

UNITED STATES PATENT AND TRADEMARK OFFICE

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PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,

Petitioner

v.

APPLIED CAPITAL, INC.,

Patent Owner

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Case No. IPR2023-00419

Patent Nos. 9,728,082

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**PATENT OWNER'S PRELIMINARY RESPONSE**  
**PURSUANT TO 37 C.F.R. § 42.107**

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| 2002       | Curriculum Vitae of Jun Zheng, Ph.D. (“ <b>Zheng CV</b> ”)                                                                                                                                         |
| 2003       | Memorandum and Order, <i>Applied Capital, Inc. v. ADT Corp.</i> , No. 1:16-CV-00815, 2019 WL 3719099 (D.N.M. Aug. 7, 2019) (“ <b>Patentability Order</b> ”)                                        |
| 2004       | Memorandum and Order on Claim Construction, <i>Applied Capital, Inc. v. ADT Corp.</i> , No. 1:16-CV-00815, 2019 WL 3782321 (D.N.M. Aug. 12, 2019) (“ <b>Markman Order</b> ”)                       |
| 2005       | Notice of Allowability, File History of U.S. Patent No. 8,378,817 (App. No. 12/695,373), Mail Date Dec. 11, 2012 (“ <b>Notice of Allowability</b> ”)                                               |
| 2006       | DECISION Denying Institution of <i>Inter Partes</i> Review, <i>ADT LLC and The ADT Corp. v. Applied Capital, Inc.</i> , IPR2017-01825, Paper 7 (PTAB Jan. 1, 2018) (“ <b>Institution Denial</b> ”) |
| 2007       | DECISION Denying Petitioner’s Request for Rehearing, <i>ADT LLC and The ADT Corp. v. Applied Capital, Inc.</i> , IPR2017-01825, Paper 9 (PTAB Mar. 15, 2018) (“ <b>Rehearing Denial</b> ”)         |
| 2008       | W3C et al. “Scalable Vector Graphics (SVG) 1.1 Specification” Nov. 15, 2002, in File History of U.S. Patent Publication No. 2005/0108364 to David M. Callaghan et al. (“ <b>SVG Spec</b> ”)        |
| 2009       | Appellants’ Appeal Brief, File History of U.S. Patent Publication No. 2002/0143934 (App. No. 09/825,506) to Geoffrey T. Barker et al., Dated Dec. 9, 2008 (“ <b>Barker Appeal Brief</b> ”)         |

## **I. PRELIMINARY STATEMENT**

The Board should deny institution of Motorola's petition challenging the validity of U.S. Patent No. 9,728,082 ("’082 patent") just as it denied institution of IPR2017-01825. In August of 2019, senior federal district court Hon. Judge Joseph F. Bataillon issued an order [EX2003] where he detailed the ’082 patent's disclosure of a novel premise monitoring system and found that the claims covered patentable subject matter. Among other things, the court credited the patentee's prosecution amendments, the Examiner's reasons for allowance [EX2005], and this Board's decisions to deny institution [EX2006] and rehearing [EX2007] in IPR2017-01825.

In other words, the patentee, Examiner, this Board, and Judge Bataillon have all emphasized that the ’082 patent claims are novel and nonobvious in view of limitations requiring the determining of a communication destination and method based on a monitored event and retrieving (and dispatching), based on that event, of a specific set of image data: "images comprising all of the members selected from the group consisting of superimposed visual indicators, hierarchically organized graphical images, and vector-based graphical images." <sup>1</sup>

In its petition, Motorola raises nothing but hindsight arguments based on four references that, on their face, individually and collectively, fail to disclose all

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<sup>1</sup> EX2003 at 4–6; EX2005 at 2–3, 8–12; EX2006 at 12–17; EX2007 at 3–7.

elements of the claimed invention and, in fact, teach away from one another, such that no person of skill in the art would have been motivated to make the combinations Motorola proposes. Accordingly, all grounds to institute review should be denied.

## **II. OVERVIEW OF THE '082 PATENT**

U.S. Patent No. 9,728,082 shares a common specification with U.S. Patent No. 8,376,817, which is also being challenged in a related *Inter Partes* Review. The '082 patent is a continuation of the '817 patent, and its claims recite certain structures for performing the methods and steps claimed in the '817 patent. The earliest priority date of both patents is established by a provisional patent application (Ser. No. 61/147,948) filed on January 28, 2009 [EX1004]. Detailed descriptions of the '817 patent's disclosure and claims (and hence the '082 patent's disclosure and claims) are set forth in the Patentability Order [EX2003], Notice of Allowability [EX2005], and Institution Denial [EX2006].

The '082 patent describes and claims a novel method of notifying a first responder or other person of the current situation at a premises by determining a communication destination and method based on an event (i.e. “device identifier and device condition”) detected on the premises and by retrieving (and dispatching), based on that event, a specific set of image data: “images comprising all of the

members selected from the group consisting of superimposed visual indicators, hierarchically organized graphical images, and vector-based graphical images.”<sup>2</sup>

The retrieved and dispatched image data allow for dynamic rendering of a resolution independent, event-specific, remote monitoring user interface in which superimposed icons and indicators represent device types, states, locations, and conditions on a map of the premises through which additional event-related images are accessible.<sup>3</sup> The USPTO explicitly found that the patentee’s amendment of the claims to include the limitation requiring retrieving, based on the event, “superimposed visual indicators, hierarchically organized images, and vector-based graphical images” rendered the claimed invention novel and non-obvious over voluminous prior art of record.<sup>4</sup>

Claims 1 and 17 are the only independent claims in the ’082 patent. Claims 2–16 depend on claim 1. Claim 1 is written as follows:

A non-volatile and non-transient computer-readable medium comprising machine-executable code comprising:

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<sup>2</sup> EX2001 at ¶ 38; EX2003 at 2; EX2005 at 3, 8; EX2006 at 3–4.

<sup>3</sup> EX2001 at ¶ 37; EX2003 at 3–4; EX2005 at 3, 8; EX2006 at 3.

<sup>4</sup> EX2005 at 8–12; *see also* EX2003 at 4 (“The USPTO explicitly found that the patentee’s amendment reciting the dynamically-rendered, event-specific, graphical floor plan rendered the claimed premises monitoring invention novel and non-obvious over the voluminous prior art of record.”).

code receiving one or more signals containing a device identifier and a device condition from one or more remote alarm monitoring systems;

code retrieving enhanced information based on the device identifier and the device condition;

code determining one or more communication methods and communication destinations *based on the device identifier and the device condition*; and

code dispatching the enhanced information to the one or more communication destinations using the one or more communication methods; and

wherein the retrieving enhanced information based on the device identifier and the device condition comprises *retrieving images based on the device identifier and the device condition, the images comprising all of the members selected from the group consisting of superimposed visual indicators, hierarchically organized graphical images, and vector-based graphical images.*

Claim 17 reads as follows:

A computerized system comprising a central monitoring system receiving one or more signals containing a device identifier and a device condition from one or more remote alarm monitoring systems, *retrieving enhanced*

*information based on the device identifier and the device condition, determining one or more communication methods and communication destinations based on the device identifier and the device condition, and dispatching the enhanced information to the one or more communication destinations using the one or more communication methods, wherein the enhanced information based on the device identifier and the device condition comprises images based on the device identifier and the device condition, the images comprising all of the members selected from the group consisting of superimposed visual indicators, hierarchically organized graphical images, and vector-based graphical images.*

### **III. OVERVIEW OF THE REFERENCES CITED BY PETITIONER**

#### **A. Barker (U.S. Patent Publication No. 2002/0143934)**

Published on October 3, 2002, Barker teaches a security monitoring system that collects security device data and logs events that violate pre-programmed rules.<sup>5</sup> For certain events, the system also might call or page a person or initiate a protective response such as an audible alarm or the spraying of dye.<sup>5F6</sup> The system also allows

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<sup>5</sup> EX2001 ¶¶ 46-49; EX1010 at 107; EX1008 at Abstract.

