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Paper No. 48
Filed: October 12, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC.,
Petitioner,

v.

X ONE, INC.,
Patent Owner.

Case IPR2017-01264
Patent 8,798,647 B1

Before JAMESON LEE, STACEY G. WHITE, and SHEILA F. McSHANE, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Uber Technologies, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1, 4–11, 13, 22–25, 27, 28, 31–37, 39–42, and 45 of U.S. Patent No. 8,798,647 B1 (Ex. 1001, "the '647 patent"). X One, Inc. ("Patent Owner") filed a Preliminary Response (Paper 6). Based on our review of these submissions and associated evidence, we instituted *inter partes* review of claims 1, 4–11, 13, 22–25, 27, 28, 31–37, 39–42, and 45 of the '647 patent as obvious over Konishi alone or as paired with other references. Paper 8 ("Dec."), 25.

Patent Owner filed a Patent Owner's Response (Paper 23, "PO Resp."), and Petitioner filed a Reply (Paper 30, "Reply"). Subsequent to the Institution Decision, the Supreme Court held that, under 35 U.S.C. § 314, the Board may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1352–53 (2018). In light of the Supreme Court's decision, we modified our institution order to institute on all grounds asserted in the Petition. Paper 27, 2. Thus, the following claims and grounds are at issue in this proceeding:

Reference(s)	Basis	Challenged Claims
Konishi[1]	§103(a)	1, 5, 7, 10, 11, 22, 23, 28, 33, 36, 37, and 40–42
Konishi and Rautila[2]	§103(a)	1, 4, 5, 7, 10, 11, 22, 23, 28, 31, 33, 36, 37, and 40–42

[1] Japanese Unexamined Patent Application Publication 2002-352388 (May 25, 2001) (Ex. 1011) (English Translation Ex. 1012, "Konishi").

[2] U.S. Patent No. 6,714,797 B1 (Mar. 30, 2004) (Ex. 1025, "Rautila").

Reference(s)	Basis	Challenged Claims
Konishi and Adamczyk[3]	§103(a)	6, 24, and 32
Konishi and Makoto[4]	§103(a)	8, 9, 25, 34, 35, and 45
Konishi and Knotts[5]	§103(a)	13, 27, and 39
Mitsuoka[6]	§103(a)	1, 5, 6, 7, 10, 11, 22, 23, 24, 28, 32, 33, 36, 37, and 40–42
Mitsuoka and Rautila	§103(a)	1, 4, 5, 7, 10, 11, 22, 23, 28, 31, 33, 36, 37, and 40–42
Mitsuoka and Makoto	§103(a)	8, 9, 25, 34, 35, and 45
Mitsuoka, Konishi, and Knotts	§103(a)	13, 27, and 39

Pet. 10–12.

Patent Owner filed a Supplemental Response directed to the grounds added to the proceeding (Paper 33, "Supp. PO Resp."), and Petitioner filed a Supplemental Reply (Paper 37, "Supp. Reply"). In addition, Patent Owner filed a Motion to Exclude (Paper 40, "Mot.") to which Petitioner filed an Opposition (Paper 42, "Opp. To Mot.") and Patent Owner filed a Reply in Support of its Motion to Exclude (Paper 43, "Mot. Reply"). An oral hearing was held on August 13, 2018, and the transcript was entered into the record. Paper 46 ("Tr.").

[3] U.S. Patent No. 6,925,381 B2 (Aug. 2, 2005) (Ex. 1028, "Adamczyk").

[4] Japanese Unexamined Patent Application Publication 2002-199433 (July 12, 2002) (Ex. 1008) (English translation Ex. 1009, "Makoto").

[5] U.S. Patent No. 6,658,260 B2 (Dec. 2, 2003) (Ex. 1026, "Knotts").

[6] Japanese Unexamined Patent Application Publication 2003–168190 (June 13, 2003) (Ex. 1014) (English translation Ex. 1015, "Mitsuoka").

We have jurisdiction under 35 U.S.C. § 318(a). For the reasons discussed below, Petitioner has not demonstrated by a preponderance of the evidence that claims 1, 4–11, 13, 22–25, 27, 28, 31–37, 39–42, and 45 of the '647 patent are unpatentable.

B. Related Proceedings

We have been informed that *X One, Inc. v. Uber Technologies, Inc.*, No. 5:16-cv-6050-LHK (N.D. Cal.), may be impacted by this proceeding. Pet. 70; Paper 5, 2. In addition, U.S. Patent No. 8,798,593 B2 is the subject of *Uber Technologies, Inc. v. X One, Inc.*, Case IPR2017-01255, which is an *inter partes* review involving the same parties. *Id.*

C. The '647 Patent

The '647 patent is titled "Tracking Proximity of Services Provider to Services Consumer" and describes a system for "exchanging GPS or other position data between wireless devices." Ex. 1001 at [54], Abstract. The system involves "phones and other wireless devices [that] are programmed with software . . . to allow mutual tracking and optional position mapping displays of members of groups." *Id.* at 2:33–38. The '647 patent explains that "people want to communicate with and know where other people are." *Id.* at 3:50–51. As described in the specification, "[s]ome of the benefits of the Buddy Tracker technology are that it allows businesses to easily identify which service persons are closest to the next job and to let personnel in the field know the positions of their co-workers and to share their location with their co-workers." *Id.* at 3:26–30. In addition, "[p]arents can keep track of where their kids are" and "[f]riends can keep track of where their buddies are and share their position with their buddies." *Id.* at 3:30–32.

"[T]he invention only allows exchanging and mapping of position data with persons on a Buddy List™." *Id*. at 2:51–53. According to the '647 patent, "[t]he user must allow others on his Buddy Lists to 'see' his location (location sharing may be turned off), and the user must request to see the location of others on his Buddy Lists to be able to have their positions reported and/or mapped." *Id*. at 2:57–61. The specification describes using the "Mapit" application on a phone to send position update requests and plot the locations of other users. *Id*. at 6:33–36.

Figures 13A and 13B of the '647 patent are reproduced below.

