

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioner,

v.

KP INNOVATIONS 2, LLC,

Patent Owner.

PTAB Case No. IPR2025-00101

Patent No. 10,499,168

**PATENT OWNER'S PRELIMINARY RESPONSE
UNDER 35 U.S.C. § 42.107**

February 21, 2025

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Exhibit	Title
1001	U.S. Patent No. 10,499,168 to Robert Glen Klinefelter <i>et al.</i> (“’168 Patent”)
1002	U.S. Provisional Patent Application 60/243,162, Robert Glenn Klinefelter et al. (“’162 Provisional Patent Application”)
1003	Prosecution History of U.S. Patent No. 10,499,168
1004	Declaration of Dr. Sandeep Chatterjee (“ <i>Chatterjee</i> ”)
1005	Curriculum Vitae of Dr. Sandeep Chatterjee
1006	U.S. Patent No. 5,808,663 to Ken Okaya (“ <i>Okaya</i> ”)
1007	U.S. Patent No. 6,782,281 to Naokazu Nagasawa (“ <i>Nagasawa</i> ”)
1008	PCT International Patent Publication No. WO 01/31893 to Esa Harma (“ <i>Harma</i> ”)
1009	KP2’s Infringement Contentions (served September 24, 2024), KP2 Innovations 2, LLC, v. Samsung Electronics Co., Ltd. et al., No. 1:24-cv-00170 (W.D. Tex. Feb. 19, 2024)
1010	UK Patent Application Publication No 2,358,985 to Tetsuya Kubo et al. (“Kubo”)
1011	Claim listing for Challenged Claims of U.S. Patent No. 10,499,168.
1012	Complaint, <i>KP2 Innovations 2, LLC, v. Samsung Electronics Co., Ltd. et al.</i> , No. 1:24-cv-00170 (W.D. Tex. Feb. 19, 2024)
1013	Scheduling Order, <i>KP2 Innovations 2, LLC, v. Samsung Electronics Co., Ltd. et al.</i> , Dkt. No. 27, No. 1:24-cv-00170 (W.D. Tex. Feb. 19, 2024)
1014	“Access” definition. The American Heritage® College Dictionary (2000)

1015	<i>“Mobile telephone” definition. Telephony’s Dictionary (2nd Ed.1986)</i>
1016	<i>“Mobile phone” definition. The Focal Illustrated Dictionary of Telecommunications (1999)</i>
1017	Bob Summers, <i>Official Microsoft NetMeeting Book</i> , Microsoft Press (1998)
1018	Norman E. Sondak, Eileen M. Sondak, <i>“Video Conferencing: The Next Wave for International Business Communication,”</i> Ann. Conf. on Language and Comm. For World Business and the Professions (April 6-8, 1995)
1019	Certified Translation of Japanese Patent Publication JPH11298869, Kazuhiro Takahasi <i>et al</i>
1020	Dell™ Latitude™ CPx H-Series/J-Series User’s Guide, Initial Release November 15, 1999, Last Revision August 28, 2000, available at https://www.dell.com/support/home/en-us/productsupport/product/latitude-cpx-h/docs
1021	<i>“PC Card Technology Primer,”</i> Personal Computer Memory Card International Association, October 22, 2000, available at https://web.archive.org/web/20001022131519/http://www.pcmcia.org/pccard.htm
1022	<i>“The Zoomed Video Port for PC Cards,”</i> Personal Computer Memory Card International Association, July 8, 2000, available at https://web.archive.org/web/20000708043950/http://www.pcmcia.org/papers/zv.htm
1023	David G. Messerschmitt, <i>“Convergence of Telecommunications with Computing,”</i> Technology in Society, Vol. 18, No. 3, pp. 285-86 (1996)
1024	Mirza M. Luqman et al., <i>“Globalization of Wireless Telephone,”</i> Portland International Conference on Management of Engineering and Technology, July 29, 2001-August 2, 2001
1025	<i>“System Specifications: Latitude CPx,”</i> www.dell.com (archived March 1, 2000), available at

	https://web.archive.org/web/20000301021538/http://www.dell.com/us/en/bsd/products/spec_latit_cpx_notebooks.htm
2001	Declaration of Dr. Luke Theogarajan
2002	“ <i>I See What You Mean’: The Role of Kinesic Behaviour in Listening and Implications for Foreign and Second Language Learning</i> ,” Applied Linguistics, Volume 13, Issue 3, September 1992, Pages 239-258, available at https://doi.org/10.1093/applin/13.3.239
2003	“A complete history of the camera phone,” Simon Hill, May 13, 2022, available at https://www.digitaltrends.com/mobile/camera-phone-history/
2004	Notice of Order in Case 1:24-CV-00170-ADA KP Innovations 2, LLC v. Samsung Electronics Co., Ltd. et al Order Reassigning Case to Judge Alan D Albright for all proceedings

I. INTRODUCTION

Patent Owner KP Innovations 2, LLC (“KP2” or “Patent Owner”) submits the following Patent Owner Preliminary Response (“POPR”) pursuant to 37 C.F.R. § 42.107(a). *See also* 37 C.F.R. § 42.107(b). Petitioner Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (“Samsung” or “Petitioner”) filed a Petition for *Inter Partes* Review of U.S. Patent No. 10,499,168 (the ’168 patent”) on November 7, 2024. (IPR2025-00101, Paper No. 1 (“Petition”)).

Patent Owner respectfully requests the Board deny institution of *Inter-Partes* Review because Samsung failed to meet its burden to show a reasonable likelihood that at least one of the challenged claims is unpatentable. Specifically, Samsung failed to demonstrated a reasonable likelihood that any claim of the ’168 patent would be anticipated or rendered obvious in view of any of the four (4) asserted Grounds. Thus, the Board should deny institution of an *Inter-Partes* Review of the ’168 patent.

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

A. Real Party in Interest

Patent Owner KP Innovations 2, LLC is the real party-in-interest.

B. Related Matters

The following proceedings involving the ’168 Patent may affect or be affected by a decision in this proceeding:

- *KP Innovations 2, LLC v. Samsung Electronics Co., Ltd.*, Case No. 1-24-cv-00170-ADA (W.D. Tex.) (“KP2 Litigation”). The Original Complaint in that litigation was filed on February 19, 2024. *See* Exh. 1012 and subsequently assigned to Judge Alan D. Albright. *See* Exh. 2004.

C. Counsel and Service Information

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D. 37 C.F.R. § 42.28(b)(4): Service Information

KP2 submitted its Mandatory Notices, Paper 4, and Power of Attorney, Paper

5. KP2 also consents to electronic service directed to the following email address:

KP2-IPR@addyhart.com

III. PETITION SHORTCOMINGS

A. Claim Construction

1. **Petitioner is asserting multiple claim constructions without identifying any specific element and what is a plausible construction**

Petitioner states that the Board need not construe any terms (Pet. 12) but then asserts, “Petitioners expressly rely on this [i.e., KP2 litigation complaint] claim interpretation.” Pet. 29. Petitioner fails to meet their burden and set forth what they believe is that claim interpretation or claim term construction. Petitioner cites to a case as to how a challenged claim is to be construed (even though no claim construction has occurred in that case). However, unlike here, a claim was construed in that cited case. The Board and Patent Owner should not have to guess what terms are being construed by Petitioner when using the claim interpretation (which had alternatives) from a complaint in a co-pending litigation. Simply making a statement about co-pending litigation does not provide the Board or Patent Owner with any guidance on how Petitioner is interpreting claim language.

2. **Wrong Claim Construction Used by Petitioner’s Expert**

Petitioner in Section “V” of the Petition submitted that “the Board need not construe any term because the prior art invalidates the claims under any plausible

constructions.” Pet. 12. Therefore, Petitioner limits the construction to plausible constructions and does not identify that plausible construction. The Board is not required to determine what is plausible or not plausible. Petitioner had the burden of providing a claim construction if needed.

Even though Petitioner states that no claim construction is required it then later attempts to drop in a claim construction based on extrinsic evidence. *See* Pet. 29. Exh. 1014 is a complaint from a co-pending lawsuit. Claims have not been construed in that litigation. If Petitioner wishes to litigate the claim terms of the claim charts from the complaint, then the Board should deny the institution.

Petitioner also improperly uses a general construction and asserts the claims require certain elements but fails to identify the claims having those elements or how the terms interact with other terms in the claims.

B. The Petition must specify where each element of the claim is found in the prior art

The Petition fails to meet the requirements of 35 U.S.C. § 312(a) and 37 C.F.R. § 42.104(b)(4) because it lacks specificity as to where each element of the claims of the '168 Patent is found in the relied upon prior art. Petitioner relies on string cites to multiple paragraphs in the references and Declaration with little or no explanation of what those paragraphs teach or explain, or what it relies on in a reference. *See e.g.*, Pet. 13 (Element 18[p]); Pet. 25-26 (Element 18(e); Pet. 47(Claim 3).

Assuming Petitioner has a viable theory, which it does not, Petitioner must explain that theory in its Petition—a mere string citation is insufficient. *See, e.g., Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F.3d 1378, 1385 (Fed. Cir. 2019) (holding that a conclusory assertion with no analysis was not adequately developed); *Novartis AG v. Torrent Pharms.*, 853 F.3d 1316, 1326 n.2 (Fed. Cir. 2017) (finding that an argument presented in one conclusory sentence and a string cite was “far from sufficient to raise a meaningful challenge” and “amount[ed] to little more than a request that the Board peruse the cited evidence and piece together a coherent argument on Novartis’ behalf”).

Further, the Board has ruled in similar situations that “a string citation lacking any explanation whatsoever is imprecise and vague ... they are presented without explanation or further direction Judges are not like pigs, hunting for truffles buried in briefs; nor will we hunt for truffles buried in string citations, offered in briefs.” *Apple Inc. v. Qualcomm Inc.*, IPR2018-01276, Paper No. 32, 2020 Pat. App. LEXIS 7895, *15-16 (PTAB Feb. 3, 2020) (citing *Anderson v. Eppstein*, 59 USPQ2d 1280, 1287 (BPAI 2001) and *United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991)). Such is the situation here, and as will be noted in detail below, Pet. 33 (Element 1(d)(ii)); Pet. 37 (Element 1(e)); Pet. 47(Claim 3).

