

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HYUNDAI MOTOR COMPANY,  
Petitioner,

v.

MEL NAVIP LLC,  
Patent Owner.

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IPR2024-00174  
Patent 8,812,230 B2

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Before BENJAMIN D. M. WOOD, LYNNE H. BROWNE, AND  
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

MARSCHALL, *Administrative Patent Judge*.

DECISION  
Granting Institution of *Inter Partes* Review  
35 U.S.C. § 314

Petitioner Hyundai Motor Company filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1, 2, and 4–8 of U.S. Patent No. 8,812,230 B2 (Ex. 1001, “the ’230 patent”). *See* Pet. 1. Patent Owner Mel NavIP LLC filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314; 37 C.F.R. § 42.4(a) (2022). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and the preliminary 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.” Upon consideration of the evidence and arguments in the record, we institute *inter partes* review of the ’230 patent on all challenges set forth in the Petition.

## BACKGROUND

### *A. Real Parties-in-Interest and Related Matters*

Petitioner identifies itself, Hyundai Motor Company; Hyundai Motor America; Hyundai Capital America; Kia Corporation; and Kia America, Inc., as the real parties-in-interest. Pet. 80–81. Patent Owner identifies itself, Mel NavIP LLC, as the real party-in-interest. Paper 5, 2.

The parties identify the following related matters: *Mel NavIP LLC v. Hyundai Motor Co.*, Case No. 2:23-cv-00176 (E.D. Tex.); *Mel NavIP LLC v. General Motors Co.*, Case No. 2:23-cv-00175 (E.D. Tex.). Pet. 81; Paper 5, 2.

### *B. The ’230 Patent*

The ’230 patent relates to a navigation device capable of displaying updated service information (e.g., pricing, menus, availability) about destination facilities (e.g., hospitals, stores, restaurants) with which a user of

the device has registered to receive updated service information. Ex. 1001, 1:5–19, 2:13–27; *see also id.* at 4:4–10, Fig. 1, 5:67–6:14, Fig. 4, 9:2–3, Fig. 8, 13:13–17, Fig. 16, 13:17–21, Fig. 17.

Figure 1, reproduced below, provides an overview of the '230 patent's navigation device.

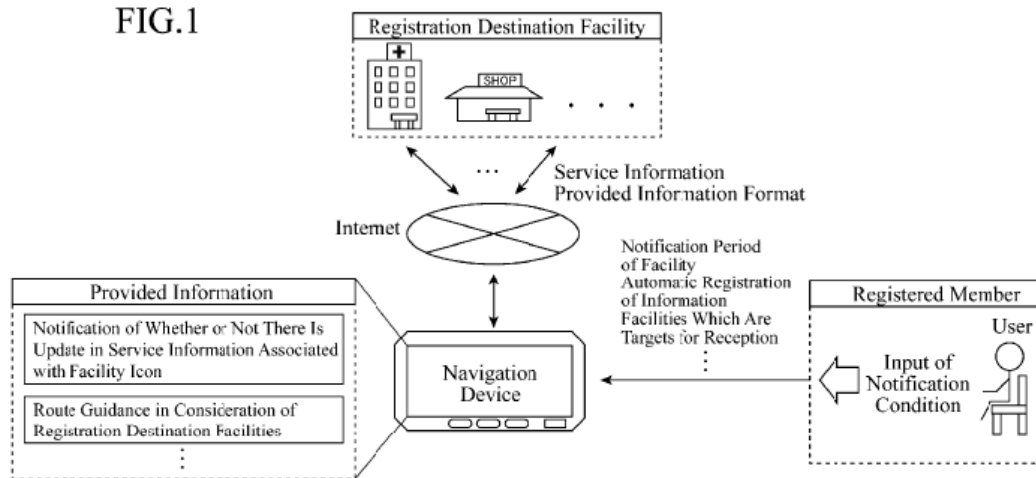


Figure 1 depicts “the structure of a service information distribution system to which [the disclosed] navigation device . . . is applied.” Ex. 1001, 3:32–4:1. “In this service information distribution system, the navigation device is connected to registration destination facilities via the internet,” and “a user who is a registered member of a registration destination facility sets a notification condition to the navigation device.” *Id.* at 4:1–6.

