

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE, INC.,  
*Petitioner*

v.

HBCU MESSAGING US LP,  
*Patent Owner*

IPR2026-00105  
U.S. Patent No. 11,991,600

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**PATENT OWNER'S CORRECTED PRELIMINARY RESPONSE**

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## TABLE OF CONTENTS

I.	INTRODUCTION .....	1
II.	FACTUAL BACKGROUND.....	2
	A. Technical Background .....	2
	B. Apple’s Knowledge of the Patent at Issue and Patent Family .....	5
	1. The ’600 Patent and Its Priority Applications.....	6
	2. A Decade of German Litigation.....	6
	3. U.S. District Court Litigation.....	8
	C. Apple’s Vastly Different Claim Construction Positions at the PTAB Versus in District Court .....	8
	D. The Challenged Claims .....	11
III.	CITED REFERENCES .....	22
	A. Horvath (Ex. 1004) .....	24
	B. Tsampalis (Ex. 1005).....	29
	C. Kansal (Ex. 1042) .....	31
IV.	ARGUMENT.....	33
	A. Petitioner’s Failure to Apply Consistent Claim Constructions Here and in District Court Should Be Rejected .....	34
	B. Petitioner Glosses Over Missing Limitations in Each of the Independent Claims .....	36
	1. The Asserted Art Fails to Disclose the “Third Message” of Claim 1 and Related Elements.....	36
	2. The Asserted Art Fails to Disclose “automatically selecting a bearer for the message” as Recited in Claim 1 .....	39
	3. Petitioner Offers No Further Argument for Any Other Independent Claim, and so the Petition Fails as to Each.....	40
	C. Apple Establishes No Adequate Motivation to Combine the References in the Manner Recited.....	41
	1. Apple’s Purported Motivation to Combine Is Nothing More than Sleight of Hand.....	41

2. Combining These References in the Manner Petitioner Proposes Is Nonsensical .....	43
D. Because Petitioner Has Failed to Show Obviousness of Any Independent Claim, It Has Also Failed to Show Obviousness of Any Dependent Claim .....	46
V. CONCLUSION.....	46

## TABLE OF AUTHORITIES

### Cases

<i>InTouch Techs., Inc. v. VGO Commc'ns, Inc.</i> , 751 F.3d 1327 (Fed. Cir. 2014).....	41
<i>Medichem, S.A. v. Rolabo, S.L.</i> , 437 F.3d 1157 (Fed. Cir. 2006).....	36
<i>Par Pharm., Inc. v. TWi Pharms., Inc.</i> , 773 F.3d 1186 (Fed. Cir. 2014).....	36
<i>W.L. Gore &amp; Assocs. v. Garlock, Inc.</i> , 842 F.2d 1275 (Fed. Cir. 1988).....	35

## TABLE OF EXHIBITS

<b>Exhibit</b>	<b>Description</b>
2022	District Court Litigation, HBCU's August 15, 2025, Proposed Constructions of Claim Terms
2023	District Court Litigation, Apple's August 15, 2025, Proposed Constructions of Claim Terms
2024	District Court Litigation, January 23, 2026, Claim Construction Hearing Transcript
2025	District Court Litigation, January 26, 2026, email from Michael Shore to the District Court
2026	District Court Litigation, January 26, 2026, email response from the District Court
2027	U.S. Patent No. 6,678,524 ("Hansson")
2028	US 2010/0131858 ("Schultz")
2029	IPR2025-00785, Decision Denying Institution of IPR (November 4, 2025)

## I. INTRODUCTION

Petitioner Apple, Inc. (“Petitioner”) filed a Petition for *Inter Partes* Review of claims 1-30 of U.S. Patent No. 11,991,600 (“the ’600 patent”) on October 31, 2025. In addition to the reasons set forth in Patent Owner’s Discretionary Denial Briefing (Paper No. 7), the Petition should be denied on the merits for at least the following reasons.

**First**, Petitioner applies vastly different approaches to claim construction in the Petition versus at District Court. The District Court Judge called out Petitioner’s behavior with concern: “Why are you proffering a construction in this case when you did not proffer one at the PTAB?” (Ex. 2024, January 23, 2026 Claim Construction Hearing Tr. at 24:24-25:1.) As set forth below, those issues have been exacerbated rather than mooted by the Court’s recent *Markman* hearing, its Order, and the Parties communications surrounding both.

**Second**, for each independent claim, the Petition completely fails to demonstrate the presence of every recited element within the collection of asserted references. Thus the Petitioner’s asserted combination, even if made, would fail to disclose every element of even a single independent claim. The Petition thus fails to make out even a prima facie case of obviousness.

**Third**, Petitioner’s supposed motivation to combine is contradicted by its own asserted references. These references not only describe systems that operate in

completely different manners, but any combination would only decrease efficiencies, increase network traffic, and undermine the very goals that the “combination” purports to advance.

For each of these independent reasons, institution of the Petition should be denied.

## **II. FACTUAL BACKGROUND**

### **A. Technical Background**

The '600 patent resulted from the pioneering efforts of Graham Merrett in the field of messaging services, and in particular, the selection of certain services to enhance the operation of messaging systems. The Inventor has multiple patents in this space, and the '600 patent represents just one example of his innovations.

As explained in the patent specification (Ex. 1001, '600 patent at 1:56-59), Short Messaging Service (SMS) is a cellular technology for sending and receiving short text messages between mobile users. It was first introduced in the Global System for Mobile Communications (GSM) standards in the 1990s but was subsequently included in other wireless standards such as Code Division Multiple Access Systems (CDMA).

Although SMS is extremely popular, one of its biggest drawbacks was that an SMS message can only carry a small amount of data, due to limitations imposed by the Mobile Application Part (MAP) protocol of SS7. Previously, an SMS

message could only contain up to 160 8-bit alphanumeric or binary characters and any message longer than 160 characters was usually sent in multiple messages.

(Ex. 1001, '600 patent at 1:66-2:2.)

A Short Messaging Service Center (SMSC) is responsible for handling the delivery of SMS messages in a wireless communications network. An SMS message sent by a mobile user is first delivered to the user's network SMSC before being routed to the recipient. If the recipient's network is operated by a different provider or employs a different wireless standard, the message may pass through more than one SMSC or SMSC gateway before reaching its final destination. Typically, signaling System 7 (SS7) provided the transport mechanism for SMS traffic. (*Id.* at 2:11-12),

Several messaging services acted as extensions to SMS. Enhanced Messaging Service (EMS), which uses existing SMS infrastructure, allowed up to 255 SMS messages to be packaged as one EMS message having richer content such as animation, pictures, sounds and formatted text. Multimedia Messaging Service (MMS) messages allowed yet further functionality and were delivered using a packet data network operating within the cellular system. MMS was first introduced in 2.5 generation networks such as GPRS, which provides an Internet Protocol (IP) overlay to the existing GSM networks. A multimedia message may contain images, audio clips and videos. (*Id.* at 2:23-24.)

As further described in the patent, another technology, Mobile Instant Messaging (MIM), enabled mobile devices to engage in real-time, instant messaging via an internet protocol data network. Users typically needed to register a user name tag or “handle” with an instant messaging service provider to send and receive messages. Many then-current MIM services also required users to maintain a persistent connection with the Internet during a chat session. (*Id.* at 2:29-31.)

The inventions of the '600 patent address multiple gaps in the prior technology, providing a system including that can transmit short message service messages via a cellular network or alternatively packet switched messages via a packet switched message service (PSMS) that operates outside the cellular core network. The system includes a server or collection of servers that support the PSMS and may also maintain status information and queue messages for delivery as needed. (*Id.* at 2:25-3:2.)

In practice, the sending mobile phone sends a request to a server residing outside the cellular core network, querying whether the recipient device address corresponds to a subscriber address. If so, the sending mobile phone sends the message via the PSMS. If not, the sending mobile phone sends the message via SMS. (*Id.* at 11:27-12:9.) The '600 patent also departed from conventional MIM systems by doing away with the requirement that an instant messaging user register

a user nametag or handle for purposes of identifying the user to the system.

