

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 REPLY ON REMAND

Patent Owner's new reliance on *In re Stepan* rests on a false premise. The Petition did not combine separate "email" and "IM" embodiments. Resp Br., 4. It relied on Rothschild's single disclosed technique—embedding an "interactive advertisement" within a "personal communication"—which Rothschild expressly teaches includes instant messaging (IM).

Rothschild does not disclose isolated "email" and "IM" embodiments. It describes its invention broadly as "a system and method that allows an Internet user to place an advertisement within a personal communication." Ex.1005, 1:26-28. It then expressly defines "personal communication" to include "an e-mail message" or an "instant messaging message" among other communication forms. Ex.1005, 8:6-11. Thus, Rothschild teaches a single "interactive advertisement" technique usable across multiple communication formats, including IM.

The Petition consistently presented Rothschild in this manner. Its "Summary of Rothschild" described Rothschild as a unitary "system and method that allows an Internet user to place an advertisement within a personal communication." Pet., 20. The introduction likewise explained that "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. And for claims 5 and 15, the Petition stated that "Rothschild describes its technique with the example of an e-mail message, but states that it is applicable to other forms of

communication including...instant messages.” Pet., 41.

The Petition’s HTML analysis follows the same framework. As the Board recognized in authorizing this reply, “the Remand Brief focuse[d] on Rothschild’s alleged teaching of a general application of HTML to advertisement, and the availability of numerous alternative communication mechanisms (email, IM) for that HTML.” Paper 42, 3. The Petition explained that “a POSITA would have recognized that such interactive advertisement would be implemented using HTML.” Pet., 33. The Petition thus applied HTML to Rothschild’s “interactive advertisement” generally, while separately relying on Rothschild’s express teaching that the advertisement may be delivered via IM. Pet., 41, 55.

Patent Owner’s attempt to recast the Petition as combining embodiments artificially divides Rothschild’s unified disclosure. The Petition relied on Rothschild’s express teaching that adding an “interactive advertisement” to a “personal communication” applies across communication forms, including IM.

Even if Rothschild’s disclosures were treated as separate “embodiments,” *Stepan* is satisfied. *Stepan* requires “a motivation to make the combination and a reasonable expectation that such a combination would be successful.” *Stepan*, 868 F.3d at 1346 n.1. Rothschild supplies both by expressly teaching that its “interactive advertisement” technique applies to IM messages. Pet., 41, 55. The Board should find claim 15 unpatentable.

Respectfully submitted,

Dated: May 29, 2026

HAYNES AND BOONE, LLP
2801 N. Harwood St., Suite 2300
Dallas, Texas 75201
Customer No. 27683

/Andrew S. Ehmke/
Andrew S. Ehmke
Registration No. 50,271
Lead Counsel for Petitioner

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.

Date of service May 29, 2026

Manner of service Email Service:

dalberti@albertilim.com;
slim@albertilim.com;
mspecht-PTAB@sternekessler.com;
jfitzsimmons-PTAB@sternekessler.com;
rbemben-PTAB@sternekessler.com;
spappas-PTAB@sternekessler.com;
PTAB@sternekessler.com;
AlbertiLim-WildseedMobile@albertilim.com

Documents served ***PETITIONER'S AUTHORIZED REPLY ON
REMAND***

Persons served David L. Alberti; Sal Lim
ALBERTI LIM & TONKOVICH LLP
950 Tower Lane, Suite 1725
Foster City, California 94404

Michael D. Specht; Jason A. Fitzsimmons
Richard M. Bemben; Steven M. Pappas
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1101 K Street, NW, 10th Floor
Washington, D.C. 20005

/Andrew S. Ehmke/

Andrew S. Ehmke
Registration No. 50,271
Lead Counsel for Petitioner