

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. IPR2024-00104
U.S. Patent No. 11,494,862

**PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 11,494,862**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	PRECISE RELIEF REQUESTED.....	2
III.	MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(a)(1).....	2
A.	Real Party-in-Interest	2
B.	Related Matters.....	2
C.	Grounds for Standing	3
D.	Lead and Back-up Counsel and Service.....	3
IV.	IDENTIFICATION OF CHALLENGES UNDER § 42.104(b)	4
V.	STATE OF THE ART RELATIVE TO THE '862 PATENT	4
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.....	5
B.	Determining the Location of the Mobile Device Was Well Known, as was Identifying a Lawyer Licensed in a Particular Jurisdiction/Location.....	7
C.	Servers, Databases, and Communications With Them Were Well Known.	8
D.	Summary of Prior Art and the Information a POSITA Would Have Understood Prior to the Critical Date of the '862 Patent.	9
VI.	OVERVIEW OF THE '862 PATENT	16
A.	PROSECUTION HISTORY	16
B.	THE '862 PATENT IS NOT ENTITLED TO THE '300 PROVISIONAL PRIORITY DATE	17
C.	CLAIM CONSTRUCTION UNDER 37 C.F.R. § 42.104(b)(3)	20

VII. PERSON OF ORDINARY SKILL IN THE RELEVANT FIELD AND RELEVANT TIMEFRAME	23
VIII. UNPATENTABILITY GROUND	23
A. Summary of the Prior Art.....	23
1. U.S. Patent No. 11,010,810 (“Pylant”) (Ex. 1033).....	23
2. Pylant is prior art to the Challenged Claims based on its filing date.	25
3. Pylant is prior art to the Challenged Claims based on its provisional filing date.	26
B. GROUND 1: Pylant, combined with the knowledge of a POSITA, renders each of the challenged claims obvious.....	27
1. Claim 1 is rendered obvious in view of Pylant.....	27
1 [Pre] – A mobile lawyer system, the system comprising:.....	27
1[a] a remote server and a remote database;	28
1[b] at least one video camera;.....	29
1[c] at least one display screen;.....	29
1[d] a mobile device executing a mobile application in communication with the at least one video camera and the at least one display screen,.....	30
1[e] and configured, upon a one-click command from a user of the mobile device, to automatically and immediately communicate a current location of the mobile device to the remote server,.....	31
1[f] the remote server being configured to:.....	33
i. automatically search a plurality of information records associated with a plurality of lawyers stored in the remote database;.....	34

ii.	automatically identify at least one lawyer licensed in a jurisdiction that correspond [sic] to the current location of the mobile device;.....	35
iii.	automatically transmit at least one notification to at least one computing device associated with the identified at least one lawyer;.....	36
iv.	receive an acceptance of engagement from a selected one of the at least one computing device associated with a selected one of the identified at least one lawyer;	36
v.	and automatically and immediately set up a bi-directional video communication session between the selected one of the at least one computing device associated with the selected one of the at least one lawyer and the mobile device, ...	37
vi.	so that live video data of the user is automatically transmitted to the selected computing device associated with the selected lawyer and live video data of the selected lawyer is automatically transmitted to the at least one display screen;	38
1[g]	automatically and immediately enable the at least one display screen to stream live video data of the selected lawyer, and the at least one video camera capture and stream live video of the user and surroundings to the computing device for viewing by the selected lawyer; and	38
1[h]	and automatically and immediately enable live video data from the mobile device and the selected computing device to be transmitted to the remote server and database for secure storage.	39
2.	Claim 6 is rendered obvious in view of Pylant.....	40
6 [Pre]	A mobile lawyer method comprising:	40
6[a]	receiving a live consultation request from a user's mobile device;	41

6[b] automatically and immediately initiating capture of images of the user and surroundings; and live-streaming the captured images to a remote server for encrypted storage via a computer network in response to receiving the consultation request;	41
6[c] automatically and immediately determining a current location of the mobile device;	42
6[d] automatically and immediately transmitting the current location of the mobile device to the remote server;	42
6[e] automatically searching, at the remote server, a plurality of information database records associated with a plurality of lawyers stored in the remote database;	42
6[f] automatically identifying, at the remote server, at least one lawyer licensed in a jurisdiction that correspond to the current location of the mobile device;	42
6[g] automatically transmitting, by the remote server, at least one notification to at least one computing device associated with the identified at least one lawyer;	42
6[h] automatically receiving live-streaming video data of an identified remote lawyer licensed to practice law in a jurisdiction associated with the current location of the mobile device;	43
6[i] automatically live-streaming captured video images of the user to the at least one remote lawyer via the remote server;	44
6[j] automatically displaying the live-streaming video data of the identified at least one remote lawyer on a display monitor viewable by the user; and	44
6[k] automatically storing the captured video data of the user and the at least one remote lawyer in a data storage device accessible by the remote server.	44
3. Claim 7 is rendered obvious in view of Pylant.	45

7 . The mobile lawyer method of claim [6] wherein initiating capture of images of the user and surroundings comprises initiating a capture of video images by at least one video camera selected from the group consisting of: at least one video camera mounted on a drone, at least one camera native to the mobile device, front and back-facing cameras native to the mobile device, at least one camera integrated and mounted on a vehicle, at least

one camera mounted at various points of a vehicle, at least one camera with infrared capabilities, and at least one 360- degree video camera.	45
4. Claim 10 is rendered obvious in view of Pylant.....	46
10. The mobile lawyer method of claim 6, wherein automatically determining a location of the user comprises accessing a GPS location of the user and determining a street address location from the GPS location.	46
5. Claim 11 is rendered obvious in view of Pylant.....	46
11. The mobile lawyer method of claim 10 further comprising automatically searching, by the remote server, a database storing data associated with a plurality of lawyers, and automatically identifying at least one remote lawyer licensed in a jurisdiction that matches the current location of the user.....	47
6. Claim 15 is rendered obvious in view of Pylant.....	47
15 [Pre] A mobile lawyer system comprising:	47
15[a] a remote server and a remote database;.....	47
15[b] at least one video camera selected from the group consisting of: at least one video camera mounted on a drone, at least one camera native to the mobile device, front and back-facing cameras native to the mobile device, at least one camera integrated and mounted on a vehicle, at least one camera mounted at various points of a vehicle, and at least one 360-degree video camera;	48
15[c] a computing device having a display screen and executing a mobile application in communication with the at least one video camera,.....	48
15[d] and configured, upon command from a user, to automatically determine a current location of the user,.....	48
15[e] communicate with the remote server and notify at least one attorney located remotely,.....	48
15[f] the at least one attorney being selected based on at least one of the attorney's licensure jurisdiction being consistent with the user's current location;.....	48
15[g] the remote server being configured to:	48
i. automatically search a plurality of information records associated with a plurality of attorneys stored in the remote database;	49

ii.	automatically identify at least one attorney licensed in a jurisdiction that correspond to the current location of the mobile device;	49
iii.	and automatically transmit at least one notification to at least one computing device associated with the identified at least one attorney;.....	49
15[h]	and the display screen configured to automatically display a live video image of the remote attorney upon acceptance of notification by the at least one remote attorney, ...	49
15[i]	and the at least one video camera being configured to automatically capture images of an ongoing incident involving the user subscriber and live-stream the captured video of the user subscriber and surroundings for live viewing by the at least one remote attorney and for storage in the database.....	50
7.	Claim 20 is rendered obvious in view of Pylant.....	50
20.	The mobile lawyer method of claim 15, wherein automatically determining a location of the user comprises accessing a GPS location of the user, and automatically identifying at least one remote lawyer licensed in a jurisdiction that matches the location of the user and matching additional filter criteria specified by the user.	50
IX.	SECONDARY CONSIDERATIONS	51
X.	DISCRETIONARY DENIAL IS UNWARRANTED	51
A.	Discretionary Denial Is Unwarranted Under <i>Fintiv</i>	51
1.	Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted	52
2.	Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision	53
3.	Investment in the parallel proceeding by the court and the parties	54
4.	Overlap between issues raised in the petition and in the parallel proceeding.....	55
5.	The petitioner and the defendant in the parallel proceeding are the same party.....	55

B.	General Plastics is not applicable.....	56
XI.	CONCLUSION.....	56

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Amgen Inc. v. Sanofi</i> , 872 F.3d 1367 (Fed. Cir. 2017)	17
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 15 (May 13, 2020).....	53, 54
<i>Apple Inc. v. Fintiv, Inc.</i> , No. IPR2020-00019, 2020 WL 2126495 (P.T.A.B. Mar. 20, 2020).....	51, 52, 53
<i>Bentley Motors Ltd. v. Jaguar Land Rover Ltd.</i> , No. IPR2019-01539, 2020 WL 5875779 (P.T.A.B. Oct. 2, 2020).....	51
<i>CommScope Technologies LLC et al. v. Dali Wireless, Inc.</i> , IPR2022-01242, Paper 23 (PTAB Feb. 27, 2023).....	51
<i>Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.</i> , 800 F.3d 1375 (Fed. Cir. 2015)	26, 27
<i>Monsanto Co. v. Syngenta Seeds, Inc.</i> , 503 F.3d 1352 (Fed. Cir. 2007)	18
<i>Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.</i> , 868 F.3d 1013 (Fed. Cir. 2017)	20
<i>Redmon Jeang LLC v. TurnSignl, Inc. and TurnSignl Foundation</i> , Case No. 0:22-cv-02749-NEB-LIB (Oct. 31, 2022)	<i>passim</i>
<i>In re Wertheim</i> , 646 F.2d 527 (CCPA 1981)	26

