UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

DODOTS LICENSING SOLUTIONS LLC,
Patent Owner.

Case IPR2023-00701
U.S. Patent No. 8,510,407 B1

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 8,510,407

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	*Lenovo Holding Co, Inc. et al. v. DoDots Licensing Sols.*, IPR2019-01279 (P.T.A.B. Jan. 19, 2021)
2002	*Lenovo Holding Co. v. DoDots Licensing Sols. LLC,* 2021 U.S. App. LEXIS 36126, at *2 (Fed. Cir. Dec. 8, 2021)
2003	Defendants' Proposed Claim Constructions, dated March 1, 2023, submitted in *DoDots Licensing Solutions LLC, v. Samsung Electronics Co., Ltd et al*., Case No.: 6:22-cv-00535-ADA-DTG (W.D. Tex)
2004	Relevant portions of Prosecution History of U.S. Patent No. 8,510,407
2005	June 21, 2022, Memo Regarding Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation
2006	Agreed Scheduling Order, dated December 29, 2022

Patent owner DoDots Licensing Solutions LLC ("DoDots" or "patent owner") submits this Patent Owner Preliminary Response to Samsung Electronics Co., Ltd.'s ("petitioner" or "Samsung") petition (Paper No. 2, "Petition") and requests the Board to deny institution of *inter partes* review of claims 1-24 ("the challenged claims") of U.S. patent no. 8,510,407 ("'407 patent," Ex. 1001).

I. INTRODUCTION.

Petitioner asks the Board to institute an *inter partes* review of the '407 patent, which DoDots has asserted in a concurrently pending district court litigation. But this Board has once before already determined that the '407 patent is *not* unpatentable in a previous IPR brought by Lenovo Holding Co ("Lenovo '407 IPR"). Ex. 2001. The Federal Circuit affirmed the Board's final written decision. *See Lenovo Holding Co. v. DoDots Licensing Sols. LLC,* 2021 U.S. App. LEXIS 36126, at *2 (Fed. Cir. Dec. 8, 2021).

In the Lenovo '407 IPR, the Board and the Federal circuit *inter alia* honed in on the Petitioner's attempt to conflate Network Information Monitor ("NIM") and Network Information Monitor Template ("NIM Template"). And in affirming the Board's decision, the Federal Circuit held a NIM Template is "a data structure that defines the characteristics of a NIM, including the NIM frame, view and control characteristics, and that excludes executable applications/compiled code." *See* Ex 2001 at page 19-20. *See* Ex. 2002.

Here, there are at least four reasons why the Board should deny institution.

First, the Board should deny institution because the petition rests on a completely wrong legal standard. The evidence petitioner submits through the declaration of Dr. Schmidt relies on the incorrect broadest-reasonable-interpretation (BRI) standard for claim construction. *See.* Exhibit 1003, Page 17. Thus, petitioner's entire invalidity analysis is legally flawed, and Dr. Schmidt's declaration should be disregarded under Federal Rule of Evidence 702 and 37 C.F.R. § 42.62. This defect in the petition affects all claims challenged in the IPR. For this reason alone, the petition cannot meet the threshold requirements set forth in 37 C.F.R. §§ 42.100(b), 42.104(b)(3), and 42.104(b)(4) and institution should be denied.

Second, independent of the inapplicable BRI standard, petitioner fails to meet its threshold burden of production requirements set forth in 37 C.F.R. §§ 42.104(b)(3), and 42.104(b)(4). Petitioner has taken up contradictory and irreconcilable positions on claims terms in the district court and *even within* this IPR. To preserve its rights in the district court, petitioner adopts the patent owner's construction "only for this IPR," but then fails to offer a construction as required under 37 C.F.R. §§ 42.104(b)(3) for a means-plus-function claim limitation. Samsung's failure to set forth a construction it believes is correct, and the failure to provide any support for the means-plus-function term are independent grounds for

denial. This defect in the petition affects all challenged claims. The Board has consistently denied IPR petitions that fail to meet the threshold requirements set forth in 37 C.F.R. §§ 42.104(b)(3) and 42.104(b)(4).

Third, petitioner has failed to show a reasonable likelihood of success for ground 2 because petitioner does *not* explain how a local HTML file of Shimada that includes content that is presented on a purported NIM meets "a content reference that comprises a network location at which content for the first networked information monitor is accessible via a TCP/IP protocol," as all challenged claims require. For this reason alone, the petition should be denied based on petitioner's failure to show a reasonable likelihood of success for ground 2.

Fourth, the petition should be discretionarily denied notwithstanding the merits under 35 U.S.C. § 314(A) because petitioner asks the Board to institute an *inter partes* review of the '407 patent, which DoDots has asserted in a concurrently pending district court litigation. Samsung's *Sotera* waiver is inadequate and will not prevent concurrent proceedings from wasteful duplication. Also, it is expected that the Board's final written decision will come two months after the underlying district court litigation goes to trial and is resolved.

