

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE, LLC,
Petitioner,

v.

GEOSCOPE TECHNOLOGIES, PTE., LTD.,
Patent Owner.

IPR2023-01213
Patent 9,097,784 B2

Record of Oral Hearing
Held: November 20, 2024

Before PATRICK R. SCANLON, SHEILA F. McSHANE, and
BRIAN D. RANGE, *Administrative Patent Judges*.

APPEARANCES:

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The above-entitled matter came on for hearing on Wednesday,
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P R O C E E D I N G S

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JUDGE RANGE: So, let's go on the record.

Good morning. I'm Judge Brian Range, and with me today are Judge Patrick Scanlon and Judge Sheila F. McShane.

This is the hearing for one *inter partes* review. The Matter No. is IPR 2023-01213. The matter is captioned Google, LLC, Petitioner, v. Geoscope Technologies, Pte., Ltd., Patent Owner. This *inter partes* review concerns U.S. Patent No. 9,097,784 B2.

I note that later this afternoon we will have a separate hearing involving the same parties. The separate hearing will address IPR 2023-01209, -01210, -01211, and -01212.

Let's start by having counsel make appearances. Who will be speaking for Petitioner today?

MR. KEANE: Your Honor, my name is Patrick Keane. I will be speaking on behalf of Petitioner Google. I have with me my colleague Dr. Mythili Markowski, who will also be speaking, and in the room with me is, also from our firm, Roger Lee, Sam Harrod, and a representative from Google, Mr. Jim Sherwood. But speaking will be myself and Dr. Markowski this morning.

JUDGE RANGE: Thank you.

And who will be appearing for Patent Owner this morning?

MR. McBRIDE: Thank you, Your Honor. This is Steve McBride for Patent Owner Geoscope. My colleague Chris Abidin will be presenting the argument today. We also have Brad Close, the Executive Vice President of Patent Owner Geoscope, on the public line.

1 JUDGE RANGE: Thank you. Before we begin with arguments, I
2 have just a couple of administrative matters.

3 First, we have your demonstratives. For clarity of record, and so that
4 we can follow your argument, we ask that you please identify what page of
5 your demonstrative you're talking about as you argue.

6 Also, because we're doing this virtually, please state your name if you start
7 speaking, so that the record is clear and to help the court reporter.

8 Second, I want to talk about timing. As a baseline, each side would
9 start with 45 minutes to present its argument.

10 Patent Owner is making these via our Legal Experience and
11 Advancement, or LEAP, Program. We welcome Christopher Abidin as the
12 LEAP practitioner this morning. Because Patent Owner is making use of the
13 LEAP program, Patent Owner may have an additional 15 minutes to argue,
14 for a total of 60 minutes.

15 I'd note that the issues presented by this matter are fairly discrete.
16 So, the parties should feel like they do not -- don't feel like you have to use
17 all the allotted time if you do not need to.

18 We will begin with Petitioner's arguments regarding unpatentability
19 and Patent Owner may respond. We will try to keep track of time and try to
20 indicate if you are running short on time, but please also try to keep track of
21 time a bit yourselves.

22 Petitioner, would you like to reserve? You may reserve some of your
23 time for rebuttal, if you wish. How much time would you like to reserve for
24 rebuttal?

25 MR. KEANE: Your Honor, we would like to reserve 15 minutes for
26 rebuttal.

1 JUDGE RANGE: Patent Owner, how much time would you like to
2 reserve for surrebuttal?

3 MR. McBRIDE: We'd like to reserve 15 minutes.

4 JUDGE RANGE: Does either party have other questions before we
5 begin?

6 MR. KEANE: Not on behalf of Petitioner, Your Honor.

7 JUDGE RANGE: Okay. It's 9:05 and Petitioner may begin its
8 argument.

9 MR. KEANE: Thank you, Your Honor. May it please the Board,
10 Patrick Keane, on behalf of Petitioner Google. I am going to just give a
11 brief introduction, Your Honors, before we start the argument.

12 There are five patents at issue, five matters, five IPRs, and I would
13 just like to give some context to the five IPRs and how they relate before we
14 jump into the '784 patent which is the subject of this session, which will be
15 handled -- the demonstratives will be argued by my colleague Dr. Mythili
16 Markowski.

17 I'd like to begin, as I said, with this context. And from Petitioner's
18 perspective, we're kind of doing these arguments in reverse. We're starting
19 with the '784 patent, and then, we're moving to the '104 patent family, which
20 is the '104 patent, the '358 patent, and the '494 patent.

21 And then, we're going to wrap up with the '753 patent. The '753
22 patent that we'll be finishing up with is actually the database patent. It's goes
23 to the database that's used for public device location. It's what's in the
24 database that matters. It's not how the database is created. It's what's in that
25 database that's used for the methods and systems for location detection.
26 That's our end-of-the-day program.

