

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

WILDSEED MOBILE, LLC,
Patent Owner

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

PATENT OWNER'S SUR-REPLY

Mail Stop "PATENT BOARD"

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

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I. INTRODUCTION

Petitioner misunderstood its main reference and has not demonstrated the obviousness of any challenged claim, even considering its impermissible new arguments.

II. THE PETITION FAILS TO DEMONSTRATE THE OBVIOUSNESS OF ANY CHALLENGED CLAIM.

A. Independent Claims 1 and 10 are not rendered obvious by Petitioner's cited art.

1. The prior art does not teach “generat[ing] a hot link” as claimed (limitation 1.1, 10.2).

For this limitation, the Petition expressly relied on creating ads (allegedly “hot links”) during message formatting. Pet., 26-29; EX2009, ¶¶46-51 (citing same); Reply, 12. But, as Dr. Malek explained and Petitioner concedes, Rothschild creates ads *before*—not during—message formation. EX2009, ¶¶57-71; Reply, 5 (timeline showing “ad is created by advertiser” before user selects it), 13.

Petitioner also admits it “does not rely on the initial creation of the advertisement.”

Reply, 2, 14. Thus, Petitioner fails to establish the theory presented its Petition.

Henny Penny Corp. v. Frymaster LLC, 938 F.3d 1324, 1330 (Fed. Cir. 2019)

(holding “the Board did not abuse its discretion by holding [petitioner] to the obviousness theory in its petition”).

a. The formatting step does not generate ads, as Dr. Houh admitted at deposition.

Petitioner asserts although Rothschild never says so, formatting email “generates” hot links. Reply, 12. Both experts explained Petitioner is wrong. Dr. Houh admitted email already includes ads before formatting, and his supplemental declaration says nothing about this topic. EX2009, ¶122. Petitioner never addresses his admission, nor Dr. Malek’s explanation that formatting does not insert or otherwise affect ads. EX2009, ¶¶55, 97.

b. Rothschild sends pre-existing ads; inserting ads does not teach “generat[ing] a hot link” (limitations 1.1, 10.2).

Petitioner admits Rothschild uses pre-existing ads, and does not create ads after users select them. *See* Reply, 5, 13. Petitioner now improperly raises a new argument that “generating” merely requires inserting, not creating. Reply, 12-13. The Board should disregard this argument because it is presented for the first time in Petitioner’s Reply. *Henny Penny*, 938 F.3d at 1331 (finding the Board properly “disregard[ed] [Petitioner’s] new theory first raised in reply”); Consolidated Trial Practice Guide (“TPG”), 74 (“[A] reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered”). Petitioner implies its new argument matches the original because both refer to “insertion of the advertisement.” Reply, 2 (citing Pet., 26). Unlike its new argument, however, Petitioner’s original “insertion” required creating interactive ads. Pet., 26-29;

EX2009, ¶¶46-51 (citing same). Petitioner’s new theory is inconsistent with the ordinary meaning of “generate,” which requires creation, as Dr. Malek’s un rebutted expert opinion demonstrates:

Q. So in your opinion, what does the word “*generate*” mean with respect to Claims 1 and 10?

A. I mean, it’s the *plain and ordinary meaning* of the term. So *generate* would mean to *create something new* that doesn’t exist.

...

Q. But is there a specific portion of the ‘169 patent that -- that you relied on to -- for your definition of the word “*generate*”?

A. Yeah. ... I’m finding a lot of places where the word “*generate*” is used, and it’s *always* used in the context of what I ... described.

EX1024, 32:23-33:2, 33:20-34:2¹.

Dr. Malek also explained inserting is not “generating:”

The claims require generating—not merely inserting—a hot link. Inserting a pre-existing ad into a new message, for example, does not generate an ad.

EX2009, ¶48.

Ignoring that testimony, Petitioner asserts incorrectly that “[n]othing in the specification of the ’169 patent supports such an interpretation of the word ‘generate.’” Reply, 14. Petitioner asserts inserting qualifies as “generating”

¹ Emphasis added unless otherwise noted.

because the '169 patent's Figure 7 shows pre-created content. Reply, 13-14. What is pre-created in Figure 7, however, is content—not links. Links will be created in the future using Figure 7's content and actions that “may be used to generate a hot link,” after users select actions “to be” associated with links. EX1001, 12:15-16, 12:28-30.

Petitioner asserts the Petition did not construe “generate” to mean create. Reply, 14. Petitioner tacitly admitted the opposite. First, Petitioner still requires creating to satisfy “generat[ing]” messages. Reply, 12-13. Second, if “generate” merely requires inserting, Petitioner could have alleged anticipation using Rothschild alone, instead of combining it with HTML tags for the sole purpose of creating hot links.

Even if “generate” merely required inserting, a POSITA would not insert Rothschild's ads into HTML-formatted email because they are incompatible—as Dr. Malek explained and Petitioner never rebuts. EX2009, ¶¶113, 115-119.

c. Ads selected using the pull down menu are pre-existing ads.

Petitioner now admits this. *See* Section II.A.1.b.

2. Petitioner has not identified any trigger to generate a hot link (limitation 1.1).

Petitioner admits Rothschild's menu 404 shows only pre-created ads. *See* Section II.A.1. That admission is fatal to both of Petitioner's theories regarding

“identify a trigger to generate a hot link”: (1) servers sending ads for inclusion in menu 404 and (2) servers receiving users’ ad selections from menu 404. Reply, 7-9. Rothschild’s interactive ads exist before menu 404 shows them—and before servers receive selections from that menu. Thus, Petitioner’s identified triggers do not generate (create) those ads. EX2009, ¶¶105-108, 111-112. Even considering Petitioner’s new theory that “generate” merely requires “inserting” (*see* Section II.A.1.b), Petitioner’s second theory fails: servers do not receive menu selections, and therefore do not identify triggers to insert ads; instead, as Dr. Houh admitted, ads are already inserted in emails. EX2011, 179:4-180:12; EX2009, ¶¶52-53.

3. Rothschild discloses sending pre-existing ads without using HTML tags (limitations 1.1, 10.2).

Rather than use HTML tags, Rothschild discloses Rich Text Format (RTF) emails with ads included as attachments, as Dr. Malek explained. EX2009, ¶¶80-87. Petitioner mistakenly asserts that Rothschild suggests email with body text containing ads wrapped in HTML tags. EX2009, ¶¶80-102; Reply, 23-24. Petitioner initially cited—but now runs from—Rothschild’s Figure 3 because Dr. Malek explained it cannot contain HTML tags. EX2009, ¶¶80-87; Reply, 21; Pet., 21, 28, 50, 61 (each annotating Fig. 3).

