

Google LLC
v.
Wildseed Mobile LLC

IPR2023-00247

U.S. Patent No. 10,869,169

Patent Owner's Demonstratives

March 7, 2024

Instituted Grounds

IPR2023-00247 ('169 Patent)		
Claims Challenged	Basis	Applied References
1-18, 21-22	35 U.S.C. § 103	Rothschild
19	35 U.S.C. § 103	Rothschild, Saltanov
20	35 U.S.C. § 103	Rothschild, Saltanov, Maes
1-18, 21-22	35 U.S.C. § 103	Rothschild, Chen
19	35 U.S.C. § 103	Rothschild, Saltanov, Chen
20	35 U.S.C. § 103	Rothschild, Saltanov, Maes, Chen

DI, 6

Agenda

- ▶ **The '169 Patent**
- ▶ The Applied Art does not Render Obvious the “Generating a Hot Link” Limitations (Claims 1 and 10)
- ▶ The Applied Art does not Render Obvious the “Determine the Action” Limitations (Claims 1 and 10)
- ▶ The Applied Art’s Interactive Ads are Not Compatible with HTML Messages (Claims 1, 10, 18)
- ▶ The Applied Art does not Render Obvious the Dependent Claims (Claims 2, 6, 8, 11, 15, 16)
- ▶ The Applied Art does not Render Obvious the “Controlling” Limitations (Claims 1, 2, 12, 18, 19, 20)
- ▶ No motivation to Combine Rothschild, Saltanov, and Maes (Claim 20)

The '169 Patent

(12) **United States Patent**
Engstrom et al.

(10) **Patent No.:** US 10,869,169 B2
(45) **Date of Patent:** *Dec. 15, 2020

(54) **METHOD AND SYSTEMS FOR
GENERATING AND SENDING A HOT LINK
ASSOCIATED WITH A USER INTERFACE
TO A DEVICE**

(58) **Field of Classification Search**
None
See application file for complete search history.

(71) Applicant: **Varia Holdings LLC**, Brooklyn, NY
(US)

(56) **References Cited**

U.S. PATENT DOCUMENTS

(72) Inventors: **G. Eric Engstrom**, Kirkland, WA (US);
Peter Zatloukal, Duvall, WA (US);
Tyrol Graham, Seattle, WA (US)

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(Continued)

(73) Assignee: **Varia Holdings LLC**, Brooklyn, NY
(US)

FOREIGN PATENT DOCUMENTS

(*) Notice. Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

This patent is subject to a terminal disclaimer.

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WO	02093408	11/2002

(Continued)

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International Search Report for Application No. PCT/US02/14594,
dated Jul. 15, 2002.

(21) Appl. No.: 15/839,396

(Continued)

(22) Filed: **Dec. 12, 2017**

Primary Examiner — Mohamed Ibrahim

(65) **Prior Publication Data**
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(74) *Attorney, Agent, or Firm* — Schwabe, Williamson & Wyatt, P.C.

Related U.S. Application Data

(63) Continuation of application No. 14/158,708, filed on Jan. 17, 2014, now Pat. No. 9,843,907, which is a
(Continued)

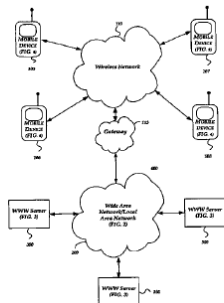
(57) **ABSTRACT**

Systems, methods, and computer-readable media for sending hotlinks to a device are provided. The device may be on a wireless network, a wired network, or directly coupled to the device sending the hot link. The hot link contains an associated action that is performed by the device receiving the hot link. The associated action may be performed when a user interface is activated or automatically when the hot link is received by the device. The action can be a broadcast action, Internet action, call action, download action, or upload action. The broadcast action instructs the device to tune to a particular broadcast in response to the selection of the user interface. The internet action instructs the device to access an Internet site in response to the selection of the user

(Continued)

(51) **Int. Cl.**
G06F 15/177 (2006.01)
H04W 4/12 (2009.01)
(Continued)

(52) U.S. Cl.
CPC *H04W 4/12* (2013.01); *G06Q 30/02*
(2013.01); *G07C 13/00* (2013.01); *H03J*
1/0058 (2013.01);
(Continued)



Systems, methods, and computer-readable media for **send-
ing hotlinks** to a device are provided. The device may be on a wireless network, a wired network, or directly coupled to the device sending the hot link. The **hot link contains an associated action that is performed** by the device receiving the hot link. The associated action may be performed when a user interface is activated or automatically when the hot link is received by the device. The action can be a broadcast action, Internet action, call action, download action, or upload action. The broadcast action instructs the device to tune to a particular broadcast in response to the selection of the user interface. The internet action instructs the device to access an Internet site in response to the selection of the user

(Continued)

EX1001, 1

'169 Patent Exemplary Claim

1. One or more non-transitory computer-readable media (NTRM) including program code, wherein execution of the program code by one or more processors of a computer system is to cause the computer system to:

- identify a trigger to generate a hot link; and
- in response to detection of the trigger, determine an action to be performed upon activation of the hot link based on the trigger, wherein activation of the hot link by individual user devices of a set of user devices is to cause the individual user devices to execute program code to perform the action;
- generate a hot link message to include the determined action and instructions for rendering and displaying the hot link at each of the set of user devices; and
- control transmission of the hot link message to the set of user devices.

EX1001, Claim 1

Agenda

- ▶ The '169 Patent
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- ▶ The Applied Art does not Render Obvious the “Determine the Action” Limitations (Claims 1 and 10)
- ▶ The Applied Art’s Interactive Ads are Not Compatible with HTML Messages (Claims 1, 10, 18)
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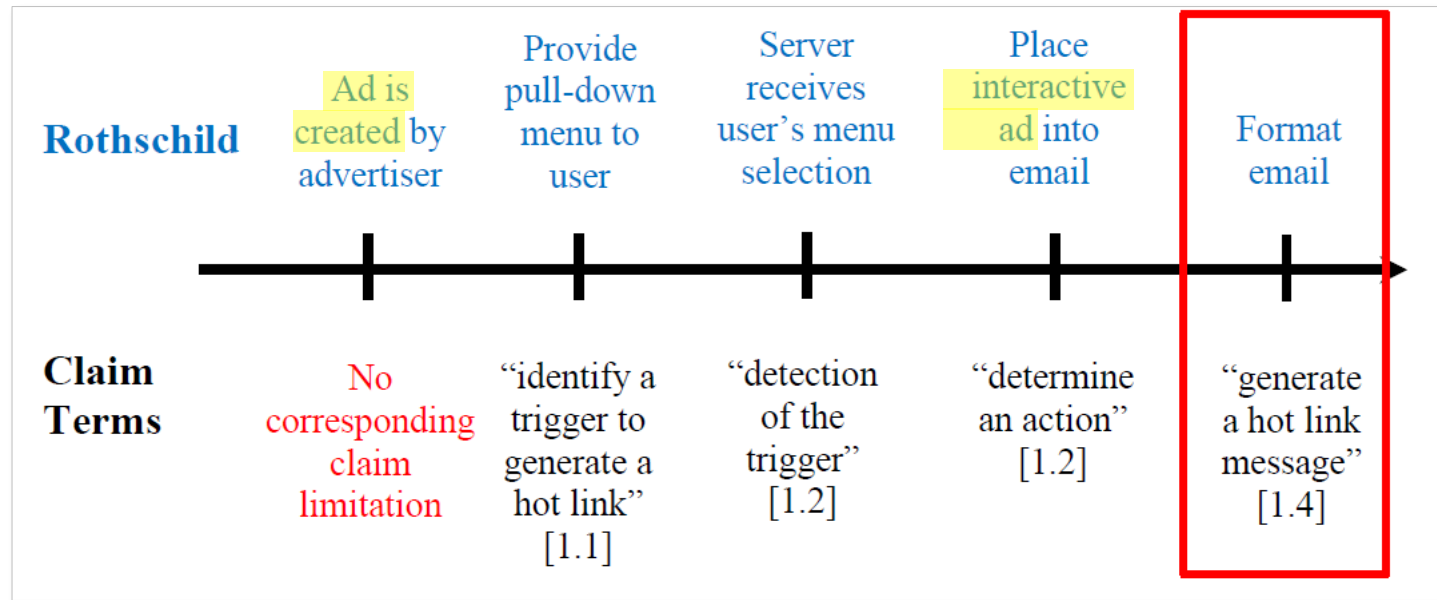
Now undisputed: interactive ads are pre-existing

