

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

Case: IPR2017-01801
U.S. Patent No. 8,995,433

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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LIST OF EXHIBITS¹

No.	Description	Previously Submitted
1001	U.S. Patent No. 8,995,433	X
1002	Declaration of Dr. Zygmunt J. Haas	X
1003	Curriculum Vitae of Dr. Zygmunt J. Haas	X
1004	File History of U.S. Patent Application No. 14/224,125, which issued as U.S. Patent No. 8,995,433	X
1005	U.S. Patent No. 8,150,922 (“ <i>Griffin</i> ”)	X
1006	International Published Application No. WO01/11824A2 (“ <i>Zydney</i> ”)	X
1007	U.S. Patent No. 6,725,228 (“ <i>Clark</i> ”)	X
1008	WO 02/17650A1 (“ <i>Vaananen</i> ”)	X
1009 - 1013	RESERVED	
1014	U.S. Patent Application Publication No. 2002/0101848A1 (“ <i>Lee</i> ”)	X
1015	U.S. Patent Application Publication No. 2002/0146097A1 (“ <i>Vuori</i> ”)	X
1016	E. Levinson, <i>Request for Comments (RFC) 2387: The MIME Multipart/Related Content-type</i> (Aug. 1998)	X
1017	File History of U.S. Patent Application No. 13/546,673, which issued as U.S. Patent No. 8,724,622	X
1018	U.S. Patent No. 8,724,622	X

¹ Citations to non-patent publications are to the original page numbers of the publication, and citations to U.S. patents are to column:line number of the patents.

No.	Description	Previously Submitted
1019	File History of U.S. Patent Application No. 12/398,063, which issued as U.S. Patent No. 8,243,723	X
1020	U.S. Patent No. 8,243,723	X
1021	File History of U.S. Patent Application No. 10/740,030, which issued as U.S. Patent No. 7,535,890	X
1022	U.S. Patent No. 7,535,890	X
1023	Uniloc Patent Local Rule 4-2 Proposed Construction of Terms, Case No. 2:16-cv-00642-JRG (Lead) (E.D. Tex.)	X
1024	Harry Newton, <i>Newton’s Telecom Dictionary</i> (16th. ed. 2000)	X
1025	John Rittinghouse, <i>IM Instant Messaging Security</i> (1st ed. 2005)	X
1026	Dreamtech Software Team, <i>Instant Messaging Systems: Cracking the Code</i> (2002)	X
1027	Upkar Varshney et al., <i>Voice over IP</i> , Communication of the ACM (2002, Vol. 45, No. 1)	X
1028	Iain Shigeoka, <i>Instant Messaging in Java: Jabber Protocols</i> (2002)	X
1029	Trushar Barot & Eytan Oren, <i>Guide to Chat Apps</i> , TOW Center for Digital Journalism, Columbia University (2005)	X
1030	Samir Chatterjee et al., <i>Instant Messaging and Presence Technologies for College Campuses</i> , IEEE Network (Nov. 9, 2005)	X
1031	Daniel Minoli & Emma Minoli, <i>Delivering Voice Over IP Networks</i> (2nd ed. 2002)	X
1032	Thomas Porter & Michael Gough, <i>How to Cheat at VoIP Security</i> (1st ed. 2007)	X
1033	Harry Newton, <i>Newton’s Telecom Dictionary</i> (18th. ed. 2002)	X

No.	Description	Previously Submitted
1034	Justin Berg, <i>The IEEE 802.11 Standardization Its History, Specification, Implementations and Future</i> , George Mason University, Technical Report Series (2011)	X
1035	Wolter Lemstra & Vic Hayes, <i>Unlicensed Innovation: The Case of Wi-Fi</i> , Competition and Regulation in Network Industries (2008, Vol. 9, No. 2)	X
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I. INTRODUCTION

Samsung Electronics America, Inc. (“Petitioner”) submits this reply to Patent Owner’s (“PO’s”) Response (Paper 12, “Resp.”) concerning claims 1-5, 7-12, 14-17, 25, and 26 of the ’433 patent (Ex. 1001). PO’s arguments should be rejected and the challenged claims found unpatentable for at least the reasons set forth in the Petition (Paper 1, “Pet.”) and accompanying exhibits, the Board’s decision to institute IPR (Paper 8, “Dec.”), Mr. Easttom’s cross-examination testimony, and the additional reasons discussed below. Indeed, PO’s Response copies, with only minor non-substantive edits, its already-rejected arguments from its preliminary response, and PO did not submit new testimonial evidence. Thus, there is no reason for the Board to alter its initial determinations from its institution decision.

