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Patent Owner's Presentation
IPR2023-00628
U.S. Patent No. 7,233,790

Netflix, Inc. v. VL Collective IP LLC
June 27, 2024

Statutory Grounds for Challenges

Ground	Assertion	Petitioned Claims
1	Anticipation by Mehta	1-4 and 8-11
2	Obviousness based on Mehta in view of Schlapfer	1-14



'790 Patent

(12) United States Patent Kjellberg et al.		(10) Patent No.: US 7,233,790 B2 (45) Date of Patent: Jun. 19, 2007
(54) DEVICE CAPABILITY BASED DISCOVERY, PACKAGING AND PROVISIONING OF CONTENT FOR WIRELESS MOBILE DEVICES	(56) References Cited U.S. PATENT DOCUMENTS 5,835,724 A 11/1998 Smith (Continued) FOREIGN PATENT DOCUMENTS EP 0 992 922 A2 4/2000 (Continued) OTHER PUBLICATIONS Austaller, Gerhard, et al.: "Gulliver Beans: Generating Device Optimized and Individualized Content For WAP Applications", Proc. Workshop Information Design for Mobile Web Services, [Online] May 15, 2000, pp. 1-7, XP-002266342. (Continued) Primary Examiner—Creighton Smith (74) Attorney, Agent, or Firm—Blakely Sokoloff Taylor & Zafman LLP	
(75) Inventors: Rikard M. Kjellberg , Santa Cruz, CA (US); Sheng Liang , Cupertino, CA (US); Tomas G. Lund , Menlo Park, CA (US); William Chan , San Mateo, CA (US); Ramakrishna Chinta , Sunnyvale, CA (US); Xinbi Chen , Palo Alto, CA (US)		
(73) Assignee: Openwave Systems, Inc. , Redwood City, CA (US)		
(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 753 days.		
(21) Appl. No.: 10/600,746		
(22) Filed: Jun. 19, 2003		
(65) Prior Publication Data US 2004/0054786 A1 Mar. 18, 2004		
Related U.S. Application Data		
(60) Provisional application No. 60/393,024, filed on Jun. 28, 2002, provisional application No. 60/392,383, filed on Jun. 28, 2002, provisional application No. 60/393,041, filed on Jun. 28, 2002, provisional application No. 60/392,999, filed on Jun. 28, 2002.		
(51) Int. Cl. H04M 3/00 (2006.01)		
(52) U.S. Cl. 455/419; 455/418; 455/414.1		
(58) Field of Classification Search 455/419, 455/418, 414.1		
See application file for complete search history.		
14 Claims, 14 Drawing Sheets		
<pre> graph LR SM[SUBSCRIBER] --> DM[DOWNLOAD MANAGER] CS1[CONTENT SUPPLIER] --> DM CS2[CONTENT SUPPLIER] --> DM DM --> SS[SUBSCRIBER] </pre>		

Title: Device Capability Based Discovery, Packaging And Provisioning Of Content For Wireless Mobile Devices

Original Assignee: Openwave Systems, Inc.

Priority Date: Jun. 19, 2003

Petitioned Claims: 1-14

EX1001, '790 Patent, at Title Page; Paper 1, Petition, at 3-4



DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Presentation of Patent Owner

'790 Patent: Claim 2

2. 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;

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



'790 Patent: Claim 2

2. 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;

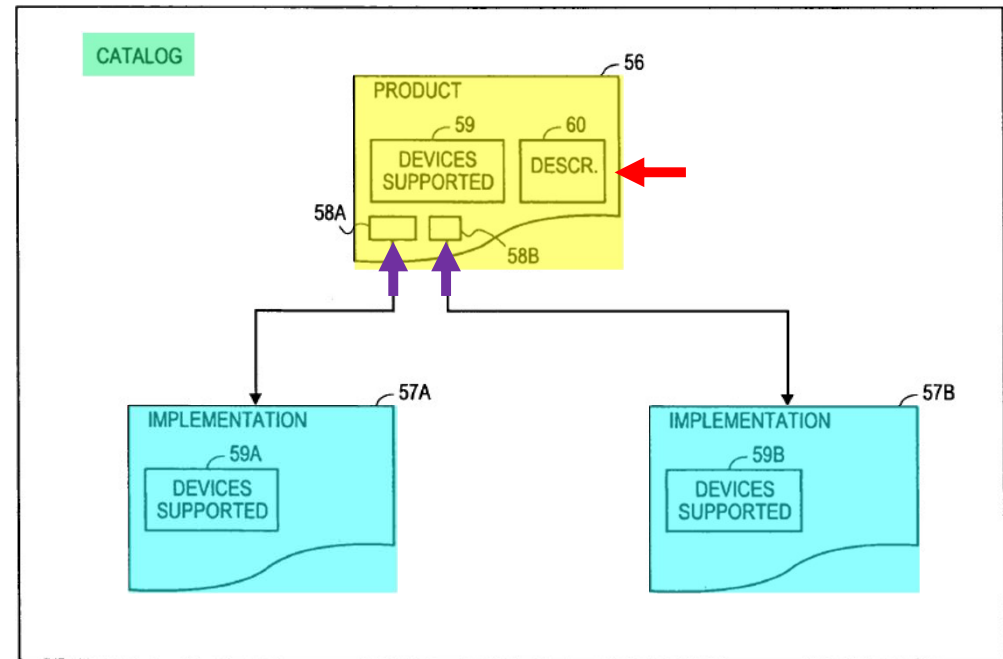


FIG. 5

EX1001, '790 patent, at claim 2; Fig. 5



'790 Patent: Claim 2

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.

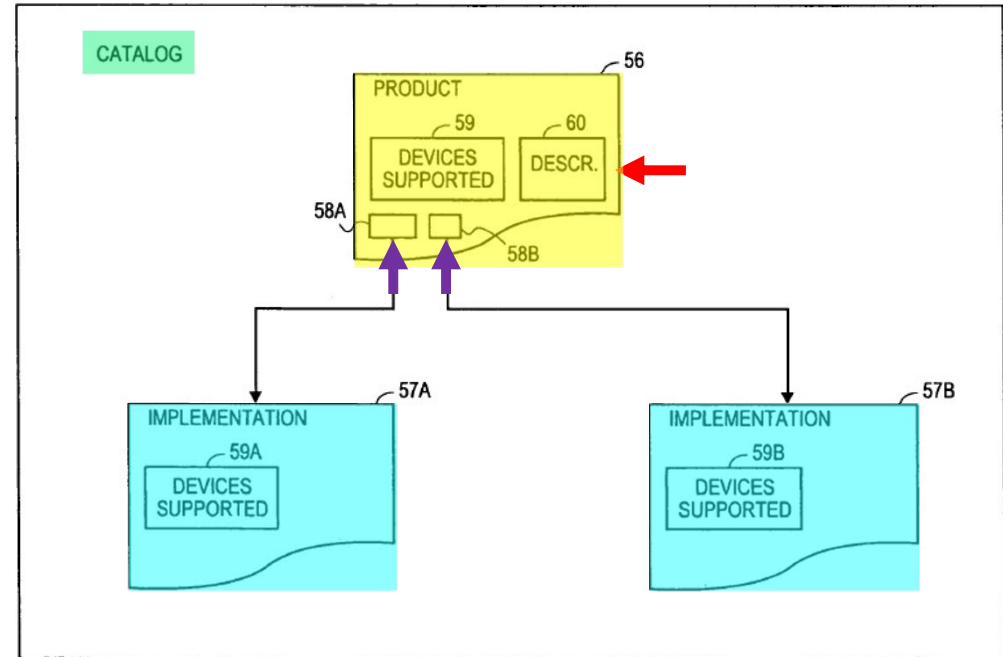


FIG. 5

EX1001, '790 patent, at claim 2; Fig. 5



Ground 1: Anticipation by Mehta

Ground	Assertion	Petitioned Claims
1	Anticipation by Mehta	1-4 and 8-11
2	Obviousness based on Mehta in view of Schlapfer	1-14



Mehta: Overview

(19) United States	
(12) Patent Application Publication	(10) Pub. No.: US 2002/0131404 A1
Mehta et al.	(43) Pub. Date: Sep. 19, 2002
(54) METHOD AND SYSTEM FOR MAINTAINING AND DISTRIBUTING WIRELESS APPLICATIONS	(52) U.S. Cl. 370/352; 370/351
(75) Inventors: Samir Narendra Mehta , Renton, WA (US); Mazin Ramadan , Seattle, WA (US); Zeyad Ramadan , Seattle, WA (US)	(57) ABSTRACT
Correspondence Address: SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 6300 SEATTLE, WA 98104-7092 (US)	Computer- and network-based methods and systems for maintaining and provisioning wireless applications are provided. 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 and resources to mobile subscriber devices, such as wireless devices. Embodiments of the present invention can also be used to deploy applications and resources for wired subscriber devices. Application, resources, and other content is provisioned and verified by the MAS for authorized access by the subscriber, compatibility with a requesting subscriber device, and the security and billing policies of the carrier and system administrators of the MAS. In this manner, applications, resources, and other content can be downloaded to devices, such as wireless devices, with greater assurance of their ability to successfully execute. In one embodiment, content is provisioned by one or more of the steps of inspecting the content for malicious or banned code, optimizing the content for smaller size and greater speed, instrumentation of code that implements security, billing, and other carrier policies, and packaging of code for the intended subscriber device. Additional security is provided through application filters that are used to prevent applications that contain designated API from being downloaded to a subscriber's device. In one embodiment, the MAS includes a Protocol Manager, Provisioning Manager, Cache, Deployment Manager, Billing Manager, Logging Manager, Administrator, and Heartbeat Monitor, which interoperate to provide the provisioning functions.
(73) Assignee: 4thpass Inc. , 83 South King Street, Seattle, WA 98101 (US)	
(21) Appl. No.: 09/997,402	
(22) Filed: Nov. 28, 2001	
Related U.S. Application Data	
(60) Provisional application No. 60/253,674, filed on Nov. 28, 2000. Provisional application No. 60/271,661, filed on Feb. 26, 2001. Provisional application No. 60/296,901, filed on Jun. 8, 2001. Provisional application No. 60/296,872, filed on Jun. 8, 2001.	
Publication Classification	
(51) Int. Cl. ⁷	H04L 12/28

EX1003, Mehta, at Title Page



Mehta: Overview

[0003] 2. Background Information

[0004] Today, wireless devices have become prolific in many communities of the world. Devices such as wireless phones, handsets, personal information managers, electronic organizers, personal digital assistants, portable e-mail machines, game machines, and other devices are used by subscribers of telephone carriers to add convenience to our lives. However, the software used on such devices and the mechanisms for deploying such software to these devices are arcane. Typically, a customer, for example, of a cellular phone service, must bring the cellular phone into a vendor of the cellular phone service to have new or updated service software or capabilities loaded onto the phone. In addition, even changes to a customer's subscription are processed on location or by calling up a customer service representative.

