

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner

v.

PANTECH CORPORATION,
Patent Owner

Case IPR2023-01271
Patent No. 7,283,839

PATENT OWNER PRELIMINARY RESPONSE

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I. INTRODUCTION

Petitioner LG Electronics Inc. (“Petitioner”) filed a Petition for *Inter Partes* Review of claims 1 and 2 of U.S. Patent No. 7,283,839 (“the ‘839 Patent”) on August 11, 2023. The Petition should be denied for the following reasons.

First, the Petition fails to meet the particularity requirement of 35 U.S.C. § 312(a) and 37 C.F.R. §§ 42.6 (a)(3), 42.22(a)(2), and 42.104(b)(4)-(5) by providing only conclusory analysis and instead relying on the expert declaration to provide argument and analysis which are nowhere to be found in the Petition itself, by relying on prior art not identified in the grounds and not discussed in the Petition, by making excessive use of internal cross-references throughout the paper, by highlighting text and figures without explanation, and by combining arguments under 35 U.S.C. §§ 102 and 103 in a single ground.

Second, even if these deficiencies are overlooked, the Petition fails to show that it is more likely than not that claims 1 and 2 are unpatentable.

II. BACKGROUND

A. THE ‘839 PATENT

The ‘839 Patent, entitled “Wireless Communicating Terminal for Providing Integrated Messaging Service and Method Thereof,” generally relates to a wireless communication terminal and method for transmitting and receiving various kinds of messages by using an integrated messaging service program. ‘893 Patent at 1:8-15.

At the time of the '839 Patent (which claims priority to April 14, 2004), conventional messaging services provided different interfaces for text messages and multimedia messages. In some instances, a user would need to access separate applications for text and multimedia applications. Further, conventional wireless communication terminals managed incoming and outgoing messages using an in-box and an out-box, analogizing the messages to a traditional letter. This approach provided a late response in comparison to an Internet instant messenger. *See* EX1001 at 1:32-50.

The '839 Patent solved this problem by providing an integrated messaging service. In one example, the integrated messaging service receives message content and a menu selecting signal in the integrated user interface. The integrated user interface also displays the message content and description data. The wireless communication terminal determines the kind of message to be transmitted which is inputted into the integrated user interface, generates an outgoing message which includes identification data corresponding to the message kind, and transmits the outgoing message. The integrated user interface displays the outgoing message content and the description data. *See, e.g.,* EX1001 at 4:6-5:19, FIG. 2.

The wireless communication terminal also determines a message kind of a received message, divides the received message into message content and description data, and displays the message content and the description data in the integrated user interface. *See, e.g., id.* at 5:20-62, FIG. 3. By integrating the user

interface of text messages and multimedia messages, the technique provides a single application or service thereby increasing usability and simplicity for the user. *See id.* at 4:31-34. As an additional benefit, the integrated user interface increases speed by avoiding delays due to analogizing messages to letters. *See id.* at 4:41-46.

B. THE ART CITED AND RELIED ON BY PETITIONER¹

1. U.S. Pat. No. 8,020,105 (“Lemay”)
2. PCT Pub. No. WO 03/056789 (“Maguire”)
3. U.S. Pat. App. Pub. No. 2002/0152220 (“Kang”)
4. Network Working Group, Internet Engineering Task Force (IETF) Request for Comments (RFC): 2822, Internet Message Format (2001) (“RFC2822”)

III. THE LEVEL OF ORDINARY SKILL IN THE ART

For purposes of this Preliminary Response only, Patent Owner adopts the level of ordinary skill in the art from the Petition, which is that a person of ordinary skill in the art (“POSITA”) would have had a minimum of a bachelor’s degree in electrical or computer engineering or computer science, or a related field, along with at least two years of professional experience in messaging services for

¹ As explained *infra*, Petitioner also relies on multiple other references within the grounds which are not identified as part of the grounds themselves.

wireless communication terminals (or additional graduate education substituting for professional experience and/or significant experience in the field substituting for formal education). Pet. at 11. Patent Owner reserves the right to address the level of ordinary skill in the art if the Petition is granted.

IV. CLAIM CONSTRUCTION

Claims in a post-grant review are construed using the same claim construction standard as in a civil action. 37 C.F.R. § 42.100(b). Under this standard, claims terms are generally given their ordinary and customary meaning as understood by a person of ordinary skill in the art (“POSITA”) at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (en banc). The POSITA is deemed to read the claim term in the context of the entire patent, including the specification and prosecution history. *Id.* at 1313-1316.

Courts depart from the plain and ordinary meaning in only two instances: (1) when a patentee acts as its own lexicographer, and (2) when the patentee disavows the full scope of the claim term in the specification or during prosecution. *Hill-Rom Servs. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014).

Petitioner’s statement that all of the claim terms should be construed “according to their plain and ordinary meaning as would have been understood by a POSITA in view of the specification” (Petition at 11-12), without specifying what constitutes the plain an ordinary meaning of any term, is not helpful in

resolving the controversy at hand. Accordingly, Patent Owner reserves the right to present claim construction arguments if the Petition is granted.

V. ARGUMENT

The Board should exercise its discretion to deny the Petition because it fails to meet the particularity requirements of 35 U.S.C. § 312(a) as well as 37 C.F.R. §§ 42.6 (a)(3), 42.22(a)(2), and 42.104(b)(4)-(5). Even if such deficiencies are overlooked, the Board should deny the Petition because it fails to show that claims 1 and 2 are more likely than not unpatentable.

A. THE PETITION FAILS TO MEET THE PARTICULARITY REQUIREMENT OF 35 U.S.C. §312(a) AND 37 C.F.R. §§ 42.6(a)(3), 42.22(a)(2), AND 42.104(b)(4)-(5)

A petition for *inter partes* review (“IPR”) must identify “with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); *see also* 37 C.F.R. § 42.104(b)(4)-(5) (requiring that “the petition” identify “[h]ow the construed claim is unpatentable,” as well as “[t]he exhibit number of the supporting evidence relied upon to support the challenge and *the relevance of the evidence to the challenge raised*, including identifying specific portions of the evidence that support the challenge” (emphasis added)); *and* 37 C.F.R. § 42.22(a)(2) (requiring petitions in general to include “[a] full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence” (emphasis added)). Petitioner is required to set forth

its arguments and evidence in the Petition and may not incorporate by reference arguments contained in other documents. 37 C.F.R. § 42.6 (a)(3) (“Arguments must not be incorporated by reference from one document into another document.”).

