

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner.

Case IPR2023-00628
Patent No. 7,233,790

**PETITIONER’S REPLY TO PATENT OWNER RESPONSE IN *INTER*
PARTES REVIEW OF U.S. PATENT NO. 7,233,790**

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I. INTRODUCTION

The Board instituted review of all the '790 patent's claims as being anticipated by Mehta (EX1003) and obvious over Mehta and Schlapfer (EX1009).

The overlap between Mehta and the challenged claims is unavoidable. Both Mehta and the '790 patent claims disclose a central distribution system that manages the publication, provisioning, and delivery of digital content from multiple content providers to wireless services subscribers. The only way in which Patent Owner ("PO") could attempt to distinguish Mehta was to mischaracterize Mehta and ignore its express teachings. But the record is clear—Mehta anticipates nearly all of the '790 patent's claims.

Likewise, PO ignores the strong motivations that one of ordinary skill in the art ("POSITA") would have combined Mehta and Schlapfer, asserting the two references are completely unrelated. But Mehta teaches the provisioning of content for delivery to a user's device, and Schlapfer discloses descriptors relating to an application's attributes such as its name, size, and URL, which are sent to the user's device during provisioning. This simple concept would have ineluctably suggested to a POSITA to employ Schlapfer's application descriptors as part of Mehta's provisioning process.

Thus, PO's Response ("POR") fails to raise any genuine issue of merit. As such, the '790 patent's claims are anticipated by Mehta and obvious over Mehta

and Schlapfer. Accordingly, the Board should find the claims of the '790 patent unpatentable.

II. THE CHALLENGED CLAIMS ARE ANTICIPATED BY MEHTA

Claims 1-4 and 8-11 are anticipated by Mehta's Mobile Application System ("MAS"). Pet., 26-46. In an attempt to attack the Petition's merits, PO resorts to mischaracterizing and ignoring the express disclosures in Mehta to advance unfounded positions. Indeed, when pressed during his deposition, even PO's expert relented, unable to maintain the untenable positions in his declaration.

A. Mehta teaches "a plurality of different implementations of at least one of the items of digital content"

PO's basis for contending that Mehta does not disclose this limitation is premised on a fundamentally flawed characterization of Mehta's MAS.

Both the '790 patent and Mehta acknowledge the same problem: with the proliferation of numerous different wireless devices, a need existed to efficiently distribute content from content providers to the many different wireless devices. *See* EX1001, 2:13-17; EX1003, [0004]. The '790 patent's purported solution to this problem is a "server system [that] includes a download manager that manages the publication, purchase, and delivery of digital products from multiple suppliers to wireless services subscribers." EX1001, Abstract. The '790 patent further discloses that a particular product can have "multiple implementations . . .

published on the download manager, each of which may be designed for a specific client device or set of client devices.” *Id.*, 9:44-48.

Like the ’790 patent’s download manager, Mehta’s solution is its MAS, which is a content distribution system that allows “[c]ontent providers 106 [to] provide applications to the MAS . . . [which] are then verified, published, and provisioned to the subscriber devices 101 by the MAS 105.” *Id.*, [0061]. The MAS stores and supports multiple versions of content and “functionally equivalent programs having the same name that are capable of running on multiple kinds of devices,” which are “implementations of a piece of content” as claimed in the ’790 patent. *Id.*, [0098], Fig. 9B; EX1002, ¶¶65-66.

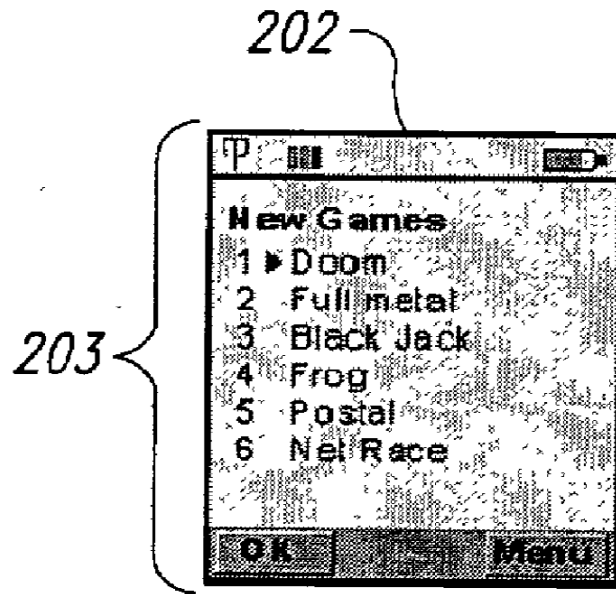
Unable to avoid the striking similarities with the ’790 patent, PO takes the problem that Mehta describes and conflates it to be Mehta’s solution, trying to distinguish Mehta from the ’790 patent. In the “Background Information” section, Mehta discloses the problem: “[c]ontent providers, who wish to develop applications for such wireless devices, must do so for each device they wish to support.” EX1003, [0004]. PO interprets this description of the *problem* (which precedes the “Brief Summary of the Invention” section) and repeatedly cites to paragraph [0004] of Mehta to assert that “Mehta assumes that in order to make an application work on ‘each device,’ content providers must ‘develop’ a different application for ‘each device.’” *See, e.g.*, POR, 6, 18. PO asserts “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.” *Id.*, 7. The foregoing argument by PO unequivocally contradicts the express disclosures of Mehta.

