

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

DH INTERNATIONAL LTD.,
Patent Owner.

PTAB Case No. IPR2024-01322

Patent No. 9,022,294

**PATENT OWNER'S RESPONSE
UNDER 35 U.S.C. § 42.120**

June 9, 2025

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TABLE OF EXHIBITS

Exhibit	Title
1001	U.S. Patent No. 9,022,294 to Gaillard <i>et al.</i> (“’294 Patent”)
1002	Prosecution History of U.S. Application No. 12/603,085
1003	Declaration of Stuart Lipoff (“ <i>Lipoff</i> ”)
1004	Curriculum Vitae of Stuart Lipoff
1005	U.S. Patent No. 6,941,156 to Mooney (“ <i>Mooney</i> ”)
1006	U.S. Patent No. 6,909,705 to Lee <i>et al.</i> (“ <i>Lee 705</i> ”)
1007	U.S. Patent No. 6,697,638 to Larsson <i>et al.</i> (“ <i>Larsson</i> ”)
1008	U.S. Patent No. 7,278,581 to Ong (“ <i>Ong</i> ”)
1009	U.S. Patent No. 8,862,393 to Zhou <i>et al.</i> (“ <i>Zhou</i> ”)
1010	U.S. Patent No. 6,931,266 to Miyoshi <i>et al.</i> (“ <i>Miyoshi</i> ”)
1011	U.S. Patent No. 6,526,287 to Lee (“ <i>Lee 287</i> ”)
1012	U.S. Patent No. 6,845,097 to Haller <i>et al.</i> (“ <i>Haller</i> ”)
2001	Declaration of Safwan Zaheer (“ <i>Zaheer</i> ”)
2002	Prosecution History of U.S. Application No. 7,628,333
2003	Bluetooth Specification Version 1.1, Part K:3 Cordless Telephone Profile.

I. INTRODUCTION

Patent Owner DH International Ltd. (“DHI” or “Patent Owner”) submits the following Patent Owner Response (“POR”) pursuant to 37 C.F.R. § 42.120. *See* 37 C.F.R. § 42.120. Petitioner Google LLC (“Google” or “Petitioner”) filed a Petition for *Inter Partes* Review of U.S. Patent No. 9,022,294 (“the ’294 Patent”) on September 11, 2024. (IPR2024-01322, Paper No. 1 (“Petition”)) and a Decision granting institution under 35 U.S.C. § 314 on March 24, 2025.

Contrary to the Petition, nothing in the art anticipated or rendered obvious the claims of the ’294 Patent. The Petitioner is based upon flawed assertions of the Petitioner’s Expert who failed to review the BluetoothTM specification (Exh. 2003) cited in the Mooney Patent and who’s assertions are contrary the teachings of that specification. None of the claims of the ’294 Patent can be rendered obvious given the references cited in the two (2) separate Grounds and all claims must be found not invalid.

II. MANDATORY NOTICES (37 C.F.R. § 42.8)

A. Real Party in Interest

Patent Owner DH International Ltd. is the real party-in-interest.

B. Related Matters

The U.S. Patent 9,022,294 is a continuation-in-part of U.S. Patent No. 7,628,333, for which Google has filed IPR2024-01321. The Grounds in IPR2024-01321 are based on different prior art references from this IPR.

III. BACKGROUND OF U.S. PATENT NO. 9,022,294

The '294 Patent, titled "Portable Electronic Device and Method for Alternate Data Conveyance Operations Responsive to an Invariable Activation Command," issued on May 5, 2015, as a continuation-in-part of U.S. Patent 7,628,333, that was application No. 10/552,912, filed as a National Stage Filing of PCT/IB03/01523, on April 14, 2003. *See* Exh. 1001, cover page; 1002, ¶32.

The use of portable electronic devices such as electronic cards for security was known at the time of the '294 Patent. However, what was not known was that a switching element, used to switch from local access of stored data to the transmission of the stored data is enabled by both user validation and "an activation cue." *Id.*, ¶31. Prosecution of the parent '333 Patent further reinforced this novel and nonobvious characteristic. During the prosecution '333 Patent, the patent applicant stated that:

Thus, the contact switch 24 of the card of [prior art] document D1 has the effect of only activating the read mode portion of the card, and has a quite different

function than the control device¹ claimed in the present patent application, which must necessarily be triggered to initiate any data flow towards or out of the electronic circuit.

Exh. 2002, p. 218-219 (emphasis in original). Thus, as claimed in the '333 Patent, no data flow towards or out of the electronic circuit occurs without being triggered to initiate a data flow. *See* Exh. 2001, ¶¶31-32.

Once the portable electronic device is activated, a first set of data is accessible in an inactive state. *See* Exh. 1001, 9:49. Upon receiving the “activation cue” by the control device, the data accessible is switched to a second set of data by the switching element. *See Id.*, 9:28-30; Exh. 2001, ¶33. The “activation cue” is a predetermined indication for switching what data will be accessed. It is an indicator, “for example, a predetermined bit sequence.” *Id.*, 9:24-27; Exh. 2001, ¶34.

“Stored data” is transmitted in response to:

a cue receiver operatively linked to the electronic circuit, a data conveyance switching element operatively linked to the electronic circuit and capable of being in either one of a first and a second state, and power means for providing power to the portable electronic device.

¹ A “control device can be any suitable device allowing the portable electronic device holder to selectively trigger a data conveyance operation.” Exh. 1001, 8:29-31.

The method of data conveyance includes awaiting for an activation cue to be received at the cue receiver; if an activation cue is received at the cue receiver, assigning its first state to the switching element, while if no activation cue is received at the cue receiver, assigning its second state to the switching element; and selectively triggering the control device to issue an invariable activation command. Upon the control device being triggered, if the switching element is in its first state, first data will be forwarded to the first data transceiver for initiating a data exchange operation with a first external data exchange device; while if the switching element is in its second state, second data will be forwarded to the second data transceiver for initiating a data exchange operation with a second external data exchange device.

Exh. 1001, Abstract; Exh. 2001, ¶27.

IV. PERSON OF ORDINARY SKILL IN THE ART

Patent Owner agrees with the Petitioner on the level of ordinary skill in the art. A person with ordinary skill in the relevant art at the time of invention - April 14, 2003 - would have a bachelor's degree in electrical engineering or a similar discipline and at least three years of relevant industry or research experience in wireless communication between devices. This definition is approximate, and more education may substitute for industry experience or vice versa. *See* Exh. 2001, ¶¶26-29.

V. THE CHALLENGED CLAIMS

Petitioner challenged claims 1-20 of the '294 Patent. *See* Paper 1, p. 2. Claims 1, 10, 11, 12, and 19 are independent and each claim recites features distinguishing the '294 Patent from the asserted prior art, either directly or via dependency. Exh. 2001, ¶35.

Grounds	Basis	Challenged Claims
1.	35 U.S.C. § 103 <i>Mooney</i>	1-20
2.	35 U.S.C. § 103 <i>Mooney</i> and <i>Lee</i>	1-20

VI. CLAIM CONSTRUCTION

In an *inter partes* review proceeding, “a claim of a patent ... shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b); Exh. 2001, ¶¶44-45.

A. The term “activation cue” should be construed as “a predetermined indicator”

The claim term “activation cue” means a predetermined indicator, such as “a predetermined bit sequence” (Exh. 1001, 6:1-3), that is “recognized by the electronic device as an activation cue.” *Id.* The activation cue must be intended as a

predetermined indicator and not a message or signal recognized as a message or signal for other action. *See* Exh. 2001, ¶46. If the “activation cue” is not predetermined, then the claim element has been improperly read out of the claims. Furthermore, if the “activation cue” is not predetermined, then hindsight is used to call any message or signal an activation cue, even if that message or signal is never intended to operate as an activation cue.

In the Institution Decision (ID), the Board stated that “ ‘a cue receiver operatively linked to said electronic circuit for receiving an activation cue from a source external to said cellular phone’ – does not limit ‘activation cue’ to a predetermined bit sequence or predetermined indicator as argued by Patent Owner.” DI 13. However, Patent Owner never asserted that the “activation cue” had to be a predetermined bit sequence. Rather, the predetermined bit sequence was but an example of something that “was intended to be a predetermined indicator.” A message could be an activation cue, as long as that message was “intended” to be an activation cue. To meet this claim element, simply receiving a message or data is not enough. The claim language is “an activation cue” not “something acting as an activation cue.” The specification provides an example of a bit sequence intended to serve as an activation cue. The Patent Owner in this POR and the Board in the ID acknowledges that it is only an example. *See* DI 14. This is an example of something that is specifically created to act as an activation cue.

Nothing is read into the claims from the specification. The specification reinforces and provides examples that an activation cue is an identifiable thing that has an intended purpose, not simply a label placed upon some message in hindsight.

B. “data conveyance switching element”

The term “data conveyance switching element” should be given its plain meaning, which is the switching of the data. The data itself is what is being switched. States are not switched by the “data conveyance switching element; rather, states are assigned to what the switch is conveying. “[I]f an activation cue is received at the cue receiver, assigning its first state to the switching element, while if no activation cue is received at the cue receiver, assigning its second state to the switching element; and selectively triggering the control device to issue an invariable activation command.” Exh. 1001, Abstract. The actual switching element is described in the ’294 Patent as a “[s]witching element 44b [that] can be any type of device allowing data to be conveyed according to alternate data conveyance operations in response to an activation cue being received by transceiver 18 or not.” Exh. 2001, 9:28-31. The switching element is for switching data, i.e., data conveyance operations. Exh. 2001, ¶47.

C. “data exchange device” and “external data exchange device”

Claims must be construed “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art *and the*

prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (*emphasis added*) (citing 35 U.S.C. § 282(b)). The ID did not construe “external data exchange device.” *See* ID, 16.

