

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

WILDSEED MOBILE LLC,
Patent Owner.

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

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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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)
Ex.1022	Supplemental Declaration of Henry Houh
Ex.1023 (New)	Supplemental Declaration of Henry Houh in Support of Petitioner Reply
Ex.1024 (New)	Deposition transcript of Dr. Sam Malek

I. Introduction

The Petition shows that Rothschild's interactive advertisements that have embedded URLs and are inserted into email messages teach "hot link" messages as described and claimed in the '169 patent. Patent Owner's Response ("Response," Paper 20) fails to refute the Petition's obviousness analysis because it relies on unclaimed concepts and mischaracterizations of Petitioner's positions. For the reasons explained in the Petition and below, the Board should find all challenged claims unpatentable.

II. Rothschild's interactive advertisements, which have embedded URLs teach a "hot link" as claimed.

Rothschild describes sending interactive advertisements in emails, which teaches sending a "hot link" in a "hot link message" as claimed. The claims recite various limitations related to the "hot link," including "*identify[ing] a trigger to generate a hot link*," "*detect[ing] the trigger*," "*determine[ing] an action*," and "*generat[ing] a hot link message*." Rothschild renders the claims obvious because it describes that a user is provided with a pull-down menu ("*identify a trigger*") for selecting an interactive advertisement ("*hot link*"). Petition, 26-29. When the server receives the user's selection ("*detect[s] the trigger*") from the pull-down menu, it places the selected advertisement with an embedded URL into an email message ("*determine[s] an action*"). Petition, 29-30. The server then formats the email ("*generate[s] a hot link message*") for sending to the designated recipients.

Petition, 32-34.

Patent Owner's primary argument is that Rothschild's interactive advertisement is not generated "during the message creation process" but is instead previously created by the advertiser. Response, 11-13. This argument—and those related to it—do not refute the petition's analysis for at least two reasons. First, nowhere do the claims require generating a hot link "during the message creation process" as Patent Owner argues. Instead, the claims simply provide "*identify a trigger to generate a hotlink*" and "*receive . . . a request to generate a hotlink.*" (limitations 1.1, 10.2). Patent Owner cannot refute the Petition's analysis by relying on unclaimed limitations. Second, the Petition does not rely on the initial creation of the advertisement content as teaching "*generate a hot link.*" The Petition instead cites to the subsequent "insertion of the advertisement into an e-mail message." Petition, 26. Mischaracterizing the Petition's position cannot refute the Petition's analysis. For the reasons described below, Rothschild renders obvious each claim limitation related to the hot link—and Patent Owner's reliance on non-existent claim limitations and mischaracterizations of the Petition's analysis do not show otherwise.

A. Rothschild teaches "*identify a trigger to generate a hot link*" as claimed.

Patent Owner's arguments related to "*identify a trigger to generate a hot link*" rely on non-existent claim limitations. Patent Owner argues that "Claims 1

and 10 each require generating a hot link **during the message creation process**.

EX1001, limitation 1.1 (‘identify a trigger to generate a *hot link*;’).” Response, 11; Ex.1024, 19. But the claims do not recite any such timing requirement that hot link generation must occur “during a message creation process.” Rather, limitation 1.1 simply recites the step of “**identify[ing] a trigger**.”

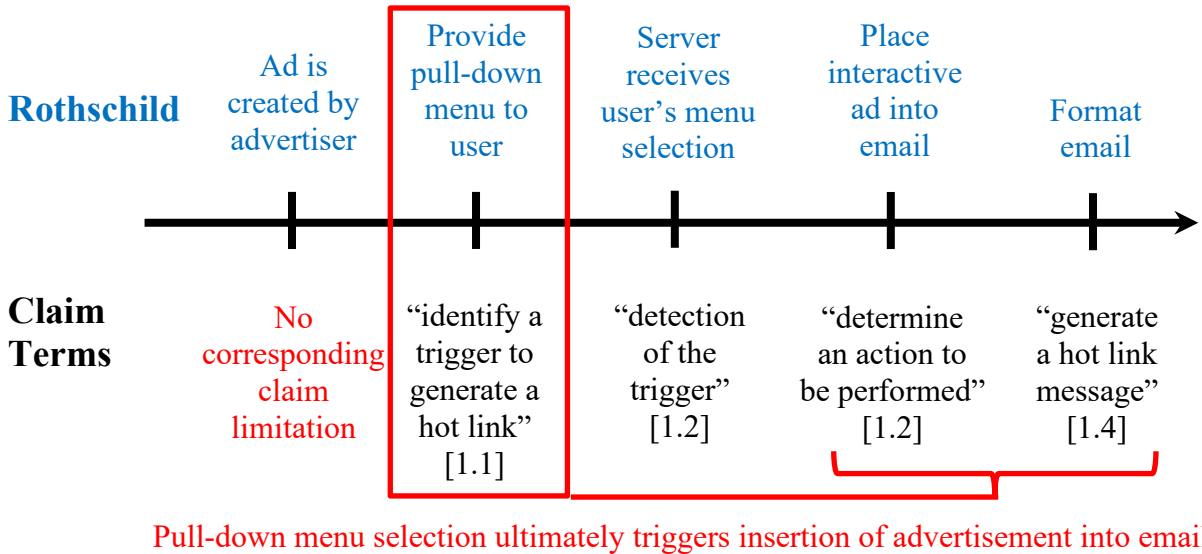
By treating limitation [1.1] as requiring generating the hot link—rather than *identifying the trigger* that generates the hot link—Patent Owner conflates limitation [1.1] with limitation [1.4]. Limitation [1.4] recites “*generate a hot link message*...” Patent Owner argues that “Petitioner devotes most of its discussion to [1] generating a hot link message—as opposed to a hot link.”). Response, 12. Patent Owner further argues that “generating the message (the “hot link message” that includes the hot link) is an additional limitation of the claims and is distinct from the requirement to generate the hot link itself.” Response, 12.

