

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, SAMSUNG ELECTRONICS CO. LTD.,
AND SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner

v.

MULTIMODAL MEDIA LLC,
Patent Owner.

Case No. IPR2024-00053
U.S. Patent No. 8,107,978

**PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 8,107,978**

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LIST OF EXHIBITS¹

Ex-1001	U.S. Patent No. 8,107,978
Ex-1002	Declaration of Dr. Benjamin B. Bederson
Ex-1003	Curriculum Vitae of Dr. Benjamin B. Bederson
Ex-1004	File History of U.S. Patent No. 8,107,978
Ex-1005	PCT Publication WO2001/013656 (“Bengtsson”)
Ex-1006	PCT Publication WO2007/020627 (“Roujinsky”)
Ex-1007	U.S. Patent Publication 2005/0136955 (“Mumick’955”)
Ex-1008	INTENTIONALLY LEFT BLANK
Ex-1009	INTENTIONALLY LEFT BLANK
Ex-1010	INTENTIONALLY LEFT BLANK
Ex-1011	INTENTIONALLY LEFT BLANK
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Ex-1013	INTENTIONALLY LEFT BLANK
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Ex-1017	INTENTIONALLY LEFT BLANK
Ex-1018	INTENTIONALLY LEFT BLANK
Ex-1019	INTENTIONALLY LEFT BLANK
Ex-1020	INTENTIONALLY LEFT BLANK

¹ Four-digit pin citations that begin with 0 are to the branded numbers added by Petitioner in the bottom right corner of the exhibits. All other pin citations are to original page, column, paragraph, or line numbers.

Ex-1021	<i>Multimodal Media LLC v. Guangdong Oppo Mobile Telecommunications Corp., Ltd.</i> , 2:21-cv-00436, D.I. 65 (E.D. Tex. Apr. 24, 2023) (Claim Construction Order) (“ <i>Oppo</i> Litigation”)
Ex-1022	<i>Multimodal Media LLC v. TCL Technology Group Corporation et al.</i> , 2:22-cv-00463, D.I. 23 (E.D. Tex. Feb. 22, 2023) (Stay Order) (“ <i>TCL</i> litigation”)
Ex-1023	<i>Multimodal Media LLC v. Samsung Electronics Co., Ltd. et al.</i> , 2:22-cv-00462, Infringement Contentions (E.D. Tex. May 30, 2023) (“ <i>Samsung</i> Infringement Contentions”)
Ex-1024	U.S. Patent Publication 2008/0219416 (“Roujinsky-US”)
Ex-1025	Alok Sinha, Client-server computing (1992), Communications of the ACM, 35, 7 (July 1992), 77–98, DOI: https://doi.org/10.1145/129902.129908
Ex-1026	Benjamin B. Bederson & James D. Hollan, Pad++: A Zooming Graphical Interface for Exploring Alternate Interface Physics, UIST ‘94 Proceedings of the 7th Annual ACM Symposium on User Interface Software and Technology 17 (1994), DOI: http://dx.doi.org/10.1145/192426.192435
Ex-1027	Tim Berners-Lee, Robert Cailliau, Ari Luotonen, Henrik Frystyk Nielsen, and Arthur Secret, The World-Wide Web (1994), Communications of the ACM 37, 8 (August 1994), 76-82, DOI: http://dx.doi.org/10.1145/179606.179671
Ex-1028	INTENTIONALLY LEFT BLANK
Ex-1029	C.J. Date, An Introduction to Database Systems at 8 (7th ed. 2000)
Ex-1030	Nokia 3250 User Guide (2006), available at: https://ia801806.us.archive.org/32/items/manualzilla-id-5923903/5923903.pdf
Ex-1031	David Dearman, Amy Karlson, Brian Meyers, and Ben Bederson, Multi-modal text entry and selection on a mobile device (2010), In Proceedings of Graphics Interface 2010 (GI ‘10), Canadian Information Processing Society, CAN, 19–26

Ex-1032	AOL Instant Messenger Registration page (1999), available at: https://web.archive.org/web/19991127133324/http://aim.aol.com/?promo=106712&pageset=Aim
Ex-1033	Newsroom, Apple Reinvents the Phone with iPhone (Jan. 9, 2007), available at: https://www.apple.com/newsroom/2007/01/09Apple-Reinvents-the-Phone-with-iPhone/
Ex-1034	U.S. Patent Publication 2007/0150830
Ex-1035	Webster’s New World Computer Dictionary 264-65 (10th ed. 2003)
Ex-1036	Elia Palme, Chuan-Hoo Tan, Juliana Sutanto, and Chee Wei Phang, Choosing the smart phone operating system for developing mobile applications (2010), In Proceedings of the 12th International Conference on Electronic Commerce: Roadmap for the Future of Electronic Business (ICEC ‘10), Association for Computing Machinery, New York, NY, USA, 146–152, DOI: https://doi.org/10.1145/2389376.2389397
Ex-1037	Microsoft Computer Dictionary 378 (5th ed. 2002)
Ex-1038	RealPlayer 8 Plus User Manual (Rev. 1.0) (2000), available at: https://www.itya.unam.mx/computo/sites/manuales/realplayer/rp8manualfull.pdf
Ex-1039	The Wayback Machine Archive, Pine Information Center, Frequently Asked Questions, University of Washington (Oct. 4, 2000), available at: https://web.archive.org/web/20010410095757/http://www.washington.edu/pine/faq/sendreceive.html
Ex-1040	Nokia 9300 User Guide (2005), available at: https://www.manualslib.com/download/756822/Nokia-9300.html
Ex-1041	Jackson Phipps, The History of PPC and Google Ads, 2060 Digital, available at: https://2060digital.com/blog/the-history-of-ppc-and-google-ads/#:~:text=In%202000%2C%20Google%20rolled%20out,digital%20advertisers%20across%20the%20world
Ex-1042	INTENTIONALLY LEFT BLANK
Ex-1043	PCT Publication WO2006/020938 (“Mumick’938)

Ex-1044	INTENTIONALLY LEFT BLANK
Ex-1045	INTENTIONALLY LEFT BLANK
Ex-1046	<i>Multimodal Media LLC v. Guangdong Oppo Mobile Telecommunications Corp., Ltd.</i> , 2:21-cv-00436, D.I. 74 (E.D. Tex. Sept. 6, 2023) (Order of Dismissal)

I. INTRODUCTION

Google LLC, Samsung Electronics Co. Ltd., and Samsung Electronics America, Inc. (collectively, “Petitioner”) request *inter partes* review (“IPR”) of Claims 10-14 of U.S. Patent No. 8,107,978 (“the ’978 Patent”) (Ex-1001), currently assigned to Multimodal Media LLC (“PO”).

The challenged claims recite a voice short message service (“SMS”) messaging system including a client application that “integrates voice content to a text message created by a user” and transmits a voice message notification with the text message to the intended recipients. Ex-1001, Cl. 10. The system further includes “a server for remotely recording and storing” the user’s voice message; a user interface for the user to input text and voice messages; and memory storage on the mobile device for storing recipient addresses. *Id.*

The prior art teaches the claimed voice SMS messaging system—including the well-known configuration of a client application, server, user interface, and memory storage performing their routine functions—and renders the challenged claims unpatentable. Accordingly, Claims 10-14 of the ’978 Patent are invalid as obvious over the prior art.

This Petition presents grounds that the examiner did not consider during prosecution. These grounds are more than reasonably likely to prevail, and this Petition should be granted.

II. MANDATORY NOTICES UNDER 37 C.F.R. §42.8

Real Parties-in-Interest: Petitioner identifies the following real parties-in-interest: Google LLC², Samsung Electronics Co. Ltd., and Samsung Electronics America, Inc.

Related Matters: A decision in this proceeding could affect or be affected by the following proceedings, which assert infringement of the challenged '978 patent: (1) *Multimodal Media LLC v. Samsung Electronics Co. Ltd., et al.*, 2:22-CV-00462 (E.D. Tex.); and (2) *Multimodal Media LLC v. TCL Technology Group Corporation et al.*, 2:22-cv-00463 (E.D. Tex.). Co-Petitioner Google has not been named in, and is not a party to, any litigation involving the '978 Patent.

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III. FEE AUTHORIZATION

Pursuant to 37 C.F.R. §42.15(a) and §42.103(a), the PTO is authorized to charge any and all fees to Deposit Account No. LA500639.

IV. GROUNDS FOR STANDING

Petitioner certifies that the '978 Patent is available for review, this Petition is timely filed, and Petitioner is not barred or estopped from requesting review.

V. PRECISE RELIEF REQUESTED

Petitioner requests review and cancellation of Claims 10-14 as unpatentable based on the following grounds, supported by a declaration from Dr. Benjamin Bederson. Ex-1002 ¶¶1-31.

Ground	Summary
1	Claims 10-13 are obvious over Mumick'955 (Ex-1007) in view of Bengtsson (Ex-1005)

Ground	Summary
2	Claim 14 is obvious over Mumick'955 (Ex-1007) in view of Bengtsson (Ex-1005) in further view of Roujinsky (Ex-1006)
3	Claims 10-14 are obvious over Bengtsson (Ex-1005) in view of Roujinsky (Ex-1006)

VI. THE CHALLENGED PATENT

The '978 Patent purports to describe a method and system that integrates text content with voice content in a wireless SMS text message using “standard methods of recipient addressing.” Ex-1001, 3:3-7. Simply put, the patent purports to allow a user to record a voice message that is associated with a text message to a recipient. Ex-1002 ¶¶47-48. Figure 3A illustrates the system of the invention:

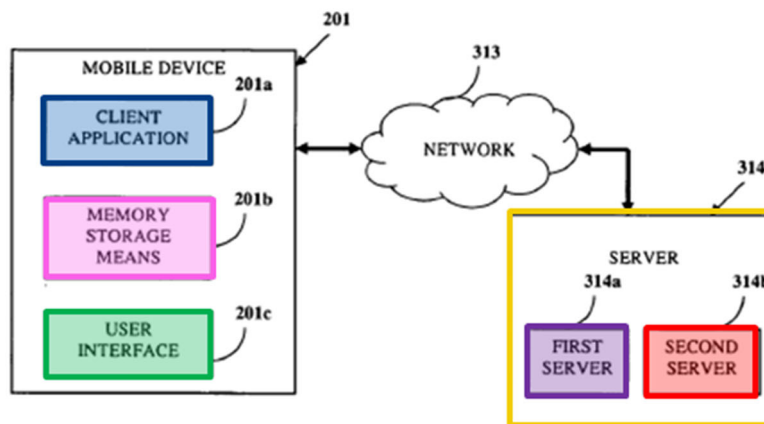


FIGURE 3A

As the figure illustrates, the system comprises mobile device 201 and server 314 (yellow) connected via network 313. Ex-1001, 5:23-25. Mobile device 201 includes client application 201a (blue), memory storage means 201b (pink), and user interface 201c (green). Ex-1001, 5:25-27. Client application 201a “integrates voice content to a text message” that is created by a user “using methods of recipient addressing.” Ex-1001, 5:27-30. Memory storage means 201b stores a list of recipient addresses that are accessed by the user. Ex-1001, 5:32-34. Moreover, the user inputs text and voice messages using user interface 201c. Ex-1001, 5:34-36. Server 314 may further include first server 314a (purple) for storing the user’s voice messages and second server 314b (red) for transmitting “text SMS messages along with the attached voice message notification” to the recipients. Ex-1001, 5:36-46. The ’978 Patent discusses using links for the voice message notification. Ex-1001, 5:7-16.

VII. PROSECUTION HISTORY OF THE ’978 PATENT

The ’978 Patent was filed on March 28, 2008. The examiner rejected Claims 10-14 as unpatentable over Shaked in view of Blackburn. Ex-1004, 99-116. In response, applicant amended Claim 10 to add a server for remotely “recording,” “wherein said server is configured to provide access to said recipient for listening to said recorded voice message,” and “said client application” for transmitting a voice message notification with an addressed text message to said recipients. Ex-1004, 125. Applicant argued that the Shaked-Blackburn combination “do[es] not provide

a client application for transmitting a voice message notification with a text SMS ... and also do[es] not disclose that a recipient of the text SMS comprising the voice message notification can access and listen to the voice message stored in the server.” Ex-1004, 139, 145-146. The examiner allowed all claims, citing applicant’s response as the reason for allowance. Ex-1004, 154; Ex-1002 ¶¶49-50.

VIII. LEVEL OF ORDINARY SKILL IN THE ART

A person of ordinary skill in the art at the relevant time (“POSITA”) would have had a bachelor’s degree in electrical engineering, computer science, computer engineering, or a related field, and two-three years of experience with multimedia and Internet-related communications technologies, or the equivalent, with additional education substituting for experience and vice versa. Ex-1002 ¶¶28-30.

IX. PRIORITY DATE

The earliest possible priority for the ’978 Patent is April 25, 2007. Petitioner takes no position on the proper priority date for each claim of the ’978 Patent. Assuming this earliest date, all prior art references asserted in this petition are prior art. Ex-1002 ¶51.

X. CLAIM CONSTRUCTION³

Petitioner interprets the claims of the '978 Patent according to the *Phillips* claim construction standard. 37 C.F.R. §42.100(b). For the purposes of this Petition, Petitioner does not believe that any term requires explicit construction to resolve the issues presented in this Petition except for the terms below, including one that was construed pursuant to §112(6).⁴ All others should be given their plain and ordinary meaning. To the extent that terms were construed or agreed upon by the parties in the *Oppo* district court litigation against an unrelated party,⁵ Petitioner applies these constructions for purposes of this Petition, except where noted below. Ex-1002 ¶¶52-56.

A. “memory storage means on said mobile device for storing a list of addresses of recipients” (Claim 10)

In the *Oppo* district court litigation, the parties agreed that this claim term is subject to 35 U.S.C. §112, ¶6 and should be given the following construction:

Function: “storing a list of addresses of recipients.”

³ Petitioner has adopted these constructions only for purposes of this Petition and reserves the right to propose and/or adopt any construction in any pending litigation matter.

⁴ For the means-plus-function term, Petitioner has identified the closest disclosed structure in the '978 Patent that relates to the recited function, but by doing so, Petitioner does not intend to, and does not, waive any argument that the structure for performing the claimed function of each term is not sufficiently disclosed.

⁵ On September 6, 2023, the *Oppo* litigation was dismissed due to settlement (Ex-1046).

Structure: “a floppy disk, a flexible disk, hard disk, magnetic tape, any other magnetic medium, a Compact Disc-Read Only Memory (CD-ROM), Digital Versatile Disc (DVD), any other optical medium, punch cards, paper tape, any other physical medium with patterns of holes, a Random Access Memory (RAM), a Programmable Read-Only Memory (PROM), an Erasable Programmable Read-Only Memory (EPROM), an Electrically Erasable Programmable Read-Only Memory (EEPROM), a flash memory, any other memory chip or cartridge, a carrier wave as described hereinafter, or any other medium from which a computer can read,” and equivalents. Ex-1021, 47. Petitioner applies this construction for purposes of this Petition and explains herein that the prior art in the Petition invalidates the challenged claims under this construction.

B. “wherein the client application transmits one of a text message, a voice message, and a combination thereof” (Claim 13)

This claim term was construed by the district court in the *Oppo* litigation to mean “wherein the client application transmits a text message, a voice message, or a combination thereof.” Ex-1021, 16-21. Petitioner applies this construction for purposes of this Petition and explains herein that the prior art in the Petition invalidates the challenged claims under this construction.

C. “client application” (Claims 10, 13-14)

The parties in the *Oppo* litigation agreed that this claim term should be construed to mean “a program present on the sender’s mobile device.” Ex-1021, 48.

