

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. 10,62,620

Title: PLATFORM LOCATION AND TIME BASED ADVERTISING

IPR2023-00918

PATENT OWNER'S SUR-REPLY

June 27, 2024

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TABLE OF EXHIBITS

Exhibit	Title
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 (“Felt”)
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 (“Adharapurapu”)
1010	U.S. Patent No. 8,391,886 (“Thaper”)
2001	EXPUNGED
2002	U.S. Patent No. 10,621,620 file history

On Reply, Petitioner accuses Patent Owner of offering “many unsupported accusations,” Paper 12 (Reply) p.1, but Petitioner fails to identify where such support is lacking. Contrary to Petitioner’s assertion, Patent Owner points out what the references teach and describe, and where Petitioner’s arguments depart from the references’ clear teachings. That Patent Owner does not rely on an expert does not make Patent Owner's positions unsupported. An expert is not required in inter partes reviews. *See Wyers v. Master Lock co.*, 616 F.3d 1231, 1242 (Fed.Cir.2010) (“Even in court, we have said, expert testimony is not required when the references and the invention are easily understandable.”) Depending on the complexity of the art, Board members may be able to easily understand and “soundly explain” the prior art without help from experts. *See e.g., Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015). Such is the case here. But even where the record contains such expert testimony, the Board must weigh that testimony against other record evidence in reaching its conclusion, and it may give that testimony less weight, so long as the Board supports its decision with substantial evidence. *See Trs. of Columbia Univ. v. Illumina, Inc.*, 620 F. App'x 916, 922 (Fed. Cir. 2015) (unpublished) (“The PTAB [is] entitled to weigh the credibility of the witnesses in light of their qualifications and evaluate their assertions accordingly.”) (citations omitted)). Thus, even if the record contains expert testimony, the law does not require the PTAB to rely upon it, especially where that testimony is contrary to the

clear disclosure of the prior art of record. *Id.* at 1079-1080. For example, in analyzing Felt, Petitioner's Expert erroneously equates non-consumer mobile units 124 and consumer mobile devices 120, as shown below. See Paper 12 (Reply), p.6.

I. GROUND 1: NON-ANTICIPATION OF CLAIMS 28 & 29 BY FELT (VERIZON)

A. Petitioner Conflates Felt's Consumer Device 120 with Felt's Non-Consumer Device 124.

Petitioner attempts to interpret Felt (Ex. 1004) such that all the embodiments describe the same content delivery. Petitioner's argument is incorrect. Felt describes multiple embodiments that have different types of delivery intended to perform different functions. One type of delivery is to a consumer via a mobile device (sometimes referred to as a wireless device) 120. *See* Ex. 1004, (Felt), ¶0021. Another type of delivery is to a non-consumer mobile unit 124 when in proximity to a consumer mobile device 120, *see id.* at ¶¶0034-36; Figure 2. Felt identifies and describes consumer devices (120, 112) separately from non-consumer devices (114, 122, 124). *See, e.g.*, FIGs. 1, 2, 2B, 3C, 5, 6, 7 (all separately identifying consumer devices and non-consumer devices that receive different types of content delivery)

If content delivery were the same for consumer and non-consumer devices, Felt would not need to differentiate between the two. There is a canon of construction: "[T]he general assumption is that different terms have different meanings," and such is the case here. *See, e.g., PPC Broadband, Inc. v. Corning*

Optical Communs. RF, LLC, 815 F.3d 747, 751 (Fed. Cir. 2016) (criticized on other grounds). Petitioner would have you ignore that non-consumer devices are intentionally left out of specific figures (e.g., FIGs. 6, 7) because content delivery is different for consumer mobile devices than for non-consumer mobile units. For example, in one embodiment, content is being delivered to and displayed on the consumer device 120, such as a mobile phone. In another embodiment of Felt, content delivered to non-consumer devices is not for the operator of the non-consumer device, rather, the content is for the non-consumer device to display so that a potential consumer 120 within the vicinity can view it. Felt, ¶0036.

Limitation 28(c) requires “a first and a ***second delivery rule*** associated with a ***second geolocation*** at which the ***recipient*** is tracked.” Exh. 1001, 40:13-20 (emphasis added). By contrast, Petitioner relies generally on non-consumer mobile unit 124 to satisfy limitation 28(c), but non-consumer mobile unit 124 is not at “a second geolocation at which the recipient is tracked” because non-consumer mobile unit 124 is not a ***recipient*** as required by the claims.¹ The claim language specifies that a “recipient” is a “recipient of media content,” delivered depending on specifically claimed delivery rules associated with the recipient’s “profile data” and with a “second geolocation of the recipient.” Exh. 1001, 4:16-20. Nothing in Felt

¹ In its POR, Patent Owner also shows that Felt does not disclose a *second delivery rule*. Paper 11 (POR) at 18-19.

describes that the non-consumer mobile unit is a “recipient” with “profile data” as used in the claims of the ’620 Patent. Indeed, Petitioner fails to show how Felt discloses the very specific claim limitations of 28(c) – 28(g) using mobile unit 124. Paper 12 (Reply), pp. 4-5. These claim limitations are all specifically directed to the “recipient” of the media content, who is not part of the mobile advertising platform disclosed in Felt. Instead, Felt’s realtime distribution of advertisements incorporates non-consumer mobile unit 124 as part of its delivery system. The “recipient” is the consumer seeing the content.

