

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COSTAR REALTY INFORMATION, INC.,
Petitioner,

v.

CLANTECH, INC.,
Patent Owner.

IPR2022-00799
Patent 9,886,421 B1

Before JO-ANNE M. KOKOSKI, CHRISTOPHER M. KAISER, and
JON M. JURGOVAN, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

CoStar Realty Information, Inc. and Duolingo, Inc. (collectively, “Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–17 (the “challenged claims”) of U.S. Patent No. 9,886,421 B2 (“the ’421 patent,” Ex. 1001). Paper 3 (“Pet.”). Clantech, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). With Board authorization (Paper 9), Petitioner filed a Preliminary Reply (“Pet. Reply,” Paper 10), and Patent Owner filed a Preliminary Sur-reply (“Sur-reply,” Paper 11).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314 (2018); *see also* 37 C.F.R. § 42.4 (2021). Upon consideration of the Petition, Preliminary Response, Reply, and Sur-reply, we determine that Petitioner has established a reasonable likelihood of prevailing with respect to the unpatentability of at least one claim of the ’421 patent, and we do not deny the Petition under 35 U.S.C. § 315(a)(1). Accordingly, for the reasons that follow, we institute an *inter partes* review of claims 1–17 of the ’421 patent.

A. *Real Parties in Interest*

Petitioner identifies CoStar Realty Information, Inc. and Duolingo, Inc. as the real parties in interest. Pet. 80. Patent Owner identifies Clantech, Inc. and Modern Font Applications LLC as the real parties in interest. Paper 12, 2.

B. *Related Matters*

The parties identify *Duolingo, Inc. v. Modern Font Applications, LLC*, No. 3:21-cv-06132 (N.D. Cal.) and *CoStar Realty Information, Inc. v.*

Modern Font Applications, LLC, No. 3:21-cv-07521 (N.D. Cal.) as related matters. Pet. 80; Paper 12, 2. Patent Owner additionally identifies *Modern Font Applications LLC v. Alaska Airlines, Inc.*, No. 2:19-cv-00561 (D. Utah) and *Modern Font Applications LLC v. Alaska Airlines*, No. 21-1838 (Fed. Cir.) as related current proceedings involving the '421 patent. Paper 12, 2.

C. The '421 Patent

The '421 patent “relates to methods, systems and computer program products for allowing characters of fonts that are not standard to an operating system of a computer to be displayed and/or otherwise used by the operating system of the computer.” Ex. 1001, 1:26–30. The '421 patent teaches that “electronic documents requested by a reader are displayed on the reader’s computer using only the fonts that are currently loaded onto the reader’s computer.” *Id.* at 1:58–60. If the reader’s computer does not contain the fonts the author used when creating the electronic document, the operating system of the readers computer will replace the unknown fonts with known fonts, and the document is displayed on the reader’s computer in a different form than that created by the author. *Id.* at 1:60–64.

The '421 patent addresses this problem by providing methods and structures “for allowing an operating system to have access to characters of non-standard fonts included in a network document.” Ex. 1001, 2:63–66. The '421 patent teaches that “the term ‘network document’ is intended to mean any form of an electronic file that can have a display character embedded therein, attached thereto, referenced therein, such as through a link, or can otherwise be associated therewith.” *Id.* at 7:37–41. The '421 patent describes “non-standard fonts” as “fonts that are not loaded on the requesting computer and thus the corresponding characters cannot be displayed or otherwise used by the operating system thereof.” *Id.* at 3:5–9.

In one embodiment, the '421 patent describes a network environment that includes a developer computer (on which the network document is created) and a browsing computer (which is used to access and read the network document). Ex. 1001, 7:9–12, 7:35–36. The developer computer is loaded with a developer application program that includes a document builder that can generate a network document. *Id.* at 8:45–51. The developer application program also includes a character packager that generates a font package that is incorporated into, or linked to, the network document. *Id.* at 8:52–55. The font package includes the formatting information necessary for the browsing computer to generate one or more, generally non-standard display characters when the browsing computer downloads and displays the network document. *Id.* at 8:55–60. The font package can be embedded within the network document, or can be stored in a different directory or server than the network document. *Id.* at 11:17–21.

In addition to the font package, the character packager also creates an instruction code that is also either referenced by or embedded in the network document. Ex. 1001, 11:31–34. The instruction code comprises computer executable instructions to facilitate downloading an installation module onto the browsing computer. *Id.* at 11:34–36. The installation module “comprises computer-executable instructions for automatically installing” the font package on the browsing computer when the browsing computer requests the network document. *Id.* at 11:36–41.

The '421 patent teaches that, in response to a request, the network document is downloaded onto the browsing computer, along with the instruction code and the font package. Ex. 1001, 12:20–27. The browsing computer then begins processing the computer executable instructions within the network document and requests the installation module, which is

subsequently downloaded to and installed on the browsing computer. *Id.* at 12:28–37. Once installed, the installation module communicates with the browser computer’s operating system, “thereby accessing all the wealth of resource offered by the operating system,” and the formatting information within the font package “is either permanently installed or temporarily exposed to” the operating system. *Id.* at 13:20–28. The operating system then uses the font files to display the network document in the same form as which it was created, and the characters within the font files “can be used in the same way as any of the font characters originally loaded on” the browsing computer. *Id.* at 14:20–27.

