

Petitioner's Demonstratives

Netflix, Inc. v. VideoLabs, Inc.

U.S. Patent No. 7,233,790

Case: IPR2023-00628

June 27, 2024

Instituted Grounds

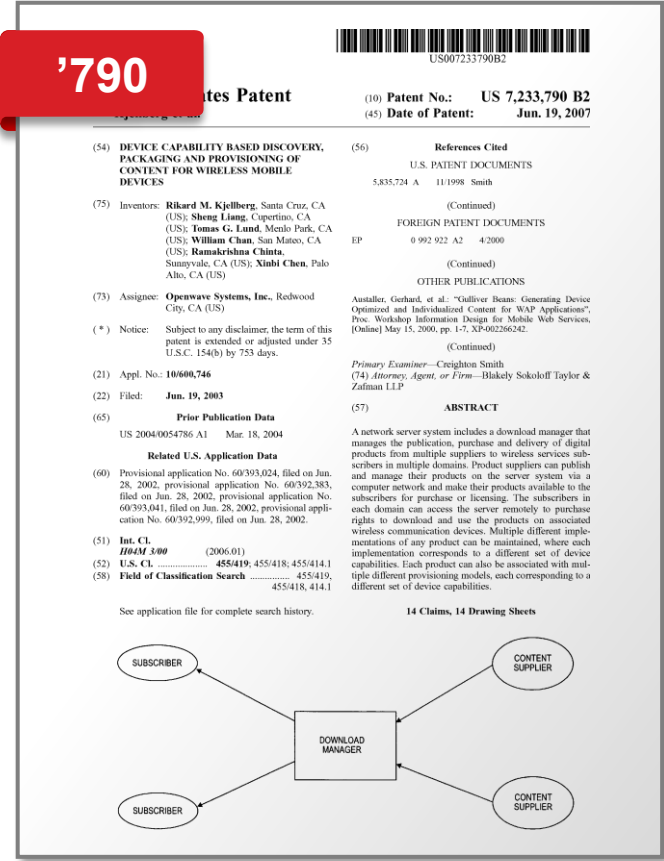
Ground	Challenged Claims	Basis	References
1	1-4, 8-11	§102	<i>Mehta</i>
2	1-14	§103(a)	<i>Mehta, Schlapfer</i>

Pet. at 22

Disputed Issues

- 1 “a plurality of different implementations of at least one of the items of digital content”
- 2 “the product catalog including, in association with each item of content, a reference to each implementation of said item of content”
- 3 “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”
- 4 “selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber”
- 5 “provisioning models corresponding to a different set of device capabilities”
- 6 “a corresponding set of provisioning attributes and descriptors”
- 7 A POSITA would have been motivated to combine *Mehta* and *Schlapfer*

U.S. Patent No. 7,233,790



Ex1001 ('790 Patent)

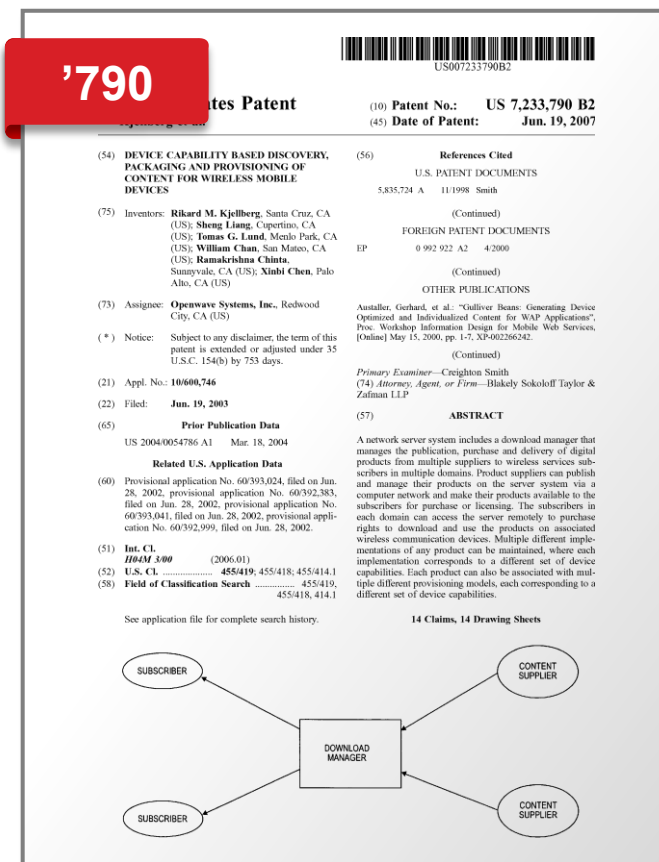
Title:
Device Capability Based Discovery, Packaging and Provisioning of Content for Wireless Mobile Devices

Priority Date:
June 19, 2003

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

POR at 9

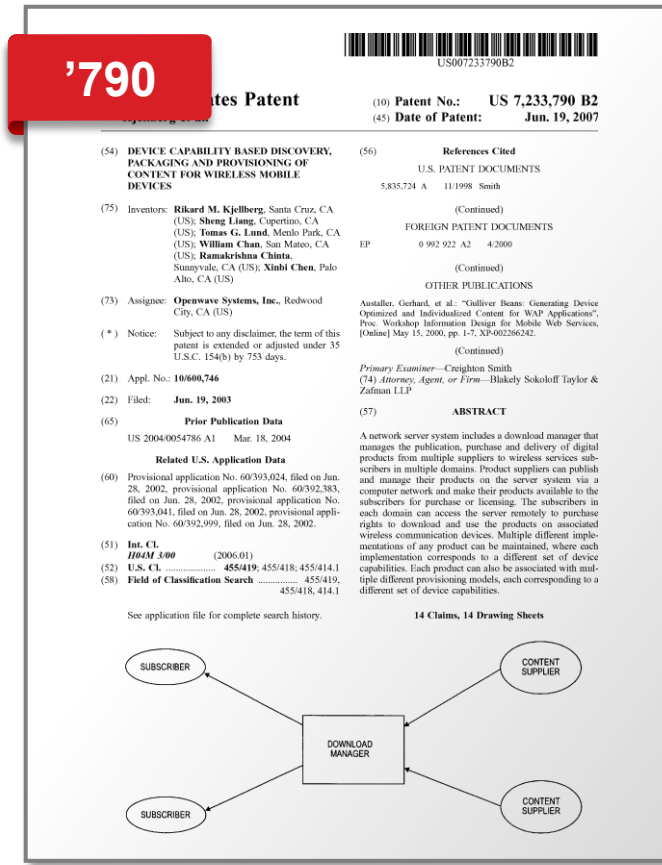
'790 Patent | Alleged Problem | No Central Content Store



images, ring tones, screensavers, wallpapers, etc. Although newer mobile devices often come pre-provisioned with certain digital products when first acquired by the subscriber, it is desirable to allow subscribers to acquire additional digital products for use in their mobile devices as such products become available. While this capability already exists, currently subscribers acquire digital content directly from the content suppliers (typically via the wireless network and the Internet). This process is inconvenient if a subscriber wishes to acquire various different items of digital content from different suppliers, since the subscriber must navigate to the web sites of different suppliers. There-

Ex1001 ('790 Patent) at 1:45-56

'790 Patent | Alleged Problem | Subscriber Devices Need Different Provisioning



From the content supplier's perspective, another impediment to the efficient distribution of digital content is the fact that different mobile devices often require different content packaging formats and provisioning protocols. In order to make a given item of digital content available to multiple mobile devices supporting different provisioning models, a digital content supplier will normally deploy that item of content multiple times, packaging it differently for each of the provisioning models. For example, an image to be

* * *

of those two delivery modes. It is very burdensome for digital content suppliers to have to package and provision the digital content they produce in a manner that is suitable for all of the devices in the marketplace. Moreover, it is difficult for content suppliers to keep up with the constant changes in device capabilities for the many mobile devices in the marketplace. Consequently, there is often a gap

Ex1001 ('790 Patent) at 1:60 – 2:10

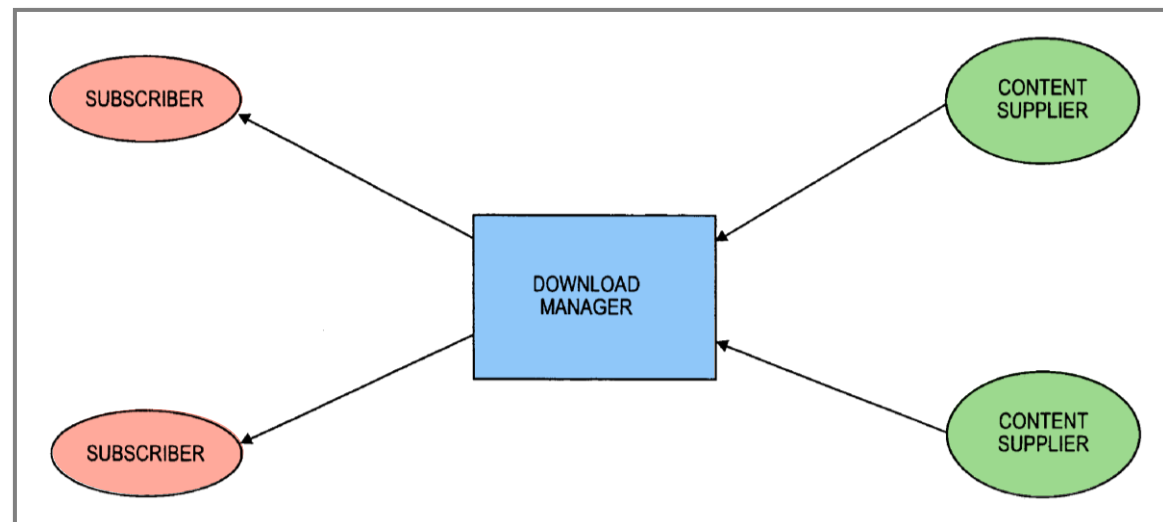
'790 Patent | Disclosed Solution | Download Manager

