

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

URNSIGNL, INC. ANDURNSIGNL FOUNDATION,
Petitioners,

v.

REDMON JEANG LLC,
Patent Owner.

CASE No. IPR2024-00102
U.S. Patent No. 11,443,395

**PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 11,443,395**

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EXHIBIT LIST

Ex. No.	Brief Description
Ex. 1001	US Patent No. 11,443,395 (“’395 Patent”)
Ex. 1002	Declaration of Dr. Michael Shamos (“Shamos” or “Ex. 1002”)
Ex. 1003	Curriculum Vitae of Dr. Michael Shamos
Ex. 1004	US Patent No. 11,494,861 (“’861 Patent”)
Ex. 1005	US Patent No. 11,494,862 (“’862 Patent”)
Ex. 1006	US Patent No. 11,443,395, Prosecution History
Ex. 1007	‘395 Patent’s provisional app 62364300 (“’300 Provisional”)
Ex. 1008	Smartphone History: The Timeline of a Modern Marvel
Ex. 1009	40 Fascinating Mobile App Industry Statistics
Ex. 1010	Mozilla Location Service
Ex. 1011	Skype
Ex. 1012	Apple Talk: Is FaceTime video chat Steve Jobs
Ex. 1013	Quora
Ex. 1014	When Zoom was young: the early years
Ex. 1015	Published App US 2002/0002469 to Hillstrom (“Hillstrom”)
Ex. 1016	Published App US 2011/0320370 to Henry (“Henry”)
Ex. 1017	US Patent No. 8,817,966 to Wrench (“Wrench”)
Ex. 1018	Published App US 2012/0204029 to Trabucco (“Trabucco”)
Ex. 1019	Published App US 2015/0371456 to Moore (“Moore”)
Ex. 1020	Quicklegal Comstock magazine
Ex. 1021	Teens Create ‘Five-O’ App To Help Document Police Brutality
Ex. 1022	Mobile Justice ACLU of Nebraska.
Ex. 1023	Apps Designed for Recording Police Encounters
Ex. 1024	It’s your right to film
Ex. 1025	Oh Crap
Ex. 1026	Alibi App
Ex. 1027	US 2016/0358017 to Guzik (“Guzik”)
Ex. 1028	One Touch Law
Ex. 1029	Smartphone App offers legal advice (LegalSwipe)
Ex. 1030	Were you stopped by the Police (Legal Equalizer)
Ex. 1031	Published App US 2016/0182707 to Gabel (“Gabel”)
Ex. 1032	Could This New App, Debuting at Techshow, Become the Uber of Law?
Ex. 1033	US Patent No. 11,010,810 to Pylant (“Pylant”)
Ex. 1034	Pylant Provisional App 62335405 (“’405 Provisional”)

Ex. No.	Brief Description
Ex. 1035	Dkt. 61, Plaintiff's Resp. to Defs.' Initial Inv. Cont. and Prior Art Statement
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Ex. 1037	McGill Report
Ex. 1038	Dkt. 8, First Amended Complaint
Ex. 1039	Dkt. 10, Proof of Service / Returned Summons
Ex. 1040	Index of Challenged Claims
Ex. 1041	Extrinsic evidence, dictionary definition for "immediately"
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Ex. 1045	Extrinsic evidence, dictionary definition for "automatically"

CLAIM LISTING

The following claim listing adds bracketed labels [pre], (a), (b), etc. for the ease of reference. See also Ex. 1040.

1. [pre] A mobile lawyer system for use during a traffic stop comprising:

[a] a mobile device having at least one video camera configured for mounting inside the passenger compartment of a vehicle and capture

[b] video images of a driver of the vehicle;

[c] the mobile device further incorporating a display screen viewable by the driver of the vehicle;

[d] a remote server and a database configured to store information about a plurality of lawyers licensed in at least one jurisdiction;

[e] the mobile device executing a mobile application configured, upon command from the driver of the vehicle,

[f] to communicate with the remote server,

[g] wherein the remote server is configured to automatically determine a location of the vehicle,

[h] automatically identify a jurisdiction associated with the vehicle location,

[i] automatically identify at least one lawyer licensed in the identified jurisdiction,

[j] and immediately automatically directly notify the at least one identified lawyer for assistance; and

[k] the display screen of the mobile device configured to live-stream a video image of the at least one identified lawyer for presentation to the driver of the vehicle,

[l] and the at least one video camera is configured to automatically live-stream video captured by the at least one video camera for viewing by the at least one identified lawyer and for storage in the remote database,

[m] where the at least one mobile device being configured to automatically enable bi-directional audio and video communication between the at least one identified lawyer and the at least one passenger

I. INTRODUCTION

This petition establishes the unpatentability of claim 1 of U.S. Patent No. 11,443,395 (the “Challenged Claim” of the “’395 Patent”) (Ex. 1001), which named as inventors Clayton K. Redmon and Wei Wei Jeang, and assignee Redmon Jeang LLC (“Patent Owner”).

Patent Owner filed the ’395 Patent with 33 claims originally presented. Several claims were subject to a restriction and the examiner required Patent Owner to make an election of claims. Patent Owner elected to move forward with claims 1-8 that are drawn to introducing a third party (*e.g.*, a licensed attorney) into a police encounter such as a traffic stop (’395 Patent at 2:7-11; 5:44-45) via a live video conference between at least one passenger in a motor vehicle and an attorney located remotely.

The ’395 Patent eventually issued after multiple Office Actions and an Appeal. The ’395 Patent issued with 1 independent claim and 7 dependent claims.

Ground 1, the only ground in this Petition, relies on a reference not before the examiner, Pylant (Ex. 1033), combined with the knowledge of a person of ordinary skill in the art (a “POSITA”) as of the filing date of the application that led to the ’395 Patent. The knowledge of a POSITA is discussed in detail in Section V “State of the Relevant Art,” and demonstrated by the exhibits cited therein, as well as by the Declaration of Michael Ian Shamos (Ex. 1002).

II. PRECISE RELIEF REQUESTED

Petitioners, TurnSignl, Inc. and TurnSignl Foundation (collectively, “Petitioner”) request review under 35 U.S.C. § 311 of claim 1 of the ’395 Patent and cancellation of the challenged claim under post-AIA 35 U.S.C. § 103.

III. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(a)(1)

A. Real Party-in-Interest

Petitioner certifies that TurnSignl, Inc. and TurnSignl Foundation are the real parties-in-interest.

B. Related Matters

Patent Owner has asserted the ’395 Patent against Petitioners in ongoing litigation captioned *Redmon Jeang LLC v. TurnSignl, Inc. and TurnSignl Foundation*, Case No. 0:22-cv-02749-NEB-LIB (Oct. 31, 2022) (the “Litigation”) in the United States District Court for the District of Minnesota. On November 14, 2022, Patent Owner filed a First Amended Complaint. (Ex. 1038). The earliest service date of the Amended Complaint served on the Petitioners identified above was December 2, 2022. (*See* Summons, Ex. 1039).¹ This Petition has been filed within one year of Petitioners’ being served a complaint alleging infringement of the ’395 Patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b).

¹ Patent Owner filed the original complaint on October 31, 2022, but never served that Complaint. An amended complaint was filed and served on December 2, 2022.

The '395 Patent is being asserted in these proceedings along with two other patents within the same patent family as the '395 Patent—namely, U.S. Patent Nos. 11,494,861 (Ex. 1004) (“’861 Patent”) and 11,494,862 (Ex. 1005) (“’862 Patent”). Petitioner is filing concurrent petitions challenging the ’861 and ’862 Patents.

C. Grounds for Standing

Petitioners certify under Rule 42.104(a) that the '395 Patent is eligible for *inter partes* review, and Petitioners are not barred or estopped from requesting an *inter partes* review on the grounds identified in this Petition.

In the Litigation, Patent Owner filed an amended complaint alleging infringement of the '395 Patent on November 14, 2022, and served Petitioners on December 2, 2022. Exs. 1038 and 1039. This Petition is timely filed within not more than the one year period set out in 35 U.S.C. § 315(b), 37 C.F.R. § 42.101.

D. Lead and Back-up Counsel and Service

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docketinglitin@btlaw.com (referencing Attorney Docket No. 90322-396892 and cc'ing mnelson@btlaw.com and daniel.valenzuela@btlaw.com). The Patent and Trademark Office is authorized to charge the fee set out in 37 C.F.R. § 42.15(a), and any additional fees due, to Deposit Account No. 100435. A Power of Attorney for the Petitioners identified above is filed concurrently with this petition.

IV. IDENTIFICATION OF CHALLENGES UNDER § 42.104(b)

Petitioners ask for institution of *inter partes* review of claim 1.

Ground	Basis	Index of References	Challenged Claim
1	§ 103	Pylant	1

Pylant was not relied on or cited by the Examiner during prosecution of the '395 Patent. The declaration of technical expert Michael Ian Shamos, Ph.D., J.D. (Shamos, Ex. 1002) further supports the proposed ground of unpatentability.

V. STATE OF THE ART RELATIVE TO THE '395 PATENT

The Challenged Claim recites “a mobile lawyer system for use during a traffic stop.” '395 Patent (Ex. 1001), Col. 5, lines 44-45 (or “5:44-45”). The Challenged Claim is directed to the “concept” of using technology to introduce a third party (a licensed attorney) into a police encounter with a motorist. 2:8-11. The claim recites generic technology such as a mobile device (that includes a video camera and a display screen), GPS location technology, and an application (“app”) that communicates with conventional devices (*e.g.*, a remote server, and a database), to

perform routine tasks, (identify, notify, and communicate with an attorney licensed in the jurisdiction/location of the vehicle/mobile device). 5:46-6:22. As discussed below (*see* V(D) in particular), the elements of the Challenged Claim were well known and in public use before the Critical Date of the '395 Patent. *See also* Ex. 1002, ¶¶63-78.

A. Mobile Devices with Video Cameras, Display Screens, and the Ability to Run Applications Permitting Bi-Directional Video Communications Were Ubiquitous Before the Critical Date.

Mobile devices having video cameras, display screens, and applications that allowed bi-directional communications were well known before July 19, 2016 – the earliest possible filing date of the '395 Patent – and, moreover, before July 19, 2015. The historical development of mobile devices and their capabilities is described in, for example, “Smartphone History: The Timeline of a Modern Marvel” (“Smartphone History”) (Ex. 1008). Cellphones were invented in 1972 and became smartphones (with computer processors) in 1992. *Id.* The first camera phone came out in 2000 and cellphones were able to access the Internet in 2001. *Id.* Apple released the iPhone in 2007, and the Android phone appeared in 2008. *Id.* Those devices had cameras and display screens. Shamos, Ex. 1002, ¶79.

Applications or “apps” for cellphones were available at least by 1994. (Ex. 1009). Over the next twenty (20) years, apps’ popularity grew immensely, and, by 2016, there had been at least 140 billion app downloads just in the United States. *Id.*

The number jumped to 175 billion in 2017. *Id.*; Ex. 1002, ¶80.

