

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'S RESPONSE

TABLE OF CONTENTS

I. INTRODUCTION	1
II. BACKGROUND	1
A. THE '839 ATENT	1
B. OVERVIEW OF THE CITED ART	5
III. THE LEVEL OF ORDINARY SKILL IN THE ART	12
IV. CLAIM CONSTRUCTION	13
A. "integrated user interface" and "IUI"	14
B. "determining a message kind of the message to be transmitted which is inputted in the IUI"	21
C. "transmitting the outgoing message"	29
V. ARGUMENT	30
A. PETITIONER HAS FAILED TO SATISFY ITS BURDEN UNDER 35 U.S.C. § 314(a)	30
1. Ground 1: Anticipation of Claims 1 and 2 by Lemay (Alone or in Combination With Alfke)	31
2. Ground 2 - Maguire in View of Kang Does Not Render Claims 1 and 2 Obvious	61
3. Lemay (Alone or in Combination with Alfke) in View of RFC2822 Does Not Render Claims 1 and 2 Obvious	80
4. Maguire in View of Kang and RFC2822 Does Not Render Claims 1 and 2 Obvious	81
VI. CONCLUSION	83

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Forest Laboratories, LLC v. Sigmapharm Laboratories, LLC</i> , 918 F.3d 928 (Fed. Cir. 2019).....	15, 22, 29
<i>Hill-Rom Servs. v. Stryker Corp.</i> , 755 F.3d 1367 (Fed. Cir. 2014).....	13
<i>Honeywell Int'l, Inc. v. ITT Indus., Inc.</i> , 452 F.3d 1312 (Fed. Cir. 2006).....	15, 17, 22, 29
<i>Luminara Worldwide, LLC v. Liown Elecs. Co.</i> , 814 F.3d 1343 (Fed. Cir. 2016).....	17
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005).....	13
<i>Poly-America, L.P. v. API Industries, Inc.</i> , 839 F.3d 1131 (Fed. Cir. 2016).....	15, 16, 22, 29
<i>Sony Corp. v. Iancu</i> , 924 F.3d 1235 (Fed. Cir. 2019).....	15, 22, 29
<i>Techtronic Industries Co. Ltd. v. Int'l Trade Comm'n</i> , 944 F.3d 901 (Fed. Cir. 2019).....	15, 22, 29
<i>Verizon Servs. Corp. v. Vonage Holdings Corp.</i> , 503 F.3d 1295 (Fed. Cir. 2007).....	15, 22, 29
Statutes	
35 U.S.C. § 316	30, 83
Regulations	
37 C.F.R. § 42.100.....	13

LIST OF EXHIBITS

Exhibit	Description
2001	Declaration of Dr. Edwin A. Hernandez
2002	Deposition Transcript of Dr. Vijay Madiseti dated May 21, 2024
2003	RFC 2821: Simple Mail Transfer Protocol
2004	ETSI ES 202 314-4 V1.1.1 (2004-05): Fixed Network Multimedia Messaging Service (F-MMS); Part 4: PSTN/ISDN; Multimedia Message Communication Between A Fixed Network Multimedia Messaging Terminal Equipment and A Multimedia Messaging Service Centre
2005	Open Media Alliance, OMA-MMS-CTR-v1_2-20030916-C, "Multimedia Messaging Service Client Transactions," Version 1.2, Candidate Version 16-Sept-2003
2006	AOL Instant Messenger TMobile Sidekick Chat dated January 18, 2004, available at http://web.archive.org/web/20040118024122/http://mymobile.aol.com:80/portal/aolmobilesvc/frame_pda.html
2007	AOL Instant Messenger TMobile Sidekick Chat dated January 18, 2004, available at http://web.archive.org/web/20040118024122/http://mymobile.aol.com:80/portal/aolmobilesvc/frame_pda.html

I. INTRODUCTION

The present proceeding was instituted without any claim terms being explicitly construed. Institution Decision (Paper 8), 8-9. When properly construed, however, it is abundantly clear that claims 1 and 2 (“the challenged claims”) of U.S. Patent 7,283,839 (‘the ‘839 patent’) are patentable over the cited art because none of the cited art (alone or in the combinations proposed by Petitioner) discloses a wireless communication terminal that (a) provides an “instant messenger-like interface” for text messages and multimedia messages, (b) determines a message kind of an outgoing message to be transmitted that is inputted in the interface, much less based on whether or not a multimedia file is included in the message, and (c) transmits the outgoing message without changing a transmission protocol or a network.

As such, the Board should find Petitioner has not shown by a preponderance of evidence claims 1 and 2 of the ‘839 patent are unpatentable.

II. BACKGROUND

A. THE ‘839 ATENT

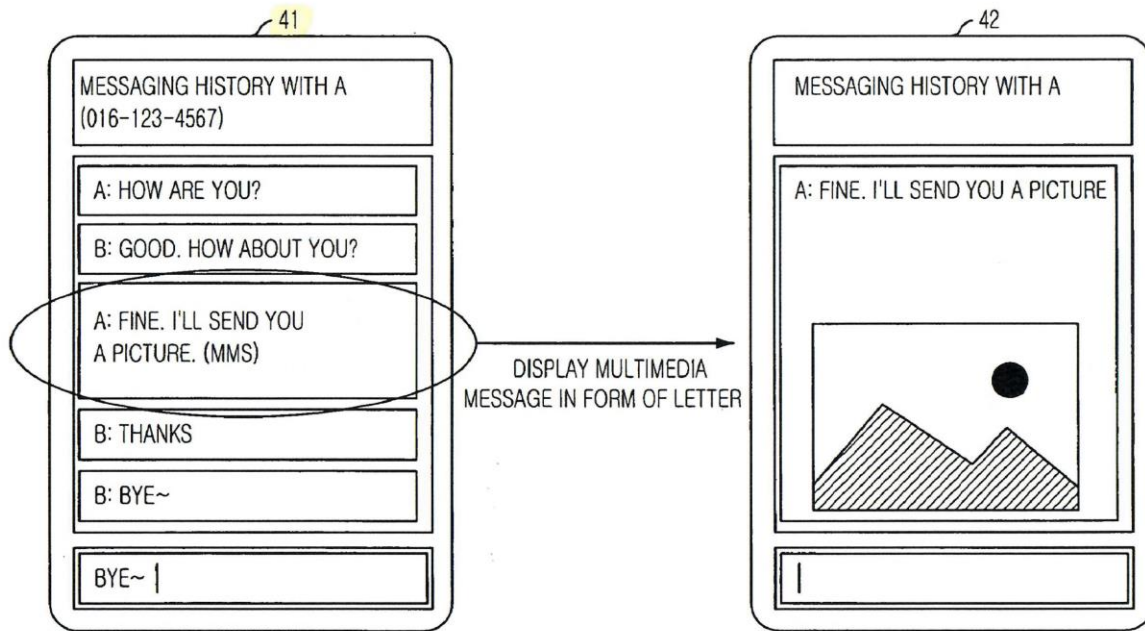
The ‘839 Patent, entitled “Wireless Communicating Terminal for Providing Integrated Messaging Service and Method Thereof,” relates to a wireless communication terminal for transmitting and receiving text messages and multimedia messages in an integrated user interface. EX1001, 1:8-15, 55-62.

At the time of the '839 Patent (which claims priority to April 14, 2004), text messages were transmitted/received using a communication protocol called short message service ("SMS") and multimedia messages were transmitted/received using a communication protocol called multimedia messaging service ("MMS"). Text messages sent over SMS included description data and message content in the form of text that were sent directly to the intended recipient, whereas multimedia messages sent over MMS included a multimedia file that was stored temporarily by an MMS server while an automated push notification was sent to the intended recipient (e.g., via SMS) to cause the recipient to retrieve the multimedia file from its storage location. Because of these differences, conventional messaging services provided different interfaces for text messages and multimedia messages. *Id.* at 1:32-38. 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. *Id.* at 1:45-48. This approach provided a late response in comparison to an Internet messenger. *Id.* at 1:48-50.

The '839 Patent solved this problem by providing a wireless communication terminal with an integrated messaging service program that, when operated, provides a single, unitary instant messenger-like user interface for text messages and multimedia messages. *Id.* at 1:55-2:40, 7:41-46. By integrating the user interface of text messages and multimedia messages into a single, unitary instant

messenger-like user interface, e.g., as shown at 41 in FIG. 4B (reproduced below), the '839 Patent provides a single application or service thereby increasing usability and simplicity for the user. *See id.* at 1:32-44. As an additional benefit, the integrated user interface (“IUI”) increases speed by avoiding delays due to analogizing messages to letters using a separate inbox and outbox. *Id.* at 1:45-50.

FIG. 4B



In one example, the wireless communication terminal receives message content of an outgoing message that was inputted by a user B in the input field of the integrated user interface. *Id.* at 2:20-29, 4:6-7. The wireless communication terminal determines the kind of message to be transmitted based on whether or not

the message content inputted by the user B included a multimedia file. *Id.* at 4:14-20. In the case of a multimedia message, the wireless communication device generates an outgoing message which comprises (a) identification data corresponding to the message kind, and (b) message content made up of an informing message and a multimedia file. *Id.* at 4:64-5:9. In the case of a text message, the wireless communication device generates an outgoing message which comprises (i) identification data corresponding to the message kind, and (ii) message content in the form of text only. *Id.* at 4:26-36. The wireless communication device transmits the outgoing message to a user A using the communication protocol corresponding to the message kind (e.g., SMS in the case of a text message, or MMS in the case of a multimedia message), and displays the transmitted message in the integrated user interface with other messages to/from user A in transmitted/received order. *Id.* at 4:31-36, 5:16-19, 6:22-37, FIGS. 2 and 4B. In the case of both text messages and multimedia messages, the message content is displayed along with the description data. *Id.* at 4:43-46, 5:16-19, FIG. 4B.

The wireless communication terminal also determines a message kind of a received message from another wireless communication terminal, divides the message into message content and description data, and displays the message content and the description data of the received message in the integrated user

interface with other messages to/from the other user in transmitted/received order.

Id. at 1:63-2:40, 5:20-62, FIG. 3.

B. OVERVIEW OF THE CITED ART

1. U.S. Pat. No. 8,020,105 (“Lemay”) (EX1005)

Lemay describes “a unified user interface for instant messaging and email.” EX1005, 1:49-50. The user interface lists messaging records in a table of contents (TOC) pane (*see, e.g.*, FIG. 2A at 202). *See, e.g.*, EX1005, 5:29-30. Instant messaging content and email content are displayed in separate panes (*see, e.g.*, FIG. 2C at 220 and 222) or in separate windows (*see, e.g.*, FIG. 2D at 235 and 216). *See, e.g.*, EX1005, 6:65–7:9, 7:53-56. An input field at the bottom of the instant messaging pane (*see, e.g.*, FIG. 2B at 218) or the bottom of the instant messaging window (*see, e.g.*, FIG. 2D) allows a user to initiate an instant messaging session. *See, e.g.*, EX1005, 6:2-5, 30-34, 43-45; 10:16-41. The input field appears if a user associated with a selected messaging record in the TOC becomes available for instant messaging. *See, e.g.*, EX1005, 6:2-5, 6:30-34, 10:16-41; EX2001, ¶¶ 51-52.

2. U.S. Pat. No. 7,765,263 (“Alfke”) (EX1006)

Alfke relates to a method and apparatus for processing electronic messages. EX1006, Abstract. An email client determines whether to send an email as an email or an alternative kind of message based on whether an alternative message

delivery mechanism is available, and if so repackages the email message in a format compatible with the alternative delivery system. EX1006, 5:50-6:4, 6:17-36, 7:24-38, 7:49-63, 8:6-34, 11:29-58, 13:25-40, 16:1-23; EX2001, ¶ 53.

3. PCT Pub. No. WO 03/056789 (“Maguire”) (EX1007)

Maguire discloses “[a] method for viewing communication events on a mobile device that includes a user interface, a communications event handler, and a communications event database.” EX1007, Abstract. The mobile device may also include a transceiver, a processor, and a display. EX1007, [0025]. The transceiver is used to both transmit and receive communications events. EX1007, [0026]. The processor 122 interacts with the display 120 “upon receipt of a communications event and querying [the communications event] database” and “uses display 120 to provide interface 124.” *Id.* The interface 124 is shown in FIG. 5 of Maguire (reproduced below):

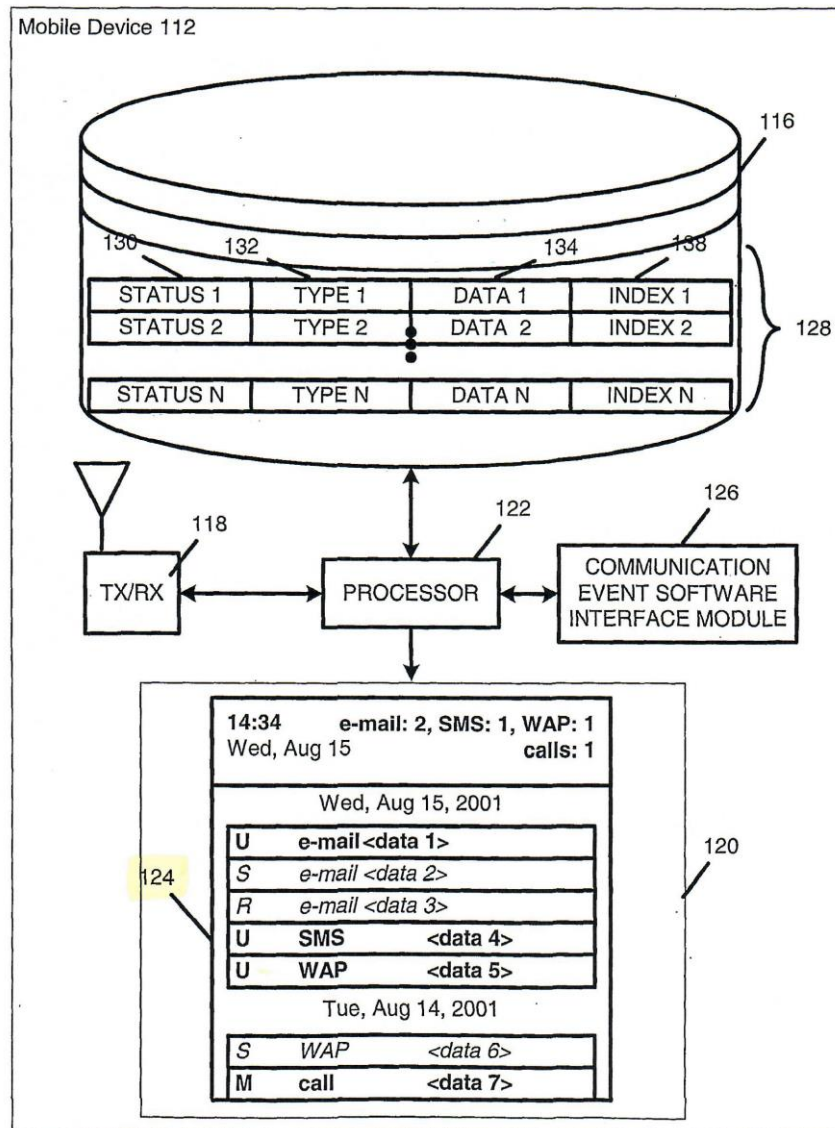


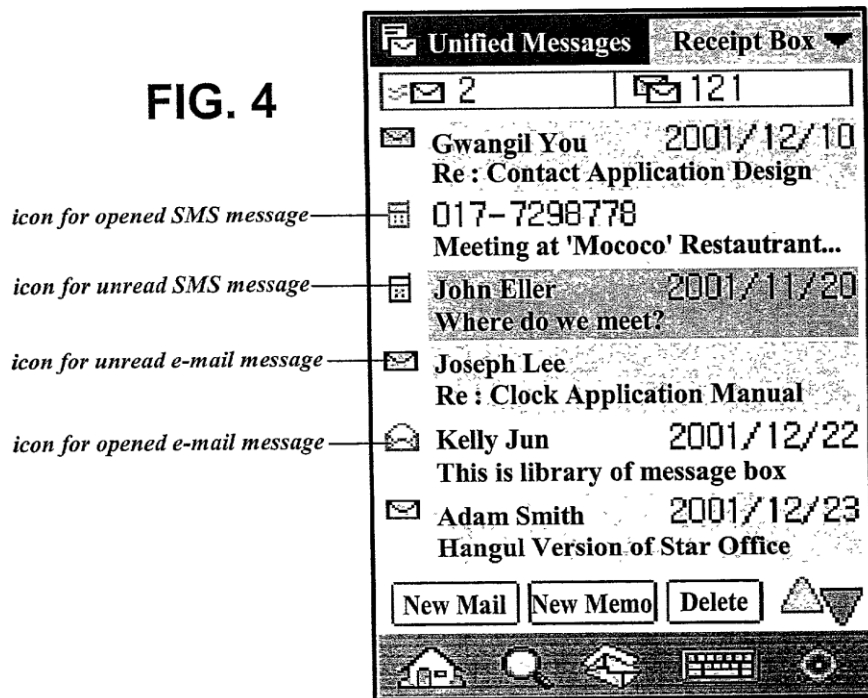
Figure 5

“Interface 124 illustrates a date and time, as well as the number of e-mail, SMS, WAP and telephone all type communications events between the mobile device and the correspondent.” *Id.* Maguire is silent as to the form of any interface that may be used to send messages. EX2001, ¶¶ 54-55.

