

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

WILDSEED MOBILE LLC,
Patent Owner

U.S. Patent No. 10,869,169

IPR2023-00247

**PETITION FOR *INTER PARTES* REVIEW
UNDER 35 U.S.C. § 312 AND 37 C.F.R. § 42.104**

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Petitioner's Exhibit List

Ex.1001	U.S. Patent No. 10,869,169
Ex.1002	Prosecution History of U.S. Patent No. 10,869,169
Ex.1003	Declaration of Henry Houh under 37 C.F.R. § 1.68
Ex.1004	<i>Curriculum Vitae</i> of Henry Houh
Ex.1005	U.S. Patent No. 8,645,211 to Rothschild (“Rothschild”)
Ex.1006	U.S. Patent No. 6,839,411 to Saltanov (“Saltanov”)
Ex.1007	U.S. Patent No. 6,836,792 to Chen (“Chen”)
Ex.1008	U.S. Patent Publication No. 2002/0002502 to Maes (“Maes”)
Ex.1009	RFC 1738 (December 1994)
Ex.1010	RFC 1866 (November 1995)
Ex.1011	HTML Specification 4.01
Ex.1012	WO2001008020A1 to Tsai (“Tsai”)
Ex.1013	Federal Trial Court Statistics
Ex.1014	Complaint for Patent Infringement, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 6:21-cv-01245 (W.D. Tex. Dec. 1, 2021)
Ex.1015	Amended Complaint, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 6:22-cv-00357 (W.D. Tex. May 9, 2022)
Ex.1016	Voluntary Dismissal, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 6:21-cv-01245 (W.D. Tex. Apr. 4, 2022)
Ex.1017	Complaint for Patent Infringement, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 6:22-cv-00357 (W.D. Tex. Apr. 4, 2022)
Ex.1018	Amended Complaint, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 6:21-cv-01245 (W.D. Tex. Feb 28, 2022)
Ex.1019	Transfer Order, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 6:22-cv-00357 (W.D. Tex. Apr. 4, 2022)

Ex.1020	Joint Case Management Statement, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 3:22-cv-04928 (N.D. Cal. Nov. 29, 2022)
Ex.1021	Civil Minutes, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 3:22-cv-04928 (N.D. Cal. Nov. 29, 2022)

I. INTRODUCTION

U.S. Patent No. 10,869,169 (the “’169 Patent,” Ex.1001) is generally directed to the concept of sending a “hot link” by e-mail, text message (SMS), or instant message. The “hot link” described in the ’169 patent may be displayed as “a virtual button, icon, symbol, or some other user interface associated with the device receiving the hot link.” Ex.1001, 2:15-17. The hot link “instructs the receiving device to perform some action upon activation of the hot link.” Ex.1001, 7:27-28. This action may be, for example, “to obtain and render a web page in a web browser.” Ex.1001, 18:60-61.

However, such hot links were well-known and existed in various forms before the filing of the ’169 patent. *See* Ex.1005, 1:26-27. For example, Rothschild describes a system that allows users to insert an interactive advertisement into an e-mail, SMS, or instant message that is sent to another user. *See* Ex.1005, 8:6-11. The interactive advertisement is displayed as a “graphic” or “icon” that can be interacted with. *See* Ex.1005, 8:22-25. Interaction with the advertisement causes the recipient’s device to retrieve additional data from a web site. *See* Ex.1005, 5:8-16. For the reasons explained below, the concept of sending a hot link to other users was well-known at the time the ’169 patent was filed.

Accordingly, pursuant to 35 U.S.C. §§ 311, 314(a), and 37 C.F.R. § 42.100, Petitioner Google LLC respectfully requests that the Board review and cancel

claims 1-22 (“the Challenged Claims”) of the ’169 patent as unpatentable under (pre-AIA) 35 U.S.C. §103(a).

II. GROUNDS FOR STANDING

Petitioner certifies that the ’169 Patent is eligible for IPR and Petitioner is not barred or estopped from requesting IPR challenging the claims. 37 C.F.R. § 42.104(a).

III. THE ’169 PATENT

A. Summary of the ’169 Patent

The ’169 patent generally “relates to providing a method and system for generating and sending a hot link to a device.” Ex.1001, 1:66-67. “The hot link contains an action that instructs the receiving device to perform some activity when an associated user interface is selected.” Ex.1001, 2:1-3. In one example, the hot link includes “instructions to obtain and render a web page in a web browser.” Ex.1001, 18:60-61; *see also* 13:54-14:5.

In the ’169 patent, the user sends a hot link message to one or more recipients. The hot link message may be “a Short Message Service (SMS) message, an instant messaging (IM) message, or an email message.” Ex.1001, claim 5. After receiving the hot link message, the receiving user may interact with the hot link within the hot link message to cause the associated action to be performed: “The hot link may direct the device receiving the hot link to perform

some action.” Ex.1001, 2:6-7.

The ’169 patent also claims various user interface features that were well-known at the time the ’169 patent was filed. For example, claim 19 recites basic user interface elements for forwarding a message. Claim 20 recites user interface elements for providing positive or negative feedback about content. As will be explained in detail below, each of the claim limitations of the Challenged Claims is rendered obvious by the prior art. Ex.1003, ¶¶21-24.

B. Prosecution History of the ’169 Patent

The ’169 patent was filed on December 12, 2017, and through a chain of continuations, claims priority to a provisional application (Ex.1010) filed May 10, 2001.¹ In a first office action, the claims were rejected with various combinations of U.S. Patent No. 6,411,685 to O’Neal (“O’Neal”), U.S. Patent No. 6,473,609 to Schwartz (“Schwartz”), and U.S. Patent Publication No. 2003/0187811 to Chang (“Chang”). Ex.1002, 217-30. To overcome this rejection, the Applicant amended the claims to include limitations related to a “trigger,” arguing that the prior art did not teach “in response to detection of the trigger, determine an action to be performed upon activation of the hot link based on the trigger.” Ex.1002, 210. The

¹ Petitioner does not concede that the ’169 patent is entitled to this earliest priority date.

Examiner was not persuaded and maintained the rejections. Ex.1002, 182-96.

The Applicant then further amended the claims to recite that the hot link message includes “instructions for rendering and displaying the hot link at each of the set of user devices.” Ex.1002, 161-66. After further prosecution, the Office issued a notice of allowance. Ex.1002, 43-49. The Examiner’s stated reasons for allowance were as follows:

The closest prior art of record (O’Neal et al., U.S. Patent No. 6411685) does not teach nor suggest in detail identifying a trigger to generate a hot link; in response to detection of trigger, determine an action to be performed upon activation of the hot link based on the trigger wherein the activation of the hot link causes user devices to execute a program code to perform the action and generate the hot link message to include the determined action and instructions for rendering and displaying the hot link at each set of user devices.

Ex.1002, 48.

As will be explained below, the prior art shows that each of the claim limitations of the ’169 patent, particularly those added during prosecution, were already known at the time of filing.

IV. LEVEL OF ORDINARY SKILL IN THE ART

A POSITA on and before May 11, 2001 would have had a working knowledge of the software and communication arts pertinent to the ’169 patent. A POSITA would have had a bachelor’s degree in computer science, computer

engineering, or an equivalent, and two years of work experience in the field of communications and software. Lack of professional experience can be remedied by additional education, and vice versa. Ex.1003, ¶¶18-20.

V. CLAIM CONSTRUCTION

In an IPR, claims are construed “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b). The Board only construes the claims to the extent necessary to resolve the underlying controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017). Petitioner submits that for the purposes of this proceeding and given the prior art being advanced by Petitioner, the terms of the Challenged Claims should be given their plain and ordinary meaning, and no terms require specific construction.² Ex.1003, ¶25.

VI. RELIEF REQUESTED AND THE REASONS FOR THE REQUESTED RELIEF

Petitioner asks that the Board institute a trial and cancel the challenged claims as unpatentable in view of the analysis below.

² Petitioner does not concede that any term in the challenged claims meets the statutory requirements of 35 U.S.C. § 112.

VII. THE BOARD SHOULD INSTITUTE INTER PARTES REVIEW

A. The *Fintiv* factors favor institution

The six factors considered for § 314 denial strongly favor institution. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). On June 21, 2022, Director Vidal issued a Memorandum on how the Board should apply the *Fintiv* factors (“*Fintiv* Guidance”). The Director’s *Fintiv* Guidance and the *Fintiv* factors weigh in favor of institution.

The ’169 patent was first asserted against Petitioner in the Western District of Texas in a complaint filed December 1, 2021. *See* Ex.1014. Patent Owner filed an amended complaint on February 28, 2022. *See* Ex.1018. Patent Owner then voluntarily dismissed the amended complaint on April 4, 2022. *See* Ex.1016.

On that same day, April 4, 2022, Patent Owner filed another complaint in the Western District of Texas asserting the ’169 patent (and others). *See* Ex.1017. Patent Owner filed an amended complaint on May 9, 2022. *See* Ex.1015.

After Petitioner filed its answer, the parties subsequently agreed to transfer the case to the Northern District of California. The court ordered the transfer on August 29, 2022, thereby opening the case in the Northern District of California. *See* Ex.1019. Thus, the district court case remains at an early stage. Petitioner has diligently prepared and filed this petition.

1. Factor 1 is neutral (Possibility of a Stay).

No party has requested a stay pending of the co-pending district court litigation pending the outcome of this IPR. Accordingly, the Board should not infer the outcome of such motion. *See Dish Network L.L.C. v. Broadband iTV, Inc.*, IPR2020-01359, Paper 15 at 11 (PTAB Feb. 12, 2021) (“improper to speculate” what district court “might do regarding a motion to stay” when a stay had not yet been requested). Without “specific evidence” of how the court would rule on any stay motion, this factor is neutral. *Sand Revolution II, LLC v. Cont’l Intermodal Grp.—Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative).

2. Factor 2 favors institution (proximity of trial date to final written decision).

This factor favors institution and weighs strongly against discretionary denial.

As of the filing of the petition, the Northern District of California has adopted a schedule only through claim construction and has not set a trial date. Ex.1020.

Further, because of the uncertainties of court schedules, the PTAB weighs the median time-to-trial of the relevant court. *See Fintiv* Guidance, 8-9. Here, the median time-to-trial in the Northern District of California is 34.7 months. *See*

Ex.1013. Based on these statistics, notwithstanding the parties’ proposed trial dates, trial would occur approximately in June 2025 (as calculated from the case opening in the Northern District of California) or February 2025 (as calculated from the April 2022 complaint in the Western District of Texas). In either case, the Board’s Final Written Decision would be issued well before any trial.

3. Factor 3 favors institution (investment in parallel proceeding).

This factor, which focuses on work completed “at the time of the institution decision,” strongly favors institution. *Fintiv*, IPR2020-00019, Paper 11, 9–10. This factor is not about the total investment by the court and parties, but the investment “in the merits of the invalidity positions.” *Sand Revolution*, IPR2019-01393, Paper 24 at 10 (emphasis added). As of the filing of this Petition, the Northern District of California has adopted a scheduling order through claim construction, setting the claim construction hearing for July 14, 2023, which would be after an estimated June 2023 institution decision. *See* Ex.1020, 1021; *PEAG*, IPR2020-01214, Paper 8 at 17 (minimal investment in the invalidity positions in the Petition weighs against discretionary denial); *see also Verizon Bus. Network Servs. Inc. v. Huawei Techs. Co. Ltd.*, IPR2020-01080, Paper 11 at 13-14 (Jan. 14, 2021) (finding “minimal” investment when parties had not submitted dispositive briefing on validity issues); *Fintiv*, IPR2020-00019, Paper 11 at 10 (“If, at the time of the

institution decision, the district court has not issued orders related to the patent..., this fact weighs against exercising discretion to deny institution.”).

4. Factor 4 favors institution (overlap in issues).

There is no present overlap of prior art issues due to the early stage of district court litigation. Although Petitioner served its preliminary invalidity contentions in the second Texas proceeding, no final invalidity contentions were filed. Moreover, the parties have proposed that Petitioner serve Invalidity Contentions according to Northern District of California Patent Local Rule 3-3 on March 3, 2023. Thus, at this time there is no overlap in issues between the district court and PTAB. Consequently, this factor favors institution.

5. Factor 5 is neutral (overlap in parties).

Petitioner is a defendant in the litigation. That is true of most Petitioners in IPR proceedings. Accordingly, this factor should not be a basis for denying institution.

6. Factor 6 favors institution (other circumstances).

The grounds of unpatentability presented in the Petition are strong, which favors institution. *See Fintiv*, IPR2020-00019, Paper 11 at 14-15 (“[I]f the merits of a ground raised in the petition seem particularly strong on the preliminary record, this fact has favored institution.”). The Petition demonstrates that the prior

art discloses the very features that the examiner found to be allowable over the art considered during prosecution.

7. The Board should institute under the Director’s *Fintiv* Guidance

The Director’s *Fintiv* Guidance strongly supports institution of this challenge. Under the *Fintiv* Guidance, the Board “will not deny institution of an IPR or PGR under *Fintiv* [] when a petition presents compelling evidence of unpatentability.”

The Board should not deny institution because this Petition “presents compelling evidence of unpatentability” of claims 1-22. *See Fintiv* Guidance, 4 (“Compelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence”). For example, the Petition demonstrates that the prior art discloses the claim elements that the examiner found to be allowable over the art considered during prosecution. *See* Section IX. The teachings detailed below “would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence” and thus institution is warranted. *See Fintiv* Guidance, 4.

B. Discretionary Denial Under General Plastic is not Appropriate

The '169 patent has not been challenged in any prior IPR petition, so none of the General Plastic discretionary institution factors apply to this Petition. See *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2016) (Section II.B.4.i. precedential).

C. Discretionary Denial Under 35 U.S.C. § 325(d) is not Appropriate

Denial under § 325(d) is not warranted because the challenges presented in this petition are neither cumulative nor redundant to the prosecution of the '169 patent. None of the prior art asserted in the grounds was presented to or considered by the Examiner during prosecution. Accordingly, under the first part of the *Advanced Bionics* framework, the Board should not deny institution. IPR2019-01469, Paper 6 at 8-9 (PTAB Feb. 13, 2020) (precedential). Moreover, the challenges in this petition are non-cumulative because the art relied upon here teaches the claim elements that the Examiner deemed allowable. *Compare* Ex.1002, 48 *with* Ex.1005.

VIII. IDENTIFICATION OF GROUNDS

The patentability of claims 1-22 is challenged as follows:

No.	Ground
#1	Claims 1-18 and 21-22 are obvious under 35 U.S.C. § 103 over Rothschild.
#2	Claim 19 is obvious under 35 U.S.C. § 103 over Rothschild and Saltanov.
#3	Claim 20 is obvious under 35 U.S.C. § 103 over Rothschild, Saltanov, and Maes.
#4	Claims 1-18 and 21-22 are obvious under 35 U.S.C. § 103 over Rothschild and Chen.
#5	Claim 19 is obvious under 35 U.S.C. § 103 over Rothschild, Chen, and Saltanov.
#6	Claim 20 is obvious under 35 U.S.C. § 103 over Rothschild, Chen, Saltanov, and Maes.