Bi-directional voice and video communications between mobile devices and/or mobile devices and other types of computers have long been known. Skype, for example, was introduced in 2003. (Ex. 1011; Ex. 1002, ¶84). By 2005, Skype had 50 million users and 600 million in 2010. *Id.* Skype allowed voice, video and instant messaging over the Internet. *Id.* Similarly, apps offering such communications on the iPhone shortly appeared after the iPhone's introduction. (Ex. 1012; Ex. 1002, ¶85). Steve Jobs announced the bi-directional video FaceTime app for the iPhone on June 7, 2010. *Id.* Also, Zoom (originally called Saasbee) became available for video conversations over the Internet by 2012. (Ex. 1014; Ex. 1002, ¶86). By 2012, it was publicly suggested to use FaceTime to contact a lawyer during a traffic stop. *See, e.g.*, "Can I put my lawyer on FaceTime on my phone during a traffic stop?" on Quora, April 12, 2015. (Ex. 1013; Ex. 1002, ¶¶85, 87). It was not inventive in 2016 to use a cell phone for video calls. *Id.* at ¶87.

B. Determining the Location of the Mobile Device Was Well Known, as was Identifying a Lawyer Licensed in a Particular Jurisdiction/Location.

Mobile devices performed geolocation even before GPS receivers became available in 1999, and geolocation is still available for phones without GPS. (Ex. 1010; Ex. 1002, ¶81). The geographic location of a mobile device can be determined from, for example, the identity of nearby cell towers and Wi-Fi access points. *Id.* As

early as 2014, the Mozilla Foundation offered a location service API that used Bluetooth beacons as well as Wi-Fi and cell towers to locate cellphones. *Id.* Also, since 2008, every Apple iPhone has had GPS capability, and many apps discussed below make use of GPS to locate a nearby attorney. (Ex. 1010; Ex. 1002, ¶82). Thus, by the beginning of 2016, geolocation by cellphones/mobile devices was conventional. Ex. 1010; Ex. 1002, ¶83.

In nearly all 50 states, lawyers must be licensed to practice law, and their practice is typically limited to the state or states in which they are licensed. (Ex. 1002, ¶88). As described below in more detail, multiple mobile phone apps provided access to location-based databases of attorneys to enable a user to contact a nearby lawyer during a vehicle incident. *Id.* at ¶89. And it has long been known that a person facing legal peril and a potentially adversarial situation in a traffic stop may desire to have an attorney present. *Id.* at ¶90. Many prior art references disclose systems that permit a person in legal jeopardy to record police encounters and obtain representation in real time. *Id.* at ¶91; *see also* Section V(D), below.

C. Servers, Databases, and Communications With Them Were Well Known.

Servers, databases, and computers, such as those in a mobile device to communicate with servers, and databases were well known by the beginning of 2016. *Id.* at ¶92. It was known that servers could be configured to perform tasks such as determining the location of a vehicle, identifying records (such as a list of lawyers

associated with a particular location), and sending messages (*e.g.*, notifying) to other servers/computers such as those of one or more identified lawyers. *Id.* Such communications were routine at the beginning of 2016, and had been routine for many years before that date. *Id.* As of the beginning of 2016, databases were also known to be common structures that stored data, such as video records, lawyer records, and that such records could be encrypted. *Id.* at ¶93.

D. Summary of Prior Art and the Information a POSITA Would Have Understood Prior to the Critical Date of the '395 Patent.

Hillstrom (Ex. 1015) - 2001. On June 19, 2001, Hillstrom filed an application that was published on January 3, 2002 as U.S. Patent Application Publication 2002/0002469 entitled “System and Method for Hiring Lawyers and Managing the Process Entailed in the Pursuit of Clients’ Legal Claims.” (“Hillstrom”) Ex. 1015. Hillstrom discloses a system including an Electronic Process Control System (“EPCS”) that, among other things, includes a database [0029, 0037] for matching lawyers and clients based on geographic location. [0034]. The system also stores the qualifications of the lawyers. [0025]. Users may access the system via mobile device. [0030]. Hillstrom also discloses exchanging forms to create a legal engagement. [0041]. Although Hillstrom does not expressly disclose using the system during a police encounter, it would have been obvious to a POSITA to use Hillstrom’s system for a police encounter because police encounters occurred and were being recorded for years before 2016 (*e.g.*, a bystander used a camera to record

a video of the beating of Rodney King in 1991 during his arrest after a high-speed pursuit). (Ex. 1002, ¶¶94-95). A POSITA would thus have understood that using Hillstrom's system to contact a lawyer during a police encounter and record the encounter might diffuse the situation. *Id.*

Henry (Ex. 1016) – 2010. On June 23, 2010, Henry, Jr. filed a provisional application and within 1 year filed a nonprovisional on June 22, 2011 that was published on December 29, 2011 as U.S. Patent Application Publication 2011/0320370 entitled, "System and Method for Providing Remote Representation." ("Henry"). Henry discloses two-way real-time audio and video communication between a driver and a lawyer during an incident: "The embodiments of the present invention provide novel systems and methods for providing on call real-time remote legal services by utilizing wireless audio and video components that also allow for two-way communication. The embodiments enable an individual to have access to legal representation and consult with legal counsel at the time an incident occurs." (Ex. 1016, Abstract). Henry also taught that an individual may not know how to respond to inquiries or know his/her legal rights and that an individual may become uncomfortable or nervous during an encounter with law enforcement and that Henry's system could solve these problems by providing "*legal services at the time of an incident.*" (*Id.* at [0004]).

Figure 1 depicts the logic flow of Henry's system.

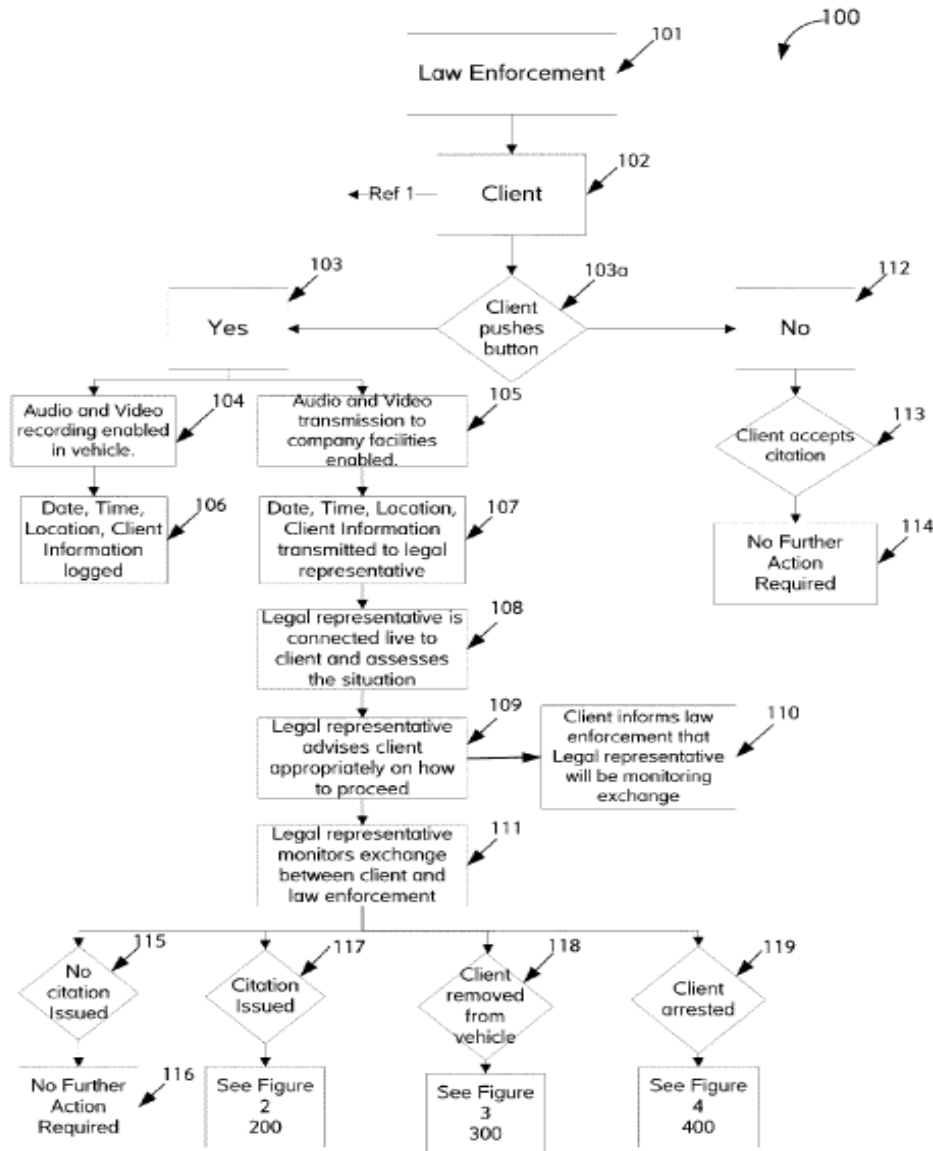


FIG. 1

Referring to Fig. 1, a user initiates contact with a lawyer by pressing a button (YES, 1a) or other indicator (102a) on an electronic device to enable audio access and video recording 104 and transmission to a company or other entity 105. (*Id.* at [0020]). The company or other entity may be a lawyer or an intermediary that provides access to legal services. Regardless, the time, date, and location are logged

106 and transmitted 107, and a legal representative is connected live (*i.e.*, in real-time) to assess the situation 108 and advise the client how to move forward 109. *Id.* at [0021]. Figure 5 also describes an exemplary method 500 for accessing real-time legal assistance after a car accident via video and audio equipment. *Id.* at [0027] and Fig. 5. There, like in Figure 1, the system logs date, time, and client information. *Id.*; *see also* Ex. 1002, ¶¶96-100.

Henry further describes alternative embodiments in which the wireless system always on and the activity is constantly tracked. *See* Henry at [0028]. In this "constant on" embodiment, the client optionally transitions to real-time tracking after an accident. *Id.* The system may have "memory means" to store the data obtained. *Id.*; Ex. 1002, ¶101.

Henry teaches that its system would be beneficial to "traffic stops" and other personal safety situations [0019] and that the audio/video device may be a mobile phone. *Id.* at [0039]; Ex. 1002, ¶¶96-98, 103.

Wrench (Ex. 1017) – 2010. On July 8, 2010, Wrench filed a provisional application that was the basis of a regular application filed July 8, 2011 and published on July 12, 2012 as U.S. Patent Application Publication 2012/0176466 entitled "Method of Collecting and Employing Information about Parties to a Televideo Conference" that ultimately issued as U.S. Patent 8,817,966 on August 26, 2014 (Ex. 1017, "Wrench"). Wrench discloses a system able to match a user to

an attorney for video communication. Ex. 1002, ¶104.

Wrench teaches that videoconferencing may take place using a cellphone: “Software exists to allow an individual to turn a basic computer station, cell phones and other smart devices into video terminals, which can process video signals.” Wrench, 1:39-41. Wrench teaches that its system connects individuals who may *or may not* have been known to one another previously, and may be routed to each other based on good fits to collaborate based (*see* Wrench, 1:48-53), including matching users with attorneys. *Id.* at 4:28-31. For example, Wrench describes creating “Profile Templates” so “that information about an attorney's credentials and areas of specialization would be collected by the system as personal characteristics” to help match users with attorneys (*Id.* at 4:28-31) and connecting via videoconference individuals needing legal help with attorneys having matching professional experience or other characteristics. *Id.* at 15:6-9; Ex. 1002, ¶¶105-106.