Figure 3 depicts an embodiment where the consumer and non-consumer devices work together. This figure highlights that multiple distinct embodiments are being discussed in Felt and the operation of one embodiment differs from another. The different embodiments include (1) content delivery to consumer mobile devices 120 from servers, (2) content delivery to signage displays (moving or fixed) 124, 114, and 3) content delivered to consumer mobile devices 120 from mobile units 124.

The Reply fails to address Patent Owner’s POR argument that the Petition improperly cherry-picks elements from the different distinct approaches while ignoring Felt’s teachings and description. *See* Paper 12 (POR), p.12. Indeed, Petitioner ignores this argument. *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.”). At least because even the cherry-picking and combining of elements found in different embodiments of Felt does not satisfy all of the claim limitations, it is not enough to establish the ’620 patent is obvious or much less anticipated, and Petitioner’s arguments in this accord fail.

B. Advertisements Displayed on Felt’s Non-Consumer Device 124 are Not Sent to a Consumer Mobile Device 120 and Do Not Satisfy the Claim Language that Requires

Petitioner states, “Felt actually describes ad delivery as an ongoing and realtime program, using interrelated architectures, and without over constraining itself to fixed arrangements.” Paper 12 (Reply), p.1. Whether Felt covers this or not is irrelevant because, claims 28 and 29 do not cover “ad delivery as an ongoing and realtime program, using interrelated architectures, and without over constraining itself to fixed arrangements,” as explained below with reference to the claim language.

1. Claim 28

Petitioner glosses over the difference set forth in Felt between consumer and non-consumer devices when it asserts, “Felt does discuss progressive ads in terms of mobile unit 124, as a van in paragraph [0042].” See Paper 12 (Reply) p.5. However, Petitioner ignores that mobile unit 124 is not a consumer device and is

distinct from consumer mobile device 120. Specifically, mobile unit 124 has functionality not available in mobile device 120. For example, Felt describes decision module 712 as only being within mobile unit 124 or ad server 107. Felt does not disclose that the module 712 is within a consumer device 120:

Referring to FIGS. 7-8, an exemplary decision module 712 is shown, such as decision module 212 within mobile unit 124 (FIG. 2A) or a corresponding decision module 232 within ad server 107 (FIG. 2B). Elements 1001-1012 represent items of marketing content that decision module 712 may distribute to mobile devices 120 a-120 n or mobile unit 124 n. Decision module 712 may also distribute marketing content to various mobile mats 124 or displays 114. Labels “A”-“L” on elements 1001-1012 may represent data or instructions 800 (FIG. 8) tagged to the particular items of marketing content. Such data 800 may be in the form of metadata and may comprise categories and/or criteria assigned to individual items of marketing content 1001-1012.

Exh. 1004 ¶64. The location of the decision module 712 demonstrates that a consumer device 120 differs from a non-consumer device 124. *See, e.g.*, FIGS. 7-8 (showing decision module 712 in non-consumer mobile unit 124 or ad server 107). Because the operation and embodiments of mobile units 124 differ from mobile

device 120, the Petitioner cannot mix parts of one embodiment with parts of another when attempting to show anticipation and obviousness.

When discussing claim 28 in the Reply, Petitioner fails to address claim element 28(c). *See* Paper 12 (Reply), pp. 3-9. Petitioner attempts to argue parts of the claim in a vacuum, without comprehending the complete claim element. Claim element 28(c) requires that a first delivery rule associated with an element of the recipient's profile data and a second delivery rule associated with a second geolocation. *See* Paper 11 (POR), pp. 18-19. Claim element 28(d) associates the first geolocation with the first delivery rule, and claim element 28(g) requires “*delivering, upon fulfillment* of [1] the first delivery rule [associated with recipient's profile data] and [2] the second delivery rule [associated with a second geolocation],” media content to the *recipient*. Ex. 1001, claim 28 (emphasis added). Thus, simply updating ads based on proximity to the second location as Felt teaches, fails to require the first delivery rule associated with *recipient* profile data (elements 28(c), (d)) to be fulfilled as required in element 28(g). *Id.* Petitioner fails to show specifically how Felt discloses claim elements 28(c) – 28(g), relying on generalities and conflating embodiments. *See id.* at 18-20.

