Paper No. 7

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Facebook, Inc. and Instagram, LLC

Petitioners,

v.

Voxer IP LLC,

Patent Owner.

Case IPR2021-00399
U.S. Patent No. 10,109,028

PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 35 U.S.C. § 313 AND 37 C.F.R. § 42.107

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EXHIBIT TABLE

Exhibit #	Description
2001	Voxer, *Voxer Business Named Best Overall App in the First Annual Silicon Valley Business App Awards* (Nov. 18, 2013), https://www.voxer.com/blog/voxer-business-named-best-overall-app-in-the-first-annual-silicon-valley-business-app-awards/
2002	Second Amended Agreed Scheduling Order, *Voxer v. Facebook*, Case No. 1:20-cv-00644-ADA, Dkt. 88 (W.D. Tex. Apr. 20, 2021)
2003	Petitioner's Final Invalidity Contentions Claim Chart for Munje in combination with Rand against U.S. Patent No. 10,109,028, served January 14, 2021
2004	Petitioner's Final Invalidity Contentions Claim Chart for Bulthuis in combination with Pelttari against U.S. Patent No. 10,109,028, served January 14, 2021
2005	July 17, 2020 Email Between Counsel re Asserted Claims
2006	Information about the Pfizer-BioNTech COVID-19 Vaccine, https://www.cdc.gov/coronavirus/2019-ncov/vaccines/different-vaccines/Pfizer-BioNTech.html (accessed February 11, 2021)
2007	Texas Vaccine Data Dashboard, https://tabexternal.dshs.texas.gov/t/THD/views/COVID-19VaccineinTexasDashboard/Summary?:origin=card_share_link&:embed=y&:isGuestRedirectFromVizportal=y (accessed April 27, 2021)

I. INTRODUCTION

Facebook and Instagram's Petition (Paper 1, IPR2021-00399, "Petition" or "Pet.") should be rejected on both discretionary and substantive grounds.

First, the Board should use its discretion to deny institution under § 314(a). In particular, the challenged patent is currently the subject of litigation in the Western District of Texas, a case that has been ongoing for ***over fifteen months.*** In that time, the parties have exchanged multiple document productions as well as source code productions, and Petitioner has served both preliminary and final invalidity contentions. In addition, the district court has already issued a claim construction order after full briefing by the parties and a hearing. The trial date in the Texas case is currently set for January 18, 2022—***six months*** before the Board's Final Written Decision would issue if institution were granted.

Moreover, there is ***complete*** overlap between the issues presented in the Petition and the district court case. Petitioner's invalidity contentions rely on precisely the same art asserted in the Petition. Petitioner has not agreed to forego relying on the Petition's cited prior art and arguments in the litigation if institution is granted and has therefore reserved its right to continue to assert in litigation any invalidity ground raised in this petition, rendering the two proceedings entirely duplicative.

Thus, not only has there been significant investment of time and resources in the district court litigation, it will reach a determination on invalidity months in advance of this Petition, on the very same combinations. Petitioner has effectively chosen the forum in which it will present its invalidity defense by waiting ***almost twelve months*** to file the Petition and relying on the same grounds presented in the litigation.

Second, the grounds do not render obvious multiple elements of challenged claims 1, 5, and 12. Petitioner has failed to present a *prima facie* case for the disclosure or obviousness of several claim limitations, including in particular an "embeddable communications software module." The embeddable communications software module handles particular claimed communications functions and interoperates with a host software application using an API. However, none of the four references raised by Petitioner disclose an embeddable communications software module or discuss in any detail the internal organization of any disclosed communications software. For Ground 2, Petitioner even points to a hardware module that is solely used for storage as meeting the "software" claim limitation. Neither the Petition, nor its cited references, nor its expert declaration, present a cogent case for the disclosure of obviousness of the "embeddable communications software module" limitation in either Ground. Several other limitations are lacking

from the prior art references as well. Patent Owner thus respectfully requests the Board deny institution of *inter partes* review.

II. BACKGROUND

A. Voxer

Voxer is a leading communications innovator. It developed and provides the Voxer app for iOS and Android, as well as the Voxer SDK. Tom Katis is Voxer's co-founder, served as CEO until 2015, and is a named inventor on the '028 patent. He served as a United States Army Special Forces Communications Sergeant in a combat deployment to Afghanistan after September 11, 2001. Mr. Katis experienced the shortcomings of existing communications systems while coordinating medevac, tactical reinforcements, and close air support in combat operations. Among other deficiencies, he observed that these systems could operate only in real-time or after complete message composition, and were ill-suited for time-sensitive communications with multiple groups in a disruptive environment.

Mr. Katis and his team began developing communications solutions in 2006 to remedy these shortcomings. The new technologies enabled transmission of voice and video communications with the immediacy of live communication and the reliability and convenience of messaging. The technologies allowed transmission and reception under poor and varying network conditions and regardless of recipient availability.

Voxer launched the Voxer Walkie Talkie app in 2011. It became an immediate success and was named Best Overall App in the First Annual Silicon Valley Business App Awards in 2013. Ex. 2001.

B. Overview of the '028 Patent

U.S. Patent No. 10,109,028 (Ex. 1001, "'028 patent") is addressed to a particular way of enabling software applications to communicate. Rather than having a standalone application that includes all communications functionality, the '028 patent "involves a module that can be embedded in a software application, which provides the application with various communications features." '028 patent at 1:59-63. Because the communications functionality is provided as a module, rather than as an entire software application, the "module can be embedded in a wide variety of software applications." *Id.* at 3:11-12. While the embeddable communications software module is responsible for communications, the host application "is arranged to provide a user interface and options that a user can interact with to activate particular features," including features that "may have nothing to do with network communications." *Id.* at 4:61-67.

Having a separate module rather than a monolithic application has several advantages, including reduced development time. *Id.* at 3:44-49 ("[I]t would be desirable to find a way to easily integrate the above functionality into third party applications. This would allow third parties to integrate advanced communications

features into their applications, while reducing development time and eliminating the need to invest in a network infrastructure."); 5:16-20 ("The developer of the software application 206 need not spend time or resources on developing a proprietary communications solution, but instead can offload such functionality to the module 204, which is typically provided by another developer."). Third parties can piggy-back on the investment in communications infrastructure that was made by the vendor of the embeddable communications software module. *Id.* at 3:57-4:4; 5:10-14 ("Due to the module, the software application 204 need not directly manage network communications.").

Thus, the structural relationship between the embeddable communications software module and the host software application is an important aspect of the invention. The embeddable communications software module is embedded in the software application and is not co-extensive with the application itself. *Id.* at 5:1-2 ("Embedded within the software application is an embeddable communications software module 204."); 5:2-5 ("The embeddable communication software module 204 is a distinct software module that manages some or all of the aforementioned communications features . . . ."). Figure 2 depicts this relationship, with the embeddable communications software module 204 depicted as within software application 206:

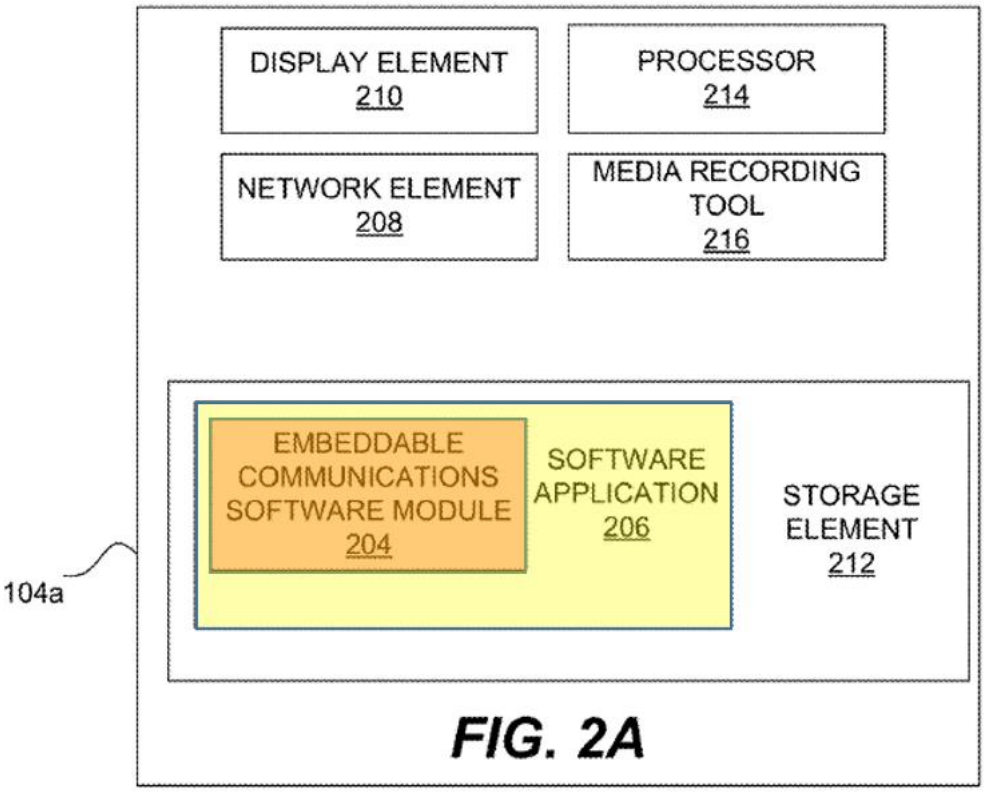

FIG. 2A

Another example of how the software application is not co-extensive with the embeddable communications software module is how the two components communicate with each other. The embeddable communications software module provides an Application Programming Interface ("API") which the software application can use to configure and command the module. *Id.* at 5:24-28 ("The module 204 includes an application programming interface (API) 230 and a communications management unit 232. The API is arranged to receive API inputs, commands or calls from the software application 206."); 5:37-39 ("The communications management unit 232 of the module 204 is arranged to process and execute any received API commands or instructions."); cl. 1 ("provide an application

programming interface (API) that allows the embeddable communications software module to receive API inputs from the software application, the embeddable communication software module and the software application communicating through the API"); cl. 12 (similar).

The invention allows a software application to access a specific type of communications system through the embeddable communications software module. In particular, the communications are progressively transmitted and received. *E.g.*, *id.* at 3:26-29 ("When a user is sending a message (e.g., an outgoing voice call), the device also progressively transmits and stores the message while it is being created."); 7:58-61 ("The module 204 then progressively transmit[s] or routes the message based at least in part on the recipient identity information as the message is being created by the user (step 312).").

The progressive storage of incoming messages allows each received message to be rendered in two different modes: a real time mode and a time shifted mode. *Id.* at 3:32-34 ("This storage feature enables two modes of operation for the user, a real time mode and a time-shifted mode."); 8:49-53 ("RENDER IN REAL TIME . . . . [A]n in coming message should be progressively rendered as it is received and/or stored."); 3:37:-39 ("In the time-shifted mode, the user can selectively render and review any stored messages.").

C. Grounds Asserted in the Petition

The Petition asserts two obviousness grounds based on post-AIA 35 U.S.C. § 103(a) against independent claims 1 and 12 and dependent claim 5 (the "challenged claims"):

- Ground 1 alleges that claims 1, 5, and 12 are obvious over U.S. Patent Publication No. 2006/0003740 (Ex. 1002, "Munje") in view of U.S. Patent No. 9,462,115 (Ex. 1003, "Rand") (Pet. at 21-52);
- Ground 2 alleges that claims 1, 5, and 12 are obvious over PCT Publication No. WO 03/015383 (Ex. 1004, "Bulthuis") and PCT Publication No. WO 2010/136997 (Ex. 1005, "Pelttari") (Pet. at 52-75).

D. Challenged Claims of the '028 Patent

Petitioner challenges claims 1, 5, and 12 of the '028 patent.

Claim	Limitation
1[pre]	1. An embeddable communications software module that allows a software application to access a communications system providing both time delayed and near real time communication, the embeddable communications software module stored in a non-transitory tangible computer readable storage medium,
1[a]	wherein the embeddable communications software module is arranged to:
1[b]	provide an application programming interface (API) that allows the embeddable communications software module to receive API inputs from the software application, the embeddable communication software module and the software application communicating through the API;

1[c]	receive an incoming message behavior policy from the software application, wherein the incoming message behavior policy controls how the embeddable communications software module responds to incoming messages;
1[d]	receive an incoming message from an remote communications device;
1[e]	progressively store the incoming message as it is received;
1[f]	in response to the received message, send a notification to the software application based on the incoming message behavior policy;
1[g]	selectively render the incoming message in a near real time mode, wherein the near real time mode involves progressively rendering the incoming message as it is received;
1[h]	selectively render the incoming message in a time-shifted mode, wherein the time shifted mode involves rendering the incoming message after the incoming message has been received and stored; and
1[i]	determine whether to render the incoming message in the near real time mode or the time-shifted mode based at least in part on the incoming message behavior policy,
1[j]	wherein the software application is separate from the communication system that is accessed through the embeddable communications software module.
5[pre]	5. An embeddable communications software module as recited in claim 1 wherein the embeddable communications software module is further arranged to:

5[a]	receive recipient identity information from the software application, the recipient identity information indicating an identity of a message recipient;
5[b]	record outgoing media created by a user;
5[c]	progressively transmit the outgoing media to remote device while the outgoing media is being created by the user wherein the message recipient of the outgoing media is identified by the recipient identity information received from the software application; and
5[d]	progressively store the outgoing media while the outgoing media is being created and transmitted.
12[pre]	12. An embeddable communications software module that allows a software application to access a communications system providing both time delayed and near real time communication, the embeddable communications software module stored in a non-transitory tangible computer readable storage medium wherein the embeddable communications software module is arranged to:
12[a]	provide an application programming interface (API) that allows the embeddable communications software module to receive API inputs from the software application, the embeddable communication module and the software application communicate through the API;
12[b]	receive recipient identity information from the software application, the recipient identity information indicating an identity of a message recipient;
12[c]	record outgoing media created by a user;

12[d]	progressively transmit the outgoing media to a remote communications device associated with the message recipient while the outgoing media is being created by the user, wherein the message recipient of the outgoing media is identified by the recipient identity information received from the software application; and
12[e]	progressively store the outgoing media while the outgoing media is being created and transmitted,
12[f]	wherein the software application is separate from the communication system that is accessed through the embeddable communications software module.

E. Overview of the Cited Art

1. Munje

Munje describes a push-to-talk (PTT) system for voice communications. Munje at Abstract. Munje's stated improvement on PTT is "automatically recording Push-To-Talk (PPT) voice communications for replay." *Id.* at [0007]. Munje primarily discusses recording incoming, rather than outgoing PTT voice signals. Munje does not provide any details for the timing of transmission or reception of messages, such as whether they are transmitted or received progressively.

Munje describes a mobile station 102 or 202 "which communicates through a wireless communication network 104." *Id.* at [0021]. Munje discloses that communications are performed by "a predetermined set of applications" on the mobile station. *Id.* at [0037] ("A predetermined set of applications which control

basic device operations, including at least data and voice communications applications, will normally be installed on mobile station 202 during its manufacture."); [0044] ("UE 302 is a terminal equipment (e.g. a mobile station) which includes PoC application client software, which includes functionality of the present application but otherwise utilizes conventional techniques.").

Munje does not discuss the internal software architecture of its networking application. So, for example, it does not disclose any constituent software modules contained inside the application, nor does it review any software libraries that are utilized by the application. Munje is similarly silent about any internal messaging system between software components, and does not disclose any type of API.

2. Rand

Rand is generally detected to a technique for improved audio mixing of digital voice communications. Rand at 1:55-60 ("It is therefore desirable to provide a system, architecture, and User Interface that is purpose designed for use cases where typical systems fails to provide the level of control and audio mixing functionality necessary for modes of communication in which voice is mixed with other audio signals in real time."). For example, Rand discusses continuously mixing a variety of audio sources so that digital voice communications can coexist with other audio. *Id.* at 2:33-37.