Trabucco (Ex. 1018) – 2011. On February 4, 2011, Trabucco filed an application that was published on August 9, 2012 as U.S. Patent Application Publication 2012/0204029 entitled, “Method and System for Conducting an Attorney Client Privileged Conference with the Lawyer at an Independent Location” (Ex. 1018, “Trabucco”). Trabucco taught a system for an attorney to communicate remotely and privately (via videoconference) with an incarcerated person using a server to establish a secure link between the attorney and client/person. Trabucco at

[0007-0010]; Ex. 1002, ¶107. Specifically, Trabucco taught a method for conducting a confidential privileged video conference at a selected time between an incarcerated inmate at a specific video conference terminal at the incarceration location and the inmate's attorney at a computer at an independent location (*e.g.*, the attorney's office ([0008])) comprising:

- a) establishing a server to securely link the conference terminal and the computer over a communication network;
- b) verifying the lawyer's status and identity;
- c) verifying the inmate is the attorney's client;
- d) assigning an identity code for the attorney to sign into the server using the computer over the communication network;
- e) establishing one or more people responsible to bring the inmate to the conference terminal at the selected time;
- f) the attorney signing into the server while the inmate is brought to the terminal by the one or more people at the selected time;
- g) the server establishing an encrypted link between the terminal and the computer at the selected time; and
- h) the attorney and inmate conducting a confidential video conference.

Trabucco. at [0010]-[0018]; Ex. 1002, ¶107.

Moore (Ex. 1019) – 2014. On June 24, 2014, Moore, Jr. et al. filed an application that was published on December 24, 2015 as U.S. Patent Application Publication 2015/0371456, entitled “System and Method for Detecting and Remotely Assisting Vehicle Incidents and Dispatching Assistance” (Ex. 1019, “Moore”). It discloses a system for obtaining help at a road incident and making a

video recording of the incident. Specifically, the system includes an in-car device with an associated camera for detecting vehicular incidents such as mechanical failures and collisions and transmitting an incident notification to a remote monitoring station. Abstract. A camera associated with the device sends images to the station, where an operator can view and assess the nature of the incident, communicate by voice and/or video with the occupant of the vehicle via a cellular telephone connection, and dispatch assistance. Abstract; Ex. 1002, ¶¶108-110.

Referring to Figure 3, Moore taught that camera 20 or 20a is positioned so that its field of view included the driver's seat area and that the camera would be moveable so that it could be panned for a wider viewing area. Moore, [0016]. Moore also taught a forward-facing camera that was always active and enabled, and that images or video from that camera are stored, in memory in in-car device 10 and/or *at a remote server 14. Id.* In addition, Moore taught transmitting the location of the vehicle via GPS to a server: "If in-vehicle device 10 detects that vehicle 12 has broken down and is inoperable, device 10 *sends a signal to server 14 indicating* the nature of the mechanical problem and *the location of vehicle 12 as determined by GPS data.*" Moore, [0021]; Ex. 1002, ¶¶108-110.

Quicklegal, Inc. (Ex. 1020) – 2014. At least as early as July 21, 2014, Quicklegal, Inc. made a cellphone app available called Quicklegal that enabled a user to contact an attorney for legal assistance based on location. A Comstock's

Magazine article on June 6, 2016 (Ex. 1020) describes the system:

In 2014, Bluford created Quicklegal, a cloud-based legal practice management system, where lawyers can offer on-demand advice to customers with legal questions.

...

The app allows customers to select a legal specialty. It also connects them with an attorney near them, which is crucial because certain laws vary from state to state. “Some state laws prohibit the way an attorney can interact,” he says. “We’ve decided to adjust our technology to meet each state’s requirements.”

...

Attorneys pay \$499 to be a part of the platform, which has an Uber-like review system for customers to leave feedback. After three negative reviews, an attorney can be barred from the network. As of May 2016, 1,800 attorneys have registered.

Comstock’s Magazine, June 6, 2016; Ex. 1002, ¶111.

Five-O App (Ex. 1021) – 2014. An August 14, 2014, a Huffpost article titled “Teens Create ‘Five-O’ App to Help Document Police Brutality” (Ex. 1021) described a mobile app that empowers citizens “to record and store data from every encounter with law enforcement.” Those incident reports can then be shared and used by the community to rate individual officers and police departments as a whole. Ex. 1002, ¶112.

Mobile Justice App (Ex. 1022) – 2012/2014. The American Civil Liberties Union developed the “Mobile Justice” app in 2012 and distributed it to the public at

least as early as November 5, 2014. (Ex. 1022). The ACLU of Nebraska Mobile Justice smartphone app was created to empower individuals to hold Nebraska law enforcement agencies accountable for their actions. This app has four main features:

- Record - allows citizens to capture exchanges between police officers and themselves or other community members in audio and video files that are automatically emailed to the ACLU of Nebraska.
- Witness - gives citizens the option to alert nearby Mobile Justice App users when they are stopped by police in order to witness and document the interaction.
- Report - gives citizens the option to provide a more-detailed account of their interactions with police in an incident report, which will be transmitted directly to the ACLU of Nebraska.
- Know Your Rights - provides an overview of what rights protect Nebraskans when they are stopped by law enforcement officers.

It was also described in an article, “Apps Designed for Recording Police Encounters,” dated November 7, 2016. (Ex. 1023); Ex. 1002, ¶113.

The Mobile Justice app was “available for free from the Play store,” and let users “download a version of the app that corresponded with the state the user lived in. Through this app you can record a video of a police encounter and send it immediately to the American Civil Liberties Union of your state. You can also receive notifications of other users witnessing an incident, or report an incident that you’re seeing. Like the other apps, Mobile Justice reminds you of your rights as a civilian, whether you’re in a police encounter or witnessing an incident.” (Ex. 1023;

Ex. 1002, ¶114).

Hands Up 4 Justice App (Exs. 1023, 1024) – 2015. The “Hand Up 4 Justice” app was available at least as early as February 1, 2015. It was described in a Wired Magazine article entitled, “It’s Your Right to Film the Police. These Apps Can Help,” which was published on May 3, 2015. (Ex. 1024). This app allowed people to discreetly record interactions with police officers *during traffic stops*, etc. The app integrated emergency contacts and GPS, uploaded to YouTube or a Dropbox account, and was available for download from the iTunes store. Inspired by its creator Duncan Kirkwood’s personal experience during a traffic stop, he “wanted to make it easier for people of color (who are disproportionately stopped by police on US highways) to record their interactions without fear of intimidation.” *Id.*; *see also* Ex. 1002, ¶115.

The app was also described in the article, “Apps Designed for Recording Police Encounters,” dated November 7, 2016. (Ex. 1023). Available for \$0.99 cents from the Google Play app store, this app offers “a discreet way to record any police encounters that you might have,” and “advice on how to behave during those encounters. Some features include: cloud storage for videos, setting your front or rear camera for default use, adding an emergency contact that will be informed of any recorded videos, and the ability to connect the app to a Dropbox account.” (A Dropbox account is a cloud storage account). Ex. 1002, ¶1116.

The Oh Crap! App (Ex. 1025). The Oh Crap! app was available by February 2015. The Oh Crap! app was used on a mobile device and, among other things, determine the user's location and, if clicked, would communicate with a participating attorney based on the user's geographic location. The app also recorded the law enforcement encounter. Ex. 1025; Ex. 1002, ¶117.

The Alibi App (Ex. 1026) – 2015. A TechRepublic May 29, 2015 article titled, "An app that passively records your life so you always have a witness" (Ex. 1026) describes an "Alibi app." The article describes the app's default setting is to "record **audio, images, and geolocation.**" "Most Android phones pick up a four to six foot radius, and the images are just shy of HD quality. The video is relatively low quality but captures a lot . . . and the geolocation picks up once every 15 minutes. If you keep audio recording, have it take one photo a minute, and tag your geolocation, there's no measurable effect on battery life. But if you record video, you'll get about 85% of the phone's normal battery life. Alibi launched publicly in January 2015, and Saleh said it's done much better than they hoped. They get a couple hundred downloads a week, and are now just shy of 10,000 total." "Version 2.0 may have a Dropbox account integration, so users can save files into their directory and have the data replicated on Dropbox's *servers for extra backup.*" (Ex. 1026; Ex. 1002, ¶118).

Guzik (Ex. 1027) – 2015. On June 5, 2015, Guzik filed an application that

was published on December 8, 2016 as U.S. Patent Application Publication 2016/0358017, titled “In-Vehicle User Interfaces for Law Enforcement” (Ex. 1027, “Guzik”). Guzik discloses a system installed in a law enforcement vehicle to obtain information regarding an incident from a witness or participant in the incident.

Referring to Figure 1, Guzik a camera, speakers, communication interfaces, a display, and cloud storage for video data. Guzik provides in-vehicle user interfaces to a person contacted by a law enforcement officer (*e.g.*, a member of the community, an eyewitness, or a suspect that is arrested). Guzik, [0015]. The in-vehicle user interfaces may be presented by an in-vehicle information device, which may provide video via a display device and/or audio via an audio device to a person in a secure holding area (*e.g.*, backseat, rear passenger compartment, etc.) of a law enforcement vehicle. *Id.* The communication interfaces may enable the person 110 to initiate communication with third-parties (*e.g.*, an attorney or relative) via a telephony application, an email application, and/or a messaging application. Guzik, [0041]. Guzik describes embodiments in which the interface has an interactive menu that includes, among other things, an attorney contact option 312 (Fig. 3), the activation of which may cause the interactive interface module 222 to provide an interactive interface that has a list of pre-screened attorneys and their contact information. Guzik, [0054]. The contact information may be selectable to initiate contact (*e.g.*, a telephone number may be clicked on to initiate a telephone call). *Id.*

at 0054; Ex. 1002, ¶¶119-121. Although Guzik does not disclose the use of a mobile phone, the “One Touch Law” App (and many of the other apps) ran on mobile devices, including mobile phones. Ex. 1002, ¶122.

The “One Touch Law” App (Ex. 1028) – 2015. On June 18, 2015, a mobile application known as “One Touch Law” became available. (See Ex. 1028). It shows that a lawyer can be located by specialty and a video or phone consultation can be established. Ex. 1002, ¶123.

The “LegalSwipe” App (Ex. 1029) – 2015. A June 29, 2015 CTVNews article titled “Smartphone app offers legal advice for police encounters” describes features of the “LegalSwipe” app. (See Ex. 1029). LegalSwipe, a “new smartphone app aims to offer bite-sized legal advice as well as other protections to people randomly stopped and questioned by police.” *Id.* The “free app comes amid emotional debate over ‘carding’ and similar practices in which officers ask for information unrelated to a criminal investigation.” *Id.* These practices disproportionately single out young black men and other minorities. *Id.* “Other functions [of the app] allow users to video an encounter and send the recording of the encounter to a remote server, and to send geo-tagged email messages.” *Id.*; Ex. 1002, ¶124.

The “Legal Equalizer” App (Exs. 1030, 1023) – 2015. The “Legal Equalizer” app was also described in a December 9, 2015, NBC News published

article titled, “Were You Stopped by the Police? There’s an App For That” (Ex. 1030). The article states, “the concept behind the app stems from what Njie (its developer) considered a pattern of unlawful traffic stops.” In the event of a traffic stop, the user can “record the entire interaction with police officers, notify family members of the coordinates of their location, and be informed of their legal rights in an instant.” *Id.* A user may “select three contacts to be notified in the event of a traffic stop. The contacts are inputted by the user in the apps settings. Once those contacts are set, all a user has to do is press the “SOS” button on the app and a message will go out to the contacts automatically.” *Id.* “The other feature of the app is the record button. Once the user sends their SOS, they simply have to press the record button. The recording is automatically sent to a server where it will be stored regardless of what happens to the phone and the video is also backed up to the user’s iCloud.” *Id.*; Ex. 1002, ¶125.

