

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)
IPR2023-00248 (Patent 7,376,414 B2)

Held: March 7, 2024

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

IPR20 23-00247 (Patent 10,869,169 B2)

IPR2023-00248 (Patent 7,376,414 B2)

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commencing at 9:00 a.m., via video teleconference.

P R O C E E D I N G S

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COURT REPORTER: We will now go on record with IPR number 2023-00247, and IPR number 2023-00248.

JUDGE CYGAN: Good afternoon. This is Judge Cygan. Judges McMillin and Easthom are also present. We will now hear argument and case number IPR2023-00247 between Petitioner Google LLC, and Patent Owner Wildseed Mobile, concerning U.S. Patent Number 10,869,169. After that argument concludes we'll take a short break before commencing argument in IPR2023-00248. Counsel of the parties can you please introduce yourself starting with Petitioner?

MR. EHMKE: Thank you, Your Honors. This is Andrew Emke. I am lead counsel on behalf of Petitioner Google. Joining me today are Calmann Clements and Raghav Bajaj. Mr. Clements will be presenting on behalf of Google in the proceeding ending 00247.

JUDGE CYGAN: And Patent Owner.

MR. HIGGINS: Hi, I'm Zack Higgins with Kramer Alberti, and with me is David Alberti who is lead counsel. I'll be presenting for the hot link '169 Patent and David Alberti will be presenting for the Ad '414 Patent.

JUDGE CYGAN: Thank you and welcome to the Board.

MR. HIGGINS: Thank you.

JUDGE CYGAN: Per our order dated January 30th of this year, each party is provided with 60 minutes of oral argument. The parties

1 need not use the entirety of that time. Petitioner will argue first and may
2 reserve time for rebuttal. Patent Owner will respond to Petitioner's argument
3 and may reserve time for sur-rebuttal. We have the demonstratives from
4 each party. Please remember to identify yourselves when speaking, and
5 please mute yourself when not speaking. If you encounter any issues of
6 connectivity, please let us and the hearing staff know as soon as possible.
7 Petitioner, how much time would you like to reserve for rebuttal?

8 MR. CLEMENTS: I'd like to reserve 20 minutes, Your Honor.

9 JUDGE CYGAN: Twenty minutes? Okay. Petitioner, it's 12:02.
10 You may begin.

11 MR. CLEMENTS: Thank you, Your Honors. So, I'll start my
12 presentation today on slide 2. So, the '169 Patent describes and claims
13 sending a hot link through email. Now, what is a hot link? Well, the claims
14 of the '169 Patent define what a hot link is. As highlighted in green here, a
15 hot link that is something that, when activated, causes the user device to
16 perform an action. And one example of an action is to direct the user's
17 device to a webpage. Now, their claims also recite identifying and detecting
18 a trigger to generate a hot link, as shown in yellow. This claimed trigger
19 initiates the process of inserting a hot link into an email message.

20 Turning to slide 3, the process of initiating the insertion of a hot
21 link is illustrated here in the '169 Patent. We have here in Figure 7 a user
22 interface element with a menu that allows a user to select from a number of
23 options. And the selected option then gets placed in an email message in a
24 form the user can interact with and then send to another user. In short, the
25 '169 Patent is directed to a process for creating and sending a message with a

1 link in it.

2 Turning to slide 4, Rothschild, like the '169 Patent, describes a
3 process for sending a message with a link in it. Rothschild describes a pull
4 down menu with a list of interactive advertisements, and when a user selects
5 one of those advertisements, this initiates the process of inserting the
6 interactive advertisement into the email message. And Rothschild's
7 interactive advertisements are a hot link because they direct the recipient's
8 device to a web page. In other words, they perform an action, just like the
9 example of a hot link in the '169 Patent. So turning to slide 5, our first topic
10 of discussion will be that Rothschild teaches identifying a trigger to generate
11 a hot link. Turning to slide 6, we have here a timeline of Rothschild's
12 teachings to show how they match up with what is claimed.

13 And we'll first start with limitation 1.1, which is outlined in the red
14 box here, and recites identify a trigger to generate a hot link. Turning to
15 slide 7, this table summarizes our positions with respect to identify a trigger
16 to generate a hot link. Now, we have broken this limitation up into its
17 individual components, which are what the trigger is, how the trigger is
18 identified, why the trigger generates a hot link, and why Rothschild's
19 interactive advertisement is a hot link.

20 JUDGE CYGAN: Mr. Clements?

21 MR. CLEMENTS: Yes.

22 JUDGE CYGAN: In the Petition, you had, I think, identify two
23 alternative ways in which Rothschild might meet this. Are you focusing
24 solely on one way in your argument today?

25 MR. CLEMENTS: Our argument today will focus on our first

1 position, which is that there's a distinction between identifying the trigger
2 and detecting the trigger. Now, in our Petition, as you noted, Judge Cygan,
3 we did have an alternative position in which -- in case Patent Owner had
4 taken the position that detection of the trigger was referring to identifying
5 the trigger, where we treated those similarly. But they haven't taken that
6 position, and so we're focusing on our first position, which is identifying the
7 trigger is when the server presents the pull down menu to the user and
8 detecting the trigger is when the server receives the user's response or
9 selection.

10 JUDGE CYGAN: And are you no longer pursuing the second one,
11 or is that still something we should consider?

12 MR. CLEMENTS: I wouldn't say we're no longer pursuing it. I
13 would just say that because Patent Owner has not presented that position,
14 I'm not focusing on that. But we still believe that for the reasons we
15 presented in our Petition, that that alternative theory is also one way in
16 which Rothschild renders the claims obvious.

17 JUDGE CYGAN: Thank you.

18 MR. CLEMENTS: So turning to slide 8, a Rothschild server
19 identifies the trigger to the user's device when it provides the sending user's
20 device with an email communication page that contains the pull down. For
21 example, the sending user visits an email website such as Hotmail and is
22 provided with a webpage for creating an email. And that web page includes
23 this pull down menu, and so the server has identified to the user a pull down
24 menu or the trigger.

25 Turning to slide 9, so why is the pull down menu a trigger? Well,

1 when we look to the specification of the '169 Patent for guidance for this
2 term, we see that in one example, as shown here in Figure 7, the user is
3 provided with a menu of items to select from, such as a radio station or a
4 website, and the user selection of an item from this ultimately triggers
5 insertion of a hot link into a message.

6 Turning to slide 10, Rothschild describes something similar. We
7 can see that Rothschild's pull down menu is a similar selection mechanism.
8 The pull down menu allows a user to select from a palette of advertisements,
9 and the user selection ultimately causes the server to generate the hot link as
10 claimed. So Rothschild's pull down menu is a trigger as claimed. Turning
11 to slide 11, so why is the pull down menu a trigger to generate a hot link?
12 Well, when the user selects an advertisement from the pull down menu and
13 submits their selection, this ultimately causes the advertisement to be
14 inserted into the email, and then it is then formatted into something that the
15 user can interact with. In other words, it becomes a hot link at that point. So
16 turning to slide 12, why is this interactive advertisement a hot link?

17 Well, because it meets the definition of a hot link as recited in the
18 claims. In particular, interaction with the interactive advertisement causes
19 an action to be performed. For example, when the receiver of the message
20 opens their email, they'll see this advertisement in the form of an icon, a
21 graphic, or text that is advertising some product. Then the user clicks on
22 that advertisement or interacts with it, and that causes their device to go to a
23 website, just like the example in the '169 Patent. So because Rothschild's
24 pull down menu initiates the process of inserting an interactive
25 advertisement into an email message, which is then formatted to become a

1 hot link, Rothschild teaches a trigger to generate a hot link as claimed.

2 I'm turning to slide 13. Patent Owner has argued that inserting a
3 pre-existing advertisement is not generating a hot link because the
4 advertisement already existed. But Patent Owner's argument here does not
5 address the analysis we presented in the Petition. We're not saying that the
6 hot link is generated when the advertiser initially creates the ad. Instead, as
7 we can see in this timeline, what we have said is that when the server inserts
8 the email into, or the advertisement into the email, it is then formatted as
9 something the user can interact with, and that's when it becomes a hot link.
10 So in summary, Rothschild's server identifies the trigger to generate a hot
11 link when it provides the pull down menu to the user.

12 Turning to slide 14, we move on to the next limitation in the
13 claims, which is detection of the trigger. Turning to slide 15, we have here a
14 timeline graphic where we're referring to limitation 1.2, detection of the
15 trigger.

16 JUDGE EASTHOM: Counsel, going back to -- your friend's slide,
17 the Patent Owner's slide, but I think it's slide 9. So are those -- you're saying
18 those are pre-created content also, just like the advertisements that you rely
19 on in Rothschild?

20 MR. CLEMENTS: That's correct, Your Honor.

21 JUDGE EASTHOM: Okay. Thanks.

22 MR. CLEMENTS: So turning to slide 16, in Rothschild, the
23 trigger is detected when the server receives the user's advertisement
24 selection. For example, after the user submits their selection through the
25 pull down menu, the server receives a compilation of data, which includes

1 that advertisement data. So in other words, the server is receiving indication
2 that the pull down menu has been used. In other words, it has detected the
3 trigger. It has detected the pull down menu.

4 So turning to slide 17, and as we discussed earlier based on Judge
5 Cygan's question, Patent Owner has argued that the Petition points to the
6 same thing for identifying and detecting the trigger, but we have our main
7 position where we have identified two separate teachings for this limitation.
8 Again, Rothschild identifies the trigger by providing the pull down menu to
9 the user's device. The server detects that the trigger has been used when the
10 server receives the user's advertisement selection.

11 So turning to slide 18, we move on to the next claim limitation,
12 determining an action. So turning to slide 19, Rothschild teaches that in
13 response to receiving the user's advertisement selection or detection of the
14 trigger, the server determines what action will be performed upon activation
15 of the hot link. Now, this claim limitation does not affirmatively recite
16 performing that action. Instead, it recites determining what action will be
17 performed when the user, at some point in the future, activates that hot link.
18 So again, we have a table here that breaks this limitation up into its
19 individual components. The table summarizes how we determine the action
20 will be performed in the future, what that action actually is, and then when
21 that action is actually performed.

22 So turning to slide 20, we have here again our timeline graphic for
23 this limitation. Turning to slide 21, so what is the action? Well, the action
24 to be performed here is directing the user's device to a website identified by
25 the URL that's in the advertisement. So when the user receives an email and

1 they see the graphic or text that makes up the advertisement and they interact
2 with it, this will cause the user's device to be directed to the website
3 identified by the URL. That is the action that is performed when the user
4 activates the hot link.

5 Turning to slide 22, so how is this action determined? Well,
6 Rothschild's server determines what action is going to be performed when it
7 places that selected interactive advertisement along with its embedded URL
8 into the email message. So the server has many different interactive
9 advertisements available to it, but when it places the user selected
10 advertisement into the email, it is determining what action will be
11 performed. Now, Patent Owner's argument here is similar to the argument
12 they made for the previous limitation we discussed that they've said that the
13 action has already been determined when the ad was created. But again,
14 we're not relying on the creation of the ad for determining the action.
15 Instead, what we're saying here is that when the server inserts the ad, that is
16 determining what action will be performed when the user interacts with the
17 ad.

18 JUDGE CYGAN: So Mr. Clements, is the thrust of your argument
19 that the user is provided with a number of possible triggers, and those have
20 been identified by the server when the server sends the drop down menu.
21 So, the user gets possible triggers. The user selects one, and that's sent back
22 to the server. And then by that choice of the user, that's how the action to be
23 performed is selected, because there will be a number of different ads, each
24 of those ads has a different URL associated with it, or a different sort of
25 application associated with it and location. And based upon that choice,

1 that's how the action to be performed upon activation of the hot link is
2 determined.

3 MR. CLEMENTS: That is correct, Your Honor. The server
4 determines what action will be performed by placing the user selected ad
5 into the email message. We don't think that the claims were intended to
6 cover the case where the server itself chooses which ad will be put in or
7 which hot link is put in. The fact that there's some user selection, I don't
8 think, means that the server still has to determine what action will be
9 performed. And it does so by taking the user selection and placing that
10 selected advertisement into the email message.

11 JUDGE CYGAN: So, in the way that you read the claim, it's not
12 required that there be a hot link in which the contours of that hot link is later
13 determined. In the way you're reading the claim, there's a number of
14 different possible hot links. Each of those associated with its own actions.

15 MR. CLEMENTS: That sounds correct, Your Honor.

16 JUDGE CYGAN: Thank you.

17 MR. CLEMENTS: So turning to slide 23, ultimately when the
18 recipient interacts with the advertisement or activates the hot link, that is
19 when the action is actually performed, which is to cause the user's device to
20 be directed to the website identified in the advertisement. So in summary,
21 Rothschild's server determines the action to be performed when it places the
22 user selected advertisement into the email message.

23 So turning to slide 24, we move on to our next topic, which is
24 generating a hot link message. Turning to slide 25, we have here our
25 timeline graphic for this limitation.

1 JUDGE EASTHOM: Counsel, can I ask you another question? It
2 seems like, and I might be wrong about this, but I thought you said aren't
3 you relying on the same step for the generate the hot link and also determine
4 an action to be performed because I thought you said for the generate you
5 were talking about the server selecting a particular ad to put in the message,
6 and you said the same thing for the determining action to be performed.

7 MR. CLEMENTS: So, yeah. So, there's two ways or two main
8 points I want to make to answer your question, Judge Easthom. First is that
9 in that earlier limitation where it says identify a trigger to generate a hot link,
10 it's not affirmatively reciting generating the hot link, it's just something
11 saying we have to identify a trigger to generate the hot link. The second
12 point I'll make is that there is a distinction between generating the hot link
13 and generating the hot link message because what Rothschild teaches, and as
14 we see here in slide 26, the quote we have, that at step 516, the message
15 data, which includes the selected advertisement, is formatted into a standard
16 email format. So, Rothschild is saying we're doing two things here.

17 We're formatting the message and we're formatting the
18 advertisement. So, the formatting of the advertisement into something that
19 becomes a hot link, that is what we're pointing to for when the hot link is
20 generated. The whole package itself, the message, you know, the destination
21 addresses, the content of the message, that's all generation of the hot link
22 message. And I'll note that when Rothschild said formatting, it's not simply
23 bolding text or changing font size. What it's doing is it's compiling all this
24 data that it got from the user and putting it into something that resembles an
25 email message and putting it into something, the hot link into something that

1 the user can interact with. Does that answer your question?

2 JUDGE CYGAN: Judge Easthom, you're muted.

3 JUDGE EASTHOM: Sorry about that, I'm going to think about
4 that. Thank you. Yeah, that answers my question for now. Thank you.

5 MR. CLEMENTS: Thank you.

6 JUDGE CYGAN: Mr. Clements, if I can follow up on that. You
7 mentioned that the identify step doesn't affirmatively recite generating the
8 hot link. If we're reading that limitation that way, how do we understand the
9 next limitation which assumes the hot link is already there? The next
10 limitation says, determine an action to be performed upon activation of the
11 hot link. How should we understand that?

12 MR. CLEMENTS: When it says there, so let me go back to that
13 claim limitation. When it says determine in response to detection of the
14 trigger, determine an action to be performed upon activation of the hot link.
15 But what it's talking about is something that happens in the future. So we're
16 going to determine the action that happens eventually in the future when the
17 user has that link and clicks on it. Now, in that first step of identifying a
18 trigger to generate a hot link, while it's not affirmatively reciting the act of
19 generating a hot link, we've still explained in our Petition that the hot link
20 does get generated, but it gets generated later on. In other words, there's no
21 timing limitation in the claim as to when that hot link becomes generated.
22 So what we're talking about in this first step of identifying a trigger to
23 generate a hot link, all we're doing here is identifying a trigger. That's the
24 only thing we have to do. There's no timing limitation as to when that hot
25 link must be generated.

1 JUDGE CYGAN: Can you help me understand? If the hot link
2 has not been generated, has not been generated yet in the step in which the
3 action is being determined, how does that square with, I guess, your
4 interpretation of Rothschild, where the hot link already has the action
5 associated with it?

6 MR. CLEMENTS: So I wouldn't say that the action already has
7 the -- I mean, so in Rothschild there is a URL, but the URL by itself is not
8 the action. The action is going to the website when the user clicks on it. So
9 when we have this step here of determine an action to be performed on
10 activation of the hot link, it's written a little weirdly because it's saying we're
11 going to determine an action now, but that action will happen in the future
12 when the user clicks on the link. And so all we're determining at the step
13 here of in response to detection of the trigger, we're determining what action
14 will be performed, which we do by placing the selected advertisement into
15 the message. Does that help answer your question?

16 JUDGE CYGAN: So I'm just trying to make sure I understand. If
17 in -- if in that determining step you have -- the action is being determined
18 based upon which of the selections was performed of the different drop
19 down options. But that -- those hot links seem to have been already --
20 already done. They don't seem to be future hot links. They seem to be sort
21 of prior hot links, which have already been, I guess, fully fleshed out. And
22 the determining is the selection of those. I thought I understood you to say
23 earlier -- I'm trying to understand how your comment that those would be --
24 hot links would be, I guess, generated in the future.

25 MR. CLEMENTS: So I guess I think to be a little bit more

1 precise, we have all these advertisements that Rothschild has. They're not
2 quite hot links yet because they haven't been put into a form that, when
3 activated, causes them to perform a link. If we think about these
4 advertisements as they're stored on the server, they are just raw data. It's just
5 data that represents the picture, it's data that represents the URL location, but
6 it's not yet something that we think of when we're presented with an email
7 and there's like a hyperlink that we can click on. So the advertisements,
8 yeah, we kind of say that these will eventually become hot links, but they
9 become the hot link when they're formatted and put into the email.

10 JUDGE CYGAN: What about the formatting into the email turns
11 them into a hot link if they already have embedded URLs in them?

12 MR. CLEMENTS: So the embedded URL the way I'm rethinking
13 about that is that the URL itself is just -- it's just text that indicates a
14 location. It's not a hyperlink yet. It's not yet something that the user can
15 interact with when they when they click on it. It's just text that has a
16 location and when we look at the '169 Patent, we believe that's similar to
17 what the '169 Patent describes. In that list of options you have a list of
18 things such as a website, so it puts the website. I don't think that -- I mean
19 that website is already a URL. I don't think that the -- the URL gets chosen
20 when the hot link is generated. I think that there's already a website
21 that's associated with that option there that ultimately becomes a hot link.
22 And in the Rothschild it's similar to that. There's an advertisement. It's got a
23 location, but it's not yet in a form that when the user interacts with it causes
24 it to go to -- it causes their device to go to a website. So that's why we say
25 that this formatting it into standard email format is what turns it into a hot

1 link.

2 JUDGE CYGAN: So really you're pointing to the generating stuff
3 is performing not just the generation of the message containing a hot link,
4 but the generating of a hot link message which in itself is generating the hot
5 link?

6 MR. CLEMENTS: I believe that's right. What Rothschild teaches
7 that you're formatting everything, this whole package. It has message data,
8 the recipients of the message, and that all becomes generation of the hot link
9 message. But you're also formatting the advertisement within, and that's
10 what generation of the hot link is. That's when the hot link actually gets
11 generated. And that was ultimately triggered, or initiated, when the user
12 made a selection from the pull down menu.

13 JUDGE CYGAN: Thank you. And just to wrap up, are you
14 saying that first step, identify a trigger to generate a hot link? And the way I
15 think you're saying it now is that you're just saying, as soon as the server
16 presents that menu, that's enough to meet that step, right?

17 MR. CLEMENTS: That's correct, Your Honor. When the user
18 goes to the web page and they're provided with this page that has the pull
19 down menu, the trigger has been identified to the user. And that's what I
20 think --

21 JUDGE CYGAN: We want to generate one of those hot links
22 sometime in the future.

23 MR. CLEMENTS: That's correct.

24 JUDGE CYGAN: Gotcha. Okay. Thank you.

25 MR. CLEMENTS: So turning to slide 27, we move on to our next

1 topic, which is instructions for rendering and displaying the hot link. So
2 turning to slide 28, the claims recite that the hot link message includes
3 instructions for rendering and displaying the hot link. So what are the
4 instructions for rendering or displaying the hot link? Well, the Petition
5 provided two examples of that. And so in one example, it could be the
6 HTML code that provides instructions for displaying that on the user's
7 device. And another example we provided is that the image file, such as a
8 JPEG or GIF, that makes up the advertisement is instructions for rendering
9 and displaying the hot link.

