

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

K-40 ELECTRONICS, LLC
Petitioner

v.

ESCORT, INC.
Patent Owner

Case IPR2013-00203
Patent 7,999,721

Before GLENN J. PERRY, THOMAS L. GIANNETTI, and
TRENTON A. WARD, *Administrative Patent Judges*.

WARD, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

K-40 Electronics, LLC, filed a petition to institute an *inter partes* review of claims 1-10 of U.S. Patent 7,999,721 (the “’721 patent”). Paper 1 (“Pet.”). Patent Owner Escort, Inc. timely filed a preliminary response. Paper 5 (“Prelim. Resp.”). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides as follows:

THRESHOLD -- The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Petitioner contends that the challenged claims are unpatentable under 35 U.S.C. §§ 102 and/or 103 on the following specific grounds (Pet., 19-45):¹

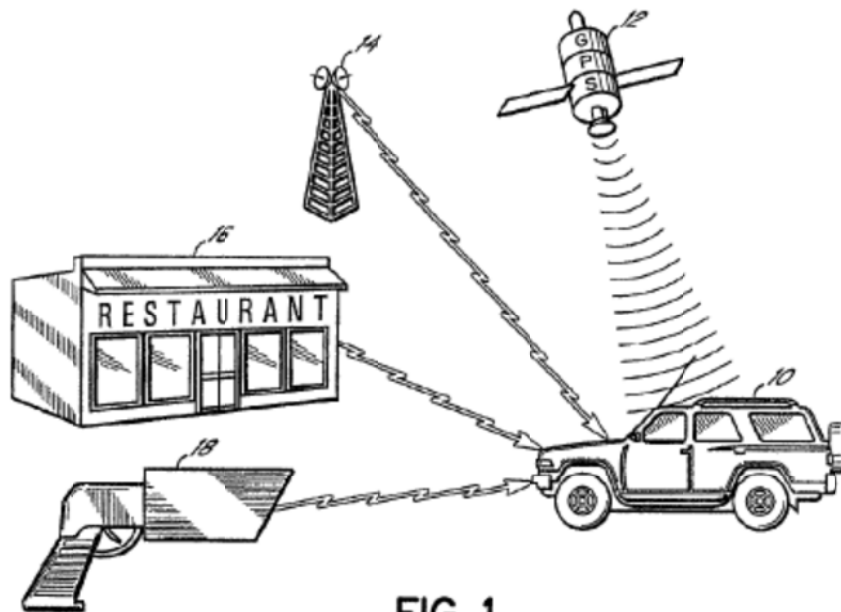
Reference(s)	Basis	Claims challenged
US 6,233,589 (Ex. 1002) (“Hoffberg”)	§ 102	1-10
US 6,204,798 (Ex. 1003) (“Fleming, III”)	§ 102	2-8 and 10
Fleming, III and Hoffberg	§ 103	2-10

For the reasons given below, we institute an *inter partes* review of claims 1-10.

¹ Petitioner supports its challenge with a declaration by Dr. Christopher Bartone (Ex. 1007) (“Bartone Decl.”).

B. The Claimed Invention

The '721 patent (Ex. 1001) is titled "Radar Detector With Navigational Function" and generally relates to a Global Positioning System ("GPS")-enabled radar detector designed to process dynamically radar sources based on previously-stored geographically referenced information. '721 patent, Abstr. The patent explains that, in the spectrum allocated by the FCC for police radar systems, there are increasing numbers of signals generated by other applications. '721 patent, col. 2, ll. 12-22. "As a result, radar detectors are increasingly generating false alarms, effectively 'crying wolf,' reducing the significance of warnings from radar detectors." '721 patent, col. 2, ll. 19-22. The patent describes a radar detector that includes technology for determining the location of the detector, and comparing this location to the location of known false alarm sources so as to vary the alarm provided by the radar detector in response to false alarm sources. '721 patent, col. 4, ll. 21-39. Figure 1 of '721 patent is reproduced below:



'721 patent, Figure 1

As shown above in Figure 1, the '721 patent describes that a vehicle 10 can be equipped with a radar detector having a GPS receiver enabled to identify its present coordinates so as to distinguish between a police radar gun 18 and a false alarm radar signal from a stationary source at restaurant 16. '721 patent, col. 8, ll. 28-45. Furthermore, the patent describes that in "location lockout" mode, the GPS-enabled radar detector can access a database and suppress all audible warnings of radar signals at a particular location associated with a known source of spurious police radar signals. '721 patent, col. 15, ll. 9-16. Claims 1 and 2 illustrate the claimed subject matter and are reproduced below:

1. A navigation and police activity warning device comprising:

a receiver section receiving signals generated in the context of law enforcement activity,

a warning section responding to the receiver section and providing a warning if a received signal correlates to a law enforcement signal, the warning produced by the warning section varying in relation to a vehicle location derived from a position determining circuit,

a navigational system providing a graphical display and navigational functions, the display including a display of navigational information including a map and stored geographic locations on said map for which the device stores data that is used by said warning section in varying the warning produced in response to a law enforcement signal.

