

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.;
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

Case No. IPR2024-01472
U.S. Patent No. 11,190,633

PATENT OWNER'S RESPONSE

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	BACKGROUND	3
A.	Mr. Mullen, The '633 Patent, And The Underlying District Court Case	3
B.	Person Of Skill In The Art (“POSITA”)	6
C.	Claim Construction.....	7
	1. Claim 1 – “said device includes motion sensing operable to distinguish between a plurality of different types of motion”	8
	2. Claim 1 – “said first event and second event are different”	16
D.	Cited References.....	18
	1. Narayanaswami.....	18
	2. Fujisawa	19
	3. Kita’514	20
	4. Kita’039	21
	5. Cannon	22
III.	ARGUMENT.....	24
A.	Grounds 1-5 Of The Petition Fail To Establish Obviousness Of The Limitation “Said Device Includes Motion Sensing Operable To Distinguish Between A Plurality Of Different Types Of Motion”.....	24
B.	Grounds 1-3 Of The Petition Fail To Establish Obviousness Of The Limitation “A Device Operable To Receive First Wireless Communication Signals Associated With A First Event And Second Wireless Communication Signals Associated With A Second Event From Said Mobile Telephonic Device, Wherein Said First Event And Second Event Are Different”	28
C.	Grounds 4-5 Of The Petition Fail To Establish Obviousness Of The Limitations “A Device Operable To Receive ... Second Wireless Communication Signals Associated With A Second Event From Said Mobile Telephonic Device” And “Said Device Is Operable To Provide Second User Perceivable Notification Signals That Are Dependent Upon Said Second Communication Signals”.....	32

IV. CONCLUSION.....35

TABLE OF AUTHORITIES

	Page(s)
Federal Cases	
<i>Daiichi Sankyo Co. Ltd, Inc. v. Apotex, Inc.</i> , 501 F.3d 1254 (Fed. Cir. 2007)	6
<i>Envtl. Designs, Ltd. v. Union Oil Co.</i> , 713 F.2d 693 (Fed. Cir. 1983)	6
<i>Exxon Chemical Patents v. Lubrizol Corp.</i> , 64 F.3d 1553 (Fed. Cir. 1995)	26
<i>In re Enhanced Security Research, LLC</i> , 739 F.3d 1347 (Fed. Cir. 2014)	30, 31
<i>In re Wesslau</i> , 353 F.2d 238 (CCPA 1965)	30, 31
<i>InTouch Techs., Inc. v. VGO Commc'ns, Inc.</i> , 751 F.3d 1327 (Fed. Cir. 2014)	31
<i>KSR Int'l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	7
<i>Okajima v. Bourdeau</i> , 261 F.3d 1350 (Fed. Cir. 2001)	6
<i>Phillips. Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (en banc)	13
Federal Statutes	
35 U.S.C. 112, ¶ 6	2, 10, 15
Regulations	
37 C.F.R. § 42.24(b)(1).....	37

TABLE OF EXHIBITS

Exhibit	Description
2001	<i>Every Samsung Galaxy Watch ever: From 2018 to now</i> , https://www.croma.com/unboxed/every-samsung-galaxy-watch-ever
2002	<i>Mullen Industries LLC v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:24-CV-00049-JRG, Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.’s Proposed Terms and Claim Elements for Construction
2003	U.S. Pub. No. 2004/0204044A1 to Pinsky <i>et al.</i>
2004	Dictionary definition of “include” – Merriam-Websters Collegiate Dictionary. 10 th Ed., 2001
2005	Dictionary definition of “distinguish” – Collins Concise Dictionary, 5 th Ed., 2001
2006	Dictionary definition of “distinguish” - The American Heritage Dictionary of the English Language, 4 th Ed., 2000
2007	<i>Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation</i> , Vidal, June 21, 2022
2008	<i>Mullen Industries LLC v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:24-CV-00049-JRG, Order Denying Motion to Stay, Dkt. 71 (E.D. Tex. Jan. 23, 2025)

2009	<i>MyPort, Inc. v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:22-CV-00114-JRG, Order, Dkt. 73 (E.D. Tex. June 13, 2023)
2010	<i>Solas OLED Ltd. v. Samsung Display Co., Ltd.</i> , Case No. 2:19-CV-00152-JRG, 2020 U.S. Dist. LEXIS 125973 (E.D. Tex. July 17, 2020)
2011	<i>Oyster Optics, LLC, v. Infinera Corp.</i> , Case No. 2:19-CV-00257-JRG, Order, Order, Dkt. 87 (E.D. Tex. July 17, 2020)
2012	Docket Navigator, Time to Milestones for Judge Gilstrap (EDTX) in Patent Cases for the Last 5 Years
2013	<i>Mullen Industries LLC v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:24-CV-00049-JRG, Complaint, Dkt. 1 (E.D. Tex. Jan. 26, 2024)
2014	Excerpt from <i>Mullen Industries LLC v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:24-CV-00049-JRG, Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.'s Initial Invalidity Contentions
2015	Declaration of Ivan Zatkovich

Mullen Industries LLC (“Patent Owner” or “Mullen”) submits this Response to the Petition for *Inter Partes* Review (“Petition”) of U.S. Patent No. 11,190,633 (“the ’633 Patent”) filed by Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc., (“Petitioner” or “Samsung”). The Petition should be denied in its entirety as failing to prove by a preponderance of the evidence that any of Claims 1-39 of the ’633 Patent are obvious. Patent Owner’s Response is accompanied by the expert declaration of Ivan Zatkovich. Ex. 2015.