IV. U.S. PATENT NO. 10,499,168

A. Background

The '168 Patent, titled “*System, Method, and Apparatus for Providing Interpretive Communication on a Network*,” issued on December 3, 2019, it was filed on February 8, 2010, as a divisional of application 10/057,131, which was filed on October 25, 2001, Patent No. 7,792,676, and claims priority to Provisional application No. 60/243,162, which was filed on October 25, 2000. *See* Exh. 1001, cover page; Exh. 2001, ¶42.

At the time of the first filing, interpretive communication on a network was limited to video conferencing systems that required dedicated network resources, *i.e.*, ISDN lines (Exh. 1001, 1:31-35,) and special hardware (*See* Exh. 1021; 1022,) to enable live real-time or near-real-time streaming video. The first cellular phone with a built-in camera that was able to take low-resolution still photographs (0.35 megapixels) was manufactured by Samsung and released in South Korea in June of 2000, but a connection to a computer was required to get the pictures off the cellular phone. *See* Exh. 2003, 1. The first real camera phone was produced by Sharp and released in Japan by J-Phone (J-SH04) in November 2000. The J-Phone could take low-resolution (0.11 megapixels) still photographs and send the still photographs electronically. *See* Exh. 2003, 2. Exh. 2001, ¶¶32-34.

Video conferencing systems were known at the time of the '162 Provisional Patent Application. The provisional application stated:

In one attempt to provide a solution, a video conferencing service has been developed. The system, known as Video Interpreting Program, has been offered by a well-established Maryland company ... since 1997.

Exh. 1001, 1:29-31; 1002, 12:1-3. What was not known, however, was an approach or device that is:

A cost effective system introduced to satisfy the need for remote visual exchange between an interpreter, a non-hearing impaired person and a hearing disabled person. Moreover, to date, there is no indication that any service providers has moved to implement a video/audio system based on Internet connections as implemented by some of the various embodiments of the present invention.

Exh. 1001, 2:5-12; 1002, 13:5-9; 2001, ¶¶35-36.

The '162 Provisional Patent and '168 Patent also identify the location of and inability to move a desktop video conferencing system:

Further, most hospitals do not have a significant [amount of] telecommunications equipment for providing video conferencing at

their facilities. However, for the hospitals that do have this equipment it is often located far away from the emergency room area and is considerably bulky and difficult, if not relatively impossible, to move from room to room. Thus, **this solution of utilizing a hospital's teleconferencing equipment is also considered a failure to solve the above mentioned problems**, such as medical facility interpretation, as the videoconference presentation of the interpreter is not in a useful location relative to the emergency room for the patient or the family that may be able to advise medical personnel in the treatment of the patient.

Exh. 1001, 2:55-67; 1002, 14:13-21 (*emphasis added*). The use of traditional video conferencing systems failed to address the identified problems. A POSITA would also understand the identified problems. Exh. 2001, ¶37.

Besides video conferencing, mobile devices, such as personal digital assistance (PDAs), cellular (mobile) telephones with data capability, and laptop computers with wireless internet were also known at the time of the provisional patent application. However, smartphones, such as the Apple iPhone, were not

released until June 29, 2007,¹ more than six years after the filing date of the '162 Provisional Patent Application. Exh. 2001, ¶38.

The '162 Provisional Patent and '168 Patent provided the solution of using portable devices connected to the Internet and wide area networks (WAN):

In one preferred embodiment, the present invention provides for the introduction of an online exchange linking a network of qualified sign language interpreters, oral interpreters, simultaneous transcribers and, where appropriate, voice or motion recognition captioning. The exchange would utilize current Internet and wide area computer network technologies allowing live audio and video feeds.

Exh. 1001, 9:4-10; 1002, 26:1-5; 2001, ¶39.

To address the portability of the conferencing system, the provisional called out examples of Internet-capable portable devices: “PDA, laptop, Internet-capable cellular phone, or similar handheld device [that could incorporate the teachings of this patent to create a device] capable of receiving, displaying, and broadcasting the

¹ Apple CEO Steve Jobs announced the first iPhone on January 9, 2007, at the Macworld convention in San Francisco. The iPhone was released to the public on June 29, 2007.

remote sign language or foreign language interpreter's signing and vocal communications." *See* Exh. 1001, 9:32-36; 1002, 22:18-20; 2001, ¶40.

The inventors of the patent, Robert Klinefelter (now deceased) and Gregory Picconelli, were not working for a company developing this technology. Robert Klinefelter grew up in California with deaf parents and experienced firsthand the difficulties that deaf people have getting medical and other types of assistance. Mr. Picconelli, who also lived in California, is an individual who was working with the video industry at the time of the invention and experienced the need for mobile translation while on vacation. Mr. Klinefelter and Mr. Picconelli are true American inventors.

B. Priority

The '168 Patent was filed as a Divisional application of application 10/057,131. The '131 application (now Patent No. 7,792,676) was filed on October 25, 2001, and claims priority to Provisional application number 60/243,162, filed on October 25, 2000. Exh. 2001, ¶42.

Neither the patent examiner during examination of the application nor the PTAB on appeal raised any issues with the priority claim (Exh. 1003, 832-837) of the '168 Patent. Exh. 1002; 2001, ¶42. Even if one accepts Petitioner's priority argument, the references relied on in Grounds 1-4 fail to disclose and describe all of

the claim elements of claims 18-21. Petitioner also fails to provide a motivation to combine the references at the time of filing the '168 Patent. Exh. 2001, ¶43.

V. PERSON OF ORDINARY SKILL IN THE ART

Patent Owner asserts that a person of ordinary skill in the art would have some familiarity with underlying technologies involving communication or networking service devices that utilize cameras and displays. For example, a person of ordinary skill in the art would need to know how to utilize electrical components of the system but would not necessarily need to be an expert on the design of communication service devices. A person of ordinary skill in the art would need to know how configurations for transmitting and receiving information over a network are created and implemented in devices. Exh. 2001, ¶¶28-31.

VI. THE CHALLENGED CLAIMS

Petitioner challenged claims 18-21 of the '168 Patent. *See* Pet. 6. Claim 18 is an independent claim with dependent claims 19-21. Exh. 1001, 22:31-62; 2001, ¶41.

VII. APPLICABLE LEGAL PRINCIPLES

Petitioner has the burden to show that it is likely to prevail as to at least one of the four claims at issue of the '168 Patent. *See* 35 U.S.C. § 314; *SAS Institute Inc. v. Iancu*, 2018 WL 1914661 (Apr. 24, 2018). “A claim is anticipated only if each

and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). To make a *prima facie* showing of obviousness under 35 U.S.C. § 103, the Petition must, among other requirements, fulfill the requirements set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), including demonstrating that the cited references, in combination, disclose each element of a challenged claim. *In re Magnum Oil Tools Int’l.*, 829 F.3d 1364, 1376 (Fed. Cir. 2016); see also *Apple Inc. v. Contentguard Holdings, Inc.*, IPR2015-00442, Paper 9 at 12-13 (PTAB July 13, 2015).

Petitioner also has the burden to show there would have been some motivation to combine the asserted prior art, and that the proposed combination would render the patented claims obvious. “Obviousness requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination.” *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011) (internal citation omitted); see also *In re Magnum Oil Tools Int’l.*, 829 F.3d at 1376. Even if individual modifications or choices were known, a petition must explain why making all the changes at once would be obvious. *Apple Inc. v. Contentguard*, Paper 9 at 16-17 (“[T]he mere fact that individual changes might have been obvious does not make doing all of the changes at once obvious.”).

The Federal Circuit has found that even for an obviousness challenge based on a single reference in view of the knowledge and skill of a POSITA there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination. *In re Stepan Co.*, 868 F.3d 1342, 1345-46 (Fed. Cir. 2017). In other words, when a gap in a single prior art reference requires filling with, for example, the knowledge of one of ordinary skill, there must be a further showing that the skilled artisan would have arrived at the claimed invention and the reasoning behind it.

The lack of a technological obstacle to combining references, in and of itself, does not justify a finding of obviousness. *See In re Omeprazole Patent Litig. v. Apotex Corp.*, 536 F.3d 1361, 1380-81 (Fed. Cir. 2008). A reason for combining disparate prior art references is critical and should be made explicit. *InTouch Techs., Inc. v. VGo Communs., Inc.*, 751 F.3d 1327, 1351 (Fed. Cir. 2014) (internal citation omitted).

Hindsight analysis is inappropriate. Obviousness must be measured “at the time the invention was made.” *Ortho-McNeil Pharm. v. Mylan Labs*, 520 F.3d 1358, 1364 (Fed. Cir. 2008) (emphasis original). A petition must demonstrate a rationale to combine prior art references without relying on the patent disclosure itself. *P&G v. Teva Pharms. USA, Inc.*, 566 F.3d 989, 995 (Fed. Cir. 2009). The Petitioner must

not use the patent as a roadmap. *In re NTP, Inc.*, 654 F.3d 1279, 1299 (Fed. Cir. 2011)(internal citation omitted); *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

VIII. CLAIM CONSTRUCTION

A. Claim Construction Standard

In an *inter partes* review proceeding, “a claim of a patent ... shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b). Claims must be construed “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art *and the prosecution history pertaining to the patent.*” 37 C.F.R. § 42.100(b) (*emphasis added*) (citing 35 U.S.C. § 282(b)). Hence, all other claim terms should be given their plain and ordinary meaning as used in the ’168 patent specification and file history.

B. The term “receive and transmit information”

Claim 18 recites “at least one user communication device configured to receive and transmit information over the communication network.” Exh. 1001, 22:34-36. The term “receive and transmit information” means real-time or near real-

time audio and visual information. Also, the Preamble to 18[p] states, “[a] communication service device operable with a communication network.” Exh. 1001, 22:31-32. The preamble enables the communication device of claim 18 to transmit and receive real-time or near real-time audio/visual information through the communication network. The use of a “communication service device” in claim 18 also provides a POSITA context for the service device to be used for communication, which for interpreting or translating would have to be real-time or near real-time communication. Exh. 2001, ¶46.

The specification states, “interpreting services may be displayed in real time or near real time.” Exh. 1001, 5:60-61. The patent is directed at interpreting services. In order to be effective, an interpreter must be able to see what a deaf person is signing in real-time. The ’168 Patent provides no example of non-real-time recorded video information being sent and then translated. Indeed, all examples in the ’168 Patent are real-time information. The Petition even admits that the “... ’168 Patent relates to systems for providing ‘real-time or near real-time interpreting services for utilization on a network.” Pet. 8 (*citing* EX1001, 1:16-18); Exh. 2001, ¶47.

