

IPR2023-00621 (U.S. Patent No. 8,020,083)
PO's Preliminary Response

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

DODOTS LICENSING SOLUTIONS LLC,
Patent Owner.

Case IPR2023-00621
U.S. Patent No. 8,020,083 B1

**PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR
INTER PARTES REVIEW OF UNITED STATES PATENT NO. 8,020,083**

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION.....	1
II. THE '083 PATENT.....	5
A. Background of the claimed invention.	5
B. The previous Lenovo '083 IPR.	9
III. THE LEVEL OF ORDINARY SKILL IN THE ART.	12
IV. CLAIM CONSTRUCTION.	13
V. THE LEGAL STANDARD FOR OBVIOUSNESS.....	13
VI. INSTITUTION SHOULD BE DENIED FOR TWO THRESHOLD REASONS.	15
A. Petitioner applies the incorrect claim construction standard under 37 C.F.R. 42.100(b).....	15
B. Petitioner fails to meet the requirements of §§ 37 C.F.R. 42.104(b)(3) and 42.104(b)(4).....	17
1. Petitioner violates both 42.104(b)(3) and 42.104(b)(4).....	18
2. Petitioner fails to identify specific portions of the specification that describe the structure for a supposed means-plus-function limitation.	20
VII. PETITIONER FAILS TO MEET ITS BURDEN OF PRODUCTION.	23
A. Petitioner fails to meet its burden of production with respect to challenged claims 9-16.....	23
1. Petitioner fails to meet its burden of production with respect to its Ground 1A, Ground 1B and Ground 2 arguments because it relies on references without establishing their critical date.....	26
VIII. PETITIONER HAS FAILED TO SHOW A REASONABLE LIKELIHOOD OF SUCCESS FOR ANY OF GROUNDS 1A, 1B AND 2.	27

A.	Petitioner neither establishes the critical date for the Beer and Petty references nor does it explain how or why a POSITA would combine Beer or Petty with <i>inter alia</i> Brown.	29
B.	Petitioner neither establishes the critical date for the Darnell reference nor does it explain how or why a POSITA would combine Darnell with <i>inter alia</i> Brown.	30
C.	Petitioner neither establishes the critical date for Jones nor does it explain how or why a POSITA would combine Jones with Brown or why Brown and Jones should be treated as one reference.	31
D.	Petitioner neither establishes the critical date for Yohanan nor does it explain how or why a POSITA would combine Yohanan with Brown, Jones, Beer, Petty or Darnell, or with Shimada and Bucholz.	32
E.	Petitioner fails to demonstrate how a local HTML file in Shimada that includes content that is presented on an alleged NIM meets “a content reference that comprises a network location at which content for the first networked information monitor is accessible via a TCP/IP protocol.”	33
IX.	THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE BOARD UNDER 35 U.S.C. § 314(A).	37
A.	The district court case is not stayed nor is there any evidence that a stay will be granted if the IPR were instituted.	40
B.	Proximity of the district court’s trial date to the Board’s projected statutory deadline for a final written decision.	40
C.	Both the district court and the parties have made significant investments in the parallel district court case.	41
D.	There is significant overlap between the issues raised in the petition and in the parallel district court case.	42
E.	Petitioner and defendant in the parallel litigation are the same party.	43
F.	Other circumstances favor the Board exercising its discretion to deny institution, including the merits.	43

X.	CONCLUSION.....	43
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TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Adaptics Limited, v. Perfect Company</i> IPR2018-01596, Paper 16 (P.T.A.B. January 24, 2019)	19
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (P.T.A.B. March 20, 2020)	<i>passim</i>
<i>Apple Inc. v. Samsung Elecs. Co.</i> , 839 F.3d 1034 (Fed. Cir. 2016)	14
<i>Canadian Solar Inc. v. The Solaria Corporation</i> , IPR2021-00095, Paper 12, 11 (P.T.A.B. 2021)	41
<i>Carefusion Corporation v. Baxter International, Inc.</i> , IPR2016-01456, Paper 9 (P.T.A.B. February 6, 2017)	22, 23
<i>Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.</i> , IPR2020-00122, Paper 15 (P.T.A.B. May 15, 2020)	40
<i>Clickbooth.com LLC v. Essociate, Inc.</i> , IPR2015-00464, Paper 9 (P.T.A.B. July 9, 2015)	21
<i>Floteck Indus., Inc. v. Nat'l Oilwell DHT, L.P.</i> , IPR2015-01210, Paper 11 (P.T.A.B. Nov. 6, 2015)	20
<i>Forest Lab 'ys, LLC v. Sigmapharm Lab 'ys, LLC</i> , 918 F.3d 928 (Fed. Cir. 2019)	14
<i>Google, LLC. v. Personalized Media Comm., LLC.</i> , IPR2020-00723, Paper 22 (P.T.A.B. August 31, 2020)	40
<i>Graham v. John Deere Co. of Kansas City</i> , 383 U.S. 1 (1966)	14
<i>Harmonic Inc. v. Avid Tech., Inc.</i> , 815 F.3d 1356, 2016 U.S. App. LEXIS 3727, 118 U.S.P.Q.2D (BNA) 1198	16

<i>Hebert v. Lisle Corp.</i> , 99 F.3d 1109 (Fed. Cir. 1996)	16
<i>KSR Int'l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	14
<i>Lenovo Holding Co. v. DoDots Licensing Sols. LLC</i> , 2021 U.S. App. LEXIS 36126 (Fed. Cir. Dec. 8, 2021).....	1, 6, 7
<i>Lindsay Corporation v. Valmont Industries</i> , IPR2015-01039, Paper 7 (P.T.A.B. Sept. 24, 2015).....	20
<i>Medshape, Inc. v. Cayenne Med., Inc.</i> , IPR2015-00848, Paper 9 (P.T.A.B. Sep 14, 2015).....	21
<i>Microsoft Corp. v. Corel Software, LLC</i> , Case No. IPR2016-01300 (P.T.A.B. Jan. 4, 2016).....	30
<i>Ex parte Miyazaki</i> , 89 U.S.P.Q.2d 1207 (BPAI Nov. 19, 2008)	21
<i>Next Caller Inc. v. TrustID, Inc.</i> , IPR2019-00961, -00962 Paper 10, (P.T.A.B. Oct. 16, 2019)	40
<i>NHK Spring Co., Ltd. v. Intri-plex Technologies</i> , IPR2018-00752, Paper 8, 11 (P.T.A.B. 2018).....	38
<i>In re Novatel</i> , 846 F. Supp. 2d at 1107-08.....	16
<i>Parus Holdings, Inc. v. Google LLC</i> , 2023 U.S. App. LEXIS 14543 (Fed. Cir. 2023)	23, 24, 25
<i>Phillips v AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (en banc)	13, 15, 18, 19
<i>Sand Rev'n II LLC v. Cont'l Intermodal Grp. – Trucking LLC</i> , IPR2019-01393, Paper 24 (P.T.A.B. June 16, 2020)	42
<i>SAS Institute, Inc. v. Complementsoft, LLC</i> , IPR2013-00226, Paper 9 (P.T.A.B. Aug. 12, 2013).....	20

<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020)	4, 38, 42
<i>Square, Inc. v. J. Carl Cooper</i> , IPR2014-00158, Paper 10 (P.T.A.B. May 15, 2014)	29
<i>Standard Innovation Corp. v. Lelo, Inc.</i> , IPR2014-00148, Paper No. 41 (P.T.A.B. April 23, 2015)	31
<i>Stryker Corp. v. Karl Storz Endoscopy</i> , IPR2015-00764 Paper 13 (P.T.A.B. Sept. 2, 2015).....	29
<i>TRW v. Magna Elecs.</i> , IPR2015-00972, Paper 9 (P.T.A.B. Sept. 16, 2015).....	29

