

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

IPR2025-00021
Patent 11,096,039 B2

Before JEFFREY S. SMITH, MIRIAM L. QUINN, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

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

I. INTRODUCTION

Google LLC, Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (“Petitioner”) filed a Petition (Paper 4 (“Pet.”)) requesting *inter partes* review of claims 1–19 (“challenged claims”) of U.S. Patent No. 11,096,039 B2 (Ex. 1001, “the ’039 patent”). Mullen Industries LLC (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any 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.” 35 U.S.C. § 314. We have authority to determine whether to institute review under 37 C.F.R. § 42.4.

Upon consideration of the arguments and the evidence of record at this preliminary stage, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing on at least one of the challenged claims of the ’039 patent. Accordingly, we grant Petitioner’s request and institute an *inter partes* review of all challenged claims of the ’039 patent and with respect to all grounds set forth in the Petition.

II. BACKGROUND

A. *Real Parties-in-Interest*

Petitioner identifies Google LLC, Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. as real parties-in-interest. Pet. xi. Patent Owner names Mullen Industries LLC as the real party-in-interest. Paper 5, 1.

B. Related Matters

Both parties identify, as matters currently involving the '039 patent, *Mullen Industries LLC v. Samsung Electronics America, Inc.; Samsung Electronics Co., Ltd.* No. 2:24-cv-00049-JRG (E.D. Tex., filed Jan 26, 2024).

Petitioner also identifies two terminated proceedings involving the '039 patent: *Mullen Industries LLC v. Apple Inc.*, Case No. 5:23-cv-00437 (N.D.CA.), *Mullen Industries LLC v. Apple Inc.*, Case No. 6:22-cv-00145 (W.D.TX.). Pet. xiii. The '039 patent also was the subject of IPR2023-00096, which was terminated after institution due to settlement. *Apple Inc. v. Mullen Industries LLC*, IPR2023-00096, Paper 17 (PTAB Nov. 7, 2023) (Termination).

C. The '039 Patent

The '039 patent is titled “Systems and Methods for Locating Cellular Phones and Security Measures for the Same.” Ex. 1001, code (54). The '039 patent relates to systems and methods for remotely determining a device’s location. *Id.* at 1:17–20.

The '039 patent describes that a deficiency in current systems is that the location of a device that is determined by Global Positioning System (“GPS”) signals is only minimally utilized. *Id.* at 1:29–31. The patent seeks “to provide systems and methods which better utilize the information about a device’s location.” *Id.* at 1:31–33. More specifically, the patent describes “systems and methods for allowing a user of a cellular phone (e.g., a requesting user or a requester) to locate the position of a different user’s cellular phone (e.g., a requested user) based upon requestor-assigned access rights.” *Id.* at 1:38–43.

According to the '039 patent, the process initiates when a user requests the location of another user's cell phone, and then the process evaluates if the user initiating the location request has the rights to access the location of the desired user. *Id.* at 4:54–57. If no access rights for the requesting user have been granted, the process informs the requesting user that he/she has not been given access to the requested location. *Id.* at 4:57–60. But, if access has been given by a particular user that allows for the requesting user to locate that particular user, the allowed location information is provided, though the process may filter the information and only provide a portion of the available information. *Id.* at 4:66–5:4.

An example of a screen displaying location information is shown in Figure 6, reproduced below.

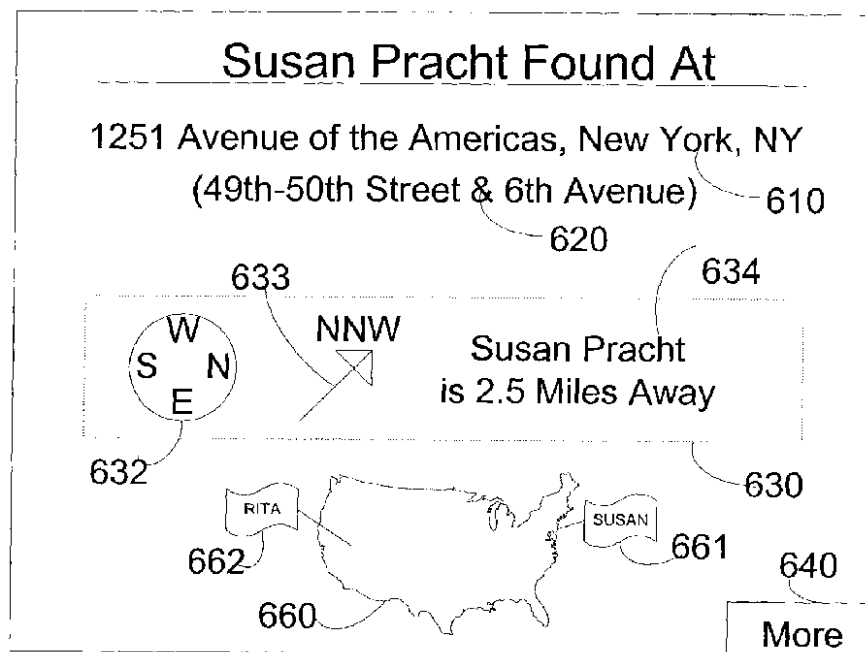


Figure 6, above, shows primary location information 610, as well as secondary location information 620 to supplement the requested user's exact location, directional information 630, distance information 634, map 660,

and the location of other users Rita and Susan, at 661 and 662. *Id.* at 7:31–8:12, Fig. 6.

The '039 patent also describes a login feature in which a user profile is stored remotely. *Id.* at 9:53–57. In accordance with the '039 patent, a display screen is provided for a user to log into a device. *Id.* at 9:60–62. The '039 patent states that logging into a device also adds a level of security, especially when combined with a password. *Id.* at 9:62–64.

D. Illustrative Claim

Petitioner challenges claims 1–19 of the '039 patent. Pet. 1. Claims 1 and 2 are the only independent claims. Independent claim 1, reproduced below, is illustrative of the claimed subject matter.

1. [1PRE]¹ A system comprising:

[1A] a remote system, [1B] wherein user information is operable to be identified from a plurality of different user information by receiving at least a manually entered login from a first wireless device associated with said user information and a manually entered password associated with said login, [1C] a location of said first wireless device is operable to be recorded on said remote system after said user information has been identified on said first wireless device and said location is associated with said user information and provided by said first wireless device to said remote server, [1D] a location-based event is operable to be provided based, at least in part, on said location of said first wireless device, wherein said location-based event is operable to be manually pre-selected from a list of at least three types of location-based events on a device, [1E] a location-based event notification is operable to be provided on said device as a result of, at least in part, location access rights of said device

¹ Petitioner's designations to reference the elements of claim 1 are set forth in brackets. Pet. 10–26. Herein we refer to the elements of claim 1 using Petitioner's designations.

from said first wireless device, [1F] wherein a first one of said at least three types of location-based events is, at least in part, region-based, and a second one of said at least three types of location-based events is, at least in part, distance-based.

Ex. 1001, 13:15–39.

E. Evidence

Petitioner relies on the patent references summarized in the table below.

Name	Reference	Exhibit
Sheha	US 7,333,820 B2, filed July 11, 2002, issued Feb. 19, 2008	1005
Degnbol	WO 00/22860, published Apr. 20, 2000	1035
McNulty	US 7,146,407 B2, issued Dec. 5, 2006	1040
Tobin	US 2003/0074209 A1, published Apr. 17, 2003	1041
McDonnell	US 6,813,499 B2, issued Nov. 2, 2004	1042
Obradovich	US 6,133,853, issued Oct. 17, 2000	1043
Randall	US 2004/0024846 A1, filed Aug. 22, 2001, published Feb. 5, 2004	1007 ²
De Vries	US 6,968,279 B1, issued Nov. 22, 2005	1013

Petitioner also relies on the Declaration of Mr. David H. Williams (Ex. 1003) to support its contentions that the challenged claims are unpatentable.

F. Asserted Grounds

Petitioner asserts that the challenged claims of the '039 patent are unpatentable based on the following grounds summarized in the table below (Pet. 2):

² Exhibit 1007 is a U.S. national stage application of the PCT application in Exhibit 1008.