1. Mehta teaches a “plurality of items of digital content,” which is different from “a plurality of different implementations”

PO insists that Netflix’s mapping of the claimed “plurality of content” and “implementations” is “[i]nconsistent and [c]ontradictory.” POR, 16-17. In advancing this argument, PO improperly focuses on part of the Petition’s analysis while disregarding other key portions.

There is no dispute that the claimed “plurality of items of content” can be “applications received by the MAS” *or* “other content to be provided to the mobile subscriber device includ[ing], for example, games, text, graphics, audio, and video.” Pet., 27; EX1003, [0059-0060]; EX1029, 21:25-22:2 (Dr. Goodrich, PO’s expert, agrees “digital content” “can be games, images, software applications, videos”). Figure 2 of Mehta demonstrates this point:



EX1003, Fig. 2. Menu 202 of Figure 2 depicts a list of new applications 203 that can be downloaded to a subscriber device. *Id.*, [0063]. Each listed game (*e.g.*, Doom, Black Jack) is the claimed “item of digital content” and list 203 displays the claimed “plurality of items of digital content.” *See Pet.*, 27-28.

There is also no dispute that a software application can be the claimed “item of digital content.” Instead, PO mischaracterizes the Petition’s analysis, contending “Petitioner also maps those same applications to the claimed ‘implementations’ of the items of content.” POR, 16-17. When a software application or software program is the claimed “item of digital content,” the claimed “implementation” would be a “binary file (a ‘binary’) representing the product” or a version of that software, “where each version corresponds to a different set of device capabilities.” *Pet.*, 28-29. For example, Mehta explains that Figure 9D (below) is an “application

submission notification,” which includes information provided by the content provider about the submitted application. *Id.*, [0099].

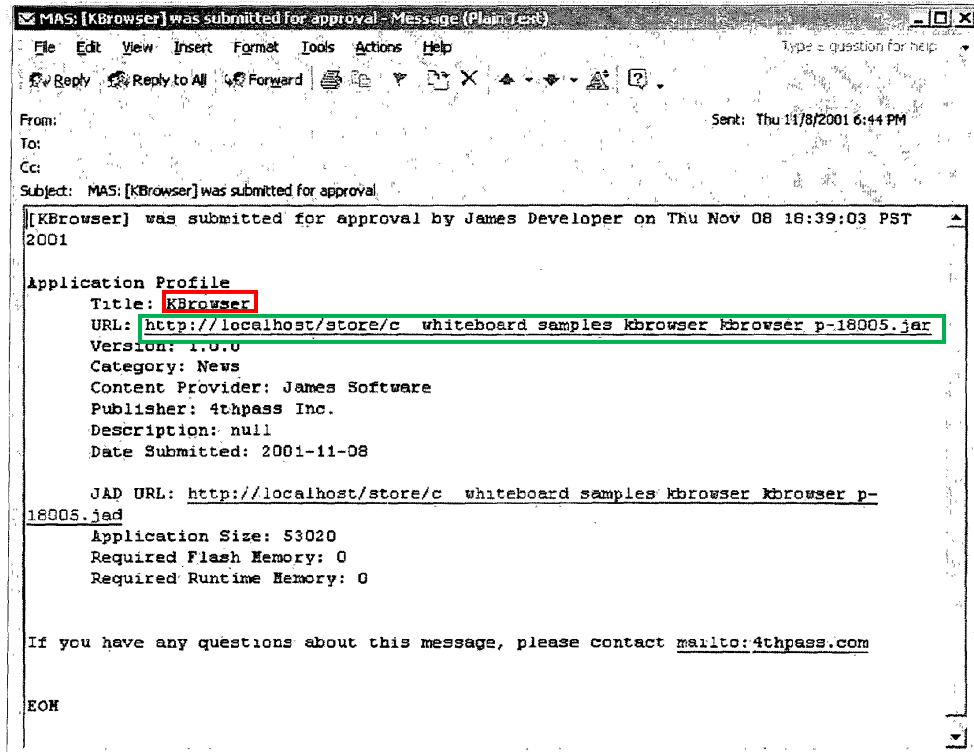


Fig. 9D

EX1003, Fig. 9D (annotated). As depicted above, the claimed “item of digital content” in Figure 9D is “Kbrowser” (in the red rectangle), and the claimed “implementation” would be the .jar file of “Kbrowser” (at the URL in the green rectangle). Thus, the Petition’s mapping does not point to the same application to satisfy each limitation but rather confirms that the claimed “items of digital content” and the associated claimed “implementation” are both taught by Mehta.

2. Mehta teaches the claimed “different implementations”

MAS teaches the claimed “different implementations of at least one of the items of digital content.” EX1002, ¶¶65–66. As explained above, PO conflates Mehta’s description of the problem in the art to be Mehta’s solution when contending that Mehta “never suggests that the applications can have different versions or implementations for different device types” and that “there must be a separate ‘application[]’ for ‘each device.’” POR, 18. Tellingly, PO does not rely on Mehta’s intrinsic record to support its untenable positions.