Statutes

35 U.S.C. 102	18
35 U.S.C. 112(f)	17
35 U.S.C. 282(b)	15
35 U.S.C. § 103	13, 14, 28
35 U.S.C. § 282(b)	13
35 U.S.C. § 314(A)	4, 37
35 U.S.C. § 316(a)(11).....	40
35 U.S.C. § 316(e)	17

Other Authorities

37 C.F.R. 42.100(b)	15
37 C.F.R. 42.104(b)(3).....	15, 17
37 C.F.R. § 42.6(a)(3)	3
37 C.F.R. § 42.22	3, 23
37 C.F.R. § 42.24(a).....	3

37 C.F.R. § 42.24(a)(i).....	25
37 C.F.R. § 42.62	2
37 C.F.R. §§ 42.100 and 104	43
37 C.F.R. § 42.100(b)	13, 17
37 C.F.R. §§ 42.100(b), 42.104(b)(3), and 42.104(b)(4).....	2
37 C.F.R. §§ 42.104(b)(3).....	<i>passim</i>
37 C.F.R. §§ 42.104(b)(3), and 42.104(b)(4)	2, 3
37 C.F.R. § 42.104(b)(4).....	18
Fed. R. Evid. 702(d).....	16
Federal Rule of Evidence 702.....	2

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	<i>Lenovo Holding Co, Inc. et al. v. DoDots Licensing Sols.</i> , IPR2019-01278 (P.T.A.B. Jan. 19, 2021)
2002	<i>Lenovo Holding Co. v. DoDots Licensing Sols. LLC</i> , 2021 U.S. App. LEXIS 36126, at *2 (Fed. Cir. Dec. 8, 2021)
2003	Defendants' Proposed Claim Constructions, dated March 1, 2023
2004	Fintiv Memo, dated June 21, 2022
2005	Agreed Scheduling Order, dated December 29, 2022

Patent owner DoDots Licensing Solutions LLC (“DoDots” or “patent owner”) submits this Patent Owner Preliminary Response to Samsung Electronics Co., Ltd.’s (“petitioner” or “Samsung”) petition (Paper No. 2, “Petition”) and requests the Board to deny institution of *inter partes* review of claims 1-16 (“the challenged claims”) of U.S. patent no. 8,020,083 (“’083 patent,” Ex. 1001).

I. INTRODUCTION.

Petitioner asks the Board to institute an *inter partes* review of the ’083 patent, which DoDots has asserted in a concurrently-pending district court litigation. But this Board has once before already determined that the ’083 patent is *not* unpatentable in a previous IPR brought by Lenovo Holding Co (“Lenovo ’083 IPR”). Ex. 2001 Paper 37. The Federal Circuit affirmed the Board’s final written decision. *See Lenovo Holding Co. v. DoDots Licensing Sols. LLC*, 2021 U.S. App. LEXIS 36126, at *2 (Fed. Cir. Dec. 8, 2021).

In the Lenovo ’083 IPR the Board and the Federal circuit honed in on the Petitioner’s attempt to conflate Network Information Monitor (“NIM”) and Network Information Monitor Template (“NIM Template”). And in affirming the Board’s decision, the Federal Circuit held a NIM Template is a data structure that defines the characteristics of a NIM, including the NIM frame, view and control characteristics, and that excludes executable applications/compiled code. *See* Ex 2001 at page19. *See* Ex. 2002.

Here, there are at least six reasons why the Board should deny institution.

First, the Board should deny institution because the petition rests on a completely wrong legal standard. The evidence petitioner submits through the declaration of Dr. Schmidt relies on the incorrect broadest-reasonable-interpretation (BRI) standard for claim construction. Thus, petitioner's entire invalidity analysis is legally flawed, and Dr. Schmidt's declaration should be disregarded under Federal Rule of Evidence 702 and 37 C.F.R. § 42.62. This defect in the petition affects all claims challenged in the IPR. For this reason alone, the petition cannot meet the threshold requirements set forth in 37 C.F.R. §§ 42.100(b), 42.104(b)(3), and 42.104(b)(4) and institution should be denied.

Second, independent of the inapplicable BRI standard, petitioner fails to meet its threshold burden of production requirements set forth in 37 C.F.R. §§ 42.104(b)(3), and 42.104(b)(4). Petitioner has taken up contradictory and irreconcilable positions on claims terms in the district court and *even within* this IPR. To preserve its rights in the district court, petitioner adopts the patent owner's construction "only for this IPR," but then fails to offer a construction as required under 37 C.F.R. §§ 42.104(b)(3) for a means-plus-function claim limitation. Samsung's failure to set forth a construction it believes is correct, and the failure to provide any support for the means-plus-function term are independent grounds for denial. This defect in the petition affects all challenged claims. The Board has

consistently denied IPR petitions that fail to meet the threshold requirements set forth in 37 C.F.R. §§ 42.104(b)(3) and 42.104(b)(4).

Third, petitioner has failed to show a reasonable likelihood of success for any of grounds 1A, 1B, and 2 because the petitioner has not met its burden of production nor met its burden of persuasion. The petition does *not* set forth the prior art date for the majority of its references, nor does the petition state any rationale whatsoever to combine the references it discusses and relies on. These defects in the petition affect all challenged claims. Thus, for this reason alone, the petition should be denied based on petitioner's failure to particularly point out the grounds on which the petitioner relies.

Fourth, the petition should be denied based on 37 C.F.R. § 42.22 (requiring petitions to include a detailed explanation of the significance of the evidence). In an effort to get around the word limit for its brief, petitioner incorporates by reference extensively throughout the petition and as a result of this cursory and improper approach, fails to particularly point out the evidence it purportedly relies on and provide a detailed explanation of the significance of the evidence. *See* 37 C.F.R. § 42.24(a) (limiting word count to 14,000 words) and 37 C.F.R. § 42.6(a)(3) (prohibiting incorporation by reference). These defects in the petition affect all challenged claims. For this reason alone, the petition should be denied

based on petitioner's failure to particularly point out the grounds and evidence on which petitioner relies.

Fifth, petitioner has failed to show a reasonable likelihood of success for ground 2 because petitioner does *not* explain how a local HTML file of Shimada that includes content that is presented on a purported NIM meets "a content reference that comprises a network location at which content for the first networked information monitor is accessible via a TCP/IP protocol," as all challenged claims require. For this reason alone, the petition should be denied based on petitioner's failure to show a reasonable likelihood of success for ground 2.

Sixth, the petition should be discretionarily denied notwithstanding the merits under 35 U.S.C. § 314(A) because petitioner asks the Board to institute an *inter partes* review of the '083 patent, which DoDots has asserted in a concurrently-pending district court litigation. Samsung's *Sotera* waiver is inadequate and will not prevent concurrent proceedings from wasteful duplication. Also, it is expected that the Board's final written decision will come two months after the underlying district court litigation goes to trial and is resolved.

II. THE '083 PATENT.

A. Background of the claimed invention.

In the late 1990s, more than seven years before the first iPhone was released, the inventors John and George Kembel (twin brothers and Stanford University alumnae) developed “dot” technology, which today is known as the mobile app. The '083 patent, titled “System and Methods for Creating and Authoring Internet Content Using Application Media Packages,” discloses the fundamental technology used in modern-day mobile apps and the stores used to download and install those apps onto mobile devices (e.g., Apple App Store and Samsung Galaxy Store).

