

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

MULTIMODAL MEDIA LLC,

Patent Owner.

Patent No. 8,107,978
Filing Date: March 27, 2008
Issue Date: January 31, 2012

Inventors: Ewald C. Anderl, Ajay Kumar Thapar, Chinna Marudhu Pandian,
Chockalingam
Title: ADDRESSING VOICE SMS MESSAGES

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2024-00053

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EXHIBIT LIST

Exhibit No.	Description of Document
Ex. 2001	Second Amended Docket Control Order, Dkt. 72, <i>Multimodal Media LLC v. Samsung Elecs. Co.</i> , No. 2:22-cv-00462-JRG-RSP (E.D. Tex. Jan. 12, 2024)
Ex. 2002	Defendants' Motion to Stay Pending Resolution of Motion to Transfer Venue, Dkt. 78, <i>Multimodal Media LLC v. Samsung Elecs. Co.</i> , No. 2:22-cv-00462-JRG-RSP (E.D. Tex. Feb. 7, 2024)
Ex. 2003	Defendants' Motion to Transfer Venue to The Northern District of California Under 28 U.S.C. § 1414(a), Dkt. 49, <i>Multimodal Media LLC v. Samsung Elecs. Co.</i> , No. 2:22-cv-00462-JRG-RSP (E.D. Tex. Oct. 20, 2023)

I. INTRODUCTION

On December 5, 2023, Google LLC, Samsung Electronics Co. Ltd., and Samsung Electronics America, Inc., filed a Petition for *Inter Partes* Review (Paper 1, “Petition” or “Pet.”) of claims 10-14 of U.S. Patent No. 8,107,978 (Ex. 1001, the “’978 Patent”). On December 14, 2023, the Board issued a Notice of Filing Date for the Petition and set the time for filing Patent Owner’s Preliminary Response (Paper 5).

The Board should deny institution of the Petition because:

- (1) The Prior Art cited in Ground 1, U.S. Patent Application Publication No. 2005/0136955 to Mumick et al. (“Mumick’955,” Ex. 1007) and PCT Publication No. WO2001/013656 to Bengtsson et al. (“Bengtsson,” Ex. 1005), individually or in combination fail to disclose the claimed “client application” that “integrates voice content to a text message created by a user” as required by independent claim 10. Rather, Mumick’955 teaches a system that requires a user to manually select an option from the address book, which instructs a server to do the claimed integration. Bengtsson does not disclose integration of voice content to a text message by the client application at all, and Petitioners fail to close this gap with their expert declaration. In addition, taking Petitioners’ interpretations of the prior art as true would lead the POSITA to not be motivated to look to

Bengtsson from the teachings in Mumick'955.

- (2) The Prior Art cited in Ground 2 relates only to dependent claim 14, which depends from claim 10, and therefore Ground 2 fails for the same reasons as Ground 1.
- (3) The Prior Art cited in Ground 3, Bengtsson and PCT Publication No. WO 2007/020627 to Roujinsky ("Roujinsky," Ex. 1006) do not disclose the claimed "client application" that "integrates voice content to a text message created by a user using methods of recipient addressing as used by text short message service messaging" as required by independent claim 10. As with Ground 1, Bengtsson does not disclose a client application that integrates voice content to a text message. Although the Petition does not rely on Roujinsky for this claimed feature, it also does not disclose the claimed client application. The POSITA would not be motivated to look to Roujinsky from Bengtsson because Roujinsky's system operates on a server rather than on the mobile device.

The Board should also exercise its discretion to deny institution under *Fintiv* and should reject any late *Sotera* stipulation.

In describing problems with existing systems for sending voice SMS messages, the '978 Patent notes that existing methods “require a sender to input the recipient’s address through a user input interface” and that current methods use “addresses manually entered by the user for addressing the text messages.” *Id.* 1:51:58. The '978 Patent provides that the method and system must “overcome the limitation of a user input requirement for addressing the recipients of the voice SMS messages.” *Id.* 2:1-3.