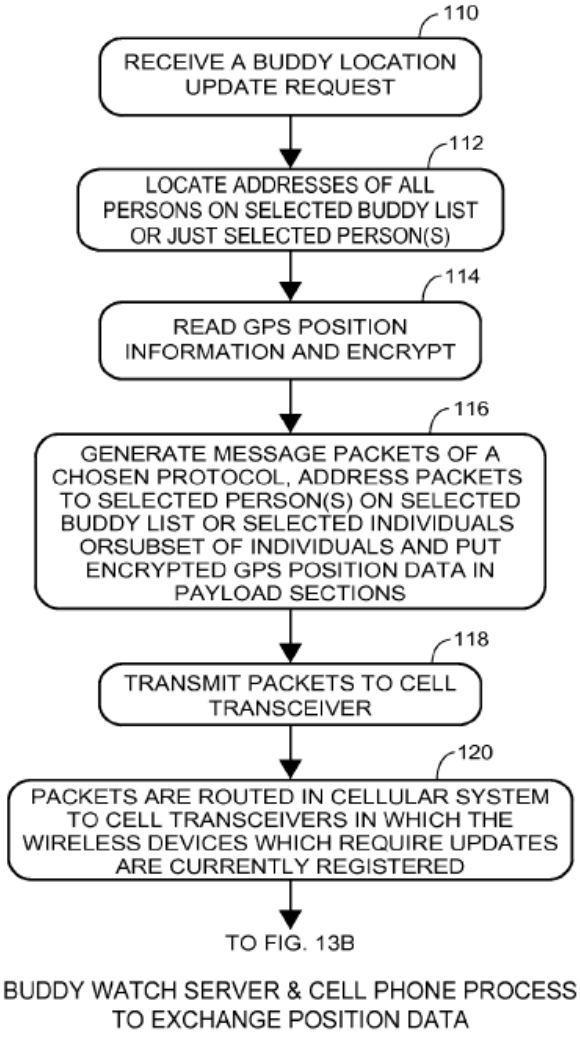

FIG. 13A

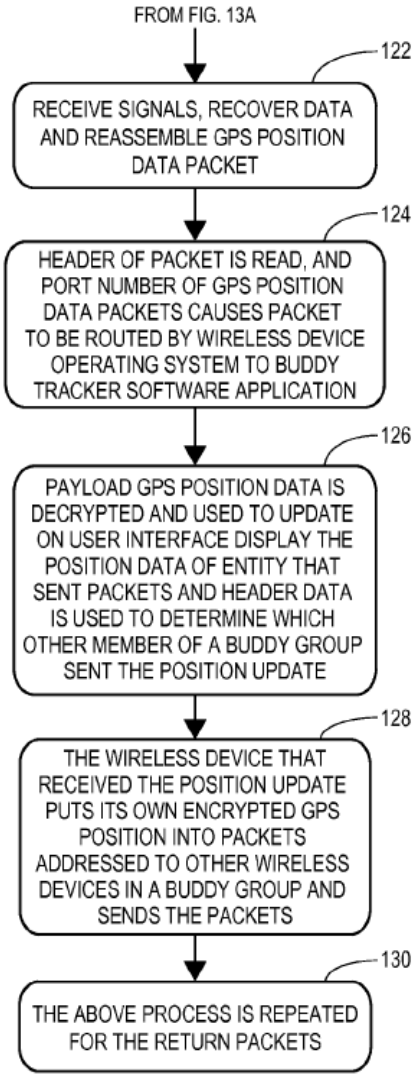

FIG. 13B

Together, Figures 13A and 13B depict "a flowchart of the method of exchanging GPS position data among cell phones of a watch list." *Id*. at 4:39–41 (reference numerals omitted). The process includes receiving a buddy location update request, reading the GPS position data from the built in GPS receiver, and transmitting GPS location data to devices on the buddy list. *Id*. at Figs. 13A, 13B. Those devices receive the information, interpret it, and display the sending device's location. *Id*. Then, the device that

received the position update sends its own GPS location for display on other devices in the buddy group. *Id*.

D. Instituted Claims

The panel instituted *inter partes* review of claims 1, 4–11, 13, 22–25, 27, 28, 31–37, 39–42, and 45, of which claims 1, 22, and 28 are independent. Claim 1 is illustrative of the challenged claims and is reproduced below:

> 1. A method of tracking proximity of position associated with a first wireless device relative to a position of a second wireless device, wherein one of the first wireless device and the second wireless device is associated with a provider of a desired service and the other of the first wireless device and the second wireless device is associated with a requestor of the desired service, the method comprising:
>
> causing receipt of information on the first wireless device representing the position of the second wireless device and a map associated with the position associated with the first wireless device and the position of second wireless device;
>
> causing display of the map on the first wireless device with position associated with the first wireless device and the position of the second wireless device rendered thereon; and
>
> causing receipt of information on the first wireless device representing positional update of the second wireless device, and causing update of display of the map on the first wireless device with the position associated with the first wireless device and updated position of the second wireless device rendered thereon;
>
> wherein the causing of the update is to be performed to indicate proximity of and direction between position of the provider of the desired service and position associated with the requestor of the desired service;

> wherein the method is invoked responsive to launching an application on the first wireless device in connection with a request from the requestor for the desired service; and
>
> wherein the provider is selected in connection with the request for the desired service and the method further comprises forming a use-specific group to have the first wireless device and the second wireless device in connection with the request for the desired service.

Ex. 1001, 28:50–29:18.

E. Person of Ordinary Skill in the Art

All of the asserted grounds in this proceeding are based on obviousness under 35 U.S.C. § 103(a). As part of our obviousness determination, § 103 requires us to ascertain the level of ordinary skill in the pertinent art at the time of the invention. *Graham v. John Deere*, 383 U.S. 1, 17 (1966). The resolution of this question is important because it allows us to "maintain[] objectivity in the obviousness inquiry." *Ryko Mfg. Co. v. Nu–Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the time of the invention. *In re GPAC, Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995).

Factors that may be considered in determining the level of ordinary skill in the art include, but are not limited to, the types of problems encountered in the art, the sophistication of the technology, and educational level of active workers in the field. *Id.* In addition, the level of ordinary skill in the art is reflected by the prior art of record. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). Generally, it is easier to establish obviousness under a higher level of ordinary skill in the art. *Innovention Toys, LLC v. MGA Entm't, Inc.*, 637 F.3d 1314, 1323 (Fed. Cir. 2011).

Petitioner's declarant, Dr. Chris G. Bartone, opines that "a person of ordinary skill would have had at least a four-year degree in electrical engineering, computer science, or a related field of study, or equivalent experience, and at least two years of experience in or with mobile wireless communications and navigation systems." Ex. 1003 ¶ 40. Patent Owner's declarant, Mr. Mark A. Struza, directs us to deposition testimony from Dr. Bartone, which purportedly clarifies Dr. Bartone's definition. Ex. 2004 ¶ 25. These clarifications raise the purported level of skill in the art by asserting that "a person of ordinary skill in the art would need to have broader experience than simply designing a wireless receiver or antenna"; instead: "The person of ordinary skill in the art, as understood by Dr. Bartone, would be involved 'with mobile wireless communication systems. . ., not just one little aspect of it.'" *Id.* (citing Ex. 2007, 47:1–9). Patent Owner alleges that Dr. Bartone further explained his view that someone of ordinary skill in the art would have a "good grasp" of the technology at the "system level," which includes the user-facing front-end application through the signal-receiving elements. PO Resp. 6 (citing Ex. 2007, 48:10–49:6). Mr. Struza states that he applied Dr. Bartone's "person of ordinary skill in the art, as clarified during his deposition." *Id.* ¶ 26.

We have reviewed Dr. Bartone's testimony, and we find his references to the front end and signal receiving elements were intended to denote that a person of ordinary skill's understanding should include an understanding of the elements' use at a system level in mobile wireless communications and navigation systems, but the ordinarily skilled artisan need not "have detailed understandings of every single aspect and every single system." *See* Ex. 2007, 48:17–19, *see also id.* at 46:15–49:6. Under

Dr. Bartone's testimony, a person of ordinary skill in the art would not be required to have an understanding of, for instance, the details of the design of user applications or antenna except as required for an understanding of how these elements work within the mobile wireless communications and navigation systems. *See id.* Additionally, under our review of Petitioner's proposed qualifications, we decline to adopt the qualifier "at least," because the use of this qualifier introduces vagueness. Accordingly, on this record, we adopt the qualifications that a person of ordinary skill would have a four-year degree in electrical engineering, computer science, or a related field of study, or equivalent experience, and two years of experience in or with mobile wireless communications and navigation systems, and this would include an understanding of how system elements work within mobile wireless communications and navigation systems.