Statutes

35 U.S.C. § 101	55
35 U.S.C. § 102(a)(2).....	24
35 U.S.C. § 102(d)	26

35 U.S.C. § 102(e)(1).....	26
35 U.S.C. § 103	2, 4
35 U.S.C. § 112(d)	17, 18
35 U.S.C. § 311	2
35 U.S.C. § 312.....	58
35 U.S.C. § 314.....	51, 55
35 U.S.C. § 314(a) (2018).....	52
35 U.S.C. § 315(b)	3
Other Authorities	
37 C.F.R. § 42.8(a)(1)	2
37 C.F.R. § 42.15(a).....	4
37 C.F.R. §42.24(a)(1)(i)	58
37 C.F.R. § 42.24(d)	58
37 C.F.R. § 42.101	3
37 C.F.R. § 42.104	58
37 C.F.R. § 42.104(b)(3).....	20
“Smartphone History: The Timeline of a Modern Marvel” (“Smartphone History”) (Ex. 1008).....	6
Rule 42.104(a).....	3

EXHIBIT LIST

Ex. No.	Brief Description
Ex. 1001	US Patent No. 11,494,862(“’862 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. 11,443,395 (“’395 Patent”)
Ex. 1005	US Patent No. 11,494,861 (“’861 Patent”)
Ex. 1006	US Patent No. 11,494,862, 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
Ex. 1036	Redline b/w '405 provisional and Pylant
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"
Ex. 1042	Table mapping '300 Provisional to '395 Patent
Ex. 1043	Plaintiff's Resp. and Objs. to Defs. First Set of Rogs
Ex. 1044	Declaration of Susan Hanrahan
Ex. 1045	Extrinsic evidence, dictionary definition for "automatically"

CLAIMS LISTING

Claim 1 – [Pre] A mobile lawyer system, the system comprising:

- a. a remote server and a remote database;
- b. at least one video camera;
- c. at least one display screen;
- d. a mobile device executing a mobile application in communication with the at least one video camera and the at least one display screen,
- e. and configured, upon a one-click command from a user of the mobile device, to automatically and immediately communicate a current location of the mobile device to the remote server,
- f. the remote server being configured to:
 - i. automatically search a plurality of information records associated with a plurality of lawyers stored in the remote database;
 - ii. automatically identify at least one lawyer licensed in a jurisdiction that correspond to the current location of the mobile device.
 - iii. automatically transmit at least one notification to at least one computing device associated with the identified at least one lawyer;
 - iv. receive an acceptance of engagement from a selected one of the at least one computing device associated with a selected one of the identified at least one lawyer;
 - v. and automatically and immediately set up a bi-directional video communication session between the selected one of the at least one computing device associated with the selected one of the at least one lawyer and the mobile device,
 - vi. so that live video data of the user is automatically transmitted to the selected computing device associated with the selected lawyer and live video data of the selected lawyer is automatically transmitted to the at least one display screen;
- g. automatically and immediately enable the at least one display screen to stream live video data of the selected lawyer, and the at least one video camera capture and stream live video of the user and surroundings to the computing device for viewing by the selected lawyer;
- h. and automatically and immediately enable live video data from the mobile device and the selected computing device to be transmitted to the remote server and database for secure storage.

Claim 6 – [Pre] A mobile lawyer method comprising:

- a. receiving a live consultation request from a user's mobile device;
- b. automatically and immediately initiating capture of images of the user and surroundings, and live-streaming the captured images to a remote server for encrypted storage via a computer network in response to receiving the consultation request;
- c. automatically and immediately determining a current location of the mobile device;
- d. automatically and immediately transmitting the current location of the mobile device to the remote server;
- e. automatically searching, at the remote server, a plurality of information records associated with a plurality of lawyers stored in the remote database;
- f. automatically identifying, at the remote server, at least one lawyer licensed in a jurisdiction that correspond to the current location of the mobile device;
- g. automatically transmitting, by the remote server, at least one notification to at least one computing device associated with the identified at least one lawyer;
- h. automatically receiving live-streaming video data of an identified remote lawyer licensed to practice law in a jurisdiction associated with the current location of the mobile device;
- i. automatically live-streaming captured video images of the user to the at least one remote lawyer via the remote server;
- j. automatically displaying the live-streaming video data of the identified at least one remote lawyer on a display monitor viewable by the user; and
- k. automatically storing the captured video data of the user and the at least one remote lawyer in a data storage device accessible by the remote server.

Claim 7

The mobile lawyer method of claim 6, wherein initiating capture of images of the user and surroundings comprises initiating a capture of video images by at least one video camera selected from the group consisting of: at least one video camera mounted on a drone, at least one camera native to the mobile device, front and back-facing cameras native to the mobile device, at least one camera integrated and mounted on a vehicle, at least one camera mounted at various points of a vehicle, at least one camera with infrared capabilities, and at least one 360- degree video camera.

Claim 10

The mobile lawyer method of claim 6, wherein automatically determining a location of the user comprises accessing a GPS location of the user and determining a street address location from the GPS location.

Claim 11

The mobile lawyer method of claim 10 further comprising automatically searching, by the remote server, a database storing data associated with a plurality of lawyers, and automatically identifying at least one remote lawyer licensed in a jurisdiction that matches the current location of the user.

Claim 15 – [Pre] A mobile lawyer system comprising:

- a. a remote server and a remote database;
- b. at least one video camera selected from the group consisting of: at least one video camera mounted on a drone, at least one camera native to the mobile device, front and back-facing cameras native to the mobile device, at least one camera integrated and mounted on a vehicle, at least one camera mounted at various points of a vehicle, at least one camera with infrared capabilities, and at least one 360-degree video camera;
- c. a computing device having a display screen and executing a mobile application in communication with the at least one video camera,
- d. and configured, upon command from a user, to automatically determine a current location of the user,
- e. communicate with the remote server and notify at least one attorney located remotely,
- f. the at least one attorney being selected based on at least one of the attorney's licensure jurisdiction being consistent with the user's current location;
- g. the remote server being configured to:
 - i. automatically search a plurality of information records associated with a plurality of attorneys stored in the remote

- database;
- ii. automatically identify at least one attorney licensed in a jurisdiction that correspond to the current location of the mobile device;
- iii. and automatically transmit at least one notification to at least one computing device associated with the identified at least one attorney;
- h. and the display screen configured to automatically display a live video image of the remote attorney upon acceptance of notification by the at least one remote attorney,
- i. and the at least one video camera being configured to automatically capture images of an ongoing incident involving the user subscriber and live-stream the captured video of the user subscriber and surroundings for live viewing by the at least one remote attorney and for storage in the database.

Claim 20

The mobile lawyer method of claim 15,
wherein automatically determining a location of the user comprises accessing a GPS location of the user, and automatically identifying at least one remote lawyer licensed in a jurisdiction that matches the location of the user and matching additional filter criteria specified by the user.

I. INTRODUCTION

This petition establishes the unpatentability of claims 1, 6, 7, 10, 11, 15, and 20 of U.S. Patent No. 11,494,862 (the “Challenged Claims” of the “’862 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 ’862 Patent with 20 claims originally presented. No Office Actions issued. A terminal disclaimer was filed to overcome a nonstatutory double patenting rejection as the U.S. Patent No. 11,443,395 (Ex. 1004) and 11,494,861 (Ex. 1005) was commonly owned with the ’862 Patent. The claims 1-20 are drawn to introducing a third party (*e.g.*, a licensed attorney) into an encounter needing a lawyer, *e.g.*, such as a traffic stop (’862 Patent at 2: 28-32; 5:21-24) via a live video conference between at least one an attorney located remotely and another party with a mobile device executing a mobile application.

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 ’862 Patent. The knowledge of a POSITA is discussed in detail in Section V “State of the Relevant Art,” and demonstrated by the exhibits cited in that section, 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 claims 1, 6, 7, 10, 11, 15, and 20 of the ’862 Patent and cancellation of the challenged claims 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 ’862 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 ’862 Patent is being asserted in these proceedings along with two other patents within the same patent family as the ’862 Patent—namely, U.S. Patent Nos. 11,443,395 (Ex. 1004) *and* 11,494,861 (Ex. 1005). Petitioner is filing concurrent petitions challenging the ’395 (IPR2024-00102) and ’861 (IPR2024-00103) Patents.

C. Grounds for Standing

Petitioners certify under Rule 42.104(a) that the '862 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 '862 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.

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 '862 Patent.

