

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

WILDSEED MOBILE LLC,
Patent Owner

Case IPR2023-00247
U.S. Patent No. 10,869,169

**PATENT OWNER PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107(a)**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	<i>Intentionally Left Blank</i>
2002	Case No. 3:22-cv-04928, Plaintiff Wildseed Mobile, LLC'S Patent L.R. 3-1 Disclosure of Asserted Claims and Infringement Contentions
2003	U.S. Patent No. 10,869,169 Invalidity Contentions
2004	<i>Intentionally Left Blank</i>
2005	U.S. Patent No. 6,411,685 to O'Neal
2006	U.S. Patent No. 6,473,609 to Schwartz <i>et al.</i>

I. INTRODUCTION

The Board should deny institution of *inter partes* review of claims 1-22 of U.S. Patent No. 10,869,169 (“the ’169 patent”) for at least two reasons. First, Petitioner’s references fail to disclose or render obvious all claim limitations, including “*in response to* detection of a trigger, determine an action.” In Petitioner’s asserted Grounds for independent claims 1 and 10, the alleged action is determined *before*—not in response to—detection of the alleged trigger. Because there is a missing element, the Board should deny institution. Further, it is no surprise that in view of this missing element, the Petition does not clearly explain how the references teach the claimed trigger in the first instance. Accordingly, Petitioner’s failure to meet its burden to specify with particularity where each element of the claims is found in the asserted art also warrants denial. Additionally, in Petitioner’s asserted Grounds for independent claim 18, the asserted art does not disclose or suggest the “assignment” limitation. Thus, Petitioner does not have a reasonable likelihood of prevailing on any independent claim (and therefore any challenged claim). So the Board should deny institution.

Second, the Board should deny institution under the Board’s precedential *Fintiv* decision in view of resources already expended in the parallel litigation. Rather than diligently preparing and filing its Petition, as Petitioner asserts, Petitioner waited until just one day before the one-year § 315(b) deadline. As a

result, the parties have already served infringement and invalidity contentions, proposed claim constructions, and are proceeding with discovery. Each of the references relied on in the Petition is also cited in the invalidity contentions in the parallel proceeding. And Petitioner has not provided a *Sotera* or *Sand* stipulation. For at least these reasons, the Board should use its discretion under § 314(a) and deny institution.

II. THE '169 PATENT

A. Summary

The '169 patent, titled “Method and systems for generating and sending a hot link associated with a user interface to a device,” issued on December 15, 2020 and claims priority to a chain of applications starting with U.S. Provisional Application No. 60/290,592, filed May 11, 2001. EX1001, [45], [54], [60], [63].

The '169 patent notes that, at the time of the invention, cellular telephones had become more common and widely used for numerous applications, not just phone calls:

[t]he lower cost of ownership, along with the increased services and features available, has made it common for individuals to own a cellular telephone and use it for daily communications. Individuals are no longer restricting the use of their cellular telephone to strictly business or emergency calls.

EX1001, 1:48-53.

The '169 patent relates to hot links that improve mobile device functionality.

Hot links can be sent to devices in order to allow the receiving device to perform an action, for example, tuning to a broadcast or fetching data.

Briefly described, the present invention is directed to generating and sending a hot link to a telecommunications device. The hot link is associated with an action that can be performed by the receiving device. ... For example, a hot link may be associated with an action to call another user upon activation of a user interface, or when the hot link is received by the device, automatically performing the associated action.

EX1001, 3:59-4:2; *see id.*, 16:3-38, FIG. 11 (describing exemplary actions).

In one embodiment, hot links may be automatically generated to enable actions based on user preferences. For example, a hot link, which instructs the user's device to receive the broadcast of a certain song, is generated when it is determined that particular song is playing:

Hot link application 680 may generate hot links, send hot links, and receive hot links to/from other devices. Server 640 may route hot links to other devices, as well as be programmed to *automatically generate hot links* and send them to requesting devices. For example, server hot link application 680 may *generate hot links* for a user *based on their user preferences*. One particular example would include when a *user desires* to have a *hot link* sent to his device *when a certain song is playing*. When the song is playing, server hot link application 680 may send a hot link instructing the user's device to receive the broadcast of the song when the command button is activated.

EX1001, 11:22-33¹.

¹ Emphasis is added throughout unless otherwise noted.

The action to be performed upon activation of the hot link can be determined automatically, and can depend on the capabilities of the receiving device.

FIG. 11 illustrates a set of *exemplary actions* that may be included within a hot link message, according to one embodiment of the invention. Action routine 1105 is associated with broadcast action 1110, Internet action 1120, download action 1130, upload action 1140, call action 1150, and other action 1160. The *action to include within the hot link* may be provided in many different ways. For example, the *action* may be *automatically identified* based on the current use of the device generating the hot link, or manually selected by the user

* * *

FIG. 13 illustrates a process for generating a hot link message for a device The information is used to prepare the *message* according to the *specifications of the receiving devices*. For example, the instructions to *tune a personal computer* to a particular broadcast may be *different* than to *tune a mobile device* to the same *broadcast*.

EX1001, 16:3-17:20.