Dr. Malek explained and Petitioner admits that ads are pre-existing. *See* Section II.A.1. Dr. Malek also explained why “Rothschild makes it impossible for an existing interactive ad to be ... inserted into the body of an HTML email.”

EX2009, ¶115. Petitioner never rebuts Dr. Malek’s analysis. Instead, Petitioner merely states Rothschild can be combined with HTML, implying that something else could be relevant, but never identifies anything else. Reply, 15, 16, 18, 20.

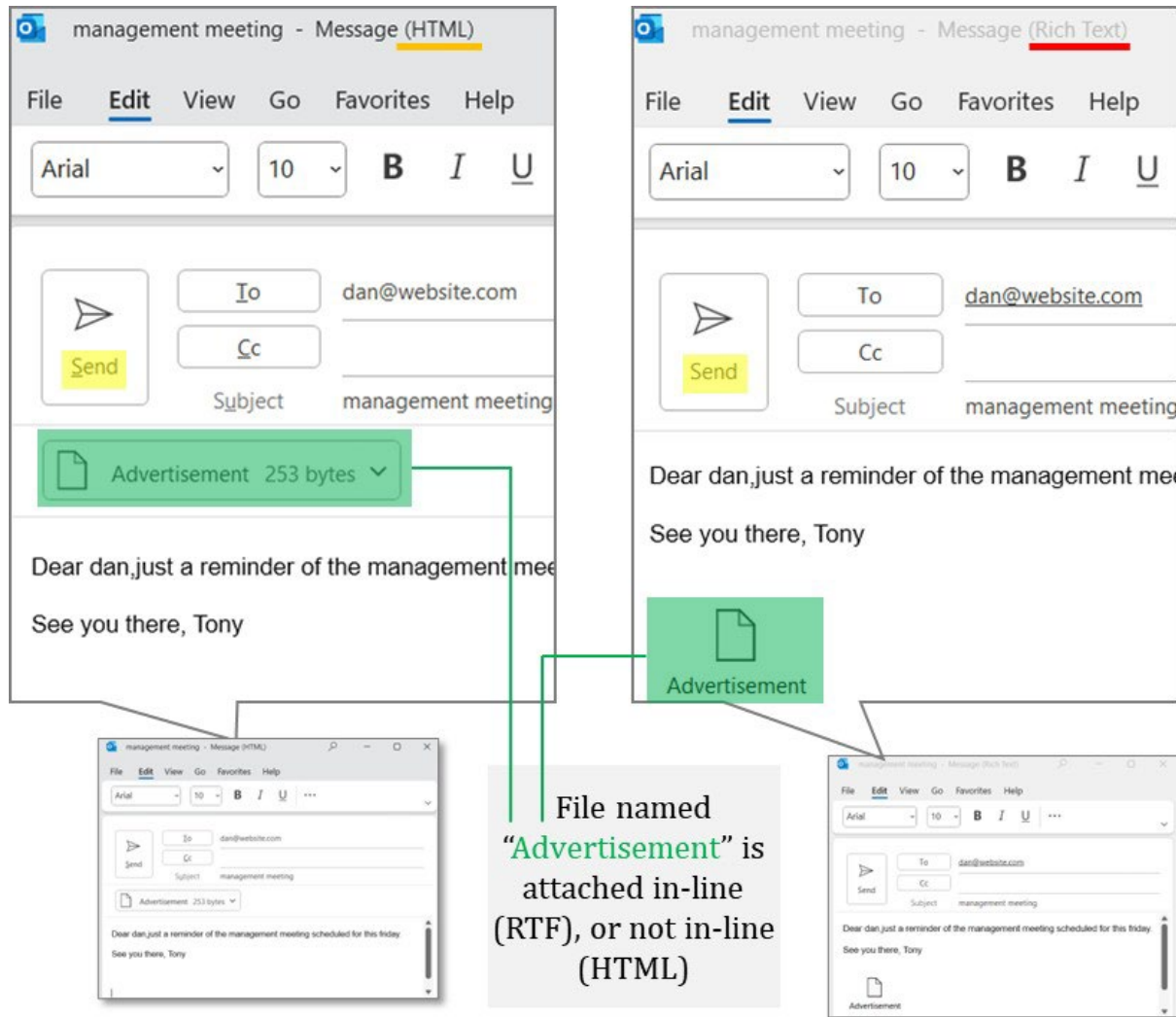
Petitioner alleges incorrectly that “Patent Owner ... provides no substantive analysis regarding the obviousness combination presented in Grounds 4-6,” Reply, 18. Petitioner admits Grounds 4-6 are identical to Grounds 1-3, except they cite Chen more formally. Pet., 82-83; Reply, 18. Thus, Patent Owner’s arguments apply equally to Grounds 4-6.

Dr. Malek disagrees it is obvious to use HTML with Rothschild. EX2009, ¶79. Nevertheless, he analyzed the combination. Petitioner explains that in HTML generally, ads can be inserted into email ““with or *without* HTML links”” (i.e., HTML tags). Reply, 16 (quoting EX1007, 8:23-26). Put another way, Chen expressly states that HTML email with ads does not require or imply using HTML links, because HTML email can insert ads “without” HTML links. The “without” option is what Rothschild combined with HTML yields. Dr. Malek explained that HTML tags are incompatible with Rothschild’s interactive ads, so although combining Rothschild with HTML could yield HTML-formatted email messages, those HTML messages include ads only as attachments, never with HTML tags. EX2009, ¶¶97-101. Petitioner never rebuts Dr. Malek’s explanation. Reply, 18.

a. Petitioner’s argument relies on the false assumption that Rothschild’s advertisements are in HTML format.

Petitioner originally proposed that Rothschild’s interactive ads are in HTML format, in part because Dr. Houh “mistakenly believed that HTML was the only format for rich email at the time of the invention.” EX2009, ¶¶77. Dr. Malek rebutted this assertion, explaining that Rothschild discloses email in RTF—not HTML—format, and that ads are included as attachments, not using HTML tags. EX2009, ¶¶80-87. Petitioner never disputes that.

