

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.

IPR2023-00621
Patent 8,020,083 B1

Before HUBERT C. LORIN, AMBER L. HAGY, and SHARON FENICK,
Administrative Patent Judges.

FENICK, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

Samsung Electronics Co., Ltd. (“Petitioner”) filed a petition for *inter partes* review challenging claims 1–16 (“challenged claims”) of U.S. Patent 8,020,083 B1 (Ex. 1001 (“the ’083 patent”)). Paper 2 (“Pet.” or “Petition”). DoDots Licensing Solutions LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With the Board’s authorization (Ex. 1020), Petitioner filed a Preliminary Reply (Paper 7, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 8, “Prelim. Sur-reply”). The Board has authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a).

Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the Petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we institute an *inter partes* review as to the challenged claims of the ’083 patent on all grounds of unpatentability presented.

B. *Real Parties in Interest*

Petitioner identifies Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc., as the real parties in interest. Pet. 100.

Patent Owner identifies only itself as the real party in interest. Paper 3 (Patent Owner’s Mandatory Notices), 1.

C. *Related Matters*

Petitioner identifies the following proceeding as a related matter: *DoDots Licensing Solutions LLC v. Samsung Electronics Co., Ltd.*, 6:22-cv-00535 (W.D. Tex.) (“the related district court litigation”). Pet. 100.

Petitioner additionally notes that the patent was the subject of *DoDots Licensing Solutions LLC v. Lenovo*, 1-18-cv-00098 (D. Del.) and *inter partes* review proceeding IPR2019-01278. *Id.* at 100–101.

Patent Owner also cites Western District of Texas case 6:22-cv-00535 as related and additionally identifies as related *DoDots Licensing Solutions LLC v. Apple Inc.*, CA No. 6:22-cv-00533 (W.D. Tex. May 24, 2022). Paper 3, 1–2.

D. The '083 Patent

The title of the '083 patent is “System and Methods for Creating and Authoring Internet Content Using Application Media Packages.” Ex. 1001, code (54). The '083 patent discloses, in part, a software component for accessing and displaying network content. *Id.* at code (57). 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.* at 3:57–59, 5:40–48. When a Dot is opened by a user, the frame is presented in the user’s display, and network content is retrieved and presented in a viewer enclosed by the frame. *Id.* at 23:5–17. The network content may be identified via URLs included in the Dot. *Id.* at code (57), 13:47–52, 14:14–16. The Specification describes 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.* at 5:44–48.

Figure 5, illustrating an example of an instance of a Dot, is reproduced below.

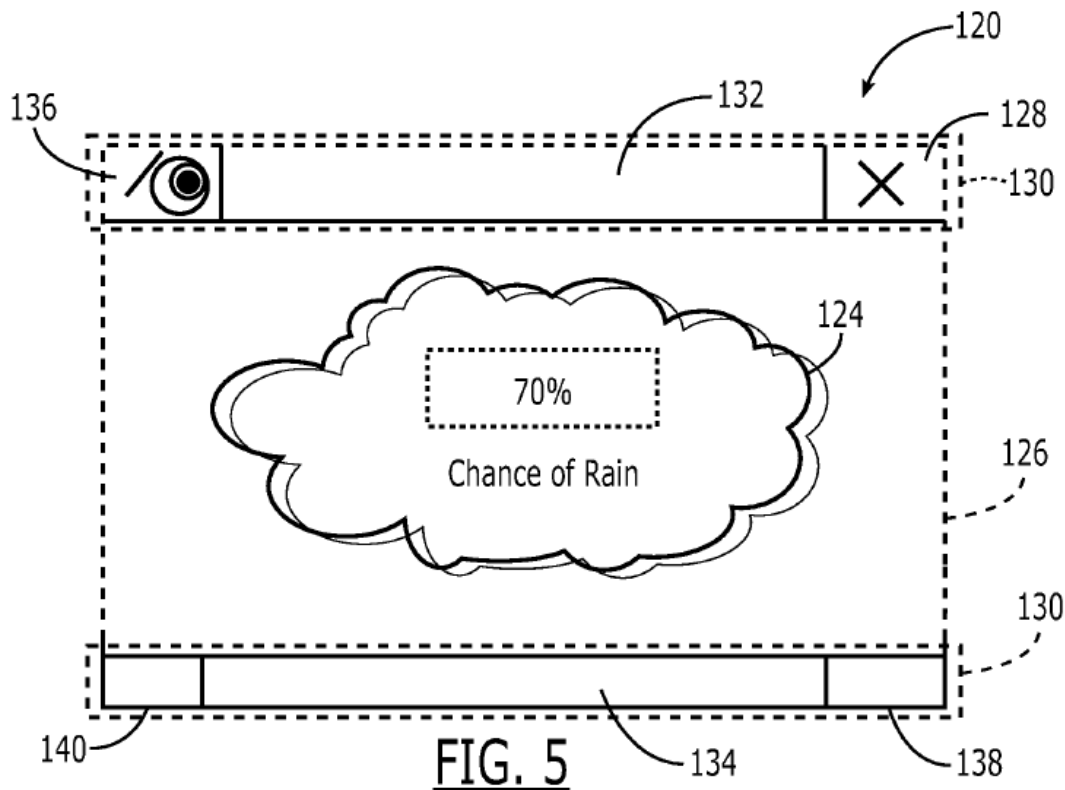


Figure 5 depicts Dot 120, a visual indicator of likelihood of rain expressed as a percentage and rendered against an image of a cloud. *Id.* at 4:53–55, 14:44–47. A Dot is an instantiation of a Dot definition, which comprises an XML definition and a network reference to Internet content. *Id.* at 13:47–52. For the Dot in Figure 5, the Dot definition describes the size, configuration, and location of control space 126 and control space 130, which may include controls such as a “close’ button” or a “resize’ handle.” *Id.* at 14:48–53. The instructions for rendering the static cloud image are also found in the Dot definition. *Id.* at 14:54–58. Alternately, the image may be obtained from the location to which the network reference points. *Id.* at 14:58–60. The data representing the likelihood of rain is obtained

from a server indicated by the network reference. *Id.* at 14:63–15:1. The frequency of updating and re-rendering the dynamic data may be controlled by the Dot definition or by the source of the data. *Id.* at 15:3–6.

A server may store a number of Dots and provide a Dot to a client system upon request. *Id.* at 7:5–23, 20:63–21:42, 22:53–23:19, Figs. 1, 6, 8. A user at the client system may then store or use the Dot. *Id.* at 23:20–62.

E. Illustrative Claim

Claims 1 and 9 are the only independent claims among the challenged claims. Claim 1 is reproduced below with Petitioner’s limitation designations added in brackets for ease of reference:

1. A client device, the client device comprising:

[1.1] electronic storage having stored thereon a plurality of networked information monitor templates defining a plurality of networked information monitors, the plurality of networked information monitor templates comprising a first networked information monitor template defining a first networked information monitor, wherein the first networked information monitor template comprises:

[1.2] (1) a content reference that comprises a network location at which content for the first networked information monitor is accessible via a TCP/IP protocol;

[1.3] (2) a definition of a graphical user interface of the first networked information monitor that lacks controls for manually navigating a network, and that includes a frame within which content received from the network location can be displayed, and frame characteristics defining one or more a color, a size, or a position on the electronic display of the frame; and

[1.4] (3) 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;

[1.5] an electronic display; and

[1.6] one or more processors configured to access the first networked information monitor template, and to execute the first networked information monitor template such that the graphical user interface of the first networked information monitor is presented to a user on the electronic display having content received from the content reference therein.

F. Evidence

Petitioner relies on the following references:

Reference	Description	Exhibit
Buchholz et al. (“Buchholz”)	US 6,088,340	Ex. 1009
Brown et al. (“Brown”)	US 6,278,448 B1	Ex. 1005
Wecker et al. (“Wecker”)	US 6,449,638 B1	Ex. 1006
Shimada et al. (“Shimada”)	US 6,789,263 B1	Ex. 1008

Petitioner additionally relies on a declaration of Douglas C. Schmidt (Ex. 1003).

G. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–16 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
1–5, 9–13	103	Brown
1–16	103	Brown, Wecker
1–16	103	Shimada, Buchholz

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. Because the claims at issue have an effective filing date prior to the effective date of the AIA’s amendments to 35 U.S.C. § 103, we apply the pre-AIA version of § 103 in this Decision. *See* Ex. 1001, codes (22), (63).

II. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)

Patent Owner argues that we should exercise discretion to deny institution under 35 U.S.C. § 314(a) because the factors identified in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”), weigh in favor of denying institution. Prelim. Resp. 37–43; Prelim. Sur-reply 7. Petitioner argues we should not discretionarily deny institution under *Fintiv*. Pet. 97–99; Prelim. Reply 6–7.

The precedential decision in *Fintiv* identifies a non-exclusive list of factors parties may consider addressing where there is a related, parallel district court action to determine whether such action provides any basis for discretionary denial. *Fintiv*, 5–16. Those factors include:

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. at 5–6.

In evaluating the factors, we take a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review. *Id.* at 6. The Director has issued additional guidance on the application of

Fintiv. See Katherine K. Vidal, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022) (“*Fintiv* Memo”). Additionally, we are guided by the precedential decisions of the Director in *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102, 49–50 (Oct. 4, 2022) (precedential), and *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 (Feb. 27, 2023) (precedential) (“*CommScope*”).

We are instructed to consider compelling merits under *Fintiv* factor six only after a determination that the first five *Fintiv* factors favor discretionary denial. *CommScope*, 4–5. Thus, we begin by considering the first five *Fintiv* factors.²

A. First Five Fintiv Factors

1. Whether a Stay Exists or Is Likely to Be Granted if a Proceeding Is Instituted

“A district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts.” *Fintiv*, 6. *Fintiv* indicated that, in previous Board decisions, the existence of a district court stay pending Board resolution of an *inter partes* review has weighed strongly against discretionary denial, while a denial of such a stay request sometimes weighs in favor of discretionary denial. *Id.* at 6–8.

Petitioner argues that this factor “is neutral because neither party has requested a stay. . . . Upon [filing] of this petition, Petitioner intends to file a motion to stay the parallel litigation.” Pet. 97. Petitioner further contends

² While *Fintiv* factor six encompasses considerations other than the compelling merits, neither party has argued such considerations exist in this case.

that the Board generally declines to predict outcomes of possible future stay requests. Prelim. Reply 6.

Patent Owner argues that this factor weighs against institution, because Petitioner “has not sought to stay the district court litigation[a]nd there is no indication that the court will grant any stay, if one is sought.” Prelim. Resp. 40.

Because, “[i]n the absence of specific evidence, we will not attempt to predict” whether a district court would stay “based on a variety of circumstances and facts beyond our control and to which the Board is not privy,” we find this factor to be neutral. *See Sand Revolution II, LLC v. Cont’l Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative) (“*Sand Revolution*”).

2. *Proximity of the Court’s Trial Date to the Board’s Projected Statutory Deadline*

The proximity factor in *Fintiv* asks us to evaluate our discretion in light of a trial date that has been set in a parallel litigation. *See Fintiv*, 3, 5 (“*NHK* applies to the situation where the district court has set a trial date to occur earlier than the Board’s deadline to issue a final written decision in an instituted proceeding.”; “When the patent owner raises an argument for discretionary denial under *NHK* due to an earlier trial date, the Board’s decisions have balanced the following factors”) (citing *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”).

As noted above in the discussion of the first factor, *Fintiv* cites concern regarding “inefficiency and duplication of efforts.” *Id.* at 6. In its analysis of the proximity factor, *Fintiv* echoes that concern in its guidance that “[i]f the court’s trial date is at or around the same time as the projected

statutory deadline or even significantly after the projected statutory deadline, the decision whether to institute will likely implicate other factors discussed herein, such as the resources that have been invested in the parallel proceeding.” *Id.* at 9. Similarly, in *NHK*, the Board expressed concern that a trial before the deadline for a final written decision addressing the same prior art and arguments would have undermined the Board’s objectives of providing an effective and efficient alternative to district court litigation. *See NHK*, 20 (citing *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017) (precedential)).

We are instructed that

when analyzing the proximity of the court’s trial date under factor two of *Fintiv*, when other relevant factors weigh against exercising discretion to deny institution or are neutral, the proximity to trial should not alone outweigh all of those other factors. Parties may present evidence regarding the most recent statistics on median time-to-trial for civil actions in the district court in which the parallel litigation resides for the PTAB’s consideration. Where the parties rely on time-to-trial statistics, the PTAB will also consider additional supporting factors such as the number of cases before the judge in the parallel litigation and the speed and availability of other case dispositions.

Fintiv Memo, 8–9 (internal citations and footnote deleted).

Petitioner argues this factor

weighs against discretionary denial. The projected statutory deadline for the PTAB’s Final Written Decision (FWD) is August 2024. The trial date in the co-pending litigation is currently set for June 24, 2024. . . . [T]he District Court’s median time from filing to trial was recently calculated as 28.9 months, yielding an estimated trial date in October 2024, which falls after the expected FWD date of August 2024. . . . Samsung’s Motion to Transfer Venue that was recently filed in W.D. Tex., if

successful, will further ensure that the FWD far outpaces any trial date.

Pet. 97–98.

Patent Owner argues:

The Western District of Texas issued its scheduling order on December 29, 2022 setting trial for in June 24, 2024. Ex. 2005. . . . [T]he 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.

Prelim. Resp. 40. Patent Owner additionally asserts that the motion to transfer was denied, and additionally “a Markman Order has been issued and fact discovery has commenced in earnest.” Prelim. Sur-reply 7.

Additionally Patent Owner contends “in a July 27, 2023 Order, the Court reiterated that, while some discovery dates will be moved, the June 24, 2024 trial date will not change.” *Id.* (citing Ex. 2008).

The trial date set by the court in the related district court litigation is approximately four months before an anticipated final written decision in this case. However, we are instructed to consider the median-time-to-trial data. In this case, we determine that this factor should be considered to be neutral.

3. Investment in the Parallel Proceeding by the Court and Parties

If, at the time of the institution decision, the district court has issued substantive orders related to the challenged patent, such as a claim construction order, this fact weighs in favor of denial. *See Fintiv*, 9–10. On the other hand, if the district court has not issued such orders, this fact

weighs against discretionary denial. *Id.* at 10. *Fintiv* also directs us to consider whether “the petitioner filed the petition expeditiously.” *Id.* at 11.

In the Petition, Petitioner argues this factor

weighs against discretionary denial because co-pending litigation is in its early stages and investment in the case has been minimal. Moreover, the institution decision will likely issue before fact discovery, expert discovery, and expert reports are complete. If an IPR is instituted, subsequent investments in the district court proceeding can further be minimized (*e.g.*, through a motion to stay pending IPR and Samsung’s stipulation).

Pet. 98. Petitioner additionally argues that the resources expended at the time of its Preliminary Reply “remain[] low” and “mostly relate[] to claim construction.” Prelim. Reply 7. Petitioner additionally argues its diligence in filing the Petition provides further weight against discretionary denial in considering this factor.

Patent Owner argues in its Preliminary Response:

Patent [O]wner, [P]etitioner, 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. [Petitioner] has also produced a portion of its relevant source code, which [Patent Owner] 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.

Prelim. Resp. 41. In its Preliminary Sur-reply, Patent Owner asserts that after the Markman order issued, “both parties pushed forward with

discovery” and that “[b]ased on the current posture of the litigation, DoDots has started expending significant resources, including reviewing Samsung’s source code over the last three weeks. Both parties have also collected and intend to produce extensive documents as part of fact discovery.” Prelim. Sur-reply 7.