III. LEVEL OF ORDINARY SKILL IN THE ART

For the purposes of this Preliminary Response only, Patent Owner agrees with the level of ordinary skill in the art proposed by Petitioners, “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.” Pet. at 7. Patent Owner does not believe that minor deviations from this level of skill in the art would materially change the analysis.

IV. CLAIM CONSTRUCTION

A. “memory storage means . . .”

Patent Owner agrees that application of the agreed construction of this term from the Oppo case is proper:

Function: “storing a list of addresses of recipients”

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.

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

Patent Owner agrees with Petitioners that this term should be construed to mean “wherein the client application transmits a text message, a voice message, or a combination thereof.” Ex-1021, 16-21.

C. “client application [on a mobile device]”

Petitioners attempts to modify the agreed claim term “client application” to be “a client application on a mobile device,” and construes that to mean “a program present on the sender’s mobile device.” Patent Owner does not believe that applying this construction to the term “client application” or “client application on a mobile device” creates a material difference in claim scope, and the Board need not consider

this to resolve the issues raised in the Petition. *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

**V. THE PETITION HAS NOT DEMONSTRATED A
LIKELIHOOD OF SUCCESS**

Institution should be denied because the Petition fails to show that any of the proposed combinations disclose a client application that integrates voice content to a text message.

**A. Ground 1: The Petition Fails to Show that Mumick’955
and Bengtsson Render the Challenged Claims Obvious**

**1. The Petition Fails to Show that Mumick’955 or Bengtsson
Disclose the Claimed Client Application**

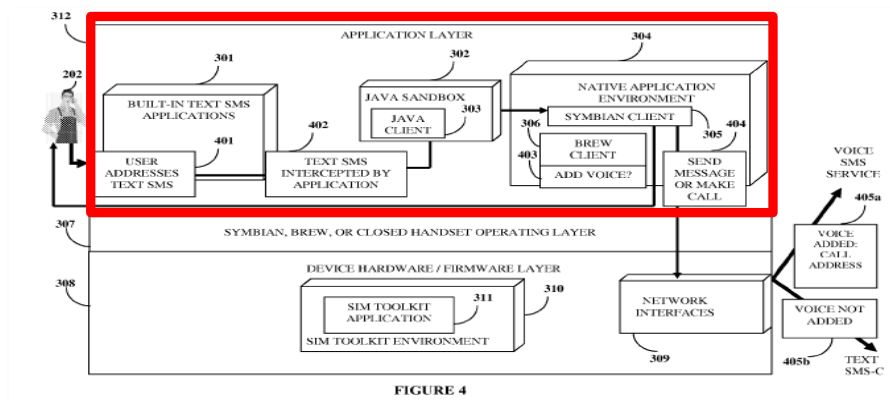
The combination of Mumick’955 and Bengtsson do not render the challenged claims obvious because neither reference discloses “a client application on a mobile device, wherein said client application integrates voice content to a text message created by a user using methods of recipient addressing as used by text short message service messaging” as required by independent claim 10. Rather, Mumick’995 discloses (1) that the user must manually use multiple different native applications on the mobile device; and (2) that the “integration,” to the extent it exists at all,

occurs on a server rather than on the mobile device.

The '978 Patent discloses and claims “[a] client application provisioned on the user's mobile device intercepts the addressed text SMS message and prompts whether the user wants to include voice content in the text SMS message.” Ex. 1001 2:18-21. Unlike the prior art, the '978 Patent discloses that a client application on the mobile device intercepts the text SMS and automatically prompts the user whether to include a voice message:

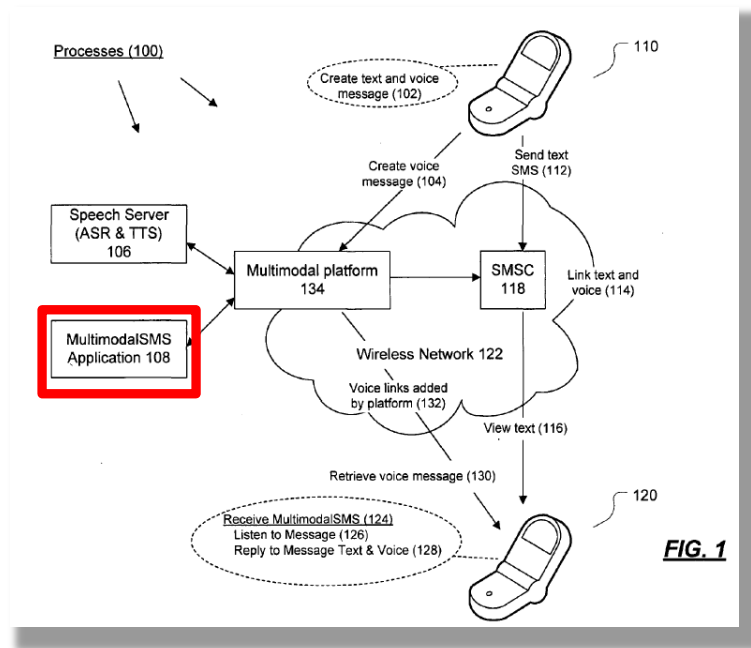
The native Symbian client application 305 intercepts 402 the addressed text SMS message. The user 202 is prompted whether a voice SMS message needs to be included or not, and accordingly makes a call to the server 314 or sends the addressed text SMS message 404.

Ex. 1001 6:33-37. Figure 4 discloses this client application and its functionality, located in the application layer of the mobile device:



Ex. 1001, Figure 4 (annotated)

Mumick’955 teaches that a “MultimodalSMS Application 108” is not located on the mobile device, but rather interfaces with the server titled “multimodal platform” 134:



Ex. 1007, FIG. 1 (annotated)

Mumick’955 teaches a system wherein a user creates a “MultimodalSMS message” by creating “any text message she wishes to send . . . and determine[ing] to whom the message is to be sent using whatever mechanisms are provided by the device 202.” *Id.* ¶ 40. If the user wishes to add speech to this message, the user manually scrolls through her phone book to find a “MultimodalSMS link” which connects through a voice network to a server that records the speech. *Id.*

Rather than using the claimed client application to integrate a voice message to an

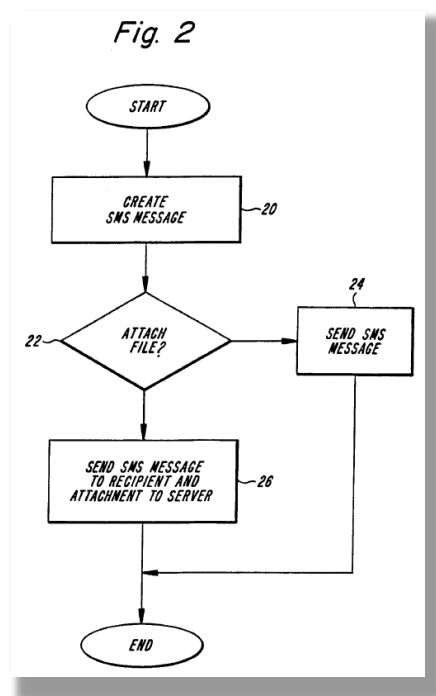
SMS message, Mumick’955 teaches that the user must create a text message in the standard text messaging client, then manually select a different contact in the phone book to compose a voice message which the server adds to the text message using “an application on the device.” *Id.* ¶ 47. Rather than use a client application to perform the claimed features, Mumick’955 uses applications already on the device and requires the user to manually create a text message using these standard clients, then the “MultimodalSMS Application” which is clearly *not* located on the mobile device performs the “integration,” to the extent anything is integrated at all.

Petitioners attempt to cure this material, obvious flaw in the primary reference by suggesting an obviousness combination with Bengtsson. Pet. at 27. Petitioners state that “[a]dditional 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.” *Id.* (quoting Ex. 1005 7:25-27).¹ Nevertheless, Bengtsson does not teach the claimed client application.

