

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COSTAR REALTY INFORMATION, INC. and DUOLINGO, INC.,
Petitioner,

v.

CLANTECH, INC.,
Patent Owner.

IPR2022-00800
Patent 9,892,093 B1

Before GREGG I. ANDERSON, JO-ANNE M. KOKOSKI, and
JON M. JURGOVAN, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)
Dismissing or Denying Petitioner's Motion to Exclude
37 C.F.R. § 42.64

I. INTRODUCTION

Petitioner, CoStar Realty Information, Inc. and Duolingo, Inc. (collectively “Petitioner”), filed a Petition requesting *inter partes* review of claims 1–21 of U.S. Patent No. 9,892,093 B1 (Ex. 1001, “the ’093 patent”). Paper 3 (“Pet.”). Clantech, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). We instituted *inter partes* review on November 23, 2022. Paper 13 (“Inst. Dec.”). Patent Owner filed a Response (Paper 26, “PO Resp.”), Petitioner filed a Reply (Paper 58, “Reply”), and Patent Owner filed a Sur-Reply (Paper 65, “Sur-Reply”).

Patent Owner filed Motion to Exclude Evidence (Paper 66, “Motion,” “Mot.”), Petitioner filed an Opposition to the Motion (Paper 67, “Opposition,” “Opp.”), and Patent Owner filed a Reply to the Opposition (Paper 68, “Reply to Opposition,” “Reply to Opp.”).

A hearing was held on August 29, 2023, and a transcript has been made of record. Paper 76 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 314. Upon considering the record, for reasons discussed below, we find claims 1–21 unpatentable.

II. BACKGROUND

A. Real Parties- in- Interest

Petitioner alleges it is the real party-in-interest. Pet. 66. Patent Owner alleges the real parties-in-interest are the Patent Owner, Clantech, Inc., and Modern Font Applications LLC as Exclusive Licensee. Paper 6, 2 (“Modern Font Applications, LLC’s Mandatory Notice Information”).

B. Related Matters

The '093 patent has been challenged by Petitioner in *Duolingo, Inc. v. Modern Font Applications LLC*, No. 3:21-cv-06132 (N.D. Cal. Aug. 10, 2021) and *CoStar Realty Information, Inc. v. Modern Font Applications LLC*, 3:21-cv-07521 (N.D. Cal. Sept. 27, 2021). Pet. 66; Paper 6, 2.

C. Overview of the '093 Patent

The application for the '093 patent was filed on June 29, 2016 Ex. 1001, code (22). The '093 patent claims priority through a chain of applications, the earliest being US patent application Ser. No. 09/906,444, filed July 16, 2001, now abandoned. *Id.* at 1:9–27. The disclosures of all applications in the chain are incorporated by reference. *Id.* at 1:26–27.

1. Technical Background

The '093 patent relates to

the field of computer font technology. In particular, the present invention 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, 1:33–38.

Conventional printed material generally appears to the reader “precisely as it was generated by the author.” Ex. 1001, 1:62–65. “[E]lectronic documents requested by a reader are displayed on the reader’s computer using only the fonts that are currently loaded on the reader’s computer.” *Id.* at 1:65–2:1. Thus, the problem identified is how to view, copy or otherwise display characters of fonts in different applications that are not standard to an operating system of a reader’s computer. *Id.* at 2:62–67.

2. Subject Matter of '093 Patent

The '093 patent addresses the different font problem by enabling the computer requesting or opening the network document to provide “a font package containing computer readable formatting information necessary for an operating system to render the corresponding characters.” Ex. 1001, 3:17–22. “[T]he network document is generated and displayed by the computer using the same characters with which it was originally created.” *Id.* at 4:51–54.

Figure 2 of the '093 patent is reproduced below.

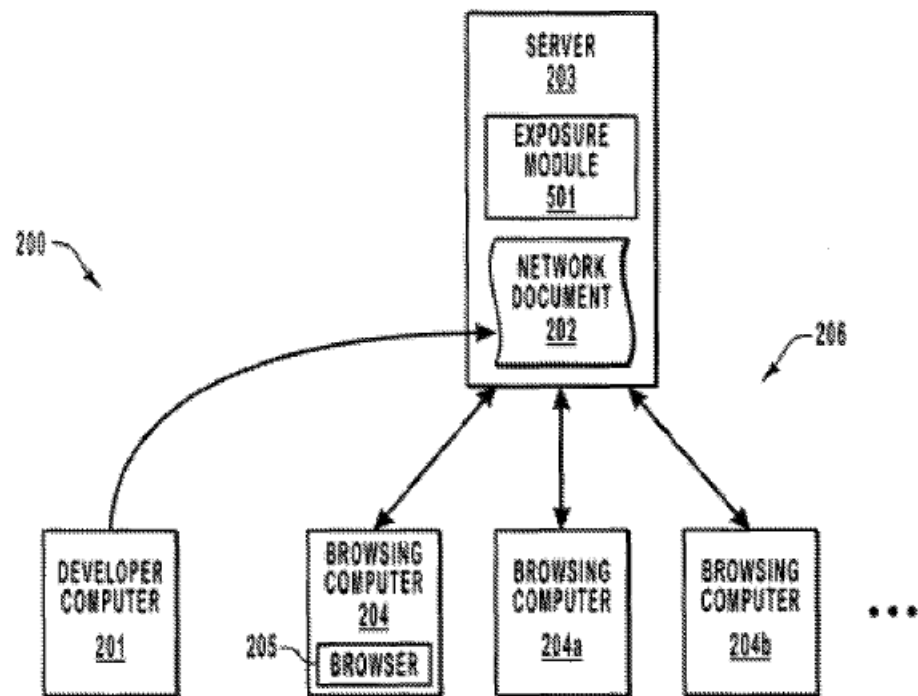


Figure 2 is a schematic diagram of a developer computer from which a developer can post a network document, to a server for access by browsing computers.

Ex. 1001, 3:3:63–65. Figure 2 shows a developer computer 201 and a browsing computer 204 both coupled with network 206. *Id.* at 7:34–41. The developer computer 201 is a computer used to create a network document 202. *Id.* at 7:32–34, 7:42–43. “[N]etwork documents’ can include web pages and other forms of electronic files that can be posted on the Internet; email communications including those that have an HTML document attached thereto; and an HTML document that has embedded therein or reference to any form of application file that contains a display character.” *Id.* at 8:41–47.

In the creation of an HTML document, such as a web page to be displayed, the page is typed in and bounded on each side by a specific font tag. Ex. 1001, 7:54–57. The “font tag defines the name of the font, such as Times New Roman or Courier.” *Id.* at 7:57–58. An operating system processes the HTML document by reading the font tag to determine “whether a font file corresponding to the font tag is loaded in the standard font directory.” *Id.* at 7:60–63. A “standard font” is one where the font tag is loaded in the standard font directory and each character for a corresponding font uses standard font file formats such as a scalable outline format. *Id.* at 3:23–25, 7:66–8:6. “Non-standard fonts” are not loaded on the browsing computer and “the corresponding characters cannot be displayed or otherwise used by the operating system thereof.” *Id.* at 3:12–17, 8:16–21. “[T]he determination of whether a character qualifies as a non-standard character is based solely upon what formatting information is loaded upon or otherwise available to a discrete browsing computer.” *Id.* at 8:21–24.

Developer computer 201 of Figure 2 is loaded with a developer application program. Ex. 1001, 8:50–52. The developer application

program includes a character packager, which generates a font package that is incorporated into or linked to the network document. *Id.* at 8:59–62. The font package “includes the formatting information necessary for the operating system of browsing computer 204 to generate one or more display characters, generally non-standard characters, when browsing computer 204 downloads and displays network document 202.” *Id.* at 7:63–67.

Figure 3A of the '093 patent is reproduced below.

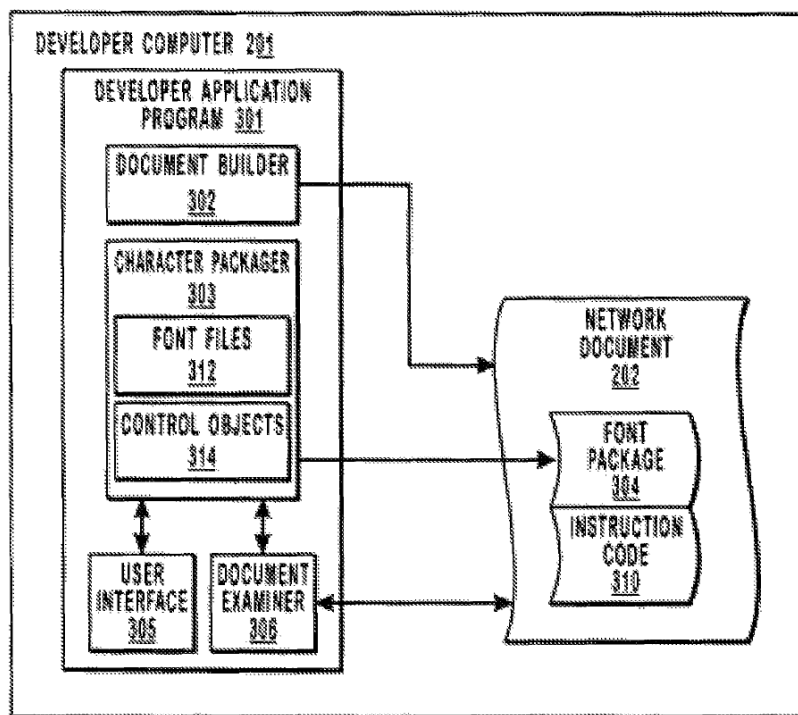


Figure 3A illustrates one embodiment of developer computer 201 of Figure 2 having a developer application program 301 loaded thereon.

Ex. 1001, 8:50–52. “[C]haracter packager 303 identifies the display characters used in network document 202 that are to be included in font package 304.” *Id.* at 9:15–17. Document examiner 306 can “include a list of standard characters and/or fonts and then review network document 202 to identify those characters and/or fonts that are not on the standard list.”

Id. at 10:5–8. “As the different characters, character groups, and/or fonts are selected by user interface 305 and/or document examiner 306, character packager 303 creates corresponding font files 312.” *Id.* at 10:9–12.

Character packager 303 also creates a discrete control object 314 for each corresponding font file 312 and has “handling information which can be used to selectively enhance, manipulate, or otherwise alter the characters within the corresponding font file 312.” *Id.* at 10:40–45. “Once font files 312 and control objects 314 are completed, character packager 303 combines and compresses font files 312 and control objects 314 so as to form font package 304.” *Id.* at 10:53–54.

Character packager 303 shown in Figure 3A also creates instruction code 310, which “comprises computer executable instructions that facilitate downloading onto browsing computer 204 an installation module 501.” Ex. 1001, 11:37–42. Turning to Figure 2, once the font package 304 and instruction code 310 are in network document 202, the document is “loaded onto server 203 so as to accessible by browser computer 204 over network 206.” *Id.* at 11:58–61. The network document is now viewable by the reader using the same characters with which it was originally created. *Id.* at 4:51–54.

D. Illustrative Claim

Claims 1, 10, and 18 are independent claims directed to, respectively, an apparatus, a “non-transitory computer-readable medium,” and a method. Claims 2 through 9 depend directly or indirectly from claim 1. Claims 11 through 17 depend directly or indirectly from claim 10. Claims 19 through 21 depend from claim 18. Claim 1 is reproduced below as illustrative of the claimed subject matter.

[1P]¹ An apparatus of a hand-held² device for exposing a non-standard font of a network document to an operating system comprising:

[1A] a processing unit;

[1B] memory to store instructions that, when executed by the processing unit, cause the processing unit to:

[1C.1] implement a browser for navigating to a network document of a website hosted at a website server;

[1C.2] enable communication between the browser and the web site server;

[1C.3] provide access by the browser to the network document;

[1D.1] generate a transmission for a request to a font server, based at least in part on the network document, to download a font file to the hand-held device, wherein the font file corresponds to a defined character or group of characters;

[1D.2] receive at the hand-held device the font file from the font server, based at least in part on the request to download a font file to the hand-held device; and

[1E.1] automatically expose at least a portion of the font file to an operating system on the hand-held device, to enable the operating system to render one or more of the defined character or group of characters,

¹ The bracketing paragraphs follow Petitioner's format for designating claim limitations. *See* Pet. 69. We adopt Petitioner's format for this Decision.

