

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 PRELIMINARY RESPONSE TO PETITION
PURSUANT TO 37 C.F.R. §42.107(a)**

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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 <i>Uniloc USA, Inc. v. Samsung Electronic America’s, Inc.</i> , Case No. 2:16-cv-642
2003	U.S. Pat. App. Pub. No. 2004/0128356 (“ <i>Bernstein</i> ”)

I. INTRODUCTION

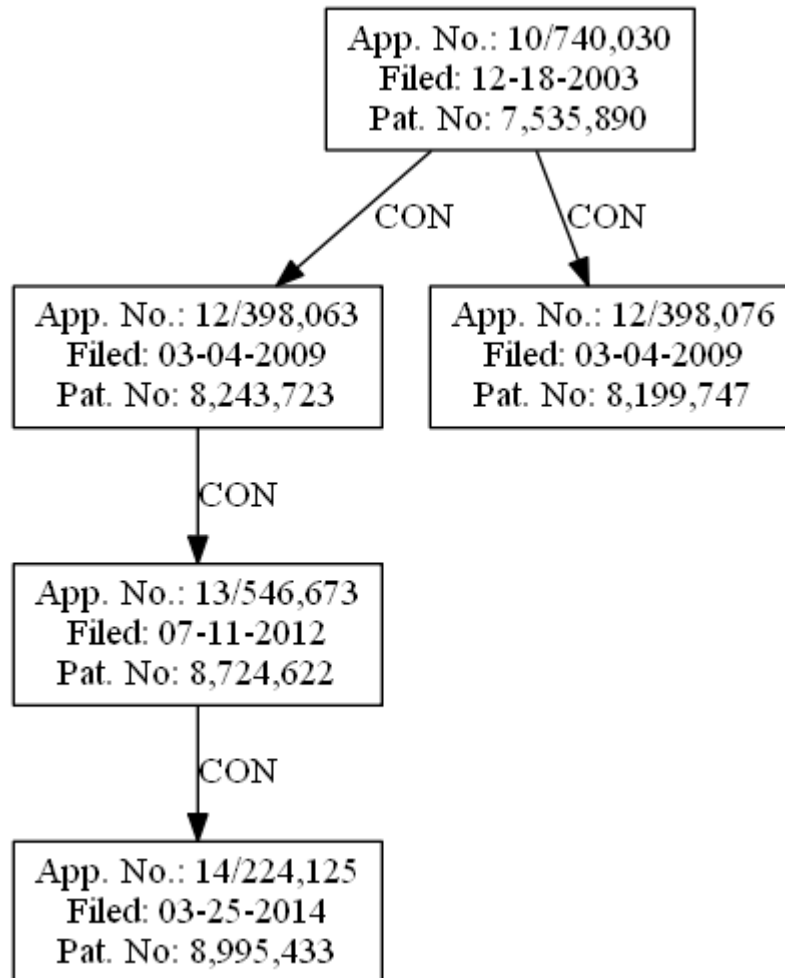
Patent Owner, Uniloc Luxembourg S.A., submits this Owner's Preliminary Response to Petitioner Samsung Electronics America, Inc.'s Petition for *Inter Partes* Review ("Petition" or "Pet. at _") of United States Patent No. 8,995,433 B2 ("the '433 Patent" or "EX1001") challenging Claims 1-5, 7-12, 14-17,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

The Petition should be denied in its entirety. First, the Petition relies on grounds that should be denied review providentially because they are horizontally or vertically redundant over grounds already before the Board in other Petitions. Second, Petitioner fails to meet its threshold burden of proving that there is a reasonable likelihood 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.

II. RELATED MATTERS

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).¹ The diagram below how this family of patents is interrelated.



Petitioner has initiated six of the thirty-six IPRs initiated against these five patents, as highlighted below. Eighteen IPR petitions initiated against these five patents predate Petitioner's six filings.

