UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD. and SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioners

v.

MOBILE DATA TECHNOLOGIES LLC,

Patent Owner

IPR2025-00536
U.S. Patent No. 9,032,039

PATENT OWNER'S PRELIMINARY RESPONSE
35 U.S.C. § 313, and 37 C.F.R. § 42.107(a)

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2001	E-mail serving amended infringement contentions in EDTX-Litigation
2002	Comparison between the specifications of the '039 and '801 Patents
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2004	Reserved
2005	Reserved
2006	E-mail from the Board regarding the 535 and 536 IPR panel assignments (May 2, 2025)
2007	Reserved
2008	E-mail from Erick S. Robinson memorializing the phone conversation with Petitioners' counsel (September 26, 2024)
2009	Reserved
2010	Reserved
2011	Reserved
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2013	E-mail exchange between Erick S. Robinson and Petitioners' counsel regarding a stay (October 17, 2024)
2014	E-mail exchange between Erick S. Robinson and Petitioners' counsel regarding a stay (February 19, 2025)
2015	E-mail exchange between Erick S. Robinson and Petitioners' counsel wherein Petitioners shared their motion to stay with Patent Owner (March 4, 2025)
2016	Second Amended Docket Control Order in the EDTX-Litigation (December 19, 2024)
2017	United States District Courts — National Judicial Caseload Profile (September 30, 2024)
2018	E-mail from Petitioners' counsel serving their initial and additional disclosures (October 16, 2024)
2019	E-mail from Petitioners' counsel serving their invalidity contentions (January 31, 2025)
2020	E-mail from Petitioners providing materials produced by third-party Microsoft Corporation and Sybase, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (April 25, 2025)
2021	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (March 7, 2025)

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2022	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 24, 2025)
2023	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 21, 2025)
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2029	E-mail from Petitioners' counsel with a draft of a proposed communication to the Board (April 30, 2025)
2030	E-mail from Petitioners' counsel with sharing with Patent Owner their proposed *Sotera* stipulation (April 18, 2025)
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2032	Petitioners' proposed *Sotera* stipulation for '535 and '536 IPRs (April 18, 2025)
2033	Petitioners' claim chart against '039 Patent based on the Nokia 9210 System (January 31, 2025)
2034	Reserved
2035	Summary of verbatim (or nearly verbatim, strikethrough added) matches between the '536 petition to the Houh Declaration (Ex.1003)
2036	E-Mail from Petitioners providing Casio America, Inc.'s declarations certifying business records in response to Petitioners' subpoena in the EDTX-Litigation (May 9, 2025)
2037	Joel West & David Wood, *EVOLVING AN OPEN ECOSYSTEM: THE RISE AND FALL OF THE SYMBIAN PLATFORM* (2013)
2038	Bradston Henry, *Multiplayer Server Basics | Creating a Multiplayer Game Server - Part 1* (Oct. 25, 2021),

Ex.	Description
	https://dev.to/ibmdeveloper/multiplayer-server-basics-ep-1-creating-a-multiplayer-game-server-5aed
2039	Declaration of George Edwards in Regard to the Petitions for *Inter Partes* Review of U.S. Patent No. 9,032,039
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2041	Declaration of Mahdi Eslamimehr for IPR2025-00536 of U.S. Patent No. 9,032,039
2042	File History of Ex Parte Reexamination of U.S. Patent 8,793,336

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107(a), Mobile Data Technologies, LLC ("Patent Owner" or "MDT") submits this Preliminary Response to the Petition for *Inter Partes* Review ("IPR") of U.S. Patent No. 9,032,039 (the "'039 Patent"), filed by Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, "Petitioners"), challenging claims 1-4, 8-9, 13-15, 17-19, 22-25, and 28-30 (the "Challenged Claims") of the '039 Patent. Paper 4, 2 ("'536 IPR Petition" or "Petition"). Because Petitioners fail to meet their burden of showing a reasonable likelihood they would prevail with respect to at least one claim challenged in the Petition, institution should be denied.

I. INTRODUCTION

A. Procedural History

On June 10, 2024, Mobile Data Technologies LLC ("Patent Owner") filed a patent infringement complaint (the "Complaint") against Petitioners in the United States District Court for the Eastern District of Texas. *Mobile Data Technologies LLC v. Samsung Electronics Co. Ltd. et al.*, 2:24-cv-00435-JRG-RSP (E.D. Tex.) ("EDTX-Litigation"). ***The EDTX-Litigation will be tried six months before a final written decision ("FWD") is issued in this proceeding***. In the Complaint, Patent Owner asserted four patents: the '039 Patent, U.S. Patent Nos. 8,825,801 ("the '801 Patent"), 9,619,578 ("the '578 Patent"), and 9,922,348 ("the '348 Patent"). Patent Owner served its infringement contentions on September 4,

2024, for these patents. On October 6, 2024, Patent Owner filed an Amended Complaint, adding U.S. Patent No. 8,793,336 ("the '336 Patent") to the EDTX-Litigation. On the same day, Patent Owner served its amended infringement contentions in which "[n]othing else was added other than a chart for the asserted claims of the '336 [Patent] and the file history for the '336 [Patent]." Ex.2001.

Nearly eight months into the EDTX-Litigation, and after the service of both invalidity and infringement contentions, Petitioners filed *ten* IPR petitions—two IPR petitions against each Asserted Patent. More specifically, on January 31, 2025, Petitioners filed the '536 IPR Petition. On March 17, 2025, a notice of filing date was accorded to the '536 IPR Petition, thereby establishing a three-month deadline of June 17, 2025 in which Patent Owner may file a POPR.

On March 26, 2025, the USPTO Acting Director Coke Morgan Stewart issued a memo introducing interim processes to manage the Patent Trial and Appeal Board's (PTAB) workload, effectively creating a new, bifurcated, review scheme, in which discretionary denial considerations are analyzed first by the USPTO Director, in consultation with at least three PTAB judges. The Director will then issue a decision either denying institution or allowing the petition to be assigned to a three-judge panel, per the normal procedure. As a matter of right, the Patent Owner may submit a Discretionary Denial ("DD") brief, due within two months of the notice of filing date of an IPR petition.

On May 14, 2025 (well within the two-month filing period of May 17, 2025), Patent Owner filed a DD Brief, presenting the Board with various independent reasons to exercise their discretion to deny institution of the '536 IPR Petition. *See* Paper 8.

In the DD Brief, Patent Owner argues that the *Fintiv* factors weigh heavily in favor of denial and thus the Board should exercise its discretion to deny institution of the '536 IPR.[1] The EDTX-Litigation is proceeding on a schedule for an April 2026 jury trial—five months before any IPR would conclude between Petitioners and Patent Owner, even if the Board were to institute.[2] In addition, there is substantial overlap between the '536 IPR Petition and the EDTX-Litigation as Petitioner relies on system art in the EDTX-Litigation that corresponds to the references relied upon in the Petition, and Petitioners' Sotera-style stipulation is

[1] The *Fintiv* factors reasoning is discussed in Patent Owner's DD Brief at pages 4-62. *See* Paper 8; *see also* Exs. 2002, 2006, 2008, 2013-2017, 2026-2030, 2032, 2033, 2035, 2037-2039.

[2] This reasoning regarding the timing and investment in the EDTX-Litigation is discussed in Patent Owner's DD Brief at pages 6-15. *See* Paper 8; *see also* Exs. 2008, 2013-2017, 2026, and 2027.

ineffective.[3] Furthermore, the '536 IPR Petition relies excessively on expert testimony[4] and lacks merit.[5]

B. Summary

Institution of an IPR is discretionary, and is authorized when, first, "the same or substantially the same prior art" was *not* previously present to the U.S. Patent and Trademark Office (35 U.S.C. §325(d)), and second, "the information presented in the petition … and any response … shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition" (35 U.S.C. §314(a)).

Institution should be denied because Petitioners do not satisfy the threshold for institution of this IPR. More specifically, institution should be denied because

[3] The reasoning regarding overlap and the ineffective *Sotera*-style stipulation is discussed in Patent Owner's DD Brief at pages 15-30. *See* Paper 8; *see also* Exs. 2006, 2027-2030, 2032, 2033, 2037, and 2039.

[4] The reasoning regarding Petitioners' excessive reliance on expert testimony is discussed in Patent Owner's DD Brief at pages 32-41. *See* Paper 8; *see also* Exs. 2035 and 2038.

[5] The reasoning regarding the lack of merits is discussed in Patent Owner's DD Brief at pages 41-62 (and herein). *See* Paper 8.

Petitioners' obviousness arguments as to each Ground are deficient as they have not shown there is a reasonable likelihood that they would prevail in establishing the unpatentability of at least one challenged claim.