II. CLAIM CONSTRUCTION

Petitioner addresses the BRI of the following terms.

A. “Instant Voice Message” (All Challenged Claims)

As applied in the Petition, the BRI of the term “instant voice message” (IVM) is a message containing digitized speech that is capable of being transmitted in real time to a recipient device. In response, PO offers an implied construction of IVM in an attempt to avoid the prior art. In particular, PO argues (1) that the IVM is the “audio file” or is within the “audio file” and (2) that “instant” requires real time receipt. As discussed below, PO’s positions should be rejected as they are

unsupportable and introduce ambiguity.

1. The IVM Is a Message Containing Digitized Speech

In addressing the prior art, PO implicitly argues that the claimed IVM is an audio file or is within an audio file. For example, PO argues that “Neither *Griffin* nor *Zydney* Attach a File to an Audio File” (Resp., 24), even though the claims do not require attachment to an “audio file.” Rather, claim 9 requires “attach[ing] one or more files to the instant voice message.” (Ex. 1001, 24:66-67.) PO argues, however, that “[t]he ‘instant voice message’ claimed in all the challenged claims is recorded in the audio file and is not an encapsulating transport package.” (Resp., 30.) This implicit construction of IVM conflicts with the disclosure of the ’433 patent itself, as well as claims in related patents that also recite an IVM.

For example, claim 4 of the ’433 patent recites an “audio file creation system creating an audio file *for* the instant voice message.” (Ex. 1001, 24:24-25.) Based on this claim language, PO’s interpretation that the audio file *is* the claimed IVM makes no sense. Instead, the claimed IVM is a message containing audio and other data. This understanding of IVM is further evidenced by claims in related patents that share the same specification as the ’433 patent. *See In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303 (Fed. Cir. 2011). For example, claim 13 of related patent 8,199,747 (“the ’747 patent”) recites “separating the instant voice message into an audio file and one or more files.”

(Ex. 1043, 25:6-26:3.) This limitation only makes sense if the IVM is a message object that contains at least “an audio file and one or more files,” as recited in claim 13. It would be impossible to separate the IVM into an audio file and one or more files if the IVM is the audio file (or contained within the audio file). Similarly, claim 2 of related U.S. Patent No. 8,243,723 recites “the instant voice message *includes* one or more files attached to an audio file.” (Ex. 1020, 24:17-20 (emphasis added).) Likewise, the claims of related U.S. Patent No. 8,724,622 (“the ’622 patent”) recite “the instant voice message *includes* an object field including a digitized audio file,” an “action field,” an “identifier field,” a “source field,” and a “destination field.” (Ex. 1018, 24:26-30 (emphasis added), 24:36-52.) Thus, it would be improper to construe the claimed IVM to be an audio file (or contained within the audio file). Instead, as the above claim language indicates, the IVM is a message containing audio and other data.

This understanding of the claimed IVM also corresponds with the description of a “message object” in the specification as a message that “comprises an action field, an ID field, a source field, a destination field, and an object field.” (Ex. 1001, 14:8-9; *see also id.*, 14:9-12, 14:21-23, 14:38-39, 14:39-42.) Here, like in the claims, the object field “is a block of data being carried by the message object, which may be, for example, a digitized instant voice message,” while the other fields include other information associated with the IVM. (*Id.*, 14:9-12,

14:21-23, 14:38-39, 14:39-42.) Thus, the specification further establishes that the claimed IVM is not the audio file (or within an audio file), but rather a message object that includes an audio file, among other data.

PO’s position is even contradicted by its expert, Mr. Easttom, who testified during his deposition regarding the ’622 patent that the claimed IVM must include information in addition to the audio file in order for the disclosed system to operate as described in the specification. (Ex. 1040, 107:18-109:24.)² For example, he explained that the IVM must include information identifying the sender (the source field) and information identifying the recipient (the destination field), “or else [the IVM] couldn’t get to the recipient.” (*Id.*, 109:5-22.)

