UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

Case No. IPR2022-01389
U.S. Patent No. 11,190,633

PATENT OWNER RESPONSE

TABLE OF CONTENTS

Page

I. INTRODUCTION 1

II. LEVEL OF ORDINARY SKILL IN THE ART 3

III. CLAIM CONSTRUCTION 4

A. Claim 1—"said first event and second event are different" 5

B. Claim 1—"said device includes motion sensing operable to distinguish between a plurality of different types of motion" 6

IV. THE PETITION DOES NOT PROVE BY A PREPONDERANCE OF THE EVIDENCE THAT GROUNDS 1-4 MAKE ALL CLAIMS OBVIOUS 8

A. All Grounds Fail Because Vock is Not Analogous Prior Art 10

1. The '633 Patent and Vock are in Different Fields of Endeavor 11

a. The Field of Endeavor of the '633 Patent is Cellular Notifications 11

b. Vock is Not in the Field of Endeavor of Cellular Notifications 12

2. Vock is Not Reasonably Pertinent to the Problem Addressed by the '633 Patent 13

a. The Problem Addressed in the '633 Patent Concerns Notifying a User of Activity at a Remote or Inaccessible Mobile Telephone 14

b. The Problem Addressed in Vock is Quantifying Sports Movements and is Unrelated to the Problem in the '633 Patent 14

B. Grounds 1-4 in the Petition Fail to Demonstrate by a Preponderance of the Evidence that Either Narayanaswami or

Fujisawa in view of Vock Disclose or Make Obvious the Watch Band Limitations of Claim 1 16

C. The Petition Fails to Prove by a Preponderance of the Evidence that the Narayanaswami Watch "Includes Motion Sensing Operable to Distinguish Between a Plurality of Different Types of Motion" as Recited in Claim 1 22

1. The Petition Does Not Sufficiently Allege or Demonstrate Why Narayanaswami Teaches the "Included" Requirement 22

2. The Petition Does Not Sufficiently Allege or Demonstrate that Narayanaswami Teaches the "Operable to Distinguish Between a Plurality of Different Types of Motion" Requirement of Claim 1 25

3. The Petition Does Not Sufficiently Support its Assertions that GPS Devices, Altimeters and Tilt Sensors in Narayanaswami are "Motion Sensing" Devices 27

D. Ground 1 in the Petition Fails to Demonstrate by a Preponderance of the Evidence that Narayanaswami Alone or in View of Vock Discloses or Makes Obvious Claims 12, 13, 15, 16-18, 27 and 29 30

1. The Petition Does Not Sufficiently Prove that Narayanaswami Discloses or Makes Obvious a "Reminder" Notification as Recited in Claim 12 30

2. The Petition Does Not Sufficiently Prove that Narayanaswami Discloses or Makes Obvious a "Missed Call" Notification as Recited in Claim 13 32

3. The Petition Does Not Sufficiently Prove that Narayanaswami Discloses or Makes Obvious Claims 15-17 34

4. The Petition Does Not Sufficiently Prove that Narayanaswami Discloses or Makes Obvious Claim 18 34

Petitioner Samsung Ex-1023, 0003

5. The Petition Does Not Sufficiently Prove that Narayanaswami Discloses or Renders Obvious Claim 27 35

6. The Petition Does Not Sufficiently Prove that Narayanaswami Discloses or Makes Obvious Claim 29.....36

E. Ground 2 in the Petition Fails to Demonstrate by a Preponderance of the Evidence that Narayanaswami Alone or in View of Vock and/or the Nokia 8890 User Guide Discloses or Makes Obvious Claims 19-21, 23-26, 28, 30-34 and 36-39.....36

1. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Discloses or Makes Obvious a "Voice Message" Notification as Recited in Claim 19.....36

2. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Makes Obvious a "Text Message" Notification as Recited in Claim 20.....38

3. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Renders Obvious the Limitations Recited in Claim 21 39

4. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Renders Obvious the Limitations Recited in Claim 23 40

5. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Makes Claim 24 Obvious.....43

6. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Makes Claim 25 Obvious.....43

7. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Renders Obvious the Limitations Recited in Claim 26 44

8. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Renders Obvious the Limitations Recited in Claim 28 44

9. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Makes Claims 30-34 Obvious.....46

10. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Makes Claims 36-39 Obvious.....46

F. Ground 3 in the Petition Fails to Demonstrate by a Preponderance of the Evidence that Fujisawa Discloses or Makes Obvious Claim 19 47

G. Ground 4 Fails to Demonstrate by a Preponderance of the Evidence that Fujisawa Alone or in View of Vock and the Nokia 8890 User Guide Discloses or Makes Obvious Claims 11, 12, 14, 15, 17, 20, 21 and 28-34.....49

1. The Petition Does Not Sufficiently Prove that Fujisawa in view of the Nokia 8890 User Guide Discloses or Makes Obvious a "Calendar Notification" as Recited in Claim 11 49

2. The Petition Does Not Sufficiently Prove that Narayanaswami Discloses or Renders Obvious a "Reminder" Notification as Recited in Claim 12 51

3. The Petition Does Not Sufficiently Prove that Fujisawa in View of the Nokia 8890 User Guide Makes Claims 14, 15 and 17 Obvious 52

4. The Petition Does Not Sufficiently Prove that Fujisawa in view of the Nokia 8890 User Guide Renders Obvious a "Text Message" Notification as Recited in Claim 20.....52

5. The Petition Does Not Sufficiently Prove that Fujisawa in view of the Nokia 8890 User Guide Makes Claim 21 Obvious 54

6. The Petition Does Not Sufficiently Prove that Fujisawa in view of the Nokia 8890 User Guide Makes Claim 28 Obvious 55

7. The Petition Does Not Sufficiently Prove that Fujisawa in View of the Nokia 8890 User Guide Makes Claims 29-31 Obvious 56

8. The Petition Does Not Sufficiently Prove that Fujisawa Discloses or Makes Obvious the "Incoming Call," "Missed Call" and "Voice Message" Notifications of Claim 32 56

9. The Petition Does Not Sufficiently Prove that Fujisawa in View of the Nokia 8890 User Guide Renders Obvious the "Text Message" Limitations Recited in Claims 33 and 34 58

V. CONCLUSION 59

TABLE OF AUTHORITIES

Page(s)

Cases

Adams Respiratory Therapeutics, Inc. v. Perrigo Co.,
616 F.3d 1283 (Fed. Cir. 2010) 4

Apple Inc. v. FastVDO LLC,
IPR2016-01203, Paper 39 (P.T.A.B. Dec. 11, 2017) 4

Arendi S.A.R.L. v. Apple, Inc.,
832 F.3d 1355 (Fed. Cir. 2016) .....*passim*

Belden Inc. v. Berk-Tek LLC,
805 F.3d 1064 (Fed. Cir. 2015) 9

Daiichi Sankyo Co. Ltd, Inc. v. Apotex, Inc.,
501 F.3d 1254 (Fed. Cir. 2007) 3

Dealertrack, Inc. v. Huber,
674 F.3d 1315 (Fed. Cir. 2012) 5

Donner Tech., LLC v. Pro Stage Gear, LLC,
979 F.3d 1353 (Fed. Cir. 2020) 13

Douglas Dynamics, LLC v. Buyers Products Co.,
717 F.3d 1336 (Fed. Cir. 2013) 5

Eli Lilly & Co. v. Teva Pharms. Int'l GmbH,
8 4th 1331 (Fed. Cir. 2021).....42, 45

Envtl. Designs, Ltd. v. Union Oil Co.,
713 F.2d 693 (Fed. Cir. 1983) 3

Graham v. John Deere Co.,
383 U.S. 1 (1966).....9, 11

Heidelberger Druckmaschinen AG v. Hantscho Commer. Prods.,
21 F.3d 1068 (Fed. Cir. 1994) 11

In re Bigio,
381 F.3d 1320 (Fed. Cir. 2004) 11, 12

In re Clay,
966 F.2d 656 (Fed. Cir. 1992) 11, 13

In re ICON Health & Fitness,
496 F.3d 1374 (Fed. Cir. 2007) 13

In re Kahn,
441 F.3d 977 (Fed. Cir. 2006) 37

In re Kubin,
561 F.3d 1351 (Fed. Cir. 2009) 9

In re Magnum Oil Tools Int'l, Ltd.,
829 F.3d 1364 (Fed. Cir. 2016) 10

In re NuVasive, Inc.,
842 F.3d 1376 (Fed. Cir. 2016) 9

Innogenetics, N.V. v. Abbott Labs.,
512 F.3d 1363 (Fed. Cir. 2008) 55

Intelligent Bio–Sys., Inc. v. Illumina Cambridge, Ltd.,
821 F.3d 1359 (Fed. Cir. 2016) 10

InTouch Techs., Inc. v. VGO Commc'ns, Inc.,
751 F.3d 1327 (Fed. Cir. 2014) 10, 55

KSR Int'l Co. v. Teleflex. Inc.,
550 U.S. 398 (2007).....4, 37, 50, 53

Metalcraft of Mayville, Inc. v. The Toro Co.,
848 F.3d 1358 (Fed. Cir. 2017) 9

Microsoft Corp. v. Enfish, LLC,
662 Fed. Appx. 981 (Fed. Cir. 2016).....*passim*

Okajima v. Bourdeau,
261 F.3d 1350 (Fed. Cir. 2001) 3

Nike, Inc. v. Adidas AG,
812 F.3d 1326 (Fed. Cir. 2016) 9

Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.,
707 F.2d 1376 (Fed. Cir. 1983) 3

Phillips v. AWH Corp.,
415 F.3d 1303 (Fed. Cir. 2005) 4, 5, 8

Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.,
411 F.3d 1332 (Fed. Cir. 2005) 15

Ruiz v. A.B. Chance Co.,
357 F.3d 1270 (Fed. Cir. 2004) 15

Rovalma, S.A. v. Bohler-Edelstahl GmbH & Co. KG,
856 F.3d 1019 (Fed. Cir. 2017) 50, 54

Samsung Elecs. Co. v. Elm 3DS Innovations LLC,
925 F.3d 1373 (Fed. Cir. 2019) 42, 45

Sci. Plastic Prods., Inc. v. Biotage AB,
766 F.3d 1355 (Fed. Cir. 2014) 13

SFC Co., Ltd. v. LG Chem, Ltd.,
IPR2020-00178, Paper 16 (P.T.A.B. May 29, 2020) 33, 41, 45

Vitronics Corp. v. Conceptronic,
90 F.3d 1575 (Fed. Cir. 1996) 8

W.L. Gore & Assocs. v. Garlock, Inc.,
721 F.2d 1540 (Fed. Cir. 1983) 34

Xerox Corp. v. Bytemark, Inc.,
IPR2022-00624, Paper 9 (P.T.A.B. Aug. 24, 2022).....*passim*

Xerox Corp. v. Bytemark, Inc.,
IPR2022-00624, Paper 12 (P.T.A.B. Feb. 10, 2023).....26

Xilinx, Inc. et al. v. Analog Devices, Inc.,
IPR2020-01564, Paper 34 (P.T.A.B. Mar. 11, 2022).....10

Statutes

35 U.S.C. § 102 10

35 U.S.C. § 103 ..... 8, 15

35 U.S.C. § 316(e) 9

TABLE OF EXHIBITS

Exhibit	Description
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2002	Plaintiff Mullen Industries LLC's Response Claim Construction Brief, Dkt. No. 45, September 9, 2022, in *Mullen Industries LLC v. Apple Inc.*, No. 6:22-cv-00145-ADA (W.D. Tex. 2022)
2003	U.S. Pub. No. 2004/0204044A1 to Pinsky *et al*.
2004	*Continental Intermodal Group–Trucking LLC v. Sand Revolution LLC et al.*, 7:18-cv-00147 (W.D.Tex. Jul. 22, 2020)
2005	Plaintiff Gesture Technology Partner LLP's Response to Apple Inc.'s Motion to Stay Pending Resolution of *Inter Partes* Review of the Asserted Patents, Dkt. No. 39, in *Gesture Tech. Partners, LLC v. Apple, Inc.*, No. 6:21-cv-00121 (W.D. Tex. Dec. 29, 2021)
2006	Standing Order Governing Proceedings (OGP) 4.1—PATENT CASES, Dkt. No. 21, dated in April 14, 2022, *Mullen Industries LLC v. Apple Inc.*, No. 6:22-cv-00145-ADA (W.D. Tex. 2022)
2007	Agreed Scheduling Order, Dkt. No. 30, dated May 28, 2022 in in *Mullen Industries LLC v. Apple Inc.*, No. 6:22-cv-00145-ADA (W.D. Tex. 2022)
2008	Davis, Ryan, "*Albright Says He'll Rarely Put Cases On Hold For PTAB*," IPLaw360 (May 11, 2021), *available at* https://www.law360.com/articles/1381597/albright-says-he-ll-very-rarely-put-cases-on-hold-for-ptab

