

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

---

IPR2025-00540  
U.S. Patent No. 8,793,336

---

**PATENT OWNER'S PRELIMINARY RESPONSE**

*35 U.S.C. § 313, and 37 C.F.R. § 42.107(a)*

**TABLE OF CONTENTS**

I.	INTRODUCTION .....	1
	A. Summary .....	1
	B. Prior Art and Asserted Grounds .....	2
	C. The '336 Patent .....	2
II.	PETITIONERS HAVE NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CLAIM CHALLENGED IN GROUND 1 OR 2 .....	3
	A. Relevant Legal Principles.....	3
	B. Ground 1: The Challenged Claims Are Not Obvious Over the Randall-Forsyth Combination.....	6
	1. Petitioners' Combination of Randall-Forsyth is Improper and Lacks a Motivation .....	7
	a) Randall and Forsyth are distinct publications and do not describe the same server.....	7
	b) Petitioners' Stated Motivation to Combine Randall and Forsyth Fails .....	10
	c) No reasonable expectation of success .....	12
	2. Petitioners fail to identify a teaching or suggestion in Randall or Forsyth for the "first web-based interface" (Limitation 1[A]/11[B]/15[B]).....	13
	3. Petitioners fail to identify a teaching or suggestion in Randall or Forsyth for "generating a second web-based interface" (Limitation 1[C]/11[D]/15[D]). .....	18
	4. Petitioners fail to identify a teaching or suggestion in Randall or Forsyth for "generating a given mobile information channel" (Limitation 27[A]). .....	23

C. Ground 2: The Challenged Claims Are Not Obvious Over the Pelkey-Eck Combination .....	25
1. Petitioners’ Stated Motivation to Combine Pelkey and Eck Fails.....	25
2. No reasonable expectation of success.....	31
3. Petitioners Fail to Identify a Teaching or Suggestion in Pelkey or Eck for “first web-based interface” (Limitation 1[A]/11[B]/15[B]).....	32
4. Petitioners Fail to Identify a Teaching or Suggestion in Pelkey or Eck for “generating a second web-based interface different than the first web-based interface” (Limitation 1[C]/11[D]/15[D]). .....	34
III. CONCLUSION.....	37

**TABLE OF AUTHORITIES**

<b>Cases</b>	<b>Page(s)</b>
<i>Abiomed, Inc. v. Maquet Cardiovascular, LLC</i> , IPR2017-01204, Paper 8 (P.T.A.B. Oct. 23, 2017).....	10
<i>Apple Inc. v. Arigna Technology</i> , IPR2022-01037, Paper 9 (P.T.A.B. Dec. 2, 2022) .....	10
<i>CAE Screenplates Inc. v. Heinrich Fiedler GmbH &amp; Co. KG</i> , 224 F.3d 1308 (Fed. Cir. 2000) .....	24
<i>Cisco Sys., Inc. v. C-Cation Tech, LLC</i> , IPR2014-00454, Paper 12 (P.T.A.B. Aug. 29, 2014).....	4
<i>Eli Lilly &amp; Co v. Teva Pharm. Int’l GmbH</i> , 8 F.4 <sup>th</sup> 1331 (Fed. Cir. 2021) .....	5
<i>Enzo Biochem, Inc. v. Gen-Probe Inc.</i> , 424 F.3d 1276 (Fed. Cir. 2005) .....	12, 31
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966).....	4
<i>Harmonic Inc. v Avid Tech., Inc.</i> , 815 F.3d 1356 (Fed. Cir. 2016) .....	3
<i>In re Baxter Int’l, Inc.</i> , 678 F.3d 1357 (Fed. Cir. 2012).....	4
<i>In re Magnum Oil Tools Int’l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016) .....	4, 6, 12, 31
<i>In re NuVasive, Inc.</i> , 842 F.3d 1376 (Fed. Cir. 2016).....	4, 8
<i>In re Schmidt</i> , 892 F.2d 1051 (Fed. Cir. 1989) .....	27

<i>In re Stepan Co.</i> , 868 F.3d 1342 (Fed. Cir. 2017) .....	10
<i>Interconnect Plan. Corp. v. Feil</i> , 774 F.2d 1132 (Fed. Cir. 1985).....	4, 11
<i>Kinetic Concepts, Inc., v. Smith and Nephew, Inc.</i> , 688 F. 3d. 1342 (Fed. Cir. 2012).....	5, 11, 30
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	4, 8
<i>Laitram Corp. v. Rexnord, Inc.</i> , 939 F.2d 1533 (Fed. Cir. 1991) .....	24
<i>Pfizer, Inc. v. Apotex, Inc.</i> , 480 F.3d 1348 (Fed. Cir. 2007) .....	6
<i>Procter &amp; Gamble Co. v. Teva Pharms. USA, Inc.</i> , 566 F.3d 989 (Fed. Cir. 2009) .....	5
<i>Reactive Surfaces Ltd. v. Toyota Motor Corp.</i> , IPR2019-00867, Paper 6 (P.T.A.B. Sep.18, 2019).....	10
<i>Samsung Elecs. Co. Ltd., et al. v. Mobile Data Technologies LLC</i> , IPR2025-00542, Paper 8 (P.T.A.B. June 16, 2025) .....	9
<i>Samsung Elecs. Co. v. Elm 3DS Innovations, LLC</i> , 925 F.3d 1373 (Fed. Cir. 2019) .....	5
<i>Samsung SDI Co. v. Ube Industries, Inc.</i> , IPR2017-02116, Paper 8 (P.T.A.B. Mar. 12, 2018).....	10
<i>W.L. Gore &amp; Associates, Inc. v. Garlock, Inc.</i> , 721 F.2d 1540 (Fed. Cir. 1983).....	4, 11
<i>Wasica Fin. GmbH v. Cont’l Auto. Sys.</i> , 853 F.3d 1272 (Fed. Cir. 2017) .....	12, 31

**Statutes**

35 U.S.C. § 103 ..... 2, 4, 6  
35 U.S.C. § 311 .....10  
35 U.S.C. § 313 .....1

**Other Authorities**

*Consolidated Trial Practice Guide*,  
U.S. Patent & Trademark Office (2019).....4

**Regulations**

37 C.F.R. § 42.107 .....1  
37 C.F.R. § 42.6 ..... 12, 31  
37 C.F.R. § 42.65 ..... 12, 31

**EXHIBIT LIST**

<b>Ex.</b>	<b>Description</b>
2001	E-mail serving amended infringement contentions in EDTX-Litigation
2002	Comparison between the specifications of the '336 and '801 Patents
2003	Petition for <i>Inter Partes</i> Review in IPR2025-00539 (Feb. 7, 2025)
2004	Reserved
2005	Reserved
2006	E-mail from the Board regarding the 539 and 540 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
2012	Reserved
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 (March 31, 2025)
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)