To the contrary, Mehta expressly discloses that MAS has the claimed “different implementations of at least one of the items of digital content.” Specifically, Mehta teaches that when a content provider submits an application, it may submit additional information about the application including, for example, the URL, Title, Version, and Description. EX1003, [0098], Figs. 9B, 9C. This additional information “allows the MAS to store and support *functionally equivalent programs having the same name* that are capable of running on multiple kinds of devices.” *Id.* (emphasis added). MAS’s ability to store “[f]unctionally equivalent programs having the same name” demonstrates that Mehta teaches the claimed “plurality of different implementations of at least one of the items of digital content.” *See* EX1002, ¶66.

In an attempt to distort this clear disclosure, Dr. Goodrich opines that Mehta only stores “multiple different applications (pieces of content) not to a single application that has ‘functionally equivalent’ versions,” and “‘functionally equivalent’ applications are merely those that accomplish the same function—*they are not different versions of the same application.*” EX2020, ¶¶70-71 (emphasis added). Dr. Goodrich posits that “[a] POSITA would understand that allowing ‘functionally equivalent’ applications (*e.g.*, Microsoft Word and Apple Pages; or Microsoft PowerPoint and Google Slides . . .) is not the same thing as having multiple implementations of an individual item of digital content (*e.g.*, Microsoft Word for Windows and Microsoft Word for Apple Macs).” *Id.*, ¶70.

Although two different word processing applications like Microsoft Word and Apple Pages might be considered “functionally equivalent,” that example is not germane to Mehta, which specifically refers to the MAS storing “functionally equivalent programs *having the same name.*” EX1003, [0098] (emphasis added). Clearly, Microsoft Word and Apple Pages do not have the same name. What Mehta refers to is MAS’s ability to store applications with the same name, like Microsoft Word (Windows) and Microsoft Word (Mac).

When confronted at his deposition, Dr. Goodrich admitted that Microsoft Word (Windows) and Microsoft Word (Mac) are functionally equivalent

applications and that Mehta's MAS can store both, gutting the positions he took in his declaration:

Q. [O]ne of ordinary skill in the art at the time of the '790 patent would also understand that Microsoft Word for Windows and Microsoft Word for Mac are also functionally equivalent, correct?

A. Yes. I'm not disputing that. But they would be even stronger than simply functionally equivalent. They would be different implementations for the same product.

[...]

Q. So if a content provider like Microsoft wanted to submit Microsoft Word for Windows to the MAS system in Mehta and also wanted to submit Microsoft Word for Mac, MAS would be able to disambiguate between the two different versions of software, correct?

A. Yes.

[...]

Q. But the MAS would allow those two different versions of Microsoft Word to be submitted into the MAS and its repository, correct?

A. I would not dispute that.

EX1029, 43:14-24; 47:15-22; 48:5-11 (omitting objections).

Trying to salvage the unreliable opinions in his declaration, Dr. Goodrich attempted to distinguish the '790 patent claims by testifying that Microsoft Word (Windows) and Microsoft Word (Mac) in MAS “would not be considered different implementations of the same product” but would instead be “different applications.” *Id.*, 48:12-16; *see also* 48:1-3. But this is nothing more than a veiled claim construction position to narrow the scope of the claimed “implementation” and the '790 patent’s claims from their plain and ordinary meaning, which was not explicitly requested by PO nor supported by the '790 patent’s intrinsic record. Indeed, the '790 patent’s claims simply require receiving and storing “a plurality of different implementations of at least one of the items of digital content”—there is no limitation requiring storage in a multi-level database or data structure. The '790 patent’s claims recite “items of digital content” not “product entry” (a term only used in the '790 patent’s specification), and thus do not require the 2-layer hierarchy depicted in Figure 5. *See* EX1001, Fig. 5; 9:38-40. This is bolstered by the '790 patent’s specification, which discloses “[a]n implementation 57 can be simply a binary file (a “binary”) representing the product.” EX1001, 9:40-42; *see also* EX1025 (*Starz* Claim Construction Order), 2-3.

There is no dispute that Microsoft Word for Windows and Mac are a “plurality of different implementations” of Microsoft Word (an “item[] of digital content”) and that they are functionally equivalent applications that can be stored in MAS. Mehta, therefore, does not “teach[] away from applications having multiple implementations” nor is it “fundamentally incompatible with applications having multiple implementations,” as PO contends. POR, 23.

B. Mehta teaches the “product catalog includ[ing], in association with each item of digital content, a reference to each implementation of said item of digital content”

As explained in Section II.A, Mehta unequivocally teaches the claimed “plurality of different implementations.” PO’s argument that “[a]ny references Mehta discloses are to the ‘applications’—the ‘items of digital content’—not to the implementations,” is incorrect. POR, 25.

