

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,

Petitioner

v.

VIDEOLABS, INC.,

Patent Owner

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

PATENT OWNER'S SUR-REPLY

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
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 Goodrich
2021	Deposition Transcript of Mr. Anthony Wechselberger
2022	Deposition Transcript of Ms. June Ann Munford

Pursuant to the Board's Order (Paper 12), Patent Owner submits this Sur-Reply in response to Petitioner Reply and to address the Board's questions.

I. Introduction

In its Response, Patent Owner ("PO") demonstrated that Mehta and Schlapfer do not disclose or render obvious many of the challenged claim elements. Mehta discloses multiple, different "items of content" *not* a single item of content that has multiple different "implementations," as is required by the claims. And Petitioner does not allege that Schlapfer discloses or suggests that missing, key element. This deficiency cuts through each of the challenged claims. In Reply, Petitioner attempts to muddy the water by minimizing the fundamental differences between Mehta and the challenged claims, but its argument are baseless.

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

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

Petitioner does not dispute that the '790 patent requires a plurality of different implementations of at least one of the items of digital content. Reply, 2-11; POR, 13-16. Petitioner instead argues that Mehta discloses this requirement, but its argument is based on a flawed premise: That Mehta's multiple different applications ("items of content") are the same as multiple different "implementations of" a single

application.¹ Reply, 2-11. They are not. Mehta’s disclosure is consistent and clear: it contemplates multiple, different “items of content” (albeit ones that might be “functionally equivalent”)—it *never* discloses a single item of content that has multiple different “implementations,” as is required by the claims. POR, 17-23.²

Petitioner ignores much of PO’s evidence showing that Mehta does not disclose any “item of content” with multiple implementations. *Compare* POR, 19 (discussing EX1003, ¶0067), 20 (discussing verification in Mehta) *with* Reply, 4-11. Instead, in Reply as in its Petition, Petitioner relies on Mehta’s single reference to “functionally equivalent programs,” arguing that the “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.’” Reply, 7; Pet., 29 (both citing EX1003, ¶0098). Petitioner’s conclusory argument does not follow from Mehta. As explained in PO’s Response, Mehta’s explicitly refers to different “functionally equivalent programs;”

¹ Petitioner alleges that Mehta’s “other content to be provided to the mobile subscriber device includ[ing], for example, games, text, graphics, audio, and video” can also be mapped to the claimed “items of content.” Reply at 4-5. Petitioner does not explain how these “other content” allegedly meet the claim language differently than “applications.” Reply at 4 (only reference to this “other content”); Pet., 26-27 (same). The “other content” is irrelevant to the parties’ dispute.

² Petitioner argues that PO’s Response “takes the problem that Mehta describes and conflates it to be Mehta’s solution.” Reply, 3-4. The point is that Mehta never contemplates a single application with multiple implementations—which is true in both Mehta’s description of the problem and its solution. POR, 6-7, 17-23.

that is, multiple different “items of content.” POR, 16-23. By its own language, Mehta does not disclose multiple implementations of any single item of content, as the claims require, but at most different “items of content” each with only a single implementation. Multiple “items of digital content” cannot by themselves meet the limitation, even if those items share the same name and are “functionally equivalent.

Petitioner’s examples emphasize that each of Mehta’s “items of content” only has a single implementation. For one example, Petitioner annotates Figure 9D (which is reproduced below), and states that “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).” Reply at 5-6. Notably, in Petitioner’s example the “item of content,” “kBrowser,” only has a single “implementation,” “the .jar file of ‘Kbrowser’ (at the URL in the green rectangle). Indeed, Figure 9D underlines that Mehta only contemplates applications having one “implementation,” as there is only room to submit a single “URL” for a single file. Figure 9D also shows that each application (whether “functionally equivalent” or not) has its own “application” profile each with a single implementation. EX1003, Fig. 9D; *see also id.*, Fig. 9A (showing only a single file can be submitted for the application).