10 So turning to slide 29, in one example, a POSITA would have
11 found it obvious to implement email with interactive advertisements using
12 HTML. And when doing so, the HTML tags are just one example of
13 instructions for rendering and displaying the hot link. And given that
14 Rothschild describes a browser-based email application, such as Hotmail, to
15 insert interactive advertisements with embedded URLs, it would have been
16 obvious to implement such browser-based email applications in HTML.

17 So turning to slide 30, the evidence of record shows the
18 obviousness of implementing email advertisements in HTML. The Chen
19 reference describes implementing email advertisements with HTML, and
20 these advertisements may even include HTML links, just like Rothschild's
21 embedded URLs. And even Patent Owner's own evidence shows that
22 Microsoft encourages using HTML format. So the evidence of record shows
23 that a POSITA looking at the teachings of Rothschild would have found it
24 obvious to implement those teachings using HTML.

25 Turning to slide --

1 JUDGE CYGAN: Counsel --

2 JUDGE CYGAN: At the bottom of that slide, in the Outlook
3 example, it states that the message keeps its formatting. Is there anything
4 you can point to -- to show that the functionality of the advertisement is
5 changing once it's being formatted in the way that you're suggesting? So
6 that it becomes a hot link through the formatting, as opposed to already
7 containing something which we would understand to be a hot link?

8 MR. CLEMENTS: The way I think about that, Your Honor, is that
9 when the advertisement is just the raw data and it's got the text, it's not
10 something that can click on. We're all familiar with the point where, you
11 know, you're typing in a text of URL and it's just text, but at some point the
12 system recognizes it as a hyperlink. It recognizes it as something that the
13 user can click on and interact with. We think that when the interactive
14 advertisement is just stored as raw data, it's not yet something that is being
15 generated, or it's not yet something that the user can interact with. But when
16 it's all formatted in that email, it becomes something the user can interact
17 with.

18 And to be clear, the process of generating the hot link is a different
19 thing than what we have here. It's the instructions for rendering and
20 displaying the hot link. And so what we're relying on for the instructions
21 and for the instructions for rendering and displaying the hot link, is in one
22 example, HTML, but we're not relying on the HTML for generating the hot
23 link.

24 JUDGE CYGAN: And are the instructions for rendering and
25 displaying that you're showing in, for example, slide 31, those just have to

1 do with the placement of the hot link in the email message and not with the
2 formatting that allows it to be clicked on?

3 MR. CLEMENTS: Yes. This is a separate thing from the
4 formatting and the generating step. This is just -- in slide 31, this is an
5 example our expert gave based on the HTML specification and the RFC
6 standard of what the HTML code in the email message might look like for
7 rendering and displaying the hot link.

8 JUDGE CYGAN: And for the instructions, you're relying upon
9 either the knowledge in the art as, you know, demonstrated by, I believe it's
10 Chen, or on Chen itself, is that correct?

11 MR. CLEMENTS: Yeah, so we do have some additional grounds
12 where we did an official combination of Chen. So, excuse me, the
13 background knowledge of a POSITA that would recognize HTML as
14 obvious, or Chen itself that shows evidence of the obviousness. And again,
15 the HTML tags are just one example of how you can render and display the
16 hot link. There are other ways in which Rothschild teaches instructions for
17 rendering and displaying. And that is, if we move on to slide 32, in our
18 second example, the data representing the icon or graphics, such as the JPEG
19 file, that provides instructions for rendering or displaying the hot link.

20 So either of these two things shows the obviousness of having the
21 message include instructions for displaying the hot link. And this makes
22 sense because clearly the user receives an email and they're seeing this
23 advertisement. They see the graphic of the text. So there has to be some
24 mechanism by which the receiving user's system is displaying that or it has
25 instructions for displaying it. And so that can either be done with HTML

1 tags, or it can be done with the image file. Both of them are instructions for
2 rendering and displaying a hot link. Does that answer your question?

3 JUDGE CYGAN: Yes.

4 MR. CLEMENTS: So turning to slide 33, much of Patent Owner's
5 response focuses on this argument that HTML is not compatible with emails
6 in rich text format, and Patent Owner bases this argument on the specific
7 text within Rothschild's figure which includes rich text in the window
8 banner. But nowhere does the specification of Rothschild limit Rothschild's
9 emails to rich text format. So Patent Owner's arguments here don't address
10 the obviousness analysis we presented in the Petition. The Petition does not
11 rely on Rothschild's rich text format example. Rather, the Petition relies on
12 the obviousness of using HTML emails to implement email advertisements.

13 And Patent Owner seems to take the position that because
14 Rothschild's figure says rich text, a POSITA would not possibly look to any
15 known technique for implementing emails but would instead myopically
16 focus only on rich text email format. But the law of obviousness allows us
17 to take into account the inferences and creative steps a POSITA would
18 employ. So in other words, a POSITA is not an automaton. Therefore, a
19 POSITA would not look to Rothschild, which only mentions rich text in this
20 figure here, not at all throughout the specification. They would not assume
21 that Rothschild's emails, especially web-based ones like Hotmail, can only
22 use rich text format.

23 Turning to slide 34, Patent Owner also argues that Rothschild does
24 not teach presenting the advertisement in line with the message, but instead
25 discloses only attaching an interactive advertisement. But this argument is

1 problematic for two reasons. First, nothing in the claim specifies whether
2 the hotlink has to be presented in line or as an attachment. So whether the
3 email message is attached outside the body or presented in line, it is still a
4 graphic icon or text that can be interacted with and causes the user's device
5 to perform an action or go to a website.

6 So it is still a hot link as claimed. Second, we don't agree with
7 Patent Owner's characterization. Rothschild describes attaching files and
8 inserting advertisements differently. And Rothschild includes two separate
9 buttons, one for attaching files and one for inserting advertisements. So a
10 POSITA would not assume that inserting advertisements was the same thing
11 as attaching a file. So in short, Rothschild's interactive advertisements teach
12 a hot link as claimed, regardless of how these advertisements are presented.

13 JUDGE CYGAN: Mr. Clements, one question on that. If the
14 advertisement is being attached in line, it doesn't seem like there's any
15 additional formatting that's being done to cause that to be turned into a hot
16 link at that point. It seems as if the advertisement itself is just data, as you
17 had mentioned earlier, not a hot link, then appending it in line doesn't seem
18 to really do anything to it.

19 MR. CLEMENTS: By appending it in line, do you mean attaching
20 it rather than presenting it in the body?

21 JUDGE CYGAN: That's right.

22 MR. CLEMENTS: Okay. So we believe that when Rothschild
23 says that it's formatting everything, including the advertisement data, which
24 is what Rothschild said, that we believe that that's putting it into a format
25 that makes it something the user can interact with. And we know this

1 because Rothschild does mention that when the user receives it, they can
2 click on it and interact with it. And that causes their device to go to the
3 website. So at some point, it was changed from raw data on a server and
4 formatted into something the user can interact with, whether it's attached or
5 presented in line. We don't think that matters. The attachment would still
6 have to be formatted into something that the user can interact with, so that
7 when they open that attachment and they click on it, it becomes a hot link.

8 JUDGE CYGAN: I'm not sure I understand that. I see on slide 31
9 with your instructions for rendering and displaying, you have something
10 which says, look, this reference is a URL that's going to follow, which does
11 seem to, although it's included in your rendering and displaying step, which
12 is not, but really with the appending of a file that has data in it. I'm not sure
13 that I have seen anything on the record that tells me that appending that file
14 simply in line has done anything to it to change that file into a hot link, to
15 really change its character from what that data was when it was being stored
16 as an advertisement and having that data being appended onto a file, I'm not
17 sure that I understand how it's being changed, how the nature of it is being
18 changed into a hot link.

19 MR. CLEMENTS: So, we would again just rely on what
20 Rothschild teaches is that formatting step. Now again, our Petition didn't
21 present the case where we were attaching it, we presented the case where it
22 would be obvious to put it in line. And so, our point in response to Patent
23 Owner's argument is that really it doesn't matter, we think it can be done
24 either way. But the point we relied primarily on in our Petition is this point
25 here, and if you're talking about, again, I want to be sure we're distinguishing

1 between generating a hot link versus having instructions for rendering and
2 displaying it. If we're looking at the attachment example, we believe it's still
3 generated when Rothschild describes this formatting step of the
4 advertisement data, and we know that it then becomes a hot link because the
5 user interacts with it when they receive it. And in the attachment example,
6 there's still instructions for rendering and displaying it because, again, one
7 example we gave is the JPEG file or the image file or the ones and zeros that
8 tell the receiving device what to display are instructions for rendering a hot
9 link. So we think that in either case, Rothschild renders it obvious, but I
10 would just point to what we said in our Petition is that it'd be obvious for it
11 to be presented in the message. And we think Rothschild describes that the
12 user can view it within the email. That suggests to a POSITA that you're
13 looking at it in the email, not just as an attachment. And again, we have
14 separate buttons for attaching files than we do for inserting advertisements.
15 So we think that suggests that the advertisement is inserted into the message
16 body, not just as an attachment.

17 JUDGE CYGAN: And for that formatting, you're looking at your
18 slide 26, correct? That's the support in Rothschild that you're pointing to?

19 MR. CLEMENTS: That's correct.

20 JUDGE CYGAN: Is there anything in Rothschild that you
21 particularly like to highlight in your briefs that talks about the nature of it
22 being changed to something which we would understand from being raw
23 data to being something which is now happening?

24 MR. CLEMENTS: I would say that what we pointed to in our
25 Petition, and then that text there, is the main point of what we're relying on,

1 as well as our expert's testimony that a POSITA would have understood that
2 to be putting it into a format that a user can interact with.

3 JUDGE CYGAN: Thank you.

4 MR. CLEMENTS: So turning to slide 35, Rothschild also teaches
5 various limitations from the dependent claims. So turning to slide 36, Claim
6 6 recites assignment information to assign the hot link to the user element,
7 user interface element. So as shown in the bottom quote, the data in the
8 email message that associates a graphic to the advertisement is assignment
9 information. And one example we gave in our Petition of that kind of
10 assignment information might be specific lines in the HTML code.

11 Turning to slide 37, Claims 8 and 16 recite this concept of
12 determining a location for each user device. And I don't think it's disputed
13 that a location can be an email address. What Patent Owner's argument here
14 seems to be is that because the user provides the destination address, the
15 server does not determine that destination address. But the claims don't
16 recite any sort of negative limitation that would exclude the server receiving
17 a destination address from the user. And surely the server has to receive the
18 user's intended destination address at some point. Because I don't think that
19 this claim is intended to cover that the server chooses who to send the
20 advertisement to. But what we're saying is by receiving the destination
21 email address from the sender, the server determines where to send the email
22 message using that user provided destination address.

23 Turning to slide 38, Claim 11 recites, among other things, identify
24 a user interface element for activation of the hot link part of generation of
25 the hot link. Rothschild's interactive advertisement is presented as an icon,

1 graphic or text can be interacted with. And that icon, graphic or text is a
2 user interface element for activation of the hot link.

3 Turning to slide 39, a POSITA would have found it obvious for
4 email to include positive and negative feedback buttons, such as thumbs up
5 or thumbs down symbols. The Petition relies on the Maes reference to show
6 that such feedback mechanisms were known, and it would have been
7 obvious for the interactive email systems of Rothschild to include such
8 feedback mechanisms. Now Patent Owner attacks this ground by arguing
9 that the Petition did not explain how it would work, but the details of how a
10 POSITA would implement these feedback mechanisms are not claimed, so
11 there is no need for the Petition to provide an analysis of such unclaimed
12 implementation details. What the Petition does do is explain how feedback
13 mechanisms for advertisements were known, and it would have been
14 obvious for a Rothschild system to include such feedback mechanisms.
15 Indeed, the prior art of records says that feedback mechanisms for
16 advertisements are preferably in the form of thumbs up or thumbs down. So
17 accordingly, the site of the prior art teaches positive and negative feedback
18 buttons as claimed.

19 So turning to slide 40, in summary, for the reasons I've discussed
20 today, Rothschild's insertion of interactive advertisements into email
21 messages renders obvious the claimed concept of sending a hot link through
22 email. Rothschild's interactive advertisements are a hot link as claimed
23 because when interacted with, they cause the recipient's device to perform an
24 action such as going to a web page. And Rothschild's pull down menu is a
25 trigger that kicks off the process of inserting a hot link into a message,

1 consistent with the example of the '169 Patent. And a POSITA would have
2 found it obvious for Rothschild's interactive advertisements to include
3 instructions for displaying the hot link, either in the form of HTML tags or
4 the JPEG file. And Patent Owner's arguments do not refute the obviousness
5 analysis presented in the Petition.

6 So if there are no further questions, Your Honor, I will yield my
7 remaining time for rebuttal.

8 JUDGE CYGAN: Thank you, counselor. You will have 21
9 minutes left for rebuttal. Patent Owner, how much time would you like to
10 reserve for a sur-rebuttal?

11 MR. HIGGINS: 15 minutes, please.

12 JUDGE CYGAN: Okay. You may begin.

13 MR. HIGGINS: Thank you, Your Honors. So Petitioner and its
14 expert misunderstood the main reference in this proceeding, Rothschild, and
15 that has numerous impacts on its original hypothesis about how Rothschild
16 could work with HTML. And today we heard a combination of their old
17 argument that they presented in the Petition, new arguments that they put in
18 the reply, and then some additional flavors that we haven't seen before
19 today. It all stems from their initial misunderstanding of the reference. I
20 want to focus on three impacts of the misunderstanding, and I'm happy to
21 discuss others as well. But I think focusing on the most important three will
22 shed a lot of light on some of the questions that Your Honors were asking
23 today and provides a good high level framework for thinking about this
24 issue.

25 So if we could first direct you to our slide number 7. The first

1 misunderstanding that Petitioner and its expert had and that's reflected in the
2 Petition is they fail to realize that in Rothschild, all the interactive ads are
3 pre-existing. And Your Honors ask questions today that are directed to
4 exactly this point. The ads in Rothschild our expert explained, and there's
5 no rebuttal and it's now admitted as shown in this slide number 7. All the
6 ads in Rothschild are created by the advertiser before anything that the
7 Petition refers to happens. So these are all pre-existing files that have the
8 URL already baked into them. And a lot flows from that key fact and we'll
9 get into the impacts of that.

10 Turning to the next slide, 8 in our deck. The interactive ad is the
11 hot link and we heard that reaffirmed today with some flavoring of, well, of
12 how the interactive ad is used or when it's activated, et cetera. But we just
13 want to make it clear that when we're talking about the claim language,
14 generate a hot link, in the Petition's language, that means creating an
15 interactive ad. Now, because the Petitioner now understands that the ads are
16 all pre-existing, they have changed the way they approach Rothschild, and
17 you heard some of that earlier today. They're relying in the Petition, they
18 relied on using HTML tags to create something that didn't exist before,
19 which was to take the raw data like a URL and a JPEG, put that, wrap that in
20 an HTML tag, and put that HTML tag into the body of an email message
21 and thereby generate a hot link. That was the original idea.

22 Petitioner continues to rely on the formatting step, saying that
23 formatting somehow does something to the ad. And as Your Honor already
24 identified, that's just not true. In fact, you don't need to take my word for it.
25 Our expert, Dr. Malek, explained in his declaration, as you can see here on

1 slide 9, the fact that there is no email format for ads. The formatting step in
2 Rothschild doesn't touch the ad. So that's just flat out wrong. And when we
3 look at the record, there's no rebuttal to our expert's testimony on this point.
4 Instead, Petitioner says, well, we're not relying on the initial creation, and
5 they try to back away from what they originally said generate means and
6 they have a different construction.

7 So just to make it crystal clear, because this did come up in Your
8 Honors' questioning already, the formatting step does not touch the ad. The
9 ad in Rothschild is pre-existing. The URL is already baked into the ad
10 embedded in there. And formatting does nothing to the ad. Turning to
11 our -- oh.

12 JUDGE EASTHOM: Yeah. I'm just having a hard time figuring
13 out what part of the claim requires or preclude -- I'm sorry, whether -- why
14 does it preclude it from already being baked in? In other words, if the server
15 stores this ad and you say the URL is already baked into it, what steps
16 precludes that?

17 MR. HIGGINS: Yeah, so this has an effect on two of the claim
18 language pieces. One is generating a hot link because we can all agree that
19 at the end of the process, whatever it is, we disagree about the process. But
20 at the end, what we have is an ad (INDISCERNIBLE).

21 JUDGE EASTHOM: Mr. Higgins, Mr. Higgins, help me out. I'm
22 sorry, I'm not as familiar with the claim. When you say generate a hot link,
23 do you mean where it says it in the first step to identify a trigger to generate
24 a hot link? Or do you mean the last part?

25 MR. HIGGINS: I'm sorry. Yes, Your Honor. Let's be -- let's -- on

1 slide 5 of our presentation, we've quoted Claim 1, which could be helpful
2 here, because I agree with you. Sorry. So we can start with the language
3 that's highlighted here, identify a trigger to generate a hot link. And as you
4 heard today, now there's some disagreement about when the hot link is
5 generated, et cetera, what that means. But what we're talking about here,
6 what I'm referring to and trying to answer your question is this first clause,
7 identify a trigger to generate a hot link. That has multiple pieces in it. There
8 is the hot link, which is the interactive ad.

9 There's the generation of the hot link, meaning creation of it,
10 although that's now disputed. Petitioner now asserts that generate could
11 mean insert, but I'll put that aside for a moment. There's the trigger to
12 generate a hot link. So something has to be a trigger to generate the hot link.
13 And then there's the identification of the trigger to generate the hot link.
14 When we talk about the importance of the URL being baked into the ad
15 already, that has an impact on generate a hot link in that first clause. It also
16 has an impact on determining action to be performed upon activation of the
17 hot link, which is also highlighted on slide 5.

18 JUDGE EASTHOM: I still don't understand why, you know, your
19 friends showing about the -- just presenting the menu itself as a trigger, is
20 identifying a trigger to generate a hot link because they're saying the trigger
21 is the menu, and then that allows you to generate a hot link sometime in the
22 future. Why do you have -- what is your argument about whether it's
23 already baked -- URLs already baked into this advertisement and the server
24 have anything to do with knowing that limitation isn't met?

25 MR. HIGGINS: It's relevant under both constructions of generate,

1 or both interpretations of generate. So let's take the correct meaning of
2 generate, which is to create. When we're talking about creating a hot link --
3 we're talking about creating an interactive ad. So --

4 JUDGE EASTHOM: Yeah, but that's -- with all due respect that's
5 not -- it's not addressing the language in the first step. We're talking about
6 the first step to generate the hot link. That I think your friend's argument is
7 that's a step for the future. That's something that's not necessarily have to
8 occur yet. So --

9 MR. HIGGINS: Right.

10 JUDGE EASTHOM: Okay.

11 MR. HIGGINS: That's what they're arguing that -- if we just
12 take -- I want to try to break it down into the simpler parts so I can identify
13 what precisely we're saying matters about the URL. So there's a trigger to
14 generate a hot link. So what that means is you're creating a hot link, you're
15 creating an interactive ad. The interactive ad that winds up being created
16 has a URL in it. Now the way the claim -- what the claim requires is that
17 something doesn't exist before, and later there's an interactive ad or hot link
18 that exists. And that interactive ad can be --

19 JUDGE EASTHOM: Well, let me give you a hypothetical. What
20 if I say, identify a trigger to shoot a bullet, and the bullet's already in the
21 chamber, right? It doesn't mean you have to go out and make a bullet and
22 put it in the chamber.

23 MR. HIGGINS: Mm-hmm. True. But if it said a trigger to
24 generate a bullet, you would need to create a bullet.

25 JUDGE EASTHOM: Well, no, the bullet could already be in the

1 chamber.

2 MR. HIGGINS: Now, the meaning of generate is to create. So we
3 may be talking about two different things here, Your Honor. I'm not sure.
4 There's two disputes that are important here. One is about what does
5 generate mean.

6 JUDGE EASTHOM: All right. Okay, you're right. I'm sorry. Let
7 me change my hypo if you will. Identify a trigger to generate shooting a
8 bullet. Did we lose sound or?