Claim(s) Challenged	35 U.S.C. §³	References/Basis	Ground name
1–6, 13	103(a)	Sheha, Degnbol, McNulty	1
7–9, 19	103(a)	Sheha, Degnbol, McNulty, Tobin	2
10–12	103(a)	Sheha, Degnbol, McNulty, McDonnell	3
14–18	103(a)	Sheha, Degnbol, McNulty, McDonnell, Obradovich	4
1–8, 10–19	103(a)	Randall, De Vries	5
9	103(a)	Randall, De Vries, Tobin	6

III. ANALYSIS

A. Discretionary Denial Under 35 U.S.C. § 314(a); Parallel District Court Litigation

Under 35 U.S.C. § 314(a), institution of *inter partes* review is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016); *see also* 35 U.S.C. § 314(a). In *Amazon Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), the Board set forth six non-exclusive factors for determining “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* at 6. These factors are as follows:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the challenged claims of the ’039 patent have an apparent effective filing date before March 16, 2013, the pre-AIA version of § 103 applies.

2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Id. at 5–6. In evaluating these factors, we take a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review. *Id.* at 6.

1. *Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted*

Patent Owner contends that “all evidence points to a stay not being entered in the district court pre- or post-institution” because Judge Gilstrap “has already denied Petitioner Samsung’s request to stay the parallel district court case pre-institution” and “has ordered that Samsung may not refile any request for a district court stay until *after* ‘the PTAB’s institution decision on the last of the pending IPRs.’”⁴ Prelim. Resp. 21.

Given that the district court denied Samsung’s motion to stay “**WITHOUT PREJUDICE** to refiling of the same within fourteen (14) days following the PTAB’s institution decision on the last of the pending

⁴ From September 30, 2024 through December 30, 2024, Petitioner filed or co-filed with Google LLC eleven *inter partes* review petitions challenging all claims of the patents asserted in the parallel district court litigation. *See* Ex. 2008, 2 n.2.

IPRs” (Ex. 2008, 3), we decline to speculate whether the district court will grant a stay. Thus, we find that factor 1 is neutral.

2. Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision

Patent Owner contends that the “district court trial is set for November 3, 2025, which is more than six months before the earliest expected date of a FWD (mid-May 2026) in this Petition.” Prelim. Resp. 24.

Petitioner contends that a “motion is pending to transfer the district-court proceeding to the Northern District of California (Ex[.] 1036[,] 8).” Pet. 73. However, on March 25, 2025, the District Court denied the motion to transfer. Ex. 2026. Thus, we find that factor 2 weighs in favor of exercising discretion.

3. Investment in the parallel proceeding by the court and the parties

Patent Owner contends that the parties “have prepared and exchanged infringement and validity contentions, presented initial disclosures,” have begun claim construction discovery and fact discovery, and will brief claim construction by the time the Board decides whether to institute. Prelim. Resp. 26. Patent Owner contends that “Petitioners waited over eight months after the district court complaint was filed to submit [the Petition].” *Id.* at 27.

Petitioner contends that the “parties have invested little in invalidity-related issues, the scheduled *Markman* hearing is over seven months away (Ex[.] 1038[,] 3), and ‘a significant portion of work remains to be done’ including ‘fact and expert discovery and dispositive motions.’” Pet. 74. Petitioner contends that “Petitioner filed this Petition less than five months after receiving Mullen’s infringement contentions and about four months before any statutory bar.” *Id.*

We agree with Petitioner that much work remains in the district court case as it relates to invalidity because discovery is in its early stages and a *Markman* hearing has not yet occurred. Petitioner filed the Petition eight months after Patent Owner filed its complaint in district court. Prelim. Resp. 27. The instant Petition largely copies from previously filed petitions. Although the filing of the Petition does not seem diligent, the timing overall does not outweigh the limited investment in the district court litigation. Thus, we determine that this factor is neutral.

*4. Overlap between issues raised
in the petition and in the parallel proceeding*

Patent Owner contends that “Petitioners challenge most of the ***same*** claims in their Petition . . . that they do in their invalidity contentions at the district court” and “rely on the same references in the Petition as they do in the district court.” Prelim. Resp. 31. Additionally, we note that the defendant’s invalidity contentions include system prior art and other invalidity defenses rooted on lack of written description, indefiniteness, enablement, and obviousness-type double patenting that cannot be asserted in an IPR. Ex. 2014, 116–119, 125–129.

Petitioner “stipulates that, if the [PTAB] . . . institutes this IPR petition on the grounds presented therein, then Samsung will not pursue in the [parallel district court] litigation any grounds that were raised or reasonably could have been raised in the IPR.” Ex. 1079; *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020).

We find that Petitioner’s stipulation mitigates some, but not all of the concerns of overlap, and weighs against exercising discretionary denial.

*5. Whether the petitioner and the defendant
in the parallel proceeding are the same party*

Patent Owner contends that the parties to this proceeding are the same parties in the parallel district court litigation. Prelim. Resp. 28–30. We disagree. Although Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Mullen Industries LLC are parties in both proceedings, Google LLC is a party in this case but not in the district court litigation. Because of the involvement of a non-defendant, even if a named real party in interest in this proceeding, we find that this factor is neutral.

*6. Other circumstances that impact the
Board’s exercise of discretion, including the merits*

Patent Owner contends that “the Petition (i) strategically chose not to address known disputes over the claim terms’ meaning and (ii) misreads both the claims and the cited references, which demonstrates the weakness of the Petition.” Prelim. Resp. 31.

We disagree. The issues raised by Petitioner are similar, if not identical, to those raised in IPR2023-00096, in which we instituted. We also disagree, on this record, that Petitioner misreads the claims and the cited references, as discussed below in both our claim construction and our analyses of Petitioner’s grounds of obviousness based on the primary references of Sheha and Randall. Patent Owner’s arguments on the merits rely extensively on Patent Owner’s proposed construction of “location access rights of said device from said first wireless device” and the similar recitation in independent claim 2. We disagree with Patent Owner’s proposed construction and with Patent Owner’s corresponding arguments on the merits relying on the proposed construction. As discussed in detail below, at this stage of the proceeding, we find that Petitioner has shown that at least some claims of the ’039 patent recite well-known and obvious

features of remotely locating a first wireless device. Due to strong merits, this factor weighs against exercising discretionary denial.

7. Conclusion

Having considered the factors above, including the timing of the proceedings, the amount of effort that has been and is yet to be expended in the parallel district court litigation, Petitioner's *Sotera* stipulation, and the merits of Petitioner's challenges, we find that, taken as a whole, the factors do not favor exercising discretion to deny institution. Although the earlier trial date weighs in favor of discretionary denial, the remaining factors are either neutral or weight against discretionary denial. Accordingly, we decline to exercise discretion to deny institution.

B. Level of Ordinary Skill in the Art

Petitioner asserts that a person of ordinary skill in the art “would have had a bachelor's degree in computer science, computer engineering, electrical engineering, or a similar degree, with one or two years of experience with wireless networks and devices, such as cellphones and personal digital assistants (‘PDAs’), as well as wireless positioning technologies, such as GPS or triangulation,” and that “[m]ore education could compensate for less practical experience, and vice versa.” Pet. 4 (citing Ex. 1003 ¶¶ 50–54). Petitioner further contends that “[m]ore education could compensate for less practical experience, and vice versa.” *Id.* Patent Owner does not propose a level of ordinary skill.

The level of ordinary skill in the art usually is evidenced by the references themselves. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978). As Petitioner's description of a

person of ordinary skill appears commensurate with the subject matter before us, we apply Petitioner's definition for purposes of this Decision.

C. Claim Construction

We interpret the challenged claims

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), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.

37 C.F.R. § 42.100(b). Under this standard, the words of a claim generally are given their "ordinary and customary meaning," which is the meaning the term would have had to a person of ordinary skill at the time of the invention, in the context of the entire patent including the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc). "In determining the meaning of [a] disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence." *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006).

Petitioner does not propose construction of any term. Pet. 5–6. Patent Owner proposes a construction for "location access rights of said device from said first wireless device" recite in claim 1 and the similar recitation of "access rights are operable to be obtained for said device that are associated with accessing said location information of said first wireless device" in claim 2. Prelim. Resp. 6–17.