The “Legal Equalizer” app was also described in the November 7, 2016 article, “Apps Designed for Recording Police Encounters.” (Ex. 1023). Like Hands Up 4 Justice, Legal Equalizer can record any encounters with the police that you may have. But unlike Hands Up 4 Justice, “Legal Equalizer focuses more on the user’s rights as a civilian, and informs or reminds the user of what he/she should say, how he/she should behave, and certain laws to remember. While this app also has its glitches, it offers a stream-to-cloud recording option, in addition to sending any

recorded video to three emergency contacts and the ability to find you a lawyer.” *Id.*; Ex. 1002, ¶126.

Gabel (Ex. 1031) – Feb. 2016. On February 19, 2016, Gabel filed an application that that was published on June 23, 2016 as U.S. Patent Application Publication 2016/0182707, entitled “Methods and Systems of Managing Accident Communications over a Network” (Ex. 1031, “Gabel”). Gabel ultimately issued as U.S. Patent 9,866,673. Gabel describes recording information about accidents, and notes that vehicle accidents often generate a police presence. *See* Gabel, [0004] (noting that vehicle accidents may result in arrest). Gabel describes systems and methods configured to detect accidents, and to collect, process, and distribute accident related data. Abstract. The accident related information may include location information, accident image information, and/or other information. *Id.* Data may be imaged using a camera of a mobile device, barcode locations may be identified, and barcodes may be decoded. *Id.* Gabel discloses use of a mobile device with a camera and obtaining location information using GPS, cell towers or Wi-Fi [0006], encrypted communications [0037], an attorney referral process [0039], calling the attorney [0041], and video recording [0052]. Ex. 1002, ¶¶127-128.

The “1Law” App (Ex. 1032) – March 2016. An article by Ambrogi on March 15, 2016 entitled “Could This New App, Debuting at Techshow, Become the Uber of Law?” (Ex. 1032) describes the “1Law” app. The developer (Velez) states,

“My app is in the on-demand service space, like Uber for lawyers ... [t]ouch the app and communicate with the attorney in real time, live.” *Id.*; Ex. 1002, ¶129.

“When a consumer first installs the app, he or she is prompted to create a login and simple profile, either by connecting to a social network such as Facebook or using an email address.” (Ex. 1032). “Once the user logs in, the app shows a map of the user’s location. If a lawyer who is part of the system is in the vicinity, the lawyer will show up as an icon depicting the number one. Blue icons indicate lawyers available at that moment. Grey icons indicate lawyers who are part of the system but not currently available.” *Id.* “Users can choose a particular area of law to narrow the displayed icons to only lawyers who handle that area. By clicking on the icon, the user sees the lawyer’s profile, describing the lawyer’s practice. If the user wants to go forward and contact the lawyer, he or she taps the call button under the profile.” *Id.* “The lawyer sees the call coming in, displaying the caller’s name and profile. The lawyer can either deny or accept the call. *Id.* If the attorney accepts, the two are connected into a video call. *Id.* If the lawyer denies the call, the user can try a different lawyer.” *Id.* (The app uses Twilio as its video platform.). *See also* Ex. 1002, ¶129.

McGill Report (Ex. 1037) – Oct. 2016. Jena McGill (“McGill”), et al., published a University of Ottawa report on October 13, 2016 titled “Emerging Technological Solutions to Access to Justice Problems: Opportunities and Risks of

Emerging Technological Solutions to Access to Justice Problems: Opportunities and Risks of Mobile and Web-based Apps.” (Ex. 1037). McGill provides details on **189 apps** that were then available to let users document incidents or obtain legal assistance. Of those 189 apps, several directly relate to assistance with traffic stop incidents including Bernie Sez, Camera V, Fixed, Hands Up App, ICE Blackbox, Mobile Justice, Oh Crap App, QuickLegal, and Stop & Frisk Watch. *Id.*; Ex. 1002, ¶141.

It is clear that multiple prior art apps offered the same capabilities as now claimed by the ’395 Patent. The purpose of this exposition has been to set forth the knowledge of a POSITA at the time of the alleged invention. The invalidity arguments below are confined only to patents and printed publications. Ex. 1002, ¶142.

VI. OVERVIEW OF THE ’395 PATENT

The ’395 Patent was filed on July 7, 2017, and issued on September 13, 2022. It claims priority to U.S. Provisional Patent Application No. 62/364,300 (“’300 provisional”) filed on July 19, 2016. *See* ’300 Provisional – Ex. 1007. The ’395 Patent’s Challenged Claim is directed at an on-demand lawyer application that automatically and immediately connects a user with a face-to-face lawyer consultation using bi-directional video and audio communication. A list of a plurality of lawyers and the jurisdiction in which they practice are stored on a remote

server. After command, the application automatically searches for suitable lawyers based on the current location of the user. Ex. 1001, claim 1. The patent uses conventional technology such as a video camera, display screen for viewing video, an app on a mobile device so a user can videoconference with an attorney, servers, and a database. Ex. 1001, claim 1; Ex. 1002, ¶¶64-76.

A. PROSECUTION HISTORY

The prosecution history of the '395 Patent is at Ex. 1006. During the prosecution of the '395 Patent, the examiner made rejections based on the following references, namely Moore et al. (US 2015/0371456), Bulrris, et al. (US 2005/0128283), Hillstrom (US 2002/0002469), Hatori, et al. (US 2015/0015706), Zureikat (US 2016/0173742), Mokashi (US 9,288,446), and Yuen (US 2016/0140179), Kelts (US 2018/0012324), Becker (US 2014/0214702), Yuen (US 2016/0140179) and Thorpe (US 2018/0018831). The Applicant made many amendments to overcome the rejected claims, but the examiner continued issuing rejections over the amendments and Applicant's responses. After several rounds of rejections, amendments, request for continued examination, abandonment and revival, the Applicant filed a Notice of Appeal to the PTAB on January 19, 2022. In its petition, Applicant presented essentially the same arguments from its last Office Action Response. With no more analysis, a Notice of Allowance issued on May 3, 2022. *See generally*, Ex. 1006.

B. THE '395 PATENT IS NOT ENTITLED TO ITS PROVISIONAL PRIORITY DATE

The '395 Patent is not entitled to its provisional filing date of July 19, 2016, because the provisional application lacks support for independent claim 1 of the '395 Patent. *See* Ex 1002, ¶¶33-48. To establish entitlement to the earlier filing date of a provisional application, a party must prove that the provisional application provides adequate written description and enablement support under Section 112 of the Patent Act, 35 U.S.C. § 112, for the claims of an asserted reference. *Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017).

The '395 Patent is the parent patent of a family of patents. It has 8 claims, 1 independent claim and 7 dependent claims. A finding of lack of support for claim 1 affects the dependent claims, rendering all claims ineligible for the '300 provisional priority date.²

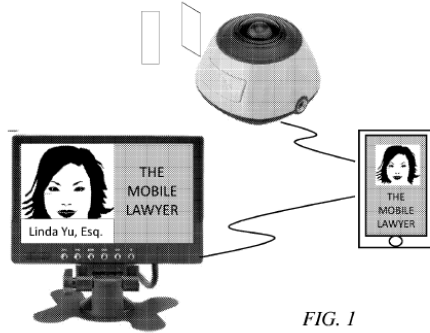
² 35 U.S.C. § 112(d) sets out the requirements for when a claim is dependent upon another. The statute provides that a claim is dependent upon another if the claim: (1) refers to “a claim previously set forth” and (2) “specif[ies] a further limitation of the subject matter claimed.” 35 U.S.C. § 112(d); *see also Monsanto Co. v. Syngenta Seeds, Inc.*, 503 F.3d 1352, 1357 (Fed. Cir. 2007) (“To establish whether a claim is dependent upon another, this court examines whether the new claim both refers to

Here, although the Applicant filed a nonprovisional application within the 12 months, none of the issued claims are supported by the provisional application. Specifically, claim 1 recites terms “automatically” and “immediately” and “directly,” terms added by amendment to allegedly overcome examiner rejections. Nowhere does the ’300 provisional mention the system doing anything automatically or immediately (only refers to a user’s action to make something happen) or directly that are related to the application doing something without user initiation. This language was later added in the ’395 nonprovisional but was never disclosed in the ’300 provisional. *See* Ex. 1006, Amendment 54 in response to Office Action dated Feb. 28, 2018, claims 2-7 depend from claim 1 and, likewise, find no support in the provisional. Ex. 1002, ¶¶36-39/

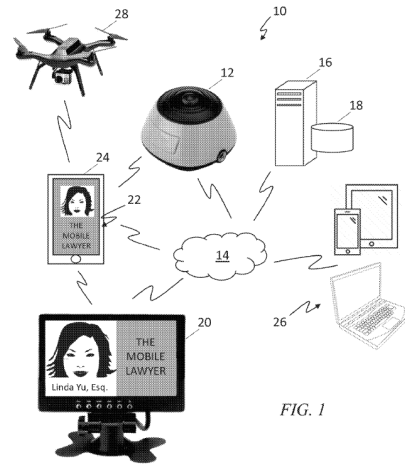
When comparing Figs. 1 of the provisional and the ’395 Patent, Patent Owner added additional elements not disclosed in the provisional. *Id.* at ¶40.

an earlier claim and further limits that referent.”). A dependent claim includes all of the limitations of the independent claim on which it depends.

Provisional



Nonprovisional



Patent Owner may try to argue that the disclosure of a “cloud data storage” covers the remote server and database. The provisional application identifies the cloud data storage for storing the live streamed video, but the nonprovisional application shows two devices, the remote server, element 15, and the cloud storage database (database) 18 and they serve different functions because they are different devices that serve different functions. *See* Ex. 1007 at [0009, 0012]. Disclosing one does not imply disclosure of the other. Ex. 1002, ¶41.

The provisional application also does not support the dependent claims for additional reasons. For example, the '300 provisional does not teach “a video camera mounted on a drone” of claim 3, and there is no support for “a plurality of video cameras mounted on the vehicle configured to capture video images in a plurality of directions” as recited in claim 4. Likewise, the '300 provisional does not support the “encrypted data” element of claims 5 and 6. Finally, because the '300 provisional

discloses only cameras inside the vehicle, it does not support claim 8's requirement of "at least one video camera configured for mounting outside the passenger compartment of the vehicle and capture video images of at least one passenger in the vehicle and surrounding environment." Ex. 1001, ¶¶42-46.

Given the lack of support for independent claim 1 (and several dependent claims, including claims 3-8), the '395 Patent is not entitled to a priority date of July 19, 2016. Hence, the priority date for the '395 Patent and claim 1 is July 7, 2017. See the detailed table at Ex. 1042; Ex. 1002, ¶¶47-48. Regardless, however, the provisional of the Pylant reference (Ex. 1033) was filed on May 12, 2016 and predates the '395 Patent even if it is accorded a July 16, 2016 priority date.

C. CLAIM CONSTRUCTION UNDER 37 C.F.R. § 42.104(b)(3)

Claims need to be construed only to the extent necessary to resolve a controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017). Here, Petitioner's position is that the terms/phrases used in the '395 Patent should be given their plain and ordinary meaning to a POSITA. To avoid a possible dispute regarding different interpretations of the plain and ordinary meaning, however, Petitioner identifies these terms for construction in this IPR: "jurisdiction," "automatically," "immediately, and "directly." Ex. 1002, ¶¶56-62.

"jurisdiction". Block 38 of Figure 2 states "Determine User Jurisdiction."