The data exchange device, by its plain meaning, which is consistent with the specification, is a device. It is shown in Figures 1, 3, and 4 of the '294 Patent. In Figure 1, item 9 is a “data exchange device,” *Id.*, Fig. 1, and “can be any sort of data exchange device comprising an electronic circuit (not shown) therein and a data transceiver 9a,” *id.*, 9:4-6. Similarly, item 9' in Figure 3 is a “data exchange device,” *id.*, 12:62, and item 104 in Figure 4, *id.*, 13:28. An external data exchange device is not a transceiver but a device with a transceiver. Exh. 2001, ¶48.

D. “Close Proximity”

Close proximity is within a several meter range. *See* Exh. 1001, 15:55-57. The range does not simply rely on the default range of Bluetooth, the several-meter range must be at least less than 30 meters. The electronic device is described as communicating with a data exchange device, such as an automatic teller machine, computer, interface machine. *See* Exh. 1001, 9:8-11. All of these example machines would require the person to be within a meter to see the interface or operate the machine. Therefore, a POSITA would consider close proximity to be 10 meters or less. Exh. 2001, ¶49.

Lastly, all of the other claim terms should be given their plain and ordinary meaning as used in the '294 Patent specification and file history. If the Board does construe any other claim terms, Patent Owner reserves the right to provide constructions for those terms or other terms, if they become material to the Board's decision.

VII. OVERVIEW OF THE PRIOR ART

A. *Mooney* (Exh. 1005)

U.S. Patent No. 6,941,156 ("*Mooney*") (Exh. 1005) was filed on June 26, 2001, and issued on September 6, 2005. *Mooney* describes a Public Telephone Switching Network (PSTN) circuit-based telephone call establishment. A second circuit is established through a PSTN and only after successfully setting up the second circuit is communication switched from the first path through the PSTN to the second path through the PSTN. *See* Exh. 1005, Fig. 1. Two concurrent paths, one originating in the cellular network and one originating through the cordless telephone base unit through the PSTN have to be successfully established before transferring a call from the first path to the second path. The establishment of the second concurrent path through the PSTN requires call data (such as caller ID information) from the first call to be sent from the other respective transceiver, and the call path must be set up before transferring from the first call path to the second call path. Exh. 2001, ¶¶38-39.

Mooney fundamentally teaches “telephony” while the ’294 Patent describe a “transaction” utilizing wireless communication (RF, IR) network in a secure manner as evident due to the essential presence of the electronic credit card (ECC). Exh. 2001, ¶¶40-41. Further, *Mooney* uses Bluetooth technology to have a cellular telephone act as a cordless phone via a piconet connecting with a cordless telephone base unit. A piconet is a small, wireless network of connected Bluetooth devices. *Mooney* describes having a prior established piconet and the device of a cellular telephone 100 having a cordless telephone mode and a matching piconet cordless telephone base unit 110. Exh. 1005, 4:7-10. “The entire Bluetooth specification (core and profiles), version 1.1, in particular the Cordless Telephone Profile portion of version 1.1 of Profiles, is explicitly incorporated ... by reference.” Exh. 1005, 2:61-64.

B. Lee (Exh. 1006)

U.S. Patent No. 6,909,705 (“*Lee 705*”) (Exh. 1006) was filed on November 2, 2000, and issued on June 21, 2005. *Lee 705* describes using a Bluetooth piconet in a cellular network to augment the cellular network. Routing of calls in the Bluetooth piconet is done with a voice-over IP network. Just as in a cellular network, the cellular telephones in the piconet are registered, and the location of the cellular telephones is stored in a location register, such as an HLR. Handoffs may occur between the piconet base stations and cellular BTS and between piconet base

stations. The *Lee 705* patent is about telephony and handoff to reduce interference and not about making transactions utilizing wireless communication, as evident due to the presence of ECC. Exh. 2001, ¶¶42-43.

VIII. RESPONSE TO SPECIFIC IPR GROUNDS

In addition to the reasons for denial outlined in Section III *supra*, Google's Petition should be denied for failing to show a reasonable likelihood that the challenged claims are unpatentable. *Mooney* alone, or the combination of *Mooney* and *Lee 705*, as presented by Petitioner fails to identify at least one if not more of the claim elements of the '294 Patent, such as the switching element, activation cue, activation cue received by a transceiver, and attempts to call a code a command.

A. GROUND 1: Obviousness Based on *Mooney*

Claims 1-20 are not obvious based on *Mooney* (Exh. 1005) alone. As detailed subsequently, *Mooney* fails to teach or disclose at least one claim element of claims 1-20. Exh. 2001, ¶52.

1. No Motivation to Combine with knowledge of a POSITA

Mooney's approach is a "technique and apparatus for transferring a communication link between two different modes of multimode cell phone." *Id.*, Abstract. The switching taught by *Mooney* is actually transferring a communication path through the network. A POSITA would understand that voice is encoded in

real-time as data in a cellular telephone, the same encoded voice data is received at the terminating device. Further, the data transmitted is voice data, not data stored in the device as described in the '294 Patent. As the communication path through the network switches, the new encoded voice data is encoded and transmitted over the newly established circuit path. Switch over module 101 is shown in Figure 1, and is not switching data. A POSITA would know and appreciate that “switch over” is activating an established path, not switching data. Nothing in the Petition identifies an actual switch in *Mooney*. In *Mooney*, it is more likely that a data bus supplies data to both transceivers and activates and deactivates the reception of data at the transceivers, rather than switching the data because switching would result in more delay and more lost data than just activating an established path. Exh. 2001, ¶53. It is the Petitioner’s burden to establish what is specifically being switched in *Mooney* and the Petitioner have failed to do so.

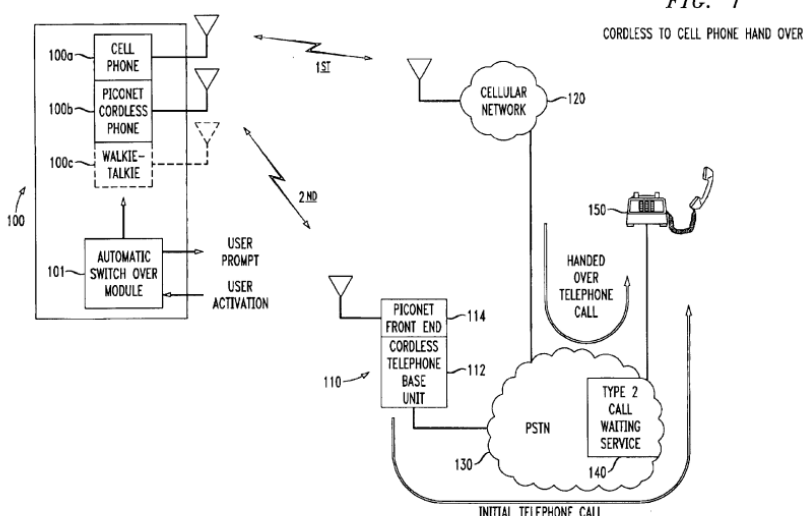
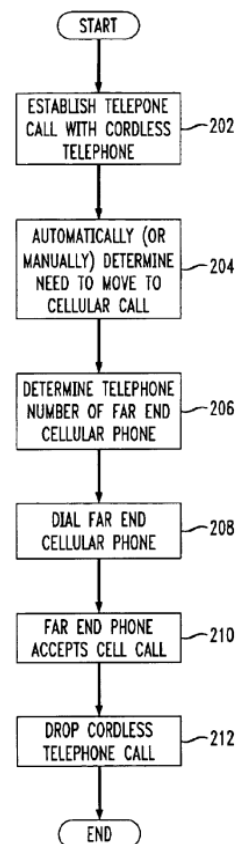


FIG. 2
CORDLESS TO CELL PHONE HAND OVER



A call is established between a multimode cell phone 100 and a far-end telephone 150 in a cordless telephone mode, step 202. *See* Exh. 2001, ¶53, Fig. 1 and 2 (above); Exh. 2001, ¶54.

A call is not switched. Rather, a call is reestablished on another path through the PSTN. Exh. 1005, Fig. 2, 204. A first call is setup through the PSTN. A second call is setup to the same person, so two concurrent calls through the PSTN are active. The second call (communication path) has to be established before it is used. Exh. 1005, Fig. 2, 210. If the far end refuses the call or the call setup fails, the second

call is not established, and the call cannot be activated or transferred by the automatic switch over module 101 of Fig. 1. Exh. 1005, Fig. 1; Exh. 2001, ¶55.

The “switch over” is simply activating an already established call path. The transceiver in *Mooney* that is associated with the second call path has already been signaling, such as callerID and sending data to set up the second call path. Nothing in *Mooney* shows actual switching is occurring or that “switch over” is switching. Further, the transceiver associated with the second call path is already being used prior to Petitioner’s alleged switching.

No transmission of the data stored in the multimode cell phone 100, such as phone book data, calling history, or user preferences, is described as occurring in *Mooney*. Figures 1 and 2 do not even mention data. Rather, real-time voice data and call setup data is being transmitted. As a matter of fact, the word “data” only appears once in *Mooney*’s detailed description with reference to the far end phone receiving a call and checking callerID data [call setup data]. Exh. 1005, 6:33-35. The call ID data is generated by the PSTN network and not the cordless telephone device. Exh. 2001, ¶56.

Thus, a POSITA would know that the establishment of a call/communication path through the PSTN is not assured (setup can fail or call can be rejected) and the activation of a communication path is not assured in *Mooney*. Such a switch over is

different from the switching of data conveyance switching element where the path to stored data is actually switched. See Exh. 1001, 14:18-26; Exh. 2001, ¶57.