“Service information distributed from the registration destination facility is presented for the user at an appropriate timing according to the notification condition set by the user and according to a current position.” Ex. 1001, 4:6–10. For example, when there is an update in service information provided by a registration destination facility being displayed on the on-screen map of the navigation device, a frame is added to the edges of an icon representing the registration destination facility and the icon flashes

to notify the user of an update to the service information. *Id.* at 5:26–31, 13:4–21.

*C. Challenged Claims*

As noted above, Petitioner challenges claims 1, 2, and 4–8 of the '230 patent, with claim 1 an independent claim and the remaining claims depending on claim 1. Pet. 1; Ex. 1001, claims 1, 2, 4–8. Claim 1, which illustrates the challenged subject matter, is reproduced below.

1. A navigation device comprising:
  - a data storage unit for storing data;
  - a service information reception processing unit for receiving service information at an external registration destination facility with which member registration is made, the service information being distributed from the external registration destination facility;
  - a service information analyzing processing unit for performing a predetermined process on the service information received by said service information reception processing unit to register the service information in said data storage unit;
  - a notification condition customization setting unit for setting a notification condition about notification of the service information at the external registration destination facility; and
  - a facility icon display processing unit for displaying, on a map of a current location and surrounding area of the navigation device, an icon representing a registration destination facility located within an area covered by the displayed map, and for displaying a modified version of the icon on the map in such manner indicating that there is an update in service information at the registration destination facility located within an area covered by the displayed map, according to the notification condition set by said notification condition customization setting unit, said notification condition being

satisfied when the service information at the represented registration destination facility has been updated,

wherein the navigation device displays the map on which the icon is displayed in accordance with a navigation function.

Ex. 1001, claim 1.

*D. Asserted Grounds of Unpatentability*

Petitioner asserts the following grounds of unpatentability (Pet. 1):

| Claim(s) Challenged | 35 U.S.C. §      | Basis/Reference(s)                    |
|---------------------|------------------|---------------------------------------|
| 1, 2, 4–8           | 103 <sup>1</sup> | Fujiwara <sup>2</sup>                 |
| 1, 2, 4–8           | 103              | Ota, <sup>3</sup> Matsuo <sup>4</sup> |

Petitioner filed a Declaration of David H. Williams (Ex. 1003) with the Petition. Patent Owner filed a Declaration of Dr. Fang Qiu (Ex. 2001) with its Preliminary Response.

ANALYSIS

*A. Legal Standards*

A claim is unpatentable as obvious under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

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<sup>1</sup> Because the '230 patent issued from an application filed before March 16, 2013, the effective date of the amendment to 35 U.S.C. § 103 enacted by the Leahy-Smith America Invents Act (AIA), we apply the pre-AIA version of this section. *See* AIA, Pub. L. No. 112–29, § 3(n)(1), 125 Stat. 284, 293 (2011).

<sup>2</sup> US 2004/0012506 A1, published Jan. 22, 2004 (Ex. 1005, “Fujiwara”).

<sup>3</sup> JP 2008/051605 A, published Mar. 6, 2008 (Ex. 1007 (Japanese version) Ex. 1008 (English Translation), collectively, “Ota”).

<sup>4</sup> US 7,383,127, issued June 3, 2008 (Ex. 1010, “Matsuo”).

subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

*B. Level of Ordinary Skill in the Art*

The level of skill in the art is “a prism or lens” through which we view the prior art and the claimed invention. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). Factors pertinent to a determination of the level of ordinary skill in the art include: (1) educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of workers active in the field. *Env’t Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696–697 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1381–82 (Fed. Cir. 1983)). Not all such factors may be present in every case, and one or more of these or other factors may predominate in a particular case. *Id.* Moreover, these factors are not exhaustive but are merely a guide to determining the level of ordinary skill in the art. *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007). In determining a level of ordinary skill, we also may look to the prior art, which may reflect an appropriate skill level. *Okajima*, 261 F.3d at 1355.

Petitioner contends that one of ordinary skill in the art “would have had an undergraduate degree in electrical engineering, computer

engineering, computer science, or an equivalent degree, as well as at least three years of experience in the design and implementation of navigation systems.” Pet. 4 (citing Ex. 1003 ¶ 36). Patent Owner contends that one of ordinary skill in the art

would have (a) a Bachelor's of Science degree in a technical field and at least four years of experience in the field of design and/or manufacture of navigation systems; (b) a Master's of Science degree in a technical field and at least two years of experience in the field of design and/or manufacture of navigation systems; or (c) a PhD in a technical field relating to the design and/or manufacture of navigation systems. Additional graduate education could substitute for professional experience, or significant experience in the field could substitute for formal education.