<sup>6</sup> EX2001 ¶ 46; EX1008 at ¶ 54–55.

an appropriate person to log in a view a historical log of events listed in a table as shown in Figure 9 below.<sup>7</sup>

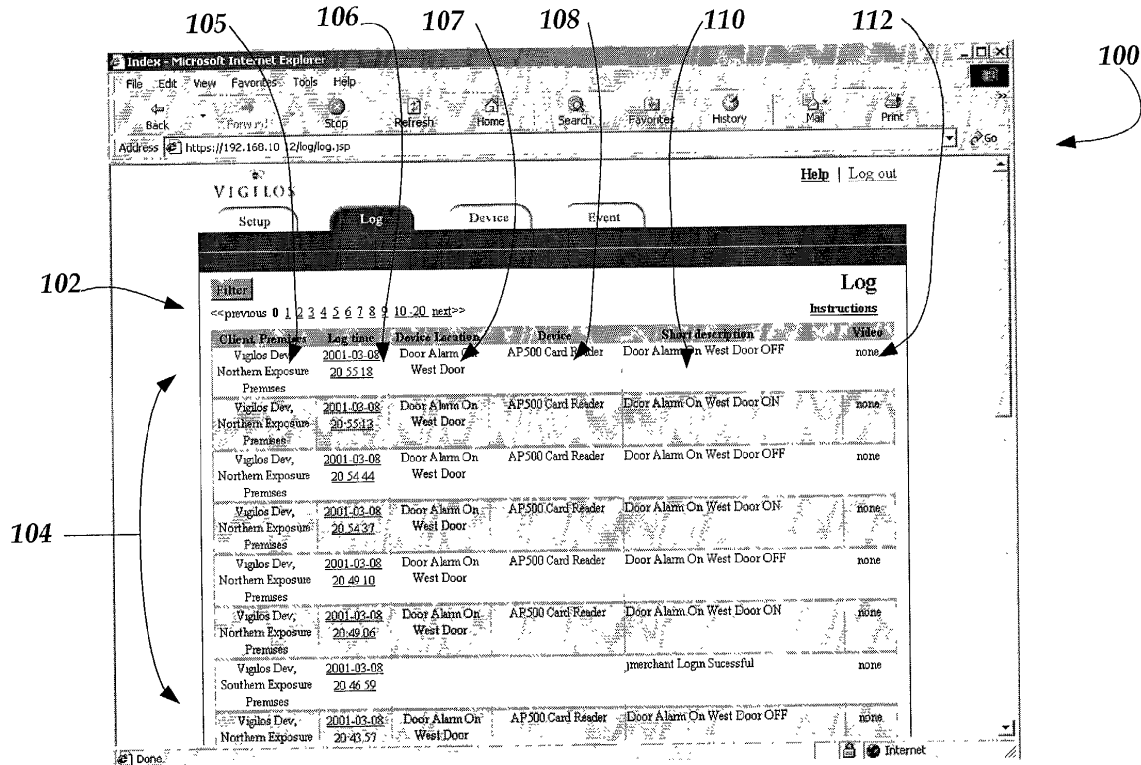


**Fig.9.**

Barker does not involve the retrieval or transmission of image data of any kind or the representation or display of premises data using images; instead, Barker's system simply monitors device activity in a way that triggers the calling of

<sup>7</sup> EX2001 ¶ 46; EX1008 at ¶ 68-69, Figs. 9-10.

authorities or the initiation of audible alarms, and it allows an administrator to review a text-based log of the events that have occurred over time in a table.<sup>8</sup>

### B. Childers (U.S. Patent Publication No. 2002/0161885)

Published on October 31, 2002, Childers discloses a system for organizing data about groups of appliances in a network using a map or a graph view.<sup>9</sup> The map view shows current data (e.g. location, state, configuration) for an appliance group, while the graph view can show data about an appliance group over time.<sup>10</sup>

Map View Showing Current Data  
about Appliance Grouping

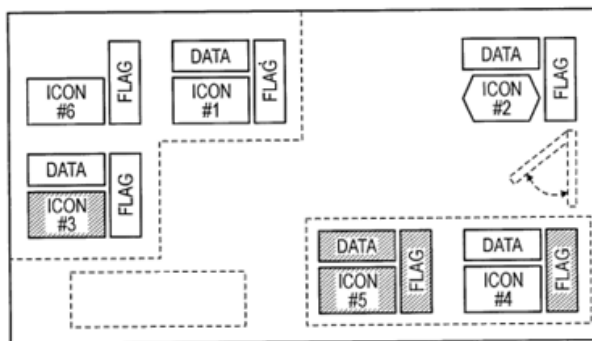


FIG. 8C

Graph View Showing Log of  
Sensor Values Over Time

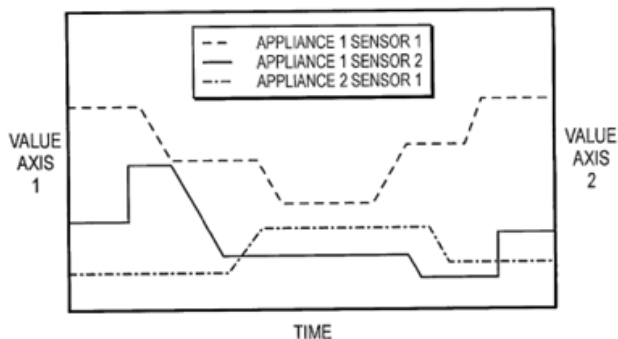


FIG. 14

<sup>8</sup> EX2001 ¶¶ 46–49; EX1008 at ¶¶ 54–55, 68–69, Figs. 9–10; EX2009 at 16–17 (explaining Barker is about “monitor[ing] . . . the underlying activity the devices are installed to perform,” not “graphically represent[ing] the location of various devices within a location”).

<sup>9</sup> EX1009 Fig. 14 (graph view); EX1009 Figs. 8a–8d (map view).

<sup>10</sup> As Figure 14 shows, in Childers’ graph view, data values for multiple appliances are plotted on an axis over time. EX2001 at ¶¶ 51–52; EX1009 at ¶ 203, Fig. 14. In contrast, the map view gives a current picture of the environment. EX2001 at ¶ 53; EX1009 at ¶ 132, Fig. 8c. EX2001 ¶¶ 50–54; EX1009 at ¶¶ 132, 201–203; *see also* EX2001 at EX1009 at ¶¶ 100, 116, 130, 131, 132, 133, Figs. 8a–8d.