<b>Ex.</b>	<b>Description</b>
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)
2024	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 11, 2025)
2025	E-mail from Petitioners providing materials produced by third-party AT&T Mobility LLC in response to Petitioners' subpoena in the EDTX-Litigation (February 5, 2025)
2026	Patent Owner's Amended Infringement Contentions in the EDTX-Litigation (October 6, 2024)
2027	Petitioners' Invalidity Contentions in the EDTX-Litigation (January 31, 2025)
2028	E-mail exchange between Homayoon Rafatijo and Petitioners' counsel regarding Petitioners' contacting the Board for filing their proposed <i>Sotera</i> stipulation (April 21-23, 2025)
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 sharing with Patent Owner their proposed <i>Sotera</i> stipulation (April 18, 2025)
2031	Reserved
2032	Petitioners' proposed <i>Sotera</i> stipulation for '539 and '540 IPRs (April 21, 2025)
2033	Petitioners' claim chart against '336 Patent based on the Nokia 9210 System (January 31, 2025)
2034	Reserved
2035	Summary of verbatim (or nearly verbatim) matches between the '540 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, <i>EVOLVING AN OPEN ECOSYSTEM: THE RISE AND FALL OF THE SYMBIAN PLATFORM</i> (2013)

<b>Ex.</b>	<b>Description</b>
2038	Bradston Henry, <i>Multiplayer Server Basics   Creating a Multiplayer Game Server - Part 1</i> (Oct. 25, 2021), <a href="https://dev.to/ibmdeveloper/multiplayer-server-basics-ep-1-creating-a-multiplayer-game-server-5aed">https://dev.to/ibmdeveloper/multiplayer-server-basics-ep-1-creating-a-multiplayer-game-server-5aed</a>
2039	Declaration of George Edwards in Regard to the Petitions for <i>Inter Partes</i> Review of U.S. Patent No. 8,793,336
2040	Order of the EDTX court denying Samsung's Motion for Relief from Protective Order
2041	Redacted version of Samsung's Motion for Relief from Protective Order filed in the EDTX-Litigation (May 29, 2025)
2042	Patent Owner's and Meta's February 21, 2025 joint email to the Board regarding the settlement of the MDT-Meta-Litigation and Meta-MDT-IPRs
2043	U.S. Design Patent 753,156 Assigned to Samsung
2044	Prosecution History of the U.S. Design Patent 753,156 Assigned to Samsung
2045	Reserved
2046	Petitioner's Authorized Reply to Patent Owner's Preliminary Response (IPR2021-00917, Paper 7, Sept. 22, 2021)
2047	Declaration of Kevin Jakel in IPR2021-00917 (May 11, 2021)
2048	Petition for Inter Partes Review in IPR2024-00246 (Dec. 6, 2023)
2049	Petition for Inter Partes Review in IPR2025-00538 (Feb. 3, 2025)
2050	Declaration of Mahdi Eslamimehr for IPR2025-00540 of U.S. Patent No. 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. 8,793,336 (the “’336 Patent”), filed by Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioners”), challenging claims 1-3, 6-16, 19-21, and 23-27 (the “Challenged Claims”) of the ’336 Patent. Paper 3, 2 (“’540 IPR Petition” or “Petition”). Institution should be denied because Petitioners fail to meet their burden to show a reasonable likelihood they would prevail with respect to at least one claim challenged in the Petition.

## **I. INTRODUCTION**

### **A. Summary**

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 a “first web-based interface,” “generating a second web-based interface,” and “generating a given mobile channel.” These are each independent reasons for why an IPR trial should not be instituted.

Furthermore, Petitioners have failed to provide a reasoned analysis of how and why a person of ordinary skill in the art (“POSITA”) would combine the prior art for at least two distinct reasons. First, Petitioners have failed to provide a

reasoned analysis that would have motivated a POSITA to combine Randall and Forsyth or Pelkey and Eck. Second, Petitioners have also failed to provide any meaningful discussion of a reasonable expectation of success, which is a separate and distinct point of analysis in any obviousness inquiry. Because Petitioners have not met their burden, institution of this IPR should be denied.

### **B. Prior Art and Asserted Grounds**

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

<b>Ground</b>	<b>Challenged Claims(s)</b>	<b>References</b>
1	1-3, 6-16, 19-21, 23-27	Randall (Ex.1005) and Forsyth (Ex.1006)
2	1,6-11, 13-16, 20-21, 23-25	Pelkey (Ex.1007) and Eck (Ex.1008)

### **C. The '336 Patent**

The '336 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 July 29, 2014. Ex.1001 (face).

In one embodiment, the '336 Patent describes an innovative method for providing a first web-based interface accessible to a first user for the user to activate a given mobile information channel for sharing content between the first user and one or more additional users.

The '336 Patent also describes generating a second web-based interface that provides each of the additional users access to at least a portion of the shared content via the mobile information channel to facilitate interaction between the first user and the additional users.

The '336 Patent also describes the mobile information channel supporting messaging between the first user and the additional users over a wireless network, and being configured to permit the first user to send and receive messaging content with the additional users. *See, e.g.*, Ex.1001, 2:8-58.

## **II. 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 this Response, the Board need only consider the validity of independent claims 1, 10, 11, 15, and 27. As discussed below, MDT and its expert Mahdi Eslamimehr, Ph.D (Ex.2050) demonstrate that the Petition fails to establish a reasonable likelihood that Petitioners will prevail and thus an IPR trial should not be instituted.

### **A. Relevant Legal Principles**

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 PTAB Consolidated Trial Practice Guide advises that a petitioner must “focus on *concise, well-organized, easy-to-follow arguments supported by readily identifiable*

*evidence* of record.” CTPG, 39. 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.”); *see also, e.g., Kinetic Concepts, Inc., v. Smith and Nephew, Inc.*, 688 F. 3d. 1342, 1369 (Fed. Cir. 2012).

For a combination of prior art references to render a claimed invention obvious, at the time the invention was made a POSITA must have (1) been motivated to combine the teachings of the prior art references and (2) had a reasonable expectation of success in making such combination. *See, e.g., Samsung Elecs. Co. v. Elm 3DS Innovations, LLC*, 925 F.3d 1373, 1380-81 (Fed. Cir. 2019) (holding that a patent challenger must show both a motivation to combine and a reasonable expectation of success; affirming Board’s finding of lack of reasonable expectation of success despite that the references were in the “same technological field”); *Eli Lilly & Co v. Teva Pharm. Int’l GmbH*, 8 F.4<sup>th</sup> 1331, 1344 (Fed. Cir. 2021) (“[W]e must first emphasize the clear distinction in our case law between a patent challenger's burden to prove that a skilled artisan would have been motivated to combine prior art references and the additional requirement that the patent challenger also prove that the skilled artisan would have had a reasonable expectation of successfully achieving the claimed invention from the combination.”); *see also Procter & Gamble Co. v. Teva Pharms. USA, Inc.*, 566 F.3d 989, 994 (Fed. Cir. 2009) (“A party seeking to invalidate a patent based on

obviousness must demonstrate ‘by clear and convincing evidence that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.’” (quoting *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1361 (Fed. Cir. 2007))). It is Petitioner’s burden to demonstrate **both** 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, 10, 11, 15, and 27 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 and they provide no support that a POSITA would have a reasonable expectation of success. 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**

**a) Randall and Forsyth are distinct publications and do not describe the same server**

Randall and Forsyth are distinct publications. 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, Petitioners' expert treats them as describing the same system and application. Petitioners' expert premises his opinion on the fact that "Randall and Forsyth were both assigned to [Symbian] and describe different aspects of functionality provided by Symbian." Ex.1003, ¶43. 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, ¶44 (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.2050, ¶¶69-71.