Petitioner	IPR#	Date	Patent
Apple	IPR2017-0220	14-Nov-16	'890
Apple	IPR2017-0221	14-Nov-16	'890
Apple	IPR2017-0222	14-Nov-16	'723

Petitioner	IPR#	Date	Patent
Apple	IPR2017-0223	14-Nov-16	'622
Apple	IPR2017-0224	14-Nov-16	'622
Apple	IPR2017-0225	14-Nov-16	'433
Facebook / WhatsApp	IPR2017-1257	7-Apr-17	'747
Facebook / WhatsApp	IPR2017-1365	3-May-17	'723
Facebook / WhatsApp	IPR2017-1427	11-May-17	'433
Facebook / WhatsApp	IPR2017-1428	11-May-17	'433
Facebook / WhatsApp	IPR2017-1523	2-Jun-17	'890
Facebook / WhatsApp	IPR2017-1524	2-Jun-17	'890
Facebook / WhatsApp	IPR2017-1667	22-Jun-17	'622
Snap	IPR2017-1611	15-Jun-17	'433
Snap	IPR2017-1612	16-Jun-17	'890
Facebook / WhatsApp	IPR2017-1634	16-Jun-17	'433
Facebook / WhatsApp	IPR2017-1635	16-Jun-17	'723
Facebook / WhatsApp	IPR2017-1636	16-Jun-17	'890
Samsung Elec	IPR2017-1797	20-Jul-17	'622
Samsung Elec	IPR2017-1798	20-Jul-17	'622
Samsung Elec	IPR2017-1799	20-Jul-17	'747
Samsung Elec	IPR2017-1800	20-Jul-17	'723
Samsung Elec	IPR2017-1801	20-Jul-17	'433
Samsung Elec	IPR2017-1802	20-Jul-17	'890
Apple	IPR2017-1804	20-Jul-17	'622
Apple	IPR2017-1805	20-Jul-17	'622
Huawei / LG Electronics	IPR2017-2090	11-Sep-17	'622
LG Electronics	IPR2017-2087	11-Sep-17	'433

¹ All five related patents derive from United States Patent Application No. 10/740,030. Also referred to collectively as the '433 Patent family.

Petitioner	IPR#	Date	Patent
LG Electronics / Huawei	IPR2017-2088	11-Sep-17	'433
Google/Huawei/Motorola	IPR2017-2080	12-Sep-17	'622
Google/Huawei/Motorola	IPR2017-2081	12-Sep-17	'622
Google/Huawei/Motorola	IPR2017-2082	11-Sep-17	'890
Google/Huawei/Motorola	IPR2017-2083	11-Sep-17	'890
Google/Huawei/Motorola	IPR2017-2084	11-Sep-17	'890
Google/Huawei/Motorola	IPR2017-2067	12-Sep-17	'433
Google/Huawei/Motorola	IPR2017-2085	11-Sep-17	'747

It is worth noting that Petitioner filed its six IPRs the same day (July 20, 2017) that Apple filed two additional IPRs. Although presumably the parties coordinated their efforts (*see* also fn. 3, *infra*), neither party identifies the other as a real party in interest. The instant Petition does provide what appears to be an accurate summary of pending litigation related to the '433 Patent. Pet. at 1–3.

III. THE PETITION FOR IPR2017-1801 SHOULD BE DENIED AS REDUNDANT.

Petitioner's IPRs 2017-1797 through 1802, including IPR2017-1801, could be the poster children for the abusive filing of redundant *inter parties* review petitions. Petitioner redundantly brings against the independent claims (Claims 1, 6, and 9) of the '433 Patent the same references (e.g., *Zydney, Clark*) and grounds that are already before the Board in other Petitions. Petitioner's attacks on dependent claims are also redundant. Yet Petitioner has not met its obligation to justify through reasoned explanation why it should again tax the Board and the Patent Owner with

these redundant filings. *See Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.*, CBM2012-00003, Paper 7, Order (P.T.A.B. October 25, 2012) at 2 (“A petitioner has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. §42.20(c).”).²

