UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC.,

Petitioner,

v.

ALEX IS THE BEST, LLC

Patent Owner

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Case IPR2017-02059

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

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**PATENT OWNER'S PRELIMINARY RESPONSE**

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## I. INTRODUCTION AND SUMMARY OF ARGUMENT

Petitioner has requested initiation of *inter partes* review (the "Petition") of claims 22, 23, 25, 27-29, 32, 33 and 35-38 (the "Challenged Claims") of U.S. Patent 8,581,991 (hereinafter the '991 patent or AITB patent) 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 either (1) *Nair,* (2) *Umeda* or (3) *Nair* and *Narayanswami* (Grounds 2-4), and therefore fails to establish a reasonable likelihood that Petitioner would prevail on any obviousness ground. Petitioner's proffered obviousness combinations of *Inoue* and *Nair, and Inoue*, *Nair* and *Narayanaswami* must fail because such combinations will change the principles of the reference by eliminating *Inoue*'s storing process which transfers the image from the buffer 56 to the memory card. Further, 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.

***Fourth***, Petitioner fails to establish a reasonable likelihood of success that Claims 22, 23, 25, 27-29, 32, 33 and 35-38 is anticipated by *Nicholas* (Ground 1). Petitioner relies on a personal computer (PC) reference which was taught against by the Patent Owner.

***Fifth***, Petitioner fails to establish a reasonable likelihood of success that Claims 22, 23, 25, 27-29, 32, 33 and 35-38 is obvious in view of *Inoue* and *Nair* (Ground 2) and in view of *Inoue*, *Nair* and *Narayanaswami* (Ground 3). These combinations fail to teach or suggest that "the Internet direct device automatically switches to another available mode of connection when

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the Internet direct device detects that the primary mode of connection to the communications network is unavailable." *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, and *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. *Narayanaswami* is merely cumulative and adds nothing to the combined teachings of *Inoue* and *Nair*.

***Sixth***, Petitioner fails to establish a reasonable likelihood of success that Claims 22, 23, 25, 27-29, 32, 33 and 35-38 is obvious over *Umeda* in view of *Inoue* (Ground 4). This combination must fail because "seamless routing between wireless networks" during roaming as taught by *Umeda* is achieved only when **both** wireless networks are simultaneously present and **available**. Whereas, the claimed invention automatically switches to another available mode of connection when the primary mode of connection to the communications network is **unavailable**.

## II. INTER PARTES REVIEW IS UNCONSTITUTIONAL

Patent Owner believes any attempt to retract Patent Owner's intellectual property rights through invalidation of any claims of the AITB patent at the United States Patent and Trademark Office is unconstitutional. In particular, the IPR process at least violates the Constitution by extinguishing private property rights through a non-Article III forum without a jury. Once a patent is granted, it "is not subject to be revoked or canceled by the president, or any other officer of the Government" because "[i]t has become the property of the patentee, and as such is entitled to the same legal protection as other property." *McCormick Harvesting Mach. Co. v.*

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