

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner,

v.

CORE WIRELESS LICENSING S.A.R.L.,
Patent Owner.

Case IPR2015-01988
Patent 8,792,398 B2

Before JAMESON LEE, DAVID C. McKONE, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

McKONE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

LG Electronics, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 10, 11, and 13 of U.S. Patent No. 8,792,398 B2 (Ex. 1001, “the ’398 patent”). Core Wireless Licensing S.a.r.l. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

Pursuant to 35 U.S.C. § 314, in our Decision to Institute (Paper 7, “Dec.”), we instituted this proceeding as to claims 10 and 13, but not claim 11.

Patent Owner filed a Patent Owner’s Response (Paper 16, “PO Resp.”), and Petitioner filed a Reply to the Patent Owner’s Response (Paper 19, “Reply”).

Petitioner relies on the testimony of Mark R. Lanning (Ex. 1002, “Lanning Decl.”). Patent Owner relies on the testimony of Alon Konchitsky, Ph.D. (Ex. 2010, “Konchitsky Decl.”).

An oral argument was held on Dec. 14, 2016 (Paper 30, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of claims 10 and 13. Based on the record before us, Petitioner has demonstrated, by a preponderance of the evidence, that claims 10 and 13 of the ’398 patent are unpatentable.

B. Related Matters

The parties indicate that the '398 patent has been asserted in *Core Wireless Licensing S.a.r.l. v. LG Electronics, Inc.*, No. 2:14-cv-00912 (E.D. Tex.) ("LG Litigation"), and *Core Wireless Licensing S.a.r.l. v. Apple, Inc.*, No. 6:14-cv-00751 (E.D. Tex.). Pet. 1; Paper 4, 2.

C. References Relied Upon

3rd Generation Partnership Project ("3GPP"), TSG-SA Working Group 1 (Services), *Technical Specification Group Services and System Aspects, Service aspects; Stage 1, Multimedia Messaging Service (3G TS 22.140 version 0.1.0)*, TSG S1#4 (99)486 (July 5–9, 1999) (Ex. 1003, "MMS-1 v0.1.0");
3GPP, *Technical Specification Group Services and System Aspects, Service aspects; Stage 1, Multimedia Messaging Service (3G TS 22.140 version 0.2.0)* (Sept. 1999) (Ex. 1004, "MMS-1 v0.2.0");
3GPP, *Technical Specification Group Terminals; Multimedia Messaging Service (MMS); Functional description; Stage 2 (3G TS 23.140 version 0.1.0)*, T2M(99)105 (Nov. 9–10, 1999) (Ex. 1006, "MMS-2");
Nokia, *MMS architecture proposal*, TSGT2#4(99)500 (June 14–16, 1999) (Ex. 1009, "Nokia Proposal").

D. The Asserted Grounds

We instituted *inter partes* review based on the following specific grounds (Dec. 35):

References	Basis	Claim Challenged
MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal	§ 103(a) ¹	10
MMS-1 v0.1.0 and MMS-1 v0.2.0	§ 103(a)	13

E. The '398 Patent

The digital mobile telephone system Global System for Mobile Communication (“GSM”) includes a two-way paging-system-like service, called Short Message Service (“SMS”), in which short text messages can be exchanged. Ex. 1001, 1:23–29. Unlike telephone calls, SMS communication does not require a connection between a transmitter and a receiver; rather, SMS messages are stored at the transmitter and pushed to the receiver as soon as the receiver can be reached. *Id.* at 1:30–46. The ’398 patent terms this a “connectionless push method.” *Id.* at 1:46–48.

According to the ’398 patent, at the time of the invention, a multimedia messaging service was being developed, in which pictures and short video clips could be transmitted in messages along with text. *Id.* at 1:66–2:4. These messages required greater bandwidth than SMS messages

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, revised 35 U.S.C. § 103 and the relevant sections took effect on March 16, 2013. Because the application from which the ’398 patent issued was filed before that date, our citations to Title 35 are to its pre-AIA version.

and could be transmitted using a Wireless Application Protocol (“WAP”).
Id. at 2:5–14.

The ’398 patent describes techniques for filtering electronic information, such as SMS messages, to be transferred to a terminal through a communication connection. *Id.* at Abstract. In the preferred embodiment, the terminal is a wireless WAP mobile station (“MS,” e.g., a cell phone) and the communication connection is a wireless network using WAP protocol. *Id.* at 5:13–20. Figure 2, reproduced below, illustrates an example of a WAP system:

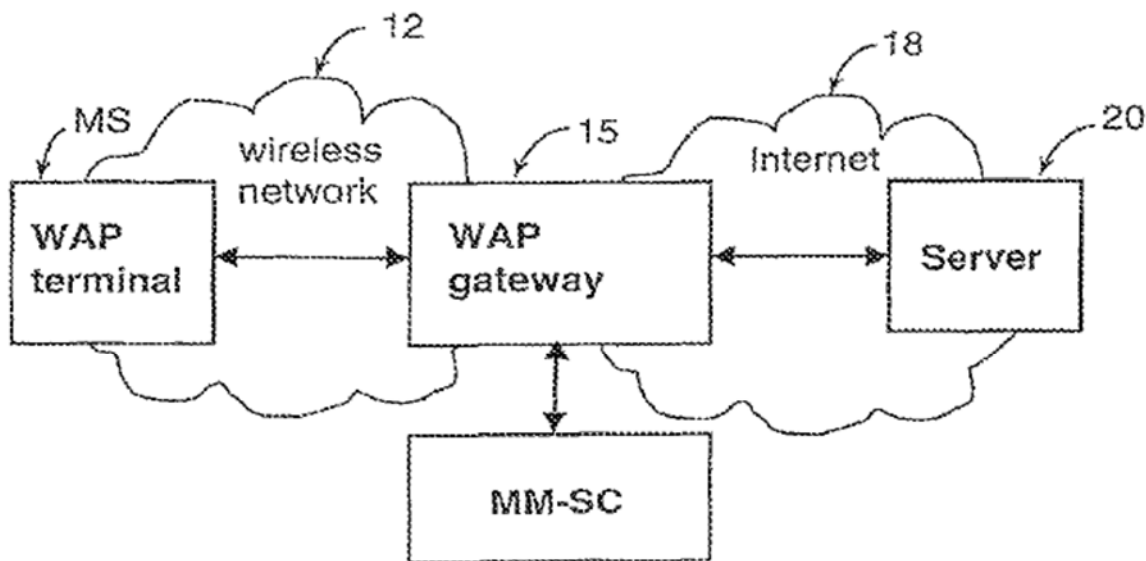


Fig. 2

Figure 2 is a block diagram of a WAP system. *Id.* at 6:26–28, 10:28–33.

Mobile station MS is a WAP terminal. Server 20 is an Internet server. Messages from server 20 to MS are communicated over Internet 18 to WAP gateway 15, which converts the messages according to a WAP protocol (such as Wireless Session Protocol (“WSP”)) for transmission over wireless

network 12 to MS. *Id.* at 6:61–7:8. The messages (also called datagrams) include headers with fields such as those shown in Table 1, reproduced below:

TABLE 1			
Fields of Headers.			
	Name of Field	Content of Field	Comments
1.	Message Class	Personal/ Advertisement/ Informative	Default: Personal
2.	Priority	Ordinary/ Urgent	Default: Ordinary

TABLE 1-continued			
Fields of Headers.			
	Name of Field	Content of Field	Comments
3.	Subject	Message subject	May also be omitted
4.	To whom	Address of recipient	Telephone number or other address of recipient (e.g. e-mail)
5.	Content information of message	Tells what the message contains	Tells the types of the files (e.g. JPEG, GIF, MPEG, WAV).
6.	From whom	Address of sender	An address added by a messaging service centre to prevent misuse

Table 1 is a table listing field names, corresponding content, and comments. As shown above, one example field is “Message Class,” which can be either “Personal,” “Advertisement,” or “Informative.” These classes can include information for sub-classes. *Id.* at 8:30–40.

As shown in Figure 2, multimedia messaging service center (“MM-SC”) is connected to WAP gateway 15.

In a multimedia messaging service, the MM-SC acts as an element that stores in its memory a multimedia message addressed to a wireless terminal MS. In a preferred embodiment

of the invention, the MM-SC forwards the multimedia message further to the wireless terminal MS if this allows the receiving of the message and when it can be reached.

Id. at 10:40–45. When server 20 sends a multimedia message (e.g., containing text and pictures) to WAP terminal MS, MM-SC stores the message in memory and sends MS a notification message that serves as a sign of the stored message and informs of the class parameter for filtering. *Id.* at 10:57–63.

A user can, via a user interface, input settings into MS in advance of receiving messages. The settings can include classes and sub-classes of messages to reject. *Id.* at 14:65–15:2. After receiving a notification message from MM-SC, MS reads parameters in the header and compares the parameters to settings stored on MS to determine whether to accept or reject the message stored on MM-SC. *Id.* at 12:30–37. “[T]he terminal preferably first reads the class information in a notification message that comes separately and if the class in question is closed by a setting, no actual message will be received at all.” *Id.* at 15:2–5. If MS decides to reject the message, it sends MM-SC a notification and the message is not delivered to MS. *Id.* at 12:38–41.

