

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.

IPR2025-00124
Patent 8,374,575 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 1–46 (“challenged claims”) of U.S. Patent No. 8,374,575 B2 (Ex. 1001, “the ’575 patent”). Mullen Industries LLC (“Patent Owner”) filed a Preliminary Response. Paper 8 (“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 ’575 patent. Accordingly, we grant Petitioner’s request and institute an *inter partes* review of all challenged claims of the ’575 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 itself as the real party-in-interest. Paper 6, 1.

B. Related Matters

Both parties identify, as a matter currently involving the '575 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 '575 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 '575 patent also was the subject of IPR2023-00097, which was terminated after institution due to settlement. *Apple Inc. v. Mullen Industries LLC*, IPR2023-00097, Paper 17 (PTAB Nov. 7, 2023) (Termination).

Petitioner further identifies three Petitions for *inter partes* review for other patents in the chain of continuations related to the '575 patent: IPR2025-00018 challenging U.S. Patent No. 11,122,418; IPR2025-00019 challenging U.S. Patent No. 9,204,283; IPR2025-00021 challenging U.S. Patent No. 11,096,039. Pet. xii.

C. The '575 Patent

The '575 patent is titled “Systems and Methods for Locating Cellular Phones and Security Measures for the Same.” Ex. 1001, code (54). The '575 patent relates to remotely determining a device’s location. *Id.* at 1:17–20.

The '575 patent describes that a deficiency in current systems is that the location of a device that is determined by GPS [Global Positioning System] 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 1:31–38. 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 ’575 patent, a 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 4:50–53. 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 4:53–56. 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 4:62–67.

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

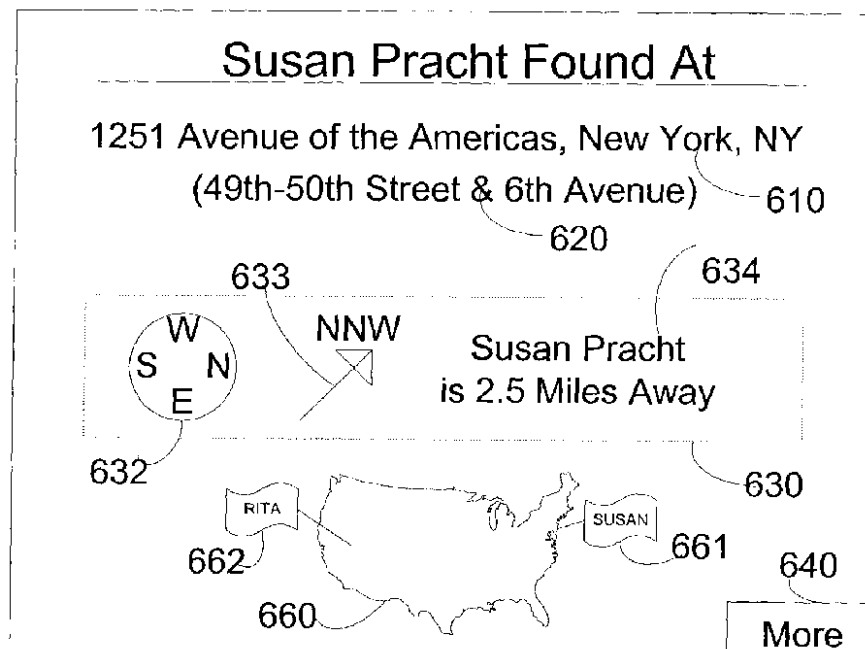


Figure 6, above, shows primary location information 610, as well as secondary location information 620 to supplement the requested user's exact location, directional information 630, distance information 634, map 660, and the location of other users Rita and Susan, at 661 and 662.

The '575 patent also describes a login feature in which a user profile is stored remotely. *Id.* at 9:39–43. In accordance with the '575 patent, a display screen is provided for a user to log into a device. *Id.* at 9:46–47. The '575 patent states that logging into a device also adds a level of security, especially when combined with a password. *Id.* at 9:47–49.

D. Illustrative Claims

Petitioner challenges claims 1–46 of the '575 patent. Pet. 1–2. Claims 1, 13–15, 30, and 38 are independent claims. Claims 2–12 depend directly from claim 1, claims 16–22 depend from claim 15, claims 23–29 depend from claim 13, claims 31–37 depend from claim 30, and claims 39–46 depend from claim 38. Independent claim 1, reproduced below with Petitioner's annotations, is illustrative of the claimed subject matter.

[1PRE] A method comprising:

[1A] obtaining a location of a first wireless telephone;

[1B] transmitting said location from said first wireless telephone to a remote server;

[1C] changing, at the direction of said first wireless telephone, a list of users on said remote server for a profile associated with said first wireless telephone that are allowed to access said location, wherein each user of said list of users is representative of one of a plurality of wireless telephones;

[1D] transmitting said location from said remote server to at least one of said users of said list of users;

[1E] determining a second location associated with one of said plurality of wireless telephones; and

[1F] providing directional information to said one of said plurality of wireless telephones, wherein said directional information is representative of directions between said location and said second location.

Ex. 1001, 12:61–13:11; Pet. 8–24.

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
Froeberg	US 6,674,849 B1, filed July 28, 2000, issued Jan. 6, 2004	1051
Randall	US 2004/0024846 A1, filed Aug. 22, 2001, published Feb. 5, 2004	1007 ¹
Tanaka	US 6,819,919 B1, filed Oct. 18, 2000, issued Nov. 16, 2004	1011

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 '575 patent are unpatentable based on the following grounds summarized in the table below (Pet. 2):

¹ Exhibit 1007 is a U.S. national stage application of the PCT application in Exhibit 1008.