Furthermore, because each carrier is physically responsible for distributing services and applications, each carrier must test services and applications it wishes to offer on the 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, ¶0004; Paper 24, POR, at 18-19



Mehta: Overview

- (19) **United States**
 (12) **Patent Application Publication** (10) **Pub. No.: US 2002/0131404 A1**
Mehta et al. (43) **Pub. Date: Sep. 19, 2002**
- (54) **METHOD AND SYSTEM FOR MAINTAINING AND DISTRIBUTING WIRELESS APPLICATIONS**
- (75) Inventors: **Samir Narendra Mehta**, Renton, WA (US); **Mazin Ramadan**, Seattle, WA (US); **Zeyad Ramadan**, Seattle, WA (US)
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- (73) Assignee: **4thpass Inc.**, 83 South King Street, Seattle, WA 98101 (US)
- (21) Appl. No.: **09/997,402**
- (22) Filed: **Nov. 28, 2001**
- Related U.S. Application Data**
- (60) Provisional application No. 60/253,674, filed on Nov. 28, 2000. Provisional application No. 60/271,661, filed on Feb. 26, 2001. Provisional application No. 60/296,901, filed on Jun. 8, 2001. Provisional application No. 60/296,872, filed on Jun. 8, 2001.
- Publication Classification**
- (51) **Int. Cl.⁷ H04L 12/28**
- (52) **U.S. Cl. 370/352; 370/351**
- (57) **ABSTRACT**
 Computer- and network-based methods and systems for maintaining and provisioning wireless applications are provided. 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 and resources to mobile subscriber devices, such as wireless devices. Embodiments of the present invention can also be used to deploy applications and resources for wired subscriber devices. Application, resources, and other content is provisioned and verified by the MAS for authorized access by the subscriber, compatibility with a requesting subscriber device, and the security and billing policies of the carrier and system administrators of the MAS. In this manner, applications, resources, and other content can be downloaded to devices, such as wireless devices, with greater assurance of their ability to successfully execute. In one embodiment, content is provisioned by one or more of the steps of inspecting the content for malicious or banned code, optimizing the content for smaller size and greater speed, instrumentation of code that implements security, billing, and other carrier policies, and packaging of code for the intended subscriber device. Additional security is provided through application filters that are used to prevent applications that contain designated API from being downloaded to a subscriber's device. In one embodiment, the MAS includes a Protocol Manager, Provisioning Manager, Cache, Deployment Manager, Billing Manager, Logging Manager, Administrator, and Heartbeat Monitor, which interoperate to provide the provisioning functions.

EX1003, Mehta, at Fig. 9a

BRIEF SUMMARY OF THE INVENTION

[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. Embodiments of the present invention can also be used to deploy applications and other content for wired subscriber devices as well. Application, resources, and other content is provisioned and verified by the MAS for authorized access by the subscriber, compatibility with a requesting subscriber device, and/or compliance with security and billing policies of the carrier and system administrators of the MAS. In this manner, applications, resources, and other content can be downloaded to devices, such as wireless devices, with greater assurance of their ability to successfully execute.

EX1003, Mehta, ¶0005; Paper 24, POR, at 8



DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Presentation of Patent Owner

Mehta Does Not Disclose Each Element of the '790 Patent

Missing Claim Elements	Claims
“a plurality of items of digital content” and “a plurality of different <i>implementations of at least one of the items of digital content</i> ”	1-4 and 8-11
“maintain a product catalog,” with “the product catalog includes, in association with each item of digital content, a reference to each implementation of said item of digital content.”	1-4 and 8-11
“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 / a] number of implementations [that are available] [for / of] each said item.”	1-4 and 8-11
“select[ing] an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber”	4, 11



Mehta Does Not Disclose Each Element of the '790 Patent

Missing Claim Elements	Claims
“a plurality of items of digital content” and “a plurality of different implementations of at least one of the items of digital content”	1-4 and 8-11
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“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 / a] number of implementations [that are available] [for / of] each said item.”	1-4 and 8-11
“select[ing] an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber”	4, 11



The '790 Patent Requires Both a “Plurality of Items of Digital Content” and “a Plurality of Different Implementations of at Least One of the Items of Content”

2. 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;

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



The “Plurality of Different Implementations” Must Be *of* “One of the Items of Content”

2. 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;

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



The '790 Patent Requires Both a “Plurality of Items of Digital Content” and “a Plurality of Different Implementations” of an Item of Content

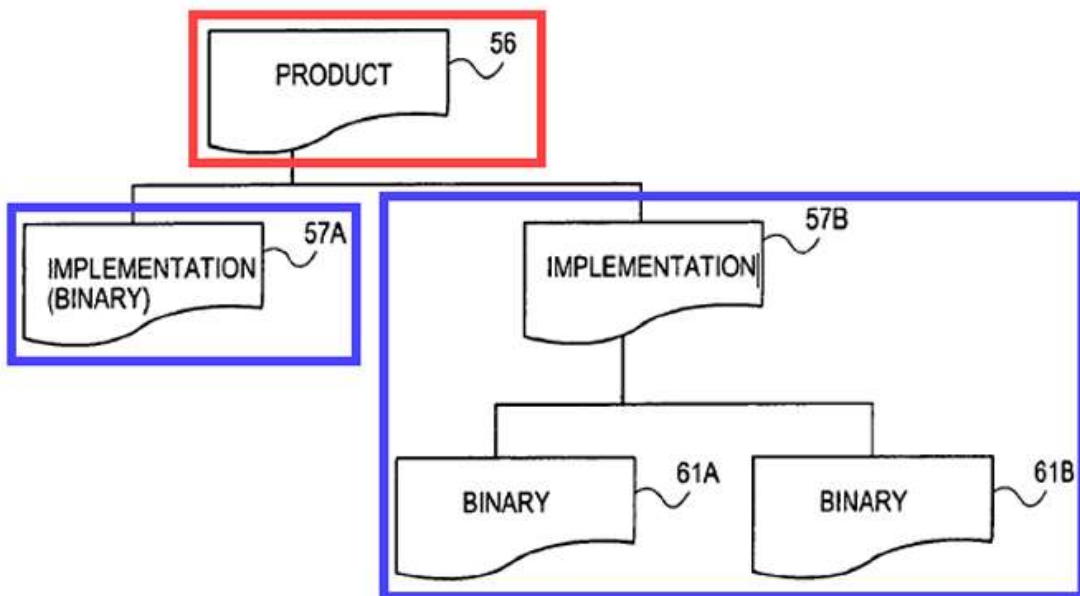


FIG. 6

EX1001, '790 patent, Fig. 6; Paper 24, POR, at 15.

FIG. 6 shows the relationship between a product and its implementations;

EX1001, '790 patent, 3:21-22; Paper 24, POR, at 14

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.

EX1001, '790 patent, at 9:37-48; Paper 24, POR, at 14

The '790 Patent Requires Both a “Plurality of Items of Digital Content” and “a Plurality of Different Implementations” *of* an Item of Content

Initially, at block 801 the download manager 1 receives inputs from a product supplier defining a product and one or *more implementations of that product*.

EX1001, '790 patent, at 11:50-52 (emphasis added); Paper 24, POR, at 15

At block 803 the download manager 1 stores *the product definition, the implementations*, and a list of all of the supported devices and provisioning protocols.

EX1001, '790 patent, at 11:56-59 (emphasis added); Paper 24, POR, at 15-16

When a product is submitted to the download manager 1 by a supplier, the supplier specifies which devices are supported by each *implementation of the product*.

EX1001, '790 patent, at 12:59-61 (emphasis added); Paper 24, POR, at 16

The prior art fails to disclose a method and system of accessing content on a wireless communication device, that specifically includes *receiving and storing a plurality of different implementations of the items of content*.

EX1004, Notice of Allowance, at 43 (emphasis in original); Paper 24, POR, at 16



Petitioner's Expert Agrees That the Claims Requires Both “Items of Digital Content” and “Implementations of at Least One of the Items of Content”

Each independent claim of the '790 patent requires maintaining a product catalog that includes a description of multiple items of content and references to different versions of each item of content, where each version corresponds to a different set of device capabilities.

EX1002, Wechselberger decl., ¶51; Paper 24, POR at 15

Q. Okay. So the claims of the '790 patent require, one, multiple items of content and, two, that at least one item of content has multiple different versions?

A. Yes.

EX2021, Wechselberger dep., at 60:6-11; Paper 24, POR at 15



The '790 Patent Requires Both a “Plurality of Items of Digital Content” and “a Plurality of Different Implementations of at Least One of the Items of Content”

2. 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;

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.

Paper 24, POPR, at 21-22



The Petition's Inconsistent Mapping: Items of Content

What does the Petition map to “Items of Content”?



The Petition's Inconsistent Mapping: Items of Content

What does the Petition map to “Items of Content”? Applications

subscriber devices.” *Id.*, [0068]. The applications received by the MAS
corresponds to “a plurality of items of content” of claim 1. This is in perfect

Paper 1, Pet., at 27; Paper 24, POR, at 16

Q. You map the 790 patent's plurality of items of content
to applications in Mehta, right?

A. Yes, that's what I'm mapping.

EX2021, Wechselberger dep., at 71:6-8; Paper 24, POR at 16



The Petition's Inconsistent Mapping: Implementations

What does the Petition map to “Items of Content”? **Applications**

What does the Petition map to “Implementations” of the “Items of Content”?



The Petition's Inconsistent Mapping: Implementations

What does the Petition map to “Items of Content”? Applications

What does the Petition map to “Implementations” of the “Items of Content”? Applications

Mehta discloses that the MAS “receive[s] applications from content providers and carrier services” (Ex. 1003, [0068]) and “store[s] and support[s] 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” (*id.*, [0098]) (emphasis added). The MAS receives, stores and supports functionally equivalent programs capable of running on multiple kinds of devices because each program corresponds to a different device having different device capabilities (*e.g.*, written using different languages). *Id.*, [0098]. Further, Mehta describes that “[t]he device capability is also examined to determine whether the requested application can be run satisfactorily on the subscriber device.” *Id.*, [0064]; Ex. 1002, ¶ 66. For these reasons, Mehta expressly discloses element 1[a][2].

Paper 1, Pet., at 29; Paper 24, POR, at 16



The Petition's Inconsistent Mapping: Implementations

“Here, given Petitioner’s unexplained inconsistent arguments and conflicting theories regarding the identity of the recited ‘instant voice message’ in Zydney within its analysis of independent claims 1 and 40, as well as across their challenged dependent claims, the Petition lacks clarity regarding precisely which element or portion of Zydney Petitioner is alleging discloses, teaches, or suggests the ‘instant voice message’ of the challenged claims. The Petition, therefore, fails to ‘specify where each element of the claim is found in’ Zydney for independent claims 1 and 40 and dependent claims 3, 5, 6, 9, 42, 43, and 46—in violation of 37 C.F.R. § 42.104(b)(4). In addition, more generally, the Petition fails to identify and explain adequately the reasoning and evidence that supports its obviousness assertions, as 35 U.S.C. § 312(a)(3), 37 C.F.R. § 42.22(a)(2), and 37 C.F.R. § 42.104(b)(5) require.”

