

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 IPR2024-00250
U.S. Patent No. 9,922,348 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, Cheng and Squibbs: 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 on *Neibauer, Cheng and Squibbs* is entirely "silent" because the Examiner never addressed them. Petitioner cannot read the Examiner's mind, so any assertions about what he may have thought about those references would be pure speculation.

As the Petition explained, the Examiner erred by overlooking these references and the compelling grounds of unpatentability they provided. (Petition, 4-5.) *Neibauer, Cheng, and Squibbs* were stronger prior art because they disclosed the limitations the Examiner thought were missing from McGarry. (*Id.*) *Neibauer, Cheng, and Squibbs* disclosed and rendered obvious each limitation of the challenged claims including limitations relating to receipt and integration of device-captured data highlighted by the Examiner in the Notice of Allowance. (*Id.*)

As further evidence of error, the Examiner rejected the claims based on double-patenting grounds over U.S. Patent No. 9,619,578, an earlier patent in the same family that is subject to another IPR (IPR2024-00249). (EX1022, 00156-00157.) The Examiner acknowledged that the '348 and '578 claims "are not

identical,” but found that “they are not patentably distinct from each other.” (EX1022, 00157.) As explained in Petitioner’s preliminary reply in IPR2024-00249, the ’578 patent was rejected on double-patenting grounds over U.S. Patent No. 8,135,801, an earlier patent whose claims were invalidated in reexamination based on Neibauer and Cheng. (See EX1022 in IPR2024-00249, 00252-00254.) The double patenting rejection was based on a finding that the ’336 and ’578 claims had “common subject matter.” (EX1022 in IPR2024-00249, 00254.) In light of the Examiner’s finding of claimed subject matter overlap with respect to the ’801, ’578, and ’348 patents, the Examiner should have appreciated Neibauer and Cheng in light of their use to reject the claims in the ’801 patent.

Advanced Bionics makes clear that if the record with respect to a reference is “silent,” as it was here, the Petitioner “must simply ‘show [that] the Office [materially] erred by overlooking something.’” *LG Elecs., supra*, at 15. The Petition did this, and more, by explaining the Examiner’s error in overlooking these references, which disclosed the limitations relied upon to allow the claims.

Ausems: *Ausems* is materially different from *Rensin*. Petitioner cited *Ausems* as “an example of a mobile communications device that, among other things, incorporated a digital camera for *recording, storing, and transmitting* digital images.” (Petition, 24 (*italics added*)). 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, 9-10.) Ausems was thus more relevant to the challenged claims and more applicable to a prior art reference (such as Neibauer) that disclosed the ability of the user to upload photos to a remote server.

McElfresh: McElfresh was materially different from Dowling. PO offers nothing more than block quotes from Dowling without any meaningful analysis, and has made no showing of substantial similarity. Petitioner has attached a copy of Dowling as Exhibit 1030. The Petition cited McElfresh for its disclosure of selecting and delivering advertisements *and* integrating those advertisements alongside other content on the *same webpage*, to satisfy the claimed “**data feed**” limitations. (Petition, 52-53, 57-60.) Dowling, on the other hand, does not state that the promotional information is presented on or integrated into the same webpage as other (non-advertising) content. It appears to disclose the opposite, by stating that when a user drives along a mall, “*a web page comes up and provides directions to the shopping mall.... [and] directions to the desired store.*” (POPR, 13 (quoting Dowling, ¶0064).) The references are thus materially different.

Harvey: PO also does not identify any other reference that is allegedly similar to Harvey. (POPR, 10.) In connection with *other* IPR petitions, PO argued that Harvey was cumulative of Sutherland (which Petitioner addressed), but PO does not renew those arguments here.

Petitioner's Preliminary Reply
IPR2024-00250

Dated: April 22, 2024

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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