Contrary to Patent Owner’s accusations, the Petition does not conflate generating a hot link with generating a hot link *message*. Instead, the Petition analyzes what is actually claimed—identifying a trigger. The Petition’s analysis of limitation [1.1] is summarized in the table below.

Claim Term	Rothschild’s Teachings
“ <u>identify a trigger</u> <u>to generate a hot</u>	“Rothschild describes a ‘ <i>trigger</i> ’ for generating an interactive advertisement (‘ <i>hot link</i> ’) in the form of <u>a pull-</u>

<i>link</i>	<u>down menu</u> for selecting an interactive advertisement.” Petition, 26.
<i>“<u>identify a trigger to generate a hot link</u>”</i>	“Rothschild’s server <i>identifies</i> the ‘ <i>trigger</i> ’ when it provides the sending user’s device with the e-mail communication page 402 that contains the pull-down menu.” Petition, 27.
<i>“<u>identify a trigger to generate a hot link</u>”</i>	Rothschild’s pull-down menu is a trigger to “ <i>generate a hot link</i> ” because “[s]election of an advertisement from the pull-down menu ultimately triggers insertion of the advertisement into an e-mail message.” Petition, 26.
<i>“<u>identify a trigger to generate a hot link</u>”</i>	“Rothschild’s interactive advertisement teaches a ‘ <i>hot link</i> ’ as claimed because interaction with Rothschild’s interactive advertisement causes an action to be performed.” Petition, 27.

The Petition thus explains how Rothschild’s server identifies a trigger by providing a pull-down menu. Petition, 26. The Petition further explains why the pull-down menu (trigger) generates a hot link: “Selection of an advertisement from the pull-down menu ultimately *triggers* insertion of the advertisement into an e-mail message.” Petition, 26. The hot link is ultimately generated (as triggered through the pull-down menu) when the server places the interactive advertisement within the email and “the selected advertisement[] is formatted into a standard email format.” Petition, 26 (citing Ex.1005, 11:28-30). This concept is illustrated below.



Patent Owner attempts to implicitly construe the term “generate” to exclude inserting an advertisement into an email. Patent Owner argues that “[t]he claims require generating—not merely inserting—a hot link. EX2009, ¶48. Inserting a pre-existing ad into a new message, for example, does not generate an ad.” Response, 12. But Patent Owner does not provide any formal claim construction for the term “generate.” Nor does it cite to any basis for interpreting the term “generate” to exclude inserting the advertisement into an email and formatting it for transmission. Patent Owner argues that “Rothschild does not state that formatting an email generates an interactive ad.” Response, 13. But there is no requirement that the prior art use the same wording as the claims. *See Teva Pharm. Indus. v. Astrazeneca Pharm.*, 661 F.3d 1378, 1384 (Fed. Cir. 2011) (“The prior inventor does not need to know everything about how or why its invention worked. Nor must it conceive of its invention using the same words as the patentee would

later use to claim it.”).

Because the claims do not recite that generation of the hot link occurs “during a message creation process,” Patent Owner’s timing arguments are moot. Patent Owner argues that “Dr. Houh could not identify anything in Rothschild that disclosed sending the user’s selected ad before pressing the ‘send’ button.” Response, 16. Patent Owner further argues that “when the user presses the ‘send’ button in Rothschild’s e-mail composition interface (see EX1005, FIG. 4), the email already includes the interactive ad.” Response, 15. But whether the advertisement is added to the email before or after the user presses send is irrelevant. There is no such timing requirement recited in the claims. It is further irrelevant whether the set advertisements in the pull-down menu have been downloaded in advance. Patent Owner argues that “[t]he step of downloading and storing all ads in advance is significant. Dr. Houh supposed that a server might fetch an ad after a user selects it, in a different embodiment (involving pull down menu 404).” Response, 23. Whether the server pre-fetches the interactive advertisement is also an unclaimed concept.

To the extent the “message creation process” referred to by Patent Owner relates to a claim element, Patent Owner’s own expert appears to be in agreement with Petitioner. When asked what he meant by the “message creation process,” he referred to the generation of the hot link *message*:

Q. So you say there that, "Claims 1 and 10 each require generating a hot link during the message creation process." What is the message creation process you are referring to?

A. So if you look at the claim language, it – it describes – there's a limitation that says, "Generate a hot link message."

Ex.1024, 13.