Exhibit	Description
2009	Declaration of Gerry Christensen
2010	Dictionary definitions of "include"
2011	Deposition Transcript of Dr. Harry V. Bims, May 23, 2023
2012	Altimeter, NATIONAL GEOGRAPHIC, *available at* https://education.nationalgeographic.org/resource/altimeter/
2013	Kumar *et al*., *The Evolution of Global Positioning Systems (GPS) Technology*, J. OF SCI. EDUC. & TECH., Vol. 11, No. 1 (Mar. 2002)

I. INTRODUCTION

Mullen Industries LLC ("Patent Owner") submits this Response to the Petition for *Inter Partes* Review ("Petition") of U.S. Patent No. 11,190,633 ("the '633 Patent") filed by Apple Inc. ("Petitioner"). The Petition should be denied in its entirety as failing to prove by a preponderance of the evidence that Narayanaswami or Fujisawa alone or in view of the cited secondary art make obvious Claims 1-39 of the '633 Patent.

* * *

The '633 Patent recites one independent claim – Claim 1 – and dependent Claims 2-39. The Petition does not show by a preponderance of the evidence that Claims 1-39 are unpatentable.

First, all Grounds fail as to all claims because (i) the Petition does not sufficiently show that Vock is analogous prior art to the invention of the '633 Patent and (ii) neither Narayanaswami nor Fujisawa in view of Vock teach the watch band limitations of Claim 1.

Second, Grounds 1 and 2 fail as to all claims because Narayanaswami does not disclose "said device includes motion sensing operable to distinguish between a plurality of different types of motion" as recited in Claim 1.

Third, Ground 1 fails as to dependent Claims 12, 13, 15, 16-18, 27 and 29 because the Petition fails to show by a preponderance of the evidence that

Narayanaswami discloses notification signals indicative of "missed calls" and/or "reminders."

Fourth, Ground 2 fails as to Claims 19-21, 28 and 30-34 because the Petition fails to show by a preponderance of the evidence that Narayanaswami in view of the Nokia 8890 User Guide discloses notification signals indicative of "voice messages" and/or "text messages" or teaches allowing a user to select different types of notification signals.

Fifth, Ground 2 fails as to Claims 23-26 and 36-39 because the Petition fails to show by a preponderance of the evidence that Narayanaswami in view of the Nokia 8890 User Guide discloses wireless communication signals being sent from a watch device to the mobile telephone to answer an incoming call or that comprise voice signals, including voice signals for performing an active call.

Sixth, Ground 3 fails as to Claim 19 because the Petition fails to show by a preponderance of the evidence that Fujisawa discloses or makes obvious notification signals indicative of "voice messages".

Seventh, Ground 4 fails as to Claims 11, 12, 14, 15, 17, 20 and 29-34 because the Petition fails to show by a preponderance of the evidence that Fujisawa in view of the Nokia 8890 User Guide discloses notification signals indicative of "calendar notifications," "reminders," "text messages" and/or "voice messages."

Eighth, Ground 4 fails as to Claims 21 and 28 because the Petition fails to show by a preponderance of the evidence that Fujisawa in view of the Nokia 8890 User Guide discloses allowing a user to select different types of notification signals.

For these reasons, detailed further herein, the Petition does not meet its burden of demonstrating by a preponderance of the evidence that Claims 1-39 of the ’633 Patent are unpatentable.

II. LEVEL OF ORDINARY SKILL IN THE ART

Factors pertinent to a determination of the level of ordinary skill in the art include: (1) educational level of the inventor; (2) type of problems encountered in the art: (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology, and (6) educational level of workers active in the field. *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696–697 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1381–82 (Fed. Cir. 1983)). Not all such factors may be present in every case, and one or more of these or other factors may predominate in a particular case. *Id.* Moreover, these factors are not exhaustive but are merely a guide to determining the level of ordinary skill in the art. *Daiichi Sankyo Co. Ltd, Inc. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007).

In determining a level of ordinary skill, we also may look to the prior art, which may reflect an appropriate skill level. *Okajima v. Bourdeau*, 261 F.3d 1350,

1355 (Fed. Cir. 2001). Additionally, the Supreme Court informs us that "[a] person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

Patent Owner and its declarant, Gerry Christensen, do not dispute or offer a level of skill in the art different from that proffered by Petitioner and its declarant at this time. Ex. 2009, ¶¶ 32-33; Pet., 11-12.

III. CLAIM CONSTRUCTION

"[T]he words of a claim are generally given their ordinary and customary meaning . . . that the term would have to a person of ordinary skill in the art in question at the time of the invention." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc) (citations omitted). "[T]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which [it] appears, but in the context of the entire patent, including the specification." *Phillips*, 415 F.3d at 1313. For example, a "claim construction that excludes [a] *preferred* embodiment [described in the specification] is rarely, if ever, correct and would require highly persuasive evidentiary support." *Apple Inc. v. FastVDO LLC*, IPR2016-01203, Paper 39, at 8 (P.T.A.B. Dec. 11, 2017) (quoting *Adams Respiratory Therapeutics, Inc. v. Perrigo Co.*, 616 F.3d 1283, 1290 (Fed. Cir. 2010) (citation omitted)) (emphasis added).

A "claim construction [however] must not import limitations from the specification into the claims." *Douglas Dynamics, LLC v. Buyers Products Co.*, 717 F.3d 1336, 1342 (Fed. Cir. 2013) (citation omitted). Therefore, "it is improper to read limitations from a preferred embodiment described in the specification —even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited." *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1327 (Fed. Cir. 2012) (citation omitted).

Patent Owner submits that the Petition construes two terms recited in Claim 1 of the '633 Patent over broadly and that the Board should therefore determine the proper scope of these terms under *Phillips*.

A. Claim 1—"said first event and second event are different"

Claim 1 of the '633 Patent also recites that "said first event and second event are different." Ex. 1001, 6:58-59. Patent Owner addressed the proper construction of "said first event and second event are different" in its Preliminary Response and, to the extent the Board deems the construction of this term relevant to the parties' arguments, incorporates its Phillips analysis of the term into this Response. Prel. Resp., 4-6.

B. Claim 1—"said device includes motion sensing operable to distinguish between a plurality of different types of motion"

Claim 1 of the '633 Patent also recites that "said device includes motion sensing operable to distinguish between a plurality of different types of motion." Ex. 1001, 6:60-62. This language requires that the "device" itself contain motion sensing and be able to distinguish between different motion types. Construing this term is necessary because Petitioner incorrectly argues that the "said device includes motion sensing" limitation is satisfied by components separate and peripheral to the "watch" claimed in the '633 Patent.

The meaning of "includes" is well understood in the English language. Laypersons and skilled artisans alike know the word as meaning to comprise or contain as part of a whole. Ex. 2010 ("to take in or comprise as part of a whole"; "to contain between or within"; "to contain, as a whole does[,] parts or any part or element"). The '633 Patent intrinsic record does not require a different interpretation.

Claims 1-39 recite "includes" twice, in Claim 1—"said device includes a battery, said device includes motion sensing operable to distinguish between a plurality of different types of motion." Ex. 1001, 6:60-62. This language uses "includes" according to its plain and ordinary meaning.

The ***specification*** also uses "includes" and its derivatives consistent with their plain and ordinary meaning. *Id*., 1:57-61, 3:8-11, 3:51-56, 3:61-65, 4:2-7, 4:19-22, 4:36-64, 5:10-39, 5:40-61, 5:62-6:17. The ***prosecution history*** is also consistent. Ex. 1002.

The Institution Decision notes that the "specification of the '633 patent discloses multiple embodiments where the motion sensor is external to the watch." Decision, at 20. Patent Owner respectfully submits that lines 31-34 in column 3 do not refer to motion sensors or "motion sensing" as recited in Claim 1 of the '633 Patent. That excerpt instead describes that phone output 112 can be a speaker or a vibrator.

The '633 Patent further discloses that:

> Control circuitry to determine when a cellular phone vibration occurs may be included and ***may be located <u>in</u> <u>either</u> autonomous device 350 <u>or</u> notification device 330***. Such control circuitry may, for example, be able to distinguish ambient motion (e.g., the soft-motion of somebody walking or a single hard-motion of a purse hitting a counter-top) from a vibrating cell-phone motion (e.g., a high-frequency, hard, repetitious motion).

Ex. 1001, 5:16-23 (emphasis added). The '633 Patent thus describes two discrete embodiments for motion sensing—***in*** device 350 or ***in*** device 330—and neither option is described as preferred.

In Claim 1, the inventor chose to locate the control circuitry for motion sensing in device 330, and not autonomous device 350. Construing Claim 1

consistent with this decision is supported by the intrinsic evidence and not contrary to Federal Circuit law. In *Vitronics Corp. v. Conceptronic*, the Court explained that a construction excluding the "preferred (and indeed only) embodiment in the specification . . . is rarely, if ever, correct and would require highly persuasive evidentiary support." *Vitronics Corp. v. Conceptronic*, 90 F.3d 1575, 1583 (Fed. Cir. 1996). Here, construing "said device includes motion sensing" to mean that the device itself contains motion-sensing capability, consistent with the intrinsic record, does not exclude a preferred or sole embodiment in violation of *Vitronics*. Such construction instead properly reflects that Claim 1 is directed to one of the embodiments described in the '633 Patent, which is entirely consistent with *Phillips*.

Patent Owner thus requests that the Board construe "said device includes motion sensing operable to distinguish between a plurality of different types of motion" to mean the device itself contains the motion-sensing capability.

IV. THE PETITION DOES NOT PROVE BY A PREPONDERANCE OF THE EVIDENCE THAT GROUNDS 1-4 MAKE ALL CLAIMS OBVIOUS

A patent is invalid for obviousness "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a) (2023). Obviousness is a question of law based on underlying factual

findings. *In re Kubin*, 561 F.3d 1351, 1355 (Fed. Cir. 2009). The factual inquiries include: (1) the level of ordinary skill in the art, (2) the scope and content of the prior art, (3) the differences between the prior art and the claims at issue and (4) any relevant secondary considerations. *Graham v. John Deere Co*., 383 U.S. 1, 17-18, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966).

"In an *inter partes* review . . . the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence." 35 U.S.C. § 316(e) (2023). "[T]he burden of proof is on the petitioner to prove unpatentable those issued claims that were actually challenged in the petition for review and for which the Board instituted review." *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1334 (Fed. Cir. 2016). To satisfy its burden, a petitioner must articulate why skilled artisans would have combined or modified prior art references. *In re NuVasive, Inc.*, 842 F.3d 1376, 1382 (Fed. Cir. 2016); *see also Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1366 (Fed. Cir. 2017) ("In determining whether there would have been a motivation to combine prior art references to arrive at the claimed invention, it is insufficient to simply conclude the combination would have been obvious without identifying any reason why a person of skill in the art would have made the combination."); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) ("[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of

prior art to arrive at the claimed invention.") (citing *InTouch Techs., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014)).

A petitioner must "demonstrate both 'that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.'" *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (quoting *Intelligent Bio–Sys., Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016)). A petitioner "does not satisfy its burden of proving obviousness by employing 'mere conclusory statements,' but 'must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.'" *Xilinx, Inc. et al. v. Analog Devices, Inc.*, IPR2020-01564, Paper 34, 9 (P.T.A.B. Mar. 11, 2022) (citing *Magnum Oil*, 829 F.3d at 1380).