Petitioner concurrently filed six IPR petitions (IPR2017-1797 through 1802) challenging at least 80 patent claims, many on multiple grounds, in five related patents—the ’433, ’622, ’723, ’747, and ’890 Patents—using at least 10 combinations of 9 now-familiar references (in this section, references retread from earlier proceedings are in ***bold italics***): *Aravamudan*, ***Clark***, *Griffin*, *Lee*, *Low*, ***Malik***, ***Väänänen***, ***Vuori***, and ***Zydney***.³

In April and June 2017, Petitioner Facebook filed nine IPR petitions (IPR2017-1257, 1365, 1427, 1428, 1523, 1524, 1634, 1667, and 1668) challenging

² When the Board promulgated these Regulations, it considered the effect on the economy, the integrity of the patent system, the efficient administration of justice, and the ability of the Office to timely complete proceedings as mandated by 35 U.S.C. §326(b). Because Petitioner thus frustrates Congressional intent, *see Liberty Mutual*, Paper No. 7 at 2, the Petition should be denied.

³ Petitioner and Facebook (along with Apple and others) jointly submitted invalidity contentions 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 (EX2002). Since such a filing, Petitioner, Facebook, and Apple have coordinated in IPR filings. These filings have been based on references known before the original IPR was filed.

over at least 96 claims of the same five related patents—using at least 18 combinations of 16 references: *Abburi*, *Appelman*, *Clark*, *Greenlaw*, *Hethmon*, *Holtzberg*, *Logan*, *Malik*, *Martin-Flatin*, *Microsoft*, *Moghe*, *Newton*, *Shinder*, *Väänänen*, *Vuori*, and *Zydney*.

And a year ago, on Nov. 14, 2016, Petitioner Apple concurrently filed six IPR petitions (IPRs 2017-0220 through 0225), challenging at least 71 patent claims in four of the five related patents—the ’433, ’622, ’723, and ’890 Patents—using at least 18 combinations of 13 references: *Abburi*, *Dahod*, *Daniell*, *Deshpande*, *Hogan*, *Holtzberg*, *Lerner*, *Logan*, *Malik*, *SMSS*, *Stubbs*, *Väänänen*, *Vuori*.⁴

More recently, in September 2017, Petitioner Google filed seven IPR Petitions, IPR2017-2067 and IPR2017-2080 through 2085, challenging at least 150 patent claims in four of the five related patents—the ’433, ’622, ’747, and ’890 Patents—using at least 19 combinations of 17 references: *Aggarwal*, *Appelman*,

⁴ *Dahod* and *Vouri* are cumulative, and *Dahod* had been before the Office during prosecution. Petitioner Apple admitted, and the Board found, that Apple elucidated no significant difference between *Dahod* and *Vouri*. IPR2017-0224 Order Denying Institution, Paper No. 7, May 25, 2017, at 7 (“Petitioner attempting to distinguish the Dahod application from the ‘*Vuori*’ reference relied upon in concurrently filed IPR2017-00223 on the basis that the latter ‘is not susceptible to a potential §325(d) attack’”). Petitioner admitted that *Dahod* had been before the Examiner during prosecution.

Bartholemew, Boneh, Coussement, Demsky, Enete, Erekson, Gralla, Katsef, Okano, Oppenheimer, RFC793, RFC2131, Stern, Trapani, and Zydney.

Petitioner Google filed the IPR2017-02067 against the '433 Patent challenging: Claims 9, 12–14, 17, and 25 as anticipated by **Zydney**; Claims 1–6, 11, and 16 as obvious over **Zydney** and *Stern*; Claims 7 and 8 as obvious over **Zydney** plus of *Stern* and *Enete*; Claim 10 as obvious over **Zydney** plus *Trapani*; Claim 15 as obvious over **Zydney** plus *Demsky*; Claims 18–24 as obvious over **Zydney** plus *Katseff*; and Claims 26–27 as obvious over **Zydney** plus *Enete*.