Petitioner relies on Rand solely as a combination reference for challenged claim elements relating to an API and receiving recipient identity information. Petition at 30-34; 45-47. However, Rand's teachings on both of these topics is scant. Rand remarks that "an SDK or APIs could be made for 3rd party developers to integrate with the software of this invention at their own will." *Id.* at 17:43-45. Rand also mentions that the "Application could integrate with third party VoIP and Audio Apps through an Application Programming Interface (API), Software Development Kit (SDK), or other means." *Id.* at 21:41-44. Notably, Rand's Figure 9A, relied upon by Petitioner, shows ***two different applications*** communicating with each other via an API:

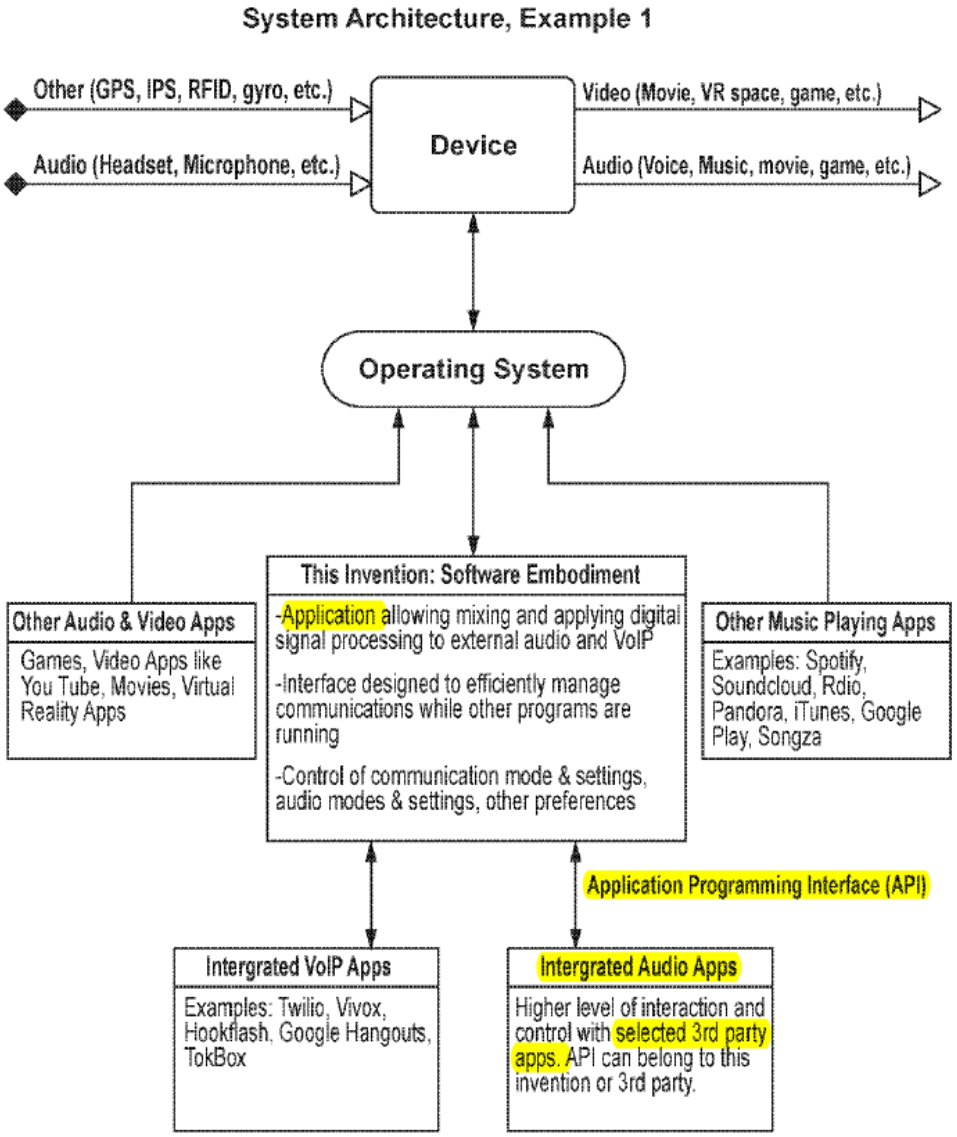

FIG. 9A

3. Bulthuis

Bulthuis describes a need to allow extra storage of voice calls made by existing mobile phones. Bulthuis at 8:24-25 ("The invention is especially relevant to users of mobile communication devices such as cell phones. Typically, when on the move, the user does not have the opportunity to both juggle the phone and write

down some piece of information that [the] other party is supplying via the phone in real-time."); 8:29-30 ("It is therefore advantageous for the user to be able to replay the conversation if and when needed.").

The solution that Bulthuis proposes to its recording problem is an additional, potentially external hardware storage device dedicated to recording voice data. *Id.* at 2:25-28 ("The device preferably has an onboard storage for storing the recorded communication. For example, the device has a solid state memory card/module or a HDD module with a small form factor that stores a copy of the communication or conversation conducted in real time."); 2:32-3:1 ("The device is connected via a wire or in a wireless fashion with the storage. For example, the device has a mobile telephone and the storage comprises a separate module that communicates with the mobile telephone using Bluetooth or another short-range communication protocol.").

4. Pelttari

Pelttari is generally directed to a voicemail system for automatically accepting incoming calls and recording them. *E.g.*, Pelttari at [0012] ("The present disclosure describes a recipient communication terminal, comprising a receiver configured to automatically identify and accept an incoming audio call over a telephony channel . . . and a recorder operatively coupled to the receiver and configured to automatically store said audio content in one or more content stores specific to said

category."). The incoming calls can also include certain "identification parameters." *Id.* ("said call including identification parameters relating to a category pertaining to content of said audio call"). The "identification parameters" can be interrogated using an API to glean more information. *Id.* at [0045] ("As an example, the category of the audio content is identified from the identification parameters using an API.").

III. LEVEL OF ORDINARY SKILL IN THE ART

A person of ordinary skill in the art ("POSITA") relevant to the '028 patent at the time of the invention would have at least (1) a Bdchelor's degree in electrical or computer engineering or a related course of study with at least two years of work experience in industry in the areas of computer networking, multimedia processing, or a related area of work or (2) a Master's degree in electrical or computer engineering or a related course of study, with at least one year of experience in industry in the areas of computer networking, multimedia processing, or a related area of work. More education can substitute for practical experience and vice versa.

The positions set forth in this preliminary response would be the same under either party's proposal for the level of ordinary skill in the art. *Cf.* Pet. at 4.

IV. CO-PENDING LITIGATION

The '028 patent has been at issue in district court litigation in the Western District of Texas for over fifteen months. *Voxer, Inc. and Voxer IP LLC v.*

Facebook, Inc. and Instagram LLC, Case No. 6:20-cv-00011 (W.D. Tex.) (the "Texas case"). Trial is set for January 18, 2022. Ex. 2002.[1]

V. CLAIM CONSTRUCTION

Claim terms in an IPR are "construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by" a POSITA and in view of the prosecution history. 37 C.F.R. § 42.100(b).

The '028 patent was already the subject of claim construction proceedings in the Texas case. The term "incoming message behavior policy" was construed as "received data indicating how the embeddable communications software module responds to incoming messages." Ex. 1008. The term "embeddable communications software module" was found not to be subject to § 112 ¶ 6, and was given its plain and ordinary meaning. *Id.* Finally, the preambles of claims 1, 5, and

[1] Petitioner contended that although "the district court and the parties have discussed a January 18, 2022 trial date, no order setting that as the trial date has issued." Pet. at 76. However, after the Petition was filed, the district court issued an order officially setting the trial date as January 18, 2022. Ex. 2002.

12 were construed to be limiting. *Id.* No other terms from the '028 patent were construed.

For purposes of this Response, Patent Owner has applied the plain meaning of all other claim terms. Patent Owner reserves its right to respond to any constructions proposed by Petitioner or the Board in the future, and to propose claim constructions.