By Petitioners' 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. 2050*, ¶71.

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. Tellingly, with regard to claim 11, Petitioners argue “The Randall-Forsyth combination discloses *a server*”. Petition, 19. The Petition repeatedly refers to the “Forums server,” as if it were a single, identified server. Petition, 20, 21 (“*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.*, 21 citing Exs.1005, 1006; *id.* citing Ex.1003, ¶90 (“Randall and Forsyth also disclose or suggest the ‘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, ¶82; *see also* ¶90 (“**Both** Randall and Forsyth describe that *the server* performs...”) (emphasis added), ¶53 (describing the “Symbian Forums server” functionality with reference to Forsyth and Randall’s “ServML” implementation), ¶69 (“Forsyth enhances the functionality of *the Symbian infrastructure*”).

Concerning the “mobile information channel” (1[A]/ 9B), Petitioners also treat “Forums” as a singular application across references: “Forums, *described by Randall and Forsyth*, is *group-based, two-way communication platform*” (Ex.1003, ¶185 (emphasis added)). After concluding that “[o]ne application discussed in Randall using its data architecture is Forums” (Ex.1003, ¶45), the expert turns to Forsyth as describing Forums (*id.* ¶46). There is no acknowledgement that Randall and Forsyth are separate publications and embodiments.

That each of Randall and Forsyth mention Symbian or Forums is not enough for Petitioners and Houh to combine the disclosures without explanation, as they

have done. *Inter partes* reviews are limited to publication art, and the references should be treated as such and not as if they are directed to the same system or application. See 35 U.S.C. § 311 (b); see also Ex.2050, ¶71. At a minimum, they are different references, so combining them requires competent explanation, which Petitioners have not provided. See, e.g., *Reactive Surfaces Ltd. v. Toyota Motor Corp.*, IPR2019-00867, Paper 6, 8 (P.T.A.B. Sep.18, 2019) (explaining that even when “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*”) (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).

**b) Petitioners’ 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. His premise for combining is “to enhance the Forums service taught by Randall.” Petition, 13 (citing Ex.1003, ¶¶73-79). 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, ¶75 (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 is not connected to the Forums service and has nothing to do with “enhanc[ing] the Forums service.” See Ex.2050, ¶¶72-77. It therefore cannot serve as a motivation to combine.

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, ¶73), 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. 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. 2050, ¶73. 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. Furthermore, each of Randall and Forsyth describe a system that independently operates and there is thus no reason for a POSITA to combine the features of both systems. See, e.g., *Kinetic Concepts, Inc.*, 688 F.3d. at 1369 (“[b]ecause each device independently operates effectively, a person having ordinary skill in the art, who was merely seeking to create a better device [for the

same function], would have no reason to combine the features of both devices into a single device.”). *See* Ex. 2050, ¶77.

**c) No reasonable expectation of success**

It is Petitioner’s burden to demonstrate both 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. First, as established above, Petitioners have not established any motivation to combine Randall and Forsyth; this failure alone is dispositive. Second, Petitioners make only conclusory statements regarding a reasonable expectation of success. Petition, 16. This is plainly insufficient, as “attorney argument is no substitute for evidence.” *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005). The Federal Circuit has held that “a party’s unsworn attorney argument... is not evidence” and cannot rebut record evidence. *Wasica Fin. GmbH v. Cont’l Auto. Sys.*, 853 F.3d 1272, 1284-85 (Fed. Cir. 2017).

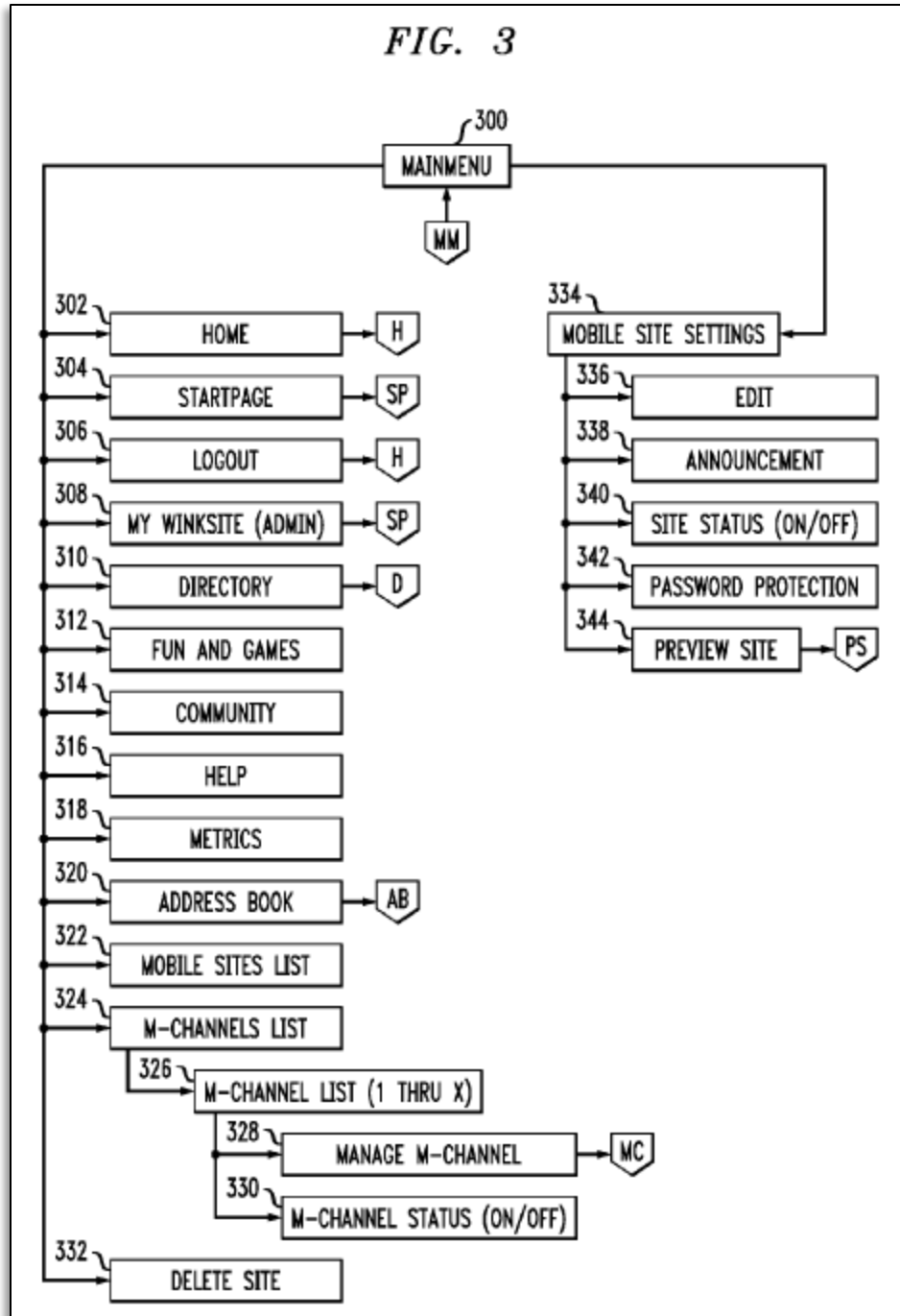
Petitioners’ reliance on their expert’s testimony (Petition, 16) does not cure the deficiency, as the expert merely repeats the conclusory assertion without any meaningful analysis. Ex.1003, ¶81. This fails to meet the evidentiary requirements of 37 C.F.R. § 42.65(a) and improperly circumvents the prohibition on incorporation by reference under 37 C.F.R. § 42.6(a)(3).

