

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS., INC
Petitioner

v.

PANTECH CORP.
Patent Owner

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

**DECLARATION OF Dr. EDWIN A. HERNANDEZ on behalf of PATENT
OWNER**

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IPR2023-01271
EX2001

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	QUALIFICATIONS	2
III.	MATERIALS CONSIDERED	9
IV.	LEGAL PRINCIPLES	11
V.	THE LEVEL OF ORDINARY SKILL IN THE ART	12
VI.	BACKGROUND	13
	A. The ‘839 Patent	13
	B. U.S. Pat. No. 8,020,105 (“Lemay”) (EX1005)	16
	C. U.S. Pat. No. 7,765,263 (“Alfke”) (EX1006)	19
	D. PCT Pub. No. WO 03/056789 (“Maguire”) (EX1007).....	19
	E. U.S. Pat. App. Pub. No. 2002/0152220 (“Kang”) (EX1008)	20
	F. Network Working Group, Internet Engineering Task Force (IETF) Request for Comments (RFC): 2822, Internet Message Format (2001) (“RFC2822”) (EX1009).....	23
VII.	CONSTRUCTION OF THE ‘839 PATENT	24
	A. “Integrated User Interface”/”IUI”	24
	B. “Determining a Message kind of the message to be transmitted which is inputted in the IUI”	28
	C. “Transmitting the Outgoing Message”	35
VIII.	LG’s Petition Fails to Establish that Claims 1,2 are Obvious	36
	A. Lemay and/or Alfke does not render the ‘839 Patent Anticipated or Obvious.	36
	1. Lemay and/or Alfke Do Not Disclose an “Integrated User Interface”	36
	2. The User Interface in Lemay Does Not Display Text Messages and Multimedia Messages in Transmitted/Received Order	48
	3. Lemay Does Not Disclose “Determining a Message Kind of The Message to be Transmitted Which is Inputted in The IUI”	57

4.	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	66
5.	Lemay Does Not Disclose "Transmitting the Outgoing Message"	70
B.	The Combination of Maguire and Kang Does Not Render The Challenged Claims Obvious.....	75
1.	The Proposed Combination of Maguire and Kang Would Not Meet The "Integrated User Interface (IUI)" Limitation	75
2.	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	81
3.	The Proposed Combination of Maguire and Kang Doesn't Determine Message Kind of a Message to be Transmitted Which is Inputted in an IUI.....	83
4.	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.....	89
5.	The Proposed Combination of Maguire and Kang Does Not Disclose The "Transmitting The Outgoing Message" Limitation	92
C.	Lemay (Alone or in Combination with Alfke) in View of RFC2822 Does Not Render The Challenged Claims Obvious.....	93
D.	The Combination of Maguire, Kang, and RFC2822 Do Not Render The Challenged Claims Obvious.....	95

TABLE OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 7,283,839
1003	Declaration of Dr. Vijay Madiseti
1005	U.S. Patent No. 8,020,105 (Lemay)
1006	U.S. Patent No. 7,765,263 (Alfke)
1007	WO 03/056789 (Maguire)
1008	U.S. Appl. No. 2002/015220 (Kang)
1009	RFC 2822: Internet Message Format
2002	Deposition Transcript of Dr. Vijay Madiseti dated May 21, 2024
2003	RFC 2821: Simple Mail Transfer Protocol, April 2001
2004	ETSI ES 202 314-4 V1.1.2 (2005-03): 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 T-Mobile 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 T-Mobile 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

1. My name is Dr. Edwin A. Hernandez. I have been retained by PANTECH Corporation, which I may refer to as either the “Patent Owner” or “PANTECH,” for this inter partes review proceeding, which I may refer to as “this IPR” or “the IPR.” I understand that this IPR involves U.S. Patent No. 7,283,839 (EX1001), which I may refer to as “the ‘839 patent” for shorthand. I understand that the claims challenged in this IPR are claims 1 and 2 of the ‘839 patent.

2. I understand that the ‘839 patent is assigned to PANTECH.

3. I understand that in this proceeding LG Electronics, Inc., which I may also refer to collectively as the “Petitioner” or “LG,” filed a Petition for review of Claims 1 and 2 of the ‘839 patent.

4. I understand that the above claims are challenged by Petitioner based upon anticipation and/or obviousness over the following references:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2	102(e) ³	Lemay
1, 2	103(a)	Lemay
1, 2	103(a)	Maguire, Kang
1, 2	103(a)	Lemay, RFC 2822
1, 2	103(a)	Maguire, Kang, RFC 2822

5. I have been asked to provide my objective, independent analysis of the ‘839 patent in view of the asserted prior art references and other documents cited in

the Petition and to provide my opinion regarding the allegations in the Petition, as well as the supporting opinions of Dr. Vijay Madisetti (EX1003).

6. I am not currently, nor have I ever been, an employee of Pantech. I received no compensation for this declaration beyond my normal hourly compensation of \$425 based on my time actually spent analyzing the '839 patent, the asserted prior art references cited herein and in the Petition, and any related issues. I will not receive any added compensation based on the outcome of this IPR, any other IPR, or any other proceeding involving the '839 patent.

7. Based upon the materials that I have considered, and the arguments made by Petitioner and Dr. Madisetti, as explained below it is my opinion that Petitioner has failed to meet its burden to show that any challenged claim of the '839 Patent is unpatentable.

II. QUALIFICATIONS

8. My general qualifications can be found in my curriculum vitae attached as Appendix A. It includes my educational and professional background, published books, articles, publications, public lectures and conference proceedings. One section details my assignments testifying at depositions and trial as an expert witness.

9. I am an owner and founder of EGLA CORP, an intellectual property, engineering consulting, and startup accelerator incubator in the fields of a) Wireless Communications, 4G and 5G, b) Media Streaming, and c) Health technologies.

10. I have a Ph.D. in Computer Engineering in Mobile Computing in 2002, and received a B.S. from Costa Rica Institute of Technology in Electronics Engineering, and a M.S. in Electrical and Computer Engineering from the University of Florida.

11. I have been retained as an independent expert consultant in the fields of cable television systems and broadcasting, multimedia streaming, mobile devices and systems, air-interface and Long-Term Evolution (LTE), cloud storage and data synchronization, wireless communications, block-chain technology, power management, personal area networking, and smart phones and wireless embedded software development.

12. My experience in wireless communications, modulation, RF propagation models, and antenna engineering dates back to the 1990s, when I was a AX.25 radio node in from 1996 – 1997, working in civil band radio, VHF bands (140 MHz) and FSK (Frequency Shifting Keying) modulation.

13. I founded COMPUNET in 1997 and was its lead engineer from 1997 to 2009. While at COMPUNET, I was a lead developer for authentication services, security services, web services, and networking configuration services.

14. During this is the time I worked on my own HAM – AX.25 radio node in Tegucigalpa, Honduras. A network of about 10 nodes existed at the time that even communicated with an Internet gateway located at the ITU-Honduras office, including trying servers and protocols over UUCP, IRC, and many text-based interfaces that worked at a slow baud rates.

15. I worked for Microsoft from 2001 to 2003 as a Technical Program Manager. In that position, I was responsible for driving architecture, design, test automation, and security analysis for Bluetooth Personal Area Networking (PAN). I also drove testing over networking protocols, such as IPv4 networks and IPv6 networks, including early versions of 802.11b and candidates in the 2.4GHz bands that uses Frequency Hopping Spread spectrum.

16. As part of my PhD, I became an expert in RF system simulation, including propagation models, and selection of appropriate modulation techniques based on SNR (Signal to Noise Ratios) and other parameters experimented using 802.11b technologies and SISO Antennas.

17. I worked for Motorola, Inc. from 2003 to 2010 as a Principal Staff Software Engineer. In that position, I was responsible for application development for Google and Android platforms. I participated in kernel-level prototyping, data support, Multimedia Messaging (MMS) for Android, and digital rights management (DRM).

18. While at Motorola, I received training on RF system testing, RF modulation techniques, specially trained on mobile messaging technologies, and other air interfaces that were used by Motorola, namely iDEN, CDMA, and WIMAX. Additionally, at Motorola I was the technical lead and main developer for MMS application programming interface (API) for Android in 2009-2010, and participated as part of the team working on several Java specification requests (JSRs), including JSR-82, JSR-177, and JSR-120 for J2ME Devices around 2004-2008, and many other MIDP functions.

19. Additionally, I am very familiar with Wireless LANs RF modulation, and system testing, as I have been involved in this field since 2001. I am also very familiar with signal processing and included in both my Master's and PhD work the use of linear filters and a Kalman filter, and have worked with other signal processing techniques mostly in voice applications and signature mapping of music files with Mel-frequency Cepstral Coefficients (MFCC).

20. From 2009 to present time, I have been working with Software-defined Radios and GNU Radio-based systems including Ettus Research boxes, and recently with Blade RF in the creation of a Software & hardware LTE emulator based on the US Patent 7,231,330.

21. Starting in 2010, I founded EGLA CORP. There, I created MEVIA applications, such as Clout to Cable. MEVIA is a "software-as-a service" and a

cloud-based platform that enables “MEVIA Music,” which is currently in operation in several countries including Brazil, Honduras, and the United States.

22. Additionally, while at Motorola, Microsoft, and EGLA CORP, I have participated in design and development of User Interfaces for several applications.

- Microsoft Windows, User Interface for the Wireless Zero Configuration Service
- User Interfaces for external displays, mobile applications, and J2ME MIDP Interfaces while working with 3rd party application developers from MobiTV, TeleNAV, and other.
- At EGLA CORP assisted several startups and projects with Figma designs and other User Interface and User Experience projects for mobile applications.

23. MobileCAD also implements Software Defined Radios (e.g. GNU Radios) and can simulate or emulate a Base Station or even a client device using open source projects such as OpenBTS and Open-Air Interface projects. I am experienced interfacing BladeRF and HackRF to MacOS and upgrading GNU Radio to operate with Python 3.x. The tools aforementioned and others that can be implemented over GNU Radio, C/C++, Python, and others are fundamental parts of my mobile emulators where you can test and validate LTE protocols, modulation, and systems, either conductive or OTA.

24. In summary, MobileCAD can recreate a simulated drive test and validate protocol performance from Layer-2 to other upper layers and applies attenuation and simulated multi-path fading to one or several antennas.

25. Additionally, I worked as an advisor and researched the use of Big Data in simulation for a ray tracing to cover antenna reception, propagation of RF signals, and low- to high-frequency simulation, as well as have a better understating on multipath fading and signal-to-noise ratio.

26. I have worked with modulation and simulation at multiple and patent cases involving:

- Beamforming and Modulation
- Wireless Protocols
- LTE and Emulation
- IEEE 802.11 and Bluetooth

27. Additionally, over my career, my research has involved aspects of network security, wireless communications, network and communications reliability, artificial intelligence, multimedia streaming, and software engineering.

28. I am a named inventor on eleven patents issued by the United States Patent and Trademark Office, including the following:

- U.S. Patent No. 7,564,810 – Method and System for Managing Power Consumption of a Network Interface Module in a Wireless Computing Device

- U.S. Patent No. 7,231,330 – Rapid Mobility Network Emulator Method and System

- U.S. Patent No. 7,697,508 – System, Apparatus, and Method for Proactive Allocation of Wireless Communication Resources

- U.S. Patent No. 8,213,417 – System, Apparatus, and Method for Proactive Allocation of Wireless Communication Resources

- U.S. Patent No. 7,269,388 – Bluetooth PAN Driver

- U.S. Patent No. 8,788,715 – Rules-based Network Selection Across Multiple Media

- U.S. Patent No. 7,996,505 – Rules-based Network Selection Across Multiple Media

- U.S. Patent No. 8,024,487 – Smart Scan for Bluetooth PAN Services

- U.S. Patent No. 8,707,337 – Java-based Push to Talk

- U.S. Patent No. 7,331,793 – Magnetic Connector

- U.S. Patent No. 11,441,773 – Systems and Methods for Improved Biohazard Waste Destruction

- U.S. Patent No. 10,123,074, 10,524,002, 11,140,441 – Method, System, and Apparatus for Multimedia Content Delivery to Cable TV and Satellite Operators

29. I have assisted several IPRs and provided testimony on handover patents for LTE, IEEE 802.11 beamforming, Bluetooth, and other wireless technologies.

30. I have no financial interest in either party or in the outcome of this proceeding. I am being paid for my work as an expert in these matters on an hourly basis. My compensation is not dependent on the outcome of these proceedings or the content of my opinions. My opinions, as explained below, are based on my education, experience, and background in the fields discussed above, and my review of the '720 Patent and its file history, the materials provided by Patent Owner, and the other materials discussed herein.

31. For consistency and ease of review, all of my column and line citations to the patent specifications are in "column:line" format.

III. MATERIALS CONSIDERED

32. I have reviewed the '839 Patent, including the challenged claims, and its prosecution history. I have also reviewed the Petition for inter partes review filed by Petitioner, as well as EX1001-1060 attached. I have also reviewed the following documents as part of my analysis:

- Ex. 2002: May 21, 2024 Deposition of Vijay Madisetti
- Ex. 2003: RFC 2821: Simple Mail Transfer Protocol, dated April 2001

- Ex. 2004: ETSI ES 202 314-4 V1.1.2 (2005-03): 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
- Ex. 2005: Open Media Alliance, OMA-MMS-CTR-v1_2-20030916-C, “Multimedia Messaging Service Client Transactions,” Version 1.2, Candidate Version 16-Sept-2003
- Ex. 2006: AOL Instant Messenger T-Mobile Sidekick Chat dated January 18, 2004, available at http://web.archive.org/web/20040118024122/http://mymobile.aol.com:80/portal/aolmobilesvc/frame_pda.html
- Ex. 2007: AOL Instant Messenger T-Mobile Sidekick Chat dated January 18, 2004, available at http://web.archive.org/web/20040118024122/http://mymobile.aol.com:80/portal/aolmobilesvc/frame_pda.html

33. In forming my opinions, I have considered the materials listed above and any documents cited in this declaration. I have also relied on my own education, knowledge, and experience in the relevant art. I have also considered the understanding of a POSITA around the time of the invention of the ‘839 patent.

