

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC, SAMSUNG ELECTRONICS CO. LTD.,  
AND SAMSUNG ELECTRONICS AMERICA, INC.,  
Petitioner,

v.

MULTIMODAL MEDIA LLC,  
Patent Owner.

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IPR2024-00056  
Patent 7,929,949 B2

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Before WILLIAM V. SAINDON, NEIL T. POWELL, and  
SCOTT RAEVSKY, *Administrative Patent Judges*.

RAEVSKY, *Administrative Patent Judge*.

DECISION  
Granting Institution of *Inter Partes* Review  
35 U.S.C. § 314

## I. INTRODUCTION

Google LLC, Samsung Electronics Co. Ltd., and Samsung Electronics America, Inc. (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1, 2, 4, 5, and 9 of U.S. Patent No. 7,929,949 B2 (Ex. 1001, “the ’949 patent”). Pet. 1. Multimodal Media LLC (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless it is determined that there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition. After considering the parties’ arguments and evidence, and for the reasons set forth below, Petitioner demonstrates a reasonable likelihood of prevailing with respect to at least one of the challenged claims of the ’949 patent. Accordingly, we institute an *inter partes* review with respect to all challenged claims and grounds asserted in the Petition. 37 C.F.R. § 42.108(a).

Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far. This is not a final decision as to patentability of the challenged claims.

## II. BACKGROUND

### A. Related Matters

The parties identify the following infringement lawsuits involving the ’949 patent: *Multimodal Media LLC v. Samsung Electronics Co.*, No. 2:22-cv-00462 (E.D. Tex.) and *Multimodal Media LLC v. TCL Technology Group Corporation*, No. 2:22-cv-00463 (E.D. Tex.) (collectively, the “District Court litigation”). Pet. 2; Paper 6, 2.

*B. Real Parties-in-Interest*

Petitioner identifies itself as the real parties-in-interest (RPI). Pet. 2. Patent Owner identifies itself as the sole RPI. Paper 6, 2.

*C. The '949 patent*

The '949 patent describes a method and system to enable a recipient to interact with an interactive multimodal message triggered on the recipient's mobile device. Ex. 1001, code (57). A “multimodal message” is a seamless combination of graphics, text, and audio output or a combination of the above modalities with speech, text, and touch input or vice-versa.” *Id.* at 3:10–13. Figure 2 is reproduced below.

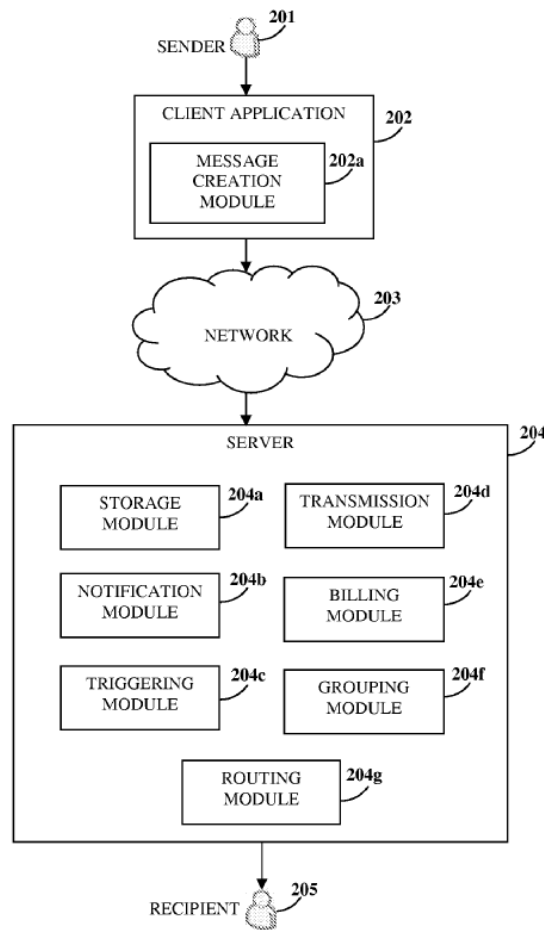


FIG. 2

Figure 2 depicts a system for enabling a recipient to interact with an interactive multimodal message triggered on a mobile device of the recipient. *Id.* at 2:62–64. Sender 201 creates the interactive multimodal message using client application 202. *Id.* at code (57). Server 204 stores the created interactive multimodal message. *Id.* Server 204 sends a notification to recipient's 205 mobile device. *Id.* The notification comprises a pointer to the stored interactive multimodal message. *Id.*