D. Lead and Back-up Counsel and Service

Lead Counsel	Back-up Counsel
Mark C Nelson, Lead Counsel Reg. No. 43,830 Barnes & Thornburg LLP 2121 N. Pearl St. Suite 700 Dallas, TX 75201 Telephone: (214) 258-4140	Daniel A. Valenzuela, Back-up Counsel Reg. No. 69,027 Barnes & Thornburg LLP 2121 N. Pearl St. Suite 700 Dallas, TX 75201 Telephone: (214) 258-4150

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.

Facsimile: (214) 258-4199 Email: mnelson@btlaw.com	Facsimile: (214) 258-4199 daniel.valenzuela@btlaw.com
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Please address all correspondence and service to the address of counsel listed above. Petitioners also consent to electronic service by email at Patent-doctinglitin@btlaw.com (referencing Attorney Docket No. 90322-396894 and cc'ing mnelson@btlaw.com and daniel.valenzuela@btlaw.com). The U.S. 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 Claims
1	§ 103	Pylant	1, 6, 7, 10, 11, 15, 20

Pylant was not relied on or cited by the Examiner during prosecution of the '862 Patent. The declaration of technical expert Michael Ian Shamos, Ph.D., J.D. (Ex. 1002) further supports the proposed ground of unpatentability.

V. STATE OF THE ART RELATIVE TO THE '862 PATENT

The Challenged Claims recite “a mobile lawyer system.” '862 Patent (Ex. 1001), 6:50-51. The Challenged Claims are directed to the “concept” of using technology to introduce a third party (*e.g.*, a licensed attorney) into an event. (*See* Challenged Claims). The Challenged Claims are drawn to a system and method of

use of a mobile application on a mobile device (*e.g.*, a standard cell phone), that can be installed to facilitate video communications with an attorney based on location through a standard remote server. Such systems were in public use prior to the earliest effective filing date. The '862 patent also does not propose or require any hardware modifications to the cellphone or server. All of the functions recited in the Challenged Claims are accomplished through conventional software. Ex. 1002, ¶67.

The Challenged Claims recite conventional, well-understood 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). 6:50-10:30. As discussed below (*see* V(D) in particular), the elements of the Challenged Claims were well known and in public use before the July 19, 2016, the earliest possible effective filing date of the '862 Patent. Ex. 1002, ¶¶59-65, 137.

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 '862 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. Ex. 1002, ¶68.

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.*

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, ¶73. 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, ¶74. 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, ¶75. 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, ¶74. It was not inventive in 2016 to use a cell phone for video calls. *Id.* at ¶76.

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, ¶70. 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, ¶71. Thus, by the beginning of 2016, geolocation by cellphones/mobile devices was conventional. Ex. 1010; Ex. 1002, ¶72.

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, ¶77. Likewise, for there to be a legal representation engagement, the lawyer

must accept the client's request. Ex. 1002 ¶80. The lawyer's acceptance can take many forms (*e.g.*, oral, electronic, paper, etc.). *Id.*

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 ¶78. Similarly, in the case of electronic acceptance of legal representation, a POSITA would have understood that such communication could be received from a computing device associated with the lawyer. *Id.* at ¶80. 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 ¶79. Many prior art references disclose systems that permit a person in legal jeopardy to record police encounters and obtain representation in real time. *See generally* 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 ¶81. 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 ¶82.

D. Summary of Prior Art and the Information a POSITA Would Have Understood Prior to the Critical Date of the '862 Patent.

The Declaration of Mr. Shamos identifies and describes numerous prior art references, including public uses, from 2001 through 2015. *See generally* Ex. 1002, at ¶¶ 83-124, and cited exhibits. Because a POSITA would have been known about this prior art, the art's teaching is part of the knowledge of a POSITA. Due to word limitations, Petitioner does not recite all of the details of these prior art references, but instead describes their teaching at a high level with citations to the art itself, and to paragraphs of the Shamos Declaration containing further description of the art. The details regarding the filing dates, public use dates, and/or other description dates are recited in the Shamos Declaration and, of course, on the documents themselves.

Together, there prior art references taught many (if not all) of the elements of the Challenged Claims:

- Hillstrom (Ex. 1015) – 2001, for example, taught a database for matching lawyers and clients based on geographic location [0034] that could be accessed via a mobile device [0030]. Hillstrom also taught exchanging forms to create a legal engagement. [0041]. A POSITA would have understood that Hillstrom's system could be used for a

police encounter because such encounters occurred and were being recorded before 2016 (*e.g.*, a bystander used a camera to record a video of the beating of Rodney King in 1991). *See also* Ex. 1002, ¶¶83-84.

- Henry (Ex. 1016) – 2010, for example, taught two-way, real-time audio and video communication between a driver and a lawyer during an incident, including traffic stops. Abstract, [0019], [0021], [0027], Figs. 1 and 5. Henry also taught that a user could initiate contact with a lawyer via one-click, by pressing a button (YES, 1a) or other indicator (Fig. 1, [0020]), and that the time, date, and location are logged and transmitted, and that the legal representative is connected immediately (*e.g.*, live in real-time) to assess the situation and advise the client how to move forward. [0021]; *see also* Ex. 1002, ¶¶85-92.
- Wrench (Ex. 1017) – 2010, for example, also disclosed a system able to match a user with an attorney for video communication, including using a mobile device. 1:39-41; 4:28-31. Wrench also teaches “Profile Templates” containing information about attorneys’ credentials to help match users with attorneys and connecting the user with the attorney having the matching experience. 4:28-31; 15:6-9; *see also* Ex. 1002, ¶¶93-95.
- Trabucco (Ex. 1018) – 2011, for example, taught a system/method for

an attorney to communicate remotely and privately (via videoconference) with an incarcerated person using a server to establish a secure link. [0007-0010]. The system/method included (a) establishing a server linking the conference terminal and a computer over a communication network, (b) verifying the lawyers identity, (c) verifying that the inmate is a client, (d) assigning an identity code to the lawyer to sign into the server, (e) establishing person(s) responsible to bring the inmate to the conference terminal, (f) attorney signing in, (g) server establishing an encrypted link, and (h) the attorney and inmate conduction a bi-directional conference. [0010-0018]; *see also* Ex. 1002, ¶¶96-98.

- Moore (Ex. 1019) – 2014, for example, taught a system for obtaining help at a road incident and making a video recording of the incident, including an in-car device with a camera that sent images to the station for an operator to view, assess the situation, and communicate by video with the driver/passenger of the vehicle, and dispatch assistance. Abstract. Moore also taught storing the images/video at a remote server and transmitting the location of the vehicle via GPS to a server. [0021]; *see also* Ex. 1002, ¶¶99-101.
- Quicklegal, Inc. (Ex. 1020) – 2014), for example, was an app that

enabled a user to contact an attorney for legal assistance based on location and/or legal specialty. *See also* Ex. 1002, ¶¶102-103.

- Five-O App (Ex. 1021) – 2014, for example, was an app to help document police brutality, which empowered citizens to “record and store data” from encounters with law enforcement. Ex. 1021; *see also* Ex. 1002, ¶104.
- Mobile Justice App (Ex. 1022) – 2012/2014, for example, was an app developed by the ACLU that permitted citizens to capture exchanges between themselves and the police and send the video to the ACLU. *See* Ex. 1002, ¶¶105-106.
- Hands Up 4 Justice App (Exs. 1023, 1024) – 2015, for example, was an app designed to permit users to record interactions with police during traffic stops. The app integrated emergency contact and GPS, and uploaded the records to YouTube or a Dropbox account (*i.e.*, cloud storage). *See* Ex. 1002, ¶¶107-108.
- The Oh Crap! App (Ex. 1025) – 2015, for example, was used on a mobile device and, among other things, determined the user’s location and, if clicked, would communicate with a participating attorney in the user’s jurisdiction (*i.e.*, state). The app also recorded the law enforcement encounter and was marketed for use with DUI/DWI encounters. *See* Ex.

1002, ¶¶109-110.

- The Alibi App (Ex. 1026) – 2015, for example, had default settings that recorded audio, images, and geolocation. Dropbox integration permitting users to save files into their directory and have the data stored on Dropbox’s servers for backup was also contemplated. *See* Ex. 1002, ¶111.
- Guzik (Ex. 1027) – 2015, for example, taught a system installed in a law enforcement vehicle to obtain information regarding an incident from a witness. The system had a camera, speakers, communication interfaces, a display, and cloud storage for video data. [0015]. The communication interfaces could enable the witness/person to communicate with third-parties (*e.g.*, an attorney) via telephony, email, or messaging. [0041]. Guzik taught an interface with an interactive menu that contained a list of pre-screened attorneys and their contact information, and permitted an audio communication with one-click on the menu. Fig. 3; [0054]; *see also* Ex. 1002, ¶¶112-115.
- The “One Touch Law” App (Ex. 1028) – 2015, for example was a mobile app demonstrating that a lawyer could be located by specialty and that a video/audio consultation could be established. *See* Ex. 1002, ¶¶116-117.