Claim 10, reproduced below, is illustrative of the claimed subject matter:

10. An apparatus comprising:
 - a receiver configured to receive a filtering parameter from a network element through a wireless network; and
 - a processor configured to allow or prevent the receiving of electronic information through the wireless network on the basis of said filtering parameter and the apparatus is configured not to receive the electronic information

through the wireless network when the filtering parameter denotes the electronic information being prevented;

a user interface for marking in advance the receiving of the electronic information as being allowed or prevented on the basis of the filtering parameter;

wherein the processor is further configured to compare the received filtering parameter to said marking made in advance; and

said apparatus is arranged to receive the electronic information through the wireless network only when said comparison shows the receiving of the electronic information being allowed.

II. ANALYSIS

A. *Claim Construction*

We interpret claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–45 (2016). In applying a broadest reasonable construction, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. “*connectionless push method*”

Claim 13 recites, *inter alia*, “the filtering parameter is received over a wireless network using a *connectionless push method*.” We construed “connectionless push method” to mean “a method in which messages are transferred from a transmitting device to a receiving device by pushing the

messages, stored on the transmitting device, to the receiving device as soon as the receiving device can be reached, without first establishing a connection between the transmitting device and the receiving device,” and noted that the ’398 patent describes SMS as an example of a connectionless push method. Dec. 9–10 (citing Ex. 1001, 1:38–48).

Patent Owner agrees with this construction. PO Resp. 26–27. Petitioner does not contest it. On the complete record, we maintain our construction.

2. “*filtering parameter*”

Claim 10 recites “a receiver configured to receive a *filtering parameter* from a network element.” Similarly, claim 13 recites “receiving by a device a *filtering parameter* associated with electronic information.”

Patent Owner contends that “filtering parameter” should be construed as “as a parameter that denotes general information concerning a multimedia message that is used to classify the multimedia message, as distinguished from a parameter indicating the format of the multimedia components (i.e., the media type) of the message.” PO Resp. 23. We note two components of Patent Owner’s proposal: 1) a parameter that denotes “general information” concerning a multimedia message, and 2) a negative limitation that the parameter does not indicate the format of the multimedia components of the message. We also note that, in the LG Litigation, Patent Owner agreed to a construction of “filtering parameter” that is broader than the construction it now proposes. Specifically, Patent Owner (and Petitioner) previously agreed that “filtering parameter” means “an indication transmitted to the mobile terminal that is used as the basis for allowing or preventing the

receiving of electronic information.” Ex. 1049, 2. Patent Owner does not explain, or even acknowledge, its departure in this proceeding.

As to its proposal in this proceeding, Patent Owner contends that “filtering parameter” is “defined by the specification.” PO Resp. 23. Patent Owner first points to the “Summary of the Invention” section of the ’398 patent, in particular to the statement that “a specific parameter intended for filtering is attached to electronic information, with the help of which the electronic information is classified before it is delivered to a wireless terminal, and a receiving terminal is first informed of said parameter.” Ex. 1001, 3:13–17. Patent Owner argues that, in this passage, “the filtering parameter is described as a parameter received at the mobile terminal and used to classify electronic information before that electronic information is actually received.” PO Resp. 23.

Patent Owner (*id.* at 23–25) further cites to description that it contends describes the invention generally, rather than simply a preferred embodiment. *Id.* at 2–25. For example, in discussing Table 1 (reproduced above), the ’398 patent states “as one field the headers have the classification data of a message *according to the invention* in the field Message Class.” *Id.* at 8:16–18 (emphasis added). In a discussion of Figure 3a, the ’398 patent states:

FIG. 3a shows one possible rough structure of a notification message 21, where the presented notification message 21 comprises a header part “Header Information” 22 and in addition, e.g. fields 23 for denoting the properties (such as the component’s type and size) of the multimedia components (which there can be one or more) contained by multimedia messages. The “Header Information” part 22 comprises message class fields *according to the invention* which denote general

information of the multimedia message stored in the MM-SC. Furthermore, the part 22 in question may contain the information on the sender's address and priority.

Id. at 11:5–14 (emphasis added). Both of these examples include the recitation “according to the invention.” Patent Owner argues that “[b]y characterizing **the invention** in this way, the patentee is setting forth statements of definition.” PO Resp. 26.

We are not persuaded by Patent Owner's arguments. None of the passages cited by Patent Owner purport to define “filtering parameter.” They also do not, on their faces, purport to exclude subject matter from “filtering parameters.”

Assuming that the '398 patent defines “the invention” as requiring sending information in headers that denote “general information” about multimedia messages, and that such requirement can be imputed to the term “filtering parameter,” Patent Owner does not persuasively explain what “general information” is and how it excludes information that indicates the format of the multimedia components of the messages. Patent Owner argues that, in all of the examples it cites, “whether included in a notification message or in a header of an MMS message, the filtering parameter is found in a **message class** field, and serves to classify the MMS message.” PO Resp. 25. Referring to Table 1 of the '398 patent, Patent Owner distinguishes the “message class field” as “different from fields such as ‘5. Content information of message,’ which are used to indicate ‘the types of the files’ (i.e., the format of the multimedia components of the message), and not to ‘denote general information of the multimedia message.’” *Id.* Here, Patent Owner appears to contend that a filtering parameter is limited to the “message class field” described in the Specification, a position that is

problematic, as it would be a clear attempt to read a limitation into the claims from the Specification. Nevertheless, at the oral hearing, Patent Owner stated that “our construction does not say message class field” and that “[o]ur construction is that there must be information that classifies the message. It’s possible you could do that in a way other than a designated message class field.” Tr. 30:13–19.

When pressed at the oral hearing to explain what it meant by “general information,” Patent Owner argued that “it is information that classifies the message as a whole” as opposed to information that “speak[s] to components of a message.” *Id.* at 33:1–14. As to the meaning of “classify,” Patent Owner argued “we haven’t proffered any special definition of classify” but “we could revert to common everyday usage, and that would be something that would group things together on the basis of a common characteristic.” *Id.* at 31:9–15. Patent Owner contended that, in an example of a message that included video or a picture, a media type parameter would only classify the video or picture portion of the message, and not the remainder of the message. *Id.* at 33:15–34:22.

We are not persuaded by Patent Owner’s distinction and see no basis for it in the Specification. Patent Owner does not explain persuasively, or support with evidence, its position that the “message class” field provides general information about a message while other fields, for example the “from whom” field shown in Table 1 of the ’398 patent, only provides information about portions of the message. Patent Owner contends that the “message class” field is the only field depicted in Table 1 that exemplifies a “filtering parameter.” Tr. 36:7–37:18. Nevertheless, the Specification specifically identifies the “from whom” field as an example of a “filtering

parameter.” Ex. 1001, 15:45–47 (“The message class and possible other filtering parameters, such as the ID of the source”). We read the Specification to describe “message class” as but one example of a “filtering parameter,” with the other fields listed in Table 1 being other examples. Importantly, Patent Owner offers no persuasive support in the Specification, either lexicography or disclaimer, for its negative limitation, i.e., “as distinguished from a parameter indicating the format of the multimedia components (i.e., the media type) of the message.” *Cf. Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003) (“Beyond the words of the claim, neither the district court nor Raytek has identified any express disclaimer or independent lexicography in the written description that would justify adding that negative limitation.”).

As Petitioner points out (Reply 15–18), a broader construction is supported by other claims in the ’398 patent. As the Federal Circuit has counseled, “[o]ther claims of the patent in question, both asserted and unasserted, can also be valuable sources of enlightenment as to the meaning of a claim term. Because claim terms are normally used consistently throughout the patent, the usage of a term in one claim can often illuminate the meaning of the same term in other claims.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (en banc) (internal citation omitted). Although not challenged in this proceeding, claims 1 and 5–8 of the ’398 patent are instructive.

Claim 1 recites, inter alia, “determining by a network element a multimedia message having an associated filtering parameter for a device.” Claims 5–8 depend from claim 1 and recite specific examples of “filtering parameters”:

Claim 5: “wherein said filtering parameter comprises information on at least one class of a number of predetermined classes, on the basis of which the multimedia message has been classified into said class”;

Claim 6: “wherein said filtering parameter further comprises information for identifying an original source of the multimedia message”; and

Claims 7 and 8: “wherein the filtering parameter further comprises information for identifying a content of the multimedia message.”

Claim 5, for example, recites that the filtering parameter comprises information on at least one class. This is substantially the same as Patent Owner’s proposal “general information concerning a multimedia message that is used to classify the multimedia message,” at least as Patent Owner seeks to apply it. Under the doctrine of claim differentiation, however, we presume that “filtering parameter” is broader than “information on at least one class.” Indeed, claims 6, 7, and 8 give other examples, such as “information for identifying an original source of the multimedia message” (consistent with the example at column 15, lines 45–47, of the ’398 patent) and “information for identifying a content of the multimedia message” (consistent with the “media type” information Patent Owner seeks to exclude from filtering parameters).

