UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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UBER TECHNOLOGIES, INC.
Petitioner

v.

ENOVSYS LLC
Patent Owner.

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Case No. IPR2024-00826
U.S. Patent No. 6,441,752

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# ADDITIONAL BRIEFING RELATING TO ILLINOIS LAW IN SUPPORT OF PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 6,441,752 AS REQUESTED BY THE BOARD'S EMAIL OF 9/18/2024

IllinoisLaw is analogous art to the ’752 Patent. While Patent Owner’s Preliminary Response (POPR) argues that IllinoisLaw “is not a technical reference for which a POSITA would have knowledge,” that is not the correct standard by which to assess whether art is analogous. POPR 22. Applying *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1004 (Fed. Cir. 2023), IllinoisLaw is plainly analogous. Both the ’752 Patent’s Proximity Alert Claims and IllinoisLaw are in the same field of endeavor, each directed to solving the problem of identifying potentially abusive tracking. Indeed, as demonstrated by the Petition and accompanying expert declaration of Mr. Andrews, the development of tracking systems and anti-stalking legislation were two sides of the same coin, propelled by the same government initiatives and funding sources. IllinoisLaw is also reasonably pertinent to the problem addressed, because it provides a definition of stalking that can be used to distinguish potentially abusive tracking from other, innocent behaviors.

## I. IllinoisLaw Is In The Same Field of Endeavor As The ’752 Patent

The Petition relies on IllinoisLaw for two grounds against the Proximity Alert Claims of the ’752 Patent.[1] These claims are directed to a “tracking mode” used to detect “concealed or clandestine” tracking, enabling the system to alert a user to the

[1] Three of the Petition’s five grounds do not rely on IllinoisLaw, so whether IllinoisLaw is analogous art is not dispositive of the Petition. Also, IllinoisLaw is only relevant if the claim is narrowly understood as including a “minimum distance” requirement. Pet., 11 n.4. In its POPR, PO does not appear to take this narrow position.

presence of potentially abusive tracking devices. Pet. 1; Ex-1001, Abstract.

The field of endeavor is determined by "reference to explanations of the invention's subject matter in the patent application, including the embodiments, function, and structure of the claimed invention." *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Additionally "it is necessary to consider 'the reality of the circumstances'… in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor," including "weigh[ing] those circumstances from the vantage point of the *common sense* likely to be exerted by one of ordinary skill in the art." *Id*. (emphasis added).

Here, IllinoisLaw is in the same field of endeavor as the '752 Patent's Proximity Alert Claims, because both are directed to solving the problem of identifying abusive tracking activity: (1) clandestine tracking as described by the '752 Patent, and (2) stalking for IllinoisLaw. As explained in the Petition, the '752 Patent includes embodiments directed to a "tracking mode" (Ex-1001, 5:12-17) for determining if a user is being tracked by any other mobile unit (*id.,* 3:16-18). These embodiments address "[a] risk of abuse [that] clearly exists and must be handled appropriately," because "the thought of being tracked by a clandestine unit concealed in an object such as a car or luggage to reveal the location of an individual would be unacceptable by the general public." Ex-1001, 1:60-66. The '752 Patent's field of endeavor thus relates to potential "abuse" caused by unauthorized tracking.

As Mr. Andrews explained, the development of tracking systems to identify unauthorized/criminal activity—such as the potential abuse from clandestine tracking addressed by the '752 Patent—was intertwined with the development of anti-stalking legislation, such as IllinoisLaw, throughout the U.S. during the 1990s. *See, e.g.*, Ex-1002 ¶¶75-93. This intertwined relationship, which arose from government involvement in both areas, and a "heightened public awareness" around the crime of stalking, led tracking system developers to focus on combatting stalking as an application of their systems. *Id*. ¶¶80-87, 90. In view of these circumstances, a common sense place for a POSITA to look for additional information about these activities would have been the resulting laws enacted to curb such abuses.