D. Challenged Claims

Petitioner challenges claims 1–17 of the ’421 patent, of which claims 1, 6, and 11 are independent. Independent claim 1 is illustrative of the claimed subject matter, and is reproduced below.

1. A non-transitory computer-readable medium adapted for use with a computer coupled to a network such that select information on the non-transitory computer-readable medium is accessible by a hand-held device having an operating system coupled to the network, the non-transitory computer-readable medium including:

an electronic file package including a plurality of display characters and computer executable instructions for identifying the plurality of display characters for display and for identifying one or more external fonts used to render at least one of the plurality of display characters;

a font package comprising one or more external font files that include formatting information necessary for the hand-held device to render the at least one of the plurality of display characters using the one or more identified external fonts, the font package separate from the computer executable instructions for identifying the plurality of display characters for display; and

an exposure module for installation of the one or more external font files in a temporary font directory on the hand-held device, the one or more external font files being received from the computer responsive to the computer receiving a request for the font package from the hand-held device so that the hand-held device can render the at least one of the plurality of display characters using the one or more external font files, whereby when the plurality of display characters are displayed by a program module of the operating system using the one or more external font files, wherein in response to the one or more external font files being installed, a system font table of the hand-held device is updated to reflect an availability of the external font files.

Ex. 1001, 15:65–16:32.

E. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–17 would have been unpatentable based on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–9	103 ¹	Collins, ² Gautier, ³ Schaefer ⁴
1–5, 11–17	103	Collins, Gautier, Schaefer, Parthasarathy ⁵
10	103	Collins, Gautier, Schaefer, Miller ⁶

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the ’421 patent claims priority to an application filed on July 15, 2001 (Ex. 1001, code (63)), we refer to the pre-AIA version of Section 103.

² Collins, US 5,781,714, issued July 14, 1998 (Ex. 1005).

³ Gautier, US 7,127,493 B1, issued Oct. 24, 2006 (Ex. 1008),

⁴ Schaeffer, US 7,028,305 B2, issued Apr. 11, 2006 (Ex. 1009).

⁵ Parthasarathy, US 6,347,398 B1, issued Feb. 12, 2002 (Ex. 1006).

⁶ Miller, US 7,537,167 B1, issued May 26, 2009 (Ex. 1010).

Pet. 2. Petitioner relies on the Declaration of Erez Zadok (“the Zadok Declaration,” Ex. 1003) in support of its contentions.

II. ANALYSIS

A. 35 U.S.C. § 315(a)

Patent Owner contends that the Petition is barred under 35 U.S.C. § 315(a)(1). Prelim. Resp. 36–52. Patent Owner asserts that Petitioner CoStar filed a civil action regarding the ’421 patent on September 27, 2021, and Petitioner Duolingo filed a civil action on August 20, 2021. *Id.* at 37 (citing Exs. 2001–2006). Patent Owner asserts that “[n]either Petitioner initially asserted claims for declaratory judgment of invalidity in their original complaints.” *Id.* After Patent Owner’s exclusive licensee did not assert a counterclaim for patent infringement, Patent Owner asserts that “Petitioners each filed unauthorized amended complaints that asserted claims for declaratory judgment of invalidity of at least one claim of the patent.” *Id.* at 38 (citing Ex. 2007 ¶¶ 20, 68–76; Ex. 2008 ¶¶ 16, 64–73). As a result, Patent Owner alleges, “[e]ach of Petitioners filed a civil action prior to their present petition for inter partes review,” which was accorded a filing date of April 4, 2022 (Paper 4, 1), “and in those civil actions each petitioner filed claims to challenge the validity of the same patent they endeavor to challenge in their present petition for inter partes review.” Prelim. Resp. 39.

Section 315(a) provides:

(a) Infringer’s Civil Action.—

(1) Inter Partes Review Barred by Civil Action.— An inter partes review may not be instituted if, before the date on which the petition for such review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.

(2) Stay of Civil Action.—

If the petitioner or real party in interest files a civil action challenging the validity of a claim of the patent on or after the date on which the petitioner files a petition for inter partes review of the patent, that civil action shall be automatically stayed until either—

- (A) the patent owner moves the court to lift the stay;
- (B) the patent owner files a civil action or counterclaim alleging that the petitioner or real party in interest has infringed the patent; or
- (C) the petitioner or real party in interest moves the court to dismiss the civil action.

(3) Treatment of Counterclaim— A counterclaim challenging the validity of a claim of a patent does not constitute a civil action challenging the validity of a claim of a patent for purposes of this subsection.

According to Patent Owner, “though petitioners’ initial complaints omitted the later-added ‘claim’ for invalidity, the date of adding that ‘claim’ does not change the date on which the ‘civil action’ was filed.” Prelim.

Resp. 41. Patent Owner argues that the

distinction between the term ‘civil action’ and the term ‘claim’ (referring to relief sought in a civil action) . . . in view of the Legislative History of § 315, demonstrates that Congress intended that § 315 preclude the filing *or maintaining* of an inter partes review at any time after a petitioner added claims of invalidity to a civil action filed before the petition for inter partes review.