Dr. Houh—but not Petitioner—asserts “rich text” in Rothschild Figure 3’s is generic, not a reference to Microsoft’s RTF format. EX1023, ¶16 (no citation except the placeholder “CITE”). That is wrong. As Dr. Malek testified and Dr. Houh never rebuts, Microsoft Outlook shows in-line attachments only in RTF format, not HTML format. EX2009, ¶82. Further, Outlook’s window title states “(Rich Text)” indicating the email is in “Rich Text Format” (RTF)—as opposed to “(HTML)” format.



EX2009, ¶83. Petitioner insists Rothschild could be used with HTML emails.

Reply, 15-24. Dr. Malek provided an example of exactly that—recreating Figure 3 with HTML email (see graphic above). The HTML email includes the ad as an attachment—not with HTML tags—because HTML tags are incompatible with Rothschild’s interactive ads. EX2009, ¶¶113-126. Petitioner never rebuts Dr. Malek’s analysis.

Rothschild makes no mention of HTML email. Dr. Malek explained that RTF was preferable at the time for many reasons. EX2009, ¶78. Petitioner never rebuts Dr. Malek’s testimony, merely noting that in 2023, Microsoft recommends HTML and converts RTF emails to HTML format. Reply, 20; EX1023, ¶¶18-19. But Dr. Malek explained that even if Rothschild’s emails were converted to HTML format, ads would be included as attachments, not with HTML tags. EX2009, ¶¶97-101. Further, that 2023 document is decades newer than Rothschild, so cannot rebut Dr. Malek’s testimony that RTF was preferable in Rothschild’s time.

b. Rothschild discloses sending ads attached to RTF format emails, without any HTML tags.

Petitioner admits ads are pre-created, not created using HTML tags during message formation. *See* Section II.A.1. Dr. Malek explained that Figure 3: (1) is Rothschild’s only visual example of email, (2) shows email in RTF format with an attachment, and (3) does not show any HTML formatting or tags. Tellingly, Petitioner provides no rebuttal and no longer relies on Figure 3. Reply, 21 (“Fig. 3 ... Petitioner does not rely on the RTF example.”).

c. Rothschild attaches ads as pre-existing files, not as part of HTML tags.

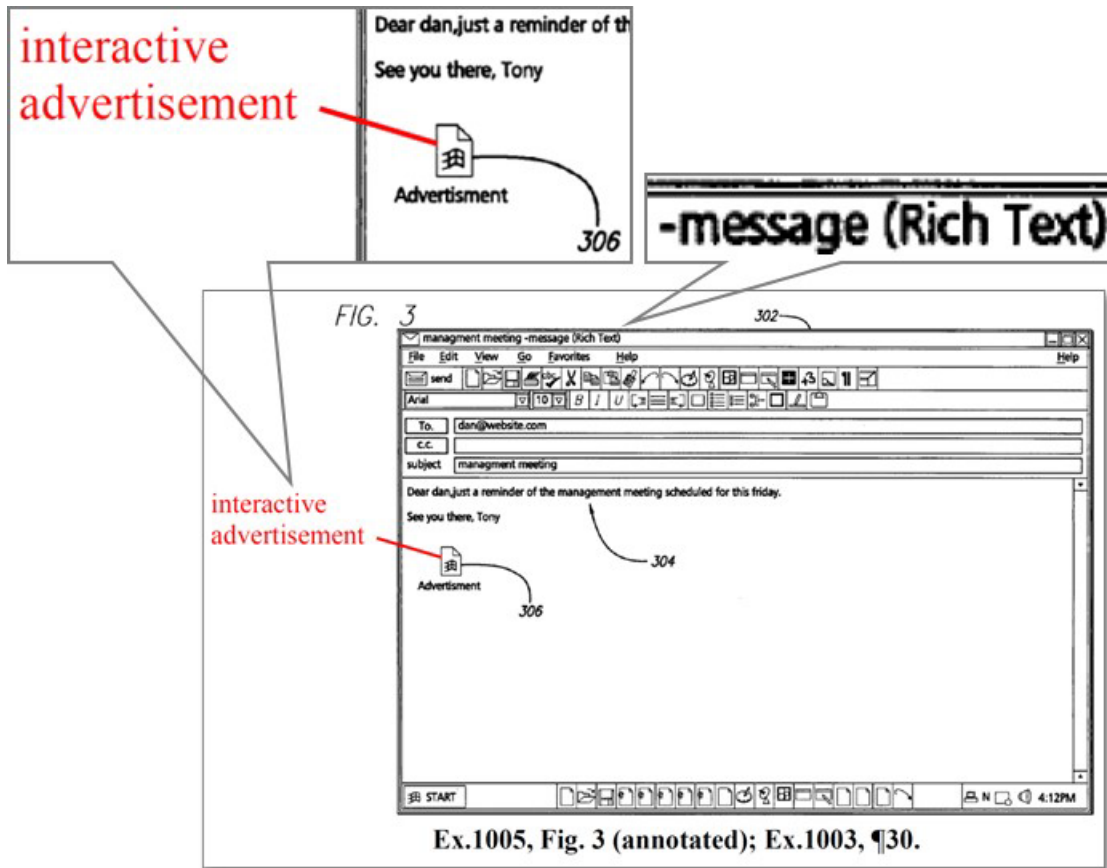
Dr. Malek explained Rothschild’s ads are always attached, pre-existing files. EX2009, ¶¶57-71, 80-102. Petitioner never responds on the merits, instead citing

aspects of Rothschild that supposedly suggest including ads without attaching them. Reply, 21-24.

Petitioner asserts incorrectly that Rothschild's reference to ads "in the email" (1) proves ads are not attached and (2) suggests using HTML. Reply, 21, 22 (quoting EX1005, 8:31-64). To the contrary, the quote expressly refers to as email "containing" an attached ad "in the e-mail:"

FIG. 3 shows an e-mail message The e-mail message *contains* a personal message 304 and a sender-selected *advertisement* 306.... [T]he recipient will merely have the opportunity to view the advertisement as provided *in the e-mail*.

EX1005, 8:31-35. Petitioner quotes—but never rebuts—Dr. Malek's analysis establishing that Figure 3 shows an email in RTF format where an "ad is *attached in-line* with the message, rather than being attached outside of the message body." Reply, 21 (quoting POR, 35). The ad is attached "in-line," meaning "in" the email's body as Figure 3 visually shows, but it is still an attachment.