Prelim. Resp. 3 (citing Ex. 2001 ¶ 29).

Patent Owner does not identify any deficiencies in Petitioner's proposal, and we view the parties' proposals as overlapping to a large extent. *See* Pet. 4; Prelim Resp. 3. For purposes of this Decision, we adopt and apply Petitioner's proposed level of ordinary skill in the art, which we view as consistent with the level of skill reflected in the '230 patent and the asserted prior art. None of our determinations in this Decision would have been different if we applied Patent Owner's proposal. If the parties continue to propose differing levels of ordinary skill in the art during trial, they should explain the differences and the relevance to the patentability issues in this case.

### *C. Claim Construction*

We construe each claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b).” 37 C.F.R. § 42.100(b). Under this standard, claim terms are

generally given their ordinary and customary meaning as would have been understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc) (“We have frequently stated that the words of a claim ‘are generally given their ordinary and customary meaning.’” (citations omitted)). “The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner contends that no claim construction is required for us to reach a decision on institution (Pet. 4), and Patent Owner does not address claim construction in its Preliminary Response. We determine that no express claim construction is necessary for the purposes of this Decision and therefore apply the plain and ordinary meanings of the claim limitations before us. If either party believes that the patentability of any challenged claim turns on a claim construction issue, they should set forth any proposed constructions in a separate section of their briefing during trial rather than implicitly relying on a construction in arguments addressing the prior art.

#### *D. Obviousness Based on Fujiwara*

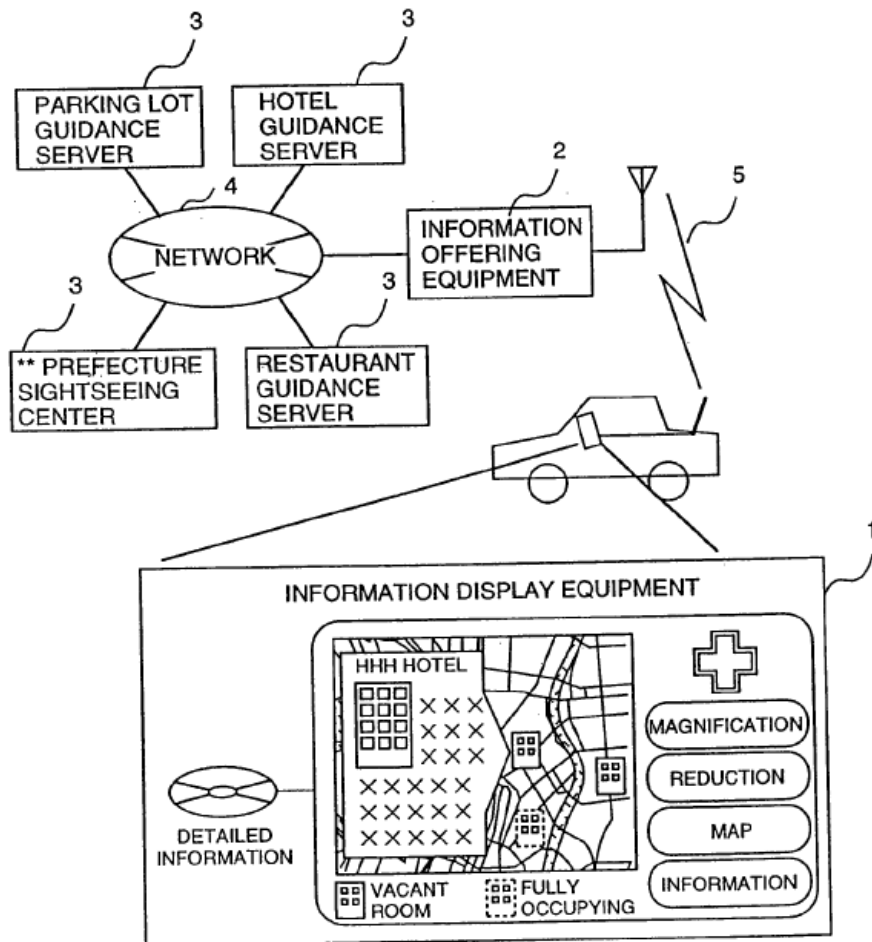
Petitioner argues that Fujiwara renders obvious claims 1, 2, and 4–8. *See* Pet. 5–43. Patent Owner raises several arguments against this challenge. *See* Prelim. Resp. 5–9. We first provide a brief overview of the prior art, and then address the parties’ arguments.