At that time of the invention, accessing Internet content involved the use of downloaded web browsers running on a personal computer or mobile device. But web browsers were limiting and hindered the way in which web content was viewed on mobile devices. For example, users and application developers had limited control over the presentation of internet content; content was essentially trapped within the frame of the browser. *See* Ex. 1001 ('083 patent) 2:5-23. The Kembels recognized early on that there was dissatisfaction with web browsers and there was a “growing desire for individual users to fully control the aggregation and presentation of content and web applications that appear on a client computer.” *See Id.* at 2:32-36. The Kembels sought to eliminate the need for web browsers. To

do so, they developed an approach of delivering content over the Internet outside a web browser. Notably, when the Kembels conceived of their patented technology, there was no word for mobile apps. So, the Kembels coined the terms “dot” or “Network Information Monitor (NIM)” —which today are colloquially referred to as an app. These “dots” are “fully configurable frame[s] with one or more controls” through which content is presented on the display of a device and viewed by the user. *See Id.* 5:42-43.

At the time of invention described in the '083 patent (i.e., in the late 1990s), web browsers (e.g., Microsoft Internet Explorer, Netscape Navigator) were installed on computers and used to retrieve and display websites and their webpages. A person would manually navigate between the different webpages of a website by e.g., (1) entering a webpage in a URL entry field, or (2) using forward and backward browsing buttons to move between web pages. The '083 patent changed this paradigm.

As the Federal Circuit noted in *Lenovo Holding Co.*, 2021 U.S. App. LEXIS 36126, at *2 (Fed. Cir. Dec. 8, 2021), DoDots' patents “relate to a method for accessing and displaying Internet content in a graphical user interface (“GUI”).”

The NIM (mobile app), which is generated by the NIM template, is a “fully configurable frame with one or more controls; the frame through which content is optionally presented. The configurable frame used in accordance with the

invention stands in contrast to present web browsers, which are branded by the browser vendor and which have limited means by which to alter the controls associated with the browser.” Ex. 1001 (’083 patent), 5:42-48. And a NIM developer (Mobile App Developer) “has full control over all aspects of the appearance and functionality of NIM frame 137. Thus, a NIM developer has the ability to control, for example, the functionality located at any corner of frame 137, functionality placed along the top or bottom of the frame, or on the sides of the frame.” *Id.* at 17:41-45. Such customizability provided added flexibility over traditional web browsers.

Figure 8 of the ’083 patent further describes how a NIM template is delivered to user’s device to eventuate the installation of a NIM (i.e., an app):

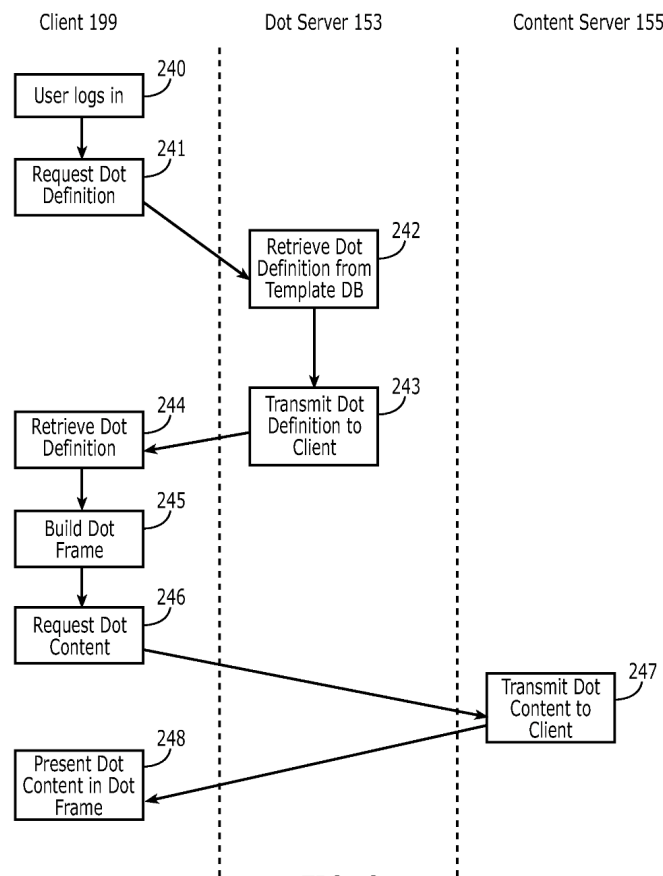


FIG. 8

See '083 Patent, Fig. 8. The process is similar to how users today download and execute apps from the Apple App Store or the Samsung Galaxy Store. Specifically, a NIM template is transmitted by TCP/IP as XML to define the Dot that will receive content and interaction for a user over a network. When the user “clicks on the name of a NIM” [i.e., the name of the app], a request is sent “to the applications server 50 via the transmission channel 44 (step 241).” *Id.* at 20:7-17. The client computing device then retrieves the NIM definition from the NIM template database” (app store), installs the app using information in the .apk file

(NIM template) and, when the user runs the app, creates a frame in the display of the user interface. *Id.* at 20:17-50. Put another way, the patent lays out the process for delivering both the data defining the creation of a NIM and also retrieving the content to be displayed within the frame of the NIM.

B. The previous Lenovo '083 IPR.

In the Lenovo '083 IPR, the Board found that the '083 patent discloses, in part, a software component for accessing and displaying network content. *See* Ex. 2001 at 4. This component, termed an “Application Media Package” or “Dot,” is a “fully configurable frame with one or more controls” with content optionally presented through the frame. *Id.* When a user opens a Dot, the frame is presented in the user's display, and network content is retrieved and presented in a viewer enclosed by the frame. *Id.* The network content may be identified via URLs included in the Dot. *Id.* The specification explains that the Dot “stands in contrast to present web browsers, which are branded by the browser vendor and which have limited means by which to alter the controls associated with the browser.” *Id.* A server may store a number of Dots and provide a Dot to a client system upon request. *Id.* at 5. A user at the client system may then store or use the Dot. *Id.*

One key dispute in the prior Lenovo IPR proceeding related to the construction of the term “networked information monitor template” (“NIM template”), which is referred to as an Application Media Package template in

the '083 patent. The Board concluded (and the Federal Circuit affirmed) that this term means “a data structure that defines the characteristics of a NIM, including the NIM frame, view, and control characteristics, [which] excludes executable applications/compiled code.” *See* Ex. 2001 at 13, Ex. 2002. Though the construction itself is important, the reasons for reaching this construction are equally important.

The Board noted that according to the specification, “[e]ach Application Media Package template *defines* the characteristics of a specific Application Media Package, including fully configurable frame characteristics, viewer and control characteristics, and Application Media Package content references.” Ex. 2001 at 14 (citing '083 patent at 7:19–23 and 24:12–14). The Board further agreed with the patent owner that with respect to “the definition of the NIM,” the definition is “content, rather than compiled code,” and Figure 8 shows that a “Dot Frame” is “buil[t]” on a client computer after the “Dot Definition” is retrieved from a server. *Id.* at 11. Additionally, the Board also agreed with DoDots that the NIM templates are significantly smaller than the NIMs they define. *Id.* at 11-12.

And the Board reviewed the use of NIM template in the claims and noted that “the NIM template defines a NIM and comprises a content reference, a definition of a graphical user interface including a frame, and instructions configured to cause the NIM to request content from the network location in the

content reference and to generate the graphical user interface (“GUI”) with received content within the frame.” Ex. 2001 at 14.

Though the Board noted that the meaning of a NIM template is not specifically defined in the '083 patent specification, the patent makes clear that each NIM template “defines the characteristics of a specific Application Media Package, including fully configurable frame characteristics, viewer and control characteristics, and Application Media Package content references.” *Id.*

As the '083 specification points out, “[u]nlike a downloadable, custom, client-application (e.g., for delivering custom web applications to users’ desktops), an Application Media Package is entirely content.” Ex. 1001 ('083 patent) at 8:53-56. Moreover, this definition “is content, rather than compiled code, which provides additional flexibility at the client side should it be desired to modify the definition” *Id.* at 14:45-60. The specification says that “[a] A Dot developer can author a new Dot application by developing web content (HTML, GIF files, etc.) and by packaging that content in a Dot Definition, eliminating the need for compilers and consequently, downloading executables.” *Id.* at 40:24-28.