II. THE '407 PATENT.

A. Background of the claimed invention.

In the late 1990s, more than seven years before the first iPhone was released, the inventors John and George Kembel (twin brothers and Stanford University alumnae) developed "dot" technology, which today is known as the mobile app. The '407 patent, titled "Displaying Time-Varying Internet Based Data Using Application Media Packages," discloses the fundamental technology used in modern-day mobile apps and the stores used to download and install those apps onto mobile devices (e.g., Apple App Store and Samsung Galaxy Store).

At that time of the invention, accessing Internet content involved the use of downloaded web browsers running on a personal computer or mobile device. But web browsers were limiting and hindered the way in which web content was viewed on mobile devices. For example, users and application developers had limited control over the presentation of internet content; content was essentially trapped within the frame of the browser. *See* Ex. 1001 at 2:25-30. The Kembels recognized early on that there was dissatisfaction with web browsers and there was a "growing desire for individual users to fully control the aggregation and presentation of content and web applications that appear on a client computer." *See Id*. at 2:30-36. The Kembels sought to eliminate the need for web browsers. To do so, they developed an approach of delivering content over the Internet outside a

web browser. Notably, when the Kembels conceived of their patented technology, there was no word for mobile apps. So, the Kembels coined the terms "dot" or "Network Information Monitor (NIM)"—which today are colloquially referred to as an app. These "dots" are "fully configurable frame[s] with one or more controls" through which content is presented on the display of a device and viewed by the user. *See Id.* at 5:21-28.

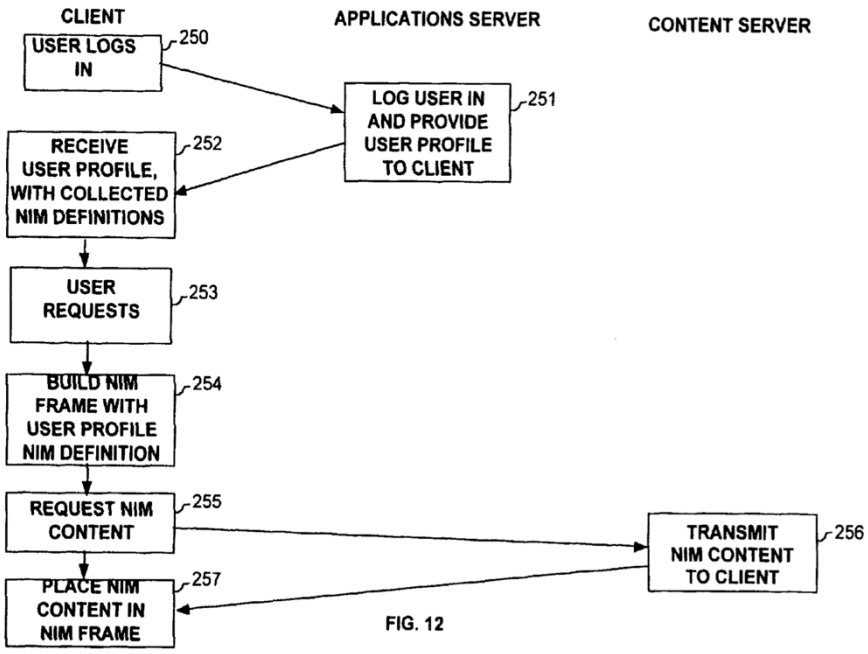
At the time of invention described in the '407 patent (i.e., in the late 1990s), web browsers (e.g., Microsoft Internet Explorer, Netscape Navigator) were installed on computers and used to retrieve and display websites and their webpages. A person would manually navigate between the different webpages of a website by e.g., (1) entering a webpage in a URL entry field, or (2) using forward and backward browsing buttons to move between web pages. The '407 patent changed this paradigm.

As the Federal Circuit noted in *Lenovo Holding Co.,* 2021 U.S. App. LEXIS 36126, at *2 (Fed. Cir. Dec. 8, 2021), DoDots' patents "relate to a method for accessing and displaying Internet content in a graphical user interface ("GUI")."

The NIM (mobile app), which is generated by the NIM template, is a "fully configurable frame with one or more controls; the frame through which content is optionally presented. The configurable frame used in accordance with the invention stands in contrast to present web browsers, which are branded by the

browser vendor and which have limited means by which to alter the controls associated with the browser." Ex. 1001 at 5:42-48. And a NIM developer (Mobile App Developer) "has full control over all aspects of the appearance and functionality of NIM frame 137. Thus, a NIM developer has the ability to control, for example, the functionality located at any corner of frame 137, functionality placed along the top or bottom of the frame, or on the sides of the frame." *Id*. at 17:32-37. Such customizability provided added flexibility over traditional web browsers.

Figure 12 of the '407 patent further describes how a NIM template is delivered to user's device to eventuate the installation of a NIM (i.e., an app):



See Id. at Fig. 12.