2. A police warning receiver comprising:

a receiver section adapted to receive electromagnetic signals indicative of police activity;

an alert section responsive to the receiver section and adapted to provide an alert if a received electromagnetic signal correlates to a police signal;

a position determining circuit generating a location signal; and

storage for information associated with geographic locations.

II. ANALYSIS

A. Status of Fleming, III and Hoffberg as Prior Art

As an initial matter, we review whether the references relied upon by Petitioner qualify as prior art. Patent Owner argues that these references, Fleming III and Hoffberg, were “removed” as prior art during prosecution and relies here on the inventor declarations that were submitted to the USPTO examiner. Pet. 48-53. We have reviewed those declarations and the prosecution record, and find the Patent Owner’s arguments unpersuasive for the reasons discussed below.

1. Fleming, III

During the prosecution of the ’721 patent, the Examiner rejected the pending claims based on Fleming, III. Ex. 1004, Dec. 30, 2009 Office Action, 4-7. In response, the Patent Owner submitted a Rule 131 Declaration from the inventor in an effort to antedate Fleming, III, that is to establish that this reference is not effective as prior art because the invention covered by the patent had been conceived of and diligently reduced to practice prior to the legally effective date of Fleming, III. *See* Ex. 2022, Dec. 15, 2004 Declaration of Steven K. Orr Under 37 CFR §1.131 (“2004 Orr Declaration”). The Examiner found the 2004 Orr Declaration sufficient to antedate Fleming, III and thus withdrew the rejections based on Fleming, III. *See* Ex. 2037, 3.

Petitioner contends that Fleming, III was not antedated properly because the 2004 Orr Declaration “is legally and factually insufficient because it provides no factual showing of diligence at all.” Pet., 8. Patent Owner counters, however, that the 2004 Orr Declaration need not provide a factual showing of diligence because “Orr does not rely on a *constructive reduction to practice*, but rather an *actual reduction to practice*, which antedated both [the Fleming, III and Hoffberg] references.” Prelim. Resp., 33-34 (emphasis added).

We have reviewed this declaration and determine that it is deficient. First, the 2004 Orr Declaration states that some features were actually reduced to practice and some features were constructively reduced to practice at a later date, but the 2004 Orr Declaration fails to identify which of the claimed features were actually reduced to practice and which were constructively reduced to practice. *See* Ex. 2022, 2-4.² Second, the 2004 Orr Declaration fails to relate the claims of the ’721 patent to the invention that is alleged to be earlier in time. Therefore, we are persuaded by the Petitioner’s argument that the 2004 Orr Declaration did not properly antedate Fleming, III.

2. Hoffberg

Patent Owner argues that Hoffberg should not be considered by the Board because it was antedated during the prosecution of the related ’881 “grandparent” application. Prelim. Resp., 53. This argument is unavailing. The 2005 Orr

² During the prosecution of U.S. Application No. 10/396,881 (“’881 application”), the grandparent patent application to the ’721 patent, the Examiner found the 2004 Orr Declaration to be deficient for failure to identify those features that were subject to an actual reduction to practice. Ex. 2023, 3. To address the ambiguity, the Patent Owner filed a supplemental declaration from Mr. Orr, which specifically identified those claims pending in the ’881 application that were subject to an actual reduction to practice. *See* Ex. 2024, August 19, 2005 Declaration of Steven K. Orr Under 37 CFR §1.131 (“2005 Orr Declaration”), ¶ 13.

Declaration relied upon in the '881 application (*see* footnote *supra*) identified when certain claims in the '881 application were actually reduced to practice. *See* Ex. 2024, 4. Patent Owner fails, however, to relate the invention that is alleged to be earlier in time to the claims of the '721 patent. Therefore, we are not persuaded by Patent Owner's argument that it has antedated Hoffberg.