9 MR. HIGGINS: No, I wasn't sure if you were finished or not.

10 JUDGE EASTHOM: I'm sorry. I'm sorry. Yeah, I changed the
11 hypothetical. I'm sorry. I was saying, what if we just said the hypo is what
12 I just said.

13 MR. HIGGINS: Oh, sure. Yeah, so if you have to generate a hot
14 link, in our view, that means you need to create a hot link. In the Petition's
15 theory that is creating an interactive advertisement. That interactive
16 advertisement, in order for it to be a hot link -- or the reason why the
17 interactive advertisement is a hot link is because it has a URL in it. So if
18 you have to create the hot link, if you have to create the interactive ad, which
19 we maintain is the right way to read the claim, then you need to create
20 something that didn't exist before. And in our slide, we have a slide directed
21 to this point about what does generate mean. And that is slide 13 talks a lot
22 about what generate means and why we're saying generate means to create.
23 So --

24 JUDGE CYGAN: Counsel, if I can redirect you for a moment
25 because I've seen your slide 13 and it does talk about it a bit in the abstract.

1 It might be useful for us to looking at slide 5 for you to identify how the
2 Patent is doing this. Is there a specific embodiment in the Patent you'd like
3 to discuss how it identifies a trigger and where the hot link is generated
4 relative to that?

5 MR. HIGGINS: Certainly, Your Honor. So there's -- let's see. I'm
6 happy to get into more detail about some examples in the specification.
7 Maybe to keep the discussion focused, we could even talk about Figure 7 of
8 the -- which is the figure that the Petitioner has cited, just so we can focus in
9 on things that we've already been talking about today. But if we -- what the
10 Patent talks about is there is, let me see. On Figure 7, that's shown in our
11 slide 14. We would potentially -- we could start here, and if you'd like to
12 discuss more, we certainly can discuss more. But in our slide 7, we're
13 responding to the Petitioner citing Figure 7 of the Patent, and they're making
14 the point that in Figure 7 of the Patent, there's pre-existing content, there's
15 pre-created content. And they're trying to make the argument that the pre-
16 created content is analogous to the pre-created ads of Rothschild. There is a
17 critical difference between the two, however.

18 So, to Your Honor's point, in the hot link Patent, there is content
19 that exists before, and the hot link Patent describes creating hyperlinks or
20 creating hot links, which aren't necessarily URLs, but certainly URL is an
21 example. And it's creating links that point to pre-existing content, and
22 there's no surprise there. It would be normal for a link to something to point
23 to something that already exists. The link itself, however, is created. So,
24 even in the hot link Patent specification quoted here on slide 14, there are
25 actions shown in this hot link item 710, shown in Figure 10 -- sorry, shown

1 in Figure 7. Those are actions that can be used to generate a hot link,
2 meaning a hot link that is to be created can point to this pre-existing content.
3 And as we also say, there's actions to be associated, meaning in the future,
4 that'll be associated with the hot link. But the hot link Patent --

5 JUDGE CYGAN: Counsel. Sorry to interrupt you, but just before
6 we go too far, on Figure 7, you're looking at 720, which is sort of the
7 preference information as being the trigger. So, in this 710 system of
8 selecting the trigger, the identifying the trigger is represented by box 720,
9 and then that is what's going to be used to generate, to figure out what the
10 trigger is to generate the hot link. Is that correct, or am I reading that
11 incorrectly?

12 MR. HIGGINS: No, I wouldn't say that, Your Honor. I don't think
13 this Patent specifically says that 720 is the trigger. I'm more pointing to this
14 for the point that Figure 7 shows an example of using pre-existing content
15 and then creating links that are associated with that pre-existing content, but
16 the links themselves are created.

17 JUDGE CYGAN: I understand that, counsel, but I think what
18 Judge Easthom and myself are trying to focus on is the limitation of
19 identifying a trigger to generate a hot link, and how that relates to the
20 requirement to generate a hot link, whether that comes afterwards, how is
21 that related to it. In your patent, you talk about the system can automatically
22 recognize a certain trigger, not a trigger assist, but recognize that if there
23 was, I think, a 7 out of 10 preference on something, then that's when they
24 should generate a hot link, or if the user presses a button, they should
25 generate a hot link. Are those the situations you're identifying as triggers?

1 MR. HIGGINS: Yes, Your Honor. So yes, there's some need
2 identified to create a hot link that did not exist before.

3 JUDGE CYGAN: And in both those situations from the Patent,
4 and maybe you can point something out, which I'm not seeing, both of those
5 really are talking about, here's how we identify what the trigger will be. It
6 doesn't really say whether or not the hot link is going to be generated at that
7 point or what the contours of the hot link are going to be. I think that's what
8 you're pointing to in Figure 7, but I think what we're concerned with is isn't
9 this step just identifying what that trigger is going to be, whether it's a button
10 press, whether it's a preference, whether it's some other way of determining
11 what that trigger is going to be?

12 MR. HIGGINS: Well, the Patent does describe generating the
13 actual links. So the link would have associated with it some action or
14 content, for example, as pre-created content. So I'm not exactly sure if we're
15 speaking the same language here, but the claim language of a trigger is
16 basically there's some reason why a hot link is going to be created. And we
17 focused in on our reasoning on the creation of a hot link portion, and the
18 Petition relies on using HTML tags for that. So we've been laser focused on
19 when because the hot link already exists, it's not created. And there's no
20 trigger to create one either because it already exists. So I'm not sure if that
21 helps you, but we could also look at examples in the Patent specification, if
22 you like, of what are examples of hot links or, you know, how -- what are
23 created. But at the end of the day, in the hot link Patent, there's a message
24 that's created and it has a hot link in it. I think everyone agrees on that.
25 And --

1 JUDGE CYGAN: Well, I think the key -- I'm sorry to interrupt
2 again. I think the key distinction we're trying to drill down on is when in the
3 claim that happens. Does it happen when the hot link message is generated?
4 I think that you're pointing in your slide 14, you look at the hot link action
5 selection system, that seems to really correspond to the determine and action
6 to be performed upon activation of the hot link. Is that what you're saying?
7 But as you're saying here, that's still not generating the hot link at that point
8 because you need more than this sort of mere data, I think is your argument,
9 right? So where in the claim is the hot link, the hot link itself being
10 generated?

11 MR. HIGGINS: I see. Yes, Your Honor. And if you turn to our
12 slide 5, maybe it's useful here to focus on the claim language. I think you've
13 identified something that there is a dispute between the parties about when
14 exactly the hot link is generated. So you're exactly right there. And you're
15 also right, I think, what you're getting at is the claim doesn't then separately
16 break out, generate a hot link. So that may be the cause of why you're
17 asking this question. But in the claim there's the -- you identify a trigger to
18 generate a hot link as we've highlighted there.

19 And later there's generating a hot link message. And that hot link
20 message includes the determined action and instructions for rendering and
21 displaying the hot link. So in our view, at that point, when the message is
22 generated, and the message includes this determined action and the action as
23 this highlighted -- the highlighted language determined in action to be
24 performed upon activation of the hot link. So you're generating a message,
25 it includes the action for the hot link, and it includes instructions for

1 rendering and displaying the hot link.

2 At that point, the hot link has also been generated because you
3 have the action, you know, to simplify this a bit, the action is essentially the
4 guts of why the hot link is a hot link. It's -- for example, the URL. And then
5 the instructions for rendering and displaying the hot link, that tells you how
6 is the message going to show this hot link. So when the receiver of the
7 message gets the message, these instructions for rendering and displaying
8 the hot link are going to show the hot link that was created during this claims
9 process.

10 JUDGE CYGAN: So just to be clear that I understand, the hot link
11 itself has to include the determined action, right?

12 MR. HIGGINS: Correct.

13 JUDGE CYGAN: That's not something which is sort of appended
14 onto it. And that's why you're saying that the hot link is generated in the
15 course of generating the hot link message because the hot link message is
16 what's tying everything together, correct?

17 MR. HIGGINS: Yes.

18 JUDGE CYGAN: Okay.

19 JUDGE EASTHOM: So then why can't it be -- generating -- when
20 you generate the hot link message and you pull the hot link from the server
21 storage and it has all the data -- all the instruction data with it as you say,
22 why isn't that enough? Because you pull first step says -- I'm sorry. Let
23 finish. I'm sorry to be more clear. Because the way I read it -- it says
24 generate a hot link message. So you have this message, this email message
25 and it includes the, you know, it includes the hot link, and it includes these

1 instructions for the hot link. But I just don't see anywhere where the claim
2 requires you to actually generate the hot link by adding instructions to it.

3 MR. HIGGINS: I see. Okay. Well it's true that the claim doesn't
4 separately break out generate a hot link separately from identify a trigger to
5 generate a hot link. And so that may be the reason why we're talking about
6 this point. But the hot link, there's a couple things to keep in mind here with
7 the claims. So maybe the most on point here is this determinant action,
8 which is another important difference between Petitioner's hypothesized way
9 that Rothschild will work and how it actually works. So determining an
10 action requires deciding basically what URL is going to be inside the
11 interactive ad in the parlance of the Petition. That determination needs to be
12 made. That's made during the message generation phase. And until that
13 action is determined, there's no hot link created.

14 So, or maybe to put it a different way, if you have a pre-existing ad
15 and it already has the URL in it, that URL, the action has already been
16 determined. There's no generating that hot link. There's no creating the
17 interactive ad. There's no determining the URL that's in the ad. It's already
18 been done. And so that's why we're emphasizing so much the fact that the
19 interactive ads in Rothschild are pre-created. So if, for example, we have
20 just a pre-existing ad, the URL is already baked in, and you attach that pre-
21 existing ad to an email message, that's in fact what Rothschild is showing,
22 for example, in Figure 3. But that does not generate, it doesn't create a hot
23 link because the hot link is the interactive ad that already exists before the
24 user gets any item from a pull down menu. The pull down menu is
25 populated with pre-existing ads. And there's no determining the action to be

1 performed because the URL and every one of those interactive ads is already
2 determined before the user ever gets any pull down menu.

3 JUDGE CYGAN: And Mr. Higgins, sorry, Judge Easthom, did
4 you want to comment on that?

5 JUDGE EASTHOM: No, thank you. Go ahead.

6 JUDGE CYGAN: I think you're highlighting a key distinction
7 here, which is that, in your view of claim there has to be a hot link which is
8 set forth in the message, and that has to have been determined in some way
9 other than what Petitioner is arguing. And the way Petitioner is arguing is
10 that there's a bunch of different, I guess, potential triggers. There's a bunch
11 of different things or not a bunch of different -- there are a bunch of different
12 advertisements. The advertisements, any of those advertisements could be a
13 trigger and all of those have been identified.

14 These are the possible triggers for the hot link, and within one of
15 those is the one that's eventually going to be chosen. I think that's, if I
16 understand correctly, that's why they're saying they've identified a trigger.
17 And then the selected trigger itself, that's the determining the action to be
18 performed. So in your view, what is, what's faulty about that view in that
19 when the user selects it? And then moreover, I think in Petitioner's point,
20 when the server puts it into the message, that's the determining the activity
21 perform step. What's faulty about that?

22 MR. HIGGINS: Yeah, there are two main things that are faulty
23 about that, Your Honor. The first, it gets into more of the claim language, so
24 it's the in response to detecting the trigger language. Let me address that
25 second, because it's actually maybe it takes a little bit more brain power to

1 figure out. The second one is similar -- is simpler to understand, which is
2 that second part of what you're saying, when the server gets this data, stuff
3 happens. That is something that as we saw, we discussed this a little bit
4 earlier, but as we saw during, sorry, on our slide 10, the server, first of all,
5 the formatting doesn't do anything to the ad. And secondly, the server
6 doesn't insert the ad for a couple of reasons.

7 First off, Petitioner's expert Dr. Houh admitted that, by the time
8 the server is at the step of formatting the message, the ad has already been
9 selected and it's already in the message data. So the server is not doing
10 anything with the ad. There's no email format for an ad, and the ad is
11 already determined by the user, and the ad is already in the data that the
12 server gets. Dr. Houh thought that when the user selected an ad from the
13 dropdown menu, that selection went to the server and then the server sent
14 the ad back. But as he admitted, there is no disclosure in Rothschild of that.
15 So that's the second reason why we have a problem with Petitioner's
16 argument there.

17 Now, getting back to the claim language on Claim 5, the reason
18 that, and this may, maybe I should have focused on this more as well. In the
19 claim language, there are these different steps and they come in order. So
20 there's identify a trigger to generate a hot link, and then the next line is, in
21 response to detection of the trigger, determine an action to be performed
22 upon activation of the hot link. And this is critical and why we have a
23 problem with the Petition's position. You have detection of the trigger, and
24 let's suppose that's when the server receives the user's ad selection, which
25 even though Petitioner's expert, Dr. Houh admitted there is no disclosure of

1 that, let's just take that as an example or a hypothetical that the server detects
2 what ad the user selected.

3 So the next clause in the claim requires that in response to that,
4 determine an action to be performed upon activation of the hot link. Well,
5 both parties agree that the action to be performed is the URL or activation of
6 the URL. The URL, however, already is pre-existing and is already baked
7 into the ad before it ever shows up in the pull down menu. So even if we say
8 that the trigger is the server receiving the user's ad selection, in response to
9 that receiving of the ad selection, there is no determining the action to be
10 performed because that's already done. The ad is pre-existing, including the
11 URL in the ad. It's never edited. Formatting doesn't edit the ad. Formatting
12 doesn't select the URL. It's already done.

13 JUDGE EASTHOM: But why isn't it enough that when the user
14 selects the hot link, that that's determining the action to be performed?
15 Because it's telling the, I mean, when the user selects that -- when the user
16 activates the hot link, that tells it what specific action to perform. In other
17 words, display that certain ad or go to that certain ad.

18 MR. HIGGINS: Yes, Your Honor. In fact, that's, sorry.

19 JUDGE EASTHOM: No, I'm sorry. Go ahead. I should have not
20 kept going on.

21 MR. HIGGINS: No problem. Yes, and that's the point you're
22 making is exactly a point that Petitioner made. And I can point you to a
23 slide that'll help. But essentially, there's a big distinction between
24 determining the action, or there's a big distinction that we need to keep in
25 mind between the hot link and the hot link message. And keeping the claim

1 language in mind of that will help. So let me just turn to the slide so I can
2 point you to that, because I think it'll help in answering exactly your
3 question. So in our slide 27, we discussed exactly this point. And I think if
4 I give a simplified hypothetical, it might help illustrate the point we're trying
5 to make.

6 So it is true -- absolutely true. You're right that -- let's take a
7 universe where there are only two ads. One ad is for cats, and it has a URL
8 pointing to cats.com. And the other ad is for golf, and it has a URL
9 pointing to golf.com. So, Your Honor, you're absolutely right, that if the
10 user selects the cats ad, the message is going to show the cats ad, and if a
11 recipient of the message interacts with the cats ad, it's going to go to
12 cats.com. That's definitely true. However, that's not going to change what
13 happens when you interact with the cats ad. No matter what happens, the
14 cat's ad will always point to cats.com. The golf ad will always point to
15 golf.com. And the claim requires determining the action that happens when
16 you interact, when you activate the hot link, which is the interactive ad, we
17 all agree. It's not something about what happens when you read the
18 message. It's about what happens when you interact with the hot link. In
19 other words, the interactive ad.

20 So in Rothschild, the cats ad, and the golf ad, those are fully
21 baked, the URLs are set before any user gets any menu, allowing them to
22 select cats ad or golf ad. After they select cat's ad or golf ad, nothing
23 happens to that ad except that it gets sent along as an attachment. So even if
24 we accept some trigger has been identified, the claim language requires that
25 in response to identifying that you're detecting that trigger, you determine

1 the action and the action is the URL, putting aside whether it's the URL as
2 text or the URL is where that text points you to. Either way, the URL is
3 fixed, never changed, never determined in response to the user selecting an
4 ad.

5 JUDGE EASTHOM: Thank you, counsel.

6 JUDGE CYGAN: And Mr. Higgins, just to push back on that a
7 little bit, if we can move to your slide 14.

8 MR. HIGGINS: Yes, Your Honor, I'm there.

9 JUDGE CYGAN: So on Figure 7, let's assume that the
10 determining is going to be based upon the user selection of the Sopranos.
11 That's really not going to change either. There's going to be something
12 associated with that Sopranos that the user really doesn't -- it's going to be
13 pre-associated with that Sopranos. How is that different from if instead of
14 Sopranos in the end, it was advertised with one advertisement two? If the
15 user is selecting advertisement two, why isn't that determining the action in
16 the same way that the user selecting Sopranos in Figure 7 is determining the
17 action?

18 MR. HIGGINS: Okay. Excellent, Your Honor, yes. So the
19 difference is that if we first we'll do Figure 7, and then I'll analogize it to this
20 simplified analogy I made earlier, a hypothetical. Each of these things like
21 the Sopranos, et cetera, those all exist. It's an existing TV show. The point
22 that Figure 7 is making is yes, there's a wide variety of things you could pick
23 to create, to generate a link to those things. So, but what you're sending in
24 the message is a link that does not previously exist. The Sopranos exist, but
25 the link to the Sopranos, that is something that is created during the message

1 creation process. And, in fact, in our slide 14, and the specification points
2 that out, hot link item 710, which includes the Sopranos, those are actions
3 that may be used, meaning future tense, to generate a hot link. These are not
4 hot links. 710 is not a hot link.

5 JUDGE EASTHOM: Is that your only disclosure of what generate
6 means? Or you said you had another example where you're saying these hot
7 links don't exist. I mean, one of these URLs, they don't pre-exist, and
8 they're not associated with Sopranos. Is there anywhere in the spec that we
9 can see that help us along?

10 MR. HIGGINS: Yes. Yes, Your Honor. So I think one thing that
11 I definitely want to point to in the specification is something that our expert
12 highlighted in his deposition testimony. And I want to let me find the slide
13 for that in just a moment here. Because I think that that will be very
14 instructive as to the meaning of generate. So in our slide 13, this is where
15 we detail our expert's testimony about the plain and ordinary meaning of
16 generate means create. And then getting to your point, Your Honor, when
17 our expert was asked if there's anything in the Patent specification that
18 supports his opinion, his testimony that generate means create, he pointed to
19 column 17, line 29. And I think that's worth looking at because it goes
20 directly to usage of generating and inserting.

21 So if we open Exhibit 1001, which is the Patent at issue here, I will
22 just turn to that. And if we go to line, sorry, to column 17, line 29, there's a
23 sentence that starts at line 29 and ends at lines 31. And the usage that I want
24 to particularly focus on is the end of that sentence, where it says that
25 characters are generated and inserted into the message. So generating and

1 inserting in that specification passage are clearly two different things. And it
2 makes sense. First, you would generate something to create it. After it
3 exists, then you can insert it into the message. And there's other, that's the
4 most crisp use of generate and insert in the specification that I'm aware of,
5 and it goes directly to one of the party's current disputes.

6 There are other usages in the specification of generating a hot link.
7 And it doesn't -- they don't expressly distinguish generate versus insert, but it
8 still uses the term generate, generating and sending, et cetera. And I'm
9 trying to see if I want to, if there's a particular passage I could point you to in
10 addition that might help. Okay, so at, for example, at column 9, line 47,
11 there's discussion of Figure 7 that refers to generating, sending, and
12 receiving hot links. And let's see. I'm not sure if you're looking for anything
13 in particular in the discussion, but I think the discussion of Figure 7 at
14 column 12 is also helpful. Like at line 16, it talks about the hot link items.
15 And we quoted this on the slide, but it can be used to generate a hot link.
16 And let's see if there's anything else. Oh, yes.

17 And then at column 12, line 63, there's a hot link interface module
18 811 that generates, sends, and receives hot links. And that talks about, that
19 may be instructive and maybe what you're looking for, Your Honor, because
20 it talks about how the module interacts with other interface modules to
21 obtain the information used to generate and perform the action associated
22 with the hot link. So, and then it goes on to say it also generates a data
23 message containing the hotlink, et cetera. So, I'm not sure if that answers
24 your question, Your Honor, but I hope that those are useful examples for
25 you.

1 JUDGE EASTHOM: Well, let me let me ask you this. That is a
2 good example. So, column 5, line 63. It says hot link interface module as
3 you pointed out generates, sends, and receives hot links. And it says hot link
4 interface module 811 interacts with the other interface modules to obtain the
5 information used to generate and perform the action. I'm just wondering.
6 So, I mean, it sounds like this information could be pre-stored.

