

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Microsoft Corporation,
Petitioner

v.

MOBILE TELECOMMUNICATIONS TECHNOLOGIES, LLC
Patent Owner

Case IPR2016-01581
Patent 5,754,946

**PATENT OWNER MOBILE TELECOMMUNICATIONS
TECHNOLOGIES, LLC'S PRELIMINARY RESPONSE**

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I. BACKGROUND

On August 11, 2016, the Petitioner Microsoft Corporation (“Microsoft” or “Petitioner”) filed a Petition for *Inter Partes* Review under 37 C.F.R. § 42.100, requesting *inter partes* review of claims 1-2, 4, and 7-9 of U.S. Patent No. 5,754,946 (“the ’946 Patent”) on two grounds. The Petitioner asserts that claims 1-2, 4, and 7-9 of the ’946 Patent are unpatentable over the following references under 35 U.S.C. §§ 102, 103:¹

Ground 3 - Claims 1, 4, and 7-8 as anticipated and obvious over U.S. Patent No. 5,448,759 (“*Krebs*”); and

Ground 4 – Claims 1-2, 4, and 7-9 as obvious over *Krebs* in view of U.S. Patent No. 5,396,537 (“*Schwendeman*”) in view of U.S. Patent No. 5,031,179 (“*Yoshida*”).

The ’946 Patent, entitled “Nationwide Communication System,” was filed on September 21, 1993 and issued on May 19, 1998. The ’946 Patent expired on May 19, 2015.

The ’946 Patent describes and claims methods and systems for communication between a system network and a mobile unit. The system network

¹ Grounds 1 and 2 involving four other references: Japanese Unexamined Patent Application H2-213237 (“*Akiyama*”), U.S. Patent No. 4,940,963 (“*Gutman*”), U.S. Patent No. 4,644,351 (“*Zabarsky*”), and U.S. Patent No. 5,311,516 (“*Kuznicki*”), are described in another petition, IPR2016-01576.

includes a plurality of base transmitters and base receivers included in the network. The base transmitters are divided into zonal assignments and broadcast in simulcast using multi-carrier modulation techniques. The system network controls the base transmitters to broadcast in simulcast during both systemwide and zonal time intervals. The system network dynamically alters zone boundaries to maximize information throughput. The system also uses a mobile unit which receives messages from the network and transmits messages to the network. The mobile unit includes a switch that allows a user to request the network to retransmit a portion of a received message that contains errors. Ex. 1001 at Abstract.

II. INTRODUCTION

The Patent Owner, Mobile Telecommunications Technologies, LLC, submits this Preliminary Response to the Petition for *Inter Partes* Review of claims 1-2, 4, and 7-9 of the '946 Patent. 37 C.F.R. § 42.107.

The Patent Owner respectfully requests that the Board deny the Petition on every ground alleged by the Petitioner for, at least, the following reasons.

First, with regard to Ground 3, *Krebs* does not teach or suggest, at least, at least, “a switch actuatable to specify a portion of the displayed message for which a user desires to retransmission from the communications network,” as recited in claim 1, “a switch actuatable to specify a portion of the displayed message for

which a user desires retransmission ... means for retransmitting radio frequency signals containing the portion of the message to the mobile unit,” as recited in claim 7, and “receiving an indication of a portion of the displayed message for which a user desires retransmission; transmitting, only upon receipt of the indication, a signal requesting retransmission of said indicated portion of said message,” as recited in claim 8 (hereinafter collectively referred to as the “user specified or indicated portion limitation”). Dependent claim 4 is not obvious over *Krebs*, because independent claim 1 from which it depends, is not obvious over *Krebs* and because of the additional features it recites.

For anticipation under 35 U.S.C. §102 a proponent must show “that the four corners of a single prior art document describe every element of the claimed invention.” Obviousness under 35 U.S.C. §103 requires that all claim limitations must be taught or suggested by the applied references. For Ground 3, the Petitioner relies on *Krebs* for the user specified or indicated portion limitation. Its argument is a simple assertion that, because the original message in *Krebs* gets transmitted in response to a notification message and the notification message may contain a part of the original message, part of the notification message gets retransmitted. It has not argued that a part of the notification message is specified or indicated by the user as required by the user specified or indicated portion limitation. Nor has it argued that retransmission of a part of the notification

message is desired by the user also as required by the user specified or indicated portion limitation.

Also, the Patent Owner submits that in *Krebs* there is no need for the user to specify or indicate to the central processor what part of the notification message should be retransmitted with the original message. Additionally, the central processor of *Krebs* knowing that it had already sent part of the original message in the notification message could conserve bandwidth by *not* retransmitting that portion of the notification message. This latter argument is admitted by the Petitioner.

At least because the Petitioner's argument regarding *Krebs* teaching or suggesting this limitation does not even include a discussion of the elements of the limitation, there is no reasonable likelihood that the Petitioner can prevail with regard to claims 1, 4, and 7-8 of the '946 Patent according to Ground 3.

Second, with regard to Ground 4, *Krebs*, *Schwendeman*, and *Yoshida*, individually or in combination, do not teach or suggest, at least, the user specified or indicated portion limitation as recited in claims 1 and 7-8. Dependent claims 2, 4, and 9 are not obvious over *Krebs*, *Schwendeman*, and *Yoshida*, because independent claims 1 and 8, from which they depend respectively, are not obvious over *Krebs*, *Schwendeman*, and *Yoshida* and because of the additional features they recite.

Obviousness under 35 U.S.C. §103 requires that all claim limitations must be taught or suggested by the applied references. For Ground 4, the Petitioner relies on *Schwendeman*, and *Yoshida* for the user specified or indicated portion limitation. Its entire argument with regard to this limitation is that *Schwendeman* discusses a retransmission of an entire message and *Yoshida* describes retransmitting the erroneous part of a message. Again it does not argue that a part of the notification message is specified or indicated by the user or that retransmission of a part of the notification message is desired by the user. In addition, the portions of *Schwendeman* and *Yoshida* cited by the Petitioner do not support such an argument. At least because the Petitioner's argument regarding *Schwendeman* and *Yoshida* teaching or suggesting this limitation does not even include a discussion of the elements of the limitation, there is no reasonable likelihood that the Petitioner can prevail with regard to claims 1-2, 4, and 7-9 of the '946 Patent according to Ground 4.