Facebook, Inc. v. Uniloc Usa, Inc., No. IPR2017-01523, 2017 WL 6034646, at *8 (P.T.A.B. Dec. 4, 2017); Paper 24, POR, at 16



Mehta Does Not Disclose Applications With Multiple Implementations

Content providers, who wish to develop applications for such wireless devices, must do so for each device they wish to support, and, in [sic] potentially in conjunction with the carriers and device manufacturers, must test such applications

EX1003, Mehta, ¶0004; Paper 24, POR, at 18-19

These components inter-operate to receive applications from content providers and carrier services, to provision them for delivery to the subscriber devices, such as those shown in FIG. 1, and to process MAS commands.

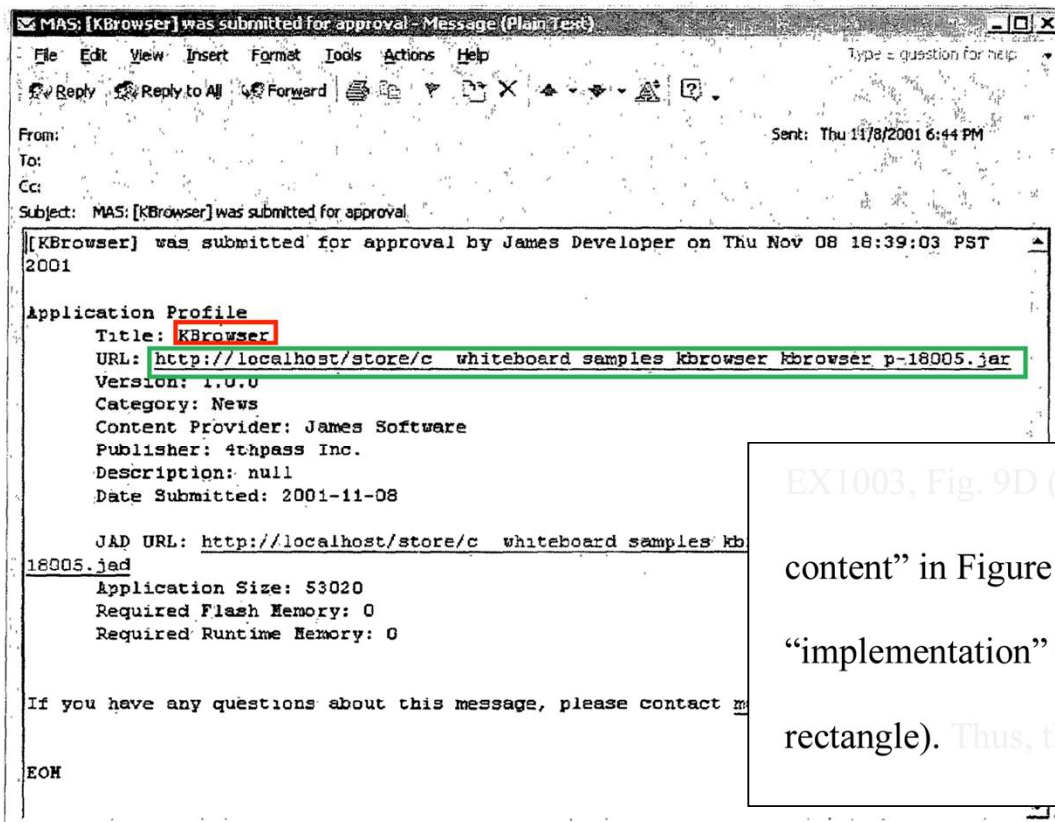
EX1003, Mehta, ¶0068; Paper 24, POR, at 18

[T]he MAS may analyze various profiles, for example a subscriber profile, a device profile, and an application profile to determine whether the subscriber is authorized to use the application and whether the application's needs, as reflected in the application profile, are met by the device, as reflected in the device profile.

EX1003, Mehta, ¶0067; Paper 24, POR, at 19



Mehta Does Not Disclose Applications With Multiple Implementations



EX1003, Fig. 9D (annotated). As depicted above, the claimed “item of digital content” in Figure 9D is “Kbrowser” (in the red rectangle), and the claimed “implementation” would be the .jar file of “Kbrowser” (at the URL in the green rectangle). Thus, the Petition’s mapping does not point to the same application to

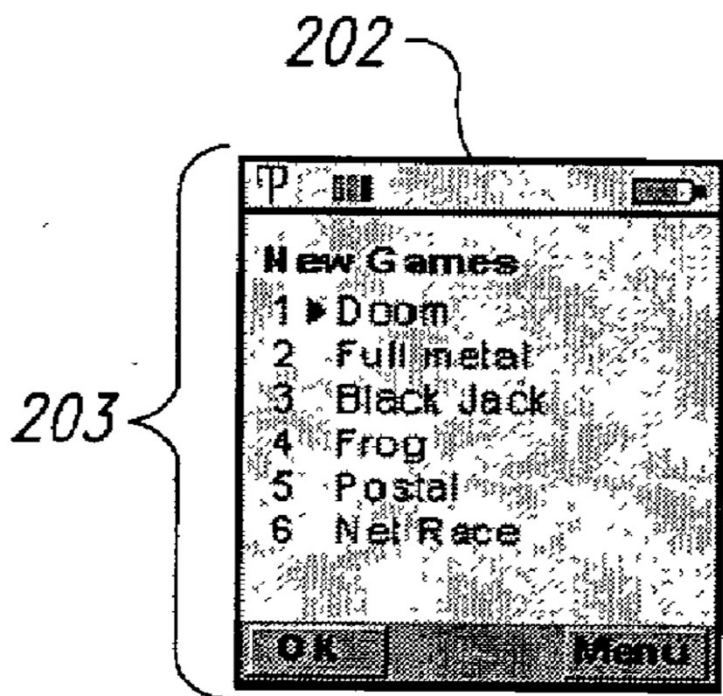
Fig. 9D

EX1003, Mehta, at Fig. 9D; Paper 28, Reply, at 6

Paper 28, Reply, at 6



Mehta Does Not Disclose Applications With Multiple Implementations



EX1003, Mehta, at Fig. 2;
Paper 31, Sur-Reply, at 4-5

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

Paper 28, Reply, at 5; Paper 24, POR, at 3

Petitioner’s “Functionally Equivalent” Argument Is Wrong

multiple kinds of devices.” *Id.* (emphasis added). MAS’s ability to store “[f]unctionally equivalent programs having the same name” demonstrates that Mehta teaches the claimed “plurality of different implementations of at least one of the items of digital content.” *See* EX1002, ¶66.

Paper 28, Reply, at 7



Mehta Discloses “Functionally Equivalent” Programs, Not Multiple Implementations of Programs

[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 name and a short description of the application, a list of supported Java profiles (which are compared with device profiles to determine devices capable of running the application, the language in which the application was written, and billing information such as a suggested sales price and

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 subscriber category to which the submitted application belongs, suggest a price, list a Java profile, specify memory requirements, particular compatible devices, etc. In one embodiment, the content providers selections are considered recommendations that can be overwritten through the Administration Website 802.

EX1003, Mehta, ¶0098; Paper 24, POR, at 21-23;
Paper 31, Sur-Reply, at 5-6



Mehta Discloses “Functionally Equivalent” Programs, Not Multiple Implementations of Programs

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

Q. Did you say sure?

A. I agreed, yes. I said sure.

EX2021, Wechselberger dep., at 69:6-11 (objection omitted);
Paper 24, POR, at 22-23



Mehta Discloses “Functionally Equivalent” Programs, Not Multiple Implementations of Programs

Q. So let me understand this. 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. Yes, in this example it would. And it 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, Goodrich dep., at 47:15-48:4 (attorney objection omitted);
Paper 31, Sur-Reply, at 6-7



Mehta Discloses “Functionally Equivalent” Programs, Not Multiple Implementations of Programs

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. Indeed, I think it would be possible, but they would not be considered different implementations of the same product. They would just, again, in this flat database, you list it 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, Goodrich dep., 48:5-20 (objection omitted);
Paper 31, Sur-Reply, at 6-7



Mehta Discloses “Functionally Equivalent” Programs, Not Multiple Implementations of Programs

Q. Going back to your Lion King example, would your opinion be that the .MOV version of Lion King would be functionally equivalent to the .MP3 version of Lion King?

A. I would answer that the same way I did with respect to Microsoft Word. Functionally equivalent is a broader concept than having different implementations for the same product. Hence, for the Lion King example, a .MP3 and a .MOV are different implementations of the same product. They’re also functionally equivalent, but functionally equivalent is broader. Hence, *when Mehta is disclosing functionally equivalent, it is not referring to it as different 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.*

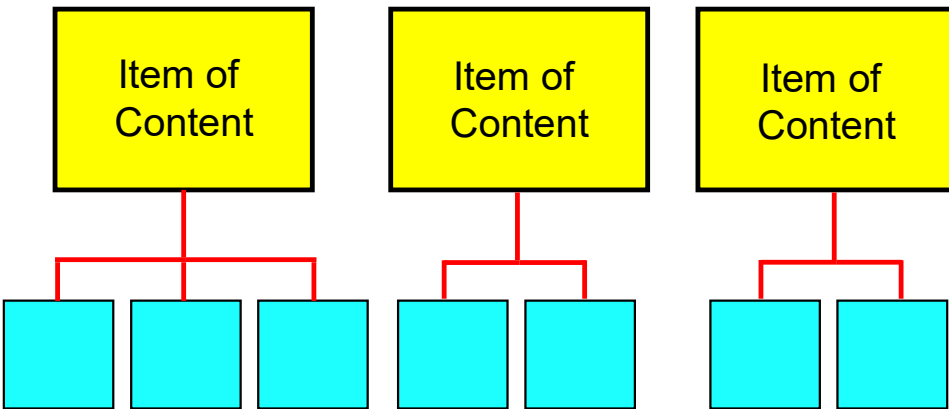
EX1029, Goodrich dep., at 44:22-45:21 (emphasis added)
(objection omitted); Paper 31, Sur-Reply, at 7



Mehta Discloses “Functionally Equivalent” Programs, Not Multiple Implementations of Programs

The '790 Patent

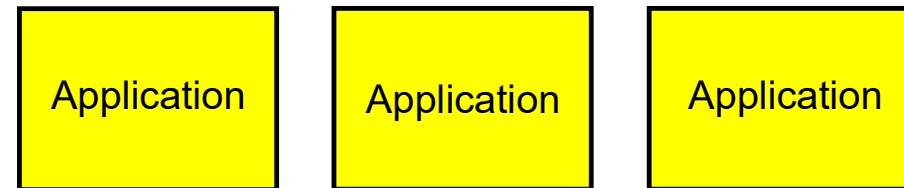
“plurality of items of digital content”



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

Mehta

“plurality of items of digital content”



Claim Elements Mehta Does Not Disclose

Missing Claim Elements	Claims
“a plurality of items of digital content” and “a plurality of different implementations of at least one of the items of digital content”	1-4 and 8-11
“maintain a product catalog,” with “the product catalog includes, in association with each item of digital content, a reference to each implementation of said item of digital content.”	1-4 and 8-11
“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 / a] number of implementations [that are available] [for / of] each said item.”	1-4 and 8-11
“select[ing] an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber”	4, 11