Petitioner misunderstood its main reference.

Petitioner now admits that:

- the interactive “[a]d is created by advertiser” before the user selects it, and
- that same pre-existing “interactive ad” is later placed into an email.

Petitioner's Reply



Reply at 13

Undisputed: Petition theory: interactive ad = claimed “hot link”

Patent Owner's Dr. Malek

47. Petitioner asserts that Rothschild's interactive advertisement is a “hot link.” Pet., 26 (“generating an *interactive advertisement* (*‘hot link’*)”), 27 (“Rothschild's *interactive advertisement* teaches a *‘hot link’* as claimed”); EX2011, 59:21-60:4 (“Q ... the *interactive advertisement* is the *hotlink* and the hotlink includes the embedded URL. Am I getting that correct? A. *Yeah.*”). Petitioner

EX2009, ¶ 47

Petitioner's Reply

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

Reply at 1

No generating a hot link: Interactive ads are created before—not during—message formatting

The Petition relied on creating interactive ads. Specifically, Petitioner asserted that the ad became interactive by adding HTML tags during message formatting. Petitioner does not dispute that the Petition's theory is wrong. Petitioner now asserts incorrectly that the Petition relied on inserting pre-existing interactive ads.

Patent Owner's Dr. Malek

47. Petitioner asserts that Rothschild's interactive advertisement is a "hot link." Pet., 26 ("generating an *interactive advertisement* ('*hot link*')"), 27 ("Rothschild's interactive advertisement teaches a '*hot link*' as claimed"); EX2011, 59:21-60:4 ("Q ... the *interactive advertisement* is the *hotlink* and the hotlink includes the embedded URL. Am I getting that correct? A. *Yeah*."). Petitioner asserts that the sender receiving, or selecting an ad from, the pull down menu during the message-creation process qualifies as the claimed trigger or request to "generate a hot link." Pet., 26-29. Thus, Petitioner asserts that Rothschild generates an interactive advertisement during the message-creation process.

51. In sum, Petitioner asserts that when Rothschild formats an email message, it generates an interactive ad, and it could do so by using HTML tags. Pet., 32-34, 42, 46. But Rothschild's disclosure contradicts Petitioner's assertion, as the following sections demonstrate.

Petitioner's Reply

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

Reply at 2

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

Reply at 14

Petitioner's expert admits formatting does not generate hot links; formatting does not affect ads or make ads interactive

Patent Owner's Dr. Malek

97. Petitioner places great emphasis on Rothschild's statement that the formatting step refers to both the message and the selected interactive ad. Pet., 23 (“the message data (which includes the selected advertisement) is formatted into a standard e-mail format.”, citing EX1005, 11:28-30). **Formatting the email does not format the selected ad. There is no “email format” for an attachment. Instead, the email simply attaches whatever existing file is to be attached. Thus, formatting the message data does not disclose generating an interactive ad. The reason**

122. **Dr. Houh also admitted that** when the “send” button is pushed, the **message already has the actual selected ad.** EX2011, 179:4-180:12 (“... server to *retrieve the ad to send back to the client to insert the ad, ... the whole message that is ready to send in ready—to—send format*”). Therefore, **any interactive ad would be part of the message**—but not in HTML format within message box 410, which only accepts plain text—**when the user hits “send.”**

EX2009, ¶¶ 97, 122

Petitioner's Reply

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.

Reply at 12

The Petition relied on creating interactive ads to generate a hot link.

Petitioner now asserts incorrectly that the claims do not require “generating the hot link.”

Petitioner repeats its formatting theory without addressing its own expert's admission that Petitioner is wrong.

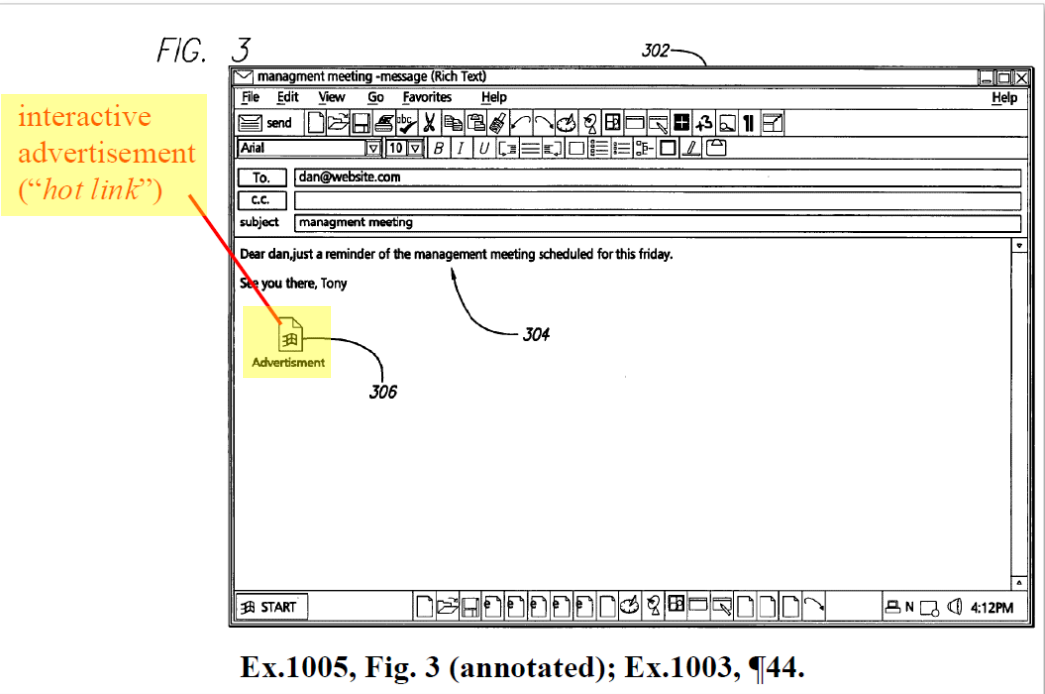
Petitioner's impermissible new argument: insert pre-existing interactive ad, rather than create interactive ad