VI. THE PETITION SHOULD BE DENIED UNDER § 314(a)

The precedential *Fintiv* decision identifies several factors that balance considerations of system efficiency, fairness, and patent quality when a Patent Owner raises an argument for discretionary denial due to the advanced state of a parallel proceeding. *Apple Inc. v. Fintiv, Inc*., IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020). These factors include:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;

2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;

3. investment in the parallel proceeding by the court and the parties;

4. overlap between issues raised in the petition and in the parallel proceeding;

5. whether the petitioner and the defendant in the parallel proceeding are the same party; and

6. other circumstances that impact the Board's exercise of discretion, including the merits.

Id.; *see also NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (considering an earlier trial date as a factor in favor of discretionary denial). The Board examines these factors, which relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution. *Fintiv*, IPR2020-00019, Paper 11 at 6, 9. In evaluating the factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review. *Id.*

The current state of the Texas case, as well as the tremendous investment in that case, favors denial of the Petition. Indeed, Petitioner waited ***almost twelve months*** after the complaint was filed to file their Petition. The validity of the challenged claims will be addressed in the Texas jury trial on January 18, 2022, ***six months*** before the Board issues its final written decision here. Further, Petitioner's final invalidity contentions rely on the same prior art cited in the Petition's grounds. Ex. 2003 (combination of Munje and Rand charted against the challenged claims); Ex. 2004 (combination of Bulthuis and Pelttari charted against the challenged claims). Accordingly, the district court will determine the validity of the challenged patent, based on the ***same*** grounds presented in this petition, many months before a final written decision in this IPR.

The parties have also spent considerable time and resources in the litigation. Petitioner has already served both preliminary and final invalidity contentions. The district court has issued a claim construction order after full briefing by the parties and a hearing. Patent Owner has produced over 300,000 pages in discovery, and Petitioner has produced over 400,000 pages. Fact discovery, expert discovery, dispositive motions, and the trial itself addressing the validity of the '028 patent will also have been completed in advance of the Board's final written decision. Therefore, instituting here, on the same invalidity arguments asserted against the same patent in the parallel district court litigation is contrary to the AIA's goal of providing for an effective and efficient means to resolve questions of validity. *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16-17 (PTAB Sept. 6, 2017).

A. Factor 1: No Court Has Granted a Stay Nor Has Any Party Sought One

Factor 1 favors discretionary denial. Petitioner does not argue that institution would result in a stay of the Texas case. Nor has Petitioner requested a stay. Even if Petitioner did seek a stay, at this late stage of the litigation, it would not likely be granted, given the significant time and resources expended on the litigation to date. Thus, in the absence of a motion to stay, this factor weighs in favor of denial or is, at worst, neutral. *See Fintiv*, IPR2020-00019, Paper 15, at 12 ("A judge determines

whether to grant a stay based on the facts of each specific case as presented in the briefs by the parties. We decline to infer, based on actions taken in different cases with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here."); *Supercell Oy v. Gree*, IPR2020-00215, Paper 10 at 9 (PTAB June 10, 2020) (Board finds factor neutral where the record "is silent as to whether the district court has granted a stay, or has commented on the possibility of a stay in this case.").

B. Factor 2: The District Court Case Is in an Advanced Stage

Factor 2 weighs in favor of discretionary denial. Precedent requires the Board to consider the "proximity of the court's trial date to the Board's projected statutory deadline for a final written decision" in the parallel proceeding. The trial date in the Texas case is currently set for January 18, 2022—***six months*** before the Board's Final Written Decision would issue if institution were granted. This fact alone weighs heavily in favor of denial. *See Fintiv*, IPR2020-00019, Paper 15, at 13, 17 (trial preceded Board decision by ***2 months***); *U.S. Venture, Inc. v. Sunoco Partners Marketing & Terminals L.P.*, IPR2020-00728, Paper 10 at 8-9 (PTAB Oct. 1, 2020) (finding that factor 2 favored denial where the trial date was not set but the Board estimated trial "some ***three or four months*** before we issue our final decision").

Further, the litigation is in advanced stages. Indeed, as already discussed, Petitioner waited ***almost twelve months*** after the complaint was filed before filing

this petition. The complaint was filed more than a year ago on January 7, 2020, and the Petition was filed one day short of a year later, on January 6, 2021. Since the filing of the complaint, the parties have exchanged multiple document productions and source code productions. Patent Owner has produced over 300,000 pages in discovery, and Petitioner has produced over 400,000 pages. Petitioner served preliminary invalidity contentions on July 1, 2020, more than ***nine months*** ago. Likewise, Petitioner served final invalidity contentions on January 14, 2021, more than ***six months*** before the institution decision deadline in this proceeding. Patent Owner also served final infringement contentions on January 14, 2021. The district court issued its claim construction order months ago as well, on October 29, 2020, after full briefing by the parties and a hearing. Ex. 1008. Thus, the litigation is significantly ahead of this IPR.

C. Factor 3: The Parties and the District Court Have Made a Substantial Investment in the Parallel Proceeding

Factor 3 weighs strongly in favor of discretionary denial. "[The] more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs." *Fintiv*, IPR2020-00019, Paper 11, at 10.

As already discussed, the parties and the district court will have already invested a substantial amount of time and effort in the parallel proceeding—including completing fact discovery, expert discovery, and preparing for and holding a jury trial—by the time the Board issues a final written decision in July 2022. Ex. 2002.

Likewise, as discussed with respect to Factor 2, the parties and the Court have already heavily invested in the district court case. The parties have exchanged multiple document productions and source code productions. Patent Owner has produced over 300,000 pages in discovery, and Petitioner has produced over 400,000 pages. Petitioner has served both its preliminary and final invalidity contentions. The parties have fully briefed and argued claim construction issues, and the Court has issued a *Markman* order.

Further, the obviousness case in the litigation is identical to the Petition. *See* Ex. 2003 (combination of Munje and Rand charted against the challenged claims in Petitioner's final invalidity contentions); Ex. 2004 (combination of Bulthuis and Pelttari charted against the challenged claims in Petitioner's final invalidity contentions). Thus, instituting the petition will be duplicative of the efforts already expended in district court, wasting time and resources.

D. Factor 4: The Issues and Arguments Raised in the Petition are The Same as Those in District Court

There is complete overlap between the claims and issues asserted here and in the district court.

In particular, this Petition presents the following three Grounds:

Ground	References	Basis	Challenged Claims
1	Munje in view of Rand	§103(a)	1, 5, 12
2	Bulthuis in view of Pelttari	§103(a)	1, 5, 12

All of these Grounds and references were also identified in Petitioner's invalidity contentions in the parallel district court proceeding. Specifically, Petitioner served an invalidity chart that charted Munje (as a primary reference) in combination with Rand (as a secondary reference) against the challenged claims. Ex. 2003. Petitioner also served an invalidity chart that charted Bulthuis (as a primary reference) in combination with Pelttari (as a secondary reference) against the challenged claims. Further yet, Petitioner cites to the ***same portions of the prior art*** in its invalidity contentions that Petitioner relies on in the Petition, thereby articulating the same arguments as the Petition as to why Munje, Rand, Bulthuis, and Pelttari allegedly render obvious all of the challenged claims before the Board here. *Compare* Petition at 21-52 (combination of Munje with Rand raised by Petitioner against claims 1, 5, and 12 of the '028 patent), *with* Ex. 2003 at 2-110 (combination of Munje with Rand raised by Petitioner against claims 1, 5, and 12 of

the ’028 patent); *compare* Petition at 52-75 (combination of Bulthuis with Pelttari raised by Petitioner against claims 1, 5, and 12 of the ’028 patent), *with* Ex. 2004 at 2-134 (combination of Bulthuis with Pelttari raised by Petitioner against claims 1, 5, and 12 of the ’028 patent).

