

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

GEOSCOPE TECHNOLOGIES PTE. LTD.
Patent Owner

Case No. IPR2023-01214
U.S. Patent No. 8,320,264

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. THE BOARD SHOULD EXERCISE ITS DISCRETION AND DENY THIS PETITION UNDER §314(A)	2
a. Factor 1: The district court case has concluded, and cannot be stayed	5
b. Factor 2: The Board’s final written decision deadline would be more than one year after the district court issued its final judgment.....	6
c. Factor 3: There has been substantial investment by the parties and district court in the litigation, culminating in a final decision by the court	6
d. Factor 4: There is substantial overlap between the issues raised in the petition and in the district court	9
e. Factor 5: Petitioner and the defendant in the district court litigation are the same party	10
f. Factor 6: Other circumstances weigh in favor of exercising discretion to deny institution, including the merits	10
III. OVERVIEW OF THE ’264 PATENT	11
IV. SUMMARY OF THE REFERENCES ASSERTED IN THE PETITION.....	13
A. Almgren	13
B. Haartsen	14
V. LEVEL OF ORDINARY SKILL IN THE ART	14
VI. CLAIM CONSTRUCTION.....	15

VII. PETITIONER FAILS TO SHOW A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CHALLENGED CLAIM.....	15
VIII. CONCLUSION.....	19

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)	<i>passim</i>
<i>AviaGames, Inc. v. Skillz Platform, Inc.</i> , IPR2022-00530, Paper 14 (PTAB Mar. 2, 2023)	4, 10
<i>CommScope Technologies LLC v. Dali Wireless, Inc.</i> , IPR2022-01242, Paper 23 (PTAB Feb. 27, 2023)	3, 4, 11
<i>Mylan Laboratories Ltd. v. Janssen Pharmaceutica NV</i> , IPR2020-00440, Paper 17 (PTAB Sept. 16, 2020)	8
<i>NHK Spring Co., Ltd. v. Intri-Plex Technologies, Inc.</i> , IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018)	2, 5, 6

Statutes

35 U.S.C. § 314(a)	1, 2, 4, 11
--------------------------	-------------

LIST OF EXHIBITS

Exhibit No.	Petitioner's Exhibits
1001	U.S. Patent No. 8,320,264, issued on November 27, 2012 ("the '264 Patent")
1002	File History of U.S. Patent Application No. 11/920,076, filed on December 15, 2008 ("the '076 Application")
1003	U.S. Provisional Application No. 60/681,475, filed on May 17, 2005
1004	U.S. Patent No. 6,137,993, issued on October 24, 2000 to M. Almgren and M. Frodigh ("Almgren")
1005	U.S. Patent No. 5,491,837, issued on February 13, 1996 to J. Haartsen ("Haartsen")
1006	U.S. Patent No. 6,498,932, issued on December 24, 2002 to M. Silventoinen and H. Posti ("Silventoinen")
1007	U.S. Patent No. 6,184,829, issued on February 6, 2001 to L. Stilp ("Stilp")
1008	Declaration of David Hilliard Williams
1009	Curriculum Vitae of David Hilliard Williams
1010	U.S. Patent No. 5,917,811, issued on June 29, 1999 to L. Weaver et al. ("Weaver")
1011	U.S. Patent No. 5,023,900, issued on June 11, 1991 to D. Tayloe et al. ("Tayloe")
1012	Complaint dated November 22, 2022, <i>Geoscope Technologies Pte. Ltd. v. Google LLC f/k/a Google Inc.</i> , Civ. Action No.
1013	Preliminary Identification of Asserted Claims dated March 27, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC f/k/a Google</i>

	<i>Inc.</i> , Civ. Action No. 1:22-cv-01331 (EDVA) filed on November 22, 2022
1014	U.S. Patent Application Publication No. 2005/0271012, published on December 8, 2005 to A. Agrawal et al. (“Agrawal”)
1015	U.S. Patent Application Publication No. 2002/0172160, published on November 21, 2002 to T. Mouldsley (“Mouldsley”)
1016	U.S. Patent Application Publication No. 2002/0172223, published on November 21, 2002 to L. Stilp
1017	U.S. Patent No. 6,751,187, issued on June 15, 2004 to J. Walton and J. Ketchum (“Walton”)
1018	U.S. Patent No. 6,522,888, issued on February 18, 2003 to J. Garceran et al. (“Garceran”)
1019-1022	Not Assigned
1023	Stipulation Regarding Agreed Upon Claim Constructions dated May 23, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC f/k/a Google Inc.</i> , Civ. Action No. 1:22-cv-01331 (EDVA) filed on November 22, 2022
1024	Plaintiff Geoscope Technologies PTE. LTD.’s Opening Claim Construction Brief dated May 26, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC f/k/a Google Inc.</i> , Civ. Action No. 1:22-cv-01331 (EDVA) filed on November 22, 2022
1025-1027	Not Assigned
1028	Claim Construction Memorandum Opinion & Order dated July 19, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC f/k/a Google Inc.</i> , Civ. Action No. 1:22-cv-01331 (EDVA) filed on November 22, 2022

