

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM SERVICES LLC,

Petitioner,

v.

SMART SPEAKER LLC,

Patent Owner.

Patent No. 12,316,706

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Inventors: Yehuda Binder and Benjamin Maytal

Title: SYSTEM AND METHOD FOR SERVER BASED CONTROL

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2026-00146

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Exhibit No.	Description of Document
2001	Plaintiff's Disclosure of Asserted Claims and Infringement Contentions in <i>Smart Speaker LLC v. Amazon.com Servs. LLC</i> , Case No. 2:25-cv-00707-JRG (E.D. Tex.), dated September 16, 2025
2002	Defendant's Invalidity and Subject Matter Eligibility Contentions in <i>Smart Speaker LLC v. Amazon.com Servs. LLC</i> , Case No. 2:25-cv-00707-JRG (E.D. Tex.), dated December 9, 2025
2003	Federal Register, Vol. 90, No. 199, dated Friday, October 17, 2025
2004	Second Amended Docket Control Order (Dkt. 33) in <i>Smart Speaker LLC v. Amazon.com Servs. LLC</i> , Case No. 2:25-cv-00707-JRG (E.D. Tex.), dated October 29, 2025
2005	Letter to Amazon.com, Inc. re May Patents Ltd. Patent Portfolio, dated July 23, 2024
2006	Appeal Statistics, Patent Trial and Appeal Board, dated October 31, 2025
2007	Patent Trial and Appeals Board (PTAB) data at a glance December 2025

I. INTRODUCTION

On November 21, 2025, Amazon.com Services LLC (“Petitioner”) submitted a petition (Paper 2, “Petition” or “Pet.”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 12,316,706 (EX1001, the “’706 Patent”), challenging Claims 1-29 (the “Challenged Claims”) as obvious over two sets of prior art combinations across sixteen grounds. The Petition should be denied in its entirety because neither set of prior art discloses core limitations of Claim 1.

The ’706 Patent claims a client device for use with a WLAN in a building, configured to capture human voice data, send it over the Internet to an external server for processing, and receive distinct “*first*” and “*second*” messages back from the server—the “*first message*” causing the client device to operate its own actuator, and the “*second message*” causing the client device to send a “*control message*” to a separate controlled device over the WLAN. Pet. at ix. This architecture places the client device at the center of the control scheme: the client device both operates its own actuator and relays control commands to other devices in the home. Two independent deficiencies run through every ground and are dispositive.

First, Grounds 1–8 rely on Lim (EX1005) as the primary reference. Lim does not disclose the claimed “*first message*” or “*second message*.” Lim’s server functions as a speech recognition engine that returns recognition data—*e.g.*, confirming that the user said “Samsung”—to the client device, which then

independently determines what actuator operation to perform based on its own pre-programmed app logic. That is not a server-generated “*message*” that directs actuator operation as Claim 1 requires. For the “*second message*,” the Petition alternatively points to Lim’s “command code data” downloaded from a server database. But this is a pre-existing static codeset—a library of IR/RF command codes—that is merely retrieved from a database, not a “*message*” generated by the server “*in response to*” the sending of captured voice data. Further, the FIG. 6 workflow on which the Petition relies does not disclose any server generating or sending messages at all. None of the secondary references in Grounds 2–8 remedies these deficiencies.

Second, Grounds 9–16 rely on the combination of Williams (EX1006) and Lim. Williams does not disclose at least the claimed “*second message*” that causes the “*client device*” to “*send[], to the controlled device over the WLAN, a control message in response to the received second message.*” Williams’ “services 218” are merely the provision of informational content related to various services—*e.g.*, ordering groceries, identifying songs, or answering questions. Williams’ sole mention of device control, in paragraph [0051], does not disclose any server-to-device messaging path or functionality. The Petition concedes that Williams does not disclose a client device sending a “*control message*” to a controlled device, yet the proposed combination with Lim fails to articulate any coherent motivation for grafting Lim’s client-device-as-relay architecture onto Williams’ system—where

services already flow directly from the server to controlled devices. The resulting three-hop architecture of the Williams-Lim system is a product of the Petition's construction, not a reasonable combination of the two references' actual teachings. None of the secondary references in Grounds 10–16 remedies these deficiencies.