Petitioner argues that the Petition should be instituted because it challenges claim 1, which is not asserted in the Texas case. Petition at 77. This argument is meritless. Indeed, dependent claim 5, which depends from claim 1, ***is*** asserted in the district court. Ex. 2005. In order to determine the invalidity of claim 5 in the district court, the jury must make a decision as to whether the prior art teaches or renders obvious each and every limitation of claim 1. Thus, Petitioner’s challenge of claim 1 does not raise any new issues. *Fintiv*, Paper 11 at 13 (“The existence of non-overlapping claim challenges will weigh for or against exercising discretion to deny institution under *NHK* ***depending on the similarity of the claims challenged*** in the petition to those at issue in the district court.”); *Vizio, Inc. v. Polaris PowerLED Technologies, LLC*, IPR2020-00043, Paper 30 at 10-11 (PTAB May 4, 2020) (“Petitioner has not provided argument as to why the additional challenges to the dependent claims in the Petition provide a meaningful distinction between the two proceedings.”); *see also Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00961, Paper 10 at 14 (PTAB Oct. 16, 2019) (***none*** of the challenged claims were asserted in the co-pending litigation).

Additionally, Petitioner has not stipulated to withdraw any reference or combination of references cited in the Petition from the parallel district court litigation. This strongly favors discretionary denial because the same invalidity issues would continue to be litigated here and in the district court, and distinguishes this case from others where the withdrawal of invalidity arguments in district court was found to favor institution. *Cf. Sand Revolution II, LLC v. Continental Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 11-12 (PTAB June 16, 2020); *Apple Inc. v. Maxell, Ltd.*, IPR2020-00204, Paper 11 at 15-17 (PTAB June 19, 2020).

E. Factor 5: Petitioner and Defendant are the Same Party

Petitioner is the same party as the defendant in the district court litigation. Accordingly, this factor weighs in favor of denial, especially in light of the other factors.

F. Factor 6: Other Considerations Weigh in Favor of Denial

No other compelling circumstances support institution. The specific factors addressed above each weigh strongly in favor of denial of institution under §314(a) and in line with *NHK Spring*, as discussed above. As such, any balancing of these factors demonstrates that efficiency and integrity of the AIA are best served by denying review. *Fintiv*, IPR2020-00019, Paper 11, at 6. And no other circumstances that impact the Board's exercise of discretion under §314(a) demonstrate otherwise.

Indeed, the merits of the grounds asserted in the instant Petition are far from strong, for the reasons discussed further in this preliminary response. Nevertheless, even where "the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present." *Fintiv*, IPR2020-00019, Paper 11, at 15; *E-One, Inc. v. Oshkosh Corp*., IPR2019-00162, Paper 16 at 8, 13, 20 (PTAB June 5, 2019) (denying institution based on earlier district court trial date, weakness on the merits, and the district court's substantial investment of resources considering the invalidity of the challenged patent).

In particular, the district court case is unlikely to be delayed due to the COVID-19 pandemic. Indeed, even before any COVID-19 vaccines were approved, the Court did not delay the trial. The FDA has since approved multiple COVID-19 vaccines with effectiveness rates around 95%. Ex. 2006. Texas has already administered over 17.4 million vaccine doses. Ex. 2007. The district court case is currently set for trial in January 2022. Ex. 2002. Thus, the trial will take place many months after the general population will have been vaccinated against the virus. Petitioner has cited no evidence that the trial will be delayed in these circumstances, let alone evidence that the trial will be delayed more than six months necessary to take it beyond the final written decision period. Petitioner has also cited

no evidence supporting its conclusory assertion that the COVID-19 virus will delay trials on the 2022 docket.

For all of these reasons, the facts of this case—like those in *NHK Spring* (and its progeny)—support the conclusion that "[i]nstitution of an inter partes review under these circumstances would not be consistent with 'an objective of the AIA … to provide an effective and efficient ***alternative*** to district court litigation.'" *NHK Spring*, IPR2018-00752, Paper 8, at 20 (emphasis added) (quoting *General Plastic*, IPR2016-01357, Paper 19, at 16-17); *Fintiv*, IPR2020-00019, Paper 11, at 6. The Board should deny institution under §314(a).

VII. THE PETITION FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD THAT CLAIMS 1, 5, OR 12 ARE OBVIOUS BASED ON MUNJE IN VIEW OF RAND (GROUND 1)

Even if the Board declines to exercise its discretion to deny institution, institution should nevertheless be denied because even when combined, Munje and Rand fail to teach four critical limitations of challenged claims 1, 5, and 12. In particular, the proposed combination fails to disclose an embeddable communications software module (claims 1, 5, and 12), using an API for communication between the embeddable communications software module and a software application (claims 1, 5, and 12), progressively transmitting outgoing media while the media is being created (claims 5 and 12), and progressively rendering an incoming message as it is received (claims 1 and 5).

A. The Combination of Munje and Rand Fails to Disclose or Render Obvious an Embeddable Communications Software Module

All of the challenged claims require an "embeddable communications software module." The embeddable communications software module must, among other things:

- "allow[] a software application to access a communications system" (claims 1 and 12);
- "provide an application programming interface (API) that allows the embeddable communications software module to receive API inputs from the software application" (claims 1 and 12);
- "receive an incoming message behavior policy from the software application" (claim 1);
- "send a notification to the software application based on the incoming message behavior policy" (claim 1); and
- "receive recipient identity information from the software application" (claims 5 and 12).

Of note, the claimed embeddable communications software module is not co-extensive with the claimed software application. *See, e.g.*, '028 patent at 3:10-12 ("[T]he present application pertains to an embeddable software communications module. The module can be embedded in a wide variety of software applications.");

3:62-67 ("[T]he company has embedded an embeddable software communications software module (not shown) into its software applications. The module allows the devices 104*a*/104*b* and software applications 102*a*/102*b* to access the telecommunication and media management system 100."). And as reviewed above, the challenged claims include limitations about communication between the embeddable communications software module and the software application. Thus, citations or argument that tend to show the existence or operation of a software ***application*** do not necessarily show the existence or operation of a claimed embeddable communications software ***module***.

Petitioner only identifies Munje as disclosing an embeddable communications software module. Pet. at 21-28. Petitioner does not allege that Rand discloses this limitation, nor does Petitioner allege that Munje renders the limitation obvious.

It is beyond dispute that the Petition fails to establish that Munje discloses an embeddable communications software module. To merit institution, the statute requires that "the petition identif[y], in writing and ***with particularity***, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim . . . ." 35 U.S.C. § 312(a)(3) (emphasis added). Moreover, "[t]he petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon." 37 C.F.R. § 42.104(b)(4). The Petition does not satisfy those requirements.

As an initial matter, Petitioner has not even sufficiently identified what it contends are the particular claimed "embeddable communications software module" and the particular claimed "software application" in Munje. *See generally* Pet. at 21-28; *see id.* at 22 (vague statement that "this mobile station can be implemented with software modules"); 25 (vague statement that "such a user interface can be implemented with a software application"); 26 (mentioning "various third-party and integrated software applications" but none that would communicate with the claimed embeddable communications software module). Petitioner alleges that "this described method" can "constitute a software module or modules," Pet. at 23, but fails to describe the structure or organization of any such module, including how it would qualify as a claimed "embeddable communications software module" that meets the other claim requirements.

Additionally, none of Petitioner's citations to portions of Munje relate to the claim limitation. Petitioner cites to its expert declaration, but that material simply mirrors the content of the Petition with no additional explanation. Ex. 1006 ¶¶ 86-98. Petitioner cites to paragraphs [0007], [0013], and [0051-55] of Munje, Pet. at 21-22, yet nothing in those paragraphs relates to the internal organization of Munje's software. Petitioner points to Figure 4 of Munje, Pet. at 22, but that figure is "a schematic block diagram ***of pertinent electrical components*** for the automatic recording of PTT voice communications for replay in the mobile station of FIGS. 1-

2." Munje at [0013] (emphasis added). Nothing in Figure 4 relates to the internal organization of Munje's software (as opposed to, for example, "electrical components"). Petitioner next raises Figure 6, Pet. at 22-23, but that figure "is a ***flowchart*** for describing a method of automatically recording PTT voice communications for replay in a mobile station." Munje at [0015] (emphasis added). Nothing in Figure 6 relates to the internal organization of Munje's software (as opposed to, for example, a sequence of steps performed by Munje's sole disclosed software application). Petitioner cites to general material about communications, Pet. at. 24, but does not even attempt to show how the cited material relates to communications performed by an embeddable communication software module (as opposed to Munje's sole software application). Last, Petitioner attempts to establish that there is some unspecified module that may be "embedded" by citing to Munje at [0066] ("[T]he method may be embodied in a computer program product which includes a storage medium (e.g. computer disk or memory) and computer instructions stored in the storage medium."). But that paragraph simply confirms that Munje's technique are implemented in a ***software application***, not an ***embeddable communications software module***. *Id.* ("computer program product"). Plus, a generalized statement that code can be stored on disk does not disclose the particular structure and organization of an embeddable communications software module. The Petition contains no analysis whatsoever for how any of these cited

sections could show an embeddable communications software module in Munje. *See generally* Pet. at 21-24.