IV. LEGAL PRINCIPLES

34. I have been instructed that claims in an inter partes review are construed using the same claim construction standard as in a civil action, and that 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.

35. The POSITA is deemed to read the claim term in the context of the entire patent, including the specification and prosecution history.

36. I have been informed that a POSITA departs 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.

37. I have been informed that in order for a claim to be anticipated by a single reference, that reference must disclose, expressly or inherently, each and every element of the claim within the four corners of the reference itself, unless a document has been specifically incorporated by reference into that document. Further, the prior art reference must disclose each element as they are arranged in the claim. I have also been informed that a reference does not anticipate if a POSITA must combine the reference’s teachings with his own knowledge of the particular art in order to be in possession of the challenged claim.

38. I have been informed that in order for a claim to be rendered obvious by a single reference, or a combination of two or more references, the following factors must be considered: 1) the scope and content of the prior art; 2) the differences between the prior art and the claims at issue; 3) the level of ordinary skill in the art; and 4) any secondary considerations of non-obviousness. An obviousness determination cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

V. THE LEVEL OF ORDINARY SKILL IN THE ART

39. In my opinion, 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).

40. The ‘839 patent further states that one of its objects is “to provide an integrated user interface by using an integrated messaging service program in order to provide an easy and user-friendly interface without modifying a transmission protocol or network.” EX1001, 1:58-62. The ‘839 patent provides examples of user

interfaces (see EX1001, FIGS. 4A-4C). Thus, one of skill in the art would have had experience with user interfaces.

41. I am a person of ordinary skill in the art. As explained above, I have worked on Multimedia Messaging (MMS) for Android; have been specially trained on mobile messaging technologies; and participated in design and development of User Interfaces for several applications.

42. It is my understanding that Petitioner's expert, Dr. Madisetti, has opined that a 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 wireless communication terminals. EX1003, ¶ 45. I disagree with Dr. Madisetti's characterization that a POSITA would not be required to have experience with user interfaces because, as explained above, an object of the invention of the '839 patent is to provide an integrated, easy and user-friendly interface. EX1001, 1:58-62. However, my opinions herein apply equally regardless of which characterization of a person of ordinary skill in the art is used.

VI. BACKGROUND

A. The '839 Patent

43. The '839 patent is a novel mechanism to handle in a single interface and establish a "chat-like" interface for WAP-PUSH MMS message and SMS

messages that received by a mobile phone without requiring a user initiated “refresh” or any intervention. Text message and multimedia message are defined by 3GPP specifications, as shown in the EX1008, p. 11. The WAP Push architecture defines how the Wireless Session Protocol (WSP) which is connection-oriented handles messaging.

44. RFC 2821, “Simple Mail Transfer Protocol” specifies the basic protocol for Internet electronic mail transport at the time of the ‘839 patent.

45. WAP PUSH messages differ from SMTP or Simple Mail Transport Protocol, as SMTP work in a different way, as it is designed to write to an “Inbox” and connects an SMTP Server with an @origin to another SMTP server where @destination resides. EX2003 at 12-13.

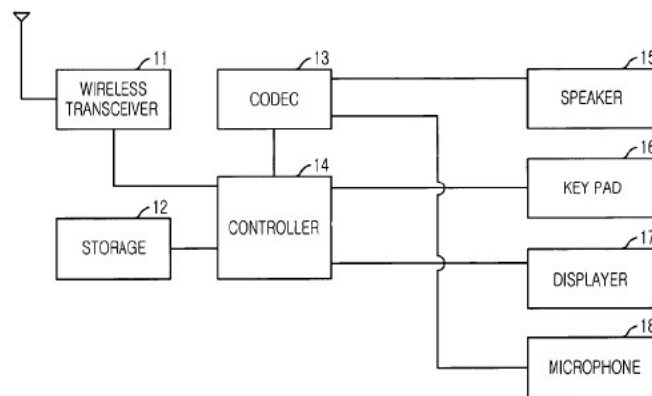
46. For example, if an email was composed and addressed to a recipient whose email address ended in “@gmail.com,” the SMTP protocol would connect the user’s computer with an SMTP server assigned to the @gmail.com domain, and send the email to that server. The email would remain on that server, until a client application that can retrieve mail, by, e.g., implementing POP or IMAP protocols, retrieves the contents of the mailbox for the specific user from the SMTP Server where the message resides.

47. In contrast, SMS and MMS are peer-to-peer, which means that, even if SMS and MMS messages are routed through intervening servers, they are ultimately pushed directly to the recipient.

48. Hence, SMS and MMS are peer-to-peer and use push messages that can only arrive over the wireless interface and occur from phone-to-phone, whereas SMTP or MAIL are server-based pull require Internet service (e.g. Packet Data) or WIFI access for those mobile terminals with WIFI.

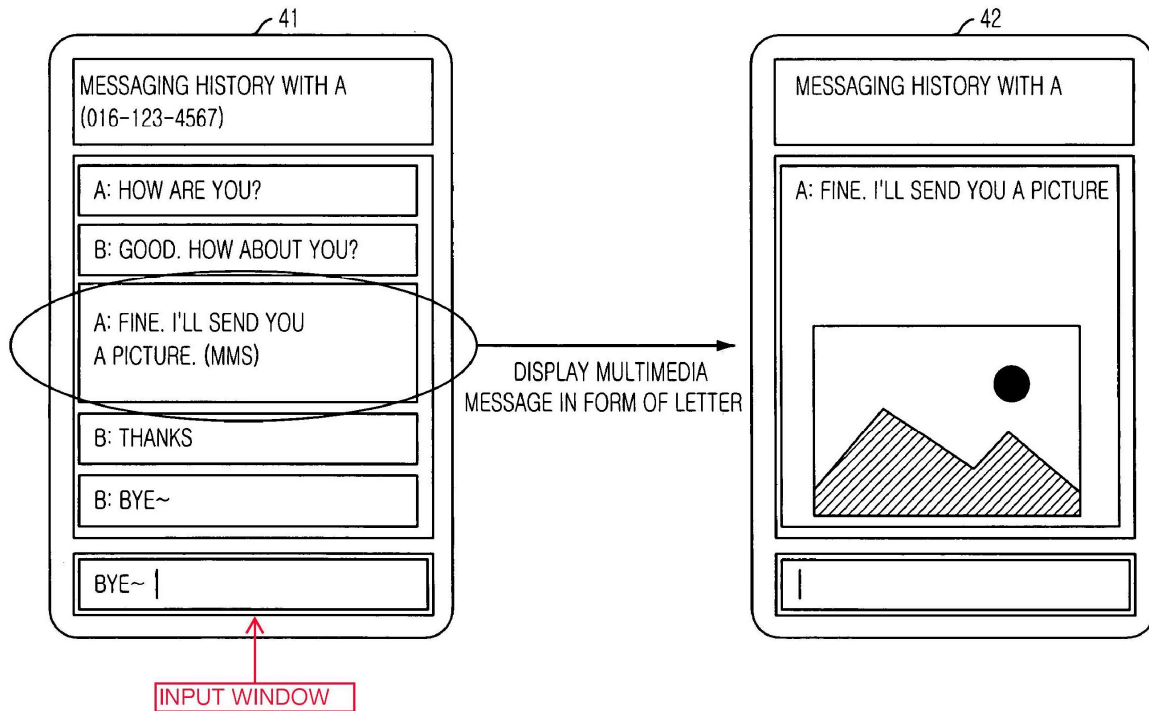
49. Therefore, FIG 1 of the '839 patent depicts element 11 or “Wireless Transceiver,” that handles the reception and transmittal of SMS and MMS messages.

FIG. 1



50. Similarly, FIG 4B shows communication between users A and B and display WAP Push and SMS messages in a unified interface and how the interface is updated when a MMS message containing the picture.

FIG. 4B



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

51. Lemay describes “a unified user interface for instant messaging and email.” EX1005, at 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 at 5:29-30. Instant messaging content and email content are displayed in separate panes or in separate windows :

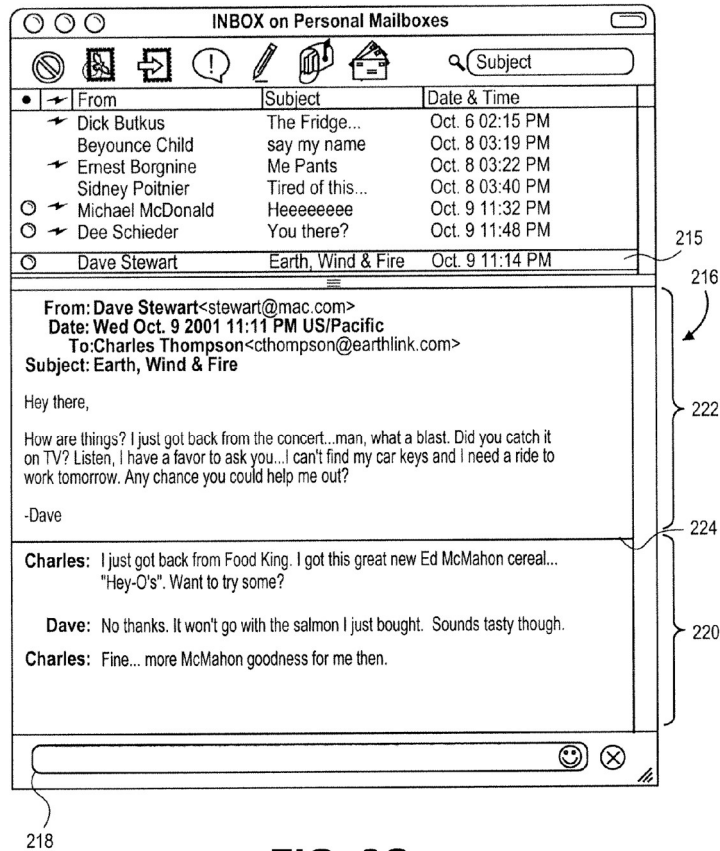


FIG. 2C

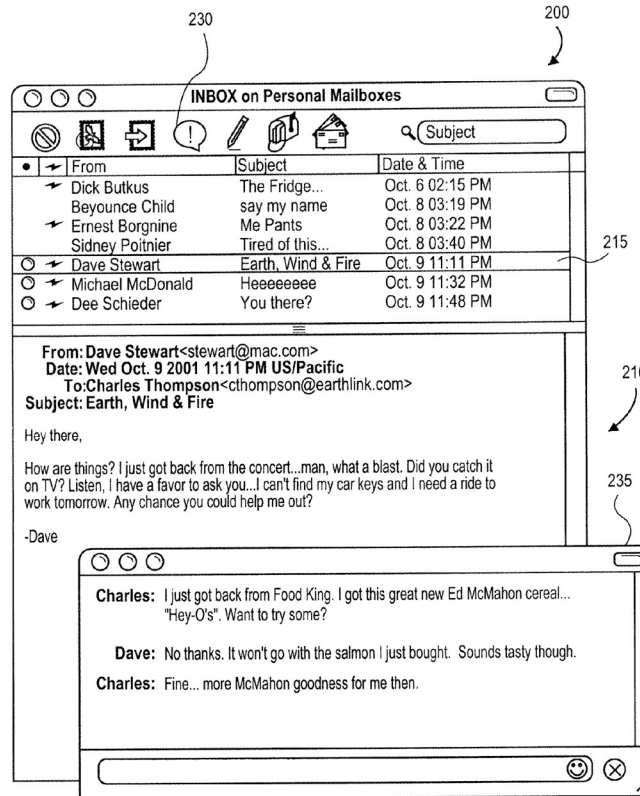


FIG. 2D

FIG. 2C at 220 and 222; FIG. 2D at 235 and 216). *See also* EX1005, 6:65–7:9, 7:53–56.

52. 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 at 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 at 6:2-5, 6:30-34, 10:16-41.

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

53. Alfke relates to a method and apparatus for processing electronic messages. EX1006 at 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 at 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.

