

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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IPR2024-00053  
Patent 8,107,978 B2

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Before WILLIAM V. SAINDON, HYUN J. JUNG, and NEIL T. POWELL,  
*Administrative Patent Judges.*

JUNG, *Administrative Patent Judge.*

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

## I. INTRODUCTION

### A. *Background and Summary*

Google LLC, Samsung Electronics Co. Ltd., and Samsung Electronics America, Inc. (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting institution of an *inter partes* review of claims 10–14 of U.S. Patent No. 8,107,978 B2 (Ex. 1001, “the ’978 patent”). Multimodal Media LLC (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

Under 35 U.S.C. § 314, an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the Petition and for the reasons explained below, we determine that Petitioner has shown a reasonable likelihood of prevailing with respect to at least one of the challenged claims.

Thus, we institute an *inter partes* review of claims 10–14 of the ’978 patent on all presented challenges. 37 C.F.R. § 42.108(a) (“When instituting . . . review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”); *see also SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

### B. *Real Parties in Interest*

Petitioner identifies Google LLC, Samsung Electronics Co. Ltd., and Samsung Electronics America, Inc. as real parties in interest. Pet. 2. Patent Owner identifies itself as the real party in interest. Paper 6, 2.

### C. *Related Matters*

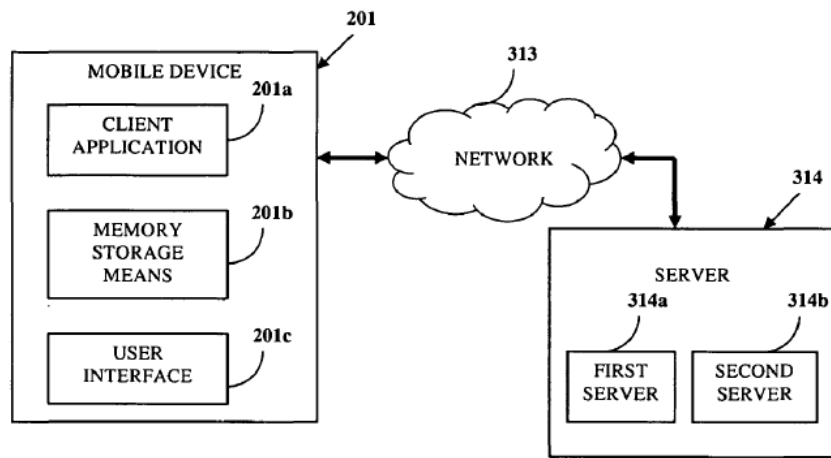
The parties identify *Multimodal Media LLC v. Samsung Elecs. Co. Ltd.*, 2:22-cv-00462-JRG-RSP (E.D. Tex.) and *Multimodal Media LLC v.*

*TCL Tech. Grp. Corp.*, 2:22-cv-00463-JRG-RSP (E.D. Tex.) as related matters. Pet. 2; Paper 6, 2.

*D. The '978 Patent (Ex. 1001)*

The '978 patent issued on January 31, 2012 from an application filed on March 27, 2008 and claims priority to a foreign application filed on April 25, 2007. Ex. 1001, codes (22), (30), (45). The '978 patent also incorporates several patent applications. *Id.* at 1:7–26.

The '978 patent particularly “relates to voice short message service (SMS) messaging using standard methods of recipient addressing as used by text SMS messaging.” Ex. 1001, 1:38–40. According to the '978 patent, “existing methods for voice SMS messaging do not allow the sender to practically use addresses stored in a local address book in the mobile device for selecting the recipients,” and its “system must overcome the limitation of a user input requirement for addressing the recipients of the voice SMS messages.” *Id.* at 1:61–64, 2:1–3. Reproduced below is Figure 3A of the '978 patent.



**FIGURE 3A**

Figure 3A shows “a system for voice short message service messaging.” Ex. 1001, 2:51–52, 5:22–23. The system includes mobile

device 201 and server 314, both connected to network 313. *Id.* at 5:23–25. Mobile device 201 includes client application 201a, memory storage means 201b, and user interface 201c. *Id.* at 5:25–27.

“[C]lient application 201a integrates voice content to a text message created by a user 202 using methods of recipient addressing as used by text short message service messaging.” Ex. 1001, 5:27–30. User 202 can access a list of recipient addresses stored in memory storage means 201b and can input voice and text messages through user interface 201c. *Id.* at 5:32–36.

“In order to integrate 104 the text SMS message with voice content, the client application 201a intercepts 104a the addressed text SMS message,” and “prompts 104b the user 202 as to whether a voice SMS message needs to be included.” Ex. 1001, 7:42–46, Fig. 1. “If the user 202 prefers to additionally add a voice SMS message, the client application 201a connects the mobile device 201 to a server 314.” *Id.* at 7:48–52.

“[S]erver 314 stores the voice messages of the user and transmits a voice message notification with a text message to addressed recipients.” Ex. 1001, 5:36–39. Server 314 can be more than one server, such as first server 314a for storing voice SMS messages and second server 314b for transmitting SMS messages with an attached voice message notification. *Id.* at 5:39–46.

#### *E. Illustrative Claim*

The '978 patent includes 16 claims, of which Petitioner challenges claims 10–14. Of the challenged claims, claim 10, reproduced below, is independent.

10. A system for voice short message service messaging, comprising:

a client application on a mobile device, wherein said client application integrates voice content to a text message created by

a user using methods of recipient addressing as used by text short message service messaging;

a memory storage means on said mobile device for storing a list of addresses of recipients;

a user interface on the mobile device for said user to input voice messages and text messages; and

a server for remotely recording and storing said voice messages of the user, wherein said server is configured to provide access to said recipient for listening to said recorded voice message; and

said client application for transmitting a voice message notification with an addressed text message to said recipients.

Ex. 1001, 102:12–40.

*F. Asserted Prior Art and Proffered Testimonial Evidence*

Petitioner identifies the following references as prior art in the asserted grounds of unpatentability:

| Name                | Reference                                   | Exhibit |
|---------------------|---|---------|
| Mumick <sup>1</sup> | US 2005/0136955 A1, published June 23, 2005 | 1007    |
| Bengtsson           | WO 01/13656 A1, published Feb. 22, 2001     | 1005    |
| Roujinsky           | WO 2007/020627 A1, published Feb. 22, 2007  | 1006    |

Petitioner contends that Mumick and Bengtsson are prior art under § 102(b) and Roujinsky is prior art under § 102(a).<sup>2</sup> Pet. 7 (citing Ex. 1002 ¶ 51), 10,

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<sup>1</sup> Petitioner refers to Ex. 1007 as “Mumick’955;” however, in this Decision, we refer to that exhibit as “Mumick,” because we do not need to discuss Ex. 1043, which Petitioner cites to as “Mumick’938.”

<sup>2</sup> The relevant sections of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284 (Sept. 16, 2011), took effect on March 16, 2013. Because the ’978 patent issued from an application filed before that date, our citations to 35 U.S.C. §§ 102 and 103 in this Decision are to their pre-AIA versions. *See also* Pet. 7 (noting that “[t]he earliest possible priority for the ’978 Patent is April 25, 2007” but taking no position on the proper priority date for any of the claims).

12, 14. Petitioner also provides a Declaration of Dr. Benjamin B. Bederson. Ex. 1002.

*G. Asserted Grounds*

Petitioner asserts that claims 10–14 are unpatentable on the following grounds:

| Claims Challenged | 35 U.S.C. § | References/Basis             |
|-------------------|-------------|------------------------------|
| 10–13             | 103(a)      | Mumick, Bengtsson            |
| 14                | 103(a)      | Mumick, Bengtsson, Roujinsky |
| 10–14             | 103(a)      | Bengtsson, Roujinsky         |

Pet. 4–5.

II. 35 U.S.C. § 314(a)

As noted above in Section I.C., the parties identify related matters. Pet. 2; Paper 6, 2. Petitioner notes that “there is no litigation currently pending against Co-petitioner Google.” Pet. 71. Petitioner, thus, contends that the factors of *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”) do not apply to Google LLC (“Google”), because those factors “depend on actions or activities of a petitioner in a co-pending litigation.” *Id.*

Petitioner also argues that, if the *Fintiv* factors are considered for Google only, “they strongly weigh against denial.” Pet. 71. When the *Fintiv* factors are weighed against the other petitioners, Samsung Electronics Co. Ltd., and Samsung Electronics America, Inc. (collectively, “Samsung”), Petitioner argues that only factor 1 is neutral and the other factors weigh against exercising our discretion under § 314(a) to deny the Petition. *Id.* at 71–74.

Patent Owner argues, *inter alia*, that “two of the three parties are Defendants in the parallel proceeding,” “the asserted claims in the District Court Litigation are all at issue in the Petition,” and “trial in the District Court Litigation is set for October 28, 2024, more than seven months prior to the projected statutory deadline for a Final Written Decision of this Petition on June 14, 2025.” Prelim. Resp. 16–17. Patent Owner also argues that every factor weighs in favor of discretionary denial. *Id.* at 16–22. Patent Owner further argues that any late *Sotera*-style stipulation should not be accepted. *Id.* at 22 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (designated precedential in relevant part) (“*Sotera*”).

