

**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**

**SECOND DECLARATION OF DR. VIJAY K. MADISETTI**

**I. INTRODUCTION AND SCOPE OF ASSIGNMENT**

1. My name is Dr. Vijay Madiseti. I am a tenured Professor in Electrical and Computer Engineering at Georgia Tech, where I have been teaching since 1989, and a Fellow of the IEEE. A copy of my CV (Ex. 2002), which sets forth my qualifications in greater detail is attached to the Declaration of Dr. Vijay K. Madiseti (Ex. 2001) as Appendix A.

2. My background, retention by the Patent Owner of U.S. Patent No. 6,441,828 (“the ‘828 patent”), MobileMedia Ideas LLC (“MobileMedia”) in connection with the Petition For *Inter Partes* Review of U.S. Patent No. 6,441,828 Under 35 U.S.C. § 312 And 37 C.F.R. § 42.104, dated October 12, 2012 (“Petition”) are briefly described at paragraphs 1-12 of Ex. 2001.

3. I submit this Second Declaration in connection with MobileMedia's Motion to Amend the Patent, in which it cancelled original claims 6, 7, 15, 17, and 18, and proposed new substitute claims 19 through 23.

4. I have reviewed the Petitioner's Opposition to Patent Owner's Motion To Amend, dated July 18, 2013 ("Opposition"), as well as the additional exhibits submitted concurrently with the Opposition that were not submitted with the Petition: Ex. 1008)( U.S. Patent No. 5,764,291 ("Fullam"), issued June 9, 1998 and filed September 30, 1994); Ex. 1009 (U.S. Patent No. 5,956,564 ("Williams"), issued October 18, 2005 and filed October 8, 1998); Ex. 1010 (U.S. Patent No. 6,091,450 ("Hirasawa"), issued July 18, 2000 and filed June 10, 1997); Ex. 1011 (U.S. Patent No. 6,738,075 ("Torres") issued May 18, 2004 and filed December 31, 1998); Ex. 1012 (U.S. Patent No. 5,812,736 ("Flashpoint") issued September 22, 1998 and filed September 30, 1996) (collectively, "the Opposition Prior Art" ) .

5. As I explained in paragraphs 53-67 of Ex. 2001, it is my technical opinion that proposed new claims 19-23 are supported by the written description of the specification of the '828 patent and the written description of the Japanese applications to which the application that matured into the '828 patent claims priority.

6. As I explained in paragraphs 68-132 of Ex. 2001, it was my technical opinion that proposed new claims 19-23 are not anticipated by or rendered obvious

to a person of ordinary skill in the art at the time of the invention of the '828 patent in light of the five prior art references (Exs. 1002-1006) cited in the Petition (“Petition Prior Art”).

7. In the Opposition, Petitioner argues that the proposed substitute claims are unpatentable. Specifically, Petitioner argues that claim 19 is indefinite under 35 U.S.C. § 112 ¶ 2 and that the structural limitations added to claim 19 are insufficient to overcome the presumption that under 35 U.S.C. § 112 ¶ 6 applies to the “means for determining a direction in which an image of the image signal is to be displayed read from the recording medium” and that if it is determined that no longer invokes Section 112 ¶ 6, then it improperly enlarges the scope of the original claims of the '828 patent.

8. Petitioner argues that the '828 patent does not describe an algorithm for performing the claimed “determining function.”

9. Petitioner argues that claim 19 has no written description support in the '828 patent or the foreign priority applications for an apparatus that combines the image processing block of what Petitioner describes as the “second embodiment” with the microcomputer of what Petitioner describes as the “first embodiment” and that claim 19 is purportedly unpatentable under 35 U.S.C. § 112 ¶ 1.

10. Petitioner argues that claim 21 is indefinite under 35 U.S.C. § 112 ¶ 2 because a person of ordinary skill in the art purportedly would not understand the scope of the claim 21 phrase “unless the microcomputer receives said detection signal again” in light of the specification.
11. Petitioner also argues that claim 21 is unpatentable under 35 U.S.C. § 112 ¶ 1 because it purportedly lacks written description support in the specification.
12. Petitioner argues that claim 23 is unpatentable under 35 U.S.C. § 112 ¶ 1 because it purportedly lacks written description support the specification.
13. Petitioner argues that claim 19 is unpatentable because it purportedly enlarges the scope of the original claims.
14. Petitioner also argues that claims 19-23 are unpatentable as obvious under 35 U.S.C. § 103.
15. Specifically, Petitioner argues that claims 19-22 are obvious over the combination of Anderson (Ex. 1002) in view of Fullam (Ex. 1008), Williams (Ex. 1009), and Hirasawa (Ex. 1010).
16. Petitioner also argues that claims 19-22 are obvious over Nagasaki (Ex. 1004) in view of Kagle (Ex. 1005), Fullam (Ex. 1008), and Williams (Ex. 1009)
17. Petitioner argues that claim 23 is obvious over the combination of Anderson, Fullam (Ex. 1008), Williams (Ex. 1009), and Flashpoint (Ex. 1012).

18. I disagree with Petitioner on all of these issues and I submit this Reply Declaration to respond to the arguments made in the Opposition.

## II. SUMMARY OF OPINIONS

19. As I explain below, it continues to be my technical opinion that the substitute claims 19-23 are definite, supported by the specification of the '828 patent and the September 8, 1999 and January 25, 1999 Japanese priority applications, and are entitled to a priority date at least as early as January 25, 1999. The proposed substitute claims respond to, and obviate, the asserted grounds of unpatentability involved in this trial presented in the Petition regarding the original claims. This was achieved by adding new, additional limitations that obviate arguments that the original claims were invalid over the Petition Prior Art. Moreover, it continues to be my opinion that the proposed substitute claims would not have been obvious to a person of ordinary skill in the art in light of the Petition Prior Art. They do not enlarge the scope of the original claims they are replacing, or introduce new matter.

20. It is also my opinion that the substitute claims 19-23 are patentable over the Opposition Prior Art.

21. As explained below, the proposed new claims 19-23 incorporate features that are not described in the Petition Prior Art and Opposition Prior Art. It is my technical opinion that proposed substitute claims 19-23 are not anticipated by the

# 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.