- The “LegalSwipe App (Ex. 1029) – 2015, for example, was a smartphone app permitting users to video encounters with police and send recordings of same to a remote server, as well as sending geo-tagged email messages. *See* Ex. 1002, ¶118.
- The “Legal Equalizer” App (Exs. 1030, 1023) – 2015, for example, was a mobile app designed for use in traffic stops that permitted the user to record the encounter with the press of a button, and the recording would be automatically sent to a server for storage. *See* Ex. 1002, ¶¶119-120.
- Gabel (Ex. 1031) – Feb. 2016, for example, taught methods/systems for managing accident communications over a network and noted that accidents often generated police presence. [0004]. The system/method included a mobile device with a camera, obtaining GPS location information [0006], encrypted communications [0037], an attorney referral process [0039], calling the attorney [0041], and video recording [0052]. *See also* Ex. 1002, ¶¶121-122.
- The “1Law” App (Ex. 1032) – March 2016, for example, was described as an “on-demand service space, like Uber for lawyers ... [t]ouch the app and communicate with an attorney in real time, live.” Ex. 1032. The app shows a map of the user’s location, and 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. *Id.* Clicking on the icon reveals the lawyer's profile and tapping the call button initiates contact. *Id.* The lawyer can accept or deny the call, but if accepted the user and lawyer are connected in a video call. *Id.*; *see also* Ex. 1002, ¶¶123-124.

- McGill Report (Ex. 1037) – Oct. 2016. This report provides details on **189 apps** that were available to users to document incidents or obtain legal assistance, many of which related to assistance with traffic stops. Ex. 1037; *see also* Ex. 1002, ¶¶136.

The preceding review of prior art makes clear that the concepts of using mobile devices with cameras, display screens, and downloadable apps to engage in bi-directional video and/or audio communications with lawyers during traffic stops and other law enforcement encounters was well known prior to the July 19, 2016—the earliest possible filing date for the '862 patent. The preceding art also taught geolocation of the mobile device (and thus determining the user's/vehicle's location), using servers to automatically communicate with the mobile device and/or the devices of the lawyers, and storing the video and/or audio communications on a server, for example, in the cloud. *Id.* 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, ¶137.

VI. OVERVIEW OF THE '862 PATENT

The '862 Patent was filed on October 22, 2021, and issued on November 8, 2022. The '862 Patent is a continuation of the '861 Patent (Ex. 1005) which is a CIP of the '395 Patent" (Ex. 1004), which claims priority to U.S. Provisional Patent Application No. 62/364,300 ("300 provisional") filed on July 19, 2016. '300 Provisional – Ex. 1007. The '862 Patent's Challenged Claims are directed at an on-demand lawyer application that automatically 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 by a single button press, the app executes causing the application to automatically search for suitable lawyers based on the current location of the user. Ex. 1001, claim 1. As discussed previously, 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. Ex. 1001, claim 1; Ex. 1002 ¶¶59-65.

A. PROSECUTION HISTORY

1. The prosecution history of the '862 Patent is at Ex. 1006. During the prosecution of the '862 Patent, Applicant submitted a preliminary amendment

adding claims 15-20. The Applicant later filed a terminal disclaimer. Ex. 1006 at 52. The examiner issued a Notice of Allowance on September 23, 2022 along with an Examiner' Amendment for claims 6 and 15. Ex. 1006 at 59-68. Ex. 1002, ¶¶31-32.

B. THE '862 PATENT IS NOT ENTITLED TO THE '300 PROVISIONAL PRIORITY DATE

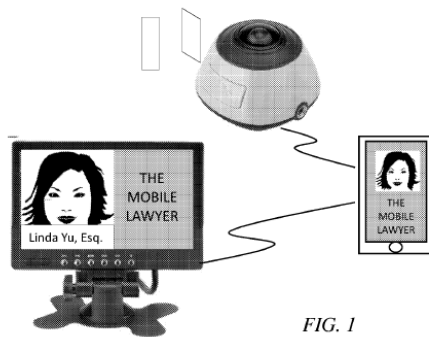
The '862 Patent is not entitled to the provisional the '300 filing date of July 19, 2016, because the provisional application lacks support for many of the Challenged Claims. To establish entitlement to the earlier filing date of a provisional application, a party must prove that the provisional application 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 '862 Patent has 20 claims, 3 independent claims and 17 dependent claims. A finding of lack of support for the independent claims affects the dependent claims, rendering all claims stemming from the independent ineligible for the '300 provisional priority date.² For instance, the '300 provisional lacks support for the

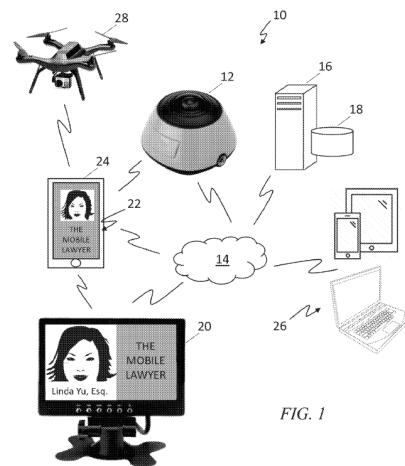
² 35 U.S.C. § 112(d) sets out the requirements for when a claim is dependent upon another. The statute provides that a claim is dependent upon another if the claim: (1) refers to “a claim previously set forth” and (2) “specif[ies] a further limitation of the subject matter claimed.” 35 U.S.C. § 112(d); *see also Monsanto Co. v.*

limitation “receive and acceptance of legal representation engagement from the computing device associated with the at least one lawyer” in claim 1. When comparing Figs. 1 of the provisional and the ’862 Patent, Patent Owner added additional elements not disclosed in the provisional. Ex. 1002, ¶¶37-38.

Provisional



’862 Fig. 1



The ’300 Provisional also lacks support for the claim 1 limitation “automatically search a plurality of information records associated with a plurality of lawyers stored in the remote database.” This limitation is not disclosed in the provisional, which furthermore does not even mention a “database.” Ex. 1002, ¶39.

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

In addition to lacking support for claim 1, the '300 provisional application lacks support for claims 7 and 15 of the '862 Patent. Claims 7 and 15 recites a “video camera mounted on a drone” and other cameras in the Markush group that are not disclosed by the '300 Provisional. Ex. 1002, ¶40.

The claim 6 limitation, “automatically searching, at the remote server, a plurality of information records associated with a plurality of lawyers stored in the remote database” also finds no support in the '300 Provisional, which does not disclose any database at all, let alone a remote one having records about lawyers. Further, the claim 6 element of “encrypted storage” is not taught in the '300 Provisional, which does not contain any mention or suggestion of encryption. Ex. 1002, ¶41. Therefore, dependent claims 7, 10, and 11 also lack provisional support. *Id.*

Claim 15 limitations “remote database,” and “remote server” are not supported in the '300 Provisional, which does not mention any “server” or “database.” Further, there is also no support for the claim 15 limitation, “the remote server being configured to: automatically search a plurality of information records associated with a plurality of attorneys stored in the remote database.” Ex. 1002, ¶42. As claim 20 depends from claim 15, there is also no support in the provisional for claim 20. *Id.*

For at least these reasons, no Challenged Claim is entitled to a priority date of July 19, 2016. Hence, the priority date for the Challenged Claims is no earlier than July 7, 2017, and all matter in the '862 Patent that stems from new matter in the '861 Patent cannot have a filing date earlier than the date filing date of the '861 nonprovisional application, i.e., August 28, 2017. Ex. 1002, ¶43. See detailed table at Ex. 1042.

Regardless, however, the provisional of the Pylant reference (Ex. 1033) was filed on May 12, 2016 and predates the '862 Patent even if it is accorded a July 19, 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, the terms/phrases used in the '862 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 set forth its understanding of the plain and ordinary meaning of the following terms: “jurisdiction,” “automatically,” and “immediately.” Ex. 1002, ¶¶52-57.

“jurisdiction”. The specification equates “jurisdiction” with current location of the user. Block 38 of Figure 2 reads, “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. *Id.* at 3:53-54. Elsewhere, the specification also equates jurisdiction with the location of the user. 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.* 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, ¶55.

“automatically”. The specification does not use the term “automatically” at all – the term appears only in the claims. Claim 1 recites that the remote server is configured to “automatically search a plurality of information records associated with a plurality of lawyers store in the remote database,” “automatically identify at least one lawyer licensed in a jurisdiction the correspond [sic] to the current location of the mobile device,” “automatically transmit at least one notification to at least one computing device associated with the identified at least one lawyer,” “automatically and immediately set up a video communication session between the computing device associated with the at least one lawyer and the mobile device ... and live

video data of the at least one lawyer is automatically transmitted to the display screen. 6:50-7:15. 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, ¶56.

“immediately”. The claims and the specification use the term “immediately” to signify a temporal relationship. *see also* Ex. 1002, ¶____. 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. 3:58-61; *see also* 4:34-35 (“The captured video data is ‘immediately’ transmitted to the lawyers associated computing device.”); 4:47-50 (user “immediately clicks on Mobile Lawyer App icon”); 4:62-64 (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.” Ex. 1002, ¶57. This is because 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).