Claim(s) Challenged	35 U.S.C. §²	References/Basis³
1–9, 11, 12, 30–37	103(a)	Sheha
1–9, 11, 12, 30–37	103(a)	Sheha, Froeberg
10	103(a)	Sheha, Randall
10	103(a)	Sheha, Froeberg, Randall
12–29, 38–45	103(a)	Sheha, Tanaka
12–29, 38–45	103(a)	Sheha, Froeberg, Tanaka
46	103(a)	Sheha, Tanaka, Randall
46	103(a)	Sheha, Froeberg, Tanaka, Randall
1–46	103(a)	Randall
1–46	103(a)	Randall, Froeberg

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,

² 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 ’575 patent have an apparent effective filing date before March 16, 2013, the pre-AIA version of § 103 applies. Our analysis would not change under the AIA version of § 103.

³ Because each of Petitioner’s grounds includes whether or not Froeberg is included, we divide each of Petitioner’s grounds into one ground without Froeberg, and one with Froeberg.

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;
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 of the 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 for a stay of 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. 23–24.

⁴ From September 30, 2024 through December 30, 2024, Petitioner filed or co-filed with Google LLC eleven *inter partes* review petitions challenging

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 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. 26.

Petitioner contends that a “motion is pending to transfer the district-court proceeding to the Northern District of California (Ex[.] 1036[,]) 8).” Pet. 76. 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. 28. Patent Owner contends that “Petitioners waited over eight months after the district court complaint was filed to submit [the Petition].” *Id.* at 29.

Petitioner contends that the “parties have invested little in invalidity-related issues, the scheduled *Markman* hearing is over six months away

all claims of the patents asserted in the parallel district court litigation. *See* Ex. 2008, 2 n.2.

(Ex[.] 1038[,] 3), and ‘a significant portion of work remains to be done’ including ‘fact and expert discovery and dispositive motions.’” Pet. 76–77. Petitioner contends that “Petitioner filed this Petition less than six months after receiving Mullen’s infringement contentions and about three 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 nine months after Patent Owner filed its complaint in district court and five months after Patent Owner served its infringement contentions. Prelim. Resp. 30. 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. 30–32. 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. 33–34.

We disagree. The issues raised by Petitioner are similar, if not identical, to those raised in IPR2023-00097, 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 element [1C] and similar recitations in the other independent claims. 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 '575 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).

At this stage of the proceeding, Patent Owner does not challenge the level of ordinary skill in the art proposed by Petitioner's expert. *See*

generally Prelim. Resp. For purposes of this Decision, we adopt Petitioner’s proposal as reasonable and consistent with the ’575 patent specification and the prior art.⁵

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 an express construction of any term. Pet. 5–6. In contrast, Patent Owner proposes a construction for element 1[C] and similar recitations in the other independent claims.

⁵ If Patent Owner disagrees with Petitioner’s formulation of the level of skill in the art, it must do so in its Response. If a different level of skill would affect the outcome in this case, the parties must brief that issue as well. The parties are also encouraged to submit evidence, other than conclusory expert testimony, that supports their position.

Element 1[C] is reproduced below:

[1C] changing, at the direction of said first wireless telephone, a list of users on said remote server for a profile associated with said first wireless telephone that are allowed to access said location, wherein each user of said list of users is representative of one of a plurality of wireless telephones.

Ex. 1001, 12:65–13:3.⁶

Patent Owner contends that:

the plain language of Claims 1, 14, and 30 requires that the “access [to] said location” is provided in each instance both (i) by a specific device (i.e., the same first wireless telephone recited in the claims that has its location determined) and (ii) to a specific device (i.e., a wireless telephone associated with a user as recited in the claims).

Prelim. Resp. 7. Patent Owner contends that Petitioner “improperly ignores” that element [1C] requires “the ‘access [to] said location’” is provided **by a specific device** recited in the claim. *Id.* at 8. Patent Owner also contends that Petitioner “incorrectly argues that providing ‘access [to] said location’” **to a specific device** as recited in the claim “can be satisfied” if the device is “allowed access to location information as a result of a group policy that gives a group access to location information.” *Id.* Patent Owner contends that as a result of Petitioner’s “two errors,” Petitioner seeks to “improperly rewrite” element [1C] as changing “a policy that may result in allowing a list of users” to access said location, wherein each user of said list of users is

⁶ Claim 14 recites an identical limitation and claim 30 recites a substantively identical element with the only different being that “said remote server” in element [1C] is “a remote server” in claim 30. Ex. 1001, 12:65–13:1, 14:11–16, 15:33–38. The parties also agree claims 13, 15, and 38 recite elements similar to element [1C]. Pet. 35; 42–43; Prelim. Resp. 6–7, 17.

representative of one of a plurality of wireless telephones.” *Id.* at 8–9 (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. 9. 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.* at 9–10. Patent Owner contends that the ’575 patent expressly 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 10 (citing Ex. 1001, 1:44-46). Patent Owner provides additional arguments to support its contention that element [1C] read in light of the Specification, excludes a group permission. *Id.* at 11–15. Finally, Patent Owner contends that during prosecution, the Examiner mapped the ““changing ... a list of users ... that are allowed to access the location ...” to column 4 of Havinis. *Id.* at 15–16 (citing Ex. 1002, 320; Ex. 2003, 4:9–10). According to Patent Owner, this mapping demonstrates that the Examiner interpreted this limitation to require “each such grant to be for a specified device as recited in the claim.” *Id.* at 16 (emphasis omitted).

