

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.

IPR2023-00756
Patent 9,369,545 B2

Before HUBERT C. LORIN, GRACE KARAFFA OBERMANN, and
SHARON FENICK, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Samsung Electronics Co., Ltd. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–21 of U.S. Patent No. 9,369,545 B2 (Ex. 1001, “the ’545 patent”). DoDots Licensing Solutions LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Petitioner also filed a Preliminary Reply (Paper 7, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 8, “Prelim. Sur-reply”).¹

We have jurisdiction under 35 U.S.C. § 6.

Upon consideration of the arguments and evidence presented by Petitioner, we are persuaded that Petitioner has demonstrated, under 35 U.S.C. § 314(a), a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim.

For the reasons stated below, we institute *inter partes* review as to challenged claims 1–21 of the ’545 patent.

B. Related Proceedings

Petitioner indicates, and Patent Owner agrees, that the ’545 patent is the subject of *DoDots Licensing Solutions LLC v. Samsung Electronics Co., Ltd. et al.*, No. 6:22-cv-00535 (W.D. Tex. 2022). Pet. 109 (citing Ex. 1019); Paper 3, 1–2.

¹ The Board authorized the filing of these papers. *See* Ex. 1023.

Petitioner notifies us that the '545 patent was also subject of IPR2019-00988 filed by Lenovo Holdings, et al.² Pet. 109.

Patent Owner notifies us that the '545 patent is currently involved in *DoDots Licensing Solutions LLC v. Apple Inc. et al.*, No. 6:22-cv-00533 (W.D. Tex. 2022). Paper 3, 1.

C. The '545 patent (Ex. 1001)

1. Disclosure

The title of the '545 patent is “Accessing and Displaying Network Content.” Ex. 1001, code (54). The '545 patent discloses, among other things, a method for accessing and displaying network content in a graphic user interface (“GUI”). *Id.* at Abstr.

According to the '545 patent, conventional web browsers are limited in the “aggregation” and “presentation” of content. Ex. 1001, 1:48–51. As to the aggregation of content, the '545 patent states that a user may use conventional web pages to view content sources in a single web page, such as stock, weather and sports information (*id.* at 1:27–38), and because the user is not in a position to separately aggregate the content at a client computer, the user is constrained to view the content that has been delivered in the manner provided by the server computer hosting the web page (*id.* at 1:45–48). As to the presentation of content, the '545 patent states that conventional content was divided into regions on a single web page. *Id.* at 1:27–38. The '545 patent identified a purported problem, noting that when

² The Board’s decision in IPR2019-00988 (Ex. 1012; Ex. 2001), which determined no challenged claims unpatentable, was affirmed by the Federal Circuit. *See Lenovo Holding Company, Inc. v. DoDots Licensing Solutions LLC*, 2021 WL 5822248 (Fed. Cir. 2021) (“*Lenovo*”). Ex. 1014; Ex. 2002.

disparate content was aggregated, it was “reassembled into a full web page and . . . served through a full-screen browser.” *Id.*

The ’545 patent discloses a method for accessing and displaying network content in a GUI. Ex. 1001, Abstr. It is capable of processing distributable computer readable media. *Id.* at 4:29–30. Distributable computer readable media includes, but is not limited to, standard web content, such as HTML, dHTML, images, imbedded ActiveX and Java applications, JavaScript, CSS, Pen scripts, Streaming Media, and/or Flash. *Id.* at 4:31–34.

According to the ’545 patent, a user logs into a server by providing a login identifier, which is used to obtain the user’s profile. Ex. 1001, 4:44–47. The user profile includes references to networked information monitors (NIMs). *Id.* at 4:54–56. In the ’545 patent, the term “networked information monitor” refers to a fully configurable frame with one or more controls, which stands in contrast to conventional web browsers, which have limited means to alter the browser controls. *Id.* at 4:56–63. A “NIM template” defines the characteristics of a specific NIM, including fully configurable frame characteristics, viewer and control characteristics, and NIM content references. *Id.* at 6:34–37; *see id.* at 2:30–32 (“a definition of a Networked Information Monitor (NIM)” which defines a “NIM frame”). After the user accesses the user profile and the NIM template defines the characteristics of the NIM frame, the content is placed in a NIM viewer defined by the frame. *Id.* at 2:30–34.

