

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

WILDSEED MOBILE, LLC,
Patent Owner.

IPR2023-00247
Patent 10,869,169 B2

Before KARL D. EASTHOM, TERRENCE W. McMILLIN, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

CYGAN, *Administrative Patent Judge*.

DECISION
Final Written Decision on Remand
Determining Some Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

A. *Background and Summary*

Google LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of claims 1–22 (the “challenged claims”) of U.S. Patent No. 10,869,169 B2 (Ex. 1001, the “’169 patent”). The parties briefed their positions, oral argument was held, and we entered a Decision that Petitioner has shown by a preponderance of the evidence that claims 1–14 and 16–22 of the ’169 patent are unpatentable, and has not shown by a preponderance of the evidence that claim 15 of the ’169 patent is unpatentable. Paper 33 (“Final Dec.”).

Google LLC appealed our determination that Petitioner has not shown that claim 15 is unpatentable to the Federal Circuit, which issued a decision vacating our determination with respect to claim 15. *Google LLC v. Wildseed Mobile, LLC*, 2026 WL 409969, at 1, 3 (Fed. Cir. February 13, 2026). The Federal Circuit determined that it “cannot reasonably discern the basis upon which the Board concluded that Google has not shown that claim 15 would have been obvious over the prior art.” *Id.* at 3. The Federal Circuit remanded the case for an explanation of the reasoning for that determination. *Id.* at 3.

Consistent with the remand, the Board and parties conferenced on the nature of the further briefing, resulting in briefing limited to the obviousness rejection of claim 15 without further submission of evidence. Paper 37. Petitioner filed its Remand Briefing, and Patent Owner filed Responsive Briefing. Papers 38, 41. We granted additional briefing upon Petitioner’s request “limited to the *In re Stepan*” discussion in Patent Owner’s Responsive Briefing. Paper 42. Petitioner filed its Remand Reply and Patent Owner filed its Remand Sur-reply. Papers 43, 44.

Consistent with the scope of the remand, we issue this Final Written Decision on Remand addressing only claim 15. We incorporate the full original Final Written Decision (Paper 33) in this Decision, including the level of ordinary skill in the art and the plain meaning construction of all terms, which have not been further addressed in the post-remand briefing. Claim 15 recites two alternative modalities for generating a hot link message, either as a Short Message Service (SMS) or an instant messaging (IM) message. Petitioner does not contest our finding that the SMS alternative of claim 15 has not been shown to be unpatentable. *Google v. Wildseed*, 2026 WL 409969 at 2. We do not revisit that determination here as it is outside the scope of the remand.

On the full trial and remand record, with respect to the sole issue of the patentability of the IM alternative of claim 15, we determine that the Petitioner has not provided evidence or explanation sufficient to meet its obviousness burden. Accordingly, we determine that Petitioner has not shown, by a preponderance of the evidence, that claim 15 of the '169 patent is unpatentable.

B. Claim 15

Claim 15 recites:

15. The computer system of claim 10, wherein the processor circuitry is to:
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.

Ex. 1001, 19:63–20:3. Claim 15 depends from independent claim 10, which recites, in pertinent part, that the processor circuitry is to “generate the 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.” *Id.* at 19:28–30. Such language in claim 10 is essentially identical to language in independent claim 1. *Id.* at 18:19–21.

C. Prior Art and Asserted Grounds

Petitioner asserts that claim 15 would have been unpatentable as being obvious over Rothschild (Ex. 1005),¹ or Rothschild in view of Chen (Ex. 1007)^{2, 3}

II. ANALYSIS

A. Legal Standards

Petitioner has the burden to shown the unpatentability of any challenged claim. “In an inter partes review . . . , the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.” 35 U.S.C. § 316(e). “In an *inter partes* review, the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ 35 U.S.C. § 316(e), and that burden never shifts to the patentee.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir. 2016).

The unpatentability assertions to be considered at trial are those presented in the Petition. *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 365 (2018) (stating that “an inter partes review . . . proceeds ‘[i]n accordance with’ or ‘in conformance to’ the petition” (quoting Oxford English Dictionary (3d ed., Mar. 2016), www.oed.com/view/Entry/155073)).