Patent Owner contends that Petitioner ignores the claim language that requires "the 'location access rights' to be provided '*from*' a specific

device” recited in claim 1. *Id.* at 7. Patent Owner further contends that Petitioner incorrectly argues “that ‘location access rights’ ‘*of*’ or for the specific device” recited in claim 1 can be satisfied when a group policy allows the device to access location information, because under the plain claim language the rights are of a specific device. *Id.* According to Patent Owner, Petitioner improperly rewrites this claim term as “a policy that may result in allowing said device to access location information about said first wireless device.” *Id.* (emphasis omitted).

Patent Owner contends that a group policy that allows a group to access location information may be an empty set, or the group members may change over time. Prelim. Resp. 8. According to Patent Owner, the group policy imposes risk of erroneously allowing or disallowing access to location information, because a user may forget that the group is allowed access when adding a member to the group, or a user may forget that a member was deleted from the group. *Id.* Patent Owner contends that the ’039 patent recognizes this risk in describing that “[o]ne object of the present invention is to provide a security feature which allows a user to limit and/or deny location access to a particular user.” *Id.* at 8–9 (citing Ex. 1001, 1:44-46). Patent Owner provides additional arguments to support its contention that the claimed “location access rights,” read in light of the Specification, excludes a group permission. *Id.* at 9–14.

We disagree with Patent Owner on this record. The language of claim 1 recites “location access rights of said device from said first wireless device.” The claim language does not limit the location access rights to be of only the one other device, at the exclusion of other devices. The ordinary and customary meaning of “location access rights of said device from said

first wireless device” encompasses rights that allow other devices, in addition to the recited device, to access location information.

The disclosure in the written description is consistent with the ordinary and customary meaning. Although the written description states that an object of the invention is to provide a security feature which allows a user to limit or deny access to a particular user, the written description discusses other purposes served by the assignment of access rights. For example, the written description discloses that “[u]sers may be added, individually or in groups, to a list of users with location access rights to a specific user by that specific user. A specific user may, at any time, modify, delete, or add users allowed to access his or her location.” Ex. 1001, 3:22-26. The written description further discloses that “a user may organize his/her user list into groups and assign access rights to that group (e.g., family member user group, close friend user group).” *Id.* at 13:9–12.

The fact that the written description of the ’039 patent sets forth multiple objectives to be served by the access rights confirms that these terms should not be construed as limited to a single device. *Phillips*, 415 F.3d at 1327. Further, because the written description here includes an embodiment where a user assigns access rights to a group, we are persuaded that the scope of the disputed claim terms encompasses a group permission. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) (holding that interpreting a claim to exclude an embodiment disclosed in the written description “is rarely, if ever, correct and would require highly persuasive evidentiary support, which is wholly absent in this case.”).

At this stage, we interpret the scope of the “location access rights of said device from said first wireless device” to encompass at least the

disclosed embodiment of assigning access rights to a group. Ex. 1001, 13:9–12.

D. Asserted Obviousness — Sheha Grounds

Petitioner asserts that (1) claims 1–6 and 13 are unpatentable as obvious over Sheha, Degnbol, and McNulty; (2) claims 7–9 and 19 are unpatentable as obvious over Sheha, Degnbol, McNulty, and Tobin; (3) claims 10–12 are unpatentable as obvious over Sheha, Degnbol, McNulty, and McDonnell; and (4) claims 14–18 are unpatentable as obvious over Sheha, Degnbol, McNulty, and McDonnell, and Obradovich. Pet. 5–41. Patent Owner disputes whether “location access rights of said device from said first wireless device” in claim 1, or “access rights are operable to be obtained for said device that are associated with accessing said location information of said first wireless device” in claim 2, are disclosed. Prelim. Resp. 41–55.

We begin with an overview of Sheha, Degnbol, and McNulty. We then turn to the parties’ arguments.

1. Sheha (Exhibit 1005)

Sheha is titled “System and Method for Providing Routing, Mapping, and Relative Position Information to Users of a Communication Network.” Ex. 1005, code (54). Sheha states that it is directed to a system and method for providing real-time position information of one party to another party. *Id.* at code (57). Figure 3, reproduced below, illustrates telephone and computing devices for establishing a mobile-to-mobile connection. *Id.* at 6:45–47.

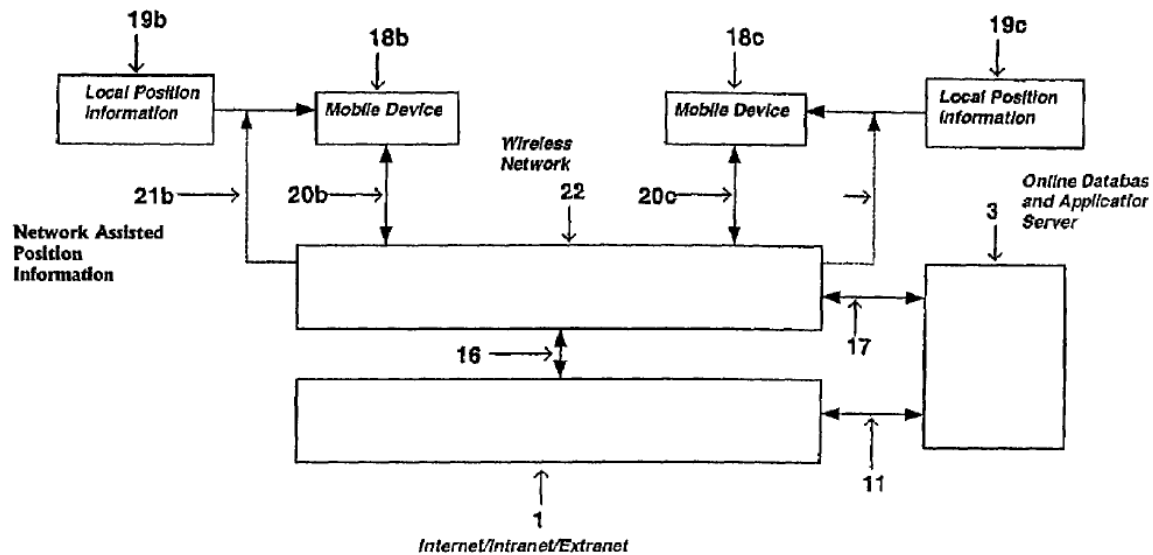


Figure 3, above, illustrates mobile devices 18b, 18c, wireless network 22, and online database and application server (ODAS) 3 for establishing mobile-to-mobile connections. *Id.* at 10:66–11:15.

Mobile devices 18b, 18c include onboard position information devices 19b, 19c, respectively. *Id.* at 11:15–17. Information is transferred to wireless network 22 via wireless connections 20b, 20c, respectively. *Id.* at 11:10–15. ODAS 3 stores telephone and address information. *Id.* at 7:51–55. Telephone account users have a username and password for ODAS 3. *Id.* at 8:40–46. Prior to the destination mobile device 18c receiving the telephone call from the originating mobile device 18b, wireless network 22 sends the position information, obtained from the ODAS 3, in the form of a Map Caller-ID. *Id.* at 11:38–42.

2. Degnbol (Exhibit 1035)

Degnbol is titled “A Method and a System for Transmitting Data Between Units.” Ex. 1035, code (54). Degnbol relates to a method and a system for automatic notification of a user A of the entry of pre-selected user B into a pre-determined area (or proximity to a particular location). *Id.*

at 9. Each of user A and user B carries a communications device such as a data-enabled cellular phone or a pager, the position of which is known to a wireless network. *Id.* at 9, 20. The location of user B is determined by reference to the position of the communications device. *Id.* at 9.

Degnbol describes a “Buddy List,” which is a list of other users whose location and/or movements the user wishes to be notified of. *Id.* Preferences for each user “can be configured on an individual Buddy basis or as overall preferences comprising all Buddies on the personal Buddy List.” *Id.* at 10. Degnbol describes that preferences can be configured directly from the handset of the user’s cellular phone. *Id.* at 11.

3. McNulty (*Exhibit 1040*)

McNulty is titled “Data Synchronization Mechanism for Information Browsing Systems.” Ex. 1040, code (54). McNulty relates to organizing information for access by two or more information browsing devices. *Id.* at 1:6–9.