*Fintiv* instructs us to consider whether to deny institution in certain circumstances when there is parallel district court litigation, upon consideration of six factors:

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.

*Fintiv*, Paper 11 at 6.

Our analysis of *Fintiv* is guided by the USPTO Director’s Memorandum issued on June 21, 2022, titled “Interim Procedure for

Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation” (“Director’s Memo”). The Director’s Memo states that “the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.” Director’s Memo 3; *see also id.* at 7–8. Thus, we will not exercise our discretion to deny institution if a petitioner makes a stipulation similar to that provided in *Sotera*.

We agree with Petitioner that *Fintiv* does not apply to Google and, even if applied, the *Fintiv* factors weight against denial. Pet. 71–74. As for Samsung, it states that it “will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in the [related] district court Case 2:22-cv-00462-JRG-RSP,” thereby making a stipulation similar to that provided in *Sotera*. Ex. 1047, 1 (citing *Sotera*).

Accordingly, pursuant to the Director’s Memo, we decline to exercise discretion under 35 U.S.C. § 314(a) to deny institution.

### III. ANALYSIS

#### A. Legal Standards

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent [claim] it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016). This burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). The Board may authorize an *inter partes* review if we determine that the information presented in the Petition shows that there is a



reasonable likelihood that Petitioner will prevail with respect to at least one of the claims challenged in the petition. 35 U.S.C. § 314(a).

Petitioner contends that the challenged claims of the '978 patent are unpatentable under § 103. Pet. 4–5. A claim is unpatentable under § 103 if the differences between the claimed subject matter 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). 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) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). When evaluating a combination of teachings, we must also “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Whether a combination of elements produces a predictable result weighs in the ultimate determination of obviousness. *Id.* at 416–417.

*B. Level of Ordinary Skill in the Art*

Petitioner argues that a person of ordinary skill in the art 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 ordinary skill in the art “[f]or purposes of th[e] Preliminary Response only.” Prelim. Resp. 4 (citing Pet. 7). “Patent Owner does not believe that minor deviations from this level of skill in the art would materially change the analysis.” *Id.*

Based on the preliminary record, we adopt Petitioner’s asserted level of ordinary skill to determine whether there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the Petition.

### C. Claim Construction

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

37 C.F.R. § 42.100(b); *see Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

#### 1. “memory storage means on said mobile device for storing a list of addresses of recipients”

Petitioner states that, in related litigation that has been dismissed due to settlement, the parties agreed the limitation quoted above is subject to § 112, ¶ 6. Pet. 8. Petitioner contends that the function is “storing a list of addresses of recipients” and the corresponding structure includes various media and “any other medium from which a computer can read.” *Id.* at 8–9 (citing Ex. 1021, 47); *see also id.* at 8 n.3 (stating that “Petitioner has adopted these constructions only for purposes of this Petition and reserves

the right to propose and/or adopt any construction in any pending litigation matter”).

Patent Owner agrees that applying the interpretation from the related dismissed litigation is proper. Prelim. Resp. 4–5 (citing Ex. 1021, 47).

Based on the preliminary record, we adopt the parties’ agreed-to interpretation of “memory storage means on said mobile device for storing a list of addresses of recipients.” Pet. 8–9; Prelim. Resp. 4–5; Ex. 1021, 47. Specifically, we adopt a means-plus-function interpretation wherein the function is “storing a list of addresses of recipients” and the corresponding structure includes:

a floppy disk, a flexible disk, hard disk, magnetic tape, any other magnetic medium, a Compact Disc-Read Only Memory (CD-ROM), Digital Versatile Disc (DVD), any other optical medium, punch cards, paper tape, any other physical medium with patterns of holes, a Random Access Memory (RAM), a Programmable Read-Only Memory (PROM), an Erasable Programmable Read-Only Memory (EPROM), an Electrically Erasable Programmable Read-Only Memory (EEPROM), a flash memory, any other memory chip or cartridge, a carrier wave as described hereinafter, or any other medium from which a computer can read,

“and equivalents.” Pet. 8–9; Prelim. Resp. 4–5; Ex. 1021, 47.

2. *“wherein the client application transmits one of a text message, a voice message, and a combination thereof”*

Petitioner states that the limitation from claim 13 quoted above was interpreted in the related dismissed litigation to mean “wherein the client application transmits a text message, a voice message, or a combination thereof.” Pet. 9 (citing Ex. 1021, 16–21). Patent Owner agrees with Petitioner’s interpretation. Prelim. Resp. 5 (citing Ex. 1021, 16–21).

Based on the record at this stage, we adopt the parties agreed-to interpretation of “wherein the client application transmits one of a text message, a voice message, and a combination thereof” to mean “wherein the client application transmits a text message, a voice message, or a combination thereof.” Pet. 9; Prelim. Resp. 5; Ex. 1021, 16–21.

3. “*client application*”

Petitioner states that the parties in the related dismissed litigation agreed that “client application” means “a program present on the sender’s mobile device.” Pet. 9 (citing Ex. 1021, 48). Petitioner argues that the claim recites “a client application on a mobile device,” so interpreting “client application” to mean “a program present on the sender’s mobile device” would be redundant. *Id.* at 10 (citing Ex. 1001, claim 1). Petitioner, thus, proposes interpreting “a client application on a mobile device,” and not just “client application,” to mean “a program present on the sender’s mobile device.” *Id.*

“Patent Owner does not believe that applying this construction to the term ‘client application’ or ‘client application on a mobile device’ creates a material difference in claim scope, and the Board need not consider this to resolve the issues raised in the Petition.” Prelim. Resp. 5–6.

Based on the record before us, we agree with Petitioner that the interpretation of “client application” should not include “on the sender’s mobile device,” because claim 10 recites “a client application on a mobile device.” Pet. 9. For our analysis below, we preliminarily adopt Petitioner’s proposed interpretation of the phrase “a client application on a mobile device” to mean “a program present on the sender’s mobile device.” *Id.* at 10.

#### 4. *Remaining Terms*

“Petitioner does not believe that any [other] term requires explicit construction to resolve the issues presented in this Petition,” and “[a]ll others should be given their plain and ordinary meaning.” Pet. 8. Patent Owner does not present any other proposed interpretations. *See generally* Prelim. Resp.

On the record before us, because determining whether to institute trial does not require construing explicitly any other claim term, we determine that no other claim term requires express interpretation at this stage. *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)).

#### D. *Asserted Obviousness Based on Mumick and Bengtsson*

##### 1. *Mumick (Ex. 1007)*

Mumick describes “[c]ombining speech with existing text wireless Short Message Service (SMS), to create a multimodal SMS service,” in which 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.” Ex. 1007, code (57); *see also id.* ¶ 2 (stating Mumick relates specifically to “the addition of speech capabilities to standard text messaging systems creating a multimodal SMS service”). Mumick extends “the combination of voice with text SMS to other computing devices such as PDAs and PCs.” *Id.* at code (57).

Mumick “provides a Multimodal SMS mechanism (MultimodalSMS) combining speech, or other modalities (such as image or video data), with standard text SMS” that “allows users to send and receive voice messages

associated directly with text SMS messages.” Ex. 1007 ¶ 8. Reproduced below is Figure 1 of Mumick.