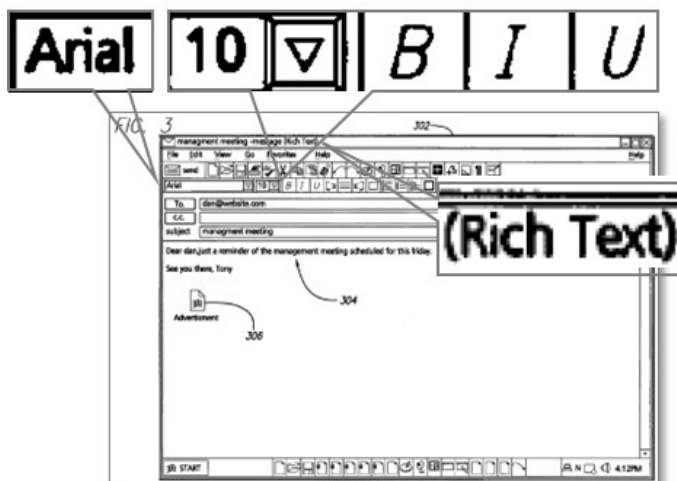


EX2009, ¶82 (citing Pet., 21). The Figure 3 email cannot use HTML. EX2009, ¶¶82-87. As Dr. Malek explained, HTML tags are incompatible with Rothschild’s interactive ads in any context (not limited to Figure 3), and “Rothschild makes it impossible for an existing interactive ad to be ... inserted into the body of an HTML email.” EX2009, ¶115. Thus, Dr. Malek’s testimony establishes Rothschild uses “in an email” to refer to attachments, not HTML tags.

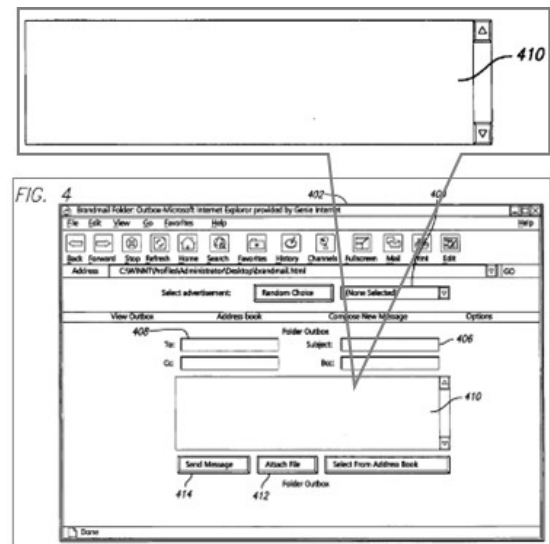
Petitioner initially cited Figure 3 because it misunderstood the figure. EX2009, ¶¶80-102. Tacitly conceding Dr. Malek is correct that Figure 3 shows an RTF email with an attached ad, Petitioner no longer relies on Figure 3 and never rebuts Dr. Malek’s explanation, instead asserting he focused “solely” on that

figure. Reply, 21-23. That is wrong. Dr. Malek extensively analyzed other Rothschild text and figures to explain why ads are pre-existing and attached—always—to all messages, in all embodiments. EX2009, ¶¶75-102

Petitioner asserts that Rothschild distinguishes ads and attachments, and Figure 4 shows (1) selecting ads from menu 404, and (2) the “attach file” button. Reply, 22. That is true but does not show including ads in an email without attaching them. After all, Figure 4 generates the email of Figure 3, which attaches an ad and has no HTML tags. EX1005, 9:11-13 (“If the sender indicates a desire to send an e-mail to a recipient, he may be provided with an e-mail communication page 402, as shown in FIG. 4.”). Thus, Figure 4’s menu 404 only discloses attaching ads, not using HTML tags. Indeed, Figure 4 shows only plain text input boxes that cannot possibly use HTML tags:



Rich Text Format



Plain text, no format options

EX2009, ¶92. Petitioner never rebuts Dr. Malek’s testimony.

Dr. Malek explained that Rothschild’s menu 404 and “attach file” button are different ways to attach ads. EX2009, ¶119. Petitioner never addresses Dr. Malek’s analysis. Figure 4 provides both the Rothschild-specific menu 404 and industry-standard “attach files” button to allow attachment of files from different sources. Specifically, menu 404 selects ads from ad palettes stored in web site memory. Pet., 22-23 (quoting EX1005, 9:26-30 (“[M]enu 404 gives the sender the ability to choose an advertisement from a sender created palette of advertisements.”)); EX1005, 9:41-44 (“advertisements that are stored in the Web site memory device”). The “attach file” button allows sending other files, such as user-provided ads that are not in the user’s ad palette. EX2009, ¶118 (citing EX1005, 8:39-47 (“*interactive, sender-provided, advertisement*”). Further, menu 404 enables functionality specific to Rothschild but does not eliminate the need for attaching files as usual. *See* EX1005, 9:23-26 (“attach file button 412 [] allows the sender to attach separate files to the e-mail.”).

Figure 4 provides only plain text input that cannot use HTML tags. EX2009, ¶95. Petitioner never disputes Dr. Malek’s analysis and asserts it does not rely on message box 410—but that is exactly what Dr. Houh pointed to. EX2009, ¶120 (citing EX2011, 179:4-180:12 (“So that’s how the actual ... code of the hotlink ... would end up in that *message box 410*.”)).