Instead, the '600 patent teaches that the user's mobile phone number be utilized as the user's identifier:

The destination address may be a mobile phone number or a numeric "shortcode" or alias representing one or more, or a combination of, phone numbers, email addresses, instant messaging user handles and IP addresses. Therefore, for all users of the messaging service, and unlike conventional MIM clients, the invention utilizes a user's mobile phone number as the identifier of the user, and does not require the user to register a user name, tag or handle, thus providing a single number for message sending.

(*Id.* at 3:36-44.)

The patent also addresses situations in which the recipient mobile phone is not connected to the server when the packet switched message is sent. In that situation, the '600 patent teaches that message may be queued by the server until the recipient device connects to the server. (*Id.* at 4:11-16.) Messages received over both SMS system and the PSMS system are displayed by the same messaging application. (*Id.* at 2:61-3:2.)

#### **B. Apple's Knowledge of the Patent at Issue and Patent Family**

Apple has been aware of the '600 patent's family for at least a decade. That familiarity stems not only from communications between Apple and both the previous and current patent owner but from litigation in multiple jurisdictions over the last decade and the citation of multiple related patents and applications in Apple's own U.S. patents.

## **1. The '600 Patent and Its Priority Applications**

The '600 patent claims priority to two separate 2007 Australian patent applications, AU/2007/903979 (the "AU 979 application") and AU/2007/906230 (the "AU 230 application") (the "Australian applications"). The Australian applications are the parents of a family encompassing dozens of applications and patents worldwide, all of which share the same, single inventor.

Apple cites multiple applications and patents from the '600 patent family in its own patents. For instance, U.S. Pat. App. No. 2014/0295899 ("'899 application"), which resulted in the U.S. Patent No. 8,918,128 (the "'128 patent"), claims priority to the same two Australian applications. The '899 application is cited on the face of Apple's U.S. Pat. No. 12,262,197, (Ex. 2002 at 2), and the '128 patent is cited in Apple's U.S. Pat. No. 11,775,145. (Ex. 2003 at 2.) Another application tracing back to the same Australian applications, U.S. Pat. App. 2014/307184 is cited on the face of four separate Apple patents, U.S. Patents No. 11,743,375, 12,265,696, 12,348,663, and 11,775,145. (Exs. 2004-2007.)

## **2. A Decade of German Litigation**

Prior to assigning the patent to HBCU, the previous patent owner asserted the German equivalent patent against Apple in Germany in 2015. That case led Apple to file a Nullity Action in the German Patent Court. One of the references asserted by Apple in the Nullity Action was the Tsampalis PCT, which has the

exact same substance as the Tsampalis reference asserted in this Petition. Initially, the German patent at issue was found unpatentable, but amended claims were upheld as valid by Germany's highest court. (Ex. 2012, BGH, Judgment of December 15, 2020 - X ZR 120/18 - Federal Patent Court at 1-3.) Of course, as with the claims challenged here, those amended European claims include elements and features different from the original claims of the European patent.

Importantly, as Apple asserted various prior art references and arguments in Germany, the previous patent owner submitted that art to the USPTO in further ongoing prosecution of the '600 patent family. (Likewise, HBCU continues to diligently update the Examiner in the current U.S. prosecution with Apple's invalidity submissions in ongoing U.S. litigation.)

Accordingly, all U.S. patents issued in the family since that time—including the '600 patent at issue—were allowed over the Tsampalis PCT, as well as other prior art submitted by Apple in Germany. (*See* Ex. 1001 at 2 (cover page identifying WO 2004/061583 and other references); *see also* Ex. 2013, EP 2 177 072 (DE document number 60 2008 022 036.2) Nullity Action at 7 (“With respect to the prior art, we refer to the following citations, appended hereto as Exhibits. . . The prepublished international patent application WO 2004/061583 A2, published on 22 July 2004, hereinafter referred to as ‘MOTOROLA’”).)

### **3. U.S. District Court Litigation**

On October 7, 2024, Patent Owner filed a Complaint against Apple in the Western District of Texas, (Ex. 2001, District Court Case, Dkt. 1), followed by a First Amended Complaint (“FAC”) on Jan. 24, 2025 (Ex. 2014, District Court Case, Dkt. 32). The District Court litigation has progressed steadily since. The parties have served their preliminary contentions and fully briefed claim construction. (Ex. 2015, District Court Case, Dkt. 49.) The claim construction hearing took place as scheduled for January 20, 2026. (*Id.* at 2-3.) The case is set for trial in July 2027. (*Id.* at 4.)

#### **C. Apple’s Vastly Different Claim Construction Positions at the PTAB Versus in District Court**

While here Petitioner has stated that “no formal constructions are presently necessary,” (Pet. at 4), and are relying on the plain and ordinary meaning for each term—indeed for every term in all seven related IPRs—Petitioner’s approach in District Court was the exact opposite. Petitioner proposed multiple terms for construction in the District Court, offered various proposed constructions of terms, and sought indefiniteness of one term.

Both parties claim construction proposals were developed and exchanged well in advance of the Petition filing. (Exs. 2022 and 2023, HBCU and Apple’s August 15, 2025 Proposed Construction of Claim Terms.) Thus, Petitioner has zero excuse for failing to make the Board and Director aware of each sides’

proposals, much less for failing to apply even its own District Court proposal within the Petition. This represents a classic case of seeking tactical advantage by applying one claim construction for infringement and another construction validity.

Indeed, Petitioner's inconsistent positions on claim construction risk inconsistent rulings even on the very same prior art asserted in the Petition. The District Court Judge expressed concern regarding this tactic:

THE COURT: I got it. I got it. And so -- and with regard to this claim term, what construction did you proffer at the PTAB?

MR. MALLOY [Apple's Counsel]: We didn't proffer any construction. We were applying the plain and ordinary meanings.

THE COURT: And what's the difference between the PTAB and my Court?

MR. MALLOY: It's the same claim construction standard is my understanding. And what I'm trying to express is that we haven't taken any --

THE COURT: No. I -- maybe my question wasn't clear. ***Why are you proffering a construction in this case when you did not proffer one at the PTAB?***

(Ex. 2024, January 23, 2026 Claim Construction Hearing Tr. at 24:13-25:1.)<sup>1</sup>

The District Court's confusion is understandable, and following the District Court's claim construction Order the risk of inconsistent rulings has only escalated. Specifically, the District Court addressed multiple terms at issue in this Petition:

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<sup>1</sup> Unless otherwise indicated, emphasis in this brief has been added.

“cellular core network,” a series of terms involving the phrase “wherein . . . when,” and “bearer.” Petitioner proposed constructions of each of these terms at District Court, yet neither offered nor applied any construction here.

Petitioner’s failure here is particularly glaring with respect to each of these elements. First, the District Court adopted Patent Owner’s proposed construction of “cellular core network,” an element of multiple claims at issue here. The definition adopted by the Court is lengthy and detailed (*see* Ex. 1116), yet ***none of that language was applied by Apple in its Petition.*** Petitioner’s own proposal in District Court differed substantially from its position here, and yet Petitioner failed to apply it or even mention it within the Petition. Because Petitioner addressed neither the District Court’s construction nor even its own proposed construction, it is impossible to know how Petitioner applied this term within the Petition, or worse if Petitioner’s construction might further “evolve” as needed.

Second, with respect to the phrasing “wherein . . . when” (recited here in challenged claim 6), while in its *Markman* order the District Court adopted the “plain and ordinary meaning” *for now*, that has not mooted the issue. Instead, both the Court and Parties currently understand that the term may require further construction later, because the parties likely dispute what that plain and ordinary meaning is. (*See* Ex. 2025, Email from Shore to Court (“The parties have differing positions on what the plain and ordinary meaning for these four terms should be.”));

Ex. 2026, Email from Court. (“Judge Albright would like to see more briefing at the summary judgment stage.”).)

Inherent in this percolating dispute is the fact that *Petitioner has a specific view of the plain and ordinary meaning of that term*; otherwise there would be no ongoing issue to resolve later. Yet here at the PTAB Petitioner conceals both its view of the plain and ordinary meaning and the more basic fact that any terms were in dispute at all.