We also are not persuaded by Patent Owner's other arguments based on the prosecution history. Patent Owner contends that the Petition should be denied because the same arguments and prior art were before the Office previously. Pet. 27-36. We disagree. Under 35 U.S.C. § 325(d), "the Director may . . . reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." Consistent with the statute, we have reviewed the record in the prosecution. In summary, we are not required by statute to reject a Petition based upon the fact that certain arguments or art previously were considered by the Office, and after reviewing the prosecution history, we decline to do so in this case. *See* 35 U.S.C. § 325(d). The record before us is not the same as that previously before the Office, and we are, in any event, not persuaded by the declarations previously submitted that apparently influenced the outcome.

B. Anticipation by Hoffberg of claims 1-10

1. Overview of Hoffberg

Hoffberg discloses a mobile communication device "including police radar and LIDAR detectors, user output, memory, central processor, GPS receiver and RF transceiver." Hoffberg, col. 24, ll. 29-32. The mobile communication device in Hoffberg is enabled to process current location information in conjunction with stored locations and associated events to determine a priority of the associated events. Hoffberg, Abstr. Figure 1 of Hoffberg is reproduced below.

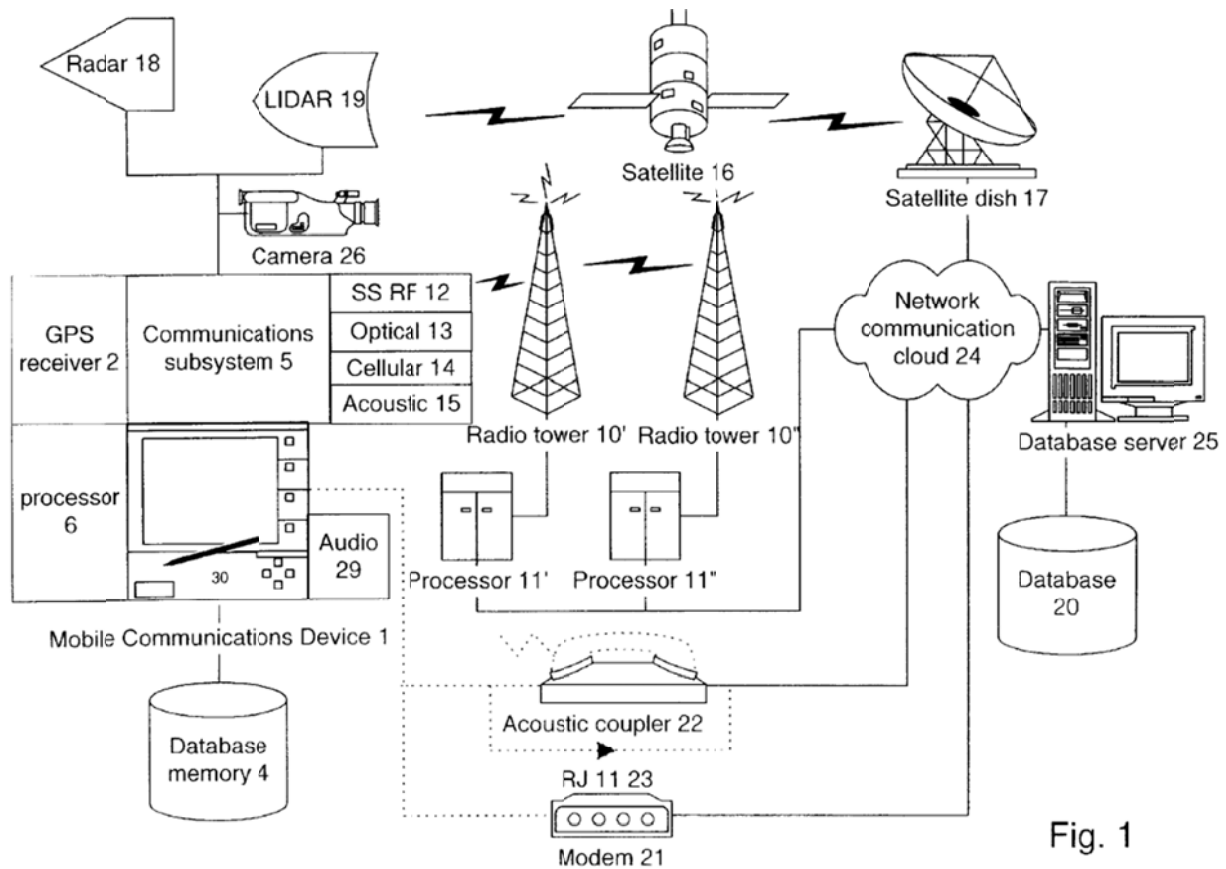


Fig. 1

Hoffberg, Figure 1

As shown above in Figure 1, the mobile communications device 1 can include a location sensing system 2 for producing a location output, a memory 4 for storing a set of locations and associated events, and a processor 6. Hoffberg, col. 26, ll. 36-40. The mobile communications device 1 in Hoffberg also includes an event detector having a radar detector 18 and a LIDAR detector 19. Hoffberg, col. 30, ll. 44-46. Hoffberg discloses that its mobile communications device 1 can suppress false alarms by correlating detecting events with false alarm events stored in the memory 4. Hoffberg, col. 29, ll. 8-11 (“[i]t is noted that, in the case of ‘false alarms’, the response of the unit is to detect the event, e.g., radar signal, correlate it with a stored ‘false alarm’ event, and suppress an alarm or modify the alarm signal.”). “Thus, information stored in memory and/or transmitted between units,

may signify an important alarm or a suppression of an erroneous alarm.”

Hoffberg, col. 29, ll. 11-13.

Hoffberg discloses that its mobile communications device 1 can filter sensor outputs based on present sensor outputs, past experience with a particular location in question, and the experience of others at the particular location. Hoffberg, col. 28, l. 63 – col. 29, l. 4. Furthermore, Hoffberg discloses that further information can be stored about a detected event in addition to the location and source of the event. *Id.*, col. 30, ll. 20-24. For example, Hoffberg discloses that “mobile police radar ‘traps’ are often relocated,” so these types of events can be stored with an expiration date. *Id.*, col. 30, ll. 31-35.