We disagree with Patent Owner on this record. The language of claim 1, quoted above, recites “changing, at the direction of said first wireless telephone, a list of users on said remote server for a profile associated with said first wireless telephone that are allowed to access said location, wherein each user of said list of users is representative of one of a plurality of

wireless telephones.” Ex. 1001, 12:65–13:3. The recitation of “said location” derives antecedent basis from element [1A], which recites “obtaining a location of a first wireless telephone,” thus “said location” in element [1C] is the location of the first wireless telephone. *Id.* at 12:62.⁷ The claim language does not limit access to the location of the first telephone to one other device, at the exclusion of other devices. Indeed, the claim language specifically recites that “a list of *users*” are changed “for a profile associated with said first wireless telephone” and that “each user of said list of users is representative of one of a *plurality of wireless telephones*.” Ex. 1001, 12:65–13:3 (emphases added). The ordinary and customary meaning of “changing, at the direction of said first wireless telephone, a list of users on said remote server for a profile associated with said first wireless telephone that are allowed to access” to the location of the first wireless device “wherein each user of said list of users is representative of one of a plurality of wireless telephones” (Ex. 1001, 12:65–13:3) encompasses allowing “a list of users,” each having a telephone, access to the location of the “first wireless telephone” and further encompasses allowing other telephones, in addition to the recited plurality of wireless telephones access to the location of the first wireless telephone.

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 (Ex. 1001, 1:44–46), the written description also discusses adding users to a list or group of users

⁷ In claims 14 and 30, “said location” also derives antecedent basis from “obtaining a location of said first wireless telephone.” *Id.* at 14:8, 15:32.

with 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 12:56–58.

Claims 1, 14, and 30 specifically recite “changing . . . a list of users,” which is inconsistent with Patent Owner’s argument that “‘access [to] said location’ to a specific device” is “recited in the claim.” Prelim. Resp. 8. Also, the written description of the ’575 patent discusses adding users to a list or group of users with access rights, which confirms that element [1C] and the identical and substantively identical recitations in claims 14 and 30, respectively, should not be construed as Patent Owner contends (Prelim. Resp. 8) to require providing access “to a specific device” so as to exclude allowing “access to location information as a result of a group policy that gives a group access to location information.” *Phillips*, 415 F.3d at 1327. Further, in light of the recitations of claims 1, 14, and 30 and the written description here, we are persuaded that the scope of the disputed claim terms encompasses a group policy or giving a group access to location information. *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.”).

Regarding claims 13, 15, and 38, the similar element lacks the recitation of “at the direction of said first wireless telephone.” Ex. 1001, 13:59–63, 14:29–33, 16:14–18. For instance, claim 13, more specifically, recites “changing a list of users on said remote server for a profile associated with said first wireless telephone that are allowed to access said location, wherein each user of said list of users is representative of one of a plurality of wireless telephones.” *Id.* at 13:59–63. Patent Owner contends “the plain language of Claims 13, 15, and 18 requires that the ‘access [to] said location’ is provided in each instance to a specific device (*i.e.*, a wireless telephone associated with a user as recited in the claims).” Prelim. Resp. 17. Patent Owner relies on its arguments for claims 1, 14, and 30. *Id.* For the same reasons given for claims 1, 14, and 30, we are not persuaded to limit claims 13, 15, and 38 as proposed by Patent Owner.

D. Asserted Obviousness of Claims 1–9, 11, 12, and 30–37—Sheha Grounds

Petitioner asserts that (1) claims 1–9, 11, 12, and 30–37 are unpatentable as obvious over Sheha, or over Sheha and Froeberg; (2) claim 10 is unpatentable as obvious over Sheha and Randall or Sheha, Randall, and Froeberg; (3) claims 12–29 and 38–45 are unpatentable over Sheha and Tanaka or Sheha, Tanaka, and Froeberg; and (4) claim 46 is unpatentable over Sheha, Tanaka, and Randall or Sheha, Tanaka, Randall, and Froeberg. Pet. 6–44. Patent Owner disputes Petitioner’s assertion for element [1C] and the recitations in the other independent claims that are identical, substantively identical, or similar. Prelim. Resp. 42–54. Patent Owner also disputes Petitioner’s assertion for element [13D] and similar recitations in claims 15 and 38. *Id.* at 55–58.

We begin with an overview of Sheha and Froeberg, which are asserted in all grounds. 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.

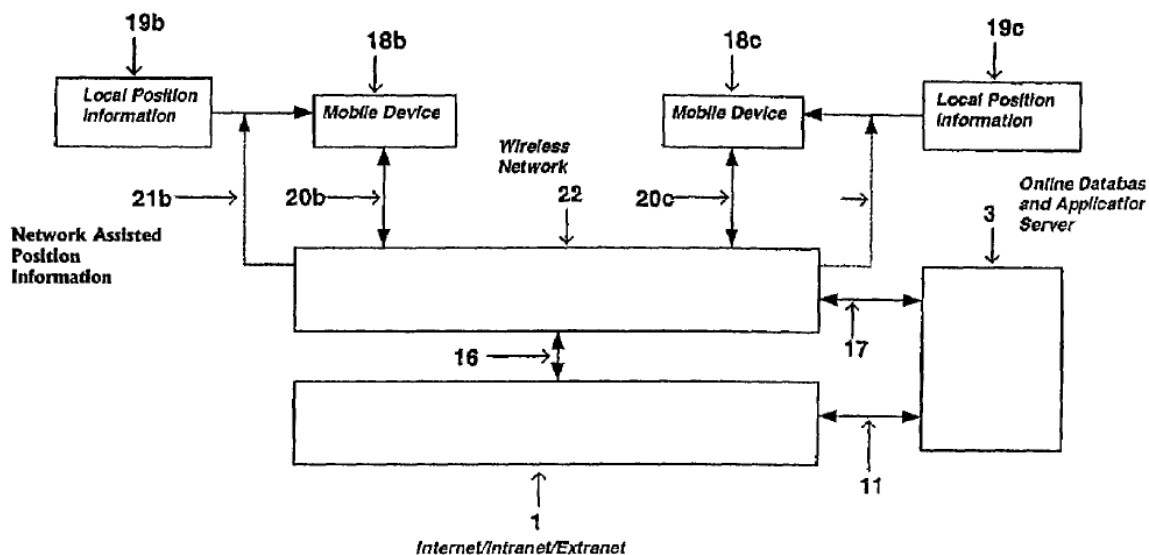


Figure 3, above, illustrates mobile devices 18b, 18c, wireless network 22, and online database and application server (ODAS) 3 for establishing mobile-to-mobile connections. *Id.* at 10:66–11:15.

