UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.
Petitioner

v.

UNILOC LUXEMBOURG, S.A.
Patent Owner

IPR2017-1801
PATENT 8,995,433

PATENT OWNER RESPONSE TO PETITION
PURSUANT TO 37 C.F.R. §42.120

Table of Contents

List of Exhibits

Exhibit No.	Description
2001	Declaration of William C. Easttom II
2002	Invalidity Contentions Submitted on December 16, 2016 in the underlying consolidated case of *Uniloc USA, Inc. v. Samsung Electronic America's, Inc*., Case No. 2:16-cv-642
2003	U.S. Pat. App. Pub. No. 2004/0128356 ("*Bernstein*")

II. INTRODUCTION

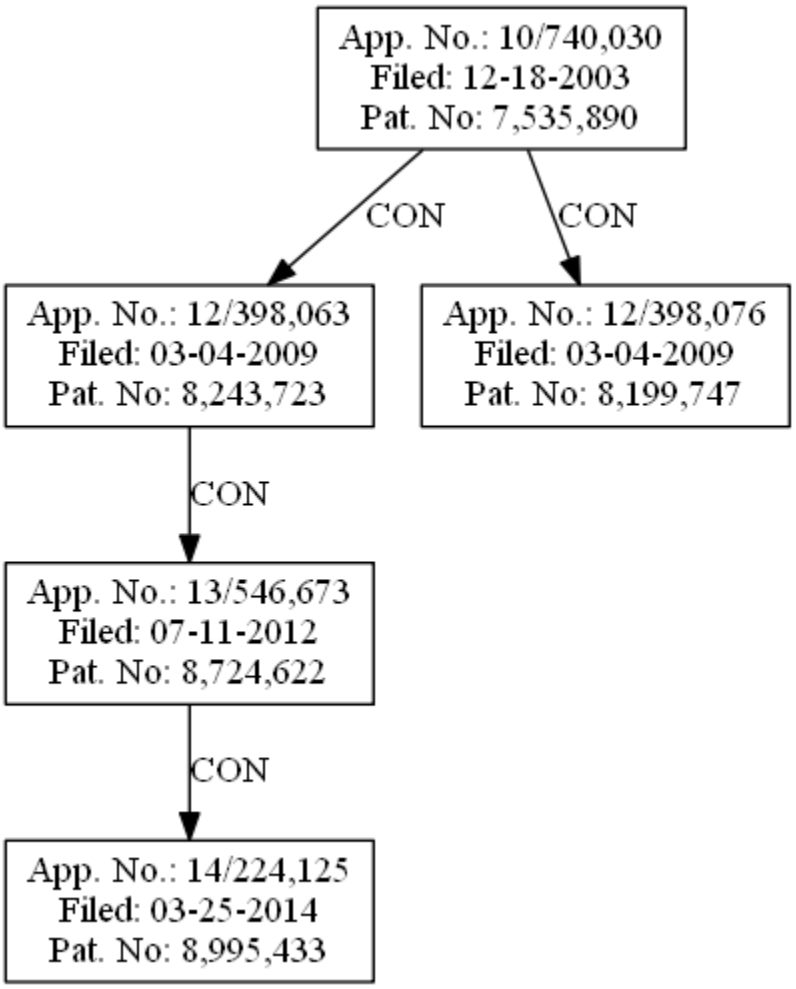
Patent Owner, Uniloc Luxembourg S.A., submits this Owner's Response to Petitioner Samsung Electronics America, Inc.'s Petition for *Inter Partes* Review ("Petition" or "Pet. at _") of United States Patent No. 8,995,433 B2 ("the '433 Patent" or "EX1001") challenging Claims 1-5, 7-12, 14-17, 25, and 26 for obviousness.

The Petition should be denied in its entirety. Petitioner fails to meet its burden of proving that even one challenged claim is unpatentable. Specifically, the Petition fails to satisfy the All Elements Rule and also fails to show that even one challenged claim would have been obvious in view of the asserted references when the claimed subject matter is taken as a whole at the time the application was filed.

III. THE ’433 PATENT DESCRIBES INSTANT VOICE MESSAGING OVER A PACKET-SWITCHED NETWORK.

A. Effective Filing Date of the ’433 Patent

The ’433 Patent is in a family of patents including United States Patent Nos. 8,199,747 (the ’747 Patent); 7,535,890 (the ’890 Patent); 8,243,723 (the ’723 Patent); and 8,724,622 (the ’622 Patent). The diagram below charts how this family of patents is interrelated.



The ’433 Patent is titled “System and Method for Instant VoIP Messaging.” The ’433 Patent issued March 31, 2015 from United States Patent Application

No. 14/224,125, which is a Continuation of Application No. 13/546,673, filed on Jul. 11, 2012, now Pat. No. 8,724,622, which is a Continuation of Application No. 12/398,063, filed on Mar. 4, 2009, now Pat. No. 8,243,723, which is a Continuation of Application No. 10/740,030, filed on Dec. 18, 2003, now Pat. No. 7,535,890.

B. Overview of the Technology Protected by the '433 Patent

The Abstract of the '433 Patent provides an overview of the technical disclosure:

> Methods, systems and programs for instant voice messaging over a packet-switched network are provided. A method for instant voice messaging may comprise receiving an instant voice message having one or more recipients, delivering the instant voice message to the one or more recipients over a packet-switched network, temporarily storing the instant voice message if a recipient is unavailable; and delivering the stored instant voice message to the recipient once the recipient becomes available.

EX1001, Abstract.

Conventional circuit-switched communications enabled traditional telephony yet had a variety of technical disadvantages that limited developing other forms of communication over such networks. According to the '433 Patent, "[c]ircuit switching provides a communication path (i.e., dedicated circuit) for a telephone call from the telephone terminal to another device . . . over the [public switched telephone

network or] PSTN, including another telephone terminal. During the telephone call, voice communication takes place over that communication path." EX1001, 1:30–35.

The '433 Patent expressly distinguishes circuit-switched networks from packet-switched networks at least in that the latter routes packetized digital information, such as "Voice over Internet Protocol (i.e., 'VoIP'), also known as IP telephony or Internet telephony." *Id*. at 1:36–38. Because legacy circuit-switched devices were unable to communicate directly over packet-switched networks, media gateways were designed to receive circuit-switched signals and packetize them for transmittal over packet-switched networks, and vice versa. *Id*. at 2:9–22. The conversion effected by media gateways highlights the fact that packetized data carried over packet-switched networks is different from and incompatible with an audio signal carried over a dedicated circuit-switched network. *Id*. The '433 Patent explains that, notwithstanding the advent of instant text messages, at the time of the claimed invention there was no similarly convenient analog to leaving an instant voice message over a packet-switched network. *Id*. at 2:35–48. Rather, "[c]onventionally, leaving a voice message involves dialing the recipient's telephone number (often without knowing whether the recipient will answer), waiting for the connection to be established, speaking to an operator or navigating through a menu of options, listening to a greeting message, and recording the message for later

pickup by the recipient. In that message, the user must typically identify himself or herself in order for the recipient to return the call." *Id*. at 2:27– 34.