A system and method for efficiently managing the publication, purchase and delivery of digital content from multiple content suppliers to multiple wireless services subscribers in multiple domains are described below. As used in this

Ex1001 ('790 Patent) at 3:45-48

one or more server computer systems on a network. The server system includes an application server referred to herein as the “download manager”. Digital content suppliers can publish and manage their products using the download manager via a computer network, such as the Internet, and can make their products available to wireless services subscribers through the download manager for purchase or licensing. Subscribers can access the server system via

Ex1001 ('790 Patent) at 3:66 – 4:6



Ex1001 ('790 Patent) at Fig. 1

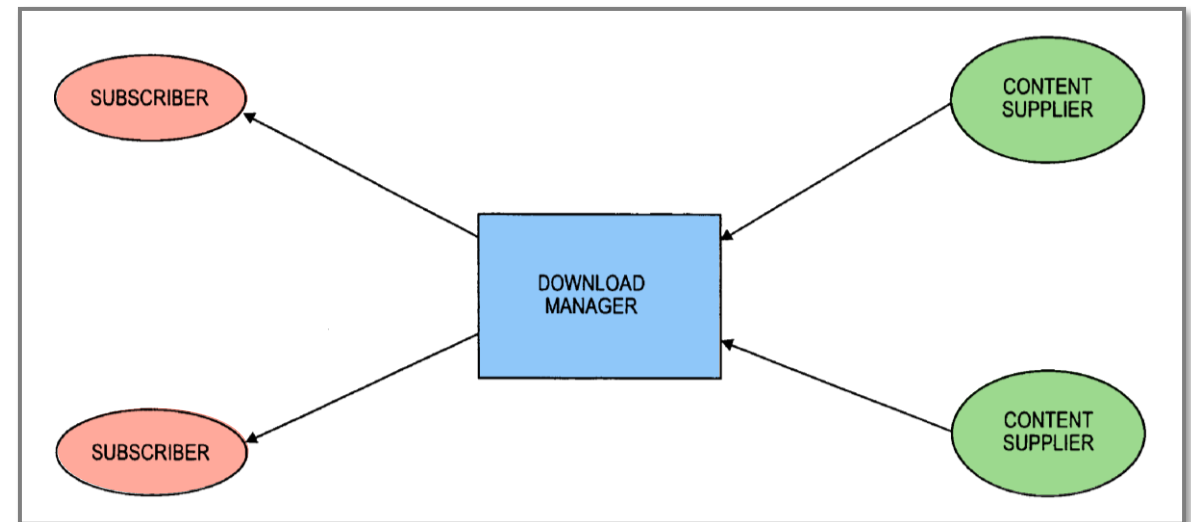
'790 Patent | “items of content” and “implementations”

FIG. 1 illustrates the relationship between the download manager, content suppliers, and wireless services subscribers (users of mobile devices). The download manager 1 acts as an intermediary between multiple content suppliers 2 (e.g., 2A, 2B, etc.) and multiple customers (e.g., 3A, 3B, etc.), e.g., wireless services subscribers, belonging to multiple “domains”. In the supply chain process for distribution of digital content, a content supplier 2 adds a digital product to the set of products managed by the download manager 1 (i.e., products “in the store”). The supplier 2 then associates

Ex1001 ('790 Patent) at 4:9-18

The product catalog 54 contains descriptions of all published items of content (products). Referring to FIG. 5, the catalog 54 includes, for each product entry 56, a reference 58 to at least one implementation 57 of that product. An implementation 57 can be simply a binary file (a “binary”) representing the product. In some cases, however, an imple-

Ex1001 ('790 Patent) at 9:37-42



Ex1001 ('790 Patent) at Fig. 1

'790 Patent | Representative Claim 2

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 ('790 Patent) at Claim 2

1

Mehta Teaches:

“a plurality of different implementations of at least one of the items of digital content”

Mehta

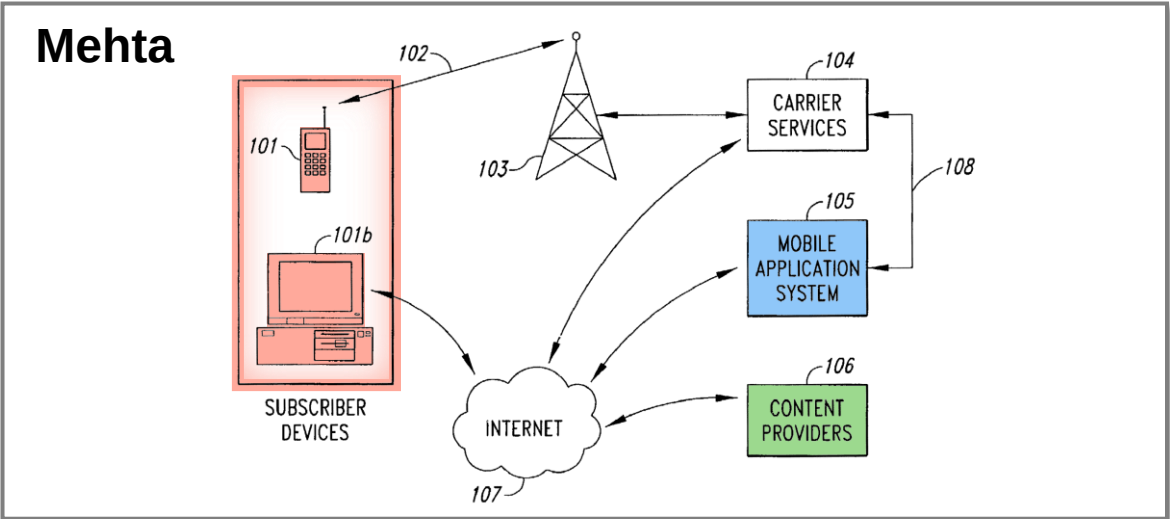
[0005] Embodiments of the present invention provide computer- and network-based methods and systems for maintaining and provisioning wireless applications. Example embodiments provide a Mobile Application System (MAS), which is a collection of interoperating server components that work individually and together in a secure fashion to provide applications, resources, and other content to mobile subscriber devices, such as wireless devices.

Ex1003 (Mehta) at [0005]

[0085] The Device Verifier 602 determines the type and capabilities of the subscriber device from which the request was made and determines whether the device capabilities are sufficient to support a specific application. The capabilities

Ex1003 (Mehta) at [0085]

Mehta



Ex1003 (Mehta) at Fig. 1

application.” Ex. 1003 at [0085]. The MAS analyzes profiles such as “a subscriber profile, a device profile, and an application profile” stored in “a data repository” to determine that a specific application can execute properly on the subscriber device under examination. *Id.* at [0005], [0067], [0099]. When the MAS receives a request

EX1002 (Expert Declaration of Anthony Wechselberger) at ¶ 40

Pet. at 28-29; ID at 14; Reply at 2-11; EX1001 at 9:38-48, cl. 2, Fig. 5; EX1002 ¶¶ 40, 65-66; EX1004 at [0004]-[0005], [0059]-[0061], [0064], [0068], [0085], [0098]-[0099], Figs. 1, 2, 5, 9B-9D; EX1029 at 21:25-22:2, 43:14-24; 47:15-22; 48:1-16; EX2020 ¶ 39.

