

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.

IPR2023-00701
Patent 8,510,407 B1

Before HUBERT C. LORIN, AMBER L. HAGY, and SHARON FENICK,
Administrative Patent Judges.

FENICK, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

Samsung Electronics Co., Ltd. (“Petitioner”) filed a petition for *inter partes* review challenging claims 1–24 (“challenged claims”) of U.S. Patent 8,510,407 B1 (Ex. 1001 (“the ’407 patent”)). Paper 2 (“Pet.” or “Petition”). DoDots Licensing Solutions LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With the Board’s authorization (Paper 7), Petitioner filed a Preliminary Reply (Paper 8, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 9, “Prelim. Sur-reply”). The Board has authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a).

Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the Petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we institute an *inter partes* review as to the challenged claims of the ’407 patent on all grounds of unpatentability presented.

B. *Real Parties in Interest*

Petitioner identifies Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc., as the real parties in interest. Pet. 105.

Patent Owner identifies only itself as the real party in interest. Paper 3 (Patent Owner’s Mandatory Notices), 1.

C. *Related Matters*

Petitioner identifies the following proceeding as a related matter: *DoDots Licensing Solutions LLC v. Samsung Electronics Co., Ltd.*, 6:22-cv-00535 (W.D. Tex.) (“the related district court litigation”). Pet. 105–

106. Petitioner additionally notes that the patent was the subject of *inter partes* review proceeding IPR2019-01279. *Id.* at 106.

Patent Owner also cites Western District of Texas case 6:22-cv-00535 as related and additionally identifies as related *DoDots Licensing Solutions LLC v. Apple Inc.*, CA No. 6:22-cv-00533 (W.D. Tex. May 24, 2022). Paper 3, 1–2.

D. The '407 Patent

The title of the '407 patent is “Displaying Time-Varying Internet Based Data Using Application Media Packages.” Ex. 1001, code (54). The '407 patent discloses, in part, a software component for accessing and displaying network content. *Id.* at code (57). This component, termed a Networked Information Monitor (NIM) is a “fully configurable frame with one or more controls” with content optionally presented through the frame. *Id.* at 2:61–63, 5:21–24. When a NIM is opened by a user, the frame is presented in the user’s display and network content is retrieved and presented in a viewer enclosed by the frame. *Id.* at 19:63–20:30. The network content may be identified via URLs (uniform resource locators) included in the NIM definition. *Id.* at code (57), 20:24–27. The network content is time-varying, e.g., as in an image that varies over time. *Id.* at code (57). 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.* at 5:24–28.

Figure 9B, reproduced immediately below, illustrates a pack, that is a customized arrangement of NIMs created by a user. *Id.* at 3:50–51, 16:10–29,

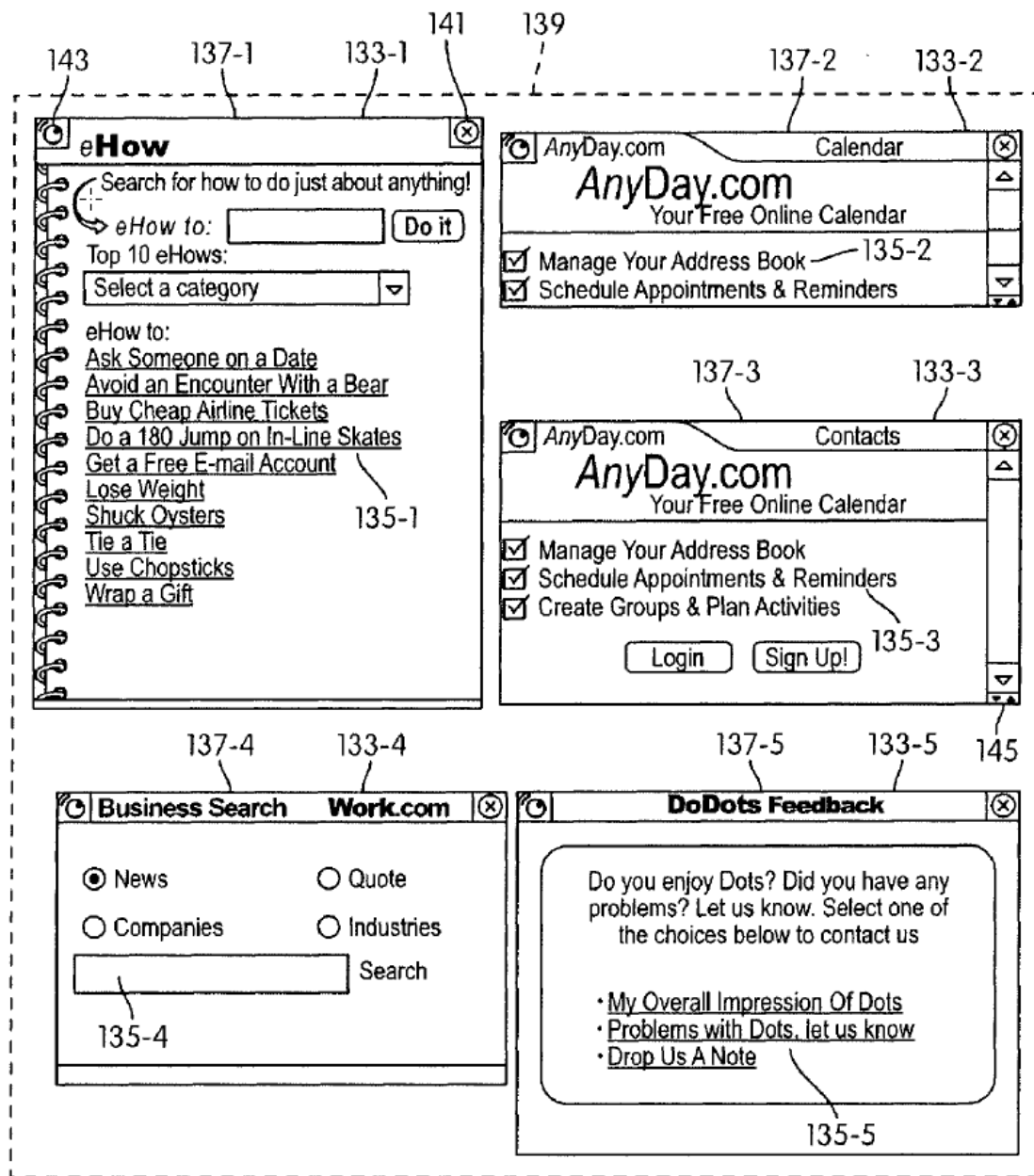


FIG. 9B

Figure 9B illustrates pack 139, which includes five NIMs 133-1 through 133-5. *Id.* at 16:65–66. Each NIM 133 includes viewer 135 for viewing

content and frame 137 for providing user functionality. *Id.* at 16:66–17:1. Frame 137 for each NIM 133 provides functions and controls for manipulating the visual manifestation of NIM 133, for example dismiss button 141 that can be used to dismiss the NIM, menu button 143 that causes a menu to appear, control button 145 that can resize the NIM, and forward and backward controls. *Id.* at 17:16–43, 22:24–61. Content may be retrieved from content servers via URLs identified in the NIM definition for placement in the NIM frame. *Id.* at 21:21–31.

Figure 11, reproduced immediately below, is a flow chart of steps taken to present a NIM to a user. *Id.* at 3:56–58, 20:7–8.

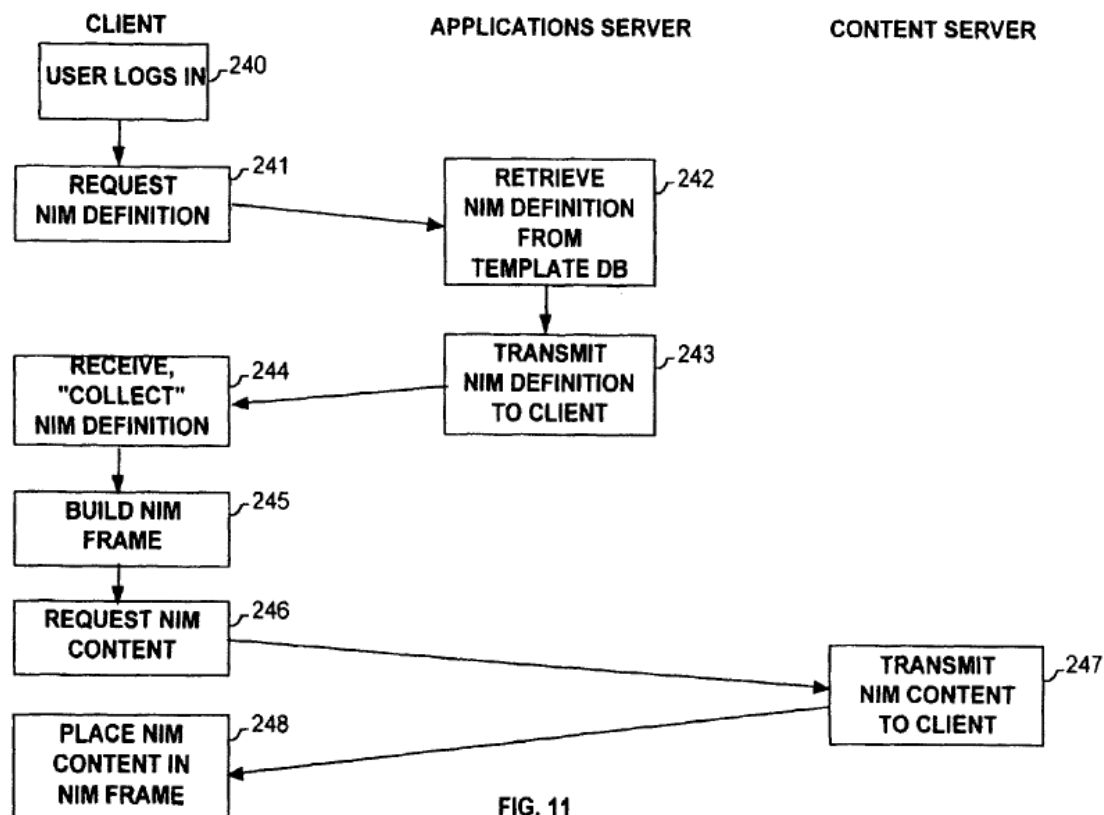


Figure 11 depicts a user's client device making requests to an applications server and a content server, leading to the display of a NIM. *Id.* at 20:7–30.