The process is similar to how users today download and execute apps from the Samsung Galaxy Store or the Apple App Store. Specifically, a NIM template is transmitted by TCP/IP as XML to define the Dot that will receive content and interaction for a user over a network. When the user "clicks on the name of a NIM" [i.e., the name of the app], a request is sent "to the applications server 50 via the transmission channel 44 (step 241)." *Id*. at 20:8-13. The client computing device then retrieves the "NIM definition from the NIM template database" (app store), installs the app using information in the .apk file (NIM template) and, when the user runs the app, creates a frame in the display of the user interface. *Id*. at 20:18-42. Put another way, the patent lays out the process for delivering both the data defining the creation of a NIM and also retrieving the content to be displayed within the frame of the NIM.

B. The previous Lenovo '407 IPR.

In the Lenovo '407 IPR, the Board found that the '407 patent discloses, in part, a software component for accessing and displaying network content. *See* Ex. 1012 at 4. This component, termed an "Networked Information Monitor" (NIM) is "a fully configurable frame with one or more controls with content optionally presented through the frame." *Id* (internal quotations omitted). When a user opens a NIM, the frame is presented in the user's display, and network content is retrieved and presented in a viewer enclosed by the frame. *Id*. The network content

may be identified via URLs included in the Dot. *Id*. The Specification describes that the frame according to the invention "stands in contrast to present web browsers, which are branded by the browser vendor and which have limited means by which to alter the controls associated with the browser." *Id*.

One key dispute in the prior Lenovo IPR proceeding related to the construction of the term "networked information monitor template" ("NIM template"). The Board concluded (and the Federal Circuit affirmed) that this term means "a data structure that defines the characteristics of a NIM, including the NIM frame, view, and control characteristics, [which] excludes executable applications/compiled code." *See Id.* at 14. Though the construction itself is important, the reasons for reaching this construction are equally important.

The Board noted that according to the specification, claims, and prosecution history, a NIM template is a data structure that defines the characteristics of a NIM, including the NIM frame, view and control characteristics, and that excludes executable applications/compiled code. *See Id.* at 13-14. According to the claims, the NIM template, stored in electronic storage of a client computing device (1.A), includes the definition of a NIM (1.C) / "viewer graphical user interface having a frame." *See Id.* at 14.

Though the Board noted that the meaning of a NIM template is not specifically defined in the '407 patent specification, the patent makes clear that

each NIM template "defines the characteristics of a specific NIM, including fully configurable frame characteristics, viewer and control characteristics, and Application Media Package content references." *Id*.

The Board acknowledged that the '407 specification, "does not indicate that the data structure for the NIM template contains compiled code." Ex. 1012 at 15. As a result, the Board agreed that the definition of a NIM "***the definition of the NIM is content, rather than compiled code.***" *Id.* at 16 (emphasis in the original). The Board further noted the specification's teaching that "[a]n application–type NIM, such as a web calendar or web mail, may be changed by the user, by the content provider, or by other content, ***while advantageously avoiding the need to distribute and support a hard-coded compiled application***." *Id.* at 16 (emphasis in the original) (internal quotes omitted).

The Board concluded that "[f]rom these disclosures, we understand that the Specification prohibits the NIM template from using compiled code or being an executable application. Our review of the Specification did not identify disclosure of use of compiled code or an executable application as the NIM template." *Id*.

In summarizing its position, the Board stated, "[t]he Specification does not describe any NIM template that uses compiled code or executable applications." *Id*. at 18. Rather, the Specification provides that "each NIM Definition contains just enough information to define, layout, and initialize a NIM's components

(frame, controls, etc.)" and "[t]he definition is content, rather than compiled code." *Id*.

Based on its constructions, the Board found that the prior art Lenovo relied on did not render the '407 patent unpatentable.

III. THE LEVEL OF ORDINARY SKILL IN THE ART.

In the Lenovo '407 IPR, the Board found that a person of ordinary skill in the art "would have a bachelor's degree in electrical or computer Engineering, Computer Science, or a related field and have three or more years of corresponding industry work experience." Ex. 1012 at 8. DoDots agrees that this is the correct standard for a POSITA.

IV. CLAIM CONSTRUCTION.

In an *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b), including construing the claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b). The proper claim construction standard is the one set forth in *Phillips v AWH Corp.,* 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

Here, as discussed below, petitioner relies on Dr. Schmidt to argue that claims 1-24 of the '407 patent are allegedly invalid as being obvious under Section

103. But Dr. Schmidt applies the completely wrong claim construction standard in forming his opinions. Because petitioner's grounds for invalidity are framed and supported under a completely wrong legal standard, its petition must be denied.

V. THE LEGAL STANDARD FOR OBVIOUSNESS.

The question of obviousness is resolved based on underlying factual determinations, including: (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so called secondary considerations. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966). A claim is only unpatentable under 35 U.S.C. § 103 if "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *KSR Int'l Co. v. Telefex Inc.*, 550 U.S. 398, 406 (2007) (quoting 35 U.S.C. §103).

