

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

WILDSEED MOBILE, LLC,
Patent Owner.

IPR2023-00247
Patent 10,869,169 B2

Before KARL D. EASTHOM, TERRENCE W. McMILLIN, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

CYGAN, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

Google LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of claims 1–22 of U.S. Patent No. 10,869,169 B2 (Ex. 1001, the “’169 patent”). Wildseed Mobile LLC (“Patent Owner”) filed a Preliminary Response (“Prelim. Resp.”). Paper 6. We authorized additional briefing on certain matters. Exs. 3001, 3002. Petitioner filed a Reply (Paper 7, “Pet. Reply”) and Patent Owner filed a Sur-reply (Paper 8, “PO Sur-reply”).

Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may be instituted only if “the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons given below, on this record Petitioner has established a reasonable likelihood that it would prevail in showing the unpatentability of at least claim 1 of the ’169 patent. Accordingly, we institute an *inter partes* review as to claims 1–22 of the ’169 patent and all of the asserted grounds of unpatentability.

B. *Real Parties in Interest*

Petitioner identifies Google LLC and YouTube, LLC as the real parties in interest. Pet. 84. Petitioner identifies Google LLC as a subsidiary of XXVI Holdings, Inc., which is a subsidiary of Alphabet Inc., but states that XXVI Holdings Inc. and Alphabet Inc. are not real parties in interest to this proceeding. *Id.* n.3. Patent Owner identifies Wildseed Mobile LLC as the real party in interest. Paper 5, 1.