We are mindful of the investment of the district court, and of the parties, to date, especially the holding of a Markman hearing and the issuance of a Markman order. On the other hand, on the record before us, the filing of the Petition was expeditious. Based on the information presented, moreover, discovery is in its early stages, as even Patent Owner acknowledges in arguing that a “first set of document requests and interrogatories have been exchanged.” Prelim. Resp. 41. We determine this factor weighs slightly against exercising discretion to deny institution.

4. *Overlap Between Issues Raised in the Petition and in the Parallel Proceeding*

“[I]f 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*, 12. “Conversely, if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution under *NHK*.” *Id.* at 12–13. A stipulation as in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential as to § II.A), if one is entered, would be highly relevant. “Consistent with *Sotera Wireless, Inc.*, the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have

reasonably been raised before the PTAB.” *Fintiv* Memo 3 (footnote omitted).

Petitioner argues this factor “weighs against discretionary denial. If this Petition is instituted, Petitioner stipulates not to pursue primary references asserted in this Petition (*i.e.*, Brown and Shimada) in the co-pending litigation.” Pet. 99.

Patent Owner argues, without citation to the record, that

[i]nvalidity issues related to the ’083 patent are already being litigated in WDTX. [Petitioner]’s invalidity contentions already set forth the grounds raised in this petition.

Prelim. Resp. 42. Patent Owner additionally argues that Petitioner has “fail[ed] to submit a *Sotera* stipulation” and thus “has done nothing to mitigate concerns of potentially conflicting decisions and duplicative efforts between the district court and the Board.” *Id.* at 42–43.

While not a *Sotera* stipulation, Petitioner’s stipulation appears to be similar to that in *Sand Revolution*. See *Sand Revolution*, 11–12 (finding that a stipulation not to pursue the same grounds in the parallel litigation “mitigates to some degree the concerns of duplicative efforts”). We recognize that this stipulation is narrower in scope than a *Sotera*-type stipulation. However, Petitioner’s stipulation still reduces potential overlap with the district court litigation. In *Sand Revolution*, such a stipulation weighed marginally against exercising discretion to deny institution. *Sand Revolution*, 12.

We determine this factor weighs slightly against exercising discretion to deny institution.

5. *Whether the Petitioner and the Defendant in the Parallel Proceeding Are the Same Party*

If the petitioner is unrelated to the defendant in the parallel proceeding, that might weigh against discretionary denial. *See Fintiv*, 13–14.

Petitioner and Patent Owner each agree that Petitioner is a defendant in the co-pending litigation. Pet. 99; Prelim. Resp. 43.

As with *Fintiv* factor 2, therefore, this factor is neutral with respect to our exercise of discretion to deny the Petition.

B. *Conclusion*

We have considered the circumstances and facts before us in view of the first five *Fintiv* factors. Because our analysis is fact-driven, no single factor is determinative of our conclusion. Considering these five *Fintiv* factors together, we determine that they do not favor a discretionary denial.

As we do not find that the first five *Fintiv* factors favor discretionary denial, we therefore do not make a determination regarding compelling merits under *Fintiv* factor 6, and our consideration ends with this conclusion. *CommScope*, 4–5.

III. PATENTABILITY ANALYSIS

A. *Legal Standards*

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800

F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review).

A patent claim is unpatentable under 35 U.S.C. § 103(a) 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 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 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) objective evidence of nonobviousness, i.e., secondary considerations.³ *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

“To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). We analyze the asserted grounds with the principles stated above in mind.

B. Level of Ordinary Skill in the Art

Petitioner states:

A person of ordinary skill (“POSITA”) relating to the subject matter of the ’083 Patent would have had (1) a bachelor’s degree in computer science, computer engineering, electrical engineering, or a related field, and (2) at least three years of

³ In the present record, neither party presents arguments or evidence relating to secondary considerations.

corresponding industry work experience. Additional graduate education could substitute for professional experience, or significant experience in the field could substitute for formal education.

Pet. 5 (citing Ex. 1003 ¶¶ 20–21). Petitioner argues that additional graduate education could substitute for professional experience or vice versa. *Id.*

Patent Owner states:

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.”

Prelim. Resp. 12–13 (citing Ex. 1012,⁴ 8). Patent Owner agrees with this standard and argues that it is the same as the standard Petitioner proposes. *Id.* at 13.

We agree that there appear to be no significant differences. We adopt Patent Owner’s formulation of the level of skill in the art, but on the present record we would reach the same preliminary determinations under Petitioner’s formulation of the level of skill.

⁴ Patent Owner’s citation is to Exhibit 2001, which is described in Patent Owner’s exhibit list as “*Lenovo Holding Co, Inc. et al. v. DoDots Licensing Sols.*, IPR2019-01278 (P.T.A.B. Jan. 19, 2021).” Prelim. Resp. viii. However, Exhibit 2001 appears instead to be a version of *Lenovo Holding Co., Inc. v. DoDots Licensing Sols. LLC*, No. 2021-1247, 2021 WL 5822248 (Fed. Cir. 2021), which also appears in our record as Exhibit 1014 and Exhibit 2002. Exhibit 1012 is a copy of the cited Board decision. We assume this is a typographical error and we encourage the parties to cite to exhibits already in the record for clarity rather than adding additional versions, barring any issue with previously-entered exhibits.

C. *Claim Construction*

1. *Construction Statement of Dr. Schmidt (Petitioner's Declarant)*
(Ex. 1003 ¶ 26)

Patent Owner urges the Board to deny institution due to “[Petitioner’s] failure to use the correct claim construction standard.” Prelim. Resp. 19.

Patent Owner contends that Petitioner has “use[d]” the wrong claim construction standard because declarant Dr. Schmidt states: “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.’ 37 C.F.R. § 42.100(b).” Ex. 1003 ¶ 26 (emphasis added). Patent Owner characterizes said statement as “Dr. Schmidt *unequivocally* stat[ing] that he *use[d]* the BRI [broadest reasonable interpretation] standard to interpret the challenged claims.” Prelim. Resp. 16 (emphasis added).

According to Patent Owner, “based on Dr. Schmidt’s failure to apply the right claim construction standard, [Petitioner] necessarily cannot meet its burden of production and burden of persuasion under 37 C.F.R. 42.104(b)(3).” Prelim. Resp. 17 (citing, *inter alia*, *Dynamic Drinkware*, 800 at 1378). This is so because, according to Patent Owner, “throughout its petition, [Petitioner] 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.” *Id.* at 15–16. “[I]f a petitioner relies on an incorrect claim construction standard (as [Petitioner] does here), it necessarily follows that the petitioner has not properly construed the challenged claims.” *Id.* at 18. “Given [Petitioner’s] error in this regard, it is impossible for [Petitioner] to show in its petition how the prior art it cites

supposedly invalidates a properly construed claim,” in violation of 37 C.F.R. § 42.104(b)(4). *Id.* “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’ in compliance with 37 C.F.R. §§ 42.100(b), which ‘warrants denial of [Petitioner’s] petition.’” *Id.* at 17.

In a nutshell, Petitioner responds by characterizing the statement appearing in Dr. Schmidt’s Declaration that is at issue as a “typographical error.” Prelim. Reply 2, 4 (referring to Ex. 1003 ¶ 26). According to Petitioner, “Dr. Schmidt quoted an earlier version of 37 C.F.R. § 42.100(b) that mentioned the ‘broadest reasonable construction’” and this is “a typographical error.” *Id.* at 1–2, *see also* 4 (“a single instance of a typo in Dr. Schmidt’s declaration where he was citing to 37 C.F.R. § 42.100(b).”).

