

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC and YOUTUBE, LLC,
Petitioner,

v.

ROBOCAST, INC.,
Patent Owner.

IPR2023-00594
Patent 8,606,819 B2

Before PATRICK M. BOUCHER, MICHELLE N. WORMMEESTER, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

Google LLC and YouTube LLC (collectively, “Petitioner”) filed a
Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review
of claims 1–23 and 25–30 of U.S. Patent No. 8,606,819 B2 (Ex. 1001, “the

'819 patent"). Paper 2 ("Pet."). Robocast, Inc. ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp."). With our authorization, Petitioner filed a Reply and Patent Owner filed a Sur-reply. Papers 8 ("Reply"), 9 ("Sur-reply").

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we deny the Petition and do not institute an *inter partes* review.

I. BACKGROUND

A. The '819 Patent

The '819 patent is a continuation of U.S. Patent Application No. 09/144,906 (now U.S. Patent No. 8,965,932 B2 ("the '932 patent")). The '932 patent is a continuation of U.S. Patent No. 7,155,451 B1 ("the '451 patent"). Ex. 1001, code (63).

The '819 patent "relates generally to computer networks, and specifically to a method of sequencing and scheduling web pages." *Id.* at 1:23–25. According to the '819 patent, previous methods for a user "to access services, information and entertainment on the Web . . . typically require[d] a significant amount of user effort and decision-making to drive the web surfing experience." *Id.* at 5:51–6:4. For example, the user might "make certain choices, position the mouse pointer and click the mouse buttons appropriately to indicate the decisions," or "may type in a URL or access a bookmark to visit a favorite search engine." *Id.* at 5:51–61. This perceived difficulty is addressed by the patent by responding to a "triggering

event, such as a mouse click on a single ‘link’ [with] the presentation of a series of resources instead of one resource at a time.” *Id.* at 2:59–61. “This arrangement of resources[] is defined as a ‘show structure’ or ‘structure,’ which contains a set of nodes,” each of which “represents a resource such as a web page, an executable file, or a data file stored at a predetermined location and accessed via its corresponding address.” *Id.* at 2:61–65.

Figure 2B of the ’819 patent is reproduced below.

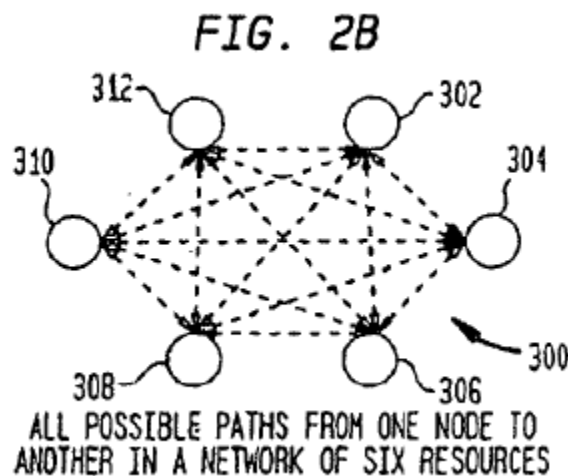


Figure 2B illustrates an array 300 of nodes 302, 304, 306, 308, 310, 312 that are available for presentation, with each node in the array accessible from the other nodes. *Id.* at 7:3–6. “For a typical show or presentations, an arrangement of these nodes or a portion of these nodes is selected for presentation.” *Id.* at 7:6–9. Examples of such arrangements or portions of nodes are provided in Figures 2C–2F (not reproduced here), and include such structures as “a show structure that simultaneously spans multiple paths from the same starting node” or “spans multiple paths concurrently.” *Id.* at 7:12–15, 7:26–28.

Figure 4 is reproduced below:

FIG. 4
RoboSurf

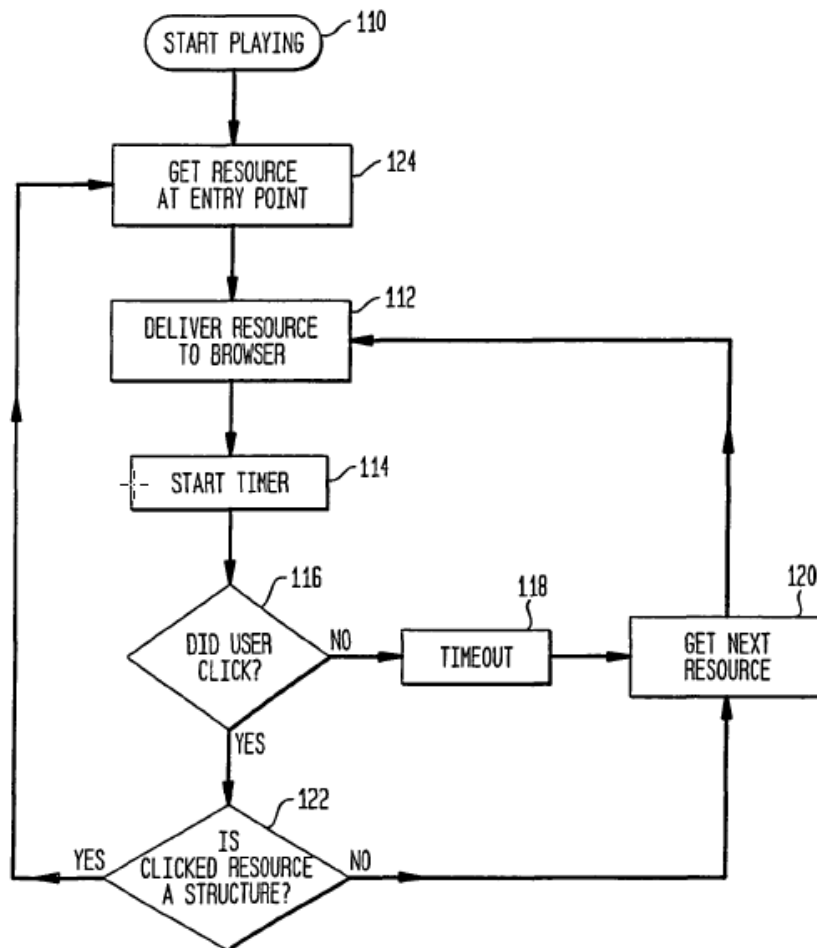


Figure 4 is a flow-chart diagram of a client-side software application that processes URLs and predefined structures automatically while monitoring timer settings and navigation decisions of users. *Id.* at 4:23–26, 10:47–50. At step 110, the process of Figure 4 accesses a default list of URLs that may be generated by a source such as a web server network, a profiler program, a search engine, or a screen saver’s play queue. *Id.* at 10:56–67. A URL is delivered to a user’s browser at step 112 and the content referenced by the URL is activated automatically for presentation to the user. *Id.* at 11:1–5. When presentation starts, the process starts a timer (step 114), and while the

timer is running, the process monitors the user's action to determine whether the user wants to manually override the play sequence by clicking a URL (step 116). *Id.* at 11:5–13. If the user selects a link (step 122) and the link is part of a different show structure, the process proceeds to step 124, and the newly selected show structure replaces the current show structure. *Id.* at 11:14–18. If the selected link is not part of another show structure, the process proceeds to step 120 to retrieve the next resource (step 120), the timer is reset, and play continues at step 112. *Id.* at 11:18–21. This scenario is identified as advantageous for “someone who has seen the presented content before, or in the case of content that the viewer chooses to skip (even an advertisement or PSA).” *Id.* at 9:45–48. If the user does not select a link, the timer expires (step 118) and the play sequence continues at step 120. *Id.* at 11:30–31.