	Patent Owner's Exhibits
2001	Declaration of Christopher M. Gerson in Support of Patent Owner's Motion for Pro Hac Vice Admission of Christopher M. Gerson Under 37 C.F.R. § 42.10(c)
2002	<i>Not Assigned</i>
2003	Memorandum Opinion on Google's Motion for Judgment on the Pleadings on Patent Eligibility dated September 18, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC</i> , Civ. Action No. 1:22-cv-01331 (EDVA)
2004	Memorandum Opinion on Apple's Motion for Judgment on the Pleadings on Patent Eligibility dated September 18, 2023, <i>Geoscope Technologies Pte. Ltd. v. Apple Inc.</i> , Civ. Action No. 1:22-cv-01373 (EDVA)
2005	Final Judgment dated October 6, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC</i> , Civ. Action No. 1:22-cv-01331 (EDVA)
2006	Final Judgment dated October 5, 2023, <i>Geoscope Technologies Pte. Ltd. v. Apple Inc.</i> , Civ. Action No. 1:22-cv-01373 (EDVA)
2007	Order dated June 26, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC</i> , Civ. Action No. 1:22-cv-01331 (EDVA)
2008	Email from Saunak Desai to Stephen E. Noona, "Geoscope v. Google - Claim Narrowing" (June 12, 2023)
2009	Claim Construction Memorandum Opinion & Order dated July 19, 2023, <i>Geoscope Technologies Pte. Ltd. v. Apple Inc.</i> , Civ. Action No. 1:22-cv-01373 (EDVA)
2010	Order dated June 26, 2023, <i>Geoscope Technologies Pte. Ltd. v. Apple Inc.</i> , Civ. Action No. 1:22-cv-01373 (EDVA)
2011	Defendant Google LLC's Final Invalidity Contentions dated July 3, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC</i> , Civ. Action No. 1:22-cv-01331 (EDVA)

2012	Geoscope’s Opening Appeal Brief dated November 17, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC, Apple Inc.</i> , Case Nos. 24-1003 (Lead) 24-1018 (member) (Fed. Cir.)
2013-2017	<i>Not Assigned</i>
2018	Stipulation of Partial Judgment of Noninfringement and Invalidity dated August 22, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC</i> , Civ. Action No. 1:22-cv-01331 (EDVA)
2019	Order dated September 18, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC</i> , Civ. Action No. 1:22-cv-01331 (EDVA)
2020	Partial Judgment dated September 18, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC</i> , Civ. Action No. 1:22-cv-01331 (EDVA)
2021	Stipulation of Partial Judgment of Noninfringement and Invalidity dated August 15, 2023, <i>Geoscope Technologies Pte. Ltd. v. Apple Inc.</i> , Civ. Action No. 1:22-cv-01373 (EDVA)
2022	Order dated September 18, 2023, <i>Geoscope Technologies Pte. Ltd. v. Apple Inc.</i> , Civ. Action No. 1:22-cv-01373 (EDVA)
2023	Partial Judgment dated September 18, 2023, <i>Geoscope Technologies Pte. Ltd. v. Apple Inc.</i> , Civ. Action No. 1:22-cv-01373 (EDVA)
2024	Docketing Statement dated October 16, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC</i> , Case No. 24-1003 (Fed. Cir.)

I. INTRODUCTION

The Board should deny the Petition for *Inter Partes* Review of U.S. Patent No. 8,320,264 (“’264 Patent”) because Petitioner Google LLC (“Petitioner”) fails to demonstrate a reasonable likelihood that any challenged claim is not patentable.