1 In the middle of the day, we'll be talking about how you access that
2 database once it's been created through normalization of signals from a
3 cellular phone, and so forth.

4 This morning, we're starting with data that you might want to add to
5 that database to provide some kind of streaming affiliation to the location of
6 that local device that you've located. So, we're beginning kind of at the back
7 and working our way then forward.

8 With that said, I also would like to point out some problems in status
9 associated with these patents. The five patents all derive from the same
10 priority document, as I'm sure Your Honors are aware, and final judgments
11 were received in all of those patents in District Court.

12 The patent we're talking about this morning, the '784 patent, was
13 deemed unpatentable under 35 USC Section 112, the claims that were
14 presented to the District Court. Those claims were not appealed to the
15 Federal District -- or I'm sorry -- to the Court of Appeals for the Federal
16 Circuit. And yet, they were not disclaimed for purposes of the PTAB and
17 the IPR. We suggested that they be disclaimed, but Patent Owner decided to
18 go forward. So, to preserve Google's interests, we're here today.

19 Patent Owner has also disclaimed many of the claims of the other
20 patents that we'll be discussing today. There's just a handful of patents
21 remaining for these IPRs.

22 Finally, I would like to point out that the claimed construction in all
23 of those District Court matters was not raised as an issue on appeal to the
24 Federal Circuit in the cases that were appealed, the four that we'll be hearing
25 this afternoon. Across the board, because these all derive from the same
26 priority document, I would like to mention that the claim construction we

1 will be applying is the same claim constructions across all of our hearings
2 today. That claim construction was correctly decided by both the District
3 Court and Your Honors in the DI and really does not need to be revisited,
4 particularly because, as I said, that hasn't been an issue raised on the appeals
5 in the District Court.

6 I would like to, also, from a contextual point of view, mention that
7 these patents that are being challenged by Petitioner were all deemed worthy
8 of institution, based on the prior art, the compelling merits of the prior art
9 that Petitioner has presented. Each of these petitions was presented with the
10 supporting evidence in the form of that prior art, as well as the supporting
11 evidence of Petitioner's expert, David Williams. In many cases, that expert
12 testimony has gone un rebutted. In fact, in the case we're dealing with here
13 in this session, there was no cross-examination of Petitioner's expert, nor did
14 Patent Owner provide an expert for Petitioner to cross-exam.

15 So, again, lots of problems with these patents, a lot of common issues
16 that in Petitioner's mind have already been decided. We'll be happy to
17 answer questions as the day goes on, but regarding the merits of the petition,
18 I'm going to turn that over to my colleague Dr. Mythili Markowski to
19 present the oral argument.

20 JUDGE RANGE: This is Judge Range.

21 I had one procedural question before we get going, which is my
22 understanding is, for the '784 patent, the District Court found that, I guess,
23 during litigation, you narrowed the case down, so other were only two
24 claims at issue, or something like that, and the District Court found that
25 those claims were indefinite, and so, technically, didn't weigh-in on the other
26 claims. You're challenging a number of other claims here also, correct?

1 MR. KEANE: Correct.

2 JUDGE RANGE: Okay.

3 MR. KEANE: But those claims, as I said, they were not appealed.

4 Many of the issues that were presented to the District Court exist with the
5 claims that we will be discussing today. That's what we'll be talking about.

6 JUDGE RANGE: Yes, I understand. Like same claim terms, and so
7 forth, right?

8 MR. KEANE: Yes. Thank you, Your Honor.

9 I'll have Dr. Markowski present our oral argument.

10 DR. MARKOWSKI: Good morning, Your Honors. May it please
11 the Court, my name is Mythili Markowski, on behalf of Petitioner Google,
12 LLC.

13 And to elaborate further on what my colleague Patrick Keane
14 mentioned regarding the procedural history of this case, I'd like to bring to
15 the Court's attention some information that they may or may not be aware of.

16 So, as Patrick mentioned and the Court noted, the claims that were
17 finally asserted in the District Court in the related litigation were narrowed
18 down to just Claim 11. And the Patent Owner in its preliminary response
19 indicated, at page 5, footnote 2, that they had entered a stipulation wherein
20 Claim 11 was understood and acknowledged to be indefinite, and therefore,
21 invalid. And the Patent Owner also indicated that that was the sole asserted
22 claim at the time of the District Court's ruling.

23 However, the footnote goes further and indicated that the terms found
24 indefinite are part of every claim of the '784 patent, as they are found in both
25 independent Claims 1 and 12. And we wanted to bring this to the Court's
26 attention because the independent Claims 1 and 12 are still at issue in this

1 proceeding, have not been disclaimed by the Patent Owner, and to date, even
2 as of this morning, when Petitioner checked the Patent Center, we did not
3 see any type of communication with the Patent Office or any type of
4 disclaimer filed with respect to either Claim 11, which was, again, found to
5 be invalid by the District Court. It was not appealed by the Patent Owner,
6 nor was there any indication that Claims 11 and 12, or every claim of the
7 '784 patent, were admitted to be invalid by Patent Owner.