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 accepts this definition of a POSITA. Ex. 1002, ¶¶44, 50. As evidenced by his CV (Ex. 1003), Dr. Shamos is at least one of ordinary skill in the art, *i.e.*, a POSITA. Ex. 1002, ¶51.

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 an event 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 Claims 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 '862 Patent. Pylant is analogous prior art in the same field of the invention. Ex. 1002, ¶¶125, 138-139.

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 (2:39-40)] having an expertise associated with the determined specific and currently occurring real-world situation of the user." 1:41-46; Abstract 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. 7:11-33. Pylant teaches that a user initiates a request for a consultant/expert via, for example, an app on a mobile device (15:6-20) with a display (display 254, 13:2, 30-35)), and a remote server and database. *See, e.g.*, device 101-104 or device 200 from FIGS. 1-2; 15:19-23. Ex. 1002, ¶¶140-141.

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 limitations. Ex. 1002, ¶¶140-141.

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

Petitioner asserts that, if the effective filing date of the '862 Patent is found to be October 22, 2021 or August 28, 2017 or 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 '862 Patent. Note, even if the filing date of the '862 Patent is July 19, 2016 – the filing date of the '300 Provisional – Pylant is still prior art. Ex. 1002, ¶¶138-139, *see also* 125-127.

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 '862 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 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

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,

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, Ex. 1002, ¶¶128-130. 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, ¶130.

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, ¶131-135.

B. GROUND 1: Pylant, combined with the knowledge of a POSITA, renders each of the challenged claims obvious

1. Claim 1 is rendered obvious in view of Pylant.

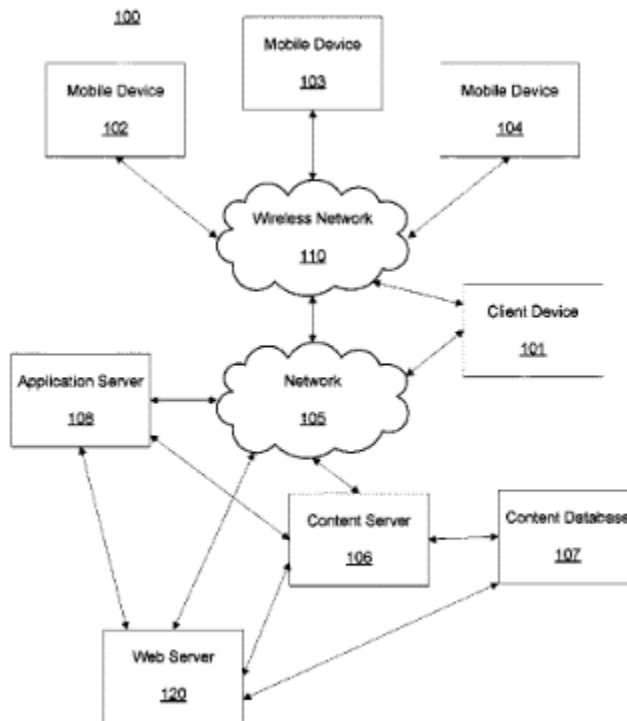
Pylant alone and/or in combination with a POSITA’s knowledge render claim 1 obvious.

1 [Pre] – A mobile lawyer system, the system comprising:

Pylant discloses this limitation. Ex. 1002, ¶¶143-145. Pylant provides “[t]he 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. Abstract; 1:41-51. Pylant explicitly disclose that an *attorney* is one of the experts (2:38-39; 8:1-5), and that the attorney can be consulted during a traffic stop. 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.”); 7:14-24 (further disclosing traffic stop embodiment). Pylant also discloses a second attorney example with Jim needing an attorney at the scene of an accident. 7:34-63.

1[a] a remote server and a remote database;

Pylant discloses this limitation. Ex. 1002, ¶¶146-150. Pylant discloses “servers” that can be “single processors with associated communications and data storage and database facilities,” or “networked or clustered complex[es] of processors and associated network and storage devices.” 4:57-5:9. 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).



1[b] at least one video camera;

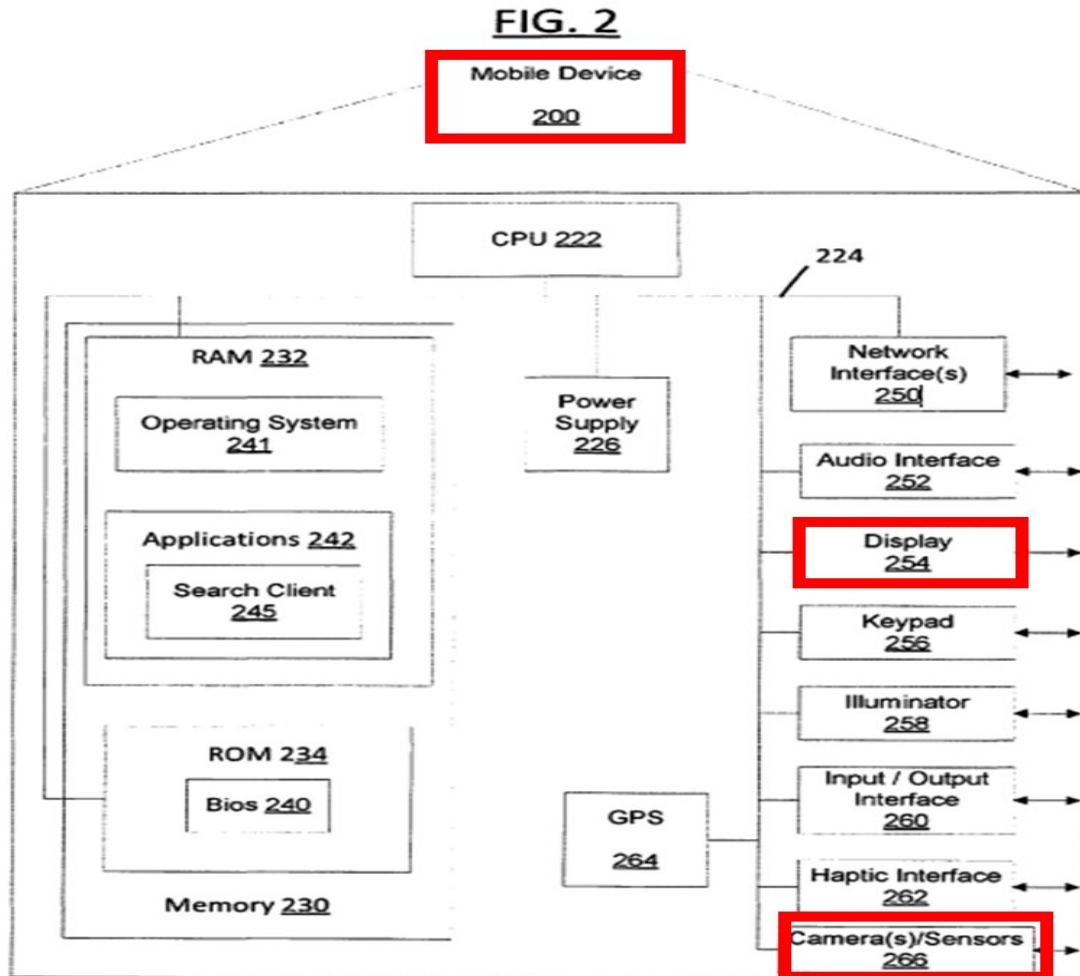
Pylant discloses this limitation. Ex. 1002, ¶¶151-153. Figure 2 of Pylant discloses the interior of mobile device 200, that includes “Camera(s)/Sensors 266.” *See also* 13:6-11. Pylant also teaches that these cameras can be video cameras. *See, e.g.,* Fig. 4 (step 402 “Video Consultative Request Initiated”); 16:55-59; 1:52-55 (“[T]he disclosed systems and methods provide a computerized, fully automated network environment that enables video conferencing between two geographically remote users.”).

1[c] at least one display screen;

Pylant teaches this limitation. Ex. 1002, ¶¶154-158. Figure 2 (below), for

example, discloses the specifics of the mobile device, including “Display 254.”

See also 13:30-35 (disclosing variety of display screens).



A POSITA would have known that a display on a mobile phone or device was capable of streaming video between two parties. Ex. 1002, ¶157.

1[d] a mobile device executing a mobile application in communication with the at least one video camera and the at least one display screen,

Pylant discloses this limitation. Ex. 1002, ¶¶159-164. As discussed above in connection with Figure 2, Pylant discloses mobile devices with video cameras and

display screens. Pylant also discloses that the mobile device can execute a mobile application in communication with the video camera and display screen. For example, referring to Figure 3, consulting request engine 300 can be embodied as a “stand-alone application that executes on a user device,” including a “downloadable application installed on the user's device.” Fig. 3; 15:6-18 (also noting that consulting request engine 300 can be installed as “a video chat application (*e.g.*, FaceTime®, Skype®, and the like) that enables two users to communicate in real-time via video conferencing”). 15:6-18; Ex. 1002, ¶163. Pylant discloses a real-world example executing the application on a cell phone with video camera and display. *See* 7:11-33 (describe user (Jeff) being pulled over by a police officer for suspected DUI). Also, it was well known to a POSITA that app stores existed where cellphone owners could download apps, and that such apps could be used in the context of police (or other) encounters. Ex. 1002, ¶162.