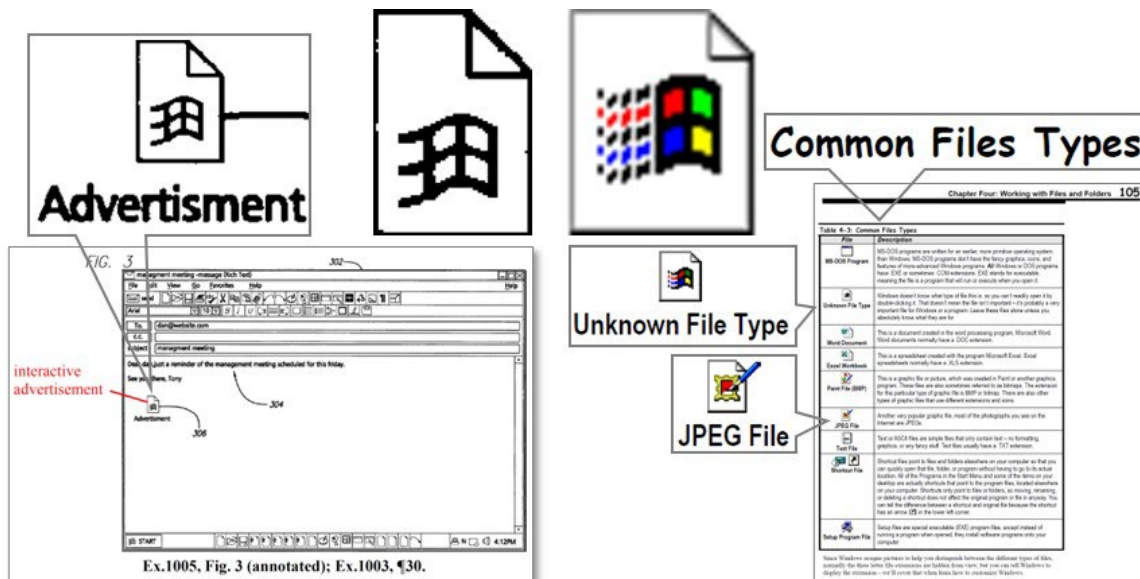
Petitioner further asserts Rothschild omits HTML tag implementation details because they were known, and cites the Petition’s arguments regarding hypothetical HTML tags. Reply, 23. Although HTML <a href> tags were known, as noted above, they are incompatible with Rothschild’s interactive ads: “Rothschild makes it impossible for an existing interactive ad to be ... inserted into the body of an HTML email.” EX2009, ¶115. That is, the reason Rothschild does not mention HTML tag implementation details is because Rothschild does not (and cannot) use HTML tags for email.

Petitioner also makes a new argument: if the ad is attached, it would be obvious to “embed the URL into the advertisement using HTML.” Reply, 24. First, the Board should disregard this argument because it is presented for the first time in Petitioner’s Reply. TPG, 74. Second, Petitioner does not assert that its new argument relates to “generating” the hot link as claimed—nor that the embedded URL is generated in response to a trigger. Instead, Petitioner asserts that a message with an attached ad containing HTML tags qualifies as a “hot link message” comprising “instructions for rendering and displaying the hot link” and “assignment information”—presumably as recited in limitations 1.4 (and 10.7), 6.2 (and 11), and 18.1, 18.2, and 18.3. Reply, 23-24.

As Dr. Malek explained and Petitioner never rebuts, “Petitioner cites nothing in Rothschild regarding data in an email that assigns an ad to an icon.” EX2009,

¶114. That includes Rothschild’s Figure 3. Dr. Malek already considered the possibility of HTML tags within ads: “Even if the interactive ad has HTML tags, any such tags already exist in the interactive ad before the user selects it.” EX2009, ¶106. Any HTML tag in an attached ad is not instructions in an email for displaying that ad in the email, and does not assign the icon to the URL. Instead, as Dr. Malek explained, the email client determines what icon to display based on the attached file’s file type (e.g., .jpg or unknown).

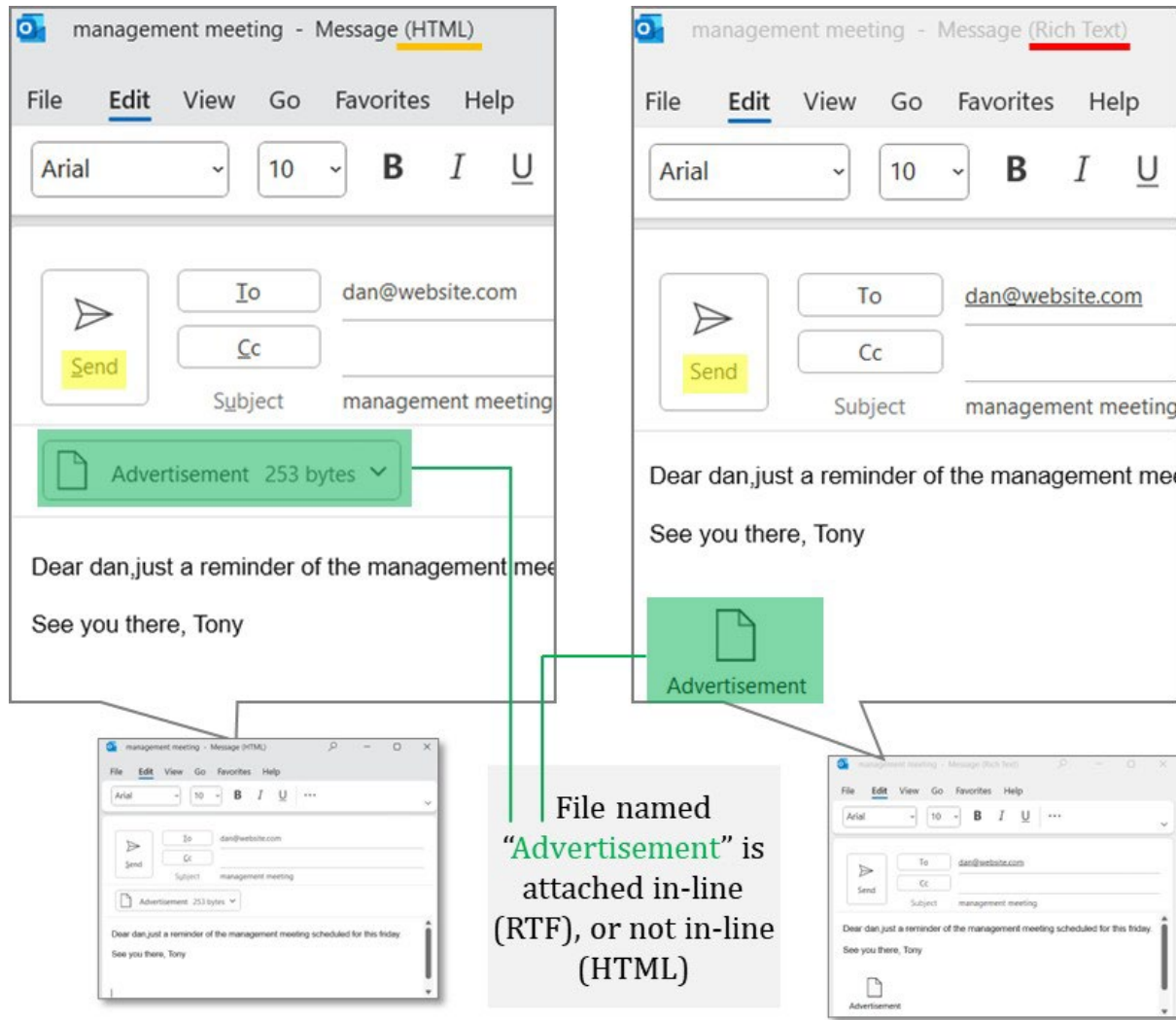
In Figure 3, the interactive ad is an attached file with a Microsoft Windows icon that denotes that the file is of an unknown file type.