B. Illustrative Claim

Challenged independent claim 1 is representative of the challenged claims, and is reproduced below.

1. A method for providing content via a communications network on a user's computer, obtained from a plurality of resources in an organized arrangement comprising the steps of:
 - creating a show structure of nodes, each node identifying a resource from a plurality of accessible resources, at least some of which are network accessible resources;
 - without requiring user input, automatically accessing a plurality of said network accessible resources identified by a corresponding node;
 - causing content corresponding to each of said accessed resources to be automatically accessed and presented through said user's computer in accordance with said show structure such that during said presentation of at least some of said

content from said accessed resources, at least some of said other network accessible resources are being accessed,

wherein said step of creating further comprises the step of providing interactively variable duration information, representing the duration that said content corresponding to said accessed resource is presented so as to enable a user to vary said duration; and

causing advertisement content to be presented to said user in a persistent content window in connection with said automatic presentation of said content through said user's computer.

Ex. 1001, 17:43–67.

C. Evidence

Petitioner relies on the following references¹:

Shimizu	US 5,634,062	May 27, 1997	Ex. 1003
Filepp	US 5,347,632	Sept. 13, 1994	Ex. 1007
Robertson	US 6,486,895 B1	Nov. 26, 2002	Ex. 1009
Wolfe	US 5,715,445	Feb. 3, 1998	Ex. 1014
Reilly	US 5,740,549	Apr. 14, 1998	Ex. 1015
Rakavy	US 5,913,040	June 15, 1999	Ex. 1018

Excerpts from Robert C. Benedict, Jr., *Using Harvard Graphics Version 2 for Windows* (David P. Ewing, 1993) (Ex. 1004) (“Benedict”)

Excerpts from David Fox and Troy Downing, *HTML Web Publisher's Construction Kit* (Waite Group Press, 1995) (Ex. 1005) (“Fox”)

¹ Patent Owner does not dispute that all of Petitioner's asserted art is prior art. See Prelim. Resp. 13 (“[A]ll of the references relied upon in the Petition are asserted to be prior art pursuant to 35 U.S.C. §102. Patent Owner reserves the right to present evidence of prior invention with respect to each of the references in the event of institution.”).

Catherine Guinan and Alan F. Smeaton, *Information Retrieval from Hypertext Using Dynamically Planned Guided Tours*, PROC. ACM CONF. HYPERTEXT 122–130 (ACM, Nov. 1992) (Ex. 1008) (“Guinan”)

In addition, Petitioner relies on a Declaration by Christopher M. Schmandt. Ex. 1002.

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–23 and 25–30 on the following grounds. Pet. 3.

Claim(s) Challenged	35 U.S.C. §²	References
1–15, 23, 25–28	103(a)	Shimizu, Fox, Benedict, Wolfe, Filepp
16–22	103(a)	Shimizu, Fox, Benedict, Wolfe, Filepp, Guinan
22	103(a)	Shimizu, Fox, Benedict, Wolfe, Filepp, Guinan, Robertson
13, 29	103(a)	Shimizu, Fox, Benedict, Wolfe, Filepp, Rakavy
30	103(a)	Shimizu, Fox, Benedict, Wolfe, Filepp, Reilly

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C § 103. The ’819 patent resulted from an application filed on April 18, 2012, claiming the benefit of the filing dates of earlier applications. Ex. 1001 at codes (22), (60), (63). We accordingly apply the pre-AIA version of § 103 herein. *See* Pet. 11 (Petitioner referring to pre-AIA statutory provisions); Prelim. Resp. 13 (Patent Owner stating that “[t]he ’819 Patent is subject to pre-AIA provisions of 35 U.S.C. *et seq.*”).

E. Real Parties in Interest

Petitioner identifies Google LLC and YouTube, LLC as real parties in interest. Pet. 1. Patent Owner identifies Robocast, Inc., as a real party in interest. Paper 5, 2.

F. Related Matters

Both parties identify the following related matters as involving the '819 patent: (1) *Robocast, Inc. v. Netflix, Inc.*, No. 1:22-cv-00305 (D. Del.); and (2) *Robocast, Inc. v. YouTube, LLC*, No. 1:22-cv-00304 (D. Del.) (collectively, “the related litigation”). Pet. 1; Paper 5, 2. Both parties also identify IPR2023-00182 as an *inter partes* review involving the '819 patent, challenged by a different petitioner. Pet. 1; Paper 5, 2.

Several *inter partes* reviews involving related patents are identified by one or both parties: IPR2022-1125, IPR2023-00081, IPR2023-00590, IPR2023-00591, IPR2023-00592, and IPR2023-00593. Pet. 1; Paper 5, 2.

II. JURISDICTION OVER EXPIRED PATENTS

Patent Owner states that “[t]he '819 Patent expired long before the Petition was filed on February 21, 2023,” and that “[w]ith the expiration of the patent, the Board ceased to have jurisdiction over the '819 Patent.” Prelim. Resp. 15. We disagree and conclude that jurisdiction is consistent with our statutory authority in view of Supreme Court and Federal Circuit precedent, and USPTO regulations.

Patent Owner grounds its argument on the Supreme Court’s pronouncement that “patents are public franchises that the Government grants to the inventors of new and useful improvements.” Prelim. Resp. 13–

14; *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1373 (2018). According to Patent Owner, “so long as the public franchise exists, the [U.S. Patent and Trademark Office] may have jurisdiction to amend and cancel the claims of the patent (e.g., via *inter partes* review.)” Prelim. Resp. 13–14. But “[w]hen a patent expires,” Patent Owner says, “the public franchise ceases to exist and the franchisee (e.g., the patent owner) no longer has the right to exclude others.” *Id.* at 14. Patent Owner reasons that, after the patent expires, “[a]t most, the franchisee may be entitled to collect damages” and thereby that “[e]xpiration removes the patent from the [Office’s] jurisdiction and returns it to the sole jurisdiction of the Article III courts, which have exclusive authority to govern claims for damages.” *Id.*

In *Oil States*, the Supreme Court also explained that “[i]nter partes review is ‘a second look at an earlier administrative grant of a patent.’” *Oil States*, 138 S. Ct. at 1374 (quoting *Cuozzo Speed Techs., LLC v. Lee*, 579 U. S. 279 (2016)). Other panels of the Board have relied on this statement in concluding that the Board has jurisdiction over expired patents in *inter partes* review proceedings. *Apple, Inc. v. Gesture Tech. Partners, LLC*, IPR2021-00922, Paper 10 at 17–18 (PTAB Nov. 29, 2021); *Apple, Inc. v. Gesture Tech. Partners, LLC*, IPR2021-00921, Paper 24 at 36–38 (PTAB Dec. 5, 2022).