As an initial matter, the Board should exercise its discretion to deny the Petition under § 314(a). Two district court litigations involving the ’264 Patent have already resulted in final judgments. These litigations are *Geoscope Technologies Pte. Ltd. v. Google LLC.*, Civ. Action No. 1:22-cv-01331-MSN (E.D. Va.) (“Google Action”) and *Geoscope Technologies Pte. Ltd. v. Apple Inc.*, Civ. Action No. 1:22-cv-01373-MSN (E.D. Va.) (“Apple Action”). Moreover, by the time the district court entered final judgment, the parties and the court had already invested substantial resources into the actions, completing *Markman*, fact discovery, and expert discovery. Thus, institution would not be an efficient use of the Board’s time and resources. Further, the Petition falls far short of presenting a “compelling unpatentability challenge” that would warrant institution despite this inefficiency.

Even if the merits are considered, the Petition still fails. At a minimum, Petitioner fails to show that its cited art teaches or suggests “without disabling any other communication channel,” as required by every independent claim of the ’264 Patent. The disclosure that Petitioner relies on is inconsistent with the language of the challenged claims of the ’264 Patent and the purpose of the patented invention.

Thus, the Board should deny institution.

II. THE BOARD SHOULD EXERCISE ITS DISCRETION AND DENY THIS PETITION UNDER §314(A)

The Board should exercise its discretion to deny institution under § 314(a) because institution would be an “inefficient use of Board resources.” *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19-20 (PTAB Sept. 12, 2018). As explained in further detail below, two district court litigations involving the ’264 Patent are not just at advanced stages but, in fact, have ***already resulted in final judgments***.

In *NHK Spring Co.*, the Board denied institution of an *inter partes* review under § 314(a) where a parallel district court proceeding was nearing its final stages, and a PTAB proceeding would not conclude until about six months after the district court trial was scheduled. *NHK Spring Co.*, IPR2018-00752, Paper 8 at 19-21. In so reasoning, the Board set the precedent that parallel court proceedings must be considered when determining whether the institution of an *inter partes* review is consistent with the objective of the America Invents Act (“AIA”) to “provide an effective and efficient alternative to district court litigation.” *Id.*

Building on *NHK Spring Co.*, in *Apple Inc. v. Fintiv, Inc.*, the Board identified specific factors relating to “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential).

The *Fintiv* factors include:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Id.

The Director provided further guidance on the application of the *Fintiv* precedent in a June 21, 2022 Memorandum regarding an Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (“Guidance Memo”) and *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 (PTAB Feb. 27, 2023) (precedential). The Director set forth a “compelling merits test” under which the Board—if it has found that *Fintiv* factors 1-5 favor discretionary denial—must assess whether a petition presents a “compelling unpatentability challenge” before discretionarily denying institution. *CommScope*, IPR2022-01242, Paper 23 at 3-5. As the Director explained, “the compelling merits standard is a higher standard than the standard for institution set

by statute.”¹ *Id.* at 3. A reasonable likelihood that the petitioner would prevail with respect to at least one challenged claim does not suffice to demonstrate that a challenge is “compelling.” Rather, a “compelling” challenge is one “in which the evidence, if unrebutted at trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence” such that “it is **highly likely** that the petitioner would prevail with respect to at least one challenged claim.” *Id.* at 3-4 (emphasis added). This is a “high standard” (see *AviaGames, Inc. v. Skillz Platform, Inc.*, IPR2022-00530, Paper 14, at 3, 5 (PTAB Mar. 2, 2023)) and the Board must explain its reasoning in determining whether the merits are compelling. *CommScope*, IPR2022-01242, Paper 23 at 4-6.

As discussed below, the *Fintiv* factors weigh strongly in favor of discretionary denial and Petitioner’s challenge does not meet even the statutory standard, let alone the higher “compelling merits” standard. Thus, the Board should exercise its discretion to deny institution under § 314(a). On October 5, 2023 and October 6, 2023, the district court issued final judgments in both the Google and Apple Actions.

¹ Institution of an IPR is authorized only when “the information presented in the petition ... and any response ... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

Exs. 2005, 2006. Prior to that, on August 22, 2023, Petitioner and Patent Owner stipulated to partial judgment of non-infringement of the '264 Patent in view of the district court's claim construction. Ex. 2018 ¶¶ 5-6. The district court accepted the stipulation on September 18, 2023 (Ex. 2019) and partial judgment was entered on the same day (Ex. 2020). This stipulation of non-infringement of the '264 Patent and partial judgment were also entered in the Apple Action. Ex. 2021 ¶¶ 5-6; Ex. 2022; Ex. 2023.