Petitioner accepts Patent Owner’s construction because the construction is a plausible construction, and Petitioner stated that they believe their art invalidates the claims under any plausible constructions. *See* Pet. 12. Petitioner also waived its

right to make new claim construction arguments for additional claim terms by failing to include them in its Petition. Petitioner made no claim construction for any of the challenged claims 18-21 of the '168 Patent and is now prevented from doing so.

To the extent Petitioner states that no express construction is required and then later advocates for a specific interpretation during the course of any instituted IPR, such action would be contrary to federal regulation, this Board's guidelines, and settled law. *See* 37 C.F.R. § 41.104(b)(3) ("The statement [of relief requested] must identify ... [h]ow the challenged claim is to be construed."); *Microsoft Corp. v. Uniloc*, IPR2019-01188, Paper 27 at 19, 2020 Pat. App. LEXIS 12698 (PTAB Nov. 4, 2020) (on reply, petitioner "cannot raise new claim construction issues that were not previously raised in its petition") (quoting Consolidated Trial Practice Guide 44-45 (Nov. 2019) *available at* <https://www.uspto.gov/TrialPracticeGuide>).

If the Board construes any other claim terms, Patent Owner reserves the right to provide constructions for those terms or other terms, if they become material to the Board's decision.

IX. OVERVIEW OF THE PRIOR ART

A. Okaya (Exh. 1006)

U.S. Patent No. 5,808,663 ("*Okaya*") (Exh. 1006) was filed on January 21, 1997, and issued on September 15, 1998. Exh. 2001, ¶¶50-51. *Okaya* describes a multimedia carousel peripheral device for connection to a computer or video

conferencing system, similar to a monitor, microphone, or camera. The *Okaya* device is not a standalone device that can connect to a network. Exh. 2001, ¶52.

The *Okaya* multimedia carousel device has to be used in a video conferencing system or with a computer. The disclosed multimedia carousel includes a cube-shaped media unit rotatably disposed on a stationary base with four outwardly facing sides of the media unit, each having an active color matrix display, cameras, and voice-activated microphone. See Exh. 1006, Abstract. The *Okaya* carousel “includes several input and output terminals for integrating with a multimedia computer or video conferencing system.” Exh. 1006, 3:2-3. *Okaya* does not include any networking capability. Exh. 2001, ¶53. The lack of any networking capability is shown in Fig. 2, of *Okaya*:

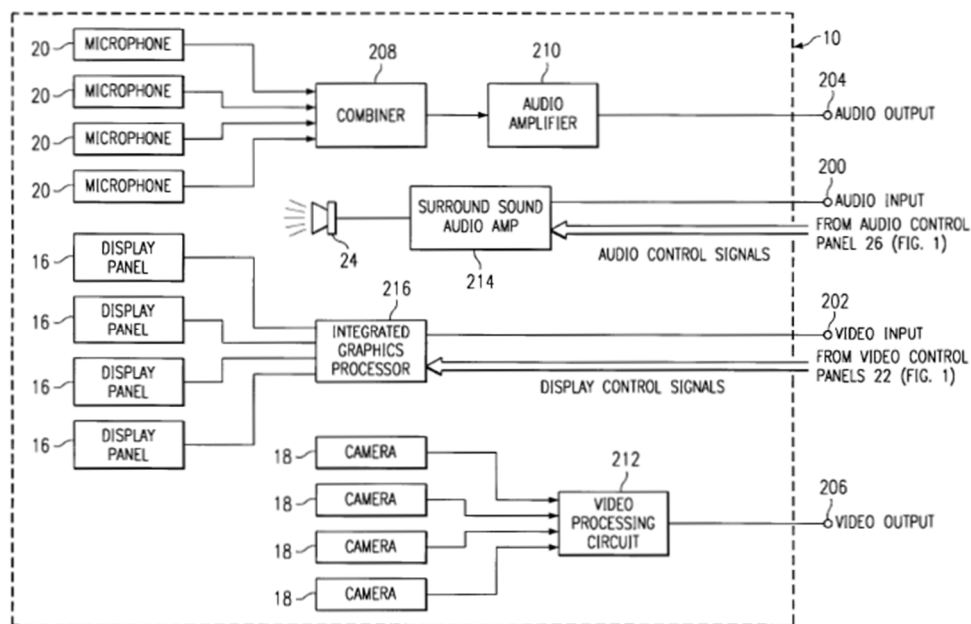


Fig. 2

Exh. 1006, Fig. 2; 1002, ¶¶53-55.

B. Harma (Exh. 1008)

PCT International Publication No. WO 01/31893 (*Harma*) (Exh. 1008) was filed on October 25, 2000, and has an international publication date of May 3, 2001. *Harma*'s priority date does not predate the '162 Provisional Patent Application. *Harma* describes a mobile phone with a first camera and a second camera with a capturing direction of the second camera essentially different from the capturing direction of the first camera. *See* Exh. 1008, 1:26-28; 2001, ¶¶56-57, 64.

Harma explains that “[m]ore and more often mobile phones include a camera that enables capturing still pictures and video clips, as well as their use in video conferences. Exh. 1006, 1,4-5. *Harma* teaches that:

... when capturing still pictures or capturing video clips, the capturing direction of the camera points away from the user, whereas in a video conference, the capturing direction of the camera is towards the user. Moreover, a usage of this type sets many requirements for the camera provided in the mobile phone, for instance, it must be light in weight, small in size, economical in expenses, and it must have good picture quality.

Exh. 1006, 1:6-12. Furthermore, “the object of the [Harma] invention is a mobile phone that enables capturing still pictures and video clips, for instance, in a video

conference.” *Harma* only describes video clips in video conferencing, not real-time (*i.e.*, streaming) video; essentially, a live video is a continuous stream, whereas a video clip is a specific, extracted section of a previously made video. Exh. 2001, ¶¶59-60.

A POSITA would have understood that a “live video” is a broadcast happening in real-time or near real-time, where viewers see the content as it is recorded, while a “video clip” is a short segment taken from a longer video, which has already been recorded and may have been edited beforehand. Exh. 2001, ¶61.

The cameras of *Harma* have different capabilities. The first camera facing the user takes photographs with a short focal length. The image (still photograph) is then processed for possible pattern recognition; that image (still photograph) can then be combined with another image (still photograph) captured by the second camera with a longer focal point. *See* Exh. 1006, 6:20-23. *Harma* explains that the images are captured, and afterward, “the mobile phone can be moved and inclined, and the user’s image can still be shown in the split-screen image 10. Exh. 1008, 6:22-23. The image is a photograph that has already been processed and combined, allowing the camera to be moved without affecting the already captured photograph. Additionally, the “first camera has a first angle of view, which is essentially smaller than the second angle of view of the second camera. Thus, the first camera can be used for capturing the target, generally the user, close by, for example, the distance

of 20 cm, whereas the second camera produces a sharp image from a further distance.” Exh. 1006, 3:31-35. The further distance is “typically from about 50 – 300 cm.” Exh. 1006, 5:2-3; 2001, ¶62.

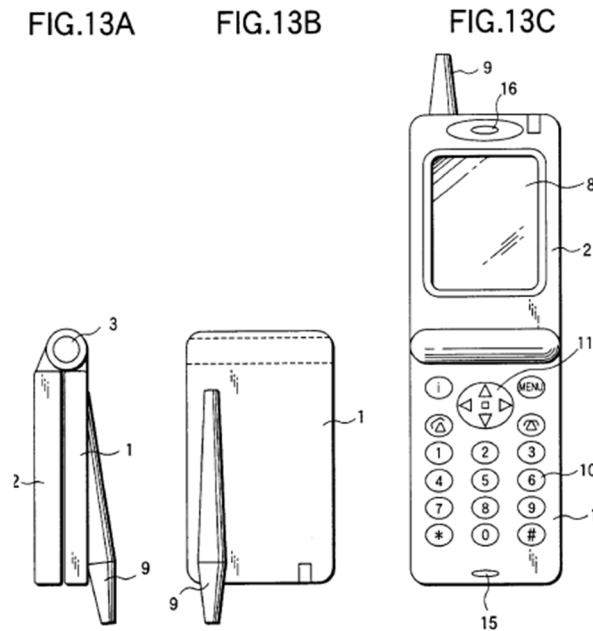
Nothing in *Harma* teaches capturing and transmitting, in real-time or near real-time, video images. Also, there exists no teachings of accessing the first input and the second input device at the same time. In *Harma*, a previously taken photograph is post-processed onto a video clip where the video clips are sent in a video conference. Video clips are portions of stored video, not real-time or near real-time video being transmitted. This also closely corresponds to what a POSITA would know around the time of *Harma*’s international filing date (October 25, 2000). See Exh. 2006, 1 (J-Phone released in November of 2000, transmitting only low-resolution still images). Exh. 2001, ¶63.

C. Nagasawa (Exh. 1007)

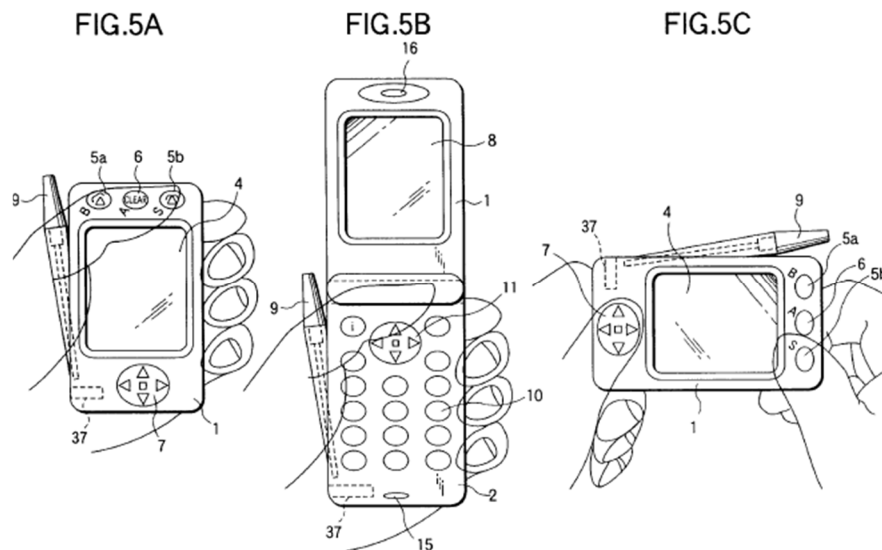
U.S. Patent No. 6,782,281 (“*Nagasawa*”) (Exh. 1007) was filed on November 3, 2000, and issued on August 24, 2004. Exh. 2001, ¶65. Patent Owner’s ’162 Provisional Patent Application filing date of October 25, 2000, predates the filing date of the *Nagasawa* patent of November 3, 2000. Exh. 2001, ¶69.