Patent Owner's Dr. Malek

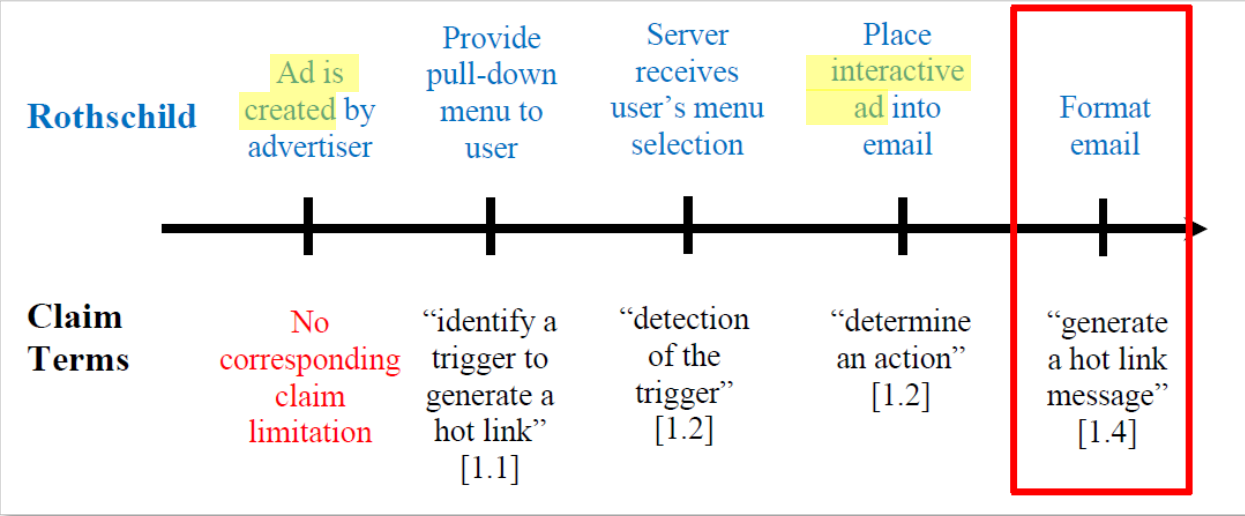
51. In sum, Petitioner asserts that when Rothschild formats an email message, it generates an interactive ad, and it could do so by using HTML tags. Pet., 32-34, 42, 46. But Rothschild's disclosure contradicts Petitioner's assertion, as the following sections demonstrate.

EX2009, ¶ 51

Petition



Petitioner's reply



Reply at 13

Petitioner's impermissible new argument is wrong: inserting is not “generating”

Patent Owner's Dr. Malek

it contains the *interactive advertisement* that's selected.”). 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. Instead, the inserted ad already existed. Petitioner's discussion of limitation 10.2's requirement to “generate a hot

EX2009, ¶ 48

Petitioner ignores Dr. Malek's answers to Petitioner's questions explaining that inserting is not "generating" and citing specification

Patent Owner's Dr. Malek

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. Let me -- let me look for that.

Now, I'm finding a lot of places where the word "generate" is used, and it's always used in the context of what I pretty much, I think, described.

So, for example, on column 17, line 29, it says, "If special characters or strings are used to

Petitioner's Reply

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.

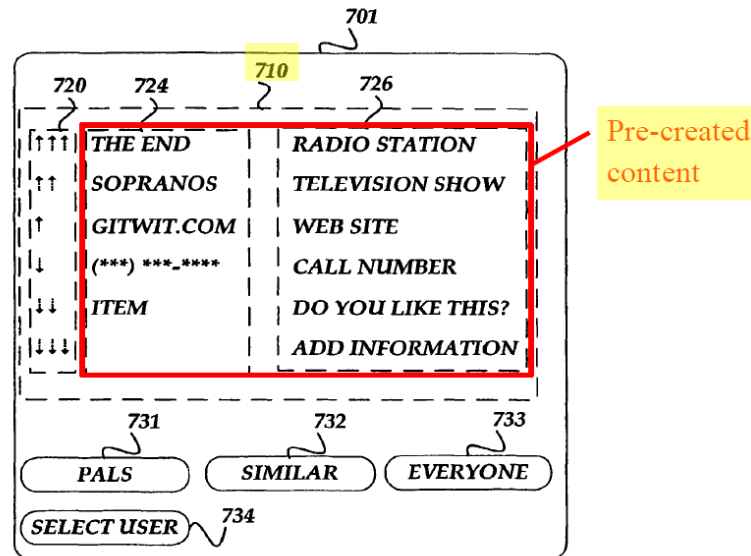
But the Petition does not construe the term "generate" to mean the initial creation of the advertisement content. Nothing in the specification of the '169 patent supports such an interpretation of the word "generate." Indeed, the

Reply at 13-14

Content—not links—exist before message in '169 specification; hot links are “to be” created using pre-existing content

Petitioner's Reply

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)

'169 Patent

Hot link items 710 contain a set of actions that may be used to generate a hot link. Display 701 may contain titles in many different ways. For example, the opinion data may be used to help select the action to be associated with the hot link. For example, when the action item has been given a

EX1001, 12:15-16, 12:28-30

“Generating” requires “creating”: hot link message is not pre-created

Petition

[1.4] *generate a hot link message to include the determined action and instructions for rendering and displaying the hot link at each of the set of user devices; and*

First, Rothschild’s server *generates a hot link message* when the web server *formats the message data into an e-mail* that contains the selected interactive advertisement. “At step 516 the message data (which includes the selected advertisement) is formatted into a standard e-mail format. The formatted e-mail’s reply-to address is changed, at step 518, to reflect the senders e-mail address that was provided by the sender upon registration.” Ex.1005, 10:65-11:33. Accordingly, *by formatting the message data into an e-mail message* containing the interactive advertisement, the web server “*generates a hot link message*” as claimed.

Petition's sole purpose for adding HTML to 103 combination is to create ("generate") hot links

The Petition relied on creating interactive ads by adding HTML tags during message formatting.

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.

Petition

A POSITA would have understood that an HTML implementation of an embedded URL in an interactive advertisement displayed as a graphic, text, GIF, or other form described by Rothschild would include HTML tags ("instructions") that define how the embedded URL is displayed within the interactive advertisement. An example HTML code is shown below:

```
<a href="URL">  
  
</a>
```

See Ex.1010, 35; Ex.1011, 179; Ex.1003, ¶59.

Pet. at 33

D. Ground 4: Claims 1-18 and 21-22 are obvious under 35 U.S.C. § 103 over Rothschild and Chen

Ground 1 presents Rothschild as rendering obvious "instructions for rendering and displaying the hot link," citing to Chen as evidence that it would be obvious for Rothschild's e-mail service to be implemented using HTML, and in so doing, the HTML code would provide such instructions for rendering and displaying a hot link. To the extent Patent Owner argues that Chen does not represent the background knowledge of a POSITA, Ground 4 (along with grounds 5 and 6 for claims 19 and 20 respectively) provides reasons why a POSITA would have found it obvious to implement Rothschild's interactive advertisements using HTML, as evidenced by Chen. Ex.1003, ¶185.