U.S. Patent No. 8,645,211 to Rothschild (“Rothschild,” Ex.1005) was filed January 5, 2001 and issued February 14, 2014. Rothschild is thus prior art to the ’169 patent under 35 U.S.C. § 102(e).

U.S. Patent No. 6,836,792 to Chen (“Chen,” Ex.1007) was filed December 3, 1999 and issued December 28, 2004. Chen is thus prior art to the ’169 patent under 35 U.S.C. § 102(e).

U.S. Patent No. 6,839,411 to Saltanov (“Saltanov,” Ex.1006) was filed March 1, 1999 and issued January 4, 2005. Saltanov is thus prior art to the ’169 patent under 35 U.S.C. § 102(e).

U.S. Patent Publication No. 2002/0002502 to Maes et al. (“Maes”) was filed

April 20, 2001 and issued January 3, 2002. Maes is thus prior art to the '169 patent under 35 U.S.C. § 102(e).

IX. IDENTIFICATION OF HOW THE CLAIMS ARE UNPATENTABLE

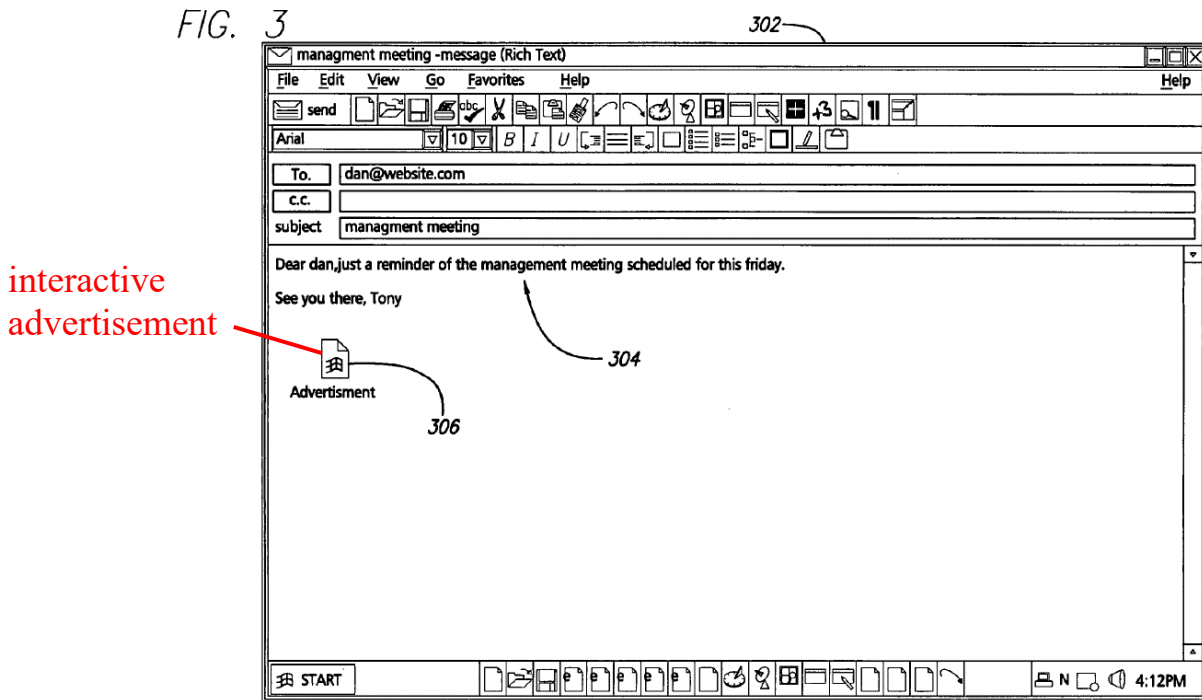
A. Ground 1: Claims 1-18 and 21-22 are obvious under 35 U.S.C. § 103 over Rothschild.

1. Summary of Rothschild

Like the '169 patent, Rothschild relates to sending a message that includes a hot link, which in Rothschild is in the form of an electronic communication (such as an email) with an embedded interactive advertisement that directs users to the advertiser's webpage. In particular, Rothschild describes a "system and method that allows an Internet user to place an advertisement within a personal communication." Ex.1005, 1:26-27. The advertisement may be an interactive advertisement that includes an embedded URL to retrieve data from a website. *See* Ex.1005, 11:57-6:13. "When a recipient interacts with an interactive advertisement, the request data (contained in the advertisement's embedded URL) ... retrieve[s] data from the Web site." Ex.1005, 5:8-16.

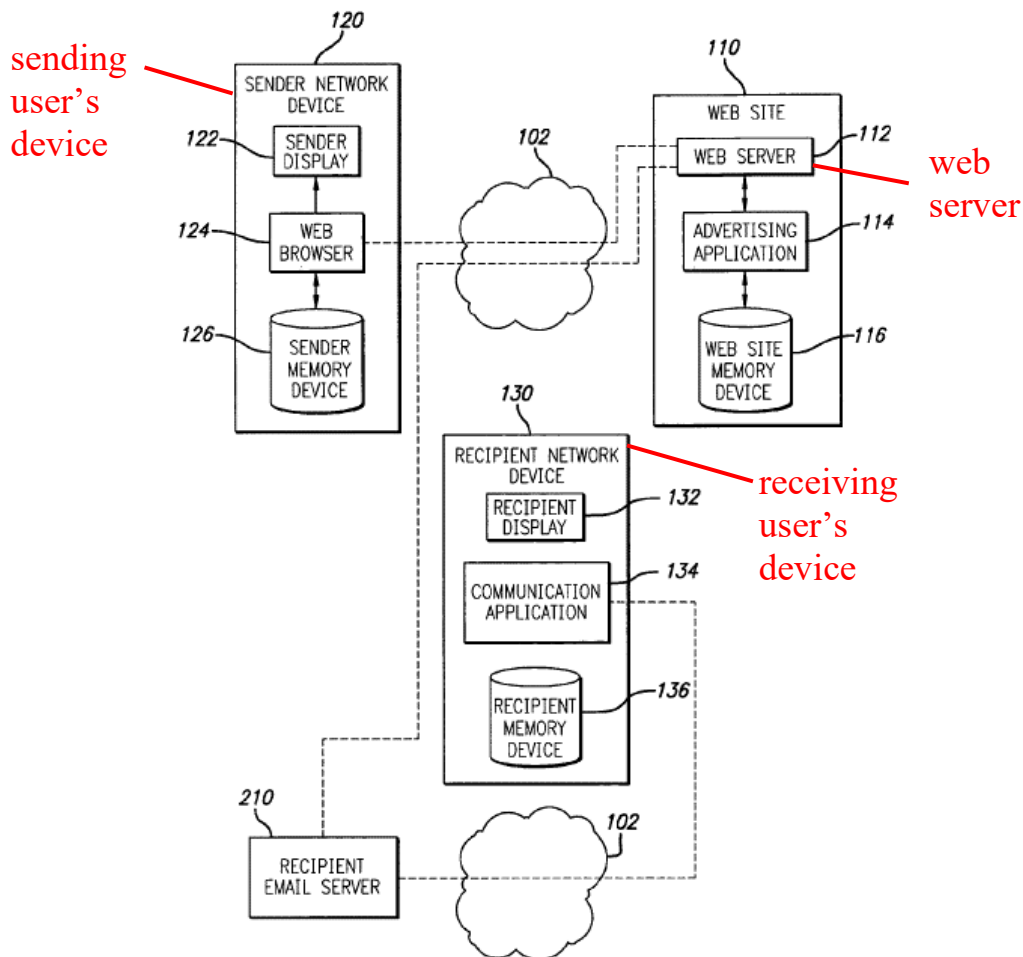
Like the claimed hot link, Rothschild's interactive advertisement may be displayed as "an icon, graphic, text, or voice message that can be interacted with to provide the recipient with additional communication data." Ex.1005, 8:22-25. The "types of additional communication data include, but are not limited to, text data,

graphic data, voice data, video data, and all other types of electronically transmitted data generally known to those skilled in the art.” Ex.1005, 8:27-30.



Ex.1005, Fig. 3 (annotated); Ex.1003, ¶30.

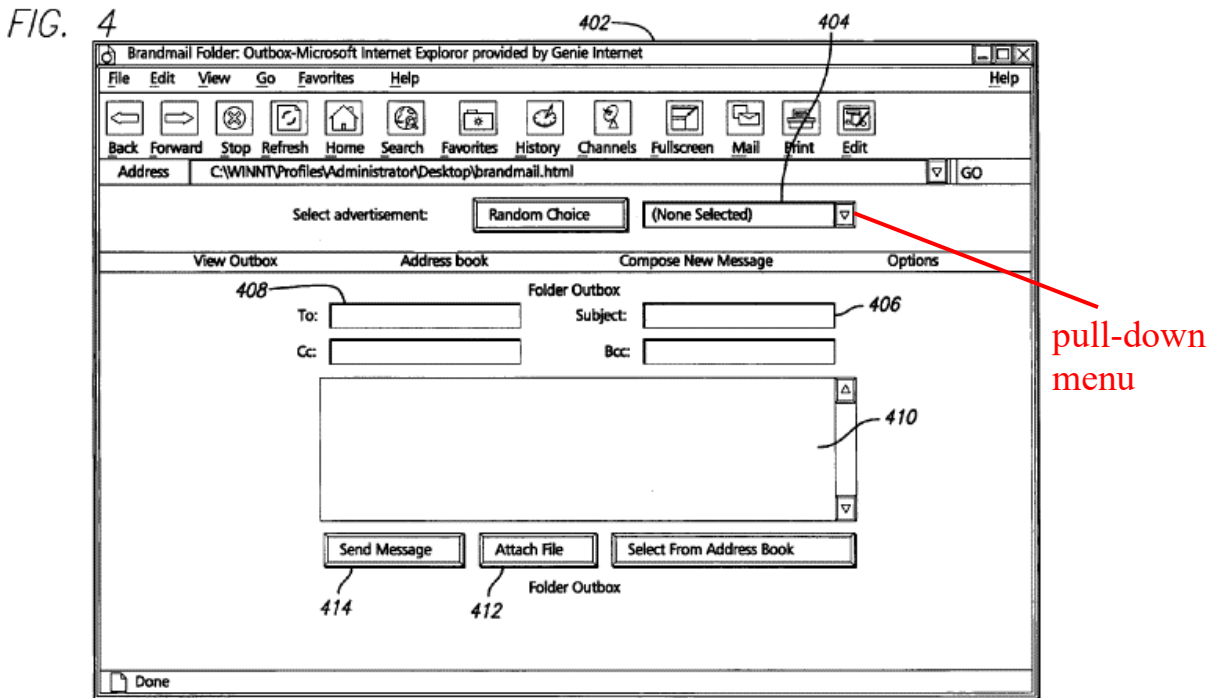
To send a personal communication containing an advertisement to a recipient, the sender accesses a “Web site 110 via the sender network device 120.” Ex.1005, 8:64-66. “Specifically the Web browser 124, operating on the sender network device 120, interfaces over the Internet 102 with the Web server 112, which is operating on the Web site 110.” Ex.1005, 8:66-9:2. “The sender network device 120 is used to send a personal communication, together with a sender-selected advertisement, to the recipient network device 130 via the Web site 110.” Ex.1005, 8:3-6.



Ex.1005, Fig. 2 (annotated); Ex.1003, ¶31.

When users access the web site 110, they are “provided with an e-mail communication page 402, as shown in FIG. 4.” Ex.1005, 9:12-13. “The e-mail communication page 402 provides a recipient space 408 where the sender can designate at least one recipient that will receive the e-mail.” Ex.1005, 9:18-20. “The e-mail communication page 402 further provides a pull down menu 404 for selecting an advertisement that is to be included within the e-mail. The pull down

menu 404 gives the sender the ability to choose an advertisement from a sender created palette of advertisements.” Ex.1005, 9:26-30.



Ex.1005, Fig. 2 (annotated); Ex.1003, ¶32.

When the sending user has identified the recipients and selected the interactive advertisement, “the message data (which includes the selected advertisement) is formatted into a standard e-mail format.” Ex.1005, 11:28-30. Then, “the formatted e-mail is sent to the designated recipient(s).” Ex.1005, 11:32-33. A recipient of the e-mail message may then view and interact with the advertisement to activate the URL and receive additional data from a web site. For example, Rothschild describes an example in which the interactive advertisement pertains to Nike™: “If the recipient interacts with the interactive advertisement, the

recipient will be provided with additional communication data (e.g., graphic, text, audio, video) pertaining to Nike™.” Ex.1005, 8:31-64.

Rothschild is analogous art to the ’169 patent because Rothschild is in the same field of endeavor—telecommunication—as the ’169 patent. *Compare* Ex.1001, 3:59-61 (“The present invention is directed to generating and sending a hot link to a telecommunications device”) *with* Ex.1005, 4:9-14 (explaining that the invention relates to sending a “personal communication” to various types of devices, including a “personal computer” or “mobile phone”).

Accordingly, Rothschild shows that it was known to send messages having “hot links” to other users as described and claimed in the ’169 patent. Ex.1003, ¶¶26-34.

2. Claim 1

[1.0] *One or more non-transitory computer-readable media (NTRM) including program code, wherein execution of the program code by one or more processors of a computer system is to cause the computer system to:*

First, Rothschild describes a web server with hardware and software components (“*non-transitory computer-readable media (NTRM) including program code*”). Rothschild’s “Web Server” includes “**hardware/software** server components that serve information content over a network and the ‘back end’ **hardware/software** components ... that interact with the server component to perform services for Web site users.” Ex.1005, 6:61-67. The web server includes

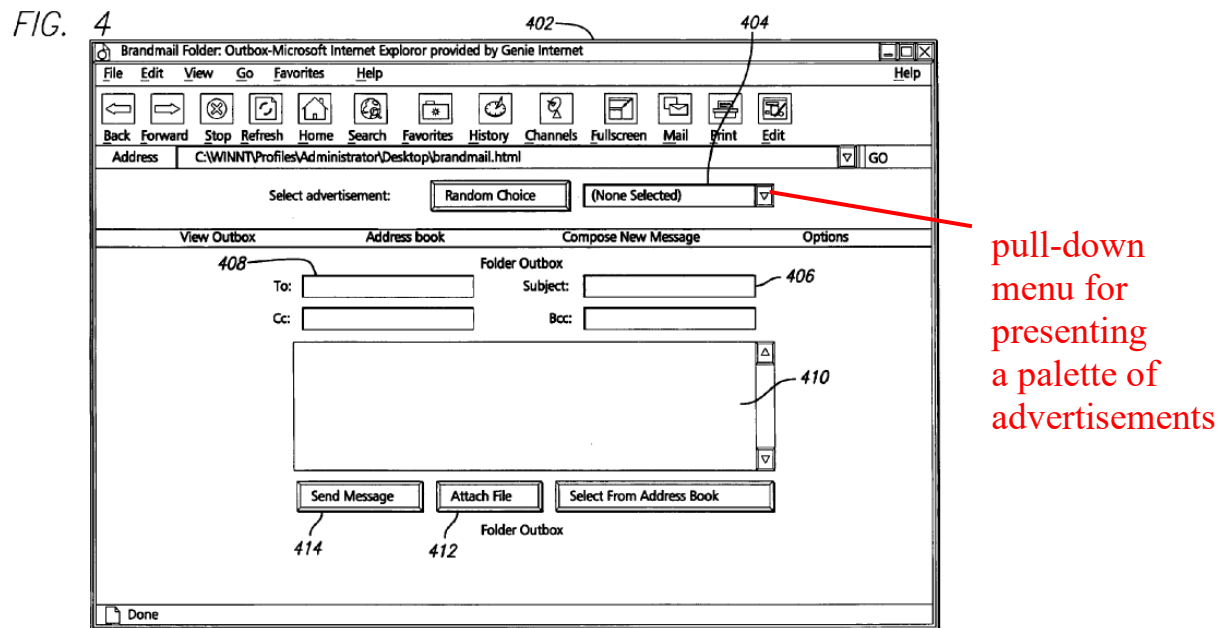
non-transitory computer-readable media in the form of a Web site memory device 116, which may be “long or short term data storage devices, including, but not limited to, RAM, cache memory, flash memory, magnetic disks, optical disks, removable disks, SCSI disks, IDE hard drives, tape drives, smart cards, and all other types of data storage devices (and combinations thereof, such as RAID devices) generally known to those skilled in the art.” Ex.1005, 7:37-8:2.