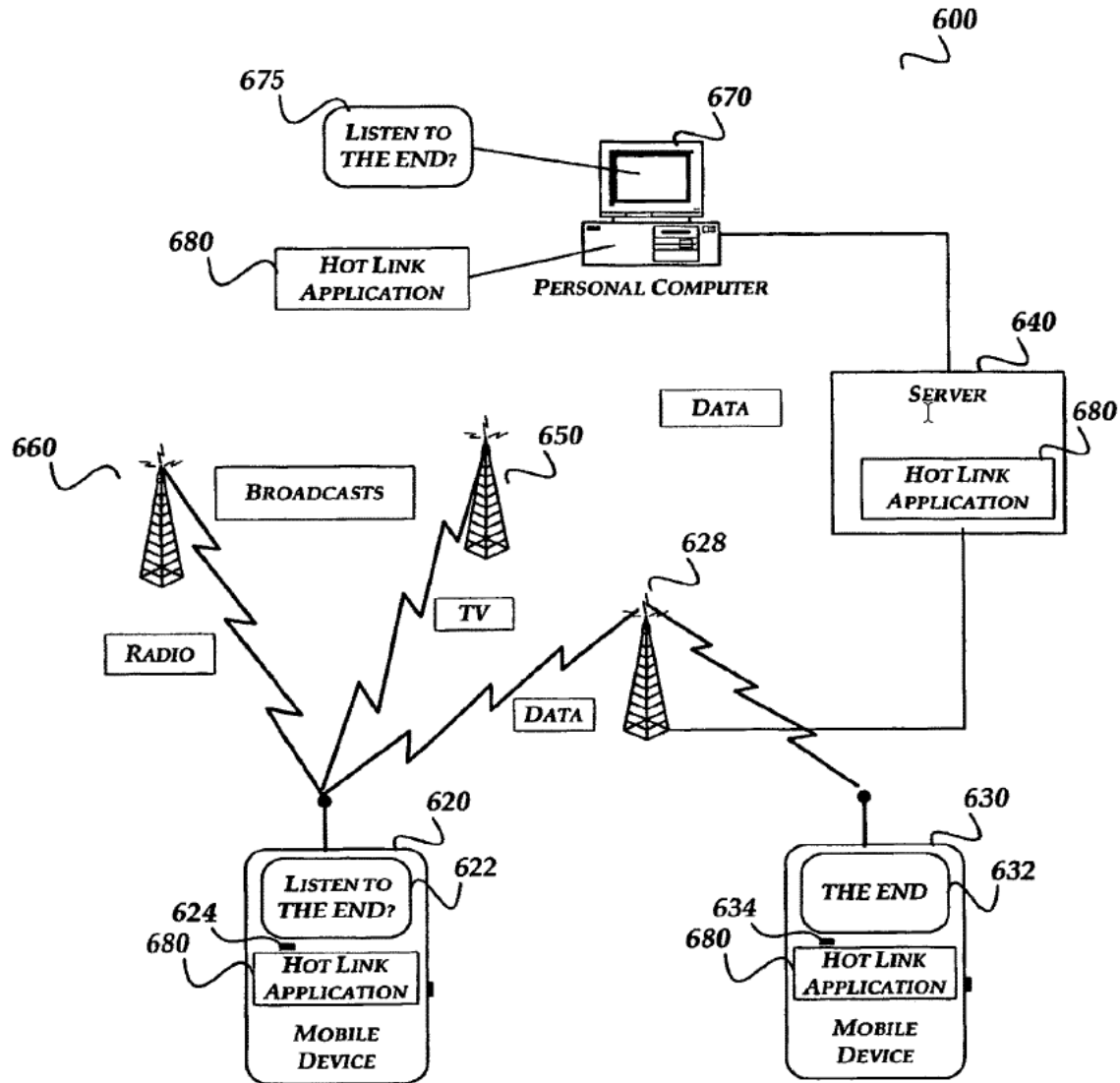
C. Related Matters

The parties represent that the '169 patent is involved in *Wildseed Mobile LLC v. Google LLC et al.*, 3-22-cv-04928, N.D. CA, filed August 29, 2022. Pet. 84; Paper 5, 1. Petitioner further represents that the '169 patent is involved in *Wildseed Mobile LLC v. Google LLC et al.*, 6-22-cv-00357, W.D. TX, filed April 4, 2022; however, Patent Owner states that this is the original filing of the first-listed case. Pet. 84; Paper 5, 1. Petitioner further represents that the '169 patent is involved in *Wildseed Mobile LLC v. Google LLC et al.*, 6-21-cv-01245, W.D. TX Oct. 8, 2021; however, Patent Owner states that this case has been voluntarily dismissed. Pet. 84; Paper 5, 1.

Patent Owner represents that Petitioner has filed, at the same time that this Petition was filed, petitions for *inter partes* review against related family members U.S. Patent No. 10,251,021 (IPR2023-00244), U.S. Patent No. 10,959,040 (IPR2023-00245), U.S. Patent No. 9,141,960 (IPR2023-00246), and U.S. Patent No. 7,376,414 (IPR2023-00248). Paper 5, 1.

D. The '169 Patent

The '169 patent is titled “Method and Systems for Generating and Sending a Hot Link Associated With a User Interface to a Device.” Ex. 1001, code (54). The '169 patent issued from Application Serial No. 15/839,396, filed on December 12, 2017, and claims priority through a chain of continuation applications to Provisional Application No. 60/290,592, filed on May 11, 2001. *Id.* at codes (21), (22), (60), (63). Figure 6, reproduced below, illustrates an environment implementing the disclosed invention:



As explained in the '169 patent,

FIG. 6 shows a functional block diagram of a hot link transfer system utilizing a server and mobile devices, in accordance with the present invention. As shown in the figure, hot link transfer system 600 includes personal computer 670, mobile device 620, mobile device 630, radio broadcast 660, TV broadcast 650, and data broadcast 626. Personal computer 670 includes display 675 and hot link application 680. Server 640 includes hot link application 680. Mobile device 620 includes display 622, command button 624, and hot link application 680. Mobile

device 630 includes display 632, command button 634, and hot link application 680.

Ex. 1001, 11:6–17.

As illustrated in Figure 6, the user of mobile device 630 is listening to a song titled “THE END.” Ex. 1001, 11:42–43. The user may select command button 634 to send a hot link to users of devices 620 and 670 that, when selected, will tune their devices to the broadcast currently playing “THE END.” *Id.* at 11:43–54. Users 620 and 670 may receive a message accompanying the hot link, such as, “Listen to THE END?” *Id.* at 11:60–64.

E. Illustrative Claim

Claim 1 is illustrative, and recites as follows:¹

[1.0] One or more non-transitory computer-readable media (NCRM) 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:

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

[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,

[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;

[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;

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

¹ Petitioner’s bracketing indicia have been added.

F. Evidence

Petitioner relies on the following patent evidence.

Name	Patent Document	Exhibit
Rothschild	U.S. Patent No. 8,645,211	1005
Saltanov	U.S. Patent No. 6,839,411	1006
Chen	U.S. Patent No. 6,836,792	1007
Maes	U.S. Pub. No. 2002/0002502 A1	1008

Petitioner relies upon a declaration by Dr. Henry Houh. Ex. 1003.

G. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–22 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–18, 21–22	103(a) ²	Rothschild
19	103(a)	Rothschild, Saltanov
20	103(a)	Rothschild, Saltanov, Maes
1–18, 21–22	103(a)	Rothschild, Chen
19	103(a)	Rothschild, Chen, Saltanov
20	103(a)	Rothschild, Chen, Saltanov, Maes

II. ANALYSIS

A. Legal Standards

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, “would have been obvious at the time the invention was made to a person having ordinary skill in the art [to which said subject matter pertains].” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398,

² Petitioner asserts, and we agree for purposes of institution, that the pre-AIA patentability scheme applies to the ’169 patent. *See* Pet. 19.

406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of non-obviousness.³ *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

Petitioner asserts that a person of ordinary skill in the art on or before May 11, 2001

would have had a working knowledge of the software and communication arts pertinent to the '169 patent . . . [and 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.

Pet. 11–12 (citing Ex. 1003 ¶¶ 18–20).

Patent Owner does not dispute Petitioner's assessment of the level of ordinary skill for the purposes of institution. Prelim. Resp. 9. Determining the level of ordinary skill in the art involves various factors, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citation omitted). The prior art of record also reflects the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). For purposes

³ Neither party presents evidence or arguments regarding objective evidence of non-obviousness at this stage.

of this Institution Decision, we adopt the assessment offered by Petitioner, as it is consistent with the '169 patent and the asserted prior art.

