

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

WILDSEED MOBILE LLC,
Patent Owner.

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

PETITIONER'S AUTHORIZED BRIEFING ON REMAND

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I. Introduction

The Petition showed that claim 15 is obvious by citing Rothschild's express disclosure that its interactive advertisements—which can be formatted with HTML—are transmissible via instant messaging (“IM”). Pet., 32-35, 41, 55. Patent Owner did not specifically address claim 15 until its Sur-reply and even then only challenged the SMS limitation. Paper 36 (Federal Circuit Decision), 5. The record thus contains no evidence or argument to rebut the Petition's showing that claim 15's IM limitation is obvious. The Board should thus find claim 15 unpatentable.

II. The Petition Showed the Obviousness of Claim 15's IM Limitation.

The dispositive question on remand is whether the record shows that Rothschild's HTML-formatted interactive advertisements can be sent via IM. The Petition showed that they can. Pet., 41, 55; Ex.1005, 8:6-11; *see also* Paper 36, 5 (acknowledging that “Google's petition discusses the SMS limitation and IM limitation of claim 15”). The Petition explained that Rothschild's interactive advertisements can be sent in a “personal communication [that] can include, but is not limited to ... an **instant messaging message**.” *Id.* The prior art thus teaches “*the processor circuitry is to: ... generate the hot link message as an instant messaging (IM) message for transmission over a communications network.*”

Rothschild describes a technique for placing interactive advertisements within personal communications—not email only. Pet., 20; Ex.1005, 1:26-27; 8:6-

11. Rothschild describes its technique primarily in the context of email, and thus the Petition's independent claim analysis does so as well. Pet., 24-35. But Rothschild expressly contemplates that its technique applies to other communication types, stating that a "personal communication can include, but is not limited to ... an instant messaging message." Ex.1005, 8:6-11. The Petition relied on this express disclosure to show that Rothschild's technique applies to IM messages and cited it in its arguments for claims 5 and 15. Pet., 41, 55. And the obviousness of HTML-formatted advertisements in IM is further supported by Dr. Houh's testimony. Ex.1003 ¶¶ 80-81, 130-31; Pet., 41, 55.

Patent Owner's mischaracterization that Google's HTML argument was limited to only email ignores the actual position presented in the Petition. The Petition's proposed combination applied HTML to Rothschild's interactive advertisement itself and did not limit the type of personal communication to only email. Pet., 32-34 ("a POSITA would have recognized that such **interactive advertisement** would be implemented using HTML"). And as the Petition's introduction explained, "Rothschild describes a system that allows users to insert an interactive advertisement into an email, SMS, or **instant message** that is sent to another user. *See* Ex.1005, 8:6-11." Pet., 8.

As a result, the Petition's analysis in limitation [1.4] ("*instructions for rendering and displaying a hot link*") is directed to the HTML formatting of the

interactive advertisement itself. The communication mechanism used to transmit that advertisement—whether email or IM—does not change this analysis. Because HTML attaches to the interactive advertisement rather than to any particular message type, Rothschild's express disclosure that its technique applies to IM messages confirms that claim 15's IM limitation is met. And Rothschild's disclosure that "a personal communication can include [an] **instant messaging message**" is cited in the Petition for claims 5 and 15. Pet., 41, 55.

Patent Owner's Response focused heavily on Rothschild's SMS embodiment of Fig. 11 and ignored the relevant analysis provided in the Petition. But the Petition did not rely on the use of HTML with SMS messages and instead relied on the known and obvious use of HTML with interactive advertisements transmitted over internet-based communications. Reply, 17. Nothing in that position excluded the applicability of HTML-formatted interactive advertisements to other communication types expressly contemplated by Rothschild, including IM.

Moreover, the Petition's analysis of the IM limitation provides at least as much disclosure for IM as the '169 patent itself provides. *See Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1570 (Fed. Cir. 1997). The '169 patent does not describe any technical details about implementing the invention in an IM environment. *See generally* Ex.1001. Rather, the '169 patent simply states that "[t]he message is sent using an appropriate message protocol for the receiving

device.” Ex.1001, 2:24-25. It then merely lists email and IM as alternative message formats in claims 5 and 15. Rothschild, by contrast, expressly states that its technique applies to IM messages. Pet., 41; Ex.1005, 8:6-11.

In sum, the Petition, supported by Dr. Houh's testimony, demonstrated that Rothschild's express disclosure of applying its interactive-advertisement technique to IM messages—combined with the well-known use of HTML to implement such advertisements—rendered obvious the IM limitation of claim 15.