The '433 Patent describes a user-accessible client configured for instant voice message and for direct communication over a packet-switched network (e.g., through an Ethernet card). *Id*. at 12:13–16. Certain clients are specially configured to "listen[] to the input audio device 212," "record[] the user's speech into a digitized audio file 210 (i.e., instant voice message) stored on the IVM client 208," and "transmit[] the digitized audio file 210" as packetized data (e.g., using TCP/IP) over a packet-switched network (e.g., network 204) "to the local IVM server 202." *Id*. at 8:12–26, Fig. 2.

C. Claims 1, 6, and 9 of the '433 Patent Are in Independent Format.

Independent Claims 1, 6, and 9 recite systems for transmitting instant voice messages over a packet-switched network:

> 1. A system comprising:
>
> an instant voice messaging application including a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over a packet-switched network via a network interface;
>
> wherein the instant voice messaging application displays a list of one or more potential recipients for the instant voice message;
>
> wherein the instant voice messaging application includes a message database storing the instant voice message, wherein the instant voice message is represented by a database record including a unique identifier; and
>
> wherein the instant voice messaging application includes a file manager system performing at least one of storing, deleting and

retrieving the instant voice messages from the message database in response to a user request.

EX1001, 23:65 to 24:15.

6. A system comprising:

an instant voice messaging application including a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over a packet-switched network via a network interface;

wherein the instant voice messaging application displays a list of one or more potential recipients for the instant voice message;

wherein the instant voice messaging application includes a file manager system performing at least one of storing, deleting and retrieving the instant voice messages from a message database in response to a user request; and

wherein the instant voice messaging application includes a compression/decompression system for compressing the instant voice messages to be transmitted over the packet-switched network and decompressing the instant voice messages received over the packet-switched network.

EX1001, 24:33–51.

9. A system, comprising:

an instant voice messaging application comprising:

a client platform system for generating an instant voice message;

a messaging system for transmitting the instant voice message over a packet-switched network, and wherein the instant voice message application attaches one or more files to the instant voice message.

EX1001, 24:60–67.

IV. PERSON OF ORDINARY SKILL IN THE ART

Petitioner alleges through its declarant, Zygmunt J. Haas, that a "person of ordinary skill in the art at the time of the alleged invention of the '433 Patent ("POSA") would have had at least a bachelor's degree in computer science,

computer engineering, electrical engineering, or the equivalent and at least two years of experience in the relevant field, e.g., network communication systems. More education can substitute for practical experience and vice versa." Pet. at 9 (citing Ex. 1002, ¶¶15-16.).

Uniloc's declarant, Chuck Easttom, testified that a person of ordinary skill in the art is "someone with a baccalaureate degree related to computer technology and 2 years of experience with network communications technology, or 4 years of experience without a baccalaureate degree." EX2001 ¶ 16.

As shown by his declaration and attached curriculum vitae, Mr. Easttom's qualifications and experience exceed those of the hypothetical person having ordinary skill in the art defined above. Nevertheless, his analysis and opinions regarding the '723 Patent have been based on the perspective of a person of ordinary skill in the art as of December 2003. *Id*.

V. PETITIONER FAILS TO PROVE ANY OF THE CHALLENGED CLAIMS 1–5, 7–12, 14–17, 25, OR 26 IS UNPATENTABLE

"In an inter partes review ..., the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence." 35 U.S.C. § 316(e). Because IPR2017-1801 only presents theories of obviousness, Petitioner must demonstrate a that at least one of the challenged patent claims would have been obvious to a person having ordinary skill in the art ("PHOSITA") most pertinent to the claimed subject matter as a whole at the time the application was filed in view

of the art cited in the Petition. Petitioner fails to meet this burden. The Petition should, therefore, be denied.

A. There Was No Motivation to Combine *Zydney* with *Griffin*

Griffin does not disclose an instant voice message, does not disclose communication over a packet-switch network, and cannot be combined with *Zydney* without losing *Zydney*'s primary purpose.

1. Petitioner Does Not Establish a Prima Facie Case that *Griffin* Discloses an "Instant Voice Message."

Petitioner relies on the argument that the user interface patent to *Griffin* discloses an "instant voice message." (Pet. pp. 9–10). That argument is unsupportable, and Petitioner fails to support it. Petitioner also ignores the contrary import of *Griffin*, which is amply illustrated by significant passages in *Griffin* that contradict Petitioner's suggestion. For at least these reasons, as shown below, Petitioner fails to establish a prima facie case that *Griffin* discloses an "instant voice message," as recited by all the challenged Claims 1–5, 7–12, 14–17, 25, or 26.

The *Griffin* user interface patent is not as Petitioner asserts "a system for exchanging speech (i.e., voice) chat messages in real time between wireless mobile terminals . . . .". Pet. p. 9. Rather, *Griffin* is a user interface patent for "displaying and interacting with speech and text group chat threads." *Griffin*, 1:62–65. The distinction is important because *Griffin* is concerned with the details of how to

manage "a plurality of chat threads in a single chat history on a limited display." *Id.* at 1:65–67. The *Griffin* user interface patent focuses on building "dynamic and static buddy-lists, as well as a technique to incorporate user friendly and small screen friendly nicknames that better enable users to identify and interact with users." *Id.* at 1:67–2:6. *Griffin* is unrelated to exchanging speech chat messages in real time.

Nonetheless, Petitioner argues that *Griffin*'s "disclosed method is 'for instant messaging'" because: (1) a voice message is "transmitted in 'real-time,'" EX1002, ¶ 81; (2) "real-time speech chat messaging is consistent with how instant voice messaging is described in the specification of the '433 Patent," EX1002, ¶ 82; and, (3) terminals are "presented with information regarding the availability of other terminals." EX1002, ¶ 83. These arguments do not follow from *Griffin*; instead, they ignore the disclosure in *Griffin* or misrepresent it.

2. *Griffin* Does Not Teach Real Time Communication.

Petitioner's first flawed argument is that *Griffin* discloses an instant voice message simply because a message is "transmitted in 'real-time.'" EX1002, ¶ 81. Petitioner is mistaken. EX2001, ¶ 33.

Transmission in real time is not communication in real time. Real-time communication requires the capability for receipt in real time. Petitioner does not account for when the message is actually received. Moreover, Petitioner does not show that there is any support in *Griffin* for real-time transmission.

Petitioner's expert cites *Griffin*'s recitals of capturing speech, a passing reference to "speech and text messages" or "voice message," a "buddy list," and "recording and "transmitting." EX1002, ¶ 81. Petitioner relies solely on these recitations to argue that *Griffin* shows instant voice messaging. Pet. pp. 21–22. Petitioner's argument fails. The one and only mention of "real-time" in the entirety of the *Griffin* user interface patent is in the general Technical Field, which recites: "a novel technique of managing the display of a plurality of real-time speech and text conversations (e.g., chat threads) on limited display areas." *Griffin*, 1:9–11. EX2001, ¶34.

