

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

IPR2025-00544
U.S. Patent No. 9,619,578

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 '578 and '801 Patents
2003	Petition for <i>Inter Partes</i> Review in IPR2025-00543 (Feb. 5, 2025)
2004	Reserved
2005	Return of Service filed in the EDTX-Litigation (June 21, 2024)
2006	E-mail from the Board regarding the 543 and 544 IPR panel assignments (May 2, 2025)
2007	Decision Granting Institution of Inter Partes Review in IPR2024-00249 (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)
2026	Patent Owner's Infringement Contentions in the EDTX-Litigation (September 4, 2024)
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)
2031	Reserved
2032	Petitioners' proposed <i>Sotera</i> stipulation for '543 and '544 IPRs (April 21, 2025)
2033	Petitioners' claim chart against '578 Patent based on the Nokia 9210 System (January 31, 2025)
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2037	Joel West & David Wood, <i>EVOLVING AN OPEN ECOSYSTEM: THE RISE AND FALL OF THE SYMBIAN PLATFORM</i> (2013)

Ex.	Description
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2047	Declaration of Kevin Jakel in IPR2021-00917 (May 11, 2021)
2048	Petition for Inter Partes Review in IPR2024-00249 (Dec. 6, 2023)
2049	Declaration of Petitioners' expert from '538 IPR
2050	Declaration of Mahdi Eslamimehr for IPR2025-00544 of U.S. Patent No. 9,619,578

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. 9,619,578 (the “’578 Patent”), filed by Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioners”), challenging claims 1, 6-12, 15-19, and 21-22 (the “Challenged Claims”) of the ’578 Patent. Paper 4, 2 (“’544 IPR Petition” or “Petition”). Institution should be denied because Petitioners fail to meet their burden to show a reasonable likelihood that 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 “application-based information channel,” “a first interface,” and “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. 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 or even coming from the protocols. 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, 6-12, 15-19, 21-22	Randall (Ex.1005) and Forsyth (Ex.1006)
2	1, 6-12, 15-19, 21	Pelkey (Ex.1007) and Eck (Ex.1008)

C. The '578 Patent

The '578 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 April 11, 2017. Ex.1001 (face).

In one embodiment, the '578 Patent describes an innovative method that enables a mobile device user to, via a first interface, designate a content item for insertion into an application-based information channel, the at least one content item comprising media data captured by the mobile device.

The '578 Patent also describes integrating the content item and information associated with at least one wireless networking functionality of the mobile device to generate at least one integrated content item.

The '578 Patent also describes inserting the at least one integrated content item into the application-based information channel.

The '578 Patent further describes the application-based information channel providing a second interface wherein two or more users share access to a plurality of content items including the at least one integrated content item.

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, 8, 9, 12, 16, 17, 21, and 22. As discussed below, MDT and its expert, Mahdi Eslamimehr, Ph.D (Ex.2050) demonstrate that the Petition fails to establish a reasonable likelihood that Petitioners will prevail and thus an IPR trial therefore 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, 8, 9, 12, 16, 17, 21, and 22 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 nor 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, the 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, ¶45. 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, ¶46 (emphasis added). There is no basis for treating "the Forum service" as one-in-the-same across references. The issue shows up throughout his declaration and the Petition. *See* Ex.2050, ¶¶106, 111-113.

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.2050, ¶106.

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; Ex.2050, ¶¶104-106. Regarding claim 9, Petitioners tellingly argue “The Randall-Forsyth combination discloses **a server**”. Petition, 16. The Petition repeatedly refers to the “Forums server,” as if it were a single, identified server. Petition, 18, 26 (“*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.*, 18 citing Exs.1005, 1006; *id.* citing Ex.1003, ¶87 (“*Both* Randall and Forsyth describe that *the* [Forums] *server* performs processing actions...”). 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 combination of Randall and Forsyth 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, ¶84; *see*

also ¶87 (“**Both** Randall and Forsyth describe that **the server** performs...”)
(emphasis added), ¶55 (describing the “Symbian Forums server” functionality with
reference to Forsyth and Randall’s “ServML” implementation), ¶71 (“Forsyth
enhances the functionality of **the Symbian infrastructure**”).

Concerning the “application-based information channel” (1[A]/9[B]),¹
Petitioners also treat “Forums” as a singular application across references: “Forums,
described by Randall and Forsyth, is an application” (Petition, 19 (emphasis
added)), alternating citations (*Id.* 18-19). After concluding that “[o]ne application
discussed in Randall using its data infrastructure is Forums” (Ex.1003, ¶47), the
expert turns to Forsyth as describing Forums (*id.*, ¶48). There is no
acknowledgement that Randall and Forsyth are separate publications and
embodiments.

Petitioners also treat the references as single Symbian-based system in the
context of the “first interface” (1A/9B): relying on Randall’s “Forums
infrastructure” as teaching a wireless network interface (Petition, 26-27 citing

¹ Petitioners incorporate by reference their Claims 1[A]/9[B] analysis for
Claims 12/17/21/22/8/16. Petition at 49-51. Thus, Petitioners’ faulty “application-
based information channel” analysis undermines the entirety of their Ground 1
arguments.

Randall, 40:15-41:2, 13:22-24, Figure 4), and then Forsyth as describing the functionality of *that interface* (Petition, 27 citing Forsyth, 6:1-22).

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.2050, ¶106. 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 “to enhance the Forums service taught by Randall.” Petition, 12 (citing Ex.1003, ¶¶75-81). 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, ¶77 (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 this benefit has nothing to do with “enhanc[ing] the Forums service.” See Ex.2050, ¶108. It therefore cannot serve as a motivation to combine.