Institution of an IPR remains discretionary even when a petitioner demonstrates a reasonable likelihood as to at least one claim. *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018) (“§ 314(a) invests the Director with discretion on the question *whether* to institute review”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“First of all, the PTO is permitted, but never compelled, to institute an IPR proceeding.”). “Because the Board’s practice, in light of *SAS*, is to institute on all grounds asserted in a petition, the Board may consider whether a lack of particularly as to one or more of the asserted grounds justifies denial of an entire petition.” *Adaptics Limited v. Perfect Co.*, IPR2018-01596, Paper 20, at 17 (P.T.A.B. Mar. 6, 2019) (informative).

Here, Petitioner provides conclusory analysis in its Petition and relies extensively on the Declaration of Vijay Madiseti (EX1003) (“Madiseti Declaration”) to provide argument and analysis which are nowhere to be found in the Petition itself. The Board should deny institution on that basis alone. *See, e.g., Cisco Systems, Inc. v. C-Cation Tech., LLC*, No. IPR2014-00454, Paper 12, at 10 (P.T.A.B. Aug. 29, 2014) (refusing to consider “arguments that are not made in the Petition, but are instead incorporated by reference to the cited paragraphs and

claim charts of . . . [the] Declaration” and refusing to institute because the anticipation grounds in the Petition failed to “include a detailed explanation of the significance of the quotations and citations from the applied references” and the obviousness grounds failed to “address meaningfully the scope and content of the prior art, and differences between the claimed subject matter and the prior art,” while also failing to “provide sufficient articulated reasoning with rational underpinning” explaining why the POSITA would modify the applied reference in the manner proposed); *Eiko Global, LLC v. Blackbird Tech. LLC*, No. IPR2017-00980, Paper 16 (P.T.A.B. Sept. 1, 2017). The Petition also fails to meet the particularity requirement because it (a) relies improperly on color coding of words in the Petition, instead of providing an explanation of the significance of the color coding or the words, (b) relies excessively on internal cross-references in the Petition, which in turn rely on the Madisetti Declaration for their argument, (c) improperly combines anticipation and obviousness arguments in a single ground, and (d) improperly relies on half a dozen additional references that are not particularly specified as a basis for any of the grounds.

1. Lack of Particularity in Ground 1

a) The Petition Improperly Relies on the Madisetti Declaration

The Petition improperly relies on the Madisetti Declaration to present its arguments. For example, Petitioner’s entire discussion of the scope and content of

the prior art is a single sentence in the Petition. Pet. at 12 (“This Petition is supported by Dr. Madisetti’s declaration, which describes the prior art’s scope and content at the time of the ’839 [sic].”). In support of this single sentence, the Petition then cites 31 paragraphs of the Madisetti Declaration which covers sixteen pages. *Id.* (citing Madisetti Declaration, ¶¶ 1-30, 65). Further, these paragraphs do not even support Petitioner’s claim as to what constitutes the prior art. Instead, they list the experience which Petitioner claims supports Dr. Madisetti’s qualifications as an expert and his understanding of patent law. As such, there is no way for Patent Owner to determine what Petitioner claims was present in the art at the time of the invention of the ’839 patent. Petitioner behaves no differently with respect to its analysis of the claim elements themselves. For example, for element 1(pre), Petitioner provides a single, conclusory sentence in the Petition itself. See Pet. at 12 (“The prior art discloses 1[pre] regardless of whether it is limiting. See § IX. Madisetti ¶ 52.”). Paragraph 52 of the Madisetti Declaration then cites non-specifically the entirety of Section IX of the Declaration – a full 222 pages. Similarly, in element 1(d), Petitioner relies on a series of non-specific citations to “description data,” “email,” and “instant messaging,” followed by a citation to over eight pages of arguments in the Madisetti Declaration which are

nowhere in the Petition itself. *See* Pet. at 27-28, Madisetti Declaration ¶ 85.²

Again, in element 1(e)(iv), Petitioner’s entire argument is a single sentence and picture, followed by non-specific reference to approximately 30 lines of Lemay and three paragraphs of the Madisetti Declaration. Pet. at 39 (“Lemay discloses transmitting the email and instant messaging replies to a messaging counterpart. Lemay 1:18-22, 1:63-2:3, 9:20-52, Madisetti ¶¶ 95-97.”). It is not until one references the cited paragraphs in the Madisetti Declaration itself, which cover two full pages, that specific references within the cited block quotes are provided to show where in Lemay Petitioner believes element 1(e)(iv) is shown. Element 1(e)(v) is similar: a series of pictures, citation to large blocks of text in Lemay, and citation to three paragraphs of the Madisetti Declaration covering seven full pages of analysis. *Compare* Pet. at 40-41 with Madisetti Declaration, ¶¶ 98-100. Finally, in element 1(e)(vi), the entirety of Petitioner’s argument is a single sentence –

² Petitioner argues in a footnote that, “[t]o the extent required, it would have been obvious for this description data to be included in messages.” Pet. at 27. But nowhere does the Petitioner even attempt to set forth *why* it would have been obvious to modify Lemay in the manner Petitioner claims, other than by reference to the same arguments which it claims show anticipation. As such, the Board should reject Petitioner’s attempt to argue in the alternative that Lemay renders the challenged claims obvious as well.

“Lemay also further discloses that “when an incoming message is received, it is examined (via the tagged identification) to determine whether the message is an email message or another message type – e.g., when configured to exchange only emails and instant messages, the tagged identification is used to determine if messages are email or instant messages.” – followed by citation to a total of 47 lines of the Alfke reference (on which Petitioner wrongly argues it can rely solely because it is allegedly incorporated by reference to Lemay (see below)), an additional three paragraphs covering three pages in the Madisetti Declaration, followed by reference to an additional 40 lines of Alfke with no explanation whatsoever. Pet. at 41-43.