Mehta’s data repository that stores application profiles, which include a URL of the content, is the claimed “product catalog includ[ing], in association with each item of digital content, a reference to each implementation of said item of digital content. When submitting an application to the MAS, the Content Provider Website requests “additional information from the content provide [sic] about the application to be submitted, which becomes part of an application profile.” EX1003, [0098]. Figure 9B includes exemplary information about the application that is requested, including Title, URL, Version, and Description. *Id.*, Fig. 9B. The

application submission notification in Figure 9D (above) uses the data “to create the application profile, *which is stored and maintained in a data repository* (e.g., data repository 511 in FIG. 5).” *Id.*, [0099] (emphasis added). For example, regarding Figure 9D, the “item of digital content” is “Kbrowser,” the “implementation” is in the .jar file, and the URL, which is associated with this implementation of “Kbrowser,” is the “reference to each implementation of said item of digital content.” EX1003, Fig. 9D, [0099]. This information in the application profile is stored in MAS’s data repository—the claimed “product catalog.” EX1002, ¶67. Thus, PO’s argument that Mehta “does not show that the ‘URL’ or ‘other location reference’ is included in the ‘product catalog,’ as required by the claims” has no merit. POR, 26.

PO refers to the “Applications Store 1216” in Mehta to assert “MAS takes the ‘URL or other location reference’ submitted by the ‘content provider,’ . . . [but] does not disclose that the ‘URL or other location reference’ is ever stored in the ‘data repository.’” POR, 27. This is false. The “Application Store 1216” and process described in paragraph [0131] of Mehta is associated with the embodiment described in relation to Figure 12 of Mehta and does not preclude the application profile being stored in the data repository. Regardless, PO ignores that the Figure 5 embodiment discloses that the URL associated with the item of content is stored in the application profile, which is then stored in the data repository. EX1002, ¶67.

PO next argues that the “‘URL or other location reference’ is 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.’” POR, 28. That is irrelevant. As explained above, a URL associated with the content is stored in the data repository. That the URL may be the location of the application before it is stored in MAS is of no consequence. There is no limitation in the ’790 patent claims that requires the claimed “reference” to be a location in the product catalog where the implementation of the item of digital content is stored—the claims merely require that the “product catalog” include a “reference to each implementation,” which is what the URL is.

C. Mehta teaches “the selected portion, as presented to the subscriber, provides only a single description of each item of digital content in said portion”

First, the Petition specifically explains how Mehta teaches this limitation, negating PO’s unsupported argument that the Petition does not. POR, 29-30. Mehta, for example, expressly teaches “application discovery returns a list of content that can be downloaded that match criteria that are designated by the subscriber” and in some embodiments “the MAS only lists those applications that are supported by the subscriber’s device.” Pet., 36 (citing EX1003, [0006, 0117]). Indeed, Mehta discloses that Figure 11F is an exemplary screen display of the “subscriber’s Personal Access List” (“PAL”), which includes “the name and

description of the application.”¹ *Id.* Figure 11F (below) depicts that the list of applications satisfies the claimed “only a single description of each item of digital content.” For example, the Amark game application, is an “item of digital content” (green rectangle) and has a single description “Amark.”

¹ As background, a “subscriber’s PAL is the list of applications that the subscriber desires to have the MAS display on the subscriber’s device during, for example, application discovery.” EX1003, [0116].

