

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

MOBILE DATA TECHNOLOGIES LLC,

Patent Owner

IPR2025-00538
U.S. Patent No. 8,825,801

PATENT OWNER'S PRELIMINARY RESPONSE

35 U.S.C. § 313, and 37 C.F.R. § 42.107(a)

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EXHIBIT LIST

Ex.	Description
2001	E-mail serving amended infringement contentions in EDTX-Litigation
2002	Comparison between the specifications of the '039 and '801 Patents
2003	Petition for <i>Inter Partes</i> Review in IPR2025-00537 (Feb. 3, 2025)
2004	Reserved
2005	Return of Service filed in the EDTX-Litigation (June 21, 2024)
2006	E-mail from the Board regarding the 537 and 538 IPR panel assignments (May 2, 2025)
2007	Decision Granting Institution of Inter Partes Review in IPR2024-00247 (June 11, 2024)
2008	E-mail from Erick S. Robinson memorializing the phone conversation with Petitioners' counsel (September 26, 2024)
2009	Reserved
2010	Reserved
2011	Reserved
2012	Reserved
2013	E-mail exchange between Erick S. Robinson and Petitioners' counsel regarding a stay (October 17, 2024)
2014	E-mail exchange between Erick S. Robinson and Petitioners' counsel regarding a stay (February 19, 2025)
2015	E-mail exchange between Erick S. Robinson and Petitioners' counsel wherein Petitioners shared their motion to stay with Patent Owner (March 4, 2025)
2016	Second Amended Docket Control Order in the EDTX-Litigation (December 19, 2024)
2017	United States District Courts — National Judicial Caseload Profile (March 31, 2025)
2018	E-mail from Petitioners' counsel serving their initial and additional disclosures (October 16, 2024)
2019	E-mail from Petitioners' counsel serving their invalidity contentions (January 31, 2025)
2020	E-mail from Petitioners providing materials produced by third-party Microsoft Corporation and Sybase, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (April 25, 2025)
2021	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (March 7, 2025)

Ex.	Description
2022	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 24, 2025)
2023	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 21, 2025)
2024	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 11, 2025)
2025	E-mail from Petitioners providing materials produced by third-party AT&T Mobility LLC in response to Petitioners' subpoena in the EDTX-Litigation (February 5, 2025)
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2027	Petitioners' Invalidity Contentions in the EDTX-Litigation (January 31, 2025)
2028	E-mail exchange between Homayoon Rafatijo and Petitioners' counsel regarding Petitioners' contacting the Board for filing their proposed <i>Sotera</i> stipulation (April 21-23, 2025)
2029	E-mail from Petitioners' counsel with a draft of a proposed communication to the Board (April 30, 2025)
2030	E-mail from Petitioners' counsel sharing with Patent Owner their proposed <i>Sotera</i> stipulation (April 21, 2025)
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2032	Petitioners' proposed <i>Sotera</i> stipulation for '537 and '538 IPRs (April 21, 2025)
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2036	E-Mail from Petitioners providing Casio America, Inc.'s declarations certifying business records in response to Petitioners' subpoena in the EDTX-Litigation (May 9, 2025)
2037	Joel West & David Wood, <i>EVOLVING AN OPEN ECOSYSTEM: THE RISE AND FALL OF THE SYMBIAN PLATFORM</i> (2013)

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2038	Bradston Henry, <i>Multiplayer Server Basics Creating a Multiplayer Game Server - Part 1</i> (Oct. 25, 2021), https://dev.to/ibmdeveloper/multiplayer-server-basics-ep-1-creating-a-multiplayer-game-server-5aed
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2047	Declaration of Kevin Jakel in IPR2021-00917 (May 11, 2021)
2048	Petition for Inter Partes Review in IPR2024-00247 (Dec. 6, 2023)
2049	Declaration of Mahdi Eslamimehr for IPR2025-00538 of U.S. Patent No. 8,825,801

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107(a), Mobile Data Technologies, LLC (“Patent Owner” or “MDT”) submits this Preliminary Response to the Petition for *Inter Partes* Review (“IPR”) of U.S. Patent No. 8,825,801 (the “’801 Patent”), filed by Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioners”), challenging claims 1, 7-12, and 14-25 (the “Challenged Claims”) of the ’801 Patent. Paper 4, 2 (“’538 IPR Petition” or “Petition”). Institution should be denied because Petitioners fail to meet their burden to show a reasonable likelihood they would prevail with respect to at least one claim challenged in the Petition.

I. INTRODUCTION

A. Summary

Petitioners present improper combinations, mixing distinct embodiments without acknowledgment and arguing motivations that are illogical. Petitioners also fail to identify teachings in the cited art that correspond to explicit claim limitations, including “information associated with [a] wireless networking functionality.” Notably, when addressing the “information associated with [a] wireless networking functionality” for both Grounds, their expert acknowledges the failure of references relied upon in each Ground to disclose relevant teachings—encapsulation of certain information according to GSM-SMS and WAP protocols. Moreover, Petitioners fail to differentiate two distinct claim terms, namely “integrating” and “inserting.”

Putting aside Petitioners and their expert going beyond the references identified in each Ground, there is no support for the encapsulation of the specific information relied on by them as being encapsulated. These are each independent reasons for why an IPR trial should not be instituted.

Furthermore, Petitioners have failed to provide a reasoned analysis of how and why a person of ordinary skill in the art (“POSITA”) would combine the prior art for at least two distinct reasons. First, Petitioners have failed to provide a reasoned analysis that would have motivated a POSITA to combine Randall and Forsyth or Pelkey and Eck. Second, Petitioners have also failed to provide any meaningful discussion of a reasonable expectation of success, which is a separate and distinct point of analysis in any obviousness inquiry. Because Petitioners have not met their burden, institution of this IPR should be denied.

B. Prior Art and Asserted Grounds

Petitioners assert the Challenged Claims are unpatentable based on the following grounds under 35 U.S.C. §103:

Ground	Challenged Claims(s)	References
1	1, 7-12, 14-25	Randall (Ex.1005) and Forsyth (Ex.1006)
2	1, 7-12, 15, 17, 20, 22-25	Pelkey (Ex.1007) and Eck (Ex.1008)

C. The '801 Patent

The '801 Patent is titled Method, Apparatus and System for Management of Information Content for Enhanced Accessibility Over Wireless Communication Networks, and was issued by the U.S. Patent & Trademark Office on September 2, 2014. Ex.1001 (face).

In one embodiment, the '801 Patent describes an innovative method that enables a mobile device user to transfer content from the mobile device to a server for insertion into a mobile information channel so that the mobile device user can interact with one or more additional users.

The '801 Patent also describes transferring information associated with at least one wireless networking functionality of a wireless network from the mobile device to the server.

The content and the information associated with the at least one wireless networking functionality of the wireless network is integrated into the mobile information channel. *See, e.g.*, Ex.1001, 5:63-6:10.

The '801 Patent also enables other content from at least one of the additional users to be inserted into the mobile information channel.

II. PETITIONERS HAVE NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CLAIM CHALLENGED IN GROUND 1 OR 2

Petitioners assert two obviousness grounds of unpatentability. Petition, 2. For this Response, the Board need only consider the validity of independent claims 1, 22, 23, and 25. As discussed below, MDT and its expert Mahdi Eslamimehr, Ph.D (Ex.2049) demonstrate that the Petition fails to establish a reasonable likelihood that Petitioners will prevail and thus an IPR trial should not be instituted.

A. Relevant Legal Principles

It is Petitioners' burden to show why the challenged claims are unpatentable. *Harmonic Inc. v Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016). The PTAB Consolidated Trial Practice Guide ("CTPG") advises that a petitioner must "focus on *concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence* of record." CTPG, 39. It is Petitioners' duty to provide sufficient grounds for the institution of a review "focus[ing] on concise, well organized, easy-to-follow arguments supported by readily identifiable evidence of record." *Cisco Sys., Inc. v. C-Cation Tech, LLC*, IPR2014-00454, Paper 12, 11 (P.T.A.B. Aug. 29, 2014).

The ultimate determination of obviousness under 35 U.S.C. §103 is a question of law based on underlying factual findings. *In re Baxter Int'l, Inc.*, 678 F.3d 1357, 1362 (Fed. Cir. 2012) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)).

“To satisfy its burden of proving obviousness, a petitioner cannot employ merely conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380-81 (Fed. Cir. 2016).

The “factual inquiry” into the reasons for “combin[ing] references must be thorough and searching, and the need for specificity pervades.” *In re NuVasive, Inc.*, 842 F.3d 1376, 1381-82 (Fed. Cir. 2016) (internal quotations and citations omitted). The specific reasoning must include some rational underpinning to combine the prior art elements as claimed to support the conclusion of obviousness. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). In addition, the references must be viewed without the benefit of hindsight vision afforded by the claimed invention. *See, e.g., W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983); *Interconnect Plan. Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985) (“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”); *see also, e.g., Kinetic Concepts, Inc. v. Smith and Nephew, Inc.*, 688 F. 3d. 1342, 1369 (Fed. Cir. 2012).