A POSITA would have no motivation to look to *Mooney*'s description of attempting to establish an alternate communication path through a circuit based Public Switch Telephone Network (PSTN) network for describing a "transaction" utilizing wireless communication (RF, IR) network in a secure manner, as evident due to the essential presence of the electronic credit card (ECC). Exh. 2001, ¶58

A POSITA would understand that switching data conveyance between devices communicating stored data directly or over a non-circuit based network ("Network 106 may be for example Internet or other suitable data exchange communication network," Exh. 1001, 27-28), is different than setting up different paths between the same devices, i.e., multimode cell phone of 100 and far-end telephone 15 across a PSTN networks as described in *Mooney*. Exh. 2001, ¶59. A POSITA would not look to circuit-based PSTN networking of *Mooney* when considering "switching data conveyance." Exh. 2001, ¶60

A POSITA would not look to *Mooney* relying on a piconet that requires preconfigured network association like Bluetooth when attempting to solve problems of a device capable of communicating with "data exchange devices [that] can be any sort of data exchange device comprising an electric circuit...therein and a data transceiver 9a therein able to cooperate with transceiver 18 of device 10, Exh.

1001, 9:3-8, such as 104 of Fig. 1 of the '294 Patent. The problem being solved is communicating with “any sort of data exchange device” and not preconfigured Piconet devices. *Mooney* is fundamentally about “telephone calls” while '294 is about “transactions.” Exh. 2001, ¶61.

2. Independent Claim 1

Mooney does not render claim 1 obvious because at least one claim element is not found in the reference and what a POSITA’s knowledge. See Exh. 2001, ¶62.

a. [1.a] “an electronic circuit capable of storing data therein, capable of processing data, and capable of data input and output;”

The Petition asserts that “[r]egarding the claimed “storing” and “processing,” *Mooney* explains that “the 3-in-1 cell phone,” as was known in the art, “include[s] the ability and convenience of storing all phone book data, calling history and user preferences.” *Mooney*, 1:32-45; Lipoff, ¶83.’ Pet. 16. First, this **is not** what *Mooney* explains. What *Mooney* actually teaches is:

Convenience aside, a 3-in-1 cell phone conventionally provides establishment of a telephone call with a wireless cell phone network, or with a local cordless telephone, depending upon which mode the phone is in. To operate the 3-in-1 cell phone in a cordless telephone mode, the 3-in-1 cell phone is manually switched to a cordless telephone mode by the user, and then a telephone call is made from the base unit. Similarly, to operate a 3-in-1 cell phone in a cellular mode, the 3-in-1 phone is manually switched to a cellular mode, and then a cellular

telephone call is established from the handset. To switch between cordless and cellular modes, the user must first terminate any existing telephone call, and then manually switch the mode of the 3-1 telephone.

Exh. 1005, 1:32-45.

Conversely, what Lipoff says at ¶83 is:

Mooney discloses [1.a] because *Mooney's* “multimode cell phone” includes various electrically coupled electronic components, including conventional storage for storing data, “an appropriate processor” capable of processing data, and “multiple functional modes, e.g., a cell phone mode 100a, a piconet cordless telephone 100b, and a walkie-talkie mode 100c.” and “automatic switchover module” capable of data input and output (collectively, “an electronic circuit”). *Mooney*, 1:54-66, 3:52-63, 7:9-12.

Exh. 1003, ¶83; Exh. 2001, ¶63. Neither the cited section of *Mooney* or the cited section of Exh. 1003 supports storing phone book data, calling history, and user preferences. Exh. 2001, ¶64. The '294 patent teaches data that is stored prior to transmission, which is not simply stored data as asserted by Petitioner. Petitioner referring to “memory” or “data that may be saved in a memory” fails to establish that the data will be transmitted through a transceiver as required in the claims, (e.g., element 1.h).

The Petition goes on to assert that “A POSITA would have understood that the electronic circuit of *Mooney's* multimode cell phone is capable of storing

instructions (data) in addition to “phone book data, calling history and user preferences” that the processor processes to achieve the aforementioned “initiate, establish and switch over” functions. *Mooney*, 7:9-12; *id.*, 17 3:60-63 (“The desired mode of the multimode cell phone 100 may be controlled through suitable communications with each communication path functionality 100a–100c”); Lipoff, ¶84.” Pet. 16-17; Exh. 2001, ¶65.

Once again, Lipoff in ¶84 erroneously asserts that *Mooney* at 1:32-45 teaches the storing all phone book data, calling history, and user preferences. The “data” term in the claims of the ’294 Patent has to be able to be transferred. Here, Lipoff makes a blanket statement that cell phones are capable of storing instructions (data). Simply saying “data exists” is not what is claimed in the ’294 Patent, such as that stated in element 1.h.

What Petitioner and Lipoff fail to explain is what data is explicitly stored and what data is considered input and output, and what is actually switched. What Petitioner and Lipoff are attempting to describe is that *Mooney* uses real-time voice data being transmitted between telephones over circuits in a PSTN. Therefore, the “data” term described in the Petition is not stored data, rather it is real-time data, and this type of data fails to meet the data element used in later elements of the claims. See Exh. 2001, ¶66. The same data that is stored is processed, and capable of being input and output in the ’294 Patent. Exh. 2001, ¶67.

Mooney, as cited by Petitioner and their expert, fail to establish a circuit for storing data, processing data, and being capable of data input and output of that data. Exh. 2001, ¶68.

b. [1.e] “a cue receiver operatively linked to said electronic circuit for receiving an activation cue from a source external to said cellular phone”

The '294 Patent identifies an activation cue as being “in the form of a data communication of a specific type which will be recognized by the electronic device 10 as an activation cue, for example, a predetermined bit sequence.” Exh. 1001, 9:24-27. The “activation cue” must be recognized by the electronic device as an activation cue. Thus, simply calling something an “activation cue” is improper if the electronic device does not specifically recognize it as an “activation cue.” For example, if a receiver comes into range of a transmitter and processes data from the transmitter that is received at that receiver when a signal from the transmitter carrying that data is strong enough to be processed at the receiver. The receiver is not waiting for a specific “recognizable activation cue.” Rather the receiver simply was trying to receive a signal and process a signal. Further, “upon an activation cue being received by portable electronic device 10, switching element 44b switches to its activated state.” Exh. 1001, 10:14-16; Exh. 2001, ¶69.

The Petition asserts that receiving “quality” Bluetooth signals is an activation cue from a “piconet front end.” Pet. 26. A “cordless telephone link (e.g., Bluetooth

signal link of good quality is a link that has been established with the cordless base for a given length of time (e.g., for at least two minutes).” Pet. 26-27; Exh. 2001, ¶70.

First, *Mooney* does not describe a “Bluetooth signal link of good quality.” *Id.* What is actually described in *Mooney* is:

A person on their way home is talking to a co-worker on their multimode cell phone 100 (in cell phone mode). That person then arrives home and sits down near their cordless base station 110. Preferably, the multimode cell phone 100 maintains a configuration such that when a cordless telephone link (e.g., a piconet BLUETOOTH™ link of good quality) has been established with the cordless base for a given length of time (e.g. for at least two minutes), then the multimode cell phone handset 100 will allow switch over to the cordless telephone call and ultimately drop or terminate the original cell phone call.

Id., 14-24 (*emphasis added*). No mention of a quality signal is made in the paragraph. The paragraph refers to a “link,” that is, the call between the cordless base station and the end telephone user that has been set up and ready to be transferred to, and not the Bluetooth “signal” between the cellular telephone in the cordless telephone mode and the cordless telephone base unit. Exh. 2001, ¶71.

No Bluetooth link exists without the cellular telephone in the cordless telephone mode, actively communicating with the cordless telephone base unit.

Further when the cellular telephone comes into range of the cordless telephone base unit. It is the cellular telephone that transmits a Bluetooth ping to notify the cordless telephone base unit it is in range; it is not an “activation cue” received by the cellular telephone when it detects a signal from the cordless telephone base. As a matter of fact, activation cue is NOT a measure of, or quality of a signal. Activation cue is different from quality of signal. The Bluetooth specification cited in *Mooney (see id. 2:65-3:3)* explains the process:

A TL [terminal] that is out of range of a GW (gateway) searches for it by periodically trying to page it. A GW shall devote as much of its free capacity as possible (considering power limitations and ongoing signalling) to page scanning in order to allow roaming TLs that enter the range of the GW to find it as quickly as possible. This scheme minimizes ‘air pollution’ and gives reasonable access time when coming into range of the GW. When a TL has successfully paged a GW, a master-slave switch shall be performed since the GW shall be the master. A connection-oriented L2CAP channel and, possibly, a L2CAP connectionless channel are established to be used for all TCS signaling during that Cordless Telephone session.

Exh. 2003, 111. The Cellular telephone is not coming into range and detecting a Bluetooth signal, and once the signal from the cordless telephone base unit is strong enough (i.e., a Bluetooth signal link of good quality is a link that has been established (asserted activation cue)). The cellular telephone continually transmits pings and attempts to contact the GW (cordless telephone base unit), regardless of the

Bluetooth strength. So, the received signal strength is not what the cellular telephone uses to determine if it is in the range of a GW. It is the GW that determines if it has received the page from the cellular phone, and to receive the page, the GW must have an adequate signal FROM the cellular telephone. Exh. 2001, ¶72.

The Bluetooth link between the cellular telephone and the cordless base unit is established when in active use. The Bluetooth specification states that:

A TL that is within range of a GW shall normally be in park mode when it is not engaged in calls. This mode is power-efficient, allows for reasonable call setup times and allows broadcasting to the attached TLs.

Exh. 2003, 111. Once the cellular telephone has transmitted a ping over Bluetooth and the GW has detected it and responded, the resulting connection is not a link. No permanent links have been established between the GW and cellular telephone. The cellular telephone is in “park mode.” “Upon arrival of an incoming call, or when a TL wants to make an outgoing call, the GW shall be put in active mode. The L2CAP channels...are used for all TCS control signalling.” Exh. 2003, 111. The only way a link can be established for a predetermined amount of time, such as two minutes, is if the GW is put into active mode because of an incoming or outgoing call. Exh. 2001, ¶73.

