

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

**DECLARATION OF DR. HENRY HOUH, PH.D.,
UNDER 37 C.F.R. § 1.68
IN SUPPORT OF PETITIONER REPLY**

TABLE OF CONTENTS

I.	Introduction.....	3
II.	Summary of Opinions.....	4
III.	Explanation of Opinions	5
A.	A POSITA would have found it obvious to implement Rothschild’s interactive advertisements using HTML.....	5
B.	My original declaration explains the obviousness of using HTML to implement interactive advertisements.	6
C.	Patent Owner ignores the obviousness analysis in the Petition and instead attacks positions that were not made by Petitioner.....	7
D.	Patent Owner relies on an overly narrow interpretation of Rothschild.....	8
E.	Patent Owner attacks Rothschild itself rather than the proposed obviousness ground.	10
F.	Rothschild’s interactive advertisements teach a “ <i>hot link</i> ” as claimed regardless of how the advertisements are presented.	12
IV.	Summary	15
V.	Conclusion	16

I, Henry Houh, Ph.D., declare as follows:

I. INTRODUCTION

1. I am the Henry Houh who has previously submitted a declaration as Ex.1003 in this proceeding. The terms of my engagement, my background, qualifications and prior testimony, and the legal standards and claim constructions I am applying are set forth in my previous CV and declaration. *See* Ex.1003; Ex.1004. I offer this declaration in reply to the Patent Owner Response filed in this proceeding.

2. I have been retained as an independent expert consultant in this proceeding before the United States Patent and Trademark Office (the “Patent Office”). I am being compensated for my work in this matter at my standard hourly rate. I am also being reimbursed for reasonable and customary expenses associated with my work and testimony in this investigation. My compensation is not contingent on the outcome of this matter or the specifics of my testimony.

3. I previously submitted an expert declaration in support of Google, Inc.’s Petition for *inter partes* review (IPR) regarding U.S. Patent No. 10,869,169 (“the ’169 patent”) to Engstrom *et al.* *See* Ex. 1003. I understand that Patent Owner Wildseed submitted a Patent Owner Response (“Response”) in IPR2023-00247 (Paper 17) addressing grounds for obviousness presented by Petitioner in its Petition. I submit this expert declaration in support of Petitioner’s Reply to the

Response.

4. Details regarding my qualifications, testifying experience, employment history, fields of expertise, and publications are provided in my prior declaration and my CV, Ex. 1003; Ex.1004.

5. In the preparation of this declaration, I have studied the materials listed in Ex.1003, as well as the materials cited in this declaration, including:

- a. Declaration of Sam Malek, Ex. 2009;
- b. Patent Owner's Response, Paper 20;
- c. Certified Transcript from Deposition of Sam Malek, Ex.1024.

6. In forming the opinions expressed below, I have also considered the relevant legal standards, including the standard for obviousness, and any additional authoritative documents as cited in the body of this declaration, as well as my own experience and training in the field of magnetics.

7. Unless otherwise noted, all emphasis in any quoted material has been added.

II. SUMMARY OF OPINIONS

8. I disagree with Dr. Malek's and Patent Owner's position that a POSITA looking at Rothschild would interpret the words "rich text" in the email window of Fig. 4 to mean that Rothschild's interactive advertisements can *only* be

implemented with emails in Microsoft's Rich Text Format (RTF)¹. It is my understanding that a POSITA is one of ordinary creativity and skill and is not an automaton. A POSITA would have therefore relied on their background knowledge and skill to implement an interactive advertisement within an email in a variety of known methods (including HTML) for providing rich text in an email and email advertisement—not just Microsoft's RTF.

III. EXPLANATION OF OPINIONS

A. A POSITA would have found it obvious to implement Rothschild's interactive advertisements using HTML.

9. As I explained in my original declaration, 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. Ex.1003, ¶58. I further presented additional grounds that combine the teachings of Chen with those of Rothschild to show that implementing email advertisements with HTML would have been obvious. Ex.1003, ¶¶185-96. The Response ignores the teachings in Rothschild and the record—and instead relies on an overly narrow

¹ The references Dr. Malek cites explain that "Rich Text Format (RTF) is a Microsoft format that's supported only by these email applications: Microsoft Exchange Client versions 4.0 and 5.0 [and] All versions of Outlook."

view of Rothschild based solely on a figure.