The passages in *Griffin* on which Petitioner relies demonstrate only that a message is sent, not when. *Griffin*, 11:48–67. *Griffin* does not disclose any detail about <u>how</u> or <u>why</u> any such conversations might be communicated in real-time. Moreover, *Griffin* teaches away from real-time communication. As shown below, *Griffin* explicitly addresses communicating when the recipient is <u>not available for real-time communication</u>.

Griffin expressly contradicts Petitioner's position that *Griffin* discloses an "instant voice message." Communication in *Griffin* is not instant. EX2001, ¶ 35. *Griffin* teaches a system that has no knowledge of, or interest in, and no way to know whether a recipient is positioned to hear a message. EX2001, ¶ 35. *Griffin* is interested only in whether a terminal is configured to be able to receive a message

at some arbitrary point in the future.

Griffin is a user interface patent, it is about managing a display of various group chat messages. EX1005, Abstract ("A single content region in a chat history display is used to display entries representative of . . . all chat histories for all of chat threads currently engaged in by a given mobile terminal."). One aspect of this interface is the use of a "buddy's presence status" to identify terminals that are able to receive a message. EX1005, 8:47–52, Fig. 9. *Griffin* uses a "presence manager to establish" this status. *Id.* at 5:9–15, Fig. 7 (internal citations omitted). As examples of "status," *Griffin* lists "Available," "Off," and "TextOnly." *Id.* at Fig. 7.

These statuses in *Griffin* indicate only that a terminal may be configured to receive a message at some point in the future. A message may not actually be delivered to a terminal even when the terminal is "Available." EX1005, 5:9–22, 6:56–7:1, 11:48–67. *Griffin* describes a message broadcaster determining "the status of the target by locating the target's identifier in a presence record." *Id.* at 6:62–7:1 (internal citations omitted). Then, for "each <u>available target</u> (i.e., where the presence record indicates that the recipient can receive the message type), the broadcast manager[] composes an inbound chat message." *Id.* (internal citations omitted) (<u>underling</u> added). The broadcast manager prepares a chat message only for "Available" terminals. *Id.* But even after composing the inbound chat message for an "Available" terminal, however, the message <u>still may not be delivered</u>: "It should

be noted, that if an inbound speech message arrives while the chat history display is not visible to the user, the received speech is queued up." *Id.* at 11:48–50. Thus, even if a terminal is listed as "Available," the terminal still may not receive the message.

Petitioner's misplaced reliance on this "presence status" to argue that *Griffin* "includes terminals 100 that are presented with information regarding the availability of other terminals 100 for messaging and facilitates the real-time (i.e., immediate) transmission of speech chat messages between available terminals" distorts the teaching of *Griffin*. EX1002, ¶ 83. Nowhere, for example, does Petitioner reference *Griffin*'s failure to deliver a message even when the terminal is "Available." *Id. Griffin* expressly contradicts Petitioner's position. No PHOSITA would have understood *Griffin* to disclose an "instant voice message." EX2001, ¶ 36.

a) *Griffin* Discloses Text Messages Not Instant Voice Messages.

Petitioner argues that because *Griffin*'s "real-time speech chat messaging is consistent with how instant voice messaging is described in the specification of the '433 Patent," then it somehow naturally follows that *Griffin* discloses an instant voice message. EX1002, ¶ 82 (underling added). Petitioner is mistaken.

Every passage of *Griffin* that Petitioner relies on is directed explicitly toward text messaging. *Id.* Petitioner does not cite to any part of *Griffin* that describes instant

voice messaging. Thus, even if it were true that *Griffin* is "consistent with" these passages in the '433 Patent, Petitioner has not established how this somehow results in *Griffin* disclosing an "instant voice message," which it does not. EX2001, ¶ 37.

b) "Push-to-Talk" Does Not Disclose an Instant Voice Message.

In addition to relying on flawed arguments, Petitioner also relies on flawed evidence. Throughout the Petition, Petitioner relies on a connotation of "push-to-talk" that is applicable today but was not applicable in 2003. Pet. at pp. 10, 16, 35, 61. EX2001, ¶ 38. When the 2017 application for *Griffin* was filed, a PHOSITA would have recognized "push-to-talk" as technology that enables a mobile device to operate as a half-duplex radio similar to a walkie-talkie. EX2001, ¶ 38. This half-duplex communication allows a user device to transmit or receive a message, but not both at the same time.

When *Griffin* was filed, "push-to-talk" was used by radio operators in, for instance, the Citizens Band. EX2001, ¶ 38. Push-to-talk over cellular did not begin to be formalized until 2006, when the Open Mobile Alliance opened its Request for Comments No. 4354. https://tools.ietf.org/html/rfc4354 (last accessed Oct. 20, 2017). Every mention of push-to-talk in *Griffin* refers to that half-duplex, radio-based communication method. No PHOSITA would equate such a method with the claimed "instant voice message." EX2001, ¶ 38.

But even if "push-to-talk" could be stretched to cover an "instant voice message," the communication in *Griffin* did not take place "over a packet-switched network," as recited in the challenged claims. In 2003, all such communication was made over circuit-switched networks. EX2001, ¶ 39.

3. Petitioner's Suggestion to Combine *Griffin* and *Zydney* Is Improper, Unworkable, and Is Incompatible with *Zydney*.

As shown, a PHOSITA would recognize that the proposed combination of *Griffin* with *Zydney* would not work. The features of *Griffin* cannot be substituted for the features of *Zydney* because they are incompatible. Moreover, if the combination were to be attempted, the result would vitiate the primary purpose of *Zydney*. EX2001, ¶ 52.

a) The Combination of *Griffin* and *Zydney* Would Render *Zydney* Inoperable for Its Intended Purpose.

Petitioner relies on a hypothetical combination of *Griffin* and *Zydney* as disclosing each of the independent claims. Pet. at 15–66. But as shown above, *Griffin* has nothing to do with whether the terminal can receive a message at the instant it was sent. The message is prepared based on a terminal's technical ability to receive the message at some arbitrary point in the future. The message is only delivered if the user has the "chat history display" visible. EX1005, 11:48–67. This is not

"instant" communication. EX2001, ¶¶ 33, 37.[1]

By contrast, *Zydney* relies on peer-to-peer communication of its "voice containers." EX1006, 15:33–34. This peer-to-peer communication occurs only when both the transmitting and receiving devices are online and capable of transmitting and receiving at the time of communication. EX1006, 15:33–34. For this to work, *Zydney* requires a transmitting device to know that the receiving device is available at the time of communication. Indeed, the stated purpose of *Zydney* is to route voice containers "to the appropriate recipients instantaneously." EX1006, at 1 (Summary of the Invention). *Griffin*'s inability to provide the sending device with the

[1] Petitioner attempts to wave away these deficiencies in *Griffin* by arguing that *Griffin* "does not, however, provide additional details regarding what precisely current status 702 indicates." Pet. at 31. That statement is disingenuous. *Griffin* shows: (1) assigning "Available" as "current status 702"; (2) creating inbound chat messages only for an "Available" target; and (3) not delivering those messages to an "Available" target if the terminal isn't displaying the proper window. *See* EX1005, 5:9–22 describing Fig. 7 ("recipients' current status 702 (i.e., an indicator of whether the recipient is ready to receive the particular type of message, speech and/or text messages only, etc.")); 6:56–7:1 ("For each available target (i.e., where the presence record indicates that the recipient can receive the message type 401), the broadcast manager 303, composes an inbound chat message 500."); 11:48–67 ("if an inbound speech message arrives while the chat history display is not visible to the user, the received speech is queued up.").

appropriate information about the receiving device is incompatible with the technical assumptions underlying *Zydney*'s entire function, which is to communicate instantaneously.