"An invention is not obvious simply because all of the claimed limitations were known in the prior art at the time of the invention. Instead, we ask 'whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success.'" *Forest Lab'ys, LLC v. Sigmapharm Lab'ys, LLC*, 918 F.3d 928, 934 (Fed. Cir. 2019). "Of course, concluding that the

references are within the scope and content of the prior art to be considered for obviousness does not end the inquiry. *Graham* makes clear that the obviousness inquiry requires a determination whether the claimed invention would have been obvious to a skilled artisan" at the time of the invention. *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1050 n.14 (Fed. Cir. 2016).

VI. INSTITUTION SHOULD BE DENIED FOR TWO THRESHOLD REASONS.

Samsung's petition should be denied for two threshold reasons: (1) the petitioner uses the incorrect BRI claim-construction standard to analyze whether the disclosures in the prior art render the challenged claims obvious; and (2) the petitioner fails to meet its burdens set forth in §§ 37 C.F.R. 42.104(b)(3) and 42.104(b)(4).

A. Petitioner applies the incorrect claim construction standard under 37 C.F.R. § 42.100(b).

For an *inter partes* review proceeding, 37 C.F.R. § 42.100(b) states that "a claim of a patent *shall* be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent." In other words, in an IPR, the PTAB should construe a claim term using the *Phillips* standard that both the Federal

Circuit and district courts use in litigation. Samsung acknowledges as much in its petition. *See* petition at 3. Because attorney argument is *not* evidence, however, Samsung relies entirely on the declaration of its expert Douglas C. Schmidt to support all of its invalidity grounds. Indeed, throughout its petition, Samsung cites to and incorporates Dr. Schmidt's opinions on what the prior art supposedly discloses and why those disclosures allegedly render the challenged claims obvious. But in his declaration, Dr. Schmidt unequivocally states that he uses the BRI standard to interpret the challenged claims:

> I understand that, for purposes of my analysis in this *inter partes* review proceeding, the terms appearing in the patent claims should be interpreted according to their *broadest reasonable construction in light of the specification of the patent in which it appears.*

Ex. 1003 at 17 (emphasis added, internal quotations omitted).

Dr. Schmidt's failure to apply the correct legal standard when construing claim terms disqualifies his testimony. Fed. R. Evid. 702(d) (requiring an expert "reliably appl[y] the principles and methods to the facts of the case"); *See Hebert v. Lisle Corp.,* 99 F.3d 1109, 1117 (Fed. Cir. 1996) (holding that expert testimony should be excluded when it applies wrong legal standard.)

Construing a challenged claim under an incorrect legal standard is an error of law and results in the Petitioner failing to meet its burdens of production and persuasion. *See e.g.*, *Harmonic Inc. v. Avid Tech., Inc.,* 815 F.3d 1356, 1363 (Fed.

Cir. 2016) (holding that in an IPR, "the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.") *See* also *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (holding that "[i]n an *inter partes* review, the burden of persuasion is on the petitioner to prove unpatentability by a preponderance of the evidence, 35 U.S.C. § 316(e), and that burden never shifts to the patentee.") (internal quotations omitted). In other words, based on Dr. Schmidt's failure to apply the right claim construction standard, Samsung necessarily cannot meet its burden of production and burden of persuasion under 37 C.F.R. 42.104(b)(3). Having failed to use the appropriate claim construction standard, the petitioner cannot, as required in *Dynamic Drinkware*, prove "unpatentability by a preponderance of the evidence." Samsung's failure to comply with 37 C.F.R. §§ 42.100(b) warrants denial of Samsung's petition.

B. Petitioner fails to meet the requirements of §§ 37 C.F.R. 42.104(b)(3) and 42.104(b)(4).

42.104(b)(3) requires Petitioner to provide a statement detailing "[h]ow the challenged claim is to be construed." This provision also requires, "[w]here the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure,

material, or acts corresponding to each claimed function." As is apparent, 42.104(b)(3) compels the petitioner to (1) set forth how the challenged claim is to be construed; and (2) when a claim contains a means-plus-function, the construction must identify the specific portion of the specification that describes the structure for each claim function. Here, Samsung fails to meet either of these prerequisites in its petition.

Separately, 42.104(b)(4) directs the petitioner to provide a statement detailing "[h]ow the construed claim is unpatentable under the statutory grounds identified in paragraph (b)(2) of this section (i.e., 35 U.S.C. 102 or 103). The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon." As detailed below, Samsung fails to meet this requirement as well.

1. Petitioner violates both 42.104(b)(3) and 42.104(b)(4).

As discussed above, Samsung's petition fails to apply the *Phillips* standard. Petitioner has an affirmative burden to set forth how the challenged claim is to be construed. Samsung's failure to construe the claims under the *Phillips* standard results in Petitioner failing to meet its burden under 37 C.F.R. § 42.104(b)(3).

And additionally, if a petitioner relies on an incorrect claim construction standard (as Samsung does here), it necessarily follows that the petitioner has not properly construed the challenged claims. Given Samsung's error in this regard, it

is impossible for Samsung to show in its petition how the prior art it cites supposedly invalidates a properly construed claim. This violates the requirements of 37 C.F.R. § 42.104(b)(4) and is yet another threshold reason for denying the petition.