B. My original declaration explains the obviousness of using HTML to implement interactive advertisements.

10. 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; Ex.1003, 84. “Given that Rothschild describes an interactive advertisement that is displayed with a graphic and includes an embedded URL, a POSITA would have recognized that such interactive advertisement would be implemented using HTML.” Ex.1003, ¶58. 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.

11. Additional grounds 4-6 further provide “reasons why a POSITA would have found it obvious to implement Rothschild’s interactive advertisements using HTML, as evidenced by Chen.” Ex.1003, ¶185. 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.” Ex.1003, ¶186. 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. Ex.1003, ¶190. It is thus my opinion that using HTML to implement interactive advertisements in email is *obvious*.

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

12. Importantly, it is my opinion that using HTML to implement interactive advertisements in email is *obvious* and not inherent as Patent Owner implies: “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 by arguing that “Rothschild discloses attaching interactive ads to SMS messages, which do not use HTML.” Response, 33. But my opinion does not rely on the obviousness of using HTML with SMS messages. My opinion instead relies on the obviousness of using HTML with interactive advertisements in *email* which was both conventional and obvious as evidenced by Chen.

13. 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 my declaration does not claim that Rothschild provides the exemplary HTML code. Instead, my declaration presents an example of how a POSITA would understand Rothschild's teachings based on their background knowledge, Chen, and the HTML specification. Nor does my declaration rely on the advertisement being entered into Rothschild's message space 410, as Patent Owner asserts. *See* Response, 57-59.

14. Patent Owner does not respond to the obviousness ground my declaration presents 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 my declaration.

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

15. 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).

16. The term “rich text” by itself merely indicates to a POSITA something beyond plain text. Rich Text Format (RTF), on the other hand, is a specific, proprietary format used by Microsoft. CITE. Regardless of whether RTF can be used to implement interactive advertisements, it would have been obvious to implement email with interactive advertisements using HTML—particularly in the web-based email system described by Rothschild. Ex.1005, 8:64-9:31.

17. Again, a POSITA is not an automaton but is one of ordinary skill and creativity. Patent Owner further argues that “Rothschild has no need for Petitioner’s hypothetical HTML tags.” Response, 39. 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. Simply because Rothschild illustrates one example in Fig. 3 of using rich text does not mean that POSITAs would not have looked to known, suitable options for implementing the teachings described by Rothschild.

E. Patent Owner attacks Rothschild itself rather than the proposed obviousness ground.

18. 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 obviousness analysis in my declaration. 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. This contradicts the references that Dr. Malek cites, which state that RTF is only compatible with Microsoft Exchange Clients and all versions of Microsoft Outlook, and that RTF messages are converted to HTML format when sent outside the sender’s organization:

Rich Text Format (RTF) is a **Microsoft format that’s supported only by these email applications:**

- Microsoft Exchange Client versions 4.0 and 5.0
- All versions of Outlook

You can use RTF when you send messages inside an organization that uses Microsoft Exchange, but **we recommend that you use the HTML format. In fact, when you send an RTF message to someone outside your organization, Outlook automatically converts it to HTML**, so the message keeps its formatting and its attachments.”).

Ex 2019, p. 2.

19. But Patent Owner’s argument discounts the “background knowledge” of a POSITA. By the priority date of the ’169 patent, it was already conventional and known to implement email advertisements using HTML. *See* Ex.1007, 2:37-39. 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.