In McNulty, “a user of a base system such as a desktop computer system, organizes information stored on a server system for subsequent access by the user through a mobile device such as a wireless telephone.” *Id.* at 2:19–23. When accessing the information through the mobile device, the server system provides a list of one or more data objects representing information previously gathered by the user, which can be accessed on the mobile device with a single user-interface gesture, for example, by pressing a single key of a numeric keypad on the mobile device. *Id.* at 2:39–44.

McNulty describes that upon initial contact with mobile system interface 210, the user is authenticated through wireless telephone 110. *Id.* at 3:46–47; 11:14–15. In accordance with McNulty’s authentication

transaction, the user enters the telephone number of wireless telephone 110 using keypad 1002 and conventional user interface techniques. *Id.* at 11:19, 11:34–44. McNulty describes that the information is “manually entered.” *Id.* at 11:54–59. McNulty also describes that the user completes authentication by supplying an associated password. *Id.* at 11:60–62.

McNulty describes allowing a user to invoke an action, such as locating nearby places. *Id.* at 13:34–42. Examples of displays resulting from invoking an action are shown in Figures 24 and 25, reproduced below.

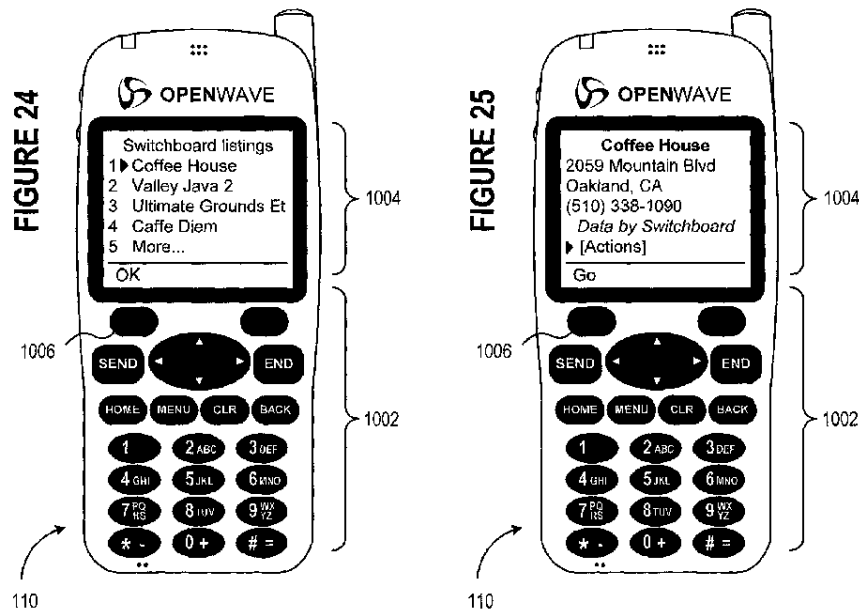


Figure 24 illustrates that a user is presented with the first four nearby coffee shops, which are sorted by proximity to the user, and an option to see more nearby coffee shops. *Id.* at 16:44–48. Upon selecting the first coffee shop, information describing that coffee shop is displayed, as shown in Figure 25. *Id.* at 16:48–51.

4. Independent Claim 1

a) The Preamble and Elements [1A] through [1C]

The preamble of claim 1 and elements [1A] through [1C] are below.

1. [1PRE] A system comprising:

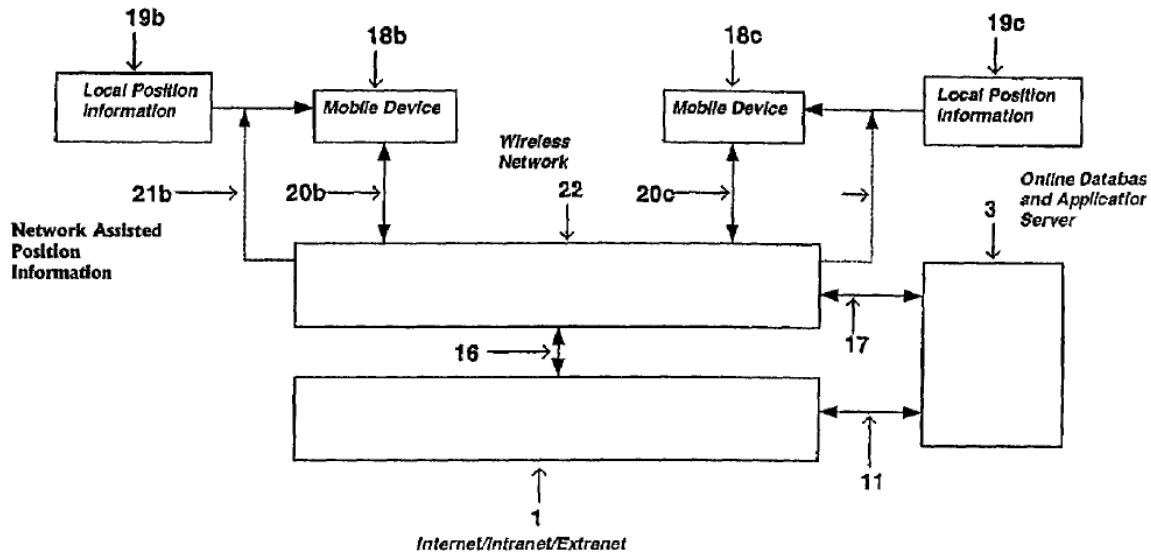
[1A] a remote system, [1B] wherein user information is operable to be identified from a plurality of different user information by receiving at least a manually entered login from a first wireless device associated with said user information and a manually entered password associated with said login, [1C] a location of said first wireless device is operable to be recorded on said remote system after said user information has been identified on said first wireless device and said location is associated with said user information and provided by said first wireless device to said remote server.

Ex. 1001, 13:15–27.

Petitioner relies on Sheha for teaching or suggesting a system comprising a remote system that receives a manually entered login from a first wireless device and records the location of the first wireless device, recited in the preamble and elements [1A] through [1C]. Pet. 10–15 (citing, e.g., Ex. 1005, code (57), 2:25–29, 4:66–5:2, 5:26–29, 6:57–59, 7:20–23, 8:31–53, 9:50–10:6, 10:48–50, 11:3–8, 11:15–27, 11:55–12:7, 13:17–21, 21:4–6, 22:1–8, Fig. 3). Petitioner relies on McNulty for teaching or suggesting manual entry of user information, such as a login, recited in element [1B]. Pet. 11 (citing e.g., Ex. 1040, 11:54–59, Fig. 10B). Petitioner argues manual entry would have been known to be “typical,” “predictable,” and would have been incorporated into the Sheha, Degnbol, McNulty combination to “enhance” the system and “in order to more effectively provide location data.” Pet. 11, 18–19 (citing, e.g., Ex. 1003 ¶¶ 115–119, 133–134).

Figure 3 of Sheha illustrates a system for establishing a mobile-to-mobile connection (Ex. 1005, 6:45–47) in which “every telephone account user has a username and password for the ODAS 3” (*id.* at 8:40–42) and the

user signs-on to ODAS 3 “using authentication and authorization protocols” (*id.* at 8:42–46).



In the system shown in Figure 3, above, position information of each of mobile devices 18b, 18c is updated in ODAS 3 prior to establishing a telephone call. *Id.* at 10:66–11:15. With respect to element [1B] and Sheha’s teaching that “every telephone account user has a username and password for the ODAS 3” (*id.* at 8:40–42), McNulty further describes that “[i]n another alternative embodiment, the user is identified according to the address of wireless telephone 110, *whether manually entered as described above with respect to FIG. 10B or automatically.*” Ex. 1040, 11:54–59, Fig. 10B.

Based on the evidence and arguments currently of record, we find that Petitioner demonstrates sufficiently for purposes of institution that the Sheha, Degnbol, and McNulty combination teaches the features recited in the preamble and claim elements [1A] through [1C] and Petitioner provides sufficient rationale to make its proposed combination.

b) Elements [1D] through [1F]

Elements [1D] through [1F] are below.