As explained in the Petition, Rothschild's formatting step formats both the email message ("*hot link message*") and associated data including the selected advertisement ("*hot link*"). Petition 26-29; 32-34. Accordingly, if the "message creation process" is the generation of the hot link *message*, then generation of the hot link occurs *during* the message creation process under the Patent Owner expert's understanding. Patent Owner thus does not refute the Petition's obviousness analysis that Rothschild teaches "*identify a trigger to generate a hot link.*"

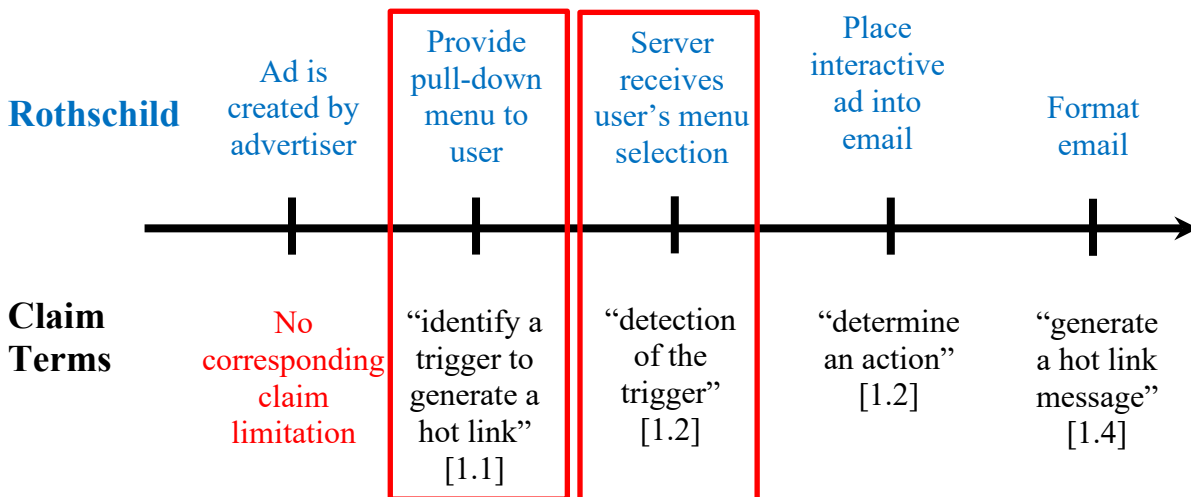
B. Rothschild teaches "*detection of the trigger*" as claimed.

Patent Owner mischaracterizes the Petition as relying on a single element for two separate claim limitations: "Petitioner asserts that receiving the user's selection of an ad from pull down menu 404 qualifies as both detection (limitation 1.2) and identification (limitation 1.1) of the trigger." Response, 48. Contrary to Patent Owner's assertions, the Petition relies on separate teachings for identifying and detecting the trigger. Further, the Petition applies Rothschild using two

separate interpretations.

Under Petitioner's first interpretation, Rothschild's server identifies the trigger when it provides the pull-down menu. Petition 26-28. Rothschild's server then separately detects the trigger when it receives the user's advertisement selection. Petition, 29-30. Thus, the Petition—under Petitioner's first interpretation—distinctly relies on two separate elements for the separate claim limitations, as shown in the table below and illustrated in the figure.

Claim Term	Rothschild's Teachings
<i>“identify a <u>trigger</u> to generate a hot link”</i>	“Rothschild describes a ‘trigger’ for generating an interactive advertisement (‘hot link’) in the form of <u>a pull-down menu</u> for selecting an interactive advertisement.” Petition, 26.
“detection of the trigger”	“When the server receives the user’s advertisement selection.” Petition, 29.



The Petition relies on separate teachings for separate limitations. Petition, 26-29.

In the event Patent Owner attempted to treat “*detection of the trigger*” as referring back to the claimed “*identify a trigger*,” Petitioner presented a second invalidity interpretation in which identification of the trigger also occurs when the server receives the user’s advertisement selection. Petition, 28-30. Because Patent Owner has not made this argument, this Reply on the first interpretation, but maintains Rothschild renders the claims obvious under the second interpretation. As provided in the first interpretation, Petitioner relies on separate teachings for separate limitations, as the Board found at institution. *See* DI, 13-14.

C. Rothschild teaches “*determining an action*” in response to detecting the trigger as claimed.

Patent Owner argues that “[i]nserting the ad does not determine what action will be taken upon activation of the ad” because “the URL is already embedded in the ad.” Response, 51. But the Petition does not rely on the act of embedding the URL into the advertisement as the claimed “*determine[ing] an action*.” Rather, the Petition states that “[w]hen 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 ... into the e-mail message**. Ex.1005, 9:26-31.” Petition, 29. Petitioner’s analysis of this term is summarized in the following table.