2. Claim 29

Patent Owner reiterates its position on claim 29 as presented in the Response and clarified with regards to claim 28 above in view of the Petitioner's Reply.

II. GROUNDS 2-6: NONOBVIOUSNESS

A. Improper New Argument

Petitioner impermissibly presents a new argument in the Reply. *See* 37 C.F.R. § 42.23(b). In footnote 1 on page 11 of the Reply, Petitioner now posits that “Foursquare clarifies typographical error on page 15 of the Petition which should have read ‘... responsiveness in tracking above concerning Element [“]28(e),” rather than referring to Element “28(c).” The original paragraph from the Petition reads:

To the extent that Verizon [Felt] lacks express or elaborate discussion of responsiveness in tracking above concerning Element 28(c), in a similar area of location-based advertising, Geer discloses activation of high resolution tracking (“HIRES”) for increased precision depending on a state of the user relative to the event/location of interest.”

Paper 1 (Petition), p.15. The Petition provides Patent Owner with absolutely no indication that any element other than the specifically identified 28(c) is being discussed. There is no claim text in that paragraph, and the preceding and post paragraphs do not indicate that an element other than 28(c) is being discussed in the Petition. Furthermore, based on the order in the Petition, it makes sense that element 28(c) is being discussed rather than 28(e). Based on Petitioner’s arguments, Patent Owner has relied on Petitioner’s failure to disclose any prior art reference for element 28(e) for “Obviousness” in Grounds 1 and 2 of the Petition in its POPR and

in its POR. *See* Paper 7 (POPR), p.26; Paper 11 (POR), pp.19-20. Because Petitioner failed to address element 28(e) concerning Ground 2, Petitioner has failed to meet its burden in showing obviousness. *See* 37 C.F.R. § 42.104(b)(4) (The Petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”) This is far from a typo.

Indeed, while Petitioner remained silent, Patent Owner relied upon this alleged error in both its POPR (Paper 7) and its POR (Paper 11). Petitioner had ample time to notify the Board and make such a correction before the Patent Owner was prejudiced in its Response (Paper 11) but chose to wait and make an improper material change to its argument in Reply (Paper 12).

In addition, Petitioner’s contention for the first time (on Reply) that element 28(e) may not be met in its anticipation section, *see* revised paragraph Paper 1, p.15(e), *supra*, coincides with Patent Owner’s argument in its POPR specifically that Petitioner through two paragraphs in its Petition on element 28(e) did not specifically apply the limitation to the asserted prior art, Felt. Patent Owner argued:

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).

Paper No. 6 (POPR), p.26. It is Petitioner's burden to show that every element of a claim is provided for in the reference and string citations without explanations fail to satisfy that burden. *See, e.g., Apple Inc. v. Qualcomm Inc.*, IPR2018-01276, Paper 32 2020 Pat. App. LEXIS 7895, *15-16 (PTAB Feb. 3 2020). Now Petitioner suggests that we should, for the first time, consider an alternative argument for obviousness of element 28(e) under Ground 2. Petitioner bears the burden of showing explicitly how this element is satisfied. Petitioner's assertion at this late stage of the game that we now consider its explanation for element 28(c) instead for element 28(e) reveals a fatal flaw in both its obviousness and its anticipation analysis. Namely, it failed to show how limitation 28(e) was satisfied for either.

Petitioner has failed to make a *prima facie* case of anticipation for Ground 1 or obviousness for Ground 2. The Board must take the Petition as presented in the proceeding, as any other decision would be prejudicial against the Patent Owner. *Patent Office Trial Practice Guide*, 77 Fed. Reg. at 48,767 (“[e]xamples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the ... unpatentability of an original ... claim,”). “The Board will not attempt to sort proper from improper portions of the reply.” *Id.* Therefore, at the very least this section of Petitioner's Reply must be

disregarded because of the new argument. Because Petitioner maintains the burden, both Grounds 1 and 2 of its Petition additionally fail for missing element 28(e).

B. Thaper (Cellco)

For the first time on Reply, Petitioner proclaims that Thaper is properly asserted through Felt via incorporation by reference (*See* Paper 12 (Reply), pp. 15-16), but Petitioner cites no case law supporting such a new proposition. Felt is a printed publication under 35 U.S.C. § 102, and the teachings of that reference are contained within that reference. The only references used in the Identified Grounds 1-13 before the Board are the Felt publication (Ex. 1004) and exhibits (Exs. 1005-1009). *See* Petition Paper 1 (Petition), pp. 1-2. Thaper has not been presented as evidence in any of the Grounds headings. It is only referred to in the Felt publication. *See* Felt, ¶27. However, now Petitioner attempts to improperly use Thaper as a second reference in a single reference obviousness argument, in which obviousness ground based solely upon Felt (Ex. 1004). *See* Paper 1 (Petition), p.18, 26.