Indeed, to the extent Dr. Schmidt uses the BRI standard for his analysis and opinions while Samsung's petition cites the *Phillips* standard, those contradictory claim construction approaches result in confusion and a lack of particularity about Samsung's invalidity grounds and the evidence purportedly supporting them. For example, in preparing its preliminary response, DoDots has been forced to consider the arguments set forth in the petition and the expert declaration under both the *Phillips* standard and the BRI standard. As a result, the number of possible permutations DoDots has to consider when analyzing Samsung's invalidity arguments in view of how Dr. Schmidt approached the claims under the BRI standard is numerous, confusing, and ultimately prejudicial. Petitioner's use of multiple claim construction standards results in lack of particularity and Petitioner and the board are forced to consider all alternatives. *See* IPR2018-01596, Paper 20 at 24 (P.T.A.B. March 6, 2019) *(*"Considering the totality of the issues addressed above, we determine that the Petition fails to meet the particularity requirement of 35 U.S.C. § 312(a)(3) and that the lack of particularity results in voluminous and excessive grounds.") Samsung's failure to use the correct claim construction

standard (and/or contradictory use of different standards) has forced DoDots to guess the arguments Samsung is trying to make and under what legal framework. This burden placed on DoDots (and the Board) should be reason enough to deny Samsung's legally flawed and imprecise petition.

2. Petitioner fails to identify specific portions of the specification that describe the structure for a supposed means-plus-function limitation.

In the concurrently pending district court litigation, Petitioner argues that the phrase "computer program modules being configured to access the networked information monitor defined by the networked information monitor template" found in claim 1 of the '407 patent (and all claims depending on claim 1) is both a means plus function claim element and indefinite. *See* Ex. 2003, pg. 4. But despite its position in the pending litigation that this phrase is a means-plus-function limitation, Samsung does not identify "the specific portions of the specification that describe the structure corresponding to each claimed function," as § 42.104(b)(3) requires. As a result, Samsung's petition should be denied on this basis. *See e.g., Floteck Indus., Inc. v. Nat'l Oilwell DHT, L.P.,* IPR2015-01210, Paper 11 at 8-9 (P.T.A.B. Nov. 6, 2015); *Lindsay Corporation v. Valmont Industries,* IPR2015-01039, Paper 7 at 11 (P.T.A.B. Sept. 24, 2015); *SAS Institute, Inc. v. Complementsoft, LLC*, IPR2013-00226, Paper 9 at 11 (P.T.A.B. Aug. 12, 2013) ("SAS does not identify what structure in the Specification it believes

corresponds to the means-plus-function limitation of claim 11. This failure is fatal to SAS's challenge of claims that include that limitation."); *Clickbooth.com LLC v. Essociate, Inc.*, IPR2015-00464, Paper 9 at 12 (P.T.A.B. July 9, 2015) ("As such, Petitioner fails to identify corresponding structure for any of the means-plus-function limitations and, therefore, fails to comply with 37 C.F.R. § 42.104(b)(3). Accordingly, we decline to institute *inter partes* review [of the challenged claims].").

Moreover, to proclaim that a limitation is definite in an IPR and indefinite in a district court case is impossible to reconcile with the fact that the Board employs a "*lower threshold* of ambiguity when determining indefiniteness" than district courts. *See Ex parte Miyazaki*, 89 U.S.P.Q.2d 1207, 1211 (BPAI Nov. 19, 2008) (precedential)); *See also Medshape, Inc. v. Cayenne Med., Inc.,* IPR2015-00848, Paper 9 at 8 (P.T.A.B. Sep 14, 2015) (denying institution on claims) ("A claim term that does not satisfy the definiteness requirement under *Nautilus* likewise fails to satisfy the definiteness requirement of *Miyazaki*.").

And further, petitioner provides no reason for abandoning its litigation claim construction positions in its petition. This is particularly problematic because even though the same claim construction standard applies in both forums, petitioner makes no effort to justify the abandonment of its indefiniteness means-plus-function district-court construction and the contradictions in its approach here. Instead, petitioner ignores that issue altogether in the petition. Petitioner's failure

to "take ownership" of its competing and contradictory claim constructions here and in the district court is sufficient reason alone to reject the Petition in its entirety. In *Carefusion Corporation v. Baxter International*, the Board found that this approach was insufficient and denied institution:

> We agree with Patent Owner that Petitioner has failed to provide a sufficient statement of how the challenged claims are to be construed as required by 37 C.F.R. § 42.104(b)(3). Petitioner states that it relies on constructions advanced by Patent Owner in the related litigation; remarkably, however, Petitioner also states that it does not agree that those constructions are in fact correct. *See* Petition at 9. *As such, Petitioner has failed to indicate that it agrees with, proposes, or adopts the constructions attributed to Patent Owner. See Toyota Motor Corp. v. Blitzsafe Texas, LLC,* Case IPR2016-00422, slip op. at 26–27 (P.T.A.B. Jul. 6, 2016) (Paper 12).

