

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**NETFLIX, INC.,**

Petitioner

v.

**VIDEOLABS, INC.,**

Patent Owner

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IPR2023-00628  
U.S. Patent 7,233,790

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**PATENT OWNER'S RESPONSE**

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**PATENT OWNER'S EXHIBIT LIST**

| <b>Exhibit</b> | <b>Description</b>                                                                                                                                      |
|----------------|---------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2001           | <i>Ex Parte</i> Reexam Request in Reexam Control No. 90/015,063                                                                                         |
| 2002           | Reexam Order in the '063 Reexam                                                                                                                         |
| 2003           | Non-Final Office Action in the '063 Reexam                                                                                                              |
| 2004           | U.S. Patent Application Publication No. 2002/0078178 to Senoh                                                                                           |
| 2005           | U.S. Patent No. 6,035,339 to Agraharam et al.                                                                                                           |
| 2006           | U.S. Patent No. 6,421,726 to Kenner et al.                                                                                                              |
| 2007           | U.S. Patent No. 6,345,279 to Li et al.                                                                                                                  |
| 2008           | Response to the Non-Final Office Action in the '063 Reexam                                                                                              |
| 2009           | Final Rejection in the '063 Reexam                                                                                                                      |
| 2010           | Response to Final Rejection the '063 Reexam                                                                                                             |
| 2011           | Notice of Intent to Issue Reexam Certificate in '063 Reexam                                                                                             |
| 2012           | Amendment After Final or under 37CFR 1.312, initialed by the examiner                                                                                   |
| 2013           | '063 Reexam Transactions Docket in Patent Center                                                                                                        |
| 2014           | Scheduling Order for <i>Starz Entertainment, LLC v. VL Collective IP, LLC</i> , Case 1-21-cv- 01448 (D. Del.)                                           |
| 2015           | Starz's Second Amended Disclosure of Invalidity Contentions in <i>Starz Entertainment, LLC v. VL Collective IP, LLC</i> , Case 1-21-cv- 01448 (D. Del.) |
| 2016           | Declaration of Jaime F. Cardenas-Navia in Support of Motion For Admission <i>Pro Hac Vice</i>                                                           |
| 2017           | Correspondence in <i>Starz Entertainment, LLC v. VL Collective IP, LLC</i> , Case 1-21-cv- 01448 (D. Del.)                                              |
| 2018           | Reexam Certificate from the '063 Reexam                                                                                                                 |
| 2019           | Hearing Transcript from <i>Intramedic Co. Ltd. v. Given Imaging Ltd</i> IPR2015-00579, EX2003 (PTAB Aug. 5, 2015)                                       |
| 2020           | Expert Declaration of Dr. Michael T. Goodrich                                                                                                           |
| 2021           | Deposition Transcript of Mr. Anthony Wechselberger                                                                                                      |

VideoLabs, Inc. (“Patent Owner”) submits this Response to the Petition of Netflix, Inc. (“Petitioner”) seeking *inter partes* review (“IPR”) of U.S. Patent No. 7,233,790 (the “’790 patent”). The Response is supported by the declaration of Dr. Michael T. Goodrich (EX2020). EX2020, ¶¶1-127.

## **I. INTRODUCTION**

The Petition fails to show that any of the challenged claims are unpatentable. The relied-upon references, Mehta and Schläpfer, take an entirely different approach than the ’790 patent. The ’790 patent enables the creation of a centralized, dynamic store of content. The ’790 patent makes this possible through a specific, two-layer hierarchy: there is (1) the content itself and (2) the different versions, or implementations, of the content (for example, different implementations for different device capabilities). As an example, a program, such as Microsoft Word, can be thought of in two ways: (1) a single piece of content, “Microsoft Word” and (2) multiple implementations of the content, such as the Microsoft Word file for Windows and or the Microsoft Word file for Macs. The ’790 patent takes advantage of this discovery by creating a store in which the user is only presented with the piece of content (e.g., Microsoft Word), not the individual implementations of that content. Yet, when the user selects their piece of content, the patented invention ensures that the user only gets the correct implementation, all without the user knowing.

Mehta and Schläpfer take an entirely different approach. Mehta does not recognize or take advantage of the hierarchical division of content and its implementations. Instead, Mehta discloses single-version applications that do not have different implementations for different device requirements. Mehta's failure to disclose *both* "applications" and "implementations" of those applications means it also fails to disclose the '790 patent's mechanisms for managing the relationship between "application" and "implementations," such as "references" to each implementation and only presenting a single description per application. For the example above, a Mehta store would only have "Microsoft Word," without multiple versions. In sum, Mehta teaches a fundamentally different approach to content delivery than the '790 patent.

Schläpfer, which Petitioner relies on for other elements, similarly does not disclose or suggest the '790 patent's innovative approach. Far from anticipating or rendering obvious the challenged claims of the '790 patent, Mehta and Schläpfer teach away from its central innovation.

## **II. BACKGROUND**

### **A. Overview of the '790 Patent (EX1001)**

U.S. Patent No. 7,233,790 was filed June 19, 2003 and issued June 19, 2007. It lists Rikard M. Kjellberg, Sheng Liang, Tomas G. Lund, William Chan, Ramakrishna Chinta, and Xinbi Chen as inventors. It claims priority to Provisional

application No. 60/393,024, filed on June 28, 2002; provisional application No. 60/392,383, filed on Jun. 28, 2002; provisional application No. 60/393,041, filed on Jun. 28, 2002; and provisional application No. 60/392,999, filed on Jun. 28, 2002.

In the early 2000s, around the time of the '790 patent invention, there was an explosion of computing devices such as laptops, PDAs, mobile phones, and other wireless devices that entered the market, each with different capabilities, as well as a vast increase in the number of content providers offering digital content. EX1001, 1:22-25, 1:40-2:17, 3:45-60. The inventors of the '790 patent realized that, if content providers wanted to ensure that content would work properly on a range of devices, they either had to make separate items of content for each device or they had make multiple different “implementations” (or versions) of each item of content. *Id.*, 9:49-62. Additionally, each implementation had to be “provisioned” differently for different devices, (*id.*, 1:60-2:7), and each piece of content might require different “packaging,” (*id.*, 1:63-27, 12:65-13:15).

The result was highly fragmented digital storefronts for purchasing content. *See id.*, 1:50-59 (describing the prior art storefronts). Each store had to provide content for every device that it wanted to sell its products to. *See id.*, 1:60-63. Unless customers already knew which content store had appropriate content for their device, they would have to visit multiple stores to find one that had device-appropriate content.

The '790 patent addresses these problems with a “download manager,” which utilizes the distinction between content generally and the various implementations of that content. *Id.*, 3:63-4:8. For example, Lion King is a piece of content. The various versions of Lion King (such as an .mp3 file or an .mov file) are the implementations of Lion King. EX2020, ¶39. As another example, Microsoft Word is another piece of content, while the versions of Microsoft Word for Windows and Microsoft Word for Apple Macs are different implementations. *Id.* The download manager is a unique innovation that manages the various relationship between the content, the implementations of that content, the device capabilities suitable for each implementation, the packaging and provisioning options for each implementation of content, and the device capabilities suitable for each packaging and provisioning option. EX1001, 4:9-25.

By storing and maintaining these relationships, the '790 patent creates a centralized, scalable store in which the user is only presented with the items of content, while the store maintains references to each implementation, unbeknownst to the user. This store allows the users to only have to deal with the item of content themselves, while ensuring they always receive the correct implementation of that content. *Id.*, 1:50-2:17, 8:66-9:12. Continuing the first example above, the user can select the Lion King but will actually be delivered the particular implementation of the Lion King (e.g., an .mp3 file) that works on their device. In the second example,

the user can select “Microsoft Word” and the user will be sent, for example, Microsoft Word for a Mac (if the user has an Apple Mac). Ultimately, this dynamic store is made possible by the ’790 patent’s novel multi-layer system which conceptually divides, on the one hand, the items of content and, on the other hand, the implementations of that content. EX2020, ¶¶36-40.

**B. The Claims of the ’790 Patent**

The ’790 patent has four independent claims, claims 1, 2, 8, and 9. EX2020, ¶¶41-42. Claim 2 is an exemplary method that reflects the above-described invention:

2. A method of providing access to digital content for use on wireless communication devices, the method comprising:

receiving and storing in a server system a plurality of items of digital content to be made available for use in wireless communication devices used by a plurality of wireless services Subscribers, including receiving and storing a plurality of different implementations of at least one of the items of digital content, where each implementation of any given item of digital content corresponds to a different set of device capabilities

operating the server system to maintain a product catalog containing a description of the items of digital content, wherein the product catalog

includes, in association with each item of digital content, a reference to each implementation of said item of digital content;

receiving a request from a wireless device used by one of the subscribers;

in response to the request, selecting a portion of the product catalog to be presented to the subscriber, based on device capabilities of the wireless device used by the subscriber; and

presenting the selected portion of the product catalog to the subscriber via a wireless network, such that the selected portion, as presented to the subscriber, provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item.