Petitioner here has not proven that skilled artisans would have been motivated to make the combinations set forth in its asserted grounds, would have reasonably expected to successfully do so, or that Narayanaswami or Fujisawa teach all claim limitations. Petitioner thus has not proven that all challenged claims are unpatentable. *Magnum Oil*, 829 F.3d at 1381.

A. All Grounds Fail Because Vock is Not Analogous Prior Art

"References within the statutory terms of 35 U.S.C. § 102 qualify as prior art for an obviousness determination only when analogous to the claimed invention." *In*

re Bigio, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (citing *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992)). Two separate tests define the scope of analogous prior art—(1) whether the reference is from the same field of endeavor as the claimed invention, regardless of the problem addressed and, (2) if the reference is not within that field of endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *Bigio*, 381 F.3d 1325 (citing *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979)). Whether a reference is "analogous" is a question of fact and part of the "scope and content of the prior art" analysis under *Graham*. *Heidelberger Druckmaschinen AG v. Hantscho Commer. Prods*., 21 F.3d 1068, 1071 (Fed. Cir. 1994).

1. The '633 Patent and Vock are in Different Fields of Endeavor

The field of endeavor is determined based on the explanations of the embodiments, function and structure of the invention. *Bigio*, 381 F.3d at 1326.

a. The Field of Endeavor of the '633 Patent is Cellular Notifications

The '633 Patent describes embodiments for a user of a mobile telephone to be remotely notified of activity on the mobile telephone when it is not physically with the user or otherwise readily accessible. Ex. 1001, 1:18-43; Ex. 2009, ¶ 51. The structure of the invention of the '633 Patent is a clip-on device or wristwatch, and

the function of the invention is receiving wireless communications from a mobile telephone regarding activity on the mobile telephone, e.g., an incoming call. Ex. 1001, 1:18-2:11, FIGS. 1-3; Ex. 2009, ¶ 51. Petitioner's declarant has not offered any opinion on the field of endeavor of the '633 Patent. Ex. 2011, 9:21-10:1, 14:6-8.

b. Vock is Not in the Field of Endeavor of Cellular Notifications

The field of endeavor of Vock is monitoring and quantifying movement of a human, or equipment used by a human, during a sport. Ex. 1007, 1:30-2:6; Ex. 2009, ¶¶ 43, 52. While Vock also discloses wristwatches, the function of those watches is sensing movement, receiving movement data from another device and/or transmitting movement data to another device. Ex. 1007, 40:38-62, 60:15-30; Ex. 2009, ¶¶ 44-46, 52. Vock has a different function then the invention of the '633 Patent as a whole and thus is not in the same field of endeavor. *Bigio*, 381 F.3d at 1326; Ex. 2009, ¶ 52. Even under the "common sense" approach noted by the Federal Circuit in *In re Bigio*, skilled artisans would not have reasonably been expected to look to prior art directed to power/movement sensing units as disclosed in Vock for a solution to the problem facing the inventor of the '633 Patent of notifying users of activity occurring on a remote or inaccessible mobile phone. *Bigio*, 381 F.3d at 1326; Ex. 2009, ¶53.

2. Vock is Not Reasonably Pertinent to the Problem Addressed by the '633 Patent

"A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re ICON Health & Fitness*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (quoting *Clay*, 966 F.2d at 659). The "dividing line between reasonable pertinence and less-than-reasonable pertinence is context dependent" and "rests on the extent to which the reference of interest and the claimed invention relate to a similar problem or purpose." *Donner Tech., LLC v. Pro Stage Gear, LLC*, 979 F.3d 1353, 1359 (Fed. Cir. 2020) (citations omitted). When determining if a reference is reasonably pertinent, the problems to which the invention and the prior art both relate must be identified and compared. *Id.*, at 1360 (citing *Sci. Plastic Prods., Inc. v. Biotage AB*, 766 F.3d 1355, 1360 (Fed. Cir. 2014) ("The analogous art inquiry is a factual one, requiring inquiry into the similarities of the problems and the closeness of the subject matter as viewed by a person of ordinary skill.")). The analysis is performed through the eyes of a skilled artisan who is considering turning to the teachings of references outside her field of endeavor. *Donner Tech.*, 979 F.3d at 1360 (citing *Clay*, 966 F.2d at 660 (concluding that a reference was not reasonably

pertinent where POSITA "would not reasonably have expected to solve the [relevant] problem . . . by considering" the reference)).

a. The Problem Addressed in the '633 Patent Concerns Notifying a User of Activity at a Remote or Inaccessible Mobile Telephone

The '633 Patent states that the "present invention relates to cellular notifications . . . when the user cannot hear or sense audio signals or vibration signals (e.g., incoming call notification signals) emanating from that user's cell phone." Ex. 1001, 1:18-34; Ex. 2009, ¶ 55. The problem thus identified in the '633 Patent is that notifications of events occurring on a mobile phone exist physically on the phone and under certain circumstances cannot be perceived by the user. Ex. 2009, ¶ 55. The purpose of the invention of the '633 Patent is to notify a user of such events when the user is unable to hear or sense audio signals, sense vibrations or see light emanating from the mobile phone. Ex. 1001, 1:18-34; Ex. 2009, ¶ 56.

b. The Problem Addressed in Vock is Quantifying Sports Movements and is Unrelated to the Problem in the '633 Patent

Vock explains that persons engaging in sports, like mountain biking, skating, roller-blading, wind-surfing, and skate-boarding, only have a qualitative sense of their movements:

> For example, a typical snowboarder might regularly exclaim after a jump that she "caught" some "big sky," "big air" or "phat air" without ever quantitatively knowing

> how much time really elapsed in the air. Speed or velocity also remain unquantified. Generally, a person such as a skier can only assess whether they went "fast", "slow" or "average", based on their perception of motion and speed (which can be grossly different from actual speed such as measured with a speedometer or radar gun).

Ex. 1007, 1:45-63; Ex. 2009, ¶ 57. Vock thus describes mounting devices on sports equipment or humans during sporting activities that can quantify sports movements, such as "speed," "air time," "drop distance" and "power." Ex. 1007, 2:9-26; Ex. 2009, ¶ 57.

As the Federal Circuit explained in *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, assessing differences between the prior art and the claimed subject matter under 35 U.S.C. § 103 requires consideration of the claimed invention as a whole, not part by part. *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005) ("Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components.") (citing *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004)).

This principle applies with equal force here. Looking at the invention of the '633 Patent as a whole, skilled artisans would not have looked to a sports movement

detection device as disclosed in Vock when confronted with the problems described in the ’633 Patent and with no knowledge of the invention of the ’633 Patent. Ex. 2009, ¶ 58. That the ’633 Patent refers to control circuitry for sensing when mobile telephones are vibrating does not bring Vock into the spectrum of relevance. *Id*.

Vock is thus not analogous art to the invention of the ‘633 Patent, and for this reason, all Grounds should be rejected.

B. Grounds 1-4 in the Petition Fail to Demonstrate by a Preponderance of the Evidence that Either Narayanaswami or Fujisawa in view of Vock Disclose or Make Obvious the Watch Band Limitations of Claim 1

No reference in the Petition describes or illustrates “a watch band; a second watch band; a buckle, wherein said buckle is coupled to said second watch band” as recited in Claim 1 of the ’633 Patent. Ex. 2009, ¶ 59. While Petitioner and its declarant, Dr. Bims, claim that “the components of [a] watch band … had been well known for decades to have two watch bands extending from a watch with a buckle to connect the bands to one another,” neither one supports this assertion with evidence. Pet. 22, 28.

Petitioner admits that “Narayanaswami does not disclose the specific elements of the claimed watch band” and that “Fujisawa … does not disclose a two-piece watch band with a buckle.” Pet. 28. Contrary to Petitioner’s assertion, Vock *also* does not disclose the claimed configuration. Ex. 2009, ¶60. Vock depicts watches in

Figures 27, 28, 38, 39, 41 and 80, but these figures do not show "a watch band; a second watch band; a buckle, wherein said buckle is coupled to said second watch band." *Id*. The Vock written description also does not refer to a "buckle" or multiple "bands." Prel. Resp., 42-45; Ex. 2009, ¶¶ 43-46.

Petitioner and Dr. Bims incorrectly allege that Figure 39 of Vock concerns the watch depicted in Figure 38. But Vock makes clear that Figures 38 and 39 are two different embodiments. Ex. 2009, ¶ 61. In the "Brief Description of the Drawings," Vock refers to the watches in Figures 38 and 39 as two separate configurations, namely "a power watch" and "***another*** power watch configuration":

> FIG. 38 illustrates a power watch constructed according to the invention;
>
> FIG. 39 shows ***another*** power watch configuration, in accord with the invention;

Id.; Ex. 1007, 21:17-20 (emphasis added). If Figure 39 was intended to be a different view of the watch shown in Figure 38, the description of Figure 39 would have referred to "the power watch configuration of Figure 38" consistent with standard patent drafting practice. But this is not how Figure 39 is described.

The figures themselves also depict completely different-looking bands, particularly at the watch face, as annotated below:

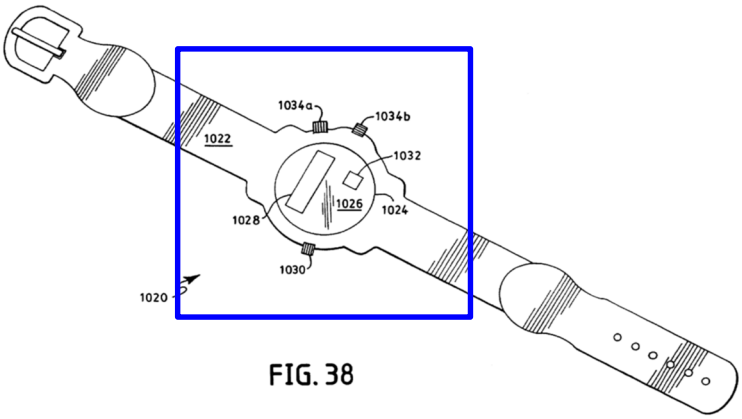


FIG. 38

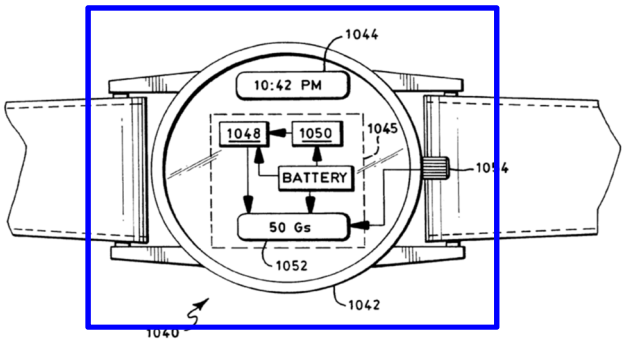


FIG. 39

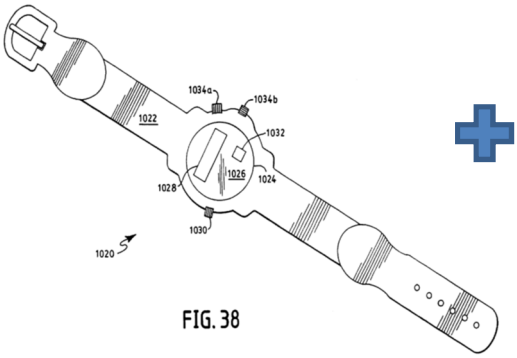
Ex. 1007, 44:26-47 (describing watch 1020 having a single "band 1022"); 44:48-45:5 (describing watch 1040 with no mention of a buckle nor multiple bands); Ex. 2009, ¶62.

