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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE, INC.  
Requester and Appellant

v.

TIERRAVISION, INC.  
Patent Owner and Respondent

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Appeal 2018-007234  
Reexamination Control 95/001,801  
Technology Center 3900  
Patent RE 41,983 E

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Before RICHARD M. LEBOVITZ, JOHN A. JEFFERY, and  
ERIC B. CHEN, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION ON EXAMINER'S DETERMINATION  
UNDER 37 C.F.R. § 41.77(d)

This is a decision under 37 C.F.R. § 41.77(f) on the Examiner's determination under 37 C.F.R § 41.77(d) maintaining the rejections of claims 60–77, 86–91, 93, 95, 97–99, 101, 107, 109, and 111. We have jurisdiction under 35 U.S.C. §§ 6(b), 134, and 315. We affirm.

In a prior Decision on Appeal, entered April 28, 2017, we reversed the Examiner's decision not to reject claims 60–68, 86–91, 93, 95, and 97 under 35 U.S.C. §§ 102(b) and 103(a), as proposed and appealed by Requester Google, Inc. These rejections were entered in the Board decision as a new ground of rejection pursuant to 37 C.F.R. § 41.77(b), as follows:

1. Claims 60–66, 68, and 86 are rejected under 35 U.S.C. § 102(b) as anticipated by Phelan (WO 97/07467 A1; Feb. 27, 1997).

2. Claims 67, 87–91, 93, 95, and 97 are rejected under 35 U.S.C. § 103(a) as unpatentable over various combinations of Phelan, Zavoli (Walter Zavoli et al., *Customer Location Services*, VEHICLE NAVIGATION & INFO. SYS. CONF. PROC. 613–17 (IEEE 1994)), Israni (US 6,308,177 B1; Oct. 23, 2001), Delorme (US 4,972,319; Nov. 20, 1990), and Kimoto (JP H10-13961; Jan. 1998).<sup>1</sup>

We also reversed the Examiner's decision not to reject claims 69–77, 98, 99, 101, 107, 109, and 111 under 35 U.S.C. § 103(a) as proposed by Requester Google, Inc., as follows:

3. Claims 69–77, 98, 99, 101, 107, 109, and 111 are rejected under 35 U.S.C. § 103(a) as unpatentable over various combinations of Machii (US

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<sup>1</sup> Patent Owner does not present any arguments with respect to the rejection of claims 67, 87–91, 93, 95, and 97 under 35 U.S.C. §103(a). Thus, any such arguments are deemed to be waived.

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6,324,467 B1; Nov. 27, 2001), Zavoli, Nakano (WO 00/31663; Feb. 6, 2000), and Davies (US 6,247,019 B1; June 12, 2001).<sup>2</sup>

Patent Owner Tierravision, Inc. submitted a Request to Reopen Prosecution Under 37 C.F.R. § 41.77(b)(1), dated May 26, 2017 (“Request”), accompanied by arguments and additional evidence, as follows:

A. Supplemental Declaration under 37 C.F.R. § 1.132 of Zaydoon Jawadi, dated May 26, 2017;

B. Supplemental Declaration under 37 C.F.R. § 1.131, by Alfred M. Wallner, dated May 26, 2017, accompanied by Exhibits LL–MMM.

In response to Patent Owner’s Request, Requester filed written comments to Patent Owner’s Request, dated June 23, 2017 (“Requester § 41.77(c) Comments”) also accompanied by additional evidence in the form of a Third Declaration of Michael S. Braasch, Ph.D., under 37 C.F.R. § 1.132, accompanied by Exhibit A, dated June 23, 2017.

The Examiner determined that claims 60–77, 86–91, 93, 95, 97–99, 101, 107, 109, and 111 were unpatentable and issued a Determination under 37 C.F.R. § 41.77(d), dated March 16, 2018 (“Determination”).

Patent Owner submitted a Patent Owner Reply, dated April 16, 2018 (“PO § 41.77(e) Comments”).

Requester submitted a Requester Reply, dated May 16, 2018.

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<sup>2</sup> Patent Owner does not present any arguments with respect to the rejection of claims 101, 107, 109, and 111 under 35 U.S.C. §103(a). Thus, any such arguments are deemed to be waived.