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

54. 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 at Abstract. The mobile device may also include a transceiver, a processor, and a display. EX1007 at [0025]. The transceiver is used to both transmit and receive communications events. EX1007 at [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):

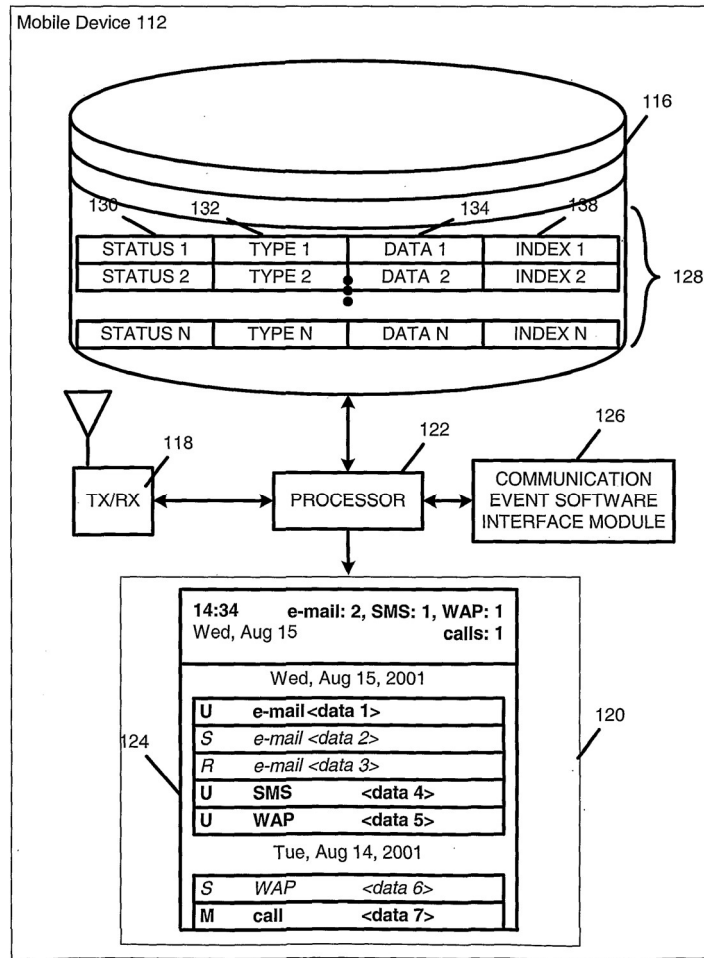


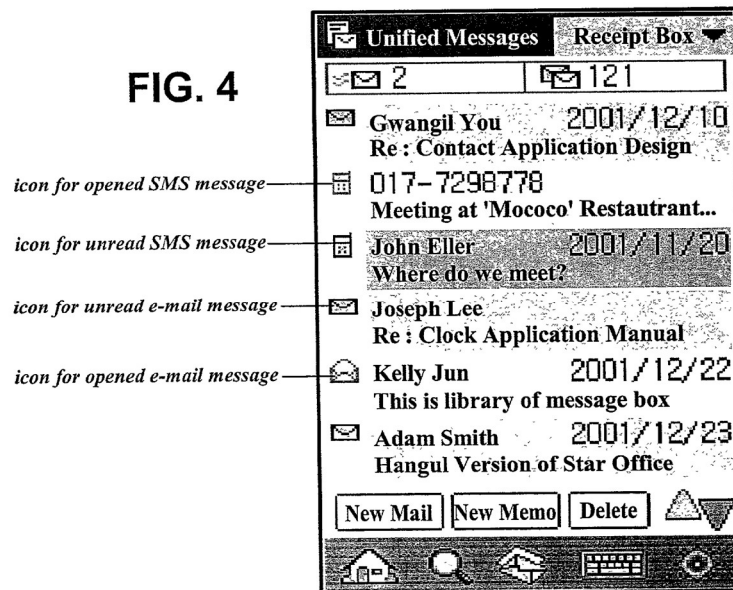
Figure 5

55. “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.

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

56. 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 at 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 at [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):



57. 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].

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. Reference numerals 701, 710, and 711 point to the dialog box, the 'ok' button, and the 'Send' button respectively.

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	@	▽△	⬅			

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

FIG. 8

801

New Memo										
To		dino211@mailserver.com								
From										
[Text Area]										
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	⌂	A	12	@	▽	△	[Arrow]			

59. 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], [0046]-[0047]. If a warning is generated, the user may select a suitable delivery manner. EX1008, [0047]-[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].

F. Network Working Group, Internet Engineering Task Force (IETF) Request for Comments (RFC): 2822, Internet Message

Format (2001) (“RFC2822) (EX1009)

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

VII. CONSTRUCTION OF THE ‘839 PATENT

A. “Integrated User Interface”/”IUI”

61. Based on my analysis of the ‘839 patent, a POSITA examining the claims of the ‘839 patent would understand the phrase “integrated user interface” and its abbreviation “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.

62. The ‘839 Patent describes “the present invention” as an instant messenger-like interface for multimedia messaging service (MMS) messages. EX1001 at 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.”).

63. Instant messaging, also known as “chatting,” is the real-time exchange of messages between two or more users.

64. 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 at 38:5-18), were known to have such an interface for transmitting and receiving text messages.

65. For example, I am familiar with AOL’s Instant Messenger, cited by Dr. Madisetti as an example of an instant messaging program at his deposition. As can be seen below, AOL Instant Messenger possessed an interface in which instant messages to and from an individual that were text-based were displayed in the order in which they were transmitted and received.



EX2006-2007.

66. 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.

67. 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.

68. 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 at 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 ‘839 patent, 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 to a POSITA that the inventor did not intend an “integrated user interface” to encompass such interfaces.

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

69. Based on my analysis of the ‘839 patent, a POSITA examining the claims of the ‘839 patent would understand the phrase “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.”

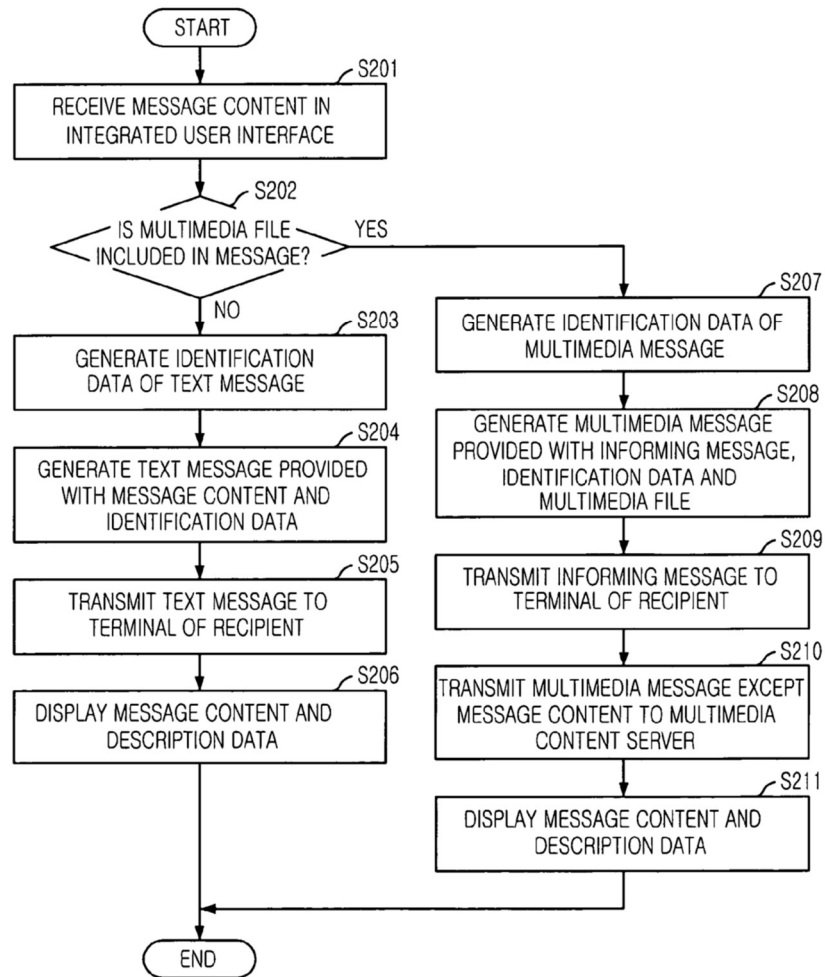
70. The ‘839 Patent describes “the present invention” as a wireless communication terminal with an integrated user interface for transmitting and receiving messages of various kinds. EX1001 at 7:31-34 (“[t]he present invention provides an integrated user interface for transmitting/receiving *diverse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

messages through one integrated user interface by using an integrated messaging service program.”)(emphasis added); EX1001 at 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.”).

71. The ‘839 Patent further describes “the present invention” as an instant messenger-like interface for multimedia messages. EX1001 at 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).

72. The ‘839 patent does not describe any integrated user interface that transmits or receives only one kind of message, and a POSITA would have recognized that the inventors of the ‘839 patent did not consider an integrated user interface that transmitted or received a single type of message to be part of their invention.

73. Such an understanding is also consistent with the Detailed Description of the Invention of the '839 Patent, in which the preferred embodiment is described as determining a message kind of an outgoing message inputted in the IUI based on whether a multimedia file is included in the inputted message. *See, e.g.,* EX1001 at 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 at 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 include only texts, 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).



74. Since the integrated user interface 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), and since the claimed wireless communication device generates the outgoing message after message content is inputted in the IUI and message kind is determined,¹ a POSITA would further understand that the determination of message kind must be based on the

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

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).

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

76. I disagree with the position Dr. Madisetti took at his deposition that a multimedia message “. . . can be something like an email message or it could be an MMS message, as an example,” EX2002 at 16:9-21, and that “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 at 18:2-8.

77. The ‘839 patent is clear that a multimedia message is a message transmitted or received using a multimedia messaging service. Multimedia messages may contain a notification message (which can be sent using the same protocol as a text message) and a multimedia file. For example, when describing the problems in the prior art that the invention is intended to solve, the ‘839 patent explains that “[r]ecently, the mobile terminal is provided with *a multimedia message transceiving service* including text data, voice data, images, and moving pictures.” EX1001 at 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 at 7:41-46.

78. 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 wireless network that was developed by the Open Mobile Alliance in cooperation with the 3rd Generation Partnership Project (“3GPP”). EX2005; see also EX2004, p. 20, Section 8.2.4, p. 37.

79. According to the MMS standard, “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.” EX2005. A mobile terminal configured as an MMS client can exchange multimedia messages directly with a similarly configured mobile terminal over a wireless network. *Id.*

80. Furthermore, according to the specification, when an MMS message was sent, a mobile terminal received the MMS notification message as a push notification (e.g., via SMS). EX2005 at 36. When this MMS notification message was received by the mobile terminal, the mobile terminal could initiate a WAP gateway connection to download the content of the MMS message. *Id.* at 37

81. Because SMS and MMS notification messages were both sent via SMS, which pushes messages to the recipient, an instant messenger-like user interface showing transmitted/received 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.

82. Third, email is incompatible with the fundamental object of the invention—providing an instant messenger-like interface.

83. Email was a well-known and widely used technology at the time. Email is not transmitted/received over a wireless network using the MMS protocol. Instead, email is transmitted/received over the Internet using a protocol called SMTP, which stands for Simple Mail Transfer Protocol.

84. 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.

85. 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. This is consistent with the specification of the '839 patent, which never mentions the term "email."

86. For at least the above reasons, a POSITA would not have considered email a "multimedia message." 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.

C. "Transmitting the Outgoing Message"

87. Based on my analysis of the '839 patent, a POSITA examining the claims of the '839 patent would understand the phrase "transmitting the outgoing message" to mean "transmitting the outgoing message without changing the transmission protocol or the network of the message."

88. 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 at 4:22-25 ("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).

VIII. LG’S PETITION FAILS TO ESTABLISH THAT CLAIMS 1,2 ARE OBVIOUS

89. LG’s Petition includes four grounds as shown below.

Ground	References	Claims
1	Lemay	1, 2
2	Lemay	1,2
3	Maguire, Kang	1,2
4	Lemay, RFC 2822	1,2
5	Maguire, Kang, RFC 2822	1,2

90. It is my opinion that the Petition fails to show that any of the Grounds set forth by Petitioner render either claim 1 or 2 of the ‘839 patent unpatentable.

A. Lemay and/or Alfke does not render the ‘839 Patent Anticipated or Obvious.

1. Lemay and/or Alfke Do Not Disclose an “Integrated User Interface”

91. As explained in section VII.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 an 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.” Lemay fails to meet this claim limitation.