However, the full claim term recites “a client application *on a mobile device*.” Ex-1001, Cl. 1.⁶ Construing the term “client application” to mean “a program present on the sender’s mobile device” renders the claim term “a client application on a mobile device” redundant. To be consistent with the claims and avoid redundancy, Petitioner proposes instead that the *full claim term* “a client application *on a mobile device*” be construed as “a program present on the sender’s mobile device.” With that caveat, Petitioner applies this construction for purposes of this Petition and explains herein that the prior art in the Petition invalidates the challenged claims under this construction.

XI. BRIEF DESCRIPTION OF THE APPLIED PRIOR ART

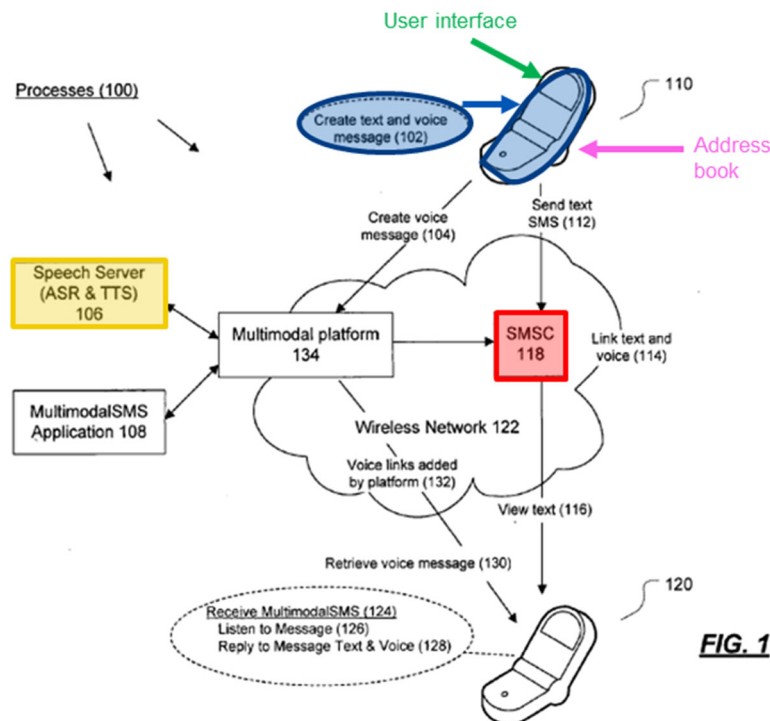
A. Mumick’955 (Ex-1007)

Mumick’955, titled “Techniques for Combining Voice with Wireless Text Short Message Services,” was published as US2005/0136955 on June 23, 2005. Ex-1007, Cover. Mumick’955 is §102(b) prior art.

Mumick’955 discusses “a Multimodal SMS mechanism (MultimodalSMS)” for “combining speech, or other modalities (such as image or video data), with standard text SMS” to enable “users to send and receive voice messages associated directly with text SMS messages.” Ex-1007 ¶8. Specifically, Mumick’955’s mobile device user “creates any text message she wishes to send ... and determines to whom

⁶ Emphases have been added herein unless otherwise noted.

the message is to be sent using whatever mechanisms are provided by the device.”
Id. ¶40; *see also id.* at Fig. 1 (blue). If the user “wishes to add speech to the SMS message, she clicks on a MultimodalSMS link in her phone book, or similar mechanism provided by the device,” (pink) “which connects her through the voice network” to a Multimodal Platform. Ex-1007 ¶40. There, the user is provided instructions “to allow her to record her voice message through the Speech Platform” (yellow), which “is then stored for future retrieval” in a database, Media Server, or “any other storage mechanism ... that facilitates storing audio content.” *Id.*



The user “then sends the SMS message which is transmitted through the SMS network” to the Short Message Service Center (SMSC) (red), which further “transmits the message to the recipient and also communicates a link within the

message that allows the Multimodal Platform ... to uniquely associate the SMS message and the stored voice message.” *Id.* Mumick’955 also explains that the “the link embedded in an SMS message can be created at the sending device.” *Id.* ¶27; Ex-1002 ¶¶57-60.

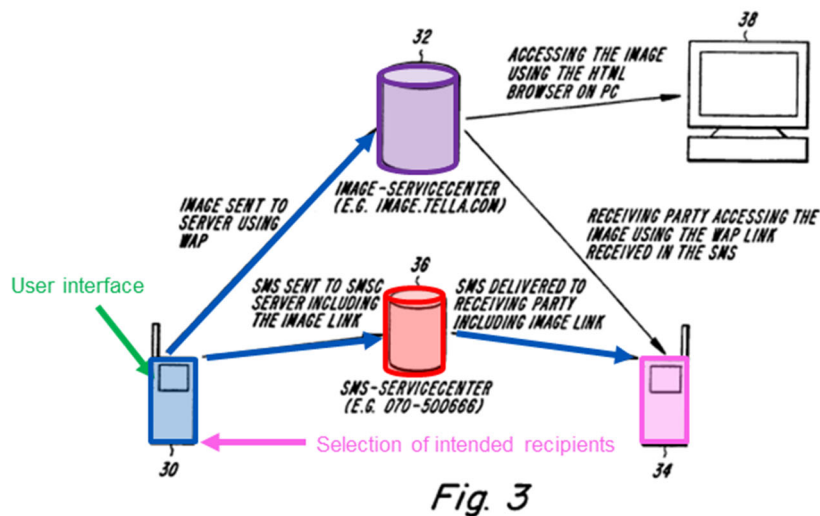
B. Bengtsson (Ex-1005)

Bengtsson, titled “A System and Method for Sending Multimedia Attachments to Text Messages in Radio-communication Systems,” was published as WO2001/013656 on February 22, 2001. Ex-1005, Cover. Bengtsson is §102(b) prior art.

Bengtsson discloses systems “for communicating multimedia attachments to short text messages in radiocommunication systems.” Ex-1005, 1:9-10. Specifically, Bengtsson discloses that the user’s mobile terminal may be provided “an audio recorder for recording ... voice” and “used to capture and send audio information” for storage at the terminal. Ex-1005, 7:7-10. Moreover, Bengtsson’s system includes “an advanced messaging application” that enables the system to attach the image or audio files to an SMS message, *id.* at 7:21-23, for transmission to another terminal, *id.* at 7:12-14.

Bengtsson discloses that in the user’s terminal, the “user first creates a conventional SMS message,” Ex-1005, 7:24-25, as shown below in Figure 3 (green). Before the SMS message is sent by the user, the advanced messaging application at

the terminal (blue) prompts the user to ask “whether an attachment file should be included.” Ex-1005, 7:25-27. If the user opts to attach a file, then “certain information is added to the SMS message,” which is then sent to the recipient selected by the user (pink), and “the attachment is sent to a special server” (e.g., server 32 (purple)) for the recipient to retrieve. Ex-1005, 7:30-8:3.

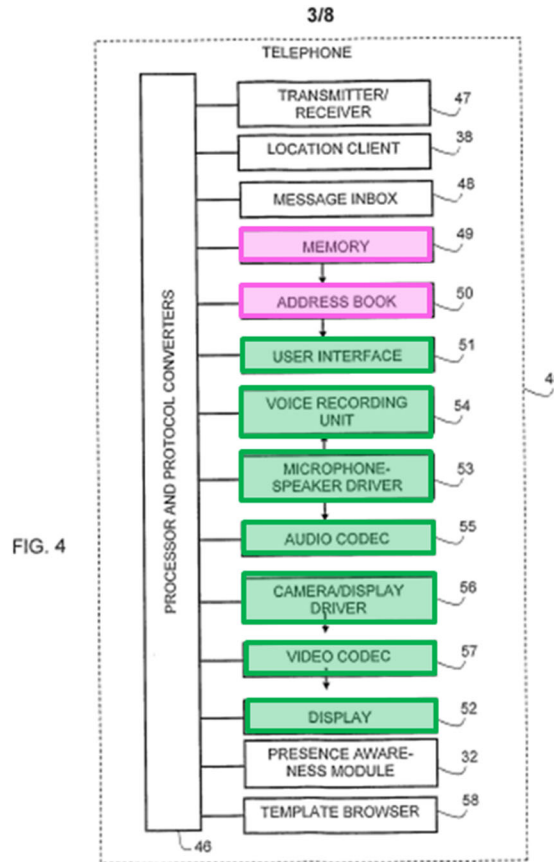


Bengtsson further discloses that the attached image or audio file is not sent directly from terminal 30 to recipient 34; instead, the text part of the message is sent to the recipient via SMS server 36 (red) and “the attachment is transmitted to a different server 32” (purple). Ex-1005, 8:10-14. Specifically, terminal 30 includes a URL address in the SMS message that is sent to the recipient. Ex-1005, 8:21-24. The recipient then receives a “link to the server 32 where the image (or other attached file) is stored” and can be downloaded. Ex-1005, 8:25-28; Ex-1002 ¶¶61-64.

C. Roujinsky (Ex-1006)

Roujinsky, titled “Method and System for Obtaining Feedback from at Least One Recipient Via a Telecommunication Network,” was published as WO2007/020627 on February 22, 2007. Ex-1006, Cover. Roujinsky is §102(a) prior art.

Roujinsky discloses creating—using a sending device—a multimedia message, sending the message to a server for storing with the recipient’s identity, and receiving information regarding the recipient’s response or receipt of the message. Ex-1006, 3:12-19. Specifically, Roujinsky’s system includes cellular telephone 45, *id.* at 9:1-2, that comprises memory 49 for “stor[ing] data” such as sender/recipient profiles and address book 50 (pink), which allows the phone or the system’s server to use the “phone’s contact list or contacts and groups managed by the system,” *id.* at 9:10-15, Fig. 4 (annotated). User interface 51 (green) allows telephone numbers corresponding to recipient addresses to be chosen “for conveying voice and/or video streaming,” *id.* at 9:11-13, and has “a keypad and scrolling keys for typing text messages,” *id.* at 9:15-16.



Telephone 45 also includes microphone/speaker driver 53 (green) that converts speech “to electrical signals for recording using a voice recording unit 54” (green). Ex-1006, 9:17-24. Roujinsky further discloses that “the sender can establish streaming or voice communication with the messaging server and dictate messages for direct storage by the messaging server.” Ex-1006, 18:8-12.

Roujinsky is a WIPO publication of a PCT application published in English and designating the U.S. In addition to the WIPO publication (Ex-1006), the PCT application also published as U.S. Patent Publication 2008/0219416 (“Roujinsky-US”). Thus, Roujinsky-US (Ex-1024) is also §102(e) prior art to the ’978 Patent

based on the August 10, 2006 international filing date of the PCT. The table below includes cross references to identical disclosures in Roujinsky-US corresponding to the Roujinsky cites herein. Substitute IPR grounds based on Roujinsky-US may be used in place of Roujinsky should PO try to swear behind Roujinsky. The identical disclosures of Roujinsky (Ex-1006) and Roujinsky-US (Ex-1024) invalidate the claims for the reasons discussed in Sections XIII.B-XIII.C. Ex-1002 ¶¶65-69.

Roujinsky (Ex-1006)	Roujinsky-US (Ex-1024)
1:2-3	¶1
3:12-19	¶¶11-14
4:10-16	¶23
4:18-20	¶24
7:7-9	¶36
8:5-8	¶37
9:1-2	¶45
9:10-24	¶¶45-46
10:23-24	¶47
11:7-10	¶49
13:3-5	¶54
14:1-5	¶68
16:26-29	¶92
17:3-5	¶93
18:8-12	¶98
Fig. 4	Fig. 4

XII. THE BOARD SHOULD NOT EXERCISE ITS DISCRETION UNDER §325(d) TO DENY HEARING THESE INVALIDITY ISSUES FOR THE FIRST TIME IN THIS PETITION

In considering its discretion under §325(d), “the Board uses the following two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments

previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential).

On the first prong of the *Advanced Bionics* analysis, the Board has held that where “neither [the combination references] nor similar prior art was before the examiner ... the prosecution history does not include any overlapping arguments directed to this prior art.” *Godbersen-Smith Constr. Co. d/b/a Gomaco Corp. v. Guntert & Zimmerman Const. Div., Inc.* IPR2021-00050, Paper 24 at 19-21 (PTAB May 7, 2021). And in such a case, where the first prong of *Advanced Bionics* is not met, the Board “need not address part two of the analysis.” *Id.* at 21.

Here, the first *Advanced Bionics* prong is not met. None of the references relied upon in this petition (i.e., Bengtsson, Roujinsky, and Mumick’955) were presented to the examiner. Nor were any similar disclosures or teachings presented to the examiner. The ’978 Patent does cross reference and incorporate by reference U.S. Patent No. 7,184,786 (“’786 Patent”), which is the issued patent for Mumick’955. But, unlike the ’786 Patent, Mumick’955 is §102(b) prior art to the ’978 Patent and cannot be sworn behind. Moreover, neither Mumick’955 nor the ’786 Patent were listed on an IDS for the examiner to consider during prosecution,

nor is there any evidence in the record that either was ever considered by the examiner or applied in a rejection. *See* MPEP §609.05 (“The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, applications, or other information submitted for consideration by the Office, and MPEP §609.04(a), subsection I, states, ‘the list may not be incorporated into the specification but must be submitted in a separate paper.’ ***Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.***”); *see also Qualcomm Inc. v. Daedalus Prime LLC*, IPR2023-00567, Paper 13 at 18-19 (PTAB Oct. 11, 2023) (the Board was not “willing to presume Sutardja ’785 was considered” by the examiner “simply because it was incorporated by reference in” another reference cited during prosecution). Accordingly, none of the grounds or arguments based on these disclosures were previously presented to the examiner, yet they are directly material to patentability. Because the first *Advanced Bionics* prong is not met, the Board need not move to the second prong. *Oticon Med. AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15 at 20 (PTAB Oct. 16, 2019) (precedential) (declining to exercise discretion when “new, noncumulative prior art [is] asserted in the Petition”).⁷

⁷ Note that the first prong of *Advanced Bionics* is also not satisfied because all of the

Even assuming the Board were to reach it, however, the second *Advanced Bionics* prong makes clear that institution should not be denied under §325(d) because, to the extent it is deemed considered, it would have been a material error to overlook Mumick’955. *See Advanced Bionics*, Paper 6 at 8 n.9 (explaining that certain of the factors laid out by the Board in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential), may be particularly useful for determining, in the second prong, whether the examiner “erred”). Specifically, “[a]n example of a material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.” *Id.* at 8 n.9. “For example, if the record of the Office’s previous consideration of the art is not well developed or silent, then a petitioner may show the Office erred by overlooking something persuasive under factors (e) and (f).” *Id.* at 10. *Becton, Dickinson* factors (e) and (f) are: “(e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.” *Id.* at 9 n.10.

Ground 3 references were indisputably never before the examiner, and the secondary references in Grounds 1-2 were indisputably never before the examiner.

Here, the Examiner would have materially erred by overlooking the clear and unambiguous teachings of Mumick’955, which include disclosures identical to the ’786 Patent. As explained in detail in Section XIII.A, Mumick’955 (in combination with other prior art not of record) renders obvious challenged independent Claim 10. As just one example, applicant’s arguments during prosecution regarding limitations 10[d] and 10[e] resulted in allowance. Ex-1004, 139, 145-146 (applicant arguing the prior art “do[es] not provide a client application for transmitting a voice message notification with a text SMS and also do[es] not disclose that a recipient of the text SMS comprising the voice message notification can access and listen to the voice message stored in the server”). These limitations are plainly taught by Mumick’955. *See infra* Section XIII.A. Moreover, it was also material error to overlook Mumick’955 because it is §102(b) prior art that cannot be sworn behind and is available in obviousness combinations.