**2. Petitioners fail to identify a teaching or suggestion in Randall or Forsyth for the “first web-based interface” (Limitation 1[A]/11[B]/15[B]).**

For limitation 1[A]/11[B]/15[B], namely “providing a first web-based interface accessible to a first user,” Petitioners completely miss the mark. Petitioners misread limitation [1A] by treating the phrase “web-based interface” as a wireless network link that can communicate with servers “in any manner over any kind of network, such as GSM or UMTS, CDMA and WCDMA mobile radio, Bluetooth, 802.11, [and] IrDa etc.” Petition, 24. That interpretation ignores the intrinsic evidence showing the “first web-based interface” is a *human-facing content-management page*. See Ex. 2050, ¶78. The specification discloses this by first saying that the system “provides at least one *content-management site* accessible to a *system user*,” and the “content management site makes it simple for unsophisticated users to upload, enter, create, syndicate, distribute or otherwise manage content that is important to them.” ‘336 Patent, 5:10-12, 10:28-32. It further describes the home menu page of that content management site, where the “text and graphics of the home page 100, although initially the same for both registered and unregistered users, may be periodically updated or otherwise customized to *display account information or other information* that is unique to a registered user, upon login of such a user” (*Id.* 11:5-9, emphasis added), as well as “[t]he main menu page 300 provides a user interface comprising a series of display regions denoted by blocks

302 through 344, each associated with a corresponding user-activatable hypertext link or other control mechanism.” *Id.* 11:34-37.

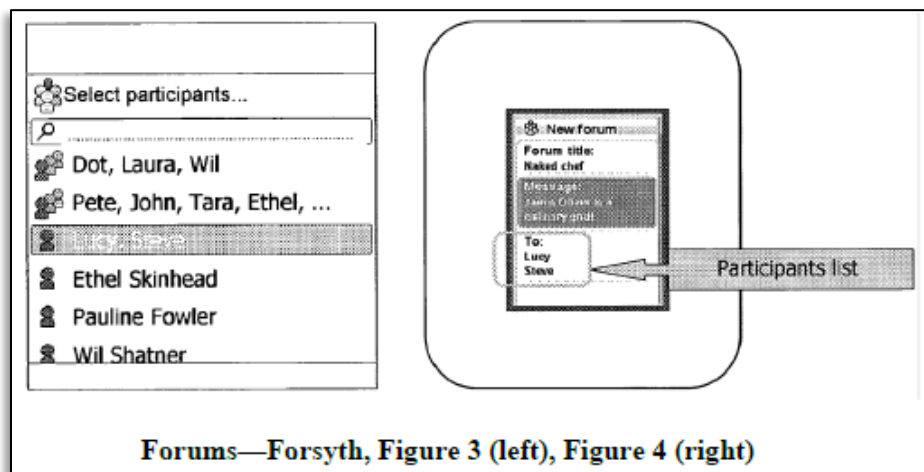
For example, ‘336 Figure 3 below is a user interface for “a main menu page 300 of the example content management site” (‘336 11:32-33) as required in claim 1. This is the “first web-based interface” contemplated by the patent in claim 1. The first user interface relates to a content management site, as described above. “By utilizing the content management site, system users can create one or more personal or business mobile sites with various sets of features, and then share such sites via the mobile Internet or other wireless network with friends, family, colleagues, or other groups of any type.” ‘336 Patent, 10:24-28.



'336 Fig. 3.

Petitioners also assert that a “first web-based interface” is disclosed by the image below, which allegedly describes the creation of a new Forum. Petition, 29.

Petitioners reason that because the Forum is created, it will “provide a platform through which users share content by posting/sending the content to Forum via the server,” and thus “is therefore a first web-based interface.” Petition, 29-30. However, as discussed above, this is not equivalent to the site management interface as disclosed in the specification. For example, Petitioner’s purported interface does not include a means for managing an M-Channel (328), or turning an M-Channel on or off (330). It merely allows a user to name the forum, select participants, and add an initial message. Furthermore, the starting of a new “Forum” is *not* “web-based.” According to Forsyth, “[t]o start a Forum, a user sends a short message to his chosen recipients. To do this, the user/Forum creator enters a SMS-style message and Forum title into the wireless communication device.” Forsyth, 5:45-48. There is no discussion of ever accessing a web site or content management site – a Symbian user simply sends a text message to a group of recipients. *See* Ex. 2050, ¶79.



In addition, Petitioners ignore the fact that the “first web-based interface” corresponding to a content management site will also have a corresponding URL. This is an explicit requirement as disclosed in the ’336 patent, stating that a “user accesses the home page 100 [of the content management site] by entering a corresponding uniform resource locator (URL) in a web browser of their associated user device.” ’336 Patent, 10:50-53. However, both Randall and Forsyth are completely silent as to this capability. In fact, Forsyth (Petitioners’ reference of choice for all of the user interfaces) does not even disclose the term “URL,” further highlighting that the combination does not teach this limitation. *See* Ex. 2050, ¶80. Petitioners attempt to remedy this by referring to Randall’s “ADS Number,” which is merely, as admitted by Petitioners, “in effect a pointer to entity specific data held on the **web server**, in this case, Alice’s information.” Petition, 27 (citing EX-1005, 64:27-28.). It is therefore *not* a first web-based interface as contemplated by the ’336 patent.