2. Claims 1–21

Petitioner challenges claims 1–21. Pet. 1. Claims 1 and 16 are the independent claims from which claims 2–15 and 17–21 depend,

respectively, and are reproduced below, with the bracketing provided by Petitioner. *See id.* at v–vi (claim 1), ix–x (claim 16).

1. [1pre] A computer-implemented method of obtaining content over a network and displaying the content to a user, the method being implemented in a client computing device in operative communication with a server over a network, the client computing device including electronic storage, a display, and one or more processors configured to execute one or more computer program modules, the method comprising:

[1.1] transmitting a request to the server over the network, the request requesting networked information monitor template;

[1.2] receiving the requested networked information monitor template from the server over the internet, the requested networked information monitor template having been transmitted from the server over the network responsive to the transmitted request, the networked information monitor template comprising:

[1.3] a definition of a viewer graphical user interface within which content in a web browser-readable language may be presented on the display of the client computing device; and

[1.4] a definition of a first content element for the networked information monitor template, the definition of the first content element referencing a first network location from which the first content element for the networked information monitor template is served over the network;

[1.5] responsive to instructions included in the requested networked information monitor template, presenting the viewer graphical user interface defined by the networked information monitor on the display of the client computing device separate from and outside of any other graphical user interface that includes user controls for specifying the

first network location from which the first content element for the networked information monitor is served over the network;

- [1.6] responsive to instructions included in the requested networked information monitor template, transmitting over the network a first content request to the first network location referenced by the definition of the first content element for the networked information monitor template;
- [1.7] receiving, over the network, the first content element transmitted responsive to the first content request;
- [1.8] presenting the received the first content element in the viewer graphical user interface defined by the networked information monitor template, wherein the definition of the viewer graphical user interface and/or the first content element define all controls for enabling a user to interact with the first content element through the viewer graphical user interface.

Ex. 1001, 42:22–43:4.

16. [16pre] A computer-implemented method of obtaining and displaying content obtained over a network to a user on a client computing device, the method being implemented in the client computing device, the client computing device including electronic storage, a display, and one or more processors configured to execute one or more computer program modules, the method comprising:

- [16.1] executing on the client computing device client parser, wherein the execution of the client parser results in the client computing device:
 - [16.2] transmitting over the network a first content request to a first network location referenced by a definition of a first content element in a networked information monitor template that is readable by the client parser;

- [16.3] receiving, over the network, the first content element transmitted responsive to the first content request;
- [16.4] presenting a viewer graphical user interface defined by the networked information monitor template on the display of the client computing device and wherein the viewer graphical user interface defined by the networked information monitor template is presented separate from and outside of any other graphical user interface that includes user controls for specifying the first network location from which the first content element for the networked information monitor is served over the network; and
- [16.5] presenting the received content element within the viewer graphical user interface defined by the networked information monitor template, wherein the definition of the viewer graphical user interface and/or the first content element define all controls for enabling a user to interact with the first content element through the viewer graphical user interface.

Ex. 1001, 44:32–64.

D. Asserted References

Petitioner relies on the following references:

Name	Reference	Ex. No.
Brown	U.S. Patent No. 6,278,448 B1, issued Aug. 21, 2001	1005
Wecker	U.S. Patent No. 6,449,638 B1, issued Sep. 10, 2002	1006
Beer	U.S. Patent No. 5,793,368, issued Aug. 11, 1998	1007
Shimada	U.S. Patent No. 6,789,263 B1, issued Sep. 7, 2004	1008
Buchholz	U.S. Patent No. 6,088,340, issued Jul. 11, 2000	1009
Darnell	“HTML 4 Unleashed,” 1997 ³	1011
Krishna	U.S. Patent No. 6,055,522, issued Apr. 25, 2000	1021

Petitioner also relies on a Declaration of Dr. Douglas C. Schmidt (Ex. 1003) as support for the various contentions.