The asserted link of good quality discussed in *Mooney* (see Exh. 1005, 6:20-21) is a call that has been initiated and setup through the PSTN by the cellular phone with the cordless telephone base unit. The Bluetooth specification requires a call

(incoming or outgoing) in order to establish a connection for a predetermined length. The “cordless module is informed of the signal quality [link of good quality established for at least two minutes] (via its first transceiver/cue receiver) and a call may be established in cordless mode via BLUETOOTH™” (Pet. 27) is not true. An incoming or outgoing call is required to establish a link that is timed for at least two minutes; a condition for allowing the establishment of a link cannot be having already established the link for two minutes. Exh. 2001, ¶74.

i. Petitioner’s Expert’s Declaration is Flawed

Petitioner’s Expert’s declaration is flawed and their expert did not consider the actually teachings of the Bluetooth specification that was incorporated by reference leading his erroneous assertions. *Mooney* does not function as asserted in Petitioner’s expert declaration. In the ’294 Patent, “an activation cue” is described as:

[A]n activation cue can be received by electronic device 10 from data exchange device transceiver 9a. This activation cue is in the form of a data communication of a specific type which will be recognized by electronic device 10 as an activation cue, for example a predetermined bit sequence.

Exh. 1001, 9:22-27 (*emphasis added*). The activation cue must be a specific type of data communication from an external source, which will be recognized

by the electronic device of the claims *before* data is transmitted. Exh. 2002, pp. 218-219.

Petitioner relies on the teachings of Bluetooth contained in *Mooney* as disclosing “an activation cue.” *Mooney* makes use of “‘piconet technology’² in general, and Bluetooth technology in particular.” Exh. 1005, 2:39-40. *Mooney* incorporated by reference a Bluetooth standard. *Id.* 2:57-64. However, neither Petitioner nor its Expert considered, much less entered into evidence, the incorporated Bluetooth specification, version 1.1. This oversight is important because the Bluetooth specification explicitly contradicts Petitioner and its expert. Therefore, PO entered it as evidence at Exh. 2003.

Petitioner’s expert relies on is his own opinion of what a POSITA would know, but the incorporated Bluetooth specification is what a POSITA *actually* knew at the time *Mooney* was filed. *See* Exh. 2003, published Feb. 22, 2001. Additionally, Petitioner’s expert is not a Bluetooth expert. *See* Exh. 1003, ¶¶9-22. Because Petitioner’s own knowledge and experience contradict the Bluetooth specification, it is *per se* improper.

² “Piconet technology” is described in the Bluetooth specification as Bluetooth signalling used for cordless phones.

ii. Petitioner’s Arguments are Contrary to the Bluetooth Specification

Bluetooth, as described in Exh. 2003 and incorporated into *Mooney*, operates contrary to Petitioner’s description. First, *Mooney* does not describe a “Bluetooth signal link of good quality” as a quantified, measured, or monitored attribute of the signal link, such as signal strength. That is Petitioner’s embellishment. Instead, *Mooney* only describes a Bluetooth link established for a duration of two minutes before transferring a cellular call to the cordless base unit. *Mooney* does not teach or suggest the “activation cue” as asserted by Petitioner.

First, no Bluetooth link can ever exist without the cellular telephone operating in the cordless telephone mode, (e.g., actively communicating with the cordless telephone base unit). When the cellular telephone comes into range of the cordless telephone base unit. It is the cellular telephone that transmits a Bluetooth ping to notify the cordless telephone base unit it is in range; it is not an ‘activation cue’ received by the cellular telephone when it detects a signal from the cordless telephone base. *See* Exh. 2003, 111. Hence, the cellular phone in *Mooney* contacts the cordless phone and not the other way around.

Further, *Mooney*’s purported measurement of Bluetooth signal quality or two-minute connection time cannot be the claimed “activation cue.” The Bluetooth specification incorporated by *Mooney*, explains the process:

A TL [terminal or cordless telephone] that is out of range of a GW (gateway) [or cordless base unit] searches for it by periodically trying to page it. A GW shall devote as much of its free capacity as possible (considering power limitations and ongoing signalling) to page scanning in order to allow roaming TLs that enter the range of the GW to find it as quickly as possible. ... When a TL has successfully paged a GW, a master-slave switch shall be performed since the GW shall be the master. A connection-oriented L2CAP channel and, possibly, a L2CAP connectionless channel are established to be used for all TCS signaling during that Cordless Telephone session.

Exh. 2003, 111. The terminal (e.g., the cordless telephone) that is sending a page does not *receive* the “activation cue.” Similarly, when a cellular phone in *Mooney* is incorporated, it too sends the page or “pings” the CTBS:

The cellular telephone continually transmits pings and attempts to contact the GW (cordless telephone base unit), regardless of the Bluetooth strength. So, the received signal strength is not what the cellular telephone uses to determine if it is in the range of a GW. It is the GW that determines if it has received the page from the cellular phone, and to receive the page, the GW must have an adequate signal FROM the cellular telephone.

Exh. 2001, ¶72. The Bluetooth link between the cellular telephone and the cordless base unit is established only when in active use. The Bluetooth specification states that:

A TL [cordless telephone] that is within range of a GW [cordless base unit] shall normally be in park mode when it is not engaged in calls.

Exh. 2003, 111 (emphasis in original). The terminal (cordless telephone) is in “park mode” when not engaged in a call. “Upon arrival of an incoming call, or when a TL wants to make an outgoing call, the GW shall be put in active mode. The L2CAP channels...are used for all TCS control signaling.” Exh. 2003, 111. Thus, no link exists without a call being set up and established. No quality of signal can be determined for a link until a call is actually established. Once the call is set up or established, then the two-minute timer starts.

The two-minute timer cannot act as “an activation cue” because it is not received by *Mooney’s* cellular phone but is actually set within the cellular phone. *See* Exh. 1005, 6:15-24. The timer is not set before activation of the link and only *after* activation of a call over the Bluetooth link, prior to *Mooney’s* cellular phone transferring the cellular call. “A timer is used within the cellular telephone to time the link (i.e., call). This timer is internal to the cellular telephone and is not received as required by the claim element of the ’294 Patent.” Exh. 2001, ¶76. Further, the

transfer of the active call is initiated by the cellular phone in *Mooney*, so the transfer cannot be an activation cue. *See* Exh. 1005, 6:25-29.

An activation cue cannot be a Bluetooth link that has been set for two minutes because call data has already been sent from the Bluetooth transceiver to the cordless telephone base unit in order to set up the link, i.e., caller ID data to establish the path through the PSTN. This demonstrates that communication of call data occurs before the predetermined time that is erroneously asserted as the activation cue has been received. Exh. 2001, ¶75.

However, the claim element requires the activation cue to be received at the activation cue transceiver. A timer is used within the cellular telephone to time the link (i.e., call) set up through the PSTN. This timer is internal to the cellular telephone and is not received as required by the claim element of the '294 Patent. Exh. 2001, ¶76. *Mooney* fails to teach “activation cue” because 1) call data is transmitted *before* Petitioner’s alleged activation cue is received in the active state assigned, and 2) the timer for the at least two-minute time period is not “external to said cellular phone” because *Mooney*’s cellular phone itself sets the time period and also causes transfer. Exh. 2001, ¶77.

iii. The Decision to Institute Erroneously Found an “Activation Cue” Occurs in Element [1.e] when a Quality Bluetooth Signal (e.g., call received for two minutes) is Received From the Cordless Base Unit

The DI erroneously found “that the piconet/Bluetooth cordless module of the cellular phone in *Mooney* receives a quality Bluetooth signal from the cordless base unit, which acts as an ‘activation cue’ to switch a phone call (transmission of voice/call data) from cell phone mode to Bluetooth mode.” DI, p. 27(emphasis added)(for element [1.e]). However, the ’294 Patent requires an “activation cue” that occurs *before* data is exchanged, not two minutes after a link is active and data has been exchanged. *See* Exh. 2001, ¶¶31-32. Further, the “activation cue” must be “external to said cellular phone,” but the timer in *Mooney* is inside the cellular phone. Additionally, according to the Bluetooth standard, a link does not exist until a call is made because the call must exchange data specific to that call setup. Exh. 2003, 111. Conversely, the Board erroneously found a link already active for two minutes satisfies the “activation cue.”

Although extrinsic evidence “may be useful to the court,” it is considered “less significant” than the claim language, specification, and prosecution history making up the intrinsic record. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005). The Board’s construction of an “activation cue” as a quality timer for when the cellular phone of *Mooney* switches a call goes outside of the intrinsic record, reading

limitations of *Mooney* into the '294 patent. *See* DI, p. 27. Furthermore, Petitioner and the DI confuse disclosure of a device entering Bluetooth range with actually making a call that establishes a link.

Hence, Petitioner did not meet its burden of establishing element [1.e] was found in the references. “Failure to prove the matter as required ... means that the party with the burden of persuasion loses on that point—thus, if the fact trier of the issue is left uncertain, the party with the burden [the petitioner] loses.” *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378-79 (Fed. Cir. 2015). The preponderance of the evidence does not support the determining element [1.e] operates as Petitioner and its expert assert. Hence, there can be no likelihood of success, especially when Petitioner’s explanation explicitly contradicts the teachings of the Bluetooth specification that was incorporated by reference into *Mooney*.

3. [1.f] “ a data conveyance switching element operatively linked to said electronic circuit, said switching element being assigned a first state upon an activation cue having been received by said cue receiver, and being assigned a second state when no activation cue was received by said cue receiver; and”

The claim element requires the “data conveyance switching element operatively linked to said electronic circuit and being assigned a first state upon an activation cue having been received by said cue receiver. The state has to be

assigned when the activation cue having been received. *Mooney* fails to describe this claim element. Exh. 2001, ¶78.