*The Claims*

The original patent claims were amended during the reexamination proceedings. Independent claims 60 and 69 are exemplary, with disputed limitations in italics and underlining and bracketing to illustrate claim amendments:

60. A map display system operating in conjunction with a portable wireless device, comprising:

- an input interface layer handling communication between a user and the device and being configured to capture user input position information;
- a geocoding engine, residing on a server, configured to:
  - receive user input position information from the portable wireless device;
  - compute a geodetic coordinate from the user input position information; and
  - transmit the geodetic coordinate to the portable wireless device; and
- a map display engine configured to use the geodetic [coordinates] coordinate to generate a plurality of data structure names and request the data structures from a map segment server.

69. A method of operating a map display system in conjunction with a portable wireless device, comprising:

- receiving user input position information from the portable wireless device;
- computing, at a geocoding engine at a server, a geodetic coordinate from the user input position information;
- generating, at the portable wireless device, a plurality of map segment server data structure names based on the geodetic [coordinates] coordinate, each name uniquely identifying a preexisting map segment server data structure; and*

transmitting, from the map segment server to the portable wireless device, a plurality of data structures comprising map data associated with the geodetic coordinate, the plurality of data structures [and] associated with the respective map segment server data structure names [from a map segment server].

## ANALYSIS

### *§ 102 Rejection—Phelan*

#### Claims 60–63, 65, 66, 68, and 86

The Examiner found that parameters of Phelan for generating a map request, such as “lon,” “lat,” “scale,” “xp,” and “yp” (i.e., longitude in degrees, latitude in degrees, map scale, horizontal size of the map in pixels, vertical size of the map in pixels), correspond to the limitation “data structure names.” (Determination 7.) The Examiner further found that the icons of Phelan, as illustrated in Figure 3, which are generated by the map request, correspond to the limitation “data structures.” (*Id.* at 7–8.) We agree with the Examiner’s determination.

Phelan relates to a client device that transmits names or geographical coordinates to its surrounding cellular base stations to map and overlay server computers, such that a map of the current location along with identified facilities are transmitted to the client device. (P. 5, ll. 5–13; *see also* fig. 3.) Figure 3 of Phelan illustrates a map request to a map server computer 11 from a client computer 10 that specifies geographical coordinates. (P. 8, ll. 3–6.) “The map server contains map data, including coordinate data representing the spatial coordinates of at least one point on the area represented by the map.” (P. 5, ll. 20–23.) Phelan explains that “[a]lso supplied by the map server 11 are the icons 6, 7, 8, 9, which are

displayed within the ‘info’ frame 5” such that “[i]con 6 indicates banks, icon 7 restaurants, icon 8 hotels, etc.” (P. 8, ll. 18–21.) Moreover, Phelan explains that “for client browsers capable of running Java or some other local processing capability, the response from the information server 12 specifies one or more overlay icons and associates a longitude and latitude with each.” (P. 9, ll. 28–32.)

Phelan also explains that the “map request” illustrated in Figure 3 takes the form:

`http://www.multimap.com?lon="0.1666"&lat="51.545&scale="25000"&xp="500"&yp="300".`

(P. 10, ll. 10–14.) Furthermore, Phelan explains that “[t]his map request contains parameters specifying the longitude, latitude and scale of the map, and also its dimensions in horizontal and vertical pixels (xp and yp).”

(P. 10, ll. 16–18.) Because Phelan explains that a map request contains parameters specifying the longitude (“lon”), latitude (“lat”), scale of the map (“scale”), and dimensions in horizontal pixels and vertical pixels (“xp” and “yp”), Phelan teaches the limitation “data structure names.” Moreover, because Phelan explains that overlay icons (e.g., icon 6 for banks, icon 7 for restaurants, and icon 8 for hotels,) are associated with longitude and latitude, Phelan teaches the limitation “data structures.”

First, Patent Owner argues that “Claim [60] requires that the map display engine determine the names assigned to specific data structures and then request those multiple data structures” (PO § 41.77(e) Comments 4) because “[t]he first mention of ‘data structures’ in Claim 60 is the reference to determining ‘data structure names’ and the second mention of ‘data structures’ points back to the named data structures” (*id.* 4–5). However,

even if we adopt Patent Owner’s claim construction, claim 60 is still anticipated by Phelan. In particular, the limitation “a plurality of data structure names and request the data structures from a map segment server” is broad enough to encompass Figure 3 of Phelan, which illustrates multiple icons (e.g., icon 6 for banks, icon 7 for restaurants, and icon 8 for hotels) generated by a map request to map server computer 11, each icon having identifying parameters (e.g., “lon,” “lat,” “scale,” “xp,” and “yp”).