Additionally, regarding the expert’s notion of “enhanc[ing] the Forums service” of Forsyth with Randall’s infrastructure, including its extensible database (Ex.1003, ¶75), 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.2050, ¶111. 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.2050, ¶111. 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 a few 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, ¶81. 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. The Petition fails to identify a teaching or suggestion in Randall or Forsyth for the “application-based information channel” (Limitation 1[A]/9[B])

Petitioners' theory of obviousness centers around the notion that Forsyth's Forums is an application and that an individual Forum is an “application-based information channel.” *See* Petition, 19-21, 28-35. Petitioners contend that within the Forums application, a user can create an individual Forum for group-based text messaging by “designating participants.” Petition, 28. With regard to 1[A]/9[B], Petitioners assert that “Each individual Forum is . . . [an application-based information channel]².” Petition, 20. Creation of an individual Forum is enabled via utilization of a “group object” within Forums:

² Petitioners used the language, “computer program-based medium for transferring information,” which Petitioners equated to an “application-based

Forums runs on the object based operating system Symbian OS. In 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 2:47-52. Specifically, Forsyth states that the group object is application independent:

Fundamental to Forums is the idea of there being an object which defines solely the identities of members of a group: as such, it is content and *application independent*.

Forsyth at 5:15-17.

Each group exists as an application independent object and can hence be accessed by different applications and used for a wide variety of purposes—whenever an application designer wishes to include some kind of group communication functionality.

Id. at 5:55-60; *see also id.* at 2:37-39 (“No earlier system includes the concept of the content and *application independent ‘group’ object*.”). Thus, it is undisputed that the group objects created in Forums are application independent, per Forsyth’s express teaching. As such, contrary to Petitioners’ arguments, an individual Forum is not an *application-based* information channel. *See* Ex.2050, ¶¶115-120. Neither Petitioners nor their expert explain how an “application independent” channel can be “application-based.”

information channel” in their proposed claim construction of “application-based information channel.” Petition, 6.

From a technological and implementation perspective, Forsyth's application-independent group objects is technologically inconsistent with the '578 Patent. A POSITA would have recognized that mapping an application-independent structure onto the '578 Patent's channel would demand a fundamental redesign: the group object would need to be cloned or irrevocably bound to a specific application context; server logic would need new namespace and access-control layers to prevent other apps from re-using the object; and the client would have to transmit extra metadata so the server could disambiguate a specific group object in, for example, a Messaging app from the exact same object when invoked by a Diary app. *See* Ex.2050, ¶120. Neither Petitioners nor their expert address the need for these, or any, modifications necessitated by Forsyth's use of group objects as its "foundation stone for building applications." Forsyth, 3:14-18.

Recognizing the shortcomings of this identical argument made in Petitioners' petition in IPR2025-00536,³ Petitioners attempt to switch positions in their Response To Patent Owner's Discretionary Denial Brief (IPR2025-00536, Paper 9; "DD Response"). Petitioners' DD Response does not argue that an individual Forum

³ IPR2025-00536 uses the same Randall-Forsyth combination to challenge the 9,032,039 Patent, which uses the same "application-based information channel" term. IPR2025-00536, Paper 4, 24-30.

is the application-based information channel (*see* Petition, 27), but rather that “***the group object*** is therefore an ‘application-based information channel’” and that the claimed channel can exist across applications. DD Response, 36-37 (emphasis added). Nowhere in the Petition do Petitioners argue the group object is the channel, and it should not be credited if Petitioners attempt a similar shift here. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (recognizing Petitioners are held to the positions in their petition). In any event, the group object in Forsyth is just a data object—“a collection of information that describes or references...2 [sic] or more entities”. Forsyth, 2:17-19. Petitioners’ new argument simply highlights the weakness in the argument presented in their Petition—***an individual Forum is not application-based***.

Petitioners’ arguments regarding limitation 12[A]/17[D]/21[A]/22[B] suffer from the same issues and deficiencies, as do the arguments for claim 8 (which incorporates the limitations of claim 1) and claim 16 (which incorporates the limitations of claim 12).

3. The Petition also fails to show how each of the four different potential “first interfaces” meet the remainder of the claim limitations

Further in Ground 1, the Petition identifies ***four*** potential “first interfaces” (1[A]/9[B]) but does not clearly explain how each of the four purported first interfaces permits designation of a “content item comprising media data from a

mobile device” (1[A]/9[B]), how *that same content item* is integrated with information associated with a wireless networking functionality (1[B]/9[C]), how the *same integrated content item* is inserted into *the same channel* associated with each purported “first interface” (1[C]/9[D]), and how that same channel provides multiple users access to the same integrated content item (1[C]/9[D]). Rather, the Petition bounces between discussions of text messages (which Petitioners concede are *not* media data (Petition, 24)), photos, sounds, and image data, without addressing how they could be combined.