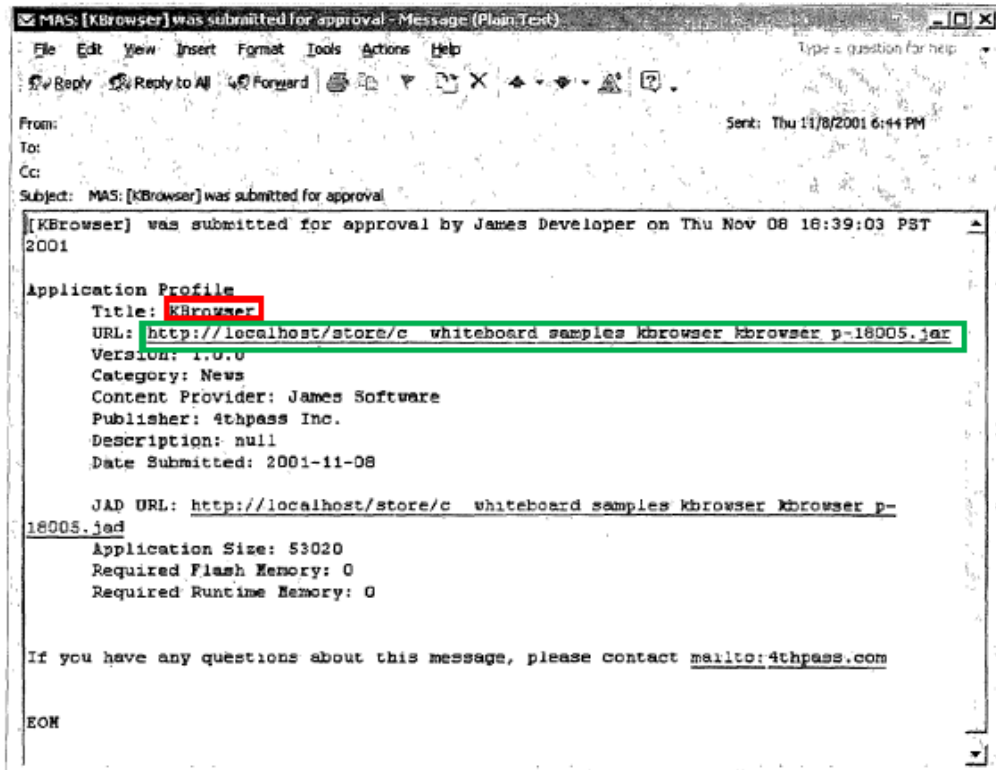
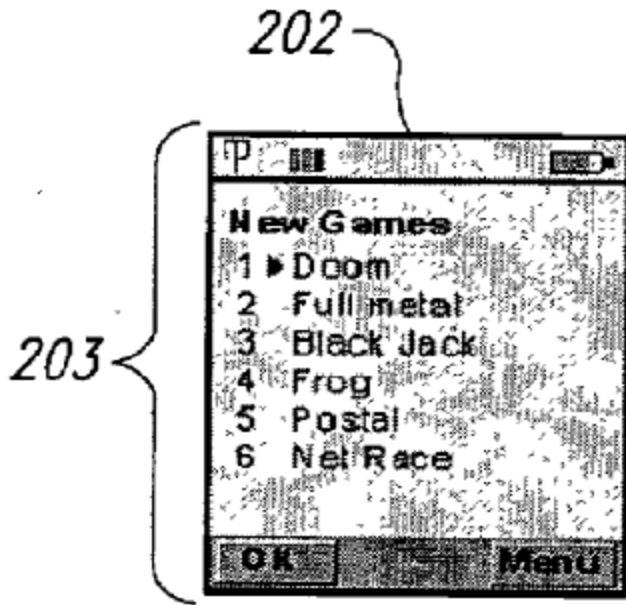


Fig. 9D

Petitioner next points to a list of games in Mehta's Figure 2 (shown below) as examples of "items of digital content" ("Doom," "Black Jack," etc.). Reply at 4-5. Petitioner does not explain how this example shows "a plurality of different implementations." Every indication is that each game has only a single implementation.



EX1002, Fig. 2 (excerpted).

Moreover, even if you consider a hypothetical scenario with “functionally equivalent” games with the same name (for example, two “Dooms,” each written in different computer languages), there is no disclosure in Mehta that the “functionally equivalent” games would somehow constitute multiple “implementations” instead of what they are, multiple different “items of content.”

Much the opposite, Mehta is clear that each “functionally equivalent” item of content is still its own application. EX1003, ¶0098. Mehta explains that “[s]pecifying” information such as “the application source language” is what allows it to store “functionally equivalent programs having the same name.” *Id.*, ¶0098. In other words, Figure 2, which shows “a list of new applications,” would simply show two “Doom” games, but the MAS would be able to distinguish them using

information such as “the application source language.” *Id.* Mehta simply does not disclose that two “functionally equivalent” games (such as two different “Doom” games) would actually be displayed as a single game, with a single entry for “Doom.”

Petitioner makes great hay out of Patent Owner’s expert, Dr. Goodrich, stating that two hypothetical applications (“Microsoft Word (Windows) and Microsoft Word (Mac)”) are “functionally equivalent.” Reply, 8-10. But that testimony does not support Petitioner’s argument, much less “gut[] the positions [Dr. Goodrich] took in his declaration.”³ *Id.*, 9. Dr. Goodrich acknowledged that “Microsoft Word for Windows and Microsoft Word for Mac” are functionally equivalent, but that Mehta does not disclose treating them as two implementations of a single “item of content.” Transcript of Deposition of Michal T. Goodrich (EX1029), 47:15-48:20. As Dr. Goodrich explained, the MAS “would list them as separate applications, not different implementations of the same application. That’s how MAS would treat those software products, M-A-S.” EX1029, 47:15-48:20.⁴ That is because, “when Mehta is disclosing functionally equivalent, it is not referring to it as different