Finally, the term “bearer” appears multiple times in each independent claim. Both sides offered competing constructions in District Court, but Petition never addressed nor even mentioned either proposal. While the Court adopted “plain and ordinary” meaning for the term, as with the term “wherein . . . when” there is no way to determine exactly what “plain and ordinary” meaning Petitioner applied here versus what it will apply in District Court

#### **D. The Challenged Claims**

Petitioner challenges claims 1-30 of the patent, including independent claims. As set forth below, given that the asserted prior art fails to disclose regarding the independent claims, the Petitioner’s arguments regarding the dependent claims must also be rejected.

The claims are reproduced below, with Petitioner’s labelling of the elements for convenience only:

Claim 1	
<b>1pre1</b>	A method performed by
<b>1pre2</b>	a sending mobile phone that transmits short message service (SMS) messages and non-SMS based packet switched messages, the method comprising:
<b>1a</b>	retrieving a destination address of a message from the message, wherein the destination address is a phone number of a receiving mobile phone;
<b>1b</b>	sending information representing at least the phone number of the receiving mobile phone;
<b>1c</b>	receiving a response to the sending of the information;
<b>1d1</b>	based at least in part on the response, automatically selecting a bearer for the message,
<b>1d2</b>	wherein the bearer is selected from a group including: an SMS bearer;
<b>1d3</b>	a packet-switched message bearer supported by a cellular connection between the sending mobile phone and a cellular base station; and
<b>1d4</b>	a packet-switched message bearer supported by a wireless local area network (WLAN) connection between the sending mobile phone and a WLAN base station;
<b>1e</b>	after the automatically selecting, formatting the message for transmission via the selected bearer;
<b>1f</b>	after the formatting, transmitting, by the sending mobile phone using the selected bearer, the message, to the receiving mobile phone; and
<b>1g1</b>	performing the retrieving, the sending, the receiving, the automatically selecting, the formatting and the transmitting for at least first, second and third iterations, wherein:
<b>1g2</b>	during the first iteration, a first message is sent to a first receiving mobile phone using the SMS bearer;

<b>1g3</b>	during the second iteration, a second message is sent to a second receiving mobile phone using the packet-switched message bearer supported by the cellular connection; and
<b>1g4</b>	during the third iteration, a third message is sent to a third receiving mobile phone using the packet-switched message bearer supported by the WLAN connection;
<b>1h</b>	wherein a packet switched message service (PSMS) is used to send the third message to the third receiving mobile phone;
<b>1i</b>	wherein the PSMS is a service for sending and receiving packet switched messages other than SMS, enhanced message service (EMS) and multimedia message service (MMS) messages;
<b>1j</b>	wherein a same messaging client on the sending mobile phone performs at least the retrieving, the sending, the receiving, the automatically selecting, the formatting and the transmitting for each of the first, second and third iterations.
<b>Claim 2</b>	
<b>2a</b>	The method of claim 1, wherein at the time the first message is sent to the first receiving mobile phone: a phone number corresponding to the first receiving mobile phone is on a list of subscribing addresses which is stored on a server of the PSMS; and
<b>2b</b>	a plurality of messages sent by the sending mobile phone, to the first receiving mobile phone, via the PSMS, are queued on a server of the PSMS.
<b>Claim 3</b>	
<b>3</b>	The method of claim 1, wherein at the time the first message is sent to the first receiving mobile phone: no phone number corresponding to the first receiving phone is associated with a subscriber of the PSMS.
<b>Claim 4</b>	
<b>4</b>	The method of claim 1, wherein the messaging client provides an option to modify the third message, wherein the option is not available to modify the first message.

<b>Claim 5</b>	
<b>5</b>	The method of claim 1, wherein the response originates from a server which is located outside of a cellular core network, wherein the sending mobile phone is authenticated to the PSMS via SMS and the sending mobile phone is authenticated to the PSMS via a hardware identifier of the sending mobile phone.
<b>Claim 6</b>	
<b>6</b>	The method of claim 1, wherein the response is correlated with a status of the receiving mobile phone when the receiving mobile phone is associated with a subscriber of the PSMS.
<b>Claim 7</b>	
<b>7</b>	The method of claim 1, wherein the sending mobile phone is authenticated to the PSMS via SMS and the sending mobile phone is authenticated to the PSMS via a randomly generated authentication identifier.
<b>Claim 8</b>	
<b>8</b>	The method of claim 1, wherein the sending mobile phone simultaneously displays a left arrow and a right arrow in an interface which displays message content corresponding to a plurality of messages exchanged between the sending mobile phone and the third receiving mobile phone.
<b>Claim 9</b>	
<b>9</b>	The method of claim 1, wherein the first receiving mobile phone, the second receiving mobile phone and the third receiving mobile phone are different mobile phones.
<b>Claim 10</b>	
<b>10</b>	The method of claim 1, wherein the first receiving mobile phone, the second receiving mobile phone and the third receiving mobile phone are the same mobile phone.
<b>Claim 11</b>	

<b>11pre</b>	The method of claim 1, wherein:
<b>11a</b>	between the automatically selecting and the formatting of the third iteration, an attachment option is presented; and
<b>11b</b>	during the entirety of the first iteration, the attachment option is not presented.
<b>Claim 12</b>	
<b>12</b>	The method of claim 11, wherein the attachment option is a voice message attachment option.
<b>Claim 13</b>	
<b>13pre</b>	A system comprising:
<b>13a</b>	a sending mobile phone comprising a message client, wherein the sending mobile phone retrieves a destination address of a message from the message, wherein the destination address is a phone number of a receiving mobile phone; and
<b>13b1</b>	a server of a packet switched message service (PSMS)
<b>13b2</b>	that receives information, wherein the information indicates the phone number of the receiving mobile phone;
<b>13c</b>	wherein the server of the PSMS sends a response in response to receipt of the information;
<b>13d1</b>	wherein, based at least in part on the response, the sending mobile phone automatically selects a bearer for the message, wherein the bearer is selected from a group including:
<b>13d2</b>	a short message service (SMS) bearer;
<b>13d3</b>	a packet-switched message bearer supported by a cellular connection between the sending mobile phone and a cellular base station; and
<b>13d4</b>	a packet-switched message bearer supported by a wireless local area network (WLAN) connection between the sending mobile phone and a WLAN base station;

<b>13e</b>	wherein, after the sending mobile phone automatically selects the bearer, the sending mobile phone formats the message for transmission via the selected bearer;
<b>13f</b>	wherein, after the message is formatted, the sending mobile phone transmits, using the selected bearer, the message to the receiving mobile phone;
<b>13g</b>	wherein the sending mobile phone sends a first message to a first receiving mobile phone using the SMS bearer;
<b>13h</b>	wherein the sending mobile phone sends a second message to a second receiving mobile phone using the packet-switched message bearer supported by the cellular connection; and
<b>13i</b>	wherein the sending mobile phone sends a third message to a third receiving mobile phone using the packet-switched message bearer supported by the WLAN connection;
<b>13j</b>	wherein the server of the PSMS receives content of the third message and sends the content to the third receiving mobile phone;
<b>13k</b>	wherein the PSMS is a service for sending and receiving packet switched messages other than SMS, enhanced message service (EMS) and multimedia message service (MMS) messages;
<b>13l</b>	wherein the message client retrieves the destination address and formats the message.

<b>Claim 14</b>	
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<b>14pre</b>	The system of claim 13, further comprising:
<b>14a</b>	a subscriber data store;
<b>14b</b>	wherein the server of the PSMS receives an indication that a subscriber of the PSMS has become associated with a mobile phone which has capabilities different than those reflected in the subscriber data store;
<b>14c</b>	wherein the server updates the subscriber data store to reflect a change of mobile phone.