C. Claim Construction

In an *inter partes* review, we construe a patent claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b).” 37 C.F.R. § 42.100(b) (2019). Under this standard, the words of a claim generally are given their “ordinary and customary meaning,” which is the meaning the term would have to a person of ordinary skill at the time of the invention, in the context of the entire patent including the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

Here, Petitioner contends that “the terms of the Challenged Claims should be given their plain and ordinary meaning, and no terms require specific construction.” Pet. 12. Patent Owner “agrees with Petitioner that the terms of the Challenged Claims should be given their plain and ordinary meaning.” Prelim. Resp. 9.

At this stage, no need exists to construe any claim terms expressly to resolve the parties’ disputes. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

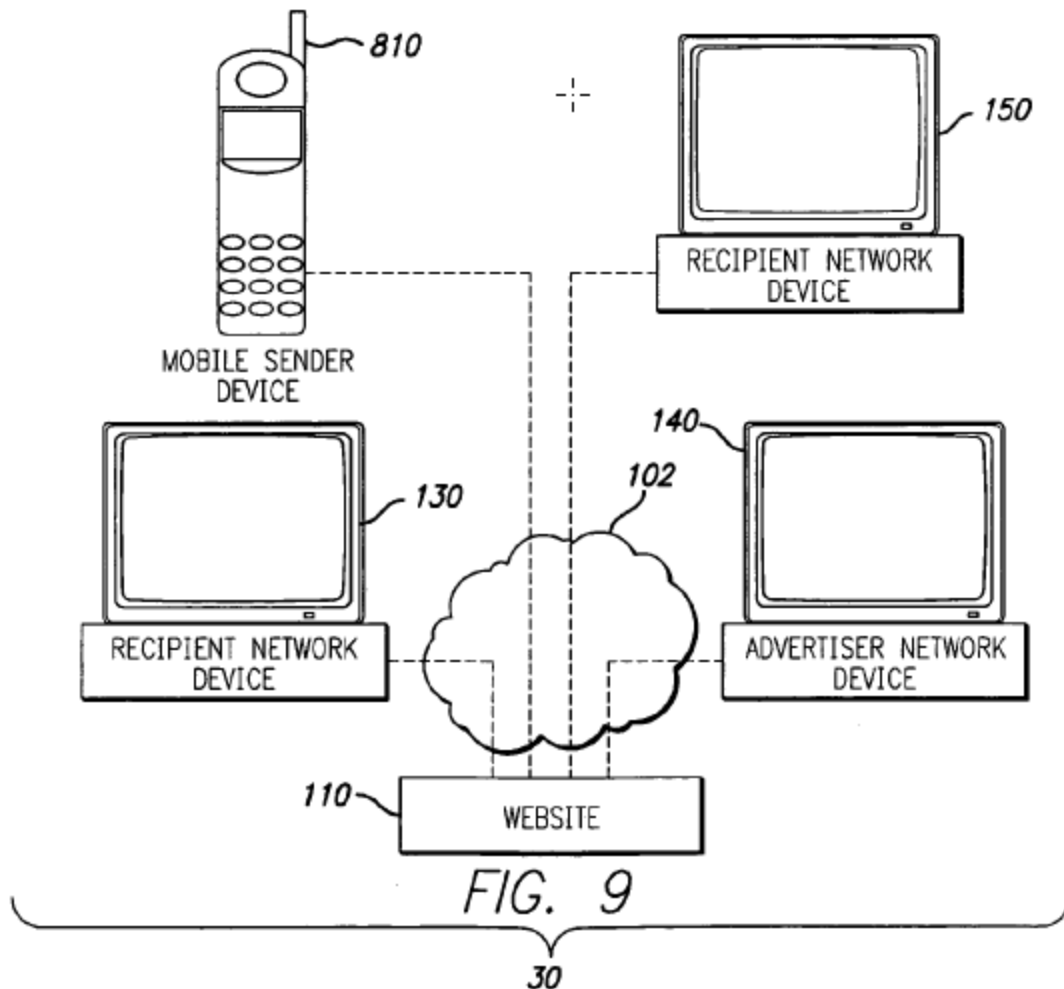
D. Obviousness over Rothschild

Petitioner asserts that claims 1–18, 21, and 22 are unpatentable under § 103(a) as obvious over Rothschild (Ground 1), or alternately, over Rothschild in view of Chen (Ground 4). Patent Owner provides arguments and evidence against these assertions.

Upon consideration of Petitioner’s explanations and the totality of evidence in this current record, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in showing that claims 1 and 18 are unpatentable under § 103(a) as obvious over either Rothschild or the combined teachings of Rothschild and Chen.

