

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

GOOGLE INC.,

Petitioner,

v.

ALEX IS THE BEST, LLC

Patent Owner

---

Case IPR2017-02058

U.S. Patent No. 8,581,991

---

**PATENT OWNER'S PRELIMINARY RESPONSE**

**TABLE OF CONTENTS**

**Page No.**

TABLE OF CONTENTS

I. INTRODUCTION AND SUMMARY OF ARGUMENT ..... 1

II. INTER PARTES REVIEW IS UNCONSTITUTIONAL..... 4

III. PATENT OWNER IS ENTITLED TO EFFECTIVE FILING DATE OF JULY 26, 2005..... 5

IV. THE PETITION FAILS TO ESTABLISH A REASONABLE LIKELIHOOD AT LEAST ONE OF THE CHALLENGED CLAIMS IS UNPATENTABLE ..... 5

    A. The Petition Fails to Establish a Motivation to Combine for Obvious Grounds..... 6

        1. The Petition fails to provide a satisfactory motivation to combine Inoue and Nair (Ground 1) ..... 7

        2. The Petition fails to provide a satisfactory motivation to combine Yamazaki and Nicholas (Ground 2)..... 9

        3. The Petition fails to provide a satisfactory motivation to combine Yamazaki and Nair (Ground 3).. 11

        4. The Petition fails to provide a satisfactory motivation to combine Yamazaki, Nicholas and Nair (Ground 4) ..... 12

        5. The Petition fails to provide a satisfactory motivation to combine Kusaka and Nicholas (Ground 5)14

        6. The Petition fails to provide a satisfactory motivation to combine Kusaka, Nicholas and Nair (Ground 6) ..... 15

    B. Ground 1: The Petition Fails to Establish a Reasonable Likelihood That Claims 1-3, 10-14 and 21 are Rendered Obvious in view of Inoue and Nair ..... 16

    C. Ground 2: The Petition Fails to Establish a Reasonable Likelihood That Claims 1-3, 12-14 and 21 are Rendered Obvious by Yamazaki in view of Nicholas ..... 17

    D. Ground 3: The Petition Fails to Establish a Reasonable Likelihood That Claims 1-3, 12-14 and 21 are Rendered Obvious in view of Yamazaki and Nair ..... 18

    E. Ground 4: The Petition Fails to Establish a Reasonable Likelihood That Claims 10 and 11 are Rendered Obvious in view Yamazaki, Nicholas and Nair..... 20

    F. Ground 5: The Petition Fails to Establish a Reasonable Likelihood That Claims 1-3, 12-14 and 21 are Rendered Obvious in view Kusaka and Nicholas ..... 21

    G. Ground 6: The Petition Fails to Establish a Reasonable Likelihood That Claims 10 and 11 are Rendered Obvious in view Kusaka, Nicholas and Nair ..... 22

V. CONCLUSION ..... 24

**TABLE OF AUTHORITIES**

	<b>Page No.</b>
<b><u>Cases</u></b>	
<i>Ex Parte Ahlfeld</i> , APPEAL 2014-009272, 2016 WL 4775709 (P.T.A.B. Sept. 9, 2016) .....	7
<i>In re Magnum Oil Tools Int’l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016) .....	7
<i>Jacobs Corp. v. Generis III, Inc.</i> , IP2014-01267, Paper 12 (P.T.A.B. Jan. 22, 2015) .....	6
<i>Kinetic Concepts, Inc. v. Smith &amp; Nephew, Inc.</i> , 688 F.3d 1342 (Fed. Cir. 2012) .....	7
<i>KSR Int’l Co. v. Teleflex, Inc.</i> , 550 U.S. 398 (2007) .....	6
<i>McCormick Harvesting Mach. Co. v. Aultman &amp; Co.</i> , 169 U.S. 606 (1898) .....	4
<i>Moses Lake Indus., Inc. v. Enthone, Inc.</i> , IPR2014-00243, Paper 6 (P.T.A.B. June 18, 2014) .....	7
<i>Oil States Energy Services LLC v. Greene’s Energy Group, LLC.</i> .....	4
<i>Purdue Pharma L.P. v. Depomed, Inc.</i> , 643 F. App’x 960 (Fed. Cir. 2016) .....	7
<b><u>Other Authorities</u></b>	
37 C.F.R. §42.108(c) .....	6