The stored interactive multimodal message is triggered on recipient's 205 mobile device when the pointer in the notification is accessed. *Id.*

Service information is transmitted to recipient's 205 mobile device through the triggered interactive multimodal message. *Id.* The interactive multimodal message triggered on recipient's 205 mobile device enables the recipient interaction. *Id.* The interactive multimodal message may be forwarded to one or more second recipients simultaneously. *Id.* At least a part of the forwarded interactive multimodal message is displayed differently to each of the second recipients. *Id.*

*D. Challenged Claims*

Claim 1, below, is illustrative of the challenged claims. Petitioner's claim element labels are included for ease of reference.

1. [pre] A method of enabling a recipient to interact with an interactive multimodal message triggered on a mobile device of said recipient, comprising the steps of:
  - [a] creating said interactive multimodal message by a sender using a client application available to said sender, wherein said created interactive multimodal message is stored at a server;
  - [b] sending a notification comprising a pointer to said stored interactive multimodal message to said mobile device of the recipient by said server;
  - [c] triggering the stored interactive multimodal message on the mobile device of the recipient by accessing said pointer in said notification; and
  - [d] transmitting service information to the mobile device of the recipient through said triggered interactive multimodal message;
  - [e] whereby the interactive multimodal message triggered on the mobile device enables said recipient interaction.

Ex. 1001, 9:50–67; *see* Pet. 22–36.

*E. Asserted Grounds of Unpatentability*

Petitioner asserts the following grounds of unpatentability (Pet. 5):

<b>Claim(s) Challenged</b>	<b>35 U.S.C. §<sup>1</sup></b>	<b>Reference(s)/Basis</b>
1, 2, 4, 5, 9	103	Still <sup>2</sup>
1, 2, 4, 5, 9	103	Still, Levkovitz <sup>3</sup>
1, 2, 4, 5, 9	103	Mumick <sup>4</sup>
1, 2, 4, 5, 9	103	Mumick, Levkovitz

Petitioner also relies on the declaration of Dr. Benjamin B. Bederson (Ex. 1002). Patent Owner does not rely on declaration testimony at this stage.

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<sup>1</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102, 103 effective March 16, 2013. The ’949 patent was filed before March 16, 2013, so the pre-AIA versions of §§ 102, 103 apply. Ex. 1001, code (22).

<sup>2</sup> U.S. Publication No. 2008/0182603 A1 to Still, published July 31, 2008 (Ex. 1008).

<sup>3</sup> U.S. Publication No. 2007/0088852 A1 to Levkovitz, published Apr. 19, 2007 (Ex. 1009).

<sup>4</sup> U.S. Publication No. 2008/0004046 A1 to Mumick, published Jan. 3, 2008 (Ex. 1010). Petitioner refers to this reference as Mumick’046, presumably because Petitioner also cites “Mumick’938,” Exhibit 1043. Pet. 5, vii. For simplicity, we refer to Mumick’046 simply as Mumick, and should we need to address Exhibit 1043 during trial, will refer to that reference as Mumick’938.

### III. ANALYSIS

#### *A. Discretion under 35 U.S.C. § 314(a)*

Patent Owner argues that we should exercise discretion under § 314(a) to deny institution in light of the District Court litigation. Prelim. Resp. 13–21.

We consider the following factors when determining whether to deny institution under § 314(a) based on a parallel district court proceeding:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

*Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). We also consider “several clarifications” made by the Director of the United States Patent and Trademark Office (“USPTO”). See USPTO Memorandum, Interim Procedure for Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation, 2 (June 21, 2022) (“Director’s Memo”).<sup>5</sup>

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<sup>5</sup> Available at [https://www.uspto.gov/sites/default/files/documents/interim\\_proc\\_discretionary\\_denials\\_aia\\_parallel\\_district\\_court\\_litigation\\_memo\\_20220621\\_.pdf](https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf).