7 MR. HIGGINS: Yes. The information is pre-stored, which is not
8 surprising. Like if you're making a link to something, normally you would
9 link to something that exists. The point we're making is that the link itself is
10 new. The link is created and generated. The data that it links to that's
11 existing. That's no surprise there. In contrast, in Rothschild, everything is
12 pre-existing. The entire hot link is pre-existing. There's no choosing what
13 URL goes into the interactive ad.

14 JUDGE EASTHOM: Okay. Thank you. I understand your
15 position. Appreciate that.

16 JUDGE CYGAN: And, Mr. Higgins, if I can focus on that point.
17 We were talking about the determining step. The fact that if there's an ad
18 which already has an action associated with it, it's not really determining yet.
19 But isn't it really the case that you're showing us here on slide 14 that it's the
20 actions that are being determined? So, the hot link item 710 are the actions
21 that are being determined. And the claim recites determine an action to be
22 performed. So the fact that there may later on be the specific addresses
23 associated with it, and the context and the formatting, that really doesn't
24 seem to come into play in the determining step. In the determining step, it
25 just seems to me as if there seems to be a list of actions such as Sopranos.

1 I'm still not clear why that's different if the user is choosing between The
2 End and Sopranos in the Patent.

3 And then in Rothschild, they're choosing between advertisement
4 one and advertisement two. That still seems to be determining the action,
5 even though the later steps of how that hot link is being constructed are
6 going to differ in those two, in Rothschild and the Patent. So is it really the
7 determining step that you're focusing on here for the distinction between the
8 Patent and Rothschild?

9 MR. HIGGINS: Yes, Your Honor. And let me try to state it more
10 crisply and maybe that'll help. So I think you're exactly right to go to our
11 slide 14. So let's stay there and looking at the Patent Figure 7 and these hot
12 link items 710. And let me try to highlight why we're emphasizing this
13 determinant action to be performed.

14 Let me take a step back for a moment as well and point out that in
15 the Petition, and really, you know, at root, we are talking about what was the
16 argument in the Petition. The argument in the Petition, we heard a reference
17 to it today, even though I think they've officially dropped that as of their
18 reply, that what happens in the Petition, there is a theory that there is an
19 HTML tag that would take something like a JPEG file and a URL and put
20 those together in one HTML tag and insert that into the body of a message
21 and that was the creation of a hot link. You have the URL inside; you have
22 the JPEG to show the link and you make the link that way. But even if we
23 don't limit ourselves to that example, and we just take a step back and
24 looking at Figure 7 and what these things are.

25 So let's take the Sopranos because that's an excellent example and

1 it's shown in the figure and let me try to make this point more crisply. So
2 the Sopranos, obviously, that's a reference to a television show. We can
3 assume that within that there's a reference to a particular episode of the
4 Sopranos. It doesn't particularly matter. My point is that the Sopranos is an
5 existing piece of content. That's absolutely true. And it's also true that the
6 user could choose Sopranos. So definitely that is true. And so in the
7 parlance of the Patent, when you generate a hot link and you're associating
8 an action to be performed, that action to be performed can be the Sopranos,
9 shown in Figure 7.

10 The critical difference between the Patent and Rothschild is that if
11 we're to -- in the patent, there's a message created that has a new link that
12 never existed before that links to the Sopranos because the user asked to
13 generate and create a new link that linked to the Sopranos. So even though
14 the Sopranos content is existing, the link is not. In Rothschild, if you were
15 to imagine this Figure 7 of the hot link Patent in the context of the
16 Rothschild pull down menu, in Rothschild, these items here, Sopranos
17 would be an ad for Sopranos with the URL www.sopranos.com, let's say.
18 And the ad would already exist. The user would pick Sopranos, which is a
19 pre-existing file that is an ad that has a URL pointing to the Sopranos.

20 Before the user picks that ad, it's already fully baked. It has the
21 URL in it. And all that happens is that pre-existing file that is an interactive
22 ad would get attached to an email message and sent. But the claim requires
23 that you determine what action is going to be performed. So in the case of
24 Figure 7, the action to be performed is a link to the Sopranos. It'll be some
25 pointer to the Sopranos, and you would get to the Sopranos. But the link

1 itself doesn't exist yet. In Rothschild, the action to be performed could even
2 be, let's say, that same action. The difference being that the action is already
3 determined, and the ad is already fully baked before the user can ever pick it.

4 JUDGE CYGAN: Mr. Higgins, does that matter in terms of the
5 language of the determined step or are you pointing to a different step?

6 MR. HIGGINS: No. It matters for the determined step. And the
7 reason, if we can go to slide 5, or you can look at Claim 1 of the Patent, the
8 reason that matters is because this determinant action portion, as you can
9 see, because it comes after the in response portion, and also because it's
10 indented in the original, there's, first of all, you have to have detection of the
11 trigger. That trigger is a trigger to generate a hot link.

12 In our view, that means there has to be creation of a hot link and
13 there needs to be a trigger that says, okay, you need to create a hot link or
14 interactive ad in our parlance in response to detecting the trigger. So first of
15 all, there has to be a trigger. Second, there has to be detection. And third,
16 in response to that, meaning it didn't happen before, it's only after in
17 response. Then after you've detected the trigger, because you detected the
18 trigger to create a hot link, at that point, you determine an action to be
19 performed.

20 In Rothschild, the action to be performed is set before the user ever
21 sees an ad. So even if we don't even talk about or don't even dispute
22 anything about trigger, even though Petitioner's expert said that -- admitted
23 that Petitioner's hypothesis doesn't work, even if we ignore all that for a
24 moment, if the server of Rothschild receiving the user's selected ad is the
25 trigger, then in response to receiving the selected ad, there is no determining

1 an action to be performed because the URL of that selected ad is already in
2 the selected ad. Nothing happens to that ad. It's not formatted. It's not
3 edited. It's not touched. And more specifically for this claim language, the
4 URL inside it is not changed. So there is no determining in response.

5 JUDGE CYGAN: In your Patent, where would you like us to look
6 to particularly for the "in response to"?

7 MR. HIGGINS: Let's see. So let me see. Well, I'd start with
8 column 12, line 63 with the hot link module generating the hot link. And let
9 me see if I can point you to something more crisply for this exact point.

10 JUDGE EASTHOM: Counsel, can I ask you a question before you
11 go off on line 63, please? It says hot link interface module generate sends
12 and receives hot links. So it seems like those hot links already exist.

13 MR. HIGGINS: Well, the generation part is creating them.
14 They're created -- being created and they didn't exist before, and they're
15 created in response to a message. And the reason we know is because, for
16 example, in the Figure 7 example, if you select -- if a user selects the
17 Sopranos, for example, there's going to be a new message that never existed
18 before. That new message that never existed before is going to have a hot
19 link, and that hot link that never existed before is going to point to the
20 Sopranos. And the only reason it points to the Sopranos is because the user
21 asked for a link that doesn't exist before that will now point to the Sopranos
22 because the user picks Sopranos.

23 JUDGE EASTHOM: Well, but if you look at this line 63, why
24 isn't it -- it's not really telling you how it generates it. Why isn't it broad
25 enough to convey to one of ordinary skill in the art that when you say

1 generates, sends, and receives hot links, that you could just be pulling data
2 from a soft memory that has the hot link in it? Why isn't that enough? I
3 mean, I don't understand because it doesn't really explain -- you know, it's
4 just a black box. And it doesn't say where we're receiving these hot links.
5 When it says it receives hot links, it seems to imply that, you know, these
6 hot links already exist, but it can generate it also by grabbing them and then
7 sending them and putting them in an email message generating
8 (INDISCERNIBLE) for them. I'm sorry. I keep running on. But go ahead.
9 I finished.

10 MR. HIGGINS: Well, not a problem, Your Honor. I always am
11 more interested in hearing what you have to say than hearing myself, so. No
12 problem. I think -- so a couple of points there, Your Honor. First of all, I
13 want to focus on the claim language itself. And as we all know, the
14 specification can describe all sorts of things. But we're laser focused on the
15 determining an action in response to detecting the trigger because that's what
16 the claim requires. But in terms of the specification, you're right that in
17 general, hot links could exist, et cetera. I mean, you could create hot links
18 and then once they're created, they could exist somewhere. Our point here is
19 first off, I think getting to the meaning of generate will help the discussion
20 here because we want to distinguish between pulling together something,
21 let's say fetching, right? Fetching an existing item versus generating that.
22 And I think that's part of what your question goes to.

23 And on that point, so that's one point, and we have a slide directed
24 to that, and I definitely want to point you to the specification there. And
25 then there's also the question of, well, is because there's pre-existing content,

1 and I guess this is a confusing point, all the content is pre-existing, whatever
2 we link to, say the cats.com website, golf.com, Sopranos, all these things
3 that are being linked to, those all are pre-existing, and that's natural.

4 Normally, you would only link to something that already exists. It's hard to
5 imagine linking to something that doesn't exist, although I suppose it's
6 theoretically possible. But the claims and the patents are making a
7 distinction between, you can have content and actions and things that you
8 want to link to, now we're going to create the link that has that action. But
9 the creation of the link is separate. And the -- I'll point you first to our slide
10 on this point about generating, and then go to the Patent as well. But our
11 slide on generating, we referred to it earlier in our discussion today.

12 Dr. Malek, our expert at his deposition, pointed to a passage, so
13 our slide 13 is directed to exactly this point of what does generating mean?
14 Why do we know that generating means creating? And so when the
15 specification refers to generating, it means creating, and it's creating a hot
16 link. The hot link points to something that already exists, but the hot link
17 itself is new and created. And our expert, Dr. Malek, referred to column 17,
18 line 29. And there, again, we looked at that earlier today, but I think it's
19 important enough that it bears repeating. Column 17, line 29, has a sentence
20 that goes to column -- to line 31. And the key language we want to focus on
21 there is that characters are, quote, generated and inserted into the message.
22 So inserting is different than generating. Generating means creating. And
23 so when the specification is talking about generating the hot links, it doesn't
24 mean fetch pre-existing hot links. It's actually creating hot links.

25 Those links are things that could be URLs, and they could also be

1 things like going to a radio station, all kinds of actions. So there's a lot of
2 different actions that are contemplated that could be the action that's
3 performed when you activate the hot link. But the hot link itself is
4 something that's generated, and it's generated because the user says, hey, I
5 want to send, for example, the Sopranos, or I want to send my friends, hey,
6 go tune into this radio station. And therefore, the hot link patent creates a
7 hot link that did not exist before that points to something that the user
8 selected as being the action to be performed, and that action will happen
9 when the recipient receives the message that has the hot link in it.

10 JUDGE CYGAN: And, counsel, I believe you're at about five
11 minutes into your sur-rebuttal time if you'd like to wrap up.

12 MR. HIGGINS: Okay. Yeah, I'll just make one more high-level
13 point because I think Your Honors are very familiar with all the material.
14 The third high-level point, and I'll point you to our slide at slide 29. The
15 third consequence of Petitioner and its expert misunderstanding Rothschild
16 is that they thought that HTML tags could be used with Rothschild to insert
17 HTML tags into the body of a message. And our expert went into great
18 detail explaining why the ads that the user selects are not wrapped in HTML
19 tags. And therefore, even if you were to use HTML with Rothschild, it
20 would not result in inserting an ad into a message.

21 And even if we – we're not saying that you can't use HTML
22 messages, even though Rothschild doesn't disclose that, but if you turn to
23 our slide 33, our expert anticipated this argument and said that even if you
24 used HTML formatted email, this is not the point he's making. It's not that
25 Rothschild doesn't disclose it. It's when you use Rothschild's interactive ads,

1 which are pre-existing files that can be attached to RTF messages or SMS
2 messages, those absolutely cannot be stuck into the body of an HTML
3 message. They're already interactive.

4 And therefore, even if you used an HTML message, what you
5 would have is an attachment, an attachment of an existing file. You would
6 not insert an HTML tag into the body of the message. And even in
7 Petitioner's language, where they're talking about Chen and saying Chen
8 discloses HTML with ads, even Chen says you can use it, as we highlight
9 here on our slide, with or without HTML links.

10 And what you'll have in Rothschild as our expert explained and
11 Petitioner does not rebut. If you combine an HTML formatted email with
12 the interactive ads of Rothschild, you will get an email that attaches a pre-
13 existing file. It will not use HTML links. So, thank you, Your Honors.

14 JUDGE CYGAN: Thank you, Mr. Higgins. We will have, I
15 believe, eight minutes left for your sur-rebuttal. Petitioner, would you like
16 to start on your rebuttal? You have 21 minutes.

17 MR. CLEMENTS: Yes. Thank you, Your Honors. So, I have a
18 few points that I would like to make on rebuttal. So, Patent Owner has said
19 that generating a hot link means to generate a link that never existed. But
20 when we look at the Figure 7 example in the '169 Patent, we can see that
21 there is content with a link. There is an example of gitwit.com. So, in
22 Figure 7, we have pre-created content, which includes URLs such as that
23 gitwit.com, and that those eventually become part of the hot link. So, we
24 don't think that the claims exclude, or we don't think Patent Owner's position
25 is tenable here. And I'll also note that nowhere does the claim exclude that a

1 link cannot previously exist. What the claim does recite, or in other words,
2 the claim does not recite, generate a link. It says generate a hot link. And
3 what is a hot link?

4 Well, a hot link is something that when interacted with causes the
5 user's device to perform an action. And so our position is that when
6 Rothschild's server takes the raw data that forms the advertisement and
7 formats that into something that recipient can interact with, that is when it
8 becomes a hot link. It may have existed as a URL before, but it becomes a
9 hot link at that formatting stage. And Rothschild provides some additional
10 discussion of this in column 449. It says the advertising application then
11 utilizes the message data, the sender data, and advertisement data to format
12 and send a personal communication containing a sender selected
13 advertisement.

14 That's similar to what we've cited to step 16 that we showed earlier
15 that Rothschild's server is taking this raw data, it's taking advertisement data,
16 not the advertisement, but advertising data and putting it into something that
17 the user can then interact with. That is when it becomes a hot link as
18 claimed. And this process is ultimately triggered by the user's selection of
19 an advertisement from a pull down menu.

20 Now, Patent Owners has characterized some of our positions as
21 new, but I want to point to where we identify these positions in our Petition.
22 So, for example, our position at formatting the advertisement into something
23 that makes it a hot link is generation of the hot link. Patent Owner has said
24 that that's a new position, but that has been our position all along. If we look
25 at page 26 of our Petition where we address this limitation, we say that when

1 the server receives a compilation of data that includes the user's
2 advertisement selection, that data -- which includes the selected
3 advertisement, is formatted into a standard email format. So we have always
4 pointed to that formatting step.

5 Now, Patent Owner also characterizes (INDISCERNIBLE) our
6 position that the server determines the action when it places the selected
7 advertisement in the email. But again, the Petition on page 29 says
8 Rothschild's server determines an action to be performed by placing a
9 selective interactive advertisement along with its embedded URL into the
10 email message. Now another point I want to make is that Patent Owner has
11 continued to mischaracterize our reliance on HTML. Patent Owner has a
12 slide that says the sole purpose of reliance on HTML tags is to generate the
13 hot link.

14 And Patent Owner's counsel gave an example that they said that
15 we had pointed to this HTML code as an example of generating the hot link,
16 but that is not correct. We have not relied on HTML for generating the hot
17 link. What we have relied on the HTML tags as an example is the claimed
18 instructions for rendering and displaying the hot link. And again the HTML
19 tags are just one example. Another example of that -- of instructions for
20 rendering and displaying a hot link would be the image file such as a JPEG
21 file.

22 On a further point, Patent Owner has provided a slide that says
23 URL equals the action to be performed. So that's not quite accurate. The
24 action is going to a website. And as we've stated in our Petition, the URL
25 helps define that action because it gives the location of a website. So when

1 we were talking about the action, we were talking about the act of going to a
2 website. And this action is determined when the server inserts the selected
3 advertisement along with the URL into the email message, much like the
4 example in the '169 Patent disclosed in Figure 7, where there's a number of
5 options to choose from. And the selected option then gets placed into a
6 message and becomes a hot link.

7 Now, Patent Owners has also argued that we did not rebut many of
8 their arguments about why HTML tags cannot be inserted into a rich text
9 format email. And the reason for that is that it's not our position that you
10 would put HTML tags into rich text format email. Again, our position is
11 that a POSITA looking at Rothschild would not read it to mean that only
12 rich text format emails can be used. And Patent Owner's argument discounts
13 the background knowledge of a POSITA because POSITAs had already
14 successfully implemented email advertisements in HTML. In other words,
15 POSITAs were already making the combination that we proposed.

16 So finally, Patent Owner has argued that we no longer -- in their
17 slide, they had a slide that we no longer have an argument for SMS or
18 instant messaging, the limitations of Claim 15. But in the line that Patent
19 Owner quoted, we're not saying that we don't make the case that SMS
20 messages would include HTML. But what the Petition does rely on is that
21 Rothschild's explicit teaching of a technique, it can apply that to SMS or
22 instant messaging. In either of those cases, the interactive advertisement
23 would still be displayed to the recipient. And thus, the image data for the
24 advertisement, such as a JPEG or GIF, would be instructions for displaying
25 that advertisement to the user. Your Honors, I'm happy to answer any

1 further questions you may have.

2 JUDGE CYGAN: Mr. Clements, with respect to the discussion of
3 the in response to detection of a trigger. You're relying on Figure 7, which
4 is sort of a manual user embodiment of it. There's also an embodiment in
5 the Patent, which is really an automatic identification, the trigger, where the
6 computer takes care of all the steps of identifying where the hot link is going
7 to go to, as opposed to Figure 7, where the user is really doing a little bit
8 more specifying.

9 Do you think that it would be a fair reading of Claim 1, to because
10 of that in response to limitation, that Claim 1 is only capturing the automatic
11 detection? And what I mean by this is that the claim requires in response to
12 the text of the trigger, then determining that action, as opposed to specifying
13 the trigger and the possible actions beforehand that you really -- it's really in
14 response to detection of the trigger.

15 MR. CLEMENTS: So yeah, I understand your question. So what
16 I would say is that there are examples in the specification such as, you know,
17 there could be a song on the radio and then that causes a hot link to be
18 generated. But what I'll note here is that the term trigger does not appear in
19 the specification of the '169 Patent at all. So we're kind of left to, well, what
20 is a trigger? What is identifying a trigger and detecting a trigger? And so
21 we look to this example in Figure 7 as one fair reading. So whatever the
22 scope of trigger is, I think it would at least include this example here. And
23 because trigger is recited so broadly, we think that it would cover what
24 we've described in Rothschild, which is very similar to what is described in
25 the '169 Patent.

1 JUDGE CYGAN: Thank you, Mr. Clements. There's no other
2 questions by the panel?

3 MR. CLEMENTS: If there are no further questions, then I'll yield
4 the remaining of my time. Thank you, Your Honors.

5 JUDGE CYGAN: Thank you. Mr. Higgins, you have eight
6 minutes.

7 MR. HIGGINS: Thank you, Your Honors. So I'll make some high
8 level points and I'm happy to answer questions as well. So first off, I want
9 to take a step back and direct us all back to the original petition. The
10 argument made in the Petition is now something that our expert proved is
11 incorrect, something that the reply no longer maintains, but something that
12 we're hearing about today. And some questions have come up about this.
13 So let me refresh all our recollections. The original argument was that the
14 server would get raw data and do some processing to create an HTML tag
15 using a URL and a JPEG. And that was the idea was that a message would
16 have an HTML tag that didn't exist before. That HTML tag would point to a
17 URL, and it would point to a JPEG.

18 Now, our expert proved that that is not how Rothschild works
19 because, first of all, the ads are already pre-existing. Secondly, the ads do
20 not use HTML tags, and we can prove that by looking at the fact that they
21 are attached to other types of messages, like SMS and RTF, and you just
22 heard Petitioner admit that those absolutely do not use HTML tags. So we
23 know beyond doubt and without any rebuttal that the interactive ads of
24 Rothschild are not wrapped in HTML tags, and the server in Rothschild is
25 not creating HTML tags to make these interactive ads. So, and that's one

1 point I want to emphasize a lot, is that we rebutted the arguments in the
2 Petition.