92. 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 text messages and email messages separately. For each of the embodiments of Lemay shown, email content is displayed in a separate pane or a separate window from the instant message content:

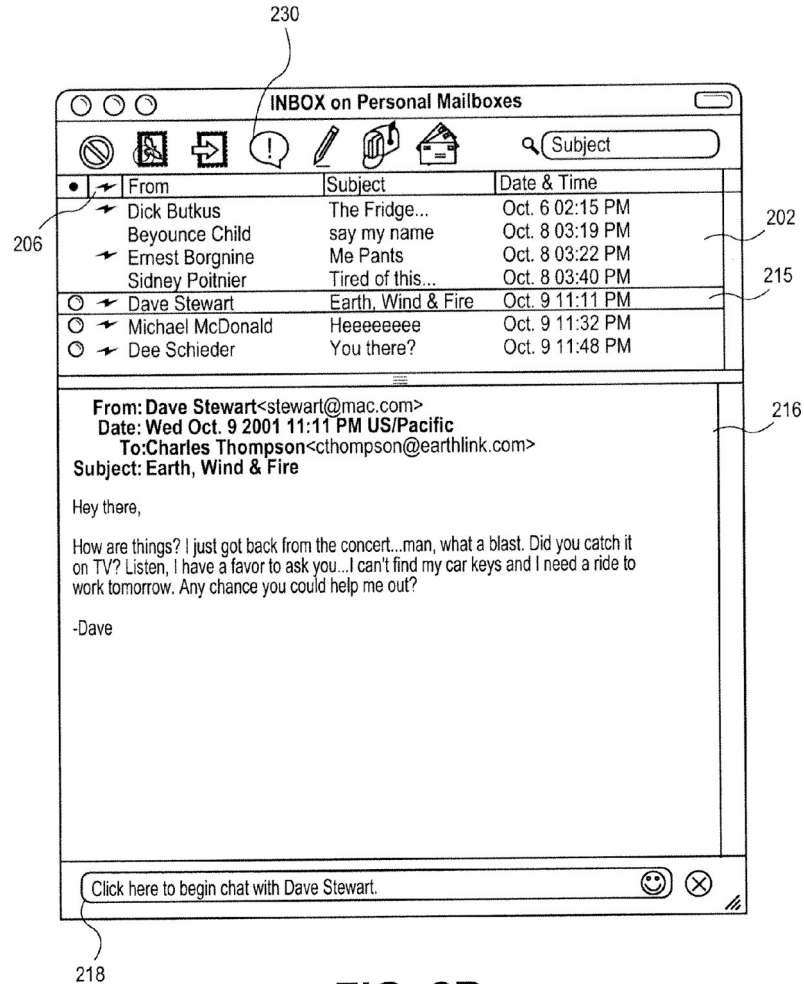


FIG. 2B

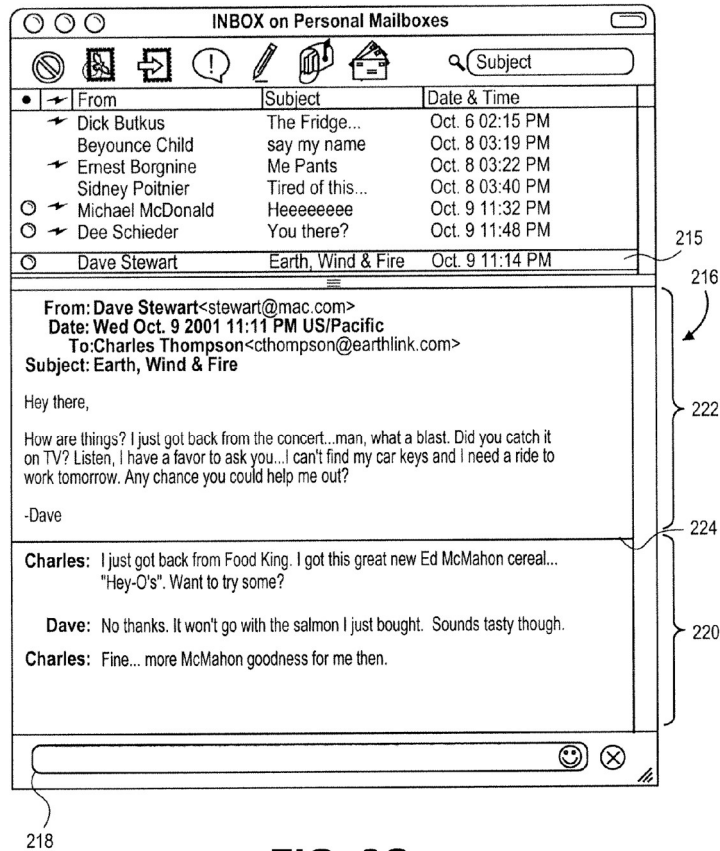


FIG. 2C

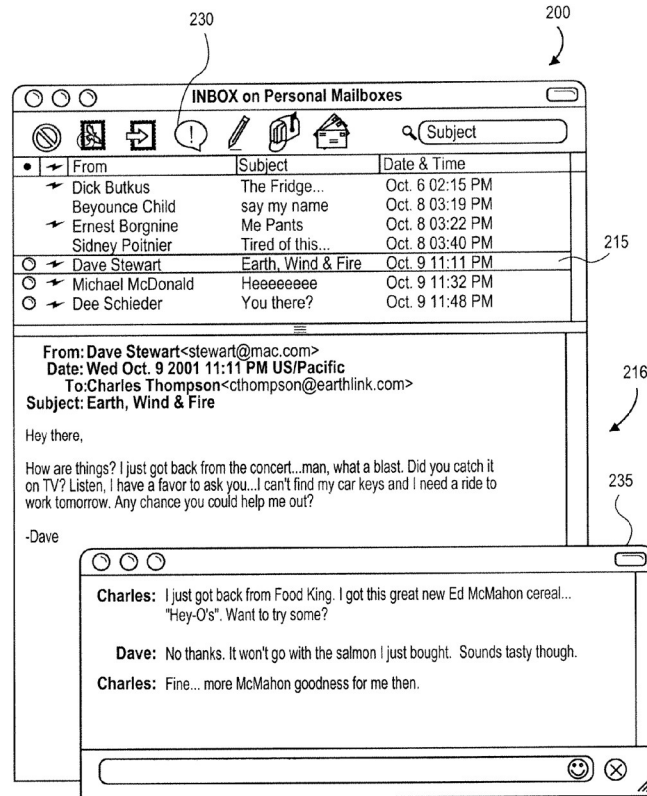


FIG. 2D

EX1005 at Figs. 2A-2D.

93. Further, Lemay does not disclose a unitary input window for inputting more than one type of message. Lemay discloses that input fields 218 and 420, which are the only methods of inputting a message disclosed in Lemay, are solely for instant messaging. 6:2-4 (“Input field 218 allows a user to initiate an instant messaging session with another user...”), 6:5-8 (“In one embodiment, input filed 218 appears in pane 216 when a user associated with a selected record is available for an instant messaging session.”), 6:17-20 (“In one embodiment, if the user associated

with the selected record in TOC 202 is offline or is otherwise not currently available for instant messaging, then input field 218 does not appear in pane 216.”), 6:34-39 (“In yet another embodiment, input field 218 includes an affordance, i.e., a visual clue to the function of the input field 218. For example, in the embodiment illustrated in FIG. 2B, when input field 218 appears a clue stating “Click here to begin chat...” appears to assist the user.”), 6:43-46 (“[I]nput field 218 may appear when a user receives an invitation to join an instant messaging session from another user. For example, if an invitation to instant message is accepted, input field 218 may appear in pane 216.”), 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...”). There is no disclosure in Lemay of the input field receiving email, or any messages other than instant messages.

94. I disagree with Dr. Madiseti’s statement 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 at 149:2-13. 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 at 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

95. Further, the interface disclosed by Lemay is not an instant messenger-like interface, but an email like interface. As shown in Figs. 2A-2D, Lemay discloses a standard email inbox, showing, e.g., a “From,” “Subject” and “To” line:

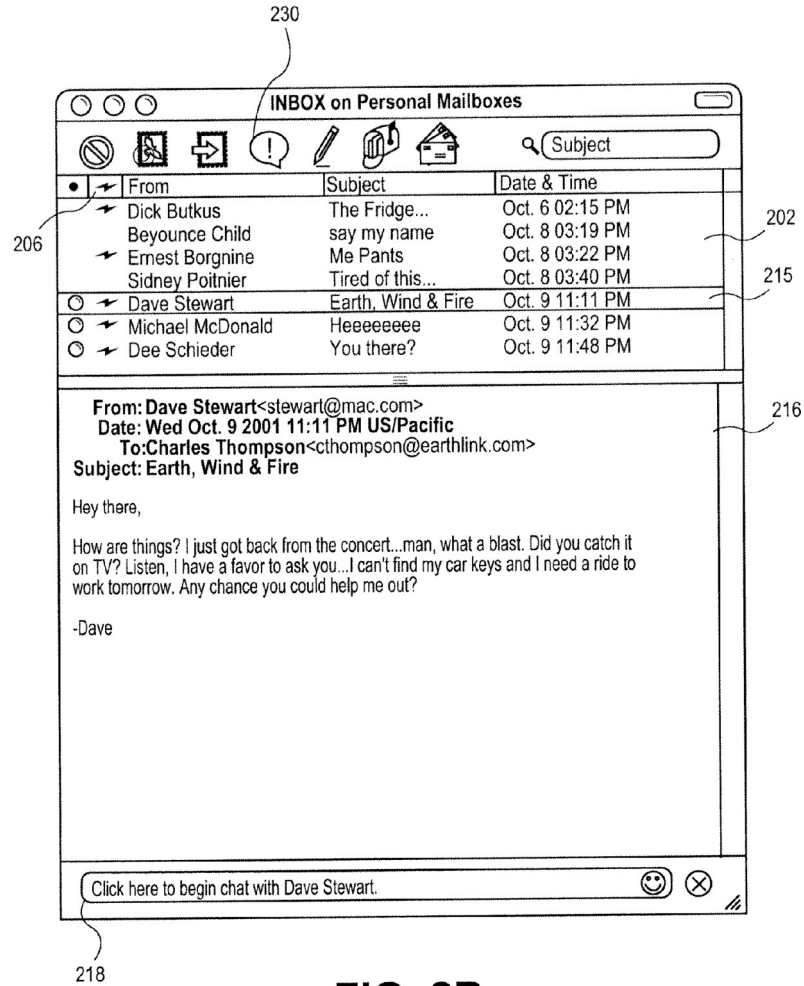


FIG. 2B

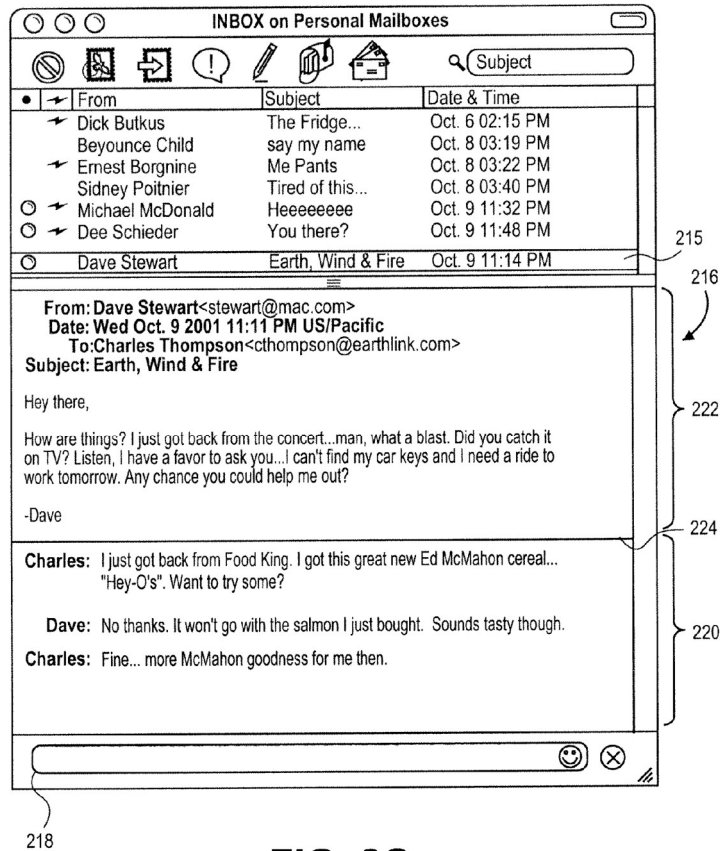


FIG. 2C

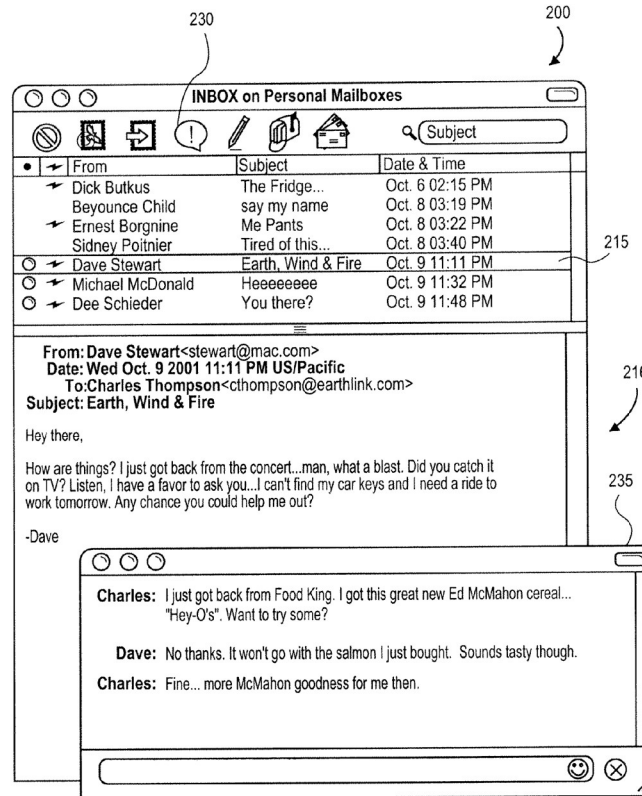


FIG. 2D

EX1005 at Figs. 2A-2D.

96. Further, the interface disclosed by Lemay is not an instant messenger-like interface, but an email like interface. As shown in Figs. 2A-2D, Lemay discloses a standard email inbox, showing, e.g., a “From,” “Subject” and “To” line. Moreover, FIG 2C depicts a standard inbox with two ways to update the screen:

- User initiated, by pressing a refresh button
- Or by a timer, where a refresh is issued via POP3 or IMAP.

97. By no means does Lemay disclose a WAP PUSH mechanism because, to join a messaging chat session, Lemay at 6:43-45 indicates that a user will receive an invitation to join a chat. What this means is that the interface shown will only be

able to receive an image or multimedia as an attachment to a message, but Lemay does not provide any embodiments or provides a way to handle emails as shown in '839 at FIG. 4B. In fact, Lemay actually fail to show 1(b) or “ a storage for storing an integrated messaging service program and messages in order to provide an integrated user interface (IUI);” Simply because, all email is stored in the remote mail server or a mailbox. Whereas the '839 patent needs to store the messages, SMS and MMS, as those are peer-to-peer.