² The claim language is "hand-held" but throughout the record "handheld" is more often used and we do so as well unless quoting a reference to "hand-held."

[1E.2] wherein an installation module is used to automatically expose the at least a portion of the font file to the operating system, and

[1E.3] wherein the installation module copies the font file to a temporary font directory and

[1E.4] updates a system font table of the operating system to include information about the font file.

Pet. 69–70 (“CLAIM APPENDIX”); *see also* Ex. 1001, 16:5–33 (claim 1).

E. Evidence

This proceeding is based on the following prior art references and expert testimony:

Collins, US Patent No. 5,781,714, issued July 14, 1998 (Ex. 1005, “Collins”).

Parthasarathy, US Patent No. 6,347,398 B1, issued February 12, 2002 (Ex. 1006, “Parthasarathy”).

Gautier, US Patent No. 7,127,493 B1, issued October 24, 2006 (Ex. 1008, “Gautier”).

Schaefer, US Patent No. 7,028,305 B2, issued April 11, 2006 (Ex. 1009, “Schaefer”).

Petitioner relies on the “Declaration of Erez Zadok in Support of Petition for *Inter Partes* Review of U.S. Patent No. 9,892,093” (Ex. 1003, “Zadok Declaration”) and on the “Declaration of Erez Zadok, Ph.D. in Support of Petitioner’s Reply (Ex. 1071, “Zadok Reply Declaration”);

Patent Owner relies on certain exhibits³ to assert it conceived of the invention prior to the earliest filing date of Schaefer (PO Resp. 8 (citing Exs. 2029, 2032, 2035–2036, 2046–2049, 2061, 2070); 18–48 (claim chart citing Exs. 2003, 2114–2119, 2033, 2052, 2053, 2055, 2071, 2073, 2075, and 2091)).

Patent Owner relies on certain testimony and exhibits to show diligence from conception to actual and constructive reduction to practice (PO Resp. 9–10 (citing Exs. 2029–2036, 2053, 2056–2057, 2059, 2070, 2077, 2079–2089));

Patent Owner also relies on the “Declaration of Mac Newbold, M.S.C.S., in Support of Patent Owner’s Response to Petition” (Ex. 2075, “Newbold Declaration”).

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–21 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §⁴	Reference(s)/Basis
1–5, 7–10, 14–21	103	Collins, Gautier, Schaefer
6, 11–13	103	Collins, Gautier, Schaefer, Parthasarathy

III. ANALYSIS

A. Level of Ordinary Skill in the Art

Relying on the Zadok Declaration, Petitioner alleges

³ Exhibits will be specifically identified as needed for purposes of this Decision.

⁴ The Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011) revised 35 U.S.C. § 102, effective March 16, 2013. The ’093 patent has an effective filing date prior to March 16, 2013 (*see* Section II.C). Thus, the grounds asserted are under the pre-AIA version of 35 U.S.C. § 103.

A person [of] ordinary skill in the art . . . would possess 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.

Additional education could substitute for professional experience and significant work experience could substitute for formal education.

Pet. 6–7 (citing Ex. 1003 ¶ 76). Patent Owner does not respond to Petitioner’s proposal and does not propose an alternative level of ordinary skill.

Petitioner’s proposal is consistent with the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (Proposed definition along with the prior art of record, reflects an appropriate skill level). Accordingly, to the extent relevant, we adopt Petitioner’s proposed level of ordinary skill for purposes of this Decision.

B. 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 (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, does “not believe that any claims require construction to resolve the patentability disputes in this proceeding” and would apply the plain and ordinary meaning for the claim terms. Pet. 6. Patent Owner alleges “it is necessary to properly construed the term ‘directory’ and consider whether a [person of ordinary skill in the art] would have understood Collins’ ‘cache’ to teach or suggest a directory or installation.” PO Resp. 57–58.

1. *“the installation module copies the font file to a **temporary font directory** and updates a system font table of the operating system to include information about the font file” (“installation module” limitation) (emphasis supplied)*

All the claims include the installation module limitation, which is specifically recited in independent claims 1, 10, and 18. PO Resp. 58. Patent Owner argues that Collins’ “PfrCache,” relied on by Petitioner to show the “font directory” of installation module limitation, is a cache and not a directory. *Id.* at 62; *see also* Pet. 31 (showing for “temporary font directory”).

In support of its position, Patent Owner highlights that the ’093 patent “does not ever use the term ‘cache’, and does not suggest anywhere that a ‘cache’ can be a directory.” PO Resp. 59. Patent Owner then cites dictionary definitions stating that a directory: is “stored on a disk”; “contain[s] bookkeeping information about files;” requires an operating system to read or write information, which “must use an operating system command;” and that directory files cannot be directly edited. *Id.* at 59–60

(citing Ex. 2071,⁵ 6; Ex. 2073,⁶ 7–8; Ex. 2075, 23 (citing Exs. 2071 and 2073) (some emphasis omitted)).

Patent Owner then provides additional extrinsic evidence to show how a cache differs from a directory. PO Resp. 58–64. Patent Owner disputes as conclusory Dr. Zadok’s testimony that a person of ordinary skill in the art “would have understood that Collins’s PfrCache is a ‘font directory’ because it contains a catalog listing PFR files by name (i.e., font files).” *Id.* at 62 (citing Ex. 1003, 113). Patent Owner also alleges that a cache “can be either a reserved section of main memory or an independent high-speed storage device” and is “always faster than main RAM memory.” *Id.* at 60 (citing Ex. 2071, 3; Ex. 2073, 4; Ex. 2075, 23). Indeed, Patent Owner’s main argument is that disk memory is slower than RAM memory, but cache memory is always faster than main RAM memory. *Id.* at 60–61. Furthermore, Patent Owner cites Petitioner’s expert, Dr. Zadok that files are not stored in cache memory. *Id.* at 61 (citing Ex. 1003, 21). In sum, Patent Owner contends a cache is different from a fonts directory. *Id.* at 62 (citing Ex. 2075, 24; Ex. 1003, 28).

Petitioner responds that a person of ordinary skill in the art would have “understood ‘directory’ to mean ‘a catalog for filenames.’” Pet. Reply 2 (citing Ex. 1011,⁷ 142; 1071 ¶¶ 8–30). Petitioner argues “[t]he intrinsic record refutes that a ‘temporary font directory’ must be ‘on a disk.’” *Id.* (citing Ex. 1001, 4:22–5:11, 5:56–6:42; Ex. 1071 ¶¶ 10–13). According to

⁵ MICROSOFT COMPUTER DICTIONARY, Microsoft Press (4th Ed. 1999).

⁶ COMPUTER & INTERNET DICTIONARY, Random House (3rd Ed. 2000).

⁷ Same as Exhibit 2071. *See* fn 5 above.

Petitioner, the extrinsic record does not require a “temporary font directory” to be stored on a disk. *Id.* at 3 (citing Ex.2071, 142 (directory is a “catalog of filenames”); Ex.2073 158–159 (“file used to organize other files into a hierarchical structure”); Ex.1068,⁸ 138; Ex.1069,⁹ 158; Ex. 1071 ¶¶ 14–26).

Petitioner relies on the Zadok Reply Declaration to assert that a cache can be a directory and “can also include just a catalog for filenames.” Pet. Reply 3–4 (citing Ex. 1071 ¶¶ 14–25 (citing *inter alia* Ex. 1068, 138; Ex.1069, 158; Ex. 2073, 158–159; Ex. 1011, 142; Ex. 1070,¹⁰ 404)). The Zadok Reply Declaration also supports that “a person of ordinary skill would have known that directories were not always stored on disks.” Ex. 1071 ¶ 24 (citing Ex. 1070, 403–404).

Patent Owner argues the Reply argument and evidence should be excluded. PO Sur-Reply 3–5; *see also* Mot. (seeking to exclude Exhibits 1064, 1065, 1066, 1067, 1068, 1069, 1070, 1071 on various grounds). The Motion is dismissed or denied as analyzed in Section IV below. The Sur-Reply does not otherwise respond to Petitioner’s argument and evidence on this claim construction issue. *See generally* PO Sur-Reply.

We are not persuaded by Patent Owner’s arguments that a cache is not a font directory. The evidence that Patent Owner cites (including the ’093 patent, file history, dictionary definitions, etc.) does not define the directory in terms of the medium in which it is stored. Patent Owner attempts to import limitation restricting the directory to be stored in a particular type of

⁸ DICTIONARY OF COMPUTER SCIENCE, ENGINEERING, AND TECHNOLOGY, CRC Press (2001).

⁹ WEBSTER’S DICTIONARY OF COMPUTER TERMS, Simon & Schuster, Inc. 1999).

¹⁰ Abraham Silberschatz, *Operating System Concepts* (1995).

memory, a disk. There is no such restrictive language in the '093 patent, the file history, or any other intrinsic or extrinsic evidence. We decline Patent Owner's proposal to import such a limitation into the claims.

We give weight to the Zadok Reply Declaration and agree with Petitioner that even if storage on a disk is required by the claim language, Collins teaches a "BrowserDirectory" is part of the "DiskRootDirectory," which is a "directory on a disk." Pet. Reply 5 (citing Ex. 1005, Fig. 22; Ex. 1071 ¶¶ 31–35). Neither are we persuaded that any differences between a directory and a cache, in speed for example, require us to exclude a cache memory from a from our construction of "temporary font directory."

We therefore determine that cache memory falls within the scope of the installation module limitation. Specifically, a cache memory may include a temporary font directory.

C. Legal Standard for Obviousness

A patent claim is invalid as obvious if the differences between the claimed subject matter and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a) (2018).

The ultimate determination of obviousness is a question of law, but that determination is based on underlying factual findings . . . The underlying factual findings include (1) "the scope and content of the prior art," (2) "differences between the prior art and the claims at issue," (3) "the level of ordinary skill in the pertinent art," and (4) the presence of secondary considerations of nonobviousness such "as commercial success, long felt but unsolved needs, failure of others," and unexpected results.

In re NuVasive, Inc., 842 F.3d 1376, 1381 (Fed. Cir. 2016) (internal citation omitted) (citing *inter alia Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966)).

“To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Furthermore, in assessing the prior art, the Board must consider whether a person of ordinary skill would have been motivated to combine the prior art to achieve the claimed invention. *NuVasive*, 842 F.3d at 1381.

As the Federal Circuit found, in quoting from the Supreme Court’s decision in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418–19 (2007),

“because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known,” “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”

Personal Web Technologies, LLC v. Apple, Inc., 848 F.3d 987, 991–92 (Fed. Cir. 2017).

D. Obviousness of Claims 1–5, 7–10, and 14–21 Over Collins, Gautier, and Schaefer (Ground 1)

Petitioner alleges claims 1–5, 7–10, and 14–21 would have been obvious over Collins, Gautier, and Schaefer. Pet. 2, 7–55. Petitioner relies on the Zadok Declaration in support of its contentions. Ex. 1003 ¶¶ 101–227.

1. Collins (Ex. 1005)

Collins explains that a font is a set of shapes “representing each character in an alphanumeric character set.” Ex. 1005, 1:26–28. Collins is directed to a system for “creating and playing back portable documents” so that “text with a variety of different fonts can be accurately played back by a machine which does not previously have font descriptions and font interpreters for all of that document’s fonts.” *Id.* at 5:23–29.

Figure 1 of Collins is reproduced below.