For example, Petitioners present improper combinations, mixing distinct embodiments without acknowledgment and arguing motivations that are illogical. Petitioners also fail to identify teachings in the cited art that correspond to explicit claim limitations, including "previously established application-based information channel" and "information associated with [a] wireless networking functionality." Notably, when addressing the "information associated with [a] wireless networking functionality" for both Grounds, their expert acknowledges the failure of references relied upon in each Ground to disclose relevant teachings—encapsulation of certain information according to GSM-SMS and WAP protocols. Putting aside Petitioners and their expert going beyond the references identified in each Ground, there is no support for the encapsulation of the specific information relied on by them as being encapsulated.

Because Petitioners have not met their burden, institution of this IPR should be denied.

C. Prior Art and Asserted Grounds

Petitioners assert the Challenged Claims are unpatentable based on the following grounds under 35 U.S.C. §103:

Ground	Challenged Claims(s)	References
1	1-4, 8, 9, 13-15, 17-19, 22-25, 28-30	Randall (Ex.1005) and Forsyth (Ex.1006)
2	1-4, 8, 9, 13-15, 17-19, 22-25, 28-30	Pelkey (Ex.1007) and Eck (Ex.1008)

D. The ’039 Patent

The ‘039 Patent is titled Method, Apparatus and System for Management of Information Content for Enhanced Accessibility Over Wireless Communication Networks, and was issued by the U.S. Patent & Trademark Office on May 12, 2015. Ex.1001 (face).

In one embodiment, the ‘039 Patent describes a method that enables a mobile device user to transfer content captured by the mobile device to a server for insertion into a previously established application-based information channel so that the mobile device user can interact with one or more additional users.

The ‘039 Patent also describes transferring information associated with at least one wireless networking functionality of the mobile device from the mobile device to the server.

The content and the information associated with the at least one wireless networking functionality of the mobile device is integrated into the previously established application-based information channel. *See, e.g.*, Ex.1001, 5:51-65, 9:8-28.

The invention also enables other content from at least one of the additional users to be inserted into the previously established application-based information channel.

E. The Challenged Claims The '039 Patent

The challenged claims 1-4, 8-9, 13-15, 17-19, 22-25 and 28-30 include independent claims 1, 17, 18, 19, 22, and 23, set forth below.

1. A method comprising:

1[A] capturing content at a mobile device;

1[B] identifying a previously established application-based information channel into which the captured content is to be inserted, the identified application-based information channel permitting interaction between a user of the mobile device and one or more additional users;

1[C] determining information associated with at least one wireless networking functionality of the mobile device;

1[D] providing the captured content from the mobile device to at least one server for insertion in association with the determined information into the identified application-based information channel; and

1[E] receiving other content, at the mobile device via the identified application-based information channel, from at least one of the additional users.

17. A non-transitory computer-readable storage medium having embodied therein executable code of one or more software programs, wherein said executable program code when executed by a processing element of the mobile device causes the mobile device to perform the method of claim 1.

18. A mobile device comprising:

18[A] at least one processing element comprising a processor coupled to a memory; and

18[B] at least one network interface;

18[C] said at least one processing element being configured to:

18[D] capture content at the mobile device;

18[E] identify a previously established application-based information channel into which the captured content is to be inserted, the identified application-based information channel permitting interaction between a user of the mobile device and one or more additional users;

18[F] determine information associated with at least one wireless networking functionality of the mobile device;

18[G] provide, via said at least one network interface, the captured content from the mobile device to at least one server for insertion in association with the determined information into the identified application-based information channel; and

18[H] receive other content, via the identified application-based information channel, from at least one of the additional users.

19. A method comprising:

19[A] receiving, at a server from a mobile device, content for insertion into a previously established application-based information channel, the previously established application-based information channel permitting interaction between a user of the mobile device and one or more additional users;

19[B] receiving, at the server from the mobile device, information associated with at least one wireless networking functionality of the mobile device;

19[C] integrating the content and the information associated with said at least one wireless networking functionality of the mobile device into the previously established application- based information channel; and

19[D] inserting other content from at least one of the additional users into the previously established application-based information channel.

22. A non-transitory computer-readable storage medium having embodied therein executable code of one or more software programs, wherein said executable program code when executed by a processing element of the server causes the server to perform the method of claim 19.

23. A server comprising:

23[A] at least one processing element comprising a processor coupled to a memory; and

23[B] at least one network interface;

23[C] said at least one processing element being configured to:

23[D] receive, from a mobile device, content for insertion into a previously established application-based information channel, the previously established application-based information channel permitting interaction between a user of the mobile device and one or more additional users;

23[E] receive, from the mobile device, information associated with at least one wireless networking functionality of the mobile device;

23[F] integrate the content and the information associated with said at least one wireless networking functionality of the mobile device into the previously established application-based information channel; and

23[G] insert other content from at least one of the additional users into the previously established application- based information channel.

II. PETITIONERS' FAILURE TO IDENTIFY "ALL REAL PARTIES IN INTEREST" IS A VIOLATION OF 37 C.F.R. §42.8(B)(1)

Petitioners failed to identify all real parties in interest in the '536 Petition. 37 CFR §42.8(b)(1); 35 U.S.C. §315(a)(1).

"[T]he focus of the real-party-in-interest inquiry is on the patentability of the claims challenged in the IPR petition, bearing in mind who will benefit from having those claims canceled or invalidated." *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1348 (Fed.Cir.2018). "Determining whether a non-party is a 'real party in interest' ***demands a flexible approach*** that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that ***has a preexisting, established relationship with the petitioner***." *Id.*, 1351. This inquiry requires examining the IPR petitioner's relationship with the non-party to determine whether the IPR petitioner represents the non-party's interest in invalidating the challenged claims. *Id.*

As an initial matter, Petitioners previously sought to invalidate the '336 Patent—the great-grandparent of the '039 Patent—via an *ex parte* reexamination filed in June 2023 through Unified Patents LLC ("Unified")—an entity in which Petitioners are members. Ex.2042 (File History of Ex Parte Reexamination of U.S. Patent 8,793,336 filed by Unified); Ex.2040 1, n.2 (admitting "Samsung Electronics

Co., Ltd." is a member of Unified Patents).

It is undisputed that Petitioners and Unified have a pre-existing, established relationship, as Petitioners are paying members of Unified. Ex.2040, 1 n.2. And it is without question that Unified stands to benefit from the outcome of Petitioners' IPRs, should that outcome be favorable to Petitioners. Unified expended the resources necessary to prepare and file the reexamination request against the '336 Patent, which shows Unified's interest in invalidating the claims of the Asserted Patents. Unified publicly states that "Unified exists to break the cycle of patent assertion."[6] And as of 2024 Petitioners are "the most sued company in the U.S., with 69 patent infringement lawsuits involving 208 patents."[7] Thus, as evidenced by Petitioners' membership in Unified, Petitioners and Unified both benefit from invalidating patents.

Despite knowing that Unified—which Petitioners are members of—benefit from the outcome of these IPRs, Petitioners failed to list Unified as a real party-in-interest. Petitioners' intentional concealment favors denial.

[6] https://www.unifiedpatents.com/success.

[7] https://www.greyb.com/blog/patent-litigation-trends/.

III. PETITIONERS HAVE NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CLAIM CHALLENGED IN GROUND 1 OR 2

Petitioners assert two obviousness grounds of unpatentability. Petition, 2. For the purpose of this Response, the Board need only consider the validity of independent claims 1, 17, 18, 19, 22, and 23. As discussed below, the Petition fails to establish a reasonable likelihood that Petitioners will prevail and thus a trial therefore should not be instituted. In support, PO cites to the declaration of Mahdi Eslamimehr, Ph.D (Ex.2041).

A. Relevant Legal Principles

Review cannot be instituted unless the Petition demonstrates a reasonable likelihood that at least one of the challenged claims is unpatentable. 35 U.S.C. §314(a); 37 C.F.R. §42.108(c). Under §314, the Board is required to make "a binary choice – either institute review or don't." *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018).

It is Petitioners' burden to show why the challenged claims are unpatentable. *Harmonic Inc. v Avid Tech., Inc*., 815 F.3d 1356, 1363 (Fed. Cir. 2016). The Board "will not take on the role of advocate for a party, trying to make out a case the party has not adequately stated." Board of Patent Appeals and Interferences, Standing Order ¶121.5.2 (Mar. 8, 2011). Rather, it is Petitioners' duty to provide sufficient grounds for the institution of a review "focus[ing] on concise, well organized, easy-

to-follow arguments supported by readily identifiable evidence of record." *Cisco Sys., Inc. v. C-Cation Tech, LLC*, IPR2014-00454, Paper 12, 11 (P.T.A.B. Aug. 29, 2014).