In support of its characterization, Petitioner argues, *inter alia*, that the Petition “clearly explain[s] . . . [that] ‘Petitioner submits that all claim terms should be construed according to the *Phillips* standard. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005); 37 C.F.R. §42.100.’” Prelim. Reply 1 (quoting Pet. 2; also citing an instance of the phrase “[u]nder the *Phillips* standard” at Pet. 2). According to Petitioner, “it is undisputed that the Petition itself is based on the correct *Phillips* standard and that Dr. Schmidt’s claim construction analysis is wholly consistent with the invalidity arguments set forth in the Petition.” *Id.* at 4 (referring to Dr. Schmidt’s claim construction analysis of the claim limitations “NIM” and “NIM template”; *see* Ex. 1003 ¶ 28 (cited at Pet. 3–4) and ¶ 29 (cited at Pet. 4–5), respectively). Dr. Schmidt’s claim construction analysis essentially repeats what is said in the Petition. *Compare* Ex. 1003 ¶¶ 28, 29, *with* Pet. 3–4, Pet. 4–5. Petitioner adds that constructions for these two claim limitations are

“the only claim constructions presented in Dr. Schmidt’s declaration [and were] endorsed by the Federal Circuit under the *Phillips* standard and constructions with which [Patent Owner] agrees.” Prelim. Reply 4, *see also id.* at 3 (citing Prelim. Resp. 19–20).

Patent Owner responds, *inter alia*, that “[Petitioner’s] reply relies *solely* on attorney arguments to claim that Dr. Schmidt made a typographical error. [Petitioner] fails to provide any testimonial evidence as to the nature of the error, an explanation of how the purported error occurred, and how it was discovered.” Prelim. Sur-reply 1. Patent Owner also dismisses the impact of Petitioner’s claim construction analysis of the claim limitations “NIM” and “NIM template” on the question of whether Petitioner has used the correct claim construction standard in its analysis. “[T]hat ‘networked information monitor’ and ‘networked information monitor template’ have established constructions says nothing about Schmidt using *Phillips* when he expressly states that he used BRI in assessing the validity of the challenged claims.” *Id.* at 5. According to Patent Owner, “[t]he Petition actually uses the BRI standard to construe claims because, while it discusses the *Phillips* standard in general on pages 2–3, the Petition relies entirely on Dr. Schmidt’s declaration for evidentiary support for each and every claim element, and Dr. Schmidt admits using BRI.” *Id.* Finally, in an apparent response to Petitioner’s contention that “Patent Owner was [not] unduly burdened by Dr. Schmidt’s typo,” Patent Owner argues that “[r]equiring [Patent Owner] to parse through Dr. Schmidt’s analysis to figure out where he got it wrong/where he may have gotten it right when his declaration only says that he used BRI is unduly prejudicial to [Patent Owner].” *Id.* at 4.

We have carefully considered the parties’ positions. For the following reasons, we are unpersuaded that Petitioner used the wrong claim

construction standard in the analysis. Petitioner’s alleged “failure to use the correct claim construction standard” is not supported by the totality of the evidence in this case. Prelim. Resp. 19.

It is undisputed that the Petition states that “[a]ll claim terms should be construed according to the *Phillips* standard. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005); 37 C.F.R. §42.100.” Pet. 2. Standing alone, there is no dispute that the Petition uses the correct claim construction standard in the analysis.

It only becomes a question because Petitioner’s declarant (Dr. Schmidt) employs the phrase “broadest reasonable construction in light of the specification of the patent in which it appears” in describing his “understand[ing]” of the claim construction standard. Ex. 1003 ¶ 26.

If Dr. Schmidt’s “understand[ing]” of the claim construction standard was that BRI should be used, then it was incorrect. The claim construction standard for claims of challenged unexpired patents in this forum was changed from BRI to the *Phillips* standard in 2018, long before Dr. Schmidt signed the Declaration (Feb. 22, 2023). See “*Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*,” 83 Fed. Reg. 51340, 51340–51359, 51343 (October 11, 2018) (“This change replaces the BRI standard for construing unexpired patent claims and proposed substitute claims in IPR, PGR, and CBM proceedings with the federal court claim construction standard, which is articulated in *Phillips* and its progeny.”); 37 C.F.R. § 42.100(b).

But the Petition articulates, unequivocally, the correct claim construction standard and goes into some detail in explaining what the *Phillips* standard entails. Pet. 2–5 (citing Ex. 1003 ¶¶ 28–29). Although

Petitioner cites Dr. Schmidt’s Declaration in support, a practitioner consulting the Declaration would have no difficulty understanding that the Petition uses the *Phillips* standard and the mention of “broadest reasonable construction in light of the specification of the patent in which it appears” in the Declaration was not the one Petitioner was applying.

We also consider the fact that Dr. Schmidt’s statements are presented within the section of the Declaration devoted to construing “NIM” and “NIM template.” *See* Ex. 1003 ¶¶ 26–29. The constructions in the Declaration for these terms are those set forth in the Petition and rely “on constructions endorsed by the Federal Circuit under the *Phillips* standard.” Prelim. Reply 3. This bolsters our view that the Petition was unequivocal about using the *Phillips* standard to interpret the challenged claims, notwithstanding the Declaration’s mention of the BRI standard.

Finally, it is important to emphasize that Patent Owner does not yet address or dispute any of Petitioner’s contentions on claim construction grounds. *Cf. Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1378 (Fed. Cir. 2023) (“the Board explicitly noted that ‘Patent Owner does not yet dispute Petitioner’s contention’”). “NIM” and “NIM template” are the only claim terms for which Petitioner has proposed constructions and which Patent Owner discusses. Pet. 2–5; Prelim. Resp. 9–12. Even if we were to assume *arguendo*, as Patent Owner argues, that Petitioner used the BRI standard, Patent Owner had an opportunity, and, as we institute, will have an additional opportunity, to propose different constructions under the *Phillips* standard. *Cf. Axonics*, 75 F.4th at 1382 (“In its institution decision, following the parties’ lead, the Board construed the relevant claim terms under the [BRI] standard. . . . For the first time in the patent owner response, because the patent had expired, the patent owner proposed a different

construction under the standard set forth in [*Phillips*]" (discussing *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374 (Fed. Cir. 2018)). But, at this stage, Patent Owner has not pointed to a contention by Petitioner that it believes relies on an allegedly incorrect construction. Patent Owner has not placed in genuine dispute, at this stage of the proceeding, the construction of any claim terms. *Cf. id.* at 1381 ("both parties had agreed to the claim construction adopted by the Board in the institution decision.") Since Patent Owner has not proposed a different construction for any claim term at this stage, on this record, we accept Petitioner's proposition that "[a]ll claim terms should be construed according to the *Phillips* standard." Pet. 2.

We do not agree with Patent Owner that any confusion exists over the Petition using the correct claim construction standard. The evidence does not support Patent Owner's contention that Petitioner "fail[ed] to use the correct claim construction standard." Prelim. Resp. 19.

On this record, we find the Declaration contains an error in its statement of the claim construction standard. Ex. 1003 ¶¶ 26–29. Denying the Petition on that basis alone would be "unduly strict." *Cf. Netflix, Inc. v. DivX, LLC*, 80 F.4th 1352, 1354 (Fed. Cir. 2023) ("The Board's directive that Netflix more precisely articulate the relevant field of endeavor to meet its burden was unduly strict."). To the extent that Patent Owner disagrees with our assessment on that point, Patent Owner may flesh out the issues further during trial, for example, by cross-examination of Petitioner's declarant.

On this record, we decline to "disregard" Dr. Schmidt's declaration or find that "petitioner's entire invalidity analysis is legally flawed." Prelim. Resp. 2.

2. *Construction of Claim Terms*

As discussed above, in interpreting the claims of the '083 patent, we “use[e] the same claim construction standard that would be used to construe the claim[s] 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 (2022); *see also Phillips*, 415 F.3d at 1312–19.