I. INTRODUCTION

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 any of Claims 1-39 are unpatentable.

For all of Grounds 1-5, the Petition fails to establish obviousness of a watch including a device, where “*said device includes motion sensing operable to distinguish between a plurality of different types of motion,*” as recited in Claim 1. In the parallel district court action, Petitioner argued that this claim term is indefinite. However, the district court issued a preliminary claim construction¹ finding that this term is not indefinite, and can be construed. In the District Court’s preliminary claim

¹ The District Court’s final claim construction is expected to be received imminently. Once received, Patent Owner will seek leave to submit the District Court’s final claim construction in this proceeding.

construction, the District Court indicated that this term should be construed according to 35 U.S.C. 112, ¶ 6. The structure, as argued by Patent Owner, is control circuitry configured to recognize or show a difference between different types of motion, including as described in the '633 Patent's specification at column 5, lines 16-26. Based on such a construction, all of Grounds 1-5 fail because:

- Grounds 1-3: Narayanaswami, Kita'514, Kita'039, and/or Cannon, at most, refer to various types of sensors, but all these sensors do is report motion signals. These references fail to teach or suggest anything (e.g., circuitry and algorithms) that analyzes the signals from these sensors to distinguish different types of motion as claimed in Claim 1.
- Grounds 4-5: Fujisawa, Kita'514, and/or Cannon, at most, refer to various types of sensors, but all these sensors do is report motion signals. These references fail to teach or suggest anything (e.g., circuitry and algorithms) that analyzes the signals from these sensors to distinguish different types of motion as claimed in Claim 1.

For Grounds 1-3, the Petition also fails to establish obviousness based on Narayanaswami, Kita'514, Kita'039, and/or Cannon of a watch device that receives from a mobile telephonic device first and second wireless communication signals associated with different first and second events, as recited in Claim 1.

For Grounds 4-5, the Petition also fails to establish obviousness of a watch device that is operable to receive second wireless communication signals associated with a second event from a mobile telephonic device, where the watch device is operable to provide second user perceivable notification signals that are dependent upon the second wireless communication signals.

For at least 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. BACKGROUND

A. Mr. Mullen, The '633 Patent, And The Underlying District Court Case

Jeffrey Mullen has invented prolifically across a wide array of technologies since the early 2000s, including, for example, with regard to wireless and cellular communications systems and devices, security improvements regarding the same, augmented reality and virtual reality devices, and autonomous defense systems. Mr. Mullen is the inventor of the '633 Patent and the sole member and founder of the Patent Owner Mullen Industries LLC. Patent Owner filed the parallel district court case more than a year ago in January 2024 to seek remedies for Petitioner Samsung's unlawful use of Mr. Mullen's patented technologies, including but not limited to with regard to the '633 Patent.

Mr. Mullen disclosed in U.S. application no. 14/172,884 and its corresponding U.S. provisional application no. 60/455,218 his design of a watch device that wirelessly communicates with a mobile phone to receive notifications of incoming calls, missed calls, calendar appointments, text messages, voice messages, location-based alerts and even distinguish between different types of movements—all of this approximately 15 years *before* Samsung released its Samsung Watch in 2018 containing the same features. Ex. 2001; Ex. 2015, ¶¶ 15-24.

Each of the Grounds of the Petition is directed to claim 1 or a claim dependent on claim 1. Claim 1 defines a watch for use with a mobile telephonic device. Ex. 1001, Claim 1.

Among other things, as relevant to this Response, Claim 1 specifies that the watch device receives from the mobile telephonic device first and second wireless communication signals associated with different first and second events. *Id.*

Claim 1 also specifies that the watch device includes motion sensing operable to distinguish between a plurality of different types of motion.

In addition, Claim 1 specifies that the watch device is operable to receive second wireless communication signals associated with a second event from a mobile telephonic device, where the watch device is operable to provide second user perceivable notification signals that are dependent upon the second wireless communication signals.

These summarized features of Claim 1 addressed in this Response are seen in the below emphasized text of Claim 1.

Limitation	Claim Language
1(pre)	A watch for use with a mobile telephonic device that provides notification of an incoming call, said watch comprising:
1(a)	a watch band; a second watch band; a buckle, wherein said buckle is coupled to said second watch band; and
1(b)	<i>a device operable to receive first wireless communication signals associated with a first event and second wireless communication signals associated with a second event from said mobile telephonic device, wherein said first event and second event are different,</i>
1(c)	said device includes a battery,
1(d)	<i>said device includes motion sensing operable to distinguish between a plurality of different types of motion,</i>
1(e)	said device is operable to provide first user-perceivable notification signals that are dependent upon said received first communication signals, and

Limitation	Claim Language
1(f)	<i>said device is operable to provide second user perceivable notification signals that are dependent upon said second communication signals.</i>

B. Person Of Skill In The Art (“POSITA”)

Factors pertinent to a determination of the level of ordinary skill in the art (“POSITA”) 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, Ivan Zatkovich, a POSITA in the field of the asserted ’633 Patent would have possessed at least a Bachelor of Science degree in computer science, computer engineering, electrical engineering, or a similar degree with one or two years of experience with operating system and application software in mobile devices, such as cellular phones, personal digital assistants, and smart watches. Ex. 2015, ¶¶ 27-29; *id.* at ¶¶ 7-14.