For a combination of prior art references to render a claimed invention obvious, at the time the invention was made a POSITA must have (1) been motivated to combine the teachings of the prior art references and (2) had a reasonable expectation

of success in making such combination. *See, e.g., Samsung Elecs. Co. v. Elm 3DS Innovations, LLC*, 925 F.3d 1373, 1380-81 (Fed. Cir. 2019) (holding that a patent challenger must show both a motivation to combine and a reasonable expectation of success; affirming Board’s finding of lack of reasonable expectation of success despite that the references were in the “same technological field”); *Eli Lilly & Co v. Teva Pharm. Int’l GmbH*, 8 F.4th 1331, 1344 (Fed. Cir. 2021) (“[W]e must first emphasize the clear distinction in our case law between a patent challenger's burden to prove that a skilled artisan would have been motivated to combine prior art references and the additional requirement that the patent challenger also prove that the skilled artisan would have had a reasonable expectation of successfully achieving the claimed invention from the combination.”); *see also Procter & Gamble Co. v. Teva Pharms. USA, Inc.*, 566 F.3d 989, 994 (Fed. Cir. 2009) (“A party seeking to invalidate a patent based on obviousness must demonstrate ‘by clear and convincing evidence that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.’” (quoting *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1361 (Fed. Cir. 2007))). It is Petitioner’s burden to demonstrate **both** a motivation to combine **and** a reasonable expectation of success. *See In re Magnum Oil Tools*, 829 F.3d at 1381. Mere conclusory statements are insufficient. *Id.*, at 1380.

B. Ground 1: The Challenged Claims Are Not Obvious Over the Randall-Forsyth Combination

Ground 1 asserts independent claims 1, 22, 23 and 25 are rendered obvious under 35 U.S.C. §103 by the combination of Randall and Forsyth, relying on the declaration of Henry Houh, Ph.D. (Ex.1003) as support. Petitioners' arguments fail for multiple reasons. Not only do Petitioners present improper prior art combinations, mixing references and embodiments without explanation, but also their stated motivation for the combination is nonsensical and they provide no support that a POSITA would have a reasonable expectation of success. Further, even considering Petitioners' proposed combination of Randall-Forsyth, the asserted combination fails to teach or suggest explicit limitations.

1. Petitioners' combination of Randall-Forsyth is improper and lacks a motivation

a) Randall and Forsyth are distinct publications and do not describe the same server

Randall and Forsyth are distinct publications. As an initial matter, Randall published in 2002 (Ex.1005, 1), whereas Forsyth published in 2004 (Ex.1006 (face)). Neither claims priority to or incorporates the other by reference. Petitioners make no showing that both describe the same version of Forums or the same version of the Symbian operating system.

Notwithstanding different disclosures and different time frames, Petitioners' expert treats them as describing the same system and application. Petitioners' expert

premises his opinion on the fact that “Randall and Forsyth were both assigned to [Symbian] and described different aspects of functionality provided by Symbian.” Ex.1003, ¶42. Merging the two distinct *publications*, he continues—without citation to the references—that the “client-server infrastructure is described in Randall which along with Forsyth describes use of *this infrastructure* to provide *the Forums service*.” Ex.1003, ¶43 (emphasis added). There is no basis, however, for treating “the Forum service” as one-in-the-same across references. The issue shows up throughout his declaration and the Petition. *See* Ex.2049, ¶¶81, 85-87.

By the expert’s (and Petitioners’) logic, a publication referencing iOS version 1.0 could be combined with a publication on iOS version 26 without explanation or motivation, or “Google Hangouts,” which evolved significantly in infrastructure, operational logic, and communication protocols, but that is improper. *In re NuVasive, Inc.*, 842 F.3d at 1381-82 (holding the “factual inquiry” into the reasons for “combin[ing] references must be thorough and searching, and the need for specificity pervades”); *see also KSR Int’l*, 550 U.S. at 418 (holding the specific reasoning for combining references must include some rational underpinning to combine the prior art elements as claimed); *see* Ex.2049, ¶87.

The Petition refers to “the Forums server” as a unitary, singular device, relying on the combined teachings of Randall and Forsyth. A server in Randall does not inherently correspond to a server in Forsyth. Petitioners cannot argue that “the

Forums server” provides features X, Y, and Z, where X is from Randall and Y is from Forsyth, without addressing the combination. *In re NuVasive, Inc.*, 842 F.3d at 1381; *see also KSR Int’l*, 550 U.S. at 418; *see* Ex.2049, ¶87. Tellingly, with regard to claim 23, Petitioners argue “The Randall-Forsyth combination discloses a **server** which is an ‘*apparatus*’”. Petition, 36, bold emphasis added. The Petition repeatedly refers to the “Forums server,” as if it were a single, identified server. Petition, 38 (“*The Forums server* performs processing...”; “*The Forums server* acts as ‘a store...’”). But the Petition ambiguously refers to servers of each of Forsyth and Randall, citing the expert’s conflated discussion of both. *Id.*, 38 citing Exs.1005, 1006; *id.* citing Ex1003, ¶142 (“Randall and Forsyth also disclose or suggest *the server’s* ‘processing element’ in *the server* includes ‘a memory’...”). The expert’s faulty premise is pervasive throughout related IPRs. *See, e.g., Samsung Elecs. Co. Ltd., et al. v. Mobile Data Technologies LLC*, IPR2025-00542, Paper 8, 59-61 (P.T.A.B. June 16, 2025) (discussing expert’s conflating Randall and Forsyth with citations to declaration).

Further, after noting “[t]he Randall-Forsyth combination discloses *a server*”, the expert describes *that server* with references to Randall’s “server hosting Forums” and describes *that server* relying on Forsyth’s server. Ex.1003, ¶139; *see also* ¶142 (“*Both* Randall and Forsyth describe that *the server* performs...”) (emphasis added), ¶52 (describing the “Symbian Forums server” functionality with reference to

Forsyth and Randall’s “ServML” implementation), ¶68 (“Forsyth enhances the functionality of *the Symbian infrastructure*”).

Concerning the “mobile information channel” (1[A]/ 20), Petitioners also treat “Forums” as a singular platform across references: “Symbian Forums, *described by Randall and Forsyth*, is a group-based, two-way **communication platform**” (Ex.1003, ¶185 (emphasis added)). After concluding that “[o]ne application discussed in Randall using its data infrastructure is Forums” (Ex.1003, ¶45), the expert turns to Forsyth as describing Forums (*id.* ¶46). There is no acknowledgement that Randall and Forsyth are separate publications and embodiments.

That each of Randall and Forsyth mention Symbian or Forums is not enough for Petitioners and Houh to combine the disclosures without explanation, as they have done. *Inter partes* reviews are limited to publication art, and the references should be treated as such and not as if they are directed to the same system or application. *See* 35 U.S.C. § 311(b); *see also* Ex.2051, ¶¶86-87. At a minimum, they are different references, so combining them requires competent explanation, which Petitioners have not provided. *See, e.g., Reactive Surfaces Ltd. v. Toyota Motor Corp.*, IPR2019-00867, Paper 6, 8 (P.T.A.B. Sep.18, 2019) (explaining that even when ““combining multiple embodiments *from a single reference*, ... *there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful*””) (quoting *In re Stepan Co.*, 868 F.3d 1342,

1345-46 n.1 (Fed. Cir. 2017)); *see also Apple Inc. v. Arigna Technology*, IPR2022-01037, Paper 9, 20 (P.T.A.B. Dec. 2, 2022); *Samsung SDI Co. v. Ube Industries, Inc.*, IPR2017-02116, Paper 8, 21 (P.T.A.B. Mar. 12, 2018); *Abiomed, Inc. v. Maquet Cardiovascular, LLC*, IPR2017-01204, -01205, Paper 8, 8-12 (P.T.A.B. Oct. 23, 2017).

b) Petitioners’ stated motivation to combine Randall and Forsyth fails

Petitioners adopt the expert’s opinion on the motivation to combine, but his opinion is contrary to law and logic. His premise for combining is because “Forsyth further enhances the Forums service,” which is taught by Randall. Petition, 12. Contrary to the expert’s rationale of “enhanc[ing] *the Forums service*,” Petitioners and their expert point to the benefit of using group objects *in other applications*. *See* Petition, 13; Ex.1003, ¶74 (emphasizing “group created in one application ...can immediately be used *in other applications*” and “data specifically created for one group in one application can be *re-used in a different application*”). This benefit is not connected to the Forums service and has nothing to do with “enhanc[ing] the Forums service.” *See* Ex.2049, ¶¶89-91. It therefore cannot serve as a motivation to combine.

