

**PUBLIC VERSION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

In re U.S. Patent No. 8,092,345

Filed: November 13, 2009

Issued: January 10, 2012

Inventors: Michael Ellis; Caron Ellis

Title: Systems and Methods for a Portable Electronic Journal

---

Mail Stop PATENT BOARD, PTAB  
Patent Trial and Appeal Board  
U.S.P.T.O.  
P.O. Box 1450  
Alexandria, VA 22313-1450

**DECLARATION OF JOSEPH A. PARADISO**

I, Joseph A. Paradiso, make this declaration in connection with Petitioner's Reply to Patent Owner's Response submitted by Petitioner for the *inter partes* review of U.S. Patent No. 8,092,345 ("the 345 Patent"), IPR2015-000698. All statements herein made of my own knowledge are true, and all statements herein made based on information and belief are believed to be true. I am over age 21 and otherwise competent to make this declaration. Although I am being compensated for my time in preparing this declaration, the positions articulated

herein are my own, and I have no stake in the outcome of this proceeding or any related litigation or administrative proceedings.

### **I. Incorporation by Reference**

175. Unless otherwise provided below, I hereby incorporate by reference my declaration made in connection with the Petition to institute an *inter partes* review on the 345 Patent (“February 5, 2015 Declaration”). UA-1003.

### **II. Claim Interpretation**

176. In my February 5, 2015 Declaration, I offered an opinion that the term “common file format” would be understood by persons of ordinary skill in the art to mean “any well-known or standardized format that permits easy viewing or printing with a computer, such as a personal computer.” UA-1003 at ¶ 17. I understand that the Patent Trial and Appeal Board (the “Board”) disagreed and preliminarily found that the term “common file format” should be given its plain and ordinary meaning. Paper 10 at 5-6. The analysis and conclusions contained herein and in my February 5, 2015 Declaration remain the same under either interpretation of the term “common file format.”

### **III. Unpatentability in View of Patent Owner’s Response and the Accompanying Exhibits**

177. I have reviewed Patent Owners adidas AG’s Response to Petition for *Inter Partes* Review and Exhibits 2001 – 2024. My analysis and conclusions below are in response to these materials.

**A. A Person of Ordinary Skill in the Art Would Have Been Motivated to Combine the Teachings of Mault and DeLorme to Render Obvious Claims 1-3, 6-11, 15-7, and 20 of the 345 Patent**

178. In my February 5, 2015 Declaration, I opined how the combination of Mault and DeLorme would render obvious at least claims 1-3, 6-11, 15-18, and 20 of the 345 Patent. Patent Owner disagrees with this analysis by asserting that: (1) the Petitioner mischaracterizes Mault’s disclosure of a “PDA that includes or communicates with a body activity monitor” (UA-1004 at 18:8-10) (Paper 20 at 7-9); (2) Mault and DeLorme are directed to different needs of a user and that DeLorme teaches away from a combination with Mault (Paper 20 at 9-14); (3) I was not a person of ordinary skill in the art during the relevant time period because I never worked on a device that incorporated a GPS receiver in my professional capacity (Paper 20 at 11-12); and (4) Mault’s disclosed system did not need any improvement. I address each of these arguments, below.

1. Mault Teaches That a PDA Can Be Used to Record a User’s Location Over Time

179. In describing the reasons to combine Mault and DeLorme, I noted the similarities shared by these two references, including that they “both ... disclose portable electronic devices for monitoring and logging information about a user.” UA-1003 at ¶ 36. Patent Owner does not specifically contest this statement and instead focuses only on Mault’s disclosure that the portable monitoring device can be, among other things, a PDA. *See* UA-1004 at 18:7-10 (“The monitoring device

according to the present invention may take other forms. For example, the monitoring device may be a PDA that includes or communicates with a body activity monitor.”). Specifically, Patent Owner argues that although Mault’s PDA can include or communicate with a body activity monitor, such a body activity monitor cannot be a GPS receiver; rather, Patent Owner asserts that the PDA’s body activity monitor can only be an accelerometer. Paper 20 at 7-9, 15. It is my opinion that this argument contradicts the plain teachings of Mault.

180. Patent Owner and Dr. Michalson’s argument effectively attempts to rewrite Mault’s disclosure. Whereas Mault states that “the monitoring device may be a PDA that includes or communicates with **a body activity monitor**” (UA-1004 at 18:8-10), Patent Owner and Dr. Michalson interpret this statement as “the monitoring device may be a PDA that includes or communicates with **an accelerometer only.**” Patent Owner and Dr. Michalson also interpret “[t]he PDA **may have** an accelerometer built in or interconnected therewith” (UA-1004 at 18:10-11) as “[t]he PDA **only has** an accelerometer built in or interconnected therewith.” Both Patent Owner and Dr. Michalson fail to explain why a person of ordinary skill in the art would read Mault’s otherwise clear disclosure in such a limited fashion.

181. Patent Owner also asserts that Mault discloses a GPS-only embodiment and a separate PDA embodiment that are somehow completely

divorced from each other and the remainder of the specification. Specifically, Patent Owner examines a portion of the specification from column 8, line 42, to column 12, line 11, which discusses capabilities of using GPS in its invention, and Patent Owner concludes that “Mault does not teach that this embodiment takes the form of a PDA.” *See* Paper 20 at 7. In my opinion, Mault’s disclosure is not so limited.

182. Instead, Mault describes throughout the specification that the monitoring device, with or without using GPS, can take various *forms*, including as a PDA. For example, looking at the figure illustrating the “GPS Version of Monitor” focused on by Patent Owner, shown below, this schematic does not disclose the particular form of the monitoring device (*e.g.*, whether it is a phone, belt-mounted, wrist-worn, etc.); it only shows a representation of the monitoring device. *See* UA-1004 at 8:45-61 (describing the representative monitoring device **84** with several components, including different types of body activity monitors (*e.g.*, **80**, **105**, **109**, **114**), manual input **110**, and communication transceiver **98**). *See also* UA-1004 at Fig. 6 (illustrating a representative monitoring device **84** that includes GPS and other body activity monitors), 9:21-24.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.