B. Prosecution History

During prosecution of the application leading to the '169 patent, the Examiner considered and dismissed the type of references that Petitioner relies on in the Petition. In particular, the Examiner initially rejected the claims over art that, as in Rothschild, discloses a template for composing email, and art that discloses messages containing URL hyperlinks. Then, after argument by Applicant distinguishing this type of art, the Examiner allowed the claims. Petitioner's revisiting of this same type of art similarly fails.

1. The Examiner’s reasons for allowance distinguished the type of art relied upon in the Petition.

The Examiner allowed the claims after analyzing and citing specific passages from O’Neal (EX2005), which is similar in relevant part to the asserted Rothschild reference. As discussed below, both O’Neal and Rothschild disclose a template that allows users to create email messages with attachments. The Examiner called O’Neal the “closest prior art of record,” but found that it does not disclose multiple limitations including “in response to detection of a trigger, determine an action”—which Petitioner’s art also fails to show, as discussed below (Section III.B). EX1002, 48. Specifically, the Examiner determined the following:

The following is an examiner’s statement of reasons for allowance: 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.

Id.

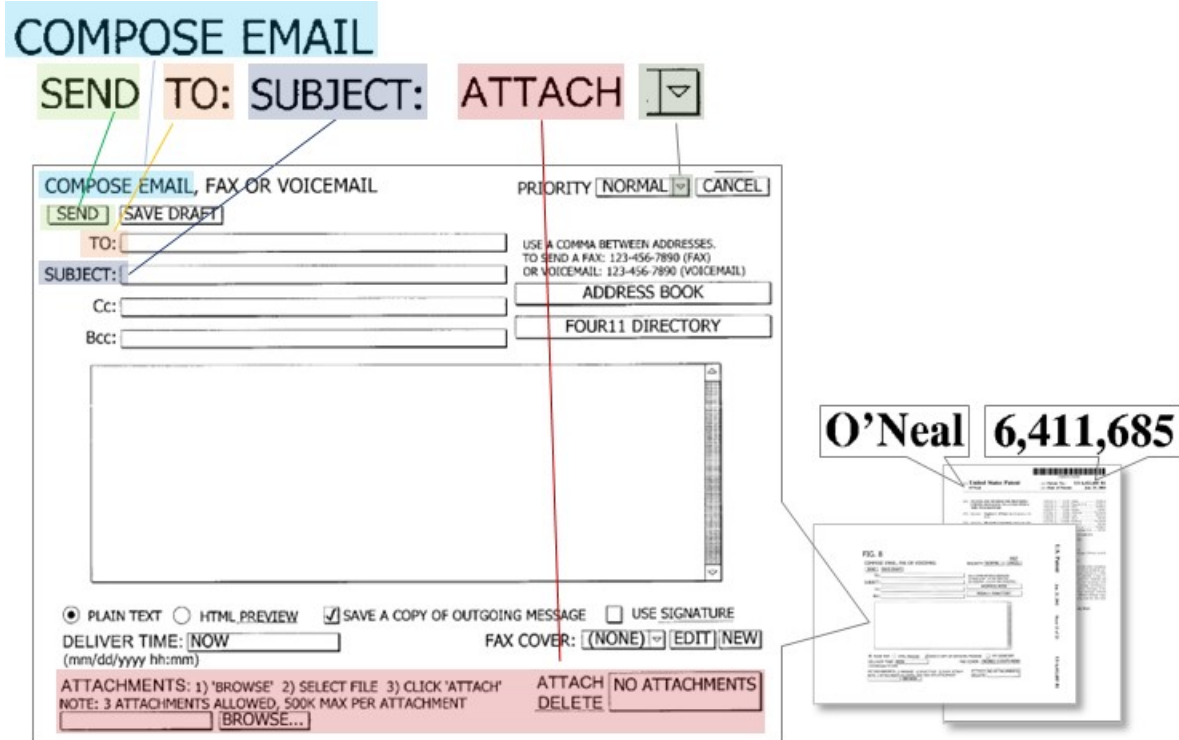
After an RCE, *id.*, 149-150, the Examiner rejected the claims as being obvious in view of O’Neal, in combination with other references. *Id.*, 120-130. For the limitation “in response to detection of a trigger, determine an action to be performed upon activation of the hot link based on the trigger,” the Examiner relied in part on O’Neal at col. 6, lines 13-24, which discusses details of

“commonly available full-featured e-mail clients.” *Id.*, 121; EX2005, 6:14-16. For the limitation “generat[ing] a hot link message to include the determined action,” the Examiner relied on O’Neal at col. 15 lines 1-19. EX1002, 121. That cited passage, in turn, refers to a template for composing “common web based e-mail,” as depicted in O’Neal’s Figure 8:

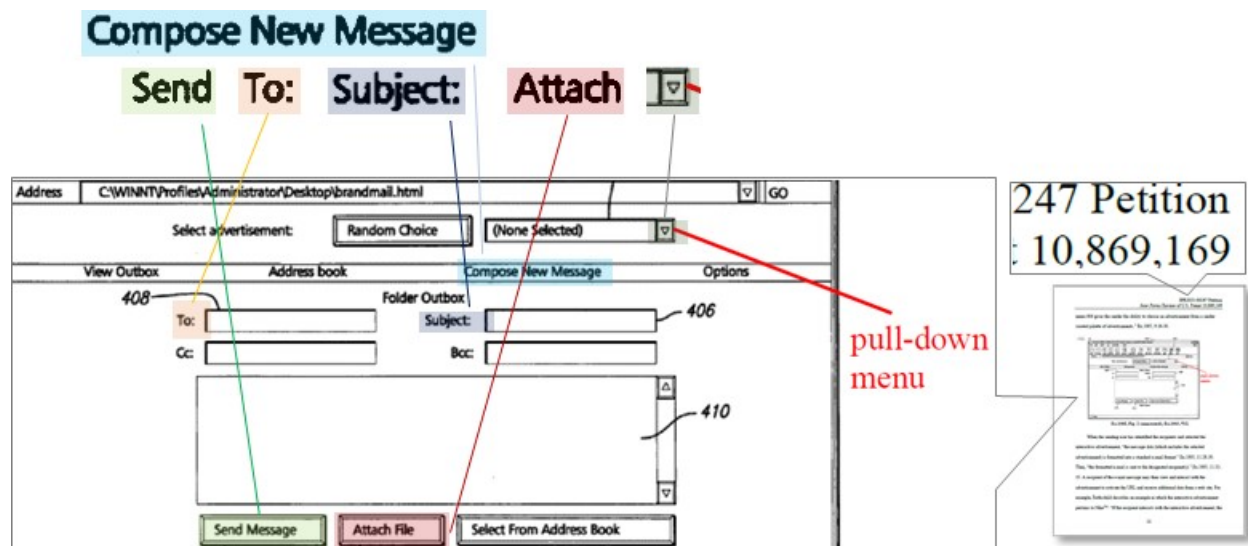
FIG. 8 is the *compose template* downloaded in response to a click on the compose link of the template of FIG. 7. A *message may be composed in this template* in the manner similar to *common web based e-mail*. A “to” field, a “subject” field, a “cc” field and a “bcc” field are all provided.

EX2005, 15:14-19.

The message composition template shown in O’Neal’s Figure 8 is very similar to Rothschild’s Figure 4 that Petitioner relies on. As shown below, both templates allow composing email, with fields, buttons, and drop-down menus for “send,” “to,” “subject,” “attach,” and other common email functionality.



EX2005, FIG. 8 (annotated).



Pet., 23, citing EX1005, FIG. 4 (annotated).

In response to the Office Action, Applicant argued, among other things, that the “commonly available full-featured e-mail clients” disclosure of O’Neal “does not disclose or fairly suggest the use of hot links, let alone that the client

determines an action to be performed upon activation of a hot link.” EX1002, 109-110. Applicant further argued that O’Neal does not teach the “generat[ing] a hot link limitation,” because “[g]enerating a message to include a hot link does not necessarily flow from the mere discussion of clicking an icon to download a compose message template.” *Id.*, 110-111. Consequently, the Examiner withdrew the rejection based on the type of commonly available full-featured e-mail clients found in O’Neal, which is similar to Rothschild. *Id.*, 85. And after Applicant filed a Terminal Disclaimer, *id.*, 64-65, the claims were allowed. *Id.*, 48-49.

2. The Examiner cited art that disclosed emails containing a URL hyperlink.

The Examiner also relied on Schwartz (EX2006) in combination with O’Neal to reject the claims. EX1002, 120-130. Schwartz discloses messages with URL hyperlinks. The Applicant expressly pointed out the URLs to the Examiner when responding to one such rejection:

Schwartz is generally directed to replacing ‘*universal resource locators [i.e., URLs]* in the incoming *message* with address identifiers’

Id., 107.

As the Schwartz reference states:

[I]ncoming *messages* to the mobile device, including notification and requests, and which *typically has* one or more *universal resource identifiers or locators [i.e., URLs]*, are processed in the link server device to generate compact messages.

EX2006, 3:2-5.

In fact, the Applicant distinguished Schwartz’s disclosure from the claims, arguing “[t]he cited section of *Schwartz* [does] not include any discussion of triggers, and the entirety of *Schwartz* does not include any discussion of triggers.” EX1002, 107. Thus, the Examiner allowed the claims knowing full well that prior art disclosed messages containing URLs—exactly the type of disclosure that Petitioner reuses here.

C. Person of Ordinary Skill in the Art

Patent Owner applies Petitioner’s definition of a POSITA and level of ordinary skill for purposes of this preliminary response. *See* Pet., 11-12. However, Patent Owner does not concede that Petitioner’s definition is correct.

D. Claim Construction

Like Petitioner, Patent Owner submits that the terms should be given their plain and ordinary meaning for the purposes of this proceeding. Pet., 12 (“[T]he terms of the Challenged Claims should be given their plain and ordinary meaning, and no terms require specific construction.”).

III. THE PETITION FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CHALLENGED CLAIM.

Each of the Petition’s Grounds 1-6 rely on Rothschild as the primary reference. Petitioner’s asserted Grounds for independent claims 1 and 10 fail because they do not disclose the limitation “*in response to* detection of a trigger, determine an action.” In each of the Rothschild obviousness Grounds, the alleged

action (i.e., determining whether interacting with the ad will fetch additional data) is determined *before*—not “in response to”—detection of the alleged trigger.

Furthermore, the Petition does not clearly explain how the references disclose the claimed trigger. With respect to Petitioner’s asserted Grounds for independent claim 18, the asserted art does not disclose or suggest the “assignment” limitation. Thus, Petitioner does not demonstrate a reasonable likelihood of prevailing on any independent claim (and therefore any challenged claim). For at least these reasons, the Board should deny institution.