EX1001, claim 2.

The dependent claims 3-8 and 10-14 also add additional limitations.

### **C. Overview of Mehta (EX1003)**

Mehta provides a system for maintaining and provisioning wireless applications. EX1003, Abstract. In particular, Mehta is directed to addressing the problem that “[c]ontent providers, who wish to develop applications for such wireless devices, must do so for each device they wish to support . . . .” *Id.*, ¶0004. That is, Mehta assumes that in order to make an application work on “each device,” content providers must “develop” a different application for “each device.” This

stands in stark contrast to the '790 patent, which uses a two-layer hierarchy to take advantage of the fact that individual items of content (such as an application) can be broken into multiple implementations, each of which work with a different device. Ultimately, Mehta and the '790 patent fundamentally view the world differently, and thus propose different solutions. Mehta assumes that you must have a different application for each device, and so is concerned with how to manage and provision the resulting huge number of applications. *Id.*, ¶0004. Conversely, the '790 patent recognizes that you do not need a new item of content for each device, but can break up that content into different implements, and so is concerned with managing the relationship between content and implementation. Thus, in contrast to the '790 patent, Mehta does not teach or suggest including multiple versions (or, implementations) of a single application—indeed, Mehta is premised on the idea that you need an entirely new application for each new device.

At a high level, Mehta provides a Mobile Application System (MAS) that allows for uploading and downloading mobile applications. *See id.*, ¶0061. Mehta allows content providers to publish applications. *See id.*, ¶0064. Fig. 2 (reproduced below) illustrates a mobile device that can operate MAS.

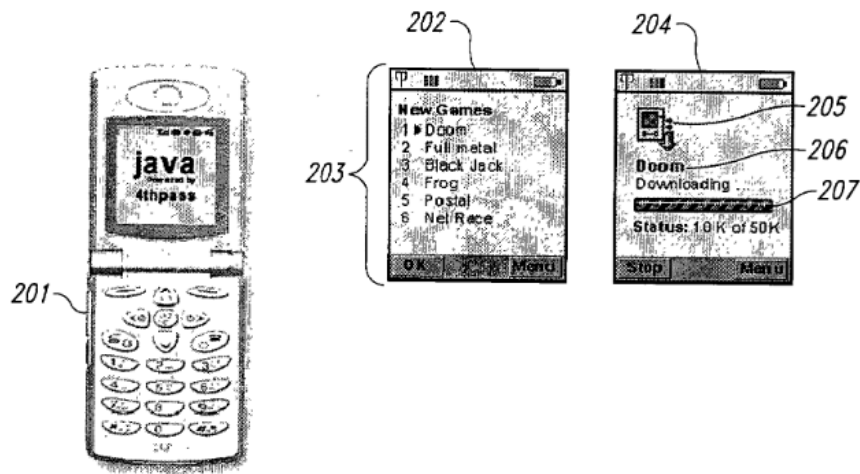


*Fig. 2*

*Id.*, Fig. 2

Mehta discloses that the MAS is able to respond to user's requests either for an application or for a list of applications. *Id.*, ¶¶0006-0009, 0016, 0067-0070. As a part of responding to that request, the MAS determines which applications are “compatib[le] with a requesting subscriber device.” *Id.*, Abstract, ¶0067 (“[T]he MAS may analyze various profiles, for example a subscriber profile, a device profile, and an application profile to determine whether the subscriber is authorized to use the application and whether the application’s needs, as reflected in the application profile, are met by the device, as reflected in the device profile.”); ¶¶0005, 0073, 0098. In particular, for a request for an application, the MAS will refuse the request if the application is incompatible. For a request for a list of

applications, the MAS can filter out applications that are not compatible with the user's device, leaving a list of only compatible applications. As discussed above, Mehta does not contemplate the idea of different versions of applications—it only determines whether or not the single version of the application is compatible. EX2020, ¶¶43-46.

#### **D. Overview of Schläpfer (EX1009)**

Schlapfer is a white paper that describes JAVA mobile applications. *See* EX1009, 3. Schlapfer provides a guide for developing and testing mobile applications. *See id.* Schlapfer also describes using the Mobile Information Device Profile (MIDP) for the J2ME Platform. *See id.*, 7-10. The Petition does not rely on Schlapfer to teach or suggest multiple implementations of an individual piece of content, as required by the independent claims of the '790 patent. EX2020, ¶¶47.

### **III. PRIORITY DATE OF THE '790 PATENT**

Petitioner assumes a priority date of June 19, 2003, which is the filing date of the '790 patent. Pet., 14-16. Patent Owner reserves all rights to establish its preferred priority date in this or other proceedings, but does not dispute this assumed priority date for purposes of its Response. The Petition fails regardless of the priority date of the '790 patent. EX2020, ¶48.

#### **IV. LEVEL OF ORDINARY SKILL**

Petitioner sets forth a level of ordinary skill. Pet., 16. Patent Owner's expert proposes a similar level, but regardless this Response establishes that Petitioner's arguments fail even under its preferred definition of the level of ordinary skill. EX2020, ¶¶49-52.

##### **A. RELATED MATTERS**

Patent Owner is asserting the '790 patent in the following district court actions:

- *VideoLabs, Inc. v. Netflix Inc.*, Case 1:22-cv-00229 (D. Del.)
- *Starz Entertainment, LLC v. VL Collective IP, LLC*, Case 1-21-cv-01448 (D. Del.)
- *VideoLabs, Inc. v. Roku, Inc.*, Case 1:23-cv-01136 (D. Del.)
- *Unwired Planet, LLC v. Apple, Inc.*, Case 3:13-cv-04134 (N.D. Cal.)
- *Unwired Planet, LLC v. Apple Inc.*, Case 3:12-cv-00505 (D. Nev.)

The '790 patent was also involved in *Ex Parte* Reexam Control No. 90/015,063.

#### **V. CLAIM CONSTRUCTION**

##### **A. Patent Owner's Claim Construction Analysis**

Petitioner has not presented a proposed construction for any of the terms. *See* Pet., 22-25. Patent Owner submits that no express construction of any term is

required at this stage. For the purposes of the Petition and Patent Owner Preliminary Response (POPR) Patent Owner applies the plain and ordinary meaning of the claim terms. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). Patent Owner does not waive any rights to assert constructions should the Petition be instituted.

Petitioner acknowledges that the Court in a related case ordered that, for the “wireless communication devices”/“wireless device,” no construction is necessary but that the term is not restricted to “personal mobile devices;” construed “content”/“digital content”/“product”/“digital product” to mean to “software and/or data embodying a file for delivery or purchase;” and construed “implementation” to mean “one or more binary files (or ‘binaries’), software files, software applications, and/or executable files representing a product.” Petitioner has not shown that any claim is unpatentable under either these constructions or the plain and ordinary meaning of the terms. EX2020, ¶53.

## VI. ASSERTED GROUNDS

The Petitioner asserts the following grounds in the Petition:

| Ground | Challenged Claims | Basis | References |
|--------|-------------------|-------|------------|
| 1      | 1-4 and 8-11      | §102  | Mehta      |

|   |      |      |                               |
|---|------|------|-------------------------------|
| 2 | 1-14 | §103 | Mehta in view of<br>Schlapfer |
|---|------|------|-------------------------------|

**VII. PETITIONER HAS NOT SHOWN THAT ANY CHALLENGED CLAIMS ARE UNPATENTABLE**

**A. Ground 1: Mehta Does Not Anticipate Claims 1-4 And 8-11**

**1. Mehta Does Not Disclose a Plurality of Different Implementations of At Least One of the Items of Digital Content.**

Each claim of the '790 patent requires “receiving and storing a plurality of different implementations of at least one of the items of digital content. *See* EX1001, Claims (cls.) 1, 2, 8, 9.<sup>1</sup> A POSITA would understand Mehta to take a fundamentally different view of the world than the '790 patent does: Mehta assumes that there must be a different application for each set of device requirements; the inventors of the '790 patent figured out that you could offer a single application (or other item of content) while storing different implementations of that content for each set of

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<sup>1</sup> Various independent and dependent claims of the '790 patent recite further elements that expound on the “implementations” limitation. *See* Cl. 2, 9 (“provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item”), Cl. 3, 10 (“each implementation of the plurality of items of digital content has been previously associated in the server system with at least one device identity, according to corresponding device capabilities supported by the implementation”), 4, 11 (“downloading the selected implementation of the item of digital content to the wireless device used by the subscriber.”). Mehta of course does not disclose these additional limitations for the same reason it does not disclose implementations of at least one of the items of digital content generally.

device requirements. EX2020, ¶54. This fundamental disconnect demonstrates that Mehta does not disclose “a plurality of different implementations of at least one of the items of digital content.”