Second, Patent Owner argues that “the single name for the single map image file does not meet the requirements of Claim 60 that multiple data structure names be generated to request multiple data structures.” (PO § 41.77(e) Comments 6.) Accordingly, Patent Owner argues, “there is no teaching in Phelan that the parameters of the HTTP request individually identify anything at all” and “[t]here is no data structure in Phelan named ‘lat,’ ‘lon,’ ‘scale,’ or any of the other parameters.” (*Id.* at 7.) However, as discussed previously, Figure 3 of Phelan illustrates multiple icons (e.g., icon 6 for banks, icon 7 for restaurants, and icon 8 for hotels) generated by a map request to map server computer 11, each icon having identifying parameters (e.g., “lon,” “lat,” “scale,” “xp,” and “yp”).

Third, Patent Owner argues that “[t]he lon, lat, scale, xp, and yp parameters of Phelan define the latitude, longitude, scale and number of pixels of the single map image file that Phelan returns to the user” (PO § 41.77(e) Comments 7–8) and accordingly, “[t]hese parameters do not define the icons; they do not refer to the icons; and they do not name the icons” (*id.* at 8). Patent Owner further points to paragraph 19 of the Supplemental Jawadi Declaration, which states that “one of ordinary skill in

the art, examining the HTTP request, would understand that the HTTP request does not identify, name, or correspond to the icons of Phelan.”

(¶ 19.) Contrary to Patent Owner’s arguments, Phelan explains that “the response from the information server 12 specifies one or more overlay icons and associates a longitude and latitude with each.” (P. 9, ll. 30–32.)

Last, Patent Owner argues that “[u]nder the proper construction that data structures means map segments, Phelan fails to anticipate Claim 60 for the additional reason that Phelan does not disclose requesting multiple map segments” because “Phelan discloses requesting only a single map image to fit the user’s screen, while the ’983 Patent discloses how to divide a map into segments and request multiple map segments.” (PO § 41.77(e) Comments 10.) Patent Owner further points to paragraph 19 of the Supplemental Jawadi Declaration, which states the following:

Reading the disclosure of Phelan, one of ordinary skill in the art would understand that Phelan describes generating a request for a single map, not the multiple data segments of the ’983 Patent, and that single map is created upon request rather than pre-existing within a set of map segments.

(¶ 19.) However, Patent Owner’s arguments are not commensurate in scope with claim 60, because the claim does not require “data structures” to be map segments. In particular, dependent claim 61, which depends upon claim 60, further limits the claimed “data structure” to “wherein at least one of the plurality of data structures comprises a file.” The importation of a narrow embodiment (e.g., multiple map segments) into the broader independent claim 60 is improper. *See SuperGuide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“For example, a particular

embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.”)

Accordingly, we agree with the Examiner that the rejection of claims 60–63, 65, 66, 68, and 86 under 35 U.S.C. § 102(b) as anticipated by Phelan should be maintained.

#### Dependent Claim 64

The Examiner found that map server computer 11 of Phelan, in which map requests are centered along latitude and longitude, and the movable map window of Phelan, in which a user can zoom in and out for more detail from client computer 10, collectively correspond to the limitation “wherein the map image comprises a slightly zoomed-in map image, which is centered at the geodetic coordinate.” (Determination 10.)

Phelan explains that “[a] map request to a map server computer 11 from the client computer 10 specifies the geographical coordinates of the map,” such that “[t]he coordinates may be supplied to the map server 11 as the latitude and longitude in degrees of the centre point of the map and its scale.” (P. 8, ll. 4–10.) Moreover, Phelan explains that “[t]he architecture of the preferred system is such that it can support a movable map window” such that “[a] user can scroll North, South, East or West on the screen and see more detail appear, and can zoom in and out for more detail or for a wider perspective using the zoom.” (P. 13, ll. 19–23.) Because Phelan explains that the map from map server 11 can be retrieved based on latitude and longitude of the center and that the user can zoom in on a map, Phelan

discloses the limitation “wherein the map image comprises a slightly zoomed-in map image, which is centered at the geodetic coordinate.”