<b>Claim 15</b>	
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<b>15</b>	The system of claim 14, wherein the subscriber data store is updated to reflect that the subscriber is no longer associated with a mobile phone which is identified by the subscriber data store.
<b>Claim 16</b>	
<b>16</b>	The system of claim 15, wherein the subscriber data store is located outside of a cellular core network.
<b>Claim 17</b>	
<b>17</b>	The system of claim 13, wherein the message client displays at least one of a right arrow and a left arrow simultaneously with the third message.
<b>Claim 18</b>	
<b>18pre</b>	The system of claim 13, wherein:
<b>18a</b>	a phone number associated with a plurality of receiving mobile wireless devices is received by the server of the PSMS; and
<b>18b</b>	the server of the PSMS sends a response in response to receipt of the phone number associated with the plurality of receiving mobile wireless devices indicating that each one of the plurality of receiving mobile wireless devices corresponds to a subscriber of the service.
<b>Claim 19</b>	
<b>19pre</b>	The system of claim 13, wherein:
<b>19a</b>	a phone number associated with a plurality of receiving mobile wireless devices is received by the server of the PSMS; and
<b>19b</b>	the server of the PSMS sends a response in response to receipt of the phone number associated with the plurality of receiving mobile wireless devices indicating that a message to the plurality of receiving mobile wireless devices should not be sent via the service.
<b>Claim 20</b>	

20	The system of claim 19, wherein: prior to the response sent in response to receipt of the phone number associated with the plurality of receiving mobile wireless devices being sent, the server of the PSMS determines that at least one of the plurality of receiving mobile wireless devices has an inactive status with the PSMS.
<b>Claim 21</b>	
<b>21pre1</b>	A method performed by
<b>21pre2</b>	a sending mobile device that transmits short message service (SMS) messages and non-SMS based packet switched messages, the method comprising:
<b>21a</b>	sending first information representing a first phone number of a first receiving mobile device to a server;
<b>21b</b>	receiving a first response to the sending of the first information;
<b>21c</b>	based at least in part on the first response, automatically selecting an SMS bearer for a first message;
<b>21d</b>	formatting the first message for transmission via the SMS bearer;
<b>21e</b>	transmitting the first message using the SMS bearer;
<b>21f</b>	retrieving a destination address of a second message, wherein the destination address of the second message represents at least a second phone number of a second receiving mobile device;
<b>21g</b>	sending the destination address of the second message to the server;
<b>21h</b>	receiving a second response to the sending of the destination address of the second message;
<b>21i</b>	based at least in part on the second response, automatically selecting a first packet-switched message bearer for the second message;
<b>21j</b>	formatting the second message for transmission via a cellular connection between the sending mobile device and a cellular base station;

<b>21k</b>	transmitting, via the cellular connection, the second message to the second receiving mobile device;
<b>21l</b>	retrieving a destination address of a third message, wherein the destination address of the third message represents at least a third phone number of a third receiving mobile device;
<b>21m</b>	sending the destination address of the third message to the server;
<b>21n</b>	receiving a third response to the sending of the destination address of the third message, wherein the third response indicates that a plurality of receiving mobile devices corresponding to the destination address of the third message are associated with a packet switched message service (PSMS);
<b>21o</b>	based at least in part on the third response, automatically selecting a second packet-switched bearer for the third message;
<b>21p</b>	formatting the third message for transmission via the second packet-switched bearer and a wireless local area network (WLAN) connection between the sending mobile device and a WLAN base station; and
<b>21q</b>	transmitting, using the second packet-switched bearer and the WLAN connection, the third message to the plurality of receiving mobile devices;
<b>21r</b>	wherein the PSMS is a service for sending and receiving packet switched messages other than SMS, enhanced message service (EMS) and multimedia message service (MMS) messages.

**Claim 22**

<b>22</b>	The method of claim 21, wherein each one of the first response, second response and third response originates from a server which is located outside of a cellular network.
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**Claim 23**

<b>23</b>	The method of claim 22, further comprising: sending a group based message to the third receiving mobile device and to a fourth receiving mobile device, via the PSMS and the WLAN, wherein the group based message comprises video information.
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<b>Claim 24</b>	
<b>24</b>	The method of claim 21, wherein the first phone number is not listed as being associated with a subscriber of the PSMS at the time the first response is received.
<b>Claim 25</b>	
<b>25</b>	The method of claim 21, wherein the second receiving mobile device is authenticated to the PSMS, via SMS protocol, prior to the transmitting of the second message, wherein the second message is routed via the PSMS; wherein the first receiving mobile device is not authenticated to the PSMS, via SMS protocol, prior to receiving at least one SMS message from one of the plurality of receiving mobile devices.
<b>Claim 26</b>	
<b>26</b>	The method of claim 21, wherein the second receiving mobile device is not connected to the PSMS during the entire time between which the destination address of the second message is sent and the second response is received, wherein the second message is routed via the PSMS.
<b>Claim 27</b>	
<b>27</b>	The method of claim 21, wherein the destination address of the second message is a sequence of decimal numbers and the destination address of the third message is a sequence of decimal numbers.
<b>Claim 28</b>	
<b>28</b>	The method of claim 21, wherein the sending mobile device simultaneously displays a left arrow and a right arrow in an interface which displays message content corresponding to a plurality of messages exchanged between the sending mobile device and a receiving mobile device associated with the PSMS.
<b>Claim 29</b>	
<b>29pre1</b>	A method performed by

<b>29pre2</b>	a sending mobile device that transmits short message service (SMS) messages and non-SMS based packet switched messages, the method comprising:
<b>29a</b>	sending first information representing a first phone number of a first receiving mobile device to a server;
<b>29b</b>	receiving a first response to the sending of the first information;
<b>29c</b>	based at least in part on the first response, automatically selecting an SMS bearer for a first message;
<b>29d</b>	formatting the first message for transmission via the SMS bearer; and
<b>29e</b>	transmitting the first message using the SMS bearer;
<b>29f</b>	retrieving a destination address of a second message, wherein the destination address of the second message represents at least a second phone number of a second receiving mobile device;
<b>29g</b>	sending the destination address of the second message to the server;
<b>29h</b>	receiving a second response to the sending of the destination address of the second message indicating that the second message is not to be sent to at least one of a first plurality of receiving mobile devices corresponding to the destination address of the second message via a packet switched message service (PSMS);
<b>29i</b>	based at least in part on the second response, automatically selecting the SMS bearer for sending the second message to the at least one of the first plurality of receiving mobile devices;
<b>29j</b>	formatting the second message for transmission via a cellular connection between the sending mobile device and a cellular base station;
<b>29k</b>	transmitting, via the cellular connection, the second message to the at least one of the first plurality of receiving devices;
<b>29l</b>	retrieving a destination address of a third message, wherein the destination address of the third message represents at least a third phone number of a third receiving mobile device;

<b>29m</b>	sending the destination address of the third message to the server;
<b>29n</b>	receiving a third response to the sending of the destination address of the third message, wherein the third response indicates that a second plurality of receiving mobile devices corresponding to the destination address of the third message are associated with the PSMS;
<b>29o</b>	based at least in part on the third response, automatically selecting a packet-switched bearer for the third message;
<b>29p</b>	formatting the third message for transmission via the packet-switched bearer and a wireless local area network (WLAN) connection between the sending mobile device and a WLAN base station; and
<b>29q</b>	transmitting, using the packet-switched bearer and the WLAN connection, the third message to the second plurality of receiving mobile devices.
<b>Claim 30</b>	
<b>30</b>	The method of claim 29, wherein the sending mobile phone simultaneously displays a left arrow and a right arrow in an interface which displays message content corresponding to a plurality of messages exchanged between the sending mobile device and a receiving mobile device associated with the PSMS.

The Petitioner has challenged all 30 claims on a single round, specifically, obviousness in view of the combination of the multiple separate references:

Horvath, Tsampalis, Kansal, and Dorenbosch. (Petition, Paper 2 at 1.)

### III. CITED REFERENCES

Petitioner cobbles together a multiple-reference combination to assert against each of the challenged independent claims, with additional references tacked on for most dependent claims. In doing so, Petitioner manufactures what it names as the “Horvath-Tsampalis-Kansal-Dorenbosch combination,” and treats

that as a single “reference”—something that Petitioner then speaks of as if it actually exists and can be measured against the claims. (*See* Pet. at 19.)

This attempted usage disguises the instances in which Petitioner simply fills in details where even *the combined references contain insufficient disclosure*. In these instances, Petitioner asserts that elements would have been “obvious” even in light of the full multiple-reference combination, rather than showing where the element can be found within any one of the asserted references themselves:

*it would have been obvious for the combination’s sending mobile phone* to send a request that included the telephone number of the receiving mobile phone to the “network element within the network” (*e.g.*, HLR 202 and/or HSS 210), so that the network element was able to look up the profile of the receiving phone.