Additionally with regard to the expert’s notion of an “enhanced Forums service” of Forsyth with Randall’s infrastructure, including its extensible database (Ex.1003, ¶72), there is no reason to do so; it is merely impermissible hindsight

reconstruction. Forsyth describes the use of “content and application independent group objects” so there is no need for Randall. Forsyth, 3:14-18. *See* Ex.2049, ¶89. Forsyth describes the use of a client server architecture, with group objects residing on a remote server and the use of pointers to such a central server (Forsyth, 3:19-31), which indicates the use of a central database. *See* Ex.2049, ¶89. As explained by Petitioners and their expert, the combination is not rooted in any additional benefit, but rather impermissible hindsight. *See W.L. Gore*, 721 F.2d at 1553; *Interconnect Plan. Corp.*, 774 F.2d at 1143. Furthermore, each of Randall and Forsyth describe a system that independently operates and there is thus no reason for a POSITA to combine the features of both systems. *See, e.g., Kinetic Concepts, Inc.*, 688 F.3d. at 1369 (“[b]ecause each device independently operates effectively, a person having ordinary skill in the art, who was merely seeking to create a better device [for the same function], would have no reason to combine the features of both devices into a single device.”).

c) No reasonable expectation of success

It is Petitioner’s burden to demonstrate both a motivation to combine, and a reasonable expectation of success. *See In re Magnum Oil Tools*, 829 F.3d at 1381. Mere conclusory statements are insufficient. *Id.*, at 1380. First, as established above, Petitioners have not established any motivation to combine the references; this failure alone is dispositive. Second, Petitioners make only conclusory statements

regarding a reasonable expectation of success. Petition, 15. This is plainly insufficient, as “attorney argument is no substitute for evidence.” *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005). The Federal Circuit has held that “a party’s unsworn attorney argument... is not evidence” and cannot rebut record evidence. *Wasica Fin. GmbH v. Cont’l Auto. Sys.*, 853 F.3d 1272, 1284-85 (Fed. Cir. 2017).

Petitioners’ reliance on their expert’s testimony (Petition, 15) does not cure the deficiency, as the expert merely repeats the conclusory assertion without any meaningful analysis. Ex.1003, ¶78. This fails to meet the evidentiary requirements of 37 C.F.R. § 42.65(a) and improperly circumvents the prohibition on incorporation by reference under 37 C.F.R. § 42.6(a)(3).

2. Petitioners fail to identify anything in Randall or Forsyth that teaches or suggests the claimed “information associated with [a] wireless networking functionality of [a] wireless network.” (Limitation 1[F]/23[G]/25[G])

In connection with limitation 1[F]/23[G]/25G, Petitioners argue—relying only on their expert—that Randall-Forsyth teaches the recited “information associated with at least one wireless networking functionality,” pointing to encapsulation of sender name, date/time, and Forum name in a protocol (e.g., GSM-SMS or WAP) message. But Petitioners’ expert admits that neither Randall nor Forsyth describe any details of a protocol message or such encapsulation. *See* Ex.1003, ¶120; *see also* Ex.2049, ¶¶82, 93-95, 103-108. Nevertheless, Petitioners

rely on their expert's say-so. In any event, sender name, date/time, and Forum name are not “associated with [a] *wireless networking functionality of [a] wireless network*” and there is no teaching or suggestion that such information is encapsulated by the mobile device or included in a protocol message.

Specifically, Petitioners argue that sender name, date/time, and Forum name are “‘information associated’ with ‘the wireless networking functionality’ of messaging” and are captured and “encapsulated” by the mobile device.

These scenarios/examples also demonstrate “information associated” with the “wireless networking functionality” of messaging. (EX-1003, ¶¶116-123.) Specifically, when the device captures user content, the mobile device must create a Forums message for inclusion in the stored message object at the server containing the sender name (i.e., identity of the user in the Forum (e.g., Steve)), Forum name (e.g., Naked Chef), and content provided by the user, captured by the device (e.g., “Yeah mebees but he grinds his spices with his teeth and spits them into the food”). (EX-1003, ¶119.) The mobile device must further encapsulate the Forums message into a protocol message (e.g., GSM-SMS or WAP) to be transmitted over wireless network. (EX-1003, ¶¶120-123.)

Petition, 31.

While the inclusion of that information *may* indicate the integration of wireless networking functionality, Petitioners' examples fail to actually teach that. Notably, despite Petitioners' emphatic conclusion that it “must” be so, Petitioners cite nothing to support their argument that the mobile device must create a Forums message by encapsulating sender name and Forum name. Indeed, in the client-server architecture of the Forum application advanced by Petitioners (*see, e.g.,* Petition, 17-

18), there is no need for the mobile device to determine this information.¹ See Ex.2049, ¶¶106-107. As described in Forsyth and illustrated in the user interfaces of Figures 6-9 (relied on by Petitioners elsewhere), a user selects a previously established Forum (e.g., Naked Chef) (Figure 6) and after selecting “Forum Reply,” the user enters a text message, which is posted to the selected Forum. Contrary to Petitioners and their expert, there is no reason for the mobile device message to (as required by limitation 1[F]/23[G]/25[G]), include in the message (1) the user identity, as the system already knows which user is logged into the system (having presented him/her with their individualized list of available Forums), or (2) the Forum name (the user having already selected the particular Forum). Any user name, timestamp or Forum name may be added by the server as a matter of course, but not because the mobile device encapsulated this information and sent it to the server, as required by the claim language. Ex.2049, ¶107.

Moreover, sender name and Forum name (and date/time, referred to elsewhere) are not *necessarily* information associated with a wireless networking functionality. At best, sender name and Forum name are related to the text message

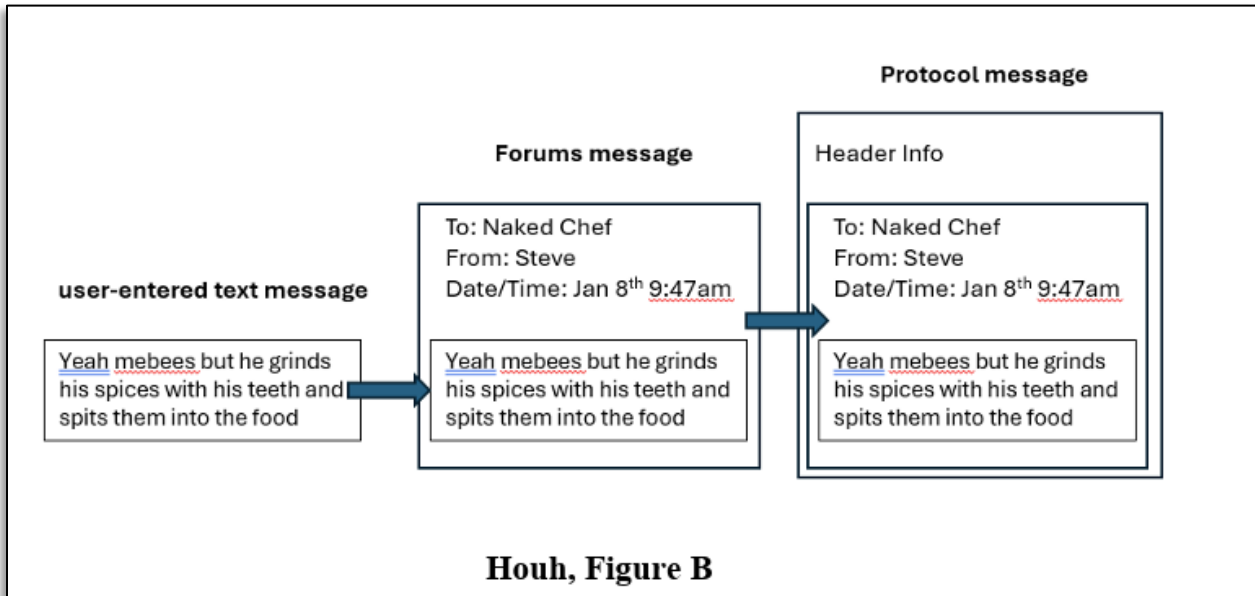
¹ Contrary to Petitioners’ argument regarding limitation 1[F]/23[G]/25[G], there is also no reason the wireless network must insert such information with the content in the mobile information channel.

relied on by Petitioners as the claimed *content* or the Forum *mobile information channel*. See Ex.2049, ¶¶105-109. First, Petitioners argue regarding limitation 1[F] that the Forums message is the claimed content: “*content* provided by the user, *captured* by the device (e.g., “Yeah mebees but he grinds his spices with his teeth and spits them into the food”).” Petition, 31 (emphasis added), citing Ex.1003, ¶119. This argument relies on “group-based text messaging,” (Petition, 30) as shown in the text-message interfaces of Figures 7-9. Thus, information about the message—sender name and date/time—is at best information *about* the claimed content—not “information associated with [a] wireless networking functionality of [a] wireless network.” See Ex.2049, ¶¶110-113. Petitioners’ expert implicitly acknowledges this, stating: “the [captured] content (message; “No way!”) and at least a portion of the determined information (poster identity (e.g., Lucy) and date/time (Jan 8th 10:30am) is integrated [and is thus integrated content] ‘*into the mobile information channel*.’” Petition, 33.