The '294 Patent describes the switching element as “any type of device allowing data to be conveyed according to alternate data conveyance operation in response to an activation cue begin received by the transceiver 18 or not.” Exh. 1001, 9:28-31. The state must change when the activation cue is received. Exh. 2001, ¶79. “[U]pon an activation cue being received by portable electronic device 10, switching element 44b switches to its activation state. If the control device 12 is selectively triggered by the portable electronic device holder while switching element 44b is in this activated state, data exchange will be initiated between the portable electronic device 10 and the external data exchange device 9.” Exh. 1001, 10:13-20. Exh. 2001, ¶80.

The switching element is linked to said electronic circuit, and no other dependencies are claimed in the '294 Patent other than a transceiver receiving the action cue. The activation cue results in switching that allows a portable electronic device, when triggered by the control device, to exchange data between the portable electronic device 10 and the external data exchange device 9. Exh. 2001, ¶81.

First, the use of a Bluetooth signal is not an activation cue, but ignoring that, *Mooney* does not describe automatic switching based upon the Bluetooth signal as asserted in the Petition. What *Mooney* describes is:

In accordance with the principles of the present invention, an automated procedure may be initiated by the user of the multimode cell phone 100 at the press of a designated button. The user may be prompted about impending loss of signal or otherwise loss of the established telephone call, and may be prompted to permit establishment of and ultimately transfer to an alternative type communication path (e.g., a cellular phone call). In response, the user preferably activates a suitable button, e.g., a dedicated button called, e.g., “Switch to Cell Network”, or simply “Switch Communication Path”. Of course, the transfer may be entirely automated without requiring input from the user, within the scope of the invention.

Exh. 1005, 4:37-49. Transferring from a cordless telephone to cellular telephone is not necessarily automatic as asserted in the Petition, (*See* Pet. 28-30), a user must press a button to make the transfer occur. Exh. 2001, ¶82.

Second, transferring of the calls does not occur upon the pressing of a designated button (or automatic, if even possible). Rather, a second call path is attempted to be established through the PSTN. *See* Exh. 1005, 4:50-5:62. A second call path is attempted to be setup, the transferring of the call occurs ONLY after the second path has been successfully established:

To accomplish this, the multimode cell phone 100 may send, e.g., a quick DTMF “7” followed by a DTMF “9” (i.e., representing the characters “SW”) notifying the near end user and the far end phone 150 (and user) that a switch is about to happen. The far end phone 150 would remain ready for a switch over for a given length of time, e.g.,

for 20 seconds. The multimode cell phone 100 makes the alternate phone call as described above. After the far end phone receives the new call, it checks the call related information (e.g., CallerID data) against entries in a suitable lookup table, and if it finds a match, then automatically flashes the telephone line on the original telephone call. The near end phone, as in the first example, is then notified that the second call has gone through, allowing the conversation to continue on a switched over communication path.

Exh. 1005, 6:26-39. The original communication path is still active until the call is transferred over. There can be no change of state or transfer of a communication path until after the second communication path is established. This is opposed to the claim language requiring the state to change upon reception of the activation cue. Exh. 2001, ¶83.

The change of state or transferring of the communication path in *Mooney* may never occur. If the setup of the call path is not successful due to the far-end phone refusing to accept (Exh. 1005, 5:1-3) the call³ or the actual transfer fails:

In the unlikely event that the switchover does not succeed, the switchover is preferably delayed (e.g., for 10 seconds or more) to allow

³ “The converse of the example of FIGS. 1 and 2 is also possible. For instance, the multimode cell phone 150 may move from a cell phone call to a cordless telephone call.” Exh. 1005, 5:7-9.

the users to switch back to the initial telephone call or communication path.

Exh. 1005 6:41-44. A state change in *Mooney* is not in response to a request to transfer, rather it is upon the successful completion of setting up the path through the PSTN and successful transfer to the new path through the PSTN. Exh. 2001, ¶84.

The Petition erroneously asserts that states are assigned before a second call path through the PSTN is established and transfer to the second path (i.e. switching) has occurred:

[An] (electronic circuit) that is assigned (1) a “piconet cordless telephone mode” (first state) when a quality Bluetooth signal is received by the piconet module transceiver (upon an activation cue having been received by the cue receiver) or (2) a “cell phone mode” (second state) when no quality Bluetooth signal is received by the piconet module transceiver (when no activation cue was received by said cue receiver).

Pet. 29. The claim does not simply require a first state and a second state be assigned at some point as identified by the Petitioner; it requires “said switching element being assigned a first state upon an activation cue having been received by said cue receiver” (Exh. 1001, 23-28), which requires the first state to be assigned upon the activation cue having been received. Exh. 2001, ¶85. The alleged state does not change based upon the asserted “activation cue” being received (i.e., signal of

sufficient strength). Rather, in the Petition's approach, the activation would occur at some time after the second call path has been successfully established, assuming it is even successfully established.

Mooney does not have an activation cue as described in the '294 Patent, and even if the Petitioner's initiation of a transfer was in response to an activation cue, no change of state assignment as required by this claim element occurs in response to any such initiation. Rather, a change of state only occurs in *Mooney* after 1) successfully setting up a second path; and 2) successfully transferring over to the new path. The act of communicating with a cordless telephone base station does not result in a change in the state of the call or transfer of the call in *Mooney*. Exh. 2001, ¶86.

4. **[1.h]: “wherein upon said control device being selectively triggered by the user to issue said invariable activation command: if said switching element is in said first state, a first data conveyance operation will be initiated through the instrumentality of said first data transceiver for sending data from said electronic circuit to the first external data exchange device over said first communication link; and ”**

The claim element [1.e] establishes the only way to be assigned a first state is upon an activation cue being received. The Petition asserts the activation cue is when the piconet receiver comes into range (receives a strong signal) from the cordless telephone base unit and a cellular call is occurring. As previously explained, that is not how Bluetooth works. See Exh. 1002, ¶¶69-75; Exh. 2001,

¶¶87-88. The Petitioner's Expert did not consider the teachings of the Bluetooth specification that was incorporated by reference into the Mooney patent.

Petitioner now admits that the first state is not dependent upon an activation cue, but rather simply the connection to the cordless telephone base. If, as asserted by the Petitioner (Pet. 36) for element 1.h, simply connecting the cellular telephone to the base unit and dialing numbers are triggering. Exh. 2001, ¶89.

The purpose of the invariable activation command is security. The '294 Patent describes the invariable activation command as:

It is noted that, according to the present invention, the activation command issued when control device 12 is triggered, is an invariable activation command. That is to say that the portable electronic device holder will not be able to select to issue different activation commands by means of control device 12 depending on whether the user considers that a data exchange operation should be accomplished with an external data exchange device 9, or whether the user wishes to display information on screen 16 on the basis of data stored in memory 42. The same invariable activation command will thus be issued upon control device 12 being triggered, and it is the state of switching element 44 b, resulting from the receipt or non-receipt of an activation cue by portable electronic device 10, that will be decisive as to the type of data conveyance that will occur.

Exh. 1001, 10:37-51. Exh. 2001, ¶90.

Dialing a phone is not issuing an invariable activation command. As mentioned in *Mooney*, a user can use call features of the PSTN to make another call while placing one on hold. Exh. 1005, 4:59-5:57. Multiple “invariable activation commands cannot be issued, as it would not be invariable. If entering a phone number is an invariable activation command, then a second number cannot be entered. But the Bluetooth specification teaches exactly that. Entering a second phone number or other post-dialing (The ability to send dialing information after the outgoing call request set-up message is sent. Exh. 2003, 112) is allowed. Exh. 2001, ¶91.

Dialing a phone number is not “invariable” and a second phone number can be dialed while the call to the first number is active. Further both calls can be connected demonstrating a second activation can be selected when a first activation has occurred. Exh. 2001, ¶92.

Because dialing a telephone number is not an invariable activation command, this element is not described in *Mooney*. Exh. 2001, ¶93. Also, *Mooney* does not provide the claim elements associated with an activation cue and invariable activation command, as claimed in the '294 Patent. Further, *Mooney* is about establishing telephone calls and '294 Patent is about transactions due to ECC. Exh. 2001, ¶94.

5. Claim 2 – “A cellular phone as defined in claim 1, further comprising a display screen operatively linked to said electronic circuit.”

Claim 2 is a dependent claim and incorporates all the elements of claim 1. All the elements of claim 1 are not disclosed in *Mooney* or provided by what a POSITA would know. *See* Exh. 2001, ¶¶62-94; Exh. 2001, ¶¶95-96. Therefore, all of the claim elements of claim 2 are not found in *Mooney*. Exh. 2001, ¶97.

6. Claim 3 – “A cellular phone as defined in claim 1, wherein said first data transceiver includes said cue receiver.”

Claim 3 is a dependent claim and incorporates all the elements of claim 1. All the elements of claim 1 are not disclosed in *Mooney* or provided by what a POSITA would know. *See* Exh. 2001, ¶¶ 62-94; Exh. 2001, ¶¶98-99. All of the claim elements of claim 3 are not found in *Mooney*. Exh. 2001, ¶100.

7. Claim 4 – “A cellular phone as defined in claim 1, wherein said control device is one of a manually activated button, a keypad for receiving a PIN code, a biometric parameter detector and a combination thereof.”

Claim 4 is a dependent claim and incorporates all the elements of claim 1. All the elements of claim 1 are not disclosed in *Mooney* or provided by what a POSITA would know. *See* Exh. 2001 ¶¶ 62-94; Exh. 2001, ¶¶101-102. All of the claim elements of claim 4 are not found in *Mooney*. Exh. 2001, ¶103.