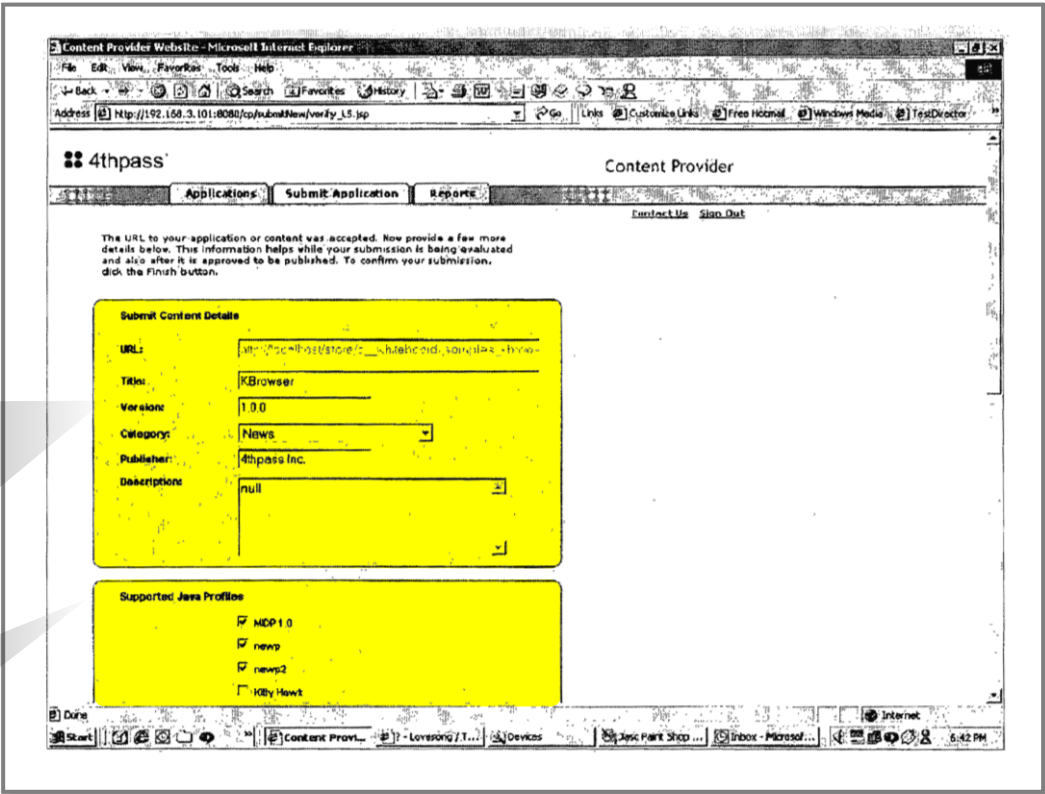
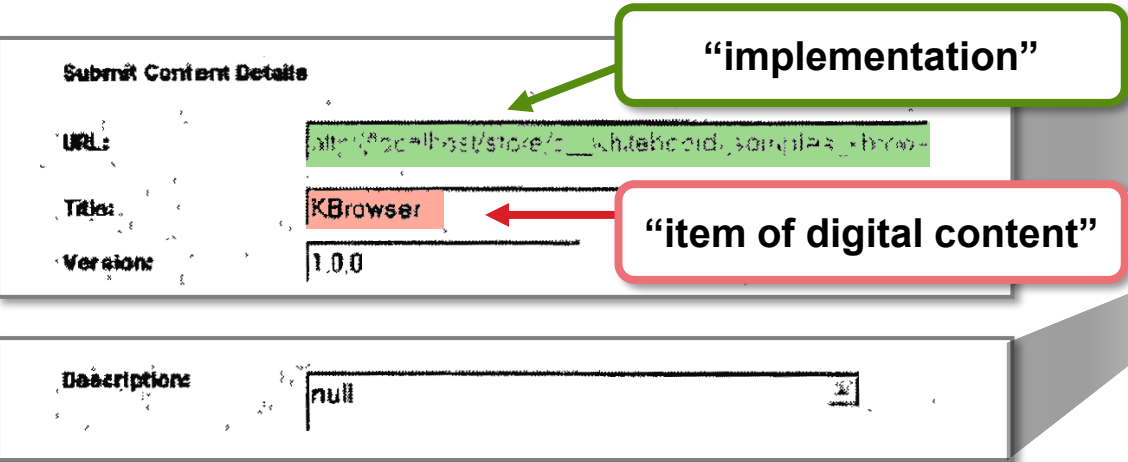
1

Mehta Teaches:

“a plurality of different implementations of at least one of the items of digital content”

[0098] Once the application has been located and inspected for submission, the Content Provider Website 801 preferably requests additional information from the content provide about the application be submitted, which becomes part of an application profile when the application is approved. For example, the content provider may include a

Ex1003 (Mehta) at [0098]



Ex1003 (Mehta) at Fig. 9B

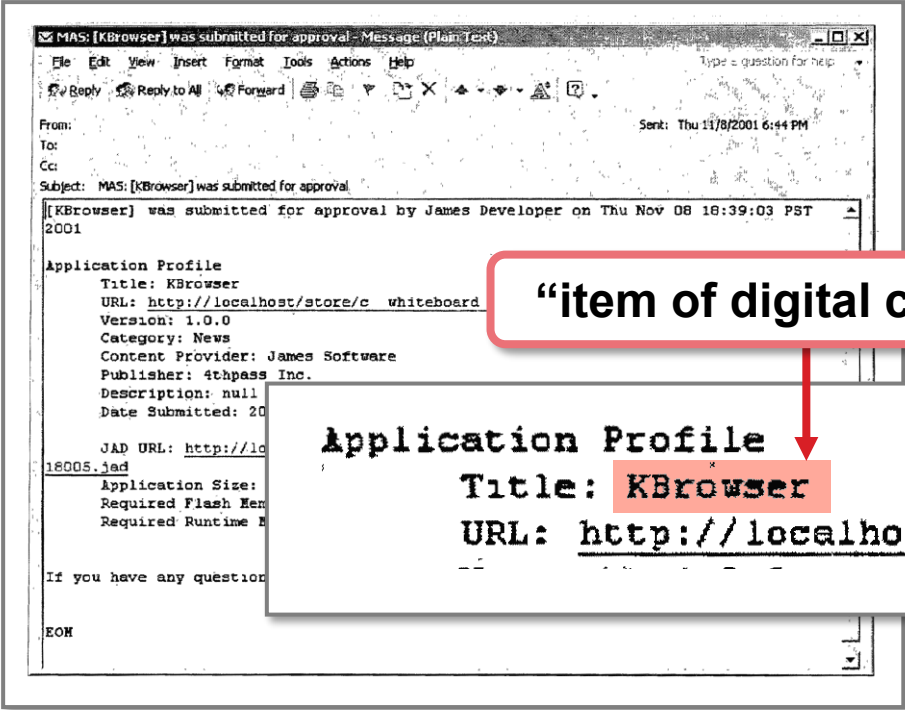
Pet. at 28-29; ID at 14; Reply at 2-11; EX1001 at 9:38-48, cl. 2, Fig. 5; EX1002 ¶¶ 40, 65-66; EX1004 at [0004]-[0005], [0059]-[0061], [0064], [0068], [0085], [0098]-[0099], Figs. 1, 2, 5, 9B-9D; EX1029 at 21:25-22:2, 43:14-24; 47:15-22; 48:1-16; EX2020 ¶ 39.

1

Mehta Teaches:

“a plurality of different implementations of at least one of the items of digital content”

Mehta, Fig. 9D



“item of digital content”

“implementation”

Application Profile
 Title: KBrowser
 URL: http://localhost/store/c_whiteboard_samples_kbrowser_kbrowser_p-18005.jar

ted application. FIG. 9D is an example application submission notification generated by an Administrator. The

EX1003 (Mehta) at [0099]

EX1003 (Mehta) at Fig. 9D

Pet. at 28-29; ID at 14; Reply at 2-11; EX1001 at 9:38-48, cl. 2, Fig. 5; EX1002 ¶¶ 40, 65-66; EX1004 at [0004]-[0005], [0059]-[0061], [0064], [0068], [0085], [0098]-[0099], Figs. 1, 2, 5, 9B-9D; EX1029 at 21:25-22:2, 43:14-24; 47:15-22; 48:1-16; EX2020 ¶ 39.

1

Mehta Teaches:

“a plurality of different implementations of at least one of the items of digital content”

trial use parameters). 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. The content provider may also select a

Ex1003 (Mehta) at [0098]; EX1002 at ¶ 66

Mehta's MAS



Microsoft Word



Microsoft Word

- Functionally equivalent programs
- Same names
- Capable of running on multiple types of devices

1

Mehta Teaches:

“a plurality of different implementations of at least one of the items of digital content”



Dr. Michael Goodrich | Patent Owner’s Expert

are the implementations of Lion King. For 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. The download

EX2020 (Goodrich Declaration) at ¶ 39



Microsoft Word



Microsoft Word

Pet. at 28-29; ID at 14; Reply at 2-11; EX1001 at 9:38-48, cl. 2, Fig. 5; EX1002 ¶¶ 40, 65-66; EX1004 at [0004]-[0005], [0059]-[0061], [0064], [0068], [0085], [0098]-[0099], Figs. 1, 2, 5, 9B-9D; EX1029 at 21:25-22:2, 43:14-24; 47:15-22; 48:1-16; EX2020 ¶ 39.

1

Mehta Teaches:

“a plurality of different implementations of at least one of the items of digital content”



Goodrich

Patent Owner's Expert

PO's Expert agrees Microsoft Word for Windows and Mac would be “functionally equivalent programs” in the context of *Mehta*

Q. So one 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 of the same product.

EX1029 (Goodrich Deposition Transcript) at 43:14-24 (omitting objections)

Pet. at 28-29; ID at 14; Reply at 2-11; EX1001 at 9:38-48, cl. 2, Fig. 5; EX1002 ¶¶ 40, 65-66; EX1004 at [0004]-[0005], [0059]-[0061], [0064], [0068], [0085], [0098]-[0099], Figs. 1, 2, 5, 9B-9D; EX1029 at 21:25-22:2, 43:14-24; 47:15-22; 48:1-16; EX2020 ¶ 39.

1

Mehta Teaches:

“a plurality of different implementations of at least one of the items of digital content”



Goodrich

Patent Owner's Expert

PO's Expert agrees *Mehta's* MAS would support and store both Microsoft Word for Windows and Mac

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 (Goodrich Deposition Transcript) at 47:15-22; 48:5-11 (omitting objections)

Pet. at 28-29; ID at 14; Reply at 2-11; EX1001 at 9:38-48, cl. 2, Fig. 5; EX1002 ¶¶ 40, 65-66; EX1004 at [0004]-[0005], [0059]-[0061], [0064], [0068], [0085], [0098]-[0099], Figs. 1, 2, 5, 9B-9D; EX1029 at 21:25-22:2, 43:14-24; 47:15-22; 48:1-16; EX2020 ¶ 39.