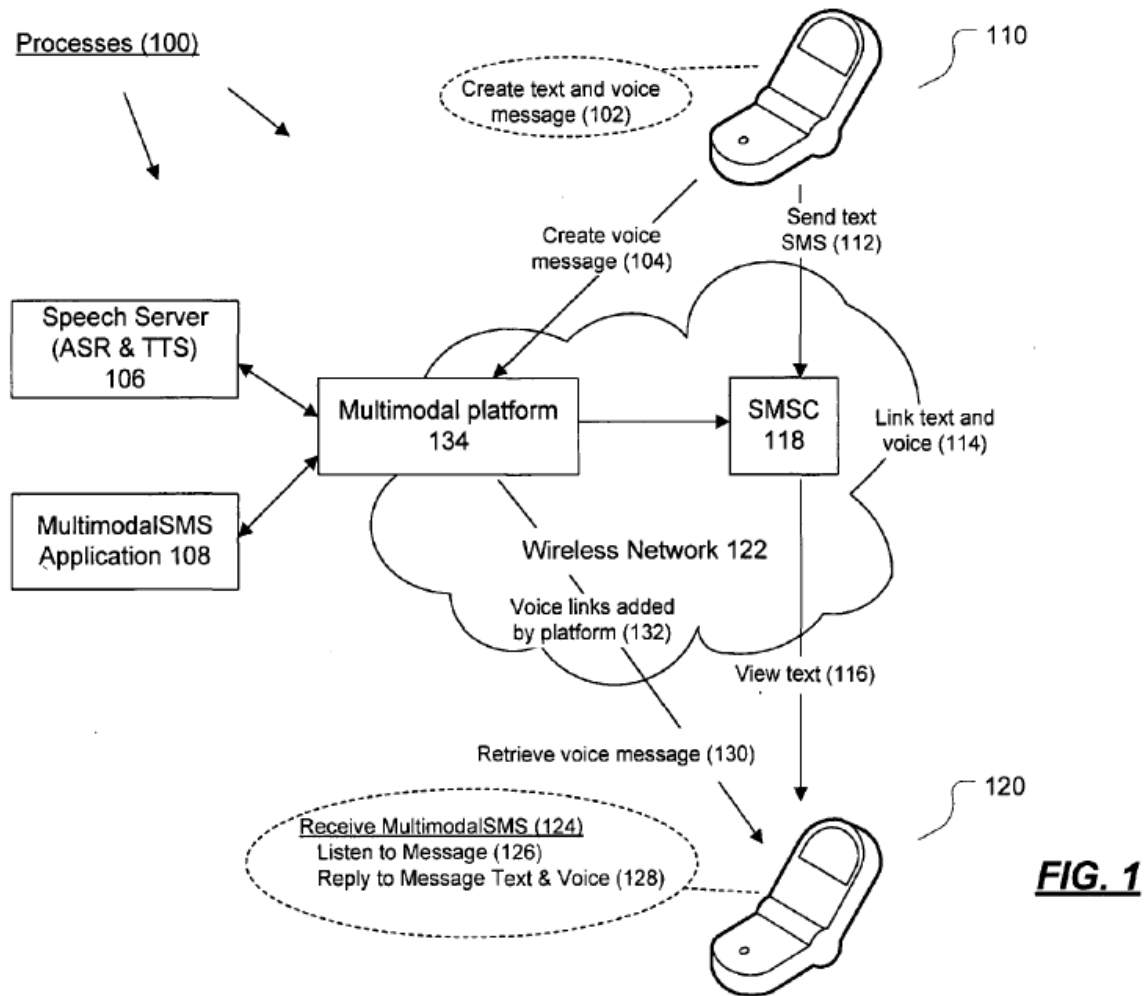


Figure 1 shows processes 100 for creating, sending, and receiving a MultimodalSMS message. Ex. 1007 ¶¶ 14, 16. Mumick’s system includes “user input and/or output devices including those capable of playing and recording speech and those capable of entering and displaying text information” and “an application server for the MultimodalSMS service . . . to combine speech with text messages created using one [of] the input devices and sending such combined messages to a device that provides one or more of the output capabilities.” *Id.* ¶ 9. Mumick’s system can also have “a Short Message Service Center (SMSC) and a Multimodal Platform.” *Id.*

“The text input device is used to compose a message to be sent using standard SMS technology,” and “[t]he MultimodalSMS application combines the text message . . . with a spoken message.” Ex. 1007 ¶ 10; *see also id.* ¶ 40, Fig. 2 (describing and showing an “example process” wherein a user at “telephone device 202” creates a text message, “determines to whom the message is to be sent using whatever mechanisms are provided by the device 202,” and “click[ing] on a MultimodalSMS link in her phone book, or similar mechanism provided by the device, which connects her through the voice network 204 to the Multimodal Platform 134” to add a voice message).

“The recorded voice message is then stored for future retrieval in database 214.” Ex. 1007 ¶ 40, Fig. 2. “The combined message is sent to recipient(s) who then can read the text message and retrieve, from the application server, the associated voice message.” *Id.* ¶ 10.

“In a preferred embodiment, voice is sent as part of an SMS message by including within the SMS message a link to retrieve the voice message from another location (e.g., the SMS message may contain a link to the Multimodal Platform 134 which, when accessed, causes the voice message to be retrieved from the Speech Platform 206 (or from a media server or database).” Ex. 1007 ¶ 40, Fig. 2; *see also id.* ¶ 27 (stating that “[i]t should be noted that the link embedded in an SMS message can be created at the sending device, or by using the Multimodal Platform 134 to SMSC 118 link, or by using a modified SMSC 118”).

“The MultimodalSMS application may provide a user with the capability of storing, editing and applying lists of recipients so that a message can be distributed to a number of recipients,” and “[t]hese lists would be stored in the application Database 214.” Ex. 1007 ¶ 44. “[T]he

lists could be used for addressing MultimodalSMS or even standard text SMS messages.” *Id.* “If contacts are stored in the device, rather than in the network, they can also be used in addressing a MultimodalSMS message” and “could be accessed as part of the Multimodal application, by using an application on the device.” *Id.* ¶ 47.

“The Multimodal Platform 134 component, controlled by the MultimodalSMS application 108, also allows MultimodalSMS message creation and retrieval by other means and with other than standard wireless telephones.” *Id.* ¶ 50. “Any device that supports either Simultaneous or Sequential Multimodal applications, or Web applications, can be used.” *Id.* “As an illustrative example, a PDA that supports simultaneous multimodal applications could be used to enter text via a keyboard while recording the voice portion of the message simultaneously.” *Id.*

2. *Bengtsson (Ex. 1005)*

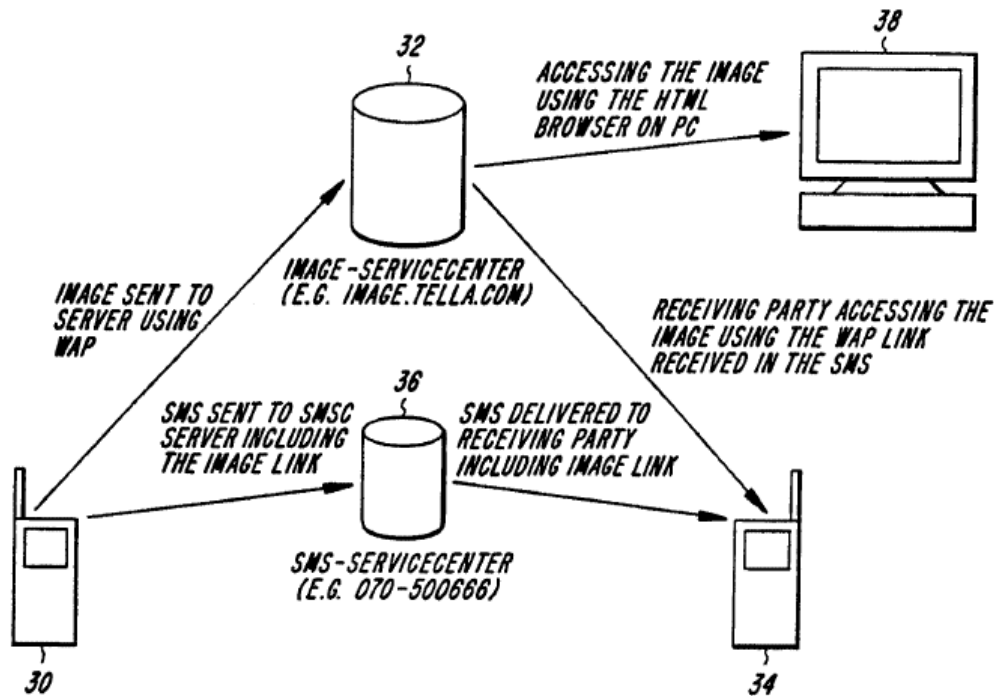
Bengtsson “provid[es] methods and mechanisms for transmitting attachments to text messages without turning terminals into e-mail clients.” *Ex. 1005, 5:4–5.*<sup>3</sup> “When an attachment is to be transmitted, an address of an attachment server is appended to the text message,” and the address “is then forwarded to the intended recipient, e.g., via an SMS server, while the attachment is sent to the attachment server.” *Id.* at 5:5–8. “Upon receipt of the text message, the recipient can then download the attachment from the attachment server using the address included in the text message.” *Id.* at 5:8–10.

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<sup>3</sup> Like Petitioner, we cite to the page numbers of Bengtsson, not the exhibit page numbers.



“[A]n advanced messaging application provides the capability to attach such files to an SMS message for routing within the radiocommunication system.” Ex. 1005, 7:21–23. “[A] user first creates a conventional SMS message in his or her terminal,” and “before the user sends the SMS message, the terminal can ask the user whether an attachment file should be included.” *Id.* at 7:24–26. “If the user opts not to attach a file to the SMS message, then the SMS message is transmitted conventionally,” but if a file is attached, “certain information is added to the SMS message, which is forwarded to the intended recipient, and the attachment is sent to a special server for retrieval by the recipient of the SMS message.” *Id.* at 7:28–8:3. Figure 3 of Bengtsson is below reproduced.