8. Claim 5 – “A cellular phone as defined in claim 1, wherein said electronic circuit includes said switching element.”

Claim 5 is a dependent claim and incorporates all the elements of claim 1. All the elements of claim 1 are not disclosed in *Mooney* or provided by what a POSITA would know. *See* Exh. 2001, ¶¶62-94; Exh. 2001, ¶¶104-105.

Petitioner fails to identify where the switching element is, as defined in claim 1 element of “a data conveyance switching element operatively linked to said electronic circuit, said switching element being assigned a first state upon an activation cue having been received by said cue receiver, and being assigned a second state [sic] when no activation cue was received by said cue receiver.” *See* Exh. 2001, ¶¶ 78-86; Exh. 2001, ¶106. Thus, all of the claim elements of claim 5 are not found in *Mooney*. Exh. 2001, ¶107.

9. Claim 6 – “A cellular phone as defined in claim 5, wherein said electronic circuit comprises a microchip, and wherein said switching element is a series of instructions programmed onto said microchip.”

Claim 7 is a dependent claim and incorporates all the elements of claim 1. All the elements of claim 1 are not disclosed in *Mooney* or provided by what a POSITA would know. *See* Exh. 2001, ¶¶108-109.

Petitioner fails to identify where the switching element is, as defined in claim 1 element of “a data conveyance switching element operatively linked to said electronic circuit, said switching element being assigned a first state upon an

activation cue having been received by said cue receiver, and being assigned a second state when no activation cue was received by said cue receiver.” See Exh. 2001 ¶¶ 78-86. Simply stating that a POSITA can implement switching in software does not establish that a POSITA would understand how to implement a data conveyance switch as required when all the elements related to the data conveyance are considered. Exh. 2001, ¶110. Thus, all of the claim elements of claim 6 are not found in *Mooney*. Exh. 2001, ¶111.

10. Claim 7 – “A cellular phone as defined in claim 1, wherein said switching element comprises a logical circuit.”

Claim 7 is a dependent claim and incorporates all the elements of claim 1. All the elements of claim 1 are not disclosed in *Mooney* or provided by what a POSITA would know. See Exh. 2001 ¶¶62-94; Exh. 2001, ¶¶112-113.

Petitioner fails to identify where the switching element is, as defined in claim 1 element of “a data conveyance switching element operatively linked to said electronic circuit, said switching element being assigned a first state upon an activation cue having been received by said cue receiver, and being assigned a second state when no activation cue was received by said cue receiver.” See Exh. 2001 ¶¶ 78-86; Exh. 2001, ¶114. All of the claim elements of claim 7 are not found in *Mooney*. Exh. 2001, ¶115.

- 11. Claim 8 – “A cellular phone as defined in claim 1, wherein said first data transceiver comprises a proximity transceiver for accomplishing a wireless data exchange with a first external data exchange device through a direct link representing said first communication link where the cellular phone is conveyed toward a close proximity of the first external data exchange device and within a range to receive the activation cue to initiate the wireless data exchange.”**

Claim 8 is a dependent claim and incorporates all the elements of claim 1. All the elements of claim 1 are not disclosed in *Mooney* or provided by what a POSITA would know. *See* Exh. 1002 ¶¶62-94; Exh. 2001, ¶¶116-117.

The claim language does not simply state proximity; rather, it has to be in close proximity of the first external data exchange device. *See* Exh. 1001, 19:67. Close proximity is described in the '294 Patent as “a proximity transceiver that allows data transmission within a limited range, such as within several meters for example.” Exh. 1001, 15:55-57. The piconet/Bluetooth receiver has a range of up to 100 feet [30 meters], according to *Mooney*. *See* Exh. 1005, 43-45; Exh. 2001, ¶118.

The cellular telephone device is described by the Petitioner as receiving the activation cue as soon as the piconet signal is detectable. That position would place the cellular telephone towards the 30-meter range and not the several-meter range that the '294 Patent defines as “close proximity.” *See* Exh. 1001, 15:55-57. Close proximity is also within a limited range through a corresponding direct link. *See* Exh. 1001, 15:61-63. The cellular telephone of *Mooney* only has to be in the range

of the cordless base station and not in close proximity to the cordless base station.

Exh. 2001, ¶119. Thus, all of the claim elements of claim 8 are not found in *Mooney*.

Exh. 2001, ¶120.

- 12. Claim 9 – “A cellular phone as defined in claim 8, wherein said second data transceiver comprises a communication network transceiver for wireless communication through a communication network that represents said second communication link, with one of a remote portable electronic device, a remote server, a remote terminal and a combination thereof.”**

Claim 9 is a dependent claim and incorporates all the elements of claims 1 and 8. All the elements of claim 1 and 8 are not disclosed in *Mooney* or provided by what a POSITA would know. *See* Exh. 2001, ¶¶62-94; Exh. 2001, ¶¶121-122.

All of the claim elements of claim 9 are not found in *Mooney*. Exh. 2001, ¶123.

13. Independent claim 10.

- a. [10.a]: “an electronic circuit capable of storing data therein, capable of processing data, and capable of data input and output;”**

As previously discussed, *Mooney* does not describe this element. *See* Exh. 2001 ¶¶ 63-68; Exh. 2001, ¶124.

- b. [10.f] “a cue receiver operatively linked to said electronic circuit for receiving an activation cue from a source external to said cellular phone; and”**

An activation cue is not described in *Mooney*. See Exh. 2001 ¶¶ 69-77; Exh. 2001, ¶125. An activation cue is not described in *Mooney*. Exh. 2001, ¶126.

- c. **[10.h] “wherein upon said control device being selectively triggered by the user to issue said invariable activation command: if an activation cue was received by said cue receiver, said electronic circuit will accomplish said first data conveyance operation to convey data from said electronic circuit to said first data transceiver for transmitting data through said first data transceiver; and”**

An activation cue and invariable activation command are not described in *Mooney*. See Exh. 2001 ¶¶ 87-94; Exh. 2001, ¶127.

An activation cue and invariable activation command are not described in *Mooney*. Also, not all of the elements of independent claim 10 are disclosed in *Mooney* nor made available through the knowledge of a POSITA. Exh. 2001, ¶¶128-129.

14. Independent claim 11

- a. **[11.d]: “an electronic circuit capable of storing data therein, capable of processing data, and capable of data input and output;”**

119. As previously discussed, *Mooney* does not describe this element. See Exh. 2001, ¶¶ 63-68; Exh. 2001, ¶130.

- b. [11.h]: “a cue receiver operatively linked to said electronic circuit for receiving an activation cue from said first data exchange device;”

An activation cue is not described in *Mooney*. See Exh. 2001, ¶¶ 69-77; Exh. 2001, ¶131. An activation cue is not described in *Mooney*. Exh. 2001, ¶132.

- c. [11.i]: “a data conveyance switching element operatively linked to said electronic circuit, said switching element being assigned a first state upon an activation cue having been received by said cue receiver, and being assigned a second state when no activation cue was received by said cue receiver; and”

A data conveyance switching element and activation cue are not described in *Mooney*. See Exh. 2001 ¶¶ 78-86; Exh. 2001. An activation cue is not described in *Mooney*. Exh. 2001, ¶¶133-134.

- d. [11.k]: “wherein upon said control device being selectively triggered by the user to issue said invariable activation command: if said switching element is in said first state, a first data conveyance operation will be initiated through the instrumentality of said first data transceiver for exchanging data between said electronic circuit and the first external data exchange device; and”

An activation cue and invariable activation command are not described in *Mooney*. See Exh. 2001, ¶¶ 87-94; Exh. 2001, ¶135.

An activation cue and invariable activation command are not described in *Mooney*. Also, all of the elements of independent claim 11 are not disclosed in *Mooney* nor made available through the knowledge of a POSITA. Exh. 2001, ¶¶136-137.

15. Independent claim 12

- a. **[12.pre]: “A method for data conveyance with a cellular phone of the type comprising: an electronic circuit capable of storing data therein, capable of processing data, and capable of data input and output, a user-triggered control device operatively linked to said electronic circuit, said user-triggered control device configured to be operated by a user via one of a button, a keypad, a tactile screen, and a biometric parameter detector, and after being operated issue an invariable activation command, first and second data transceivers operatively linked to said electronic circuit, a cue receiver operatively linked to said electronic circuit, a data conveyance switching element operatively linked to said electronic circuit and capable of being in either one of a first and a second state, and power means for providing power to said cellular phone, said method comprising the steps of:”**

The “an electronic circuit capable of storing data therein, capable of processing data, and capable of data input and output” claim element is addressed previously and not described in *Mooney*. See Exh. 2001, ¶¶ 63-68; Exh. 2001, ¶138.

- b. **[12.a]: “awaiting for an activation cue to be received at said cue receiver;”**

An activation cue is not described in *Mooney*. See Exh. 2001, ¶¶ 69-77. An activation cue is not described in *Mooney*. Exh. 2001, ¶¶139-140

- c. **[12.b]: “if an activation cue is received at said cue receiver, assigning said first state to said switching element, while if no activation cue is received at said cue receiver, assigning said second state to said switching element; and;”**

An activation cue and assignment of states as described in the '294 Patent are not described in *Mooney*. See Exh. 2001 ¶¶ 78-86. An activation cue and assignment of a state as described in the '294 Patent is not described in *Mooney*. Exh. 2001, ¶¶ 141-142.

- d. **[12.c]: “a user selectively triggering said control device to issue an invariable activation command whereby: if said switching element is in said first state, forwarding first data to said first data transceiver for initiating a data exchange operation with a first external data exchange device over a first communication link; and”**

An invariable activation command as claimed in the '294 Patent is not described in *Mooney*. See Exh. 2001, ¶¶ 87-94; Exh. 2001, ¶ 143.

An invariable activation command, as described in the '294 Patent, is not described in *Mooney*, also *Mooney* fails to teach or describe all of the claim elements of claim 12. Exh. 2001, ¶¶ 144-145.