8 And as recently as Monday and Tuesday of this week, Petitioner
9 reached out to Patent Owner and suggested that, should Patent Owner file a
10 disclaimer of the claims in the '784 patent, we could preserve the Court's
11 resources and obviate the need for an oral hearing, and therefore, dispense
12 with this proceeding. However, the Patent Owner preferred not to follow
13 that particular line of action and has decided to go ahead with this oral
14 proceeding or oral hearing. And, of course, Petitioner is proceeding with
15 this oral hearing as well to preserve its interests in this matter.

16 With that background, I would like to turn the Court's attention to
17 Petitioner's demonstratives. And we will turn to Slide No. 2, just for the
18 Court's reference. This illustrates just the face page of the U.S. Patent No.
19 9,097,784, which is the subject of the Petitioner's challenge today.

20 On to Slide 3 of the demonstratives, I'm sure the Court is aware
21 we've just provided a recitation of what included in our petition as to what
22 the purported problem was that the '784 patent attempts to address and how
23 the '784 patent addresses that purported problem. For Your Honors' sake, I'll
24 just repeat that language here.

25 So, the purported problem identified in the '784 is that calibration
26 data measured via a calibration data collection device may contain errors due

1 to the physical limitations of the collection device, which could be a wireless
2 device, and/or the collection process. Any data collection device may
3 produce some degree of signal degradation or dropout. So, the '784 patent
4 purports to provide a solution, that being a system and method to collecting
5 modified calibration data to correct calibration errors and enhance the
6 accuracy of the collected data in a database by matching calibration data
7 associated with a mobile station, like a wireless device, with positions of
8 streets in the street database.

9 However, none of these concepts, and certainly not the solution
10 provided by the '784 patent, is novel or innovative in any regard. In fact, all
11 of these aspects that are brought forward in the '784 patent were taught by
12 the prior art.

13 We can move on to Slide No. 4. As I mentioned, the claims of the
14 '784 patent that are challenged by Petitioner are Claims 1, 2, 10, 11, 12, 13,
15 21, and 22. And Claim 11 was the claim that was found to be invalid by the
16 District Court and that finding was not appealed to the Federal Circuit.

17 What I have presented for you on Slide 4 is the method of generating
18 a calibration database claims. And you'll notice that Claim 1, the
19 independent claim, has a preamble and nine steps.

20 Dependent Claims 2, 10, and 11 just further characterize that method
21 claim and include additional limitations.

22 System Claims 12, 13, 21, and 22 track the language of the method
23 Claim 1 and dependent Claims 2, 10, and 11.

24 And while I have you on this slide, I want to highlight to Your
25 Honors that it really is Element 1.6 that would be the subject of our
26 presentation today. However, I will briefly also touch upon Element 1.4.

1 We could move on now to Slide No. 6. As Your Honors noticed this
2 morning and included in your introduction, there has been a significant
3 narrowing of the issues in this particular proceeding. Specifically, Patent
4 Owner did not separately dispute the Petitioner's position with respect to
5 dependent Claims 2, 10, 11, 13, 21, and 22. And this was noted in your
6 institution decision and this, also, is apparent in Patent Owner's response and
7 surreply, where they do not separately argue the patentability of such
8 dependent claims.

9 Likewise, Patent Owner had not separately disputed Petitioner's
10 position as to independent Claim 12. This was also noted in the institution
11 decision. And likewise, Patent Owner did not separately dispute any
12 Petitioner's positions in its Patent Owner response or in its surreply.

13 Finally, as I mentioned a few minutes ago, it really is Element 1.6
14 that is going to be the crux of our argument today. And that's because Patent
15 Owner has repeatedly and consistently asserted that Crane, our primary
16 reference that we are asserting in this proceeding, has no teaching or
17 suggestion of -- and this is the language that I reproduced here of Element
18 1.6 -- "determining from said status a most likely one of said plural streets
19 upon which said wireless device is located."

20 Now, while asserting this, as my colleague mentioned, Petitioner
21 provided expert testimony as to how a person of ordinary skill in the art
22 would have read Crane and the secondary reference, Spain, and understood
23 the disclosures of the same and the combination set forth by Petitioner.

24 And this is important because this is potentially an anticipation
25 response that the Patent Owner has provided, and we have only asserted one
26 ground per challenge and that is obviousness. And obviousness is

1 predicated on what a person of ordinary skill in the art would understand the
2 prior disclosures to have provided, especially in the context of this
3 combination, in view of the knowledge generally available in the art.

