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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner,

v.

CORE WIRELESS LICENSING S.A.R.L.,
Patent Owner.

Case IPR2015-01986
Patent 8,165,049 B2

Before JAMESON LEE, DAVID C. McKONE, and KEVIN W. CHERRY, *Administrative Patent Judges.*

LEE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

LG Electronics, Inc. ("Petitioner") filed a Petition ("Pet.") for *inter partes* review of U.S. Patent No. 8,165,049 B2 (Ex. 1001, "the '049 patent"). Paper 1. The Petition challenges the patentability of claims 11–15, 17, and 28–31 of the '049 patent. In an initial decision, we instituted *inter*

partes review of each of these claims, except claim 15. Paper 7 ("Dec. Inst."). Petitioner filed a Request for Rehearing. Paper 11. That request was denied. Paper 12.

Core Wireless Licensing S.a.r.l. ("Patent Owner") filed a Patent Owner Response (Paper 16, "PO Resp."), and Petitioner filed a Reply (Paper 19, "Reply"). A consolidated oral hearing for this proceeding and for Case IPR2015-01988 was held on December 14, 2016. A transcript of the oral hearing is included in the record. Paper 33 ("Tr.").[1]

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). We determine that Petitioner has shown by a preponderance of the evidence that claims 11–14, 17, and 28–31 of the '049 patent are unpatentable.

B. Related Matters

Patent Owner indicates that the '049 patent is at issue in *Core Wireless Licensing S.a.r.l. v. LG Electronics, Inc.*, Civ. No. 2:14-cv-00912 (E.D. Tex.) ("LG Litigation"). Paper 4, 2. Petitioner additionally indicates that *Core Wireless Licensing S.a.r.l. v. Apple Inc.*, Civ. No. 6:14-cv-00751 (E.D. Tex.) is a related matter. Pet. 1. U.S. Patent No. 8,792,398 claims priority to the '049 patent and is involved in *inter partes* review IPR2015-01988. Paper 4, 2.

C. The '049 Patent

The '049 patent is titled "Filtering of Electronic Information to be Transferred to a Terminal." Ex. 1001, (54). The electronic information to

[1] Patent Owner filed Observation on Cross-Examination (Paper 25), and Petitioner filed a Response (Paper 29). Both papers have been considered.

be transferred can be any electronic content, such as short messages, picture messages, multimedia messages, and files. *Id.* at 3:44–48. The '049 patent is directed to an apparatus and a method for filtering electronic information to be transferred to a terminal through a telecommunication connection. *Id.* at Abstr. It involves (1) attaching a specific filtering parameter by the device transferring the electronic information to the electronic information before the electronic information is transferred to the terminal through the telecommunication connection, and (2) informing the terminal of the filtering parameter before the electronic information is transferred to the terminal through the telecommunication connection. *Id.* The terminal checks the filtering parameter and decides, based on the filtering parameter, whether to allow or prevent receiving the electronic information. *Id.*

The '049 patent describes that, preferably, the filtering parameter is transmitted to the terminal in a separate notification message before sending of the electronic information to the terminal in the event the terminal indicates that it will allow receiving of the information. *Id.* at 3:8–12. The '049 patent also describes that alternatively the filtering parameter is included in the first part of the electronic information, such as a header, which the terminal reads first, and the terminal may decide, upon reading the filtering parameter in the header, that receiving the rest of the electronic information will be prevented. *Id.* at 3:12–19.

The '049 patent describes that in a preferred embodiment, the receiving terminal carries out the filtering automatically on the basis of pre-setting made in the terminal. *Id.* at 3:19–21. The '049 patent describes that alternatively the terminal may inform the user of the filtering parameter and

then the user can decide whether to receive or not receive the electronic information. *Id.* at 3:21–26.

According to the ’049 patent, unnecessary current consumption by the terminal would be avoided because the terminal will not receive messages that are prevented and will not have to examine them. *Id.* at 3:29–33. Also according to the ’049 patent, transferring data in a mobile communication network is expensive, and thus, if data transfer is prevented, expenses will be avoided and network capacity will be saved. *Id.* at 3:34–38.

Claims 11, 14, and 28 are independent and reproduced below:

> 11. An apparatus, comprising:
>
> a radio part configured to enable receiving electronic information through a cellular communication connection; and
>
> a processor configured to receive a filtering parameter over the cellular telecommunication connection via the radio part, which filtering parameter is related to the electronic information,
>
> wherein the processor is further configured to automatically allow or prevent the receiving of the electronic information on the basis of said filtering parameter and the apparatus is arranged not to receive the electronic information through the cellular telecommunication connection when the filtering parameter denotes the electronic information being prevented.
>
> 14. A method, comprising:
>
> receiving by an apparatus of a recipient to whom electronic information is addressed a filtering parameter associated with electronic information that is to be received through a cellular telecommunication connection;
>
> automatically allowing or preventing receiving of the electronic information on the basis of the filtering parameter; and
>
> preventing the receiving of the electronic information through the cellular telecommunication connection if the

> filtering parameter denotes the electronic information as information whose receipt is to be prevented.
>
> 28. An apparatus, comprising:
>
> a radio part for receiving from a cellular telecommunication network a multimedia message that comprises the following fields: message class, subject, to whom, and content information of the multimedia message; and
>
> a processor configured to cause receiving with the radio part a notification message from the cellular telecommunication network before receiving of the content information of the multimedia message, the notification message comprising the message class of the multimedia message,
>
> wherein the processor is further configured to use the message class as a filtering parameter to automatically allow or prevent the receiving of the content information of the multimedia message on the basis of said filtering parameter and the apparatus is configured not to receive the content information of the multimedia message from the cellular telecommunication network when the filtering parameter denotes the content information as information whose receipt is to be prevented.

Id. at 17:5–20, 17:37–48, 19:20–20:13.

D. Evidence Relied Upon by Petitioner

Petitioner relies on the following references:

MMS Specs.

Petitioner collectively identifies as "MMS Specifications" a series of four draft Technical Specifications developed by 3rd Generation Partnership Project ("3GPP"). Pet. 4. We refer to "MMS Specifications" simply as "MMS Specs." The documents are:

3GPP, *Technical Specification Group Services and System Aspects, Service aspects; Stage 1, Multimedia Messaging Service (3G TS*

22.140 version 0.1.0), TSG S1#4 (99)486 (July 5–9, 1999) (Ex. 1003, "MMS-1 v0.1.0");

3GPP, *Technical Specification Group Services and System Aspects, Service Aspects; Stage 1, Multimedia Messaging Service (3G TS 22.140 version 0.2.0)* (Sept. 1999) (Ex. 1004, "MMS-1 v0.2.0");

3GPP, *Technical Specification Group Services and System Aspects, Service aspects; Stage 1, Multimedia Messaging Service (3G TS 22.140 version 1.0.0)*, TSGS#5(99) 431 (Oct. 11–13, 1999) (Ex. 1005, "MMS-1 v1.0.0");

3GPP, *Technical Specification Group Terminals; Multimedia Messaging Service (MMS); Functional Description; Stage 2 (3G TS 23.140 version 0.1.0)*, T2M(99) 105 (Nov. 9–10, 1999) (Ex. 1006, "MMS-2").

SMS Realization

Petitioner identifies as "SMS Realization" a technical specification developed by 3GPP (Pet. 6):

3GPP, *Technical Specification Group Terminals; Technical realization of the Short Message Service (SMS); Point-to-Point (PP) (3G TS 23.040 version 3.1.0)* (1999-07) (Ex. 1008, "SMS").

Nokia Proposal

Petitioner identifies a technical proposal purportedly presented by Nokia Corporation (Pet. 7):

MMS architecture proposal, TSGT2#4(99)500 (June 14–16, 1999) (Ex. 1009, "Nokia Proposal").

Sony Proposal

Petitioner identifies a technical proposal purportedly presented by Sony Corporation (Pet. 7):

> 3GPP, *Technical Specification Group Services and System Aspects, Service aspects; Stage 1, Multimedia Messaging Service (3G TS 22.140 version 0.3.1)*, T2M(99)008 (Nov. 9–10, 1999) (Ex. 1010, "Sony Proposal").

Table Summarizing References

Reference		Date	Exhibit
MMS Specs.	MMS-1 v0.1.0 MMS-1 v0.2.0 MMS-1 v1.0.0 MMS-2	July 12, 1999[2] Sept. 13, 1999[3] Oct. 10, 1999[4] Nov. 15, 1999[5]	Ex. 1003 Ex. 1004 Ex. 1005 Ex. 1006
SMS	3G TS 23.040 version 3.1.0	July 22, 1999[6]	Ex. 1008
Nokia Proposal	TSGT2#4(99)500	June 29, 1999[7]	Ex. 1009
Sony Proposal	T2M(99)008	Nov. 15, 1999[8]	Ex. 1010

[2] Based on the testimony of Friedhelm Rodermund. Ex. 1007 ¶ 19.
[3] Based on the testimony of Friedhelm Rodermund. Ex. 1007 ¶ 20.
[4] Based on the testimony of Friedhelm Rodermund. Ex. 1007 ¶ 21.
[5] Based on the testimony of Friedhelm Rodermund. Ex. 1007 ¶ 22.
[6] Based on the testimony of Friedhelm Rodermund. Ex. 1007 ¶ 23.
[7] Based on the testimony of Friedhelm Rodermund. Ex. 1007 ¶ 24.
[8] Based on the testimony of Friedhelm Rodermund. Ex. 1007 ¶ 26.

Petitioner also relies on the Declarations of Mr. Mark R. Lanning (Exs. 1002, 1043), and the Declaration of Mr. Friedhelm Rodermund (Ex. 1007). Patent Owner relies on the Declaration of Alon Konchitsky, Ph.D. (Ex. 2010).