Carefusion Corporation v. Baxter International, Inc., IPR2016-01456, Paper 9 at 7 (P.T.A.B. Feb. 6, 2017) (emphasis added)

Further, in *Carefusion Corp*., the Board saw through petitioner's equivocating on indefiniteness in the district court and purportedly agreeing with the patent owner's position, noting that petitioner failed to identify "the structure, material, or acts corresponding to the claimed function" and holding that "[p]etitioner's assertion that the claim terms are indefinite [in the district court] does *not* excuse [p]etitioner's failure to provide the required claim construction" under 37 C.F.R. § 42.104(b)(3). *Carefusion Corporation,* IPR2016-01456, Paper 9 at 8-9.

Petitioner here certainly does not "agree" with its proposed constructions, nor does it "adopt" those constructions other than for the "purposes of this IPR only." Petitioner's failure to address its district court means-plus-function and indefiniteness construction and the ambiguities in its positions here, and failure to identify corresponding structure warrant denial of the petition.

Indeed, Samsung's petition —where there is no stipulated construction, no Board-sanctioned claim construction, no citations to the '407 patent, and no argument or explanation in favor of the constructions presented—is a model of how *not* to meet the standard set forth in § 42.104(b)(3). This is reason enough to deny the petition in its entirety.

VII. PETITIONER HAS FAILED TO SHOW A REASONABLE LIKELIHOOD OF SUCCESS FOR ANY OF GROUNDS 1A, 1B, 1C AND 2.

A. Petitioner does not explain defect in prior consideration of Brown.

First, it is important to recognize that Brown was expressly considered by the Patent Examiner during prosecution of the application that resulted in the '407 Patent. Ex. 2004 pages 1 and 2. Each IDS disclosing these references has a sentence added by Examiner, which he initialed, that "All references considered except where lined through." Ex. 2004 pages 1 and 2. Petitioner tries to minimize this critical fact by arguing that "[i]ndeed, during prosecution, the examiner did not consider Brown" and that the Brown reference was "not utilized by the Examiner."

Petition at 7 and 104. But the references only would have been "utilized by the Examiner," if Examiner concluded after his consideration that the references invalidated the claims. Petition at 7 and 104. The fact that Examiner did not reject the claims in light of these references strongly bolsters the validity of the claims, rather than undermining it.

Second, the Petitioner has made no argument as to why the Examiner made an error. *See Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7-9 (PTAB Feb. 13, 2020) (precedential) (holding "[i]f the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.")

For the foregoing reasons the board should deny institution of an IPR. This defect affects all claims under Grounds 1A, 1B and 1C, and this is reason enough to deny the petition in its entirety when considered with the argument presented below for Ground 2.

B. Petitioner fails to demonstrate how a local HTML file in Shimada that includes content that is presented on an alleged NIM meets "a content reference that comprises a network location at which content for the first networked information monitor is accessible via a TCP/IP protocol."

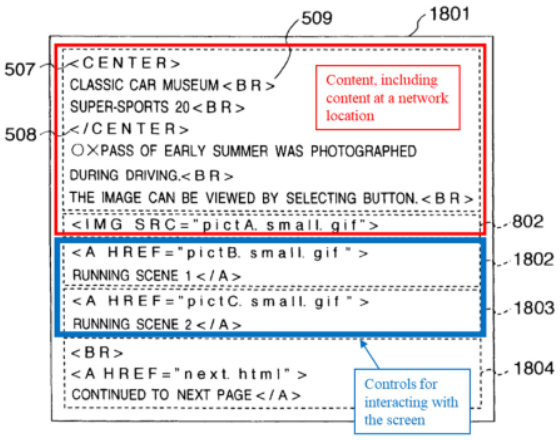
Petitioner fails to demonstrate how a *local* HTML file of Shimada that includes *content that is presented* on an alleged NIM meets "transmission, over a network to a web server at a network location, of a content request for content to

be displayed within the frame of the viewer graphical user interface defined by the networked information monitor template," as all challenged claims require. The issue turns on the disclosed components of Shimada in the HTML file being local references, which precludes accessing the content over a network to a web server at a network location later time. *See* Petition at 83.