**a. The claims require both a “plurality of items of digital content” and “a plurality of different implementations of at least one of the items of content.”**

The independent claims require both (1) “a plurality of items of digital content” as well as (2) a plurality of different implementations of at least one of the items of digital content. Mr. Wechselberger acknowledged this during his deposition, agreeing that “the claims of the ’790 patent require, *one*, multiple items of content, and *two*, that at least one item of content has multiple different versions.” Deposition Transcript of Mr. Anthony Wechselberger (EX2021), 60:6-11 (emphasis added); EX1002, ¶51; EX2020, ¶55.

This division between content on the one hand and different implementations (or versions) of that content on the other hand is described in the specification. Figure 6, shown below, “shows the relationship between a product and its implementations.” EX1001, 3:21-22.

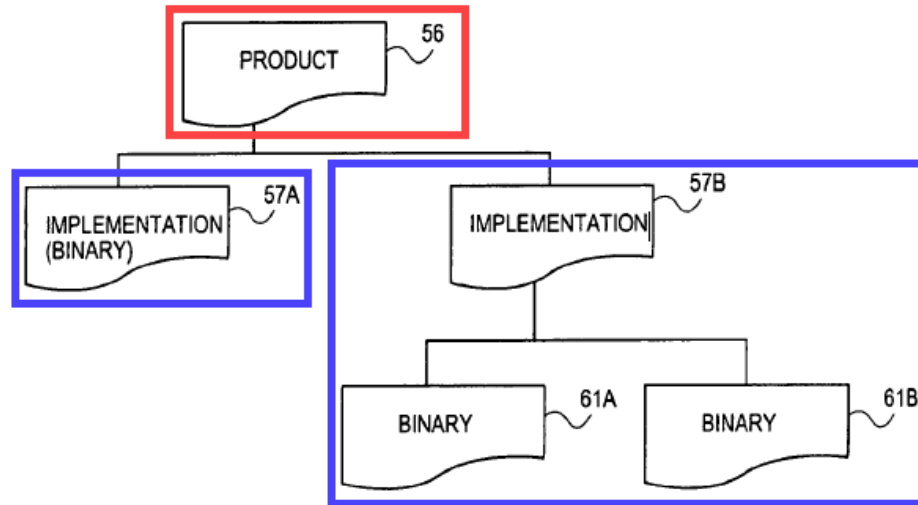


FIG. 6

*Id.*, Fig. 6 (annotations added). The product is shown in red, and the implementations are shown in blue. The '790 patent explains that “[t]he product catalog 54 contains descriptions of all published items of content (products).” *Id.*, 9:37-38. “[T]he catalog 54 includes, for each product entry 56, a reference 58 to at least one implementation 57 of that product.” *Id.* at 9:38-48. Thus, the items of content (called a “product” in figure 6) and the implementations are separate concepts. The catalogue contains both “descriptions of all published items of content” **and** “a reference 58 to at least one implementation 57 of that product.”<sup>2</sup> EX2020, ¶¶56-57.

<sup>2</sup> While the specification describes an embodiment in which there is “at least one implementation 57 of th[e] product,” the claims require “a plurality of different implementations.”

Figure 6 demonstrates that the implementations are not merely different products that happen to be similar, but different versions of a single item of content. *See, e.g.* EX1001, Fig. 5, Fig. 6, 13:22-24 (“At block 1202 the download manager retrieves the content type of the selected implementation (e.g., MIDlet, EXE file, applet, iAppli, etc.).”). Indeed, Mr. Wechselberger appears to agree that implementations are different versions of a single item of content. EX1002, ¶65 (“In view of the ‘790 citations discussed above and as further discussed below, a POSITA would understand that ‘implementations’ of claim 1 would include versions of digital content, where each version corresponds to a different set of device capabilities.”), ¶51 (“Each independent claim of the ‘790 patent requires maintaining a product catalog that includes a description of multiple items of content and **references to different versions of each item of content . . .**” (emphasis added)); EX2021, 60:6-11; EX2020, ¶58.

The specification of the ‘790 patent repeatedly confirms that the concept of “items of content” is distinct from the concept of implementations. *See, e.g.*, EX1001, Fig. 8 (“Defining a product *and* submitting one or more implementations.”), 11:50-52 (“at block 801 the download manager 1 receives inputs from a product supplier defining a product *and* one or more implementations of that product.”), 11:56-59 (“At block 803 the download manager 1 stores the product definition, the implementations, and a list of all of the supported devices and

provisioning protocols.”), 12:59-61 (“When a product is submitted to the download manager 1 by a supplier, the supplier specifies which devices are supported by each implementation of the product.”). Indeed, during prosecution, the examiner allowed the claims explicitly because “[t]he prior art fails to disclose a method and system of accessing content on a wireless communication device, that specifically includes *receiving and storing a plurality of different implementations of the items of content.*” EX1004, 43 (emphasis in original); Pet., 14; EX2020, ¶59.

Based on the claim language, and confirmed by the specification, the claims of the ’790 patent require both “items of digital content” and, separately, “implementations of at least one of the items of content.” EX2020, ¶¶55-60

**b. Petitioner’s Attempted Mapping Is Inconsistent and Contradictory.**

Petitioner maps “[t]he applications received by the MAS” to the claimed “plurality of items of content.” Pet., 27-28, 31; EX1002, ¶64; EX2021, 71:6-8 (“Q. You map the ’790 patent’s plurality of items of content to applications in Mehta, right? A. Yes, that’s what I’m mapping.”); *see* Decision on Institution (DI), 13. However, Petitioner also maps those same applications to the claimed “implementations” of the items of content as well. Pet., 28-29; EX1002, ¶65-66; *see* DI, 14; EX2020, ¶61.

Petitioner’s contradictory mapping by itself demonstrates that the Petition has not shown that Mehta discloses this element. *Facebook, Inc. v. Uniloc USA, Inc.*, IPR2017-01523, Paper 7 at 18, (December 4, 2017) (holding, “Petitioner’s unexplained inconsistent arguments and conflicting theories regarding the identity of the recited “instant voice message” in Zydney within its analysis of independent claims 1 and 40, as well as across their challenged dependent claims, the Petition lacks clarity regarding precisely which element or portion of Zydney Petitioner is alleging discloses, teaches, or suggests the “instant voice message” of the challenged claims.”); *see also* EX2020, ¶¶61-62. As discussed above, the plain language of the ’790 patent claims require both a “plurality of items of digital content” and multiple implementations of at least one item of content. Yet Petitioner maps both the “items of digital content” and the “implementations” to the same “applications.” Petitioner’s inherently contradictory mapping demonstrates the fundamental flaw in the Petition. *Id.*

**c. Mehta Does Not Disclose That Applications Have Multiple Implementations.**

Mehta does not disclose both “items of digital content” and “implementations of at least one of the items of content.” As discussed above, Petitioner maps both “items of digital content” and the “implementations” to the same thing, Mehta’s “applications.” Petitioner’s double mapping is no accident—it is out of necessity

because Mehta simply does not disclose providing applications with multiple versions for different device types. EX2020, ¶¶63-66.

Regardless of whether one considers Mehta’s applications to be the “items of content” or “implementations,” the point is that Mehta does not disclose both “the “items of content” and “implementations”—thus Mehta does not disclose or suggest any “implementations” of “items of content”.” Mehta includes dozens of references to, and descriptions of, “applications,” but never suggests that the applications can have different versions or implementations for different device types. *See, e.g.*, EX1003, ¶0068 (“These components inter-operate to receive applications from content providers and carrier services, to provision them for delivery to the subscriber devices, such as those shown in FIG. 1, and to process MAS commands.”); EX2020, ¶64.

Indeed, Mehta is clear that each application is its own file and is not made up of other subsidiary files (like the implementations are in the ’790 patent). For example, Mehta explains in the “Background Information” that “[c]ontent providers, who wish to develop applications for such wireless devices, must do so for each device they wish to support, and, in [sic] potentially in conjunction with the carriers and device manufacturers, must test such applications.” EX1003, ¶0004. That is, there must be a separate “application[]” for “each device.” From this, a POSITA would understand that each “application” in Mehta is for a separate device

requirement—in stark contrast to the '790 patent where the pieces of content have multiple different versions, each of which corresponds to a device. EX2020, ¶¶64-65.

For another example, Mehta explains that “the MAS may analyze various profiles, for example a subscriber profile, a device profile, and an application profile to determine whether the subscriber is authorized to use the application and whether the application’s needs, as reflected in the application profile, are met by the device, as reflected in the device profile.” EX1003, ¶0067. This passage again indicates that each application has a single version made for a particular device type. If each application had multiple versions for multiple device types, it would make no sense to determine whether the application as a whole can be used on a device. EX2020, ¶166.