The applications server responds to a request by the user's client for a NIM definition and transmits it to the client. *Id.* at 20:18–23. The client requests the necessary content elements from the URLs in the NIM definition from the corresponding content server that supplies them to the client. *Id.* at 20:24–30. The client creates the NIM frame and places the content in a viewer within the frame. *Id.* at 20:23–24, 20:28–32. This allows the user to preview the NIM or to “collect” it (add it to their user profile), and to interact with the NIM as displayed. *Id.* at 14:20–35, 19:51–60, 20:30–46, 20:66–21:4.

E. Illustrative Claim

Claims 1 and 13 are the two independent claims among the challenged claims. Claim 1 is reproduced below with Petitioner's limitation designations added in brackets for ease of reference:

1. A client computing device configured to access content over a network, the client computing device comprising:

[1.1] electronic storage configured to store networked information monitor template associated with a networked information monitor, the networked information monitor template having therein a definition of a viewer graphical user interface having a frame within which time-varying content in a web browser-readable language may be presented on a display associated with the client computing device, wherein the frame of the viewer graphical user interface lacks controls for enabling a user to specify a network location at which content for the networked information monitor is available; and

[1.2] one or more processors configured to execute one or more computer program modules, the one or more computer program modules being configured to access the networked information monitor defined by the networked information monitor template, wherein

accessing the networked information monitor defined by the networked information monitor template results in:

- [1.3] 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;
- [1.4] reception, over the network from the web server at the network location, of content transmitted from the web server in response to the content request, the content being time-varying;
- [1.5] presentation, on the display, of the viewer graphical user interface defined by the networked information monitor template outside of and separate from any graphical user interface of any other application; and
- [1.6] presentation, on the display within the frame of the viewer graphical user interface defined by the networked information monitor, of the time-varying content received from the web server.

Ex. 1001, 42:28–64.

F. Evidence

Petitioner relies on the following references:

Reference	Description	Exhibit
Beer	US 5,793,368	Ex. 1007
Buchholz et al. (“Buchholz”)	US 6,088,340	Ex. 1009
Brown et al. (“Brown”)	US 6,278,448 B1	Ex. 1005
Wecker et al. (“Wecker”)	US 6,449,638 B1	Ex. 1006
Shimada et al. (“Shimada”)	US 6,789,263 B1	Ex. 1008

Petitioner additionally relies on a declaration of Douglas C. Schmidt (Ex. 1003).

G. Asserted Grounds

Petitioner asserts that claims 1–24 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1–4, 7–11, 13–16, 19–23	103	Brown
1–4, 7–16, 19–23	103	Brown, Wecker
5, 6, 17, 18	103	Brown, Beer
5, 6, 17, 18	103	Brown, Wecker, Beer
1–24	103	Shimada, Buchholz

II. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)

Patent Owner argues that we should exercise discretion to deny institution under 35 U.S.C. § 314(a) because the factors identified in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”), weigh in favor of denying institution. Prelim. Resp. 26–32; Prelim. Sur-reply 7. Petitioner argues we should not discretionarily deny institution under *Fintiv*. Pet. 103–104; Prelim. Reply 6–7.

The precedential decision in *Fintiv* identifies a non-exclusive list of factors parties may consider addressing where there is a related, parallel district court action to determine whether such action provides any basis for discretionary denial. *Fintiv*, 5–16. Those factors include:

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

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. Because the claims at issue have an effective filing date prior to the effective date of the AIA’s amendments to 35 U.S.C. § 103, we apply the pre-AIA version of § 103 in this Decision. *See* Ex. 1001, codes (22), (63).

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. at 5–6.

In evaluating the factors, we take a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review. *Id.* at 6. The Director has issued additional guidance on the application of *Fintiv*. See Katherine K. Vidal, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022) (“*Fintiv* Memo”). Additionally, we are guided by the precedential decisions of the Director in *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102, 49–50 (Oct. 4, 2022) (precedential), and *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 (Feb. 27, 2023) (precedential) (“*CommScope*”).

We are instructed to consider compelling merits under *Fintiv* factor six only after a determination that the first five *Fintiv* factors favor discretionary denial. *CommScope*, 4–5. Thus, we begin by considering the first five *Fintiv* factors.²

² While *Fintiv* factor six encompasses considerations other than compelling merits, neither party has argued such considerations exist in this case.

A. First Five Fintiv Factors

1. *Whether a Stay Exists or Is Likely to Be Granted if a Proceeding Is Instituted*

“A district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts.” *Fintiv*, 6. *Fintiv* indicated that, in previous Board decisions, the existence of a district court stay pending Board resolution of an *inter partes* review has weighed strongly against discretionary denial, while a denial of such a stay request sometimes weighs in favor of discretionary denial. *Id.* at 6–8.

Petitioner argues that this factor “is neutral because neither party has requested a stay.” Pet. 103. Petitioner further contends that the Board generally declines to predict outcomes of possible future stay requests. Prelim. Reply 6.

Patent Owner argues that this factor weighs against institution, because Petitioner “has not sought to stay the district court litigation” and because “there is no indication that the court will grant any stay, if one is sought.” Prelim. Resp. 28.

Because, “[i]n the absence of specific evidence, we will not attempt to predict” whether a district court would stay “based on a variety of circumstances and facts beyond our control and to which the Board is not privy,” we find this factor to be neutral. *See Sand Revolution II, LLC v. Cont’l Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative) (“*Sand Revolution*”).

2. *Proximity of the Court’s Trial Date to the Board’s Projected Statutory Deadline*

The proximity factor in *Fintiv* asks us to evaluate our discretion in light of a trial date that has been set in a parallel litigation. *See Fintiv*, 3, 5

(“*NHK* applies to the situation where the district court has set a trial date to occur earlier than the Board’s deadline to issue a final written decision in an instituted proceeding.”; “When the patent owner raises an argument for discretionary denial under *NHK* due to an earlier trial date, the Board’s decisions have balanced the following factors”) (citing *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”)).

As noted above in the discussion of the first factor, *Fintiv* cites concern regarding “inefficiency and duplication of efforts.” *Id.* at 6. In its analysis of the proximity factor, *Fintiv* echoes that concern in its guidance that “[i]f the court’s trial date is at or around the same time as the projected statutory deadline or even significantly after the projected statutory deadline, the decision whether to institute will likely implicate other factors discussed herein, such as the resources that have been invested in the parallel proceeding.” *Id.* at 9. Similarly, in *NHK*, the Board expressed concern that a trial before the deadline for a final written decision addressing the same prior art and arguments would have undermined the Board’s objectives of providing an effective and efficient alternative to district court litigation. *See NHK*, 20 (citing *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017) (precedential)).

We are instructed that

when analyzing the proximity of the court’s trial date under factor two of *Fintiv*, when other relevant factors weigh against exercising discretion to deny institution or are neutral, the proximity to trial should not alone outweigh all of those other factors. Parties may present evidence regarding the most recent statistics on median time-to-trial for civil actions in the district court in which the parallel litigation resides for the PTAB’s

consideration. Where the parties rely on time-to-trial statistics, the PTAB will also consider additional supporting factors such as the number of cases before the judge in the parallel litigation and the speed and availability of other case dispositions.

Fintiv Memo, 8–9 (internal citations and footnote deleted).

Petitioner argues this factor

weighs against discretionary denial. The projected statutory deadline for the PTAB’s Final Written Decision (FWD) is September 2024. The trial date in the co-pending litigation is currently set for June 24, 2024. . . . [T]he District Court’s median time from filing to trial was recently calculated as 28.9 months, yielding an estimated trial date in October 2024, which falls after the expected FWD date of September 2024. . . . Samsung’s Motion to Transfer Venue that was recently filed in W.D. Tex., if successful, will further ensure that the FWD far outpaces any trial date.

Pet. 103–104.

Patent Owner argues:

The Western District of Texas issued its scheduling order on December 29, 2022 setting trial for in June 24, 2024. . . . [T]he 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.

Prelim. Resp. 28–29. Patent Owner additionally asserts that the motion to transfer was denied, and additionally “a Markman Order has been issued and fact discovery has commenced in earnest.” Prelim. Sur-reply 7.