[1D] a location-based event is operable to be provided based, at least in part, on said location of said first wireless device, wherein said location-based event is operable to be manually pre-selected from a list of at least three types of location-based events on a device, [1E] a location-based event notification is operable to be provided on said device as a result of, at least in part, location access rights of said device from said first wireless device, [1F] wherein a first one of said at least three types of location-based events is, at least in part, region-based, and a second one of said at least three types of location-based events is, at least in part, distance-based.

Ex. 1001, 13:27–39.

Petitioner relies on Degnbol for teaching or suggesting at least three types of location-based events recited in element [1D]. Pet. 16–18 (citing e.g., Ex. 1035, code (57), 1:7–13, 3:11–15, 3:23–27, 6:1–8, 6:10–17, 9:32–10:3, 10:17–11:3, 11:5–8, 12:4–6, 12:10–12, 13:17–21, 18:5–8, 19:1–3, 21:5–6). Petitioner, more specifically, argues that Degnbol describes more than three different types of location-based events, including whether the buddy (i.e., first wireless device) (1) is in a certain geographic area, (2) is within a certain distance of the device, (3) is in the same continent, (4) is in the same country, (5) is in the same district, (6) is within a coordinate range, (7) on a street, and (8) whether the user has been the subject of an alert to another user. Pet. 17; Ex. 1003 ¶ 132. Petitioner relies on McNulty’s teachings discussed above with respect to element [1B] for teaching or suggesting manually selecting items from a list on a device recited in element [1D]. *Id.* at 18 (citing, e.g., Ex. 1040, 11:54–59, 16:44–56, Figs. 24, 25). Petitioner further relies on Degnbol for teaching or suggesting that the

location-based events are based on region and distance, recited in element [1F]. *Id.* at 25–26 (citing, e.g., Ex. 1035, 6:6–8, 6:10–17, 8:18–20, 8:22–29, 10:31–33, 11:5–11, 13:19–20, 22:1–6).

Regarding elements [1D] and [1F], Degnbol describes “a method and a system for automatic notification of a user ‘A’ of the entry of pre-selected user ‘B’ into a pre-determined area for proximity to a particular location” depending “on a successful match of user specified parameters. Ex. 1035, 1:7–11. Degnbol describes the pre-determined area as a “predetermined range” that is “selected by the user” and “may have associated communication expenses” that may be dependent on “distance” or, alternatively, the “predetermined range” “may be associated with a geographic area, such as a continent, country, district, city, co-ordinate range or a street.” *Id.* at 6:1–8, 6:10–17.

For element [1E], Petitioner relies on the combination of Sheha and Degnbol. Petitioner also relies on Degnbol for teaching or suggesting providing notification of a location-based event, recited in element 1[E]. Pet. 24–25 (citing, e.g., Ex. 1035, 1:11–13, 5:16–20, 10:17–18, 11:13–14, 11:16–18, 12:4–8, 14:4–6, 20:23–32, 21:23–29, 22:1–8). Petitioner relies on Sheha for teaching or suggesting another device being given by the first wireless device rights to access its location, recited in element [1E]. *Id.* at 21 (Ex. 1005, 3:4–14, 3:22–28, 4:8–18, 4:59–5:46, 8:42–53, 9:59–10:4, 10:17–26, 11:55–12:7, 13:65–14:2, 14:54–61, 18:45–19:46). Petitioner alternatively relies on Degnbol for teaching or suggesting providing notification of a location-based event that is “operable to be provided on said device as a result of, at least in part, location access rights of said device from said first wireless device.” Pet. 24–25 (citing, e.g., Ex. 1035, 1:11–13,

5:16–20, 10:17–18, 11:13–14, 11:16–18, 12:4–8, 14:4–6, 20:23–32, 21:23–29, 22:1–8).

The parties’ dispute centers on element [1E] and the requirement that notification is provided “as a result of, at least in part, location access rights of said device from said first wireless device.” With respect to that requirement, Sheha describes that “users . . . define a group of specific users” that have access to their mobile’s position information and then the system uses “a group database and authorization and authentication protocols to identify users that are permitted” access to the location of the mobile device. Ex. 1005, 11:55–12:7.

Patent Owner disputes Petitioner’s reliance on Sheha for teaching or suggesting “location access rights of said device from said first wireless device” recited in element [1E]. Prelim. Resp. 41–53. Patent Owner makes four arguments as follows: (1) Sheha’s privacy/permission settings are for the most part limited to time period restrictions and “are *not* ‘location access rights,’ are *not* provided ‘from’ the mobile device, and are *not* ‘of’ or for another specified device;” (2) Sheha’s disclosures “regarding ‘groups’” are in the context only “of ‘landline-to-landline’ requests” and are irrelevant as they do not pertain to the location of a wireless device; (3) Sheha’s disclosures “regarding ‘groups’” are “not ‘location access rights’ ‘of’ or for a specific device to access location information” as required by Patent Owner’s proposed construction of “location access rights of said device from said first wireless device;” and (4) Petitioner’s obviousness arguments are based on “hindsight.” *Id.* We address each of Patent Owner’s arguments in turn.

Regarding Patent Owner's first argument that Sheha's privacy/permission settings are for the most part limited to time period restrictions and "are *not* 'location access rights,' are *not* provided 'from' the mobile device, and are *not* 'of' or for another specified device" (*id.* at 43–46), Petitioner relies on different disclosures in Sheha. As set forth above, Petitioner, instead, relies on Sheha's disclosures relating to users defining "a group of specific users that have access" to the mobile's position information. *See, e.g.,* Pet. 21 (citing, *e.g.,* Ex. 1005, 11:55–12:7). Based on this preliminary record, we find that Sheha's description of privacy/permission settings with time period restrictions does not undermine that Sheha discloses privacy-permission settings relating to defining a group of users with access to location information.

Regarding Patent Owner's second argument that Sheha's disclosures "regarding 'groups'" are in the context only "of 'landline-to-landline' requests" and are irrelevant as they do not pertain to the location of a wireless device (Prelim. Resp. 46–47), based on this record, we disagree. We find based on this preliminary record that Sheha discloses that location information for both landline phones and mobile phones is stored in the ODAS, and that a mobile device can request the location of either a landline phone or a mobile phone. Ex. 1005, 11:55–12:7 (describing that "users can define a group of specific users" that have access to position information and "using the authorization and authentication protocols a user can request the position of a mobile device, similarly to requesting the position of a landline device").

Regarding Patent Owner's third argument that Sheha's disclosures "regarding 'groups'" are "not 'location access rights' 'of' or for a specific

device to access location information” as required by Patent Owner’s proposed construction of “location access rights of said device from said first wireless device” (Prelim. Resp. 47), based on this record, we disagree. As discussed above, we are not persuaded to adopt Patent Owner’s construction of “location access rights of said device from said first wireless device” based on the current record. *See* § III.C.

Regarding Patent Owner’s fourth argument that Petitioner’s obviousness arguments are based on “hindsight” (Prelim. Resp. 47), based on this record, we disagree. Instead, we agree with Petitioner that even if Sheha did not explicitly disclose using the group database permissions in mobile-to-mobile embodiments, a person of ordinary skill in the art would have done so because it would have allowed a mobile user to specify a group of other mobile users to have access to the user’s location (or to provide access on an individual-user basis). Pet. 23–24. Petitioner’s argument and evidence at this juncture shows that such a technique “was well-known as a beneficial option with reasonable expectation of success in a system like Sheha’s.” Pet. 23–24 (citing Ex. 1007 ¶¶ 52–70, 136, 144–148; Ex. 1003 ¶¶ 107–110).

We, therefore, find on the current record that Petitioner shows sufficiently that Sheha alone teaches that the notification is provided “as a result of, at least in part, location access rights of said device from said first wireless device” as recited in element [1E]. For the reasons given above, we find Patent Owner’s arguments do not undermine Petitioner’s showing.

For completeness, we turn to Petitioner’s alternative argument that Degnbol teaches or suggests providing notification of a location-based event that is “operable to be provided on said device as a result of, at least in part,

location access rights of said device from said first wireless device.” Pet. 24–25 (citing, e.g., Ex. 1035, 1:11–13, 5:16–20, 10:17–18, 11:13–14, 11:16–18, 12:4–8, 14:4–6, 20:23–32, 21:23–29, 22:1–8). Degnbol describes the following:

[B]oth User A and User B represent ‘subscribers’ to the system. As such, each has previously provided profile information to the system, now stored in the system database. User’s A profile includes a desire to be alerted when User B is in his vicinity; User’s B profile includes a permission to notify User A of his whereabouts.