2. *Analysis*

Petitioner contends that claims 1-10 are anticipated by Hoffberg. Pet., 19-38. Patent Owner counters that Hoffberg is not prior art and has been considered previously by the Office. Prelim. Resp., 44-53. As discussed above, we are not persuaded by Patent Owner’s arguments. As to the merits of the proposed grounds of anticipation, Patent Owner does not contest Petitioner’s challenge that Hoffberg discloses all of the elements of claims 1-10.

We have reviewed Petitioner’s analysis and supporting evidence regarding the proposed grounds of anticipation of claims 1-10 based on Hoffberg and determine that Petitioner has met its burden under 35 U.S.C. § 312. For example, with respect to the recitation in claim 1 of a “warning produced by the warning section varying in relation to a vehicle location derived from a position determining circuit,” Petitioner cites Hoffberg’s disclosure that its mobile communications device can receive data from the GPS receiver such that “in the case of ‘false alarms’, the response of the unit is to detect the event, e.g., radar signal, correlate it with a stored ‘false alarm’ event, and suppress an alarm or

modify the alarm signal.” Pet., 23-24 (quoting Hoffberg, col. 29, ll. 8-11); *see also* Bartone Decl., ¶ 43. Additionally, with respect to the recitation in claim 2 of a “position determining circuit generating a location signal,” Petitioner cites to Hoffberg’s disclosure of a GPS receiver enabled to determine the location of its mobile communications device. Pet., 29 (citing Hoffberg, col. 26, ll. 45-54); *see also* Bartone Decl., ¶ 46. Furthermore, with respect to the recitation in claim 5 of “obtaining information on geographic locations that was gathered by another police warning receiver,” Petitioner cites to Hoffberg’s disclosure that “[i]f a particular user does not have direct experience with a location, then the experience of others at that location may be substituted or combined to improve analysis of the sensor signal.” Pet., 33 (citing Hoffberg, col. 28, l. 66 – col. 29, l. 2); *see also* Bartone Decl., ¶ 49.

For these reasons, Petitioner has demonstrated that there is a reasonable likelihood that it will prevail on its challenge to claims 1-10 based on the ground that these claims are anticipated by Hoffberg.

C. Anticipation by Fleming, III of claims 2-8 and 10

1. Overview of Fleming, III

Fleming, III discloses a radar detector for alerting an operator of a motor vehicle to an incoming police radar signal. Fleming, III, Abstr. “Upon detection of an incoming radar signal, the radar detector can utilize the position, velocity, and/or heading data from the global positioning system receiver to *determine whether to generate an alert.*” Fleming, III, Abstr. (emphasis added). Figure 1 of Fleming, III is reproduced below.