Second, Petitioners contend that a Forum created in the Forums application is the claimed “mobile information channel.” Petition, 18-19. Thus, information about the Forum’s name (and its group participants) is at best information about the claimed information channel—not “*information associated with* ... wireless networking functionality.” Ex.2049, ¶¶110, 112, 113.

Petitioners continue the same paragraph block-quoted above—again relying on their expert—with an apparent alternate argument: “The protocol message includes information associated with the action of sending a message over the network such as message type and content type identifier.” Petition, 31 (citing Ex.1003, ¶¶121-122 (citing Ex.1015, 42-43, 60, 63)). This too fails. *See* Ex.2049, ¶¶101-102, 108.

Petitioners’ expert further provides a conclusory statement that “[t]he mobile device must also encapsulate the generated Forums message into a protocol message to be transmitted by over wireless network, as I illustrate in my Figure B below.” Ex.1003, ¶120.



Ex.1003, ¶120.

Other than his say-so, Petitioners’ expert offers no evidence supporting a conclusion that a message sent *via Forsyth’s Forums* is encapsulated into a protocol message, let alone with the sender name, date/time, and Forum name. In fact, their expert concedes that “neither Randall nor Forsyth provides the details of the wireless messaging functionality of GSM-SMS or WAP.” Ex.1003, ¶120. Nevertheless, he goes on to state that his conclusory opinion is “well-known to and within the general knowledge of a POSITA.” *Id.* Thus, Petitioners’ expert assumes without providing any explanation that the Forums message in Forsyth is somehow converted into a protocol message. For support, he cites his own made-up drawings, resulting in merely a circular argument. Ex.1003, ¶120. Furthermore, it should go without saying that Petitioners’ expert’s drawings are not proper prior art in this proceeding. *Meta Platforms, Inc., et al. v. Eight kHz, LLC*, IPR2023-01023, Paper 10, 31 (P.T.A.B. Jan. 9, 2024) (“We further note ... Dr. Begault’s deposition testimony, which does not qualify as prior art in this proceeding.”).

In the next few paragraphs, their expert cites Exhibits 1015 (GSM Standard) and 1014 (WDP Standard, describing WAP)—references that are not included in any Asserted Ground—to discuss GSM and WAP functionality. Ex.1003, ¶¶121-123 (referencing disclosures in Exs.1015 and 1014). Their expert does so to fill the gap he admits exists in Randall and Forsyth. But Forsyth is directed at neither WAP nor GSM and, as such, their expert’s explanation of “the wireless messaging

functionality of GSM-SMS or WAP” is nothing more than an impermissible attempt to gap-fill the prior art’s teachings by expert testimony. *See* Ex.2049, ¶¶109.

In fact, Forsyth does not mention even once “WAP” or “Wireless Application protocol,” and teaches away from GSM-based platforms: “Wireless information devices based on the Symbian OS platform, are ‘smarter’ than current generation GSM phones in being able to offer multiple, advanced, robust client based applications.” Forsyth at 1:32-35; *see* Ex.2049, ¶100. Forsyth specifically lists fundamental weaknesses associated with GSM phones making GSM unsuitable for Forsyth, e.g., “no single system fully and successfully accommodates the unique characteristics of communicating between groups of mobile users.” Forsyth, 1:54-60.

Randall adds nothing, merely mentioning that GSM and other networks could be used (*See* Randall, 1:11-13) and never providing detail on any protocol message content. *See* Ex.2049, ¶¶85, 93-94.

Moreover, Petitioners’ argument is inconsistent with the ‘801 Patent. Despite the ‘801 Patent explicitly acknowledging that communication protocols, such as WAP, can be used (*See, e.g.,* Ex.1001, 4:26-35), it does not identify this standard protocol header information or sender name, date/time or channel name as the claimed “information associated with [a] wireless networking functionality of [a]

wireless network.” Petitioners’ exclusive reliance on their expert highlights the deficiencies in Randall and Forsyth.

The expert’s citations to Ex.1014 and Ex.1015 (*See* Ex.1003, ¶¶62-63) do not save the argument. Such citations are the expert’s impermissible reliance on a “reference” not included in Ground 1. *See Cisco Sys., Inc.*, IPR2014-00454, Paper 12 at 9 (providing that “practice of citing the Declaration to support conclusory statements that are not otherwise supported in the Petition also amounts to incorporation by reference”); *Meta Platforms, Inc.*, IPR2023-01023, Paper 10 at 31 (“We further note that several of Petitioner’s assertions are supported only by VR Book (Ex. 1063), which is not relied upon as the basis for this challenge, or Dr. Begault’s deposition testimony, which does not qualify as prior art in this proceeding.”)). Furthermore, even if these references were considered, contrary to Petitioners’ argument, there is no discussion in Randall or Forsyth of the sender name, date/time, or Forum name being included in a protocol message; Petitioners’ expert’s argument is based merely on impermissible hindsight. *See W.L. Gore*, 721 F.2d at 1553; *Interconnect Plan. Corp.*, 774 F.2d at 1143.

Petitioners’ arguments regarding limitation 23[G]/25[G] suffer from the same issues and deficiencies, as do the arguments for claim 22 (which incorporates the limitations of claim 1).

a) Petitioner’s Arguments Regarding Protocol Messaging is Incorrect

In its Response to Patent Owner’s Discretionary Denial Brief (Paper 9) for the related IPR2025-00536 concerning the ‘039 Patent (“Paper 9”), Petitioners argue that “sender name, date/time, and Forum name” are indeed included in a “protocol message sent to the server.” As noted in the section immediately above, there is no disclosure in Randall nor Forsyth that describes any details of a protocol message. Petitioners, however, point to Forsyth Figure 7 claiming it “shows that all of *the information* (sender name, date/time, etc.) is presented together, meaning that *the information* must have been determined by the mobile device and sent to the server.” Paper 9, 42 (emphasis added). And again, Petitioners cite only to their expert declaration (Ex.1003, ¶¶161, 177) for support.

First, Forsyth’s Figure 7 is not a “protocol message;” it is just a screen of a mobile device displaying message content without any indication it came from messaging protocols. Second, on the one hand, Petitioners state “[a]s noted above, ***this information*** is separate and distinct from the information encapsulated in a protocol message.” Paper 9, 42 (emphasis added). Regarding “this information,” Petitioners are clearly referring to the “sender name, date/time, etc.” as noted above. On the other hand, however, Petitioners argue “‘***determined information*** associated with’ the action of sending the Forums message (e.g., sender name, date/time, Forum name) is provided along with the text message entered by the user (captured content)

in the **protocol message** sent to the server.” Paper 9, 41 (bold emphasis added). This contradiction of whether the information *is* or *is not* part of the message or the message protocol shows that Petitioners’ argument is inconsistent.

b) Petitioners’ GSM/WAP references do not teach the missing limitations from Randall and Forsyth

Regardless of Petitioners’ conclusory reasoning, Petitioners’ reliance on GSM and WAP references, which Petitioners characterize as being part of the “knowledge and creativity of a POSITA,” is misplaced. These references either teach away from Petitioners’ conclusions or fail to fill in the gaps of Randall-Forsyth.

First, Petitioners erroneously point to GSM-SMS as evidence of content integration because GSM-SMS is a bearer network and thus GSM-SMS message requires a protocol header to transmit message data. *See* Petition, 38-40. Simply, the protocol header of GSM-SMS does not integrate with the content item to become the “integrated content item” that is shared with two or more users. Ex.2049, ¶109. Further, nowhere do Petitioners identify or explain what part of the protocol header from the wireless network would become part of the claimed integrated content item.