Maintain a Product Catalog Where the Product Catalog Includes, in Association With Each Item of Digital Content, a Reference to Each Implementation of Said Item of Digital Content

2. 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;

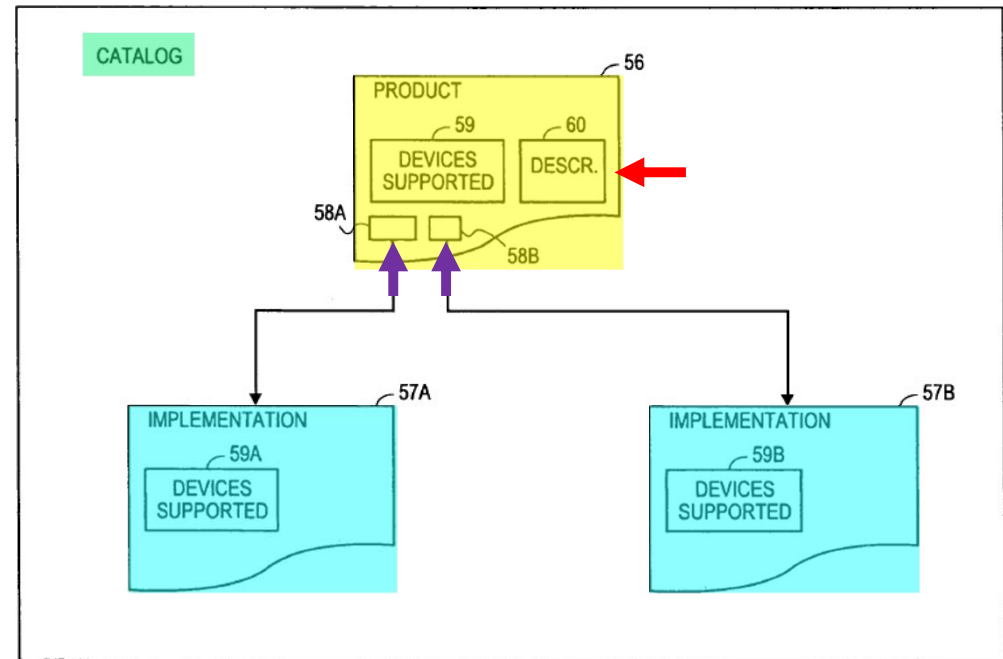


FIG. 5

EX1001, '790 patent, at claim 2; Fig. 5



The Petition's Mapping: Product Catalog

What does the Petition map to “Product Catalog”?



The Petition's Mapping: Product Catalog

What does the Petition map to “Product Catalog”? **Data Repository**

In view of these teachings of Mehta, a POSITA would have understood that Mehta's “data repository” is essentially identical to the '790 patent's “product catalog containing a description of the items of content” of claim 1. Ex. 1002, ¶ 67.

Paper 1, Pet., at 30; Paper 24, POR, at 25

Q. And so what you map in Mehta to the product catalog is the data repository, right?

A. Yes.

EX2021, Wechselberger dep., at 57:14-16; Paper 24, POR at 25



The Petition's Mapping: Reference to Each Implementation

What does the Petition map to “Product Catalog”? **Data Repository**

What does the Petition map to “Reference to Each Implementation”?



The Petition's Mapping: Reference to Each Implementation

What does the Petition map to “Product Catalog”? **Data Repository**

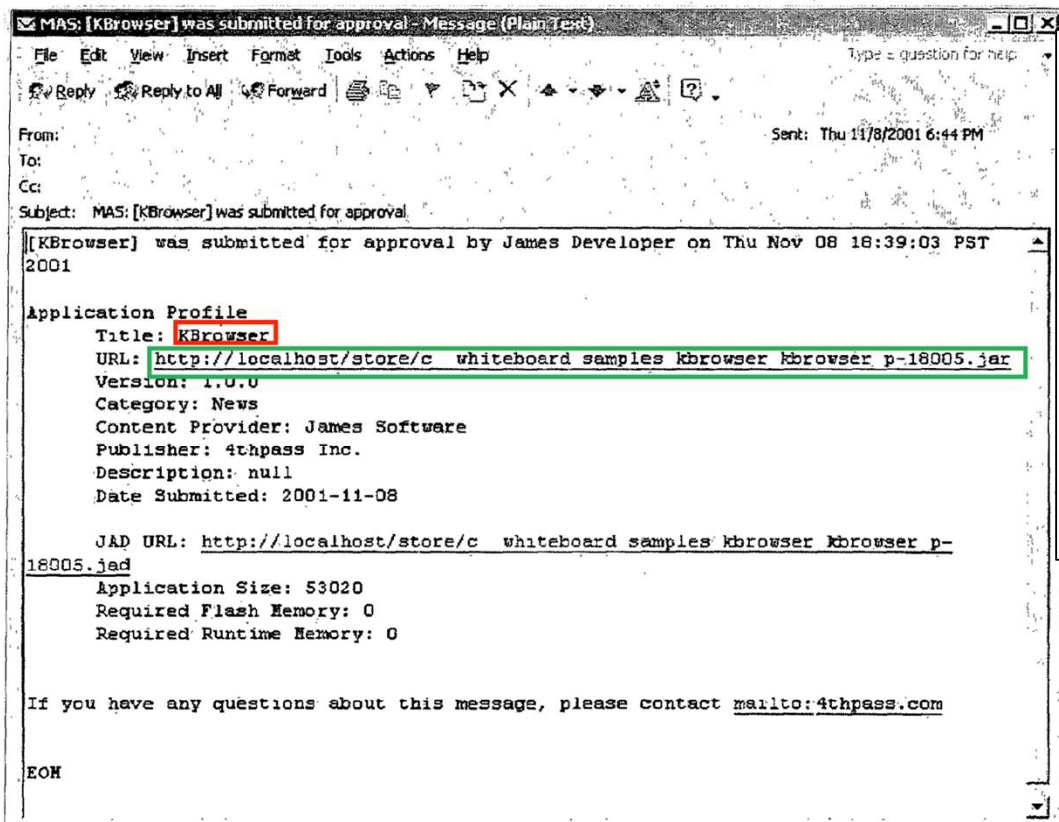
What does the Petition map to “Reference to Each Implementation”? **URL of the Content**

Mehta's data repository that stores application profiles, which include a URL of the content, is the claimed “product catalog includ[ing], in association with each item of digital content, a reference to each implementation of said item of digital content. When submitting an application to the MAS, the Content Provider

Paper 28, Reply, at 1; Paper 1, Pet., at 30-31;
Paper 24, Sur-Reply, at 7-8



Mehta Does Not Disclose a Reference to Each Implementation of Said Item of Digital Content In The Product Catalog



data repository 511 in FIG. 5)." *Id.*, [0099] (emphasis added). For example, regarding Figure 9D, the “item of digital content” is “Kbrowser,” the “implementation” is in the .jar file, and the URL, which is associated with this implementation of “Kbrowser,” is the “reference to each implementation of said item of digital content.” EX1003, Fig. 9D, [0099]. This information in the application profile is stored in MAS’s data repository—the claimed “product catalog.” EX1002, ¶67. Thus, PO’s argument that Mehta “does not show that the

Paper 28, Reply, at 12

Fig. 9D

EX1003, Mehta, at Fig. 9D;
Paper 28, Reply, at 6



Mehta Does Not Disclose That the URL Is Stored in the Data Repository

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).

EX1003, Mehta, ¶0099; Paper 31, Sur-Reply, at 8-9

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 name and a short description of the application, a list of Supported Java profiles (which are compared with device profiles to determine devices capable of running the application, the language in which the application was written, and billing information such as a suggested sales price and trial use parameters).

EX1003, Mehta, ¶0098; Paper 31, Sur-Reply, at 8-9



Claim Elements Mehta Does Not Disclose

Missing Claim Elements	Claims
“a plurality of items of digital content” and “a plurality of different implementations of at least one of the items of digital content”	1-4 and 8-11
“maintain a product catalog,” with “the product catalog includes, in association with each item of digital content, a reference to each implementation of said item of digital content.”	1-4 and 8-11
“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 / a] number of implementations [that are available] [for / of] each said item.”	1-4 and 8-11
“select[ing] an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber”	4, 11



The Selected Portion, As Presented, Provides a Single Description of Each Item of Digital Content in Said Portion, Regardless of the Number of Implementations of Each Said Item

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.