At the oral hearing, Patent Owner argued that the examples of claims 6–8 “are in addition to the information that classifies the message in its entirety.” Tr. 30:23–31:5. Patent Owner conceded that the examples of claims 6–8 “are explained in the specification as additional ways in which

filtering may be obtained,” but argued that “always there is something that classifies the message first.” *Id.* at 31:5–8. This argument is not persuasive. Claims 5–8 do not just say that additional filtering can be performed using information identifying a source or information identifying a content of a message. Rather, claims 5–8 give examples of what a “filtering parameter” can be. Patent Owner offers no persuasive support for its argument that the language “filtering parameter” carries with it a requirement that it classify a message with a field akin to a class field. More importantly, claims 7 and 8 directly refute Patent Owner’s contention that a “filtering parameter” excludes “media type” information.

Claims 10 and 13 broadly recite receiving “a filtering parameter” and allowing or preventing the receiving electronic information on the basis of the filtering parameter. The Specification describes examples of such filtering parameters, including a message class field, but, contrary to Patent Owner’s arguments, does not define filtering parameters restrictively or exclude information such as media type information. Claims 5–8 echo these examples and make clear that a filtering parameter can include various types of information, such as information identifying message class, message source, and content. This evidence does not support the construction Patent Owner proposes in this proceeding. Rather, it fully supports the construction both parties agreed to in district court, namely, “an indication transmitted to the mobile terminal that is used as the basis for allowing or preventing the receiving of electronic information.” Ex. 1049, 2. On the complete record, we adopt the construction of “filtering parameter” the parties agreed to in district court.

B. Patent Owner Challenges to Prior Art Status

1. Printed Publication Status of Prior Art

Patent Owner argues that MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal are not “printed publications” for purposes of 35 U.S.C. § 102. PO Resp. 27–42.

According to the Federal Circuit, “[b]ecause there are many ways in which a reference may be disseminated to the interested public, ‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’” under Section 102. *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (quoting *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986)). A reference is publicly accessible “upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008).

We assess public accessibility on a case-by-case basis. *See Kyocera*, 545 F.3d at 1350. In instances of references cataloged in libraries, for example, “competent evidence of the general library practice may be relied upon to establish an approximate time when a thesis became accessible.” *In re Hall*, 781 F.2d at 899. As the Federal Circuit has counseled, “indexing is a relevant factor in determining accessibility of potential prior art, particularly library-based references.” *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374, 1380 (Fed. Cir. 2012). Indexing may also be relevant to references stored in online databases, as “indexing is no more or less important in evaluating the public accessibility of online

references than for those fixed in more traditional, tangible media.” *Id.* In *SRI International*, for example, in the context of a motion for summary judgment, a document on an FTP server was not shown to have been sufficiently publicly available, in part, because “the FTP server did not contain an index or catalogue or other tools for customary and meaningful research.” 511 F.3d at 1196.

On the other hand, in cases in which copies of documents actually were disseminated to interested members of the public, indexing is less important, if at all. For example, the Federal Circuit stated: “a printed publication need not be easily searchable after publication if it was sufficiently disseminated at the time of its publication.” *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014). In *Suffolk*, the prior art was a message posted to an Internet newsgroup site. *Id.* at 1361. There, the patent owner argued that posted messages were non-indexed. *Id.* at 1365. In *Suffolk*, the Federal Circuit concluded that the posting was sufficiently disseminated to those of ordinary skill in the art to be considered publically accessible, after noting that the posting “elicited at least six responses over the week following its publication” and that “[m]any more people may have viewed the post without posting anything themselves.” *Id.* The Court further noted: “the record indicates that those of ordinary skill in the art actually were using [the] newsgroups.” *Id.* at 1364.

In another example, the Federal Circuit found that a paper presented orally at a technical conference and handed out afterward upon request was publicly accessible where “between 50 and 500 persons interested and of ordinary skill in the subject matter were actually told of the existence of the paper and informed of its contents by the oral presentation, and the

document itself was actually disseminated without restriction to at least six persons.” *Mass. Inst. of Tech. v. AB Fortia*, 774 F.2d 1104, 1108–09 (Fed. Cir. 1985) (“MIT”); *cf. In re Klopfenstein*, 380 F.3d 1345, 1347 (Fed. Cir. 2004) (a printed slide presentation displayed continuously for two and a half days at a meeting of a technical association and displayed for less than a day at a university held to be publicly accessible). Discussing the *MIT* case, the *Klopfenstein* court noted that “[t]he key to the court’s finding [in *MIT*] was that actual copies of the presentation were distributed. The court did not consider the issue of indexing.” 380 F.3d at 1349 (citing *MIT*, 774 F.2d at 1108–10).

The cases discussing the public accessibility of documents actually disseminated to members of the public are the most relevant to the facts of this proceeding. The other cases focusing on indexing, whether online or at a library, are less pertinent. For the reasons given below, we conclude that MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal were publicly accessible at the relevant time and, thus, qualify as prior art printed publications.

Prior to addressing Petitioner’s evidence of public accessibility, we address Patent Owner’s characterization of these documents as “early stage” versions of technical specifications and related proposals of 3GPP that were being debated in advance of formal “releases” by 3GPP of the specifications, and as “annotated throughout with editorial comments, tracked changes (e.g., revisions from earlier drafts), informalities, and placeholder text.” PO Resp. 27–29. To the extent the characterization amounts to an argument that such “early stage” nature of the documents disqualifies them as printed publications, the argument is rejected. Patent Owner cites no authority to support the notion that a document in draft form cannot be deemed a printed

publication even if it is sufficiently made publically accessible, and we decline to so hold.

Turning to Petitioner's evidence, to establish these documents as printed publications, Petitioner relies on the testimony of Friedhelm Rodermund (Ex. 1007). Pet. 5. Mr. Rodermund details his experience with 3GPP and its record keeping, including his work as Secretary for one of 3GPP's working groups, and states that he has personal knowledge of 3GPP's record keeping processes. Ex. 1007 ¶¶ 1, 2, 5, 6. Petitioner also relies on admissions of Patent Owner's expert witness, Dr. Konchitsky, as to his experience attending 3GPP meetings. Reply 3–6 (citing Ex. 1042 (Konchitsky Deposition)). Dr. Konchitsky testifies that he participated in 3GPP on behalf of DSP Communications, Inc., and Intel Corp. Ex. 2010 ¶¶ 10, 11.

Dr. Konchitsky explains that 3GPP is an organization consisting of six telecommunications standard development groups. Ex. 2010 ¶ 10.

Dr. Konchitsky further explains:

Members of 3GPP develop complete network system specifications by exchanging information regarding cellular telecommunications network technologies, including radio access, non-radio access, the core transport network, Wi-Fi integration, and service capabilities—such as codecs, security, quality of service. 3GPP's specifications and studies are thus contribution-driven by member companies. The 3GPP technologies from these groups are constantly evolving through generations of commercial cellular/mobile systems (such as UMTS WCDMA). Since the completion of the first LTE and the Evolved Packet Core specifications, 3GPP has become the focal point for mobile systems beyond 3G.

Id. Petitioner does not dispute this background information.

According to Mr. Rodermund, 3GPP published its temporary and final specifications on an FTP server accessible to the general public without restriction. Ex. 1007 ¶¶ 11–13. Mr. Rodermund testifies that by 1999 at least 100 companies were members of 3GPP and multiple people at each of these companies participated in 3GPP meetings. *Id.* ¶ 14. Dr. Konchitsky testifies consistently, stating that such meetings were attended by a “few dozen” to “a few hundred” people. Ex. 1042, 44:19–45:2. Dr. Konchitsky testifies that drafts of documents to be discussed at the meetings were handed out at the meetings, for example via “USB keys that people were moving from one to another.” *Id.* at 47:23–48:6; *see also id.* at 52:15–18 (“Q. And these companies had access to the materials circulated during these meetings; correct, sir? A. Again, if they are -- if they were at the meetings, they had it at the meeting.”), 54:22–24 (“[W]hen I attended the meetings, I got those circulated live and while I was there, you know, with this USB.”). Mr. Rodermund testifies that the date and location of the meeting at which a temporary document was presented is recorded on the first page of the document. Ex. 1007 ¶ 16. Patent Owner concedes that each of the documents at issue was handed out at the respective meetings to attendees. Tr. 44:3–8.

Mr. Rodermund also testifies that, as part of 3GPP’s regular business practice, documents, including temporary documents such as those at issue in this proceeding, were uploaded to 3GPP’s FTP server prior to meetings in which they were discussed. Ex. 1007 ¶¶ 14, 17. According to Mr. Rodermund, 3GPP sent emails notifying participants when documents had been uploaded to the FTP server. *Id.* ¶ 14. Dr. Konchitsky confirmed that he was able to access documents for meetings he did not attend.

Ex. 1042, 54:24–55:3 (“When I was not there, because my information was subscribed or registered and subscribed to particular information that I wanted, I was able to access that after that has been posted on the 3GPP Web site. On the FTP of the 3GPP.”). Mr. Rodermund identified MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal as documents that were made available on the FTP server. Ex. 1007 ¶¶ 19, 20, 24.