Only those terms that are in controversy need be construed, and only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner submits constructions for “networked information monitor” and “networked information monitor template.” Pet. 3–5. Petitioner’s constructions are the same as those that the Board adopted in IPR2019-01278. *See* Ex. 1012, 9–19. This construction of “network information monitor template” was upheld by the Federal Circuit on appeal. *Lenovo Holding Co., Inc. v. DoDots Licensing Sols. LLC*, No. 2021-1247, 2021 WL 5822248 (Fed. Cir. 2021)⁵; Ex. 1014, 5–9.

Patent Owner does not present arguments against these claim constructions or suggest that we should construe these or any other claim terms. Prelim. Resp. 13. As addressed *supra* Section III.C.1, Patent Owner

⁵ We use the version included in the record as Exhibit 1014 for its pagination.

argues that Petitioner's declarant has applied the wrong standard in providing opinions regarding the proper construction of the claims. *Id.*

We need not construe any claim terms at this point in the proceeding for the purpose of institution. *Nidec Motor Corp.*, 868 F.3d at 1017. However, we note certain of Petitioner's arguments that relate to the constructions of "networked information monitor" and "networked information monitor template" adopted in IPR2019-01278. *See infra* § III.D.4.

3. 37 C.F.R. § 42.104(b)(3)

Patent Owner additionally argues that Petitioner has failed to properly identify corresponding structure for a means-plus-function claim limitation, in violation of 37 C.F.R. § 42.104(b)(3). Prelim. Resp. 20–23. Patent Owner argues that, despite taking a position in the related district court litigation that limitation 1.4 of claim 1 should be interpreted as a means-plus-function claim element, Petitioner did not identify in its Petition corresponding structure in the specification. *Id.* at 20–21 (citing Ex. 2003, 4–5). Patent Owner argues that "nothing precludes [Petitioner] from arguing the '083 claims contain means-plus-function limitations at the district court." Prelim. Sur-reply 6–7. Patent Owner additionally argues that Petitioner's preliminary identification of this claim term as indefinite in the related district court litigation is inconsistent with its position before us that it is definite. Prelim. Resp. 21.

Petitioner contends, in response, that it has not advanced an argument that means-plus-function treatment should be accorded limitation 1.4; and that while it indicated such treatment in initial claim construction pleadings, it did not in the revised constructions submitted to the district court. Prelim. Reply 5 (citing Ex. 1021).

Whether Petitioner could, in the future, argue that limitation 1.4 of claim 1 is a means-plus-function claim limitation in the related district court litigation, Petitioner did not include this in the joint filing listing terms in dispute in that case. Ex. 1021. Petitioner also does not argue that limitation 1.4 of claim 1 is a means-plus-function claim limitation before us, and on the present record, we do not determine that it is. This distinguishes the case before us from the non-designated cases Patent Owner cites to (Prelim. Resp. 20–21), in which (a) a petitioner identified a claim term as requiring means-plus-function claim construction but did not identify a corresponding structure,⁶ (b) the panel independently determined a limitation to require means-plus-function construction, due to “means for” terminology, but the petitioner did not identify a corresponding structure,⁷ or (c) a petitioner did identify a claim term as requiring means-plus-function interpretation and also identified a corresponding structure.⁸ On this record, Patent Owner does not persuade us that the alleged deficiencies warrant a denial of the Petition in this particular case.

*D. Obviousness of Claims 1–5 and 9–13 over Brown and
Obviousness of Claims 1–16 over Brown and Wecker*

Petitioner contends that claims 1–5 and 9–13 are obvious over Brown and that claims 1–16 are obvious over a combination of Brown and Wecker.

⁶ *SAS Institute, Inc. v. Complementsoft, LLC*, IPR2013-00226, Paper 9 at 10–11 (PTAB Aug. 12, 2013); *Clickbooth.com LLC v. Essociate, Inc.*, IPR2015-00464, Paper 9 at 11 (PTAB July 9, 2015)

⁷ *Lindsay Corp. v. Valmont Indus., Inc.*, IPR2015-01039, Paper 7 at 11 (PTAB Sept. 24, 2015).

⁸ *Flotek Indus., Inc. v. Nat’l Oilwell DHT, L.P.*, IPR2015-01210, Paper 11 at 8–9 (PTAB Nov. 6, 2015).

Pet. 8–57. Patent Owner presents certain additional arguments that relate to these arguments. Prelim. Resp. 23–33.

1. *Arguments Relating to the Burden of Production and to the Alleged Inclusion of Additional Prior Art in the Combination*

a. Burden of Production

Patent Owner argues that Petitioner has improperly referenced its arguments with respect to claims 1–8 in its arguments regarding the patentability of claims 9–16. Prelim. Resp. 23–25 (citing Pet. 57). Patent Owner additionally argues that, in the Petition, the descriptions of the references and combinations are incorporated into each mapping that includes citations to the references. *Id.* at 25 (citing Pet. 9 n.2). Patent Owner argues generally that, in these portions of the Petition, the Petitioner evades the word limit and requires us to “play archaeologist” with the record. *Id.* at 23–26.

We are not persuaded that Petitioner’s cross-referencing renders Petitioner’s position unclear, or that any internal references constitute an attempt to circumvent the applicable word limits, as argued by Patent Owner. Our rules prohibit incorporation by reference from one document into another document, but our guidance does not identify internal-cross referencing as an abuse of process. 37 C.F.R. § 42.6(a)(3); *see* Patent Trial and Appeal Board Consolidated Trial Practice Guide 40 (Nov. 2019) (available at <https://www.uspto.gov/trialpracticeguideconsolidated>). A party that includes such cross references risks a determination that the referenced material is confusing, inapposite, or insufficient; for example, a Petitioner’s reliance on cross-referenced arguments may be problematic if a claim difference is not addressed, or if irrelevant portions of a document are cross-referenced and a panel is put in the position of “playing archaeologist” to

determine what the intended arguments are. This does not appear to be the case here.

Having considered the Patent Owner’s procedural arguments carefully, we find that none of the issues identified by Patent Owner renders the Petition deficient, or otherwise warrants denying institution.

b. Alleged Inclusion of Additional Prior Art in the Combination

Patent Owner additionally presents arguments asserting that the obviousness grounds incorporate references other than Brown, Wecker, Shimada, and Buchholz. Prelim. Resp. 26–33. For example, Petitioner styles as “Ground 1A” an argument regarding the obviousness of claims 1–5 and 9–13 over Brown, but Patent Owner asserts that it should be considered as an argument over a combination of Brown, Jones,⁹ Beer,¹⁰ Petty,¹¹ Shimada, Yohanan,¹² and Darnell.¹³ Pet. 1; Prelim. Resp. 28. Patent Owner does not clearly make out its argument that the arguments made are based on the asserted combinations. See Prelim. Resp. 26 (“[A]s 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”), 28 (“[A]s explained above, 1A is a combination of Brown, Jones, Beer, Petty, Shimada, Yohanan and Darnell.”). However, it is clear that the Petition mentions these references in its arguments relating to the obviousness of claim 1 over Brown. Pet. 19–29, 32–41. We examine whether the use of

⁹ Jones et al., US 6,819,345 B1 (Ex. 1010).

¹⁰ Beer, US 5,793,368 (Ex. 1007).

¹¹ Petty et al., US 6,342,907 B1 (Ex. 1013).

¹² Yohanan, US 5,737,560 (Ex. 1016).

¹³ Rick Darnell et al. HTML 4 UNLEASHED (1997) (Ex. 1011).

these references amounts to the use of them in a combination for a showing of obviousness.

It appears that the use of the references generally occurs to support the assertions by Petitioner's declarant regarding what would have been obvious to one of ordinary skill in the art. *See, e.g.*, Pet. 19–20 (invoking Beer and Petty to support Dr. Schmidt's testimony that one of ordinary skill in the art would have understood system memory to be a form of electronic storage); 27–28 (describing Darnell as supporting Dr. Schmidt's testimony that one of ordinary skill in the art would have understood HTML to not include compiled code); 35–36 (citing Shimada and Yohanan to support Dr. Schmidt's testimony regarding a design decision). In fact, it appears that these references each appear for the same purposes in Dr. Schmidt's declaration. Ex. 1003 ¶¶ 46, 59, 69; *see* 37 C.F.R. § 42.65(a). Upon our examination of the record, we see no instance of a use of a reference to supply a teaching or suggestion absent from the references Petitioner asserts it is using, with the possible exception of Jones.¹⁴ *See* Pet. 44. For the purpose of our institution decision, we will not consider Petitioner's arguments relating to Jones.