The specification also does not teach that Figures 38 and 39 concern the same watch. Just as in the "Brief Description of the Drawings" section, Vock describes Figure 39 at lines 48-49 in column 40 as "another watch"—"FIG. 39 illustrates ***another*** watch system 1040 . . ."—and *not* as the watch of Figure 38. Ex. 1007, 44:48-49 (emphasis added); Ex. 2009, ¶ 63. Figures 38 and 39 in fact do not use the same reference numerals for common features. Ex. 2009, ¶ 63. The statement in

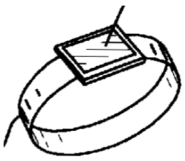
Vock's description of the watch system 1040 of Figure 39 that, "As above, the watch 1042 is made to mount over the user's wrist," does not speak to the watch configurations in Figures 38 and 39. *Id*. "As above" simply refers to the fact that both configurations are mountable on a human wrist. *Id*. Petitioner's assertion that Vock discloses a "two-band strap with a buckle" is therefore demonstrably false. Pet., 28, 50; Ex. 1003, ¶¶ 98, 153.

Incorporating any "watch band of Vock" into the Narayanaswami watch would not have provided a two-band watch with a buckle as Claim 1 requires. Ex. 2009, ¶ 64. Adding the single band with buckle in Figure 38 of Vock to the single-banded watch in Figure 1 of Narayanaswami would have provided for a single-banded watch with a buckle, not a two-banded watch with a buckle:

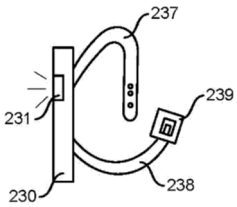
Vock, Fig. 38



Narayanaswami, Fig. 1



'633 Patent, Fig. 2



Id. Combining Figure 39 with Figure 1 also would not have provided two bands *and* a buckle:

Vock, Fig. 39 **Narayanaswami, Fig. 1** **'633 Pat., Fig. 2**

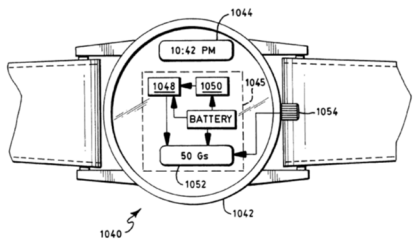
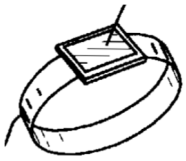
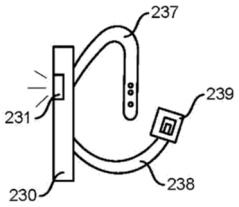


FIG. 39





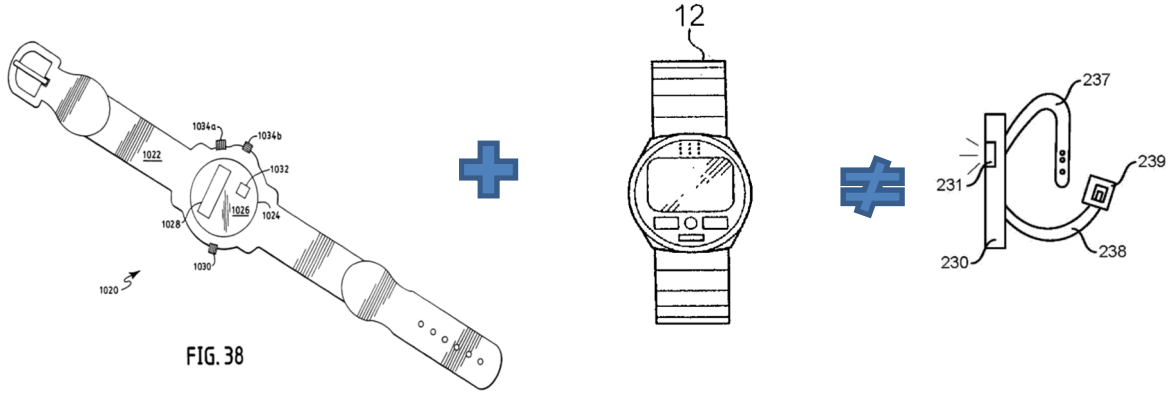
Id., ¶65. While Petitioner contends Figure 39 shows two bands, this is not necessarily true. Both portions shown on the sides of the watch face could certainly be part of the same single band, e.g., a band of elastic, rubber or some other appropriate material. *Id*.

Dr. Bims argues, "it would have been obvious to incorporate the two-band strap with a buckle disclosed in Vock with the smart watch of Narayanaswami," which wrongly presumes that Vock discloses a "two-band strap with a buckle." Ex. 1003, ¶ 100. Petitioner's statement that Figure 39 "demonstrates that the smart watch of Vock includes two bands" mischaracterizes Vock—Figure 39 is an incomplete illustration and, in fact, the watch band therein may be one band or use a fastener other than a buckle (e.g., Velcro®). Even assuming Figure 39 of Vock discloses two bands, neither the Petition nor Dr. Bims argue that skilled artisans would have combined the embodiments in Figures 38 and 39.

Incorporating any "watch band of Vock" into the Fujisawa watch also would not have provided a two-band watch with a buckle as Claim 1 requires. Ex. 2009, ¶

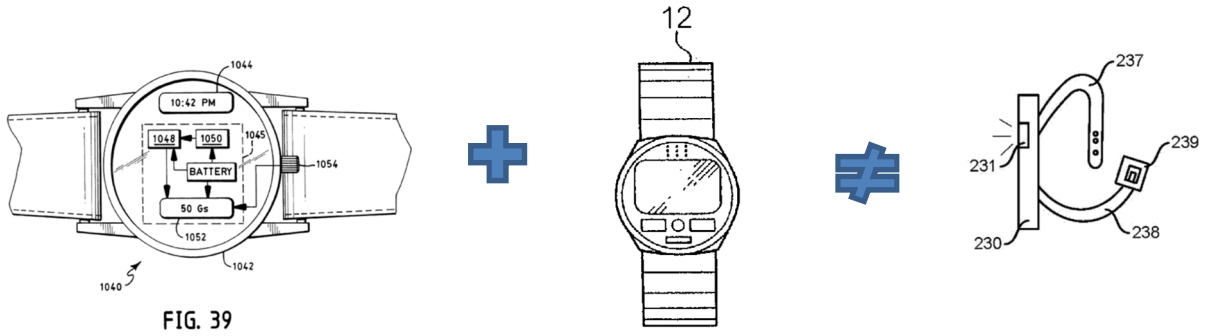
66. Adding the single band with buckle in Figure 38 of Vock to the band in Figure 1 of Fujisawa (which has no buckle or "lugs") would not have provided for two bands and a buckle:

Vock, Fig. 38 **Fujisawa, Fig. 1** **'633 Pat., Fig. 2**



Id. Combining the watches in Figure 39 and Figure 1 (neither of which disclose a buckle) also would not have provided an embodiment with a buckle:

Vock, Fig. 39 **Fujisawa, Fig. 1** **'633 Pat., Fig. 2**



Id.

Dr. Bims argues, "it would have been obvious to incorporate the two-band strap with a buckle disclosed in Vock with the smart watch of Fujisawa," which

wrongly presumes that Vock discloses a "two-band strap with a buckle." Ex. 1003, ¶ 153.

The Petition thus fails to present evidence sufficiently demonstrating that skilled artisans would have found by a preponderance of the evidence the watchband limitations in Claim 1 disclosed or rendered obvious by the cited reference and evidence of record. Ex. 2009, ¶ 67.

C. The Petition Fails to Prove by a Preponderance of the Evidence that the Narayanaswami Watch "Includes Motion Sensing Operable to Distinguish Between a Plurality of Different Types of Motion" as Recited in Claim 1

1. The Petition Does Not Sufficiently Allege or Demonstrate Why Narayanaswami Teaches the "Included" Requirement

For the "motion sensing" limitation, the Petition and Dr. Bims allege:

- "Narayanaswami discloses element 1d, including motion sensing" (Pet. 31);
- "Narayanaswami discloses element 1d, 'motion sensing operable to distinguish between a plurality of different types of motion'" (Ex. 1003, ¶ 107); and
- "Narayanaswami discloses motion sensing operable to distinguish between different types of motion" (Pet. 32; Ex. 1003, ¶ 108).

Missing from these allegations is a key element of the claim language, namely that "***said device includes*** motion sensing operable to distinguish between a plurality of different types of motion." Ex. 1001, 6:60-62; Ex. 2009, ¶ 68. As demonstrated in Section III.B, Claim 1 of the '633 Patent requires "motion sensing" capability to be

contained within "said device." Petitioner and Dr. Bims are silent on this element and cannot remedy this deficiency with new allegations or evidence. For this reason alone, Ground 1 fails.

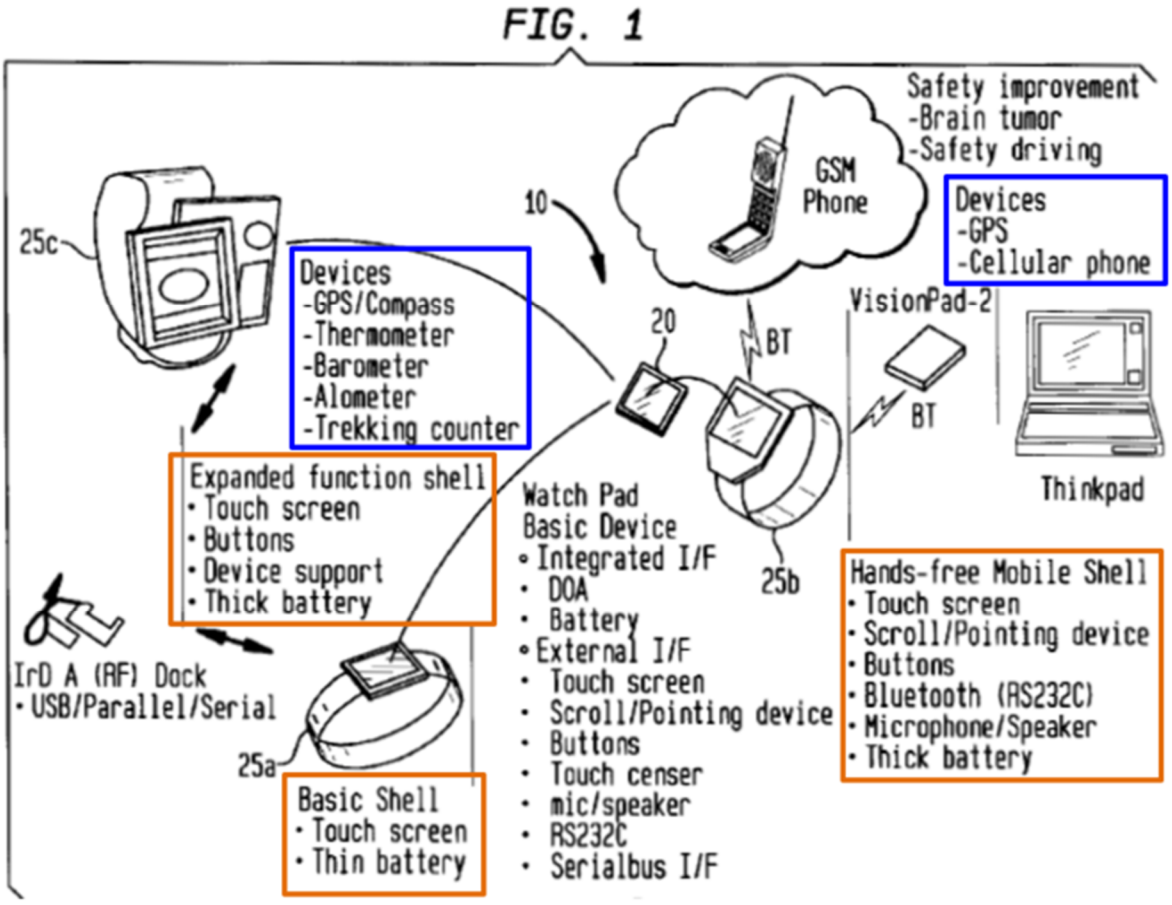
Even assuming Petitioner addressed the "includes" requirement, the two disclosures in Narayanaswami—lines 40-50 in column 3 and lines 15-19 in column 6—cited by the Petition and Dr. Bims for the claim limitation in general do not teach a device that "includes motion sensing." Ex. 2009, ¶ 70. These excerpts instead describe devices as being *supported by* watch device 10 or connected to device 10 *over an interface*—not as being "included" in device 10:

> "[T]he base card 20 may be implemented in . . . an expanded function shell 25c, providing touch screen, buttons and ***support for various devices*** such as GPS/compass, thermometer, barometer, altimeter, etc." . . . .
>
> In a preferred embodiment, ***additional sensors may be attached*** to the Wrist Watch device ***over an interface***. Examples may include additional ***tilt and motion*** (velocity, direction, speed) sensors, environment sensors such as thermal sensors, pressure sensors, health monitoring sensors such as blood pressure, etc.