1. Fujiwara

Fujiwara relates to a navigation system that provides up-to-date information about facilities on a map in such a fashion that a driver can readily perceive the information about the facilities without averting attention from the road. Ex. 1005 ¶¶ 1, 6; *see also id.* at Figs. 17–23 (depicting information about hotels and restaurants on display screen of the navigation system).

Figure 1, reproduced below, is an overview of Fujiwara’s navigation system.

FIG.1



The navigation system depicted in Figure 1 comprises information display equipment 1, information offering equipment 2, information offering server 3, and network 4. Ex. 1005 ¶ 38. Fujiwara explains that information offering equipment 2 obtains information about facilities (e.g., hotel occupancy levels, restaurant wait times) from information offering server 3 (e.g., hotel guidance server, restaurant guidance server) through network 4 (e.g., the internet) and displays that information on information display equipment 1. *Id.* ¶ 38, Figs. 1, 17–23.

Fujiwara allows a user to configure how to update the information (e.g., based on time or location), and specify the information to be retrieved. Ex. 1005 ¶¶ 71–80; Figs. 8 (showing that a user can set the information to be retrieved based on the classification of the facilities), Fig. 9 (showing that a user can set the information to be retrieved based on the area of interest), Fig. 10 (showing that a user can set the information to be retrieved based on vehicle size, credit card information, and preferred service stations), 11–13. Fujiwara further teaches that only users registered with user authentication server 26 may receive information from information offering equipment 2. *Id.* ¶¶ 111, 117.

Fujiwara also discloses icon property setting means 65, which can adjust the “color and size, intensity, chroma, light on/light off, display/non display” of an icon representing a facility based on information about the facility. Ex. 1005 ¶¶ 83, 87. “For example, an icon of a restaurant which is not crowded is shown by blue (white in FIG. 19), an icon of a restaurant which is available if waiting a little, is shown by yellow (black in FIG. 19), and an icon of a restaurant which is not available if waiting a little, is shown by red (dotted line in FIG. 19).” *Id.* ¶ 87.

## 2. Discussion

We begin with Petitioner’s argument that independent claim 1 would have been obvious in view of Fujiwara. *See* Pet. 8–32. For each limitation in claim 1, Petitioner points to specific portions of the reference that support its position and declarant testimony addressing each limitation. *See id.* (citing Ex. 1003). Patent Owner argues that Petitioner fails to establish that Fujiwara discloses or renders obvious the service information reception processing unit, notification condition customization setting unit, and the facility icon display processing unit limitations. *See* Prelim. Resp. 5–9 (citing Ex. 2005). We address each of these limitations in turn below.

### a. Service Information Reception Processing Unit

Claim 1 includes a “service information reception processing unit” limitation that requires “a service information reception processing unit for *receiving service information at an external registration destination facility with which member registration is made*, the service information being distributed from the external registration destination facility.” Ex. 1001, claim 1 (emphasis added).

Petitioner contends that “Fujiwara’s display side communications equipment 21 and Fujiwara’s SCI 39, together, disclose the ‘service information reception processing unit.’” Pet. 10 (citing Ex. 1003 ¶ 119). More specifically, “display side communications equipment 21 receives service information and SCI 39 processes service information.” *Id.* (citing Ex. 1003 ¶ 119; Ex. 1005 ¶¶ 49–50, 53, Figs. 2, 4). According to Petitioner, “Fujiwara’s display side communication equipment 21 and SCI 39 (*i.e.*, ‘service information reception processing unit’) ‘reciev[es] service information at an external registration destination facility’ and that its

information offering server 3 (*i.e.*, ‘external registration destination facility’) distributes service information.” Pet. 11 (alterations in original) (citing Ex. 1003 ¶ 120).