1[e] and configured, upon a one-click command from a user of the mobile device, to automatically and immediately communicate a current location of the mobile device to the remote server,

Pylant discloses this limitation. Ex. 1002, ¶¶165-167. Pylant discloses a mobile device as described above. Figure 2 of Pylant also teaches that the mobile device (200) is equipped with “GPS 264,” which can “determine the physical

coordinate of Client device 200⁴ ... output[ing] a location as latitude and longitude values.” Fig. 2; 13:61-14:6 (also disclosing other means of determining the location of the mobile device). Pylant teaches that its systems/methods “provide a computerized, fully automated network environment that enable video conferencing between users” (1:51-55), and that a user can initiate a request via a mobile device, resulting in the specifics of the user’s situation, including the time, date, and *location* of the user being provided to the consultant. 2:14-22; 17:1-10. Pylant also teaches that its systems/methods operate “automatically, in real-time” (1:41-45) thus indicating that upon the user’s command the mobile device communicates the location information to the remote server (*see e.g.* Fig. 4, step 401 where user initiates the consulting request engine 300, which “can be hosted by an application server, content server,” as well as other types of servers (14:64-15:5)) automatically (without human intervention) and immediately (without significant delay), which is how electronic systems such as Pylant typically function. Pylant also teaches that “Display 254” of mobile device 200 “may include a touch sensitive screen arranged to receive input from an object such as a stylus or digit from a human hand.” 13:32-35. In addition, Pylant teaches that the request for a consultant/attorney can be include within a “single request” (*i.e.*, one click) on the aforementioned touch

⁴ Pylant uses “Client device 200” to refer to Figure 2’s “Mobile Device 200.” *See generally* Columns 13-14.

sensitive screen. 7:43-46. A POSITA also would have understood that application requests can be initiated with “one-click.” Ex. 1002, at ¶166.

1[f] the remote server being configured to:

The system includes a remote server at Figure 1. *See* claim 1[a]. It was well known that a server functions automatically without input from a user or other human intervention. Ex. 1002, ¶¶168-171. Pylant discloses that a remote server and database are included in its definition of server. “For the purpose of this disclosure the term ‘server’ should be understood to refer to a service point which provides processing, database, and communication facilities. By way of example, and not limitation, the term ‘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. Servers may vary widely in configuration or capabilities, but generally a server may include one or more central processing units and memory. A server may also include one or more mass storage devices, one or more power supplies, one or more wired or wireless network interfaces, one or more input/output interfaces, or one or more operating systems, such as Windows Server, Mac OS X, Unix, Linux, FreeBSD, or the like.” 4:58-5:8; Ex. 1002, ¶169.

Pylant discloses that the content servers and databases store the relevant data for the services (plurality of lawyers, doctors, etc.) “It should also be understood that content 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, as discussed in more detail below. Embodiments exist where the network IOS is also coupled with/ connected to a Trusted Search Server (TSS) which can be utilized to render content in accordance with the embodiments discussed herein.” 12:37-45; *See* Fig. 1; Ex. 1002, ¶170.

i. automatically search a plurality of information records associated with a plurality of lawyers stored in the remote database;

Pylant discloses this limitation. Ex. 1002, ¶¶172-173. In Figure 4, Pylant describes a user initiating (step 401) a request for video consultation, which triggers a search to identify a consultant (step 403). As described previously, the request may be created based on the user’s circumstances, including the need for a lawyer. 17:34-47. In such a case (and in other cases), Pylant teaches that the request triggers the search for information stored in a database(s) (*e.g.*, database 320 of Figure 3), to identify the consultant, which, as discussed above, Pylant *expressly teaches* could be a lawyer. 17:34-37; 16:14-21 (teaching that stored consultant data includes “location, certifications, capabilities, skills, and the like”). Pylant teaches this database can be remote from, for example, the mobile device, from the server, or

both. *See, e.g.*, Figs. 1, 3-5; 14:65-15:5. Also, as described previously the server (*e.g.*, consulting request engine 300) would perform this task “automatically” (without human intervention), which is also taught in Figure 4’s flow chart, and which a POSITA would have understood based on the typically operation of server-database communications. Ex. 1002, ¶173.

ii. automatically identify at least one lawyer licensed in a jurisdiction that correspond [sic] to the current location of the mobile device;

Pylant discloses this limitation. Ex. 1002, ¶¶174-175. As discussed above in connection with element 1[e], Pylant teaches communication of the mobile device’s (*i.e.*, user’s) location to the remote server. *See also* 17:1-10. Pylant also teaches that the remote server uses the user’s location to query the database to identify the correct consultant (*e.g.*, lawyer in some embodiments) for user’s situation based on the data stored about the consultant, *i.e.*, the consultants’ “location, certifications, capabilities, skills, and the like.” 16:14-21. A POSITA would understand that “certifications” with respect to lawyers would include the state (*i.e.*, jurisdiction) where the lawyer was licensed. Ex. 1002, ¶175. Pylant teaches that steps 403-405 of Figure 4 are performed by the consultant module 306 of consulting request engine 300, which as describe above, is a remote server. Figs. 3-4; 16:60-68. Also, as discussed above, Pylant taught that the remote server performed its tasks “automatically,” which is typical of electronic systems.

iii. automatically transmit at least one notification to at least one computing device associated with the identified at least one lawyer;

Pylant discloses this limitation. Ex. 1002, ¶¶176-177. “Once the expert user is identified, the expert user [which Pylant teaches can be a lawyer as described above] and the user A are *automatically* put in contact with one-another via a created/established network connection that includes a video conferencing session.” 2:27-29. Referring to Figure 4, Pylant teaches that the consultant is notified in step 404, and that such notification can be “any type of message or notification, including, but not limited to, an IM, SMS, MIMS, email, phone call, and the like.” Fig. 4; 18:13-18. Step 404 is performed by the consultant module 304 of consulting request engine 300, which, as discussed above, is a server. Figs. 3, 4; 16:60-68. Because electronic notifications would necessarily be sent to the consultant’s/lawyer’s device, Pylant also teaches this aspect of the limitation.

iv. receive an acceptance of engagement from a selected one of the at least one computing device associated with a selected one of the identified at least one lawyer;

Pylant discloses this limitation. Ex. 1002, ¶¶178-179. Referring again to Figure 4, Pylant teaches that if the consultant accepts in step 405, a video conference is initiated (step 406). Fig. 4; 18:18-20. Pylant further teaches, as discussed above, that the remote server communicates with the consultant’s computing device via (*e.g.* IM, SMS, MIMS, email), and thus Pylant teaches that the acceptance of

engagement can be received at the remote server from the consultant's computing device. Pylant, in fact, provides the specific example of engaging an attorney in this manner such that acceptance of the engagement occurs by the attorney responding to the user's notification in the affirmative. 7:54-63 ("After identifying the proper attorney, the attorney is sent a request for his/her availability, and should the attorney respond in the affirmative, Jim and the attorney are connected via a video conferencing session ... enable[ing] the attorney to provide legal advice to Jim on-the-spot, at the accident site."); *see also* Ex. 1002, ¶49.

v. and automatically and immediately set up a bi-directional video communication session between the selected one of the at least one computing device associated with the selected one of the at least one lawyer and the mobile device,

Pylant discloses this limitation. Ex. 1002, ¶180. As discussed above, Pylant teaches that upon the attorney responding to the user's (Jim's) request, Jim and the attorney are connected via a video conference session. 7:54-63; 2:27-30 ("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."). *See also* Fig. 4; 16:55-59. Pylant thus teaches that the bi-directional video (*see, e.g.*, 1:29-37, 52-55) is "automatically" (without human intervention and "immediately" (without significant delay) established between the selected consultant's/lawyer's computing device and the mobile device, using

various modules of the consulting request engine (remote server). Figs. 3, 4; 16:60-68.

- vi. so that live video data of the user is automatically transmitted to the selected computing device associated with the selected lawyer and live video data of the selected lawyer is automatically transmitted to the at least one display screen;**

Pylant discloses this limitation. Ex. 1002, ¶¶181-182. This limitation is a consequence of limitation 1[f][v]. As discussed above, Pylant's systems/methods provide "a computerized, fully automated network environment that enables video conferencing between two geographic remote users." 1:52-55; 7:60-62 ("Jim and the attorney are connected via a video conferencing session ... enable[ing] the attorney to provide legal advice to Jim on-th-spot, at the accident site."). The system would be equally applicable to the Jeff-DUI situation. 7:14-28.