1. Rothschild (Ex. 1005)

Rothschild relates to “provided for adding an advertisement to a personal communication and providing additional communication data to a recipient that interacts with the advertisement regardless of the network device the recipient is utilizing.” Ex. 1005, code (57). Figure 9 illustrates a configuration of devices according to the invention:



The embodiment of Figure 9 is described as follows:

the mobile client is an e-mail client that works together with the advertising application 114 (see FIG. 2) to route an e-mail containing an advertisement to a recipient network device 130. The mobile sender device 810 is connected to, and communicates through, the Internet 102. This allows the mobile sender device 810 to communicate with the Web site 110, and more specifically with the advertising application 114 (see FIG. 2). The e-mail client allows the sender to provide the mobile sender device 810, containing the various software components depicted in FIG. 8, with message data and selected advertisement data. After the message data and selected advertisement data is compiled, and the sender has indicated that the compiled data should be sent, the compiled data (which may include message data, advertisement data, and sender data) is transmitted to the Web site 110. . . . if the recipient network device 130 interacts with an interactive advertisement contained within the e-mail, the recipient network device 130 will be provided with additional communication data pertaining to the request data contained in the URL that is embedded within the interactive advertisement.

Ex. 1005, 15:12–35.

2. Chen (Ex. 1007)

Chen relates to a “method for providing add-on services responsive to an email transferred via a distributed computer network.” Ex. 1007, code (57). The add-on service may be auto-reply, paging, virus scanning, and the like. *Id.* at 7:15–25. After the add-on service is performed, the email is passed to an HTML converter facility that converts the email format to a browser-displayable format. *Id.* at 7:40–44.

3. Analysis of Claim 1

We begin our analysis of Petitioner’s obviousness contentions with Petitioner’s assertions as to claim 1.

a) [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:

Petitioner asserts that this limitation, to the extent limiting, is described by Rothschild. Petitioner points to Rothschild's description of a web server having memory device 111 that, when executed within a hardware device such as a web server, operates an application program 114 on the web site 110. Pet. 24–25 (citing Ex. 1005, 6:61–67 (“hardware/software server”), 7:37–8:2 (“RAM, cache memory, . . . tape drives”), 6:38–47 (“an application program . . . performs a function when executed within a computer hardware device”), 7:37–8:2 (“advertising application 114, operating on the Web site 110, [which] permits a sender to create, and send a personal communication”)).

b) [1.1] identify a trigger to generate a hot link

Petitioner asserts that this limitation is described by Rothschild's pull-down menu 404 for selecting an interactive advertisement. Pet. 26 (citing Ex. 1005, Fig. 4, 9:11–31; Ex. 1003 ¶ 41). Petitioner asserts that “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” *Id.* at 27 (citing Ex. 1005, 11:5–10). Petitioner also states that Rothschild's server identifies the trigger when it receives the user's selection of an advertisement from the pull-down menu. *Id.* at 28–29 (citing Ex. 1005, 11:14–16). Petitioner asserts that selection of an advertisement from the pull-down menu, via receipt of the selection at the server, “ultimately *triggers* insertion of the advertisement into an email message.” *Id.* at 26 (citing Ex. 1005, 9:11–31), 28–29 (citing Ex. 1005, 11:28–30, Ex. 1003 ¶ 45). Petitioner asserts that the advertisement contains a hot link because the advertisement is interactive, containing an embedded URL

(Universal Resource Locator), and interaction with the advertisement causes an action to be performed, such as retrieving additional data from a web site. *Id.* at 27–28 (citing Ex. 1005, 5:8–16).

Patent Owner argues that the Petition does not clearly explain how the references disclose identifying the claimed trigger. Prelim. Resp. 10, 20. Patent Owner points out Petitioner’s reliance on two different aspects of Rothschild as teaching identifying the claimed trigger. *Id.* at 20 (citing Pet. 26–28). Patent Owner points to Petitioner’s reliance on Rothschild’s pull-down menu, in which the identification of the trigger is the provision of the ad choices in that menu to the user, and the user’s selection of an ad from that pull-down menu, in which the receipt of the user’s selection is the identification of the trigger. *Id.* Patent Owner argues that Petitioner’s reliance on both teachings fails to explain why either teaches the claim trigger. *Id.*

We do not discern any lack of clarity in Petitioner’s assertions for limitation 1.1. Petitioner provides two alternative descriptions in Rothschild, asserting that each, separately, teaches limitation 1.1. Patent Owner does not argue that Petitioner may not present alternative assertions as to which teachings make obvious a claim limitation. Consequently, we do not agree with Patent Owner that Petitioner’s assertions are unclear, or have not been explained with particularity.

On this preliminary record, we determine that Rothschild sufficiently teaches limitation 1.1 for purposes of institution.

c) [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;

Petitioner points to the action of Rothschild's server, upon receipt of the user's selection of the advertisement from the pull-down menu, of placing the selected interactive advertisement with its associated URL, into the email message. Pet. 29 (citing Ex. 1005, 9:26–31). By detecting which advertisement and associated URL was selected, the server determines which advertisement and associated URL should be put into the email message. *Id.* at 29–30. Because the URL determines the action to be performed when a recipient of the message activates the advertisement in the email, detection of the selected URL results in the determination of the data to be retrieved when the advertisement is activated. *Id.* at 30 (citing Ex. 1005, 11:57–12:13, 8:31–64; Ex. 1003 ¶¶ 46–50).