Therefore, there is no reasonable likelihood that the Petitioner can prevail with regard to claims 1-2, 4, and 7-8 of the '946 Patent on either ground.

III. PROPER CLAIM CONSTRUCTION

A. Rules Governing Claim Construction

1. *Phillips* Standard Governs

The '946 Patent expired on May 19, 2015, so the proper claim construction is that used in district court review. The broadest reasonable interpretation (BRI) standard does not apply. In regard to the proper claim construction used in district court review, MPEP 2258 provides that “[i]n a reexamination proceeding involving claims of an expired patent, claim construction pursuant to the principle set forth by the court in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (words of a claim “are generally given their plain and ordinary meaning” as understood by a POSA at the time of the invention) should be applied since the expired claims are not subject to amendment. *See Ex parte Papst-Motoren*, 1 USPQ2d 1655 (Bd. Pat. App. & Inter. 1986).”

i. Look to Claims Themselves and Then Specification

The first step in construing claims under *Phillips* is to “look to the words of the claims themselves.” *Vitrionics Corp. v. Conceptiontronic*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Second, the specification must be considered when construing claim terms. *Id.* “[T]he specification is always highly relevant.” *Id.*

ii. Can Read Specification Limitations into Claims

Claim construction under *Phillips* varies from the BRI standard in at least two important ways. Claim construction under *Phillips* may read limitations in the specification into the claims. For example, “[t]he presumption that a term is given its plain and ordinary meaning may be rebutted by the applicant by clearly setting forth a different definition of the term in the specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) (the USPTO looks to the ordinary use of the claim terms taking into account definitions or other “enlightenment” contained in the written description). MPEP 2111.01.

iii. Can Rely on Extrinsic Evidence

Under *Phillips*, “it is entirely appropriate, perhaps even preferable, for a court to consult trustworthy extrinsic evidence to ensure that the claim construction it is tending to from the patent file is not inconsistent with clearly expressed, plainly apposite, and widely held understandings from the pertinent technical field.” *Pitney Bowes, Inc. v. HP Co.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999).

In summary, under *Phillips* the first step in construing claims is to look to the words of the claims themselves. The second step is to consider the specification. Additionally, there is no prohibition on reading limitations in the specification into the claims, and to consult trustworthy extrinsic evidence.

B. Background on the Technology and the '946 Patent

1. Person of Ordinary Skill in the Art

A person having ordinary skill in the art at the time of the invention (PHOSITA) of the '946 Patent would possess a bachelor's degree in electrical engineering or its equivalent and about four years working in the field of wireless telecommunications networks and would possess knowledge regarding wireless transmission protocols as used in telecommunications, or equivalent education and work experience.

2. Claim Limitations

Independent claim 1 recites: a two-way wireless data communication system including a switch actuatable to specify a portion of the displayed message for which a user desires retransmission, and means for transmitting, only upon actuation of the switch, a signal to the communications network requesting retransmission of the specified portion of the message. Independent claim 7 recites: a two-way wireless data communication system including a switch actuatable to specify a portion of the displayed message for which a user desires retransmission, means for receiving, from a mobile unit, radio frequency signals representing a portion of the message that the user desires retransmission; and means for retransmitting radio frequency signals containing the portion of the message to the mobile unit. Independent claim 8 recites: a two-way wireless data

communication method including receiving an indication of a portion of the displayed message for which a user desires retransmission and transmitting, only upon receipt of the indication, a signal requesting retransmission of said indicated portion.

C. Construction of Independent Claim Terms

1. “retransmission” or “retransmitting” of claims 1 and 7-8

Challenged claims 1 and 7-8 recite a “retransmission.” The Petitioner asserts that, because of issue preclusion, the interpretation of “retransmission” to the mobile unit should not be limited to a second transmission from the network to the mobile unit, but must also include a single transmission to the mobile unit if the information transmitted is relayed at least once within the network.

The Patent Owner submits that the term “retransmission” should be construed to have its plain and ordinary meaning. This plain and ordinary meaning is the transmission of something again, or for a second time.

2. “means for receiving a radio frequency message from the network” of claim 1

Challenged claim 1 recites “means for receiving a radio frequency message from the network.” The Petitioner asserts that the corresponding function is “receiving a radio frequency message from the network” and the linked structure includes an antenna (1502 or 1702) and a receiver (1506 or 1706).

The Patent Owner submits that the phrase “means for receiving a radio frequency message from the network” should be construed to have its plain and ordinary meaning.

3. “means for transmitting, only upon actuation of the switch, a signal to the communications network requesting retransmission of said specified portion of said message” of claim 1

Challenged claim 1 recites “means for transmitting, only upon actuation of the switch, a signal to the communications network requesting retransmission of said specified portion of said message.” The Petitioner asserts that the corresponding function is “transmitting, only upon actuation of the switch, a signal to the communications network requesting retransmission of said specified portion of said message” and the linked structure includes an antenna (1502), a transmitter (1520), transmit logic (1518), and a switch (1622).

The Patent Owner submits that the phrase “means for transmitting, only upon actuation of the switch, a signal to the communications network requesting retransmission of said specified portion of said message” should be construed to have its plain and ordinary meaning.

4. “means for receiving said specified portion retransmitted from the communications network and for displaying the received specified portion on the display” of claim 1

Challenged claim 1 recites “means for receiving said specified portion retransmitted from the communications network and for displaying the received specified portion on the display.” The Petitioner asserts that the corresponding function is “receiving said specified portion retransmitted from the communications network and displaying the received specified portion on the display” and the linked structure includes an antenna (1502) and a receiver (1506) for receiving a message portion, and further includes a display logic and a display for displaying the received portion.

The Patent Owner submits that the phrase “means for receiving said specified portion retransmitted from the communications network and for displaying the received specified portion on the display” should be construed to have its plain and ordinary meaning.