Thus, IPR2017-1801 and the grounds it asserts are redundant and should be denied because “numerous redundant grounds” needlessly place “a significant burden on the Patent Owner and the Board” and “cause unnecessary delays.” *Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.*, CBM2012-00003, Paper 7 (P.T.A.B. October 25, 2012) at 2 (“multiple grounds, which are presented in a redundant manner by a petitioner who makes no meaningful distinction between them, are contrary to the regulatory and statutory mandates, and therefore are not all entitled to consideration.”); *Costco Wholesale Corp. v. Robert Bosch LLC*, IPR2016-00035, Paper No. 16, Decision Denying Institution, at 11 (Denying institution where Petitioner asserted “multiple” grounds that were, in fact, just variations of the same ground); *see* 37 C.F.R. §42.1(b) which mandates a “just, speedy, and inexpensive resolution of every proceeding.”

Of the thirty-six IPRs that have been initiated against the patents in this family, at least twenty-five IPRs rely on *Zydney* as a primary reference. Although Petitioner may allege that *Griffin* is the “primary reference” *Zydney* is the substance-over-form primary reference doing most of the work in each of the six Petitions. The *inter partes* review system is not a piñata party in which each colluding Petitioner can take a turn whacking at Patent Owner’s patents with the *Zydney* stick. The Board should therefore reject the instant Petition outright.

A. Petitioner’s Unjust and Unjustified Horizontal Redundancy

As clearly laid out above, IPRs 2017-1797 through 1802 re-use a collection of well-worn references served up in other Petitions. The references relied upon provide essentially the same teachings to meet the same claim limitations, but Petitioner’s lawyer arguments do not explain why one reference more closely satisfies any claim limitation at issue in some respects than does another reference, and vice versa. These references are not identical, each reference has to be better in some respect otherwise the references are collectively horizontally redundant and cumulative. IPR2017-1801 should be denied.

The Board should disregard redundant grounds. *See General Plastic Industrial Co. LTD, v. Canon Kabushiki Kaisha*, No. IPR2016-01357, Paper No. 19, Decision Denying Petitioner’s Request for Rehearing at 3 (Where “Petitioner filed follow-on petitions against the same patents [for] each of those follow-on petitions,

[the Board] exercised [its] discretion not to institute pursuant to 35 U.S.C. §314(a) and 37 C.F.R. §42.108(a).”);⁵ *Berk-Tek LLC v. Belden Techs. Inc.*, No. IPR2013-00057, Paper No. 21, Decision on Request for Rehearing at 4–5 (P.T.A.B. May 14, 2013) (“If the petitioner makes no meaningful distinction between certain grounds, the Board may exercise discretion by acting on one or more grounds and regard the others as redundant” because “allowing multiple grounds without meaningful distinction by the petitioner is contrary to the legislative intent”); *Oracle Corp. v. Clouding IP, LLC*, No. IPR2013-00075, Paper No. 8, Decision Institution of *Inter Partes* Review at 13–14 (P.T.A.B. May 3, 2013) (denying various grounds of unpatentability because they were redundant); *AmkorTech., Inc. v. Tessera, Inc.*, No. IPR2013-00242, Paper No. 37, Decision Institution of *Inter Partes* Review at 32–33 (P.T.A.B. Oct. 11, 2013) (ditto).

B. Petitioner Uses Vertical Redundancy to Take a Third and Fourth Bite.

IPR2017-2067 acknowledges that “petitioners have filed [multiple] IPR proceedings challenging . . . claims of the ’433, ’622, [’723,] ’890, and ’747 patents

⁵ Relying on the seven factors from *NVIDIA Corp. v. Samsung Elec. Co.*, Case IPR2016-00134, Paper No. 9 (PTAB May 4, 2016) to deny each of the follow-on Petitions. *Canon Kabushiki Kaisha* at 9-10.