Nagasawa discloses an approach for a folding portable telephone apparatus with a first display and a second display on a first case body. See Exh. 1007, Abstract; 2001, ¶¶66-67. *Nagasawa* mentions a camera only once. The camera is

“a small-sized TV camera 53 [located] at the hinge” (Exh. 1007, 7:40; Fig. 12B) and not on the first case body. The hinge (3) is the thickest part of *Nagasawa*’s device, and the thinnest part is the first case body (1). *See* Exh. 1007, Figs 12A-B, 13A-C:



The purpose of the first screen is for the device to be used as a pocket game machine. *See* Exh. 1007, 4:54-60. Controls for limited call functionality and gaming are accessible when the device is closed, as shown in Figs. 5A-C:



Exh. 1007, Figs. 5A-C; 3:55-65. The first screen is not used when the device is open. Exh. 1007, 5:15-30; 2001, ¶68.

X. RESPONSE TO SPECIFIC IPR GROUNDS

In addition to the reasons outlined in Petitioner's Shortcoming section, Section III *supra*, the Board should deny the Petition because it fails to show a reasonable likelihood that the challenged claims are unpatentable. The *Okaya* reference alone or combined with knowledge of one skilled in the art, *Harma* reference combined with knowledge of one skilled in the art, and the combination of *Nagasawa* and *Harma* references as presented by Petitioner, fail to identify at least one, if not more, of the claim element of the '168 Patent, such as the cameras capable of capturing real-time or near real-time video in a housing as claimed in claims 18-21 of the '168 Patent.

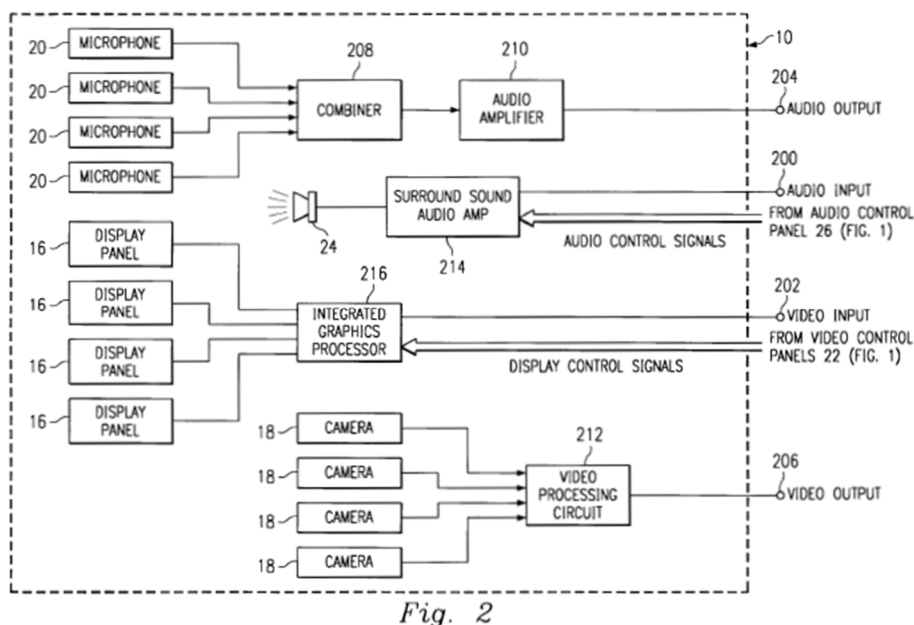
A. GROUND 1: Anticipation Based on *Okaya*

For the following reasons, Petitioner fails to meet its burden of proof in regard to the *Okaya* reference. *Okaya* (Exh. 1006) does not anticipate claims 18-21 because *Okaya* does not teach every element of claims 18-21, including at least elements 18[b], 18[c], 18[d], and 18[e]. Exh. 2001, ¶¶70-71.

The *Okaya* patent's carousel is not enabled. "Where a reference appears to not be enabling on its face, however, an applicant may successfully challenge the cited prior art for lack of enablement by argument without supporting evidence." *In re Morsa*, 713 F.3d 104, 110, (Fed. Cir. 2013); MPEP § 2121. The *Okaya* peripheral device is not enabled for the operation asserted in the Petition of changing views and combining people into a single display and other similar operations.

Okaya admits multiple times in the patent that a video conferencing system and multimedia application on a computer are "not shown." See Exh. 1006, 3:20-21, 3:24-25, 3:27-28, 33-35, 63-65. Petitioner relies on this unenabled functionality to disclose elements of the '168 claims. However, *Okaya* does not explain how the computer or videoconferencing system is accessed, where it is accessed from, or if any of the components in the *Okaya* carousel are used, *i.e.*, is the video processing of the carousel or computer/video conferencing system used for the display of split screens or processing the images displayed on the carousel?

This view is supported by Figure 2 of *Okaya* where no control signals are received from the computer/video conferencing system. The only control signals are from the controls on the carousel, which are rudimentary at best.



The only way a modified video (split screen, other image than from camera) can be displayed is if it is received that way at the carousel via the video input. Same with audio. The term “video processing circuit 212” only appears once in the specification (Exh. 1006, 3:22-25), and that simply states that the video signals are processed as necessary by the video processing circuit 212 and then made available at the video output terminal 206 to, e.g., a video conferencing system that is not shown. *See id.* As such, the *Okaya* reference does not enable the functionality relied on by the Petitioner.

1. Independent Claim 18 is Not Anticipated by *Okaya*

In order to show anticipation, Petitioner must show “that the four corners of a single, prior art document describe every element of the claimed invention.” *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). Moreover, the reference must also disclose those elements “arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

The specification of the '168 Patent explains that the communication service device of claim 18 overcomes the problems discussed in the background with known video conferencing systems. *See* Exh. 1001, 2:48-67. “FIG. 3 depicts a preferred embodiment of a hand-held two user computer device.” Exh. 1001, 4:61-63. The communication device of claim 18 is the device that must receive and present the video and audio data in a form for transmission over a network and receive the data in a form from the network. It is an integrated device that is able to function by communicating with a network. Exh. 2001, ¶72.

Okaya discloses a peripheral device that must be connected to a computer or video conferencing system - - it does not disclose a network-enabled device, nor does it disclose a single integrated device. Exh. 2001, ¶73.

a. 18[p] A communication service device operable with a communication network, comprising

The preamble 18[p] is limiting because claim elements are introduced, *i.e.*, “a communication network.” “If the claim preamble, when read in the context of the

entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)(citing *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951)). Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. *See, e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application “to gain an understanding of what the inventors actually invented and intended to encompass by the claim” as drafted without importing “‘extraneous’ limitations from the specification.”) The preamble introduces the device being operable with a communication network. That element is then used in the next element 18[a] “at least one user communication device configured to receive and transmit information over the communication network.” Exh. 1001, 22:34-36.

This claim element requires the communication service device to be operable with a communication network. While the device in *Okaya* is a multimedia carousel, the carousel has no connection to a network as shown in Fig. 2 above. *See* Exh. 1006, Fig. 2. The data input and output from the carousel is not in a format for communicating over a communication network. Claim 18 is for a communication

service device, not a system, such as a multimedia carousel device connected to a computer device. *See* Exh. 2001, ¶74. As the carousel device fails to disclose that it is operable with a communication network and must rely on other external devices, the asserted disclosed elements are neither present nor arranged as in claim 18.

A component (i.e., networking interface) for such networking is not shown or described in the specification. A mere reference to a separate system or device that is connected to the carousel that is not shown or enabled as having network communication capability also fails to meet this limitation. Thus, *Okaya* does not teach a communication service device operable with a communication network as required by the preamble.

**b. 18[a] at least one user communication device
configured to receive and transmit information over
the communication network**

The Federal Circuit's analysis of the meaning of the claim term “configured to” is considered to have the same meaning as “adapted to.” In three cases, the Federal Circuit has addressed the construction of the term “adapted to.” In each case, the Federal Circuit has noted that “... the phrase ‘adapted to’ is frequently used to mean ‘made to,’ ‘designed to,’ or ‘configured to,’ but it can also be used in a broader sense to mean ‘capable of’ or ‘suitable for’” *Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1349 (Fed. Cir. 2012); *see also In re Man Mach. Interface Tech. LLC*, 822 F.3d 1282, 1286-87 (Fed. Cir. 2016); *In re Giannelli*, 739

F.3d 1375, 1379-81 (Fed. Cir. 2014) (*quoting Aspex*, 673 F.3d at 1349). In so doing, the Federal Circuit acknowledges that “configured to” is narrower in scope than “capable of.” These findings were summed up in *SIPCO v. Amazon.com, Inc., et al.*, No. 2:08-CV-359, Dkt. No. 562, 2012 WL 5195942, slip op. at 91 (E.D. Tex. Oct. 19, 2012) (Gilstrap, J.) (construing “‘configured to’ to have its plain meaning, ‘which the Court understands to require not merely being capable of being configured but rather being actually configured.’”)

Claim element 18[a] requires the device to be “configured to” receive and transmit information over the communication network. *See* Exh. 1001, 22:34-36. When “configured to” language is used, it is not enough that a device may be capable of performing the claimed function; it must be specifically designed or adapted to perform that function. *Okaya*’s Carousel is not configured to communicate over the communication network. Exh. 2001, ¶75.

Figure 2 of *Okaya* identifies the input and output as audio output being separate from video output and video input being separate from audio input. The inputs and outputs are not configured for transmission over a network. *See* Exh. 1006, Fig. 2. There is no network communication that is part of the display device of *Okaya*. It is impossible for the carousel alone to communicate over a network because it has no network capability. It would have to be connected to another device

or entirely re-designed; hence it is not configured to receive and transmit information over a communication network. Exh. 2001, ¶76.

The Petition seems to erroneously assert a video conferencing system that is not shown in *Okaya*. See Exh. 1006, 3:19-21. Further, Petitioner reads into the *Okaya* reference a network-enabled device with the statement:

Okaya's carousel, either alone or integrated with a multimedia computer and/or video conferencing system, permits up to four users to simultaneously communicate with a remote vendor over a network.