Id. at 39–40. In particular, Patent Owner argues that the statute does not define “civil action,” and, relying on the Federal Rules of Civil Procedure, argues that the commonly understood meaning should be applied. *Id.* at 38–46. Patent Owner then argues that, “[a]s commonly understood, the filing date of a ‘civil action’ does not change irrespective of a later addition of a new claim, whether or not the new claim relates back to the filing date.” *Id.*

at 43. Therefore, “each Petitioner’s ‘claim’ for declaratory judgment of invalidity relates back to the 2021 date on which each respective Petitioner commenced its ‘civil action’ by filing a complaint.” *Id.*

Statutory interpretation “begins with the ‘language of the statute.’” *Hughes Aircraft Co. v. Jacobson*, 525 U.S. 432, 438 (1999); *see also SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018) (“Where a statute’s language carries a plain meaning, the duty of an administrative agency is to follow its commands as written.”). Here, the plain meaning of the language in Section 315(a)(1) is clear. The plain meaning directs us to first determine if a petitioner “filed a civil action challenging the validity of a claim” of the challenged patent “before the date on which the petition was filed.” If the petitioner did file such a civil action, Section 315(a)(1) commands that “the inter partes review may not be instituted.” Applying the plain meaning to the facts here, as of the April 4, 2022 filing date of the Petition, Petitioner had not “filed a civil action challenging the validity” of the ’421 patent. Thus, we determine that the Petition is not barred by § 315(a)(1).

Accordingly, we determine that the Petition is not barred by Section 315(a).

B. Level of Ordinary Skill in the Art

Petitioner contends that a person having ordinary skill in the art (“POSITA”) would have had “a Bachelor of Science degree from an accredited institution in computer science, computer engineering, or an equivalent, and 2–3 years of experience in Web design, data communications, and general Information Technology system administration.” Pet. 5 (citing Ex. 1003 ¶ 77). Petitioner also contends that “[a]dditional education could substitute for experience and significant work experience could substitute for formal education.” *Id.* At this stage of the

proceeding, Patent Owner neither addresses Petitioner's proposed definition, nor proposes a different level of skill in the art.

On this record, we determine that the level of ordinary skill is reflected in the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (specific findings on the ordinary skill level are not required “where the prior art itself reflects an appropriate level and a need for testimony is not shown” (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985))). A more specific definition is not necessary for purposes of deciding whether to institute review.

C. Claim Construction

We construe each claim “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (2019). Under this standard, claim terms are generally given their plain and ordinary meaning as would have been understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). Only those terms in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Realtime Data LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019).

Petitioner states that it “do[es] not believe that any claims require construction to resolve the patentability disputes here,” and, as a result, Petitioner “appl[ies] the plain and ordinary meaning for each claim term.” Pet. 5. Patent Owner proposes a construction for the term “formatting information necessary for . . .”/“formatting information for . . .” that appears in each of the independent claims of the '421 patent. Prelim. Resp. 11–14.

We determine that no claim term requires express construction for purposes of this Decision.

D. Asserted Obviousness over Collins, Gautier, and Schaeffer

Petitioner contends that claims 1–9 would have been obvious over the combined teachings of Collins, Gautier, and Schaeffer. Pet. 5–57.

1. Overview of Collins

Collins is directed to “the computer technology of representing and generating the shapes of alphanumeric characters and other images used with text.” Ex. 1005, 1:12–15. Collins teaches that “not all computers have the same font descriptions or the ability to interpret the same font languages,” which “creates a problem if an electronic document created on a first computer using one or more given fonts is then transferred to a second computer which does not have those fonts and cannot interpret them.” *Id.* at 3:4–9. Collins explains that “[o]ne solution to the problem of making fonted text portable is to send a copy of all fonts and font interpreters needed to properly render the characters of a document along with it,” but this approach “has many problems.” *Id.* at 3:21–24. Collins criticizes this approach by explaining that “finding out what fonts and interpreters need to be sent with each such document would be labor intensive,” and “may present legal problems” because “both the code and sequence of outline segments contained in font descriptions have been considered by many to be copyrightable, and thus cannot be installed in a new machine without legal permission.” *Id.* at 3:24–33. This results in the document shown or printed on the second computer having different fonts than intended, which “can cause the document to have a very different, and often undesired appearance, and can disrupt its spacing and pagination.” *Id.* at 3:9–13. Collins, therefore, seeks to provide an apparatus and method for creating and playing

back portable documents, “in which text with a variety of different fonts can be accurately played back by a machine which does not previously have the font descriptions and font interpreters for all of that document’s fonts.” *Id.* at 5:23–28.

Figure 1 of Collins is reproduced below.