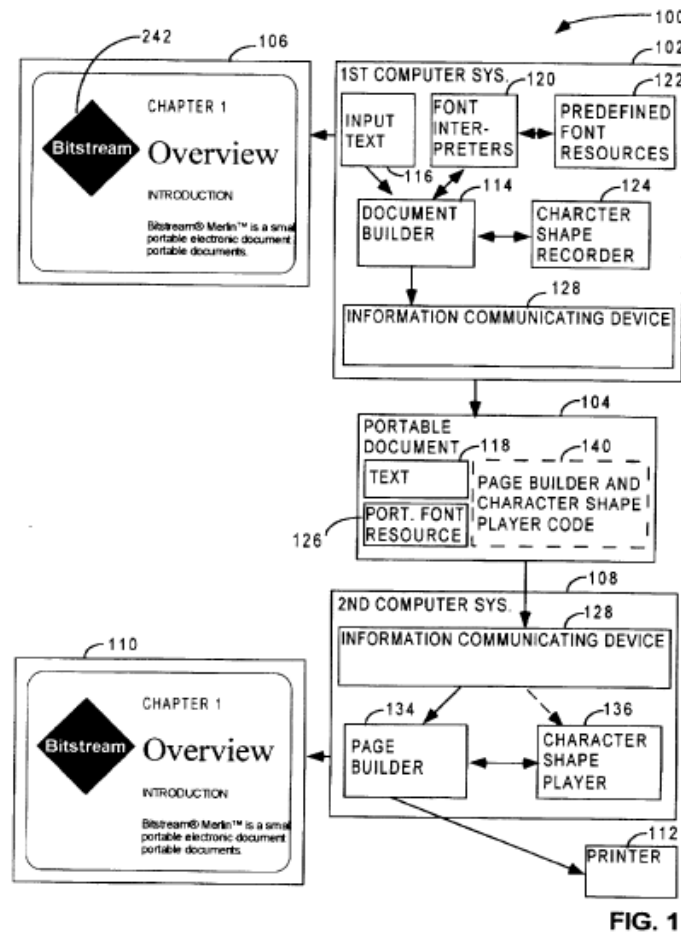


Figure 1 is a block diagram illustrating a system for creating and playing back portable fonted documents including a first computer system and a second computer system.

Ex. 1005, 6:19–26, 8:56–57. The first computer system 102 creates a portable document 104. *Id.* at 8:57–59. The second computer system 108 plays back the portable document through its video monitor 110 and printer 112. *Id.* at 8:60–62. The second computer 108 includes page builder 134 and character shape player (“CSP”) 136. *Id.* at 9:55–56.

Figure 22 of Collins is reproduced below.

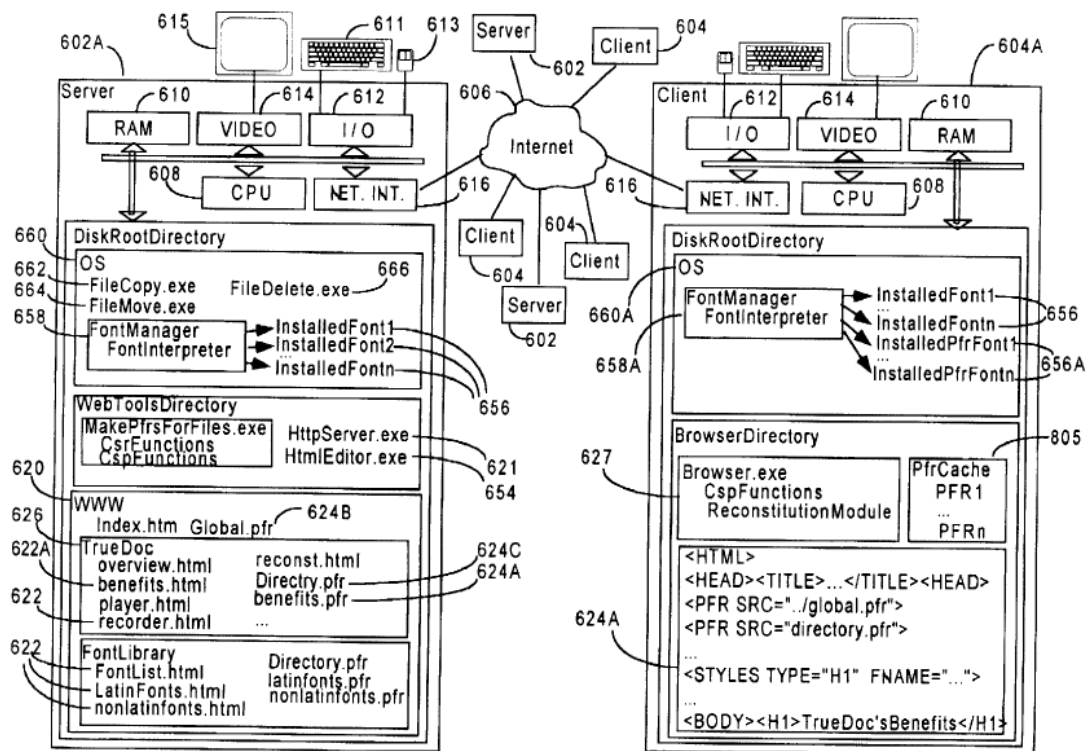


FIG. 22

Figure 22 is a block diagram of a version of another embodiment files are created for HTML files of a World Wide Web site.

Ex. 1005, 7:35–38. The embodiment of Figure 22 is “designed to be used as part of the Internet’s World Wide Web (the ‘Web’).” *Id.* at 26:42–43. The system “comprises a plurality of Web server computers 602 and a plurality of Web client computers 604 which are connected to each other over the internet network 606.” *Id.* at 26:43–46. “Prior art HTML files are ASCII

text files containing text to be displayed and non-displayable tag which can identify the formatting of the text.” *Id.* at 27:6–9. “[T]he HTML language has been extended to include tags which specify the fonts which are intended to be used in the display of HTML text.” *Id.* at 27:12–14.

Portable font resources (“PFR”) include a logical font directory with logical font records and physical font records. Ex. 1005, 24:5–13. “PFR files contain portable font resource which describe the shapes of the intended fonted characters.” *Id.* at 27:14–16.

[A] URL specification identifying a PFR file containing font descriptions necessary for the display of fonts contained in the document. Note that PFR tags do not enclose any text since they apply the names of file images to be displayed in the text since they apply to a whole file. A file can contain multiple PFR tags, because one of the innovative aspects of FIG. 22’s embodiment of the invention is that it allows a document’s fonts to be rendered from more than one PFR file.

Ex. 1005, 29:48–55.

The page builder “creates a rendered image, such as a page image or a screen image from the portable document.” Ex. 1005, 9:56–58. Using the portable document and its associated PFR files, the page builder asks the CSP to “generate the shape for [a] character given its associated font code.” *Id.* at 9:63–65. Through these features, Collins enables “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 10:41–45.

2. *Gautier (Ex. 1008)*

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.

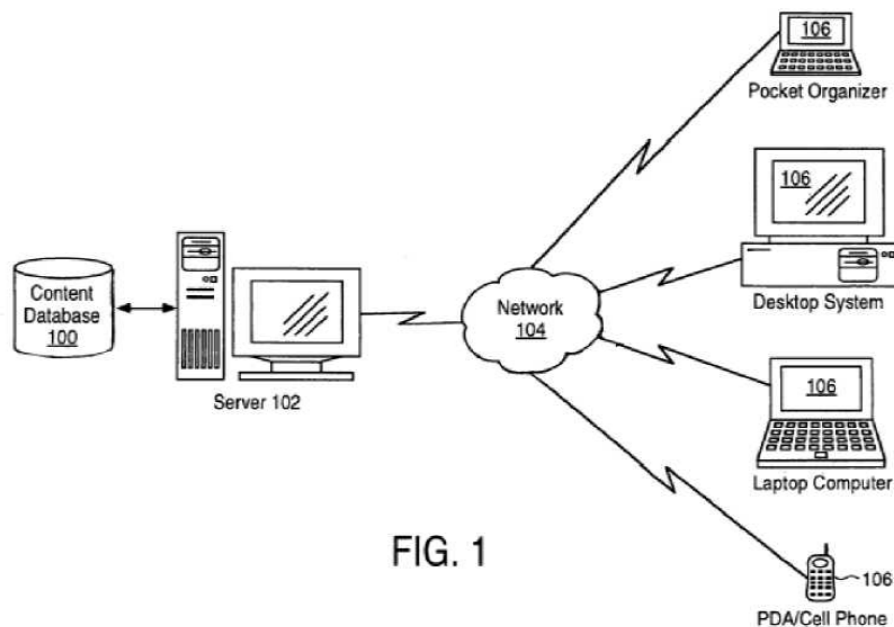


FIG. 1

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 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. *Id.* at 5:47–49.

3. *Schaefer (Ex. 1009)*

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.

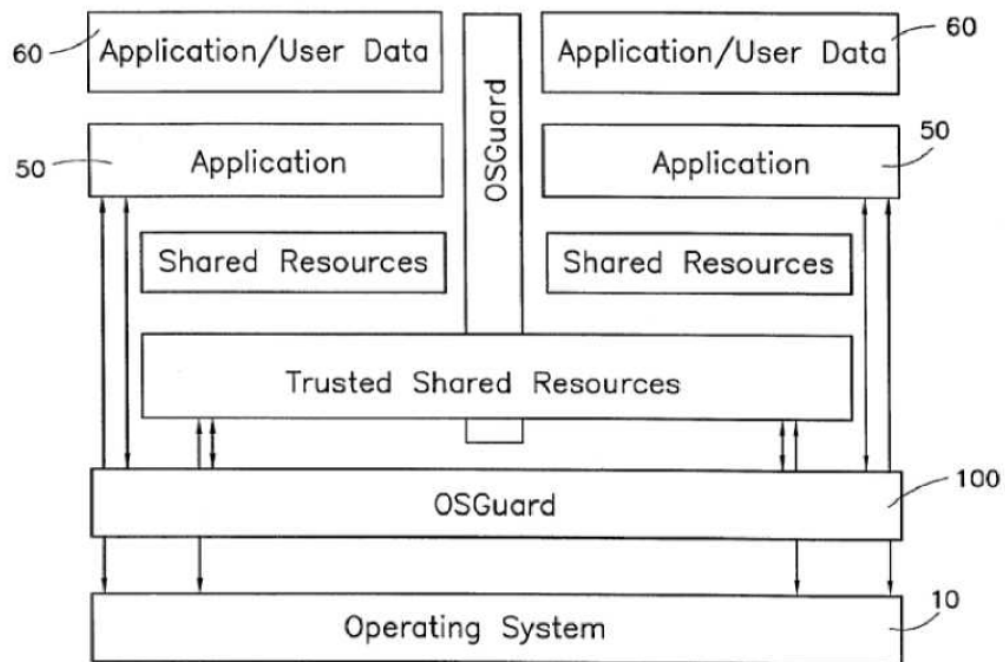


Fig. 1

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 2:35–40.

Figure 4 of Schaefer is reproduced below.