E. The Asserted Grounds of Unpatentability

Trial was instituted on the following grounds of unpatentability:

References	Basis	Claims Challenged
MMS Specs.[9] and Nokia Proposal	§ 103(a)	11–14 and 17
MMS Specs.[10], Nokia Proposal, Sony Proposal, and SMS	§ 103(a)	28–31

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142–46 (2016). Consistent with that standard, we assign claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention, in the context of the entire patent disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

[9] For claims 11, 13, 14, and 17, Petitioner relies on MMS-1 v0.1.0 and MMS-1 v0.2.0. For claim 12, Petitioner additionally relies on MMS-2.
[10] Petitioner relies on MMS-1 v0.1.0, MMS-1 v0.2.0, and MMS-1 v1.0.0.

There are, however, two exceptions: "1) when a patentee sets out a definition and acts as his own lexicographer," and "2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution." *Thorner v. Sony Comp. Entm't Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). It is inappropriate to limit a claim to a preferred embodiment without a clear intent in the specification to redefine a claim term or a clear disavowal of claim scope. *See id.* Limitations that are not a part of the claim should not be imported into the claim. *See SuperGuide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

If an inventor acts as his or her own lexicographer, the definition must be set forth in the specification with reasonable clarity, deliberateness, and precision. *See Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998). It is improper to add into a claim an extraneous limitation, i.e., one that is added wholly apart from any need for the addition to interpret what is meant by the words or phrases in the claim. *See Hoganas AB v. Dresser Indus., Inc*., 9 F.3d 948, 950 (Fed. Cir. 1993); *E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co*., 849 F.2d 1430, 1433 (Fed. Cir. 1988).

Only terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc*., 200 F.3d 795, 803 (Fed. Cir. 1999).

1.

"automatically allow or prevent the receiving of the electronic information on the basis of said filtering parameter" / "automatically allowing or preventing receiving of the electronic information on the basis of the filtering parameter" / "automatically allow or prevent the receiving of the content information of the multimedia message on the basis of said filtering parameter"

Claim 11 recites: "automatically allow or prevent the receiving of the electronic information on the basis of said filtering parameter." Claim 14 recites: "automatically allowing or preventing receiving of the electronic information on the basis of the filtering parameter." Claim 28 recites: "automatically allow or prevent the receiving of the content information of the multimedia message on the basis of said filtering parameter."

Petitioner contends that "automatically" in the context of these phrases means "based on settings input by the user in advance of receiving the filtering parameter." Pet. 11. The construction provided by Petitioner is excessively narrow in that it requires the determination to be made on the basis of information inputted "by the user in advance of receiving the filtering parameter." Even if the disclosed embodiments in the '049 patent operate on that basis, nothing in the claims include that restriction. Patent Owner asserts that "automatically allow or prevent" and "automatically allowing or preventing" should be construed according to their plain and ordinary meaning. PO Resp. 27. We agree with Patent Owner.

We construe each of the phrases "automatically allow or prevent the receiving of the electronic information on the basis of said filtering parameter," and "automatically allowing or preventing receiving of the electronic information on the basis of the filtering parameter," as **allowing**

or preventing receiving without a user deciding, after receipt of the filtering parameter, on whether to allow or prevent the receiving of the electronic information. We construe the phrase "automatically allow or prevent the receiving of the content information of the multimedia message on the basis of said filtering parameter," as **allowing or preventing receiving without a user deciding, after receipt of the filtering parameter, on whether to allow or prevent the receiving of the content information of the multimedia message**.[11]

2.

"cellular telecommunication connection"

Each of independent claims 11, 14, and 28 recites "cellular telecommunication connection." Petitioner proposes that this term be construed as meaning "transmission link that allows communication of electronic information between a network and a cellular phone." Pet. 11. Patent Owner states that there is no need for any specific construction for this term and that the plain and ordinary meaning is applicable. PO Resp. 27–28. We agree with Patent Owner. The construction proposed by Petitioner is unhelpful in that it simply shifts the context of the modifier "cellular" from that of a connection to a phone. Nothing indicates that "cellular" or "cellular telecommunication connection" needs to be expressly construed. The plain and ordinary meaning as would be understood by one with ordinary skill in the art in the context of the '049 patent applies.

[11] This is the same construction we adopted for these terms upon the institution of trial. Dec. Inst. 12.

3.

"filtering parameter"

Each independent claims 11, 14, and 28 recites a "filtering parameter." In claim 11, the processor is configured to receive a filtering parameter. In claim 14, an apparatus performs the step of receiving a filtering parameter. In claim 28, the processor is configured to use a message class within a received multimedia message as a filtering parameter.

Patent Owner contends that "filtering parameter" should be construed as "as a parameter that denotes general information concerning a multimedia message that is used to classify the multimedia message, as distinguished from a parameter indicating the format of the multimedia components (i.e., the media type) of the message." PO Resp. 23. We note two components of Patent Owner's proposal: 1) a parameter that denotes "general information" concerning a multimedia message, and 2) a negative limitation that the parameter does not indicate the format of the multimedia components of the message. We also note that, in the LG Litigation, Patent Owner agreed to a construction of "filtering parameter" that is broader than the construction it now proposes. Specifically, Patent Owner (and Petitioner) previously agreed that "filtering parameter" means "an indication transmitted to the mobile terminal that is used as the basis for allowing or preventing the receiving of electronic information." Ex. 1049, 2. Patent Owner does not explain, or even acknowledge, its departure in this proceeding.

As to its proposal in this proceeding, Patent Owner contends that "filtering parameter" is "defined by the specification." PO Resp. 23. Patent Owner first points to the "Summary of the Invention" section of the '049

patent, in particular to the statement that "a specific parameter intended for filtering is attached to electronic information, with the help of which the electronic information is classified before it is delivered to a wireless terminal, and a receiving terminal is first informed of said parameter." *Id.* at 23–24 (citing Ex. 1001, 3:2–6). Patent Owner argues that, in this passage, "the filtering parameter is described as a parameter received at the mobile terminal and used to classify electronic information before that electronic information is actually received." PO Resp. 23.

Patent Owner further cites to description that it contends describes the invention generally, rather than simply a preferred embodiment. *Id.* at 24–26. For example, in discussing Table 1 (7:52–8:9), the '049 patent states "as one field the headers have the classification data of a message *according to the invention* in the field Message Class." *Id.* at 8:10–12 (emphasis added). In a discussion of Figure 3a, the '049 patent states:

> FIG. 3a shows one possible rough structure of a notification message 21, where the presented notification message 21 comprises a header part "Header Information" 22 and in addition, e.g. fields 23 for denoting the properties (such as the component's type and size) of the multimedia components (which there can be one or more) contained by multimedia messages. The "Header Information" part 22 comprises message class fields *according to the invention* which denote general information of the multimedia message stored in the MM-SC. Furthermore, the part 22 in question may contain the information on the sender's address and priority.

Id. at 11:5–15 (emphasis added). Both of these examples include the recitation "according to the invention." Patent Owner argues that "[b]y characterizing ***the invention*** in this way, the patentee is setting forth statements of definition." PO Resp. 26.

We are not persuaded by Patent Owner's arguments. None of the passages cited by Patent Owner purport to define "filtering parameter." They also do not, on their faces, purport to exclude subject matter from "filtering parameters."

Assuming that the '049 patent defines "the invention" as requiring sending information in headers that denote "general information" about multimedia messages, and that such requirement can be imputed to the term "filtering parameter," Patent Owner does not persuasively explain what "general information" is and how it excludes information that indicates the format of the multimedia components of the messages. Patent Owner argues that, in all of the examples it cites, "whether included in a notification message or in a header of an MMS message, the filtering parameter is found in a ***message class*** field, and serves to classify the MMS message." PO Resp. 26. Referring to Table 1 of the '049 patent, Patent Owner distinguishes the "message class field" from "fields such as '5. Content information of message,' which are used to indicate 'the types of the files' (i.e., the format of the multimedia components of the message), and not to 'denote general information of the multimedia message.'" *Id.* Here, Patent Owner appears to contend that a filtering parameter is limited to the "message class field" described in the Specification, a position that is problematic, as it would be a clear attempt to read a limitation into the claims from the Specification. Nevertheless, at the oral hearing, Patent Owner stated that "our construction does not say message class field" and that "[o]ur construction is that there must be information that classifies the message. It's possible you could do that in a way other than a designated message class field." Tr. 30:13–19.

When pressed at the oral hearing to explain what it meant by "general information," Patent Owner argued that "it is information that classifies the message as a whole" as opposed to information that "speak[s] to components of a message." *Id.* at 33:1–14. As to the meaning of "classify," Patent Owner argued "we haven't proffered any special definition of classify" but "we could revert to common everyday usage, and that would be something that would group things together on the basis of a common characteristic." *Id.* at 31:9–15. Patent Owner contended that, in an example of a message that included video or a picture, a media type parameter would only classify the video or picture portion of the message, and not the remainder of the message. *Id.* at 33:15–34:22.

We are not persuaded by Patent Owner's distinction and see no basis for it in the Specification. Patent Owner does not explain persuasively, or support with evidence, its position that the "message class" field provides general information about a message while other fields, for example the "from whom" field shown in Table 1 of the '049 patent, only provides information about portions of the message. Patent Owner contends that the "message class" field is the only field depicted in Table 1 that exemplifies a "filtering parameter." Tr. 36:7–37:18. Nevertheless, the Specification specifically identifies the "from whom" field as an example of a "filtering parameter." Ex. 1001, 15:49–51 ("The message class and possible other filtering parameters, such as the ID of the source . . . .). We read the Specification to describe "message class" as but one example of a "filtering parameter," with the other fields listed in Table 1 being other examples. Importantly, Patent Owner offers no persuasive support in the Specification, either lexicography or disclaimer, for its negative limitation, i.e., "as

distinguished from a parameter indicating the format of the multimedia components (i.e., the media type) of the message." *Cf. Omega Eng'g, Inc, v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003) ("Beyond the words of the claim, neither the district court nor Raytek has identified any express disclaimer or independent lexicography in the written description that would justify adding that negative limitation.").

As Petitioner points out (Reply 15–18), a broader construction is supported by other claims in the '049 patent. As the Federal Circuit has counseled, "[o]ther claims of the patent in question, both asserted and unasserted, can also be valuable sources of enlightenment as to the meaning of a claim term. Because claim terms are normally used consistently throughout the patent, the usage of a term in one claim can often illuminate the meaning of the same term in other claims." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (en banc) (internal citation omitted). Although not challenged in this proceeding, claims 6–8, 21, and 22 of the '049 patent are instructive.

Claim 1 recites, inter alia, "storing by a network element a specific filtering parameter in association with a multimedia message addressed to a recipient." Claim 18 recites, inter alia, "a processor configured to store a specific filtering parameter in association with the electronic information." Claims 6–8, 21, and 22 depend, directly or indirectly, from claim 1 or claim 18 and recite specific examples of "filtering parameter":

> Claim 6: "wherein said filtering parameter further comprises information for identifying an original source of the multimedia message"

Claim 7: "wherein the filtering parameter further comprises information for identifying a content of the multimedia message"

Claim 8: "wherein said filtering parameter further comprises information for identifying a content of the multimedia message"

Claim 21: "wherein the filtering parameter further comprises information identifying the original source of the electronic information"

Claim 22: "wherein the filtering parameter further comprises information identifying the content of the electronic information"

Indeed, claims 6, 7, 8, 21, and 22 give other examples, such as "information for identifying an original source of the multimedia message" (consistent with the example at column 15, lines 49–51, of the '049 patent) and "information for identifying a content of the multimedia message" (consistent with the "media type" information Patent Owner seeks to exclude from filtering parameter).

At the oral hearing, Patent Owner argued that the examples of claims 6–8, 21, and 22 "are in addition to the information that classifies the message in its entirety." Tr. 30:23–31:5. Patent Owner conceded that the examples of claims 6–8, 21, and 22 "are explained in the specification as additional ways in which filtering may be obtained," but argued that "always there is something that classifies the message first." *Id.* at 31:5–8. This argument is not persuasive. Claims 6–8, 21, and 22 do not just say that additional filtering can be performed using information identifying a source

or information identifying a content of a message. Rather, claims 6–8, 21, and 22 give examples of what a "filtering parameter" can be. Patent Owner offers no persuasive support for its argument that the language "filtering parameter" carries with it a requirement that it classify a message with a field akin to a class field. More importantly, claims 7, 8, and 22 directly refute Patent Owner's contention that a "filtering parameter" excludes "media type" information.

Additionally, claim 14 recites, inter alia: "receiving by an apparatus of a recipient to whom electronic information is addressed a filtering parameter associated with electronic information." Claim 15 depends from claim 14 and recites: "wherein the filtering parameter comprises the information on at least one class of a number of classes agreed on in advance, on the basis of which the electronic information has been classified into the class . . . ." That is consistent with reading "filtering parameter" in claim 14 sufficiently broad to cover more than just classifying a message with a class field. Furthermore, when considered in light of the substance of claims 6–8, 21, and 22, we determine that "filtering parameter" is broader than "information on at least one class."

Claims 11, 14, and 18 broadly recite "a filtering parameter" and allowing or preventing the receiving of information on the basis of the filtering parameter. The Specification describes examples of such filtering parameters, including a message class field, but, contrary to Patent Owner's arguments, does not define filtering parameters restrictively or exclude information such as media type information. Claims 6–8, 15, 21, and 22 echo these examples and make clear that a filtering parameter can include various types of information, such as information identifying message class,

identifying message source, and identifying message content, respectively. This evidence does not support the construction Patent Owner proposes in this proceeding. Rather, it fully supports the construction both parties agreed to in district court, namely, "an indication transmitted to the mobile terminal that is used as the basis for allowing or preventing the receiving of electronic information." Ex. 1049, 2. On the complete record, we adopt the construction of "filtering parameter" the parties agreed to in district court.

B. Level of Ordinary Skill in the Art

Relying on Mr. Lanning's testimony, Petitioner contends 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 similar degree, and at least two years of professional experience in the programming, design, or implementation of telecommunications protocols, or equivalent educational and professional experience. Pet. 9 (citing Ex. 1002 ¶ 11). Patent Owner does not propose a level of ordinary skill. Nevertheless, Dr. Konchitsky testifies to a level of skill similar to that proposed by Petitioner. Ex. 2010 ¶ 29. We find that Petitioner's proposal is consistent with the level of ordinary skill reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978). Accordingly, on the complete record, we adopt Petitioner's statement of the level of ordinary skill in the art.

C. The References as Prior Art Printed Publications

1. Public Accessibility

Patent Owner argues that Petitioner has not shown that Nokia Proposal (Ex. 1009), Sony Proposal (Ex. 1010), and each of the documents

within MMS Specs. (Ex. 1003–1006), respectively constitutes a printed publication, because Petitioner failed to demonstrate that these documents meet the requirements of "public accessibility." PO Resp. 28. For reasons discussed below, we determine that Petitioner has established that Nokia Proposal, Sony Proposal, and each of the documents within MMS Specs. constitutes a printed publication.

Prior to addressing Petitioner's evidence of public accessibility, we address Patent Owner's characterization of these documents as "early stage" versions of technical specifications and related proposals of 3GPP that were being debated in advance of formal "releases" by 3GPP of the specifications, and as "annotated throughout with editorial comments, tracked changes (e.g., revisions from earlier drafts), informalities, and placeholder text." PO Resp. 29–30. To the extent the characterization amounts to an argument that such "early stage" nature of the documents disqualifies them as printed publications, the argument is rejected. Patent Owner cites no authority to support the notion that a document in draft form cannot be deemed a printed publication even if it is sufficiently made publically accessible, and we decline to so hold. That a revision can be expected before formal "release" as a finished product does not undermine status of the draft as a printed publication if the draft itself is sufficiently publically accessible. Patent Owner conflates the legal concept of a "printed publication" in patent law and the formal "release" of a document as a completed work.

According to the Federal Circuit, "[b]ecause there are many ways in which a reference may be disseminated to the interested public, 'public accessibility' has been called the touchstone in determining whether a reference constitutes a 'printed publication'" under Section 102. *Kyocera*

Wireless Corp. v. Int'l Trade Comm'n, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (quoting *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986)). A reference is publicly accessible "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it." *SRI Int'l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008).

We assess public accessibility on a case-by-case basis. *See Kyocera*, 545 F.3d at 1350. In instances of references cataloged in libraries, for example, "competent evidence of the general library practice may be relied upon to establish an approximate time when a thesis became accessible." *In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986). As the Federal Circuit has counseled, "indexing is a relevant factor in determining accessibility of potential prior art, particularly library-based references." *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374, 1380 (Fed. Cir. 2012). Indexing may also be relevant to references stored in online databases, as "indexing is no more or less important in evaluating the public accessibility of online references than for those fixed in more traditional, tangible media." *Id.* In *SRI International*, for example, in the context of a motion for summary judgment, a document on an FTP server was not shown to have been sufficiently publicly available, in part, because "the FTP server did not contain an index or catalogue or other tools for customary and meaningful research." 511 F.3d at 1196.

On the other hand, in cases in which copies of documents actually were disseminated to interested members of the public, indexing is less important, if at all. For example, the Federal Circuit stated: "a printed

publication need not be easily searchable after publication if it was sufficiently disseminated at the time of its publication." *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014). In *Suffolk*, the prior art was a message posted to comp.infosystems.www.authoring.cgi, a newsgroup site. *Id.* at 1361. There, the patent owner argued that posted messages were non-indexed. *Id.* at 1365. The assertion appears not to have been in dispute.

In *Suffolk*, the Federal Circuit concluded that the posting was sufficiently disseminated to those of ordinary skill in the art to be considered publically accessible, after noting that the posting "elicited at least six responses over the week following its publication" and that "[m]any more people may have viewed the post without posting anything themselves." *Id.* The Court further noted: "the record indicates that those of ordinary skill in the art actually were using [the] newsgroups." *Id.* at 1364.

In another case, the Federal Circuit found that a paper presented orally at a technical conference and handed out afterward upon request was publicly accessible where "between 50 and 500 persons interested and of ordinary skill in the subject matter were actually told of the existence of the paper and informed of its contents by the oral presentation, and the document itself was actually disseminated without restriction to at least six persons." *Mass. Inst. of Tech. v. AB Fortia*, 774 F.2d. 1104, 1108–09 (Fed. Cir. 1985) ("*MIT*"); *cf. In re Klopfenstein*, 380 F.3d 1345, 1347 (Fed. Cir. 2004) (a printed slide presentation displayed continuously for two and a half days at a meeting of a technical association and displayed for less than a day at a university held to be publicly accessible). Discussing the *MIT* case, the *Klopfenstein* court noted that "[t]he key to the court's finding [in *MIT*] was that actual copies of the presentation were distributed. The

court did not consider the issue of indexing." 380 F.3d at 1349 (citing *MIT*, 774 F.2d at 1108–10).

The cases discussing the public accessibility of documents actually disseminated to members of the public are the most relevant to the facts of this proceeding. The other cases focusing on indexing, whether online or at a library, are less pertinent. For the reasons given below, we conclude that Nokia, Sony, and each of the documents within MMS Specs., i.e., MMS-1 v0.1.0, MMS-1 v0.2.0, MMS-1 v1.0.0, and MMS-2 were sufficiently publicly accessible at the relevant time and, thus, qualify as prior art printed publications.

Patent owner's expert, Dr. Konchitsky, explains that 3GPP is an organization consisting of six telecommunications standard development groups. Ex. 2010 ¶ 10. Dr. Konchitsky further explains:

> Members of 3GPP develop complete network system specifications by exchanging information regarding cellular telecommunications network technologies, including radio access, non-radio access, the core transport network, Wi-Fi integration, and service capabilities—such as codecs, security, quality of service. 3GPP's specifications and studies are thus contribution-driven by member companies. The 3GPP technologies from these groups are constantly evolving through generations of commercial cellular/mobile systems (such as UMTS WCDMA). Since the completion of the first LTE and the Evolved Packet Core specifications, 3GPP has become the focal point for mobile systems beyond 3G.

Id. We credit the above quoted testimony of Dr. Konchitsky, which is not disputed by Petitioner.

To establish these documents as printed publications, Petitioner relies on the testimony of Friedhelm Rodermund (Ex. 1007). Pet. 5–6. Mr. Rodermund details his experience with 3GPP and its record keeping,

including his work as Secretary for one of 3GPP's working groups, and states that he has personal knowledge of 3GPP's record keeping processes. Ex. 1007 ¶¶ 1, 2, 5, 6. Petitioner also relies on admissions of Patent Owner's expert witness, Dr. Konchitsky, as to his experience attending 3GPP meetings. Reply 3–6 (citing Ex. 1042 (Konchitsky Deposition)). Dr. Konchitsky testifies that he participated in 3GPP on behalf of DSP Communications, Inc., and Intel Corp. Ex. 2010 ¶¶ 10, 11.

According to Mr. Rodermund, 3GPP published its temporary and final specifications on an FTP server accessible to the general public without restriction. Ex. 1007 ¶¶ 11–13. Mr. Rodermund testifies that by 1999 at least 100 companies were members of 3GPP and multiple people at each of these companies participated in 3GPP meetings. *Id.* ¶ 14. Dr. Konchitsky testifies consistently, stating that such meetings were attended by a "few dozen" to "a few hundred" people. Ex. 1042, 44:19–45:2. Dr. Konchitsky testifies that drafts of documents to be discussed at the meetings were handed out at the meetings, for example via "USB keys that people were moving from one to another." *Id*. at 47:23–48:6; *see also id.* at 52:15–18 ("Q. And these companies had access to the materials circulated during these meetings; correct, sir? A. Again, if they are -- if they were at the meetings, they had it at the meeting."), 54:22–24 ("[W]hen I attended the meetings, I got those circulated live and while I was there, you know, with this USB."). Mr. Rodermund testifies that the date and location of the meeting at which a temporary document was presented is recorded on the first page of the document. Ex. 1007 ¶ 16. Patent Owner concedes that each of the documents at issue was handed out at the respective meetings to attendees. Tr. 44:3–8.

Mr. Rodermund also testifies that, as part of 3GPP's regular business practice, documents, including temporary documents such as those at issue in this proceeding, were uploaded to 3GPP's FTP server prior to meetings in which they were discussed. Ex. 1007 ¶¶ 14, 17. According to Mr. Rodermund, 3GPP sent emails notifying participants when documents had been uploaded to the FTP server. *Id.* ¶ 14. Dr. Konchitsky confirmed that he was able to access documents for meetings he did not attend. Ex. 1042, 54:24–55:3 ("When I was not there, because my information was subscribed or registered and subscribed to particular information that I wanted, I was able to access that after that has been posted on the 3GPP Web site. On the FTP of the 3GPP."). Mr. Rodermund identified MMS-1 v0.1.0, MMS-1 v0.2.0, MMS-1 v1.0.0, MMS-2, Nokia Proposal, and Sony Proposal as documents that were made available on the FTP server. Ex. 1007 ¶¶ 19, 20, 21, 22, 24, and 26.

Based on the testimony of Mr. Rodermund and Dr. Konchitsky, we find that physical copies of MMS-1 v0.1.0, MMS-1 v0.2.0, MMS-1 v1.0.0, MMS-2, Nokia Proposal, and Sony Proposal were distributed at the meetings listed on the faces of those documents. We further find that each of these documents was distributed to at least a "few dozen" and perhaps more than one hundred persons without restriction. We further find that, contemporaneously, additional persons were alerted, via e-mail, to the existence of these documents when they were uploaded to 3GPP's FTP site.

In arguing that these documents were publicly available as of the meeting dates appearing on the faces of those documents, Petitioner focuses on the actual, physical dissemination of those documents at the 3GPP

meetings convened to discuss those documents.[12] Reply 3–5. Petitioner contends that the recipients of the documents, representatives of major companies developing wireless standards and members of committees dedicated to the specific topics of those documents, were the persons most interested in the subject matter of those documents. *Id.* at 5. Petitioner draws a parallel between the facts of this proceeding and those of *MIT*. *Id.* at 8.

Patent Owner, for its part, focuses on the indexing, or lack thereof, of the documents stored on 3GPP's online database. PO Resp. 31–35. Patent Owner argues that such documents were searchable only by a directory of uninformative file names, such as that shown in Exhibit 2003, with no guidance from an index, README file, document list, or other explanation of the documents that make up the list of file names. *Id.* Also, Mr. Rodermund could not recall the sophistication of 3GPP's server search facility. Ex. 2002, 45:21–46:4. According to Patent Owner, in order to find a document on the 3GPP FTP site, a person would have had to know the temporary document number for the document and information about the meeting at which the document was discussed. PO Resp. 32–33. In that regard, Mr. Rodermund testifies that "the ftp document server is structured according to meetings, so each meeting has its own folder," and that "by knowing the document number, you can retrieve the document from this

[12] At the oral hearing, Petitioner conceded that the evidence does not support a finding that 3GPP disseminated copies of those documents via email. Rather, Petitioner contends that such emails included notifications of the documents and locations on the FTP site. Tr. 23:9–24:14. *See also* Ex. 2002 (Rodermund Dep.), 35:21–36:10 (confirming that e-mails notified recipients of the availability of new documents).

meeting folder." Ex. 2002, 13:2–6. Dr. Konchitsky testifies that, at the relevant time period, "it would be very difficult or impossible . . . for a person who was not an active participating member of the 3GPP review groups to search for documents on particular topics posted on the 3GPP servers." Ex. 2010 ¶ 57.

Patent Owner argues that the facts of this proceeding are akin to those of *SRI*. PO Resp. 35–38. According to Patent Owner, "there is no indication that an anonymous person of ordinary skill in the art in 1999 would have visited the 3GPP FTP server and 'freely navigated' through the appropriate folders, sub-folders, and directories to find the Draft MMS Specifications and proposal relied upon by Petitioner." *Id.*at 37. Patent Owner argues that Petitioner has not "provide[d] any evidence that the 3GPP FTP site was indexed in a manner comprehensible to an anonymous person of ordinary skill in the art in 1999 or that documents posted thereto were provided meaningful file names that might allow them to be located." *Id.* at 37–38. Drawing a distinction between participants in 3GPP meetings and "anonymous" persons of ordinary skill, Patent Owner argues that "Petitioner offers no evidence that anyone outside of 3GPP working groups ever even viewed the Draft MMS Specifications on which it relies outside of the very meetings at which they were purportedly discussed." *Id.* at 38.

As indicated above, we are guided by the Federal Circuit's treatment of similar facts in cases involving actual dissemination of documents or actual presentation to interested persons of ordinary skill, such as *MIT* and *Klopfenstein*. In *MIT*, a document held to be publicly accessible was presented orally to between 50 and 500 skilled artisans at an industry conference and, after the fact, actually distributed without restriction to six

persons. *MIT*, 774 F.2d at 1108–09. In *Klopfenstein*, the Federal Circuit found that a set of printed posters, continuously displayed for two and a half days at one industry meeting and again for less than one day at another, was a printed publication, even though no copy of the presentation was disseminated at either meeting and the presentation was never catalogued or indexed in any library or database. 380 F.3d at 1350. Cataloguing and indexing in a library or database is not required where there has been sufficient actual dissemination. Moreover, where there is subsequent additional storage in a database, following sufficient actual dissemination, the stored copy need not be easily accessible. *Suffolk*, 752 F.3d at 1364. As explained above, in this proceeding, the papers in question were handed out without restriction to at least dozens of skilled artisans, with more being alerted, by email, to the posting of the documents on 3GPP's server. Ex. 1007 ¶¶ 11–14, 16, 17; Ex. 1042, 47:23–48:6, 52:15–18, 54:22–55:3. That constitutes sufficient actual dissemination of the documents at issue to qualify them as printed publications, even if the posted documents on 3GPP's server are not indexed or easily searchable.

The facts of the *SRI* case, on the other hand, are quite different from those in this proceeding. In *SRI*, a document (the "Live Traffic" paper) on a publicly accessible FTP server was not shown to be publicly accessible when "[n]either the directory structure nor the README file in the PUB subdirectory identifies the location of papers or explains the mnemonic structure for files in the EMERALD subdirectory, or any subdirectory for that matter," and the evidence did "not show that an anonymous user skilled in the art in 1997 would have gained access to the FTP server and would have freely navigated through the directory structure to find the Live Traffic

paper." 511 F.3d at 1196. In *SRI*, the record showed that only one member of the public knew about the availability of the Live Traffic paper. *Id.* In *SRI*, there was no evidence that any copy was actually disseminated to anyone. Importantly, *SRI* specifically distinguished its facts from those of cases of actual dissemination, observing that, "[u]nlike the posters hung at a conference in *Klopfenstein*, the Live Traffic paper was not publicized or placed in front of the interested public." 511 F.3d at 1197. Rather, the Federal Circuit characterized the facts of *SRI* as "most closely analogous to placing posters at an unpublicized conference with no attendees." *Id.*

At the hearing, Patent Owner distinguished *MIT* from the facts of this proceeding by arguing that the distribution of the documents at 3GPP's respective meeting "was not to the public person of ordinary skill." Tr. 45:10–13. Patent Owner concedes that the people attending these meetings would have met the minimum qualifications for persons of ordinary skill in the art. *Id.* at 42:3–7. Nevertheless, Patent Owner argued, "[w]e must consider the people not at the meeting, because the person of ordinary skill is not just the folks at the meeting." *Id.* at 42:13–18. According to Patent Owner, "[t]he petitioner's definition of the person of ordinary skill does not say it's a member of this working group. So we consider the public at large or the members of ordinary skill at large. So dissemination at the meeting doesn't reach that person." *Id.* at 41:8–13.

We are not persuaded by Patent Owner's arguments. In *MIT*, 774 F.2d at 1109, it was sufficient that a document was made known to attendees of an industry conference. Similarly, in *Klopfenstein*, 380 F.3d at 1351, it was sufficient that a presentation was displayed to attendees of an industry conference attended by skilled artisans. Patent Owner does not

point to any authority stating that, in the case of actual dissemination of a reference, that reference must have been made available to skilled artisans at large, rather than just to people with at least ordinary skill who already had an interest in the subject and have become members of a working group focusing on the subject. Here, the evidence shows that the documents in question were actually handed out to dozens of skilled artisans who were interested in the subject, without restriction on subsequent dissemination. We observe also that the members of 3GPP's working group do not cease to be members of the public at large when they have involved themselves in a working group focusing on specific subject matter of interest to them.