## I. INTRODUCTION AND SUMMARY OF ARGUMENT

Petitioner has requested initiation of *inter partes* review (the “Petition”) of claims 1-3, 10-14 and 21 (the “Challenged Claims”) of U.S. Patent 8,581,991 (hereinafter the ‘991 patent or AITB patent)<sup>1</sup> issued to Alex Is The Best, LLC (“Patent Owner” or “AITB”). AITB respectfully requests that the Board deny the Petition for at least the following reasons:

*First*, *inter partes* review is unconstitutional.

*Second*, Petitioner fails to establish why a person of ordinary skill in the art would have combined *Inoue* with *Nair* (Ground 1), and therefore fails to establish a reasonable likelihood that Petitioner would prevail on any obviousness ground. Petitioner’s proffered obviousness combinations involving *Inoue* must fail because such combinations will not lead a person of ordinary skill in the art to the claimed invention because *Inoue*’s camera establishes a network connection on power-up only when a communication card is installed in the card slot. *Inoue*’s card slot can (a) be empty, (b) have a communication card, or (c) have a memory card.

*Third*, Petitioner fails to establish why a person of ordinary skill in the art would have combined *Yamazaki* with either (a) *Nicholas*, (b) *Nair* or (c) *Nicholas* and *Nair* (Grounds 2-4), and therefore fails to establish a reasonable likelihood that Petitioner would prevail on any obviousness ground. Petitioner’s proffered obviousness combinations involving *Yamazaki* must fail because such combinations will not lead a person of ordinary skill in the art to the claimed invention because *Yamazaki* does not or suggest an electronic camera that automatically connects to the communications network on power-up. Additionally, *Nicholas* teaches away from the claimed invention. Further, *Nair* merely describes providing seamless routing between wireless network while the cell phone user is roaming, i.e., when both wireless networks are

---

<sup>1</sup> The Petitioner requested initiation of another *inter partes* review of the same U.S. Patent 8,581,991 in IPR2017-02059. This Petition and the instant Petition relies on same three references.

simultaneously present and **available** when “handoff” or switch is made from one wireless network to another wireless network. Whereas, the claimed invention automatically switches to another available mode of connection when the primary mode of connection to the communications network is **unavailable**.

*Fourth*, Petitioner fails to establish why a person of ordinary skill in the art would have combined *Kusaka* with either (a) *Nicholas* or (c) *Nicholas* and *Nair* (Grounds 5-6), and therefore fails to establish a reasonable likelihood that Petitioner would prevail on any obviousness ground. Petitioner’s proffered obviousness combinations involving *Kusaka* must fail because such combinations will not lead a person of ordinary skill in the art to the claimed invention because *Kusaka* does not teach (a) automatically connecting the Internet direct device to the communications network on power-up using one of a plurality of available modes of connection, which is designated as a primary mode of connection; and (b) automatically switching to another available mode of connection when the Internet direct device detects that said primary mode of connection to the communications network is unavailable. Additionally, *Nicholas* teaches away from the claimed invention. Further, *Nair* merely describes providing seamless routing between wireless network while the cell phone user is roaming, i.e., when **both** wireless networks are simultaneously present and **available** when “handoff” or switch is made from one wireless network to another wireless network. Whereas, the claimed invention automatically switches to another available mode of connection when the primary mode of connection to the communications network is **unavailable**.

*Fifth*, Petitioner fails to establish a reasonable likelihood of success that Claims 1-3, 10-14 and 21 are obvious in view of *Inoue* and *Nair* (Ground 1). This combination fails to teach or suggest that “the Internet direct device automatically switches to another available mode of

# 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.