A. Summaries of the Asserted References

1. Rothschild

Rothschild describes the field of the invention as:

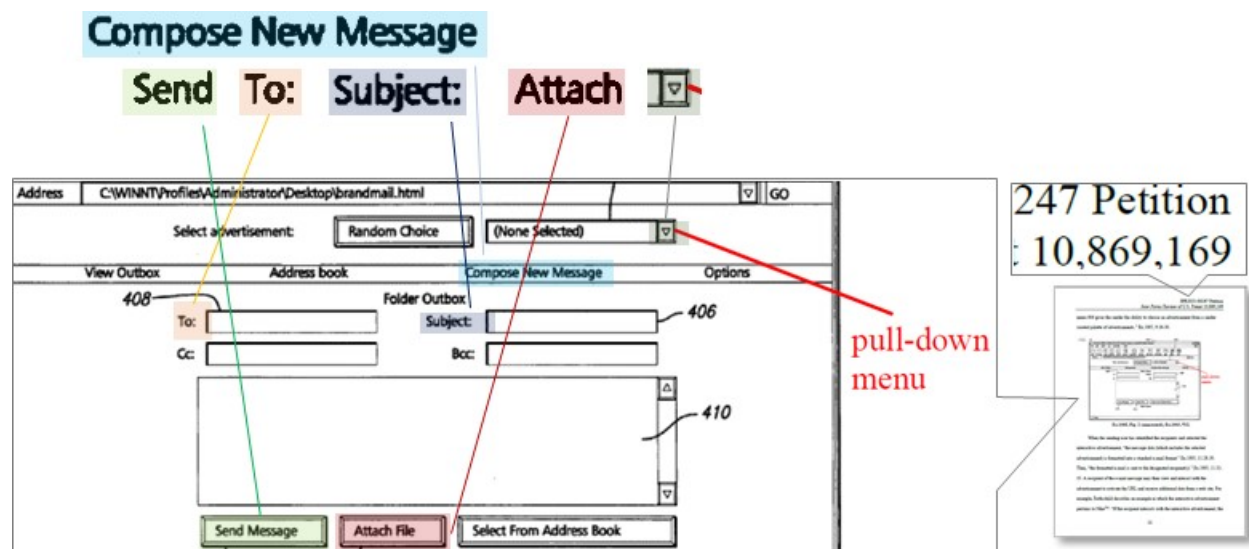
The present invention . . . allows an Internet user to place an advertisement within a personal communication, and provides a recipient of the personal communication requesting additional information with such information

EX1005, 1:24-31. In particular, Rothschild discloses that users create emails and insert advertisements into those emails using a message composition template.

EX1005, 9:11-29 (“If the sender indicates a desire to send an e-mail to a recipient, he may be provided with an e-mail communication page 402, as shown in FIG. 4. . . . 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 advertisement can include a URL for retrieving additional information. EX1005,

11:60-65 (“[I]f the advertisement is interactive, . . . additional communication data will be provided The location of the additional communication data . . . is contained in a URL embedded within the interactive advertisement.”).

Rothschild’s Figure 4 depicts a message composition template with buttons and fields for “send,” “to,” “subject,” “attach,” and other common email functionality. “FIG. 4. is a diagram illustrating an exemplary Web page utilized to gather data for providing a recipient with an e-mail containing a sender-selected advertisement.” EX1005, 5:62-64.



Pet., 23, citing EX1005, FIG. 4 (annotated).

Importantly, in Rothschild an advertiser determines whether the ad will be “interactive” (i.e., include an embedded URL that fetches data) or “static” (not include a URL) *before* a user selects the ad, and before the server receives the user’s ad selection. EX1005, 11:5-33; *see infra*.

Once the *advertiser* is logged on, the advertiser can ... *upload an advertisement* to the Web site 110. ... The *advertiser* should *at this time specify* whether the *advertisement* is *static or interactive*. If it is interactive, the additional communication data provided upon interaction, or the location of such data, should be provided so that the additional communication data can be provided to any recipient interacting with the interactive advertisement.

EX1005, 13:26-49.

If the advertisement contained in the e-mail is *static*, it can be displayed However, if the advertisement is *interactive*, and the advertisement is interacted with, additional communication data will be provided to the recipient network device 130. The location of the additional communication data (or a pointer to the data) is contained in a *URL embedded* within the *interactive advertisement*.

Id., 11:57-65.

As explained below, the step that Petitioner asserts discloses the claimed “detection of a trigger” (i.e., receiving the user’s ad selection) occurs only *after* the alleged action has been determined. That is, the advertiser has already:

1) determined whether interacting with the ad will fetch additional data (the alleged “action”); 2) determined the ad’s URL (if any); and 3) uploaded the ad.

As also explained below, Rothschild does not disclose assigning a hot link. Rothschild does not disclose any details regarding how to embed a URL in an ad, and Petitioner does not assert otherwise. Pet., 20-24, 41-43.

Rothschild is the only reference that Petitioner discusses on a limitation-by-limitation basis for each challenged independent claim.