Petitioner further contends that “[a]n ‘external registration destination facility’ is a facility such as a hotel, restaurant, ferry, or parking lot.” Pet. 9 (citing Ex. 1001, 1:11–19, Figs. 1, 16–17; Ex. 1003 ¶ 117). According to Petitioner, “[s]ervice information’ is information about an ‘external registration destination facility’ such as business hours, address, hotel vacancy, restaurant wait times, menus, and ferry availability.” *Id.* (citing Ex. 1001, 13:6–21, Figs. 16–17; Ex. 1003 ¶ 117). Petitioner considers Fujiwara’s information offering sever 3—which “can be a variety of different servers, such as a hotel guidance server 3, restaurant guidance server 3, and/or a parking lot guidance server 3”—as corresponding to the claimed external registration destination facility. *Id.* at 11 (citing Ex. 1003 ¶ 120; Ex. 1005 ¶¶ 9, 38, 76, 87, Figs. 1, 17–23). Petitioner further argues that Fujiwara “discloses that ‘member registration’ can be made with the information offering server 3 (*i.e.*, ‘external registration destination facility’).” Pet. 12 (citing Ex. 1003 ¶ 122); *see also id.* 12–13 (citing Ex. 1003 ¶¶ 122–125; Ex. 1005 ¶¶ 6, 38, 76, 87, 105, 108, 110–11, 117, claim 7) (arguing that Fujiwara discloses a registration system through user authentication server 26).

Patent Owner argues that Petitioner “erroneously equates” Fujiwara’s information offering server 3 with the claimed external registration destination facility because “Fujiwara does not provide any indication whatsoever that the information offering server pertains to a particular facility.” Prelim. Resp. 7 (citing Ex. 2001 ¶¶ 41–43). Patent Owner relies

on a portion of the '230 patent's background section describing route guidance to a registration destination facility to argue that "the information offering server simply cannot be the same as the registration destination facility." *Id.* at 7 (citing Ex. 1001, 1:20–30). Patent Owner further contends that "Fujiwara only provides for registration with an information offering server for categorical information, such as hotels, restaurants or parking lots," and thus Fujiwara does not disclose "a particular registration destination facility with which member registration is made." Prelim. Resp. 7 (citing Ex. 2001 ¶¶ 41–43). Patent Owner also asserts that an ordinary artisan "would not understand Fujiwara as rendering this element obvious because the system of Fujiwara differs from that of the '230 Patent fundamentally." *Id.* (citing Ex. 2001 ¶¶ 41–43).

Based on the current record, we find Petitioner's arguments persuasive and Patent Owner's arguments unavailing. While we agree with Patent Owner that Fujiwara's information offering server may offer service information for multiple facilities, we disagree that this necessarily takes it outside of the scope of the claim limitation at issue, based on the current record. For example, in the situation where Fujiwara's information offering server offers service information for a single facility, Fujiwara's information offering server would pertain to a particular registration destination facility. We understand Petitioner's argument as based on Fujiwara's ability to provide information as to specific hotels, such as vacancies at a specific hotel, not hotels generally. *See* Pet. 9–14; Ex. 1005, Figs. 14–18, 20–23 (showing vacancy information for specific hotels). Fujiwara's reference to vacancy information would seem to make little sense if not tied to a particular facility. Patent Owner does not address this aspect of Petitioner's

arguments, which renders Fujiwara’s ability to provide service information for more than one facility inapposite. *Cf. Hewlett-Packard Co. v. Mustek Systems, Inc.*, 340 F.3d 1314, 1326 (Fed. Cir. 2003) (“[A] prior art product that sometimes, but not always, embodies a claimed method nonetheless teaches that aspect of the invention.”).

As to Patent Owner’s argument that an ordinary artisan would not understand Fujiwara as rendering obvious this limitation because “the system of Fujiwara differs from that of the ’230 patent fundamentally,” we find the argument lacking in explanation and support. *See* Prelim. Resp. 7 (quoting Ex. 2001 ¶ 43). The cited declarant testimony does not aid Patent Owner here, as it merely repeats the arguments from the Preliminary Response without further explanation or citation to supporting evidence.

Based on the current record, Petitioner establishes adequately that Fujiwara discloses “a service information reception processing unit for receiving service information at an external registration destination facility with which member registration is made, the service information being distributed from the external registration destination facility.”

*b. Notification Condition Customization Setting Unit*

Claim 1 includes a “notification condition customization setting unit” limitation that requires “a notification condition customization setting unit for *setting a notification condition about notification of the service information* at the external registration destination facility.” Ex. 1001, claim 1 (emphasis added).