Mehta’s disclosure of verifying whether applications are compatible with the user’s device does not disclose or suggest “implementations.” Pet., 28-29, 31. Mehta discloses two types of compatibility verification. First, Mehta discloses that a user can request a list of applications, and in response the MAS will return a list of applications. EX1003, ¶67; EX2021, 43:4-7, 46:13-47:1. This process is called “Application Discovery,” (EX2021, 41:13-42:13), and is shown in Figure 4 of Mehta, (*id.*, 39:8-10). As a part of the Application Discovery process, Mehta discloses that the MAS can filter out applications that are incompatible with the

user's device. *Id.*, 47:2-6, 51:15-19, 53:2-3. Second, Mehta discloses that a user can request a specific application. EX1003, ¶0064 (“The device capability is also examined to determine whether the requested application can be run satisfactorily on the subscriber device.”). In that case, if the requested application is not compatible with the user's device the MAS will not provide the requested application. EX2021, 57:4-9; EX2020, ¶67.

Neither type of compatibility verification discloses or suggests “implementations of at least one of the items of content.” EX2020, ¶¶67-68. Determining whether an application is compatible with a device in no way implies that the application in fact has multiple versions, each of which are compatible with a separate device type. Quite the opposite, Mehta's extensive disclosure of how to verify whether each application is compatible with a user's device only makes sense if the application has a single version. For example, it would make no sense to filter out an application merely because it has one version that is incompatible with a user's device, when another version could be compatible. *Id.* Thus, a POSITA would understand that Mehta's disclosure is not compatible with applications having multiple implementations. *Id.*

Finally, Mehta’s reference to “functionally equivalent programs”<sup>3</sup> does not suggest that applications have “implementations.” Pet., 29, 31. Mehta discloses that content providers can upload applications that may or may not be “functionally equivalent.” See EX1003, ¶0099. Petitioner asserts that Mehta’s disclosure of “functionally equivalent programs,” or “applications,”<sup>4</sup> discloses multiple implementations of an item of content (Pet., 29), but that is not correct. EX2020, ¶69. As is clear from the quoted passage itself, Mehta merely discloses two *different* items of content that share a function, not two versions of a single piece of content:

FIGS. 9B and 9C are an example screen displays of an additional information submission screen of a Content Provider Website. Specifying this information, including the application source language, *allows the MAS to store and support functionally equivalent programs having the same name that are capable of running on multiple kinds of devices* that even may be written using different languages.

EX1003, ¶0098.

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<sup>3</sup> Mr. Wechselberger testified that “functionally equivalent *programs*” means the same thing as “functionally equivalent *applications*.” EX2021, 65:14-17. Patent Owner agrees.

<sup>4</sup> Mehta uses programs and applications synonymously. EX2021, 76:14-17.

Notably, the passage states “functionally equivalent programs.” By its own language, it is referring to multiple different applications (pieces of content) not to a single application that has “functionally equivalent” versions. The full context of the passage further makes this clear. The passage explains that even if two applications have the same name because they are “functionally equivalent”—for example, two applications named: “Writing Application”—they can be distinguished by the other data provided, such as “short description” and “application source language.” Thus, each application is a separate application (even if they perform the same general function)—they are not different versions of a single application. Allowing “functionally equivalent” applications (e.g., Microsoft Word and Apple Pages; or Microsoft PowerPoint and Google Slides; or Google Sheets, Apple Numbers, and Microsoft Excel) is not the same as having multiple implementations of an individual item of digital content (e.g., Microsoft Word for Windows and Microsoft Word for Apple Macs). EX2020, ¶70.

Indeed, even Mr. Wechselberger effectively acknowledged at his deposition that “functionally equivalent” applications are merely those that accomplish the same function—they are not different versions of the same application. At his deposition, Mr. Wechselberger explained that Microsoft Word (a well-known document writing application) is “functionally equivalent to any other writing application”:

Q. Okay. Is Microsoft Word functionally equivalent to any other writing application?

Q. Did you say sure?

A. I agreed, yes, I said sure.

EX2021, 69:6-11 (attorney objection omitted).

Thus, for example, Microsoft Word and Apple Pages (another well-known writing application) would be functionally equivalent. EX2020, ¶¶71-72. But crucially, these “functionally equivalent” applications are not different “implementations” of a single application—they are instead wholly different applications. *Id.* Indeed, Mehta teaches away from applications having multiple implementations because its disclosed system is premised on single-version applications and is fundamentally incompatible with applications having multiple implementations. *Id.*

Accordingly, Mehta does not disclose the “plurality of different implementations of at least one of the items of content” element of the ’790 Patent. *Id.*, ¶¶63-73.

**2. Mehta Does Not Disclose the Product Catalog Including, in Association with Each Item of Content, a Reference to Each Implementation of Said Item of Content.**

The independent claims of the ’790 Patent further require “maintaining a product catalog,” with “the product catalog including, in association with each item

of content, a reference to each implementation of said item of content.” EX2020, ¶74. This concept is illustrated in Figure 5, shown below, which demonstrates this “relationship between a product entry [an item of content] and implementations of the product in the product catalog.” EX1001, 3:19-20.

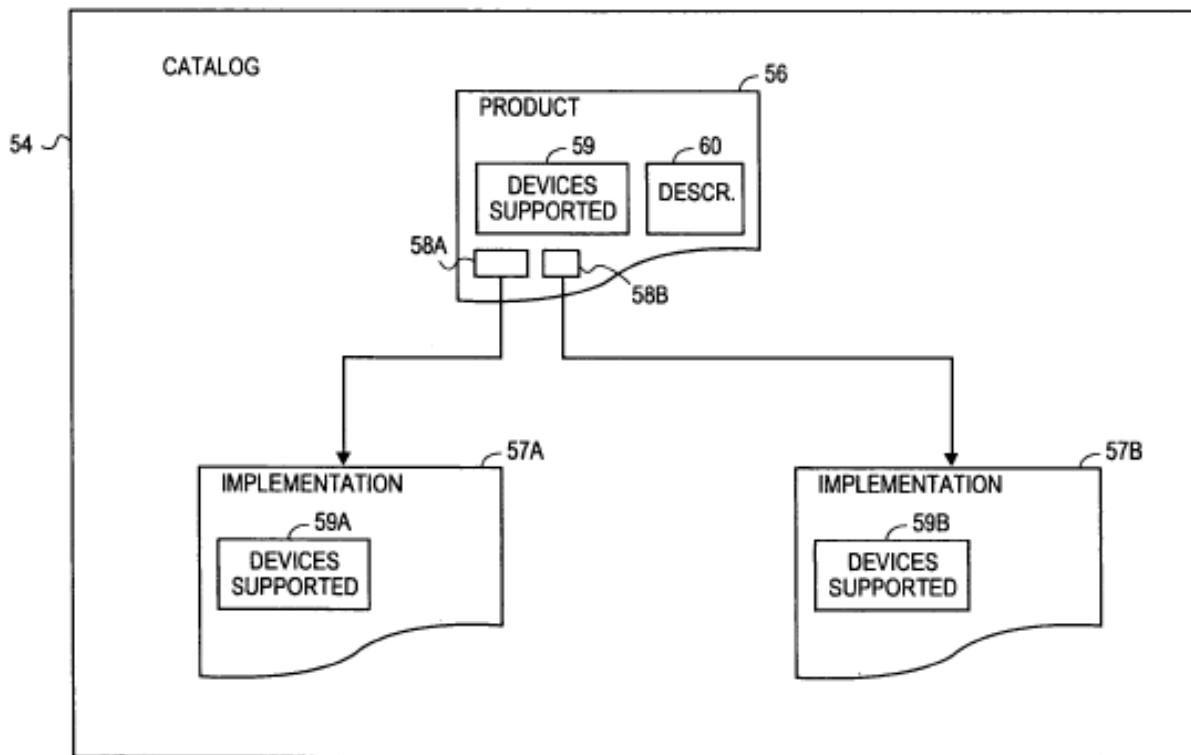


FIG. 5

*Id.*, Fig. 5.

Mehta does not disclose “a reference to each implementation of said item of content” “in association with each item of content.” As an initial matter, as explained above, Mehta does not disclose the claimed “implementations.” See Section VII.A.1. Therefore, it does not disclose a “product catalog including, in

association with each item of content, **a reference to each *implementation of said item of content.***” Indeed, this element highlights the fundamental disconnect between Mehta and the ’790 patent. As explained above, the claims of the ’790 patent distinguish between (1) the content and (2) implementations of that content. EX2020, ¶¶74-75. The patented invention takes advantage of this division to maintain a catalog that shows users the content, while still providing them access to all of the implementations. Mehta, in contrast, does not. Any “references” Mehta discloses are to the “applications”—the “items of digital content”—not to the implementations.