The Petition impermissibly mixes and matches disclosures from various Forsyth embodiments: Scenario 1-Group based text messaging, Scenario 2-Discussion of Photos, and Scenario 4-A Digital Memento from a User’s Birthday. But Petitioners fail to explain how aspects of these embodiments may be properly combined. For example, when discussing the “content item comprising media data” term, Petitioners point to Scenario 1-Group based text messaging.⁴ Petition, 24. Petitioners also point to Scenario 2-Discussion of Photos where a user “takes a few

⁴ Petitioners’ reliance on Scenario 1-Group based text messaging is incorrect because text messaging is not “media data,” as Petitioners’ themselves acknowledge. Petition, 24 (“describing media as encompassing ‘a document, a video, a photo, a graphic, a music file, etc.’”).

photographs” and sends them to the group. Petition, 24. Petitioners also point to Scenario 4-A Digital Memento from a User’s Birthday where “[p]eople post MP3s of the kind of music played at each club.”⁵

When discussing the “first interface” limitation of the claims, Petitioners point to Scenario 1-Group based text messaging. Petition, 28. The first interface, however, allows designation of the content item comprising media data, and as Petitioners’ themselves acknowledge, Scenario 1-Group based text messaging does not contain media data. Petitioners acknowledge this deficiency but do nothing to fill the gap other than by citing to their expert’s conclusory statement. Petition, 29.

Regarding the “insertion of captured content” requirement, Petitioners point to Scenario 2-Discussion of Photos and Scenario 4-Digital Memento from a User’s

⁵ Petitioners’ reliance on scenarios where content is not captured by the mobile device is fundamentally flawed. For example, in Scenario 2-Discussion of Photos the photos are not taken by the mobile device (“a user is on holiday, and he takes a few photographs of the beach *with his digital camera*”) and thus are not “captured by the mobile device.” Likewise, in Scenario 4-A Digital Memento from a User’s Birthday the pictures are taken with “digital cameras,” not “captured by the mobile device.” Petition, 25 (citing Forsyth, 9:5-35). And similarly, the music files from Scenario 4 are not “captured by the mobile device.”

Birthday (Petition, 37), again even though neither of those scenarios involves media data “captured by a mobile device.”

Regarding the “information associated with a wireless networking functionality,” Petitioners point to Scenario 1-Group based text messaging and Scenario 3-Social Scheduling. Petition, 38-39. Regarding the “integrating the at least one content item and information ... to generate at least one integrated content item,” Petitioners again point to Scenario 1-Group based text messaging, even though this scenario does not include the required media data. Petition, 40.

“When an obviousness argument relies on ‘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, otherwise a skilled artisan would not arrive at the claimed combination.’” *Reactive Surfaces*, IPR2019-00867, Paper 6 at 8 (quoting *In re Stepan Co.*, 868 F.3d at 1345-46 n.1); *see also Arigna Technology*, IPR2022-01037, Paper 9 at 20; *Samsung SDI Co.*, IPR2017-02116, Paper 8 at 21; *Abiomed*, IPR2017-01204, Paper 8 at 8-12.

Petitioners’ arguments regarding limitation 12[A]/17[D]/21[A]/22[B] suffer from the same issues and deficiencies, as do the arguments for claim 8 (which incorporates the limitations of claim 1) and claim 16 (which incorporates the limitations of claim 12).

4. Petitioners fail to identify anything in Randall or Forsyth that teaches or suggests the claimed “information associated with [a] wireless networking functionality of the mobile device” (Limitation 1[B]/9[D])

In connection with limitation 1[B]/9[D], Petitioners argue—relying exclusively 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, ¶163; *see also* Ex.2050, ¶¶121-123, 127. In any event, sender name, date/time, and Forum name are not “associated with [a] **wireless networking functionality of the mobile device**” in either Randall or Forsyth. Further, Petitioners fundamentally mischaracterize the functionality of WAP over GSM-SMS and their own WAP/GSM references—which are not part of the prior art in the Grounds of the Petition. Even if considered, these references do not fill the gaps of Randall’s and Forsyth’s admitted deficiencies.

a) Petitioners’ arguments are conclusory and contradictory

Specifically, Petitioners argue that sender name, date/time, and Forum name are “information associated with [a] wireless functionality of the mobile device.”

These scenarios/examples also demonstrate “*information associated*” with the “*wireless networking functionality*” of messaging. Specifically, when the device captures user content, the mobile device

must create a Forums message for inclusion in the stored message object for the Forum stored 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.

Petition, 38 (emphasis in original).

Notably, despite Petitioners' emphatic conclusion that it "must" be so, Petitioners cite nothing to support the argument that the mobile device must create a Forums message by determining sender name and Forum name. Indeed, in the client-server architecture of the Forum application advanced by Petitioners (*see, e.g.,* Petition, 21), there is no need for the mobile device to provide this information.⁶ *See* Ex.2050, ¶¶124-125. As described in Forsyth and illustrated in the user interfaces of Figures 6-9 (relied on by Petitioners elsewhere),⁷ a user selects a previously established Forum (e.g., Naked Chef) (Figure 6) and after selecting "Forum Reply,"

⁶ Contrary to Petitioners' argument regarding limitation 1[B]/9[D], there is also no reason the mobile device must insert such information with the content in the application-based information channel.

⁷ *See, e.g.,* Petition, 23-24 (explaining Figure 6 permits a user to navigate a list of Forums and allows selection of one to "navigate[] to a screen associated with the Forum (e.g., Forsyth Figure 8)"); *id.* at 35-36 (explaining a user selecting a Forum from Figure 6 is directed to the selected Forum (Figure 8) and "enter content ... 'for insertion' into the Forum" (Figure 9)).

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 provide (or, as required by limitation 1[B]/9[D], 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). Ex.2050, ¶136. Any user name, timestamp or Forum name may be added by the server as a matter of course, but not because the mobile device provided this information and sent it to the server, as required by the claim language. Ex.2050, ¶¶124-125.

Moreover, sender name and Forum name (and date/time, referred to elsewhere) are not information associated with a wireless networking functionality. At best, this information is related to the content posting relied on by Petitioners as the claimed *content* or the Forum *application-based information channel*. See Ex.2050, ¶¶126-128.

First, Petitioners argue regarding limitation 1[A] that the Forums message interface is how the claimed content can be entered or posted: “When the user selects one of these Forums, the user navigates to a user interface associated with the selected Forum (e.g., Forsyth Figure 8) where the *user can enter and post content*.” Petition, 35-36 (emphasis added) (relying on “group-based messaging,” as shown in the text-message interfaces of Figures 7-9). Thus, sender name and date/time is at

best information about the claimed content, not “information associated with [a] wireless networking functionality of the mobile device.” *See* Ex.2050, ¶¶124-125. Petitioners’ expert implicitly acknowledges this, stating: “the sender name and Forum name are included in the Forums message.” Ex.1003, ¶171.⁸

Second, as explained above, Petitioners contend that a Forum created in the Forums application is the claimed “application-based information channel.” *Petition*, 19-21. 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.2050, ¶¶126-127.

Importantly, apparently in support of the Forum name being wireless networking functionality information, Petitioners explicitly note the creation of a

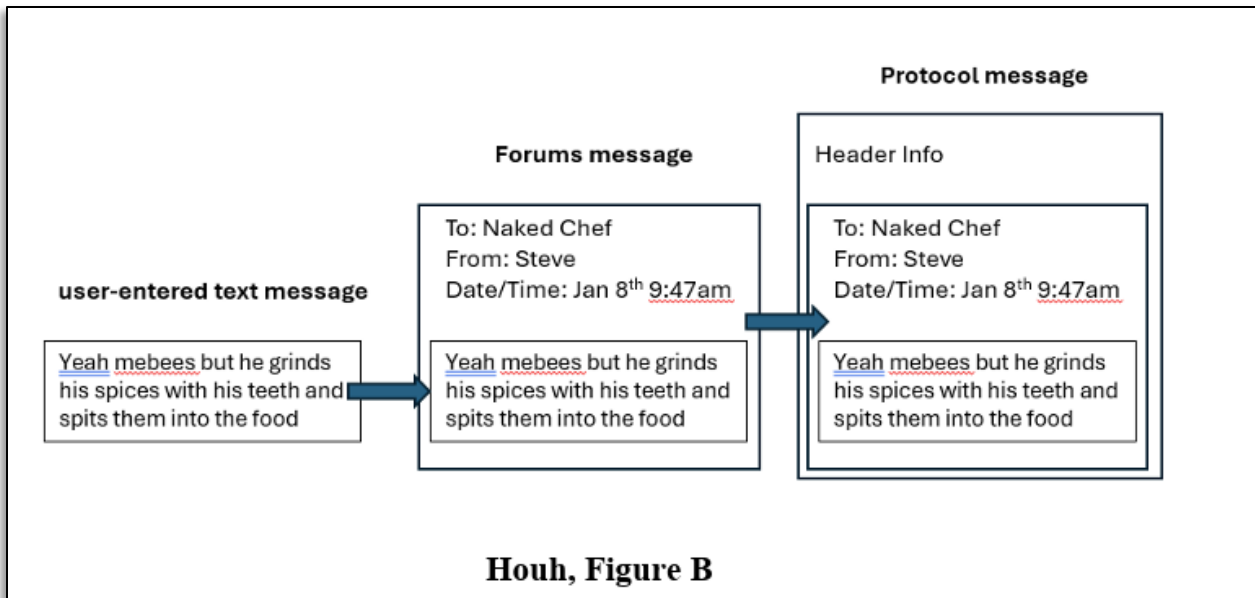
⁸ Although Petitioners’ expert later claims that “the server integrates . . . [the] sender/poster identity, Forum name, date/time” with the content, this is nonsensical following his statement such information was already included with the content item. Ex.1003, ¶171. No such integration is necessary on the server end when the user already having logged in and selected the Forum made that information an inherent part of the content item. *See* *Petition* 35-36 (detailing how a user navigates the interface where a user can post content).

new Forum in Scenario 1. Petition, 38 (“For example, in Forsyth’s Scenario 1, when the ‘Naked Chef’ Forum is created, the user sends an initial message to the server. (See EX-1006, 6:1-9.)”). To the extent Petitioners imply a user’s message by which he/she names the Forum and creates it is “information associated with at least one wireless networking functionality,” that fails. The “wireless networking functionality” must be “of the mobile device,” and the supposed sending of the Forum name at the time the Forum where it is integrated at the server is a requirement of the server and not an element of the “wireless networking functionality of the mobile device” as required by the claims.

b) Petitioners’ argument that the protocol message includes information associated with the wireless networking functionality of the mobile device also fails

Petitioners argue “[t]he protocol message includes information associated with the action of sending a message determined by the mobile device such as message type and content type identifier.” Petition, 39 (citing Ex.1003, ¶¶164-165 (citing Ex.1015, 42-43, 60, 63)). This too fails. *See* Ex.2050, ¶¶130-131, 137.

In discussing limitation 1[B]/9[D] for Ground 1, Petitioners’ expert testimony begins with 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, ¶163.



Ex.1003, ¶163.

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, Petitioners' expert concedes that "neither Randall nor Forsyth provides the details of the wireless messaging functionality of GSM-SMS or WAP." *Id.* 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 with such information. For support, he cites his own made-up drawings, resulting in merely a circular argument. *Id.* 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.”).

Forsyth is directed at neither WAP nor GSM and, as such, Petitioners’ 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 with expert testimony. *See* Ex.2050, ¶¶123, 129.

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.2050, ¶129. 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 at 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.2050, ¶¶121-122, 130-131.

Moreover, Petitioners’ argument is inconsistent with the ’578 Patent. Despite the ’578 Patent explicitly acknowledging that communication protocols, such as WAP, can be used (*see, e.g.*, Ex.1001, 4:17-23), 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 the mobile device.” Petitioners’ exclusive reliance on their expert highlights the deficiencies in Randall and Forsyth.

While reference to GSM-SMS or WAP may indicate that the mobile device sends a Forums message via a wireless network, neither Forsyth nor Randall teaches that any information is separately **“associated with at least one wireless networking functionality of the mobile device”** (or, as addressed below in connection with limitation 1[C]/18[E], associated with the content). The mobile device does not determine message type or content type. *See* Ex.2050, ¶¶127, 129-131, 137. In Forsyth’s scenario, the device simply transmits the user’s text over whatever protocol is available. Forsyth, 1:22-24.

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

To fill the gap he admits exists in Randall and Forsyth, Petitioners’ expert cites Exhibits 1015 and 1014—references that are not included in any Asserted Ground—to discuss GSM and WAP functionality. Ex.1003, ¶¶162-164 (referencing

disclosures in Exs.1015 and 1014). But Petitioners' expert's citations to Ex.1014 and Ex.1015 (*See* Ex.1003, ¶¶65-66) does not save the argument.

First, such citations are Petitioners' 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.").

Second, even if considered, Petitioners' reliance on GSM and WAP references (Ex.1014 and Ex.1015), 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.

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

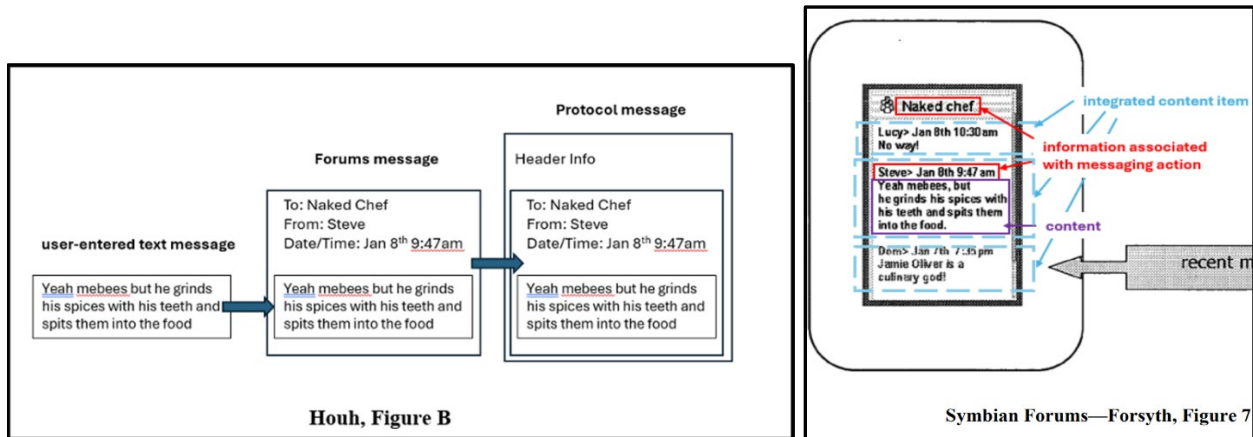
“integrated content item” that is shared with two or more users. Ex.2050, ¶¶138-142. Further, nowhere do Petitioners identify or explain what part of the protocol header from the mobile device would become part of the claimed integrated content item.

Petitioners’ expert relies on the SMS-SUBMIT transport protocol data unit (“TPDU”) header requirements in his attempt to show that information associated with wireless networking functionality of a mobile device 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.2050, ¶¶76-79. 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 indicate 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.2050, ¶¶81, 139. Dr. Houh's own evidence thus concedes that bytes of information in the header 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.1003, ¶163; Ex.2050, ¶¶140-141. 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.1003, ¶¶163, 172; Ex.2050, ¶¶140-141. 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.2050, ¶¶136, 142.

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 the mobile device*. 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 mobile device.⁹ *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 mobile device. In fact, the only information similar to Houh’s examples that is required by the SMS-SUBMIT PDU 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.¹⁰ Ex.2050, ¶139.

⁹ Houh repeatedly omits the Patent’s limitation “of the mobile device” often conflating actions that are or may be performed by network servers as attributable to the mobile device.

¹⁰ Houh also implies that if the user data in the message content includes a user data header (UDH), the UDH would also integrate with the message content. Ex.1003, ¶165 (citing Ex.1015, 60, 63). This also fails because the UDH would not be integrated with the message content. The UDH is nothing more than a SMS functionality that informs the receiving device that the incoming data is not a standard short message. Ex.2050, ¶¶79-80. Rather, the UDH indicator in the SMS header is a signal to the receiving device that the header is longer than the standard

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.2050, ¶139. Moreover, the transport services layer, where WAP protocols reside, is also above the bearer network layer not a wireless network functionality of the mobile device. Ex.2050, ¶¶142. Petitioners therefore attempt to double-count what they claim as the application-based information channel as also information associated with the wireless network functionality of the mobile device.

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.2050, ¶¶76, 139. The distribution of the Forums message to other users would use the SMS-DELIVER TPDU. Ex.2050, ¶76. 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

GSM-SMS-PDU protocol header because the receiving device needs additional information to decipher the included message content. Ex.2050, ¶¶80.

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.

Petitioners' arguments regarding limitation 12[B,C]/17[E,F]/21[B]/22[C,D] suffer from the same issues and deficiencies, as do the arguments for claim 8 (which incorporates the limitations of claim 1) and claim 16 (which incorporates the limitations of claim 12).

5. Petitioners' 1[A] and 1[B] arguments are contradictory

Furthermore, Petitioners' argument regarding limitation 1[A]/9[B] is at odds with their 1[B]/9[D] argument. For 1[A], Petitioners specifically state "[t]his is illustrated by Forsyth's 'group-based text messaging' Scenario" as how to create a Forum within Forums. Petition, 28. For 1[B], Petitioners contend that the same group-based text messaging "at least one wireless networking functionality." Petition, 38. Accordingly, Petitioners rely on Forsyth's group-based text messaging teaching both limitation 1[A]'s "application-based information channel" and limitation 1[B]'s "wireless networking functionality of a mobile device." Petitioners' approach underscores their misunderstanding of Forsyth, the '578 Patent claims, and the law. *See, e.g., Becton, Dickinson and Co. v. Tyco Healthcare Gr., LP*, 616 F.3d 1249, 1254 (Fed. Cir. 2010) ("Where a claim lists elements separately, the clear implication of the claim language is that those elements are distinct component[s] of the patented invention.") (internal quotations omitted); *Hopkins Manufacturing Corporation v. Cequent Performance Products, Inc.*, IPR2015-00613, Paper 9, 12 (P.T.A.B. Aug. 7, 2015).

Petitioners misconstrue Forsyth by mapping its disclosure of "group-based text messaging" to the claimed "wireless networking functionality." *See* Ex.2050, ¶¶143-145. But Forsyth's reference to "group-based text messaging" is not a

“wireless networking functionality” of the mobile device—it is a capability of Forums, which, as Petitioners contend, is an application.

Petitioners admit that “group-based text messaging” is no more than a capability of Forums, which Petitioners contend to be the claimed application (Petition, 19-20): “Forums is a ‘messaging tool that facilitates open discussion amongst a group.’” Petition, 23; *see also* Petition, 38 (“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, 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, 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, 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, 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, 2:48-53. Contrary to Petitioners’ mischaracterization (Petition, 38), Forsyth’s reference to “group-based text messaging” is not a “wireless networking functionality of the mobile device”—it is a capability of Forums, which, as Petitioners contend, is an application. *See* Ex.2050, ¶¶143-145.

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 ’578 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. Fourth, Petitioners’ other incorporated references nonetheless fail to fill these gaps. 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, 62.

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, ¶247; Petition, 60);

(ii) Pelkey does not describe integration of messaging and sharing content like photos with multiple users (Ex.1003, ¶247);

(iii) Pelkey does not describe any in-game messaging (Ex.1003, ¶247; Petition, 60); and

(iv) Pelkey does not disclose details of the wireless network used to provide wireless messaging from the game system to the server (Petition, 76; Ex.1003, ¶276).

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, ¶247.)” Petition, 60. This is contrary to the teaching of Eck, which solves any issue

regarding “cost” an entirely different way. *See* Ex.2050, ¶¶153-155, 157. 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.2050, ¶¶155-157; *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.2050, ¶155. 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, 60-61 (citing Ex.1003, ¶247; 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.2050, ¶158) 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, 61). 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, 61 (citing Ex.1003, ¶247). But the expert never explains what those modifications would be given differences in operation of a game system

using a client-server-based messaging platform where data is centrally stored on a server (Pelkey) versus a specific device-to-device paging system that allows two users to communicate while playing a portable game device where all the data is stored locally on devices using a decentralized data network (Eck) using fundamentally different network architectures. Ex.2050, ¶151 Indeed, their expert never explains what those modifications would be given differences in operation and architecture. Indeed, the expert provides no explanation of whether, circa 2002, a “GSM-SMS and 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.2050, ¶159.

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.2050, ¶158-159.

Regardless, Petitioners' motivation to combine is technically baseless and contradictory. Pelkey's described network architecture is both fundamentally incompatible with Eck's messaging system. 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.2050, ¶¶149-151. This is based on the false conclusion that such a drastic change to Eck is necessary to obtain internet-based functionality. Rather, network architecture and infrastructure are two distinct things. Ex.2050, ¶149. 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.2050, ¶155. 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 '578 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 a few conclusory statements regarding a reasonable expectation of success. Petition, 61. This is plainly insufficient, as “attorney argument is no substitute for evidence.” *Enzo Biochem*, 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, 61) does not cure the deficiency, as the expert merely repeats the conclusory assertion without any meaningful analysis. Ex.1003, ¶248. 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. The alleged Pelkey-Eck combination does not teach an “application-based information channel into which the captured content is to be inserted” (Limitation 1[A]/9[B])

Even if the combination of Pelkey and Eck is considered as Petitioners contend, Petitioners fail to present a *prima facie* case that the combination teaches limitation 1[A]/9[B].

In addressing 1[A]/9[B], Petitioners argue that “the captured content (photo/images, sound/auto files) ‘is inserted’ into the ‘application-based information channel.’” Petition, 80-81 (quoting 1[A]/9[B]). In support, they point to (i) a user customizing their person character and (ii) “PagerWorld supports transmission of messages ‘with images and sound bytes to other pagers in the network....’” Petition, 80-81 (citing Eck, 16:42-45, 24:30-36). Neither teaches nor suggests the claim limitation.

