

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.
Petitioner

v.

MOBILE DATA TECHNOLOGIES, INC.,
Patent Owner

Case IPR2024-00246
U.S. Patent No. 8,793,336 B2

PETITIONER'S PRELIMINARY REPLY

Petitioner respectfully submits this Preliminary Reply, as authorized by the Board, to address certain issues raised by Patent Owner ("PO") under § 325(d).

Neibauer and Cheng: Under Part Two, "if 'the record is not well developed or silent,'" the Petitioner "must simply 'show [that] the Office [materially] erred by overlooking something.'" *LG Elecs. v. Pantech*, IPR2023-01273, Paper 26 at 15 (PTAB April 9, 2024) (quoting *Advanced Bionics*). The record here on Neibauer and Cheng is entirely "silent" because the Examiner never addressed them.

As the Petition explained, the Examiner erred by overlooking Neibauer and Cheng and the compelling grounds of unpatentability they provided. (Petition, 5-6.) They were stronger prior art than Rensin because they disclosed the limitations the Examiner thought were missing from Rensin. (*Id.*) As further evidence of error, the Examiner entered a double patenting rejection based on U.S. Patent No. 8,135,801 – the direct parent of the '336 patent whose claims were invalidated in reexamination based on Neibauer and Cheng. (*Id.*, 5.) The double patenting rejection was based on the Examiner finding that the '336 and '801 claims had "common subject matter." (EX1022, 00239.) This demonstrates that the Examiner should have appreciated Neibauer and Cheng in light of their use to reject similar claims in the '801 patent.

PO attempts to distinguish the '336 and '801 claims through a two-column chart comparing claim 1 of both patents, but PO fails to consider the claims as a whole. (POPR, 16-17.) The left column highlights limitations in the '801 relating

to “**accessibility rules**,” but those features are separately recited in ’336 dependent claims 8 and 9. (Petition, 40-44.) The right column highlights limitations in the ’336 relating to “**messaging content**” between users, which are encompassed by ’801 claim 9 that was also invalidated based on Neibauer. (EX1028, 19:26-30.) The PTAB affirmed the obviousness of claims 1-9, 12-13, 15-19 and 21-28 based on Neibauer. (EX1024, 9-12.) The fact that the independent claims are not identical does not diminish the Examiner’s finding of subject matter overlap between the claims of both patents, further demonstrating the existence of material error.

Miller: Agboatwalla is materially different and would have required a fundamentally different analysis to combine with Neibauer. In fact, the PTO expressly refused to apply Agboatwalla during the ’801 patent reexamination after finding that it did *not* disclose “**web-based**” interfaces, which are also recited in the challenged claims. (EX1029, 0015-0018.) Miller by contrast discloses a web-based community with far greater similarity to Neibauer and the ’336 patent. (Petition, 19-20.) The Petition supported the combination by noting that “Miller discloses many of the same features that Neibauer describes as being available for clubs, including message boards, chat, contact list, among others.” (Petition, 20 (citations omitted).) Agboatwalla does not disclose those same features. It instead describes an Enterprise Habitat (EH) for managing business data such as documents, email, spreadsheets, database data, etc. (EX2003, 3:32-37, 31:52-60.)

Ausems: Dependent claim 7, to which Ausems was applied, requires that device-captured image data be shared. (Petition, 39.) Ausems discloses a mobile device with a camera for capturing, storing, and transmitting images. (*Id.*, 59-60.) The disclosures of Rensin cited by PO merely identify a camera as a “PDA expansion slot” device, and do not describe the camera’s operation in any detail or state that captured images can be stored and transmitted. (POPR, 10.)

Fransioli: The nearby restaurant feature in Flom cited by PO retrieves data “based on previous search requests made by that user.” (POPR, 11 (quoting Flom, ¶0059).) That would have complicated the combination with Neibauer because the “**messaging content**” of claim 21, to which Fransioli was applied, includes a Yahoo! club board message that does not require a previous user search request. (Petition, 63.) Nor does Fransioli. The combination was further enhanced by Fransioli’s disclosure that it can be used with a “web portal,” which included Yahoo! as confirmed in Neubauer. (EX1002, ¶193; Petition, 63-64.) Flom contains no similar disclosures. For all of these reasons, Flom is materially different from Fransioli.

Harvey: PO misses the point for which Harvey was cited—the ability of a creator to add content to a community *before* it is created and launched. (Petition, 66.) Sutherland does not show this; the disclosures cited by PO instead show the ability to upload images to a community *after* it is created and *after* other members have been invited to join it. (POPR, 12-13, ¶6 (quoting Sutherland, ¶0034).)

Petitioner's Preliminary Reply
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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Section 42.6, that a complete copy of the attached **PETITIONER'S PRELIMINARY REPLY** and related documents are being served via electronic mail on the 22nd day of April 2024 upon the Patent Owner's attorneys of record in this proceeding as follows:

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