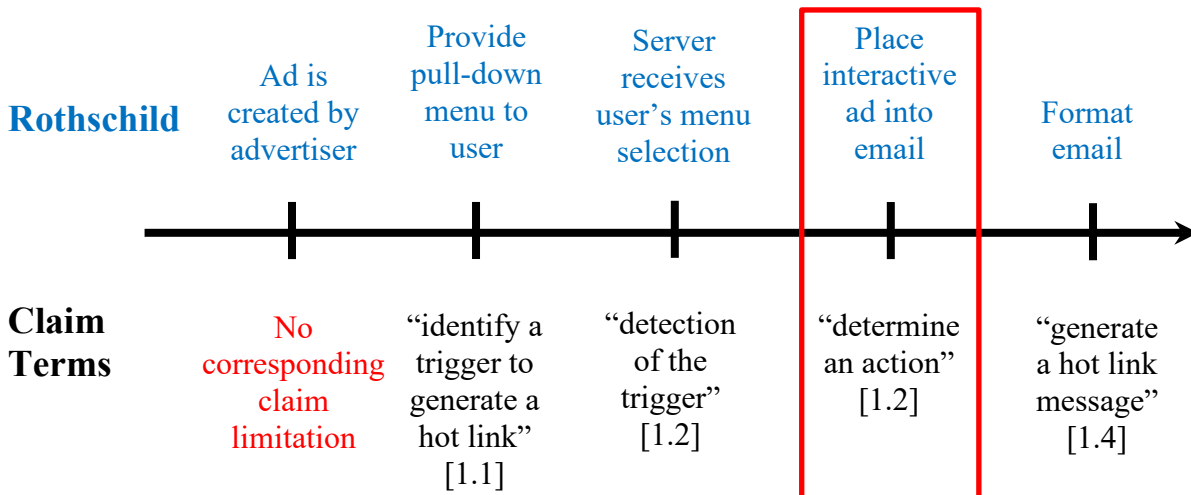
Claim Term	Rothschild’s Teachings
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<u>“determine an action to be performed upon activation of the hot link”</u>	“Rothschild’s server determines an action to be performed by placing the selected interactive advertisement—along with its embedded URL—into the e-mail message.” Petition, 29.
<u>“determine an action to be performed upon activation of the hot link”</u>	The action is the “retrieval of additional information.” “Thus, the nature of the URL itself defines ‘ <i>an action to be performed</i> ’ as claimed.” Petition, 30.
<u>“determine an action to be performed upon activation of the hot link”</u>	“when the recipient of the email message activates the interactive advertisement.” Petition, 29.

The Petition explains that “[t]he 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.” Petition, 29. But this is not to say that embedding the URL is what determines the action to be performed.

By improperly relying on the act of creating the advertisement and embedding the URL into the advertisement, Patent Owner argues “the URL is determined before—not in response to—selecting the ad from the pull down

menu.” Response, 52. But the Petition does not cite to the embedding of the URL during creation of the advertisement as teaching the claimed “*determin[ing] an action.*” The Petition instead explains that by placing the selected advertisement into the email message, the server “*determine[s] an action to be performed*” as recited in the claim. *See* Petition, 29-30. In other words, inserting the selected advertisement determines what action will be performed when the user engages with it, as highlighted below.



Inserting the selected ad “determines” what action will be performed. Petition, 29-30

Patent Owner's assertion that “[b]y the time the ad is inserted into a message, there is nothing left to determine” is likewise incorrect. Response, 52. The server still makes the determination as to what advertisement to insert based on the user's received selection. *See* Ex.1005, 11:1-38; Petition, 29-30.

Patent Owner further argues that “[t]he claims require ‘determin[ing] an action to be performed upon activation of the hot link’—not the hot link *message*.”

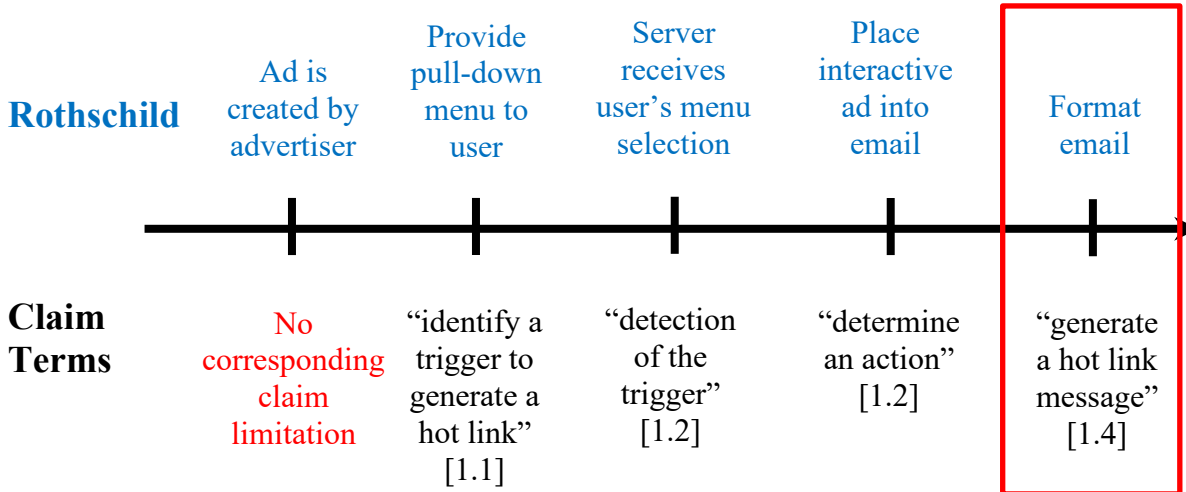
Response, 51. But again, Petitioner does not rely on activation of the email

message for this claim limitation. Rather, Petitioner explains that activation of the interactive advertisement (“*hot link*”) occurs “when the recipient of the email message activates the interactive advertisement.” Petition, 26-30.

D. Rothschild teaches “*generating a hot link message*” as claimed.

Patent Owner argues that the Petition improperly relies on Rothschild’s formatting of the email for both “generating a hot link *message*” and “generate the hot link.” See Response, 12. But as explained above, the claims do not affirmatively recite “generating the hot link.” Moreover, the Petition explains that “consistent with the discussion at [1.4], the hot link is ‘generated’ when the e-mail message containing the hot link is formatted,” as summarized below. Petition, 42.