Based on the testimony of Mr. Rodermund and Dr. Konchitsky, we find that physical copies of MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal were distributed at the meetings listed on the faces of those documents. We further find that each of these documents was distributed to at least a “few dozen” and perhaps more than one hundred persons without restriction. We further find that, contemporaneously, additional persons were alerted, via e-mail, to the existence of these documents when they were uploaded to 3GPP’s FTP site.

In arguing that MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal were publicly available as of the meeting dates appearing on the faces of those documents, Petitioner focuses on the actual, physical dissemination of those documents at the 3GPP meetings convened to discuss those documents.² Reply 3–4. Petitioner contends that the recipients of the documents, representatives of major companies developing wireless standards and members of committees dedicated to the specific topics of

² At the oral hearing, Petitioner conceded that the evidence does not support a finding that 3GPP disseminated copies of those documents via email. Rather, Petitioner contends that such emails included notifications of the documents and locations on the FTP site. Tr. 23:9–24:14. *See also* Ex. 2002 (Rodermund Dep.), 35:21–36:10 (confirming that e-mails notified recipients of the availability of new documents).

those documents, were the persons most interested in the subject matter of those documents. *Id.* at 4–5. Petitioner draws a parallel between the facts of this proceeding and those of *MIT*. *Id.* at 8.

Patent Owner, for its part, focuses on the indexing, or lack thereof, of the documents stored on 3GPP’s online database. PO Resp. 30–31. Patent Owner argues that such documents were searchable only by a directory of uninformative file names, such as that shown in Exhibit 2003, with no guidance from an index, README file, document list, or other explanation of the documents that make up the list of file names. *Id.* at 30–31.

Mr. Rodermund could not recall the sophistication of 3GPP’s server search facility. Ex. 2002, 45:21–46:4. According to Patent Owner, in order to find a document on the 3GPP FTP site, a person would have had to know the temporary document number for the document and information about the meeting at which the document was discussed. PO Resp. 31–34. In that regard, Mr. Rodermund testifies that “the ftp document server is structured according to meetings, so each meeting has its own folder,” and that “by knowing the document number, you can retrieve the document from this meeting folder.” Ex. 2002, 13:2–6. Dr. Konchitsky testifies that, at the relevant time period, “it would be very difficult or impossible . . . for a person who was not an active participating member of the 3GPP review groups to search for documents on particular topics posted on the 3GPP servers.” Ex. 2010 ¶ 57. Notably, Patent Owner does not contend that members of the 3GPP review groups, particularly those who have received notices about posting of documents on the server, would have had difficulty in locating the posted documents.

Patent Owner argues that the facts of this proceeding are akin to those of *SRI*. PO Resp. 34–37. According to Patent Owner, “there is no indication that an anonymous person of ordinary skill in the art in 1999 would have visited the 3GPP FTP server and ‘freely navigated’ through the appropriate folders, sub-folders, and directories to find the Draft MMS Specifications and proposal relied upon by Petitioner.” *Id.* at 35–36. Patent Owner argues that Petitioner has not “provide[d] any evidence that the 3GPP FTP site was indexed in a manner comprehensible to an anonymous person of ordinary skill in the art in 1999 or that documents posted thereto were provided meaningful file names that might allow them to be located.” *Id.* at 36–37. Drawing a distinction between participants in 3GPP meetings and “anonymous” persons of ordinary skill, Patent Owner argues that “Petitioner offers no evidence that anyone outside of 3GPP working groups ever even viewed the Draft MMS Specifications on which it relies outside of the very meetings at which they were purportedly discussed.” *Id.* at 37.

As indicated above, we are guided by the Federal Circuit’s treatment of similar facts in cases involving the actual dissemination of documents or actual presentation to interested persons of ordinary skill, such as *MIT* and *Klopfenstein*. In *MIT*, a document held to be publicly accessible was presented orally to between 50 and 500 skilled artisans at an industry conference and, after the fact, actually distributed without restriction to six persons. 774 F.2d at 1108–09. In *Klopfenstein*, the Federal Circuit found that a set of printed posters, continuously displayed for two and a half days at one industry meeting and again for less than one day at another, was a printed publication, even though no copy of the presentation was disseminated at either meeting and the presentation was never catalogued or

indexed in any library or database. 380 F.3d at 1350. As explained above, in this proceeding, the papers in question were handed out without restriction to at least dozens of skilled artisans, with more being alerted to the documents via e-mail. Ex. 1007 ¶¶ 11–14, 16, 17; Ex. 1042, 47:23–48:6, 52:15–18, 54:22–55:3. That constitutes sufficient actual dissemination of the documents at issue to qualify them as printed publications, even if the posted documents on 3GPP’s server were not indexed or easily searchable.

The facts of the *SRI* case, on the other hand, are quite different from those in this proceeding. In *SRI*, a document (the “Live Traffic” paper) on a publicly accessible FTP server was not shown to be publicly accessible when “[n]either the directory structure nor the README file in the PUB subdirectory identifies the location of papers or explains the mnemonic structure for files in the EMERALD subdirectory, or any subdirectory for that matter,” and the evidence did “not show that an anonymous user skilled in the art in 1997 would have gained access to the FTP server and would have freely navigated through the directory structure to find the Live Traffic paper.” 511 F.3d at 1196. In *SRI*, the record showed that only one member of the public knew about the availability of the Live Traffic paper. *Id.* In *SRI*, there was no evidence that any copy actually was disseminated to anyone. Importantly, *SRI* specifically distinguished its facts from those of cases of actual dissemination, observing that, “[u]nlike the posters hung at a conference in *Klopfenstein*, the Live Traffic paper was not publicized or placed in front of the interested public.” 511 F.3d at 1197. Rather, the Federal Circuit characterized the facts of *SRI* as “most closely analogous to placing posters at an unpublicized conference with no attendees.” *Id.*

At the hearing, Patent Owner distinguished *MIT* from the facts of this proceeding by arguing that the distribution of MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal at the respective meetings “was not to the public person of ordinary skill.” Tr. 45:10–13. Patent Owner concedes that the people attending these meetings would have met the minimum qualifications for persons of ordinary skill in the art. *Id.* at 42:3–7. Nevertheless, Patent Owner argued, “[w]e must consider the people not at the meeting, because the person of ordinary skill is not just the folks at the meeting.” *Id.* at 42:13–18. According to Patent Owner, “[t]he petitioner’s definition of the person of ordinary skill does not say it’s a member of this working group. So we consider the public at large or the members of ordinary skill at large. So dissemination at the meeting doesn’t reach that person.” *Id.* at 41:8–13.

We are not persuaded by Patent Owner’s arguments. In *MIT*, it was sufficient that a document was made known to attendees of an industry conference. 774 F.2d at 1109. Similarly, in *Klopfenstein*, it was sufficient that a presentation was displayed to attendees of an industry conference attended by skilled artisans. 380 F.3d at 1351. Patent Owner does not point to any authority stating that, in the case of actual dissemination of a reference, the reference must have been made available to skilled artisans at large, rather than just to people with ordinary skill who already had an interest in the subject and have become members of a working group focusing on the subject. Here, the evidence shows that the documents in question were actually handed out to dozens of skilled artisans who were interested in the subject, without restriction on subsequent dissemination. We observe also that the members of 3GPP’s working group do not cease to

be members of the public at large when they have involved themselves in a working group focusing on specific subject matter of interest to them.

On the complete record, we conclude that MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal were sufficiently publicly accessible prior to the filing date of the '398 patent and, thus, are prior art printed publications.

2. Nokia Proposal is Prior Art

Nokia Proposal does not identify on its face its author or authors. The evidence shows, however, that the named inventor of the '398 patent, Matti Salmi, participated, along with Jeus Staack, as a delegate for Nokia in the meeting at which Nokia Proposal was presented. Ex. 1007 ¶ 27; Ex. 2016, 5. Patent Owner contends that, because of Mr. Salmi's participation in the meeting and alleged similarities between Nokia Proposal and the '398 patent, Mr. Salmi likely is the author of Nokia Proposal. PO Resp. 43–44. Patent Owner argues that Petitioner's challenge is under 35 U.S.C. § 102(a), and that under § 102(a), an inventor's own work is not prior art. Patent Owner contends that the priority date of the '398 patent is December 3, 1999, the date of the filing of an application in Finland. *Id.* at 44.

According to the predecessor of the Federal Circuit, “[o]ne's own work is not prior art under § 102(a) even though it has been disclosed to the public in a manner or form which otherwise would fall under § 102(a).” *In re Katz*, 687 F.2d 450, 454 (CCPA 1982). Nevertheless,

Disclosure to the public of one's own work constitutes a bar to the grant of a patent claiming the subject matter so disclosed (or subject matter obvious therefrom) . . . when the disclosure occurred more than one year prior to the date of the application, that is, when the disclosure creates a one-year time bar,

frequently termed a “statutory bar,” to the application under § 102(b).