The ultimate determination of obviousness under 35 U.S.C. §103 is a question of law based on underlying factual findings. *In re Baxter Int'l, Inc.*, 678 F.3d 1357, 1362 (Fed. Cir. 2012) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)). "To satisfy its burden of proving obviousness, a petitioner cannot employ merely conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness." *In re Magnum Oil Tools Int'l, Ltd*., 829 F.3d 1364, 1380-81 (Fed. Cir. 2016).

The "factual inquiry" into the reasons for "combin[ing] references must be thorough and searching, and the need for specificity pervades." *In re NuVasive, Inc.*, 842 F.3d 1376, 1381-82 (Fed. Cir. 2016) (internal quotations and citations omitted). The specific reasoning must include some rational underpinning to combine the prior art elements as claimed to support the conclusion of obviousness. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). In addition, the references must be viewed without the benefit of hindsight vision afforded by the claimed invention. *See, e.g.*, *W.L. Gore & Associates, Inc. v. Garlock, Inc.,* 721 F.2d 1540, 1553 (Fed. Cir. 1983); *Interconnect Plan. Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985) ("When prior art references require selective combination by the court to render obvious a

subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.").

It is Petitioner's burden to demonstrate a motivation to combine, and a reasonable expectation of success. *See In re Magnum Oil Tools*, 829 F.3d at 1381. Mere conclusory statements are insufficient. *Id.*, at 1380.

B. Ground 1: The Challenged Claims Are Not Obvious Over the Randall-Forsyth Combination

Ground 1 asserts independent claims 1, 17, 18, 19, 22, and 23 are rendered obvious under 35 U.S.C. §103 by the combination of Randall and Forsyth, relying on the declaration of Henry Houh, Ph.D. (Ex.1003) as support. Petitioners' arguments fail for multiple reasons. Not only do Petitioners present improper prior art combinations, mixing references and embodiments without explanation, but also their stated motivation for the combination is nonsensical. Further, even considering Petitioners' proposed combination of Randall-Forsyth, the combination fails to teach or suggest explicit limitations.

1. Petitioners' Combination of Randall-Forsyth is Improper and Lacks a Motivation

Petitioners' expert premises his opinion on the fact that "Randall and Forsyth were both assigned to [Symbian] and described different aspects of functionality provided by Symbian." Ex.1003, ¶45. Merging the two distinct *publications*, he continues—without citation to the references—that the "client-server infrastructure

is described in Randall which along with Forsyth describes use of *this infrastructure* to provide *the Forums service*." Ex.1003, ¶46 (emphasis added). There is no basis for treating "the Forum service" as one-in-the-same across references. The issue shows up throughout his declaration and the Petition. *See* Ex.2041, ¶¶72-74.

As an initial matter, Randall published in 2002 (Ex.1005, 1), whereas Forsyth published in 2004 (Ex.1006 (face)). Neither claims priority to or incorporates the other by reference. Petitioners make no showing that both describe the same version of Forums or the same version of the Symbian operating system. Notwithstanding different disclosures and different time frames, the expert treats them as describing the same system and application. By the expert's (and Petitioners') logic, a publication referencing iOS version 1.0 could be combined with a publication on iOS version 26 without explanation or motivation, or "Google Hangouts," which evolved significantly in infrastructure, operational logic, and communication protocols, but that is improper. *In re NuVasive, Inc.*, 842 F.3d at 1381-82 (holding the "factual inquiry" into the reasons for "combin[ing] references must be thorough and searching, and the need for specificity pervades"); *see also KSR Int'l*, 550 U.S. at 418 (holding the specific reasoning for combining references must include some rational underpinning to combine the prior art elements as claimed); *see* Ex.2041, ¶74.

The Petition refers to "the Forums server" as a unitary, singular device, relying on the combined teachings of Randall and Forsyth. A server in Randall does not inherently correspond to a server in Forsyth. Petitioners cannot argue that "the Forums server" provides features X, Y, and Z, where X is from Randall and Y is from Forsyth, without addressing the combination. *In re NuVasive, Inc.*, 842 F.3d at 1381; *see also KSR Int'l*, 550 U.S. at 418; *see* Ex.2041, ¶72-74. Telling, with regard to claim 23, Petitioners argue "The Randall-Forsyth combination…teaches or suggests ***a 'server"***". Petition, 43. The Petition repeatedly refers to the "Forums server," as if it were a single, identified server. Petition, 30, 43 ("***The Forums server*** performs processing…"; "***The Forums server*** acts as 'a store…'"). But the Petition ambiguously refers to servers of each of Forsyth and Randall, citing the expert's conflated discussion of both. *Id.*, 43 citing Exs.1005, 1006; *id.* citing Ex1003, ¶191 ("Randall and Forsyth also disclose or suggest ***the server's*** 'processing element' in ***the server*** includes 'a memory'…"). The expert's faulty premise is pervasive throughout related IPRs. *See*, *e.g.*, *Samsung Elecs. Co. Ltd., et al. v. Mobile Data Technologies LLC*, IPR2025-00542, Paper 8, 59-61 (P.T.A.B. June 16, 2025) (discussing expert's conflating Randall and Forsyth with citations to declaration).

Further, after noting "[t]he combination of Randall and Forsyth discloses ***a server***", the expert describes *that server* with references to Randall's "server hosting Forums" and describes *that server* relying on Forsyth's server. Ex.1003, ¶84; s*ee*

also ¶87 ("***Both*** Randall and Forsyth describe that ***the server*** performs…") (emphasis added), ¶55 (describing the "Symbian Forums server" functionality with reference to Forsyth and Randall's "ServML" implementation), ¶71 ("Forsyth enhances the functionality of ***the Symbian infrastructure***").

Concerning the "application-based information channel" (1A/ 9B), Petitioners also treat "Forums" as a singular application across references: "Forums, ***described by Randall and Forsyth***, is ***an application***" (Petition, 19 (emphasis added)), alternating citations (*Id.* 18-19). After concluding that "[o]ne application discussed in Randall using its data architecture is Forums" (Ex.1003, ¶47), the expert turns to Forsyth as describing Forums (*id.* ¶48). There is no acknowledgement that Randall and Forsyth are separate publications and embodiments.

Petitioners also treat the references as single Symbian-based system in the context of the "first interface" (1A/9B): relying on Randall's "Forums infrastructure" as teaching a wireless network interface (Petition, 26 citing Randall, 40:15-41:2, 13:22-24, Figure 4), and then Forsyth as describing the functionality of *that interface* (Petition, 27 citing Forsyth, 6:1-22).

a) The Stated Motivation to Combine Randall and Forsyth Fails

Petitioners adopt the expert's opinion on the motivation to combine, but his opinion is contrary to law and logic. The expert's purported motivation to combine Randall and Forsyth does not undo his improper treatment of them and, in any event,

fails. His premise for combining is "to enhance the Forums service taught by Randall." Petition, 13 (citing Ex.1003, ¶¶75-81). Contrary to the expert's rationale of "enhanc[ing] ***the Forums service***," Petitioners and their expert point to the benefit of using group objects ***in other applications***. *See* Petition, 14; Ex.1003, ¶77 (emphasizing "group created in one application …can immediately be used ***in other applications***" and "data specifically created for one group in one application can be ***re-used in a different application***"). This benefit has nothing to do with "enhanc[ing] the Forums service." *See* Ex.2041, ¶¶75-79.

Additionally with regard to the expert's notion of "enhanc[ing] the Forums service" of Forsyth with Randall's infrastructure, including its extensible database (Ex.1003, ¶75), there is no reason to do so; it is merely impermissible hindsight reconstruction. Forsyth describes the use of "content and application independent group objects" so there is no need for Randall. Forsyth, 3:14-18. *See* Ex.2041, ¶76. Forsyth describes the use of a client server architecture, with group objects residing on a remote server and the use of pointers to such a central server (Forsyth, 3:19-31), which indicates the use of a central database. *See* Ex.2041, ¶76-77. As explained by Petitioners and their expert, the combination is not rooted in any additional benefit, but rather impermissible hindsight. *See W.L. Gore,* 721 F.2d at 1553; *Interconnect Plan. Corp.*, 774 F.2d at 1143.

Moreover, when addressing the motivation, again the expert—and Petitioners—rely on the faulty premise that "***both references are directed to the same service, Forums***". Ex.1003, ¶81; Petition, 15.