Second, Rothschild explains that software is executed by a computer hardware device, such as a web server (“*computer system*”). “Within the context of computer hardware and software, an application program is a set of one or more computer programs that performs a function when executed within a computer hardware device.” Ex.1005, 6:38-47. One example of such an application program is “advertising application 114, operating on the Web site 110, [which] permits a sender to create, and send a personal communication containing a sender-selected advertisement to the communication application 134.” Ex.1005, 7:37-8:2.

Thus, because Rothschild describes a web server having a memory device that stores applications that are executed by computer hardware, Rothschild renders obvious “*One or more non-transitory computer-readable media (NTRM) including program code, wherein execution of the program code by one or more processors of a computer system is to cause the computer system to*” as claimed. Ex.1003, ¶¶35-38.

[1.1] identify a trigger to generate a hot link; and

First, Rothschild describes a “*trigger*” for generating an interactive advertisement (“*hot link*”) in the form of a pull-down menu for selecting an interactive advertisement. *See* Ex.1005, 9:11-31.



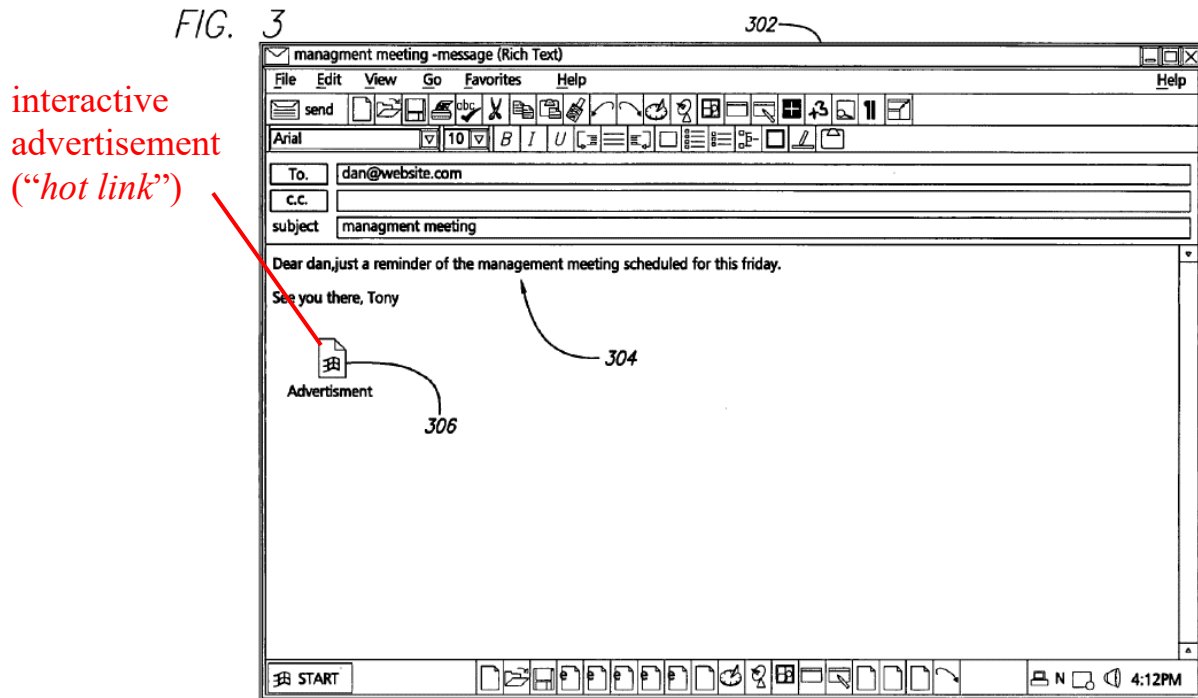
Ex.1005, Fig. 4 (annotated) Ex.1003, ¶41.

Selection of an advertisement from the pull-down menu ultimately *triggers* insertion of the advertisement into an e-mail message. *See* Ex.1005, 9:11-31. When the server receives a compilation of data that includes the user’s advertisement selection, such “data (which **includes the selected advertisement**) is formatted into a standard e-mail format.” Ex.1005, 11:28-30.

Second, Rothschild's server *identifies* the “trigger” when it provides the sending user's device with the e-mail communication page 402 that contains the pull-down menu. Upon request from a user, the server “provides the sender network device with an e-mail communication page (see FIG. 4), enabling the sender to enter ... a selected advertisement that should accompany the completed e-mail.” Ex.1005, 11:5-10. As noted above, the user selects an advertisement from the pull-down menu. Accordingly, because selection of an advertisement through the pull-down menu ultimately triggers insertion of an interactive advertisement into an e-mail, Rothschild's server “*identif[ies] a trigger for generating a hot link*” when it presents the selection mechanism (e.g., pull-down menu) through the web communication page 402.

Third, Rothschild's interactive advertisement teaches a “hot link” as claimed because interaction with the interactive advertisement causes an action to be performed. Rothschild's interactive advertisement is displayed as a “graphic” or “icon” that can be interacted with. *See* Ex.1005, 8:22-25. Interaction with the advertisement causes the recipient's device to retrieve additional data from a web site. *See* Ex.1005, 5:8-16. This is analogous to the “hot link” as described in the '169 patent, which may be displayed as “a virtual button, icon, symbol, or some other user interface associated with the device receiving the hot link.” Ex.1001, 2:15-17. The hot link “instructs the receiving device to perform some action upon

activation of the hot link.” Ex.1001, 7:27-28. This action may be, for example, “to obtain and render a web page in a web browser.” Ex.1001, 18:60-61.



Ex.1005, Fig. 3 (annotated); Ex.1003, ¶44.

Thus, because Rothschild’s web server presents a pull-down menu with a list of interactive advertisements that, when selected by the user, cause an email (having an interactive advertisement with an embedded URL) to be created, Rothschild renders obvious “*identify a trigger to generate a hot link*” as claimed. Ex.1003, ¶¶39-44.

Rothschild’s server also “*identif[ies] a trigger to generate a hot link*” when it receives the user’s selection of an advertisement from the pull-down menu. After

the user selects an advertisement, Rothschild's server "receives the compilation of data, which includes message data, sender data, and **advertisement data**."

Ex.1005, 11:14-16. Then, "the message data (which includes the selected advertisement) is formatted into a standard e-mail format." Ex.1005, 11:28-30.

Because receipt of the user's selection prompts the server to insert the selected advertisement ("*hot link*") into the e-mail message ("*hot link message*"), receipt of the user's selection identifies a trigger to generate the e-mail message and interactive advertisement therein. For this reason as well, Rothschild renders obvious "*identify a trigger to generate a hot link*" as claimed. Ex.1003, ¶45.

[1.2] *in response to detection of the trigger, determine an action to be performed upon activation of the hot link based on the trigger,*

When the server receives the user's advertisement selection ("*detection of the trigger*"), Rothschild's server determines an action to be performed by placing the selected interactive advertisement—along with its embedded URL—into the e-mail message. Ex.1005, 9:26-31. The URL helps define "the action to be performed" by defining the location of data on the Internet from where additional data is retrieved when the receiving user interacts with the interactive advertisement to follow the URL.

As explained above, when the recipient of the email message activates the interactive advertisement, the embedded URL is used to cause the recipient's

device to retrieve additional information (e.g., graphic, text, audio, video pertaining to the advertised product) from a web site. *See* Ex.1005, 11:57-12:13; 8:31-64. Furthermore, because retrieval of additional information (“*action to be performed upon activation of the hot link*”) is defined by the sending user’s selection of the advertisement (“*trigger*”), retrieval of additional information is “*based on the trigger*” as claimed.

A POSITA also would have recognized that various characteristics of the URL define “*the action to be performed*” by specifying the type of application that will perform the action associated with the URL. Ex.1003, ¶49. For example, industry standards (as explained in RFC 1738, Ex.1009) indicate that “http” specifies Hypertext Transfer Protocol and thus invokes a web browser. Ex.1009, 4. Thus, the nature of the URL itself defines “*an action to be performed*” as claimed.

Thus, because Rothschild’s system receives a selected advertisement from the user, and in response generates an e-mail message with an interactive advertisement when activated by the user, causes an action to retrieve additional information to be performed, Rothschild renders obvious “*in response to detection of the trigger, determine an action to be performed upon activation of the hot link based on the trigger*” as claimed. Ex.1003, ¶¶46-50.

[1.3] wherein activation of the hot link by individual user devices of a set of user devices is to cause the individual user devices to execute program code to perform the action;

As explained above at [1.1], the interactive advertisement (“*hot link*”) includes an embedded URL that when activated, causes the recipient’s system to retrieve additional data. *See* Ex.1005, 11:57-12:13. “When a recipient interacts with an interactive advertisement, the request data (contained in the advertisement's embedded URL) calls to the data processing layer. The data processing layer uses the request data (which may contain message data that is linked to sender data and advertisement data) to retrieve data from the Web site memory device.” Ex.1005, 5:8-16.

Accordingly, a POSITA would have found it obvious that the application (e.g., a web browser) of the recipient’s device that obtains additional information from a web site executes program code when doing so. Indeed, Rothschild explains that “an application program is a set of one or more computer programs that performs a function when executed within a computer hardware device.” Ex.1005, 6:39-41.

Thus, because Rothschild describes that the receiving user can interact with an advertisement to activate the URL, which causes program code to execute to retrieve data from a web site, Rothschild renders obvious “*wherein activation of the hot link by individual user devices of a set of user devices is to cause the individual user devices to execute program code to perform the action*” as claimed. Ex.1003, ¶¶51-53.

[1.4] generate a hot link message to include the determined action and instructions for rendering and displaying the hot link at each of the set of user devices; and

First, Rothschild's server generates a hot link message when the web server formats the message data into an e-mail that contains the selected interactive advertisement. "At step 516 the message data (which includes the selected advertisement) is formatted into a standard e-mail format. The formatted e-mail's reply-to address is changed, at step 518, to reflect the senders e-mail address that was provided by the sender upon registration." Ex.1005, 10:65-11:33. Accordingly, by formatting the message data into an e-mail message containing the interactive advertisement, the web server "*generates a hot link message*" as claimed.

Second, the e-mail includes the selected interactive advertisement, which includes the embedded URL (which defines "*the determined action*" as explained at [1.2]). See Ex.1005, 11:63-65 ("The location of the additional communication data (or a pointer to the data) is contained in a URL embedded within the interactive advertisement").

Third, the selected interactive advertisement can be displayed as "an icon, graphic, text, or voice message that can be interacted with to provide the recipient with additional communication data." Ex.1005, 8:3-30. Rothschild explains that graphic data can be in a variety of forms, including "JPEG, GIF, or any other

generally recognizable graphical format.” Ex.1005, 13:41-42. Given that Rothschild describes an interactive advertisement that is displayed with a graphic and includes an embedded URL, a POSITA would have recognized that such interactive advertisement would be implemented using HTML. Ex.1003, ¶58. Indeed, using HTML to implement advertisements within e-mail messages was well-known to POSITAs. *See e.g.*, Ex.1007 (Chen), 2:37-54 (describing inserting advertisements into e-mail using HTML as “conventional”). Rothschild also mentions “Hotmail” as an example e-mail service. *See* Ex.1005, 2:26-36. POSITAs would have recognized that such browser-based e-mail applications relied on HTML. Ex.1003, ¶58.

A POSITA would have understood that an HTML implementation of an embedded URL in an interactive advertisement displayed as a graphic, text, GIF, or other form described by Rothschild would include HTML tags (“*instructions*”) that define how the embedded URL is displayed within the interactive advertisement. An example HTML code is shown below:

```
<a href=“URL”>  
<img src= “graphic.jpg”>  
</a>
```

See Ex.1010, 35; Ex.1011, 179; Ex.1003, ¶59.

In this example, the URL—which is the location where the additional information is located—is displayed to the user as a graphic defined by the JPEG

file graphic.jpg. In this manner, the URL is embedded in the interactive advertisement, which appears to the user as the image file “graphic.jpg.” *See* Ex.1003, ¶60 (citing Ex.1011, 179). Accordingly, a POSITA would have found it obvious for Rothschild’s interactive advertisement, which is sent in the e-mail (“*hot link message*”), to include HTML code that acts as “*instructions for rendering and displaying a hot link.*” Ex.1003, ¶60.

Additionally, the data representing the icon or graphic are “*instructions for rendering and displaying the hot link*” because the data (e.g., JPEG file) informs the receiving device how to display the graphic or icon.

Thus, because Rothschild’s web server formats an e-mail message which includes the interactive advertisement that defines how it is to be displayed, Rothschild renders obvious “*generate a hot link message to include the determined action and instructions for rendering and displaying the hot link at each of the set of user devices*” as claimed. Ex.1003, ¶¶54-62.

[1.5] *control transmission of the hot link message to the set of user devices.*

Rothschild’s web server transmits the e-mail message (“*hot link message*”) with the interactive advertisement to the recipients (“*set of user devices*”): “At step 520, the formatted e-mail is sent to the designated recipient(s).” Ex.1005, 11:30-33.

Thus, because Rothschild's web server transmits the formatted e-mail message to the designated recipients, Rothschild renders obvious "*control transmission of the hot link message to the set of user devices*" as claimed.

Ex.1003, ¶¶63-64.

3. Claim 2

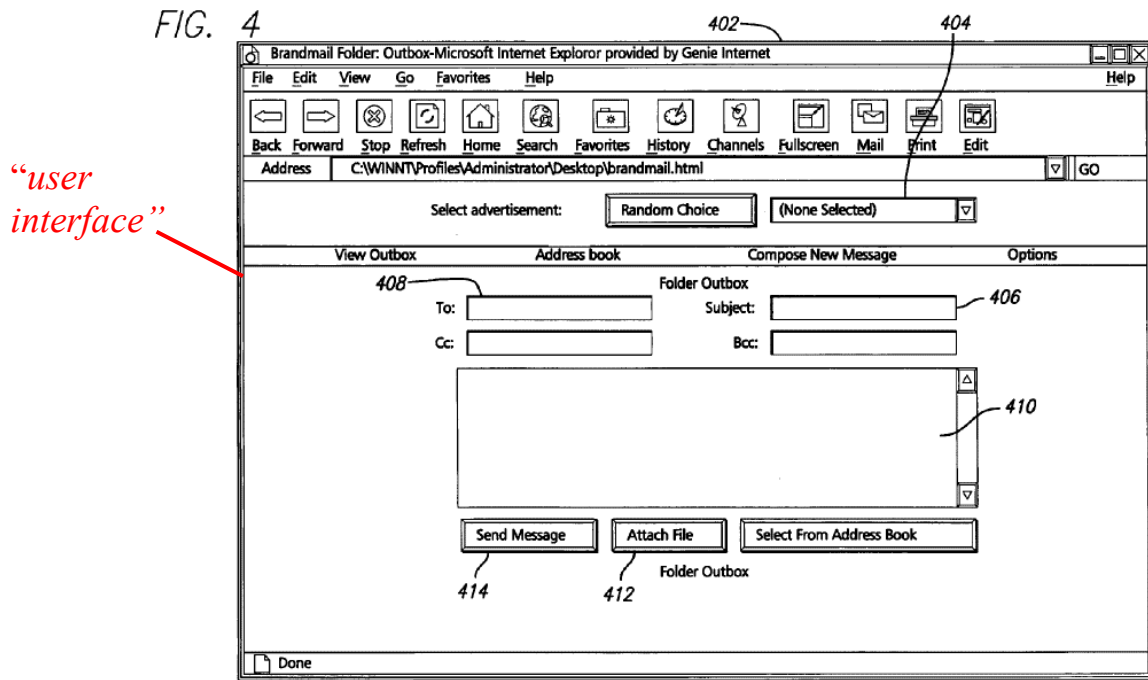
[2.0] *The one or more NTCRM of claim 1, wherein the individual user devices are second user devices, and execution of the program code is to cause the computer system to:*

See [1.0]. Ex.1003, ¶65.

[2.1] *provide a user interface to a first user device to be rendered and displayed by the first user device, the user interface comprising one or more graphical control elements to control selection of users associated with the set of second user devices; and*

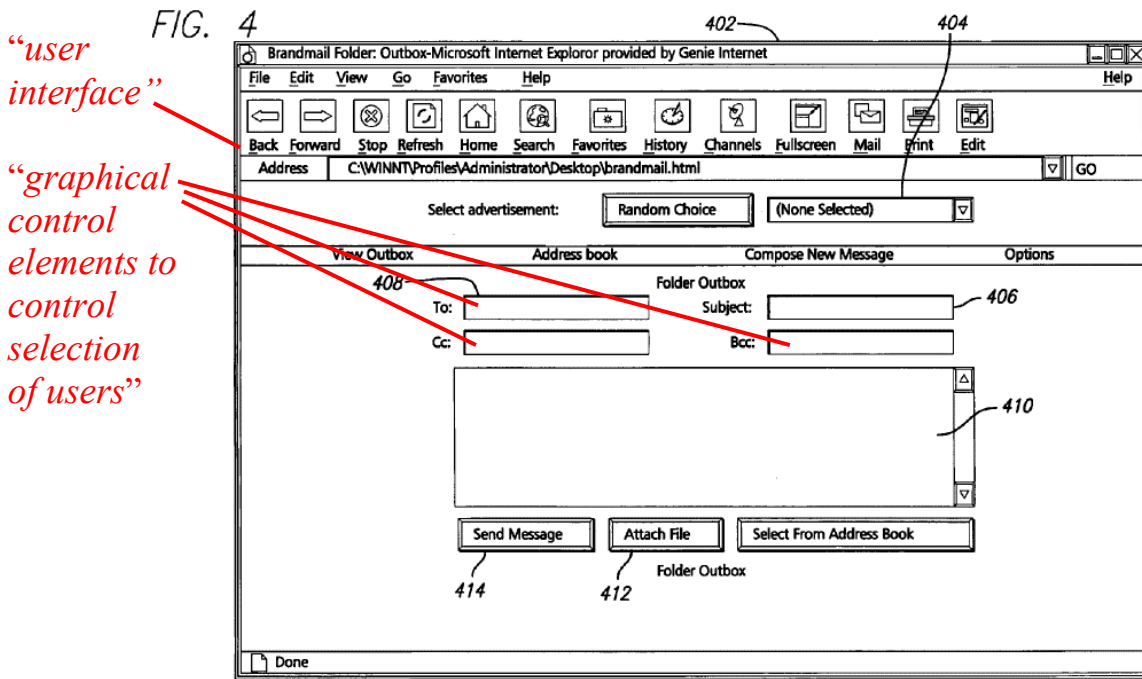
First, Rothschild describes how the web server provides an e-mail communication page 402 to the sender's device. As explained above, when a user desires to send an e-mail with an interactive advertisement, the user accesses a website: "Specifically the Web browser 124, operating on the sender network device 120, interfaces over the Internet 102 with the Web server 112, which is operating on the Web site 110." In other words, the web browser on the sender's device receives data from the Web site 110 for displaying an "e-mail communication page 402" ("*user interface*"). Ex.1005, 9:13. In this manner, the

web server provides “a user interface to a first user device to be rendered and displayed by the first user device.”



Ex.1005, Fig. 4 (annotated); Ex.1003, ¶66.

Second, the “e-mail communication page 402 provides a recipient space 408 where the sender can designate at least one recipient that will receive the e-mail.” Ex.1005, 9:18-20. The recipient spaces teaches “one or more graphical control elements to control selection of users associated with the set of second user devices.” Because a POSITA would have recognized that recipients receive e-mail messages through an electronic device, the recipients are “users associated with the set of second user devices.” Ex.1003, ¶68.



Ex.1005, Fig. 4 (annotated); Ex.1003, ¶67.

Thus, because the sender's device is provided with a web page that allows the user to select designated recipients, Rothschild renders this limitation obvious. Ex.1003, ¶¶66-69.

[2.2] control receipt, from the first user device, of a request to generate a hot link along with identification information of the set of second user devices to receive the hot link.

As explained above at [1.1], a user who desires to send an e-mail with an interactive advertisement (“hot link”) to one or more recipients does so by accessing a Web site 110. See Ex.1005, 9:11-31, 11:1-33. In particular, by accessing the web site and identifying a set of recipients, the user is providing to

the web server, a “request to generate a hot link along with identification information of the set of second user devices to receive the hot link.”

After the user has designated recipients, Rothschild’s server “receives the compilation of data, which includes message data, sender data, and advertisement data.” Ex.1005, 11:14-16. A POSITA would have understood that the web server receives, in this example, e-mail addresses of the designated recipients (“identification information of the set of second user devices to receive the hot link”). A POSITA would have understood that in the other examples listed by Rothschild—such as “text messages, SMS messages, chat-room messages, instant messaging messages, video messages, voice messages”—a different type of destination address would be used (e.g., phone number, user identification, etc.). Ex.1003, ¶72. Because these destination addresses are associated with recipient devices or users associated with those devices, the destination addresses provided to the web page 402 are “identification information of the set of second user devices to receive the hot link.”

Thus, because Rothschild’s web server presents communication page 402 to the user and receives a list of recipients from the sending user, Rothschild renders this limitation obvious. Ex.1003, ¶¶70-72.

4. Claim 3

[3.1] The one or more NTCRM of claim 2, wherein the information of the set of

user devices comprises a selection of one or more users associated with the set of user devices or a selection of a group of users associated with the set of user devices.

As explained above at [2.1], the “e-mail communication page 402 provides a recipient space 408 where the sender can designate **at least one recipient that will receive the e-mail**” (“a selection of one or more users associated with the set of user devices”). Ex.1005, 9:18-20.

Thus, because Rothschild describes that the web server presents communication page 402 to, among other things, receive a list of recipients from the sending user, Rothschild’s renders this limitation obvious. Ex.1003, ¶¶73-74.

5. Claim 4

[4.1] The one or more NTCRM of claim 1, wherein execution of the program code is to cause the computer system to: generate the hot link message to include an indication about the hot link, wherein the indication about the hot link comprises text, multimedia, or a link pointing to a resource that includes information about the hot link.

Rothschild renders this claim obvious in various ways. In one example, text within Rothschild’s interactive advertisement is an “*indication about the hot link.*” Rothschild explains that if an advertisement includes text, “the advertising application 114 allows the advertiser the option of typing in the textual information that makes up the advertisement. Alternatively, the advertiser can upload the advertisement data (e.g., text, icon, graphic, audio).” Ex.1005, 13:21-43. A POSITA would have understood that “textual information that makes up the

advertisement” is an “*indication about the hot link*” as claimed. Ex.1003, ¶76.

Indeed, the claim language explicitly recites “text” as one example of what is included in the term “indication:” “*wherein the indication about the hot link comprises text, multimedia, or a link pointing to a resource that includes information about the hot link.*”

Additionally, the URL embedded within the interactive advertisement teaches “*an indication about the hot link.*” The claim explicitly recites that the indication may be a “*link pointing to a resource that includes information about the hot link.*” As explained above at [1.1] and [1.2], the URL embedded within Rothschild’s interactive advertisement is used to retrieve additional communication data. *See* Ex.1005, 8:31-64.

Thus, because Rothschild explains that the interactive advertisement includes textual information and a URL that make up the advertisement, and the interactive advertisement is placed within an e-mail message, Rothschild renders obvious “*wherein execution of the program code is to cause the computer system to: generate the hot link message to include an indication about the hot link, wherein the indication about the hot link comprises text, multimedia, or a link pointing to a resource that includes information about the hot link*” as claimed. Ex.1003, ¶¶75-78.

6. Claim 5

[5.0] *The one or more NTCRM of claim 4, wherein execution of the program code is to cause the computer system to:*

See [4.1]. Ex.1003, ¶79.

[5.1] *generate the hot link message as a Short Message Service (SMS) message, an instant messaging (IM) message, or an email message.*

Rothschild describes its technique with the example of an e-mail message, but states that it is applicable to other forms of communication including SMS messages and instant messages: “It should be appreciated that a personal communication can include, but is not limited to, an e-mail message, text message, short message service (SMS) message, chat-room message, instant messaging message, video message, voice message, and any other personalized network communications generally known to those skilled in the art.” Ex.1005, 8:6-11.

Thus, Rothschild renders obvious “*generate the hot link message as a Short Message Service (SMS) message, an instant messaging (IM) message, or an email message*” as claimed. Ex.1003, ¶¶80-81.

7. Claim 6

[6.0] *The one or more NTCRM of claim 1, wherein execution of the program code is to cause the computer system to:*

See [1.0]-[1.4]. Ex.1003, ¶82.

[6.1] *identify a user interface element for activation of the hot link prior to generation of the hot link; and*

First, consistent with the discussion at [1.4], the hot link is “*generated*” when the e-mail message containing the hot link is formatted.

Second, prior to the creation and formatting of the e-mail message, the user selects an advertisement for placement within the message. As explained above at [1.1], the hot link includes an embedded URL. As also explained in [1.4], “[a]n interactive advertisement is an **icon, graphic, text**, or voice message that can be interacted with to provide the recipient with additional communication data.” Ex.1005, 8:21-24. A POSITA would have understood that the text or graphic that the user interacts with to activate the URL is a “*user interface element for activation of the hot link*”. See also Ex.1005, 8:31-63; Ex.1003, ¶84. Further, to generate the hot link with the icon, graphic, or text, a POSITA would have understood that such icon, graphic, or text would need to be identified prior to generating the hot link. Ex.1003, ¶85.

Thus, because Rothschild’s server identifies an icon, graphic or text that is used to generate the hot link, Rothschild renders obvious “*identify a user interface element for activation of the hot link prior to generation of the hot link*” as claimed. Ex.1003, ¶¶83-86.

[6.2] *generate the hot link message to include assignment information, the assignment information to assign the hot link to the identified user interface element.*

Rothschild explains that an interactive advertisement is displayed in the form of graphic, texts, or icons. As explained above at [6.1], such graphics or text are a “*user interface element*” as claimed. A POSITA would have understood that data contained within an e-mail messages that associates the graphic, text, or icon with the advertisement is “*assignment information to assign the hot link to the identified user interface element.*” Ex.1003, ¶¶87-88.

In the case where the interactive advertisement is provided through HTML, the HTML lines that are used to assign the graphic to the interactive advertisement is “*assignment information to assign the hot link to the identified user interface element*”. In the example above, the HTML lines , , and assign the user interface element graphic.jpg to the interactive advertisement. *See* Ex.1011, 179. Ex.1003, ¶89.

Thus, because Rothschild describes that an interactive advertisement is comprised of advertisement data, such as text or graphics, that is assigned to the interactive advertisement, and the advertisement data is used to generate the interactive advertisement, Rothschild renders obvious “*generate the hot link message to include assignment information, the assignment information to assign the hot link to the identified user interface element*” as claimed. Ex.1003, ¶90.

8. Claim 7

[7.1] *The one or more NTCRM of claim 1, wherein the hot link comprises*

instructions to obtain and render a web page in a web browser, execute executable instructions of an application program, or adjust radiofrequency circuitry to obtain and display broadcasted content.

As explained above, the interactive advertisement (“*hot link*”) includes instructions to obtain and render a web page in a web browser. Rothschild explains that the recipient device 130 includes a communication application, which “may be a Web browser.” Ex.1005, 7:51. A POSITA would have found it obvious for the recipient device to obtain the data from the URL through use of a web browser, as that is a common way to retrieve additional data from a web site. Ex.1003, ¶92. As Rothschild explains, “[t]he location of the additional communication data (or a pointer to the data) is contained in a URL embedded within the interactive advertisement.” Ex.1005, 11:57-12:13. “If the recipient interacts with the interactive advertisement, the recipient will be provided with additional communication data (e.g., graphic, text, audio, video).” Ex.1005, 8:47-50. “The additional communication data can contain advertisement data, entertainment data, educational data, or any other type of data made available to the Web site.” Ex.1005, 8:60-63. Rothschild explicitly mentions that the additional data may be a “populated communication page.” Ex.1005, 10:29.

Thus, because Rothschild’s interactive advertisement includes an embedded URL, which instructs a web browser to obtain and display additional information, Rothschild renders obvious “*wherein the hot link comprises instructions to obtain*

and render a web page in a web browser, execute executable instructions of an application program, or adjust radiofrequency circuitry to obtain and display broadcasted content” as claimed. Ex.1003, ¶¶91-93.