4. U.S. Pat. App. Pub. No. 2002/0152220 (“Kang”) (EX1008)

Kang relates to “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.” EX1008, Abstract. “If a user clicks a unified receipt box among displayed items . . . , the controlling unit 26 searches both a mail message DB 42 and a SMS message DB 43 having been created in the storage module.” EX1008, [0029]. “All messages stored in the two DBs 42 and 43 have been received from outside.” *Id.* A unified message management table (UMMT) “is used for unified management of the two DBs 42 and 43 which contain different types of messages, respectively.” *Id.* at [0030]. “The controller unit 26 sequentially reads all entries of the UMMT 41 . . . and lists all or a part of them within a single window” as shown in FIG. 4 (reproduced below):

FIG. 4



If the user selects “New Mail” in the Receipt Box illustrated in FIG. 4, the system in Kang provides a new mail screen as shown in FIG. 7 (reproduced below). EX1008, [0040]; EX2001, ¶ 57.

FIG. 7

The figure shows a mobile device screen with a 'New Mail' form. The form has fields for 'To' (0191234567), 'CC', 'Attached', and 'Title'. A warning dialog box is displayed in the center, with the text: 'Warning! Can't send through e-mail service Change to New Memo for SMS'. The dialog box has an 'ok' button. Below the dialog box are 'Send' and 'Cancel' buttons. At the bottom of the screen is a numeric keypad with letters and symbols. A reference numeral 701 points to the left side of the screen, 710 points to the warning dialog box, and 711 points to the 'ok' button.

✉		New Mail							
To		0191234567							
CC									
Attached									
Title									
Warning! Can't send through e-mail service Change to New Memo for SMS ok									
Send		Cancel							
1	2	3	4	5	6	7	8	9	0
Q	W	E	R	T	Y	U	I	O	P
A	S	D	F	G	H	J	K	L	;
Z	X	C	V	B	N	M	,	.	/
Close	°i	A	12	@	▽△	⬅			

Likewise, if the user selects “New Memo”, the system provides a new memo screen as shown in FIG. 8 (reproduced below). EX1008, [0045]; EX2001, ¶ 58.

FIG. 8

801

New Memo									
To	dino211@mailserver.com								
From									
Send					Cancel				
1	2	3	4	5	6	7	8	9	0
Q	W	E	R	T	Y	U	I	O	P
A	S	D	F	G	H	J	K	L	;
Z	X	C	V	B	N	M	,	.	/
Close	°i	A	12	@	▽△	⬅			

After the user requests transmission (step S44 in FIG. 6a; step S63 in FIG. 6b), the system checks the message to see if it is compatible with the message kind selected by the user (steps S45, S46, and S50 in FIG. 6a; S64, S65, and S70 in FIG. 6b) and, if not, outputs a warning window informing the user of impossible message delivery and asking the user to select a suitable delivery manner (step S51 in FIG. 6a; step S71 in FIG. 6b). EX1008, [0042], [0047]. If a warning is generated, the user may select a suitable delivery manner. EX1008, [0043], [0048]. If there is no warning, the message is sent using the protocol originally

selected by the user (step S47 in FIG. 6a; step S66 in FIG. 6b). EX1008, [0041], [0046]; EX2001, ¶ 59.

5. Network Working Group, Internet Engineering Task Force (IETF) Request for Comments (RFC): 2822, Internet Message Format (2001) (“RFC2822) (EX1009)

RFC2822 is a standard specifying a syntax for email messages sent between computer users. EX1009, Abstract. The standard “makes no provision for the transmission of images, audio, or other sorts of structured data in electronic mail messages.” EX1009, 3.

III. THE LEVEL OF ORDINARY SKILL IN THE ART

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 and user interfaces for wireless communication terminals (or additional graduate education substituting for professional experience and/or significant experience in the field substituting for formal education). EX2001, ¶¶ 39-42. Petitioner’s formulation of a POSITA differs in that it deletes any experience with user interfaces; however, Patent Owner’s arguments are equally valid whether Petitioner or Patent Owner’s formulation for the experience of a POSITA is used.

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 and ordinary meaning of any term, is not helpful in resolving the controversy at hand.

For example, the Petition fails to specify what constitutes the plain and ordinary meaning of “integrated user interface (IUI),” “determining a message kind of an outgoing message which is inputted in the IUI,” and “transmitting the

outgoing message," which are relevant to Petitioner's anticipation and obviousness arguments. The Petition also ignores language in the specification disavowing claim scope. The disavowals pertain to the following claim terms relevant to Patent Owner's position that the Petition fails to show the challenged claims are unpatentable.

A. "integrated user interface" and "UI"

The term "integrated user interface" and its abbreviation "UI" should be construed to mean "a single, unitary instant messenger-like interface for transmitting/receiving text and multimedia messages, where an instant messenger-like interface is a single interface that displays an input window for composing an outgoing message to a recipient as well as transmitted and received messages to/from the recipient in transmitted/received order." EX2001, ¶¶ 61-68.

As noted above, the '839 Patent describes "the present invention" as a wireless communication terminal with a single integrated user interface for transmitting and receiving messages of various kinds. EX1001, 7:31-34 ("[t]he present invention provides an integrated user interface for transmitting/receiving diverse kinds of messages through **one** integrated user interface by using an integrated messaging service program"). The '839 Patent further describes "the present invention" as an instant messenger-like interface for multimedia messaging service (MMS) messages. EX1001, 7:41-46 ("[t]he present invention provides

user-friendly interface of the messaging service so that the user can use multimedia messaging service frequently and provides ***an instant messenger-like interface*** that can be compared with the conventional messaging service so that the user can exchange responses fast using the integrated messaging service.”).

By describing “the present invention” as such, the inventor disavowed claims covering a device having one interface for SMS messages and another interface for MMS messages; as well as disavowing claims covering a device with an interface that is not instant messenger-like. *See, e.g., Techtronic Industries Co. Ltd. v. Int’l Trade Comm’n*, 944 F.3d 901, 907 (Fed. Cir. 2019) (“It is axiomatic that, where the specification ‘describes “the present invention” as having [a] feature,’ that representation may disavow contrary embodiments.”); *Poly-America, L.P. v. API Industries, Inc.*, 839 F.3d 1131, 1136 (Fed. Cir. 2016) (“[A]n inventor may disavow claims lacking a particular feature when the specification describes “the present invention” as having that feature.”); *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007) (“When a patent thus describes the features of the ‘present invention’ as a whole, this description limits the scope of the invention.”); *see also Sony Corp. v. Iancu*, 924 F.3d 1235, 1241 (Fed. Cir. 2019); *Forest Laboratories, LLC v. Sigmapharm Laboratories, LLC*, 918 F.3d 928, 933 (Fed. Cir. 2019); and *Honeywell Int’l, Inc. v. ITT Indus., Inc.*, 452 F.3d 1312, 1318 (Fed. Cir. 2006).

The specification of the '839 patent also disparages the “conventional wireless terminal” that “use[s] a different interface according to the message kind to transmit and receive the text message or the multimedia message” and “provides different terms for each of messaging menus” such that “there is a problem that the user should use the various messaging services frequently in the conventional method.” EX1001, 1:31-44. According to the '839 patent, “[t]he conventional wireless communication terminal manages incoming/outgoing messages in an in-box and an out-box based on a concept that the message is a kind of letter” (i.e., like mail), and “provides late response in a communication, compared to an Internet instant messenger.” *Id.* at 1:45-50.

The “present invention,” on the other hand, “provides an instant messenger-like interface that can be compared with the conventional messaging service so that the user can exchange responses fast using the integrated messaging service.” *Id.* at 7:41-46. These statements in the specification, disparaging and distinguishing prior art based on the absence of a single, unitary instant messenger-like interface for text and MMS messages is further evidence the inventor intended to disavow claims lacking these features. *See, e.g., Poly-America, L.P. v. API Industries, Inc.*, 839 F.3d 1131, 1136 (Fed. Cir. 2016) (“Similarly, an inventor may disavow claims lacking a particular feature when the specification distinguishes or disparages prior art based on the absence of that feature.”); *Honeywell Int’l, Inc. v. ITT Indus., Inc.*,

452 F.3d 1312, 1318 (Fed. Cir. 2006) (“The written description's detailed discussion of the prior art problem addressed by the patented invention, viz., leakage of non-metal fuel filters in EFI systems, further supports the conclusion that the fuel filter is not a preferred embodiment, but an only embodiment.”), 1319 (“Nevertheless, based on the disclosure in the written description, which demeaned the properties of carbon fibers, we conclude that the patentee thereby disavowed carbon fibers from the scope of the '879 patent's claims.”) and 1320 (“Contrary to the district court's understanding, the written description has gone beyond expressing the patentee's preference for one material over another. Its repeated derogatory statements concerning one type of material are the equivalent of disavowal of that subject matter from the scope of the patent's claims.”); *Luminara Worldwide, LLC v. Liown Elecs. Co.*, 814 F.3d 1343, 1354 (Fed. Cir. 2016) (“By teaching that the "present description" solves the problems associated with the prior art candle devices because it is driven by "real but chaotic movements," the patentee disclaims devices driven by rhythmic or metronomic patterns.”).

Instant messaging, also known as “chatting,” is the real-time exchange of messages between two or more users. EX2001, ¶ 63; *see also* EX1005, 1:26-31. A POSITA would immediately understand the phrase “instant messenger-like interface” to mean a single interface that displays an input window for composing an outgoing message to a recipient as well as transmitted and received messages

to/from the recipient in transmitted/received order. Instant messengers at the time of the '839 Patent, including the instant messengers identified by Petitioner's expert during his deposition (i.e., AOL Instant Messenger, ICQ, and Blackberry Messenger), EX2002, 38:5-18, were known to have such an interface for transmitting and receiving instant messages over the Internet. EX2001, ¶¶ 65-67.

When asked about the meaning of "internet instant messenger" in the '839 patent, Petitioner's expert, Dr. Madisetti, was evasive but eventually he gave a few examples:

Q: Are you aware of any standard for internet instant messengers?

A: . . . in the 2004 timeframe, there would have been examples of messaging services that use the internet, for example, America Online, ICQ, and others—a few others. Blackberry, as an example, Blackberry Messenger.” EX2002, 35:14-41:3. As noted above, all of the internet instant messengers identified by Petitioner's expert have a user interface with an input window or field for composing an outgoing message to a recipient and display transmitted and received messages to/from the recipient in transmitted/received order. EX2001, ¶¶ 65-67.

Patent Owner's proposed construction is also consistent with the Detailed Description of the Invention of the '839 Patent, in which the IUI is shown and described as having an input window for composing an outgoing message to a

recipient and in which transmitted and received messages to/from the recipient are displayed together in transmitted/received order. *See, e.g.*, EX1001, FIG. 4B (reproduced below with annotations) and FIG. 4C (reproduced below with annotations).

FIG. 4B

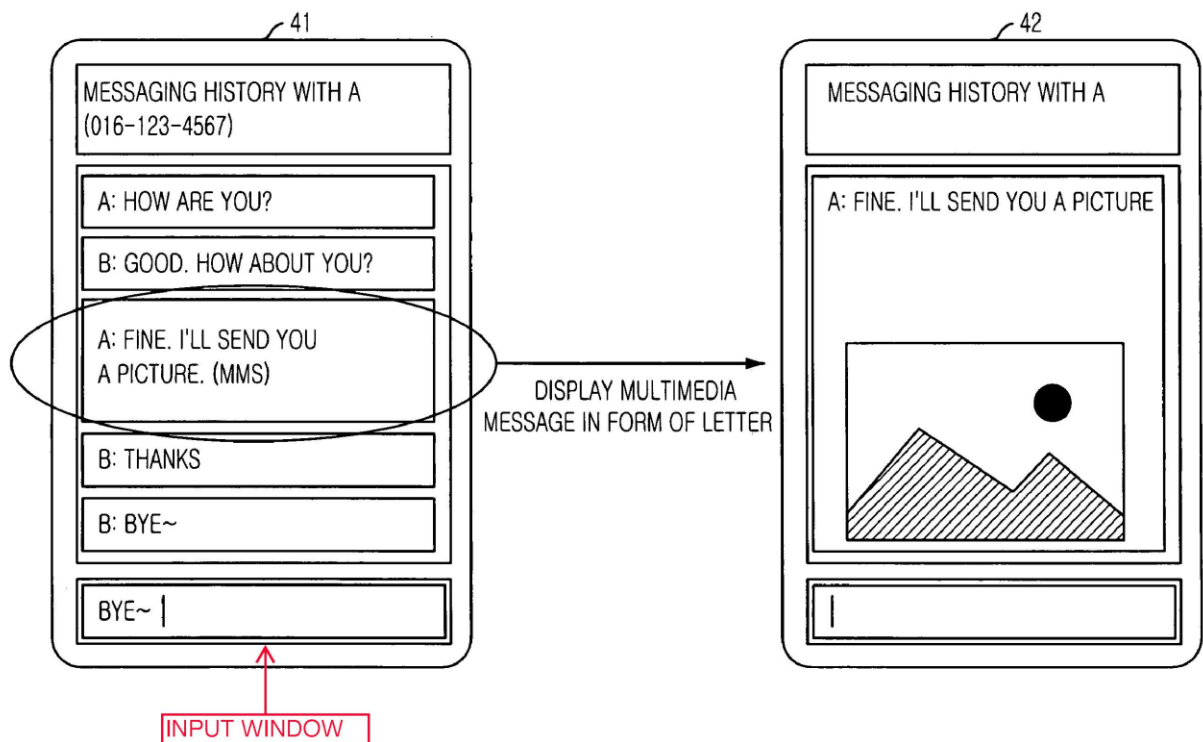


FIG. 4B shows messages received by user B from user A and messages transmitted by user B to user A, displayed in the integrated user interface in the order in which they were transmitted/received. *See, e.g.*, EX1001, 6:33-37 (“As shown in display image 41 of Fig. 4B, short messages transmitted/received

between the users A and B and an informing message of a multimedia message transmitted from the user A are outputted on the integrated user interface in the transmitted/received order.”); see also EX1001, 6:42-44 (“Then, a message outputted upon the selection can be converted into an output form of the integrated user interface, i.e., a messenger form.”). FIG. 4B also shows a text message (“BYE~”) being composed by user B in the input window of the IUI.

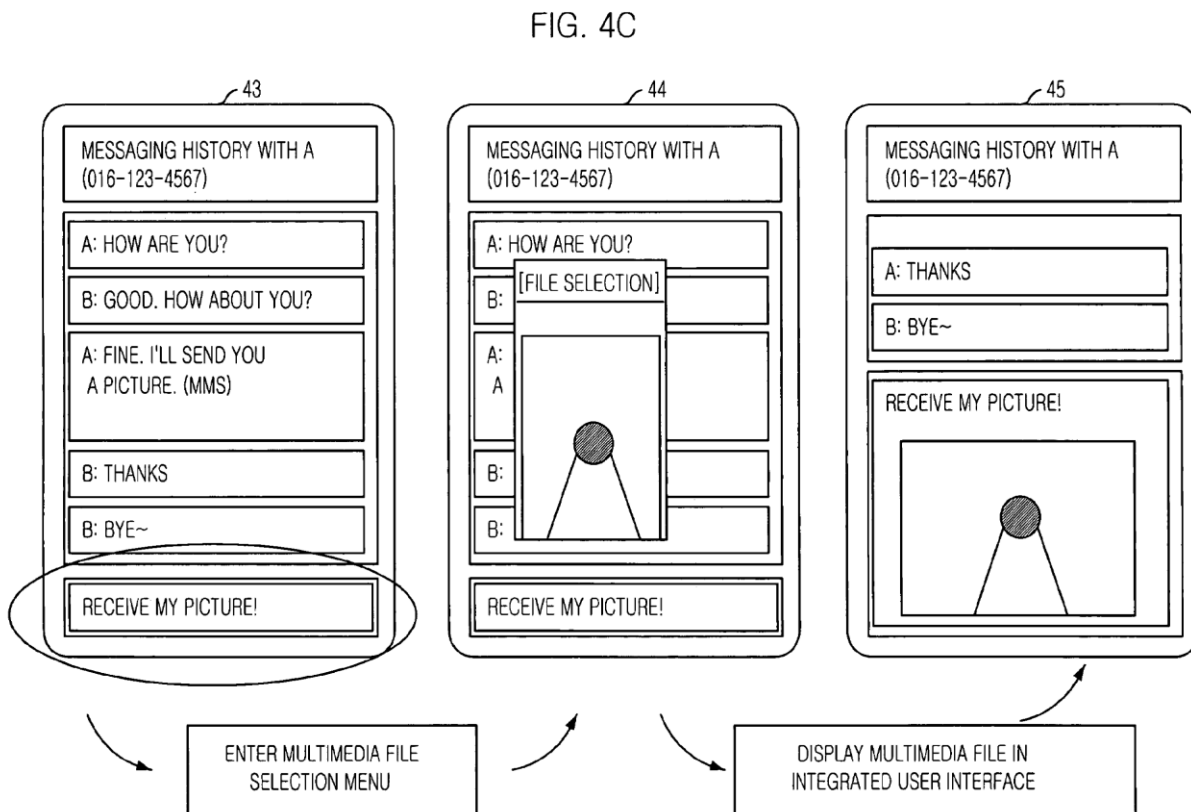


FIG. 4C shows the same IUI with a multimedia message being authored by user B in the input window. See, e.g., EX1001, 7:4-6 (“Meanwhile, referring to images 43 and 45 of FIG. 4C, a multimedia message is authored by the user B on

an input window of the integrated user interface.") A difference between a conventional Internet instant messenger and the IUI of the present invention is that, in a conventional Internet instant messenger, only one type of message (i.e., an instant message) is received in an input window and displayed in transmitted/received order, whereas the IUI of the present invention is a single, unified interface for two different types of messages (i.e., text messages and multimedia messages), that includes a unified input window for text messages and multimedia messages and displays transmitted/received text messages and multimedia messages together, in a unified manner, in transmitted/received order. EX2001, ¶¶ 61-68.