[which are] in the same patent family as the '433 Patent.” 2067 Pet. at 3.⁶

Those Petitioners challenge the claims of the '433 Patent as obvious in nine (9) IPRs:

- Apple Inc. v. Uniloc Luxembourg S.A., IPR2017-00225 (Instituted May 25, 2017);
- Facebook, Inc. v. Uniloc USA, Inc., IPR2017-01427;⁷
- Facebook, Inc. v. Uniloc USA, Inc., IPR2017-01428;⁸
- Facebook, Inc. v. Uniloc USA, Inc., IPR2017-01634;
- Snap Inc. v. Uniloc USA, Inc., IPR2017-01611;
- Samsung v. Uniloc USA, Inc. IPR2017-1801;⁹

⁶ Petitioners' apparent coordination to game the system is wasteful and unfair. On the very day (i.e., on July 20, 2017) Petitioner Samsung filed six Petitions against the '433 Patent family, including IPR2017-1801, Apple filed IPR2017-1804 and 1805 also asserting the same *Zydney*, *Shinder*, *Clark*, *Appelman*, and *Hethmon* references.

⁷ Challenging: Claims 9, 12, 14, 17, 25-26 as obvious over *Zydney*; Claims 11, 15, 16 as obvious over *Zydney* plus *Greenlaw*; and Claim 10 as obvious over *Zydney* plus *Newton*.

⁸ Challenging: Claims 1-8 as obvious over *Zydney* plus *Clark*; and Claim 7 as obvious over *Zydney* plus *Clark* plus *Appelman*.

⁹ Challenging: Claims 1-3, and 8 as obvious over *Griffin* and *Clark*; Claims 4 and 7 as obvious over *Griffin*, *Clark*, and *Zydney*; Claim 5 as obvious over *Griffin*, *Clark*

- LG, Huawei v. Uniloc, Inc. IPR2017-2088;¹⁰
- LG, Huawei v. Uniloc, Inc. IPR2017-2087;¹¹ and as anticipated in
- Google v. Uniloc, Inc. IPR2017-2067.¹²

Thus, Petitioner grossly violates the long-standing prohibition against vertical redundancy. IPRs 2017-1797 through 1802 recycle well-worn references through the simple expedient, on this go-round, of adding a user interface patent to *Griffin* to the mix. Nowhere, however, does Petitioner explain how simply adding *Griffin* makes it fair or permissible to again burden the Board and the Patent Owner with this latest barrage of Petitions. It is clear that Petitioners are gaming the system.

and *Väänänen*; Claims 9, 11, 14-17, 25, and 26 as obvious over *Griffin* and *Zydney*; Claim 12 as obvious over *Griffin*, *Zydney*, and *Vaananen*; Claim 10 as obvious over *Griffin*, *Zydney*, and *Lee*; and Claim 7 as obvious over *Griffin*, *Zydney*, and *Vuori*.

¹⁰ Challenging: Claims 9, 12, 14, 17, 25-26 as obvious over *Zydney*; Claims 11, 15, 16 as obvious over *Zydney* plus *Greenlaw*; and Claim 10 over *Zydney* plus *Newton*.

¹⁰ Challenging: Claims 1-8 as obvious over *Zydney* plus *Clark*; and Claim 7 over *Zydney* plus *Clark* plus *Appelman*.

¹¹ Challenging: Claims 1-6 and 8 as obvious over *Zydney* plus *Clark*; and Claim 7 as obvious over *Zydney* plus *Clark*;

¹² Challenging: Claims 9, 12-14, 17, and 25 as anticipated by *Zydney*; Claims 1-6, 11, and 16 as obvious over *Zydney* and *Stern*; Claims 7 and 8 as obvious over *Zydney* plus of *Stern* and *Enete*; Claim 10 as obvious over *Zydney* plus *Trapani*; Claim 15 as over *Zydney* plus *Demsky*; Claims 18-24 as obvious over *Zydney* plus *Katseff*; and Claims 26-27 as obvious over *Zydney* plus *Enete*.