The Board concluded that “[f]rom these disclosures, we understand that the Specification prohibits the NIM template from using compiled code or being an executable application. Our review of the Specification did not identify disclosure of use of compiled code or an executable application as the NIM template.” Ex.

2001 at 15. In rejecting Lenovo's arguments, the Board held that "a NIM template is content, rather than compiled code, and that using a Dot Definition eliminates the need for downloading executables apply to all NIM templates, not just one particular embodiment. The Specification does not describe any NIM template that uses compiled code or executable applications." Ex. 2001 at 15-16. In other words, the Board found *unpersuasive* Lenovo's argument that "a NIM template might contain any binary content, including executable code." Ex. 2001 at 16 (internal quotes omitted).

In summarizing its position, the Board stated, "[t]he Specification does not describe any NIM template that uses compiled code or executable applications. Rather, the Specification provides that "[t]he Dot Definition 104 contains just enough information to define, layout, and initialize a Dot's components (frame, controls, etc.)" and "[t]he definition is content, rather than compiled code." Ex. 2001 at 17.

Based on its constructions, the Board found that the prior art Lenovo relied on did not render the '083 patent unpatentable.

III. THE LEVEL OF ORDINARY SKILL IN THE ART.

In the Lenovo '083 IPR, the Board found that a person of ordinary skill in the art "would have a bachelor's degree in electrical or computer Engineering, Computer Science, or a related field and have three or more years of corresponding

industry work experience.” Ex. 2001 at 8. DoDots agrees that this is the correct standard for a POSITA and Samsung has also adopted this definition. Therefore, there is no dispute about the skill level of a POSITA.

IV. CLAIM CONSTRUCTION.

In an *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b), including construing the claims in accordance with the ordinary and customary meaning of such claims 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). The proper claim construction standard is the one set forth in *Phillips v AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

Here, as discussed below, petitioner relies on Dr. Schmidt to argue that claims 1-16 of the '083 patent are allegedly invalid as being obvious under Section 103. But Dr. Schmidt applies the completely wrong claim construction standard in forming his opinions. Because petitioner's grounds for invalidity are framed and supported under a completely wrong legal standard, its petition must be denied.

V. THE LEGAL STANDARD FOR OBVIOUSNESS.

The question of obviousness is resolved based on 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) where in evidence, so called secondary considerations.

Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17–18 (1966). A claim is only unpatentable under 35 U.S.C. § 103 if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the 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) (quoting 35 U.S.C. § 103).

“An invention is not obvious simply because all of the claimed limitations were known in the prior art at the time of the invention. Instead, we ask ‘whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success.’” *Forest Lab ’ys, LLC v. Sigmapharm Lab ’ys, LLC*, 918 F.3d 928, 934 (Fed. Cir. 2019). “Of course, concluding that the references are within the scope and content of the prior art to be considered for obviousness does not end the inquiry. *Graham* makes clear that the obviousness inquiry requires a determination whether the claimed invention would have been obvious to a skilled artisan” at the time of the invention. *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1050 n.14 (Fed. Cir. 2016).

VI. INSTITUTION SHOULD BE DENIED FOR TWO THRESHOLD REASONS.

Samsung's petition should be denied for two threshold reasons: (1) the petitioner uses the incorrect BRI claim-construction standard to analyze whether the disclosures in the prior art render the challenged claims obvious; and (2) the petitioner fails to meet its burdens set forth in §§ 37 C.F.R. 42.104(b)(3) and 42.104(b)(4).

A. Petitioner applies the incorrect claim construction standard under 37 C.F.R. 42.100(b).

For an *inter partes* review proceeding, 37 C.F.R. 42.100(b) states that “a claim of a patent *shall* be construed using 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.” In other words, in an IPR, the P.T.A.B. should construe a claim term using the *Phillips* standard that both the Federal Circuit and district courts use in litigation. Samsung acknowledges as much in its petition. *See* petition at 2. Because attorney argument is *not* evidence, however, Samsung relies entirely on the declaration of its expert Douglas C. Schmidt to support all of its invalidity grounds. Indeed, throughout its petition, Samsung cites to and incorporates Dr. Schmidt's opinions on what the prior art

supposedly discloses and why those disclosures allegedly render the challenged claims obvious. But in his declaration, Dr. Schmidt unequivocally states that he uses the BRI standard to interpret the challenged claims:

I understand that, for purposes of my analysis in this *inter partes* review proceeding, the terms appearing in the patent claims should be interpreted according to their *broadest reasonable construction in light of the specification of the patent in which it appears*.

Ex. 1003 at 16 (emphasis added, internal quotations omitted).

Mr. Schmidt's failure to apply the correct legal standard when construing claim terms disqualifies his testimony. Fed. R. Evid. 702(d) (requiring an expert "reliably appl[y] the principles and methods to the facts of the case"); *See also In re Novatel*, 846 F. Supp. 2d at 1107-08; *Hebert v. Lisle Corp.*, 99 F.3d 1109, 1117 (Fed. Cir. 1996) (finding an expert's testimony inadmissible because the expert applied the wrong legal standard).

Construing a challenged claim under an incorrect legal standard is an error of law and results in the Petitioner failing to meet its burdens of production and persuasion. *See e.g., Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363, 2016 U.S. App. LEXIS 3727, *8, 118 U.S.P.Q.2D (BNA) 1198, 1202 (holding that in an IPR, "the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.") *See also Dynamic Drinkware*, 800 F.3d at 1378. ("In an *inter partes* review, the burden of persuasion is on the petitioner to

prove 1 ‘unpatentability by a preponderance of the evidence,’ 35 U.S.C. § 316(e), and that burden never shifts to the patentee.”) In other words, based on Dr. Schmidt’s failure to apply the right claim construction standard, Samsung necessarily cannot meet its burden of production and burden of persuasion under 37 C.F.R. 42.104(b)(3). Having failed to use the appropriate claim construction standard, the petitioner cannot, as required in *Dynamic Drinkware*, prove “unpatentability by a preponderance of the evidence.” Samsung’s failure to comply with 37 C.F.R. §§ 42.100(b) warrants denial of Samsung’s petition.

B. Petitioner fails to meet the requirements of §§ 37 C.F.R. 42.104(b)(3) and 42.104(b)(4).

42.104(b)(3) requires Petitioner to provide a statement detailing “[h]ow the challenged claim is to be construed.” This provision also requires, “[w]here the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.” As is apparent, 42.104(b)(3) compels the petitioner to (1) set forth how the challenged claim is to be construed; and (2) when a claim contains a means-plus-function, the construction must identify the specific portion of the specification that describes

the structure for each claim function. Here, Samsung fails to meet either of these prerequisites in its petition.

Separately, 42.104(b)(4) directs the petitioner to provide a statement detailing “[h]ow the construed claim is unpatentable under the statutory grounds identified in paragraph (b)(2) of this section (i.e., 35 U.S.C. 102 or 103). The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.” Samsung fails to meet this requirement as well.

1. Petitioner violates both 42.104(b)(3) and 42.104(b)(4).

As discussed above, Samsung’s petition fails to apply the *Phillips* standard. Petitioner has an affirmative burden to set forth how the challenged claim is to be construed. Samsung’s failure to construe the claims under the *Phillips* standard results in Petitioner failing to meet its burden under 37 C.F.R. § 42.104(b)(3).