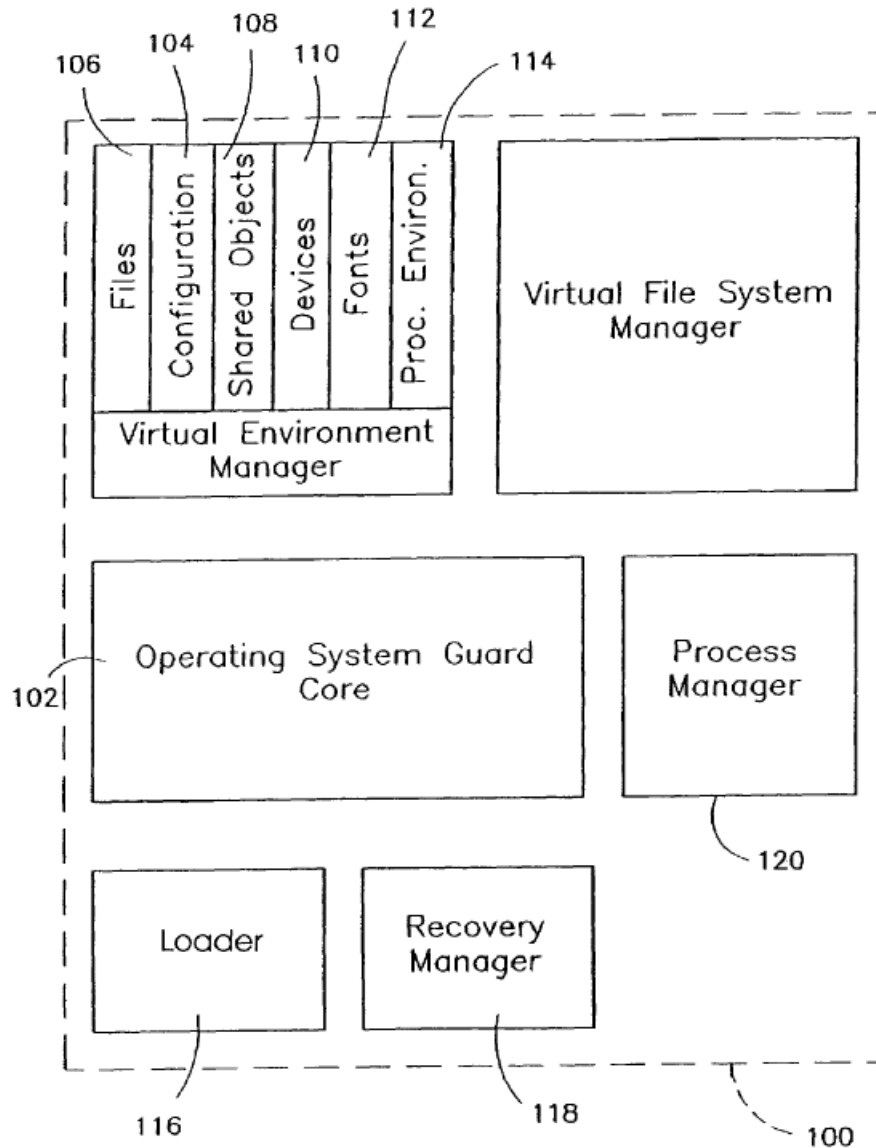


Fig. 4

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. Whether Schaefer is Prior Art

Schaefer was filed on May 16, 2001, published on November 21, 2002, and issued on April 11, 2006. Ex. 1009, codes (22), (45), (65). The earliest effective filing date of the ’093 patent is July 16, 2001. Ex. 1001, code (63). Thus, based on the record filing dates shown on the faces of Exhibits 1009 and 1001, Schaefer is prior art under pre-AIA § 102(e).

Patent Owner argues that Schaefer is not prior art because “at least one embodiment of the inventions claimed in the ’093 patent” was conceived and reduced to practice prior to Schaefer’s May 16, 2001, filing date. PO Resp. 4–5.

a. Legal Standards

“To antedate (or establish priority) of an invention, a [patent owner] must show either an earlier reduction to practice, or an earlier conception followed by a diligent reduction to practice.” *Purdue Pharma L.P. v. Boehringer Ingelheim GmbH*, 237 F.3d 1359, 1365 (Fed. Cir. 2001).

“Conception is the formation, in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is thereafter to be applied in practice.” *Cooper v. Goldfarb*, 154 F.3d 1321, 1327 (Fed. Cir. 1998)). “A reduction to practice can be either a constructive reduction to practice, which occurs when a patent application is filed, or an actual reduction to practice.” *Id.* “In order to establish an actual reduction to practice, the inventor must prove that: (1) he constructed an embodiment or performed a process that met all the limitations of the [claimed invention];

and (2) he determined that the invention would work for its intended purpose.” *Id.*

If a patent owner has not shown actual reduction to practice prior to the “critical date” of a reference, the patent owner may nonetheless antedate the reference by establishing prior conception and reasonable diligence towards a constructive reduction to practice. *Purdue Pharma*, 237 F.3d at 1365. “Reasonable diligence must be shown throughout the entire critical period, which begins just prior to the competing reference's effective date and ends on the date of the invention’s reduction to practice.” *Arctic Cat Inc. v. GEP Power Prods., Inc.*, 919 F.3d 1320, 1331 (2019). However, the “diligence need not be perfectly continuous—only reasonably continuous.” *Id.* (emphasis omitted).

To be persuasive, an inventor's testimony of conception and reduction to practice must be corroborated by other independent evidence. “Conception must be proved by corroborating evidence which shows that the inventor disclosed to others his completed thought expressed in such clear terms as to enable those skilled in the art to make the invention.” *REG Synthetic Fuels, LLC v. Neste Oil Oyj*, 841 F.3d 954, 962 (Fed. Cir. 2016) (internal quotation marks omitted). “However, there is no final single formula that must be followed in proving corroboration.” *Id.* (quotation marks omitted); *see also Kolcraft Enters., Inc. v. Graco Children’s Prods., Inc.*, 927 F.3d 1320, 1324 (Fed. Cir. 2019); *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1169–70 (Fed. Cir. 2006).

“In the final analysis, each corroboration case must be decided on its own facts with a view to deciding whether the evidence as a whole is persuasive.” *Berges v. Gottstein*, 618 F.2d 771, 776 (CCPA 1980). Corroborating evidence may consist of “testimony of a witness, other than

the inventor,” or “evidence of surrounding facts and circumstances independent of information received from the inventor.” *Medichem*, 437 F.3d at 1171. “Even the most credible inventor testimony is a fortiori required to be corroborated by independent evidence, which may consist of documentary evidence as well as the testimony of non-inventors.” *Id.* at 1171–72 (emphasis omitted). We assess whether evidence corroborates conception and reduction to practice under a “rule of reason” analysis. *Cooper*, 154 F.3d at 1330.

In an *inter partes* review, 35 U.S.C. § 316(e) imposes the ultimate burden of persuasion to “prove unpatentability by a preponderance of the evidence” onto the petitioner. This burden never shifts to the patent owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). However, when the patent owner attempts to antedate the prior art, “[a] second and distinct burden, the burden of production” can shift between the petitioner and the patentee. *Id.* at 1379; *see Magnum Oil*, 829 F.3d at 1375–76. Specifically, the patent owner “bears the burden of establishing that its claimed invention is entitled to an earlier priority date than an asserted prior art reference.” *Magnum Oil*, 829 F.3d at 1375–76. Once the patent owner establishes it is entitled to an earlier priority date, the burden of production then shifts back to the petitioner “to convince the court that [the patent owner] is not entitled to the benefit” of the earlier priority date. *Dynamic Drinkware*, 800 F.3d at 1379 (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1328 (Fed. Cir. 2008)).

b. Conception

Patent Owner argues that Schaefer does not qualify as prior art because on January 30, 2001, the sole inventor (Robert G. Adamson III) of the ’093 patent conceived of the subject matter of claims 1–3 and 5–17 “in

build 50 of his MediaForge 4.2 software.” PO Resp. 8 (citing Ex. 2053,¹¹ 19–27, 60–65; Ex. 2075, 51–52; Ex. 2056,¹² 11; Ex. 2057,¹³ 4; Ex. 2036,¹⁴ 16–17; Ex. 2061;¹⁵ Ex2070,¹⁶ 26–27; Ex. 2048,¹⁷ 3), 9, 17–48 (“Prior Conception Chart”). Petitioner’s Reply does not respond to Patent Owner’s argument and evidence of conception. *See* Pet. Reply 1.

c. Reduction to Practice

Patent Owner argues alternatively that “the evidence need only show reasonable diligence from just before Schaefer’s priority date (May 16, 2001) through the constructive reduction to practice on July 16, 2001,” when the application for the ’093 patent was filed. PO Resp. 9–11, 47–49 (citing *Medtronic v. Teleflex Innovations*, IPR2020-00132, Paper 127 at 58 (PTAB June 17, 2021)). Patent Owner’s evidence of diligence relies on declarations and evidence from the inventor, coworkers, and patent attorneys. *Id.* at 47–

¹¹ Declaration of Robert B. Adamson III (“Adamson III Declaration,” inventor of ’093 patent).

¹² Declaration of Robert G. Adamson IV (son of inventor).

¹³ Declaration of Natalie Gildersleeve (daughter of inventor).

¹⁴ Declaration of Byron W. Boyd Jr. (co-founder of ClearSand (aka “Clearsand”) Corporation with the inventor).

¹⁵ Exhibit B to Exhibit 2059, Affidavit of Nathaniel E Frank-White (Records Request Processor at the Internet Archive,” Ex. 2059 ¶ 1).

¹⁶ Declaration of Sylvia Hall-Ellis, Ph.D. (Adjunct Professor in the School of Information at San José State University testifying as an expert to the public availability and authenticity of two publications).

¹⁷ ClearSand Corporation Beta Testing for MediaForge 5.0 (annotated).

49 (citing Ex. 2053, 4, 15–17; 2077,¹⁸ 9–15; Ex. 2036, 6, 16; Ex. 2121,¹⁹ 3; Ex. 2056, 5–7; Ex. 2057, 5; Ex. 2099,²⁰ 1–5; Ex. 2029,²¹ 4; Ex. 2035,²² 4–6).

At the hearing, Petitioner argued “none of the thousands of pages that is submitted show prior conception or reduction to practice in a *handheld device*.” Tr. 7:5–6 (emphasis added). Petitioner cites the Federal Circuit’s decision in *Parus*²³ for its holding that where “a patent owner attempts to antedate an asserted prior art reference, the patent owner assumes a temporary burden of production.” *Id.* at 15:21–16:1; *Parus*, 70 F.4th at 1371–1372.

d. Alternative Theory

As previously noted, Petitioner’s Reply does not respond to Patent Owner’s argument and evidence of conception nor does it respond to the argument regarding diligent reduction to practice. *See* Pet. Reply 1. Instead, Petitioner argues that Schaefer is not needed and Collins teaches the same limitations that Schaefer was cited for. *Id.* (“Petitioner relied on Schaefer

¹⁸ Declaration of Michael Gutierrez (performed forensic imaging of several hard drives, CDs, and electronic zip files provided by counsel).

¹⁹ Declaration of Jared Rowe (Lead User Interface (UI) Developer and Designer for ClearSand Corporation).

²⁰ ClearSand Corporation Timesheet for April and June 2001.

²¹ Declaration of Adrian J. Lee (patent attorney at Workman Nydegger PC who drafted inventor’s patent application and authenticates invoice dated August 8, 2001, to TrueRes, Inc. showing work from April 3, 2001, through July 16, 2001 (Ex. 2030)).

²² Declaration of Dana Tangren (patent attorney at Workman Nydegger PC who drafted inventor’s patent application and authenticates invoice dated August 8, 2001, to TrueRes, Inc. showing work from April 3, 2001 through July 16, 2001 (Ex. 2035)).

²³ *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365 (Fed. Cir. 2023); *see also* Pet. Reply 14 (cited as *Parus Holdings, Inc. v. Google LLC*, No. 2022-1269, 2023 WL 3939532, at *4 (Fed. Cir. June 12, 2023)).

only for the ‘copying’ and ‘updating’ claim elements, and Collins teaches both.”). As to the “copies the font file” limitation in each of the independent claims,, Petitioner argues “Collins in combination with Gautier teaches this limitation.” *Id.* at 2 (citing Pet. 31–35; Ex. 1003 ¶¶ 150–166).

Petitioner cites to the Federal Circuit decision in *Realtime*. Tr. 7:14–18. In *Realtime*, the Federal Circuit concluded that where the primary argument was that one reference disclosed all the claim elements, an alternative argument that a second reference disclosed some of the elements in the claims at issue did not require a showing by petitioner of a reason to combine the second reference with the first. *Realtime*, 912 F.3d at 1372–1373.

e. Discussion and Conclusion

We find the holding in *Parus* applicable here and determine we are not required to “play archaeologist with the record” in order to find specific support for conception. *Parus*, 70 F.4th at 1371. *Parus*’ holding directly discusses this situation in holding that “[t]he burden of production cannot be met without some combination of citing the relevant record evidence with specificity and explaining the significance of the produced material in briefs.” *Id.* Patent Owner’s list of exhibits include approximately one hundred twelve (112) exhibits which purportedly relate to its allegation of prior invention relative to Schaefer. *See* Exs. 2011–2123. Citations to some of the exhibits are spread throughout the Patent Owner Response, including the Prior Conception Chart. *See* PO Resp. 18–48. Despite the volume of exhibits, we are not provided with a definitive discussion of why many are relevant to conception or reduction to practice.