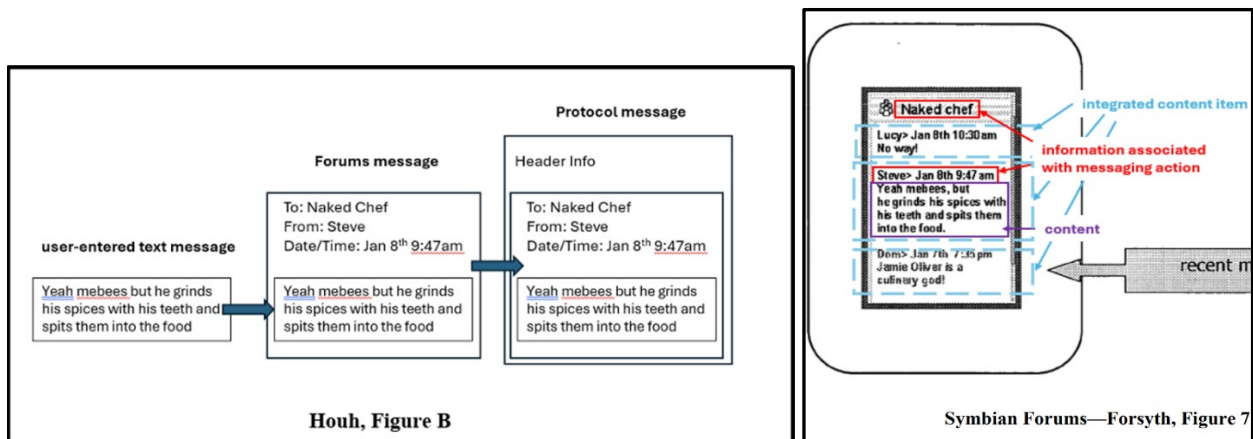
Petitioners’ expert relies on the SMS-SUBMIT transport protocol data unit (“TPDU”) header requirements in his attempt to show that information associated wireless networking functionality of a wireless network gets integrated with the content item. Ex.1003, ¶¶164-165 (citing Ex. 1015, 42-43, 60, 63). In his declaration, Petitioners’ expert reproduces the TPDU chart that shows all the

mandatory and optional information that must or can be included in an GSM-SMS-protocol header. Ex.1003, ¶165. The protocol header data in the chart are all the fields in the chart except the user data (TP-UD), which is, of course, the actual content of the message. However, as shown in the SMS-SUBMIT TPDU chart (Ex. 1015, 43), all the header data is exclusive to SMS functionality to ensure a message gets to where it is going and can be read by the receiving device. Ex.2049, ¶¶64-73. Nowhere do Petitioners or their expert explain why a POSITA would be motivated to integrate any of that temporary protocol data with the message content, as required by the claim language. It is as if Petitioners are claiming that an addressed and stamped envelope integrates with the letter inside to become part of the letter content.

The GSM-SMS Standard TPDU fields chart on which Petitioners' expert relies indicates that each of these fields is service center controlled or mobile station (the user device) controlled. Ex.1003, ¶165 (citing Ex.1015, 43). Every field except TP-UD is discarded after delivery. Ex.2049, ¶¶71-72. Petitioners' expert's own evidence thus concedes that header bytes would not obviously become part of a persistent "integrated content item," aligning with Patent Owner's position.

Petitioners' expert's Figure B contrasted with his annotated Forsyth Figure 7, shown below, demonstrates the folly of Petitioners' logic. The Forums message, as depicted in their expert's Figure B, *is the content* of the GSM-SMS message.

Ex.2049, ¶¶111-112. While Houh contends in his Figure B that the “header info” integrates with the content in the protocol message, Houh abandons this position when he annotates Forsyth Figure 7. Ex.2049, ¶112. Nowhere does Houh explain where the “header info” from the protocol message would find its way into the Naked Chef Forum. Meanwhile, Houh relabels the user data content of the GSM-SMS message as “information associated with messaging action”—none of which is part of the GSM-SMS header protocol which Petitioner insists would be integrated. Petition, 39 (“The protocol message includes information associated with the action of sending a message over the network. . . . Thus, the messaging “information” is “one or more messaging actions.”); Ex. 1015, 43 (*not showing* Forum name, sender name, and date/time as part of the SMS-SUMBIT “header info”).



Forsyth Figure 7 is related to application-layer; it is not the transport envelope. Houh’s attempt to graft bearer-layer headers onto this figure violates basic network

layering principles, effectively conflating transport layer protocol (WDP) with the higher application layer (Forum content). Ex.2049, ¶¶ 74, 113.

Rather, Houh cannot show that sender name, Forum name, and/or date/time are disclosed as *information associated with at least one wireless networking functionality of said at least one wireless network*. Houh admits that **SMS is an example** of *wireless networking functionality*. Ex.1003, ¶160. As such, Houh claims that sender name, Forum name, and/or date/time are necessarily an element of information associated with wireless networking functionality of messaging of the *wireless networking functionality of said at least one wireless network*. *Id.*, ¶162. However, as explained above, the “sender/poster identity, Forum name, date/time” is an element of the Forums program and not the GSM-SMS messaging functionality of the wireless networking functionality of said at least one wireless network.² In fact, the only information similar to Houh’s examples that is required by the SMS-

² There is no *per se* information that is not information associated with the wireless networking functionality of a wireless network. Information like sender/poster identity, Forum name, date/time could be information associated with the wireless networking functionality of a wireless network, but it is not in the context of Randall-Forsyth or even in GSM-SMS/WAP protocols. *See* Ex.2049, ¶¶75-80.

SUBMIT TPDU is the TP-DA or destination address. Ex. 1015, 43. However, in the case of Forums, that address would be the address of the server hosting Forums, not any of the information that would be allegedly included in the content that would be posted in the Forum itself. Ex.2049, ¶71. Further, Petitioners do not show that the address is shown in Forums or otherwise integrated with the content on Forums and shared with other users as the claims require.

Indeed, those fields originate from the application itself, not from the bearer network. At that layer, there is thus no bearer-layer parameter to integrate from the wireless network. Ex.2049, ¶71. Moreover, the transport services layer, where WAP protocols reside, is also above the bearer network layer not a wireless network functionality of the wireless network. Ex.2049, ¶113. Petitioners therefore attempt to double-count what they claim as the mobile information channel as also information associated with the wireless network functionality of the wireless network.

Moreover, if the Forums content is then delivered to other Forums users via SMS, it would be encapsulated by a different SMS protocol header—not the original. Ex.2049, ¶¶78-80 (citing Ex. 1015, 39). The distribution of the Forums message to other users would use the SMS-DELIVER TPDU. Ex.2049, ¶110. Even then, the sender/poster identity of the original message would not be a part of the GSM-SMS protocol information as the only included header information is the TP-OA

(originating address of the message), which would be the Forums server address. Thus, Petitioners cannot show that their proposed integrated content item at the second interface is the same integrated content item produced at the first interface.

Ultimately, Petitioners' entire argument for this critical limitation rests on a chain of unsupported assumptions. First, Petitioners assume Forsyth's high-level application concept must use a specific low-level protocol like WAP or GSM-SMS, even though Forsyth teaches away from GSM and never mentions WAP. Second, Petitioners assume such a protocol would encapsulate packet header data (sender, forum name, timestamp) that Forsyth never discloses. Third, Petitioners assume this packet header data, which describes user activity within the application, qualifies as information generated by a "wireless networking functionality," a term the '801 patent reserves for distinct network services like billing or SMS centers. And, Petitioners make these assumptions despite their own expert admitting the foundational references are silent on these technical details. This string of speculation, bridged only by the expert's conclusory say-so and improper citation to non-asserted art, falls far short of demonstrating a reasonable likelihood of success and is precisely the type of hindsight-driven reconstruction the law forbids.

3. Petitioners fail to identify and differentiate the claim terms “Inserting” and “Integrating” (Limitation 1[F]/23[G]/25[G])

Petitioners’ obviousness case rises and falls on the premise that “inserting” content and “integrating” wireless-network information are interchangeable acts.³ The intrinsic record teaches the opposite. At a minimum, these are separate claim limitations. The Petition shows that it simply collapses the two limitations—1[C]/1[E] versus 1[F]—into the same bucket. *Id.* This is sharp practice. *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1563 (Fed.Cir.1991) (“[O]ur interpretation [should] give[] full effect to the recitation of two distinct elements in the claimed structure.”); *Meta Platforms, Inc. v. Eight kHz, LLC*, IPR2023-01003, Paper 9, 31-32 (P.T.A.B. Jan. 9, 2024) (“At this stage, we question whether Petitioner’s approach of using its analysis of limitation 1[B] as a shorthand for ten other allegedly ‘similar’ limitations that use different language and pertain to different steps, without any further explanation, is sufficient to meet its burden.”). Because the cited art (and the

³ For example, under the heading of §V(B)(1)(d)(2) “***Integrating ... information associated with***” a “**wireless networking functionality**,” Petitioners state the “content and the information associated with a wireless networking functionality are provided to the server and *inserted* into the “mobile information channel.” Petition, 33. This is one of many examples where Petitioners conflate the terms.