C. Claim Construction

In the Petition’s section addressing claim construction, Petitioner states it “does not believe that any term requires express construction.” Pet. at 8. However, the Petition ignores that the construction of two terms was disputed in prior IPR proceedings involving the ’633 Patent before such proceedings were terminated due to settlement, and at least the same disputed constructions are relevant here. *See* Ex. 1023 at 5-8. Petitioner also ignores that the parties are actively disputing claim construction of the ’633 Patent in the parallel district court case, including one of the same claim terms discussed below that is relevant to the issues here, and that the district court has issued a preliminary claim construction for this term. *See* Ex. 2002 at 9.

The Board’s institution decision did not construe any terms, and instead made a preliminary finding at the institution stage that “even under Patent Owner’s narrower constructions, Petitioner has shown a reasonable likelihood of success that at least one claim is unpatentable.” Paper 9, at 13. At that time, however, the Board did not have the benefit of the district court’s preliminary claim construction.

Patent Owner respectfully submits that, based on the proper constructions of the terms of Claim 1 of the ’633 Patent, the cited references do not teach or suggest the elements of Claim 1.

Accordingly, relevant to the issues here, Patent Owner submits that the Board should construe the following two claim terms.

1. 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 watch device itself contain motion sensing capability that is operable to do what the claim language states—*i.e.*, distinguish between different motion types. Ex. 2015, ¶¶ 32-39.

Patent Owner and Petitioner are actively disputing the construction of this same claim term in the parallel district court action and the Court has issued a

preliminary construction rejecting Petitioner's argument that this term is indefinite, and finding that this term can be construed.

Construing this term is necessary because, as addressed *infra* at Section III.A, Petitioner:

(i) incorrectly argues that “said device ***includes*** motion sensing” can be satisfied by components separate from and peripheral to (*i.e.*, not included in) the “device” claimed in the '633 Patent; and

(ii) improperly ignores (by ascribing no meaning to and failing to substantively address in the Petition) the portion of this term that expressly requires the device to be “***operable to distinguish between*** a plurality of different types of motion.”

As a result of Petitioner's two errors, Petitioner in effect seeks to improperly rewrite this claim term to read: “said device ~~includes~~ receives motion sensing data ~~operable to distinguish between~~ of a plurality of different types of motion.” Indeed, confirming that Petitioner attempts to rewrite the claim language to require that the device merely needs to receive motion sensing data, the Petition argues in a footnote that “Claim 1 does not recite sensing motion” Pet., 30 n.8. This, again, is a transparent effort by Petitioner to allow for the situation where a device can merely receive motion sensing data, instead of giving meaning to the expressly stated requirement in the claim that the device must “include motion sensing.” Moreover,

confirming that the Petition likewise ascribes no meaning to the words of the claim that expressly require the watch device to include motion sensing “operable to distinguish between a plurality of different types of motion,” the Petition erroneously argues in the same footnote that “Claim 1 does not recite ... making use of information gathered through sensing motion.” *Id.* Petitioner is again incorrect; directly contrary to Petitioner’s argument, the claim requires that the claimed watch device must indeed make use of information gathered through sensing motion by expressly stating that *the watch device must be “operable to distinguish between a plurality of different types of motion.”*

Again, in the parallel district court litigation, the district court has issued a preliminary claim construction finding that this term is not indefinite (as argued by Petitioner), and can be construed. In the district court’s preliminary claim construction, the Court indicated that this term should be construed according to 35 U.S.C. 112, ¶ 6. The structure, as argued by Patent Owner, is control circuitry configured to recognize or show a difference between different types of motion, including as described the ’633 Patent’s specification at column 5, lines 16-26:

Control circuitry to determine when a cellular phone vibration occurs may be included and may be located in either autonomous device 350 or 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).* Such control circuitry may be configured for use

with a particular phone and may have inputs that allow a user to adjust the sensitivity/operation of either device 350 or 330.

Ex. 1001, '633 Patent, at 5:16-26 (emphases added).

Accordingly, the Board should construe this claim term because the parties fundamentally dispute its meaning and, as discussed *infra* at Section III.A, Petitioner's alleged prior art does not satisfy this claim term as properly construed.

First, as to issue (i) referenced above, the meaning of “includes” in this claim term is well understood in the English language. Laypersons and skilled artisans alike know that the word means to comprise or contain as part of a whole. Ex. 2004 (“to take in or comprise as part of a whole”; “to contain between or within”). The '633 Patent intrinsic record is consistent, and does not require a different interpretation.

Turning to the claim language, Claims 1-39 recite “includes” twice, both instances of which are 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.

Indeed, importantly, the '633 Patent discloses that:

Control circuitry to determine when a cellular phone vibration occurs ***may be included*** and may be located ***in either autonomous device 350 or 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 (emphases added). The '633 Patent thus describes two different embodiments for “including” motion sensing capability (*i.e.*, control circuitry), either by including such control circuitry (i) ***in*** device 350 or (ii) ***in*** device 330. Device 330 is the device that provides notifications to a user (*e.g.*, Ex. 1001, 5:52-57), and device 350 can be a separate sensor (*e.g.*, *id.*, 5:11-12).