Petitioners appear to be playing the odds: If Petitioners keep filing IPR petitions against the '433 Patent family, Petitioners will eventually overwhelm the Board and Patent Owner.¹³

Petitioner's ruse is transparent, futile, and unfair. As explained below, user interface patent *Griffin* is ill-suited to Petitioner's hopes because *Griffin* adds nothing relevant to either *Zydney* or *Clark*. *Griffin* does not describe or enable an instant voice messaging application. Indeed, *Griffin* merely mentions "voice" in passing: First, in the context of push-to-talk, which is inapplicable here; and second, merely as an alternative to text payloads. *Griffin* also does not describe or enable transmission of an instant voice message over a packet-switched network. *See Canon Kabushiki Kaisha* at 11 (citation omitted) ("The filing of sequential attacks against the same claims, with the opportunity to morph positions along the way, imposes inequities on Patent Owner" and on the Board).

Indeed, Petitioner tacitly admits that it chose *Griffin* as a primary reference knowing it is redundant over *Zydney*: "While *Zydney* is at issue in a different IPR challenging the '433 Patent . . . Grounds 1–7 rely on *Griffin* as a primary reference .

¹³ "You will kill ten of my men but we will kill one of yours. And in the end it is you that will tire [of it first]." Ho Chi Minh, September 1946, at the close of negotiations with the French. Seeds of Revolution, Todd McCain, iUniverse LLC (Bloomberg 2009) at p. 229.

. . . because it is different” *See* Pet. at 8. *See also* IPR2017-1797 at 7 (ditto), IPR2017-1798 at 8 (ditto), IPR2017-1799 at 7 (ditto), IPR2017-1800 at 6 (ditto), IPR2017-1802 at 7–8 (ditto). If all that is needed is “different” then there will never be an end to Petitioners’ abuse of the system and harassment of Patent Owner. Thus, IPR2017-1801 should be denied.

C. *Zydney* is Materially the Same as the art Cited During Prosecution of the ’433 Patent and Therefore is Demonstrably Duplicative for the Purposes Relied on by Petitioner

As explained herein, the Petition fails to “set forth . . . [h]ow [each] construed claim is unpatentable under the statutory grounds identified [in the Petition and] specify where each element of the claim is found in the prior art patents or printed publications relied upon,” as required by 37 C.F.R. § 42.104(b)(4). *See Kingston Technology Company, Inc. v. SPEX Technologies, Inc.*, IPR2017-0824 (Paper 8) (P.T.A.B. August 17, 2017) (denying institution in part because “the rules require the petition to identify ‘how the construed claim is unpatentable under the statutory grounds identified’ and ‘specify where each element of the claim is found in the prior art patents or printed publications relied upon’”). Further, of the two primary references relied upon in the Petition, *Griffin* and *Zydney*, at least the latter is materially the same as the art cited during prosecution of the ’433 Patent.

Many of the assertions in the Petition against the claims of the ’433 Patent are based in part on *Zydney*. In other words, Petitioner relies on *Zydney* for the purpose

of providing an allegedly *missing* teaching (i.e., absent from the record during prosecution of the application for the '433 Patent) to allegedly invalidate each challenged claim of the '433 Patent. Notwithstanding Petitioner's purpose to introduce *Zydney* for the missing teachings needed to support its grounds, *Zydney* is demonstrably duplicative for those purposes.

On page 50 of the Petition, Petitioner relies on an alleged teaching in *Zydney*, stating "it would have been obvious to a POSA at the time of the alleged invention to modify *Griffin*'s system/process such that terminal 100 is directly connected to network 203 *in view of the teachings of Zydney*." (Emphasis added.) However, U.S. Pat. App. Pub. No 2004/0128356 (EX2003; "*Bernstein*"), listed on the face of the '433 Patent similarly describes a terminal directly connected to a network. EX2003, ¶ 0013, Fig. 1.