Including *Griffin* in the system described by *Zydney* would frustrate, if not eliminate, the purpose of *Zydney*. EX2001, ¶ 54. While Petitioner proposes several grounds for combining *Griffin* and *Zydney*, none addresses the fundamental incompatibility (*Griffin*'s indifference toward a recipient's immediate availability). Petitioner's grounds all rely on a fundamental misunderstanding—because the "connectivity status" in *Griffin* and *Zydney* mean entirely different things. Pet. at 37 (Petitioner's suggestions for motivations to combine *Griffin* and *Zydney*). *Zydney* requires status to include "the core states of whether the recipient is online or offline." EX1006, 14 (underlining added). *Griffin* doesn't know and doesn't care whether a recipient is actually online (i.e., whether the recipient currently has the chat history displayed). EX2001, ¶ 54.

A PHOSITA would not be motivated to combine *Griffin* and *Zydney*. *Griffin* would have to be substantially changed, which would require time and expense, before it could be compatible with *Zydney*. MPEP §2143 (If a proposed modification amounts to extra work and greater expense for no apparent reason, there is no prima facie obviousness.). Where, as here, the features of one reference cannot be substituted into the structure of a second reference, there is no prima facie

obviousness. *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983) ("The fact that features of one reference cannot be substituted into the structure of a second reference may indicate that the claims were nonobvious in view of the combined teachings of the two references.").

A proposed modification that changes the principle of operation of the reference being modified cannot render the challenged claims prima facie obvious. *See In re Ratti*, 270 F.2d 810, 813 (C.C.P.A. 1959) ("The teaching of the Chinnery et al. patent points away from the addition of any spring element [and nothing in] the disclosure of Jepson's coffee maker gasket . . . suggest[s] that any part of it has applicability to shaft seals. The two arts are at least somewhat remote from each other even if they both involve sealing."). IPR2017-1801 should be denied.

b) The Combination of *Griffin* and *Zydney* Would Result in *Zydney's* Messages Being Lost.

As explained above, *Griffin* is uninterested in when a message is actually delivered, also *Griffin* makes available only the most recent message. *Griffin* states: "In a current implementation, the most recently received speech message (or at least that portion that will fit in available memory) [is] queued at the receiving terminal." EX1005, 11:50–53. A PHOSITA would understand this to mean that *only* the most recently received speech message (or portion thereof) is queued at the receiving terminal. EX2001, ¶ 56. Also, as explained above, *Zydney* is concerned with routing

all messages "to the appropriate recipients instantaneously or stored for later delivery." EX1006, 1:20–22. EX2001, ¶ 42. If *Griffin* were to be combined with *Zydney* in the manner suggested by Petitioner, then all messages other than the most recent message would be lost. EX2001, ¶ 56. That would be unacceptable because *Zydney* stores messages that cannot be heard immediately.

Petitioner has failed to show that any PHOSITA would have been motived to combine the user interface patent *Griffin* with *Zydney*. An IPR Petition must articulate rationale that demonstrates that a PHOSITA would have a reasonable expectation of success in combining the teachings of asserted references in the manner contemplated by the Petitioner. *See In re Rinehart*, 531 F.2d 1048, 1053–1054 (C.C.P.A. 1976) (Markey, C.J.) (When it is proposed to combine two references to get a result that "neither is capable" of alone, there is no prima facie obviousness.).

c) The Combination of *Griffin* and *Zydney* is Inoperable for Text-only Buddies.

Griffin supports text-only buddies that lack speech messaging capability. EX2001, ¶¶ 53, 59. For example, in FIG. 7 of *Griffin*, buddy "JaneT" has a status 702 of "TextOnly," indicating that JaneT cannot successfully receive/play a speech message. This status is important, because it prevents a speech message from being erroneously sent to JaneT: "message broadcaster 303, upon receiving the outbound

chat message 400, first compiles a list of target recipients . . . . For each target, the message broadcaster 303, determines the status 702 of the target . . . . For each available target (i.e., where the presence record indicates that the recipient can receive the message type 401), the broadcast manager 303, composes an inbound chat message 500." EX1005, 6:56–7:1 (emphases added); EX2001, ¶ 53.

Petitioner's suggestion to replace *Griffin*'s status 702 with availability/ unavailability as understood by *Zydney* would result in an inoperable system, at least for text-only buddies. EX2001, ¶ 53. A Text-only buddy connected to the server complex 204 would be considered "available" as understood by *Zydney* simply by virtue of having an Internet connection (e.g., that enables communication with the server complex 204[2]) and would therefore be available for selection as a recipient of a speech message. *Id.* However, *Griffin* does not disclose or even contemplate, what would happen if a text-only buddy were to be selected to receive a speech message. *Id.* Petitioner has failed to address a glaring flaw in the posited combination of *Griffin* and *Zydney*.[3] *Id.*

Even a single text-only buddy is enough to destroy any proposed rationale for combining *Griffin* and *Zydney*. No PHOSITA would intentionally design a

[2] *See* fn. 14, *supra*.

[3] *See* fn.15, *supra*.

system/process that is inoperable (e.g., has erroneous behavior), no matter how unlikely the inoperable use case is. *See In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (finding no prima facie obviousness because resulting modification "would be rendered inoperable for its intended purpose" and therefore the reference "teaches away"); *In re Sponnoble*, 405 F.2d 578, 587 (C.C.P.A. 1969) (holding claims are not obvious where a proposed combination produces a seemingly inoperative device).

Moreover, "[a]n obviousness determination requires finding both 'that a skilled artisan would have been motivated to combine the teachings of the prior art . . . and that the skilled artisan would have had a reasonable expectation of success in doing so.'" *In re Stepan Co.*, Case No. 2016-1811 (Fed. Cir. Aug. 25, 2017), slip op. at 5 (*citing Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367–68 (Fed. Cir. 2016)) (emphasis added). Here, not only is there no reasonable expectation of success, but there is an express indication that the combination will fail, at least for text-only buddies.

Thus, the Petition should be denied in its entirety at least because Petitioner's proposed combination of *Griffin* and *Zydney* is inoperable.

B. *Griffin* Does Not Teach Instant Voice Messaging Over a Packet Switched Network as Required by All Challenged Claims.

The '433 Patent describes and claims delivering an instant voice message over a packet-switched system. EX1002 ¶ 20; Pet. at 10 ("As explained in detail by Dr.