Claim Term	Rothschild’s Teachings
“hot link message”	“Rothschild’s web server formats (“generate[s]”) <u>an email</u> (“hot link message”). Petition, 42.
“generate a hot link message”	“Rothschild’s web server <u>formats</u> (“generate[s]”) an email (“hot link message”). Petition, 42.



Formatting the e-mail based on the compilation of data generates the hot link. Petition, 32-34

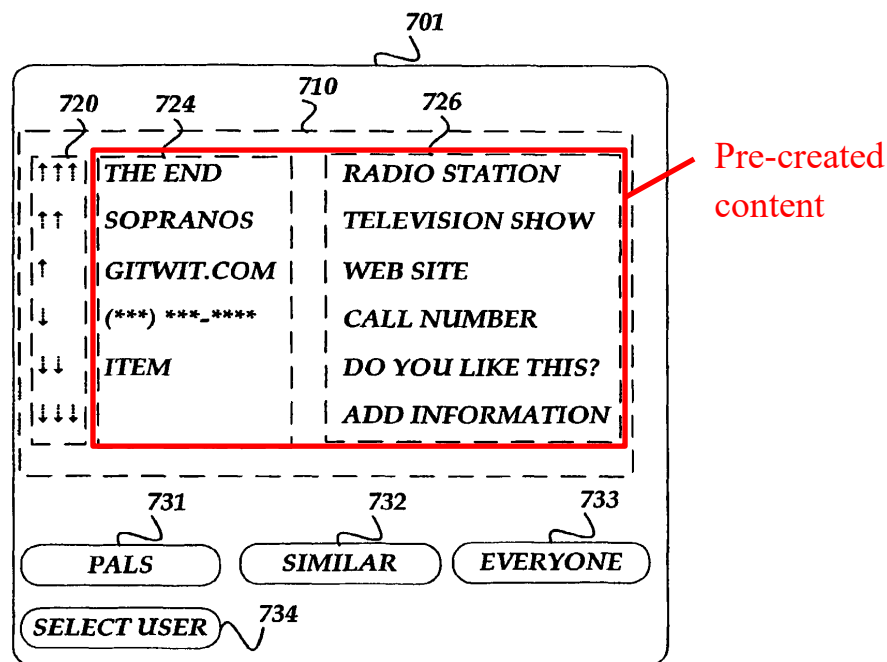
Patent Owner further argues that the cited portions of Rothschild “merely refer[] to formatting, not generating.” Response, 13. But Rothschild’s formatting process is not simply formatting text as Patent Owner implies. Rothschild’s formatting process generates the email by compiling data—including the advertisement—into an email format: “the message data (which includes the selected advertisement) is formatted into a standard e-mail format.” Ex.1005, 11:28-30; Petition 32-34. And as explained above, there is no requirement that the prior art use the same wording as the claims. *See Teva Pharm.* at 1384.

E. Rothschild’s “pre-existing” advertisements are similar to the hot links described in the ’169 patent.

As explained above, Patent Owner’s primary argument appears to be that because the content of Rothschild’s interactive advertisements was previously created, the advertisements are not generated in response to the pull-down menu

("trigger"). Patent Owner argues that "when a user selects an interactive ad from the pull down menu, that ad already has an embedded URL and is already a fully-formed interactive ad." Response 29; *see also* 49, 52.

But the Petition does not construe the term "generate" to mean the initial *creation* of the advertisement content. Nothing in the specification of the '169 patent supports such an interpretation of the word "generate." Indeed, the specification of the '169 patent similarly describes a "hot link action selection system 700" that allows the user to select from pre-existing content. "Display 701 may contain titles 724 identifying the action, as well as descriptions 726 of the action. The title may be the broadcast name, item, song name, movie, product number, and the like." Ex.1001, 12:16-19.



Ex.1001, Fig. 7 (annotated)

The '169 patent thus describes generating a hot link by placing pre-created content into an email message. Ex.1001, Fig. 7, 12:6-54, claim 5; Ex.1024, 18-20. A POSITA would have therefore understood that by inserting the advertisement into the email and formatting it for transmission, Rothschild's email server *generates* the advertisement, regardless of when the content for that advertisement was created. Rothschild thus teaches "*generate a hot link message*" as claimed.

III. Patent Owner ignores the Petition's analysis regarding the obviousness of using HTML to implement Rothschild's interactive advertisements.

The Petition explains that it would have been obvious to implement Rothschild's interactive advertisements with HTML because doing so was "conventional" and thus within the background knowledge of a POSITA. Petition, 33. The Petition further provided additional grounds that combine the teachings of Chen with those of Rothschild to show that implementing email advertisements with HTML would have been obvious. Petition, 78-83. Patent Owner ignores the teachings in Rothschild and the record—and instead relies on a narrow view of Rothschild based solely on a figure. Ex.1023, ¶¶8-9.