Both actions are closed pending Patent Owner's appeal to the Federal Circuit. Patent Owner's appeal does not involve the '264 Patent. Ex. 2024 (Docketing Statement for Patent Owner's appeal indicating that the '264 Patent is not at issue on appeal); *see also* Ex. 2012 at 8.

a. Factor 1: The district court case has concluded, and cannot be stayed

“A district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts,” and thus “weigh[s] against exercising the authority to deny institution under *NHK*.” *Fintiv*, IPR2020-00019, Paper 11 at 6.

Although Petitioner contends it “will seek a pre-institution stay” (Pet. at 69), it has not filed any motion to stay the Google Action in view of the instant Petition. Nor could it because the district court proceedings are closed pending Patent Owner's appeal to the Federal Circuit. Accordingly, contrary to Petitioner's

assertion, there is no need to “predict whether the district court will stay related litigation”—the district court *cannot* stay the litigation given the posture. Pet. at 69. Thus, this factor weighs in favor of exercising discretion to deny institution.

b. Factor 2: The Board’s final written decision deadline would be more than one year after the district court issued its final judgment

As demonstrated by *NHK* and its progeny, “[i]f the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Fintiv*, IPR2020-00019, Paper 11 at 9. The district entered final judgment in October 2023, months before the Board would even institute review, much less issue a final written decision. There is no further scheduled or proposed trial date in the Google Action. Accordingly, the Board should find that this factor weighs in favor of denial of institution.

c. Factor 3: There has been substantial investment by the parties and district court in the litigation, culminating in a final decision by the court

“[I]f, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition, this fact favors denial.” *Fintiv*, IPR2020-00019, Paper 11 at 9-10.

The Google Action is concluded as a result of the district court’s claim construction ruling and § 101 ruling as to other asserted patents. At least the claim

construction ruling is a substantive order related to the '264 Patent, which favors denial of institution.² Ex. 1028 at 30-34.

Even before the district court issued its claim construction and § 101 rulings, the parties and district court had already made a substantial investment in the litigation. Fact and expert discovery in the Google Action were completed prior to the district court's § 101 ruling and nearly completed even before the Petition was filed on August 9, 2023. *See* Ex. 2007 (setting July 3, 2023 deadline for opening expert reports and August 18, 2023 deadline for close of expert discovery). This completed discovery included extensive written discovery, numerous depositions of fact and expert witnesses, and expert reports.

Contrary to Petitioner's assertions of diligence (*see* Pet. at 71), Petitioner waited until *after* the parties and the court invested significant resources in the case to file the Petition. Petitioner contends that it "filed its Petition less than three months after being made aware of the full set of asserted claims." *Id.* This contradicts the record. The Petition challenges every asserted claim identified in Patent Owner's

² Although Petitioner also contended that the claims of the '264 Patent are unpatentable under § 101, the district court's § 101 ruling did not address the '264 Patent due to the parties' prior stipulation of non-infringement in view of the district court's claim construction ruling. Ex. 2003 at 1 n.1.

preliminary identification of asserted claims, served on March 27, 2023. Ex. 1013; *see also* Pet. at 6 (identifying challenged claims). Although Patent Owner narrowed its assertion of claims on June 12, 2023, that apparently had no bearing on the Petition, which challenges far more claims than were identified as asserted on that date. Ex. 2008. Thus, Petitioner’s contention that its purported “diligence in filing its Petition outweighs any investment” in the litigation is incorrect.

Moreover, the district court and Patent Owner also made a substantial investment in the Apple Action, another litigation involving the ’264 Patent.³ The same substantive orders—a *Markman* order and § 101 ruling—were issued by the district court in the Apple Action. Exs. 2004, 2009. And fact and expert discovery

³ Although Petitioner is not a party to the Apple Action, the Board has recognized that discretionary denial under the *Fintiv* factors can be based on a district court litigation involving the same challenged patent even if Petitioner is not a party to that case. For example, in *Mylan Laboratories Ltd. v. Janssen Pharmaceutica NV*, IPR2020-00440, Paper 17 (PTAB Sept. 16, 2020), the Board denied institution after evaluating the *Fintiv* factors for two related litigations involving the challenged patent—one between the patent owner and the petitioner (referred to as the “Mylan litigation”) and one between the patent owner and a different defendant (referred to as the “Teva litigation”). *Id.* at 9-11, 25.

were also completed in the Apple Action prior to the district court’s § 101 ruling in September 2023. Ex. 2010 (setting July 3, 2023 deadline for opening expert reports and August 18, 2023 deadline for close of expert discovery). Again, Petitioner chose to file the Petition *after* these parties and the district court invested substantial resources in the case.