Ex. 1005, 3:40-50; 6:15-19 (emphasis added); Ex. 2009, ¶ 70. Critically, neither Petitioner nor Dr. Bims explains why skilled artisans would have understood "support for" and "over an interface" to mean that the "various devices" or "additional sensors" are contained in watch device 10 itself. Ex. 2009, ¶ 70.

Petitioner thus does not show by a preponderance of the evidence that Narayanaswami teaches the "said device includes" element of Claim 1.

Consistent with these disclosures, Figure 1 of Narayanaswami depicts components contained in watch device 10 in one list (**orange**) and devices that are not onboard, but supported by, device 10, in a separate list (**blue**):



Ex. 1001, FIG. 1; Ex. 2009, ¶ 71. Figure 1 does not show that the GPS/Compass or alometer [sic] in shell 25c are part of the "Expanded function shell" or any other part of watch device 10. Ex. 2009, ¶ 71. Figure 1 in fact lists "Cellular phone" under "Devices," which surely is not incorporated into watch device 10. *Id.*

2. The Petition Does Not Sufficiently Allege or Demonstrate that Narayanaswami Teaches the "Operable to Distinguish Between a Plurality of Different Types of Motion" Requirement of Claim 1

The allegations in the Petition also fail to address the "operable to distinguish between a plurality of different types of motion" limitation of Claim 1. Petitioner and Dr. Bims allege "GPS and altimeter sensors are both capable of sensing motion" but fail to explain what type of motion either device allegedly senses or how and why these devices operate to distinguish between different motion types. Pet. 32; Ex. 1003, ¶ 107; Ex. 2009, ¶ 72.

The Board in its Institution Decision highlights these deficiencies in the Petition by drawing its own conclusions about the technical operations and capabilities of GPS devices and altimeters, rather than citing to and relying on evidence and technical reasoning from Petitioner and Dr. Bims. Decision, at 21 ("The altimeter senses vertical movement, and the GPS senses horizontal movement, which are "different types of motion" within the meaning of claim 1.").

The Petition and Dr. Bims also allege that Narayanaswami discloses "tilt and motion (velocity, direction, speed) sensors" capable of "motion sensing" but fail to explain what type of motion these devices allegedly sense or how and why these devices operate to distinguish between different motion types. Pet. 32; Ex. 1003, ¶ 107; Ex. 2009, ¶ 76.

Again, in its Institution Decision, the Board highlights these deficiencies in the Petition by drawing its own conclusions about the technical operations and capabilities of tilt sensors and motion sensors, rather than citing to and relying on evidence and technical reasoning from Petitioner and Dr. Bims. Decision, at 22 ("The tilt sensor measures the motion of the device into a tilt, or sloping position, and the motion sensor measures the velocity of the device. Tilt and velocity are "a plurality of different types of motion" within the meaning of claim 1.").

While Dr. Bims contends that "[i]t would have been obvious to a POSITA to use motion sensors to distinguish between different types of motion, such as the vibration motion during 'quiet time' and the velocity and direction motions using the GPS and altimeter sensors," he provides no supporting evidence or persuasive or technical reasoning supporting this assertion. Ex. 2009, ¶ 77. His "declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is being offered to support, and is entitled to little weight." *Xerox Corp. v. Bytemark, Inc*., IPR2022-00624, Paper 9, at 15 (P.T.A.B. Aug. 24, 2022) ("Dr. Jones does not cite to any additional supporting evidence or provide any technical reasoning to support this statement. . . . This is particularly problematic in cases where, like here, expert testimony is offered not simply to provide a motivation to combine prior-art teachings, but rather to supply a limitation missing from the prior art."); *see also Xerox Corp. v. Bytemark, Inc*., IPR2022-00624, Paper 12, at 5

(P.T.A.B. Feb. 10, 2023) ("The declaration does not provide any technical detail, explanation, or statements supporting *why* the expert determines that the feature in question was required or would have been obvious based on the prior art disclosure.") (emphasis in original).

3. The Petition Does Not Sufficiently Support its Assertions that GPS Devices, Altimeters and Tilt Sensors in Narayanaswami are "Motion Sensing" Devices

Petitioner and Dr. Bims allege "GPS and altimeter sensors are both capable of sensing motion" but fail to explain why or cite any technical evidence supporting this assertion. Pet. 32; Ex. 1003, ¶ 107. *Xerox Corp.*, IPR2022-00624, Paper 9, at 15 ("Dr. Jones does not cite to any additional supporting evidence or provide any technical reasoning to support this statement . . . ."). The Board in its Institution Decision highlights these deficiencies in the Petition by drawing its own conclusions about the technical operations and capabilities of GPS devices and altimeters, rather than citing to and relying on evidence and technical reasoning from Petitioner and Dr. Bims. Decision, at 21 ("When a user moves from one location to another, the GPS, by sensing and displaying a different location, indicates that the user has moved to a different location. Similarly, when a user's altitude changes, the altimeter, by sensing and displaying a different altitude, indicates that the user has moved to a different altitude.").

In reality, neither GPS nor altimeter devices measure or otherwise sense motion. GPS calculates location using a constellation of satellites that reside in geosynchronous orbit around the Earth. Ex. 2009, ¶ 73; Ex. 2013. Calculations derived from measurements of GPS signals provide the position of a GPS-enabled device, typically presented as a latitude and longitude, so long as the device has adequate signaling with at least three satellites. This position information could be used by additional software programs to calculate the location of a person or device and may be used for a variety of purposes such as calculating speed and direction. Ex. 2009, ¶ 73; Ex. 2013.

Altimeter devices also do not measure or sense motion. An altimeter consists of a sealed metal chamber that expands as air pressure decreases and contracts as it increases. Ex. 2009, ¶ 74; Ex. 2012. Measurements of these changes were used at the time of the invention in conjunction with a known point in space, such as sea level, to determine altitude. Similar to GPS data, this altitude information could be used in conjunction with software programs to calculate the altitude of a device/equipment over time and for a variety of purposes such as calculating speed of descent and/or ascent. Ex. 2009, ¶ 74; Ex. 2012. At this deposition, Dr. Bims agreed that altimeters measure altitude in terms of distance (e.g., feet or yards) ascended or descended – not motion – and that a "collection of altimeter readings can be used by a person of ordinary skill to determine the rates of change" and in

turn "the vertical motion of the user/device over that period of time." Ex. 2011, 79:20-23, 81:13-84:5.

Skilled artisans at the time of the invention would have understood that neither a GPS or altimeter device would have been capable of directly sensing, measuring and quantifying motion as Petitioner and Dr. Bims allege. *Id*., ¶ 75.

Petitioner and Dr. Bims further allege "[t]ilt is a type of motion sensed with sensors such as the ball-in-a-tube sensor disclosed in the '633 patent" and that "sensing velocity is also motion sensing" but fail to explain why or cite any technical evidence supporting this assertion. Pet. 32; Ex. 1003, ¶ 107; Ex. 2009, ¶ 76. Again, in its Institution Decision, the Board highlights these deficiencies in the Petition by drawing its own conclusions about the technical operations and capabilities of tilt sensors and motion sensors, rather than citing to and relying on evidence and technical reasoning from Petitioner and Dr. Bims. Decision, at 22 ("The tilt sensor measures the motion of the device into a tilt, or sloping position, and the motion sensor measures the velocity of the device.").

* * *

Accordingly, for these reasons, the Petition and Dr. Bims fail to demonstrate that Narayanaswami discloses the "said device includes motion sensing operable to distinguish between a plurality of different types of motion" limitation of Claim 1 of the '633 Patent, and Grounds 1 and 2 fail.

D. Ground 1 in the Petition Fails to Demonstrate by a Preponderance of the Evidence that Narayanaswami Alone or in View of Vock Discloses or Makes Obvious Claims 12, 13, 15, 16-18, 27 and 29

1. The Petition Does Not Sufficiently Prove that Narayanaswami Discloses or Makes Obvious a "Reminder" Notification as Recited in Claim 12

Claim 12 recites that the "second user-perceivable [notification] signals are indicative of a **reminder**." Ex. 1001, 7:21-22 (emphasis added). Claim 1, from which Claim 12 depends, further recites that those "signals" must be "dependent upon . . . second communication signals" that are received from a "mobile telephonic device" and "associated with a second event." *Id*., 6:55-67. The claimed "**reminder**" is thus in response to communication signals received from a mobile telephonic device and associated with an event. The Petition fails to prove that Narayanaswami discloses this feature or renders it obvious. Ex. 2009, ¶¶ 78-80.

The Petition and Dr. Bims rely on a "snooze option" described in Narayanaswami—"One feature in particular enabled by the present invention is the facility by which a user may stop the alarm, select a snooze option where the user will receive subsequent reminders (i.e., the alarm to activate) after a predefined time interval . . . ." Pet., 38 (citing Ex. 1005, 8:28-32); Ex. 1003, ¶ 121. A recurring alarm after selecting "snooze" on watch device 10 is not a "second user-perceivable notification signal[] that [is] dependent upon said second communication signals" received from a "mobile telephonic device" and "associated with a second event,"

as required by Claim 12. Ex. 2009, ¶ 79. The recurring alarms of a basic "snooze" function are set by the user on watch device 10 as described in Narayanaswami. *Id*.

Petitioner and Dr. Bims also allege, "a POSITA would understand that a reminder can be stored as a calendar entry, the notification of the occurrence of the calendar entry would be the reminder, and thus Narayanaswami discloses that the second event is indicative of a reminder." Pet., 38; Ex. 1003, ¶ 121. Neither the Petitioner nor Dr. Bims, however, reference any disclosure in Narayanaswami (or other record evidence) that supports conflating a notification indicative of a calendar event and a notification indicative of a reminder of an upcoming calendar event (e.g., "You have a meeting starting in 5 minutes."). Ex. 2009, ¶ 80. The '633 Patent in fact distinguishes between these two types of notifications. Ex. 1001, 3:14-18 ("For example, remote notification device 130 may alert a user when cell phone 101 receives an incoming call, a ***calendar notification*** occurs, a ***reminder*** occurs, a missed call occurs, a new voice or text message is received, or any other cell phone activity.") (emphasis added); 7:19-22 (Claim 11 reciting "calendar notification"; Claim 12 reciting "reminder"); Ex. 2009, ¶ 80.

Lastly, Dr. Bims alleges, "these various disclosures would render obvious providing user-perceivable signals indicative of a reminder." Ex. 1003, ¶ 121. His declaration testimony, however, does not cite additional evidence or provide

persuasive or technical reasoning and is therefore conclusory, unsupported and entitled to little weight. *Xerox Corp.*, IPR2022-00624, Paper 9, 15.

2. The Petition Does Not Sufficiently Prove that Narayanaswami Discloses or Makes Obvious a "Missed Call" Notification as Recited in Claim 13

Claim 13 recites that the "second user-perceivable [notification] signals are indicative of a **missed call**." Ex. 1001, 7:23-24 (emphasis added). Like Claim 12, Claim 13 depends from Claim 1 and, accordingly, the claimed "**missed call**" notification is in response to communication signals received from a mobile telephone and associated with an event. The Petition fails to prove that Narayanaswami discloses this feature or renders it obvious. Ex. 2009, ¶¶ 81-84.