Based on its assertions regarding the use of these references, Patent Owner argues that the Petition is deficient because it does not include any assertions or analysis regarding their critical date or regarding a motivation to combine these references with the ostensible references used in the grounds. Prelim. Resp. 26–27, 29–33. As discussed, on the present record, with the possible exception of Jones, it does not appear that the Petition

¹⁴ With respect to Jones, it appears that Brown incorporates Jones by reference, though Patent Owner argues that this is unclear. Ex. 1005, 13:39–44; Ex. 1010, codes (54), (73), (22); Prelim. Resp. 31–32.

relies on these references in combination to teach or suggest the claims, and thus we do not agree that the Petition is deficient as argued. As we institute, Patent Owner will have further opportunity to clarify the record with its assertions regarding the use of these references in the grounds asserted.

2. *Brown (Ex. 1005)*

Brown describes a “method of creating a composite desktop built from Web content retrieved from one or more Web sites.” Ex. 1005, code (57).

Brown describes a composite desktop 302 that:

includes one or more desktop components. A desktop component is a distinct geometric region that displays a single piece of Web-based content. . . . [A]ctive desktop component 308 corresponds to a component retrieved locally or from a remote computer. . . . The component may be selected from a Web page, within which the component is embedded. . . . The Web page desktop component 310 corresponds to an entire Web page that was selected for inclusion within the composite desktop 302.

Id. at 7:21–48. The composite desktop and its components are illustrated in Figure 3A, a pictorial representation of a user interface desktop, which is

reproduced below.

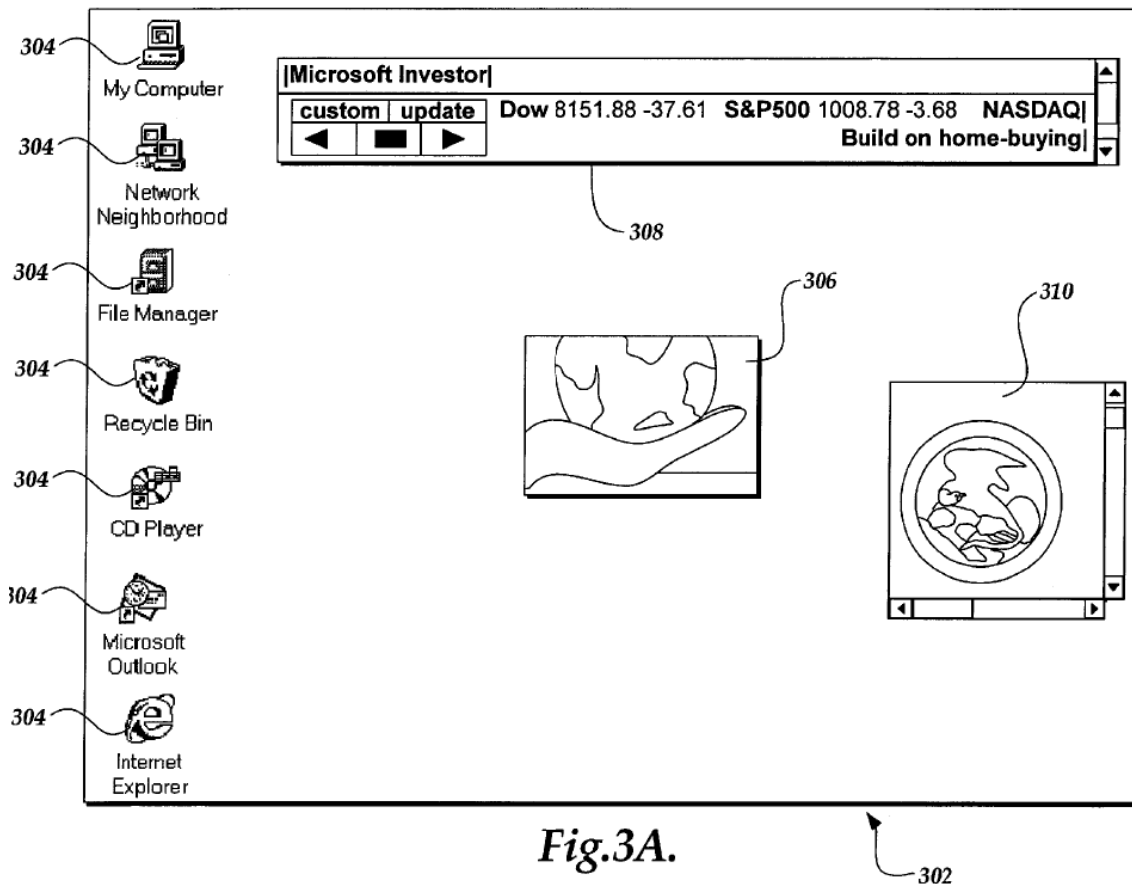


Figure 3A illustrates desktop 302, icons 304, static desktop component 306, active desktop component 308, and Web page desktop component 310. *Id.* at 3:61–62, 7:9–48.

Icons 304 of Figure 3A are displayed in a first transparent window (the “icon layer”) of composite desktop 302 and desktop components (306, 308, 310) are displayed in a second simultaneously-displayed window, the HTML window/layer. *Id.* at 7:66–8:9. An exemplary 40-line file corresponding to the HTML layer of desktop 302 depicted is provided in the specification. *Id.* at 11:29–12:43. Lines 10 through 13 of this file “include HTML instructions that correspond to the Web page desktop component 310.” *Id.* at 13:14–15. Lines 14 through 17 of this file “comprise HTML

instructions that describe the active desktop component 308.” *Id.* at 12:61–62. These “include a URL specifying an Internet location where additional HTML code corresponding to the active desktop component 308 resides.” *Id.* at 13:1–4.

These lines 10 through 17 are:

```
10. <IFRAME id=7 MARGINWIDTH=0
MARGINHEIGHT=0 name="DeskMovrW"
src="http://www.uspto.gov/"
11. resizable="XY"
12. subscribed_url="http://www.uspto.gov/"
13. frameborder=0 style="BACKGROUND: transparent;
position:absolute; LEFT:620; TOP:254; WIDTH:156;
HEIGHT:150; Z-INDEX:1014"></IFRAME>
14. <IFRAME id=8 MARGINWIDTH=0
MARGINHEIGHT=0 name="DeskMovrW"
src="http://www.microsoft.com/ie/ie40/gallery/ticker.htm"
15. resizable="XY"
16. subscribed_url="http://www.microsoft.com/ie/ie40/gallery/
cdf/g_stock.cdf"
17. frameborder=0 style="BACKGROUND: transparent;
position:absolute; LEFT:178; TOP:26; WIDTH:516;
HEIGHT:57; Z-INDEX:1016"></IFRAME>
```

Id. at 11:59–12:10.

3. *Wecker (Ex. 1006)*

Wecker describes:

A method for rendering information . . . available through the Internet on a computer includes storing a content structure file, a data file and a script file. . . . The content structure file is read to ascertain which script in the script file is associated with data to be rendered. The data from the data file is retrieved and the associated script file is executed to render the data.

Ex. 1006, code (57).

Wecker indicates that content structure files (also termed “content definition format” or “CDF” files), script templates, and data files for display on a mobile device are stored in a cache memory of a mobile device. *Id.* at 3:3–6, 6:34–39, Fig. 6. The system allows content to be delivered and updated “in small segments of data instead of full HTML pages” to “make[] it efficient and economical to update time-critical information.” *Id.* at 10:41–51.