Petitioner contends that Fujiwara’s retrieval range setting means 60 discloses the “notification condition customization setting unit” limitation. Pet. 16 (citing Ex. 1005 ¶¶ 71, 75–80, Fig. 6; Ex. 1003 ¶ 134). Specifically,

Petitioner argues that “Fujiwara’s retrieval range setting means 60 ‘sets one or more items selected by the user’ (*i.e.*, customization) ‘as a retrieve object property’ (*i.e.*, ‘notification condition’).” *Id.* at 17 (citing Ex. 1005 ¶ 71, Fig. 6; Ex. 1003 ¶ 135). Petitioner cites to several examples of retrieve object properties (*i.e.*, notification conditions) that a driver can set for retrieval from the information offering server 3 (*i.e.*, registration destination facility), including the facility category, location, and other characteristics like credit card networks accepted. *Id.* at 17–22 (citing Ex. 1003 ¶¶ 137–47; Ex. 1005 ¶¶ 71, 75–76, Figs. 8–10).

Patent Owner argues that “[t]he categorical information for which the disclosure of Fujiwara pertains is not service information as described in the ’230 patent,” which states that “service information must be subject to updating.” Prelim. Resp. 8 (citing Ex. 2001 ¶ 44). Patent Owner further contends that an ordinary artisan “would not find it obvious to replace the high level, categorical information disclosed in Fujiwara with the destination specific service information disclosed in the ’230 Patent.” *Id.*

We do not find Patent Owner’s arguments persuasive. As the Petition explains, “Fujiwara’s retrieval range setting means 60 allows a driver to have predetermined settings[,*i.e.*, notification conditions] that can be used to automatically retrieve object properties, such as business hour information and vacancy information,” *i.e.*, service information. Pet. 21 (citing Ex. 1005 ¶ 76; Ex. 1003 ¶ 144). As explained above, we read the Petition as alleging that Fujiwara provides facility-specific information, not “categorical information” as Patent Owner alleges—information such as vacancy information would have little value if it were not tied to specific facilities and not updated. *See* Prelim. Resp. 8. In addition, we again view Patent

Owner’s argument that an ordinary artisan would not find it obvious to replace the high level, categorical information disclosed in Fujiwara with destination specific service information as an unsupported, conclusory assertion entitled to little weight based on the current record. *See id.* (citing Ex. 2001 ¶ 44).

Based on the current record, we find that Petitioner has adequately established that Fujiwara discloses “a notification condition customization setting unit for setting a notification condition about notification of the service information at the external registration destination facility.”

*c. Facility Icon Display Processing Unit*

Claim 1 includes a “facility icon display processing unit” limitation that requires

a facility icon display processing unit for displaying, on a map of a current location and surrounding area of the navigation device, an icon representing a registration destination facility located within an area covered by the displayed map, and for *displaying a modified version of the icon on the map in such manner indicating that there is an update in service information at the registration destination facility located within an area covered by the displayed map, according to the notification condition set by said notification condition customization setting unit, said notification condition being satisfied when the service information at the represented registration destination facility has been updated.*

Ex. 1001, claim 1 (emphasis added).

Petitioner contends that “Fujiwara’s icon setting means 62, icon drawing location setting means 63, icon setting means 64, and icon property setting means 65” renders obvious the facility icon display processing unit. *See* Pet. 22 (citing Ex. 1003 ¶ 150). Petitioner further argues that an ordinary artisan

would have understood that Fujiwara’s icon property setting means 65 [] teaches “displaying a modified version of the icon on the map in such manner indicating that there is an update in service information at the registration destination facility located within an area covered by the displayed map” because the icon property setting means 65 “sets [the] property of an icon such as color and size, intensity, chroma, light on/light off, display/non display, based on information taken out with the received data analysis means 61.”

*Id.* at 27 (citing Ex. 1003 ¶ 164; Ex. 1005 ¶¶ 87, 96); *see also id.* at 25–31 (addressing various aspects of the “displaying a modified version of the icon” aspect of the limitation).

Patent Owner’s Preliminary Response raises three arguments—all directed to the emphasized portion of the limitation quoted above. *See* Prelim. Resp. 8–9. First, Patent Owner argues that Fujiwara does not “indicate[] that the updated service information is subject to a notification condition set by a user for a destination facility where the user has registered” because “the information is at best categorical information not specific to a facility where the user has registered.” *Id.* (citing Ex. 2001 ¶¶ 45–47). Second, Patent Owner contends that “Fujiwara’s vague description of intelligibly presenting information for a driver’s convenience is a far cry from displaying a modified version of an icon on a map to indicate that there is an update in service information” because “an indication of an update at a server of high-level categorical information cannot be a disclosure of this element.” *Id.* at 9 (citing Ex. 2001 ¶¶ 45–47). Third, Patent Owner asserts that an ordinary artisan would “not consider the disclosure of updates to whole categories of service providers as rendering obvious updates based on notification conditions set by a user for specific

destinations at which the user has registered.” *Id.* (citing Ex. 2001 ¶¶ 45–47).