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. *Froeberg (Exhibit 1051)*

Froeberg is titled “Telephone Providing Directions to a Location,” and discloses a “system providing a map and driving directions to a user of a user telephone for a remote location associated with a remote telephone number.” Ex. 1051, codes (54), (57). Froeberg describes that the user telephone includes logic for “designating a remote telephone number,” and for decoding maps sent to it, and the server:

includes a map object generator for generating the map object from the remote telephone number and a driving directions object generator for generating the driving directions object from the remote telephone number and user location-determination information for a local address, a local telephone number, or local geodetic coordinates provided by a geodetic location device in the user telephone.

Id. at 1:45–60.

3. *Independent Claim 1*

a) *Preamble [1PRE]: “A method comprising”*

Petitioner relies on Sheha’s disclosure that it describes “a ‘*method*’ for “providing real-time position information of one party to another party by utilizing . . . a mobile telecommunications network.” Pet. 8 (quoting Ex. 1005, code (57); citing Ex. 1003 ¶¶ 94–96). Petitioner’s arguments for the preamble are not disputed at this preliminary stage in the proceeding.

Based on the evidence and arguments currently of record, we find that Petitioner demonstrates sufficiently for purposes of institution that Sheha teaches the features recited in the preamble of claim 1.

b) [1A] “obtaining a location of a first wireless telephone”

Petitioner relies on Sheha’s disclosure of mobile-to-mobile communication described with respect to Figure 3. Pet. 9 (reproducing Ex. 1005, Fig. 3 with annotations).

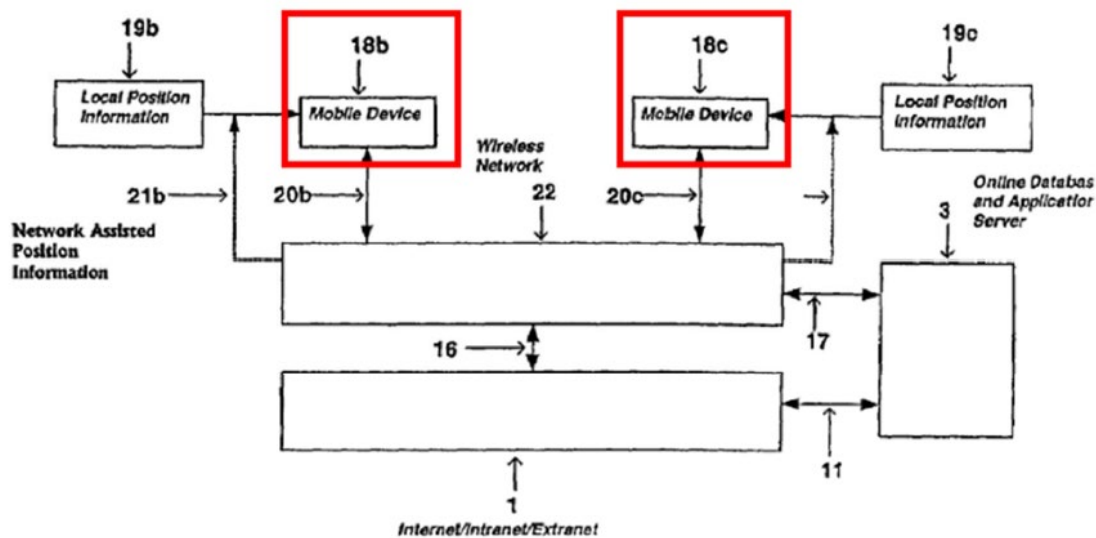


FIG. 3

Annotated Figure 3, above, illustrates, among other things, mobile devices 18b, 18c, wireless network 22, and ODAS 3 for establishing mobile-to-mobile connections (Ex. 1005, 10:66–11:15) and includes Petitioner’s annotation of a red box around each of mobile device 18b and mobile device 18c. Pet. 9 (reproducing Ex. 1005, Fig. 3 with annotations).

Petitioner argues that Sheha discloses determining the position of mobile devices, such as mobile devices 18b and 18c, and supplying the position to the ODAS 3 database. Pet. 9 (citing Ex. 4:13–18, 10:5–16, 11:3–20, 11:44–51, Fig. 3; Ex. 1003 ¶¶ 97–99). Sheha describes in “the mobile-to-mobile application” that “position information can be obtained.” Ex. 1005, 4:13–18. Sheha also describes that the “location of the mobile device is typically calculated” by the mobile device using an “onboard position information device” or “by getting network-assisted position information 21a from the wireless network 22.” *Id.* at 10:5–8.

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

c) [1B] “transmitting said location from said first wireless telephone to a remote server”

Petitioner argues that each mobile device “forwards” is position information to ODAS 3, which Petitioner argues “is a *remote server*.” Pet. 10 (citing (Ex. 1005, 7:21–23, 11:3–37, Fig. 3; Ex. 1003 ¶¶ 100–101). Sheha describes that “the position information of each device can be updated in the ODAS 3,” for example, by the mobile device “relay[ing] to the ODAS 3 through the wireless connection 20b into the wireless network 22” the position information. *Id.* at 11:3–26. Petitioner’s arguments are not disputed at this preliminary stage in the proceeding.