Because Mumick’955 in combination with Bengtsson at least renders obvious all elements of independent Claim 10, including elements that were argued by applicant to distinguish the prior art during prosecution, it would have been an error for the examiner to have overlooked Mumick’955’s teachings had it been considered. *Advanced Bionics*, Paper 6 at 10 (if record not well developed or silent on material prior art, error can be shown by “something persuasive”).

In view of the foregoing, the Board should not exercise its discretion under §325(d) to deny institution.

XIII. DETAILED EXPLANATION OF THE UNPATENTABILITY GROUNDS

A. Ground 1: Claims 10-13 are rendered obvious by Mumick’955-Bengtsson

1. A POSITA would have been motivated to combine Mumick’955-Bengtsson and had a reasonable expectation of success

In addition to the reasons set forth below, a POSITA would have been motivated to combine the teachings of Mumick’955 and Bengtsson (“Mumick’955-Bengtsson”) and would have had a reasonable expectation of success in doing so because each relates to systems and methods for transmitting multimedia messages, including voice associated with SMS messages. Ex-1005, Abstract, 7:7-10; Ex-1007 ¶8. For example, Mumick’955 states that a user creates a text message and determines who to send it to “using whatever mechanisms are provided by the [user’s mobile] device.” Ex-1007 ¶40. The user may “add speech to the SMS message” by clicking on a link or similar mechanism provided by the device, which connects the user to a “Multimodal Platform” where they are given instructions on how to record a voice message. *Id.* The user “then sends the SMS message which is transmitted” to a “Short Message Service Center (SMSC),” which further “transmits the message to the recipient and also communicates a link within the message that allows the

Multimodal Platform ... to uniquely associate the SMS message and the stored voice message.” *Id.*

Bengtsson discloses a method wherein a user “creates a conventional SMS message” at their mobile terminal; before the message is sent, an advanced messaging application at the terminal *prompts* the user to ask “whether a[voice] attachment file should be included”; and if the user opts to attach a file then a URL address to the file is added to the SMS message, which is sent to the recipient, and “the attachment is sent to a special server for retrieval by the recipient.” Ex-1005, 7:23-8:3.

A POSITA would have looked to Bengtsson for additional implementation options and details for integrating a voice message to a text message and been motivated to combine Mumick’955 with Bengtsson. Ex-1002 ¶¶70-72. In particular, a POSITA would have recognized a benefit of incorporating the additional functionalities of Bengtsson’s client application on the mobile device, such as its ability to intercept a user’s text message and prompt the user to add a voice message, into Mumick’955’s system. Ex-1002 ¶72. Mumick’955 already teaches a client application on the mobile device that integrates voice content to a text message but explains that the user should click a “link in her phone book, or similar mechanism provided by the device,” to add voice. Ex-1007 ¶40. A POSITA would have recognized that such “a similar mechanism” for the user to integrate voice content

would be to implement Mumick’955’s client application to intercept the user’s text message and prompt the user to add voice, as taught by Bengtsson. Ex-1002 ¶¶72-73. This would have streamlined the process for the user, as opposed to having to click on a separate link as in Mumick’955’s application. *Id.* Including more user-friendly functionality on a client application on the mobile device would have been an obvious design choice to a POSITA as it would have ensured a faster and more flexible and reliable user experience. *Id.*; *see also id.* ¶¶32-46; Ex-1025, 78, 97; Ex-1030, 34; Exs-1026-1027; Exs-1029-1041; Ex-1043.

A POSITA would have had a reasonable expectation of success in combining Mumick’955-Bengtsson because they both disclose straightforward applications of well-known technologies using standard hardware and software systems such as client applications present on mobile devices and multimodal messaging. Ex-1002 ¶74. As such, it would have been well within the skill of a POSITA to implement the prompting capabilities of Bengtsson’s client application into Mumick’955’s client application. *Id.*; Ex-1005, 7:23-8:3; Ex-1007 ¶40.

2. Claim 10

a. Element 10[pre]: A system for voice short message service messaging, comprising:

Mumick’955-Bengtsson teaches Claim 10’s preamble to the extent it is limiting. Ex-1002 ¶75. Mumick’955 discloses “[c]ombining speech with existing text wireless” SMS “to create a multimodal SMS service.” Ex-1007, Abstract.

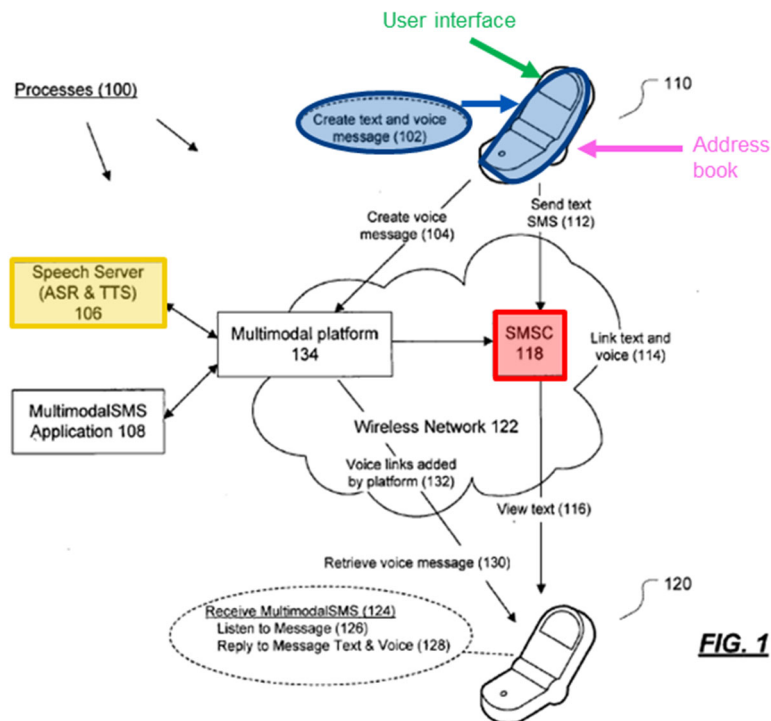
Specifically, Mumick’955 discloses “a Multimodal SMS mechanism (MultimodalSMS)” for “combining speech, or other modalities (such as image or video data), with standard text SMS” to enable “users to send and receive voice messages associated directly with text SMS messages.” Ex-1007 ¶8.

b. Element 10[a]: a client application on a mobile device, wherein said client application integrates voice content to a text message created by a user using methods of recipient addressing as used by text short message service messaging;

Mumick’955-Bengtsson teaches Element 10[a]. Ex-1002 ¶76. Mumick’955 teaches a client application on a mobile device. *Id.* Specifically, Mumick’955’s system includes “user input and/or output devices including those capable of playing and recording speech and those capable of entering and displaying text information.” Ex-1007 ¶9. Mumick’955 provides examples of such devices, including “Personal Digital Assistants (PDA),” and explains that “a PDA that supports simultaneous multimodal applications could be used to enter text via a keyboard while recording the voice portion of the message.” *Id.* ¶50. Mumick’955 envisions that the client application would also be able to access a contacts list. *Id.* ¶47.

Mumick’955’s client application integrates voice content to a text message created by a user. Ex-1007 ¶40. Specifically, Mumick’955 teaches with Figure 1 an exemplary process for creating a MultimodalSMS message. *Id.* The mobile device user “creates any text message she wishes to send” and “determines to whom the

message is to be sent using whatever mechanisms are provided by the device.” *Id.*; *see also id.* ¶8 (disclosing “standard wireless telephone devices capable of sending and receiving SMS text messages”), Fig. 1 (blue). If the user “wishes to add speech to the SMS message, she clicks on a MultimodalSMS link in her phone book, or similar mechanism provided by the device, which connects her through the voice network” to a Multimodal Platform. Ex-1007 ¶40. The user is given instructions “to record her voice message through the Speech Platform” (yellow). *Id.* The user “then sends the SMS message which is transmitted through the SMS network” to the SMSC (red), which further transmits it “to the recipient and also communicates *a link within the message* that allows the Multimodal Platform ... to uniquely associate the SMS message and the stored voice message.” *Id.* The link embedded in the message “can be created at the sending device” (*id.* ¶27), thus integrating the voice content to the text message. Ex-1002 ¶77.



A POSITA would have understood that Mumick’955’s client application integrates voice content to a text message in the same manner as the ’978 Patent. Ex-1002 ¶78. For example, the ’978 Patent’s “client application 201a communicates with the server 314” where the voice message is stored to receive “the information required for the construction of the voice message notification” and “add[s] the voice message notification to the text SMS message.” Ex-1001, 7:29-36. The voice message notification *may be a link to the voice message. Id.* at 5:7-12 (“Bob and Mary, upon receiving the text SMS message may click on a ‘Listen to Voice message’ link included in the voice message notification.”); Ex-1002 ¶¶79-80.

As noted above, Mumick’955 also discloses that the text message is “created by a user using methods of recipient addressing as used by text short message service

messaging.” Ex-1007 ¶47. Specifically, Mumick’955 discloses that “[i]f contacts are stored in the device ... they can also be used in addressing a MultimodalSMS message.” *Id.* In particular, Mumick’955 discloses that the contacts may “be accessed as part of the Multimodal application, by using an application on the device.” *Id.*

Additional implementation details are also taught by Bengtsson, which, instead of having the user select a link, affirmatively “prompts” a user to optionally attach voice content to a text message. Ex-1005, 7:25-27. Specifically, Bengtsson teaches “an advanced messaging application” on the sending device that enables the user to attach an audio file (i.e., voice message) to an SMS message created by the user in their mobile terminal for transmission to another mobile terminal. Ex-1005, 7:21-25, 6:9-12. A POSITA would have understood that Bengtsson’s advanced messaging application in the mobile terminal is “a client application on a mobile device” because Bengtsson’s invention is described in terms of a client-server architecture, wherein the mobile terminal is the client. Ex-1005, 5:2-10 (describing Bengtsson’s invention in terms of mobile (e-mail) client and SMS server); Ex-1002 ¶¶81-83 (providing background on client-server architecture); Ex-1025, 91. Moreover, a POSITA would have understood that Bengtsson’s advanced messaging application in the mobile terminal is a program present on the sender’s mobile device. Ex-1002 ¶84.

In Bengtsson, the “client application integrates voice content to a text message created by a user.” Ex-1005, 7:23-8:3. In Bengtsson’s application, the “user first creates a conventional SMS message” (green). Ex-1005, 7:23-25, Fig. 3 (annotated). Before the SMS message is sent, the advanced messaging application at terminal 30 (blue) prompts the user to ask “whether an attachment file should be included.” Ex-1005, 7:25-27. If the user opts to attach a voice message, then “certain information is added to the SMS message,” which is then sent to the recipient selected by the user (pink), and “the attachment is sent to a special server,” e.g., server 32 (purple) for the recipient to retrieve. Ex-1005, 7:30-8:3. Terminal 30’s application “includes the URL address (e.g., image.telia.com/sending-phone-number/image-number) as part of the text that is sent” as an SMS message to the recipient. *Id.* at 8:21-24.

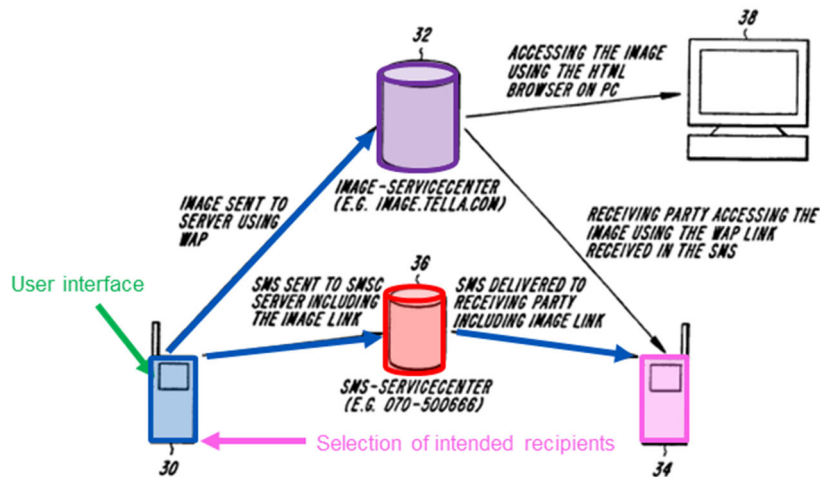


Fig. 3

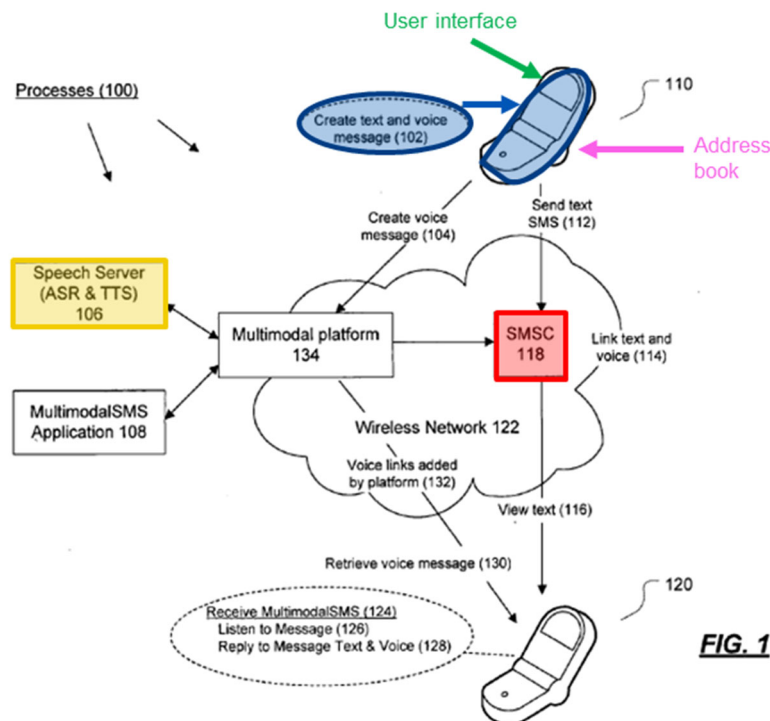
A POSITA would have understood that Bengtsson’s advanced messaging application “integrates voice content to a text message created by a user,” as claimed,

because it incorporates the voice message notification into the text message created by the user in the same way as the '978 Patent, that is, by prompting the user. Ex-1002 ¶¶81, 85-89. That is, in the '978 Patent, the client application “prompts 104b the user 202 as to whether a voice SMS message needs to be included.” Ex-1001, 3:42-46. If the user wishes to “add a voice SMS message, the client application 201a connects the mobile device 201 to a server 314” to record and store the message and transmits a “voice message notification” with the text SMS message “to the addressed recipients.” Ex-1001, 3:48-54. The voice message notification may be a link to the voice message, which the user may click to listen to. *Id.* at 5:7-12. Accordingly, as with the '978 Patent, Bengtsson integrates voice content to a text message, by prompting the user to attach voice content and then including a voice message notification (i.e., link) to the voice message in the text message. Ex-1002 ¶90.