In *Cisco Systems, Inc.*, No. IPR2014-00454, the Board denied institution based on Cisco doing exactly what Petitioner does here: provide conclusory analysis in its petition, while providing its actual arguments in an expert declaration that was not subject to the word count limits of 37 C.F.R. § 42.24(a)(1)(ii). The Board criticized Petitioner’s citations to large portions of an expert declaration, including lengthy claim charts, to support conclusory statements in the petition, and refused to consider arguments not made in the petition and only incorporated by reference. *Cisco*, Paper 12 at 7-10. It thereafter denied institution because the petition did not specify sufficiently where each element of the claims was disclosed in the cited prior art references. In denying institution, the Board commented:

One purpose of the prohibition against incorporation by reference is to eliminate abuses that arise against incorporation. In the petition before us, incorporation by reference of numerous arguments from [expert's] 250-page Declaration into the Petition serves to circumvent the page limits imposed on petitions for inter partes review, while imposing on our time by asking us to sift through over 250 pages of [expert's] Declaration. . . to locate the specific arguments corresponding to the numerous paragraphs cited to support Petitioner's assertions.

Id. at 10 (internal citations omitted). The *Cisco* decision is not an isolated one. In

Eiko Global, LLC v. Blackbird Tech. LLC, No. IPR2017-00980, Paper 16

(P.T.A.B. Sept. 1, 2017), “[t]he Petition’s substantive analysis as to how

[reference] allegedly disclose[d] the limitation amount[ed] to a single sentence . . .

with an unexplained citation to five distinct passages of [reference] and four

paragraphs of [expert's] declaration.” *Id.* at 22. The Board denied institution of the

pertinent ground due to this rule violation, stating:

This conclusory analysis, which does not identify which elements of [reference] allegedly correspond to the claim elements and parrots the claim language with a bare assertion that [reference] discloses the limitation, falls far below the particularity and specificity that our governing statute and rules require of arguments and evidence in a petition. The Petition also impermissibly incorporates by reference the more detailed analysis in [expert's] declaration. Arguments that are not presented and developed in the Petition, and instead are incorporated by reference to [expert's] declaration, are not entitled to consideration.

Id. at 22-23 (citations omitted). Similarly, in *Intervet Inc. v. Boehringer Ingelheim*

Vetmedica Inc., No. IPR2018-01788, Paper 9 (P.T.A.B. Apr. 16, 2019), the Board

denied institution based on the Petitioner’s massive use of incorporation by reference, stating, “[i]ncorporation by reference amounts to a self-help increase in the length of the brief and is a pointless imposition on the court’s time. A brief must make all the arguments accessible to the judges, rather than ask them to play archeologist with the record.” *Id.* at 8 (internal citations, quotation marks, and alternations omitted).

As explained above, the Petition itself does not identify “where each element of the claim is found in the prior art,” nor does it identify “the relevance of the evidence,” which is a required component of each ground of the petition. 37 C.F.R. § 42.104(b)(4)-(5). “The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.” 37 C.F.R. § 42.104(b)(5). By including conclusory summaries of its grounds in the Petition and extensively incorporating by reference material contained within the Madisetti Declaration, Petitioner violates these rules, warranting denial of institution. In fact, the situation in LGE’s petition is even more egregious than the one which triggered denial of institution in *Cisco*. The Petition incorporates by reference large swaths of the Madisetti Declaration and its attached appendices, which amount to 299 pages of additional material. “Incorporation by reference serves to circumvent the [word limits] imposed on petitions for *inter partes* review, while also obscuring the arguments and evidence by requiring the Patent Owner and the Board to sift

through the declaration to locate specific, relevant arguments.” *Hopkins Mfg. Corp. v. Cequent Performance Prods.*, Case IPR2015-00616, Paper 9, at 44-45 (P.T.A.B. Aug. 17, 2015). Arguments that are not presented in the Petition but instead incorporated by reference to the Madisetti Declaration, are not entitled to consideration, and as shown above, without the Madisetti Declaration, the Petition fails to identify “with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3).

b) The Petition Substitutes Color Coding of References for Particularity of Argument

In addition to Petitioner’s excessive reliance on the Madisetti Declaration, the Petition is riddled with unexplained color coding of both terms of the challenged claims and figures and multiple terms in the alleged prior art. For example, in one portion of the Petition, Petitioner states in its discussion of the ’839 patent that, “The controller also displays the message, including description data of the message such as data ‘identifying transmitted/received message[s]’,” with the terms “controller,” “message” and “description data” shaded in red, light blue and pink, respectively. Pet. at 8. But in the very next paragraph, Petitioner uses the same light blue color to shade the term “message content.” It is unclear whether the Petitioner is arguing that the terms “message” and “message content” should be construed identically (in which case it has not identified these terms for

construction anywhere in the Petition) or for some other, unknown reason.

Similarly, when discussing the Lemay reference, Petitioner states "...Lemay displays both the message contents, alongside the 'date and time' and 'the name of the user from which the record originated' that identifies whether messages were sent or received," with the term "message contents" in light blue and the terms "date and time" and "the name of the user from which the record originated" in light pink. Pet. at 15-16. Similar highlighting is used elsewhere in the Petition for other terms, see Pet. at 49 ("information describing that message"), 50 ("data about the message"), 67 ("additional information about the message"), as well as for even more terms in sections of the Madisetti Declaration, see ¶ 69 ("the subject of the corresponding record" and "name of the person who sent each message").

Petitioner's highlighting of multiple terms and phrases within its discussion of the same references make it impossible for Patent Owner to determine which, of the multiple terms highlighted, Petitioner asserts constitute the "description data" in the challenged claims for each of the claim elements. Petitioner certainly does not explain that, or indeed what its color coding is supposed to represent, in the Petition. Similarly, Petitioner highlights in the same color the terms "transceiver," "network interface," and "wireless network." See Pet. at 7, 13, 21. Nowhere, even in the Madisetti Declaration, is it explained why a "network interface" in Lemay and a "wireless network" in Alfke both constitute the "transceiver" in the '839

patent.³ Petitioner simply puts the terms in the same color and hopes that they will be perceived as such. But doing so does not meet Petitioner's burden of identifying with particularity the evidence that supports its ground.