Mr. Easttom’s testimony also confirms that the term IVM is used to refer to not only the message object but also the “digital representation of the audio” contained within the message object. (*Id.*, 111:21-112:5.) Accordingly, in context,

² While Mr. Easttom’s testimony in Exhibit 1040 pertains to the ’622 patent, the ’433 and ’622 patents are part of the same chain of continuation patents and share the same specification. (*Compare* Ex. 1001 *with* Ex. 1018; *see also* Ex. 1042, 18:19-19:7.) Accordingly, Mr. Easttom’s testimony related to the ’622 patent is relevant to the ’433 patent and should be considered. *See Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1273 (Fed. Cir. 2017).

the claimed IVM is a message object that includes an audio file containing the digitized instant voice message but is not itself the audio file (or within the audio file).

Thus the Board should reject PO’s nonsensical construction that the claimed IVM is the audio file (or is within the audio file), and instead find that the BRI of IVM is a message containing digitized speech (that is capable of being transmitted in real time to a recipient device).

2. “Instant” Means Capable of Being Transmitted in Real Time to a Recipient Device

As to the “instant” aspect of the claimed IVM, PO argues that “[n]o POSITA would have understood *Griffin* to disclose an ‘instant voice message’” because *Griffin* purportedly does not disclose “instant” communication. (Resp., 8-12 (citing Ex. 2001, ¶¶33-36).) According to PO, this is because “[r]eal-time communication requires the capability for receipt in real time.” (Resp., 9.) To the extent that this is an accurate interpretation, it is not significant to this dispute because *Griffin* explicitly discloses “real-time speech and text conversations.” (Ex. 1005, 1:7-11; *see infra* Section III.A.)³ *Griffin* also explains that its messages are automatically

³ In other proceedings, PO has pressed an even more narrow interpretation of IVM that requires instant playback to the user (i.e., “heard on the receiving end in real

heard in real time if the chat history display is visible when the messages are received. (Ex. 1005, 11:48-67.)

In any event, the specification and claims of the ’433 patent explain that a message can be an IVM even if it is not received by a recipient device in real time. For example, when a recipient device is not available, the specification and claims explain that an IVM may be temporarily stored at a server for later delivery to the recipient device. (*See, e.g.*, Ex. 1001, Abstract, 8:36-43, 9:21-25, 10:11-15, 10:56-60, 16:37-42, 17:34-38, 18:21-26, 19:8-13, 19:67-20:4, 26:26-32.) Additionally, Mr. Easttom testified that “instant messaging” only requires the capability of immediate receipt (not actual receipt) by a device. (*See* 1040, 25:12-22, 30:7-16, 34:4-10, 50:2-10, 97:7-20.) Thus, a message transmitted to a recipient device need not be received in real time in order to be an IVM.

Therefore, the Board should find that the BRI of the claimed “instant voice message” is a message containing audio data that is capable of being transmitted in real time to a recipient device.

time”). Case No. IPR2017-01799, Paper 21 at 32 (P.T.A.B. June 11, 2018). PO has not proposed such an interpretation here.

III. THE CHALLENGED CLAIMS ARE OBVIOUS OVER THE PRIOR ART

PO merely regurgitates its already-rejected arguments from its preliminary response. For the reasons below, the Board should again reject PO’s arguments and find that Petitioner has proven the unpatentability of the challenged claims to a preponderance of the evidence.

A. *Griffin* Discloses an “Instant Voice Message”

PO’s argument (at Resp., 8-14) that *Griffin* does not disclose an “instant voice message” is based on its strained construction of this term, which should be rejected for the reasons discussed above in Section II.A.2. Properly construed, there is no dispute that *Griffin* discloses this limitation. (Pet., 13-14.)

However, *Griffin* discloses this limitation even under PO’s improper construction. For example, *Griffin* expressly discloses “*real-time* speech and text conversations.” (Ex. 1005, 1:10-11 (emphasis added).) PO argues that such a message is not an “instant voice message” because: (1) it “may not be delivered” to an available terminal when queued (Resp., 11-12), (2) only discloses an instant text message (*id.*, 12-13), and (3) is based on “push-to-talk” (*id.*, 13-14). None of these rationales withstand scrutiny.