Patent Owner argues that Petitioner is relying on the receipt of the user's selection of an advertisement to teach the *detection* of the trigger in limitation 1.2, but that Petitioner has already relied on that same action to teach the *identifying* of the trigger in limitation 1.1. Prelim. Resp. 22. Patent Owner argues that Petitioner does not explain how the user's selection qualifies as either limitation, or why the same step of Rothschild could satisfy both limitations. *Id.*

We do not agree with Patent Owner's argument for two reasons. First, as acknowledged by Patent Owner, Petitioner states that the identifying of the trigger is taught by Rothschild's provision of the advertising option within the pull-down menu presented to the user. Pet. 27 (citing Ex. 1005, 11:5–10) ("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").

Second, we determine that Petitioner's explanation adequately distinguishes between the acts constituting the identifying and the detection of the trigger. For identifying the trigger, Petitioner points to the actions relating to which advertisement has been selected by the user; i.e., formatting and inserting the data including the user's advertising selection. Pet. 26. The identifying of the trigger is thus, related to acknowledging which advertisement has been selected by the user and which corresponding embedded URL will be replicated in the message to recipients. *Id.* at 28 (citing Ex. 1005, Fig. 3; Ex. 1003 ¶ 44).

For detecting the trigger, Petitioner focuses on related, but distinguishably different actions. Petitioner points to the receipt of the advertisement resulting in a responsive email message. *Id.* at 30. That is, the detection of the trigger is the acknowledgement of the fact that some selection has been received by the server such that the server then, in response, generates an email message. *Id.* (citing Ex. 1003 ¶¶ 46–50).

Thus, we determine Petitioner's assertions to sufficiently show separate teachings for limitations 1.1 and 1.2 in Rothschild, for purposes of institution. We welcome clarifying claim construction from the parties during the course of the trial.

Patent Owner further argues that Rothschild does not disclose an action to be performed *in response to* detection of a trigger. Prelim. Resp. 13. Patent Owner here focuses on Petitioner's mapping of Rothschild's detection of a trigger as corresponding to the server receiving the user's ad selection. *Id.* at 14 (citing Pet. 29). Patent Owner argues that because Petitioner's alleged action to be performed is defined by the URL associated

with the advertisement, and because the URL was associated with the advertisement prior to its selection by the user, the URL was determined “*before – not in response to –* the ‘detection’ (receipt of the user’s ad selection).” *Id.* at 15 (citing Ex. 1005, 11:57–65, 13:26–49). Patent Owner reasons that the server does not determine the “action to be performed” in response to receiving the user’s ad, because it has been predetermined by the advertiser. *Id.* at 15–18.

Although the URL is pre-associated with a particular advertisement, we do not agree that the server does not perform functions, such as inserting the advertisement and embedded URL into an email message, in response to determining that the user selected an advertisement. As admitted by Patent Owner, “[i]f the user chose to not include an ad, the server does not include one[, and i]f the user selected a static ad with no URL, the server does not insert a URL into the ad.” Prelim. Resp. 18. Clearly, the selection of an ad, when detected by a server, results in the insertion of that ad with any accompanying URL. Although the advertiser determines which URL is associated with which ad, it is the user’s action in selecting a desired ad, and the server’s detection of that ad, that results in a message containing a particular URL that when activated, causes an action based upon the identity of that URL to be performed.

Thus, we determine that Petitioner has, on the current record and for purposes of institution, met its burden to show limitation 1.2 to be taught by Rothschild.

d) [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 discussed for limitations 1.1 and 1.2, Petitioner points to the message recipient's activation of the advertisement, causing the recipient's system to retrieve data from the source of the advertisement's URL. Pet. 31 (citing Ex. 1005, 5:8–16, 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[, which] uses the request data . . . to retrieve data from the Web site memory device.”)). Petitioner asserts that the retrieval of data occurs via a web browser application, and that it would have been obvious for such retrieval to have occurred through execution of program code, in view of Rothschild's statement that “an application program is a set of one or more computer programs that performs a function when executed within a computer hardware device.” *Id.* (quoting Ex. 1005, 6:39–41; citing Ex. 1003 ¶¶ 51–53).

e) [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;

Petitioner asserts that “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.” Pet. 32 (citing Ex. 1005, 10:65–11:33 (“At step 516 the message data (which includes the selected advertisement) is formatted into a standard e-mail format”)). Petitioner further asserts that the URL embedded in the advertisement included in the message defines the determined action, and that the display of the message's advertisement may be in a variety of forms, including graphical. *Id.* at 32–33 (citing Ex. 1005, 8:3–30, 13:41–42). Petitioner asserts that the data

representing the graphical form of the advertisement comprises instructions for rendering and displaying the hot link; i.e., the link itself.

Additionally, relying on testimony by Dr. Houh, and description in Chen and Rothschild, Petitioner asserts that a person having ordinary skill in the art would have recognized that such an interactive advertisement would have been implemented by HTML, whose code comprises instructions for rendering and displaying the hot link. *Id.* (citing Ex. 1003 ¶¶ 58–59; Ex. 1007, 2:37–54 (Chen’s description of inserting advertisements into e-mail using HTML as “conventional”); Ex. 1005, 2:26–36 (Rothschild’s mention of “Hotmail” as an example e-mail service)). Petitioner asserts that a person having ordinary skill in the art would recognize the obviousness of HTML code to process the URL, the code thereby acting as instructions for rendering and displaying a hot link. *Id.* at 33–34 (citing Ex. 1003 ¶ 60).

