UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOMTOM, INC.,
Petitioner,

v.

BLACKBIRD TECH LLC d/b/a BLACKBIRD TECHNOLOGIES,
Patent Owner.

Case IPR2017-02023
Patent 6,434,212

PATENT OWNER'S SUR-REPLY

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Pursuant to authorization provided in the Board's October 16, 2018 e-mail to the parties, Blackbird Tech LLC d/b/a Blackbird Technologies ("Blackbird" or "Patent Owner") files this sur-reply in response to the Reply in support of the Petition for *inter partes* review filed by the named Petitioner TomTom, Inc. ("TomTom" or "Petitioner"). Rather than rehash prior arguments, Patent Owner will focus on certain salient issues in Petitioner's Reply, and stand on its Response for the remaining issues.

I. JIMINEZ DOES NOT DISCLOSE A TRANSMITTER

Petitioner continues to insist that Jiminez's 'one shot 146' teaches the claimed "transmitter in communication with the step counter," required by claim 6. Reply at 12-18. A "one shot" is a type of monostable multivibrator that is an electrical component used, in this context, to normalize the voltage wave input from a sensor.[1] It is not, as Petitioner claims, a transmitter. (Ex. 2001 at ¶ 45).

Petitioner points to the '212 patent's description of a transmitter to attempt to bolster its ill-founded argument:

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[1] *See* Ex. 1022 at 94:17-20.

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> According to the '212 patent "[t]ransmitter 34 i*s mounted in the step counter housing and is preferably* an Rf telemetric signal transmitter with a 30 inches to 36 inches transmission range. *Alternat[iv]ely*, the transmitter is a wireless or wired digital transmitter with a coding function to limit or eliminate interference with other similar devices." EX1001 at 3:12-17 (emphasis added). The '212 patent further states that "[t]he transmitter 34 transmits either *raw data* or calculated distances, pace, etc. to a wrist-mounted display unit receiver 40.

Reply at 12. Petitioner posits that the '212 patent's indication that its transmitter can transmit raw data "allows a 'transmitter' to be a device that transmits a raw data signal." Reply at 13. Petitioner concludes that because Jiminez's 'one shot 146' transmits raw data, calculated data, or step count to a microprocessor, it qualifies as the transmitter required by claim 6 of the '212 patent. Reply at 15.

Petitioner's argument is incorrect for several reasons. First, to the extent Petitioner believes it is proper to look to the specification to determine what a transmitter in the '212 patent is, the '212 patent makes it clear that a transmitter is either a RF telemetric signal transmitter or a wireless or wired digital transmitter with a coding function. Ex. 1001 at 3:12-17. Since Jiminez's 'one shot 146' is

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indisputably not a RF telemetric signal transmitter, in order to be a transmitter under the '212 patent, it would have to fall into the second category of transmitter disclosed by the '212 patent: a wireless or wired digital transmitter with a coding function. But 'one shot 146' does not have a coding function. Rather, 'one shot 146' is a type of monostable multivibrator that is an electrical component used to normalize the voltage wave input from a sensor. *See* Ex. 1022 at 94:17-20. Normalizing a voltage wave input is not a coding function.

Second, Petitioner's new position regarding the claimed transmitter (that a transmitter is any device that transmits a raw data signal), is an untimely claim construction argument that should not be considered. Petitioner presented this theory for the first time in its Reply and did not construe "transmitter" at all in its Petition. Such a belated theory should be rejected by the Board. The Supreme Court has observed that "a petitioner will seek an inter partes review of a particular kind—one guided by a petition describing 'each claim challenged' and 'the grounds on which the challenge to each claim is based.' 35 U.S.C. § 312(a)(3)." *SAS Institute Inc. v. Iancu,* 138 S. Ct. 1348, 1355 (2018). The PTO's regulations implementing 35 U.S.C. § 312(a)(3) require the petition to identify "[h]ow the challenged claim is to be construed" and "[h]ow the construed claim is

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unpatentable." 37 C.F.R. § 42.104(b)(3),(4). Once set out in a petition, "petitioner's contentions … define the scope of the litigation all the way from institution through to conclusion." *SAS*, 138 S. Ct. at 1357. By trying to present a new claim construction argument on Reply, instead of relying on an explanation of the claims presented in the Petition,[2] Petitioners have impermissibly departed from their Petition, in contravention of the guidance found in the *SAS* decision and the Board's regulations.

Third, Petitioner's expert and Patent Owner's expert agree that 'one shot 146' is a monostable multivibrator. *See* Ex. 1022 at 94:17-20; Ex. 2001 at ¶ 45. The Board also agreed with this position in its Institution Decision. Paper No. 7 at 26. Patent Owner and the Board agree that a monostable multivibrator is not a transmitter. Paper No. 7 at 26-27; Patent Owner's Response at 44. Indeed, the Board inserted a link in its Institution Decision that supports its (and Patent Owner's) position (https://en.wikipedia.org/wiki/Multivibrator). Paper No. 7 at

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[2] Petitioners did not seek reconsideration of the Board's initial institution decision or otherwise attempt to demonstrate where, in their Petition, such a theory was presented.

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