5. “means for detecting errors in the received message” of claim 2

Challenged claim 2 recites “means for detecting errors in the received message.” The Petitioner asserts that the corresponding function is “detecting errors in the received message” and the closest possible structure includes a receiver capable of decoding error correcting codes contained in the message.

The Patent Owner submits that the phrase “means for detecting errors in the received message” should be construed to have its plain and ordinary meaning.

6. “means for highlighting said errors when the message is displayed on said display” of claim 2

Challenged claim 2 recites “means for highlighting said errors when the message is displayed on said display.” The Petitioner asserts that the corresponding function is “highlighting said errors when the message is displayed on said display” and the linked structure includes a display capable of highlighting errors in the message by underlining errors, placing errors in brackets, or printing errors in reserve video.

The Patent Owner submits that the phrase “means for highlighting said errors when the message is displayed on said display” should be construed to have its plain and ordinary meaning.

7. “means for transmitting radio frequency signals containing a message to the mobile unit” of claim 7

Challenged claim 7 recites “means for transmitting radio frequency signals containing a message to the mobile unit.” The Petitioner asserts that the corresponding function is “transmitting radio frequency signals containing a message to the mobile unit” and the linked structure includes a base transmitter connected to an antenna.

The Patent Owner submits that the phrase “means for transmitting radio frequency signals containing a message to the mobile unit” should be construed to have its plain and ordinary meaning.

8. “means for receiving, from the mobile unit, radio frequency signals representing a portion of the message that the user desires retransmission” of claim 7

Challenged claim 7 recites “means for receiving, from the mobile unit, radio frequency signals representing a portion of the message that the user desires retransmission.” The Petitioner asserts that the corresponding function is “receiving, from the mobile unit, radio frequency signals representing a portion of the message that the user desires retransmission” and the linked structure includes a base transmitter connected to an antenna.

The Patent Owner submits that the phrase “means for receiving, from the mobile unit, radio frequency signals representing a portion of the message that the user desires retransmission” should be construed to have its plain and ordinary meaning.

9. “means for retransmitting radio frequency signals containing the portion of the message to the mobile unit” of claim 7

Challenged claim 7 recites “means for retransmitting radio frequency signals containing the portion of the message to the mobile unit.” The Petitioner asserts

that the corresponding function is “retransmitting radio frequency signals containing the portion of the message to the mobile unit” and the linked structure includes a base transmitter connected to an antenna.

The Patent Owner submits that the phrase “means for retransmitting radio frequency signals containing the portion of the message to the mobile unit” should be construed to have its plain and ordinary meaning.

10. Limitations regarding a “portion of” a message of claims 1 and 7-8

Challenged claims 1 and 7-8 each recite a “portion of” a message. The Petitioner asserts that the term is limited to “only a portion.”

The Patent Owner submits that the term a “portion of” a message should be construed to have its plain and ordinary meaning.

D. *Krebs*

Krebs is directed to improving the utilization of communication resources between a central processor and a communication unit. Ex. 1007 at 1:8-11. Communication resources are defined by the particular multiplexing scheme used. *Id.* at 1:16-18. However, wireless communication systems necessitate communication resources with bandwidths appropriate for the type of communication. *Id.* at 1:31-33. For example, file transfers or facsimile transmissions require longer bandwidths than short data messages such as pages.

Id. at 1:34-36. As a result, improving the utilization of communication resources requires improving the utilization of bandwidths appropriate for the type of communication.

Krebs provides a method for efficient communication resource bandwidth utilization when transmitting first (short) bandwidth messages, second (long) bandwidth messages, and third (still longer) bandwidth messages to a communication unit from a central processor. *Id.* at 2:9-14. It does this by providing different methods for transmitting first (short) bandwidth messages and second (long) bandwidth messages or third (still longer) bandwidth messages. When a message is a first (short) bandwidth message, it directly transmits the short message to a communication unit via a first set of communication resources used primarily for short bandwidth messages. *Id.* at 2:9-14 and Fig. 2 at 202. This is shown below in Annotation 1 of Fig. 2 of *Krebs*.