9. Claim 8

[8.0] *The one or more NTCRM of claim 1, wherein execution of the program code is to cause the computer system to:*

See claim 1. Ex.1003, ¶94.

[8.1] *determine a location for each user device of the set of user devices; and*

Consistent with well-known e-mail functionality, a POSITA would have recognized that Rothschild’s server determines the e-mail address for each recipient through the provided recipient space 408: “The e-mail communication page 402 provides a recipient space 408 where the sender can designate at least one recipient that will receive the e-mail.” Ex.1005, 9:18-20; *see also* Ex.1005, Fig. 4 (showing “To” and “Cc” fields); Ex.1003, ¶95. An email address is consistent with how the ’169 patent uses the term “location”: “The location may be a network address, a telephone number, a frequency, or some other information uniquely identifying the location of the device receiving the hot link message.” Accordingly, the e-mail addresses of the recipients of Rothschild’s e-mail message are “locations” as claimed.

Thus, Rothschild's server receives the recipient email addresses from the sending user, Rothschild renders this limitation obvious. Ex.1003, ¶¶95-96.

[8.2] *generate the hot link message to include the location of each user device.*

As explained above at [1.4], a "hot link" is generated when "the message data (which includes the selected advertisement) is formatted into a standard e-mail format." Ex.1005, 11:28-30. A POSITA would have understood that in standard e-mail formatting, each recipient is provided in the e-mail message under either the "To" field or the "Cc" field. *See e.g.*, Ex.1005, Fig. 3; Ex.1003, ¶97.

Thus, because a POSITA would have recognized that Rothschild's e-mail would include the e-mail addresses of each of the recipients, Rothschild renders this limitation obvious. Ex.1003, ¶98.

10. Claim 9

[9.0] *The one or more NTCRM of claim 1, wherein, to control transmission of the hot link message to the set of user devices, execution of the program code is to cause the computer system to:*

See claim 1. Ex.1003, ¶99.

[9.1] *instruct a network interface of the computer system to send the hot link message to the set of user devices over a wired or wireless network.*

First, Rothschild's web server includes the hardware components for transmitting data over the Internet ("*network interface*"). In particular, Rothschild's

web server includes “hardware/software server components that serve information content over a network.” Ex.1005, 6:61-67.

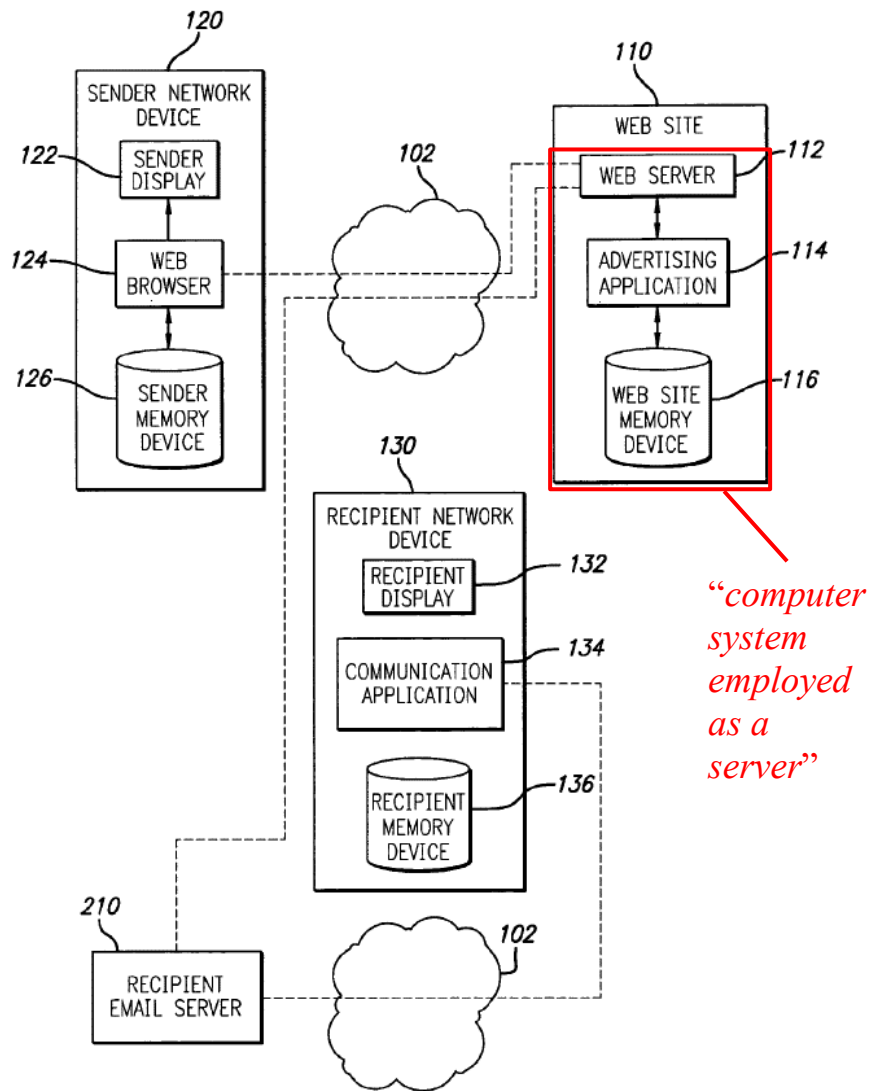
Second, as explained above at [1.5], Rothschild’s web server transmits the e-mail message that includes the interactive advertisement (“*hot link*”) over a network. “The sender network device, the recipient network device, and the Web site are coupled together on a communication network, such as, the Internet, local area network, wide area network.” Ex.1005, 7:11-14.

Thus, because Rothschild’s web server includes hardware components for transmitting an email with the interactive advertisement over a network, Rothschild renders obvious “*instruct a network interface of the computer system to send the hot link message to the set of user devices over a wired or wireless network*” as claimed. Ex.1003, ¶¶100-02.

11. Claim 10

[10.0] *A computer system to be employed as a server, the computer system comprising:*

Rothschild describes a web server 112 associated with a website (“*computer system to be employed as a server*”). Rothschild describes a Web site that is realized by a “Web server 112, an advertising application 114, and a Web site memory device 116” as shown in Fig. 2 below. Ex.1005, 7:37-8:2.



Rothschild, Fig. 2 (annotated); Ex.1003, ¶103.

Thus, because Rothschild describes a web server, Rothschild renders obvious a “*computer system to be employed as a server*” as claimed. Ex.1003, ¶¶103-04.

[10.1] *network interface circuitry to:*

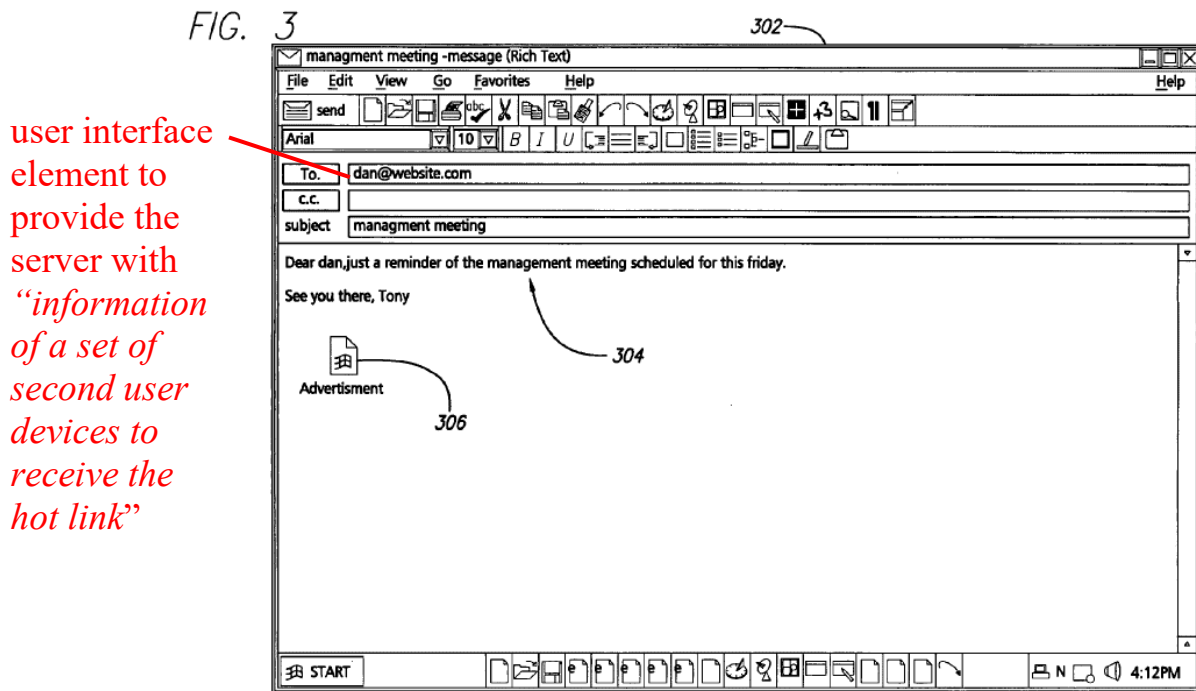
Rothschild's web server "interfaces" with the sender's device over the Internet: "Specifically the Web browser 124, operating on the sender network device 120, interfaces over the Internet 102 with the Web server 112, which is operating on the Web site 110." Ex.1005, 8:64-9:10. As described above at [9.1], Rothschild's web server includes "*network interface circuitry*" in that the web server includes "hardware/software server components that serve information content over a network." Ex.1005, 6:61-67.

Thus, because Rothschild's web server includes hardware/software server components that serve information and interface over a network, Rothschild renders obvious "*network interface circuitry*" as claimed. Ex.1003, ¶¶105-06.

[10.2] *receive, from a first user device, a request to generate a hot link along with information of a set of second user devices to receive the hot link, and*

First, as explained above at [1.1] and [1.2], a user accesses a web site to generate an e-mail message with an interactive advertisement. In this manner, the web server associated with the web site receives "*a request to generate a hot link.*"

Second, Rothschild's web server also provides the sending user with a mechanism to designate the recipients of that e-mail message. "The e-mail communication page 402 provides a recipient space 408 where the sender can designate at least one recipient that will receive the e-mail." Ex.1005, 9:11-31.



Ex.1005, Fig. 3 (annotated); Ex.1003, ¶108.

Accordingly, when a user accesses the web page 402 and identifies the recipients of the message and advertisement, the web server receives “*information of a set of second user devices to receive the hot link.*” Moreover, as explained above at [2.1] and [2.2], by designating e-mail addresses of users who have their associated devices, the sending user is designating a set of second user devices. Moreover, a POSITA would have understood that anything received from the sending user’s device would be received by the hardware/software components for transferring data over a network (“*network interface circuitry*”). Ex.1003, ¶109.

Thus, because Rothschild’s web server receives a selection of an interactive advertisement for inclusion in an e-mail message, as well as the recipients of that

e-mail message, Rothschild renders obvious “*receive, from a first user device, a request to generate a hot link along with information of a set of second user devices to receive the hot link*” as claimed. Ex.1003, ¶¶107-10.

[10.3] *transmit a hot link message to the set of second user devices; and*

Rothschild’s web server transmits the e-mail message with the interactive advertisement (“*hot link message*”) to the recipients (“*set of second user devices*”). “At step 516 the message data (which includes the selected advertisement) is formatted into a standard e-mail format ... At step 520, the formatted e-mail is sent to the designated recipient(s).” Ex.1005, 10:65-11:33. A POSITA would have understood that data transmitted from the server would be transmitted by the hardware/software components for transferring data over a network (“*network interface circuitry*”). Ex.1003, ¶111.

Thus, because Rothschild’s web server transmits the e-mail with the interactive advertisement to the recipients, Rothschild renders obvious “*transmit a hot link message to the set of second user devices*” as claimed. Ex.1003, ¶111-13.

[10.4] *processor circuitry communicatively coupled with the network interface circuitry, the processor circuitry communicatively coupled with the network interface circuitry, the processor circuitry is to:*

First, a POSITA would have found it obvious for Rothschild’s web server to include processor circuitry as that is how servers perform the services for which they were designed. Ex.1003, ¶114. Rothschild’s web server includes “‘back end’

hardware/software components” (“*processor circuitry*”) to perform services for web-site users, which a POSITA would have understood to include processor circuitry. Ex.1005, 6:61-67; Ex.1003, ¶114.

Second, because these services are provided to web site users over a network, a POSITA would have recognized that Rothschild’s “back end” hardware/software components (“*processor circuitry*”) interfaces with the hardware/software components that serve information content over a network (“*network interface circuitry*”). Ex.1003, ¶115.

Thus, Rothschild renders obvious “*processor circuitry communicatively coupled with the network interface circuitry, the processor circuitry communicatively coupled with the network interface circuitry*” as claimed. Ex.1003, ¶116.

[10.5] *in response to detection of a trigger, determine an action to be performed upon activation of the hot link,*

As explained above at [1.2] and [1.3], when the server receives the user’s advertisement selection (“*detection of a trigger*”), Rothschild’s system places a selected advertisement—along with an embedded URL—into an e-mail message (“*determines an action to be performed upon activation of the hot link*”).

Thus, Rothschild renders obvious “*in response to detection of a trigger, determine an action to be performed upon activation of the hot link*” as claimed.

Ex.1003, ¶¶117-18.

[10.6] wherein activation of the hot link by individual second user devices of the set of second user devices is to cause the individual second user devices to execute program code to perform the action, and

As described above at [1.1]-[1.3], activation of the URL within the interactive advertisement (“*hot link*”) causes an application (e.g., a web browser) on the receiving user’s device to obtain additional data from a web site (“*cause[s] the individual second user devices to execute program code to perform the action*”) when the user interacts with the advertisement (“*activation of the hot link by individual second user devices of the set of second user devices.*”). See Ex.1005, 11:57-12:13.

Thus, Rothschild’s interactive advertisement, when interacted with by the receiving user, causes the receiving user’s device to obtain additional information from the web site, Rothschild renders obvious, “*wherein activation of the hot link by individual second user devices of the set of second user devices is to cause the individual second user devices to execute program code to perform the action*” as claimed. Ex.1003, ¶¶119-20.

[10.7] generate the hot link message to include the determined action and instructions for rendering and displaying the hot link at each of the set of user devices.

For the reasons explained above at [1.4], Rothschild renders obvious
*“generate the hot link message to include the determined action and instructions
for rendering and displaying the hot link at each of the set of user devices”* as
claimed. Ex.1003, ¶121.

12. Claim 11

[11.1] *The computer system of claim 10, ... identified user interface element.*

See claim 10, [6.1], and [6.2]. Ex.1003, ¶¶122-24.

13. Claim 12

[12.1] *The computer system of claim 10, ... set of second user devices.*

See claim 10, [2.1], and [2.2]. Ex.1003, ¶¶125-27.

14. Claim 13

**[13.1] *The computer system of claim 10, wherein the hot link comprises
instructions to obtain and render a web page in a web browser, execute
executable instructions of an application program, or adjust radiofrequency
circuitry to obtain and display broadcasted content.***

See claims 7 and 10. Ex.1003, ¶128.