Pet. 16 (*citing* Exh. 1006, Fig.2, 3:22-42, 3:56-4:14). *Okaya's* carousel is connected to a multimedia computer or video conferencing system, not “integrated with” or combined together. Exh. 2001, ¶77. Petitioner and its expert misinterpret *Okaya* as describing integration with a computer, rather than connected to a computer or video conferencing system. The only place the term “integrated” appears in the text of *Okaya* cited above in the Petition is for an “integrated graphics processor 216.”

The Petition asserts that “*Okaya's* carousel ***can be*** integrated with a multimedia computer and/or video conferencing system. See Pet. 16. This is insufficient. It does not disclose that the carousel itself is specifically made or adapted to receive or transmit information over the communication network. Nowhere in *Okaya* is such “integration” described or taught in the figures or specifications. *Okaya* does not disclose the integration of devices, as the carousel is

depicted in all the figures as a separate peripheral device connecting to a computer device (or videoconferencing device) that enables encoding/decoding audio and video data for transmission over a network. Exh. 2001, ¶78.

The Petition also asserts that a POSITA would have known to configure the I/O ports of Figure 2 to function with commercially available PCs. Pet. 18. No configuration for network communication is shown or described anywhere in Figure 2 of *Okaya*. No explanation of how the video and audio input and output data are encoded and decoded for transport over a network is provided in the Petition. See *Supra* IX.A; Exh. 2001, ¶79.

Okaya's device is a computer peripheral device that connects, like a monitor, to a computer/videoconferencing system and not a standalone device with network capability, as required in claim 18. Further, the Petition erroneously asserts that a video conferencing system and not a device encompasses all the elements of claim 18. Exh. 2001, ¶80. Therefore, *Okaya* patent fails to describe element 18[a] of the '168 Patent.

- c. **18[e] wherein the first and second input devices and first display devices are carried by the housing in an orientation to allow the at least one user to access the at least one first input device and first display device from the first side of the housing at the same time as the at least one second input device from the second side of the housing**

The controls of the *Okaya* carousel do not enable a user to switch between cameras, display split screens, or otherwise process different inputs. Voice-activated switching can occur in *Okaya*; the captured images show up from the switched camera in the other video conferencing system and not on a display of the carousel connected to the local computer/video conferencing system. No access by the first user of the first display device occurs. It is the other computer or videoconferencing system across the network that is accessing the display. The cameras are accessed from across the network, and the carousel display is accessed locally. It is across the network where the image shows up from the carousel's camera. *See* 1006, 3:38-42. The computer or video conferencing system performs that type of processing because of the additional hardware (*see* Exh. 1021; 1022) and power requirements to display real-time video. *See* Exh. 1021-22; 2001, ¶81.

Further, the Petitioner asserted no enablement of the split screen functionality. The only statement regarding a split screen is:

[I]mages captured [not video] by all of the cameras 18 could be simultaneously displayed in a “split screen” type of arrangement on the

vendor's display panel. Still further, even assuming voice-activated cameras are used, a sort of split screen format could still be used, with the current speaker's image taking up a larger area of the vendor's display screen than the images captured by the other cameras.

Exh. 1006, 4:9-15. The split screen discussed is not occurring on *Okaya*'s carousel, it is occurring on the vendor's display screen. There is no enablement for how, where, or when the split screen occurs other than it can occur and appear on the vendor's screen. Further, the explanation is of captured images, and not captured video, real-time video, or any other indication that the captured images are at the same time for the "split screen" of *Okaya*. This is especially true of bandwidth limitations that existed at the time of *Okaya*. Exh. 2001, ¶82.

Claim 18 claims a *device*, and the "access ... from" of claim element 18[e] occurs on that device. The access by at least one user of the first and second input device "at the same time" of element 18[e] does not occur on a different device (i.e., computer/videoconferencing system rather than the carousel). Exh. 2001, ¶83.

The *Okaya* carousel device describes a "display control panel 22 having several control buttons for controlling various aspects of the associated display panel 16." Exh. 1006, 4:58-60. None of the video controls for the *Okaya* carousel device are described as accessing other displays of the carousel. The controls are

specifically for the associated display panel, not other display panels or input devices of the carousel. Exh. 2001, ¶84.

The *Okaya* carousel device has an “audio control panel 26 including several buttons or knobs for controlling various qualities of the speaker audio output.” Exh. 1006, 4:62-64. None of these controls are for accessing input devices. Figure 2 of *Okaya* does not show any other control signals but displays control panel 22 and video control panel 26. Exh. 2001, ¶¶85-86.

The Petition asserts that “at least one user would utilize the video conference system to call up a remote participant.” Pet. 25. First, the Petitioner describes the device as the carousel device, then the device is described as the carousel device and a computer/video conference system. Then, the device is described as the carousel device, a first computer/video conference system, network, and second computer/video conference system where a user selects what is displayed on the remote (first computer/video conference system). The Petition started with a carousel and now is using two teleconferencing systems and the carousel as the device. Exh. 2001, ¶87. In contrast, claim 18 recites a single device, not a system. To anticipate claim 18, the single reference must disclose “each and every element of the claimed invention . . . arranged or combined in the same way as in the claim.” *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009).

This claim element 18[e] also requires “an orientation to allow the at least one user to access the at least one input device *from the first side of the housing* at the same time as the at least one second input device from the second side of the housing.” Exh. 1001, 22:47-52. The “access” has to be from the first side and not across a network on a second video conferencing system. Exh. 2001, ¶88.

If the “at least one user” of the claim element is two or more users, the claim still requires the user “access” to be from the first side of the housing (i.e., access is not from all sides) and not simply accessing the cameras and displays on the multimedia carousel at the same time as asserted by the Petitioner. *See* Pet. 25; 2001, ¶89.

The “access” of claim element 18[e] is clicking on the icon to start the interpreting session. Exh. 1001, 9:45-49. The icon is displayed on the first display device on the first side along with the first input device. Once started, the interpreting service uses the first input and second input devices along with the first display. Exh. 2001, ¶90.

The '162 Provisional Patent Application and the '168 Patent also mention webpages that a POSITA would understand are selected or provided (“accessed”) with additional information used by the interpreting session. *See* Exh. 1002, 12:14 (the provider computer provides a series of web pages that allow access to the interpreting system); 15:11-12 (present invention may be implemented on any

computer that has access to a network, *e.g.*, the World Wide Web); 15:21-22 (In one preferred embodiment, the provider computer provides one or a series of web pages that allows access to the interpreting system); 17:11-13 (In still other preferred embodiments, the user is provided with a pull-down menu that allows for users to choose from a variety of predefined menu options, wherein the options define the type of service request desired); and 23:3 (menu would provide a choice of icons); Exh. 1001, Abstract; 3:60-67; 2001, ¶91. “Access” is via the first side of the housing and not simply standing in front of a camera. Exh. 2001, ¶92.

The Petitioner’s two users “First Theory” appears to use a preferred embodiment for claim scope, “[t]he claim scope is presumed in this interpretation to include this preferred embodiment.” Pet. 26. The Petitioner admits that the claims were amended during prosecution, *id.*, and are improperly attempting to limit the claim to its previous form. Exh. 2001, ¶93.

Okaya does not disclose the “access” limitation of this claim element. The Petitioner also asserts that “(one member of *Okaya*’s product team ‘accesses’ all cameras 18 of the multimedia carousel 10 at the same time as viewing this local display 16 by operating the carousel...a) turn on/off the various cameras, (b) adjust the media unit to change the video being captured by the cameras, and/or (c) operate the video conferencing system and/or multimedia PC to call up the remote

participant, causing the transmission of all the camera feeds to the remote participant.” Pet. 30-31; 2001, ¶94.

However, none of the controls described on *Okaya*’s carousel provide such control. If such control exists, it is not found on the *Okaya* carousel device but in the local videoconferencing system or remote video conferencing system connected to the carousel. The claim element requires “have an orientation to allow the at least one user to access the at least one input device *from the first side of the housing* at the same time as the at least one second input device from the second side of the housing.” Exh. 1001, 22:47-52 (*emphasis added*); 2001, ¶95.

Further, Petitioner erroneously equates “access” to physically turning the carousel of *Okaya* to obtain access. If the carousel is turned, then the first side is no longer the first side. Further, it would make the claim limitation meaningless as the first and second input devices and first display device are carried by the housing in claim elements 18[b-e]. Hence, movement of the housing will move everything the housing is carrying. The side causing the movement is irrelevant. Finally, the claim recites “access” and not movement. There is no patent or prosecution history to support such an interpretation. Exh. 2002, ¶92. Claim 18[e] is therefore not described in *Okaya*. Exh. 2001, ¶96. Thus, *Okaya* reference does not describe all the elements of claim 18 and does not anticipate claim 18 of the ’168 Patent.

2. **Claim 19 – “The communication service device as claimed in claim 18, wherein the first side of the housing and the second side of the housing face mutually opposite directions.”**

Claim 19 is a dependent claim that incorporates all the elements of independent claim 18. As *Okaya* fails to teach or describe all of the elements of independent claim 18, *Okaya* also fails to teach or describe all the elements of dependent claim 19. Exh. 2001, ¶¶97. Thus, Claim 19 of the '168 Patent is not anticipated by *Okaya*.

3. **Claim 20 – “The communication services device as claimed in claim 18, wherein the first input device comprises a first camera, and where the second input device comprises a second camera.”**

Claim 20 is a dependent claim that incorporates all the elements of independent claim 18. As *Okaya* fails to teach or describe all of the elements of independent claim 18, *Okaya* also fails to teach or describe all the elements of dependent claim 20. Exh. 2001, ¶¶98. Thus, Claim 20 of the '168 Patent is not anticipated by *Okaya*.

4. **Claim 21 – “The communication services device as claimed in claim 19 includes, a second display device residing on the second side of the housing.”**

Claim 21 is a dependent claim that incorporates all the elements of dependent claim 19 and independent claim 18. *Okaya* fails to teach or describe all of the elements of independent claims 18 and 19, as well as all the elements of dependent claim 21. Exh. 2001, ¶¶99-100.

Claim 21 of the '168 Patent is not anticipated by *Okaya*. Thus, *Okaya* patent does not teach or describe all the claim elements of claims 18-21 of the '168 Patent, and the '168 Patent is not anticipated by *Okaya*.

B. GROUND 2: Obviousness Based on *Okaya*

For the following reasons, Petitioner failed to meet its burden of proof in regard to any motivation to combine, and such combination, if even possible, fails to disclose every element of claims 18-21, including elements 18[b], 18[c], 18[d], and 18[e]. Exh. 2001, ¶101.