Even if “insert” qualifies as “generate”: cannot insert Rothschild’s interactive ads into HTML messages

Patent Owner’s Dr. Malek

EX2025.). Therefore, because the SMS message can attach any of the interactive ads that are stored in the ad palette, and any ad it selects to attach to an SMS message does not have an <a href> tag, none of the interactive ads stored in the ad palette have an <a href> tag. Therefore, Rothschild makes it impossible for an existing interactive ad to be taken from the user’s ad palette and simply be inserted into the body of an HTML email. The ad could be attached to a message, but not inserted into HTML.

EX2009, ¶ 115

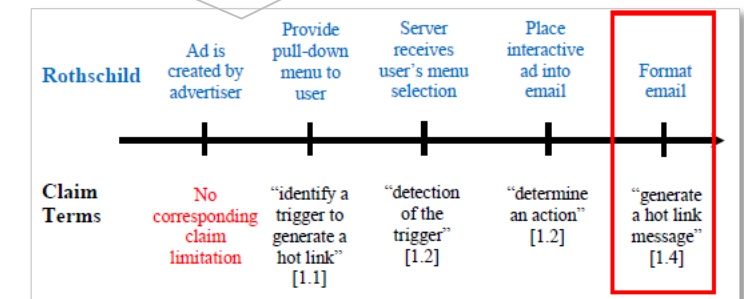
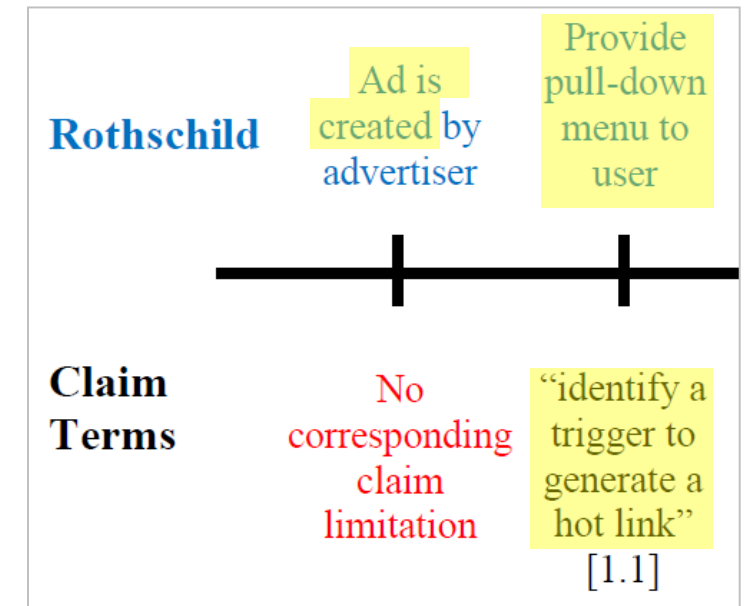
Petitioner’s Reply: No rebuttal

See Reply at 15-24

“Trigger” to generate hot link: theories require pull-down menu, but pull-down menu shows only pre-created ads

Petitioner's Reply

Claim Term	Rothschild's Teachings
“ <u>identify a trigger</u> to generate a hot link”	“Rothschild describes a ‘trigger’ for generating an interactive advertisement (‘hot link’) in the form of a <u>pull-down menu</u> for selecting an interactive advertisement.” Petition, 26.
“ <u>identify a trigger</u> to generate a hot link”	“Rothschild’s server <i>identifies</i> the ‘trigger’ when it provides the sending user’s device with the e-mail communication page 402 that contains the <u>pull-down menu</u> .” Petition, 27.
“ <u>identify a trigger</u> to <u>generate</u> a hot link”	Rothschild’s <u>pull-down menu</u> is a trigger to “generate a hot link” because “[s]election of an <u>advertisement from the pull-down menu</u> ultimately triggers insertion of the advertisement into an e-mail message.” Petition, 26.



Reply at 13

Reply at 3-4

Patent Owner's Demonstrative Exhibit – Not Evidence

Petitioner's identified triggers do not generate (create) the pre-created ads in pull-down menu

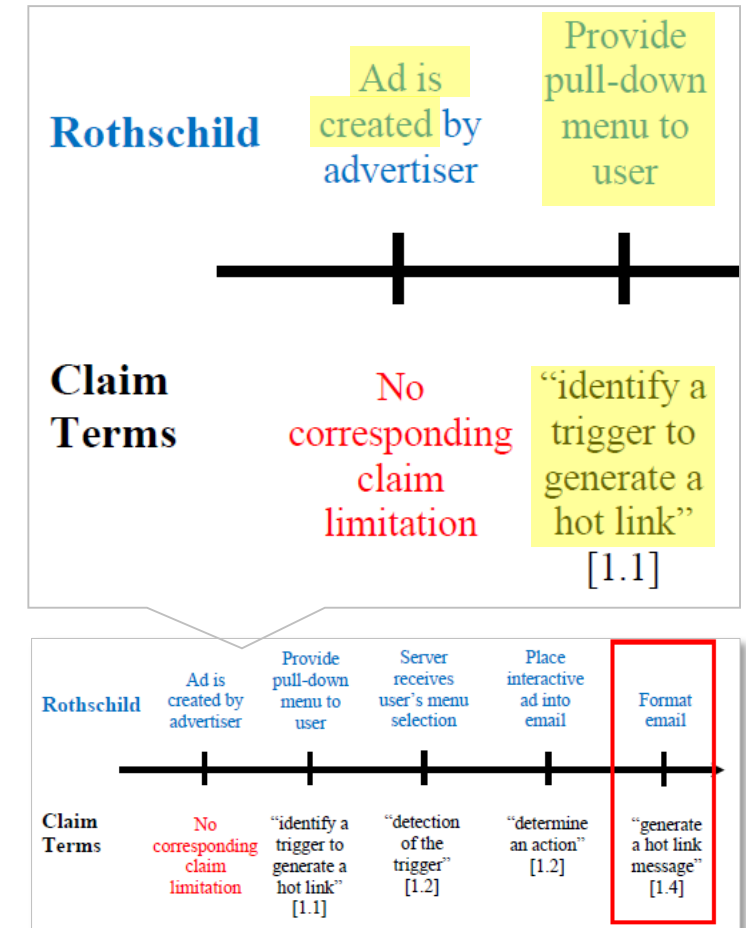
Rothschild's interactive ads exist before pull-down menu shows them—and before servers receive selections from that menu. Thus, Petitioner's identified triggers do not generate (create) those ads.

Patent Owner's Dr. Malek

74. When the server identifies interactive ads to include in the pull down menu, those ads have already been generated and are available for attaching to SMS messages. Identifying the menu, or the ads that are shown in the menu, or the user's selection of an ad from the menu, is not a trigger to generate an interactive ad, but rather a way to select a pre-existing ad. Rothschild 9:32-50 (*Once the*

EX2009, ¶ 74

Petitioner's Reply



Reply at 13

Petitioner's identified triggers do not generate (insert) the pre-created ads from the pull-down menu into messages

Even considering Petitioner's new theory that "generate" merely requires "inserting", Petitioner's second theory fails: servers do not receive pull-down menu selections, and therefore do not identify triggers to insert ads.

Instead, as Dr. Houh admitted, ads are already inserted in emails. Petitioner's Reply does not address Dr. Houh's admission and simply repeats the Petition.

Thus, Petitioner's identified triggers do not generate (insert) those ads.