B. “determining a message kind of the message to be transmitted which is inputted in the IUI”

The term “determining a message kind of the message to be transmitted which is inputted in the IUI” should be construed to mean “determining whether or not a multimedia file is included in the message to be transmitted which is inputted in the IUI.”

The ‘839 Patent describes “the present invention” as a wireless communication terminal with an integrated user interface for transmitting and receiving messages of various kinds. EX1001, 7:31-34 (“[t]he present invention provides an integrated user interface for transmitting/receiving *diverse kinds of*

messages through one integrated user interface by using an integrated messaging service program.”)(emphasis added); EX1001, 7:35-40 (“[t]he present invention provides a wireless communication terminal and a method for transmitting and receiving **messages of various kinds, e.g., a text message and a multimedia message**, by using an integrated messaging service program without changing a transmission protocol or a network to thereby provide a user-friendly interface to a user.”)(emphasis added). By describing “the present invention” in this way, the inventor disavowed claims covering a device with an IUI for transmitting and receiving only one kind of message. *See, e.g., Techtronic Industries Co. Ltd.*, 944 F.3d at 907; *Poly-America, L.P.*, 839 F.3d at 1136; *Verizon Servs. Corp.*, 503 F.3d at 1308; *Sony Corp.*, 924 F.3d at 1241; *Forest Laboratories, LLC*, 918 F.3d at 933; and *Honeywell Int’l, Inc.*, 452 F.3d at 1318.

The ’839 Patent further describes “the present invention” as an instant messenger-like interface for multimedia messages. EX1001, 7:41-46 (“[t]he present invention provides user-friendly interface of the messaging service so that the user can use **multimedia messaging service** frequently and provides an instant messenger-like interface that can be compared with the conventional messaging service so that the user can exchange responses fast using the integrated messaging service.”) (emphasis added). By describing “the present invention” in this way, the inventor limited the scope of the claims to a device in which one of the message

kinds must be a message sent using a multimedia messaging service (i.e., MMS) protocol.

Multimedia messages may contain a notification message (which is sent using the same protocol as a text message) and a multimedia file. EX2001, ¶ 77. Since the IUI of the '839 Patent provides a single input window for inputting both text messages and multimedia messages (as opposed to different input windows based on message kind),¹ and since the claimed wireless communication device generates the outgoing message after message content is inputted in the IUI and message kind is determined,² a POSITA would understand the determination of message kind must be based on the content of the message inputted in the IUI—in particular, whether or not the content includes a multimedia file (which distinguishes the two kinds of messages). EX2001, ¶¶ 73-74. Thus, the term “determining a message kind of the message to be transmitted which is inputted in the IUI” should be construed to mean “determining whether or not a multimedia file is included in the message content inputted in the IUI.”

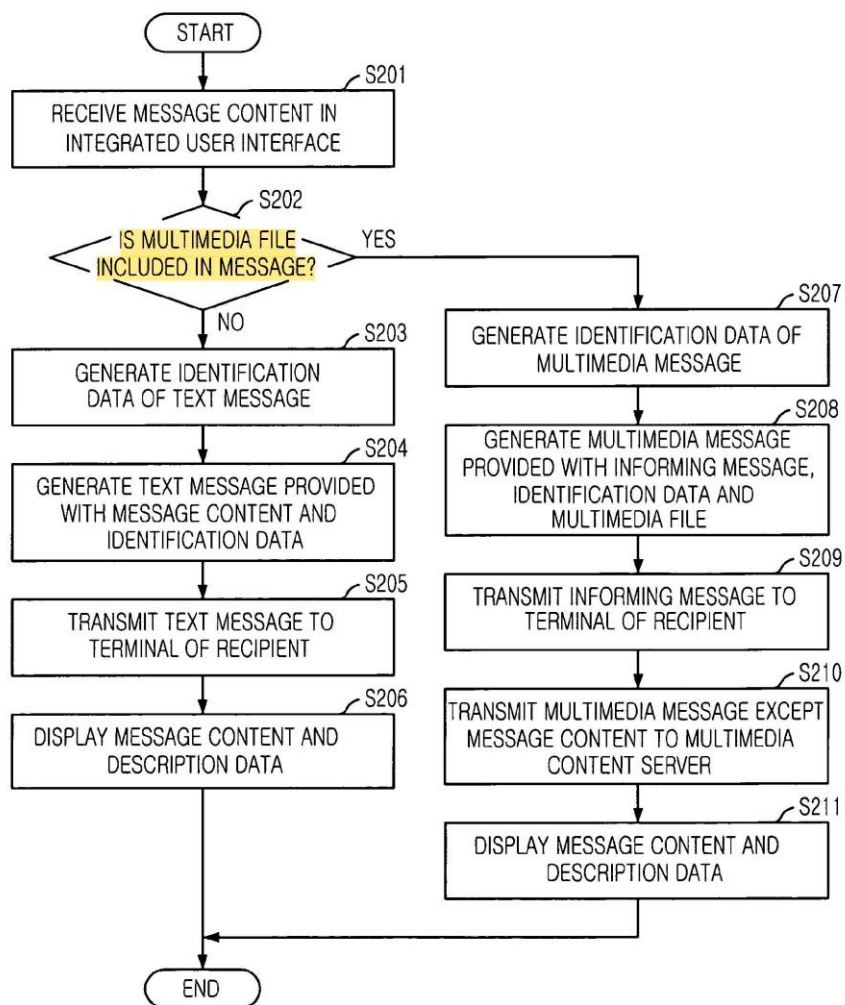
Patent Owner's proposed construction is consistent with the Detailed Description of the Invention of the '839 Patent, in which the preferred embodiment

¹ See Section IV.A., *supra*.

² See EX1001, Claim 1 (“... , generating an outgoing message . . . *corresponding to the message kind*, . . .”)(emphasis added).

is described as determining a message kind of an outgoing message inputted in the IUI based on whether or not a multimedia file is included in the inputted message. *See, e.g.*, EX1001, 3:40-45 (“When the wireless communication terminal transmits a message (hereinafter, which is referred to as an outgoing message), the controller 14 determines the message kind of an outgoing message ***based on whether a multimedia file is included in the message content or not . . .***”)(emphasis added); EX1001, 4:14-20 (“The controller **14** determines the kind of a message ***according to whether a multimedia file is included in the message content or not*** at step **S202**. If the message content includes only text, the kind of the message content is determined as a text message. If the message content include a multimedia file, the kind of a message is determined as a multimedia message.”)(emphasis added); and FIG. 2 (reproduced below).

FIG. 2



EX1001, FIG. 2 (step S202).

With regard to the meaning of “multimedia message,” a POSITA would have understood the term to mean “a message transmitted or received over a cellular network using the multimedia messaging service (MMS) protocol.”

EX2001, ¶¶ 75-85. During his deposition, Petitioner's expert Dr. Madisetti took the unusual position that a multimedia message "... can be something like an email message or it could be an MMS message, as an example." EX2002, 16:9-21. When asked whether the '839 patent provided an example of an email being a multimedia message, Petitioner's expert did not provide an example in the '839 patent and instead answered "one of or—would understand that an email would an example of a multimedia message because it describes multimedia messages includes data, such as voice data, images, moving pictures." EX2002, 18:2-8. In fact, the '839 patent never mentions the term "email," even though email was a very well-known and widely used technology at the time. EX2001, ¶ 85. While it's understandable Dr. Madisetti might seek to blur the lines between Petitioner's prior art and the '839 patent, the fact is a POSITA would not have considered email a "multimedia message." EX2001, ¶¶ 75-85.

First, the '839 patent is clear a multimedia message is a message transmitted or received using a multimedia messaging service. EX2001, ¶ 77. For example, when describing the problems in the prior art the invention is intended to solve, the '839 patent explains, "[r]ecently, the mobile terminal is provided with *a multimedia message transceiving service* including text data, voice data, images, and moving pictures." EX1001, 1:27-30 (emphasis added). In another example, when characterizing the invention, the '839 patent states "[t]he present invention

provides user-friendly interface of the messaging service so that the user can use *multimedia messaging service* frequently . . .” EX1001, 7:41-46.

Second, a POSITA would understand that by “multimedia messaging service,” the ’839 patent is referring to “MMS,” a standard protocol for sending multimedia messages over a cellular network developed by the Open Mobile Alliance in cooperation with the 3rd Generation Partnership Project (“3GPP”). EX2001, ¶¶ 78-81; *see also, e.g.*, EX2004, p. 20, Section 8.2.4, p. 37; EX2005. According to the MMS standard at the time, “Multimedia Messaging Service (MMS) is a system application by which a WAP client is able to provide a messaging operation with a variety of media types.” EX2004 at 5. A mobile terminal configured as an MMS client can exchange multimedia messages with a similarly configured mobile terminal over a wireless network. *Id.* When an MMS message is sent, an MMS notification message is sent as a push notification (e.g., via SMS) to the recipient mobile terminal. EX2005 at 36. When this MMS notification message is received by the mobile terminal, the mobile terminal can initiate a WAP gateway connection to retrieve the content of the MMS message. EX2005 at 37. Because SMS and MMS notification messages were both pushed to the recipient, an instant messenger-like user interface showing transmitted/received SMS and MMS messages in the order in which they are transmitted/received,

while allowing new messages to be inputted/sent, as set forth in the '839 patent, was possible. EX2001, ¶¶ 78-81.

Third, email is incompatible with the fundamental object of the invention—providing an instant messenger-like interface. EX2001, ¶¶ 82-85. Email is not transmitted/received over a cellular network using the MMS protocol. EX2001, ¶¶ 83-84. Instead, email is transmitted/received over the Internet using a protocol called SMTP, which stands for Simple Mail Transfer Protocol. According to the SMTP protocol, a sender may send an email by connecting to the Internet and transmitting the email, including the recipient's address, the subject of the email, and the body of the email, to the sender's email server. The sender's email server then determines the next email server to receive the email based on the recipient's address.. The next server could either be an intermediate email server along the delivery route or the recipient's email server. Once the email arrives at the recipient's server, it is stored there until the recipient establishes a connection with the Internet and retrieves the email using a different protocol, such as POP or IMAP.. The need for an Internet connection, and the delay inherent in email due to the nature of email protocols, which call for the recipient to pull received emails from its server, make email incompatible with an instant messenger-like user interface, the provision of which is a fundamental object of the '839 patent.

EX2001, ¶ 85. For at least these reasons, a POSITA would not consider email to be a multimedia message in the context of the '839 patent. .

C. “transmitting the outgoing message”

The term “transmitting the outgoing message” should be construed to mean “transmitting the outgoing message without changing the transmission protocol or the network of the message.”

The '839 Patent describes “the present invention” as a wireless communication terminal for transmitting and receiving messages of various kinds “without changing a transmission protocol or a network.” EX1001, 7:35-40; see also *id.* at 7:47-49; and 1:8-15. The '839 Patent also states it is “an object of the present invention to provide a wireless communication terminal . . . for transmitting and receiving different kinds of messages . . . without modifying a transmission protocol or a network.” *Id.* at 1:55-62.

By describing “the present invention” and “object of the present invention” as such, the inventor disavowed claims covering a device that changes the protocol or network for a message being transmitted or received. *See, e.g., Techtronic Industries Co. Ltd.*, 944 F.3d at 907; *Poly-America, L.P.*, 839 F.3d at 1136; *Verizon Servs. Corp.*, 503 F.3d at 1308; *Sony Corp.*, 924 F.3d at 1241; *Forest Laboratories, LLC*, 918 F.3d at 933; and *Honeywell Int’l, Inc.*, 452 F.3d at 1318.

Patent Owner's proposed construction is consistent with the Detailed Description of the Invention of the '839 Patent, in which the preferred embodiment is described as transmitting multimedia messages and text messages using their conventional protocols and networks. See, e.g., EX1001, 4:21-25 ("The multimedia file must be transmitted to a receiving terminal through the multimedia contents server differently from the text that is transmitted to the receiving terminal directly."); 4:37-42 ("The identification data identify the kind of the outgoing message. The text message and the multimedia message are transmitted to the receiving terminal in different routes. Therefore, the identification data of the text message are different from the identification data of the multimedia message."); and FIG. 2 (e.g., steps S205 and S209 for text message and informing (text) messages, respectively, and S210 for multimedia message). EX2001, ¶¶ 87-88.

V. ARGUMENT

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

The petitioner in an IPR bears the burden of proving by a preponderance of evidence that each challenged claim is unpatentable. 35 U.S.C. § 316(e).

Petitioner has failed to meet this burden.

1. Ground 1: Anticipation of Claims 1 and 2 by Lemay (Alone or in Combination With Alfke)

Ground 1 of the Petition alleges claims 1 and 2 are anticipated and/or rendered obvious by Lemay (EX1005), alone or in combination with Alfke (EX1006). Claim 1 is directed to a wireless communication terminal comprising, among other things, “a wireless transceiver for transceiving a message to/from an outside device through a wireless network,” “a storage for storing an integrated messaging service program and messages in order to provide an integrated user interface (IUI),” “a displayer for displaying the message content and description data in the IUI,” and “a controller” for “determining a message kind of the message to be transmitted which is inputted in the IUI,” “generating an outgoing message including identification data corresponding to the message kind,” “transmitting the outgoing message,” and “displaying the message content and the description data” of outgoing and incoming messages “in the IUI.” EX1001, 8:1-26. Claim 2 depends from claim 1 and further comprises “wherein the description data include incoming/outgoing description data in order to present whether the message is transmitted or received.” EX1001, 8:27-30.

Lemay, alone or in combination with Alfke, fails to anticipate or render obvious claims 1 and 2 because it does not disclose “an integrated user interface

(IUI),” “determining a message kind of the message to be transmitted which is inputted in the IUI,” or “transmitting the outgoing message,” as claimed.

(a) Lemay Does Not Disclose The “Integrated User Interface (IUI)” Limitation

As shown in section IV.A., *supra*, a POSITA would understand that the “integrated user interface” limitation recited in claim 1 of the '839 patent means “a single, unitary instant messenger-like interface for transmitting/receiving text and multimedia messages, where an instant messenger-like interface is single interface that displays an input window for composing an outgoing message to a recipient as well as transmitted and received messages to/from the recipient in transmitted/received order.” As detailed below, Lemay fails to meet this claim limitation. EX2001, ¶¶ 91-111. Instead of a single, unitary instant messenger-like interface that displays different types of messages together (i.e., in a unified manner) in transmitted/received order, Lemay discloses displaying instant messages and email messages separately. *See* EX1005, Figs. 2A-2D. That is, Lemay discloses separating email content from instant message content by means of a divider or by presentation in separate panes. EX1005, 7:5-9; EX2001, ¶ 92. Further, Lemay does not disclose a unitary input window for inputting more than one type of message. There is no disclosure in Lemay of the input field receiving any messages other than instant messages. Lemay, Figs. 2A-2D; EX2001, ¶ 93.