A. The Petition explains the obviousness of using HTML to implement interactive advertisements.

Rothschild explains that "[i]f the sender-selected advertisement 306 is a static advertisement, then the recipient will merely have an opportunity to view the advertisement **as provided in the e-mail**. If the sender-selected advertisement 306

is an interactive advertisement, then the recipient will also have **an opportunity to interact with the advertisement to receive additional communication data.**"

Ex.1005, 8:33-39; Petition, 42 (citing Ex.1003, 84). As stated in the Petition, "[g]iven 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." Petition, 33. A POSITA would have found it obvious to implement the interactive advertisement with HTML because "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')." Ex.1003, ¶58

The Petition further provides additional grounds 4-6 that provide "reasons why a POSITA would have found it obvious to implement Rothschild's interactive advertisements using HTML, as evidenced by Chen." Petition, 78. Chen 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." Petition, 79. While "Rothschild generically describes inserting an interactive advertisement within an e-mail," Chen "provides evidence that, indeed, techniques for inserting advertisements into an e-mail" such as HTML were known. Petition, 80-81. The

Petition thus relies on the *obviousness* of using HTML. Ex.1023, ¶¶ 10-11.

B. Patent Owner ignores the obviousness analysis in the Petition and instead attacks positions that were not made by Petitioner.

Patent Owner mischaracterizes the Petition as relying on inherency rather than obviousness: “But nowhere does Rothschild teach that its e-mails use HTML format, nor is that inherent.” Response. 33. Patent Owner further attacks an embodiment not relied on the Petition by arguing that “Rothschild discloses attaching interactive ads to SMS messages, which do not use HTML.” Response, 33. But the Petition does not rely on the obviousness of using HTML with SMS messages. The Petition instead relies on the obviousness of using HTML with interactive advertisements in *email* which was both conventional and obvious as evidenced by Chen.

Patent Owner further argues that “Petitioner fabricates an example of HTML code for the purposes of the Petition, citing the HTML specification and its own declarant’s testimony, but not Rothschild.” Response, 54. But the Petition does not suggest that the example HTML code is provided in Rothschild. Instead, the Petition presents an example of how a POSITA would understand Rothschild’s teachings based on their background knowledge and evidence of record (Chen and the HTML specification). Nor does the Petition rely on the advertisement being inserted into Rothschild’s message space 410, as Patent Owner asserts. *See* Response, 57-59.

Patent Owner further provides no substantive analysis regarding the obviousness combination presented in Grounds 4-6 regarding the obviousness of using HTML to implement email advertisements as taught by Chen. Patent Owner merely states that “Chen does not cure the deficiencies of Rothschild, including Rothschild’s use of Rich Text Format (RTF) for its emails, not HTML.” Response, 10. But pointing out that Rothschild provides an example that uses “rich text” does not address the obviousness of using HTML as outlined in the Petition. Ex.1023, ¶¶12-14.

C. Patent Owner relies on an overly narrow interpretation of Rothschild.

Patent Owner takes a narrow view of Rothschild by noting that the email window title in Rothschild’s Fig. 3 indicates “(rich text).” Response, 35. Patent Owner argues that “Petitioner has not shown that email in HTML format would necessarily have been used in Rothschild’s system, or explained why a POSITA would have sought to use emails formatted in HTML instead of RTF, as Rothschild expressly teaches.” Response, 34. Patent Owner thus appears to take the position that because the example e-mail window in Rothschild’s figure says “rich text,” a POSITA would understand that Rothschild’s interactive advertisements can *only* be used with a specific Microsoft format: Rich Text Format (RTF).

Patent Owner’s position ignores the law of obviousness. A POSITA is not

an automaton but is one of ordinary skill and creativity. *See KSR Int'l Co. v.*

Teleflex Inc., 550 U.S. 398, 421 (2007). A “court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id* at 418. Simply because Rothschild illustrates an exemplary email window with the words “rich text” does not mean that Rothschild *cannot* use emails formatted in HTML as was known to do. Ex.1023, ¶¶15-16.

Patent Owner further ignores the law of obviousness by arguing that “Rothschild has no need for Petitioner’s hypothetical HTML tags.” Response, 39. But simply because Rothschild illustrates one example in Fig. 3 does not mean that POSITAs would not have looked to known, suitable options for implementing the teachings described by Rothschild. *See Intel Corp. v. Pact XPP Schweiz AG*, 61 F.4th 1373, 1380 (Fed. Cir. 2023) (“It’s not necessary to show that a combination is the *best* option, only that it be a *suitable* option.”); Ex.1023, ¶¶ 8, 17.

D. Patent Owner attacks Rothschild individually—rather than the proposed obviousness ground.

At most, Patent Owner attacks the combination of Rothschild and Chen by attacking Rothschild individually—rather than addressing the proposed combination. Patent Owner’s alleged technical challenges of HTML do not properly refute the Petition’s obviousness analysis. Patent Owner argues that “Email in HTML format presented technical challenges at the time of the ’169 patent, including security, compatibility, and resource issues, so emails were often

sent in plain text or RTF format, not HTML.” Response, 34.

But Patent Owner's argument discounts the “background knowledge” of a POSITA. *See KSR* at 418. By the priority date of the '169 patent, it was already conventional and known to implement email advertisements using HTML. *See Chen*, 2:36-41. Chen 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, 8:19-26. Even Patent Owner's own evidence explains that “[y]ou can use RTF when you send messages inside an organization that uses Microsoft Exchange, **but we recommend that you use the HTML format.**” Ex.2019, 2. Ex.1023, ¶¶ 18-19.