c) The Petition Is Riddled With Excessive Cross-Citations

As with Petitioner's extensive and improper reliance on the Madisetti Declaration for arguments that should be in its Petition, Petitioner also relies on an incomprehensible web of internal cross-references (which as explained *supra*, further rely on the Madisetti Declaration to make its arguments). For example, in element 1(e)(i), Petitioner references the analyses of four different elements, [1.pre], [1.b], [1.c] and [1.d]. Each of these elements in turn, reference each of the previous analyses. See Pet. at 22 (referencing element [1.pre] as support for element [1.b]), 25 (referencing elements [1.pre] and [1.b] as support for element [1.c]), 27 (referencing elements [1.pre], [1.b] and [1.c] as support for element [1.d]), In essence, Petitioner relies on the entirety of its previous analysis, with the exception of section 1(a), as its proposed support for Lemay anticipating element 1(e)(i). Such blanket citations of both the Petition itself fail to "identify [] specific

³ It should be noted that, to the extent Petitioner is arguing the two both constitute a "transceiver," this undercuts Petitioner's argument that the entirety of Alfke is incorporated by reference in Lemay.

portions of the evidence that support the challenge,” and have led to denial of institution. For example, in *Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00449, Paper 10 (July 15, 2015), *reh’g denied*, Paper 13 (Dec. 21, 2015), the Board found Apple’s Petition “riddled with vague, nested citations to broad sections of [prior art], the Dr. Sherman declaration, other exhibits and other sections of the Petition....” *Id.* at 6. The Board went on to note:

In a representative example, the Petition features one page of analysis addressing how the Hypothetical ABYSS-Denning System allegedly would meet the limitation of independent claim 1...This analysis directly cites: (1) four other sections (§§ III.D.4, IV.D.1.-2., IV.E.2) or approximately ten pages, of the Petition; (2) thirty-four paragraphs...or approximately ten pages of the Dr. Sherman Declaration; (3) three full pages of ABYSS, and (4) two full pages of Denning.

Id. at 7. The Board further noted that a half-page of Apple’s analysis cited to six other pages of the Petition, nine pages of the expert declaration supporting the Petition, and nine of the thirteen pages of a prior art reference, and that “[o]ur counts do not include the extensive further internal citations and cross-references in the cited section of the Petition and Dr. Sherman Declaration.” *Id.* at 7-8. As a result, the Board denied institution for failure to comply with 35 U.S.C. § 312(a) and 37 C.F.R. § 42.104(b)(4)-(5), finding the “incomprehensible web of internal cross-references to the Petition and [] Declaration” left the Board “to play archaeologist with the record.” *Id.* at 11 (citing *Cisco*). Again, the *Apple* decision is not an isolated one. In *Juniper Networks Inc. v. Core Optical Techs. LLC*,

IPR2020-01664, Paper 9, at 23 (Apr. 16, 2021), the Board denied institution, noting that for two of the challenged claims “the cross-referencing to multiple sections that lack specificity and particularity further obscures whatever proposed combination petitioner relies on.” And in *Lenovo (United States), Inc. v. Litl LLC*, IPR2021-00681, Paper 8, at 13 (Sept. 3, 2021), the Board denied institution, noting that both the petition and the supporting expert declaration made extensive use of internal cross-references, as well as references to each other, which “contribute[d] to the deficiency of the Petition.” As with *Apple*, *Juniper Networks* and *Lenovo*, the cross-references in the Petition to large portions of the Madisetti Declaration and previous portions of the Petition itself, which then reference still further portions of the Petition and Declaration, require the Board “to play archaeologist with the record,” and warrant denial of institution.

Finally, Petitioner is required to adhere to a strict 14,000-word limit in the Petition. 37 C.F.R. § 42.24(a)(1)(ii). Indeed, the Board “decline[s] to consider information presented in a supporting declaration, but not discussed in a petition because, among other reasons, doing so would encourage the use of declarations to circumvent the page limits that apply to petitions.” *Conopco, Inc. v. Procter & Gamble Co.*, No. IPR2013-00510, Paper 9, at 8 (P.T.A.B. Feb. 12, 2014).

Petitioner certifies that the Petition contains 13,989 words —eleven words shy of the maximum allowed word count. Pet. at 95. But as explained *supra*, Petitioner relies on the 299-page Madisetti Declaration to circumvent these limits. As with

its improper incorporation by reference and cross-referencing, Petitioner's violation of the word count limit warrants denial of institution, because without the analysis in the Madisetti Declaration, the petition utterly fails to demonstrate "how the construed claim is unpatentable." 37 C.F.R. § 42.104(b)(4); *Conopco*, No. IPR2013-00510, Paper 9, at 8–9.

d) The Petition Improperly Combines Obviousness and Anticipation Arguments Into a Single Ground

Ground 1 of the Petition asserts that Lemay either anticipates the challenged claims under 35 U.S.C. § 102 or renders the challenged claims obvious under 35 U.S.C. § 103. However, statutes promulgating the content of grounds in an IPR clearly state that the ground shall either be an anticipation **or** obviousness ground, but never both. 37 C.F.R. § 42.104(b)(2) (a petition shall include "[t]he specific statutory grounds under 35 U.S.C. §§ 102 or 103 on which the challenge to the claim is based. . ."). Petitioner's improper attempt to combine two grounds of invalidity into a single ground directly contradicts 37 C.F.R. § 42.104(b)(2). See *CallCopy, Inc. v. Verint Ams., Inc.*, IPR2013-00492, Paper 14, at 7-8 (P.T.A.B. February 5, 2014) (denying institution and noting that where Petitioner combined multiple grounds into a single ground for invalidity, the PTAB was "unwilling to engage in supposition of how to effect such analysis for the individual grounds as a substitute for Petitioner's analysis.").