These citations reviewed above are the full extent of the Petition's efforts to show the presence of an embeddable communications software module in Munje. There is a complete failure of proof. Confirming that the Petition has improperly short-circuited this portion of the invalidity analysis, where the Petition discusses the various other claim elements that specify what the ***embeddable communications software module does***, the Petition instead cites to material describing what ***Munje's client software application does***. *E.g.*, Pet. at 24-28. The Petition consistently conflates the two.

Moreover, contrary to Petitioner's contention, Munje does not disclose an embeddable communications software module. Munje only describes the operation of a single relevant communications application running on a mobile device. Munje at [0044] ("UE 302 is a terminal equipment (e.g. a mobile station) which includes PoC application client software, which includes functionality of the present application but otherwise utilizes conventional techniques."); [0037]. Munje does not discuss the internal software architecture of its networking application. So, for example, it does not disclose any constituent software modules contained inside the application, nor does it review any software libraries that are utilized by the application.

B. The Combination of Munje and Rand Fails to Disclose or Render Obvious Providing an API for Communications Between the Embeddable Communications Software Module and the Software Application

Claim 1 contains the limitation "provide an application programming interface (API) that allows the embeddable communications software module to receive API inputs from the software application, the embeddable communication software module and the software application communicating through the API." Claim 12 contains the similar limitation "provide an application programming interface (API) that allows the embeddable communications software module to receive API inputs from the software application, the embeddable communication module and the software application communicate through the API." Petitioner's position on the limitation in the context of claim 12 relies on its analysis from claim 5. Pet. at 50. However, the combination of Munje and Rand fails to disclose or render obvious these limitations.

Petitioner argues that Munje discloses this limitation, Pet. at 28-29, but this does not appear to be a serious argument, since none of the material cited by Petitioner from Munje has any relationship to the claim limitation. Moreover, Munje has no discussion whatsoever of any communication between software components on the same device, much less an API. This is not surprising since Munje only discloses a single relevant communications software application, which does not

need to internally communicate with any other software component on the same device. *E.g.*, Munje at [0044] (single "application client software . . . includes the functionality of the present [patent] application"). Munje clearly does not disclose the limitation.

Petitioner next argues that the limitation would have been obvious because "[a]n API was a commonly used mechanism to integrate multiple software components, and the use of APIs to do so was regular industry practice long before the *Munje* disclosure." Pet. at 29. The Board should reject Petitioner's invitation to read this element out of the challenged claims in such a cursory manner. First, Petitioner has not established that APIs were "commonly used" or in "regular industry practice." Its expert declaration contains no corroborating analysis and merely parrots the Petition. Ex. 1006 ¶ 101. Petitioner cites no other evidence or exhibits in support of this proposition. Second, Petitioner's motivation to combine is insufficient. "Common use" and "regular industry practice" do not necessarily imply that a skilled artisan would have a meaningful reason to alter the system of Munje or that a skilled artisan could have accomplished the modification with a reasonable expectation of success. Third, since Munje does not contain "multiple [communications] software components," even Petitioner's cited motivation would not have led a skilled artisan to alter Munje's system. Fourth, it is legally improper to find an element obvious without identifying it in ***some*** prior art reference. *See*

K/S Himpp v. Hear-Wear Techs., LLC, 751 F.3d 1362, 1365 (Fed. Cir. 2014) (explaining that "obviousness" "require[s] record evidence to support an assertion that [the claimed] structural features . . . were known prior art elements," and that "an assessment of basic knowledge and common sense as a replacement for documentary evidence for core factual findings lacks substantial evidence support").

Petitioner further argues that Rand discloses the API limitation and that Munje could have been combined with Rand to render the limitation obvious. Petition at 30-34. The Board should reject this argument as well.

First, as noted above, Munje is utterly silent on any internal communication between different software components residing on the same device. There is only one described communications software component—the client application that contains all of Munje's communications functionality. Munje at [0037], [0044]. Thus, all of Petitioner's cited motivations to combine Rand with Munje (same field of endeavor, same problem, similar solutions, Pet. at 31-33) are beside the point. There is no advantage to adding an API-based software component-to-software component communications system to Munje, because there are no internal communications in Munje at all. None of Petitioner's cited motivations address any advantages to modifying Munje to add communications between internal software components. Indeed, given the lack of existing internal communications in Munje, adding an extensive and heavyweight API interface to Munje would take

considerable time, effort, and money, and would only result in a system with more complexity but the same functionality. A person of ordinary skill in the art would not be motivated to alter Munje like that.

Second, Rand does not actually disclose the claimed API limitation. Petitioner's only citations to Rand are to Figure 9A and 21:38-46. Pet at 32-33. But notably, these sections of Rand discuss ***one independent application communicating with another via an API***, not an application communicating with an embedded software module inside the application via an API, as claimed. *See* Rand at Fig. 9A (box described as "Application" connected to another box labeled "Intergrated Audio Apps" via "Application Programming Interface (API)"); 21:38-46 ("***The Application*** could integrate with ***third party VoIP and Audio Apps*** through an Application Programming Interface (API), Software Development Kit (SDK), or other means.") (emphasis added). Notably, Petitioner does not contend that Rand discloses an embeddable communications software module. Patent Owner agrees that Rand does not disclose such a module. In particular, Rand has no disclosure of using an API for anything more than arms-length communication between two peer applications. Nothing in Petitioner's analysis of this limitation addresses this defect in Rand. *See generally* Pet. at 28-34.

Hence, neither Munje alone, nor Munje in view of "regular industry practice," nor Munje in combination with Rand, disclose or render obvious the claim limitation.

C. The Combination of Munje and Rand Fails to Disclose or Render Obvious Progressive Transmission as the Outgoing Media Is Created (Claims 5 and 12)

Claims 5 and 12 each require progressive transmission of outgoing media as the media is created. '028 patent at cl. 5 ("progressively transmit the outgoing media to remote device while the outgoing media is being created by the user"); cl. 12 ("progressively transmit the outgoing media to a remote communications device associated with the message recipient while the outgoing media is being created by the user."). However, the Petition does not establish that these limitations are met or rendered obvious by the combination of Munje and Rand.

Petitioner only identifies Munje as disclosing these limitations. Pet. at 48-49, 51-52. Petitioner does not allege that Rand discloses this limitation, nor does Petitioner allege that Munje renders the limitation obvious. Petitioner's assertion that Munje discloses the "progressive transmission" is conclusory, based primarily on citations to an expert declaration. It is also mistaken.

Petitioner's citations to Munje are inapposite. Petitioner cites Munje at [0074]: "Upon PTT button depression, the processor causes the voice data of the PTT voice transmission to be stored in the memory simultaneously with its

transmission." Pet. at 48. Petitioner also cites Munje at [0049]: "End users may initiate PoC talk sessions." Pet. at 48. Neither of these citations relate to the claim requirements to "progressively transmit the streaming media over a network as the streaming media is created." Neither citation addresses the form of the transmission—whether it is progressive or not. Additionally, the citation to [0074] is about the relationship between ***storage*** and ***transmission***, not the claimed relationships between ***transmission*** and ***media creation***. Storage and creation are not the same thing, and are explicitly distinguished in the claims. '028 patent at cl. 5 ("progressively store the outgoing media while the outgoing media is being created and transmitted"); cl. 12 (same). [0074] of Munje does not relate to progressive transmission of media as the media is created. Indeed, nothing in the cited sections of Munje does. For example, nothing compares the time that media is created or recorded to the time that it is transmitted. Additionally, Petitioner's expert declaration contains no additional material or analysis relating to this limitation. Ex. 1006 at ¶ 142-44. Moreover, Petitioner does not allege that there is anything inherent in PTT or PoC that would require progressive transmission as the outgoing media is created.