E. Asserted Grounds

Petitioner contends that claims 1–21 of the ’545 patent are unpatentable under the following grounds:

Ground	Claim (s) Challenged	35 U.S.C. §	Reference(s)/Basis
1A	1–4, 6–10, 13–15	§ 103 ⁴	Brown, Wecker
1B	5, 11–12, 16–21	§ 103	Brown, Wecker, Beer

³ In a table provided by Petitioner, “Darnell” is indicated as having a “Publication Date” of “1997.” Pet. 2; see also Ex. 1018 (Declaration of June Ann Mumford) On the present record, this date is not disputed.

⁴ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 102 and 103. Because the challenged claims of the ’545 patent claim an effective filing date before the effective date of the applicable AIA amendments (*see* Ex. 1002, 73–75), we refer to the pre-AIA versions of 35 U.S.C. § 103 throughout this Decision.

Ground	Claim (s) Challenged	35 U.S.C. §	Reference(s)/Basis
2A	1–4, 6–7, 9–10, 13–15	§ 103	Shimada, Buchholz
2B	5, 8, 12	§ 103	Shimada, Buchholz, Darnell
2C	11, 16–21	§ 103	Shimada, Buchholz, Krishna

Pet. 1.

II. ANALYSIS

A. 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. 27–33; Prelim. Sur-reply 6–7. Petitioner argues we should not discretionarily deny institution under *Fintiv*. Pet. 106–108; 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;
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.⁵

⁵ While *Fintiv* factor six encompasses considerations other than the compelling merits, neither party has argued such considerations exist in this case.

1. First Five Fintiv Factors

a. 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. . . . Upon filing of this petition, Petitioner intends to file a motion to stay the parallel litigation.” Pet. 106. Petitioner further contends that the Board generally declines to predict outcomes of possible future stay requests. Prelim. Reply 6.

Patent Owner argues that the factor weighs against institution, because Petitioner “has not sought to stay the district court litigation[a]nd there is no indication that the Court will grant any stay, if one is sought.” Prelim. Resp. 30.

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. *Sand Revolution II, LLC v. Cont’l Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative) (“*Sand Revolution*”).

b. 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 that this factor:

weighs against discretionary denial. The projected statutory deadline for the PTAB's Final Written Decision (FWD) is October 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 29.5 months, yielding an estimated trial date in November 2024, which falls after the expected FWD date of October 2024. . . . [Petitioner's] Motion to Transfer Venue that was filed in W.D. Tex., if successful, will further ensure that the FWD far outpaces any trial date.

Pet. 106–107.

Patent Owner argues:

The Western District of Texas issued its scheduling order on December 29, 2022 setting trial for [] June 24, 2024. Ex. 2005. [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. 30. 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 6.

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.

c. 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. 107. Petitioner additionally argues that the resources expended at the time of its Preliminary Reply “remains 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 Owner, Petitioner, co-defendant Apple, and the WDTX Court have all spent significant resources on the asserted patents including the '083 [sic] Patent. Discovery is ongoing in WDTX, with both parties having already exchanged their first set of document requests and interrogatories. [Petitioner] has also produced a portion of its relevant source code, which [Patent Owner] will begin reviewing within the next few weeks. The parties have also fully briefed claim construction and a motion to transfer venue from WDTX to NDCA, and exchanged infringement and invalidity contentions. Indeed, the parties have been litigating this case for approximately fourteen months.

Prelim. Resp. 31. 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 6–7.

We are mindful of the investment of the 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.” Prelim. Resp. 31.

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

d. 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. 107.

Patent Owner argues, without citation to the record, that:

Invalidity issues related to the '083 [sic] patent are already being litigated in WDTX. Petitioner's invalidity contentions already set forth the grounds raised in this petition.

Prelim. Resp. 32. Patent Owner additionally argues that Petitioner has “fail[ed] to submit a stipulation per [*Sotera*]” and thereby “refuse[s] to mitigate concerns of potentially conflicting decisions and duplicative efforts between the district court and Board.” *Id.*

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 in favor of not exercising discretion. *Sand Revolution*, 12.

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

e. 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. 107; Prelim. Resp. 33.

