

UBER TECHNOLOGIES, INC. v. X ONE, INC., Appeal No. 2019-1164 (Fed. Cir. May 5, 2020). Before Prost, Dyk, and Wallach. Appealed from the Patent Trial and Appeal Board.

Background:

X One owned a patent covering an apparatus for exchanging location information between mobile devices. The claims recited an apparatus that would allow map and location sharing between two users with different mobile devices, such that they would see each other's location on a map.

Uber filed a petition for *inter partes* review (IPR) asserting that the claims would have been obvious over a combination of Okubo and Konishi. The Board determined that the claims' recitation of software "to transmit the map with plotted locations to the first individual," was non-obvious over these references. The Board held that this claim feature implied "server-side" location plotting, which would not have been obvious. In other words, the server plots the user locations on the map, and sends the plotted map to the user terminal.

Both Okubo and Konishi were directed to transmitting location information between mobile devices. The Board found that Okubo disclosed "terminal-side" plotting, where the locations are plotted on the map by the terminal instead of the server. The Board found that Konishi disclosed "server-side" plotting like the claims. However, the Board held that combining this feature of Konishi into Okubo would not have been obvious because it would have been a "wholesale modification of Okubo" and "represent impermissible hindsight."

Uber appealed.

Issue/Holding:

Did the Board err in finding that the claims were not obvious? Yes, reversed and remanded.

Discussion:

The Federal Circuit held that a person having ordinary skill would have been faced with only two options for map plotting: server-side plotting or terminal-side plotting. Given only two options, it would have been obvious to one of ordinary skill to pick one of them (or swap one for the other) as an obvious design choice. Thus, a person having ordinary skill would have found it obvious to combine Okubo with Konishi to use server-side plotting in Okubo.

The Federal Circuit dismissed X One's argument that because Okubo was directed to a low-data-rate differential GPS system, and Konishi uses a cellular network, the two references were not combinable. The Federal Circuit stated that it is not necessary for two prior art references to be physically combinable to support a finding of obviousness. Instead, the question is whether the claimed inventions are rendered obvious by the teachings of the prior art as a whole.