Alfke is not relied on by Petitioner for the IUI and therefore fails to remedy the deficiencies of Lemay. EX2001, ¶¶ 99-101. Therefore, Lemay alone or in combination with Alfke fails to anticipate or otherwise render claims 1 and 2 of the '839 patent unpatentable.

i. The User Interface in Lemay Does Not Display Text Messages and Multimedia Messages in Transmitted/Received Order

The user interface in Lemay is a combination of different interfaces—not a single, unitary interface. EX2001, ¶¶ 91-112. As shown in FIGS. 2A-2D, and 4 of Lemay (reproduced below), the user interface does not disclose displaying email and instant messages exchanged with another user in transmitted/received order in a single interface. In each of the figures, Lemay shows instant messaging open in a separate window or pane from any email messages:

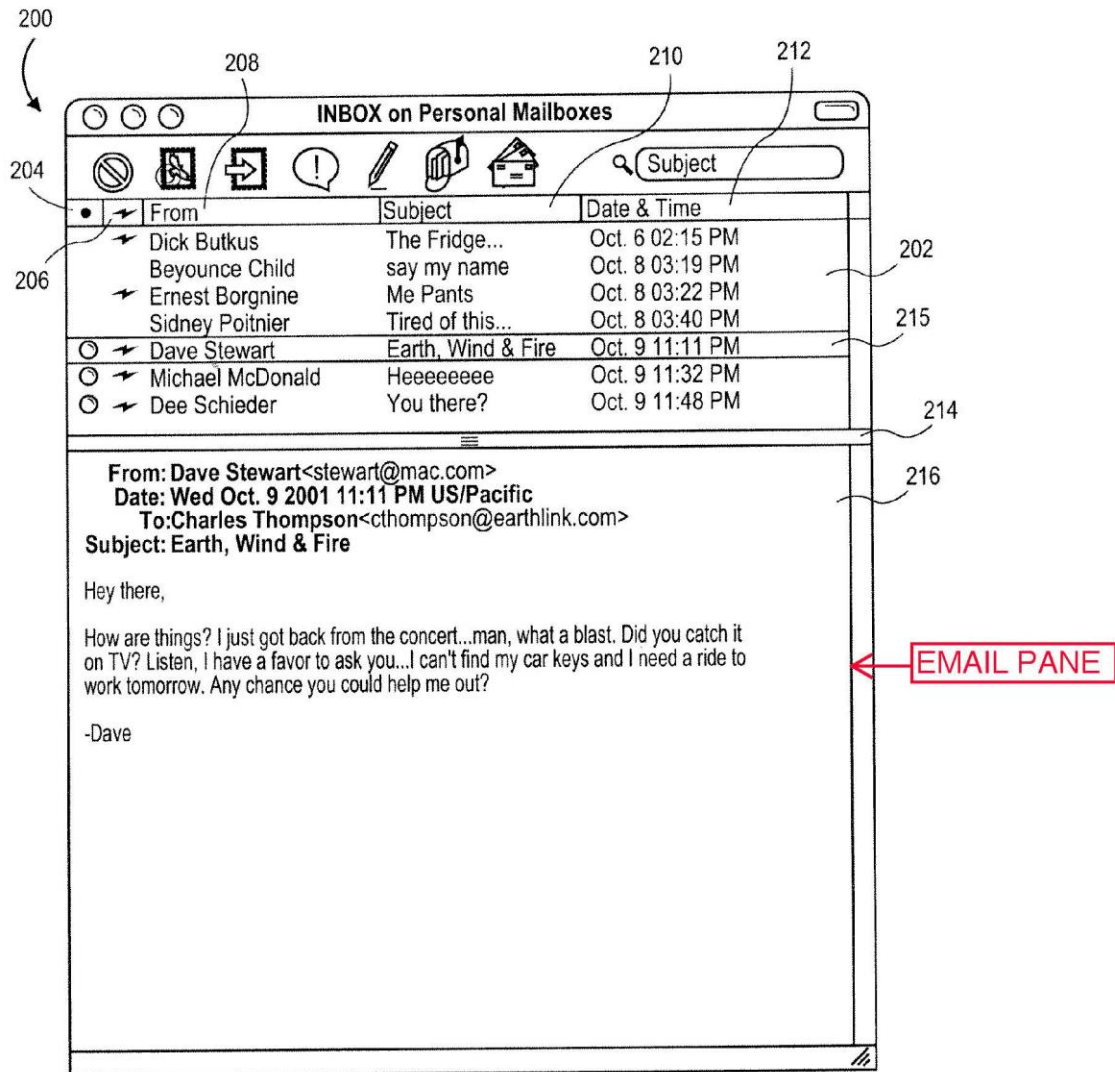
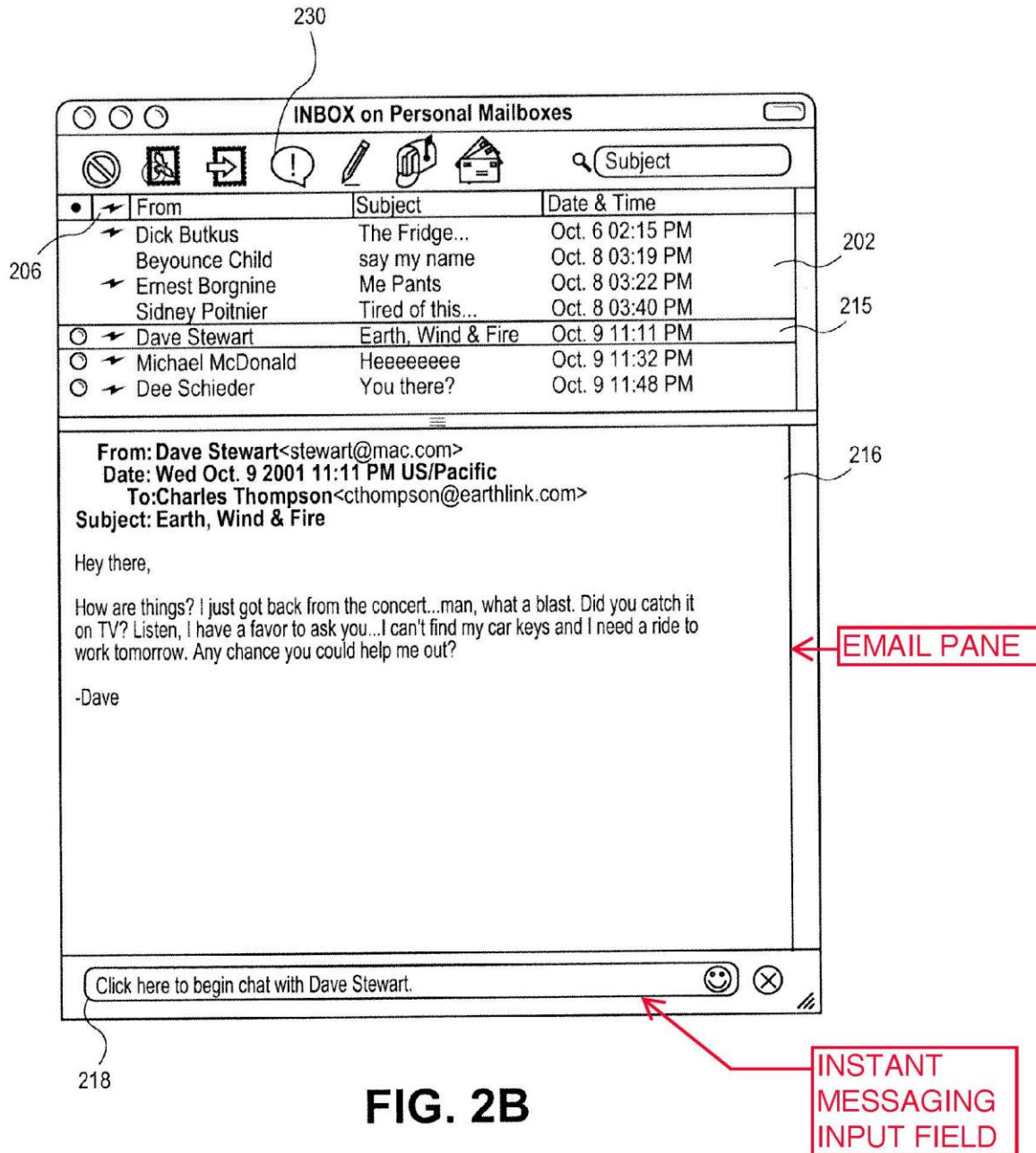
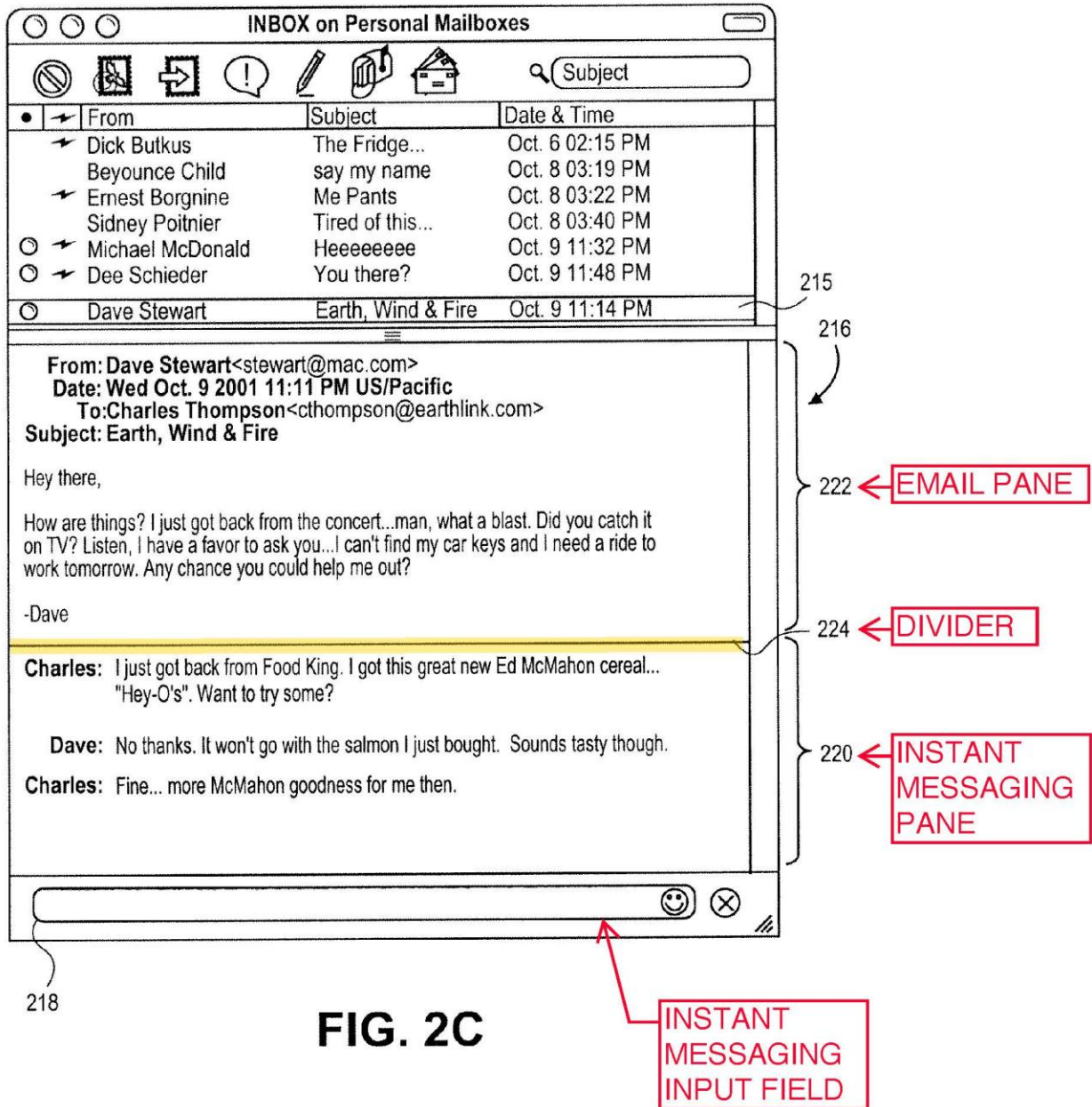
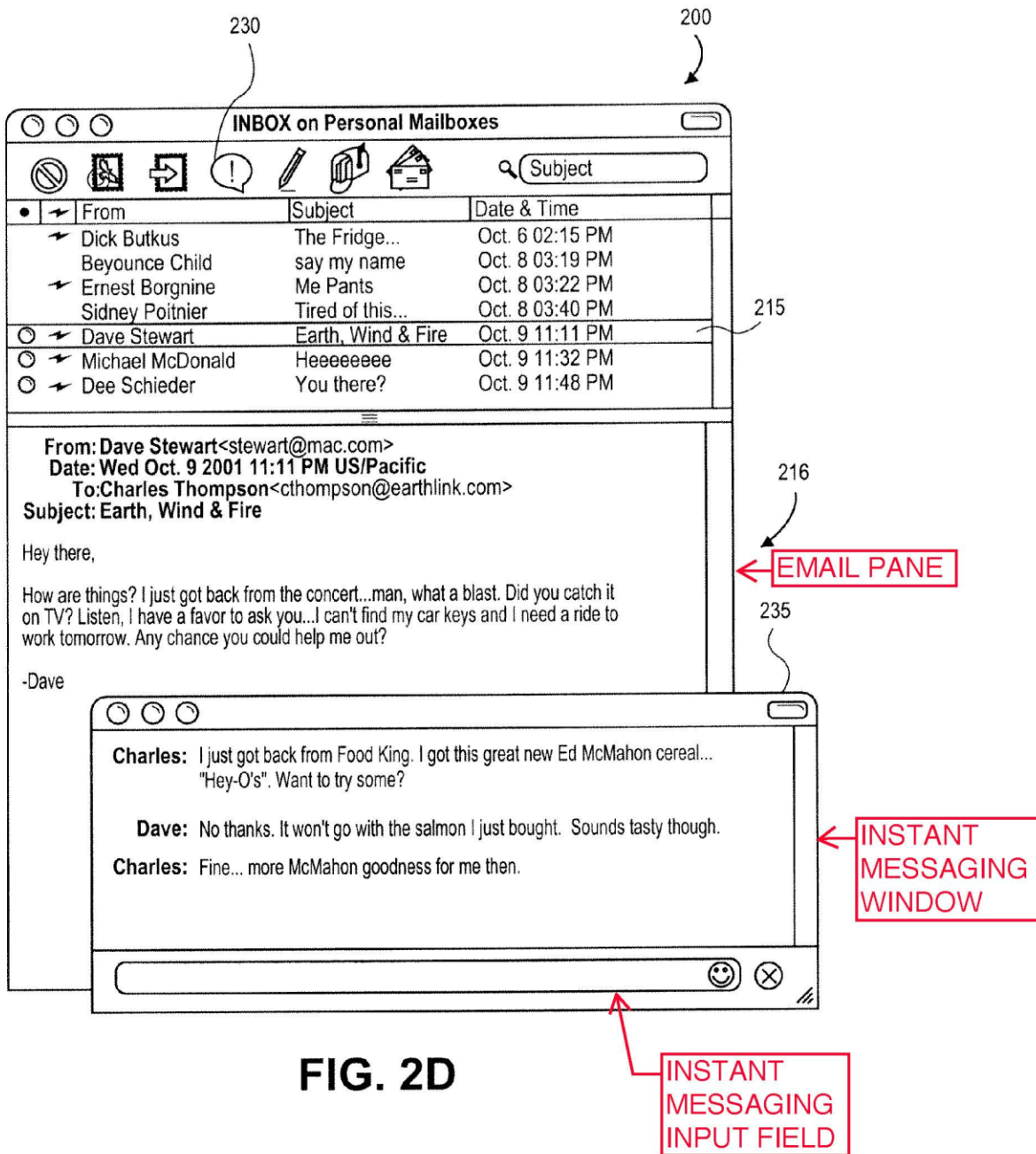
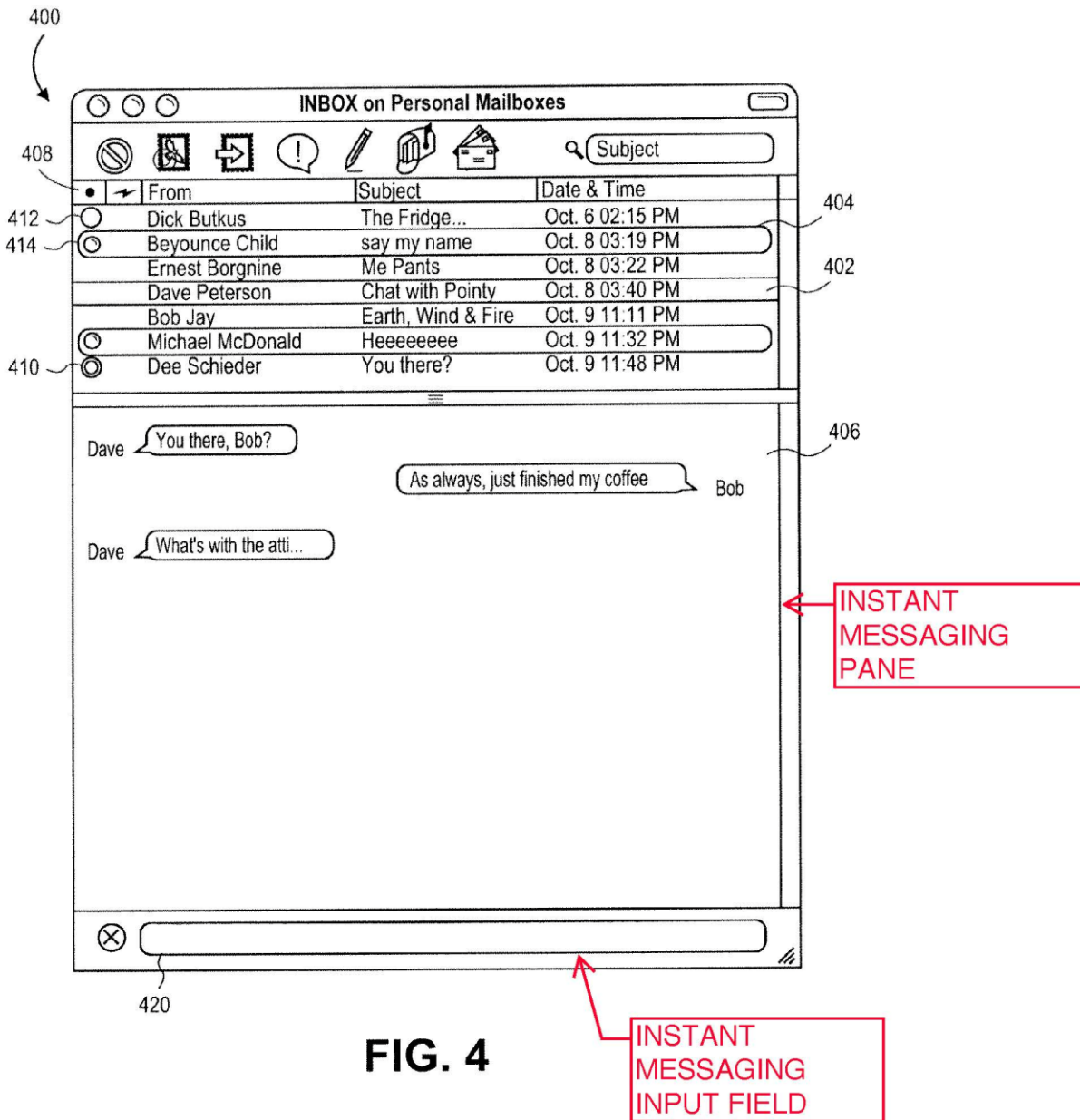


FIG. 2A









EX2001, ¶ 92.