Patent Owner criticizes such reliance because, in *Oil States*, the Supreme Court “emphasize[d] the narrowness of [its] holding” as addressing “only the precise constitutional challenges that *Oil States* raised.” Prelim. Resp. 14 (quoting *Oil States*, 138 S. Ct. at 1379 (alterations by Patent Owner)). According to Patent Owner, “the ‘precise constitutional challenge’

[in *Oil States*] did not involve an expired patent as is the case here, and the Supreme Court has yet to address the PTAB's jurisdiction to conduct inter partes review of expired patents." *Id.* But even if Patent Owner is correct that the Supreme Court has not specifically addressed whether the Board has jurisdiction over expired patents, that fact does not warrant discounting the logical consequences of what the Supreme Court has decided.

This is particularly so because the Court provided context for its statement, specifically identifying the types of constitutional questions it recognized as left unaddressed by explaining that its "decision should not be misconstrued as suggesting that patents are not property for purposes of the Due Process Clause or the Takings Clause." *Oil States*, 138 S. Ct. at 1379. In addition, we note that the Supreme Court explicitly recognized that "[t]he America Invents Act replaced inter partes reexamination with inter partes review," and that *inter partes* reexamination has regularly considered expired patents. *Oil States*, 138 S. Ct. at 1371; *see generally In re Rambus, Inc.*, 753 F.3d 1253, 1255–56 (Fed. Cir. 2014) (discussing procedures for *inter partes* reexamination of expired patent).

The Federal Circuit has also affirmed the Board's determination with respect to expired claims in *inter partes* review. *See, e.g., Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.*, 853 F.3d 1272, 1279 (Fed. Cir. 2017) (noting that "[t]he Board construes claims of an expired patent in accordance with *Phillips* . . . [and] [u]nder that standard, words of a claim are generally given their ordinary and customary meaning')."). This is consistent with our contemporaneous interpretation of our regulations as demonstrating that expired patents are properly considered to be within our jurisdiction. 37 C.F.R. § 42.100(b); *see also, e.g.*, 87 Fed. Reg. 51,341 (Oct. 11, 2018)

(Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board)³ (“The claim construction standard adopted in this final rule also is consistent with the same standard that the Office has applied in interpreting claims of expired patents and soon-to-be expired patents.”).

Furthermore, the statutes governing *inter partes* review do not limit them to unexpired patents. *See* 35 U.S.C. §§ 311(b), 311(c), 315; *see also Sony Corp. v. Iancu*, 924 F.3d 1235, 1239–41 (Fed. Cir. 2019) (affirming that a case or controversy before the PTAB existed when a patent was expired; articulating the importance of the Board’s review of expired patents since expired patents can be asserted for past infringement).

Even if none of these factors alone is dispositive, they are collectively consistent with the Board’s jurisdiction extending to cover expired patents. More particularly, Patent Owner does not adequately explain why the Board’s authority to take “a second look at an earlier administrative grant of a patent” ends when the patent term expires even though the rights granted by the patent are not yet exhausted. *Oil States*, 138 S. Ct. at 1374. We accordingly disagree that the Board lacks jurisdiction over expired patents.

III. ANALYSIS

A. Legal Principles

A claim is unpatentable for obviousness under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are “such that the subject matter as a whole would have been obvious at the time the

³ Available at <https://www.federalregister.gov/d/2018-22006/p-13>.

invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of nonobviousness, i.e., secondary considerations.⁴ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)); see *In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333 (Fed. Cir. 2016) (citing *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006)).

B. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person of ordinary

⁴ The parties do not address objective indicia of nonobviousness, which accordingly do not form part of our analysis.

skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). “This legal construct is akin to the ‘reasonable person’ used as a reference in negligence determinations” and “also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan.” *Id.* (citing *In re Carlson*, 983 F.2d 1032, 1038 (Fed. Cir. 1993)).

Petitioner proposes that a person of ordinary skill in the art “would have possessed a bachelor’s in electrical engineering, computer science, or similar field, with at least two years of experience developing and implementing network-based computer systems, such as systems for storing and retrieving information over the Internet or communicating using the Web.” Pet. 7. Petitioner adds that “[s]uch a person could also have qualified with more formal education and less technical experience, or vice versa.” *Id.* (citing Ex. 1002 ¶¶ 13–18).

Patent Owner proposes that a person of ordinary skill in the art “would have the equivalent of a four-year degree from an accredited institution (usually denoted as a B.S. degree) in computer science, computer engineering or the equivalent, and experience with, or exposure to, topics in computer networking, multimedia, and web systems. A person of ordinary skill in the art would also have approximately 3-5 years of professional experience with these topics.” Prelim. Resp. 5–6. In addition, Patent Owner says that “[a]dditional graduate education could substitute for professional experience, while significant experience in the field might substitute for formal education.” *Id.*

Petitioner supports its proposal with testimony by Dr. Schmandt. *See* Ex. 1002 ¶ 16. Although the proposals differ in certain respects, they do not differ in ways that affect our decision to deny institution of the proceeding. *See id.* (Dr. Schmandt testifying that “Patent Owner’s proposed articulation is not meaningfully different” and that his “analysis, opinions and conclusions . . . would not change if Patent Owner’s articulation were applied”). Both proposals include baccalaureate degrees and experience in generally related fields, with both parties indicating that additional education or experience could compensate for some lack in the other. For purposes of this Decision, we adopt Petitioner’s proposal, which we find consistent with the level of skill reflected by the prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the prior art may reflect an appropriate level of skill in the art).

C. Claim Construction

The Board uses “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (2019); *see Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). Certain terms recited in the challenged claims were construed during prior litigation of the ’451 patent, i.e., an ancestor of the challenged ’819 patent that Petitioner characterizes as “shar[ing] a near-verbatim written description with the ’819 patent”). Ex. 1023 (claim construction order in cases involving Microsoft and Apple); Ex. 2003, 5 (clarification of

certain claim constructions on summary judgment); Pet. 8–9. Patent Owner advocates that we adopt such prior constructions in this proceeding. Prelim. Resp. 6. Although “Petitioner does not believe express claim construction is necessary at this time,” Petitioner takes the position that its asserted prior art “renders the challenged claims obvious under the district court’s constructions.” Pet. 10. And we agree with Patent Owner that the Petition “presents extensive arguments” that apply the district court’s constructions. *See* Prelim. Resp. 6 (citing Pet. 9–10, 12–20, 33).