Thus, even aside from the district court’s substantive claim construction ruling related to the ’264 Patent, there has been substantial investment by the parties and the district court in the Google Action (and the Apple Action). Accordingly, this factor weighs heavily in favor of denying institution.

d. Factor 4: There is substantial overlap between the issues raised in the petition and in the district court

Fintiv states that “if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial,” and if “other circumstances weigh against redoing the work of another tribunal, the Board may, nonetheless, exercise the authority to deny institution.” *Fintiv*, IPR2020-00019, Paper 11 at 12, 14.

The primary prior art references relied on by Petitioner for this proceeding—Almgren and Haartsen—are also relied on by Petitioner in the Google Action. Ex. 2011 at 29 (identifying Almgren and Haartsen as prior art asserted against the ’264 Patent in Petitioner’s Final Invalidity Contentions in the Google Action). Thus, there is significant overlap between Petitioner’s invalidity arguments in this proceeding

and its invalidity arguments in the district court. Further, the record pertaining to these invalidity arguments has already been developed in the district court, including through hundreds of pages of expert reports. Petitioner does not address this factor—and the clear overlap in arguments—beyond stating that it “reserves the right” to file a stipulation in the Google Action. Pet. at 72. But the Google Action is closed pending Patent Owner’s appeal of other issues that do not involve the ’264 Patent.

It is an inefficient use of the Board’s resources to develop a record that has already been developed in the Google Action in order to assess the validity of the ’264 Patent. Thus, this factor weighs in favor of denying institution.

e. Factor 5: Petitioner and the defendant in the district court litigation are the same party

The petitioner here and the defendant in the district court litigation are both Google LLC—in other words, identical. This was true in *Fintiv*, *Snap*, and *AviaGames*. Therefore, this factor weighs in favor of denying institution.

f. Factor 6: Other circumstances weigh in favor of exercising discretion to deny institution, including the merits

The “factors considered in the exercise of discretion” are part of a “balanced assessment of all the relevant circumstances in the case, including the merits.” *Fintiv*, IPR2020-00019, Paper 11 at 14. “[I]f the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present.” *Id.* at 15.

As discussed in the merits sections below, each ground is lacking at least because Almgren and Haartsen fail to teach “without disabling any other communication channel” as required by every independent claim of the ’264 Patent. *Infra* § VII. Thus, at best, the merits in this case fall into the camp of a “closer call,” not in Petitioner’s favor. At a minimum, the merits fall far short of satisfying the “compelling merits test” which presents a “higher standard than the standard for institution set by statute,” requiring that it be “highly likely that the petitioner would prevail with respect to at least one challenged claim.” *CommScope*, IPR2022-01242, Paper 23 at 3-5.

Because institution of any ground raised in the Petition would be an inefficient use of the Board’s resources—as evidenced by all six *Fintiv* factors—and the Petition fails to satisfy the “compelling merits test,” the Board should exercise its discretion under § 314(a) to deny institution.

III. OVERVIEW OF THE ’264 PATENT

The ’264 Patent is directed to a method and system for “determining a path loss value of a signal transmitted from a wireless device and received by a receiver” where the “wireless device and the receiver operate within a wireless communication system.” Ex. 1001 at Abstract, cl. 1. As the ’264 Patent explains, “[p]ath loss is a measure of signal attenuation” constituting “the difference between the transmitted signal power and the received signal power.” *Id.* at 1:19-21. Path loss can be used in

connection with geolocating mobile devices as these devices can receive a number of different types of signals from various transmitters and use path loss values to determine their position in relation to those transmitters, or such information can be used to generate and update location models used as part of calculating the location of a mobile device.

The claimed invention of the '264 Patent improved on prior art systems which “determine[d] the path loss value by assigning a dedicated frequency channel to the wireless device and disabling interfering frequency channels within the wireless communication system” because “[s]etting aside a dedicated frequency channel also requires revising the frequency use plan for the entire geographic area which is costly and inefficient.” *Id.* at 3:39-45. The '264 Patent is directed to a method and system for “determining a path loss value of a signal transmitted by a wireless device and received by a receiver” that involve allowing such a determination while the wireless device and receiver are actively communicating and, importantly, without disabling any other communication channel. Ex. 1001 at cl. 1. As the '264 Patent explains, “[b]y using an active communication channel, the path loss measurement can be conducted without disrupting an existing frequency use plan to allocate a specific frequency channel for path loss calculations” and “the results can be as reliable as using a dedicated frequency channel for beacon signaling.” *Id.* at 4:60-67.