And additionally, if a petitioner relies on an incorrect claim construction standard (as Samsung does here), it necessarily follows that the petitioner has not properly construed the challenged claims. Given Samsung’s error in this regard, it is impossible for Samsung to show in its petition how the prior art it cites supposedly invalidates a properly construed claim. This violates the requirements of 37 C.F.R. § 42.104(b)(4) and is yet another threshold reason for denying the petition.

Indeed, to the extent Dr. Schmidt uses the BRI standard for his analysis and opinions while Samsung's petition cites the *Phillips* standard, those contradictory claim construction approaches result in confusion and a lack of particularity about Samsung's invalidity grounds and the evidence purportedly supporting them. For example, in preparing its preliminary response, DoDots has been forced to consider the arguments set forth in the petition and the expert declaration under both the *Phillips* standard and the BRI standard. When considering each of the elements in the challenged claims, the number of possible permutations DoDots has to consider when analyzing Samsung's invalidity arguments in view of how Dr. Schmidt approached the claims under the BRI standard is numerous, confusing and ultimately prejudicial. The patent owner should not be required to guess the invalidity arguments a petitioner sets forth. *See Adaptics Limited, v. Perfect Company IPR2018-01596(Paper 16, informative)*("Considering the totality of the issues addressed above, we determine that the Petition fails to meet the particularity requirement of 35 U.S.C. § 312(a)(3) and that the lack of particularity results in voluminous and excessive grounds.") Samsung's failure to use the correct claim construction standard (and/or contradictory use of different standards) has forced DoDots to do exactly this—guess the arguments Samsung is trying to make and under what legal framework. This burden placed on DoDots

(and the Board) should be reason enough to deny Samsung's legally-flawed and imprecise petition.

2. Petitioner fails to identify specific portions of the specification that describe the structure for a supposed means-plus-function limitation.

In the concurrently-pending district court litigation, Petitioner argues that the phrase “instructions configured (i) to cause the first networked information monitor to request content from the network location in the content reference via the TCP/IP protocol, and (ii) to cause the first networked information monitor to generate the graphical user interface of the first networked information monitor with the content received from the network location via the TCP/IP protocol within the frame” is both a means plus function claim element and indefinite. *See* Ex. 2003, pg. 4 and 5. But despite its position in the pending litigation that this phrase is a means-plus-function limitation, Samsung does not identify “the specific portions of the specification that describe the structure corresponding to each claimed function,” as § 42.104(b)(3) requires.

Petitions that fail to identify corresponding structure in the specification are consistently denied under 37 C.F.R. §§ 42.104 (b)(3). *See e.g., Floteck Indus., Inc. v. Nat'l Oilwell DHT, L.P.*, IPR2015-01210, Paper 11 at 8-9 (P.T.A.B. Nov. 6, 2015); *Lindsay Corporation v. Valmont Industries*, IPR2015-01039, Paper 7 at 11 (P.T.A.B. Sept. 24, 2015); *SAS Institute, Inc. v. Complementsoft, LLC*, IPR2013-

00226, Paper 9 at 11 (P.T.A.B. Aug. 12, 2013) (“SAS does not identify what structure in the Specification it believes corresponds to the means-plus-function limitation of claim 11. This failure is fatal to SAS’s challenge of claims that include that limitation.”); *Clickbooth.com LLC v. Essociate, Inc.*, IPR2015-00464, Paper 9 at 12 (P.T.A.B. July 9, 2015) (“As such, Petitioner fails to identify corresponding structure for any of the means-plus-function limitations and, therefore, fails to comply with 37 C.F.R. § 42.104(b)(3). Accordingly, we decline to institute *inter partes* review [of the challenged claims].”).

Moreover, to proclaim that a limitation is definite in an IPR and indefinite in a district court case is impossible to reconcile with the fact that the Board employs a “*lower threshold* of ambiguity when determining indefiniteness” than district courts. *See Ex parte Miyazaki*, 89 U.S.P.Q.2d 1207, 1211 (BPAI Nov. 19, 2008) (precedential)); *See also Medshape, Inc. v. Cayenne Med., Inc.*, IPR2015-00848, Paper 9 at 8 (P.T.A.B. Sep 14, 2015) (denying institution on claims) (“A claim term that does not satisfy the definiteness requirement under *Nautilus* likewise fails to satisfy the definiteness requirement of *Miyazaki*.”).

And further, petitioner provides no reason for abandoning its litigation claim construction positions in its petition. This is particularly problematic because even though the same claim construction standard applies in both forums, petitioner makes no effort to justify the abandonment of its indefiniteness means-plus-

function district-court construction and the contradictions in its approach here. Instead, petitioner ignores that issue altogether in the petition. Petitioner's failure to "take ownership" of its competing and contradictory claim constructions here and in the district court is sufficient reason alone to reject the Petition in its entirety. In *Carefusion Corporation v. Baxter International*, the Board found that this approach was insufficient and denied institution:

We agree with Patent Owner that Petitioner has failed to provide a sufficient statement of how the challenged claims are to be construed as required by 37 C.F.R. § 42.104(b)(3). Petitioner states that it relies on constructions advanced by Patent Owner in the related litigation; remarkably, however, Petitioner also states that it does not agree that those constructions are in fact correct. *See* Petition at 9. *As such, Petitioner has failed to indicate that it agrees with, proposes, or adopts the constructions attributed to Patent Owner. See Toyota Motor Corp. v. Blitzsafe Texas, LLC*, Case IPR2016-00422, slip op. at 26–27 (P.T.A.B. Jul. 6, 2016) (Paper 12).

Carefusion Corporation v. Baxter International, Inc., IPR2016-01456, Paper 9 at 7 (P.T.A.B. Feb. 6, 2017) (emphasis added)

Further, in *Carefusion Corp.*, the Board saw through petitioner's equivocating on indefiniteness in the district court and purportedly agreeing with the patent owner's position, noting that petitioner failed to identify "the structure, material, or acts corresponding to the claimed function" and holding that "[p]etitioner's assertion that the claim terms are indefinite [in the district court] does *not* excuse [p]etitioner's failure to provide the required claim construction"

under 37 C.F.R. § 42.104(b)(3). *Carefusion Corporation v. Baxter International, Inc.*, IPR2016-01456, Paper 9 at 8-9.

Petitioner here certainly does not “agree” with its proposed constructions, nor does it “adopt” those constructions other than for the “purposes of this IPR only.” Petitioner’s failure to address its district court means-plus-function and indefiniteness construction and the ambiguities in its positions here, and failure to identify corresponding structure warrant denial of the petition.

Indeed, Samsung’s petition —where there is no stipulated construction, no Board-sanctioned claim construction, no citations to the ’083 patent, and no argument or explanation in favor of the constructions presented—is a model of how *not* to meet the standard set forth in § 42.104(b)(3). This is reason enough to deny the petition in its entirety.

VII. PETITIONER FAILS TO MEET ITS BURDEN OF PRODUCTION.

A. Petitioner fails to meet its burden of production with respect to challenged claims 1-16.

37 C.F.R. § 42.22 requires an IPR petition to include a detailed explanation of the significance of the evidence. In *Parus Holdings, Inc. v. Google LLC*, 2023 U.S. App. LEXIS 14543, *10-11 (Fed. Cir. 2023), the Federal Circuit cautioned against a shotgun approach to argument by stating, “[o]ne cannot reasonably expect the Board to sift through hundreds of documents, thousands of pages, to

find the relevant facts.” In reaching this conclusion, the Court noted that “the Board should not be forced to play arch[a]eologist with the record.” *Id.* (internal citations and quotations omitted).