Mr. Andrews' declaration provides substantial background facts explaining the early, interrelated development of offender tracking systems and anti-stalking legislation. *Id*. ¶¶75-93. In particular, the same government entity that provided funding for the early development of offender tracking systems, as part of a Congressional mandate to "[d]evelop new technologies to fight crime and improve criminal justice"—the National Institute of Justice ("NIJ")—was also "actively involved in projects to address stalking." *Id*. ¶¶80-81 (quoting Ex-1040, 0002), ¶90. Specifically, Congress tasked the NIJ "to develop and distribute among the states a 'constitutional and enforceable' model anti-stalking code," which the NIJ published in October, 1993. *Id*. (quoting Ex-1040, 0005); *see also id*. (describing the NIJ's

preparation of annual reports on stalking and domestic violence that were mandated by the Violence Against Women Act of 1994). As a result, developers of tracking systems who were receiving NIJ funding (and others) focused on stalking as an application of their systems. *Id*. ¶¶80-81 (citing Exs-1034, -1039).

The interrelated nature between the development of tracking systems to address potentially abusive tracking and the development of anti-stalking legislation, as noted by Mr. Andrews, demonstrates the common sense notion that a POSITA would have considered both as addressing the same field of endeavor.

## II. IllinoisLaw Is Reasonably Pertinent To The Problem With Which The Inventor Was Involved

Even if not in the same field of endeavor, IllinoisLaw is also reasonably pertinent to the problem addressed by the Proximity Alert Claims. "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011).

As noted above, these claims are directed to detecting "concealed or clandestine" mobile units that are tracking a wireless consumer. Pet. 1; Ex-1001, Abstract. As the '752 Patent explains, a problem these claims seek to address is distinguishing between mobile units that are actually tracking the wireless consumer,

and units that are merely coincidentally located nearby the consumer. *See, e.g.*, Ex-1001, 5:53-57 (discussing a need to "eliminate the risk of identifying communication units that reside in a fixed geographic boundary over the tracking period," but were not actually tracking the consumer). Indeed, the patent suggests the establishment of some "standard" by which to identify such tracking. *Id*., 5:30-34.

IllinoisLaw is thus pertinent to this problem, because it provides a specific and implementable definition that distinguishes potentially abusive or criminal tracking from mere coincidental following or incidental co-location. Pet. 54. Indeed, the Petition explains that "a POSITA would have included a 'minimum distance' threshold … as taught by IllinoisLaw, because following for a *short* distance might be incidental and innocent." *Id*. at 56 (citing Ex-1002 ¶234). Accordingly, IllinoisLaw "logically would have commended itself" to the inventor's work because it provides a solution to the specific problem the inventor was seeking to address. *Klein,* 647 F.3d at 1348. Moreover, because Layson'757 and Layson'213 are plainly analogous art to the '752 Patent, Petitioner's explanation as to why a POSITA would have been motivated to combine Layson'757-Layson'213 with IllinoisLaw further demonstrates its pertinence the problem being solved. *Corephontonics*, 84 F.4th at 1004 ("the pertinence of the prior art to the problem solved … may be implicit in the petition's discussion of the challenged claims and why a [POSITA] would be motivated to combine the prior art references").

Respectfully Submitted,

*/s/ Ben Haber*
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## CERTIFICATE OF PAGE COUNT

Pursuant to 37 C.F.R. § 42.24(d), Petitioner certifies that this **Additional Briefing Relating to IllinoisLaw In Support Of Petition For *Inter Partes* Review Of U.S. Patent No. 6,441,752 As Requested by the Board's Email of 9/18/2024** complies with the 5-page limit set out in the Board's email of 9/18/2024, exclusive of the table of contents, certificates of service, and page count.

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

I hereby certify that on October 2, 2024, I caused a true and correct copy of the foregoing ADDITIONAL BRIEFING RELATION TO ILLINOIS LAW IN SUPPORT OF PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 6,441,752 AS REQUESTED BY THE BOARD'S EMAIL OF 9/18/2024 to be served electronically on counsel for Patent Owner at the following address:

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