Haas [EX1002], the ’433 Patent is directed to instant voice messaging over a packet-switched network that interconnects clients via a server.”). Petitioner argues that *Griffin* effectively discloses both “instant voice messaging” and sending the instant voice messages over a packet-switched network. But Petitioner tacitly acknowledges that *Griffin* does not expressly disclose either. Indeed, *Griffin’s* initial description of the “invention” in the “Detailed Description of the Preferred Embodiment” is consistent with sending recorded audio files through a circuit-switched system:

> The present invention . . . may comprise any wireless communication device such as a handheld cellular phone or a wirelessly enabled Personal Digital Assistant (PDA). . . . As shown, the mobile terminal 100 comprises a speaker 103 for rendering signals, such as received speech, audible; a display 102 to render text and graphical elements visible; a navigation rocker 105 that allows a user to navigate a list or menu displayed on the screen; programmable buttons . . . ; a microphone 107 that captures audio such as the user’s speech; and a push-to-talk button 101 that allows the user to initiate recording and transmission of audio.

EX1005, 3:1–30 (underlining added to show circuit-switched context). Petitioner tries unsuccessfully to walk away from *Griffin’s* description of sending recorded audio files through a circuit-switched system.

First, Petitioner simply states that “software (and related components)” in *Griffin* is the “instant voice messaging application” claimed in all the claims of the

’433 Patent. Pet. at 15. Likewise, Petitioner simply states that the phrase “packet-based network 203” in *Griffin* is the “packet-switched network” claimed in the ’433 Patent. Pet. at 15–16. These empty conclusions do not stand up to scrutiny.

In *Griffin’s* 16 columns and 14 figures, there is no occurrence of the term “packet-switched,” and only three occurrences of “packet”:

> The data packets are sent on to a communication network 203 . . . which is a packet-based network, may comprise a public network such as the Internet or World Wide Web . . . .

EX1005, 3:59–65 (underlining added).

> Furthermore, the present invention would benefit systems other than packet data based systems, as well as systems that are limited in scope to a single wireless carrier’s domain.

EX1005, 4:23–26 (underlining added). *See also* Dr. Haas’ description of *Griffin* at ¶¶ 61–70 (no use of the term “packet-switched” and no discussion of *Griffin* as packet-switched); *but cf*. Dr. Haas’ description of *Zydney* at ¶¶ 71–76 (referring to *Zydney* as packet-switched in ¶ 72) and of *Lee* (referring to *Lee* as packet-switched in ¶ 84).[4] This is an admission by omission: *Griffin* fails to teach a packet–switched network. Indeed, Dr. Haas and *Griffin* both refer to *Griffin* as showing in Figure 2 a “system” that “may include packet-based communication

[4] *Zydney* is unpatented application: International App. No. WO 01/11824A2.

network 203 . . . .” EX1002 ¶ 89; EX1005, 3:59–65. Thus, Petitioner tacitly concedes that *Griffin* does not describe or enable a packet-switched network.

Moreover, Petitioner’s only argument that *Griffin’s* use of “packet-based network 204” somehow describes the claimed packet-switched network across which instant voice messages are sent as claimed by the ’433 Patent is the following single sentence in *Griffin* referring to Fig. 2:

> The communication network 203, which is a packet-based network, may comprise a public network such as the Internet or World Wide Web, a private network such as a corporate intranet, or some combination of public and private network elements.

EX1005, 3:59–62. This passage, and Fig. 2, do not support Petitioner’s conclusion.

First, communications network 203 is not part of *Griffin’s* invention, which is limited to Server Complex 201 and Mobile Terminals 100 in some embodiments, or to the Mobile Terminals alone in all other embodiments. EX1005, 4:6–26. Indeed, *Griffin* states that it makes no difference whether or not communication network 203 is packet based. EX1005, 4:24–25 (“Furthermore, the present invention would benefit systems other than packet data based systems . . .”).

Second, the communication referred to by the relied upon single sentence is by and between the Mobile Terminals, which are separated from communication network 203 by wireless carriers (such as Verizon or Sprint). Therefore, there is no

evidence to support leaping to Petitioner's conclusion that *Griffin* just somehow must use, and therefore must describe, communication through a packet-switched network.

C. Petitioner Fails to Make a Prima Facie Showing that *Zydney* or *Griffin* Describes Attaching One or More Files to an Audio File.

1. Neither *Griffin* nor *Zydney* Attach a File to an Audio File.

Petitioner has not shown that Claim 9, or any of its dependents, Claims 11, 14–17, 25, or 26 would have been obvious over the combination of *Griffin* and *Zydney*. Indeed, Petitioner admits that "*Griffin* does not explicitly describe attaching files to a speech message." Pet. at 48; EX1002, ¶ 191 ("*Griffin* does not explicitly describe attaching one or more files to a speech chat message.").

Petitioner resorts to arguing that "A [PHOSITA] would have . . . been motivated to modify *Griffin*'s system/process to implement such features in view of the teachings of *Zydney* . . . ." EX1002, ¶ 191; *see* Pet. at 48. But Petitioner admits that *Zydney* also does not disclose attaching one or more files to an "audio file" either. "*Zydney* discloses including attachments in the voice container." Pet. at 49. EX1002, ¶ 192 ("*Zydney* describes attaching . . . to the voice container.").

Petitioner tries incorrectly to equate the "voice container" of *Zydney* (and the data structure shown in Figs. 4 and 5 of *Griffin*) with the claimed "instant voice message" of the '433 Patent. The "voice container" of *Zydney* encapsulates and

transports the voice message. Specifically, *Zydney* describes its system as including a "central server to send, receive and store messages using voice containers." *Zydney*, EX1006, 2:2–3. *Zydney* also provides that "the message is first acquired, compressed and then stored in a voice container 26 which is then sent to its destination(s)." *Zydney*, 11:2–3. *Zydney* explains that various voice data "formats" and "voice compression formats" can be accommodated because *Zydney* packages the voice data message into, and transmits it via, a "voice container." *Id*. at 10–11. Specifically,

> The server is adapted to recognize[] the voice format of voice data contained in the voice containers, this information may be communicated by the agent prior to a voice container transmission, included in the voice container or provided to the server from the agent when polled by the server.

Zydney, EX1006, 12:13–17. *Zydney* can accommodate these various voice formats and compression formats because *Zydney* packages the voice message into an enrobing voice container:

> The voice data is transmitted in a voice container. The term "voice containers" as used throughout this application refers to a container object that contains no methods but contains voice data or voice data and voice data properties.

Zydney, EX1006, 11:6–8.

Zydney does not attach "one or more files" to the data message itself; *Zydney* instead attaches files to only the encapsulating package, i.e., the voice container:

> Another important application of the present invention ... is attaching other media to the voice containers to provide a richer communications environment. For example, voice containers may have digitized greeting cards appended to them to present a personalized greeting.
>
> The voice container has the ability to have other data types attached to it and thus be transported to the recipient.

Zydney, EX1006, 19:2–7. Fig. 3 shows the contents of a voice container.

