UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC,

Petitioner,

v.

NORTHSTAR SYSTEMS LLC,

Patent Owner.

Patent No. 8,805,416
Filing Date: February 14, 2008
Issue Date: August 12, 2014
Inventor: Scott C. Harris
Title: METHOD AND SYSTEM FOR MOBILE DEVICE SELECTIVELY REPORTING OF GPS POSITION INFORMATION TO OTHERS

PATENT OWNER'S PRE-INSTITUTION SUR-REPLY

Case No. IPR2023-01049

EXHIBIT LIST

Exhibit No.	Description of Document
2001	Amended Docket Control Order, Dkt. 70, in *Northstar Sys. LLC v. Volkswagen AG*, Case No. 2:22-cv-00486-JRG (Lead Case) (E.D. Tex.)

On January 9, 2024, the Board authorized Petitioner to submit a five-page pre-institution reply addressing the claim limitation "information about a current location of the mobile communication device . . . includ[ing] global positioning system (GPS) information." Ex. 3001. The Board further authorized Patent Owner to submit a five-page sur-reply.

Petitioner does not dispute that the Petition should be denied if the Board were to accept Patent Owner's interpretation of the Challenged Claims. Furthermore, Petitioner ignores the plain language of the claims and the specification itself. Petitioner focuses on embodiments in Columns 1, 2, and 4; however, Petitioner fails to discuss the server-mediated embodiments which are described in Column 5 onward. Nothing in Petitioner's citations to Columns 1, 2, or 4 describes "information ***about*** a current location." The description of "information about a current location" does not begin until Column 5. For example, Column 5 describes an embodiment of the thin client as follows: "On a thin client such as 600, the operations that can be done using the GPS information is often limited by the limited resources of the thin client." '416 Patent, 5: 6-8. The specification then describes this embodiment as transmitting "raw" information, which includes information "***about*** the environment." *Id*. 5: 42-46 (emphasis added). The ***server*** then uses this information to "**narrow down the current location to a position**." *Id.* 5: 47-59 (emphasis added). Indeed, this disclosure makes clear that "information about a

current location" does not include the current location—otherwise the server would not need to narrow down the position.

Petitioner has no explanation for why the claims require that the server send the location to the mobile device. Instead, Petitioner attempts to cobble together reasons for why this server configuration does not preclude the mobile device itself sending the exact location to the server.

In view of the specification and the plain language of the claims, the Board should not adopt Petitioner's interpretation of the claims and should deny institution.

Respectfully submitted,

Dated: January 25, 2024 By: /*Vincent J. Rubino, III* /

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CERTIFICATE OF SERVICE

A copy of PATENT OWNER'S PRE-INSTITUTION SUR-REPLY TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,805,416 has been served on Petitioner's counsel of record as follows:

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