A POSITA would have been motivated to combine Mumick'955 with Bengtsson and had a reasonable expectation of success in doing so for the reasons explained in Section XIII.A.1, namely, to obtain a more user-friendly functionality to ensure a faster and more flexible and reliable user experience. Ex-1002 ¶¶91-93.

c. **Element 10[b]: a memory storage means on said mobile device for storing a list of addresses of recipients;**

Mumick’955-Bengtsson teaches Element 10[b]. Ex-1002 ¶94. Mumick’955 teaches “a memory storage means” on the mobile device “for storing a list of addresses of recipients.” Ex-1007 ¶40. Specifically, Mumick’955’s mobile device user creates a MultimodalSMS message by first creating “any text message she wishes to send” and “determin[ing] to whom the message is to be sent using whatever mechanisms are provided by the device.” *Id.* If the user “wishes to add speech to the SMS message, she clicks on a MultimodalSMS link *in her phone book, or similar mechanism provided by the device*” (Fig. 1 (pink)). *Id.*

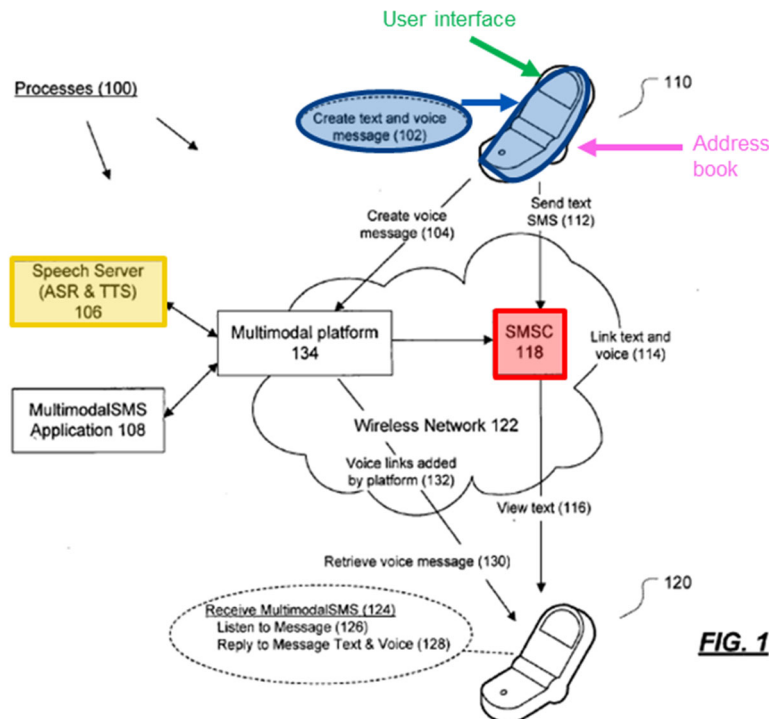


Mumick’955 further states that the “MultimodalSMS application may provide a user with the capability of *storing*, editing and applying *lists of recipients* so that a message can be distributed to a number of recipients.” Ex-1007 ¶44. Moreover, if the user’s “contacts are stored in the device ... they can also be used in addressing a MultimodalSMS message.” Ex-1007 ¶47. A POSITA would have understood that Mumick’955’s phone book and stored contacts lists in the mobile device meet the claimed “memory storage means” because their functions are to “stor[e] a list of addresses of recipients” (Ex-1007 ¶¶40, 47) and their structure can be a memory, including any medium from which a computer can read for storing data such as addresses, such as flash, EEPROM, or another type of non-volatile memory for storing data such as addresses. Ex-1002 ¶¶95-96; Ex-1030, 34.

d. Element 10[c]: a user interface on the mobile device for said user to input voice messages and text messages; and

Mumick’955-Bengtsson teaches Element 10[c]. Ex-1002 ¶97. Mumick’955 discloses “a user interface on the mobile device” for the “user to input voice messages and text messages.” Ex-1007 ¶9. Specifically, Mumick’955 discloses that its system includes “*user input and/or output devices including those capable of pickup and playback of speech and those capable of entering and displaying text information.*” Ex-1007 ¶9, Fig. 1 (green). Mumick’955 further discloses that “[t]he text input device is used to compose a message to be sent using standard SMS

technology.” Ex-1007 ¶10. Moreover, Mumick’955 discloses that a voice message can be input using a microphone on the mobile device. *Id.* at Cl. 10 (“inputting said audio message into a first wireless telephone by using a microphone associated with said first wireless telephone”).



- e. **Element 10[d]: a server for remotely recording and storing said voice messages of the user, wherein said server is configured to provide access to said recipient for listening to said recorded voice message; and**

Mumick’955-Bengtsson teaches Element 10[d]. Ex-1002 ¶98. Mumick’955 discloses “a server for remotely recording and storing” the “voice messages of the user.” Ex-1007, Abstract. Specifically, Mumick’955’s system includes a “speech server” that can be utilized “for recognition of voice commands, rendering of text

into speech, *and recording or playing back voice recordings.*” *Id.* Mumick’955 states that a user that wishes “to add speech to the SMS message” created at the user’s device may “click[] on a MultimodalSMS link in her phone book, or similar mechanism provided by the device,” and be connected “through the voice network” to the Multimodal Platform. Ex-1007 ¶40. The user is given instructions “to allow her to *record her voice message through the Speech Platform,*” as shown in Figure 2 (yellow),⁸ which “is then stored for future retrieval in database 214.” Ex-1007 ¶40. Moreover, Mumick’955 states that “[t]he specific storage mechanism used *may include a Media Server, a database or any other storage mechanism 107 that facilitates storing* audio content” (purple). Ex-1007 ¶40.

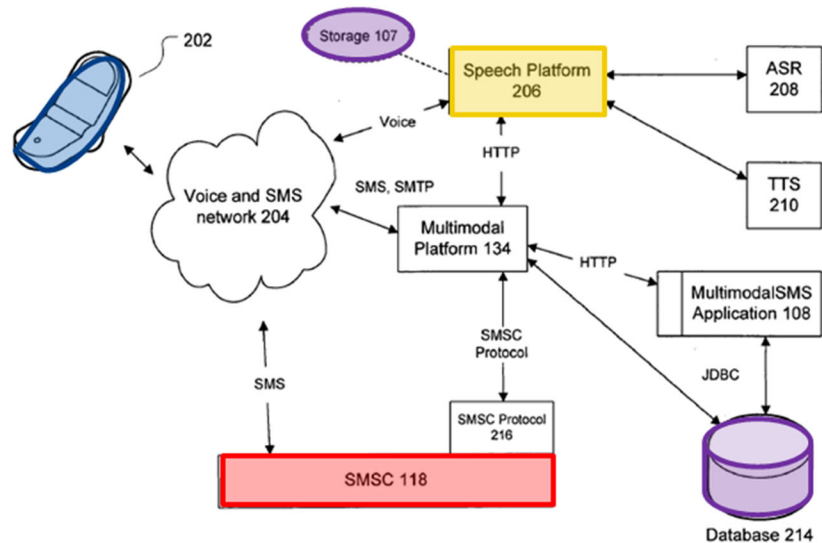


FIG. 2

⁸ Figure 2 is a more detailed example architecture of the system shown in Figure 1. Ex-1007 ¶39.

Mumick'955 further discloses a server that "is configured to provide access to" the "recipient for listening to" the "recorded voice message." Ex-1007 ¶40. In particular, after a voice message is recorded, the SMSC (red), "transmits the message to the recipient and also communicates a link within the message that allows the Multimodal Platform 134 to uniquely associate the SMS message and the stored voice message." *Id.* For example, the Multimodal Platform, when accessed, retrieves the voice message "from the Speech Platform" or "from a media server or database" where it was stored. *Id.*; Ex-1002 ¶99.

Although Mumick'955 teaches using two servers to record and store the voice messages (speech and media servers), the phrase "a server" in element 10[d] would have been understood by a POSITA to mean "at least one server." *See, e.g., 01 Communique Lab. Inc. v. LogMeIn Inc.*, 687 F.3d 1292, 1296-97 (Fed. Cir. 2012) (finding "a location server computer" was not limited to a "single physical computer" because "[a]s a general rule, the words 'a' or 'an' in a patent claim carry the meaning of 'one or more'" and an exception "arises only 'where the language of the claims themselves, the specification, or the prosecution history necessitate a departure from the rule'").

Moreover, a POSITA would have understood that the term "a server" in this independent claim is not limited to only a single server implementation, because the independent claims must be consistent with narrower dependent claims that require

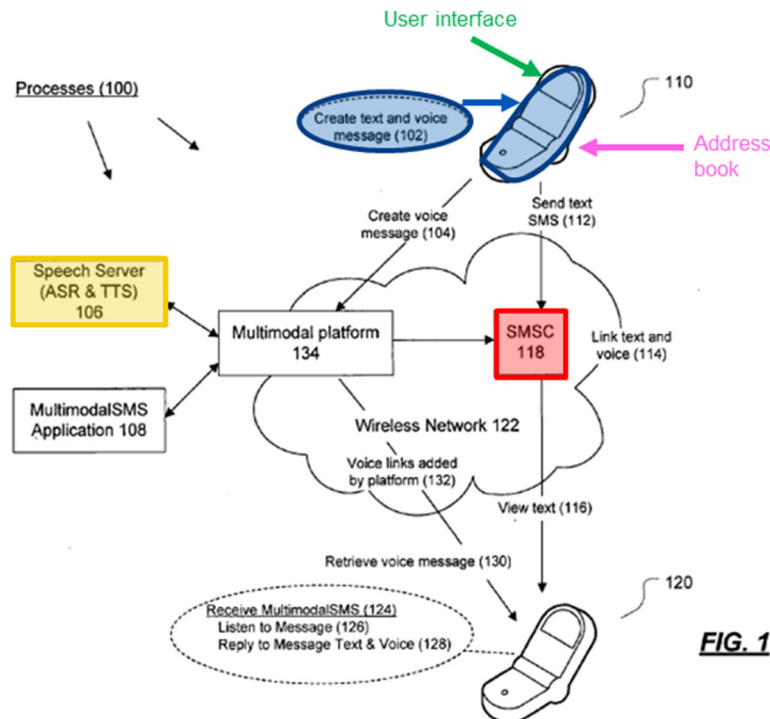
at least two servers (*see* Cls. 11-12; *see also* Fig. 3A (depicting first server 314a and second server 314b)). Ex-1002 ¶100. A POSITA would have known that Mumick’955’s servers would have provided redundancy and reliability as well as scalability—all of which would have been motivations to use multiple servers. *Id.* Furthermore, a POSITA would have known that multiple servers could have been structured to put different services on different servers. *Id.* For example, both database and web servers were commonly used to store and communicate information, respectively and those are examples of services that could easily and would frequently be put on multiple servers. Ex-1002 ¶¶101-105; Ex-1027; Ex-1029, 29-30, 50-54.

f. Element 10[e]: said client application for transmitting a voice message notification with an addressed text message to said recipients.

Mumick’955-Bengtsson teaches Element 10[e]. Ex-1002 ¶¶106-108.

Mumick’955 teaches that the client application transmits a voice message notification with an addressed text message to the recipients. Ex-1007 ¶40. Specifically, if the user creates a text message and “wishes to add speech ... she clicks on MultimodalSMS link,” and is given instructions “to record her voice message through the Speech Platform” (yellow). *Id.* The user “then sends the SMS message which is transmitted through the SMS network” to the SMSC (red), which further “transmits the message to the recipient and also communicates a link within

the message that allows the Multimodal Platform ... to uniquely associate the SMS message and the stored voice message.” *Id.* Mumick’955 further states that “the link embedded in an SMS message *can be created at the sending device.*” Ex-1007 ¶27; *see also id.* at Cl. 10.



Mumick’955 states that “[w]hen the message is received by the user ... there is a telephony link embedded in the message that, using whatever method is available on the recipients’ device, once accessed, connects the recipient to the Multimodal Platform,” which then “retrieves the voice message from the Speech Server” or other storage mechanism “and plays it to the recipient.” Ex-1007 ¶41.

To the extent that a POSITA would have desired additional implementation details, such as the form of the appropriate links in the voice message notification,

these details are also taught by Bengtsson. Ex-1002 ¶¶109-112. Specifically, Bengtsson's system includes "an advanced messaging application" that enables the system to attach a voice message notification to an SMS message created by the user. Ex-1005, 7:21-25; Ex-1025, 91.

In Bengtsson's mobile terminal, the "user first creates a conventional SMS message" (green). Ex-1005, 7:23-25, Fig. 3 (annotated). If the user opts to attach a voice message file, then the SMS message "includes the URL address (e.g., image.telia.com/sending-phone-number/image-number) as part of the text that is sent." Ex-1005, 8:21-24. The recipient therefore receives "the link to the server 32 [purple] where the image (or other attached file) is stored and, optionally, a file type associated with the attachment," and "may choose to download the image from server 32 using, e.g., WAP, to his or her terminal 34." Ex-1005, 8:25-29; *see also id.* at 9:1-10 ("[R]eceiving terminal 34 sends, e.g., a Wireless Session Protocol (WSP) request with the URL to a WAP Gateway/Proxy 40, which provides protocol conversion, encoding/decoding, etc. of the signals transmitted therethrough.").

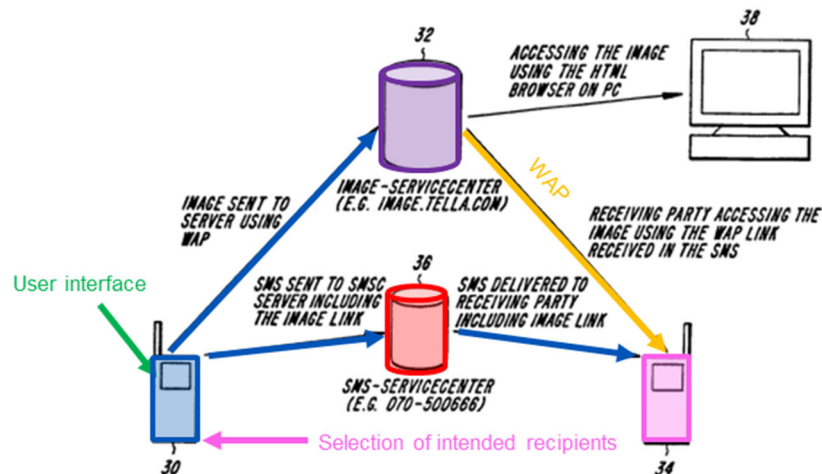


Fig. 3

Therefore, the recipient “receives a message containing the text message” and “the link to the server 32 where the image (or other attached file) is stored” and can be downloaded. Ex-1005, 8:25-28; Ex-1002 ¶¶113-116. A POSITA would have understood that the “link to the server 32 where the image (or other attached file) is stored” is a voice message notification because the link notifies the recipient of the existence of the voice message, and the ’978 Patent itself discloses using links for notifications. Ex-1001, 5:7-16; Ex-1002 ¶116.

A POSITA would have been motivated to refer to Bengtsson’s teachings to obtain the benefit of its use of a specific URL address (or similar such unique identifier) linking the stored voice message to the text message that is sent to the recipient with Mumick’955’s voice notification and would have had a reasonable expectation of success in doing so. Ex-1002 ¶¶117-118. Mumick’955 already teaches that the embedded link that allows the Multimodal Platform to “uniquely

associate the SMS message and the stored voice message,” Ex-1007 ¶40, may be “created at the sending device.” Ex-1007 ¶27. A POSITA would have been interested in examples of embedded links that “uniquely associate the SMS message and the stored voice message” and would have looked to Bengtsson’s teachings as appropriate. Ex-1002 ¶¶117-118. A POSITA would have had a reasonable expectation of success in combining Mumick’955-Bengtsson for the reasons explained in Section XIII.A.1. *Id.*

3. Claim 11: The system of claim 10, wherein said server comprises a first server for storing the voice messages of the user.