IV. SUMMARY OF THE REFERENCES ASSERTED IN THE PETITION⁴

A. Almgren

Almgren describes a method and apparatus “for estimating path loss in a radio communication system.” Ex. 1004 at Abstract. Almgren explains that it “addresses a problem of how path loss on different connections in a mobile radio communications system can be estimated from values of transmitted and received power levels on radio channels.” *Id.* at 2:51-55. Almgren further explains that the problems it purportedly addresses are “solved by measuring the power level received by a base station receiver or a mobile station receiver on a certain, or given, radio channel.” *Id.* at 2:66-3:1. “The transmission power levels of those mobile station transmitters or base stations that use this radio channel are known.” *Id.* at 3:1-3.

Almgren also describes “selecting a radio channel and determining the power level at which those transmitters that send on the radio channel transmit.” *Id.* at 3:15-17. Then, “[t]he power level received on said radio channel in a number of receivers

⁴ Petitioner has only relied upon Almgren and Haartsen for the limitations addressed in this Preliminary Response. *See* Pet. at 25-26, 39, 45, 53, 62, 66. Accordingly, Patent Owner only provides summaries of those two references herein. Patent Owner does not concede that any other reference cited by Petitioner has any disclosure relevant to the issues in the Petition.

in the radio communications is measured.” *Id.* at 3:18-19. Thus, Almgren describes using a particular radio channel for path loss measurements.

B. Haartsen

Haartsen describes a “method and system for the adaptive allocation of channels within a radio communication system.” Ex. 1005 at Abstract. Haartsen explains that the “channel allocation scheme described by this invention makes use of periodic measurements performed both by one or more base stations and/or by one or more mobile stations to determine the best channel under the current radio environment.” *Id.* at 5:31-35. This first involves an “acquisition phase” which “begins with measurements of the signal power of the pilot signals broadcast from surrounding base stations.” *Id.* at 5:51-53. “These measurements are performed by the mobile station which ... periodically measures the received signal strength (RSSI) of a number of individual pilot signals transmitted from surrounding base stations.” *Id.* at 5:53-57. The measurements of these pilot signals can then be “used to calculate the path losses between the base stations whose signals were measured and the mobile station performing the measurements.” *Id.* at 7:5-8. Accordingly, Haartsen describes using dedicated pilot signals for path loss measurements.

V. LEVEL OF ORDINARY SKILL IN THE ART

Patent Owner adopts Petitioner’s definition of a person of ordinary skill in the art (“POSITA”) for the purposes of this Preliminary Response. Patent Owner

reserves the right to present arguments on the definition should the Petition be instituted.

VI. CLAIM CONSTRUCTION

Patent Owner does not dispute Petitioner's statement on claim construction for the purposes of this Preliminary Response. Patent Owner reserves the right to present arguments on the constructions should the Petition be instituted.

VII. PETITIONER FAILS TO SHOW A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CHALLENGED CLAIM

To the extent the Board considers the merits of the Petition, the Petition fails to demonstrate that Almgren or Haartsen, alone or in view of the other references in the Petition, anticipates or renders obvious any of the challenged claims.

In particular, all of the challenged claims of the '264 Patent require performing the claimed method (or a system performing the claimed steps) "without disabling any other communication channel." Ex. 1001 at cls. 1, 3, 6, 11, 13, 15, 20, 21, 23, 25-27. There is no disclosure in Almgren or Haartsen that teaches or suggests this limitation. And Petitioner does not even contend that its other references teach or suggest this limitation as it points to nothing from them in connection with this limitation.⁵ See Pet. at 25-26, 39, 45, 53, 62, 66.

⁵ As Petitioner did not identify any disclosure in its other asserted references relevant to this limitation, they are not addressed below. Patent Owner does not concede that

First, Petition fails to show that Almgren teaches “without disabling any other communication channel.” Without actually proposing a construction (*see* Pet. at 12-14), Petitioner asserts that this claim language “encompasses not dedicating a specific frequency channel for measuring path loss.” Pet. at 25.⁶ Thus, Petitioner ignores the claim language as written and attempts to swap in a different meaning without proposing that as a construction. Petitioner does not attempt to show that Almgren teaches this limitation as written. Thus, Petitioner’s argument fails for this reason alone.