Id. Thus, the threshold issue is whether Nokia Proposal qualifies as prior art under § 102(b).

Nokia Proposal was presented and distributed at a 3GPP meeting on June 14–16, 1999. Ex. 1009, 1. As explained in Section I.B.1 above, Nokia Proposal was publicly accessible as of the dates of this meeting. The earliest United States filing date that the ’398 patent can claim is December 1, 2000. Ex. 1001, [63]. The ’398 patent also lists a foreign application priority date of December 3, 1999, the filing date of the Finnish application. *Id.* at [30].

Section 102(b) (emphasis added) provides: “A person shall be entitled to a patent unless — . . . (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the *date of the application for patent in the United States.*” On its face, the express language of the statute states that its statutory bar is evaluated as of the patent’s filing date in the United States, in this case December 1, 2000. For purposes of § 102(b), we do not consider the December 3, 1999, foreign filing date. *See* 35 U.S.C. § 119(a) (“no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing”)³; MPEP §§ 706.02(VI), 2133.02(II). It is not necessary to determine who wrote Nokia Proposal.

³ We look to the pre-AIA version of 35 U.S.C. § 119(a). *See* AIA, Pub. L. No. 112–29, § 3(n)(1).

Nokia Proposal is prior art under § 102(b), regardless of who authored it. Accordingly, Patent Owner's arguments that Nokia Proposal represents the work of Mr. Salmi are inconsequential and do not help its position.

C. Asserted Grounds of Unpatentability

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” We resolve the question of obviousness on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations.⁴ *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

In an obviousness analysis, some reason must be shown as to why a person of ordinary skill would have combined or modified the prior art to achieve the patented invention. *See Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 (Fed. Cir. 2008). A reason to combine or modify the prior art may be found explicitly or implicitly in market forces; design incentives; the “interrelated teachings of multiple patents”; “any need or problem known in the field of endeavor at the time of invention and addressed by the patent”; and the background knowledge, creativity, and common sense of

⁴ Patent Owner does not argue that secondary considerations evidence nonobviousness, and the complete record does not include such evidence.

the person of ordinary skill. *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328–29 (Fed. Cir. 2009) (quoting *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418–21 (2007)).

1. Level of Ordinary Skill in the Art

Relying on Mr. Lanning’s testimony, Petitioner contends that a person of ordinary skill in the art would have had a Bachelor’s Degree in Electrical Engineering, Computer Science, Computer Engineering or a similar degree, and at least two years of professional experience in the programming, design, or implementation of telecommunications protocols, or equivalent educational and professional experience. Pet. 7–8 (citing Ex. 1002 ¶ 11). Patent Owner does not propose a level of ordinary skill. Nevertheless, Dr. Konchitsky testifies to a level of skill similar to that proposed by Petitioner. Ex. 2010 ¶ 29. In any case, we find that Petitioner’s proposal is consistent with the level of ordinary skill reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978). Accordingly, on the complete record, we adopt Petitioner’s statement of the level of ordinary skill in the art.

2. Scope and Content of the Prior Art

a. Overview of MMS-1 v0.1.0 and MMS-1 v0.2.0

MMS-1 v0.1.0 and MMS-1 v0.2.0 are two draft versions of a specification providing an overall service description and core requirements of a multimedia messaging service (“MMS”), and are directed to network operators, service providers and terminal and network manufacturers.

Ex. 1003, 5 § 1; Ex. 1004, 5 § 1. MMS-1 v0.1.0 purports to be a final version submitted to a 3GPP working group. Ex. 1003, 11. MMS-1 v0.2.0 purports to be a subsequent version presented to another 3GPP working group. Ex. 1004, 10 § 10.

(1) MMS-1 v0.1.0

Figure 1 of MMS-1 v0.1.0 is reproduced below:

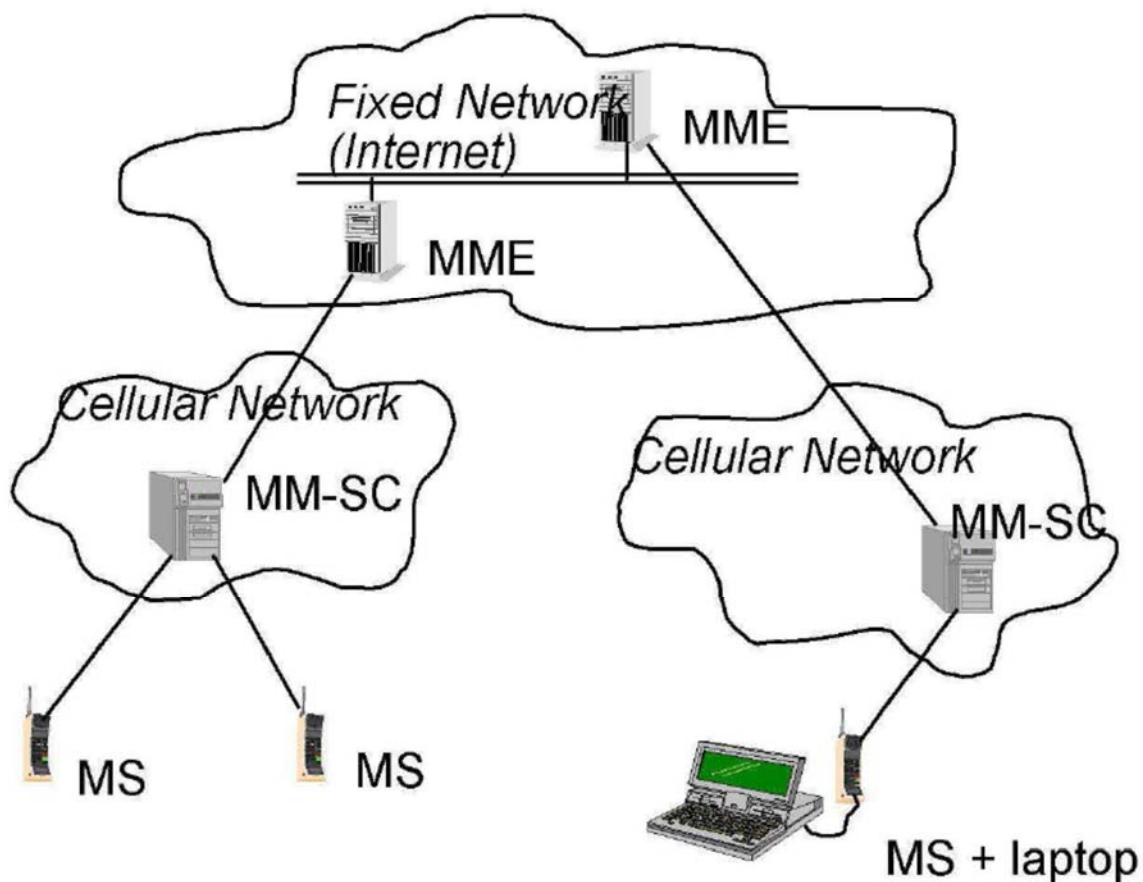


Figure 1 depicts an architecture for an MMS system, including mobile stations (“MS”) interfacing with an MM-SC of a cellular network, which, in turn, interfaces with a fixed network, such as the Internet. Ex. 1003, 5 § 1.

In its description of the high-level architecture of the system, MMS-1 v0.1.0 describes a “store and forward” system in which a multimedia

message (“MM”) is stored on a server at the MM-SC while an MS (also referred to as a MM-terminator) is notified as soon as it becomes reachable to the network. *Id.* at 6–7 § 4. Downloading of the MM is “either initiated by the MM-terminator, e.g. as a resulting action of a notification, or by the MM-SC to support the means of direct message delivery.” *Id.* MMS-1 v0.1.0 describes a “generic notification mechanism” for using notifications to “inform the MM-terminator about incoming messages, including a description of the message, e.g. content, size, type. Based upon this information, the recipient (user or application) can instruct the MM-SC how to handle this MM.” *Id.* at 8 § 5.4.

As to message delivery, MMS-1 v0.1.0 provides: “the standard shall support personalised MM handling, e.g. a user profile should be used for specifying user defined restrictions (parameters specifying what kind of messages should be screened or forwarded, directly delivered or stored at the MM-SC, etc.).” *Id.* at 7 § 5.2. According to MMS-1 v0.1.0, the user profile handling can be performed at either the MS or the MM-SC. *Id.* at 7–8 § 5.2. The user profile supports “filtering,” which “means that the MM or specific elements are not automatically delivered to the MM-terminator, but stored in MM-SC from where the MM-terminator can later explicitly request the MM.” *Id.* at 9 § 6.

(2) MMS-1 v0.2.0

Like MMS-1 v0.1.0, MMS-1 v0.2.0 provides high-level requirements for an MMS system, although MMS-1 v0.2.0 lacks detail as to the role of MM-SC in storing and forwarding MMs. Ex. 1004, 6–7 § 4. As part of its description of general service capabilities, MMS-1 v0.2.0 states that “[t]he

MMS shall provide the capability to support MM prioritisation and MM screening (e.g. the sender and recipient of the MM can prioritise the importance of the multimedia messages or automatically delete ‘junk mail’ without delivery to the recipient’s terminal).” *Id.* at 8 § 5.1.