1

Mehta Teaches:

“a plurality of different implementations of at least one of the items of digital content”

'790 Patent, Claim 2

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;

* * *

Ex1001 ('790 Patent) at Claim 2

Submit Content Details

URL:

Title:

Version:

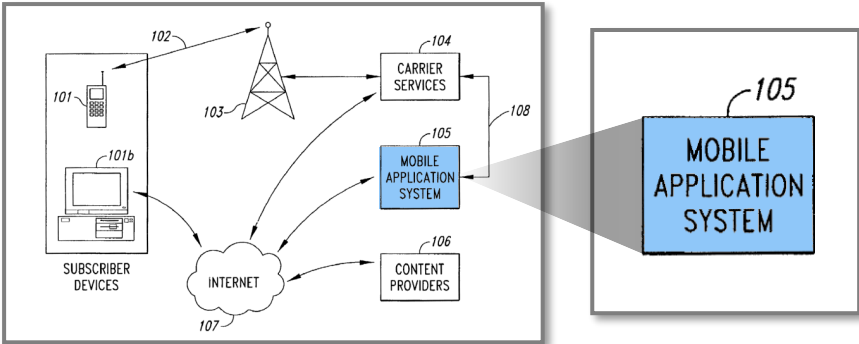
Description:

“implementation”

“item of digital content”

Ex1003 (Mehta) at Fig. 9B

Mehta



Ex1003 (Mehta) at Fig. 1

trial use parameters). 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. The content provider may also select a

“plurality of different implementations”

Ex1003 (Mehta) at [0098]; EX1002 at ¶ 66

Pet. at 28-29; ID at 14; Reply at 2-11; EX1001 at 9:38-48, cl. 2, Fig. 5; EX1002 ¶¶ 40, 65-66; EX1004 at [0004]-[0005], [0059]-[0061], [0064], [0068], [0085], [0098]-[0099], Figs. 1, 2, 5, 9B-9D; EX1029 at 21:25-22:2, 43:14-24; 47:15-22; 48:1-16; EX2020 ¶ 39.

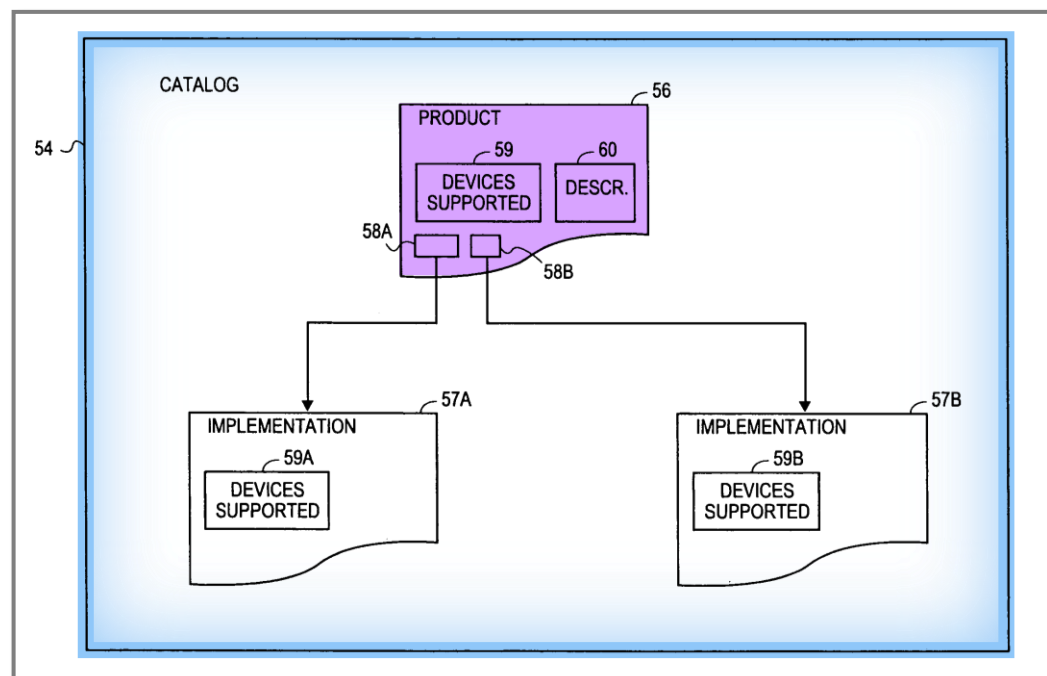
1 Patent Owner Disputes *Mehta*'s “different implementations”

Patent Owner:

Mehta's MAS would list Microsoft Word for Windows and Mac as different products, not different implementations of the same application

The product catalog 54 contains descriptions of all published items of content (products). Referring to FIG. 5, the catalog 54 includes, for each product entry 56, a reference 58 to at least one implementation 57 of that product. An implementation 57 can be simply a binary file (a “binary”) representing the product. In some cases, however, an implementation 57 may represent two or more binaries 61, as shown in FIG. 6. Also as represented in FIG. 5 and FIG. 6, any particular product may have multiple implementations published on the download manager, each of which may be designed for a different specific client device or set of client devices.

Hence, any particular product entry in the catalog 54 can include references to multiple implementations of the product. However, the products shown to any particular sub-



Ex1001 ('790 Patent) at 9:37-51

Ex1001 ('790 Patent) at Fig. 5

1 Patent Owner Improperly Seeks to Import Preferred Embodiment into Claims

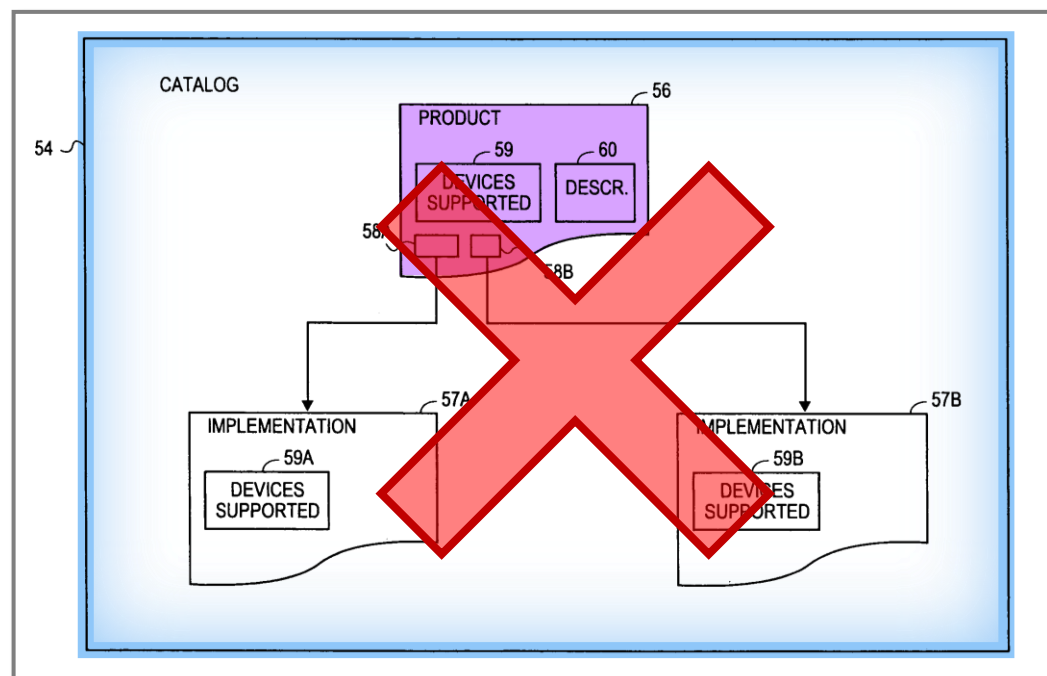
Patent Owner Agrees:

“No express construction for any term is required at this stage” (POR at 10-11)

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;

* * *

Ex1001 ('790 Patent) at Claim 2



Ex1001 ('790 Patent) at Fig. 5

POR at 10-11, 21-23; Pet. at 28-29; ID at 14; Reply at 2-11; EX1001 at 9:37-51, cl. 2, Fig. 5; EX1002 ¶¶ 40, 65-66; EX1004 at [0004]-[0005], [0059]-[0061], [0064], [0068], [0085], [0098]-[0099], Figs. 1, 2, 5, 9B-9D; EX1029 at 21:25-22:2, 43:14-24; 47:15-22; 48:1-16, 54:21-55:10; EX2020 ¶ 39.

1 Patent Owner Disputes *Mehta*'s “different implementations”

Patent Owner:

Mehta discloses multiple “items of content” each with only one application

devices that it designates as operable. Content providers, who wish to develop applications for such wireless devices, must do so for each device they wish to support, and, in potentially in conjunction with the carriers and device manufacturers, must test such applications. Moreover, if a particular software application doesn't operate properly, the carrier must recall all of the physical devices to update the software. Thus, there is an escalating need for deploying software more easily to wireless devices.

EX1003 (Mehta) at [0004]

trial use parameters). 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. The content provider may also select a

Ex1003 (Mehta) at [0098]

2

Mehta Teaches:

“the product catalog including, in association with each item of content, a reference to each implementation of said item of content”

'790 Patent, Claim 2

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;

[0098] Once the application has been located and inspected for submission, the Content Provider Website 801 preferably requests additional information from the content provide about the application be submitted, which becomes part of an application profile when the application is approved. For example, the content provider may include a

* * *

trial use parameters). FIGS. 9B and 9C are an example screen displays of an additional information submission screen of a Content Provider Website. Specifying this infor-

Ex1003 (Mehta) at [0098]

Mehta Teaches:

'790 Patent, Claim 2

Mehta, Fig. 9B



2

Mehta Teaches:

“the product catalog including, in association with each item of content, a reference to each implementation of said item of content”

'790 Patent, Claim 2

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;

Mehta's application profiles are stored in the MAS data repository, which is the claimed “product catalog”

ted application. **FIG. 9D** is an example application submission notification generated by an Administrator. The Administrator uses the information submitted by the content provider (which includes the submitted application) and the data generated during the inspection process to create an application profile, which is stored and maintained in a data repository (e.g., data repository **511** in **FIG. 5**) for use in the verification process of the Provisioning Manager (as described with reference to **FIG. 6**). Content providers may

Ex1003 (Mehta) at [0099]

2

Mehta Teaches:

“the product catalog including, in association with each item of content, a reference to each implementation of said item of content”

'790 Patent, Claim 2

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;

Application profiles are stored in its data repository, which is the claimed “product catalog”



Wechselberger | Petitioner Expert

...ion to find applications that meet criteria specified in the subscriber request. In view of these teachings, 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.