Patent Owner's Dr. Malek

73. Petitioner's second theory is that the trigger is identified when a server receives a user's selection of an ad from the pull down menu. Pet., 27. This theory is based on Dr. Houh's misunderstanding of Rothschild. He supposed that after the user selects an ad, the server fetches the ad and returns it to the sender to populate the message, before the user presses the "send" button.

...

EX2011, 68:1-16; 179:4-180:12; Pet., 27. Dr. Houh could not identify anything in Rothschild that supported his theory regarding sending the user's selected ad before pressing the "send" button.

Petitioner's Reply

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

Reply at 8-9

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Undisputed: URL = action to be performed

Petitioner's Reply

<i>“determine an <u>action to be performed</u> upon activation of the hot link”</i>	The action is the “retrieval of additional information.” “Thus, the nature of the <u>URL</u> itself defines ‘<i>an action to be performed</i>’ as claimed.” Petition, 30.
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Reply at 10

Petitioner's theory is wrong; now undisputed: URL already exists before user selects ad

Patent Owner's Dr. Malek

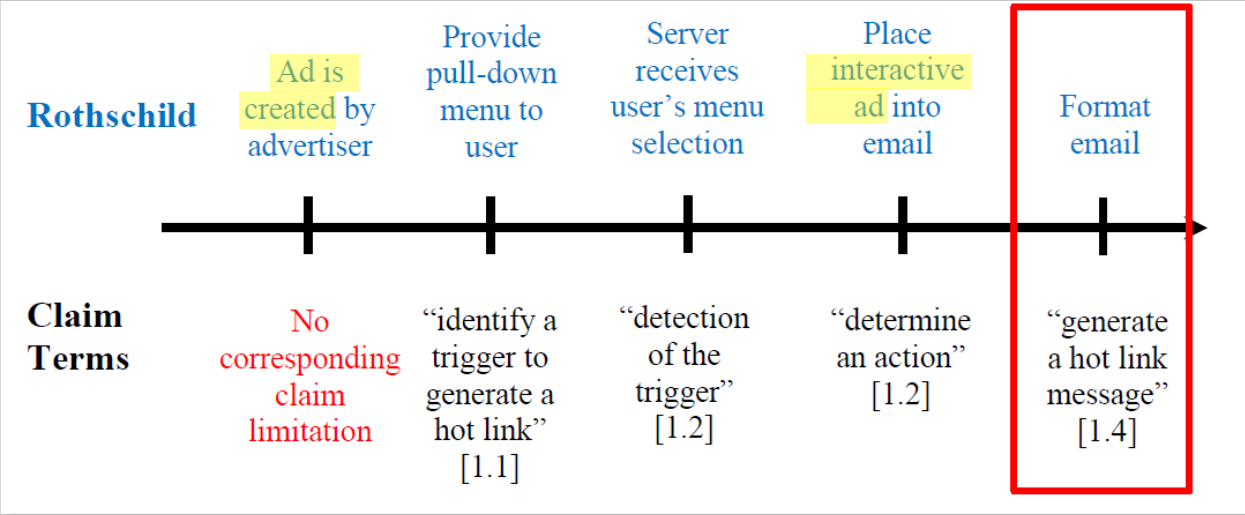
a. The interactive ad already exists with an embedded URL before the user selects it.

105. Petitioner proposes that the process of inserting an interactive ad into a message involves a server creating the interactive ad by identifying the relevant URL and embedding that URL into the ad, perhaps by using HTML tags. Pet., 32-34. Rothschild does not disclose that, and Petitioner does not assert otherwise. Pet., 32-34.

106. Before the user can select any interactive ad from the pull down menu 404, the interactive ad already exists and already has a URL embedded in it. 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, ¶¶ 105-106

Petitioner's reply



Reply at 13

Petitioner never addresses its own expert's testimony showing Petitioner's theory is wrong

Patent Owner's Dr. Malek

73. Petitioner's second theory is that the trigger is identified when a server receives a user's selection of an ad from the pull down menu. Pet., 27. This theory is based on Dr. Houh's misunderstanding of Rothschild. He supposed that after the user selects an ad, the server fetches the ad and returns it to the sender to populate the message, before the user presses the "send" button.

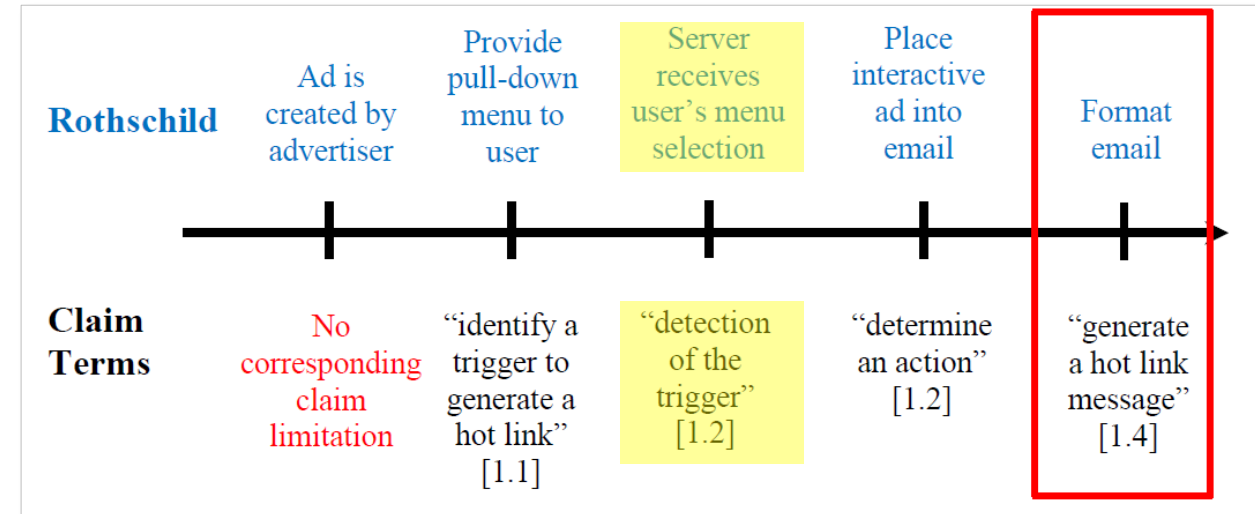
...

EX2011, 68:1-16; 179:4-180:12; Pet., 27. Dr. Houh could not identify anything in Rothschild that supported his theory regarding sending the user's selected ad before pressing the "send" button.

122. Dr. Houh also admitted that when the "send" button is pushed, the message already has the actual selected ad. EX2011, 179:4-180:12 ("... server to

EX2009, ¶¶ 73, 122

Petitioner's reply



Reply at 13

URL is determined before—not in response to—detection of trigger

Patent Owner's Dr. Malek

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

111. By the time the ad is inserted into a message, **there is nothing left to determine.** The **advertiser determines what URL** will be embedded into an ad when the advertiser uploads the ad. EX1005, 13:26-49 (“... the advertiser can ... *upload an advertisement* to the Web site 110. ... The *advertiser* should *at this time specify* whether the *advertisement* is *static or interactive*. If it is interactive, the additional communication *data provided upon interaction*, or the *location of such data*, *should be provided ...*”). Thus, the URL is already determined before the message creation process begins. The **user determines which ad** will be inserted into the message by selecting the ad from the pull down menu 404. EX1005, 9:26-52 (“The

EX2009, ¶ 111

Petitioner's Reply quotes but never rebuts

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.