III. The Full Record in Context Confirms HTML-formatted Advertisements Apply to IM.

The full context of the record does not support Patent Owner's contentions at the Federal Circuit that Petitioner limited its HTML argument to email only. Patent Owner points to certain statements made by Petitioner in its Reply and at the oral hearing. But these statements do not foreclose—or even address—the applicability of HTML-formatted interactive advertisements to IM messages. For example, Petitioner stated that “the Petition does not rely on the obviousness of using HTML with SMS messages” but “instead relies on the obviousness of using HTML with interactive advertisements in email.” Reply, 17. Patent Owner characterizes this as a “dispositive” concession that Petitioner's HTML argument was limited to email and excluded all other message types, including IM. Appellee Br. 14-15. But context matters. The Reply was distinguishing the two main embodiments of Rothschild—the cellular-network SMS method and the internet-

based method—and explaining that the Petition relied on the latter, not the former.

And Petitioner's statement about the interactive advertisement being "in email" was responsive to Patent Owner's challenge of the independent claims, where the analysis used the email example. PO Resp. 32-48. These statements simply do not disclaim HTML-formatted advertisements in IM.

Petitioner's oral hearing statements similarly do not disclaim HTML-formatted advertisements with IM. At the oral hearing, Petitioner's counsel referenced "image data" such as JPEG as a "technique" that "can apply" to "instant messaging." Tr., 56. Patent Owner reads this as an admission that Petitioner's only argument for IM was JPEG, not HTML. Appellee Br. 19-20. Petitioner's discussion of alternative teachings does not foreclose HTML-formatted interactive advertisements from meeting this limitation. Petitioner never disclaimed the use of HTML-formatted advertisements with IM, as the transcript shows. Tr., 56.

Importantly, Petitioner's Reply and oral hearing statements are entirely consistent with the points presented here. The Petition relied on the obviousness of using HTML with Rothschild's interactive advertisement—the same interactive advertisement that Rothschild expressly states can be sent via IM. Reply, 17-21.

IV. The Record Contains No Evidence Disputing HTML-formatted Advertisements in IM Messages.

Patent Owner never provided expert testimony or other evidence disputing Rothschild's express teaching that the personal communication containing the

interactive advertisement can be an IM message, nor did Patent Owner contest the Petition's showing with respect to the IM limitation of claim 15. *See generally* PO Resp.; PO Sur-reply; Paper 36, 5. This silence is significant because the only expert testimony addressing the IM limitation is from Petitioner's expert, Dr. Houh, and that testimony supports a finding of unpatentability.

Patent Owner's Response did not separately address claim 15. Instead, its arguments focused on the independent claims—specifically, whether Rothschild used HTML at all and whether Rothschild's SMS embodiment could support HTML formatting. PO Resp. 32-48, 60-65. Patent Owner made no argument directed to the IM alternative recited in claim 15 and thus waived it.

As the Federal Circuit acknowledged, Patent Owner “specifically addressed claim 15 for the first time in its patent owner's sur-reply **but provided arguments only for the SMS limitation.**” Paper 36, 5. The Sur-reply stated that “Petitioner's sole allegations regarding SMS and IM are that Rothschild also discloses those formats,” but proceeded to argue only that “SMS messages do not use HTML tags.” Sur-reply, 27. Patent Owner's expert, Dr. Malek, testified that SMS messages are incompatible with HTML formatting, but did not testify that IM messages are similarly incompatible. Ex.2009 ¶¶ 57, 60, 64, 76.

Dr. Houh's testimony is therefore unrebutted. Although Petitioner bears—and has carried—the burden of proving unpatentability by a preponderance of the

evidence, 35 U.S.C. § 316(e), Patent Owner's failure to contest the IM limitation leaves the Petition and Dr. Houh's testimony as the only evidence on this issue.

The Board should credit that un rebutted evidence and find that Petitioner has demonstrated the obviousness of claim 15's IM limitation.

V. Finding Unpatentability of Claim 15 Is Consistent with the FWD.

A finding that claim 15 is unpatentable is consistent with the Board's analysis in its FWD. The Board's sole basis for distinguishing claim 15 was the incompatibility of SMS with HTML. The Board found that "SMS does not use HTML or any other formatting" and concluded that Petitioner had not shown how an SMS message could satisfy the limitation requiring instructions for rendering and displaying the hot link. FWD, 35-36. Neither the Patent Owner nor the Board identified any deficiency in Petitioner's showing regarding HTML-formatted interactive advertisements delivered by IM. Indeed, the evidence of record showed that Rothschild's internet-based communication types such as instant messaging messages are compatible with HTML, which is "platform independent" and is "the publishing language of the World Wide Web"—a "kind of publishing mother tongue that all computers may potentially understand." Ex.1010, 1; Ex.1011, 1, 23. The Board's SMS-specific rationale does not apply to IM.

The record thus establishes that Rothschild's interactive advertisements apply to IM messages and that Claim 15 is unpatentable.

Respectfully submitted,

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CERTIFICATE OF SERVICE

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

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