³ Petitioner’s quoted testimony purports to only “omit[] objections,” Reply at 10, but the quotes in fact leave out most of Dr. Goodrich’s answers. Goodrich at 47:15-48:20

⁴ Petitioner alleges that Dr. Goodrich’s opinion is a “claim construction position,” Reply at 10, but that makes no sense. Dr. Goodrich is opining on Mehta’s disclosure and its application to the claim language, not on claim construction.

implementations of the same product. Instead, it's revealing it to describe how to disambiguate in its descriptions of all flat, not clustered in terms of implementations, different applications where functionally equivalent programs even with the same name can nevertheless be distinguished based on other metadata." EX1029, 43:35-48:4.

Petitioner asserts that "[t]here 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," Reply, 11, but that is simply not true. Regardless of how a different, modern system would treat Microsoft Word, *Mehta* has no concept of "items of digital content' with different implementations. Thus, once Microsoft Word for Windows and Mac are submitted to the MAS, they would be "list[ed] . . . as different applications. Completely different. They just happen to have the same name perhaps, but otherwise the metadata would distinguish them and they would be considered completely different products in this scenario." EX1029, 47:15-48:20.

B. 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.

Petitioner alleges that "Mehta's data repository that stores application profiles" is the claimed "product catalog" and the "URL of the content" is "a reference to each implementation of said item of digital content." Reply, 11. But

Mehta does not disclose that the URL itself is “stored and maintained in a data repository,” as required by the claims. It at most discloses that the URL is used to create something (the application profile) that is in turn stored in the data repository.

Petitioner asserts “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.” Reply, 12 (citing EX1002, ¶67). But Figure 5 (reproduced below) does not even reference the URL (the alleged “reference”). Similarly, Mehta’s paragraphs 67 and 68, do not mention the URL. As Petitioner admits, Mehta only discloses “us[ing] the data [including the URL] to create the application profile,” and that the application profile (not the URL) is then stored. Reply, 11-12 (internal quotations omitted).

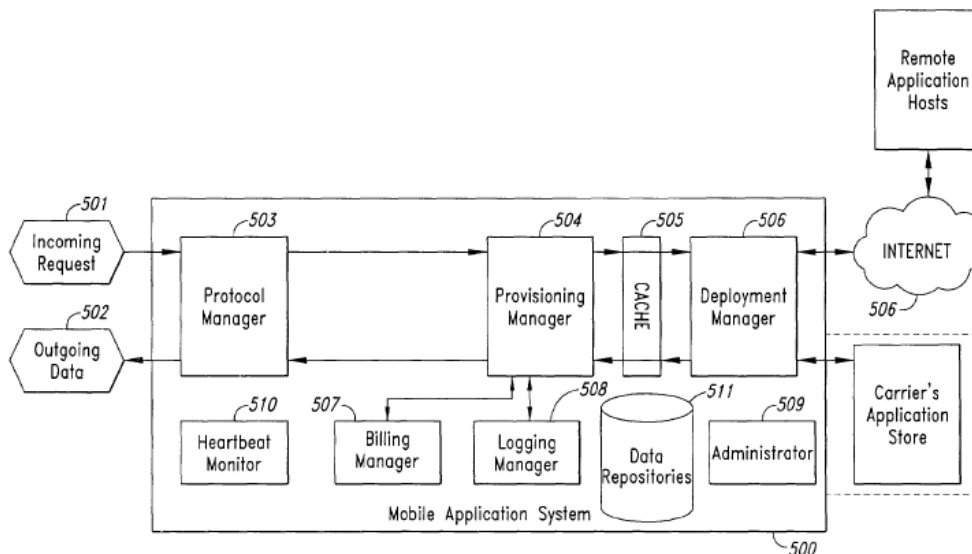


Fig. 5

Nothing in Mehta discloses that the URL is stored “in the application profile” and therefore in the data repository. Indeed, it is unsurprising that Mehta does not disclose storing the URL in the application profile or the data repository—the purpose of the URL is to “identif[y] a file (an application or service) to download” to the MAS, and thus the MAS has no reason to store that URL in the data repository after it has used it to access and download the application. EX2020, ¶¶81-83.

Petitioner’s “Kbrowser” example again highlights the problem. Petitioner argues that “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.’” Reply at 12. But Mehta only discloses that the URL is used to “identif[y] a file (an application or service) to download.” EX1003, ¶0064. There is no indication that the URL is stored “in the application profile” and thus “in MAS’s data repository,” as Petitioner claims. Reply, 12.

Petitioner next argues that PO’s discussion of the “Applications Store 1216” is irrelevant because the “Applications Store 1216” is merely one embodiment and “does not preclude the application profile being stored in the data repository.” Reply, 12. Petitioner’s ultimate point is unclear, but in any event, its statement betrays its argument: the relevant question is not whether “the application profile [is] stored in the data repository” but whether Mehta discloses storing *the URL* in

the data repository. It does not.