It is Petitioner's burden to identify, "in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim." 35 U.S.C. §

312(a)(3); 37 C.F.R. § 42.104(b)(4)-(5). As stated by the Federal Circuit, "[i]t is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify '***with particularity***' the 'evidence that supports the grounds for the challenge to ***each claim***.'" *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (emphasis added). Here, Petitioner purports to rely on Munje for the "progressive transmission" limitations, but has failed to identify "with particularity . . . the evidence that supports the grounds" that Munje discloses the claim limitations. This is a sufficient reason to deny the Petition by itself.

Even beyond the failure of Petitioner and its expert to even plausibly allege that the "progressive transmission" limitations are disclosed by Munje, the reference itself demonstrates that it does not disclose progressive transmission of streaming media as the media is created. There are several indications in Munje that voice data is not progressively transmitted as it is created. Munje describes sending "talk bursts" of voice traffic rather than a progressive stream. *See, e.g.*, Munje at [0047] ("The protocols over an It interface support the transport of talk bursts, floor control, and link quality messages between UE 302 and PoC Server 304."). And when Munje describes the behavior of the system when the PTT button is depressed, Munje only discusses storing voice data when it is transmitted, but never suggests that the voice data is transmitted progressively as it is created. *E.g.*, *id.* at [0074] ("Upon PTT

button depression, the processor causes the voice data of the PTT voice transmission to be stored in the memory simultaneously with its transmission.").

Additionally, because Munje's alleged invention is focused on the replay of received messages, Munje almost exclusively describes the behavior of a receiving device, rather than a transmitting device. *E.g.*, Munje at [0020] ("a PTT replay switch for replaying a PTT voice communication previously received through the wireless transceiver"), *id.* ("Advantageously, PTT voice communications may be replayed in the event that the end user of the mobile station fails to initially hear such communication."). It is thus no surprise that there is no description in Munje of how the timing of creation of outgoing voice messages relates to the timing of their transmission. Indeed, the sole description of Munje's alleged replay invention being used with outgoing messages is found in paragraph [0074], which Petitioner cites to, but which does not relate to the claim requirement.

In sum, Petitioner has essentially ignored the limitations of claims 5 and 12 regarding progressive transmission of the outgoing media as the outgoing media is created. Neither the cited material, nor any other material from Munje disclose the limitations. Petitioner's expert has no additional analysis or evidence pertinent to the limitations. Petitioner does not rely on any obviousness theory, or any other reference for the limitations. Petitioner does not even argue that the limitations are inherent in Munje. Institution should be denied on this basis alone.

D. The Combination of Munje and Rand Fails to Disclose or Render Obvious Progressively Rendering an Incoming Message as It Is Received (Claims 1 and 5)

Claim 1 contains the limitation "selectively render the incoming message in a near real time mode, wherein the near real time mode involves progressively rendering the incoming message as it is received." Claim 5 depends from claim 1. Petitioner relies solely on Munje to disclose this limitation. Pet. at 40. Petitioner does not allege that Rand discloses this limitation, nor does Petitioner allege that Munje renders the limitation obvious.

The entirety of Petitioner's argument for why Munje discloses this limitation is that it "allows for conventional PTT voice communications processing during which audible voice is heard from the speaker of the mobile station" and it discloses "the conventional listening of voice." Pet at 40 (citing Munje at [0068] and [0054]). Petitioner's expert declaration has no additional analysis or material of any kind. Ex. 1006 ¶ 121.

The cited material from Munje does not disclose that the incoming message is progressively rendered as it is received; at most, it suggests that ***after*** the message has been received, it is played back at some later time. There is simply no disclosure in Munje of the claimed progressive rendering of an incoming message as it is received. To the contrary, Munje discusses sending and receiving "talk bursts" rather than a progressive stream. Munje at [0047] ("The protocols over an It

interface support the transport of talk bursts, floor control, and link quality messages between UE 302 and PoC Server 304."). Thus, Petitioner has failed to plausibly allege that this claim limitation is met, and the IPR should be denied on this basis alone. *See, e.g.*, *Microsoft Corp. v. Michael Philip Kaufman*, IPR2017-01141, Paper 7, at 14-16 (PTAB Oct. 4, 2017) (denying institution where Petitioner "has not explained persuasively" how the cited references meet a claim limitation).

Accordingly, Petitioner fails to show that the combination of Munje and Rand discloses at least four limitations of the challenged claims. Ground 1 should be denied.

VIII. THE PETITION FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD THAT CLAIMS 1, 5, OR 12 ARE OBVIOUS BASED ON BULTHUIS IN VIEW OF PELTTARI (GROUND 2)

Even when combined, Bulthuis and Pelttari fail to teach at least two limitations of challenged claims 1, 5, and 12. In particular, the proposed combination fails to disclose an embeddable communications software module (claims 1, 5, and 12) or using an API for communication between the embeddable communications software module and a software application (claims 1, 5, and 12).

A. The Combination of Bulthuis and Pelttari Fails to Disclose or Render Obvious an Embeddable Communications Software Module

All of the challenged claims require an "embeddable communications software module." The embeddable communications software module must also

meet several other claim requirements relating to communicating with a host software application. *See* Section VII.A above. Of note, the claimed embeddable communications software module is not co-extensive with the claimed software application. *See, e.g.*, '028 patent at 3:10-12; 3:62-67; Section VII.A above. Thus, citations or argument that tend to show the existence or operation of a software ***application*** do not necessarily show the existence or operation of a claimed embeddable communications software ***module***.

Petitioner only identifies Bulthuis as disclosing an embeddable communications software module. Pet. at 53-55. Petitioner does not allege that Pelttari discloses this limitation, nor does Petitioner allege that Bulthuis renders the limitation obvious.

Petitioner's invalidity theory for this limitation is fatally flawed because Petitioner points to a ***hardware*** "module" described in Bulthuis that ***is used exclusively for data storage*** as meeting this limitation. Pet. 53 (citing Bulthuis at 4:20-30 and 2:8-9). Bulthuis is crystal clear that the "module" is an internal or external specialized storage hardware:

> An implementation of the invention uses a module with a storage for coupling with the communication device for enabling recording of the real time communication. The module is coupled galvanically, electrically or in a wireless manner with the device. Preferably, the module is controllable via a user-interface of the device. For example,

> a certain key or pattern of keys is reserved for user-interaction with the module to implement, e.g., scrolling through the communication stored on the module, or replaying the communication most recently recorded, or to activate the recording during a real time communication upon a user input. The module preferably, comprises at least one organizational mechanism for organizing the recorded communications in a retrievable form for the user. The module preferably comprises an opt-out mechanism adapted to exempt a particular communication from recording.

Bulthuis at 4:20-30. Bulthuis provides further detail about the storage module:

> The recording can, but need not, be made at the device itself. For example, c cell phone can be equipped with a recording component comprising, e.g., a flash memory card or a hard disk drive unit (HDD) with a small form-factor. The recording component can be accommodated in the cell phone or can be made a separate module that is galvanically or wirelessly coupled with the communication device. In the latter case, the module preferably uses a short-range communication protocol, e.g., Bluetooth. The recording components as a separate module can be an after-market add-on. Play-out of the recording can be through the loudspeaker of the cell phone, of a laptop PC or through another loudspeaker, e.g. the stereo system of the user's car using a suitable connection. Alternatively, the module can be equipped with its own loudspeaker.