In Claim 1, the inventor expressly chose to locate the motion sensing capability in the ***same*** device that provides the notification signals to a user (like the specification describes with respect to device 330), and not a separate device like device 350 that may simply be a sensor. Ex. 1001, Claim 1 (claiming that “***said device*** includes motion sensing operable to distinguish between a plurality of different types of motion” and “***said device*** is operable to provide first user-perceivable notification signals ... and second user-perceivable notification signals”) (emphases added). Construing Claim 1 consistent with the inventor’s decision such that the “motion sensing operable to” is located in the ***same*** claimed “device” that provides the notification signals to a user is supported by the intrinsic

evidence, including the plain language of the claim. Such a construction properly reflects that Claim 1 is directed to one of the embodiments described in the '633 Patent, which is consistent with *Phillips*. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc) (“[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.”).

Patent Owner thus submits that the Board should construe “said device ***includes*** motion sensing operable to distinguish between a plurality of different types of motion” to require that the device itself (*i.e.*, the same device that provides the notification signals to a user) includes control circuitry that contains the motion-sensing capability.

Second, as to issue (ii) referenced above, the portion of the claim language requiring that the device that includes motion sensing is “***operable to distinguish between*** a plurality of different types of motion” should likewise be given its plain and ordinary meaning, which is that the device’s control circuitry is configured to distinguish between different types of motion. Ex. 2015, ¶¶ 32-39.

What it means to “distinguish between” is well understood in the English language. Laypersons and skilled artisans alike know that the word “distinguish” means “to make, show, or recognize a difference.” Ex. 2005; *see also* Ex. 2006

("[t]o perceive as being different or distinct"). The '633 Patent intrinsic record is consistent, and does not require a different interpretation.

Indeed, turning to the specification, the '633 Patent discloses that:

Control circuitry . . . may be located in . . . 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 (emphases added). The '633 Patent thus describes that a device is operable to distinguish between different types of motion when its control circuitry is configured to recognize or show a difference between two different types of motion. This claim term is thus directed to specific capability within control circuitry of the claimed device for distinguishing between different types of motion, and is not met (like the Petition incorrectly argues) by a device that merely receives motion sensing data for multiple types of motion without inclusion of control circuitry that is configured to do what the claim requires, which is to recognize or show a difference between different types of motion.

The prosecution history is also highly instructive. *See* Ex. 1004, at p. 486, File History of U.S. Patent Appln. No. US 14/172,884, 7/20/21 Notice of Allowance and Notice of Allowability. Specifically, when allowing the claim that is now numbered Claim 1 in the '633 Patent, the Examiner specifically referenced the need for "control circuitry" in the Examiner's Reasons for Allowance when referring to

this motion sensing claim element (stating that “paragraph [0031] of published application discloses: 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.” (underlining in original)). Ex. 2015, ¶¶ 30-31. Petitioner and its expert did not address this evidence, which further underscores that this claim term of Claim 1 of the ’633 Patent is directed to specific capability within control circuitry of the claimed device for distinguishing between different types of motion. *Id.*

Patent Owner thus submits that the Board should construe “said device includes motion sensing *operable to distinguish between a plurality of different types of motion*” to require that the device includes control circuitry that is configured to recognize or show a difference between different types of motion.

Whether or not the Board reaches such a construction by invoking 35 U.S.C. 112, ¶6 consistent with the district court’s preliminary claim construction, with the corresponding structure being as referenced at Ex. 1001, 5:16-23, the result is the same: Claim 1 is not met by references that merely refer to sensors that report motion signals. Rather, Claim 1 requires control circuitry that analyzes signals from one or more motion sensors to distinguish different types of motion.

2. Claim 1 – “said first event and second event are different”

Patent Owner submits that the plain language of Claim 1 requires both (i) the existence of a “first event” and a “second event” (i.e., they are not the same event) and (ii) that the first event and second event are “different.” Ex. 1001, Claim 1. Accordingly, the claim does not cover first and second events that are, for example, both text messages or both incoming calls because to hold otherwise would ignore and conflate these two separate and distinct requirements of the claim. Patent Owner submits that construing this term is necessary because, as addressed *infra* at Section III.B, the construction of this claim limitation is relevant to Petitioner’s failure to demonstrate obviousness of at least Grounds 1-3 of the Petition. Ex. 2015, ¶¶ 40-42.

Like the plain language of the claim, the specification supports Patent Owner’s construction of this claim term. For example, the specification refers to “different” events as events that are associated with different “type[s] of alert[s].” *Id.*, 5:32-36. The specification also refers to an incoming call and a calendar notification as “different” alerts. *Id.*, 2:41-44. Conversely, nowhere does the specification refer to two text messages as “different” events, or two to incoming calls as “different” events.

The prosecution history is also highly instructive. On March 19, 2019, applicant amended independent claim 15 (later renumbered as independent claim 1

in the '633 Patent) to require (i) a “first event” and a “second event” and to further require (ii) that “said first event and second events are different.” Ex. 1004, 322. On April 16, 2019, the Examiner mailed an Office Action rejecting the claims. *Id.*, 326-336. The Examiner stated that the primary reference, Chihara U.S. Pub. No. 2002/0068600A1, disclosed a first event corresponding to an incoming call. *Id.*, 329-330. However, importantly, the Examiner held that the fact that such reference disclosed receiving notifications of various incoming calls over time did **not** mean that Chihara disclosed “first” and “second” events where such events were “different.” Rather, the Examiner expressly held that Chihara did **not** disclose “a second event ... wherein said first event and second events are different.” *Id.* The Examiner relied instead on secondary reference, Pinsky U.S. Pub. No. 2004/0204044A1, for this feature. *Id.*, 330. Critically, the cited portion of Pinsky refers to notifications corresponding to “different” events—*i.e.*, incoming phone calls, e-mails, and appointment reminders. Ex. 2003, ¶ [0019]. The prosecution history thus also makes clear that the “different” first and second events in claim 1 cannot all be, for example, incoming calls or text messages.