*Fig. 3*

“Figure 3 illustrates a node map used to describe the routing of SMS messages and attachments according to an exemplary embodiment.” Ex. 1005, 5:22–23. “[T]erminal 30 can have stored therein an address, e.g, a uniform resource location (URL) address” to identify server 32 with the

attachment. *Id.* at 8:14–16. “The terminal includes the URL address . . . as part of the text that is sent to the receiving party 34 as an SMS message,” and “terminal 30 may also include the file type (e.g., image, audio, etc.) of the attachment with the URL address in the SMS message.” *Id.* at 8:21–24. “[R]eceiving party 34 thus receives a message containing the text message, the link to the server 32 where the image (or other attached file) is stored and, optionally, a file type associated with the attachment.” *Id.* at 8:25–27.

3. *Independent Claim 10*

a) *Preamble*

Petitioner argues that, to the extent the preamble is limiting, Mumick’s MultimodalSMS teaches “[a] system for voice short message service messaging.” Pet. 23–29 (citing Ex. 1002 ¶ 75; Ex. 1007, Abstract, ¶ 8).

b) *“a client application on a mobile device, wherein said client application integrates voice content to a text message created by a user using methods of recipient addressing as used by text short message service messaging”*

For the limitation quoted above, Petitioner argues that Mumick’s system includes devices that can play and record speech, enter and display text, and access a contacts list. Pet. 24 (citing Ex. 1002 ¶ 76; Ex. 1007 ¶¶ 9, 47, 50). Petitioner also argues that Mumick integrates voice content with a text message. *Id.* at 24–26 (citing Ex. 1002 ¶ 77; Ex. 1007 ¶¶ 8, 27, 40, Fig. 1).

According to Petitioner, one of ordinary skill in the art would have understood that Mumick’s client application integrates voice content with a text message in the same manner as the ’978 patent. Pet. 26 (citing Ex. 1001, 5:7–12, 7:29–36; Ex. 1002 ¶¶ 78–80). Petitioner contends that Mumick also discloses contacts are stored in a device, accessed as part of an

application on the device, and can be used in addressing a message. *Id.* at 26–27 (citing Ex. 1007 ¶ 47).

*(1) Proposed Combination with Bengtsson*

Petitioner also contends that Bengtsson describes additional implementation details, specifically Bengtsson describes that, “instead of having the user select a link, affirmatively ‘prompt[ing]’ a user to optionally attach voice content to a text message.” Pet. 27 (citing Ex. 1005, 6:9–12, 7:21–27). In Petitioner’s view, one of ordinary skill in the art “would have understood that Bengtsson’s advanced messaging application in the mobile terminal is ‘a client application on a mobile device’ because Bengtsson’s invention is described in terms of a client-server architecture, wherein the mobile terminal is the client” and “that Bengtsson’s advanced messaging application in the mobile terminal is a program present on the sender’s mobile device.” *Id.* (citing Ex. 1002 ¶¶ 81–84; Ex. 1005, 5:2–10; Ex. 1025, 91).

Petitioner also argues that Bengtsson describes prompting the user by asking whether a file should be attached. Pet. 28 (citing Ex. 1005, 7:23–8:3, Fig. 3). Petitioner further argues that Bengtsson includes a URL address as part of the text. *Id.* (citing Ex. 1005, 8:21–24, Fig. 3). Petitioner, thus, argues that one of ordinary skill in the art would have understood that Bengtsson’s advanced messaging application integrates voice content with a text message, as claimed and in the same manner as the ’978 patent. Pet. 28–29 (citing Ex. 1001, 3:42–46, 3:48–54, 5:7–12; Ex. 1002 ¶¶ 81, 85–90).

*(2) Asserted Reasons for Combining*

Petitioner argues that Mumick and Bengtsson “relate[] to systems and methods for transmitting multimedia messages, including voice associated

with SMS messages.” Pet. 21–22 (citing Ex. 1005, code (57), 7:7–10, 7:23–8:3; Ex. 1007 ¶¶ 8, 40). Petitioner also argues that one of ordinary skill in the art “would have looked to Bengtsson for additional implementation options and details for integrating a voice message to a text message” and would have been motivated to combine Mumick and Bengtsson because of a recognized “benefit of incorporating the additional functionalities of Bengtsson’s client application on the mobile device, such as its ability to intercept a user’s text message and prompt the user to add a voice message” into Mumick. *Id.* at 22 (citing Ex. 1002 ¶¶ 70–72).

Because Mumick “already teaches a client application on the mobile device that integrates voice content to a text message but explains that the user should click a ‘link in her phone book, or similar mechanism provided by the device,’ to add voice,” Petitioner argues that one of ordinary skill in the art “would have recognized . . . ‘a similar mechanism’” to accomplish such integration would be “to intercept the user’s text message and prompt the user to add voice, as taught by Bengtsson.” Pet. 22–23 (citing Ex. 1002 ¶¶ 72–73; Ex. 1007 ¶ 40).

According to Petitioner, the proposed combination (1) “would have streamlined the process for the user, as opposed to having to click on a separate link as in Mumick’955’s application,” (2) would have “[i]nclud[ed] more user-friendly functionality on a client application on the mobile device,” (3) “would have been an obvious design choice,” and (4) “would have ensured a faster and more flexible and reliable user experience.” *Id.* at 23 (citing Ex. 1002 ¶¶ 32–46, 72–73; Ex. 1025, 78, 97; Ex. 1030, 34; Exs. 1026, 1027, 1029–1041, 1043).

*(3) Reasonable Expectation of Success*

Petitioner also argues that one of ordinary skill in the art would have had a reasonable expectation of success in making the proposed combination because (1) both references “relate[] to systems and methods for transmitting multimedia messages, including voice associated with SMS messages” (Pet. 21 (citing Ex. 1005, Abstract, 7:7–10; Ex. 1007 ¶ 8)), (2) both references “disclose straightforward applications of well-known technologies using standard hardware and software systems such as client applications present on mobile devices and multimodal messaging” (*id.* at 23 (citing Ex. 1002 ¶ 74)) and (3) implementing Bengtsson’s prompting capabilities into Mumick’s client application was well within ordinary skill in the art (*id.* (citing Ex. 1005, 7:23–8:3; Ex. 1007 ¶ 40)). *See also id.* at 29 (arguing similarly) (citing Ex. 1002 ¶¶ 91–93).

*c) “a memory storage means on said mobile device for storing a list of addresses of recipients”*

For the limitation quoted above, Petitioner argues that one of ordinary skill in the art would have understood that Mumick’s phone book and stored contact lists meet the limitation because their function is to store a list of recipient addresses and the corresponding structure is a computer-readable memory. Pet. 30–31 (citing Ex. 1002 ¶¶ 94–96; Ex. 1007 ¶¶ 40, 44, 47, Fig. 1; Ex. 1030, 34).

*d) “a user interface on the mobile device for said user to input voice messages and text messages”*

For the limitation quoted above, Petitioner argues that Mumick discloses a system including a user input device, a text input device, and a microphone for voice messages. Pet. 31–32 (citing Ex. 1002 ¶ 97; Ex. 1007 ¶¶ 9, 10, claim 10, Fig. 1).

- e) *“a server for remotely recording and storing said voice messages of the user, wherein said server is configured to provide access to said recipient for listening to said recorded voice message”*

For the limitation quoted above, Petitioner argues that Mumick discloses a speech server for recording and playing back voice recordings. Pet. 32–34 (citing Ex. 1002 ¶¶ 98, 99; Ex. 1007, Abstract, ¶ 40, Fig. 2). Petitioner also argues that Mumick teaches two servers for recording and storing voice messages, “a server” would have been understood to mean at least one server, and dependent claims 11 and 12 require at least two servers. *Id.* at 34–35 (citing Ex. 1002 ¶ 100).

Petitioner further argues that more than one server would provide redundancy, reliability, and scalability so that one of ordinary skill in the art would have been motivated to use multiple servers that would have been structured to have different services on different servers as known in the art. Pet. 35 (citing Ex. 1002 ¶¶ 100–105; Ex. 1027; Ex. 1029, 29–30, 50–54).

- f) *“said client application for transmitting a voice message notification with an addressed text message to said recipients”*

Petitioner argues that Mumick discloses the above-quoted limitation. Pet. 35–36 (citing Ex. 1002 ¶¶ 106–108; Ex. 1007 ¶¶ 27, 40, 41, claim 10, Fig. 1). Petitioner also argues that, to the extent that one of ordinary skill in the art “would have desired additional implementation details, such as the form of the appropriate links in the voice message notification,” Bengtsson describes a system with an “advanced messaging application” for attaching a voice message notification to an SMS message. *Id.* at 36–38 (citing Ex. 1001, 5:7–16; Ex. 1002 ¶¶ 109–116; Ex. 1005, 7:21–25, 8:21–29, 9:1–10, Fig. 3; Ex. 1025, 91).