Moreover, seemingly to address this omission, Petitioners erroneously attempt to describe Randall’s table “Alice’s iData” as a content management user interface. Petition, 30-31. This is completely inaccurate. The graphic, while showing a list of settings and personal data (e.g. contact information, calendar entries, photos, current mood) for a user named “Alice,” does not have any of the *control* features as described above in ’336 Fig. 3. For example, there is no provision whatsoever for

managing M-channels, websites, or mobile sites. In fact, Randall describes the “Alice” table by concluding “a view of *this database* would be provided on Alice's mobile device to allow her to manage her *data*.” Randall, p.66 at 19-20 (emphasis added). Also, since it is provided for use by a *mobile device*, it is not being provided for the first web-based interface. Thus, it is not intended to be used by the “first web-based interface” as a content management site as described above to generate a second web-based interface, it is merely intended for viewing and managing user data by the user of a mobile device. *See* Ex. 2050, ¶81.

**3. Petitioners fail to identify a teaching or suggestion in Randall or Forsyth for “generating a second web-based interface” (Limitation 1[C]/11[D]/15[D]).**

For limitations 1[C]/11[D]/15[D], namely “generating a second web-based interface different than the first web-based interface,” Petitioners again fail to identify a teaching or suggestion in Randall or Forsyth for these limitations.

The ’336 patent draws a distinction between (i) the “first web-based interface” for a site that a creator uses to build a *mobile information channel* and (ii) the “second web-based interface” for a *mobile web site* that becomes publicly available after the mobile information channel has been built. As explained, “[t]he content management site of the system 10 in the illustrative embodiment thus allows a user to *manage content for access via the mobile devices* 15 by interaction with one or more specified M-channels.” ‘336 Patent, 14:7-11 (emphasis added). The mobile

information channels ‘are also referred to as “M-channels’ herein.” *Id.*, 5:21-22. Thus, the first user interface, associated with the content management site as explained above, allows “unsophisticated users to *upload, enter, create, syndicate, distribute or otherwise manage content* that is important to them, in a manner that allows such content to be accessed, shared, and acted upon from a mobile device.” *Id.*, 10:28-34. In other words, the *operations* of the second web-based interface are completely *dependent* on the first web-based interface.

In contrast to this distinction in the ‘336 Patent between the first and second web-based interfaces, when addressing the second web-based interface, Petitioners merely point to a figure from Forsyth showing a Forums discussion on a mobile device, and state it “is different from the ‘first web-based interface’ (e.g., the network communications interface, the content management user interface, the New Forum user interface, or the Forum Reply user interface).” Petition, 37. In fact, Petitioners expend no effort at all with reference to the term “generating.” *See* Ex. 2050, ¶83. However, even ignoring Petitioners’ indecision of which interface constitutes the first web-based interface, Petitioners never establish that Randall or Forsyth teach or suggest a “second web-based interface” consistent with the specification. That is, Petitioners fail to identify any user interface that is a *mobile web site* that becomes publicly available after the content management site has been employed by the user.

The generation of a second web-based interface is well-defined in the '336 specification, and the Randall-Forsyth combination fails to disclose it. For example, “[t]he content management site in the illustrative embodiment is designed to *generate and otherwise manage* dynamic, time-sensitive, task-oriented *mobile sites*, including wireless collaborative workspaces and communities.” ’336 Patent, 10:8-23 (emphasis added). Thus, the content management site allows users to “create one or more personal or business mobile sites with various sets of features, and then share such sites via the mobile Internet.” *Id.*, 10:24-27 (emphasis added). “The generation of a given *mobile site* and the management of the content associated therewith is driven in the illustrative embodiment from the content management site at the server side of the system, accessible via a standard browser.” *Id.*, 18:32-40. This means the interfaces according to the invention will have a unique URL which is accessible from a browser<sup>1</sup>. However, Petitioners never point to a *mobile site* or

---

<sup>1</sup> “A positive determination in step 2114 results in the execution of content and/or data device formatting step 2116, database entry creation step 2118, and site URL and redirect file creation step 2120. *The URL is used to access the mobile site that 30 is created as a result of the FIG. 21 process.*” ‘336 Patent, 16:25-30, emphasis added. This clearly demonstrates that the second web-based interface has a specific URL, and the interface can be accessed via the URL.

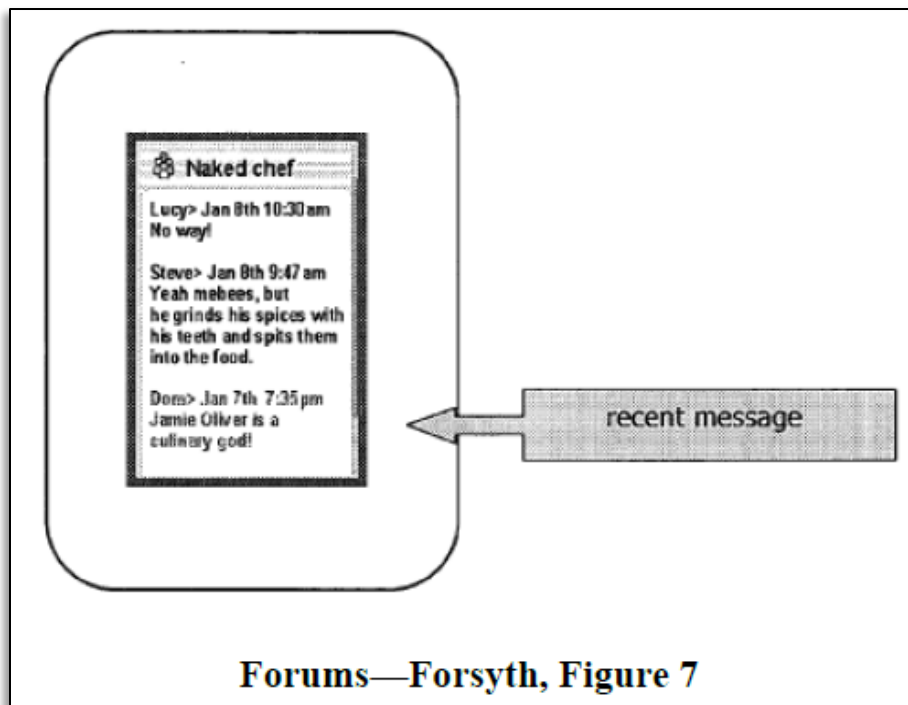
any user interface that is represented by a website or a URL. *See* Ex. 2050, ¶84. In fact, Neither Randall nor Forsyth ever indicate that each of the Forums has an individual URL. To the contrary, Forsyth states clearly that “FIGS. 2-11 are screen shots of the display of a wireless information device *running the Forums application.*” Forsyth, 3:62-63, emphasis added. Therefore, Forsyth’s forums are simply discussion groups running inside the Forums application (and accessed therethrough) and *cannot* be accessed by a particular URL. To this point, Petitioners contend that a *Forums server* “handle[s] all aspects of storing and forwarding messages to the intended recipients.” Petition, 36. Petitioners also allege “the Randall-Forsyth combination teaches or at least suggests user interfaces provided by Forums are web-based information generated by the server and provided to the wireless devices (e.g., via a website downloaded.)” Petition, 38 citing Petition §V.B.6.a.(2). To support this assertion, Petitioners refer to (Petition, 26) a passage in Randall that discusses “ADS Numbers,” as follows in its entirety:

An ADS Number is the most prominent and public aspect of the ADS system. It is in one implementation an address on a web server - for example [www.indirect.com/Alice](http://www.indirect.com/Alice). (Other less visible approaches are also possible). This address is in effect *a pointer to entity specific data held on the web server, in this case, Alice's information.*

Randall, 64:25-28

*First*, this use of an “ADS Number” does not indicate that Randall discloses a specific URL for a “second web-based interface” for a Forums discussion as shown

in Forsyth Figure 7 (shown below) as put forth by Petitioners. The ADS system is described in Randall as “a general purpose architecture which can be used by many different applications which require information sharing; it is in essence a framework.” Randall, 10:4-5. It is in fact *a database network*, where an “application resident on the device queries and receives data from the remote, extensible database.” *Id.*, 7:21-22. Thus, it is merely a repository of data that can be used by applications; it is *not the application itself* (e.g. Forums). See Ex. 2050, ¶85.



Petition, 37.

*Second*, Petitioners point to this *exact same disclosure* for support of the “first web-based interface.” See Petition, 26. In that instance, Petitioners attempt to argue that the “Alice” data table acts as a content management site (it doesn’t). See §III.B.2

above. This glaring inconsistency indicates that the Randall Forsyth combination never discloses a “second web-based interface” that is accessible via a URL, and there is no indication that the second interface is accessible in any way other than running the Forums application. *See* Ex. 2050, ¶¶86-87.

This closed Forums system teaches directly away from the inventive concept of the patent, which states “another advantage of the system described in conjunction with the illustrative embodiment is that it does not require users to download and install any particular client-side software.” ’336 Patent, 18:32-35. Forums, as an application created by Symbian, requires a software download to operate it.

Thus, Forsyth’s multiple Forums interfaces, accessible only via the Forums application and not via a URL, are not the equivalent of “generating a second web-based interface different than the first web-based interface.”

**4. Petitioners fail to identify a teaching or suggestion in Randall or Forsyth for “generating a given mobile information channel” (Limitation 27[A]).**

For limitation 27[A], namely “generating a given mobile information channel,” Petitioners get it wrong again, merely pointing to their arguments for the disclosure of a mobile information channel as used in their arguments for Claim 1 limitation “activate a given mobile information channel for sharing content” of §V.B.6.a.(3).(a). Petition, 41. This fails for several reasons.

*First*, this fails on its face because the claim language of limitation 27[A] is different than that of Claim 1, namely “**generating** a given mobile information channel” in Claim 27[A] vs. “**activate** a given mobile information channel” in Claim 1. Re-defining the claims so that “generate” means merely “activate” would therefore rewrite the claim language and erase the drafter’s deliberate differentiation. Federal Circuit precedent confirms that such a rewrite is impermissible. The court must “presume that the use of ... different terms in the claims connotes different meanings.” *CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1317 (Fed. Cir. 2000). Likewise, “differences among claims can also be a useful guide in understanding the meaning of particular claim terms.” *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1538 (Fed. Cir. 1991). Collapsing distinct words violates that canon.

*Second*, as described above, ’336 Fig. 21 discloses an exemplary process for the generation of a web-based interface, and this includes blocks 2122-2146 that describe the “M-Channel Wizard” for generation of an M-Channel. *See* Ex. 2050, ¶¶89-90. As discussed, the Randall-Forsyth combination does not disclose anything in this regard, specifically generating a discussion forum that can be accessed via a browser at a URL. Moreover, the ’336 specification distinguishes between generation and activation, noting “the process generates the appropriate rules for the

display engine in step 2132, and then *activates or otherwise generates* one or more M-channels for the mobile site in step 2134.” ’336 Patent, 16:35-38, emphasis added.

Thus, Petitioners have failed to show the prior art teaches or suggests “generating a given mobile information channel.”

**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 independent claims 1, 10, 11, and 15 of the ’336 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, 58.

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, ¶212; Petition, 59);

(ii) Pelkey does not describe integration of messaging and sharing content like photos with multiple users (Ex.1003, ¶213);

(iii) Pelkey does not describe any in-game messaging (Ex.1003, ¶213; Petition, 60); and

(iv) Pelkey does not disclose details of the wireless network used to provide wireless messaging from the game system to the server (Petition, 66; Ex.1003, ¶228).

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, ¶213.)" Petition, 59. This is contrary to the teaching of Eck, which solves any issue regarding "cost" an entirely different way. *See* Ex. 2050, ¶¶92-96. 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. 2050, ¶¶95-96; *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 have made no showing regarding the cost savings allegedly available for a user using the client server architecture of Pelkey, which is also a charge-based service. *See* Ex. 2050, ¶95. Instead, Petitioners improperly rely on their expert’s conclusory statement.

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*, 59 (citing Ex.1003, ¶213; Ex.1008, 10:13-19). The statement is telling: Petitioners are suggesting both a modification to Eck’s “pager cartridge” and a modification of Pelkey. However, Petitioners never explain what either modifications would actually be. *See* Ex. 2050, ¶98.

This is a glaring failure given the fundamentally different architectures of Pelkey (client-server) and Eck (peer-to-peer) (*See* Ex. 2050, ¶¶97-98) and Petitioners' (and their expert's) very next statement that "Pelkey does not describe any game play that includes in-game messaging in conjunction with the aforementioned features" (Petition, 60). Petitioners present no evidence—not even a conclusory statement from their expert—to support that a user would consider any messaging disclosed in Eck to foster the features in Pelkey of "exploration and adventure," "chat and community interaction," and "character growth."

Furthermore, 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, 60 (citing Ex.1003, ¶213). But Petitioners' expert never explains what those modifications would be given differences in operation of a game system using a client-server based messaging platform via a modem and a wide area network (Pelkey) versus a specific device-to-device paging system over a paging network that allows two users to communicate while playing a portable game device (Eck) and fundamentally different network architectures. *See* Ex.2050, ¶100. Indeed, Petitioners' 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.2050, ¶100.

Potential issues not addressed by Petitioners or their expert, include, for example, redesigning the game cartridge interface to accommodate differing electrical and communication protocols between the pager and GSM/WAP systems, addressing increased power consumption and battery management demands typical of GSM or WAP devices, implementing necessary changes in software drivers and firmware to manage GSM/WAP-specific network registration, messaging protocols, and error-handling routines, and ensuring robust signal integrity and electromagnetic compatibility, particularly given the distinct operational frequency bands and interference concerns of GSM/WAP compared to paging systems. *See* Ex. 2050, ¶100.