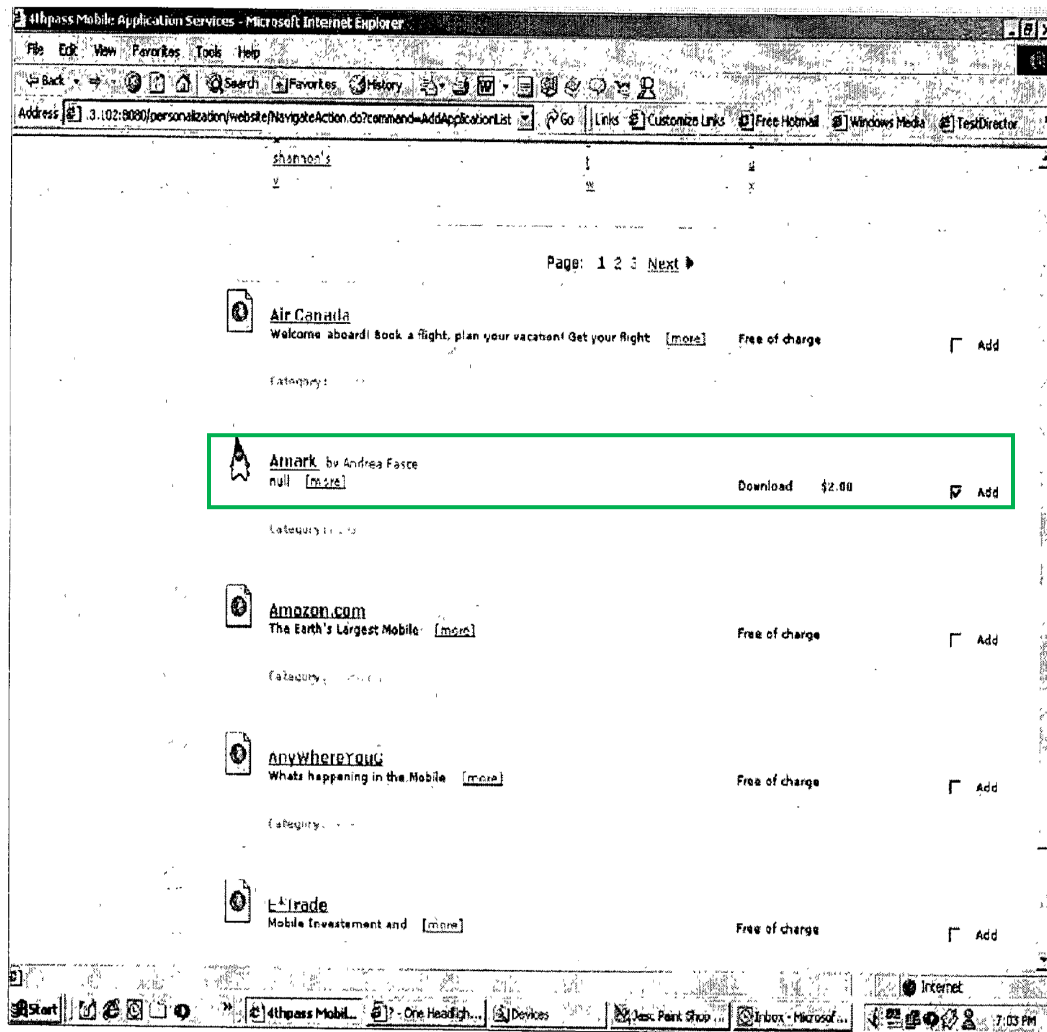


Fig. 11F

EX1003, Fig. 11 (annotated).

Figure 2 (above), analyzed by Dr. Goodrich (*see* EX2020, ¶45), depicts how the list of applications could look on a subscriber's device, *i.e.*, there is only a single description identifying each game. In view of this express disclosure and that Mehta discloses “different implementations,” it is simply incredulous for PO

to contend that the Petition did not analyze this limitation or that “Mehta is silent” as to this limitation. POR, 29-30.

Second, PO’s hypothetical regarding “Program A” and “Program B” is incomplete and should be disregarded. POR, 31-32. For example, those programs have different titles, and it is not clear whether they are functionally equivalent applications like Apple Pages and Microsoft Word, which would impact what is displayed to the user.

D. Mehta teaches “selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber”

PO argues the Petition points to the “Application Discovery” process in Mehta as “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.’” POR, 33. This is not so.

Mehta teaches the claimed “selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber,” as explained in the Petition and by Netflix’s expert, Mr. Wechselberger. During Application Discovery, a filtered list that includes “only appropriate versions from which the user may select an item for download” is presented to the user’s device, as explained in Section II.C and depicted in Figure 2. Pet., 41 (citing EX1003, [0067]). Accordingly, what is presented to the user’s

device, is the claimed “single description of each item of digital content,” not the “implementation.” EX1003, Fig. 2.

Once the user selects the application to download, “the MAS retrieves the application, *verifies that it is appropriate and permitted* for download to that device and user . . . and sends the packaged application to the requesting subscriber device.” Pet., 41 (emphasis added) (citing EX1003, [0070]). Thus, the application that the user selects is the “requested item of digital content.” Mehta further explains the “Verify Device routine *compares the device profile associated with the subscriber’s device* to the application profile for the requested application and *verifies that the resources required by the application are available according to the device profile.*” EX1002, ¶83 (citing EX1003, [0139]). If so, only after analyzing the device’s capabilities with the resources required for the application, will the MAS then select that implementation of the application for download onto the user’s device.

Furthermore, Mr. Wechselberger’s deposition testimony is consistent. He was asked whether the MAS “re-check[s] that that selected application is compatible with the user’s device,” and he testified “[s]ince 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.” EX2021, 53:11-20. Indeed, the verification routine

checks whether the devices have *the resources required by the application*, not whether the application is compatible. EX1003, [0139].

The other portion of Mr. Wechselberger's deposition cited by PO is also inapposite. POR, 34-35. Specifically, Netflix's expert was asked: "When a user selects one of the applications from the filtered list, the user will never get a different application than the one they requested, right?" EX2021, 54:5-11. He responded: "Certainly nothing like that is disclosed by Mehta that I can recall." *Id.* But the question posed is nonsensical. If a user selects "Doom" from the filtered list shown in Figure 2, MAS will not return "Frog." If the application satisfies the verification processes, MAS will download the appropriate Doom implementation to the user's device.

III. THE CHALLENGED CLAIMS ARE OBVIOUS OVER MEHTA AND SCHLAPFER

Schlapfer and Mehta both focus on provisioning for software applications particularly for mobile devices with small displays. Schlapfer teaches using application descriptors that identify an application's attributes during provisioning. A POSITA would combine Mehta with Schlapfer to improve Mehta's provisioning

process. PO's attempts to recast Mehta and Schlapfer as non-analogous and incompatible are not credible, and should be rejected.²

A. Schlapfer is prior art

PO's argument that Schlapfer, an article that was available on the Internet, was not publicly available and therefore is not prior art is unavailing. **First**, Schlapfer, was dated July 7, 2001, prior to the '790 patent's June 19, 2003 priority date.³ Pet., 19 (citing EX1009, 26). **Second**, Schlapfer was cited in EP1303153B1 (EX1017, field (56)), indicating that Schlapfer was accessed via the Internet at

² Regarding Ground 2, PO asserts Mehta does not disclose certain limitations of the challenged claims, but these arguments fail for the same reasons discussed with respect to Ground 1, *supra*.