Based on the evidence and arguments currently of record, we find that Petitioner demonstrates sufficiently for purposes of institution that Sheha teaches the features recited in claim element [1B].

d) [1C] “*changing, at the direction of said first wireless telephone, a list of users on said remote server for a profile associated with said first wireless telephone that are allowed to access said location, wherein each user of said list of users is representative of one of a plurality of wireless telephones*”

Petitioner relies on Sheha’s disclosure that “each device may have privacy settings,” which Petitioner argues are “also called ‘permission settings.’” Pet. 10 (citing Ex. 1005, 4:49–66, 5:3–46, 8:42–53, 10:17–26, 11:63–12:7; Ex. 1003 ¶ 102).⁸ Petitioner argues that the “*first wireless telephone*’s privacy/permission settings information can include ‘a group database and authorization and authentication protocols’ by which the device’s user ‘can define a group of specific users that have access to’ the device’s location information” and the “ODAS uses this privacy information” to determine whether a particular user is authorized to obtain the location of the first wireless telephone. *Id.* at 10–11 (citing Ex. 1005, 3:4–14, 3:22–28, 4:8–18, 4:59–5:20, 9:59–10:4, 11:55–12:7, 13:65–14:2, 14:54–61, 19:9–13; Ex. 1003 ¶ 102).

Patent Owner disputes Petitioner’s arguments and evidence for element [1C] for the following four reasons: (1) Sheha’s disclosures of privacy/permission settings are for the most part limited to time period restrictions and do not teach a “list of users” that “are allowed to access” wireless telephone location; (2) Sheha’s disclosures “regarding ‘groups’” are in the context only “of ‘landline-to-landline’ requests” and are irrelevant as

⁸ Petitioner uses other descriptions including “privacy/permission specification options,” “privacy configuration,” and “position transfer permissions” and argues that all these descriptions are of the same “privacy” or “permission” settings according to Sheha. Pet. 12 n. 3 (citing Ex. 1005, 4:35–42, 4:59–5:46, 10:17–26, 10:44–11:9).

they do not pertain to the location of a wireless device; (3) Sheha's disclosures "regarding 'groups'" do not describe granting "of 'access [to] said location' to a specific device" as required by Patent Owner's proposed construction of element [1C]; and (4) Petitioner's arguments that element [1C] would have been obvious over Sheha should be rejected because as "hindsight." Prelim. Resp. 45–49. We address each of Patent Owner's arguments in turn.

Regarding Patent Owner's first argument that Sheha's disclosures of privacy/permission settings are for the most part limited to time period restrictions and do not teach a "list of users" that "are allowed to access" wireless telephone location (*id.* at 45–47), as set forth above, Petitioner relies on Sheha's disclosures that Petitioner argues teaches "a group of specific users that have access to' the device's location information." Pet. 10–11 (citations omitted).⁹ 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. 47–48), 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

⁹ Indeed, Patent Owner acknowledges Petitioner's reliance on these disclosures. *See, e.g.*, Prelim. Resp. 47.

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”). Furthermore, we do not agree with Patent Owner’s fourth argument regarding obviousness in view of these disclosures for the reasons given below.

Regarding Patent Owner’s third argument that Sheha’s disclosures “regarding ‘groups’” do not describe granting “of ‘access [to] said location’ to a specific device” as required by Patent Owner’s proposed construction of element [1C] (Prelim. Resp. 47–48), based on this record, we disagree. As discussed above, we are not persuaded to adopt Patent Owner’s construction of element [1C] 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. 49), 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 who have permission to access the user’s location (or to provide access permission on an individual-user basis). Petitioner’s argument and evidence at this juncture shows that such a technique was well-known and a beneficial option with reasonable expectation of success in a system like Sheha’s.” Pet. 11–14 (citing Ex. 1007 ¶¶ 52–70, 136, 144–148; Ex. 1003 ¶¶ 107–110).

Based on the evidence and arguments currently of record, we find that Petitioner demonstrates sufficiently for purposes of institution that Sheha teaches the features recited in claim element [1C]. For the reasons given above, at this preliminary stage, we find that Patent Owner's arguments do not undermine Petitioner's showing.

e) [1D] “transmitting said location from said remote server to at least one of said users of said list of users”

Petitioner relies on Sheha's disclosure that “[w]hen a mobile device's position information is requested, the system, based on privacy settings, responds with the appropriate position information to the requesting user's device.” Pet. 17 (quoting Ex. 1005, 12:1–7). Petitioner also relies on similar disclosures in Sheha of ODAS 3 updating a mobile device with the position information of another mobile device. *Id.* (citing Ex. 1005, 4:59–5:46, Ex. 11:49–51; Ex. 1003 ¶¶ 127–128). Petitioner's arguments are not disputed at this preliminary stage in the proceeding.

Based on the evidence and arguments currently of record, we find that Petitioner demonstrates sufficiently for purposes of institution that Sheha teaches the features recited in claim element [1D].

f) [1E] “determining a second location associated with one of said plurality of wireless telephones”

Petitioner argues that element [1E] is taught by Sheha because Sheha describes determining the position of mobile devices, such as mobile devices 18b and 18c, and sharing that information. Pet. 18 (citing Pet. 9; Ex. 1005, 4:13–18, 10:66–11:54, Fig. 3; Ex. 1003 ¶ 129–130). Sheha describes “placing a telephone call from a mobile device 18b” by inputting a telephone number “of another wireless device 18c” and updating “the position

information of *each device* . . . in the ODAS 3.” Ex. 1005, 10:65–11:7 (emphasis added). Sheha further describes that “*mobile devices 18b and 18c* continually send their updated position information to the ODAS 3, when the position information has changed significantly as compared to the positioning error probability and as determined by the *positioning technology or network configuration*.” Ex. 1005, 11:44–49 (emphases added). Sheha describes that position information of a mobile device “is calculated” by a “positioning information device” (positioning technology) or is received from wireless network 22 “using a network assisted positioning approach” (network configuration). *Id.* at 11:15–20. Petitioner’s arguments are not disputed at this preliminary stage in the proceeding.