Because Grounds 1–8 and Grounds 9–16 each fail to account for multiple limitations of independent Claim 1, the Board should deny institution of the Petition in its entirety.

II. CLAIM CONSTRUCTION

For the purposes of this Preliminary Response only, Patent Owner agrees with Petitioner that the Board need not construe any claims. Pet. at 4-5.

III. LEVEL OF ORDINARY SKILL IN THE ART

For the purposes of this Preliminary Response only, Patent Owner applies Petitioner's definition of a POSITA. Pet. at 4.

IV. PETITIONER HAS NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF SUCCESS FOR THE GROUNDS ADVANCED IN THE PETITION, AND THE PETITION SHOULD BE DENIED

The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) so-called secondary considerations where in evidence. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *KSR Int'l Co. v. Teleflex*

Inc., 550 U.S. 398, 406 (2007). The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983).

The Board has held that a failure to identify the differences between the claimed subject matter and the prior art is fatal to an obviousness challenge. *See Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00355, Decision Denying Institution of *Inter Partes* Review, Paper 9 at 9-10 (P.T.A.B. June 26, 2015) (denying institution for failure to identify the differences between the claimed subject matter and the prior art).

In arriving at an obviousness determination, the Board must sufficiently explain and support the conclusions that the prior-art references disclose all the elements recited in the Challenged Claims and a relevant, skilled artisan not only could have made, but would have been motivated to combine all the prior art references in the way the patent claims and reasonably expected success. *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017). That is, even if all the claim elements are found across a number of references, an obviousness determination must consider whether a person of ordinary skill in the art would have the motivation to combine those references. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *Los Angeles Biomedical*

Rsch. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co., 849 F.3d 1049, 1067 (Fed. Cir. 2017) (vacating and remanding an obviousness determination, in part, because the Board did not make factual finding as to whether there was an apparent reason to combine all three prior art references to achieve the claimed invention and whether a person of skill in the art would have had a reasonable expectation of success from such a combination). This combinability determination, as supported by an articulated motivation to combine, requires a plausible rationale as to why those prior art references would have worked together. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013). Absent some articulated rationale, a “common sense” finding is no different than the conclusory statement “would have been obvious.” *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017). Of additional importance, “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references” *Innogenetics, N.V. v. Abbott Lab’ys*, 512 F.3d 1363, 1373 (Fed. Cir. 2008).

35 U.S.C. § 312(a)(3) requires that an IPR petition must identify, “in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(4) requires that a “petition filed under section 311 may be considered only if . . . the petition provides such other information as the Director may require by regulation.” 37 C.F.R. § 42.104(b)(4) requires that a petition

for *inter partes* review “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.” General knowledge, such as applicant admitted prior art, expert testimony, common sense, and other evidence, that is not prior art consisting of patents or printed publications may not be used to supply a missing claim limitation. *See* July 31, 2025 Memorandum from Acting Director Stewart Regarding Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4). The Board may deny an IPR petition that fails to comply with Rule 104(b)(4). *Id.*

A. The Petition Does Not Show That Lim Discloses “*receiving, from the server device over the Internet via the WLAN, first and second messages, in response to the sending of the captured first and second human voice data,*” as Required by Claim Element 1[D][2], or “*operating the first actuator in response to the received first message,*” as Required by Claim Element 1[D][3]

Claim 1 requires the client device to be configured for “*receiving, from the server device over the Internet via the WLAN, first and second messages, in response to the sending of the captured first and second human voice data*” (limitation 1[D][2]), “*operating the first actuator in response to the received first message*” (limitation 1[D][3]), and “*sending, to the controlled device over the WLAN, a control message in response to the received second message*” (limitation 1[D][4]). Together, these limitations define a voice-command architecture in which the server generates and sends distinct “*messages*” to the client device in response to distinct voice

commands, and those messages cause the client device both to operate its own actuator and to relay a control message to a separate controlled device. As demonstrated below, Lim does not disclose this architecture.