(Ex. 1001, Fig. 2). Referring to that figure, the specification equates “jurisdiction” (block 38) with location of the user/vehicle such as city and state. Ex. 1001, 3:53-54. Elsewhere, the specification also equates jurisdiction with the location of the user. *Id.* at 3:14-16 (notification sent to lawyers licensed in the same “jurisdiction” as the current location of the user); *id.* at 2:45-46 (lawyers licensed in various “jurisdictions”); *id.* at 5:15-17 (“[t]he lawyer selection criteria is primarily ‘jurisdictional’ due to the licensing requirements for lawyers”); *id.* at 4:55-57 (discussion police officer’s action under laws of a “jurisdiction”). Taken together, a POSITA reading the specification would understand “jurisdiction” to mean “***state***,” *i.e.*, the territorial range of a lawyer’s license, because in the United States lawyers are licensed on a state-by-state basis. *See* Ex. 1002, ¶59.

“automatically”. The specification does not use the term “automatically,” other than in the claims. Claim 1 recites the remote server is configured to “automatically” determine a location of the vehicle, “automatically identify a jurisdiction associated with that vehicle location, “automatically” identify at least one lawyer licensed in the identified jurisdiction, and “immediately automatically directly” notify the at least one identified lawyer. Ex. 1001, 6:1-10. The claim further states the video camera is configured to “automatically” live stream video and that the mobile device is configured to “automatically” enable bi-directional audio and video communication. *Id.* at. 6:14-20. A POSITA reading the specification would

understand “automatically” to mean “*without manual intervention.*” This is the common meaning of “automatically” in the computer art, and is confirmed by this definition from Rigdon’s “Dictionary of Computer and Internet Terms: “automatic (adj) ~ Pertaining to something that functions without external control.” Ex. 1045; Ex. 1002, ¶60.

“immediately”. The claims and the specification use the term “immediately” to signify a temporal relationship. For example, the specification states that the first lawyer who responds to an alert notification can “immediately” view the live-streamed video information on a computing device. Ex. 1001, 3:13-23; *see also* 3:60-62 (“The captured video data is ‘immediately’ transmitted to the lawyers associated computing device.”); *id.* at 4:7-10 (user “immediately clicks on Mobile Lawyer App icon); *id.* at 4:21-25 (first lawyer who responds “immediately” has access to live-streamed video and the lawyer’s image is “immediately” displayed). A POSITA reading the specification would understand “immediately” to mean “*without significant delay.*” In the context of a police traffic stop, the driver needs assistance quickly, not within seconds, but also not within hours. The summoning of a lawyer needs to occur quickly enough so that the lawyer can be of material assistance during the stop. This definition is consistent with the well-understood meaning of “immediately” “**2:** without delay.” *See* American Heritage, at 658 (Ex. 1041); *see also* Ex. 1002, ¶61.

“directly”. This term is used in the Challenged Claim in the limitation, “immediately automatically directly notify the at least one identified lawyer for assistance.” It is a step performed by the “remote server.” In the context of a “notification,” the plain and ordinary meaning is that the notification is “from the server to the lawyer without any intermediary.” That is, a notification occurs “directly” from A to B if A communicates specifically with B. A notification does not occur “directly” from A to B if A notifies C, and asks C to notify B. Ex. 1002, ¶62.

VII. PERSON OF ORDINARY SKILL IN THE RELEVANT FIELD AND RELEVANT TIMEFRAME

Patent Owner stated in response to written discovery in the Litigation that a POSITA would have “[1] a bachelor’s degree in computer science or computer engineering and/or work experience in coding software; [2] would have experience with or knowledge of confrontations with police officers during traffic stops or other encounters; and/or [3] would have knowledge of basic legal concepts, including the concept of the attorney-client relationship, jurisdiction, and Constitutional rights.” Ex. 1043 at 6, 7. For the purposes of this IPR, Petitioner accept this definition of a POSITA. Ex. 1002, ¶¶49-55. As evidenced by his CV (Ex. 1003), Dr. Shamos is at least a POSITA.

VIII. UNPATENTABILITY GROUND

A. Summary of the Prior Art

1. U.S. Patent No. 11,010,810 (“Pylant”) (Ex. 1033)

The prior art reference relied on is U.S. Patent 11,010,810 (Ex. 1033) (“Pylant”) titled, “Computerized System and Method for Automatically Establishing a Network Connection for a Real-Time Video Conference Between Users”. It discloses a mobile lawyer system for use during a traffic stop as recited in the challenged claims. Pylant and a POSITA’s knowledge at the time of the invention as discussed in Dr. Shamos’ declaration, Ex. 1002, renders the Challenged Claim obvious.

Pylant was filed May 12, 2017 and claims priority to Provisional Application 62/335,405, filed May 12, 2016 (’405 Provisional) (Ex. 1034). Pylant is prior art under post-AIA 35 U.S.C. § 102(a)(2) and/or 102(e). Pylant was not before the Examiner during the prosecution of the ’395 Patent. Pylant is analogous prior art in the same field of the invention. Ex. 1002, ¶144.

Pylant discloses “systems and methods for automatically, in real-time, establishing a network connection for video conferencing between a user and an expert user [*e.g.*, an attorney (Pylant, 2:39-40)] having an expertise associated with the determined specific and currently occurring real-world situation of the user.” 1:41-46. Pylant discloses many examples of such situations, including the situation where a user (Jeff) is being pulled over for suspected drunken driving (*e.g.*, a traffic

stop) and needs to connect with an attorney in real-time during the traffic stop. 7:11-28; Ex. 1002, ¶152.

Pylant teaches that a user initiates a request for a consultant/expert via, for example, an app on a mobile device. 15:6-20. The systems/methods analyze the request to identify the situation's characteristics, analyze the data associated with the user (*e.g.*, the time, data, **location** of the user), and the like, to determine details of the situation. 2:17-26. This analysis and identified information is then used to **identify an expert user** with sufficient capabilities (*e.g.*, experience/credentials satisfying an expert level threshold) corresponding to the situation, for example, an attorney in the case of Jeff. *Id.* Once identified, Pylant's systems/methods automatically, immediately, and directly notify the expert and, if the expert responds, automatically establish a connection between the user and expert and automatically start a bi-directional videoconference between the user and the expert. Abstract; Fig. 4; 2:36-41; 7:64-8:7; 16:55-67; 17:34-47; claim 1 at 21:62-67; claim 10 at 23:1-6. This video can be livestreamed and can be stored or recorded for future use either locally or remote. *See* 2:27-34. Petitioner describes Pylant's additional features below in connection with particular claim elements. Ex. 1002, ¶¶145-146.

2. Pylant is prior art to the Challenged Claims based on its filing date.

Petitioner asserts that, if the effective filing date of the '395 Patent is found to be July 7, 2017, then for the prior art reference Pylant, Petitioner relies on Pylant's

filing date of May 12, 2017, which precedes the filing date of the '395 Patent. Ex. 1002, ¶131.

3. Pylant is prior art to the Challenged Claims based on its provisional filing date.

Petitioner asserts that, if the effective filing date of the '395 Patent is found to be July 19, 2016 (which it is not), then Pylant is entitled to its provisional filing date of May 12, 2016, in view of *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015). Under *Dynamic Drinkware*, Petitioner has the initial burden of production to show the prior art reference is prior art under 35 U.S.C. § 102(e)(1).³ Petitioner asserts that it has met that burden by showing that the prior art reference (Pylant) is entitled to the priority claim by showing the disclosure of the provisional application (Pylant provisional) provides support for the claims in the

³ See *Dynamic Drinkware*, 800 F.3d at 1382 (“A provisional application’s effectiveness as prior art depends on its written description support for the claims of the issued patent of which it was a provisional.”). Note: The Federal Circuit has not yet ruled on whether *Dynamic Drinkware*, and specifically its reliance on *In re Wertheim*, 646 F.2d 527, 537 (CCPA 1981), extends to post-AIA 35 U.S.C. § 102(d), and expressly declined to do so in its *Dynamic Drinkware* decision. *Dynamic Drinkware*, 800 F.3d at 1382 n.2. However, the PTAB has applied the *Dynamic Drinkware* requirement in post-AIA proceedings. IPR2021-01328,

reference patent. *See Dynamic Drinkware*, 800 F.3d at 1382 (citing *In re Wertheim*, 646 F.2d 527, 537 (C.C.P.A. 1981)) (discussing that the petitioner failed to meet its burden of proving that the asserted prior art patent (“Raymond patent was entitled to the benefit of its earlier-filed provisional (“Raymond provisional”) filing date); *Securus Tech.*, 2015 Pat. App. Filings LEXIS 6049, *8 (quoting 37 C.F.R. § 42.104(b)(4) (2012))).

In this showing, Petitioner (through expert review) has specified where each element of a claim in Pylant is found in the Pylant provisional. Ex. 1002, ¶¶132-136. At this point, Petitioner has met its initial burden. However, Petitioner goes further and shows Pylant’s provisional application provides written description support for the subject matter relied on in the Pylant patent. *Dynamic Drinkware*, 800 F.3d at 1379. As required under *Dynamic Drinkware*, Petitioner shows the requisite support in the Pylant provisional for reliance on disclosures from the ‘395 Patent. Ex. 1002, ¶¶132-136. Dr. Shamos has reviewed the Pylant provisional and the Pylant issued patent under *Dynamic Drinkware* and concluded the subject matter in the Pylant Patent is fully supported by the ‘405 Provisional. *See* redlined Ex. 1036; Ex. 1002, ¶¶137-140.

B. GROUND 1: Pylant renders obvious Claim 1

Pylant renders obvious claim 1. Pylant teaches a mobile lawyer system specifically for uses in a traffic stop. Pylant further teaches automatically

establishing a network connection for a real-time video conference that can be stored as it is occurring (*e.g.*, in real-time as a media streaming event). *See* Pylant, 1:65-67; 2:27-30. Pylant teaches using a video camera or plurality of cameras (13:6-11). Pylant further teaches a mobile device with a display (a display 254, 13:2, 30-35)) and a remote server and database (“The database 320 can be any type of database or memory, and can be associated with a content server on a network (*e.g.*, content server 106 web server 120 or application server 108 from FIG. 1) or a user's device (*e.g.*, device 101-104 or device 200 from FIGS. 1-2) (15:19-23). Pylant describes a database comprised of a “dataset” of data associated with users, service, applications, content, and the like (“database 320 can store data for users, *e.g.*, user data. Such user data can be for those users requesting a consultant as well as user data for consultants”). Pylant, 15:33-36; *See* Ex. 1002, ¶¶143-149.

Further Pylant teaches automatically establishing a network connection for video conferencing between a user and an expert user having a knowledge associated with the determined specific and occurring real-world situation of the user. (*See e.g.*, traffic stop as described at 7:11-33). Pylant discloses streaming video and audio in real time (1:63-67). All elements of claim 1 not explicitly revealed in Pylant are rendered obvious by a POSITA's knowledge. Ex. 1002, ¶¶143-149.

1. Preamble – A mobile lawyer system for use during a traffic stop comprising:

Pylant discloses this limitation. Pylant provides “The disclosed systems and

methods automatically, in real-time, establish a network connection between two users based on one user's current situation and the other user's determined expertise in that situation. [Pylant, Abstract]. The experts contemplated by Pylant include ("consultant, doctor, and **attorney**"). 2:38-39; *see also* 8:1-5 ("**attorney**, doctor, psychiatrist or other professional"). Ex. 1002, ¶150.