3 The arguments in the Petition talked about creating an HTML tag
4 in response to getting data from the pull down menu. Our expert explained
5 why that is incorrect and why the Petitioner and the Petitioner's expert
6 misunderstood Rothschild. And so that HTML argument is something that
7 they dropped, although we're hearing about it kind of again today. The
8 formatting step of the server does not edit the ad. It --doesn't change the ad,
9 doesn't create the ad, doesn't make an HTML tag. That's one item we want
10 to emphasize. Another high-level point I want to make is I think there's been
11 a lot of confusion about the difference between pre-existing content and a
12 pre-existing ad. And even just now, we heard Petitioner point out that pre-
13 existing content could be, for example, a URL. And that's true, no doubt.
14 Before you link to a URL, you probably want to make sure that the URL
15 exists, otherwise you're pointing to junk that won't work. So yes, the URL is
16 pre-existing. The link to it, however, is not. And now we're hearing yet
17 more flavors that I don't think we've heard of before about a link is different
18 than a hot link, et cetera, et cetera.

19 The bottom line is when we look at the Patent language about
20 determining the action to be performed, whether or not the action is the URL
21 text or what happens when you interact with the URL text with using your
22 computer that can do something with the URL text, the point remains the
23 same. Setting the URL text is what's going to matter here. If the URL
24 points to cats.com, then eventually the recipient of the message is going to
25 go to cats.com. If instead it points to golf.com, the recipient of the message

1 is going to go to golf.com. The only thing that determines where that user is
2 going to go, the recipient is going to go, cats.com or golf.com, that it's all set
3 before anything the Petition talks about.

4 That's all in the pre-existing ad that exists before the user ever gets
5 a menu or dropdown menu or selects anything. Our expert proved that the
6 server in Rothschild is not getting raw data and generating a hot link or
7 doing anything with the URL. There's been no rebuttal to that point. So I
8 don't think it's appropriate for Petitioner to claim that that's what happens
9 when he's demonstrated that it's not. It's absolutely wrong. And with that,
10 I'll be happy to answer any other questions.

11 JUDGE CYGAN: Counsel, I just have one question. Do you
12 believe there's a difference between the embodiments in the Patent about an
13 automatic generation versus the user generation with respect to the in
14 response to detection of the trigger step? Because certainly in the automatic
15 step of the disclosure of the patent, there's talk about the computer
16 automatically recognizes when the trigger is going to happen and can look to
17 see what's playing on the device. And then clearly it's not using pre-
18 generated content in that description.

19 But is there description in the Patent which would tend -- is there
20 no description of which your contentions support, particularly in Figure 7
21 where the user is manually setting up what actions they want to take? Is this
22 being set up sort of ahead at the time? I'm trying to figure out if this, in
23 response to, is really only getting us to where the computer has to
24 automatically just create something on the fly, which is your point, and if
25 that's really only limited to the automatic embodiments in the Patent.

1 MR. HIGGINS: That's an excellent question, Your Honor. To be
2 honest, I have not thought about that because it wasn't in the Petition. So I'd
3 have, and I'd hate to just, you know, make -- try to answer you on the fly in
4 two minutes. I would want to think about that.

5 JUDGE CYGAN: Fair enough. If the panel has no further
6 questions.

7 JUDGE EASTHOM: Just -- I have one -- just one final question.
8 Mr. Higgins, you mentioned this a little bit, but you said the formatting
9 doesn't do anything for this for Petitioner. And I was, you know, I was
10 reading at column 11 lines 27, 28, which they cited in the Petition, and it
11 says it's step 516, the message data, which includes the selected
12 advertisement is formatted into a standard email format. So is your position
13 that the formatting doesn't format the advertisement?

14 MR. HIGGINS: Exactly, Your Honor. And our expert actually
15 explained this in unrebutted testimony. So the collection of data includes the
16 message text, and certainly there's formatting of an email disclosed, but
17 there is no email format for an ad. And our expert said exactly that in his
18 declaration. There's been no rebuttal. So there is no formatting of the
19 interactive ad, which is a pre-existing file. There's only formatting of the
20 text. And the reason that there's formatting of email text is because, for
21 example, if it's an RTF message, like in Figure 3, and I'll just point out that,
22 you know, the Petition itself sites Figure 3, maybe at least four times. And
23 Petitioner now, now that we've shown that Figure 3 doesn't show what they
24 thought it showed, they say they don't rely on it anymore.

25 But in Figure 3, it's a good example because it's showing an

1 interactive ad that's attached to the email. Formatting the email to RTF
2 format, rich text format, that's going to involve doing some processing to
3 make the message readable in rich text format. And there's hidden code, and
4 we go into this with Dr. Malek's declaration, but there'll be instructions for
5 the receiving device to properly display the rich text format email. That rich
6 text format is something that's hidden to a normal user. They only see the
7 formatted stuff, like in Figure 3 of Rothschild. You only see the actual text
8 that's meant for the user in the ad. But underneath the scenes, though,
9 behind the scenes, even the paragraph breaks, those have hidden encoded
10 instructions in them in rich text format that tell the receiving device, hey, put
11 a paragraph break here.

12 So you absolutely are going to do formatting of the message text
13 for doing email formatting. An email absolutely has different formats, that's
14 true. But the email formatting doesn't touch an interactive ad. There's no
15 email format for an ad, for a file, or for ads as our expert explained. And so
16 the data that the server receives, it does include the selected ad, and that's
17 part of our point. The server's not going and fetching the ad. It's already in
18 the message. And the formatting that happens absolutely applies to the text,
19 the body text of the message, because that's what email formatting does. But
20 it doesn't touch a file.

21 JUDGE EASTHOM: Okay. I appreciate that. Thank you. I don't
22 have anything else.

23 JUDGE CYGAN: And counsel, just to be clear, you're saying it
24 doesn't touch the file, but you're also saying it doesn't format how that file is
25 being presented to the user, as -- this is a picture, this is a link, this is a

1 video.

2 MR. HIGGINS: Correct.

3 JUDGE CYGAN: That does seem to be what's the form of the
4 HTML, right?

5 MR. HIGGINS: I think I understand what you're asking, Your
6 Honor. So yes, like, let me break that into two pieces. In the Figure 3
7 example, just to keep a crisp example, it's the only visual example of a
8 message in Rothschild. There's an attachment and it's shown in line, it
9 appears to be part of the body. The decision of how to show that attachment,
10 whether it's in line or not, that's something that's done by the operating
11 system. And as Dr. Malek pointed out in his declaration, we provide the
12 detail there.

13 The Figure 3 happens to show Windows OS operating system icon
14 for an unknown file type. If instead it were a JPEG, it would show the
15 generic icon for a JPEG. So anything inside that file is not telling the email
16 in Rothschild how to display that file. Instead, it's going to use the operating
17 systems rules for how to, or the email clients' rules for how do you display
18 an attachment. If instead we were dealing with HTML, it's true that HTML
19 tags can be created that would point to a JPEG, and you would see a JPEG,
20 et cetera. And that's what Petitioner thought Figure 3 showed, but we
21 proved that it's not. So when we're talking about HTML tags and
22 hypothetical HTML tags, it's true that you could have them pointing to some
23 file to show how to show this HTML tag, but that's not how Rothschild ads
24 work.

25 JUDGE CYGAN: Thank you, counsel, for explaining that.

1 Before we take a break, I'd first like to thank both of you for your
2 attendance and your presentations. Really like to commend you on your
3 command of the record, and also the slide exhibits, which were extremely
4 helpful in following the arguments. On this case, a final written decision
5 will be issued in due course. And I think we'll take a 10 minute break and
6 start at about 2:02, if that's acceptable.

7 MR. HIGGINS: Thank you, Your Honor.

8 JUDGE CYGAN: And please stay on the line before you take
9 your break to answer any questions the court reporter may have on this -- on
10 this (INDISCERNIBLE). Thank you. But this hearing is now adjourned.

11 (Recess taken from 1:52 p.m. to 2:02 p.m.)

12 JUDGE MCMILLIN: This is the beginning of the oral argument
13 in IPR2023-00248 in which the challenged patent is US Patent No.
14 7,376,414. The parties are Petitioner Google LLC, and Patent Owner
15 Wildseed Mobile, LLC. Who is appearing on behalf of the Petitioner,
16 please?

17 MR. EHMKE: Thank, Your Honor. This is Andrew Ehmke, lead
18 counsel on behalf of Petitioner. Joining me today is Raghav Bajaj. And Mr.
19 Bajaj will be presenting on behalf of Petitioner.

20 JUDGE MCMILLIN: Okay. Thank you, Mr. Ehmke. Welcome,
21 Mr. Bajaj.

22 MR. BAJAJ: Thank you, Your Honor.

23 JUDGE MCMILLIN: And who is appearing on behalf of the
24 Patent Owner?

25 MR. ALBERTI: David Alberti on behalf of the Patent Owner.

1 And I will give the presentation today on behalf of the Patent Owner, as well
2 as lead counsel.

3 JUDGE MCMILLIN: Thank you very much, Mr. Alberti. Is there
4 anything anyone wants to deal with before we begin the oral argument?

5 MR. BAJAJ: Not from Petitioner, Your Honor.

6 JUDGE MCMILLIN: All right.

7 MR. ALBERTI: I have nothing.

8 JUDGE MCMILLIN: Great. Mr. Bajaj, how much time would
9 you wish to reserve for your rebuttal?

10 MR. BAJAJ: I'd like to reserve 20 minutes, please.

11 JUDGE MCMILLIN: We gave each party an hour. So that will
12 give you 40 minutes.

13 MR. BAJAJ: Thank you, Your Honor.

14 JUDGE MCMILLIN: Please proceed.

15 MR. BAJAJ: Thank you, Your Honor. Turning to slide 2 and
16 starting off with a brief overview of the Patent, the '414 Patent is directed to
17 playing content and advertisements on mobile devices. And on the right side
18 of slide 2, we've reproduced Figure 9, which shows how the '414 Patent
19 obtains user information from a mobile device, determines an advertisement
20 to play on the mobile device, and then plays the advertisement at a certain
21 time. On the left side of slide 2, we've reproduced Figure 6 of the Patent,
22 which shows the various modules in the client advertisement application.
23 These modules include, as relevant to the discussion today, other source
24 module 606, which obtains information about the user in one example from
25 the user's messages.

1 Turning to slide 3, Claim 1 of the '414 Patent, closely parallels
2 Figure 9 and the abstract. And there are three high level concepts and
3 limitations recited in Claim 1. First, providing information to a server about
4 a user. That's limitation A. Second, receiving an advertisement that's
5 determined based on that provided information, that's limitation B. And
6 then third, playing the advertisement and while you're playing the
7 advertisement, storing the content, and resuming the content after the
8 advertisement. That's limitation C. And we'll focus on three key disputes
9 today. One, what does it mean to take information from a message as
10 recited in Claim 1? Two, does the prior art teach taking information from
11 messages under either the correct plain and ordinary meaning or Patent
12 Owner's narrow interpretation? And three, does the prior art teach a cellular
13 phone that plays advertisements and resumes stored content?

14 Moving ahead to slide 6, as shown here, our prior art mapping
15 demonstrated that limitations A and B were rendered obvious by the
16 combined teachings of Frerichs and Kawasaki, and limitation C was
17 rendered obvious by the combined teachings of Frerichs and Kauffman.
18 We'll briefly touch on each of these references and address them in more
19 detail. Turning to slide 7, Frerichs discusses streaming audio and inserting
20 targeted advertisements into streaming audio. And just like Claim 1
21 autonomously collects information about a user and uses that information to
22 select an advertisement, Frerichs collects information about a user and forms
23 a profile for the user and then targets advertisements to the user's profile.
24 Frerichs is applicable to various client devices, including cellular phones, as
25 recited in Claim 1.

1 Turning to slide 8, the Petition also relied on the Kawasaki
2 reference and the Kawasaki reference also discusses targeted advertisements.
3 What Kawasaki does is it focuses on taking information from messages
4 received by a user to target advertisements to the user's interests. And it
5 does so by scanning the user's email activity and other internet information
6 accessed by the user. That information taken from messages forms a user's
7 profile of interest like golf, and then can be used to target advertisements to
8 the user.

9 Finally, turning to slide 9, the Petition also relied on Kauffman,
10 and this reference teaches an advertisement insertion technique in the
11 streaming media art, what's recited in Limitation (c). In Kauffman's
12 techniques, advertisements are received and stored in the cache at a client
13 device. Those advertisements are output at an appropriate time, and while
14 an advertisement is being output, the user's desired content is cached, and so
15 when the content is resumed, it's played out from the cache at the end of the
16 advertisement.

17 So turning to slide 10, we'll start with the claim construction
18 dispute in this proceeding. On slide 11, we've again reproduced Limitation
19 (a) of Claim 1. And the language that we'll focus on is the phrase
20 information taken by the cellular device from a message sent to the cellular
21 device from another user of another cellular device. The Petitioner's
22 position has been, and always has been, that the plain and ordinary meaning
23 applies to this and all claim terms. And Patent Owner, on the other hand,
24 doesn't offer an explicit construction, but it instead contends that the plain
25 and ordinary meaning of this claim phrase requires information that was

1 actually in a message. So although they focus on the word taken, it's really
2 information that's at dispute. When you take information, what is the
3 information? And in effect, Patent Owners' construction --

4 JUDGE MCMILLIN: Excuse me. This is Judge McMillin. That
5 limitation, limitation (a), autonomously providing to a server by the cellular
6 device, refers to cellular device. I don't believe the term cellular device
7 appears in the '414 Patent outside the claims. What's a cellular device? The
8 '414 Patent, excuse me, talks about mobile devices, --

9 MR. BAJAJ: Right.

10 JUDGE MCMILLIN: -- and it provides a definition of mobile
11 device. But it never talks about a cellular device. What is a cellular device?
12 And there seems to be some distinction between mobile device and cellular
13 device. One is in the spec; one is in the claims. So what do you believe
14 cellular device is within the construction, within the plain and ordinary
15 meaning of the '414 Patent claims?

16 MR. BAJAJ: So given the fact that the specification doesn't detail
17 what a cellular device might be, it would be any device with cellular
18 connectivity. Now in our prior art mapping we pointed to teachings of a
19 cellular phone in the Frerichs reference, but to your point, Your Honor,
20 there's no specific definition of what a cellular device needs to be in the
21 Patent itself.

22 JUDGE MCMILLIN: I was more concerned because with regard
23 to again that limitation autonomously providing to a server by the cellular
24 device, and it goes on to say the information taken by the cellular device
25 from a message. The information taken from the message you seem to rely

1 upon Kawasaki, and I was more concerned about cellular device and the
2 disclosure of Kawasaki.

3 MR. BAJAJ: Right. And so, just to be clear, it's the combination
4 of Frerichs and Kawasaki to teach that limitation. And what Frerichs does is
5 it teaches the cellular device portion of that. Kawasaki, we're relying on to
6 teach taking information from received messages, messages received by a
7 client device. And so, when you combine those teachings, you have
8 messages received by a cellular device and taking information from those
9 messages.

10 JUDGE MCMILLIN: So you don't rely upon Kawasaki for
11 disclosing a cellular device?

12 MR. BAJAJ: Correct.

13 JUDGE MCMILLIN: Thank you.

14 MR. BAJAJ: Certainly. So, moving back to slide 11, in effect
15 Patent Owner's construction is that the word taken means extracting. So, for
16 a received message, the information provided to a server and then used for
17 advertising is limited to a word or characters of text that were exactly in the
18 message. And nothing can be changed about the text. It has to be exactly
19 reproduced in the user's information and used as is in the advertisement
20 selection in Limitation (b). And even under that narrow interpretation, our
21 prior art meets that construction. And we'll see on a later slide that
22 Kawasaki scans a user's email and takes information from that email. For
23 example, if a received email reflects an interest in golf, whether or not the
24 email includes the word golf, Kawasaki can recognize that and indicate an
25 interest in golf in the user's profile. So, in the instance where the email says,

1 let's go golf, golf, the interest is taken from that message and provided to the
2 server. But turning the slide 12 --

3 JUDGE MCMILLIN: But did you -- I'm sorry for interrupting.

4 MR. BAJAJ: Yes, Your Honor.

5 JUDGE MCMILLIN: This is Judge McMillin again. That
6 limitation says providing to a server by the cellular device, information
7 associated with a user of the cellular device. And then it talks about the
8 information taken by the cellular device from a message sent to the cellular
9 device from another user of another cellular device. The message
10 identifying characteristics of the user of the cellular device. And that
11 limitation says provide to a server information associated with a user of a
12 cellular device. And then the end the message identifying characteristics of
13 the user of the cellular device. My question is: Is the information associated
14 with a user of the cellular device in the first part of that claim, the
15 identifying characteristics of the user of the cellular device in the last part of
16 the claim?

17 MR. BAJAJ: So, our position in the Petition, Your Honor, is that
18 we read that claim to mean that the identifying characteristic of the user of
19 the cellular device was provided to the server. Patent Owner's expert, on the
20 other hand, has a different view of it. Patent Owner's expert's view is that
21 the identifying characteristic of the user of the cellular device does not need
22 to be autonomously provided to a server. The distinction, ultimately, is not
23 one that has been argued as separately in favor of the patentability of the
24 claim. So, it really hasn't been briefed, but that's Patent Owner's position,
25 and that, you know, differs from what Petitioner analyzed in the Petition.

1 JUDGE MCMILLIN: And what do you rely on for the message
2 identifying characteristics of the user of the cellular device? Where is that
3 taught in the prior art, according to you? And I cheated. I read your
4 materials. And your Petition deals with that at pages 41 to 43. And I think,
5 from looking at pages 41 to 43 of the Petition, that the only thing you cite is
6 Kawasaki. The only prior art you cite, you cite your expert, but the only
7 prior art reference that you cite is Kawasaki, Exhibit 1005, at column 4, lines
8 34 through 42. A lot in that question, and I apologize to you. I'm asking
9 about what you identify as the message identifying characteristics of the user
10 of the cellular device. I think you deal with that in the Petition at pages 41
11 to 43, and the only thing you identify is Kawasaki, column 4, lines 34 to 42.

12 MR. BAJAJ: Right. So, what we see in that portion of Kawasaki
13 is that the user views golf-related web pages 13A, email 12A, right? So we
14 know that the user is viewing email. And what does that mean to a
15 POSITA? A POSITA understands that if you're viewing golf-related email,
16 you sent and received golf-related email. That identifies a characteristic of
17 the user. The user is interested in golf, for example. And so it is Kawasaki,
18 understood by a POSITA, to be teaching messages that identify
19 characteristics. You know, we all send and receive email all day. Those
20 identify various characteristics about ourselves. You know, sometimes they
21 have our name, our phone number. Sometimes they have things that are in
22 our interest. And, you know, for example, the golf-related email or, you
23 know, a concert of interest that was also in our expert declaration. So email
24 can really include any information. And because Kawasaki teaches that
25 email is reflective of the user's interests, it is email identifying characteristics

1 of the user.

2 JUDGE MCMILLIN: That does seem to be what you argue and
3 say in your Petition. But if we look at what you identified, again, column 4,
4 lines 34 through 42 of Kawasaki. Kawasaki seems to be talking about
5 matching what it calls a recognizer with what it calls unknown data from
6 the things that it analyzes, which are web pages, email, user groups, or
7 whatever. But it doesn't seem to in that passage, at least to me, to teach
8 identifying characteristics of the user. It seems to be that we derive data
9 from these four sources, including email, and we match that to a recognizer.
10 And the recognizer is predefined in Kawasaki. And so, if we're matching
11 this data to something that's predefined, how are we identifying a
12 characteristic of the user?

13 MR. BAJAJ: Well, say we have a set of five characteristics that
14 we're evaluating of the user. One of those is golf, right? That is an
15 identifying characteristic. The claim and the specification don't say that the
16 characteristic has to be undefined beforehand, right? And so in Kawasaki,
17 even if we are matching the email against a list of defined characteristics, it
18 is still identifying characteristics of the user within that set.