The Petition and Dr. Bims cite to an excerpt in Narayanaswami at lines 13-20 in column 11 that does not relate to incoming calls or notifying users that a call was missed. Pet., 38-39; Ex. 1003, ¶ 122. The disclosure instead relates to an alarm setting feature for setting priorities of quiet time versus the alarm. Ex. 1005, 11:13-20; Ex. 2009, ¶ 82. Petitioner and Dr. Bims cite to no other disclosure in Narayanaswami. Pet., 38-39; Ex. 1003, ¶ 122. At his deposition, Dr. Bims was unable to identify a single disclosure in Narayanaswami relating to a missed call. Ex. 2011, 74:15-79:15 (identifying additional excerpts from Narayanaswami that do not concern "missed calls").

Dr. Bims alleges that a "POSITA would understand that Narayanaswami treats calls as an event that triggers a type of alert or alarm and that if the user does not respond to the call, then the watch will provide an alarm at a preset time after the call is missed." Ex. 1003, ¶ 122. He does not cite any evidence or persuasive or technical reasoning supporting this assertion and thus appears to rely on nothing more than impermissible hindsight to arrive at the claimed invention. Ex. 2009, ¶ 83; *SFC Co., Ltd. v. LG Chem, Ltd.*, IPR2020-00178, Paper 16, at 38-39 (P.T.A.B. May 29, 2020); *see also* Ex. 2011, 74:15-79:15 (failing to identify a single disclosure in Narayanaswami relating to "missed calls"). His testimony is therefore conclusory and unsupported, adds little to the conclusory assertion for which it is being offered to support, and is entitled to little weight. *Xerox Corp.*, IPR2022-00624, Paper 9, at 15.

Petitioner and Dr. Bims further assert, "Narayanaswami discloses . . . determining that a user did not hear an alarm, such as the alert associated with the incoming call." Pet., 39; Ex. 1003, ¶ 122. To the contrary, Narayanaswami contains no such disclosure, nor does Petitioner or Dr. Bims cite to any portion of Narayanaswami. Ex. 2009, ¶ 84.

In short, Narayanaswami does not teach the "missed call" limitation of Claim 13, and Petitioner and Dr. Bims fail to provide any additional evidence or technical reasoning that cures this deficiency—only conclusory assertions about what skilled

artisans would have understood based on hindsight. *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.").

3. The Petition Does Not Sufficiently Prove that Narayanaswami Discloses or Makes Obvious Claims 15-17

Claims 15-17 depend from Claim 1 and recite first and second user-perceivable notification signals indicative of an "**incoming call**," a "**reminder**" and/or a "**missed call**." Ex. 1001, 7:29-40 (emphasis added). For the reasons provided as to Claim 12 ("reminder") and Claim 13 ("missed call"), Narayanaswami does not teach Claims 15-17 or render them obvious. Ex. 2009, ¶ 85.

4. The Petition Does Not Sufficiently Prove that Narayanaswami Discloses or Makes Obvious Claim 18

Claim 18 depends from Claim 1 and requires that "at least one of said plurality of different types of motion is a human motion." Ex. 1001, 7:41-42. For at least the reasons provided as to Claim 1, Narayanaswami does not disclose Claim 18 or render it obvious. Ex. 2009, ¶ 86.

5. The Petition Does Not Sufficiently Prove that Narayanaswami Discloses or Renders Obvious Claim 27

Claim 27 depends from Claim 1 and requires the "device" be "operable to" (i) receive third wireless communication signals associated with a third event, wherein each of said first event, second event, and third event is different," and (ii) "provide third user-perceivable notification signals that are dependent upon said third wireless communication signals." Ex. 1001, 8:5-10. Petitioner fails to demonstrate that Narayanaswami discloses Claim 27 or renders it obvious. Ex. 2009, ¶¶ 87-88.

The Petition and Dr. Bims allege Narayanaswami discloses providing notifications of events that are different, e.g., a series of missed calls, and events that are of different types, e.g., a missed call and a reminder. Pet. 41; Ex. 1003, ¶ 129. These allegations are misplaced. Ex. 2009, ¶¶ 88. First, as demonstrated in Section III.A, Claim 1 requires the first, second and third events to be different—not three separate occurrences of the same type of event, e.g., three missed calls. *Id*. Second, as demonstrated in Sections IV.D.1 and IV.D.2, the Petition does not sufficiently prove that Narayanaswami discloses or renders obvious the "reminder" and "missed call" limitations in Claims 12 and 13, respectively. *Id*. Petitioner's contention that "Narayanaswami discloses providing notifications of . . . events that are of different types, e.g., a missed call and a reminder" is thus conclusory and unsupported. *Id*.

6. The Petition Does Not Sufficiently Prove that Narayanaswami Discloses or Makes Obvious Claim 29

Claim 29 depends from Claim 27 and requires that the "said first user-perceivable signals are indicative of an **incoming call**, said second user-perceivable signals are indicative of a **reminder**, and said third user-perceivable signals are indicative of a **missed call**." Ex. 1001, 8:16-20 (emphasis added). For the reasons provided as to Claims 12, 13 and 27, Narayanaswami does not disclose Claim 29 or render it obvious. Ex. 2009, ¶ 85.

E. Ground 2 in the Petition Fails to Demonstrate by a Preponderance of the Evidence that Narayanaswami Alone or in View of Vock and/or the Nokia 8890 User Guide Discloses or Makes Obvious Claims 19-21, 23-26, 28, 30-34 and 36-39

1. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Discloses or Makes Obvious a "Voice Message" Notification as Recited in Claim 19

Claim 19 depends from Claim 1 and recites "said first user-perceivable signals are indicative of a voice message." Ex. 1001, 7:43-44. Petitioner fails to demonstrate that Narayanaswami in view of the Nokia 8890 User Guide renders this feature obvious. Ex. 2009, ¶¶ 89-92.

The Petition and Dr. Bims concede that Narayanaswami does not disclose notifying a user of watch device 10 of a voice message, but contend that modifying device 10 to include this functionality would have been obvious to skilled artisans because voicemail notifications were implemented on mobile phones at the time.

Pet. 42; Ex. 1003, ¶ 133. Dr. Bims' obvious analysis is not sufficient. Ex. 2009, ¶ 91.

While determining whether it would have been obvious for a skilled artisan to combine references is a flexible inquiry, obviousness cannot be established "by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at 418 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Generic references to common features and functionality and alleged user preferences are not a wholesale substitute for reasoned analysis and evidentiary support. *Arendi S.A.R.L. v. Apple, Inc.*, 832 F.3d 1355, 1362 (Fed. Cir. 2016); *see also Microsoft Corp. v. Enfish, LLC*, 662 Fed. Appx. 981, 990 (Fed. Cir. 2016) (unpublished) (finding "same art," "same techniques," "same technical" and "closely related subject matter" to be insufficient rationale for combining references).

Here, Dr. Bims alleges that skilled artisans would have incorporated a voicemail notification feature into the Narayanaswami watch device 10 because this feature was allegedly "commonly available in mobile phones" and allegedly "would provide additional functionality" to device 10, and because users would have allegedly "preferred" a broad set of features in watch device 10. Ex. 1003, ¶ 93. His declaration testimony, however, does not support these generic assertions with additional evidence or reasoning. Ex. 2009, ¶ 91. These assertions, without more,

are insufficient to show persuasively that skilled artisans would have recognized some deficiency in one reference or had reason to look to the other and combine them. *Id*.

Claim 19 depends from Claim 1 and thus the "**voice message**" must be in response to communication signals received from a mobile telephonic device and associated with an event. Ex. 1001, 6:55-67. Neither the Petition nor Dr. Bims address this requirement or the fact that the mobile phones disclosed in the Nokia 8890 User Guide were not Bluetooth-enabled and would have been unable to transmit signals to another device. Ex. 2009, ¶ 92.

2. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Makes Obvious a "Text Message" Notification as Recited in Claim 20

Claim 20 recites that the "first user-perceivable [notification] signals are indicative of a **text message**." Ex. 1001, 7:45-46 (emphasis added). Like Claim 19, Claim 20 depends from Claim 1 and, accordingly, the claimed "**text message**" notification is in response to communication signals received from a mobile telephonic device and associated with an event. Petitioner and Dr. Bims rely on the same deficient obviousness analysis as advanced against Claim 19. Pet. 42-43; Ex. 1003, ¶¶ 134. For at least the reasons provided as to Claim 19, the Petition fails to

demonstrate that Narayanaswami in view of the Nokia 8890 User Guide renders Claim 20 obvious. Ex. 2009, ¶ 93.

3. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Renders Obvious the Limitations Recited in Claim 21

Claim 21 recites that the "device is operable to allow a user to select a type of user-perceivable signal for said first user-perceivable signals that is different than a type of user-perceivable signal for said second user-perceivable signals." Ex. 1001, 7:47-51. Petitioner and Dr. Bims rely on the same deficient obviousness analysis as advanced against Claims 19 and 20. Pet. 43; Ex. 1003, ¶¶ 135-136. Moreover, that Narayanaswami discloses a single type of notification for a phone call, namely the displaying of a Caller ID, does not sufficiently support adding the feature of user selection of different audible tones into the Narayanaswami watch device 10. Ex, 2009, ¶ 94. Dr. Bims also fails to explain how the touch screen in Narayanaswami would have had the capability to select different tones or how the processors in Narayanaswami would have supported this functionality. *Id*. For these reasons, the Petition fails to demonstrate that Narayanaswami in view of the Nokia 8890 User Guide renders Claim 21 obvious. *Id*.

4. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Renders Obvious the Limitations Recited in Claim 23

Claim 23 recites the "wireless communication signals operable to be sent to said mobile telephonic device comprise wireless communication signals to answer an **incoming call**" and depends from Claim 22, which requires that the device be "operable to send wireless communication signals to said mobile telephonic device." Ex. 1001, 7:52-58 (emphasis added). The Petition fails to demonstrate that Narayanaswami in view of the Nokia 8890 User Guide renders Claim 23 obvious. Ex. 2009, ¶ 95.

Petitioner and Dr. Bims cite the only disclosure in Narayanaswami suggesting transmission of information from watch device 10 back to another device:

> Inter-device interaction software applications are included *to permit the watch display to become the display for another device* such as a GPS located in a concealed location, (e.g., a bag), or a thermostat on the wall, etc. Thus, this application Software enables communication between the other device and the Wrist Watch by receiving/displaying the data and ***transmitting back information*** sent from the Wrist Watch.

Ex. 1005, 7:63-8:3 (emphasis added); Pet., 44; Ex. 1003, ¶ 137. However, the "transmitting back information" disclosure (i) is in the specific context of watch device 10 serving as a display screen for other devices (i.e., "to permit the watch display to become the display for another device") and (ii) Narayanaswami is silent

about what "transmitting back information" means, what that information entails and how watch device 10 is configured with this functionality. Ex. 2009, ¶ 96. This single disclosure does not teach watch device 10 sending signals to a mobile telephone to answer an incoming phone call, as required by Claim 23. *Id*.

Petitioner and Dr. Bims attempt to remedy this deficiency in Narayanaswami by relying on the Nokia 8890 User Guide—"Nokia User Guide discloses "[w]hen someone calls you, the phone alerts you (see 'Ringing options' on page 60) and Call flashes on the display. To answer, press any key...." Pet, 44 (citing Ex. 1008, 19); Ex. 1003, ¶ 137. This disclosure, however, merely describes the functionality of notifying a user of an incoming call—the *exact* functionality already described in Narayanaswami at lines 3-5 in column 8. Ex. 2009, ¶ 97. This Nokia disclosure adds nothing further to what Narayanaswami already discloses and does not remedy the deficiencies of Narayanaswami. *Id*.

Dr. Bims' obviousness assertion is also legally insufficient—"It would have been obvious to send these voice signals from a smart watch, such as the watch disclosed in Narayanaswami, to the mobile device, thus allowing the user to conduct a voice call via the smart watch." Ex. 1003, ¶ 137; Ex. 2009, ¶ 98. He does not cite to any additional evidence or provide any persuasive or technical reasoning supporting his assertion and appears to rely on nothing other than impermissible hindsight to arrive at the claimed invention. *SFC Co.*, IPR2020-00178, Paper 16, at

38-39. His testimony is thus conclusory and unsupported and is entitled to little weight. *Xerox Corp.*, IPR2022-00624, Paper 9, at 15.