98. 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 at 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).”). None of the citations to Lemay (or Alfke) in the Petition teach or suggest that the input field may be used to input email, much less a multimedia message.

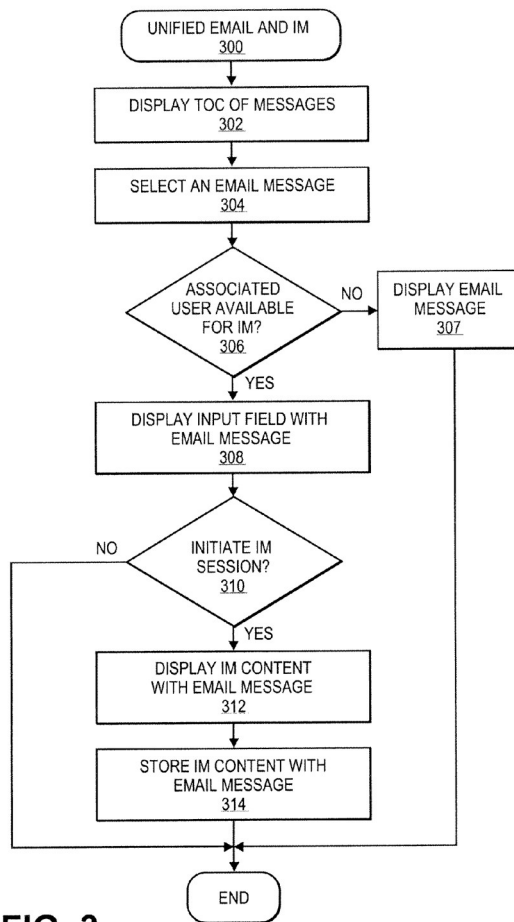


FIG. 3

99. 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 at 11:60-63, 15:6-9.

100. 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 at 11:4-12.

101. Alfke is not relied on by Petitioner for the disclosure of the IUI, and Dr. Madisetti does not argue that Alfke discloses an IUI.

102. Therefore it is my opinion that Lemay, either alone or in combination with Alfke, fails to remedy the deficiencies of Lemay.

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

103. In addition to the fact that Lemay alone or in combination with Alfke does not disclose an integrated user interface because it does not disclose the ability to send more than one type of message, Lemay alone or in combination with Alfke also does not disclose the ability to display transmitted and received messages to/from the recipient in transmitted/received order .

104. Lemay 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.

105. As explained above, email and instant messages are sent to the end recipient via two different protocols, SMTP (in the case of email) and SMS or MMS (in the case of instant messages).

106. In the case of SMTP, email is stored in a mail server until it is retrieved (i.e., pulled) by its intended recipient, while instant messaging is sent directly to the intended recipient.

107. The difference between storage until receipt and sending directly to the recipient prevent email and instant messages from reliably being received in the same order in which they are transmitted. The use of SMTP can cause a delay of several minutes between the transmission and receipt of an email message, while using SMS or MMS results in transmission of instant messaging to the intended recipient in a near instantaneous fashion. As a result, an instant message which is sent to a recipient immediately after an email message is sent is likely to be received by the sender before the corresponding email message arrives.

108. 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.

109. Nothing in Lemay suggests otherwise. 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. The first pane displaying an inbox does not meet the claim limitation because it only shows received messages.

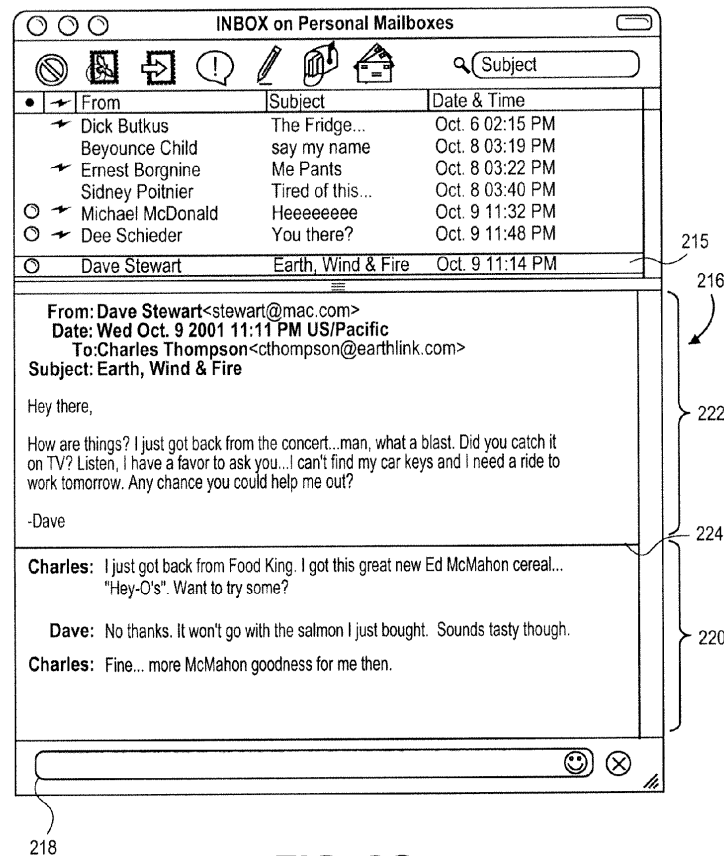


FIG. 2C

110. 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.

111. The second pane 222 displaying a selected email does not meet the claim limitation because it is only a received message. EX1005, 7:5-9.

112. The third pane 220 displaying an instant messaging session does not meet the claim limitation because it is limited to one type of message (text) and does not integrate multimedia messages with text messages. EX1005, 6:67-7:9, Fig. 2C.

113. 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 at 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.

114. In the embodiment shown in FIG. 2A of Lemay, an email in the TOC 202 is selected but no input field is displayed.

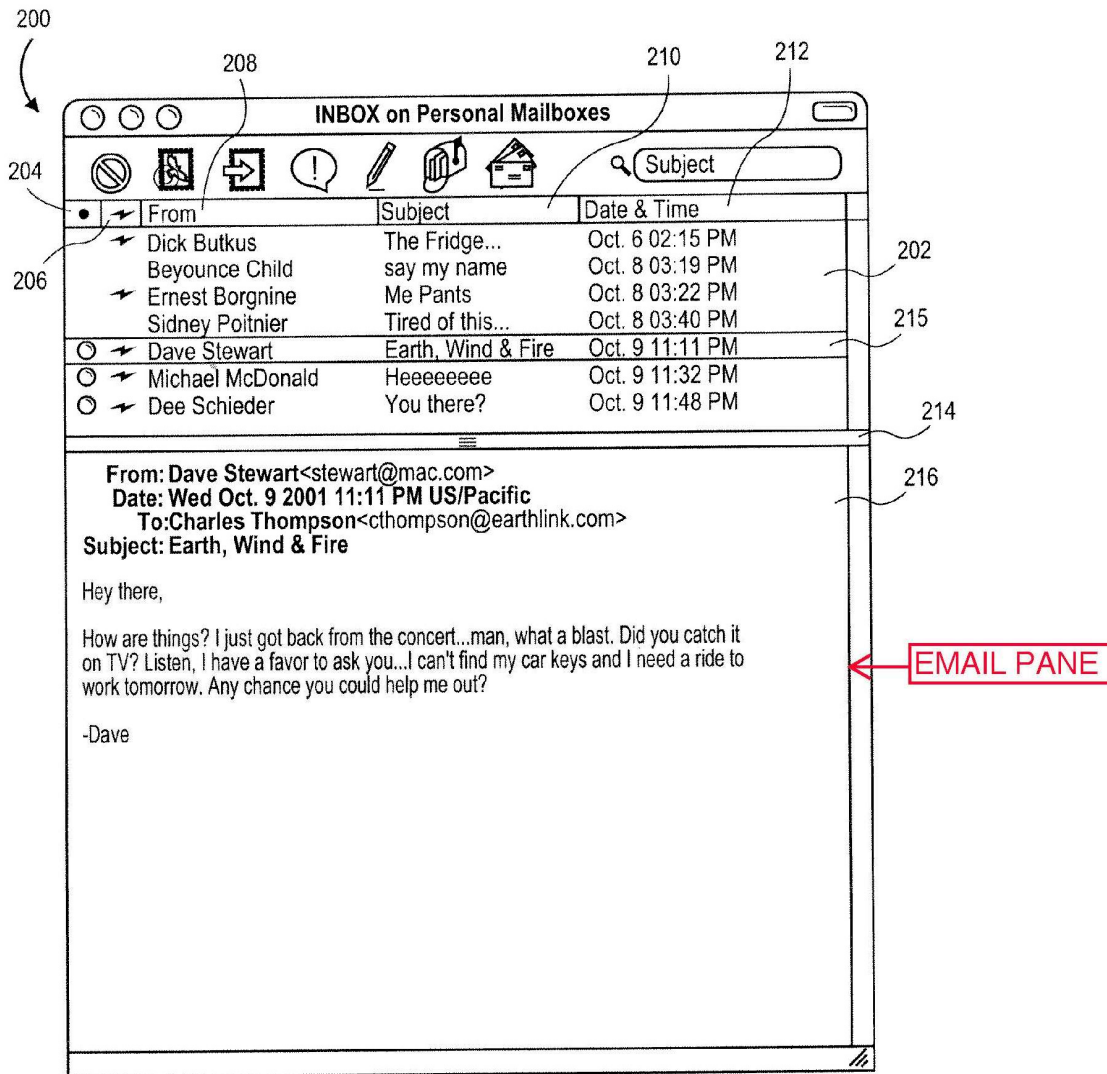
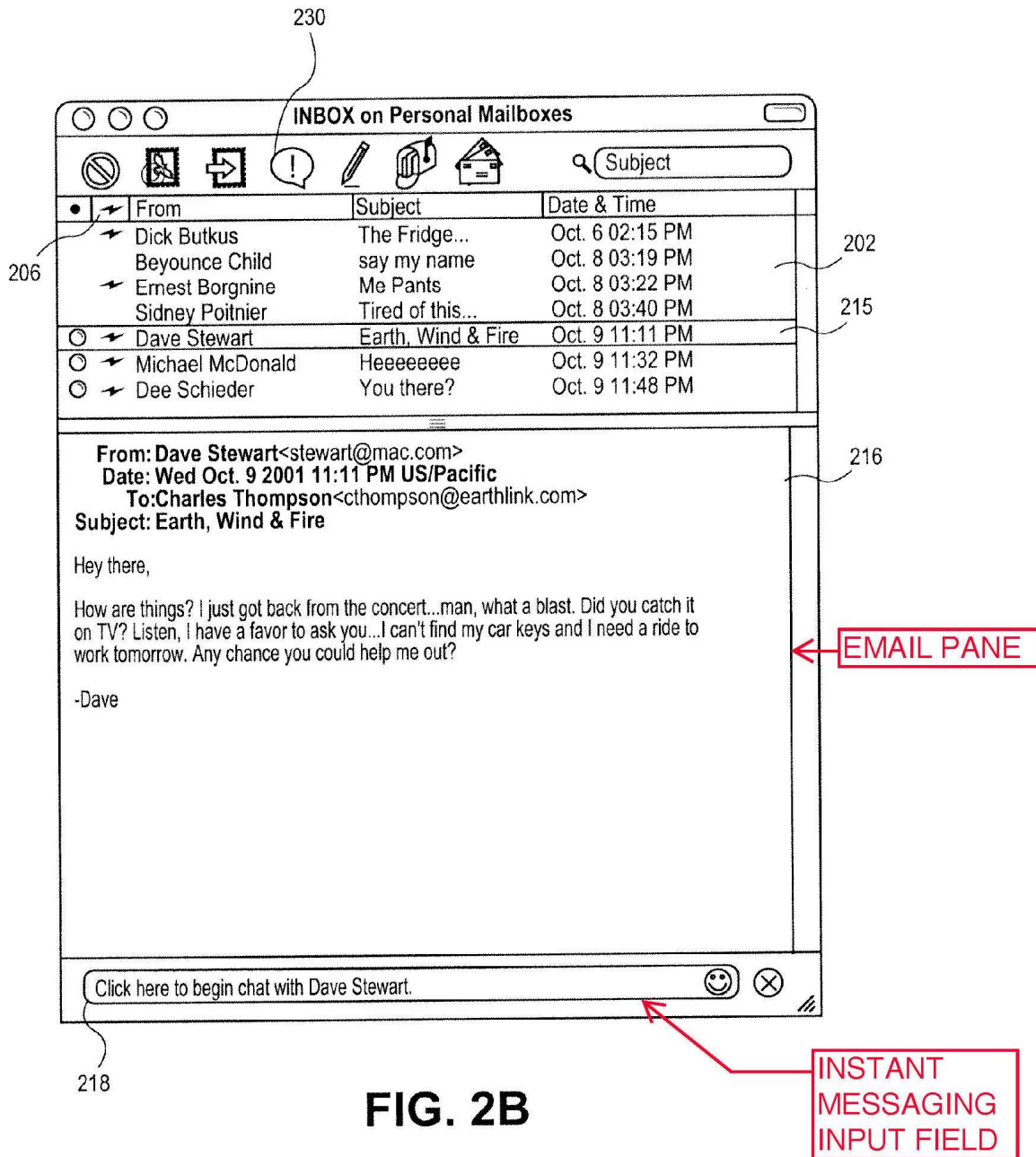