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

2. Conclusion Regarding § 314(a)

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.

B. Discretionary Denial Under 35 U.S.C. § 325(d)

In the section entitled “VIII. PETITIONER HAS FAILED TO SHOW A REASONABLE LIKELIHOOD OF SUCCESS FOR ANY GROUNDS 1A, 1B, 2A, 2B, AND 2C,” Patent Owner argues as follows:

First, it is important to recognize that Brown and Jones were all expressly considered by the Patent Examiner, during prosecution of the application that resulted in the ‘545 Patent. Each IDS disclosing these references has a sentence added by Examiner, which he initialed, that “All references considered except where lined through.” Ex. 2003 at (Brown and Jones). Petitioner tries to minimize this critical fact by arguing that the references were not “substantively applied or discussed during prosecution” (Pet. at 1), but the references only would have been “substantively applied or discussed” if Examiner concluded after his consideration that the references invalidated the claims. 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 in not considering [B]rown. For these two reasons the board should deny institution of an IPR.

Prelim. Resp. 22–23 (emphasis omitted). We interpret Patent Owner’s argument as a request that the Board exercise its discretion to deny institution under § 325(d). (We do not discuss Jones (Ex. 1010) in this section which is devoted to 35 U.S.C. § 325(d) because Petitioner has not been asserted it as a reference in any ground. Patent Owner’s concern about Jones is discussed in section II.H.3.)

Section 325(d) provides that the Director may elect not to institute a proceeding if the challenge to the patent is based on matters previously presented to the Office. 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*, Paper 6 at 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*, Paper 6 at 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.

1. First step of the framework

Patent Owner contends that Brown was “expressly considered by the Patent Examiner, during prosecution of the application that resulted in the ‘545 Patent.” Prelim. Resp. 22.

The only evidence provided showing Brown was “expressly considered” is an IDS statement. Ex. 2003; cited at Prelim Resp. 23. The IDS statement contains two sets of documents. Ex. 2003, 1–12 (first set); 15–22 (second set). The first set lists over 250 references, one of which includes Brown. *Id.* at 6, reference 4E. The Examiner signed the bottom of the page citing Brown on Sept. 24, 2015. Where the Examiner signed the page, it states that the Examiner “CONSIDERED” on that date (i.e., on Sept. 24, 2015). What precisely the Examiner “considered” on that date is unclear because none of the citations, including to Brown, have been initialed. This evidence which amounts to a single uninitialed citation to Brown among hundreds of other citations does not provide a sufficient basis for the Board to exercise its discretion to deny institution under § 325(d).

Moreover, Petitioner does not challenge the patentability of the claims over Brown alone. Under Ground 1A, claims 1–4, 6–10, and 13–15 are challenged under § 103 over the *combination* of Brown and Wecker and, under Ground 1B, claims 5, 11–12, 16–21 are challenged under § 103 over the *combination* of Brown, Wecker, and Beer. As Petitioner correctly points out, “none of Wecker, Beer . . . were previously cited or applied in a rejection during prosecution of the ‘545 Patent.” Pet. 108.

Even assuming the signing and dating of the page citing Brown is sufficiently indicative of the Examiner having considered Brown, the record does not show that the Examiner previously rejected any claim under 35 U.S.C. § 102 and/or 103 over any reference, let alone Brown. Thus, there are no “similarities and material differences between [the combinations of Brown and Wecker and Brown, Wecker, and Beer] and the prior art involved during examination” (*Becton, Dickinson* factor (a)) and no “cumulative nature of [the combinations of Brown and Wecker and Brown, Wecker, and Beer] and the prior art evaluated during examination” (*Becton, Dickinson* factor (b)).

Petitioner’s arguments are necessarily new ones and no overlap between the arguments made during examination and the manner in which Petitioner relies on Brown exists. *Cf. Becton, Dickinson* factor (d).

For the reasons discussed related to *Becton, Dickinson* factors (a), (b), and (d), we find the art and arguments are not the same or substantially the same as was previously presented to the Office.