Dr. Bims' analysis also fails to address the requirement of "reasonable expectations of success" and, for this reason alone, is incomplete and improper. *Eli Lilly & Co. v. Teva Pharms. Int'l GmbH*, 8 4th 1331, 1344 (Fed. Cir. 2021) ("[W]e must first emphasize the clear distinction in our case law between a patent challenger's burden to prove that a skilled artisan would have been motivated to combine prior art references and the additional requirement that the patent challenger also prove that the skilled artisan would have had a reasonable expectation of successfully achieving the claimed invention from the combination."); *see also Samsung Elecs. Co. v. Elm 3DS Innovations LLC*, 925 F.3d 1373, 1380-1381 (Fed. Cir. 2019) (finding lack of adequate reasonable expectation of success).

Dr. Bims' generic references to common features and functionality and alleged user preferences are also not a wholesale substitute for reasoned analysis and evidentiary support and do not support a finding of unpatentability. Ex. 1003, ¶ 93; *see also Arendi*, 832 F.3d at 1362; *Microsoft Corp.*, 662 Fed. Appx. at 990.

5. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Makes Claim 24 Obvious

Claim 24 recites the "wireless communication signals operable to be sent to said mobile telephonic device comprise **voice signals**." Ex. 1001, 7:52-54, 59-61 (emphasis added). Petitioner and Dr. Bims rely on the same deficient obviousness analysis as advanced against Claim 23. Pet. 43-44; Ex. 1003, ¶ 138. For the reasons provided as to Claim 23, the Petition fails to demonstrate that Narayanaswami in view of the Nokia 8890 User Guide renders Claim 24 obvious. Ex. 2009, ¶ 100.

6. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Makes Claim 25 Obvious

Claim 25 recites the "wireless communication signals operable to be sent to said mobile telephonic device comprise wireless communication signals to answer an **incoming call** and wireless communication signals comprising **voice signals**." Ex. 1001, 7:52-54, 62-66 (emphasis added). Petitioner and Dr. Bims rely on the same deficient obviousness analysis as advanced against Claim 23. Pet. 45; Ex. 1003, ¶ 139. For the reasons provided as to Claim 23, the Petition fails to demonstrate that Narayanaswami in view of the Nokia 8890 User Guide renders Claim 25 obvious. Ex. 2009, ¶ 101.

7. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Renders Obvious the Limitations Recited in Claim 26

Claim 26 recites the "wireless communication signals comprising voice signals comprise **voice signals** operable to be utilized by said mobile telephonic device for an **active call**." Ex. 1001, 7:52-54, 8:1-4 (emphasis added). Petitioner and Dr. Bims rely on the same deficient obviousness analysis as advanced against Claim 23. Pet. 45; Ex. 1003, ¶ 140. For the reasons as respect to Claim 23, the Petition fails to demonstrate that Narayanaswami in view of the Nokia 8890 User Guide renders Claim 26 obvious. Ex. 2009, ¶ 102.

8. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Renders Obvious the Limitations Recited in Claim 28

Claim 28 recites the "device is operable to allow a user to select different types of user-perceivable signals for each of said first user-perceivable signals, said second user-perceivable signals, and said third user-perceivable signals." Ex. 1001, 8:11-15. Petitioner and Dr. Bims rely on the same deficient obviousness analysis as advanced against Claims 19-21. Pet. 45; Ex. 1003, ¶ 141. For at least the reasons provided as to Claims 19-21, the Petition fails to demonstrate that Narayanaswami in view of the Nokia 8890 User Guide renders Claim 28 obvious. Ex. 2009, ¶ 103.

Moreover, that Narayanaswami discloses a single type of notification for a phone call, namely the displaying of a Caller ID, does not sufficiently support adding

the feature of user selection of different audible tones into the Narayanaswami watch device 10. *Id*., ¶ 104. Dr. Bims also fails to explain how the touch screen in Narayanaswami would have had the capability to select different tones or how the processors in Narayanaswami would have supported this functionality. *Id*.

Dr. Bims alleges "it would have been obvious to a POSITA to assign different types of user-perceivable signals, such as the visual or audible signals disclosed by the Nokia User Guide, in the smart watch of Narayanaswami" and that "a user could select different tones, which are user-perceivable signals, and different types of tones for each different type of event, such as, for example, selecting a different type of tone for a voice call, a text message, or a reminder." Ex. 1003, ¶ 141. He does not cite to any additional evidence or provide any persuasive or technical reasoning supporting his assertion and thus appears to rely on nothing other than impermissible hindsight to arrive at the claimed invention. *SFC Co.*, IPR2020-00178, Paper 16, at 38-39 (P.T.A.B. May 29, 2020). His testimony is conclusory and unsupported and is entitled to little weight. *Xerox Corp.*, IPR2022-00624, Paper 9, at 15. Dr. Bims' analysis also fails to address the requirement of "reasonable expectations of success" and, for this reason alone, is incomplete and insufficient. *Eli Lilly*, 8 4th at 1344; *see also Samsung Elecs.*, 925 F.3d at 1380-1381.

Dr. Bims' generic references to common features and functionality and alleged user preferences are also not a wholesale substitute for reasoned analysis and

evidentiary support and do not support a finding of unpatentability. Ex. 1003, ¶ 93; *see also Arendi*, 832 F.3d at 1362; *Microsoft Corp.*, 662 Fed. Appx. at 990 (finding "same art," "same techniques," "same technical" and "closely related subject matter" to be insufficient rationale for combining references).

9. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Makes Claims 30-34 Obvious

Claims 30-34 recite first user-perceivable signals and second user-perceivable signals that are indicative of "**incoming calls**," "**reminders**," "**missed calls**," "**voice messages**" and/or "**text messages**." Ex. 1001, 8:21-45 (emphasis added). Petitioner and Dr. Bims rely on the same deficient obviousness analysis as advanced against Claims 12, 13, 19, 20 and 27. Pet. 46-47; Ex. 1003, ¶¶ 142-146. For the reasons provided as to Claims 12, 13 19, 20 and 27, the Petition fails to demonstrate that Narayanaswami in view of the Nokia 8890 User Guide renders Claims 30-34 obvious. Ex. 2009, ¶ 106.

10. The Petition Does Not Sufficiently Prove that Narayanaswami in View of the Nokia 8890 User Guide Makes Claims 36-39 Obvious

Claim 36-39 recite sending wireless communication signals to the mobile telephonic device that comprise wireless communication signals to answer an incoming call and/or that comprise voice signals, including voice signals for an active call. Ex. 1001, 8:49-64. Petitioner and Dr. Bims rely on the same deficient

obviousness analysis as advanced against Claims 23-26. Pet. 47-48; Ex. 1003, ¶¶ 147-150. For the reasons provided as to Claims 23-26, the Petition fails to demonstrate that Narayanaswami in view of the Nokia 8890 User Guide renders Claims 36-39 obvious. Ex. 2009, ¶ 107.

F. Ground 3 in the Petition Fails to Demonstrate by a Preponderance of the Evidence that Fujisawa Discloses or Makes Obvious Claim 19

Claim 19 recites the "first user-perceivable [notification] signals are indicative of a **voice message**." Ex. 1001, 7:43-44 (emphasis added). Claim 19 depends from Claim 1, which recites that the "signals" must be "dependent upon . . . first communication signals" received from a "mobile telephonic device" and "associated with a first event." *Id*., 6:55-67. The claimed "**voice message**" notification is thus in response to communication signals received from a mobile telephone and associated with an event. The Petition fails to demonstrate Fujisawa discloses this feature or render it obvious. Ex. 2009, ¶ 108.

Petitioner and Dr. Bims rely on Fujisawa's description for reading saved voice messages from memory 33 on watch-shaped information processing device 12/12A:

> [W]hen the central control circuit 25A receives "message playing operation by list" (step Sd2: playing operation by list), it sees the address management table AMT and acquires all the readout addresses for the caller's messages." "Using the readout addresses, the central control circuit 25A reads only the incoming call time data and the caller data in the nonvolatile memory 33, and

> displays them on the display unit 29 (step Sd5).” Thus, Fujisawa discloses that the user-perceivable signals are indicative of a voice message.

Ex. 1003, ¶ 172 (citing Ex. 1006, ¶¶ [0290]-[0291]).

Dr. Bims’ reliance on paragraphs [0290] and [0291] of Fujisawa is improper. These paragraphs do not teach “third user perceivable signals are indicative of a voice message.” Ex. 2009, ¶ 110. While Claim 19 recites that the “perceivable [notification] signals” must be “dependent upon” the “wireless communication signals” received from the “mobile telephonic device,” the “incoming call time data and the caller data in the nonvolatile memory 33” displayed to the user in Fujisawa in paragraph [0291] ***are not*** “dependent upon said third wireless communication signal.” *Id*. Rather, this data is stored in memory 33 and read by “central control circuitry 25A” upon user request, e.g., several days after the voice message data was stored in memory 33. *Id*. The display of this information or the playback of stored voice messages is not a “[notification] signal” indicative of a “voice message” as recited in Claim 19. *Id*.

G. Ground 4 Fails to Demonstrate by a Preponderance of the Evidence that Fujisawa Alone or in View of Vock and the Nokia 8890 User Guide Discloses or Makes Obvious Claims 11, 12, 14, 15, 17, 20, 21 and 28-34

1. The Petition Does Not Sufficiently Prove that Fujisawa in view of the Nokia 8890 User Guide Discloses or Makes Obvious a "Calendar Notification" as Recited in Claim 11

Claim 11 recites the "second user-perceivable [notification] signals are indicative of a **calendar notification**." Ex. 1001, 7:19-20 (emphasis added). The Petition fails to prove that Fujisawa in view of the Nokia 8890 User Guide renders Claim 11 obvious. Ex. 2009, ¶ 111.

The Petition concedes that Fujisawa does not describe watch-shaped information processing device 12/12A as providing signals indicative of a calendar notification. Petitioner and Dr. Bims thus point to the Nokia 8890 User Guide—"The calendar keeps track of reminders, calls you need to make, meetings, and birthdays. It can even sound an alarm when it's time for you to make a call or go to a meeting." Pet., 61; Ex. 1003, ¶ 186. Dr. Bims argues that skilled artisans would have deemed it obvious to incorporate this "alarm" into the Fujisawa watch because it was allegedly a "common feature of mobile devices at the time," would have allegedly provided added functionality and users of the Fujisawa watch would have allegedly preferred a broad set of features. Ex. 1003, ¶¶ 94, 96. These generic allegations – without citations to any additional evidence or technical reasoning –

do not provide the articulated reasoning with rational underpinning required to support a legal conclusion of obviousness. *KSR*, 550 U.S. at 418. References to common features and functionality and alleged user preferences cannot be used as wholesale substitutes for reasoned analysis and evidentiary support. *Arendi*, 832 F.3d at 1362; *see also Microsoft Corp.*, 662 Fed. Appx. at 990 (finding "same art," "same techniques," "same technical" and "closely related subject matter" as insufficient rationale for combining references).

For "reasonable expectations of success," Dr. Bims argues that "one of skill in the art would have expected to have been successful in incorporating this additional feature into the smart watch of Fujisawa by, for example, modifying the software already present in the watch" because Fujisawa discloses "providing notifications of an incoming call." Ex. 1003, ¶ 186. His declaration testimony, however, does not cite to any evidence to support the inference that a skilled artisan would have reasonably expected to successfully implement in the Fujisawa watch providing a signal indicative of a calendar notification in response to a calendar event occurring on a mobile telephone. *Rovalma, S.A. v. Bohler-Edelstahl GmbH & Co. KG*, 856 F.3d 1019, 1026 (Fed. Cir. 2017); Ex. 2009, ¶ 113.