1. Lim’s Server Provides Recognition Data, Not Actuator-Directing “messages”

The Petition maps the “*first message*” to Lim’s server’s speech processing results during the FIG. 4 setup and configuration workflow. Pet. at 32–41. In that workflow, the user speaks a brand name at step 402, and “[t]he resulting spoken syllables may be digitized and presented to a speech recognition means for processing” on “a remote server 500.” EX1005, [0027]. The Petition then argues that the server returns speech processing results to the client device, and the client device operates its actuator (display, speaker, or LEDs) in response—for example, by presenting the next prompt in the setup sequence. Pet. at 38–41; EX1002, ¶¶ 125–129.

But Lim does not disclose the server returning any control “*message*” to the client device during the FIG. 4 workflow. The text of paragraphs [0027]–[0030] describes voice input being sent to the server for speech recognition and then jumps directly to what the client device does next—without identifying any specific data “*message*” transmitted from server to client device in between. The Petition and Dr. Houh fill this gap by asserting that “it would have been obvious” that “speech

processing result(s)” are sent back from the server. Pet. at 32–34; EX1002, ¶¶ 114–115. But the claim requires that the client device be configured for “*receiving*” a “*message*” “*from the server device*”—and nothing suggests that whatever the Petitioner arbitrarily believes are “speech processing result(s)” would constitute a control “*message*” as claimed.

Further, even assuming that a recognition result were returned to the client device, Lim does not disclose “*operating the first actuator in response to the received first message*” as required by limitation 1[D][3]. The client device’s actuator operation—displaying the next prompt—is determined by its own pre-programmed app logic, not by any server message. EX1005, [0023]. The server’s contribution at each stage is, at most, limited to providing a binary recognition outcome (*e.g.*, “the spoken word matches ‘Samsung’” or “no match found”). The client device then independently decides which prompt to display, which LED to illuminate, which spoken message to synthesize, and so forth, based on its own local firmware logic: if speech recognition fails, repeat step 402 (*id.*, [0028]); if brand is ambiguous, present a short list at step 404 (*id.*); if the brand is uniquely identified, prompt for model number at step 406 (*id.*, [0029]); if model information is insufficient, solicit additional info at step 410 (*id.*, [0029]). At each stage, the server does not direct the actuator’s operation. It merely provides upstream data that the client’s local firmware uses as one input in its own decision-making process. This is

fundamentally different from Claim 1’s requirement that the client device “*operat[e] the first actuator in response to the received first message*”—which requires the “*message*” itself to cause the actuator operation.

Claim 1’s architecture envisions a server that processes voice data and sends a “*first message*” that directs a specific actuator operation—just as the “*second message*” must direct a specific control action on the controlled device. In Lim’s FIG. 4 workflow, however, the server functions as a speech recognition engine that returns recognition data to the client device, and the client device’s own software logic determines what actuator operation, if any, to perform. That is not “*operating the first actuator in response to the received first message.*”

2. Lim Does Not Disclose a “*second message*” from the Server in Response to “*second human voice data*”

The Petition offers two alternative mappings for the “*second message*” received from the server, and neither satisfies the claim. Pet. at 35–38, 42–46; EX1002, ¶¶ 120–124, 130–135.

First, the Petition argues that the “*second message*” is the “recognized speech (e.g., text strings) or results of further analyzing the recognized speech that allows the client device to determine whether to proceed to block 610.” Pet. at 43; EX1002, ¶ 131. But the Petition’s own framing demonstrates why this cannot be the claimed “*second message*”: basic speech recognition data—e.g., the server confirming that

the user said “power on”—does not itself constitute a “*second message*” in response to which the client device sends “*a control message*” to a “*controlled device over the WLAN*,” as required by limitation 1[D][4]. Claim 1 requires the “*second message*” to be the server’s directive that triggers the client device to send a control command to a separate controlled device. A recognition result that merely “allows the client device to determine whether to proceed to block 610” is an intermediate processing step—the functional equivalent of a “yes/no” gate that the client device evaluates locally—not a server-generated message that causes the client device to relay a control command to a controlled device.

Second, the Petition argues in the alternative that the “*second message*” is the “command code data” downloaded from the server at block 610 of FIG. 6. Pet. at 44–45; EX1005, [0036]; EX1002, ¶¶ 122–123, 132–134. This mapping has two independent deficiencies.