15. Claim 14

**[14.1] *The computer system of claim 10, wherein the processor circuitry is to:
generate the hot link message to include an indication about the hot link,
wherein the indication about the hot link comprises text, multimedia, or a link
pointing to a resource that includes information about the hot link.***

See claims 4 and 10. Ex.1003, ¶129.

16. Claim 15

[15.0] *The computer system of claim 10, wherein the processor circuitry is to:*

See claim 10. Ex.1003, ¶130.

[15.1] *generate the hot link message as a Short Message Service (SMS) message for transmission over a cellular communication network, or generate the hot link message as an instant messaging (IM) message for transmission over a communications network*

See claims 5 and 10. Ex.1003, ¶131.

17. Claim 16

[16.1] *The computer system of claim 10, wherein the processor circuitry is to: determine a location for each second user device of the set of second user devices; and generate the hot link message to include the location of each second user device.*

See claims 8 and 10. Ex.1003, ¶132.

18. Claim 17

[17.1] *The computer system of claim 10, wherein the network interface circuitry is to transmit the hot link message to the set of user devices over a wired or wireless network.*

See claims 9 and 10. Ex.1003, ¶133.

19. Claim 18

[18.0] *One or more non-transitory computer-readable media (NTCRM) including program code, wherein execution of the program code by one or more processors of a user device is to cause the user device to:*

Rothschild describes a recipient device (“*user device*”). The recipient device includes “a recipient display 132, a communication application 134, and a recipient

memory device 136.” Ex.1005, 7:39-41. The recipient device 130 includes various forms of memory 136, such as “long or short term data storage devices, including, but not limited to, RAM, cache memory, flash memory, magnetic disks, optical disks, removable disks, SCSI disks, IDE hard drives, tape drives, smart cards, and all other types of data storage devices (and combinations thereof, such as RAID devices).” Ex.1005, 7:60-64. A POSITA would have recognized these types of memory as non-transitory computer-readable media. Ex.1003, ¶135.

Moreover, like the discussion above at [1.0], the recipient device 130 includes a communication application 134. Rothschild explains that “an application program is a set of one or more computer programs that performs a function when executed within a computer hardware device.” Ex.1005, 6:39-42. A POSITA would have understood that an application running on the recipient device that performs the claimed steps (described below in [18.1]-[18.4]), such as a web browser or communication application 134, is “*program code*” as claimed. Ex.1003, ¶135.

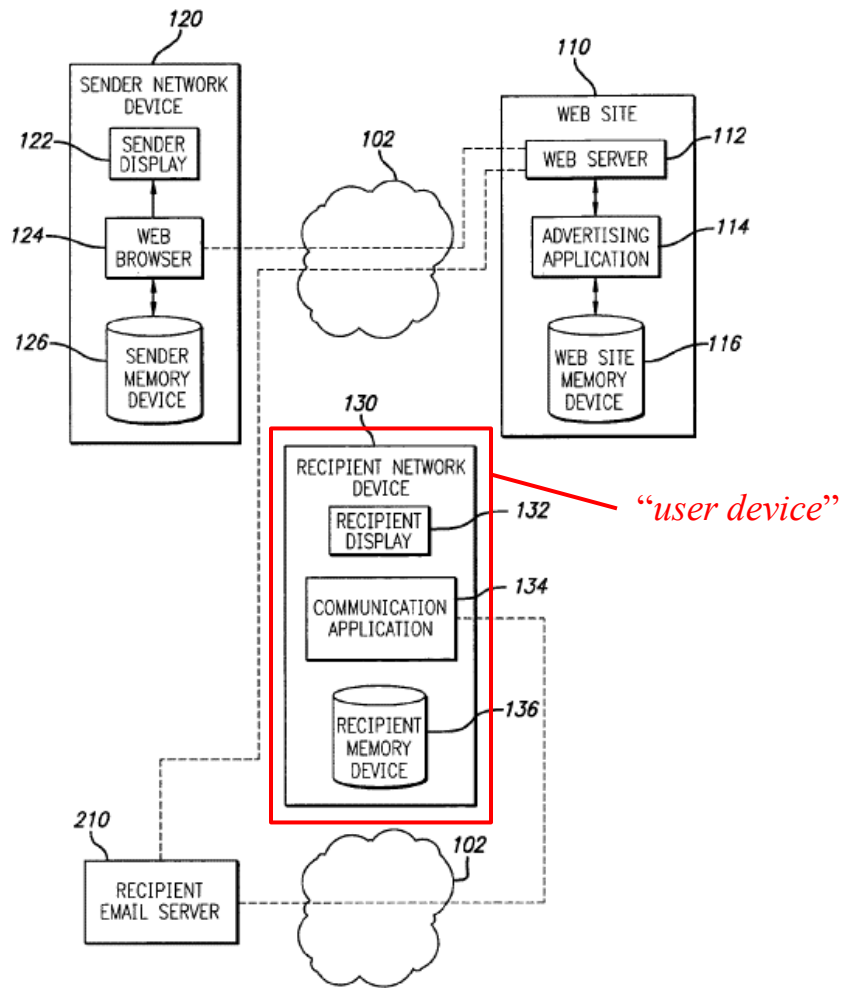


FIG. 2

Ex.1005, Fig. 3 (annotated); Ex.1003, ¶134.

Thus, because Rothschild describes a recipient device that includes various forms of memory 136 and an application 134 that is executed by hardware, Rothschild renders obvious “one or more non-transitory computer-readable media (NTRM) including program code, wherein execution of the program code by one

or more processors of a user device is to cause the user device to” as claimed.

Ex.1003, ¶¶134-36.

[18.1] *control receipt of a hot link message comprising a hot link and assignment information, the assignment information to assign the hot link to a graphical control element (GCE),*

First, as described above at [1.5], the web server transmits the e-mail message to the designated recipients. Accordingly, the recipient devices then receive the e-mail (“*hot link message*”) including the interactive advertisement (“*hot link*”). “The e-mail communication page 402 provides a recipient space 408 where the sender can designate **at least one recipient that will receive the e-mail.**” Ex.1005, 9:18-20. By receiving the e-mail message, an application on the recipient device “*control[s] receipt*” of the e-mail message, and the interactive advertisement within.

Second, as explained above at [1.1] and [1.4], the personal communication (“*hot link message*”) may include an interactive advertisement (“*hot link*”) that includes a graphic or icon that is rendered to the user on the user device display. The rendered graphic or icon is a “*graphical control element*” with which the recipient may interact.

Third, as explained above at [6.1] and [6.2], the interactive advertisement (“*hot link*”) is comprised of “advertisement data” that associates (i.e., assigns) the interactive advertisement with the rendered graphic or icon that is displayed to the

user. A POSITA would have understood that data contained within the e-mail message that associates the interactive advertisement with the graphic or icon that is to be rendered on the receiving device's display is "*assignment information*" because it assigns the graphic or icon to the interactive advertisement. ¶139.

Thus, because the recipient devices in Rothschild receive an e-mail message that includes an interactive advertisement comprises of advertisement data that associates the interactive advertisement with a graphic for display, Rothschild renders obvious "*control receipt of a hot link message comprising a hot link and assignment information, the assignment information to assign the hot link to a graphical control element (GCE)*" as claimed. Ex.1003, ¶137-40.

[18.2] and the hot link comprising instructions to perform an action and instructions for rendering and displaying the hot link;

First, as explained above at [1.2], the interactive advertisement includes an embedded URL that, when interacted with by the recipient, causes the recipient's device to perform the action of obtaining additional information.

Second, as explained above at [1.4], the interactive advertisement includes the data (e.g., HTML code) that is used to display the interactive advertisement as a graphic or icon.

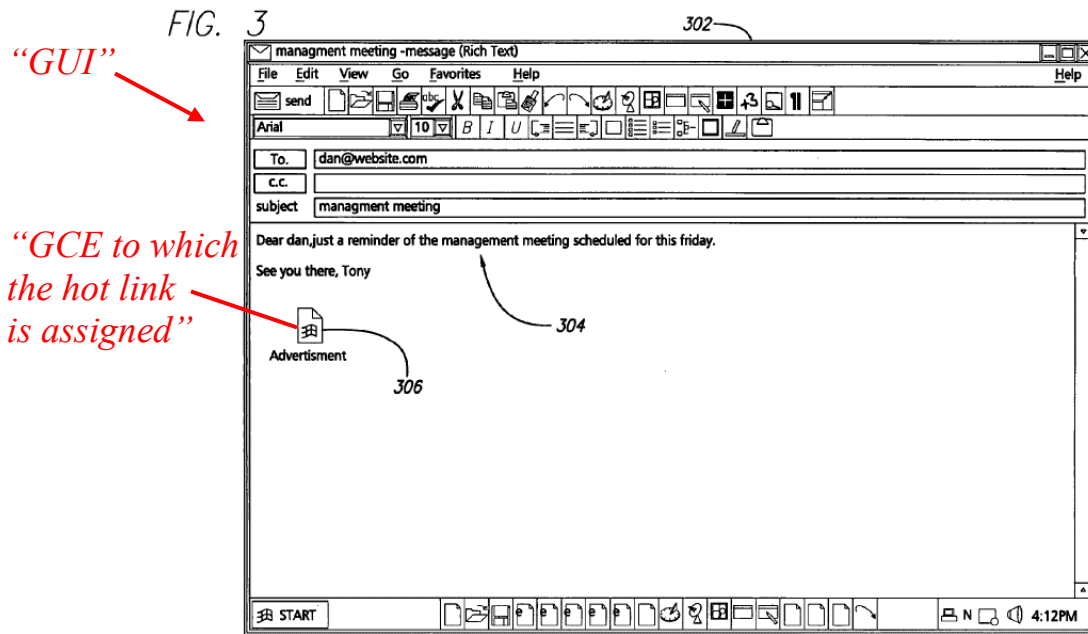
Thus, for the reasons explained above at [1.2] and [1.4], Rothschild renders obvious "*and the hot link comprising instructions to perform an action and*

instructions for rendering and displaying the hot link” as claimed. Ex.1003, ¶¶141-43.

[18.3] *generate a graphical user interface (GUI) to include the GCE to which the hot link is assigned according to the assignment information; and*

Rothschild explains that the recipient devices include a display 132 that is used by an application (e.g., an e-mail client or web browser) to present an interface (“*graphical user interface*”) for displaying the interactive advertisement: “The personal communication received by the communication application 134 may be displayed on the recipient display 132.” Ex.1005, 7:39-40.

Fig. 3 of Rothschild shows what the e-mail looks like from the sender’s perspective. A POSITA would have recognized that the e-mail displayed on the recipient’s device would be presented in a similar manner. Ex.1003, ¶145.



Ex.1005, Fig. 3 (annotated); Ex.1003, ¶145.

Thus, because Rothschild describes a recipient device with a communication application to display the e-mail message and the e-mail message includes a graphic or icon that can be interacted with, Rothschild renders obvious “*generate a graphical user interface (GUI) to include the GCE to which the hot link is assigned according to the assignment information*” as claimed. Ex.1003, ¶¶144-46.

[18.4] in response to activation of the GCE, execute the instructions of the hot link to perform the action.

As explained above at [1.3], when the user interacts with the interactive advertisement and activates the URL, the web browser of the receiving device executes instructions to retrieve content from the location specified by the URL.

Thus, Rothschild renders obvious “*in response to activation of the GCE, execute the instructions of the hot link to perform the action*” as claimed. Ex.1003, ¶147.

20. Claim 21

[21.0] *The one or more NTCRM of claim 18, wherein execution of the instructions of the hot link is to cause the user device to:*

See Claim 18. Ex.1003, ¶148.

[21.1] *obtain and render a web page in a web browser implemented by the user device;*

See [7.1]. Ex.1003, ¶149.

[21.2] *execute executable instructions of an application program, wherein the executable instructions of the application program are stored by a memory device of the user device, or the executable instructions of the application program are to be obtained by the user device over a communication network; or adjust radio frequency circuitry of the user device to obtain broadcasted content for display*

See [7.1]. Because the claim is written with alternative language (i.e., “or”), the claim is met because [21.1] is met. Ex.1003, ¶150.

21. Claim 22

[22.1] *The one or more NTCRM of claim 18, wherein the GUI comprises an indication about the hot link, wherein the indication about the hot link comprises text, multimedia, or a link pointing to a resource that includes information about the hot link.*

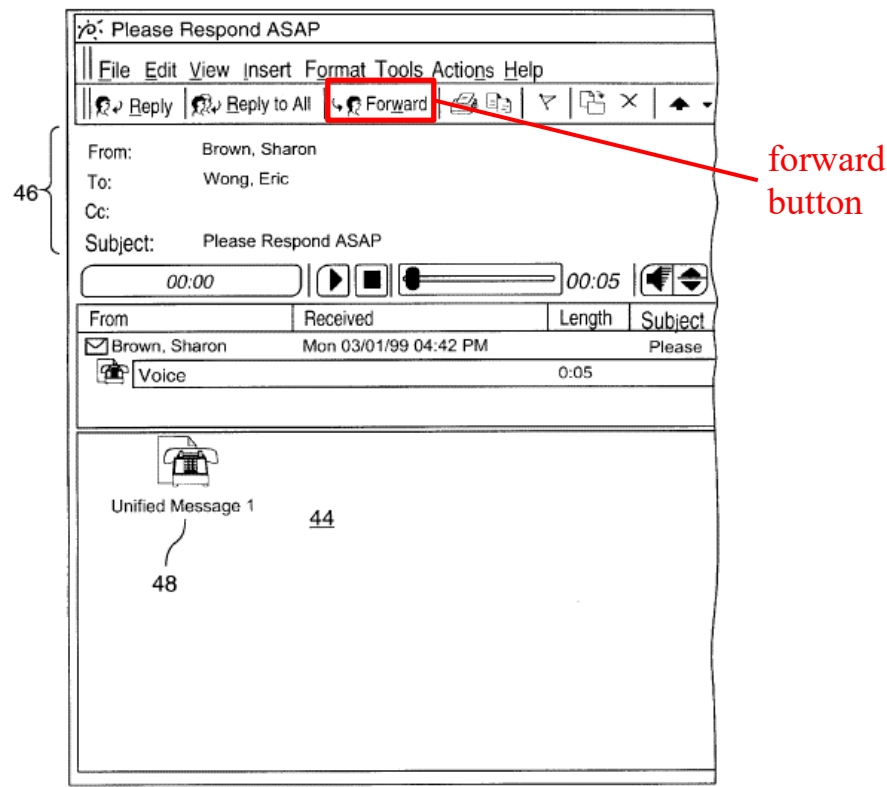
See claims 4 and 18. Ex.1003, ¶151.