Mumick’955-Bengtsson teaches Claim 11. Ex-1002 ¶119. Mumick’955 discloses a server for the same reasons described in Section XIII.A.2.e. *See, e.g.*, Ex-1007, Abstract (speech server can be utilized for “recording or playing back voice recordings”). Mumick’955 further discloses a first server for storing the voice messages of the user. Ex-1007 ¶40. Specifically, Mumick’955 discloses that a user that wishes “to add speech to the SMS message” created at the user’s device may “click[] on a MultimodalSMS link in her phone book, or similar mechanism provided by the device” “to allow her to record her voice message through the Speech Platform.” Ex-1007 ¶40, Fig. 2 (yellow). “The recorded voice message is then stored for future retrieval in database 214.” Ex-1007 ¶40. Moreover, Mumick’955 discloses that “[t]he specific storage mechanism used may include a

Media Server, a database or any other storage mechanism 107 that facilitates storing audio content” (purple). Ex-1007 ¶40. Accordingly, at least a Media Server or database is the first server for storing the voice messages. Ex-1002 ¶119.

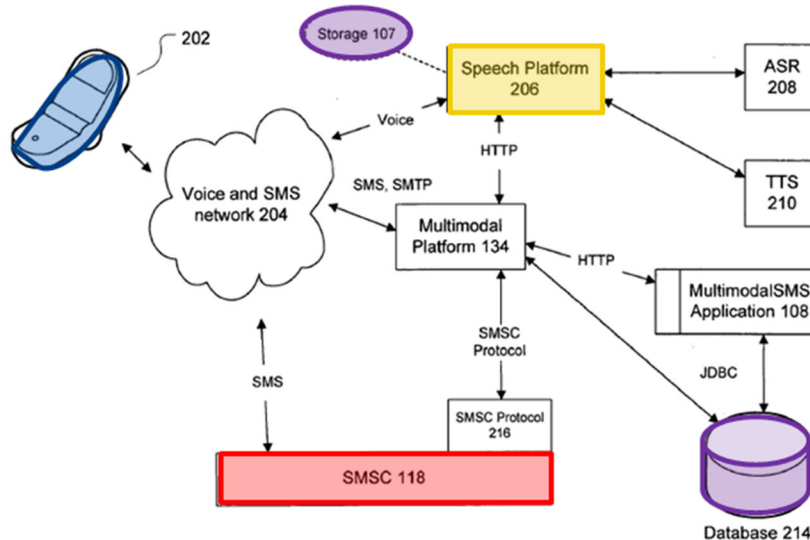


FIG. 2

4. **Claim 12:** The system of claim 10, wherein said server comprises a second server for transmitting said voice message notification with said addressed text message to the recipients.

Mumick’955-Bengtsson teaches Claim 12. Ex-1002 ¶120. Mumick’955 discloses a server for the same reasons described in Section XIII.A.2.e. *See, e.g.*, Ex-1007, Abstract. Mumick’955 further discloses a second server for transmitting the voice message notification with the addressed text message to the recipients. The user “sends the SMS message which is transmitted through the SMS network 204 to the” SMSC (red), which then “transmits the message to the recipient and also communicates a link within the message that allows the Multimodal Platform 134 to

uniquely associate the SMS message and the stored voice message.” Ex-1007 ¶40. For example, “voice is sent as part of an SMS message by including within the SMS message a link to retrieve the voice message from another location.” *Id.* Accordingly, at least the SMSC is the second server for transmitting the voice message notification with the addressed text message to the recipients. Ex-1002 ¶121.

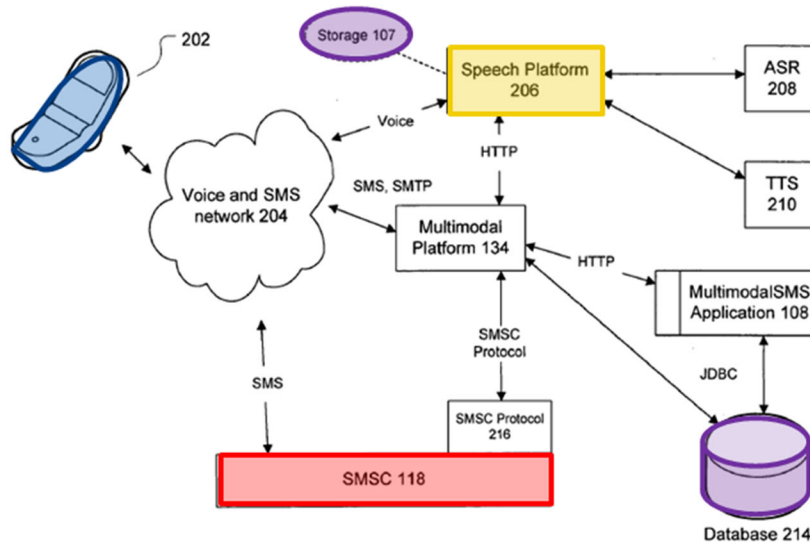
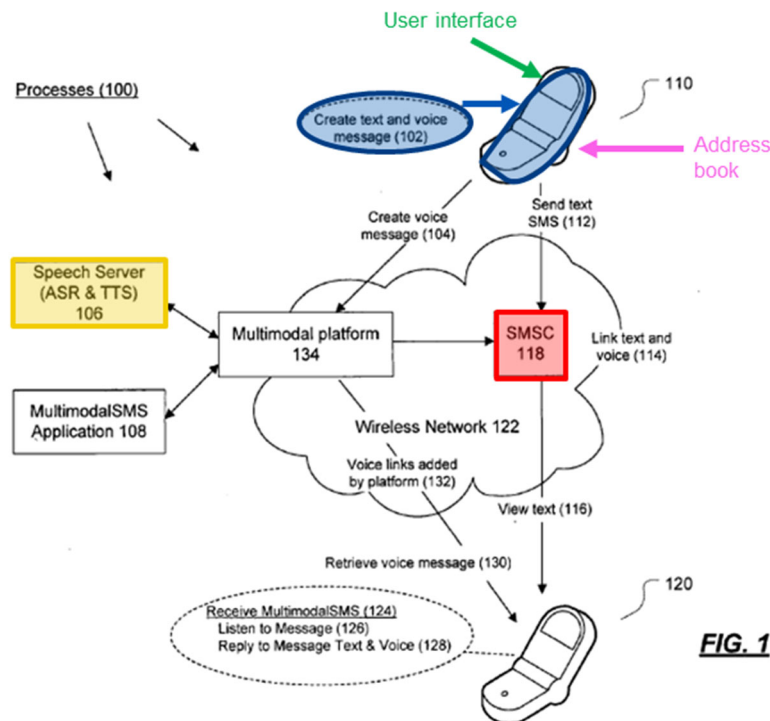


FIG. 2

5. Claim 13: The system of claim 10, wherein the client application transmits one of a text message, a voice message, and a combination thereof.

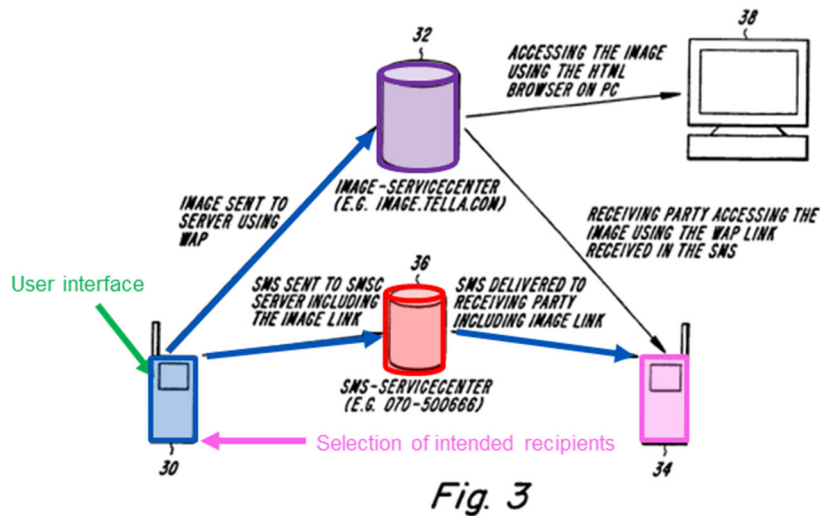
Mumick’955-Bengtsson teaches Claim 13. Ex-1002 ¶122. Mumick’955 teaches a client application on the mobile device for the same reasons described in Sections XIII.A.2.b/XIII.A.2.f. *See, e.g.*, Ex-1007 ¶40. Mumick’955 further teaches that the client application transmits one of a text message, a voice message, and a combination thereof. *Id.* Specifically, Mumick’955 explains that the user creates a

text message “and determines to whom the message is to be sent.” *Id.* ¶40, Fig. 1 (blue). If the user “wishes to add speech to the SMS message, she clicks on a MultimodalSMS link in her phone book, or similar mechanism provided by the device, which connects her through the voice network” to a Multimodal Platform. Ex-1007 ¶40. There, the user is provided instructions “to record her voice message through the Speech Platform” (yellow). *Id.* The user “then **sends the SMS message** which is transmitted through the SMS network” to the SMSC (red). *Id.*



This claim is also taught by Bengtsson. Bengtsson teaches a client application on the mobile device for the same reasons described in Sections XIII.A.2.b/XIII.A.2.f. *See, e.g.*, Ex-1005, 7:21-25 (Bengtsson’s advanced messaging application enables the system to attach an image or audio file to an SMS message

for transmission to another mobile terminal), 6:9-12 (Bengtsson's terminal is a mobile terminal), 5:2-10 (Bengtsson's invention is described in terms of a client-server architecture). Bengtsson further teaches that its client application "transmits one of a text message, a voice message, and a combination thereof," as claimed. Ex-1005, 7:23-8:3. Specifically, Bengtsson states that in the user's terminal, the "user first creates a conventional SMS message" (green). Ex-1005, 7:23-25, Fig. 3 (annotated). Before the SMS message is sent by the user, the advanced messaging application at the terminal (blue) prompts the user to ask "whether an attachment file should be included." Ex-1005, 7:25-27. If the user chooses "not attach a file to the SMS message," then it is "transmitted conventionally." Ex-1005, 7:28-30.



If the user opts to attach a file, then "certain information is added to the SMS message," which is then sent to the user-selected recipient (pink), and "the attachment is sent to a special server" for the recipient to retrieve/access. Ex-1005,

7:30-8:3. Bengtsson also states that terminal 30 (where the client application resides) “includes the URL address (e.g., image.telia.com/sending-phone-number/image-number) as part of the text that is sent” as an SMS message to the receiving party. Ex-1005, 8:21-24. A POSITA would have considered this message to be a combination voice/text message as envisioned by the ’978 Patent. Ex-1002 ¶¶123-128; Ex-1025, 91.

A POSITA would have been motivated to combine Mumick’955 with Bengtsson and had a reasonable expectation of success in doing so for the reasons explained in Section XIII.A.1. Ex-1002 ¶¶129-130.

B. Ground 2: Claim 14 is rendered obvious by Mumick’955-Bengtsson-Roujinsky

1. Claim 14: The system of claim 10, wherein the client application is provided on an operating system of the mobile device.

Mumick’955-Bengtsson-Roujinsky teaches a “client application” that “is provided on an operating system of the mobile device.” As explained in Section XIII.A.2.b, it would have been obvious to modify Mumick’955’s client application (Ex-1007 ¶40) to include Bengtsson’s ability to intercept a user’s text message and prompt the user to add a voice message (Ex-1005, 7:25-27), but Mumick’955 does not expressly disclose an operating system. Roujinsky teaches a similar system for creating—using a messaging client on the sending device (Ex-1006, 7:7-9)—a multimedia message and sending the message to a server for storing. *Id.* at 3:12-19.

Roujinsky additionally discloses that its messaging client can “be implemented in a variety of technologies,” such as for example, “Java, J2ME, Brew, Symbian, Linux, Windows, PocketPC, SmartPhone, PalmOS, or others.” Ex-1006, 8:5-8. These are all well-known operating systems. Ex-1002 ¶¶131-132, 135-136 (“The letters ‘OS’ in ‘PalmOS’ stand for ‘operating system.’”).

A POSITA would have been motivated to combine Mumick’955-Bengtsson with Roujinsky because they would have recognized a benefit of incorporating Roujinsky’s teachings of a client application provided *on an operating system* of the mobile device into the combined Mumick’955-Bengtsson system as operating systems were well-known to provide stability for users and efficiency for application developers. Ex-1002 ¶133. For example, building applications on top of existing operating systems allows developers to take advantage of the innumerable technological supports built into those operating systems to reduce the amount of effort that must be spent in building new applications. *Id.* Moreover, Roujinsky discloses that its “messaging client 31 can run on different devices such as mobile phones, smart phones, WDAs PDAs, etc. and be implemented in [a] variety of technologies.” Ex-1006, 8:5-8. Mumick’955’s client application can be used on such devices having operating systems. Ex-1007 ¶50 (PDAs, PocketPCs support multimodal applications). Thus, a POSITA would have been motivated to

incorporate Roujinsky's more detailed teachings regarding implementation of a client application provided on an operating system. Ex-1002 ¶133.

A POSITA would also have had a reasonable expectation of success in combining the teachings of Mumick'955-Bengtsson-Roujinsky. Ex-1002 ¶¶134, 137. Mumick'955-Bengtsson-Roujinsky all disclose systems and methods for transmitting multimedia messages using familiar elements such as client applications on mobile devices, multimodal messaging, and servers that a POSITA would have understood are amenable to various well-understood and predictable combinations. Ex-1005, 7:23-8:3; 1006, 3:12-19; Ex-1007 ¶40; Ex-1033; Ex-1036.

C. Ground 3: Claims 10-14 are rendered obvious by Bengtsson-Roujinsky

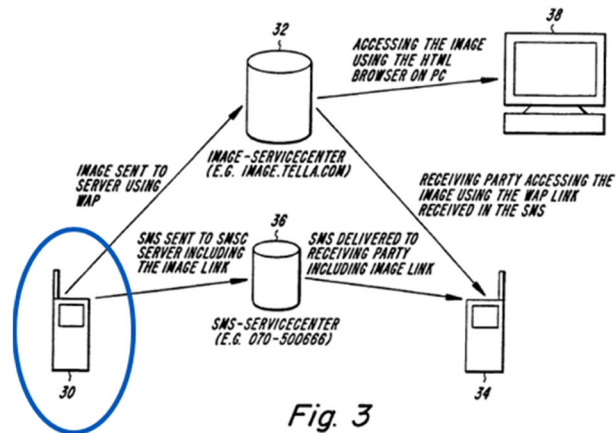
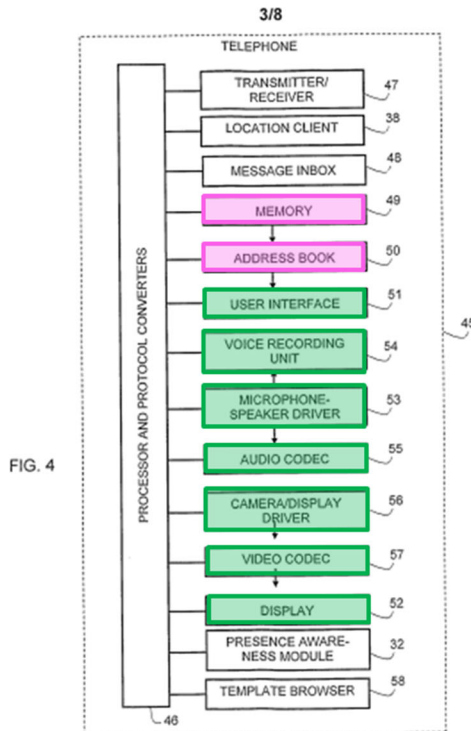
1. A POSITA would have been motivated to combine Bengtsson-Roujinsky and had a reasonable expectation of success

In addition to the reasons set forth below, a POSITA would have been motivated to combine the teachings of Bengtsson and Roujinsky ("Bengtsson-Roujinsky") and would have had a reasonable expectation of success in doing so because each relates to systems and methods for transmitting multimedia messages, including voice associated with SMS messages. Ex-1005, Abstract, 7:7-10; Ex-1006, 1:2-3. For example, Bengtsson discloses a method wherein a user "creates a conventional SMS message" at their terminal; before the message is sent, the terminal prompts the user to ask "whether [a voice] attachment file should be

included”; and if the user opts to attach a file then a URL address to the file is added to the SMS message, which is sent to the recipient, and “the attachment is sent to a special server for retrieval by the recipient.” Ex-1005, 7:23-8:3. Similarly, Roujinsky discloses creating—using a sending device—a voice message, sending the message to a server for storing with the recipient’s identity and transmission to the recipient, and receiving information regarding the recipient’s response or receipt of the message. Ex-1006, 3:12-19. Roujinsky also discloses a memory on the sending device that stores an address book (*id.* at 9:10-15), a user interface for creating and addressing messages (*id.* at 9:11-16), and the ability for voice messages to be dictated by a user (*id.* at 9:17-24, 13:3-5) for remote recording and storage by a server (*id.* at 18:8-12). Ex-1002 ¶¶138-139.

