

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

BROADPHONE LLC,
Patent Owner.

Case IPR2024-00155
U.S. Patent No. 10,341,811

PATENT OWNER'S PRELIMINARY RESPONSE

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Cases

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I. Introduction

The Board should decline institution of *inter partes* review (“IPR”) of U.S. Patent No. 10,341,811 (the “’811 Patent”). The Petition fails to show a reasonable likelihood of unpatentability. In particular, the Petition fails to show that a POSITA would be motivated to combine Spain-I with both Hunzinger and Nanda, and therefore fails to show that the combination of Spain-I, Hunzinger, and Nanda renders obvious any claim of the ’811 Patent.

II. Background

At a high level, the ’811 Patent is directed to a method by which a portable radio communication device can perform device-specific location-based actions. As part of this method, the portable device receives signals from nearby antennas and compares information related to those signals to information related to a device-specific target location. The ’811 Patent also claims a system comprising computer program code to perform such a method.

III. Level of Ordinary Skill in the Art

The Petition posits that a POSITA in the field of the ’811 Patent “would have had at least a BS degree in computer science, electrical engineering, or similar discipline, and two or more years of experience with location determining-based systems and/or processes, such as for example systems/processes for determining mobile device location(s).... More education can supplement practical experience

and vice versa.” Pet. at 3. For purposes of this preliminary response only, Patent Owner does not challenge the proposed definition.

IV. Claim Construction

The Petition states that “For purposes of this proceeding, no special constructions are necessary to assess whether the challenged claims are unpatentable over the asserted prior art, and thus Petitioner applies their plain meanings.” Pet. at 5. For purposes of this preliminary response only, Patent Owner agrees that no formal claim construction is necessary.

V. The Board should deny institution on the merits.

The Petition fails to show that Spain-I in view of Hunzinger and Nanda renders obvious limitations 1(b), 1(c), 15(b), or 15(c) of the ’811 Patent. Pet. at 12-53, 66. In particular, the Petition necessarily relies on the triple combination of Spain-I, Hunzinger, and Nanda for these limitations, yet fails to show that a POSITA would have been motivated to form that specific combination. Instead, the Petition plainly relies on hindsight, using the ’811 Patent as a roadmap for a method and system implementing device-specific location-based actions.

Spain-I lacks at least two of the key concepts of the ’811 Patent: (1) determining proximity to *device-specific* target locations and (2) performing location-based actions on the portable device when the device is at the device-specific target location. Rather, Spain-I teaches the use of a server separate from the

portable device to estimate the portable device's location, which may be "of interest *to the location server*," in contrast to the '811 Patent's focus on performing location-specific, device-specific actions on the portable device.

The Petition argues that a POSITA would have "found it obvious to configure Spain-I's system/processes to allow the MU to provide for device-specific target location selections" because "Spain-I... suggests the concept of user initiated target location fingerprint data collection," in particular by disclosing "generating/storing in a database fingerprints corresponding to selected location(s) that are compared to monitored fingerprint information to determine whether the MU's current location is 'at a particular location or not'" and "configurations where a user can initiate a request that causes 'the MU [to] capture[] the fingerprint of its current location.'" Pet. at 16.

But this does not show that a POSITA would be motivated to bridge the gap between Spain-I's generic notion of a server monitoring device locations based on fingerprints and the specific idea of utilizing device-specific target locations. For example, nothing in Spain-I discloses or suggests a target location that is device-specific or otherwise tailored to a given user or device. The Petition's hand-waving assumption of an "understanding that there were various ways and reasons providing for device-specific target locations corresponding to fingerprints..." is plainly

paraphrasing the '811 Patent claim language, and assuming that a POSITA would be trying to reach the specific solution claimed in the '811 Patent.

Furthermore, the same Petitioner makes the same argument, nearly verbatim, in co-pending petitions to reach *different conclusions*, confirming that the argument is purely generic and results oriented. In IPR2024-00154, Petitioner argues that a POSITA would have “found it obvious to configure Spain-I’s system/processes to *determine if the MU’s current location was in proximity of a user chosen location*” because Spain-1 “suggests the concept of user initiated location-based fingerprint data collection,” in particular by disclosing “generating/storing in a database fingerprints corresponding to selected location(s) to determine whether the MU’s monitored location is ‘at a particular location or not’” and “configurations where a user can initiate a request that causes ‘the MU [to] capture[] the fingerprint of its current location.’” IPR2024-00154, Petition, at 14-15 (emphasis added); *see also* IPR2024-00153, Petition, at 14.