FIG. 2A

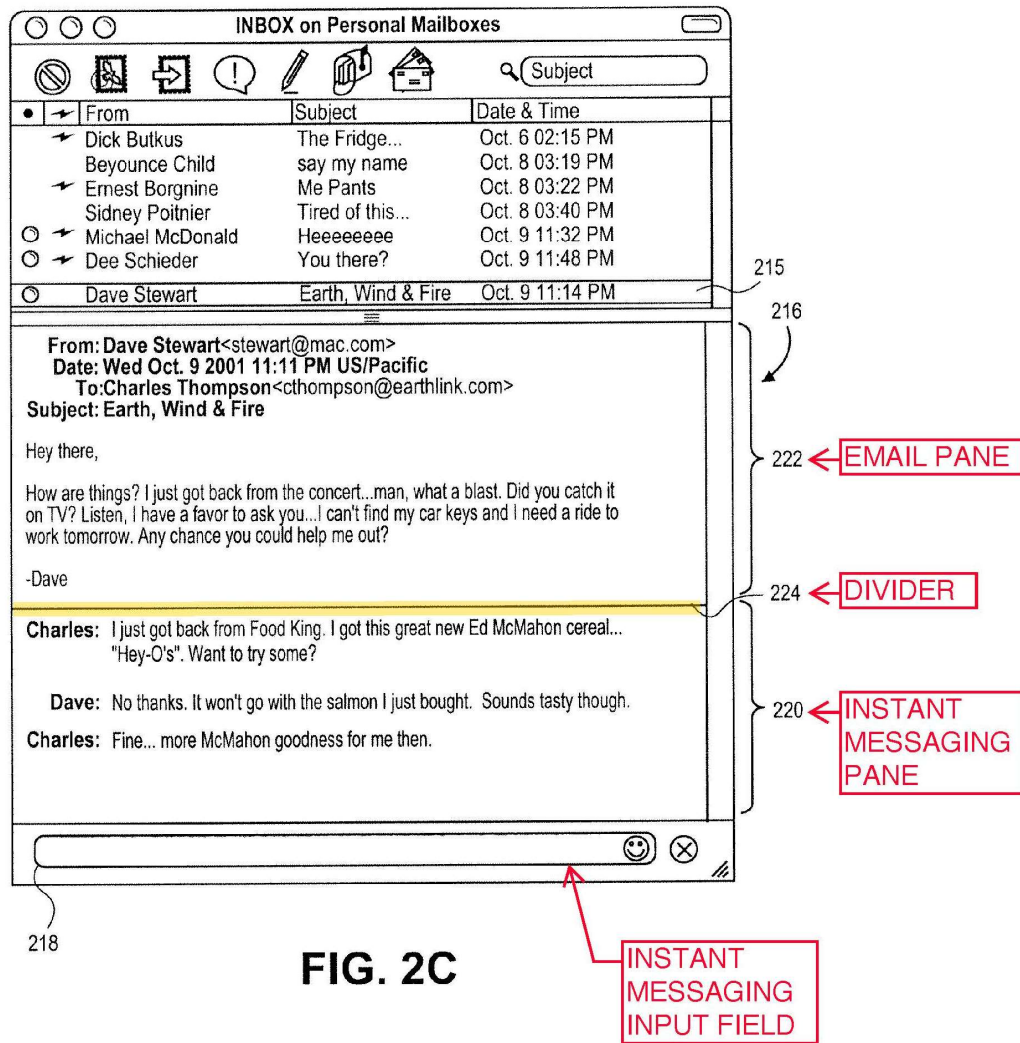
EX1005, FIG. 2A.

115. 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.



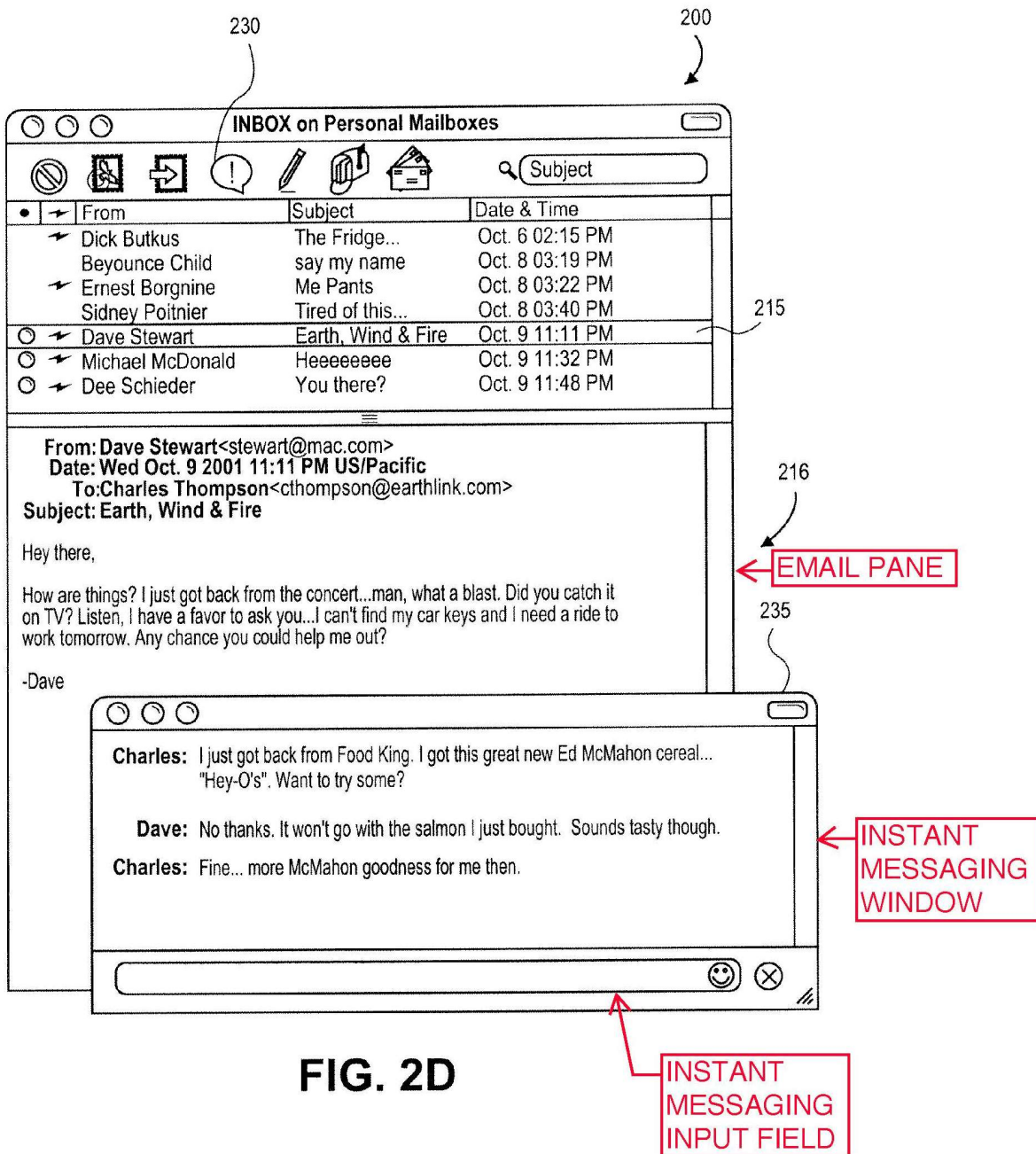
EX1005 at FIG. 2B.

116. 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.

117. 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.



EX1005, FIG. 2D.

118. 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.

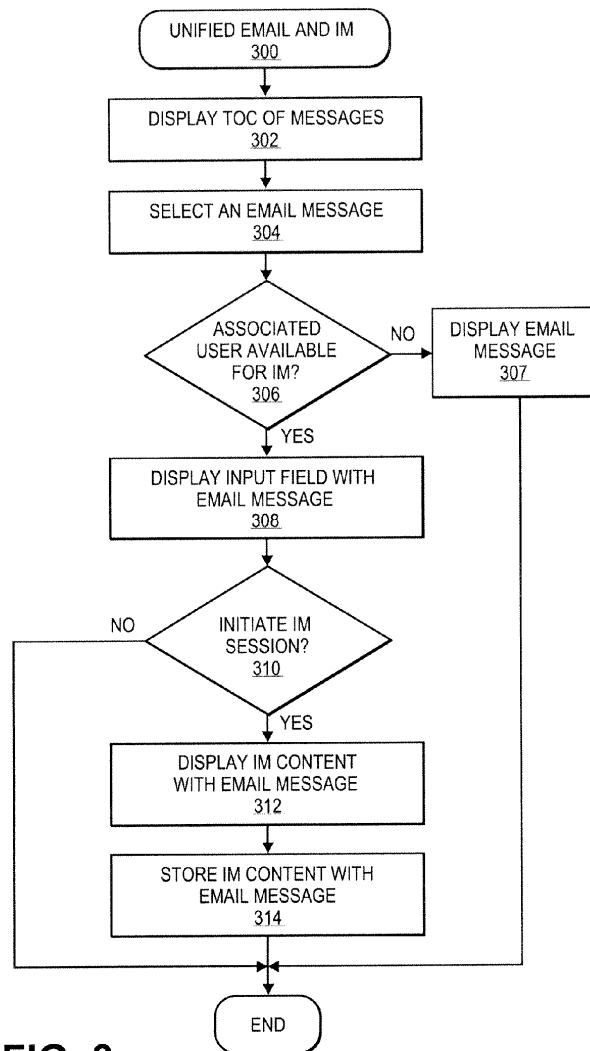


FIG. 3

EX1005 at 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).”).

119. 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 at 11:4-12.

120. 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, and Petitioner has not in my opinion demonstrated that Lemay (alone or in combination with Alfke) anticipates or renders obvious claims 1 and 2.

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

121. As explained in section VIII.B., *supra*, a POSITA would understand that 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.” In my opinion, 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. In Lemay determining a message

kind of the message to be transmitted is not based on what has been inputted in the user interface.

122. 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. 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 at 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).

123. In none of the above examples from Lemay 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.

124. 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. *See, e.g.*, 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).

125. 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.

126. 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. EX1006, FIGS. 3-4, 6:17-22, 8:19-34, 14:14-18.

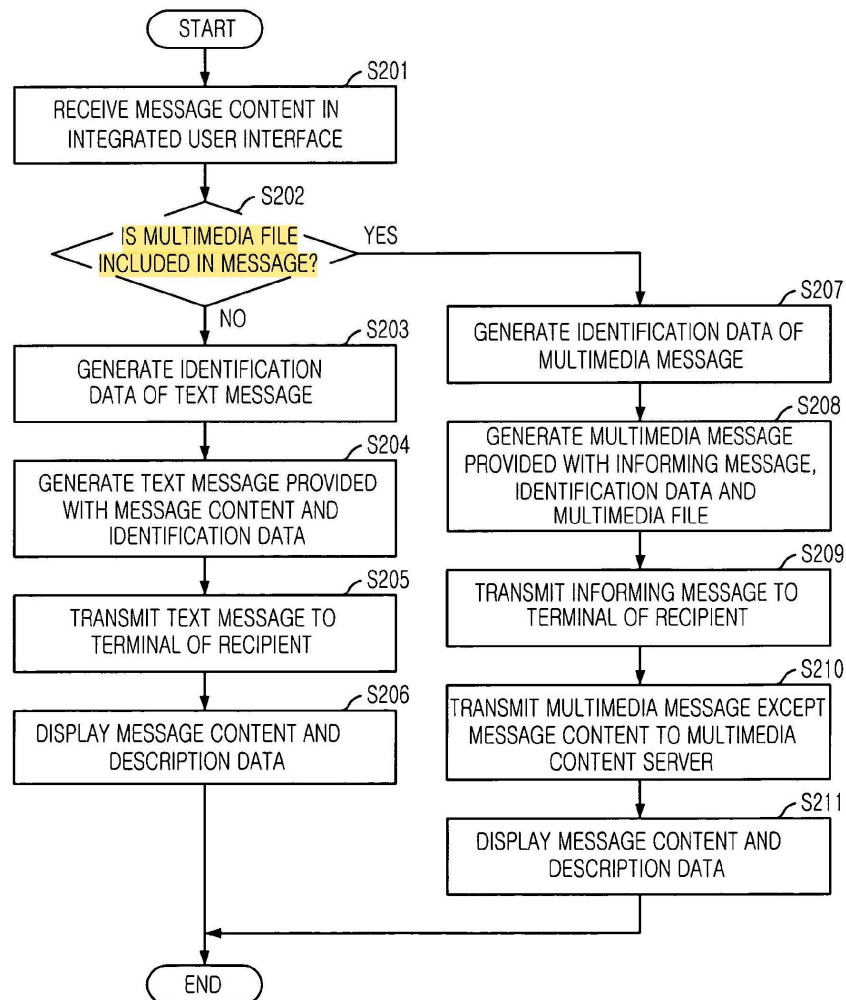
127. Notably, the determination in Alfke is not based on the content of a message inputted in a user interface prior to generating the email, much less based on whether or not such content includes a multimedia file. *See, e.g.*, EX1006 at 5:50-6:4 (discusses email client determining whether to send 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).

128. Further, claims 1 and 2 of the '839 patent do not 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 at 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 at Fig. 2 (S201, S202).

129. 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. 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.

130. 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 at 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.

131. 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.

132. 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 at 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).

133. 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.