First, PO’s argument that “the terminal still may not receive the message” when it is queued (Resp., 11-12) is irrelevant and wrong. PO does not dispute that when the chat history display is visible *Griffin*’s messages are transmitted,

received, and heard by a user of a terminal 100 in real time. (Ex. 1005, 11:48-67; *see also* IPR2017-01799, Paper 21, 32-33 (explaining *Griffin*’s messages are “delivered if the user has the ‘chat history display’ visible on the user interface”).) Even when the chat history display is not visible, *Griffin* explicitly teaches that the terminal 100 can queue a message after it is received. (Ex. 1005, 11:48-50; 11:52-53; *see also* Dec., 19; IPR2017-01797, Ex. 2001, ¶69 (P.T.A.B. June 11, 2018) (Mr. Easttom explaining that “[o]nce the inbound chat message 500 is **received at a recipient terminal**, the...message 500 is either shown in a chat history display...or queued...for later playback....”).) Finally, *Griffin* teaches “an alternative embodiment [in which] queuing can occur at the server complex.” (Ex. 1005, 11:53-55.) These messages also qualify as IVMs because the ’433 patent describes IVMs that are temporarily stored for later delivery, which Mr. Easttom confirmed are “still...instant message[s].” (*See* 1040, 97:7-20; Section II.A.2.)

Second, PO’s assertion that “[e]very passage of *Griffin* that Petitioner relies on is directed explicitly toward text messaging” is wrong and contradicted by its own argument (on the very same page) explicitly referring to *Griffin*’s description of “speech message[s].” (Resp., 12 (citing Ex. 1005, 11:48-50).) Petitioner thoroughly explained that *Griffin*’s speech chat messages are instant **voice** messages. (Pet., 13-14 (compiling numerous examples in *Griffin*).)

Finally, PO’s argument that *Griffin* does not teach an “instant voice

message” because it contains the term “push-to-talk” ignores how that term is actually used in *Griffin*, and instead speculates about “walkie-talkie” technology not discussed in the challenged patents or the asserted prior art. (Resp., 13-14; Ex. 2001, ¶¶38-39.) As explained in the Petition, *Griffin*’s terminal 100 includes a “push to talk” button that the user activates to “record and transmit a speech message,” i.e., an IVM. (Pet., 13 (citing Ex. 1005, 9:20-31, 11:42-47, 12:1-3).) This is not a “walkie-talkie.” PO’s additional argument that “push-to-talk” is circuit-switched ignores *Griffin*’s teaching that its messages are delivered through “packet-based” communication network 203. (Ex. 1005, 3:49-65; Dec., 20; *see* Section III.B.) PO’s “walkie-talkie” interpretation of “push-to-talk” is simply inapplicable to *Griffin*.

Thus, *Griffin* discloses an “instant voice message” even under PO’s narrow interpretation requiring instant receipt.

B. *Griffin* Discloses an Instant Voice Messaging Over a Packet Switched Network

PO’s argument that *Griffin* fails to disclose messaging over a packet-switched network is unsustainable. (Resp., 20-24.) *Griffin* teaches that its speech chat messages are transmitted through “packet-based” network 203. (Pet., 17-18; Ex. 1002, ¶109.) *Griffin* also discloses that network 203 can be the “Internet.” (Ex. 1005, 3:61-65.) The ’433 patent provides the “Internet” as an example of a “packet-switched network.” (Ex. 1001, 1:39.) Thus, *Griffin* describes that its speech chat

messages are transmitted over a network that the ’433 patent itself explains is packet-switched.

PO’s argument that “network 203 is not part of *Griffin*’s invention” is legally erroneous because “[a] reference must be considered for everything it teaches...and is not limited to the particular invention it is describing and attempting to protect.” *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir. 1985). Similarly, PO’s argument that “*Griffin* does not describe or enable a packet-switched network” (Resp., 23) is also legally erroneous because “a patent need not teach, and preferably omits, what is well known in the art.” *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986). And, as Dr. Haas testified, packet-switched networks and their method of operation were well-known. (Ex. 2001, ¶¶31-51 (citing Exs. 1024, 1027, 1031, 1033-1035, 1038-1039).)

Therefore, the Board should find that *Griffin* teaches instant voice messaging over a packet-switched network.

C. A POSA Would Have Been Motivated to Combine *Griffin* and *Zydney* for the Reasons Explained in the Petition

As with its other arguments, PO adds literally nothing to its already-rejected arguments that *Griffin* purportedly would not have been combined with *Zydney*. (Compare POPR, 24-58, with Resp., 8-42; see Dec., 20-21.) Thus, the Board should reject PO’s arguments for the same reasons provided in its institution

decision. Additionally, these arguments do not apply to Petitioner’s challenges of claims 1-3, 4, 7, and 8, which do not rely on *Zydney*. (Pet., 6-7.)