Additionally Patent Owner contends “in a July 27, 2023 Order, the Court reiterated that, while some discovery dates will be moved, the June 24, 2024 trial date will not change.” *Id.* (citing Ex. 2008).

The trial date set by the court in the related district court litigation is approximately four months before an anticipated final written decision in this case. However, we are instructed to consider the median-time-to-trial data. In this case, we determine that this factor should be considered to be neutral.

3. *Investment in the Parallel Proceeding by the Court and Parties*

If, at the time of the institution decision, the district court has issued substantive orders related to the challenged patent, such as a claim construction order, this fact weighs in favor of denial. *See Fintiv*, 9–10. On the other hand, if the district court has not issued such orders, this fact weighs against discretionary denial. *Id.* at 10. *Fintiv* also directs us to consider whether “the petitioner filed the petition expeditiously.” *Id.* at 11.

In the Petition, Petitioner argues this factor

weighs against discretionary denial because co-pending litigation is in its early stages and investment in the case has been minimal. Moreover, the institution decision will likely issue before fact discovery, expert discovery, and expert reports are complete. If an IPR is instituted, subsequent investments in the district court proceeding can further be minimized (*e.g.*, through a motion to stay pending IPR and [Petitioner’s] stipulation).

Pet. 104. Petitioner additionally argues that the resources expended at the time of its Preliminary Reply “remain[] low” and “mostly relate[] to claim construction.” Prelim. Reply 7. Petitioner additionally argues its diligence in filing the Petition provides further weight against discretionary denial in considering this factor. *Id.*

Patent Owner argues in its Preliminary Response:

Patent [O]wner, [P]etitioner, 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, . . . first set of document requests and interrogatories, and entered into a protective order. [Petitioner] has also produced a portion of its relevant source code, which [Patent Owner] 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 fourteen months.

The parties' and the district court's substantial investment in the district court litigation favors denial of institution. Prelim. Resp. 29–30. In its Preliminary Sur-reply, Patent Owner asserts that after the Markman order issued, “both parties pushed forward with discovery” and that “[b]ased on the current posture of the litigation, [Patent Owner] has started expending significant resources, including reviewing [Petitioner's] source code over the last three weeks. Both parties have also collected and intend to produce extensive documents as part of fact discovery.” Prelim. Sur-reply 7.

We are mindful of the investment of the district court, and of the parties, to date, especially the holding of a Markman hearing and the issuance of a Markman order. On the other hand, on the record before us, the filing of the Petition was expeditious. Based on the information presented, moreover, discovery is in its early stages, as even Patent Owner acknowledges in arguing that a “first set of document requests and interrogatories” have been exchanged and documents have been collected and are “intended” to be produced. Prelim. Resp. 29; Prelim. Sur-reply 7.

We determine this factor weighs slightly against exercising discretion to deny institution.

4. *Overlap Between Issues Raised in the Petition
and in the Parallel Proceeding*

“[I]f 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*, 12. “Conversely, if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution under *NHK*.” *Id.* at 12–13. A stipulation as in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential as to § II.A), if one is entered, would be highly relevant. “Consistent with *Sotera Wireless, Inc.*, the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.” *Fintiv* Memo 3 (footnote omitted).

Petitioner argues this factor “weighs against discretionary denial. If this Petition is instituted, Petitioner stipulates not to pursue primary references asserted in this Petition (*i.e.*, Brown and Shimada) in the co-pending litigation.” Pet. 104.

Patent Owner argues, without citation to the record, that

[i]nvalidity issues related to the ’407 patent are already being litigated in WDTX. [Petitioner]’s invalidity contentions already set forth the grounds raised in this petition.

Prelim. Resp. 30. Patent Owner additionally argues that Petitioner has “fail[ed] to submit a *Sotera* stipulation” and thus “has done nothing to mitigate concerns of potentially conflicting decisions and duplicative efforts between the district court and the Board.” *Id.* at 30.

While not a *Sotera* stipulation, Petitioner’s stipulation appears to be similar to that in *Sand Revolution*. See *Sand Revolution*, 11–12 (finding that a stipulation not to pursue the same grounds in the parallel litigation “mitigates to some degree the concerns of duplicative efforts”). We recognize that this stipulation is narrower in scope than a *Sotera*-type stipulation. However, Petitioner’s stipulation still reduces potential overlap with the district court litigation. In *Sand Revolution*, such a stipulation weighed marginally against exercising discretion to deny institution. *Id.* at 12.

We determine this factor weighs slightly against exercising discretion to deny institution.

5. *Whether the Petitioner and the Defendant in the Parallel Proceeding Are the Same Party*

If the petitioner is unrelated to the defendant in the parallel proceeding, that might weigh against discretionary denial. See *Fintiv*, 13–14.

Petitioner and Patent Owner each agree that Petitioner is a defendant in the co-pending litigation. Pet. 104; Prelim. Resp. 31.

As with *Fintiv* factor 2, therefore, this factor is neutral with respect to our exercise of discretion to deny the Petition.

B. *Conclusion*

We have considered the circumstances and facts before us in view of the first five *Fintiv* factors. Because our analysis is fact-driven, no single factor is determinative of our conclusion. Considering these five *Fintiv* factors together, we determine that they do not favor a discretionary denial.

As we do not find that the first five *Fintiv* factors favor discretionary denial, we therefore do not make a determination regarding compelling

merits under *Fintiv* factor 6, and our consideration ends with this conclusion. *CommScope*, 4–5.

III. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 325(d)

Patent Owner contends that Petitioner does not explain a “defect in [the] prior consideration of Brown” and argues as follows

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.”).

Prelim. Resp. 20–21. We interpret Patent Owner’s argument as a request that the Board exercise its discretion to deny institution under § 325(d).

A. Legal Standards

35 U.S.C. § 325(d) states, in pertinent part, that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the

petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”

The Board uses a two-part framework for evaluating arguments under § 325(d):

- (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and
- (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”). “[T]he *Becton, Dickinson* factors provide useful insight into how to apply the framework under 35 U.S.C. § 325(d).” *Id.* at 9 (footnote omitted). The non-exclusive *Becton, Dickinson* factors are:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton, Dickinson*”). *Becton, Dickinson* factors (a), (b), and (d) relate to the first part of the *Advanced Bionics* framework (whether the same or substantially the same art or arguments previously were presented to the Office), and *Becton, Dickinson* factors (c), (e), and (f) relate to the second part of that framework (previous Office error). *Advanced Bionics*, 9–11. Only if the same or substantially the same art or arguments were previously presented to the Office do we then consider whether the petitioner has demonstrated a material error by the Office. *Id.*

Under § 325(d), the art or arguments must have been previously presented to the Office during proceedings, such as examination of the underlying patent application, pertaining to the challenged patent. *Advanced Bionics*, 7. Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (“IDS”), in the prosecution history of the challenged patent. *Id.* at 7–8.

B. Analysis

Patent Owner contends that Brown was “expressly considered by the Patent Examiner during prosecution of the application that resulted in the ‘407 Patent.” Prelim. Resp. 20.

The only evidence provided showing Brown was “expressly considered” is in an IDS. Ex. 2004³ (cited at Prelim Resp. 20). This IDS

³ Exhibit 2004 consists of three excerpts from the file history of the application that issued as the ‘407 patent. That file history was submitted as Exhibit 1002. Page 1 of Exhibit 2004 can be found on page 90 of Exhibit 1002. Page 2 of Exhibit 2004 can be found on page 94 of Exhibit 1002.

has been initialed as an indication that the references were considered. Ex. 1002, 90. It also appears that, in this IDS, the applicant described Brown as having been cited in a co-pending application. *Id.* at 100. Patent Owner does not assert, nor can we discern in the record, that the substance of Brown was discussed by the Office or the Patent Owner. *See* Pet. 105.

Although Brown was not the basis of any rejection of the claims, its listing in an initialed IDS supports a conclusion that this reference was previously presented and considered during prosecution. *See Advanced Bionics*, 7–8 (noting that art made of record includes prior art identified in an IDS).

However, the Petition includes grounds that include other art along with Brown, which was not before the Examiner, asserting obviousness of certain claims over a combination of Brown and Wecker, Brown and Beer, and Brown, Wecker, and Beer. Pet. 1, 8–65. While Wecker is apparently included in combination with Brown for a “single feature” and in the alternative for claims 1–4, 7–11, 13–16 and 19–23, Petitioner does not assert that any of claims 5, 6, 12, 16, or 17 would have been obvious over Brown on its own. *Id.* at 8, 52–57, 58–65. Additionally, Petitioner includes a ground based on a combination not including Brown, that of Shimada and Buchholz. *Id.* at 1, 65–100. Patent Owner does not argue, nor do we apprehend that Wecker, Beer, Shimada, or Buchholz are cumulative of any reference cited to or by the Office.

Pages 3–5 can be found on pages 99–101 of Exhibit 1002. A second IDS, disclosing more than one hundred more references, is found on pages 144 through 147 of Exhibit 1002.

Patent Owner’s arguments, therefore, do not implicate any grounds presented in the Petition with the exception of the first ground, and do not implicate any ground asserted against claims 5, 6, 12, 17, and 18.