On page 55 of the Petition, Petitioner relies on another alleged teaching in *Zydney*, stating "it would have been obvious to a POSA at the time of the alleged invention to modify *Griffin*'s system/process *based on the teachings of Zydney* so that status 702 indicates whether terminal 100 is 'available' or 'unavailable'[".] (Emphasis added.) However, *Bernstein*, similarly describes indicating whether the terminal is available or unavailable. *Id.* at ¶¶ 0007, 0016, 0017, 0122, and 0132.

On page 38 of the Petition, Petitioner relies on yet another alleged teaching in *Zydney*, stating "it also would have been obvious to modify *Griffin*'s system/process

based on the teachings of Zydney so that speech chat messages are temporarily stored at server complex 204 and received by the recipient's terminal 100 depending on whether the recipient's status 702 indicates that the recipient is available.” (Emphasis added.) However, *Bernstein* similarly describes storing instant messages to a server (e.g., for later retrieval by a user becoming available) in addition to describing indicating whether the terminal is available or unavailable. *Id.* at ¶¶ 0050, 0100, 0129, and 0130.

Under 35 U.S.C. § 325(d), the Board need not and should not second-guess issues of patentability that the Office addressed before issuing the '433 Patent. Specifically, the statute authorizes rejecting grounds for *inter partes* review that seek to reargue positions:

In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and *reject the petition or request because, the same or substantially the same prior art or arguments previously were presented* to the Office.

35 U.S.C. § 325(d) (emphasis added). Accordingly, based on § 325(d), Petitioner's reliance on *Zydney* should be rejected as cumulative with what the Primary Examiner had cited and considered during prosecution. *See, infra, Unified Patents, Inc. v. Berman*, Case IPR2016-1571 (P.T.A.B. Dec. 14, 2016) (Paper 10) and *Cultec, Inc. v. Stormtech LLC*, Case IPR2017-0777 (P.T.A.B. Aug. 22, 2017)

(Paper 7). Compounding the matter is the fact that Petitioner made no attempt to explain why its cumulative reliance on *Zydney* does not invoke that statute. *See Baker Hughes Oilfield Operations, Inc. v. Smith International, Inc.*, No. IPR2016-1450 (P.T.A.B. Dec. 22, 2016), Paper 10 (finding the reliance on references previously presented to the Office was not entitled to consideration due to “the failure of Petitioner to address the impact of § 325(d)”).

In *Berman*, the Board denied institution of one ground under § 325(d) because the petitioner asserted an obviousness combination that included a reference the examiner considered during prosecution and a second reference that was cumulative of prior art that the examiner considered. The Board also declined to exercise discretion under § 325(d) with respect to a second asserted obviousness combination, where the examiner did not consider the asserted references during prosecution, and the references were not cumulative of the prior art the examiner considered during prosecution. In *Cultec*, the Board denied institution under § 325(d) because (i) the examiner previously considered two of the asserted references—one reference was raised in a third-party submission that the examiner discussed in rejecting the claims and the other reference the examiner cited and applied throughout prosecution; and (ii) the two additional references upon which the petitioner relied were cumulative of prior art the examiner considered during prosecution.

D. The Board Should Exercise its Discretion and Deny the Petition.

35 U.S.C. § 314(a) and 37 C.F.R. § 42.108 make clear that institution of an *inter partes* review is discretionary. Various factors help the Board in determining whether to exercise discretion to deny review. *Blue Coat Systems LLC v. Finjan, Inc.*, No. IPR2016-01443, Paper 13, Decision Denying Institution of *Inter Partes* Review at 8–9 (P.T.A.B. Jan. 23, 2017) provides a listing of eight such factors (collecting cases, internal citations omitted):

- (1) the finite resources of the Board;
- (2) the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than one year after the date on which the Director notices institution of review;
- (3) whether the same petitioner previously filed a petition directed to the same claims of the same patent;
- (4) whether, at the time of filing of the earlier petition, the petitioner knew of the prior art asserted in the later petition or should have known of it;
- (5) whether, at the time of filing of the later petition, the petitioner already received the patent owner’s preliminary response to the earlier petition or received the Board’s decision on whether to institute review in the earlier petition;
- (6) the length of time that elapsed between the time the petitioner learned of the prior art asserted in the later petition and the filing of the later petition;

- (7) whether the petitioner provides adequate explanation for the time elapsed between the filing dates of multiple petitions directed to the same claims of the same patent; and
- (8) whether the same or substantially the same prior art or arguments previously were presented to the Office.

