

Filed: January 17, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC,
Petitioner,

v.

NORTHSTAR SYSTEMS, LLC,
Patent Owner.

Case IPR2023-01049
U.S. Patent 8,805,416

**PETITIONER'S REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE**

On January 9, 2024, the Board authorized Petitioner to submit a five-page pre-institution reply addressing Patent Owner’s request for discretionary denial under 35 U.S.C. § 314(a) and Patent Owner’s construction of the claim limitation “information about a current location of the mobile communication device ... includ[ing] global positioning system (GPS) information.” Ex. 3001.

I. PETITIONER’S SOTERA STIPULATION REMOVES OVERLAP

Under the Interim Procedure, “the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.” Interim Guidance, 3. BMW AG, defendant in the district court litigation and real party-in-interest in this proceeding, has stipulated that if the Board institutes IPR on this Petition, it will not pursue in the related district court proceeding, *NorthStar Systems LLC v. Bayerische Motoren Werke AG*, 2:22-cv-00496 (EDTX), “any ground that [Petitioner] raised or reasonably could have raised” during this proceeding. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020); 35 U.S.C.

§ 315(d); Ex. 1021; Ex. 1023.¹ Accordingly, Patent Owner’s request for discretionary denial under §314(a) is moot. Interim Guidance, 3.

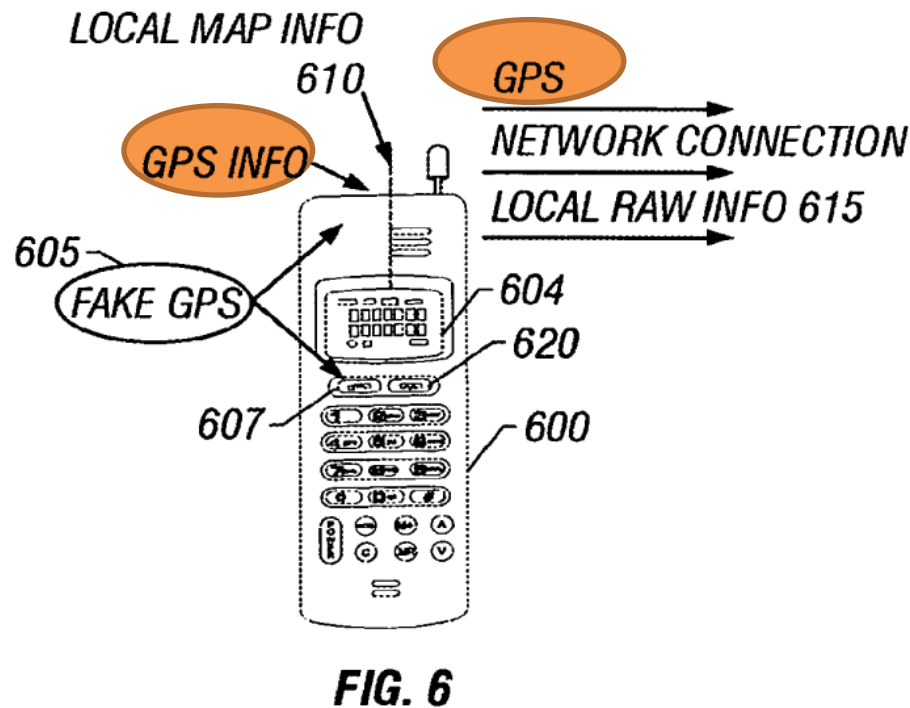
II. “INFORMATION ABOUT A CURRENT LOCATION OF THE MOBILE COMMUNICATION DEVICE” INCLUDES THE CURRENT LOCATION ITSELF

Claim 1 recites “receiving, by a mobile communication device, information about a current location of the mobile communication device, wherein the information about the current location includes global positioning system (GPS) information.” Ex. 1001, claim 1; Pet., 6 (identifying limitation [1a]). Patent Owner argues that “Claim 1(a) requires ‘receiving information **about** a current location,’ not the location itself” POPR, 4 (bold in original). Patent Owner’s construction is not supported by the ’416 patent specification and improperly narrows the plain language of the claim, which supports an interpretation that the “information about the current location” includes the location itself.

¹ Validity is not at issue in *BMW of North America, LLC v. NorthStar Systems LLC*, 6:23-cv-00456 (WDTX), where Petitioner currently seeks a declaratory judgment of noninfringement.

A. Patent Owner’s Construction is Not Supported by Intrinsic Evidence.

Patent Owner’s construction is too narrow because limitation [1a] provides that “information about a current location of the mobile communication device ... *includes global positioning system (GPS) information*” and the specification explains that a “cellular phone” including a “GPS device” is an “*automatic position location detection* technology.” Ex. 1001, claim 1, 1:14-17 (emphasis added). Consistent with this description, the specification describes portable phone 200 including a “position detector” (also called a “positioning device”) for determining the phone’s “position, and report[ing] that position to a remote source.” Ex. 1001, 2:12-21; FIG. 2. The specification also describes “GPS computer 600” (also called a “thin client,” “cell phone,” etc.) for receiving “GPS info” and transmitting the same to a sever. Ex. 1001, 4:35-43, 48-51, FIG. 6. The specification does not differentiate these “position detector” and “GPS” devices from those that “automatic[ally]” detect “position location,” or otherwise provide that “information about a current location” necessarily excludes the position location of the device. Ex. 1001, 1:14-17, 2:12-21, 4:35-43, 48-51, FIG. 6.



Ex. 1001, FIG. 6 (annotated).

That claim 1 further recites receiving, from the “remote source,” navigation information including the current location of the mobile device (as argued by Patent Owner), does not preclude the mobile device from sending its current location, or the “user’s current location as determined by [a GPS] position determination system.” POPR, 5; Pet., 6-7, 12. Indeed, as explained above, the ’416 patent explains that the position detector of portable phone 200 “allow[s] the position detector to determine [the portable phone’s] position, and report that position to a remote source.” Ex. 1001, 2:12-21. The ’416 patent also explains that electronic devices that “automatically determine[]” their position “by communicating with a constellation

of global position detecting satellites 130, for automatic determination of position” were known, and that such a device “may communicate its determined position to the server.” Ex. 1001, 1:26-35.

Accordingly, Patent Owner’s construction is unsupported by the intrinsic evidence.

III. CONCLUSION

For at least these reasons, Patent Owner’s argument that the claims require “‘receiving information about a current location,’ but not the location itself” must be rejected. The plain and ordinary meaning of claim element [1a] does not exclude the location of the mobile device itself.

Date: January 17, 2024

Respectfully Submitted,

/Kara A. Specht/

Kara A. Specht, Reg. No. 69,560
Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Petitioner's Reply to Patent Owner's Preliminary Response** was served on January 17, 2024, via email directed to counsel of record for the Patent Owner at the following:

Vincent J. Rubino, III
vrubino@fabricantllp.com

John Rubino
jarubino@rubinoip.com

PTAB@fabricantllp.com

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By: /Lisa C. Hines/
Lisa C. Hines
Case Manager
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP