

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESEARCH IN MOTION CORP and RESEARCH IN MOTION LIMITED

Petitioner,

v.

MOBILEMEDIA IDEAS LLC

Patent Owner

Case IPR2013-00016 (JYC)

Patent U.S. 6,441,828

**PATENT OWNER'S MOTION
TO AMEND THE PATENT**

Pursuant to 35 U.S.C. § 316(d)(1)(b) and 37 C.F.R. § 42.121, Patent Owner MobileMedia Ideas LLC (“MobileMedia”) moves to amend the patent. MobileMedia’s Motion to Amend is supported by the accompanying Declaration of Dr. Vijay K. Madiseti, dated May 20, 2013 (“Madiseti Decl.”) (Ex. 2001). An Appendix is included listing the Exhibits accompanying this Motion, which are cited herein and in the Madiseti Declaration. Since MobileMedia is proposing to cancel all of the claims that are at issue in this *inter partes* review and is replacing them with a reasonable number of substitute claims, it is not necessary for MobileMedia to submit a Patent Owner’s Response and therefore MobileMedia will not be submitting a Patent Owner’s Response.

If any fees are due in connection with this matter, the Commissioner is hereby authorized to charge them to Attorney Deposit Account 50-3081.

I. INTRODUCTION

U.S. Patent No. 6,441,828 (“the ‘828 patent”) is directed to an image displaying apparatus that automatically displays digital images stored in memory in a normal, correct direction (*i.e.*, landscape or portrait), based on direction-displaying information for the image stored in memory and the orientation of the device. (*See, e.g.*, Ex. 2001 at ¶¶ 13-26 (citing, *e.g.*, Ex. 1001, Abstract, 1:5-8, 1:64-2:2, 3:38-41, 5:48-59, 6:27-35, 8:62-9:4, 9:27-

67; Fig. 16.)) The specification of the '828 patent also describes including the following features into the apparatus:

- a position sensor having a moving element that is movable in all directions to automatically detect which position the image display apparatus is placed;
- a recognition sensor that provides a detection signal to a microcomputer based on which a displaying status of the image displaying means is changed for at least an expiration time unless the microcomputer receives the detection signal again;
- a recognition sensor that (a) emits light and (b) detects the light returned from a human body or object and can detect light from a part of a human body at a distance of less than 20 cm;
- a slide show mode of display that does not require a key to be pressed to display each image and is different than a playback mode of display that requires a key to be pressed to display each image, with which the automatic display works.

(See, e.g., Ex. 2001 ¶¶ 37-39.) These features were not recited in the claims upon which the Board instituted this *inter partes* review. (*Id.*) In this Motion to Amend, MobileMedia proposes canceling claims 6, 7, 15, 17, and

18, and presents new claims 19, 20, 21, 22, and 23 as proposed substitutes for original claims 6, 7, 15, 17, and 18.

Proposed new claims 19-23 recite the features noted above, which are described and supported in the '828 patent specification and the Japanese applications to which the application that matured into the '828 patent claims priority, Japanese Patent Application 10-254231 (Ex. 2005), filed September 8, 1998 (a certified translation of which is Ex. 2007) and Japanese Patent Application 11-016215 (Ex. 2006), filed January 25, 1999 (a certified translation of which is Ex. 2008), which support a priority date of at least as early as January 25, 1999, for the proposed new claims.

As explained below and in greater detail in the Madisetti Declaration (Ex. 2001), the proposed substitute claims respond to and obviate the grounds of unpatentability involved in this trial by adding additional limitations to the claims that are at issue in this *inter partes* review. The additional limitations do not enlarge the scope of the claims, or introduce new matter. Proposed new claims 19-23 incorporate features that are not described in the prior art Petitioner relies upon in deeming this review, (Exs. 1002-1006.) (“Petition Prior Art”). (Ex. 2001 at ¶¶ 68-123, 124-32.)

The original claims at issue in this review contained limitations that were written in means-plus-function format. As explained below, certain of the proposed new claims incorporate sufficient structure for achieving the specified function so that certain of these elements no longer invoke 35 U.S.C. § 112 ¶ 6. In other claims, the additional features were added with non-means-plus function language. As explained in greater detail in the Madisetti Declaration and below, the proposed new claims are novel and result in an apparatus with combinations of features that would not have been obvious to a person of ordinary skill in the art at the time of the invention. MobileMedia respectfully requests that proposed new claims 19-23 be allowed.

II. CLAIM LISTING

The following is a listing of all claims at issue in this *inter partes* review, including new claims proposed in this Motion to Amend as substitute claims for canceled claims, marked up to show changes from the corresponding original '828 patent claims for which they are proposed as substitutes. Deleted language is in “strikethrough” font and added language is underlined.

Claims 6, 7, 15, 17, 18. (Canceled)

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.