2. Chen, Saltanov, Maes

Chen relates to add-on services for email. EX1007, 1:6-8 (“The present invention relates to systems and methods for providing add-on services to emails transferred via a distributed computer network.”). Petitioner nominally cites Chen in combination with Rothschild in Grounds 4-6, but merely as evidence for the contention that it would have been obvious to “implement Rothschild’s interactive advertisements using HTML”—without any limitation-by-limitation allegations involving Chen. Pet., 78, 82.

Petitioner does not allege that Chen discloses any particular limitation, and specifically, Petitioner does not rely on Chen for the claimed trigger or the computer system’s particular response to the detection thereof. Nor does Petitioner allege that Chen cures any of the deficiencies in Rothschild identified herein. *Id.*

Petitioner also relies on Saltanov and/or Maes, but only for dependent claims 19 and 20 (Grounds 2, 3, 5, and 6). Petitioner does not allege that Saltanov or Maes is relevant to the independent claims. Accordingly, Saltanov and Maes are not relevant to the analysis here.

B. Rothschild does not disclose “*in response to detection of a trigger, determine an action to be performed upon activation of a hotlink.*”

Independent claims 1 and 10 each recite: “*in response to detection of a trigger, determine an action to be performed upon activation of the hot link.*”

Petitioner relies on Rothschild alone as disclosing this element. Pet., 29-30. But in

Rothschild, the alleged action is determined *before* the alleged trigger is created—let alone detected—and therefore the action cannot be determined *in response to* detection of the trigger, as the claims require.

In Petitioner’s discussion of Element [1.2], the alleged “detection of a trigger” and the “action to be performed” that is determined in response are as follows.² Petitioner asserts the “detection of a trigger” corresponds to the server receiving the user’s ad selection. Pet., 29 (“When the server receives the user’s advertisement selection (‘detection of the trigger’) . . .”). The user’s ad selection,

² As discussed below in Section III.C, the Petition does not specify with particularity which disclosures in Rothschild allegedly correspond to the claimed trigger. It is unclear whether Petitioner is alleging that the trigger is the user’s selection of an ad from a pull-down menu, or the pull-down menu itself. For purposes of the argument in this section, however, Patent Owner addresses the passages cited in the Petition for the “detecting” element (Element [1.2] in Petitioner’s labeling of the claims)—namely, that the user’s selection is the “trigger.” For Petitioner’s assertion in Element [1.1] that the pull-down menu itself is the “trigger,” there is no corresponding allegation in Element [1.2] of 1) any detection of the pull-down menu, nor 2) any determination of an action in response to detecting the pull-down menu.

in turn, is made from a pull-down menu. Pet., 27 (“[T]he user selects an advertisement from the pull-down menu.”). Petitioner asserts the “action to be performed upon activation of the hot link” that is “determine[d]” is the retrieval of additional information from an address specified by a URL that is embedded in an advertisement. *Id.*, 30 (“retrieval of additional information (‘action to be performed upon activation of the hot link’)”), 29 (“The URL helps define ‘the action to be performed’ by defining the location of data on the Internet from where additional data is retrieved . . .”).

Petitioner’s argument fails, however, because the “action to be performed upon activation of the hot link” in Rothschild (*i.e.*, the retrieval of additional information) is determined *before*—not *in response to*—the “detection” (receipt of the user’s ad selection). Specifically, as discussed in more detail below, during an ad upload process, an advertiser determines whether or not interacting with the ad will fetch additional information, and if so, what URL is embedded in the ad. EX1005, 11:57-65, 13:26-49. And, importantly, this ad upload process must be completed *before* any user can select the ad, and therefore before the server detects the user’s selection. *Id.*, 9:26-52. By the time the server receives the selected ad from the user, the ad already exists in its final form and does not change. *Id.*, 11:5-33. It either contains an embedded URL, or not. The server does not determine the “action to be performed” in response to receiving the user’s ad, *i.e.*, whether

clicking on the ad will retrieve additional information, or what URL will be used.

Instead, if the ad does not include a URL, the server sends an email without any URL; but if the ad does have a URL, it is the URL that the advertiser chose for the ad—before the user selected the ad, and before the server receives the user’s ad selection. *Id.*, 11:5-33.

Before the user can select an ad, Rothschild requires an earlier step. During an advertisement upload process, an advertiser determines whether the ad will be “interactive” (include an embedded URL) or “static” (not include a URL).

Once the *advertiser* is logged on, the advertiser can . . . *upload an advertisement* to the Web site 110.

. . .

The *advertiser* should *at this time specify* whether the *advertisement* is *static or interactive*. If it is interactive, the additional communication data provided upon interaction, or the location of such data, should be provided so that the additional communication data can be provided to any recipient interacting with the interactive advertisement.

Id., 13:26-49.

If the advertisement contained in the e-mail is *static*, it can be displayed However, if the advertisement is *interactive*, and the advertisement is interacted with, additional communication data will be provided to the recipient network device 130. The location of the additional communication data (or a pointer to the data) is contained in a *URL embedded* within the *interactive advertisement*.

Id., 11:57-65.

Petitioner relies on steps (i.e., receiving the user's email, which may include an ad, and sending the email) that occur only after the advertiser already performed the steps described above, that is: 1) determined whether interacting with the ad will fetch additional data (the alleged "action"); 2) determined the ad's URL (if any); and 3) uploaded the ad.