II. CLAIM CONSTRUCTION

A. Introduction

The Board interprets claims using the "broadest reasonable construction in light of the specification of the patent in which [they] appear[]." 37 C.F.R. § 42.100(b). Unless the record shows otherwise, we presume a claim term carries its "ordinary and customary meaning," which is "the meaning that the term would have to a person of ordinary skill in the art in question" at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Petitioner requested construction of the terms "responsive to launching an application" / "in association with an application launched" and "use-specific group." Pet. 14–16. In the Institution Decision, we construed "responsive to launching an application" / "in association with an

application launched." Dec. 7–8. We also determined that no other terms required express construction for the purposes of that Decision. *Id.* at 8 (citing *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Patent Owner proposes constructions for "responsive to launching an application" / "in association with an application launched" and "use-specific group." PO Resp. 7–15. Based on the issues currently before us, we discern a need to address the construction of the term "responsive to launching an application" / "in association with an application launched" and "use-specific group." For the purposes of this Decision, no other terms require express construction.

B. Construction of "responsive to launching an application" / "in association with an application launched"

Independent claim 1 recites, in relevant part, "wherein the method is invoked responsive to launching an application." Independent claim 22 recites "wherein the second wireless device . . . is thereby selected in associat[ion] with launch of the application." Independent claim 28 requires certain claim elements to be "invoked responsive to launching an application." Petitioner advocated for these terms to be construed to mean that the steps are invoked or selected "in association with the running of the application." Pet. 15.

In the Institution Decision, the panel preliminarily determined that Petitioner's proposed construction was incorrect and, for the purposes of institution, determined that "[t]he plain meaning of launching refers to an initial running or opening of an application." Dec. 8. The panel agreed with the district court's construction, which states that "'[r]esponsive to

launching' simply places a temporal relationship on launching and the other claimed functions," while "'[i]n association with an application launched' is broader, and just requires some relationship between launching and the claimed functions." *Id*. (citing *X One, Inc. v. Uber Techs., Inc*., No. 5:16-cv-6050-LHK, 2017 WL 3581184, *22 (N.D. Cal. Aug. 18, 2017)). Patent Owner urges us to "maintain [the] construction from the Institution Decision and apply the plain meaning of the 'launching' terms." PO Resp. 13.

The parties dispute whether "launching" is broad enough to encompass a period in which a user may provide input to the system. According to Patent Owner, "an ordinary artisan would understand that the claimed steps must occur responsive to the 'launching,' not responsive to the user input." *Id*. at 10. Mr. Sturza supports Patent Owner's contentions and testifies that "[t]he program is merely 'running,' after 'launching' has ended, when it has reached a state where the program can accept user interactions." Ex. 2004 ¶ 38. Petitioner, however, directs us to claim 22, which recites a user selecting a service provider in association with the launch of the application. Reply 4–5. We interpret this claim, in relevant part, to require that the user provide input to the system to select a service provider "in association with launch of the application." Ex. 1001, 30:53–57. Thus, claim 22 recites an association between launch and user input. For reasons that will be described below, the launching and running of an application are two different periods in the lifecycle of an application. Therefore, in order for the recited association to exist during the relevant period, the launch must be broad enough to allow for some user interaction. As such, Petitioner argues, and we agree, that Patent Owner's proposal would exclude a claimed embodiment. Reply 4–5.

In addition, a similar argument was raised before the district court. There, the court found that "a preferred embodiment which requires user input while the application is running would not be automatically excluded by [the plain meaning of] 'responsive to launching' or 'in association with an application launched.'" Ex. 2006, 40. We agree that the launch terms are broad enough to allow for some user interactions; however, we do not find the breadth of these terms to be limitless. *See generally TF3 Ltd. v. Tre Milano, LLC*, 894 F.3d 1366, 1371 (Fed. Cir. 2018) ("Above all, the broadest reasonable interpretation must be *reasonable* in light of the claims and specification.").

At the oral hearing, Petitioner's counsel argued that "[t]he method being invoked responsive to [launching] means that the launch of an application is a prerequisite for invoking the method and that the method has to happen after that launch." Tr. 11:12–14. Judge Lee asked whether Petitioner believed that shutting down a computer would be responsive to starting the computer. *Id.* at 12:2–11. Petitioner's counsel replied in the affirmative, asserting that "in order to [turn a] computer off, the computer would already have to have been turned on" and thus, in Petitioner's view, responsive to launching would encompass anything that occurred after launch. *Id.* at 11:15–13:14; *see also id.* at 7:3–8:4 (Petitioner's counsel explaining that something that occurred two days after launching an application would still be responsive to launching the application).

We are not persuaded that the terms should be construed in such a broad manner. The specification discusses loading, launching, and running an application. *See e.g.*, Ex. 1001, Abstract ("Cell phones and other wireless devices with GPS receivers have *loaded* therein a Buddy Watch application

and a TalkControl application."); 12:35–37 ("[A]pplication programs could be *loaded and run* on the phones themselves."); 25:3–5 ("Buddy Watch applications *running* on GPS enabled cell phones."); Fig. 32 ("User *launched* talkcontrol application on handset."); 26:54–56 ("A user who wished to join a walkie-talkie talk group *launches* the TalkControl application.") (emphasis added). Thus, the specification suggests that the patentee distinguished launching from running. The patentee knew how to direct its claim to the running of an application, but instead the patentee chose to direct its claim to launching the application. The patentee could have used the word "running," but instead chose a different term that implies a different scope. *See Acumed LLC v. Stryker Corp.*, 483 F.3d 800, 807 (Fed. Cir. 2007) (noting patentee's usage of language is strong evidence that the patentee considered "transverse" and "perpendicular" to have distinctly different meanings.).

We find that, in light of the specification and the plain meaning of the term, launching is not equivalent to running an application. *See* Ex. 2004 ¶ 37 (Mr. Sturza's testimony citing dictionaries in support of his statement that "[o]ne of ordinary skill in the art would have understood that the ordinary meaning of 'launching' is during a program's start up procedures"). The specification does not use these terms interchangeably; instead, launching refers to the initiation or startup of an application. *See e.g.*, *id* at Fig 32 (first step in the flow chart is launching the application on a handset); 26:51–59 (describing Figure 32 as depicting the process by which a user can initiate joining a talk group); *see also id* at Figs 34–40 (depicting launching as the initial step). Thus, the claims require the recited activities to be "responsive to" or "in association with" the startup of the application.

Patent Owner's counsel asserts that the claims require some connectivity between launching the application and displaying the map. Tr. 26:21–27:4. Specifically, "there needs to be a connection either in time or by operation" between the launching of the application and the invocation of the recited method. *Id.* at 27:5–7. As noted above, the district court found that "'[r]esponsive to launching' simply places a temporal relationship on launching and the other claimed functions: they happen in response to launching. 'In association with an application launched' is broader, and just requires some relationship between launching and the claimed functions." Ex. 2006, 39. We agree, but in the interest of providing more specificity, we clarify that the required temporal relationship with the claimed activities is one that requires the claimed functions to occur during or near the time of startup of the application. We provide this clarification because we have determined that the temporal relationship must be anchored to the startup of the application or else the term "launch" loses its meaning. The required relationship is not shown by simply pointing out that the application was started at some point in time prior to the occurrence of the recited activities. Finding otherwise would render meaningless the distinction between launching and running an application because the specification and plain meaning of the term indicate that launching is the startup of the application and running indicates the continued operation of that application. We are charged with giving the claim terms their broadest reasonable interpretation in light of the specification and that charge includes respecting the patentee's specific word choice and giving that choice the appropriate meaning and emphasis. Therefore, we find that the plain meaning of "responsive to launching" requires that there be a temporal relationship between the startup

of the recited application and the occurrence of the other recited activities and "associated with launch" is a broader term that requires a relationship between the startup of application and the recited activities.