Petition's mapping) addresses only **insertion** by end-users, not **integration**, Ground 1 fails on its face.

a) “Integrate” and “Insert” are defined differently in the specification

The specification draws a distinction between “inserting” and “integrating.” For example, the specification describes several exemplary methods, including “*inserting* content provided by the first user into the mobile information channel, ... *inserting* at least a portion of the additional content into the mobile information channel, and *integrating* into the mobile information channel information associated with at least one wireless networking functionality.” Ex.1001, 2:20-28. This distinction applies to claim 1, which recites this same language.

The '801 specification describes “inserting” as basic content placement into a mobile information channel. *See* Ex.1001, 2:20-24, 2:39-44, 2:58-62. However, the specification defines “integrate” much differently; namely to “integrate into the mobile information channel information associated with at least one wireless networking functionality of said at least one wireless network.” *Id.*, 2:64-67. Indeed, one of the stated goals of the patent is to “provide improved integration of information content management with wireless network functionality.” *Id.*, 3:51-53. And, “the information content of a given mobile site generated in the system 10 may be configured so as to *integrate* therewith information associated with at least one wireless networking functionality of the wireless network 12.” *Id.*, 5:63-66.

Moreover, none of the cited references state *where* any of the integration occurs, other than on a message board. The '801 Patent is clear: the “services integration server **39 controls the *integration of information associated with these wireless networking functionalities* with the content of the mobile site generated via the content management site.” Ex.1001, 9:53-56, emphasis added. The claimed “content” comes from the *users* (*Id.*, Claim 1); -however- “information associated with wireless networking functionality” is not user content, but is generated from *network services*, such as SMS, MMS, billing, etc. as described above. Thus, while *inserting* merely places user-authored material in the channel, *integrating* requires the server to combine network-functionality data with that material—creating a richer composite that enables wireless actions (messaging, billing, etc.) directly from the mobile information channel.**

b) “Integrate” and “Insert” are both used in the claim and are not the same

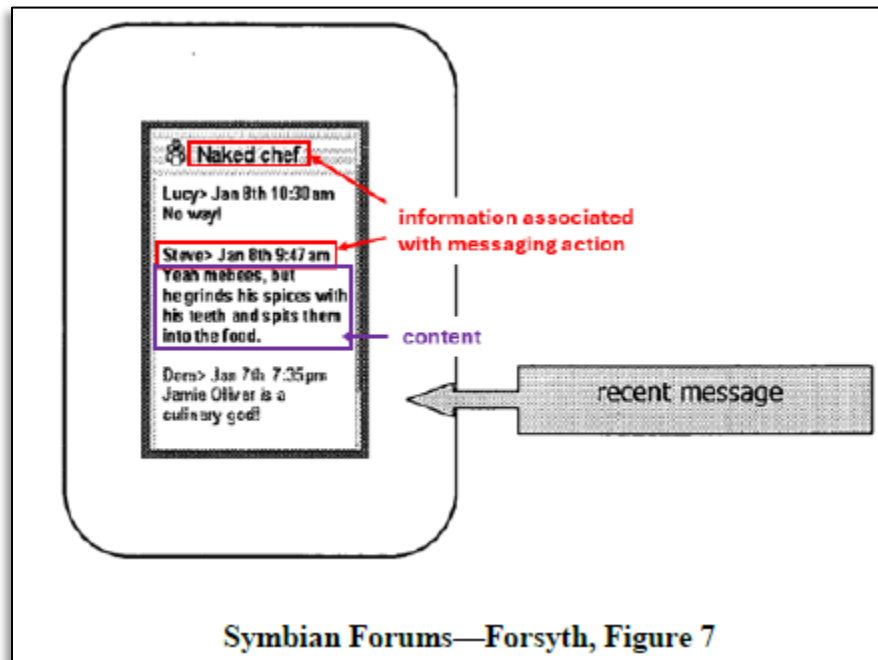
The '**801 patent treats “insert” and “integrate” as distinct verbs at the claim level, not just in the specification.** For example, independent claim 1 lays out three ordered actions—“*inserting [first-user content] ... inserting [additional content] ... and integrating [network-functionality information]*.” Ex.1001, 19:6-18. The other independent claims repeat exactly the same triplet: see **claim 14** (Ex.1001, 21:40-60) and **claim 23** (Ex.1001, 23:3-22). By reciting both verbs in every independent claim, the drafter signals that **insertion (simple placement of user-authored**

material) and integration (merging wireless-network data into that material) are separate, sequential operations. Re-reading the claims so that “integrate” means merely “insert” would therefore rewrite the claim language and erase the drafter’s deliberate differentiation.

Federal Circuit precedent confirms that such a rewrite is impermissible. The court must “*presume that the use of ... different terms in the claims connotes different meanings.*” *CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1317 (Fed. Cir. 2000). Likewise, “*differences among claims can also be a useful guide in understanding the meaning of particular claim terms.*” *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1538 (Fed. Cir. 1991). Collapsing distinct words violates that canon. Because the independent claims of the ’801 patent consistently preserve both verbs, any construction that conflates “integrating” with “inserting” would run afoul of these settled rules and improperly alter the scope of every asserted claim.

The Petition merely shows a display with supposedly “integrated” data such as date/time shown in the figure below (Petition, 34) but never points to any disclosure in Randall or Forsyth that performs the integration function of server 39 or that merges SMS, MMS, or other service data into displayed content. There is no indication or disclosure of how the “information associated with at least one wireless networking functionality” came to be presented on the display. Thus, Forsyth’s

“Forums” is simply a database of user posts—an insertion site. But the integration step is left completely unaddressed. The Petition re-labels ordinary postings on a Forum as *integration*, which is ineffective.



This failure to appreciate the distinction between inserting and integrating is fatal to the Petition’s analysis of the prior art. The Petition identifies Forsyth’s display of a message thread, which includes user-provided content (the message text) alongside mobile information channel data (the sender’s name and a timestamp), as evidence of “integration.” Petition, 34. However, this is merely the organized display of inserted content. The sender’s name and the message text are both part of the same user-generated submission. The ’801 patent, in contrast, claims the integration of information from a separate wireless networking functionality, such as an external SMS, MMS, or billing system with the user-provided content. Ex.2049, ¶¶104-113.

The Forums information channel is *not* a separate networking functionality. Randall and Forsyth do not disclose a server architecture capable of fetching data from such external network services and merging it into the Forums channel. Presenting a list of messages with sender names is fundamentally different from integrating, for example, a user's SMS message count from an SMS center alongside their Forum posts. The Petition fails to identify any prior art that teaches this claimed integration.

4. Petitioners' 1[B] and 1[F] arguments are contradictory

Furthermore, Petitioners' argument regarding limitation 1[B]/23[C] is at odds with their 1[F]/23[G] argument. For 1[B], Petitioners specifically state "Forsyth describes creation and activation of a Forum in group-based text messaging Scenario 1" as how to activate a Forum. Petition, 20. For 1[F], Petitioners contend that the same group-based text messaging is "at least one wireless networking functionality." Petition, 30. Accordingly, Petitioners rely on Forsyth's group-based text messaging for teaching both limitation 1[B]'s "mobile information channel" and limitation 1[F]'s "wireless networking functionality of a wireless network." Petitioners' approach underscores their misunderstanding of Forsyth, the '801 Patent claims, and the law.

Petitioners misconstrue Forsyth by mapping its disclosure of "group-based text messaging" to the claimed "wireless networking functionality." *See* Ex.2049, ¶114. But Forsyth's reference to "group-based text messaging" is not a "wireless

networking functionality” of the wireless network—it is a capability of Forums, which, as Petitioners contend, is an application. *See* Ex.2049, ¶¶115-116.

Petitioners admit that “group-based text messaging” is no more than a capability of Forums (Petition, 18-20): “Forums . . . facilitates open discussion amongst a group.” Petition, 18; *see also* Petition, 30-31 (“Forums supports ‘group based text messaging’ and ‘group based multi-media messaging.’”).

Forsyth itself confirms that Forums uses group objects to initiate group-based text messaging. Forsyth at 3:35-45. A group object, Forsyth explains, is “a collection of information that describes or references at least the minimum amount of information about 2 or more entities (usually individual ...) required for activities to be engaged in between them.” Forsyth at 2:17-22. In the context of text messaging, Forsyth explains that “the collection of information” required to create a group object is information about the participant in the group: “In Forums, a new group object can be created when a user defines the recipients of a message.” Forsyth at 2:48-49. Forums supports “group-based text messaging” by allowing a user to select “a group of participants”—which is stored as an “application independent object”—to create a Forum. Forsyth at 5:50-62. Thus, Forsyth’s “group-based text messaging” is a capability of Forums. Forums supports a text messaging activity because it is a “messaging tool.” Forsyth at 5:27-30. It is group-based because “[i]n Forums, a new group object can be created when a user defines

the recipients of a message, or (going beyond a simple messaging application) whenever the user defines the desired participants to be involved in group communication.” Forsyth at 2:48-53. Contrary to Petitioners’ mischaracterization (Petition, 38), Forsyth’s reference to “group-based text messaging” is not a “wireless networking functionality of at least one wireless network”—it is a capability of Forums, which, as Petitioners contend, is an application. *See* Ex.2049, ¶¶115-116.