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

Petitioner asserts that Rothschild’s web server transmits the formatted advertisement-bearing message to recipients. *Id.* at 34–35 (citing Ex. 1005, 11:30–33; Ex. 1003 ¶¶ 63–64).

g) Reasons to Combine Rothschild and Chen (Ground 4)

Petitioner applies Chen either as evidence to support the asserted obviousness of using HTML to implement Rothschild’s interactive advertising (Ground 1), or to combine Chen’s HTML teachings to make obvious the use of HTML to implement Rothschild’s interactive advertising (Ground 4). For the latter, Petitioner asserts that a person having ordinary skill in the art would have found it obvious to combine the teachings of Rothschild and Chen because it “represents the combination of known elements (e-mail advertisements) according to known methods (HTML) to

yield predictable results.” Pet. 82 (citing Ex. 1003 ¶¶ 187–93). Petitioner also points to Chen’s statement 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.” *Id.* (quoting Ex. 1007, 3:64-67). Petitioner asserts that a person of ordinary skill in the art would have had a reasonable expectation of success in such combination because both Rothschild and Chen describe a similar variety of media advertisements, with Chen further stating that each form of media advertisement may be with or without HTML links. *Id.* at 81 (citing Ex. 1003 ¶¶ 191–192; Ex. 1005, 8:22–25; Ex. 1007, 8:23–27).

h) Determination

In view of the foregoing, we determine that Petitioner has sufficiently shown, for purposes of institution, that each element of claim 1 has been taught or suggested by either Rothschild in view of the knowledge in the art (including Chen), or Rothschild in view of Chen. Further, that Petitioner has sufficiently shown, for purposes of institution, that a person having ordinary skill in the art would have reason to combine Rothschild with the knowledge in the prior art, or with Chen, as suggested by Petitioner, and would have a reasonable expectation of success in doing so.

4. Analysis of Claim 18

Patent Owner specifically addresses Petitioner’s assertions with respect to claim 18. In furtherance of clarifying the issues for trial, we provide our determination on those assertions for purposes of institution.

Claim 18 recites, in pertinent part, “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).” Petitioner builds upon

its assertions for claim 1, in which Rothschild's message to its recipient, including an interactive advertisement represented by a graphic or icon, teaches its hot link message having a graphical control element. Pet. 58. Regarding the claimed assignment information, Petitioner relies upon Dr. Houh's testimony that a person having ordinary skill in the art "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." *Id.* (citing Ex. 1003 ¶ 139). Specifically, Petitioner asserts (for limitation 1.4) that an interactive advertisement that includes an embedded URL would have been implemented using HTML. *Id.* at 33 (citing Ex. 1003 ¶ 58). Because HTML code relies on tags that define how the embedded URL is displayed, Petitioner asserts that these tags assign the user interface element to the interactive advertisement. *Id.* (citing Ex. 1003 ¶ 59; Ex. 1010, 35; Ex. 1011, 39), 43 (providing an example in which "the HTML lines , , and assign the user interface element graphic.jpg to the interactive advertisement").

Patent Owner argues that this example has no support in Rothschild, and that Rothschild lacks any description of data in an email that assigns an ad to an icon. Prelim. Resp. 23. We agree; however, Petitioner does not represent that such description or example is taught by Rothschild. Rather, Petitioner provides reasoning to explain why a person having ordinary skill in the art, encountering Rothschild's URL-based advertising message, would find obvious the use of HTML tags associating the URL with the graphical ad in that message. On the current record, we find Petitioner's explanation

to be supported by its cited sources, and sufficient at this stage to show obviousness of the claim limitation at issue.

Patent Owner further argues that any such data would be assigning the ad (which is an icon) to itself. Prelim. Resp. 23. We do not agree that Petitioner’s assertion merely assigns an ad to itself. Rather, Petitioner proposes assigning the URL to the graphical image in the message, through the use of HTML tags as asserted to be known in the art at the time. Even though Rothschild’s URL is “embedded” in the advertisement in the email, Petitioner’s explanation of the use of HTML tags to embed, or assign, the URL to the graphical email element is self-consistent. Consequently, we do not agree with Patent Owner’s argument.

Further, we agree with Petitioner’s assertions with respect to the remaining limitations, as discussed for the similar limitations of claim 1, and further elaborated by Petitioner for claim 18. Pet. 55–62. For the above-mentioned reasons, we determine that Petitioner has shown, for purposes of institution on the current record, that claim 18 would have been obvious over Rothschild, or over the combination of Rothschild and Chen.