In each case, Childers teaches using raster-only image formats to facilitate the map and graph views, without regard for the occurrence of any particular event.<sup>11</sup> Dr. Polish admits Childers does not teach the use of device condition or identifier (i.e. a monitored event) in deciding what data to retrieve/transmit, who to send it to, or when to notify a user of certain information.<sup>12</sup> Moreover, for graphs, Childers discloses using raster-only images such as “a JPEG, GIF, or BMP file” or “comma delimited text” that stores data in the form of a dot-matrix structure.<sup>13</sup> Likewise, for maps, Childers discloses using raster-only images such as “GIF, BMP, JPEG, etc.”<sup>14</sup>

#### Childers Teaches Raster-Based Images For The Map View

[0133] The icons and object displayed on the map view may include both active network devices and passive devices. The ability to add and manipulate the passive devices along with the active network devices may allow the user to accurately represent the physical environment of his equipment rooms, for example. Other exemplary implementations may allow the end-user to import graphical images in a variety of formats (GIF, BMP, JPG, etc) to use as icons customized for their specific equipment (both active and passive).

#### Childers' Teaches Raster-Based Images For The Graph View

[0205] The graphs may be depicted based on a time range and a set of particular sensor readings. Allowing more than one appliance to be graphed at a time allows users to physically view the patterns of environmental changes as well as compare one area of a location against another. The graphs themselves may be organized by day, week, month, or for the entire time range provided. These graphs may then be saved as in a graphic format, such as, a JPEG, GIF, or BMP file, among others, for email and/or reports, or can be exported as comma-delimited text to another utility of the users choosing.

While Childers suggests that a background image in the map view could be “a graph, contour plot, and vector plot, among others,”<sup>15</sup> Childers never suggests this

<sup>11</sup> EX2001 at ¶¶ 52–55; EX1009 at ¶¶ 133, 203, 205.

<sup>12</sup> EX2001 at ¶ 57; EX1002 at ¶ 183.

<sup>13</sup> EX2001 at ¶ 52; EX1009 at ¶¶ 203, 205, Fig. 14.

<sup>14</sup> EX2001 at ¶ 54; EX1009 at ¶ 133.

<sup>15</sup> EX2001 at ¶ 55; EX1009 at ¶ 116.

as a reference to images that store vector drawing instructions, as opposed to the raster-only images referenced multiple times in the Childers' disclosure.<sup>16</sup>

### C. Callaghan (U.S. Patent Publication No. 2005/0108364)

Published on May 19, 2005, Callaghan's invention uses the "SVG plugin" and "scalable vector graphics (SVG) XML markup language files" to render (via basic ASCII drawing commands) "resolution independent" user interfaces for industrial device.<sup>17</sup> Callaghan's invention teaches away from using "resolution dependent" images like "GIF, JPG, TIF, BMP, etc." in user interfaces in favor of SVG XML markup language files that can be executed on the client-side to allow for rendering "resolution independent" graphics.<sup>18</sup>

#### Callaghan Teaches Away From "Resolution Dependent" Interfaces That Use Raster-Only Images Such As GIF, JPG, TIF, BMP

[0030] Conventionally, device-related graphics are provided via images (e.g., GIF, JPG, TIF, BMP, etc.) that are downloaded to a remote Web interface, which can consume bandwidth and memory and increase overhead. In addition, such downloaded images typically cannot be searched and are resolution dependent, wherein the viewable size defined and cannot be scaled according to a display window. In many instances, applications such as Java applets and/or applications are additionally or alternatively downloaded and executed to render graphics. Such applications can likewise consume bandwidth and memory and increase overhead. Moreover, such images and/or Web applications can require specialized software and/or hardware, rendering engines and/or peripheral utilities. Thus, the present invention provides a novel approach that can improve conventional techniques for displaying graphic representative of a device to a user employing a remote interface.

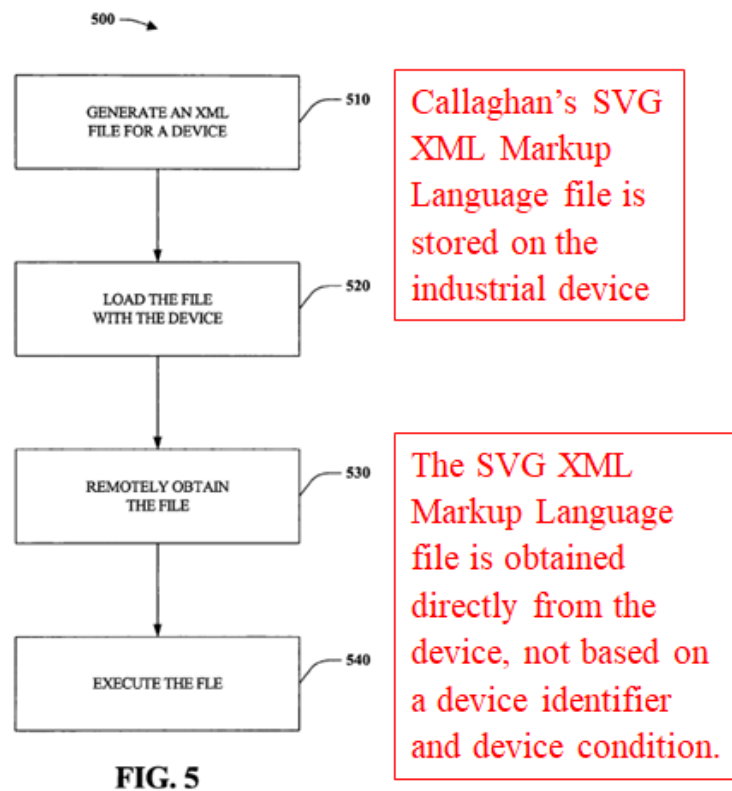
[0052] At reference numeral 510, an SVG XML file is generated for a device. As described supra, utilizing the XML markup language Scalable Vector Graphics (SVG) syntax provides for representing device graphics as well as text within a file that can be executed via ASCII drawing commands at a client machine. Thus, a remote user can retrieve a device's SVG file via a Web browser and render interactive graphics and/or text within the browser rather than download one or more graphics files (e.g., GIF, JPG, TIF, etc.) and/or executable applications such as Java applets and/or applications. Such graphics can be refreshed to provide the user with a representation that reflects the actual state of the physical entity graphically depicted. In addition, the rendered graphics can be searched and include links to other files. Moreover, the rendered graphics can be resolution independent, wherein a user and/or an automatic mechanism can scale the graphics within a viewing region. The foregoing provides for various benefits over conventional systems and techniques, as described in detail above.

<sup>16</sup> EX2001 at ¶¶ 55–56; EX1009 at ¶¶ 133, 205.

<sup>17</sup> EX1008 at ¶¶ 2, 9.

<sup>18</sup> EX2001 at ¶¶ 60–64; EX1008 at ¶¶ 7, 10, 30, 43.

Figure 5 (reproduced below) shows the operation of Callaghan's SVG file-based system involves loading an industrial device with an SVG file representing a face plate of the device, obtaining the SVG file from the device, and executing it.<sup>19</sup> Nothing in Callaghan suggests any step that depends on the occurrence of a monitored event (i.e. device identifier and device condition).<sup>20</sup>



<sup>19</sup> EX2001 at ¶ 62; EX1008 Fig. 5.

<sup>20</sup> EX2001 at ¶¶ 62–65; EX1008 at ¶¶ 7, 10.