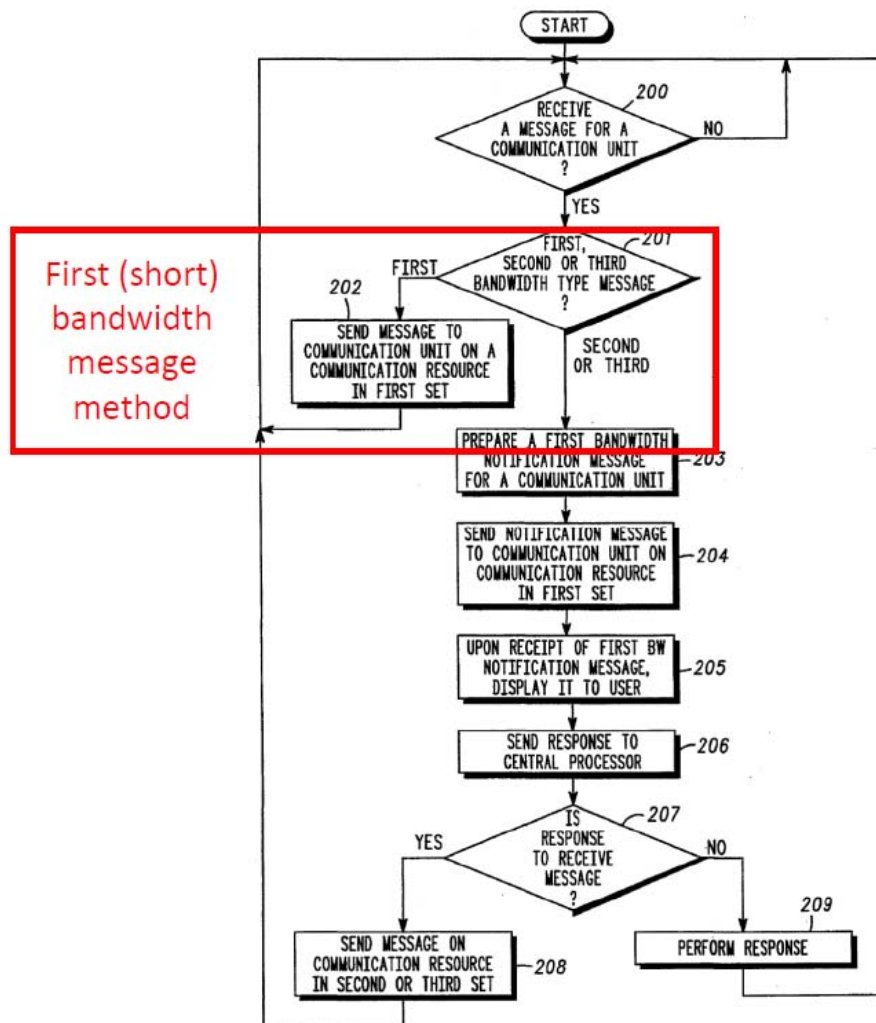


FIG. 2

Annotation 1

When a message is a second (long) bandwidth message or a third (still longer) bandwidth message, *Krebs* performs a two-step process. In the first step, it prepares a first (short) bandwidth notification message for the original message and transmits the first (short) bandwidth notification message to a communication unit via a first set of communication resources used primarily for short bandwidth messages. Ex. 1007 at 2:23-28 and Fig. 2 at 203-204. The first (short) bandwidth

notification message is a first (short) bandwidth message that notifies the communication unit that the original message is available for transmission to it. *Id.* at 4:57-61. The first (short) bandwidth notification message typically contains the originator of the original message, a summary of the message, the date sent, the length of the message, priority, and cost to retrieve the entire message over the network. *Id.* at 4:61-65. The first step of the two-step process for second (long) bandwidth messages or third (still longer) bandwidth messages is shown below in Annotation 2 of Fig. 2 of *Krebs*.

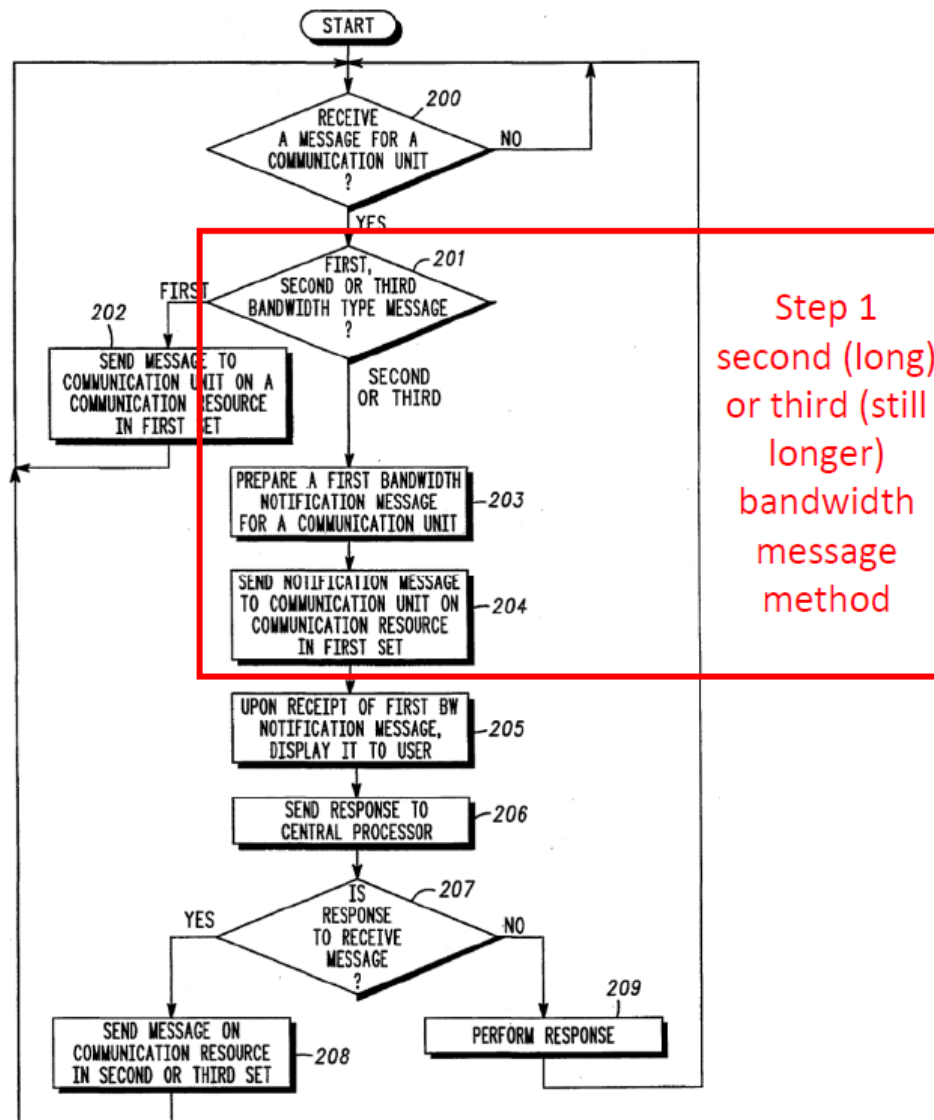


FIG. 2

Annotation 2

The second step of the two-step process for transmitting a second (long) bandwidth message or a third (still longer) bandwidth message involves interaction with the user of the communication unit (pager) before the original message is finally sent. First, when the communication unit receives the first (short) bandwidth notification message transmitted in the first step from the central

processor, it displays it to a user. Ex. 1007 at 5:3-5 and Fig. 2 at 205. Next, the user, observing the first (short) bandwidth notification message, sends a response from the communication unit to the central processor. *Id.* at 5:22-24 and Fig. 2 at 206. The response may comprise a receive message request, a delete message request, a forward message request, or a save message request. *Id.* at 5:24-26. If the response is a received message request, the central processor sends the original second (long) bandwidth message or a third (still longer) bandwidth message to the communication unit via a second or third set of communication resources used primarily for long bandwidth messages or longer still bandwidth messages, respectively. *Id.* at Fig. 2 at 207-208. The second step of the two-step process for second (long) bandwidth messages or third (still longer) bandwidth messages is shown below in Annotation 3 of Fig. 2 of *Krebs*.