The Petition concedes in a footnote that “[f]or purposes of this Petition only ... Petitioner assumes the narrowest possible interpretation of this limitation, that the second event different from the first event requires a different kind of event, e.g., a call and an email message as opposed to two different call events.” Pet., 28 n.7.

Accordingly, the Board should hold that this term requires two types or kinds of events, e.g., a call and an email, instead of two of the same type or kind of event (e.g., two different calls).

D. Cited References

1. Narayanaswami

U.S. Patent 6,477,117 (“Narayanaswami”, Ex. 1005) describes a concept for a watch coupled via Bluetooth to a GSM phone. Ex. 2015, ¶¶ 49-50.

Narayanaswami states:

“Typically, multiple persons are congregated in a room and carry their cell phones in a hand bag or wear them on their belts, have a hard time determining which cell phone is ringing when a ringing tone is heard in a room. This results in every person in the room pulling out his/her cell phone out of their handbag or belt to check if it is the one that is ringing. The caller Id display feature of the Wrist Watch device is particularly advantageous as each wearer may simply glance at the watch and would immediately know if the ringing phone belonged to him/her.”

Ex. 1005, at 8:6-15.

For reasons explained below, this reference is not relevant, invalidating prior art. By way of example only, there is no disclosure or suggestion of implementation of the motion-related claim elements. For example, there is no disclosure whatsoever of control circuitry or algorithms that could process sensor data to “distinguish between a plurality of different types of motion” as claimed in Claim 1.

Other notifications in Fujisawa do not result in a user-perceivable notification signal from the watch. E.g.:

“a communication end notification is sent from the radio base station 14 to the mobile telephone 11A(step Se21). Thereby, the communication line between the mobile telephone 13 and the mobile telephone 11A is released (step Se22).”

Ex. 1006, at [0312].

Fujisawa also fails to disclose that its watch includes motion sensing operable to distinguish between different types of motion. For example, there is no disclosure whatsoever of control circuitry or algorithms that could process sensor data to “distinguish between a plurality of different types of motion” as claimed in Claim 1.

3. Kita’514

US Publication 2001/0043514 (“Kita ‘514,” Ex. 1007) describes a concept for a watch-like device with sensors and memory units attached to the band, which band has bus lines for power, data, processor clock, etc. to support the functioning of these attached devices. Ex. 2015, ¶¶ 55-59.

This reference is not relevant, invalidating prior art as to any claim. For example, while Kita ‘514 discloses a “wireless communication function” (see, e.g., Ex. 1007, at [0154]), Kita ‘514 does not disclose wireless connection to a phone as required by the claims of the ‘633 Patent.

Kita '514 does not disclose any “user-perceivable notification signal.” The only “alarm” disclosed in Kita '514 is the “emergency alarm” which the watch conveys not to the user but to “a destination or an emergency center which may be previously stored in the memory.” Ex. 1007, at [0251].

590. Kita '514 thus not disclose either the “first user-perceivable notification signals that are dependent upon said received first communication signals associated with a first event” and the “second user perceivable notification signals that are dependent upon said second communication signals associated with a second event” required by the claims of the '633 Patent.

591. While mentioning possible motion sensors, Kita '514 discloses or suggests nothing about control circuitry or algorithms that could process sensor data to “distinguish between a plurality of different types of motion” as required by Claim 1 of the '633 Patent.

4. Kita'039

JP Publication 2002-125039 (in certified translation as “Kita '039,” Ex. 1009) describes a concept for a “child terminal” wirelessly coupled to a “parent terminal” (a mobile phone) in a communication network. Ex. 2015, ¶¶ 60-61.

This reference is not relevant, invalidating prior art as to any claim. As with Fujisawa, the only “user-perceivable notification signal dependent upon a received

communication signal” in Kita ‘039 is the flashing of the LED on the watch when a call comes in:

“Under the control of the CPU 215, the display driver 224 drives the display unit 225, whereby the communication data received by the parent terminal A and transmitted from the parent terminal A is displayed on the communication content display unit 203 (see FIG. 9), and the driver 208 drives the LED 204, causing the LED 204 to light up.”

Ex. 1009, at [0062].

5. Cannon

Cannon describes a concept for an “indication unit” which may be built into a “portable wireless device” (e.g., a smartphone). That device may receive a message while the user of that device is physically away from that device. The indication unit can sense when the user returns to that device. The indication unit then checks if a message was received during the user’s absence. If so, the indication unit presents a notification to let the user of that device know that a message had been received during the user’s absence. Ex. 2015, ¶¶ 62-65.

20. Unlike any of the references to which Petitioner attempts to combine Cannon, Cannon does not disclose a watch with any components or capabilities needed to:

- Receive any claimed “wireless communication signal associated with an event;” or
- Present any claimed “user-perceivable notification signal.”

