

Filed on behalf of TRACBEAM, LLC
By: Sean Luner
DOVEL & LUNER
201 Santa Monica Blvd, Suite 600
Santa Monica, CA 90401
Telephone (310) 656-7066
sean@dovel.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC,
Petitioner,

v.

TRACBEAM, LLC,
Patent Owner

Case No. IPR2015-01696
Patent 7,525,484

**PATENT OWNER'S PRELIMINARY RESPONSE TO THE PETITION
FOR INTER PARTES REVIEW OF U.S. PATENT NO. 7,525,484 UNDER
35 U.S.C. § 313 PURSUANT TO 37 C.F.R. § 42.107**

Table of Contents

- I. Petitioner’s two grounds fail because neither PCT ‘307 nor FCC 99-245 is prior art.....1
 - A. Reason 1: Petitioner does not satisfy its burden of identifying specific claim limitations in the challenged claims that it contends do not have sufficient written description support in the earlier ‘892 PCT and ‘367 applications.....6
 - B. Reason 2: What Petitioner asserts is missing from the underlying PCT ‘307 application—a “GPS handset”—is disclosed in the underlying application.....12
- II. Petitioner fails to satisfy its burden of demonstrating that the challenged claims are unpatentable.22
 - A. Petitioner’s burden.22
 - B. Ground 1.....26
 - 1. Petitioner’s discussion.27
 - 2. Petitioner’s claim charts.....31
 - 3. Petitioner’s obviousness assertions.....51
 - C. Ground 2.....56
- III. Conclusion.59

Table of Authorities

Cases

Amazon v. Personalized Media Communications,
IPR2014-01533, Paper 16 (April 20, 2015) 3, 4, 56

Apple Inc. v. ContentGuard Holdings,
IPR2015-00440, Paper 11, (July 13, 2015).....22

Apple Inc. v. Sightsound Technologies, LLC.,
CBM2013-00019, Paper 17 (October 8, 2013)11

Billy Goat Industries, Inc., v. Schiller Grounds Care, Inc.,
IPR2014-00742, Paper 8 (November 7, 2014)..... 25, 56

CallCopy, Inc. v. Verint Americas, Inc.,
IPR2013-00492, Paper 14 (Feb. 5, 2014)..... 49, 58

Cf., DeSilva v. DiLeonardi,
181 F.3d 865 (7th Cir. 1999).....56

*Christie Medical Holdings, Inc. v. The Research Foundation of The City College of
New York*,
IPR2015-00213, Paper 19 (September 18, 2015) 24, 33

Cisco Systems, Inc. v. C-Cation Technologies, LLC,
IPR2014-00454, Paper 12 (August 29, 2014) 24, 33, 52, 54

Cordis Corp. v. Medtronic AVE, Inc.,
339 F.3d 1352 (Fed. Cir. 2003)11

Corning Incorporated v. DSM IP Assets B.V.,
IPR2013-00048, Paper 94 (May 9, 2014)56

Dynamic Drinkware, LLC v. National Graphics, Inc.,
800 F.3d 1375 (Fed. Cir. 2015)5

FedEx Corp. v. IPVenture, Inc.,
IPR2014-00833, Paper 24 (Feb. 20, 2015)..... 4, 9, 11

Focal Therapeutics, Inc. v. Senorx, Inc.,
IPR2014-00116, Paper 8 (April 22, 2014)7

Google Inc. v. Unwired Planet, LLC,
CBM2014-00006, Paper 31 (April 6, 2015)11

Heart Failure Technologies, LLC v. Cardiokinetix, Inc.,
IPR2013-00183, Paper 12 (July 31, 2013).....51

Hollmer v. Harari,
681 F.3d 1351 (Fed. Cir. 2012).....3

In re Kahn,
441 F.3d 977 (Fed. Cir. 2006).....59

Kloster Speedsteel AB v. Crucible, Inc.,
793 F.2d 1565 (Fed. Cir. 1986).....24

KSR Int’l v. Teleflex Inc.,
550 U.S. 398 (2007) 52, 54

Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.,
CBM2012-00003, Paper 8 (Oct. 25, 2012) 8, 26

LizardTech, Inc. v. Earth Resource Mapping, Inc.,
424 F.3d 1336 (Fed. Cir. 2005).....11

Polaris Wireless v. TruePosition, Inc., IPR2013-00323,
Paper 9 (November 15, 2013)7

Rexnord Corp. v. Laitram Corp.,
274 F.3d 1336 (Fed.Cir.2001).....11

Samsung Electronics Co. et al v. Black Hills Media, LLC,
IPR2014-00737, Paper 7 (November 4, 2014)..... 52, 54, 55

Sharp Corp. v. Surpass Tech Innovation,
IPR2015-00022, Paper 9 (March 10, 2015)59

Synopsys, Inc. v. Mentor Graphics Corp.,
IPR2012-00041, Paper 16 (Feb. 22, 2013)..... passim

Technology Licensing Corp. v. Videotek, Inc.,
545 F.3d 1316 (Fed. Cir. 2008).....5

Tempur Sealy International, Inc. v. Select Comfort Corp.,
IPR2014-01419, Paper 9 (March 27, 2015) passim

Universal Remote Control, Inc. v. Universal Electronics, Inc.,
IPR2013-00152 Paper 8 (August 19, 2013).....23

Wowza Media Systems, LLC and Coffee Cup Partners, Inc. v. Adobe Systems, Inc.,
IPR2013-00054, Paper 16 (July 13, 2013).....23

Statutes

35 U.S.C. § 103 52, 54
35 U.S.C. § 1203
35 U.S.C. § 314.....4
35 U.S.C. § 316.....5

Regulations

37 C.F.R. § 42.104 passim
37 C.F.R. § 42.22 passim

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.