Reply at 11

Petitioner's impermissible new argument is wrong: server never determines the URL (action to be performed)

Petitioner's impermissible new argument is that the server determines what ad to insert when the server receives the user's ad selection and inserts the selected ad into the message.

Even under Petitioner's new argument, the user—not the server—determines the ad.

Petitioner never addresses its own expert's testimony showing Petitioner's theory is wrong. Contrary to Petitioner's assertion, Rothschild does not disclose the server receiving the user's selection of an ad from the pull-down menu.

Patent Owner's Dr. Malek

122. Dr. Houh also admitted that when the “send” button is pushed, the message already has the actual selected ad. EX2011, 179:4-180:12 (“... server to retrieve the ad to send back to the client to insert the ad, ... the whole message that is ready to send in ready—to—send format”). Therefore, any interactive ad would be part of the message—but not in HTML format within message box 410, which only accepts plain text—when the user hits “send.”

EX2009, ¶ 122

Petitioner's Reply

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.

Reply at 11

Action upon hot link—not message —activation

Petitioner does not dispute that the claim requires determining the action to be performed upon activation of the hot link, not the hot link *message*. Indeed, Petitioner points to “activates the interactive advertisement” (hot link), and states the tautology that activation of the ad occurs upon activation of the ad.

- But Petitioner merely points to inserting a pre-existing ad with a pre-existing URL. That does not determine the URL (action to be performed).

Patent Owner’s Dr. Malek

110. Inserting the ad does not determine what action will be taken upon activation of the ad. Instead, the URL is already embedded in the ad. 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*. The selected interactive ad already has a URL embedded in it, so inserting that ad does not determine what its embedded URL is. Petitioner’s argument requires determining the URL that is embedded within a first interactive ad, not merely picking an interactive ad without determining its embedded URL.

Petitioner’s Reply

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.

Reply at 11-12

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- ▶ The Applied Art does not Render Obvious the Dependent Claims (Claims 2, 6, 8, 11, 15, 16)
- ▶ The Applied Art does not Render Obvious the “Controlling” Limitations (Claims 1, 2, 12, 18, 19, 20)
- ▶ No motivation to Combine Rothschild, Saltanov, and Maes (Claim 20)

Petitioner never rebuts Dr. Malek's explanations regarding HTML tags are incompatible with Rothschild's interactive ads

Patent Owner's Dr. Malek

D. Independent Claim 18 would not have been obvious in view of Petitioner's grounds.

- 1. Petitioner's proposed HTML `<a href>` tag is incompatible with Rothschild's interactive ads.**
 - a. Rothschild does not disclose using HTML, let alone an `<a href>` tag, in an email.**
 - b. Petitioner's proposal would create a redundant second URL in an interactive ad that already has an embedded URL and does not have an `<a href>` tag.**
 - c. Attaching ads to messages is the only method Rothschild discloses for including ads, and is incompatible with Petitioner's `<a href>` tag.**
 - d. Petitioner's hypothetical use of HTML code requires a step that Rothschild does not disclose, and that the mobile embodiment precludes: the server sending a selected interactive ad back to the sender device.**
 - e. HTML `<a href>` 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's Reply: No rebuttal

See Reply at 15-24

Petitioner never rebuts Dr. Malek's explanations regarding HTML tags are incompatible with Rothschild's interactive ads

One example of Dr. Malek's unrebutted explanations

Patent Owner's Dr. Malek

EX2025.). Therefore, because the SMS message can attach any of the interactive ads that are stored in the ad palette, and any ad it selects to attach to an SMS message does not have an <a href> tag, none of the interactive ads stored in the ad palette have an <a href> tag. Therefore, Rothschild makes it impossible for an existing interactive ad to be taken from the user's ad palette and simply be inserted into the body of an HTML email. The ad could be attached to a message, but not inserted into HTML.

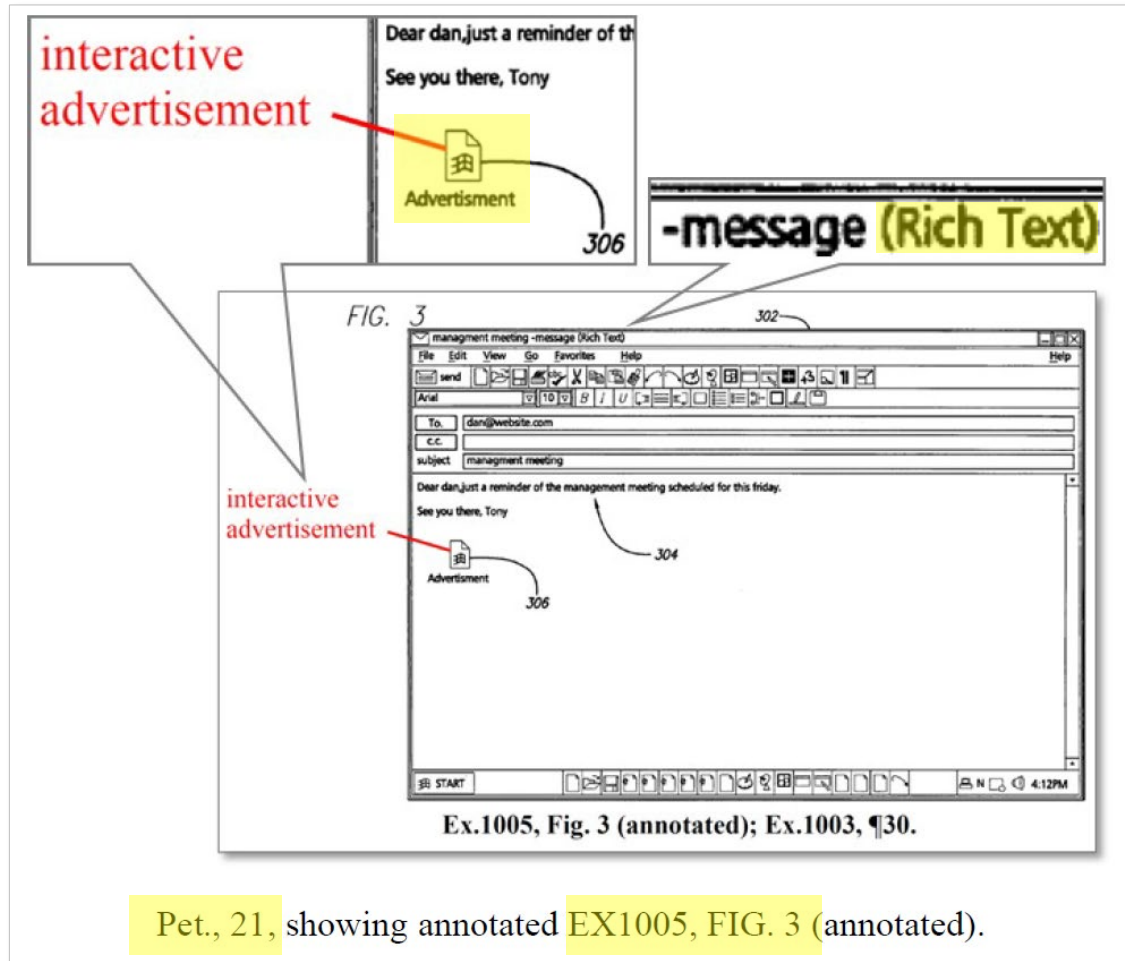
EX2009, ¶ 115

Petitioner's Reply: no rebuttal

See Reply at 15-24

Petitioner mistakenly thought Rothschild showed HTML email, now admits it is RTF with attachment; “does not rely on” it anymore

Patent Owner's Dr. Malek



Petitioner's Reply: drops Figure 3 RTF email

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.