MMS-1 v0.2.0 also describes multimedia messaging profiles, wherein “[t]he user shall be able to create, update, store, transfer, interrogate, manage and retrieve his multimedia messaging profiles” and “can define what media types and notification shall be delivered to him (e.g. voice only or text only).” *Id.* at 9 § 6. MMS-1 v0.2.0, however, does not specify where such profiles are stored. *Id.*

b. Overview of MMS-2

Patent Owner contends that MMS-2 is related to MMS-1 v0.1.0 and MMS-1 v0.2.0 in that “specification 23.140 version 0.1.0 (Ex. 1006) describes how the service requirements discussed in specification 22.140 (Exs. 1003, 1004, and 1005) are **realized** with the selected technologies.” PO Resp. 13. Although Petitioner does not cite MMS-2 in its challenges, Patent Owner argues that it “provides context for how a person of ordinary skill in the art would interpret the drafts of the 22.140 specification, Exs. 1003–1005.” *Id.* at 14.

Figure 2 of MMS-2 is reproduced below:

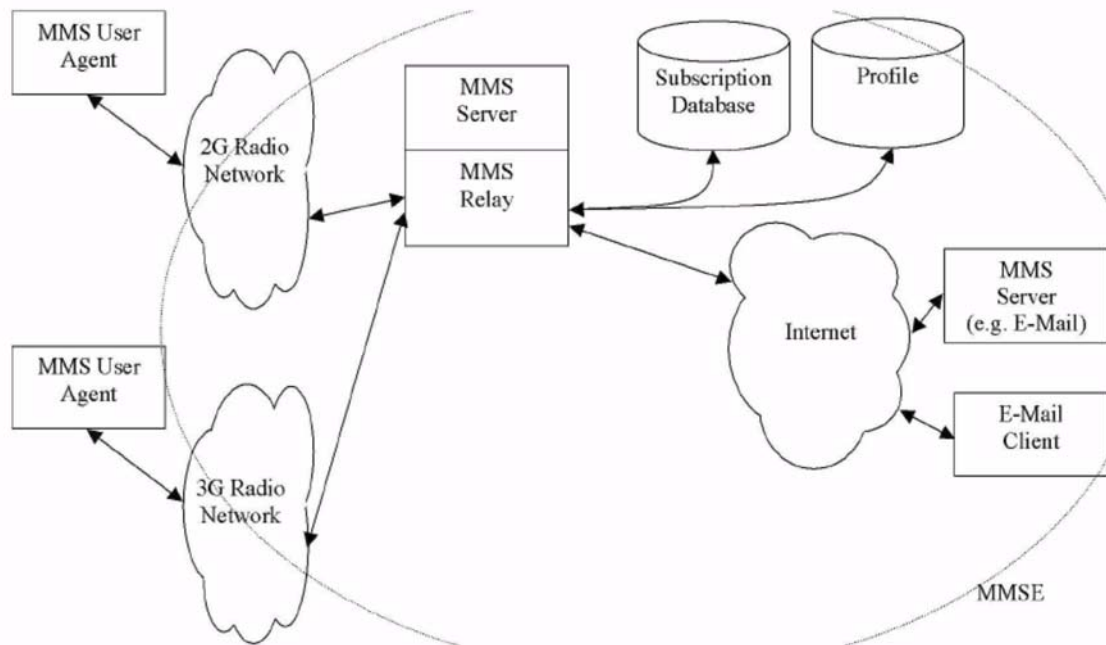


Figure 2 : MMS Architecture Overview

Figure 2 is a block diagram of an MMS architecture. In this diagram, “Profile” information is shown as a database connected to an MMS Relay, rather than connected to an MMS User Agent, which corresponds to a mobile terminal.

c. Overview of Nokia Proposal

Nokia Proposal is a technical contribution made by Nokia, and gives a brief introduction to architectural issues related to MMS. Ex. 1009, 1 (Introduction). Nokia Proposal proposes a network architecture, including mobile stations and other network elements, at “a general level, independent of the exact interfaces and protocols used between the network elements.” *Id.* (Proposed Network Architecture for MMS).

Figure 3 of Nokia Proposal is reproduced below:

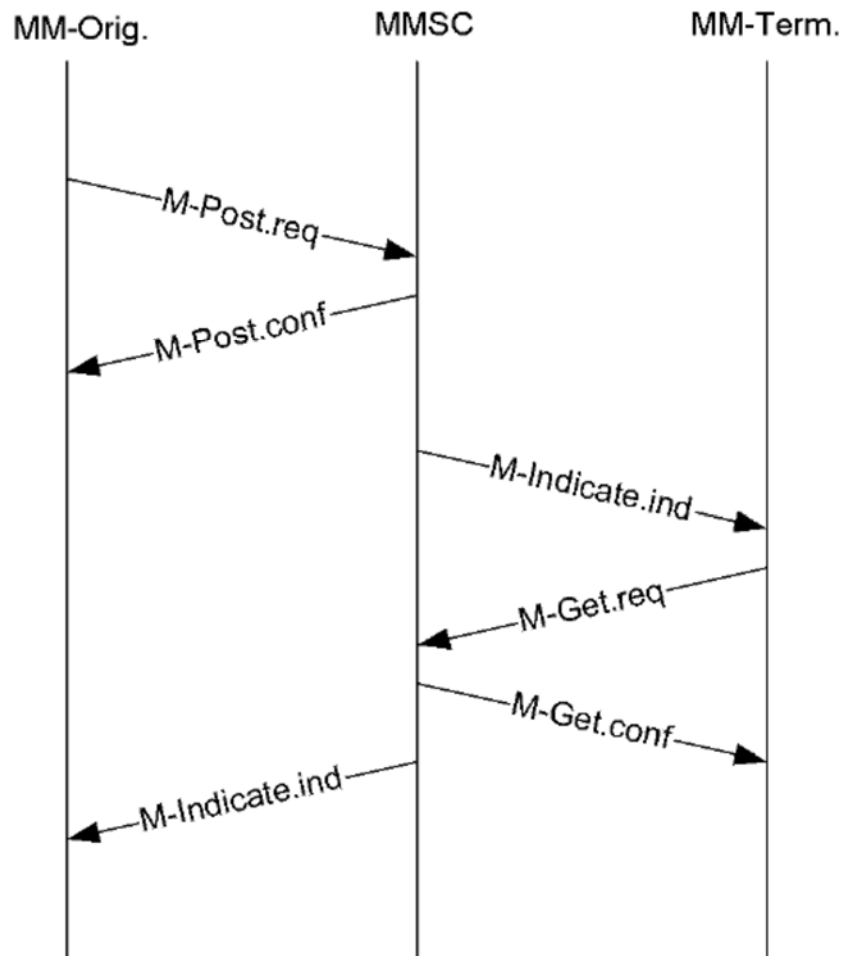


Figure 3. The MMS operations.

Figure 3 is a flow diagram that provides an overview of the basic operations needed to deliver a multimedia message from a multimedia originator (“MM-Orig.”) to a multimedia terminal (“MM-Term.”) via a MM-SC (also abbreviated “MMSC”). *Id.* at 2–3. MM-Orig. sends a multimedia message using an M-Post operation. When the MM-SC tries to deliver the message to MM-Term, it first sends an M-Indication operation to MM-Term. After receiving M-Indication, MM-Term. retrieves the message from MM-SC using an M-Get operation. *Id.* at 2. “In the M-Indicate operation, the contents header and the size of the multimedia message is delivered. In the

M-Get operation, the MM-Terminator indicates which part of the content it wants to receive.” *Id.* at 3.

Figure 5 of Nokia Proposal is reproduced below:

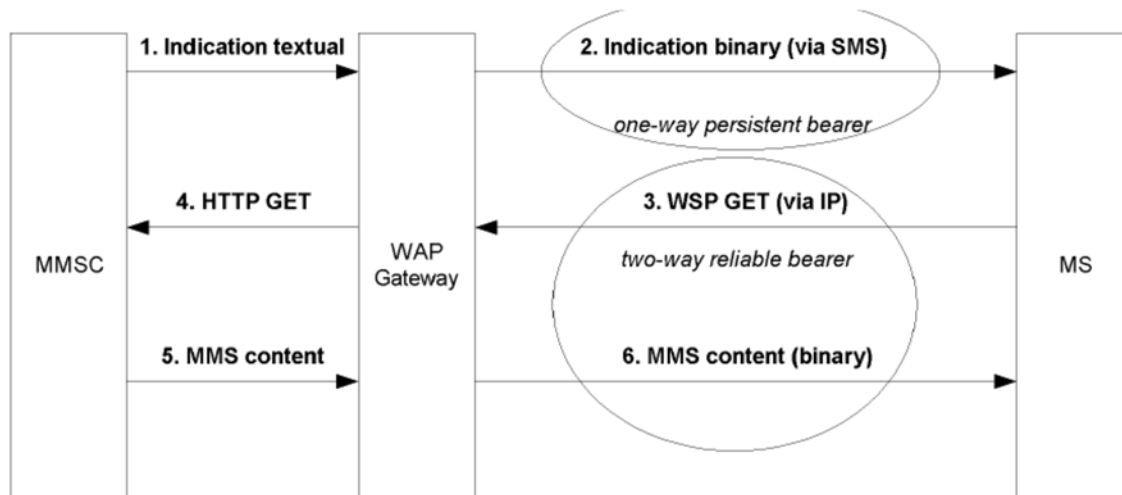


Figure 5. Delivery of multimedia message from MMSC to MS.