III. DISCRETIONARY INSTITUTION, § 314(A)

Institution of an inter partes review is discretionary. *See* 35 U.S.C. § 314(a) (authorizing institution of an inter partes review under particular circumstances, but not requiring institution under any circumstances); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review . . .” (emphasis omitted)); *Harmonic Inc. v. Avid*

Tech., Inc., 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).⁴

Patent Owner urges the Board to exercise discretion to deny institution of *inter partes* review under § 314(a) based on the factors established in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 WL 2126495, at 2–3 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). Prelim. Resp. 50–54.

An advanced state of a parallel district court proceeding is a “factor that weighs in favor of denying the Petition under § 314(a).” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”). Specifically, an early trial date is part of a “balanced assessment of all relevant circumstances in the case, including the merits.” Consolidated Trial Practice Guide November 2019 (“TPG”) 58.⁵

This balanced assessment involves consideration of the following factors:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;

⁴ On June 21, 2022, the USPTO issued an Interim Procedure for Discretionary Denials in AIA Postgrant Proceedings with Parallel District Court Litigation, available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf (the “Interim Procedure”).

⁵ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv, Paper 11 at 5–6.

Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

The parties agree that neither party has moved for a stay and this factor is neutral. Pet. Reply 1; PO Sur-reply 1.

Accordingly, this factor is neutral in exercising discretion to deny institution.

Factor 2: proximity of the court's trial date to the Board's projected statutory deadline for a final written decision

On August 22, 2022, the Western District of Texas transferred the California litigation to the Northern District of California after an agreement to transfer by the parties. See Pet. 16 (citing Ex. 1017); *supra* § I.B. The parties agree that the Northern District of California has not set a trial date. See Pet. 17 (citing Ex. 1021); Pet. Reply 1; Prelim. Resp. 38; PO Sur-reply 1. Petitioner provides evidence that “the median time-to-trial in the Northern District of California is 34.7 months.” Pet. 14 (citing Ex. 1013, 9). According to Petitioner, “[b]ased on these statistics, trial would occur approximately in June 2025 (as calculated from the case opening in the Northern District of California),” about a year after any final written decision in the instant case. See *id* at 15.

As Petitioner argues, this timing favors not exercising discretion to deny institution. Pet. Reply 1 (citing *Meta Platforms Inc. v. Thales Visionix*,

Inc., IPR2022-01301, Paper 11 at 11 (PTAB Mar. 13, 2023); *Google LLC v. Ikorongo Tech. LLC*, IPR2021-00204, Paper 16 at 8–9 (PTAB Jan. 25, 2022) (“factor[] 2 . . . favor[s] not exercising our discretion because there is no trial date”).

Accordingly, this factor weighs against exercising discretion to deny institution.

Factor 3: investment in the parallel proceeding by the court and the parties

“This investment factor is related to the trial date factor, in that more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Fintiv*, Paper 11 at 10. If, at the time of the institution decision, a district court has issued substantive orders related to the challenged patent, such as a claim construction order, this circumstance weighs in favor of denial. *See Id.* at 9–10. On the other hand, if the district court has not issued such orders, this circumstance weighs against discretionary denial. *Id.* at 10. Moreover, in evaluating this factor, “[i]f the evidence shows that the petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted, this fact has weighed against exercising the authority to deny institution under *NHK*.” *Id.* at 11.

Petitioner contends that “the claim construction hearing will occur on July 12, 2023 (Ex.1026, p. 11), while institution decisions will issue no later than June 16, 2023 (*see* 35 U.S.C. § 314(b)(1)).” Pet. Reply 2.

Patent Owner argues that “the parallel litigation proceeded for twelve months [prior to the filing of] the Petition on November 30, 2022, one day

before the § 315(b) deadline.” Prelim. Resp. 26. Patent Owner also contends as follows:

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.

Prelim. Resp. 26-27.

Patent Owner does not point to any substantive orders related to the claim construction or the validity of the ’169 patent prior to, or after, the transfer. The record shows some investment in the District Court in terms of actions by parties toward the patentability issues presented here but “much work remains.” *See Sand Revolution II, LLC v. Cont’l Intermodal Grp.—Trucking LLC*, IPR2019-01393, Paper 24 at 11 (PTAB June 16, 2020) (informative) (“[W]e recognize that much work remains in the district court case as it relates to invalidity: fact discovery is still ongoing, expert reports are not yet due, and substantive motion practice is yet to come.”) (“*Sand Revolution*”); Prelim. Resp. 39 (indicating discovery is ongoing).

As to the timing of the Petition’s filing, according to Petitioner, after filing its first complaint in the Western District of Texas on December 1, 2021, Patent Owner filed an amended complaint on February 28, 2022, and then voluntarily dismissed the suit on April 4, 2022. *See* Pet. 13 (citing Ex. 1014; Ex. 1016; Ex. 1018). On the same day, April 4, 2022, Patent Owner filed another complaint in the Western District of Texas and then filed an amended complaint on May 9, 2022. *Id.* (citing Ex. 1015). After Petitioner

filed its answer, the parties agreed to transfer the case to the Northern District of California and the court ordered the transfer on August 29, 2022. *Id.* (citing Ex. 1019). Patent Owner does not dispute these facts as asserted by Petitioner. *See generally* Prelim. Resp.