EX2009, ¶88 (citing EX2020, 105 (Windows file type icons)); *see also* EX2020, 105 (same page that is shown above) (“There are also *other types* of graphic files that use *different* extensions and *icons*.”) (“Since *Windows assigns pictures* to help

you distinguish between the *different types of files*”). The displayed icon for a file type does not change based on any HTML tag or other content inside of the attached file. Instead, every file of “Unknown file type” is shown as “Unknown file type.” For example, the attached advertisement is shown in Figure 3 with the “Unknown File Type” icon, even though it is an interactive ad and therefore contains a URL. EX2009, ¶¶88-90.

Further, the email client determines—regardless of any HTML tag within attachments—that it will display attachments in-line if the email is in RTF format, but only outside of the body if the email is in HTML format.



EX2009, ¶83; *see also* EX2009, ¶82 (quoting EX2019, 2 (“*Attachments* in an RTF message *appear as icons* within the message body.”))).

Email clients do not determine whether HTML tags are inside files, let alone parse HTML tags to determine what graphics to display for attachments. Further, any HTML tags inside the file would point to particular graphics to display (e.g., “graphic.jpg”), not an operating system icon that email clients choose, and certainly not the “Unknown File Type” icon. EX2009, ¶50 (citing Pet., 33 (“<a

href ... graphic.jpg’’)). Instead, instructions for displaying the attachment icon are in the operating system or email client’s software, not in any particular email or attachment.

Petitioner’s new argument fails to address any of these points. Further, Petitioner is not permitted to make a new argument at this stage. TPG, 74. To be clear, this argument is new. Petitioner admits URLs in ads are pre-existing, but before Dr. Malek explained why, Petitioner mistakenly believe the opposite. *See* Section II.A.1. The Petition’s sole argument about ads’ URLs relies on hypothetical HTML tags that Petitioner incorrectly thought could be inserted into Rothschild’s message bodies. EX2009, ¶¶75-102. Petitioner asserts it “provided an alternate interpretation” of “instructions” for displaying a hot link, citing the Petition’s assertion that JPEG file data informs receiving devices how to display graphics. Reply, 23 (citing Pet., 34). The Petition never presents that as an alternative, but rather, as detail regarding HTML tags specifying URLs and graphics to be displayed, e.g., “graphic.jpg.” EX2009, ¶50; Pet., 33. The Petition never refers to creating ad URLs or graphics before the message creation process, so makes no argument regarding creating pre-existing ads. *See* Section II.A.1.

4. In Rothschild, the action to be performed is already embedded in the ad—not determined—when the user selects it (limitations 1.2, 10.5).

a. The ad already exists before the user selects it.

Petitioner admits ads already exist with URLs before users select them. *See* Section II.A.1.b. “Inserting the ad into a message does not involve identifying a URL or embedding any URL into an ad. Even if the interactive ad has HTML tags, any such tags already exist in the interactive ad before the user selects it.” EX2009, ¶106. Petitioner never rebuts Dr. Malek’s analysis. Reply, 2-11.

b. Inserting an ad into a message does not determine the action that will be performed when interacting with the ad.

Limitations 1.2 and 10.5 require determining an action to be performed upon activation of the “hot link”—as opposed to the hot link *message*. EX1001, 10:14-15, 19:22-24. Petitioner asserts ads are hot links. Pet., 26; Reply, 3-4. Therefore, relevant action occurs upon activation of the ad, specifically the URL in that ad. The Petition and Dr. Houh asserted servers determine “the action to be performed” by selecting URLs to be inserted into ads in response to receiving users’ ad selections. EX2009, ¶104 (citing EX2011, 62:19-21 (“[T]he interactive advertisement includes an embedded URL, and it’s the URL which defines the determined action.”)); *see also* Pet., 29-30 (“[V]arious characteristics of the URL define ‘the action to be performed’ [T]he nature of the URL itself defines ‘an action to be performed’ as claimed.”).

Petitioner and Dr. Houh misunderstood Rothschild. EX2009, ¶¶53-54, 73, 103-104. Dr. Malek explained—and Petitioner now admits—URLs are already in pre-existing ads before user selection. *See* Section II.A.1. Thus, the “action to be performed” is not determined by servers, because URLs are already embedded before user selection.

In light of Petitioner’s admission, Petitioner now asserts servers determine actions by determining what ad to insert into messages based on user selection. Reply, 9-11. By the terms of Petitioner’s own argument, users—not servers—determines ads. *Id.*; EX2009, ¶¶111-112. Further, Dr. Malek explained determining ads does not determine the action to be performed upon interaction with ads. Instead, as Petitioner and Dr. Houh admitted, the action is fetching information from addresses ads’ URLs. EX2009, ¶¶103-104. Specifically, Dr. Malek explained:

At most, determining what ad to insert relates to determining an action that will be available when interacting with the hot link message, because the inserted ad is a first interactive ad rather than a second interactive ad. The claims require ‘determin[ing] an action to be performed upon activation of the hot link’—not the hot link message.

EX2009, ¶110. Put another way, the action (the URL in the ad) is pre-determined when the ad is created. The server never determines that action (URL)—let alone in response to detecting the trigger.