Even if Petitioner’s argument as to what “without disabling any other communication channel” “encompasses” (Pet. at 25) is accepted, Petitioner still fails to show that Almgren teaches this limitation. Petitioner relies on Almgren’s disclosure that “it is possible to estimate interference of any connections that may be set up on different radio channels” as meaning “no channels are disabled” but fails to show any relation between these two concepts. Pet. at 26 (citing Ex. 1004 at

these references have any disclosure relevant to the issues in the Petition.

⁶ Petitioner’s arguments based on Almgren for claims 13 and 23 of the ’264 Patent only refer back to Petitioner’s arguments based on Almgren for claim 1 of the ’264 Patent. *See* Pet. at 39, 45. Thus, for the same reasons, Petitioner’s arguments based on Almgren fail for those claims as well.

18:6-15). This language in Almgren only shows that multiple radio channels exist and may be used as part of a radio communications system but does not describe how signals used for path loss measurements are acquired. The '264 Patent claims are directed to determining path loss values using signals acquired as part of active communication between a wireless device and receiver, without disabling any other communication channels. Petitioner does not show how Almgren teaches not disabling other communication channels while acquiring signals for path loss measurements. Rather, the language Petitioner points to is about communications that occur after such path loss measurements are made.

Moreover, Almgren refers to using dedicated channels for path loss measurements but Petitioner disregards these disclosures. For example, Almgren explains that “the power level received by a base station receiver or a mobile station receiver” is measured “on a certain, or given, radio channel.” Ex. 1004 at 2:66-3:1. Thus, even under Petitioner’s interpretation of “without disabling any other communication channel,” Almgren still fails to teach this limitation. Accordingly, Petitioner fails to show that Almgren anticipates or renders obvious the challenged claims for at least this reason.

Second, Petitioner fails to show that Haartsen teaches “without disabling any other communication channel.” Again, without proposing a construction (*see* Pet. at 12-14), Petitioner treats this claim language as only requiring that a “dedicated

frequency channel” not be used. *See* Pet. at 53-54.⁷ For the same reason explained above, Petitioner’s argument fails for this reason alone because Petitioner does not attempt to show that Haartsen teaches this limitation as written.

Even if Petitioner’s interpretation of “without disabling any other communication channel” is accepted, Petitioner still fails to show that Haartsen teaches this limitation. As Petitioner acknowledges, Haartsen describes the use of pilot signals transmitted on particular channels for path loss measurements. *See, e.g.*, Ex. 1005 at 5:37-40 (“In the following description, it is assumed that each base station transmits a pilot signal (i.e., a set-up or control channel) at a known frequency and of a known power level.”), 5:51-53 (“The acquisition phase 410 begins with measurements of the signal power of the pilot signals broadcast from surrounding base stations.”). Thus, Haartsen describes the use of dedicated frequency channels for path loss measurements which fails to meet “without disabling any other communication channel,” even under Petitioner’s interpretation of that language. Accordingly, Petitioner fails to show that Haartsen anticipates or renders obvious

⁷ Petitioner’s arguments based on Haartsen for claims 13 and 23 of the ’264 Patent only refer back to Petitioner’s arguments based on Haartsen for claim 1 of the ’264 Patent. *See* Pet. at 62, 66. Thus, for the same reasons, Petitioner’s arguments based on Haartsen fail for those claims as well.

the challenged claims for at least this reason.

VIII. CONCLUSION

Petitioner fails to show that institution is warranted. As explained above, institution would require an inefficient use of the Board's resources. A district court has already reached final judgments in two litigations involving the '264 Patent. Moreover, these final judgments came after the parties and the district court had already invested substantial resources in the Google Action. The Petition falls far short of presenting a "compelling unpatentability challenge" that would warrant proceeding despite the advanced stage of the Google Action.

Even if the Board reaches the merits under the lower "reasonable likelihood" standard, denial is still warranted. Petitioner's sole ground fails to demonstrate that the asserted prior art teaches every limitation of the challenged claims. For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution.