Regardless, Petitioners’ motivation to combine is technically baseless and contradictory. Pelkey’s described network architecture is both fundamentally incompatible with Eck’s messaging system and is completely unnecessary. However, Petitioners claim that it is necessary to adopt Pelkey’s client-server network architecture to avoid the charge-based messaging system disclosed in Eck

and obtain “internet-based functionality.” Petition, 60-61. First, this assumption is based on the false choice that a POSITA must abandon the peer-to-peer (P2P) network architecture disclosed in Eck to operate on anything other than the pager-network infrastructure described in Eck. This is based on the false conclusion that such a drastic change to Eck is necessary to obtain internet-based functionality. *See* Ex. 2050, ¶¶98-99. Rather, network architecture and infrastructure are two distinct things. Ex.2050, ¶97. Thus, there is no inherent need whatsoever for a POSITA to look to Pelkey to adapt Eck’s messaging system to a different network infrastructure.

Second, Petitioners and Houh illogically suggest that the combination of Pelkey and Eck would yield a system that operates over a GSM-SMS network infrastructure. Ex. 1003, ¶¶276-79. This type of network is also a charge-based system for exchanging messages—especially at the time of the priority date—which completely contradicts Petitioners’ stated cost reason for a motivation to combine. Ex. 2050, ¶95. Thus, it is nonsensical for a POSITA to attempt a complicated redesign of the Eck network architecture for Pelkey’s to merely substitute a cost model that is comparably the same as the one a POSITA is trying to avoid. *See, e.g., Kinetic Concepts*, 688 F. 3d. at 1369 (“[b]ecause each device independently operates effectively, a person having ordinary skill in the art, who was merely seeking to create a better device [for the same function], would have no reason to combine the features of both devices into a single device.”).

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 '336 Patent claims.

## **2. No reasonable expectation of success**

As above, it is Petitioner's burden to demonstrate both 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. First, as established above, Petitioners have not established any motivation to combine Pelkey and Eck; this failure alone is dispositive. Second, Petitioners make only conclusory statements regarding a reasonable expectation of success. Petition, 60. This is plainly insufficient, as "attorney argument is no substitute for evidence." *Enzo Biochem*, 424 F.3d at 1284. The Federal Circuit has held that "a party's unsworn attorney argument... is not evidence" and cannot rebut record evidence. *Wasica*, 853 F.3d at 1284-85.

Petitioners' reliance on their expert's testimony (Petition, 60) does not cure the deficiency, as the expert merely repeats the conclusory assertion without any meaningful analysis. Ex.1003, ¶248. This fails to meet the evidentiary requirements of 37 C.F.R. § 42.65(a) and improperly circumvents the prohibition on incorporation by reference under 37 C.F.R. § 42.6(a)(3).

**3. Petitioners Fail to Identify a Teaching or Suggestion in Pelkey or Eck for “first web-based interface” (Limitation 1[A]/11[B]/15[B]).**

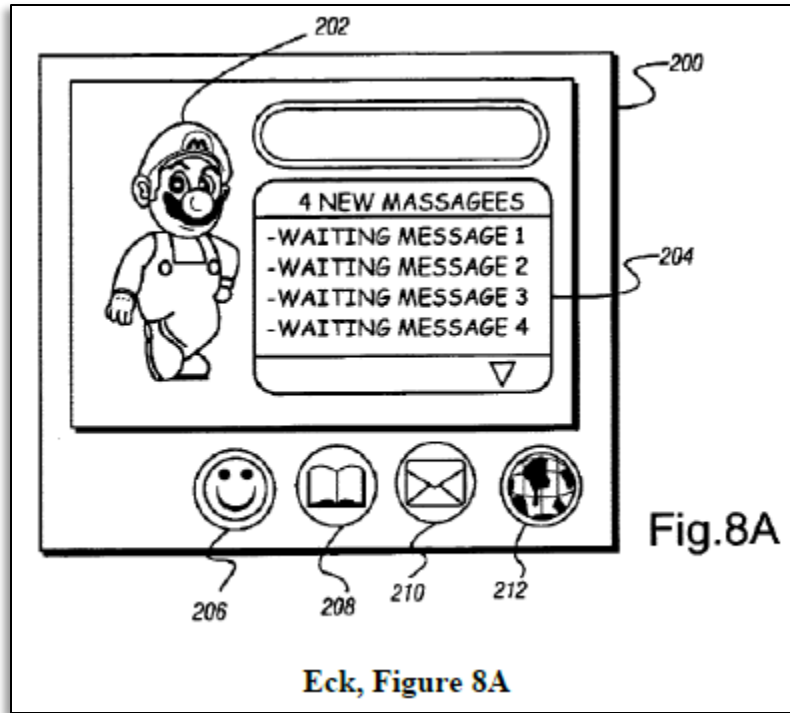
Even if the combination of Pelkey and Eck were proper, Petitioners fail to present a prima facie case that the combination teaches the “first web-based interface” as recited in at least limitation 1[A].

As discussed above for limitation 1[A] for Randall/Forsyth, the ‘336 Patent specification clearly defines the “first web-based interface” as a user interface for a content management site. The Pelkey/Eck combination falls woefully short.

The only mention of “content management” with reference to Pelkey/Eck is the conclusory statement that the “combination of Pelkey and Eck discloses “a virtual location at the content management site at which user-authored content may be added for transmission to the mobile web site” under Meta’s proposed construction in the MDT-Meta-Litigation. Ex. 1003, ¶235, Petition, 70. This falls far short of the description in the ‘336 specification. Regardless, Petitioners plow ahead by alleging “the ‘*first web-based interface*’ is the PagerWorld main screen.” Petition, 72. This main screen allegedly “permits users to activate the content sharing features in PagerWorld (e.g., messages, customizing persona using photos) when the user selects such features from the mains screen.” Petition, 72 (citing Eck, 10:32-40). Again, this paltry disclosure does not even come close to the content management site as required by the defined “first web-based interface.” Ex. 2050, ¶102.

For example, Petitioners use the image below from Eck to show “the main screen 200.” Petition, 65. Petitioners describe this main screen as giving users “choices including “Icon 206 (‘My Persona’) [which] is a face; icon 208 [which] is a book (‘Pager Lingo’); icon 210 [which] is an unopened envelope (‘Message Center’); and icon 212 [which] is a globe (‘PagerWorld’).” (EX-1003, ¶230 (citing EX-1008, 10:65-11:7).)” Petition, 65. This is the full extent of disclosure of anything resembling a content management site. Ex. 2050, ¶101.

This is not a content management *site*. It is merely a user screen on a portable gaming device that allows users to choose an icon for their player, and to allow access to various other functions such as messages and the “Pager World” application. There is no indication that this screen allows customization or generation of a separate interface in any way, other than selecting a user icon. Again, this is vastly different from and inadequate in comparison to the requirements of the ’336 specification and is therefore not equivalent. *See* Ex. 2050, ¶101.