Petitioner never rebuts Dr. Malek’s analysis. Petitioner asserts it relies on activation of links, not messages. Reply, 11. Petitioner initially relied on activating links, as explained in the first paragraph of this section. But the activation of the link launches the URL that is already in the ad before the user selects it, and Petitioner admits that the server does not determine the pre-existing URL because the server does not create or edit the URL in a pre-existing interactive ad, so Petitioner no longer relies on activating the hot link. *See* Section II.A.1; Reply, 9-12. Therefore, Petitioner’s current argument relies on activation of messages, not activation of links. Petitioner points to ad selection—that is, selecting a given ad “A” with an URL, as opposed to another ad “B” with another URL. Reply, 11. If the server includes ad “A” in a message, the URL in ad “A” will always have its same pre-existing first URL. If instead the server includes a different ad “B,” that different ad “B” will always have its own pre-existing different URL. The server never determines which URL is in an ad “A” or “B”, and therefore, never determines what action will be performed when interacting with ads. EX2009, ¶¶109-110.

Petitioner never directly addresses Dr. Malek’s testimony, instead offering vague statements. Petitioner asserts although URLs “help[] define” actions, “this is not to say that embedding the URL is what determines the action to be performed.” Reply, 10. Petitioner never resolves that paradox. Regardless, Petitioner and Dr.

Houh stated the URL is indeed the action to be performed. EX2009, ¶104.

Petitioner quotes and never disputes Patent Owner’s statement that the URL is determined before—not in response to—selecting an ad, but asserts that inserting the ad determines what action will be performed when engaging with “it.” Reply, 11. The use of “it” is vague. The action that will be performed when engaging with the ad (“hot link”) is: the pre-existing URL in the ad will be launched. That is Petitioner’s original and now abandoned theory. The action that will be performed when engaging with the hot link message—as opposed to the hot link itself—is reading the message. Interacting with the message is irrelevant. The claims require interacting with the hot link—not the hot link message. EX2009, ¶¶109-110.

c. The URL and ad are determined before—not in response to—detection of the trigger.

Petitioner admits URLs are determined before—not in response to—detection of triggers. *See* Section II.A.1. Petitioner asserts incorrectly that the original Petition “does not rely on the act of embedding the URL into the advertisement,” but that is exactly what it relied on: HTML tags creating ads with URLs. *See* Section II.A.1. Petitioner now relies solely on inserting ads into messages for the claimed “determine the action.” Reply, 9. Choosing the ad for a message determines what action will be performed when interacting with that message—not the ad—and the user—not the server—determines the ad. *See* Section II.A.4.b.

Moreover, Dr. Houh admitted Petitioner’s argument fails. Petitioner asserts servers detect triggers when receiving selections from menu 404. Reply, 8. Dr. Houh admitted Rothschild does not disclose servers receiving selections from menu 404. Instead, servers receive email that “is fully composed and already includes the hot link.” EX2009, ¶¶52-53. Petitioner cites—but never addresses—Dr. Houh’s admission. Reply, 6 (citing POR, 15). Therefore, even under Petitioner’s new argument that “generate” merely requires “inserting” rather than creating, *see* Section II.A.1.b, servers do not detect triggers to insert ads, nor insert ads in response to detecting triggers. Instead, ads are already inserted. *See* Section II.A.1.a.

B. Independent Claim 18 is not rendered obvious by Petitioner’s asserted combination.²

1. Petitioner’s proposed HTML tag is incompatible with Rothschild’s interactive ads.

Petitioner never rebuts Dr. Malek explanation why the Petition fails to render obvious claim 18. Petitioner asserts that Rothschild can be combined generally with HTML—without specifying anything else. *See* Section II.A.3.

² Although Petitioner addresses Rothschild in the arguments below, the arguments apply equally to Petitioner’s alternative grounds relying on the combination of Rothschild and Chen (Grounds 4-6).

Petitioner never disputes that (1) its “sole argument regarding assignment information is that a URL could be assigned to an image using HTML tags” and (2) Petitioner’s hypothetical HTML tags are incompatible with Rothschild’s interactive ads. EX2009, ¶¶113-115; POR, 54-55.

a. Rothschild does not disclose using HTML tags in an email.

Petitioner never disputes that Rothschild does not disclose using HTML in an email nor assigning ads to icons. EX2009, ¶114. Petitioner now asserts even if ads are attached, if attached ads contain HTML tags they show assignment. Reply 24. Operating system or email client code assigns icons to attached ads based on file type, so the message does not comprise data that (1) assigns ads (hot links) to icons or (2) provides instructions for displaying ads (hot links) in email. *See* Section II.A.3.c.

b. Petitioner’s proposal would create a redundant second URL in an interactive ad that already has a URL and does not have an HTML tag.

Petitioner never rebuts Dr. Malek’s explanation Rothschild combined with HTML yields ad that are attachment to email because (1) a POSITA would not use HTML tags to create a redundant second URL, and (2) “Rothschild makes it impossible for an existing interactive ad to be ... inserted into the body of an HTML email.” EX2009, ¶¶115-16.

- c. Attaching ads to messages is the only method Rothschild discloses for including ads, and is incompatible with Petitioner's HTML tag.**

Petitioner never rebuts Dr. Malek's explanation that the only method Rothschild discloses for including ads requires attaching them and is incompatible with Petitioner's hypothetical HTML tags. EX2009, ¶¶117-19.

- d. Petitioner's hypothetical HTML tag requires a step that Rothschild does not disclose.**

Petitioner never rebuts Dr. Malek's explanation that (1) Petitioner's hypothetical HTML tags require a step that Dr. Houh mistakenly believed is disclosed but is not and (2) it impossible to insert Rothschild's ads into an HTML email body. EX2009, ¶¶115-23.

- e. HTML tags must be put into the body of an HTML message, but Rothschild does not disclose composing email in HTML or editing the content of the body after formatting into email format.**

Petitioner never rebuts Dr. Malek's explanation that HTML tags must be put into the body of an HTML message, but Rothschild makes that impossible. EX2009, ¶¶115-26.

C. Dependent Claims

- 1. Petitioner fails to show generating a hot link during message creation (limitations 2.2, 6.1, 11.1).**

Petitioner never rebuts Dr. Malek's statement that "Petitioner's sole theory for claims 6 and 11 require inserting HTML tags into the body of the email, which

is incompatible with Rothschild’s interactive ads.” EX2009, ¶129. *See* Sections II.A-B. Petitioner asserts that for reasons “explained above”—without any citation—formatting “generates” ads (“hot links”). Reply, 12-13. Petitioner never rebuts Dr. Malek’s explanation why Petitioner’s original arguments are wrong, so Petitioner presumably refers to its new argument that “generating” merely requires inserting rather than creating. *See* Section II.A.1.b. Formatting does not insert ads, however, because ads are already included in email before servers format email. *See* Section II.A.1.a.