Petitioner's declarant, Dr. Haas, wrote that "*Zydney* . . . describes attaching files to voice containers." EX1002, ¶192. *Zydney*'s voice message is digitally recorded into a file that is compressed and stored in temporary memory, and only thereafter is the voice message placed within a distinct voice container. Dr. Haas admits that *Griffin* does not disclose attaching a file to an audio file, and that neither does *Zydney*:

> *Griffin* already describes attaching files to a chat message, and *Zydney* similarly discloses attaching files to a voice message. Therefore, such a modification would have been a commonsense and natural extension of *Griffin's* teachings.

EX1002, ¶ 194 (underlining added).

Mr. Easttom testifies that the voice message of *Zydney* is audio data that is first acquired and then stored in a voice container, which is a type of data structure

distinct from a voice message file. *E.g.*, EX2001, ¶¶ 41, 49–50 (*citing*, *inter alia*, EX1006, 11:1–3 ("the [voice] message is first acquired, compressed and then stored in a voice container 26 which is then sent to its destination(s).")). The *Zydney* application shows that the digitally-recorded voice message file and the voice container are distinct elements. *Id.*

Contrary to what Petitioner argues, the temporary voice message file in *Zydney* is not somehow metaphysically transformed in a manner that makes it lose its distinct identity simply by being placed within a voice container that is transmitted. Dr. Haas acknowledges at ¶ 74 that the "voice message is placed into a 'voice container' and transmitted to its destination."). Moreover, no PHOSITA would have been motivated to remove the explicit distinction between content and container. *Zydney* discloses that multiple discrete files (each serving a unique purpose) are placed within that voice container and later, upon receipt, individually unpacked. EX1006, 19:1–7; EX2001, ¶¶ 41–49. Thus, the "voice container" of *Zydney* is not, and cannot be, the claimed "instant voice message."

As shown above in section III.A., *Griffin* and *Zydney* cannot be combined as Petitioner suggests because a PHOSITA would not have expected success from such an attempt to combine. Moreover, if such a combination were attempted, it would defeat the underlying purpose behind *Zydney*. EX2001, ¶ 54. Petitioner tries to read the "voice container' out of Griffin by treating *Griffin* as if it involves an isolated

"audio file." That dog won't hunt. Neither Petitioner nor its expert explain why or how Zydney would deal with all the contents of the voice container. *See Zydney* Fig. 3 showing the contents of the voice container.

> Referring to Fig. 3 there is illustrated an exemplary embodiment of the voice container having voice data and voice data properties components. Voice container components include an originator's code 302 (which is a unique identifier), one or more recipient's code 304, originating time 306, delivery time(s) 308, number of "plays" 310, voice container source 312 which may be a PC, telephone agent, non-PC based appliance, or other, voice container reuse restrictions 314 which may include one time and destroy 316, no forward 318, password retrieval 320, delivery priority 322, session values 324, session number 326, sequence number for partitioned sequences, 328, repeating information 330, no automatic repeat 332, repeat times 334, and a repeat schedule 336. Additionally, the voice container will have information concerning codec type, size, sample rate, and data. The voice container will be sent using standard TCP/IP transport.

EX1006 at 23 (underlining added).

Petitioner attempted to explain away this fatal flaw by referencing *Zydney*'s description of the Multipurpose Internet Mail Extension (MIME) standard. *Zydney* states:

> In one implementation example . . . the voice container can [be] formatted using industry standards such as Multipurpose Internet Mail Extension (MIME) format. This extension allows non-textual messages

> and multipart message bodies attachments to be specified in the message headers. MIME was developed and adopted by the Internet Engineering Task Force (1ETF). The MIME protocol which is an extension of SMTP, covers binary, audio and video data.

EX1006, 19:7–12. *See* Pet. at 49; EX1002, ¶ 156. Petitioner's attempt falls flat.

This passage of *Zydney* refers to attaching files to a voice container, and not to an instant voice message audio file. It is undisputed that *Zydney* does not teach or suggest attaching one or more files to the voice-message. Presumably that is why the Petition points exclusively to the *container* in an attempt to fit a square peg into a round hole. The remaining references to MIME in *Zydney* are directed to the voice container itself being a MIME attachment to an email, and not the voice container, let alone the instant voice message, having a MIME attachment. *See* EX1006, 15:15–17, 17:2–4. Dr. Haas tacitly admits this fact:

> *Zydney* also explains that the Voice container can be formatted using the Multipurpose Internet Mail Extension (MIME) standard, which "allows for non-textual messages and multipart message bodies attachments to be specified in the message headers."

EX1002, ¶ 158 (underlining added) (*citing* EX1006 at 19:7–10, 19:13–20:9.) Thus, *Zydney* provides no details as to how an instant voice message can have a MIME attachment.

The "instant voice message" claimed in all the challenged claims is recorded in the audio file and is not an encapsulating transport package:

> In response to the start signal, the IVM client (softphone) 208 listens to the input audio device 212 and records the user's speech into a digitized audio file 210 (i.e., instant voice message) stored on the IVM client 208.

EX1001, 8:11–15. The "recorded audio file (instant voice message)," *id*. at 10:50, is processed and "compressed by apply a compression algorithm. . . ." EX1001, 10:64–65.

Indeed, the "instant voice message" is transmitted over a packet-switched network by the "messaging system." Claim 9 recites:

> a messaging system for transmitting the instant voice message over a packet-switched network, and
>
> wherein the instant voice message application attaches one or more files to the instant voice message.

EX1001, 24:64–67. Thus, the claimed "instant voice message" is not analogous to the "voice container" of *Zydney* at all. *Zydney* does not disclose or suggest attaching one or more files to the instant voice message itself as required by Claims 9, 11, 12, 14–17, 25, and 26:

> More specifically, when an instant voice message is to be transmitted to the one or more IVM recipients, one or more documents may be

attached to the instant voice message to be, stored or displayed by the one or more selected IVM recipients.

'433 Patent, EX1001, 12:32–36.

Claim 9 uses the term "instant voice message." That use is significant because the language of the claim itself is the best guide to the meaning of its terms. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) ("the context in which a term is used in the asserted claim can be highly instructive."); *Alloc, Inc. v. Intern. Trade Comm'n*, 342 F.3d 1361, 1368 (Fed. Cir. 2003) ("'Claim language generally carries the ordinary meaning of the words in their normal usage in the field of invention' at the time of invention.") (citation omitted).

For at least these reasons, Petitioner has failed to meet its obligation to present prima facie evidence that *Zydney* or *Griffin* renders Claim 9 obvious, and therefore cannot meet its obligation for any challenged dependent claims 11, 12, 14–17, 25, or 26. The Board should therefore deny the Petition with regard to all of the challenged claims.

2. *Zydney* Teaches Away from "Wherein the Instant Voice Message Application Attaches One or More Files to the Instant Voice Message."