The first deficiency is that the command code data is not downloaded “*in response to the sending of the captured . . . second human voice data*,” as required by limitation 1[D][2]. The claim requires that the “*second message*” be received from the server “*in response to*” the sending of “*second human voice data*” to the server. But Lim’s command code data is not generated by the server in response to processing voice data. It is a pre-existing codeset—a static library of IR/RF command codes—that is merely retrieved from a database. Lim explains that “an

app may draw on a library of codesets suitable for commanding the functional operations of various types of appliances of multiple manufactures and/or models” and that “this library . . . may be located externally at a local PC or remote server device accessible to smart device 110 for the download of only those code sets necessary for operation of the configured appliances.” EX1005, [0024]. Lim separately discloses that the “communication of the setup data may comprise downloading of a complete set of command code data into the controlling device from an off-platform database of codesets located for example . . . on a remote server 500.” *Id.*, [0030]. This is a database retrieval operation—downloading a pre-packaged set of IR/RF codes—not the server generating and sending a “*message*” in response to processing voice data. Lim’s system is fundamentally an app-based universal remote control: the user configures which appliance to control through a setup dialogue, and the app downloads the appropriate codeset from a database. That is architecturally distinct from the claimed system in which the server processes voice data and, in response, generates and sends a “*message*” that causes the client device to send a control command.

The second deficiency is that FIG. 6—the workflow on which the Petition relies for the “*second message*” mapping—does not itself disclose any server generating or sending messages at all. FIG. 6 depicts a local workflow on the client device: “solicit function name” (step 604), determine whether the function is

“uniquely identified” (step 606), “load function data” (step 610), and “transmit signal [from client device] to appliance” (step 614). EX1005, [0035]–[0036], FIG. 6. The server’s only role in this workflow is as an off-screen speech recognition engine and a database from which codesets may be downloaded. There is no disclosure in Lim’s FIG. 6 of the server generating or sending any “*message*” to the client device at all—let alone a “*second message*” sent “*in response to*” the sending of “*second human voice data*,” as the claim requires.

3. All Other Grounds Relying on Lim Alone Fail for the Same Reasons

Claims 5–6, 10, 12, 16, 20–21, 23, and 29 are challenged in Ground 1 alongside Claim 1. Because the Petition’s Ground 1 mapping fails to establish that Lim discloses the “*first message*” and “*second message*” limitations of Claim 1, or that Lim discloses “*operating the first actuator in response to the received first message*,” Ground 1 necessarily fails for every dependent claim that incorporates Claim 1’s limitations.

Additionally, Grounds 2–8 each rely on Lim as their foundation and add one secondary reference (Wittenberg (EX1008), Gruber (EX1009), Benesty (EX1010), Goldsmith (EX1040), Chatterjee (EX1012), Rosenberger (EX1013), and Rossing (EX1014), respectively) to address dependent claim limitations. Pet. at 49–68. None of these secondary references is cited for, or remedies, Lim’s failure to disclose the

“first message,” “second message,” or “operating the first actuator in response to the received first message” limitations. Because Grounds 2–8 inherit Ground 1’s deficiencies in full, they fail for the same reasons. The Board should deny institution on Grounds 1–8.

B. The Petition Does Not Show That Any Combination of Williams and Lim Discloses “receiving, from the server device over the Internet via the WLAN, first and second messages, in response to the sending of the captured first and second human voice data,” as Required by Claim Element 1[D][2], and “sending, to the controlled device over the WLAN, a control message in response to the received second message,” as Required by Claim Element 1[D][4]

Claim 1 requires the client device to be configured for “receiving, from the server device over the Internet via the WLAN, first and second messages, in response to the sending of the captured first and second human voice data.” Pet. at 86. Claim 1 further requires the client device to be configured for “sending, to the controlled device over the WLAN, a control message in response to the received second message.” Pet. at 91. These limitations require two distinct “messages” from the server—a “first message” that causes the client device to operate a first actuator, and a “second message” in response to which the client device sends a control message to a controlled device over the WLAN. Williams discloses neither.

1. Williams Does Not Disclose Sending a “*second message*” to a “*client device*” in Response to Voice Commands the Causes the “*client device*” to “*send[]*, to the controlled device over the WLAN, a control message in response to the received second message”

The Petition’s mapping of the “*second message*” rests on Williams’ disclosure that its server’s applications 120 “may use the information from the event notifications 216 to initiate or customize services 218 on behalf of users associated with the home 102,” and that “[s]uch services may be provided through any of the media devices 106 located in the home, as well as through other application devices 220.” Pet. at 88–89 citing EX1006, [0036]. The Petition then asserts that a POSITA would have understood that “providing services 218 to a controlled device . . . involves sending information (second message) to the controlled device.” Pet. at 89 citing EX1002, ¶ 355.