Reply at 21

EX2009, ¶ 82

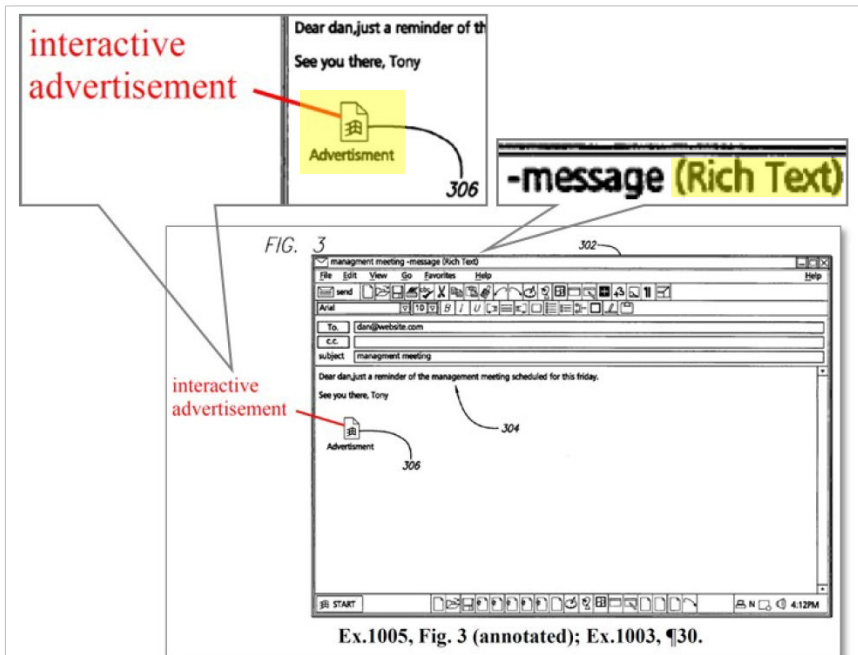
Petitioner continues to misunderstand Rothschild in Reply: mistakenly thought ads “in” RTF email are not attached

Rothschild

FIG. 3 shows an e-mail message **302** directed to a recipient. The e-mail message contains a personal message **304** and a sender-selected advertisement **306**. If 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

EX1005, 8:31-36

Patent Owner's Dr. Malek



Ex.1005, Fig. 3 (annotated); Ex.1003, ¶30.

Pet., 21, showing annotated EX1005, FIG. 3 (annotated).

Petitioner's Reply

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.

Reply at 21

EX2009, ¶ 82

Even combining HTML email with Rothschild interactive ads: HTML email would have attachments, “without” HTML tags

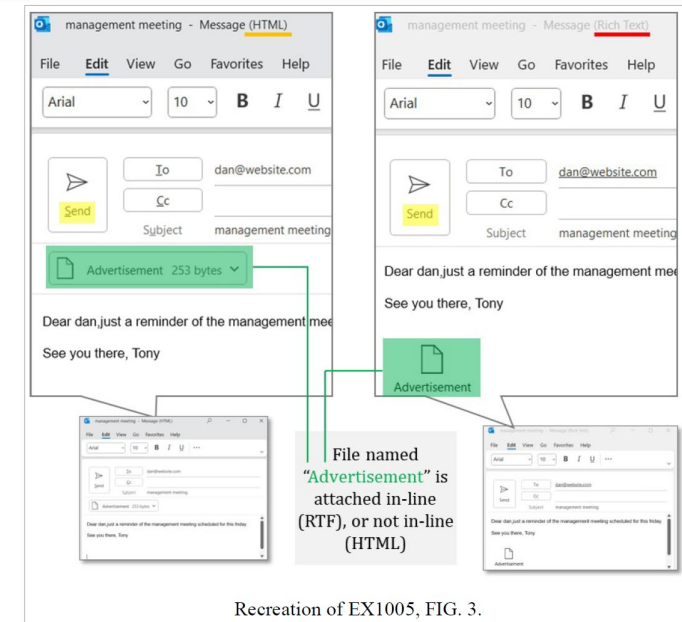
Petitioner’s Reply

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

Reply at 16

Patent Owner’s Dr. Malek

101. Petitioner’s proposed HTML tags would not create an attachment, which is the only method that Rothschild discloses for including an ad in an e-mail (see, e.g., Rothschild’s Figures 3, 5, 11). At his deposition, Dr. Houh supposed that HTML tags could be added to the message space 410. EX2011, 179:4-180:12. But message space 410 accepts only plain text, not text in HTML format, and Rothschild does not state that it is in HTML format.



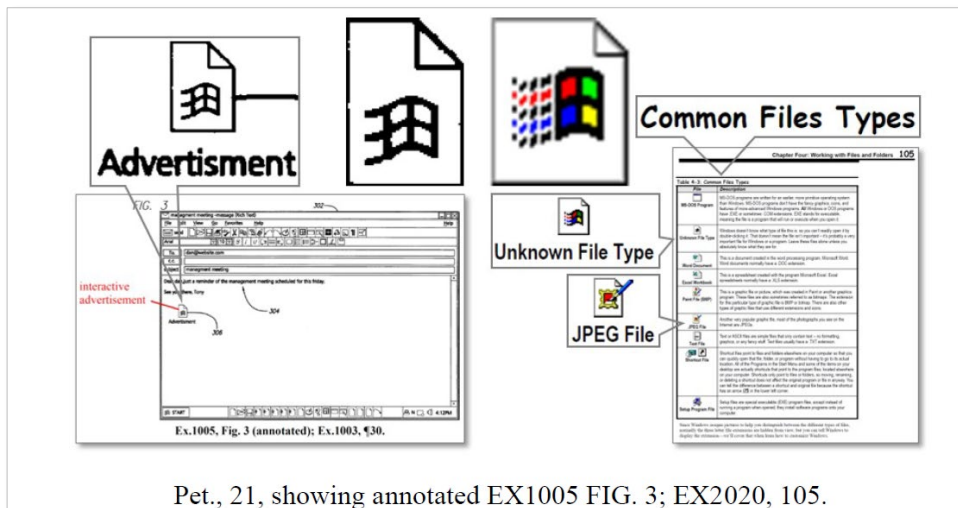
EX2009, ¶¶ 83, 101

Petitioner's impermissible new argument is wrong: attached files containing HTML tags do not qualify

Any pre-existing HTML tags within an interactive ad are not the claimed “instructions for rendering and displaying the hot link” because tags within an attached ad do not affect how an email client displays the attached file.