³ PO does not dispute that the priority date for purposes of its POR is June 19, 2003, and PO's expert assumed that date in his analysis. *See* Pet., 14–16; POR, 9; EX1029, 17:20–20:16. Any attempt to dispute the priority date in a sur-reply would be untimely and therefore waived. Paper 18, 9 (“[A]rguments not raised in the [POR] may be deemed waived.”); *Hulu, LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00298, Paper 31, 58 & n.16 (P.T.A.B. May 17, 2022) (priority argument first raised in sur-reply was waived).

“http://www.ericsson.co.th/mobilityworld/Java/White_Paper.pdf” on November 11, 2002. *Id.*, 19 n.3. These two reasons are sufficient to establish that Schlapfer was publicly available prior to the priority date.

PO contends this does not establish public availability because the URL in EP1303153B1 may not have been a public link, *i.e.*, the URL may have been a private link to an internal Ericsson server. POR, 38. This argument is nonsensical because the EP1303153B1 applicant was affiliated with Vodafone, an entirely separate entity from Ericsson and would presumably not have had access to an internal Ericsson server. EX1017, field (73).

To confirm Schlapfer was available on the public Internet, Netflix obtained a declaration from June Munford, an expert in the field of library and information science.⁴ EX1030. Ms. Munford found that the URL cited in EP1303153B1 was

⁴ Reply evidence is proper because it is directly responsive to an argument made in the POR. *See* POR, 37–39. Such new evidence and argument is permissible in reply when it “elaborates on [an] . . . argument” originally made in the petition. *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1385 (Fed. Cir. 2023); *see also Universal Electronics, Inc. v. Roku, Inc.*, IPR2022-00818, Paper 29, 26 (P.T.A.B. Oct. 23, 2023) (reply evidence permitted where the petitioner did not “chang[e] its theory” of public accessibility).

referenced on Ericsson’s public website by no later than August 3, 2002, before the ’790 priority date. *Id.* ¶9. Accordingly, Ms. Munford concluded that “Ericsson was clearly advertising and distributing copies of [Schlapfer] to the public as of August 3, 2002.” *Id.* Thus, there can be no doubt that Schlapfer is prior art. *See, e.g., Jazz Pharms., Inc. v. Amneal Pharms., Inc.*, 895 F.3d 1347, 1356–59 (Fed. Cir. 2018) (materials on the FDA website were publicly accessible); *Voter Verified, Inc. v. Premier Election Sols., Inc.*, 698 F.3d 1374, 1379–81 (Fed. Cir. 2012) (article posted on a website “open to any internet user” was publicly accessible).

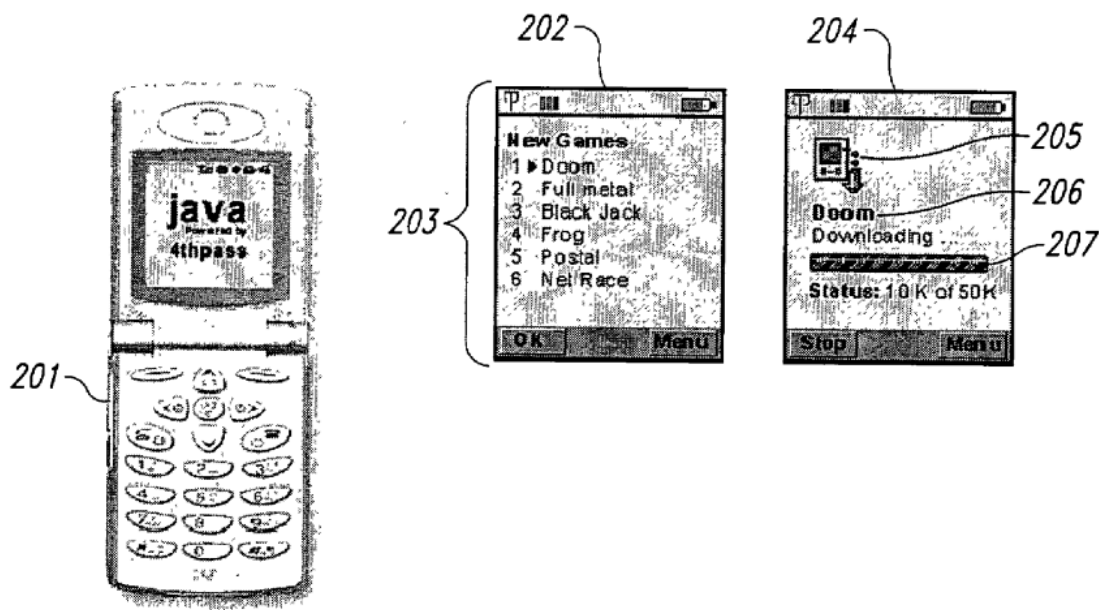
B. Mehta and Schlapfer disclose providing “only a single description of each item of digital content, regardless of the number of implementations”

As discussed above, Mehta alone discloses this limitation. Nonetheless, combining Mehta and Schlapfer makes it even more clear that the challenged claims are unpatentable.