Based on the evidence and arguments currently of record, we find that Petitioner demonstrates sufficiently for purposes of institution that Sheha teaches the features recited in claim element [1E].

g) [1F] “*providing directional information to said one of said plurality of wireless telephones, wherein said directional information is representative of directions between said location and said second location*”

Petitioner relies on Sheha’s disclosure of providing driving directions and route information, as well as Sheha’s disclosure of the wireless network sending position information obtained from the ODAS in the form of a Map Caller-ID (Caller-identification). Pet. 18–22 (citing Ex. 1005, 5:21–34, 7:41–8:9, 9:23–34, 11:20–51, Fig. 5; Ex. 1003 ¶¶ 131–135). Petitioner, alternatively, relies on the combination of Sheha and Froeberg arguing that a person of ordinary skill in the art would have modified Sheha in view of Froeberg to generate the directions at the ODAS and transmit the directions from the ODAS to one or both mobile devices to reduce storage and

processing requirements at the mobile device. *Id.* at 22–23 (citing Ex. 1051, code (57), Figs. 1, 5, 1:6–10, 1:40–65, 3:30–6:20, 7:5–46; Ex. 1003 ¶¶ 136–143). Petitioner’s arguments are not disputed at this preliminary stage in the proceeding.

Sheha describes the following:

In one embodiment the display unit on the destination telephone 8 can display the caller’s name, telephone number, address, and can provide a map illustration of varying resolutions configured by the user through the telephone network 2. Additionally, the telephone 8 can provide route and driving direction information between the originating telephone number’s location 5 and the destination telephone number’s location 8.

Ex. 1005, 7:44–51.

Sheha describes ODAS 3 receiving “position information for both mobile devices 18b and 18c.” Ex. 1005, 11:20–23. Sheha also describes ODAS 3 sending position information of a telephone “to the telephone network 2 to be incorporated into the Map Caller-ID data format.” *Id.* at 7:51–57.

Froeberg includes further supporting disclosures. For example, Froeberg describes a server that includes “a map object generator for generating the map object from the remote telephone number” and “a driving directions object generator for generating the driving directions object from the remote telephone number.” Ex. 1051, code (57). Froeberg describes the server decoding “geodetic location” to an address and transmitting driving directions. *See, e.g., id.* at Fig. 3.

Based on the evidence and arguments currently of record, we find that Petitioner demonstrates sufficiently for purposes of institution that Sheha

alone or in combination with Froeberg teaches the features recited in claim element [1F].

h) 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 Sheha alone or in combination with Froeberg teaches or suggests all recitations in claim 1. Also, we find that Petitioner provides sufficient rationale to combine the teachings of Sheha and Froeberg for purposes of institution. *See* § III.D.3.g.

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 Sheha alone or in combination with Froeberg.

4. Independent Claim 30

Petitioner relies, for the most part, on its contentions with respect to claim 1 for how Sheha alone or in combination with Froeberg teaches the subject matter of independent claim 30. *See* Pet. 35. The recitations in claim 30 are substantively identical to those in claim 1, except claim 30 does not include element [1B]. Patent Owner relies on the arguments, which we addressed above in connection with our analysis of claim 1 and obviousness over Sheha alone or in combination with Froeberg. *See* Prelim. Resp. 42–49.

Based on our analysis of claim 1, we determine that Petitioner demonstrates a reasonable likelihood that independent claim 30 is unpatentable over Sheha alone or in combination with Froeberg.

5. *Dependent Claims 2–12 and 31–37*

Petitioner asserts that claims 2–9, 11, 12, and 31–37 are unpatentable as obvious over Sheha alone or with Froeberg. Pet. 6–35. Petitioner asserts that claim 10 is unpatentable as obvious over Sheha and Randall, or Sheha, Froeberg, and Randall. *Id.* at 35–36. Claims 2–12 depend from claim 1, and claims 31–37 depend from claim 38. Petitioner provides a detailed analysis in support of its position that the asserted art teaches or suggests the limitations in dependent claims 2–12 and 31–37. *See* Pet. 6–36.

We have reviewed Petitioner’s assertions and the evidence in support thereof. Patent Owner does not separately challenge Petitioner’s analysis for dependent claims 2–12 and 31–37. Based on the record at this preliminary stage, we conclude that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that claims 2–9, 11, 12, and 31–37 are unpatentable under 35 U.S.C. § 103 as obvious over Sheba alone, or Sheha and Froeberg. 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 10 is unpatentable as obvious over Sheha and Randall, or Sheha, Froeberg, and Randall.

6. *Independent Claims 13–15 and 38 and Dependent Claims 12, 16–29, and 39–46*

Petitioner asserts that claims 12–29 and 38–45 are unpatentable as obvious over Sheha and Tanaka, or Sheha, Tanaka, and Froeberg. Pet. 36–44. Petitioner asserts that claim 46 is unpatentable as obvious over Sheha, Tanaka, and Randall, or Sheha, Tanaka, Randall, and Froeberg. *Id.* at 44.

Patent Owner disputes Petitioner’s assertion for element [13C] and similar recitations in claims 14, 15, and 38. Prelim. Resp. 42–55. Patent

Owner also disputes Petitioner’s assertion for element [13D] and similar recitations in claims 15 and 38. *Id.* at 55–58.

We begin with an overview of Tanaka. We then turn to the parties’ arguments.

a) Tanaka (Exhibit 1011)

Tanaka is titled “Method for Providing Matching and Introduction Services to Proximate Mobile Users and Service Providers.” Ex. 1011, code (54). Tanaka relates to a “personal matching/meeting service that utilizes wireless, and/or Internet infrastructures coupled with real-time positional data,” so that the system can “inform system users when they come within range of other users who meet search criteria.” *Id.* at 1:15–21.