1. No motivation to combine *Okaya's* carousel device with *Okaya's* computer device

Okaya's separate devices, such as a computer or video conferencing system, must be connected to the carousel device for it to operate. The devices are not combined into a single housing, but rather connected via video and audio connections, similar to connecting a computer to a monitor. Exh. 2001, ¶102.

A POSITA would not make such a combination because there would be no savings in size, as the displays still have to be part of a video conferencing system and sit on a table viewable by the videoconference participants. Exh. 2001, ¶103.

Further, it would be undesirable to combine *Okaya's* carousel with *Okaya's* computer into one device. Video and audio processing required a powerful computer in 2000, resulting in fans exhausting the generated heat at the table around which people are sitting. A POSITA would understand that noise from fans of

computers from that period would disrupt a conference or meeting. Furthermore, table space would be required for the combined carousel and computer, and additional space would also be needed for the keyboard and mouse. This is why videoconference systems would have display devices, such as the carousel, separate from the computer/videoconferencing system at the time of the Provisional Patent Application filing. Exh. 2001, ¶104.

Okaya states a “technical advantage achieved is that the multimedia carousel is much less expensive than other means for enabling the same function, such as LCD projectors.” Exh. 1006, 2:24-26. Making a unique device housing the computer and carousel would make the resulting device more expensive than separate devices, negating a motivation to combine the carousel and computer into a single device. Exh. 2001, ¶105.

There is no motivation to combine the teachings of *Okaya* with knowledge of a POSITA because 1) Petitioner is connecting the devices and not combining the devices, 2) if a combination were made, the device would be disruptive to a conference or meeting because of size, noise, and heat produced by the device, 3) the technical advantages of *Okaya* would not be met with such a combination, 4) there is no motivation found in the references or knowledge of a POSITA to combine the carousel with any other device, because only connecting (i.e., like with a monitor

to a computer) is described in *Okaya*. Even if such a combination were possible, as explained in Ground I, elements would still be missing.

2. Independent Claim 18 Is Not Obvious in View of *Okaya*

The combination of *Okaya*'s carousel with the computer/videoconferencing system does not render claim 18 obvious because all the claim elements are not found in the combination. Exh. 2001, ¶106.

a. 18[b] the at least one user communication device comprising a housing having a first side and a second side

The device operates with a communication network. The *Okaya* device is a multimedia carousel that has no connection to a network. *See* Exh. 1006, Fig. 2. The data input and output from the carousel is not in a format for communicating over a communication network. Claim 18 encompasses a communication service device, not a system, such as a multimedia carousel connected to a computer. Exh. 2001, ¶107.

Simply connecting the carousel via its audio and video input and output ports, as asserted in the Petition, fails to have one or more communication devices *having a housing, i.e., a single housing*, with a first side and a second side as required by claim element 18[b]. The carousel has a housing and the computer/videoconferencing system would have one or more housings. Exh. 2001, ¶108.

Element 18[b] is not obvious in view of *Okaya*.

- b. 18[c] at least one first input device and first display device configured to allow the at least one user to input and output visual information wherein the at least one first input device and first display device resides on the first side of the housing**

As explained for element 18[b], there is not a single housing as required by the claims. Exh. 2001, ¶109; *See supra* §X.B.2.a.

- c. 18[d] at least one second input device configured to input visual information wherein the at least one second input device resides on the second side of the housing**

As explained for elements 18[b] and 18[c], there is not a single housing as required by the claims. *See supra* §X.B.2.a.; Exh. 2001, ¶¶107-109.

- d. 18[e] wherein the first and second input devices and first display devices are carried by the housing in an orientation to allow the at least one user to access the at least one first input device and first display device from the first side of the housing at the same time as the at least one second input device from the second side of the housing**

As explained for elements 18[b], 18[c], and 18[d] there is not a single housing as required by the claims. *See supra* §X.B.2.a.; Exh. 2001, ¶¶107-10.

Further, the claim element “allow[s] the at least one user to access the at least one first input device and first display device from the first side of the housing is not taught or described by the combined devices in *Okaya*. Exh. 2001, ¶112.

The “access” of claim element 18[e] is clicking on the icon to start the interpreting session. Exh. 1001, 9:45-49. The icon is displayed, for example, on the first display device on the first side, along with the first input device. Once started, the interpreting service uses the first input and second input devices along with the first display. Exh. 2001, ¶113.

The '162 Provisional Patent Application and the '168 Patent also mention webpages that a POSITA would understand are selected or provided (“accessed”) with additional information used by the interpreting session. *See* Exh. 1002, 12:14 (the provider computer provides a series of web pages that allow access to the interpreting system); 15:11-12 (present invention may be implemented on any computer that has access to a network, *e.g.*, the World Wide Web); 15:21-22 (In one preferred embodiment, the provider computer provides one or a series of web pages that allows access to the interpreting system); 17:11-13 (In still other preferred embodiments, the user is provided with a pull-down menu that allows for users to choose from a variety of predefined menu options, wherein the options define the type of service request desired); and 23:3 (menu would provide a choice of icons); Exh. 1001, Abstract; 3:60-67; 2001, ¶114.

Okaya does not disclose all of the elements of claim 18 in the combined devices of the *Okaya* reference. Exh. 2001, ¶115. Thus, Claim 18 is not obvious in view of *Okaya*.

3. Claim 19 – “The communication service device as claimed in claim 18, wherein the first side of the housing and the second side of the housing face mutually opposite directions.”

Claim 19 is a dependent claim and incorporates all the elements of independent claim 18. Exh. 2001, ¶116. As with independent claim 18, claim 19 requires a single housing, not devices connected by cables as asserted by Petitioner in the Petition. *See supra* §X.B.2.a-d.; Exh. 2001, ¶¶107, 117. All the elements of independent claim 18 are not disclosed in the combined devices of the *Okaya* reference. Exh. 2001, ¶119; *See supra* §VI.B.2.a. Hence, *Okaya* does not disclose all of the elements of claim 19 in the combined devices of the *Okaya* reference. Exh. 2001, ¶118. All the elements of independent claim 18 are not disclosed in the combined devices of the *Okaya* reference. Exh. 2001, ¶119; *See supra* §X.B.2.a-d.

4. Claim 20 – “The communication services device as claimed in claim 18, wherein the first input device comprises a first camera, and where the second input device comprises a second camera.”

Claim 20 is a dependent claim and incorporates all the elements of independent claim 18. Exh. 2001, ¶120. All the elements of independent claim 18 are not disclosed in the combined devices of the *Okaya* reference. *See Exh. 2001*, ¶¶107-114. All of the elements of claim 20 are not disclosed in the combined devices disclosed in the *Okaya* reference. Exh. 2001, ¶121. Claim 20 of the '168 Patent is not obvious in view of *Okaya*.

5. Claim 21 – “The communication services device as claimed in claim 19 includes, a second display device residing on the second side of the housing.”

Claim 21 is a dependent claim and incorporates all the elements of independent claims 18 and 19. Exh. 2001, ¶122. All the elements of independent claim 18 and dependent 19 are not disclosed in the combined devices of the *Okaya* reference. *See supra* §X.B.2-3; §B.2-3.; Exh. 2001, ¶¶107-115, ¶123. Therefore, all of the elements of claim 21 are not disclosed in the combined devices disclosed in the *Okaya* reference. Exh. 2001, ¶124.

Claims 18-20 are not obvious in the combined devices of the *Okaya* reference because there is no motivation to combine such devices, and if combined as described by Petitioner, there is not a single housing as required by the claims of the '168 Patent. Exh. 2001, ¶125. Petitioner failed to establish a *prima facie* showing of obviousness.

C. GROUND 3: Obviousness Based on *Harma*

For the following reasons, Petitioner failed to meet its burden of proof in regard to any motivation to combine *Harma*'s systems and in regard to the *Harma* reference teaching all of the claimed elements, including at least 18[a] 18[d], and 18[e].

1. Independent Claim 18 Is Not Obvious in View of *Harma*

The *Harma* reference does not render claim 18 obvious because all the claim elements are not found in the single reference in view of the knowledge of a

POSITA. As previously explained, *Harma* does not send real-time information, *Harma* teaches only still photographs and VIDEO CLIPs being sent. *See* §V.B; Exh. 2001, ¶126. Any assertion that *Harma* uses real-time video for video conferencing uses improper hindsight.

The '168 Patent allows for near real-time video, so a POSITA would know some buffering would be allowed. However, the video transmitted and displayed to remote users would be without perceived delay between the events as they occur and the events depicted in the video. Exh. 2001, ¶127.

Harma only discloses video clips and pictures, not real-time data, nor displays events as they occur at or nearly at the time the events happen. A POSITA would know a picture is an event frozen in time. A POSITA would also know that a video clip is a portion of a stored video. It is a clip or a segment from a larger video. It is not in real-time or near real-time. Exh. 2001, ¶128.

The reason for *Harma* specifically limiting its transmission to pictures and video clips (even for video conferencing) is consistent with what was known by a POSITA at the time. Data transmission over a cellular network was limited. Cellular telephones were just beginning to transmit pictures. *See* §V.B; Exh. 2001, ¶129.

A POSITA would also know and understand that limiting transmission to video clips and still photographs would be desirable because less transmission bandwidth would be required. Exh. 2001, ¶130. *Harma* avoids using special

hardware and approaches to implement real-time audio and video transmission and reception, as demonstrated by Exh. 1021 and 1022. Economic considerations are part of *Harma*'s requirements. Exh. 1006, 2:10-12 ("many requirements for the camera provided in the mobile phone; for instance, it must be light in weight, small in size, economical in expenses, and it must have a good picture quality.") Limiting weight, size, and expense are all requirements. A POSITA would understand that hardware to support real-time video cameras would add weight and cost to *Harma*'s mobile phone to support good picture quality. Further, a POSITA would understand that such hardware would be too large and take too much battery power to fit and operate in a cellular phone at that time. For all of the above reasons, there would be no motivation to combine *Harma* with the knowledge of a POSITA.

a. 18[a] at least one user communication device configured to receive and transmit information over the communication network.

As explained above, the information received and transmitted in *Harma* is limited to still photographs and video clips, even during video conferencing. See Exh. 2001, ¶¶59-62. The '168 Patent requires real-time or near real-time information to be received and transmitted over the network. Video clips of a person signing or a person talking would miss important information that would prevent a translation from occurring, as disclosed in the '168 Patent. A POSITA knows of only low-resolution still photographs being able to be sent from a cellular phone, as

described in *Harma*. See Exh. 2003. Thus, *Harma*, along with the knowledge of a POSITA, does not teach or describe this element of claim 18. Exh. 2001, ¶¶131-132.