We determine that Petitioner has presented sufficient evidence that Fujiwara renders obvious the facility icon display processing unit limitation. For example, Figure 19, reproduced below, demonstrates the capability of Fujiwara’s system to display a modified icon for a facility with updated service information.

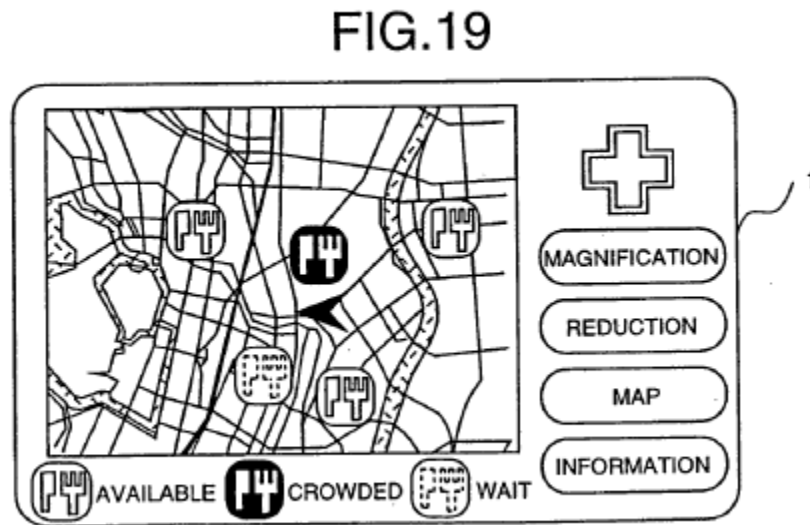


Figure 19 depicts a navigation device with a map showing several restaurant facilities, wherein the color of the icons representing the facilities changes based on updated service information, i.e., the restaurant’s wait time. *See* Ex. 1005 ¶ 87; Pet. 29 (citing Ex. 1003 ¶ 167). Petitioner persuasively explains, based on the current record, that Fujiwara teaches how a user may predetermine how property information is to be updated, i.e., the icons are modified in accordance with the notification condition customization setting unit. *See* Pet. 29–30 (citing Ex. 1003 ¶ 169; Ex. 1005 ¶¶ 76–80, Figs. 11–13). As discussed above, and as the Petition explains, we view Fujiwara as

providing facility-specific, updated information, not mere categorical information as Patent Owner alleges. *See* Prelim. Resp. 8–9.

At this stage, we find that Petitioner has adequately established that Fujiwara discloses the facility icon display processing unit limitation.

### 3. Conclusion

Based on the foregoing, we determine that Petitioner establishes adequately that Fujiwara discloses the disputed limitations. We have also reviewed Petitioner’s arguments and evidence as to the remaining limitations of claim 1. Based on our review of the current record, Petitioner establishes sufficiently that Fujiwara discloses or renders obvious all of the limitations of claim 1 for the reasons provided by Petitioner. *See* Pet. 8–32. Accordingly, Petitioner establishes a reasonable likelihood that independent claim 1 would have been obvious based on Fujiwara.

We have also reviewed Petitioner’s arguments and evidence as to dependent claims 2 and 4–8. *See* Pet. 32–43. Patent Owner does not separately address the dependent claims. Prelim. Resp. 9. Because we institute *inter partes* review as to independent claim 1, we also institute *inter partes* review as to dependent claims 2 and 4–8. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

#### *E. Obviousness Based on Ota and Matsuo*

Petitioner argues that the combination of Ota and Matsuo also renders claims 1–2 and 4–8 obvious. *See* Pet. 43–77. Patent Owner raises several arguments against this challenge. *See* Prelim. Resp. 10–15.

We institute *inter partes* review as to this challenge because we institute *inter partes* review as to claims 1–2 and 4–8 based on Petitioner’s obviousness challenge based on Fujiwara. *See SAS*, 138 S. Ct. at 1359–60.

We provide the following brief analysis of the parties' arguments to guide the parties during trial. We first provide a brief overview of the prior art, and then address the parties' arguments.