4. *Analysis of Claim 1 –
Obviousness over Brown or over Brown and Wecker*

Petitioner argues that claim 1 would have been obvious over Brown, and also over a combination of Brown and Wecker. Pet. 19–41.

Petitioner argues that, to the extent the preamble is limiting, Brown teaches a “client device” in its computer. Pet. 19 (citing Ex. 1005, 2:54–57, 4:32–40, Claim 15; Ex. 1003 ¶¶ 44–45).

With respect to limitation 1.1 of claim 1, relating to electronic storage having a plurality of NIM templates defining a plurality of NIMs, Petitioner argues that Brown’s system memory and/or registry would have stored the HTML instructions defining a composite desktop containing desktop components, and that these desktop components teach or suggest NIMs. *Id.* at 19–23 (citing, *inter alia*, Ex. 1005, 4:54–58, 6:20–26, 6:34–36, 7:21–22, 11:1–13:54, 14:8–9; Ex. 1003 ¶¶ 46–50). Petitioner notes that its desktop components are implemented as floating frames with frame controls, which can be positioned on a desktop and resized, and that they display a piece of web-based content. *Id.* at 23–25 (citing Ex. 1005, 7:22–26, 12:61–65, Fig. 3A; Ex. 1003 ¶¶ 51–52). Petitioner argues that the HTML instructions that define the desktop components in Brown would thus be NIM templates as

per the construction we adopt. *Id.* at 25–27 (citing Ex. 1005, 7:57–59, 11:39–12:10, 12:61–62, 14:7–8, Fig. 3A; Ex. 1003 ¶¶ 54–58). Petitioner argues that, as HTML instructions, they do not contain compiled code. *Id.* at 27–28 (citing Ex. 1005, 6:36–37, 11:56–12:10; Ex. 1003 ¶ 59).

Petitioner argues that limitation 1.1 is additionally taught by the combination of Brown and Wecker. Pet. 29–32. Petitioner proposes a combination in which Wecker’s cache storing HTML templates is “leverage[d]” in Brown’s system and in which Brown’s desktop components could be implemented as described in Wecker’s disclosure of mobile channels. *Id.* at 13. Petitioner provides a detailed explanation of the similarities between the references, which, Petitioner contends, would have led one of ordinary skill in the art to pursue the combination is the application of known techniques to yield predictable results. *Id.* at 14–15 (citing Ex. 1005, 12:61–62; Ex. 1006, 3:17–20; Ex. 1003 ¶¶ 37–38). Petitioner argues that one of ordinary skill would have had a reasonable expectation of success in making this combination. *Id.* at 14–15 (citing Ex. 1003 ¶ 38). Petitioner argues that, in this combination, Wecker’s mobile electronic storage (cache memory) would hold script templates for Wecker’s mobile channels. *Id.* at 29–30 (citing Ex. 1006, 8:31–39, Figs. 6–7; Ex. 1003 ¶¶ 61–62).

With respect to the content reference of limitation 1.2 of claim 1, Petitioner argues that Brown’s content files, including a URL to an internet location, teach or suggest the network location at which content for a desktop component is found. *Id.* at 32–34 (citing Ex. 1005, 12:5–6, 13:1–5; Ex. 1003 ¶¶ 64–66). With respect to the definition of a graphical user interface lacking controls for manually navigating a network and including a frame and frame characteristics, Petitioner argues that Brown’s desktop

components/floating frames comprise such graphical user interfaces, and are defined by Brown's HTML instructions. *Id.* at 34–36 (citing Ex. 1005, 12:1–10, 12:61–64, Fig. 3A; Ex. 1003 ¶¶ 68–70). For the instructions that cause the NIM to request content from the network location in the content reference and to generate the graphical user interface of the NIM, Petitioner similarly cites the HTML instructions in Brown, with its content subscription and user-interface information. *Id.* at 37–38 (citing Ex. 1005, 11:39–12:43, 13:1–13; Ex. 1003 ¶¶ 72–73).

Lastly, for limitations 1.5 and 1.6, which require an electronic display and processors configured to access and execute the NIM such that the graphical user interface of the NIM is presented on the electronic display, Petitioner cites Brown's monitor and the HTML viewer and desktop shell that execute the HTML instructions and present the resulting interface. *Id.* at 39–41 (citing Ex. 1005, 5:38–39, 6:26–41, Figs. 1–2; Ex. 1003 ¶¶ 74–76).

Patent Owner presents no additional arguments with respect to these assertions. On the present record, we determine that Petitioner has made a sufficient showing of a reasonable likelihood that it would prevail with respect to showing that claim 1 would have been obvious over Brown, and that claim 1 would have been obvious over Brown and Wecker.

5. *Analysis of Claims 2 and 3 –
Obviousness over Brown or over Brown and Wecker*

With respect to claims 2 and 3, Petitioner presents arguments relating to the claimed inclusion in the NIM template of “control characteristics that define one or more controls that are usable . . . to interact with or control the first networked information monitor” (claim 2) and that define visual representations of such controls (claim 3) with reference to the teaching in Brown that Brown's desktop components are resizable and scrollable, and

that Brown shows visual representations of these controls. Pet. 42–43, 45 (citing Ex. 1005, 7:59–61, 9:13–27, 12:4, Fig. 3A; Ex. 1003 ¶ 78).

Petitioner makes an additional argument with respect to Jones that we do not consider, as discussed *supra* Section III.D.1.b.

Patent Owner makes no additional arguments with respect to claims 2 and 3.

On the present record, we determine that Petitioner has made a sufficient showing of a reasonable likelihood that it would prevail with respect to showing that claims 2 and 3 would have been obvious over Brown, and that claims 2 and 3 would have been obvious over Brown and Wecker.

6. *Analysis of Claims 4 and 5 –
Obviousness over Brown or over Brown and Wecker*

Claims 4 and 5 relate to a second NIM template and second NIM, substantially similar to the first NIM template and first NIM of claim 1, with claim 5 requiring that the user interface of the second NIM is presented “separately and discretely” from the user interface of the first NIM. Ex. 1001, 48:18–49.

Petitioner argues that Brown teaches multiple networked information monitors in its multiple desktop components, each with its own content reference and associated network location, which are displayed separately and independently of one another. Pet. 46–50 (citing Ex. 1005, 4:13–19, 7:21–23, 11:56–67, Fig. 3A; Ex. 1003 ¶¶ 84–85, 88–91).

Patent Owner makes no additional arguments with respect to claims 4 and 5.

On the present record, we determine that Petitioner has made a sufficient showing of a reasonable likelihood that it would prevail with

respect to showing that claims 4 and 5 would have been obvious over Brown, and that claims 4 and 5 would have been obvious over Brown and Wecker.

7. *Analysis of Claims 6–8 –
Obviousness over Brown and Wecker*

Claims 6–8 relate to the transmission of a request to a server for a further NIM template responsive to the reception of a user request for the NIM defined by the further NIM template (claim 6) and to the storage and execution of the further NIM template (claims 7 and 8). Ex. 1001, 48:50–63.

Petitioner argues that Wecker’s disclosure of the periodic retrieval of new channels and of a user subscribing to a new channel teaches or suggests this request from a user (of a desktop as in Wecker) to a server. Pet. 51–52 (citing Ex. 1006, 3:63–66, 4:3–6, 7:55–63; Ex. 1003 ¶¶ 92–95). Petitioner contends that this combination would allow Wecker’s subscriptions to be implemented for the HTML instructions of Brown that provide the desktop components. *Id.* at 52–53 (citing Ex. 1005, 13:5–9; Ex. 1006, 4:4–5, Ex. 1003 ¶ 94). Petitioner additionally argues that such HTML instructions would have been stored and executed. *Id.* at 54–55 (citing Ex. 1003 ¶¶ 96–99). Petitioner additionally supports this combination of Brown with Wecker as the application of known techniques to a known structure, and motivated by certain efficiency benefits, and asserts that one of ordinary skill would have had a reasonable expectation of success in this combination. *Id.* at 15–18 (citing Ex. 1006, 4:53–62; Ex. 1003 ¶¶ 40–41).