We have reviewed the court’s claim-construction order, and adopt its construction of the following terms for purposes of this Decision. First, we construe “node,” which is recited in multiple claims, as “an identifier of a resource that includes an address to the resource and the duration for which the resource’s content is to be presented by default.” *See* Ex. 1023, 16–17; Prelim. Resp. 8–10.

Second, we construe “show structure of nodes,” which is recited in each of challenged independent claims 1, 16, 23, and 26, as well as in certain dependent claims, as “a structure that is arranged for the display of content by specifying one or more paths through a plurality of nodes. The show structure of nodes specifies the duration of any display,” but there is no durational requirement separate from the construction of “node.” *See* Ex. 1023, 2–13; Ex. 2003, 5; Prelim. Resp. 7–8.

Third, we construe “interactively variable duration information,” which is recited in each of challenged independent claims 1, 23, and 26, as “a parameter specifying how long a content is to be displayed by default before a subsequent content is displayed, where the viewer of the content can change the parameter.” Ex. 1023, 22–23; Prelim. Resp. 10–12.

For purposes of this Decision, we accord all other terms recited in the challenged claims their plain and ordinary meaning. *See* Ex. 1023, 17–20, 26–29 (court adopting plain and ordinary meaning of “plurality of accessible resources,” “content,” “without requiring user input,” “in accordance with said show structure,” “providing,” and “search results”); *see* Prelim. Resp. 7 (Patent Owner advocating that “any additional claim language be[] accorded its plain and ordinary meaning”).

D. Overview of the Prior Art

1. Shimizu

Shimizu “relates to a hypertext apparatus capable of setting up a plurality of links between nodes.” Ex. 1003, 1:8–9. “Nodes serve as the units of such information as text information, image information, sound information and motion pictures.” *Id.* at 6:1–3. “Node information structures” hold information about each node, and may include slots for a “node identifier,” a “display procedure,” an “entity information pointer,” and “link information.” *Id.* at 6:30–32, 6:46–50. The “node identifier” uniquely identifies the respective node information structure while the other slots retain various pointers for pointing to a procedure program function used when the node is to be displayed, the entity information to be displayed, and the link information attached to the node. *Id.* at 6:50–62. “The entity information thus pointed to [by the entity information pointer] may be a character string, image information, motion picture or sounds.” *Id.* at 6:57–59.

Figure 9 of Shimizu is reproduced below.

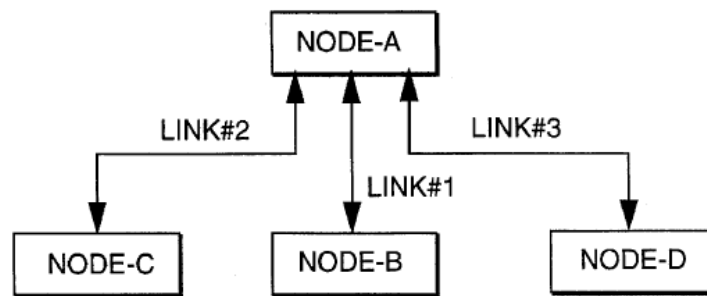


FIG. 9

Figure 9 is “a conceptual view of typical nodes and links and the relations in effect therebetween when the order of link information is changed.” *Id.* at 7:49–51. That is, nodes B, C, and D are linked to node A respectively via links #1, #2, and #3, but their order has been changed through the use of a graphical user interface such that, “[i]n this case, the link information ‘link #2’ is followed by ‘link #1’ and ‘link #3,’ in that order from left to right.” *Id.* at 7:36–56. When a play button is used to initiate a display of nodes according to their order, “the content of the node A is displayed first followed by the contents of the nodes C, B and D, in that order.” *Id.* at 7:57–65.

2. Fox

Fox describes itself as “three books in one,” with a section describing “what the Web is, how to access it, and how to navigate around using a number of popular tools,” a section describing a “toolbox and guide” for various content creators, and a section providing a “tutorial on starting your own Web site.” Ex. 1005, 26–27.⁵

⁵ When citing to Fox, we refer to the page numbers added by Petitioner rather than to the book’s native pagination.

3. *Benedict*

Benedict provides portions of a book that describes Harvard Graphics for Windows, “a program designed for creating business presentations.” Ex.1004, 19.⁶ The program can be used to “create professional-looking slides on your desktop computer” and can be used “to display the presentation on a computer screen.” *Id.*

Chapter 17 of Benedict describes the ScreenShow and HyperShow features of the program, with which “you can turn your computer into a projector and show high-resolution images directly on-screen.” *Id.* at 116. Figure 17.1 of Benedict is reproduced below.

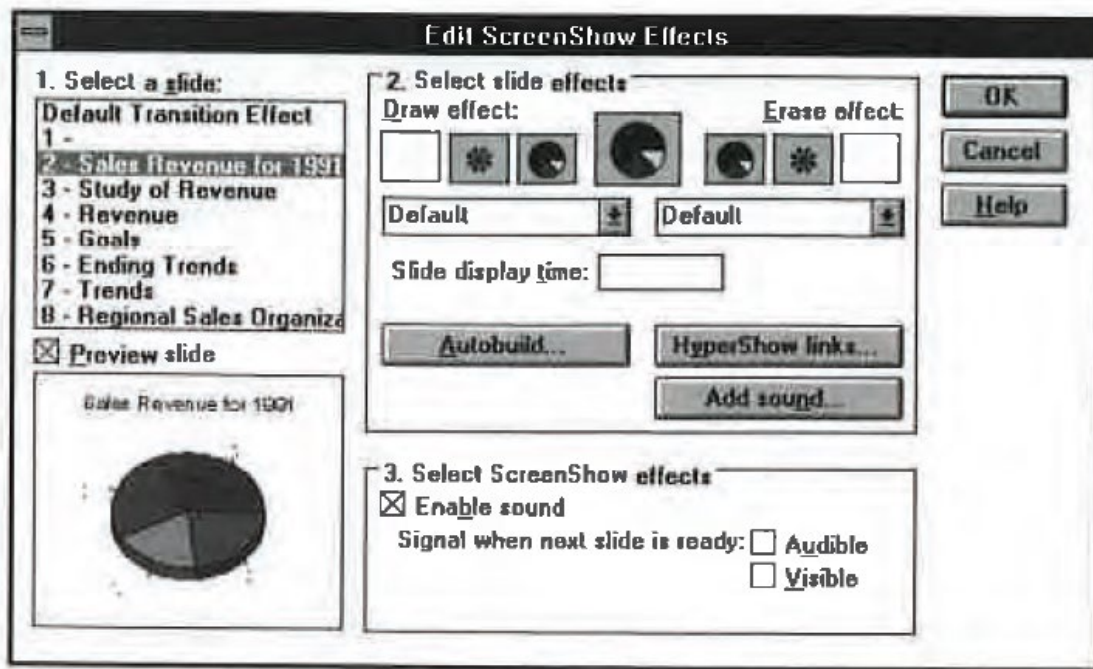


Figure 17.1 shows an “Edit ScreenShow Effects” dialog box, which can be used to set ScreenShow Effects, particularly transition effects from one slide

⁶ When citing to Benedict, we refer to the page numbers added by Petitioner rather than to the book’s native pagination.

to the next. *Id.* at 119–120. These include enabling slides to be shown in a self-running ScreenShow, with a “Slide display time” setting that allows a user to set or change the duration individually selected slides are displayed. *Id.* at 120.