Below we organize what Patent Owner does specifically cite to establish dates for conception and reduction to practice. With respect to our

determination following *Parus*, we have organized what Patent Owner points to as evidence specific to conception or reduction to practice of a handheld device. For example, the cited Prior Conception Chart relies in part on the Newbold and Zadok Declarations, stating “[h]and-held devices included browsers for downloading Internet webpages.” PO Resp. 18 (citing Ex. 2075, 13; Ex. 1003, 32–33). That “hand-held devices [incorporated] browsers” is also alleged as part of the “MediaForge Software.” *Id.* at 18–19 (citing same Newbold and Zadok Declarations; Ex. 2055, 7 (“ . . . Mirage uses the same runtime components in both browsers . . . Internet Explorer . . . ”)); Ex. 2091, 4 (Palm Pilot)). These citations are either to expert opinions or to the product Patent Owner alleges was a reduction to practice of the claimed invention. The evidence does not support any conception date including a handheld device.

As to the other third-party declaration evidence, we agree with Petitioner that the testimony of conception is not sufficiently corroborated. *See* Pet. Reply 16. Specifically, we again find that there is no specific disclosure as to a handheld device. The forensic expert in the Gutierrez Declaration simply lists files and creation and modification dates. *See* Ex. 2077 ¶¶ 27–48. The Gutierrez Declaration does not discuss the contents of the files. The Adamson III Declaration relies on the Gutierrez Declaration to establish dates when work was done. *See* Ex. 2053 ¶¶ 42–45. But again, we are not provided with any evidence that a handheld device was disclosed in any of the files.

In establishing conception a party must show that every limitation of the claim must have been known to the inventor at the time of the alleged conception. *Cf. Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985) (conception requires showing for every limitation in an interference count).

Similarly, in connection with “actual reduction to practice,” the inventor must prove that he “constructed an embodiment or performed a process that met all the limitations” of the claimed invention. *Cooper*, 154 F.3d at 1327.

We find that a “handheld” device is required in all challenged claims. Claims 1 through 9 are directed to an “apparatus of a hand-held device.” Ex. 1001, 16:5–7 (claim 1). Claims 10 through 17 are directed to a “non-transitory computer-readable medium,” requiring “enabling communication between a handheld device and a web site server.” *Id.* at 16:61–63; *see also* Tr. 90:9–20 (Petitioner arguing the “instruction” for enabling would require a “hand-held device” to be rendered). Like claims 10 through 17, claims 18 through 21 are directed to a method but all recite the same “enabling communication” through a “handheld device.” Ex. 1001, 18:5–7.

Patent Owner concedes that a handheld device is required except for claims 10 through 17, directed to a “non-transitory computer-readable medium,” because “[n]one of these claims requires use with a hand-held device, only that the medium include instructions.” PO Sur-Reply 6 (citing Ex. 1001, 16:58–18:3). Patent Owner cites to the evidence of the attorney disclosures and the MediaForge Software to support conception of a handheld device for a “computer readable medium” prior to the earliest filing date of Schaefer. *Id.* at 6–8 (citing Ex. 2075 ¶ 44; Ex. 1003 ¶¶ 55–57). However, as discussed below, Patent Owner does not explain legally or factually why the recitation of a handheld device in claims 10 through 17 should be ignored.

Concerning the “handheld device” limitation, at the hearing Patent Owner’s counsel was asked directly for support for a handheld device. Tr. 46:24–47:2. Patent Owner argued that

computer readable media is something that *has to be accessible by a handheld device*. And in one embodiment, that can be a website on a web server.

Id. at 47:3–20 (emphasis added). Patent Owner’s counsel was again asked for specifics of how the evidence supports is “there anything in the briefing itself where you either discuss the Adamson’s [III] Declaration or compare the pertinent disclosure from [Exhibits] 2100 and 2101 to 2052?” *Id.* at 47:25–48:1. The response was not specific, asserting only that “[t]he brief cites to Exhibit 2052, okay? And that’s the exhibit that Petitioners challenged. And the brief says those documents that disclosure that we cited in 2052 was made by February 2001.” *Id.* at 48:13–20 (citing Ex. 2053 (Adamson III Declaration) ¶ 135).

Exhibit 2052 is entitled “MediaForge 4.1/4.2 Release Notes” (“Release Notes”). Ex. 2052. Exhibit 2052 is undated but is referenced in the Adamson III Declaration (Ex. 2053, 19) which authenticates the Release Notes. *Id.* at 19. The “Builds” 1, 2, 2.1, 2.2, 2.3, and 2.4 are described but are undated. *Id.* at 2–4. Builds 3, 3.1, 4, 5, 6, 6.1, 7, 8, 8.1, 8.2, and 9–24 have notations indicating dates between November of 1999 and April of 2000. *Id.* at 4–20. Neither the Adamson III Declaration nor Exhibit 2052 include any mention of a handheld device, instead stating in a conclusory manner that “I can confirm that the claim charts accurately show conception of my claimed invention for each of the claim elements as shown on the chart and disclosed in Exhibits 2052 and 2055, and fontmagic.mfg.” Ex. 2053, ¶ 136. Similarly, the entirety of paragraph 135 of the Adamson III Declaration states that “[b]y the end of 2000, it was well-known that many operating systems rendered fonts for use in displaying characters on computer screens.” *Id.* ¶ 135.

None of the evidence relied on shows that “a definite and permanent idea” related to a handheld device was formed in the mind of the inventor and thereafter “to be applied in practice.” *See Cooper*, 154 F.3d at 1327. The evidence, including that for claims 10 through 17, which is not separately highlighted, is all based on an implication, supported by expert opinion, that a handheld device would have the same functionality as computers generally and thus was “conceived.” *See* Tr. 58:18–25 (Patent Owner’s counsel: “What I’m saying is that the conception -- the idea that formed in his mind was, this is going to be for any client computer that accesses the Internet. And the experts have confirmed that handheld computer is consumed [conceived] -- is part of that.”); *see also* PO Sur-Reply 6–8 referenced above (citing Ex. 2075 ¶ 44; Ex. 1003 ¶¶ 55–57).

Petitioner’s theory that Schaefer is an alternative to Collins argument is supported by the Petition, which argues Collins discloses Limitations [1.E.1] and [1.E.3]. Pet. 31–33. Petitioner argues that “Schaefer also discloses the same limitation.” *Id.* at 33. Along with Collins, Petitioner cites Schaefer for Limitation [1.E.4], reciting in pertinent part a “font table.” *Id.* at 37–38. However, Collins is still relied on to show that a person of ordinary skill “would have understood this disclosure in Collins to be a ‘*system font table*’ because a table is merely a ‘data structure usually consisting of a list of entries, each entry being identified by a unique key and containing a set of related values.’” *Id.* at 36 (citing Ex. 1003 ¶ 174 (citing Ex. 1011, 434); *see also* Ex. 1003 ¶¶ 172–177 (Limitation [1.E.4] met by Collins and not mentioning Schaefer).

Patent Owner contends that proceeding without Schaefer is a new ground. *See, e.g.*, Tr. 42:8–10. Patent Owner asserts that trial was instituted based on the combination including Schaefer. *Id.* at 72:15–73:2. The

Institution Decision “also cites” to Schaefer for Limitation [1.E.3], as noted above in the Petition. While the Institution Decision is fundamental to whether a trial occurs, it is a preliminary determination only. *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 262 (2016). Trial takes place on what is alleged in the Petition, not the Institution Decision.

Having reviewed the argument and evidence relied upon by Patent Owner, we find that Patent Owner has not shown conception prior to the critical date of Schaefer. We also determine that even if Patent Owner has shown conception prior to the effective date of Schaefer, the Petition alleges Schaeffer as additional support for certain limitations. Collins sufficiently shows those limitations as well, as is supported in the Petition.

5. Claim 1

Petitioner has sufficiently shown each limitation of claim 1 is disclosed by the combination of Collins, Gautier, and Schaefer, or Collins and Gautier alone. We rely on the Petition and the Zadok Declaration. *See* Pet. 19–38; Ex. 1003 ¶¶ 112–177.

The parties’ arguments are summarized below.

a. Petitioner’s Argument and Evidence Regarding Claim 1

The preamble of claim 1 [1P], recites an “apparatus of a hand-held device for exposing a non-standard font of a network document to an operating system.” Petitioner makes a showing that the preamble is taught by Collins, treating it as a patentable limitation. Pet. 19–22. Patent Owner does not address the preamble. We agree that the preamble is limiting at least because it provides antecedent basis for the terms “non-standard font,” “network document,” and “operating system.” *See Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003).

Petitioner argues Gautier teaches the recited “handheld device.” Pet. 20 (citing Ex. 1008,²⁴ 5:30–35, 1:33–40 (“today a web site may be accessed by many different types of clients, from conventional full size computers . . . to **small handheld computers with small screens . . . to cellular telephones**”); Ex.1003 ¶ 115). Petitioner cites to Gautier’s teaching that the “optimization constraint[s include both] client device type [and] client operating system type.” *Id.* at 20–21 (quoting Ex. 1008, 5:49–55).

For the recited “operating system” of the preamble, Petitioner cites to Collins’ system, shown in Figure 22 above (*see* Section III.E.1), and Collins’ explanation that “Web server computers 602 and a plurality of Web client computers 604 which are connected to each other over the internet network 606.” Pet. 19 (citing Ex. 1005, 26:41–46). Petitioner points to Figure 22’s operating system 660 which “contains a browser program 627 which sends HTTP requests for HTML files and then displays them on the screen 615A of its computer for a user to see.” *Id.* (citing Ex. 1005, 27:45–48). Gautier is also cited for showing an operating system as an “optimization constraint” in a client device. *Id.* at 20–21 (citing Ex. 1008, 5:49–55).

Collins’ HTML files “are ASCII text files containing text to be displayed and non-displayable tag which can identify the formatting of the text.” Ex. 1005, 27:6–10. Petitioner relies on the preceding to teach the recited “network document.” Pet. 21 (citing Ex. 1005, 27:6–10; Ex. 1003 ¶ 116).

²⁴ Petitioner’s showing on all limitations includes relying on Gautier to show the “hand-held device.” *See, e.g.*, Pet. 22 (“combination of Collins and Gautier therefore discloses a ‘hand-held device’” as part of showing for Limitations [1A] and [1B]).

Petitioner relies on Collins HTML files as “standard fonts” generated using a standard version of the HTML language “extended to include tags which specify the fonts which are intended to be used in the display of HTML text.” Pet. 21 (citing Ex.1005, 27:11–14, 61–62). Petitioner contends that Collins teaches “non-standard” HTML fonts can be specified. *Id.* (citing Ex. 1005, 30:42–46). Petitioner concludes that Collins’ “network documents” use one or more “non-standard font[s].” *Id.* (citing Ex. 1003 ¶ 117).

Limitations [1A] and [1B] recite, respectively, a “processing unit” and a “memory to store instructions.” Petitioner points to Collins’ teaching of “one or more CPUs 608 for executing computer instructions and reading and writing data” and “a random access memory (or ‘RAM’) 610 for storing instructions execution by the CPU and data read or written by the CPU.” Pet. 22 (citing Ex. 1005, 26:54–67, Fig. 22; *see also* Ex. 1008, code (57), 2:66–3:5 (“processor” and “memory”), 5:31–35); Ex. 1003 ¶¶ 119–121).

Limitation [1C.1] recites “implement a browser for navigating to a network document of a website hosted at a website server.” Petitioner alleges Collins has Web server computers with a hard disk having Web servers. Pet. 23 (citing Ex. 1005, 26:41–46; Fig. 22). The Web servers have a “DiskRootDirectory” which includes, among other things, HTML files for a hypothetical Web site. *Id.* (citing Ex. 1005, 27:1–3). Petitioner alleges the data stored in directory includes HTML files, which Petitioner contends is the claimed “network document.” *Id.* (citing Ex. 1005, 27:4–6; Ex. 1003 ¶¶ 123–126). Petitioner also cites Collins as teaching the use of a mouse to navigate the Web. *Id.* at 24 (citing Ex. 1005, 27:48–54). According to Petitioner, “navigation” is taught by Collins because using the browser program a user of client computer 604A **“navigate[s] through the Web by**

using his mouse to click on portions of the documents which contain links to other documents.” *Id.* at 24 (quoting Ex. 1005, 27:48–54).