Bengtsson never discloses that the disclosed “advanced messaging application” on the sending device either prompts the user to attach voice content or integrates voice content to an SMS message as claimed in the ’978 Patent. Indeed,

¹ Patent Owner notes that Petitioners’ use of the term “prompts” in quotes is incorrect, as the cited section of Bengtsson never uses the word “prompts.” Patent Owner assumes this is a misquote of the prior art reference and not an intentional attempt to mislead the Board.

the portion of Bengtsson cited by Petitioners for this claim element, including what Petitioners claim is “prompting,” merely states “before the user sends the SMS message, the terminal can ask the user whether an attachment file should be included at step 22.” Ex. 1005, 7:25-27. In this description, Bengtsson is referring to step 22 in Figure 2, shown below, which is “a general method for transmitting messages with attachments according to the present invention.” *Id.*, 5:20-21.



Ex. 1005, Fig. 2

Although Petitioners claim that Bengtsson provides “implementation details,” Bengtsson is completely silent as to how the “terminal” accomplishes this, and what software on the terminal is used to create this association. Petitioners’ expert states without support that “[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" (Ex. 1002 ¶ 81), but nowhere do Petitioners, Bengtsson, or Petitioners' expert disclose or explain that the "advanced messaging application" is the claimed "client application" that "integrates voice content to a text message created by a user using methods of recipient addressing as used by text short message service messaging" as required by claim 10 of the '978 Patent.

2. The Motivation to Combine Mumick'955 and Bengtsson is Based Entirely on Impermissible Hindsight

Petitioners provide several grounds by which the POSITA would have been motivated to combine the teachings of Mumick'955 and Bengtsson, each of which are either too general or based on impermissible hindsight.

Directly related to the client application, Petitioners state that the POSITA would have been motivated to combine the references "to obtain a more user-friendly functionality to ensure a faster and more flexible and reliable user experience." Pet. 29. This broad statement of general goals is not sufficient to find a motivation to combine.

Petitioners' main argument for combining Mumick'955 and Bengtsson is based on both references being in the same field because "each relates to systems and methods for transmitting multimedia messages, including voice associated with

SMS messages.” Pet. at 21. Petitioners also state that the 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.” *Id.* at 22. Petitioners, again reading functionality into Bengtsson that does not exist, note that the 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.” *Id.* Aside from assuming that Bengtsson discloses the claimed client application on the mobile device (which is incorrect), each of these motivations fails.

First, the POSITA would have no motivation to modify Mumick’955. Assuming *arguendo* that Petitioners are correct that “Mumick’955 already teaches a client application on the mobile device that integrates voice content to a text message” (*id.*), there would be no need for the POSITA to look to Bengtsson for a “similar mechanism” for the user to integrate voice content to an SMS message. *Id.* at 22-23. Neither the Petition nor Petitioners’ expert declaration provides any reasoning or motivation as to why the POSITA would need “implementation details” in Bengtsson, or any motivation to change the functionality of the primary reference. This is a material failure in the Petition and reason alone for this Ground to be denied institution.

Second, the Petitioners openly admit that they are using impermissible hindsight to make the proposed combination, noting that there would be “a benefit” of incorporating the functionalities of Bengtsson’s client application into Mumick’955, “such as its ability to intercept a user’s text message and prompt the user to add a voice message.” *Id.* at 22. This “benefit” is unstated, aside from “streamlin[ing] the process for the user,” (*id.* at 23), and does nothing to inform the Board or the Patent Owner why the POSITA would have sought this benefit aside from attempting to reach the claimed invention.

Because the Petition relies on impermissible motivations to combine Mumick’955 and Bengtsson, institution should be denied.

B. Ground 2 Relates Only to a Dependent Claim and Fails Because Ground 1 Fails to Render the Underlying Independent Claim Obvious

For the reasons stated above, the combination of Mumick’955 and Bengtsson do not render claim 10 obvious. Therefore, Ground 2 regarding claim 14, which depends from claim 10, fails for the same reasons and institution should be denied.