19 JUDGE MCMILLIN: So the defined characteristics are already
20 defined in the recognizer?

21 MR. BAJAJ: Correct.

22 JUDGE MCMILLIN: Okay. Thank you. Sorry for interrupting
23 you again. I'm trying to let you talk a little bit now.

24 MR. BAJAJ: Thank you. So turning to slide 12, nothing in the
25 claim language itself and nothing in the specification supports Patent

1 Owner's narrow extracting view. For example, the claim doesn't recite
2 taking information by extracting, and the specification doesn't use the word
3 take or taken or define what it should mean in this context. There's one
4 instance of the word taken in the specification, and it's outside of this
5 context. And even when the specification talks about messages used to
6 provide information about a user, it doesn't specify how that information is
7 added or what information is added. In passing, the specification just says
8 other sources can be used, and it gives the example of a message from
9 another user of another mobile device, almost identical to the claim
10 language.

11 So the specification doesn't say, for example, you know, the words
12 corresponding to the characteristic are extracted and shipped off to the
13 server. And so when Patent Owner argues for this narrow interpretation,
14 nothing in the passage of the specification, nothing in the specification
15 supports that. And Patent Owner argues, for example, that our expert
16 misread the specification. I disagree because you can't misread what's not
17 there. And what's not there is any detail about what it means to take
18 information from a message. In Figure 8, which is reproduced here in part,
19 similarly doesn't support a narrow interpretation. All it says is if there's
20 information from other sources, add information about the user, and then
21 generate it and send it to the server.

22 JUDGE MCMILLIN: You talked about, I misled you, because I
23 said I was going to be quiet, but I'm not. This is Judge McMillin again. And
24 you talked about the specification and where it discussed this particular
25 limitation regarding taking -- regarding another email, an email from another

1 user. So the only disclosure I could find directly related to that was in
2 column 10, maybe lines 18 through 23 of the '414 Patent. And it says, and
3 you'll excuse me for reading it, but additionally, other source modules 606
4 enables other sources to be used to provide information regarding the user,
5 e.g., a message from another user of another mobile device that identifies
6 characteristics of the current user of the mobile device. The claims are a
7 little bit different. The claims say information taken by the cellular device.
8 In the specification, the information that's provided is information regarding
9 the user. My point is that is there some difference between providing
10 information regarding the user as disclosed in the specification and
11 information taken from the message? Is there some distinction there? You
12 don't understand what I'm saying.

13 MR. BAJAJ: (INDISCERNIBLE) Your Honor. I believe that the
14 specification doesn't define what it means to provide information regarding
15 the user and doesn't define what it means to take information from a
16 message, right? And so if we are to just read those words, I think that the
17 natural import is to say, okay, I can provide information, I can take
18 information in different ways, right? I'm not restricting how you may take
19 information or how you may use a message to provide information. That is
20 the point of that difference or that lack of definition in the specification as to
21 what these terms mean.

22 JUDGE MCMILLIN: Well, the claims talk about information
23 taken from a message. That doesn't appear in the specification. What if the
24 information provided about the user may not necessarily have been taken
25 from the message? That, yes, it's based on the message, but, you know, I

1 thought that maybe there was some difference.

2 MR. BAJAJ: And I think that's consistent with Figure 8 of the
3 Patent, Your Honor, which takes all of this information that includes the
4 message information, and then it generates information about user of mobile
5 device for server. That's step 822 in Figure 8. So it takes everything that's
6 available, and then it generates something else. So what's provided to the
7 server may not be exactly what's in those sources, because there's that
8 interim generation process. Again, there's no detail as to what that
9 generation process entails, but I think your interpretation that what's
10 provided may not be, you know, exactly what's in the message is correct.

11 JUDGE MCMILLIN: Yes, let me give you an example. The
12 message from the other user says, let's go play golf at Mar-a-Lago. And the
13 generated information that's provided to the server is this person lives in
14 Florida near Mar-a-Lago. But that really wasn't taken from the message, the
15 person lives in Florida. It just said, let's go play golf in Mar-a-Lago. Is that
16 the distinction that you think is trying to be drawn here?

17 MR. BAJAJ: The distinction that Patent Owner is trying to draw is
18 that in that message, you could either send to the server the word golf or the
19 phrase Mar-a-Lago. And our position is consistent with your example, Your
20 Honor, that we can take from that message that the user lives in Florida or is
21 near Florida or something of that sort, right? And this is also consistent with
22 what our expert said during his deposition, right? If I say to you, you know,
23 what did you take from that lecture? And you summarized the lecture. I'm
24 not going to come back and say, no, you didn't take that because you didn't
25 quote the words of the lecture. Right. If you summarize it, if you interpret

1 it, that's still taking information from whatever the source is.

2 JUDGE MCMILLIN: Okay. Thank you.

3 MR. BAJAJ: Certainly. So moving ahead, I just want to circle
4 back on the claim construction. Again, it's Patent -- or Petitioner's
5 interpretation that the plain and ordinary meaning applies to this. And as we
6 discussed, Judge McMillin and I, that includes deriving or summarizing
7 information from messages.

8 So moving to slide 15, we'll now address the dispute on these
9 message limitations. And again, the combination of Frerichs and Kawasaki
10 is cited to teach this. Slide 16, we detailed what the limitation actually says.
11 So I'll move to slide 17. And as I mentioned earlier, Frerichs collects user
12 information and provides it to a server and targets advertisements based on
13 that provided information. And Frerichs also discusses inserting targeted
14 advertisements into streaming audio at cellular phones, cellular devices.

15 Slide 18, we've also relied on Kawasaki to render obvious this
16 limitation. And what Kawasaki does is again, it scans content information
17 of an internet user, including sent and received emails. I'll turn briefly to
18 slide 19, where, as we hinted earlier, Kawasaki teaches taking information
19 from a message, like an interest in golf, whether or not received messages
20 have the word golf, right? Your message could say, let's hit a quick nine
21 holes, and that could be interpreted to an interest in golf. But the email
22 could also say, let's go play a round of golf. And then you get associated
23 with an interest in golf. In either circumstance, Kawasaki can recognize an
24 interest in golf and takes information from a received message.

25 Turning to slide 20, in combination with the teachings of Frerichs

1 of a cellular phone, a POSITA would have recognized that Kawasaki's
2 teachings were applicable to cellular devices. After all, Kawasaki
3 contemplates wide applicability and envisions that any client device that can
4 display email can implement the analysis and profile building detailed
5 throughout the reference. And it was known, of course, at the time of the
6 '414 Patent that cellular devices sent and received emails. For example, the
7 Ericsson R380 details that the smartphone reads email and makes phone
8 calls. In other words, cellular devices receive messages, and it would have
9 been obvious to take information from an email message sent to the cellular
10 device.

11 Turning to slide 21, Patent Owner argues that Petitioner didn't
12 identify anything in Kawasaki that suggests taking information from a
13 message is recited. But as we spoke earlier, Judge McMillin, Kawasaki
14 does. And we cited in the Petition how that teaching applies to Kawasaki.
15 There's sent and received emails, there's emails received by a cellular device,
16 and those emails identify characteristics of the user. This is summarized on
17 slides 21, 22, 23, and 24. I won't belabor that topic again because I know we
18 discussed it at length.

19 But turning to slide 25, we'll now address the motivation to
20 combine Kawasaki and Frerichs. On slide 26, a POSITA would have
21 recognized that the art provides an explicit motivation to combine Kawasaki
22 and Frerichs. Frerichs selects advertisements based on a user profile, and it
23 specifically states if there's any other information that can provide a more
24 desirable advertisement, that should be included. And where would a
25 POSITA find other information to provide desirable advertisements? The

1 teachings of Kawasaki. Kawasaki says that its goal is to improve the match
2 between user interests and advertisements. And so as our expert Dr. Houh
3 stated, a POSITA would have recognized Kawasaki as teaching a technique
4 to improve advertisement targeting and to provide more desirable
5 advertisements as contemplated by Frerichs. And on this specific point,
6 Patent Owner doesn't have a dispute.

7 Turning to slide 27, however, what Patent Owner's arguments
8 amount to is that a POSITA wouldn't bodily incorporate the system of
9 Kawasaki into the cellular phone of Frerichs. But as Your Honors are well
10 aware, bodily incorporation is not the test for obviousness. Our argument is
11 that one of skill in the art would take Kawasaki's teachings of taking
12 information from messages and apply that to Frerichs. Patent Owner's
13 argument, on the other hand, is that you would need to take all of Kawasaki,
14 the entire architecture, and put it into Frerichs to combine the references.
15 But that's not consistent with the law. So, but if we are to entertain that
16 bodily incorporation argument, Patent Owner's argument is that Kawasaki's
17 techniques use neural networks, and so you wouldn't combine Kawasaki's
18 neural networks with Frerich's cellular phone. But that argument misses the
19 point and mischaracterizes the reference. It is true that Kawasaki uses neural
20 networks. They're shown in Kawasaki's Figure 2 as element 22, neural
21 network processing. But the neural networks in Kawasaki don't have to
22 execute on the client device. Instead, the neural networks are used to form
23 recognizers which execute on the client device. And the fact that
24 recognizers can and do execute on client devices is plain from Kawasaki. In
25 another sense, or as another point, recognizers aren't described as neural

1 networks in Kawasaki, so there's no basis to Patent Owner's argument that
2 the neural network 22 in Kawasaki outputs a neural network recognizer 23.
3 Rather, the more logical reading of Kawasaki is that the recognizers are not
4 neural networks, and it's those recognizers, simple algorithms, and rules, that
5 would be combined with Frerich's teachings of a cellular device to
6 incorporate the teachings of Kawasaki.

7 Turning to slide 28 briefly, the fact that recognizers are not neural
8 networks is confirmed by additional evidence of record. So Kawasaki, for
9 example, states that recognizers are very small and compact, and it
10 incorporates by reference an earlier application, describe methods of
11 scanning, analyzing, and handling digital information, the '664 Patent. That
12 patent uses neural networks to create weighted lists of regular expressions.
13 And our expert, Dr. Houh, testified that regular expressions, as shown in the
14 '664 Patent itself, are nothing more than lines of text that can be used to
15 evaluate and characterize content. And that's processing that a cellular
16 device would have been capable of. So to conclude on this point, a POSITA
17 would have combined Kawasaki with Frerich's, and would have had a
18 reasonable expectation of success in doing so.

19 Turning to our next topic, caching, or recording advertisements at a
20 cellular device. Specifically, turning to slide 30, Limitation (c) of the claim
21 requires storing content while outputting an advertisement. And this
22 limitation is taught by the combination of Frerich's and Kauffman. More
23 specifically, turning to slide 31, Frerich's teaches at a client location
24 inserting targeted advertisements into streaming audio. And it specifies that
25 client locations include a personal computer but can also include cellular

1 phones. Turning to slide 32, Frerichs' teachings are combined with
2 Kauffman, which teaches caching at a client location, like the personal
3 computer or cellular phone of Frerichs. Kauffman explicitly teaches
4 recording streaming content when an advertisement is playing, and then
5 resuming the streaming content after the completion of an advertisement.
6 Patent Owner doesn't dispute at least this aspect of Kauffman. And what
7 Kauffman states is that a caching inserter system intercepts streaming media,
8 and that the caching inserter can be at an end user location. As shown in
9 Figure 1 of Kauffman here, the caching inserter can be at a user's home.
10 And in combination with Frerichs, the teachings render obvious that a
11 cellular device records or caches content that is stopped and then resumes
12 the content after an advertisement is complete.

13 Turning to slide 33, Patent Owner disputes that Kauffman teaches
14 caching at a client device that plays content. In Patent Owner's view,
15 Kauffman teaches at best caching at the set top box 14 in Kauffman's Figure
16 1, but the set top box doesn't play content, the TV does. So according to
17 Patent Owner, Kauffman can't be used to teach Limitation (c) of the claim.
18 But again, this is nothing more than a bodily incorporation argument. Our
19 argument is that one of skill in the art would apply the teaching of Kauffman
20 of outputting advertisements and recording content while outputting
21 advertisements with Frerichs' cellular device. Patent Owner, on the other
22 hand, argues that the hardware architecture of Kauffman is different than the
23 hardware architecture of Frerichs. But what that ignores is Kauffman itself,
24 the level of skill in the art, and the teachings of Frerichs. Again, Kauffman's
25 claims teach that the caching inserter can be in a communication device at an

1 end user location. And a computer or a cellular device is a computing
2 device, a communications device, I'm sorry. And a POSITA would have
3 recognized that by disclosing caching at an end user device, that Kauffman
4 is envisioning caching at a device that plays content. For example, a set top
5 box in the TV are akin to a cellular device's hardware and speaker for
6 output, for audio. Additionally, as we stated in the Petition, a POSITA
7 would have recognized that Kauffman's techniques were applicable to many
8 types of computing devices, including those disclosed by Frerichs. This is
9 particularly true when considering the teachings of Frerichs detailed earlier,
10 where an example of a client location or a client site is a personal computer
11 or cellular phone. So in combination, Frerichs and Kauffman render
12 obvious, recording by the cellular device and resuming by the cellular device
13 as recited in limitation (c).

14 Turning to slide 35, combining Frerichs and Kauffman would have
15 been nothing more than combining prior art elements according to known
16 methods to yield predictable results, a classic KSR rationale. Frerichs
17 teaches playing advertisements as recited in limitation (c), 1.3.1 in the
18 Petition. And it describes one advertisement insertion technique, but it
19 expressly says that it's flexible. Other insertion techniques can be used.

20 On slide 36, Kaufman teaches an alternative advertisement
21 technique using caching. And as we stated in the Petition, applying this
22 technique to Frerichs would have been nothing more than substituting one
23 technique for another or combining prior art elements. As Dr. Houh
24 testified, Kauffman discloses outputting advertisements in place of
25 streaming media content and provides implementation details, like the

1 caching inserter, for how to do that. Dr. Houh also testified that preloading
2 and caching advertisements, as Kauffman's techniques teach, provides for
3 quicker response times. And that's a motivation consistent with precedent,
4 including the *Intel v. Pact* case that we've cited here on slide 36.

5 But turning to slide 37, one of Patent Owner's arguments against
6 the combination is that there wouldn't have been a reasonable expectation of
7 success, because Kauffman's only applicable to video, and cell phones
8 allegedly could not handle video. But that ignores the argument and the
9 record evidence. Kauffman is broadly applicable to streaming media, not
10 just video. And Dr. Houh testified that even though Kaufman relates to
11 video streams, it would have been understood to also apply to audio streams,
12 which are less complex than video.

13 Turning to slide 38, Patent Owner also argues that in any
14 combination, the caching is performed upstream of the device that plays
15 content. So there's a delay caused by a second connection from the caching
16 inserter to the end user device. Again, that misinterprets the combination.
17 In the proposed combination, the cellular device has the caching inserter. So
18 there's no second connection and no added delay. So accordingly, a
19 POSITA would have found it obvious to combine the teachings of Kauffman
20 with Frerichs.

21 I'll now turn briefly to the dependent claims because I know my
22 time is short. Skipping ahead to slide 40, Patent Owner separately argues
23 Claims 2 and 3, claiming that the prior art doesn't teach providing a
24 preference of the user of the cellular device or a radio station broadcast
25 received by the cellular device. Patent Owner argues that this data needs to

1 be taken from a message as well. But that interpretation doesn't comport
2 with the claims or the specification. In Claim 1, the information provided to
3 a server is taken from a message. That's not in dispute. But in Claim 2, the
4 provided information is sourced from other aspects. It includes other types
5 of data like preferences, demographic data, or a geographic location. There's
6 no limitation in the claim that would require that information to be within
7 the message received by the cellular device. And nothing in the
8 specification suggests that preference data or demographic data would be in
9 the message. Rather, the specification says that preferences are provided by
10 preference module 602 here on slide 40. And demographics are provided by
11 demographic module 612, also in Figure 6. Other sources, messages, are
12 provided by other source module 606. And frankly, that is the only
13 interpretation that makes sense. If we take Claim 3, for example, and read it
14 in context, under Patent Owner's interpretation, the message that would be
15 required by Claim 3 would have to include a radio station broadcast received
16 by the cellular device, and the geographic location of the cellular device, and
17 the characteristic of the user of the cellular device. There's nothing in the
18 Patent to suggest all of that information is in one message, a 140 character
19 SMS message. So Patent Owner's arguments are premised on an overly
20 narrow interpretation of the claim that's inconsistent with the intrinsic
21 record.

22 Interpreted correctly, turning to slide 41, Frerichs teaches
23 providing radio station information. It teaches that information for the user's
24 profile can be derived from stations being selected. That is, radio station
25 broadcasts received by the cellular device.

1 Turning to slide 42, Claim 4 is also disputed, and Claim 4 recites
2 receiving an advertisement prior to playing the advertisement and recording
3 the advertisement for playback. Frerichs teaches this, as shown on slide 42.
4 But here, Patent Owner argues the references individually instead of the
5 combination. It asserts that Frerichs' ad is not selected using information
6 from a message. But the advertisement that is determined, or referenced
7 rather, in Claim 4 is the advertisement determined in Claim 1, Limitation 1.2
8 in the Petition, which is taught by the combination of Frerichs and
9 Kawasaki. That advertisement is selected based on the information provided
10 by Kawasaki's teachings from messages received by the user. Patent Owner
11 looks at Claim 4 in isolation instead of looking at Claim 4 as a dependent
12 claim, and its myopic look at the prior art doesn't provide for patentability.

13 Finally, turning to slide 43, Claim 7 recites receiving a stream for
14 the advertisement. And Frerichs teaches this, an advertisement is carried by
15 the streaming media. And as an alternative teaching, we also relied on
16 Kauffman, which teaches an incoming advertisement designated as stream
17 A. I'll reserve the remainder of my time for rebuttal.

18 JUDGE MCMILLIN: You used about 42 minutes, so you have 18
19 minutes left.

20 MR. BAJAJ: Thank you.

21 JUDGE EASTHOM: Mr. Bajaj, quick question. So you --

22 JUDGE MCMILLIN: Sorry.

23 JUDGE EASTHOM: Oh, that's okay. That's okay Judge
24 McMillin. I was still thinking. It's not your fault. Just to summarize, even
25 if we adopt Patent Owner's narrow construction, you contend that Kawasaki

1 in combination with Frerichs discloses that, right?

2 MR. BAJAJ: Yes, Your Honor.

3 JUDGE EASTHOM: Or renders it obvious. Okay.

4 MR. BAJAJ: Correct.

5 JUDGE EASTHOM: Thank you.

6 JUDGE MCMILLIN: Mr. Alberti, how much time would you like
7 to reserve?

8 MR. ALBERTI: I would like to reserve 15 minutes for rebuttal,
9 Your Honor.

10 JUDGE MCMILLIN: All right. Great. Please feel free to go
11 ahead. Thank you.

12 MR. ALBERTI: In the interest of time, I will sort of be jumping
13 around our slides. I don't think I'll have time to go through all of them. So I
14 will call out slide numbers as well as I can. And I'd like to begin with slide
15 number 6. Just as an overview, we've already discussed the '414 Patent. I'm
16 sure we'll discuss that in detail as we go through some of these limitations.
17 So I won't do a separate introduction to that, but I'll start right away
18 discussing how the proposed combination does not disclose or render
19 obvious the information taken limitations. From there, I'll move to discuss
20 the fact that it also does not disclose or render obvious the recording
21 limitations. Then I'll touch on the lack of motivation to combine, and then
22 finally, I'll address at least some of the dependent claims.

23 So moving to slide number 7, the information taken limitation. If
24 we look at Claim 1 in particular subsection (a), it specifies what this
25 information is, and the language specifically is that you provide to a server

1 by the cellular device information associated with a user of the cellular
2 device. The information taken by the cellular device from a message sent to
3 the cellular device from another user of another cellular device, the message
4 identifying characteristics of the user. And then it goes on to say in section
5 (b) that the advertisement that you get is determined by the server based at
6 least in part on that provided information, which again was taken from a
7 message. The proper construction of taken in view of the plain meaning of
8 that term, in view of the specification, in view of the file history, and in view
9 of just your general understanding of what that would be, including extrinsic
10 evidence, requires that you're actually taking some information that was in a
11 message that was sent to that cellular device.

12 JUDGE MCMILLIN: Mr. Alberti?

13 MR. ALBERTI: Yes.

14 JUDGE MCMILLIN: This is Judge McMillin. Let me interrupt
15 you right there because this seems to be a outcome determinative dispute.
16 Let's say the message says, and I'll change my example a little, hey, do you
17 want to play Augusta National or Pebble Beach? And the information that's
18 sent from the cellular device to the server says, this person, this user has an
19 interest in golf. Golf wasn't in the message. But was that information taken
20 from the message?