MAS’s ability to list only those application that are supported by the subscriber’s device “avoid[s] the problem of having to explicitly select a compatible application.” EX1003, [0117]. Schlapfer recognizes that mobile devices have “limited screen space” and “limited [network] bandwidth.” EX1009, 7. Thus, it would have been obvious to a POSITA to present only the necessary information on the user’s screen such as “only a single description of each item of

digital content in said portion regardless of the number of implementations of each said item.” EX1002, ¶108.

PO vaguely argues that “there are many ways to accomplish” limiting the amount of content shown on a small screen. POR, 40. But Figure 2 of Mehta, for example, depicts only a “single description of each item of digital content”:



EX1003, Fig. 2, [0063]. In menu 202, the user’s screen is so small that it can display only the titles of six games at once. *See* EX1029, 50:8–13. Likewise, screen display 204 depicts only the title of one game. Given the limited amount of display space, there are not “many ways to accomplish” further limiting the amount of information on those screens. POR, 40. With respect to descriptions of content, a POSITA would readily have considered displaying a “single description

of each piece of content” to limit the amount of information shown on a mobile device screen, like in Mehta, Figure 2. *See* EX1002 ¶¶105–08.

Relatedly, PO makes the misguided argument that “Mehta would have to be fundamentally changed to incorporate multiple versions,” POR, 40. First, as explained above, Mehta discloses the claimed “different implementations,” which even Dr. Goodrich admitted. EX1029, 47:15–22, 54:21–55:10. Third, Mehta discloses that the MAS stores the “version” of an application uploaded to the system. *See, e.g.*, EX1003, Figs. 9B, 9D, 10C. Thus, Mehta would not have to be fundamentally changed to incorporate multiple versions of an application.

**C. A POSITA would have understood that Mehta discloses
“provisioning models corresponding to a different set of device
capabilities”**

It is undisputed that Mehta discloses at least four examples of provisioning models. PO’s argument that Mehta does not satisfy this limitation⁵ because Mehta is allegedly limited to *only* the four provisioning models expressly identified is inconsistent with Mehta’s broader disclosures.

Mehta has extensive disclosures regarding provisioning. *See, e.g.*, EX1003, [0011-0015], [0072-0076], [0080-0081], [0135-0144]. In Mehta, “provisioning” refers to “the customizing and distributing of content for a particular use, for

⁵ The Petition relies only on Mehta for this limitation.

example, for use on a particular kind of subscriber device by a particular customer.” EX1002, ¶0059. A POSITA would therefore understand Mehta to disclose more than the four exemplary models expressly identified in its specification.⁶ See EX2021, 16:9–13; EX1002, ¶116.

Device capabilities are also considered during Mehta’s provisioning process, which PO ignores. For example, “the Device Verifier 602” in Provisioning Manager 600, in Figure 6, “determines whether the device capabilities are sufficient to support a specific application.” EX1003, [0085], Fig. 6. Device profile information is used “during the provisioning of an application.” *Id.*, [0112]. From those disclosures, a POSITA would have understood that device capabilities play an important role in Mehta’s provisioning process, and thus it would have been obvious to employ provisioning models that correspond to particular device capabilities. See EX1002 ¶¶115–16.

Based on Mehta’s provisioning disclosures, the choice of additional, specific provisioning models was left up to a POSITA. For example, the choice between “walled garden” and “open” provisioning in Mehta is based principally on whether

⁶ PO incorrectly contends that this argument was not raised in the Petition. POR, 48. The Petition, however, explains Mehta discloses “*at least four* different types of provisioning models.” Pet., 54 (emphasis added).

an application is published to the MAS. EX1003, [0008–0009]. Likewise, the choice between “static” and “dynamic” provisioning is based generally on when the content is provisioned. Because of that distinction, MAS can use multiple provisioning models simultaneously, such as “walled garden” and “static” provisioning. *See id.* Indeed, Mehta teaches “[p]rovisioning includes one or more of the steps of retrieving, inspecting . . . and packaging, and may include additional steps as needed to ready an application for downloading to a target device.” *Id.*, [0064]. A POSITA would thus recognize that various considerations in the provisioning process (*e.g.*, device capabilities, application packaging, or encryption) may require selection of additional provisioning models based on device capabilities. *See id.*, [0012], [0064], [0085]; EX1002 ¶116.

D. Mehta and Schlapfer disclose “a corresponding set of provisioning attributes and descriptors”

Mehta combined with Schlapfer’s application descriptors satisfies this limitation.

The ’790 patent discloses creating a “content descriptor” based on the selected provisioning model, which corresponds to the claimed “provisioning descriptors.” EX1001, 13:28–30. That content descriptor contains several attributes, such as the name, size, and URL of the content. *Id.*, 13:30–33. One type of implementation on which the provisioning model (and thus the content

descriptor) may be based is a “MIDlet.” *Id.*, 13:23. A MIDlet is a Java software application that implements certain packages designed for mobile devices.

EX1009, 6. A typical MIDlet contains a “.jar” file, which is executable, and may also have a “.jad” file, which is an “application descriptor.” *Id.*

Schlapfer discloses an application descriptor containing “attributes” such as the application’s name, size, and URL. *Id.* The application descriptor is sent to the mobile device during provisioning, just as the content descriptor of the ’790 patent is downloaded during provisioning. *Id.*, 10–11; EX1001, 13:36–37. The descriptors of Schlapfer and the ’790 patent are equivalent. *See* EX1001, 13:28–30. Thus, the “application descriptor” described in Schlapfer is plainly an example of the “provisioning descriptors” claimed in the ’790 patent.