¹ U.S. Patent No. 8,645,211.

² U.S. Patent No. 6,836,792.

³ Petitioner asserts, and we agree, that the pre-AIA patentability statutes apply to the ’169 patent. *See* Pet. 19.

B. Analysis of Claim 15

1. The Assertions in the Petition

The Petition asserts that claim 15 would have been obvious over Rothschild or alternately, over Rothschild and Chen. Pet. 15, 82. Petitioner relies exclusively on its showing for claims 5 and 10 for claim 15. Pet. 15 (stating only “See claims 5 and 10. Ex. 1003 ¶ 131”), 82; Ex. 1003 ¶ 131 (stating only “See claims 5 and 10”).

Petitioner’s discussion of claim 10 is limited to Rothschild’s email descriptions. For the “generate the hot link message” limitation of claim 10, Petitioner refers solely to its assertions for the “generate a hot link message” limitation, limitation [1.4], of claim 1. Pet. 53–54. Petitioner’s assertions for generating a hot link message in limitation [1.4] are solely based on email. Pet. 32 (stating, “by formatting the message data into an e-mail message containing the interactive advertisement, the web server ‘*generates a hot link message*’ as claimed.”). Further, the Petition relies on e-mail for the requirement of limitation [1.4] that the hot link include the determined action and instructions for rendering and displaying a hot link. *Id.* at 34 (stating, “because Rothschild’s web server formats an e-mail message which includes the interactive advertisement that defines how it is to be displayed, Rothschild renders obvious ‘*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*’ as claimed.”). Petitioner’s explanation of how Rothschild teaches claim 1 relies entirely on its email discussion, and does not rely at all on any teachings of Rothschild of an IM modality. Nor does Petitioner point to a general teaching that would encompass more than the workings of Rothschild’s email modality.

Petitioner’s discussion of the other “hot link” limitations of claim 10 also rely solely upon Rothschild’s e-mail example. *See* Pet. 49 (“as explained above at [limitations [1.1] and 1.2]], a user accesses a web site to generate an e-mail message with an interactive advertisement [teaching] ‘*a request to generate a hot link.*’”), 50 (“by designating e-mail addresses of users who have their associated devices, the sending user is designating a set of second user devices.”), 51 (“Rothschild’s web server transmits the e-mail message with the interactive advertisement (‘*hot link message*’) to the recipients (‘*set of second user devices*’)”), 52 (“Rothschild’s system places a selected advertisement—along with an embedded URL—into an e-mail message (‘*determines an action to be performed upon activation of the hot link*’)”). Petitioner does not discuss either the SMS or IM modalities in its assertions for claim 10.

Petitioner’s discussion of claim 5 addresses the limitation, “generate the hot link message as a Short Message Service (SMS) message, an instant messaging (IM) message, or an email message.” Pet. 41. Petitioner’s showing for the obviousness of the SMS and IM modalities follows:

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.”

Pet. 41 (quoting Ex. 1005, 8:6–11).

2. The Briefing, Board's Decision, and Federal Circuit Decision

In its Response, Patent Owner did not specifically address either the SMS or IM modalities of claim 5. *See* PO Resp. However, Petitioner made the following statement in its Reply:

Patent Owner mischaracterizes the Petition as relying on inherency rather than obviousness: “But nowhere does Rothschild teach that its e-mails use HTML format, nor is that inherent.” Response. 33. Patent Owner further attacks an embodiment not relied on the Petition by arguing that “Rothschild discloses attaching interactive ads to SMS messages, which do not use HTML.” Response, 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.

Pet. Reply 17.

Patent Owner seized upon this statement in its Sur-reply. PO Sur-reply 27. Patent Owner argues that “Petitioner never reconciles its theories for independent claims versus claim 15.” *Id.* Patent Owner points to a statement of Dr. Malek as attesting that SMS messages do not use HTML tags.” *Id.* (citing Ex. 2009 ¶¶ 57–72). Patent Owner argues that, in Petitioner’s own words, “[t]he Petition does not rely on the obviousness of using HTML with SMS messages.” *Id.*

In our Final Written Decision, we determined that Petitioner has not clearly shown how claim 15 would have been obvious, stating:

Petitioner’s assertions for the “generate a hot link message” limitation in independent claim 1 are based upon “Rothschild’s formatting process [that] generates the email by compiling data – including the advertisement – into an email format.” Pet. Reply 13. Petitioner requires an email embodiment, with HTML, to meet limitation [1.4]. *Id.* at 20–21 (“the combination of Rothschild and Chen represents the

combination of known elements (e-mail advertisements) according to known methods (HTML) to yield predictable results.”).