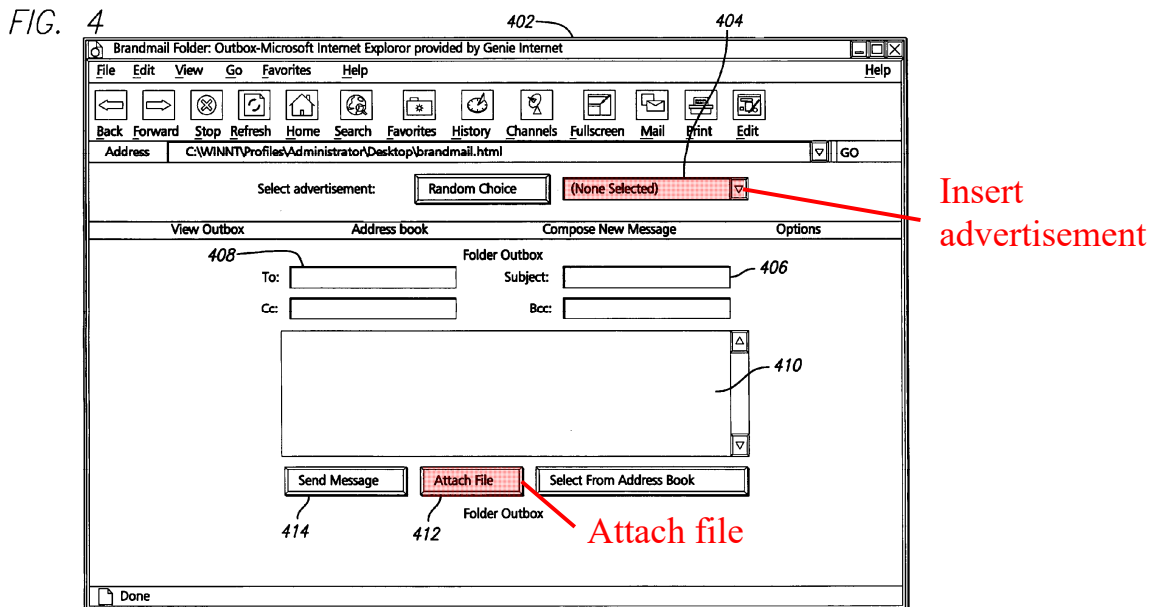
20. Thus, POSITAs had already successfully implemented email advertisements using HTML. In other words, POSITAs had already made the combination proposed by Petitioner. A POSITA evaluating Rothschild would have had the background knowledge necessary to overcome potential problems related to using HTML. *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.

21. 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.” Ex.1003, ¶193.

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

22. Patent Owner and Dr. Malek ignore the plain teachings of Rothschild, in which advertisements are provided “included within the e-mail” rather than attached to the email. Ex.1005, 11:28-30; Ex.1003, ¶70. 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, I do not rely on the RTF example, and Dr. Malek’s arguments are undermined by the documents to which he cites.

23. 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).

24. 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.

25. 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 my declaration. As I explained, 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.’” Ex.1003, ¶57 (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.” Ex.1003, ¶189. The Petition thus explains that implementing Rothschild’s interactive advertisement with HTML was conventional background knowledge (Grounds 1-3) and would have been obvious (Grounds 4-6).

26. Rothschild’s interactive advertisements—implemented using HTML—teach “*instructions for rendering and displaying the hot link*” and “*assignment information*” as claimed. Ex.1003, ¶¶54-62, 87-90.

27. 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. Thus it still would have been

obvious for the interactive advertisement as attached to include “*instructions*” and “*assignment information*” as claimed. Said differently, nothing in the claim language excludes sending the “*hot link*” as an attachment to an email. 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.

IV. SUMMARY

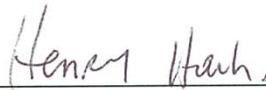
28. In summary, a POSITA would have found it obvious for Rothschild’s interactive advertisements to be implemented using HTML, both because it was conventional to do so and would have been obvious in view of the prior art of record (Chen and the HTML specification).

V. CONCLUSION

29. This declaration and my opinions herein are made to the best of my knowledge and understanding, and based on the material available to me, at the time of signing this declaration. I declare that all statements made herein on my own knowledge are true and that all statements made on information and belief are believed to be true, and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 or Title 18 of the United States Code.

Date: December 8, 2023

Respectfully submitted,



Henry Houh, Ph.D.