1. *Griffin* Is Compatible With *Zydney*

PO argues that *Griffin* and *Zydney* are incompatible because “*Griffin* has nothing to do with whether the terminal can receive a message at the instant it was sent,” which PO identifies as *Zydney*’s purpose. (Resp., 14-17.) However, *Zydney* indicates that its voice containers can be transmitted either “instantaneously or stored for later delivery.” (Ex. 1006, 1; *id.*, 13:12-18, 14:6-13, 15:19-21, 16:7-21, Figs. 4, 8). Moreover, contrary to PO’s offered purpose, Mr. Easttom testified that the purpose of *Zydney* is its voice containers, which can be transmitted immediately or stored for later delivery. (Ex. 1040, 181:17-22, 182:21-24, 185:3-4, 185:21-22, 191:3-17.) Nevertheless even if *Zydney*’s purpose was instantaneous, peer-to-peer communication, *Griffin* states that its messages are transmitted and received in real-time by terminals 100. (See Section III.A.) Moreover, *Griffin* explicitly states that its system can also operate in a peer-to-peer mode. (Ex. 1005, 4:18-21, 8:8-14.) Thus PO’s arguments fails.

Furthermore, PO’s argument regarding “*Griffin*’s indifference toward a recipient’s immediate availability” (Resp., 16) is contrary to *Griffin*’s teaching of a status indicator 911 in a buddy list display that is updated based on status 702 (Ex. 1005, 8:1-7, 15-59, Figs. 6, 9), and Mr. Easttom’s testimony that the “entire

purpose of *Griffin*” is to update indications of availability in buddy lists (Ex. 1040, 167:10-13 (“[T]he focus of *Griffin* was updating these buddy list. That’s what it’s all about is giving you indication of availability and types of availability. It’s the entire purpose of *Griffin*.”)).

Accordingly, *Griffin* and *Zydney* are compatible.

2. Messages Would Not Be Lost in the Combined System

PO argues that there would have been no motivation to combine *Griffin* and *Zydney* because, in *Griffin*, “only the most recently received speech message...is queued at the receiving terminal,” while “*Zydney* is concerned about routing *all* messages.” (Resp., 17-18.) *Griffin*, however, describes delivering all messages when the chat history display is visible. (Ex. 1005, 11:48-67.) If the chat history display is not visible, *Griffin* explains that more than one unheard speech chat message may be stored at terminal 100, as Mr. Easttom acknowledged during his deposition. (Ex. 1040, 171:11-172:2.) For example, *Griffin* explains that terminal 100 will indicate that there is “*at least* one unheard and/or unread inbound chat message 500 that has arrived at the terminal 100.” (Ex. 1005, 8:30-32 (emphasis added).) As the Board recognized (Dec., 19, 21), *Griffin*’s discussion of “queued” messages merely relates to a functionality for automatically playing back the most recently received speech chat message (Ex. 1005, 11:48-67). There is no indication in *Griffin* that removing or replacing a message in a queue results in deletion of the

message from terminal 100.

3. PO’s Arguments Regarding *Griffin*’s Text-Only Buddies Are Misplaced

PO argues that “replac[ing] *Griffin*’s status 702 with availability/unavailability as understood by *Zydney* would result in an inoperable system, at least for text-only buddies,” because “[a] Text-only buddy connected to the server complex 204 *would be considered ‘available’*...simply by virtue of having an Internet connection...and would therefore be available for selection as a recipient of a speech message.” (Resp., 19-20.) This argument rewrites Petitioner’s proposed combination. Petitioner does not argue that the combination would “replace” status 702, as PO contends, but rather that status 702 would “include connectivity information,” such that “status 702...indicate[s] whether terminal 100 is currently connected to server 204.” (Pet., 40-43; Ex. 1002, ¶¶167-76.) Additionally, as the Board recognized, Petitioner’s combination does not rely on *Griffin*’s text-only buddy features. (Dec., 21 n.2.)

Nevertheless, the inclusion of text-only buddies in the combination would not result in an inoperable system. As an initial matter, PO’s arguments are based on what the references teach separately. But it is axiomatic that the test for obviousness does not require the bodily incorporation of one reference into another. *See Allied Erecting & Dismantling Co. v. Genesis Attachments, LLC*, 825 F.3d 1373, 1380-81 (Fed. Cir. 2016). Rather, the test is what the combined

teachings of the references would have suggested to a POSA. *Id.* And Petitioner has established that the combination of *Griffin* and *Zydney* would have taught that status 702 includes connectivity information that indicates whether each client 100 is currently connected to server 204. (Pet., 40-43; Ex. 1002, ¶¶170-176.)