#### **D. Baier (US Patent No. 8,191,005)**

Published on April 12, 2009, Baier teaches a system for visualizing an industrial environment in which resolution dependent “sparse images” are downloaded to a client device after being pixel-mapped to higher resolution images that are stored on a remote server; and then, when a user of the client device zooms in on or pans to a particular area of the sparse image, additional pixels are “streamed” from the high-resolution images stored on the server.<sup>21</sup> “[A]s a user zooms in on an area of an image that is pixel-mapped to a higher resolution version thereof, data corresponding to the area under focus is streamed to the display area coincident with respect pixels mapped thereto and resolution of the image area can be augmented, preserved, or enhanced.”<sup>22</sup> If the system infers that other data relating to the user’s role or intent is useful, that data may be presented simultaneously with the additional pixel data.<sup>23</sup>

Baier teaches implementing its user interface and resolution management system with a pixel-mapping solution and does not describe providing the user with images defined by vectors or based on any particular event (device identifier and condition) in the industrial environment.<sup>24</sup>

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<sup>21</sup> EX2001 at ¶¶ 66–67; EX1007 at 15:41–16:10; *see also* 15:42–18:30.

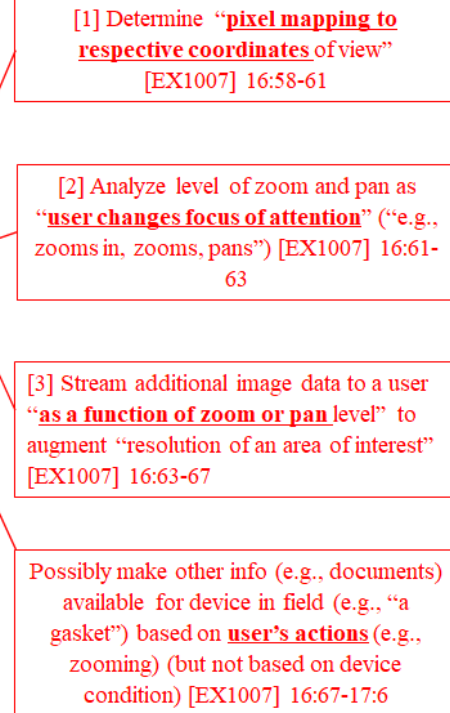
<sup>22</sup> EX1007 at 15:62–16:1.

<sup>23</sup> EX2001 at ¶¶ 68–70; EX1007 at 16:55–17:6.

<sup>24</sup> EX2001 at ¶¶ 71–72; EX1007 at 15:62–16:1, 16:55–65, 17:3–6, 17:11–17.

The basic operation of Baier’s resolution regulating system is described in columns 16-17 with reference to Figures 19-20.<sup>25</sup>

FIG. 19 is a flow diagram describing a high-level methodology in connection an embodiment. At 1902, determination or inference is made regarding reference of operator view of image data in an industrial automation environment. An initially viewed image is identified, coordinates with respect to level of zoom, area being viewed, pixel mapping to respective coordinates of view are determined. As a user changes focus of attention (e.g., zooms in, zooms, pans . . . ), level of zoom and pan are analyzed at 1904, and at 1906 data is streamed to the user as a function of zoom or pan level that enhancing a visualization experience. For example, additional image data can be streamed to augment, preserve, or increase resolution of an area of interest. Likewise, tertiary information can be made available (e.g., as a user zooms in on a gasket, documents related to the gasket or links to associated information can be made available). Thus, image data is not only pixel-mapped to corresponding image data bit it can also be contextually mapped to information or sources of information relevant to the image data.



In other words, Baier discloses a system around downloading resolution dependent images—that must store data for each pixel (i.e. to implement pixel mapping)—and managing when high-resolution data is sent based on the end user’s point of reference in the sparse image.<sup>26</sup> Baier emphasizes using this solution despite alleged “market forces” to the contrary.<sup>27</sup>

<sup>25</sup> EX2001 at ¶ 70; EX1007 at 16:55–17:21.

<sup>26</sup> EX2001 at ¶¶ 69-71; EX1007 at 15:53–16:10.

<sup>27</sup> EX2001 at ¶¶ 71-72; EX1007 at 15:53–16:10.

#### IV. CLAIM CONSTRUCTION

It is established that the Board applies the claim construction standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).<sup>28</sup> Under *Phillips*, claim terms are afforded “their ordinary and customary meaning.”<sup>29</sup> “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.”<sup>30</sup> Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy.<sup>31</sup>

Applied Capital assumes each term of the '082 patent claims is given its ordinary and customary meaning. Applied Capital also acknowledges the Markman Order from the prior litigation against ADT Corporation<sup>32</sup> and agrees with the construction determination by the Court therein.

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<sup>28</sup> See 37 C.F.R. § 42.100(b); see also Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 11, 2018) (applicable to *inter partes* reviews filed on or after November 13, 2018).

<sup>29</sup> See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005).

<sup>30</sup> *Id.* at 1313.

<sup>31</sup> See *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

<sup>32</sup> EX1006; EX2004.

## **V. MOTOROLA’S GROUNDS FOR REVIEW LACK MERIT.**

The Board should deny the Petition to institute review of the Challenged Claims because none of the four grounds raised in the Petition provide a basis for the Board to find that there is a reasonable likelihood of prevailing on any claim challenged in the Petition. Motorola raises nothing but hindsight arguments based on four references that, on their face, individually and collectively fail to disclose all elements of the claimed invention and, in fact, teach away from one another, such that no person of skill in the art would have been motivated to make the combinations Motorola proposes. Accordingly, all grounds to institute review should be denied.

### **A. [GROUND 1] Baier cannot anticipate claims 1–17.**

Under 35 U.S.C. § 102, a claim is anticipated only if “a single prior art reference disclose[s] each and every limitation of the claimed invention, either expressly or inherently.”<sup>33</sup> “Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention *arranged as in the claim*.”<sup>34</sup>

Claims 1 and 17 of the ’082 patent requires “retrieving,” “based on the device identifier and the device condition” of a monitored device, “images comprising all [of] the members selected from the group consisting of superimposed visual

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<sup>33</sup> *SRI Int’l, Inc. v. Cisco Sys., Inc.*, 930 F.3d 1295, 1306 (Fed. Cir. 2019).

<sup>34</sup> *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2008) (emphasis added); *SynQor, Inc. v. Artesyn Techs., Inc.*, 709 F.3d 1365, 1375 (Fed. Cir. 2013) (same).

indicators, hierarchically organized graphical images, and vector-based graphical images.” Claims 1 and 17 also require “dispatching” such images to a communication destination, using a communication method, after determining the destination and method “based on the device identifier and the device condition.” Because *Baier* does not disclose each such limitation, it cannot anticipate claims 1 and 17.

**1. Motorola concedes Baier does not anticipate claims 1 and 17.**

Motorola’s anticipation argument fails for the simple reason that Motorola concedes a POSITA would understand that Baier does not disclose retrieving and sending an SVG file based on an event (device condition and device identifier) occurring at a monitored premises but instead discloses “streaming additional pixel data to address the resolution problem” based on actions occurring at a user’s device (i.e. a user changing their level of zoom or pan in a sparse image).<sup>35</sup>

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<sup>35</sup> IPR2023-00418 Paper 1 at 40–41; IPR2023-00419 Paper 1 at 38–39; EX1002 at ¶ 142.