B. Ground 2: Claim 19 is obvious under 35 U.S.C. § 103 over Rothschild and Saltanov.

1. Summary of Saltanov

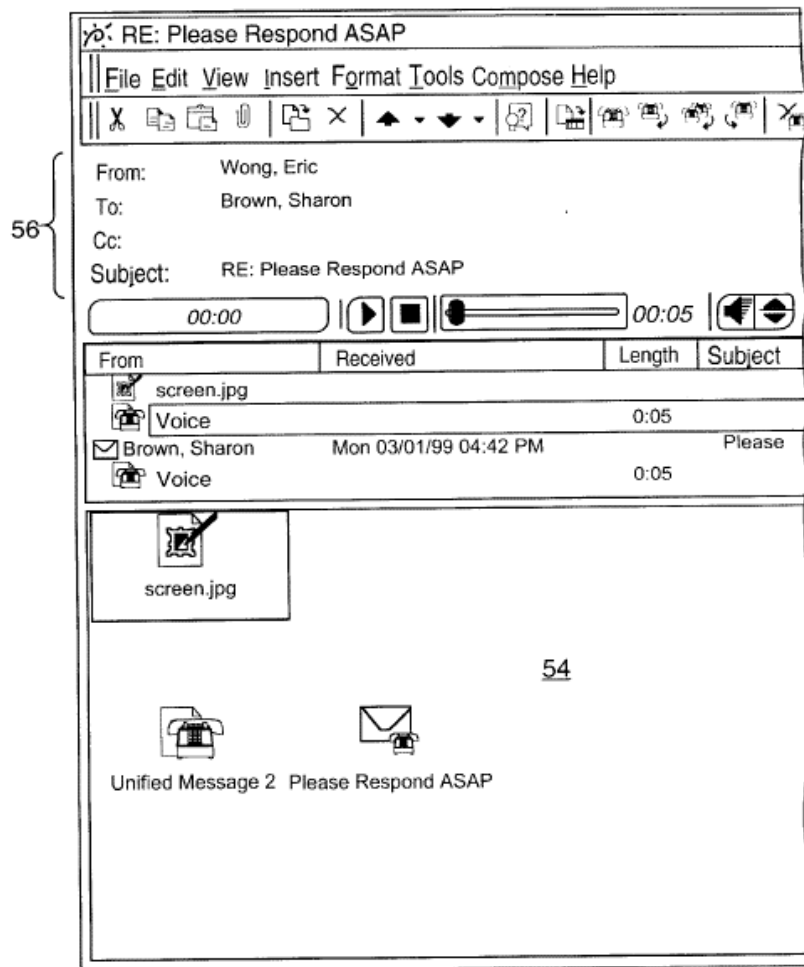
U.S. Patent No. 6,839,411 to Saltanov discloses e-mail forwarding—something that was well-known and commonly done in e-mail applications at the time the '169 patent was filed. Saltanov describes a “graphical user interface [that] can be implemented in a variety of messaging systems, including electronic mail systems.” Ex.1006, abstract. Saltanov describes that a user’s device may run “Microsoft Outlook® client messaging software sold by Microsoft Corporation.” Ex.1006, 5:16-17. “The client messaging software provides a graphical user interface (GUI) to display the user’s messages held in their post office mailbox and to allow the user to invoke messaging functions.” Ex.1006, 5:17-20. The user can “perform messaging functions such as create, attach, read, modify, reply, **forward**, store and delete messages of various types.” Ex.1006, 5:12-14.

Saltanov illustrates an example of an e-mail message that is received by a user as shown below in Fig. 4B.



Ex.1006, Fig. 4B; Ex.1003, ¶153.

As shown in figure, there is an option to forward the e-mail. Saltanov explains that the “recipient of the message ... replies back to the sender (or forwards the message to another) such that the reply message includes not only the original message but also additional attachments.” Ex.1006, 5:53-57. When forwarding the message, the user is presented with a new window (i.e., a new GUI), as shown below in Fig. 5B.



Ex.1006, Fig. 5B; Ex.1003, ¶154.

As shown in the figure, the new window includes a “properties area 56” that has a “To” field and a “Cc” field. The e-mail is then sent to the user when the user clicks send. Ex.1003, ¶¶152-55.

2. Reasons to Combine Saltanov with Rothschild

Saltanov provides an example of forwarding e-mail messages, something that both POSITAs and the general population were doing regularly before the '169 patent was filed. Accordingly, a POSITA would have found it obvious that a

recipient of an e-mail message with an interactive advertisement as taught by Rothschild could forward that e-mail message to other people, as evidenced by Saltanov. Ex.1003, ¶156.

As an initial matter, Saltanov is analogous art to the '169 patent because Saltanov relates to the same field of endeavor—telecommunication—as the '169 patent. The '169 patent is “directed to generating and sending a hot link to a telecommunications device”). Similarly, Saltanov relates to user interfaces of e-mail applications. *See e.g.* Ex.1006, 5:12-14, Fig. 5B.

As explained above at IX.A.1, Rothschild’s system allows the sender of an e-mail to “depress the send message button 414 to send the e-mail (which includes the attachment(s) and the selected advertisement) to the designated recipient(s).” Ex.1005, 9:57-60. In particular, the e-mail message “is forwarded on to the communication application 134 operating on the recipient network device 130.” Ex.1005, 11:54-56. “[T]he communication application 134 may be an e-mail application (e.g., Microsoft Outlook™).” Ex.1005, 7:48-50. Accordingly, a POSITA would have found it obvious for the communication application 134 on Rothschild’s recipient device 130 to include the known capabilities, functionalities, and features of the available communication applications, such as Microsoft Outlook. Ex.1003, ¶158.

Saltanov describes a “personal computer 120 [that] runs Microsoft Outlook® client messaging software sold by Microsoft Corporation.” Ex.1006, 5:15-17. “The client messaging software provides a graphical user interface (GUI) to display the user’s messages held in their post office mailbox and to allow the user to invoke messaging functions.” Ex.1006, 5:17-20. Saltanov gives various examples of the messaging functions “such as create, attach, read, modify, reply, **forward**, store and delete messages of various types.” Ex.1006, 5:12-13. Accordingly, a POSITA would have recognized that the communication application 134 of Rothschild, which may be Microsoft Outlook, would include known functionality such as forwarding e-mail messages. Ex.1003, ¶159.

A POSITA would have further understood that forwarding e-mail messages would work in a manner that was familiar to many users. Ex.1003, ¶160. In particular, a POSITA would have understood that when forwarding an e-mail, the user is provided with a new window that allows the user to enter the recipients of the forwarded e-mail and send the forwarded e-mail message when ready. *See e.g.*, Ex.1006, Fig. 5B, 5B’. When doing so, the originally received e-mail message that includes the interactive advertisement is then forwarded to additional users.

A POSITA would have had a reasonable expectation of success when combining the teachings of Saltanov with those of Rothschild. Both Rothschild and Saltanov explicitly suggest the combination as they both list Microsoft Outlook as

an example of a communication application. Moreover, Rothschild explicitly suggests that forwarding e-mails, as shown by the “forward” arrow in Fig. 4. A POSITA would have found it obvious and predictable for the Microsoft Outlook in Rothschild to include the features of the Microsoft Outlook in Saltanov. More specifically, a POSITA would have found it obvious and predictable for the Microsoft Outlook in Rothschild to include the capability of forwarding e-mails. A POSITA would also have realized the benefit of forwarding the interactive advertisement so that it reaches a larger audience. Ex.1003, ¶161.

Thus, the combination of Rothschild and Saltanov represents the combination of known elements (e-mail client functionality) to yield predictable results (the ability to forward e-mail). Ex.1003, ¶¶156-62.

3. Claim 19

[19.2] *The one or more NTCRM of claim 18, wherein the GUI is a first GUI, and execution of the program code is to cause the user device to:*

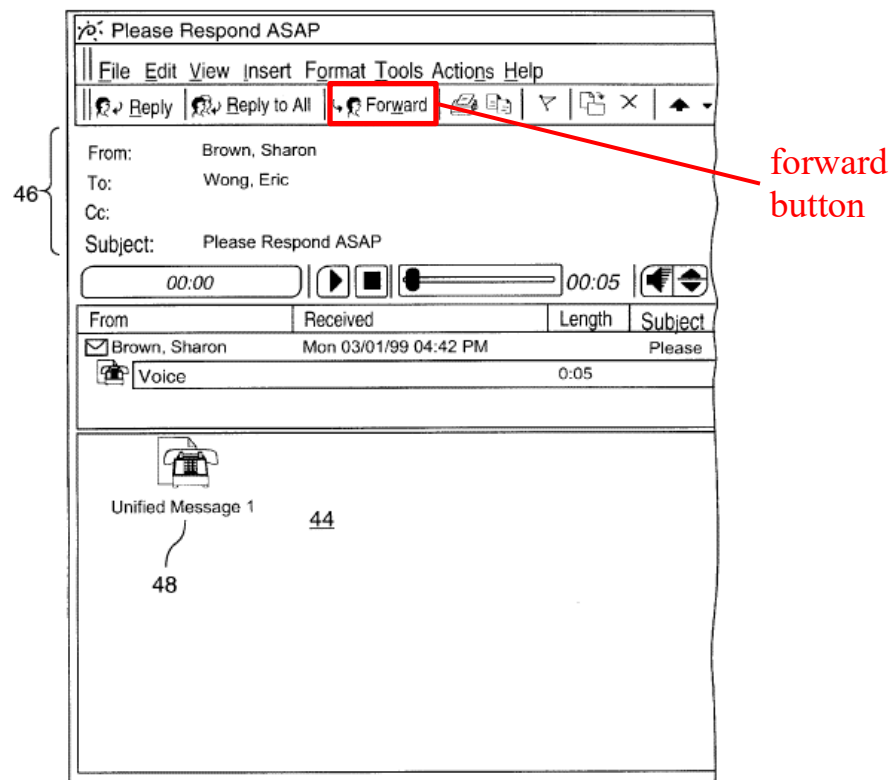
See claim 18. Ex.1003, ¶163.

[19.1] *generate a second GUI comprising a user selection GCE and a submission GCE, the user selection GCE to control selection of a set of other user devices to be provided with a hot link, and the submission GCE to control submission of the set of other user devices; and*

First, Saltanov provides an example in which when a user forwards an e-mail, a new window (included in a “*second GUP*”) is displayed. “The client messaging software provides a graphical user interface (GUI) to display the user’s

messages held in their post office mailbox and to allow the user to invoke messaging functions.” Ex.1006, 5:17-20. The user can “perform messaging functions such as create, attach, read, modify, reply, **forward**, store and delete messages of various types.” Ex.1006, 5:12-14.

Saltanov illustrates an example of an e-mail message that is received by a user as shown below in Fig. 4B, which includes a “Forward” button.



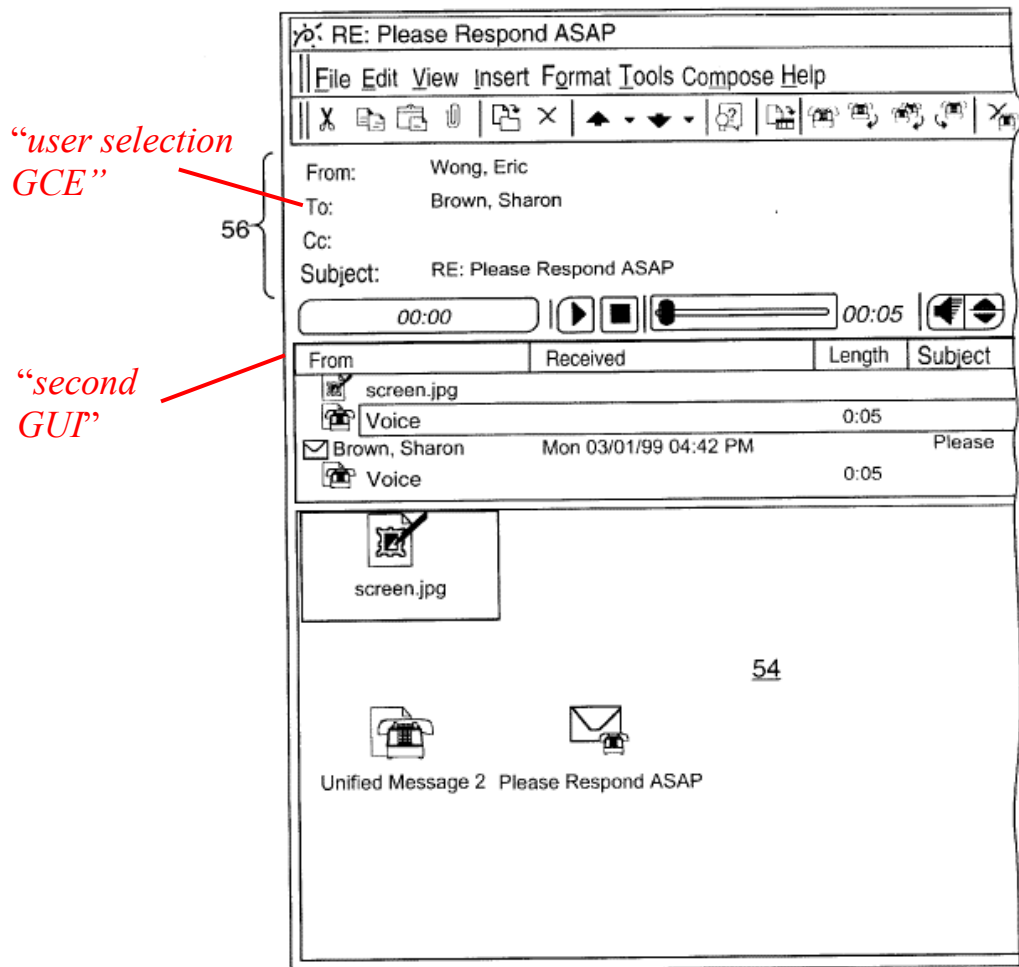
Ex.1006, Fig. 4B (annotated); Ex.1003, ¶165.

Saltanov explains that the “recipient of the message ... replies back to the sender (**or forwards** the message to another) such that the reply message includes

not only the original message but also additional attachments.” Ex.1006, 5:53-57.

When forwarding the message, the user is presented with a new window (part of the “*second GUP*”).

Second, Saltanov shows that the new window includes fields for entering the users to whom the e-mail will be forwarded. As shown in the figure, the new window includes a “properties area 56” that has a “To” field and a “Cc” field (“*user selection GCE to control selection of a set of other user devices to be provided with a hot link*”), as shown below in Fig. 5B.



Ex.1006, Fig. 5B (annotated); Ex.1003, ¶167.

Third, a POSITA would have recognized that the user interface of e-mail applications include “Send” buttons (“*submission GCE to control submission of the set of other user devices*”) for sending the e-mail message after the recipients have been identified and the message is ready for sending. Ex.1003, ¶168. For example, Rothschild explains that when a user sends an e-mail, “the sender can depress the send message button 414 to send the e-mail (which includes the attachment(s) and the selected advertisement) to the designated recipient(s).”

Ex.1005, 9:57-61. POSITAs also recognized that e-mail clients such as Microsoft Outlook include a “Send” button when sending an e-mail (whether an original e-mail or a forwarded e-mail). Ex.1003, ¶168.



Ex.1006, Fig. 4A (partial).