Figure 5 is a flow diagram showing delivery of multimedia messages from the MM-SC to an MS via a WAP Gateway. *Id.* at 4. Along with Figure 4, Figure 5 shows “how the WAP Gateway is located in front of the MMSC to allow the conversion of WSP requests to the corresponding HTTP requests.” *Id.*

3. Alleged Obviousness of Claim 10 over MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal

Petitioner contends that claim 10 would have been obvious over MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal. Pet. 11–20. Patent Owner argues that the prior art does not teach a “filtering parameter” (PO Resp. 45–55) and that the prior art does not teach use of a filtering parameter

at a terminal device (*id.* at 55–59). We address the parties’ contentions below and conclude that claim 10 would have been obvious.

Petitioner contends that the “MS,” “Cellular Network,” and “MM-SC,” shown in Figure 1 of MMS-1 v0.1.0 (reproduced above), correspond to the “receiver,” “wireless network,” and “network element,” respectively, of claim 10. Pet. 11–12. We agree with Petitioner and find that MMS-1 v0.1.0, for example Figure 1, teaches a “receiver” (MS), a “wireless network” (Cellular Network), and a “network element” (MM-SC), as recited in claim 10. Petitioner further argues, citing to Mr. Lanning’s testimony, that a skilled artisan would have understood that the mobile stations described in MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal would have included processors. *Id.* at 15–16 (citing Ex. 1002 ¶ 47). We credit Mr. Lanning’s testimony on this point and find that the mobile stations described in the prior art references would have included processors.

We also find that the notification described in MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal includes a “filtering parameter,” as recited in claim 10. Pet. 13–14. Specifically, such a notification includes “a description of the message, e.g. content, size, type.” Ex. 1003, 8 § 5.4. The notification is sent to the MS (receiver) via the Cellular Network (wireless network). *Id.*, Fig. 1, 6–7 § 4 (“The MM-Terminator shall be . . . informed by an appropriate notification.”), 8 § 5.4 (“Notifications shall be used [to] inform the MM-terminator about incoming messages.”); Ex. 1009, Fig. 3. Thus, MMS-1 v0.1.0 teaches “a receiver configured to receive a filtering parameter from a network element through a wireless network,” as recited in claim 10.

We further find that the prior art teaches “a processor configured to allow or prevent the receiving of electronic information through the wireless network on the basis of said filtering parameter.” Pet. 15–16. Specifically, MMS-1 v0.1.0 describes that “[t]he MMS shall provide MM downloading . . . initiated by the MM-terminator, e.g. as a resulting action of a notification.” Ex. 1003, 6–7 § 4. Here, a processor allows the mobile station to receive a MM based on the notification. MMS-1 v0.1.0 also describes that MMs can be screened or filtered (prevented) based on a user profile at the mobile station. *Id.* at 7–8 § 5.2, 9 § 6. Thus, “the apparatus is configured not to receive the electronic information through the wireless network when the filtering parameter denotes the electronic information being prevented,” as recited in claim 10. Pet. 16–17.

As noted above, MMS-1 v0.1.0 describes that messages can be delivered or screened based on a “user profile.” Ex. 1003, 7–8 § 5.2, 9 § 6. We credit Mr. Lanning’s testimony (Ex. 1002 ¶ 53) that interaction with the user profile would have occurred through a user interface. Thus, we find that the prior art teaches “a user interface for marking in advance the receiving of the electronic information as being allowed or prevented on the basis of the filtering parameter.” Pet. 17. As noted above, allowing or screening of MMs can be based on the user profile. Ex. 1003, 1–8 § 5.2. As more clearly stated in MMS-1 v0.2.0, “the user can define what media types and notification shall be delivered to him (e.g., voice only or text only).” Ex. 1004, 9 § 6. The logical implication of these disclosures, read together, is that the parameters stored in the user profile are used to evaluate the information in a notification (corresponding to one or more filtering parameters) to determine whether to instruct the MM-SC to prevent or allow

delivery of the message. We credit Mr. Lanning's testimony that this would be done by the mobile station's processor. Ex. 1002 ¶ 56. Thus, the prior art teaches "wherein the processor is further configured to compare the received filtering parameter to said marking made in advance." Pet. 17–18.

As to the limitation "said apparatus is arranged to receive the electronic information through the wireless network only when said comparison shows the receiving of the electronic information being allowed," as recited in claim 10, Petitioner cites to the teachings in MMS-1 v0.1.0 that a user profile includes parameters specifying what kind of messages should be screened and that the MS can inform the MM-SC how to handle a multimedia message based on information in the notifications. Pet. 19 (citing Ex. 1003, 7 § 5.2, 8 § 5.4). Petitioner also relies on MMS-1 v0.1.0's statement that "[t]he MMS shall provide MM downloading . . . initiated by the MM-terminator, e.g. as a resulting action of a notification." *Id.* (quoting Ex. 1003, 7 § 4). Petitioner alternatively relies on Nokia Proposal to show this limitation. *Id.* at 19–20. That reliance is unnecessary because Petitioner has shown that the system and method of MMS-1 v0.1.0 and MMS-1 v0.2.0 includes this feature.

Petitioner contends that a skilled artisan would have combined MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal because all of these documents were directed to a common solution for a common purpose, MMS design and implementation. Pet. 10. According to Petitioner and Mr. Lanning, these specifications were directed to developing the same industry standard for mobile phone communication. *Id.* (citing Ex. 1002 ¶ 35). We agree with Petitioner. As Mr. Lanning testifies, MMS-1 v0.1.0 and MMS-1 v0.2.0 were directed to establishing service requirements for systems that

implemented MMS. Ex. 1002 ¶ 35; *see also* Ex. 1003, 5 § 1 (“This Technical Specification defines the stage one description of the Multimedia Messaging Service, MMS. Stage one is an overall service description, primarily from the subscriber’s and service providers’ points of view.”); Ex. 1004, 5 § 1 (same). As they are iterations of the same document, we find that a skilled artisan would have considered their teachings together. Mr. Lanning further testifies that Nokia Proposal sought “to provide the basis for the technical discussion related in choosing the suitable platform for MMS.” *Id.* (quoting Ex. 1009, Introduction). Thus, Nokia Proposal sought to propose a particular architecture for implementing aspects of the service requirements set forth in MMS-1 v0.1.0 and MMS-1 v0.2.0. As such, we find that a skilled artisan also would have considered Nokia Proposal together with MMS-1 v0.1.0 and MMS-1 v0.2.0.⁵ On the complete record, we find that a skilled artisan would have had reason to combine MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal.

Patent Owner responds that the prior art does not teach a “filtering parameter” under its proposed construction of that term. PO Resp. 45–55. According to Patent Owner, “[r]ather than suggest a parameter for classifying messages based on general information concerning the messages, at most, the Draft MMS Specifications discuss the need to handle

⁵ We note that Patent Owner also contends that a skilled artisan would have considered the draft specifications collectively (although, as discussed below, Patent Owner draws a different conclusion as to whether the drafts teach a user profile at mobile station). PO Resp. 56 (“[T]hat person of ordinary skill would use and consider the documents collectively, giving most attention and reliance to more recent drafts of the related specifications.”).

multimedia messages that incorporate varying media types.” *Id.* at 47.

Patent Owner distinguishes between a parameter that identifies a portion of a message for filtering from a parameter that identifies the entire message for filtering: “While discarding or providing special handling for elements ***within a message*** that have particular media types may be a category of filtering, it is not the classification based on general information concerning a ***message*** that is enabled by the filtering parameter of the claims of the ’398 patent.” *Id.* at 48; *see also id.* at 51 (“[A]ny filtering implied [in MMS-1 v0.1.0 § 5.2] is based on the type of a message element, and not a message itself—much less the message-class-based message filtering (e.g., personal, advertisement, informative) taught by the ’398 patent.”), 54–55 (“It is evident from the evolution of the MMS-1 specification drafts (Exs. 1003–1005) that ‘indicat[ing] which part of the content it wants to receive’ [as recited in Nokia Proposal, at 3] refers to controlling delivery of particular message elements to ensure interoperability, as discussed above.”). Patent Owner echoes this argument in its characterization of the prior art’s user profile information: “what is suggested by MMS-1 v0.1.0, and reinforced by the later drafts, is that personalized message handling through a user profile refers to a user’s preferences about which media types included within a message should be permitted to be delivered to the user’s mobile device.” *Id.* at 50.