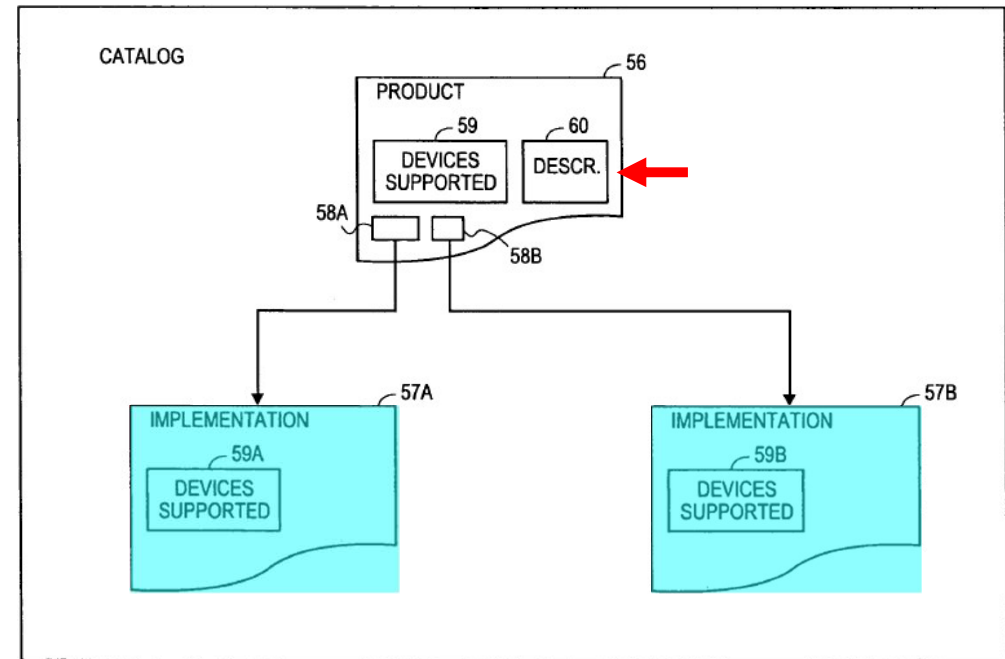


FIG. 5

EX1001, '790 patent, at claim 2; Fig. 5



Petitioner's Faulty Argument

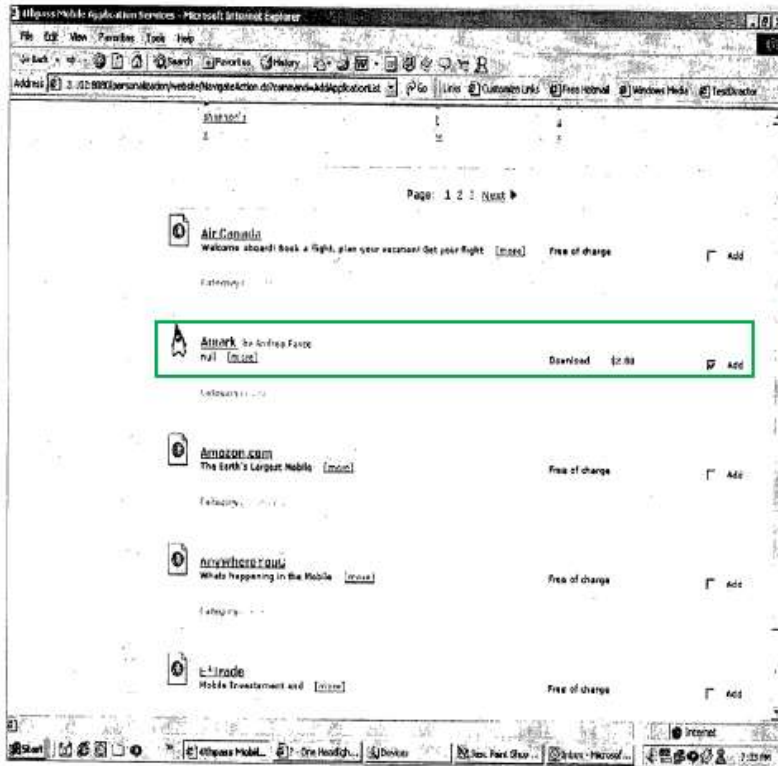


Fig. 11F

EX1003, Mehta, at Fig. 11F; Paper 28, Reply, at 15

Indeed, Mehta discloses that Figure 11F is an exemplary screen display of the “subscriber’s Personal Access List” (“PAL”), which includes “the name and description of the application.”¹ *Id.* Figure 11F (below) depicts that the list of applications satisfies the claimed “only a single description of each item of digital content.” For example, the Amark game application, is an “item of digital content” (green rectangle) and has a single description “Amark.”

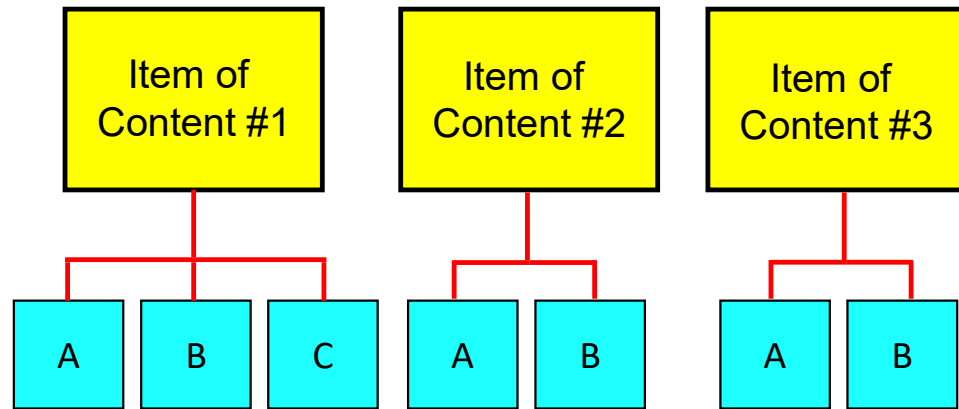
Paper 28, Reply, at 13-14



Mehta Does Not Provide a Single Description of Each Item of Digital Content in Said Portion, Regardless of The Number of Implementations of Each Said Item

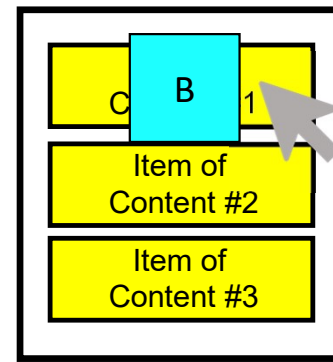
The '790 Patent

items of digital content



implementations
of the item of content

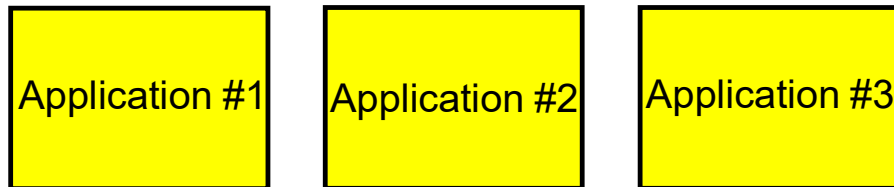
portion of the product catalog



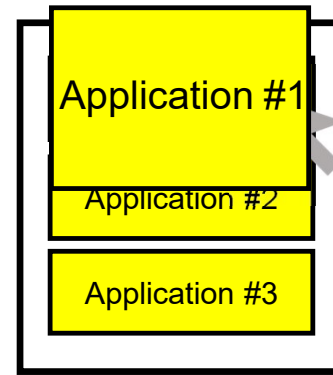
Mehta Does Not Provide a Single Description of Each Item of Digital Content in Said Portion, Regardless of The Number of Implementations of Each Said Item

Mehta

items of digital content



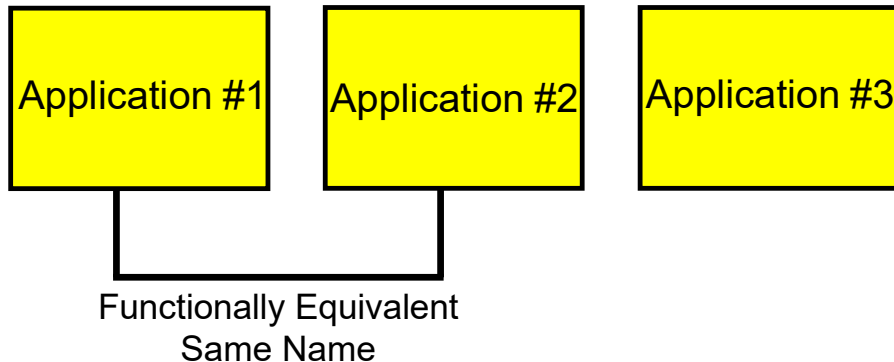
portion of the product catalog



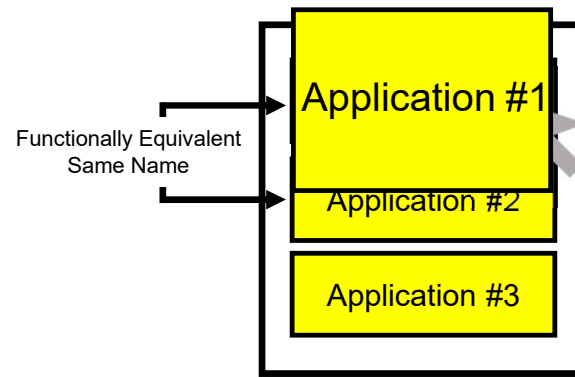
Mehta Does Not Provide a Single Description of Each Item of Digital Content in Said Portion, Regardless of The Number of Implementations of Each Said Item

Mehta

items of digital content



portion of the product catalog



provides only a *single* description of each item of digital content in said portion, *regardless of the number of implementations of each said item*



Claim Elements Mehta Does Not Disclose

Missing Claim Elements	Claims
“a plurality of items of digital content” and “a plurality of different implementations of at least one of the items of digital content”	1-4 and 8-11
“maintain a product catalog,” with “the product catalog includes, in association with each item of digital content, a reference to each implementation of said item of digital content.”	1-4 and 8-11
“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 / a] number of implementations [that are available] [for / of] each said item.”	1-4 and 8-11
“select[ing] an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber”	4, 11



'790 Patent: Claim 4

2. . . .
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.

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.

EX1001, '790 patent, at claims 2, 4



Claim 4 Requires Two Different “Selecting” Steps

- 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 (claim 2)
- presenting the selected portion of the product catalog to the subscriber via a wireless network (claim 2)
- receiving from the subscriber a request for one of the items of digital content in said portion of the product catalog (claim 2)
- selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber (claim 2)

Petitioner’s Mapping

Application Discovery

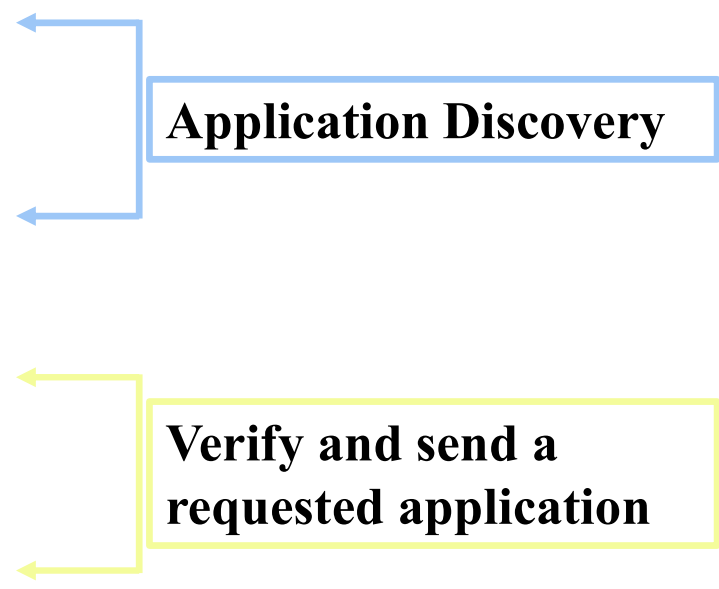
Verify and send a requested application



Mehta Does Not Disclose Performing Both “Selecting” Steps

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.

Petitioner's Mapping



Application Discovery

Verify and send a requested application

EX1003, Mehta, ¶0070; Paper 31, Sur-Reply, at 11-12



Mehta Does Not Disclose Performing Both “Selecting” Steps

“In step 1404, the Provisioning Manager determines whether the ‘command’ is a request to download and, if so, continues in step 1404, else continues in step 1408.”

Once the provisioning has occurred in steps 1406 or 1407, the request is post-processed in step 1413.”

“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.”