III. ANALYSIS

A. Analysis of Asserted Ground of Obviousness Based on Konishi

Petitioner argues that claims 1, 5, 7, 10, 11, 22, 23, 28, 33, 36, 37, and 40–42 would have been obvious over Konishi. Pet. 16–42. Petitioner's assertions are supported by a declaration from Dr. Bartone. Ex. 1003.

1. Overview of Konishi

Konishi is a Japanese unexamined patent application publication titled "Vehicle Search System and Vehicle Allocation System Using the Vehicle Search System." Ex. 1012 at [54]. Konishi discloses a system "[t]o enable a customer to easily search for the status of vacant vehicles located within a prescribed range from the current position of the customer on a map and displaying the positions on the screen of the customer's information terminal." *Id*. at Abstract. Figure 1 of Konishi is reproduced below.

[FIG. 1]

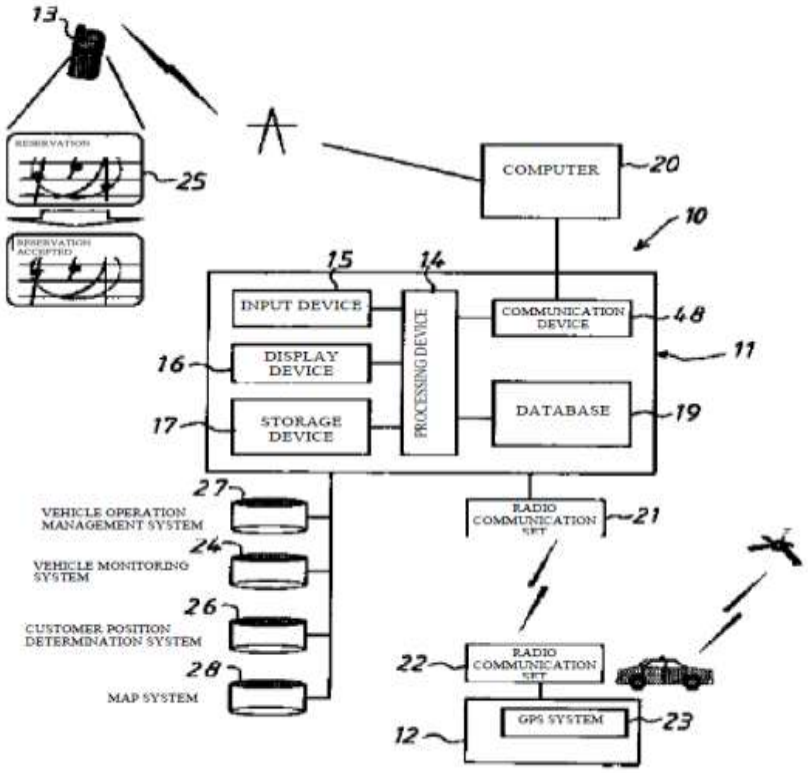

Figure 1 depicts Konishi's system, which includes information processing device 11, vehicle information terminal 12 mounted in each vehicle, and mobile telephone set 13 that is used as a customer information terminal. *Id.* ¶ 26. In Konishi's system, each vehicle has a terminal with a GPS system for detecting the vehicle's position. *Id.* ¶ 27. When a customer selects a vehicle allocation service with their mobile telephone, the system determines the customer's position through their mobile phone, and locates vacant vehicles within a prescribed range from customer. *Id.* ¶¶ 28–30. When there is a vacant vehicle suitably close to the requesting customer, the system "reads out a map . . . with the customer position in the center," and "inputs the customer position and the current position of the retrieved vacant vehicle." *Id.* ¶ 31. The system then transmits the information to the mobile

telephone, and the information is displayed on the customer's screen. *Id.* If the customer makes a reservation and a vehicle accepts the reservation, vehicles other than the reserved vehicle are no longer displayed and the customer's mobile phone is updated at regular time intervals to display the current position of the reserved vehicle as it approaches. *Id.* ¶ 33.

2. Claim 1

Petitioner alleges that Konishi teaches "[a] method of tracking proximity of position associated with a first wireless device relative to a position of a second wireless device, wherein one of the first wireless device and the second wireless device is associated with a provider of a desired service and the other of the first wireless device and the second wireless device is associated with a requestor of the desired service." *See* Pet. 19–20 (citing Ex. 1012 ¶¶ 25–35; Ex. 1003 ¶¶ 80–81). Petitioner further asserts that Konishi teaches "causing receipt of information on the first wireless device representing the position of the second wireless device and a map associated with the position associated with the first wireless device and the position of second wireless device" and "causing display of the map on the first wireless device with position associated with the first wireless device and the position of the second wireless device rendered thereon." *See id.* at 21–22 (citing Ex. 1012 ¶¶ 33, 35; Ex. 1003 ¶ 84). In addition, Petitioner contends that Konishi teaches "wherein the causing of the update is to be performed to indicate proximity of and direction between position of the provider of the desired service and position associated with the requestor of the desired service." *See id.* at 22–23 (citing Ex. 1012 ¶¶ 31–33, 35; Ex. 1003 ¶¶ 84–86, 88). Petitioner also argues that Konishi teaches "wherein the provider is selected in connection with the request for the desired service

and the method further comprises forming a use-specific[7] group to have the first wireless device and the second wireless device in connection with the request for the desired service." *See id.* at 24–25 (citing Ex. 1012 ¶¶ 29–32, 33–35, 39, 41; Ex. 1003 ¶ 91). We find these contentions to be well supported by the record and undisputed by Patent Owner.

Patent Owner argues that Petitioner's contentions fail as to the recited "method [being] invoked *responsive to launching an application* on the first wireless device." PO Resp. 17–40 (emphasis added). As to this limitation, Petitioner contends that "Konishi discloses that the operation of the vehicle allocation system 10 starts when 'the customer selects a vehicle allocation service with the mobile telephone set 13.'" Pet. 23 (citing Ex. 1012 ¶ 29, Fig. 2). Petitioner also alleges that "Konishi further discloses that 'execution of the program is terminated' if the customer does not make a reservation." *Id.* at 24 (citing Ex. 1012 ¶ 32). Petitioner further asserts that "Konishi does not expressly disclose a customer launching an application. A skilled artisan, however, would understand from Konishi's teachings that a customer would launch an application on his mobile phone before selecting the vehicle allocation service and terminate the application if he chooses not to make a reservation." *Id.* (citing Ex. 1003 ¶ 89). Dr. Bartone supports Petitioner's allegations with his testimony that "a person of ordinary skill in the art would have understood that various methods could be invoked in response to a user launching an application on a wireless device to request a service." Ex. 1003 ¶ 90. He also testified that a skilled artisan would have

[7] Patent Owner argues the construction of "use-specific group," but it does not put forth any arguments based on this limitation. *See* PO Resp. 13–15; Reply 7.

read Konishi and understood that, in order for Konishi's application to be terminated, it first must have been launched prior to any termination of that application. *Id.* ¶ 89.

According to Patent Owner, "Konishi does not disclose any application software on the mobile device. In Konishi's system, such application software would be unnecessary." PO Resp. 18. Thus, Konishi's system would not teach launching of an application because it does not need an application. *Id.* We disagree. As Petitioner points out, "Konishi's system transmits and displays messages (e.g., "no vacant vehicles") on a user's mobile phone's screen. The mobile phone would have application software running to display the message." Reply 9 (citing Ex. 1012 ¶¶ 30–31, Ex. 1034 111:19–113:9; Ex. 1035 ¶ 19) (internal citations omitted). We find Petitioner's evidence to be sufficient to establish the presence of relevant application software on the mobile device. The question remains, however, whether Petitioner has established a sufficient temporal relationship between the launch of the application and the invocation of the recited method.