A POSITA would have been motivated to combine Bengtsson-Roujinsky because they would have recognized a benefit of incorporating Roujinsky’s teachings of an address book stored in memory on the sender’s device (Fig. 4 (pink)) and a straightforward user interface for creating and addressing voice and text messages (Fig. 4 (green)) into Bengtsson’s mobile device (Fig. 3 (blue)). Ex-1002 ¶140. A POSITA would have recognized a benefit of allowing the user to use the existing contacts list already on their device when creating and addressing text messages. *Id.* Moreover, incorporating Roujinsky’s well-known user interface and

memory storage elements into Bengtsson's mobile device, would combine familiar elements with predictable results. *Id.*



Furthermore, a POSITA would have been motivated to include the remote recording capabilities via a server of Roujinsky into a system like Bengtsson to take advantage of the more significant resources on a server which would reduce the likelihood, for example, of running out of storage if all voice messages were stored on the sender's device. Ex-1002 ¶141. A POSITA would thus have understood that the combination would result in a more resource-efficient system. *Id.*; Ex-1006, 9:8-10.

A POSITA would also have had a reasonable expectation of success in combining the teachings of Bengtsson-Roujinsky. Ex-1002 ¶142. A POSITA would

have understood that these references both disclose systems and methods for transmitting multimedia messages using familiar elements such as mobile devices, SMS messaging, memory storage, user interfaces, and servers that a POSITA would have understood are amenable to various well-understood and predictable combinations, as explained in further detail below. *Id.*; Ex-1005, 7:23-8:3; Ex-1006, 3:12-19; Ex-1033.

2. Independent Claim 10

a. Element 10[pre]: A system for voice short message service messaging, comprising:

Bengtsson-Roujinsky teaches Claim 10's preamble to the extent it is limiting. Ex-1002 ¶143. Bengtsson discloses systems "for communicating multimedia attachments to short text messages in radiocommunication systems." Ex-1005, 1:9-10. Bengtsson further discloses a user creating an SMS message and attaching a voice file. Ex-1005, 7:8-10 ("an audio recorder for recording audio, **voice**, music, or any kind of sounds, may be provided to the terminal and used to capture and send audio information"), 7:21-27 ("advanced messaging application provides the capability to attach such files to an SMS message"), 8:21-24 (terminal 30 includes "the file type (e.g., image, audio, etc.) of the attachment with the URL address in the SMS message").

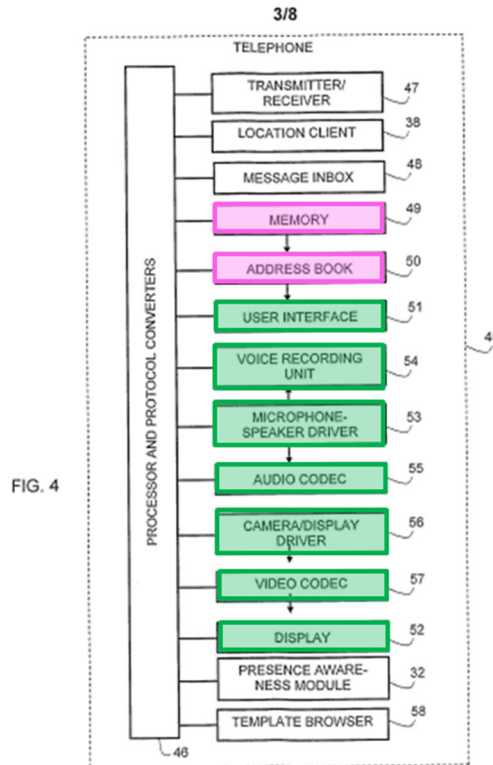
- b. Element 10[a]: a client application on a mobile device, wherein said client application integrates voice content to a text message created by a user using methods of recipient addressing as used by text short message service messaging;**

Bengtsson-Roujinsky teaches Element 10[a]. Ex-1002 ¶¶144-146. Bengtsson teaches a client application on a mobile device that integrates voice content to a text message for the same reasons discussed in Ground 1 (*see* Section XIII.A.2.b). *See, e.g.,* Ex-1005, 7:21-8:3 (before the user sends the SMS message, the advanced messaging application at the mobile terminal intercepts text messages and prompts the user about whether an attachment (e.g., image or audio file) should be included), 6:9-12 (Bengtsson’s terminal is a mobile terminal), 5:2-10 (Bengtsson’s invention is described in terms of a client-server architecture); Ex-1025, 91.

To the extent that Bengtsson does not expressly disclose using “methods of recipient addressing,” it would have been obvious to a POSITA that the message would be created using familiar methods of recipient addressing, such as by the user selecting a recipient’s phone number from their mobile address book, because this was a standard and well-known implementation in mobile devices by 2007, as exemplified by Roujinsky. Ex-1002 ¶¶147-151 (citing other examples); Ex-1030, 34; Ex-1032-Ex-1033; Ex-1034 ¶¶37, 46.

Similar to Bengtsson, Roujinsky’s cellular phone is “enhanced by a software client” (i.e., messaging client 31), Ex-1006, 9:1-2, that is loaded into sending device

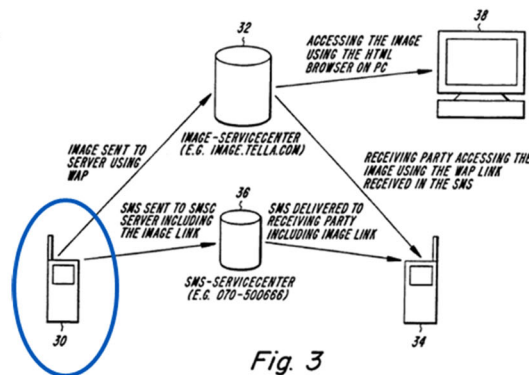
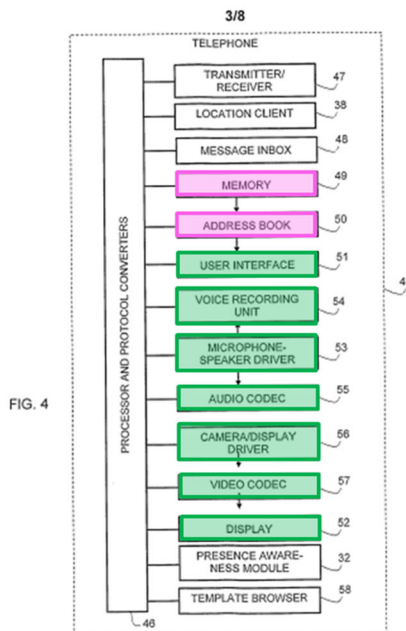
45, *id.* at 7:7-9, Fig. 4 (telephone 45). Roujinsky discloses memory 49 that “stores data” such as sender/recipient profiles and address book 50 (pink), which allows the phone or system’s server to use the “phone’s contact list or contacts and groups managed by the system.” Ex-1006, 9:10-15.



Moreover, Roujinsky discloses that “[t]he sender creates a voice/text message” and selects the “recipients to whom he wishes to send the message.” Ex-1006, 11:7-8; *see also id.* at 14:1-5 (a user interface (green) “allows the sender to choose recipients by list selection, by alphabet, by categories (e.g. family, friends, work), by phone number, and private number and allows a voice tag to be attached to the message”). The recipient information and message are sent by messaging

client 31 from the sender to a server, which processes, stores, and sends the message to the recipients. Ex-1006, 11:8-10.

A POSITA would have been motivated to implement Roujinsky's teachings of an address book on the sender's device (Fig. 4 (pink)) and a user interface (Fig. 4 (green)) for creating messages using methods of recipient addressing into Bengtsson's mobile device (Fig. 3 (blue)), to the extent not already taught, to select an intended recipient for a text message. Ex-1002 ¶¶152-154. That is, a POSITA would have understood to implement this familiar element in mobile messaging clients, as taught by Roujinsky. *Id.* A POSITA would have included Roujinsky's disclosed methods of recipient addressing to allow the user to use their existing contacts when creating text messages. *Id.*

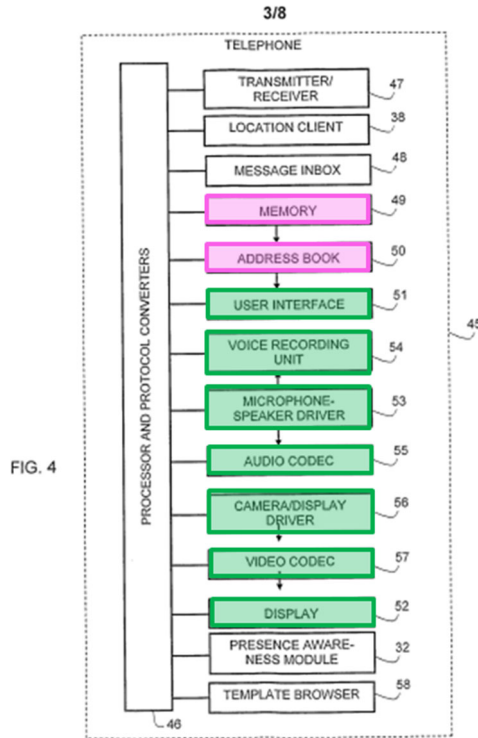


A POSITA would have had a reasonable expectation of success in combining Bengtsson-Roujinsky because they both disclose straightforward applications of well-known technologies using standard hardware and software systems such as mobile devices, SMS messaging, memory storage, and user interfaces. Ex-1002 ¶155. As such, it would have been well within the skill of a POSITA to implement Roujinsky's addressing techniques into Bengtsson's mobile device. *Id.*; Ex-1005, 7:23-8:3; Ex-1006, 3:12-19.

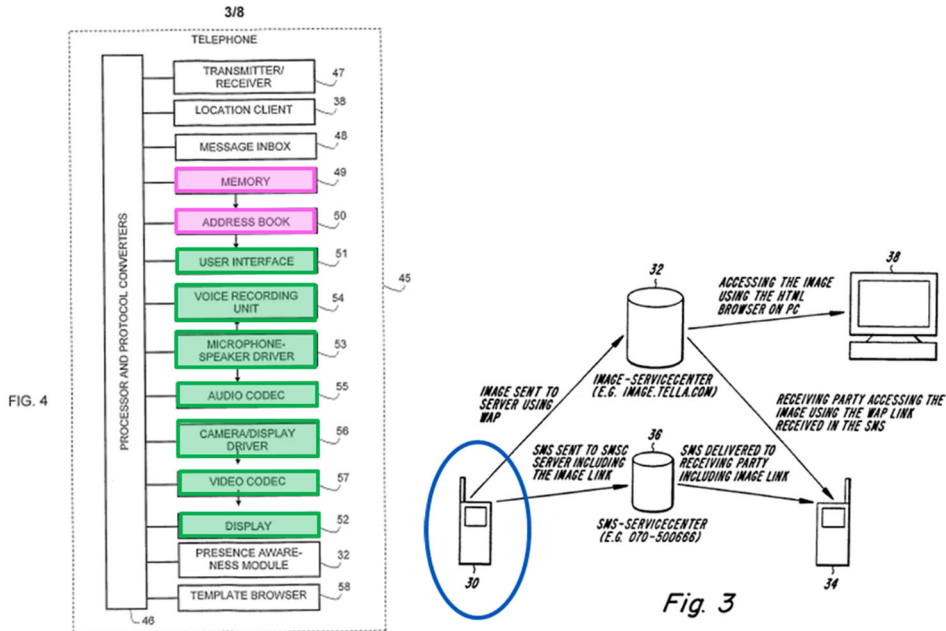
c. Element 10[b]: a memory storage means on said mobile device for storing a list of addresses of recipients;

Bengtsson-Roujinsky teaches Element 10[b]. Ex-1002 ¶156. Bengtsson teaches "a memory storage means" on the mobile device. *Id.* Bengtsson states that terminal 30 can store an address such as a URL address, "identifying the server 32 that the image is to be sent to." Ex-1005, 8:14-16. A POSITA would have understood that storing URL addresses requires memory. Bengtsson's memory device storage would also have the capability to store a list of recipient addresses. Ex-1002 ¶156. Bengtsson states that "[t]he text message is then forwarded to the intended recipient." Ex-1005, 5:6-7. It was well-known by POSITAs in 2007 that mobile devices were configured to store recipient addresses, as exemplified by Roujinsky. Ex-1002 ¶156; Ex-1030, 34.

Roujinsky teaches “a memory storage means on [the] mobile device for storing a list of addresses of recipients.” Ex-1006, 9:10-15. Specifically, Roujinsky states that its system includes cellular telephone 45 that comprises memory 49 for “stor[ing] data” such as sender/recipient profiles and address book 50 (pink), which allows the phone or the system’s server to use the “phone’s contact list or contacts and groups managed by the system.” Ex-1006, 9:10-15, Fig. 4 (annotated); *see also id.* at 14:1-5 (a user interface (green) “allows the sender to choose recipients by list selection”). A POSITA would have understood that Roujinsky’s memory 49 meets the claimed “memory storage means” because its function is to “stor[e] a list of addresses of recipients” (Ex-1006, 9:10-11) and its structure can be a memory, including any medium from which a computer can read for storing data such as addresses, such as “a machine-readable memory tangibly embodying a program of instructions executable by the machine.” Ex-1006, 20:1-3; Ex-1002 ¶157; Ex-1033.



A POSITA would have been motivated to implement Roujinsky's teachings of a memory storage means for storing a list of recipient addresses (e.g., an address book) on the sender's device (Fig. 4 (pink)) into Bengtsson's mobile device (Fig. 3 (blue)), for the reasons discussed above in Section XIII.C.1. Ex-1002 ¶¶158-159. Specifically, a POSITA would have understood that an address book feature is a familiar element to be included in mobile terminals, as disclosed by Roujinsky. *Id.*; Ex-1005, 7:23-8:3; Ex-1006, 3:12-19.