(Pet. at 30.)

The problem with Petitioner’s analysis is that the “combination’s sending mobile phone” *does not exist, nor is it described in any single reference*. Yet Petitioner treats it as if it were a single, unitary reference and then springboards its obviousness analysis from that fake starting point. In reality, none of the prior art references cited by Petitioner, either alone or in combination, teach all the elements of any independent claim, and thus Petitioner’s arguments fail at the outset. Each reference asserted against the independent claims is summarized briefly below.

**A. Horvath (Ex. 1004)**

Petitioner cites Horvath, Ex. 1004. As set forth below, Horvath is cumulative with multiple references that were cited in original prosecution. For at least the same reasons that the claims were originally allowed, as well as at least the reasons set forth below, Horvath, alone or in combination with the other cited references, does not teach or suggest the claimed subject matter of the '600 patent.

Petitioner concedes that Horvath focuses on SMS messages only. “Horvath focuses on the selective use of packet switched or circuit switched bearers for delivery of SMS messages.” (Pet. at 8.) As such, Horvath is concerned with messaging that is sent by way of a cellular network, not outside the cellular network.

Horvath identifies a problem associated with the conventional transmission of SMS messages, which is that SMS traffic was traditionally transmitted in the same circuit switched networks used by cellular providers to carry voice traffic:

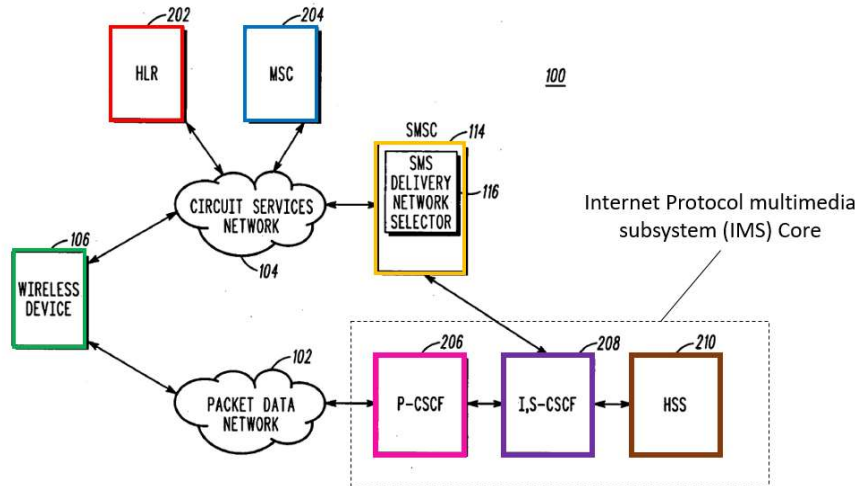
One problem with the traditional way of transmitting SMS messages discussed above is that the circuit services network is primarily used for voice services. The circuit services network is unnecessarily burdened with SMS traffic. Network resources such as air interface capacity and MSC capacity, among other things, are decreased.

(Ex. 1004 at [0004].)

Horvath explains that, in order to overcome this problem, some cellular providers utilize a packet data network (as opposed to a circuit services network)

for transmission of SMS messages. (*Id.* at [0004].) However, this solution still burdened the overhead of the traditional cellular network because the Short Message Service Center (SMSC) did not know whether the intended recipient device was registered to receive messages over a packet data network. (*Id.*) As a result, the SMSC (operating within the traditional cellular network) still “needs to query a home subscriber server (‘HSS’) to determine the registration status of the recipient device. This process creates unnecessary overhead for the system.” (*Id.*)

Figure 2 of Horvath (reproduced produced below with added color annotations) illustrates Horvath’s proposed solution, in which a sending wireless device 106 (dark green box) is coupled to the packet data network 102 and the circuit services network 104. (*Id.* at [0034].) A home location register (“HLR”) 202 (red box) that helps route calls and SMS messages is also coupled to the circuit services network 104. The HLR is a database that holds subscription information associated with wireless devices subscribing in the circuit services network. (*Id.* at [0002].) A mobile switching center (“MSC”) 204 (blue box) that manages communications between the wireless device 106 and the public switched telephone network (“PSTN”), is also coupled to the circuit services network. (*Id.* at [0031]-[0032].)



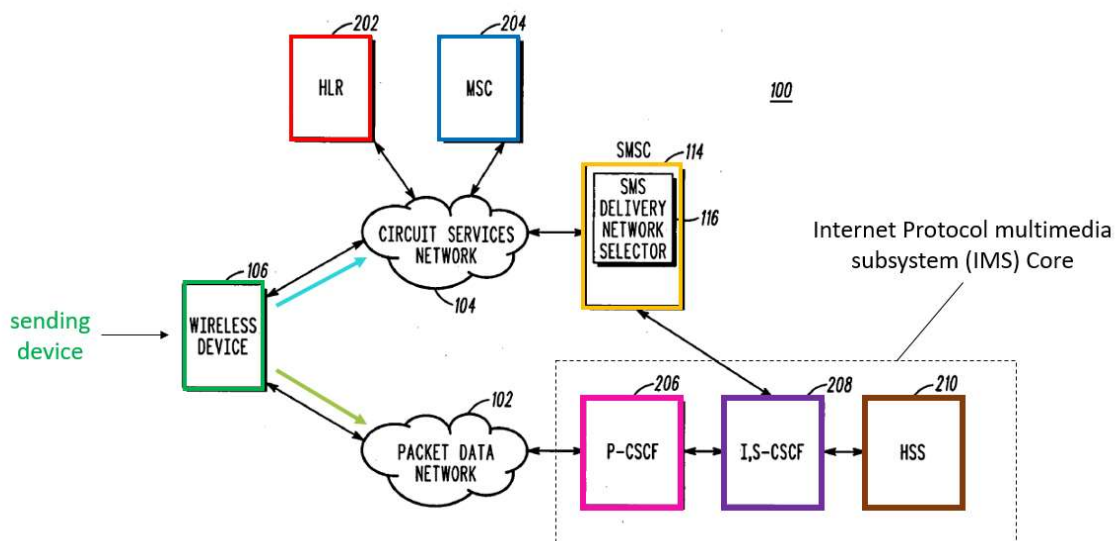
In the Horvath framework, the SMSC 114 (orange box) is directly coupled to the circuit services network 104, and indirectly coupled to the packet data network 102 via a proxy call session control function (“P-CSCF”) 206 (pink box), an interrogating/serving call session control function (“I,S-CSCF”) 208 (purple box) and a registrar such as a home subscriber server (“HSS”) (brown box). (*Id.* at [0033].) The P-CSCF 206, I,S-CSCF 208, and HSS 210 together “comprise part of an Internet Protocol multimedia subsystem (‘IMS’) core” (black dotted line box, present in the original) that supports a session internet protocol (“SIP”) network “used for establishing instant messaging, telephone calls, and other real time communications over the Internet.” (*Id.* at [0033]-[0034].)

Within the IMS core, the HSS 210 maintains a database with a profile (e.g., the telephone number) of each wireless device 106 registered with the IMS core. In addition, the “S-CSCF notifies the SMSC 114 that the wireless device 106 has registered,” and “also transmits SIP contact information associated with the

wireless device” so that the SMSC 114 can deliver an SMS message to the wireless device 106 over the packet data network 102. (*Id.* at [0040].)

In this manner, each wireless device registered with the IMS core can send and receive SMS messages through the packet data network 102. (*Id.* at [0040], [0044], [0053].) By contrast, each wireless device not registered with the IMS core can only send and receive SMS messages through the circuit services network 104. (*Id.* at [0047], [0050].) Through use of the IMS-based network, Horvath moves some SMS messaging traffic off the circuit network 104 and onto the IMS-based data network (packet data network 102), thereby providing capacity relief on the circuit services network 104 without unduly burdening the SMSC. (*Id.* at [0039].)

The operation of Horvath is set forth in the reproduction of Horvath’s Figure 2 below, further annotated in color for convenience.