2. Petitioners fail to identify a teaching or suggestion in Randall or Forsyth for the "previously established application-based information channel" (Limitation 1[B]/18[D])

Petitioners' theory of obviousness centers around the notion that Forsyth's Forums is an application and that an individual Forum is an "application-based information channel." *See* Petition, 24-30. Petitioners contend that within the Forums application, a user can create an individual Forum for group based text messaging by identifying the group of users "whom [the user] wishes to invite." Petition, 24-25. With regard to 1[B]/18[D], Petitioners assert that "an individual Forum is 'application-based information channel.'" Petition, 27. Creation of an individual Forum is enabled via utilization of a "group object" within Forums:

> ***Forums runs on the object based operating system Symbian OS***. In Forums, ***a new group object can be created*** when a user defines the recipients of a message, or (going beyond a simple messaging application) whenever the user defines the desired participants to be involved in group communication.

Forsyth at 2:47-52. Specifically, Forsyth states that the group object is application independent:

> ***Fundamental to Forums is the idea of there being an object which defines solely the identities of members of a group***: as such, it is content and ***application independent***.

Forsyth at 5:15-17.

> ***Each group exists as an application independent object*** and can hence be accessed by different applications and used for a wide variety of purposes—whenever an application designer wishes to include some kind of group communication functionality.

Id. at 5:55-60; *see also id.* at 2:37-39 ("No earlier system includes the concept of the content and ***application independent 'group' object***."). Thus, it is undisputed that the group objects created in Forums are application independent, per Forsyth's express teaching. As such, contrary to Petitioners' arguments, an individual Forum is not an *application-based* information channel. *See* Ex.2041, ¶¶80-84. Neither Petitioners nor their expert explain how an "application independent" channel can be "application-based."

From a technological and implementation perspective, Forsyth's application-independent group objects is technologically inconsistent with the '039 Patent. A POSITA would have recognized that mapping an application-independent structure onto the '039 Patent's channel would demand a fundamental redesign: the group object would need to be cloned or irrevocably bound to a specific application context; server logic would need new namespace and access-control layers to prevent other apps from re-using the object; and the client would have to transmit extra metadata so the server could disambiguate a specific group object in, for example, a Messaging app from the exact same object when invoked by a Diary app. *See* Ex.2041, ¶84. Neither Petitioners nor their expert address the need for these, or

any, modifications necessitated by Forsyth's use of group objects as its "foundation stone for building applications." Forsyth, 3:14-18.

Recognizing the shortcomings of their argument, in their Response To Patent Owner's Discretionary Denial Brief (Paper 9; "DD Response"), in addressing *Fintiv* factor 6 (related to the merits), Petitioners attempt to shift positions. Here, Petitioners argue *not* simply that an individual Forum is the application-based information channel (*see* Petition, 27), but rather that "***the group object*** is therefore an 'application-based information channel'" and that the claimed channel can exist across applications. DD Response, 36-37 (emphasis added). Nowhere in the Petition do Petitioners argue the group object is the channel, and it should not be credited. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (recognizing Petitioners are held to the positions in their petition). In any event, the group object in Forsyth is just a data object—"a collection of information that describes or references…2 [sic] or more entities". Forsyth, 2:17-19. This new argument simply highlights the weakness in the argument Petitioners did present in their Petition; an individual Forum is not application-based.

Petitioners' arguments regarding limitation 19[A]/23[C] suffer from the same issues and deficiencies, as do the arguments for claim 17 (which incorporates the limitations of claim 1) and claim 22 (which incorporates the limitations of claim 19).

3. Petitioners fail to identify anything in Randall or Forsyth that teaches or suggests the claimed "information associated with [a] wireless networking functionality of the mobile device" (Limitation 1[C]/18[E])

In connection with limitation 1[C]/18[E], Petitioners argue—relying exclusively on their expert—that Randall-Forsyth teaches the recited "information associated with at least one wireless networking functionality," relying on encapsulation of sender name, date/time, and Forum name in a protocol (e.g., GSM-SMS or WAP) message. But the expert admits that neither Randall nor Forsyth describe any details of a protocol message or such encapsulation. *See* Ex.1003, ¶160; *see also* Ex.2041, ¶85-87, 92. Nevertheless, Petitioners rely on their expert's say-so. In any event, sender name, date/time, and Forum name are not "associated with [a] ***wireless networking functionality of the mobile device***" and there is no teaching or suggestion that such information is determined by the mobile device or included in a protocol message.

Specifically, Petitioners argue that sender name, date/time, and Forum name are "information associated with [a] wireless functionality of the mobile device" determined by the mobile device.

> These scenarios/examples also demonstrate the mobile device "determin[es] information specifying" the "messaging action" (send a message). Specifically, the mobile device must create a Forums message by (1) determining the sender (i.e., identity of the user in the Forum (e.g., Steve)) and the Forum name (e.g., Naked Chef) and (2) combining that information with the text, image, etc. provided by the user.

Petition, 32.

Notably, despite Petitioners' emphatic conclusion that it "must" be so, Petitioners cite nothing to support the argument that the mobile device must create a Forum's message by determining sender name and Forum name. Indeed, in the client-server architecture of the Forum application advanced by Petitioners (*see, e.g.,* Petition, 17), there is no need for the mobile device to determine this information.[8] *See* Ex.2041, ¶¶88-89. As described in Forsyth and illustrated in the user interfaces of Figures 6-9 (relied on by Petitioners elsewhere),[9] a user selects a previously established Forum (e.g., Naked Chef) (Figure 6) and after selecting "Forum Reply," the user enters a text message, which is posted to the selected Forum. Contrary to

[8] Contrary to Petitioners' argument regarding limitation 1[D]/18[F], there is also no reason the mobile device must insert such information with the content in the application-based information channel.

[9] *See*, *e.g.*, Petition, 28 (when addressing "identify[ing] a previously established application-based information channel" of 1[B]/18[D], explaining Figure 6 presents a user's list of Forums and allows selection of one to "navigate[] to a screen associated with the Forum (e.g., Forsyth Figure 8)"); *id.* at 23 (explaining a user selecting "Forum Reply" (Figure 8) and "input[ting] a text message which 'is posted to the Forum'" (Figure 9)).

Petitioners and their expert, there is no reason for the mobile device message to determine (or, as required by limitation 1[D]/18[F], include in the message) the user identity, as the system already knows which user is logged into the system (having presented him/her with their individualized list of available Forums), or the Forum name (the user having already selected the particular Forum);[10] any user name, timestamp or Forum name may be added by the server as a matter of course, not because the mobile device determined this information and sent it to the server, as required by the claim language. Ex.2041, ¶¶88-89.

Moreover, sender name and Forum name (and date/time, referred to elsewhere) are not information associated with a wireless networking functionality but, at best, related to the text message relied on by Petitioners as the claimed ***content*** or the Forum ***application-based information channel***. *See* Ex.2041, ¶¶90-91. First, Petitioners argue regarding limitation 1[A] that the Forums message is the claimed content: "The text message entered into the user interface is captured at the wireless device." Petition, 23-24 (relying on "group-based messaging," as shown in the text-message interfaces of Figures 7-9). Thus, information about the message—sender name and date/time—is at best information about the claimed content—not "information associated with [a] wireless networking functionality of the mobile

[10] *Id.*

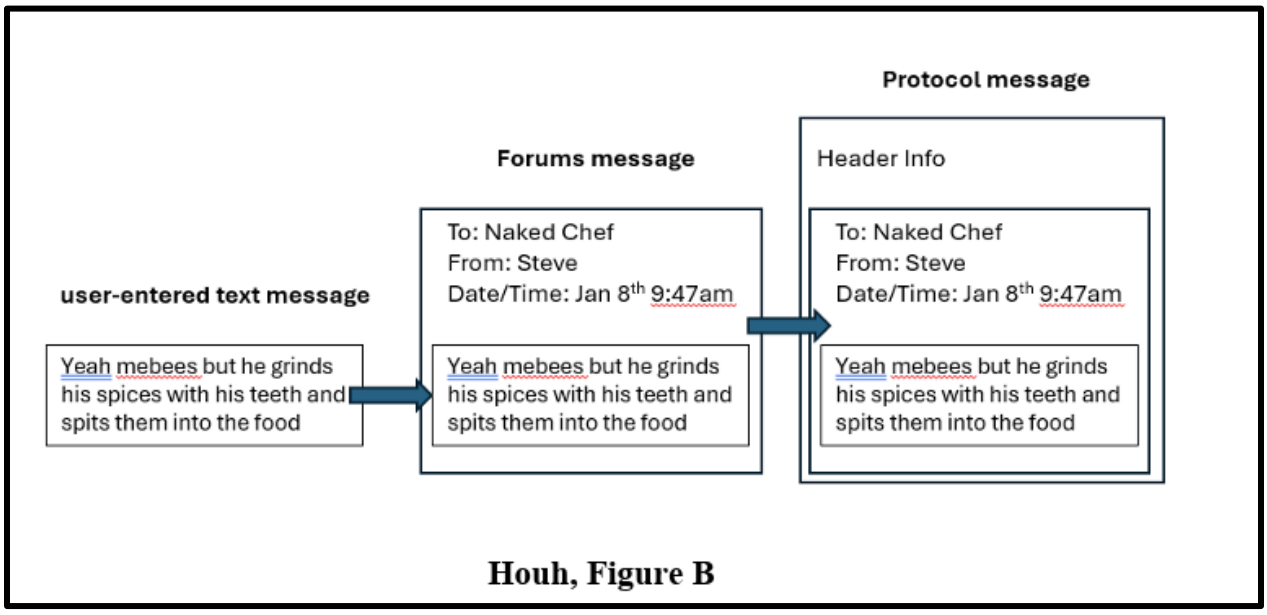
device." *See* Ex.2041, ¶¶90-91. Petitioners' expert implicitly acknowledges this, stating: "The 'captured content' and ***its*** associated 'determined [i.e., wireless networking functionality] information' of Forum message posted by a user is 'integrated content.'" Ex.1003, ¶246 (addressing "integrated content" claims 24 and 25 with cross-reference to limitation 1[D]) (emphasis added).