As explained in Section I.A.2 above, a “filtering parameter” is “an indication transmitted to the mobile terminal that is used as the basis for allowing or preventing the receiving of electronic information.”

Specifically, we reject Patent Owner’s arguments that a filtering parameter is limited to general information about an entire message to the exclusion of

information that identifies the message as including a particular media type, such as a picture or video. Moreover, to the extent Patent Owner is arguing that claim 10 requires that a “message” be accepted or rejected in its entirety, Patent Owner has not supported that position with persuasive evidence. Claim 10 recites, inter alia, “a processor configured to allow or prevent the receiving of electronic information . . . on the basis of said filtering parameter.” Patent Owner does not explain why “electronic information” should be read to mean a specific unit of information, such as a “message.” Moreover, MMS-1 v0.1.0 states that “the MM or specific elements are not automatically delivered to the MM-terminator, but stored in MM-SC from where the MM-terminator can later explicitly request the MM.” Ex. 1003, 9 § 6. Thus, Patent Owner’s argument is not persuasive.

Patent Owner also argues that the prior art does not teach “‘a processor configured to allow or prevent the receiving of electronic information on the basis of said filtering parameter,’ where that processor is **at the mobile device** itself as recited in claim 10.” PO Resp. 55. Claim 10 recites “wherein the processor is further configured to compare the received filtering parameter to said marking made in advance.” As explained above, Petitioner maps the “profile containing user preferences” of MMS-1 v0.1.0, also referred to as “Multimedia messaging profiles” in MMS-1 v0.2.0, to claim 10’s “marking made in advance.” Pet. 17 (citing Ex. 1003, 9 § 6; Ex. 1004, 9 § 6). According to MMS-1 v0.1.0, “[t]he profile information can be located in either or both of the MM-terminator and/or the MM-SC.” Ex. 1003, 9 § 6. On that basis, Petitioner argues that the marking made in advance can be stored at the mobile station and, therefore, the processor that

compares the received filtering parameter (notification) to the marking made in advance (profile) can be the mobile stations' processor. Pet. 17–18.

Patent Owner concedes that MMS-1 v0.1.0 teaches that the filtering based on the profile can be at the mobile station. Tr. 47:8–13. Nevertheless, Patent Owner argues that MMS-2 describes a user profile that “is not located at the terminal (e.g., mobile phone), but is instead located elsewhere in the network.” PO Resp. 57. Patent Owner contends that MMS-2 is a later document in the same set of specifications as MMS-1 v0.1.0 and that a “person of ordinary skill would use and consider the documents collectively, giving most attention and reliance to more recent drafts of the related specifications.” *Id.* at 56. According to Patent Owner, “a person of ordinary skill in the art would understand that differences between the specifications reflected a progressive understanding of the current thinking of the working group regarding the service it described.” *Id.* at 58.

MMS-2 describes a “User Profile” that includes a “set of rules how to handle incoming messages and [their] delivery.” Ex. 1006 § 4.2. Figure 2 of MMS-2 depicts a “Profile” as remote from an “MMS User Agent.” *Id.* Additionally, Figures 3–11 depict various information flows among a Terminal, a Relay, and a Server, with a Profile depicted as remote from the Terminal. *Id.* § 4.3. We agree with Patent Owner that MMS-2 provides examples of profile information remote from a mobile terminal and, accordingly, that any filtering based on that profile information would be remote from the mobile terminal.

In the Patent Owner Response, Patent Owner argued that “a person of ordinary skill, reading these Draft MMS Specifications and seeing that only the earliest draft (Ex. 1003, MMS-1 v.0.1.0) indicated that a profile might be

stored or used at a mobile device as opposed to a remote server, would be discouraged from exploring the option.” PO Resp. 58–59. Patent Owner cited no evidence supporting this contention. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). At the oral argument, Patent Owner conceded that MMS-2 does not teach away from filtering at the mobile station, “[c]ertainly not in the classic disparagement situation.” Tr. 48:8–12. We conclude that MMS-2 does not teach away from “a processor configured to allow or prevent the receiving of electronic information on the basis of said filtering parameter,” as recited in claim 10, where that processor is at the mobile device.

At the oral hearing, Patent Owner stated that its position is that MMS-2 “reflected the most up-to-date thinking of the relevant committee. And it is that thinking that the person of ordinary skill would look to when going to implement systems of this nature.” Tr. 47:19–22. Notwithstanding that the MMS-1 v0.1.0, MMS-1 v0.2.0, and MMS-2 are related to each other and are produced in chronological order on a common subject, the disclosures in each stand on their own merit. The teachings in an earlier document, i.e., MMS-1 v0.1.0, insofar as the public is concerned, are not rendered null and void because a later document, MMS-2, reflects a changed preference of the working group and does not contain the same disclosure. At issue is what each document discloses in terms of technology, not what document reflects the most current thinking of the working group on the subject.

Patent Owner, moreover, does not point to evidence that MMS-2 ascribes any particular advantage to implementing a user profile remote from a mobile terminal. In any case, “just because better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes.” *In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012). As explained above, we find that MMS-1 v0.1.0 teaches “a processor configured to allow or prevent the receiving of electronic information on the basis of said filtering parameter,” as recited in claim 10, where that processor is at the mobile device. Patent Owner does not persuade us that the disclosure of MMS-2 teaches away, repudiates, or otherwise throws the teachings of MMS-1 v0.1.0 into doubt.

In sum, as explained above, MMS-1 v0.1.0 and MMS-1 v0.2.0, with or without Nokia Proposal, teach each limitation of claim 10. Petitioner has introduced persuasive evidence that a skilled artisan would have had reasons to combine the teachings of these references to arrive at the subject matter of claim 10. Patent Owner does not argue or present evidence of secondary considerations of nonobviousness. We have considered Patent Owner’s evidence and argument and find it unpersuasive. In sum, upon consideration of all the evidence, including the evidence in the Petition and Patent Owner’s Response, we conclude that Petitioner has proved by a preponderance of the evidence that claim 10 would have been obvious over MMS-1 v0.1.0 and MMS-1 v0.2.0, with or without Nokia Proposal.

4. Alleged Obviousness of Claim 13 over MMS-1 v0.1.0 and MMS-1 v0.2.0

For the limitations of claim 13: “receiving by a device a filtering parameter associated with electronic information that is to be received through a wireless network”; “allowing or preventing receiving of the electronic information on the basis of the filtering parameter”; and “preventing the receiving of the electronic information through the wireless network if the filtering parameter denotes the electronic information as information whose receipt is to be prevented,” Petitioner cites to the same disclosure in MMS-1 v0.1.0 and MMS-1 v0.2.0 as it does for the similar limitations of claim 10. Pet. 33–34. Patent Owner presents its arguments for claim 13 along with its arguments for claim 10, discussed above. PO Resp. 45–59. For the reasons given for claim 10, we find that MMS-1 v0.1.0 and MMS-1 v0.2.0 teach these limitations and that a skilled artisan would have had reason to combine MMS-1 v0.1.0 and MMS-1 v0.2.0.

Regarding the limitation “wherein the filtering parameter is received over a wireless network using a connectionless push method,” Petitioner argues that the notification can be sent over a wireless network (“Cellular Network” of MMS-1 v0.1.0, Fig. 1) via SMS (*Id.* at 9 § 5.6). Pet. 34–37. As Petitioner notes, and as we explain in Section I.A.1 above, the ’398 patent gives SMS as an example of a connectionless push method. Thus, we find that MMS v0.1.0 teaches that the notification and, accordingly, the filtering parameter, is received by the MS using a connectionless push method (SMS). Patent Owner does not present separate argument as to this limitation of claim 13.

MMS-1 v0.1.0 and MMS-1 v0.2.0 teach each limitation of claim 13. Petitioner has introduced persuasive evidence that a skilled artisan would have had reasons to combine the teachings of these references to arrive at the subject matter of claim 13. Patent Owner does not argue or present evidence of secondary considerations of nonobviousness. We have considered Patent Owner's evidence and argument and find it unpersuasive. In sum, upon consideration of all the evidence, including the evidence in the Petition and Patent Owner's Response, we conclude that Petitioner has proved by a preponderance of the evidence that claim 13 would have been obvious over MMS-1 v0.1.0 and MMS-1 v0.2.0.

III. CONCLUSION

MMS-1 v0.1.0, MMS-1 v0.2.0, and Nokia Proposal qualify as printed publications under 35 U.S.C. § 102(b). Nokia Proposal is prior art to the '398 patent under 35 U.S.C. § 102(b) regardless of authorship. Petitioner has demonstrated, by a preponderance of the evidence, that claim 10 is unpatentable over MMS-1 v0.1.0 and MMS-1 v0.2.0, with or without Nokia Proposal; and that claim 13 is unpatentable over MMS-1 v0.1.0 and MMS-1 v0.2.0.

IV. ORDER

For the reasons given, it is:

ORDERED, based on a preponderance of the evidence, that claims 10 and 13 are unpatentable; and

FURTHER ORDERED, because this is a final written decision, the parties to this proceeding seeking judicial review of our Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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