Accordingly, a POSITA would have recognized that a user, who receives an e-mail message with an interactive advertisement as taught by Rothschild, would have the ability to forward that e-mail to additional recipients. When doing so, it would have been obvious for the forwarding user to select the recipients using the “To” and “Cc” fields (“*user selection GCE*”) and then to click on a “Send” button to transmit the e-mail (“*submission GCE*”). Ex.1003, ¶169.

Thus, because Rothschild describes receiving an e-mail message with an interactive advertisement, and Saltanov provides an example GUI of forwarding e-mails, Rothschild and Saltanov render obvious “*generate a second GUI comprising a user selection GCE and a submission GCE, the user selection GCE to control selection of a set of other user devices to be provided with a hot link, and the submission GCE to control submission of the set of other user devices*” as claimed. Ex.1003, ¶¶164-70.

[19.2] *control transmission of another hot link message that includes an indication of the selected set of other user devices in response to selection of the submission GCE.*

As explained above at [19.1], because Saltanov describes forwarding e-mails, a POSITA would have found it obvious for Rothschild’s recipient device to forward the e-mail with an interactive advertisement to additional recipients. The forwarded e-mail thus becomes “*another hot link message*” with a “To” or “Cc” field that indicates the “*selected set of other user devices.*” The forwarded message is sent when the user clicks the send button (“*in response to selection of the submission GCE*”). Ex.1003, ¶171.

C. Ground 3: Claim 20 is obvious under 35 U.S.C. § 103 over Rothschild, Saltanov, and Maes

1. Summary of Maes

U.S. Patent Publication No. 2002/0002502 (“Maes”) demonstrates that user interfaces with a mechanism for providing user feedback were widely known before May of 2001. Maes relates to a tool that “helps a person choose a product from among many possible products.” Ex.1008, [0024]. “The tool extracts information about product characteristics that appeal to or repulse the person, and uses the extracted information to present the person with additional product choices.” Ex.1008, [0024]. To extract the information on user preferences, Maes’ system provides a “user interface” in which “the user can indicate positive or

negative preferences by clicking on buttons under the products.” Ex.1008, [0071].

“Buttons and menu items can be appropriately marked by the works ‘like’ and ‘dislike,’ a ‘thumbs-up’ or ‘thumbs-down’ symbol, or the like.” Ex.1008, [0071].
Ex.1003, ¶172.

2. Reasons to Combine Maes with Rothschild and Saltanov

A POSITA would have found it obvious for a recipient of Rothschild’s interactive advertisement to provide feedback about the additional content delivered by interacting with the advertisement. In particular, a POSITA would have been motivated, and found it beneficial, for the content of Rothschild’s interactive advertisement to receive user feedback so that the advertisers and marketers can improve their outreach to customers. Ex.1003, ¶173.

As an initial matter, Maes is analogous art to the ’169 patent because Maes relates to the same field of endeavor—telecommunication—as the ’169 patent. *Compare* Ex.1001, 3:59-61 (“The present invention is directed to generating and sending a hot link to a telecommunications device”) *with* Ex.1008, [0063] (describing “communication sessions, such as by electronic mail or by mail or messenger”).

As explained above, Rothschild describes “[a]n interactive advertisement is an icon, graphic, text, or voice message that can be interacted with to provide the recipient with **additional communication data**.” Ex.1005, 8:22-25. Rothschild

explains that “[t]he additional communication data can contain advertisement data, entertainment data, educational data, or any other type of data made available to the web site.” Ex.1005, 8:27-30. Rothschild explains that an advertisement “should appeal to the e-mail recipient.” Ex.1005, 3:24-25.

Maes provides a mechanism by which users can rate content. As explained above, Maes describes a “user interface” in which “the user can indicate positive or negative preferences by clicking on buttons under the products.” Ex.1008, [0071]. “Buttons and menu items can be appropriately marked by the works [sic] ‘like’ and ‘dislike,’ a ‘thumbs-up’ or ‘thumbs-down’ symbol, or the like.” Ex.1008, [0071].

Accordingly, a POSITA would have found it obvious for a recipient of Rothschild’s interactive advertisement to provide feedback on the advertised product. Ex.1003, ¶177. A POSITA would have found it obvious to include such feedback buttons within the e-mail message or within the additional content received by activating the URL of the interactive advertisement. Indeed, mechanisms for providing feedback on advertisements was well-known. *See e.g.*, Ex.1012, 26 (describing an “extensive feedback mechanism which applies to ... advertisements displayed” and “is preferably in the form of either ‘thumbs up’ or ‘thumbs down’”).

A POSITA would have had a reasonable expectation of success. Ex.1003, ¶178. Maes explains that its feedback mechanism can be done through

“communication sessions, such as by electronic mail or by mail or messenger.”

Ex.1008, [0063]; A POSITA would have found the combination beneficial. Maes explains that “an embodiment of the invention can allow the user to rate each or some of the products, to provide more information about the user’s desires than which are the most/least liked.” Ex.1008, [0126]; *see also* Ex.1012, 25-26 (“In any forum or system, the information is only as good as the people participating. Without feedback, the incentive to be responsible and provide good and helpful information to others is low”). The combination of Maes and Rothschild thus yields the predictable result of providing advertisers with a mechanism to increase the appeal of their advertisements. Ex.1003, ¶178.

Accordingly, the combination of Maes with Rothschild represents the use of a known technique (Maes’s ratings mechanism) to improve similar methods (Rothschild’s interactive advertisement content) in the same way (providing advertisers with feedback to improve their outreach). Ex.1003, ¶¶173-79.

3. Claim 20

[20.0] *The one or more NTCRM of claim 19, wherein the second GUI comprises:*

See claim 19. As discussed in claim 19, the new window created when forwarding an e-mail is part of “*the second GUI*.” For the claim limitations below, whichever part of the user interface is presenting the positive and negative

graphical control elements is also part of the claimed “*second GUI*.” Ex.1003, ¶180.

[20.1] *a positive opinion GCE to control submission of a positive opinion of a content item; and*

As explained above at IX.D.2, a POSITA would have found it obvious for Rothschild’s recipient device to include a user interface for providing feedback, as evidenced by Maes. Maes describes a “user interface” in which “the user can indicate positive or negative preferences by clicking on buttons under the products.” Ex.1008, [0071]. “Buttons and menu items can be appropriately marked by the works ‘like’ and ‘dislike,’ a ‘thumbs-up’ or ‘thumbs-down’ symbol, or the like.” Ex.1008, [0071].

Thus, because Maes describes a “thumbs up” button for rating content, which a POSITA would have found applicable to Rothschild’s interactive advertisement, Rothschild and Maes render obvious “*a positive opinion GCE to control submission of a positive opinion of a content item*” as claimed. Ex.1003, ¶¶181-82.

[20.2] *a negative opinion GCE to control submission of a negative opinion of the content item.*

As explained above at IX.D.2, a POSITA would have found it obvious for Rothschild’s recipient device to include a user interface for providing feedback, as evidenced by Maes. Maes describes a “user interface” in which “the user can

indicate positive or negative preferences by clicking on buttons under the products.” Ex.1008, [0071]. “Buttons and menu items can be appropriately marked by the works ‘like’ and ‘dislike,’ a ‘thumbs-up’ or ‘**thumbs-down**’ symbol, or the like.” Ex.1008, [0071].

Thus, because Maes describes a “thumbs down” button for rating content, which a POSITA would have found applicable to Rothschild’s interactive advertisement, Rothschild and Maes render obvious “*a negative opinion GCE to control submission of a negative opinion of the content item*” as claimed. Ex.1003, ¶¶183-84.

D. Ground 4: Claims 1-18 and 21-22 are obvious under 35 U.S.C. § 103 over Rothschild and Chen

Ground 1 presents Rothschild as rendering obvious “instructions for rendering and displaying the hot link,” citing to Chen as evidence that it would be obvious for Rothschild’s e-mail service to be implemented using HTML, and in so doing, the HTML code would provide such instructions for rendering and displaying a hot link. To the extent Patent Owner argues that Chen does not represent the background knowledge of a POSITA, Ground 4 (along with grounds 5 and 6 for claims 19 and 20 respectively) provides reasons why a POSITA would have found it obvious to implement Rothschild’s interactive advertisements using HTML, as evidenced by Chen. Ex.1003, ¶185.

1. Summary of Chen

Chen (U.S. Patent No. 6,836,792) relates to a “method for providing add-on services responsive to an email transferred via a distributed computer network.” Ex.1007, abstract. Chen’s background section provides examples of known mechanisms by which advertisements are inserted into e-mail messages—through HTML: “[A]n advertisement insertion module 170 interfaces with HTML converter facility 158 to insert an appropriate advertisement banner into the email message prior to sending the email message.” Ex.1007, 2:51-54. Chen further shows that various concepts, including the HTML converter facility 158, are “conventional and may include other implementational details and variations, which are well known to those in the business of providing email service.” Ex.1007, 2:37-39. Chen also explains that the advertisements inserted into the e-mail “may take various forms, including without limitation one or more of audio, still banner, animation, video clips, each with or without HTML links.” Ex.1007, 8:23-26. Accordingly, Chen provides evidence that before May of 2001 it was well-known to insert advertisements into emails using HTML. A POSITA would have recognized that HTML code includes instructions for rendering and displaying graphics. Ex.1003, ¶186.

2. Reasons to Combine Rothschild and Chen

A POSITA would have found it obvious to implement Rothschild's interactive advertisement using known techniques. Chen provides evidence that it was known to implement advertisements in e-mail using HTML. For the reasons explained below, a POSITA would have found it obvious and beneficial to implement Rothschild's interactive advertisement using HTML. Ex.1003, ¶187.

As an initial matter, Chen is analogous art to the '169 patent because Chen is in the same field of endeavor—telecommunication. *Compare* Ex.1001, 3:59-61 (“The present invention is directed to generating and sending a hot link to a telecommunications device”) *with* Ex.1007, abstract (describing “method for providing add-on services responsive to an email transferred via a distributed computer network”).

Rothschild generically describes inserting an interactive advertisement within an e-mail. In particular, Rothschild describes a “system and method that allows an Internet user to place an advertisement within a personal communication.” Ex.1005, 1:26-27. The advertisement may be an interactive advertisement that includes an embedded URL to retrieve data from a website. *See* Ex.1005, 11:57-6:13. “When a recipient interacts with an interactive advertisement, the request data (contained in the advertisement's embedded URL) ... retrieve[s] data from the Web site.” Ex.1005, 5:8-16. Rothschild's interactive

advertisement may be displayed as “an icon, graphic, text, or voice message that can be interacted with to provide the recipient with additional communication data.” Ex.1005, 8:22-25. Rothschild leaves out the implementation details for inserting an interactive advertisement that is displayed with a graphic and includes an embedded URL, thus suggesting that such details were known. Ex.1003, ¶189.

Chen provides evidence that, indeed, techniques for inserting advertisements into an e-mail were known. Specifically, Chen describes an HTML converter facility 158 that is “conventional and may include other implementational details and variations, which are well known to those in the business of providing email service.” Ex.1007, 2:37-39. “[A]n advertisement insertion module 170 interfaces with HTML converter facility 158 to insert an appropriate advertisement banner into the email message prior to sending the email message.” Ex.1007, 2:51-54.

A POSITA would have had a reasonable expectation of success when combining the teachings of Rothschild with Chen because both Rothschild and Chen describe similar types of advertisement. Ex.1003, ¶191. Rothschild explains that the advertisements may be displayed as “an icon, graphic, text, or voice message that can be interacted with to provide the recipient with additional communication data.” Ex.1005, 8:22-25. Similarly, Chen explains that the advertisements “may take various forms, including without limitation one or more of audio, still banner, animation, video clips, each with or without HTML links.”

Ex.1007, 8:23-27. Accordingly, a POSITA would have expected Chen’s HTML-specific implementation of advertisements to be applicable to Rothschild’s advertisements as well. Ex.1003, ¶192.

A POSITA would have recognized that implementing Rothschild’s interactive advertisement using HTML would have been beneficial. Chen explains that its teachings provide “improved techniques for providing new services and features to users of an existing email system in a way that requires little change to the existing email systems and at little cost.” Ex.1007, 3:64-67. Accordingly, the combination of Rothschild and Chen represents the combination of known elements (e-mail advertisements) according to known methods (HTML) to yield predictable results. Ex.1003, ¶¶187-93.

3. Claims 1-18 and 21-22

The claim analysis for this ground is substantially the same as the analysis provided in Ground 1. *See supra* IX.A.1-IX.A.21. Ex.1003, ¶194.

E. Ground 5: Claim 19 is obvious under 35 U.S.C. § 103 over Rothschild, Chen, and Saltanov

The claim analysis for this ground is substantially the same as the analysis provided in Ground 2. *See supra* IX.B.1-IX.B.3. Ex.1003, ¶195.

F. Ground 6: Claim 20 is obvious under 35 U.S.C. § 103 over Rothschild, Chen, Saltanov, and Maes

The claim analysis for this ground is substantially the same as the analysis provided in Ground 3. *See supra* IX.C.1-IX.C.3. ¶196.

X. CONCLUSION

Accordingly, Petitioner has established a reasonable likelihood that claims 1-22 are unpatentable.

Respectfully submitted,

Dated: November 30, 2022
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XI. MANDATORY NOTICES

A. Real Party-in-Interest

Pursuant to 37 C.F.R. § 42.8(b)(1), Petitioner certifies that the real parties-in-interest are Google LLC³ and YouTube, LLC.

B. Related Matters

Pursuant to 37 C.F.R. § 42.8(b)(2), to the best knowledge of the Petitioner, the following cases are relevant to the '169 patent:

Case Heading	Number	Court	Filed
<i>Wildseed Mobile LLC v. Google LLC et al.</i>	3-22-cv-04928	N.D. CA	August 29, 2022
<i>Wildseed Mobile LLC v. Google LLC et al.</i>	6-22-cv-00357	W.D. TX	April 4, 2022
<i>Wildseed Mobile LLC v. Google LLC et al.</i>	6-21-cv-01245	W.D. TX	Oct. 8, 2021

C. Lead and Back-up Counsel and Service Information

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³ Google LLC is a subsidiary of XXVI Holdings Inc., which is a subsidiary of Alphabet Inc. XXVI Holdings Inc. and Alphabet Inc. are not real parties-in-interest to this proceeding.

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Please address all correspondence to lead and back-up counsel. Petitioner consents to service in this proceeding by email at the addresses above.

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), Petitioner hereby certifies, in accordance with and reliance on the word count provided by the word-processing system used to prepare this Petition, that the number of words in this paper is 13,923. Pursuant to 37 C.F.R. § 42.24(d), this word count excludes the table of contents, table of authorities, mandatory notices under § 42.8, certificate of service, certificate of word count, appendix of exhibits, and any claim listing.

Dated: November 30, 2022

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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105, service was made on Patent Owner as detailed below.

Date of service November 30, 2022

Manner of service FEDERAL EXPRESS

Documents served

- Petition for IPR of U.S. Patent No. 10,869,169
- Certificate of Word Count
- Petitioner's Exhibit List
- Exhibits Ex.1001 to Ex.1021

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