Second, as explained above, Petitioners contend that a Forum created in the Forums application is the claimed "application-based information channel." Petition, 24-25, 28. Thus, information about the Forum's name (and its group participants) is at best information about the claimed information channel—not "***information associated with*** … wireless networking functionality." Ex.2041, ¶¶90-91.

Importantly, apparently in support of the Forum name being wireless networking functionality information, Petitioners explicitly note the creation of a new Forum in Scenario 1. Petition, 32 ("For example, in Scenario 1 of Forsyth, when the 'Naked Chef' Forum is created, the user sends an initial message to the server. (See EX-1006, 6:1-9.)"). To the extent Petitioners imply a user's message by which he/she names the Forum and creates it is the basis for the Forum name being sent, that fails. The "application-based information channel" must be "previously established," and the supposed sending of the Forum name at the time the Forum is created is not with regard to a "previously established" channel.

Petitioners continue the same paragraph block-quoted above—again relying on their expert—with an apparent alternate argument: "The protocol message includes information associated with the action of sending a message determined by the mobile device such as message type and content type identifier." Petition, 33 (citing Ex.1003, ¶¶162-163 (citing Ex.1015, 42-43, 60, 63)). This too fails. *See* Ex.2041, ¶¶93-94, 100.

In discussing limitation 1[C]/18[E] for Ground 1, the expert testimony begins with a conclusory statement that "[t]he mobile device must also encapsulate the generated Forums message into a protocol message to be transmitted by over wireless network, as I illustrate in my Figure B below." Ex.1003, ¶160.



Houh, Figure B

Ex.1003, ¶160.

Other than his say-so, the expert offers no evidence supporting a conclusion that a message sent ***via Forsyth's Forums*** is encapsulated into a protocol message,

let alone with the sender name, date/time, and Forum name. In fact, the expert concedes that "neither Randall nor Forsyth provides the details of the ***wireless messaging functionality*** of ***GSM-SMS or WAP***." *Id.* Nevertheless, he goes on to state that his conclusory opinion is "well-known to and within the general knowledge of a POSITA." *Id.* Thus, the expert assumes without providing any explanation that the Forums message in Forsyth is somehow converted into a protocol message with such information. For support, he cites his own made-up drawings, resulting in merely a circular argument. *Id.* Furthermore, it should go without saying that the expert's drawings are not proper prior art in this proceeding. *Meta Platforms, Inc., et al. v. Eight kHz, LLC*, IPR2023-01023, Paper 10, 31 (P.T.A.B. Jan. 9, 2024) ("We further note … Dr. Begault's deposition testimony, ***which does not qualify as prior art in this proceeding***.").

In the next few paragraphs, the expert cites Exhibits 1015 and 1014—references that are not included in any Asserted Ground—to discuss GSM and WAP functionality. Ex.1003, ¶¶162-164 (referencing disclosures in Exs.1015 and 1014). The expert does so to fill the gap he admits exists in Randall and Forsyth. But Forsyth is directed at neither WAP nor GSM and, as such, the expert's explanation of "the ***wireless messaging functionality*** of ***GSM-SMS or WAP***" does not constitute "providing helpful context" to understand any teaching of Forsyth. *See* Ex.2041, ¶¶87, 92. It is an attempt to gap-fill the prior art's teachings by expert testimony.

In fact, Forsyth does not mention even once "WAP" or "Wireless Application protocol," and teaches away from GSM-based platforms: "Wireless information devices based on the Symbian OS platform, are 'smarter' than current generation GSM phones in being able to offer multiple, advanced, robust client based applications." Forsyth at 1:32-35; *see* Ex.2041, ¶92. Forsyth specifically lists fundamental weaknesses associated with GSM phones making it unsuitable for Forsyth, e.g., "no single system fully and successfully accommodates the unique characteristics of communicating between groups of mobile users." Forsyth at 1:54-60.

Randall adds nothing, merely mentioning that GSM and other networks could be used (*See* Randall, 1:11-13) and never providing detail on any protocol message content. *See* Ex.2041, ¶¶85-86, 93-94.

Moreover, Petitioners' argument is inconsistent with the '039 Patent. Despite the '039 Patent explicitly acknowledging that communication protocols, such as WAP, can be used (*See*, *e.g.,* Ex.1001, 4:17-23), it does not identify this standard protocol header information or sender name, date/time or channel name as the claimed "information associated with [a] wireless networking functionality of the mobile device." Petitioners' exclusive reliance on their expert highlights the deficiencies in Randall and Forsyth.

The expert's citations to Ex.1014 and Ex.1015 (*See* Ex.1003, ¶¶65-66) does not save the argument. Such citations are the expert's impermissible reliance on a "reference" not included in Ground 1. *See Cisco Systems, Inc. v. C-Cation Techs.,* IPR2014-00454, Paper 12, 9 (P.T.A.B. Aug. 29, 2014) (informative) (providing that "practice of citing the Declaration to support conclusory statements that are not otherwise supported in the Petition also amounts to incorporation by reference"); *Meta Platforms, Inc.,* IPR2023-01023, Paper 10 at 31 ("We further note that several of Petitioner's assertions are supported only by VR Book (Ex. 1063), which is not relied upon as the basis for this challenge, or Dr. Begault's deposition testimony, which does not qualify as prior art in this proceeding.")). Furthermore, even if these references were considered, contrary to Petitioners' argument, there is no discussion in Randall or Forsyth of the sender name, date/time, or Forum name being included in a protocol message; the expert's argument is based merely on impermissible hindsight. *See W.L. Gore,* 721 F.2d at 1553; *Interconnect Plan. Corp.*, 774 F.2d at 1143.

While reference to GSM-SMS or WAP may indicate that the mobile device sends a Forums message via a wireless network, neither Forsyth nor Randall teaches that any information is separately "**determin[ed] about the wireless networking functionality of the mobile device"** (or, as addressed below in connection with limitation 1[D]/18[F], associated with the content). The mobile device does not