- b. 18[d] at least one second input device configured to input visual information wherein the at least one second input device resides on the second side of the housing**

The second input device in *Harma* is limited to video clips and photographs. It does not capture and communicate visual information that is real-time or near real-time. See *supra* §IX.B; Exh. 2001, ¶¶59-62, 133.

- c. 18[e] wherein the first and second input devices and first display devices are carried by the housing in an orientation to allow the at least one user to access the at least one first input device and first display device from the first side of the housing at the same time as the at least one second input device from the second side of the housing.**

Harma is not accessing the first input device and first display device at the same time as the at least one second input device from the second side of the housing. *Harma* captures a still photograph (after which the camera can move) and then processes that photograph and combines it with another image. See Exh. 1008, 6:22-23. The cameras and display are not accessed simultaneously as required by element 18[e]. Exh. 2001, ¶62.

Harma, along with the knowledge of a POSITA does not teach or describe this element of claim 18. Exh. 2001, ¶134. Claim 18 of the '168 Patent is not

obvious in view of *Harma*, because *Harma* is limited to transmission of still photographs and video clips, and a POSITA would understand that still photographs and video clips are not real-time or near real-time video.

2. Claim 19 – “The communication service device as claimed in claim 18, wherein the first side of the housing and the second side of the housing face mutually opposite directions.”

Claim 19 is a dependent claim and incorporates all the elements of independent claim 18. Exh. 2001, ¶135. *Harma* does not disclose all of the elements of independent claim 18. See §VI.C.1; Exh. 2001, ¶¶126-134, 136. *Harma*, along with the knowledge of a POSITA does not teach or describe this element of claim 19. Exh. 2001, ¶137. Claim 19 of the '168 Patent is not obvious in view of *Harma* because all elements are not taught or described.

3. Claim 20 – “The communication services device as claimed in claim 18, wherein the first input device comprises a first camera, and where the second input device comprises a second camera.”

Claim 20 is a dependent claim and incorporates all the elements of independent claim 18. Exh. 2001, ¶138. All the elements of independent claim 18 are not disclosed in the *Harma* reference. See *supra* §X.C.1; Exh. 2001, ¶¶126-134, 139. *Harma*, along with the knowledge of a POSITA does not teach or describe this element of claim 20. Exh. 2001, ¶140.

Harma fails to teach or describe all the elements of claim 20 of the '168 Patent, and claim 20 is not obvious in view of *Harma*. Petitioner failed to establish a *prima facie* showing of obviousness. None of the claims 18-20 are obvious in view of *Harma* as at least one of the claim limitations is not taught or described by the single reference along with knowledge of a POSITA. Further, Petitioner did not include claim 21 in Ground 3.

D. GROUND 4: Obviousness Based on *Nagasawa* and *Harma*

For the following reasons, Petitioner failed to meet its burden of proof with regards to any motivation to combine *Nagasawa* in view of *Harma*, and with regards to the combination teaching all of the claimed elements, including at least elements 18[c] and 18[d].

1. No Motivation to Combine

Petitioner provides no motivation to combine *Nagasawa* and *Harma*. Exh. 2001, ¶141. The *Nagasawa* patent covers a foldable phone that has a screen on the outside that enables the phone to act as “a pocket game machine” with buttons for user control beside the screen. *See* Exh. 1007, Abstract; 2001, ¶142. The *Nagasawa* patent only discloses one camera 53 and a third display 51 for use in video conferencing:

Video conference display may be provided where the photo sticker 51 is to be affixed in order to provide a folding portable apparatus equipped with a small-sized TV camera 53 at the hinge.

Exh. 1007, 7:37-40; Fig. 12B. *Nagasawa* describes a phone with three screens: 4, 51, and 52, along with camera 53. The use of *Nagasawa* for video conferencing is shown to be used when the phone is in an open position in Fig. 12B. The term “camera,” element 53, only appears once in the *Nagasawa* patent and it is not on the housing; instead it is located on a hinge. Exh. 2001, ¶143.

There is no suggestion in the *Nagasawa* patent for 1) having a second camera (or a second camera accessible by the user simultaneously with the first camera access), and 2) if a second camera is desired, that it would be placed on the second side opposite from the first camera. Exh. 2001, ¶144.

Figure 3B of the *Nagasawa* patent depicts the controls used with the “pocket game.” A person using the pocket game would cover any camera placed on the outer surface of the first case body. Any camera placed in such a position would be abused with dirt and oil from a game player’s hand. Exh. 2001, ¶145.

The Petition asserts that “the POSITA would have been motivated to implement the two cameras facing different directions, taught by *Harma*, in the base system of *Nagasawa* to obtain the enhanced two-camera features described by

Harma.” However, the petition provides no information on what those features are and why they would motivate the combination. Exh. 2001, ¶146.

A statement is made that “the benefits of filming both the user and the surroundings and would have allowed the display of a split-screen image containing the captures from both cameras.” Pet. 56. However, what is described is what a second camera would capture, not how having that additional information is a benefit. Exh. 2001, ¶147.

The ability to display split-screen images is not dependent upon having a second camera in the *Nagasawa* phone. As images are received from camera 53 of *Nagasawa*, and an image is received from the person whose image is appearing on display 51. So, the ability to have a split screen is not dependent upon an additional camera. Exh. 2001, ¶148.

As camera 53 in *Nagasawa* is on the hinge, it would not be desirable to have a camera placed on the housing that is not fixed in the same plane as a camera placed in the upper outer housing. Petitioner asserts that a POSITA would be aware of dual cameras in a flip phone, citing Exh. 1019. The cameras in Exh. 1019 are depicted in Figures 1 and 2 to be on opposite sides of the same plane. A POSITA would not be aware of mounting one camera on the hinge of a flip phone and then mounting a second camera in a position in a separate plane. Exh. 2001, ¶149.

Further, placing a camera in the middle of the one on the side facing the user and placing a camera on the opposite side at the top of the phone would be undesirable as a slight movement of the center camera results in a greater movement of the other camera. Exh. 2001, ¶150.

The use of the “pocket game” would adversely affect the clarity of the additional camera’s images, and the offset location of one camera from the other would adversely affect the usefulness of the second camera. These drawbacks would limit the successful addition of the second camera. Exh. 2001, ¶151.

Petitioner ignores that camera 53 is placed on the hinge in *Nagasawa* and Figs. 1a-1b (*annotated*), *see* Pet. 59, and removes that camera, then places camera 4 above the hinge and camera 7 on the upper right position of the open flip phone. So, Petitioner is asserting that the motivation to combine requires the removal of camera 53 and replacing that one camera with two more. This is not combining but re-engineering *Nagasawa*. Similarly, The Petitioner’s configuration results in the problem with a camera in the middle of one side of the phone and the other camera at the top of the other side of the phone. *See* Exh. 2001, ¶¶150, 152.

The phone device of *Nagasawa* is intentionally designed so the only elements found on the outside of the closed phone are elements used for gameplay. *See* Exh. 1007, Figs. 1B, 3B, 5B, and 11B. Thus, it would be obvious to a POSITA that the

purpose of the *Nagasawa* phone is to provide gameplay when in a closed position. Exh. 1007, Fig. 5B; 2001, ¶153.

In Figure 3A, case body 1 is shown to be smaller than case body 2. The display 4 requires the majority of area on the outer surface of the case body 1. The remaining space is occupied by button pad 7. There is little, if any, room left on the outside of case body 1 for a camera in the *Nagasawa* device. Further, hinge 3 in Figure 3A is shown to have a greater thickness than either case body 1 or case body 2, demonstrating to a POSITA that the space constraints require the camera to be placed in the hinge. A POSITA would recognize that attempting to add a camera on each side of case body 1, if even possible, would result in case body 1 being of greater size. Petitioner's own reference used to show knowledge of a POSITA, Exh. 1019 demonstrates this. A POSITA would also understand that a thicker phone is less desirable as it would be uncomfortable to hold and carry. Exh. 2001, ¶154.

Nagasawa describes, “[u]nfolding the first case body 1 causes controller mentioned later to display text and graphics information on the second display 8 on the inner surface of the first case body. In the meantime, the first display 4 maintains the state assumed before the main body 1 was unfolded upward.” Exh. 1007, 4:13-16. When the phone is open, the first display is no longer used, and all functionality for the phone is oriented on the inner surface. There is no motivation to place a camera on the side with the first display because when the phone is open, it would

only function, at most, as *Harma* functions, with two cameras and one active screen. *Nagasawa* only has one screen functioning at a time. This is opposed to having a second screen as depicted in figure 6 of the '168 Patent and claim 21 that can function simultaneously. Exh. 2001, ¶155.

Further, *Harma*'s camera has a focal length of 50 to 300 cm, see Exh. 1006, 5:2-3, resulting in the person having to be 50-300 cm from the display on the outside of *Nagasawa*. The screen would be useless because the user would not be able to effectively use the display from a distance of 300 cm away. Exh. 2001, ¶156.

The Petitioner admits that a configuration with screens on both sides and cameras on both sides “would have had obvious marketing and commercial benefits.” Pet. 56. If there is such marketing and commercial demand, it is the Patent Owner who came up with the solution as claimed in the '168 Patent, and the statement demonstrates the value and unmet need for the device of the '168 Patent. Exh. 2001, ¶157.

The Petitioner failed to meet its burden to establish that there is a motivation to combine *Nagasawa* and *Harma* references. Even if such a combination is possible, at least one claim element would still be missing. Exh. 2001, ¶158. It is also impossible to place cameras on the thinnest part of *Nagasawa*'s device, as the camera in *Nagasawa* is on the thickest part (i.e., the hinge) as well as the other reasons identified above.

Furthermore, *Harma* priority date is after the filing date of the '162 Provisional Patent Application. Similarly, *Nagasawa*'s priority date of November 3, 2000, is after the priority date of the '162 provisional patent application. There also can be no motivation to combine *Nagasawa* with *Harma* because both *Nagasawa* and *Harma* are not prior art to the '162 Provisional Patent Application. Exh. 2001, ¶159.