However, the record establishes that SMS does not use HTML or any other formatting in sending a message. Ex. 2009 ¶¶ 57 (citing Ex. 1005, Fig. 10), 60 (citing Ex. 1005, Fig. 11), 64 (“[t]here is no formatting step for the SMS message, only for e-mail.”), 76 (“SMS messages . . . do not use HTML”). The record further establishes that HTML code is relied upon as the teaching for the claimed instructions for rendering. Ex. 2011, 92:17–93:4. . . . Because SMS messages are not formatted, Petitioner has not persuasively explained how a message sent by SMS would satisfy the “instructions for rendering and displaying the hot link” recited in claim 10 that are incorporated into dependent claim 15.

Final Dec. 35–36.

On appeal to the Federal Circuit, Petitioner argued that the Board’s Decision did not address the IM alternative of claim 15. *Google v. Wildseed*, 2026 WL 409969 at 2. Petitioner did not contest our finding that the SMS alternative of claim 15 has not been shown to be unpatentable. *Id.*

The Federal Circuit agreed with Petitioner, finding the Board’s Decision ambiguous on the IM alternative. *Id.* The Federal Circuit stated, “[a]lthough the Board performed a thorough analysis of the SMS limitation, the Board failed to address the IM limitation. Indeed, it made no mention of IM and even omitted the IM limitation in its quotation of claim 15.” *Id.* at 6. The Federal Circuit could not reasonably discern the basis of the Board’s decision on the IM alternative; e.g. whether it was based upon reasons why “the asserted prior art does not teach or suggest the IM limitation” or upon “a non-merits reason-such as failure to include an IM-based ground in the petition, subsequent abandonment of such a ground, waiver, or forfeiture.” *Id.* Determining that the Board “is required to ‘document its reasoning on

the record to allow accountability . . . [and] effective judicial review,” the Federal Circuit vacated the Board’s obviousness determination as to claim 15 and remanded for further proceedings consistent with their opinion. *Id.* at 6–7.

3. Determination upon Remand

The basis of the original Decision was that Petitioner had not satisfactorily explained why Rothschild’s email-related teachings would be applicable to generating a hot link message by IM. Petitioner’s explanation of how Rothschild generates a hot link message relied upon Rothschild’s formatting process, of which the only example given is the use of HTML in an e-mail message. Further, in explaining how Rothschild teaches limitation [10.7]/[1.4], that such generat[ing] is “to include the determined action and instructions for rendering and displaying the hot link,” Petitioner relied upon “HTML tags (‘instructions’) that define how the embedded URL is displayed within the interactive advertisement.”

The only explanation provided by Petitioner as to generating a hot link message by IM is that Rothschild states 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.” Pet. 40 (quoting Ex. 1005, 8:6–11); Pet. Remand Reply 2, 5–6 (arguing that this is unrebutted by Patent Owner). Such an explanation would be sufficient if each of those communications were shown to work in the same manner as email, such that no further explanation would be required to show that one having ordinary skill in the art would understand how Petitioner’s email and HTML tag explanations applied to each of the other message types.

However, it is uncontested that SMS does not use HTML tags or a formatting step, which is required under Petitioner's assertions for limitation [10.7]. Ex. 2009 ¶¶57 (citing Ex. 1005, Fig. 10), 60 (citing Ex. 1005, Fig. 11), 64 (“[t]here is no formatting step for the SMS message, only for e-mail.”), 76 (“SMS messages . . . do not use HTML”); PO Sur-reply 27. Nor does Petitioner assert or explain that IM messages are formatted so as to teach the generating step of limitation [1.4]/[10.7]. Pet. 32 (“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.”). Because Petitioner's “generating a hot link” assertions rely on the use of HTML (in email), and one of Rothschild's listed communication types (SMS) does not use HTML, Petitioner fails to show persuasively that an artisan of ordinary skill would have interpreted each of Rothschild's other listed types of personal communication as using HTML to generate a hot link in the claimed manner.