EX1002 (Expert Declaration of Anthony Wechselberger) at ¶ 67

Patent Owner Disputes *Mehta*'s Data Repository Includes a “reference” to “items of content”

Patent Owner: *Mehta* does not store the URL in the application profile or data repository

***Mehta*:** Expressly discloses application profiles are stored in its data repository

ted application. **FIG. 9D** is an example application submission notification generated by an Administrator. The Administrator uses the information submitted by the content provider (which includes the submitted application) and the data generated during the inspection process to create an application profile, which is stored and maintained in a data repository (e.g., data repository 511 in **FIG. 5**) for use in the verification process of the Provisioning Manager (as described with reference to **FIG. 6**). Content providers may

Ex1003 (*Mehta*) at [0099]

3

Mehta Teaches:

“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”

'790 Patent, Claim 2

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.

403. In step 402, the MAS searches a data repository of published applications for those that meet criteria specified in the request, and continues in step 404. Alternatively, in step 403, the MAS determines an initial list. In one embodiment this list is formed from a subscriber's personalized list if one is available, otherwise the MAS supplies a default list. In step 404, the MAS filters this initial list based upon subscriber and device capabilities. For example, 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. In step 405, the MAS adds any system

Ex1003 (Mehta) at [0067]

3

Mehta Teaches:

“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”

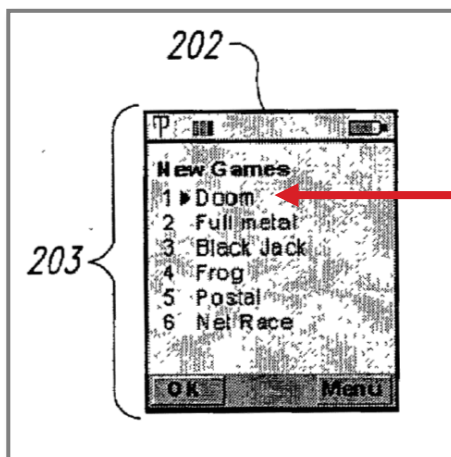
'790 Patent, Claim 2

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.

embodiments, the MAS only lists those applications that are supported by the subscriber's device. This allows the subscriber to avoid the problem of having to explicitly select a compatible application. Other combinations are also con-

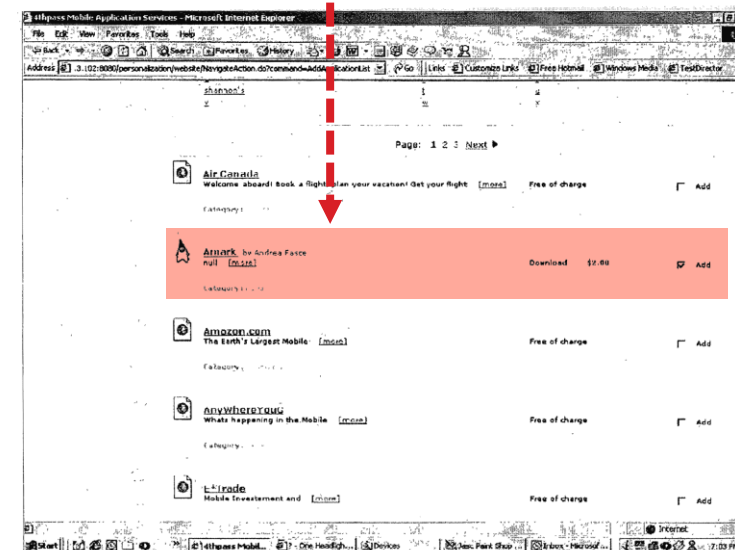
EX1003 (Mehta) at [0117]



EX1003 (Mehta) at Fig. 2 (excerpted)

“single description of each item of digital content”

“single description of each item of digital content”

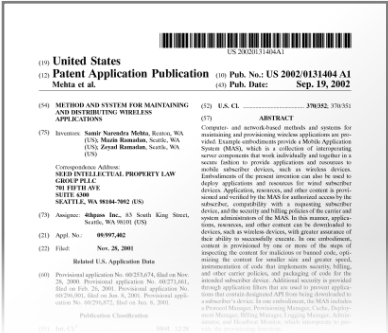


EX1003 (Mehta) at Fig. 11F

3

Mehta Teaches:

“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”



Mehta



Wechselberger
Petitioner Expert

plan supports downloading of the application. In other embodiments, the MAS only lists those applications that are supported by the subscriber’s device. This allows the subscriber to avoid the problem of having to explicitly select a compatible application. Other combinations are also con-

EX1003 (Mehta) at [0117]

In view of the last sentence in the above disclosure of Mehta, a POSITA would have understood that the MAS provides the subscriber with only a single subscriber-appropriate version that will work for the subscriber, so that the subscriber can “avoid the problem of having to explicitly select a compatible application.” Thus,

EX1002 (Expert Declaration of Anthony Wechselberger) at ¶ 77

3

Patent Owner Disputes *Mehta* Disclosing a “single description” of an “item of content”

Patent Owner: *Mehta* is “silent” on a single description for multiple implementations

'790 Patent, Claim 2

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.

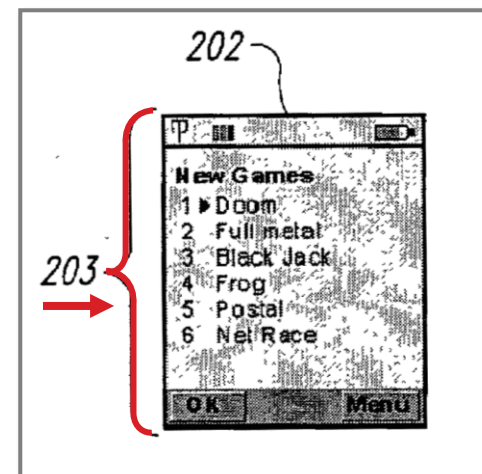
[0018] FIG. 1 is an example block diagram that illustrates how subscribers of wireless services request and download software applications from a Mobile Application System. FIG. 2 is an example block diagram of a Handset Administration Console that operates with a Mobile Application System.

EX1003 (Mehta) at [0018]

applications to be downloaded. Menu 202 is an example menu showing a list of new applications 203 that can be potentially downloaded to the subscriber device 201.

EX1003 (Mehta) at [0063]

“single description of each item of digital content”



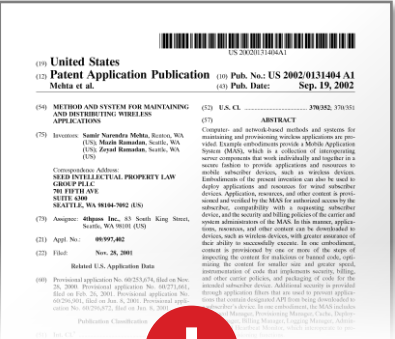
EX1003 (Mehta) at Fig. 2 (excerpted)

3

Mehta and Schlapfer Teach:

“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”

Mehta



Schlapfer

Mehta and Schlapfer would render obvious “providing only a single description of each item of digital content”

device. *Id.* at [0117] (emphasis added). Further, Schlapfer describes that the mobile devices are a family of devices that have a common set of characteristics, such as “a small display . . . and are capable of communicating via a mobile network with limited bandwidth” (Ex. 1009 at 7 (emphasis added)), and have “simple user interfaces, minimum memory budgets . . . and low-bandwidth intermittent network connections” (*id.*, at 5). So it was well known to a POSITA at the time of the alleged

EX1002 (Expert Declaration of Anthony Wechselberger) at ¶ 106

mobile network, “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] would have been obvious to a POSITA at the time of the alleged invention.

EX1002 (Expert Declaration of Anthony Wechselberger) at ¶ 108

3

Mehta and Schlapfer Teach:

“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”



Wechselberger | Petitioner Expert

mobile network, “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] would have been obvious to a POSITA at the time of the alleged invention.

EX1002 (Expert Declaration of Anthony Wechselberger) at ¶ 108

3 ***Schlapfer* Was Publicly Available Prior to the '790 Patent**

- *Schlapfer* is dated July 2001
- *Schlapfer* was distributed to the public on the Internet
- June Munford, an expert in the field of library and information science, found that the URL cited in EP1303153B1, which was filed on August 10, 2002, was referenced on Ericsson's public website by no later than August 3, 2002, before the '790 priority date of June 19, 2003

PDF captured in Appendix ERICSSON01. As Appendix ERICSSON02 was captured as of August 3, 2002, it is my determination that Ericsson was clearly advertising and distributing copies of *Mobile Applications with J2ME* to the public as of August 3, 2002.

EX1030 (Declaration of June Munford) at ¶ 9

3 Patent Owner Disputes Public Availability of *Schlapfer*

Patent Owner:

A different document besides *Schlapfer* could have been located at that URL in August 3, 2002

Declaration of June Munford

7. Appendix ERICSSON01 is a PDF copy of *Mobile Applications with J2ME* was presented on the Ericsson website. The Internet Archive captured this PDF document as of August 3, 2003. In comparing Appendix ERICSSON01 to Exhibit 1009, it is my determination that Exhibit 1009 is a true and correct copy of *Mobile Applications with J2ME*.