Petitioner contends that "Konishi does not expressly disclose a customer launching an application. A skilled artisan, however, would understand from Konishi's teachings that a customer would launch an application on his mobile phone before selecting the vehicle allocation service and terminate the application if he chooses not to make a reservation." Pet. 24 (citing Ex. 1003 ¶ 89). We agree that Konishi lacks an explicit disclosure of the launch of application and, thus, lacks an explicit teaching of the occurrence of any activities in a manner that is responsive to the launch. Thus, based on a plain reading of Konishi, it is unclear when an

application is launched and, as such, there is no stated temporal relationship between the launch of any application and the invocation of the recited method. In the absence of clear disclosure, it is Petitioner's burden to demonstrate that the required temporal relationship would have been obvious in light of Konishi's disclosures.

In its Reply, Petitioner argues that "[a person of ordinary skill in the art] would understand that application software for the vehicle search and allocation system would be launched before such user interface controls would be displayed and could receive user input." Reply 10 (citing Ex. 1035 ¶ 21). Dr. Bartone supports Petitioner's argument by providing explanation as to why "the application software *would have been launched and would be running* on the mobile phone." Ex. 1035 ¶ 21 (emphasis added). Dr. Bartone also provides credible testimony as to why we should interpret Konishi's discussion of terminating an application as describing the termination of the application software resident on the mobile device. *Id.* ¶ 23.

This evidence, however, falls short of what is required under our construction of "responsive to launching." *See supra* § II.B. Petitioner has established that an application is running on the mobile device and, thus, the application was launched at some point in time prior to the recited mapping activities. Petitioner, however, fails to provide sufficient evidence that one of ordinary skill in the art would have found it obvious to invoke the method responsive to the startup of the application. As described above, it is not enough to show that the application was launched, but rather there must be a showing as to the temporal relationship between the launch of the application and the recited method. This limitation is not met by merely

showing that the application was launched at some point in time because we must give proper weight to a patentee's choice to link the invocation of the method to the launch of the application and not to the running of the application. Thus, the evidence presented in this matter indicates that Konishi teaches that an application is launched, but the evidence fails to provide the necessary connection between Konishi's application startup and method invocation.

For the foregoing reasons, Petitioner has not established by a preponderance of the evidence that claim 1 would have been obvious over Konishi.

3. Claims 5, 7, 10, 11, 22, 23, 28, 33, 36, 37, and 40–42

Independent claim 28 contains similar language to that discussed above in regards to claim 1 ("invoked responsive to launching an application"). Petitioner's arguments as to the limitation are the same as those discussed above in regards to claim 1. Pet. 32. Thus, for the reasons discussed above, Petitioner's arguments do not make the required showing to establish that claim 28 would have been obvious over Konishi.

Independent claim 22 is broader than claims 1 and 28 in that it recites "selecting the provider of the desired service in association with an application launched . . . wherein the second wireless device is associated with the provider and is thereby selected in associated with launch of the application." Thus, claim 22 requires the selection of a service and a wireless device in association with the startup of the recited application. *See* § II.B. Petitioner contends that "Konishi does not expressly disclose a customer launching an application. A skilled artisan, however, would understand that the vehicle that accepts the reservation is selected in

association with the customer launching an application on the mobile device, and the second wireless device is associated with the provider and is selected in association with the launch of the application." Pet. 26. Dr. Bartone testifies that "the customer would have previously launched the application." Ex. 1003 ¶ 94. Petitioner's evidence is insufficient because it does not establish any relationship between the startup of the application and the required selection beyond noting that the application must have been started at some point in time prior to the selection. Petitioner cannot satisfy its burden by merely showing that the application was running and, thus, it must have been launched at some point in time prior to selection because this argument does not respect the patentee's choice to associate the required actions with the application launch as opposed to associating with just the running of an application. Therefore, for the reasons discussed above, Petitioner's arguments do not make the required showing to establish that claim 22 would have been obvious over Konishi. Further, we find that Petitioner's allegations are insufficient as to the dependent claims 5, 7, 10, 11, 23, 33, 36, 37, and 40–42 that depend from claims 1, 22 and 28.

B. Analysis of Asserted Ground of Obviousness Based on Konishi and Rautila

Petitioner alleges that claims 1, 4, 5, 7, 10, 11, 22, 23, 28, 31, 33, 36, 37, and 40–42 would have been obvious over the teachings of Konishi and Rautila. Pet. 42–46. Petitioner's allegations are supported by a declaration from Dr. Bartone. Ex. 1003.

1. Overview of Rautila

Rautila is a U.S. Patent titled "System and Method for the Transfer of Digital Data to a Mobile Device." Ex. 1025, at [54]. Rautila teaches a system for downloading software products from an external "electronic shop server" to an internet-capable cellular phone, which can then execute the downloaded program. *See id.* at 1:7–12, 1:49–55, 4:43–45. Rautila purports to address the high cost of downloading large amounts of data due to the time it takes for large files to be downloaded to a mobile device. *Id.* at 1:56–61. Rautila's method seeks out "hotspot network locations where the digital product may be downloaded into a mobile phone using a short range transceiver embedded in the mobile device." *Id.* at 2:62–64. Rautila details the process from entering the "electronic shop server" through downloading the requested software. *Id.* at 8:4–36; Figs. 4–7.

2. Analysis

Petitioner asserts that "[t]o the extent the Board finds that Konishi does not render obvious to a skilled artisan the limitation of claim 1 reciting that "the method is invoked responsive to launching an application on the first wireless device," this limitation would have been obvious over Konishi in view of Rautila." Pet. 45 (citing Ex. 1003 ¶¶ 136–137). Petitioner directs us to Rautila's disclosure of non-native software being downloaded and installed on a mobile phone. *Id.* (citing Ex. 1003 ¶ 137, Ex. 1025, 1:49–55, 1:62–63). Petitioner argues that it would have been obvious to obtain Konishi's application from an "electronic shop server" and to launch that application to invoke the method recited in Konishi. *Id.* at 45–46. Identifying the source for the application, however, does not remedy the deficiencies discussed above in relation to Petitioner's assertion of

obviousness over Konishi alone. Petitioner here again fails to provide any connection between launching the application and the recited activities beyond merely stating that the application launched at some point in time prior to the occurrence of the other recited activities. Thus, for reasons discussed above, we find that Petitioner has not met its burden to establish that claims 1, 4, 5, 7, 10, 11, 22, 23, 28, 31, 33, 36, 37, and 40–42 would have been obvious over the teachings of Konishi and Rautila.

C. Other Grounds Based on Konishi

Petitioner asserts claims 6, 24, and 32 would have been obvious over Konishi and Adamczyk. Pet. 46–49. Petitioner asserts claims 8, 9, 25, 34, 35, and 45 would have been obvious over Konishi and Makoto. *Id*. at 49–54. Petitioner asserts claims 13, 27, and 39 would have been obvious over Konishi and Knotts. *Id*. at 54–58. Petitioner's assertions are supported by a declaration from Dr. Bartone. Ex. 1003. Petitioner's assertions as to these dependent claims do not address the deficiency we discussed above in regards to Petitioner's allegations of obviousness over Konishi. Thus, for reasons discussed above, we find that Petitioner has not met its burden to establish that claims 6, 8, 9, 13, 24, 25, 27, 32, 34, 35, 39, and 45 would have been obvious over Konishi and Adamczyk, Makato, or Knotts.