On the complete record, we conclude that MMS-1 v0.1.0, MMS-1 v0.2.0, MMS-1 v1.0.0, MMS-2, Nokia, and Sony were sufficiently publicly accessible prior to the filing date of the '049 patent and, thus, are prior art printed publications.

2. Nokia Proposal as Prior Art

The Nokia Proposal does not identify on its face its author or authors. The evidence shows, however, that the named inventor of the '049 patent, Matti Salmi, participated, along with Jeus Staack, as a delegate for Nokia Corporation in the meeting at which the Nokia Proposal was presented. Ex. 1007 ¶ 27; Ex. 2016, 5. Patent Owner contends that, because of Mr. Salmi's participation in the meeting and alleged similarities between Nokia and the '049 patent, Mr. Salmi likely is the author of Nokia. PO Resp. 44–45. Patent Owner argues that Petitioner's challenge is under 35 U.S.C. § 102(a), and that under § 102(a), an inventor's own work is not prior art. Patent Owner contends that the priority date of the '049 patent is

December 3, 1999, the date of the filing of an application in Finland. *Id.* at 45.

"One's own work is not prior art under § 102(a) even though it has been disclosed to the public in a manner or form which otherwise would fall under § 102(a)." *In re Katz*, 687 F.2d 450, 454 (CCPA 1982). However, the same is not true for prior art under 35 U.S.C. § 102(b):

> Disclosure to the public of one's own work constitutes a bar to the grant of a patent claiming the subject matter so disclosed (or subject matter obvious therefrom) . . . when the disclosure occurred more than one year prior to the date of the application, that is, when the disclosure creates a one-year time bar, frequently termed a "statutory bar," to the application under § 102(b).

Id. Thus, the threshold issue is whether the Nokia Proposal qualifies as prior art under § 102(b).

The Nokia Proposal was presented and distributed at a 3GPP meeting on June 14–16, 1999. Ex. 1009, 1. As explained in Section I.B above, Nokia was publicly accessible as of the dates of this meeting. The earliest United States filing date that the '049 patent can claim is December 1, 2000. Ex. 1001, [63]. The '049 patent also lists a foreign application priority date of December 3, 1999, the filing date of a Finnish application. *Id.* at [30].

Section 102(b) (emphasis added) provides: "A person shall be entitled to a patent unless — . . . (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the *date of the application for patent in the United States*." On its face, the express language of the statute states that its statutory bar is evaluated as of the patent's filing date in the United States, in this case December 1, 2000. For purposes of § 102(b), we

do not consider the December 3, 1999, foreign filing date. *See* 35 U.S.C. § 119(a) ("no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing"); MPEP §§ 706.02(VI), 2133.02(II). It is not necessary to determine who wrote the Nokia Proposal. The Nokia Proposal is prior art under § 102(b), regardless of who authored it. Accordingly, Patent Owner's arguments that the Nokia Proposal represents the work of Mr. Salmi are inconsequential and do not help its position.

D. Claims 11–14 and 17 as Obvious over MMS Specs. and the Nokia Proposal

We have reviewed the arguments and evidence presented by Petitioner, and determine that, notwithstanding the arguments of Patent Owner, Petitioner has established by a preponderance of the evidence that claims 11–14 and 17 are unpatentable as obviousness over MMS Specs. and the Nokia Proposal.

MMS-1 v0.1.0

MMS-1 v0.1.0 is the first of three Stage 1 documents in the collection referred to by Petitioner as MMS Specifications. It begins with this statement: "This Technical Specification defines the stage one description of the Multimedia Messaging Service, MMS. Stage one is an overall service description, primarily from the subscriber's and service provider's points of view." Ex. 1003, 5. Figure 1 of MMS-1 v0.1.0 is reproduced below:

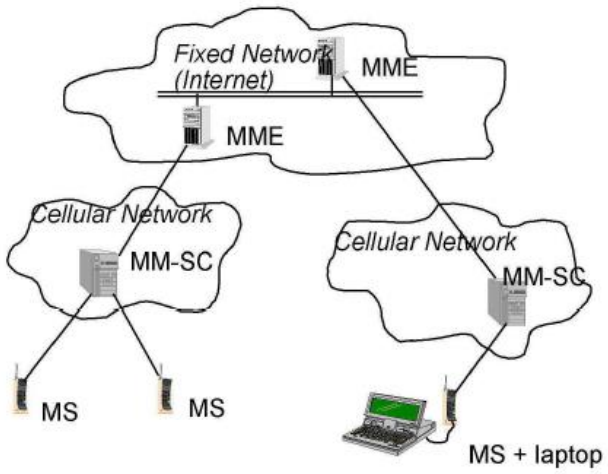

Figure 1: General view of the MMS architecture

Figure 1 illustrates the MMS architecture in a general and abstract level. *Id.* "MM" is abbreviation for Multimedia Message; "MM-SC" is abbreviation for Multimedia Message Service Center; and "MMS" is abbreviation for Multimedia Message Service. *Id.* at 6. This architecture identifies 3 different entities: (1) MM-Originator, (2) MM-Terminator, and (3) MM-Service Centre, MM-SC. *Id.* at 6–7. MM-Originator is defined as: "[t]his entity covers those parts necessary to compose and deliver a MM to the MM-Service Centre. The standard shall permit the location to be either within a mobile or fixed network." *Id.* at 6. MM-Terminator is defined as:

> This entity is the addressee of an MM transmitted by the originator to the MM-SC. The MM-terminator shall be either informed by an appropriate notification or the MM is directly delivered, if a new MM becomes available at the MM-SC. The standard shall permit the location to be either within a mobile or fixed network.

Id. at 6–7. MM-SC or MM-Service Centre is defined as:

> This entity enables in general the store and forward principle of the MMS. It can logically split into a message handling and a MM server part. The content of an incoming MM shall be stored in the server while the MM-terminator is notified as soon as it becomes reachable to the network. The standard shall permit the

> location to be either within or outside the mobile network providers domain.

Id. at 7.

MMS-1 v0.1.0 describes: "The MMS shall **provide MM downloading either initiated by the MM-terminator, e.g. as a resulting action of a notification**, or by the MM-SC to support the means of direct message delivery." *Id.* at 7 (emphasis added). With regard to notification, MMS-1 v0.1.0 states:

> The MMS shall provide a generic notification mechanism to:
>
> - notify the MM-terminator
> - acknowledge the MM-originator
>
> Notification shall be used for at least the following purposes:
>
> - **inform the MM-terminator about incoming messages**, including a description of the message, e.g. content, size, type. **Based upon this information the recipient (user or application) can instruct the MM-SC how to handle this MM**.
> - inform the MM-terminator about actions taken in MM-SC, e.g. due to profile settings like automatic MM forwarding, deletion, etc.

Id. at 8 (emphases added). MMS-1 v0.1.0 further states:

> the standard shall support **personalized MM handling, e.g. a user profile should be used for specifying user defined restrictions** (**parameters specifying what kind of messages should be screened** or forwarded, directly delivered or stored at the MM-SC, etc.).
>
> Similar to the capacity check, **the user profile handling can be performed either at the MM-terminator or in the MM-SC**.

Id. at 7–8 (emphases added). MMS-1 v0.1.0 describes that the personal profile may be located at the MM-terminator. *Id.* at 9.

MMS-1 v0.2.0

MMS-1 v0.2.0 begins with this statement: "[t]his Technical Specification defines the stage one description of the Multimedia Messaging Service, MMS. Stage one is an overall description of the capabilities which need to be considered for the provision of multimedia messaging service, primarily from the subscriber's and service providers' points of view." Ex. 1004, 5.

Figure 1 of MMS-1 v.0.1.0 is not included in MMS-1 v0.2.0. Also, although MMS-1 v0.2.0 still uses the terms "MM" and "MMS" which are defined as "Multimedia Message" and "Multimedia Message Service," respectively, it no longer uses the terms "MM-originator" and "MM-terminator." Instead, MMS-1 v0.2.0 uses the terms "sender" and "recipient." *Id.* at 6. Regarding notification, MMS-1 v0.2.0 states:

> The MMS shall provide a generic notification capability to inform the user in an appropriate manner. For example to:
>
> - inform the recipient about stored messages (including a description of the message, e.g. content, size, type).
> - inform the recipient about actions taken in network, (e.g. due to profile settings like automatic MM forwarding, deletion, etc.)
> - inform the sender about successful or failed MM delivery or storage of MM.

Id. at 8–9. In contrast with MMS-1 v0.1.0, MMS-1 v0.2.0 does not expressly describe that based on data provided in a notification, the recipient (user or application) can instruct any message center on how to handle the MM. MMS-1 v0.2.0 refers to message screening as follows:

> The MMS shall provide the capability to support MM prioritization and **MM screening** (e.g. **the sender and recipient of the MM can** prioritize the importance of the multimedia

> messages or **automatically delete "junk mail" without delivery to the recipient's terminal**).
>
> **Regarding the prioritized delivery and message screening the recipient shall have ultimate control** subject to any MM screening which is imposed by the network.

Id. at 8 (emphases added). With regard to use of a user profile, MMS-1 v0.2.0 does not expressly state where the user profile is stored. Instead, it states: "The user is able to create, update, store, transfer, interrogate, manage and retrieve his multimedia messaging profiles." *Id.* at 9. It further states: "For example the user can define what media types and notification shall be delivered to him (e.g. voice only or text only)." *Id.*

MMS-2

MMS-2 is a Stage 2 document within the collection of documents referred to by Petitioner as MMS Specifications. It begins with this statement: "[t]his 3GPP Technical Specification defines the stage 2 and stage 3 description of the non realtime Multimedia Messaging Service, MMS. Stage 2 identifies the functional capabilities and information flows needed to support the service described in stage 1." Ex. 1006, 4. MMS-2 also refers to Stage 1 as follows: "MMS uses a number of technologies to realise the requirements of the stage 1 description (3G TS 22.140). This TS describes how the service requirements are realised with the selected technologies." *Id.* Thus, MMS-2 provides a non-specific reference to Stage 1 documents designated by 3G TS 22.140 without indication of the version numbers.

With regard to referencing prior documents, MMS-2 states that for a specific reference, subsequent revisions do not apply, and that for a non-specific reference, **the latest version applies**. *Id.* at 5 (emphasis added).

Figure 2 of MMS-2 is reproduced below:

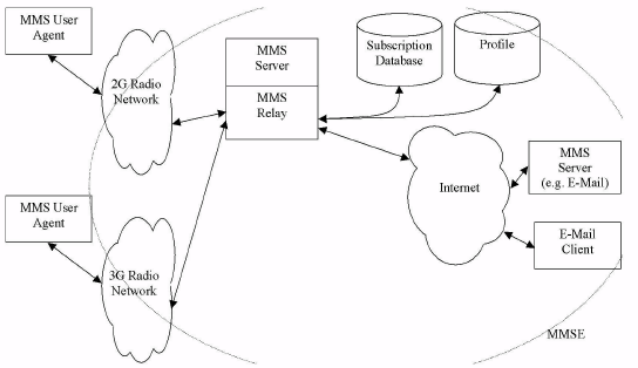

Figure 2 : MMS Architecture Overview

Figure 2 provides an overview of the multimedia messaging system architecture. *Id.* at 7. "MMSE" is defined as "Multimedia Message Service Environment." *Id.* at 5.

MMS-2 describes that "MMS Server" is the element responsible for storing messages. *Id.* at 7. With respect to "MMS relay," MMS-2 describes that it is the element that is responsible for: (1) receive and send MM; (2) enable/disable MMS function; (3) **personalized multimedia messaging**; (4) MM deletion; (5) media type conversion; (6) media format conversion; (7) message content retrieval; (8) MM forwarding; and (9) screening of MM. *Id.* at 7–8 (emphasis added). Figure 10 of MMS-2 is reproduced below:

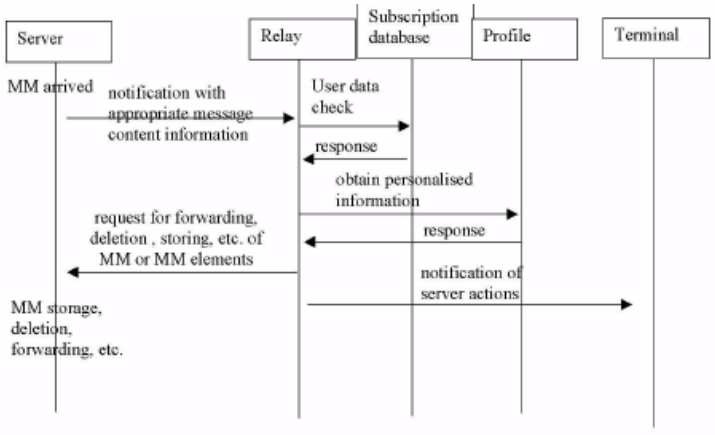

Figure 10: notification of automatic server actions

Figure 10 illustrates the various actions taken at the server and the reporting of those actions. *Id.* at 12. In that regard. MMS-2 states:

> When a MM has arrived at the Server, the Server notifies the Relay. This notification contains further information of the MM (e.g. directory of MM elements together type and size). Then the relay may check the subscription data if required (subject to prior MM session establishment) and then obtains the personalized information from the profile. MM is processed according to the profile information at the Server, e.g. MM or MM elements are deleted, forwarded to another server or stored for later retrieval using pull delivery. Subsequent to that server processing, the Relay may notify, depending on the settings in the profile, the Terminal of the actions undertaken at the Server.

Id.

1. Independent Claims 11 and 14

Claim 11 is drawn to an apparatus and claim 14 is drawn to a method. Claim 11 is representative of claims 11 and 14, because the steps recited in claim 14 correspond to the functions performed by the processor recited in claim 11. Our discussion with respect to claim 11 also applies to claim 14.

Claim 11 recites, in pertinent part: "a radio part configured to enable receiving electronic information through a cellular telecommunication connection." Based on our discussion of MMS-Specs. above, and on Petitioner's presentations on pages 15–16 of the Petition, Petitioner has shown that the system and method of MMS-1 v0.1.0 includes this feature. Specifically, Figure 1 of MMS-1 v0.1.0 shows mobile stations (MS) connected to a cellular network. Mr. Lanning testifies that one with ordinary skill in the art would have understood the figure as illustrating that the mobile stations represent cellular phones configured to exchange electronic information with the cellular network via a radio part. Ex. 1002 ¶ 42. The

'049 patent states that a radio part is an element of a wireless terminal that can transmit and receive radio frequency messages via its antenna. Ex. 1001, 14:39–50. The mobile stations shown in Figure 1 of MMS-1 v0.1.0 includes an antenna.

Claim 11 further recites: "a processor configured to receive a filtering parameter over the cellular telecommunication connection via the radio part, which filtering parameter is related to the electronic information." Based on our construction of "filtering parameter," Petitioner's presentations supported by the testimony of Mr. Lanning, and notwithstanding Patent Owner's contrary arguments which we discuss below, Petitioner has shown that the method and apparatus according to MMS-1 v0.1.0 includes this feature. In particular, MMS-1 v0.1.0 describes that notification shall be used to inform a MM-terminator about incoming messages, including a description of the message, e.g., content, size, type, and that based upon that information the recipient (user or application) can instruct the MM-SC how to handle the incoming message. Ex. 1003, 8. The information included in the notification message constitutes the filtering parameter. Mr. Lanning testifies that each of the content, size, and type description within the notification message would constitute a filtering parameter. Ex. 1002 ¶ 44. With regard to the filtering parameter being an indication on the basis of which receiving of electronic information is allowed or prevented, that is explained in connection with the next limitation of claim 11.

Petitioner also explains that although MMS Specs. do not refer to a processor that is performing the pertinent operations explicitly, "a POSITA would have understood that the mobile stations of the MMS Specifications comprise processors configured to carry out the disclosed functions of the

mobile station, including receiving a filtering parameter." Pet. 17. The acronym "POSITA" refers to a Person of Ordinary Skilled In The Art. Pet. 9. Petitioner's explanation is supported by the testimony of Mr. Lanning (Ex. 1002 ¶ 45) and is persuasive.

Claim 11 additionally recites: "wherein the processor is further configured to automatically allow or prevent the receiving of the electronic information on the basis of said filtering parameter and the apparatus is arranged not to receive the electronic information through the cellular telecommunication connection when the filtering parameter denotes the electronic information being prevented." Based on our construction of "filtering parameter," Petitioner's presentations supported by the testimony of Mr. Lanning, and notwithstanding the contrary arguments of Patent Owner which we discuss below, Petitioner has shown that the method and apparatus according to MMS-1 v0.1.0 includes this feature.

MMS-1 v0.1.0 describes that the standard shall support "personalized MM handling, e.g. a user profile should be used for specifying user defined restrictions (parameters specifying what kind of messages should be screened or forwarded, directly delivered or stored at the MM-SC, etc.)." Ex. 1003, 7. MMS-1 v0.1.0 also describes that the user profile handling can be performed either at the MM-terminator or in the MM-SC. *Id.* at 7–8. Petitioner has identified and relied on those disclosure of MMS-1 v0.1.0. Pet. 18–20. Petitioner also refers to description in MMS-1 v0.1.0 that "[t]he profile shall at least support MM filtering" where filtering "means that the MM or specific elements are not automatically delivered to the MM-

terminator." Pet. 20 (citing Ex. 1003, 9).[13] Citing to the same parts of MMS-1 v0.1.0, Mr. Lanning testifies that "MMS Specifications disclose the electronic information not being received at the mobile station when the filtering parameter indicates delivery of the electronic message should be prevented." Ex. 1002 ¶ 52.

With regard to the limitation "automatically allow or prevent the receiving of the electronic information on the basis of said filtering parameter," Petitioner has cited to disclosure in MMS-1 v0.1.0 that based on information in the notification message, either the user or the application can instruct the MM-SC how to handle the multimedia message. Pet. 16–17 (citing Ex. 1003, 8). Given our construction of "automatically allow or prevent the receiving of the electronic information on the basis of said filtering parameter," the identification of the "application," in contrast to the "user," as the decision maker on how to handle an incoming multimedia message satisfies the limitation. It is understood that in the case of the "application" deciding, the user is not making the decision after receipt of the filtering parameter. Petitioner additionally relies on Nokia for its disclosure of "automatic" message screening based on "user configurable option" as an alternative to an approach that requires user interaction. Pet. 19 (citing Ex. 1009, 3). No such reliance on the Nokia Proposal is necessary, because Petitioner has made a showing that MMS-1 v0.1.0 discloses the limitation.

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[13] Petitioner additionally relies on MMS-1 v0.2.0 for its description of automatic deletion of junk mail without delivery. Pet. 20. No such reliance is necessary. MMS-1 v0.1.0 discloses the "automatically allow or prevent the receiving" limitation.

In any event, we are persuaded by Petitioner that in light of Nokia's disclosure of "automatic" message screening, one with ordinary skill in the art would have known to make "automatic" the allowing or preventing of receiving of electronic information on the basis of the filtering parameter in MMS-1 v0.1.0 automatic. The Petition expresses reasoning with rational underpinning with regard to why one with ordinary skill in the art would have been motivated to combine the Nokia Proposal teachings with that of MMS Specs. in the manner proposed by Petitioner. Pet. 13–14. Petitioner notes: "The stated goal of the Nokia Proposal was 'to provide the basis for the technical discussion related in choosing the suitable platform for MMS.' (Nokia Proposal at LGE0747846; Lanning Decl. ¶ 40.)" Pet. 13. MMS-1 v0.1.0, on the other hand, is the first of three Stage 1 documents in the collection referred to by Petitioner as MMS Specifications. It begins with this statement: "[t]his Technical Specification defines the stage one description of the Multimedia Messaging Service, MMS. Stage one is an overall service description, primarily from the subscriber's and service provider's point of view." Ex. 1003, 5. We agree with Petitioner that the Nokia Proposal expressly complements the subject matter addressed by MMS Specs. *See* Pet. 13.