When the user selects an ad from the pull-down menu, the menu only includes ads that already exist—specifically, ads that the user previously chose to include in the list of options.

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.

Each sender is allowed to generate an individual palette of advertisements The palette contains *advertisements* that the *sender has previously selected*. . . . Once the sender has a palette of advertisements, *those particular advertisements* will be displayed to the sender through the pull down menu 404. The sender has the option, through the pull down menu 404, to *select an advertisement to accompany the e-mail*

Id., 9:26-52.

After the user selects the ad, the server receives data that includes the selected ad. The server merely formats the existing data, which includes the ad that the user selected, then sends the email.

At step 508, the advertising application provides the sender network device with an e-mail communication page (see FIG. 4), enabling the

sender to enter at least one designated recipient, the subject matter, the content, any attachments, and a selected advertisement that should accompany the completed e-mail. The end result is a compilation of data that includes sender data, advertisement data, and message data. . . . At step 512, the advertising application receives the compilation of data, which includes message data, sender data, and advertisement data, and assigns an identification number to the message data. . . . 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).

Id., 11:5-33.

Thus, as evinced by the disclosures of Rothschild discussed above, Rothschild's server merely formats the data it receives from a user. Rothschild does not disclose altering the data or the selected ad to insert a URL, and Petitioner does not allege otherwise. If the user chose to not include an ad, the server does not include one. If the user selected a static ad with no URL, the server does not insert a URL into the ad. If the user selected an ad that does have an embedded URL, the server does not create or edit the URL. Thus, the server does not determine anything regarding "retrieval of additional information" (the alleged "action"). Instead, the advertiser does, during the ad upload process. Accordingly, Rothschild does not disclose determining an action "in response to detecting a trigger," as required by the claims.

Furthermore, Petitioner asserts that "determining an action" can occur when the server inserts the ad into the email. Pet., 29 ("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 email message.”). That cannot be a determination of the alleged “action,” however, because the alleged “action” is retrieving information. *See, e.g., id.*, 30 (“retrieval of additional information (‘*action to be performed upon activation of the hot link*’)” (emphasis in original)).

Rothschild’s server does not determine whether an ad includes a URL or not. If the ad does include a URL, Rothschild’s server does not determine what the URL is. That is, the server does not determine whether clicking on the ad will lead to retrieving information. The server merely handles pre-existing ads that already have an embedded URL, or not. Further, Rothschild’s server merely reformats existing incoming data—including a pre-existing ad. The server does not insert the ad into the data that it receives from the user. EX1005, 11:3-10.

Accordingly, Rothschild does not disclose, teach, or suggest, “in response to detection of a trigger, determine an action to be performed upon activation of the hot link,” as recited in both independent claims 1 and 10. Petitioner, therefore, has not shown a reasonable likelihood of prevailing on its assertion that claims 1 and 10, or claims 2-9 and 11-17, which respectively depend therefrom, would have been obvious in view of Rothschild alone or in combination with other references.

C. The Petition fails to specify with particularity where the asserted art discloses each element of independent claims 1 and 10.

Petitioner is required to identify “with particularity, . . . the grounds on which the challenge to each claim is based,” and must “specify where each element of the claims is found in the prior art patents or printed publications relied upon.” 35 U.S.C. § 312(3); 37 C.F.R. § 42.104(b)(4). Petitioner fails to meet this burden here. Instead, the Petition lays out incomplete theories, engaging in hand waving without explaining how Rothschild supposedly renders the claims obvious.

Independent claim 1 requires that the computer system both “*identify a trigger to generate a hot link*” and “*in response to detection of the trigger, determine an action to be performed upon activation of the hot link.*” Petitioner, however, relies on two different aspects of Rothschild as allegedly disclosing the claimed “trigger”—the user’s selection of an ad from a pull-down menu, Pet., 28, and the pull-down menu itself, *id.*, 26-27—making Petitioner’s argument vague and unclear. Petitioner also relies on a user’s selection of an ad from the pull-down menu as disclosing *both* the claimed “identify[ing]” and “detection,” without explaining why it qualifies as either, let alone both. *Id.*, 28-29; *see Becton, Dickinson and Co. v. Tyco Healthcare Gr., LP*, 616 F.3d 1249 (Fed. Cir. 2010) (“Where a claim lists elements separately, ‘the clear implication of the claim language’ is that those elements are ‘distinct component[s]’ of the patented invention.”); *Engel Indus., Inc. v. Lockformer Co.*, 96 F.3d 1398, 1404-05 (Fed.

Cir. 1996) (concluding that where a claim provides for two separate elements, a “second portion” and a “return portion,” these two elements “logically cannot be one and the same”).

First, Petitioner contends the claimed “trigger” is taught by Rothschild’s pull-down menu. Pet., 26 (“Rothschild describes a ‘*trigger*’ for generating an interactive advertisement (‘hot link’) *in the form of a pull-down menu* for selecting an interactive advertisement.”). Petitioner further asserts that the claimed “identifying” occurs when the message template is sent to a user—before the user interacts with it. *Id.*, 27 (“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.*”), 28 (“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.”).

Petitioner also contends that the claimed “trigger” is taught by the user’s selection of an ad from a pull-down menu. *Id.*, 28 (“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.”). So Petitioner relies *both* on 1) the selection mechanism (i.e., the pull-down menu itself) and 2) receiving the selection therefrom, as teaching the claimed trigger.