Any argument Thaper is being asserted against claims 3 or 4 in Ground 1 (Felt single reference obviousness) is improper incorporation by reference in violation of 37 C.F.R. § 42.6(a)(3). Incorporating a patent by reference for use in an argument is no different than incorporating that argument by reference. If Petitioner wanted to rely on the teachings of Thaper as a proper obviousness reference, it should have properly presented and cited to Thaper in the Petition for claims 3 and 4. A single

reference, Ground 1 - Felt obviousness, cannot succeed if the argument relies on both Felt (Ex. 1004) and Thaper (Ex. 1010). However, even if Thaper is considered, as set forth in Patent Owner's response, the combination of Felt and Thaper fails to render claims 3 and 4 obvious. *See* Paper 11 (POR), pp.32.

III. GROUNDS 4-5: NONOBVIOUSNESS OF FELT IN VIEW OF KERR/MUHIRE/SENN

Petitioner argues that the benefits of Muhire include segmenting, organizing, and indexing to ease development. *See* Paper 12 (Reply), p.16. That may be, but the '620 patent makes no assertion that segmenting, organizing, and indexing is a problem or issue it was seeking to resolve. For a motivation to exist, there must first be a problem, *i.e.*, a reason that would have prompted the person of skill in the art to make a combination. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) ("important to identify a reason that would have prompted [PHOSITA] to combine the elements in the way the claimed new invention does.") Petitioner provides no showing or description of an alleged problem needing segmenting, organizing, and indexing to ease development in the '620 patent. Regardless, even if combined, the combination in the Petition of Felt, Keer, Muhire, and Sehn, does not render the claims obvious. *See* Paper 11 (Response), pp. 22-29.

IV. GROUNDS 7-11: ADHARAPURAPU (ALCATEL) AND OTHERS

Petitioner repeatedly describes Adharapurapu as teaching the use of tracker base stations. *See* Paper 12 (Reply), p.19. Indeed, Adharapurapu is provider base station and provider network dependent, which means that it does not need to rely on geolocation, as required by claim limitations 1(a)(i), 1(c)(ii), 28(a)(i), 28(c)(i), 29(a)(i), and 29(c)(ii) of claims 1, 28 and 29. For this reason, as well as the others set forth in Patent Owner's Response, the Adharapurapu combinations do not teach the claimed invention. Patent Owner stands by the arguments in its Response for Grounds 7-11 are not obvious in view of the combination of ADHARAPURAPU and the other references. Paper 11 (POR), pp. 30-38.

There can be no second geolocation in Adharapurapu, because, as Petitioner admits, tracker base stations are used and not geolocation to identify location. *See* Paper 12 (Reply), p. 19. The Petitioner states that Adharapurapu has "explicit disclosure that relies on a second location." *Id.* at 18. Yet, the '620 patent claims do not simply claim "a location" as asserted by Petitioner; rather, the claim term is "first geolocation" or "second geolocation." *See* Ex. 1001, 37-38:49-3. Geolocation is not dependent upon a cellular provider's fixed location base station and is provider-independent. Adharapurapu explains that "the mobile service provider 103 identifies areas in which content delivery *based on the direction of mobility service* is to be implemented and *identifies the base stations* covering that area." Exhibit

1009 (Adharapurapu), 3:50-53. Adharapurapu explicitly states it relies on the mobile service provider to identify areas. The Petitioner relies on these “tracker base stations” in Adharapurapu rather than the geolocation required by the claims. *See* Paper 12 (Reply), pp.18-19. This provider-limited approach is a further reason to distinguish Adharapurapu from the claims of the ’620 Patent, all of which require geolocation and are not limited to a specific cellular provider. Further, Petitioner has set forth no motivation to combine the geolocation approach references, such as Felt, with references that rely on the fixed location of the cellular base station in Adharapurapu.

V. CONCLUSION

As set forth in Patent Owner's POPR, POR, and above, none of the cited prior art, either alone or in combination, includes all of the limitations of any of the claims, and therefore, the patentability of the '620 Patent should be confirmed.

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Respectfully submitted,

/ 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

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 the service of Patent Owner BoardActive Corporation served Patent Owner's Sur-Reply on counsel of record for Petitioner Foursquare Labs, Inc. by filing this document through P-TACTS, as well as delivering a copy via electronic mail to the following:

Michael.Carrillo@btlaw.com

Steven.Shipe@btlaw.com

Date: June 27, 2024

By: / 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 3,223 words. Counsel has relied on the word count feature provided in Microsoft® Word for Mac Version 16.86.

Dated: June 27, 2024

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