4. *Wolfe*

Wolfe “relates to a system for retrieving information from a database.” Ex. 1014, 1:8–9. In particular, Wolfe “improves a system’s response time so that a user’s request to view new information is serviced quickly.” *Id.* at 1:9–11. This is achieved by preloading information the user is likely to request while the user views other information:

This need can be satisfied by effectively utilizing the time the user spends studying the information on the display screen. In a database system (or document retrieval system) in one embodiment of the present invention, information that the user is likely to eventually request is preloaded into memory while the user is viewing other information. The present invention takes advantage of the fact that it is possible to accurately predict the information that the user will eventually request be shown on the display. The present invention also takes advantage of the fact that the time that the user spends viewing displayed information is often sufficient to advantageously preload a substantial amount of information.

Id. at 2:23–35.

5. *Filepp*

Filepp describes an “interactive computer system network [that] enables a user to display desired information . . . through any of a plurality of

types of personal computers.” Ex. 1007, Abstr. Figure 3a of Filepp is reproduced below.

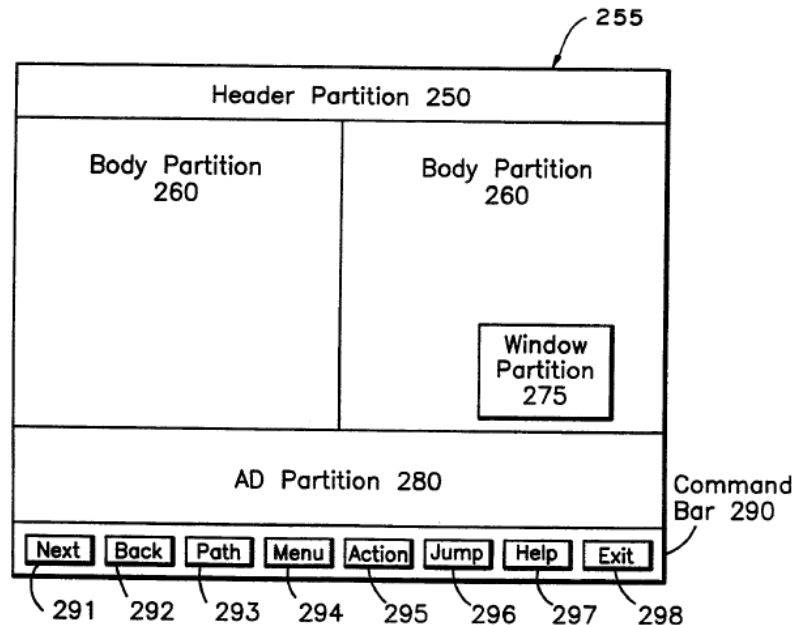


FIG. 3a

Figure 3a illustrates a display screen presented to a user, in which the page is divided into page partitions that include header partition 250, body partitions 260, window partition 275, and ad partition 280. *Id.* at 3:46–47, 8:66–9:3.

Header partition 250 “typically conveys information on the page’s topic or sponsor,” while body partitions 260 and window partition 275 “give[] the informational and transactional content of the page.” *Id.* at 9:10–16. Ad partition 280 “present[s] to the user on an individual basis from queues of advertisements that are construction off-line.” *Id.* at 9:30–34. In addition to “application access and use characteristics,” such advertisements may be presented based on “a variety of other parameters, such as user demographics or postal ZIP code” and other “targeting criteria.” *Id.* at 41–44.

6. *Guinan*

Guinan addresses “disorientation and the quality of information retrieved by the user from the hypertext” with a “guided tour” that is “logically *planned* in such a way that attention is paid to the types on the information links connecting the individual nodes the hypertext before a route through those selected nodes is computer.” Ex. 1008, 7, 9.⁷ After a user enters a natural-language query from which stopwords are removed, hypertext nodes are searched for remaining words and scored with a weighting algorithm. *Id.* at 9–10. To assemble the guided tour, nodes that meet a threshold weight are ordered with a methodology that accounts for different “link types” between nodes, with higher precedence given to those that “define a clear parent-child relationship thereby indicating a distinct hierarchical association between the nodes.” *Id.* at 10.

7. *Robertson*

Robertson describes “a user interface for viewing related documents.” Ex. 1009, 1:6–8. In particular, Robertson displays lists of Web pages “in a book metaphor, termed a WebBook.” *Id.* at 2:25–26. “When displayed, two active pages are displayed at one time,” as illustrated in Figure 3 of Robertson, reproduced below. *Id.* at 2:28–29.

⁷ When citing to Guinan, we refer to the page numbers added by Petitioner, rather than to the article’s native pagination.