Ex. 1035, 20:24–28; *see also id.* at 21:23–29 (describing a database that “includes permission information that determines whether other users may be notified of the user’s activity”).

Regarding Petitioner’s alternative argument, Patent Owner argues the following:

Rather, Degnbol instead states that determining who is part of a user’s “Buddy List” is “carried out vial other channels, for example through a web-based interface or by calling a customer service representative at a call-center.” Ex. 1035 at 5:28–31. Second, Degnbol also does not teach or suggest “location access rights” are “of” or for a specific device. Rather, like Sheha, Degnbol instead states that any permissions are based on a user’s “group[ing] Buddies into different categories, i.e., ‘Friends’, ‘Relatives’, and sub-categories such as ‘Bowling Friends’, ‘Friends from work’, ‘Best Friends’, etc.” *Id.* at 10:5–11.

Prelim. Resp. 48.

Regarding Patent Owner’s first argument, Degnbol describes that “[t]he Buddy List may be altered by the user at will, adding or deleting buddies and setting various preferences.” Ex. 1035, 9:33–10:1. Degnbol further describes that “[t]his can be done in several ways; e.g. *directly from the handset of the users cellular phone*, using a web-based interface, or by

calling an operator at a call center.” *Id.* at 10:1–3 (emphasis added). Based on this preliminary record, we find that Degnbol’s description of using a web-based interface or by calling an operator at a call center does not undermine that Sheha discloses setting Buddy List preferences “directly from the handset of the users cellular phone.” *Id.*

Regarding Patent Owner’s second argument that Degnbol “does not teach or suggest ‘location access rights’ are ‘of’ or for a specific device,” but, “instead states that any permissions are based on a user’s ‘group[ing] Buddies into different categories’” (Prelim. Resp. 48), we disagree. As discussed above, we are not persuaded to adopt Patent Owner’s construction of “location access rights of said device from said first wireless device” based on the current record. *See* § III.C.

Accordingly, we find that Degnbol provides additional evidence supporting Petitioner’s position that the combination of Sheha and Degnbol teaches “location access rights of said device from said wireless device” recited in element [1E]. We find on the current record that Patent Owner’s arguments do not undermine Petitioner’s showing.

Petitioner argues that a person of ordinary skill in the art would have made Petitioner’s proposed combination of “Degnbol’s disclosure of both selection of location-based events and manual entry using the handset of the phone with Sheha, to improve user ease, given that such techniques were well-known and conventional to POSAs at the time of alleged invention.” Pet. 18 (citing Ex. 1003 ¶ 132). Degnbol describes that “[i]t is an advantage of the present invention that user ‘A’ can be alerted when user ‘B’ arrives or leaves the defined location(s) or area(s)” so as “to enable user ‘A’ to know in advance the proximity or approximate whereabouts of user ‘B’ before

possibly acting upon this information by contacting user ‘B’ — or allowing ‘B’ to contact ‘A.’” Ex. 1035, 3:23–27. At this preliminary stage, we find that Petitioner provides sufficient rationale to combine the teachings of Sheha, Degnbol, and McNulty for purposes of institution.

Based on the evidence and arguments currently of record, we find that Petitioner demonstrates sufficiently for purposes of institution that the Sheha, Degnbol, and McNulty combination teaches the features recited in claim elements [1D] through [1F] and Petitioner provides sufficient rationale to make its proposed combination. We find that Patent Owner’s arguments do not undermine Petitioner’s showing.

c) Conclusion—Claim 1

After consideration of the arguments and the evidence of record at this early stage, we determine that Petitioner has shown sufficiently, for purposes of institution, that the combination of Sheha, Degnbol, and McNulty teaches or suggests all recitations in claim 1. Also, we find that Petitioner provides sufficient rationale to combine the teachings of Sheha, Degnbol, and McNulty for purposes of institution. We find that Patent Owner’s arguments do not undermine Petitioner’s showing.

Based on the record at this preliminary stage, we conclude that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that claim 1 is unpatentable under 35 U.S.C. § 103 as obvious over the combination of Sheha, Degnbol, and McNulty.

5. Independent Claim 2

Petitioner relies, for the most part, on its contentions with respect to claim 1 for how the combination of Sheha, Degnbol, and McNulty discloses the subject matter of independent claim 2. *See* Pet. 26–28. Patent Owner

relies on the arguments directed to independent claim 1, which we addressed above in connection with our analysis of claim 1 under Ground 1. *See* Prelim. Resp. 53–55 (referencing that the arguments made for claim 1 apply to a similar limitation in claim 2).

Based on our analysis of claim 1, and review of Petitioner’s additional contentions and corresponding evidence directed to claim 2, we determine that Petitioner demonstrates a reasonable likelihood that independent claim 2 is unpatentable over Sheha, Degnbol, and McNulty.

6. *Dependent Claims 3–6 and 13*

Petitioner contends that claims 3–6 and 13 are unpatentable over Sheha, Degnbol, and McNulty. Pet. 28–31. Patent Owner does not offer any specific arguments with respect to these claims. *See* Prelim. Resp. Based on the record before us, we are persuaded that the Petition sufficiently shows that claims 3–6 and 13 are unpatentable over Sheha, Degnbol, and McNulty.

7. *Dependent Claims 7–12 and 14–19*

Petitioner asserts that (1) claims 7–9 and 19 are unpatentable as obvious over Sheha, Degnbol, McNulty, and Tobin (Pet. 31–36); (2) Petitioner asserts that claims 10–12 are unpatentable as obvious over Sheha, Degnbol, McNulty, and McDonnell (*id.* at 36–39); (3) Petitioner asserts that claim 46 is unpatentable as obvious over Sheha, Degnbol, McNulty, McDonnell, and Obradovich (*id.* at 39–41). Patent Owner does not offer any specific arguments with respect to these grounds. Based on the record before us, we are sufficiently persuaded that the Petition shows that claims 7–12 and 14–19 are unpatentable over these grounds.

E. Asserted Obviousness — Randall Grounds

Petitioner asserts that claims 1–8 and 10–19 are unpatentable as obvious over Randall and De Vries. Pet. 42–71. Petitioner asserts that claim 9 is unpatentable as obvious over Randall, De Vries, and Tobin. Pet. 71–73.

We begin with overviews of Randall and De Vries. We then turn to the parties’ arguments.

1. Randall (Exhibit 1007)

Randall is titled “Method of Enabling a Wireless Information Device to Access Data Services.” Ex. 1007, code (54). Randall “relates to a method of enabling a wireless information device to access data services,” where the wireless information device includes radio telephones and smart phones. Ex. 1007 ¶ 2. A “directory application (which contains a user’s contacts list, and is capable of acting as a directory for any other name/contact data) [and] a location application (which gives a user’s location and includes digital maps) . . . might all be resident on a device.” *Id.* at ¶ 9.

A user might choose to subscribe to a service which allows others to track his or her location. Ex. 1007 ¶ 21. The user’s friends or parents who wish to track the user’s location might have applications resident on their devices which allow them to see the user’s current telephone number and address. *Id.* A map application could show friends and parents their position on digital maps and also show the position of the user. *Id.*

An ADS system information distribution architecture includes internet servers hosting extensible databases which can be accessed by the wireless information devices. Ex. 1007 ¶ 29. A database can define which entities can read different fields. *Id.* ¶ 47. For example, Alice can give Bob rights to read only certain fields in her database, such as location information. *Id.* ¶¶ 47,

144. When Bob's device sends Alice's ADS number to the server, the server recognizes Bob's device and allows that device to read Alice's information held on the database which is specified as being accessible to Bob. *Id.* ¶ 49. Access rights can be associated with individual entities, and can also be associated with groups of entities. *Id.* ¶ 70.