21 MR. ALBERTI: Not in the context of this Patent, and not in the
22 context of the plain understanding of that word. Let me give you an
23 example. Since we're talking about messages, if I say I took your email
24 address from your email message, everybody's going to understand what that
25 means. That means you actually took the email address from a message. If I

1 say I took the attachment from your email, that means you took an actual
2 attachment that was in an email. And I could go on. I took the list of items
3 from your email. That means you actually took that list of items from your
4 email. And --

5 JUDGE EASTHOM: Counsel, can I ask you a question?

6 MR. ALBERTI: Sure. Yeah.

7 JUDGE EASTHOM: Counsel, what if we focus on what
8 information means? Because I'm looking at my American Heritage
9 Dictionary now and it says, one of the definitions says it's knowledge,
10 information is knowledge derived from study, experience, or instruction,
11 knowledge of a specific event or situation news. That's the third one. So
12 what if we say, you know, from Judge McMillin's example, the knowledge
13 taken from the hypothetical about playing golf, or not playing golf, but
14 going to Mar-a-Lago, that knowledge -- the knowledge is the fact that its
15 golf involved. That's the plain meaning of information. The knowledge
16 derived from it.

17 MR. ALBERTI: Correct. But if we look at it in the context of the
18 specification, I mean, let's go back to column 10, lines 18 through 25. It
19 tells you what the information is. It gives you two examples. It says
20 additionally other source module 606 enables other sources to be used to
21 provide information regarding the user, e.g., a message from another user of
22 another mobile device that identifies characteristics of the current user of the
23 mobile device. The information is not something that's gleaned or derived
24 or defined from the message. It is the message. That's what the --

25 JUDGE EASTHOM: Well that's the classification. That doesn't --

1 that doesn't -- I don't even see that as being restrictive. First of all, it doesn't
2 tell us what information is. It doesn't say that it precludes knowledge, right?

3 MR. ALBERTI: Well, it's the only example given, and then it
4 goes on to say also -- okay, so now we have one example that we all agree is
5 the exact information. That's the one example that's given. But then it goes
6 on to say, the information can be provided by others or the actual user from
7 a remotely located stationary computing device about the mobile device
8 user. So now it's talking about information that's actually entered from
9 another user or the actual user. So, again, we're talking about exact data, and
10 if you want to look at the location being manually entered, that's disclosed as
11 well. When we look at the demographic module, it also discloses using
12 exact data, specifically age income and spending habits that may be
13 manually entered by the user. So the Patent gives specific examples. In
14 every example it gives, when you're talking about information, it's talking
15 about specific things, not generic knowledge. And in particular, when it
16 talks about information related to a message, it's talking about the exact
17 message. And of course when you read the Patent claims, they have to be
18 read in view of the specification. And not only that, I mean, this issue was
19 dealt with in the prosecution history. And I'll refer Your Honors to --

20 JUDGE MCMILLIN: Excuse me, Mr. Alberti. Before we go to
21 the prosecution history, can we stay with the specification a little bit? So
22 you referred to column 10, lines 18 through 25. And it says there, other
23 sources to be used to provide information regarding the user. And the other
24 source gives an example, e.g., and I had the honor of being the president of
25 the Latin club of my high school, so that means *exemplia gratia*. So that's an

1 example, and it seems to be an example of the source. The source is a
2 message from another user, but the information we're providing is regarding
3 the user, and so we derive that information from the source, the message.
4 Right. But are you saying that the characteristic that's provided, the
5 characteristics that are referred to in the claim limitation, they have to be in
6 the message? So in the example we've all been talking about, the message
7 would have to say, you like golf? Rather than deriving that the person likes
8 golf, from the fact that the person sent them messages about Augusta
9 National, Mar-a-Lago, some other golf course. So what you're saying is the
10 message itself would have to have the characteristic in it. You like golf.

11 MR. ALBERTI: Correct. If you're going to take something from a
12 message in the context of this Patent, again, the example given is the
13 information provided is the message. And that's the only example that is
14 relevant to these claims. So again, when you look at these claims and you
15 say, what does it mean to provide information and that information is taken
16 from the message? Well, what does the specification say? The example that
17 is given is that you provide the exact message. So the information that
18 you're providing has to be information in that message.

19 JUDGE MCMILLIN: But you look at the exact language in
20 column 10, lines 18 through 25, I don't think that's what it says. It says,
21 provide information regarding the user. And then it gives an example of that
22 source of information regarding the user, which is a message from another
23 user. But the information provided is information regarding the user. I
24 mean, I'm struggling to see why that limits the information regarding the
25 user to exactly what is said in the message.

1 MR. ALBERTI: Well, okay, I'm reading that sentence, right? It
2 says, additionally, other source module 606 enables other sources to be used
3 to provide information regarding the user. So then it says, e.g., that's now
4 referring to the last thing in the sentence, information, the provided
5 information regarding the user. Then it tells you what that information that
6 is provided is. It says a message from another user of another mobile device
7 that identifies characteristics of that mobile device. I think the only logical
8 way of reading that is that the e.g., modifies what's directly in front of it, so
9 that the information provided is this message that identifies these
10 characteristics, not something that's secondarily derived from it or anything
11 like that. And I think the language take, again, in the context of a message,
12 if I take an address from a message, if I take an attachment from a message,
13 if I take a list from a message, I'm taking something that was in the message.
14 And again, and that's confirmed by the prosecution history as well.

15 JUDGE MCMILLIN: And I'll let you get there, but I'm just going
16 to tell you, I read that differently. It says sources to be used to provide
17 information regarding the user. It says sources to be used. And the source
18 that it gives an example of is an email from another user, a message from
19 another user. And so the e.g., is an example of a source. And it's not an
20 example, I think you're reading it as an example of the information or
21 requirement of the information.

22 MR. ALBERTI: To me, that's how I read it. However, even if you
23 read it your way, that doesn't end the inquiry, right? You still have to look at
24 the plain language of the claim, which says taken. If you take something
25 from a message sent by another user that identifies characteristics. Again,

1 in every example I can think of, whether it be email, even if you go beyond
2 email, you say, okay, I took the letter from the envelope, another example of
3 a message. You're actually taking something from the envelope. You're
4 taking something from the message. If I say, okay, I took this piece of paper
5 off the table, I'm taking something, I'm extracting, I'm taking something that
6 was actually on the table. This broader notion just isn't supported by the
7 specification and, in particular, not supported by the file history. Which --

8 JUDGE MCMILLIN: I'm going to let you get there, I promise.
9 But isn't there another meaning for taking? You know, I go to a lecture
10 tonight. And, you know, I go there, and the person is lecturing about what
11 they view as the border crisis. And I take from that that I take from it. I
12 walk outside with my friend, and I say, I take from that lecture that that
13 person is voting for Donald Trump. That person in that lecture never said,
14 I'm voting for Donald Trump. Trump was never mentioned in that, but they
15 talk about the economic crisis, the border crisis, and whatever. And so isn't
16 what I take from that. What I analyze and get from that is that they're a
17 Trump supporter, not a Biden supporter. Isn't there another meaning of the
18 word --

19 MR. ALBERTI: That is another meaning. In fact, if I could direct
20 Your Honor to slide -- our slide number 16, there are myriad meanings of
21 this term. The one thing I would point out is Your Honor is -- Your Honor's
22 example is you're at, you know, you're at some presentation and so on. Your
23 Honor's example is not you are some piece of code running on a 2001 era
24 cell phone that is looking at receiving messages and emails. With respect to
25 that and with respect to the specification and with respect to the file history,

1 which I know you promised me I'll get to and I'm not trying to push that
2 forward. That is not a proper meaning as is many of these 90 some odd
3 definitions. I mean you could talk about taking a fish when you're fishing.
4 You can, you know, there are many ways to say that, but what I will point
5 out and we could see that on slide 16 is that one of the -- plain meaning
6 definitions is precisely what our position is and that is to take or that is to
7 extract or quote. So certainly that is an acceptable plain meaning definition,
8 and in the context of this Patent, in the context of the era of cell phones that
9 this was, you know, this was being run on. In the context of the language
10 itself, when you're talking about taking something from a message, it's the
11 right construction. And again, without even getting into the file history, I
12 just think the plain meaning and the understanding comports mostly with
13 what we see here at definition number 16. And this was from Petitioner's
14 Dictionary.

15 JUDGE MCMILLIN: And let me push back at you on that.
16 Kawasaki seems pretty sophisticated to me. It's talking about neural
17 networks and recognizers and yeah, I kind of agree with you that, gee,
18 maybe you'd have a hard time fitting in on a cell phone. But if we just look
19 at Kawasaki itself, it seems to be pretty sophisticated stuff to figure out what
20 the user is thinking about. And it's not just deriving exact words. It seems
21 to be software that is in the business of implying things about the user.

22 MR. ALBERTI: I don't disagree with that. My point is we can't
23 construe the language of this Patent based on some disclosure of Kawasaki,
24 which doesn't even mention a cell phone. When we interpret the language of
25 the '414 Patent, we need to look at the language of the '414 claims, and view

1 the '414 specification, and in view of the file history, and in view of any
2 extrinsic evidence, plain meaning, and so on.

3 JUDGE MCMILLIN: Thank you very much. Please go forward.
4 I apologize to you, Mr. Alberti.

5 MR. ALBERTI: No, this is -- you know, I actually enjoy hearings
6 like this, so no need to apologize. I will now, finally, I get to touch on the
7 file history, and I am referring now to slide 15 of our presentation. And I
8 think the most important thing here is that the examiner understood the
9 language of these claims to be narrower than more broadly sort of deriving
10 or divining or however you want to put it, information from a message or
11 something like that that's not actually taken. And we could see this because
12 there are actually a couple amendments that had to be made to the claims.
13 And this was over the Owensby reference. In the Owensby reference,
14 selected ads based on profiles. That's not in dispute. It's a similar profile-
15 based system, like Frerichs, like Kawasaki. And those profiles were built
16 using data generated from messages. That's also not in dispute.

17 In this long discussion for the record is in Ex. 2009, you know,
18 paragraphs 67 through 76. There's a long discussion about it. I won't go
19 through it in detail. But what I will point out is that only after the limitation
20 was added, specifically that information had to be taken by the cellular
21 device from a message, did the examiner decide that this Patent overcame
22 the prior art, which disclosed all these things that we're talking about now,
23 indirectly deriving, using messages, using profiles. And you can see here in
24 the file history, we excerpted it at Exhibit 1002 at 36 through 37. This is the
25 examiner's reasoning. However, Sass, in view of Owensby, do not disclose

1 providing to the server by cellular device information taken by the cellular
2 device from a message sent to the cellular device from another user of
3 another cellular device. So that was critical to the allowing of the claim. So
4 we have to give that meaning. And when you look at it, it's entirely
5 consistent with our position, and with that plain meaning of taken to be
6 extracting or quoting, which we've referred to on the subsequent slide
7 number 16.

8 JUDGE EASTHOM: Counsel, can I, you know, I guess I take it
9 from your -- our discussion that you agree that the plain meaning of
10 information includes knowledge. Is that right?

11 MR. ALBERTI: Not, I mean not in the context of -- I mean not --
12 we're talking about something that's from a message so we're talking about
13 data. I mean information means data, right? So I don't think it means
14 something more, you know, general than -- we're talking about something
15 that's taken from a message is data in the context --

16 JUDGE EASTHOM: You're limiting information to data?

17 MR. ALBERTI: Well, I think we have to read it in the context of
18 claims that that's what it means. We're talking about data, something that
19 was in an email message, or I'm sorry, a message sent by cellular device to
20 another device.

21 JUDGE EASTHOM: So, I mean I'm taking from what you're just
22 saying, that you agree information has a plain meaning that's broader than
23 data, but you're limiting it to data in the context of the Patent?

24 MR. ALBERTI: Yeah. And I think that -- I'm sorry, Your Honor.

25 JUDGE EASTHOM: In the context of the patent, you're saying?

1 MR. ALBERTI: Yeah, in the context of the Patent. And I just
2 know that that wasn't an issue that was raised in the Petition. So it wasn't the
3 Petitioner's position that information could mean knowledge or anything like
4 that. Their position was -- (INDISCERNIBLE) derived.

5 JUDGE EASTHOM: Well, no, if I can interrupt. I think, yeah,
6 derived means that's the same thing that I'm getting at. Derived is
7 knowledge. The knowledge is derived from the information. I think that is
8 their ultimate point.

9 MR. ALBERTI: Well, again, it's not something that was raised in
10 their Petition. What really, what they went after was taken from a message
11 means derived from a message. And again, in the context of the claims and
12 the specification and the file history, you know, the amendment that was
13 made overcame this exact type of art where you're using a profile and you're
14 just generally looking at messages and stuff like that. There's nothing in
15 Owensby where you're actually taking data, taking information, taking
16 something specific, extracting from a message. And that's ultimately what
17 the examiner determined and allowed these claims over the prior art.

18 JUDGE EASTHOM: Well, I think I'm just reading from the reply.
19 They're saying that the claim doesn't require extracting data from messages
20 or sending data to the server, exact information containing the message. So
21 they're saying the information doesn't have to be the exact word. Golf
22 doesn't have to be in the information. So I'm trying to simplify this and
23 saying what the argument here is, is that information isn't restricted to data.
24 That's their ultimate point. And so, you know, we're going to learn the plain
25 meaning here, and so we look to what the plain meaning of information is,

1 and it means knowledge.

2 MR. ALBERTI: But it also means data and a lot of -- just like
3 taken information can have a lot of different meanings. So I would push
4 back on that a little bit, Your Honor, and say that, you know, just like we see
5 where you can have many, many meanings of the word taken, you could
6 have many, many means of the word information in the context of this
7 Patent. Information is data.

8 JUDGE EASTHOM: But I didn't see anywhere in your spec
9 where you limited information to data. That's one of the points. I mean, you
10 want to be your own lexicographer. It seems like you want to limit
11 information to data and it's not. I mean, I agree with you. Maybe
12 information does include data.

13 MR. ALBERTI: Well, yeah, they limit it to data. There are many
14 specific references in the Patent about, for example, manually entering this
15 information. But what does that mean? If you're manually entering location
16 information, that's not knowledge, that's data. If you're manually entering
17 other, you know, and when it talks about the demographics module and it
18 says that you can manually enter all this information, it's data, it's not
19 knowledge. And so I would point Your Honor back to those parts of the
20 specification where information is directly linked to data because it's
21 manually entered. And so it doesn't -- wouldn't even make sense to take,
22 you know, have a more broader knowledge of that.

23 JUDGE EASTHOM: Yeah, and then I would try to point you back
24 to the passages you were talking about with Judge McMillin. And I didn't
25 see anything there that limited it to data.

1 MR. ALBERTI: Well, again, when you look at it in the context of
2 everything else, how information is used, you know, location can be
3 manually entered, a user's age, income spending habits may be manually
4 entered. And then it says that information is added. It's making it
5 synonymous with data. I think that's the only way you can read this.

6 JUDGE EASTHOM: Okay. I'll let you move on to your --

7 JUDGE MCMILLIN: Let me interrupt again, and I'm sorry, Mr.
8 Alberti. This is Judge McMillin. It doesn't appear to me that you argued
9 either lexicography or disavowal with regard to claim interpretation, claim
10 construction.

11 MR. ALBERTI: We did not. I'm sorry.

12 JUDGE MCMILLIN: Did you? You're arguing plain meaning.
13 Not lexicography or disavowal, right?

14 MR. ALBERTI: Correct. We're saying that the plain meaning
15 comports with the way that we can't say lexicography because nowhere in
16 the specification does it say taken means this, right? So we're not arguing
17 lexicography. And we're not arguing disavowal. What we are arguing is
18 that the reasons for allowance and the arguments that were made and the
19 amendments that were made in the prosecution history and the
20 understanding of both the applicant and the patent office both comport with
21 the Patent Owner's understanding of the meaning of taken to extract data
22 from the message.

23 JUDGE MCMILLIN: And to maybe put a fine edge on this, your
24 position is information taken from the message. If we're going to use the
25 example, if the information taken from the message is this person is

1 interested in golf, the message would have to use the word golf.

2 MR. ALBERTI: Well, if, yeah. If you're -- if you're taking that
3 being golf and you're sending it to a server, then that information, that data
4 would have had to be in the message. That is our position.

5 JUDGE MCMILLIN: Okay. Thank you.

6 MR. ALBERTI: Okay. In the interest of time, I'll move now --

7 JUDGE CYGAN: Mr. Alberti, can I -- can I get one quick
8 question?

9 MR. ALBERTI: Sure.

10 JUDGE CYGAN: I was on your slide 15 when you discussed the
11 file history, you use an ellipsis there, which, you know, attracts some interest
12 when you're talking about what the reasons for allowance actually were.
13 And looking through Exhibit 1002, it doesn't seem entirely clear with the
14 examiner's reasons, the examiner's reasons were limited to that additional
15 phrase. It's clear that that additional limitation was added in the -- in the
16 amendment. But the examiner is a little bit cagey at -- in its description of
17 what isn't taught by each reference. What's your best -- are you making the
18 argument that it's clear in the examiner's answer that the reasons for
19 allowance was the information taken from a message, or is this simply
20 additional evidence that we might want to consider when we're looking at
21 this construction?

22 MR. ALBERTI: Well, certainly, you need to consider the file
23 history. And it's clear that this -- the allowance did not happen until this
24 limitation came into -- was added to the Patent. So the limitation itself was
25 critical. Now, he didn't -- I'll give you he didn't go and say, well, here.

1 Owensby says this and here Owensby says that, but it doesn't specifically
2 say this, but he does clearly say that it doesn't disclose that limitation. So
3 my point is you have to give that limitation some serious weight and
4 consider it in the context of Owensby in the rejections that previously
5 occurred, and the rejections that previously occurred were for sort of more
6 broader language that talked about preferences and things like that, not
7 specific information that was taken from a message. And when you look at
8 the disclosure of Owensby itself, again, it's clear that it uses profiles, and it
9 talks generally about messages but does not disclose that specific limitation.

10 JUDGE CYGAN: So, you're saying we need to do a little bit of
11 inferring, you know, because it wasn't exactly completely clear. It wasn't
12 stated explicitly that it was only this limitation. It was this limitation in view
13 of the stopping recording limitation when he was talking about Sass in view
14 of Owensby. Then, so we have to do a little bit of inferring, and you're
15 saying that's not a problem in terms of this.

16 MR. ALBERTI: I don't think it's a problem. I think it's the most
17 reasonable inference, and I think that, I might have mentioned before, there's
18 extensive discussion in Exhibit 2009 walking through the file history step-
19 by-step. And so to me, it's the most reasonable inference to make. Granted,
20 it is an inference, I'll give you that, but it is the most reasonable inference.

21 JUDGE CYGAN: Thank you. I appreciate it.

22 MR. ALBERTI: Yep.

23 JUDGE EASTHOM: But then, can I just get back to that? You
24 know, your friends cite this PMC case. Unfortunately, I was associated with
25 that case, and in that case, there were two plain meanings underlying the

1 whole thing. And the Court, as your friends point out, talks about there has
2 to be a consistent and, you know, repeated description of what the claim
3 means in order to shed light on what happens when there are maybe, you
4 know, different views on what the plain meaning is. I don't see any of that
5 in this prosecution history. I see the examiner saying something, but I don't
6 really see you pointing to us anyway. You know, applicants argued that this
7 was a major distinction and the reason for it.

8 MR. ALBERTI: Well, again, I think, you know, it's in detail in Dr.
9 Malek's analysis from paragraph 67 through 76, and it's nobody's disputing
10 that Owensby selected ads based on profiles and that it used messages, and
11 nobody's disputing that this Patent did not get allowed until this limitation
12 was entered into the claims. And that's our position. So, I've not heard of
13 any case that says you should never read a claim in view of the specification.
14 Actually, I think that's, I'm sorry, in light of the file history, there's nothing
15 prohibiting that. And I think when you do read this and you look at the
16 office actions, the rejections, the amendments, and then the final allowance,
17 the most reasonable inference to make is that the examiner gave meaning to
18 this phrase.

19 JUDGE EASTHOM: Okay. I appreciate that. Thank you.

20 MR. ALBERTI: I mean, it was literally, it had to be added into the
21 claim. And as soon as it was, it was allowed. And so that's our position.