First, Williams’ “services 218” are not “*messages*” sent to a “*client device*” in response to a voice command which cause the “*client device*” to “*send[]*, to the controlled device over the WLAN, a control message in response to the received second message.” In context, Williams explains that the server’s applications 120 “may use the information from the event notifications 216 to initiate or customize services 218 on behalf of users associated with the home 102.” EX1006, [0036]. Williams then provides eight examples of these “services”: ordering groceries ([0044]), purchasing movie tickets ([0045]), identifying songs ([0046]–[0047]),

answering questions ([0048]), providing driving directions ([0049]), and looking up flight information ([0050]). In each example, the “service” is the delivery of information content to the user—*e.g.*, displaying search results, playing audio answers, or presenting recipes. *See* EX1006, [0044]–[0050]. Thus, Williams’s services 218 do not cause the “*client device*” to “*send[], to the controlled device over the WLAN, a control message in response to the received second message*” as required by the claims because services 218 is merely the provision of information content.

Second, the Petition’s mapping of the “*second message*” relies on two distinct Williams disclosures, neither of which discloses a server-generated control message. For the voice command input, the Petition cites paragraph [0051], which states that “[a]n application *might* also be designed to allow a user to control various on-premises devices and equipment.” Pet. at 76-77 (emphasis added); EX1006, [0051]; EX1002, ¶¶ 323–324. This passage merely states *what* the system can hypothetically do—accept voice commands and interact with devices—but says nothing about *how*. Critically, [0051] is silent on whether the server generates any control message, what form it would take, how it would reach a specific device, or what actuation would result. And for the server’s response—the actual “*second message*”—the Petition does not point to any specific server-generated message at all. Instead, the Petition maps the “*second message*” to Williams’ general disclosure that “services may be

provided through any of the media devices 106 located in the home.” Pet. at 88 citing EX1006, [0036]. But again, “services 218” are content-delivery functions—*i.e.*, grocery ordering, movie tickets, music identification, question-and-answer—not directed control “*messages*.”

Third, the arguments as framed in the Petition confirm that Williams alone does not disclose the claimed “*second message*.” To bridge the gap between Williams’ “services” and the claimed control “*message*,” the Petition inserts the parenthetical “(e.g., a control message)” after “services 218” and then cites three references *outside* of Ground 9 for purportedly “common implementations.” Pet. at 89 and 91 citing EX1019, 3:19–22; EX1009, Claim 1; and EX1012, [0012]. Hence, including Lim, Ground 9 is in actuality a five-reference obviousness combination disguised as a two-reference combination. Regarding the claimed “*second message*,” the Petition has not shown “where [this] element of the claim is found in the prior art patents or printed publications relied upon” for Ground 9. *See* 37 C.F.R. § 42.104(b)(4); *see* July 31, 2025 Memorandum from Acting Director Stewart Regarding Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4) (general knowledge, expert testimony, and common sense “may not be used to supply a missing claim limitation”).

Fourth, FIG. 2 of Williams further confirms this deficiency. FIG. 2 shows “services 218” flowing from applications 120 to media devices 106 and application

devices 220, but these arrows represent the general availability of services through home devices—*i.e.*, the user experiences the service via a particular device. EX1006, [0036], FIG. 2. For instance, Williams explains that a music identification application “may identify the song the user is currently listening to, and in response may provide information about related articles, offer samples, suggest related music and playlists, or present information allowing the user to purchase individual music tracks.” *Id.*, [0047]. Streaming media content to a speaker, however, is fundamentally different from sending a directed control “*message*” to a device in response to a voice command.

2. The Williams-Lim Combination Does Not Disclose a Client-Device-to-Controlled-Device Control Message Path Over the WLAN

Claim 1 requires the “*client device*” to be configured for “*sending, to the controlled device over the WLAN, a control message in response to the received second message.*” The Petition concedes that Williams does not disclose this. Pet. at 92 (“To the extent that Williams does not disclose that the control message is sent from the client device, Lim discloses this.”). The Petition then cross-references its earlier discussion of Lim without further analysis. *Id.* citing “Supra §IV.A.2.i.” This concession is dispositive.