C. Ground 3: The Petition Fails to Show that Bengtsson and Roujinsky Render the Challenged Claims Obvious

1. The Petition Fails to Show that Bengtsson or Roujinsky Disclose the Claimed Client Application

The combination of Bengtsson and Roujinsky does not render the challenged claims obvious because neither reference discloses “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” as required by independent claim 10.

As discussed above, Bengtsson does not disclose a client application which integrates voice content to a text message created by the user, instead merely containing a single disclosure that the “terminal” can “ask the user whether an attachment file should be included at step 22.” Ex. 1005, 7:25-27. This, as discussed above, does not disclose a client application that “integrates voice content to a text message created by a user” as required by claim 10.

Petitioners add Roujinsky to this combination for the proposition that “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” as exemplified by Roujinsky. Pet. at 50. Because Bengtsson does not disclose the claimed client application or any of the functionality thereof, adding Roujinsky for teachings related to recipient addressing is not adequate to cure this defect.

Roujinsky discloses a system that allows “questionnaires and surveys to be effected using mobile telephones that allow both prompts and responses to contain media content other than text alone.” Ex. 1006, 3:5-7. Roujinsky discloses that “[t]he sender creates a voice/text message” and selects the “recipients to whom he

wishes to send the message.” *Id.*, 11:7-8. Petitioners use Roujinsky’s teachings of “an address book on the sender’s device” and “a user interface” to allegedly disclose the claim limitation requiring use of “methods of recipient addressing to allow the user to use their existing contacts when creating text messages.” Pet. at 52.

Because Bengtsson does not disclose the claimed “client application” that “integrates voice content to a text message” and Roujinsky is not used by Petitioners for this portion of the claim, this ground fails without further analysis. However, the Petition also fails to meet its burden to show that the POSITA would have been motivated to combine Bengtsson and Roujinsky, and additionally fails. Roujinsky does not disclose a client application at all, but rather discloses a system that provides menus that are “voice driven rather than text-based.” Ex. 1006 1:19. The disclosure in Roujinsky is carried out “by a server operating the service to receive a voice message sent by a sender” and to convey the voice message to recipients. *Id.* 4:10-14. In Roujinsky, the voice message is created by the user on the mobile device and all remaining functionality is conducted at the server. Therefore, the POSITA would not have been motivated to combine Bengtsson and Roujinsky, and institution should be denied.

**VI. THE PETITION SHOULD BE DENIED IN THE DISCRETION
OF THE DIRECTOR UNDER 35 U.S.C. § 314(a)**

Based on Petitioners' reasons regarding § 314(a), the Board should exercise its discretion to deny this Petition.

The circumstances of the parallel district court litigation, *Multimodal Media LLC v. Samsung Elecs. Co.*, No. 2-22-cv-00462 (E.D. Tex.) (the "District Court Litigation"), necessitate denial of the Petition under the Board's precedent, as every factor considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (considering (a) "whether the petitioner and the defendant in the parallel proceeding are the same party"; (b) "overlap between issues raised in the petition and in the parallel proceeding" (c) "proximity of the court's trial date to the Board's projected statutory deadline for a final written decision"; (d) "investment in the parallel proceeding by the court and the parties"; (e) "whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted"; and (f) "other circumstances that impact the Board's exercise of discretion, including the merits.").

As set forth below, these factors collectively demonstrate that efficiency and integrity of the AIA are best served by denying review. First, two of the three parties are Defendants in the parallel proceeding. Second, the asserted claims in the District

Court Litigation are all at issue in the Petition. Third, trial in the District Court Litigation is set for October 28, 2024, more than seven months prior to the projected statutory deadline for a Final Written Decision of this Petition on June 14, 2025. Fourth, the parties (and Patent Owner in particular) have invested significant resources on developing legal and factual issues of validity and infringement in the District Court Litigation and will have invested substantially more resources before any decision on this Petition. Fifth, the Court has neither granted nor denied a stay pending this Petition. Finally, no other factors favor institution.