4 I will dispense with Slide 7 and 8, which does provide the face pages
5 of our primary and secondary references.

6 And I will ask for Your Honors to look at Slide 15, which is Element
7 1.4. And as I mentioned, this is not the subject of today's dispute with Patent
8 Owner. However, I do want to bring the Court's attention to what Element
9 1.4 recites, as well as Figure 4 of the claim disclosure which we have
10 discussed not only in the patent petition, but also in our reply. And so, the
11 Court has significant citations for this particular figure.

12 And Element 1.4 recites, "providing a location information database
13 wherein said location database includes latitude and longitude information
14 for each of a plurality of points within said region." And the database here is
15 designated as DB 172. And you can see that the data itself is labeled as 170.

16 Additionally, even further within that red box that you see circled
17 around that database 172 are roads 174. And while they are not labeled, you
18 can see even further drilling down to individual roads. So, there's a road
19 with latitude and longitude information and some dots underneath. This
20 denotes that each road is provided specific latitude and longitude coordinates
21 and these are distinct for every single road that is included in the database
22 having its own coordinates.

23 And this is just a disclosure of Crane. Spain, also, our secondary
24 reference, has a similar disclosure at paragraph 99, and as noted by the
25 Patent Owner in its preliminary response at their page 21.

26 And just one more thing. I would like you to note, in connection

1 with this Figure 4, if we could move to Slide 14, we have an illustration that
2 perhaps will help the Court in understanding what all these latitude and
3 longitude coordinates mean in the context of Crane.

4 So, Figure 3, which is to the righthand side of the screen of Slide 14,
5 includes a road that is, basically, presented vertically, or as vertically as
6 possible -- it's curved in nature -- as well as a road that is presented moving
7 from left to right on your screen.

8 And you'll notice that each of the roads has its own X marker. So,
9 these are the positions that are noted in the database for the vertical road as
10 well as the more horizontal road. And each of these latitude and
11 longitudinal positional information or data would be stored in that database
12 and associated with a specific road. And therefore, there is distinguishment
13 between roads within Crane's disclosure.

14 So, let's get to the crux of today's proceeding. And we should move
15 on to now Slide No. 17.

16 Now, Your Honors, if you do wish to discuss the other elements of
17 Claim 1 or any of the other claims, I am more than willing to answer
18 questions on those. However, I believe both Petitioner and Patent Owner
19 have significantly narrowed the issues, and specifically, to this one issue,
20 this one element, and particularly, a few words or terms within this one
21 element that we would like to narrow and focus your attention on today, as
22 everything else seems to be waived by the Patent Owner.

23 So, in Slide 17 of our demonstratives, I, basically, included in the red
24 box here would be Element 1.6. So, "determining from said status a most
25 likely one of said plural streets upon which said wireless device is located."

26 Now, the Patent Owner has decided to focus on what a most likely

1 street is and has indicated in their documents that Crane does not disclose
2 the most likely situation. However, I also want to bring to Your Honors'
3 attention page 33 through page 34 of Petitioner's petition. Specifically, we
4 relied on Patent Owner's own characterization of this term. At page 33 of
5 our petition, we relied on Patent Owner's preliminary infringement
6 contentions of the related litigation, wherein, they characterize this term as
7 "whether a device is located on a street and what street the device is likely
8 located on."

9 Now, the Patent Owner doesn't seem to be disputing that Crane
10 discloses whether a device is located on a street, but Patent Owner seems to
11 be disputing what street the device is likely located on. And instructive to
12 that, and incorporating Patent Owner's own characterization of this term,
13 Petitioner provided an excerpt from Crane that spans pages 33 through 34.
14 And Petitioner even highlighted in bold and italicized fonts text that actually
15 mirrors the characterization provided by Patent Owner.

16 So, on page 34 of the petition, as the first portion of the text
17 reproduced from Crane, we've italicized and bolded text as follows:

18 "For example, if the acquired cellular position data 140 indicate that
19 the cellular phone is on or within a certain threshold distance of the position
20 of a road 152 or is moving, the cellular phone can be assumed to be inside of
21 a vehicle traveling along the road."

22 That highlighted portion of the text of Crane is whether such mobile
23 device is on a road. And certainly, Patent Owner is not disputing that Crane
24 teaches whether a mobile device is on a road.

25 The reason why Petitioner, then, highlighted a second portion of the
26 same excerpt goes to which street or the most likely street that the mobile

1 device is on. So, the next portion of that same excerpt reads as follows:

2 "If the distances 270 are sufficiently small, a cellular phone can be
3 assumed to be in a vehicle traveling along the actual road." That goes to
4 which street or most likely street that the mobile device is on, and therefore,
5 not only has Crane provided disclosure as to whether a mobile device is on a
6 road, but also which street or most likely street that the mobile device is on.