Patent Owner argues that “one of ordinary skill in the art would understand that Claim 64 is reciting the preferred method of centering the image comprised of multiple map segments.” (PO § 41.77(e) Comments 10.)

Patent Owner also points to paragraph 29 of the Supplemental Jawadi Declaration, which states the following:

As explained previously, the '983 Patent discloses how a wireless device can receive pre-partitioned map segments from the server and then assemble these segments into a single map image to display to the device. In order to improve centering of the map image on the location of interest, the wireless device can stitch together these various map segments and “gener[ate] a slightly zoomed-in map picture centered at said coordinate.” Reading this disclosure, one of ordinary skill in the art would understand that Claim 64 is reciting the preferred method of centering the image comprised of multiple map segments.

(¶ 29 (citations omitted).) However, the Supplemental Jawadi Declaration merely provides a summary a single embodiment from the '983 patent and merely provides a conclusory statement, without additional explanation, that “one of ordinary skill in the art would understand that Claim 64 is reciting the preferred method of centering the image comprised of multiple map segments.” Moreover, Patent Owner’s arguments are not commensurate in scope with claim 64 because the claim does not require multiple map segments, much less “stitch[ing] together these various map segments.”

Patent Owner further argues that “Phelan does not disclose preparing a slightly zoomed-in map image to ensure that the map image is centered on a coordinate when displayed” because “Phelan is merely disclosing the ability to zoom in and out of a previously displayed map image.” (PO

§ 41.77(e) Comments 11.) Patent Owner also points to paragraphs 30–31 of the Supplemental Jawadi Declaration, which state the following:

The only “zooming-in” that Phelan discloses is the ability to zoom in and out on a map window that is already displaying a map. Thus, Phelan does not disclose preparing a zoomed in map image to ensure that the map image is centered on a coordinate when displayed. Phelan merely discloses the ability to zoom-in and out of a previously displayed map image. . . .

Phelan generates a new map image for each request from the client, thus the map will automatically be centered on the location of interest. There is no need for Phelan to perform any zooming-in step to center the map, like what is claimed by Claim 64.

(¶¶ 30–31.) However, even if Patent Owner’s statements are correct, Patent Owner’s arguments do not adequately distinguish over Phelan. In particular, the limitation “wherein the map image comprises a slightly zoomed-in map image, which is centered at the geodetic coordinate,” as recited in claim 64 is broad enough to encompass the map server 11 of Phelan, which can retrieve maps based on latitude and longitude of the center, such that the user can zoom in on a map.

Accordingly, we agree with the Examiner that the rejection of dependent claim 64 under 35 U.S.C. § 102(b) as anticipated by Phelan should be maintained.

*§ 103 Rejection—Machii and Zavoli*

Machii as Prior Art

Patent Owner further attempted to antedate Machii by relying upon the newly submitted Supplemental Wallner Declaration, accompanied by Exhibits LL to MMM, to establish diligence from the time period prior to

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March 3, 2000, the filing date of Machii, until September 22, 2000, the filing date of the '983 patent.

The Examiner determined that the “new . . . evidence lacks relevance to the issue of whether the Patent Owner diligently reduced the invention to practice” (Determination 12) for the time period between June 22, 2000 to July 19, 2000 (*id.* at 11). In particular, the Examiner found that “many of the Exhibits (evidence of diligence) is directed to commercial exploitation, such as seeking venture capital funding (Exhibit TT)” and “[o]ther evidence lacks any apparent connection to the invention, such as ‘Building Floorplan Recognition Software’ (Exhibit UU).” (*Id.*) We agree with the Examiner’s findings and ultimate conclusion that Machii is available as prior art.

For the time period between June 22, 2000 and July 19, 2000, the Supplemental Wallner Declaration provides purported evidence of diligence for the following dates: (i) June 26, 2000 (¶ 11; Ex. RR) (ii) June 29, 2000 (¶ 12; Ex. SS); (iii) July 4–6, 2000 (¶ 13; Ex. TT); (iv) July 10, 2000 (¶ 14; Ex. UU); (v) July 11, 2000 (¶ 15; Ex. WW); (vi) July 13–14, 2000 (¶ 16; Ex. XX); and (vii) July 16, 2000 (¶ 17; Ex. YY).