These factors favor a discretionary decision of non-institution. Even if the Board considers factors (2)–(7) inapplicable because there are no earlier-filed IPR Petitions listing Samsung Electronics America, Inc. as Petitioner, factors (1) and (8) counsel against institution. The first factor, “the finite resources of the Board,” disfavors permitting the serial filing of multiple petitions against the same patent using the same *Zydney* reference and associated arguments (which Patent Owner would otherwise have no choice but to serially rebut in the same manner).

The eighth factor also favors denial because “the same or substantially same prior art or arguments were previously presented to the office.” As explained above, Petitioner provides no explanation for why the arguments and art cited in the instant Petition differ in any way from either the art cited during prosecution or for the horizontal or vertical redundancy reflected by the IPRs pending against this patent family.

The Board should therefore exercise its discretion to deny institution of any ground presented in the instant Petition.

II. THE '433 PATENT DESCRIBES INSTANT VOICE MESSAGING OVER A PACKET-SWITCHED NETWORK.

A. Effective Filing Date of the '433 Patent

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.

III. THERE IS NO REASONABLE LIKELIHOOD THAT EVEN ONE OF THE CHALLENGED CLAIMS 1–5, 7–12, 14–17, 25, OR 26 IS UNPATENTABLE.

Petitioner has the burden of proof to establish entitlement to the relief it requests. 37 C.F.R. §42.108(c). Because IPR2017-1801 only presents theories of obviousness, Petitioner must demonstrate a reasonable likelihood 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.¹⁴

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

¹⁴ While certain deficiencies in the Petition are addressed here, Patent Owner reserves the right to address other deficiencies of the Petition in a full Response if an *inter partes* review is instituted.

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 how or why 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 not available for real-time communication.

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 available target (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) (underling 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 still may not be delivered: “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, 37.¹⁵

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

¹⁵ 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 motivated 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 204¹⁶), 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*.¹⁷ *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 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

¹⁶ See fn. 14, *supra*.

¹⁷ See fn.15, *supra*.

be rendered inoperable for its intended purpose” and therefore the reference “teaches away”); *In re Spinnoble*, 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).¹⁸ 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 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:

¹⁸ *Zydney* is unpatented application: International App. No. WO 01/11824A2.

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 explains 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 (IETF). 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 is unclear, but 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.

IV. THE SUPREME COURT IS CURRENTLY REVIEWING THE CONSTITUTIONALITY OF *INTER PARTES* REVIEW

The Supreme Court is currently considering the constitutionality of *inter partes* review proceedings. *Oil States Energy Servs., LLC v. Greene's Energy Grp.*,

LLC, 137 S. Ct. 2239 (2017). The constitutional challenge is primarily based on the argument that adversarial challenges to an issued patent—like *inter partes* reviews—are “Suits at common law” for which the Seventh Amendment guarantees a jury trial. U.S. Const. amend. VII; *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 377 (1996). Further, because patents are private property rights, disputes concerning their validity must be litigated in an Article III court, not before an executive branch agency. *McCormick Harvesting Mach. Co. v. C. Aultman & Co.*, 169 U.S. 606, 609 (1898). Out of an abundance of caution, Patent Owner hereby adopts this constitutional challenge now to preserve the issue pending the Supreme Court’s decision.

V. CONCLUSION

For at least the reasons set forth above, Uniloc respectfully requests that all challenges in Petition IPR2017-1801 be denied.¹⁹

Date: November 8, 2017

Respectfully submitted,

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¹⁹ 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 Preliminary 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: November 8, 2017

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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 PRELIMINARY 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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