According to Petitioner, one of ordinary skill in the art “would have been motivated to refer to Bengtsson’s teachings to obtain the benefit of its use of a specific URL address (or similar such unique identifier) linking the stored voice message to the text message that is sent to the recipient.” Pet. 38 (citing Ex. 1002 ¶¶ 117–118). Petitioner argues that Mumick already teaches an embedded link to associate an SMS message with a stored voice message and that one of ordinary skill in the art “would have been interested in examples of embedded links that ‘uniquely associate the SMS message and the stored voice message.’” *Id.* at 38–39 (citing Ex. 1002 ¶¶ 117–118; Ex. 1007 ¶¶ 27, 40). Petitioner also argues that one of ordinary skill in the art would have had a reasonable expectation of success in making the proposed combination for reasons previously argued. *Id.* at 39.

*g) Patent Owner’s Preliminary Response*

Patent Owner responds that neither Mumick nor Bengtsson disclose “a client application on a mobile device, wherein said client application integrates voice content to a text message created by a user using methods of recipient addressing as used by text short message service messaging.” Prelim. Resp. 6. Patent Owner argues that, in Mumick, “the user must manually use multiple different native applications on the mobile device” and “the ‘integration,’ to the extent it exists at all, occurs on a server rather than on the mobile device.” *Id.* at 6–7.

In Patent Owner’s view, the ’978 patent discloses and claims a “client application on the mobile device [that] intercepts the text SMS and automatically prompts the user whether to include a voice message.” Prelim. Resp. 7 (citing Ex. 1001, 2:18–21, 6:33–37, Fig. 4). Patent Owner argues that, in Mumick, “the user must create a text message in the standard text messaging client, then manually select a different contact in the phone

book to compose a voice message which the server adds to the text message using ‘an application on the device.’” *Id.* at 8–9 (citing Ex. 1007 ¶¶ 40, 47, Fig. 1). Patent Owner also argues that Mumick’s “‘MultimodalSMS Application’ which is clearly *not* located on the mobile device performs the ‘integration,’ to the extent anything is integrated at all.” *Id.* at 9.

According to Patent Owner, Petitioner attempts to cure the “obvious flaw in the primary reference by suggesting an obviousness combination with Bengtsson,” but “Bengtsson does not teach the claimed client application.” Prelim. Resp. 9 (citing Pet. 27). Patent Owner argues that “Bengtsson never discloses that the disclosed ‘advanced messaging application’ on the sending device either prompts the user to attach voice content or integrates voice content to an SMS message,” and the relied-upon portion of Bengtsson merely describes asking whether to attach a file before the user sends an SMS message. *Id.* at 10 (citing Ex. 1005, 5:20–21, 7:25–27, Fig. 2). Patent Owner also argues that Bengtsson is “completely silent” on how it does this and does not provide “implementation details,” as argued by Petitioner. *Id.* Patent Owner further argues that Petitioner’s declarant states without support that Bengtsson’s messaging application is a client application as required by claim 10. *Id.* at 10–11 (citing Ex. 1002 ¶ 81).

Patent Owner also responds that Petitioner’s several reasons for combining Mumick and Bengtsson “are either too general or based on impermissible hindsight.” Prelim. Resp. 11. In Patent Owner’s view, “obtain[ing] a more user-friendly functionality to ensure a faster and more flexible and reliable user experience” is a “broad statement of general goals” that is insufficient for motivating the asserted combination. *Id.*

Patent Owner further responds that Petitioner argues that Mumick and Bengtsson are in the same field and “read[s] functionality into Bengtsson



that does not exist” for prompting the proposed combination. Prelim. Resp. 11–12 (citing Pet. 21, 22). Patent Owner also argues that, if Petitioner is correct that Mumick “‘already teaches a client application on the mobile device that integrates voice content to a text message,’” one of ordinary skill in the art would not have been motivated to modify Mumick with Bengtsson “for a ‘similar mechanism’ for the user to integrate voice content to an SMS message.” *Id.* at 12 (citing Pet. 22–23). Patent Owner further argues that Petitioner fails to provide sufficient reasoning or motivation for an ordinarily skilled artisan to look to Bengtsson for “implementation details.” *Id.*

According to Patent Owner, Petitioner “openly admit[s]” to using impermissible hindsight because the asserted benefit for making the proposed combination is unstated and “does nothing to inform” why one of ordinary skill in the art would have sought the unstated benefit, “aside from attempting to reach the claimed invention.” Prelim. Resp. 13.

*h) Petitioner Shows a Reasonable Likelihood of Prevailing*

Based on the record before us, Petitioner shows a reasonable likelihood of prevailing in its challenge to independent claim 10. Petitioner cites to portions of Mumick and Bengtsson that, on the present record, teach, suggest, or would have been understood to disclose the limitations of claim 10. Pet. 23–38. At this stage, Petitioner also presents sufficient reasons with support from the record that would have motivated one of ordinary skill in the art to make Petitioner’s proposed combination with a reasonable expectation of success. *Id.* at 21–23, 29, 35, 38–39.

Turning to Patent Owner’s responsive arguments, Patent Owner identifies differences in how Mumick and the ’978 patent “integrate[] voice content to a text message.” Prelim. Resp. 6–9 (citing Ex. 1001, 2:18–21, 6:33–37, Fig. 4; Ex. 1007 ¶¶ 40, 47, Fig. 1). Claim 10, however, does not

recite a specific manner in how “said client application integrates voice content to a text message created by a user.” Patent Owner also has not yet proposed an interpretation for “said client application integrates voice content to a text message created by a user” that would require the integration be in the manner asserted by Patent Owner. *See generally* Prelim. Resp.

Notably, claim 1, unlike claim 10, recites that “integrating voice content to the text message” includes “intercepting said addressed text message by said client application” and “prompting said user to include a voice message with the addressed text message.” Ex. 1001, 10:30–33. The differences in the language of claims 1 and 10 support our determination that claim 10 does not require a specific manner of integrating voice content to a text message.

Moreover, Petitioner provides arguments and evidence that, at this stage, sufficiently show that the proposed combination of Mumick and Bengtsson would have intercepted a text message and prompted the user to include a voice message. Pet. 26 (citing Ex. 1001, 5:7–12, 7:29–36; Ex. 1002 ¶¶ 78–80), 27 (citing Ex. 1005, 6:9–12, 7:21–27), 28 (citing Ex. 1005, 7:23–8:3, Fig. 3), 28–29 (citing Ex. 1001, 3:42–46, 3:48–54, 5:7–12; Ex. 1002 ¶¶ 81, 85–90).

For example, Bengtsson describes that “before the user sends the SMS message, the terminal can ask the user whether an attachment file should be included,” and Figure 3 of Bengtsson shows terminal 30 sending an SMS message “including the image link.” Ex. 1005, 7:25–27, Figs. 2, 3. At this stage, including a link before sending an SMS message, as shown in Bengtsson’s Figure 3, sufficiently demonstrates intercepting a text message, and Petitioner’s declarant testimony supports that a request to include an

attachment file, as taught by Bengtsson, would be prompting a user to include a voice message. Ex. 1002 ¶ 88. Petitioner, thus, sufficiently shows for purposes of institution that Bengtsson teaches or suggests a client application that integrates voice content to a text message in the manner described by the '978 patent.

The record at this stage does not support Patent Owner's responsive argument that there is some distinction in the prompting described by the '978 patent and the asking whether to include an attachment file described by Bengtsson. *See* Prelim. Resp. 9–10.

Petitioner's declarant also provides sufficient support from the record that Bengtsson's advanced messaging application is "a client application," contrary to Patent Owner's argument. Prelim. Resp. 10–11; Ex. 1002 ¶ 81 (citing Ex. 1005, 5:2–10, 6:9–12, 7:12–14, 7:21–25); Ex. 1005, 5:2–10, 6:9–12.

As for Patent Owner's argument that integration occurs in Mumick's application that is not located on the mobile device, Petitioner argues, because a link to the voice message is embedded in the text message "at the sending device," Mumick discloses "a client application on a mobile device" that "integrates voice content to a text message." Pet. 25 (citing Ex. 1007 ¶ 27); Ex. 1002 ¶ 77 (discussing Ex. 1007 ¶¶ 8, 14, 27, 40, 41). At this stage, Petitioner's argument is sufficient for institution. Patent Owner does not yet address paragraph 27 of Mumick in its argument and focuses, instead, on Mumick's description of MultimodalSMS Application 108. *See* Prelim. Resp. 9.

Moreover, even if Mumick insufficiently discloses "a client application on a mobile device," Petitioner provides arguments that Bengtsson describes both "an advanced messaging application" and

integrating voice content to a text message at the sending device, as discussed previously, and those arguments are sufficient for purposes of institution. Pet. 27–29; Ex. 1005, 7:21–27, Figs. 2, 3.

Regarding Patent Owner’s contention that Petitioner’s reasons for making its proposed combination “are either too general or based on impermissible hindsight,” Petitioner sufficiently argues with support from the record that, to the extent integrating requires intercepting a text message and prompting a user, one of ordinary skill in the art would have had reasons to modify Mumick’s clicking on a link in a phone book with Bengtsson’s query of whether an attachment file should be included. Pet. 22–23 (citing Ex. 1002 ¶¶ 72–73; Ex. 1007 ¶ 40).