Patent Owner makes no additional arguments with respect to claims 6–8.

On the present record, we determine that Petitioner has made a sufficient showing of a reasonable likelihood that it would prevail with respect to showing that claims 6–8 would have been obvious over Brown and Wecker.

8. *Analysis of Claims 9–16*

Petitioner argues claims 9–16 are obvious, mainly relying on its arguments with respect to claims 1–8. Pet. 56–57. On this record, claims 9–16 appear to be substantially similar to claims 1–8. *Compare* Ex. 1001, 47:42–48:63, *with id* at 48:64–50:43. Petitioner addresses the distinct preamble of independent claim 9. Pet. 56–57 (citing Ex. 1005, claim 19; Ex. 1003 ¶¶ 100–101). Patent Owner makes no additional arguments with respect to these claims.

For the reasons detailed above, on the present record that Petitioner has made a sufficient showing of a reasonable likelihood that it would prevail with respect to showing that claims 9–13 would have been obvious over Brown or over a combination of Brown and Wecker, and that claims 14–16 would have been obvious over Brown and Wecker.

E. Obviousness of Claims 1–16 over Shimada and Buchholz

Petitioner contends that claims 1–16 are obvious over a combination of Shimada and Buchholz. Pet. 57–95. Patent Owner makes certain additional arguments relating to this ground. Prelim. Resp. 33–37.

1. *Shimada (Ex. 1005)*

Shimada describes adding a new screen display area to screen configuration information, which contains data to be displayed and information on the configuration of the screen for displaying data. Ex. 1008, 5:52–65. For example, an interface for interactive communication with a user at the client is added to a client display screen. *Id.* at 5:66–6:6.

Exemplary screen configuration data includes information regarding the location of static images (having a “.gif” extension) and of additional screen configuration data (having a “.html” extension). *Id.* at 6:14–58, Figs. 5, 6.

2. *Buchholz (Ex. 1009)*

Buchholz is directed to a method and apparatus in a wireless communication system for controlling a display of template data by a portable subscriber unit. Ex. 1009, codes (54), (57). Buchholz describes a “pack” programmed into the portable subscriber unit; the pack has a bundle of HTML templates for formatting template data for display on the page, in order to present data to a user. *Id.* at 5:1–11. “A template can, for example, define where, and in what size and color, the corresponding template data is to be displayed.” *Id.* at 5:11–13. “Keeping the pack in the portable subscriber unit 122 advantageously reduces latency for template data that is repeatedly updated and displayed in a fixed format, e.g., information services data such as a stock report.” *Id.* at 5:37–41.

3. *Obviousness of Claim 1 over Shimada and Buchholz*

Petitioner argues the obviousness of claim 1 over Shimada and Buchholz. Pet. 61–84. Patent Owner makes additional arguments regarding Petitioner’s contentions. Prelim. Resp. 33–37.

Generally, Petitioner proposes a combination of Shimada and Buchholz, in which Shimada’s “screen configuration data” is used in Buchholz’s subscriber units, is used or substituted as a template in Buchholz. Pet. 62, 64. Petitioner argues that one of ordinary skill in the art would have recognized the similarities between the references and would have performed this modification with little modification and a reasonable expectation of success. *Id.* (citing Ex. 1003 ¶¶ 122–124).

Petitioner relies on Buchholz's memory for claim 1's recited electronic storage, electronic display, and one or more processors. Pet. 63–64, 82, 83 (citing Ex. 1009, 4:1–2, 4:23–25, 5:7–9; Ex. 1003 ¶¶ 126, 148, 150–151). Petitioner additionally relies on Shimada's client screen display and information processing unit for the electronic display and processors. *Id.* at 81–83 (citing Ex. 1008, 1:26–28, 6:4–9, Fig 6; Ex. 1003 ¶¶ 147, 149).

While citing Buchholz's discussion of a template defining layout, location, size and color of the display of template data and for the execution of a NIM template (Pet. 79, 83–84, citing Ex. 1008, 5:7–9, 5:11–13; Ex. 1003 ¶¶ 142, 151), Petitioner generally relies on Shimada's screen configuration data for the claimed NIM template and a display according to the NIM template for the NIM features recited in claim 1. *See, e.g.*, Pet. 66–74 (citing, *inter alia*, Ex. 1008, 6:7–51, 7:19–23, 8:65–67, Figs. 17, 18, 22; Ex. 1003 ¶¶ 128–135).

Patent Owner contends that the showing is deficient because the disclosed components of the Shimada HTML file (corresponding, in Petitioner's argument, to the NIM template) are local references, which precludes accessing the content via a TCP/IP protocol. Prelim. Resp. 33–34. Patent Owner argues that the HTML file includes both content and controls for interacting with the screen in the same file. *Id.* However, on the current record, it appears that Shimada's HTML file includes references to content, but not the content itself, which can be separately transferred to a user device for display upon request. Ex. 1003 ¶ 130; Ex. 1008, 6:30–51 (describing HTML that includes an “address representing a static image,” which can be requested from the server and displayed on the screen of the client when a corresponding button is selected by a user).

Patent Owner additionally argues that Shimada does not teach or suggest “a network location at which content for the first networked information monitor is accessible via a TCP/IP protocol” because Shimada’s HTML code examples are relative uniform resource locators (URLs) that would retrieve locally stored information, and not information retrieved from a network. Prelim. Resp. 34–37 (citing Ex. 1008, Figs. 5, 6, 17). This argument does not address Dr. Schmidt’s testimony that Shimada’s network could be the Internet (Ex. 1003 ¶¶ 22, 136 (cited at Pet. 74)), or that Buchholz’s communication interface is also cited for the connection of the portable subscriber units with the server from which template data is obtained (Ex. 1009, 4:34–36; Ex. 1003 ¶ 138 (cited at Pet. 75–76)).

On the present record, Petitioner has made a sufficient showing of a reasonable likelihood that it would prevail with respect to showing that claim 1 would have been obvious over the combination of Shimada and Buchholz.

4. *Claims 2–16*

Petitioner makes additional showings with respect to the obviousness of claims 2–16 over Shimada and Buchholz. Pet. 84–95. Patent Owner does not present any additional arguments with respect to these claims.

As we institute on other grounds, we do not address Petitioner’s showing as to claims 2–16 on this ground at this time.

IV. CONCLUSION

For the foregoing reasons, we determine that Petitioner demonstrates a reasonable likelihood of prevailing with respect to at least one of the claims challenged in the Petition. Accordingly, *inter partes* review of the ’083 patent shall proceed in this case on all of the grounds raised in the Petition.

Our determination in this Decision is not a final determination on either the patentability of any challenged claims or the construction of any claim term. The factual findings set forth in this Decision are preliminary and provided for the sole purpose of deciding whether to institute a review. Any final findings will be based on the full trial record, including any information presented by Patent Owner in a timely filed response to the Petition. *See TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (noting that “there is a significant difference between a petitioner’s burden to establish a ‘reasonable likelihood of success’ at institution, and actually proving invalidity by a preponderance of the evidence at trial”) (quoting 35 U.S.C. § 314(a) and comparing *id.* with § 316(e)).

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–16 of the ’083 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), notice is hereby given of the institution of a trial.

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FOR PETITIONER:

W. Karl Renner
Jeremy J. Monaldo
Hyun Jin In
FISH & RICHARDSON P.C.
IPR39843-0148IP1@fr.com
PTABInbound@fr.com
axf-ptab@fr.com
jjm@fr.com
in@fr.com

FOR PATENT OWNER:

Jason S. Charkow
Richard Juang
Chandran B. Iyer
DAIGNAULT IYER LLP
jason.s.charkow@gmail.com
richard.juang@gmail.com
cbiyer@daignaultiyer.com