As discussed below, Section IV.F, we analyze Petitioner’s contentions regarding obviousness over Shimada and Buchholz and find that Petitioner has sufficiently shown, for the purposes of institution, a reasonable likelihood that it would prevail with respect to at least one of the claims challenged on a ground of obviousness over Shimada and Buchholz. We additionally find that Petitioner has sufficiently shown a reasonable likelihood with respect to claims 5, 6, 12, 17, and 18 over combinations including Brown along with Wecker and/or Beer. *See infra* § IV.E.

Accordingly, we determine that § 325(d) is not sufficiently implicated such that its statutory purpose would be undermined by institution on all challenges. We, therefore, decline to deny the Petition under § 325(d).

IV. PATENTABILITY ANALYSIS

A. *Legal Standards*

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review).

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter 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. Teleflex Inc.*, 550 U.S. 398, 406 (2007). 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) objective evidence of nonobviousness, i.e., secondary considerations.⁴ *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

“To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). We analyze the asserted grounds with the principles stated above in mind.

B. Level of Ordinary Skill in the Art

Petitioner states:

A person of ordinary skill (“POSITA”) relating to the subject matter of the ’407 Patent would have had (1) a bachelor’s degree in computer science, computer engineering, electrical engineering, or a related field, and (2) at least three years of corresponding industry work experience. Additional graduate education could substitute for professional experience, or significant experience in the field could substitute for formal education.

⁴ In the present record, neither party presents arguments or evidence relating to secondary considerations.

Pet. 5 (citing Ex. 1003 ¶¶ 20–21). Petitioner argues that additional graduate education could substitute for professional experience or vice versa. *Id.*

Patent Owner states:

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.”

Prelim. Resp. 10 (citing Ex. 1012,⁵ 8). Patent Owner agrees with this standard and argues that it is the same as the standard Petitioner proposes. *Id.*

We agree that there appear to be no significant differences. We adopt Patent Owner’s formulation of the level of skill in the art, but on the present record we would reach the same preliminary determinations under Petitioner’s formulation of the level of skill.

⁵ Patent Owner’s citation is to Exhibit 2001, which is described in Patent Owner’s exhibit list as “*Lenovo Holding Co, Inc. et al. v. DoDots Licensing Sols.*, IPR2019-01278 (P.T.A.B. Jan. 19, 2021).” Prelim. Resp. viii. However, Exhibit 2001 appears instead to be a version of *Lenovo Holding Co., Inc. v. DoDots Licensing Sols. LLC*, No. 2021-1247, 2021 WL 5822248 (Fed. Cir. 2021), which also appears in our record as Exhibit 1014 and Exhibit 2002. Exhibit 1012 is a copy of the cited Board decision. We assume this is a typographical error and we encourage the parties to cite to exhibits already in the record for clarity rather than adding additional versions, barring any issue with previously-entered exhibits.

C. *Claim Construction*

1. *Construction Statement of Dr. Schmidt (Petitioner's Declarant)*
(Ex. 1003 ¶ 26)

Patent Owner urges the Board to deny institution due to “[Petitioner’s] failure to use the correct claim construction standard (and/or contradictory use of different standards).” Prelim. Resp. 16–17.

Patent Owner contends that Petitioner has used the wrong claim construction standard because declarant Dr. Schmidt states: “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.’ 37 C.F.R. § 42.100(b).” Ex. 1003 ¶ 26 (emphasis added). Patent Owner characterizes said statement as “Dr. Schmidt *unequivocally* stat[ing] that he *use[d]* the BRI [broadest reasonable interpretation] standard to interpret the challenged claims.” Prelim. Resp. 13 (emphasis added).

According to Patent Owner, “based on Dr. Schmidt’s failure to apply the right claim construction standard, [Petitioner] necessarily cannot meet its burden of production and burden of persuasion under 37 C.F.R. 42.104(b)(3).” Prelim. Resp. 14 (citing, *inter alia*, *Dynamic Drinkware*, 800 at 1378). This is so because, according to Patent Owner, “throughout its petition, [Petitioner] 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.” *Id.* at 13. “[I]f a petitioner relies on an incorrect claim construction standard (as [Petitioner] does here), it necessarily follows that the petitioner has not properly construed the challenged claims.” *Id.* at 15. “Given [Petitioner’s] error in this regard, it is

impossible for [Petitioner] to show in its petition how the prior art it cites supposedly invalidates a properly construed claim,” in violation of 37 C.F.R. § 42.104(b)(4). *Id.* at 15–16. “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’” which “warrants denial of [Petitioner’s] petition.” *Id.* at 14.

Petitioner responds by characterizing the statement appearing in Dr. Schmidt’s Declaration that is at issue as a “typographical error” or a “typo.” Prelim. Reply 2, 3, 4 (referring to Ex. 1003 ¶ 26). According to Petitioner, “Dr. Schmidt quoted an earlier version of 37 C.F.R. § 42.100(b) with the ‘broadest reasonable construction’ language” and this is “a typographical error.” *Id.* at 2, *see also* 4 (“a single instance of a typo in Dr. Schmidt’s declaration where he was citing to 37 C.F.R. § 42.100(b).”).

In support of its characterization, Petitioner argues, *inter alia*, that the Petition “clearly explain[s] . . . [that] ‘Petitioner submits that all claim terms should be construed according to the *Phillips* standard.’” *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005); 37 C.F.R. § 42.100.” Prelim. Reply 1 (quoting Pet. 3; also citing an instance of the phrase “[u]nder the *Phillips* standard” at Pet. 3). According to Petitioner, “it is undisputed that the Petition itself is based on the correct *Phillips* standard and that Dr. Schmidt’s claim construction analysis is wholly consistent with the invalidity arguments set forth in the Petition.” *Id.* at 4. Petitioner adds that constructions for “the only claim constructions presented in Dr. Schmidt’s declaration were endorsed by the Federal Circuit under the *Phillips* standard and constructions with which [Patent Owner] agrees.” Prelim. Reply 4; *see also id.* at 3 (citing Prelim. Resp. 15–17).

Patent Owner responds, *inter alia*, that “[Petitioner’s] reply relies *solely* on attorney arguments to claim that Dr. Schmidt made a typographical error. [Petitioner] fails to provide any testimonial evidence as to the nature of the error, an explanation of how the purported error occurred, and how it was discovered.” Prelim. Sur-reply 1. Patent Owner also dismisses the impact of Petitioner’s claim construction analysis of the claim limitations “NIM” and “NIM template” on the question of whether Petitioner has used the correct claim construction standard in its analysis. “[T]hat ‘networked information monitor’ and ‘networked information monitor template’ have established constructions says nothing about Schmidt using *Phillips* when he expressly states that he used BRI in assessing the validity of the challenged claims.” *Id.* at 5. According to Patent Owner, “[t]he Petition actually uses the BRI standard to construe claims because, while it discusses the *Phillips* standard in general on page 3, the Petition relies entirely on Dr. Schmidt’s declaration for evidentiary support for each and every claim element, and Dr. Schmidt admits using BRI.” *Id.* Finally, in an apparent response to Petitioner’s contention that “Patent Owner was [not] unduly burdened by Dr. Schmidt’s typo” (Prelim. Resp. 3), Patent Owner argues that “[r]equiring [Patent Owner] to parse through Dr. Schmidt’s analysis to figure out where he got it wrong/where he may have gotten it right when his declaration only says that he used BRI is unduly prejudicial to [Patent Owner].” Prelim. Sur-reply at 4.

We have carefully considered the parties’ positions. For the following reasons, we are unpersuaded that Petitioner used the wrong claim construction standard in the analysis. Petitioner’s alleged “failure to use the correct claim construction standard” is not supported by the totality of the evidence in this case. Prelim. Resp. 16–17.

It is undisputed that the Petition states that “[a]ll claim terms should be construed according to the *Phillips* standard. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005); 37 C.F.R. §42.100.” Pet. 3. Standing alone, there is no dispute that the Petition uses the correct claim construction standard in the analysis.

It only becomes a question because Petitioner’s declarant (Dr. Schmidt) employs the phrase “broadest reasonable construction in light of the specification of the patent in which it appears” in describing his “understand[ing]” of the claim construction standard. Ex. 1003 ¶ 26.

If Dr. Schmidt’s “understand[ing]” of the claim construction standard was that BRI should be used, then it was incorrect. The claim construction standard for claims of challenged unexpired patents in this forum was changed from BRI to the *Phillips* standard in 2018, long before Dr. Schmidt signed the Declaration (Feb. 22, 2023). See “*Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*,” 83 Fed. Reg. 51340, 51340–51359, 51343 (October 11, 2018) (“This change replaces the BRI standard for construing unexpired patent claims and proposed substitute claims in IPR, PGR, and CBM proceedings with the federal court claim construction standard, which is articulated in *Phillips* and its progeny.”); 37 C.F.R. § 42.100(b).

But the Petition articulates, unequivocally, the correct claim construction standard and goes into some detail in explaining what the *Phillips* standard entails. Pet. 3–5 (citing Ex. 1003 ¶¶ 28–29). Although Petitioner cites Dr. Schmidt’s Declaration in support, a practitioner consulting the Declaration would have no difficulty understanding that the Petition uses the *Phillips* standard and the mention of “broadest reasonable

construction in light of the specification of the patent in which it appears” in the Declaration was not the one Petitioner was applying.