Id. at 8:31-9:6; *see also id.* at cl. 15 ("15. For use with a consumer electronic communication device that enables real-time communication via the device: a

module with a storage for coupling with the device for enabling automatic recording of the real time communication."); 2:25-29 ("The device preferably has an onboard storage for storing the recorded communication. For example, the device has a solid state memory card/module or a HDD module with a small form factor that stores a copy of the communication or conversation conducted in real time. The module is preferably removable and useable with, e.g., a laptop or desktop PC."); 2:33-3:3 ("For example, the device has a mobile telephone and the storage comprises a separate module that communicates with the mobile telephone using Bluetooth or another short-range communication protocol. The storage module can be kept in a suitcase or carried in another convenient place, so that the weight or shape does not interfere or hamper usage of the phone.").

This is the only "module" of any sort disclosed in Bulthuis, and it is the precise thing that Petitioner points to as purportedly being the claimed "embeddable communications software module" required by the challenged claims of the '028 patent. Pet. at 53-55. But Bulthuis' storage hardware module cannot meet the claim limitation.

First, the claimed "embeddable communications software module" is a ***software*** module, not a ***hardware*** module like in Bulthuis. *See, e.g.*, '028 patent at 5:1-9 ("Embedded within the software application is an embeddable communications software module 204. The embeddable communications software

module 204 is distinct software module that manages some or all of the aforementioned communications features . . . . The module 204 may be precompiled software, source code and/or any suitable type of software."). The software nature of the module is reflected in other claim limitations, such as the limitations related to an API. The invention of the '028 patent relates to dividing up software functionalities between a software application and an embeddable communications software module on the same device, not to migrating software functionality to hardware or moving functionality off the main device into a separate appliance. In general, both the Petition and its expert declaration are silent about how Bulthuis' hardware storage module could meet this limitation. Perhaps the closest that the Petition comes is arguing that Bulthuis' hardware storage module is stored in a non-transitory computer readable storage medium. Pet. at 55. But the portion of Bulthuis cited by Petitioner, 4:31-5:3 ***describes the software application software running on the cell phone***. It does not relate to any operating code for the storage peripheral. It does not describe any internal organization or structure of Bulthuis' software.

Second, even assuming for the sake of argument that the routines described at 4:31-5:3 are run by the hardware storage module, the code is described as being strictly limited to "detecting initiation or acceptance of a live communication by a user of a consumer electronics communication device; and recording the live

communication." Bulthuis at 4:32-34. This does not disclose the full range of functionality that the challenged claims require the embeddable communications software module to have, including essentially every limitation of the challenged claims except arguably "progressively store the incoming message as it is received." Confirming that the Petition has improperly short-circuited this portion of the invalidity analysis, where the Petition discusses the various other claim elements that specify what the ***embeddable communications software module does***, the Petition instead cites to material describing what ***Bulthuis' client software application does***. *See generally* Pet. at 55-75. The Petition consistently conflates the two.

B. The Combination of Bulthuis and Pelttari Fails to Disclose or Render Obvious Providing an API for Communications Between the Embeddable Communications Software Module and the Software Application

Claim 1 contains the limitation "provide an application programming interface (API) that allows the embeddable communications software module to receive API inputs from the software application, the embeddable communication software module and the software application communicating through the API." Claim 12 contains the similar limitation "provide an application programming interface (API) that allows the embeddable communications software module to receive API inputs from the software application, the embeddable communication module and the software application communicate through the API." However, the

combination of Bulthuis and Pelttari fails to disclose or render obvious these limitations.

Petitioner argues that Bulthuis alone discloses this limitation, Pet. at 55-56. However, none of the material cited by Petitioner from Bulthuis has any relationship to the claim limitation. Moreover, Bulthuis has no discussion whatsoever of any communication between software components on the same device, much less an API. Petition cites to Bulthuis' statement that "the module is controllable via a user-interface of the device," Bulthuis at 4:23, but this does not indicate that the control is performed via an API. Bulthuis does not disclose the limitation.

Petitioner next argues that the limitation would have been obvious because "[a]n API was a commonly used mechanism to integrate multiple software components, and the use of APIs to do so was regular industry practice long before the *Munje* disclosure." Pet. at 57. The Board should reject Petitioner's invitation to read this element out of the challenged claims in such a cursory manner. First, Petitioner has not established that APIs were "commonly used" or in "regular industry practice." Its expert declaration contains no corroborating analysis and merely parrots the Petition. Ex. 1006 ¶ 166. Petitioner cites no other evidence or exhibits in support of this proposition. Second, Petitioner's motivation to combine is insufficient. "Common use" and "regular industry practice" do not necessarily imply that a skilled artisan would have a meaningful reason to alter the system of

Bulthuis or that a skilled artisan could have accomplished the modification with a reasonable expectation of success. Third, since Bulthuis does not contain "multiple software components," even Petitioner's cited motivation would not have led a skilled artisan to alter Bulthuis' system. Fourth, it is legally improper to find an element obvious without identifying it in ***some*** prior art reference. *See K/S Himpp v. Hear-Wear Techs., LLC*, 751 F.3d 1362, 1365 (Fed. Cir. 2014) (explaining that "obviousness" "require[s] record evidence to support an assertion that [the claimed] structural features . . . were known prior art elements," and that "an assessment of basic knowledge and common sense as a replacement for documentary evidence for core factual findings lacks substantial evidence support").

Petitioner further argues that Pelttari discloses the API limitation and that Bulthuis could have been combined with Pelttari to render the limitation obvious. Petition at 57-59. The Board should reject this argument as well. Pelttari does not actually disclose the claimed API limitation. Petitioner's only citations to Pelttari are [0045], [0076], [0102], and [0115]. Pet. at 57. Neither the cited material, nor anywhere else in Pelttari, disclose the claimed API.

First, Pelttari has no disclosure of ***what specific software component*** hosts the API. Instead, Pelttari has vague statements that amount to saying that an API could be used. Pelttari does not describe the API as being located anywhere more precise than "the system." Pelttari at [0102]. Thus, Pelttari fails to disclose the full

claim requirement of an embeddable communications software module providing an API that allows the embeddable communications software module to receive API inputs from the software application. There is no distinct "software application" or "embeddable communications software module" described in Pelttari.

Second, Pelttari describes the API as being limited to a very specific purpose, to look up "the category of the audio content" from the "identification parameters" transmitted in a voice message in Pelttari. *Id.* at [045]; *see also id.* at [0077] (same); [0102] (same); [0076] (similar; mapping identification parameters to "services"). This purpose does not match any claim limitation of the '028 patent challenged claims, nor does Petitioner even attempt to argue that it does. So, at best, Pelttari discloses an API used for a different purpose than claimed in the '028 patent. And Petitioner fails to bridge the gap or explain how Pelttari's API would be adapted for use in Bulthuis' system to yield the challenged claims. Pet. at 57-59.

Hence, neither Bulthuis alone, nor Bulthuis in view of "regular industry practice," nor Bulthuis in combination with Pelttari, disclose or render obvious the API claim limitation. And Ground 2 as a whole fails because the combination of Bulthuis and Pelttari does not disclose or render obvious at least the embeddable communications software module and API limitations.

IX. CONCLUSION

A trial before the Board will not serve as an "efficient alternative" to the Texas district court litigation, but will simply be a duplicative proceeding that wastes the Board's resources and creates a risk of the Board and the district court reaching inconsistent determinations on the same arguments. Discretionary denial is appropriate.

Date: April 27, 2021

Respectfully submitted,

By: /s/ *James M. Glass*
James M. Glass

Lead Attorney for Patent Owner
Voxer IP, LLC

CERTIFICATE OF COMPLIANCE

I hereby certify that this paper complies with the type-volume limitation of 37 C.F.R. § 42.24 because it contains 11,000 words, excluding the parts of the paper exempted by 37 C.F.R. § 42.24(b).

By: /s/ *James M. Glass*
James M. Glass
Registration No. 46,729

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certify that PATENT OWNER'S PRELIMINARY RESPONSE, and all exhibits and other documents filed together with the preliminary response, were served on April 27, 2021 by e-mailing copies to counsel for Petitioner at FBVoxerIPR-KVP@keker.com.

Date: April 27, 2021

/s/ *Gavin Snyder*
Gavin Snyder