2. *De Vries (Exhibit 1013)*

De Vries is titled "Place Specific Buddy List Services." Ex. 1013, code (54). De Vries generally relates to "systems and services to facilitate communication based on location and inter-relationships of people." *Id.* at 1:5–8. De Vries discloses:

An information service provides search and notifications to inform when certain people (e.g., friends, family, business contacts, etc.) are nearby so as to facilitate communications with those people. Users may define lists of people whose locations may be tracked by positioning equipment based on personal communications/computing devices carried by the people. The information service processes this people and place data to identify those of the listed people that are in the user's vicinity, and provide notifications and user-initiated search results informing the user such as via the user's personal communications/computing device.

Id. at code (57).

Figure 1 of De Vries is reproduced below.

FIG. 1

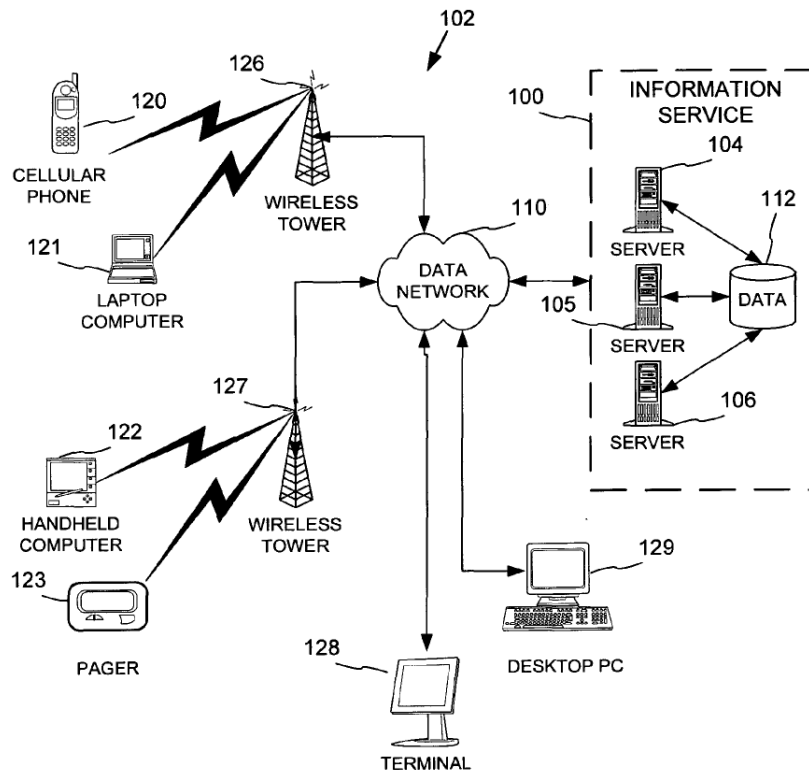


Figure 1 depicts a block diagram of a communications system in which a place-specific buddy-list information service operates. *Id.* at 3:64–67, Fig. 1.

Figure 1 of De Vries shows place-specific buddy list information service 100 in operating environment 102, which is implemented in server application software run on a server computer or group of servers 104–106 connected on distributed data communications network 10. *Id.* at 4:45–50. Information service 100 “tracks users of the information service and their locations in a people/place database 112.” *Id.* at 4:50–52. Users of information service 100 access the information service from mobile personal networked computing or telecommunications devices 120–123, such as cell phones. *Id.* at 4:60–5:5. Mobile devices 120–123 are equipped with “location detecting capability,” such as a Global Positioning System (“GPS”) receiver, which determines the locations of individual mobile

devices 120–123, “so as to thereby infer the position of their users.” *Id.* at 5:20–30. The locations of mobile devices 120–123 are “reported to or polled by the information service 100, which uses this information to track the location of the devices’ users in the people/place database 112.” *Id.* at 5:43–55. “[I]nformation service 100 processes the information as to the users and their locations stored in the people/place database 112 so as to respond to search queries and provide alerts or notifications of changes.” *Id.* at 5:56–62.

Information service 100 “supports visibility parameters, which control when a person’s location is available to be included in search response or notifications.” *Id.* at 9:32–34. “The person would set the visibility parameters to be either visible or not visible to a particular user or group of users.” *Id.* at 9:34–36

3. *Independent Claim 1*

a) *The Preamble and Elements [1A] through [1C]*

The preamble of claim 1 and elements [1A] through [1C] are below.

1. [1PRE] A system comprising:

[1A] a remote system, [1B] wherein user information is operable to be identified from a plurality of different user information by receiving at least a manually entered login from a first wireless device associated with said user information and a manually entered password associated with said login, [1C] a location of said first wireless device is operable to be recorded on said remote system after said user information has been identified on said first wireless device and said location is associated with said user information and provided by said first wireless device to said remote server,

Ex. 1001, 13:15–27.

Petitioner relies on Randall for teaching or suggesting a system comprising a remote system that receives a manually entered login from a

first wireless device and records the location of the first wireless device, recited in the preamble and elements [1A] through [1C]. Pet. 45–52 (citing e.g., Ex. 1007 ¶¶ 2, 9, 21, 28–30, 46, 52–53, 67, 71, 116–136, 144, 380, 491, 503–512, 518 (Table 4), Fig. 4).

Randall describes an “ADS”⁵ system that includes “core structures” as follows: “(a) internet servers hosting extensible databases; (b) wireless information devices which can access information on these databases; and (c) applications resident on these devices.” Ex. 1007 ¶ 28. Randall describes achieving “[a]uthentication” of a wireless device by a user “being asked by the server to state answers to personal information questions or select answers from multiple choice” or with “a PIN.” *Id.* ¶ 67. The “internet servers hosting extensible databases” include a database organized “into information fields,” such as shown in “Table 1.” *Id.* ¶ 46.

Based on the evidence and arguments currently of record, we find that Petitioner demonstrates sufficiently for purposes of institution that Randall teaches the features recited in the preamble and claim elements [1A] through [1C].

b) Elements [1D] through [1F]

Elements [1D] through [1F] are below.

[1D] a location-based event is operable to be provided based, at least in part, on said location of said first wireless device, wherein said location-based event is operable to be manually pre-selected from a list of at least three types of location-based events on a device, [1E] a location-based event notification is operable to be provided on said device as a result of, at least in part, location access rights of said device

⁵ The trademark symbol next to “ADS” is omitted. Randall states that its system is “an implementation from Symbian Limited of London, United Kingdom.” Ex. 1007 ¶ 28.

from said first wireless device, [1F] wherein a first one of said at least three types of location-based events is, at least in part, region-based, and a second one of said at least three types of location-based events is, at least in part, distance-based.

Ex. 1001, 13:27–39.

Petitioner relies on Randall for providing certain teachings relating to “a location-based event” recited in element [1D]. Pet. 53 (citing e.g., Ex. 1007 ¶ 518 (Table 4)). Petitioner, however, for the most part, relies on De Vries for teaching or suggesting providing “a location-based event” that is “one of said at least three types” with a first being based on “region” and a second being based on “distance” recited in elements [1D] and [1F]. *Id.* at 53–56, 59–60 (citing e.g., Ex. 1013, 2:18–35, 4:39–44, 4:60–65, 5:20–62, 6:4–7:12, 7:44–54, 8:41–67, 9:1–8, 9:12–14, 9:19–20, 9:26–31, 9:63–10:19, 16:34–44, Fig. 11).

Regarding elements [1D] and [1F], De Vries describes a “place-specific buddy list information service” that “supports searches based on people and place” and “provides notifications and alerts to a user that other users enumerated in the user’s buddy list are within a given or selected proximity to the user, so that a spontaneous in-person meeting or like social interaction can then be arranged.” Ex. 1013, 4:39–44. De Vries describes that the service is accessed from “mobile devices” such as “cell phones” (*id.* at 4:60–65), which are equipped “with a Global Positioning System (GPS) receiver” that detects the location of the mobile device or cell phone and reports the location to an information service 100 that tracks users’ locations in a “people /place database 112” (*id.* at 5:20–47). De Vries describes that information service 100 “supports a variety of service parameters 550” that

are set “so that notifications can be provided on different bases.” *Id.* at 8:41–51.