#### July 4–6, 2000

With respect to July 4–6, 2000, the Supplemental Wallner Declaration states the following:

In late June and throughout July 2000, Will Cooper and I worked on developing our software and demos and obtaining investor funding. Attached as Exhibit TT is a true and correct copy of an email thread between Will Cooper and Dave Perry dated July 4–6, 2000. In the email thread, Will Cooper thanked Mr. Perry for his suggestion that we contact Nokia Ventures. Will Cooper also

mentioned, “We are currently porting our mapping software to run on a Palm and Windows [sic] CE device, so hopefully we should have something to demonstrate soon.”

(¶ 13.)

Exhibit TT is a July 4, 2000 e-mail communication, sent to Dave Perry from Will Cooper, which states the following:

I hope all is well with you. *I just wanted to write to you and thank you so much for your suggestion to contact Nokia Ventures.*

*We met with them last month and although we weren't immediately able to convince Nokia of our business case, it was valuable experience for us and we learnt a lot on our trip to San Francisco, especially where we lacked sufficient marketing and cash flow information in our business pitch.*

Nokia have stayed in contact with us after the meeting, so we are still hopeful that something might eventually develop. *We are currently porting our mapping software to run on a Palm and Wlndows [sic] CE device, so hopefully we should have something to demonstrate soon.*

Best Wishes and thanks again so much in your efforts in helping set up a meeting for us with a *VC company*.

(Ex. TT (emphases added).)

Because Mr. Cooper's e-mail states that “we weren't immediately able to convince Nokia of our business case,” also described as a “VC [venture capital] company,” such meeting with Nokia Ventures is similar to “pure money-raising activity,” rather than evidence of reduction to practice. *Scott v. Koyama*, 281 F.3d 1243, 1248 (Fed. Cir. 2002) (“Precedent illustrates the continuum between, on the one hand, ongoing laboratory experimentation, and on the other hand, pure money-raising activity that is entirely unrelated to practice of the process.”). Moreover, Mr. Cooper's e-

mail states that “[w]e met with them [Nokia] last month,” indicating that such meeting occurred in June 2000, rather than July 4, 2000, the date of the e-mail. While this e-mail also states that “[w]e are currently porting our mapping software to run on a Palm and Wln-dows [sic] CE device, so hopefully we should have something to demonstrate soon,” such statement lacks specificity to both dates and facts. *Kendall v. Searles*, 173 F .2d 986, 993 (CCPA 1949) (evidence of diligence must be “specific as to dates and facts”). For example, Mr. Cooper provides no further explanation as to the nature of the work, who performed such work, or how such work relates to reduction to practice of limitations recited in the rejected claims.

July 10–11, 2000

With respect to July 10–11, 2000, the Supplemental Wallner Declaration states the following:

Attached as Exhibit UU is a true and correct copy of an email thread between Will Cooper and me dated July 10, 2000. The email thread discusses how to *add a feature to our software that would display the floorplans of buildings and airports*. Will Cooper had previously asked Chuck Eggers whether he knew of a software that was commercially available and could convert floorplans into a vector format, or, alternatively, whether Mr. Eggers could program such software. Mr. Eggers suggested trying a dedicated tracing program like Adobe Streamline, and asked whether Will Cooper or I had a specification for a vector graphics file format. Will Cooper asked me for a simple example to test out on Adobe Streamline.

(¶ 14 (emphasis added).)

The next day, I emailed Will Cooper regarding *building floorplan recognition software*. Exhibit WW is a true and correct copy of this email. I explained what my vector format supported

and listed my requirements for software that could produce a consistent vector output format from different types of bitmaps.

(¶ 15 (emphasis added).)

However, none of the claims of the '983 patent recites the limitation “display the floorplans of buildings and airports,” “building floorplan recognition software,” or similar language. Accordingly, Patent Owner has not established the relevance of Exhibit UU with respect to reduction to practice of the claimed invention. *Naber v. Cricchi*, 567 F.2d 382, 385, (CCPA 1977), *cert. denied*, 439 U.S. 826 (1978)(“It is well settled that, to satisfy the “reasonable diligence” requirement . . . the work relied on must ordinarily be directly related to reduction to practice of the invention . . .”).

July 13–14, 2000

With respect to July 13–14, 2000, the Supplemental Wallner Declaration states the following:

Attached as Exhibit XX is a true and correct copy of an email thread between Will Cooper and me dated July 13-14, 2000 discussing focusing on our business plan presentation and getting an operational street mapping product demonstration running on the Jornada and Palm in time for our upcoming Springboard presentation at University of California, San Diego. Some of our consultants were working on the product demonstration. I indicated that I would “[be] pushing the guys to get it done.”