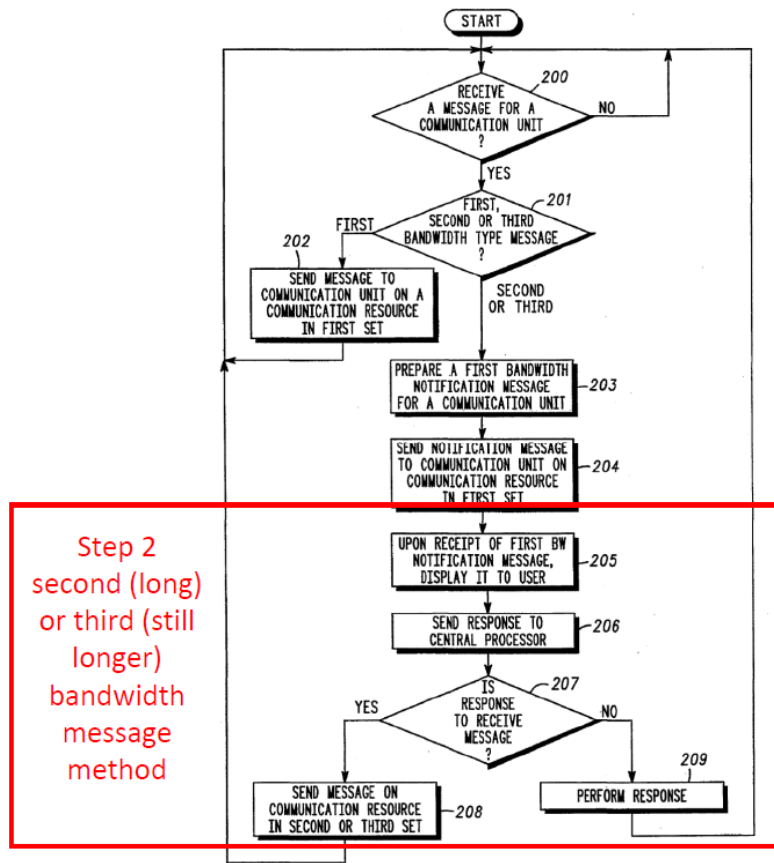


FIG. 2

Annotation 3

Krebs employs this two-step process for second (long) bandwidth messages and third (still longer) bandwidth messages to more efficiently utilize the second and third sets of communication resources. By deferring transmission of a second (long) bandwidth message or a third (still longer) bandwidth message until the communication unit requests to receive it, the second and third sets of communication resources are used more efficiently. Ex. 1007 at 2:36-40. In other words, the second and third sets of communication resources are not constantly being consumed by automatically sending second (long) bandwidth messages and

third (still longer) bandwidth messages. Instead, they are only sent when the user requests them.

The only additional cost to this two-step process is the creation and transmission of the first (short) bandwidth notification message. However, since this notification message is a shorter message than the original message and is sent via the first set of communication resources, which is used for transmitting shorter messages, the utilization of communication resources required by these first (short) bandwidth notification message is much less than the original messages.

E. *Schwendeman*

Schwendeman is directed to a method and apparatus for reliably delivering messages from a central terminal to a communication receiver in a communication system, such as an electronic mail system. Ex. 1008 at Abstract.

F. *Yoshida*

Yoshida is directed to a data communication apparatus having an error retransmission mode that allows the operator to ascertain an amount of error data when an error is contained in data, and when the error is not corrected despite retransmission of the error a predetermined number of times. It is also possible to reproduce data with respect to correctly received data by discriminating correct data contained in error data, thereby presenting error data from becoming wasted

as practically as possible. Ex. 1009 at Abstract.

IV. GROUND 3 – CLAIMS 1, 4, AND 7-8 ARE NOT ANTICIPATED BY *KREBS* AND ARE NOT OBVIOUS OVER *KREBS*.

A. Rules on anticipation and obviousness

The CAFC has held that a proponent of anticipation under 35 U.S.C. §102 must show “that the four corners of a single prior art document describe every element of the claimed invention.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (citing *Xerox Corp. v. 3Com Corp.*, 458 F.3d 1310, 1322 (Fed. Cir. 2006), citing *Advanced Display Sys. Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000).

Pursuant to the requirements for establishing a prima facie case of obviousness under 35 U.S.C. §103, all the claim limitations must be taught or suggested by the applied references. *In re Royka*, 490 F.2d 981 (CCPA 1974). “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Ex parte Frye*, 94 USPQ 2d 1072, 1076 (BPAI 2010) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), cited with approval in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

B. *Krebs* does not anticipate or render claims 1 and 7-8 obvious.

Claim 1 of the '946 Patent is directed to a mobile unit, in a two-way wireless data communication system, for transmitting and receiving radio frequency signals to and from a communications network. Claim 7 is directed to a communications network, in a two-way wireless data communication system, for transmitting radio frequency signals to a mobile unit and for receiving radio frequency signals from the mobile unit. Claim 8 is directed to a method, in a two-way wireless data communication system, for receiving and transmitting messages at a mobile unit.

Claim 1 recites “a switch actuatable to specify a portion of the displayed message for which a user desires retransmission from the communications network,” claim 7 recites “a switch actuatable to specify a portion of the displayed message for which a user desires retransmission ... means for retransmitting radio frequency signals containing the portion of the message to the mobile unit,” and claim 8 recites “receiving an indication of a portion of the displayed message for which a user desires retransmission; transmitting, only upon receipt of the indication, a signal requesting retransmission of said indicated portion of said message.” As described above, this limitation of each of claims 1 and 7-8 is referred to as the “user specified or indicated portion limitation.”