C. 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.

In its Response, PO pointed out that the Petition does not address the claim requirement 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.” POR, 29-30. In Reply, Petitioner disputes that argument. Reply, 13-16. But while Petitioner points out its argument that Mehta discloses a “selected portion,” Petitioner still has not addressed how Mehta allegedly discloses that there is “*only a single* description of each item of digital content in said portion *regardless of the number of implementations of each said item.*” *Id.* Tellingly, Petitioner leaves out the “regardless of the number of implementations of each said item” claim language from its section title. *Id.*, 13.

Petitioner’s example regarding the “Amark game application” again highlights the disconnect between Mehta and the claim language. Petitioner alleges that Figure 11F shows “only a single description identifying each game.” Reply at 14-16. But the claim requires “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.*” Figure 11F only shows examples of “items of content” with a single implementation—unsurprising since Mehta only discloses items of content with a

single implementation, *see supra* Section II.A—and is thus silent on whether “only a single description” would be provided if there were multiple implementations.⁵ This further highlights Mehta’s fundamental difference with the ’790 patent: It does not disclose applications with multiple implementations.

D. 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 require both “selecting a portion of the product catalog to be presented to the subscriber”⁶ and then “selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber.” Petitioner’s argument that Mehta discloses both steps rests on its assertion that Mehta discloses (1) that the MAS performs “application discovery” and *then also* (2) “[o]nce 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.’” Reply, 16-17 (quoting EX1003, ¶0070). But Petitioner inexplicably leaves out that Mehta states these steps are *alternatives*—not steps that the MAS takes one after another. EX1003, ¶0070 (“*Alternatively*, when input

⁵ In the POR, PO provided a hypothetical to demonstrate Mehta’s silence on this element. POR at 31-32. Petitioner takes issue with the hypothetical, Reply at 16, but does nothing to show that Mehta discloses what would happen for an application with multiple implementations—as is required by the claims.

⁶ This language is from Claims 2 and 9, from which Claims 4 and 11 depend.

request 501 is a request to download a designated application, the MAS retrieves the application . . .”).

The rest of Mehta is similarly clear that “application discovery” and requesting an application are *alternative* options. For example, in Figure 14 (shown below), if the user is requesting an application, then the process goes through “step 1404” (shown in blue). EX1003, ¶0135. If, on the other hand, the user is requesting an application list (“application discovery”), then the process goes in a different direction, “step 1408” (shown in yellow). *Id.* (“If, on the other hand, in step 1408 the designated command is a request for an application list, then the Provisioning Manager continues in step 1409 to perform application discovery, or continues in step 1410.”). Both paths lead to “Postprocess request 1413” and then “End.” EX1003, Fig. 14. The MAS cannot take both the 1404 and the 1408 paths in Figure 14.

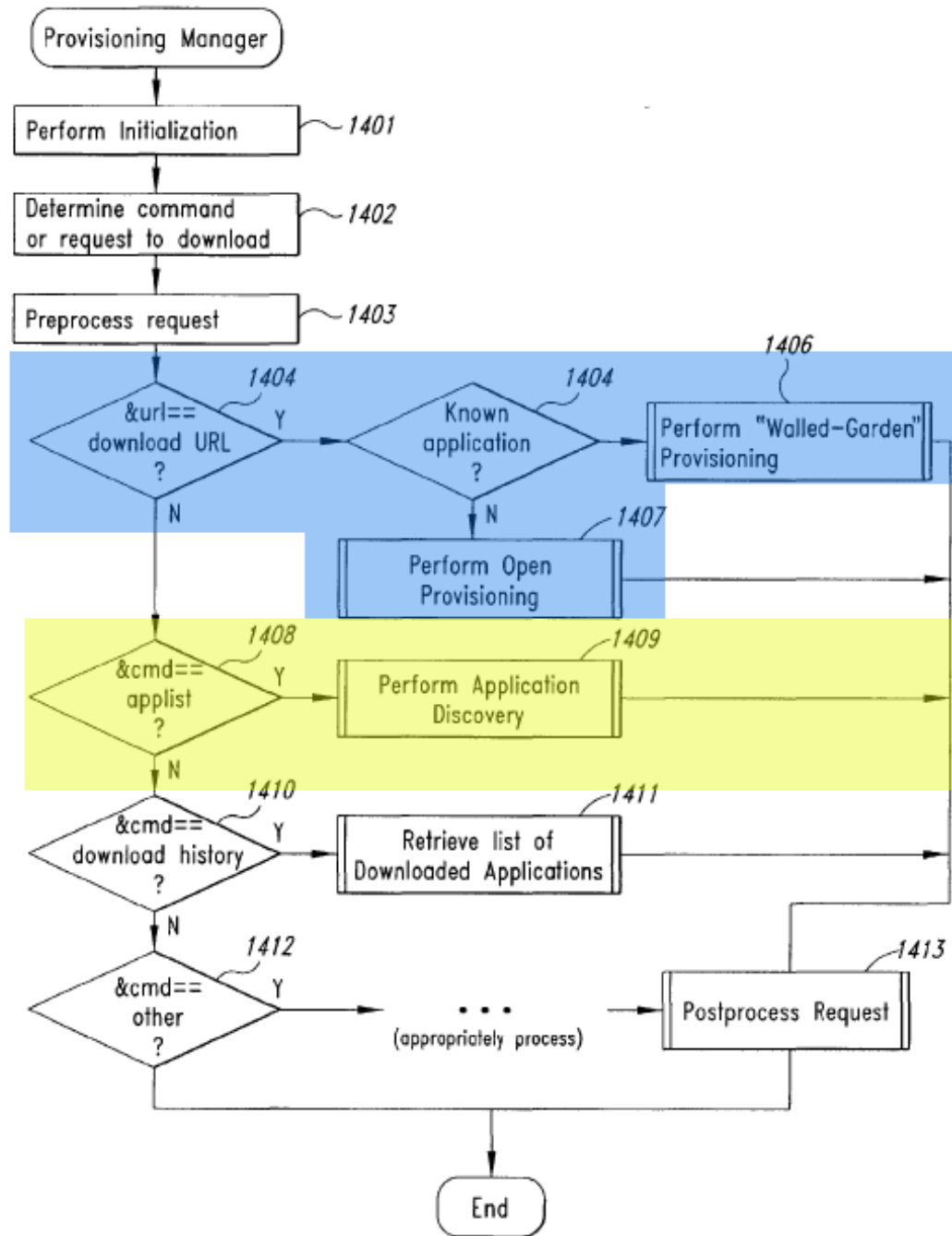


Fig. 14

Id (annotations added).

Petitioner points to Mehta’s statement that the “Verify Device routine . . . verifies that the resources required by the application are available according to the device profile.” Reply, 17. But that passage only describes how an application is requested and provided—it is not a part of the “alternative[]” application discovery process. In particular, the quoted passage concerns Figure 17, which shows “step 1504 of FIG. 15.” Mehta ¶139. Figure 15, in turn, shows “step 1406 of FIG. 14.” *Id.*, ¶136. As shown above, “step 1406 of FIG. 14” falls into the “application request” flow (shown in blue), not the “application discovery” flow (shown in yellow). *Id.*, Fig. 14.

It makes sense that Mehta does not disclose performing both “selecting” steps. As both experts testified, during application discovery in Mehta, applications are selected “based on device capabilities,” and so it would make no sense to check the application again.⁷ POR, 33-35.

Moreover, Petitioner’s argument fails even if Mehta did disclose sequentially performing application discovery and then also responding to a request for an application (which it does not). The claim requires “***selecting*** an implementation of

⁷ Petitioner argues that Mr. Wechselberger’s testimony only concerns whether the MAS checks whether the application is “compatible,” not “whether the devices have the resources required by the application.” Reply at 17-18. Petitioner’s distinction is no more than attorney argument without support in Mr. Wechselberger’s testimony or declaration. Regardless, Mehta still does not disclose performing both application discovery ***and*** this resource verification, but only discloses them as alternatives.

the requested item of digital content, based on device capabilities of the wireless device used by the subscriber.” Petitioner points, at most, to verifying “whether the devices have the resources required by the application.” Reply, 17-18. Petitioner makes no attempt to explain how verifying “whether the devices have the resources required by the application” (and either providing the application or not) discloses “*selecting* an implementation of the requested item of digital content.”

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

A. Petitioner Does Not Provide Any Obviousness Allegations For A Number Of Claim Elements.

PO noted that Mehta does not disclose the following claim elements and that the Petition does not provide any additional analysis or assertions regarding obviousness:

- “a plurality of different implementations of at least one of the items of digital content”; (POR, 98)
- “the product catalog including, in association with each item of content, a reference to each implementation of said item of content”; (POR at 35-36)
- “selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber.” (POR, 43)

Petitioner confirms in its Reply that it is only arguing that these elements are disclosed by Mehta—not that they are rendered obvious either by Mehta itself or in view of Schlapfer. Reply, 19, n.2.

B. Petitioner Has Not Shown That Schlapfer Is Prior Art.

Petitioner argues that Schlapfer was in fact publicly available before June 19, 2003, and is thus prior art. Reply, 19-21. But its argument is no more than speculation. Petitioner first points to a date in Schlapfer and a European patent. Reply, 19-20. As discussed in the POR, this evidence does not show that Schlapfer was available, much less sufficiently publicly accessible to constitute prior art. POR, 37-39.

In apparent recognition of the insufficiency of its original evidence, Petitioner submitted new evidence in reply, a declaration from a librarian, June Munford. Reply, 20-21. Petitioner's new evidence fares no better. Ms. Munford attached two screenshots from the Internet Archive's Wayback Machine: (1) a screenshot of Schlapfer located at the URL "http://www.ericsson.co.th/mobilityworld/Java/White_Paper.pdf" from August 3, 2003 (*after* the '790 patent's priority date) and (2) a screenshot of a different website that includes a link to that same URL from August 3, 2002 (before the '790 patent's priority date).

Notably, none of this is direct evidence that Schlapfer was available before June 19, 2003. Petitioner's argument is entirely based on the assumption that

Schlapfer was located at the link http://www.ericsson.co.th/mobilityworld/Java/White_Paper.pdf when the August 3, 2002 website linked to that URL. But, as Ms. Munford acknowledges, a different document besides Schlapfer could have been located at that URL in August 3, 2002. Deposition Transcript of June Ann Munford (EX2022), 15:8-16:3 (Q. It is possible -- just as a computer science matter, it is possible to have the same url and switch out the document that is available at that url. Right? THE WITNESS: In web -- in web design, it is theoretically possible to connect different resources to that url, yes.” (objection omitted)). Or a different version of Schlapfer could have been located at that URL. *Id.*, 16:19-17:6 (“Q. Okay. So, it is possible that there was a different version of the mobile applications with J2ME white paper [Schlapfer] available at the url at a different time, right? THE WITNESS: I would say on a date other than August 3rd, 2003, that is possible, yes. As of August 3rd, 2003, that is what was represented.” (objection omitted)), 19:22-20:14 (testifying that it is possible “that the link on Page 4 that [she] point[s] to in Ericsson02 [the URL] takes you to a different version than that shown in Ericsson01 [Schlapfer].”). There is only evidence that Schlapfer was located at the URL as of August 3, **2003**, after the ’790 patent’s priority date.

Moreover, even if Schlapfer was located at http://www.ericsson.co.th/mobilityworld/Java/White_Paper.pdf before June 19, 2003, there is no evidence that it was publicly available. Ms. Munford again acknowledged as much, testifying that

it is possible that “before August 3rd, 2003, that the Page 4 link in Ericsson02 [the URL] was not accessible to everyone” due to access restrictions on the webpage. *Id.*, 23:20-24:6, 25:30-26:9, 26:16-28:5 (“I can’t speak to who exactly would have had access at that time. I have no knowledge of any access restrictions, if they did exist.”), 28:17-30:2. Thus, one company (such as Vodafone, the company that received the European Patent discussed above) could have had access to Schlapfer, while the general public did not, *Id.*, 27:7-28:5, which is insufficient to show that Schlapfer was actually disseminated or locatable with reasonable diligence by an interested party. *First Solar, Inc. v. Rovshan Sade*, IPR2023-00827, Paper 13 (PTAB Nov. 16, 2023).

Petitioner has not shown that Schlapfer was actually available before June 19, 2003 (the ’790 patent’s priority date)—it simply assumes it was because the URL that would later be associated with Schlapfer existed in August 3, 2002. In other words, Petitioners assume the very thing it has the burden to prove—that Schlapfer was publicly available before June 19, 2003.

C. Mehta And Schlapfer Do Not Disclose Or Teach Providing “Only A Single Description Of Each Item Of Digital Content, Regardless Of The Number Of Implementations.”

Petitioner argues that because “Schlapfer recognizes that mobile devices have ‘limited screen space’ and ‘limited [network] bandwidth,’” “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.’” Reply, 21-22. Petitioner’s argument does not address PO’s critique. PO does not dispute that Schlapfer references small screen sizes and limited bandwidth. But 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.” POR, 39-40.

Petitioner argues that providing “only a single description of each item of digital content, regardless of the number of implementations” is obvious because it is the only way to accomplish “further limiting the amount of information on those screens [in Mehta].” Reply, 22-23. But Schlapfer merely acknowledges the reality at the time that display space and bandwidth is limited, something Mehta acknowledges as well. Since Mehta is already operating within the display space and bandwidth constraints and still does not disclose the claim limitation, there is no reason a POSITA would think that the displayed data in Mehta need be “further limited” in light of Schlapfer’s duplicative disclosure. Therefore, there is no motivation to alter Mehta to show only a “single description of each item of digital content in said portion, regardless of the number of implementations of each said item.” And regardless, as Dr. Goodrich explained, even if one were motivated to alter Mehta, the claim requirement would not be obvious because there are other

ways to adapt to a small screen size, for example “the MAS could display less information, or only display the most important or valuable applications.” EX2020, ¶105.