Significantly, the sending wireless device 106 decides which network to use based on the *capabilities of the sender's device*. (*Id.* at [0050], Fig. 2.)

Horvath is cumulative to multiple references cited during original prosecution. As set forth in the Abstract of Horvath, it relates to transmitting “short message service messages” through two alternative pathways, one of which is a packet data network:

The short message service message is destined for reception by a wireless device (106). Prior to receiving the request, a short message service center (114) determines if a wireless device (106) is registered with a registrar (210) associated with a session initiation protocol network for communicating over a packet data network (102). The short message service message is transmitted to the wireless device (106) through the session initiation protocol network communicating over the packet data network (102) in response to the request and with the determination that the wireless device (106) is registered with the registrar (210).

(*Id.* at Abstract.)

Horvath is cumulative to multiple references cited in the original prosecution of the '600 patent, including U.S. Patent No. 6,678,524 (“Hansson,” Ex. 2027). Hansson’s Abstract similarly establishes that it relates to sending data through either circuit-switched or packet-switched pathways via a mobile station, and selecting which pathway to utilize:

Upon receiving a request to deliver data addressed to the mobile station, a node in a circuit-switched network of a mobile telecommunications system identifies whether the mobile station is capable of receiving data via a packet data bearer. If so, the node further determines whether the data addressed to the mobile station

should be sent via a packet data bearer in a packet-switched network instead of sending the data via a circuit-switched bearer.

(*Id.* at Abstract.) The Background of Hansson confirms that the reference is specifically directed to SMS messages. (*Id.* at 1-14-55.)

**B. Tsampalis (Ex. 1005)**

Petitioner also cites Tsampalis, Ex. 1005. Notably, Tsampalis is wholly cumulative with at least one reference cited in original prosecution. Specifically, a substantively-identical version of Tsampalis was before the Examiner in original prosecution.

Specifically, the PCT application leading to Tsampalis, WO 2004/061583 (“Tsampalis PCT”), was in the record during prosecution of the ’600 patent and accordingly appears on the face of the ’600 patent. A comparison of the Tsampalis PCT with Tsampalis references asserted here demonstrates that they are substantively identical. (Ex. 1005, Tsampalis reference; Ex. 2009 Tsampalis PCT reference.) Unsurprisingly, Petitioner identifies no material differences between the references. Likewise, unsurprisingly, Tsampalis fails, either alone or in combination with the other cited references, to teach or suggest the claimed subject matter of the ’600 patent.

At the time of Tsampalis, cellular networks were known to support both the Short Messaging Service (SMS) as well the more recently introduced Multi-Media Service (MMS). (Ex. 1005 at [0002]-[0003].) However, such networks often

included mobile messaging devices that were “compatible with only a subset of the supported concurrent multiple mobile messaging systems.” (*Id.* at [0003].)

Such networks permitted a mobile device with MMS messaging capability to send an MMS message to a receiving mobile device capable of only receiving SMS messages (but not MMS messages). (*Id.*) On the other hand, if an MMS-capable device sent an MMS message to a device capable of only processing SMS messages, the messages could be bounced back to the sender. “Being unable to process the message due to the incompatibility of its messaging service capabilities with that of the format of the received message, the receiving mobile messaging device then typically bounces the message back to the sending mobile messaging device,” which was undesirable. (*Id.*)

To resolve this problem, before sending a message (e.g., an MMS message) to a recipient device, the sender obtains the recipient device’s capabilities from that recipient device:

In one embodiment, such devices are also capable of obtaining messaging format capabilities information from a target or recipient mobile wireless communication device, that reflect which types of non-real-time store-and-forward messaging formats a mobile wireless communication device is capable of processing. Such devices, using the messaging format capabilities information, then send[s] a message to a target mobile wireless communication device in a format that can be processed by the target mobile wireless communication device.

(*Id.* at [0022].)

Tsampalis is primarily directed to *cellular* messaging formats, namely SMS, EMS and MMS. As explained in the reference, Figure 1 of Tsampalis depicts the components of a “cellular telephone, two-way pager, or other device employing non-real-time store-and-forward messaging (e.g., SMS, EMS, MMS messaging).” The mobile device 100 contains a transceiver 102, mobile wireless communication device messaging format capabilities determinator circuitry 104, send messaging circuitry 106 and memory 107.” (*Id.* at [0024].) The “first mobile wireless communication device 100 is further connected to network 108,” e.g., a mobile cellular telephone network. (*Id.*)

**C. Kansal (Ex. 1042)**

Kansal describes mobile messaging services for sending and receiving messages of different formats. (Ex 1042, Abstract, [0009], [0035] (“an IM application,” “an SMS application,” and “an MMS application”). Kansal, generally, describes a “unified messaging UI” from which a user may view received messages of various messaging types and may select from a variety of types when composing and sending a response, demonstrating the utility and viability of integration. (*Id.* at [0062], [0077]-[0078].) In particular, the unified messaging UI “display[s] a messaging thread comprising correlated messages of different message types,” including “SMS messages, MMS messages, as well as telephone messages, voicemail messages, fax messages, video conferencing

messages, IM messages, and e-mail messages.” (*Id.* at [0009], [0045]-[0046], [0054]-[0056], [0062]-[0064], [0070], [0077]-[0078]; FIGs. 2-3.)

Kansal is cumulative to multiple references cited during original prosecution. For instance, U.S. Patent App. 2010/0131858 (“Schultz,” Ex. 2028) is cited on the face of the ’600 patent. (Ex. 1001 at 2.) Schultz, like Kansal, discloses a unified user interface. Specifically, Schultz discloses:

A device may include a user interface configured to provide audio, video or haptic output in response to received communications. The device may also include logic to identify information associated with an availability status of a user of the device and provide an audio, video or haptic output via the user interface based on the information associated with the availability status of the user of the device.

(Ex. 2028 at Abstract.)

Likewise, WO 2005/018257 (“Maaniitty”) was before the Examiner in original prosecution. (Ex 2010, WO 2005/018257; Ex. 2008, ’600 patent File History at IDS, HBCU-App0001205-06.) (listing WO 2005/018257 “Maaniitty”).)

According to Maaniitty, the reference discloses:

a method for selecting a data transfer method in a telecommunication system wherein several data transfer methods exist for selection. The method comprises determining a message to be transmitted on the basis of inputs received from a user. At least one piece of property information concerning the message being entered or already entered is checked. In order to transmit the message, the data transfer method associated in predetermined selection conditions with the property information is selected.

(Ex. 2010 at Abstract.)

#### IV. ARGUMENT

The Petition should be denied for at least three reasons.

First, Petitioner's concealment of differing claim construction positions in District Court and the PTAB should not be countenanced. Likewise, its substantive failure to apply anything other than "plain and ordinary meaning" here will necessarily result in conflicting results for at least some claims given the District Court's construction of cellular core network, and threatens other inconsistent rulings since Petitioner obviously retains some specific view of the "wherein . . . when" terms (and potentially "bearer") *and* the ability to assert those meanings in District Court later.

Second, as set forth below, the Petition fails to demonstrate the presence of all claim elements even under its faulty claim construction analysis. The references cited in the Petition add nothing compared to the original prosecution of the '600 patent. One of the asserted references is substantively identical, while the others are cumulative. (Paper 7, Patent Owner's Discretionary Denial Brief at 3-6.) Thus, the Examiner effectively compared all of the purported prior art references or their functional equivalents. The result is predictable: the Petition here fails to show all the elements of the claims.

Third, in addition to these references being cumulative and failing to show the presence of all elements, a POSITA would not be motivated to combine them in the first place.

**A. Petitioner’s Failure to Apply Consistent Claim Constructions Here and in District Court Should Be Rejected**

As set forth above, Petitioner proposed, adopted, and applied differing claim constructions in District Court versus within the Petition. That issue has been crystalized at least with the terms “cellular core network,” “wherein . . . when” and “bearer,” the last of which appears in each independent claim.

