

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 RESPONSIVE BRIEFING ON REMAND

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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As Google itself acknowledges, “the Petition’s analysis ... is directed to the HTML formatting of the interactive advertisement.” Paper 38 (“Remand Br.”), 2–3. But that analysis is exclusively in the context of “formatting the message data into an e-mail message.” Pet., 23–34. Google now claims it did not limit that theory “to only email,” Remand Br., 2, but its attempts to backfill its deficient Petition fail. The Petition never presented any theory of HTML-formatted instant messages. Nor does Google provide *any* rationale for combining the teachings of Rothschild’s different email and IM embodiments to produce HTML-formatted instant messages, as required under Federal Circuit law and the Board’s precedent.

That is why Google’s framing of the dispositive question is incorrect. Google contends the question is “whether the record shows that Rothschild’s HTML-formatted interactive advertisements can be sent via IM.” Remand Br., 1. It is not. Google’s framing ignores its burden to identify “with particularity” the “evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); 37 C.F.R. §§ 42.104(b)(4)–(5). Google’s failure to present an HTML-formatted IM theory in its Petition is fatal. Like its failure to show obviousness of the SMS limitation of claim 15, Google never tied the use of HTML to IM messages. Google cannot meet its burden by retro-fitting a position it never advanced.

The Board already found that the Petition “requires an email embodiment, with HTML,” to satisfy the independent claims. FWD, 35. Applying this finding,

the Board determined—and the Federal Circuit endorsed—that Google failed to meet its burden with respect to SMS messages. Google’s Petition treats SMS and IM equally, Pet., 41, so the Board’s logic equally applies to IM messages. The Board should thus confirm its decision upholding claim 15.

I. The Petition Does Not Demonstrate Obviousness of Using HTML to Format Instant Messages.

A petitioner “may not rely on a vague, generic, and/or meandering petition and later fault the Board for failing to understand what the petition really meant.” *Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371, 1377 (Fed. Cir. 2023). The petitioner must “articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Google’s Petition fails to do that.

Claim 15 requires “generat[ing] the hot link message” as either “a Short Message Service (SMS) message” or “an instant messaging (IM) message” and incorporates claim 10’s “instructions for rendering and displaying the hot link” limitation. EX1001, 19:28–30, 19:63–20:3. For claim 10, Google undisputedly relied exclusively on Rothschild’s email embodiment to argue obviousness of generating an HTML-formatted advertisement. Pet., 32–34 (“[A] POSITA would have found it obvious for Rothschild’s interactive advertisement, which is sent in the e-mail (*‘hot link message’*), to include HTML code that acts as *‘instructions for rendering and displaying a hot link.’*”); EX1003 ¶¶58–60; Pet. Reply, 13; Pet., 52–

53 (referencing Pet., 32–34).¹ Google’s subsequent reference to Rothschild’s separate “instant messaging message” embodiment, Pet., 41 (citing EX1005, 8:6–11), falls well short of meeting its burden to establish obviousness of claim 15.

a. As Google itself explains, “the Petition’s analysis ... is directed to *HTML formatting* of the interactive advertisement.” Remand Br., 2–3. That analysis solely addresses the context of “formatting the message data into an e-mail message.” Pet., 23–34. Nowhere does Google tie this analysis to IM messages, much less assert that Rothschild’s IM messages would include *any* formatting or HTML. *Id.*, 41. Google must be held to the theory presented in its Petition; its failure to present any HTML-formatted IM theory is alone fatal to its obviousness challenge. *DraftKings Inc. v. AG 18, LLC*, No. 2024-2078, Slip Op. at 5 (“Our case law explains that the Board cannot entertain theories absent from the petition.”) (Fed. Cir. 2026); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330 (Fed. Cir. 2019) (Board did not “abuse its discretion by holding [petitioner] to the obviousness theory in its petition”).

b. Google’s Petition further provides no reason why a skilled artisan would have applied Rothschild’s email teachings to its separate IM embodiment. Google’s complete IM analysis consists of a statement that Rothschild’s technique “is applicable to other forms of communication,” citing one paragraph of Rothschild. Pet., 41. That paragraph states nothing more than “*a personal communication can*

¹ Emphasis added unless otherwise indicated.

include ... an e-mail message, text message, short message service (SMS) message, chat-room message, instant messaging message” Pet., 41, 55 (quoting EX1005, 8:6–11). Neither Google nor its expert explains how HTML would render a hot link in an IM client; they offer no IM-specific motivation to combine; and they cite no evidence that a POSITA would have understood IM messages to use HTML at all. Pet., 41; EX1003, ¶¶80–81. Indeed, Google’s expert simply repeats the Petition’s conclusory analysis verbatim. *Compare* Pet., 41, *with* EX1003, ¶¶80–81. Google cannot carry its burden without providing rationale to combine the relied-upon teachings of different IM and email embodiments. *In re Stepan Co.*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017) (“Whether a rejection is based on combining disclosures from multiple references, combining multiple embodiments from a single reference, or selecting from large lists of elements in a single reference, *there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful*”); *Abiomed, Inc. v. Maquet Cardiovascular, LLC*, IPR2017-01204, Paper 9 at 8-12 (P.T.A.B. Oct. 23, 2017).