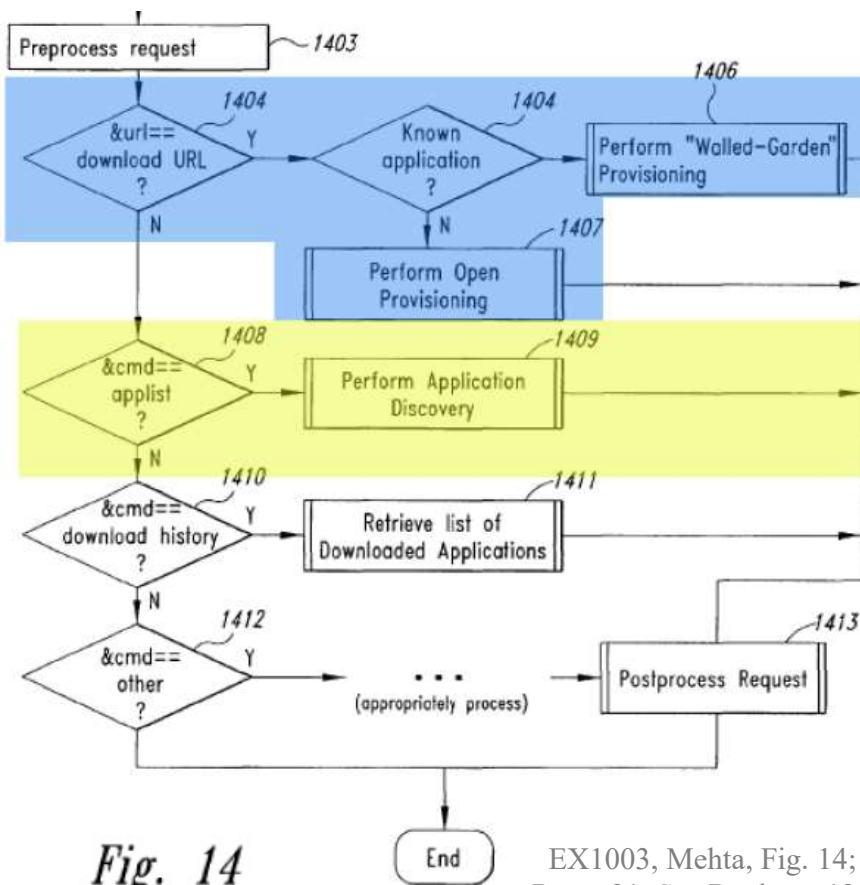


Fig. 14

EX1003, Mehta, Fig. 14;
Paper 31, Sur-Reply, at 13

EX1003, Mehta, ¶0135; Paper 31, Sur-Reply, at 11-12



Mehta Does Not Disclose Performing Both “Selecting” Steps

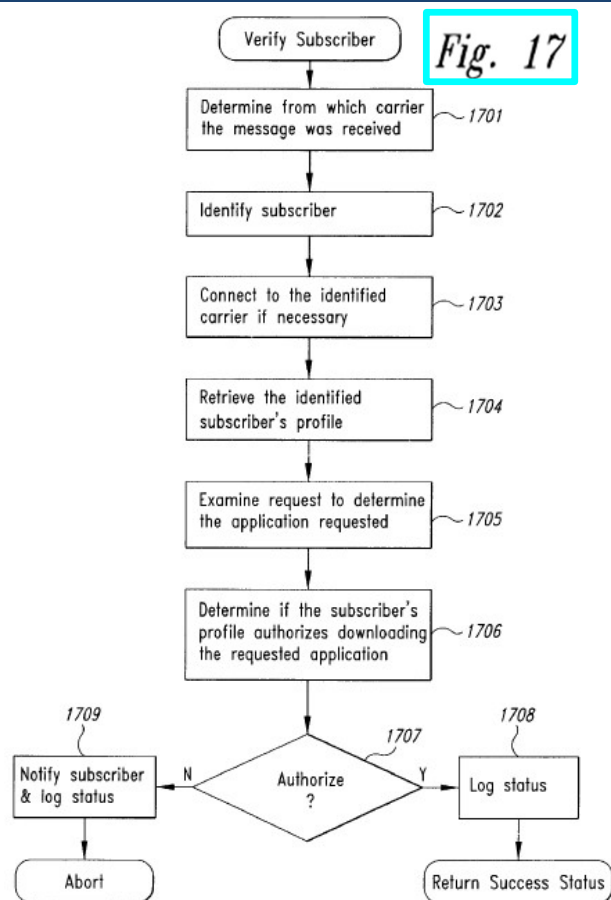


FIG. 17 is an example flow diagram of processing performed by a Verify Subscriber routine of a Provisioning Manager. (See step 1503 of **FIG. 15**.)

FIG. 15 is an example flow diagram of processing performed by a Perform Walled-Garden Provisioning routine of a Provisioning Manager. (See step 1406 of **FIG. 14**.)

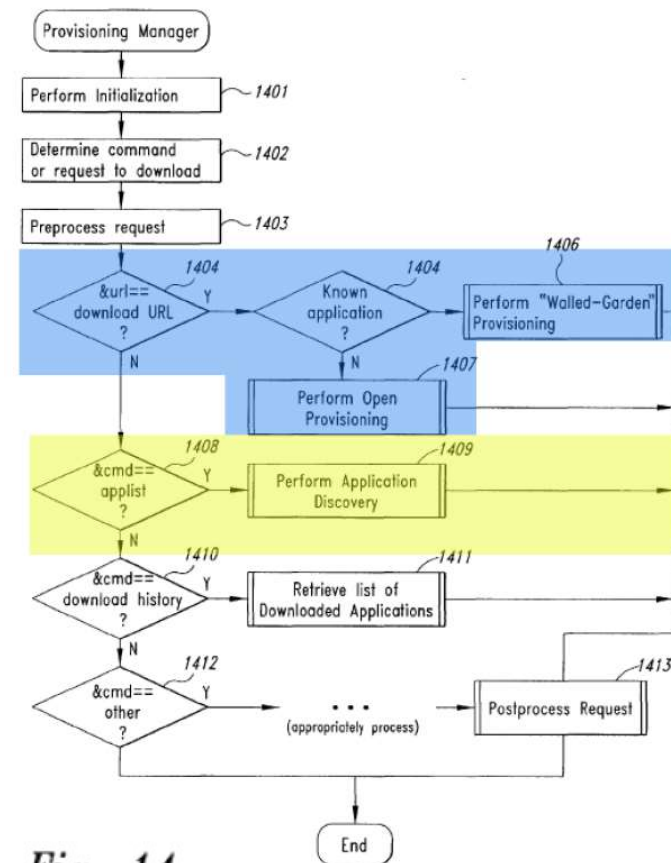


Fig. 14

EX1003, Mehta, ¶0136, ¶0138, Figs. 14-17; Paper 31, Sur-Reply, at 14

Mehta Does Not Disclose Performing Both “Selecting” Steps

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

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

EX2021, Wechselberger dep., at 53:11-20 (objection omitted);
Paper 24, POR, at 34-35

Q. When a user selects one of the applications from the filtered list, the user will never get a different application than the one they requested, right?

A. Certainly nothing like that is disclosed by Mehta that I can recall.

EX2021, Wechselberger dep., at 54:5-11 (objection omitted);
Paper 24, POR, at 34-35



Ground 2: Obviousness Based on Mehta in view of Schlapfer

Ground	Assertion	Petitioned Claims
1	Anticipation by Mehta	1-4 and 8-11
2	Obviousness based on Mehta in view of Schlapfer	1-14

Paper 1, Petition, at 22



Petitioner Does Not Make Any Additional Arguments For a Number of Elements

No additional anticipation or obviousness analysis or assertions:

- “a plurality of different implementations of at least one of the items of digital content” (Paper 24, POR, at 35)
- “the product catalog including, in association with each item of content, a reference to each implementation of said item of content” (Paper 24, 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.” (Paper 24, POR, at 43)



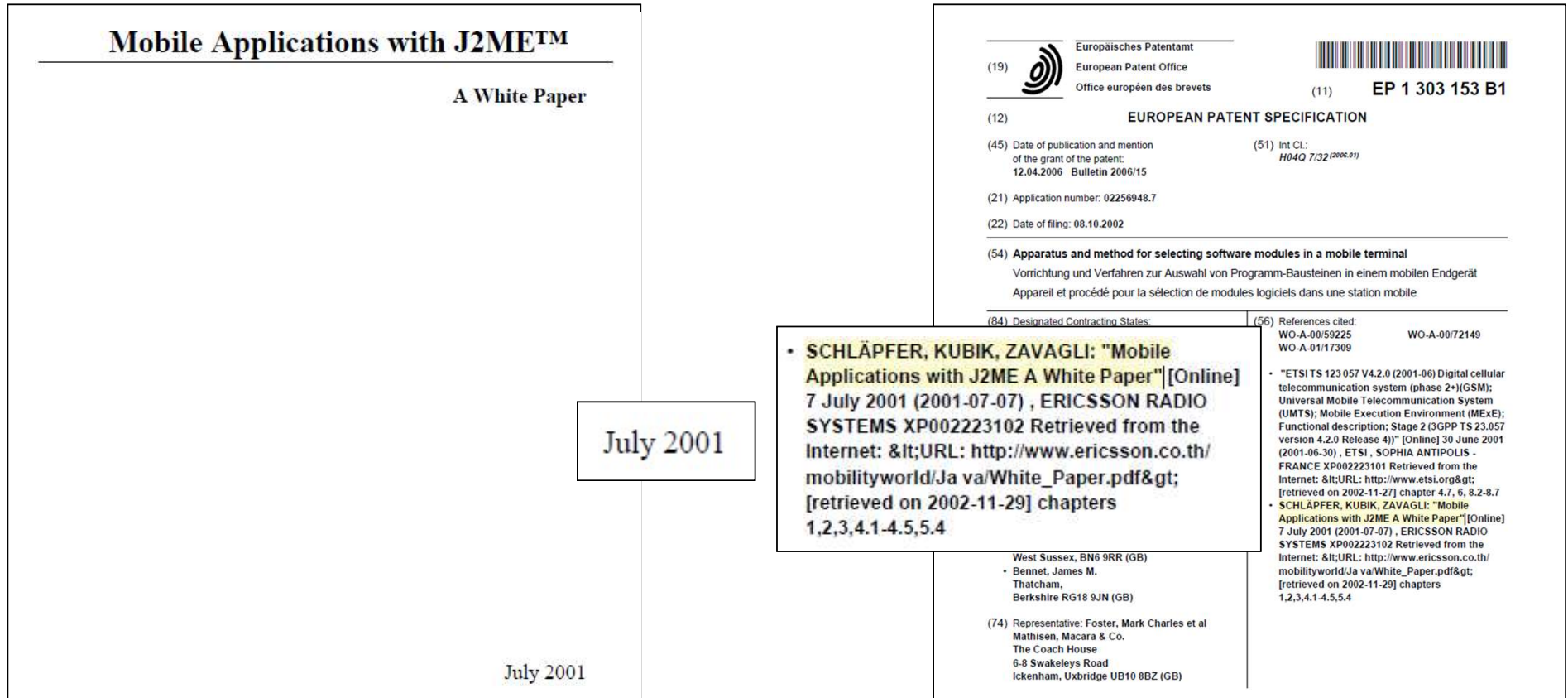
Schlapfer Is Not Prior Art

“‘[P]ublic accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’ bar under 35 U.S.C. § 102(b).”

In re Hall, 781 F.2d 897, 899 (Fed. Cir. 1986)
Paper 24, POR, at 37



Schlapfer Was Not Publicly Accessible



EX1009, Schlapfer, at 1; Paper at 24, POR, at 37-38

EX1017 at 1; Paper 24, POR, at 37-38



DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Presentation of Patent Owner

Schlapfer Was Not Publicly Accessible

“Petitioners’ pointing to a vague date listed on a website page is insufficient to meet Petitioners’ burden to show that Li was publicly accessible by a particular date.”