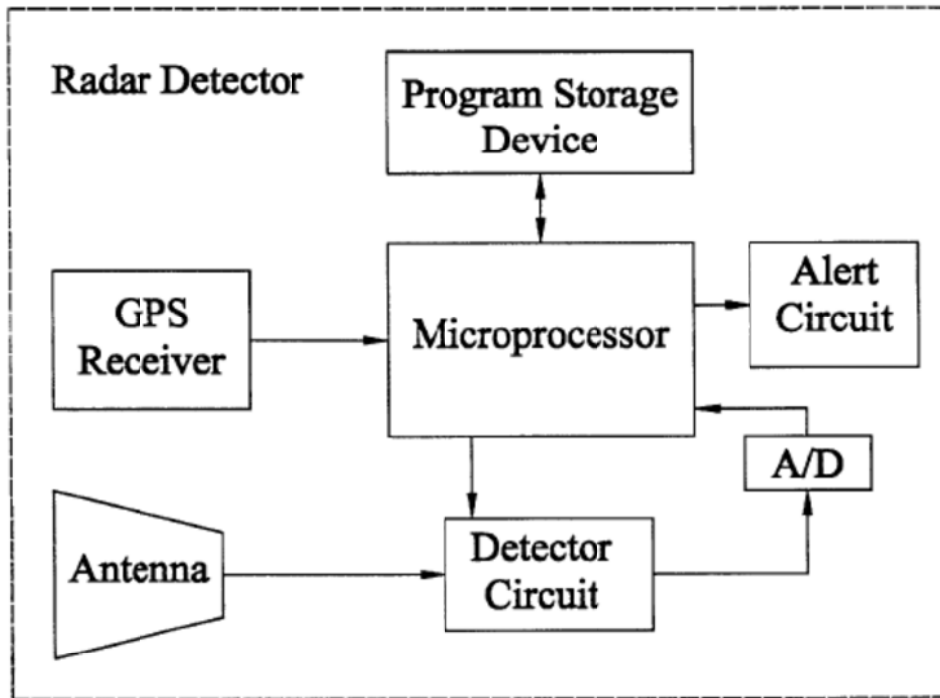


Fig. 1

Fleming, III, Figure 1

As shown above in Figure 1, Fleming, III discloses a radar detector having a detector circuit to collect radar signals from an antenna, a microprocessor to process those signals, and an alert circuit to communicate information regarding detected radar signals to the operator of a motor vehicle. Fleming, III, col. 2, ll. 25-29, 50-53. The radar detector in Fleming, III also includes a GPS receiver, which can be used to calculate the location, velocity, and heading of the radar detector. Fleming, III, col. 3, ll. 10-22.

Fleming, III further discloses that the storage device contains code that commands the microprocessor to determine whether to generate an alert based upon the position, velocity, and heading data received from the GPS receiver. Fleming, III, col. 3, ll. 30-36. “By utilizing the above method, many false alarms

may be eliminated.” Fleming, III, col. 3, ll. 44-45. Thereby, Fleming, III discloses a method by which the user of the radar detector can program certain locations as false alarm locations. *See* Fleming, III, col. 3, ll. 53-60. Fleming, III discloses that “if an operator of a motor vehicle approaches a microwave automatic door opener, then the operator can depress an ‘*ignore radar*’ button,” and the “radar detector would store the position of the radar detector and possibly the frequency and the signal strength of the incoming radar signal in the program storage device of FIG. 1.” Fleming, III, col. 3, ll. 55-60 (emphasis added). Alternatively, Fleming, III discloses that the radar detector user can hold down a “mute” button to designate a particular location as a false alarm location. Fleming, III, col. 3, ll. 63-65. Furthermore, the radar detector can access a database containing position, frequency, and signal strength for specific geographic regions identified by others as false alarm locations. Fleming, III, col. 3, l. 65 – col. 4, l. 5.