Pylant also explicitly teaches a system for the specific example of consulting an attorney during a traffic stop: "The disclosed system would enable Jeff, upon initiating a request, is able to reach, via preferably video, but at least via audio signal, an **attorney** to advise Jeff during his traffic stop." [Pylant, 7:21-24, 2:36-41] ("automatically establishing a network connection for video conferencing between a user and an expert user (consultant, doctor, **attorney**, representative) having an expertise associated with the determined specific and currently occurring real-world situation of the user."). *Id.* at ¶151.

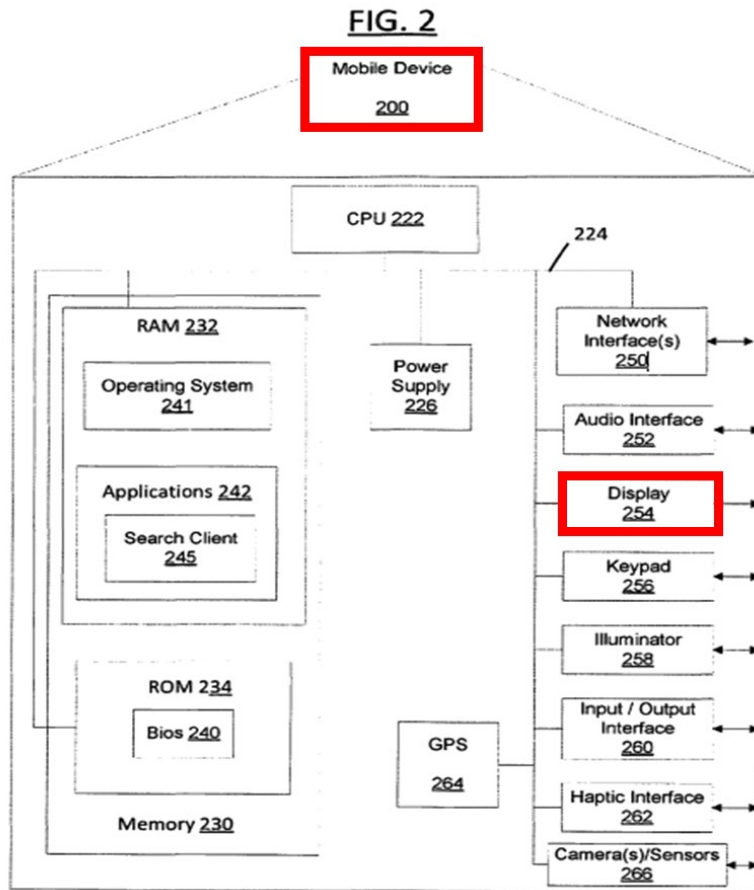
Pylant provides a real-world example in which a user (Jeff) is pulled over for a DUI [a traffic stop]. Pylant, 7:14-24. "For example, if user Jeff is pulled over for suspected drunken driving (*e.g.*, DUI—driving under the influence), user Jeff would not have the ability to contact an **attorney** and receive legal advice.... The disclosed system would enable Jeff, upon initiating a request, [] to reach, via preferably video, but at least via audio signal, an **attorney** to advise Jeff during his traffic stop." *Id.*; Ex. 1002, ¶152; *see also* Pylant at 7:34-63 (disclosing second example using Jim).

a. mobile device having at least one video camera configured for mounting inside the passenger compartment of a vehicle and capture video images of a driver of the vehicle;

Pylant discloses this limitation. Ex. 1002, ¶¶153-157. Pylant discloses the use of a mobile device while in a vehicle in its DUI example in which video captures the image of a driver: “The disclosed system would enable Jeff, upon initiating a request, is able to reach, via preferably video, but at least via audio signal, an **attorney** to advise Jeff during his traffic stop.” Pylant, 7:21-24. Referring to Figure 2, Pylant further discloses “[d]evice 200 can include one camera/sensor 266, or a plurality of cameras/sensors 266, as understood by those of skill in the art. The positioning of the camera(s)/sensor(s) 266 on device 200 can change per device 200 model, per device 200 capabilities, and the like, or some combination thereof.” Pylant, 13:6-11. Pylant discloses a camera configured for mounting inside the passenger compartment as the client device may be “a Personal Digital Assistant (PDA), a handheld computer, a tablet computer, a phablet, a laptop computer, a set top box, a wearable computer, smart watch, an integrated or distributed device combining various features, such as features of the forgoing devices, or the like.” Pylant, 6:28-32; 9:14-37 (identifying mobile devices as including, among other things, cellular telephones). To the extent not specifically stated in Pylant, a POSITA would have known that mobile devices such as cellular telephones have cameras and can be configured for mounting in a vehicle.

b. the mobile device further incorporating a display screen viewable by the driver of the vehicle;

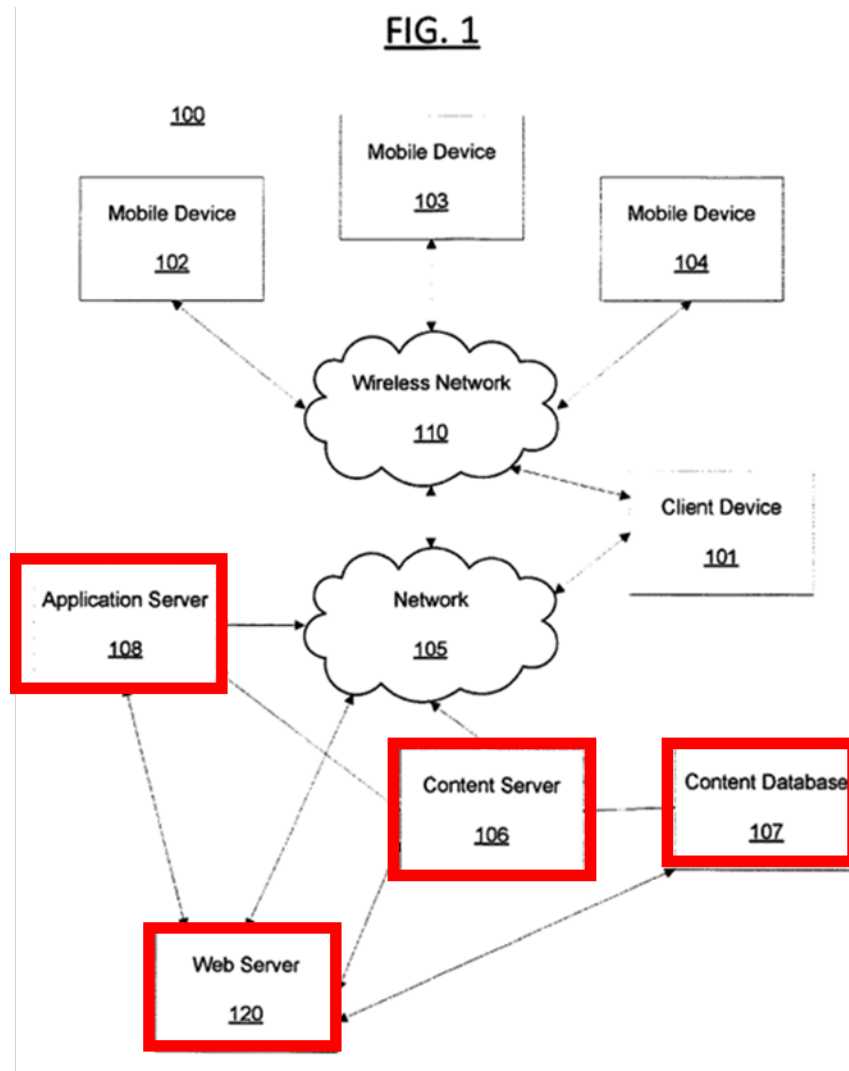
Pylant discloses this limitation. Ex. 1002, ¶¶158-160. Pylant discloses that various mobile devices that have display screens such as cellular phones and PDAs. Pylant 9:14-37 (identifying cellular telephones as mobile devices). “Display **254** may be a liquid crystal display (LCD), gas plasma, light emitting diode (LED), or any other type of display used with a computing device.” 13:30-32. In another example, a web-enabled mobile device may have a touch sensitive screen, a stylus, and an HD display in which both text and graphics may be displayed.” Pylant, 9:32-37. And Pylant teaches the use of a mobile device from a vehicle with the mobile device further incorporating a display screen viewable by the driver of the vehicle using a DUI example with video: “The disclosed system would enable Jeff, upon initiating a request, [] to reach, via preferably video, but at least via audio signal, an attorney to advise Jeff during his traffic stop.” [7:21-24]. *See* also annotated Fig. 2 with Mobile Device 200 and “Display 254.”



c. a remote server and a database configured to store information about a plurality of lawyers licensed in at least one jurisdiction;

Pylant discloses this limitation. Ex. 1002, ¶¶161-168. Pylant discloses that a remote server and a database are included its definition of “server.” Pylant 4:58-61(“‘server’ should be understood to refer to a service point which provides processing, database, and communication facilities”); 4:62-5:1 (“‘server’ can refer to a single, physical processor with associated communications and data storage and database facilities, ... and one or more database systems and application software that support the services provided by the server”). The content servers and databases

store the relevant data for the services (plurality of lawyers, doctors, etc.). 12:3-41; Fig. 1 (“[C]ontent server 106 can also store various types of data related to the content and services provided by content server 106 in an associated content database 107.”



See Annotated Fig. 1 disclosing a multiple servers (remote server) and content database (remote database). See also Fig. 3 and 4.

Pylant also teaches “a database configured to store information about a

plurality of lawyers licensed in at least one jurisdiction.” For example, “[d]atabase 320 comprises a dataset of data and metadata associated with local and/or network information related to users, services, applications, content and the like ... the data (and metadata) in the database 320 can be any type of information and type, ... [a]ccording to some embodiments, database 320 can store data for users, ... as well as user data for consultants.” Pylant, 15:19-36; *See also* Annotated Fig. 1 above. By way of further example, a “feature vector can be stored for each consultant user, and each node of the vector can correspond to information about the consultant (*e.g.*, location, certifications, capabilities, skills, and the like.”). *Id.* at 16:17-21. And, as discussed above, an attorney is one of the experts specifically identified by Pylant. Pylant moreover, further discloses that the database of experts can be narrowed with user input (*e.g.*, if the user is pulled over for speeding, the user can enter his location (to identify an attorney near that location or in that state) and which type of summons he is about to receive such that the appropriately skilled attorney can be identified.” *Id.* at 17:27-32.

d. the mobile device executing a mobile application configured, upon command from the driver of the vehicle,

Pylant discloses this limitation. Ex. 1002, ¶¶169-175. Pylant teaches executing an app on a mobile device. “A web-enabled mobile device may include a browser application that is configured to receive and to send web page, web-based messages, and ... [t]he browser application may be configured to receive and display

graphics, text, multimedia, ... employing virtually any web based language, including a wireless application protocol messages (WAP), and the like.” Pylant, 9:38-44. Pylant discloses that “the requirements for searching for an identifying an expert can be input by the user ... if the user is pulled over for speeding, the user can enter his location (to identify an attorney near that location or in that state) and which type of summons he is about to receive such that the appropriately skilled attorney can be identified.” *Id.* at 17:27-33; *see also* 17:37-47 (noting that information about a specific situation can be automatically detected upon triggering a request initiation (referring to steps 401-402 of Fig. 4), and this information can be entered by a user and/or be a combination of automatically detected and user entered information). In this way, the mobile device executes an application configured upon command of the user driver. For example, claim 1 recites “automatically establishing, via the computing device over a network, a connection between the first user and the consultant, said connection comprising said computing device enabling a live video conference between said first user and the consultant,” which indicates the user has issued a command/inquiry. *See* Pylant, claim 1 at 21:63-67; Ex. 1002, ¶173. Pylant’s DUI-traffic stop example teaches the command could come from the driver of a vehicle. 7:21-24 (“The disclosed system would enable Jeff, ***upon initiating a request***, is able to reach, via preferably video, but at least via audio signal, an attorney to advise Jeff during his traffic stop.”). And other examples disclose that