Samsung’s petition forces the Board to play archeologist with respect to its invalidity arguments for challenged claims 9-16. For example, for Grounds 1A and 1B, Petitioner’s sole argument with respect to challenged claims 9-16 is the following table:

[9.1] - [16]

Grounds 1A and 1B render these claims obvious in the same manner as explained above for the corresponding claims listed in the following table. SAM-SUNG-1003, ¶¶102-117.

Claim	Corresponding Claim
[9.1]	[1.1]
[9.2]	[1.2]
[9.3]	[1.3]
[9.4]	[1.4]
[9.5]	[1.6]
[9.6]	[1.6]
[10]	[2]
[11]	[3]
[12]	[4]
[13]	[5]
[14]	[6]
[15]	[7]
[16]	[8]

See Petition at 57. This single table directing the Board to decipher other portions of the petition and prior art is the exact scenario the Federal Circuit said in *Parus* was improper. For example, it is unclear from the above table whether [1.1] should be interpreted as a reference to the “external document” that includes a custom listing of challenged claim elements or to Section 1.1 discussed on page 19, or both. *See* Petition at iv to ix. The reason Samsung took this impermissible shortcut is clear—it wanted to claim that it met the word limit while at the same time covering its bases with small chart that incorporates pages and pages of argument. If Samsung had recited the challenged claims and corresponding arguments in its petition, Samsung’s brief would have easily exceeded the 14,000 word limit. *See* 37 C.F.R. § 42.24(a)(i) (limiting page length to 60 pages or 14,000 words).

Petitioner takes another shortcut in footnote 2, which applies to claim 1 and also claims 1-15, and states the following:

² Descriptions of the references and combinations thereof are incorporated into each mapping that includes citations to these references. All emphasis is added unless otherwise indicated.

See Petition at 9, footnote 2. Instead of making arguments with respect to each of the challenged claim numbers 9-16, Samsung simply relies on a table and a footnote pointing to “references and combinations thereof” that are somehow

“incorporated into each mapping” “that included citations to these references.”

Samsung's slipshod strategy makes the patent owner and the Board guess the specific arguments Samsung is purportedly asserting against challenged claims 9-16. This is improper. Samsung has therefore not met its burden of production by putting forward a specific prior-art combination and explanation of the alleged significance of any combinations in its petition. For this reason, the Board should deny institution.

1. Petitioner fails to meet its burden of production with respect to its Ground 1A, Ground 1B and Ground 2 arguments because it relies on references without establishing their critical date.

The Petition facially appears to argue that Ground 1A is an obviousness challenge based on Brown, Ground 1B is an obviousness challenge based on Brown and Wecker, and Ground 2 is an obviousness challenge based on Shimada and Buchholz. *See* Petition at 8 and 58.

But as explained in more detail below in Section VIII, Ground 1A is actually based on a combination of at least Brown, Jones, Beer, Petty, Yohanan and Darnell; Ground 1B is based on a combination of at least Brown, Wecker, Wecker 2, Jones, Beer, Petty, Darnell, and Yohanan; and Ground 2 is actually based on a combination of at least Shimada, Buchholz, and Yohanan. Despite relying on these multiple prior art documents to support of its invalidity arguments, Samsung's

petition provides the critical date only with respect to Brown, Wecker, Shimada and Buchholz. *See* Petition at 2.

IPR OF U.S. PATENT NO. 8,020,083

The '083 Patent claims priority to a U.S. patent application filed on April 26, 2000, as well as to a number of provisional applications, the earliest of which was filed on April 26, 1999. SAMSUNG-1001, Cover. Solely for purposes of evaluating prior art in this proceeding and without conceding the propriety of these priority claims, this Petition will treat April 26, 1999, as the earliest alleged effective filing date ("Critical Date"). The references relied on in the above grounds qualify as prior art to the '083 Patent at least under Pre-AIA §102(e) as indicated in the table below.

Reference	Publication Date	Filing Date
Brown	08/21/2001	02/17/1998
Wecker	09/10/2002	06/30/1998
Shimada	09/07/2004	06/18/1997
Buchholz	07/11/2000	06/23/1998

See Petition at 2.

Samsung's failure to discuss the critical dates of the references it relies on—specifically, Jones, Beer, Petty, Darnell and Wecker 2 — is a failure of Samsung meeting its burden of production and the petition should therefore be denied.

VIII. PETITIONER HAS FAILED TO SHOW A REASONABLE LIKELIHOOD OF SUCCESS FOR ANY OF GROUNDS 1A, 1B AND 2.

As mentioned above, Samsung's Petition sets forth the following three grounds of invalidation:

PO's Preliminary Response

Ground	Claims	Basis
1A	1-5, 9-13	§ 103: Obvious over Brown
1B	1-16	§ 103: Obvious over Brown in view of Wecker
2	1-16	§ 103: Obvious over Shimada in view of Buchholz

See Petition at 1.

But Samsung's table is misleading because Petitioner's arguments are not merely based on one reference (as in Ground 1A) or two references (as in Grounds 1B and 2). In reality, as explained above, Ground 1A is a combination of Brown, Jones, Beer, Petty, Shimada, Yohanan and Darnell; Ground 1B is a combination of Brown, Wecker, Wecker 2, Jones, Beer, Petty, Darnell, Shimada and Yohanan; and Ground 2 is a combination of Shimada, Buchholz, Darnell, and Yohanan. Thus, Samsung's grounds of invalidation are more accurately represented in the following manner:

Ground	Claims	Basis
1A	1-5, 9-13	§103: Obvious over Brown, Jones, Beer, Petty, Shimada, Yohanan and Darnell.
1B	1-16	§103: Obvious over Brown in view of Wecker, Wecker 2, Jones, Beer, Petty, Darnell, Shimada, and Yohanan.
2	1-16	§103: Obvious over Shimada in view of Buchholz, Darnell, and Yohannan.

See Petition at 1.

As explained below, Samsung fails to provide the most basic information about the prior art references that Samsung omits from its invalidation grounds table, but then relies on in its petition. The burden of establishing a motivation to combine prior art references falls squarely on petitioner. The Board has repeatedly denied institution where there is no reason to combine references. *See Stryker Corp. v. Karl Storz Endoscopy*, IPR2015-00764 Paper 13 at 13 (P.T.A.B. Sept. 2, 2015) (“[W]e fail to see, and Petitioner does not adequately explain, why it would be obvious to add a translator to redundantly perform the function that Petitioner maintains is performed by the [first reference].”); *See also Square, Inc. v. J. Carl Cooper*, IPR2014-00158, Paper 10 at 30 (P.T.A.B. May 15, 2014); *TRW v. Magna Elecs.*, IPR2015-00972, Paper 9 at 11-12 (P.T.A.B. Sept. 16, 2015). Under the CFR and the Board’s well-settled practice, Samsung’s failure to explain why references should be combined is a fatal error in its petition and for that reason, institution should be denied.

A. Petitioner neither establishes the critical date for the Beer and Petty references nor does it explain how or why a POSITA would combine Beer or Petty with *inter alia* Brown.

With respect to Grounds 1A and 1B, the Petition relies on Beer and Petty as allegedly teaching the limitation, “electronic storage having stored thereon a plurality of networked information monitor templates defining a plurality of networked information monitors.” The petition states, “both Beer and Petty, two

references directed to the display of content using style templates, refer to memory as a form of storage.” *See* Petition at 20 (internal cites omitted). But nowhere in the petition does Samsung indicate the critical date of Beer and Petty or explain how or why a person of skill in the art would combine Beer or Petty with, among others, Brown. For this reason, where Samsung has failed to meet its burdens of production and persuasion, the Board should disregard any combination relying on Beer and Petty.

B. Petitioner neither establishes the critical date for the Darnell reference nor does it explain how or why a POSITA would combine Darnell with *inter alia* Brown.