At this stage, the record supports that the proposed combination would have been more “streamlined,” “more user-friendly,” “faster,” and “more flexible and reliable,” thereby motivating the ordinarily skilled artisan to make the proposed combination. Pet. 23; Ex. 1002 ¶ 72 (opining on why the proposed combination would have been more streamlined, faster, simpler, and more reliable). The present record also indicates that the proposed combination would have been a “design choice,” as argued by Petitioner. *See* Pet. 23; Ex. 1002 ¶¶ 32–46, 72 (opining on design choice); Ex. 1025, 78, 97; Exs. 1030, 1032, 1033, 1040.

Even if Bengtsson does not show a “similar mechanism” for integrating voice content to a text message, as argued by Patent Owner, the present record sufficiently supports Petitioner’s reasons for modifying Mumick with Bengtsson so that the proposed combination would be more “streamlined,” “more user-friendly,” “faster,” and “more flexible and reliable.” *See* Pet. 23; Prelim. Resp. 11–12; Ex. 1002 ¶ 72. These reasons do not appear to be based on any impermissible hindsight, as argued by

Patent Owner. Prelim. Resp. 11, 13. Patent Owner responds that the benefit of the proposed combination is unstated, and so Petitioner must be using impermissible hindsight. *Id.* at 13. The reasons listed above appear to be the benefits of the proposed combination, and the present record sufficiently shows that one of ordinary skill in the art would have made the proposed combination to obtain those benefits. *See* Pet. 23; Ex. 1002 ¶ 72. Petitioner is not using impermissible hindsight, as argued by Patent Owner.

For the reasons above, Petitioner sufficiently shows for purposes of institution that its proposed combination of Mumick and Bengtsson includes “a client application on a mobile device, wherein said client application integrates voice content to a text message created by a user.” Petitioner, thus, shows a reasonable likelihood of prevailing in its challenge to independent claim 10.

#### 4. *Dependent Claims 11–13*

Claim 11 depends from claim 10 and recites “wherein said server comprises a first server for storing the voice messages of the user.” Ex. 1001, 11:26–27. Petitioner argues that Mumick’s Media Server or database 214 discloses the limitations of claim 11. Pet. 39–40 (citing Ex. 1002 ¶ 119; Ex. 1007, Abstract, ¶ 40, Fig. 2).

Claim 12 depends from claim 10 and recites “wherein said server comprises a second server for transmitting said voice message notification with said addressed text message to the recipients.” Ex. 1001, 11:28–30. Petitioner argues that Mumick’s SMSC discloses the limitations of claim 12. Pet. 40–41 (citing Ex. 1002 ¶¶ 120, 121; Ex. 1007, Abstract, ¶ 40, Fig. 2).

Claim 13 depends from claim 10 and recites “wherein the client application transmits one of a text message, a voice message, and a combination thereof.” Ex. 1001, 11:31–33. Petitioner argues that Mumick’s

client application transmits the recited messages. Pet. 41–42 (citing Ex. 1002 ¶ 122; Ex. 1007 ¶ 40, Fig. 1). Petitioner also argues that Bengtsson teaches the limitation. *Id.* at 42–44 (citing Ex. 1002 ¶¶ 123–128; Ex. 1005, 5:2–10, 6:9–12, 7:21–8:3, 8:21–24, Fig. 3). Petitioner further argues that one of ordinary skill in the art would have been motivated to combine Mumick and Bengtsson with a reasonable expectation of success for the reasons asserted for claim 10. *Id.* at 44 (citing Ex. 1002 ¶¶ 129–130).

Based on the preliminary record, Petitioner shows a reasonable likelihood of prevailing with respect to at least one of claims 11–13 in its challenge based on Mumick and Bengtsson.

*E. Asserted Obviousness Based on Mumick, Bengtsson, and Roujinsky*

*1. Roujinsky (Ex. 1006)*

Roujinsky’s method includes “compiling a media message using a sending device” and “sending the media message to a server for storing together with a respective identity of each recipient.” Ex. 1006, 3:12–17.<sup>4</sup> The “method is typically carried out by a server operating the service to receive a voice message sent by a sender” and “to convey the voice message to one or more recipients.” *Id.* at 4:10–13.

Roujinsky’s system 30 includes messaging client 31 loaded into sending or receiving device 45. Ex. 1006, 7:7–9, Fig. 4. “[M]essaging client 31 can run on different devices such as mobile phones, smart phones, WDAs[,] PDAs, etc. and be implemented in variety of technologies, for example Java, J2ME, Brew, Symbian, Linux, Windows, PocketPC,

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<sup>4</sup> Like Petitioner, we cite to the page numbers of Roujinsky, not the exhibit page numbers.

SmartPhone, PalmOS, or others.” *Id.* at 8:5–8. Figure 4 of Roujinsky is below reproduced.

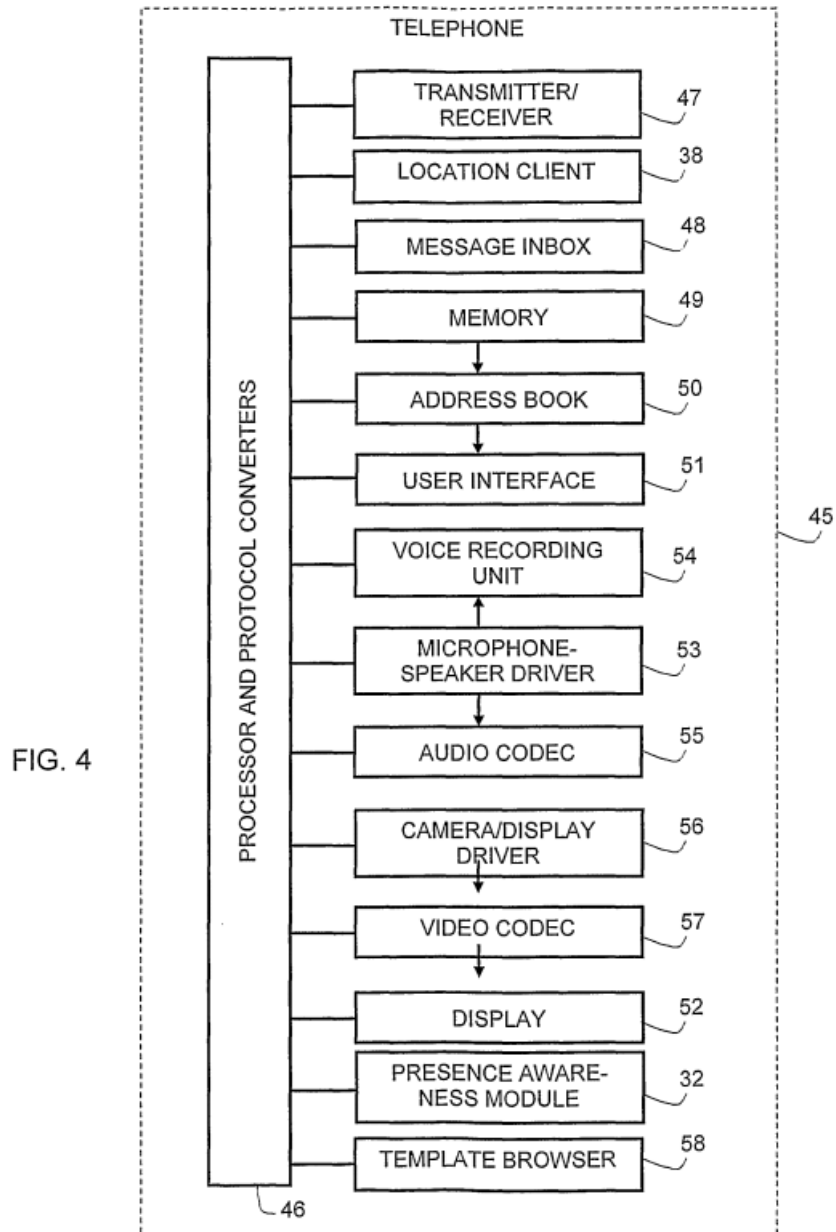


Figure 4 “is a block diagram showing functionally an enhanced telephone adapted to convey an audio message to at least one receiving device.” Ex. 1006, 5:10–11. “[T]elephone 45 is a cellular telephone that is enhanced by a software client.” *Id.* at 9:1–2.

“[M]emory 49 stores data such as an address book 50.” Ex. 1006, 9:10–12. “Address book function allows use of phone’s contact list or contacts and groups managed by the system, either on the phone or on the system’s server.” *Id.* at 9:13–15. “[U]ser interface 51 includes a keypad and scrolling keys for typing text messages and selecting options displayed on a display 52,” and “enhanced telephone 45 also has a microphone/speaker driver 53 that allows speech to be converted to electrical signals for recording using a voice recording unit 54.” *Id.* at 9:15–18.