In addition, element 1(d) of claim 1 of the ‘839 Petitioner also argues that to the extent Lemay does not anticipate the challenged claims, Lemay in combination with Alfke renders the challenged claims obvious. *See* Pet. 5 at fn.2 (“to the extent PO disputes whether Alfke is part of Lemay’s disclosure, Petitioner alternatively contends for each ground based on Lemay that it would have been obvious to modify Lemay with Alfke’s teachings in light of the incorporation.”). But nowhere except in this single sentence does Petitioner assert that the combination of Lemay with Alfke is a ground in the petition. Whether a patent claim is allegedly anticipated under Section 102 is an entirely different analysis from whether that claim is obvious under Section 103. Petitioner's attempt to combine these into a single ground, perhaps to circumvent the type-volume limitations of 37 C.F.R. § 42.24, should render this Ground fatally deficient. Further, the only support for the argument combining Alfke and Lemay in the Petition is a citation to paragraph 57 of the Madisetti Declaration, which is similarly conclusory. (“Alfke is incorporated by reference by Lemay, and is part of the Lemay disclosure. Lemay, 11:33-41.”). For these reasons, the Board should reject this attempt to introduce an additional stealth ground into the Petition. *In re Magnum Oil Tools Int’l Ltd.*, 829 F.3d 1367, 1381 (Fed. Cir. 2016).

e) The Petition Improperly Relies on References That Are Not Specified as a Basis For Ground 1

The Petition also improperly relies on half a dozen additional references that are not particularly specified as a basis for Ground 1. For example, with respect to element 1(c), Petitioner relies on a cursory statement about four additional references – Varanda, Engstrom, Nielsen, and Kimmunen – followed by a full page of discussion of those references in the Madisetti Declaration. *Cf.* Pet. at 25 fn.7 (“Indeed mobile devices using keypads are well-known”) with Madisetti Declaration ¶ 81. For element 1(d), Petitioner relies in addition to the four references above, on two additional references, RFC2779 and RFC2882, two 3GPP technical specifications, a document allegedly describing a wireless application protocol, RFC1889, and a paragraph in the Madisetti Declaration for its argument that “[t]o the extent required, it would have been obvious for the description data to be included in messages.” *Id.* at 28 fn.8. But the only reference discussed in the Petition itself is RFC2779. It is not until one examines the paragraph of the Madisetti Declaration, which contains a page and a half of argument, that any analysis of the reference is provided. And again for elements 1(e)(vii)-(viii), Petitioner relies on Varanda, Engstrom, and yet another reference, Klassen, plus a nearly page long argument in the Madisetti Declaration, for its position that “[t]o the extent identification data within the description data must be displayed, it also would have been obvious to display data identifying the message type when the

table of contents contains, e.g., both “email messages” and “instant messaging sections,” in order to accurately inform the user of each message’s type.” Pet. at 44 fn. 9. The Petition does not specify that these references are part of Ground 1, and there is no analysis of any of these references in the Petition itself.

2. Lack of Particularity in Ground 2

As with Ground 1, *supra*, Petitioner relies excessively on the Madisetti Declaration and internal cross-references to provide critical elements of its obviousness analysis in Ground 2, rather than providing those elements in the Petition itself. For example, for element 1(e)(iv) of Ground 2, Petitioner’s analysis comprises a single sentence (“Maguire discloses ‘transmitting’ ‘outgoing messages’”), a citation to three paragraphs of Maguire with no further explanation, a citation to four pages of analysis in the Madisetti Declaration, followed by additional citations to Maguire, again with no explanation. Pet. at 84. All told, the Petition cites 9 of the 43 paragraphs of Maguire ([0002] - [0004], [0013], [0018], [0021], [0025] - [0027], with only [0018] receiving even a cursory analysis. *Id.* Similarly, for element 1(e)(v), Petitioner cross-references six separate sections of its earlier obviousness analysis, plus an additional page and a half of the Madisetti Declaration. Pet. at 84-85. For element 1(e)(vi), Petitioner provides a cursory single sentence: “As discussed for [1.e.iii], Maguire further discloses determining the ‘event type’ corresponding to message kind of a received message using header data.” Pet. at 85. It then cites to three paragraphs of the Madisetti Declaration

which cover over five pages, which further cites Fig. 4 and paragraphs [0004], [0030] and [0035] with no analysis whatsoever. Pet. at 85-86. For element 1(e)(viii), Petitioner’s analysis is less than half a page, instead cross-referencing eight sections of previous analysis in the Petition, a figure, five paragraphs and two claims of Maguire with no explanation, and three paragraphs of the Madisetti Declaration, which themselves internally cross-reference over 35 pages of analysis. Madisetti Declaration, ¶¶ 180-182 (*citing* analysis of elements “[1.pre], [1.b]-[1.d], [1.e(iii)]-[1.e(v), 1.e(viii)] above”).⁴ Pet. at 88. And element 1(e)(ix) references *the entirety of Petitioner’s previous analysis*. Pet. at 89 (“See [1.pre] -[1.e(vii)]”). As with Ground 1, Petitioner’s use of extensive cross-referencing and use of the Madisetti Declaration to provide its claimed arguments, instead of placing those arguments in the petition itself, causes the Petition to fail to “state its relevance or to identify specific portions of the evidence that support the challenge.” 37 C.F.R. § 42.104(b)(5); *see also Cisco Systems, Inc. v. C-Cation Tech., LLC*, No. IPR2014-00454, Paper 12, at 10; *Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00449, Paper 10, at 11; *Hopkins Mfg. Corp. v. Cequent Performance Prods.*, Case IPR2015-00616, Paper 9, at 44-45.

3. Lack of Particularity in Grounds 3 & 4

⁴ While Petitioner claims that its analysis of element 1(e)(vii) is also “in view of Kang,” Kang is referenced nowhere in its analysis of this element.

Grounds 3 and 4 suffer from the same procedural defects of incorporation by reference of the Madisetti Declaration, and extensive internal cross-referencing, already discussed with respect to Grounds 1 and 2 above. For example, Petitioner states that “[t]o the extent PO argues further disclosure is required of the “description data” recited in [1.d], [1.e(v)], [1.e(vii)], [1.e(viii)], and [2] included in transmitted messages, RFC2822 discloses including message description data (e.g., addresses in header fields and data and time information) as part of the transmitted messages.” Pet. at 92. In support of this statement, it non-specifically cites five pages of RFC2822, and a paragraph of the Madisetti Declaration which further cites the majority of the 95-page argument constituting Ground 1, large portions of the separate 95-page argument constituting Ground 2, and the same non-specific five pages of RFC2822. *Id.* (citing Madisetti Declaration, ¶ 191) (further citing Sections IX.A.2 [1.d], [1.e(v)], [1.e(vii)], [1.e(viii)], [2], Section IX.B.4 [1.d], [1.e(v)], [1.e(vii)], [1.e(viii)], [2], and RFC2822, 14-16, 20-22, 41). In Petitioner’s argument that a POSITA would have been motivated to modify Lemay or Maguire with Kang, it cites, without any detail, 40 lines of Lemay, a paragraph of Maguire, four pages of RFC2822, and two paragraphs totaling a page and a half of the Madisetti Declaration (which themselves internally reference Section IX.A.1, large portions of Section IX.A.2. and Section IX.B.3.). And in its argument that a POSITA would have had a reasonable expectation of success when combining Lemay or Maguire with RFC2822 is a single sentence, “A POSITA