Thus, POSITAs had already successfully implemented email advertisements using HTML. In other words, POSITAs had already made the combination proposed by Petitioner. Thus, a POSITA evaluating Rothschild would have had the background knowledge necessary to overcome potential problems related to using HTML. *See Ex.1003*, ¶¶ 187-93. Patent Owner's argument ignores this background knowledge and treats a POSITA as an automaton, and should therefore be rejected. *See KSR*, 550 U.S. at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

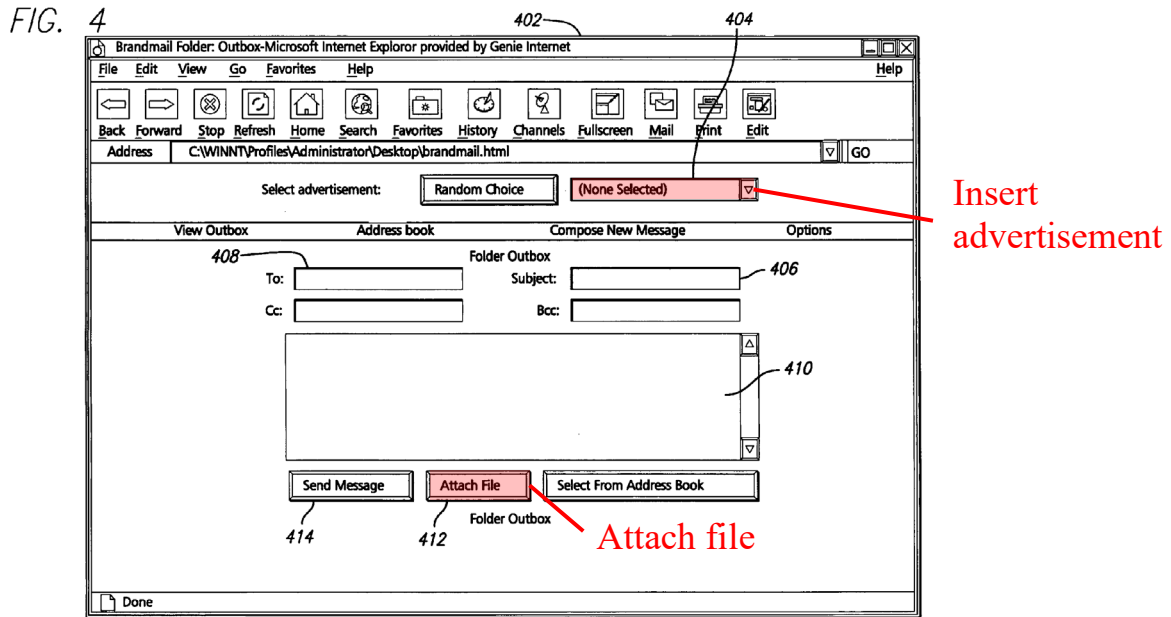
Thus, the POSITAs would not have avoided using HTML simply because of the technical challenges Patent Owner alleges. For the reasons explained in the

Petition, “the combination of Rothschild and Chen represents the combination of known elements (e-mail advertisements) according to known methods (HTML) to yield predictable results.” Petition, 82; Ex.1023, ¶¶ 20-21.

IV. Rothschild's interactive advertisements teach a “*hot link*” as claimed regardless of how the advertisements are presented.

Patent Owner ignores the plain teachings of Rothschild, in which advertisements are provided “in the e-mail” rather than attached to the email. Ex.1005, 8:31-64; Petition, 42. Patent Owner instead relies on Rothschild's Fig. 3 to argue that “[t]he interactive ad is attached in-line with the message, rather than being attached outside of the message body—which is a feature that Outlook offers only for RTF messages, not HTML messages.” Response, 35. But again, for the reasons explained above, Petitioner does not rely on the RTF example.

Rothschild expressly distinguishes between inserting advertisements and attaching files. Indeed, as shown in Fig. 4, there is one mechanism (412) to attach a file, and a separate, distinct mechanism (404) for inserting an advertisement.



Ex.1005, Fig. 4 (annotated).

Rothschild further distinguishes attachments and advertisements in the description. *See* Ex.1005, 11:7-10 (“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.”).

Accordingly, by relying on separate mechanisms for attaching files and inserting advertisements, Rothschild suggests that inserting advertisements is different and distinct from attaching files. Given that Rothschild suggests providing the advertisement “in the e-mail” rather than as an attachment, a POSITA would have found it obvious to implement the advertisement using HTML as was known and conventional in the art. Ex.1023, ¶¶ 22-24

Patent Owner’s focus on the illustrated example of Fig. 3 rather than the

text—and other figures—does not address the positions presented in the Petition.

The Petition explains that Rothschild’s interactive advertisements with embedded URLs “may be displayed as ‘an icon, graphic, text, or voice message that can be interacted with to provide the recipient with additional communication data.’”

Petition, 81 (citing Ex.1005, 8:22-25). Thus, “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.” Petition, 81. The Petition explains that implementing Rothschild’s interactive advertisement with HTML was conventional background knowledge (Grounds 1-3) and would have been obvious (Grounds 4-6).

Rothschild’s interactive advertisements—implemented using HTML—teach “*instructions for rendering and displaying the hot link*” and “*assignment information*” as claimed. Ex.1023, ¶¶ 25-26.