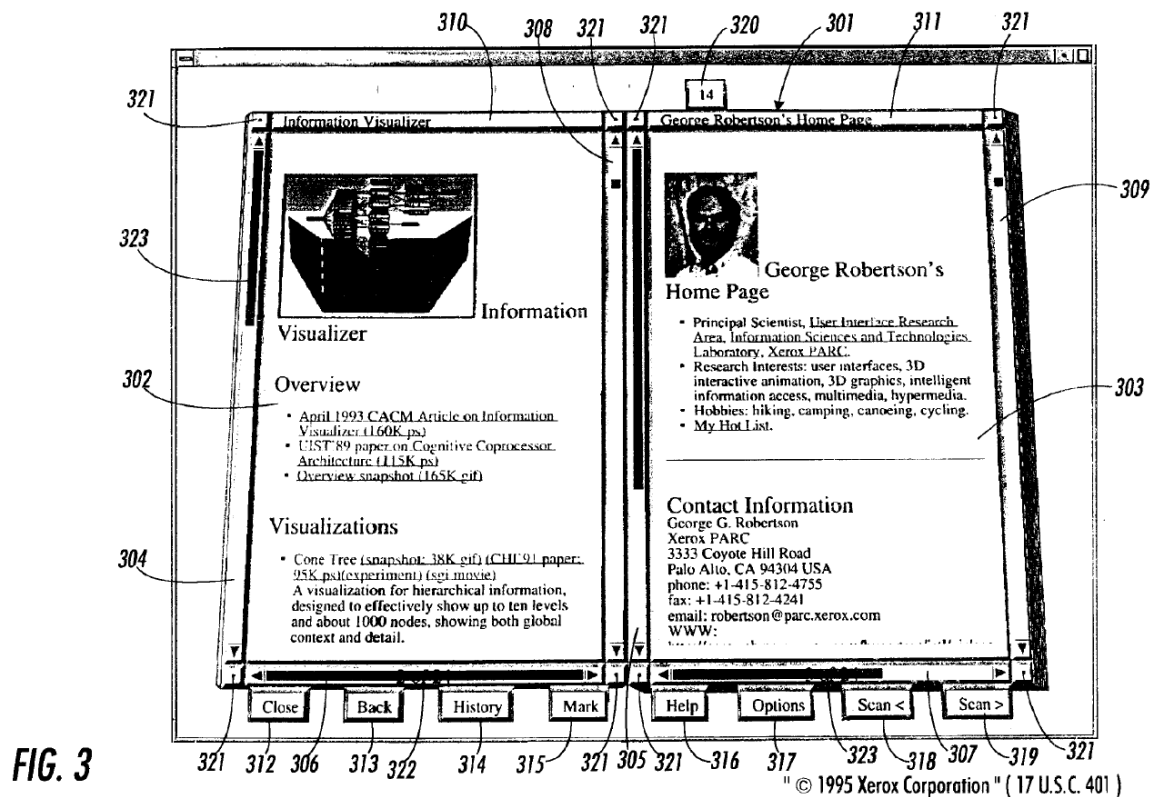


Figure 3 illustrates WebBook 301 displaying first page 302 and second page 303, “each having an identical structure.” *Id.* at 6:15–18. “Each page is provided in the order in which it is to appear in the WebBook. Accordingly, each page will represent either a left page or a right page in the WebBook.” *Id.* at 7:66–8:2.

8. Rakavy

Rakavy relates to “advertisement computer display systems and more particularly to a method and system for displaying advertisements and other information on a computer based on general user selected criteria and transmitting such information from a remote network to the local computer.” Ex. 1018, 1:7–12. Advertisements are selected and transferred to a user’s local computer and displayed. *Id.* at 5:32–36. The system collects user

feedback information and their preferences as the users interact with the advertisements by directly choosing categories of advertising or through interactive games, messages, or requesting/ordering product information. *Id.* at 3:34–47. For example, users may respond to presented advertisements on a scale from “do not show me this advertisement again” to “excellent,” and such “information may be used to modify the user preferences, and may also be incorporated into user feedback information . . . for use by the advertisers.” *Id.* at 10:13–20. Feedback information may also include “the time and length an advertisement was displayed.” *Id.* at 12:63–65.

9. Reilly

Reilly describes “distributing to a set of subscribers’ computers information matching each subscriber’s interests as well as advertising.” Ex. 1015, 1:4–10. In Reilly’s system, an information server stores and updates a database of information items and advertisements that “are each categorized so that each has an associated information category.” *Id.* at 2:63–67. User profiles similarly indicate “which categories and subcategories of news stories are of interest,” and advertisements can be “displayed on subscribers’ workstations simultaneously with news items assigned to the same category as the advertisement.” *Id.* at 5:1–4, 6:51–56.

E. Independent Claim 1

Petitioner challenges independent claim 1 as unpatentable under 35 U.S.C. § 103(a) over Shimizu, Fox, Benedict, Wolfe, and Filepp. Pet. 11–36. Petitioner characterizes its five-reference combination as relying on Shimizu, Fox, and Benedict for “techniques for linking a set of hypertext

nodes so they can be automatically displayed in a particular order and at specified intervals,” with Wolfe cited for “prefetching content during display of other content” and Fileapp cited for “displaying advertising content to the user.” *Id.* at 10. Petitioner provides an element-by-element analysis addressing specific aspects of this combination in greater detail. *Id.* at 11–36.

Because the issue it presents is dispositive, we focus on claim 1’s limitation of “creating a show structure of nodes, each node identifying a resource from a plurality of accessible resources, at least some of which are network accessible resources.” Ex. 1001, 17:47–49. According to Petitioner, “Shimizu discloses a system for defining a set of hypertext nodes and their relationships to other nodes,” and thus discloses “a show structure of nodes.” Pet. 13–14. This aspect of the limitation corresponds in Shimizu, Petitioner says, “to an arrangement or set of nodes, which identify their associated content resources and their links to other nodes.” *Id.* at 14. Petitioner adds that “Shimizu discloses a number of techniques for adding new nodes and rearranging the order of existing nodes” such that Shimizu expressly discloses “creating” the recited “show structure of nodes” or renders such creation obvious. *Id.* at 14–15 (citing Ex. 1003, 7:20–48, 9:5–59; Ex. 1002 ¶ 104).

For the aspect of the limitation that recites “each node identifying a resource from a plurality of accessible resources,” Petitioner focuses on the “node information structure” of Shimizu, particularly the “entity information pointer slot.” *Id.* at 15. Because that slot holds a pointer to “a character string, image information, motion pictures or sounds,” Petitioner reasons

that Shimizu thereby discloses identification of a particular resource from the plurality of resources accessible to the system. *Id.* at 15–16.

Petitioner relies on Shimizu alone or in combination with Fox to meet the aspect of the limitation reciting that “at least some of [the accessible resources] are network accessible resources.” *Id.* at 16–19. In doing so, Petitioner relies on Mr. Schmandt’s testimony to support its contention that Shimizu’s disclosure of storing resources in “secondary storage” would be understood as encompassing storage accessible through a network. *Id.* at 16 (citing Ex. 1003, 6:39–43, 2:49–53; Ex. 1002 ¶ 106). Alternatively, Petitioner relies on Fox’s disclosure of Uniform Resource Locators (“URLs”) as part of a hypertext system: “This would have been a straightforward adaptation; for example, entity information pointer slot 63 of Shimizu could have been readily adapted to hold a URL identifying Web resources on the Internet associated with the node.” *Id.* at 17–18.

According to Petitioner, this analysis “is consistent with claim construction rulings” in the *Microsoft* litigation that we have adopted for purposes of this Decision, at least in light of Benedict’s teachings. *Id.* at 19–23. We disagree.

Petitioner acknowledges that the constructions in the *Microsoft* litigation “further state that a show structure of nodes ‘*specifies the duration of any display,’ and that a node includes ‘*the duration for which the resource’s content is to be presented by default.*’” *Id.* at 20. To support its position that the combination of Shimizu, Benedict, and Fox meets these requirements, Petitioner relies on the following disclosure from Shimizu:*

It follows that, on the hypertext apparatus, it is necessary to set the items of link information with their order of display properly established beforehand. Only this procedure makes it

possible to create an application program that may be displayed on the screen by reading, from primary or secondary storage and *within a predetermined time*, the node information held by the nodes that are linked sequentially starting from a particular node.