Regarding (i)—customizing a persona character—Eck, in a single passing sentence, mentions “[i]t is even possible to customize the persona character using image data obtained with a digital camera cartridge.” Eck, 12:38-40. Eck never discusses what such image data is or how it is used. Petitioners, without support, go well beyond this passing reference. It is not, as Petitioners argue, the insertion of “photos/images.” *See* Ex.2050, ¶¶162-163. Petitioners simply make an unsupported leap without explanation, never explaining what “image data” may comprise or how it may be reflected in a persona character. *See* Petition, 73.

Regarding (ii)—PagerWorld transmitting messages with images and sound—there is no such disclosure. Petitioners conflate different embodiments and discussions in Eck; messages with images and sound have nothing to do with PagerWorld. *See* Ex.2050, ¶¶164-165. Established precedent forbids combining features from unrelated embodiments or references absent a clear teaching or suggestion to do so, and Petitioners point to none. *See, e.g., In re Wright*, 569 F.2d 1124, 1127 (CCPA 1977); *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1354 (Fed. Cir. 2013); *Reactive Surfaces*, IPR2019-00867, Paper 6 at 8 (“When an obviousness argument relies on ‘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, otherwise a skilled artisan would not arrive at the claimed combination.”) (quoting *In re Stepan Co.*, 868 F.3d at 1345-46

n.1); *see also* *Arigna Technology*, IPR2022-01037, Paper 9 at 20; *Samsung SDI Co.*, IPR2017-02116, Paper 8 at 21; *Abiomed*, IPR2017-01204, Paper 8 at 8-12.

Eck describes various embodiments and uses for its pager cartridge—including uses outside the context of PagerWorld. Whereas the claimed “previously established application-based information channel”—identified by Petitioners as PagerWorld—is for insertion of the captured content, not every message transmitted via the pager cartridge in Eck involves PagerWorld.

Eck makes clear that the pager cartridge can be used to send messages *separate* from PagerWorld. *See* Ex.2050, ¶166. For example, in the disclosed embodiment shown in Figure 5B, “a game cartridge is piggy-backed onto pager cartridge 100 [and] users can play the game independently via pass-through connector 902.” Eck, 13:61-63. Pager functionality is independent. “Pager cartridge 100 is a stand-alone accessory device...which can receive messages even when not attached to game machine 10.” Eck, 22:2-5. The game machine 10 can be used not to play a game or enter PagerWorld, but to merely “activate[] a display of messages on the display thereof in accordance with the operating software stored in the memory of the pager.” Eck, 22:10-14.

Eck acknowledges the separateness of traditional paging functionality from gameplay and PagerWorld. Eck summarizes the functionality of the “pager-equipped portable game machine,” *explicitly enumerating sending messages*

separately from allowing playing of pager-compatible games like PagerWorld.

Eck, 9:25-37. Also acknowledging the non-PagerWorld uses, Eck notes: “Apart from traditional paging functions, pager cartridge 100 can be used in game playing.” Eck, 9:60-61.

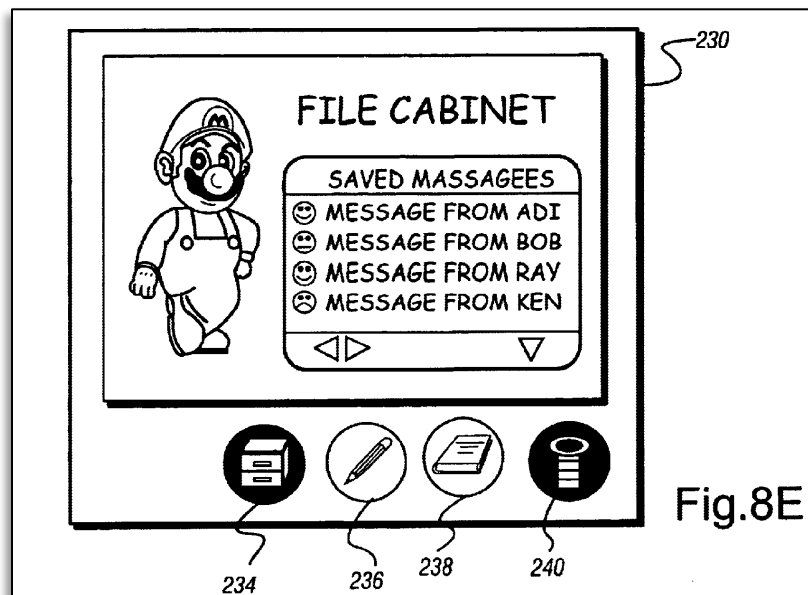
Petitioners cite to Eck, 16:42-45 and 24:30-36, for the proposition that “PagerWorld supports transmission of messages ‘with images and sound bytes to other pagers in the network....’” Petition, 80-81. However, those citations are clearly unrelated to PagerWorld.

Petitioners also cite Eck, 24:30-36, but it does not relate to PagerWorld. *See* Ex.2050, ¶166. It is part of a discussion of an “Example Digital Camera,” including its structure and circuitry. *See* Eck, 23:35-24:65. If anything, Petitioners’ citation to this embodiment actually supports Patent Owner: the discussion is of radio circuitry integrated in the game machine and functionality without reference to any game cartridge or PagerWorld; the message-sending functionality is separate from any alleged application-based information channel. Petitioners and their expert never directly address that these are disparate embodiments.