In addition, Lemay makes clear input field 218 cannot be used to compose email messages, but is for instant messages only. *See, e.g.*, EX1005, 6:2-5 (“Input field 218 allows a user to initiate an instant messaging session with another user

associated with the record which is currently selected in the TOC 202, for example, the sender of an email..."); 6:30-34 ("In another exemplary embodiment, if a user is associated with a record becomes available for instant messaging while the message is currently being browsed, input field 218 appears by animating up (e.g., popping up) from the lower portion of pane 216."), 6:43-45 ("In another embodiment, input field 218 may appear when a user receives an invitation to join an instant messaging session from another user."), 10:16-41 ("In one embodiment, pane 406 includes an input field 420, similar to the input field 218 of FIGS. 2B and 2C, when a user associated with instant messaging content in a selected messaging record 402 is available online for instant messaging.... If a user associated with the instant messaging content (e.g., another user involved in the chat) is available for instant messaging, input field 420 is displayed in pane 406. If a user then initiates or resumes the instant messaging session by inputting text into the input field 420, the content of the session is updated in pane 406, as well as in the messaging record."); *see also* EX2001, ¶¶ 93-95.

Petitioner's expert Dr. Madisetti stated at his deposition that "218, the input field, is present at all times whether or not an instant messaging session is possible or not. So you take the Input Field 218, input text, if instant messaging is possible, the message kind is instant messaging. If the input field, if the – is not – then it goes via email. So the 218 is present at all times, which is the input field for

accepting user input,” citing in support Lemay at 6:35-42. EX2001, 149:2-13.

This is incorrect. EX2001, ¶ 94. Rather in each of the embodiments disclosed in Lemay, the input field 218 is for instant messaging only, and not for email messages. *See, e.g.*, EX1005, 6:26-30 (“In one embodiment, input field 218 appears simultaneously with the messaging record content in preview pane 216 when the record is selected in the TOC 202, ***if the user associated with the record is available for instant messaging.***”), 6:30-33 (“In another embodiment, ***if a user associated with record becomes available for instant messaging while the message is currently being browsed***, input field 218 appears by animating up...”), 6:36-39 (“For example, in the embodiment illustrated in Fig. 2B, ***when input field 218 appears, a clue stating, “Click here to begin chat...”*** appears to the user.”), 6:43-45, 6:52-54, 6:66-7:2; EX2001, ¶ 94.

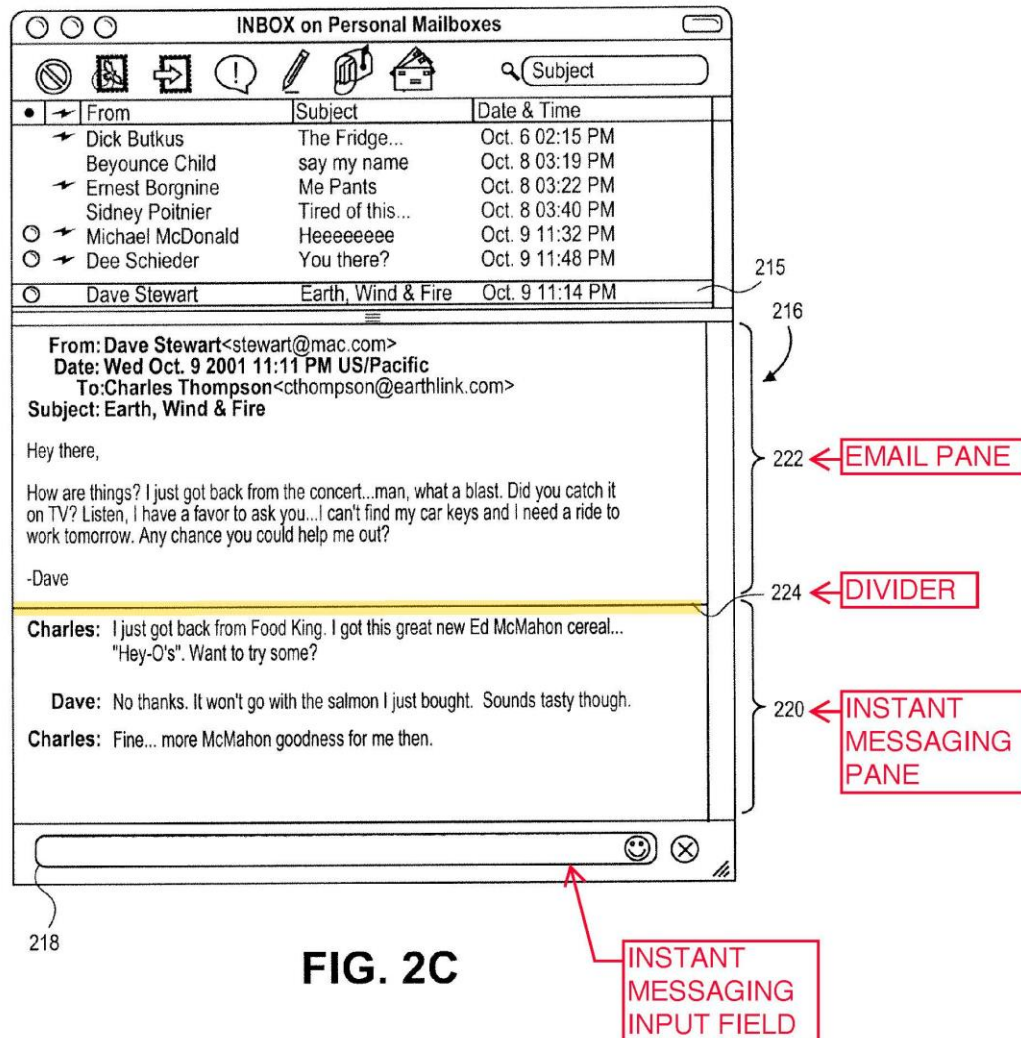
Further, the interface disclosed by Lemay is not an instant messenger-like interface, but an email like interface. EX2001, ¶¶ 95-98. As shown in Figs. 2A-2D, Lemay discloses a standard email inbox, showing, e.g., a “From,” “Subject” and “To” line. *Id.*. Indeed, Lemay uses descriptions for its interface that confirm the interface is email-like. *See, e.g.*, 8:57-60 (“Although FIGS. 2A-2C are illustrates[sic] embodiments using an Inbox, it will be appreciated that embodiments of the present invention may be applied to other folders, such as for example a Sent folder, or other user generated folders.”), 9:7-10 (“A user

associated with a selected message is a user who was a party to the initial email. For example, the 'From:' field of a selected message in an Inbox identifies a user associated with the message, i.e., the sender.”). This is consistent with claims 1 and 20 of Lemay, which specifically refers to “an email inbox.” EX1005, 11:60-63, 15:6-9; EX2001, ¶ 99.

Furthermore, Lemay also does not permit email and instant messages to be displayed in the correct transmitted/received order, because email and instant messages are transmitted at different speeds. EX2001, ¶¶ 103-112. In particular, while email is stored in a mail server until it is retrieved (i.e., pulled) by its intended recipient, which can cause a delay of several minutes between the transmission and receipt of an email message, instant messaging is sent directly to the intended recipient in a near instantaneous fashion. Thus, Lemay could not, consistent with email and instant messenger protocols at the time of the '839 patent, place both email and instant messages in order of transmission in a single interface. EX2001, ¶¶ 105-108.

In Lemay FIG. 2C (reproduced below), the user interface includes a first pane displaying an inbox listing only emails received from other parties, a second pane displaying an email selected from the list, and a third pane displaying a conventional instant messaging session. EX2001, ¶ 109-112. The first pane displaying an inbox does not meet the claim limitation because it only shows

received messages. EX2001, ¶ 109. The '839 patent explicitly distinguishes the claimed IUI from interfaces having a separate inbox and outbox. EX2001, ¶ 68. The second pane 222 displaying a selected email does not meet the claim limitation because it is only a received message. EX2001, ¶ 111. The third pane 220 displaying an instant messaging session does not meet the claim limitation because it is limited to one type of message (Internet instant message) and does not integrate multimedia messages with text messages. EX2001, ¶ 112.



ii. **The User Interface in Lemay Does Not Include An Input Window for Composing Text and Multimedia Messages**

The input field 218 or 420 in Lemay does not meet this limitation because it is only used for instant messaging. *See, e.g.,* EX1005, FIGS. 2A-2D, FIG. 4 and 1:55-58; 1:66-2:1, 5:66-6:20, 6:26-64, 9:15-19, 10:16-28; EX2001, ¶¶ 113-118. In

the embodiment shown in FIG. 2A of Lemay, an email in the TOC 202 is selected but no input field is displayed. In the embodiment shown in FIG. 2B of Lemay, an “input field 218” is displayed at the bottom of the preview pane 216 that “allows a user to initiate an instant messaging session with another user associated with the record that is currently selected in the TOC 202” is displayed. EX1005, 5:67-6:5. FIG. 2C of Lemay shows an instant messaging session initiated in a lower pane, below the preview pane displaying an email selected from the TOC. FIG. 2D of Lemay shows an instant messaging session initiated in a pop-up window 235, that is separate from the window containing the TOC and the preview pane. EX2001, ¶ 114-117. Furthermore, in the flow chart shown in FIG. 3, the input field is only displayed if the other user associated with a communication record is available for instant messaging. EX1005, FIG. 3 (steps 306 and 308); 9:15-19 (“If a user associated with a selected message is available for instant messaging, the selected email message is displayed in a preview pane with an input field for initiating an instant messaging session with the associated user (Block 308).”). EX2001, ¶ 118. None of the citations to Lemay (or Alfke) in the Petition teach or suggest the input field may be used to input email, much less a multimedia message.

Alfke does not remedy the deficiencies of Lemay with respect to this term. Alfke does not itself disclose any form of interface. Rather, Alfke references the

POSITA to Lemay for further information on what it terms the “unified user interface.” EX1006, 11:4-12; EX2001, ¶ 119.

In summary, Petitioner has not cited to any portion of Lemay or Alfke that teaches or suggests a single, integrated user interface in which a single input window receives text messages and multimedia messages to be transmitted to a recipient, as well as displaying text messages and multimedia messages to/from the recipient together in transmitted/received order. For at least this reason, Petitioner has failed to show by a preponderance of evidence that Lemay (alone or in combination with Alfke) anticipates or renders obvious claims 1 and 2.

(b) Lemay Does Not Disclose “Determining a Message Kind of The Message to be Transmitted Which is Inputted in The IUI”

As shown in section IV.B., *supra*, a POSITA would understand the limitation “determining a message kind of the message to be transmitted which is inputted in the IUI” recited in claims 1 and 2 of the ‘839 patent means “determining whether or not a multimedia file is included in the message to be transmitted which is inputted in the IUI.” As detailed below, Lemay fails to meet this claim limitation because it doesn’t determine a kind of message to transmit based on the content of a message inputted in the user interface, much less based on whether or not such content includes a multimedia file. EX2001, ¶¶ 121-128.

As acknowledged by Petitioner, the type of message to be transmitted in Lemay is either based on an online status of the recipient or where the message is dragged and dropped in the user interface. See Petition at 33-38; EX2001, ¶ 122. More specifically, in almost every embodiment of Lemay cited by Petitioner, the type of message to be transmitted is based on an online status of the recipient, and in the rest of the embodiments it is based on where the message is dragged and dropped in the interface. See, e.g., EX1005, 6:26-42 (“ . . . if a user associated with a record becomes available for instant messaging while the message is currently being browsed, input field 218 appears . . . ”); 9:29-52 (describing dragging and dropping an email in the TOC pane on an instant messaging record in the TOC pane to cause the email to be sent to the user associated with the instant messaging record through a file transfer protocol, or dragging and dropping an instant messaging record in the TOC into a new email message or an instant messaging session to insert a transcript of the instant messaging session); and FIG. 3 (step 306 – determining whether an associated user is available for instant messaging). *Id.* In none of these examples is the message kind of the message to be transmitted determined based on the content of the message inputted in the user interface. On the contrary, in the instant messenger availability examples, a message is not even inputted in the IUI when the determination of message kind is made (see step 306).

“Input” is therefore not related to the determination, but related to “application” of the determination. EX2001, ¶¶ 123-124.

Alfke, which is incorporated by reference in Lemay and cited by Petitioner for this limitation, determines how to send an email based on whether there is an alternative messaging system (e.g., an instant messaging system or a chat system) available to recipient associated with the email—not based on the content of the message inputted in the user input, much less based on whether or not such content includes a multimedia file. Therefore, Alfke fails to remedy the above-noted deficiencies of Lemay. EX2001, ¶¶ 125-127. Accordingly, Lemay (alone or in combination with Alfke) fails to anticipate or otherwise render claims 1 and 2 of the patent unpatentable.

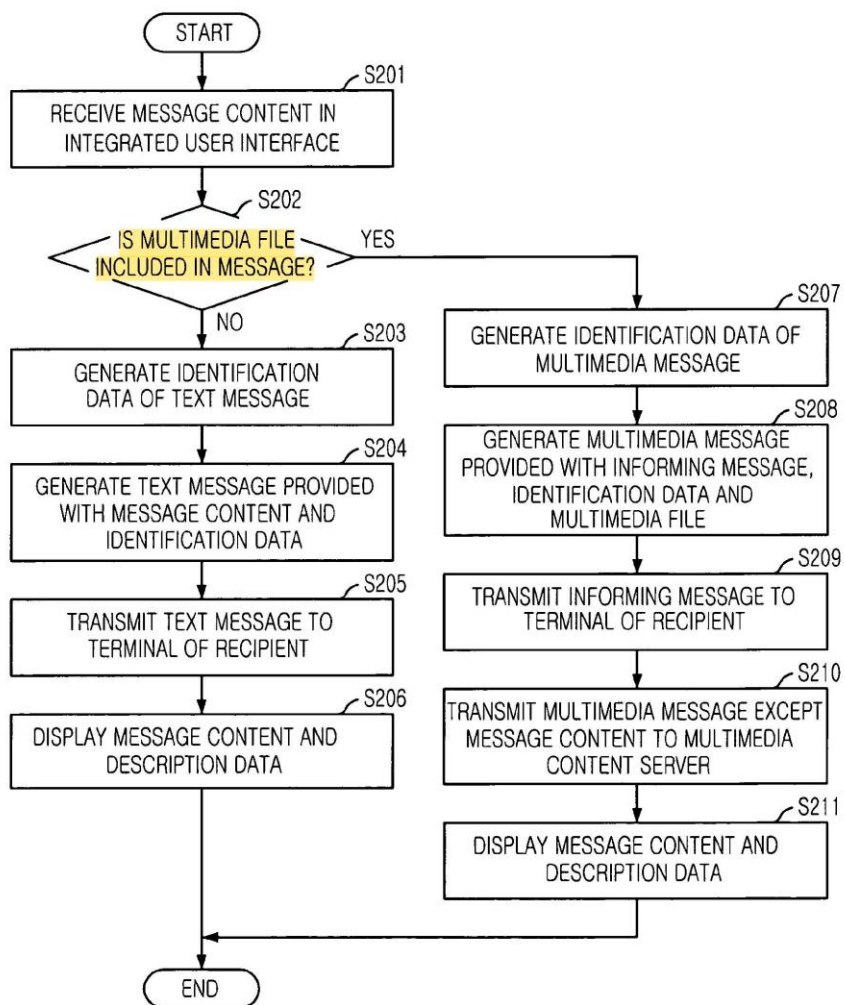
i. Lemay (Alone or in Combination With Alfke) Doesn't Determine Message Kind Based on The Content of an Outgoing Message Inputted in an Integrated User Interface

Claims 1 and 2 don't merely recite “determining a message kind”—they require “determining a message kind *of a message to be transmitted which is inputted in the IUI.*” In other words, the determination is based on a message that has already been inputted in the IUI. This is consistent with how the invention is described and shown in the '839 Patent. *See, e.g.*, EX1001, 3:40-49 (“... the controller 14 determines the message kind of an outgoing message based on

whether a multimedia file is included in the message content or not . . .”); 4:6-16

(“A message content of the outgoing message is inputted by a user in the IUI at step S201. . . . The controller 14 determines the kind of a message according to whether a multimedia file is included in the message content or not at step 202.”); 4:16-20; *see also* FIG. 2 (reproduced below).