(¶ 16.)

Exhibit XX, which includes a July 13, 2000 original e-mail communication, sent to Will Cooper from Alfred Wallner, states the following:

Will,

Joanne gave us Tuesday, August 8, for the Springboard presentation. Is that ok with you ?

I made a couple of changes to the bizintro, mainly the strategy slide and I increased our expenses reflecting 20% of revenue for data costs.

I still believe we should have a complete business plan, and I suggest you work on that during the next 2-3 weeks.

It's mostly a matter of integrating all the pieces, eg. revenue/cost projections, competitor analyses, etc. into one document.

Alfred

(Ex. XX, pp. 2-3.)

Exhibit XX, which includes a July 13, 2000 follow-up e-mail communication, sent to Will Cooper from Alfred Wallner, states the following:

[Question by Will Cooper]

FYI - I think the business plan could be a lot more work than just converting and integrating the business introduction into a document, although I'm sure a rough draft could be done in a few weeks. There's a lot of writing and a more detailed financial analysis required to make it look professional. I know that we need a proper business plan, but I'm just not sure if I have the time available just working evenings to get it done before the Springboard meeting. Maybe Rick Evans could help out with the financials, e.g. EBITDA, ROI, etc. Let's discuss further.

[Response by Alfred Wallner]

Sure, ask Rick to help out on that.

I am in favor of keeping the document short, say 20 pages, of which 5 are the exec summary, so 15 pages are left for organizing the information which we have already. Even if it's not the 'perfect' business plan, it's much better to have it than not. We can always tweak it as we go along.

[Question by Will]

What is the likelihood that we will have an operational street mapping demo running on the Palm or Jornado by the time of the Springboard?

[Response by Alfred Wallner]

your guess =my guess.

I'll be pushing the guys to get it done and will put some of my time if necessary.

I would really like to get the patent application done also.

Alfred

(Ex. XX, pp. 1-2.)

Exhibit XX, which includes a July 14, 2000 another follow-up e-mail communication, sent to Alfred Wallner from Will Cooper, states the following:

Alfred,

I know this is something you want to do, but I don't think getting the patent done will affect our short term chances of getting funded.

However, getting the demo up and running on the Jornado and Palm would have a bigger impact than stating that we had completed the patent application at the Springboard meeting or in front of other VC's. There's nothing like some actual product to convince skeptics.

For now I would put the patent on the back burner - at least until we get some VC funding to hire a patent attorney to ensure that the submitted patent is enforceable.

Let's just keep focused on what will get us funded,  
e.g.

- 1) Business Plan Presentation
- 2) Product Demo on Palm/Jornado

3) Revised Business Plan

4) Updated Website

These are all things which potential investors will want to look at, just to see we have our stuff together.

Will.

(Ex. XX, pp. 1–2.)

Because the e-mail communications between Mr. Will Cooper and Mr. Alfred Wallner refers to a “business plan,” “revenue/cost projections,” “financials, e.g. EBITDA [Earnings Before Interest, Taxes, Depreciation and Amortization], ROI [Return on Investment], etc.),” and “VC funding,” such activities are more related to “pure money-raising activity,” rather than evidence of reduction to practice of the claimed invention. *See Scott*, 281 F.3d at 1248. While Mr. Wallner states that “I’ll be pushing the guys to get it done and will put some of my time if necessary,” such statement lacks specificity to both dates and facts. *Kendall*, 173 F.2d at 986. For example, Mr. Wallner provides no further explanation as to the nature of the work, who performed such work, or how such work relates to reduction to practice. Indeed, there is no evidence that the work was actually done.

July 16, 2018

With respect to July 16, 2000, the Supplemental Wallner Declaration states the following:

On July 16, 2000, Will Cooper emailed me a link to software tools that could convert raster images to vector formats. Exhibit YY is a true and correct copy of this email.

(¶ 17.)

Exhibit YY, which includes a July 13, 2000 original e-mail communication, sent to Alfred Wallner from Will Cooper, states the following:

Alfred,

Here's a link to some Windows shareware utilities which convert raster images to various vector formats.

Will.

<http://softseeksearch02.zdnetcom/cgi-bin/search.cgi?keywords=vector+raster&seekindex=indexpcgr&maxresults=025&cb=>

(Ex. YY.)