c. The Board correctly found, and the Federal Circuit endorsed, that Google did not demonstrate the prior art “teaches instructions for displaying and rendering where the hot link message is generated as an SMS message.” FWD, 34–37; Paper 36, 5. That reasoning is equally applicable to IM messages. Both the Petition and Rothschild treat SMS and IM identically—as with SMS, the Petition never ties

together the use of HTML to format SMS or instant messages, let alone suggest that these communication types would be formatted at all. Pet., 41. Google attempts to salvage its IM arguments by alleging that “the record contains no evidence disputing HTML-formatted advertisements in IM messages.” Remand Br., 5. But the burden is on Google—not Wildseed—to establish the obviousness of using HTML to format Rothschild’s IM messages. Like SMS, Google’s Petition presents no evidence supporting this conclusion. Google’s IM and SMS arguments thus fall together.

II. The Trial Record Supports that Google Expressly Limited Its HTML Theory to Rothschild’s Email Embodiment.

Google reaffirmed throughout the IPR that its HTML-formatting theory was limited to Rothschild’s email embodiment. Google’s Reply expressly stated that “the petition does *not* rely on the obviousness of using HTML with SMS messages” and “*instead relies on the obviousness of using HTML with interactive advertisements in email.*” Pet. Reply, 17. Google now contorts that sentence to allege it was merely distinguishing Rothschild’s SMS embodiment from its internet-based embodiment, leaving intact the possibility of HTML-in-IM. Remand Br., 4–5. That revisionist reading cannot be squared with the statement Google made. Google limited its HTML theory to “email”—not to “internet-based messaging”—and nowhere did it mention including HTML in IM messages. The scope of the Petition’s theory is defined by what Google presented to the Board, not by what Google perhaps now wishes it had said. *Henny Penny*, 938 F.3d at 1330 (Fed. Cir. 2019).

Google doubled down at oral hearing. When Wildseed noted that Google had articulated no HTML argument for claim 15, Google attempted to pivot to an image formatting theory, again lumping IM and SMS together:

[W]hat the petition does rely on is that Rothschild’s explicit teaching of a technique, it can apply that to SMS or instant messaging. In either of those cases ... the image data for the advertisement, such as a JPEG or GIF, would be instructions for displaying that advertisement to the user.

Id., 56:16–25. Google’s on-record shift from HTML to image data cannot now be explained away as a parenthetical about “alternative teachings.” Remand Br., 5.²

III. Google’s Remand Brief Cannot Cure the Petition With New Arguments.

Google now manufactures reasoning not in its Petition, arguing that HTML “attaches to the interactive advertisement rather than to any particular message type.” Remand Br., 3. The Petition made no such “attaches-to-the-ad” argument, and neither did Dr. Houh. Nor did Google provide a reason to include an HTML ad in an IM. Likewise, Google’s new theme that IM is “internet-based” (and therefore like email and unlike SMS) is one Google itself conceded it “had no reason to address” during the IPR. *Google LLC v. Wildseed Mobile, LLC*, No. 24-2178, Appellant

² Moreover, the Board already rejected Petitioner’s reference to “image data,” explaining that “Petitioner does not explain how an image displayed in an SMS would be rendered.” FWD, 36–37. The same is true for IM messages.

Opening Br. at 32 (Fed. Cir. Dec. 6, 2024). New theories cannot repair a petition that did not carry its initial burden. *Magnum Oil*, 829 F.3d at 1380–81.

IV. Google’s Remaining Arguments Fail.

Google asserts that “Patent Owner made no argument directed to the IM alternative recited in claim 15 and thus waived it.” Remand Br., 5–6. But the burden to show obviousness never shifts to the patent owner. *Magnum Oil*, 829 F.3d at 1375. Google presented only an email-based HTML theory, not a separate HTML-in-IM theory. Wildseed was thus not required to rebut an argument Google never made. *FanDuel, Inc. v. Interactive Games LLC*, 966 F.3d 1334, 1342 (Fed. Cir. 2020). Dr. Malek’s testimony nonetheless undercuts Google’s missing theory. As he testified, Rothschild’s only disclosed visual example of an interactive ad is in RTF—not HTML. EX2009, ¶¶59, 76. Rothschild does not teach HTML for any embodiment of its interactive ads.

Google’s assertion that “the Petition’s analysis of the IM limitation” is commensurate with the ’169 patent’s disclosure similarly cannot remediate Google’s deficient Petition. Remand Br., 3–4 (citing *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1570 (Fed. Cir. 1997)). *Lockwood* is immaterial here; it does not change or remove Google’s burden to establish obviousness under 35 U.S.C. §§ 316(e) or 312(a)(3). *Lockwood*, 107 F.3d at 1571–72; *Henny Penny*, 938 F.3d at 1330.

The Board should confirm that Google has not shown claim 15 unpatentable.

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER'S RESPONSIVE BRIEFING ON REMAND** was served in its entirety on May 8, 2026, upon the following parties via electronic mail :

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