Patent Owner argues that the notification message in the MMS Specs. does not contain a filtering parameter. PO Resp. 46–54. We are unpersuaded. The basis of Patent Owner's contention centers on its own construction of "filtering parameter," which we have rejected above. According to Patent Owner, information on "content, size, and type" of a multimedia message cannot be a filtering parameter because they are not general information about a message and usable to classify a message. PO

Resp. 46–53. We have addressed that argument and rejected it for reasons discussed above in Section II.A.3. For instance, Patent Owner argues that a reference in MMS-1 v0.1.0 to handling a message based on content, size, and type of a message is merely about handling a message according to the media type included within the message. PO Resp. 49–50. But that disclosure constitutes using a filtering parameter to allow or prevent delivery of a message when delivery of the message is based on the media type of the message. Patent Owner argues that determining whether only the text portion or the voice portion would be delivered is not about delivering the message. PO Resp. 51. But it is when the entire message is a text message or when the entire message is a voice message.

As specifically discussed above, MMS-1 v0.1.0 describes: (1) a notification message that includes content, size, and type information about an incoming message, and based on that information the user or application can instruct the MM-SC how to handle the incoming message; (2) personalized MM handling by use of a personal profile for specifying user defined restrictions—what kind of messages should be screened; (3) MMS provides downloading initiated by the MM-terminator as a resulting action of a notification; and (4) the profile supports filtering where filtering means the multimedia message or specific elements thereof are not automatically delivered to the MM-terminator. The evidence supports reading the notification message as including a filtering parameter. A logical implication of these disclosures, read together, is that the parameters stored in the user profile are used to evaluate the information in a notification (corresponding to one or more filtering parameters) to determine whether to instruct the MM-SC to prevent or allow delivery of the message.

Patent Owner argues that MMS-1 v0.1.0 discloses that in some instances, a message that has been prevented from delivery can still be later accessed upon user request rather than forever barred from any delivery. PO Resp. 53–54. The argument is misplaced because the limitation "automatically allow or prevent the receiving of the electronic information on the basis of said filtering parameter" is satisfied by one instance of its occurrence and does not require more, e.g., deletion of the message at the MM-SC, the Multimedia Message Service Center.

Patent Owner argues that Petitioner's reliance on the Nokia Proposal as disclosing an example of providing a filtering parameter that is used to automatically allow or prevent the receiving of electronic information is without merit because the teaching merely addresses multimedia handling and not classifying a message based on a filtering parameter. PO Resp. 55–56. The argument is misplaced. Petitioner has not relied on Nokia as disclosing a notification message including a filtering parameter. Rather, Petitioner cited to the Nokia Proposal for its general teaching of "automatic" message screening based on user configurable options. Pet. 19. A notification message including a filtering parameter already is disclosed by MMS-1 v0.1.0, as we have discussed above. Furthermore, we have determined above that Petitioner does not need to rely on the Nokia Proposal for the "automatic" requirement of the claim, because Petitioner has shown that MMS-1 v0.1.0 discloses the "automatic" aspect of allowing or preventing the receiving of electronic information on the basis of a filtering parameter.

Patent Owner also argues that MMS Specs. does not disclose that the filtering is performed by a processor located at the mobile device as is

required by the claims. PO Resp. 57–61. We are unpersuaded. As discussed above, MMS-1 v0.1.0 describes (1) that it is the user or an application that instructs the MM-SC how to handle the incoming message based on the information included in a notification message; (2) that the MMS provides MM downloading initiated by the MM-terminator as a resulting action of a notification; (3) that a personal profile is used for specifying user defined restrictions, such as what kind of messages should be screened; (4) that personal profile handling may be performed at the MM-terminator; and (5) that the personal profile may be located at the MM-terminator. The evidence supports Petitioner's assertion that the filtering is performed at the mobile device of MMS-1 v0.1.0.

Patent Owner argues that all of the MMS Specs. documents must be read collectively, not individually, and that because MMS-2 as a later document requires that the user profile is stored not at the terminals one with ordinary skill in the art would have recognized that the solution provided by MMS-2 "must be" the one used in the MMS architecture notwithstanding any contrary indication in the earlier documents, e.g., MMS-1 v0.1.0. PO Resp. 57–61. We note that page 4 of MMS-2, cited by Patent Owner, nowhere states that the user profile is required to be stored away from the terminal. However, it is the case that Figures 3–11 of MMS-2, as noted by Patent Owner, show that in the system architecture according to MMS-2 the user profile is placed away from the terminal. Ex. 1006, 8–12. For reasons discussed below, Patent Owner's argument is misplaced.

Notwithstanding that the documents within MMS Specs. are related to each other and are produced in chronological order on a common subject, the disclosures in each stand on their own merit. The teachings in an earlier

document, i.e., MMS-1 v0.1.0, insofar as the public is concerned, are not rendered null and void because a later document, MMS-2, reflects a changed preference of the working group and does not contain the same disclosure. At issue is what each document discloses in terms of technology, not what document reflects the most current thinking of the working group on the subject. At oral hearing, counsel for Patent Owner stated that Patent Owner's position is that MMS-2 "reflected the most up-to-date thinking of the relevant committee. And it is that thinking that the person of ordinary skill would look to when going to implement systems of this nature." Tr. 47:19–22. That characterization of the obviousness determination is incorrect, and overlooks the actual content of each prior art reference.

Patent Owner further argues: "Additionally, a person of ordinary skill, reading these Draft MMS Specifications and seeing that only the earliest draft (Ex. 1003, MMS-1 v0.1.0) indicated that a profile might be stored or used at a mobile device as opposed to a remote server, would be *discouraged* from exploring the option." PO Resp. 60 (emphasis added). In that regard, Patent Owner does not cite to any supporting testimony of its expert, Dr. Konchitsky. Patent Owner also has cited to nothing in MMS-2 that disparages having the user profile stored at the mobile terminal device as either impracticable, unusable, or inoperative. We find Patent Owner's argument unpersuasive.

2. Claims 12, 13, and 17

Claim 13 depends from claim 11, and claim 17 depends from claim 14. On pages 20–21 of the Petition, Petitioner explains how the limitation added by claim 13 relative to base claim 11 is met by the disclosure of MMS-1 v0.1.0 as would have been understood by one with ordinary skill in

the art. On pages 25–26 of the Petition, Petitioner explains how the limitation added by claim 17 relative to base claim 14 is met by the disclosure of MMS-1 v0.1.0 as would have been understood by one with ordinary skill in the art. We agree with and are persuaded by Petitioner's analysis of the limitations added by claims 13 and 17 relative to their respective base claims 11 and 14. For these claims, Patent Owner presents no argument not already addressed and rejected above in the context of claims 11 and 14. We determine that Petitioner has shown by a preponderance of the evidence that each of claims 13 and 17 would have been obvious over MMS-Specs. and the Nokia Proposal.

Claim 12 depends from claim 11. On pages 26–30 of the Petition, Petitioner accounts for the limitations added by claim 12 relative to its base claim 11. Patent Owner presents no argument not already addressed above in the context of claim 11. We have reviewed the arguments and evidence presented by Petitioner with respect to claim 12, and determine that Petitioner has shown by a preponderance of the evidence that claim 12 would have been obvious over MMS-Specs. and the Nokia Proposal.

For claim 12, Petitioner relies on the user profile in MMS-1 v0.1.0, MMS-1 v0.2.0, and MMS-2 as the marking in advance of information as being allowed or prevented on the basis of a filtering parameter. Pet. 26–29. Patent Owner presents no argument not already addressed and rejected above in connection with base claim 11. We find that Petitioner's position is supported by the cited evidence. We also agree with Petitioner that the teachings within each of the MMS Specs. documents about the structure and use of a user profile are combinable with each other, because the documents are describing a common subject matter, i.e., a standard for multimedia

messaging service, and because all include the use of a user profile in that standard. For instance, as is explained by Petitioner:

> A POSITA would have been motivated to combine MMS Stage 1 and MMS Stage 2 because they were compiled and published to discuss, develop, and propose an industry standard for communications between mobile phones. (*Id.*) Specifically, MMS Stage 1 (including Exs. 1003–05) established service requirements for MMS, and MMS Stage 2 (including Ex. 1006) described "how the service requirements are realised." (MMS-2, Sec. 1, at LGE0748922; Lanning Decl. ¶ 40.) Accordingly, a POSITA would understand that MMS Stage 1 and MMS Stage 2 complement each other and are to be considered in conjunction.

Pet. 13. Petitioner further persuasively explains that "a POSITA would have understood that profile interaction would occur through a user interface in the mobile station." *Id.* at 27 (citing Declaration ¶ 55 of Mark R. Lanning, Ex. 1002). Petitioner additionally explain, persuasively, that "[a]lthough the MMS Specifications do not explicitly disclose the details of a 'processor' performing the claimed functionality, a POSITA would have understood that the mobile stations of the MMS Specifications comprise processors configured to carry out the disclosed functions of the mobile station, including comparing the received filtering parameter to the marking made in advance." *Id.* at 28 (citing Declaration ¶ 57 of Mark Lanning, Ex. 1002).

On pages 28–29 of the Petition, it is persuasively explained how MMS Specs., specifically the teachings of MMS-1 v0.1.0, or MMS-1 v0.1.0 and MMS-1 v0.2.0, account for claim 12's limitation "said apparatus is arranged to receive the electronic information through the cellular telecommunication connection only when said comparison shows the receiving of the electronic information being allowed." Pet. 28–29.

For that limitation, Petitioner alternatively relies on the disclosure of the Nokia Proposal. Pet. 29–30. That reliance is unnecessary because Petitioner has shown that the system and method of MMS-1 v0.1.0, or MMS-1 v0.1.0 and MMS-1 v0.2.0, includes this feature. Our discussion of the limitation in claim 11 on "allow or prevent the receiving of the electronic information on the basis of said filtering parameter" also applies here.