Compounding the confusion in Petitioner’s discussion is the fact that Petitioner relies upon the *same teaching* of Rothschild—the server’s receipt of the user’s ad selection from the pull-down menu—as disclosing both the claimed “identifying” and “detecting” a trigger.

- “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.” *Id.*, 28.
- “When the server *receives the user’s advertisement selection* (‘*detection of the trigger*’)” *Id.*, 29.

The Petition does not explain how receiving the user’s selection qualifies as either “identifying” or “detecting.” Nor does the Petition explain why the same step of Rothschild could satisfy both limitations.

Accordingly, Petitioner has not met its burden to explain with particularity why claim 1 would have been obvious over Rothschild, alone or in combination with the other cited references.³ Like claim 1, claim 10 recites: “in response to *detection of the trigger*, determine an action to be performed upon activation of the

³ As noted, the Petition also alleges the independent claims would have been obvious over Rothschild in view of Chen. However, Petitioner does not rely upon Chen for these claim limitations.

hot link.” In challenging independent claim 10, Petitioner simply refers back to its discussion of claim 1 for this element. *See id.*, 52-53. Thus, the lack of specificity and confusion as to Petitioner’s claim 1 challenge is also present for claim 10. For this additional reason, Petitioner has not shown a reasonable likelihood in prevailing on its challenge of claims 1 and 10, or of claims 2-9 and 11-17, which respectively depend therefrom.

D. Rothschild does not disclose, teach, or suggest the “assignment” limitation of independent claim 18.

Independent claim 18 recites “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).” In addressing this limitation, the Petition merely cross-references its discussion of dependent claim 6. Pet., 58-59. Yet Petitioner’s discussion of claim 6 makes a circular argument that Petitioner never resolves—namely, that the data assigns the ad to itself. Specifically, Petitioner asserts that a POSITA would understand that 1) data in an email would 2) assign the icon (or graphic, etc.) to the advertisement. *Id.*, 43 (“data contained within an e-mail messages [sic] that associates the graphic, text, or icon with the advertisement”) (“assign the graphic to the interactive advertisement”). Petitioner cites nothing in Rothschild regarding data in an email that assigns an ad to an icon. Tacitly conceding that there is no such disclosure in Rothschild, Petitioner fabricates an example of HTML code for purposes of the Petition, citing the HTML

specification and its own declarant's testimony, but not Rothschild. *Id.*, 43, citing EX1011 (HTML Specification) and EX1003 (Houh Declaration). Rothschild does not mention the term "HTML" and Petitioner does not assert otherwise. Further, as Petitioner itself points out a page earlier in the same discussion, Rothschild's interactive ad is itself an icon. Pet., 42, quoting EX1005, 8:21-24 ("An *interactive advertisement is an icon*, graphic, text, or voice message that can be interacted with . . ."). Thus, under Petitioner's logic, undisclosed data assigns the ad (which is an icon) to itself. Petitioner merely repeats that circular argument in discussing claim 18, citing its discussion of claim 6.

Accordingly, Rothschild does not disclose, teach, or suggest, "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 recited in independent claim 18. Petitioner, therefore, has not shown a reasonable likelihood of prevailing that claim 18, or claims 19-22, which depend therefrom, would have been obvious in view of Rothschild—alone or in combination with other references.

E. Petitioner does not demonstrate a reasonable likelihood of prevailing for any of the challenged claims, let alone for a substantial number of claims to warrant institution.

For all the reasons discussed above, Petitioner does not demonstrate a reasonable likelihood of prevailing in showing the obviousness of any of the

independent claims of the '169 patent, which require, among other limitations, a “trigger” (claims 1 and 10), “in response to detection of a trigger, determine an action” (claims 1 and 10), “identifying a trigger” (claim 1), and “assignment” (claim 18), or their respective dependent claims.

Patent Owner also notes that, given the differences in claim scope of the three independent claims, even if the Petition had established a reasonable likelihood of success for one of the independent claims—and it has not—instituting trial would still be a waste of the Board’s and the parties’ resources. Discretionary denial is appropriate when a petition fails to establish a reasonable likelihood of success for a substantial number of the challenged claims. See *Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper 9 (PTAB Nov. 7, 2018) (informative) (denying institution where petition did not establish likelihood of success for a sufficient number of grounds/claims); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (P.T.A.B. Jan. 24, 2019) (informative) (denying institution where petition did not establish likelihood of success for a sufficient number of grounds/claims).

IV. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION IN VIEW OF PARALLEL PROCEEDINGS.

The Board should deny institution under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) (“*Fintiv*”) because the

Fintiv analysis favors denial. As set forth below, four of the *Fintiv* factors weigh in favor of denying institution.

A. Factor 1 is neutral because the parallel litigation has not been stayed.

Factor 1 is neutral because the parallel litigation has not been stayed and the Petition presents no evidence that a stay may be granted. The district court litigation has not been stayed in view of this IPR Petition and Petitioner has not moved for such a stay nor indicated that it will file a motion to stay. Patent Owner will oppose any motion to stay.

B. Factor 2 is neutral or does not favor exercising discretion because no trial date has been set.

Factor 2 is neutral or does not favor exercising discretion because no trial date has been set and therefore it is unknown whether the district court will reach a decision on validity issues before the Board issues a final written decision.