Patent Owner argues that we should exercise discretion to deny institution for several reasons. There is no stay in the litigation, Patent Owner asserts. Prelim. Resp. 18–19. Patent Owner also argues that the trial in the District Court litigation is scheduled for October 28, 2024, more than seven months before the projected statutory deadline here. *Id.* at 16 (citing Ex. 2001). Patent Owner further asserts that the parties’ investment in the District Court litigation weighs in favor of discretionary denial because “discovery is well under way” and because the parties have exchanged infringement and invalidity contentions, among other investments. *Id.* at 17–18. Patent Owner also asserts that the District Court litigation involves the same claims. *Id.* at 16. Further, Patent Owner asserts that the District Court litigation and the Petition involve substantially the same parties. *Id.* at 15.

Petitioner argues that the trial date may be extended or dismissed based on a pending motion for judgment on the pleadings and a motion to transfer. Pet. 72. There also has been “very little activity in the case,” Petitioner argues. *Id.* Petitioner also notes that co-petitioner Google is not a party to the district court litigation. *Id.* at 73. Finally, Petitioner argues that the Petition presents compelling merits. *Id.* at 74.

Taken holistically, we find Patent Owner’s arguments for discretionary denial unavailing. Although there is no stay in the District Court, this factor weighs only marginally in favor of exercising our discretion to deny institution. The trial court date is set some months earlier than our projected statutory deadline, but the trial date may change, and the parties provide no statistics on median time to trial in the relevant district. Thus, the trial date weighs only slightly in favor of exercising our discretion



to deny institution. *See* Director’s Memo (“[T]he proximity to trial should not alone outweigh all of those other factors.”). Further, although there is an overlap in claims asserted in the district court and before the Board, Patent Owner acknowledges that this proceeding “would not cover any of the references that Petitioner[] raised in the District Court Litigation,” so the lack of overlap in issues weighs against exercising discretion. *See* Prelim. Resp. 19. We also agree with Petitioner that there has been little activity in the District Court litigation, such as the issuance of any substantive orders. *See* Pet. 74; *Fintiv*, Paper 11 at 9–10.

In sum, although there is no stay and an early trial date, we find that the uncertainty of that trial date, the current lack of progress of the District Court litigation, and the lack of overlapping issues weigh against exercising our discretion. *See* Director’s Memo 2 (“[T]he precedential import of *Fintiv* is limited to facts of that case.”). We therefore need not reach Petitioner’s assertion of compelling merits. *See* Pet. 74; *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 6 (Vidal Feb. 27, 2023) (precedential) (“The Board should first assess *Fintiv* factors 1–5; if that analysis supports discretionary denial, the Board should engage the compelling merits question.”).

We accordingly decline to discretionarily deny institution in view of the related District Court litigation.

*B. Principles of Law*

Petitioner bears the burden to demonstrate unpatentability. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

A claim is unpatentable as obvious if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). We resolve the question of obviousness based on underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the prior art and the claims; (3) the level of skill in the art; and (4) when in evidence, objective indicia of nonobviousness. *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

We apply these principles to the Petitioner’s challenges.

*C. Level of Ordinary Skill in the Art*

We review the grounds of unpatentability in view of the understanding of a person of ordinary skill in the art at the time of the invention. *Graham*, 383 U.S. at 13, 17. Petitioner asserts that

A person of ordinary skill in the art at the relevant time (“POSITA”) would have had a bachelor’s degree in electrical engineering, computer science, computer engineering, or a related field, and two-three years of experience with multimedia and Internet-related communications technologies, or the equivalent, with additional education substituting for experience and vice versa.

Pet. 7 (citing Ex. 1002 ¶¶ 28–30).

Patent Owner agrees with Petitioner’s proposed level of skill in the art at this stage. Prelim. Resp. 3. We are persuaded, on the present record, that Petitioner’s proposal is consistent with the problems and solutions in the ’949 patent and prior art of record. We adopt Petitioner’s definition of the level of skill for the purposes of this Decision.