The Patent Owner submits that *Krebs* does not anticipate claims 1 and 7-8, because it does not teach the user specified or indicated portion limitation. The

Patent Owner submits that *Krebs* does not render claims 1 and 7-8 obvious, because it does not suggest this limitation.

The Petitioner asserts that *Krebs* describes this limitation. The Petitioner says that *Krebs* describes that the user can respond to a notification message by requesting that the remaining portion of the larger second or third bandwidth message be transmitted along with those parts previously included in the notification message. Paper 1 at 36. As a result, those parts of the second or third bandwidth message which were copied into the notification message are transmitted a second time from the central processor to the mobile unit so that those parts of the notification message are retransmitted. *Id.* At least part of the notification message is not retransmitted so the notification message is transmitted only in part. *Id.* at 36-37.

The Patent Owner has described above the two-step process of *Krebs* for transmitting second (long) bandwidth messages and third (still longer) bandwidth messages. The first step of this process involves transmitting a first (short) bandwidth notification message from a central processor to a communication unit. The second step of this process involves optionally sending a receive message request from the communication unit to the central processor. This request is in response to the first (short) bandwidth notification message in order to request

transmission of the original second (long) bandwidth message or third (still longer) bandwidth message.

Therefore, the Patent Owner submits that the Petitioner is asserting that *Krebs* teaches or suggests the user specified or indicated portion limitation when it describes a user sending a receive message request in response to observing a notification message. Consequently, it is the notification message of *Krebs* that the Petitioner is equating to the displayed message of the claims of the '946 Patent.

The Patent Owner first notes that the Petitioner has not argued with respect to the user specified or indicated portion limitation that *Krebs* teaches or suggests that a user specifies or indicates a portion of the notification message. The Petitioner has broadly asserted that *Krebs* in Fig. 1 and 5:22-37, which are shown below, disclose the entire limitation. Paper 1 at 35. However, the Patent Owner submits that it is clear that *Krebs* in Fig. 1 and 5:22-37 does not disclose that a user specifies or indicates a portion of the notification message. It is important to point out that the Petitioner is saying that this figure, Fig. 1, and this passage, 5:22-37, explicitly teach the entire limitation. The Petitioner is not even saying that they suggest a limitation.

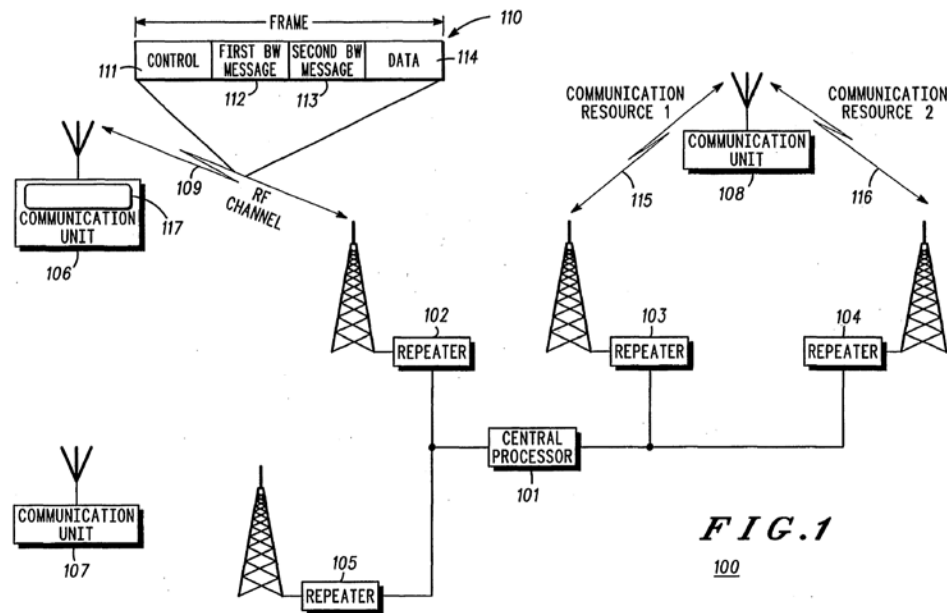


Fig. 1 of *Krebs*

Fig. 1 of *Krebs*, shown above, is silent with regard to a user specifying or indicating a portion of the notification message. The Patent Owner therefore submits that Fig. 1 of *Krebs* does not teach or suggest specifying or providing an indication of a portion of the displayed message that a user desires for retransmission, as recited in the user specified or indicated portion limitation of claims 1 and 7-8 of the '946 Patent.

Upon observing the first bandwidth notification message, the user sends a response to the central processor via the operable communication unit 206. The response may comprise a receive message request, a delete message request, a forward message request, or a save message request. The response is generally sent to the central processor immediately following the display of the first bandwidth notification message, but it may also be delayed, in which case, the central processor continues to store the message in its memory. Depending on system configuration, delaying the response to a later time of the day, when system traffic is lighter, may reduce service costs for receiving the message. If a response is not received within a predetermined period of time (e.g. 3 weeks), the central processor deletes the stored message. This time period allows the user ample time to receive any stored messages without overwhelming the memory of the central processor.

5:22-37 of *Krebs*

Similarly, 5:22-37 of *Krebs*, shown above, is silent with regard to a user specifying or indicating a portion of the notification message. The Patent Owner, therefore, submits that 5:22-37 of *Krebs* does not teach or suggest specifying or providing an indication of a portion of the displayed message that a user desires for retransmission, as recited in the user specified or indicated portion limitation of claims 1 and 7-8 of the '946 Patent.

Further, the Patent Owner submits that the argument that the Petitioner makes with regard to user specified or indicated portion limitation does not claim that *Krebs* teaches or suggests that a user specifies or indicates a desired portion of the notification message. The Petitioner simply asserts that because the original message gets transmitted in response to the request and the notification message

may contain a part of the original message, part of the notification message gets retransmitted. The Petitioner has not argued that a part of the notification message is specified or indicated by the user as required by the claim limitation. Nor has the Petitioner argued that retransmission of a part of the notification message is desired by the user.