EX1030 (Declaration of June Munford) at ¶ 7



[A]rticle posted on a website “open to any internet user” is a printed publication.

Voter Verified, Inc. v. Premier Election Sols., Inc.,
698 F.3d 1374, 1379–81 (Fed. Cir. 2012)

9. Appendix ERICSSON02 is a web page entitled “Ericsson Mobility World: Ericsson Java Community Program” as published on the Ericsson website. This web page contains a URL titled ‘Java white paper’ visible on page 4 of Appendix ERICSSON02 that links to http://www.ericsson.co.th/mobilityworld/Java/White_Paper.pdf - the same PDF captured in Appendix ERICSSON01. As Appendix ERICSSON02 was captured as of August 3, 2002, it is my determination that Ericsson was clearly advertising and distributing copies of *Mobile Applications with J2ME* to the public as of August 3, 2002.

EX1030 (Declaration of June Munford) at ¶ 9

4

Mehta Teaches:

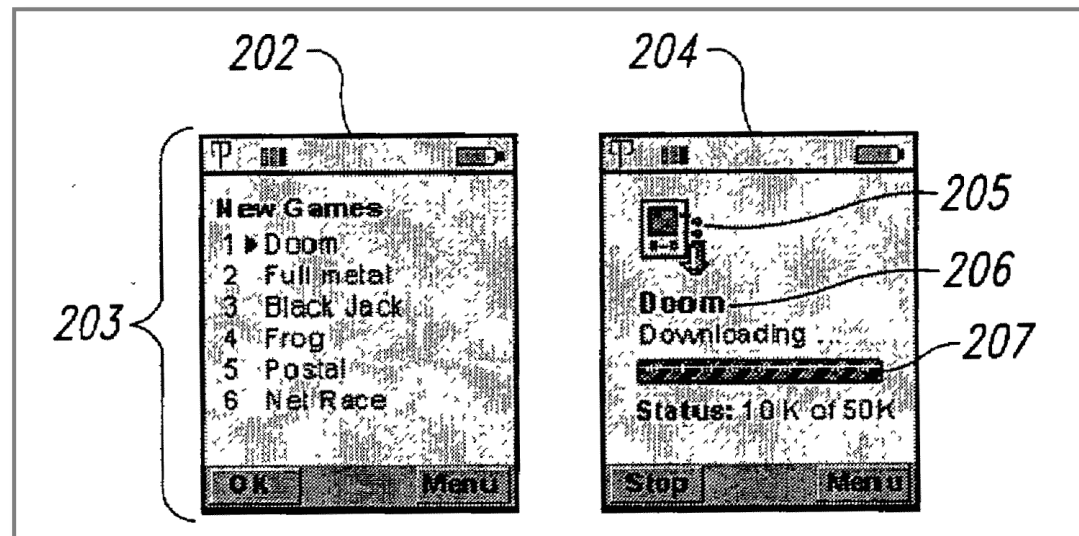
“selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber”

'790 Patent, Claim 4

A method as recited in claim 2, further comprising:

receiving from the subscriber a request for one of the items of digital content in said portion of the product catalog;

selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber;



EX1003 (Mehta) at Fig. 2 (excerpted)

Typically, the MAS is invoked by a subscriber via the command interface (as opposed to the website based interfaced) to process two different types of input requests: discovery of applications and downloading of a requested application. The MAS may also be invoked to process other

EX1003 (Mehta) at [0070]

4

Mehta Teaches:

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

'790 Patent, Claim 4

A method as recited in claim 2, further comprising:

receiving from the subscriber a request for one of the items of digital content in said portion of the product catalog;

selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber;

107 in FIG. 1. Steps 301-408 demonstrate how the MAS handles an incoming request to download an application from a subscriber device, provisions the requested application, and sends the requested application to the subscriber device. Provisioning includes one or more of the steps of

EX1003 (Mehta) at [0064]

ence to FIG. 4. Alternatively, when input request 501 is a request to download a designated application, the MAS retrieves the application, verifies that it is appropriate and permitted for download to that device and user, provisions and packages the requested application, and sends the packaged application to the requesting subscriber device. The

EX1003 (Mehta) at [0070]

4

Mehta Teaches:

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

'790 Patent, Claim 4

A method as recited in claim 2, further comprising:

receiving from the subscriber a request for one of the items of digital content in said portion of the product catalog;

selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber;

Manager. (See step 1504 of FIG. 15.) In summary, 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. In step 1801, the routine identifies the type of

* * *

are supported. In step 1804, the capabilities of the device are compared to the requirements of the requested application by comparing the device and application profiles. In step

EX1003 (Mehta) at [0139]

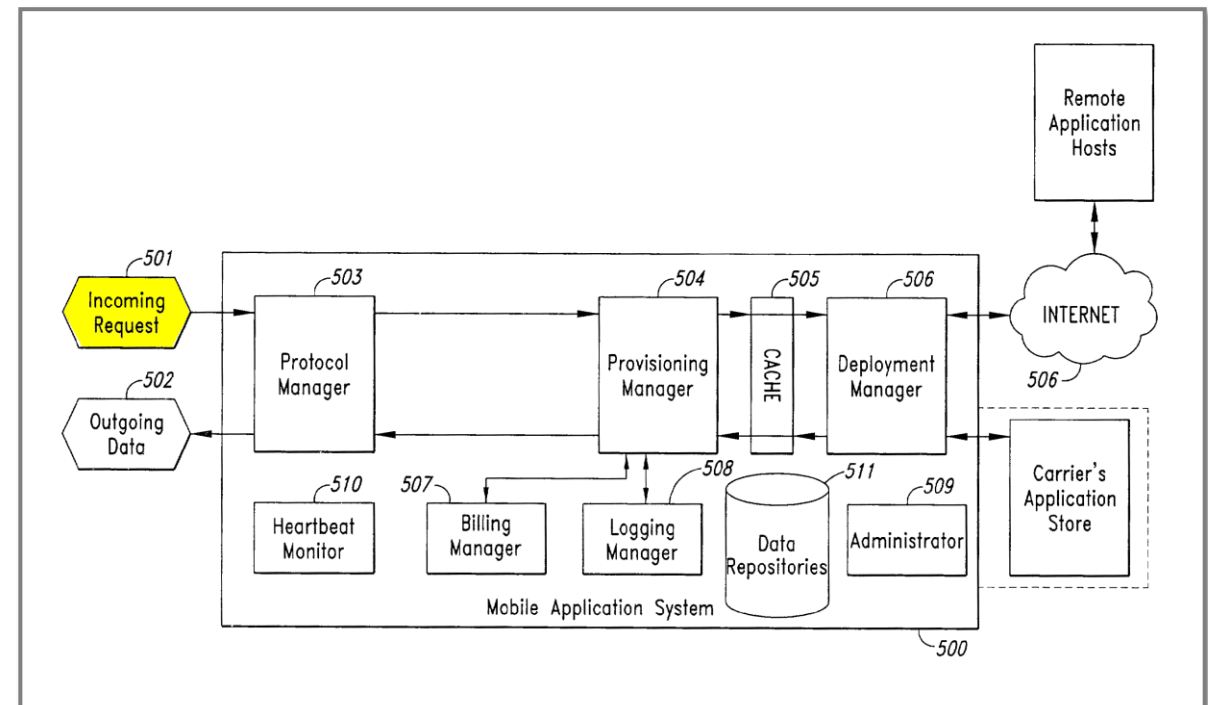
Patent Owner Disputes *Mehta* “selecting an implementation of the requested items of digital content based on device capabilities”

Patent Owner:

Application discovery and application request are not steps MAS takes one after the other

Typically, the MAS is invoked by a subscriber via the command interface (as opposed to the website based interfaced) to process two different types of input requests: discovery of applications and downloading of a requested application. The MAS may also be invoked to process other commands. Also, components of the MAS, for, may be invoked directly, , such as to perform administrative requests to obtain usage information. When input request 501 is a request for application discovery, the MAS compiles and returns a list of applications that are available and appropriate based on the subscriber, application profiles, and device profiles. The steps typically executed by the MAS to accomplish application discovery are described with reference to FIG. 4. Alternatively, when input request 501 is a request to download a designated application, the MAS retrieves the application, verifies that it is appropriate and permitted for download to that device and user, provisions and packages the requested application, and sends the packaged application to the requesting subscriber device. The

EX1003 (Mehta) at [0070]



EX1003 (Mehta) at Fig. 5

5

Mehta Teaches or Suggests:

“provisioning models corresponding to a different set of device capabilities”

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

taining and provisioning wireless applications. Provisioning, as it is discussed herein, is the customizing and distributing of content for a particular use, for example, for use on a particular kind of subscriber device by a particular customer.