2. *Analysis*

Petitioner contends that claims 2-8 and 10 are anticipated by Fleming, III. Pet., 38-45. Patent Owner counters that Fleming, III is not prior art because it was antedated by the 2004 Orr Declaration during the prosecution of the '721 patent. Prelim. Resp., 48-52. As discussed above, we are not persuaded by Patent Owner's arguments. As to the merits of the proposed grounds of anticipation, Patent Owner does not argue that Fleming, III fails to disclose any of the elements of claims 2-8 and 10. We have reviewed Petitioner's analysis and supporting evidence regarding the proposed grounds of anticipation of claims 2-8 and 10 based on Fleming, III and determine that Petitioner has met its burden under 35 U.S.C. § 312. For example, with respect to the recitation in claim 2 regarding a “position determining circuit generating a location signal,” Petitioner cites to Fleming, III's disclosure that its radar detector includes a GPS receiver that can

determine the location, velocity and heading of the radar detector. Pet., 41 (citing Fleming, III, col. 3, ll. 10-22); *see also* Bartone Decl., ¶ 59. Additionally, with respect to the recitation in claim 5 of “obtaining information on geographic locations that was gathered by another police warning receiver,” Petitioner cites to Fleming, III’s disclosure that it is possible to generate a database of position, frequency and signal strength for a specific geographic region, which can be accessed by a cellular phone coupled to the microprocessor of the radar detector. Pet., 43 (citing Fleming, III, col. 3, l. 65 – col. 4, l. 5); *see also* Bartone Decl., ¶ 63. Furthermore, with respect to the recitation in claim 7 that “said information comprises a velocity of a vehicle carrying said receiver at a geographic location[],” Petitioner cites to Fleming, III’s disclosure that the “velocity of the radar detector is determined” and “an alert is generated if the velocity of the radar detector is greater than a predetermined velocity.” Pet., 44 (citing Fleming, III, col. 5, ll. 47-51); *see also* Bartone Decl., ¶ 65.

For these reasons, Petitioner has demonstrated that there is a reasonable likelihood that it will prevail with respect to claims 2-8 and 10 based on the ground that these claims are anticipated by Fleming, III.

D. Obviousness of claims 2-10, by Fleming, III and Hoffberg

Petitioner contends that claims 2-10 are obvious in view of Fleming, III and Hoffberg. Pet., 45-49. Patent Owner repeats the same arguments as before, that Fleming, III and Hoffberg are not prior art and have been considered previously by the Office. Prelim. Resp., 44-53. As discussed above, we are not persuaded by Patent Owner’s arguments. As to the merits of the proposed grounds of obviousness, Patent Owner does not contest Petitioner’s challenge that claims 2-10 are obvious in view of Fleming, III and Hoffberg.

We have reviewed Petitioner’s analysis and supporting evidence regarding

the proposed grounds of obviousness of claims 2-10 in view of Fleming, III and Hoffberg and determine that Petitioner has met its burden under 35 U.S.C. § 312. For these reasons, Petitioner has demonstrated that there is a reasonable likelihood that it will prevail with respect to claims 2-10 based on the ground that these claims are obvious in view of Fleming, III and Hoffberg.

E. Related Litigation

Patent Owner contends that Petitioner's *inter partes* review petition should be denied because of certain findings in related litigation between the Patent Owner and the licensor of the Petitioner in the District Court for the District of Idaho. Prelim. Resp., 60. According to Patent Owner, the District Court in that litigation has determined that Mr. Orr reduced his invention to practice before the effective date of Fleming, III. Pet. 54. We are not persuaded by Patent Owner's arguments that this related litigation requires denial of this petition. First, the Patent Owner has not asserted that Petitioner is a party to the District of Idaho litigation and, therefore, bound by the result. *See Ex. 2005, Hoyt A. Fleming v. Escort, Inc. and Beltronics USA, Inc.*, 1:09-cv-105BLW, Complaint. Second, the district court's decision is not final.

III. SUMMARY

Petitioner has demonstrated that there is a reasonable likelihood of its prevailing on its challenge to the patentability of claims 1-10 of the '721 patent.

The Petition is granted as to the following grounds proposed:

- A. Claims 1-10 are anticipated by Hoffberg.
- B. Claims 2-8 and 10 are anticipated by Fleming, III.
- C. Claims 2-10 are obvious in view of Fleming, III and Hoffberg.

IV. ORDER

For the reasons given, it is

ORDERED that the Petition is *granted* as to claims 1-10.

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '721 patent is hereby *instituted* commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

FURTHER ORDERED that the trial is limited to the grounds proposed in the Petition/identified above as A, B, and C. No other grounds are authorized.

FURTHER ORDERED that an initial conference call with the Board is scheduled for 2:00 PM Eastern Time on September 30, 2013. The parties are directed to the Office Trial Practice Guide, 77 Fed. Reg. 48756, 48765-66 (Aug. 14, 2012) for guidance in preparing for the initial conference call, and should come prepared to discuss any proposed changes to the Scheduling Order entered herewith and any motions the parties anticipate filing during the trial.

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