In-Depth Geophysical, Inc. v. Conocophillips Co.,
IPR2019-00849, Paper 14 at 10, 13 (PTAB Sept. 6, 2019)

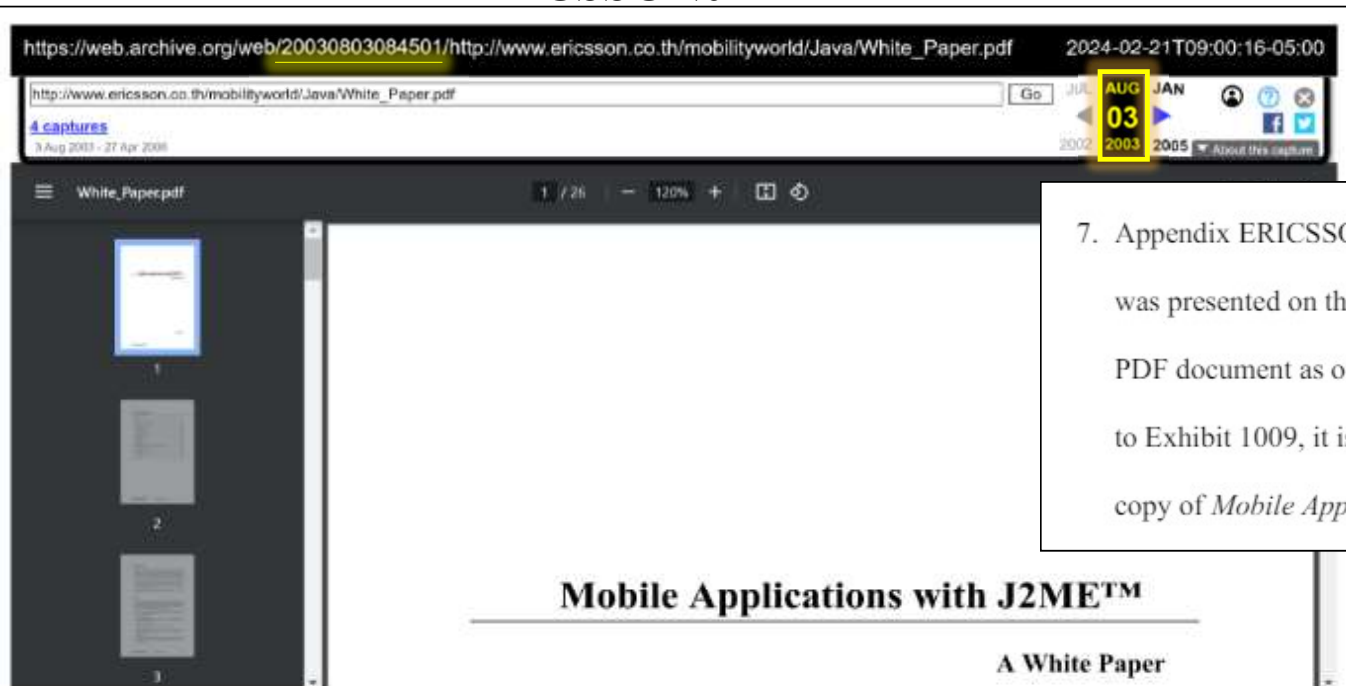


Schlapfer Was Not Publicly Accessible

ERICSSON01

Priority Date (June 19, 2003)

Paper 1, Pet., at 14



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, Munford Decl., at 3, Appendix Ericsson01 at 3;
Paper 31, Sur-Reply, at 16-18



Schlapfer Was Not Publicly Accessible

ERRICSSON02

Priority Date (June 19, 2003)

Paper 1, Pet., at 14

https://web.archive.org/web/20020803142754/http://www.ericsson.co.th:80/mobilityworld/Java/CommunityProgram 2024-02-21T08:30:58-05:00 ram.asp

http://www.ericsson.co.th/mobilityworld/Java/CommunityProgram.asp

10 captures

3 Aug 2002 - 16 Jan 2005

JUL AUG OCT
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2002 2003

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About this capture

ERICSSON

Home > Ericsson Mobility World > Ericsson Java Community Program

Ericsson Mobility

[Ericsson Mobility World]

Open Forum

What's EMW?

News

Success Stories

Event Calendar

Application Hosting

Company showroom

and Access Test Lab

Download and

Document

Ericsson Java Community Program

This program is intended to generate more business opportunity to Professional and general community in Java business. By developing Java applications with good quality, Ericsson (Thailand) will ensure your success to bring you with great business opportunity in Thailand and other markets worldwide.

Group1: Professional

Qualifications:

Useful information:

- Java island or coffee?

- Java white paper

EX1030, Munford Decl., Appendix Ericsson02 at 3-4;
Paper 31, Sur-Reply, at 16-18



DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Presentation of Patent Owner

Schlapfer Was Not Publicly Accessible

ERRICSSON02

Priority Date (June 19, 2003)

Paper 1, Pet., at 14

https://web.archive.org/web/20020803142754/http://www.ericsson.co.th:80/mobilityworld/Java/CommunityProgram 2024-02-21T08:30:58-05:00
ram.asp

http://www.ericsson.co.th/mobilityworld/Java/CommunityProgram.asp

10 captures

3 Aug 2002 - 16 Jan 2005

JUL AUG OCT
03
2002 2003

ERICSSON

Q. So, it is possible that the link on Page 4 that you point to in Ericsson02 takes you 2 to a different version than that shown in Ericsson01. Correct?

THE WITNESS: It is theoretically possible.

Q. Okay. But in fact, it is possible that the link in Ericsson02 takes you to a entirely different document than the PDF shown in Ericsson01. Right?

THE WITNESS: Again, it is theoretically possible.

EX2022, Munford dep., at 19:22-20:14 (objection omitted);
Paper 31, Sur-Reply, at 17

Document

Useful information:

- Java island or coffee?
- Java white paper

EX1030, Munford Decl., Appendix Ericsson02 at 3-4;
Paper 31, Sur-Reply, at 16-18



DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Presentation of Patent Owner

Schlapfer Was Not Publicly Accessible

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.

EX2022, Munford dep., at 15:8-15 (objection omitted); Paper 31, Sur-Reply, at 17

Q. All right. So, just as an example, if I had MMC dot com/PDF, that could be, let's say document A today. And then I could make it be document B, a totally different document tomorrow. Right?

THE WITNESS: I can only say that such changes are possible with web design.

EX2022, Munford dep., at 15:17-16:3 (objection omitted); Paper 31, Sur-Reply, at 17

Q. Okay. So, it is possible that there was a different version of the mobile applications with J2ME white paper 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.

EX2022, Munford dep., at 16:19-17:6 (objection omitted); Paper 31, Sur-Reply, at 17



There Is No Evidence The Public Could Access Schlapfer

“[T]he present case lacks any testimonial evidence that a person interested in solar trackers or solar panel assemblies would be independently aware of the web address for Wattsun or even of the company or its products. In other words, there was no evidence that the ordinarily skilled artisan would know of Wattsun or its web address. Nor does Petitioner offer evidence, or even argument, that Wattsun’s webpage was ‘indexed . . . (through search engines or otherwise)’ and thus locatable by a search engine.

Thus, while Petitioner has attempted to make a showing that Wattsun was technically accessible, ‘public accessibility requires more than technical accessibility.’”

First Solar, Inc. v. Rovshan Sade, IPR2023-00827, Paper 13 (PTAB Nov. 16, 2023) (quoting *Voter Verified, Inc. v. Premier Election Sols., Inc.*, 698 F.3d 1374, 1380 (Fed. Cir. 2012); *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1369 (Fed. Cir. 2019))



There Is No Evidence The Public Could Access Schlapfer

Q. But again it is possible that the PDF at Ericsson01 had access restrictions such that the general population could not access it before August 3rd, 2003. Correct?

THE WITNESS: I think it is theoretically possible. I see nothing to suggest it. *And I really can't speculate on who would have had access and who would not have had access.*

EX2022, Munford dep., at 28:17-29:5 (objection omitted); Paper 31, Sur-Reply, at 18



There Is No Evidence The Public Could Access Schlapfer

Q. Yes. There is a whole bunch of ways that websites can be, you know, limited in their access to only certain people. Right?

A. Yes, sure.

EX2022, Munford dep., at 24:3-6; Paper 31, Sur-Reply, at 18

Q. It is possible that the link on Page 4 of Ericsson02 was only available to competition participants, right?

A. I can't speculate on who it was available to. All I can say is I suppose it is theoretically possible that there was access restrictions up until around the capture date of 2003. I don't believe that there is any evidence to suggest that there was access restrictions, but it is possible.

Q. You don't know for sure either way?

A. I can't say for certain, no.

EX2022, Munford dep., at 26:16-27:6; Paper 31, Sur-Reply, at 18

Q. Would it be possible for one company to have access to the PDF link shown in 9 Ericsson01 before August 3rd, 2003, but for the rest of the world not to have access?

A. I can't speculate on who would and would not -- let me clarify it. 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.

EX2022, Munford dep., at 27:7-16; Paper 31, Sur-Reply, at 17



Mehta Does Not Disclose Each Element of the '790 Patent

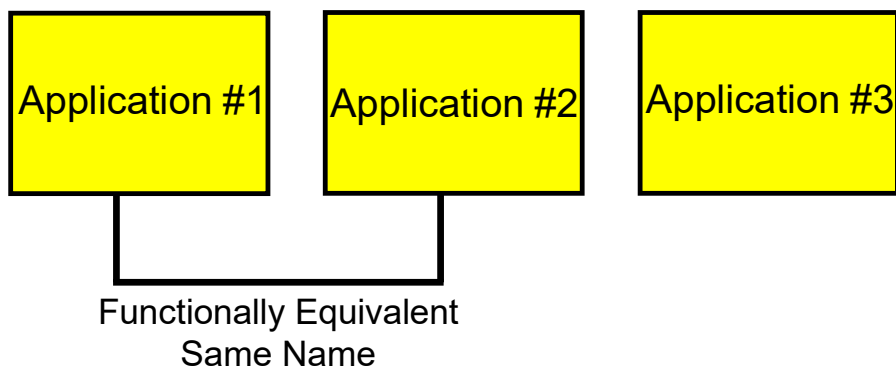
Missing Claim Elements	Claims
“a plurality of items of digital content” and “a plurality of different <i>implementations of at least one of the items of digital content</i> ”	1-4 and 8-11
“maintain a product catalog,” with “the product catalog includes, in association with each item of digital content, a reference to each implementation of said item of digital content.”	1-4 and 8-11
“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 / a] number of implementations [that are available] [for / of] each said item.”	1-4 and 8-11
“select[ing] an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber”	4, 11
“each of the provisioning models corresponding to or based on device capabilities”	5, 12
“a corresponding set of provisioning attributes and descriptors”	5, 12



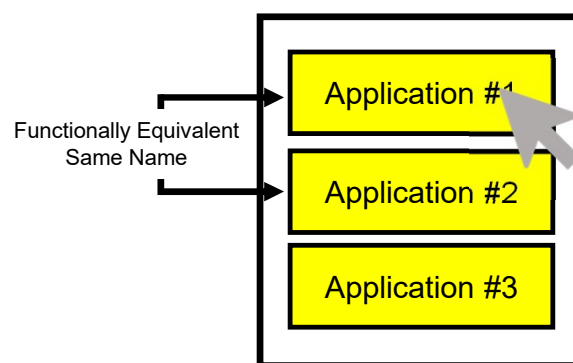
Mehta and Schlapfer Do Not Render Obvious Providing a Single Description of Item of Digital Content Regardless of the Number of Implementations

Mehta

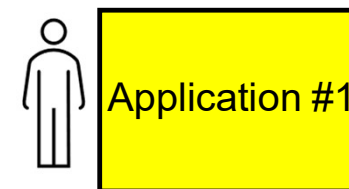
items of digital content



portion of the product catalog



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 and Schlapfer Do Not Render Obvious Providing a Single Description of Item of Digital Content Regardless of the Number of Implementations

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 contemplated.