Limitation [1C.2] recites “enable communication between the browser and the web site server.” Petitioner’s showing for this limitation is based on instructions in Collins’ extended browser program that are executed to “enable communication between the browser and the web site server.” Pet. 24–25 (citing Ex. 1003 ¶ 130).

Limitation [1C.3] recites “provide access by the browser to the network document.” Petitioner asserts that Collins’ server program 621, shown in Figure 22 above as HTTPServer.exe, detects the arrival of a request message and “**accesses** the file identified by the message’s URL” and ‘sends it back on the net to the return address in the HTTP message.’” Pet. 25 (quoting Ex. 1005, 27:42–44).

Limitation [1D.1] recites “generate a transmission for a request to a font server, based at least in part on the network document, to download a font file to the hand-held device, wherein the font file corresponds to a defined character or group of characters.” Petitioner alleges that Collins’ PFR file is a “font file.” Pet. 26 (citing Ex. 1005, 24:10–14, 24:20–23, 24:25–28); Ex. 1003 ¶ 138). Petitioner contends the recited “font file . . . corresponds to a defined character or group of characters” because “PFR tags” shown in Collins Figure 20 as <PFR SRC =“FileReference”>,” “where FileReference is a URL specification identifying a PFR file,” specify fonts and font descriptions necessary for display. *Id.* at 27–28 (citing Ex. 1005, 29:45–49, 30:42–46, Fig. 20; Ex. 1003 ¶¶ 138–143). The prior evidence and argument are supported by the Zadok Declaration. *Id.* (citing Ex. 1003 ¶¶ 138–143).

Limitation [1D.2] recites “receive at the hand-held device the font file from the font server, based at least in part on the request to download a font file to the hand-held device.” Petitioner argues the “font file request” is met when Collins’ browser program “sends an HTTP message over the internet to the server computer identified in the PFR’s URL, requesting the PFR file identified in that URL.” Pet. 28 (citing Ex. 1005, 40:15–17; Ex. 1003 ¶¶ 144–145).

Petitioner also relies on Collins’ Figures 33, 34, and 36 Annotated, reproduced at page 29 of the Petition. Figures 33, 34, and 36 are all “highly simplified flow charts” of the functional steps used by the Web browser program, browser.exe., shown in Figure 22. *See* Ex. 1005, 8:17–23, 8:28–33, Fig. 22 (reproduced above in Section III.E.1). As shown in Figure 33 Annotated, and highlighted by Petitioner in a red box, the “AccessNewDoc function is called to obtain the HTML file associated with the URL.” Pet. 28–29 (citing Ex. 1005, 37:33–39, Fig. 33 Annotated). The above evidence and argument are supported by the Zadok Declaration. *Id.* at 29 (citing Ex. 1003 ¶¶ 147–148).

Petitioner describes Limitations [1E.1]–[1E.4] as the “automatically expose” limitations. Pet. 30. Petitioner alleges the combination of Collins, Gautier, and Schaefer teaches all four elements. *Id.* (citing Ex. 1003 ¶¶ 149–177). We address each element below.

Limitation [1E.1] recites “automatically expose at least a portion of the font file to an operating system on the hand-held device, to enable the operating system to render one or more of the defined character or group of characters.” Petitioner relies on the Zadok Declaration to assert that PfrCache, shown in Collins’ Figure 22, is a “temporary location for storing the fonts on the browsing computer because caches have limited room and

older items must be removed after some time, to make room for newer items.” Pet. 32 (citing Ex. 1003 ¶ 161). Petitioner also alleges Collins’s PfrCache is a “font directory” because “it contains a catalog listing PFR files by name (i.e., font files).” *Id.* (citing Ex. 1011,²⁵ 142). Petitioner alleges Collins’ GetAndDisplayPfrs function “cause[s] all of the fonts contained in the current HTML file’s PFRs to be **installed in the operating system of the browser’s computer**, enabling them to be rendered more quickly.” *Id.* at 33 (citing Ex. 1005, 39:35–40, Fig. 38 (step 840 InstallPfr function installation of fonts)). Petitioner concludes that “[t]he installation/exposure of Collins’ PFR font package occurs automatically because the GetAndDisplayPfrs and InstallPfrs functions do not require or allow user intervention when the browsing computer is processing an HTML document.” *Id.* at 34 (citing Ex. 1003 ¶¶ 155–156).

Petitioner analyzes Limitation [1E.3] with Limitation [1E.1]. Pet. 31. Limitation [1E.3] recites “wherein the installation module copies the font file to a temporary font directory.” The combination of Collins, Gautier and Schaefer is alleged to teach “cop[ying] the font file to a temporary font directory.” *Id.* at 34 (emphasis inputted). Petitioner alleges the processes performed by Collins’ GetAndDisplayPfrs and InstallPfrs functions “cop[y] the font file to a temporary font directory” “on the hand-held device in the combination of Collins and Gautier.” *Id.* (citing Ex. 1003 ¶¶ 151–159) (emphasis omitted).

²⁵ MICROSOFT COMPUTER DICTIONARY (4TH ed. 1999), “directory n. 1. A catalog for filenames and other directories stored on a disk. A directory is a way of organizing and grouping the files so that the user is not overwhelmed by a long list of them. . . .”

Petitioner also cites to Schaefer²⁶ as disclosing files are “temporary” and their storage location is a “temporary fonts directory,” as per Limitation [1E.3]. Pet. 33–34 (citing Ex. 1009, 7:44–45; Ex. 1003 ¶ 163). Specifically, Schaefer teaches “that its ‘Operating System Guard can use its File subsystem to avoid placing the actual font file in the running system’ and to ‘enable these fonts prior to running the application and if necessary remove them afterwards.’” *Id.* (citing Ex. 1009, 9:23–25, 9:3–5; Ex. 1003 ¶ 163).

Petitioner relies on its showing for Limitation [1E.2] for the “installation module” element. Pet. 35–36 (citing Pet. 30 (showing for Limitation [1E.2]); Ex. 1003 ¶¶ 167–171). Petitioner points specifically to the browser program of Collins and the functions AccessNewDoc, GetAndDisplayPFRs, DisplayNewScreen, and InstallPfrs. *Id.* at 35.

The entirety of Limitation [1E.2] recites “wherein an installation module is used to automatically expose the at least a portion of the font file to the operating system.” Petitioner alleges the “installation module” is taught by Collins InstallPfrs function which

causes the current document’s PFR’s font descriptions 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 [sic] fonts 656A into the operating system’s font manager 658A so they can be rendered more quickly by making calls to the operating system.

Pet. 36 (quoting Ex. 1005, 37:64–38:1); *see also* Ex. 1005, Fig. 22 above (showing elements 656A and 658A);

Petitioner also makes a showing for the installation module of Limitation [1E.2]. Pet. 35–36 (citing Pet. 30 (citing Ex. 1003 ¶¶ 167–171)).

²⁶ This alternative theory was discussed in Section III.D.4.d above.

Petitioner points specifically to the browser program of Collins and the functions AccessNewDoc, GetAndDisplayPFRs, DisplayNewScreen, and InstallPfrs. *Id.* at 35.

Limitation [1E.4] recites “updates a system font table of the operating system to include information about the font file.” Petitioner relies on the Zadok Declaration and the understanding of a person of ordinary skill in the art to argue that Collins’ disclosure in Figure 22 was a “system font table” “because a table is merely a ‘data structure usually consisting of a list of entries, each entry being identified by a unique key and containing a set of related values.’” Pet. 36–37 (citing Ex. 1003 ¶ 174 (citing Ex. 1011, 434)).

6. *Petitioner’s Reasons to Combine Collins, Gautier, and Schaefer or Collins and Gautier*

Petitioner first asserts that a person of ordinary skill in the art would have been motivated to “implement Collins’ extended browser as software on a hand-held device based on the teachings of Gautier.” Pet. 15 (citing Ex. 1003 ¶¶ 101–104, 108–111). According to Petitioner this is because “by 2001, 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.” *Id.* at 15–16 (citing Ex. 1003 ¶ 101). The combination is also alleged to help web content developers provide “dynamic font web pages” on more devices of “virtually any desired size,” as suggested by Collins. *Id.* at 16 (citing Ex. 1005, 2:29–31; Ex. 1003 ¶ 103).

According to Petitioner a person of ordinary skill would have also been motivated to combine “Schaefer’s teachings of an operating system abstraction and protection layer with the teachings of Collins and Gautier.” Pet. 16 (citing Ex. 1003 ¶¶ 105–111). Petitioner argues Collins’ fonts can be

installed “into the operating system’s font manager,” but Collins “does not provide explicit details regarding integrating its extended browser with an operating system.” *Id.* at 16–17 (citing Ex. 1005, 37:64–38:3). Petitioner cites to Schaefer for the details of how to deliver applications “on the fly” to an operating system. *Id.* at 17 (citing Ex. 1009, 1:9–11; Ex. 1003 ¶ 105).

Further, Petitioner cites to Collins teaching that font installation can occur on different operating systems, such as “Windows and Macintosh computers.” Pet. 17 (citing Ex. 1005, 42:11–14). Petitioner notes that “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.* (citing Ex. 1009, 8:63–67, 9:1–48).

Citing the Zadok Declaration, Petitioner argues a person of ordinary skill would also have been motivated to “incorporate Schaefer’s abstraction layer teachings with Collins’s browser extension to allow Collins’s font extension to be installed and used uniformly in different operating systems.” Pet. 17 (citing Ex. 1003 ¶ 107). Petitioner concludes that “[t]his approach furthers the goal of uniform presentation of web content (fonts included) on any web browser, regardless of the client’s operating system or form factor (e.g., desktop, laptop, or hand-held).” *Id.* (citing Ex. 1003 ¶ 107).

7. Patent Owner’s Arguments

Patent Owner does not contest Petitioner’s showing regarding the claim limitations of the ’093 patent. As already discussed, Patent Owner contends that Schaefer is not prior art to the ’093 patent. PO Resp. 8–52. As also already discussed, Patent Owner argues that a proper construction of “directory” excludes the cache of Collins. *Id.* at 59–71.

Patent Owner also argues that the '093 patent “disavows the proprietary font format combined with ‘character shape player’ and ‘character shape recorder’ set forth in Collins.” PO Resp. 52–56. Therefore, Patent Owner argues Collins teaches away from the use of “original fonts,” teaching away from the claims of the '093 patent. *Id.* at 56–59.

According to Patent Owner, “none of the claims of the '093 patent should be construed to include” a “character shape player” or a “character shape recorder.” PO Resp. 52–56. Patent Owner alleges this is a disavowal of claim scope. *Id.*

Last, Patent Owner objects to the Board’s “denial of permission to present electronic files as evidence, see Exhibit 2090.” PO Resp. 71. This objection is based on the false premise that we denied the filing of electronic files. As Exhibit 2090 shows, we authorized the filing subject to limitations of our P-TACTS filing system. Ex. 2090, 1. The objection lacks legal basis, is factually wrong, and no relief is requested.

a. Whether the '093 Patent Disavows the Teachings of Collins

Patent Owner argues “[t]he '093 patent disavows the proprietary font format combined with ‘character shape player’ and ‘character shape recorder’ set forth in Collins. Thus, none of the claims of the '093 patent should be construed to include those features that are taught or suggested by Collins.” PO Resp. 52. The alleged disavowal appears in the “Relevant Technology” section of the '093 patent. *Id.* at 53 (citing Ex. 1001, 2:29–63, *see, e.g., id.* at 2:29–35 (“The document builder then creates a new font description (hereinafter called a ‘proprietary vector font description’) for the input text with the aid of a character shape recorder.”)). Patent Owner contends “th[e] disavowed solution is precisely the solution described by Collins.” *Id.* (citing Ex. 1005, 5:58–6:11, 9:24–40, 9:55–67).