With respect to Grounds 1A and 1B, the petition relies on Darnell as providing a rationale for a POSITA to interpret the HTML file of Brown as teaching, “the first networked information monitor template.” The petition states, “[indeed, Darnell, an academic reference directed to HTML, describes that HTML is platform independent (i.e., not requiring specific hardware or software for interpretation).” *See* Petition at 28 (internal cites omitted). Samsung does not establish that Darnell is a printed publication, nor does Samsung establish that Darnell was available to the public as of the critical date. The Board has found that although a copyright notice “may be evidence of the date of a reference,” crucially, it “sheds virtually no light on whether the document was publicly accessible as of that date.” *Microsoft Corp. v. Corel Software, LLC*, Case No. IPR2016-01300

(P.T.A.B., Jan. 4, 2016) (denying institution where petitioner failed to make threshold showing that its asserted references were prior art printed publications).

Moreover, it has long been held that a printed copyright is insufficient to authenticate a reference. Specifically, because the Federal Rules of Evidence are applicable in *inter partes* reviews, “copyright ‘dates imprinted on documents are hearsay when offered to prove the truth of the matter asserted.’” *Standard*

Innovation Corp. v. Lelo, Inc., IPR2014-00148, Paper No. 41, (P.T.A.B. April 23, 2015) at 17. As such, any copyright date printed on Darnell cannot be relied on to establish its purported publication date.

The petition additionally does not explain how or why a person of skill in the art would supposedly combine Darnell with Brown, Beer or Petty. For this reason where Samsung has failed to meet its burdens of production and persuasion, the Board should disregard any combination relying on Darnell.

C. Petitioner neither establishes the critical date for Jones nor does it explain how or why a POSITA would combine Jones with Brown or why Brown and Jones should be treated as one reference.

For Grounds 1A and 1B, the Petition also relies on Jones (which Brown appears to incorporate by reference) to teach, “define one or more controls that are usable by the user to interact with or control the first networked information monitor.” But Brown merely cites to an attorney docket number and has no patent number citation to Jones. The petition states, “[t]hird, Brown additionally directs

the reader to “Jones,” a co-pending application directed to “managing position and size for a desktop component.” *See* Petition at 44. Once again, the petition does not mention Jones’s critical date or explain why Brown and Jones should be treated as one reference. For this reason, where Samsung has failed to meet its burdens of production and persuasion, the Board should disregard any combination relying on Jones.

D. Petitioner neither establishes the critical date for Yohanan nor does it explain how or why a POSITA would combine Yohanan with Brown, Jones, Beer, Petty or Darnell, or with Shimada and Bucholz.

Samsung’s petition relies on Yohannan to teach, “[lack] controls for manually navigating a network.” *See* Petition at 35. The petition states, “[a]dditionally, Yohanan describes such an implementation lacking controls to specify a network location (“a more efficient method for accessing network locations’ using ‘a convenient method to access network locations without having to open a browser and key-in the desired site's URL”).” *Id* at 36. But the petition and Dr. Schmidt’s expert declaration fail to explain how or why a person of skill in the art would combine Yohanan with Brown, Jones, Beer, Petty or Darnell for Grounds 1A and 1B. Likewise, Samsung relies on Yohanan to support its Ground 2. But it completely fails to explain how or why a POSITA would combine Yohanan with Shimada and Bucholz. *Id.* at 77. For this reason, where Samsung has

failed to meet its burdens of production and persuasion, the Board should disregard any combination relying on Yohanan.

E. Petitioner fails to demonstrate how a local HTML file in Shimada that includes content that is presented on an alleged NIM meets “a content reference that comprises a network location at which content for the first networked information monitor is accessible via a TCP/IP protocol.”

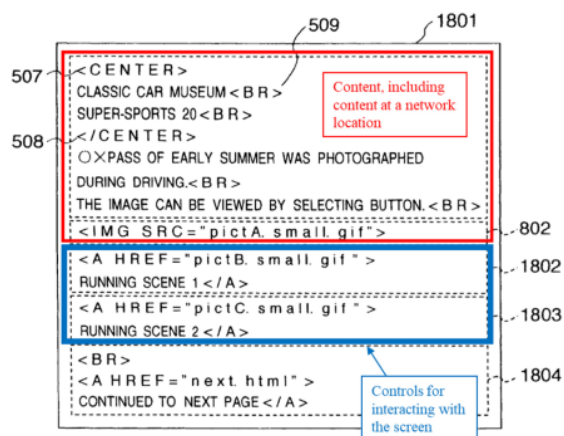
Petitioner fails to demonstrate how a *local* HTML file of Shimada that includes *content that is presented* on an alleged NIM meets “a content reference that comprises a network location at which content for the first networked information monitor is accessible via a TCP/IP protocol,” as all challenged claims require. The issue turns on the disclosed components of Shimada in the HTML file being local references, which precludes accessing the content via a TCP/IP protocol at a later time. *See* Petition at 74.

First, petitioners argue that a local HTML file teaches a NIM template. Petition 72. But the HTML file of Shimada includes *content that is presented and controls for interacting with the screen* in the same file. *See* Petition at 72. That is contrary to what the patentee describes in the '083 patent specification. The specification of the '083 patent states, “[f]or display of the new Dot, the Home Dot creates a frame in the display of the user interface (42, FIG. 1) in step 245. In step 246, the client 199 requests the necessary Internet content stored at the URL(s) identified in the Dot Definition from the corresponding content server 155. The

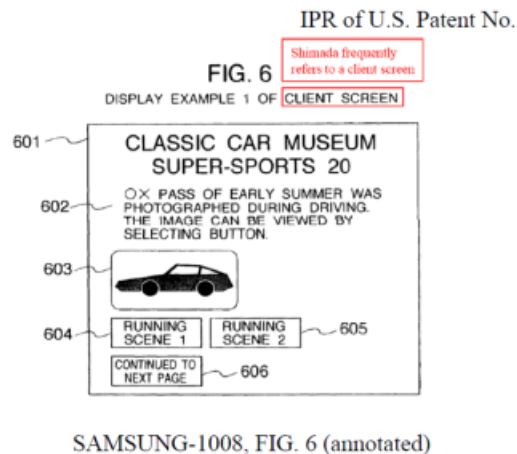
content server 155 transmits the content in step 247, and in step 248 the Home Dot presents the content in the viewer. As the type of content may vary greatly, the content may appear within the frame (such as text or images) or may be independent of the frame (such as audio) but the frame including controls for controlling aspects of the presentation of the content.” Ex. 1001 at 23:5-15.

The NIM *template* is separate and independent from content retrieved “from a network” based on the URL identified in the NIM template. Therefore, the HTML file of Shimada cannot be “a NIM template” because the content that is presented is already in the HTML file.

Second, Shimada does not teach a NIM template that comprises the “one or more content references” that comprise one or more uniform resource locators at which content for the networked information monitor is accessible over a network.”



Petition, at 80.



Petition, at 82.

In the HTML file, the images are stored locally and retrieved via a relative URL, are referenced with `<A HREF = "pictA.small.gif" >`. The locally stored information is not and cannot be retrieved "from a network."

For example, a relative tag retrieves locally stored images/files:

Example

Add left and right margins to image (with CSS):

```

```

Try it Yourself »

See https://www.w3schools.com/tags/tag_img.asp

In contrast, an absolute URL retrieves information from a network:

Example

How to insert images from another folder or from another web site:

```


```

Try it Yourself »

See id.

As shown above, in Fig. 6 of Shimada's HTML file, the images are shown as being retrieved via a relative URL and are referenced with `<A HREF = "pictA.small.gif">`. The relative URLs fetch information that is locally-stored information and does not and cannot be retrieved "from a network."