Even if the voice container could be equated with the instant voice message, which as explained above it cannot, every embodiment of *Zydney* teaches away from a client enabled to "attach one or more files to the instant voice message." *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (a reference teaches away from the

claimed invention when a person of ordinary skill, upon reading the reference, "would be led in a direction divergent from the path that was taken by the applicant."). This is because *Zydney* teaches that its voice container is specifically constructed to have files attached thereto. EX1006, 35:14–17, Figs. 16–18. Indeed, that is the fundamental purpose of the voice container. EX2001, ¶¶ 41–49. That disclosure in *Zydney* would lead a PHOSITA away from attaching one or more files to the voice message *itself*, instead of to the voice container. Therefore, not only does *Zydney* fail to disclose or suggest "wherein the instant voice message application attaches one or more files to the instant voice message" as in Claims 9, 11, 12, 14–17, 25, and 26, *Zydney* in fact teaches away from this limitation.

For at least this independent reason, Petitioner has failed to meet its obligation to present prima facie evidence that *Zydney* renders any of challenged claims obvious, and therefore cannot meet its obligation for any challenged claim. The Board should therefore deny the Petition with regard to all of the challenged claims.

3. Petitioner Shows No Motivation to Combine *Griffin* and *Zydney*, Nor How such a Combination Could Work.

Petitioner admits that "*Griffin* does not explicitly describe attaching one or more files to a speech chat message," EX 1002, ¶ 191, and therefore relies on "*Zydney*, which describes a software agent that operates to address, pack, and send a message in a Voice container." EX1002, ¶ 192. But as thoroughly explicated above, and as admitted by Petitioner and its expert, *Zydney* does not describe

attaching files to an audio file either. In a nutshell, Petitioner argues that because *Griffin* suggests attaching files to a textual chat message (EX1002, ¶ 191), and because *Zydney* suggests attaching files to a container that includes an audio message (EX1002, ¶ 192), and because "the ability to attach files to an instant voice message provides a 'richer communications environment'" (EX1002, ¶ 193), well then, a working combination just might have happened. Petitioner simply concludes, by ignoring the important differences between the audio file of the '433 Patent and the "voice container" of *Zydney*:

> In fact, as I discussed above, *Griffin* already describes attaching files to a chat message, and *Zydney* similarly discloses attaching files to a voice message. Therefore, such a modification would have been a commonsense and natural extension of *Griffin's* teachings.

EX1002, ¶ 194. Petitioner completely fails to justify this speculation and therefore has not made prima facie showing of obviousness. "An obvious determination requires finding both 'that a skilled artisan would have been motivated to combine the teachings . . . and that the skilled artisan would have had a reasonable expectation of success in doing so.'" *In Re: Stepan Co.*, Case No. 2016-1811 at *5 (Fed. Cir. Aug. 25, 2017) (*quoting Intelligent BioSys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016)); *see KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

Petitioner has utterly failed to show that the claimed invention would have been obvious.

D. No Prima Facie Showing of an "Instant Voice Message Is Represented by a Database Record Including a Unique Identifier."

1. *Clark* and *Griffin* Lack a Database Record in a Message Database, where That Database Record Includes Both a Unique Identifier and an Instant Voice Message.

Independent Claim 1 is unambiguous. Petitioner does not suggest otherwise. The claimed database record is a part of the claimed message database, and the claimed database record includes both an instant voice message and a unique identifier. The '433 Patent specifies:

> The file manager accesses a message database 310, in which both the received and recorded instant voice messages are represented as database records, each record comprising a message identifier and the instant voice message.

EX1001, 12:34–40 (underlining added for clarity). Petitioner admits that *Zydney* lacks this element. Pet. at 48–50. *Clark* plus *Griffin* also lack this element. Therefore, none of Claims 1–5, 7, or 8 could be rendered obvious by any combination of *Clark* plus *Griffin*.

Petitioner admits that neither *Griffin* or *Clark* discloses these elements as claimed:

> While *Griffin* does not explicitly disclose that each speech message stored in terminal 100's message database is represented by a database

> record including a unique identifier, it would have been obvious to a [PHOSITA] to modify *Griffin's* system/process to implement such features in view of *Clark*.

Pet. at 21; EX1002, ¶ 118. *Clark* does not disclose this element either.

Petitioner primarily cites to Fig. 5A of *Clark* and its associated description as allegedly disclosing the claimed database record. Pet. at 22. In particular, the Petition asserts that the "message store" of *Clark* discloses the claimed message database and that "StoreMessageId," which is included in a "MessageSummary table 52," discloses the claimed unique identifier. *Id*.

Petitioner's mapping is wrong. First, in Fig. 5A, *Clark* shows the "MessageSummary table 52" as being outside the "message store 23." EX1007, Fig 5A.

Second, the "MessageSummary table 52" does not include any message data at all. *Clark* describes the contents of MessageSummary table 52 as:

> The actual contents of the MessageSummary will vary depending upon the . . . implementation, but in a currently preferred embodiment . . . MessageSummary table 52 includes the following fields:

MessageId	A non-zero value that uniquely identifies a row in MessageSummary table 52.
FolderExcludeList	(Array of [FolderId + FolderDateTime]) - Identifies the Folders from which shortcuts, that would normally be created by automatic rules, should be removed.
IsUnread	Indicates whether the message is in an unread state.
IsCorresp	Indicates whether the message is correspondence from or to a recognized correspondent. The logic to set this value is described below.
MessageDateTime	The date and time to be displayed to the user when listing messages in a folder. For unsent messages this contains the creation date/time, for received messages this contains the receive date/time, and for sent message this contains the send date/time.
DisplayNames	The sender or recipient names to be displayed to the user when listing messages in a folder. For received messages this contains the sender's name, and for sent or unsent messages this contains is the names of the primary recipients.
Subject	The subject of the message.

EX1007, 16:64–17:23.

In *Clark*, the message data is included in a "Message table 54" that is separate from the MessageSummary table 52, as clearly shown in Fig. 5A. Petitioner has not shown that a single database record in *Clark* includes both a unique identifier and an instant voice message. Indeed, in Fig. 5A of *Clark*, the MessageSummary table and the Message table are in separate data stores (the catalog database 28 and the message store 23, respectively). No database record can span multiple tables, let alone multiple tables from different data stores.

Nonetheless, Petitioner speculates that the catalog database 28 and the message store 23 of *Clark* could be combined, as in Fig. 5B. Pet. at 23. However, none of the tables shown in Fig. 5B of *Clark* includes a "StoreMessageID," which is the only item of *Clark* that the Petition has asserted as disclosing the claimed unique identifier. Pet. at 23.

Clark simply does not disclose or suggest a database record in a message database, where that database record includes both a unique identifier and an instant voice message. For least this independent reason, Petitioner has failed to meet its obligation to present prima facie evidence that any of Claims 1–5 and 7–8 could have been obvious at the time of the claimed inventions.

2. Petitioner Shows No Motivation to Combine *Griffin* with *Clark* to Devise a Database Record That Included a Unique Identifier.