Moreover, Petitioners actually admit the distinction, stating: “***In addition to messaging (e.g., paging functions)***, the message cartridge ‘can be used in game playing.’” Petition, 79 (citing Eck, 9:60-61). Not every messaging/paging function in Eck relates to game play like PagerWorld, and Petitioners’ mixing of

embodiments without explanation is improper. *Reactive Surfaces Ltd.*, IPR2019-00867, Paper 6 at 8 (quoting *In re Stepan Co.*, 868 F.3d at 1345-46 n.1); *see also Arigna Technology*, IPR2022-01037, Paper 9 at 20; *Samsung SDI Co.*, IPR2017-02116, Paper 8 at 21; *Abiomed*, IPR2017-01204, Paper 8 at 8-12.

Furthermore, whereas Petitioners identify photos/images and sound as the captured content for insertion in the channel, they identify no supporting disclosure. Petitioners discuss the Message Center in support (Petition, 81-82), but there is no disclosure of inserting or designating a captured photo or sound. Through the Message Center, a user can arrive at a Compose Message screen 290 (Figure 8E, reproduced below), but that message is simply text, with no ability for media data to be added (the only options being selecting letters 222 or symbols from a dictionary 224).



Eck, Figure 8E.

4. Pelkey and Eck do not teach or suggest the integration of “one content item and information associated with at least one wireless networking functionality of the mobile device” (Limitation 1[B]/9[D])

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, 76. 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, 76-78; 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 mobile device 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-MR, TP-DA/OA, TP-PID, TP-SCTS, etc.). Ex.2050, ¶81. These protocol header data octets are discarded by the SMSC 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.

Rather, Petitioners conclude that Eck’s single passing reference to GSM and WAP technology is sufficient to meet this limitation. Petition, 76; Eck, 25:17-19 (“The present invention may also be applied to other wireless technologies such a GSM [] and WAP.”). Despite no reference to SMS in Eck, Petitioners conclude that a POSITA would have been motivated to specifically use the GSM-SMS network layer as opposed to GSM-GPRS, the native IP protocol layer of GSM that is already compliant with WAP services, to implement WAP over GSM. Ex.2050, ¶¶86-87 (citing Ex.1014, 38). Petitioners again rely on verbatim copy-pasting of Houh’s conclusory statements to argue that a POSITA would know that WAP over GSM-SMS protocols disclose integrating content with information from wireless functionality. *Compare* Petition 76-78, *with* Ex.1003, ¶¶276-280.

As explained above in Section II.B.4.c, 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.2050, ¶¶169-170. Houh states that display of a sending user’s name and associated persona image demonstrates this limitation. Ex.1003, ¶279. 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.2050, ¶¶76-79. 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.2050, ¶¶169-170. The inclusion sender identity and persona image is a function of the application-based information channel as described in Eck, not of the wireless network functionality of the mobile device. Ex.2050, ¶170.

Moreover, the use of WAP where WAP uses GSM-SMS as the bearer network further belies Petitioners' arguments. WAP is not constrained as SMS is to a single 140byte message. Ex.2050, ¶85. Rather, WAP requires a packet data transport protocol to segment much larger data elements into packets and reassemble the packets on the receiver device like in the common IP protocol. Ex.2050, ¶¶85-86. The use of GSM-GPRS, for example, already uses a segmentation and reassembly feature and does not require a specific header protocol from WAP. Ex.2050, ¶86 (citing Ex.1014, 38). Indeed, the only required fields in a WDP datagram protocol are the destination port and the source port if the bearer network has a segmentation and reassembly feature. Ex.2050, ¶85 (citing Ex.1014, 38). However, GSM-SMS does not have a segmentation and reassembly feature because the GSM-SMS system is only capable of sending individual messages and is otherwise incapable of operating with WAP. Thus, WAP must improvise using a TPDU adaptation protocol to operate over GSM-SMS. Ex.2050, ¶87.

The WDP classifies SMS as a “narrow-band” data transport mechanism as a store-and-forward bearer. Ex.1014, 11. Because the bearer lacks proper segmentation and reassembly protocols, WDP must prepend new headers to every 140-byte fragment as SMS user data, which are stripped once the fragments are reassembled. Ex.2050, ¶¶88, 171. Consequently, any per-fragment bearer header is temporary and does not persist in the reconstructed content item, defeating Petitioners’ integration theory.

Essentially, whatever content transmitted via WAP over a GSM-SMS network must be sent as a data packet within GSM-SMS message(s) that simulates packet data transmission protocol. Ex.2050, ¶¶87-89. The only header information included in the SMS message header is the necessary information to get the SMS message from the mobile device to the WAP servers. *See* Ex.1014, 18 (showing Figure 4-4, the transport profile for WDP over GSM-SMS). Moreover, the WDP header information that is included in the content of the GSM-SMS message is only the addressing scheme, the origination and destination ports, and the segmentation and reassembly references necessary to reassemble the data from all the short messages. Ex.2050, ¶¶87-89 (citing Ex.1014. 39-40). Further, once the data has been received at the destination server it will be repackaged with distinctly new headers for compatible transmission to any receiving user device. As such, Petitioners cannot point to one piece of header data from a mobile device, for either

GSM-SMS or WAP that would be integrated with the content items itself to create at least one “integrated content item,” as required by the claims.

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.2050, ¶89. 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.

Petitioners’ arguments regarding limitation 12[C]/17[F]/21[B]/22[D] suffer from the same issues and deficiencies, as do the arguments for claim 8 (which incorporates the limitations of claim 1), claim 11 (which incorporates the limitations of claim 9), and claim 16 (which incorporates the limitations of claim 12).

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.

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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 11,495 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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