Accordingly, the Board should exercise its discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

**A. The Parallel District Court Litigation and the Petition
Involve Substantially the Same Parties**

As noted in Patent Owner’s Mandatory Notice, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the ’978 Patent). *Samsung Elecs. Co., v. Multimodal Media LLC*, IPR2024-00053, Paper

6 at 2 (P.T.A.B. December 26, 2023). Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. are parties to the District Court Litigation. Although Petitioner Google is not a defendant in that litigation, Samsung itself has moved to transfer that case to the Northern District of California based on activities of Google in that District. *See* District Court Litigation at Dkt. 49 (Ex. 2003). Petitioners cannot have it both ways: both using Google as a co-petitioner to attempt to avoid a *Fintiv* analysis and also attempting to include Google in the District Court Litigation in an attempt to manufacture facts for a transfer would be inequitable. Accordingly, this factor weighs in favor of discretionary denial.

B. The District Court Litigation Involves Substantially the Same Claims

All of the asserted claims of the '978 Patent in the District Court Litigation are at issue in this Petition. “In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020). Accordingly, this fact weighs in favor of discretionary denial.

C. Proximity of the District Court’s Trial Date

The proximity of the District Court Litigation’s trial date to the Board’s projected statutory deadline for a Final Written Decision strongly weighs in favor of

discretionary denial.

The trial is scheduled for October 28, 2024. Exhibit 2001 (Second Amended Docket Control Order, Dkt. 72, *Multimodal Media LLC v. Samsung Elecs. Co.*, No. 2-22-cv-00462 (E.D. Tex. Jan. 12, 2024). Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final Written Decision of this Petition is June 14, 2025. As the District Court’s trial will be more than ***seven months before*** the projected statutory deadline, this factor weighs strongly in favor of denying institution. *See Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 10-12 (P.T.A.B. June 24, 2020) (denying institution where the jury trial was scheduled to conclude approximately ten months before the statutory deadline); *Edward LifeSciences Corp. v. Evalve, Inc.*, IPR2019-01479, Paper 7, at 6-13 (P.T.A.B. Feb. 26, 2020) (denying institution where jury trial would conclude more than nine months before a final decision would be due); *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude “several months,” before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 (“Because the trial date is substantially earlier than the projected statutory deadline for the

Board's final decision, this factor weighs in favor of discretionary denial."'). Thus, this factor also weighs in favor of discretionary denial.

D. Significant Investment and Petitioners' Delay in Filing the Petition

The parties' investment in the parallel proceeding weighs in favor of discretionary denial. In the District Court Litigation, Discovery is well under way. The parties have already exchanged infringement contentions pursuant to P.R. 3-1, and invalidity contentions pursuant to P.R. 3-3, begun the claim construction process including briefing and expert depositions, and conducted at least one fact deposition. *See* Ex. 2001. Fact discovery will close before the statutory deadline to institute this proceeding. Thus, the parties' and Court's substantial investment in this District Court Litigation weighs in favor of denial of institution under this factor.

E. No Stay of the Parallel District Court Litigation

There is no stay of the parallel District Court Litigation.² Even if the Petition were instituted and Petitioners' motion to stay the District Court Litigation is granted, prejudice, tactical disadvantage to Multimodal, the late stage of the litigation, and the lack of potential simplification would weigh strongly against such a motion. *See Lennon Image Techs., LLC v. Macy's Retail Holdings, Inc.*, 2:13-CV-

² Although Petitioners state that they have not moved to stay the district court proceeding prior to filing their petitions for *Inter Partes* Review, they did subsequently request a stay of the litigation. Ex. 2002, Dkt. 78.

00235-JRG, 2014 WL 4652117, at *1 (E.D. Tex. Sept. 18, 2014). The statutory deadline for institution is not until after claim construction discovery begins. Ex. 2001; *see Intell. Ventures II v. FedEx Corp.*, No. 2:16-cv-00980-JRG, Dkt. 141 at 5 (E.D. Tex. Oct. 24, 2017) (“The Court agrees that the Parties have already invested substantial effort and resources during discovery and in preparing claim construction briefing. . . . These circumstances weigh against staying this case”).