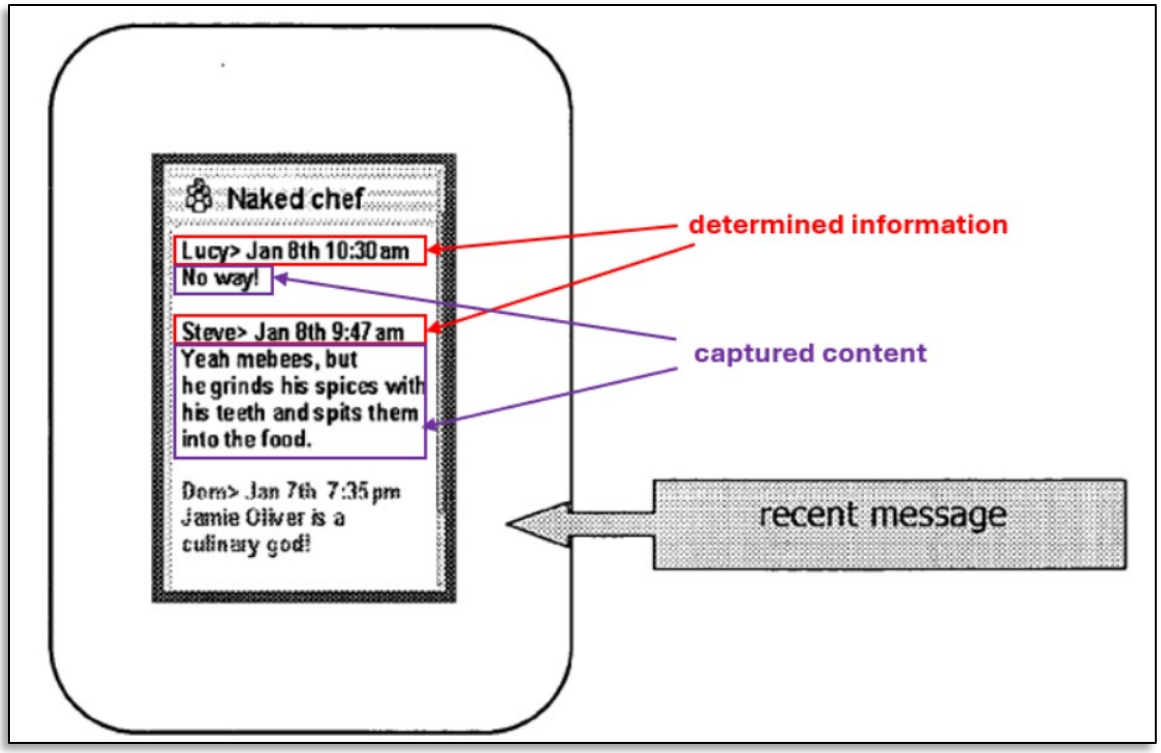
determine message type or content type. *See* Ex.2041, ¶¶91, 93-94, 100. In Forsyth's scenario, the device simply transmits the user's text over whatever protocol is available. Forsyth, 1:22-24.

Petitioners' arguments regarding limitation 19[B]/23[D] suffer from the same issues and deficiencies, as do the arguments for claim 17 (which incorporates the limitations of claim 1) and claim 22 (which incorporates the limitations of claim 19).

4. Petitioners fail to identify anything in Randall or Forsyth that teaches or suggests the claimed "provid[ing]/[e via said at least one network interface,] the captured content from the mobile device to at least one server for insertion in association with the determined information into the identified application-based information channel" (Limitation 1[D]/18[F])

In connection with limitation 1[D]/18[F], Petitioners fail to identify any specific teaching or suggestion of providing captured content "in association with the determined information" (the "determined information" being that "associated with at least one wireless networking functionality of the mobile device" (1[C])). As such, Petitioners fail to present a prima facie case of obviousness or reasonable likelihood of prevailing.

In addressing 1[D]/18[F], Petitioners continue their reliance on sender name, date/time, and Forum name (shown in Petitioners' annotated Forsyth, Figure 7 (below)) as the "determined information" being provided with captured content *as encapsulated within a GSM-SMS or WAP protocol message*:



Symbian Forums—Forsyth, Figure[11]

> The "*determined information associated with*" the action of sending the Forums message (e.g., sender name, date/time, Forum name) **is provided** along with the text message entered by the user (captured content) **in the protocol message sent to the server**. (§V.B.1.b.3.) **As shown by Forsyth's Figure 7 above**, this "*determined information*" (user identity, date/time, forum name) **is inserted "*into the identified application-based information channel*" with the "*captured content*"** and displayed on the Forum (Naked Chef) screen for each forum member. (EX-1003, ¶177).

Petition, 39. Such argument is facially flawed.

As an initial matter, as discussed above and admitted by Petitioners' expert, "neither Randall nor Forsyth provide the details of the wireless messaging

[11] Forsyth, Figure 7, as annotated by Petitioners. Petition, 39.

functionality of GSM-SMS or WAP" (Ex.1003, ¶160), so Petitioners impermissibly rely on their expert and references not included within Ground 1. *See*, *supra*, III.B.3.

Moreover, contrary to Petitioners' argument and their expert's assertion, Forsyth fails to teach or suggest sender name, date/time, and Forum name being "provided along with the text message entered by the user (captured content) in the protocol message sent to the server." Petition, 39. Forsyth includes no discussion of such information being contained in a message from the mobile device to the server, and Petitioners point to none. *See* Ex.2041, ¶¶95-97; *see also id.*, ¶¶85-87. Instead, Petitioners again rely on the unsupported, *ipse dixit* of their expert.

The only stated rationale for Petitioners' (and their expert's) position is the inclusion of the Forum name, user identity, and day/time in Forsyth's Figure 7. Petition, 39 ("As shown in Figure 7"). However, merely displaying the information does not support Petitioners' and their expert's statement that the information is "provided in the protocol message sent to the server." Petition, 39; *see* Ex.2041, ¶98. Indeed, in Forums there is no reason for such information to be sent to the asserted application-based information channel for "interaction between a user of the mobile device and one or more additional users." '039 Patent, 1[B]/18[D]; *see* Ex.2041, ¶99. As described in Forsyth and illustrated in the user interfaces of Figures 6-9 (relied

on by Petitioners elsewhere),[12] a user selects a previously established Forum (e.g., Naked Chef) (Figure 6) and after selecting "Forum Reply," the user enters a text message, which is posted to the selected Forum. Contrary to Petitioners and their expert, there is no reason for the mobile device message to include in the message the user identity, as the system already knows which user is logged into the system (having presented him/her with their individualized list of available Forums), or the Forum name (the user having already selected the particular Forum);[13] any user name, timestamp or Forum name may be added by the server as a matter of course, not because the mobile device determined this information and sent it to the server, as argued by Petitioners and required by the claim language. Ex.2041, ¶99.

[12] *See*, *e.g.*, Petition, 28 (when addressing "identify[ing] a previously established application-based information channel" of 1[B]/18[D], explaining Figure 6 presents a user's list of Forums and allows selection of one to "navigate[] to a screen associated with the Forum (e.g., Forsyth Figure 8)"); *id.* at 23 (explaining a user selecting "Forum Reply" (Figure 8) and "input[ting] a text message which 'is posted to the Forum'" (Figure 9)).

[13] *Id.*

Petitioners' arguments regarding limitation 19[C]/23[E] suffer from the same issues and deficiencies, as do the arguments for claim 17 (which incorporates the limitations of claim 1) and claim 22 (which incorporates the limitations of claim 19).

5. Petitioners' 1[B] and 1[C] Arguments are Contradictory

Furthermore, Petitioners' argument regarding limitation 1[B]/18[A] is at odds with their 1[C]/18[E] argument. For 1[B], Petitioners cite "group based text messaging" as an example of creating a Forum within Forums. Petition, 25-26 ("Forsyth's 'group based text messaging' Scenario 1 describes an example of creating a Forum (channel) within Forums."). For 1[C], Petitioners contend that the same group based text messaging "is a functionality implementable by the mobile device via the wireless network." Petition, 31. Accordingly, Petitioners rely on Forsyth's group based text messaging teaching both limitation 1[B]'s "previously established application-based information channel" and limitation 1[C]'s "mobile device wireless networking functionality." Petitioners' approach underscores their misunderstanding of Forsyth, the '039 Patent claims, and the law.

Petitioners misconstrue Forsyth by mapping its disclosure of "group based text messaging" to the claimed "wireless networking functionality." *See* Ex.2041, ¶¶101-103. But Forsyth's reference to "group based text messaging" is not a "wireless networking functionality" of the mobile device—it is a capability of Forums, which, as Petitioners contend, is an application.

Petitioners admit that "group based text messaging" is no more than a capability of Forums, which Petitioners contend to be the claimed application (Petition, 25): "Forums is a '***messaging tool that facilitates open discussion amongst a group***' including through 'group based text messaging' and 'group based multi-media messaging.'" Petition, 23; *see also* Petition, 31 ("Forums supports 'group based text messaging' and 'group based multi-media messaging.'").

Forsyth itself confirms that Forums uses group objects to initiate group based text messaging. Forsyth at 3:35-45. A group object, Forsyth explains, is "a collection of information that describes or references at least the minimum amount of information about 2 or more entities (usually individual …) ***required for activities to be engaged in between them***." Forsyth at 2:17-22. In the context of text messaging, Forsyth explains that "the collection of information" required to create a group object is information about the participant in the group: "***In Forums, a new group object can be created when a user defines the recipients of a message***." Forsyth at 2:48-49. Forums supports "group based text messaging" by allowing a user to select "a group of participants"—which is stored as an "application independent object"—to create a Forum. Forsyth at 5:50-62. Thus, Forsyth's "group based text messaging" is a capability of Forums. Forums supports a text messaging activity because it is a "messaging tool." Forsyth at 5:27-30. It is group based because "[i]n Forums, a new group object can be created when a user defines the

recipients of a message, or (going beyond a simple messaging application) whenever the user defines the desired participants to be involved in group communication." Forsyth at 2:48-53. Contrary to Petitioners' mischaracterization (Petition, 31), Forsyth's reference to "group based text messaging" is not a "wireless networking functionality of ***the mobile device***"—it is a capability of Forums, which, as Petitioners contend, is an application. *See* Ex.2041, ¶¶101-103.