The Petition’s core analysis of motivation to combine argues that “a POSITA would have been motivated, and found obvious, to configure the MU in the Spain-I system/process with mechanisms/features consistent with the user chosen location and location-based action features like that taught/suggested by Hunzinger (and Nanda) to cause a determination to detect proximity of device-specific target locations,” based almost entirely on the teachings of the secondary references. Pet.

at 26-28. But this discussion, which focuses essentially on Hunzinger and Nanda in isolation, fails to address why a POSITA would be motivated to combine Hunzinger and/or Nanda *with Spain-I*.

For example, the Petition argues that Hunzinger and Nanda provide beneficial “mechanisms for enabling a MU user to choose device-specific target location(s) from which location information is collected for comparison with current location information to cause a determination of whether the MU is at, entered, or left the device-specific target location in order to trigger corresponding selected actions.” Pet. at 26. But if Hunzinger and/or Nanda already provide those benefits, separately or in combination with each other, then those benefits provide no reason why a POSITA would be motivated to further combine either reference, or both, with Spain-I. For example, the Petition identifies nothing missing from Hunzinger and/or Nanda that a POSITA would be motivated to provide using Spain-I. A POSITA seeking a system for enabling a user to choose device-specific target locations, for example, would (under the Petition’s theory) simply use Hunzinger and/or Nanda. There is no articulated reason to use Spain-I other than hindsight bias; the Petition relies on Spain-I to meet other claim limitations, and therefore must stitch together the three references. Because the Petition does not and cannot show that Hunzinger and/or Nanda disclose all of the limitations of any claim of the ’811 Patent, this theory must fail.

The Petition defends its reliance on two secondary references to satisfy the same claim limitation by citing *Bayer Pharma AG v. Watson Lab'ys, Inc.*, 874 F.3d 1316, 1321-24 (Fed. Cir. 2017). *Bayer* suggests, at most, that when multiple secondary references suggest the same improvement, that improvement is likely obvious. There, the dispute was obviousness of an oral dissolving tablet (ODT) formulation of a certain drug. 874 F.3d at 1319, 1321. The district court had agreed with the patentee that there was no suggestion that this category of drug was suitable for ODT formulation, disregarding the six different references presented showing ODT formulations of similar drugs. *Id.* at 1321-22. The Federal Circuit reversed, emphasized that “[a]ll of these references indicate a person of ordinary skill in the art would have considered ODT formulations applicable to” the relevant category of drugs. *Id.* at 1322.

Here, however, Hunzinger and Nanda provide qualitatively different purported improvements over Spain-I. Nothing in Hunzinger corresponds to the “features that allow a mobile device user to select when to create a device-specific fingerprint, which causes fingerprint information (e.g., strength data) to be collected/measured while the MU is at a target location chosen by the user” allegedly present in Nanda. *See* Pet. at 23. Likewise, nothing in Nanda corresponds to the reminder and enter/exit functionality pointed to in Hunzinger. *See* Pet. at 17-20.

The Petition's failure to show motivation to combine Spain-I with either Hunzinger or Nanda or both dooms all asserted grounds. Each of Grounds 2-5 challenges only dependent claims, and each implicitly relies on Ground 1 to show the elements of independent claims 1 and 15. Pet. at 67, 72, 76-77, 83. And for at least elements 1(b), 1(c), 15(b), and 15(c), the Petition necessarily relies on the combination of Spain-I with either Hunzinger or Nanda.

First, the Petition impliedly concedes that Spain-I fails to disclose elements 1(b) and 15(b), at least as to the "determination of whether the portable RF communications device is within proximity of the device-specific target location." Pet. at 15-29. In particular, the Petition does not identify any device-specific target location in Spain-I and does not argue or suggest that Spain-I discloses a device-specific target location.

Second, the Petition impliedly concedes that Spain-I fails to disclose elements 1(c) and 15(c), instead asserting that "in view of Hunzinger, the modified Spain-I system/process would have been configured to initiate and perform a location-based action associated/assigned with the target location when the MU is determined to be in proximity of that location," and that "Nanda suggests configuring an MU to automatically look for a wireless LAN access point when the device-specific target location is detected." Pet. at 51-53; *see also id.* at 66. There is no suggestion, much

less a showing with particularity, that an unmodified Spain-I discloses these limitations.

VI. Conclusion

Because the Petition fails to show that a POSITA would be motivated to combine Spain-I with both Hunzinger and Nanda, which is a necessary predicate for each asserted Ground, institution should be denied as to all grounds.

Respectfully submitted,

Dated: February 20, 2024

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CERTIFICATION REGARDING WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), Patent Owner certifies that there are 1,604 words in the paper excluding the portions exempted under 37 C.F.R. §42.24(a)(1).

Dated: February 20, 2024

/s/ Reza Mirzaie
Reza Mirzaie

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on February 20, 2024, by filing this document through the P-TACTS system as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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