4. **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**

134. In addition to the reasons set forth in Section VIII.B. *supra*, in my opinion, a POSITA would also recognize that Lemay, alone or in combination with Alfke, does not teach “determining a message kind of the message to be transmitted which is inputted in the IUI” because in Lemay, 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.

135. As acknowledged by Petitioner, and as explained above, 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; EX1003. 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 at 6:26-42; 9:29-52; and FIG. 3.

136. 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. 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.

137. In addition, Lemay discloses a user interface for instant messaging and email. *See, e.g.*, EX1005 at Abstract. Instant messaging is text-based; and, as explained in Section VIII.A.3., *supra*, a POSITA would not consider email to be a multimedia message in the context of the ‘839 patent.

138. 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.

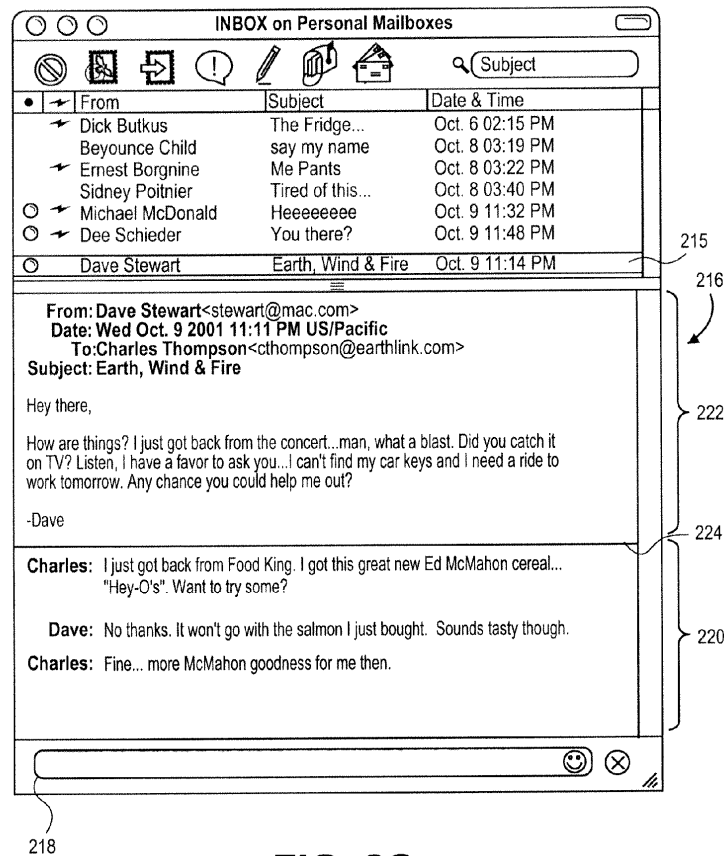


FIG. 2C

EX1005 at FIG. 2C.

139. 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 at 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) As such, it is clear that the determination in Lemay is not based on whether or not a multimedia file is included in the message to be transmitted.

5. Lemay Does Not Disclose “Transmitting the Outgoing Message”

140. As explained in Section XX *supra*, a POSITA would understand that 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.” 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.

141. I note that both Petitioner and its expert, Dr. Madisetti, admit that 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));
EX2002 at ¶ 48.

142. Even if Petitioner attempted to combine Lemay with Alfke, the combination would also not disclose this limitation. Alfke (which Petitioner asserts is incorporated by reference into Lemay (see Pet. at 5 fn.2), makes clear that the transmission protocols and networks for email and instant messages are distinct. For example, Alfke shows two methods of transmitting a message. In the first, shown in Fig. 2A, an email message is delivered through e.g., an SMTP, PoP, or IMAP protocol:

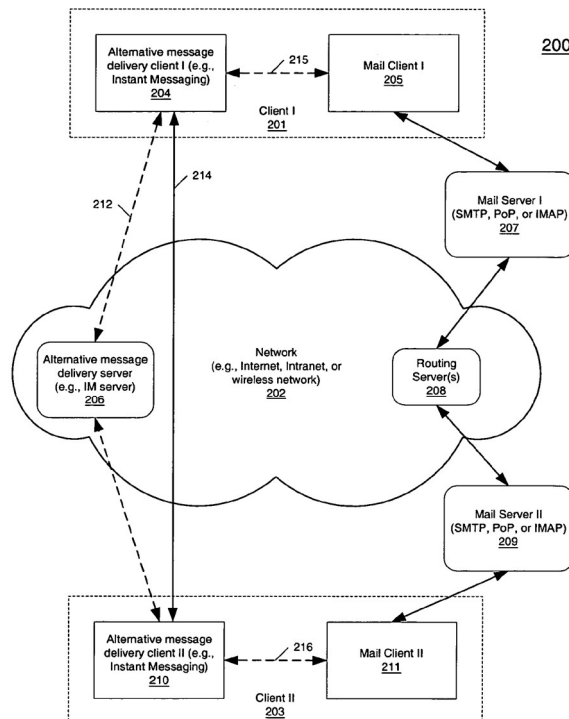
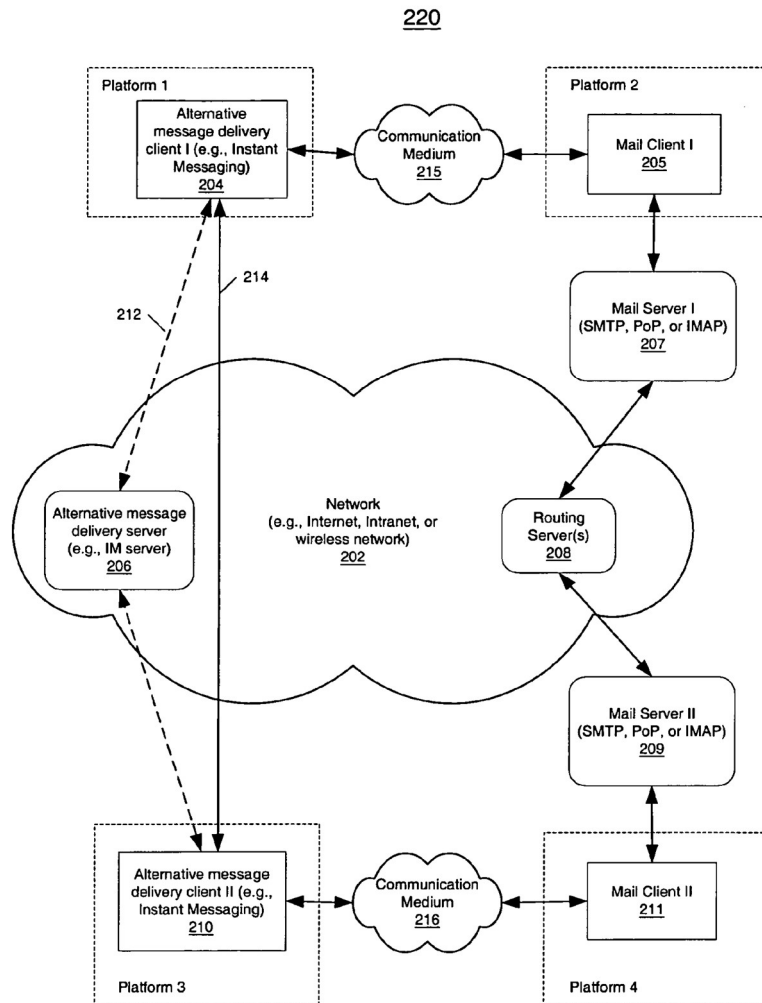


Fig. 2A

See EX1006 at Fig. 2A.

143. In the second, shown in Fig. 2B, an instant message is delivered by an “alternative message delivery client I (e.g., instant messaging).”



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

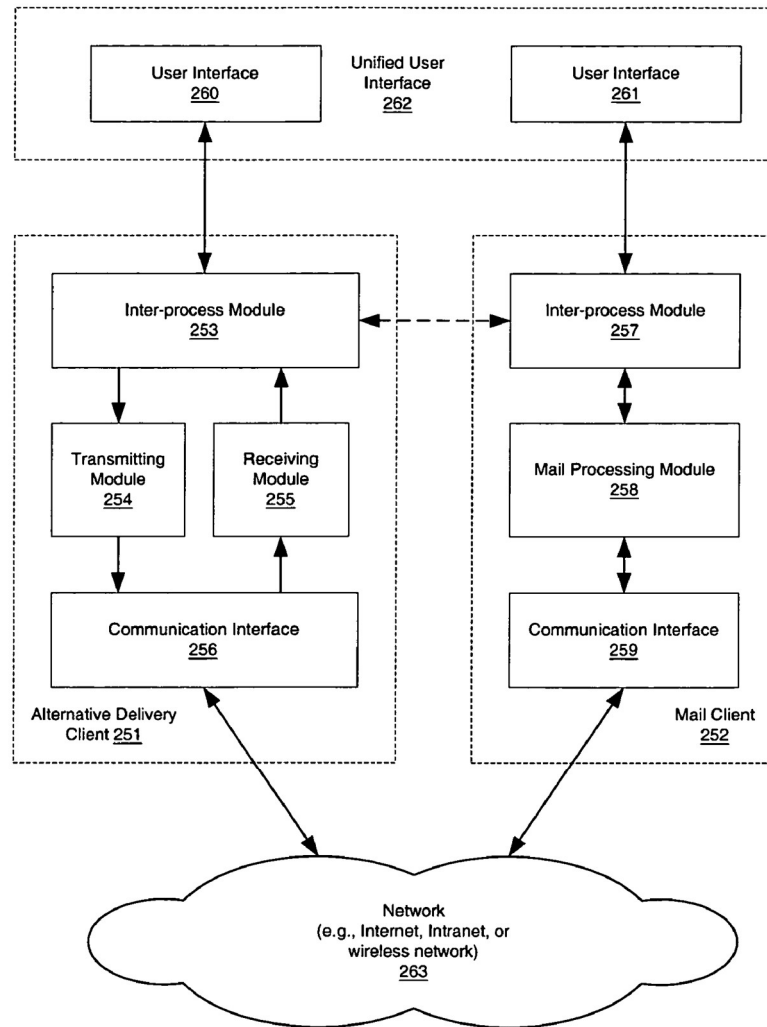


Fig. 2C

See also EX1006 at 6:42-7:3.

145. Alfke is also clear that the recipient’s alternative messaging system must be “able to handle mail messages.” EX1006 at 8:19-20.

146. 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 at 6:19-22.

147. 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.” *Id.*, 6:30-33.

148. Thus, Alfke specifies that 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. EX1006, FIGS. 3-4, 6:17-22, 8:19-34, 14:14-18.

149. As explained above, 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. This is in contrast with the invention of the ‘839 patent, which clearly states that 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 at 1:59-62.

B. The Combination of Maguire and Kang Does Not Render The Challenged Claims Obvious

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

150. As explained in section VIII.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 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 such, a POSITA would recognize that Maguire does not disclose an IUI as claimed in the ‘839 patent.

151. First, Maguire does not disclose an instant-messenger like interface, as is required by the disclosure of the ‘839 patent. The sole user interface disclosed in Maguire is interface 124 shown in Fig. 5.

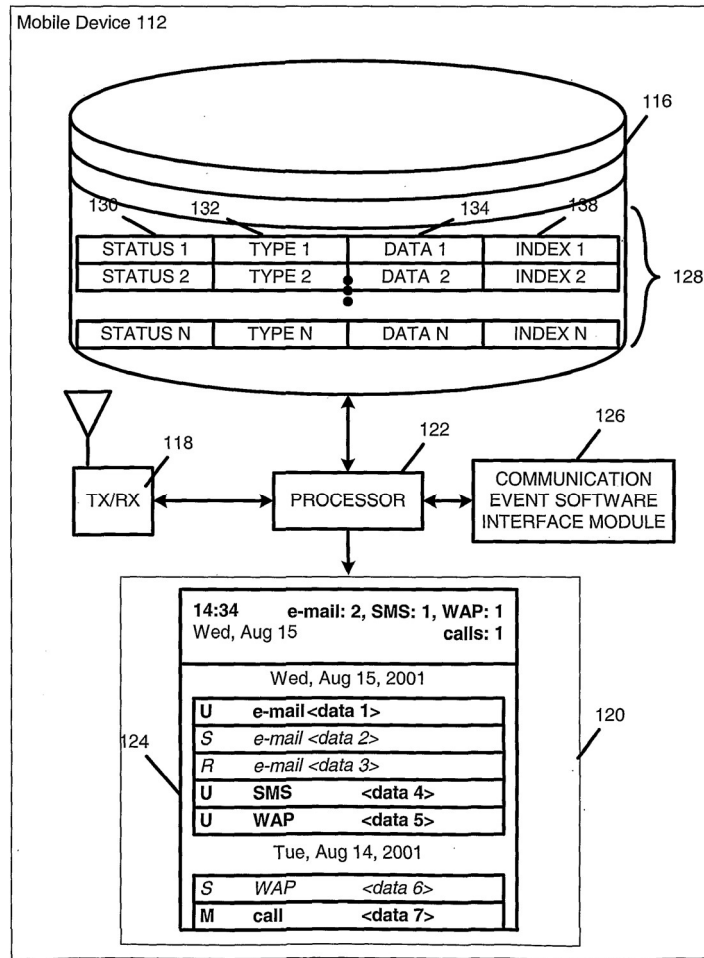


Figure 5

Pet. at 59; EX2002 at ¶¶ 136-137.