- 16. Claim 13 – “A method as defined in claim 12, further comprising the following step before the step of forwarding first data to said first data transceiver for initiating a data exchange operation with a first external data exchange device:**

forwarding third data to and displaying said third data on a display screen provided on said cellular phone, wherein said third data is representative of the content of said first data.”

Claim 13 is a dependent claim and incorporates all the elements of independent claim 12. All the elements of claim 12 are not disclosed in *Mooney* or

provided by what a POSITA would know. *See* Exh. 2001, ¶¶ 138-145; Exh. 2001, ¶¶ 146-147.

The Petition asserts that the DTMF ‘7’ and DTMF ‘9’ audio tones represent that the call (first data) will occur over a particular communication pathway. The audio tones are simply tones to notify of switching between two established paths in a communication network. It is independent of a particular communication pathway:

To accomplish this, the multimode cell phone 100 may send, e.g., a quick DTMF “7” followed by a DTMF “9” (i.e., representing the characters “SW”) notifying the near end user and the far end phone 150 (and user) that a switch is about to happen. The far end phone 150 would remain ready for a switch over for a given length of time, e.g., for 20 seconds. The multimode cell phone 100 makes the alternate phone call as described above.

Exh. 1005, 6:25-30. It is noted that setting up the path through the network with the cordless base station requires the cellular telephone to be within range AND receive information about who the cellular telephone is currently talking to over the cellular network. So, CALL ID information must be sent to the cordless base station to set up the PSTN network path that the DTMF “7” and DTMF “9” signals are sent identifying the second call path has been setup and a transfer between the call paths are going to occur. *See* Exh. 1005, 5:37-57. Therefore, the first data forwarded to the first data transceiver is Caller ID information associated with the already established call. The Caller ID information is forwarded before the DTMF “7” and

DTMF “9” signals to set up a call path through the PSTN network and the claim element is not met. Exh. 2001, ¶148. Thus, all of the claim elements of claim 13 are not found in *Mooney*. Exh. 2001, ¶149.

- 17. Claim 14 – “A method as defined in claim 13, wherein after the step of forwarding said third data to the display screen, the method comprises the following step:**

awaiting for an authorization command to be inputted through a user confirmation input device provided on said cellular phone before forwarding said first data to said first data transceiver.”

Claim 14 is a dependent claim and incorporates all the elements of claims 12 and 13. All the elements of claims 12 and 13 are not disclosed in *Mooney* or provided by what a POSITA would know. See Exh. 2001 ¶¶ 138-149; Exh. 2001, ¶¶150-151.

All of the claim elements of claim 14 are not found in *Mooney*. Exh. 2001, ¶152.

- 18. Claim 15 – “A method as defined in claim 12, wherein said first and second data are identical.”**

Claim 15 is a dependent claim and incorporates all the elements of independent claim 12. All the elements of claim 12 are not disclosed in *Mooney* or provided by what a POSITA would know. See Exh. 2001 ¶¶ 138-145; Exh. 2001, ¶¶153-154.

All of the claim elements of claim 15 are not found in *Mooney*. Exh. 2001, ¶155.

19. **Claim 16 – “A method as defined in claim 12, wherein said first data transceiver is a proximity transceiver and the step of forwarding said first data to said first transceiver is for initiating a wireless data exchange operation with a proximate first external data exchange device through a direct link representing said first communication link where the cellular phone is conveyed toward a close proximity of the first external data exchange device and within a range to receive the activation cue to initiate the wireless data exchange.”**

Claim 16 is a dependent claim and incorporates all the elements of independent claim 12. All the elements of claim 12 are not disclosed in *Mooney* or provided by what a POSITA would know. See Exh. 2001, ¶¶ 138-145; Exh. 2001, ¶¶156-157.

The cellular phone is not in close proximity with the first external data exchange device. See Exh. 2001, ¶¶ 114-115. All of the claim elements of claim 16 are not found in *Mooney*. Exh. 2001, ¶¶158-159.

- 20. Claim 17 – “A method as defined in claim 12, wherein said second data transceiver is a communication network transceiver and the step of forwarding said second data to said second data transceiver is for initiating a wireless data conveyance operation through a communication network representing said second communication link, with one of a remote portable electronic device, a remote server, a remote terminal and a combination thereof.”**

Claim 17 is a dependent claim and incorporates all the elements of independent claim 12. All the elements of claim 12 are not disclosed in *Mooney* or provided by what a POSITA would know. See Exh. 2001 ¶¶ 138-145; Exh. 2001, ¶¶ 160-161.

All of the claim elements of claim 17 are not found in *Mooney*. Exh. 2001, ¶ 162.

- 21. Claim 18 – “A method as defined in claim 12, wherein the step of selectively triggering said control device to issue the invariable activation command comprises selectively triggering one of the manually activated button, the keypad for receiving a PIN code, the biometric parameter detector and a combination thereof.”**

Claim 17 is a dependent claim and incorporates all the elements of independent claim 12. All the elements of claim 12 are not disclosed in *Mooney* or provided by what a POSITA would know. See supra ¶¶ 138-145; Exh. 2001, ¶¶ 163-164.

An invariable activation command is not described in *Mooney*. See Exh. 2001, ¶¶ 88-94. All of the claim elements of claim 18 are not found in *Mooney*.

Exh. 2001, ¶¶165-166.

22. Independent Claim 19

- a. [19.pre]: “A method for data conveyance with a cellular phone of the type comprising: an electronic circuit capable of storing data therein, capable of processing data, and capable of data input and output, a control device operatively linked to said electronic circuit, first and second data transceivers operatively linked to said electronic circuit, a cue receiver operatively linked to said electronic circuit, a data conveyance switching element operatively linked to said electronic circuit and capable of being in either one of a first and a second state, and power means for providing power to said cellular phone, said method comprising the steps of:”

The “an electronic circuit capable of storing data therein, capable of processing data, and capable of data input and output” claim element is addressed previously and not described in *Mooney*. See Exh. 2001, ¶¶ 63-72; Exh. 2001, ¶167.

- b. [19.a]: “awaiting for an activation cue to be received at said cue receiver;”

An activation cue is not described in *Mooney*. See Exh. 2001, ¶¶ 73-77; Exh. 2001, ¶¶168-169.

- c. [19.b]: “if an activation cue is received at said cue receiver, assigning said first state to said switching element, while if no activation cue is received at said cue receiver, assigning said second state to said switching element; and”

An activation cue and assignment of states as described in the ’294 Patent are not described in *Mooney*. See Exh. 2001, ¶¶ 78-86. Exh. 2001, ¶¶170-171

- d. **[19.c] “selectively triggering said control device to issue an invariable activation command whereby: if said switching element is in said first state, forwarding first data to said first data transceiver for initiating a data exchange operation with a first external data exchange device over a first communication link; and”**

An invariable activation command as claimed in the '294 Patent is not described in *Mooney*. See *supra* ¶¶ 87-94; Exh. 2001, ¶¶172-173.

- e. **[19.e] “wherein said method further comprises the following steps before the step of forwarding first data to said first data transceiver for initiating a data exchange operation with a first external data exchange device:”**

[19.f] “forwarding third data to and displaying said third data on a display screen provided on said cellular phone, wherein said third data is representative of the content of said first data; and”

The element of forwarding third data before the step of forwarding first data to “said first data transceiver” is not found in *Mooney*. See Exh. 2001, ¶¶ 147-148; Exh. 2001, ¶174.

- f. **[19.i] “forwarding fourth data to and displaying said fourth data on said display screen, wherein said fourth data is representative of the content of said second data; and”**

The Petition asserts that the “audio tones are the third data representative of the content of the first data” in the previous elements [19.e & 19.f]. See Pet. 66, 72. Now, the same audio tones are reused as the fourth data, but audio tones do not represent data. See *supra* ¶¶ 147-148; Exh. 2001, ¶¶175-176.

Mooney fails to teach or describe all of the claim elements of claim 19. Exh. 2001, ¶¶177

23. Claim 20 – “wherein said control device includes said user confirmation input device.”

Claim 20 is a dependent claim and incorporates all the elements of claim 19. All the elements of claim 19 are not disclosed in *Mooney* or provided by what a POSITA would know. See Exh. 2001 ¶¶ 167-177; Exh. 2001, ¶¶178-179.

All of the claim elements of claim 20 are not found in *Mooney*. Exh. 2001, ¶180.

B. GROUND 2: Obviousness Based on *Mooney* and *Lee 705*

The combination of *Mooney* and *Lee 705* fails to describe all elements of claims 1-20. Exh. 2001, ¶181.

1. No Motivation to Combine *Mooney* and *Lee*

There is no motivation to combine *Mooney* and *Lee 705*. A POSITA would not look to *Mooney* patent. See Exh. 2001 ¶¶ 53-61. *Mooney* is directed toward routing calls through a connection-oriented circuit-based PSTN network. See Exh. 1005, 130 Fig. 1. The *Lee 705* patent is directed toward a voice-over internet protocol (VOIP) network that is connectionless and simply routes VOIP packets. See Exh. 1006, 206 Fig. 1; Exh. 2001, ¶¶182-185.

A POSITA would know that the *Mooney* approach based on making calls through a PSTN network could not be combined with an approach with piconet base stations that are part of a cellular telephone network. *Mooney* is using the cellular telephone as a cordless handset that is dedicated to a cordless base unit, while providing an approach to transfer calls over a PSTN between the cordless base unit and a cellular network. If the teachings of *Lee 705* are used, there is no reason for *Mooney*. The cellular telephone operates as a cellular telephone and the piconet is part of the cellular network enabling calls to simply be handed over from one base station to another or piconet base station. Exh. 2001, ¶186.