## Motorola's Petition at Page 41

photographs, and are thus well-suited for SVG files. *Id.* Moreover, although Baier describes using additional pixel data to address the resolution problem, it is not limited to only that solution. *Id.* Baier describes using “*substantially any type of application*” for displaying images to a user. Ex[1007], 5:57-66. An SVG file could have easily been used in Baier’s architecture. For example, Baier’s system could start with “[s]parse images,” as disclosed (Ex[1007], 15:58-59), but if reference component 1602 determines that a user should focus on a particular device because it has malfunctioned or entered a particular state, instead of determining additional pixels to stream to the user, the resolution component 1604 could identify an SVG file for the device. Ex[1008], [0029] (each device has an SVG file); Ex[1002], ¶146.

Motorola admits Baier discloses “using pixel data to address the resolution problem.”

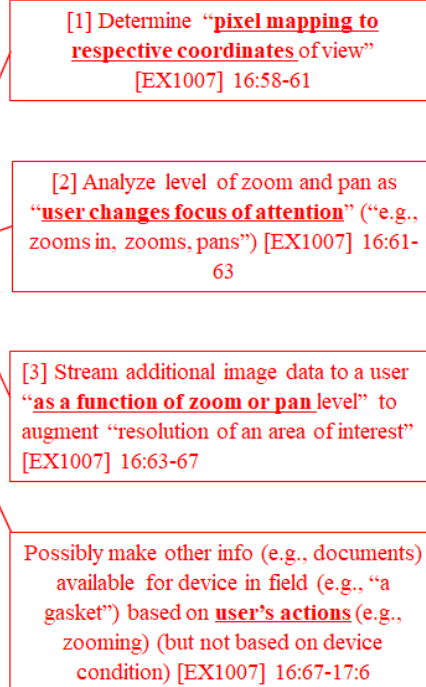
Motorola claims Baier “could have” used Callaghan’s SVG file “instead.”

As previously stated and confirmed by Applied Capital’s expert Dr. Zheng, Baier discloses a system that downloads resolution dependent images—that must store data for each pixel (i.e. to implement pixel mapping)—based on actions occurring at the user’s device (i.e. the user’s point of reference in the sparse image).<sup>36</sup> Baier makes this abundantly clear in describing the system in columns 16–17.<sup>37</sup>

<sup>36</sup> EX2001 at ¶¶ 69–71; EX1007 at 15:53–16:10.

<sup>37</sup> EX2001 at ¶ 70; EX1007 at 16:55–17:21.

FIG. 19 is a flow diagram describing a high-level methodology in connection an embodiment. At 1902, determination or inference is made regarding reference of operator view of image data in an industrial automation environment. An initially viewed image is identified, coordinates with respect to level of zoom, area being viewed, pixel mapping to respective coordinates of view are determined. As a user changes focus of attention (e.g., zooms in, zooms, pans . . . ), level of zoom and pan are analyzed at 1904, and at 1906 data is streamed to the user as a function of zoom or pan level that enhancing a visualization experience. For example, additional image data can be streamed to augment, preserve, or increase resolution of an area of interest. Likewise, tertiary information can be made available (e.g., as a user zooms in on a gasket, documents related to the gasket or links to associated information can be made available). Thus, image data is not only pixel-mapped to corresponding image data bit it can also be contextually mapped to information or sources of information relevant to the image data.



Given there is no real dispute about what Baier discloses, Motorola’s contention that Baier anticipates claims 1 and 17 is unserious and should be rejected.<sup>38</sup>

## 2. Baier does not anticipate dependent claims 2–16.

Claims 2–16 depend on claim 1. Because Baier does not disclose all the elements of claim 1, dependent claims 2–16 also do not disclose all the elements of

<sup>38</sup> The claim in paragraph 133 of Dr. Polish’s declaration that “Baier discloses ‘vector-based graphical images’” is misleading. The images Dr. Polish points to (EX1002 at ¶ 138) are still raster images. A person of skill in the art would understand this because Baier is still concerned here with pixel-mapping the detailed image to the sparse image. EX2001 at ¶¶ 71–72, 79; EX1007 at 17:22–40. The ability to display a second resolution dependent image (Fig. 22) based on a client-side user’s position or level of zoom in a first resolution dependent image (Fig. 21) does not somehow turn two resolution dependent images into images that contain vectors.

independent claim 1. Thus, for all the reasons set forth above, Motorola fails to show any reasonable likelihood that it will prevail on ground 1. Accordingly, the Petition to institute review on ground 1 should be denied.

**B. [GROUND2] Motorola’s single reference obviousness ground based on Baier should be rejected.**

Motorola’s single reference obviousness ground must be rejected as well, not only because Baier does not disclose or suggest each element of claims 1 and 17, but also because Baier actually teaches away from the claimed invention.

**1. Baier and the knowledge of a POSITA cannot render claims 1–17 obvious.**

As Motorola concedes,<sup>39</sup> Baier clearly teaches retrieving resolution dependent pixel data, based on actions taken by the user on the user’s device (i.e. the user’s decision to zoom or pan to a certain area of a pixel-mapped sparse image).<sup>40</sup> But this is the exact opposite of what claims 1 and 17 require—i.e., among other things,

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<sup>39</sup> IPR2023-00418 Paper 1 at 40-41; IPR2023-00419 Paper 1 at 38–39; EX1002 at ¶ 142.

<sup>40</sup> EX2001 at ¶¶ 72, 82 (explaining Baier’s resolution management system teaches streaming pixels—not vectors—from high resolution images stored on a remote server when a user clicks in a certain area of a sparse image); EX1007 at 15:42–18:30 (describing “Visualization System(s) and Method(s) for Preserving or Augmenting Resolution and Data Associated with Zooming or Panning in an Industrial Automation Environment”); EX2001 at ¶¶ 71–72, 82 (explaining Baier discloses determining the pixels that need to be sent to a client device based on the client device user’s level of zoom and point of reference in a sparse image, not based on any identifier or condition of a device in the industrial system); EX1007 at 30:40–54, 31:36–52; EX1002 at ¶ 121.

retrieving images, including resolution independent “vector-based graphical images,” “based on the device condition and device identifier” received from a remote alarm monitoring system.<sup>41</sup>

Given Baier teaches away from using the allegedly known concepts Motorola attempts to combine, it is nonsensical to claim that a person of skill would have been motivated to combine Baier with such knowledge to arrive at the '082 patent's claimed invention.<sup>42</sup> As Dr. Zheng explains, seeing a system designed in this way, a person of skill in the art would be discouraged from (1) retrieving vector-based images which do not store data for each pixel and do not contain the pixels needed to augment or increase resolution on the user's device; and (2) would be discouraged from retrieving such images based on a device identifier and device condition (representing an event in the field) received from a remote alarm monitoring system

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<sup>41</sup> EX2001 at ¶¶ 35-38; EX1001 at 19:6–25; EX1020 at 18:45–63.