Petitioners' inconsistent argument cannot establish a reasonable likelihood of invalidity of a challenged claim.

C. Ground 2: The Challenged Claims Are Not Obvious Over the Pelkey-Eck Combination

Ground 2 of the Petition asserts that the combination of Pelkey (Ex.1007) and Eck (Ex.1008) discloses or renders obvious every element of the independent claims of the '039 patent. This ground also fails. First, Petitioners' explanation to combine Pelkey and Eck is nothing more than impermissible hindsight. Second, neither Pelkey nor Eck, alone or in combination, teaches all limitations of the challenged claims. Third, Petitioners also rely on improperly assumed interfaces and messaging behaviors that are not disclosed in either reference. These deficiencies are not minor gaps; they go to explicit claim limitations.

1. Petitioners' Stated Motivation to Combine Pelkey and Eck Fails

Petitioners fail to identify any plausible motivation to combine the teachings of Pelkey and Eck. Petitioners merely state, without support, that a "POSITA would have been motivated to combine Eck's teachings regarding PagerWorld with the network and message server architecture taught in Pelkey." Petition, 62.

As an initial matter, the holes in Petitioners' argument are particularly notable given their admissions as to the deficiencies of Pelkey and Eck. Admitted deficiencies include:

(i) Eck does not describe a client-server structure as taught in Pelkey (Ex.1003, ¶271; Petition, 62-63);

(ii) Pelkey does not describe integration of messaging and sharing content like photos with multiple users (Ex.1003, ¶272);

(iii) Pelkey does not describe any in-game messaging (Ex.1003, ¶272; Petition, 63); and

(iv) Pelkey does not disclose details of the wireless network used to provide wireless messaging from the game system to the server (Petition, 75; Ex.1003, ¶300).

Petitioners argue that a "POSITA would be motivated to apply the network and message server architecture in Pelkey to Eck in order to avoid the charge-based system for exchanging messages and photos via pager cartridge in Eck. (EX-1003,

¶272.)" Petition, 63. This is contrary to the teaching of Eck, which solves any issue regarding "cost" an entirely different way. *See* Ex.2041, ¶¶106-107. Specifically, Eck teaches that a user can turn to "user-generated custom libraries of words, phrases and graphics" to reduce message length. This practice is called "coding," which Eck expressly acknowledges can be used "to reduce message length" and thus "reduce message charges." Eck, 16:59-60; *see also id*. 16:49-63 ("It can be seen that by using 'coding', the length of the messages may be reduced."). Petitioners and their expert point to no evidence to support a combination of Pelkey and Eck based on cost reduction, failing to address the additional costs of the proposed modification (e.g., communication and bandwidth costs of the proposed network and message server architecture) or the specific savings that would motivate the combination or prompt a user to switch to GSM-SMS or WAP. *See* Ex.2041, ¶108-109; *In re Schmidt*, 892 F.2d 1051, *2 (Fed. Cir. 1989) ("[W]hile we agree that cost saving may serve as a motive for making a modification, ***it must be clear at least that the modification, in fact, effects a reduction in the cost.***").

Petitioners continue that "a POSITA would be motivated to modify the 'pager cartridge' in Eck as necessary to use PagerWorld in Pelkey given the disclosed benefits of PagerWorld including 'exploration and adventure,' 'chat and community interaction,' and 'character growth.'" Petition, 63 (citing Ex.1003, ¶272; Ex.1008, 10:13-19). The statement is nonsensical: it admits that Eck, through its pager

cartridge, already provides the benefits of 'exploration and adventure,' 'chat and community interaction,' and 'character growth,' so why would its structure and operation need to change? *See* Eck, 10:1-19 (explaining an application of "pager cartridge 100" is Multiple User Dungeon (MUD) games that provide these benefits); *see also* Ex.2041, ¶110. Petitioners do not answer this question. Instead, the statement highlights their use of impermissible hindsight. *See W.L. Gore,* 721 F.2d at 1553; *Interconnect Plan. Corp.*, 774 F.2d at 1143.

Finally, Petitioners parrot their expert's conclusory opinions that Eck's PagerWorld game is a known technique, Pelkey's client-server based messaging server is a known method/product, and "[r]eplacing the pager system infrastructure system in Eck with the client-server architecture in Pelkey is the simple substitution of one known element for another to achieve a predictable result (internet-based functionality)." Petition, 63 (citing Ex.1003, ¶272). But the expert never explains what those modifications would be given differences in operation and architecture. Indeed, the expert provides no explanation of whether, circa 2002, a "GSM-SMS and WAP cartridge" could be constructed, how a pager cartridge could be replaced with such a hypothetical "GSM-SMS or WAP cartridge" in the system of Eck, including in the context of other portions relied on by Petitioners involving piggy-backing a digital camera cartridge onto the "GSM-SMS or WAP cartridge." *See* Ex.2041, ¶111.

Petitioners have thus failed to provide a sufficient explanation of the combination of Pelkey and Eck or the motivation to combine them. This applies to all '039 Patent claims.

2. Petitioners fail to point to disclosure of a "previously established application-based information channel into which the captured content is to be inserted" (Limitation 1[B]/18[D])

Even if the combination of Pelkey and Eck is considered as Petitioners contend, Petitioners fail to present a prima facie case that the combination teaches the limitation 1[B]/18[D].

a) Petitioners fail to point to disclosure of a "previously established application-based information channel

Petitioners fail to identify the "previously established application-based information channel...," as recited in limitation 1[B]/18[D] (and limitation 19[A]/23[D]). Here, again, Petitioners rely on the unsupported conclusions of their expert.

Parroting their expert, Petitioners argue that "PagerWorld" is persistent and thus a "previously established" information channel:

> PagerWorld includes client software in the portable game machine (client program) and corresponding software in the server (server program). **As such, PagerWorld is persistent**—it remains in existence after individual users exit the world. PagerWorld is therefore a 'previously established application-based information channel'....

Petition, 71 (citing Ex.1003, ¶289).

But as established above, there is no support for the conclusion that persistence—remaining in existence after individual users exit, as Petitioners contend—necessarily results from having both a client program and a server program. *See* Ex.2041, ¶¶112-115. Nothing indicates that the architecture dictates this functionality. The only additional information in the expert's cited paragraph not in the quoted portion of the Petition is a citation to Eck. *See* Ex.1003, ¶289 (citing Eck, 4:61-5:7, 9:40-59). But these cited passages merely described generally how to use Eck's game machine (e.g., insert game cartridge in the slot, operate power switch) (*see* Eck, 4:61-5:7) and the general pager functionality (e.g., pager cartridge provides two-way paging and is addressable, messages may be from system operator); neither portion relates specifically to PagerWorld. Petitioners' position that PagerWorld is persistent by virtue of it having both client and server programs is baseless. *See* Ex.2041, ¶114.

Additionally, neither Pelkey nor Eck teaches the server-side operations required by claims 19, 22, and 23. Those claims recite that the server receives both the captured content and the associated information and integrates them into the shared information channel (Ex.1001, 20:20–37, 20:47–21:5). While both Pelkey and Eck describe server infrastructure, neither discloses the server performing any integration of content and networking information. Pelkey's web server relays user messages between consoles (Pelkey, 5:36–48), it but does not disclose assembling

or curating integrated content. Eck's messaging backend is similarly silent in this regard. Petitioners' expert states that content is integrated "by virtue of appearing within the PagerWorld environment" (Ex.1003, ¶160), but it does not explain what integration occurs or how. Petitioners have thus failed to identify any teaching of the claimed server-side processing and storage of combined content and contextual information.

b) Petitioners fail to point to disclosure of a "previously established application-based information channel into which the captured content is to be inserted"

In addressing 1[B]/18[D], Petitioners argue that "the captured content (photo/images, sound/auto files) 'is to be inserted' into the 'previously established application based information channel.'" Petition, 73 (quoting 1[B]/18[D]). In support, they point to (i) a user customizing their person character and (ii) "PagerWorld supports transmission of messages 'with images and sound bytes to other pagers in the network….'" Petition, 73 (citing Eck, 16:42-45, 24:30-36). Neither teaches or suggests the claim limitation.