Moreover, even if Mehta did disclose “implementations of said item of content,” it still fails to disclose a “product catalog including, in association with each item of content, **a reference to each *implementation.***” EX2020, ¶76. Petitioner maps the claimed “product catalog” to the “data repository” in Mehta. Pet., 29-30 (“a POSITA would have understood that Mehta’s ‘data repository’ is essentially identical to the ’790 patent’s ‘product catalog containing a description of the items of content’ of claim 1.”); EX2021, 57:14-16 (“Q. And so what you map in Mehta to the product catalog is the data repository, right? A. Yes”); EX1002, ¶67 (“a POSITA would have understood that Mehta’s ‘data repository’ implements the ’790 patent’s ‘product catalog containing a description of the items of content’ of claim 1.”); EX2020, ¶76. Therefore, Mehta only discloses this element if it discloses

that the “reference to each implementation of said item of content” is “includ[ed]” in Mehta’s “data repository.”

Petitioner first maps Mehta’s disclosure of “a URL or other location reference,” claiming that a “POSITA would have understood that Mehta’s use of ‘a URL’ or ‘other location reference’ would correspond to ‘a reference to each implementation of said item of content’ of claim 1 because ‘a URL’ or ‘other location reference’ of Mehta provides a reference to each application to be downloaded from the MAS.” Pet., 30-31. But, in its full context, Mehta’s “URL” or “other location reference” language only refers to how the application is submitted to the MAS—it does not show that the “URL” or “other location reference” is included in the “product catalog,” as required by the claims. EX2020, ¶¶77-78.

Indeed, paragraph 97 does not mention the data repository at all. Instead, the passage concerns the “Content Provider Website 801” that “content providers” “use to submit downloadable applications to the MAS and to monitor whether the submitted downloadable applications have been reviewed (e.g., inspected) and approved for publication.” EX1003, ¶0097. With this context, Mehta explains that “[i]n one embodiment, *a content provider* logs into an account (previously configured using the Administration Website 801) on the Content Provider Website 801, and *enters a reference to the location of a file (e.g., a URL or other location reference) that the content provider desires to submit.*” *Id.* That is, a content

provider submits a new application to the MAS by telling the MAS (through the Administration Website 801) where the MAS can currently find the application (i.e., the “URL or other location reference” of the submitted application). EX2020, ¶78. Mehta discloses an “Applications Store 1216,” which “is a data repository that stores applications suitable for downloading to the subscriber device 1201.” EX1003, ¶0131. Therefore, the MAS takes the “URL or other location reference” submitted by the “content provider,” retrieves the application, and then stores the application in the “Applications Store 1216.” EX2020, ¶78. Mehta does not disclose that the “URL or other location reference” is ever stored in the “data repository.”

This is further shown in Figure 9A of Mehta, which shows an “example screen display an application submission screen of a Content Provider Website.” EX1003, ¶0097.

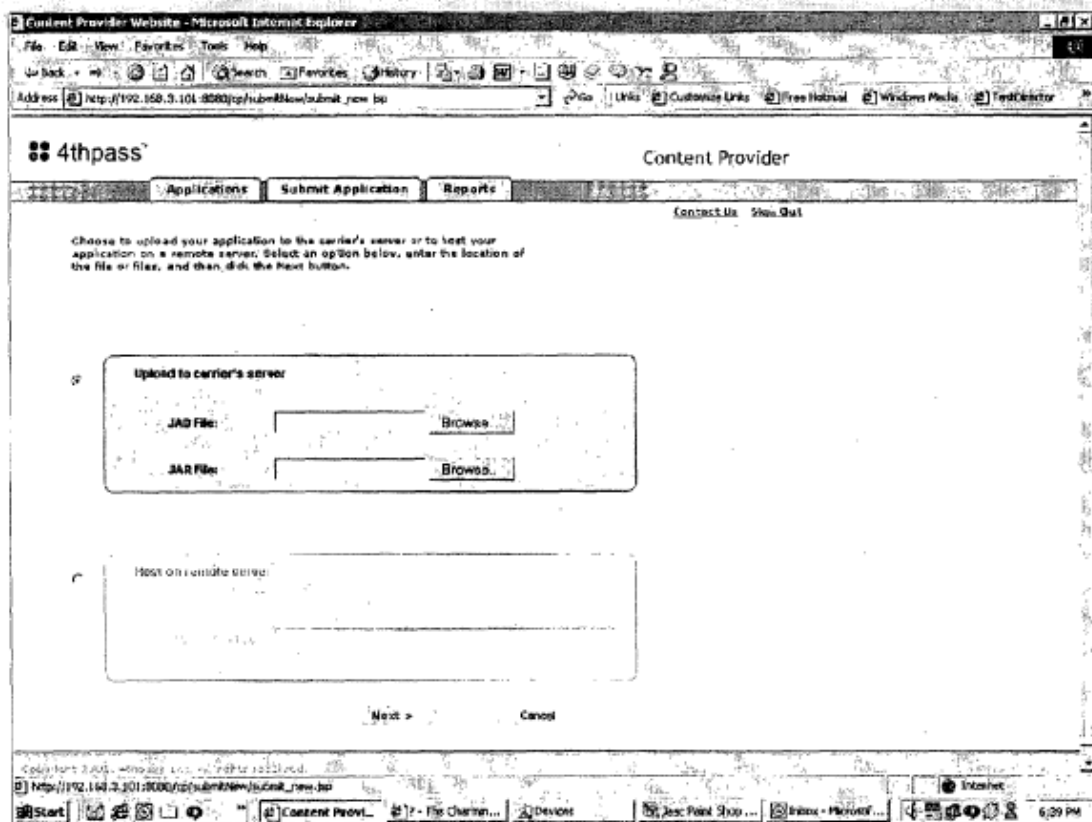


Fig. 9A

*Id.*, Fig. 9A. A POSITA would understand that the “URL or other location reference” is the merely the location of the application on the internet *before* it is submitted to the MAS—it is not a reference to the application in the MAS and is certainly not stored in the “data repository.” EX2020, ¶¶79-80.

Petitioner quotes one other passage that references “URLs,” but does not explain its relevance. *See* Pet., 30-31; *see also* EX1002, ¶68 (quoting EX1003, ¶10064). The quoted portion of Mehta does not disclose “a reference to each implementation of said item of content.” Instead, it explains the high-level steps “performed by an example Mobile Application System to provision applications for

wireless subscriber devices.” EX2020, ¶¶81. The quoted portion then goes on to specify that users can make requests to the MAS “for example, using Uniform Resource Locators (URLs) that use the HTTP messaging to direct the requests.” However, there is no indication that these URLs are stored in the data repository. *Id.*, ¶¶81-83. Indeed, a POSITA would understand that since the user is sending the “URL that identifies a file (an application or service) to download” to the MAS, the MAS has no reason to store that URL in the data repository—the MAS can just use the URL sent by the user to access the application. *Id.*

**3. Mehta Does Not Disclose That the Selected Portion, As Presented to the Subscriber, Provides Only a Single Description of Each Item of Digital Content in Said Portion, Regardless of the Number of Implementations of Each Said Item.**

Claims 2 and 9 require that “the selected portion, as presented to the subscriber, provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item.” EX1001, cls. 2, 9. Mehta does not disclose this limitation.

As an initial matter, Petitioner does not specifically explain how Mehta discloses that the “selected portion” “provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item.” Pet., 35-37; EX2020, ¶¶84-85. That by itself is sufficient basis to reject Petitioner’s argument. *See* 35 U.S.C. § 312(a)(3) (“the petition identifies, in

writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.”); *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim’ . . . . Unlike district court litigation — where parties have greater freedom to revise and develop their arguments over time and in response to newly discovered material — the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute.”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016).

Regardless, Mehta fails to disclose this element for the same reasons it fails to disclose the elements listed above: Mehta only discloses applications without multiple versions for different device requirements. EX2020, ¶86. Mehta is silent as to whether the “selected portion” “provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item” because the item of digital content can *never* have more than one implementation. *Id.*

Moreover, Mehta does not disclose this element even if Mehta did disclose items of content with multiple applications (which it does not). For claim element

2[d] generally, Petitioner points to Mehta’s “application discovery” process, which is the process by which the MAS “returns a list of content that can be downloaded that match criteria that are designated by the subscriber.” EX1003, ¶0006. Petitioner explains that, as a part of the “application discovery,” “the list provided to the subscriber device during application discovery is filtered to display only content that has been verified according to these procedures” such that “the MAS only lists those applications that are supported by the subscriber’s device.” Pet., 36 (quoting EX1003, ¶¶0007, 0117). Petitioner then asserts “that ‘the subscriber [could] avoid the problem of having to explicitly select a compatible application’ when the MAS only lists the applications that are supported by the subscriber’s device.” *Id.*, 36-37 (quoting EX1003, ¶0117). Petitioner does not explain how any of this discloses the claim element. It does not. EX2020, ¶¶87-88.