While the e-mail refers to that “shareware utilities which convert raster images to various vector formats,” such a vague and generalized statement lack specificity to both dates and facts. *Kendall*, 173 F .2d at 993. For example, Mr. Cooper provides no further explanation as to the nature of the work or who performed such work, how such work relates to reduction to practice, nor whether it was actually done.

Patent Owner identifies exhibits to support conception of the limitations of claim 69. (PO § 41.77(e) Comments 12–15.) Even assuming, solely for the sake of argument, that such discussion were sufficient to establish conception of the claimed subject matter, for the reasons already discussed, Patent Owner has not adequately described or documented diligence to either actual or constructive reduction to practice of the claimed subject matter.

Patent Owner argues that “[a]lthough, the Examiner is correct that the email in Exhibit TT related to raising funds, these funds were not to commercially exploit the inventions, but they were used to develop and

eventually reduce the invention to practice” and “[r]aising funds to develop the invention surely shows that the reduction to practice was not unreasonably delayed” with a citation to Exhibit P, submitted by Patent Owner on April 14, 2014. (PO § 41.77(e) Comments 16.)

Exhibit P, a confidential Tierravision business plan states the following:

Investing in a startup business is risky. Alfred Wallner has solid technical and marketing experience, but Tierravision will need to find other leadership talent for the company to grow as expected. Part of your capital will be used to hire a competent *VP of marketing* to help lead the company to success. *Filling this key position is one of our immediate priorities . . . .*

We are offering an investment opportunity with potential for high return after two years. We are seeking seed funding of one to two million dollars. The capital will be used to hire our initial staff, *five software developers and five marketing and sales people*, and cover operating costs for the first twelve to eighteen months. *Alfred Wallner has already completed major parts of the necessary software development.* With a development team in place, we will start rolling out the first products within three months.

(Ex. P, p. 9 (emphases added).) However, the focus of the Tierravision business plan appears to be marketing and sales, rather than product development. For example, the business plan focuses on “hiring[] a competent VP of marketing,” such that “[f]illing this key position is one of our immediate priorities,” as well as “five marketing and sales people.” While the business plan states that with “a development team in place [of five software developers], we will start rolling out the first products within three months,” the business plan further states that “Alfred Wallner has already completed major parts of the necessary software development.”

Thus, the job function of the “five software developers” is not adequately described to support Patent Owner’s argument that “these funds were not to commercially exploit the inventions, but they were used to develop and eventually reduce the invention to practice,” particularly when the business plan stated, without explanation, that major part of the necessary software development was done.

Patent Owner further argues that “even if . . . the Examiner were correct that the Supplemental Wallner Declaration did not provide corroborating evidence for the three identified periods, Patent Owner still provided sufficient evidence that Wallner did not abandon or unreasonably delay the invention.” (PO § 41.77(e) Comments 17.) In particular, Patent Owner argues that “although Patent Owner presented 26 additional corroborating exhibits covering the alleged gaps, even without this supplemental declaration, Wallner’s original sworn testimony and 36 Exhibits containing over 340 pages of documentation demonstrating that Wallner conceived of and reduced his invention to practice with reasonable diligence.” (*Id.*) Other than arguing that Patent Owner has provided voluminous evidence, regardless of the relevancy or sufficiency of such evidence, Patent Owner has not explained why such voluminous evidence provides evidence of reduction to practice of the claimed invention.

Therefore, we agree with the Examiner that Machii is eligible as prior art under 35 U.S.C. § 102(e).

Claims 69–77, 98, 99, 101, 107, 109, and 111

The Examiner determined that “Patent Owner . . . fails to address the rejection formulated by the Board” that “[W]hile [the] generation of queries

for map meshes in Machii occurs at a server, and not ‘at the portable wireless device’ as now recited in the amended claims, moving that functionality to the portable wireless device would have been obvious.” (Determination 12–13.) We agree with the Examiner’s determination.