Additionally, the purpose of *Lee 705* is to integrate a wireless local loop network with a cellular network. No suggestion is found in *Lee 705* that it would work in a non-wireless network, such as a PSTN network. Rather, it teaches explicitly away from being implemented in a non-wireless in its title, abstract, and specification. See Exh. 1005, Title, Abstract; Exh. 2001, ¶187. *Lee 705* even states circuit switched voice data is received and translated to IP packets by the BT Hub 118. Exh. 1006, 5:15-16; Exh. 2001, ¶188.

A POSITA would understand that *Mooney* uses a Bluetooth connection to make a cellular telephone operate in a mode where it is a handset to the cordless base station using the Bluetooth specification's profile for a cordless telephone. See Exh. 1005, 2:65-66. The cellular telephone is simply a Bluetooth handset extension of

the cordless telephone base station. But *Lee 705* teaches using the cellular telephone as a complete telephone and not simply a Bluetooth handset. The cellular telephone in a *Lee 705* network would never use a cordless telephone Bluetooth profile. Exh. 2001, ¶189. A POSITA would understand, that even with some common elements between the two approaches. The approaches use a cellular telephone and Bluetooth piconets in fundamentally different ways that are incompatible. Exh. 2001, ¶190.

The Petition asserts that a motivation would be to reduce congestion and interference over *Mooney's* cellular and Bluetooth networks by enabling the multimode phone to determine whether to use cellular or Bluetooth mode before sending data over the corresponding communication links. Pet. 46. This makes no sense because, the point of *Mooney* is your location dictates what mode your cellular phone is in. There is no congestion in the Bluetooth mode in *Mooney* as it is directly connected to a cordless telephone base station connected to a PSTN. Furthermore, if a person moves out of range of the cordless telephone base station, only two options exist for a call. Either it drops, or a connection is made through the cellular network. No consideration is given to congestion as only a predetermined fixed number of handsets are supported by the cordless telephone base station. Exh. 2001, ¶191.

Congestion is not even an issue in *Mooney*. It is only an issue in *Lee 705* because the Piconet base stations act as base stations in the cellular network where

multiple cellular telephones are not simply handsets but fully functioning cellular phones initiating and receiving calls and registering with location registers. Exh. 2001, ¶191

No increase in capacity can occur with the “discovery process” logic of *Lee 705*. The location of the cordless telephone base station is fixed and the cellular telephone that connects to it uses a predefined Bluetooth profile. The cellular phone in cordless handset mode in *Mooney* will only connect with Bluetooth its associated cordless telephone base station. Exh. 2001, ¶193.

There is no motivation to combine the *Mooney* and *Lee 705* references because *Mooney* is dependent upon a PSTN network and network features, with a cellular telephone used as a cordless handset, and, *Lee 705* is dependent upon a VOIP network with a cellular telephone used as a cellular telephone that hands off between piconet base stations and cellular base stations (No need for *Mooney’s* teachings). Further, there is no advantage to using the approach of *Lee 705* to increase capacity or reduce congestion in *Mooney* as congestion can never be a problem because *Mooney* is circuit based and does not use shared resources as the cellular approach of *Lee 705*. Exh. 2001, ¶194.

Mooney does not mention congestion being an issue or a concern. Petitioner’s motivation to combine *Mooney* and *Lee* is based on an issue that does not exist in *Mooney* and therefore is not impacted by the teachings of *Lee*. The finding in the

ID, *see* ID p.36, is that a motivation to reduce congestion of *Lee* is a finding that the teachings of a non-problem of congestion not found in *Mooney* is resolved by the teachings of *Lee*. This is an improper combination of references.

2. Independent claim 1

a. [1.a, 1.e, 1.f]: Claim elements relying on *Mooney* Only

Claim elements 1.a, 1.e, and 1.f only reference *Mooney* as in Ground 1 and do not rely on the combination of *Mooney* and *Lee* 705. These elements are not described in *Mooney*. *See* Exh. 2001, ¶¶ 63-86; Exh. 2001, ¶195.

b. [1.h]: “wherein upon said control device being selectively triggered by the user to issue said invariable activation command: if said switching element is in said first state, a first data conveyance operation will be initiated through the instrumentality of said first data transceiver for sending data from said electronic circuit to the first external data exchange device over said first communication link; and”

Element 1.h is not described by *Mooney*. *See* Exh. 2001, ¶¶ 87-92. The Partition asserts that “*Lee* discloses “a discovery and/or registration process” through which its device’s internal logic determines whether to use a cellular or Bluetooth network *prior* to transmitting data. *Lee* 705, 4:56-5:6.” Pet. 43. This statement is incorrect. A cellular telephone is in constant communication with a cellular network and is updating its location to location registers, such as HLR 124 of *Lee* 705. The cellular network **must** know where to find a cellular telephone in

order to set up a call. Similarly, a cellular telephone has to be registered in a network prior to calls being made or received. When the cellular telephone powers up it attempts to register in a network. If *Lee 705* is properly read, “a “dual-enabled BTED 120A performing a discovery and/or registration process” (*Lee 705*, 4:59-60), discovery and/or registration is the process of updating the location of the cellular telephone in the network if already registered or registering a cellular telephone that is accessing the network for the first time. Exh. 2001, ¶¶196-197.

Petitioner attempts to distinguish between voice data generated in an established call and command and control data. But no such distinction exists in the '294 Patent. However, the approach of *Lee 705* requires the operation and communication with both Bluetooth Hubs and cellular BTSs and be registered in the network. This is further shown by the “cellular network 100 [which] provides the administrative infrastructure and intelligence for the Bluetooth network 116 e.g. for authorization, authentication, registration, billing, profiling, roaming, etc.” *Lee 705*, 3:51-54. Registration and roaming all require communication (transmission of data) with a network **before** determining what base station/Bluetooth Hub to use. Exh. 2001, ¶¶198-199.

The combination of the *Mooney* patent and the *Lee 705* patent fail to teach or describe this element. Exh. 2001, ¶200.

3. Independent claim 10

a. [10.a, 10.f]: Claim elements relying on *Mooney* Only

Claim elements 10.a and 10.f only reference *Mooney* and not *Lee 705*. These elements are not described in *Mooney*. See Exh. 2001, ¶¶ 63-77; Exh. 2001, ¶201.

b. [10.h]: “wherein upon said control device being selectively triggered by the user to issue said invariable activation command: if an activation cue was received by said cue receiver, said electronic circuit will accomplish said first data conveyance operation to convey data from said electronic circuit to said first data transceiver for transmitting data through said first data transceiver; and”

Element 10.h is not described by *Mooney*, see Exh. 2001, ¶¶ 127-129 and *Lee 705*, see Exh. 2001, ¶¶ 196-199. The combination of *Mooney* and *Lee 705* fail to teach or describe element 10h. Exh. 2001, ¶¶202-203.

4. Independent claim 11

a. [11.d, 11.h, and 11.i]: Claim elements relying on *Mooney* Only

Claim elements 11.d, 11.h, and 11.i only reference *Mooney* and not *Lee 705*. These elements are not described in *Mooney*. See Exh. 2001, ¶¶ 130-134; Exh. 2001, ¶204.

b. [11.k]: “wherein upon said control device being selectively triggered by the user to issue said invariable activation command: if an activation cue was received by said cue receiver, ...; and”

Element 11.k is not described by *Mooney*, see Exh. 2001, ¶¶ 135-136 and *Lee 705* see Exh. 2001, ¶¶ 196-199; Exh. 2001, ¶¶ 205-206.

5. Independent claim 12

a. [12.pre, 12.a, and 12.b]: Claim elements relying on *Mooney* Only

Claim elements 12.pre, 12.a, and 12.b only reference *Mooney* and not *Lee 705*. These elements are not described in *Mooney*. See Exh. 2001, ¶¶ 138-142; Exh. 2001, ¶ 207.

b. [12.c]: “a user selectively triggering said control device to issue an invariable activation command whereby: if said switching element is in said first state, ...; and”

Element 12.c is not described by *Mooney*, see *supra* ¶¶ 143-144 and *Lee 705* see Exh. 2001, ¶¶ 196-199. Exh. 2001, ¶¶ 208-209.

6. Independent claim 19

a. [19.pre, 19.a, 19.b, 19.e, 19.f, and 19.i]: Claim elements relying on *Mooney* Only

Claim elements 19.pre, 19.a, 19.b, 19.e, 19f, and 19i only reference *Mooney* and not *Lee 705*. These elements are not described in *Mooney*. See Exh. 2001, ¶¶ 167-171; 174-177; Exh. 2001, ¶ 210.

b. [19.c]: “a user selectively triggering said control device to issue an invariable activation command ...; and”

Element 19.c is not described by *Mooney*, see Exh. 2001, ¶ 172 and *Lee 705*, see Exh. 2001, ¶¶ 196-199; Exh. 2001, ¶¶ 211-212.

7. Dependent claims 2-9, 13-18, and 20

Mooney was only cited in the Petition for the dependent claims 2-9, 13-18, and 20. *Mooney* of Ground 1 fails to describe all of the elements of the independent claims 1, 10, 11, 12, and 19. The combination of *Mooney* and *Lee 705* also fails to describe all the elements of the '294 Patent in Ground 2, as *Lee 705* is not relied upon. Exh. 2001, ¶¶ 213-214.

CONCLUSION

Petitioner Google has failed to establish that claims 1-20 are rendered obvious by any combination of the asserted prior art references. Therefore, institution by the Board of *inter partes* review is not appropriate, and the Board should deny the Petition.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies service of Patent Owner DH International Ltd. served this Patent Owner's Response on the counsel of record for Petitioner Google LLC by filing this document through the P-TACTS, as well as delivering a copy via electronic mail to the following:

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CERTIFICATE OF COMPLIANCE

This Petition complies with the type-volume limitations as mandated in 37 C.F.R. § 42.24, totaling 13,984 words. Counsel has relied upon the word count feature provided in Microsoft® Word for Mac Version 16.661.

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