As discussed above, Mehta discloses “functionally equivalent” application. *See* Section VIII.A.1. Mehta explains that the “functionally equivalent” applications can have the same name, but can, for example, “be written using different languages.” EX1003, ¶0098. From this, a POSITA would understand that, for some users, there might be multiple different “functionally equivalent” applications. EX2020, ¶¶87-88. For example, there might be a program, “Program A,” which is written in C++ (a coding language) and another program, “Program B,” which is written in C (another coding language). Both programs could be compatible with a

single user's computer. In that case, Mehta discloses that the MAS would show **both** applications to a user, leaving the user to choose between the two. Thus, even accepting Petitioner's argument that "functionally equivalent" applications are different implementations, Mehta still does not disclose that the MAS would "provide[] **only a *single* description of each item of digital content** in said portion, regardless of the number of implementations of each said item." *Id.*

**4. Mehta Does Not Disclose Selecting an Implementation of the Requested Item of Digital Content, Based on Device Capabilities of the Wireless Device Used by the Subscriber.**

Claims 4 and 11 requiring selecting "an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber" in response to receiving "from the subscriber a request for one of the items of digital content in said portion of the product catalog." EX1001, cls. 4, 11. Mehta does not disclose this limitation. EX2020, ¶89.

Claims 4 and 11 require (in relevant part):

- "selecting a portion of the product catalog to be presented to the subscriber" (cls. 2, 9)
- "presenting the selected portion of the product catalog to the subscriber via a wireless network" (cls. 2, 9)
- "receiving from the subscriber a request for one of the items of digital content in said portion of the product catalog" (cls. 4, 11)

- “selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber” (cls. 4, 11)

Petitioner asserts that Mehta discloses “selecting “an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber” when it describes the “Application Discovery” process. Pet., 41. But, as noted above, Petitioner maps the Application Discovery process—creating and presenting a filtered list of compatible applications—to the “selecting a portion of the product catalog to be presented to the subscriber, based on device capabilities of the wireless device used by the subscriber” and “presenting the selected portion of the product catalog” limitations. Pet., 33-37; EX2020, ¶¶90-92. It makes no sense (and is inconsistent) to say that the “Application Discovery” process is both the original “selecting” and “presenting” the “portion of the product catalog” and is *also* the additional “selecting an implementation of the requested item of digital content.” EX2020, ¶¶90-92.

Petitioner’s mapping fails on its own merits as well. Claims 4 and 11 require “selecting an implementation of the requested item of digital content, *based on device capabilities of the wireless device used by the subscriber.*” But, in Mehta, the applications have already been verified “based on device capabilities of the wireless device used by the subscriber” during the Application Discovery process.

EX1003, ¶0067. Therefore, a POSITA would understand that, in Mehta, the application is not again selected “based on device capabilities of the wireless device used by the subscriber” as it is unnecessary—every application on the list resulting from the Application Discovery process has already been verified. EX2020, ¶93.

Mr. Wechselberger confirmed that Mehta does not disclose selecting applications “based on device capabilities of the wireless device used by the subscriber” again after the Application Discovery process:

Q. When a user selects one of the applications from the filtered list, the MAS doesn’t re-check that that selected application is compatible with the user's device, correct?

A. Since the list has been filtered before it was presented and has been confirmed to be compatible, I don't know why it would re-check because I don't think that Mehta discloses any such thing.

EX2021, 53:11-20 (objection omitted).

Mr. Wechselberger similarly confirmed that “[w]hen a user selects one of the applications from the filtered list, the user will never get a different application than the one they requested.” EX2021, 54:5-11 (objection omitted). This confirms that the user simply requests and receives an application, without “selecting an

implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber.” EX2020, ¶¶94-96.

\* \* \*

Therefore, Mehta does not disclose each limitation of at least claims 1, 2, 4, 8, 9, and 11. Claims 3 and 10 are also not anticipated by Mehta by virtue of their dependency to claims 2 and 9. EX2020, ¶¶97.

**B. Ground 2: Mehta And Schlapfer Do Not Render Obvious Any Claim of the '790 Patent**

**1. Mehta and Schlapfer Do Not Suggest or Teach a Plurality of Different Implementations of At Least One of the Items of Digital Content.**

As explained above, Mehta does not disclose “a plurality of different implementations of at least one of the items of digital content.” See Section VIII.A.1. The Petition does not provide any additional analysis or assertions as to how this limitation is rendered obvious either by Mehta itself or in view of Schlapfer. Pet., 49; EX1002, ¶101. Therefore, Mehta and Schlapfer do not render obvious “a plurality of different implementations of at least one of the items of digital content” for the same reasons as indicated above. EX2020, ¶98.

**2. Mehta and Schlapfer Do Not Suggest or Teach the Product Catalog Including, in Association with Each Item of**

**Content, a Reference to Each Implementation of Said Item of Content.**

As explained above, Mehta does not disclose “the product catalog including, in association with each item of content, a reference to each implementation of said item of content.” *See* Section VIII.A.2. The Petition does not provide any additional analysis or assertions as to how this limitation is rendered obvious either by Mehta itself or in view of Schlapfer. Pet., 49; EX1002, ¶102. Therefore, Mehta and Schlapfer do not render obvious “the product catalog including, in association with each item of content, a reference to each implementation of said item of content” for the same reasons as indicated above. EX2020, ¶¶99.

**3. Mehta and Schlapfer Do Not Suggest or Teach That the Selected Portion, As Presented to the Subscriber, Provides Only a Single Description of Each Item of Digital Content in Said Portion, Regardless of the Number of Implementations of Each Said Item.**

As explained above, Mehta does not disclose “that the selected portion, as presented to the subscriber, provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item.” *See* Section VIII.A.3. The Petition does not provide any additional analysis or assertions as to how this limitation is rendered obvious by Mehta itself. Pet., 50-52.

Instead, Petitioner argues that this limitation is rendered obvious by Mehta in view of Schlapfer. Petitioner’s argument fails for three reasons. First, Petitioner has

not shown that Schlapfer qualifies as prior art. Second, Petitioner has not shown that a POSITA would be motivated to combine Schlapfer and Mehta. And third, this limitation is not rendered obvious by Mehta in view of Schlapfer. EX2020, ¶100.

**a. Schlapfer is not prior art.**

Petitioner asserts that “Schlapfer is prior art under, least [sic] pre-AIA § 102(a) because it was published on July 7, 2001.” Pet., 19. “Whether a reference qualifies as a printed publication under §102 is a legal conclusion based on underlying fact findings.” *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 772 (Fed. Cir. 2018). The “touchstone” of whether a reference qualifies as a printed publication is “public accessibility”—that is, whether the reference was sufficiently available that an interested POSITA could find it by exercising reasonable diligence. *See In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986). Here, Petitioner has not provided any evidence that Schlapfer was actually accessible to the general public as of the ’790 patent’s June 2003 priority (Pet., 14), much less that it was accessible such that a POSITA exercising reasonable diligence would have found it.

Petitioner only provides two pieces of evidence to support its assertion. Pet., 19 n.3. First, Petitioner points to a date on Schlapfer itself that reads “July 7, 2001.” *Id.* (citing EX1009, 26). Second, Petitioner identifies a “European Patent Specification” that cites Schlapfer and states “Retrieved from the Internet” on

“2002-11-29.” *Id.* (citing EX1017). But, crucially, this evidence at most demonstrates that Schlapfer existed and that *an* individual accessed it (whoever cited it in the European Patent Specification). There is no evidence that the “July 7, 2001” date on the face of Schlapfer is a publication date. Schlapfer could be an internal document that was created, internally released, or modified on July 7, 2001. EX2020, ¶¶101-102.

And there is no evidence that just *anyone* in the public could access Schlapfer as of “2002-11-29.” All Petitioner’s evidence shows is that one person accessed Schlapfer such that it was cited in the European patent. Petitioner’s evidence merely states that Schlapfer was accessed at “[http://www.ericsson.co.th/mobilityworld/Java/White\\_Paper.pdf](http://www.ericsson.co.th/mobilityworld/Java/White_Paper.pdf)” but Petitioner provides no evidence that that link was public. Instead, Schlapfer very well may have been hosted on an internal Ericsson server and accessible via a protected and private internet URL. EX2020, ¶¶101-102.