- 1[g] automatically and immediately enable the at least one display screen to stream live video data of the selected lawyer, and the at least one video camera capture and stream live video of the user and surroundings to the computing device for viewing by the selected lawyer; and**

Pylant discloses this limitation. Ex. 1002, ¶¶183-185. Just as Pylant taught that video of the user is automatically transmitted to the computing device of the selected lawyer and live video data of the selected lawyer is automatically transmitted to the at least one display screen (claim 1[f][vi]), Pylant taught that the display screen of the user's mobile device would "automatically" (without human

intervention) and “immediately” (without significant delay”) be enabled to make the bi-directional video possible. 2:27-30; *see also* discussion of “display screen,” element 1[c], which is incorporated herein by reference. Pylant teaches “automatically” and “immediately” because it the bi-directional video occurs in real-time. *See, e.g.*, 1:63-67; Figs. 3, 4 showing the flow chart of activities and indicating that such activities are facilitated via electronic systems). *See also* discussion of “mobile app” in connection with element 1[d], which is incorporated by reference.

Pylant also discloses a computerized, fully automated network environment enabling video conferencing between a user and a consultant/lawyer. 1:19-36, 1:51-2:3; 7:60-63. As discussed above, Pylant discloses a number of embodiments, including embodiment(s) in which Jim (or Jeff) and his lawyer are in a video conference session via their respective devices while Jim is at an accident site, or Jeff is being pulled over for suspected DUI. Pylant thus teaches that the capture and streaming of video of the user and accompanying surroundings are transmitted to the selected lawyer’s device for viewing. A POSITA would have understood that the video camera of a mobile device (*e.g.*, the video camera of a smart phone) would capture, not only the user, but also the user’s surroundings. Ex. 1002, ¶185.

1[h] and automatically and immediately enable live video data from the mobile device and the selected computing device to be transmitted to the remote server and database for secure storage.

Pylant discloses this limitation. Ex. 1002, ¶¶186-187. Pylant teaches that the video session can be stored as it is occurring (*e.g.*, in real-time as a media streaming event). 1:65-67. Pylant, therefore, teaches that enabling live video from the mobile device and the selected computing device to be transmitted is done “automatically” (without human intervention”) and “immediately” (without significant delay). Pylant further teaches that storage can occur locally, or on a server. 1:67-2:3. As discussed above in connection with element 1[a] (*see also* 1[pre]), incorporated by reference, Pylant discloses “servers” that can be “single processors with associated communications and data storage and database facilities,” or “networked or clustered complex[es] of processors and associated network and storage devices.” 4:57-5:9. Pylant disclosed the specific elements to perform the video streaming and recording. *See* Fig. 2 (including display 254 and camera(s)/sensors 266), Fig. 3 (including **Recording Module** 308 & database 320), Fig. 4 (including 414 “Initiate Video recording,” and 411 “Save to Server via Network”). Pylant also taught encryption for “secure” storage. 8:8-18.

2. Claim 6 is rendered obvious in view of Pylant.

6 [Pre] A mobile lawyer method comprising:

Pylant discloses this limitation. *See* claim 1[pre]. Ex. 1002, ¶188.

6[a] receiving a live consultation request from a user's mobile device;

Pylant discloses this limitation. Ex. 1002, ¶¶189-190. As discussed above, Pylant discloses systems/methods whereby a user can be connected to a consultant (e.g., lawyer) via video conference in real-time. Figure 4, for example, discloses the user initiating a request (step 401). And, also as discussed above, Pylant teaches a specific embodiment in which users (Jeff and Jim) initiate requests to an attorney. 7:11-63. Pylant also teaches that such requests can come from the user's mobile device. Fig. 2.

6[b] automatically and immediately initiating capture of images of the user and surroundings; and live-streaming the captured images to a remote server for encrypted storage via a computer network in response to receiving the consultation request;

Pylant discloses this limitation. Ex. 1002, ¶¶191-192. *See* claim 1[h] and [i] Pylant further discloses that the recording of the video can involve “applying encryption to the video as it is occurring” (8:8-10), which would result in encrypted storage, including at the remote server. 1:65-2:3. That this action is ultimately in response to receiving the consultation request is shown, for example, the Figure 4 flow chart. Fig. 4 (steps 401-409, 411). A POSITA would have known at the time of the alleged invention that a video camera would capture the image of the user and surroundings because cameras typically capture whatever is visible to them, including the subject and surroundings. Ex. 1002, ¶192.

6[c] automatically and immediately determining a current location of the mobile device;

Pylant discloses this limitation. Ex. 1002, ¶193. *See* claim 1 and limitation 1[e].

6[d] automatically and immediately transmitting the current location of the mobile device to the remote server;

Pylant discloses this limitation. Ex. 1002, ¶194. *See* claim 1 and limitation 1[e].

6[e] automatically searching, at the remote server, a plurality of information records associated with a plurality of lawyers stored in the remote database;

Pylant discloses this limitation. Ex. 1002, ¶195. *See* claim 1 and limitations 1[a] and 1[f][i].

6[f] automatically identifying, at the remote server, at least one lawyer licensed in a jurisdiction that correspond to the current location of the mobile device;

Pylant discloses this limitation. Ex. 1002, ¶196. *See* claim 1 and limitations 1[a] and 1[f][ii].

6[g] automatically transmitting, by the remote server, at least one notification to at least one computing device associated with the identified at least one lawyer;

Pylant discloses this limitation. Ex. 1002, ¶197. *See* claim 1 and limitations 1[a] and 1[f][iii].

6[h] automatically receiving live-streaming video data of an identified remote lawyer licensed to practice law in a jurisdiction associated with the current location of the mobile device;

Pylant discloses this limitation. Ex. 1002, ¶¶198-199. *See* claim 1 and limitations 1[f][ii], [f][iv], and [f][v]. Also, as discussed above in connection with limitation 1[e], Pylant teaches communicating the mobile device's (*i.e.*, user's) location to the remote server. *See also* 17:1-10. Pylant also teaches that the remote server uses the user's location to query the database to identify the correct consultant (*e.g.*, lawyer in some embodiments) for the user's situation based on the data stored about the consultant, *i.e.*, the consultants' "location, certifications, capabilities, skills, and the like." 16:14-21. A POSITA would understand that "certifications" with respect to lawyers would include the state (*i.e.*, jurisdiction) in which the lawyer was licensed. Ex. 1002, ¶199. Pylant teaches that steps 403-405 of Figure 4 are performed by the consultant module 306 of consulting request engine 300, which as describe above, is a remote server. Figs. 3-4; 16:60-68. Pylant also teaches specific embodiments relating to user-attorney communications in which the user (Jim) and the attorney are connected via video conference in real-time. 7:60-63. Such real-time connection is bi-directional meaning that user receives live-streaming video of the identified lawyer on the user's mobile device. 1:62-68; Fig. 4. Also, as discussed above, Pylant taught that such activity occurs "automatically," which is typical of electronic systems.

6[i] automatically live-streaming captured video images of the user to the at least one remote lawyer via the remote server;

Pylant discloses this limitation. Ex. 1002, ¶¶200-201. *See* claim 1 and 1[h].

6[j] automatically displaying the live-streaming video data of the identified at least one remote lawyer on a display monitor viewable by the user; and

Pylant discloses this limitation. Ex. 1002, ¶¶202-203. As discussed above, Pylant discloses a computerized, fully automated network environment enabling video conferencing between a user and a consultant/lawyer. 1:19-36, 1:51-2:3; 7:60-63. As discussed above, Pylant discloses a number of embodiments, including an embodiment in which Jim and his lawyer communicate with one another in a video conference session via their respective devices while Jim is at an accident site. 7:34-63. Pylant thus teaches displaying the live-streaming video data of the at least one remote lawyer on the display monitor (*see* Fig. 2 Display 254) of the user's mobile device for view by the user. *See also* Figs. 2, 3 and 4. Display 254 may be LCD, gas plasma, LED, or any type of display used with a computing device. 13:30-35.

6[k] automatically storing the captured video data of the user and the at least one remote lawyer in a data storage device accessible by the remote server.

Pylant discloses this limitation. Ex. 1002, ¶¶204-205. *See* claim 1 and 1[i].

Pylant further teaches that the recording of a conference session can be in a remote

server (e.g., on a network – Step 411 of Figure 4), or saved to a device folder (of the user and/or expert's device – Step 409). Pylant teaches that a determination is made whether the remote server is available or accessible (Step 407), if so, then recording is saved to the server on a network (Step 411), if not (Step 408), then the recording is saved to the device folder of a user(s) device, and, can be later uploaded to the server. 18:26-36.

3. Claim 7 is rendered obvious in view of Pylant.

Claim 7 reads:

7 . The mobile lawyer method of claim [6] wherein initiating capture of images of the user and surroundings comprises initiating a capture of video images by at least one video camera selected from the group consisting of: at least one video camera mounted on a drone, at least one camera native to the mobile device, front and back-facing cameras native to the mobile device, at least one camera integrated and mounted on a vehicle, at least one camera mounted at various points of a vehicle, at least one camera with infrared capabilities, and at least one 360- degree video camera.

Pylant discloses this dependent claim. Ex. 1002, ¶¶206-208. This claim is directed to the type of camera that is used to initiate the capture of video image of the user and his/her surroundings. Pylant discloses that mobile device 200 (Figure 2) 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.” Figs. 2, 4; 13:6-11. Figure 2 discloses that the camera is native to the mobile device.