7 And certainly, it goes without saying that the Element 1.6 is not
8 limited to just most likely one of said plural streets. It's a whole entire step,
9 and a portion of that step is "determining from said status a most likely one
10 of said plural streets."

11 The status here, as we mentioned in our petition, can include a rate of
12 travel, a direction of travel. And if we move back to Slide 14 of the
13 demonstratives, it's illustrative that the mobile device here that's circled in
14 blue, the status of that mobile device indicates a direction of travel, and
15 therefore, also provides information about which most likely street is
16 associated with that mobile device. Certainly, it's not being matched up with
17 the horizontal road that you see in Figure 3 of Crane.

18 Now, I also want to, again, recall one last point before I discuss other
19 aspects of Element 1.6. I'm returning to Slide No. 17.

20 The Board took all of this information in and we believe that the
21 Board got it right when they provided their institutional decision. And we've
22 highlighted that. I know that it appears to be superfluous, but I'll repeat it,
23 nevertheless: "The Board indicated the Crane system then determines the
24 actual road if the distances 270 are sufficiently small," quoting the same
25 location of the Crane disclosure that Petitioner provided. And these
26 passages are sufficient to support that Crane's "determining a most likely one

1 of said plural streets upon which said wireless device is located."

2 Now, I do want to note that, upon review of Patent Owner's
3 demonstratives, that portion of Crane's disclosure, column 4, lines 17
4 through 22 are missing. So, this is the disclosure that tells, in addition to
5 other disclosures that Petitioner had provided in its reply and elsewhere, it
6 actually gives Crane the entirety of its disclosure, support for determining a
7 most likely street.

8 Patent Owner has -- and I will preview their case, if you give me that
9 allowance, Your Honors -- Patent Owner has reduced this case to reliance on
10 one label of 152 in its figures, indicating that that is representative of how
11 Crane should entirely be viewed and understood.

12 So, for your reference, we can move to Slide No. 14. In this Figure 3
13 of Crane, both roads are labeled as 152, and Patent Owner relies on the fact
14 that both roads are labeled as 152 to indicate that there is not a
15 distinguishment or a discernment between the roads that are disclosed in
16 Crane or in this database.

17 Now, even with all of that information aside, Petitioner did provide
18 additional locations within Crane's disclosure that addresses the matching of
19 positions of the cell phones to locations of roads, as well as information
20 regarding the direction of travel, that is, status, for matching a most likely
21 road. And one particular aspect was a summary of the invention.

22 In any event, if we move to Slide No. 10 of Crane, Patent Owner's
23 arguments now just include unsupported attorney argument, unsupported by
24 any expert testimony. In fact, they didn't, as my colleague mentioned, they
25 didn't even depose our expert in terms of his understanding, nor address our
26 expert's opinions, in their Patent Owner response to the surreply.

1 But if you look at Figure 1 of Crane, each of the cell phone towers
2 here are labeled as 108. Patent Owner has not to date indicated that each of
3 these towers is somehow ambiguous in terms of having its own identity.
4 And they're asking for you, as the Patent Office, to look at Figure 3, which
5 includes 152 as a label for streets, a drafting convention, as somehow
6 indicating that all roads are 152, and therefore, they have no ability to be
7 separately distinguished.

8 JUDGE RANGE: Counsel, this is Judge Range. You have about
9 five minutes before you'll start going into your rebuttal time.

10 DR. MARKOWSKI: Okay. No problems, Your Honors, and
11 actually, I'm finished with my argument.

12 So, with that, I open the floor to any questions that Your Honors
13 might have for me, as counsel for Petitioner.

14 JUDGE RANGE: I don't have any questions at this time.

15 JUDGE SCANLON: No questions from me.

16 JUDGE McSHANE: No questions. Thank you.

17 DR. MARKOWSKI: Thank you, Your Honors.

18 JUDGE RANGE: Thank you. All right. So, it's 10:32 Eastern Time,
19 and Patent Owner may move forward with its argument.

20 MR. ABIDIN: Thank you, Your Honor. Christopher Abidin,
21 representing Patent Owner Geoscope. As we previously mentioned,
22 Executive Vice President of Geoscope Brad Close is listening on the public
23 line.

24 The Board should confirm all challenged claims because the
25 Petitioner has failed to meet its burden to show that the challenged claims
26 are unpatentable.

1 Starting at Slide 2 of the demonstratives --

2 JUDGE RANGE: Counsel, this is Judge Range. Before you get into
3 the merits, I have to admit I'm a little bit perplexed why Patent Owner is
4 bothering to go forward with this case, given what happened in the District
5 Court. I can see why -- and I think we've said this in our institution decision
6 -- as a technical matter, there's not an indefiniteness ruling as to all of the
7 claims that are challenged here, but, nevertheless, it seems like it might be a
8 problem from Patent Owner's perspective.