Two separate reasons preclude finding sufficient motivation to combine *Griffin* with *Clark* in the manner Petitioner proposes. *Cf*. Pet. at 49–50. First, both *Griffin* and *Clark* lack this element, as Petitioner admits for *Griffin* and as Patent Owner showed above for *Clark*. In other words, neither *Griffin* nor *Clark* has a requisite component of the proposed combination.

Second, *Clark* teaches away from the proposed combination, and therefore there could have been no motivation to combine. *Clark* explains that "MessageSummary table 52" is separate and distinct from the message data itself.

EX1007, Fig. 5A. Indeed, *Clark* describes the desirability of making it easier to link the MessageSummary table 52 to data messages that are in an external storage. *Id*. at 16:54–58; EX2001, ¶ 62. *Clark* also explains that keeping MessageSummary table 52 separate and distinct from the message data is desirable because doing so enhances processing performance. Processing performance is enhanced because a row of the MessageSummary table 52 is small, due to the row not containing the actual message data. EX1007, 16:58–63. *Clark* explains why the message data should be separate from the MessageSummary table 52:

> A first reason for implementing a MessageSummary table that is distinct from Message table 54 is that having a separate Message Summary table 52 facilitates linking to messages in an external message store 23. A second reason is to enhance processing performance—a MessageSummary record (i.e. a row in MessageSummary table 52) is typically much smaller than its related message record (i.e. a row in Message table 54) and it is consequently much faster to read MessageSummary records than it is to read Message records.

Ex1007, 16:54–63 (underlining added for clarity).

Because *Clark* teaches away from including the message data in the same database record as the unique identifier, there could not have been any motivation to combine *Clark* with *Griffin*. Such a combination would have frustrated the tended purpose of *Clark*, which is to facilitate linking messages by keeping the message

record summary small. It is improper to combine references if the references teach away from the combination. *See In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). A reference teaches away from the claimed invention when a person of ordinary skill, upon reading the reference, "would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). A reference also teaches away whenever it "criticize[s], discredit[s], or otherwise discourage[s] investigation into the claimed invention." *Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) (quotation omitted). *Clark*'s explanation of why the message data should be separate from the MessageSummary table 52 disparages not separating the message data from the Message Summary table.

For these reasons alone, Petitioner fails to meet its obligation to present prima facie evidence that any of Claims 1–5 and 7–8 would have been obvious at the time of the invention. For this independent reason, the Board should deny the Petition with regard to Claims 1–5 and 7–8.

E. Neither *Griffin* nor *Clark* Disclose a File Manager System Storing, Retrieving, and Deleting the Instant Voice Message.

This claim element ("a file manager system storing, retrieving, and deleting the instant voice message"), which is recited in challenged independent Claims 1 and 6, refers to the instant voice messaging application, which is also recited as "including a client platform system for generating an instant voice message and a

messaging system for transmitting the instant voice message over a packet-switched network" and "display[ing] a list of one or more potential recipients for the instant voice message." EX1001, 23:67–24:2, 24:4–6 (Claim 1), 24:34–37, 39–41 (Claim 6). The claim language makes it clear that the instant voice messaging application is on the sending device, and therefore it is the sending device's instant voice messaging application that includes the claimed message database.

Petitioner admits that neither *Griffin* nor *Clark* discloses the claimed "file manager system." EX1002, ¶ 129 ("In my opinion, the combination of *Griffin* and *Clark* discloses a component and/or functionality that performs the same function as the claimed 'file manager system.'") (underlining added); Pet. at 26–27 (ditto). Petitioner also admits that neither *Griffin* nor *Clark* can "perform the same function" if that function is the expressly claimed "deleting":

> [I]t would have been obvious to a POSA at the time of the alleged invention to modify the system/process of the [proposed] *Griffin-Clark* combination to also delete messages from the message database in view of the teachings of *Clark*. (Ex. 1002, ¶¶ 132–138.)

Pet. at 27–28 (underlining added).

> *Griffin* does not explicitly disclose a file manager system "deleting" a speech chat message from the message database. However, based on the teachings of *Clark* and the knowledge of a [PHOSITA], it is my opinion that such a person would have been motivated to modify

> *Griffin's* system/process to also delete speech chat messages from the message database.

EX1002, ¶ 129 (underlining added). Thus, Petitioner not only admits that neither *Griffin* nor *Clark* have this element, but indeed, Petitioner admits that Petitioner's proposed combination of *Griffin* and *Clark* together also does not have this element. Petitioner admits that the proposed combination itself would have to be yet further modified. *Id*. Thus, Petitioner utterly fails to make a prima facie showing on this element (deleting).

Petitioner appears to argue that the "stored messages" of *Griffin* are the claimed "file manager system" of Claims 1 and 6 (and therefore of Claims 2–5 and 7–8). Pet. at 27 (messages stored in "terminal 100's permanent storage"). But it is clear from *Griffin* that the sender does not store a copy of messages sent. In order to have a copy of a sent message, the sender must copy the message to herself, in other words, the sender has to also be the recipient, or the message is gone and cannot be stored or retrieved. EX2001, ¶ 61. The analysis above shows that *Griffin* cannot delete—Petitioner does not even argue that Griffin can delete:

> In addition to sending the message to the targeted recipient(s), the message broadcaster sends a copy of the outbound message to the transmitting terminal (i.e., the sender) as an inbound message.

EX1005, 10:30–33.

> Of course, if speech-to-text conversion is available, the actual speech content of the message could be converted to text and copied back to the transmitting terminal.[] In this manner, the occurrence of voice message results in an entry being displayed on the screen. In an alternative embodiment, rather than having the text of an outbound message sent back to the transmitting terminal via an inbound message, the transmitting terminal can locally echo the text to the display directly.

EX1005, 10:43–51. Therefore, Petitioner must rely on *Clark*. That reliance is misplaced.

Turning to *Clark*, Petitioner cites various passages as allegedly supporting the position that *Clark* adds, deletes, and retrieves messages from *Clark's* "message store 23" in response to user requests to do so. Pet. at 28. The cited passages, however, describe requests being passed from one component of *Clark's* system 20 (e.g., the message client 27) to another component of *Clark's* system 20 (e.g., the message store server 23), where neither of the components is what Petitioner alleges is the claimed message database (i.e., Petitioner refers to the message store 23). Petitioner also has not shown that the requests being communicated are "user requests" as required by the claims. EX2001, ¶ 63.

VI. CONCLUSION

For at least the reasons set forth above, Uniloc respectfully requests that all challenges in Petition IPR2017-1801 be denied.[5]

Date: May 7, 2018

Respectfully submitted,

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[5] Patent Owner does not concede, and specifically denies, that there is any legitimacy to any arguments in Petition IPR2017-1801 that are not specifically addressed herein.

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), we certify that this Response to Petition complies with the type-volume limitation of 37 C.F.R. § 42.24(b)(1) because it contains fewer than the limit of 14,000 words, as determined by the word-processing program used to prepare the brief, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a)(1).

Date: May 7, 2018

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), we certify that we served an electronic copy of the foregoing PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. § 42.107(a) along with any accompanying exhibits via the Patent Review Processing System (PRPS) to Petitioner's counsel of record at the following address:

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