Ex. 1003, 3:9–16 (emphasis added). In addition, Petitioner relies on Shimizu’s statement that “[t]his makes it possible to build with ease an application program illustratively causing the display of the nodes to be switched in a specific order and *at predetermined intervals*.” *Id.* at 5:11–14 (emphasis added). Petitioner refers to these disclosures in arguing that “Shimizu discloses a default display time, *i.e.*, a ‘predetermined’ time or interval in which node content is displayed before proceeding to the next node.” Pet. 21. Noting that “Shimizu does not appear to disclose whether the predetermined intervals can be changed by a user,” Petitioner contends that “this would have been obvious in further view of **Benedict**.” *Id.*

But as Patent Owner responds, “even if these ‘predetermined times’ or ‘predetermined intervals’ could be considered relevant default duration parameters, the Petition fails to prove that they would be **included within Shimizu’s hypertext nodes**—*i.e.*, the putative claimed ‘nodes’—as the governing claim construction expressly requires.” Prelim. Resp. 45; *see also id.* at 58–59 (“[T]he passages relied on do not provide any specifics as to *how* duration information would be implemented. Instead, they are merely speculative and aspirational statements, postulating only about what is ‘possible.’ . . . [I]t is not sufficient for Shimizu to simply teach a time interval between nodes. Rather, . . . **the node itself must ‘include . . . the duration** for which the resource’s content is to be presented by default.’ . . . The Petition fails to provide any argument or evidence demonstrating that

the described predetermined intervals are included in Shimizu's nodes." (quoting Ex. 1023, 16 (emphasis by Patent Owner)).

We agree with Patent Owner that "[i]f anything, Petitioner's cited passages appear to suggest to the contrary that these ostensible default duration parameters would instead be features of the application programs used for managing Shimizu's alleged show structures." *Id.* at 45–46; *see also id.* at 59 ("[T]he passages Petitioner relies on teach only that the 'predetermined time' would be associated with the **application program** used to display the nodes."). Several considerations support this understanding of Shimizu, including both Shimizu's disclosure and certain testimony of Petitioner's expert, Mr. Schmandt.

First, the passage that Petitioner cites from Shimizu's Summary of the Invention refers to "an application program" that causes switching of nodes displayed "at predetermined intervals." Ex. 1003, 5:11–14. The other passage that Petitioner cites similarly refers to "an application program" that may be displayed by reading node information within "a predetermined time." *Id.* at 3:12–16. Although not cited by Petitioner, Shimizu also states:

As described, the hypertext apparatus of the invention offers a user interface capable of putting into a desired order the links between the nodes to be managed and of manipulating the established link order. This makes it easy to create illustratively an application program allowing the display of node contents to be switched in a desired order and at predetermined intervals on the hypertext apparatus.

Id. at 9:60–66. All of these passages are more consistent with Patent Owner's position that the predetermined time or intervals are included in the application program rather than in the hypertext nodes. Petitioner does not provide persuasive argument or evidence to show that Shimizu should

instead be read as describing hypertext nodes that include predetermined times or intervals.

Second, we have also considered Mr. Schmandt's testimony, and he provides no meaningful additional information to support reading Shimizu as Petitioner advocates. *See* Ex. 1002 ¶¶ 118, 120–127. In testimony not cited by Petitioner, Mr. Schmandt admits that “Shimizu does not appear to disclose further details about how duration information is specified or stored within its system, or whether such intervals between nodes can be changed.” *Id.* ¶ 119. This testimony undermines Petitioner's position that Shimizu's hypertext nodes include duration information. Mr. Schmandt elaborates in testimony that Petitioner cites, but does not explain:

In a real-world implementation of the proposed combination, for example, the display time could have been specified within the node information structure 9 of Shimizu. I note that node information structure 9 in Shimizu also contains display procedure slot 62 (Fig. 6), which points to “a procedure program function used when the node in question is to be displayed on the screen.” (Shimizu, 6:52–55.) Shimizu thus contemplates that node information structure 9 may contain information about how the node will be displayed to the user, and as such, it would have been obvious that durational information could also have been included as part of node information structure 9. This durational amount could have been a default display time specified by the user, or a display time specific to the node in question, as explained above.

* * *

Shimizu itself clearly contemplates the ability to customize the display of nodes, and as explained above, node information structure 9 (Fig. 6) includes display procedure slot 62 which points to a program function or procedure used to display the node content, thus making clear that node information

structure 9 can hold information about how the node will be displayed.

Id. ¶¶ 123, 127. Mr. Schmandt’s testimony that Shimizu would need to be modified for its hypertext nodes to include duration information is strong evidence that Shimizu does not disclose hypertext nodes that include duration information. This testimony (from ¶ 123) also suggests that Shimizu’s predetermined intervals and times could be included in the procedure program function to which display procedure slot 62 points, rather than in the hypertext node, thereby providing additional evidence Shimizu’s predetermined intervals and times are included in structure other than hypertext nodes. *See also* Ex. 1003, 6:52–55.

To be clear, we also agree with Patent Owner’s characterization of Petitioner’s reliance on Benedict: “Petitioner (correctly) does *not* allege that Benedict discloses nodes consistent with the district court’s claim construction or any other teachings of the ’819 Patent, or even content derived from a plurality of resources.” Prelim. Resp. 57. Instead, Petitioner’s reliance on Benedict is limited to the ability to vary the duration. Pet. 23 (“For example, the content resources of a node would have been displayed for a predetermined (default) interval as disclosed in Shimizu, which the user could have changed in accordance with Benedict.”). Specifically, Petitioner points to Benedict’s ScreenShow as including a text box that allows a user to specify how long to display a selected slide before automatically advancing to the next slide. *Id.* at 21–22. (citing Ex. 1004, 37, 123–134). Petitioner does not argue, and this evidence would not support, that Benedict teaches nodes including duration information.

According to Petitioner, the duration “concepts are related” to “the step of providing interactively variable duration information, representing the duration that said content corresponding to said accessed resource is presented so as to enable a user to vary said duration,” also recited in independent claim 1. Pet. 20; Ex. 1001, 17:60–64. In its analysis of this additional limitation, Petitioner contends that, under its proposed combination of references, “each node would have included a display time that could have been interactively varied by the user—under two separate theories.” Pet. 31 (citing Ex. 1002 ¶¶ 150–153).