9 So, I just wanted some explanation as to why this isn't just an
10 academic exercise.

11 MR. ABIDIN: We're here today because the claims, independent
12 Claim 12, and then, dependent Claims 13, 21, and 22, they're still alive and
13 they're subject here to a prior-art-based challenge.

14 Patent Owner did reach out to Petitioner to waive the oral argument,
15 but Petitioner refused. And so, we're here to argue in favor of the claims
16 that are still alive.

17 JUDGE RANGE: All right. Thank you.

18 MR. ABIDIN: Okay. Looking at Slide 2 of the demonstratives, the
19 only ground raised by Petitioner is an obviousness challenge based on the
20 combination of two references, Crane and Spain. Challenged Claims 1 and
21 12 are the only independent claims, and the remaining challenged claims all
22 depend from either Claim 1 or 12.

23 Turning to Slide 3 of the demonstratives, the only two independent
24 claims, Claims 1 and 12, each recite "determining from said status a most
25 likely one of said plural streets upon which said wireless device is located,"
26 which the petition identifies as Limitation 1.6. The petition does not

1 contend that Spain teaches or suggests this limitation. Petitioner relies
2 solely on Crane for Limitation 1.6.

3 The Board should confirm all challenged claims because Petitioner
4 has not satisfied its burden to show that Crane discloses this limitations. To
5 meet Limitation 1.6, the Petitioner relies only on Crane's disclosure at
6 column 3, line 57, through column 4, line 22, which the petition cites in a
7 block quote at pages 33 to 34 of the petition. The block quote describes
8 Crane's matching process 256.

9 At pages 33 to 35 of the petition, Petitioner relies on Crane's
10 disclosure that the matching process includes the following two items:

11 First, Petitioner relies on Crane's disclosure that, "If the acquired
12 cellular position data 140 indicate that the cellular phone is on or within a
13 certain threshold distance of the position of a road 152 or is moving, the
14 cellular phone can assume to be inside a vehicle traveling along the road."

15 Second, the petition also relies on Crane's disclosure in this block
16 quote that, "If the distances 270 are sufficiently small, the cellular phone can
17 be assumed to be in a vehicle traveling along the actual road."

18 Petitioner asserts that Crane's reference to, "the actual road," is a
19 disclosure of determining the most likely road. And Petitioner also points to
20 the claimed most likely street as Crane's plurality of roads 152.

21 In the institution decision, the Board preliminarily found that the
22 Crane system determines the actual road if the distances 270 are sufficiently
23 small and found that this was sufficient at the institution stage to support
24 Crane teaching Limitation 1.6. That's at the institution decision at page 29.

25 However, there's a critical distinction between the cited portions of
26 Crane and Limitation 1.6. Crane makes it clear that the cited portions of

1 Crane do not differentiate between streets and only determine whether a
2 mobile device is on a street at all. In contrast, the claims required
3 determining a "most likely" street that the device is on out of a plurality of
4 streets.

5 Turning to Slide 4 of the demonstratives, for example, as shown in
6 Crane's Figure 3, Crane uses numeral 152 to refer to a plurality of roads, and
7 Crane's numeral 152 does not refer to a single street. Instead, it is a plurality
8 of roads 152, which is confirmed by Crane's figures, such as Figure 3, shown
9 on Slide 4. Cranes Figures 5 and 6, similarly, confirm that Crane's numeral
10 152 refers to a plurality of roads.

11 The cited portion of Crane cited in the petition, the block quote at
12 petition pages 34 to 35, is, therefore, directed to determining whether a
13 device is located on any of a, "plurality of roads 152," but the challenge
14 require something different. They require determining "a most likely one of
15 said plural streets upon which said wireless device is located."

16 JUDGE RANGE: Counsel?

17 MR. ABIDIN: Yes.

18 JUDGE RANGE: Turning back to Figure 6, it also labels 155,
19 correct, which is -- I believe 155 is a road network?

20 MR. ABIDIN: Correct.

21 JUDGE RANGE: Right? So, how would a road network be -- like
22 how would a person of ordinary skill in the art understand Crane's road
23 network to be different from a plurality of roads 152?

24 MR. ABIDIN: I don't believe the Petitioner has pointed to that
25 distinction in their petition. But 155 could be the overall group of roads,
26 with 152 identifying each individual road, but not identifying them

1 individually.

2 JUDGE RANGE: Right. Yes, I guess, as far as petition goes,
3 Petitioner pointed to these passages of Crane, right, at columns 3 and 4,
4 which refer to the figures? And so, I guess the job at hand is to press to
5 figure out, as a factual matter, right, does the preponderance -- what does the
6 preponderance of evidence support in terms of how a person of ordinary
7 skill would understand these passages and these figures? Does that make
8 sense?