We also consider the fact that Dr. Schmidt’s statements are presented within the section of the Declaration devoted to construing “NIM” and “NIM template.” *See* Ex. 1003 ¶¶ 26–29. The constructions in the Declaration for these terms are those set forth in the Petition and rely “on constructions endorsed by the Federal Circuit under the *Phillips* standard.” Prelim. Reply 3. This bolsters our view that the Petition was unequivocal about using the *Phillips* standard to interpret the challenged claims, notwithstanding the Declaration’s mention of the BRI standard.

Finally, it is important to emphasize that Patent Owner does not yet address or dispute any of Petitioner’s contentions on claim construction grounds. *Cf. Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1378 (Fed. Cir. 2023) (“the Board explicitly noted that ‘Patent Owner does not yet dispute Petitioner’s contention’”). “NIM” and “NIM template” are the only claim terms for which Petitioner has proposed constructions and which Patent Owner discusses. Pet. 3–5; Prelim. Resp. 8–11. Even if we were to assume *arguendo*, as Patent Owner argues, that Petitioner used the BRI standard, Patent Owner had an opportunity, and, as we institute, will have an additional opportunity, to propose different constructions under the *Phillips* standard. *Cf. Axonics*, 75 F.4th at 1382 (“In its institution decision, following the parties’ lead, the Board construed the relevant claim terms under the [BRI] standard. . . . For the first time in the patent owner response, because the patent had expired, the patent owner proposed a different construction under the standard set forth in [*Phillips*]” (discussing *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1378 (Fed. Cir. 2018))). But, at this stage, Patent Owner has not pointed to a contention by Petitioner that it

believes relies on an allegedly incorrect construction. Patent Owner has not placed in genuine dispute, at this stage of the proceeding, the construction of any claim terms. *Cf. id.* at 1381 (“both parties had agreed to the claim construction adopted by the Board in the institution decision.”) Since Patent Owner has not proposed a different construction for any claim term at this stage, on this record, we accept Petitioner’s proposition that “[a]ll claim terms should be construed according to the *Phillips* standard.” Pet. 3.

We do not agree with Patent Owner that any confusion exists over the Petition using the correct claim construction standard. The evidence does not support Patent Owner’s contention that Petitioner “fail[ed] to use the correct claim construction standard.” Prelim. Resp. 16–17.

On this record, we find the Declaration contains an error in its statement of the claim construction standard. Ex. 1003 ¶ 26. Denying the Petition on that basis alone would be “unduly strict.” *Cf. Netflix, Inc. v. DivX, LLC*, 80 F.4th 1352, 1354 (Fed. Cir. 2023) (“The Board’s directive that Netflix more precisely articulate the relevant field of endeavor to meet its burden was unduly strict.”). To the extent that Patent Owner disagrees with our assessment on that point, Patent Owner may flesh out the issues further during trial, for example, by cross-examination of Petitioner’s declarant.

On this record, we decline to “disregard[]” Dr. Schmidt’s declaration or find that “petitioner’s entire invalidity analysis is legally flawed.” Prelim. Resp. 2.

2. *Construction of Claim Terms*

As discussed above, in interpreting the claims of the ’407 patent, we “use[e] the same claim construction standard that would be used to construe the claim[s] 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 (2022); *see also Phillips*, 415 F.3d at 1312–19.

Only those terms that are in controversy need be construed, and only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner submits constructions for “networked information monitor” and “networked information monitor template.” Pet. 3–5. Petitioner’s constructions are the same as those that the Board adopted in IPR2019-01278. *See* Ex. 1012, 9–19. This construction of “network information monitor template” was upheld by the Federal Circuit on appeal. *Lenovo Holding Co., Inc. v. DoDots Licensing Sols. LLC*, No. 2021-1247, 2021 WL 5822248 (Fed. Cir. 2021)⁶; Ex. 1014, 5–9.

Patent Owner does not present arguments against these claim constructions or suggest that we should construe these or any other claim terms. Prelim. Resp. 10–11. As addressed *supra* in Section IV.C.1, Patent Owner argues that Petitioner’s declarant has applied the wrong standard in providing opinions regarding the proper construction of the claims. *Id.*

We need not construe any claim terms at this point in the proceeding for the purpose of institution. *Nidec Motor Corp.*, 868 F.3d at 1017. However, we note certain of Petitioner’s arguments that relate to the

⁶ We use the version included in the record as Exhibit 1014 for its pagination.

constructions of “networked information monitor” and “networked information monitor template” adopted in IPR2019-01278. *See infra* § IV.D.3.

3. 37 C.F.R. § 42.104(b)(3)

Patent Owner additionally argues that Petitioner has failed to properly identify corresponding structure for a means-plus-function claim limitation, in violation of 37 C.F.R. § 42.104(b)(3). Prelim. Resp. 17–20. Patent Owner argues that, despite taking a position in the related district court litigation that the “computer program modules being configured to access the networked information monitor defined by the networked information monitor template” in limitation 1.2 of claim 1 should be interpreted as a means-plus-function claim element, Petitioner did not identify in its Petition corresponding structure in the specification. *Id.* at 17 (citing Ex. 2003, 4). Patent Owner argues that “nothing precludes [Petitioner] from arguing the [’407] claims contain means-plus-function limitations at the district court.” Prelim. Sur-reply 6–7. Patent Owner additionally argues that Petitioner’s preliminary identification of this claim term as indefinite in the related district court litigation is inconsistent with its position before us that it is definite. Prelim. Resp. 18.

Petitioner contends, in response, that it has not advanced an argument that means-plus-function treatment should be accorded to any claim limitation; and that while it indicated such treatment in initial claim construction pleadings, it did not in the revised constructions submitted to the district court. Prelim. Reply 5 (citing Ex. 1021).

Whether Petitioner could, in the future, argue that limitation 1.2 of claim 1 is a means-plus-function claim limitation in the related district court litigation, Petitioner did not include this in the joint filing listing terms in

dispute in that case. Ex. 1024. Petitioner also does not argue that limitation 1.2 of claim 1 is a means-plus-function claim limitation before us, and on the present record, we do not determine that it is. This distinguishes the case before us from the non-designated cases Patent Owner cites to (Prelim. Resp. 17–18), in which (a) a petitioner identified a claim term as requiring means-plus-function claim construction but did not identify a corresponding structure,⁷ (b) the panel independently determined a limitation to require means-plus-function construction, due to “means for” terminology, but the petitioner did not identify a corresponding structure,⁸ or (c) a petitioner did identify a claim term as requiring means-plus-function interpretation and also identified a corresponding structure.⁹ On this record, Patent Owner does not persuade us that the alleged deficiencies warrant a denial of the Petition in this particular case.

D. Obviousness of Claims 1–4, 7–11, 13–16, and 19–23 over Brown and Obviousness of Claims 1–4, 7–16, and 19–23 over Brown and Wecker

Petitioner contends that claims 1–4, 7–11, 13–16, and 19–23 are obvious over Brown and that claims 1–4, 7–16, and 19–23 are obvious over a combination of Brown and Wecker. Pet. 8–58. Other than arguments addressed above, Patent Owner does not present any arguments with respect to these contentions.

⁷ *SAS Institute, Inc. v. Complementsoft, LLC*, IPR2013-00226, Paper 9 at 10–11 (PTAB Aug. 12, 2013); *Clickbooth.com LLC v. Essociate, Inc.*, IPR2015-00464, Paper 9 at 11 (PTAB July 9, 2015).

⁸ *Lindsay Corp. v. Valmont Indus., Inc.*, IPR2015-01039, Paper 7 at 11 (PTAB Sept. 24, 2015).

⁹ *Flotek Indus., Inc. v. Nat’l Oilwell DHT, L.P.*, IPR2015-01210, Paper 11 at 8–9 (PTAB Nov. 6, 2015).

1. *Brown (Ex. 1005)*

Brown describes a “method of creating a composite desktop built from Web content retrieved from one or more Web sites.” Ex. 1005, code (57).

Brown describes a composite desktop 302 that:

includes one or more desktop components. A desktop component is a distinct geometric region that displays a single piece of Web-based content. . . . [A]ctive desktop component 308 corresponds to a component retrieved locally or from a remote computer. . . . The component may be selected from a Web page, within which the component is embedded. . . . The Web page desktop component 310 corresponds to an entire Web page that was selected for inclusion within the composite desktop 302.

Id. at 7:21–48. The composite desktop and its components are illustrated in Figure 3A, a pictorial representation of a user interface desktop, which is reproduced below.