would have had a reasonable expectation of success in modifying Lemay or Maguire's teachings to make use of description data included in email messages, as disclosed by RFC2822 because proposed internet standard protocols were well-known in the art and developed for interoperability with a variety of communication devices." This is followed by a reference to a page and a half long paragraph in the Madisetti Declaration and non-specific citation to six additional references. Pet. at 93 (*citing* Madisetti Declaration, ¶ 195, Exhs. 1019-1022 and 1025-1026). And upon examination of the referenced paragraph in the Madisetti Declaration, RFC2779, a reference not relied upon for any obviousness ground, and which is mentioned nowhere in this portion of the petition, is suddenly referenced as support for Petitioner's argument. Madisetti Declaration, ¶ 195. Thus, Grounds 3 and 4 should be denied for failure to meet the particularity requirement as well.

B. PETITIONER HAS FAILED TO SATISFY ITS BURDEN UNDER 35 U.S.C. § 314(a)

The petitioner in an IPR bears the burden of proving that it is more likely than not that at least one challenged claim is unpatentable. 35 U.S.C. § 314(a). Petitioner has failed to meet this burden. Specifically, Petitioner has failed to show that it is more likely than not that the prior art, alone or in combination, discloses the claimed invention.

1. The Petition Fails to Show That Lemay Anticipates or Renders Obvious Claims 1 and 2

Ground 1 of the Petition alleges that claims 1 and 2 are anticipated and/or rendered obvious by Lemay (EX1005).

To establish anticipation under 35 U.S.C. § 102, a petitioner must identify each and every element in a claim, arranged as recited in the claim, in a single prior art reference. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (“To anticipate a claim, a single prior art reference must expressly or inherently disclose each claim limitation. . . . But disclosure of each element is not quite enough—this court has long held that anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim”).

Even if Petitioner’s improper incorporation by reference of the Madisetti Declaration and its extensive internal and external cross-referencing is ignored, it has still failed to demonstrate that Lemay contains each and every element of the challenged claims. Again, in order to show anticipation, the Petitioner must demonstrate that all elements of the claim are contained within the four corners of the alleged anticipatory reference. *Net MoneyIN*, 545 F.3d at 1371. For element 1(e)(vi) of claim 1, Petitioner does **not** rely on Lemay, the alleged anticipatory reference. Instead, it relies on Alfke, a different reference, which Petitioner alleges is incorporated by reference into Lemay. Pet. at 42-43. However, in order for

material not within the four corners of a patent to be incorporated by reference, “the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various documents.” *Adv. Display Sys. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000) (citing *In re Seversky*, 474 F.2d 671, 674 (C.C.P.A. 1973)). That is exactly what the Lemay reference does not do with respect to Alfke. While Petitioner alleges that Lemay says Alfke concerns the processing of electronic messages with the embodiments of Lemay, nowhere in the Lemay reference does it say where in Alfke that is taught, or how that processing takes place. Instead, Lemay simply incorporates Alfke wholesale. Lemay, 11:33-41. These are the exact circumstances in which incorporation by reference has been found ineffective for purposes of anticipation. *Fresenius Kabi USA, LLC v. Fera Pharms., LLC*, 2016 U.S. Dist. LEXIS 128162 at *12 (D.N.J. Sept. 20, 2016) (“The specification’s general citation to the Remington textbook as a whole is not a license to extract passages from that work in derogation of the clear language in the specification and claims”); *Round Rock Res. LLC v. SanDisk Corp.*, 81 F. Supp. 3d 339, 352-53 (D. Del. 2015); *Days Corp. v. Lippert Components, Inc.*, 558 F.Supp.3d 682, 687 (N.D. Ind. 2001).

For elements 1(c), 1(d), and 1(e)(vii)-(viii), Petitioner’s failure to show that Lemay anticipates the challenged claims is even clearer. For element 1(c), Petitioner relies on a cursory statement about four additional references – Varanda,

Engstrom, Nielsen, and Kimmunen – followed by a full page of discussion of those references in the Madisetti Declaration. *Cf.* Pet. at 25 fn.7 (“Indeed mobile devices using keypads are well-known”) with Madisetti Declaration, ¶ 81. For element 1(d), Petitioner relies in addition to the four references above, on two additional references, RFC 2779 and RFC 2882, two 3GPP technical specifications, a document allegedly describing a wireless application protocol, RFC1889, and a paragraph in the Madisetti Declaration for its argument that “[t]o the extent required, it would have been obvious for the description data to be included in messages.” *Id.* at 28 fn.8. But the only reference discussed in the Petition itself is RFC2779. It is not until one examines the paragraph of the Madisetti Declaration, which contains a page and a half of argument, that any analysis of the reference is provided. And again for elements 1(e)(vii)-(viii), Petitioner relies on Varanda, Engstrom, and yet another reference, Klassen, plus a nearly page long argument in the Madisetti Declaration, for its position that “[t]o the extent identification data within the description data must be displayed, it also would have been obvious to display data identifying the message type when the table of contents contains, e.g., both “email messages” and “instant messaging sections,” in order to accurately inform the user of each message’s type.” Pet. at 44 fn. 9. Nowhere in Lemay are Vanda, Engstrom, Nielsen, Kimmunen, RFC2779, RFC2822 or Klassen even mentioned, and there is no analysis of any of these references in the Petition itself. By relying on these references for portions of its argument, Petitioner demonstrates

through its own statements that Lemay does not anticipate claim 1 of the ‘839 patent. *See Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1334-35 (Fed. Cir. 2002) (rejecting contention that “a prior art reference may anticipate if a skilled artisan could take the reference’s teachings in combination with his own knowledge of the particular art and be in possession of the invention”). And because Petitioner has failed to meet its burden with respect to claim 1, it cannot do so with respect to claim 2 either. *Impact Selector Int’l, LLC v. Petromac IP Ltd.*, IPR2019-01660, Paper 12, at 19-21 (P.T.A.B. Apr. 2, 2020); *RCA Corp. v. Applied Digital Data Sys.*, 730 F.2d 1440, 1446 (Fed. Cir. 1984).