For example, the Petition states, “using HTML to implement advertisements within e-mail messages was well-known to POSITAs.” Pet. 33. Petitioner provides evidence to support this. *Id.* (citing Ex.1007 (Chen), 2:37–54, Ex. 1005, 2:2–36). But the Petition does not assert that using HTML to implement advertisements within IM messages was also well-known, or even that it was a possibility at the relevant time. It is not sufficient that Petitioner has not “disclaim[ed] HTML-formatted advertisements in IM.” Pet. Remand Br. 4–5. Dr. Malek's un rebutted testimony that Rothschild's SMS does not use any formatting step clearly indicates that not all of Rothschild's communications use HTML formatting. Petitioner fails to show that IM, like email, uses a similar formatting step or some other means, and fails to explain how such an IM formatting step or

other means teaches the limitations of claim 15 (including those incorporated by dependency from claim 10). We agree with Patent Owner that Petitioner has not done so. PO Remand Resp. 1 (“[Petitioner] never tied the use of HTML to IM messages”).

Although Dr. Houh testifies that the use of IM would have been obvious, this testimony is a verbatim copy of what the Petition says on claim 5. *Compare* Ex. 1003 ¶¶ 80–81, 130–31 *with* Pet. 41. Dr. Houh cites to Rothschild’s list of communication types, but provides no analysis or reasoning or further evidence for his obviousness conclusion in the Houh Declaration. As such, it is a bare conclusory statement entitled to little or no weight. *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinions is based is entitled to little or no weight.”). We further note that although Dr. Houh relies upon Rothschild’s “interactive advertisement that is displayed with a graphic and includes an embedded URL,” Dr. Houh does not explain how each of the listed communication types (which include a voice message), or IM specifically, have these properties. Ex. 1003 ¶ 58.

Absent a showing connecting IM to a formatting process or other suitable means, a gap remains between Rothschild’s teaching that IM may be a type of personal communication, and the claimed “generate the 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” of claim 10, incorporated by dependency into claim 15. Petitioner has not provided a detailed explanation, supported with specific teachings in Rothschild, as to how Rothschild’s IM modality generates hot links. Petitioner points to no teaching in Rothschild, and provides insufficient evidence or explanation of

record, to show how an IM personal communication can be used to generate a hot link as claimed.

In its Remand Reply, Petitioner argues that its statements “do not disclaim HTML-formatted advertisements in IM,” and that there is no evidence or expert testimony that IM messages are incompatible with HTML tags. Pet. Remand Reply 4–7 (also stating, “nor did Patent Owner contest the Petition’s showing with respect to the IM limitation of claim 15”). However, in *inter partes* review, the burden is on Petitioner to explain and support its assertions; it is not on Patent Owner to prove that its claims are not unpatentable. *In re Magnum Oil Tools*, 829 F.3d at 1375; PO Remand Resp. 5. Petitioner must explain how Rothschild teaches generating a hot link message, in an instant message communication, that includes the determined action and instructions for rendering and displaying the hot link. Petitioner’s reliance on a list of communication types is insufficient because although personal communications are sent “with” an advertisement, not all members of that list (e.g., SMS) generate a hot link message having the claimed instructions in the manner (formatting) asserted by Petitioner. Ex. 1005, 8:3–6; Ex. 2009 ¶ 64.

Petitioner argues that the trial record shows that IM messages use HTML tags, and that IM messages should be grouped with Internet communications such as email rather than wireless communications such as SMS. Pet. Remand Reply 7 (citing Ex. 1010, 1; Ex. 1011, 1, 23). Neither of the cited references show that IM messages use HTML tags. The first-cited reference, a document specifying Internet standards track protocol, indicates that HTML creates “documents” that are “platform independent,” not that all Internet transmission modalities use HTML tags. Ex. 1010, 1. The second-cited reference, an “Introduction to HTML 4.01,” states that HTML is a

publishing language used by the World Wide Web. Ex. 1011, 1, 23. Neither reference states that IM messages use HTML tags or explains how a hot link message is generated in an IM communication.

