IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Inter Partes Review of:)
U.S. Patent No. 9,454,748   )
Issued: September 27, 2016   )
Application No.: 12/910,706   )
Filing Date: October 22, 2010)

For: System and Method for Data Management

FILED VIA E2E

Case IPR2019-00610
Patent 9,454,748

REPLY DECLARATION OF KENDYL A. ROMÁN
IN SUPPORT OF PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT 9,454,748

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I. Introduction

1.   I, Kendyl A. Román, make this declaration. All statements herein made of my own knowledge are true, and all statements herein made based on information and belief are believed to be true. I am over 21 years of age and otherwise competent to make this declaration. Although I am being compensated for my time in preparing this declaration, the opinions herein are my own.

2.   I have been engaged by counsel for Petitioners as an expert witness in the above proceedings. I previously submitted a declaration signed January 21, 2019 (Ex. 1005). My original declaration describes my background and qualifications, my understanding of the legal standards for patentability, my description of the state of the prior art, my overview of the patent, and my overview of the prior art. I have been asked to further provide my opinion about certain statements and analyses provided by the Board in its Institution Decision as well as certain statements and analyses provided by Dr. Samuel Russ regarding the state of the art of the technology described in U.S. Patent No. 9,454,748 ("'748 Patent") (Ex. 1001) and on the patentability of this patent.

3.   In addition to the documents I considered in forming my opinion in my original declaration, I have also reviewed and considered the following in preparation of this declaration, as well as any other cited reference or document in this declaration: Institution Decision (August 7, 2019); Patent Owner's Response to

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Petition for Inter Partes Review (October 25, 2019); Declaration of Dr. Samual Russ (October 25, 2019). I offer the following analysis in response to the foregoing documents.

II.   Claims 1 and 19-22 in view of Barbosa in View of the Knowledge of a POSITA.

4.   In my original declaration, I expressed my opinion that Barbosa in view of the knowledge of a POSITA renders obvious Claims 1 and 19-22. *See* Ex. 1005 at ¶¶ 121-168. Below I provide further discussion in support of this opinion.

A.   Versions of the Java® Programming Language

5.   The Patent Owner's Response attempts to limit Barbosa to implementations using the Java 2 Platform, Micro Edition (J2ME) because wireless devices at the time were purportedly so limited. (Resp. at 12.)

6.   However, as I stated in my original declaration, Java was merely one example of an object-oriented programming language available to a POSITA at the time of Barbosa, as reflected in Barbosa. I did not limit my opinion to solely Java 2 Platform, Micro Edition (J2ME), and in my opinion, a POSITA at the time of Barbosa would also not have been so limited.

7.   By way of example, I stated in my original declaration as follows: "Barbosa discloses that '[c]omputer program code for carrying out operations of the present invention can be written in an object-oriented programming language *such*

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as Java….' [Barbosa] at 12:45-51. A questionnaire (e.g., downloaded code modules, templates, and/or programs) written in an object-oriented programming language *such as* Java would have included an index, an instruction, or a command that can represent something else such as a question, answer, or operation. Therefore, Barbosa discloses a tokenized questionnaire." Ex. 1005 at ¶ 126 (emphasis added).

8. I further opined that, "*[f]or example*, Barbosa discloses that the 'computer program transmitted from the [server]' can be 'in the form of a JAVA applet.' Ex. 1002 at 12:14-18." Ex. 1005 at ¶ 131 (emphasis added).

9. I further opined that a "POSITA would have understood that the Java programming language is a programming language that provides device independency—it runs irrespective of the particular hardware or operating system of any given device." Ex. 1005 at ¶ 132.

10. Regarding the level of ordinary skill in the art, I opined that "knowledge on how to program applications for mobile devices using programming languages *such as* Java or C++ to provide location-based services, also reflect the appropriate level of skill at the time of the claimed invention." Ex. 1005 at ¶ 104 (emphasis added).

11. Thus, rather than being limited solely to the disclosures of Java 2 Platform, Micro Edition (J2ME), it is my opinion that it would have been obvious to a POSITA at the time of Barbosa to apply known techniques used by Java (Version

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1), Java 2 Standard Edition, and Java 2 Enterprise Edition to wireless devices once those devices' then-limited computing power improved.

12.   I note that Java was originally written for use with handheld devices and was run on handheld devices as early as 1992, approximately ten years before the priority date of the '748 Patent. An example of James Gosling's expectation of running Java on handheld devices can be found in the video located at: Gosling, James; Forrest, Craig; Frazier, Al; Frank, Ed; Haughton, Patrick; Palrang, Joe; Payne, Jon; Sheridan, Mike; and Warth, Chris "The Star7 PDA Prototype", James Gosling / Green Project demonstration video (1992) (available at, https://www.youtube.com/watch?v=Ahg8OBYixL0).

B.   The Java® Programming Language and GPS Coordinates

13.   Next, the Patent Owner argues that receiving GPS information can only be accomplished via a Java Native Interface. However, this is contradicted by the near-contemporaneous development of Java Specification Request 179 (JSR-179).

14.   JSR-179 is a Java Application Programming Interface that "produces information about the present geographic location of the terminal to Java Applications." Ex. 1019 at 1.

15.   Work on JSR-179 began at least as early as March 2002, as evidenced by the JSR-179 document and other publicly available information. *Id.* at iii; *see also*

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