A second disavowal is alleged during prosecution of a related application, where Patent Owner argued “that applets provided by the server to the client via download are used to output and/or display fonts . . . instead of using regular font reading and outputting programs of the client.” PO Resp. 54 (citing Ex. 2069,²⁷ 183). Patent Owner also cites to claim amendments made during prosecution of the ’421 patent adding “‘a program module of the operating system’ uses the ‘external font files’ to display the characters.” *Id.* (citing Ex. 2069, 174).

Patent Owner concludes that “using separately downloaded computer programs for font rendering rather than the operating system’s font rendering capabilities” was disavowed. PO Resp. 54. Thus, according to Patent Owner, the use of “an externally downloaded ‘character shape player’” was disavowed and is not within the scope of the claims. *Id.* (citing Ex. 1005, 46:9–13). Patent Owner’s Sur-Reply amplifies the difference between the ’093 patent’s use of the operating system to render characters and Collins’ requirement of “something other than ‘the operating system’ to render the fonts.” PO Sur-Reply 12–13 (citing Ex. 1001, 3:10–14, 21–25, 3:30–37).

In addition, Patent Owner argues a disavowal may occur without an express concession of disavowal. PO Resp. 55 (citing *Techtronic Indus. Co. v. ITC*, 944 F.3d 901, 907 (Fed. Cir. 2019)). This type of disavowal is based on the ’093 patent’s statement that “[o]ne of the unique benefits of the present invention is that once font files 312 are enabled on browsing computer 204, the characters within font files 312 can be used the same as any of the font characters originally loaded on the browsing computer 204.”

²⁷ File history of US Pat. No. 9,886,421 (“’421 patent”).

Id. (citing Ex. 1001, 14:30–34) (emphasis omitted). Patent Owner contends Collins is therefore not relevant because Collins creates “new font descriptions” and does not use “predefined font descriptions.” *Id.* (citing Ex1005, 5:58–6:12).

Petitioner responds that the standard applied to determine whether claim scope is disavowed is “***clear and unequivocal evidence*** that the claimed invention includes or does not include a particular feature.” Pet. Reply 9 (citing *Cisco Sys., Inc. v. ITC*, 873 F.3d 1354, 1361 (Fed. Cir. 2017)). Patent Owner disputes the standard, alleging any “disavowal must be clear, but it need not be explicit” and “[d]isavowal may be inferred” PO Sur-Reply 13–14 (citing *Techtronic Indus. v. ITC*, 944 F.3d at 907). Petitioner also argues the disavowal is to unclaimed features, specifically “the ability to copy rendered fonts for use in other applications.” Pet. Reply 10 (citing Ex. 1001, 2:29–63, 14:30–34).

Concerning the written description portions of the ’093 patent that Patent Owner relies on, Petitioner argues that criticism of “prior art character shape players as inefficient is irrelevant.” Pet. Reply 11 (citing Ex.1001, 2:53–62). Petitioner argues that criticism “of a particular embodiment . . . is not sufficient to rise to the level of clear disavowal.” *Id.* (citing *Thorner v. Sony Comput. Ent. Am. LLC*, 669 F.3d 1362, 1366 (Fed. Cir. 2012); *Epistar Corp. v. ITC*, 566 F.3d 1321, 1334–1335 (Fed. Cir. 2009)).

With respect to Patent Owner’s prosecution arguments, Petitioner responds that they are irrelevant because that are “not used to distinguish the claimed invention over the prior art.” Pet. Reply 11–12 (citing *Grober v. Mako Prods. Inc.*, 686 F.3d 1335, 1342 (Fed. Cir. 2012) (no disavowal “if the applicant simply describes features of the prior art and does not distinguish the claimed invention based on those features”)).

b. Collins Teaches Away

Patent Owner argues that “Collins confirms that his invention was to create ‘new font descriptions’ that are based on ‘predefined font descriptions’ on one computer, then transfer the ‘new font description’ (not the ‘predefined font descriptions’) to a second computer, then translate the ‘new font descriptions’ into a language supported by the second computer.” PO Resp. 58. According to Patent Owner, “Collins expressly discourages transferring the predefined font descriptions” which is what the ’093 patent teaches. *Id.* Patent Owner argues the ’093 patent supports the preceding by stating that a “‘unique benefit[] of the present invention’ is that ‘the characters within font files 312 can be used the same as any of the font characters originally loaded on browsing computer 204.’” *Id.* (citing Ex. 1001, 14:30–34). In contrast, Patent Owner asserts “Collins requires translating its PFR into another software language after the fonts are transferred to the second computer.” *Id.* (emphasis omitted).

Petitioner responds that “Collins does not teach away from the claimed invention because the single paragraph [Patent Owner] cites is not ‘commensurate in scope with the ultimate claims at issue.’” Pet. Reply 12 (citing Ex. 1005, 3:24–33; *Idemitsu Kosan Co. v. SFC Co.*, 870 F.3d 1376, 1381–1382 (Fed. Cir. 2017)). Petitioner argues neither Collins nor the ’093 patent teach sending all fonts, rather, the formatting information may be “for only one character,” “a group of characters,” or “a complete font,” where the group of characters selected is “typically *less than the entire font*.” *Id.* at 12–13 (citing Ex. 1001, 10:29–35, cls. 1–21; Ex. 1071 ¶¶ 67–73).

Patent Owner argues in response that Collins “taught away from sending ‘a copy of all fonts’ or ‘predefined font descriptions’ and taught toward sending ‘new font descriptions and a proprietary interpreter.’” PO

Sur-Reply 14 (citing PO Resp. 56–57). According to Patent Owner, “[t]his explicitly teaches away from Adamson’s inventions.” *Id.*

8. Discussion

Patent Owner argues Schaefer is not prior art and the combination of Collins, Gautier, and Schaefer cannot establish unpatentability of any of claim of the ’093 patent. For reasons discussed previously, we determine that Patent Owner has not met its burden to shown prior invention.

Alternatively, Schaefer was argued as an alternative to Collins and is not necessary for Petitioner’s showing. *See* Section III.D.4 above.

We construed the “installation module” limitation above. *See* Section III.B.1 above. Our construction determined that cache memory of Collins falls within the scope of the installation module limitation. Specifically, a cache memory may be a temporary font directory. *Id.*

a. Disavowal

We first consider whether the claims of the ’093 patent should be construed to “include those features that are taught or suggested by Collins.” *See* PO Resp. 52. Both parties argue the issue as one of disavowal of claim scope rather than of claim construction. *Id.*; Pet. Reply 10 (citing *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1306 (Fed. Cir. 2011). A disavowal must be clear, but it need not be explicit, and a disavowal may be inferred. *Techtronic*, 944 F.3d at 907.

We are not persuaded that a discussion of “Relevant Technology” supports a disavowal of claim scope. The context of the alleged disavowal is that “attempts have been made to ensure that electronic documents made with non-standard fonts are displayed on a reader’s computer in the same form.” Ex. 1001, 2:9–11. In this context, the alleged disavowal from the Specification is that the “document builder then creates a new font

description (hereinafter called a ‘proprietary vector font description’) for the input text with the aid of a character shape recorder.” *Id.* at 2:29–35.

The facts here are different from *Techtronic*, where the specification clearly stated a straightforward solution to the problem identified. *Techtronic*, 944 F.3d at 908. The citations to the ’093 patent Specification do not clearly disavow creating new font descriptions; instead they are described as one attempt to display non-standard fonts. *See* Ex. 1001, 2:29–35; *see also* Pet. Reply 10 (citing *Retractable Techs.*, 653 F.3d at 1306 (Fed. Cir. 2011) (“statements about the difficulties and failures in the prior art, without more, do not act to disclaim claim scope”)).

Patent Owner argues Collins required something other than “the operating system” to render the fonts, citing column 5 of Collins which states, in part, that new font descriptions are installed onto a computer’s operating system. PO Resp. 52–53 (citing *inter alia* Ex. 1005, 5:58–61); *see also* PO Sur-Reply 12–13 (citing PO Resp. 52). We do not find these statements to clearly disavow a new font description.

Ambiguity in the Specification “cannot support a clear and unmistakable disavowal.” *See* Pet. Reply 10 (citing *CUPP Computing AS v. Trend Micro Inc.*, 53 F.4th 1376, 1382 (Fed. Cir. 2022) (no disclaimer “where the alleged disavowal is ambiguous, or even amenable to multiple reasonable interpretations”) (internal quotation marks omitted)). The ’093 patent does not clearly disavow “the ability to copy rendered fonts for use in other applications.” *See* Ex. 1001, 2:45–61 (describing second computer receiving input text and noting “the proprietary vector font description is not standard to a reader's operating system.”)).

As to the prosecution history arguments, we find that “PO’s arguments, the inventor’s claim amendments adding the term ‘program

module’ to the ’421 patent independent claims 1, 6, and 11 does not exclude the use of a separately downloaded computer program for font rendering from the ’093 patent claims.” See Pet. Reply 11 (citing Ex. 2069, 174, 176, 178). We also find that the ’093 patent claims do not require a “program module” but instead recites the operating system rendered characters. Patent Owner does not respond to Petitioner’s Reply. *Id.*; see also generally PO Sur-Reply.

b. Teaching Away

Turning to Patent Owner’s teaching away arguments, Patent Owner relies on statements in the institution decision in another *inter partes* review proceeding to allege that “the Board has already held that Collins criticizes the solution in the ’421 patent claims (which on this point are very similar to the ’093 patent claims).” PO Resp. 57 (citing *CoStar Realty Information, Inc. and Duolingo, Inc. v. Clantech, Inc.*, IPR2022-00799, Paper 14 (PTAB Nov. 25, 2002) (“’799 IPR”), 11; *In re Brandt*, 886 F.3d 1171, 1178 (Fed. Cir. 2018)). While the statement of the law from *Brandt* is correct, the citation to the ’799 IPR is not relevant here. What is cited in the ’799 IPR is a preliminary statement in an institution decision describing Collins.

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.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) (quoting *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that

was taken by the applicant.” *Id.* (quoting *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2004)).

We are not persuaded that the Petition relies on “translation” of fonts, rather than the operating system, to render the “non-standard font.” *See* Pet. 34 (citing Ex. 1003 ¶¶ 151–159). On this record, the Zadok Declaration supports Petitioner’s position that Collins’ teaching that the processes of GetAndDisplayPfrs and InstallPfrs “expose at least a portion of the font file to an operating system.” Indeed, the Zadok Declaration includes testimony, supported by evidence of record, that a user can “opt to have the browser obtain and install the intended fonts associated with a document by setting a parameter GetIntendedFonts.” Ex. 1003 ¶ 154 (citing Ex. 1005, 37:46–53). The Zadok Declaration also explains the PFR fonts can be called from the operating system by calling the entire HTML document. *Id.* ¶ 157 (citing Ex. 1005, 41:29–31).

9. Claims 2–5, 7–10, and 14–21

The above discussion relates to independent claim 1. Independent claims 10 and 18 and dependent claims 2–5, 7–9, 14–17, and 19–21 are not separately argued. *See generally* PO Resp. Having considered the complete trial record, we find that the arguments and evidence identified in the Petition sufficiently show that claims 2–5, 7–10, 14–21 are unpatentable. *See* Pet. 38–54; Ex. 1003 ¶¶ 79–227.

10. Summary Ground 1

For the foregoing reasons, we determine that Petitioner makes a sufficient showing that the combination of Collins, Gautier, with or without Schaefer, teaches or suggests all the limitations of claims 1–5, 7–10, and 14–21, and that a person of ordinary skill in the art would have combined the references in the manner asserted. Accordingly, we determine that the

information presented shows by a preponderance of the evidence that claims 1–5, 7–10, and 14–21 are unpatentable as obvious over the combined teachings of Collins and Gautier, and Collins, Gautier, and Schaefer.