Tanaka describes a central database that stores user profiles and real-time locations of system users. *Id.* at code (57). According to Tanaka, “[m]obile users can request information on nearby users by submitting a request from a mobile telephone.” *Id.* Tanaka’s server then “searches the profile database for nearby users based on a requestor’s location, locations of other users of the system and optional parameters specified in the request” and returns the search results to the requestor. *Id.*

b) Independent Claims 13–15 and 38

Petitioner relies, for the most part, on its contentions with respect to claim 1 for how Sheha alone or in combination with Froeberg discloses the subject matter of independent claims 13–15 and 38. *See* Pet. 39–43. Patent Owner disputes Petitioner’s assertion for element [13C] and similar recitations in claims 14, 15, and 38 for the same reasons discussed with respect to element [1C]. Prelim. Resp. 42–55. We disagree with Patent Owner. For the reasons discussed with respect to claim construction, we are

not persuaded to adopt Patent Owner’s construction of element [1C] based on the current record. *See* § III.C. Based on the evidence and arguments currently of record, we find that Petitioner demonstrates sufficiently for purposes of institution that Sheha teaches the features recited in claim element [13C] and similar recitations in claims 14, 15, and 38. For the reasons given above, at this preliminary stage, we find that Patent Owner’s arguments do not undermine Petitioner’s showing.

Patent Owner also disputes Petitioner’s assertion for element [13D] and similar recitations in claims 15 and 38. Prelim. Resp. 55–58. Element [13D] recites “transmitting an alert message, comprising information associated with said location, from said remote server to a user of said list of users when said user is within a certain distance of said location.”

Petitioner argues that “Tanaka teaches allowing the user to submit a search request specifying search parameters, including a search radius specifying a distance” and the “server automatically notifies the user (i.e., transmits an alert message) when another user satisfying the search parameters is ‘within the search radius’ (i.e., within a certain distance).” Pet. 40 (citing Ex. 1011, code (57), 6:10–7:1, 7:28–30, 7:61–64, 8:56–59, 10:24–27); Ex. 1003 ¶ 232). Petitioner argues that “including the first wireless telephone’s location in the proximity notification was a well-known, obvious design option” and was taught or at least suggested by Tanaka’s disclosure of providing “a ‘limited’ version of ‘Person A’s PublicImage’” to Person B. Pet. 40–41 (citing Ex. 1011, 4:27–31).

Patent Owner argues the following:

Tanaka’s search request is not directed to, nor is it capable of, targeting a specific pre-identified user, much less the “first wireless telephone” claimed, and then alerting a second wireless

telephone belonging to the claimed “user” on said list of users based on the location of the first wireless telephone. Tanaka indeed functions in the exact opposite way—it provides a “*matching and introduction*” service (e.g., Ex. 1011, Title, 7:13–14, 7:65–66, 8:63–64) to identify unknown users (i.e., not users previously identified as users for which another user will receive location alerts) that satisfy a user’s criteria to assist the user in meeting new people.

Prelim. Resp. 56 (citing, e.g., Ex. 1011, 3:66–4:2).

Based on the current record, we find that Petitioner has the better position. Tanaka describes a first user submitting a search request to system 10 “with search criterion including keywords and geographic search radius.” Ex. 1011, 6:10–12. Tanaka also describes that the first user’s “geographic position is automatically determined.” *Id.* at 6:12–13. Tanaka further describes that the search request “is transmitted by the communications device 2 to the wireless communication infrastructure 3.” *Id.* at 6:38–40. Tanaka describes that server 5 “begins the search process” by “querying the SRTP [secure real-time positional] database 6 for other users that are geographically proximate to said first user within the search radius” specified in the search request. *Id.* at 6:49–55. User profiles of users geographically close to the first user are returned, the first user selects a profile, and “system 10 responds” to the first user’s selection by “notifying said second user that said first user wishes to make contact.” *Id.* at 6:56–7:5. Tanaka also describes receiving results of a search and contacting a user received in the search result. *Id.* at 4:18–24. Tanaka describes that the “request to contact” the user received in the search result “is initiated by sending the requester’s (Person A) PublicImage to the desired recipient (Person B).” *Id.* at 4:24–27.

Patent Owner also argues that “Petitioners’ alternative theory that Tanaka itself ‘immediately teaches and would have rendered obvious’ fundamentally modifying its own system to store alert searches and provide alerts for known and specific wireless telephones (Pet., 41) also fails because it is classic impermissible hindsight reconstruction.” Prelim. Resp. 57. We find that Petitioner’s argument is not based on hindsight, but instead is sufficiently supported by Tanaka’s disclosure of providing public information regarding the requester to the recipient. Ex. 1011, 4:24–27.

Based on our analysis of claim 1, and review of Petitioner’s additional contentions and corresponding evidence directed to claims 13–15 and 38, we determine that Petitioner demonstrates a reasonable likelihood that independent claims 13–15 and 38 are unpatentable over Sheha and Tanaka, or Sheha, Tanaka, and Froeberg. Pet. 36–44. For the reasons discussed with respect to claim 1 and above with respect to element [13D] and similar recitations in claims 15 and 38, we find that Patent Owner’s arguments do not undermine Petitioner’s showing.

c) Dependent Claims 12, 16–29, and 39–45

Petitioner asserts that claims 12, 16–29 and 39–45 are unpatentable as obvious over Sheha and Tanaka, or Sheha, Tanaka, and Froeberg. Pet. 36–44. Petitioner asserts that claim 46 is unpatentable as obvious over Sheha, Tanaka, and Randall, or Sheha, Tanaka, Randall, and Froeberg. *Id.* at 44.

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 12, 16–29 and 39–45 are unpatentable as obvious over Sheha and Tanaka, or Sheha, Tanaka, and Froeberg. We also are persuaded that the Petition sufficiently shows that

claim 46 is unpatentable as obvious over Sheha, Tanaka, and Randall, or Sheha, Tanaka, Randall, and Froeberg.