“The sender creates a voice/text message and selects those recipients to whom he wishes to send the message,” and “[t]he message and destination data are sent from the sender 11 to the server 13, which processes and stores the message, and sends it to the recipients 12.” Ex. 1006, 11:7–10. “Upon receiving notification of an awaiting message, the recipient may retrieve the message from the server by sending a request using HTTP/TCP, whereupon the server conveys the message to the recipient also using HTTP/TCP.” *Id.* at 17:3–5.

## 2. *Dependent Claim 14*

Claim 14 depends from claim 10 and recites “wherein the client application is provided on an operating system of the mobile device.” Ex. 1001, 12:1–2. Petitioner argues that its proposed combination of Mumick and Bengtsson includes a client application, but Mumick does not disclose expressly an operating system. Pet. 44 (citing Ex. 1005, 7:25–27; Ex. 1006, 7:7–9; Ex. 1007 ¶ 40).

Petitioner relies on Roujinsky for teaching a messaging client implemented in well-known operating systems. Pet. 44–45 (citing Ex. 1002 ¶¶ 131–132, 135–136; Ex. 1006, 3:12–19, 7:7–9, 8:5–8). Petitioner contends that one of ordinary skill in the art would have been motivated to



combine Mumick, Bengtsson, and Roujinsky so that the asserted client application is provided on an operating system “to provide stability for users and efficiency for application developers.” Pet. 45–46 (citing Ex. 1002 ¶ 133; Ex. 1006, 8:5–8; Ex. 1007 ¶ 50). Petitioner also argues that there would have been a reasonable expectation of success in making the proposed combination. *Id.* at 46 (citing Ex. 1002 ¶¶ 134, 137; Ex. 1005, 7:23–8:3; Ex. 1006, 3:12–19; Ex. 1007 ¶ 40; Ex. 1033; Ex. 1036).

Patent Owner responds that, because Petitioner does not show that Mumick and Bengtsson would have rendered obvious claim 10, Petitioner fails to show that the same references would have rendered obvious claim 14, which depends from claim 10. Prelim. Resp. 13.

Based on the preliminary record, for the reasons discussed above, Petitioner shows a reasonable likelihood of prevailing with respect to claim 14.

*F. Asserted Obviousness Based on Bengtsson and Roujinsky*

*1. Independent Claim 10*

For “[a] system for voice short message service messaging,” Petitioner argues that Bengtsson discloses the preamble to the extent it is limiting. Pet. 49 (citing Ex. 1002 ¶ 143; Ex. 1005, 1:9–10, 7:8–10, 7:21–27, 8:21–24).

For the recited “client application on a mobile device,” Petitioner argues that Bengtsson teaches the recited client application. Pet. 50 (citing Ex. 1002 ¶¶ 144–146; Ex. 1005, 5:2–10, 6:9–12, 7:21–8:3; Ex. 1025, 91). Petitioner also argues that, to the extent that Bengtsson does not teach “methods of recipient addressing,” it would have been obvious “because this was a standard and well-known implementation in mobile devices,” as

evidenced by Roujinsky. *Id.* (citing Ex. 1002 ¶¶ 147–151; Ex. 1030, 34; Ex. 1032; Ex. 1033; Ex. 1034 ¶¶ 37, 46).

Turning to Roujinsky, Petitioner argues that its cellular phone includes a software client and memory 49 that stores address book 50 and that it teaches creating a message sent to a server and selecting a recipient for the message. Pet. 50–52 (citing Ex. 1006, 7:7–9, 9:1–2, 9:10–15, 11:7–10, 14:1–5, Fig. 4). Petitioner also argues that one of ordinary skill in the art “would have been motivated to implement Roujinsky’s teachings of an address book on the sender’s device . . . and a user interface . . . for creating messages using methods of recipient addressing into Bengtsson’s mobile device . . . , to the extent not already taught, to select an intended recipient for a text message” and “to allow the user to use their existing contacts when creating text messages.” *Id.* at 52 (citing Ex. 1002 ¶¶ 152–154; Ex. 1005, Fig. 3; Ex. 1006, Fig. 4). Petitioner further argues that one of ordinary skill in the art would have had a reasonable expectation of success in making the proposed combination, because the references “disclose straightforward applications of well-known technologies using standard hardware and software systems such as mobile devices, SMS messaging, memory storage, and user interfaces,” and the combination would have been within ordinary skill in the art. *Id.* at 53 (citing Ex. 1002 ¶ 155; Ex. 1005, 7:23–8:3; Ex. 1006, 3:12–19).

For the recited “memory storage means,” Petitioner argues that one of ordinary skill in the art would have understood that Bengtsson’s storage of addresses requires memory. Pet. 53 (citing Ex. 1002 ¶ 156; Ex. 1005, 5:6–7, 8:14–16). According to Petitioner, ordinarily skilled artisans also knew that “mobile devices were configured to store recipient addresses.” *Id.* (citing Ex. 1002 ¶ 156; Ex. 1030, 34). Petitioner also argues that Roujinsky teaches

memory 49 and that one of ordinary skill in the art would have been motivated to implement Roujinsky's memory teachings into Bengtsson. *Id.* at 54–56 (citing Ex. 1002 ¶¶ 157–159; Ex. 1005, 7:23–8:3, Fig. 3; Ex. 1006, 3:12–19, 9:10–15, 14:1–5, 20:1–3, Fig. 4; Ex. 1033).

For the recited “user interface on the mobile device,” Petitioner argues that Bengtsson teaches creating SMS messages and an audio recorder so that one of ordinary skill in the art would have understood Bengtsson's mobile terminal has the recited user interface. Pet. 56–57 (citing Ex. 1002 ¶¶ 160, 161; Ex. 1005, 7:7–10, 7:23–27). Petitioner also argues that Roujinsky teaches user interface 51 on telephone 45 for typing text messages and microphone/speaker driver 53. *Id.* at 57 (citing Ex. 1006, 9:15–24, Fig. 4).

Petitioner further argues that one of ordinary skill in the art would have been motivated to implement Roujinsky's detailed user interface teachings on the sender's device for inputting voice and text messages . . . into Bengtsson's mobile terminal . . . , as a routine way to create a text message and record a voice message on their mobile device, as Bengtsson teaches, with a reasonable expectation of success. Pet. 58–59 (citing Ex. 1002 ¶¶ 162–164; Ex. 1005, 7:28–8:3, Fig. 3; Ex. 1006, 3:12–19, Fig. 4).

For the recited “server,” Petitioner argues that Bengtsson's service centers teach a server that stores SMS and voice messages and a link to a server for accessing an attached file. Pet. 59–60 (citing Ex. 1002 ¶¶ 165–166; Ex. 1005, 1:24–26, 2:21–25, 8:10–14, 8:21–28, Fig. 3), 62–63 (citing Ex. 1005, 7:7–10, 8:23–29, Fig. 3). Petitioner also argues that, to the extent that Bengtsson does not expressly disclose the required server, (1) Bengtsson teaches sending recorded audio, (2) recording audio from a mobile terminal on a remote server was known, and (3) determining which device performs

the recording would have been a matter of design choice. *Id.* at 60–61 (citing Ex. 1002 ¶¶ 167–168; Ex. 1005, 7:7–10, 8:17–24; Ex. 1033).

Petitioner further argues that Roujinsky teaches the recited server and would have been understood to teach a routine alternative. Pet. 61–62 (citing Ex. 1002 ¶¶ 169–170; Ex. 1006, 4:10–16, 4:18–20, 10:23–24, 13:3–5, 16:26–29, 17:3–5, 18:8–12). According to Petitioner, one of ordinary skill in the art “would have been motivated to implement the remote recording capabilities of Roujinsky’s server into Bengtsson’s system to conserve the resources of the sender’s device and take advantage of the more significant resources on a server” and “result in a more resource-efficient system” with a reasonable expectation of success. *Id.* at 63–64 (citing Ex. 1002 ¶¶ 171–173; Ex. 1005, 7:23–8:3; Ex. 1006, 3:12–19; Ex. 1038, 67–68).

For a “client application for transmitting a voice message notification with an addressed text message to said recipients,” Petitioner argues that Bengtsson’s advanced messaging application teaches the limitation. Pet. 64–65 (citing Ex. 1002 ¶¶ 174–178; Ex. 1005, 5:10–12, 6:9–12, 7:21–25, 8:21–29).

*a) Petitioner’s Asserted Reason for Combining*

Petitioner argues that one of ordinary skill in the art would have been motivated to combine Bengtsson and Roujinsky with a reasonable expectation of success “because each relates to systems and methods for transmitting multimedia messages, including voice associated with SMS messages.” Pet. 46 (citing Ex. 1005, Abstract, 7:7–10; Ex. 1006, 1:2–3). Petitioner describes what each asserted reference discloses. *Id.* at 46–47 (citing Ex. 1002 ¶¶ 138–139; Ex. 1005, 7:23–8:3; Ex. 1006, 3:12–19, 9:10–24, 13:3–5, 18:8–12).