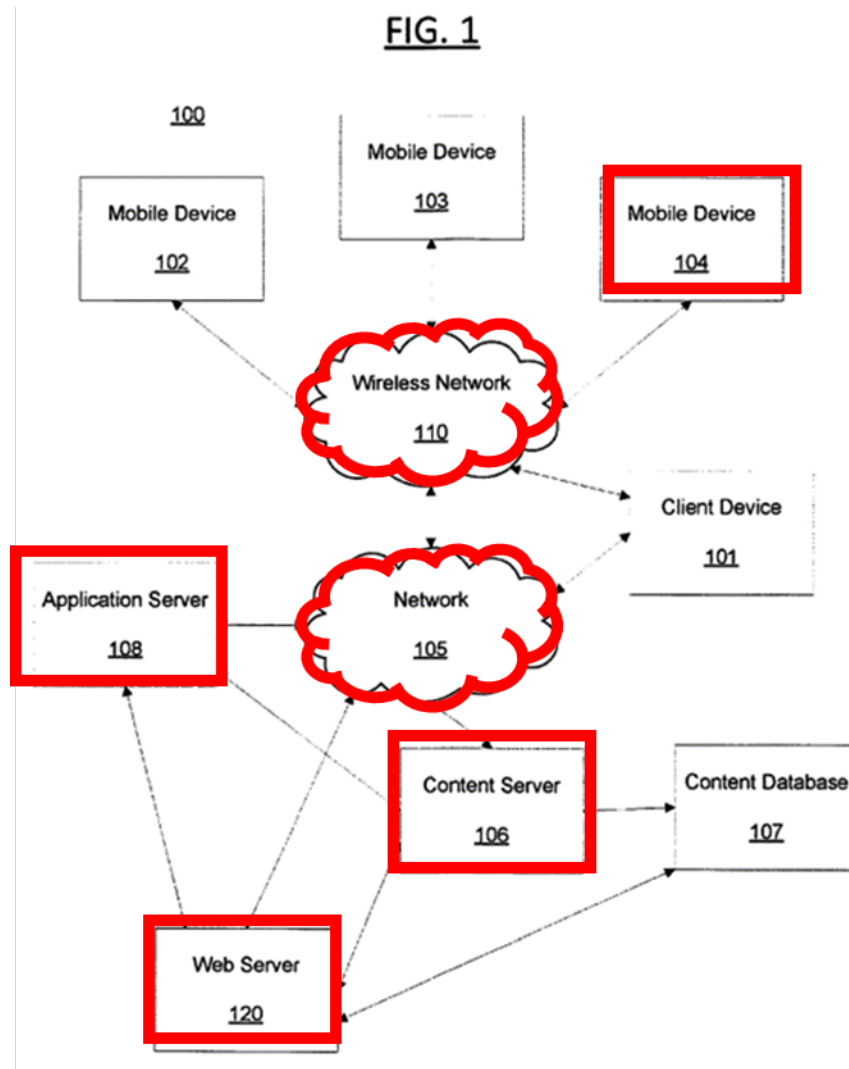
the app can be configured upon such a command. *See, e.g.*, 2:14-22 (“User A *initiates a request for a consultant*. The disclosed systems and methods, *as a result of the consultant request*, can *analyze the user's request* to identify the situation's characteristics, *analyze data associated* with the user (e.g., the time, date, location of the user), and the like, or some combination thereof, in order *to determine details* (attributes, characteristics and/or descriptors) of the situation (e.g., situation X).”; Ex. 1002, ¶¶174-175.

e. to communicate with the remote server,

Pylant discloses this limitation. Ex. 1002, ¶¶176-177. Pylant provides Figure 1 that teaches a network connecting remote servers and mobile devices. *See* Annotated Fig. 1 (showing Mobile Devices 102-104) in communication with Wireless Network 110 in communication with Network 105 in communication with servers 106, 108, 120, and database 107.

Pylant also teaches that “server” can refer to a single, physical processor with associated communications and data storage and database facilities, or it can refer to a networked or clustered complex of processors and associated network and storage devices, as well as operating software and one or more database systems and application software that support the services provided by the server.” 4:58-5:1. Hence, Pylant discloses that the mobile device is configured to communicate with the remote server. Ex. 1002, ¶177. Although the claim is unclear as to what the

“remote server” and “remote database” are “remote” from, Figure 1 (shown below) discloses that servers (106, 108, 120) and content database (107) are remote from mobile devices (102-104) and from the client device (101); *See also* Fig. 3 (disclosing the content database (320) remote from other elements).



f. wherein the remote server is configured to automatically determine a location of the vehicle,

Pylant discloses this limitation. Ex. 1002, ¶¶178-182. Pylant teaches that the processor includes module 302 which is the determination module used to locate the

vehicle. Pylant discloses “consulting request engine 300,” which includes “determination module 302, request module 304, consultant module 306, recording module 308 and communication module 310.” Pylant, 16:41-47.

Pylant describes the determination module in connection with Figure 4. Process 400 begins with the user initiating the consulting request engine 300, which can involve determining the user’s current circumstances including the activity of the user (*e.g.*, Jack being stopped for DUI), the identity of the user, the time, date, **location**, identity of other users involved in the activity, and the like. Pylant, 17:1-10. Determination module 302 performs the accounting of the user’s circumstances, including identifying the data and/or metadata being collected and/or retrieved by the user's device to determine an activity, situation and/or circumstance of the user.” *Id.* at 17:11-17. Pylant discloses that determination module 302 can detect the user’s specific location “via the GPS 264 unit on the user’s device.” *Id.* at 19-21. The location is determined “automatically,” *i.e.*, without the user asking for it to occur. Ex. 1002, ¶179.

g. automatically identify a jurisdiction associated with the vehicle location,

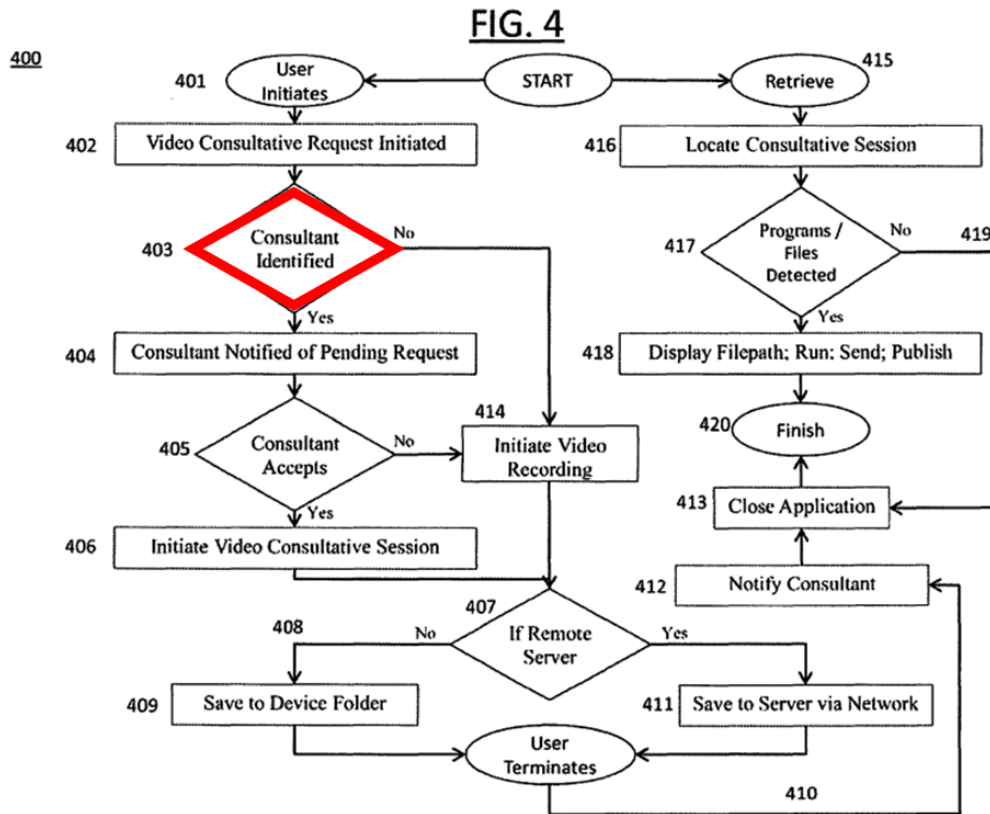
Pylant discloses this limitation. Ex. 1002, ¶¶183-184. As discussed above, “jurisdiction” in this context corresponds to a physical location, typically a state.

Pylant discloses that GPS or other location-identifying type capability available on the client device, such as a smart phone or tablet, is accessed by

determination module 302. *See* Pylant, 17:19-21; Ex. 1002, ¶182. Because the location identification is determined automatically, the identification of the jurisdiction (*i.e.*, state) associated with that location is also done automatically. Ex. 1002, ¶¶183-184.

h. automatically identify at least one lawyer licensed in the identified jurisdiction,

Pylant discloses this limitation. Ex. 1002, ¶¶185-189. Pylant discloses that a consultant's information, including certifications, capability, skills, etc. is corresponding information is stored and available via the app. Pylant, 6:14-21 (“[A] feature vector can be stored for each consultant user, and each node of the vector can correspond to information about the consultant (*e.g.*, **location**, certifications, capabilities, skills, and the like.”). Once the user starts the app, a video consultation is requested and automatically a consultant (*e.g.*, attorney) is identified. *See* Figure 4; 16:55-60 (“Process 400 details some embodiments of **automatically** establishing a network connection for video conferencing between a user and an expert user having an expertise associated with the determined specific and currently occurring real-world situation of the user.”). Steps 403-405 (consultant identified, consultant notified, consultant accepts) occur automatically, and are performed by consultant module 306. Pylant, 16:64-65; *see* Annotated Fig. 4 at 403.



Step 403, as a result of the communicated request from Step 402, a search is performed and determination is made regarding whether a consultant is identified from the request. Pylant, 17:48-50; Annotated Fig. 4 above. Ex. 1002, ¶189.

i. and immediately automatically directly notify the at least one identified lawyer for assistance; and

Pylant discloses this limitation. Ex. 1002, ¶¶190-191. Referring to Figure 4 above, Pylant discloses notifying the consultant (*e.g.*, attorney) in Step 404, which directly follows step 403 (consultant identified). The notification can be any type of message or notification (*e.g.*, IM, SMS, MIMS, email, phone call, and the like).

Pylant, 18:13-21. According to Figure 4, Step 404 occurs directly after Step 403 and since this is an electronic system would occur shortly (*i.e.*, immediately) and without intervention (*i.e.*, “automatically”) after Step 403. Figure 4; 18:13-21; Ex. 1002, ¶190. It would have been apparent to a POSITA that the lawyer must be notified “directly” while the traffic stop is in progress, and hence “immediately.” Ex. 1002, ¶191.