Petitioner's obviousness argument based on Lemay is also deficient. Under *Graham v. John Deere*, 383 U.S. 1 (1966), in order to determine whether an invention is obvious in light of the prior art, the following factors must be considered: 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 art; and 4) any secondary considerations of non-obviousness. An obviousness determination cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Magnum Oil*, 829 F.3d at 1380; *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR Co. v. Teleflex*, 550 U.S. 398, 418 (2006).

Nowhere in the Petition does Petitioner even cite *Graham*, let alone attempt to undertake the required four-part analysis. And again and again, Petitioner relies on conclusory statements to try and meet its burden. As discussed above, the entire discussion of the scope and content of the prior art in the Petition is a single conclusory sentence, which through incorporation by reference encompasses 222 pages of the Madisetti Declaration. Pet. at 12 (*citing* Madisetti Declaration, ¶¶ 1-30, 65) (*further citing* Madisetti Declaration § IX.). But nowhere within the Petition itself does Petitioner explain the scope and content of the art.

Additionally, nowhere in the Petition is there any discussion of the differences between Lemay and the challenged claims, the second *Graham* factor. Statements in the Petition such as “[t]his not only renders obvious, but affirmatively discloses . . .,” Pet. at 25, and “[t]o the extent required, it would have been obvious for this description data to be included in messages,” Pet. at 27, are not sufficient. *See, e.g., Adaptics Limited*, IPR2018-01596, Paper 20 at 19-20 (statement “*If* Bendel and Sartorius are not anticipatory, [then] the challenged claims are obvious” insufficient to specify what Petitioner regards as the difference(s) between Bendel or Sartorius and the challenged claims); *Apple, Inc. v. SmartFlash LLC*, CBM2015-0029, Paper 11, at 16-18 (P.T.A.B. May 28, 2015) (denying institution of obviousness ground based on failure to explain adequately any differences between the asserted prior art and the claimed invention); *Cisco*, IPR2014-00454, Paper 12, at 10; *Liberty Mut. Ins. Co. v. Progressive Casualty Ins.*

Co., Case CBM2012-00003, Paper 7, at 3 (P.T.A.B. Oct. 25, 2012) ("A petitioner who does not state the differences between a challenged claim and the prior art, and relies instead on the Patent Owner and the Board to determine those differences . . . risks having the corresponding ground of obviousness not included for trial for failing to adequately state a claim for relief.").

Finally, nowhere does the Petitioner even attempt to set forth *why* it would have been obvious to modify Lemay in the manner Petitioner claims, other than by reference to the same arguments which it claims show anticipation. *Cisco*, IPR2014-00454, Paper 12, at 14-15 ("the remaining grounds also do not provide sufficient articulated reasoning with rational underpinning explaining why one with ordinary skill in the art would modify the teachings of the applied references to arrive at the claimed invention. . . . Therefore, on the record before us, the information presented in the Petition does not demonstrate a reasonable likelihood that Petitioner would prevail . . .").

For at least the above reasons, Petitioner has failed to meet its burden with respect to Ground 1.

2. The Petition Fails to Show Maguire in View of Kang Renders Claims 1 and 2 Obvious

Ground 2 of the Petition alleges that claims 1 and 2 are obvious over Maguire (EX1007) in view of Kang (EX1008).

As noted above, in order to determine whether an invention is obvious in light of the prior art, the four *Graham* factors must be addressed: 1) the scope and content of the prior art; 2) the differences between the prior art and the claims at issue; 3) level of ordinary skill in the art; and 4) any secondary considerations of non-obviousness. *Graham v. John Deere*, 383 U.S. 1 (1966). Nowhere in the Petition does Petitioner even cite *Graham*, let alone attempt to undertake the required four-part analysis. Furthermore, as noted above, an obviousness determination cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Magnum Oil*, 829 F.3d at 1380; *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR Co. v. Teleflex*, 550 U.S. 398, 418 (2006). However, as with Ground 1, Petitioner impermissibly relies on conclusory statements to try and meet its burden in Ground 2.

First, as discussed above, the entire discussion of the scope and content of the prior art in the Petition is a single sentence, which through incorporation by reference encompasses 222 pages of the Madisetti Declaration. Pet. at 12 (*citing* Madisetti Declaration, ¶¶ 1-30, 65) (*further citing* Madisetti Declaration § IX.). But nowhere within the Petition itself does Petitioner explain the scope and content of the art. Similarly, Petitioner’s argument that Kang and Maguire are “analogous art” is based on a single, conclusory sentence. Pet. at 52 (“Maguire and Kang are analogous prior art in the ’839’s field – messaging services for wireless

communication terminals – and are reasonably pertinent to the problems purportedly addressed by the '839 – e.g., the need for ‘various messaging services’ to send messages.”) This is followed by references to three paragraphs of Maguire, two paragraphs of Kang, and two paragraphs of the Madisetti Declaration. *Id.* And again, the Petition states in a conclusory fashion, “A POSITA would have had a reasonable expectation of success in modifying Maguire with Kang’s teachings because of the well-understood nature of these teachings.” Pet. at 54. This is followed by a citation to four separate references, none of which are Kang, and a reference to paragraph [0028] of Maguire. But paragraph [0028] only states:

Implementations of graphical interfaces on liquid crystal displays will be well understood by those skilled in the art of mobile device design. It is fully contemplated that though mobile device 112 has been described herein as having display 120, that display 120 can be replaced with other user interfaces. Examples of such user interfaces include audio interface and dynamic Braille pads for use by individuals with visual impairments.

Nowhere does Maguire suggest the use of a module “that accepts input for and determines different outgoing message types, presenting such messages with associated description data on a display and similarly processing received messages.” Pet. at 53. Faced with a similar situation in *Cisco*, the Board found that Cisco had failed to meet its burden of showing that the challenged claim was likely to be invalid for obviousness and denied institution. *Cisco*, Paper 12, at 13-

15. Finally, nowhere in the Petition is there any discussion of the differences between Maguire or Kang and the challenged claims, the second *Graham* factor.