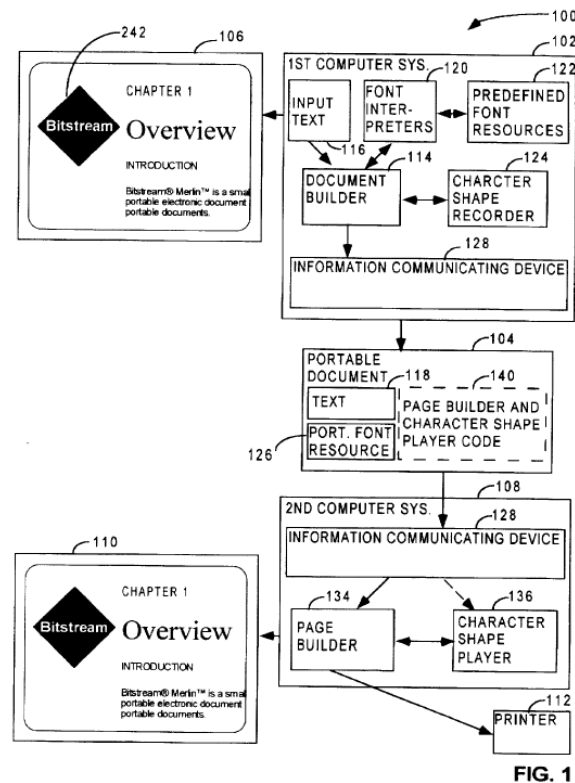


Figure 1 is a high level block diagram of one embodiment described in Collins, “in which a first computer converts an input text written using a plurality of pre-defined font descriptions into a portable document have new font descriptions,” and “a second computer receives the portable document and renders an image using the new font descriptions it contains.” Ex. 1005, 6:19–25. System 100 includes first computer 102 that creates portable document 104, and second computer system 108 in which the portable document can be played back. *Id.* at 8:56–62. First computer 102 includes document builder 114, which has means for receiving fonted input text 116.

Id. at 9:4–6. Document builder 114 places codes corresponding to each of the input text’s successive font names, text characters, and position codes into text 118 of portable document 104. *Id.* at 9:16–19. “[F]or each unique combination of character and font name in the input text,” document builder 114 also “creates a new font description for the shape described in its corresponding pre-defined font description.” *Id.* at 9:19–22.

Second computer 108 includes page builder 134 and character shape player (“CSP”) 136. Ex. 1005, 9:55–56. Page builder 134 creates a rendered image from the portable document by first reading the successive font, character, and position codes from text 118 of portable document 104. *Id.* at 9:56–60. Page builder 134 then uses the font codes to determine the font associated with each character and the position codes to position the characters, and asks CSP 136 to generate a shape for the character given its associated font code. *Id.* at 9:60–65. CSP 136 “generates this shape from the new font description indexed under that character and font in the Portable Font Resource 126,” and “delivers this shape to the page builder which places it at the proper location in the rendered image.” *Id.* at 9:65–10:2.

Collins explains that this system “allows a fonted document created with font interpreters and pre-defined font resources of the first computer . . . to be communicated to, and visually rendered with virtually the exact same appearance by a second computer which does not have those font interpreters and resources” “without copying the copyrightable shape-independent aspects of the first computer’s pre-defined font descriptions.” Ex. 1005, 10:5–14. According to Collins, “[w]ith these features, it can be seen that the invention enable virtually any document created with virtually any font to be accurately reproduced on another computer which does not

contain the original font descriptions from which it was created.” *Id.* at 10:40–44.

2. *Overview of Gautier*

Gautier is directed to “delivering content in client-server networks,” and more particularly, to the “delivery of such content in response to optimization criteria.” Ex. 1008, 1:10–14. Gautier explains “a web site may be accessed by many different types of clients, from conventional full size computers with large screen displays (e.g., 13” to 17”) and full color capabilities (16 M colors) to small handheld computers with small screens (e.g., 4” to 6”) and limited color capabilities (256 colors), to cellular telephones with very small screens (1”–2”) and virtually no color capabilities (2–8 colors monochrome).” *Id.* at 1:32–39. The problem identified by Gautier is that “[a] web page with many images that is designed to be viewed on a full size, full color monitor will not appear at all properly on a cellular telephone display with only monochrome output.” *Id.* at 1:39–42.

The optimization constraints also are dependent on characteristics of the client device. Ex. 1008, 2:27–28. Observable characteristics of the client device requesting the content include “device type, browser type, operating system, processor, memory, user preferences, software installed on the client, and language type for the requested content.” *Id.* at 2:64–3:5.

Figure 1 of Gautier is reproduced below.