Claim Term	Rothschild’s Teachings
<i>“instructions for rendering and displaying the hot link”</i>	HTML tags (“ <i>instructions</i> ”) <u>define how the embedded URL is displayed within the interactive advertisement.</u> Petition, 33 (citing Ex.1010, 35; Ex.1011, 179). Petitioner provided an alternate interpretation as well. Petition, 34.
<i>“assignment information”</i>	“A POSITA would have understood that <u>data contained within an e-mail messages that associates</u> the graphic, text, or icon with the advertisement is ‘ <i>assignment</i> ’

	<i>information’ ...”</i> “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.” Petition, 43.
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Patent Owner attempts to limit Rothschild’s teachings to only *attaching* the advertisements to the email so they can argue that “Rothschild attaches interactive ads as separate pre-existing files, not as part of HTML tags.” Response, 39. But whether Rothschild’s interactive advertisements are provided in the email or provided as an attachment, it would still have been obvious to embed the URL into the advertisement using HTML. In other words, Rothschild’s interactive advertisement—were it to be sent as an attachment—would still include “*instructions*” and “*assignment information*” as claimed. Because the claims do not specify how the hot link is included within the hot link message, Patent Owner does not refute the Petition’s obviousness analysis by arguing (wrongly) that Rothschild’s interactive advertisements are attached rather than presented in the e-mail. Ex.1023, ¶ 27.

V. Rothschild teaches the concepts recited in the dependent claims.

Claim 6 recites in part “*identify a user interface element for activation of the hot link prior to generation of the hot link.*” Patent Owner argues that “Claims 6 and 11 require identifying a user interface element ‘prior to generation of the hot link,’ meaning the hot link that claim 1 (from which claim 6 depends) or claim 10

(from which claim 11 depends) requires generating during the message creation process.” Response, 60. But for the reasons explained above, the Petition does indeed show that generation of the interactive advertisement (“*hot link*”) occurs when the selected advertisement data and email message are formatted. And the Petition explains that “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.” Petition, 42.

Patent Owner further argues that in Rothschild “[t]he user inputs the email address, however, so the server does not determine any email address, as claims 8 and 16 require.” Response, 62. But the Petition explains how Rothschild’s system “*determine[s] a location for each*” recipient device: “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.” Petition, 45. This is consistent with how the ’169 patent determines locations for recipient devices. *Id.*

VI. Rothschild teaches the “control” language as claimed.

Patent Owner notes that “Nine limitations in six claims require ‘controlling’ transmission, receipt, selection, or submission.” Response, 62. Patent Owner then argues that “controlling transmission (or receipt, selection, or submission) requires more than simply transmitting.” Response, 65. Patent Owner’s expert explains that

“[c]ontrol is used to denote one or more decisions made by the computer,”

consistent with the '169 patent's description of an operating system 320 and BIOS 318. Ex.2009, ¶134.

But the claims do not require the “control” to be done using an operating system or BIOS. Rothschild teaches controlling transmission (or receipt, selection, submission) with the same level of specificity as recited in the claim. While the specification of the '169 patent describes an operating system or BIOS, there is nothing that provides detail as to how the operating system or BIOS controls transmission or receipt. When asked in deposition if “the specification of the '169 patent explain[s] how either the operating system or BIOS controls receipt of a packet,” Patent Owner's expert explained that “this is something that a POSA would understand anyways. So a POSA would be familiar with operating systems and BIOSes and how they operate.” Ex.1024, 24. Thus, The Petition's analysis is sufficient to show obviousness of the “control” claim limitations. Petition, 35. For similar reasons, Rothschild teaches the other “control” limitations. Petition, 38, 68, 72.

VII. A POSITA would have found it obvious to include positive and negative feedback buttons

Patent Owner argues that “Petitioner fails to explain how the jumbled mess of discrete pieces in its combination would work together to deliver feedback to advertisers—which is Petitioner's sole alleged motivation to combine.” Response,

66. “It is Petitioner’s motivation to combine—not the claims—that requires considering the question of whether the advertising entities receive any feedback.” Response, 67. But a motivation to combine does not require solving every technical detail a POSITA may encounter, particularly details that are unclaimed. *See Axonics v. Medtronic*, 73 F.4th 950, 957 (Fed. Cir. 2023) (“The inquiry is not whether a relevant artisan would combine a first reference’s feature with a second reference’s feature to meet requirements of the first reference that are not requirements of the claims at issue.”) The claims do not recite *how* the advertiser receives feedback from the positive and negative buttons. The claims simply recite that the GUI includes the buttons, which the Petition addresses. Petition, 73-78; *see also* Ex.1012, 26.

VIII. Rothschild is different than the O’Neal reference used in prosecution.

Patent Owner argues that during prosecution “the Examiner considered and dismissed references similar to those that Petitioner relies on.” Response, 3. But while O’Neal describes “common email functionality,” O’Neal does not teach inserting interactive advertisements with embedded URLs as Rothschild does. *See* Ex.1005. Rothschild’s interactive advertisement with an embedded URL teaches a “*hot link*” as claimed. *See* Petition, 26-30.

IX. Conclusion

Patent Owner’s Response arguments should be rejected, and the Challenged

Claims should be found unpatentable.

Respectfully submitted,

Dated: December 8, 2023

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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 Reply, that the number of words in this paper is 5,596. This word count excludes the table of contents, table of authorities, mandatory notices under §42.8, certificate of service, certificate of word count, signature block, and appendix of exhibits. *See* 37 C.F.R. §42.24(c).

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CERTIFICATE OF SERVICE

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

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