22 Okay, so just really briefly, I know I'm running short on time.
23 Slide 21, I know this was touched on briefly, but the messages that are
24 required to meet this claim are messages that were sent from a user of
25 another cellular device. And while the exact phrase cellular device isn't

1 used, the specification of the '414 does talk about cellular phones, cellular
2 telephones, and given we're talking about mobile devices here, I think it's,
3 you know, and I don't think this has really been in dispute. The
4 combinations that were made were combinations that would involve cellular
5 phones. But when it comes to the disclosure that's being relied on, and I'll
6 refer to slide 22 now, they're relying on this notion that, well, you could
7 have an email. An email would be a message sent from a cellular device
8 from another user of another cellular device. But, you know, at the time,
9 first of all, emails were things that resided on email servers and could be
10 potentially uploaded or pushed or pulled to a client. It was not -- nobody at
11 the time of these inventions considered it like a mobile messaging
12 technology. In contrast, the '414 Patent specifically talks about cellular
13 messaging technology. In particular, it talks about SMS messages as one
14 example. So I think the general -- the generic reference to email in the
15 reference that they rely on doesn't get you all the way to what you need to
16 satisfy the specific type of message in the claims.

17 I'll move on now to the recording limitations and draw Your
18 Honors' attention to slide number 24. And for these limitations, the Petition
19 relies on Kauffman. And the problem with Kauffman, if we look at the
20 claim in 1(c), it says, recording by the cellular device content which is plain,
21 again, on the cellular device, while at least one determined advertisement is
22 plain. So we're talking about plain and recording on an end user device.
23 And Kauffman doesn't teach that. Now, there's a couple of new arguments
24 that Petitioner made that should be disregarded because they were not part of
25 the Petition. But I'll address those anyway. So let's first move on to slide

1 number 25. And you can see an annotated version of Figure 1 of Kawasaki.
2 I'm sorry, Kauffman there.

3 And paragraph nine of Kaufman's Exhibit 1006, talks about where
4 you do caching. And it's very specific. It says it could be located at any
5 convenient place along the signal path between the information source and
6 the end user. And the end user would be the far end, which would be
7 playing on a TV or a computer. And the paragraph goes on to say that at the
8 extreme, the advertisement cache could be part of a set top box at the user
9 location. So it's saying the furthest along that path it can go is at the set top
10 box. And that is not the user device. Kauffman distinguishes client devices
11 from devices that cache. For example, in paragraphs 3 and 17. And it's
12 important to note that Kauffman also says that the further upstream the
13 advertisement cache is located, the greater the broadcast potential for a
14 particular ad. So it's really telling you ideally you want this as far away
15 from the user device as possible. However, at the most extreme situation,
16 we're going to put it in the set top box. We're never going to put it in an end
17 user device that's used to actually display or audibly play the media that
18 we're talking about.

19 Moving on to slide number 26, we'll see that, again, here,
20 according to Dr. Malek, and he points this out, the caching happens
21 upstream, not at the TV or not at the computer terminal. And again, the
22 Patent specification distinguishes these two. For example, in paragraph 17,
23 when it talks about what the end user does, it says, in a conventional use of
24 this arrangement, end user 10 would send a request through a local
25 distribution network and into data network 24 for one or more multimedia

1 files to be downloaded and played on one of his devices, for example,
2 television 12, or computer 16. Now, in contrast, when he refers to the set
3 top box, he talks about something that is upstream of that. So for example,
4 earlier in paragraph 17, it talks about a residential end user is capable of
5 receiving multimedia through either a television and then a parentheses
6 using a set top box or gateway, right?

7 So distinguishing those from the television, or a computer
8 terminal 16. So there's a clear difference that's in Kauffman. You don't
9 cache at the end user device. Now, Petitioner makes this new argument
10 regarding Claim 17 and says, well, look, in Claim 17, it says that you can do
11 this caching at -- they say a communication device, but in fact, there's an
12 error in the claims. We don't even really know what the claim says. And
13 I'm referring now to slide 27. We can see that, you know, dependent claim
14 17, again, you know, it says a communication is device. We don't know
15 what that is. It was not something that was discussed in the Petition
16 anyways, but perhaps even more importantly, if we look, 17 depends on 12,
17 right? So 12 makes it clear that that arrangement, whatever it is that
18 communication, even if we, for the sake of argument, say that's a
19 communication device, it's disposed at the local point of presence because
20 17 depends from Claim 12. And so going back, now I'm on slide 26, or I'll
21 go back to slide 25, Kauffman is very clear that the point of presence can be
22 at the extreme at the set top box. So it's not at the TV or it's not at the
23 computer. So the fact that there's a dependent claim, even assuming that it
24 can be construed in the way they want it to be construed, it doesn't help them
25 at all because it's dependent on Claim 12 and Claim 12 talks about the point

1 of presence, which is only at the extreme at the set top box.

2 I think I'm starting to run into my rebuttal time, but I'd like to talk
3 about motivation to combine just briefly. You know, we heard multiple
4 times about a bodily incorporation argument. That's not what we're arguing.
5 We're arguing that, you know, based on the combination that they put
6 together, that combination would have no reasonable expectation of success
7 because according to their expert, you need to have these complex neural
8 networks that would have to run on a 2001 era cell phone. So, let me -- now
9 I know there's been some back and forth on does it really require a network
10 or not.

11 I would like to point Your Honors to slide 33, and let's just take a
12 look at what Petitioner's expert did. Okay. In his supplemental declaration,
13 right, this wasn't an issue that he contemplated in his original declaration,
14 but as a supplemental declaration, he makes a statement that the recognizers
15 in Kawasaki are not neural networks themselves, and that's Exhibit 1029 at
16 paragraph 20. But this was after he was deposed, and when he was deposed,
17 he repeatedly testified that, no, in fact, those recognizers are neural
18 networks. So, again, on slide 33, Exhibit 2011, page 40, lines 18 through
19 14, he's talking about the recognizer and then goes on to say, and that's the
20 kind of neural network analyzer that Kawasaki is talking about, page 177.

21 JUDGE EASTHOM: Counsel?

22 MR. ALBERTI: Yes.

23 JUDGE EASTHOM: It seems like he's saying that's the -- it's a
24 recognizer of neural networks. Is that not -- you know, your friend's point is
25 that these neural networks are somewhere else, and the recognizer, you

1 know, interacts with the neural network. How is that?

2 MR. ALBERTI: No, no, that's not what he's saying. He's saying,
3 okay, so he talks about it in the example where he talks about using the word
4 golf, he says the recognizer discussed and presented in Kawasaki, so now
5 he's talking about the recognizer, okay, can still discern that that kind of
6 interest, so he's talking about what is actually sitting on the phone and
7 determining whether some -- a message relates to golf or not. His very next
8 sentence is, and that's the kind of neural network analyzer that Kawasaki is
9 talking about. There's no confusion here. He's saying that the recognizer is
10 a quote unquote neural network analyzer. And then he goes on to say again
11 in the next quote, page 177, 1 through 5, he refers to them, the point is that
12 these kind of neural network recognize -- he even calls it a neural network
13 recognizer, so there's no there's no ambiguity here, I know he's trying to
14 backtrack now. But he repeatedly, in his deposition, referred to neural
15 networks, these recognizers, as being neural network recognizers and being
16 neural networks.

17 And Dr. Malek's testimony on this is really unrebutted because,
18 again, and he's an expert with grants in artificial intelligence. He knows
19 how this stuff works. And there is no credible rebuttal to him on any of
20 these points. So again, I'm running short on time. I'll move on to the
21 dependent claims, unless Your Honors have something specific you'd like to
22 ask about this lack of motivation to combine, specifically regarding the fact
23 that the proposed cell phone, pre 2001, would have been inoperable if you
24 were going to try to do this. I think the record is very fulsome on this point.
25 And again, since I only have about 10 minutes and I'd like to save some for

1 rebuttal, I'll either move on unless you have a specific question on this point.

2 JUDGE CYGAN: Okay. Mr. Alberti, can you point me to the
3 paragraph of Mr. Malek's declaration on this, specifically where he states
4 that it's not capable of being on the -- where this type of neural network is
5 not capable of being on a phone back at that time?

6 MR. ALBERTI: Oh, sure. Hold on one second.

7 JUDGE CYGAN: Page 83, maybe of Exhibit 2009, it looks like. I
8 don't know. That's what according to your --

9 MR. ALBERTI: Yeah, I mean, he gave the testimony several
10 times. I mean, I think it begins at paragraph 124, and it kind of it goes on
11 from there. Yeah, it began, I'll say it begins at paragraph 124 and I could, I
12 could give you an exact -- exact site, but it -- he goes through detail of why
13 this would not be possible at the time. In fact, I also note that in Dr. Houh's
14 deposition, he admitted that he had not even considered whether phones
15 could do this at the time. That's at page 151, lines 18 through page 152, line
16 1, and 152, 2 through 19, 154, 19 through 155, 7. And in fact, he had been
17 asked that whether he knew if any phone at the time could do this, and he
18 couldn't name one single example of that.

19 JUDGE EASTHOM: Thank you.

20 MR. ALBERTI: Okay.

21 JUDGE EASTHOM: And your expert testifies that these neural
22 networks are on the recognizer, is that right?

23 MR. ALBERTI: Our expert testified that the recognizers that
24 were -- that run on the -- that were proposed in their combination to run on
25 the clients were, in fact, themselves trained in neural networks.

1 JUDGE EASTHOM: Okay. Thanks.

2 JUDGE MCMILLIN: You've got about eight minutes left.

3 MR. ALBERTI: Good. I'll just really briefly, and I think this is a
4 quick rebuttal. And this relates to the dependent claims. And let's talk about
5 Claims 2, 3, 10, and 13. I think the argument that Petitioner was making is
6 that the provided information in these claims doesn't have to be the provided
7 information from Claim 1. And if you just, the basic laws of antecedent
8 basis will tell you that that's not correct. The provided information is the,
9 you know, it uses a definite article and we've all learned definite article
10 means you have to have prior antecedent basis. The prior antecedent basis is
11 the information that's taken by the device from a message sent to the device.

12 Now, they made a really clever argument in this last go around
13 where I think, I believe you heard, well, you would need to have all this stuff
14 in a message, and he rattled off this list of things. That's not true. I mean, if
15 you look at the dependent claims, they all say, at least you have to include at
16 least one of a series of things. So you wouldn't have to have a message with
17 all that stuff in it, you would just have to have a message that had one of
18 those things in it. So, again I think that that position is just not tenable in
19 view the claim of the claims, and with that I will rest and save whatever time
20 I have for rebuttal. Thank you.

21 JUDGE MCMILLIN: Thank you. You've got about six minutes
22 left. You're back up. You've got three times as much, Mr. Bajaj.

23 MR. BAJAJ: Thank you, Your Honor. So I'll be brief. There's a
24 lot of information to take from this oral hearing but that doesn't mean that
25 we're just taking direct quotes from Your Honors. So I'll start with the

1 Kawasaki combination again that is a bodily incorporation argument. It's the
2 teaching of Kawasaki and the teaching of taking information and detailing,
3 you know, what a user is interested in that would be combined with Frerichs
4 to render obvious that limitation.

5 I also want to turn briefly to Patent Owner's slide 15 about the
6 prosecution history. Judge Cygan, you referred to that quote from the
7 prosecution history and the ellipses. The other thing to notice there in the
8 bottom left of that slide is that the quote kind of suggests there was emphasis
9 on the information taken language. There's no emphasis in the prosecution
10 history. The examiner just copied and pasted the claim language as Your
11 Honors recognized in the institution decision. So there's no emphasis on any
12 particular claim language in the prosecution history's reasons for allowance.

13 Additionally, the distinction that the applicant made in prosecution
14 was not taking versus deriving. There were no, to your point, Judge
15 Easthom, no repeated and consistent remarks about taking and deriving. In
16 the only office action where this language was an issue, Patent Owner was
17 arguing about an affirmative act of the subscriber versus things that the
18 subscriber received. That's on page 58 of Exhibit 1002 where Patent Owner
19 is providing the distinctions that they saw. There's no discussion about
20 deriving versus taken. And the point is actually pretty simple if we look at
21 the claim language itself, right? The claim language talks about information
22 taken from a message. If it was the message that was provided as
23 information, the claim could have quite easily said, you know, autonomously
24 providing the message, but that's not what the claim says. The claim says
25 information, its knowledge, to Judge Easthom's point about the American

1 Heritage Dictionary.

2 The last point I will make is about Patent Owner's counsel made a
3 point about exact location data a number of times. But if we look at our
4 slide 14, this is Petitioner's Demonstrative's slide 14. The import of the '414
5 Patent is that if a user manually enters location information, that information
6 is not what's provided to the server because the physical location module in
7 the client advertisement application only enables coordinates identifying the
8 physical location to be provided. So as we know from Figure 8, which
9 generates information for the server, there's some derivation. I can take a
10 manually entered address by the user and create coordinates and send those
11 coordinates off to the server. I don't just take what the user entered 123
12 Main Street and shift that off to the server because that's not what's in the
13 specification. There's a deriving process in other aspects of the information
14 about the user, and that can apply just as equally to the information taken
15 from a message.

16 If there are no other questions, I will cede the remainder of my
17 time, but I'm happy to answer anything that Your Honors may have.

18 JUDGE EASTHOM: One question your friends were arguing. I
19 know you say this is an incorporation by reference argument, but I'm not so
20 sure if the recognizers include neural networks. Weren't you initially
21 positing that Kawasaki's neural networks/recognizer would be in the cellular
22 phone?

23 MR. BAJAJ: The argument was never that neural networks were
24 in a cellular phone. The arguments were that the recognizers were on a
25 cellular phone. But Kawasaki makes a distinction between what a neural

1 network is, 22, and what a recognizer is, 23. And Kawasaki never refers to
2 the recognizer as a neural network.

3 JUDGE EASTHOM: Do you take issue with the characterization
4 that your expert said the recognizers have neural networks during his
5 deposition?

6 MR. BAJAJ: Correct, Your Honor.

7 JUDGE EASTHOM: Okay.

8 MR. BAJAJ: That's not our interpretation of his testimony.

9 JUDGE EASTHOM: Thank you.

10 JUDGE CYGAN: And, Mr. Bajaj, just to be clear, throughout
11 Kawasaki, when they're looking at the message data, everything dealing with
12 the messages themselves is on the phone. So even so that the comparison to
13 the recognizers, that's all being done on the phone, correct? And only the
14 output of the recognizers is being sent to the server?

15 MR. BAJAJ: That's correct, Your Honor. Yes. So the phone does
16 the scanning of the email in the combination, right? So in the combination
17 with Frerichs, the Kawasaki recognizers would scan the email, identify that
18 it's, you know, associated with golf using, you know, regular expressions as
19 we posited in our reply declaration, and send that information off to the
20 server. That would be the information taken from a message and provided
21 to a server.

22 JUDGE CYGAN: Thank you.

23 JUDGE MCMILLIN: Thank you. Mr. Alberti? You're muted,
24 Mr. Alberti.

25 MR. ALBERTI: Always important to unmute. Thank you, Your

1 Honor. Briefly, I'd first like to start on this notion regarding the neural
2 networks and, you know, whether these strings of text or whatever they're
3 pointing to can be the neural networks. And I'd like to direct Your Honors'
4 attention to slide number 43.

5 JUDGE MCMILLIN: Your slide?

6 MR. ALBERTI: And again -- yeah, our slide number 43. And
7 again, on the lefthand side, we see Dr. Houh's supplemental declaration
8 where, again, he sort of did an about face on these recognizers. We've gone
9 over this, his prior deposition testimony. But I'd also like to point out that
10 Dr. Malek, as we see, reference on this slide, Exhibit 2009, paragraph 54,
11 explains that, you know, in the '664 Patent, which is related to Kawasaki and
12 talks about the neural network system, that that patent specifically says that
13 these expressions themselves don't do anything.

14 So this idea that you can send some string or an expression and
15 have that on a client device, such as a cell phone, and that's going to
16 magically scan email and pick out words and things like that, that's just
17 false. You know that Patent is very clear. It says the expressions are useful
18 in a neural network system. So you need the neural network system itself.
19 Without the neural network system, the expressions don't do anything. And
20 again, when you look at the '664 Patent, which it describes the network
21 system, you'll see it talks about SNNS, which is a Unix or Windows
22 workstation. That's what's required to run this thing. That's referred to at
23 Exhibit 2028, describes this neural network system. We're talking about
24 something that ran on Unix workstations. And again, this --

25 JUDGE CYGAN: Mr. Alberti?

1 MR. ALBERTI: Yes.

2 JUDGE CYGAN: Let me break in with a question. I'm a little
3 concerned about your expert's testimony because it seems to be making the
4 same pivot that you're making in your argument here, where they're
5 certainly something different than the neural network processor and the
6 recognizers. They're distinguished in Kawasaki. Whether or not we're
7 going to term the recognizers as also neural networks, there's certainly
8 something about them which is small and distinct. And when I'm looking
9 through your expert's testimony, every time your expert tries to explain why
10 those recognizers can't be on the phone, if your expert pivots back and says,
11 well, neural networks can't be on the phone because they have to be one of
12 these workstations. Certainly, understandable technology at that time for
13 neural networks themselves. But the recognizers, the product of those,
14 which are being mentioned as the algorithms, I'm not quite so sure where in
15 the record that your expert really engaged with what those resulting things
16 were, as opposed to just keep saying, oh, the neural networks can't fit on the
17 phone.

18 MR. ALBERTI: Well, the testimony was that the recognizers are a
19 trained neural network. And again, Dr. Houh is not disputing that, at least in
20 his deposition. And I'll refer Your Honor to our slide number 45.
21 Regardless of what you call these things, you know, Dr. Malek testified, this
22 is Exhibit 2009 at paragraph 29, that Dr. Houh has not considered the
23 overhead of extracting this information from email messages on a 2001 era
24 mobile device. In my opinion, the computing and battery resources on a
25 2001 era mobile device would not have allowed for a system that scanned

1 and parsed all the words of each received email repeatedly and queried a
2 database for each of those words.

3 Regardless if you want to call it a neural network or not, that's
4 what would have had to been done on a cell phone in 2001 in order to have
5 it -- to have an operable system in order to have an expectation of success,
6 which you would not have had because regardless of what you call these
7 things, that phone would have had to have been scanning emails. It would
8 have had to, you know, parse the words and done all this stuff and hit a
9 database, which that's another thing we could talk about is, you know, did
10 flip phones at the time of 2001. I mean, you could, you know, I remember
11 those phones. Those phones didn't do a whole hell of a lot. You know, you
12 had an address book that was like 20 entries long. And now you're going to
13 have a database of thousands and thousands of words and email. I mean, it
14 just.

15 JUDGE CYGAN: Mr. Alberti, did your expert point to -- is there
16 any testimony on whether algorithms and rules were not capable of being
17 run on phones at that time?

18 MR. ALBERTI: Yes. Yeah. And well, I pointed you to
19 paragraph 129 and 131 of his declarations. And again, we're talking about
20 performing what the functions of a recognizer are. Also, I'd refer to slide
21 number 38 that references other testimony of Dr. Malek, and that's again
22 from paragraph 134 that talks about the algorithms and rules and what they
23 have to do. And there's no dispute that if you want to scan emails to
24 determine whether a message has certain characteristics, you're going to
25 have to do all of this stuff and you're going to have to have done it on a 2001

1 aero mobile phone which is just not possible. So in short I refer Your Honor
2 to Exhibit 2009 at paragraph 134, and further paragraphs 129 and 131.

3 JUDGE CYGAN: Thank you. I appreciate those cites.

4 MR. ALBERTI: Yep.

5 JUDGE MCMILLIN: Mr. Alberti, you need to wrap up and say
6 goodbye.

7 MR. ALBERTI: Thank you, Your Honors, for your patience today
8 and the tough questions. I appreciate it. I have nothing further.

9 JUDGE MCMILLIN: Thank you. Everyone stay on the line to
10 see whether the court reporter has any questions before we sign off. But this
11 hearing is closed, and the record is closed.

12 (Whereupon, the above-entitled matter went off the record at 3:53
13 p.m.)

IPR20 23-00247 (Patent 10,869,169 B2)

IPR2023-00248 (Patent 7,376,414 B2)

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