UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC.,
Petitioner,

v.

ENOVSYS LLC,
Patent Owner.

Case IPR2024-00827
Patent 6,756,918

PATENT OWNER ENOVSYS LLC'S SUPPLEMENTAL BRIEF RE ANALOGOUS ART

I. INTRODUCTION

Pursuant to the Board's email dated September 18, 2024, Patent Owner, Enovsys LLC ("Enovsys" or "Patent Owner"), submits this Supplemental Brief in connection with the *Inter Partes* Review petition ("Petition") filed by Uber Technologies, Inc. ("Petitioner") for Claims 1, 2, 15, and 22 of U.S. Patent No. 6,756,918 (the "'918 Patent"). "IllinoisLaw" is not analogous art because it is neither within the field of the inventor's endeavor nor reasonably pertinent to the particular problem to which the challenged patent is directed.

II. LEGAL STANDARD

"Prior art references are applicable to the obviousness inquiry only when they are analogous to the claims being challenged." *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1004 (Fed. Cir. 2023). Two separate tests govern the scope of analogous art: "(1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *Id.* at 1004. "We analyze whether prior art is analogous with 'the foresight of a person of ordinary skill, not with the hindsight of the inventor's successful achievement.'" *Netflix, Inc. v. DivX, LLC*, 80 F.4th 1352, 1358 (Fed. Cir. 2023).

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). To be "reasonably pertinent" to the problem, the reference must "logically [] have commended itself to an inventor's attention in considering his problem." *In re Icon Health and Fitness, Inc.*, 496 F.3d 1374, 1379-80 (Fed. Cir. 2007). The Board must consider the problem faced by the inventor, as reflected in the specification. *See In re Klein*, 641 F.3d 1343 (Fed. Cir. 2011).

III. ARGUMENT

A. <u>Illinois Law Is Not In the Same Field of Endeavor as the Challenged Patent</u>

Petitioner is required to compare IllinoisLaw to the Challenged Patent. *Corephotonics*, 84 F.4th at 1009. The Challenged Patent states that the "invention relates to telecommunication services and systems, specifically such services and systems that convey the location of a mobile unit." Ex-1001 at 1:16-18. Petitioner agrees the Challenged Patent discloses "a communication system consisting of portable mobile units (PRUs) capable of determining and providing their location to a network." Ex-1002 at ¶118. Accordingly, the field of endeavor of the Challenged Patent is indisputably wireless telecommunication systems and services that request and process the position of PRUs.

In stark contrast, IllinoisLaw is self-described by the enacting legislation as "AN ACT in relation to criminal law." Ex-1010 at 0005. IllinoisLaw's field of endeavor, such as it is, is the regulation of criminal conduct. Nothing in IllinoisLaw is remotely relevant to wireless telecommunication systems and services that request and process the position of PRUs. There are no technical disclosures in IllinoisLaw at all. There is absolutely no reason a POSITA (see Ex-1002, ¶25) would consider a criminal statute, that offers nothing technical and has no relationship to telecommunication systems or PRUs, to be within the field of endeavor of the Challenged Patent. Only "with the hindsight of the inventor's successful achievement" would someone consider such an incongruous source.

For at least these reasons, IllinoisLaw is not from the same field of endeavor as the Challenged Patent.

B. <u>Illinois Law Is Not Pertinent to the Challenged Patent's Problem</u>

The Challenged Patent recognizes the "wireless industry is currently gearing towards the provision of a wide range of location-based services to the general public" and that "a need [exists] for a system whereby a remote unit should be able to request for the location of other remote units within a specific geographic area." Ex-1001 at 1:17-19 and 2:59-62. It addresses how to safely and efficiently implement location-based services within such a telecommunication system and to prevent misuse. *See e.g. id.* at 3:53-56, 6:50-61, 7:22-25. Petitioner's

expert acknowledges the specification addresses these problems with claims directed to two different embodiments: "The first embodiment (the "Proximity Alert Embodiment") relates to determining if one or more PRUs are in proximity of another PRU, and have maintained that proximity for some period of time while in motion. The second embodiment, (the "Geographic Boundary Embodiment") relates to specifying a geographic boundary and requesting the location of PRUs within that boundary." Ex-1002, ¶118. Petitioner asserts IlliniosLaw is analogous to the "Proximity Alert" embodiment.

The answer to the question of whether IllinoisLaw is "clearly directed toward the same problem the inventor was trying to solve" is plainly "no." *See Wyers Prods. Grp. Inc. v. Master Lock Co.*, 616 F.3d 1231, 1238 (Fed. Cir. 2010). IllinoisLaw provides no technical solutions to any problem, let alone the specific technical problem of how to determine whether one PRU is being misused to track the location of another PRU within a geographic boundary of a wireless telecommunication network. IllinoisLaw does not solve the problem faced by the inventor relating to a mobile telecommunication system that Petitioner itself described "relates to determining if one or more PRUs are in proximity of another PRU, and have maintained that proximity for some period of time while in motion."

Petitioner attempts to justify its use of IllinoisLaw by arguing that because it is a stalking statute, and Layson'757 and Layson'213 discuss technological techniques directed at the detection of stalking, then there is a motivation to combine the three. *See, e.g.*, Ex-1002 at ¶204. To the extent that Petitioner tries to leverage this motivation to combine arguments into an argument that IllinoisLaw is reasonably pertinent to the problems with which the inventor was involved (which are distinct inquiries), the argument fails. The motivation to combine (which Patent Owner denies is present) is an argument about how IllinoisLaw, Layson'757, and Layson'213 relate to *each other*, not to the Challenged Patent. But the inquiry of whether a prior art reference is analogous art is directed to the relationship it bears to the Challenged Patent, not other asserted prior art. *See Corephotonics*, 84 F.4th at 1007 ("[A] patent challenger cannot meet its burden of proving obviousness merely by arguing that a prior art reference 'is analogous to another prior art reference and not the challenged patent.'")

For these reasons, IllinoisLaw is not reasonably pertinent to the same problem to which the invention of the Challenged Patent is directed.

IV. CONCLUSION

For the foregoing reasons, IllinoisLaw is not analogous art to the Challenged Patent and the Board should deny institution of trial for this additional reason.

Dated: October 2, 2024

Respectfully submitted,

/s/ *Sandeep Seth*
Sandeep Seth (Reg No. 37,537)
SethLaw PLLC
Pennzoil Place
700 Milam Street, Ste. 1300
Houston, TX 77002
Telephone: (713) 244-5017
Facsimile: (713) 244-5018
Email: ss@sethlaw.com

Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

Petitioner has consented to electronic service by email in this proceeding. Pursuant to 37 C.F.R. § 42.6(e)(1), the undersigned certifies that on October 2, 2024, a copy of the foregoing document was served via electronic mail upon the following counsel for Petitioner at the below email addresses:

William M. Fink – tfink@omm.com

Ben Haber – bhaber@omm.com

Frances Mackay – fmackay@omm.com

Argirenia Zervos – rzervos@omm.com

Dated: October 2, 2024

Respectfully submitted,

/s/ *Sandeep Seth*
Sandeep Seth (Reg No. 37,537)
SethLaw PLLC
ss@sethlaw.com

Lead Counsel for Patent Owner