D. Analysis of Alleged Obviousness over Mitsuoka

Petitioner argues that claims 1, 5, 6, 7, 10, 11, 22, 23, 24, 28, 32, 33, 36, 37, and 40–42 are unpatentable under 35 U.S.C. § 103(a) over Mitsuoka. Pet. 58–69. Petitioner's assertions are supported by a declaration from Dr. Bartone. Ex. 1003.

1. Overview of Mitsuoka

Mitsuoka is a Japanese Unexamined Patent Application titled "Vehicle Dispatch Guidance System and Vehicle Dispatch Guidance Method." Ex. 1015, at [54]. Mitsuoka recognized that users requesting taxi service had no means to track the status of the taxi and thus, users were unsure as to when a requested taxi would arrive. *Id.* ¶ 3. Mitsuoka teaches searching a map based on a taxi requestor's location and extracting "map data for the vicinity of the user." *Id.* at Abstract. If an available taxi is within the vicinity map, the system adds display data representing the user's location to data representing the available taxi's location, and transmits the data and vicinity map to a portable display terminal. *Id.* Figure 2 of Mitsuoka is reproduced below.

[FIG. 2]

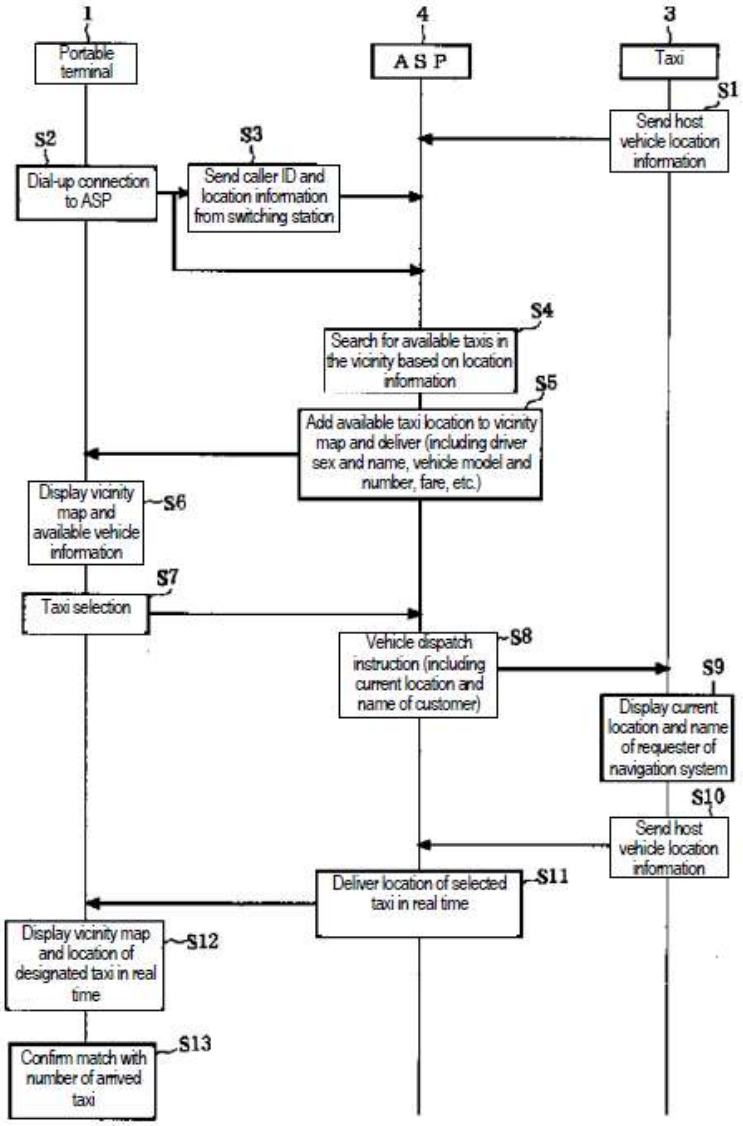

Figure 2 depicts "a sequence diagram illustrating the essential operation of said system. *Id.* ¶ 25. A taxi's location is determined via GPS navigation system and that location is displayed on a map shown on the display unit. *Id.* "[T]o request dispatch of a taxi 3, the user makes a dial-up connection to ASP 4 from the user's own portable terminal 1," which may be a portable telephone. *Id.* ¶¶ 2, 26. Application Service Provider ("ASP") 4 receives

the location information for the user's portable terminal 1. *Id.* ¶ 26. ASP 4 also receives the location information for the taxis in the area. *Id.* ¶ 27. "The control unit 14 of ASP 4 then searches the map data of map DB 15 in step S4 based on location information of portable terminal 1 . . . and extracts map data for the vicinity of the current location of portable terminal 1." *Id.* If there is an available taxi in the vicinity of the user, then in step S5, an image representing the taxi is added to the map. *Id.* ¶ 28. "The map information representing the location of the user and of the available taxis present in the vicinity of the user along with a map of the vicinity of the user . . . is delivered to portable terminal 1 via management device 11." *Id.* In step S7, the user selects the tax based on the map information and then that tax is dispatched to the user in step S8. *Id.* ¶ 29. The user's location also is displayed on the taxi's GPS. *Id.* ¶ 31.

2. Claim 1

Petitioner alleges that Mitsuoka teaches "a method of tracking the proximity of position between a wireless device of a customer seeking a desired service (e.g., a ride) and a service provider offering the desired service." Pet. 60 (citing Ex. 1015 ¶¶ 19, 21, Figs. 1, 2; Ex. 1003 ¶¶ 157–159). Petitioner further asserts that Mitsuoka teaches "causing receipt of information on the first wireless device representing the position of the second wireless device and a map associated with the position associated with the first wireless device and the position of second wireless device" and "that the 'vicinity of the user is displayed on the display unit of the user's portable terminal 1, along with taxis 3A, 3B currently traveling at certain points on the map.'" *Id.* at 61 (citing Ex. 1015 ¶ 19, Fig. 4; Ex. 1003 ¶¶ 160–161). In addition, Petitioner contends that Mitsuoka teaches

"successively acquir[ing] location information" from the selected vehicles and generating a map to display this location information such that a user can track the movement of a dispatch vehicle in real time. *Id.* at 62 (citing Ex. 1015 ¶ 42, 21; Ex. 1003 ¶ 162). Further, Petitioner alleges that Mitsuoka teaches that the map of the user and taxi position is updated so that the user may track his location relative to the location of the taxi in real time and Petitioner asserts that one of ordinary skill would have understood this to indicate the proximity and direction between the user and taxi. *See id.* at 62 (citing Ex. 1015 ¶ 42; Ex. 1003 ¶¶ 163–164). Petitioner also argues that Mitsuoka teaches that the user may select a specific taxi and after that selection a use-specific[8] group of the taxi and user is formed by "generat[ing] vehicle display data for the selected vehicle so as to be distinguishable from the vehicle display data for non-selected vehicles." *Id.* at 63 (citing Ex. 1015 ¶¶ 7, 30; Ex. 1003 ¶ 166). We find these contentions to be well supported by the record and undisputed by Patent Owner.