Moreover, if text-only buddies were incorporated into the combination, *Griffin*’s system would operate in the same manner. As Mr. Easttom admitted in a related proceeding, *Griffin*’s server operates by forwarding chat messages 500 to mobile terminals 100 that are “determined by the server complex 204 as ready, i.e. ***online and technically capable***, to receive the particular type of message.” (Case No. IPR2017-01798, Ex. 2001, ¶78 (emphasis added); *see also* Ex. 1005, Fig. 7.) Similarly, during his deposition, Mr. Easttom explained that the statuses 702 “Available” and “TextOnly” both indicate whether the terminal 100 is “connected.” (Ex. 1040, 166:25-167:9 (“[Q.] So ‘available,’ you would be connected and you can receive any type of message. ‘Text only,’ you’re connected but you can only send texts? Is that what you said? A. You can only receive texts. Q. Okay. But that’s otherwise correct, what I just stated? A. Yes.”).) In Petitioner’s proposed combination, status 702 still indicates whether a terminal 100 is connected (i.e., online) but more specifically “indicate[s] whether terminal 100 is currently connected to server 204.” (Pet., 40-43.) In such a modified system, the text-only status would indicate that the terminal 100 is connected to server 204 and

technically capable of receiving only text messages. Thus, contrary to PO’s assertion, terminal 100 would not be considered available for selection as a recipient of a speech chat message simply by virtue of having an Internet connection.

Thus, as it did in its institution decision, the Board should reject these arguments as “speculative” and “supported only with conclusory declaration testimony that is entitled to little or no weight.” (Dec., 21 n.2.)

D. The Combination of *Griffin* and *Zydney* Discloses “Attaching One or More Files to the Instant Voice Message”

Petitioner proposes two obviousness arguments with respect to the “attaching” limitation recited in claim 9. First, Petitioner argues that, although *Griffin* does not *expressly* describe attaching files to a *speech* chat message, *Griffin* does expressly describe: (1) attaching files to a text chat message and (2) that its messages could be speech. (Pet., 47-48 (citing Ex. 1005, 12:63-66; 5:42-48, 6:39-52, 7:22-25, 10:53-58, Fig. 4).) Thus, as explained in the Petition, a POSA would have recognized that *Griffin*’s system could have attached files to its speech chat messages in the exact same way as it attached files to its text chat messages for the same reasons and advantages. (Pet., 48 (citing Ex. 1002, ¶191).) PO failed to address this argument altogether. Therefore, based on Petitioner’s obviousness rationale based on *Griffin* alone, the Board should confirm its preliminary determination that this limitation would have been obvious. (Dec., 21-22.)

Second, Petitioner further argues that *Zydney*’s express teaching of attaching files to its voice containers provides an additional basis for finding this limitation obvious based on the combined teachings of *Griffin* and *Zydney*. (Pet., 48-50 (“It *also* would have been obvious to a POSA to modify *Griffin*’s system/process to implement such features in view of the teachings of *Zydney*...”).) PO’s response to this argument is that “including attachments in a voice container” does not disclose this limitation because the voice container is not a “voice message.” (Resp., 24-31.) PO’s argument fails for several reasons.

First, PO’s argument is based on a flawed interpretation of the claimed “instant voice message.” As discussed in Section II.A.1, the proper construction of IVM is “a message containing digitized speech that is capable of being transmitted in real time to a recipient device.” Under this construction, *Zydney*’s voice container is an IVM, and is undisputed that *Zydney* describes attaching files to the voice container. (Pet., 48-50; Ex. 1002, ¶192.)