*1. Ota*

Ota relates to “a navigation system and navigation device that make it possible to easily obtain new facility information and allow such information to be used while being identified as new facility information.” Ex. 1008, code (57). Ota's broadcasting device 200 receives facility information from broadcast database 300 and broadcasts the facility information over radio waves to car navigation device 100. *Id.* ¶¶ 72–76. Ota describes facility information as including the name and location of a facility, type of facility, facility business hours, parking availability at the facility, images of the facility and images of food or services provided by the facility. *Id.* ¶ 79.

Ota allows a user to search for facilities (e.g., restaurants) within a predetermined range and within the area of a map displayed on navigation device 100. Ex. 1008 ¶¶ 128, 132. Ota also discloses that facilities with updated facility information received from the broadcasting device can be distinguished from facilities pre-loaded on the navigation device through “an accompanying mark,” so that a user “can recognize new facility information.” *Id.* ¶¶ 21, 54, 62–63. “[T]he [accompanying] mark may contain words such as ‘Recommended,’ ‘New,’ ‘Latest,’ etc., or may be some kind of symbol such as an asterisk, provided that it allows appropriate recognition by the user.”” *Id.* ¶ 63.

*2. Matsuo*

Matsuo relates to “a navigation apparatus for giving route guidance using map data delivered through communication or broadcasting” and “an

information delivery apparatus for delivering map data using communication and broadcasting.” Ex. 1010, 1:10–14. Matsuo discloses a map delivery center 80 for delivering map data to a navigation terminal 5. *Id.* at 5:20–21.

Matsuo’s map delivery center 80 includes “a server 81 . . . and a point information database [] 83 for storing information indicating the types, names, addresses, and telephone numbers of primary facilities such as restaurants, gas stations, leisure facilities, and public facilities in respective areas of a map.” Ex. 1010, 7:50–55. Matsuo’s server 81 has an authentication unit 801 that performs an authentication process when accessed by navigation terminal 5 and only permits a registered navigation terminal 5 to access server 81. *Id.* at 8:5–8.

### 3. Discussion

We first address Petitioner’s argument that independent claim 1 would have been obvious in view of Ota and Matsuo. *See* Pet. 49–69. For each limitation in claim 1, Petitioner points to specific portions of the references that support its position and declarant testimony addressing each limitation. *See id.* (citing Ex. 1003).

Patent Owner argues that Petitioner fails to establish that Fujiwara discloses or renders obvious the service information reception processing unit, notification condition customization setting unit, and the facility icon display processing unit limitations. *See* Prelim. Resp. 10–14 (citing Ex. 2001). These arguments largely mirror Patent Owner’s arguments with respect to the challenge based on Fujiwara, and we find those arguments unpersuasive for the reasons discussed above. *Compare id.* at 5–9, *with id.* 10–14.

Patent Owner makes a distinct argument as to Ota when it asserts that “Ota’s description of identifying icons as ‘recommended’ or ‘new’ is far cry from displaying a modified version of an icon on a map to indicate that there is an update in service information as required by the claim.” Prelim. Resp. 14 (citing Ex. 2001 ¶¶ 54–55). Neither the Preliminary Response nor cited declarant testimony explain how the text associated with the icons (“recommended” and “new”) fail to indicate an “update in service information” or address Petitioner’s further argument that the asterisk in the icon indicates updated information. *See id.*; Pet. 63–64.

Patent Owner additionally argues that an ordinary artisan “viewing the navigation system of Ota would not review or consider the Matsuo reference at all as the combination would not include each element of Claim 1 . . . .” Prelim. Resp. 14–15; *see* Ex. 2001 ¶¶ 56–57. We find this argument duplicative of Patent Owner’s arguments that the combination of Ota and Matsuo fail to disclose or render obvious the above mentioned limitations, and thus unpersuasive.

#### 4. Conclusion

We include this challenge to claims 1, 2, and 4–8 as part of the trial because we already determined that Petitioner made an adequate showing to institute an *inter partes* review based on Petitioner’s obviousness challenge relying on Fujiwara. *See SAS*, 138 S. Ct. at 1359–60. The parties may further address patentability issues relating to all challenges during the trial.

### CONCLUSION

After considering the evidence and arguments presented in the current record, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail with respect to at least one claim of the ’230

patent challenged in the Petition. Therefore, we grant institution of *inter partes* review.

ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted for claims 1, 2, and 4–8 of the '230 patent on the unpatentability grounds asserted in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, which commences on the entry date of this decision.

IPR2024-00174  
Patent 8,812,230 B2

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