Dated: November 22, 2023

Respectfully submitted,

/Ryan J. Singer/

Ryan J. Singer
Registration No. 79,736
Lead Counsel for Patent Owner
Christopher M. Gerson
Pro Hac Vice
Backup Counsel for Patent Owner
SCHULTE ROTH & ZABEL LLP
919 Third Avenue
New York, New York 10022
Tel: (212) 756-2000
Fax: (212) 593-5955
ryan.singer@srz.com
chris.gerson@srz.com

*Counsel for Patent Owner
Geoscope Technologies Pte. Ltd.*

CERTIFICATE OF COMPLIANCE

The undersigned certifies that this brief complies with the type-volume limitations of 37 CFR § 42.24(a)(1)(i). This brief contains 4,429 words as calculated by the “Word Count” feature of Microsoft Word, the word processing program used to create it. The undersigned further certifies that this brief complies with the typeface requirements of 37 CFR § 42.6(a)(2)(ii) and typestyle requirements of 37 CFR § 42.6(a)(2)(iii). This brief has been prepared in a proportionally spaced typeface using Microsoft Word in Times New Roman 14 point font.

Dated: November 22, 2023

/Ryan J. Singer/
Ryan J. Singer
Registration No. 79,736
Lead Counsel for Patent Owner
Christopher M. Gerson
Pro Hac Vice
Backup Counsel for Patent Owner
SCHULTE ROTH & ZABEL LLP
919 Third Avenue
New York, New York 10022
Tel: (212) 756-2000
Fax: (212) 593-5955
ryan.singer@srz.com
chris.gerson@srz.com

Counsel for Patent Owner
Geoscope Technologies Pte. Ltd.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Patent Owner's Preliminary Response**, was served on November 22, 2023 via email directed to counsel of record for the Petitioner at the following address of record as listed on PAIR:

Lead Counsel:

Patrick C. Keane, Esq.
Registration No. 32,858
BUCHANAN INGERSOLL &
ROONEY PC
1737 King Street, Suite 500
Alexandria, Virginia 22314
Direct Telephone (703) 838-652 2
Main Facsimile (703) 836-2021
patrick.keane@bipc.com

Backup Counsel:

Matthew L. Fedowitz, Esq.
Registration No. 61,386
BUCHANAN INGERSOLL &
ROONEY PC
1700 K Street, NW, Suite 300
Washington, DC 20006
Direct Telephone (202) 452-7306
Main Facsimile (202) 452-7989
matthew.fedowitz@bipc.com

Backup Counsel:

Mythili Markowski, Ph.D., Esq.
Registration No. 67,063
BUCHANAN INGERSOLL &
ROONEY PC
1700 K Street, N.W., Suite 300
Washington, DC 20006

Backup Counsel:

Roger H. Lee, Esq.
Registration No. 46,317
BUCHANAN INGERSOLL &
ROONEY PC
1737 King Street, Suite 500
Alexandria, Virginia 22314
Direct Telephone (703) 838-6545
Main Facsimile (703) 836-2021
roger.lee@bipc.com

Backup Counsel:

Andrew R. Cheslock, Esq.
Registration No. 68,577
BUCHANAN INGERSOLL &
ROONEY PC
1737 King Street, Suite 500
Alexandria, VA 22314
Direct Telephone (703) 838-6523
Main Facsimile (703) 836-2021
andrew.cheslock@bipc.com

Backup Counsel:

Samuel Harrod, Esq.
Registration No. 79,148
BUCHANAN INGERSOLL &
ROONEY PC
Union Trust Building,
501 Grant Street, Suite 200

Direct Telephone (202) 452-7314
Main Facsimile (202) 452-7989
mythili.markowski@bipc.com

Pittsburgh, PA 15219
Direct Telephone (412) 562-8805
Main Facsimile (412) 562-1041
samuel.harrod@bipc.com

Backup Counsel:

Ralph G. Fischer, Esq.
Registration No. 55,179
BUCHANAN INGERSOLL &
ROONEY PC
Union Trust Building
501 Grant Street, Suite 200
Pittsburgh, PA 15219
Direct Telephone (412) 392-2121
Main Facsimile (412) 562-1041
ralph.fischer@bipc.com

Dated: November 22, 2023

/Ryan J. Singer/

Ryan J. Singer
Registration No. 79,736
Lead Counsel for Patent Owner
Christopher M. Gerson
Pro Hac Vice
Backup Counsel for Patent Owner
SCHULTE ROTH & ZABEL LLP
919 Third Avenue
New York, New York 10022
Tel: (212) 756-2000
Fax: (212) 593-5955
ryan.singer@srz.com
chris.gerson@srz.com

Counsel for Patent Owner
Geoscope Technologies Pte. Ltd.