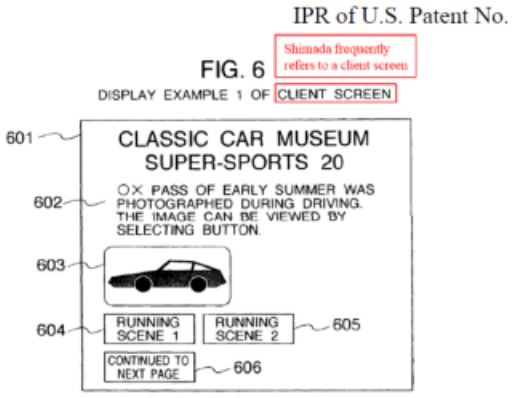
First, petitioners argue that a local HTML file teaches a NIM template. Petition at 71,78. But the HTML file of Shimada includes *content that is presented* and *controls for interacting with the screen* in the *same file*. *Id*. This is contrary to what the patentee describes in the '407 patent specification. The specification of the '407 patent states, "the applications server 50 retrieves the NIM definition from the NIM template database 74 using the NIM ID, in step 242, and provides it to the client 20 in step 243. The client 20 receives the NIM definition from the applications server 50 in step 244, and the client parser application 38 creates a frame in the display of the user interface 42 in step 245. In step 246, the client 20 requests the necessary content elements 94 stored at the URLs identified in the NIM definition from the corresponding content server 82. The content server 82 transmits the content 94 in step 247, and in step 248 the client parser application 38 places the content in the viewer, which is enclosed by the frame, allowing the user to preview the NIM." Ex. 1001 at 20:18-30.

In the independent claim, the NIM *template* is separate and independent from content retrieved "from a network" based on the URL identified in the NIM template.'407 patent, claim 1. Therefore, the HTML file of Shimada cannot be "a NIM template" because the content that is presented is already in the HTML file.

Second, Shimada does not teach a NIM template that comprises the "one or more content references" that comprise one or more uniform resource locators at which content for the networked information monitor is accessible over a network."



Petition at 71, 78.



SAMSUNG-1008, FIG. 6 (annotated)

Petition at 88.

In the HTML file shown above, the images are stored locally and retrieved via a relative URL, are referenced with <A HREF ="pictA.small.gif ">. Petition at 71,78. The locally stored information is not and cannot be retrieved "from a network." Petition at 71,78.

For example, a relative tag retrieves locally stored images/files:

Example

Add left and right margins to image (with CSS):

```
<img src="smiley.gif" alt="Smiley face" width="42" height="42" style="vertical-align:middle;margin:0px 50px">
```

Try it Yourself »

See https://www.w3schools.com/tags/tag_img.asp

In contrast, an absolute URL retrieves information from a network:



See id.

As shown above, in Fig. 6 of Shimada's HTML file, the images are shown as being retrieved via a relative URL and are referenced with <A HREF ="pictA.small.gif "">. The relative URLs fetch information that is locally-stored information and does not and cannot be retrieved "from a network."

In fact, every *single content* shown in Fig 17 of Shimada is locally located including "CLASSIC CAR MUSEUM, SUPER SPORTS", "PASS OF EARLY SUMMER WAS PHOTOGRAPHED", "DURING DRIVING", "THE IMAGE CAN BE VIEWED BY SELECTING THE BUTTON", "pictA.small.gif", "pictB.small.gif", and "pictC.small.gif." Petition at 71, 78. Therefore, Shimada does not and cannot teach, "transmission, over a network to a web server at a network location, of a content request for content to be displayed within the frame of the viewer graphical user interface defined by the networked information monitor template."

This defect affects all claims under Ground 2. The Petitioner has therefore not met its burden to establish a likelihood that it will prevail on Ground 2.

VIII. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE BOARD UNDER 35 U.S.C. § 314(A).

Samsung's petition should be denied because instituting an IPR of the same patent in the parallel WDTX litigation will waste significant Board and court resources:

- Duplication of efforts will occur because the lawsuit against Samsung is not stayed and, in fact, Samsung has not even moved for a stay.
- The WDTX litigation is set for trial on June 24, 2024, months before the Board issues any hypothetical final written decision stemming from this petition.
- DoDots, petitioner and the district court have already expended significant resources in the WDTX litigation. The parties have exchanged preliminary infringement contentions, invalidity contentions, completed discovery related to venue and briefed a transfer-of-venue motion, completed briefing on claim construction for which a hearing will held on July 27, 2023, served initial disclosures, document requests and interrogatories, entered a

protective order and are presently negotiating source code review, which will commence shortly.

- Moreover, Petitioner did not submit a *Sotera* stipulation. Instead, Petitioner only claims "not to pursue primary references asserted in this Petition (*i.e.,* Brown and Shimada) in the co-pending litigation," thereby highlighting a strategy of trying to avoid the statutory estoppel provisions. Petition at 99.

These facts warrant a denial of institution.

In determining whether to discretionarily deny institution based on these facts, the Board is to consider the presence and status of parallel district court litigation. *NHK Spring Co., Ltd. v. Intri-plex Technologies*, IPR2018-00752, Paper 8, 11 (P.T.A.B. 2018) (precedential); *Apple Inc. v. Fintiv, Inc*., IPR2020-00019, Paper 11 (P.T.A.B. 2020) (precedential) ("Fintiv"). *Fintiv* sets forth a non-exhaustive list of factors that balance system efficiency and fairness considerations when considering discretionary denial. *See* Fintiv at 5−6. The factors are:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;

2. Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;

3. Investment in the parallel proceeding by the court and the parties;

4. Overlap between issues raised in the petition and in the parallel proceeding;

5. Whether the petitioner and the defendant in the parallel proceeding are the same party; and

6. Other circumstances that impact the Board's exercise of discretion, including the merits. *Id*.

Additionally, the *Fintiv* factors should be considered in view of the guidance provided in the June 21, 2022 Memo Regarding Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation. ("Fintiv Memo"). *See* Ex. 2005.