Ultimately, the fundamental issue is that Mehta does not disclose multiple implementations so it does not disclose only displaying “a single description of each item of digital content, regardless of the number of implementations.”⁸ Petitioner points out that “Mehta discloses that the MAS stores the ‘version’ of an application uploaded to the system,” Reply, 23, but that only reflects what version of the application the MAS has. *See, e.g.*, EX1003, ¶¶0063, 0064, 0110. It has nothing to do with having multiple implementations of a single application. *See supra* Section II.A. And Schlapfer’s generic references to size limitations do not render that fundamental change to Mehta obvious.

D. Mehta Does Not Disclose Or Teach “Provisioning Models Corresponding To A Different Set Of Device Capabilities.”

Petitioner does not dispute that the four provisioning models disclosed in Mehta (walled garden, open, dynamic, and static) do not “correspond[] to a different set of device capabilities.” Reply, 23-35; POR, 46-48. Indeed, Petitioner explicitly acknowledges that, in Mehta, which provisioning model is used is based on other

⁸ Petitioner alleges that Dr. Goodrich admits that Mehta discloses “the claimed ‘different implementations.’” Reply, 23. As explained above, *supra* Section II.A, that is not true.

factors unrelated to “device capabilities.” Reply, 24-25 (“[T]he choice between ‘walled garden’ and ‘open’ provisioning in Mehta is based principally on whether an application is published to the MAS Likewise, the choice between ‘static’ and ‘dynamic’ provisioning is based generally on when the content is provisioned.”). Unsurprisingly then, while the Petition identifies references in Mehta to “device capabilities,” the Petition never explains how the “provisioning models” ever “correspond[] to a different set of device capabilities” or even relate to device capabilities at all. Pet., 54-55; POR, 44-45 (identifying this gap in the Petition). There is thus no real dispute that Mehta’s four provisioning models do not “correspond[] to a different set of device capabilities.”

In apparent recognition that its original theory does not meet this claim limitation, Petitioner tries to introduce a new theory: that Mehta vaguely discloses “more than the four exemplary models expressly identified in its specification” because it generally discusses “provisioning.” Reply, 23-24. Petitioner’s new theory fails both because it is new, and on its own merits.

It is black-letter law that the invalidity theories set forth in the Petition define the contours of an IPR proceeding. *See* 35 U.S.C. § 312(a)(3). Thus, new arguments cannot be raised in reply. *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367, 1369 (Fed. Cir. 2016); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016); *Yita LLC v. MacNeil IP LLC*, 69 F.4th 1356, 1366-

67 (Fed. Cir. 2023) (“declining to consider Yita’s argument about modifying the teaching of Rabbe . . . because it was presented too late—in a footnote in Yita’s reply brief”). Here, there is no question that the only alleged “provisioning models” identified in the Petition are walled garden, open, dynamic, and static. Pet., 54 (“Mehta then discloses at least four different types of provisioning models (i.e., ‘walled-garden provisioning,’ ‘open provisioning,’ ‘static provisioning,’ and ‘dynamic provisioning’).”), 57 (same), 65 (same). And those are certainly the only four alleged “provisioning models” the Petition references with regard to this element. *Id.* at 54-55.

Petitioner’s sole argument for why this argument is not new is that “[t]he Petition, however, explains Mehta discloses ‘at least four different types of provisioning models.’” Reply, 6 (quoting, EX1003, ¶0054). Petitioner’s reasoning is self-evidently lacking. Indicating that additional undisclosed invalidity theories are possible does not actually disclose those theories. *See Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324 (Fed. Cir. 2019) (holding that the Board properly disregarded an alternative obviousness theory first advanced in the Petitioner’s Reply.); *Colas Sols., Inc. v. Blacklidge Emulsions, Inc.*, 759 F. App’x 986 (Fed. Cir. 2019) (“[the petitioner’s] belated attempt to stretch [the] evidence to fit its alternative ‘overlapping ranges’ theory only underscores that this theory was an afterthought raised for the first time in its Reply.”) Ultimately, Petitioner’s new theories are still

undisclosed, and cannot be newly raised in reply. *See Microsoft Corp. v. Biscotti, Inc.*, 878 F.3d 1052, 1074-1075 (Fed. Cir. 2017) (“Microsoft’s brief on appeal is far more detailed and contains substantial new arguments regarding why it believes Kenoyer anticipates this limitation of claim 69. But, Microsoft needed to include those arguments in the petition to institute.”); *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1367 (Fed. Cir. 2015) (“We see no error in the Board’s rejection of Ariosa’s reliance, in its Reply submissions, on previously unidentified portions of a prior-art reference to make a meaningfully distinct contention.”); *Yita*, 69 F.4th at 1366-67 (Fed. Cir. 2023). And that makes sense. If a Petitioner could append “at least” to every invalidity theory and thereby reserve the right to add any new theory later, Section 312(a)(3)’s requirement would be meaningless. At the end of the day, Petitioner could have made its argument that Mehta’s general discussion of “provisioning” met this element in the Petition, but it did not.