FIG. 2



EX1001, Fig. 2 (S201, S202) EX2001, ¶ 128. .

In Lemay, on the other hand, determining a message kind of the message to be transmitted is not based on what has been inputted in the user interface.

EX2001, ¶ 129. As acknowledged by Petitioner, the type of message to be

transmitted in Lemay is in almost all cases based on an online status of the recipient. *See* Petition at 33-38; EX1003. More specifically, in almost every embodiment of Lemay cited by Petitioner, the type of message to be transmitted is based on an online status of the recipient, and in the rest of the embodiments it is based on where the message is dragged and dropped in the interface. *See, e.g.*, EX1005, 6:26-42 (“... if a user associated with a record becomes available for instant messaging while the message is currently being browsed, input field 218 appears . . .”); 9:29-52 (describing dragging and dropping an email in the TOC pane on an instant messaging record in the TOC pane to cause the email to be sent to the user associated with the instant messaging record through a file transfer protocol, or dragging and dropping an instant messaging record in the TOC into a new email message or an instant messaging session to insert a transcript of the instant messaging session); and FIG. 3 (step 306 – determining whether an associated user is available for instant messaging). In none of these examples is message kind of the message to be transmitted determined based on the content of the message inputted in the user interface. On the contrary, in the instant messenger availability examples, a message is not even inputted in the IUI when the determination of message kind is made (see step 306). “Input” is therefore not related to the determination, but related to “application” of the determination. In the drag and drop examples, the determination is based on where a message in the

interface is dragged and dropped—not the content of a message which is inputted in the user interface. EX2001, ¶ 130-131.

Similarly, in every embodiment of Alfke cited by Petitioner, whether or not an email generated by an email client is transmitted as an email or another kind of message is based on whether there is an alternative messaging system (e.g., an instant messaging system or a chat system) available to the recipient associated with the email. Notably, the determination is not based on the content of a message inputted in a user interface prior to generating the email, much less based on whether or not such content includes a multimedia file. *See, e.g.*, EX1006, 5:50-6:4 (discusses email client determining whether to send an email as an email or an alternative kind of message based on whether an alternative message delivery mechanism is available), 6:17-36 (discusses tagging and repackaging an email message in a format compatible with an alternative delivery system and how the recipient's alternative delivery system—not the sender's system—may determine whether the message is an email based on the tag), 7:24-38 (discusses interactions between mail clients and instant messaging clients so that emails generated by mail clients can be sent using instant messaging clients), 7:49-63 (discusses mail client determining whether to send an email as an email or an alternative kind of message based on whether an alternative messaging system is available), 8:6-34 (discusses mail client determining whether the alternative messaging system is capable of

handling mail messages, and how an email may be tagged and repackaged for delivery through the alternative messaging system), 11:29-58 (discusses mail interface 261 sending email message to a module that determines whether to send the email as an email or an alternative kind of message based on whether recipient's alternative delivery mechanism is online and capable of handling email messages), 13:25-40 (discusses mail client receiving an email message and determining whether to send the email as an email or an alternative kind of message based on whether recipient's alternative delivery mechanism is available), 16:1-23 (discusses how a mail client may select from multiple alternative delivery mechanisms to deliver an email based on an attribute of the email, the user configuration, or the user preferences), and FIG. 4 (showing how a mail client receives an outgoing email message and determines whether to send the email as an email or an alternative kind of message based on whether an alternative delivery application is online); *see also* EX2001, ¶ 132.

In summary, Petitioner has not cited to any portion of Lemay or Alfke that teaches or suggests determining a message kind of the message to be transmitted which is inputted in the IUI. For at least this reason, Petitioner has failed to show by a preponderance of evidence Lemay (alone or in combination with Alfke) anticipates or renders obvious claims 1 and 2.

ii. Lemay (Alone or in Combination With Alfke) Doesn't Determine Message Kind Based on Whether or Not A Message Inputted in an Integrated User Interface Includes a Multimedia File

As shown in Section IV.B., *supra*, a POSITA would construe the limitation “determining a message kind of the message to be transmitted which is inputted in the IUI” to mean “determining whether or not a multimedia file is included in the message to be transmitted which is inputted in the IUI.” In Lemay, on the other hand, determining a message kind of the message to be transmitted is not based on whether or not a multimedia file is included in the message to be transmitted. EX2001, ¶ 94.

First, as acknowledged by Petitioner, the type of message to be transmitted in Lemay is in almost all embodiments based on an online status of the recipient. *See* Petition at 33-38. More specifically, in every embodiment of Lemay cited by Petitioner, the type of message to be transmitted is either based on an online status of the recipient or based on where the message is dragged and dropped in the interface. *See, e.g.*, EX1005, 6:26-42; 9:29-52; and FIG. 3. In none of the examples from Lemay is message kind determined based on whether or not a multimedia file is included in the message to be transmitted. EX2001, ¶ 136.

Second, Lemay discloses a user interface for instant messaging and email. *See, e.g.*, EX1005, Abstract. Instant messaging is text-based; and, as shown in

Section IV.B., *supra*, a POSITA would not consider email to be a multimedia message in the context of the '839 patent. EX2001, ¶ 137. Even assuming email were a multimedia message (which it is not), there is no disclosure in Lemay of determining message kind based on whether or not a multimedia file is included in a message to be transmitted. To the contrary, the type of message to be transmitted in Lemay is either based on an online status of the recipient or based on where the message is dragged and dropped in the interface. FIG. 2C of Lemay shows an instant messaging session initiated in a lower pane, below the preview pane displaying an email selected from the TOC. EX1005, FIG. 2C; EX2001, ¶ 138.

Similarly, in every embodiment of Alfke cited by Petitioner, whether or not an email generated by an email client is transmitted as an email or another kind of message is based on whether there is an alternative messaging system (e.g., an instant messaging system or a chat system) available to the recipient associated with the email. *See, e.g.*, EX1006, 5:50-6:4, 6:17-36, 7:24-38, 7:49-63, 8:6-34, 11:29-58, 13:25-40, 16:1-23, and FIG. 4; *see also* EX2001, ¶ 139. As such, it is clear the determination in Lemay is not based on whether or not a multimedia file is included in the message to be transmitted.

In summary, Petitioner has not cited to any portion of Lemay or Alfke that teaches or suggests determining a message kind of the message to be transmitted which is inputted in the IUI.

For at least these reasons, Petitioner has failed to show by a preponderance of evidence Lemay (alone or in combination with Alfke) anticipates or renders obvious claims 1 and 2.

(c) Lemay Does Not Disclose “Transmitting the Outgoing Message”

As shown in Section IV.C. *supra*, a POSITA would understand the limitation “transmitting the outgoing message” recited in claims 1 and 2 of the ‘839 patent means “transmitting the outgoing message without changing the transmission protocol or network of the message.” As detailed below, Lemay fails to meet this limitation because it changes the transmission protocol or network of the outgoing message based on whether or not the recipient is online. EX2001, ¶ 140-141. Alfke, which is incorporated by reference in Lemay, fails to remedy the deficiencies of Lemay. EX2001, ¶ 142-149. Alfke specifies a message is repackaged as an instant message or an email message, based on which transmission protocol or network is used to send the message, not the message itself. Thus, Lemay, individually or in combination with Alfke, fails to teach this limitation.

Both Petitioner and its expert, Dr. Madisetti, admit Lemay changes a transmission protocol or a network. *See, e.g.*, Pet. at 14 (“The system determines whether to send emails as instant messages based on whether the recipient is

online: the system continuously monitors whether the recipient is online and, if so, determines that each outgoing email message should be *repackaged*, tagged with “identification” information specifying that the “message being delivered is an email message,” *and sent as an instant message.*” (emphasis added)); EX1003, ¶ 48. Thus, under the proper construction of “transmitting the outgoing message,” Petitioner has failed to carry its burden of proof this limitation is met.

Even if Petitioner attempted to combine Lemay with Alfke (which the Petition does not), the combination would also not disclose this limitation. EX2001, ¶¶ 142-149. Alfke (which Petitioner asserts is incorporated by reference into Lemay (see Pet. at 5 fn.2), makes clear the transmission protocols and networks for email and instant messages are distinct. EX1006, FIGS. 2A-2C; EX2001, ¶¶ 142-144. For example, Figs. 2A and 2B of Alfke shows two methods of transmitting a message. In the first, an email message is delivered through e.g., an SMTP, PoP, or IMAP protocol. See EX1006, Fig. 2A (reproduced below); In the second, an instant message is delivered by an “alternative message delivery client I (e.g., instant messaging).” EX2001, ¶¶ 142-143.

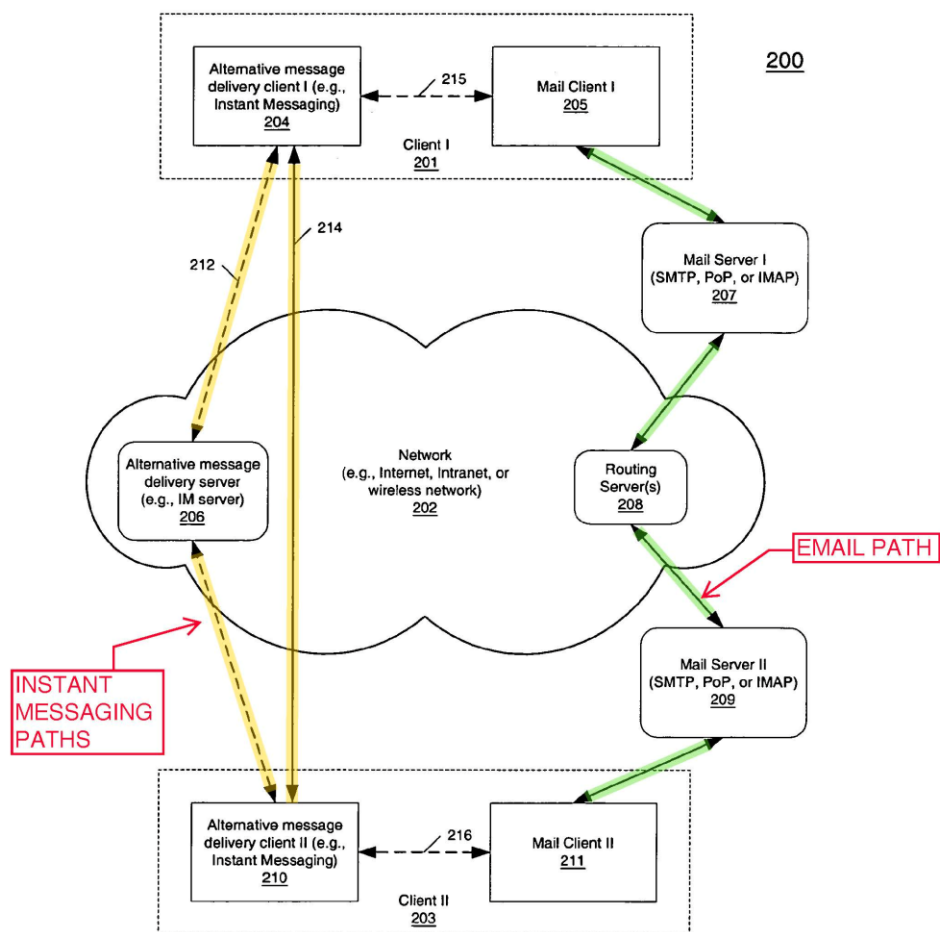


Fig. 2A

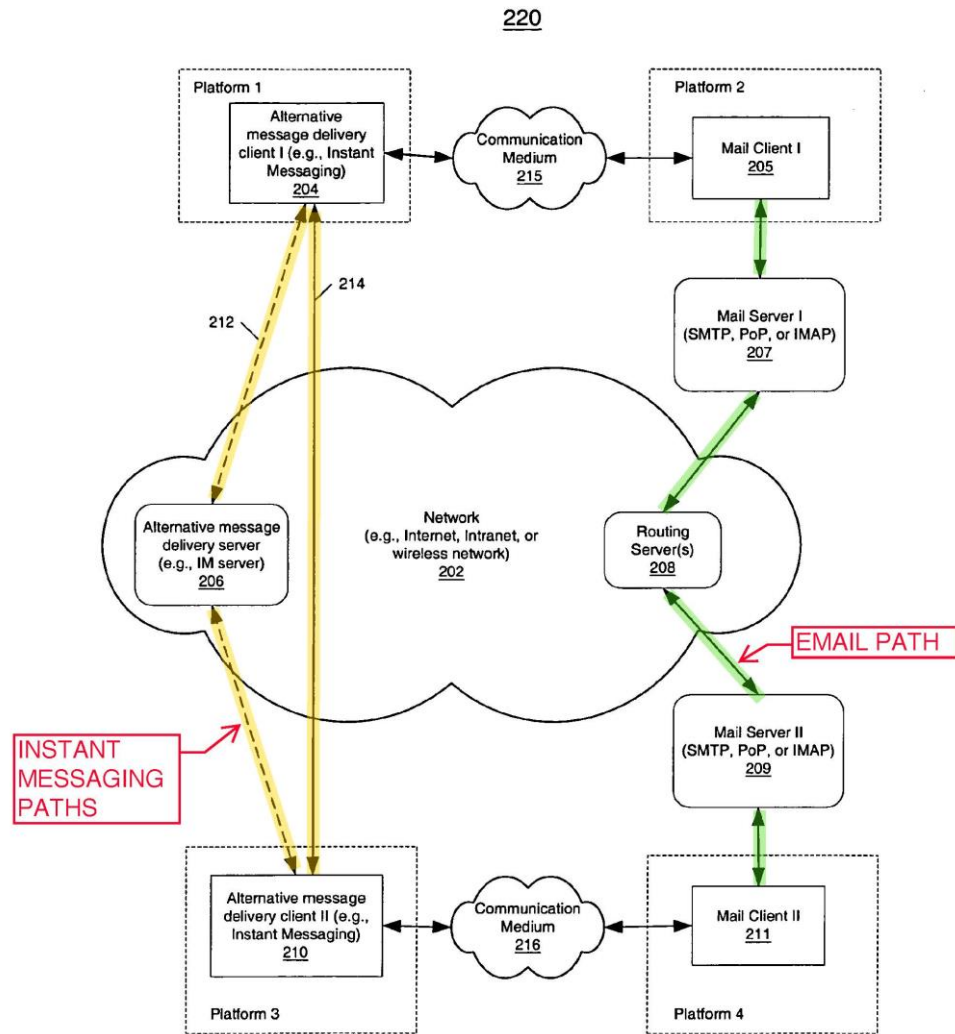


Fig. 2B

Similarly, in Fig. 2C (reproduced below), Alfke distinguishes between a “mail client” at 252, and an “alternative delivery client” 251.