According to Petitioner, one of ordinary skill in the art would have been motivated to combine Bengtsson and Roujinsky because of the “benefit of incorporating Roujinsky’s teachings of an address book stored in memory on the sender’s device . . . and a straightforward user interface for creating and addressing voice and text messages . . . into Bengtsson’s mobile device” and the “benefit of allowing the user to use the existing contacts list already on their device when creating and addressing text messages.” Pet. 47–48 (citing Ex. 1002 ¶ 140; Ex. 1005, Fig. 3; Ex. 1006, Fig. 4). Petitioner also argues that the proposed combination would have been a combination of familiar elements with predictable results. *Id.* (citing Ex. 1002 ¶ 140).

Petitioner further argues that one of ordinary skill in the art would have been motivated to include the remote recording capabilities via a server of Roujinsky into a system like Bengtsson to take advantage of the more significant resources on a server which would reduce the likelihood, for example, of running out of storage if all voice messages were stored on the sender’s device,

and the proposed combination would have been understood to “result in a more resource-efficient system.” Pet. 48 (citing Ex. 1002 ¶ 141; Ex. 1006, 9:8–10); *see also id.* at 63–64 (similarly arguing that the ordinarily skilled artisan “would have been motivated to implement the remote recording capabilities of Roujinsky’s server into Bengtsson’s system to conserve the resources of the sender’s device and take advantage of the more significant resources on a server” and “result in a more resource-efficient system” with a reasonable expectation of success) (citing Ex. 1002 ¶¶ 171–173; Ex. 1005, 7:23–8:3; Ex. 1006, 3:12–19; Ex. 1038, 67–68).

Regarding reasonable expectation of success, Petitioner contends that one of ordinary skill in the art “would have understood that these references

both disclose systems and methods for transmitting multimedia messages using familiar elements such as mobile devices, SMS messaging, memory storage, user interfaces, and servers.” Pet. 48–49 (citing Ex. 1002 ¶ 142; Ex. 1005, 7:23–8:3; Ex. 1006, 3:12–19; Ex. 1033). Petitioner, thus, contends that the references would have been understood to be “amenable to various well-understood and predictable combinations.” *Id.* at 49 (citing Ex. 1002 ¶ 142; Ex. 1005, 7:23–8:3; Ex. 1006, 3:12–19; Ex. 1033).

*b) Patent Owner’s Preliminary Response*

Patent Owner responds that the proposed combination of Bengtsson and Roujinsky does not disclose “a client application on a mobile device, wherein said client application integrates voice content to a text message created by a user using methods of recipient addressing as used by text short message service messaging.” Prelim. Resp. 13–14. Patent Owner argues that Bengtsson “merely contain[s] a single disclosure that the ‘terminal’ can ‘ask the user whether an attachment file should be included at step 22’” and “does not disclose a client application that ‘integrates voice content to a text message created by a user’ as required by claim 10.” *Id.* at 14 (citing Ex. 1005, 7:25–27).

Patent Owner also argues that “adding Roujinsky for teachings related to recipient addressing is not adequate to cure” the insufficient disclosure of Bengtsson because Petitioner uses Roujinsky’s teachings for another limitation of claim 10. Prelim. Resp. 14–15 (citing Pet. 50, 52; Ex. 1006, 11:7–8). Patent Owner further argues that Petitioner fails to show that one of ordinary skill in the art would have been motivated to combine Bengtsson and Roujinsky. *Id.* at 15.

According to Patent Owner, “Roujinsky does not disclose a client application at all, but rather discloses a system that provides menus that are

‘voice driven rather than text-based.’” Prelim. Resp. 15 (citing Ex. 1006, 1:19). Patent Owner argues that, “[i]n Roujinsky, the voice message is created by the user on the mobile device and all remaining functionality is conducted at the server,” and, thus, one of ordinary skill in the art would not have been motivated to combine Bengtsson and Roujinsky. *Id.* (citing Ex. 1006, 4:10–14).

*c) Petitioner Shows a Reasonable Likelihood of Prevailing*

Based on the preliminary record, Petitioner shows a reasonable likelihood of prevailing in its challenge to independent claim 10. Petitioner cites to portions of Bengtsson and Roujinsky that, on the present record, teach, suggest, or would have been understood to disclose the limitations of claim 10. Pet. 49–52, 53–55, 56–57, 59–63, 64–65. At this stage, Petitioner also presents sufficient reasons with support from the record that would have motivated one of ordinary skill in the art would to make Petitioner’s proposed combination with a reasonable expectation of success. *Id.* at 46–49, 52–53, 55–56, 58–59, 63–64.

Turning to Patent Owner’s argument that Bengtsson and Roujinsky fail to disclose “a client application on a mobile device, wherein said client application integrates voice content to a text message created by a user,” Petitioner cites portions of Bengtsson that describe “before the user sends the SMS message, the terminal can ask the user whether an attachment file should be included.” Pet. 50 (citing Ex. 1002 ¶¶ 144–146; Ex. 1005, 5:2–10, 6:9–12, 7:21–8:3); Ex. 1002 ¶ 144; Ex. 1005, 7:25–27. As discussed above for the challenge based on Mumick and Bengtsson, Figure 3 of Bengtsson shows terminal 30 sending an SMS message “including the image link.” Ex. 1005, Figs. 2, 3.

At this stage, including a link before sending an SMS message, as shown in Bengtsson’s Figure 3, sufficiently demonstrates intercepting a text message, and Petitioner’s testimonial evidence supports that a request to include an attachment file, as taught by Bengtsson, would be prompting a user to include a voice message. Ex. 1002 ¶¶ 144. Petitioner, thus, sufficiently shows for purposes of institution that Bengtsson teaches or suggests a client application that integrates voice content to a text message in the manner described by the ’978 patent, contrary to Patent Owner’s arguments. *See* Prelim. Resp. 13–15.

For the reasons above, Petitioner shows a reasonable likelihood of prevailing in its challenge to independent claim 10.

## 2. *Dependent Claims 11–14*

For claim 11, Petitioner argues that Bengtsson’s server teaches a “server [that] comprises a first server for storing the voice messages of the user.” Pet. 65–66 (citing Ex. 1002 ¶¶ 179–180; Ex. 1005, 1:24–26, 2:21–25, 8:10–14, 8:25–28, Fig. 3, claim 1).

For claim 12, Petitioner argues that Bengtsson’s server teaches a “server [that] comprises a second server for transmitting said voice message notification with said addressed text message to the recipients.” Pet. 66–67 (citing Ex. 1002 ¶¶ 181–182; Ex. 1005, 1:24–26, 2:21–25, 8:10–14, 8:21–28, Fig. 3, claim 1).

For claim 13, Petitioner argues that Bengtsson’s application teaches a “client application [that] transmits one of a text message, a voice message, and a combination thereof.” Pet. 67–69 (citing Ex. 1002 ¶¶ 183–186; Ex. 1005, 5:2–10, 6:9–12, 7:21–8:3, 8:21–24, Fig. 3; Ex. 1025, 91). Petitioner also argues that one of ordinary skill in the art would have understood that Bengtsson’s message is a combination of voice and text in



the manner described by the '978 patent. *Id.* at 69 (citing Ex. 1002 ¶¶ 187–188).

For claim 14, Petitioner argues that Bengtsson’s application teaches, or would have been understood to be, a “client application [that] is provided on an operating system of the mobile device.” Pet. 69–70 (citing Ex. 1002 ¶¶ 189–192; Ex. 1005, 5:2–10, 6:9–12, 7:21–25; Ex. 1025, 91). Petitioner also argues that Roujinsky teaches messaging client 31 provided on an operating system of device 45. *Id.* at 69–70 (citing Ex. 1001, 3:11–20; Ex. 1002 ¶ 193; Ex. 1006, 7:7–9, 8:5–8, 9:1–2). Petitioner further argues that one of ordinary skill in the art would have been motivated to use the operating system of Roujinsky to house an application in Bengtsson “because operating systems were well known to provide stability for users and efficiency for application developers.” *Id.* at 70 (citing Ex. 1002 ¶ 194; Ex. 1035; Ex. 1037). Petitioner additionally argues that there would have been a reasonable expectation of success in making the proposed combination. *Id.* (citing Ex. 1002 ¶¶ 195–197; Ex. 1005, 7:23–8:3; Ex. 1006, 3:12–19).

Patent Owner does not provide arguments specifically for claims 11–14 that depend from claim 10. *See* Prelim. Resp. 13–15 (arguing that Petitioner fails to show the client application recited by claim 10). Based on the preliminary record, Petitioner shows a reasonable likelihood of prevailing with respect to at least one of claims 11–14.

#### IV. CONCLUSION

After considering the evidence and arguments presented in the Petition and the cited evidence, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in proving that at least

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one of claims 10–14 of the '978 patent is unpatentable, and thus, we institute an *inter partes* review of all challenged claims on all presented challenges. 37 C.F.R. § 42.108(a).

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim or any underlying factual and legal issues.

#### V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 10–14 of U.S. Patent No. 8,107,978 B2 is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of U.S. Patent No. 8,107,978 B2 shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

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