De Vries further describes

One such parameter sets a proximity threshold within which people (or other resources 210 of FIG. 2) are to be considered proximate to the user by the information service for purposes of responding to a search or providing notifications. This proximity parameter can have the form of a geographic distance threshold, e.g., a radius in miles or kilometers, within which the people or resources must be located to be considered in proximity to the user. In alternative embodiments of the information service, the information service can employ a database or databases of detailed place information (e.g., place data 570), so as to allow proximity parameters, such as same city/town/neighborhood, same venue, same building, same room, and the like.

Ex. 1013, 9:1–14.

Petitioner argues that a person of ordinary skill in the art would have been motivated to implement Randall’s system, which alerts a user “when a contact happens to be within a defined proximity” to incorporate De Vries “to provide the user with control over what alerts they receive and trigger, about whom, and in what circumstance.” Pet. 45 (citing Ex. 1007 ¶ 518 (Table 4); Ex. 1003 ¶ 230). On the current record, we find that Petitioner provides sufficient rationale to combine the teachings of Randall and De Vries for purposes of institution.

Regarding element [1E], Petitioner relies on each of Randall and De Vries for teaching or suggesting “a location-based event notification.” *Id.* at 56–59 (citing, e.g., Ex. 1007 ¶ 518 (Table 4); Ex. 1013, 8:27–39, 9:32–45). Petitioner relies on Randall for teaching or suggesting that the notification is provided “as a result of, at least in part, location access rights of said device

from said first wireless device” recited in element [1E]. *Id.* at 56–58 (citing e.g., Ex. 1007 ¶¶ 47, 52, 67, 136, 146, 495, 503–512, 518 (Table 4)).

Petitioner argues that “Randall’s ‘Old buddy finder’ alert provides *a location-based event notification on Bob’s device as a result of location access rights of said device from Alice’s first wireless device.*” *Id.* at 58 (citing Ex. 1003 ¶ 267); *see also id.* at 56–57 (stating the same) (citing, e.g., Ex. 1007 ¶ 518 (Table 4)). Randall describes its “Old buddy finder” feature as follows “[w]ireless information device alerts Bob when a contact happens to be within a defined proximity (e.g., Bob and Alice are both in the same foreign city and didn’t know it).” Ex. 1007 ¶ 518 (Table 4). Although we find Randall’s teaching alone is sufficient, De Vries provides further evidentiary support for Petitioner’s position. Ex. 1013, 8:27–39 (describing “notification operations 500” in which “information service 100 determines which people are in the user’s proximity based on notification parameters 502, and then formulates and transmits a notification message to the user”), 9:32–45 (describing “visibility parameters, which control when a person’s location is available to be included in search response or notifications”).

The parties’ dispute centers on element [1E] and the requirement that notification is provided “as a result of, at least in part, location access rights of said device from said first wireless device.” Petitioner argues that this requirement is met by Randall because “Randall further teaches that Bob’s device can only access Alice’s location (as is necessary for alerting Bob that Alice is located nearby) if Alice has provided Bob’s ‘*device*’ sufficient ‘*location access rights*’ from Alice’s ‘*first wireless device.*’” Pet. 57 (citing Ex. 1003 ¶ 264); *see also id.* at 57–59 (identifying specific teachings in

Randall that Petitioner argues teach location access rights) (citing e.g., Ex. 1007 ¶¶ 47, 52, 67, 136, 146, 495, 503–512).

Petitioner provides an annotated version of Table 1 of Randall, reproduced below, with certain rows removed and showing a row of the table highlighted in yellow. Pet. 57.

TABLE 1			
<u>Alice's iData</u>			
Field/Attribute	Category	Details	i-Groups
First name	personal	Alice	all
Family name	personal	Edwards	all
Title	work	European Marketing Manager	all
[...]			
GPS	location	London W1, Seymour St.	partner
Hobby	preferences	Photography, travel	friends
Book	preferences	Maverick	friends
AlbumOfTheWeek	InstaPoll		friends

Table 1 of Randall shows a view of the data stored in the ADS System Database about Alice: Alice's iData. Ex. 1007 ¶ 505. The highlighted row shows a "Field/Attribute" of "GPS," having a location "Category" and belonging to an "i-Group" of "partner." *Id.* Randall describes that the "i-Group" controls what data other people see. *Id.* ¶ 509. In this instance, Alice has provided access to her GPS location to the "partner" group. *Id.* ¶ 505.

An entity seeking the information is authenticated "through the server [recognizing] Bob's device and determining the database access rights which Alice has given him." Ex. 1007 ¶ 67. Randall teaches that "[a]ccess rights can be associated with individual entities, and can also be associated with groups of entities." *Id.* ¶ 70.

Patent Owner argues that Randall “does not teach or suggest that such definitions [that is definitions of “which entities can read different fields”] are provided ‘from’ the same mobile device that is operable to have its location determined.” Prelim. Resp. 49. Randall teaches that “Table 1” is “an example application view of Alice’s i-Data,” which “is entered by Alice” or “is entered automatically.” Ex. 1007 ¶ 505. Randall further teaches that a “view of this database would be provided on *Alice’s mobile device to allow her to manage her data.*” *Id.* (emphasis added).

Patent Owner also argues that Randall’s teaching of providing an “i-Group” access to the location of a GPS location of a mobile is deficient based on Patent Owner’s proposed construction of element [1E]. Prelim. Resp. 50–52. Based on this record, we disagree that Randall is deficient. As discussed above, we are not persuaded to adopt Patent Owner’s construction of “location access rights of said device from said first wireless device” based on the current record. *See* § III.C.

Patent Owner also argues that we “should also reject Petitioners reliance, in the alternative, on a combination of Randall with [De Vries].” Prelim. Resp. 51. Patent Owner’s dispute, however, centers on “location access rights of said device from said first wireless device” and Petitioner relies on only Randall for teaching that claim recitation. Patent Owner does not offer any specific arguments with respect to the claim features that Petitioner argues are taught or suggested by De Vries.

Based on the evidence and arguments currently of record, we find that Petitioner demonstrates sufficiently for purposes of institution that the Randall and De Vries combination teaches the features recited in claim elements [1D] through [1F] and Petitioner provides sufficient rationale to

make its proposed combination. We find that Patent Owner's arguments do not undermine Petitioner's showing.

c) Conclusion—Claim 1

After consideration of the arguments and the evidence of record at this early stage, we determine that Petitioner has shown sufficiently, for purposes of institution, that the combination of Randall and De Vries teaches or suggests all recitations in claim 1. Also, we find that Petitioner provides sufficient rationale to combine the teachings of Randall and De Vries for purposes of institution. We find that Patent Owner's arguments do not undermine Petitioner's showing.

Based on the record at this preliminary stage, we conclude that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that claim 1 is unpatentable under 35 U.S.C. § 103 as obvious over the combination of Randall and De Vries.

4. Independent Claim 2

Petitioner relies, for the most part, on its contentions with respect to claim 1 for how the combination of Randall and De Vries discloses the subject matter of independent claim 2. *See* Pet. 60. Patent Owner relies on the arguments directed to independent claim 1, which we addressed above in connection with our analysis of claim 1. *See* Prelim. Resp. 53–55 (referencing that the arguments made for claim 1 apply to a similar limitation in claim 2).

Based on our analysis of claim 1, and review of Petitioner's additional contentions and corresponding evidence directed to claim 2, we determine that Petitioner demonstrates a reasonable likelihood that independent claim 2 is unpatentable over Randall and De Vries.

5. *Dependent Claims 3–19*

Petitioner asserts that claims 3–8 and 10–19 are unpatentable as obvious over Randall and De Vries. Pet. 61–70. Petitioner asserts that claim 9 is unpatentable as obvious over Randall, De Vries, and Tobin. Pet. 71–73.

Patent Owner does not offer any specific arguments with respect to these grounds. Based on the record before us, we are sufficiently persuaded that the Petition shows that claims 3–19 are unpatentable over these grounds.

IV. CONCLUSION

Based on the arguments presented in the Petition, we conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one claim of the '039 patent challenged in the Petition. Accordingly, we institute a trial on all claims and all grounds asserted in the Petition. The Board has not made a final determination under 35 U.S.C. § 318(a) with respect to the patentability of the challenged claims.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that *inter partes* review of claims 1–19 of the '039 patent is hereby instituted on all grounds stated 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; the trial will commence on the entry date of this decision.

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