21. The only watch disclosed in Cannon is a digital watch with Bluetooth always on. Its only task in Cannon is to come near enough to the portable wireless device so the indication unit senses the proximity of the watch. Events then ensue, carried out entirely by wired electronics within the indication unit, to produce a notification on the indication unit:

“When the user returns to the vicinity of the wireless device, the communication link 310 is reestablished between watch 300 and transceiver 140 and the BLUETOOTH™ transceiver 140 sends a control signal to the controller 125 which then consults message storage unit 145 and determines whether a new message has been received during the time period in which the communication channel 310 was broken. If yes, controller 125 then sends a control signal to either one or both of the received message waiting indicator 135 and the appointment reminder message indicator 130, depending on the nature of the message... it is also possible to provide a single message indicator which is activated so as to get the attention of the user whenever a message becomes pending when the user is away from the portable wireless device.” Ex. 1010, at [0023].

22. In the above citation, all numbered components are, as set forth at Ex. 1010, at [0017]-[0021], parts of the indication unit (not the watch).

III. ARGUMENT

A. Grounds 1-5 Of The Petition Fail To Establish Obviousness Of The Limitation “Said Device Includes Motion Sensing Operable To Distinguish Between A Plurality Of Different Types Of Motion”

The Board should find that all of Claims 1-39 of the '633 Patent are patentable over all Grounds because none of the cited references, alone or in combination, teach or suggest this claim limitation. Ex. 2015, ¶¶ 66-78.

The Petition’s arguments with regard to this claim limitation are based on Petitioner’s fundamental misreading of the claim language, discussed *supra* at Section II.C.1. In particular, properly construed, the first portion of this claim limitation (“said device *includes motion sensing ...*”) means that the device itself (*i.e.*, the same device that provides the notification signals to a user) contains control circuitry that provides a motion sensing capability. In addition, the second portion of this claim limitation (“said device includes motion sensing *operable to distinguish between a plurality of different types of motion*”) further defines the capability of the claimed device’s control circuitry, which is that it is configured to recognize or show a difference between different types of motion. *Id.*

For its part, Petitioner in effect erroneously seeks to rewrite this claim term to read: “said device ~~includes~~ receives motion sensing data ~~operable to distinguish between~~ of a plurality of different types of motion.” *Id.* Then, and only then on the basis of Petitioner’s improper rewriting of the claim language, Petitioner incorrectly

argues that Narayanaswami or Kita'514 teaches or suggests this claim limitation. The Board should reject Petitioner's arguments. Ex. 2015, ¶ 69.

For Grounds 1-3, Petitioner relies on Narayanaswami, or alternatively, Kita'514 as allegedly teaching this claim limitation. Pet., 31-32.

For Grounds 4-5, Petitioner relies on Kita'514 as allegedly teaching this claim limitation. Pet., 66.

For each alleged Ground, the Petition makes two critical errors.

First, the Petition repeatedly points to mere sensors in Narayanaswami (e.g., tilt sensor or GPS) (Pet., 31) or Kita'514 (e.g., accelerometer or barometer) (Pet. 32, 66) that purportedly provide sensor data to a watch. However, sensors are not control circuitry as required by this claim limitation as properly construed. Put simply, it is not enough to satisfy this claim limitation to show that the Narayanaswami or Kita'514 watch may receive sensor data from one or more sensors. *See supra* at Section II.C.2. The Board should thus reject Petitioner's attempt to in effect rewrite the claim language to merely require that "said device ~~includes~~ receives motion sensing data" *Id.*; Ex. 2015, ¶ 74.

Second, the Petition ***admits*** that it affords no meaning to the portion of the claim language requiring that the device's control circuitry is "operable to distinguish between a plurality of different types of motion." Indeed, the Petition invites the Board to commit reversible error by asserting Petitioner's erroneous view

that “Claim 1 does **not** recite ... making use of information gathered through sensing motion,” which is incorrect because Petitioner reads out express words of the claim. Pet. 30, n.8 (emphases added); Ex. 2015, ¶ 75. Directly contrary to Petitioner’s argument, every word of Claim 1 of the ’633 Patent possesses meaning and Claim 1 requires that the device’s control circuitry must be configured to “distinguish between a plurality of different types of motion.” *E.g., Exxon Chemical Patents v. Lubrizol Corp.*, 64 F.3d 1553, 1557 (Fed. Cir. 1995) (“We must give meaning to all the words in [the patent’s] claims.”); *see supra* at Section II.B.2. Accordingly, here again, the Petition errs by merely pointing to sensors (e.g., tilt sensor or GPS) as purportedly satisfying this limitation. Pet., 31-32, 66. Again, a sensor is not control circuitry. In addition, each alleged sensor identified by Petitioner at best merely senses one type of data or signals (e.g., purportedly tilt or GPS), and is not configured to “distinguish between a plurality of different types of motion” as claimed in Claim 1. This directly contrasts with Claim 1 and the ’633 Patent’s control circuitry, which is configured to distinguish between different types of motion, such as by distinguishing ambient motion from vibrating motion. Ex. 1001, Claim 1 and 5:16-23.

Petitioner’s fundamental misreading of this claim limitation, and corresponding erroneous mapping of this claim limitation to mere sensors that do not possess the claimed capability “to distinguish between a plurality of different

types of motion,” demonstrates that the Petition has failed to demonstrate obviousness of this claim limitation, let alone a “compelling case” of purported obviousness.