Now, the Petitioner's expert, Mr. Gayton, does make reference to the user selecting or indicating. However, Mr. Gayton opines that this selection or indication is with respect to the original message and not with respect to the notification message. He describes that "[t]he user's selection of the 'receive' command, therefore identifies that the portion of the first or second bandwidth message previously transmitted" and that "[t]he user's selection is an indication that the portion of the second or third bandwidth message that had not been sent previously should be transmitted." As a result, Mr. Gayton also does not argue that a part of the notification message is specified or indicated by the user as required by the claim limitation. Nor does he argue that retransmission of a part of the notification message is desired by the user.

Neither the Petitioner nor Mr. Gayton makes such an argument because it would not make any sense to a PHOSTIA. Quite simply, *Krebs* explicitly discloses that the central processor creates the notification message. Ex. 1007 at 4:65-68. Assuming, *arguendo*, that the notification message includes some part of

the original message, the central processor must know what part of the original message is in the notification message. A PHOSTIA would then understand that there is no need for the user to specify or indicate to the central processor what part of the notification message should be retransmitted with the original message. Also, a PHOSTIA would understand that the central processor of *Krebs* knowing that it had already sent part of the original message in the notification message could conserve bandwidth by *not* retransmitting that portion of the notification message.

Indeed, the Petitioner oddly also makes this last argument for the Patent Owner, essentially undercutting their entire premise. The Petitioner writes that “[a]nother approach that would have been obvious to a POSITA would was to transmit only the parts of the full second or third bandwidth message that had not been sent before in order to meet Krebs’ goal of efficiently using bandwidth.” Paper 1 at 37.

In summary, *Krebs* does not teach or suggest independent claims 1 and 7-8 of the ‘946 Patent, because, at least, it does not teach or suggest the user specified or indicated portion limitation of these claims. *Krebs* does not teach or suggest this limitation because there is no suggestion in *Krebs* that a portion of the notification message is specified or indicated by a user desiring retransmission of that portion. In fact, a PHOSTIA would understand that even if the notification message

included a part of the original message there is no need for the user of *Krebs* to specify or indicate a portion of the notification message to the central processor because the processor would already know what part of the original message is in the notification message.

As a result, *Krebs* does not anticipate or render obvious independent claims 1 and 7-8 of the '946 Patent.

C. *Krebs* does not anticipate or render dependent claim 4 obvious.

Dependent claim 4 is also not anticipated or rendered obvious over *Krebs*, because independent claim 1, from which it depends, is not obvious over *Krebs* and because of the additional features it recites.

V. GROUND 4 – CLAIMS 1-2, 4, AND 7-9 ARE NOT OBVIOUS OVER *KREBS* IN VIEW OF *SCHWENDEMAN* AND *YOSHIDA*.

A. *Krebs*, *Schwendeman*, and *Yoshida* do not render claims 1 and 7-8 obvious.

As noted above, pursuant to the requirements for establishing a prima facie case of obviousness under 35 U.S.C. §103, all the claim limitations must be taught or suggested by the applied references. *In re Royka*, 490 F.2d 981 (CCPA 1974).

The Patent Owner submits that *Krebs*, *Schwendeman*, and *Yoshida*, individually or in combination, do not teach or suggest, at least, the user specified or indicated portion limitation of claims 1 and 7-8 of the '946 Patent.

The Petitioner first asserts that *Krebs* discloses this limitation. Paper 1 at 57.

As described above with regard to Ground 3, the Patent Owner has shown that *Krebs* does not teach or suggest this limitation because there is no suggestion in *Krebs* that a portion of the notification message is specified or indicated by a user desiring retransmission of that portion. Further, if *Krebs* did disclose this limitation, there would be no need to combine it with any other references.

The Petitioner next asserts that *Schwendeman* describes that a user can manually request retransmission of previously received messages. *Id.* at 58. However, the Petitioner admits that *Schwendeman* describes the use of a telephone network for retransmissions and *Schwendeman* only discusses retransmission of the entire message. *Id.* at 58-59.

Finally, the Petitioner asserts that *Yoshida* describes retransmitting only the erroneous part of the message. *Id.* at 58-59. Although the Petitioner does not explicitly describe how all of the references are combined, it appears to be suggesting that the message transfer technique of *Krebs* is combined with the retransmission technique of *Schwendeman*, which, in turn, is combined with the technique of retransmitting only the erroneous part of the message of *Yoshida*.

As described above, pursuant to the requirements for establishing a prima facie case of obviousness under 35 U.S.C. §103, all the claim limitations must be taught or suggested by the applied references.

The Patent Owner submits that the user specified or indicated portion limitation of claims 1 and 7-8 of the '946 Patent is not disclosed or suggested by any of the three references cited by the Petitioner. Again, with regard to *Krebs*, the Patent Owner has shown above in Ground 3 that *Krebs* does not teach or suggest this limitation because there is no suggestion in *Krebs* that a portion of the notification message is specified or indicated by a user desiring retransmission of that portion.

In regard to *Schwendeman*, the Petitioner admits that *Schwendeman* only discusses retransmission of the entire message. The user specified or indicated portion limitation explicitly recites specifying or indicating a portion of the displayed message the user desires be retransmitted. Because *Schwendeman* does not teach or suggest specifying or indicating a portion of the displayed message the user desires be retransmitted, it cannot teach this limitation.

Finally, in regard to *Yoshida*, the Patent Owner submits that this reference only discloses retransmitting an erroneous part of a message automatically. Specifically, the Petitioner references *Yoshida's* description of the automatic repeat request (ARQ) protocol. Therefore, *Yoshida* cannot teach or suggest specifying or indicating a portion of the displayed message the user desires be retransmitted. The only passages of *Yoshida* that the Petitioner cites for support are the Abstract and 1:50-66. These passages are shown below.

[57]

ABSTRACT

A data communication apparatus having an error retransmission mode allows the operator to ascertain an amount of error data when an error is contained in data and when the error is not corrected despite retransmission of the error a predetermined number of times, or makes it possible to reproduce data with respect to correctly received data by discriminating correct data contained in error data, thereby preventing error data from becoming wasted as practically as possible. In addition, at the time of error retransmission, a transmission mode for retransmitting the error data is changed so as to minimize the number of incidents of error retransmission, thereby to enable efficient data transmission.