At base, the fact that Schlapfer was cited by someone in a patent application does not show public accessibility, as it is possible that Schlapfer was only accessible internally. *Id.* Taken together, there is no evidence that Schlapfer was publicly accessible to a POSITA. The Board and Courts have previously found such indicia to be insufficient to establish public accessibility. *See In-Depth Geophysical, Inc. v. Conocophillips Co.*, IPR2019-00849, Paper 14 at 4–13 (PTAB Sept. 6, 2019) (conference paper with copyright date of 2012 and date of September 2012 on its

cover was insufficient to show that the paper had been disseminated); *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 865–66 (Fed. Cir. 2010) (agreeing that the existence of a user manual without additional evidence of publication or dissemination was insufficient to render it a “printed publication” under § 102(b)). Accordingly, Petitioner’s bare assertion and unexplained dates are insufficient to establish that Schlapfer qualifies as prior art.

**b. Schlapfer and Mehta do not render obvious this element.**

Even if Schlapfer were prior art, the combination of Schlapfer and Mehta does not render obvious this element. Petitioner asserts that “to the extent Patent Owner argues that Mehta does not expressly disclose ‘provid[ing] only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item’ of element 2[e], the predictable combination of Mehta and Schlapfer would remove any doubt of the claim's unpatentability.” Pet., 51-52. That is incorrect. EX2020, ¶103.

The crux of Petitioner’s argument is that since Schlapfer discloses that mobile devices “have a small display . . . and are capable of communicating via a mobile network with limited bandwidth” and “[i]t was well-known to a POSITA at the time of the alleged invention that the screen space and signal processing capabilities of mobile devices was limited,” that a POSITA would modify Mehta to only show

“single description of each item of digital content in said portion, regardless of the number of implementations of each said item.” But this amounts to no more than inadmissible hindsight. *See Sensonics Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996) (“To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction—an illogical and inappropriate process by which to determine patentability.” (citing *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983))). Even if a POSITA were motivated to limit the amount of content shown due to “a small display,” there are many ways to accomplish that. EX2020, ¶¶104-105. Petitioner has not pointed to anything in Mehta or Schlapfer that would motivate or suggest showing a “single description of each item of digital content in said portion, regardless of the number of implementations of each said item.”

Moreover, as discussed in Section VIII.A.3 above, Mehta would have to be fundamentally altered to meet this limitation. EX2020, ¶¶104-105. Mehta’s disclosed system is based on its assumption that the system will only have to deal with single-version applications without multiple implementations. Mehta would have to be fundamentally changed in order to incorporate multiple versions. *Id.*

**c. A POSITA would not be motivated to combine  
Schlapfer and Mehta.**

Finally, a POSITA would not be motivated to combine Mehta and Schlapfer. Petitioner asserts “a POSITA would have found it obvious to combine Mehta's teachings of a mobile application system (i.e., ‘MAS’) with Schlapfer’s teachings of limited screen space of mobile devices and limited bandwidth of the mobile network, and an application descriptor and associated attributes.” Pet., 66; *see also id.*, 67-68. That is not correct. EX2020, ¶106.

As an initial matter, Mehta and Schlapfer are not analogous, *cf.* Pet., 66, and thus cannot be used as an obviousness combination. *K-TEC, Inc. v. Vita-Mix Corp.*, 696 F.3d 1364, 1375 (Fed. Cir. 2012) (“To qualify as prior art for an obviousness analysis, a reference must qualify as ‘analogous art,’ i.e., it must satisfy one of the following conditions: (1) the reference must be from the same field of endeavor; or (2) the reference must be reasonably pertinent to the particular problem with which the inventor is involved.”). Mehta and Schlapfer concern different aspects of the application lifecycle. While Mehta concerns “computer- and network-based methods and systems for *maintaining and provisioning* wireless network applications,” EX1003, ¶0005 (emphasis added), Schlapfer concerns “providing insight into Java technology for the *application development* on mobile devices.” EX1009, 2 (emphasis added). Schlapfer and Mehta are directed to different fields

of endeavors—application development and storing and provisioning applications, respectively—and concern wholly different challenges and problems. EX2020, ¶107. Thus, Mehta and Schlapfer are not analogous.

Petitioner next asserts that “Mehta itself also provides motivation to look to Schlapfer” because “Mehta recognizes the issue of resource constraints on mobile devices and contemplates taking steps to address those constraints.” Pet., 67. But even if Mehta does contemplate “resource constraints” it does so in the context of how to store and provision applications. That provides no motivation to combine Mehta with Schlapfer, which is concerned with *creating* applications to be small—an entirely different endeavor. EX2020, ¶¶107-108.

Petitioner then argues that “a POSITA would have combined Mehta and Schlapfer with a reasonable expectation of success” “because the two references both look to the use of Java for distributing digital content to mobile devices.” Pet., 68. But merely acknowledging the same technology, Java, is not enough to show that a POSITA would know how to combine Mehta and Schlapfer. EX2020, ¶109. Indeed, Mehta includes its own detailed discussion of provisioning models (e.g., walled-garden, open, static, and dynamic), which is different from Schlapfer’s treatment of provisioning. *Id.* Thus a POSITA would not easily understand how to combine the two references. EX2020, ¶109.

Finally, a POSITA would not be motivated to combine Mehta and Schlapfer because doing so in the way suggested by Petitioner would fundamentally change the purpose of Mehta. As discussed above, Mehta only discloses single-version applications without multiple implementations. Mehta's disclosed system is based on its assumption that the system will only have to deal with single-version applications without multiple implementations. Mehta would have to be fundamentally changed in order to incorporate multiple versions of applications. EX2020, ¶110.

**4. Mehta and Schlapfer Do Not Suggest or Teach Selecting an Implementation of the Requested Item of Digital Content, Based on Device Capabilities of the Wireless Device Used by the Subscriber.**

As explained above, Mehta does not disclose “selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber.” *See* Section VIII.A.4. The Petition does not provide any additional analysis or assertions as to how this limitation is rendered obvious either by Mehta itself or in view of Schlapfer. Pet., 53; EX1002, ¶112. Therefore, Mehta and Schlapfer do not render obvious “selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber” for the same reasons as indicated above. EX2020, ¶111.

**5. Mehta and Schlapfer Do Not Teach or Suggest Each Of The Provisioning Models Corresponding To or Based on Device Capabilities.**

Claims 5 and 12 require “the provisioning models corresponding to a different set of device capabilities.” Claims 6 and 13 require selecting “one of a plurality of provisioning models associated with the requested item in the server system, based on the device capabilities of the wireless device used by the subscriber.” Mehta and Schlapfer do not render obvious these limitations, which require that the provisioning models correspond to or are based on device capabilities. EX2020, ¶112.

Petitioner asserts that Mehta discloses “four different types of provisioning models (i.e., ‘walled-garden provisioning,’ ‘open provisioning,’ ‘static provisioning,’ and ‘dynamic provisioning’).” *See e.g.*, Pet., 54-59. Petitioner does not explain its argument for why it would be obvious for these provisioning models to correspond to or be based on device capabilities. For that reason alone, Petitioner has not shown that Mehta renders obvious these claim requirements.

Petitioner does discuss the other aspects of this claim elements, stating that “a POSITA would have understood that it would have been obvious to associate each of the items of digital content in the server system with a plurality of different provisioning models, because Mehta describes that ‘[p]rovisioning . . . is the customizing and distributing of content . . . for use on a particular kind of subscriber

device by a particular customer’ while disclosing at least four different types of provisioning models, and the MAS of Mehta handles a different set of device capabilities.” *Id.*, 54; EX1002, ¶¶115-116. Regardless, as explained below, a POSITA would understand that the only four “provisioning models” disclosed by Mehta (“walled-garden provisioning,” “open provisioning,” “static provisioning,” and “dynamic provisioning” **cannot** correspond to or be based on device capabilities. EX2020, ¶¶113-117.

Mehta describes each of the four alleged “provisioning models” in turn:

- Walled-Garden Provisioning: “In one embodiment of the MAS, walled-garden provisioning is provided. Content is submitted to the MAS, inspected for malicious or banned code, or for the presence of particular API, approved, and published by the MAS. Subscribers can then discover and request the content.” EX1003, ¶0008.
- Open Provisioning: “In another embodiment, open provisioning is provided. With open provisioning, a subscriber browses to a site on a network, such as the Internet, and specifies a request to download content at a particular address, for example, a URL. The MAS intercepts this request, downloads the content from the address, and inspects the content for API or other attributes that should not appear in the content. If the inspection is successful, the MAS provisions the

content for the subscriber. In one embodiment, the inspection process is performed using application filters. In some embodiments, the requested content is also verified for the subscriber's device to increase the likelihood that the content will execute properly on the device." *Id.*, ¶0009.