9 MR. ABIDIN: Right. And it's our position that these figures show
10 multiple roads labeled 152, and therefore, Crane is directed to determining
11 whether a device is located on any one of those plurality of roads 152, but
12 the challenged claims require determining "a most likely one of said
13 plurality of streets upon which the device is located."

14 Continuing on with -- unless Your Honor has any more followup
15 questions, I'll continue on with the argument.

16 JUDGE RANGE: Yes, go ahead.

17 MR. ABIDIN: Okay.

18 JUDGE RANGE: Thank you.

19 MR. ABIDIN: In the Petitioner's reply to the Patent Owner's
20 response, Petitioner argued that Crane's Figures 3 and 6, which both show
21 multiple roads labeled 152, are merely embodiments and should not be
22 relied upon to understand what Crane means by "roads 152." But these
23 Figures 3 and 5 -- 3 and 6 are the only figures in Crane which show road
24 152, roads 152, and both show multiple roads, and therefore, these figures
25 form the basis for understanding what Crane means by "roads 152."

26 If we turn to Slide 6 of the demonstratives, the Petitioner in its reply

1 also points to the summary of the invention as alleged support for Crane
2 meeting the claimed determining a most likely street, but it has the same
3 problem. The summary concerns a plurality of roads and not a single road.

4 As shown in Slide 6, in the summary of the invention, Crane uses,
5 "data indicating the locations of roads in a geographic area to derive data
6 about phones located in vehicles traveling along the roads."

7 Crane matches the position of the cellular phone to "positions of
8 roads in a geographic area." That's the positions of roads, plural. And
9 Crane's summary of the invention, therefore, does not say that the data about
10 the phones that it derives includes the most likely road, as required by the
11 claims.

12 Petitioner, at page 7 of its reply, also cites several portions of the
13 specification discussing Crane Figures 4 and 5, but in each case, Crane is
14 either discussing Figure 3, which includes the plurality of roads 152, or is
15 referring back to Figure 3 by discussing roads 152.

16 The portion of Crane cited in the petition for Limitation 1.6 is,
17 therefore, directed to determining whether a device is located on any one of
18 a plurality of roads 152. The challenged claims require something different.

19 They require determining "a most likely one of said plurality of streets upon
20 which said wireless device is located." This is a critical distinction between
21 Crane and what is required by the claims.

22 For at least these reasons, Petitioner has failed to meet its burden and
23 the Board should confirm all challenged claims. If the Board has any
24 questions, I'll open now for questions.

25 JUDGE RANGE: I wonder if you can elaborate on Crane column 4
26 at line 22, where it refers to, "If the distances 270 are sufficiently small, the

1 cellular phone can be assumed to be in a vehicle traveling along the actual
2 road." How does the usage of the actual road there, how do you explain that
3 on your argument?

4 MR. ABIDIN: So, this sentence appears to be referencing a few
5 sentences above in that portion of Crane, where Crane mentions that or
6 discloses that, starting at line 4, "If the acquired cellular position data 140
7 indicate that the cellular phone is on or within a threshold distance of the
8 position of a road or is moving, the cellular phone can be assumed to be
9 inside a vehicle traveling along the road."

10 And so, the sentence that you quoted is mentioning distances being
11 sufficiently small. And so, this portion of Crane is matched, is looking at a
12 particular road and seeing if it's within that threshold distance.

13 JUDGE RANGE: Okay. Thank you.

14 MR. ABIDIN: Okay. That's all, Your Honor. We'll reserve the
15 remainder of our time.

16 JUDGE RANGE: All right. Thank you. I have no further questions.

17 The Petitioner can move forward with your rebuttal.

18 DR. MARKOWSKI: Thank you, Your Honors. Just a few points
19 that I did want to raise. And it's notable that Patent Owner's counsel
20 indicated that column 4, lines 20 through 22, indicate a particular road. That
21 is, there is a discernment in Crane regarding individual roads within its
22 network.

23 And another point I want to raise is that Patent Owner did, in fact,
24 discuss the road network 155 that includes roads 152. That was why,
25 originally, I had pointed Your Honors to Element 1.4.

26 If you go to page 31 of the petition, we have as the last full paragraph

1 minus the last sentence on that page, where we recited, "Crane discloses
2 providing a location information database such as a geographic database
3 172." This is all in reference to the flowchart that we discussed earlier with
4 respect to Figure 4 of the Crane disclosure, containing latitude and longitude
5 information for a plurality of points, such as data 174, representing the
6 coordinates of the points along the roads 152 that form the road network
7 155, represented by the geographic database 172.

8 And they even have citation to Crane at column 3, lines 45 through
9 48. As you'll note, it includes a discussion or a recitation of a road network.

10 And as Your Honors adeptly had pointed out to Patent Owner's counsel,
11 there is no difference between a road network 155 and a plurality of roads.
12 Therefore, for this document, this Crane disclosure to make any sense, there
13 must be some distinguishment between a road network 155 and individual
14 roads 152. They can't be one and the same.