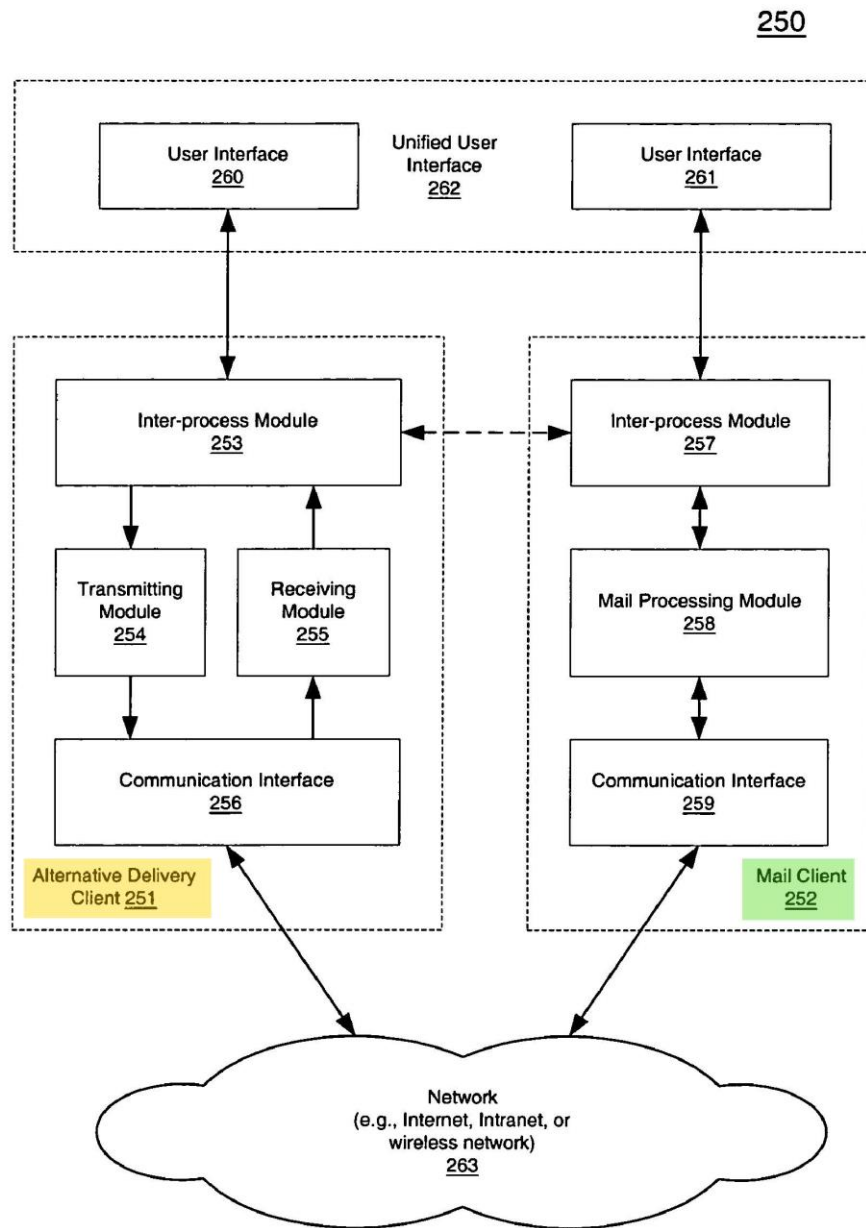


Fig. 2C

See also EX1006, 6:42-7:3. Alfke is also clear the recipient's alternative messaging system must be "able to handle mail messages." EX1006, 8:19-20; EX2001, ¶¶ 144-145.

Alfke also clearly states that in one embodiment, in order to distinguish emails from other messages in the alternative delivery system, “the email message may be tagged with an identification indicating the message being delivered is an email message and repackaged in a format compatible with the message requirement of the alternative delivery system.” EX1006, 6:19-22; EX2001, ¶ 146. In a different embodiment, “either the alternative delivery system or the email client repackages the message as an ordinary email message and the email client displays the message as if it is received from the corresponding email server.” EX1006, 6:27-31; EX2001, ¶ 147.

The transmission protocols and networks for email and instant messages are distinct. Therefore, in order to repackage an email message for delivery as an instant message, the transmission protocol and network must be changed. EX2001, ¶¶ 148-149. In contrast with the system of Lemay, which requires a transmission protocol be changed before an email may be transmitted or received as an instant message, the invention of the ‘839 patent clearly states it provides “an integrated messaging service program in order to provide an easy and user-friendly interface ***without modifying a transmission protocol or a network.***” EX1001, 1:59-62; EX2001, ¶ 149. Thus, the Petition fails to establish by a preponderance of evidence Lemay anticipates or renders obvious this limitation.

2. Ground 2 - Maguire in View of Kang Does Not Render Claims 1 and 2 Obvious

Ground 2 of the Petition alleges claims 1 and 2 are obvious over Maguire (EX1007) in view of Kang (EX1008). As noted previously, claim 1 is directed to a wireless communication terminal comprising, among other things, “a wireless transceiver for transceiving a message to/from an outside device through a wireless network,” “a storage for storing an integrated messaging service program and messages in order to provide an integrated user interface (IUI),” “a displayer for displaying the message content and description data in the IUI,” and “a controller” for “determining a message kind of the message to be transmitted which is inputted in the IUI,” “generating an outgoing message including identification data corresponding to the message kind,” “transmitting the outgoing message,” and “displaying the message content and the description data” of outgoing and incoming messages “in the IUI.” EX1001, 8:1-26. Claim 2 depends from claim 1 and further comprises “wherein the description data include incoming/outgoing description data in order to present whether the message is transmitted or received.” EX1001, 8:27-30.

As detailed below, the proposed combination of Maguire in view of Kang would not render claims 1 and 2 obvious because the proposed combination would not include “an integrated user interface (IUI),” “determining a message kind of

the message to be transmitted which is inputted in the IUI,” or “transmitting the outgoing message,” as claimed.

(a) The Proposed Combination of Maguire and Kang Would Not Meet The “Integrated User Interface (IUI)” Limitation

As shown in section IV.A., *supra*, a POSITA would understand the “integrated user interface” limitation recited in claim 1 of the '839 patent means “a single, unitary instant messenger-like interface for transmitting/receiving text and multimedia messages, where an instant messenger-like interface is a single interface that displays an input window for composing an outgoing message to a recipient as well as transmitted and received messages to/from the recipient in transmitted/received order.” Maguire does not disclose an IUI as claimed.

EX2001, ¶¶ 150-154.

First, Maguire does not disclose an instant-messenger like interface. Petitioner points to interface 124 at Fig. 5, which is the sole user interface disclosed in Maguire, as the IUI disclosed in the challenged claims:

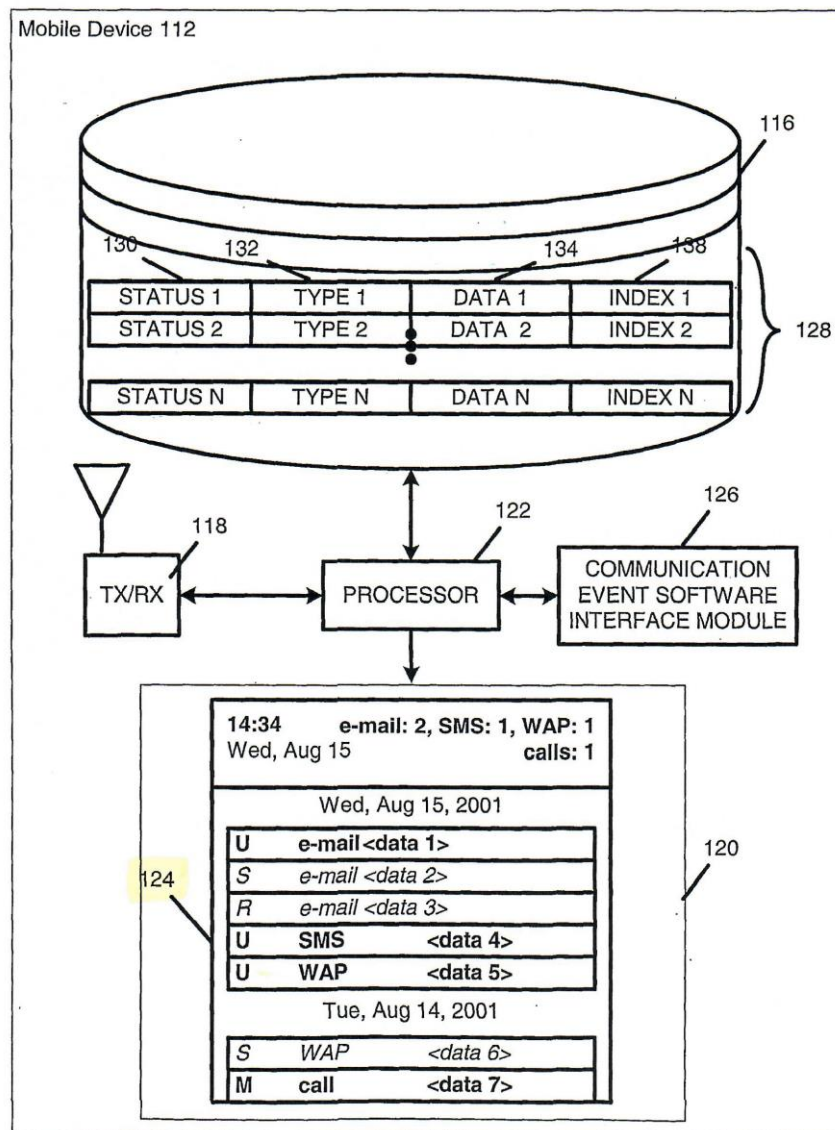


Figure 5

Pet. at 59; EX1003, ¶¶ 136-137. This is not an instant messenger-like interface as disclosed by the '839 patent. EX2001, ¶¶ 151-152. Maguire nowhere discloses an input window for composing an outgoing message to a recipient. Instead, Maguire states the interface 124 “illustrates a date and time, as well as the number of e-mail, SMS, WAP and telephone all type communications events between the mobile

device and the correspondent.” EX1007, [0026]. While Maguire generally states it may both send and receive messages, including SMS and email messages, *id.*, it provides no indication the interface shown in Fig. 5 is the same one that provides for composing an outgoing message to a recipient. In fact, Fig. 5 shows no means of composing an outgoing message at all. EX2001, ¶ 153. This is consistent with the focus of Maguire on receipt of communications, not the sending of communications. Maguire states “an embodiment of the first aspect of ***the present invention***” is “the step of ***receiving the incoming communications event*** prior to identifying the correspondent.” EX1007, [0012], [0015]. The reference to the “present invention” would tell one of ordinary skill in the art this is a requirement of the invention, and the form of any interface that is used to send messages is completely absent from Maguire. EX2001, ¶ 154.

Kang fails to remedy the deficiencies of Maguire. EX2001, ¶ 155-159. Petitioner does not reference Kang at all with respect to the limitation “a storage for storing an integrated messaging service program and messages in order to provide an integrated user interface (IUI).” Pet. at 59; EX1003 at ¶¶ 135-137. And to the extent Petitioner relies on Figs. 7 and 8 of Kang for the disclosure of an “integrated user interface,” see Pet. at 72, 75, they do not disclose an “integrated user interface” as claimed in the ‘839 patent. First, the interface in Kang is not unitary. EX2001, ¶ 156-157. Rather, Kang is clear that in order to transmit an

email message, a different interface is required than what is used to transmit an instant message:

FIG. 7

New Mail

To	0191234567
CC	
Attached	
Title	

Warning!
Can't send through e-mail service
Change to New Memo for SMS
ok

Send Cancel

1	2	3	4	5	6	7	8	9	0
Q	W	E	R	T	Y	U	I	O	P
A	S	D	F	G	H	J	K	L	;
Z	X	C	V	B	N	M	,	.	/
Close	°i	A	12	@	▽△	←			

FIG. 8

801

✉ New Memo									
To	dino211@mailserver.com								
From									
Send Cancel									
1	2	3	4	5	6	7	8	9	0
Q	W	E	R	T	Y	U	I	O	P
A	S	D	F	G	H	J	K	L	;
Z	X	C	V	B	N	M	,	.	/
Close	°i	A	12	@	▽△	⬅			

Second, the user interface of Kang is not instant-messenger like. When a user is composing a message, in both SMTP and SMS format, the message is structured as though the user were sending an email. See Figs. 7-8. The interface shown in Fig. 4 and Fig. 5 of Kang is also not instant messenger-like. Rather, it is structured along the same lines as an email inbox, with the ability to sort messages by name, date/time and type.

FIG. 4

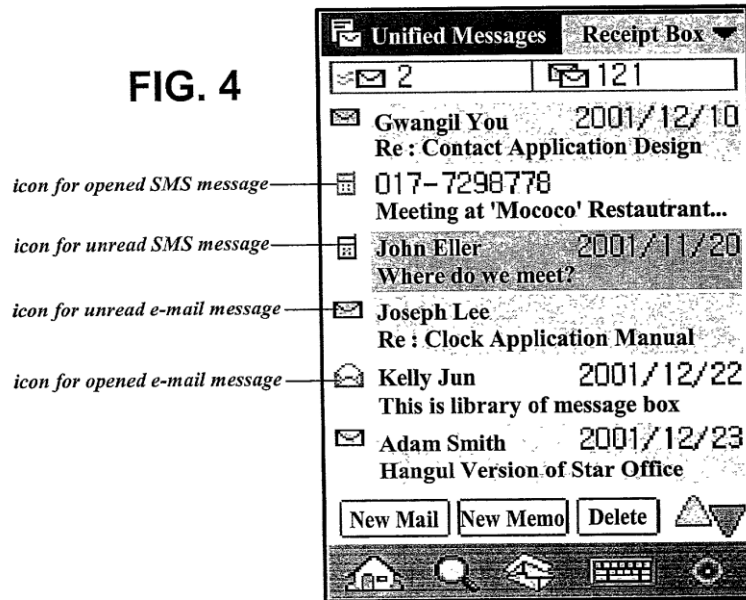
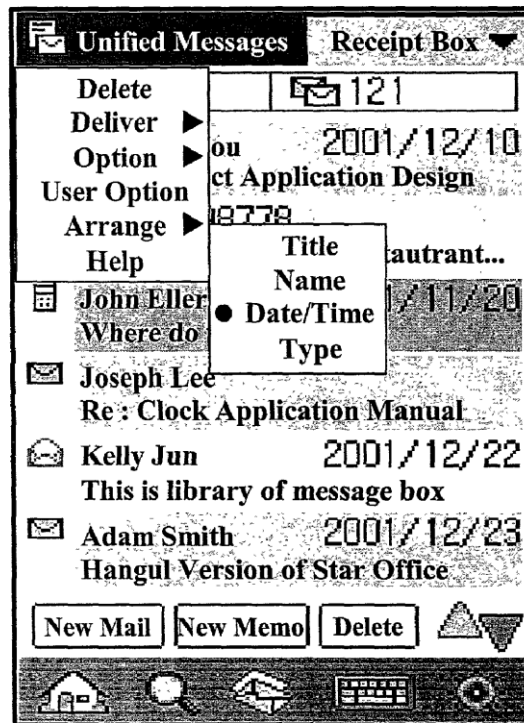


FIG. 5



EX2001, ¶ 158-159.

(b) The Proposed Combination of Maguire and Kang Would Not Meet The “Determining a Message Kind of the Message to be Transmitted Which is Inputted in the IUI” Limitation

As shown in section IV.C., *supra*, a POSITA would understand the limitation “determining a message kind of the message to be transmitted which is inputted in the IUI” recited in claims 1 and 2 of the '839 patent means “determining whether or not a multimedia file is included in the message to be transmitted which is inputted in the IUI.” Furthermore, as shown in Section IV.A., *supra*, a POSITA would understand the term “IUI” to mean “a single, unitary instant messenger-like interface for transmitting/receiving text and multimedia messages, where an instant messenger-like interface is a single interface that displays an input window for composing an outgoing message to a recipient as well as transmitted and received messages to/from the recipient in transmitted/received order.”

As detailed below, Maguire in view of Kang fails to meet this claim limitation because the proposed combination wouldn't include a controller that determines a message kind of the message to be transmitted that is inputted in an IUI, much less based on whether or not a multimedia file is included in the message to be transmitted. EX2001, ¶ 161-168. First, Maguire fails to disclose an IUI (that is, a single, unitary integrated user interface for text messages and multimedia messages that displays an input window to compose an outgoing

message as well as transmitted and received messages to/from the recipient in transmitted/received order). EX2001, ¶ 162. Second, there is no disclosure in Maguire of a controller determining a message type of an outgoing message “to be transmitted.” EX2001, ¶ 163. Third, there is no disclosure in Maguire of a controller determining a message type based on whether a multimedia file is included in a message to be transmitted. EX2001, ¶ 164.