Petitioners’ inconsistent argument cannot establish a reasonable likelihood of invalidity of a challenged claim.

C. Ground 2: The Challenged Claims Are Not Obvious Over the Pelkey-Eck Combination

Ground 2 of the Petition asserts that the combination of Pelkey (Ex.1007) and Eck (Ex.1008) discloses or renders obvious every element of the independent claims of the ’801 patent. This ground also fails. First, Petitioners’ explanation to combine Pelkey and Eck is nothing more than impermissible hindsight. Second, neither Pelkey nor Eck, alone or in combination, teaches all limitations of the challenged claims. Third, Petitioners also rely on improperly assumed interfaces and messaging behaviors that are not disclosed in either reference. These deficiencies are not minor gaps; they go to explicit claim limitations.

1. Petitioners’ stated motivation to combine Pelkey and Eck fails

Petitioners fail to identify any plausible motivation to combine the teachings of Pelkey and Eck. Petitioners merely state, without support, that a “POSITA would have been motivated to combine Eck’s teachings regarding PagerWorld with the network and message server architecture taught in Pelkey.” Petition, 55.

As an initial matter, the holes in Petitioners’ argument are particularly notable given their admissions as to the deficiencies of Pelkey and Eck. Admitted deficiencies include:

(i) Eck does not describe a client-server structure as taught in Pelkey (Ex.1003, ¶196; Petition, 55);

(ii) Pelkey does not describe integration of messaging and sharing content like photos with multiple users (Ex.1003, ¶197);

(iii) Pelkey does not describe any in-game messaging (Ex.1003, ¶197; Petition, 56); and

(iv) Pelkey does not disclose details of the wireless network used to provide wireless messaging from the game system to the server (Petition, 72; Ex.1003, ¶226).

Petitioners argue that a “POSITA would be motivated to apply the network and message server architecture in Pelkey to Eck in order to avoid the charge-based system for exchanging messages and photos via pager cartridge in Eck. (EX-1003, ¶197.)” Petition, 56. This is contrary to the teaching of Eck, which solves any issue

regarding “cost” an entirely different way. *See* Ex.2049, ¶¶119-122. Specifically, Eck teaches that a user can turn to “user-generated custom libraries of words, phrases and graphics” to reduce message length. This practice is called “coding,” which Eck expressly acknowledges can be used “to reduce message length” and thus “reduce message charges.” Eck, 16:59-60; *see also id.* 16:49-63 (“It can be seen that by using ‘coding’, the length of the messages may be reduced.”). Petitioners and their expert point to no evidence to support a combination of Pelkey and Eck based on cost reduction, failing to address the additional costs of the proposed modification (e.g., communication and bandwidth costs of the proposed network and message server architecture) or the specific savings that would motivate the combination or prompt a user to switch to GSM-SMS or WAP. *See* Ex.2049, ¶¶121-122; *In re Schmidt*, 892 F.2d 1051, *2 (Fed. Cir. 1989) (“[W]hile we agree that cost saving may serve as a motive for making a modification, **it must be clear at least that the modification, in fact, effects a reduction in the cost.**”). Petitioners have made no showing regarding the cost savings allegedly available for a user using the client server architecture of Pelkey, which is also a charge-based service. *See* Ex.2049, ¶¶121-122. Instead, Petitioners improperly rely on their expert’s conclusory statement.

Petitioners continue that “a POSITA would be motivated to modify the ‘pager cartridge’ in Eck as necessary to use PagerWorld in Pelkey given the disclosed benefits of PagerWorld including ‘exploration and adventure,’ ‘chat and community

interaction,’ and ‘character growth.’” Petition, 56 (citing Ex.1003, ¶197; Ex.1008, 10:13-19). The statement is telling: Petitioners are suggesting both a modification to Eck’s “pager cartridge” and a modification of Pelkey. However, Petitioners never explain what either modifications would actually be. This is a glaring failure given the fundamentally different architectures of Pelkey (client-server) and Eck (peer-to-peer) (*see* Ex.2049, ¶¶123, 125-128) and Petitioners’ (and their expert’s) very next statement that “Pelkey does not describe any game play that includes in-game messaging in conjunction with the aforementioned features” (Petition, 60). Petitioners present no evidence—not even a conclusory statement from their expert—to support that a user would consider any messaging disclosed in Eck to foster the features in Pelkey of “exploration and adventure,” “chat and community interaction,” and “character growth.”

Furthermore, Petitioners parrot their expert’s conclusory opinions that Eck’s PagerWorld game is a known technique, Pelkey’s client-server based messaging server is a known method/product, and “[r]eplacing the pager system infrastructure system in Eck with the client-server architecture in Pelkey is the simple substitution of one known element for another to achieve a predictable result (internet-based functionality).” Petition, 56 (citing Ex.1003, ¶197). But Petitioners’ expert never explains what those modifications would be given differences in operation of a game system using a client-server based messaging platform via a modem and a wide area

network (Pelkey) versus a specific device-to-device paging system over a paging network that allows two users to communicate while playing a portable game device (Eck) and fundamentally different network architectures. Indeed, their expert provides no explanation of whether, circa 2002, a “GSM-SMS or WAP cartridge” could be constructed, how a pager cartridge could be replaced with such a hypothetical “GSM-SMS or WAP cartridge” in the system of Eck, including in the context of other portions relied on by Petitioners involving piggy-backing a digital camera cartridge onto the “GSM-SMS or WAP cartridge.” *See* Ex.2049, ¶129.

Potential issues not addressed by Petitioners or their expert, include, for example, redesigning the game cartridge interface to accommodate differing electrical and communication protocols between the pager and GSM/WAP systems, addressing increased power consumption and battery management demands typical of GSM or WAP devices, implementing necessary changes in software drivers and firmware to manage GSM/WAP-specific network registration, messaging protocols, and error-handling routines, and ensuring robust signal integrity and electromagnetic compatibility, particularly given the distinct operational frequency bands and interference concerns of GSM/WAP compared to paging systems. *See* Ex.2049, ¶124.

Regardless, Petitioners’ motivation to combine is technically baseless and contradictory. Pelkey’s described network architecture is both fundamentally

incompatible with Eck's messaging system and is completely unnecessary. However, Petitioners claim that it is necessary to adopt Pelkey's client-server network architecture to avoid the charge-based messaging system disclosed in Eck and obtain "internet-based functionality." Petition, 60-61. First, this assumption is based on the false choice that a POSITA must abandon the peer-to-peer (P2P) network architecture disclosed in Eck to operate on anything other than the pager-network infrastructure described in Eck. Ex.2049, ¶¶126-127. This is based on the false conclusion that such a drastic change to Eck is necessary to obtain internet-based functionality. Ex.2049, ¶129. Rather, network architecture and infrastructure are two distinct things. Ex.2049, ¶127. Thus, there is no inherent need whatsoever for a POSITA to look to Pelkey to adapt Eck's messaging system to a different network infrastructure.

Second, Petitioners and Houh illogically suggest that the combination of Pelkey and Eck would yield a system that operates over a GSM-SMS network infrastructure. Ex. 1003, ¶¶276-279. This type of network is also a charge-based system for exchanging messages—especially at the time of the priority date—which completely contradicts Petitioners' stated cost reason for a motivation to combine. Ex.2049, ¶¶130-131. Thus, it is nonsensical for a POSITA to attempt a complicated redesign of the Eck network architecture for Pelkey's to merely substitute a cost model that is comparably the same as the one a POSITA is trying to avoid. *See, e.g.,*

Kinetic Concepts, 688 F. 3d. at 1369 (“[b]ecause each device independently operates effectively, a person having ordinary skill in the art, who was merely seeking to create a better device [for the same function], would have no reason to combine the features of both devices into a single device.”).

Petitioners have thus failed to provide a sufficient explanation of the combination of Pelkey and Eck or the motivation to combine them. This applies to all ‘801 Patent claims.

2. No reasonable expectation of success

It is Petitioner’s burden to demonstrate both a motivation to combine, and a reasonable expectation of success. *See In re Magnum Oil Tools*, 829 F.3d at 1381. Mere conclusory statements are insufficient. *Id.*, at 1380. First, as established above, Petitioners have not established any motivation to combine the references; this failure alone is dispositive. Second, Petitioners make only conclusory statements regarding a reasonable expectation of success. Petition, 56. This is plainly insufficient, as “attorney argument is no substitute for evidence.” *Enzo Biochem, Inc.*, 424 F.3d at 1284. The Federal Circuit has held that “a party’s unsworn attorney argument... is not evidence” and cannot rebut record evidence. *Wasica*, 853 F.3d at 1284-85.