<sup>42</sup> See *Adidas AG v. Nike, Inc.*, 963 F.3d 1355, 1358-9 (Fed. Cir. 2020) (substantial evidence supported PTAB's finding there was no motivation to combine the prior art because “combining Reed with Nishida would ‘require the alteration of the principles of operation of Reed or would render Reed inoperable for its intended purpose.’”); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1331-2 (Fed. Cir. 2019) (affirming PTAB ruling finding no motivation to combine where combining a second reference with a first would introduce too many disadvantages to prompt a POSITA to combine).

rather than the user's device.<sup>43</sup> Motorola's conclusory suggestions<sup>44</sup> that Baier "could have" used or done things that Baier neither discloses or suggests and in fact teaches away from doing, do not create an issue for the Board to resolve.<sup>45</sup>

As Baier does not disclose and, in fact, teaches away from retrieving images, including resolution independent vector-based graphical images, based on a device condition and device identifier corresponding to an event detected by a remote alarm monitoring system, Motorola's single reference obviousness combination fails to render claims 1 and 17 obvious. Further, because claims 2–16 ultimately depend from claim 1, Baier, in combination with a POSITA's knowledge, could not possibly render these claims obvious.

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<sup>43</sup> EX2001 at ¶¶ 83-84.

<sup>44</sup> Motorola contends that if Baier does not disclose the determining, retrieving, and dispatching steps "based on the device identifier and device condition," each of these limitations would have been obvious because one obvious way to implement Baier's communication, image retrieval, and display features would be to implement them based on the identity and condition of a device in the industrial environment. IPR2023-00418 Paper 1 at 25, 31, 34. But this is contradicted by the fact that Baier repeatedly teaches making decisions based on actions detected at a user's device, not actions detected in the industrial environment.

<sup>45</sup> See *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 851 F.3d 1270, 1273-75 (Fed. Cir. 2017) (holding that a prior art reference that does not contain all limitations of a challenged claim does not anticipate, and that missing limitations cannot be filled in "simply because a skilled artisan would immediately envision them.").

## 2. Obviousness based on Baier alone is implausible.

After wasting the Board's time with an admittedly unsupported anticipation ground, Motorola doubles down with the above-discussed single reference obviousness ground ***without any documentary support***. Numerous pre- and post- *KSR v. Teleflex*<sup>46</sup> decisions have rejected the notion that a single reference can make an invention obvious without a documentary basis.<sup>47</sup> Put simply, “common sense” cannot be used to achieve a claimed invention without a documentary basis in the record, lest a decision maker use impermissible hindsight reasoning. These holdings take inspiration from Supreme Court directives in *KSR v. Teleflex* to avoid

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<sup>46</sup> In *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), the Supreme Court reaffirmed the framework for determining obviousness as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Per the *KSR* Court, whether a claim is reasonably likely to be unpatentable as obvious under 35 U.S.C. § 103(a) depends on (1) the scope and content of the prior art, (2) the differences between the prior art and the claims at issue, (3) the level of ordinary skill in the pertinent art, and (4) objective evidence indicating obviousness or nonobviousness. *KSR*, 550 U.S. at 406

<sup>47</sup> See *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1366–67 (Fed. Cir. 2016); *K/S HIMPP v. Hear-Wear Techs., LLC*, 751 F.3d 1362, 1365–66 (Fed. Cir. 2014), cert. denied, 135 S. Ct. 1439 (2015); *In re Kotzab*, 217 F.3d 1365, 1371–72 (Fed. Cir. 2000) (reference teaching one sensor per valve did not render obvious claims for one sensor for multiple valves, despite “simplicity” of proposed modification extending a sensor to multiple valves); *In re Laskowsky*, 871 F.2d 115, 117 (Fed. Cir. 1989) (reciting and applying legal standard that, for obviousness over single reference, prior art must “suggest[] the desirability of the modification”).

hindsight.<sup>48</sup> They also distinguish decisions where all of the claim limitations existed in a proposed multi-reference combination.<sup>49</sup>

For example, in *K/S HIMPP v. Hear-Wear*, a requester in an *inter partes* reexamination challenged the decision of the Board holding a hearing aid patent nonobvious. The invention included modules joined by a connector.<sup>50</sup> The claims required the connector to contain a multi-pronged plug.<sup>51</sup> No documentary evidence existed in the record of multi-pronged plugs.<sup>52</sup> The Federal Circuit rejected the appellant's attempt to invoke undocumented "basic knowledge" or "common sense" to modify a single prior art reference and, thus, secured a reversal.<sup>53</sup> The Federal Circuit held that a decision maker may not hold a claimed invention obvious over a single prior art reference that fails to disclose a core structural claim limitation, unless contemporaneous documentary evidence suggested that a person of skill in the art would have modified the reference with the missing item.<sup>54</sup>

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<sup>48</sup> See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

<sup>49</sup> See, e.g., *Hear-Wear*, 751 F.3d at 1366.

<sup>50</sup> *Id.* at 1363.

<sup>51</sup> *Id.*

<sup>52</sup> *Id.* at 1365.

<sup>53</sup> *Id.* at 1366 ("[T]he Board cannot accept general conclusions about what is 'basic knowledge' or 'common sense' as a replacement for core factual findings in a determination of patentability.").

<sup>54</sup> *Id.*

*Hear-Wear* specifically discussed why the “flexible approach” to determining obviousness required by the Supreme Court’s *KSR* decision does not weaken the requirement of documentary evidence when dealing with a single-reference modification theory. “In contradistinction to *KSR*, this case involves the lack of evidence of a specific claim limitation, whereas *KSR* related to the combinability of references where the claim limitations were in evidence.”<sup>55</sup>

The same holds true here as explained above. Motorola impermissibly seeks to invalidate the ’082 patent by invoking basic knowledge, common sense, or well-known practices to supply a core structure claim limitation that is missing from the alleged prior art without documentary evidence or evidence of the desirability of the asserted modification. What’s more, Baier teaches away from such a limitation. For all the reasons set forth above, Motorola fails to show any reasonable likelihood that it will prevail on ground 2. Accordingly, the Petition to institute review on ground 2 should be denied.

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<sup>55</sup> *Id.*

**C. [GROUND 3] Baier and Callaghan cannot render claims 1–17 obvious.**

**1. Baier and Callaghan fail to disclose all elements of claims 1 and 17.**

Neither Motorola nor Dr. Polish claim that Callaghan discloses the limitations that Baier does not—i.e., the retrieving, determining, and dispatching limitations “based on the device identifier and device condition.” Indeed, Callaghan [EX1008] teaches creating a scalable vector graphics (SVG) XML markup language file representing a user interface for an industrial device, storing the SVG file on that device, sending the SVG file to a client that asks for it, and then executing the file on the client to provide “resolution independent” graphical user interface for the device.<sup>56</sup> But Callaghan does not disclose retrieving the SVG file “based on the device identifier **and device condition.**”<sup>57</sup> Nor does Callaghan disclose “dispatching” the SVG file to a communication destination using a communication method after “determining” the destination and method “based on the device identifier **and the device condition.**”<sup>58</sup>

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<sup>56</sup> EX2001 at ¶¶ 62-63, 80; EX1008 at Abstract, ¶¶ 9, 24, 29, 43.

<sup>57</sup> EX2001 at ¶¶ 62, 65; EX1008 at ¶ 10.