Second, even if PO were right that the claimed IVM in *Zydney* is the audio data contained within the voice container, this limitation would still have been obvious because attaching a file to a voice container means the file is also attached to the contents of the voice container, including the contained audio data. Indeed, based on the testimony of both Dr. Haas and Mr. Easttom, “attaching” requires only that the file and audio data travel together to their destination, such that the

destination can determine that the file and audio data are associated. (Ex. 2001, ¶30 (“the term ‘attachment’ should be interpreted as other files or information that are sent with a message”); Ex. 1040, 135:15-136:15, 137:10-13, 139:5-19.) Thus, attaching a file to one of *Zydney*’s voice containers containing audio data means the file is also attached to the audio data because the file and audio data travel together in the same voice container to their destination, and, for that reason, the destination is able to determine that the file and audio data are associated.⁴

PO’s argument that “Petitioner Shows No Motivation to Combine *Griffin* and *Zydney*” for the attachment limitation (Resp., 32-33) is nothing but conclusory attorney argument that ignores portions of the Petition and is directly contradicted by Petitioner’s expert. (Pet., 49-50 (explaining motivation to combine); Ex. 1002, ¶¶193-195.) For example, Dr. Haas testified that the combination would have beneficially provided the ability to collectively send and receive one or more files with a speech chat message:

⁴ Although PO does not address Petitioner’s obviousness argument based on *Griffin* alone for this limitation, the same logic regarding “attaching” discussed with respect to *Zydney* would apply to *Griffin*. That is, attaching a file to one of *Griffin*’s speech chat messages means the file is also attached to the message contents.

[A] skilled person would have been motivated to modify *Griffin*’s system/process such that the software (and related components) enables the attachment of one or more files to a speech chat message (similar to as described in *Zdney*) because it would have enhanced the capabilities and convenience of *Griffin*’s system/process by providing users with the ability to collectively send and receive one or more files with a speech chat message instead of needing to send and receive the files and messages separately.

(Ex. 1002, ¶193.) PO does nothing to rebut or overcome this evidence. Instead, PO improperly attempts to boot-strap its previous (erroneous) argument that *Zdney* does not disclose attachment to the instant voice message (which PO calls “an audio file”). (Resp., 32-33.)⁵ But this argument, which is wrong for the reasons discussed above, does not address the motivation to combine *Griffin* and *Zdney*.

Accordingly, PO’s arguments with respect to the “attaching” limitation fall

⁵ PO’s argument that *Zdney* purportedly teaches away from the combination (Resp., 31-32) is also entirely based on its erroneous view that the claimed IVM is the “message” (i.e., audio data) inside of the voice container. Even if this were the case, a POSA would have understood the audio data and the other file are “attached” because they are sent together in the voice container.

short.

E. *Clark* Teaches a Message Database Containing a Database Record With Both a Unique Identifier and the Message Itself

PO’s arguments against Petitioner’s unpatentability positions based on *Clark* are off base. (Resp., 34-42.) For example, PO asserts that “Petitioner admits that *Zydney* lacks this element.” (Resp., 34 (pointing to “Pet. at 48-50”).) However, *Zydney* is not even a part of the asserted combination for these claims. (Pet., 6 (asserting *Griffin* and *Clark* for claims 1-3 and 8); *see also id.*, 19-29.) The referenced pages of the Petition are also irrelevant, directed instead to claim 9 and the “attaching” limitation. (Pet., 48-50.)

The bulk of PO’s argument is directed towards its assertion that the claim language—“instant voice message is represented by a database record including a unique identifier”—requires both the message identifier and the IVM be contained in the same database record. (Resp., 34-37.) The claim language, however, is not so narrow. The claim merely states that the IVM is “represented” by a database record.

Nevertheless, even under PO’s overly narrow interpretation, *Clark* discloses this limitation. (Pet., 22-23.) In particular, PO largely ignores Figure 5B of *Clark* (*see* Resp., 35), which was discussed simultaneously with Figure 5A in the Petition (Pet., 22-23). Figure 5B shows a “MessageID” (unique identifier) that is contained in the same record as the message data (“<message.data>”). (Pet., 22-23; *see also*

Ex. 1007, 11:5-12:6.) PO does not dispute this. Instead, PO asserts that “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.” (Resp., 37.) This is simply not true. The Petition discusses both the “StoreMessageId” and the “MessageId.” (Pet., 48.) Thus, *Clark* discloses a message database containing a message record containing both the unique identifier and the message itself (as PO argues is necessary).⁶

PO’s arguments regarding Figure 5A of *Clark* fare no better. (Resp., 29-32.) As Petitioner explained, Figure 5A demonstrates a “StoreMessageID” (unique identifier) in the same record as the message data (“<message.data>”). (Ex. 1007, Fig. 5A; Pet., 48 (highlighting record 54 in a red box)). PO attempts to support its arguments by narrowly focusing on only the top half of Figure 5A (catalog 28 containing MessageSummary table 52 with “StoreMessageId” numbered 52A). As discussed above, Petitioner’s positions were not based solely on the

⁶ PO also asserts that “Petitioner speculates that the catalog database 28 and the message store 23 of *Clark* could be combined, as in Fig. 5B.” (Resp., 37.) This is not “speculation,” but an *express* teaching in *Clark*. (Ex. 1007, 11:1-3 (“As shown in FIGS 5A and 5B catalog database 28 and message store 23 may be separate from one another or may be integrated into a single integrated message store”).)