Patent Owner's Dr. Malek

106. Before the user can select any interactive ad from the pull down menu 404, the interactive ad already exists and already has a URL embedded in it. 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.**



Petitioner's Reply

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*

Reply at 24

EX2009, ¶¶ 88, 106

Dr. Malek's rebuttal of grounds 1-3 apply equally to identical grounds 4-6

Petitioner admits Grounds 4-6 are identical to Grounds 1-3, except they cite Chen more formally.

Petitioner's Reply

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

Reply at 18

Petition: Grounds 4-6 are identical to 1-3

D. Ground 4: Claims 1-18 and 21-22 are obvious under 35 U.S.C. § 103 over Rothschild and Chen

Ground 1 presents Rothschild as rendering obvious “instructions for rendering and displaying the hot link,” citing to Chen as evidence that it would be obvious for Rothschild’s e-mail service to be implemented using HTML, and in so doing, the HTML code would provide such instructions for rendering and displaying a hot link. To the extent Patent Owner argues that Chen does not represent the background knowledge of a POSITA, Ground 4 (along with grounds 5 and 6 for claims 19 and 20 respectively) provides reasons why a POSITA would have found it obvious to implement Rothschild’s interactive advertisements using HTML, as evidenced by Chen. Ex.1003, ¶185.

Pet. at 78

Agenda

- ▶ The '169 Patent
- ▶ The Applied Art does not Render Obvious the “Generating a Hot Link” Limitations (Claims 1 and 10)
- ▶ The Applied Art does not Render Obvious the “Determine the Action” Limitations (Claims 1 and 10)
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- ▶ **The Applied Art does not Render Obvious the Dependent Claims (Claims 2, 6, 8, 11, 15, 16)**
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No generating hot links during message creation (limitations 2.2, 6.1, 11.1)

Petitioner's Reply refers back to the earlier "generating a hot link" discussion (see previous slides).

Petitioner's Reply does not rebut Dr. Malek's explanation that HTML tags are incompatible with Rothschild's interactive ads.

Patent Owner's Dr. Malek

128. Petitioner has failed to show generating a hot link. When the sender selects from a palette of ads using the pull down menu 404, the user selects pre-existing ads that already include their embedded URLs; doing so does not generate any interactive ads.

129. Further, 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.

Petitioner's Reply

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

Reply at 25

Petitioner's Reply: no rebuttal

See Reply at 24-25

Sender—not server—determines e-mail address (location) (limitations 8.1, 16.1)

Petitioner never rebuts Dr. Malek’s statement that Petition does not show a server determining e-mail address / location.

Petitioner’s Reply refers to Petition, but Petition merely asserts that e-mail addresses are consistent with usage—not determination—of location.

Patent Owner’s Dr. Malek

131. The user inputs the email address, however, so the server does not determine any email address, as claims 8 and 16 require.

EX2009, ¶ 131

Petitioner’s Reply

space 408.” Petition, 45. This is consistent with how the ’169 patent determines locations for recipient devices. *Id.*

Reply at 25

Petition at 45, cited by Reply

Fig. 4 (showing “To” and “Cc” fields); Ex.1003, ¶95. An email address is consistent with how the ’169 patent uses the term “location”: “The location may be a network address, a telephone number, a frequency, or some other information uniquely identifying the location of the device receiving the hot link message.” Accordingly, the e-mail addresses of the recipients of Rothschild’s e-mail message are “locations” as claimed.

Pet. at 45

38

Petitioner no longer has any argument for claim 15, which requires SMS or IM, not email

Petition

[5.1] generate the hot link message as a Short Message Service (SMS) message, an instant messaging (IM) message, or an email message.

Rothschild describes its technique with the example of an e-mail message, but states that it is applicable to other forms of communication including SMS messages and instant messages: “It should be appreciated that a personal communication can include, but is not limited to, an e-mail message, text message, short message service (SMS) message, chat-room message, instant messaging message, video message, voice message, and any other personalized network communications generally known to those skilled in the art.” Ex.1005, 8:6-11.

16. Claim 15

[15.0] The computer system of claim 10, wherein the processor circuitry is to:

See claim 10. Ex.1003, ¶130.

[15.1] generate the hot link message as a Short Message Service (SMS) message for transmission over a cellular communication network, or generate the hot link message as an instant messaging (IM) message for transmission over a communications network

See claims 5 and 10. Ex.1003, ¶131.

Petitioner's Reply: no SMS

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.

Reply at 17

Agenda

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- ▶ No motivation to Combine Rothschild, Saltanov, and Maes (Claim 20)

Undisputed: the Petition is silent about “controlling” but “controlling” has meaning

Patent Owner’s Dr. Malek

133. Petitioner ignores the claim term “control” and treats “control transmission” as if it means the same thing as “transmit,” without any rationale. Pet., 34-35 (“Thus, because Rothschild’s web server *transmits* ..., Rothschild renders obvious “*control transmission* ...”). The same is true for “control receipt” and all other “control” limitations. Pet., 58 (“By *receiving* the e-mail message, an

...

134. The term “control” has meaning in computer science. Control is used to denote one or more decisions made by the computer. The software executing on

...

136. I understand that each claim term is presumed to have meaning. Thus, controlling transmission (or receipt, selection, or submission) requires more than simply transmitting. For example, if an application always shows a screen that

Petitioner’s Reply: No rebuttal

See Reply at 25-26

Petitioner cites nothing in Rothschild for “controlling”

Petitioner’s Reply

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.

Reply at 26

Petitioner’s Reply merely recites irrelevant and/or incorrect statements that do not show “controlling.” For example:

- contrary to Petitioner’s assertion, Rothschild does not teach “controlling.” Petition offers no citation.
- In contrast, the 169 claims expressly require “control.”
- Patent Owner does not assert control must be done using an operating system or BIOS.

1. One or more non-transitory computer-readable media (NCRM) including program code, wherein execution of the program code by one or more processors of a computer system is to cause the computer system to:

- identify a trigger to generate a hot link; and
- in response to detection of the trigger,
 - determine an action to be performed upon activation of the hot link based on the trigger, wherein activation of the hot link by individual user devices of a set of user devices is to cause the individual user devices to execute program code to perform the action;
 - generate a hot link message to include the determined action and instructions for rendering and displaying the hot link at each of the set of user devices; and
 - control transmission of the hot link message to the set of user devices.

EX1001, Claim 1

Agenda

- ▶ The '169 Patent
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- ▶ The Applied Art does not Render Obvious the “Controlling” Limitations (Claims 1, 2, 12, 18, 19, 20)
- ▶ **No motivation to Combine Rothschild, Saltanov, and Maes (Claim 20)**

Petitioner's expert never considered feedback to advertisers —the sole alleged motivation to combine

Petitioner's Reply notes not every detail needs to be solved.

This is not about details. The Petition discussion of Claim 20 (at 73-78) cites nothing:

- in Rothschild regarding feedback
- in Maes regarding advertisements
- in Saltanov

Patent Owner's Dr. Malek

139. Petitioner fails to explain how the jumbled, discrete pieces in its combination would work together to deliver feedback to advertisers—which is Petitioner's sole alleged motivation to combine. How would the buttons relate to

...

Petitioner fails to explain that as well. Indeed, Dr. Houh formed his opinion without even considering the question of what entities would receive the feedback.

EX2009, ¶ 139

Petitioner's Reply

Response, 67. But a motivation to combine does not require solving every technical detail a POSITA may encounter, particularly details that are unclaimed.

Reply at 27

Thank You