Petitioner’s remand briefing further argues that the HTML “attaches to” the advertisement rather than the message. Pet. Remand Reply 2–3. Petitioner asserts that because of this, the HTML formatting is independent of the communication type used. *Id.* Patent Owner argues that this is a new argument in that it differs from the reasoning presented in the Petition. PO Remand Resp. 6. The Petition’s assertion for limitation [1.4]/[10.7] relies on “format[ing] the message data into an email,” not “HTML-formatted advertisements” as argued in Petitioner’s Remand Briefing. Pet. Remand Reply 2–3. Petitioner’s reliance on Chen for teaching HTML is illuminating on this point. Pet. 79;⁴ PO Remand Resp. 7 (Rothschild teaches RTF formatting, not HTML formatting). In the Petition, Petitioner relies upon Chen for “known mechanisms by which advertisements are inserted into e-mail messages—through HTML.” Pet. 79. Petitioner quotes Chen, “an advertisement insertion module 170 interfaces with HTML converter facility 158 to insert an appropriate advertisement banner into the email message prior to sending the email message.” *Id.* (citing Ex.1007, 2:51–54). Petitioner’s declarant Dr. Houh describes the combination as “using HTML to render an email that includes an advertisement.” Ex. 1003 ¶ 192. Although Petitioner also cites Chen for advertisements that may have HTML links (citing Ex. 1007, 8:23–27), the Petitioner relies on “format[ing] the message data,” not selecting link-containing advertisements, to teach

⁴ Petitioner’s Rothschild-only ground similarly relies on Chen as evidence that it would have been obvious to use HTML “to implement advertisements within e-mail messages.” Pet. 33 (citing Ex. 1007, 2:37–54).

limitation [1.4]/[10.7]. We agree with Patent Owner that the Petition's focus on formatting the message data into an email is not entirely consistent with Petitioner's remand argument that the HTML attaches to the advertisement in a manner independent from the communications medium bearing the advertisement. Moreover, as discussed above and regardless of whether Petitioner's argument is new, the Petition does not address the IM modality to sufficiently show that it is taught by Rothschild and Chen.

As stated in the Final Written Decision, the insufficiency of explanation applies to both the Rothschild-only and the Rothchild and Chen grounds, because the Rothschild-only ground "still relies upon email formatting and on HTML based on the state of the art as exemplified by Chen." Dec. 35 n. 6 (citing Pet. 32–33). Although the Petition advanced a separate theory that the data of the image itself specifies what's going to be displayed (Pet. 34), the Final Written Decision determined that this theory also relied on HTML implementation.⁵ Consequently, Petitioner's Rothschild and Chen grounds are unpersuasive for the same reasons as the Rothschild-only grounds.

Due to a lack of explanation or supporting evidence, Petitioner has not sufficiently shown that Rothschild teaches generating a hot link having the claimed properties as an instant messaging message. Petitioner has not met its burden to show by a preponderance of the evidence that claim 15 would have been obvious over either Rothschild alone or Rothschild combined with Chen.

⁵ And, as noted by Petitioner, the "dispositive question on remand" does not concern its image data assertions, but "whether the record shows that Rothschild's HTML-formatted interactive advertisements can be sent via IM." Pet. Remand Reply 1.

III. CONCLUSION

For the reasons discussed above and in the originally-issued Final Written Decision (Paper 33), we conclude Petitioner has not shown by a preponderance of the evidence that claim 15 of the '169 patent is unpatentable.

Claim	35 U.S.C. §	Reference(s) / Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
15	103(a)	Rothschild		15
15	103(a)	Rothschild, Chen		15
Overall Outcome				15

IV. ORDER

Accordingly, it is

ORDERED that Petitioner does not establish by a preponderance of evidence that challenged claim 15 is unpatentable; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.⁶

⁶ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner's attention to the April 2019 Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding. *See* 84 Fed. Reg. 16654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent

Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. §§ 42.8(a)(3), (b)(2).

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