15 And what's instructive is this Petitioner's position with respect to how
16 Crane's disclosures should be understood was actually something that was
17 advanced by our expert. And this is how our expert had understood the
18 Crane disclosure. Each road 152 makes up a road network 155, and that
19 explains how a person of ordinary skill in the art would have read and
20 understood the Crane disclosure, as opposed to Patent Owner's attorney
21 argument regarding how Crane should be understood and characterized, and
22 therefore, applied to the challenged claims.

23 One other point I did want to bring to the Court's attention, again,
24 related to procedural history here, is Patent Owner's counsel had indicated
25 that only Claims 12, 13, 21, and 22 are live or pending. However, all of the
26 asserted, all of the challenged claims here are live for the purposes of this

1 present proceeding because neither the District Court, nor Patent Owner, and
2 I believe any kind of duty of candor discussions with the Patent Office, has
3 alerted the Patent Office by filing any document that we've been able to
4 observe through the documents and transactions aspect of Patent Center that
5 at least Claim 11 was found to be invalidated by the District Court and was
6 not appealed, should be disclaimed from the patent.

7 And as I mentioned earlier on, in Patent Owner's preliminary
8 response, at page 5, footnote 2, Patent Owner admits that all of the claims
9 (audio interference) for patent, including and they highlight independent
10 Claims 1 and 12, are invalid for the same indefiniteness reasons. Having
11 provided that information, that admission, to the Patent Office Appeals
12 Board, it is our position that this should also have been, likewise, transmitted
13 and communicated to the Patent Center folks who include a record for the
14 public regarding the validity of claims that exist in patents that are issued by
15 the Patent Office. So, it is not just --

16 JUDGE RANGE: This is Judge Range. Can you say again where
17 that admission is at you just referred to?

18 DR. MARKOWSKI: Yes. It is at page 5, footnote 2, of the Patent
19 Owner preliminary response. And I'll just grab that, Your Honor.

20 JUDGE RANGE: Okay. Oh, that's fine. I can pull it up.

21 DR. MARKOWSKI: Yes.

22 JUDGE RANGE: Thank you.

23 DR. MARKOWSKI: And at line 4 of that footnote, it said, it refers
24 to Exhibit 1001, which is the '784 patent, and calls out Claims 1 and 12,
25 which are the independent claims, and specifically, the claim terms that were
26 found to be indefinite, and therefore, incorporated into all of the dependent

1 claims of the '784 patent.

2 And that's why, at line 3 of that same footnote, Patent Owner admits
3 that these limitations are part of every claim in the '784 patent, and therefore,
4 none of these claims should be referred to as valid claims because the terms
5 found in the independent claims were found to be indefinite.

6 So, those are the only two points that I wanted to bring to the Board's
7 attention. Otherwise, again, I make myself available for any questions that
8 the Board may have.

9 JUDGE RANGE: I have no further questions.

10 JUDGE McSHANE: No questions. Thank you.

11 DR. MARKOWSKI: Thank you, Your Honors.

12 JUDGE RANGE: Thank you.

13 Patent Owner, you may proceed with your surrebuttal.

14 MR. ABIDIN: Thank you, Your Honor. In response to the
15 discussion about 155, we would like to point out that 155 can represent the
16 network, overall network, while 152 is a plurality of roads within that
17 network. So, they don't necessarily mean the same thing, as proposed by
18 Petitioner.

19 In addition, we are not handling prosecution and will reach out to the
20 prosecution counsel to determine what needs to be disclosed to the Patent
21 Office in response to Petitioner's comments today at the hearing. And we
22 ask the Board to confirm all the challenged claims for the reasons stated
23 previously in the hearing today.

24 Thank you.

25 JUDGE RANGE: Thank you. To the extent Patent Owner is going
26 to disclaim any claims, just from my personal perspective, I appreciate you

1 doing it sooner rather than later. So, I don't have to address a claim that
2 doesn't matter anymore.

3 MR. ABIDIN: Understood, Your Honor.

4 JUDGE RANGE: Thank you. And I have no further questions.
5 Any further questions?

6 JUDGE McSHANE: No, no questions. Thank you.

7 JUDGE SCANLON: No questions for me. Thank you.

8 JUDGE RANGE: I would like to thank everyone participating in the
9 hearing. Everyone did a great job explaining the issues at hand. And I
10 especially appreciate use of a LEAP practitioner and seeing someone
11 gaining that good experience.

12 MR. McBRIDE: Thank you, Your Honors.

13 MR. ABIDIN: Thank you, Your Honors.

14 JUDGE RANGE: Thank you. We can go off the record.

15 (Whereupon, the above-entitled matter went off the record at 10:54
16 a.m.)

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