First, Petitioner contends that Benedict teaches that “the user can change the display time for one or more nodes using the ScreenShow Effects feature,” and that “[t]he duration information for a node (which specifies how long its content resources will be displayed) can be interactively varied by a user.” *Id.* at 31–32 (citing Ex. 1002 ¶¶ 150–153). Neither Petitioner nor Mr. Schmandt’s supporting testimony explains what corresponds to a node in Benedict or explains why Benedict should be read as teaching nodes. According to Petitioner’s first theory, the interactively variable duration parameter recited in the claim “corresponds to the display time advancing to the next node, which takes the form of a predetermined (default) value as disclosed in Shimizu, which the viewer can change as disclosed in Benedict.” *Id.* at 33. But Petitioner does not persuasively show that Shimizu teaches nodes that include duration information, nor shows that Benedict supplies that teaching.

Second, Petitioner asserts that “Patent Owner in the pending litigation appears to be taking the position that [the ‘interactively variable duration information’] limitation is satisfied by a user’s ability to skip to another node

during display of node content.” *Id.* at 32. “Petitioner does not concede that this functionality satisfies the claim, but even if it did, a user viewing the content resource for a node under the proposed combination can simply press a button during display of content to immediately advance to the next node.” *Id.* (citing Ex. 1004, 121, 124). Under this second theory, “the user in the proposed combination could have shortened the display duration by immediately advancing to the next node.” *Id.* (citing Ex. 1002 ¶ 151).

According to Petitioner, “to the extent the claim were construed to encompass skipping functionality, the parameter corresponds to the amount of time the software waits when displaying a current node before automatically advancing to the next node.” *Id.* at 33 (citing Ex. 1002 ¶ 153). This second theory suffers from the same deficiency as the first theory, namely that Petitioner does not persuasively show that Shimizu teaches nodes that include duration information, nor shows that Benedict supplies that teaching.

F. Independent Claims 23 and 26

Petitioner challenges independent claims 23 and 26 over Shimizu, Fox, Benedict, Wolfe, and Filepp. Pet. 46, 48. Petitioner accurately asserts that claims 23 and 26 are “identical” to independent claim 1, with one respective exception each—claim 23 requires further advertisement content to be presented to the user “in a persistent content window” and claim 26 requires “targeted” advertisement content. *Id.* 46, 48.

These differences do not meaningfully impact our analysis. Each of independent claims 23 and 26 recites the same limitation as independent claim 1 requiring “creating a show structure of nodes, each node identifying

a resource from a plurality of accessible resources, at least some of which are network accessible resources.” Ex. 1001, 19:14–16, 20:8–10. And for this limitation, in each of claims 23 and 26, Petitioner relies on the analysis we discuss at length above with respect to independent claim 1. Pet. 46, 48. For the same reasons we discuss for independent claim 1, Petitioner’s showing is insufficient that a “show structure of nodes” that specify a default display duration (as required by our adopted construction) is created within the combination.

We conclude that Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge of independent claims 23 and 26 as unpatentable under 35 U.S.C. § 103(a) over Shimizu, Fox, Benedict, Wolfe, and Filepp.

G. Independent Claim 16

Petitioner challenges independent claim 16 as unpatentable under 35 U.S.C. § 103(a) over Shimizu, Fox, Benedict, Wolfe, Filepp, and Guinan, Pet. 48–54. As Petitioner asserts, “[c]laim 16 is similar to claim 1,” but recites additional features that relate to an “online search.” *Id.* at 48. Petitioner’s analysis is correspondingly similar, but applies Guinan in the six-reference combination to address those additional limitations. *Id.* at 49–54.

Petitioner’s reliance on Guinan arises when addressing multiple limitations of the claim, most notable when addressing the requirement of “creating a show structure of nodes based on said search results, each node identifying a resource from a plurality of accessible resources, at least some of which are network accessible resources.” *Id.* at 53–54; Ex. 1001, 18:43–

46. Petitioner agrees that “[t]his limitation is substantially identical” to the limitation we address at length above in the context of independent claim 1, “the sole difference” being that the limitation of claim 16 requires that the show structure be “based on said search results.” Pet. 53. Petitioner relies on Guinan for that aspect, but “[f]or all other aspects of the creating step,” relies on the analysis Petitioner presents for independent claim 1. *Id.* For the same reasons we discuss for independent claim 1, Petitioner’s showing is insufficient that a “show structure of nodes” that specify a default display duration (as required by our adopted construction) is created within the combination.⁸

We conclude that Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge of independent claim 16 as unpatentable under 35 U.S.C. § 103(a) over Shimizu, Fox, Benedict, Wolfe, Filepp, and Guinan.

H. Dependent Claims 2–15, 17–22, 25, and 27–30

Petitioner challenges claims 2–15, 25, 27, and 28 as unpatentable under 35 U.S.C. § 103(a) over Shimizu, Fox, Benedict, Wolfe, and Filepp, Pet. 36–48; claims 17–22 as unpatentable under 35 U.S.C. § 103(a) over Shimizu, Fox, Benedict, Wolfe, Filepp, and Guinan, *id.* at 54–61; claim 22 as unpatentable under 35 U.S.C. § 103(a) over Shimizu, Fox, Benedict, Wolfe, Filepp, Guinan, and Robertson, *id.* at 61–63; claims 13 and 29 as

⁸ Independent claim 16 does not recite “interactively variable duration information.” Those aspects of our analysis of independent claim 1 that address Petitioner’s arguments for such a recitation in the claim accordingly to do not apply to independent claim 16.

unpatentable under 35 U.S.C. § 103(a) over Shimizu, Fox, Benedict, Wolfe, Filepp, and Rakavy, *id.* at 64–68; and claim 30 as unpatentable under 35 U.S.C. § 103(a) over Shimizu, Fox, Benedict, Wolfe, Filepp, and Reilly, *id.* at 68–71. Although we have reviewed Petitioner’s analysis of these challenges, each of the challenged dependent claims depends from one of independent claims 1, 16, 23, or 26, and thus includes either the “creating a show structure of nodes” limitation that we discuss in detail in the context of independent claim 1, or (in the case of claims 17–22, dependent from independent claim 16), a minor variation of that limitation. Because that analysis is deficient for the independent claims, it is also deficient for the challenged dependent claims.

We accordingly conclude that Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenges of claims 2–15, 17–22, 25, and 27–30.

IV. DISCRETION UNDER 35 U.S.C. § 314(a)

Patent Owner asks that we exercise our discretion to deny the Petition under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) in light of the stage of the related litigation. Prelim. Resp. 15–23. Because we deny the Petition on the merits, we do not reach this request.

V. CONCLUSION

For the foregoing reasons, we conclude that the information presented in the Petition does not establish a reasonable likelihood that Petitioner would prevail in showing that at least one of claims 1–23 and 25–30 of the

IPR2023-00594
Patent 8,606,819 B2

'819 patent is unpatentable. Accordingly, we deny the Petition and decline to institute an *inter partes* review.

VI. ORDER

In consideration of the foregoing, it is
ORDERED that the Petition is *denied*, and no trial is instituted.

IPR2023-00594
Patent 8,606,819 B2

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