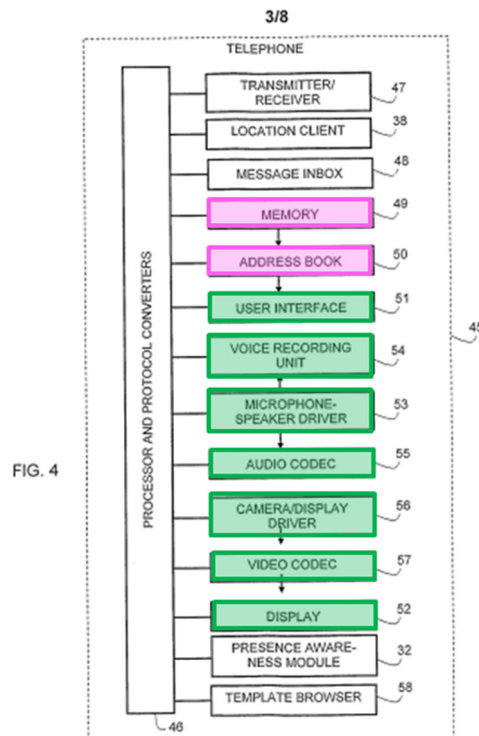


- d. **Element 10[c]: a user interface on the mobile device for said user to input voice messages and text messages; and**

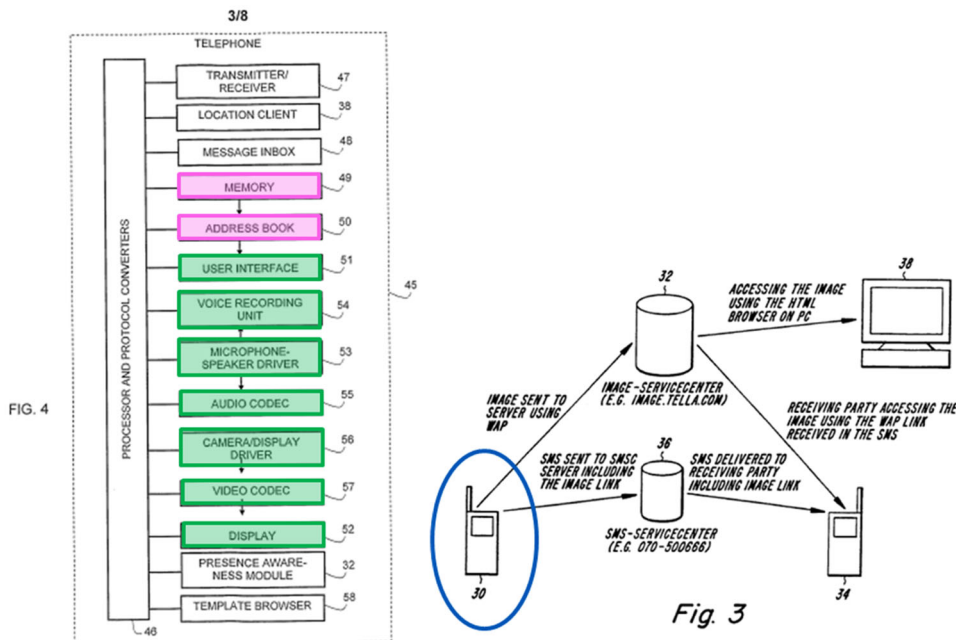
Bengtsson-Roujinsky teaches Element 10[c]. Ex-1002 ¶160. Bengtsson teaches “a user interface on the mobile device for” the “user to input voice messages and text messages.” Ex-1005, 7:7-10. Specifically, the user’s mobile terminal may include “an audio recorder for recording ... voice” and “captur[ing] and send[ing] audio information to the terminal for storage.” *Id.* Moreover, Bengtsson states that in the user’s terminal, the “user first creates a conventional SMS message.” Ex-1005, 7:23-25. Before the message is sent by the user, the advanced messaging application at the terminal prompts the user to ask “whether an attachment file should be included.” Ex-1005, 7:25-27. A POSITA would have understood that the user’s voice input and SMS message creation at Bengtsson’s mobile terminal would have

been implemented with a user interface. Ex-1002 ¶161. Additionally, this feature was well-known in the art by 2007, as disclosed by Roujinsky. *Id.*

Roujinsky discloses “a user interface on the mobile device for” the “user to input voice messages and text messages.” Ex-1006, 9:15-24. Specifically, Roujinsky discloses that telephone 45 includes “user interface” 51 (green). Ex-1006, Fig. 4 (annotated). User interface 51 typically has “a keypad and scrolling keys for typing text messages and selecting options displayed on a display 52.” Ex-1006, 9:15-16. Telephone 45 also includes microphone/speaker driver 53 (green) that enables “speech to be converted to electrical signals for recording using a voice recording unit 54” (green), which also has “a conventional user interface.” Ex-1006, 9:17-24.



A POSITA would have been motivated to implement Roujinsky's detailed user interface teachings on the sender's device for inputting voice and text messages (Fig. 4 (green)) into Bengtsson's mobile terminal (Fig. 3 (blue)), as a routine way to create a text message and record a voice message on their mobile device, as Bengtsson teaches, and a POSITA would have understood that this familiar element would be implemented in mobile terminals, as disclosed by Roujinsky. Ex-1002 ¶¶162-163. Roujinsky's straightforward and fulsome user interface teachings would enable the user to create both text and voice messages. *Id.*



A POSITA would have had a reasonable expectation of success in combining Bengtsson-Roujinsky because they both disclose straightforward applications of well-known technologies using standard hardware and software systems such as mobile devices, SMS messaging, and user interfaces. Ex-1002 ¶164. As such, it

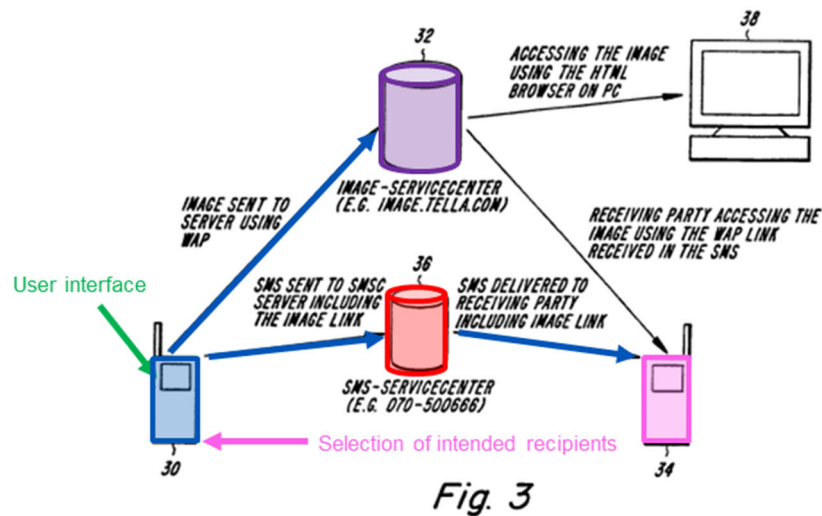
would have been well within the skill of a POSITA to implement Roujinsky's user interface into Bengtsson's mobile terminal. *Id.*; Ex-1005, 7:23-8:3; Ex-1006, 3:12-19.

- e. **Element 10[d]: a server for remotely recording and storing said voice messages of the user, wherein said server is configured to provide access to said recipient for listening to said recorded voice message; and**

Bengtsson-Roujinsky teaches Element 10[d]. Ex-1002 ¶¶165-166. Bengtsson teaches a server for storing the text messages of the user. Ex-1005, 1:24-26. Bengtsson states that a *text* message typically originates from a mobile unit that “transmits the SMS message to a service center.” *Id.* Bengtsson further states that “[s]ervice centers [SCs] are ‘store and forward’ devices” that are configured to “receive and store SMS messages,” and deliver them to mobile terminals. Ex-1005, 2:21-25.

Bengtsson also teaches that the server stores the user's *voice* messages and “is configured to provide access to [the] recipient for listening to [the] recorded voice message.” Ex-1005, 8:10-14. Specifically, Bengtsson explains that the image or audio file (e.g., voice message) attached to a text message is not sent directly from mobile terminal 30 to the recipient; instead, the text part of the message is sent to the recipient via SMS server 36 (red) and “the attachment is transmitted to a different server 32” (purple). Ex-1005, 8:10-14, Fig. 3 (annotated); *see also id.* at 8:5-7

(terminal 30 sends the attached file from terminal 30 to server 32). Terminal 30 includes as part of the SMS message that is sent to the recipient “the URL address (e.g., image.telia.com/sending-phone-number/image-number).” Ex-1005, 8:21-24. Thus, the recipient “receives a message containing the text message” and “the link to the server 32 *where the image (or other attached file) is stored*” and can be downloaded. Ex-1005, 8:25-28.



Finally, to the extent that Bengtsson does not expressly disclose a *server* for remotely recording voice messages of the user (as opposed to recording being done on the mobile terminal), Bengtsson already teaches sending recorded audio to the server where it is stored. Ex-1005, 8:17-24; *see also id.* at 7:7-10 (capture of audio and voice information). As an alternative, recording audio from a mobile terminal on a remote server was well-known to a POSITA, and the particular device that performs the actual recording would have been a routine design choice. Ex-1002

¶¶167-168. Whether the recording ability occurs at the mobile terminal and is then sent to the server, or it is recorded remotely at the server is a matter of design choice and both options would have been within the knowledge and capabilities of a POSITA, as exemplified by Roujinsky. *Id.*; Ex-1033.

Roujinsky teaches a server for remotely recording and storing voice messages of the user. Ex-1006, 18:8-12. Specifically, Roujinsky's system includes voice recording unit 54, which has a conventional user interface that may be used to "play/record and forward/backward rewind" and voice recording unit 39, which "is used to record and play a message." Ex-1006, 13:3-5. Roujinsky additionally states that messages may be "recorded by the sender at his or her sending device," as Bengtsson does, or "the sender can establish streaming or voice communication with the messaging server and *dictate messages for direct storage by the messaging server.*" Ex-1006, 18:8-12. A POSITA would have understood this as a routine alternative of recording the voice messages at the server. Ex-1002 ¶169.

Bengtsson-Roujinsky further teaches that the server is configured to provide access to the recipient for listening to the recorded voice message, as claimed. Ex-1002 ¶170. First, Roujinsky describes "operating the service to receive a voice message sent by a sender, [and] to convey the voice message to one or more recipients." Ex-1006, 4:10-16. Specifically, Roujinsky states that messaging server 35 includes memory 64 for "stor[ing] message data." *Id.* at 10:23-24. The recipient

can listen to the voice message. *Id.* at 4:18-20 (“the advantages of the invention derive not only from the ease of recording voice messages ... but also from the greater convenience of listening to a message for many users”).

Moreover, Roujinsky states that “the sender records a message,” “selects recipients and options,” and the “message is then sent to the messaging server using HTTP/TCP.” Ex-1006, 16:26-27. The messaging server “stores the message together with the identities of the recipients in the message database and conveys to each recipient notification that a message has arrived.” *Id.* at 16:27-29. “Upon receiving notification of an awaiting message, the recipient may retrieve the message from the server by sending a request using HTTP/TCP, whereupon the server conveys the message to the recipient also using HTTP/TCP.” *Id.* at 17:3-5. Bengtsson also teaches providing such access. Ex-1005, 8:25-29. For example, in Bengtsson the recipient receives “the link to the server 32 where the image (or other attached file) is stored” and “[t]he receiving party may choose to download the image from server 32 using, e.g., WAP, to his or her terminal 34.” *Id.* Of course, instead of an image, Bengtsson teaches audio or voice file types as well. *Id.* at 7:7-10, 8:23-24.

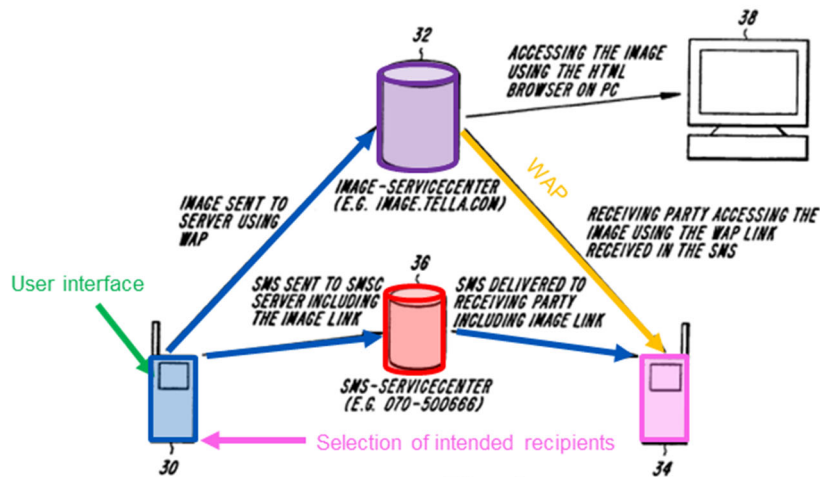


Fig. 3

A POSITA would have been motivated to implement the remote recording capabilities of Roujinsky's server into Bengtsson's system to conserve the resources of the sender's device and take advantage of the more significant resources on a server which would reduce the likelihood, for example, of running out of storage on a mobile terminal if all voice messages were stored on the sender's device. Ex-1002 ¶¶171-172. A POSITA would have understood that the Bengtsson-Roujinsky combination with Roujinsky's remote recording capabilities implemented with Bengtsson's server would result in a more resource-efficient system. *Id.*; Ex-1038, 67-68.

A POSITA would have had a reasonable expectation of success in combining Bengtsson-Roujinsky because they both disclose straightforward applications of well-known technologies using standard hardware and software systems such as mobile devices, SMS messaging, and servers. Ex-1002 ¶173. Specifically, a

POSITA would have known how to modify Bengtsson's client application to establish a voice streaming connection between the client and server 32 to allow the user to dictate the voice message to the server, as taught by Roujinsky, instead of using a file transfer protocol to upload a locally-recorded voice file. Both were well-known ways of sending voice at the time of the '978 Patent. *Id.* As such, it would have been well within the skill of a POSITA to implement Roujinsky's remote recording capabilities into Bengtsson's server. *Id.*; Ex-1005, 7:23-8:3; Ex-1006, 3:12-19.

f. Element 10[e]: said client application for transmitting a voice message notification with an addressed text message to said recipients.

Bengtsson-Roujinsky teaches Element 10[e]. Ex-1002 ¶174. Bengtsson teaches a client application on the mobile device for the same reasons described in Ground 1 (*see* Section XIII.A.2.b). *See, e.g.*, Ex-1005, 6:9-12, 5:2-10. Specifically, Bengtsson's system includes "an advanced messaging application" that enables the system to attach an image or audio file to an SMS message created by the user in their terminal for transmission to another mobile terminal. Ex-1005, 7:21-25; Ex-1002 ¶¶175-177; Ex-1025, 91.

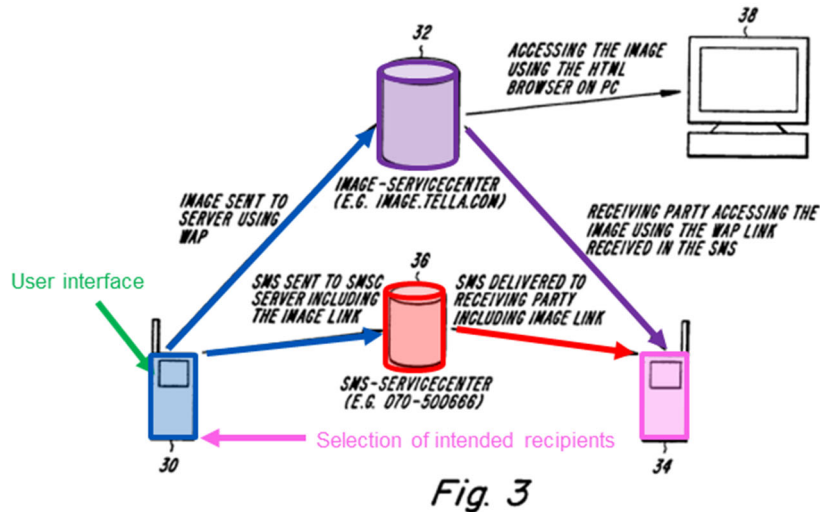
Moreover, Bengtsson teaches that the client application transmits a voice message notification with an addressed text message to the recipients for the same reasons discussed in Ground 1 (*see* Section XIII.A.2.f). *See, e.g.*, Ex-1005, 8:21-24

(mobile terminal 30 “includes the URL address (e.g., image.telia.com/sending-phone-number/image-number) as part of the text that is sent” as an SMS message to the recipient), 8:25-29 (recipient receives “the link to the server 32 where the image (or other attached file) is stored,” and “may choose to download the image from server 32 using, e.g., WAP, to his or her terminal 34”). Ex-1002 ¶178.