152. A POSITA would recognize that user interface 124 is not an instant messenger-like interface as disclosed by the '839 patent. Maguire nowhere discloses an input window for composing an outgoing message to a recipient. Instead, Maguire states that 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 at [0026].

153. While Maguire generally states that it may both send and receive messages, including SMS and email messages, *id.*, it provides no indication that 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.

154. The fact that Fig. 5 shows no method of composing an outgoing message is consistent with the focus of Maguire, which is on receipt of communications, not the sending of communications. For example, Maguire states that “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 at [0012]. The reference to the “present invention” would tell one of ordinary skill in the art that this is a requirement of the invention, and the form of any interface that is used to send messages is completely absent from Maguire.

155. The Petition does not appear to claim that Kang would disclose to one of skill in the art the integrated user interface of the ‘839 patent. I agree that Kang does not disclose such an interface.

156. To the extent that the Petition may argue that Figs. 7 and 8 of Kang disclose an “integrated user interface” as described in the ‘839 patent, see Pet. at 72, 75, I disagree that such a user interface is disclosed.

157. First, the interface in Kang is not unitary. 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	@	▽△					

158. 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.

159. 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

icon for opened SMS message
icon for unread SMS message
icon for unread e-mail message
icon for opened e-mail message

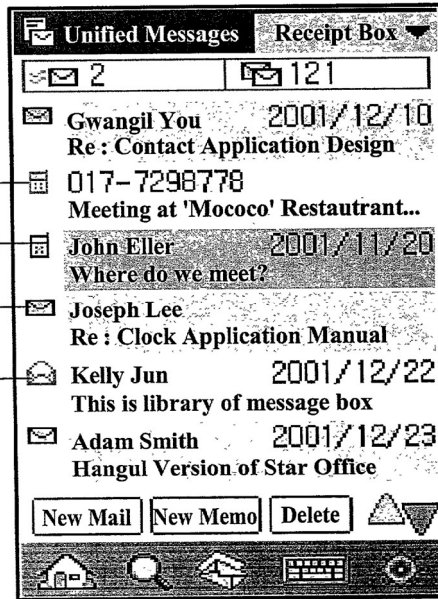
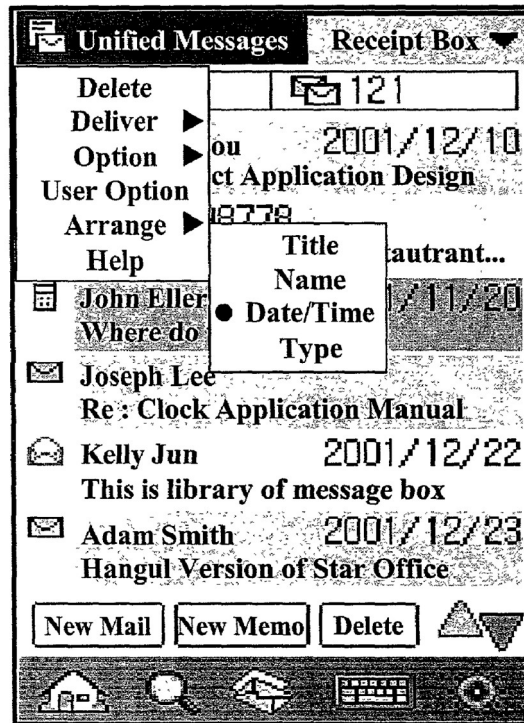


FIG. 5



2. 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

160. As explained in section VII.B., *supra*, a POSITA would understand that 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 VIII.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 an 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.”

161. A POSITA would recognize that the combination of Maguire in view of Kang would not teach the above limitation as disclosed in the ‘839 patent. 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.

162. First, Maguire fails to disclose an IUI (that is, a single, unitary integrated user interface for text messages and multimedia message 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 VII., *supra*.

163. Second, there is no disclosure in Maguire of a controller determining a message type of an outgoing message “to be transmitted.” EX1007, [0014]-[0015]

164. 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. In fact, Maguire is silent as to whether multimedia messages can be transmitted at all.

165. Kang fails to remedy the deficiencies of Maguire. The Petition admits that 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.

166. As explained above, Kang also fails to disclose an IUI (*see* Section VIII.B.1., *supra*).

167. Kang also fails to disclose a controller that determines a message type of an outgoing message to be transmitted. Instead, the user of Kang must manually

determine the message type to be used by pressing a button to convert the message from being sent via an SMS protocol instead of an SMTP protocol, or vice versa:

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	@	▽△	◀			

EX100X, Fig. 7.

168. Kang also fails to disclose a controller determining a message type based on whether a multimedia file is included in an outgoing message to be transmitted. Instead, in Kang the message type is determined by the type of addressing used (email vs. SMS) and/or by message size. EX1008, [0040]-[0052].

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

169. As explained above, the claims of the '839 patent 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 specification. *See, e.g.*, EX1001 at 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.

170. As explained in Section VIII.B.1., *supra*, 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).

171. 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.” Rather, interface 124 is disclosed as solely receiving messages. EX1007, [0026], [0031]. 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.

172. The Petition implies that this limitation is met by Maguire but fails to provide a cite that is actually relevant. For example, in Maguire, paragraphs [0002]-[0004] discuss 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. Cited 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. Cited 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. Cited paragraphs [0021]-[0022] discuss a method of receiving a communications event from a correspondent. Cited paragraph [0026] discusses the communications event database and how the interface displays communication events. Cited paragraphs [0029]-[0030] discuss

the transceiver and the display. Cited paragraphs [0035]-[0036] discuss interactions between the mobile device and the communications event database, database structure, and displaying database query results. Finally, FIG. 3 and FIG. 5 show a method of receiving a communications event and displaying a communications event history from a database and 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. 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.

173. Kang fails to remedy the deficiencies of Maguire. First, as explained above, Kang does not disclose an IUI as claimed in the ‘839 patent. *See* Section VIII.B.1., *supra*. Rather, it discloses a unified receipt box that displays several types of messages together in a single window. *See, e.g.*, EX1008 at [0002] and FIGS. 2, 4, and 5.

174. Nowhere in the Petition does Petitioner allege that 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.

175. 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 in the ‘839 patent.

176. 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 at [0040].

177. 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 at [0045].

178. 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 and warns the user if it is not (step S51 in FIG. 6a; step S71

in FIG. 6b). EX1008 at [0042], [0047]. If a warning is generated, the user may select a suitable delivery manner (step S51 in FIG. 6a; step S71 in FIG. 6b). *Id.* 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 at [0041], [0046].

179. Nowhere in the cited portions of Maguire is there a teaching or suggestion that the controller determines a message kind of the message to be transmitted.

180. 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 at [0059](emphasis added).

181. 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 at [0059]. 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 if the type is SMS. EX1008 at [0059]. “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 at [0060].

182. A POSITA reading ¶¶[0059] and [0061] in conjunction with ¶[0060] and FIG. 7, would immediately understand that 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). 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.

183. A POSITA would also rightfully conclude, as explained above, that the message type checking unit of Maguire cannot be the claimed controller because it is clear from Maguire that the 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.”.

4. 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

184. As explained in Section VII.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.”

185. 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 that Maguire fails to teach determining a message kind by “determining whether or not a multimedia file is included in the message to be transmitted which is inputted in the IUI.”

186. 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 at Abstract, FIGS. 6a-6b, 7, [0011]-[0012], [0026], [0040]-[0043], [0046]-[0048], [0050], [0051], [0059]-[0061], claims 9, 13, 16, 20).

187. In fact, Kang only discusses transmitting and receiving text messages and email. *See, e.g.*, EX1005 at Abstract. Text messages contain only text; and, as shown in Section VIII.A.3., *supra*, a POSITA would not consider email to be a multimedia message in the context of the ‘839 patent.

188. 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.

FIG. 7

FIG. 7 illustrates a mobile device screen displaying a 'New Mail' form. The form includes fields for 'To' (0191234567), 'CC', 'Attached', and 'Title'. A warning dialog box (710) is overlaid on the form, displaying the text: 'Warning! Can't send through e-mail service Change to New Memo for SMS'. The dialog box has an 'ok' button (711). Below the dialog box are 'Send' and 'Cancel' buttons. At the bottom of the screen is a numeric keypad with letters and symbols. A label 701 points to the 'To' field, and a label 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	@	▽△	↩			

FIG. 8

FIG. 8 illustrates a mobile device screen displaying a 'New Memo' form. The form includes fields for 'To' (dino211@mailserver.com) and 'From'. Below these fields are several horizontal lines for text entry. At the bottom of the screen is a numeric keypad with letters and symbols. A label 801 points to the text entry area.

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	@	▽△	↩			

5. The Proposed Combination of Maguire and Kang Does Not Disclose The “Transmitting The Outgoing Message” Limitation

189. As explained in Section VII.C. *supra*, a POSITA would understand that 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.

190. 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.

191. The Petition implies that this limitation is met by Maguire, Pet. at 84, but fails to provide a cite that is actually relevant. None of the portions of Maguire cited by Petitioner teach or suggest transmitting an outgoing message without changing the transmission protocol or network of the message. [0002]-[0004] provides solely background, with no description of transmitting an outgoing message without changing the transmission protocol or network of the message. [0013], [0018], and [0025]-[0027] generally disclose a “transceiver for transmitting and receiving communications events,” but do not disclose transmission of a message without changing the protocol of the message. [0021] does not disclose

transmission at all. Figs. 5-6 do not show any transmission of an outgoing message, only reception of a message.

192. Kang does not remedy the deficiencies of Maguire. Petitioner does not allege that Kang discloses this limitation. Pet. at 84. Further, Kang affirmatively fails to disclose this limitation. Kang teaches that, when a message is written as an email (i.e., it would be sent using an SMTP protocol), but the message is addressed to a recipient using an instant messaging address form (e.g., a telephone number), the user is prompted to change the protocol from an email protocol to MMS. Similarly, if a message is composed to be sent in an MMS format, but is addressed to a recipient's email address, the user is prompted to change the protocol from SMS to an email protocol. EX1008, Figs. 7-8, [0041]-[0047].

C. Lemay (Alone or in Combination with Alfke) in View of RFC2822 Does Not Render The Challenged Claims Obvious

193. Ground 3 of the Petition alleges that claims 1 and 2 are obvious over Lemay (EX1005) in view of RFC2822 (EX1009). However, RFC2822 does not remedy the deficiencies of Lemay and Alfke discussed above.

194. As explained above (*see* Section VIII.A.), Lemay (whether alone or in combination with Alfke) does not determine a message kind of an outgoing message inputted in the integrated user interface, as required by the claims. Lemay (alone or

in combination with Alfke) also does not disclose “transmitting an outgoing message” or an “integrated user interface.”

195. RFC2822 does nothing to cure these deficiencies, and Petitioners do not allege that either is disclosed in the reference.

196. Petitioner admits that RFC2822 “teaches a standardized format for messages carrying ‘*electronic mail*’” (emphasis added). *Id.* That is, RFC2822 teaches how to format email.

197. Further, a POSITA, upon reading RFC2822, would be taught away from combining RFC2822 with Lemay. The ‘839 patent discloses that “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 that “[t]his 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.*” RFC2882, p.3.

198. What RFC2822 defines is how to send and receive an SMS by sending it to an email. In other words, 3054447777@sms.att.com or 305444477777@tmobile.com, and how AT&T or T-Mobile will decapsulate an email sent to that address and how that is converted into a text message.

199. Thus, RFC2822 does not cure the deficiencies found on Lemay, nor how Lemay can only associate emails to text messages, but not be able to display media or a picture via MMS, as the RFC2822 states that “This standard only specifies a syntax only for text messages” at Pg. 3.

D. The Combination of Maguire, Kang, and RFC2822 Do Not Render The Challenged Claims Obvious

200. Ground 4 of the Petition alleges that claims 1 and 2 are obvious over Maguire (EX1007) in view of Kang (EX1008) and RFC2822 (EX1009). However, RFC2822 does not remedy the deficiencies of Maguire in view of Kang discussed above.

201. As explained above (see Section VIII.B.), Maguire in view of Kang does not disclose determining a message kind of an outgoing message inputted in the integrated user interface, as required by the claims. Maguire in view of Kang also does not disclose “transmitting an outgoing message” or an “integrated user interface.”

202. RFC2822 does nothing to cure these deficiencies, and Petitioners do not allege that either is disclosed in the reference.

203. Petitioner admits that RFC2822 “teaches a standardized format for messages carrying ‘*electronic mail*’” (emphasis added). *Id.* That is, RFC2822 teaches how to format email.

204. Further, a POSITA, upon reading RFC2822, would be taught away from combining RFC2822 with Lemay. The '839 patent discloses that “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 that “[t]his 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.*” RFC2882, p.3.

205. What RFC2822 defines is how to send and receive an SMS by sending it to an email. In other words, 3054447777@sms.att.com or 305444477777@tmobile.com, and how AT&T or T-Mobile will decapsulate an email sent to that address and how that is converted into a text message.

206. Thus, RFC2822 does not cure the deficiencies found on Lemay, nor how Lemay can only associate emails to text messages, but not be able to display media or a picture via MMS, as the RFC2822 states that “This standard only specifies a syntax only for text messages” at Pg. 3.

I declare that all statements made herein of my own knowledge re true and that all statements made on information and belief are believed to be true, and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code.

Dated: June 7, 2024

A handwritten signature in black ink, appearing to read 'Edwin A. Hernandez-Mondragon', written over a horizontal line.

Dr. Edwin. A. Hernandez-Mondragon