E. Obviousness of Claims 6 and 11–13 Over Collins, Gautier, Schaefer, and Parthasarathy (Ground 2)

Petitioner alleges claims 6 and 11–13 would have been obvious over Collins, Gautier, Schaefer, and Parthasarathy. Pet. 2, 55–63. Petitioner also relies on the Zadok Declaration. Ex. 1003 ¶¶ 230–247.

1. Collins (Ex. 1005), Gautier (Ex. 1008), Schaefer (Ex. 1009)

Collins, Gautier, and Schaefer were described respectively in Sections III.D.1, 2 and 3 above.

2. Parthasarathy (Ex. 1006)

Parthasarathy is related to “automatically downloading, verifying, installing, registering and displaying computer software components from computer networks like the Internet or an intranet.” Ex. 1006, 1:12–16. “Almost any software component can be downloaded, verified, and installed via the described method and system, whether it is an ActiveX™ Control, a Netscape™ ONE Plugin, a Java™ class library, a multimedia player, a document viewer, or a custom control or applet for inclusion on a digital form or a digital document.” *Id.* at 3:15–21. Parthasarathy discloses a method and system “used by applications (e.g., network browsers, network servers) to automatically download and install software components from code depositories on computer networks (e.g., the Internet, or local corporate intranets) to provide dynamic and truly interactive multimedia to a user.” *Id.* at 3:22–27.

Figure 2 of Parthasarathy is reproduced below.

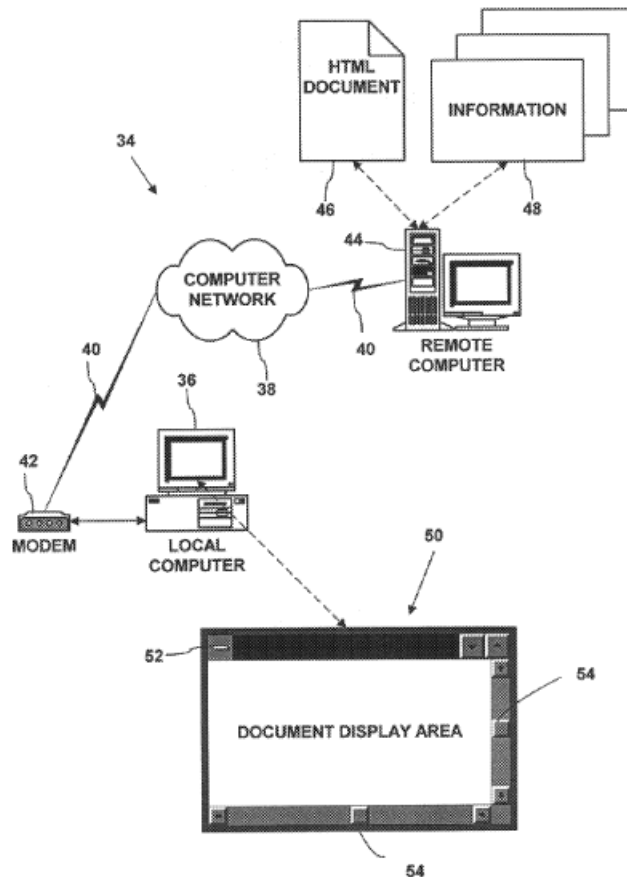


FIG. 2

Figure 2 is a block diagram illustrating a network browsing environment.

Ex. 1006, 4:1–2. Figure 2 shows browsing environment 34, wherein a local computer 36 runs software (referred to herein as a “browser”) for “unified browsing of electronic documents and other data from local sources” like memory system 16 and computer network 38 (e.g., the Internet, an intranet). *Id.* at 6:44–50.

3. Analysis of Claims 6 and 11

Claim 6 depends from claim 1, reciting “wherein the browser automatically exposes the at least a portion of the font file to the operating

system using at least in part one or more of: a plugin, a browser extension, or an Active X Control.” Claim 11 is identical but depends from claim 10.

Petitioner argues Collins “**extends** HTML ‘to include tags which specify the fonts which are intended to be used in the display of HTML text.’” Pet. 61 (citing Ex. 1005, 27:11–13). Petitioner argues this suggests that a person of ordinary skill in the art would have “been motivated to provide Collins’ browser extension as a separate downloadable file, as taught by Parthasarathy.” *Id.* at 61–62 (citing Ex. 1006, 3:15–21 (ActiveX disclosed in linking references to network objects); Ex. 1003 ¶¶ 243–245).

Petitioner alleges that Collins’ use of non-standard HTML tags would have motivated a person of ordinary skill in the art “to use Parthasarathy’s techniques in Collins to address the problems highlighted by Parthasarathy.” Pet. 58 (citing Ex. 1006, 2:36–41, 2:61–64; Ex. 1003 ¶ 237). In addition, Petitioner alleges a person of ordinary skill in the art “would have been further motivated to store Collins’ browser extension as a file that can be downloaded when a browser encounters an “<OBJECT> tag in a dynamic font document to permit more efficient and flexible updating of browser functionality.” *Id.* at 59 (citing Ex. 1003 ¶ 238).

Patent Owner does not provide a response to Petitioner’s analysis of claims 6 and 11. Having considered the complete trial record, we determine that Petitioner has established by a preponderance of the evidence that the combined teachings of Collins, Gautier, Schaefer, and Parsarathy, and Collins, Gautier, and Parsarathy account for all of the limitations recited in claims 6 and 11. Pet. 5–62.

4. Analysis of Claims 12 and 13

Claims 12 and 13 both depend from claim 11 and recite, the same subject matter as claim 4. Claim 12 is identical to claim 4 and claim 13 is

identical to claim 15. Patent Owner does not provide a response to Petitioner's analysis of claims 12 and 13.

Having considered the complete trial record, and for the reasons set forth in Section III.D above, we determine that Petitioner has established by a preponderance of the evidence that the combined teachings of Collins, Gautier, Schaefer, and Parsarathy, and Collins, Gautier, and Parsarathy account for all of the limitations recited in claims 12 and 13. Pet. 62–63.

5. Summary Ground 2

On this record and for the foregoing reasons, we determine that Petitioner makes a sufficient showing that the combination of Collins, Gautier, Schaefer, and Parthasarathy teaches or suggests all the limitations of claims 6 and 11–13, and that a person of ordinary skill in the art would have combined the references in the manner asserted. We determine that the argument and evidence establish by a preponderance of the evidence that claims 6 and 11–13 would have been obvious over the combined teachings of Collins, Gautier, Schaefer, and Parthasarathy or of the same combination without Schaefer.

IV. PATENT OWNER'S MOTION TO EXCLUDE

Patent Owner moves to exclude Exhibits 1011, 1013–1016, 1018, 1020–1027, 1029–1034, 1036–1039, 1041–1053, 1064–1065, 1067–1070. Mot. 3. Patent Owner moves to exclude portions of Exhibits 1003 and 1071. *Id.*

A. Exhibits 1011, 1013–1016, 1018, 1020–1027, 1029–1034, 1036–1039, 1041–1053, 1064–1065, and 1067–1070 as lacking authentication and as hearsay.

Patent Owner moves to exclude Exhibits 1011, 1013–1016, 1018, 1020–1027, 1029–1034, 1036–1039, 1041–1053, 1064–1065, and 1067–1070 as lacking authentication and as hearsay. Mot. 4–11.

Exhibit 1011 is the same as Patent Owner’s Exhibit 2071. The objection is overruled and the Motion is denied as inconsistent with Patent Owner’s reliance on the same exhibit.

Exhibits 1068, 1069, and 1070 are relied upon in the Zadok Reply Declaration in support of the opinion that a cache can be a directory and “can also include just a catalog for filenames.” Ex. 1071 ¶¶ 14–25. We did not rely solely on these exhibits or the Zadok Reply Declaration in determining a cache can be a directory. As such, we *dismiss* the Motion as moot as to Exhibits 1068, 1069, and 1070.

We do not rely upon the remaining exhibits and, as to those exhibits, and *dismiss* the Motion as moot.

*B. Zadok Declarations Reliance on
Objected to Exhibits (Exs. 1003 and 1071)*

Patent Owner moves to exclude portions of the Zadok Declaration and Reply Declaration as relying on unauthenticated exhibits discussed in Section IV.A above. Mot. 11–12.

To the extent the Zadok Declaration and Reply Declaration separately rely on the exhibits referenced in Section IV.A above, the objection is overruled and the Motion is *denied*. Although there is no testimony that they are documents that might be reasonably relied upon by experts, neither is there any testimony that they are not. In addition, we agree that the totality of the circumstances support Dr. Zadok’s reliance on them. Opp. 5–

6 (citing Fed. R. Evid. 901(b)(4); *New World Med., Inc. v. Microsurgical Tech., Inc.*, IPR2020-01573, Paper 63 at 6 (PTAB Feb. 16, 2022)).

C. Zadok Declarations Rely on Modern Computers

Patent Owner moves to exclude the Zadok Declaration and Reply Declaration as relying on the functionality present in modern computers. Mot. 13–15.

The Zadok Declaration makes clear at several points that the testimony is based on “how a person of ordinary skill in the art would have understood the claims of the ’093 patent *at the time of the alleged invention*, which I have been asked to assume is the 2001 timeframe.” Ex. 1003 ¶ 5 (emphasis added). We do not find that his reference to “modern computers” is anything more than imprecision in his testimony that we determine as harmless.

The objection is overruled and the Motion is *denied*.

D. Zadok Declarations Lack Support

Patent Owner moves to exclude the Zadok Declaration and Reply Declaration as lacking proper support. Mot. 16–17.

Patent Owner’s objection does not specify what opinions lack proper support. *See* Opp. 10–11; Paper 59 (“Patent Owner Objections Pursuant to 37 C.F.R. § 42.64(B)(1)”). The Motion is based on the objection and cannot remedy this deficiency. Regardless, we give the opinions such weight as we deem appropriate and will consider the support identified in making that assessment.

The objection is overruled and the Motion is *denied*.

E. Zadok Reply Declaration as Beyond the Scope of Proper Reply Evidence

Patent Owner moves to exclude the Zadok Reply Declaration as exceeding the scope of proper reply evidence. Mot. 17.

Patent Owner does not persuade us that any of the Zadok Reply Declaration is beyond the scope of a proper reply. A listing of paragraphs that are alleged to be beyond the scope does not establish that the Reply Declaration exceeded the scope. *See* Mot. 17 (citing “Ex. 1071 ¶¶ 9–16, 17–19, 24–25, 27–30, 34, 36–39, 44, 45, 50–53, 55, 57, 61–66, etc.”). It is Patent Owner’s responsibility to make specific objections.

The objection is overruled and the Motion is *denied*.

V. CONCLUSION

For the reasons discussed above, Petitioner has shown by a preponderance of the evidence that claims 1–5, 7–10, 14–21 would have been obvious over the combination of Collins, Gautier, and Schaefer or Collins and Gautier without Schaefer. Petitioner has also shown by a preponderance of the evidence that claims 6 and 11–13 would have been obvious over the combination of Collins, Gautier, Schaefer, and Parthasarathy.

VI. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–21 of the '093 patent are determined to be unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Exclude (Paper 66) is dismissed as moot or *denied*; and

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

In summary:

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1–5, 7–10, 14–21	103	Collins, Gautier, Schaefer	1–5, 7–10, 14–21	
6, 11–13	103	Collins, Gautier, Schaefer, Parthasarathy	6, 11–13	
Overall Outcome			1–21	

IPR2022-00800
Patent 9,892,093 B1

FOR PETITIONER:

Inge A. Osman
Gregory K. Sobolski
Diane E. Ghrist
Ann Marie Wahls
B. Thomas Watson
LATHAM & WATKINS LLP
inge.osman@lw.com
greg.sobolski@lw.com
diane.ghrist@lw.com
annmarie.wahls@lw.com
thomas.watson@lw.com

FOR PATENT OWNER:

Perry S. Clegg
JOHNSON & MARTIN, P.A.
pclegg@johnsonmartinlaw.com

Andrew Baca
TRASKBRITT P.C.
ajbaca@traskbritt.com