For the “identify a user element” limitation of claims 6 and 11, Petitioner asserts elements would need to be identified before generating hot links. Reply, 24-25. Petitioner never addresses the impact of its Reply’s admissions. The Petition relied on creating interactive ads during message formatting. *See* Section II.A.1. Petitioner now admits ads are created before formatting. *Id.* Petition never points to anything that identifies user interface elements before ads are created. Petitioner fails to render obvious claims 6 and 11.

2. In Rothschild, the sender, not the server, determines the e-mail address (location) of the devices (limitations 8.1, 16.1).

Dr. Malek explained that because users input email addresses, servers do not determine those addresses. EX2009, ¶¶130-131. Petitioner never rebuts Dr. Malek’s testimony. Reply, 25. Petitioner asserts without explanation that inputting addresses is “consistent” with how the ’169 patent determines locations—but what

it cites says merely refers to “us[ing] the term”—not determining—“location.”

Reply, 25 (citing Pet., 45). Tellingly, Dr. Houh’s supplemental declaration says nothing about location. Petitioner fails to render obvious claims 8 and 16.

3. Petitioner’s arguments are limited to email and therefore do not apply to SMS or IM (limitation 15.1).

Dependent claim 15 requires SMS or IMS messages, not email. EX1001, 19:63-20:3. Petitioner’s sole allegations regarding SMS and IM are that Rothschild also discloses those formats; the Petition otherwise treated those formats the same as email. Pet., 55, 41.

Petitioner never addresses the impact of its Reply’s admissions. Dr. Malek explained that SMS messages do not use HTML tags. EX2009, ¶¶57-72. Petitioner never rebuts Dr. Malek’s explanation. Instead, Petitioner admits: “[T]he Petition does not rely on the obviousness of using HTML with SMS messages.” Reply, 17. Petitioner never reconciles its theories for independent claims versus claim 15. Therefore, Petitioner fails to renders obvious claim 15.

D. The cited art does not disclose the “controlling” limitations (claims 1, 2, 12, 18, 19, 20).

The Petition is silent about the “controlling” limitations. EX2009, ¶¶132-137. Petitioner never disputes Dr. Malek’s explanation.

Petitioner asserts “Rothschild teaches controlling transmission (or receipt, selection, submission) with the same level of specificity as recited in the claim.”

Reply, 26. That is wrong. The claims expressly require the “controlling” limitations, but Petitioner never points to anything in Rothschild that teaches those concepts, at any level of specificity. In its Reply, Petitioner refers solely to the ’169 patent and a POSITA. *Id.*

Petitioner asserts the claims do not require an operating system or BIOS to perform the controlling, and the specification discloses controlling but not how to control. That is irrelevant to the question of what Rothschild teaches.

Petitioner cites Dr. Malek’s testimony that a POSITA would have known how an operating system or BIOS could control receipt, but ignores his testimony that the mere existence of an operating system or BIOS “doesn’t mean that it has all the kinds of controls that the patent requires.” EX1024, 25:16-23. Further, Petitioner’s argument applies only to controlling receipt. Petitioner asserts without explanation that for “similar reasons, Rothschild teaches the other ‘control’ limitations.” Reply, 26. Petitioner never identifies similar reasons. Merely because a POSITA knows how to control receipt does not prove Rothschild teaches controlling receipt—let alone transmission, selection, or submission.

E. Petitioner fails to provide a reason why a POSITA would have combined Rothschild, Saltanov, and Maes (claim 20).

Petitioner provides no reason the why a POSITA would combine references to deliver feedback to advertisers—the sole alleged motivation to combine. Pet., 74-76; EX2009, ¶¶138-40. Petitioner notes not every detail is (1) required for

motivation to combine or (2) articulated in the specification. Reply, 26-27. That is true but irrelevant. The cited references do not suggest providing feedback about advertisements to anyone—let alone to advertisers. Petitioner notes Rothschild discloses advertisements, but asserts nothing about feedback. Pet., 74-75.

Petitioner states Maes discloses user preferences for products, but says nothing about advertisements. Pet., 73. Petitioner never mentions Saltanov outside of the heading, so fails to allege any reason to combine all three references. Pet., 74-76.

Dr. Houh admitted he never considered whether the combination might provide feedback to advertisers. EX2009, ¶139. Dr. Malek's unrebutted analysis establishes a POSITA would not have contemplated providing feedback to advertisers even after combining the references. EX2009, ¶139. Petitioner never points to anything in the references that provides such feedback. A POSITA would not have been motivated to combine references to achieve an objective that none mention and the combination does not yield.

III. CONCLUSION

For the foregoing reasons, Petitioner has not established that any of the challenged claims of the '169 patent are unpatentable. Patent Owner therefore respectfully requests that the Board confirm the patentability of the challenged claims over the grounds presented in the Petition.

Respectfully submitted,

/ David L. Alberti /

David L. Alberti
Registration No. 43,465
Counsel for Patent Owner

Date: January 22, 2024

577 Airport Boulevard, Suite 250
Burlingame, California 94010
(650) 825-4300

CERTIFICATE OF WORD COUNT (37 C.F.R. § 424.4(d))

1. This Patent Owner's Sur-Reply complies with the type-volume limitation of 5,600 words, comprising 5,560 words, excluding the parts exempted by 37 C.F.R. § 42.24(c).

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

Respectfully submitted,

/ David L. Alberti /

David L. Alberti
Registration No. 43,465
Counsel for Patent Owner

Date: January 22, 2024

577 Airport Boulevard, Suite 250
Burlingame, California 94010
(650) 825-4300

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S SUR-REPLY** was served electronically via e-mail on January 22, 2024, in its entirety on the following counsel of record for Petitioner:

Andrew S. Ehmke (Lead Counsel) andy.ehmke.ipr@haynesboone.com
Raghav Bajaj (Back-up Counsel) raghav.bajaj.ipr@haynesboone.com
Calmann J. Clements (Back-up Counsel) calmann.clements.ipr@haynesboone.com

HAYNES AND BOONE LLP

Respectfully submitted,

/ David L. Alberti /

David L. Alberti
Registration No. 43,465
Counsel for Patent Owner

Date: January 22, 2024

577 Airport Boulevard, Suite 250
Burlingame, California 94010
(650) 825-4300