As demonstrated below, each of the *Fintiv* factors favors a denial of institution.

A. The district court case is not stayed nor is there any evidence that a stay will be granted if the IPR were instituted.

Samsung has not sought to stay the district court litigation. And there is no indication that the court will grant any stay, if one is sought. This factor, therefore, weighs against institution.

B. Proximity of the district court's trial date to the Board's projected statutory deadline for a final written decision.

The Western District of Texas issued its scheduling order on December 29, 2022 and set trial for in June 24, 2024. Ex. 2006. Pursuant to 35 U.S.C. §

316(a)(11), the projected statutory deadline for a final written decision is in at least August or September 2024, two-three months later. Because the district court trial will proceed well before the expected final written decision date, this factor favors denial of institution. *Google, LLC. v. Personalized Media Comm., LLC*., IPR2020-00723, Paper 22, 7 (P.T.A.B. 2020); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude "several months," before a final decision would be due); *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 8 (P.T.A.B. May 15, 2020) ("Because the trial date is substantially earlier than the projected statutory deadline for the Board's final decision, this factor weighs in favor of discretionary denial.")

C. Both the district court and the parties have made significant investments in the parallel district court case.

Under the third *Fintiv* factor, the Board is to "consider[] the amount and type of work already completed in the parallel litigation by the Court and the parties at the time of the institution decision." *Fintiv* at 9.

Patent owner, petitioner, co-defendant Apple, and the WDTX Court have all spent significant resources on the asserted patents including the '407 patent. Fact discovery is ongoing in WDTX, with both parties having already exchanged their initial disclosures, and first set of document requests and interrogatories, and

entered into a protective order. Samsung has also produced a portion of its relevant source code, which DoDots has already started reviewing. The parties have also fully briefed a motion to transfer venue from WDTX to NDCA (which the Court denied) and claim construction arguments were heard on July 27, 2023. In fact, the Court has already issued its claim construction ruling. Indeed, the parties have been litigating this case for approximately fifteen months.

The parties' and the district court's substantial investment in the district court litigation favors denial of institution. *See Canadian Solar Inc. v. The Solaria Corporation*, IPR2021-00095, Paper 12, 11 (P.T.A.B. 2021).

D. There is significant overlap between the issues raised in the petition and in the parallel district court case.

Under the fourth factor, as the Board found in *Fintiv*, "if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial." *Fintiv* at 12.

Invalidity issues related to the '407 patent are already being litigated in WDTX. Samsung's invalidity contentions already set forth the grounds raised in this petition. And by failing to submit a *Sotera* stipulation, Samsung has done nothing to mitigate concerns of potentially conflicting decisions and duplicative efforts between the district court and the Board. *Sotera Wireless, Inc. v. Masimo*

Corp., IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020) (precedential). In fact, in its petition, Samsung only agreed "not to pursue primary references asserted in this Petition (i.e., Brown and Shimada) in the co-pending litigation." Petition at 104. Petitioner remains silent with respect to any ground that reasonably could have been raised. These circumstances evidence Petitioner's scheme to avoid the statutory estoppel provisions and favor denial of institution. *See Sand Rev'n II LLC v. Cont'l Intermodal Grp. – Trucking LLC*, IPR2019- 01393, Paper 24, 7 (P.T.A.B. 2020) (informative); *Sotera* at 19; *Fintiv* at 18 (weighing Factor 4 in favor of denial of institution based on "concerns of inefficiency and the possibility of conflicting decisions.")

E. Petitioner and defendant in the parallel litigation are the same party.

Petitioner is the defendant in the WDTX case. Moreover, all the arguments Samsung raises in its petition are also raised in the parallel district court litigation. For this reason, this factor favors denial of institution.

F. Other circumstances favor the Board exercising its discretion to deny institution, including the merits.

The Board is to consider the merits of a petitioner's challenge when determining whether to institute a post-grant proceeding in view of parallel district court litigation. As explained in the sections above, for various individual reasons, Petitioner has failed to meet its burden under 37 C.F.R. §§ 42.100 and 104 of

establishing a reasonable likelihood of success that any of the challenged claims are unpatentable. Petitioner's failings and the significant risk of wasting judicial and Board resources all point to this additional factor as favoring denial of institution.

In sum, each of the *Fintiv* factors weigh in favor of denying institution, and the Board should exercise its discretion in accordance therewith.

IX. CONCLUSION.

For the foregoing reasons, patent owner respectfully requests the Board to deny institution of the petition in its entirety.

Dated: August 10, 2023

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,510,407 specified in 37 C.F.R. § 42.24 has 6,665 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

Dated: August 10, 2023

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE was served electronically via email on August 10, 2023, on the following counsel of record for Petitioner:

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