Patent Owner argues that Petitioner's contentions fail as to the recited "method [being] invoked *responsive to launching an application* on the first wireless device." Supp. PO Resp. 3–12. As to this limitation, Petitioner contends Mitsuoka teaches requesting a taxi via a dial up connection to ASP 4 from the user's portable telephone. Pet. 62 (citing Ex. 1015 ¶¶ 2, 26). Further, Petitioner asserts that "[a] skilled artisan would have found it obvious for the method of claim 1 to be invoked in response to running of an application on the mobile device." *Id.* at 61–62 (citing Ex. 1003 ¶ 165).

[8] Patent Owner argues the construction of "use-specific group," but it does not put forth any arguments based on this limitation. *See* PO Resp. 13–15; Reply 7.

Patent Owner argues that "Mitsuoka's software runs on its centralized 'Application Service Provider' – it is not an application on a wireless device. Further, Petitioner has identified no steps responsive to or associated with launching a device-based application." Supp. PO Resp. 2. Petitioner directs us to Mitsuoka's discussion of its portable terminal displaying maps as evidence of the existence of an application on the terminal. Supp. Reply 4 (citing Ex. 1015 ¶ 21, Fig. 4). Petitioner asserts that "[a person of ordinary skill in the art] would have found it obvious to invoke the method in response to launching an application on the mobile device even though Mitsuoka does not expressly state that an application is launched." *Id*. at 2 (citing Pet. 62–64; Ex. 1015 ¶¶ 19–21; Ex. 1003 ¶¶ 165, 170). Thus, here again we are faced with the question as to whether Petitioner has put forth sufficient evidence to establish the obviousness of a sufficient temporal relationship between the launch of the application and the invocation of the recited method.

Paragraphs 19–21 of Mitsuoka are cited by Petitioner in support of its contention. These paragraphs describe the flow of data between ASP 4, the user's portable terminal, and the taxi's system. *See* Ex. 1015 ¶¶ 19–21. For example, ASP 4 transmits map data to the portable terminal for display. *Id.* ¶ 19. Dr. Bartone testifies that "[a] person of ordinary skill would therefore understand that the method of claim 1 is invoked in response to launching an application on the mobile device in connection with a request from the requestor for the desired service." Ex. 1003 ¶ 165. He, however, does not provide an explanation as to why one of ordinary skill in the art would have made this connection between the launch of an application and the invocation of the method. In this Supplemental Declaration, Dr. Bartone

adds more to his explanation, stating that "[a] person of ordinary skill in the art would understand that the application on the portable terminal would be launched before it would connect with the Application Service Provider to receive a map with available taxis, display the map, allow a user to make a selection, transmit the selection to the Application Service Provider, and receive and display real-time map updates." Ex. 1037 ¶ 6. He further opines that

> several aspects of Mitsuoka would have suggested to a person of ordinary skill in the art in 2005 that Mitsuoka's portable terminal would be implemented with an application that would be launched on the portable terminal and that would then communicate with the Application Service Provider software running on a server to request a taxi and provide the two-way mapping between the requesting user and the taxi.

Id. ¶ 10. Dr. Bartone goes on describe data/dial-up connection between Mitsuoka's portable terminal and ASP and opines that the "application launched on the portable terminal would utilize the dial-up connection to the ASP to start the process, and that the various transmissions between the portable terminal and the ASP would be between the client-side application launched on the portable terminal and the server-side application accessed on the ASP." *Id.* ¶ 20.

We find this testimony to be persuasive evidence of a relationship between the *running* application and the invocation of the method. As discussed above, however, the claim language ties the invocation of the method to the *launch* of the application and not just the running of the application. *See* § II.B. We are persuaded that an application has been launched at some point prior to the invocation of the method that however is insufficient to meet the claim limitation. The claim specifically speaks to

launch or startup of the application and as such it is not sufficient to show that the application was launched at some point prior to invocation of the method. The claims instead require a relationship between starting of the application and invocation of the method. Petitioner has not provided us with sufficient evidence to establish the obviousness of this limitation. Thus, the evidence presented in this matter indicates that an application is launched, but the evidence fails to provide the necessary connection between application startup and method invocation.

For the foregoing reasons, Petitioner has not established by a preponderance of the evidence that claim 1 would have been obvious over Mitsuoka.

3. Claims 5, 6, 7, 10, 11, 22, 23, 24, 28, 32, 33, 36, 37, and 40–42

Independent claim 28 contains similar language to that discussed above in regards to claim1 ("invoked responsive to launching an application"). Petitioner's arguments as to the limitation are the same as those discussed above in regards to claim 1. Pet. 66. Thus, for the reasons discussed above, Petitioner's arguments do not make the required showing to establish that claim 28 would have been obvious over Mitsuoka.

Independent claim 22 is broader than claims 1 and 28 in that it recites "selecting the provider of the desired service in association with an application launched . . . wherein the second wireless device is associated with the provider and is thereby selected in associated with launch of the application." Thus, claim 22 requires the selection of a service and a wireless device in association with the startup of the recited application. *See* § II.B. Petitioner contends that "Mitsuoka discloses that the user may select the desired taxi. A skilled artisan would have found it obvious for the

selection to be in association with the user launching the application on the mobile device." Pet. 64 (citing Ex. 1015 ¶ 7, Fig. 2 at S7; Ex. 1003 ¶ 170) (internal citations omitted). Dr. Bartone testifies with further elaboration that "[a] person of ordinary skill in the art would further understand that the selection is in association with the user launching the application on the mobile device." Ex. 1003 ¶ 170. Petitioner's evidence is insufficient because it does not establish any relationship between the startup of the application and the required selection. Petitioner cannot satisfy its burden with Dr. Bartone's conclusory statement. Dr. Bartone does not support Petitioner's argument with a sufficient explanation as to why one of skill in the art would have understood such an association to exist.

Therefore, for the reasons discussed above, Petitioner's arguments do not make the required showing to establish that claim 22 would have been obvious over Mitsuoka. Further, we find that Petitioner's allegations are insufficient as to the dependent claims 5, 6, 7, 10, 11, 23, 24, 32, 33, 36, 37, and 40–42 that depend from claims 1, 22, and 28.

4. Conclusion

Thus, for reasons discussed above, Petitioner has not met its burden to prove that claims 1, 5, 6, 7, 10, 11, 22, 23, 24, 28, 32, 33, 36, 37, and 40–42 would have been obvious over Mitsuoka.

E. Analysis of Asserted Ground of Obviousness Based on Mitsuoka and Rautila

Petitioner alleges that claims 1, 4, 5, 7, 10, 11, 22, 23, 28, 31, 33, 36, 37, and 40–42 would have been obvious over the teachings of Konishi and Rautila. Pet. 68–69. Petitioner's allegations are supported by a declaration from Dr. Bartone. Ex. 1003.

Petitioner relies upon its arguments as to Konishi and Rautila to support its challenge based on Mitsuoka and Rautila. Pet. 69 ("For the same reasons discussed above in § VI.B, it would have been obvious to combine Rautila with the teachings of Mitsuoka, and, for the same reasons, such a combination renders obvious [the challenged] claims."). Thus, this challenge fails for the same reasons discussed above in regards to Petitioner's challenge based on Konishi and Rautila. *See supra* § III.B.2. Therefore, for reasons discussed above, we find that Petitioner has not met its burden to establish that claims 1, 4, 5, 7, 10, 11, 22, 23, 28, 31, 33, 36, 37, and 40–42 would have been obvious over the teachings of Mitsuoka and Rautila.