In Williams, services 218 flow directly from the cloud server (application 120 running on server 400) to controlled devices (media devices 106 and application

devices 220). EX1006, FIG. 2, [0036], [0042]. The interface device 116—the purported “*client device*”—is a voice-capture and audio-playback endpoint. There is no arrow, no data flow, and no textual description in Williams of the interface device 116 communicating with media devices 106 or application devices 220 to relay control commands. Williams’ own architecture thus has the server communicating directly with controlled devices, making it unnecessary—and contrary to Williams’ design—to route control commands through the client device.

The Petition’s reliance on Lim to fill this gap fails because there is no coherent motivation for grafting Lim’s client-device-as-relay architecture onto Williams’ system. In Williams, services 218 flow *directly* from the cloud server to controlled devices. *Id.*, FIG. 2, [0036], [0042]. The server already communicates with devices in the home through the network—there is no architectural need to route control commands through the interface device 116. The Petition’s stated motivation for the combination is that routing commands through the client device results in a “more simplified, reliable, and secure system that is easier to scale, troubleshoot, and manage.” Pet. at 90; EX1002, ¶¶ 287–288. But Williams’ architecture achieves exactly the opposite: the server’s direct communication with controlled devices *is* the simplified architecture. Inserting the client device as an intermediary adds complexity—an additional hop, an additional failure point, and additional connection-management requirements—without any disclosed benefit in Williams’

cloud-based system. Indeed, the Petition’s proposed restructuring would require dismantling Williams’ existing server-to-device communication path and replacing it with a three-hop architecture that Williams’ own design actively discourages. The Petition does not explain why a POSITA, starting from Williams’ system with direct server-to-device communication, would be motivated to interpose the client device as a command relay.

The combination thus creates a system found in neither reference: Williams’ cloud server would need to send a “*second message*” to the interface device 116, which would then relay a “*control message*” to the controlled device over the WLAN—but Williams does not disclose a server sending a “*second message*,” and the three-hop architecture of the Williams-Lim system is a product of the Petition’s construction, not a reasonable combination of the two references’ actual teachings.

3. All Other Grounds Relying on the Williams-Lim Combination Fail for the Same Reasons

Claims 5–6, 10, 12, 16, 20–21, 23, and 29 are challenged in Ground 9 alongside Claim 1. Because the Petition’s Ground 9 mapping fails to establish that the Williams-Lim combination discloses the “*first message*” and “*second message*” limitations of Claim 1, or a client-device-to-controlled-device message path over the WLAN, the Petition necessarily fails to show that the Williams-Lim combination renders obvious any of the dependent claims that incorporate Claim 1’s limitations.

Additionally, Grounds 10–16 each rely on the Williams-Lim combination as their foundation and add one secondary reference (Wittenberg (EX1008), Gruber (EX1009), Benesty (EX1010), Goldsmith (EX1040), Chatterjee (EX1012), Rosenberger (EX1013), and Rossing (EX1014), respectively) to address dependent claim limitations. Pet. at 94–100. None of these secondary references is cited for, or remedies, Williams’ failure to disclose the “*first message*,” “*second message*,” or client-device-to-controlled-device message path limitations of Claim 1. Accordingly, Grounds 10–16 fail for the same reasons as Ground 9.

In sum, the Petition has not identified where in Williams the “*first message*” and “*second message*” limitations of Claim 1 are found. Williams’ “services 218” are not “*messages*”—they are the informational content delivered through home devices. Further, the Petition concedes that Williams does not disclose a client device sending a “*control message*” to a controlled device, yet the combination with Lim fails to cure this deficiency. Because these deficiencies are present in every ground relying on the Williams-Lim combination, the Board should deny institution on Grounds 9–16. Because the Petition has not shown “where each element of the claim is found in the prior art patents or printed publications relied upon” as required by 37 C.F.R. § 42.104(b)(4), institution of Grounds 9–16 should be denied.

V. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board

deny institution of the Petition in its entirety.

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE has 4,741 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

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