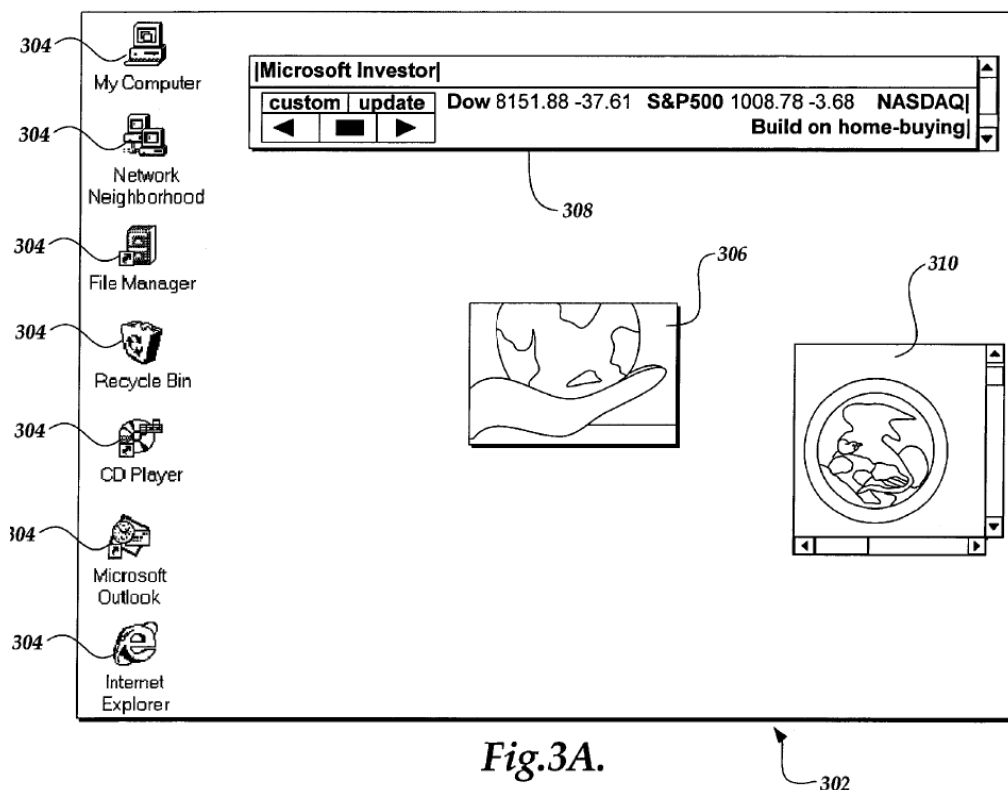


Figure 3A illustrates desktop 302, icons 304, static desktop component 306, active desktop component 308, and Web page desktop component 310. *Id.* at 3:61–62, 7:9–48.

Icons 304 of Figure 3A are displayed in a first transparent window (the “icon layer”) of composite desktop 302 and desktop components (306, 308, 310) are displayed in a second simultaneously-displayed window, the HTML window/layer. *Id.* at 7:66–8:9. An exemplary 40-line file corresponding to the HTML layer of desktop 302 depicted is provided in the specification. *Id.* at 11:29–12:43. Lines 10 through 13 of this file “include HTML instructions that correspond to the Web page desktop component 310.” *Id.* at 13:14–15. Lines 14 through 17 of this file “comprise HTML instructions that describe the active desktop component 308.” *Id.* at 12:61–62. These “include a URL specifying an Internet location where additional HTML code corresponding to the active desktop component 308 resides.” *Id.* at 13:1–4.

These lines 10 through 17 are:

```
10. <IFRAME id=7 MARGINWIDTH=0  
MARGINHEIGHT=0 name=“DeskMovrW”  
src=“http://www.uspto.gov/”  
11. resizable=“XY”  
12. subscribed_url=“http://www.uspto.gov/”  
13. frameborder=0 style=“BACKGROUND: transparent;  
position:absolute; LEFT:620; TOP:254; WIDTH:156;  
HEIGHT:150; Z-INDEX:1014”></IFRAME>  
14. <IFRAME id=8 MARGINWIDTH=0  
MARGINHEIGHT=0 name=“DeskMovrW”  
src=“http://www.microsoft.com/ie/ie40/gallery/ticker.htm”  
15. resizable=“XY”
```

16. subscribed_url="http://www.microsoft.com/ie/ie40/gallery/cdf/g_stock.cdf"

17. frameborder=0 style="BACKGROUND: transparent; position:absolute; LEFT:178; TOP:26; WIDTH:516; HEIGHT:57; Z-INDEX:1016"></IFRAME>

Id. at 11:59–12:10.

2. *Wecker (Ex. 1006)*

Wecker describes:

A method for rendering information . . . available through the Internet on a computer includes storing a content structure file, a data file and a script file. . . . The content structure file is read to ascertain which script in the script file is associated with data to be rendered. The data from the data file is retrieved and the associated script file is executed to render the data.

Ex. 1006, code (57).

Wecker indicates that content structure files (also termed “channel definition format” or “CDF” files), script templates, and data files for display on a mobile device are stored in a cache memory of a mobile device. *Id.* at 3:3–6, 6:34–39, Fig. 6. The system allows content to be delivered and updated “in small segments of data instead of full HTML pages” to “make[] it efficient and economical to update time-critical information.” *Id.* at 10:41–51.

3. *Claim 1: Obviousness over Brown or over Brown and Wecker*

Petitioner argues that claim 1 would have been obvious over Brown, and also over a combination of Brown and Wecker. Pet. 12–43.

Petitioner argues that, to the extent the preamble is limiting, Brown teaches a “client device” in its computer. Pet. 16–17 (citing Ex. 1005, 2:54–57, 4:32–40, Claim 15; Ex. 1003 ¶¶ 44–45).

With respect to limitation 1.1 of claim 1, relating to electronic storage configured to store a NIM template associated with a NIM, Petitioner argues that Brown's system memory and/or registry would have stored the HTML instructions defining a composite desktop containing desktop components, and that these desktop components teach or suggest NIMs. *Id.* at 18–21 (citing, *inter alia*, Ex. 1005, 4:54–58, 6:20–26, 6:34–36, 7:21–22, 11:1–13:54, 14:8–9; Ex. 1003 ¶¶ 46–50). Petitioner notes that Brown's desktop components are implemented as floating frames with frame controls, which can be positioned on a desktop and resized, and that they display a piece of web-based content. *Id.* at 21–23 (citing Ex. 1005, 7:22–26, 12:61–65, Fig. 3A; Ex. 1003 ¶¶ 51–54). Petitioner argues that the HTML instructions that define the desktop components in Brown would thus teach NIM templates as per the construction we adopt. *Id.* at 23–25 (citing Ex. 1005, 7:57–59, 11:39–12:43, 14:7–8, Fig. 3A; Ex. 1003 ¶¶ 55–59). Petitioner argues that, as HTML instructions, they do not contain compiled code. *Id.* at 25 (citing Ex. 1005, 6:36–37, 11:56–12:10; Ex. 1003 ¶ 60).

With respect to the definition of a graphical user interface including a frame and frame characteristics, Petitioner argues that Brown's desktop components/floating frames comprise such graphical user interfaces, are displayed on a monitor in Brown, and are defined by Brown's HTML instructions, which are web-browser readable. *Id.* at 26–29 (citing Ex. 1005, 1:35–38, 5:38–39, 11:20–28, 12:61–64, Fig. 3A; Ex. 1003 ¶¶ 62–65). Petitioner further asserts that the content displayed is “time-varying content.” *Id.* at 29–30 (citing Ex. 1005, 4:63–64; Ex. 1003 ¶¶ 66–67). Petitioner argues that the frame in Brown lacks controls for enabling a user to specify a network location. *Id.* at 30–31 (citing Ex. 1005, Fig. 3A; Ex. 1003 ¶ 68).

Petitioner argues that limitation 1.1 is additionally taught by the combination of Brown and Wecker. Pet. 31–34. Petitioner proposes a combination in which Wecker’s cache storing HTML templates is “leverage[d]” in Brown’s system and in which Brown’s desktop components could be implemented as described in Wecker’s disclosure of mobile channels. *Id.* at 12–13. Petitioner provides a detailed explanation of the similarities between the references, which, Petitioner contends, would have led one of ordinary skill in the art to pursue the combination is the application of known techniques to yield predictable results. *Id.* at 13–14 (citing Ex. 1005, 12:61–62; Ex. 1006, 3:17–20; Ex. 1003 ¶¶ 37–38). Petitioner argues that one of ordinary skill would have had a reasonable expectation of success in making this combination. *Id.* at 14 (citing Ex. 1003 ¶ 38). Petitioner argues that, in this combination, Wecker’s mobile electronic storage (cache memory) would hold script templates for Wecker’s mobile channels. *Id.* at 31–33 (citing Ex. 1006, 8:31–39, Figs. 1, 6–7; Ex. 1003 ¶¶ 69–70).

With respect to the processors configured to execute computer program modules of limitation 1.2, Petitioner argues that one of ordinary skill in the art would have understood that Brown’s HTML viewer and composite desktop shell would be executed by processors. *Id.* at 34 (citing Ex. 1003 ¶ 73). Petitioner argues that these would access the HTML instructions that define the desktop components in Brown. *Id.* at 35–36 (citing Ex. 1005, 6:30–32, 6:39–41, Figs. 1, 2; Ex. 1003 ¶¶ 74–75).

Petitioner argues that the client device downloads content from the Internet (network) using URLs, teaching or suggesting the transmission of a content request for content to be displayed in the Brown desktop component, teaching the transmission of limitation 1.3 of claim 1. *Id.* at 37–39 (citing

Ex. 1005, 3:24–33, 4:13–21, 7:21–24, 11:43–12:43, Fig. 3A; Ex. 1003 ¶¶ 77–79).