3. Dependent Claim 11: The system of claim 10, wherein said server comprises a first server for storing the voice messages of the user.

Bengtsson-Roujinsky teaches Claim 11. Ex-1002 ¶¶179-180. Bengtsson teaches a server for the same reasons described in Section XIII.C.2.e. *See, e.g.*, Ex-1005, 1:24-26 (mobile unit “transmits the SMS message to a service center”), 2:21-25 (“[s]ervice centers are ‘store and forward’ devices” that are configured to “receive and store SMS messages,” and deliver them to mobile terminals). Bengtsson further discloses a first server for storing the voice messages of the user. Ex-1005, 8:10-14. Specifically, Bengtsson discloses that the image or audio file attached to the text message is not sent directly from terminal 30 to the recipient; instead, the text part of the message is sent to the recipient via SMS server 36 (red) and “the attachment is transmitted to a different server 32” (purple). Ex-1005, 8:10-14, Fig. 3 (annotated); *see also id.* at 8:5-7 (terminal 30 sends the attached image or audio file from terminal 30 to server 32). Therefore, the recipient “receives a message containing the text

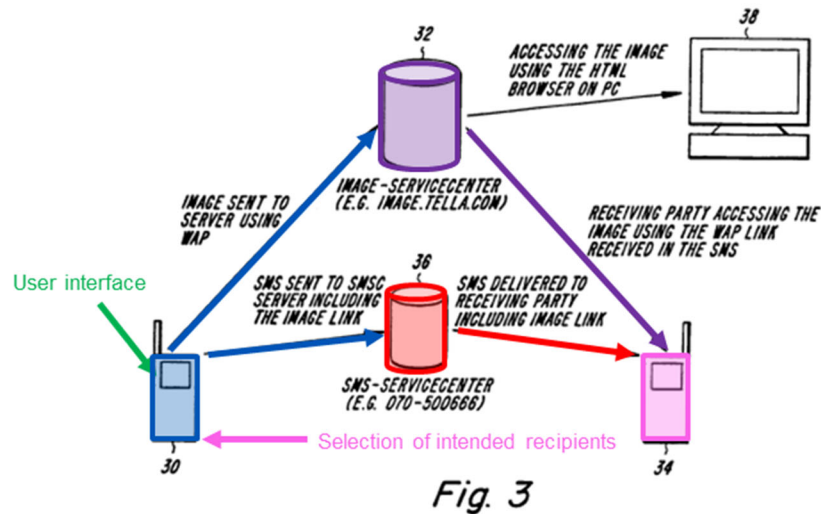
message” and “the link to the server 32 where the image (or other attached file) is stored.” Ex-1005, 8:25-28; *see also id.* at Cl. 1.



4. **Dependent Claim 12:** The system of claim 10, wherein said server comprises a second server for transmitting said voice message notification with said addressed text message to the recipients.

Bengtsson-Roujinsky teaches Claim 12. Ex-1002 ¶¶181-182. Bengtsson teaches a server for the same reasons described in Section XIII.C.2.e. *See, e.g.*, Ex-1005, 1:24-26, 2:21-25. Bengtsson further discloses a second server for transmitting the voice message notification with the addressed text message to the recipients. Ex-1005, 8:10-14. Specifically, Bengtsson discloses that the image or audio file attached to the text message is not sent directly from terminal 30 to the recipient; instead, the text part of the message is sent to the recipient via SMS server 36 (red) and “the attachment is transmitted to a different server 32” (purple). Ex-1005, 8:10-14, Fig.

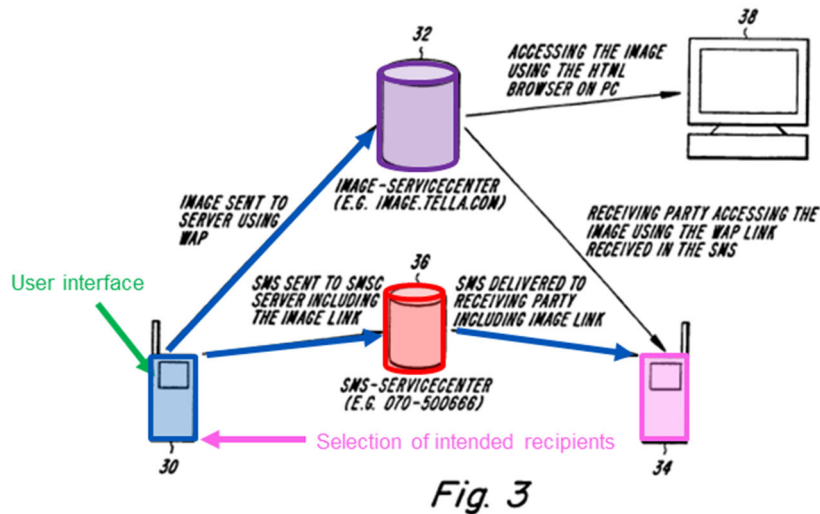
3 (annotated). Moreover, terminal 30 includes as part of the SMS message that is sent to the recipient “the URL address (e.g., image.telia.com/sending-phone-number/image-number).” Ex-1005, 8:21-24. Thus, the recipient “receives a message containing the text message” and “the link to the server 32 where the image (or other attached file) is stored” and can be downloaded. Ex-1005, 8:25-28; *see also id.* at Cl. 1.



5. Dependent Claim 13: The system of claim 10, wherein the client application transmits one of a text message, a voice message, and a combination thereof.

Bengtsson-Roujinsky teaches Claim 13. Ex-1002 ¶¶183-185. Bengtsson teaches a client application on the mobile device for the same reasons described in Sections XIII.C.2.b/XIII.C.2.f. *See, e.g.,* Ex-1005, 5:2-10, 6:9-12, 7:21-25. Bengtsson further discloses that its client application “transmits one of a text message, a voice message, and a combination thereof,” for the same reasons

discussed in Ground 1 (*see* Section XIII.A.5). Ex-1002 ¶186. Specifically, Bengtsson states that in the user's terminal, the "user first creates a conventional SMS message" (green). Ex-1005, 7:23-25, Fig. 3 (annotated). Before the SMS message is sent by the user, the advanced messaging application at the terminal (blue) prompts the user to ask "whether an attachment file should be included." Ex-1005, 7:25-27. If the user chooses "not attach a file to the SMS message," then it is "transmitted conventionally." Ex-1005, 7:28-30; Ex-1025, 91.



If the user opts to attach a file (or record a file at the server as taught by Roujinsky), then "certain information is added to the SMS message," which is then sent to the user-selected recipient (pink), and "the attachment is sent to a special server" for the recipient to retrieve/access. Ex-1005, 7:30-8:3. Bengtsson also states that terminal 30 (where the client application resides) "includes the URL address (e.g., image.telia.com/sending-phone-number/image-number) as part of the text that

is sent” as an SMS message to the recipient. Ex-1005, 8:21-24. A POSITA would have considered this message to be a combination voice/text message as envisioned by the ’978 Patent. Ex-1002 ¶¶187-188.

6. Dependent Claim 14: The system of claim 10, wherein the client application is provided on an operating system of the mobile device.

Bengtsson-Roujinsky teaches Claim 14. Ex-1002 ¶189. Bengtsson teaches that the client application is provided on an operating system of the mobile device. *Id.* For example, Bengtsson teaches a client application on the mobile device for the same reasons described in Section XIII.C.2.b. *See, e.g.*, Ex-1005, 5:2-10, 6:9-12, 7:21-25. Moreover, Bengtsson states that “a user first creates a conventional SMS message in his or her terminal.” Ex-1005, 7:23-25. A POSITA would have understood that the client application may be provided on the operating system of the mobile terminal because this would have been an obvious design choice for a mobile terminal, as exemplified by Roujinsky. Ex-1002 ¶¶190-192; Ex-1025, 91.

Roujinsky also discloses a client application on the mobile device. Ex-1002 ¶193. Specifically, Roujinsky’s cellular phone is “enhanced by a software client” (i.e., messaging client 31), Ex-1006, 9:1-2, that is loaded into sending device 45, *id.* at 7:7-9. Moreover, Roujinsky discloses that its client application (i.e., messaging client 31) is provided on an operating system of the mobile device. Specifically, Roujinsky discloses that messaging client 31 can “be implemented in a variety of

technologies,” such as for example, “Java, J2ME, Brew, Symbian, Linux, Windows, PocketPC, SmartPhone, PalmOS, or others.” Ex-1006, 8:5-8. These are the same operating systems that are disclosed as prior art by the ’978 Patent. Ex-1001, 3:11-20.

A POSITA would have been motivated to use an operating system such as those disclosed by Roujinsky to house the client application on the mobile device in Bengtsson’s system because operating systems were well known to provide stability for users and efficiency for application developers. Ex-1002 ¶¶194; Ex-1035-Ex-1037. A POSITA would have had a reasonable expectation of success in combining Bengtsson-Roujinsky because they both disclose straightforward applications of well-known technologies using standard hardware and software systems such as mobile devices. Ex-1002 ¶¶195-197. As such, it would have been well within the skill of a POSITA to implement Roujinsky’s operating system into Bengtsson’s mobile device. *Id.*; Ex-1005, 7:23-8:3; Ex-1006, 3:12-19.

XIV. THE BOARD SHOULD NOT USE ITS DISCRETION TO DENY INSTITUTION UNDER *FINTIV*

The Board should decline any request by PO to exercise discretion to deny institution under 35 U.S.C. §314(a). While Director Vidal’s June 21, 2022 Guidance made clear that “*Fintiv* is limited to facts of that case,” for completeness, Petitioner addresses the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11

(PTAB Mar. 20, 2020) (precedential). As explained below, the six factors set out in *Fintiv* do not justify denying institution.

As an initial matter, there is no litigation currently pending against Co-petitioner Google. The '978 Patent is asserted against Co-petitioner Samsung but not Co-petitioner Google. It is also asserted against non-party TCL in the *TCL* litigation, which is currently stayed. Accordingly, none of the *Fintiv* factors that depend on actions or activities of a petitioner in a co-pending litigation apply in any respect to Google. When each of these factors is weighed against Co-petitioner Google, they strongly weigh against denial. Accordingly, the Board should decline to exercise its discretion under 35 U.S.C. §314(a).

The **first *Fintiv* factor** applied against Co-petitioner Samsung alone is neutral here because Samsung has not yet moved to stay the district court proceedings pending IPR. Samsung may seek to stay the proceedings at a later date, and Petitioner will seek leave to submit a Preliminary Reply to address any post-filing developments in this regard, as necessary. Regardless, the PTAB will not infer how the district court would rule should a stay be requested. *See, e.g., Hulu LLC v. SITO Mobile R&D IP, LLC et al.*, IPR2021-00298, Paper 11 at 10-11 (PTAB May 19, 2021). Additionally, the *TCL* litigation involving the '978 Patent *is* stayed pending service of TCL under the Hague Convention, which will likely occur around February 2024. Ex-1022. Accordingly, this factor is neutral as to the *Samsung*

litigation. And in view of the lengthy stay in the *TCL* litigation, this factor weighs against denial.

For the **second *Fintiv* factor** applied against Co-petitioner Samsung alone, the district court has set a date to begin jury selection of October 28, 2024, approximately a year in the future. Even assuming that this date set about a year in the future holds, its timing does not tip in favor of denying the petition in this case. *See, e.g., Apple Inc. v. Koss Corp.*, IPR2021-00305, Paper 14 at 13 (PTAB June 3, 2021). Further, Samsung filed a Rule 12(c) motion for judgment on the pleadings under 35 U.S.C. §101 on September 20, 2023 (*Samsung Electronics Co., Ltd. et al.*, 2:22-cv-00462, D.I. 42 (E.D. Tex. Sept. 20, 2023)) and a motion to transfer on October 13, 2023 (*id.* at D.I. 46 (Oct. 13, 2023) (filed under seal)). The estimated trial date may therefore get extended, if the case is not dismissed entirely. Petitioner will notify the Board of any Court orders regarding the motion for judgment and motion to transfer, and expects to request a preliminary reply to address *Fintiv* based on subsequent developments. In addition, given the pending stay in the *TCL* litigation, the timing of trial with respect to *TCL* cannot be predicted at this time but is likely to occur after a final decision here. As such, the *Samsung* trial date weighs against denial.

The **third *Fintiv* factor** applied against Co-petitioner Samsung alone, weighs strongly against denial. There has been very little activity in the case. Claim

construction briefing has not yet begun. No depositions have yet been taken and expert discovery has not begun. There have been no substantive orders in the case, and the most cost intensive period in the district court case will likely occur around or after the institution decision. This alone weighs against denial. *See, e.g., Hulu*, Paper 11 at 13 (“We agree with Petitioner that the district court proceeding remains at the early stages, and a significant portion of work still remains to be done in the district court proceeding.”); *Skechers U.S.A., Inc. v. Nike, Inc.*, IPR2021-00160, Paper 10 at 12-13 (PTAB May 19, 2021) (“[N]either party has informed us that the District Court has undertaken a Markman hearing or entered a claim construction order. ... [T]his factor weighs against exercising our discretion.”). Moreover, there have been no development in the *TCL* litigation, which is stayed. This factor thus weighs against denial.

The **fourth *Fintiv* factor** also weighs against denial. The *Samsung* litigation is in the early stages and the *TCL* litigation is in its infancy and stayed. Co-petitioner Google is not a party to either litigation, so this IPR is thus the only forum in which Google can present its invalidity challenge. This factor thus weighs against denial.

On the **fifth *Fintiv* factor**, the Board should give little weight to the fact that Co-petitioner Samsung and PO are the same parties as in one of the relevant district court proceedings. Here, Co-petitioner Google and the defendants (Samsung and non-party TCL) in the parallel litigations are not the same parties. Moreover,

Petitioner Samsung is not a party to the *TCL* litigation. And Co-petitioner Google is not a party to either litigation. Therefore, this factor weighs against discretionary denial.

This petition presents “compelling merits” under the **sixth *Fintiv* factor**, which further weigh against discretionary denial. Where the Board “determines that the information presented at the institution stage presents a compelling unpatentability challenge, that determination alone demonstrates that the PTAB should not discretionarily deny institution under *Fintiv*.” USPTO Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022). The merits of the Petition are especially compelling here. For example, the prior art combinations Mumick’955-Bengtsson and Bengtsson-Roujinsky each render obvious independent Claim 10, including express disclosure of limitations 10[d] and 10[e], which PO relied on during prosecution to overcome prior art. Ex-1004, 139, 145-146 (applicant arguing that the prior art “do[es] not provide a client application for transmitting a voice message notification with a text SMS and also do[es] not disclose that a recipient of the text SMS comprising the voice message notification can access and listen to the voice message stored in the server.”).

Taken together, holistically, the *Fintiv*/*NHK* factors strongly weigh against denial.

XV. CONCLUSION

For the reasons above, Petitioner requests institution of IPR for Claims 10-14 of the '978 Patent based on each of the grounds specified in this Petition.

Respectfully Submitted,

/s/ Ben Haber
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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), Petitioner certifies that this petition includes 13,328 words, as measured by Microsoft Word, exclusive of the table of contents, mandatory notices under § 42.8, certificates of service, word count, and exhibits.

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on December 5, 2023, by filing this document through the Patent Trial and Appeal Board P-TACTS System, as well as delivering a copy via express mail upon the following attorneys of record for the Patent Owner and Petitioner:

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