<sup>58</sup> *Id.*

Thus, the combination of Baier and Callaghan cannot render any of claims 1–16 obvious because, collectively, Baier and Callaghan fail to disclose all elements.<sup>59</sup>

**2. On their face, Baier and Callaghan teach away from the invention, each other, and any motivation to combine.**

Further, a POSITA would not have been motivated to combine Baier with Callaghan or any other teaching knowledge of using vector graphics to render graphical user interfaces. Baier’s resolution management system teaches streaming pixels—not vectors—from high resolution images stored on a remote server when a user clicks in a certain area of a sparse image.<sup>60</sup> Moreover, Baier discloses determining the pixels that need to be sent to a client device based on actions taken by the user of the client device (i.e., panning or adjusting level of zoom), not based on a device identifier and condition representing an event monitored in the industrial environment.<sup>61</sup>

Seeing Baier’s system, a person of skill in the art would be discouraged from (1) retrieving Callaghan’s SVG file, which does not store data for each pixel and does not contain the pixels needed to augment or increase resolution on the user

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<sup>59</sup> *Univ. of Strathclyde v. Clear-Vu Lighting LLC*, 17 F.4th 155, 160 (Fed. Cir. 2021) (holding that “an obviousness determination generally requires a finding that ‘all claimed limitations are disclosed in the prior art[.]’”) (citation omitted).

<sup>60</sup> EX2001 at ¶¶ 72, 82; EX1007 at 15:42–18:30 (describing “Visualization System(s) and Method(s) for Preserving or Augmenting Resolution and Data Associated with Zooming or Panning in an Industrial Automation Environment”).

<sup>61</sup> EX2001 at ¶¶ 71–72, 82; EX1007 at 30:40–54, 31:36–52; EX1002 at ¶ 121.

device; and (2) would be discouraged from retrieving such an SVG file based on a device identifier and device condition representing an event occurring on the premises.<sup>62</sup> Indeed, Callaghan does not disclose obtaining an SVG file based on monitored device’s activity or state, let alone obtaining an SVG file based on a device identifier and device condition received from “a remote alarm monitoring system.” To the contrary, Callaghan specifically teaches storing the SVG file on the field device itself and requesting the SVG file directly from that device.<sup>63</sup> Motorola’s conclusory assertions that Baier “could have” used or done things that Baier and Callaghan neither disclose nor suggest and, in fact, teach away from cannot create an issue for the Board to resolve.<sup>64</sup>

Further, as Dr. Zheng explains, any attempt to use Callaghan’s resolution independent SVG file in Baier’s resolution dependent user interface would require a fundamental redesign of Baier, and Baier’s core pixel-mapping features and components (e.g., resolution component 1604) would need to be modified or removed. Motivation to combine prior art cannot exist where, as here, the alleged

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<sup>62</sup> EX2001 at ¶¶ 83-84.

<sup>63</sup> EX2001 at ¶ 62; EX1008 at ¶ 7.

<sup>64</sup> *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd*, 851 F.3d 1270, 1273–7 (Fed. Cir. 2017) (holding that a prior art reference that does not contain all limitations of a challenged claim does not anticipate, and that missing limitations cannot be filled in “simply because a skilled artisan would immediately envision them.”).

combination would “require the alteration of the principles of operation” of one reference or would render that reference “inoperable for its intended purpose.”<sup>65</sup> Based on these reasons, the combination of Baier and Callaghan cannot render any of the ’082 patent claims obvious.

**D. [GROUND 4] Childers combined with Barker cannot render claims 1–17 obvious.**

Motorola’s purported combination of Childers and Barker fails because, collectively, Childers and Barker fail to disclose each element of claims 1 and 17. Further, there is no documentary basis for combining these references. Once again, Motorola is arguing “common sense” without evidentiary basis, which is improper.<sup>66</sup>

Critically, Motorola does not even allege that either Barker or Childers discloses retrieving images based on a device identifier and device condition, let alone images that comprise vector-based graphical images. Nor does Motorola allege that either reference discloses dispatching images using a communication method determined based on the device identifier and device condition. And while Childers states that a background image in the map view could depict a graph such

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<sup>65</sup> *Adidas*, 963 F.3d at 358–9 (affirming PTAB’s finding that there was no motivation to combine the prior art because “combining Reed with Nishida would ‘require the alteration of the principles of operation of Reed or would render Reed inoperable for its intended purpose’”).

<sup>66</sup> *See Arendi* 832 F.3d at 1366–67; *Hear-Wear Techs.*, 751 F.3d at 1365–66; *In re Kotzab*, 217 F.3d at 1371–72; *In re Laskowsky*, 217 F.3d at 1371–72.

a “vector plot” or “contour plot,”<sup>67</sup> Dr. Zheng explains<sup>68</sup> that a POSITA would not understand such graphs to be vector-based graphical images, which are images defined by vectors.<sup>69</sup> To be sure, Childers describes using only raster image formats like BMP and JPEG in its map view and graph views, and never describes image formats in which vectors define geometric shapes like lines and curves.<sup>70</sup>

Thus, Barker and Childers collectively fail to disclose (1) retrieving, **based on the device identifier and device condition**, “images comprising all [of] the members selected from the group consisting of superimposed visual indicators, hierarchically organized graphical images, and **vector-based graphical images**”; and (2) “dispatching” such images using a communication method determined **“based on the device identifier and the device condition.”**<sup>71</sup> Motorola’s emphasis on motivation to combine puts the cart before the horse because Barker and Childers,

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<sup>67</sup> EX2001 at ¶¶ 55, 93; EX1009 at ¶ 116.

<sup>68</sup> EX2001 at ¶¶ 92–97.

<sup>69</sup> As Dr. Zheng explains [EX2001 at ¶ 93], Dr. Polish’s claim [EX1002 at ¶ 214/215] “a vector plot refers to a representation of an image using vectors, such as vector graphics stored in various known file formats, including, for example, an SVG file” is false. As Dr. Polish well knows, a POSITA would understand the phrase “vector plot” as referring to a kind of graph (just like the phrase “contour plot”) and that the phrase says nothing about the data format of the image.

<sup>70</sup> EX2001 at ¶¶ 92–97; EX1009 at ¶¶ 133, 203, 205.

<sup>71</sup> EX2001 at ¶¶ 88–99.

collectively, do not disclose all elements of claims 1 and 17 and, thus, cannot render claim 1, its dependent claims, or claim 17 obvious.<sup>72</sup>

Moreover, nothing in the record supports the combination Motorola suggests. A generous reading of Barker discloses nothing more than a system that logs alarm events, initiates phone calls or audible alarms, and allows a user to access a table listing events over time in a tabular text-only format.<sup>73</sup> Barker’s prosecution history confirms what is clear from reading Barker—Barker is not interested in retrieving or dispatching images or using images to represent information in a premises.<sup>74</sup>

In contrast, a generous reading of Childers reveals only a system that provides an application for visualizing the current location, state, and configuration of a group of appliances in a network on a map.<sup>75</sup> Motorola concedes, however, that Childers does not suggest providing the application based on an event (i.e. device identifier and device condition) detected by Childers’ server.<sup>76</sup>

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<sup>72</sup> *Univ. of Strathclyde*, 17 F.4th at 160 (holding that “an obviousness determination generally requires a finding that ‘all claimed limitations are disclosed in the prior art[.]’”) (citation omitted).

<sup>73</sup> EX2001 at ¶¶ 46–48, 90; EX1010 at ¶¶ 54–55, 68–69, Figs. 9–10, Abstract.

<sup>74</sup> EX2001 at ¶ 47; EX1010; EX2009 at 19–20.

<sup>75</sup> EX2001 at ¶¶ 53–54, 99; EX2008 at ¶ 24, Fig. 8C.