“If the consultant accepts the request from Step 404, then the system starts a video conference session between the user and the identified consultant, which is depicted in Step 406. In some embodiments, such session is recorded.” Pylant, 18:13-21; *see* Fig. 4.

j. the display screen of the mobile device configured to live-stream a video image of the at least one identified lawyer for presentation to the driver of the vehicle,

Pylant discloses this limitation. Ex. 1002, ¶¶192-197. Pylant teaches many devices with displays to live stream a video image. For example, “[i]f the consultant (*e.g.*, identified lawyer) accepts the request from Step 404, then a video conference session is initiated between the initiating user and the identified consultant Step 406.” Pylant, 18:17-20; Fig. 4. Pylant, in fact, explicitly discloses live streaming of a video conference (including video and audio creating a bi-directional relationship between the user and attorney) that is stored as it is occurring, *e.g.*, in real-time as a media streaming event. *See* Pylant, 1:63-67. And Pylant discloses well-known cell

phone or mobile device with a display *Id* at 13:30-35 (“Display **254** may be a liquid crystal display (LCD), gas plasma, light emitting diode (LED), or any other type of display used with a computing device. Display **254** may also include a touch sensitive screen arranged to receive input from an object such as a stylus or a digit from a human hand.”) .

Pylant further teaches downloading an app to a user’s mobile device, *e.g.*, cell phone and using videoconferencing. For example, “consulting request engine 300 can function as a downloadable application installed on the user's device, and in some embodiments, such application can be a web-based application accessed by the user device over a network.” Pylant, 15:8-12. “[C]onsulting request engine 300 can be installed as an augmenting script, program or application to another application, such as, for example, a video chat application (*e.g.*, FaceTime®, Skype®, and the like) that enables two users to communicate in real-time via video conferencing.” *Id.* at 15:6-17.

Pylant further teaches that the client device can vary in terms of capabilities and features and that his system is intended to cover a wide variety of potential variations. 6:32-35. Such variations include a “smart phone,” “phablet or tablet,” and/or “a web-enabled client device” that “may include a high resolution screen, one or more physical or virtual keyboards, mass storage, one or more accelerometers, one or more gyroscopes, global positioning system (GPS) or other location-

identifying type capability.” 6:33-45; 9:23-36 (further describing mobile devices as “virtually any portable computing device”). These devices can include cell phones and smart phones, both known to have video conferencing, video display, recording, camera equipped, etc. all limitations of claim 1. *See* Pylant, 9:23-36; *see also* Figs. 2 & 4 and Ex. 1002, ¶197.

k. and the at least one video camera is configured to automatically live-stream video captured by the at least one video camera for viewing by the at least one identified lawyer and for storage in the remote database,

Pylant discloses this limitation. Ex. 1002, ¶¶198-201. Pylant’s disclosed systems and methods “provide a computerized fully automated network environment that enables video conferencing between two geographically remote users.” Pylant, 1:52-55. A first user that triggers a request for a second user, and the second user is an identified expert user that is identified and selected based on, *inter alia*, the circumstances of the first user, the credentials of the second user (and how that correlate to the first user's circumstances), the identity of the first user and/or second user, the activity of the first user, and the like, and/or some combination thereof.” *Id.* at 55-62. Once second user (or expert user, used interchangeably herein) is identified, a video consultant session (or video conferencing session) is initiated between the two users. *Id.* at 1:62-65. ***“The session can be stored as it is occurring (e.g., in real-time as a media streaming event). In some embodiments, the storage of the session can occur locally on either or both users’ device: and/or in some***

embodiments, the video session can be stored on a server.” Id. at 1:65-2:3.

A POSITA would understand such a video session would be made possible via a video camera configured to live-stream such video, and that Pylant indicates this occurs automatically. Pylant, 2:27-34 (“The present disclosure provides novel systems and methods for *automatically*, in real-time, establishing a network connection for video conferencing between a user and an expert user [*e.g.*, an attorney].”); *see also* 2:27-34 (“Once the expert user is identified, the expert user and the user A are *automatically* put in contact with one-another via a created/established network connection that includes a video conferencing session.”); 2:35-41 (further discussing “automatically” establishing a network connection for video conferencing between a user and an expert, including an “attorney”). Ex. 1002, ¶200. Pylant also teaches that the interaction (*i.e.*, the video conferencing session) is stored for later retrieval and/or evidence. Pylant, 2:30-32.

- I. where the at least one mobile device being configured to automatically enable bi-directional audio and video communication between the at least one identified lawyer and the at least one passenger.**

Pylant discloses this limitation. Ex. 1002, ¶¶201-204. Petitioner incorporates by reference its citations from 1[k] above. Pylant teaches well-known two-way communication videoconferencing with applications like FaceTime and Skype. Pylant, 15:12-18 (disclosing “video chat application[s] (*e.g.*, FaceTime®, Skype®, and the like) that enables two users to communicate in real-time via video

conferencing”). Pylant also teaches that the mobile device is configured to “automatically” enable such communication. Pylant, 2:27-29 (“Once the expert user is identified, the expert user and the user A are *automatically* put in contact with one-another via a created/established network connection that includes a video conferencing session.”) Further, to the extent the term “passenger” were construed to be a second person in the vehicle (*e.g.*, not the user/driver), a POSITA would understand there could be more than one person in a vehicle at the time of, for example, a traffic stop, and that under such circumstances, the driver may hand the mobile device to the passenger to hold such that the video communication would then be between the identified lawyer and the passenger. Ex. 1002, at ¶204.

IX. SECONDARY CONSIDERATIONS

There are no secondary considerations known to Petitioner.

X. DISCRETIONARY DENIAL IS UNWARRANTED

Petitioners are aware that the Board has discretion not to institute based on the factors outlined in 35 U.S.C. § 314(a) and the Board’s case law. *See, e.g., Bentley Motors Ltd. v. Jaguar Land Rover Ltd.*, No. IPR2019-01539, 2020 WL 5875779 (P.T.A.B. Oct. 2, 2020); *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, 2020 WL 2126495 (P.T.A.B. Mar. 20, 2020). But in the interest of justice—as shown by the particular and compelling facts discussed—the Board should not exercise its discretion to decline institution here.

A. Discretionary Denial Is Unwarranted Under *Fintiv*

Under 35 U.S.C. § 314, the PTAB applies the *Fintiv* factors when considering whether to exercise its discretion to deny institution of an IPR in view of parallel district court litigation. Director Vidal recently issued a precedential decision clarifying that the PTAB must first determine whether *Fintiv* factors 1-5 favor discretionary denial of a petition; if that analysis supports discretionary denial, the Board should engage the compelling merits question. *CommScope Technologies LLC et al. v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 6 (PTAB Feb. 27, 2023) (Director Review). If not, the Board should use the lower institution standard to analyze Petitioner’s unpatentability challenge as set by statute. *See* 35 U.S.C. § 314(a) (2018) (allowing institution of an IPR 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”).

The PTAB applies the *Fintiv* rule, considering and balancing certain factors in deciding whether to exercise its discretion under 35 U.S.C. § 314(a) to deny institution of an IPR due to the existence of parallel district court litigation. *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, 2020 WL 2126495 (P.T.A.B Mar. 20, 2020) (precedential, May 5, 2020).

Here, the *Fintiv* factors do not favor discretionary denial.

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

Petitioner has not yet asked for a stay of the district court proceeding. But, as PTAB is aware, it is common to seek a stay after an IPR is filed, and particularly after institution is granted. To that end, Petitioner believes that the arguments and evidence presented show a reasonable likelihood it would prevail regarding at least 1 of the claims challenged in the petition. Petitioner believes the court should grant a motion to stay because the factors would favor a stay. Even if Petitioner waited until institution to seek a stay (around April 2024), a stay would still simplify the issues and save the parties' and district court resources. The expert report, expert discovery, and dispositive motion dates are yet to occur and the trial-ready date (January 15, 2025) is still far off. Regardless, however, a stay would simplify the issues before the district court.

Moreover, because Patent Owner is not a practicing entity, a stay would not be unduly prejudicial or put Patent Owner at a tactical disadvantage. This factor favor does not favor denial or is at most neutral.

2. Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision

When applying this factor, the PTAB has taken the court's trial schedules at face value absent some strong evidence to the contrary. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (May 13, 2020) (informative) (applying the Fintiv

factors articulated in the precedential *Fintiv* decision). At the time of filing this petition, the court has a trial date set for January 15, 2025. Assuming the IPR is instituted in April 2024, the Board’s final written decision would be due in April 2025. This three month difference between the trial date and the final written decision should not be viewed as significant to given the fact court deadlines slip. Even Director Vidal wrote “Stakeholders correctly noted that scheduled trial dates are unreliable and often change.” *See Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation*.⁴ “A court’s scheduled trial date, therefore, is not by itself a good indicator of whether the district court trial will occur before the statutory deadline for a final written decision.” *Id.*

Because Docket Navigator has no data for Judge Nancy Brasel’s average time to trial, Petitioner looked at the time to trial for the District of Minnesota. The results show an average time of 45 months⁵ compared to the national average (of all courts/judges) of 32 months. The case filing dates ranged from January 1, 2008 to October 20, 2023.

Given the average time to trial of 45 months, the court should weigh this factor

⁴ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

⁵ Excludes outliers.

against exercising discretion to deny institution.

3. Investment in the parallel proceeding by the court and the parties

Neither the parties nor the court have made a significant investment in the proceeding. At the time of the filing, the parties have served infringement and invalidity contentions, served written discovery (no depositions have been conducted), and produced a limited number of documents. The claim construction process has begun, but there is currently no date for *Markman* briefing and no scheduled *Markman* hearing date.⁶ This factor does not favor denial or is at most neutral due to the limited investment by the parties and the court.

4. Overlap between issues raised in the petition and in the parallel proceeding

The petition and the parallel district court litigation raise the same issues. This petition challenges each claim Patent Owner asserted in its infringement contentions. This factor does not favor denial.

5. The petitioner and the defendant in the parallel proceeding are the same party

The parties in the both the district court proceeding and the IPR are the same.

⁶ On September 8, 2023, Petitioner filed a Motion for Judgment on the Pleadings that the Asserted Claim was invalid under 35 U.S.C. § 101. That Motion was fully briefed on October 25, 2023.

This factor does not favor denial.

Collectively, the factors weigh against discretionary denial. So, under the Director's guidance, the Board should evaluate the merits of the petition under the statutory standard where institution of an *inter partes* review under 35 U.S.C. § 314 is justified if there is a reasonable likelihood that the petitioner would prevail regarding at least 1 of the claims challenged in the petition.

B. General Plastics is not applicable

This is the first petition filed by Petitioner for the '395 Patent. Thus, no follow-on petitions indicate *General Plastics*' applicability. No other entity has filed petitions challenging this patent.

XI. CONCLUSION

For the reasons stated above, Petitioners request institution of *inter partes* review of claim 1.

Respectfully submitted,

Dated: October 27, 2023

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and TurnSignl Foundation*

CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

The undersigned certifies, pursuant to 37 C.F.R. §42.24(d), that the word count for the foregoing Petition for *Inter Partes* Review of U.S. Patent No. 11,443,395 under 35 U.S.C. § 312 and 37 C.F.R. § 42.104 totals 12,979 words and is within the 14,000 words (excluding parts exempted under § 42.24(a)) allowed under 37 C.F.R. §42.24(a)(1)(i), as measured by the word-processing system used to prepare this paper.

Respectfully submitted,

Dated: October 27, 2023

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CERTIFICATE OF SERVICE

I certify that a true and correct copy of the PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 11,443,395, all supporting exhibits, and the Power of Attorney were served on October 27, 2023 via Priority Mail Express to the correspondence address of record:

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Dallas, TX 75214

Respectfully submitted,

Dated: October 27, 2023

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