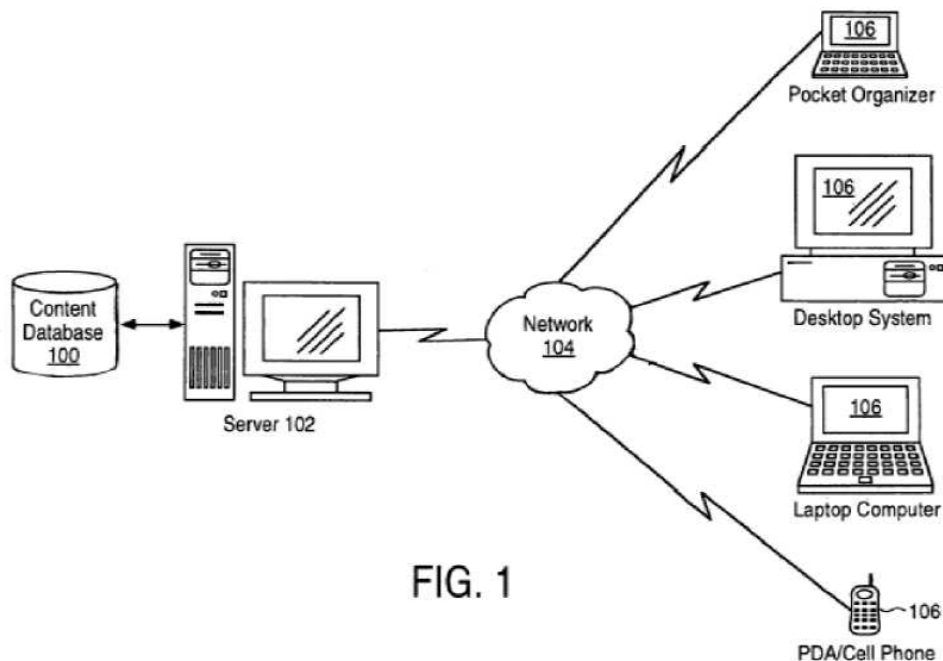


FIG. 1

Figure 1 illustrates a system with a content database and a server.

Ex. 1008, 4:39–41. Referring to Figure 1, Gautier’s web server 102 delivers content from the content database 100 to “client devices having varying bandwidth, display, and other performance characteristics.” *Id.* at 2:6–9. Gautier’s system communicates with various types of client devices including “desktop and laptop computers, pocket organizers, personal digital assistants, cellular telephones, and any other type of communication device adapted for Internet or Web based communications (i.e., HTTP).” *Id.* at 5:31–35.

Content from content database 100 that is stored “in a suitable format, such as a markup language, ASCII, and the like.” Ex. 1008, 4:47–52. A new tag (e.g., <OPT>) “demarcates a group of one or more content items that may be optionally included in the content to be delivered.” *Id.* at 2:22–24. The server “select[s] which of the optional items of content are to be delivered to the client device based on” a set of selection rules including an

optimization constraint. *Id.* at 3:6–8. For example, HTML on a T1 connection may have a lower constraint compared to a HTML on a wireless PDA. *Id.* at 6:39–55.

In operation, the server 102 receives “a request for a content item from the database 100.” Ex. 1008, 5:39–41, Fig. 2. The server determines an optimization constraint associated with the requesting client device and compiles the requested content item according to the optimization constraint. *Id.* at 5:43–47. The server transmits the compiled content item to the client. 5:47–49.

3. *Overview of Schaeffer*

Schaefer explains that “[i]n many environments, but particularly in environments where an application is delivered via a network, the most important feature is an ability to run applications on the fly, without a complex installation.” Ex. 1009, 1:9–12. Prior art approaches either modified the program to appear as if an application was installed or installed it, backing them out to restore the original configuration. *Id.* at 1:12–16. The prior art problems included the creation of “conflicts between an application and the computer’s current configuration.” *Id.* at 1:16–24.

Figure 1 of Schaefer is reproduced below.

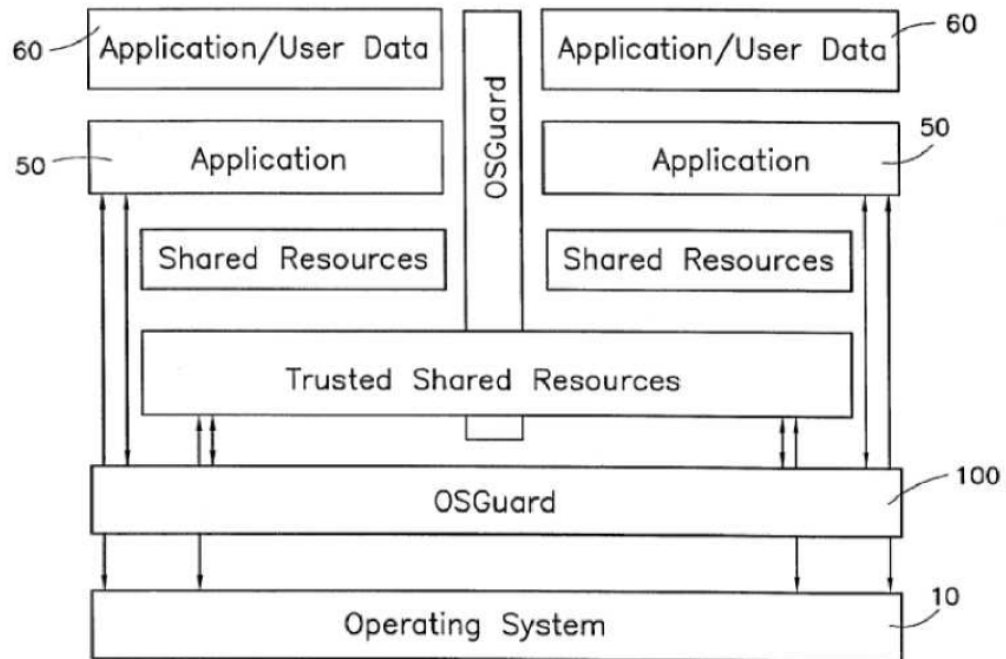


Fig. 1

Figure 1 is a block diagram schematic showing the relative relationship of an operating system and a software application.

Ex. 1009, 2:35–38. As shown in Figure 1, Schaefer provides an operating system abstraction and protection layer called the “Operating System Guard” interposed between a running software application and the operating system. *Id.* at 1:28–33.

Figure 4 of Schaefer is reproduced below.

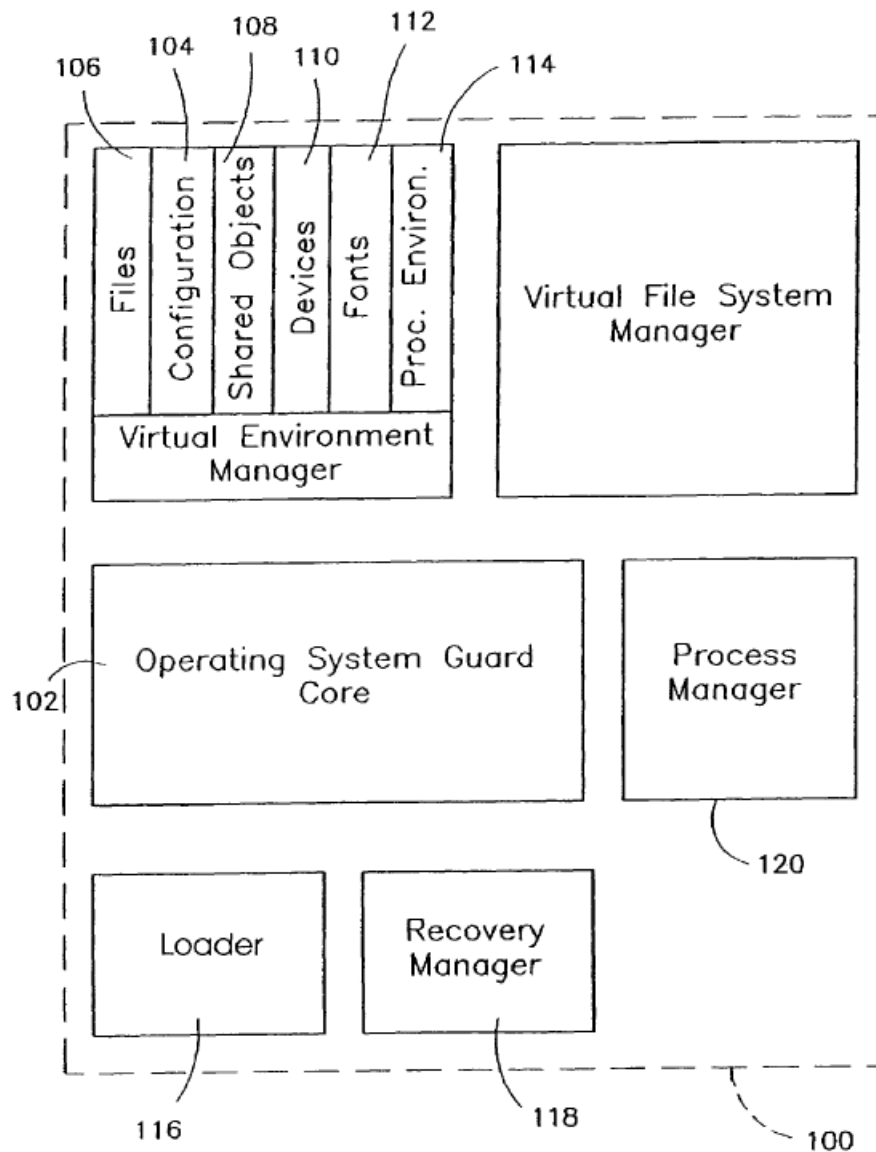


Fig. 4

Figure 4 is a block diagram schematic showing an operating system guard and subsystems.

Ex. 1009, 2:29–30. As shown in Figure 4, the Operating System Guard 110 includes a font manager 112 and a file manager 106. *Id.* at 4:15–21. Different operating systems may have different fonts. *Id.* at 8:63–67. “Some applications require fonts to be installed in order to perform

correctly.” *Id.* at 9:1–2. The Operating System Guard “will enable these fonts prior to running the application and if necessary remove them afterwards.” *Id.* at 9:3–5.

4. *Motivation to Combine*

Petitioner contends that “[a] POSITA would have been motivated to implement Collins’ extended browser as software on a hand-held device based on the teachings of Gautier.” Pet. 13 (citing Ex. 1003 ¶¶ 103–107). Petitioner asserts that “the popularity of hand-held computing devices, including PDAs and wireless devices, was increasing dramatically with several manufacturers releasing devices with enhanced processing capabilities and Internet connectivity,” and “[a] POSITA would have been motivated to implement Collins’ dynamic font browser on these hand-held devices to reach this expanding customer base and to provide Collins’ enhanced web pages to mobile devices without or minimal need for multiple content version based on client device capabilities.” *Id.* at 13–14 (citing Ex. 1003 ¶ 104). Petitioner also contends that “a POSITA would have been motivated to combine the teachings of Collins and Gautier to allow web content developers to provide dynamic font web pages having more consistent and predictable display quality of devices with varying capabilities.” *Id.* at 14 (citing Ex. 1003 ¶ 106). In that regard, Petitioner points to Collins’ teaching “that the lines and segments of its font descriptions are defined ‘with a high resolution,’ allowing generation of font images ‘of virtually any size desired.’” *Id.* (citing Ex. 1005, 2:29–31; Ex. 1003 ¶¶ 106–107).