It appears that after the parties agreed to transfer the case, Petitioner filed the Petition on November 30, 2022, no more than three months after Patent Owner filed its infringement contentions (which Patent Owner filed sometime after the August 29, 2022 transfer), and about three months prior to the service of Petitioner’s final invalidity contentions in the Northern District of California on March 3, 2023. *See* Prelim. Resp. 27; Pet. 16.

This timing, spurred at least in part by the voluntary dismissal by Patent Owner, the subsequent complaint, and the subsequent agreement to transfer, combined with the lack of substantive orders, tilts against exercising discretion to deny institution.

Therefore, this factor weighs against exercising discretion to deny institution.

Factor 4: overlap between issues raised in the petition and in the parallel proceeding

Petitioner stipulates that “it will not pursue in the parallel [California] litigation the grounds raised in the Petition.” Pet. Reply 3. Patent Owner argues that “[a]s in *Sand Revolution*, this factor *at best* “weighs *marginally* in favor of not exercising discretion to deny institution.” PO Sur-reply 3 (emphasis in original) (quoting *Sand Revolution*, Paper 24 at 11–12).

As indicated above, the Western District of Texas recently granted the parties’ transfer motion, there is no trial date set yet, and any trial for the California litigation likely will occur about a year after any final written decision is due here (i.e., June 2024). Therefore, under 35. U.S.C. 315(e)(2),

Petitioner likely will be estopped from raising an invalidity defense in the California litigation based on a “ground that the petitioner raised or reasonably could have raised” here, thereby precluding any overlapping and conflicting findings with respect to the instant proceeding.

Under a holistic analysis, not only does Petitioner’s stipulation “mitigate[] to some degree the concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions,” *see Sand Revolution*, Paper 24 at 12, Patent Owner does not show that duplicative efforts or conflicting District Court findings related to substantive invalidity issues are likely to occur due to the estoppel effects of 35 U.S.C. § 315(e)(2).

Therefore, this factor weighs against exercising discretion to deny institution.

Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same party

The parties agree that Petitioner is a defendant in the parallel proceeding. Pet. Reply 3; PO Sur-reply 4. Petitioner contends that “multiple panels have recognized that, even when the petitioner is the defendant in the parallel litigation, ‘this factor favors denial if trial precedes the Board’s Final Written Decision and favors institution if the opposite is true.’” Pet. Reply 3 (quoting *Huawei Tech Co. v. WSOU Inv., LLC*, IPR2021-00225, Paper 11 at 14 (PTAB June 14, 2021); citing *Google LLC v. Parus Holdings, Inc.*, IPR2020-00846, Paper 9 at 21 (PTAB Oct. 21, 2020) (“Petitioner is the defendant in the parallel proceeding. This fact could weigh either in favor of, or **against, exercising discretion** to deny institution, depending on which tribunal was likely to address the challenged patent first.”).

Patent Owner does not address the timing of the final written decision relative to the trial date in the California litigation as raised by Petitioner. *See* PO Sur-reply 4 (arguing this factor favors exercising discretion to deny without addressing the timing).

Accordingly, because our Final Written Decision is likely to occur before the District Court’s judgment, this factor weighs against exercising discretion to deny institution.

Factor 6: other circumstances that impact the Board’s exercise of discretion, including the merits

The factors typically considered in the exercise of discretion are part of a balanced assessment of all the relevant circumstances in the case, including the merits. *Fintiv*, Paper 11 at 14. For example, if the merits of a ground raised in the petition seem particularly strong on the preliminary record, this fact has favored institution. *Id.* at 14–15. By contrast, if the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present. *Id.* at 15. As indicated above, Petitioner shows a reasonable likelihood of prevailing in its showing of obviousness.

Therefore, this factor is neutral in exercising discretion to deny institution.

Conclusion

The Board “holistic[ally] view[s] . . . whether efficiency and integrity of the system are best served by denying or instituting review” when evaluating the *Fintiv* factors under § 314(a). *Fintiv*, Paper 11 at 6. As shown above, we determine that factors 1 and 6 are neutral and that factors 2–5 weigh against exercising discretion to deny institution. Evaluating all of

the factors on this record, we decline to exercise discretion under § 314(a) to deny institution of *inter partes* review.

IV. CONCLUSION

For the reasons discussed above, we conclude Petitioner has shown a reasonable likelihood of prevailing with respect to claims 1 and 18 of the '169 patent. We determine that the record supports institution.

Accordingly, we institute an *inter partes* review of all challenged claims under both grounds set forth in the Petition.

Our determination at this stage of the proceeding is based on the evidentiary record currently before us. This decision to institute trial is not a final decision as to patentability of any claim for which *inter partes* review has been instituted. Our final decision will be based on the full record developed during trial.

V. ORDER

For the foregoing reasons, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted for the following asserted grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–18, 21–22	103(a)	Rothschild
19	103(a)	Rothschild, Saltanov
20	103(a)	Rothschild, Saltanov, Maes
1–18, 21–22	103(a)	Rothschild, Chen
19	103(a)	Rothschild, Chen, Saltanov
20	103(a)	Rothschild, Chen, Saltanov, Maes

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

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