Regarding (i)—customizing a persona character—Eck, in a single passing sentence, mentions "[i]t is even possible to customize the persona character using image data obtained with a digital camera cartridge." Eck, 12:38-40. Eck never discusses what such image data is or how it is used. Petitioners, without support, go well beyond this passing reference. It is not, as Petitioners argue, the insertion of

"photos/images." *See* Ex.2041, ¶117. Petitioners simply make an unsupported leap without explanation, never explaining what "image data" may comprise or how it may be reflected in a persona character. *See* Petition, 73.

Regarding (ii)—PagerWorld transmitting messages with images and sound—there is no such disclosure. Petitioners conflate different embodiments and discussions in Eck; messages with images and sound have nothing to do with PagerWorld. *See* Ex.2041, ¶¶118-119. Established precedent forbids combining features from unrelated embodiments or references absent a clear teaching or suggestion to do so, and Petitioners point to none. *See, e.g., In re Wright*, 569 F.2d 1124, 1127 (CCPA 1977); *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1354 (Fed. Cir. 2013); *Reactive Surfaces Ltd. v. Toyota Motor Corp.*, IPR2019-00867, Paper 6, 8 (P.T.A.B. Sep.18, 2019) ("When an obviousness argument relies on 'combining multiple embodiments ***from a single reference***, … ***there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful***, otherwise a skilled artisan would not arrive at the claimed combination.'" (quoting *In re Stepan Co.*, 868 F.3d 1342, 1345-46 n.1 (Fed. Cir. 2017))); *see also Apple Inc. v. Arigna Technology*, IPR2022-01037, Paper 9, 20 (P.T.A.B. Dec. 2, 2022); *Samsung SDI Co. v. Ube Industries, Inc.*, IPR2017-02116, Paper 8, 21 (P.T.A.B. Mar. 12, 2018); *Abiomed, Inc. v. Maquet Cardiovascular, LLC*, IPR2017-01204, -01205, Paper 8, 8-12 (P.T.A.B. Oct. 23, 2017).

Eck describes various embodiments and uses for its pager cartridge—including uses outside the context of PagerWorld. Whereas the claimed "previously established application-based information channel"—identified by Petitioners as PagerWorld—is for insertion of the captured content, not every message transmitted via the pager cartridge in Eck involves PagerWorld.

Eck makes clear that the pager cartridge can be used to send messages ***separate*** from PagerWorld. *See* Ex.2041, ¶¶119-121. For example, in the disclosed embodiment shown in Figure 5B, "a game cartridge is piggy-backed onto pager cartridge 100 [and] users can play the game independently via pass-through connector 902." Eck, 13: 61-63. Pager functionality is independent. "Pager cartridge 100 is a stand-alone accessory device…which can receive messages even when not attached to game machine 10." Eck, 22:2-5. The game machine 10 can be used not to play a game or enter PagerWorld, but to merely "activate[] a display of messages on the display thereof in accordance with the operating software stored in the memory of the pager." Eck, 22:10-14.

Eck acknowledges the separateness of traditional paging functionality from game-play and PagerWorld. Eck summarizes the functionality of the "pager-equipped portable game machine," ***explicitly enumerating sending messages separately from allowing playing of pager-compatible games like PagerWorld***. Eck, 9:25-37. Also acknowledging the non-PagerWorld uses, Eck notes: "Apart

from traditional paging functions, pager cartridge 100 can be used in game playing." Eck, 9:60-61.

Petitioners cite to Eck, 16:42-45 and 24:30-36, for the proposition that "PagerWorld supports transmission of messages 'with images and sound bytes to other pagers in the network….'" Petition, 73. However those citations are clearly unrelated to PagerWorld.

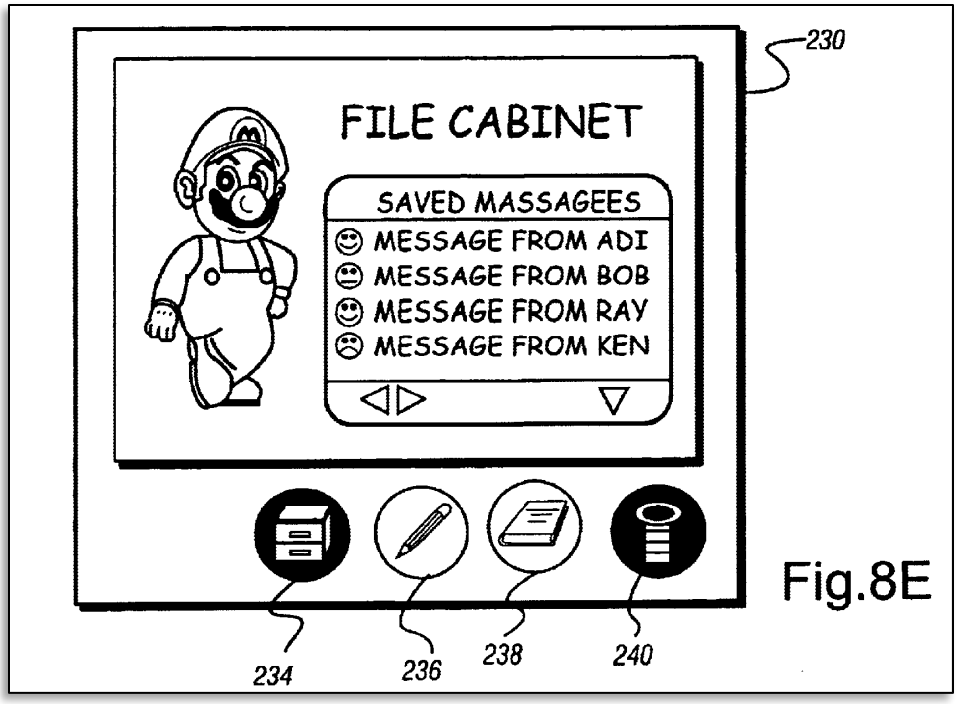
Cited by Petitioners, Eck, 16:42-45, is directed to this traditional pager functionality, never even suggesting the functionality apply to PagerWorld. *See* Eck, 16:41-17:4; *See* Ex.2041, ¶120.

Petitioners also cite Eck, 24:30-36, but it does not relate to PagerWorld. *See* Ex.2041, ¶121. It is part of a discussion of an "Example Digital Camera," including its structure and circuitry. *See* Eck, 23:35-24:65. If anything, Petitioners' citation to this embodiment actually supports Patent Owner: the discussion is of radio circuitry integrated in the game machine and functionality without reference to any game cartridge or PagerWorld; the message-sending functionality is separate from any alleged application-based information channel. Petitioners and their expert never directly address that these are disparate embodiments.

Moreover, Petitioners actually admit the distinction, stating: "***In addition to messaging (e.g., paging functions)***, the message cartridge 'can be used in game playing.'" Petition, 70 (citing Eck, 9:60-61). Not every messaging/paging function

in Eck relates to game play like PagerWorld, and Petitioners' mixing of embodiments without explanation is improper. "When an obviousness argument relies on 'combining multiple embodiments ***from a single reference***, … ***there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful***, otherwise a skilled artisan would not arrive at the claimed combination.'" *Reactive Surfaces Ltd.*, IPR2019-00867, Paper 6 at 8 (quoting *In re Stepan Co.*, 868 F.3d at 1345-46 n.1); *see also Arigna Technology*, IPR2022-01037, Paper 9 at 20; *Samsung SDI Co.*, IPR2017-02116, Paper 8 at 21; *Abiomed*, IPR2017-01204, -01205, Paper 8 at 8-12.

Furthermore, whereas Petitioners identify photos/images and sound as the captured content for insertion in the channel, they identify no supporting disclosure. Petitioners discuss the Message Center in support (Petition, 73), but there is no disclosure of inserting or designating a captured photo or sound. Through the Message Center, a user can arrive at a Compose Message screen 290 (Figure 8E, reproduced below), but that message is simply text, with no ability for media data to be added (the only options being selecting letters 222 or symbols from a dictionary 224).



Eck, Figure 8E.

IV. CONCLUSION

Based on the deficiencies identified above, Petitioners have not shown that they have a reasonable likelihood of prevailing on any of the proposed grounds. The Board should decline to institute an IPR proceeding based on the Petition.

Date: June 17, 2025

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), the undersigned hereby certifies that the foregoing Patent Owner's Preliminary Response to Petition for *Inter Partes* Review contains 9,789 words using the word count feature of Microsoft Word.

Date: June 17, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on June 17, 2025, I caused a true and correct copy of the foregoing Patent Owner's Preliminary Response to Petition for *Inter Partes* Review to be served via electronic mail upon the following attorneys of record for the Petitioners:

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