Petitioner argues the reception of time-varying content over the network and presentation of the content within a frame of a viewer graphical user interface (limitations 1.4 and 1.6) is taught by Brown for similar reasons. *Id.* at 40, 42–43 (citing Ex. 1005, 2:8–12, 2:36–41, 12:1–8, 13:4–13, Fig 3A; Ex. 1003 ¶¶ 82–84, 88).

Petitioner additionally argues that a combination of Brown and Wecker teaches or suggests limitation 1.3. Petitioner argues that Wecker’s desktop computer retrieves new data and content over the network and displays it to the user. *Id.* at 39 (citing Ex. 1006, 4:3–13; Ex. 1003 ¶ 80).

With respect to the presentation of the viewer graphical user interface defined by the NIM template as recited in limitation 1.5 of claim 1, Petitioner argues that Brown’s system includes a monitor and one of ordinary skill would have recognized that the desktop component would be displayed on the monitor. *Id.* at 41 (citing Ex. 1005, Fig. 1; Ex. 1003 ¶ 86). Petitioner further argues that Brown teaches or suggests that the desktop components may be displayed separately from each other. *Id.* at 41–42 (citing Ex. 1005, Fig. 3A; Ex. 1003 ¶ 87).

Patent Owner presents no additional arguments with respect to these assertions.

On the present record, we determine that Petitioner has made a sufficient showing of a reasonable likelihood that it would prevail with respect to showing that claim 1 would have been obvious over Brown, and that claim 1 would have been obvious over Brown and Wecker.

4. *Claims 2–4 and 7: Obviousness over Brown or over Brown and Wecker*

Claim 2 depends from claim 1, and further requires that, “responsive to the reception of one or more elements included in the received time varying-content” a feature of the viewer graphical user interface is modified “in accordance with a modification corresponding to the received one or more elements.” Ex. 1001, 42:65–43:3. Claims 3, 4, and 7 depend from claim 2.¹⁰ *Id.* at 43:4–12, 4:25–31. Claim 3 recites that the modification must comprise a modification to an image that forms a part of the graphical user interface and claim 7 recites that the modification comprises modifying text. *Id.* at 43:4–8, 43:25–31. Claim 4 recites that “the correspondence between the modification” of claim 2 and “the received one or more elements is defined by the NIM template, and claim 7 similarly recites that the NIM template defines the manner of the text modification. *Id.* at 43:9–12, 43:25–31.

Petitioner argues that Brown teaches the subject matter of claim 2 in Brown’s CDF-implemented subscriptions, which provide regularly retrieved and updated content to a desktop component that is displayed for a user, such as in Brown’s desktop component displaying stock information, or, alternatively, Wecker’s use of CDF. Pet. 44–47 (citing Ex. 1005, 13:1–13, Fig. 3A; Ex. 1006; 3:1–16; Ex. 1003 ¶¶ 89–95). With respect to the types of modifications recited in claims 3, Petitioner argues that, for the same reasons, the subject matter of claim 3 is either taught or suggested in Brown or that one of ordinary skill in the art would have understood them to be taught or suggested by Brown, additionally citing the images disclosed in

¹⁰ Claims 5 and 6 also depend from claim 2 but are not challenged in this ground. Ex. 1001, 42:13–24.

Brown. *Id.* at 47 (Ex. 1005, 2:20–21, 11:51–59, 12:44–50; Ex. 1003 ¶ 97). Additionally, Petitioner argues that Wecker discloses that a picture was included in Wecker’s “stocks” scripts file. *Id.* at 48 (citing Ex. 1006, 16:25–67; Ex. 1003 ¶¶ 99–100).

With respect to the recitation of claim 4 that “the correspondence between the modification and the received one or more elements is defined by the networked information monitor template,” Petitioner argues that one of ordinary skill in the arts would have found that this correspondence can be found in the use in Brown of HTML instructions (which Petitioner argues teaches the NIM template) to defines the desktop component. *Id.* at 48–49 (citing Ex. 1005, 6:34–36, 7:21–22, 11:1–13:54; Ex. 1003 ¶ 101).

With respect to the modifications to “text of the viewer graphical user interface” as recited in claim 7, Petitioner argues that Brown’s stock information desktop component presents information in text form and one of ordinary skill in the art would have understood this textual information to be updated. *Id.* at 49–50 (citing Ex. 1005, Fig. 3A; Ex. 1003 ¶ 103).

Patent Owner makes no additional arguments with respect to claims 2, 3, 4, or 7.

On the present record, we determine that Petitioner has made a sufficient showing of a reasonable likelihood that it would prevail with respect to showing that claims 2–4 and 7 would have been obvious over Brown, and that claims 2–4 and 7 would have been obvious over Brown and Wecker.

5. *Claims 8–11: Obviousness over Brown or over Brown and Wecker and Claim 12: Obviousness over Brown and Wecker*

Claims 8–11 depend directly or indirectly from claim 1, and add recitations specifying the NIM template includes a markup language file

(claim 8), that the receipt of content occurs according to TCP/IP protocol (claim 9), that the network location corresponds to a NIM template URL (claim 10), and that access of the NIM results in transmission of a content request to that URL according to TCP/IP (claim 11). Ex. 1001, 43:32–49. Claim 12 depends from claim 1 and recites that the computer program modules transmit a request for a NIM template to a NIM server, receive the NIM template from the NIM server, and store the NIM template in the recited storage. *Id.* at 43:50–60.

For claims 8–11, Petitioner presents the testimony of Dr. Schmidt, supported by references to Brown and/or Wecker, to explain their assertion that these recitations would have been obvious to one of ordinary skill in the art. Pet. 50–52 (citing Ex. 1005, 3:3–5, 6:26–40, 7:21–22, 11:1–13:54; Ex. 1006, 3:1–7; Ex. 1003 ¶¶ 104–108).

For claim 12, Petitioner argues that Wecker’s “self describing web site” corresponds to the claimed NIM server, which would have provided script files corresponding to Brown’s HTML instructions for a desktop component. *Id.* at 52–54 (citing Ex. 1006, 3:8–16, 10:25–56; Ex. 1003 ¶¶ 109–113).

Patent Owner makes no additional arguments with respect to claims 8–12.

On the present record, we determine that Petitioner has made a sufficient showing of a reasonable likelihood that it would prevail with respect to showing that claims 8–11 would have been obvious over Brown, and that claims 8–12 would have been obvious over Brown and Wecker.

6. *Claims 13–16 and 19–23: Obviousness over Brown and
Claims 13–16 and 19–23: Obviousness over Brown and Wecker*

Claims 14–16 and 19–23 depend directly or indirectly from independent claim 13. Petitioner argues claims 13–16 and 19–24 are obvious, relying on its arguments with respect to claims 1–4 and 7–11. Pet. 57–58. On this record, claims 13–16 and 19–23 appear to be substantially similar to claims 1–4 and 7–11. *Compare* Ex. 1001, 42:28–43:12, 43:25–49, *with id* at 43:61–44:46, 44:54–45:7. Patent Owner makes no additional arguments with respect to these claims.

For the reasons detailed above, on the present record that Petitioner has made a sufficient showing of a reasonable likelihood that it would prevail with respect to showing that claims 13–16 and 19–23 would have been obvious over Brown or over a combination of Brown and Wecker, and that claims 13–16 and 19–23 would have been obvious over Brown and Wecker.

E. *Obviousness of Claims 5, 6, 17 and 18 over Brown and Beer or
Brown, Wecker, and Beer*

Petitioner contends that claims 5, 6, 17 and 18 are obvious over a combination of Brown and Beer or Brown, Wecker, and Beer. Pet. 58–65. Patent Owner makes no additional arguments relating to this ground.

1. *Beer*

Beer is directed to a method for dynamically switching between visual styles. Ex. 1007, code (54). The method “allow[s] a user to retrieve a user interface and a visual style from a local or remote storage unit, rapidly display the visual stylized user interface, and dynamically switch between visual styles.” *Id.* at code (57); *see also id.* at 14:19–22. Figure 1, illustrating a screen shot showing an exemplary representation of a word

processor having a Windows95 visual style (Ex. 1007, 2:65–67), is reproduced below.

