

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

ASUSTEK COMPUTER INC. AND ASUS COMPUTER INTERNATIONAL,  
Petitioners,

v.

MAXELL, LTD.,  
Patent Owner

---

**Case: IPR2019-00071**

**U.S. Patent No. 6,430,498**

---

**PATENT OWNER'S PRELIMINARY RESPONSE  
TO PETITION FOR *INTER PARTES* REVIEW  
OF U.S. PATENT NO. 6,430,498**

Mail Stop **Patent Board**  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Apple v. Maxell

**TABLE OF CONTENTS**

	<b>Page</b>
TABLE OF AUTHORITIES .....	IV
I. INTRODUCTION .....	1
II. BACKGROUND .....	3
A. Technology Background .....	3
B. Overview of the ’498 Patent Invention .....	3
C. Summary of Petitioner’s Proposed Grounds of Unpatentability and the References Cited.....	5
III. CLAIM CONSTRUCTION .....	6
A. “a device for getting location information denoting a present place of said portable terminal” and “a device for getting direction information denoting an orientation of said portable terminal” (Claims 1, 5, and 10).....	8
B. “walking navigation,” “walking navigation information,” and “said walking navigation” (Claims 1, 5, and 10)” .....	11
C. “route guidance information” and “neighborhood guidance information” (Claims 1, 5, 8, and 10) .....	11
IV. LEGAL STANDARD .....	12
V. THE PETITION DOES NOT SHOW A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY CHALLENGED CLAIM .....	13
A. Ground 1: Petitioner Failed To Establish That Claims 1-3, 5-8 are Obvious Over Suzuki and Nosaka. ....	13
1. Ground 1 Has No Reasonable Likelihood of Succeeding Because the Suzuki/Nosaka Combination Does Not Disclose or Suggest Each and Every Element of the Challenged Claims .....	13
2. Ground 1 Has No Reasonable Likelihood of Succeeding Because Petitioner Does Not Articulate Any Rational Underpinning for Petitioner’s Obviousness Arguments for Suzuki/Nosaka.....	21

B.	Ground 2: Petitioner Failed to Established That Claims 1-3 and 5-8 are Obvious Over Suzuki in view of Colley.....	27
1.	Ground 2 Has No Reasonable Likelihood of Succeeding Because the Suzuki/Colley Combination Does Not Disclose or Suggest Each and Every Element of the Challenged Claims. ....	27
2.	Ground 2 Has No Reasonable Likelihood of Succeeding Because Petitioner Does Not Articulate Any Rational Underpinning for Petitioner's Obviousness Arguments for Suzuki/Colley. ....	33
C.	Ground 3: Petitioner Failed to Established That Claims 1-3 and 5-7 are Rendered Obvious By Suzuki in view of Colley and Ellenby.....	34
1.	Ground 3 Has No Likelihood of Succeeding Because the Suzuki/Colley/Ellenby Combination Does Not Disclose or Suggest Each and Every Element of the Challenged Claims. ....	34
2.	Ground 3 Has No Reasonable Likelihood of Succeeding Because Petitioner Does Not Articulate Any Rational Underpinning for Petitioner's Obviousness Combination of Suzuki and Colley and Ellenby. ....	36
D.	Ground 4: Petitioner Failed to Established That Claims 1-7, 9-13 are Rendered Obvious By Norris in view of Colley. ....	37
1.	Ground 4 Has No Reasonable Likelihood of Succeeding Because Norris in view of Colley Does Not Disclose or Suggest Each and Every Element of the Challenged Claims. ....	37
2.	Ground 4 Has No Reasonable Likelihood of Succeeding Because Petitioner Does Not Articulate Any Rational Underpinning for Petitioner's Obviousness Combination of Norris With Colley. ....	43
E.	Ground 5: Petitioner Failed to Established That Claims 1-2, 5-6, 8, 10, and 12 are Rendered Obvious by Norris in view of Nosaka and Colley.....	48

Patent No. 6,430,498  
Patent Owner’s Preliminary Response

1.	Ground 5 Has No Likelihood of Succeeding Because Norris in view of Nosaka and Colley Does Not Disclose or Suggest Each and Every Element of the Challenged Claims. ....	48
2.	Ground 5 Has No Likelihood of Succeeding Because Petitioner Does Not Articulate Any Rational Underpinning for Petitioner’s Obviousness Combination of Norris With Nosaka and Colley. ....	49
F.	Ground 6: Petitioner Failed to Established That Claims 1-2, 5-6, 8, 10, and 12 are Rendered Obvious By Norris in view of Colley and Ellenby. ....	51
1.	Ground 6 Has No Likelihood of Succeeding Because Norris in view of Colley and Ellenby Does Not Disclose or Suggest Each and Every Element of the Challenged Claims. ....	52
2.	Ground 6 Has No Likelihood of Succeeding Because Petitioner Does Not Articulate Any Rational Underpinning for Petitioner’s Obviousness Combination of Norris With Colley and Ellenby. ....	53
G.	The Board Should Disregard Mr. Andrews’s Conclusory Declaration and Most of Petitioner’s Exhibits ....	54
VI.	THE PETITION SHOULD BE DENIED BECAUSE IT EXCEEDS THE WORD LIMIT BY IMPROPERLY INCORPORATING ARGUMENTS BY REFERENCE.....	57
VII.	CONCLUSION.....	59

**TABLE OF AUTHORITIES**

**Page(s)**

**Cases**

*A. C. Dispensing Equipment Inc. v. Prince Castle LLC*,  
IPR2014-00511, Paper No. 16 (P.T.A.B. March 17, 2014) .....59

*ActiveVideo Networks, Inc. v. Verizon Comm's, Inc.*,  
694 F.3d 1312 (Fed. Cir. 2012) .....22, 44

*Apple Inc., v. Immersion Corporation*,  
IPR2016-01372, Paper No. 7 (January 11, 2017).....9

*Facebook, Inc. v. Sound View Innovations, LLC*,  
IPR2017-01004, Paper No. 13 (Aug. 29, 2017) .....9

*Facebook, Inc. v. Sound View Innovations, LLC*,  
IPR2017-01006, Paper No. 14 (Aug. 29, 2017) .....9

*Ferring B.V. v. Watson Laboratories, Inc.-Florida*,  
764 F.3d 1401 (Fed. Cir. 2014) .....24

*Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*,  
IPR2012-00001, Paper No. 59 (P.T.A.B. Nov. 13, 2013).....7, 8

*Graham v. John Deere Co. of Kansas City*,  
383 U.S. 1 (1966).....*passim*

*Guangdong Alison Hi-Tech Co., Ltd. v. Aspen Aerogels, Inc.*,  
Case IPR2017-00152, Paper No. 8 (P.T.A.B. Mar. 23, 2017) .....*passim*

*In re Abbott Diabetes Care, Inc.*,  
696 F.3d 1142 (Fed. Cir. 2012) .....7

*In re Am. Acad. Of Sci. Tech. Ctr.*,  
367 F.3d 1359 (Fed. Cir. 2004) .....6

*In re Kahn*,  
441 F.3d 977 (Fed. Cir. 2006) .....22, 45

# 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.