EX1003, Mehta, ¶0117;
Paper 1, Pet., at 51; Paper 28, Reply, at 21

4.2.1 Mobile Information Device Profile for the J2ME Platform (MIDP)

MIDP [15] addresses a family of devices that have a common set of characteristics: they have a small display (min. 96x54 pixels), contain a touch screen or keypad, and are capable of communicating via a mobile network with limited bandwidth. In essence, MIDP is built on top of CLDC, and adds classes (APIs) in the following areas:

EX1009, Schlapfer, at 7;
Paper 1, Pet., at 51; Paper 28, Reply, at 21



Mehta and Schlapfer Do Not Render Obvious Providing a Single Description of Item of Digital Content Regardless of the Number of Implementations

“To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction—an illogical and inappropriate process by which to determine patentability.”

Sensonics Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570 (Fed. Cir. 1996) (citing *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983))



Even If a POSITA Were Motivated To Limit the Amount of Content Shown Due To “A Small Display,” There Are Many Ways To Accomplish That

105. Moreover, even if a POSITA would be motivated to limit the amount of content shown due to “a small display,” there are many ways to accomplish that. For example, the MAS could display less information, or only display the most important or valuable applications. 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.”

EX2020, Goodrich Decl., ¶105; Paper 24, POR, at 40



Mehta Does Not Disclose Each Element of the '790 Patent

Missing Claim Elements	Claims
“a plurality of items of digital content” and “a plurality of different <i>implementations of at least one of the items of digital content</i> ”	1-4 and 8-11
“maintain a product catalog,” with “the product catalog includes, in association with each item of digital content, a reference to each implementation of said item of digital content.”	1-4 and 8-11
“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 / a] number of implementations [that are available] [for / of] each said item.”	1-4 and 8-11
“select[ing] an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber”	4, 11
“each of the provisioning models corresponding to or based on device capabilities”	5, 12
“a corresponding set of provisioning attributes and descriptors”	5, 12



Mehta Discloses Four Provisioning Models

- Walled-Garden Provisioning
- Open Provisioning
- Static Provisioning
- Dynamic Provisioning

EX1003, Mehta, ¶¶0008-0009; Paper 24, POR, at 45-46



None of Mehta's Four Provisioning Models Have Anything To Do With Any "Set of Device Capabilities"

[0008] In one embodiment of the MAS, **walled-garden provisioning** is provided. Content is submitted to the MAS, inspected for malicious or banned code, or for the presence of particular API, approved, and **published by the MAS**. Subscribers can then discover and request the content. In some embodiments, the published content is **preprovisioned (static provisioning)**. In other embodiments, the published content is **provisioned dynamically upon download request**.

[0009] In another embodiment, **open provisioning** is provided. With open provisioning, a subscriber browses to a site on a network, such as the Internet, and **specifies a request to download content at a particular address**, for example, a URL. The MAS intercepts this request, downloads the content from the address, and inspects the content for API or other attributes that should not appear in the content. If the inspection is successful, the MAS provisions the content for the subscriber. In one embodiment, the inspection process is performed using application filters. In some embodiments, the requested content is also verified for the subscriber's device to increase the likelihood that the content will execute properly on the device.

EX1003, Mehta, ¶¶0008-0009; Paper 24, POR, at 46



Petitioner's Expert Admits That Mehta's Four Provisioning Models Do Not Relate To the "Set of Device Capabilities"

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

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

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

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

EX2021, Wechselberger dep., at 36:11-22, 37:1-9 (objection omitted); Paper 24, POR, at 46-47

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

A. Yes.

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

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

EX2021, Wechselberger dep., at 37:18-22 (objection omitted), 38:1-9; Paper 24, POR, at 47-48



Petitioner Admits That Mehta's Four Provisioning Models Are Not Based on the "Set Of Device Capabilities"

"[T]he choice between 'walled garden' and 'open' provisioning in Mehta is based principally on whether an application is published to the MAS."

Paper 28, Reply, at 24-25

"[T]he choice between 'static' and 'dynamic' provisioning is based generally on when the content is provisioned."

Paper 28, Reply, at 24-25



Petitioner's New "Provisioning Model" Argument Is Waived

- a. 5[a]: "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."

Mehta discloses this element. Mehta discloses that "[p]rovisioning, 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." Ex. 1003, [0059] (emphasis added). "[T]he Device Verifier 602 [in Provisioning Manager 600, as shown in Fig. 6] 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." *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.*,

[0008], [0009], [0061], [0131]; Ex. 1002, ¶ 115.

A POSITA would have understood, in view of the above teachings of Mehta, that it would have been obvious to associate each of the items of digital content in the server system with a plurality of different provisioning models because Mehta describes that "[p]rovisioning . . . is the customizing and distributing of content . . . *for use on a particular kind of subscriber device* by a particular customer" while disclosing at least four different types of provisioning models, and the MAS of Mehta handles a different set of device capabilities. Ex. 1003, [0059], [0085], [0131] (emphasis added); Ex. 1002, ¶ 116. For these reasons, Mehta discloses element 5[a].

Paper 1, Pet., at 54-55



Petitioner's New "Provisioning Model" Argument Is Waived

a. 5[a]: "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."

Mehta discloses this element. Mehta discloses that "[p]rovisioning, as it is discussed herein, is the customizing and

for example, *for use on a particular kind of subscriber device* for a particular customer." Ex. 1003, [0059] (emphasis added). Provisioning Manager 600, as shown in

capabilities of the subscriber device from which the request was made and

determines whether the device capabilities are sufficient to support a specific 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.*, [0008], [0009], [0061], [0131]; Ex. 1002, ¶ 115.

A POSITA would have understood, in view of the above teachings of

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

Paper 28, Reply, at 24, n.6 *particular kind of subscriber device* by a

particular customer" while disclosing at least four different types of provisioning models, and the MAS of Mehta handles a different set of device capabilities. Ex. 1003, [0059], [0085], [0131] (emphasis added); Ex. 1002, ¶ 116. For these reasons, Mehta discloses element 5[a].

Paper 1, Pet., at 54-55



Petitioner's New "Provisioning Model" Argument Is Waived

“The Board’s rules of practice provide: ‘A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution.’ 37 C.F.R. § 42.23(b). This regulation means that an ‘IPR petitioner may not raise in reply an entirely new rationale,’ not ‘raised in its petition’ or ‘responsive to arguments raised in the patent owner's response brief.’ The regulation ‘reflects . . . efficiency and fairness interests,’ and flows from the statutory ‘requirement that the initial petition identify with particularity . . . the grounds for the challenge to each claim.’”

Yita LLC v. MacNeil IP LLC, 69 F.4th 1356, 1365–66 (Fed. Cir.) (cleaned up)

“Colas’s belated attempt to stretch that evidence to fit its alternative ‘overlapping ranges’ theory only underscores that this theory was an afterthought raised for the first time in its Reply.”

Colas Sols., Inc. v. Blacklidge Emulsions, Inc., 759 F. App’x 986, 990 (Fed. Cir. 2019)



Petitioner's New "Provisioning Model" Argument Fails On Its Merits

[0059] Embodiments of the present invention provide computer- and networkbased methods and systems for maintaining 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, ¶0059; Paper 28, Reply, at 24

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, ¶0064; Paper 28, Reply, at 25

[0112] System administrators can use the devices node of the Administration Website 802 to submit and maintain information that is used for verification during the provisioning of an application. For example, system administra-

EX1003, Mehta, ¶0112; Paper 28, Reply, at 24



Petitioner's New "Provisioning Model" Argument Fails On Its Merits

“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 coordinate system disclosed in Briggs.”

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)



Mehta Does Not Disclose Each Element of the '790 Patent

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“select[ing] an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber”	4, 11
“each of the provisioning models corresponding to or based on device capabilities”	5, 12
“a corresponding set of provisioning attributes and descriptors”	5, 12



Mehta Does Not Disclose “a Corresponding Set of Provisioning Attributes and Descriptors”

In this list, the term MIDlet is introduced. They represent the actual application based on MIDP. 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 MIDlet suite. The distinctive feature of the MIDlet suite is that all applications that it contains run in the same sandbox. That means that they can invoke each other's public methods and access each other's public members. Apart from the class definitions and resources, the jar file also 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

Optionally, it can also contain the following attributes:

- MIDlet-Description
- MIDlet-Icon
- MIDlet-Info-URL
- MIDlet-Data-Size
- MIDlet specific attributes that do not begin with 'MIDlet-'

The application descriptor is used by the Application Management Software on the mobile terminal to analyze the MIDlets, and to determine whether the terminal is capable of running the application.

EX1009, Schlapfer, at 7; Paper 1, Pet., at 55-56



Mehta Does Not Disclose “a Corresponding Set of Provisioning Attributes and Descriptors”

tation. 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.

EX1001, '790 patent, at 13:28-35;
Paper 28, Reply, at 25-26



A POSITA Would Not Be Motivated to Combine Mehta and Schlapfer

“To qualify as prior art for an obviousness analysis, a reference must qualify as ‘analogous art,’ i.e., it must satisfy one of the following conditions: (1) the reference must be from the same field of endeavor; or (2) the reference must be reasonably pertinent to the particular problem with which the inventor is involved.”

K-TEC, Inc. v. Vita-Mix Corp., 696 F.3d 1364, 1375 (Fed. Cir. 2012)



A POSITA Would Not Be Motivated to Combine Mehta and Schlapfer

Mehta

(57)

ABSTRACT

Computer- and network-based methods and systems for maintaining and provisioning wireless applications are provided. Example embodiments provide a Mobile Application

BRIEF SUMMARY OF THE INVENTION

[0005] Embodiments of the present invention provide computer- and network-based methods and systems for maintaining and provisioning wireless applications.

EX1003, Mehta, ¶0005, Abstract; Paper 24, POR, at 41



A POSITA Would Not Be Motivated to Combine Mehta and Schlapfer

Schlapfer

2 Introduction

Java is one of the most exciting things currently happening to the world of mobile devices and applications. This paper is providing insight into Java technology for the application development on mobile devices. It shall give an overview over the key aspects of Java on mobile terminals as it is today, but also over techniques that can be interesting in the near future. An important part is to present the background of J2ME, the Java platform for mobile devices. It should also provide an extensive set of resources to anyone who is interested in understanding what can be done with Java, or even better, who wants to develop her/his own Java applications.

EX1009, Schlapfer, at 3-2; Paper 24, POR, at 41