EX1003 (Mehta) at [0059]

device. Provisioning includes one or more of the steps of retrieving, inspecting, optimizing, instrumenting code, and packaging, and may include additional steps as needed to ready an application for downloading to a target device. For

EX1003 (Mehta) at [0064]

application.” *Id.*, [0085] (emphasis added), Fig. 6. Mehta then discloses at least four different types of provisioning models (*i.e.*, “walled-garden provisioning,” “open provisioning,” “static provisioning,” and “dynamic provisioning”). *Id.*,

Pet. at 54

Mehta Teaches or Suggests:

“provisioning models corresponding to a different set of device capabilities”

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

[0012] During the provisioning process, the inspected, optimized, or instrumented content can be packaged appropriate to the requesting device. In some other embodiments,

EX1003 (Mehta) at [0012]

or to communicate with other MAS components. The Deployment Manager retrieves a pre-provisioned application if one exists that meets the requests, otherwise retrieves the designated application code and provisions it for the requesting subscriber and device. In one embodiment, pro-

EX1003 (Mehta) at [0015]



Wechselberger | Petitioner Expert

116. In view of these teachings, 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

EX1002 (Expert Declaration of Anthony Wechselberger) at ¶ 116

Pet. at 54; ID at 29-30; Reply at 23-25; EX1002 ¶¶ 59, 115-16; EX1003 at [0008]-[0009], [0011]-[0015], [0059], [0061], [0064], [0071], [0080]-[0081], [0085], [0131], [0135]-[0144], Fig. 6; EX2021, 16:9-13.

Patent Owner Disputes *Mehta* Disclosing Provisioning Models Corresponding to Device Capabilities

Patent Owner:

Mehta's 4 provisioning models "do not correspond to a different set of device capabilities"

Mehta

device. Provisioning includes one or more of the steps of retrieving, inspecting, optimizing, instrumenting code, and packaging, and may include additional steps as needed to ready an application for downloading to a target device. For

EX1003 (*Mehta*) at [0064]

[0012] During the provisioning process, the inspected, optimized, or instrumented content can be packaged appropriate to the requesting device. In some other embodiments,

EX1003 (*Mehta*) at [0012]

application." *Id.*, [0085] (emphasis added), Fig. 6. *Mehta* then discloses at least four different types of provisioning models (*i.e.*, "walled-garden provisioning," "open provisioning," "static provisioning," and "dynamic provisioning"). *Id.*,

Pet. at 54

6 **Mehta and Schlapfer Teach or Suggest:**

“a corresponding set of provisioning attributes and descriptors”

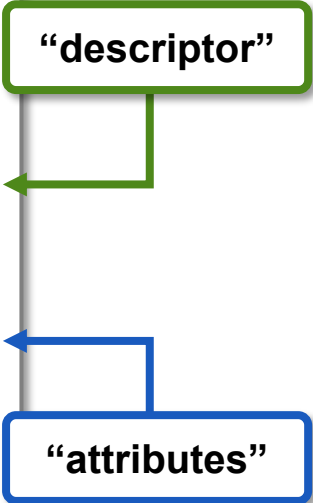
'790 Patent, Claim 5

A method as recited in claim 4, further comprising associating each of the items of digital content in the server system with a plurality of different provisioning models, each of the provisioning models corresponding to a different set of device capabilities, each provisioning model including a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices

'790 Patent

At block 1202 the download manager retrieves the content type of the selected implementation (e.g., MIDlet, EXE file, applet, iAppli, etc.). At block 1203 the download manager 1 selects the appropriate provisioning model available for that implementation, based on the device capabilities of the client device and the content type of the selected implementation. The provisioning manager 28 then creates a content descriptor for the implementation at block 1204, based on the selected provisioning model. The content descriptor 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. The content descriptor is unique to the provisioning handler (protocol) of the selected provisioning model.

The provisioning manager 28 then downloads the content descriptor to the client device at block 1205. The client



EX1001 ('790 Patent) at 13:22-37

Pet. at 55-56; ID at 26, 29-30; Reply at 25-26; EX1001 at 13:22-37; EX1002 ¶ 117-18; EX1003 at [0010], [0064], [0071]; EX1009 at 7, 8, 11, 12, Fig. 2.

Mehta and Schlapfer Teach or Suggest:

“a corresponding set of provisioning attributes and descriptors”

'790 Patent, Claim 5

A method as recited in claim 4, further comprising associating each of the items of digital content in the server system with a plurality of different provisioning models, each of the provisioning models corresponding to a different set of device capabilities, **each provisioning model including a provisioning protocol and a corresponding set of provisioning attributes** and **descriptors** for provisioning digital content in wireless devices

Mehta

[0010] In one embodiment, **content is provisioned by one or more of the steps of** inspecting the content for designated code, optimizing the content for smaller size and greater speed, instrumenting code that implements security, billing, usage, or other carrier policies, and **packaging code for the intended subscriber device.** In one embodiment, the content

EX1003 (Mehta) at [0010]

Mehta and Schlapfer Teach or Suggest:

“a corresponding set of provisioning attributes and descriptors”

'790 Patent, Claim 5

A method as recited in claim 4, further comprising associating each of the items of digital content in the server system with a plurality of different provisioning models, each of the provisioning models corresponding to a different set of device capabilities, **each provisioning model including a provisioning protocol and a corresponding set of provisioning attributes and descriptors** for provisioning digital content in wireless devices

Schlapfer

A so called Over the Air (OTA) User Initiated Provisioning Recommended Practice [16] was pre-released in April 2001 by the Java Community Process (JCP). This recommendation is an appendix to the MIDP specification, and **describes how MIDlet suites can be deployed over the air,** and the functions the devices should provide to support these deployments. The aim of the

EX1009 (Schlapfer) at 11

MIDlets, together with their support classes and resources, e.g. sounds and pictures, are **packed into a jar file.** In fact, a number of MIDlets can be contained in a single jar file. This is called a

* * *

contains a manifest file, which describes the suite. A jar file is optionally accompanied by an **application descriptor.** An **application descriptor** is a text file containing selected information from the manifest file, together with the total size of the jar file. The file extension of this **application descriptor** is .jad, and below are listed its **mandatory attributes:**

- ☐ MIDlet-Name
- ☐ MIDlet-Version
- ☐ MIDlet-Vendor
- ☐ MIDlet-Jar-URL
- ☐ MIDlet-Jar-Size

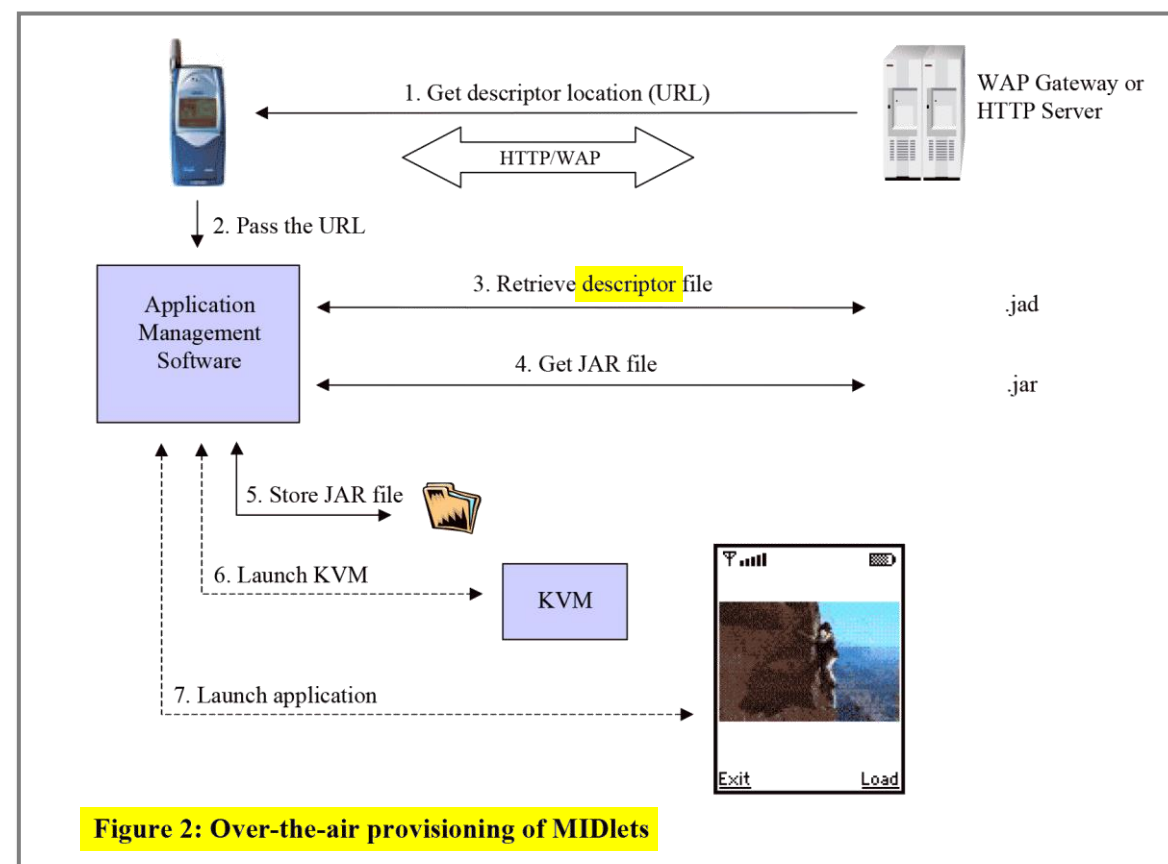
EX1009 (Schlapfer) at 7, 8

6 Mehta and Schlapfer Teach or Suggest:

“a corresponding set of provisioning attributes and descriptors”

'790 Patent, Claim 5

A method as recited in claim 4, further comprising associating each of the items of digital content in the server system with a plurality of different provisioning models, each of the provisioning models corresponding to a different set of device capabilities, each provisioning model including a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices

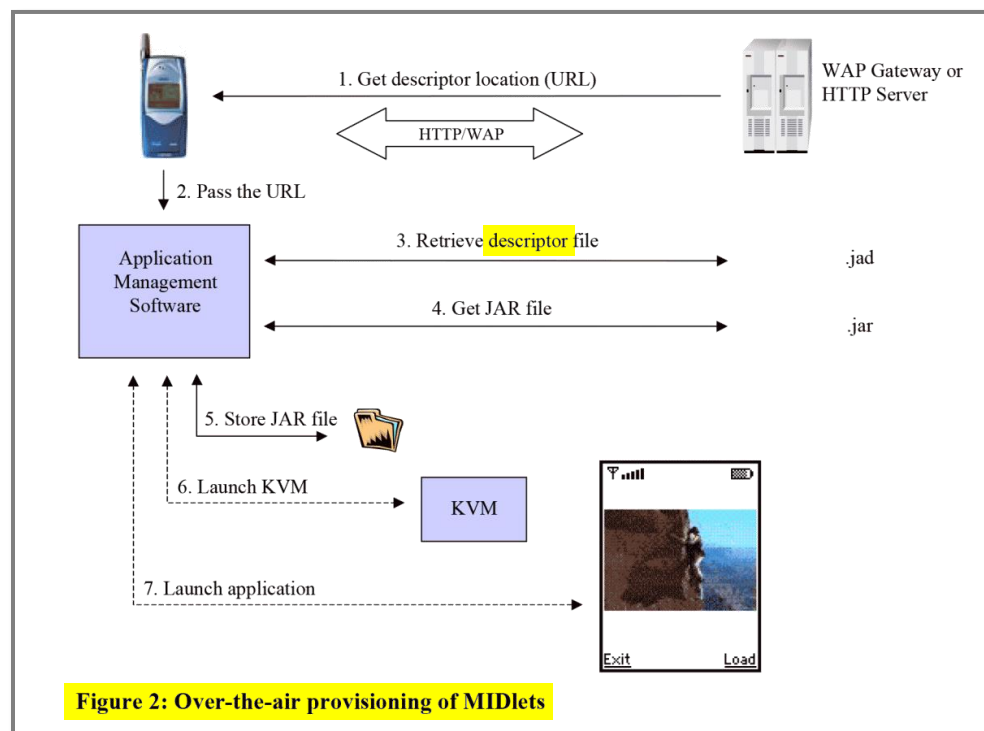


EX1009 (Schlapfer) at Fig. 2

6 Patent Owner Attacks *Schlapfer* Provisioning Attributes and Descriptors

Patent Owner:

Schalpfer's "application" attributes have nothing to do with Mehta's 4 provisioning models



EX1009 (Schlapfer) at Fig. 2

A POSITA Would Have Been Motivated to Combine *Mehta* and *Schlapfer*

- Both references are directed to distributing digital content to mobile devices over a wireless network
- Both recognize resource constraints on mobile devices
- *Schlapfer* explains new developments in Java and *Mehta* describes using Java + J2ME
- *Mehta* discloses various provisioning models, and a POSITA would look to *Schlapfer* for additional ways to provision, including the use of “provisioning attributes and descriptors”

Patent Owner Attacks Combination of *Mehta* and *Schlapfer*

Patent Owner: *Schlapfer* is directed to creating applications while *Mehta* distributes applications



Wechselberger
Petitioner Expert

“Both *Mehta* and *Schlapfer* are directed to distributing digital content to mobile devices over a wireless network.”

EX1002 (Expert Declaration of Anthony Wechselberger) at ¶ 137

Mehta

The Administrator supports the administration of the MAS for content providers, system administrators, customer care representatives, and subscribers. In one embodiment the Administrator implements website based user interfaces for the content provider, administrator, customer care representative, and subscriber. In another embodiment, the Admin-

EX1003 (*Mehta*) at [0015]

Schlapfer

4.4 Provisioning

An often addressed question is the problem of provisioning of MIDlets. As some manufacturers solve the problem today in their Java enabled phones, applications are downloaded from the Internet to a PC and then transferred to the phone using a serial cable. This solution questions the concept of mobility heavily. As in i-Mode, the user should be able to download applications to the mobile device on the go to keep the wireless experience.

A so called Over the Air (OTA) User Initiated Provisioning Recommended Practice [16] was pre-released in April 2001 by the Java Community Process (JCP). This recommendation is an

EX1009 (*Schlapfer*) at 11

POR at 41-43, 52; Pet. at 66-70; ID at 27; Reply at 26-29; EX1001 at 13:22-37; EX1002 ¶¶ 26, 137-41; EX1003 at [0002], [0005], [0010], [0012], [0015], [0064], [0070], [0076], [0080], [0092], [0095], [0097], [0098], [0105], [0106], [0113], [0130], [0133], [0145], [0148], cls. 21, 42, 58, 72, Fig. 2; EX1009 at 3-14; EX1010 at 1:59-63; EX1013 at 6:33-39; EX1014 at [0039].

'790 Patent, Claim 1

1. A method of providing access to content for use on wireless communication devices, the method comprising:
 - receiving and storing a plurality of items of content to be made available for use in wireless communication devices used by a plurality of wireless services subscribers, including receiving a plurality of different implementations of at least one of the items of content, where each implementation of any given item of content corresponds to a different set of device capabilities; and
 - maintaining a product catalog containing a description of the items of content, the product catalog including, in association with each item of content, a reference to each implementation of said item of content.

'790 Patent, Claim 2

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.

'790 Patent, Claim 3

3. A method as recited in claim 2, wherein said selecting a portion of the product catalog comprises:
in response to the request, determining the identity of the wireless device used by the subscriber, wherein 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; and
selecting the portion of the product catalog to be presented to the subscriber based on the identity of the wireless device used by the subscriber.

'790 Patent, Claim 4

4. A method as recited in claim 2, further comprising:
receiving from the subscriber a request for one of the
items of digital content in said portion of the product
catalog;
selecting an implementation of the requested item of
digital content, based on device capabilities of the
wireless device used by the subscriber; and
downloading the selected implementation of the item of
digital content to the wireless device used by the
subscriber.

'790 Patent, Claim 5

5. A method as recited in claim 4, further comprising associating each of the items of digital content in the server system with a plurality of different provisioning models, each of the provisioning models corresponding to a different set of device capabilities, each provisioning model including a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices.

'790 Patent, Claim 6

6. A method as recited in claim 5, further comprising:
receiving from the subscriber a request for one of the
items of digital content in said portion of the product
catalog;
identifying device capabilities of the wireless device used
by the subscriber;
selecting one of a plurality of provisioning models asso-
ciated with the requested item in the server system,
based on the device capabilities of the wireless device
used by the subscriber;
packaging the requested item according to the selected
provisioning model; and
provisioning the requested item in the wireless device
used by the subscriber according to the selected pro-
visioning model.

'790 Patent, Claim 7

7. A method as recited in claim 6, wherein:
said packaging the requested item comprises creating a provisioning descriptor for the requested item according to the selected provisioning model, and associating the provisioning descriptor with the requested item; and
said provisioning the requested item in the wireless device comprises sending the packaged requested item to the wireless device used by the subscriber according to a provisioning protocol associated with the selected provisioning model.

'790 Patent, Claim 8

8. A system comprising:
- a network interface through which to communicate over a communication network; and
 - a download manager to
 - receive and store a plurality of items of content to be made available for use in wireless communication devices used by a plurality of wireless telecommunications subscribers, including receiving a plurality of different implementations of at least one of the items of content, where each implementation of any given item of content corresponds to a different set of device capabilities; and
 - maintain a product catalog containing a description of the items of content, the product catalog including, in association with each item of content, a reference to each implementation of said item of content.

'790 Patent, Claim 9

9. A system comprising:
a processor; and
a storage facility accessible to the processor and containing code which, when executed by the processor, causes the processing system to
receive and store a plurality of items of digital content to be made available for use in wireless communication devices used by a plurality of wireless telecommunications 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;
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;

receive a request from a wireless device used by one of the subscribers;
in response to the request, select 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
cause the selected portion of the product catalog to be presented to the subscriber via a wireless telecommunications 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.

'790 Patent, Claim 10

10. A system as recited in claim 9, wherein selection of said portion of the product catalog comprises:
in response to the request, determining the identity of the wireless device used by the subscriber, wherein 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; and
selecting the portion of the product catalog to be presented to the subscriber based on the identity of the wireless device used by the subscriber.

'790 Patent, Claim 11

11. A system as recited in claim 10, wherein said storage facility further contains code which, when executed by the processor, causes the processing system to:

- receive from the subscriber a request for one of the items of digital content in said portion of the product catalog;
- select an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber; and
- download the selected implementation of the item of digital content to the wireless device used by the subscriber.

'790 Patent, Claim 12

12. A system as recited in claim 11, wherein said storage facility further contains code which, when executed by the processor, causes the processing system to:

associate each of the items of digital content in the server system with a plurality of different provisioning models, each of the provisioning models corresponding to a different set of device capabilities, each of the provisioning models including a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices.

'790 Patent, Claim 13

13. A system as recited in claim 12, wherein said storage facility further contains code which, when executed by the processor, causes the processing system to:

- receive from the subscriber a request for one of the items of digital content in said portion of the product catalog;
- identify device capabilities of the wireless device used by the subscriber;

- select 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;

- package the requested item according to the selected provisioning model; and

- provision the requested item in the wireless device used by the subscriber according to the selected provisioning model.

'790 Patent, Claim 14

14. A system as recited in claim 13, wherein packaging the requested item comprises creating a provisioning descriptor for the requested item according to the selected provisioning model, and associating the provisioning descriptor with the requested item; and

wherein provisioning the requested item in the wireless device comprises sending the packaged requested item to the wireless device used by the subscriber according to a provisioning protocol associated with the selected provisioning model.