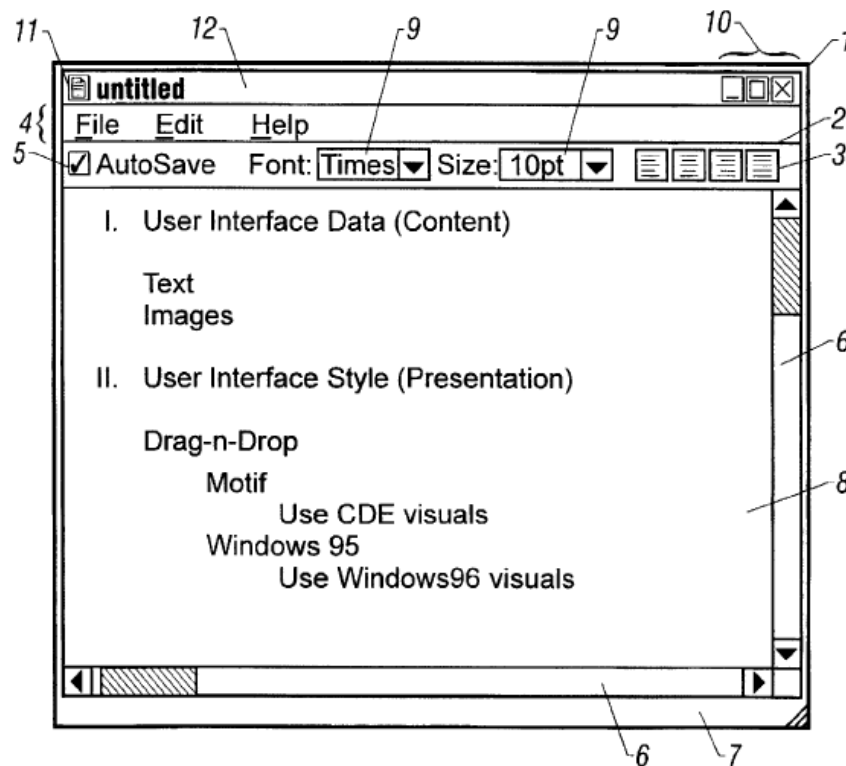


Figure 1

Figure 1 illustrates user interface widgets for user interface design. Figure 1 shows window 1, separator 2, toolbar buttons 3, menu bar 4, radio button 5, sliders 6, status bar 7, content area 8, dropdown list boxes 9, window control buttons 10, window icon 11, and title bar 12. Ex. 1007, 4:1–9.

2. *Claims 5, 6, 17, and 18: Obviousness over Brown and Beer or over Brown, Wecker, and Beer*

Petitioner argues the obviousness of claims 5, 6, 17, and 18 over a combination of Brown's desktop component interface and Beer's details regarding a user interface language to define a user interface. Pet. 59–63. Petitioner argues the combination of Brown, Wecker, and Beer for similar reasons. *Id.* at 63. Petitioner provides a showing that one of ordinary skill in the art would have been motivated to make these combinations and would

have reasonably expected success in doing so. *Id.* at 59–63 (citing, *inter alia*, Ex. 1003 ¶¶ 140–144).

Petitioner argues that the recitations in claims 5 and 17 of modification of the viewer graphical interface by adjusting a size of the frame and the recitations in claims 6 and 18 of changing a color of a frame border or background are taught or suggested by this combination. Specifically, with respect to claims 5 and 17, Petitioner argues that a response to a user event would be redrawing the user interface. Pet. 63–65 (citing Ex. 1007, 13:22–24; Ex. 1003 ¶¶ 145–149, 153). With respect to claims 6 and 18, Petitioner argues that Beer provides for different colors in figures displayed and different border colors. Pet. 64–65 (citing Ex. 1007, 8:55–57; Ex. 1003 ¶¶ 150–152, 154).

Patent Owner makes no additional arguments with respect to claims 5, 6, 17, and 18.

On the present record, we determine that Petitioner has made a sufficient showing of a reasonable likelihood that it would prevail with respect to showing that claims 5, 6, 17, and 18 would have been obvious over Brown and Beer, and that claims 5, 6, 17, and 18 would have been obvious over Brown, Wecker, and Beer.

F. Obviousness of Claims 1–24 over Shimada and Buchholz

Petitioner contends that claims 1–16 are obvious over a combination of Shimada and Buchholz. Pet. 65–100. Patent Owner makes certain additional arguments relating to this ground. Prelim. Resp. 21–26.

1. Shimada (Ex. 1008)

Shimada describes adding a new screen display area to screen configuration information, which contains data to be displayed and information on the configuration of the screen for displaying data. Ex. 1008,

5:52–65. For example, an interface for interactive communication with a user at the client is added to a client display screen. *Id.* at 5:66–6:6.

Exemplary screen configuration data includes information regarding the location of static images (having a “.gif” extension) and of additional screen configuration data (having a “.html” extension). *Id.* at 6:14–58, Figs. 5, 6.

2. *Buchholz (Ex. 1009)*

Buchholz is directed to a method and apparatus in a wireless communication system for controlling a display of template data by a portable subscriber unit. Ex. 1009, codes (54), (57). Buchholz describes a “pack” programmed into the portable subscriber unit; the pack has a bundle of HTML templates for formatting template data for display on the page, in order to present data to a user. *Id.* at 5:1–11. “A template can, for example, define where, and in what size and color, the corresponding template data is to be displayed.” *Id.* at 5:11–13. “Keeping the pack in the portable subscriber unit 122 advantageously reduces latency for template data that is repeatedly updated and displayed in a fixed format, e.g., information services data such as a stock report.” *Id.* at 5:37–41.

3. *Obviousness of Claim 1 over Shimada and Buchholz*

Petitioner proposes a combination of Shimada and Buchholz and argues the obviousness of claim 1 over that combination. Pet. 68–89. Patent Owner makes additional arguments regarding Petitioner’s contentions. Prelim. Resp. 21–26.

Generally, Petitioner proposes a combination of Shimada and Buchholz, in which Shimada’s “screen configuration data” is used in Buchholz’s subscriber units, is used or substituted as a template in Buchholz. Pet. 68–69. Petitioner argues that one of ordinary skill in the art would have

recognized the similarities between the references and would have performed this modification with little modification and a reasonable expectation of success. *Id.* (citing Ex. 1003 ¶¶ 157–161).

Petitioner relies on Buchholz for claim 1’s recited electronic storage, display, and one or more processors. Pet. 70, 80–81, 83 (citing Ex. 1009, 4:1–2, 4:14–31, 5:4–9, Fig. 2; Ex. 1003 ¶¶ 163, 164, 177, 180). Petitioner additionally relies on Shimada’s client screen display and information processing unit for the electronic display and processors. *Id.* at 80, 82 (citing Ex. 1008, 1:26–28, 6:4–9, Fig 6; Ex. 1003 ¶¶ 176, 179).

While citing Buchholz’s discussion of a template defining layout, location, size and color of the display of template data and receipt and the execution of a NIM template by a client (Pet. 70, 79, 85, 86 citing Ex. 1009, 1:13–19, 5:4–9, 5:29–35, Fig. 4; Ex. 1003 ¶¶ 163, 174, 183, 184), Petitioner generally relies on Shimada’s screen configuration data for the claimed NIM template, the content request transmission and reception, and the NIM features recited in claim 1. *See, e.g.*, Pet. 71–79, 83–85, 87, 89 (citing, *inter alia*, Ex. 1008, 5:41–44, 6:7–51, 6:59–62, 13:12–18, Figs. 16, 17, 18, 22; Ex. 1003 ¶¶ 164–173, 181–182, 187, 189).

Patent Owner contends that the showing is deficient because the disclosed components of the Shimada HTML file (corresponding, in Petitioner’s argument, to the NIM template) are local references, which precludes accessing the content over a network to a web server at a network location. Prelim. Resp. 21–22. Patent Owner argues that the HTML file includes both content and controls for interacting with the screen in the same file. *Id.* However, on the current record, it appears that Shimada’s HTML file includes references to content, but not the content itself, which can be separately transferred to a user device for display upon request. Pet. 83;

Ex. 1003 ¶¶ 162, 181; Ex. 1008, 1:34–36, 6:30–51 (describing HTML that includes an “address representing a static image,” which can be requested from the server and displayed on the screen of the client when a corresponding button is selected by a user).

Patent Owner additionally argues that Shimada does not teach or suggest the transmission of a request for content over a network (e.g. limitation 1.3) or the reception of content from over the network (e.g. limitation 1.4) via content references in Shimada’s HTML file because Shimada’s HTML code examples are *relative* URLs that would retrieve locally stored information, and not information retrieved from a network. Prelim. Resp. 23–25 (citing Ex. 1008, Figs. 5, 6, 17). This argument does not address the Dr. Schmidt’s testimony that Shimada’s network could be the Internet or that the URL requests content over a network to a web server at a network location. Pet. 68, 69, 86, 96–98; Ex. 1003 ¶¶ 22, 157, 162, 184, 207–209.

On the present record, Petitioner has made a sufficient showing of a reasonable likelihood that it would prevail with respect to showing that claim 1 would have been obvious over the combination of Shimada and Buchholz.

4. *Claims 2–24*

Petitioner makes additional showings with respect to the obviousness of claims 2–24 over Shimada and Buchholz. Pet. 90–100. Patent Owner does not present any additional arguments with respect to these claims.

As we institute on other grounds, we do not address Petitioner’s showing as to claims 2–24 on this ground at this time.

V. CONCLUSION

For the foregoing reasons, we determine that Petitioner demonstrates a reasonable likelihood of prevailing with respect to at least one of the claims challenged in the Petition. Accordingly, *inter partes* review of the '407 patent shall proceed in this case on all of the grounds raised in the Petition.

Our determination in this Decision is not a final determination on either the patentability of any challenged claims or the construction of any claim term. The factual findings set forth in this Decision are preliminary and provided for the sole purpose of deciding whether to institute a review. Any final findings will be based on the full trial record, including any information presented by Patent Owner in a timely filed response to the Petition. *See TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (noting that “there is a significant difference between a petitioner’s burden to establish a ‘reasonable likelihood of success’ at institution, and actually proving invalidity by a preponderance of the evidence at trial”) (quoting 35 U.S.C. § 314(a) and comparing *id.* with § 316(e)).

VI. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–24 of the '407 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), notice is hereby given of the institution of a trial.

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