C. Factor 3 favors denial because, by the institution deadline, the parties and the trial court will have made significant investment in the parallel litigation.

Factor 3 favors denial. This factor considers “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9. Here, the parallel litigation proceeded for twelve months before the Petitioner filed the Petition on November 30, 2022, one day before the § 315(b) deadline. As such, significant time and resources have been being expended in the parallel litigation. The parties served

infringement contentions and invalidity contentions prior to the case's transfer to the Northern District of California. Since the transfer, Patent Owner has served infringement contentions, Petitioner served invalidity contentions on March 3, 2023, and the parties have served and responded to written discovery requests. By the institution decision due date, the parties will have exchanged proposed terms for construction and will have completed claim construction discovery. These significant endeavors are clear indicators that institution would lead to significant duplicative costs.

Petitioner's claim of diligence in filing the Petition lacks credibility. Pet., 13. Petitioner waited 12 months after the Complaint was served in district court and more than six months after serving its initial invalidity contentions in the Western District of Texas prior to filing the Petition. Petitioner does not offer any explanation for its lengthy delay. This factor therefore favors denial.

D. Factor 4 strongly favors denial because there is significant overlap between the art and issues raised in the Petition and the parallel litigation.

Factor 4 also favors denial. When a "petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial." *Fintiv*, Paper 11 at 12. Here, Petitioner challenges all the claims asserted in the parallel district court litigation (claims 1, 4, 5, 7, 9, 10, 13–15, and 17–22). EX2002.

Additionally, there is significant overlap between the references and invalidity theories applied in the Petition and the invalidity contentions presented in the parallel litigation. With respect to the Petition's Grounds 1-6, the invalidity contentions assert that the same references cited in the Petition—i.e., Rothschild, optionally combined with Saltanov, Maes, and/or Chen (among others)—render obvious all of the claims asserted in the district court. EX2003.

Further, Petitioner has not stipulated, either in the district court or in the Petition, that it will not pursue invalidity in the parallel litigation based on any instituted IPR ground. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (P.T.A.B. Dec. 1, 2020) (precedential as to § II.A); *Sand Revolution II, LLC v. Continental Intermodal Group–Trucking LLC*, IPR2019-01393, Paper 24 at 11-12 (P.T.A.B. June 16, 2020) (informative). As things stand, Petitioner could pursue substantially overlapping invalidity arguments in the trial court, using identical references. This potential overlap of issues favors denying the Petition to avoid the Board duplicating the trial court's efforts and potentially reaching inconsistent results.

E. Factor 5 favors denial because Google is both Petitioner in this IPR and Defendant in the parallel litigation.

Factor 5 favors denial because the Petitioner in this IPR, Google, is the defendant in the parallel district court proceeding. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (P.T.A.B. May 13, 2020) (informative) (“Because

the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”). Petitioner is incorrect that this factor is neutral simply because it is normally the case that a petitioner and defendant would be the same party. Identity of the parties is the precise inquiry of this factor. Therefore, because the parties are the same, this factor weighs clearly in favor of discretionary denial.

F. Factor 6 favors denial because the merits of the Petition are weak and lacking in evidence.

Factor 6 also favors denial. Factor 6 is a catchall, considering “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv*, Paper 11 at 14. “[I]f the merits of the grounds raised in the petition are a close[] call, then that fact has favored denying institution when other factors favoring denial are present.” *Fintiv*, Paper 11 at 14-15. Despite Petitioner’s assertion, the Petition does not present “compelling evidence of unpatentability” sufficient to save it from discretionary denial. Pet., 17. As explained in Section III, above, the Petition’s invalidity arguments suffer several fatal flaws, failing to meet even the reasonable likelihood threshold required for institution. The “compelling merits” standard is a higher standard than the institution threshold, and thus the Petition’s invalidity arguments are even further from satisfying the compelling merits standard. June 21, 2022 *Fintiv* Memorandum, 4-5; *see also CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 3 (P.T.A.B. Feb.

27, 2023) (precedential, *sua sponte* Director review decision) (“[T]he compelling merits standard is a higher standard than the standard for institution set by statute.”).

Accordingly, four of the six *Fintiv* factors support denying institution, one is neutral, and the other is neutral or does not favor exercising discretion. Balancing these factors and taking a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review, the Board should deny institution.

V. CONCLUSION

Petitioner failed to meet its burden under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(c) to show a reasonable likelihood of success that any of the challenged claims are unpatentable because, for example, the alleged action is determined before—not in response to—detection of the alleged trigger (claims 1 and 10) and there is no disclosure of the claimed “assignment” (claim 18). Moreover, the Board should exercise its discretion to deny institution in light of parallel proceedings. Patent Owner respectfully requests that the Board deny institution of *inter partes* review.

Respectfully submitted,

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CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))

1. This Patent Owner Preliminary Response complies with the type-volume limitation of 14,000 words, comprising 6,764 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

2. This Patent Owner Preliminary Response complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word 2016 in 14-point Times New Roman font.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER PRELIMINARY RESPONSE UNDER 37 C.F.R. § 42.107(a)** and **EXHIBITS 2002-2003 and 2005-2006** were served electronically via e-mail on March 16, 2023, in their entireties on the following counsel of record for Petitioner:

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