E. Asserted Obviousness of Claims 1–46 over Randall

Petitioner asserts that claims 1–46 are unpatentable as obvious over Randall, or Randall and Froeberg. Pet. 45–75. Patent Owner disputes Petitioner’s assertion for element [1C] and similar recitations in the other independent claims. Prelim. Resp. 42–54. Patent Owner also disputes Petitioner’s assertion for element [13D] and similar recitations in claims 15 and 38. *Id.* at 55–58.

We begin with an overview of Randall. 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. *Claim 1*

Petitioner relies on Randall for teaching or suggesting all the elements of claim 1. Pet. 47–59. In particular, Petitioner relies on Randall's i-Data database, which includes one field for "GPS location," which stores the device's location. *Id.* at 48–54 (citing, e.g., Ex. 1007 ¶¶ 116–136, 502–512). Petitioner also relies on Table 1 of Randall, reproduced below, and showing a row of the table highlighted in yellow. Pet. 50.

TABLE 1

Alice's iData			
Field/Attribute	Category	Details	i-Groups
First name	personal	Alice	all
Family name	personal	Edwards	all
Title	work	European Marketing Manager	all

TABLE 1-continued

Alice's iData			
Field/Attribute	Category	Details	i-Groups
Company Name	work	Wireless Information Device gets R Us	all
Company Address	work	1 Science Park Rd, London, N1	all
Company E-mail	work	alice.edwards@Wireless Information Device getsrus.com	business 1
Company switchboard	work	0207 200 2000	all
Company Direct	work	0207 200 2012	business 1
Mobile Phone	work	0840 1234 567	business 1, friends
Home Phone 1	work	0208 341 1234	friends, family
Home Address	work	25 The Gables, Hampstead, London, NW3	family
My photo	photos		friends
Childhood photo	photos		family
Home note	notice	Sorry about dinner ☹	partner
Work note	notice	In a meeting with Tim till 7pm	work 1
My mood now	mood	Very tired	all
Tel Call Subject		"Dinner Tonight"	
Bluetooth	location	Bluetooth pods 1000-1020 . . . Sentinel room 2 . . .	
GPS	location	London W1, Seymour St.	partner
Hobby	preferences	Photography, travel	friends
Book	preferences	Maverick	friends
AlbumOfTheWeek	InstaPoll		friends

Randall, Table 1 (annotated).

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.

Petitioner also relies on Randall's authentication feature, where a user is authenticated "using their 'WID [Wireless Information Device] and password/passphrase'" Pet. 51 (citing Ex. 1007 ¶ 380; Ex. 1003 ¶ 283). Petitioner argues that after authentication is achieved, "Randall's 'server recognis[es] Bob's device and determin[es] the database access rights which Alice has given him,'" which may include "information about her device's 'GPS **location**.'" *Id.* (citing Ex. 1007 ¶¶ 21, 67, 503–512; Ex. 1003 ¶ 284).

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 by the same wireless telephone that is operable to have its location determined." Prelim. Resp. 50. 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 [1C]. 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 element [1C] based on the current record. *See* § III.C.

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 Randall alone or in combination with Froeberg teaches or suggests all recitations in claim 1. Also, we find that Petitioner provides sufficient rationale to combine the teachings of Randall and Froeberg 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 Randall alone or in combination with Froeberg.

3. *Independent Claims 13–15, 30, and 38*

Petitioner relies, for the most part, on its contentions with respect to claim 1 for how Randall alone or in combination with Froeberg discloses the subject matter of independent claims 13–15 and 38. *See* Pet. 70–75. Patent Owner disputes Petitioner's assertion for element [13C] and similar recitations in claims 14, 15, and 38 for the same reasons discussed with respect to element [1C]. Prelim. Resp. 53–55. We disagree with Patent Owner. For the reasons discussed with respect to claim construction, we are not persuaded to adopt Patent Owner's construction of element [1C] based on the current record. *See* § III.C. 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 claim element [13C] and similar recitations in claims 14, 15, and 38. For the

reasons given above, at this preliminary stage, we find that Patent Owner's arguments do not undermine Petitioner's showing.

Patent Owner also disputes Petitioner's assertion for element [13D] and similar recitations in claims 15 and 38. Prelim. Resp. 55–58. Element [13D] recites “transmitting an alert message, comprising information associated with said location, from said remote server to a user of said list of users when said user is within a certain distance of said location.”

Petitioner argues “Randall provides an ‘Old buddy finder’ service by which Bob’s ‘[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).” Pet. 70 (citing Ex. 1007 ¶ 518). Patent Owner argues “both the Petition and Randall are silent as to what form of ‘proximity’ triggers Randall’s ‘alert.’” Prelim. Resp. 57. Randall, however, teaches that contact information includes GPS location. *See, e.g.*, Ex. 1007 ¶ 505.

Based on our analysis of claim 1, and review of Petitioner's additional contentions and corresponding evidence directed to claims 13–15, 30, and 38, we determine that Petitioner demonstrates a reasonable likelihood that independent claims 13–15, 30, and 38 are unpatentable over Randall alone or in combination with Froeberg. For the reasons discussed with respect to claim 1 and above with respect to element [13D] and similar recitations in claims 15 and 38, we find that Patent Owner's arguments do not undermine Petitioner's showing.

4. *Dependent Claims 2–12, 16–29, 31–37, and 39–46*

Petitioner asserts that claims 2–12, 16–29, 31–37, and 39–46 are unpatentable as obvious over Randall alone or in combination with Froeberg. Pet. 59–69, 75. 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 2–12, 16–29, 31–37, and 39–46 are unpatentable as obvious over Randall alone or in combination with Froeberg.

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 '575 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, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–46 of the '575 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '575 patent shall commence on the entry date of this Decision, and notice is hereby given of the institution of a trial.

FOR PETITIONER

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