*D. Claim Construction*

In *inter partes* review, we construe a claim using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b).

Petitioner proposes constructions for the terms “multimodal message,” “service information,” “client application,” and “pointer.” Pet. 8–13. Patent Owner does not dispute any of these constructions. Prelim. Resp. 3–4. Patent Owner also asserts that Petitioner appears to treat the preamble of claim 1 as limiting and agrees that it is limiting. *Id.* at 4. Because none of these terms are in dispute, none of these terms require construction at this stage, and we need not determine whether the preamble of claim 1 is limiting. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

Petitioner also asserts that the term “interactive multimodal message” has its plain meaning, but Petitioner does not explain what that plain meaning is. Pet. 8–9. Patent Owner agrees with Petitioner that this term should have its plain meaning but also provides a construction for “interactive.” Prelim. Resp. 3; *see also id.* at 7. We address the meaning of this term in the context of the parties’ merits arguments below.

*E. Asserted Obviousness over Still alone or over Still and Levkovitz*

Petitioner contends that claims 1, 2, 4, 5, and 9 would have been obvious over Still alone or over the combination of Still and Levkovitz. Pet. 19–45.

*1. Overview of Still*

Still describes a system and method for delivering messages and/or multimedia content using a short message services (SMS) telecommunication network. Ex. 1008, code (57). Mobile devices are coupled to the telecommunication network. *Id.* A sender may distribute the message using a mobile device to a recipient on another telecommunication network. *Id.* In one embodiment, a message is requested using a unique pairing identifier and the message is streamed to the recipient. *Id.* The message may include a multimedia content, and may be based on a demographic trait of the recipient. *Id.*

*2. Overview of Levkovitz*

Levkovitz describes devices, systems and methods of presentation of advertisements on a wireless device. Ex. 1009, code (57). For example, a wireless communication device includes a display unit to display one or more user-selectable operations selectively associated with an advertisement embedded within an incoming message. *Id.*

*3. Independent Claim 1*

*a. Undisputed limitations*

Petitioner asserts that Still discloses the preamble and all the limitations of claim 1. Pet. 19–45. Petitioner identifies where Still teaches these limitations, supporting this showing with testimony from Dr. Bederson. *See id.* Apart from the word “interactive” in the phrase

“interactive multimodal message,” which appears in the preamble and every limitation of claim 1, Patent Owner does not dispute Petitioner’s showing. *See* Prelim. Resp. 5–9.

We determine, on this record, that Still alone discloses the preamble (whether or not limiting) and these limitations, except that we specifically address the term “interactive” in the next section. *See LG Elecs., Inc. v. Conversant Wireless Licensing S.A.R.L.*, 759 F. App’x 917, 925 (Fed. Cir. 2019) (nonprecedential) (“The Board is ‘not required to address undisputed matters’ or arguments about limitations with which it was never presented.”) (quoting *In re NuVasive, Inc.*, 841 F.3d 966, 974 (Fed. Cir. 2016)). Because we preliminarily determine that Still discloses the preamble and these limitations, we need not determine at this stage whether the combination of Still and Levkovitz discloses them.

*b. “interactive multimodal message”*

Petitioner contends that Still discloses the claimed “interactive multimodal message.” Pet. 22–23. Still teaches a message, Petitioner argues, by disclosing an intended recipient receiving a message from a sender. *Id.* at 22 (citing Ex. 1008 ¶ 7). Petitioner further points to disclosure in Still regarding the multimodal nature of this message, namely that “multimedia content . . . may be associated with the message” and “streamed to the recipient each time” they “request[] the message.” *Id.* (citing Ex. 1008 ¶ 45). Petitioner also asserts that “[a] POSITA would have understood that Still’s messages with multimedia content are interactive multimodal messages because they comprise a seamless combination of graphics, text, and audio output or a combination of the same with speech, text, and touch input.” *Id.* at 23 (citing Ex. 1002 ¶ 74).

