

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INVUE SECURITY PRODUCTS, INC.,
Petitioner,

v.

MOBILE TECH, INC.
Patent Owner.

Case PGR2019-00019
U.S. Patent 10,026,281

**PATENT OWNER'S PRELIMINARY RESPONSE
UNDER 37 C.F.R. 42.207**

Mail Stop: Patent Board
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P.O. Box 1450
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I. INTRODUCTION

Patent Owner, Mobile Tech, Inc. (“MTI” or “Patent Owner”), submits the following Preliminary Response to the Petition for Post-Grant Review (“PGR”) of U.S. Patent 10,026,281 (“the ’281 Patent”) filed by Petitioner InVue Security Products (“InVue” or “Petitioner”) in Case PGR2018-00019. *See* 37 C.F.R. § 42.207.

MTI requests that the Board reject the Petition and refuse to institute PGR for at least the following reasons:

II. THE PETITION SHOULD BE DENIED BECAUSE INVUE HAS NOT ESTABLISHED WHEELER OR THE VIDEO ARE PRIOR ART

InVue’s Ground 4 relies upon U.S. Patent Application Publication No. 2014/0159898 (“Wheeler,” Ex. 1008), which published June 12, 2014 and has an earliest priority date of June 21, 2010. Ground 5 relies upon a video identified as “MTI’s 2009 Virtual Store Tour Video” (“the Video,” Ex. 1014), which InVue alleges was publicly disclosed on May 8, 2009. *See* Paper 1, 23.

Every challenged claim of the ’281 Patent, however, is entitled to an effective filing date of January 10, 2009. *See* Ex. 1001, 1. As such, neither Wheeler nor the Video are prior art to the ’281 Patent. While InVue makes two arguments as to why Claims 1-30 are not entitled to the filing date of Application Serial No. 12/351,837 (“the ’837 application”), both are incorrect.

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A. InVue’s Revival Argument Is Not Challengeable in a PGR, and in Any Event, Is Incorrect

InVue argues the ’281 Patent’s priority claim to the ’837 application, filed January 10, 2009, should be ignored because allegedly the Patent Office improperly revived the application. Paper 1, 6-10. But this argument is not challengeable in a PGR and the Board has no jurisdiction over it. Plus, InVue is wrong on the merits.

1. PGR Proceedings Are Limited in Scope

Like every Board proceeding, PGR proceedings are of limited scope. *See Symantec Corp. v. Finjan, Inc.*, IPR2015-01895, 2016 WL 1082105, at *6 (PTAB Feb. 26, 2016) (“The Board is not a court of general jurisdiction, but an administrative tribunal with limited jurisdiction.”). Specifically, the scope of a PGR proceeding is limited by statute to “any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).” 35 U.S.C. § 321(b). These paragraphs of § 282(b), in turn, allow defenses of invalidity based upon “any ground specified in part II [of the Patent Act] as a condition for patentability” (*i.e.*, §§ 102 and 103), “any requirement of section 112” (except best mode) and “any requirement of section 251” (regarding reissue patents). *See* 35 U.S.C. § 282(b).

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