Abstract of *Yoshida*

The Abstract of *Yoshida*, shown above, is silent with regard to a user specifying or indicating a portion of a displayed message for retransmission.

In the ARQ system, the following three systems are 50
used depending on a method of retransmission:

(1) Basic ARQ (Stop-and-Wait, Idle-RQ)

This is a system wherein a confirmed response is
returned each time one data block is received, and an
ensuing data block is sent after confirmation. 55

(2) Continuous block transmission ARQ (Go-back-N)

This is a system wherein data blocks are transmitted
continuously, and when a response for request for re-
transmission is given, the process returns to the block in
which the error occurred, and an ensuing block N is 60
retransmitted without disturbing the order of the
blocks.

(3) Selective retransmission ARQ (Selective Repeat)

This system is a modification of the continuous block
transmission ARQ, and is designed to retransmit only an 65
error block.

The foregoing description appears in Data Communi-
cation Handbook, compiled by the Electronic Commu-

1:50-66 of *Yoshida*

1:50-66 of *Yoshida*, shown above, are also silent with regard to a user
specifying or indicating a portion of a displayed message for retransmission.

In summary, *Krebs*, *Schwendeman*, and *Yoshida*, individually or in
combination, do not teach or suggest, at least, the user specified or indicated
portion limitation of claims 1 and 7-8 of the '946 Patent. As a result, *Krebs* in
view of *Schwendeman* and *Yoshida* does not anticipate or render obvious
independent claims 1 and 7-8 of the '946 Patent.

B. *Krebs, Schwendeman, and Yoshida* do not render dependent claims 2, 4, and 9 obvious.

Dependent claims 2, 4 and 9 are also not obvious over *Krebs, Schwendeman*, and *Yoshida*, because independent claims 1 and 8, from which they depend respectively, are not obvious over *Krebs, Schwendeman*, and *Yoshida* and because of the additional features they recite.

VI. CONCLUSION

For the foregoing reasons, the Patent Owner respectfully requests that the Board find that Grounds 3-4 in the Petition do not present a reasonable likelihood of unpatentability, and decline to institute *Inter Partes* Review of the '946 Patent.

Specifically, the Patent Owner respectfully requests that the Board deny the Petition on every ground alleged by the Petitioner for, at least, the following reasons.

First, with regard to Ground 3, *Krebs* does not teach or suggest, at least, the “user specified or indicated portion limitation” as recited in independent claims 1 and 7-8. Dependent claim 4 is not obvious over *Krebs*, because independent claim 1 from which it depends, is not obvious over *Krebs* and because of the additional features it recites.

For anticipation 35 U.S.C. §102 a proponent must show “that the four corners of a single prior art document describe every element of the claimed

invention.” Obviousness under 35 U.S.C. §103 requires that all claim limitations must be taught or suggested by the applied references. For Ground 3, the Petitioner relies on *Krebs* for the user specified or indicated portion limitation. Its argument is a simple assertion that, because the original message in *Krebs* gets transmitted in response to a notification message and the notification message may contain a part of the original message, part of the notification message gets retransmitted. It, therefore, has not argued that a part of the notification message is specified or indicated by the user as required by the user specified or indicated portion limitation. Nor has it argued that retransmission of a part of the notification message is desired by the user also as required by the user specified or indicated portion limitation.

Also, the Patent Owner submits that in *Krebs* there is no need for the user to specify or indicate to the central processor what part of the notification message should be retransmitted with the original message. Additionally, the central processor of *Krebs* knowing that it had already sent part of the original message in the notification message could conserve bandwidth by *not* retransmitting that portion of the notification message. This latter argument is admitted by the Petitioner.

At least because the Petitioner’s argument regarding *Krebs* teaching or suggesting this limitation does not even include a discussion of the elements of the

limitation, there is no reasonable likelihood that the Petitioner can prevail with regard to claims 1, 4, and 7-8 of the '946 Patent according to Ground 3.

Second, with regard to Ground 4, *Krebs*, *Schwendeman*, and *Yoshida*, individually or in combination, do not teach or suggest, at least, the user specified or indicated portion limitation as recited in claims 1 and 7-8. Dependent claims 2, 4, and 9 are not obvious over *Krebs*, *Schwendeman*, and *Yoshida*, because independent claims 1 and 8, from which they depend respectively, are not obvious over *Krebs*, *Schwendeman*, and *Yoshida* and because of the additional features they recite.

Obviousness under 35 U.S.C. §103 requires that all claim limitations must be taught or suggested by the applied references. For Ground 4, the Petitioner relies on *Schwendeman*, and *Yoshida* for the user specified or indicated portion limitation. Its entire argument with regard to this limitation is that *Schwendeman* discusses a retransmission of an entire message and *Yoshida* describes retransmitting the erroneous part of a message. Again it does not argue that a part of the notification message is specified or indicated by the user or that retransmission of a part of the notification message is desired by the user. In addition, the portions of *Schwendeman* and *Yoshida* cited by the Petitioner do not support such an argument. At least because the Petitioner's argument regarding *Schwendeman* and *Yoshida* teaching or suggesting this limitation does not even

include a discussion of the elements of the limitation, there is no reasonable likelihood that the Petitioner can prevail with regard to claims 1-2, 4, and 7-9 of the '946 Patent according to Ground 4.

Date: November 25, 2016

Respectfully submitted,

/John R. Kasha/

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 1.550(f), a copy of Patent Owner's Preliminary Response to Petition for *Inter Partes* Review and exhibits filed by the Mobile Telecommunications Technologies, LLC on November 25, 2016 was duly served via electronic mail upon CNg@perkinscoie.com (Chun M. Ng), CSCampbell@perkinscoie.com (Chad S. Campbell), TWimsatt@perkinscoie.com (Theodore H. Wimsatt), JCrop@perkinscoie.com (Jared W. Crop), and Patentprocurement@perkinscoie.com - counsel of record for Microsoft Corporation ("Petitioner").

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