As for the “interactive” portion of the claimed message, Petitioner argues that Still enables the recipient to “interact” with the message. *Id.* (citing Ex. 1008 ¶ 22). “Specifically,” Petitioner argues, “Still states that the recipient ‘may access the content . . . to listen and/or view’ it, ‘dedicate’ it to a recipient, or ‘forward’ it to a recipient.” *Id.* (citing Ex. 1008 ¶ 22). In so arguing, Petitioner cites the ’949 patent’s disclosure, which provides “examples of recipient ‘interaction’ including the recipient ‘forwarding the interactive multimodal message’ to another recipient.” *Id.* (quoting Ex. 1001, 5:34–39).

Patent Owner argues that Still’s messages are not interactive. Prelim. Resp. 6–7. That is because Petitioner’s statement regarding the knowledge of a skilled artisan “parrots back [Petitioner’s] construction of ‘multimodal message’” but “does not explain or disclose how these alleged multimodal messages are ‘interactive,’” Patent Owner argues. *Id.* at 6 (citing Pet. 23). Patent Owner further argues that merely viewing, dedicating, or forwarding Still’s message does not make the message “interactive” under the plain meaning of that term. *Id.* at 7. Patent Owner then discusses the Petition’s reference to the “forwarding” example in the specification, reproducing the following specification passage from the ’949 patent:

The interaction with the interactive multimodal message by the recipient 205 may, for example, comprise ending the interactive multimodal message, replying to the interactive multimodal message, or *forwarding* the interactive multimodal message to one or more second recipients.

*Id.* (quoting Ex. 1001, 5:34–39) (emphasis added). Patent Owner argues that “[t]his statement is not lexicography,” and “these three examples of recipient ‘interaction’ are not what make the multimodal message interactive.” *Id.* In Patent Owner’s view, what makes a message interactive under the plain

meaning of that term is “two-way communication.” *Id.* Patent Owner also points to specification language that a “text message itself is non interactive” and argues that Still merely discloses “a non-interactive text message that is associated with some other form of media data.” *Id.* at 8 (citing Ex. 1001, 1:52–59) (emphasis omitted).

On this record, we agree with Petitioner that Still discloses the claimed interactive multimodal message. We agree that Still’s message is multimodal because it includes “a seamless combination of graphics, text, and audio output or a combination of the same with speech, text, and touch input.” Pet. 23 (citing Ex. 1002 ¶ 74). For example, as Petitioner explains, Still discloses that “multimedia content . . . may be associated with the message” and “streamed to the recipient each time” they “request[] the message.” *Id.* at 22 (citing Ex. 1008 ¶ 45). We also agree with Petitioner that Still discloses multimedia content including “music, electronic books, and other forms of audio entertainment content, as well as video content, voice messages, animation content, or other forms of content for communication, advertising, entertainment, etc.” *Id.* (citing Ex. 1008 ¶ 45). We consider these disclosures sufficient at this stage to support Dr. Bederson’s testimony that Still discloses a multimodal message, and we therefore disagree with Patent Owner’s contention that Dr. Bederson’s testimony is unsupported. *See* Prelim. Resp. 6.

We also agree with Petitioner that Still’s disclosure of forwarding a message to a recipient discloses the claimed “interactive” functionality of the multimodal message. *See* Pet. 23 (citing Ex. 1008 ¶ 22). Petitioner persuasively points to the ’949 patent’s disclosure of “forwarding” as an example of recipient “interaction” with the interactive multimodal message.

*Id.* (citing Ex. 1001, 5:34–39). Patent Owner’s counter that the ’949 patent does not define “interactive” is unavailing because the specification explicitly includes “forwarding the interactive multimodal message” as an example of “[t]he interaction.” Prelim. Resp. 7; Ex. 1001, 5:34–39.