Similarly, Petitioner's argument in Grounds 3-4 that RFC2822 is analogous art to Lemay, Maguire and Kang is a single sentence without support, except in reference to a single paragraph of the Madisetti Declaration. But as with its anticipation argument in Ground 1, rather than setting forth its argument in the petition, Petitioner instead puts its arguments in the Madisetti Declaration. For example, Dr. Madisetti states that Maguire "provides a unified view of communications events including sent and received SMS messages, email correspondences, and wireless application protocol sessions," and that Kang "provides a method of displaying several types of messages all together through a single window and of enabling a user to write and transmit a message with no consideration of message type." Madisetti Declaration, ¶ 123 (internal quotations deleted). But this argument is nowhere in the Petition itself. And for Grounds 3-4, the Madisetti Declaration effectively makes no argument at all. Madisetti Declaration, ¶ 193. Such "conclusory statements" are insufficient to meet Petitioner's burden. *In re Magnum Oil Tools Int'l Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

For at least the above reasons, Petitioner has failed to meet its burden with respect to Ground 2.

3. The Petition Fails to Show Lemay in View of RFC2822 Renders Claims 1 and 2 Obvious

Ground 3 of the Petition alleges that claims 1 and 2 are obvious over Lemay (EX1005) in view of RFC2822 (EX1009).

Patent Owner submits that the Petition fails to show that claims 1 and 2 are obvious over Lemay and RFC2822, because RFC2822 does not remedy the deficiencies of Lemay discussed above. Petitioner admits that Lemay “leave[s] it to a POSITA how to derive such information [i.e., description data],” and cites to RFC2822 solely for providing “additional details disclosing that such information is part of the transmitted message.” Pet. at 92. Such details have no bearing on the deficiencies noted above.

The Petition also fails to adequately address the *Graham* factors for Ground 3, just as it failed to do for Grounds 1 and 2. Petitioner’s entire argument that there would have been a reasonable expectation of success in modifying Lemay with RFC2822 is a single sentence: “A POSITA would have had a reasonable expectation of success in modifying Lemay or Maguire’s teachings to make use of description data included in email messages, as disclosed by RFC2822 because proposed internet standard protocols were well-known in the art and developed for interoperability with a variety of communication devices.” Pet. at 93. This is followed by a string of cites to portions of six pieces of prior art, as well as a page and a half long paragraph in the Madisetti Declaration which contains a description

of specific portions of the references at issue, along with his opinions as to why these portions would have caused one of ordinary skill in the art to reasonably expect success when modifying Lemay with RFC2822. But this analysis is nowhere in the Petition itself and is therefore entitled to no weight. *Eiko Global*, No. IPR2017-00980, Paper 16, at 23. And again, there is no discussion in the Petition of the second *Graham* factor, the difference between Lemay, RFC2822 and the challenged claims. Without such an analysis, Petitioner has failed to make out a case of obviousness. *Apple, Inc. v. SmartFlash LLC*, CBM2015-0029, Paper 11 at 16-18 (P.T.A.B. May 28, 2015) (denying institution of obviousness ground based on failure to explain adequately any differences between the asserted prior art and the claimed invention); *Liberty Mutual*, Case CBM2012-00003, Paper 7 at 3 (“A petitioner who does not state the differences between a challenged claim and the prior art, and relies instead on the Patent Owner and the Board to determine those differences . . . risks having the corresponding ground of obviousness not included for trial for failing to adequately state a claim for relief.”).

For at least the above reasons, Petitioner has failed to meet its burden with respect to Ground 3.

4. The Petition Fails to Show Maguire in View of Kang and RFC2822 Renders Claims 1 and 2 Obvious

Ground 4 of the Petition alleges that claims 1 and 2 are obvious over Maguire (EX1007) in view of Kang (EX1008) and RFC2822 (EX1009).

Patent Owner submits that the Petition fails to show that claims 1 and 2 are obvious over Maguire in view of Kang and RFC2822, because RFC2822 does not remedy the deficiencies of Maguire and Kang discussed above. Petitioner admits that Maguire and Kang “leave it to a POSITA how to derive such information [i.e., description data],” and cites to RFC2822 solely for providing “additional details disclosing that such information is part of the transmitted message.” Pet. at 92. Again, such details have no bearing on the deficiencies noted above.

The Petition also fails to adequately address the *Graham* factors for Ground 4, just as it failed to do for Grounds 1, 2 and 3. Petitioner’s entire argument that there would have been a reasonable expectation of success in modifying Maguire with RFC2822 is a single sentence: “A POSITA would have had a reasonable expectation of success in modifying Lemay or Maguire’s teachings to make use of description data included in email messages, as disclosed by RFC2822 because proposed internet standard protocols were well-known in the art and developed for interoperability with a variety of communication devices.” Pet. at 93. This is followed by a string of cites to portions of six pieces of prior art, as well as a page and a half long paragraph in the Madisetti Declaration which contains a description of specific portions of the references at issue, along with his opinions as to why these portions would have caused one of ordinary skill in the art to reasonably expect success when modifying Maguire with RFC2822. But this analysis is nowhere in the Petition itself and is therefore entitled to no weight. *Eiko Global*,

No. IPR2017-00980, Paper 16, at 23. And just as with Grounds 1, 2 and 3, there is no discussion of the differences between Maguire, Kang, RFC2822 and the challenged claims. Such a failure warrants denial of institution. *Apple, Inc. v. SmartFlash LLC*, CBM2015-0029, Paper 11, at 16-18; *Liberty Mutual*, Case CBM2012-00003, Paper 7, at 3.

For at least the above reasons, Petitioner has failed to meet its burden with respect to Ground 4.

VI. CONCLUSION

Pursuant to 35 U.S.C. § 314, Patent Owner respectfully requests that the Board refuse to institute *inter partes* review for the reasons stated herein.

Dated: December 12, 2023

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(b) and (d), the undersigned hereby certifies that this Patent Owner Preliminary Response complies with the type-volume limitation of 37 C.F.R. § 42.24(b)(1) because, exclusive of the exempted portions, it contains 8,898 words as counted by the word-processing system used to prepare the paper.

Dated: December 12, 2023

/Jason M. Shapiro/

Jason M. Shapiro

Reg. No. 35,354

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was served electronically via electronic mail on December 12, 2023 on the following counsel of record for Petitioners:

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