Petitioner also contends that “[a] POSITA would have been further motivated to combine Schaefer’s teachings of an operating system abstraction and protection layer with the teachings of Collins and Gautier.”

Pet. 14 (citing Ex. 1003 ¶¶ 108–114). Petitioner asserts that, although “Collins discloses that the fonts can be installed ‘into the operating system’s font manager,” Collins “does not provide explicit details regarding integrating its extended browser with an operating system.” *Id.* (citing Ex. 1005, 37:64–38:1). Petitioner contends that “[a] POSITA would have therefore been motivated to find these techniques, such as disclosed by Schaefer[,], which integrates applications delivered ‘on-the fly’ much like Collins ‘on-demand’ browser extension.” *Id.* at 14–15 (citing Ex. 1009, 1:9–11; Ex. 1003 ¶ 108). And Petitioner contends that Collins motivates the combination because Collins notes that “its font installation process can be performed on different operating systems, such as ‘Windows and Macintosh computers,’” and “Schaefer similarly acknowledges font handling behavior is ‘different on alternate operating systems’ and describes font management for different operating systems (e.g., Windows and Macintosh).” *Id.* at 15 (citing Ex. 1003 ¶ 109). According to Petitioner, incorporating “Schaefer’s abstraction layer teachings with Collins’s browser extension” would have allowed “Collins font extension to be installed and used uniformly in different operating systems,” which would further “the goal of uniform presentation of web content (fonts included) on any web browser, regardless of operating system or form factor (e.g., desktop, laptop, or hand-held).” *Id.* (citing Ex. 1003 ¶ 110).

Patent Owner responds that “Collins teaches away from transferring a font usable by an operating system.” Prelim. Resp. 14. In particular, Patent Owner argues “Collins teaches that the original font should not be transferred between computers” because “both technical and legal problems weigh against transferring the original font that would be usable by the operating system, along with the intense labor needed to install fonts.” *Id.*

at 14–15 (citing Ex. 1005, 3:20–34). Patent Owner also argues that Collins “teaches that outside technical barriers such as networking speed weight against the transfer of the original fonts.” *Id.* at 15 (citing Ex. 1005, 4:35–45).

A reference does not teach away “if it merely expresses a general preference for an alternative invention but does not ‘criticize, discredit, or otherwise discourage’ investigation into the invention claimed.” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Claim 1 recites, *inter alia*, “identifying one or more external fonts used to render at least one of the plurality of display characters” that “include formatting information necessary for the hand-held device to render the at least one of the plurality of displayed characters for display,” wherein “the plurality of display characters are displayed by a program module of the operating system using the one or more external font files.”

We disagree, on this record, that Collins’ identification of problems associated with “sending a copy of all fonts and font interpreters needed to properly render the characters of a document along with it” teaches away from the invention described in claim 1. Collins as a whole teaches tagging fonts used to display the text, which enable document authors to specify fonts other than the basic HTML text type, creating new font descriptions for any new character-font combinations in the document in portable font resource (PFR) files that describes the shape and sequence of moves, lines, and curves that render the display character, and installing those PFR files. Ex. 1005, 24:10–14, 24:20–28, 27:11–14, 27:61–62, 29:41–43, 30:38–46, 34:10–17, 40:19–22. Accordingly, Collins teaches identifying external fonts and using external fonts as claim 1 recites. Independent claim 6 includes

similar limitations. *See, e.g.*, Pet. 44–48 (Petitioner relying on the same disclosures as claim 1 for similar limitations in claim 6).

Patent Owner further argues that Collins teaches “that one should not transfer the ‘exact same font’ but should translate fonts into a proprietary format unusable by the operating system before transferring them, and therefore” teaches away from the claims of the ’421 patent. Prelim.

Resp. 19. Patent Owner asserts that Collins “does not use the operating system to render and does not update a system font table to reflect a proprietary font format that the operating system cannot use.” *Id.* at 21.

Collins, however, describes a function (“InstallPfrs”) that

causes the current document’s PFR’s font description to be converted into a font language and format which can be used by the client computer’s operating system and then installs these converted fonts . . . into the operating system’s font manager . . . so they can be rendered more quickly by making calls to the operating system.

Ex. 1005, 37:64–38:3. Therefore, on this record, we disagree that Collins teaches away from the claims of the ’421 patent based on its teachings regarding the operating system’s rendering of the external fonts. Moreover, even assuming (without deciding) that Collins does not describe updating a system font table as Patent Owner contends, Petitioner also relies on Schaefer’s description of font manager behavior that includes inserting a font into a system font table to meet the system font table limitation of independent claims 1 and 6. *See* Pet. 37–38 (citing Ex. 1009, 9:11–17), 49.