4. Claim 10 is rendered obvious in view of Pylant.

Claim 10 reads:

10. The mobile lawyer method of claim 6, wherein automatically determining a location of the user comprises accessing a GPS location of the user and determining a street address location from the GPS location.

Pylant discloses this dependent claim. Ex. 1002, ¶¶209-210. *See* claim 1 and 1[e] disclosing accessing a GPS location of the user. Pylant teaches the determination module 302 can detect via the GPS 264 unit on the user’s device that the user is at a specific location. 17:19-21. GPS transceiver 264 can also employ other geo-positioning mechanisms, including, but not limited to, triangulation, assisted GPS (AGPS), E-OTD, CI, SAI, ETA, BSS or the like, to further determine the physical location of Client device 200.” 13:60-14:6; Figs. 2, 4. A POSITA would have understood that a mobile device (*e.g.*, a smart phone) could determine the street address of the user based on the latitude/longitude provided by the GPS, a functionality that was standard on smart phones prior to July 19, 2016, as demonstrated by, for example, Apple Maps and Google Maps. Ex. 1002, ¶210.

5. Claim 11 is rendered obvious in view of Pylant.

Claim 11 reads:

11. The mobile lawyer method of claim 10 further comprising automatically searching, by the remote server, a database storing data associated with a plurality of lawyers, and automatically identifying at least one remote lawyer licensed in a jurisdiction that matches the current location of the user.

Pylant discloses this dependent claim. Ex. 1002, ¶¶211-212. *See* claim 1 and 1[f][i] and [f][ii], which are incorporated by reference. Referring to Figure 4, Pylant discloses automatically searching for a consultant/lawyer (step 402), and automatically identifying the consultant/lawyer (step 403). Pylant's system/method obtained information associated with the user, including location, to determine attributes of the situation, and utilized that information to identify the consultant/lawyer having sufficient capabilities, including "credentials," which a POSITA would understand meant licensed in a particular jurisdiction (*e.g.*, state). 2:14-29; Ex. 1002, ¶212.

6. Claim 15 is rendered obvious in view of Pylant.

Claim 15 recites every limitation of claims 1 and 7 combined. Pylant taught all elements of this claim. Ex. 1002, ¶213.

15 [Pre] A mobile lawyer system comprising:

See claim 1 and 1[pre]; Ex. 1002, ¶214.

15[a] a remote server and a remote database;

See claim 1 and 1[a]; Ex. 1002, ¶215.

15[b] at least one video camera selected from the group consisting of: at least one video camera mounted on a drone, at least one camera native to the mobile device, front and back-facing cameras native to the mobile device, at least one camera integrated and mounted on a vehicle, at least one camera mounted at various points of a vehicle, and at least one 360-degree video camera;

See claim 1 and 1[b] and claim 7; Ex. 1002, ¶216.

15[c] a computing device having a display screen and executing a mobile application in communication with the at least one video camera,

See claim 1 and 1[pre], [b], [c], and [d]; Ex. 1002, ¶217.

15[d] and configured, upon command from a user, to automatically determine a current location of the user,

See claim 1 and 1[e]; Ex. 1002, ¶218.

15[e] communicate with the remote server and notify at least one attorney located remotely,

See claim 1 and 1[f], [f][i]-[f][iii]; Ex. 1002, ¶219.

15[f] the at least one attorney being selected based on at least one of the attorney's licensure jurisdiction being consistent with the user's current location;

See claim 1 and 1[f], [f][ii]; *see also* claim 11; Ex. 1002, ¶220.

15[g] the remote server being configured to:

See claim 1 and 1[f]; Ex. 1002, ¶¶221-222.

- i. automatically search a plurality of information records associated with a plurality of attorneys stored in the remote database;**

See claim 1, 1[a], and 1[f][i]; Ex. 1002, ¶223.

- ii. automatically identify at least one attorney licensed in a jurisdiction that correspond to the current location of the mobile device;**

See claim 1 and 1[f][ii]; Ex. 1002, ¶224.

- iii. and automatically transmit at least one notification to at least one computing device associated with the identified at least one attorney;**

See claim 1 and 1[f][iii]; Ex. 1002, ¶225.

15[h] and the display screen configured to automatically display a live video image of the remote attorney upon acceptance of notification by the at least one remote attorney,

See claim 1 and 1[f][iv] (acceptance of the notification); *see also* claim 1[g] and claim 6[j] (display screen configured to automatically display a live video image of the remote attorney). Ex. 1002, ¶226.

15[i] and the at least one video camera being configured to automatically capture images of an ongoing incident involving the user subscriber and live-stream the captured video of the user subscriber and surroundings for live viewing by the at least one remote attorney and for storage in the database.

See claim 1 and 1[g], [h], and [i]. As discussed above, Pylant disclose an embodiment where a user (Jim) is connected with an attorney via video so as to enable the attorney to receive live-stream video from Jim at the accident site so as to be able to provide legal advice to Jim. 7:43-63. Ex. 1002, ¶227.

7. Claim 20 is rendered obvious in view of Pylant.

Claim 20 reads:

20. The mobile lawyer method of claim 15, wherein automatically determining a location of the user comprises accessing a GPS location of the user, and automatically identifying at least one remote lawyer licensed in a jurisdiction that matches the location of the user and matching additional filter criteria specified by the user.

Pylant discloses this dependent claim. Ex. 1002, ¶228. See claim 1[e] and 1[f][i]-[f][ii] (GPS location and identifying remote lawyer licensed in a jurisdiction that matches the location of the user). Pylant also teaches that the consultant/lawyer matching based on additional criteria, for example, that “Jim has rear-ended another car and has broken his arm ... can be included in the request” and the “request can include the location of Jim, and *what transpired in the accident*” to help identify the proper attorney. 7:34-62. The request “can comprise any amount of data.” 7:50-52.

Pylant not only teaches matching for the location of the user, but also teaches “matching based on additional filter criteria specified by the user” such as an attorney specializing in accidents.

IX. SECONDARY CONSIDERATIONS

There are no secondary considerations known to Petitioner.

X. DISCRETIONARY DENIAL IS UNWARRANTED

Petitioner is 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*⁵ “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 months⁶ 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 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

⁵ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

⁶ Excludes outliers.

scheduled *Markman* hearing date.⁷ 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. 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.

⁷ 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.

B. General Plastics is not applicable

This is the first petition filed by Petitioner for the '862 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, Petitioner requests institution of *inter partes* review of claims 1, 6, 7, 10, 11, 15, 16 and 20.

Respectfully submitted,

Dated: October 27, 2023

By: /Mark C. Nelson/

Mark C. Nelson, Reg. No. 43,830

mnelson@btlaw.com

Daniel A. Valenzuela, Reg. No. 69,027 (*Backup Counsel*)

daniel.valenzuela@btlaw.com

Juanita DeLoach, *Pro Hac Vice* Forthcoming

juanita.deloach@btlaw.com

BARNES & THORNBURG LLP

2121 N. Pearl St., Suite 700

Dallas, TX 75201

Telephone: (214) 258-4200

Fax: (214) 258-4199

*Counsel for TurnSignl, Inc.
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. 11,494,862 under 35 U.S.C. § 312 and 37 C.F.R. § 42.104 totals 12,116 words and is within the 14,000 words allowed under 37 C.F.R. §42.24(a)(1)(i).

Respectfully submitted,

Dated: October 27, 2023

By: /Mark C. Nelson/

Mark C. Nelson, Reg. No. 43,830

mnelson@btlaw.com

Daniel A. Valenzuela, Reg. No. 69,027 (*Backup Counsel*)

daniel.valenzuela@btlaw.com

Juanita DeLoach, *Pro Hac Vice* Forthcoming

juanita.deloach@btlaw.com

BARNES & THORNBURG LLP

2121 N. Pearl St., Suite 700

Dallas, TX 75201

Telephone: (214) 258-4200

Fax: (214) 258-4199

*Counsel for TurnSignl, Inc.
and TurnSignl Foundation*

CERTIFICATE OF SERVICE

I certify that a true and correct copy of the PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 11,494,862, all supporting exhibits, and the Power of Attorney were served on October 27, 2023 via Priority Mail Express to the correspondence address of record:

Fulton Jeang PLLC
6333 E. Mockingbird Ln., Ste 147
Dallas, TX 75214

Respectfully submitted,

Dated: October 27, 2023

By: /Mark C. Nelson/
Mark C. Nelson, Reg. No. 43,830
mnelson@btlaw.com
Daniel A. Valenzuela, Reg. No. 69,027 (*Backup Counsel*)
daniel.valenzuela@btlaw.com
Juanita DeLoach, *Pro Hac Vice* Forthcoming
juanita.deloach@btlaw.com
BARNES & THORNBURG LLP
2121 N. Pearl St., Suite 700
Dallas, TX 75201
Telephone: (214) 258-4200
Fax: (214) 258-4199

*Counsel for TurnSignl, Inc.
and TurnSignl Foundation*