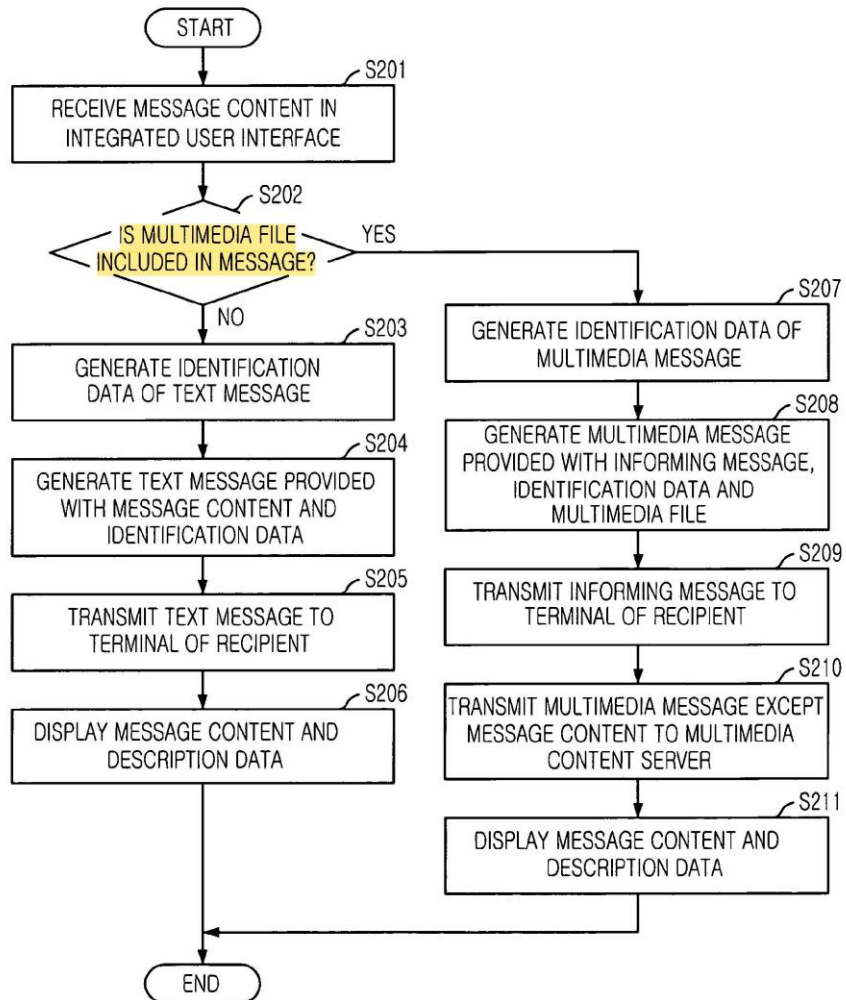
Petitioner admits Maguire “does not require a particular input mechanism for messages, or specify a particular way of determining an outgoing message type” and “leaves it to a POSITA to determine how to input a message and select the message type used for transmitting outgoing messages.” Pet. at 52 and 53. Petitioner instead relies on Kang for “additional teachings of a streamlined interface for inputting messages that includes a “message type checking unit” and “converting unit.” Pet. at 53. However, Kang fails to remedy the deficiencies of Maguire because Kang also fails to disclose: an IUI (*see* Section V.A.2.(a)., *supra*); a controller that determines a message type of an outgoing message to be transmitted which is inputted in the IUI; and a controller determining a message type based on whether or not a multimedia file is included in an outgoing message to be transmitted. EX2001, ¶ 166-168.

Accordingly, the proposed combination of Maguire and Kang fails to render claims 1 and 2 of the patent unpatentable.

i. The Proposed Combination of Maguire and Kang Doesn't Determine Message Kind of a Message to be Transmitted Which is Inputted in an IUI

As noted previously, claims 1 and 2 don't merely recite "determining a message kind"—they require the controller to determine message kind "*of a message to be transmitted which is inputted in the IUI.*" In other words, the determination of message kind by the controller is based on a message that is inputted in an IUI. This is consistent with how the invention is described and shown in the '839 Patent. *See, e.g.*, EX1001, 3:40-49 ("... the controller 14 determines the message kind of an outgoing message based on whether a multimedia file is included in the message content or not ..."); 4:6-20 ("A message content of the outgoing message is inputted by a user in the IUI at step S201. ... The controller 14 determines the kind of a message according to whether a multimedia file is included in the message content or not at step 202."); *see also* FIG. 2 (reproduced below).

FIG. 2



EX1001, Fig. 2 (Steps S201 and S202).

Neither Maguire nor Kang discloses an IUI (that is, a single, unitary integrated user interface for text messages and multimedia messages that displays an input window to compose an outgoing message as well as transmitted and

received messages to/from the recipient in transmitted/received order). See Section V.A.2.(a), *supra*; EX2001, ¶ 170.

The Petition fails to cite to any portion of Maguire that discloses inputting a message in the interface 124 that Petitioner alleges to be an “IUI.” As reflected in its title, “User Interface And Method of **VIEWING** Unified Communications Events on a Mobile Device,” Maguire teaches an interface and method for *viewing* communication events. There is no teaching of inputting an outgoing message in the interface, much less determining a message kind of an outgoing message that is inputted in the interface. EX2001, ¶ 171. The Petition implies this limitation is met by Maguire but fails to provide a cite that is actually relevant. For example, in Maguire, cited paragraphs [0002]-[0004] discusses the field of the invention (generally “a user interface for messaging,” and more particularly “user interfaces for displaying a communications event in context with select stored communications events”), data services supported by cellular networks, and types of communication events; paragraphs [0012]-[0014] summarize aspects of the invention, including determining a communication event type of an event stored in a database; controlling a user interface to allow a user to ignore or answer a telephone call, read or ignore an email or SMS message; a mobile device having a user interface and a transceiver for transmitting and receiving communications events; a communications event type identifier for identifying a type of event from

a list; and displaying a retrieved communication event history; paragraphs [0019]-[0020] discuss a user interface through which a user can view communications events with a particular correspondent through use of a communications event database; paragraphs [0021] and [0022] discuss a method of receiving a communications event from a correspondent; paragraph [0026] discusses the communications event database and how the interface displays communication events; paragraphs [0029]-[0030] discuss the transceiver and the display; paragraphs [0035]-[0036] discuss interactions between the mobile device and the communications event database, database structure, and displaying database query results; FIG. 3 shows a method of receiving a communications event and displaying a communications event history from a database; and FIG. 5 shows a mobile device with a communications event database and a display used to provide a user interface for displaying information about communications events between the mobile device and a correspondent. EX2001, ¶ 172. None of these portions of Maguire teach or suggest inputting a message to be transmitted in the interface alleged by Petitioner to be an IUI. Petitioner admits as much in its discussion of motivation to modify Maguire in view of Kang. Pet. at 52 and 53.

Kang fails to remedy the deficiencies of Maguire. EX2001, ¶¶ 173-183. First, Kang does not disclose an IUI as claimed. See Section V.A.2.(a). It

discloses a unified receipt box that displays several types of messages together in a single window. *See, e.g.*, EX1008, ¶ [0002], FIGS. 2, 4, and 5; EX2001, ¶ 173.

In fact, nowhere in the Petition does Petitioner allege Kang discloses an IUI as claimed. *See* Pet. at 50-54 and 59-62. Petitioner instead relies on Kang “for its teachings of a well-understood input module (including, e.g., a keypad and inputs for menu selection) 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. More particularly, Petitioner relies on Kang for “additional teachings of a streamlined interface for inputting messages that includes a ‘message type checking unit’ and ‘converting unit’ that allows the user to input different types of messages in a single interface while advantageously avoiding the need to ‘choose a message input screen’ by automatically selecting a message type before transmission.” Pet. at 53-54. Petitioner cites to paragraphs [0011], [0012], [0040], [0041], [0042], [0046], [0050], [0059], [0061] and FIGS. 1, 6a, 6b, 7, and 9-10 of Kang as support. Pet. at 50-54 and 78-83. However, in the cited portions of Kang (other than arguably the embodiment shown in FIG. 10 and described at ¶¶ [0059] and [0061]), message kind is actually determined by the user—not a controller, as claimed. EX2001, ¶ 174-175.

For example, if the user selects “New Mail” in the Receipt Box illustrated in FIGS. 4 and 5 (step S41 in FIG. 6a), the system (i.e., alleged controller) in Kang provides a new mail screen (step S42 in FIG. 6a; FIG. 7). EX1008, FIGS. 4, 5, 6a, [0040]; EX2001, ¶ 176. Likewise, if the user selects “New Memo” (step S60 in FIG. 6b), the system provides a new memo screen (step S61 in FIG. 6b; FIG. 8). EX1008, FIG. 6b, [0045]; EX2001, ¶ 177. After the user requests transmission (step S44 in FIG. 6a; step S63 in FIG. 6b), the system checks the message to see if it is compatible with the message kind selected by the user (steps S45, S46, and S50 in FIG. 6a; S64, S65, and S70 in FIG. 6b) and, if not, outputs a warning window informing the user of impossible message delivery and asking the user to select a suitable delivery manner (step S51 in FIG. 6a; step S71 in FIG. 6b). EX1008, [0041]-[0042], [0046]-[0047]; EX2001, ¶ 178. If a warning is generated, the user may select a suitable delivery manner. If there is no warning, the message is sent using the protocol originally selected by the user (step S47 in FIG. 6a; step S66 in FIG. 6b). *Id.* Nowhere in the cited portions of Maguire is there a teaching or suggestion the controller determines a message kind of the message to be transmitted. EX2001, ¶ 179.

Furthermore, in the embodiment shown FIG. 10 and described in ¶¶[0059] and [0061] of Kang, the controlling unit 26 “outputs an input window demanding *only information of a recipient* (S80) first when a user requests for a new

message.” EX1008, [0059](emphasis added); EX2001, ¶ 180. After the user enters the recipient data, the message type checking unit 21 examines the entered data (S81) and “regards a message to write as SMS message when the entered data is composed of numeric digits, and as mail message when the entered data include the symbol of ‘@’ indicative of a mail account (S82).” EX1008, [0059]; EX2001, ¶ 181. The message type checking unit 21 notifies the controlling unit 26 of the message type, and the controlling unit provides either the “New Mail” screen of FIG. 7 if the type is email or the “New Memo” screen of FIG. 8 if the type is SMS. *Id.* “After the user completes the message by filling in necessary information as well as a body message in field of the message input screen (S84, S89),” the user may request transmission of the message. EX1008, [0060]; EX2001, ¶ 181. A POSITA reading ¶¶[0059] and [0061] in conjunction with ¶[0060] and FIG. 7, would immediately understand the “window demanding only information of a recipient” receives either a recipient’s phone number or email inputted by the user (step S80)—not the message itself (which is not entered by the user until step S84 or S89). EX2001, ¶ 182. Therefore, any determination of message kind performed by the message type checking unit is not based on the message to be transmitted which is inputted in the IUI, as required in the claims.³ *Id.*

³ A POSITA would also rightfully conclude that the message type checking unit of Maguire cannot be the claimed controller because it is clear from Maguire that the

In summary, Petitioner has not cited to any portion of Maguire or Kang teaches or suggests a controller determining a message kind of the message to be transmitted which is inputted in the IUI. For at least this reason, Petitioner has failed to show by a preponderance of evidence Maguire and Kang render claims 1 and 2 obvious.

ii. The Proposed Combination of Maguire and Kang Doesn't Determine Message Kind Based on Whether or Not a Multimedia Message is Included in the Message to be Transmitted

As shown in Section IV.B., *supra*, a POSITA would construe the limitation “determining a message kind of the message to be transmitted which is inputted in the IUI” to mean “determining whether or not a multimedia file is included in the message to be transmitted which is inputted in the IUI.”

Since, as admitted by Petitioner, Maguire “does not . . . specify a particular way of determining an outgoing message type” and “leaves it to a POSITA to determine how to . . . select the message type used for transmitting outgoing messages,” Pet. at 52 and 53, there is no dispute Maguire fails to teach determining a message kind by “determining whether or not a multimedia file in

message type checking unit does not perform all the functions of the claimed controller, such as “providing the IUI to the keypad . . .,” “generating an outgoing message . . .,” “transmitting the outgoing message,” “displaying the message content and the description data of the outgoing message in the IUI,” etc. EX2001, ¶ 183.

included in the message to be transmitted which is inputted in the IUI.” EX2001, ¶ 185.

With regard to Kang, none of the examples cited by Petitioner disclose message kind being determined based on whether or not a multimedia file is included in the message to be transmitted. Pet. at 52-54 and 78-83 (citing EX1008, Abstract, FIGS. 6a-6b, 7, [0011]-[0012], [0026], [0040]-[0043], [0046]-[0048], [0050], [0051], [0059]-[0061], claims 9, 13, 16, 20EX2001, ¶ 186.

In fact, Kang only discusses transmitting and receiving text messages and email. *See, e.g.*, EX1008, Abstract; EX2001, ¶ 187. Text messages contain only text; and, as shown in Section IV.B., *supra*, a POSITA would not consider email to be a multimedia message in the context of the '839 patent. Even assuming email was a type of multimedia message (which it is not), there is no disclosure in Kang of determining message kind based on whether or not a multimedia file is included in a message to be transmitted. To the contrary, the type of message to be transmitted in Kang is either determined by the user or based on an address (i.e., phone number or email address) for the recipient. EX2001, ¶ 188.

In summary, Petitioner has not cited to any portion of Maguire or Kang that teaches or suggests determining a message kind of a message to be transmitted which is inputted in the IUI. For at least these reasons, Petitioner has failed to

show by a preponderance of evidence the proposed combination of Maguire and Kang renders claims 1 and 2 obvious.

c) The Proposed Combination of Maguire and Kange Does Not Disclose The “Transmitting The Outgoing Message” Limitation

As shown in Section IV.C. *supra*, a POSITA would understand the limitation “transmitting the outgoing message” recited in claims 1 and 2 of the '839 patent means “transmitting the outgoing message without changing the transmission protocol or network of the message.” Maguire fails to disclose this limitation. EX2001, ¶¶ 189-192. There is no discussion in Maguire of transmitting an outgoing message via its interface, much less transmitting an outgoing message without changing the transmission protocol or network of the message. EX2001, ¶ 190. The Petition implies this limitation is met by Maguire but fails to provide a cite that is actually relevant. EX2001, ¶ 191. In fact, none of the cited portions of Maguire teach or suggest transmitting an outgoing message without changing the transmission protocol or network of the message.

Kang does not remedy the deficiencies of Maguire. EX2001, ¶ 192. Petitioner does not allege Kang discloses this limitation. Pet. at 84. Further, Kang affirmatively fails to disclose this limitation. *Id.*

3. Lemay (Alone or in Combination with Alfke) in View of RFC2822 Does Not Render Claims 1 and 2 Obvious

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

Patent Owner submits the Petition fails to show claims 1 and 2 are obvious over Lemay (alone or in combination with Alfke) and RFC2822, because RFC2822 does not remedy the deficiencies of Lemay and Alfke discussed above. EX2001, ¶ 193-199. Petitioner admits Lemay “leave[s] it to a POSITA how to derive such information [i.e., description data],” and cites to RFC2822 for providing “additional details disclosing that such information is part of the transmitted message.” Pet. at 92. However, Petitioner admits RFC2822 “teaches a standardized format for messages carrying ‘*electronic mail*’” (emphasis added). *Id.* That is, RFC2822 teaches how to format email. EX2001, ¶ 196-199. That may or may not be relevant once a determination is made to send an email, but it has no bearing on whether or not it would be obvious to modify Lemay to determine a message kind of an outgoing message inputted in the integrated user interface, as required by the claims. Further, as explained above (*see* Section V.A. *supra*), Lemay (whether alone or in combination with Alfke) does not disclose “transmitting an outgoing message” or an “integrated user interface.” EX2001, ¶¶

91-120, 140-149. RFC2822 does nothing to cure these deficiencies, and Petitioners do not allege either is disclosed in the reference. EX2001, ¶ 195.

Further, a POSITA, upon reading RFC2822, would be taught away from combining RFC2822 with Lemay. EX2001, ¶¶ 197-199. The '839 patent discloses “an object of the present invention to provide a wireless communication terminal and a method for transmitting and receiving different kinds of messages, e.g., a text and a multimedia message in an integrated user interface...”. EX1001, 1:55-59. But RFC2822 is explicit: “This standard specifies a syntax only for text messages. In particular, *it makes no provision for the transmission of images, audio, or other sorts of structured data in electronic mail messages.*” EX1009, 3.

4. Maguire in View of Kang and RFC2822 Does Not Render Claims 1 and 2 Obvious

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

Patent Owner submits the Petition fails to show 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. EX2001, ¶¶ 200-206. Petitioner admits Maguire and Kang “leave it to a POSITA how to derive such information [i.e., description data],” and cites to RFC2822 for providing “additional details disclosing that such information is part of the transmitted

message.” Pet. at 92. However, Petitioner admits RFC2822 “teaches a standardized format for messages carrying ‘*electronic mail*’” (emphasis added). *Id.* As noted above, RFC2822 may or may not be relevant once a determination is made to send an email, but it has no bearing on whether or not it would be obvious to modify the combination of Maguire and Kang to determine a message kind of an outgoing message inputted in an integrated user interface, as required by the claims. Further, as explained above (see Section V.B.), the combination of Maguire and Kang do not disclose “transmitting an outgoing message” or an “integrated user interface.” EX2001, ¶ 150-159, 189-192. RFC2822 does nothing to cure these deficiencies, and Petitioners do not allege either is disclosed in the reference. EX2001, ¶ 202.

Further, a POSITA, upon reading RFC2822, would be taught away from combining RFC2822 with Maguire. EX2001, ¶¶ 204-206. The '839 patent discloses “an object of the present invention to provide a wireless communication terminal and a method for transmitting and receiving different kinds of messages, e.g., a text and a multimedia message in an integrated user interface...”. 1:55-59. But RFC2822 is explicit: “This standard specifies a syntax only for text messages. In particular, ***it makes no provision for the transmission of images, audio, or other sorts of structured data in electronic mail messages.***” EX1009 at 3.

VI. CONCLUSION

As Petitioner has failed to meet its burden of proof under 35 U.S.C. § 316(e), Patent Owner respectfully requests the Board find the challenged claims to be patentable for the reasons stated herein.

Dated: June 7, 2024

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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 Response complies with the type-volume limitation of 37 C.F.R. § 42.24(b)(1) because, exclusive of the exempted portions, it contains 13,950 words as counted by the word-processing system used to prepare the paper.

Dated: June 7, 2024

/Jason M. Shapiro/
Jason M. Shapiro, Reg. No. 35,354
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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was served electronically via electronic mail on June 7, 2024 on the following counsel of record for Petitioners:

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