2. The Petition Does Not Sufficiently Prove that Narayanaswami Discloses or Renders Obvious a "Reminder" Notification as Recited in Claim 12

Claim 12 recites that "second user perceivable [notification] signals are indicative of a **reminder**." Ex. 1001, 7:21-22 (emphasis added). The Petition and Dr. Bims rely on the same alleged motivations and reasonable expectations of success advanced against Claim 11. Pet., 61; Ex. 1003, ¶ 187. For at least the reasons provided as to Claim 11 in Section IV.G.1, the Petition fails to prove that Fujisawa in view of the Nokia 8890 User Guide renders Claim 12 obvious. Ex. 2009, ¶ 114.

Petitioner and Dr. Bims additionally allege, "One type of item that the calendar can keep track of is a 'reminder'." Pet., 61; Ex. 1003, ¶ 187. Neither the Petitioner nor Dr. Bims, however, reference any disclosure in Fujisawa or the Nokia 8890 User Guide (or other record evidence) that supports conflating a notification indicative of a calendar event and a notification indicative of a reminder of a future calendar event (e.g., "You have a meeting starting in 5 minutes."). Ex. 2009, ¶ 115. The '633 Patent indeed distinguishes between the two types of notifications. Ex. 1001, 3:14-18 ("For example, remote notification device 130 may alert a user when cell phone 101 receives an incoming call, a ***calendar notification*** occurs, a ***reminder*** occurs, a missed call occurs, a new voice or text message is received, or any other cell phone activity.") (emphasis added); 7:19-22 (Claim 11 reciting "calendar notification"; Claim 12 reciting "reminder"); Ex. 2009, ¶ 115.

3. The Petition Does Not Sufficiently Prove that Fujisawa in View of the Nokia 8890 User Guide Makes Claims 14, 15 and 17 Obvious

Claims 14, 15 and 17 recite first and second user-perceivable signals that are indicative of "**incoming calls**," "**calendar notifications**" and/or "**reminders**." Ex. 1001, 7:25-31, 36-40 (emphasis added). Petitioner and Dr. Bims rely on the same deficient obviousness analysis as advanced against Claims 11 and 12. Pet. 61-62; Ex. 1003, ¶¶ 188-190. For at least the reasons provided as to Claims 11 and 12, the Petition fails to demonstrate that Fujisawa in view of the Nokia 8890 User Guide renders Claims 14, 15 and 17 obvious. Ex. 2009, ¶ 116.

4. The Petition Does Not Sufficiently Prove that Fujisawa in view of the Nokia 8890 User Guide Renders Obvious a "Text Message" Notification as Recited in Claim 20

Claim 20 recites that the "first user-perceivable [notification] signals are indicative of a **text message**." Ex. 1001, 7:45-46 (emphasis added). The Petition fails to prove that Fujisawa in view of the Nokia 8890 User Guide renders Claim 20 obvious. Ex. 2009, ¶ 117.

The Petition concedes that Fujisawa does not describe watch-shaped information processing device 12/12A as providing signals indicative of a text message. Petitioners and Dr. Bims thus point to the Nokia 8890 User Guide—"Nokia User Guide discloses, [w]hen you receive a text message, the phone displays Message received and the [text message icon], and makes a sound." Pet., 79; Ex.

1003, ¶ 191. Dr. Bims argues that skilled artisans would have deemed it obvious to incorporate the text message feature because it was allegedly a "common feature of mobile devices at the time," would have allegedly provided additional functionality and users of the Fujisawa watch would have allegedly preferred a broad set of features. Ex. 1003, ¶¶ 94, 96, 191. These generic allegations – without citations to any additional evidence or support – do not provide the articulated reasoning with rational underpinning required to support the legal conclusion of obviousness. *KSR*, 550 U.S. at 418. References to common features and functionality and alleged user preferences cannot be used as wholesale substitutes for reasoned analysis and evidentiary support. *Arendi*, 832 F.3d at 1362; *see also Microsoft Corp.*, 662 Fed. Appx. at 990.

For "reasonable expectations of success," Dr. Bims argues that "one of skill in the art would have expected to have been successful in incorporating this additional feature into the smart watch of Fujisawa by, for example, modifying the software already present in the watch" because Fujisawa discloses "providing notifications of an incoming call." Ex. 1003, ¶ 191. His declaration testimony, however, does not cite to any evidence to support the inference that a skilled artisan would have reasonably expected to successfully implement in the Fujisawa watch providing a signal indicative of a calendar notification in response to a calendar event

occurring on a mobile telephonic device. Ex. 2009; ¶ 119; *Rovalma*, 856 F.3d at 1026.

5. The Petition Does Not Sufficiently Prove that Fujisawa in view of the Nokia 8890 User Guide Makes Claim 21 Obvious

Claim 21 recites that the "device is operable to allow a user to select a type of user-perceivable signal for said first user-perceivable signals that is different than a type of user-perceivable signal for said second user-perceivable signals." Ex. 1001, 7:47-51. The Petition fails to prove that Fujisawa in view of the Nokia 8890 User Guide renders Claim 21 obvious. Ex. 2009, ¶ 120.

The Petition concedes that Fujisawa does not describe watch-shaped information processing device 12/12A as allowing a user to select different types of signals for the first and second notification signals, but points to disclosures in the Nokia 8890 User Guide that describe assigning ring tones to caller groups and alert tones to text messages. Pet. 62-63; Ex. 1003, ¶ 192. First, Petitioner and Dr. Bims rely on the same deficient obviousness analysis as advanced against Claims 19 and 20. Pet. 62-63; Ex. 1003, ¶ 192. These arguments are unpersuasive.

Second, Dr. Bims fails to provide sufficient evidence of motivation to combine or reasonable expectations of success. His declaration testimony merely alleges, "a user ***could*** select different tones, which are user-perceivable signals, and different types of tones for different types of events, such as, for example, selecting

a different type of tone for a voice call and for a text message." Ex. 1003, ¶ 192 (emphasis added). Whether a user "could" select different tones is not the proper inquiry. *InTouch Techs.*, 751 F.3d at 1351 ("Dr. Yanco's testimony primarily consisted of conclusory references to her belief that one of ordinary skill in the art *could* combine these references, not that they would have been motivated to do so. . . . that is not the relevant inquiry.") (emphasis added). Rather, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion" that skill artisans *would* have made the combination. *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008) (citation omitted). But nowhere does Dr. Bims "state how or why a person ordinarily skilled in the art would have found the claims of the ['633 Patent] obvious in light of some combination of [Fujisawa and the Nokia 8890 User Guide]." *Id*. His generic references to common features and functionality and alleged user preferences (*see* Ex. 1003, ¶¶ 94, 96) are not a wholesale substitute for reasoned analysis and evidentiary support. *Arendi*, 832 F.3d at 1362.

6. The Petition Does Not Sufficiently Prove that Fujisawa in view of the Nokia 8890 User Guide Makes Claim 28 Obvious

Claim 28 recites that the "device is operable to allow a user to select different types of user-perceivable signals for each of said first user-perceivable signals, said second user-perceivable signals, and said third user-perceivable signals." Ex. 1001,

8:11-15. The Petition fails to prove that Fujisawa in view of the Nokia 8890 User Guide renders Claim 28 obvious for at least the reasons provided as to Claim 21. Ex. 2009, ¶ 123.

7. The Petition Does Not Sufficiently Prove that Fujisawa in View of the Nokia 8890 User Guide Makes Claims 29-31 Obvious

Claims 29-31 recite first user-perceivable signals, second user-perceivable signals and third user-perceivable signals that are indicative of "**incoming calls**," "**reminders**," "**missed calls**," "**voice messages**" and/or "**text messages**." Ex. 1001, 8:16-30. Petitioner and Dr. Bims rely on the same deficient obviousness analysis as advanced against Claims 12, 13, 19, 23, 20 and 30. Pet. 64; Ex. 1003, ¶¶ 195-197. For the reasons provided as to Claim 12 ("reminder") and Claim 20 ("text messages"), the Petition fails to demonstrate that Fujisawa in view of the Nokia 8890 User Guide renders Claims 29-31 obvious. Ex. 2009, ¶ 124.

8. The Petition Does Not Sufficiently Prove that Fujisawa Discloses or Makes Obvious the "Incoming Call," "Missed Call" and "Voice Message" Notifications of Claim 32

Claim 32 recites the "first user-perceivable signals are indicative of an **incoming call**, said second user-perceivable signals are indicative of a **missed call**, and said third user-perceivable signals are indicative of a **voice message**." Ex. 1001, 8:31-35 (emphasis added). The Petition and Dr. Bims rely exclusively on Fujisawa to challenge the patentability of Claim 32 by citing to "Ground 3, claims 13, 19 and

23." Pet., 64. Taken together, however, the Fujisawa disclosures cited by Petitioner and Dr. Bims in Ground 3 against Claims 13, 19 and 23 do not (and cannot) teach both a "missed call" notification and a "voice message" notification. Ex. 2009, ¶ 125. For at least this reason, the Petition fails to demonstrate that Fujisawa discloses or renders obvious Claim 32. *Id*.

With respect to Claim 13 directed to a "missed call" notification, Petitioner and Dr. Bims cite to Paragraph [0272] of Fujisawa as disclosing a missed call:

> Fujisawa also discloses a second event. First, receiving two calls, one after the other would satisfy this limitation. Second, to the extent the claim requires the second event is of a different type than the first, Fujisawa discloses a different second event—***a missed call:*** "As shown in FIG. 19, during this process, the caller's telephone number and a message 'recording caller's message' are shown on the display unit 29 of the watch-shaped information processing device 12A to inform the user that the call is currently leaving a message." Ex. 1006, [0272].

Ex. 1003, ¶ 155; Pet., 51.

As to Claim 19 reciting "voice messages," as demonstrated above in Section IV.F, Petitioner relies on disclosures in Fujisawa that do not disclose providing notification signals indicative of voice messages as recited in Claim 19. In truth, the only disclosure in Fujisawa of a "voice message" notification is *also* in Paragraph [0272]—the same paragraph relied on by Petitioner for the "missed call" notification recited in Claim 13. Ex. 2009, ¶ 127. Paragraph [0272] states that "the caller's

telephone number and a message 'recording caller's message' are shown on the display unit 29 of the watch-shaped information processing device 12A to inform the user that the call is currently leaving a message." Ex. 1006, ¶ [0272]; Ex. 2009, ¶ 127.

In other words, to meet the "missed call" *and* "voice message" elements of Claim 32, Petitioner and Dr. Bims must rely on the *same disclosure* in Fujisawa, which is improper. Ex. 2009, ¶ 128. The '633 Patent makes clear that the recited "missed call" and "voice message" are two different types of events that cannot be satisfied by the same disclosure in Fujisawa. *Id.*

9. The Petition Does Not Sufficiently Prove that Fujisawa in View of the Nokia 8890 User Guide Renders Obvious the "Text Message" Limitations Recited in Claims 33 and 34

Claims 33 and 34 recite first user-perceivable signals, second user-perceivable signals and third user-perceivable signals that are indicative of "**incoming calls**," "**missed calls**," "**voice messages**" and/or "**text messages**." Ex. 1001, 8:36-45. Petitioner and Dr. Bims rely on the same deficient obviousness analysis as advanced against Claim 20. Pet. 64-65; Ex. 1003, ¶¶ 198-199. For at least the reasons provided as to Claim 20, the Petition fails to demonstrate that Fujisawa in view of the Nokia 8890 User Guide renders Claims 33 and 34 obvious. Ex. 2009, ¶ 130.

V. CONCLUSION

For at least the foregoing reasons, the Petition does not meet its burden of demonstrating by a preponderance of the evidence that Claims 1-39 of the ’633 Patent are unpatentable and all claims should be deemed patentable.

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Respectfully submitted,

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CERTIFICATE OF WORD COUNT

The undersigned certifies pursuant to 37 C.F.R. § 42.24(d) that the foregoing Patent Owner Response excluding any table of contents, table of authorities, certificates of service or word count, or appendix of exhibits or claim listing, contains 13,203 words according to the word-processing program used to prepare this paper (Microsoft Word). Petitioner certifies that this Patent Owner Response does not exceed the applicable type-volume limit of 37 C.F.R. § 42.24(a).

Dated: June 6, 2023

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