- Static Provisioning: "In some embodiments, the published content is preprovisioned (static provisioning)." *Id.*, ¶0008.
- Dynamic Provisioning: "In other embodiments, the published content is provisioned dynamically upon download request." *Id.*<sup>5</sup>

Crucially, none of these provisioning models have anything to do with any "set of device capabilities." EX2020, ¶¶113-115. Whether an application is provided using "walled-garden" or "open" provisioning depends *only* on whether the application has already been published by the MAS. EX1003, ¶¶0008-0009. Indeed, Mr. Wechselberger acknowledged that whether the MAS uses "walled-garden" or "open" provisioning is based on whether the MAS has already published the application:

Q. Right. But if content is published by the MAS, then you use walled garden provisioning, right?

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<sup>5</sup> Static and dynamic provisioning are sub-models of the walled-garden provisioning models. Ex1002 ¶0008; Wechselberger dep. at 25:7-21.

A. In -- yes, once it's published, you would use walled garden provisioning as . . . If it's been published by the -- if it's already been published by the MAS, then it's considered content that is under the walled garden umbrella.

EX2021, 36:11-22 (attorney objection omitted, cleaned up); *see also id.*, 26:17-27:3, 30:12-19.

Q. And if not published by the MAS, then it's considered content that's under the open provisioning umbrella?

A. I would say that if it's not been published by the MAS, and I said -- I call that under the MAS umbrella, then open provisioning content would be content that has not yet been published by the MAS.

*Id.*, 37:1-9 (attorney objection omitted); *see also id.*, 27:9-18.

Similarly, whether an application is provided using “static” or “dynamic” provisioning depends **only** on whether the application has already been provisioned by the MAS. EX1003, ¶¶0008-0009. Mr. Wechselberger similarly acknowledged that whether the MAS uses “static” or “dynamic” provisioning is based on whether the MAS has already provisioned the application:

Q. [I]f the content has already been provisioned, Mehta discloses using static provisioning, correct?

A. Yes.

EX2021, 37:18-22 (attorney objection omitted).

Q. And if the content has not been provisioned, Mehta uses dynamic provisioning, correct?

A. If the content has not been pre-provisioned, then -- which is called static, then Mehta provides an alternate processing approach, which he calls dynamic, where the content is provisioned dynamically.

EX2021, 38:1-9 (attorney objection omitted). Thus, the only provisioning models disclosed by Mehta (“walled-garden provisioning,” “open provisioning,” “static provisioning,” and “dynamic provisioning”) **cannot** correspond to or be based on device capabilities. EX2020, ¶¶113-117. Thus Mehta does not teach or suggest this element.

At Mr. Wechselberger’s deposition, he opined that Mehta discloses more provisioning models than just “walled-garden provisioning,” “open provisioning,” “static provisioning,” and “dynamic provisioning” because it describes the “concept” of provisioning models. EX2021, 16:3-18:6. This argument is not in the Petition and thus not a part of these proceedings. *See* 35 U.S.C. § 312(a)(3); *Intelligent Bio-Sys., Inc.*, 821 F.3d at 1369; *Harmonic Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016). EX2020, ¶118.

Regardless, Mr. Wechselberger’s new argument is incorrect. In particular, Mr. Wechselberger opines that Mehta discloses more “provisioning models”

because the '790 patent states that “[a] provisioning ‘model’, in this context, includes a particular provisioning protocol and a content packaging format,” (EX1001, 13:1-3 (quoted in EX1002, ¶115)), and Mehta discloses “provisioning protocol[s]” and “packaging.” EX1002, ¶115. But, even if true, disclosing “provisioning protocol[s]” and “packaging” does not disclose a “provisioning model.” EX2020, ¶119. As an analogy, one could say that a car includes wheels and metal. But a reference that only discloses wheels and metal does not disclose a car. *Id.* This is supported by the claims, which explicitly require both (1) “a plurality of different provisioning models” and (2) “a provisioning protocol.” EX1001, cl. 5.

Mr. Wechselberger even acknowledged at his deposition that “walled garden, open, static, and dynamic” are the only provisioning models disclosed in Mehta by name. EX2021, 18:12-18 (“Q. The only labels for provisioning models disclosed in Mehta are walled garden, open, static, and dynamic, correct? A. Those are the only -- I would agree. We can call those labels, yes, four labels that he has disclosed.” (attorney objection omitted)). EX2020, ¶¶119-120.

Thus, Mehta only discloses the four provisioning models discussed above, “walled-garden provisioning,” “open provisioning,” “static provisioning,” and “dynamic provisioning,” but those provisioning models do not correspond to and are not based on any “set of device capabilities.” Accordingly, Mehta does not disclose, teach, or suggest selecting “the provisioning models corresponding to a different set

of device capabilities” or “one of a plurality of provisioning models associated with the requested item in the server system, based on the device capabilities of the wireless device used by the subscriber.” EX2020, ¶121.

**6. Mehta and Schlapfer Do Not Teach or Suggest a Corresponding Set of Provisioning Attributes and Descriptors.**

Claims 5 and 12 require “a corresponding set of provisioning attributes and descriptors.” Mehta and Schlapfer do not render obvious these limitations.

Petitioner does not assert that Mehta discloses “a corresponding set of provisioning attributes and descriptors.” *See* Pet., 55-56. The Petition does not provide any additional analysis or assertions as to how this limitation is rendered obvious by Mehta itself. *See e.g.*, Pet., 50-52, 55-56. Instead, Petitioner argues that this limitation is rendered obvious by Mehta in view of Schlapfer. Petitioner’s argument fails for three reasons. First, Petitioner has not shown that Schlapfer qualifies as prior art. Second, Petitioner has not shown that a POSITA would be motivated to combine Schlapfer and Mehta. And third, this limitation is not rendered obvious by Mehta in view of Schlapfer. EX2020, ¶122.

**a. Schlapfer is not prior art.**

As explained above, Petitioner had not shown that Schlapfer qualifies as prior art. *See* Section VIII.B.3.a; EX2020, ¶123.

**b. Schlapfer and Mehta do not render obvious this element.**

Even if Schlapfer were prior art, the combination of Schlapfer and Mehta does not render obvious this element. Petitioner asserts that “Schlapfer confirms that it was well-known to a POSITA at the time of the alleged invention that a provisioning model would include a corresponding set of provisioning attributes and descriptors.” Pet., 55-56. In particular, Petitioner points to Schlapfer’s disclosure of “an application descriptor,” “mandatory attributes such as name, version, vendor, jar URL, and jar size,” and “optional attributes such as description, icon, info URL, and data size.” *Id.* (quoting EX1009, 7-8, 9, 11, 12).

But Petitioner does not explain how any of these are “*provisioning* attributes and descriptors”—and Schlapfer does not disclose that they are. EX2020, ¶124. During his deposition, Mr. Wechselberger confirmed that “a provisioning descriptor is something that has a description of the provisioning protocol” and “the provisioning attribute is something that has an attribute of the provisioning protocol.” EX2021, 10:19-11:6. Yet, Petitioner has not shown that the alleged “descriptors” and “attributes” have anything to do with the “provisioning model.” Indeed, as explained above, Mehta’s provisioning models (walled-garden, open, static, and dynamic) have nothing to do with these identified alleged “descriptors” and “attributes.” Thus, Mehta in view of Schlapfer would not render obvious “each

provisioning model including . . . a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices.” EX2020, ¶124.

**c. A POSITA would not be motivated to combine Schlapfer and Mehta.**

Finally, a POSITA would not be motivated to combine Mehta and Schlapfer. As discussed above, Mehta and Schlapfer are not analogous art and a POSITA would not generally be motivated to combine them. For this element in particular, Petitioner asserts “it was well-known to a POSITA [at] the time of the alleged invention that a provisioning model would include a corresponding set of provisioning attributes and descriptors.” Pet., 68-69. But Petitioner’s argument fundamentally misses the mark. As explained above, Mehta’s provisioning models (walled-garden, open, static, and dynamic) have nothing to do with the identified alleged “descriptors” and “attributes,” and so a POSITA would not be motivated to combine Mehta and Schlapfer regarding this element. EX2020, ¶¶125-126.

\* \* \*

Therefore, Mehta and Schlapfer do not render obvious each limitation of at least claims 1, 2, 4, 5, 6, 8, 9, 11, 12, 13. Claims 3, 7, 10, and 14 are also not rendered obvious by Mehta and Schlapfer by virtue of their dependency to claims 2, 6, 9, and 13.

## VIII. CONCLUSION

For the reasons stated above, the Petition fails to show that any challenged claim is unpatentable.

Dated: December 22, 2023

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**CERTIFICATE OF COMPLIANCE**

The undersigned hereby certifies that Patent Owner's Response consists of 10,756 words, excluding the table of contents, certificate of service, this certificate of compliance, or table of exhibits. The Response complies with the type-volume limitation of 14,000 words as mandated in 37 C.F.R. § 42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare this paper (Microsoft Word).

Dated: December 22, 2023

Respectfully submitted,

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**Counsel for Patent Owner**

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S RESPONSE and Associated Exhibits** was served on December 22, 2023, via electronic mail, as agreed to by counsel, upon the following counsel for Petitioner:

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