<sup>76</sup> IPR2023-00418 Paper 1 at 54 (conceding “Childers, however, does not disclose details regarding how the central server processes the disclosed inputs to obtain the disclosed outputs.”).

Nothing in these references suggests a POSITA would be motivated to modify Barker's phone calls, audible alerts, and tabular event log with Childers' map view or modify Childers to make the map view dependent on Barker's event logging rules.<sup>77</sup> If a POSITA reading Barker and Childers would have been motivated to do anything, it would be to use Childers' graph view—which shows information over time but lacks superimposed icons and is not interactive—as an additional way to display events logged by Barker over time—i.e. the underlying device activity over time.<sup>78</sup> Indeed, only Childers' graph view describes showing event values over time, while the map view simply shows current information about a group of devices. Using Childers' map view would destroy Barker's purpose, utility, and preferred data presentation format and would be contrary to Barker's goal of simply monitoring underlying device activity over time.<sup>79</sup>

**E. All of Motorola's alleged grounds are improper.**

All the prior art assertions and combinations made by Motorola fall into categories the Federal Circuit has warned against. First, Motorola attempts to fill in missing limitations in its anticipatory references by what a POSITA “could have” done. But the Federal Circuit has explicitly rejected the notion that reference missing

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<sup>77</sup> EX2001 at ¶¶ 100–101.

<sup>78</sup> EX2001 at ¶ 101.

<sup>79</sup> EX2009 at 19–20.

a limitation can anticipate a claim based on what a POSITA would “envision.”<sup>80</sup> In *Nidec*, the Board found a claim anticipated based on a prior art reference that did not disclose a claim element on the grounds that a POSITA reading the reference would “at once envisage” the claimed arrangement.<sup>81</sup> The Federal Circuit held that this finding could not be based on substantial evidence because, plainly, the reference did not contain every claim limitation.<sup>82</sup> The Federal Circuit held that the Board is not permitted “to fill in missing limitations simply because a skilled artisan would immediately envision them.”<sup>83</sup>

And yet, that is exactly what Motorola is asking the Board to do. Motorola asks that the Board fill in the gaps in its grounds for invalidity where certain limitations simply are not there. Motorola admits that Baier comes up short on certain claim limitations, and yet still asserts Baier as an anticipatory reference on the basis of what Baier “could have” used.<sup>84</sup> Motorola takes massive leaps in, for example, explaining that retrieving enhanced information based on device identifier and condition “would have” been obvious to a POSITA reading references that make no gestures in that direction whatsoever. Motorola cannot simply wish limitations

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<sup>80</sup> *Nidec Motor Corp.*, 851 F.3d 1273–75.

<sup>81</sup> *Id.* at 1274.

<sup>82</sup> *Id.* at 1274–75.

<sup>83</sup> *Id.*

<sup>84</sup> IPR2023-00418 Paper 1 at 40–41; IPR2023-00419 Paper 1 at 38–39; EX1002 at ¶ 142.

into the prior art that are not there, nor is institution warranted based on references that, on their own or in combination, fail to disclose every limitation of the Challenged Claims.<sup>85</sup>

Likewise, in reaching its conclusions on obviousness, Motorola has engaged in yet another mode of reasoning forbidden by the Federal Circuit: impermissible hindsight. The Federal Circuit has made clear that “[e]ven under our ‘expansive and flexible’ obviousness analysis, we must guard against ‘hindsight bias’ and ‘ex post reasoning.’”<sup>86</sup> In *St. Jude*, the patent at issue involved using a balloon to prevent a plug from entering a damaged blood vessel while the vessel is being repaired.<sup>87</sup> One prior art reference disclosed stopping bleeding without a balloon, and another used a balloon to control bleeding from a gunshot wound.<sup>88</sup> The defendant argued that the combination of these two pieces of prior art rendered the patent-in-suit obvious.<sup>89</sup> The Federal Circuit held that these two references, when combined, would not teach every limitation of the patent-in-suit.<sup>90</sup> Nor would there be any motivation to

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<sup>85</sup> See *Galderma Labs., L.P. v. Teva Pharm. USA, Inc.*, 799 Fed. Appx. 838, 845 (Fed. Cir. 2020) (reiterating and applying the standard set in *Nidec*).

<sup>86</sup> *St. Jude Med., Inc. v. Access Closure, Inc.*, 729 F.3d 1369, 1381 (Fed. Cir. 2013).

<sup>87</sup> *Id.* at 1374.

<sup>88</sup> *Id.* at 1381.

<sup>89</sup> *Id.* at 1380.

<sup>90</sup> See *id.* at 1381.

combine the references, as they each taught complete but different solutions to the same problem in the art.<sup>91</sup>

“Obviousness ‘cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.’”<sup>92</sup> Motorola has attempted to use the ’082 and ’817 patents as guides on how they should combine various references in hindsight. And yet, Motorola’s combinations still come up short.

Motorola suggests that a POSITA would be motivated to combine Barker and Childers, even when Barker explicitly distinguishes itself from systems using images to represent data in an environment like Childers does.<sup>93</sup> Motorola assures the Board that a POSITA would combine Baier and Callaghan, even though Baier proposes a complete solution that would have to be substantially undone and reworked to incorporate Callaghan.<sup>94</sup> But even if a POSITA would make these combinations, they would still find themselves with something less than the claimed invention. For example, neither Baier nor Childers discloses dispatching any such set of images to a communication device, using a communication destination, based on the device

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<sup>91</sup> *See id.*

<sup>92</sup> *Cheese Sys., Inc. v. Tetra Pak Cheese & Powder Sys., Inc.*, 725 F.3d 1341, 1352 (Fed. Cir. 2013) (citing *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998)).

<sup>93</sup> EX2001 at ¶ 49; EX2009 at 19–20.

<sup>94</sup> EX2001 at ¶¶ 72, 82–85.

identifier and device condition.<sup>95</sup> Similarly, the combination of Baier and Childers would lack the retrieving, determining, and dispatching limitations core to the Challenged Claims.<sup>96</sup> In short, Motorola has arrived at its conclusions by looking backwards at what *it* would do *today*, not what a POSITA, reading the '082 and '817 patents at the time of their respective filings, would understand.<sup>97</sup>

## **VI. CONCLUSION**

As the saying goes, “If ifs and buts were candy and nuts, we’d all have a Merry Christmas.” Motorola cannot simply wish limitations into the prior art that are not there, nor is institution warranted based on references that, on their own and in combination, not only fail to disclose every limitation of the Challenged Claims but also teach away from the combinations Motorola alleges. The Board should exercise its discretion and deny Motorola’s Petition under § 314(a). Regardless, the Petition is not reasonably likely to prevail on any of the grounds asserted against the Challenged Claims. Accordingly, all grounds to institute review should be denied.

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<sup>95</sup> EX2001 at ¶¶ 47, 56, 88–99

<sup>96</sup> EX2001 at ¶¶ 80–81.

<sup>97</sup> *See* 35 U.S.C. § 103.

Date: May 10, 2023

Respectfully submitted,

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## **CERTIFICATE OF WORD COUNT**

Pursuant to 37 C.F.R. § 42.24, the undersigned certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE contains less than 14,000 words excluding the table of contents, table of authorities, certificate of service, certificate of word count, and appendix of exhibits. Patent Owner has relied on the word count feature of the word processing software used to create this paper in making this certification.

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