Petitioners’ reliance on their expert’s testimony (Petition, 57) does not cure the deficiency, as the expert merely repeats the conclusory assertion without any

meaningful analysis. Ex.1003, ¶198. This fails to meet the evidentiary requirements of 37 C.F.R. § 42.65(a) and improperly circumvents the prohibition on incorporation by reference under 37 C.F.R. § 42.6(a)(3).

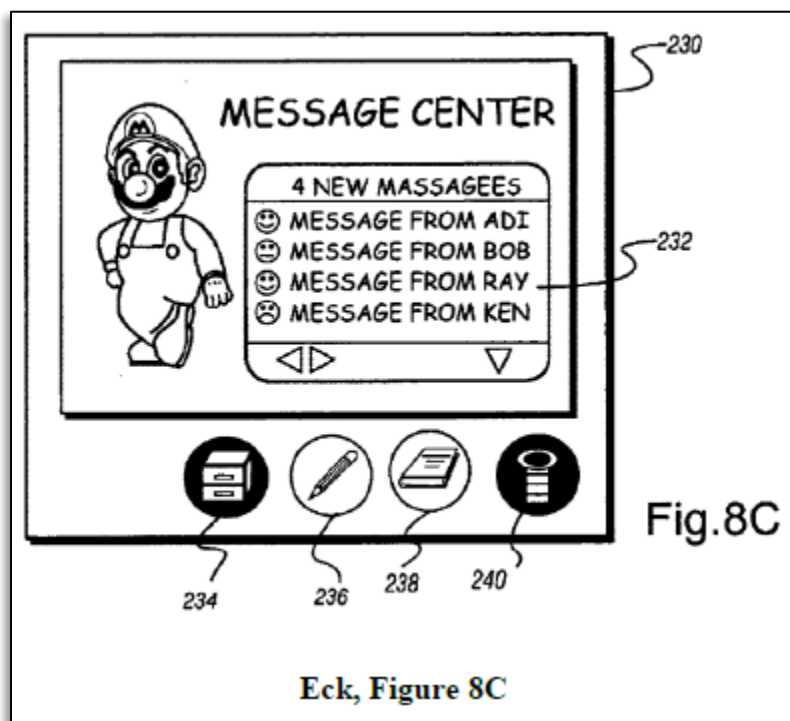
3. Petitioners’ asserted combination of Pelkey and Eck fails to identify anything that teaches or suggests the claimed “integrating into the mobile information channel information associated with at least one wireless networking functionality of said at least one wireless network.” (Limitation 1[F]/23[G]/25[G])

Even if the combination of Pelkey and Eck were proper, Petitioners fail to present a prima facie case the combination teaches “integrating into the mobile information channel information associated with at least one wireless networking functionality of said at least one wireless network.” as recited in limitation 1[F]/23[G] and limitation 23[G].

As shown above in §II.3, the claim terms “integrate” and “insert” are defined differently in the specification, and are deliberately used as separate terms in the claims. Ex.2049, ¶133. In particular, Petitioners fail to provide evidence of “integrating.” In its discussion of “integrating,” the Petition refers to its §VI.B.1.c.(2), which discusses “Mobile Devices Associated with at Least One Wireless Network.” Petition, 75. However, this section of the Petition only discusses the use of a pager cartridge that can allegedly give the mobile devices internet connectivity. Petition, 69-75. As discussed above in §II.3.a, the ’801 specification defines integration as a function of an integration server and other infrastructure for

provision of the networking information. Notably, Petitioners provide *no disclosure* of the relevant server-side activity or similar infrastructure in Pelkey-Eck. Ex.2049, ¶¶132, 134-140.

The only proffered evidence of integration is the non-annotated figure below from Eck, which is alleged to show information from the wireless network. Petitioners state that “the GSM protocol includes fields associated with the action of sending a message over the wireless network and are therefore also “information” associated with “wireless network functionality” by inclusion in the protocol message originated by the sending mobile device.” Petition, 78.



Petition, 78.

Petitioners add the conclusory statement “[m]essages transmitted via WAP will include the same additional information.” Petition, 78. They offer no analysis or citation to a document or expert declaration, which is insufficient. Ex.2049, ¶140.

Petitioners conclude with a brief discussion of a received message (as shown in the above Eck figure 8C). Petition, 79. They argue that because “sender information (e.g., “ADI,” “BOB,” “KEN,” as shown in Figures 8C and 8E) is integrated along with the message-related information,” the integration claim limitation is met. As further evidence, their expert states “Eck discloses the use of “[n]otification circuitry 134 [which] provides notification to the user that a message has been received. Notification circuitry 134 may be implemented as a vibration circuit that is controlled by control circuit 136 to vibrate when a message is received.” Petition, 79, EX-1003, ¶241. However, this again is completely devoid of any discussion of the necessary server-side infrastructure, and is therefore insufficient. Ex.2049, ¶136.

The Petition’s attempt to equate the display of a sender’s name in Eck’s Message Center with the claimed “integration” fundamentally mischaracterizes both the prior art and the invention. Petition, 77. Eck discloses a simple, self-contained application where a user’s handle and persona character are part of the message application itself. This is merely the presentation of user-provided data alongside the message application data. In contrast, the ’801 patent claims the integration of

information associated with a wireless networking functionality data that originates from a network service provider, not from the user's message composition in the application. Showing MESSAGE FROM BOB on a screen (Petition, 78 citing Eck Figure 8C) is not integration of a wireless network functionality; it is the basic function of Eck's messaging application, a feature inherent to the messaging application itself, not an advanced integration of separate network services as claimed. Ex.2049, ¶¶137-139.

The combination of WAP and GSM-SMS protocols with Pelkey and Eck do not make up for Petitioners' admitted lack of information with wireless network functionality being integrated with a content item. As Petitioners admit, "Pelkey does not disclose details of the wireless network used to provide wireless messaging." Petition, 72. Further, Petitioners do not rely on the extensive disclosure of paging technology in Eck despite Eck's disclosure that message transmission via paging can interface with the Internet and Internet connected devices. *See* Petition, 73-74; Eck, 9:43-45 ("The pagers in the system are individually and collectively addressable to and from . . . [the] PC-Internet."). Thus, Petitioners admit that Eck's disclosure of pager wireless networking messaging functionality does not result in the integration of information associated with at least one wireless networking functionality of a wireless network with a content item to generate at least one integrated content item, as required by the claims.

Even if WAP and GSM-SMS are combined with Pelkey and Eck, the only data that GSM-SMS contributes is transient delivery protocol header data (TP-DA/OA, TP-PID, TP-SCTS, etc.). These protocol header data octets are discarded once forwarding is complete and never reach the application layer where Pelkey/Eck's "content items" reside. Therefore, no integrated "content" originates from the bearer layer, and Petitioners' theory fails on the face of the governing protocol.

As explained above in §II.B.2(b), the GSM-SMS protocol headers themselves contain no information that would otherwise be integrated with the messaging content, nor does Pelkey-Eck disclose anything that is included in that SMS header would be integrated with the message content. Ex.2049, ¶138. Houh states that display of a sending user's name and associated persona image demonstrates this limitation. Ex. 1003, ¶237. However, this ignores, as explained in detail above, that GSM-SMS used as a data transport protocol would not include any of that information in its header data. Ex.2049, ¶139. Foremost, the GSM-SMS-SUBMIT data message does not include the sender's identity nor does it include any data space for a persona image to be transmitted in the header. Ex.2049, ¶140.

Moreover, the integration of WAP header information over a GSM-SMS network with a content item is completely nonsensical. For example, a modest 100kB photo (such as a JPEG) would take no less than 715 GSM-SMS messages to

transmit via WAP over GSM-SMS. Ex.2049, ¶140. Petitioners make no explanation why some 715 separate GSM-SMS and/or WAP headers would necessarily be integrated with the final content item or why a POSITA would include such information with the content item adding upwards of 6.4kB of additional data. The header information for a data packet is information associated with wireless network technology, but it is information that is meant to be discarded once the data packet has arrived at its destination. Ex.2049, ¶140.

III. CONCLUSION

Based on the deficiencies identified above, Petitioners have not shown that they have a reasonable likelihood of prevailing on any of the proposed grounds. The Board should decline to institute an IPR proceeding based on the Petition.

Date: July 14, 2025

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), the undersigned hereby certifies that the foregoing Patent Owner's Preliminary Response to Petition for *Inter Partes* Review contains 9,996 words using the word count feature of Microsoft Word.

Date: July 14, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on July 14, 2025, I caused a true and correct copy of the foregoing Patent Owner's Preliminary Response to Petition for *Inter Partes* Review to be served via electronic mail upon the following attorneys of record for the Petitioners:

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