Thus, PO’s contention that the descriptors and attributes disclosed in Schlapfer have “nothing to do with” provisioning is unavailing. *See* POR, 51.

E. A POSITA would have been motivated to combine Mehta and Schlapfer

PO advances three, unfounded attacks on the Mehta/Schlapfer combination: (1) Mehta and Schlapfer are not analogous art; (2) a POSITA would not have understood how to combine Mehta and Schlapfer; and (3) a POSITA would also

have not been motivated to combine the two references for purposes of the “provisioning attributes and descriptors” limitation of claims 5 and 12.⁷

First, Mehta and Schlapfer are analogous art. It is well-settled that a reference is analogous art if it is “from the same field of endeavor” or if it is “reasonably pertinent to the particular problem with which the inventor is involved.” *K-TEC, Inc. v. Vita-Mix Corp.*, 696 F.3d 1364, 1375 (Fed. Cir. 2012). Both conditions are met here: “Mehta and Schlapfer are directed to distributing digital content to mobile devices over a wireless network.” EX1002 ¶137. This alone is sufficient to establish that Mehta and Schlapfer are analogous.

PO strains to distinguish Mehta from Schlapfer, arguing that they “concern different aspects of the application lifecycle.” POR, 41. PO argues, Mehta concerns “maintaining and provisioning” applications over a wireless network, while Schlapfer concerns “application development on mobile devices.” *Id.*

Those sweeping characterizations of the references, however, ignore their actual disclosures. Although Mehta focuses heavily on the process of provisioning

⁷ In addition, PO again mischaracterizes Mehta, contending Mehta would need to be “fundamentally changed in order to incorporate multiple versions of applications” to assert there is no motivation to combine. POR, 43. As discussed in Section III.B, *supra*, that contention is incorrect.

mobile applications, it also involves the development of such applications. For example, implementing MAS would require developing software for a mobile device, such as the disclosed “website based user interfaces” for the subscribers.⁸ EX1003, [0015]; *see also id.*, Fig. 2. Likewise, Schlapfer is not limited solely to application development, as it expressly discusses the process for provisioning mobile applications. EX1009, 10–11.

Second, a POSITA would have known ***how*** to combine Mehta and Schlapfer. PO again reads Mehta too narrowly, contending that a POSITA would not have understood how to combine the references because Mehta’s discussion of provisioning models “is different from Schlapfer’s treatment of provisioning.” POR, 42. However, as discussed above, the four provisioning models discussed in Mehta are merely examples; Mehta makes clear that device capabilities are considered during the provisioning process. A POSITA would have looked to Schlapfer (and other analogous references) to consider additional approaches to provisioning beyond those expressly identified in Mehta, and would not have had difficulty doing so. A POSITA would have been familiar with provisioning mobile

⁸ As Mehta explains, subscribers are “mobile subscriber devices, such as wireless devices.” EX1003, [0005].

applications, including the use of provisioning models including “a corresponding set of provisioning attributes and descriptors.” EX1002, ¶140.

Third, a POSITA would have also been motivated to combine Mehta and Schlapfer as to the claimed “provisioning attributes and descriptors.” PO alleges Mehta’s provisioning models “have nothing to do with” Schlapfer’s descriptors and attributes. POR, 52. But a POSITA, who would have had significant experience and/or training in “content distribution and management,” would have known “that a provisioning model would include a corresponding set of provisioning attributes and descriptors.” EX1002, ¶¶26, 140. A POSITA would have needed to look beyond Mehta for guidance as to how to implement attributes and descriptors that a POSITA would have expected to be present in a provisioning model. *See id.* One available source is Schlapfer, which is analogous art to Mehta. Accordingly, a POSITA would have been motivated to combine Mehta and Schlapfer as to the “provisioning attributes and descriptors” limitation. *See id.*, ¶¶140–41.

IV. AMENDED CLAIMS 1 AND 8 ARE INVALID

The Board has authority to and should determine whether claims 1 and 8 as amended during reexamination are invalid. Paper 15, 2–6. Further, PO has not put forth any evidence negating that the Petition sufficiently addresses amended claims 1 and 8 or challenging Mr. Wechselberger’s supplemental declaration (EX1026).

See EX1029, 17:6-14. Accordingly, the grounds and supporting evidence in the Petition establish that amended claims 1 and 8 are unpatentable.

V. CONCLUSION

For the foregoing reasons, the Board should find that the challenged claims are unpatentable.

Respectfully submitted,

Dated: March 15, 2024

By: // Aliza George Carrano //
Lead Counsel for Petitioner

CERTIFICATE OF COMPLIANCE

The undersigned certifies that this Petition complies with the applicable type-volume limitations of 37 CFR § 42.24. Exclusive of the portions exempted by 37 CFR § 42.24(a), this Petition contains 5,574 words as counted by the word processing program used for its preparation (Microsoft Word 2021).

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on March 15, 2024, a copy of the foregoing document was served by email directed to the following counsel of record and distribution list:

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