To be clear, the Petition is completely silent on this claim limitation’s requirement for control circuitry that can distinguish between a plurality of different types of motion, and Petitioner cannot remedy this fundamental deficiency with new allegations or evidence. In any event, there is no disclosure or suggestion in Narayanaswami or Kita’514, and the Petition points to none, of any control circuitry that is configured to distinguish between a plurality of different types of motion as claimed in Claim 1 of the ’633 Patent. For example, in direct contrast, Narayanaswami only briefly refers to a CPU 55 (*e.g.*, Ex. 1005, 3:55), and there is no disclosure of what, if any, sensor data CPU 55 receives, much less any teaching or suggestion that it receives sensor data for multiple different types of motion and uses control circuitry to distinguish between a plurality of different types of motion as claimed. Ex. 2015, ¶¶ 76-78.

B. Grounds 1-3 Of The Petition Fail To Establish Obviousness Of The Limitation “A Device Operable To Receive First Wireless Communication Signals Associated With A First Event And Second Wireless Communication Signals Associated With A Second Event From Said Mobile Telephonic Device, Wherein Said First Event And Second Event Are Different”

Narayanaswami describes only one instance of a watch receiving a signal from a mobile phone, namely one containing “caller ID information.” Ex. 1005, 7:63-8:5. Narayanaswami does not teach or suggest a watch that also receives “second” signals associated with a “second” and “different” event “from said mobile telephonic device,” as claimed in Claim 1 and referenced *supra* at Section II.C.2 regarding claim construction. Ex. 2015, ¶¶ 79-88.

Petitioner asserts that (i) Narayanaswami describes using a personal computer (“PC”) to input a calendar appointment to a watch, which is “a second event of a different type” (Pet., 29); and (ii) it would have been obvious from Narayanaswami to input a calendar appointment to the watch from a mobile phone instead of from a PC (Pet., 30).

Initially, as discussed *supra* at Section II.C.2, the proper construction of the “first event and second event are different” limitation in Claim 1 requires **both** (i) the existence of a “first event” and a “second event” (i.e., they are not the same event) and (ii) that the first event and second event are “different.” Claim 1 does not cover first and second events that are, for example, both incoming calls, and thus

Narayanaswami's description that its watch can receive from a mobile phone information regarding multiple calls does *not* teach or suggest claim 1. Indeed, Petitioner concedes that "[f]or purposes of this Petition only ... Petitioner assumes ... that the second event different from the first event requires a different kind of event, e.g., a call and an email message as opposed to two different call events." Pet., 28 n.7.

Importantly, Petitioner next admits that Narayanaswami does not disclose or suggest receiving "second" signals associated with a "second" and "different" event "from said mobile telephonic device," as claim 1 of the '633 Patent requires. Pet., 29 (Petitioner acknowledging that "Narayanaswami describes the appointment as originating at a user's *PC*" and not a mobile phone) (emphases added). Accordingly, Petitioner admits that Narayanaswami does not disclose this feature of claim 1.

In the face of this critical deficiency, Petitioner next makes an unsupported logical leap that, even worse, reads isolated portions of Narayanaswami out of context and in a manner inconsistent with Narayanaswami's teachings as a whole. Specifically, Petitioner argues that a "PC" is only an "[e]xample" of a device that Narayanaswami teaches or suggests can provide a calendar appointment to Narayanaswami's watch. Pet., 28. However, contrary to Petitioner's argument, Narayanaswami clearly and deliberately states that its watch is intended to provide "desktop *PC-like* functions"—leaving no doubt that when Narayanaswami refers to

imparting existing functions to Narayanaswami's watch it intentionally and deliberately identified those functions as originating from a PC:

It would thus be highly desirable to provide a wearable device/appliance (a wrist watch) capable of **wirelessly accessing information** and equipped with an interactive user interface and high resolution display **for providing a variety of desktop PC-like functions**.

Ex. 1005, 1:66-2:3 (emphases added).

It is an object of the present invention to provide a wearable It device/appliance (a wrist watch) capable of **wirelessly accessing information** and equipped with an interactive user interface and high resolution display **for providing a variety of desktop PC-like functions**.

Id., 2:12-16 (emphases added). Petitioner's failure to identify, much less address, these portions of Narayanaswami, and thus Petitioner's corresponding failure to consider Narayanaswami "as a whole," demonstrates that Petitioner has failed to prove obviousness of this feature let alone present a "compelling case" of purported obviousness. *In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965) (holding that there is an enduring admonition against impermissibly "pick[ing] and choos[ing]" from a reference "only so much ... as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to" a POSITA); *In re Enhanced Security Research, LLC*, 739 F.3d 1347, 1355 (Fed. Cir. 2014) (holding it impermissible to "stitch together an obviousness finding ... without considering the references as a whole"). Ex. 2015, ¶ 83.