The District Court adopted a very specific meaning of “cellular core network,” and it is expected that the Parties and Court will address the construction of the “wherein . . . when” terms again once the record is further developed. (*See* Ex. 2025, Email from Shore to Court (“The parties have differing positions on what the plain and ordinary meaning for these four terms should be.”); Ex. 2026, Email from Court. (“Judge Albright would like to see more briefing at the summary judgment stage.”).)

These numerous differences in applied constructions as well as the ongoing disputes only highlight the impropriety of Petitioner’s approach. Petitioner cannot assert that its failures regarding claim construction are mooted when some terms have been construed contrary to its arguments, and for others the issues are still live. Even worse, Petitioner retains the flexibility at District Court to assert

whatever “ordinary meaning” of terms it wants for “wherein . . . when” and even “bearer,” while hiding those same positions from the Board and Director here. And beyond that, Petitioner’s entire approach begs the question of what other “ordinary meaning” interpretations it intends to apply in District Court versus before the Board for claim terms never even addressed in District Court.

The use of one construction for purposes of infringement and a different construction for purposes of validity is a fundamental violation of the most basic principles of patent law and of simple fairness. *W.L. Gore & Assocs. v. Garlock, Inc.*, 842 F.2d 1275, 1279 (Fed. Cir. 1988) (“having construed the claims one way for determining their validity, it is axiomatic that the claims must be construed in the same way for infringement”). Yet that is exactly what Petitioner has held open for itself, by: (1) never even revealing to the Board or Director the competing constructions of “cellular core network,” much less applying them in the Petition; (2) ignoring an ongoing dispute regarding “wherein . . . when” and the obvious fact that Petitioner maintains a specific of the term’s ordinary meaning; and (3) retaining an ability to mold the “ordinary” meaning of “bearer” at District Court while ignoring any such constraints here.

Petitioner’s attempt to have the patents viewed differently in the different forums appears purely for strategic advantage: applying broader “plain and ordinary” meanings in IPR while retaining flexibility to seek more specific,

narrower meanings in District Court. For this reason, alone, the Petition should be denied.

**B. Petitioner Glosses Over Missing Limitations in Each of the Independent Claims**

Each independent claim includes at least one element that is completely missing from Petitioner's cited art. Because the purported combination fails entirely to disclose at least one element, the Petition's obviousness allegation must fail. *Par Pharm., Inc. v. TWi Pharms., Inc.*, 773 F.3d 1186, 1194 (Fed. Cir. 2014) (“We first must determine whether TWi carried its burden to prove that all claimed limitations are disclosed in the prior art. *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006) (stating that we consider motivation to combine and reasonable expectation of success only ‘if all the elements of an invention are found in a combination of prior art references’).”)

**1. The Asserted Art Fails to Disclose the “Third Message” of Claim 1 and Related Elements**

Claim 1 of the '600 Patent recites, among other elements: (1) “retrieving a destination address of a message from the message, wherein the destination address is a phone number”; (2) selecting a “bearer” for the message among three types of bearers, one of which is “a packet-switched message bearer supported by a wireless local area network (WLAN) connection between the sending mobile phone and a WLAN base station”; and (3) sending a message via one of the

bearers. (Ex. 1001 at claim 1.) The claim further recites that there must be at least three iterations of those steps, including at least one in which the message is sent via the third recited bearer, the “packet-switched message bearer supported by a wireless local area network (WLAN) connection.” (*Id.* at claim 1.) Finally, the package-switched message bearer (“PSMS”) is “a service for sending and receiving packet switched messages other than SMS, enhanced message service (EMS) and multimedia message service (MMS) messages.” (*Id.* at claim 1.)

Nothing in the asserted prior art meets this claim language, either alone or in combination. Petitioner asserts that two different messages types will satisfy these limitations, either MMS or IM: (Pet. at 48 (“the sending phone . . . formats and sends the third message as *MMS (or IM)* using the 802.11 network (packet-switched message bearer supported by the WLAN connection)”))

The first of these arguments obviously fails because the claim language expressly precludes the use of MMS with a packet switched message service (PSMS). Specifically, claim 1 recites that “a packet switched message service (PSMS) is used to send the third message . . . wherein the *PSMS is a service for sending and receiving packet switched messages other than SMS, enhanced message service (EMS) and multimedia message service (MMS) messages.*” (Ex. 1001 at claim 1.)

Likewise, the third message also cannot be a conventional IM because conventional IM systems did not retrieve the destination address of an IM message from the IM message itself, as also required by the language of claim 1: “retrieving a destination address of a message from the message, wherein the destination address is a phone number.” (*Id.* at claim 1.)

Indeed, Petitioner’s own secondary reference (unsurprisingly, not asserted against the independent claims) confirms that conventional IM systems at the time of the ’600 patent were based on a buddy list, not derived from phone numbers. (Ex. 1006, Dorenbosch at [0004].) Thus in conventional IM systems such as the one disclosed in Dorenbosch, if a user wanted to send a message to a buddy who was online, the user could do so by clicking on the bolded buddy on the menu and then composing the message. Conversely, if a buddy was offline there was typically no functionality that allowed a user to try to send a message. (*Id.*) .

This makes sense, because in IM systems such as Dorenbosch, the sender knows before ever composing the message that the intended IM recipient subscribes to that service and is online. There was no reason to retrieve address information from the message to send to the server, much less to learn the *capabilities* of the recipient device.

This is further confirmed by Petitioner’s complete failure to show the any relationship between its “IM” theory and Element 1[a], which recites retrieving

“the destination address of a message from the message.” For this element, Petitioner first discusses Horvath. (Pet. at 25-27.) Nowhere in that discussion, however, does Horvath even mention, let alone disclose, retrieving the destination address of an intended message recipient from the message itself.

Alternatively, Petitioner asserts that Tsampalis discloses retrieving the destination address of an intended message recipient from the message. (Pet. at 27-29.) Tsampalis, however, is directed to “non-real-time store-and-forward messaging (e.g., SMS, EMS, MMS messaging).” (Ex. 1005, Tsampalis, [0024].) This is the opposite of the online, real time messaging of IMs. Thus the Petitioner’s alternative mapping of the third message to an Instant Message fails for multiple reasons.

**2. The Asserted Art Fails to Disclose “automatically selecting a bearer for the message” as Recited in Claim 1**

Claim 1 further recites automatically selecting a bearer from the three recited bearers:

based at least in part on the response, *automatically selecting a bearer for the message, wherein the bearer is selected from a group including*: an SMS bearer; a packet-switched message bearer supported by a cellular connection between the sending mobile phone and a cellular base station; and a packet-switched message bearer supported by a wireless local area network (WLAN) connection between the sending mobile phone and a WLAN base station.

(Ex. 1001 at claim 1.) Thus, the sending mobile phone must not only have the capability to send a message over each of the three recited bearers, but also functionality for automatically selecting among the three bearers. (*Id.*)

Petitioner's analysis of two of the bearers, elements [1d3] (packet switched over the cellular bearer) and [1d4] (packet switched over WLAN) fails to specifically cite to any of Horvath, Tsampalis or Kansal, instead referring to the make-believe "Horvath-Tsampalis-Kansal's sending mobile phone." (*See* Pet. at 39-43.)

**3. Petitioner Offers No Further Argument for Any Other Independent Claim, and so the Petition Fails as to Each**

Each of the remaining independent claims includes corresponding elements to those addressed above. (*See* Pet. at 63-66, 73-75, and 78-81 (Elements [13pre]-[13l] of claim 13, Elements [21pre]-[21r] of claim 21, and Elements [29pre]-[29q] of claim 29).)

Petitioner does not even attempt to provide any additional argument or context to any of elements, instead simply referring back to its arguments regarding claim 1. (Pet. at 63-66, 73-75, 78-81.) Accordingly, the Petition fails as to these claims as well.

**C. Apple Establishes No Adequate Motivation to Combine the References in the Manner Recited**

**1. Apple's Purported Motivation to Combine Is Nothing More than Sleight of Hand**

A POSITA would not have been motivated to combine Horvath, Tsampalis, and Kansal as proposed in the Petition. (*See* Petition, Paper 2 at 21-22.)