For the foregoing reasons, we determine that Petitioner has shown by a preponderance of the evidence that claim 12 would have been obvious over MMS-Specs. and the Nokia Proposal.

E. Claims 28–31 as Obvious over MMS Specs., Nokia Proposal, Sony Proposal, and SMS

We have reviewed the arguments and evidence presented by Petitioner, and determine that, notwithstanding the arguments of Patent Owner which are discussed below, Petitioner has established by a preponderance of the evidence that each of claims 28–31 is unpatentable as obviousness over MMS Specs., Nokia Proposal, Sony Proposal, and SMS.

Claim 28 is independent. Claims 29 and 31 each depend from claim 28. Claim 30 depends from claim 29. Claim 28 is much like claim 11 discussed above. The differences between claim 28 and claim 11 are:

1. While claim 11 refers to receiving electronic information, claim 28 refers to receiving "a multimedia message that comprises the following fields: message class, subject, to whom, and content information of the multimedia message."

2. Although claim 11 recites receiving a filtering parameter, claim 28 recites receiving a notification message, and specifies that receipt of the notification message is prior to receiving the content information of the multimedia message, and that the notification message comprises the "message class" of the multimedia message.

3. Claim 28 recites that the "message class" is used as the filtering parameter.

The discussion above applying MMS Specs. to claim 11 also applies to claim 28. We make additional analysis here to address the subject matter of claim 28, taking into account the difference mentioned above.

First, in MMS-1 v0.1.0, the electronic information received from the cellular communication network is a multimedia message. Ex. 1002 ¶ 86. Also, MMS-1 v.0.1.0 discloses that the multimedia message includes the "type" of the message and the content of the message. *Id.*; Ex. 1003, 7. The term "type" reflects a "message class." Petitioner acknowledges that MMS-1 v0.1.0 does not describe explicitly that the multimedia message include a "subject" field and a "to whom" field." Pet. 33. Petitioner identifies SMS as describing electronic messages with "subject" and "to whom" fields. *Id.* Petitioner asserts that "[a]s MMS was built on SMS, it would have been obvious to a POSITA to combine the message format from the SMS Realization with the MM structure of the MMS Specification to effect message delivery with a multimedia message format having the claimed fields." *Id.* The assertion is persuasive. One with ordinary skill in the art would have known to incorporate at least the same fields for a multimedia message as the conventional fields used within a message according to short messaging service as described in SMS. Alternatively, relying on the testimony of Mr. Lanning, Petitioner asserts that one with ordinary skill in the art would have understood that the "subject" and "to whom" fields are present in a multimedia message. *Id.* (citing Ex. 1002 ¶ 87). In that regard, we credit the testimony of Mr. Lanning, which is not contradicted by the testimony of Patent Owner's expert, Dr. Konchitsky.

Second, in MMS-1 v0.1.0, a mobile station is configured to receive a "notification" from the cellular telecommunications network. Ex. 1003, 7. Specifically, MMS-1 v0.1.0 states: "The MMS shall provide MM downloading either initiated by the MM-terminator, e.g., **as a resulting action of a notification** . . . ." *Id.* (emphasis added). Mr. Lanning explains that because downloading of the MM occurs "as a resulting action of notification," one can infer that the notification is received before the MM. Ex. 1002 ¶ 90. We credit the testimony of Mr. Lanning and are persuaded that in the system and method according to MMS-1 v0.1.0, notification is received prior to receiving the multimedia message. Additionally, Petitioner cites the Nokia Proposal as disclosing that a notification message is received by a mobile station before that mobile station receives the content of a multimedia message. Pet. 34. That assertion is supported by the testimony of Mr. Lanning. *Id.* ¶¶ 90, 91. But there is no need for Petitioner to rely on that disclosure from the Nokia Proposal.

MMS-1 v0.1.0 also describes that the notification message includes the "type" of the multimedia message. Ex. 1003, 8. We regard "type" as an indicator of message class and thus the notification message of MMS-1 v0.1.0 includes a message class field. Specifically, MMS-1 v0.1.0 states: "Notifications shall be used for at least the following purposes: -- inform the MM-terminator about incoming messages, including a description of the message, e.g., content, size, **type**. Based upon this information the recipient (user or application) can instruct the MM-SC how to handle this MM."

Id. at 8 (emphasis added).[14] We find that MMS-1 v0.1.0 describes a notification message that includes a message class field indicating the message class of the multimedia message.

Third, MMS-1 v0.1.0 describes that based on information in the notification message, the user or application can instruct the MM-SC on how to handle that multimedia message. *Id.* Given that "type" is information included in the notification message, it would have been obvious to one with ordinary skill in the art to use "type" in the notification message as a filtering parameter. As noted above, a "type" of message indicates a message class of the multimedia message.

Petitioner additionally cites to the Sony Proposal for its disclosure of using the topic of a multimedia message as a filtering parameter. Pet. 37. Petitioner has not made clear how the teaching of the Sony Proposal about using topic as a filtering parameter would be combined with the notification message in MMS-1 v0.1.0. It also is uncertain how "topic" of message constitutes a message class. It would appear that every message has a topic, in which case each message would define its own class. That, however, would defeat the purpose of classifying a message. In that regard, Petitioner has not provided sufficient explanation. However, reliance on the Sony

[14] Petitioner also cites to disclosure in MMS-1 v1.0.0 of MMS supporting message "types" and message content formats. Pet. 35. Such reliance on MMS-1 v1.0.0 is unnecessary, given that MMS-1 v0.1.0 already discloses a notification message that includes a description of the message "type." However, Petitioner's citation to MMS-1 v1.0.0 further supports its reading of the disclosure of MMS-1 v0.1.0. Both documents are focused on providing a standard for MMS design and implementation.

Proposal is unnecessary, because MMS Specs. already suggest using "type" of message as a filtering parameter.

Patent Owner argues that the "type" of a message as disclosed in MMS-1 v0.1.0 does not constitute a filtering parameter. PO Resp. 61–63. The argument is the same as that discussed and rejected above in the context of claims 1 and 14, where Patent Owner also argues that the "type" of message is not a filtering parameter. For the same reasons discussed above, the argument is rejected here as well.

Patent Owner also argues that while the "type" information within the notification message "may contain an indication of the types of media elements within the multimedia messages, there is no suggestion that they contain a parameter for classifying messages based on ***message class***." PO Resp. 63. The argument is misplaced because the "type" indication as disclosed in MMS-1 v0.1.0 pertains to the entire message rather than only to individual component parts thereof. In that regard, MMS-1 v0.1.0 states: "Notifications shall be used for at least the following purposes: -- inform the MM-terminator about incoming messages, **including a description of the message**, e.g., content, size, **type**." Ex. 1003, 8.

Claim 29 depends from claim 28 and further recites: "wherein the message class is selected from a group consisting of personal, commercial and other information." Petitioner notes correctly that the added limitation would be satisfied so long as the message class is one of the three mentioned in the list, i.e., personal, commercial, or other. Pet. 40. Because of the catch-all selection "other" in the list, whatever is used as "type" information in MMS-1 v0.1.0 necessarily would satisfy one of the three selections listed

in claim 29.[15] Alternatively, Petitioner also notes that MMS-1 v0.2.0 discloses junk mail as a type of multimedia message. Pet. 40 (citing Ex. 1004, 8). We agree with Petitioner that it would have been obvious to one with ordinary skill in the art to indicate in "type" of message that the corresponding message is junk mail, and we agree with Petitioner that junk mail is commercial information. With regard to combining teachings from MMS-1 v0.1.0 and MMS-1 v0.2.0, Petitioner presents reasoning with rational underpinning on pages 12–15 of the Petition. Both documents are focused on providing a standard for MMS design and implementation. If junk mail is a type of multimedia message as recognized in MMS-1 v0.2.0, then one with ordinary skill in the art similarly would have recognized junk mail as a type of multimedia message in the context of MMS-1 v0.1.0.

Petitioner further relies on the Sony Proposal as disclosing message classes in the form of the topics of the messages. Pet. 40. We have determined above that Petitioner has not made clear how the teaching of the Sony Proposal about using topic as a filtering parameter would be combined with the notification message in MMS-1 v0.1.0, and that it is uncertain how "topic" of message constitutes a message class. There is, however, no need for Petitioner to rely on the Sony Proposal with regard to the limitation added by claim 29, because it is already accounted for by the disclosures of MMS-1 v0.1.0 and MMS-1 v0.2.0.

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[15] Petitioner cites to MMS-1 v1.0.0 for its disclosure of using standard media types and message content formats. Pet. 40. Such reliance is unnecessary, because whatever is the type used for categorizing information, it satisfies the "other" alternative recited in claim 29.

Patent Owner does not present any argument for claim 29 separate from those it has presented for claim 28 and which we have discussed and rejected above.

Claim 30 depends from claim 29, and claim 31 depends from claim 28. On pages 40–41 of the Petition, Petitioner explains how the limitation added by claim 30 relative to claim 29 and the limitation added claim 31 relative to claim 28 are met by the disclosure of MMS-1 v0.1.0 as would have been understood by one with ordinary skill in the art. We agree with and are persuaded by Petitioner's analysis of the limitations added by claims 30 and 31 relative to their respective base claims 28 and 29. For claims 30 and 31, Patent Owner presents no argument not already addressed and rejected above in the context of claims 11, 14, and 28.

For the foregoing reasons, we determine that Petitioner has shown by a preponderance of the evidence that each of claims 28–31 would have been obvious over MMS-Specs., the Nokia Proposal, the Sony Proposal, and SMS.

III. CONCLUSION

Petitioner has shown, by a preponderance of the evidence, that claims 11–14 and 17 are unpatentable under 35 U.S.C. § 103 as obvious over MMS Specs. and the Nokia Proposal.

Petitioner has shown, by a preponderance of the evidence, that claims 28–31 are unpatentable under 35 U.S.C. § 103 as obvious over MMS Specs., the Nokia Proposal, the Sony Proposal, and SMS.

IV. ORDER

It is

ORDERED that claims 11–14, 17, and 28–31 of the ’049 patent are unpatentable; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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