Moreover, a stay would not decrease the burden on the Court and the parties since any instituted IPR would not cover any of the references that Petitioners raised in the District Court Litigation for both anticipation or any of the combinations of obviousness, and do not include Petitioners’ challenges under § 112 or § 101. *Intell. Ventures II*, No. 2:16-cv-00980-JRG, Dkt. 141 at 3-4 (“[T]he instituted IPRs only cover a narrow slice of the invalidity arguments Defendants have raised in this case. For example, Defendants have argued that the ’715 Patent is invalid under § 102 with respect to at least eight references . . . under § 103 with respect to at least twenty-six combinations . . . under § 112 [], and under § 101.”).

Accordingly, it would be unlikely for the Court to hold that a stay would streamline the litigation and this factor supports denial of institution.

F. Other Factors Favor Discretionary Denial

Petitioner do not present a strong case on the merits, further supporting denial of institution. Petitioners also do not identify any other factors which weigh against

discretionary denial. Pet. at 70-74.

Thus, when viewing the factors together, the Petition should be denied in the Director's discretion under 35 U.S.C. § 314(a).

VII. THE BOARD SHOULD REJECT ANY LATE SOTERA STIPULATION

Samsung has not made a *Sotera*-style stipulation that “if IPR is instituted, [Petitioner] will not pursue in the District Court Litigation any ground raised or that could have been reasonably raised in an IPR” in its Petition, which weighs further in favor of discretionarily denying institution. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 13-14 (P.T.A.B. Dec. 1, 2020) (designated Dec. 17, 2020).

The Board should not accept any late *Sotera* stipulation after this Preliminary Response. Petitioners have known about the District Court Litigation since Patent Owner filed a Complaint asserting infringement of the '227 Patent against Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (November 29, 2022) over one year before this Petition (December 2023). Three docket control orders have been entered in the District Court Litigation, each anticipating a trial date for October 2024. Ex. 2001. Any withholding of the *Sotera* stipulation in its Petition is gamesmanship and prejudicial to Patent Owner in this proceeding and is inconsistent

with 37 C.F.R. § 42.1(b)'s mandate to "secure the just, speedy, and inexpensive resolution of every proceeding."

Both the Board and the Director are abundantly clear that Petitioners cannot wait until after the Board renders its Institution Decision to address the issues of *Fintiv* and the Board's discretionary authority, and to submit a *Sotera* stipulation. *NXP USA, Inc. v Impinj, Inc.*, IPR2021-01556, Paper 12, 5-6 (P.T.A.B. Aug. 25, 2022); *see also id.*, IPR2021-01556, Paper 13, 3-4 (P.T.A.B. Sept. 7, 2022) (the Director finding "that the Board correctly determined that a stipulation, offered by a petitioner for the first time after a decision denying institution, is not a proper basis for granting rehearing of the decision on institution;" "[p]ermitting a petitioner to wait and see if the Board denies institution under *Fintiv*, and then offer such a stipulation for the first time on rehearing, frustrates these goals [of avoiding conflicting decisions] and would open the door to gamesmanship;" "***the only appropriate time for a petitioner to offer a stipulation related to the Fintiv factor 4 analysis is prior to the Board's decision of whether to institute review.***") (*emphasis added*).

VIII. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board deny Google LLC, Samsung Electronics Co. Ltd., and Samsung Electronics America, Inc.'s Petition in its entirety.

Respectfully submitted,

Dated: March 14, 2024

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned MULTIMODAL MEDIA LLC'S PRELIMINARY RESPONSE specified in 37 C.F.R. § 42.24 has 4,661 words in compliance with the 14,000-word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word 2010.

Respectfully submitted,

Dated: March 14, 2024

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CERTIFICATE OF SERVICE

A copy of MULTIMODAL MEDIA LLC'S PRELIMINARY RESPONSE
and EXHIBITS (Nos. 2001, 2002, 2003) have been served on Petitioners' counsel
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