Page 18, lines 14–23 of our previous Decision, mailed April 28, 2017, states the following:

A person of ordinary skill in the art would have recognized that incorporating the known feature of transferring the storage database of Zavoli from the server to the in-vehicle GPS (or vice versa), with the known information providing system of Machii would have been obvious. *Such a modification would result in transferring the map data base [405] of Machii, including the storage address map meshes based upon latitude-longitude, from the server [1302] to the terminal [1306] of Machii.*

(Dec. 18 (emphasis added and citation omitted).) Thus, the rejection of independent claim 69 in our previous Decision was based upon modifying Machii by transferring map data base 405, as illustrated in Figure 4, from server 1302 to terminal 1306.<sup>3</sup> While our Decision states that “[w]e do not agree with the Examiner’s determination” (Dec. 16), such statement was in reference to the Examiner’s ultimate conclusion that the combination of Machii and Zavoli would not have rendered obvious independent claim 69 (*id.* at 15–16) and not a determination that it would have been obvious to

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<sup>3</sup> The Examiner inadvertently stated “[t]he Board explained that the *search engine* was moved to the portable wireless device, not the map database.” (Determination 13 (emphasis added).) However, the Examiner’s statement is harmless error, because the articulated rationale for modifying Machii to for reject independent 69 was provided in our Decision, thus, providing Patent Owner with adequate notice.

modify Machii by transferring search engine 403 from server 1302 to terminal 1306.

First, Patent Owner argues that “the Board determined that both the search engine and the map database were moved from the server of Machii to the terminal of Machii.” (PO § 41.77(e) Comments 18.) Accordingly, Patent Owner argues, “any map information would already reside on the terminal and would no longer be sent from the server” and “the rearrangement of Machii proposed by the Board does not meet the limitations of Claim 69 and cannot render the claim obvious.” (*Id.*) However, as discussed previously, in our previous Decision, the rejection of independent claim 69 was based upon based upon modifying Machii by transferring map data base 405, as illustrated in Figure 4, from server 1302 to terminal 1306, rather than transferring search engine 403 from the server 1302 of Machii to terminal 1306 of Machii, as argued by Patent Owner.

Second, Patent Owner argues, “[o]ne of ordinary skill in the art, reading Zavoli and keeping in mind both the teachings of Machii on how to effectively use a low cost system and Machii’s goal of a low cost system, would not move functionality like the search engine and map database from the server to the client” and that “a person of skill in the art would follow both Machii’s and Zavoli’s recommendations to use a low cost, low functionality terminal.” (PO § 41.77(e) Comments 19–20.) Patent Owner also points to the Supplemental Jawadi Declaration, which states the following:

One of ordinary skill in the art, reading Zavoli and keeping in mind both the teachings of Machii on how to effectively use a low cost system and Machii’s goal of a low cost system, would

not move functionality like the search engine and map database from the server to the client but would instead follow both Machii's and Zavoli's recommendation to use a low-cost, low-functionality terminal.

(¶ 45.) However, the fact “[t]hat a given combination would not be made by businessmen for economic reasons does not mean that persons skilled in the art would not make the combination because of some technological incompatibility.” *In re Farrenkopf*, 713 F.2d 714, 718 (Fed. Cir. 1983).

Last, Patent Owner argues “[m]odifying Machii's search engine to ‘reside on’ the terminal would substantially disrupt the solution provided in Machii to achieve the stated objectives.” (PO § 41.77(e) Comments 20.) Accordingly, Patent Owner argues “[t]he Board's modification of Machii would require the map database to send maps for the entire search path, instead of just the eventual route” which “would substantially increase the communication load between server and terminal and defeats Machii's stated objective.” (*Id.* at 20–21.) Again, as discussed previously, in our previous Decision, the rejection of independent claim 69 was based upon modifying Machii by transferring map data base 405, as illustrated in Figure 4, from server 1302 to terminal 1306, rather than moving from the server 1302 of Machii to the terminal 1306 of Machii, as argued by Patent Owner.

Accordingly, we agree with the Examiner that the rejection of amended claims 69–77, 98, and 99 under 35 U.S.C. § 103(a) as unpatentable over Machii and Zavoli should be maintained.

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## DECISION

We affirm the Examiner's decision to maintain the rejection of claims 60–66, 68, and 86 under 35 U.S.C. § 102(b) as anticipated by Phelan.

We affirm the Examiner's decision to maintain the rejection of claims 69–77, 98, and 99 under 35 U.S.C. § 103(a) as unpatentable over Machii and Zavoli.

Requests for extensions of time in this inter partes reexamination proceeding are governed by 37 C.F.R. § 1.956. *See* 37 C.F.R. § 41.79.

This is a final 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.

AFFIRMED