Petitioner’s new argument also fails on the merits. As an initial matter, Mehta does not actually disclose any provisioning models beyond the four identified above. POR at 48-50. Petitioner points to Mehta’s “extensive disclosures regarding provisioning” but never explains how those purportedly disclose “provisioning models.” Reply, 23-24. Instead, Petitioner just makes the conclusory allegation that “[a] POSITA would therefore understand Mehta to disclose more than the four exemplary models expressly identified in its specification” without explanation or

support.⁹ That is not true. POR,48-50. Therefore even considering Petitioner’s new argument, Mehta only discloses the four identified provisioning models (which do not meet this claim requirement).

Moreover, nothing in Mehta discloses that provisioning in general “correspond[s] to a different set of device capabilities.” Petitioner alleges that “[d]evice capabilities are also considered during Mehta’s provisioning process” and “device capabilities play an important role in Mehta’s provisioning process.” Reply, 24. But the claim requires that provisioning models correspond to device capabilities, which is not the same thing as device capabilities generically “play[ing]” a role in the provisioning process. Petitioner’s argument boils down to a simple assertion that because Mehta recognizes “device capabilities” and “provisioning models,” “[a] POSITA would thus recognize” the possibility of “provisioning models based on device capabilities.” Reply, 25. But obviousness requires more than mere possibility. *Virtek Vision Int’l ULC v. Assembly Guidance Sys., Inc.*, Nos. 2022-1998, 2022-2022, 2024 U.S. App. LEXIS 7185, at *7 (Fed. Cir. Mar. 27, 2024) (“The mere fact that these possible arrangements existed in the prior art does not provide a reason that a skilled artisan would have substituted the one-camera angular direction system in Keitler and Bridges with the two-camera 3D

⁹ Petitioner cites to paragraph 116 of Mr. Wechselberger’s declaration, but that paragraph just contains his conclusion and his statement that Mehta “disclos[es] at least four different types of provisioning models.” Ex1002, ¶116.

coordinate system disclosed in Briggs.”). Mehta does not suggest or teach provisioning models based on device capabilities—indeed, it teaches away from this limitation because the *only* examples of provisioning models in Mehta *cannot* correspond to device capabilities. POR, 46-49.

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

Petitioner argues that “Schlapfer discloses an application descriptor containing ‘attributes’ such as the application’s name, size, and URL” and “the ‘application descriptor’ described in Schlapfer is plainly an example of the ‘provisioning descriptors’ claimed in the ’790 patent.” Reply, 26. Petitioner’s arguments in Reply still do not show that Schlapfer or Mehta disclose “*provisioning* attributes and descriptors.” See POR, 51-52.

Petitioner’s argument appears to be that Schlapfer’s “application” attributes constitute “*provisioning* attributes and descriptors” because the specification of the ’790 patent describes “content descriptors” that Petitioner alleges “corresponds to the claimed ‘provisioning descriptors.’” Reply, 25-26. Petitioner reasons that if a “content descriptor” (which “specifies the name of the content to be provisioned, the size of the content, a location (e.g., a URL) at which the content is stored, and the content type of the content,” EX1001, 13:30-34) constitutes a “provisioning descriptor,” then Schlapfer’s “application descriptor” must also be the claimed “provisioning descriptors.” *Id.* But Petitioner must show that Schlapfer discloses

the claim language, not the specification. And Petitioner has not shown that the '790 patent's "content descriptors" are synonymous with "provisioning descriptors" such that disclosing one necessarily discloses the other. Particularly since Schlapfer's "application" attributes have nothing to do with the only provisioning models disclosed in either Schlapfer or Mehta (Mehta's four provisioning models).

F. A POSITA Would Not Be Motivated To Combine Mehta And Schlapfer

Petitioner has not shown that a POSITA would be motivated to combine Mehta and Schlapfer. Reply, 26-29. First, Petitioner argues that "Mehta and Schlapfer are analogous art" because "Mehta and Schlapfer are directed to distributing digital content to mobile devices over a wireless network." *Id.*, 27. But Schlapfer is fundamentally directed to creating digital applications, while Mehta is concerned with distributing them. POR, 41-43, 52. Petitioner attempts to evade this fact by noting that Schlapfer "expressly discusses the process for provisioning mobile applications," Reply, 28, but it only does so in the context of how to create mobile applications such that they can be provisioned. EX1009, 10-11.

Second and third, Petitioner rehashes its argument that Mehta discloses additional provisioning models beyond the four that it actually discloses. Reply, 28-29. As explained above, Mehta only discloses the four provisioning models (walled, open, dynamic, and static), and those models have nothing to do with the

provisioning disclosed in Schlapfer. POR, 52. Thus a POSITA would not be motivated to combine their teachings.

IV. CONCLUSION

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

Dated: April 26, 2024

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CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that Patent Owner's Sur-Reply consists of 5,539 words, excluding the table of contents, certificate of service, this certificate of compliance, or table of exhibits. The Sur-Reply complies with the type-volume limitation of 5,600 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: April 26, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

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