It is not enough that references exist in the same general area of technology or even enough that a certain combination of references worked after the fact; there must be an actual motivation to combine, at least some “logical underpinning” beyond “generic ‘reasons’ to combine.” (Ex. 2029 IPR2025-00785, Decision Denying Institution of IPR at 14 (denying institution, in part, for lack of motivation to combine where the reasons for combining were generic and vague).) Nor is a “reasonable likelihood of success” enough to create a motivation to combine. The obviousness inquiry asks whether a POSITA would have been motivated to combine, not whether they could have successfully done so. *Adidas AG v. Nike, Inc.*, 963 F.3d 1355, 1359 (Fed. Cir. 2020); *InTouch Techs., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014). A reasonable expectation of success cannot fill the gap left by an absent motivation to combine.

Here, Petitioner's asserted “motivations” to combine are hindsight solutions in search of non-existent problems. (Pet. at 16-25.) For example, Petitioner states that “a POSITA would have combined Horvath and Tsampalis such that the sender

would obtain and use a recipient's MFCI to enhance users' messaging experiences and ensure that the format of outgoing messages is compatible with the messaging format capability of the recipients' device before the message is sent." (Pet. at 18.) But this was a problem that Horvath already solved, which Petitioner immediately acknowledges. (*Id.*) But there is no explanation for why a POSITA would want to re-solve the problem using teachings from Tsampalis.

Petitioner's remaining three explanations for motivation to combine are unsupported, conclusory statements. (*Id.* at 18-19 ("Second, a POSITA would have sought to leverage Tsampalis-like MFCI in enhanced messaging formats such as MMS and IM. . . . Third, a POSITA would have been motivated to apply Tsampalis-like MFCI to Horvath's system to advance Horvath's express objectives of reducing 'unnecessary overhead for the system' and 'dynamic optimization of [] resources. Fourth, a POSITA would have found it obvious to combine the teachings of Horvath with Tsampalis because the combination merely involves the application of a known technique to a known system to achieve predictable results.'").)

These generic "reasons" to combine the alleged teachings of all four references lack rational underpinning, particularly because Petitioner does not even identify which teachings of which references are being combined to achieve any particular limitation in the claims.

## **2. Combining These References in the Manner Petitioner Proposes Is Nonsensical**

Even if there were articulated, true motivation to combine generally, which there is not, it would not make sense to combine the references in this way. Apple advances three purported benefits for why a POSITA would have modified Horvath based on Tsampalis, *i.e.*, (i) to ensure that the format of “messages is compatible with the capabilities of the recipients’ device,” (ii) to permit “more frequent and reliable use of enhanced messaging formats such as MMS and IM” which were not included in Horvath, and (iii) “to advance Horvath’s express objections of reducing ‘unnecessary overhead for the system.’” (Pet. at 18-19.) None of these purported bases withstands scrutiny.

*First*, A POSITA would not have been motivated to modify Horvath to ensure that the format of the message is compatible with the capabilities of the recipients’ device, because Horvath already performed this function.

In Horvath, once the message transmitted by the sending wireless device reaches the mobile operator network, the SMSC 114 within the mobile operator network determines how the mobile operator network will deliver the SMS to the recipient. (Ex. 1004 at [0045]-[0047] (“If the SMSC 114 determines that the recipient device is registered on the packet data network 102, the SMSC 114 delivers the SMS message to the recipient device through the packet data network 102 . . . . If the recipient device is not registered on the packet data network 102,

the SMSC 114 delivers the SMS message to the recipient device through the traditional circuit services network.”.)

Petitioner fails to explain why a sender in Horvath would need (or even desire) to obtain the MFCI of the recipient to “ensure that the format of outgoing messages is compatible with the messaging format capability of the recipients’ device,” when Horvath already has a decision-making function within SMSC 114 to ensure that the format of outgoing messages is compatible with the messaging format capability of the recipients’ device.

*Second*, Petitioner argues that a POSITA would have combined Tsampalis with Horvath’s system to permit “more frequent and reliable use of enhanced messaging formats such as MMS and IM.” (Pet. at 17-18.) A POSITA motivated to accomplish that goal could have done so within the existing architecture of Horvath by extending the existing functionality in Horvath’s mobile operator network for determining how to deliver an outgoing message to include not only SMS message formats, but also EMS and MMS messages.

Similarly, Petitioner argues that a POSITA would have been motivated to “leverage the Tsampalis like MFCI in Horvath’s system” such that the “sending mobile phone utilizes” such “information when determining how to format and deliver a message to a receiving mobile phone.” (Pet. at 18-20.) Petitioner’s proposed combination makes the leap that a POSITA would have been motivated

to relocate Horvath's functionality for deciding how to deliver the message to the recipient from the mobile operator network to the sending wireless device itself. However, the Petition fails to explain why a POSITA would have selected such a radical alteration of Horvath's existing architecture, when a simple extension of Horvath's teachings would have satisfied the goal of permitting other messaging formats.

*Third*, the Petitioner's proposed combination of Horvath and Tsampalis would increase overhead, not reduce it. As mentioned above, the sending wireless device in Horvath learns its own capabilities with a single request/response exchange with the mobile operator network. This single request/response exchange need not be repeated every time the sending wireless device desires to send a message to a recipient because, once the sending wireless device learns its own capabilities, it can store that information within the sending wireless device for future use.

Moreover, since Horvath's SMSC 114 (within the mobile operator network) determines how to deliver the SMS message to the recipient, there is no need for the sending wireless device to engage in any further request/response exchanges with the mobile operator network to learn the capabilities of each intended message recipient. By locating that decision-making function within the mobile

operator network, Horvath's architecture minimizes traffic between the sending wireless device and the network.

Accordingly, rather than advancing the "express objectives of reducing 'unnecessary overhead for the system,'" (Pet. at 18-19), the proposed combination would do the opposite, by substantially increasing traffic each time the sender desires to send a message to a recipient.

For at least the reasons set forth above, the Petition has failed to demonstrate that a POSITA would have combined the asserted references in a manner that corresponds in any manner to the architecture described and claimed in the '600 patent.

**D. Because Petitioner Has Failed to Show Obviousness of Any Independent Claim, It Has Also Failed to Show Obviousness of Any Dependent Claim**

The remaining Grounds of the Petition are directed to dependent claims only. As set forth above, however, the Petition has failed with respect to each independent claim. Thus the Petition likewise fails with respect to each dependent claim.

**V. CONCLUSION**

For the reasons set forth above, the Petition should be denied institution.

Dated: February 26, 2026

Respectfully submitted,

/ Timothy Devlin /

Timothy Devlin (Reg. No. 41,706)

tdevlin@devlinlawfirm.com

DEVLIN LAW FIRM LLC

1526 Gilpin Avenue

Wilmington, DE 19806

Tel: (302) 449-9010

Fax: (302) 353-4251

*Attorney for Patent Owner*

## CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner's Preliminary Response consists of 10,437 words, excluding cover page, table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The brief complies with the type-volume limitation of 14,000 words as mandated in 37 C.F.R. §**Error! Bookmark not defined.** 42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

/ Timothy Devlin /  
Timothy Devlin

**CERTIFICATE OF SERVICE**

I hereby certify that on February 26, 2026, I caused a true and correct copy of **PATENT OWNER'S CORRECTED PRELIMINARY RESPONSE** to be served via electronic mail on the following counsel for Petitioner:

<b>LEAD COUNSEL</b>	<b>BACKUP COUNSEL</b>
W. Karl Renner, Reg. No. 41,265 Fish & Richardson P.C. 60 South Sixth Street Suite 3200 Minneapolis, MN 55402 Tel: 202-783-5070 Fax: 877-769-7945 Email: <a href="mailto:IPR50095-0260IP1@fr.com">IPR50095-0260IP1@fr.com</a>	David Holt, Reg. No. 65,161 Nicholas Stephens, Reg. No. 74,320 Charlene Thrower, Reg. No. 79,289 Joseph Bauer, Reg. No. 81,218 Fish & Richardson P.C. 60 South Sixth Street Minneapolis, MN 55402 Tel: 202-783-5070 Fax: 877-769-7945 Email: <a href="mailto:IPR50095-0260IP1@fr.com">IPR50095-0260IP1@fr.com</a>

/ Timothy Devlin /  
Timothy Devlin