We do not understand Petitioner to be arguing for lexicography, as Patent Owner asserts. Prelim. Resp. 7. Rather, we understand Petitioner to be arguing that the claimed “interactive” functionality is explicitly described in the specification as including “forwarding.” *See* Pet. 23. Patent Owner’s lexicography argument overlooks that “[a] claim construction that excludes a preferred embodiment is rarely, if ever correct and would require highly persuasive evidentiary support.” *Kaufman v. Microsoft Corp.*, 34 F.4th 1360, 1372 (Fed. Cir. 2022) (quotation omitted). Because the ’949 patent lists “forwarding” as an example of “interaction,” we determine on this record that “forwarding” is encompassed by the term “interactive” in claim 1. *See* Ex. 1001, 5:34–39. Patent Owner cites no evidence for its assertion that “interactive” requires “two-way communication” instead of forwarding. *See* PO Resp. 8. Thus, there is no “highly persuasive evidentiary support” on this record that would counsel excluding “forwarding” from the claimed “interactive.” *See Kaufman*, 34 F.4th at 1372.

Thus, on this record, we find that Still discloses the claimed “interactive multimodal message.”

*c. Summary as to Claim 1*

Based on the preliminary record before us, Petitioner has shown a reasonable likelihood that claim 1 would have been obvious over Still alone. Because we preliminarily agree with Petitioner regarding obviousness over



Still alone, we save for trial the issue of whether Still and Levkovitz would have rendered claim 1 obvious.

4. *Dependent Claims 2, 4, 5, 9*

Petitioner contends that dependent claims 2, 4, 5, and 9 would have been obvious over Still alone or over the combination of Still and Levkovitz. Pet. 37–45. Patent Owner does not specifically contest these claims at this stage. We leave for trial the issue of whether Petitioner establishes that Still alone or the combination of Still and Levkovitz would have rendered obvious claims 2, 4, 5, and 9.

F. *Asserted Obviousness over Mumick alone or Mumick and Levkovitz*

Petitioner also contends that claims 1, 2, 4, 5, and 9 would have been obvious over Mumick alone or over the combination of Mumick and Levkovitz. Pet. 46–70.

1. *Overview of Mumick*

Mumick describes methods for combining speech with existing text wireless Short Message Service (SMS) to create a multimodal SMS service. Ex. 1010, code (57). A user of standard SMS text service is provided with a link within each message that allows adding or retrieval of a voice message associated with an SMS text message. *Id.* A speech server in the wireless network may be used for recognition of voice commands, rendering of text into speech, and recording or playing back voice recordings. *Id.* An automatic and unique identification of each message is created to allow retrieval of the message without manually selecting the message. *Id.* Additional services include message lists, integration with voicemail systems, image and video messages, cross-functional applications with Multimedia Messaging Services (MMS) and Enhanced Message Services

(EMS), and extensions of the combination of voice with text SMS to other computing devices such as PDAs and PCs. *Id.*

2. *Independent Claim 1*

a. *Undisputed limitations*

Petitioner asserts that Mumick discloses the preamble and all the limitations of claim 1. Pet. 49–62. Petitioner identifies where Mumick teaches these limitations, supporting this showing with testimony from Dr. Bederson. *See id.* Apart from the word “interactive” in the phrase “interactive multimodal message,” which appears in the preamble and every limitation of claim 1, Patent Owner does not dispute Petitioner’s showing. *See Prelim. Resp.* 10–13.

We determine, on this record, that Mumick discloses the preamble (whether or not limiting) and these limitations, except that we specifically address the term “interactive” in the next section. Because we preliminarily determine that Mumick discloses the preamble and these limitations, we need not determine at this stage whether the combination of Mumick and Levkovitz discloses them.

b. *“interactive multimodal message”*

Petitioner contends that Mumick discloses the claimed “interactive multimodal message.” Pet. 49–50. Mumick teaches a multimodal message, Petitioner argues, by describing that a user “creates a voice message by directly calling the multimodal platform” or “replying to a previous multimodal SMS or text SMS[]” and following prompts “to create a voice recording.” *Id.* at 49 (citing Ex. 1010 ¶ 24). Subsequently, Petitioner argues, Mumick’s platform sends a text message to a recipient, “notifying them that a voice message has been recorded and providing a link . . . which

can be activated to listen to the message.” *Id.* (citing Ex. 1010 ¶ 24). The message may include “text, voice, and image,” Petitioner contends. *Id.* (citing Ex. 1010 ¶ 59).