2. Independent Claim 18 is Not Obvious with *Nagasawa* in View of *Harma*

- a. [18c]: “at least one first input device and first display device configured to allow the at least one user to input and output visual information wherein the at least one first input device and first display device resides on the first side of the housing”**

The camera on the first side of the *Nagasawa* phone is located on a hinge and not the housing. Exh. 1007, Fig. 12B. Petitioner asserts that there was no reason for *Nagasawa* to place the camera in the hinge, and it can be moved and placed on one side of the housing. See Pet. 60. The Ground is *Nagasawa* in view of *Harma*, Pet. 50, but the argument is switching between that combination and *Harma* in view of *Nagasawa*, with the teachings of *Nagasawa* being disregarded. Exh. 2001, ¶160.

The Petitioner's logic is that *Harma* has two cameras; it would be obvious to remove *Nagasawa*'s camera and place *Harma*'s cameras anywhere in *Nagasawa*. See Pet. 60. Such an approach fails to acknowledge that there is a reason for the inventors of *Nagasawa* to place the camera on the hinge. Since *Nagasawa* has

demonstrated in the figures that the camera is located in the widest portion of the phone, the camera cannot be placed anywhere other than the hinge and not on the thinnest part of the phone (first case body (1)). *See supra* §X.D.1; Exh. 2001, ¶¶150, 161.

Further, placing a camera on the second side of the housing would add an element that is not related to gaming (display and controllers) on the “outer surface of the first case body (1).” *See* Exh. 1007, Abstract. *Nagasawa* only places items related to gameplay on the second side of the housing. Exh. 2001, ¶162.

A camera cannot be placed on one side of the first case body of *Nagasawa* because there is no room, let alone on both sides and only items related to gameplay are located on the second side of the housing. Exh. 2001, ¶163.

Nagasawa in view of *Harma* does not render claim element 18(c) obvious as the combination fails to establish that *Nagasawa* can carry two cameras (as the camera of *Nagasawa* is removed) on the thinnest part of *Nagasawa*, i.e., the first case body. Even if only one camera is placed on the first case body and the other is left on the hinge of *Nagasawa*, that would not have the two cases on the same housing (i.e., the first case body).

Using the cameras of *Harma* while removing the camera of *Nagasawa* requires using the teachings of *Harma* on how to use the cameras. *Harma* teaches using the camera for video clips and still photographs. Even if a camera could fit on

the thinnest part of the *Nagasawa* device, which it cannot, the resulting use of that camera would be for video clips and still photographs, not for visual information as element [18c] requires.

- b. **[18e]: “wherein the first and second input devices and first display devices are carried by the housing in an orientation to allow the at least user to access the at least one first input device and first display device from the first side of the housing at the same time as the at least one second input device from the second side of the housing”**

As previously stated, a camera could not be placed on one side of the first case body of *Nagasawa*, let alone on both sides. See Exh. 2001, ¶¶153-154, 164. Petitioner is erroneously adding a second input device, i.e., a second camera, that the petition asserts can fit on the first case body in addition to the first camera that cannot fit. There is a reason the camera in the *Nagasawa* is placed in the thickest part of the cellular phone. The Petitioner and their expert simply assert that a camera will fit, but provide no evidence of how small a camera can be to support real-time or nearly real-time video, no evidence on if there is enough power to support a second camera, no evidence if there is enough memory to support two cameras, and if the memory usage of cameras would impact game playing (as that is the focus of *Nagasawa*). It is the Petitioner’s burden to establish such evidence, not the Patent Owner.

If the camera from *Harma* was placed on the one side of the first case body of *Nagasawa*, it would be a camera that is for still photographs or to record video clips. See Exh. 2001, ¶¶57-60. The camera is not for real-time or near real-time video information. The cameras and display in *Harma* are also not accessed at the same time. See *supra* X.C.1.c.; Exh. 2001, ¶62. Further, there is no information as to how much additional power additional cameras would require, the size of *Harma*'s cameras compared to *Nagasawa*. The amount of additional memory that would be required by having a second camera, and how using extra memory for cameras would affect the memory for game playing, as that is the focus of *Nagasawa*. Exh. 2001, ¶165.

The combination of *Nagasawa* in view of *Harma* fails to teach all of the elements of claim 18 because the camera of *Nagasawa* cannot be moved from the hinge, and if it is possible to place a camera on the outside of the first case body it would not be on the same housing as the camera on the hinge. Exh. 2001, ¶166. The housing in claim 18 of the '168 Patent carries the displays and cameras. If the display would extend across the top portion, hinge, and bottom portion, then all of the communication device would be considered a single housing. In *Nagasawa*, only the top portion carries the displays in one housing, and the hinge carries one of the cameras in another housing, regardless of the placement of a fictional camera.

3. Claim 19 – “The communication service device as claimed in claim 18, wherein the first side of the housing and the second side of the housing face mutually opposite directions”

Claim 19 is a dependent claim and incorporates all the elements of independent claim 18. *See* Exh. 2001, ¶¶160-167.

In Figures 2A and 4A of *Nagasawa*, the open phone does not reside in a plane. The hinge faces in one direction, and if a camera can be placed on the outside of the first case body, the camera does not face in a mutually opposite direction. Exh. 2001, ¶168.

Nagasawa, in view of *Harma*, fails to teach all the elements of claim 19 of the '168 Patent. Exh. 2001, ¶169.

4. Claim 20 – “The communication services device as claimed in claim 18, wherein the first input device comprises a first camera, and where the second input device comprises a second camera”

Claim 20 is a dependent claim and incorporates all the elements of independent claim 18. Exh. 2001, ¶170.

If the camera from *Harma* was placed on the one side of the first case body of *Nagasawa*, it would be a camera that is for still photographs or to record video clips. *See* Exh. 2001, ¶¶57-60. The camera is not for real-time or near real-time video information. Exh. 2001, ¶171.

Nagasawa, in view of *Harma*, fails to teach all the elements of this claim. *See* Exh. 2001, ¶¶160-166, 172.

5. Claim 21 – “The communication services device as claimed in claim 19 includes, a second display device residing on the second side of the housing”

Claim 21 is a dependent claim incorporating all the elements of independent claims 18 and 19. Exh. 2001, ¶¶160-169, 173. *Nagasawa*, in view of *Harma*, fails to teach all the elements of this claim. Exh. 2001, ¶174. Petitioner failed to establish a *prima facie* showing of obviousness. Claims 18-21 are not obvious in view of *Nagasawa* and *Harma*, as presented in Ground 4, because there is no motivation to combine the references, all of the claim elements are not found in the combination, and *Harma* and *Nagasawa* are not prior art. Exh. 2001, ¶175.

The Petitioner failed to meet its burden and establish that it would prevail as to any of the four asserted claims. Further, *Nagasawa* and *Harma* do not predate the priority date of the Provisional Patent Application.

XI. SECONDARY CONSIDERATIONS

As the Petitioner failed to meet its burden of establishing a *prima facie* case for any of the claims of the '168 Patent, much less to identify a motivation to modify *Okaya* in Ground 2, *Harma* in Ground 3, or *Nagasawa* in view of *Harma* in Ground 4, Patent Owner reserves the right to address secondary considerations, if needed, later in these proceedings.

XII. DENIAL OF INSTITUTION IS APPROPRIATE

Denial of the institution is appropriate because the Petitioner failed to meet their burden and establish that they are more likely than not to succeed in any of the claims in any of the Grounds would be found anticipated or obvious. Further, “the decision whether to institute an inter partes review is discretionary.” *Unified Patents Inc. v. C-Cation Techs., LLC*, IPR2015-01045, Paper 15 at 3 (PTAB Oct. 7, 2015) (citing 37 C.F.R. § 42.108 (a)). Denial of institution (Discretionary or otherwise) appropriate in this case for the following reasons:

1. It is unlikely that the Petitioner will prevail and show any claims are invalid under Grounds 1-4 of the Petition.
2. Only four claims are asserted out of 21 claims that exist in the '168 Patent. The majority of the claims in the patent will not be affected by this *inter partes* review.
3. This patent has expired, and the Patent Owner will be irreparably harmed if one or more claims survive this *inter partes* review and after an 18-month IPR delay, the “stayed” litigation is restarted and takes another 18 months.
4. Judge Albright of the W.D. of Texas has been assigned the case during the stay. *See* Exh. 2004. As Judge Albright’s desire to bring cases to trial within 18 months, a Decision regarding the four claims at issue in

this *inter partes* review will take only a few months more than the *inter partes* review.

5. Due to the change in administration and the back-to-office executive order (signed January 20, 2025) and hiring freeze executive order (signed January 20, 2025), the USPTO's Patent and Trademark Appeal Board's (PTAB) Administrative Judges staffing may have issues over the next 18 months. This case is not a good use of judicial resources because of (a) only four claims are at issue; (b) the patent term has expired; (c) more likely than not, one or more claims will survive the *inter partes* review; (d) Patent Owner is harmed by delays added to reaching a conclusion of the litigation by the *inter partes* review; and (e) Judge Albright has a reputation as being able to resolve patent cases in approximately 18 months, which would only be a few months after this *inter partes* review could be resolved.

For these reasons, in addition to other discretionary issues identified in the Patent Owner's Provisional Response, this *inter partes* review should not be instituted.

Congress specifically contemplated that regulations implementing IPRs might include "a safety valve that allows the Office to decline to institute further

proceedings if a high volume of pending proceedings threatens the Office’s ability to timely complete all proceedings.” *157 Cong. Rec.* S1377 (daily ed. Mar. 8, 2011).

Even if the Board found one Ground met the reasonable likelihood of showing unpatentability threshold with respect to a few claims, which the Patent Owner does not believe to be true, it still can deny institution because the benefits of holding a trial “would be overwhelmed by the burden of addressing the challenges having no reasonable likelihood.” *Biofrontera Inc. v. DUSA Pharms., Inc.*, IPR2018-01585, Paper 10 (P.T.A.B. Feb. 26, 2019).

CONCLUSION

Petitioner Samsung failed to establish that claims 18-21 are anticipated or rendered obvious by any combination of the asserted prior art references, where elements are missing, and Petitioner has established no motivation to combine references. Therefore, institution by the Board of *inter partes* review is not appropriate. Thus, the Board should deny the Petition.

Respectfully submitted,

February 21, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies the service of Patent Owner KP Innovations 2, LLC, served this Patent Owner's Preliminary Response on the counsel of record for Petitioner Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. by filing this document through the P-TACTS, as well as delivering a copy via electronic mail to the following:

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CERTIFICATE OF COMPLIANCE

This Petition complies with the type-volume limitations as mandated in 37 C.F.R. § 42.24, totaling 13,938 words. Counsel has relied upon the word count feature provided in Microsoft® Word for Windows, version 2501.

Dated: February 21, 2025

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