Petitioner's only alleged obviousness rationale is that "Narayanaswami *teaches* that its watch 'synchronizes' with 'other devices,'" which Petitioner then couples with its conclusory assertion that such "other devices" "would have included a cell phone (or PDA) having a calendar capability." Pet., 29 (citing Ex. 1005, 7:3-9) (emphases added). This, again, is an unsupported logical leap and not what Narayanaswami describes, which is that its "object of the present invention" is for the watch provides PC-like functions. Ex. 1005, 2:12-16. Confirming this, the only mention of a device that includes a "calendar" capability is a PC. *Id.*, 9:25-26. And, the only mention of a mobile phone's capability is of providing "caller ID information." Ex. 1005, 7:63-8:5. Accordingly, when Narayanaswami refers to synchronizing its watch with "other devices," relevant to the issues here logically and literally it means nothing more than synchronizing the watch with one or more PCs to obtain PC-like functions (e.g., calendar appointments) and synchronizing the watch with a user's mobile phone to receive caller ID information. The Board should reject Petitioner's hindsight attempt to reinterpret Narayanaswami as teaching or suggesting something more, especially when in fact, Narayanaswami expressly states that its "object" and focus is to provide PC-like functions. *In re Wesslau*, 353 F.2d at 241; *In re Enhanced Security Research, LLC*, 739 F.3d at 1355; *see also e.g., InTouch Techs., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014) (concluding that expert "succumbed to hindsight bias in her obviousness analysis")

where such analysis focused on what “one of ordinary skill in the art could” allegedly have done instead of what “they would have been motivated to do”). Ex. 2015, ¶ 84.

Accordingly, the Board should find that the Petition has failed to demonstrate obviousness of this claim limitation, and thus should hold that Claims 1-39 of the '633 Patent are patentable over the art cited for Grounds 1-3 for this additional reason.

C. Grounds 4-5 Of The Petition Fail To Establish Obviousness Of The Limitations “A Device Operable To Receive ... Second Wireless Communication Signals Associated With A Second Event From Said Mobile Telephonic Device” And “Said Device Is Operable To Provide Second User Perceivable Notification Signals That Are Dependent Upon Said Second Communication Signals”

The Board should also hold that Claims 1-39 of the '633 Patent are patentable over the art cited for Grounds 4-5 for the additional, independent reason that Petitioner fundamentally errs when it argues that Fujisawa “teaches” these claim elements. Pet., 65, 67-68; Ex. 2015, ¶¶ 89-97.

The Petition alleges that Fujisawa’s “watch-shaped information processing device” receives the claimed “second wireless communication signals” in the form of a “*voice message*” from Fujisawa’s mobile telephone. Pet., 65 (“The voice message is ... the second wireless communication signal.”) (citing Ex. 1006, ¶ 270 (“The mobile telephone 11A receives the data for the message (step Sc21), and then

sends the data to the watch-shaped information processing device 12A via the SCO link (step Sc22).”) (emphases added).

The Petition next argues that Fujisawa “teaches” that its watch-shaped information processing device is “operable to provide second user perceivable notification signals that are dependent upon said second communication signals” as claimed in Claim 1. For the alleged “second user perceivable notification signals,” the Petition points to the display by Fujisawa’s watch-shaped information processing device of the text “*recording caller’s message.*” Pet., 68 (“the watch displays ‘recording caller’s message’ to the user”) (citing Ex. 1006, ¶ 272).

The Petition fails to demonstrate obviousness of these claim limitations. In fact, directly contrary to Petitioner’s misapplication Fujisawa’s purported teachings to these claim limitations in Claim 1 of the ’633 Patent, Fujisawa’s watch-shaped information processing device displays the text “recording caller’s message” (the Petition’s alleged “second user perceivable notification signals”) *before* the watch-shaped information processing device actually (if ever) receives the voice message from the wireless telephone (the Petition’s alleged “second wireless communication signals”). That is, before any voice message (the alleged “second wireless communication signals”) is received by the watch-shaped device, the watch-shaped device displays the text “recording caller’s message” (the alleged “second user perceivable notification signals”). Accordingly, the watch-shaped device’s display

of the “recording caller’s message” is *not* “dependent upon” the voice message at all because the watch-shaped device displays the “recording caller’s message” text before the device actually, if ever, receives the voice message. The Petitioner indeed *admits* that Fujisawa does not teach this claim element when it admits that Fujisawa’s voice message is received by Fujisawa’s watch-shaped information processing device only *after* it has already displayed the text “recording caller’s message,” which confirms that the display of the “recording caller’s message” text is not dependent upon the voice message at all: “Fujisawa teaches that ‘the caller’s telephone number and a message ‘recording caller’s message’ are shown on the display unit of the watch-shaped information processing device 12A The voice message is *subsequently* transmitted” Pet., 65 (emphases added). The Petition thus fundamentally errs when it argues that Fujisawa’s displayed “recording caller’s message” text (the Petition’s alleged “second user perceivable notification signals”) is dependent on Fujisawa’s voice message (the Petition’s alleged “second wireless communication signals”) as claimed in Claim 1 of the ’633 Patent. *Id.* at 65, 68; Ex. 2015, ¶¶ 94-95; see also *id.* ¶ 96.

Accordingly, because the Petition fundamentally errs in its application of the purported prior art to, and its reading of, the limitations of Claim 1 of the ’633 Patent, the Board should find that the Petition has failed to demonstrate obviousness of these

claim limitations, and thus should hold that Claims 1-39 of the '633 Patent are patentable over the art cited for Grounds 4-5 for this additional reason.

IV. 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 that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE specified in 37 C.F.R. § 42.24 have 7,766 words, in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24(b)(1). This word count was prepared by the word-processing program used to prepare this paper (Microsoft Word).

Dated: July 8, 2025

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