Mumick’s multimodal message is also interactive, Petitioner asserts, because Mumick “discloses that the recipient may ‘reply to a voice mail by SMS.’” *Id.* at 50 (citing Ex. 1010 ¶ 55). Petitioner notes that “[t]his is how the ’949 [p]atent presents the interaction,” as it provides “examples of recipient ‘interaction’ includ[ing] the recipient ‘replying to the interactive multimodal message.’” *Id.* at 50, n.13.

Patent Owner argues that Petitioner’s Mumick-based challenges fail for the same reason as its Still-based challenges, “namely that the disclosed messages in Mumick[] are not ‘interactive’ as required by the challenged claims.” Prelim. Resp. 10. Patent Owner again faults Petitioner for relying on “the example of ‘forwarding’ the interactive multimodal message in the specification to expand the definition of ‘interactive’ to include every message ever written.” *Id.* (citing Pet. at 50 and n.13). Patent Owner further argues that “merely replying to a voice mail with an SMS does not make the voice mail itself interactive.” *Id.* Moreover, Patent Owner asserts that merely presenting a menu to a recipient when they listen to a voicemail in Mumick does not make the message itself interactive. *Id.* at 11. “All cellular systems will necessarily use some sort of interface that allows a user to reply to a message,” Patent Owner argues, but “[t]hat does not make the messages themselves interactive.” *Id.* at 11.

At this stage, Petitioner persuades us that Mumick discloses the claimed interactive multimodal message. We agree on this record that Mumick teaches a multimodal message by disclosing, for example,

“multimodal SMS” that may include “text, voice, and image.” *See* Pet. 49 (citing Ex. 1010 ¶¶ 24, 59). We also agree on this record that Mumick’s multimodal message is interactive because Mumick “discloses that the recipient may ‘reply to a voice mail by SMS.’” *Id.* at 50 (citing Ex. 1010 ¶ 55).

Patent Owner’s argument is unavailing because it relies on a construction for “interactive” that we have not adopted. As with the Still-based challenges, Patent Owner ignores the disclosure in the ’949 patent specification that “replying” to a message is an example of interaction:

The interaction with the interactive multimodal message by the recipient 205 may, for example, comprise ending the interactive multimodal message, *replying* to the interactive multimodal message, or forwarding the interactive multimodal message to one or more second recipients.

Ex. 1001, 5:34–39 (emphasis added). Not only that, but Patent Owner’s construction for “interactive” further undermines its argument against Mumick. As we note above, Patent Owner views “interactive” as requiring “two-way communication.” Prelim. Resp. 7. It is difficult to see how receiving a message and replying to it, as disclosed in Mumick, does not disclose “two-way communication.” *See* Ex. 1010 ¶¶ 24, 55.

Accordingly, on this record, we find that Mumick discloses the claimed “interactive multimodal message.”

*c. Summary as to Claim 1*

Based on the preliminary record before us, Petitioner has shown a reasonable likelihood that claim 1 would have been obvious over Mumick alone. Because we preliminarily agree with Petitioner regarding

obviousness over Mumick alone, we save the issue of whether Mumick and Levkovitz would have rendered claim 1 obvious for trial.

3. *Dependent Claims 2, 4, 5, 9*

Petitioner contends that dependent claim 2, 4, 5, and 9 would have been obvious over Mumick alone or over the combination of Mumick and Levkovitz. Pet. 62–70. Patent Owner does not specifically contest these claims at this stage. We leave for trial the issue of whether Petitioner establishes that Mumick alone or the combination of Mumick and Levkovitz would have rendered obvious claims 2, 4, 5, and 9.

IV. CONCLUSION

At this stage of the proceeding, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing on its challenges as to at least one challenged claim. At this preliminary stage, we have not made a final determination as to the patentability of the challenged claims or any underlying factual and legal issues.

V. ORDER

It is, therefore,

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of all challenged claims of the '949 patent is instituted with respect to all grounds of unpatentability set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial commencing on the entry date of this Decision.

IPR2024-00056  
Patent 7,929,949 B2

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