Patent Owner also argues that “the ’421 patent explicitly rejects the use of Collins’ proprietary font format along with the CSR and CSP” and “confirms many problems with Collins’ approach.” Prelim. Resp. 23 (citing Ex. 1001, 2:21–53). We agree that the background section of the ’421

patent identifies a prior art solution using character shape recorders and players, and states that “this solution does not allow the fonts represented by the proprietary vector to be freely copied and pasted into or otherwise used, such as by printing, by other applications that do not access the services of the character shape player.” Ex. 1001, 2:44–48. We disagree, however, that stating that a prior art approach has problems that the claimed invention sought to solve amounts to an “explicit rejection” of that approach, such that prior art directed to that approach should be discounted from an obviousness analysis. Moreover, we discern nothing in the ’421 patent, and on this record neither party argues, that a proprietary font format is necessarily excluded from the scope of the independent claims.

Having reviewed Petitioner’s and Patent Owner’s arguments, and the evidence of record, we are persuaded that Petitioner sufficiently establishes, for the purposes of institution, that a POSITA would have been motivated to combine the teachings of Collins, Gautier, and Schaefer with a reasonable likelihood of success. *See* Pet. 13–16; Ex. 1003 ¶¶ 103–107.

This determination is preliminary in nature and based on the record at this stage of the proceeding. We invite the parties to develop these arguments further at trial, should they so desire, to the extent permitted under our rules. In particular, we invite the parties to address Patent Owner’s assertion that Collins teaches away from the claims of the ’421 patent.

5. Independent Claims 1 and 6

Petitioner relies on Collins as teaching or suggesting most of the limitations of independent claims 1 and 6, but relies on Gautier as disclosing a hand-held device that uses an operating system and Schaefer with respect to font manager behavior such as the use of system font table. Pet. 18–49;

Ex. 1003 ¶¶ 115–241. At this stage of the proceeding, Patent Owner does not address Petitioner’s specific contentions with respect to claims 1 and 6. *See* Prelim. Resp. 14–36.

We have reviewed Petitioner’s contentions for all of the elements of independent claim 1 and the supporting evidence. Pet. 18–38. Based on the record before us, we are persuaded that Petitioner’s discussion of the particular structures, systems, methods, and operations in Collins, Gautier, and Schaefer, and the explanations in the Petition and the Zadok Declaration, sufficiently show that the combined teachings of Collins, Gautier, and Schaefer teach or suggest all of the limitations of claims 1 and 6. *Id.*; Ex. 1003 ¶¶ 115–206.

6. Dependent Claims 2–5 and 7–9

Petitioner contends that the combined teachings of Collins, Gautier, and Schaefer teach or suggest all of the limitations of dependent claims 2–5 (which depend from claim 1) and 7–9 (which depend from claim 6). Pet. 49–57; Ex. 1003 ¶¶ 242–278. At this stage of the proceeding, Patent Owner does not offer any specific arguments with respect to claims 2–5 and 7–9. *See* Prelim. Resp. 14–36. Based on the record before us, we are persuaded that Petitioner’s discussion of the particular structures, systems, methods, and operations in Collins, Gautier, and Schaefer, and the explanations in the Petition and the Zadok Declaration, sufficiently show that the combined teachings of Collins, Gautier, and Schaefer teach or suggest all of the limitations of claims 2–5 and 7–9. Pet. 49–57; Ex. 1003 ¶¶ 242–278.

7. Conclusion: Claims 1–9

We have reviewed Petitioner’s contentions for all of the elements of claims 1–9 and Petitioner’s contentions regarding a reason to combine the

teachings of Collins, Gautier, and Schaefer, as well as all of Patent Owner's arguments in response. Based on the record before us, we determine that Petitioner establishes a reasonable likelihood that it would prevail in showing that independent claims 1 and 6, and claims 2–5 and 7–9 that respectively depend therefrom, would have been obvious over the combined teachings of Collins, Gautier, and Schaefer.

E. Remaining Grounds

Petitioner contends that the subject matter of claims 1–5 and 11–17 would have been obvious over the combined teachings of Collins, Gautier, Schaeffer, and Parthasarathy, and the subject matter of claim 10 would have been obvious over the combined teachings of Collins, Gautier, Schaefer, and Miller. Pet. 57–77. At this stage of the proceeding, Patent Owner does not offer any arguments specifically addressing these grounds. *See* Prelim. Resp. 14–36. Having determined that Petitioner establishes a reasonable likelihood of showing that at least one of the challenged claims is unpatentable, we exercise our discretion and institute an *inter partes* review based on these grounds as well. *See Guidance of the Impact of SAS on AIA Trial Proceedings* (April 26, 2018) (explaining that “the PTAB will institute as to all claims or none” and “if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition”).

F. Notices

The Board shall deem waived any issue not raised in a timely response to the Petition, or as permitted in another manner during trial, even if asserted in the Preliminary Response or discussed in this Decision.

Nothing in this Decision authorizes Petitioner, in a manner not otherwise permitted by the Board's rules, to supplement the information pertaining to any ground advanced in the Petition.

III. CONCLUSION

Taking into account the arguments in the Petition, the Preliminary Response, the Reply, and the Sur-reply, and the evidence of record, we determine that Petitioner has established a reasonable likelihood that it will prevail on its challenge to at least one claim of the '421 patent.

Additionally, we determine that the Petition is not barred by 35 U.S.C. § 315(a). Thus, we institute an *inter partes* review of all challenged claims on the grounds presented in the Petition.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that an *inter partes* review is instituted with respect to the grounds asserted in the Petition; and

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

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