“StoreMessageId 52A” located in catalog 28, and thus PO’s arguments fail.

F. *Clark* Does Not Teach Away From the *Griffin-Zydney-Clark* Combination

PO’s argument that *Clark* teaches away from the combination ignores Figure 5B and the unpatentability positions actually proposed in the Petition. (Resp., 37-39.) In its Response, PO again relies solely on “MessageSummary table 52” (Resp., 37-39), even though Petitioner’s positions were not so limited (Pet., 22-23). Thus, PO’s argument is completely irrelevant for records 54 and 54’ in *Clark* (both pointed to by Petitioner). (Pet., 22-23.) Additionally, PO’s argument that *Clark* “disparages not separating the message data from the Message Summary table” (Resp., 39) ignores *Clark*’s express teaching that “catalog database 28 and message store 23...*may be integrated into a single integrated message store,*” as *Clark* illustrates in Figure 5B (Ex. 1007, 11:1-3 (emphasis added), Fig. 5B).

Thus, PO’s argument that *Clark* teaches away from the combination should be rejected because it is non-responsive to Petitioner’s actual arguments and overlooks the express teachings of *Clark*.

G. The Combination of *Griffin* and *Clark* Discloses a File Manager System That Can Store, Delete, and Retrieve Instant Voice Messages

PO focuses its argument only on the claimed function of “deleting” and thus tacitly concedes that the combination discloses “storing” and “retrieving” instant voice messages. (Resp. 39-42.) While PO attacks *Griffin* individually for its

purported non-disclosure of “deleting” (Resp., 41), as the Board recognized, Petitioner properly relied on *Griffin* for its teaching of “retrieving” (Dec., 24). PO does not disturb this finding. Because none of the challenged claims explicitly require “deleting” (only “at least one of storing, deleting, and retrieving” (Ex. 1001, 24:11-14)) the Board should dismiss PO’s arguments.

Regarding “deleting,” PO attacks *Clark* in only a single paragraph, arguing that “[t]he cited passages...describe requests being passed from one component of *Clark*’s system...to another...where neither of the components is what Petitioner alleges is the claimed message database (...message store 23)” and that the requests are not “user requests.” (Resp. 42.) These arguments are only supported by conclusory testimony—(Ex. 2001, ¶63) which repeats nearly verbatim the argument of the Response—and are contradicted by the express teachings in *Clark*. As Petitioner explained, a “[m]essage client 27 will typically generate requests *in response to user input* such as requests to message store server 24 to add, change, or *delete* a message’ in message store 23.” (Pet., 28 (emphasis added) (quoting Ex. 1007, 18:25-29); *see also* Ex., 1007, 9:15-16.) This express teaching makes clear that *Clark* discloses a user request to delete a message in the message database (message store 23).

Thus, *Clark* explicitly teaches deleting messages, and PO does not contest Petitioner’s showing that a POSA would have been motivated to provide such a

“well-known and commonly used” delete functionality in the combined system. (Pet., 28-29, Ex. 1002 ¶¶134-138.) Thus, the Board should confirm its preliminary findings and find these claims to be obvious.

IV. CONCLUSION

The Board should find claims 1-5, 7-12, 14-17, 25, and 26 of the ’433 patent unpatentable and cancel them.

Respectfully submitted,

Dated: August 24, 2018

By: /Naveen Modi/
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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing Petitioner's Reply to Patent Owner's Response contains, as measured by the word-processing system used to prepare this paper, 5,087 words. This word count does not include the items excluded by 37 C.F.R. § 42.24(a).

Respectfully submitted,

Dated: August 24, 2018

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served on the counsel for Patent Owner a true and correct copy of the foregoing Petitioner’s Reply to Patent Owner’s Response and supporting exhibits by electronic means on August 24, 2018, at the following address of record:

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