F. Other Grounds Based on Mitsuoka

Petitioner asserts claims 8, 9, 25, 34, 35, and 45 would have been obvious over Mitsuoka and Makoto. Pet. 69. Petitioner asserts claims 13, 27, and 39 would have been obvious over Mitsuoka, Konishi and Knotts. *Id.* at 69–70. Petitioner's assertions are supported by a declaration from Dr. Bartone. Ex. 1003. Petitioner's assertions as to these dependent claims do not address the deficiency we discussed above in regards to Petitioner's allegations of obviousness over Mitsuoka. Thus, for reasons discussed above, we find that Petitioner has not met its burden to establish that claims 8, 9, 13, 25, 27, 34, 35, 39, and 45 would have been obvious over Mitsuoka and Makato or Mitsuoka, Konishi, and Knotts.

IV. MOTION TO EXCLUDE

In *inter partes* review proceedings, documents are admitted into evidence subject to an opposing party asserting objections to the evidence and moving to exclude the evidence. 37 C.F.R. § 42.64. As movant, Patent

Owner has the burden of showing that an objected-to exhibit is not admissible. 37 C.F.R. § 42.20(c). For the reasons discussed below, we deny-in-part and dismiss-in-part Patent Owner's Motion to Exclude. [9]

A. Exhibits 1008–1016

Patent Owner moves to exclude Exhibits 1008–1016[10], which include sworn statements from Angela Lo (Exs. 1010, 1013, and 1016 ("the Lo affidavits")) filed in support of accuracy of the translations of Makoto (Ex. 1009), Konishi (Ex. 1012), and Mitsuoka (Ex. 1015). *See* Mot. 2–8; Mot. Reply 2. Patent Owner contends that the Lo affidavits are deficient because (1) Ms. Lo did not did not personally translate the documents, and the declarant cannot attest to the accuracy of a translation as required under the Federal Rules of Evidence; (2) the Lo affidavits are improper because they do not include a warning that willful false statements and the like are punishable by fine or imprisonment; and (3) the Lo affidavits are hearsay. Mot. 2–8; Mot. Reply 2. Patent Owner further alleges that the issues related to the Lo affidavits cannot be cured by reliance on subsequent declarations filed (Exs. 1029–1032) because the later filed declarations violate Rule 42.63(b). *Id*. at 5. Petitioner opposes the Motion.

We have reviewed the Motion, Opposition, and Reply, and we do not agree with the Patent Owner that it is required that the Lo affidavits come from the translator of the documents. Rule 42.63(b) requires that "[w]hen a party relies on a document . . . in a language other than English, a translation

[9] Patent Owner's Motion also sought to exclude Exhibits 1017–1019, but that portion of the Motion has been withdrawn. Mot. Reply 5.

[10] We address Exhibits 1005–1007 below.

of the document into English and an affidavit attesting to the accuracy of the translation must be filed with the document." Rule 42.63 does not specify which individuals may provide such an affidavit. Patent Owner relies upon Federal Rules Evidence 602 and 603 in support of its allegation that Ms. Lo is an improper affiant. Under Rule 602, "[a] witness may testify to a matter only if evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter." Rule 603 states that "a witness must give an oath or affirmation to testify truthfully. It must be in a form designed to impress that duty on the witness's conscience." We are not persuaded that Ms. Lo's affidavits violate either of those rules of evidence.

Evidence to prove personal knowledge may consist of the witness's own testimony. The Federal Rules of Evidence require "a witness who testifies to a fact which can be perceived by the senses must have had an opportunity to observe, and must have actually observed the fact." Fed. R. Evid. 602 Advisory Committee's Note. Ms. Lo's affidavits state that the translation is "to the best of my knowledge and belief," that the translated document represents a "true and accurate translation from Japanese into English," and that the translation "has been verified to be an accurate and complete rendering of the original document." *See e.g.*, Ex. 1010. We find that these statements, which are made on the letterhead of the translation company, contain sufficient indicia to support the admissibility of the affidavit because they specifically identify the document translated, the languages the document is translated to and from, the person that translated the documents, and the purported experience of that translator. *Id.* Patent Owner was free to cross examine Ms. Lo as to her affidavit, but in the

absence of cross examination we are left with sworn and unrebutted testimony as to the accuracy of the underlying translations.

In addition, we note that Rule 42.2 specifies that an "[a]ffidavit means affidavit or declaration under § 1.68 of this chapter." (emphasis added). Patent Owner asserts that Ms. Lo's affidavits must meet the rules for declarations specified in Rule 1.68. This is unnecessary because 28 U.S.C. § 1746 describes the requirements for using an "unsworn declaration" in place of a "sworn declaration." The Lo affidavits contain sworn testimony before a notary public, and as such § 1746 does not apply. *See e.g.*, Ex. 1010 (stating "Sworn to before me this January 11, 2017").

Further, Patent Owner does not explain why the Lo affidavits are hearsay, short of an allegation of lack of personal knowledge. *See* Mot. Reply 2. In this context, lack of personal knowledge in making an averment, however, pertains to credibility of the witness, not inadmissibility of evidence as hearsay.

As for other alleged failures of the Lo affidavits under Rule 42.63(b), any alleged deficiencies were remedied when Petitioner filed Exhibits 1029, 1030, and 1032, which are declarations of the translators for translated documents, Exhibits 1009, 1012, and 1015.[11] Additionally, the declarations in Exhibits 1029, 1030, and 1032 contain statements that willful false statements are punishable by fine and imprisonment. *See e.g.*, Ex. 1029. Accordingly, we deny Patent Owner's motion to exclude the translations of

[11] We granted Petitioner's motion to file the supplemental declarations, in part, because the information in the supplemental declarations "constitutes additional support that allegedly confirms the accuracy of translations of prior art" and the filing could "obviate the need for filing additional authenticating documents in the future." *See* Paper 20, 5.

prior art references, Makoto, Konishi, and Mitsuoka (Exs. 1009, 1012, and 1015), their untranslated versions (Exs. 1008, 1011, and 1014), and associated declarations in support of the translations (Exs. 1010, 1013, and 1016).

B. Exhibits 1005–1007, 1020, and 1022

Patent Owner moves to exclude Exhibits 1005–1007, 1020, and 1022 as not being relevant to this proceeding because they were not relied upon by Petitioner in its Petition, Reply, or Dr. Bartone's supporting declarations. Mot. 8, 11–12. Petitioner responds that the exhibits were included to provide consistency between this proceeding and the IPR2017-01255 proceeding, and to the extent the Board does not rely on these exhibits, the Motion to Exclude should be dismissed as moot. Opp. To Mot. 11.

Neither party has relied, substantively, on any of Exhibits 1005–1007, 1020, and 1022. In addition, we have not relied upon these exhibits in reaching this Final Written Decision. Accordingly, we dismiss the Motion to Exclude these exhibits as moot.

V. CONCLUSION

Based on the arguments in the Petition, as well as the evidence of record, we determine that Petitioner has not demonstrated by a preponderance of the evidence that claims 1, 4–11, 13, 22–25, 27, 28, 31–37, 39–42, and 45 of the '647 patent would have been obvious over Konishi or Mitsuoka alone or in combination with Rautila, Adamczyk, Makato, or Knotts.

VI. ORDER

For the reasons given, it is

ORDERED that Petitioner has not demonstrated by a preponderance of the evidence that claims any one of 1, 4–11, 13, 22–25, 27, 28, 31–37, 39–42, and 45 of U.S. Patent No. 8,798,647 B1 are unpatentable;

FURTHER ORDERED that the Motion to Exclude as to Exhibits 1008–1016 is denied and the Motion to Exclude as to Exhibits 1005–1007, 1020, and 1022 is dismissed as moot; and

FURTHER ORDERED that because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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