But the '083 patent specification states, for example,

[t]he Home Dot 200 communicates to the server 153 via an HTTP request. The HTTP request URL contains an API call. Any API calls that require the uploading of data to the server place the data in the message body of the request. API calls that require uploading/downloading of data send/receive that data in XML format.

All API calls are the end part of a complete URL that begins with:

<http://<someservername>.DoDots.com/DoDots/> where

<someservername> is variable and DoDots is an alias for the DoDots servlet/JSP servlet or servlets directory. Arguments to any of the

methods are passed in as name value pairs in the query string portion
or the URL.”

Ex. 1001 31:63-32:7.

In fact, every *single content* shown in Fig 17 of Shimada is locally located including “CLASSIC CAR MUSEUM, SUPER SPORTS”, “PASS OF EARLY SUMMER WAS PHOTOGRAPHED”, “DURING DRIVING”, “THE IMAGE CAN BE VIEWED BY SELECTING THE BUTTON”, “pictA.small.gif”, “pictB.small.gif”, and “pictC.small.gif.” Therefore, Shimada does not and cannot teach, “one or more content references that comprise one or more uniform resource locators at which content for the networked information monitor is accessible over a network.”

Petitioner has therefore not met its burden to establish a likelihood that it will prevail on Ground 2.

IX. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE BOARD UNDER 35 U.S.C. § 314(A).

Samsung’s petition should be denied because instituting an IPR of the same patent in the parallel WDTX litigation will waste significant Board and court resources:

- Duplication of efforts will occur because the lawsuit against Samsung is not stayed and, in fact, Samsung has not even moved for a stay.

- The WDTX litigation is set for trial on June 24, 2024, months before the Board issues any hypothetical final written decision stemming from this petition.
- DoDots, petitioner and the district court have already expended significant resources in the WDTX litigation. The parties have exchanged preliminary infringement contentions, invalidity contentions, completed discovery related to venue and briefed a transfer-of-venue motion, completed briefing on claim construction for which a hearing will held on July 27, 2023, served initial disclosures, document requests and interrogatories, entered a protective order and are presently negotiating source code review, which will commence shortly
- Moreover, Petitioner did not submit a *Sotera* stipulation. Instead, Petitioner only claims “not to pursue primary references asserted in this Petition (*i.e.*, Brown and Shimada) in the co-pending litigation,” thereby highlighting a strategy of trying to avoid the statutory estoppel provisions. Petition at 99.

These facts warrant a denial of institution.

In determining whether to discretionarily deny institution based on these facts, the Board is to consider the presence and status of parallel district court

litigation. *NHK Spring Co., Ltd. v. Intri-plex Technologies*, IPR2018-00752, Paper 8, 11 (P.T.A.B. 2018) (precedential); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. 2020) (precedential) (“Fintiv”). *Fintiv* sets forth a non-exhaustive list of factors that balance system efficiency and fairness considerations when considering discretionary denial. *See Fintiv* at 5–6. The factors are:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties;
4. Overlap between issues raised in the petition and in the parallel proceeding;
5. Whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. Other circumstances that impact the Board’s exercise of discretion, including the merits.

Id. Additionally, the *Fintiv* factors should be considered in view of the guidance provided in the June 21, 2022 Memo Regarding Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation. (“Fintiv Memo”). *See Ex. 2004.*

As demonstrated below, each of the *Fintiv* factors favors a denial of institution.

A. The district court case is not stayed nor is there any evidence that a stay will be granted if the IPR were instituted.

Samsung has not sought to stay the district court litigation. And there is no indication that the court will grant any stay, if one is sought. This factor, therefore, weighs against institution.

B. Proximity of the district court's trial date to the Board's projected statutory deadline for a final written decision.

The Western District of Texas issued its scheduling order on December 29, 2022 and set trial for in June 24, 2024. Ex. 2005. Pursuant to 35 U.S.C. § 316(a)(11), the projected statutory deadline for a final written decision is in at least August or September 2024, two-three months later. Because the district court trial will proceed well before the expected final written decision date, this factor favors denial of institution. *Google, LLC. v. Personalized Media Comm., LLC.*, IPR2020-00723, Paper 22, 7 (P.T.A.B. 2020); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude “several months,” before a final decision would be due); *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 8 (P.T.A.B. May 15, 2020) (“Because the trial date is substantially

earlier than the projected statutory deadline for the Board's final decision, this factor weighs in favor of discretionary denial.")

C. Both the district court and the parties have made significant investments in the parallel district court case.

Under the third *Fintiv* factor, the Board is to "consider[] the amount and type of work already completed in the parallel litigation by the Court and the parties at the time of the institution decision." *Fintiv* at 9.

Patent owner, petitioner, co-defendant Apple, and the WDTX Court have all spent significant resources on the asserted patents including the '083 patent. Fact discovery is ongoing in WDTX, with both parties having already exchanged their initial disclosures, and first set of document requests and interrogatories, and entered into a protective order. Samsung has also produced a portion of its relevant source code, which DoDots will begin reviewing within the next week. The parties have also fully briefed a motion to transfer venue from WDTX to NDCA and claim construction, which will be heard on July 27, 2023. Indeed, the parties have been litigating this case for approximately fourteen months.

The parties' and the district court's substantial investment in the district court litigation favors denial of institution. *See Canadian Solar Inc. v. The Solaria Corporation*, IPR2021-00095, Paper 12, 11 (P.T.A.B. 2021).

D. There is significant overlap between the issues raised in the petition and in the parallel district court case.

Under the fourth factor, as the Board found in *Fintiv*, “if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.”

Fintiv at 12.

Invalidity issues related to the '083 patent are already being litigated in WDTX. Samsung's invalidity contentions already set forth the grounds raised in this petition. And by failing to submit a *Sotera* stipulation, Samsung has done nothing to mitigate concerns of potentially conflicting decisions and duplicative efforts between the district court and the Board. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020)(precedential). In fact, in its petition, Samsung only agreed “not to pursue primary references asserted in this Petition (i.e., Brown and Shimada) in the co-pending litigation.” Petition at 99. Petitioner remains silent with respect to any ground that reasonably could have been raised. These circumstances evidence Petitioner's scheme to avoid the statutory estoppel provisions and favor denial of institution. *See Sand Rev'n II LLC v. Cont'l Intermodal Grp. – Trucking LLC*, IPR2019- 01393, Paper 24, 7 (P.T.A.B. 2020) (informative); *Sotera* at 19; *Fintiv* at 18 (weighing Factor 4 in favor of

denial of institution based on “concerns of inefficiency and the possibility of conflicting decisions”).

E. Petitioner and defendant in the parallel litigation are the same party.

Petitioner is the defendant in the WDTX case. Moreover, all the arguments Samsung raises in its petition it also raises in the parallel district court litigation. For this reason, this factor favors denial of institution.

F. Other circumstances favor the Board exercising its discretion to deny institution, including the merits.

The Board is to consider the merits of a petitioner's challenge when determining whether to institute a post-grant proceeding in view of parallel district court litigation. As explained in the sections above, for various individual reasons, Petitioner has failed to meet its burden under 37 C.F.R. §§ 42.100 and 104 of establishing a reasonable likelihood of success that any of the challenged claims are unpatentable. Petitioner's failings and the significant risk of wasting judicial and Board resources all point to this additional factor as favoring denial of institution.

In sum, each of the *Fintiv* factors weigh in favor of denying institution, and the Board should exercise its discretion in accordance therewith.

X. CONCLUSION.

For the foregoing reasons, patent owner respectfully requests the Board to deny institution of the petition in its entirety.

Dated: July 14, 2023

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,020,083 specified in 37 C.F.R. § 42.24 has 8,793 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

Dated: July 14, 2023

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S
PRELIMINARY RESPONSE was served electronically via email on July 14,
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