Eck, Figure 8A

Petition, 65.

Moreover, nowhere in either Pelkey or Eck is it disclosed that this first “web-based interface” corresponds to a URL. As explained in §II.B.2, this is an explicit requirement as disclosed in the ’336 patent. However, both Pelkey and Eck are completely silent as to this capability. In fact, Eck (Petitioners’ reference of choice for all of the user interfaces) does not even disclose the term “URL,” further highlighting that the combination does not teach this limitation. *See* Ex. 2050, ¶103.

**4. Petitioners Fail to Identify a Teaching or Suggestion in Pelkey or Eck for “generating a second web-based interface different than the first web-based interface” (Limitation 1[C]/11[D]/15[D]).**

As discussed at length above in §II.B.3, the ’336 Patent specifically discloses details about the generation of the second interface as a function of specific user

inputs that are entered into a content management site. Petitioners fail to point to any such disclosure in Pelkey or Eck.

For disclosure of limitations 1[C]/11[D]/15[D], Petitioners focus their discussion mainly on the fact that the interfaces for an address book (Eck, Figure 8G) and a file cabinet (Eck, Figure 8E) are *different* from the “main” interface as shown in Eck Figure 8A. Petition, 72-74. However, Petitioners are completely silent as to the *generation* of such interfaces, which is the principal action in this claim limitation. Again, Petitioners provide no analysis or disclosure of how the address book and file cabinet interfaces are *generated* using the inputs provided to the first web-based interface. *See* Ex. 2050, ¶105.

For example, regarding Figure 8E, Eck explains that the file cabinet in figure 8E can be reached from the screen shown in Figure 8C, such that “[s]electing File Cabinet icon 234 takes the user to a File Cabinet screen 270 shown in FIG. 8E.” Eck, 11:26-40. Likewise, for the address book in Figure 8G, it presents itself similarly: “selecting Address Book icon 238 takes the user to an Address Book screen 309 shown in FIG. 8G.” *Id.* Thus, as opposed to “generating a second web-based interface” as required by the claim, Eck’s various interfaces are summoned merely by clicking on icons. This indicates that they are not *generated*, but are simply pre-fabricated, and are filled with information as entered by the user. There are no chosen options in terms of any of the variables as shown in ’336 Figure 21 such as in steps

2100 through 2120, and certainly no disclosure of an M-channel creation wizard as 2122 through 2146.

More importantly, Petitioners never point to a *mobile site* or any user interface that is represented by a website or a URL in Pelkey or Eck. As with the Randall-Forsyth disclosure, Eck states that “FIGS. 8A-8H show various screens that are part of the interface conceptually shown in FIG. 7,” while “FIG. 7 is a conceptual block diagram of an interface for pager cartridge 100 when it is connected to game machine 10.” Eck, 2:51-56. Therefore, the Pelkey-Eck forums are simply discussion groups running on a game console with a pager accessory attached and running specific Nintendo-authored software. These forums cannot be accessed by a particular URL. Ex. 2050, ¶106.

To this point, Petitioners contend that the “second interfaces are ‘web-based’ for the same reasons set forth above in §VI.B.5.” Petition, 73 (citing EX-1003, ¶245.). In §VI.B.5, Petitioners state that “PagerWorld includes *client software* in the portable game machine (client program) and *corresponding software* in the server (server program).” Petition, 69 (citing EX-1008, 4:61-5:7, 9:40-59.). Therefore, to access the forum, a Nintendo device would need to be running proprietary Nintendo software on the client *and* the server, as thus described by Petitioners. This is inconsistent with the ’336 specification, which states “it does not require users to download and install any particular client-side software;” it is also “accessible via a

standard browser;” and can be used “from any type of user device running any operating system.” ‘336 Patent, 18:32-45. The Pelkey-Eck combination discloses *none* of these critical features and therefore *teaches directly away* from the open, “web-based” inventive concept of the patent. See Ex. 2050, ¶¶107-108.

### III. 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: July 14, 2025

Respectfully submitted,

/Eugene Goryunov/

Eugene Goryunov (Reg. No. 61,579)  
Homayoon Rafatijo (Reg. No. 80,870)  
**BROWN RUDNICK LLP**  
1900 N Street NW  
Washington, D.C. 20036  
Tel: (202) 536-1700  
Fax: (202) 536-1701

Erick Robinson, Esq. (Reg. No. 51,354)  
Jayme Partridge (Reg. No. 39,011)  
Patrick M. Dunn (Reg. No. 70,474)  
Jayne C. Piana (Reg. No. 48,424)  
**BROWN RUDNICK LLP**  
811 Main Street, 18th Fl.  
Houston, TX 77002  
Tel: (281) 815-0511  
Fax: (281) 605-5699

Ian G. DiBernardo (Reg. No. 40,991)  
**BROWN RUDNICK LLP**  
Times Square Tower, 47th Fl.

7 Times Square  
New York, NY 10036  
Tel: (212) 209-4800  
Fax: (212) 209-4801

*Attorneys for Patent Owner  
Mobile Data Technologies LLC*

**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 7,717 words using the word count feature of Microsoft Word.

Date: July 14, 2025

Respectfully submitted,

*/Eugene Goryunov/*

Eugene Goryunov (Reg. No. 61,579)

*Attorneys for Patent Owner*

*Mobile Data Technologies LLC*

**CERTIFICATE OF SERVICE**

I hereby certify that on July 14, 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:

Lori Gordon (Reg. No. 50,633)  
Goodwin Procter LLP  
1900 N St. N.W.  
Washington, D.C. 20036  
Phone: (202) 346-4000  
Fax: (202) 346-4444  
Gordon-ptab@goodwinlaw.com

Doug Kline (Reg. No. 35,574)  
GOODWIN PROCTER LLP  
100 Northern Avenue  
Boston, MA 02210  
Phone: (617) 570-1000  
Fax: (617) 523-1231  
dkline@goodwinlaw.com

Naomi Birbach (Reg. No. 67,113)  
Goodwin Procter LLP  
620 Eighth Avenue  
New York, NY 10018  
Phone: (212) 813-8800  
Fax: (212) 355-3333  
NBirbach@goodwinlaw.com

Srikanth Reddy  
(*pro hac vice* application to be filed)  
GOODWIN PROCTER LLP  
100 Northern Avenue  
Boston, MA 02210  
Phone: (617) 570-1000  
Fax: (617) 523-1231  
sreddy@goodwinlaw.com

Date: July 14, 2025

Respectfully submitted,

/Eugene Goryunov/  
Eugene Goryunov (Reg. No. 61,579)  
**BROWN RUDNICK LLP**  
1900 N Street NW  
Washington, D.C. 20036  
Tel: (202) 536-1700  
Fax: (202) 536-1701

*Attorneys for Patent Owner*  
*Mobile Data Technologies LLC*