2. Second step of the framework

Because the same or substantially the same art or arguments were not previously presented to the Office, we do not consider whether Petitioner has demonstrated a material error by the Office. *See Advanced Bionics*, Paper 6 at 9–11.

3. Conclusion Regarding § 325(d)

Under the circumstances of this case, we determine that exercising discretion to deny the Petition under § 325(d) is unwarranted.

C. Principles of Law for Patentability

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 on the basis of 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 ordinary skill in the art; and (4) when in evidence, objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

“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*, 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 of persuasion never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

D. Level of Ordinary Skill in the Art

Petitioner states:

A person of ordinary skill (“POSITA”) relating to the subject matter of the ’545 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. [Ex. 1003] ¶¶ 20–21.

Additional graduate education could substitute for professional experience, or significant experience in the field could substitute for formal education.

Pet. 5.

Patent Owner states:

In the Lenovo '545 IPR [i.e., IPR2019-00988 (*see* footnote 2)], 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. 2001 at 9. [Patent Owner] agrees that this is the correct standard for a POSITA and [Petitioner] has also adopted this definition. Therefore, there is no dispute about the skill level of a POSITA.

Prelim. Resp. 12.

Patent Owner does not propose a definition for the level of skill in the art possessed by a POSA that is significantly different from that proposed by the Petitioner. Also, as Patent Owner indicates, Petitioner’s proposal is consistent with the one adopted in IPR2019-00988. *See* Ex. 2001, 9.

We adopt Petitioner’s asserted level of ordinary skill in the art.

E. Claim Construction

For petitions filed on or after November 13, 2018, as here, “[claims] of a patent . . . shall be 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 (2022); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005).

1. “*networked information monitor*” (“NIM”)

Petitioner states that it “adopts” the construction of “NIM” “which was adopted in IPR2019-00988”; that is, “a fully configurable frame with one of more controls; the frame through which content is optionally presented.” Pet. 3–4 (citing, *inter alia*, Ex. 1012, 10; Ex. 1003 ¶ 28).

Patent Owner does not propose an alternative construction at this stage. *See generally* Prelim. Resp. 12–13.

2. “*networked information monitor template*” (“NIM template”)

Petitioner states that it “adopts” the construction of “NIM template” “which was adopted in IPR2019-00988”; that is, “a data structure which defines the characteristics of a NIM, including the NIM frame, view, and control characteristics, and which exclude executable applications/compiled code.” Pet. 4–5 (citing, *inter alia*, Ex. 1012, 19; Ex. 1003 ¶ 29).

Patent Owner does not propose an alternative construction at this stage. *See generally* Prelim. Resp. 12–13.

3. *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.” Prelim. Resp. 18.

Patent Owner contends that Petitioner has “use[d]” 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. 15 (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. 16 (citing, *inter alia*, *Dynamic Drinkware*, 800 F.3d 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 15. “[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 17. “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.* “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’ in compliance with 37 C.F.R. §§ 42.100(b), which ‘warrants denial of [Petitioner’s] petition.’” *Id.* at 16.

In a nutshell, Petitioner responds by characterizing the statement appearing in Dr. Schmidt’s Declaration that is at issue as a “typographical error.” Prelim. Reply 2, 4 (referring to Ex. 1003 ¶ 26). According to Petitioner, “Dr. Schmidt quoted an earlier version of 37 C.F.R. § 42.100(b) that mentioned the ‘broadest reasonable construction’” and this is “a

typographical error.” *Id.* at 1–2, *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. 2; also citing an instance of the phrase “[u]nder the *Phillips* standard” at Pet. 2). 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 (referring to Dr. Schmidt’s claim construction analysis of the claim limitations “NIM” and “NIM template” discussed in sections II.A.E. 1. and 2, above; *see* Ex. 1003 ¶¶ 28 (cited at Pet. 3–4) and ¶ 29 (cited at Pet. 4–5), respectively). Dr. Schmidt’s claim construction analysis essentially repeats what is said in the Petition. *Cf.* Ex. 1003 ¶¶ 28, 29 and Pet. 3–4, Pet. 4–5, respectively. Petitioner adds that constructions for these two claim limitations are “the only claim constructions presented in Dr. Schmidt’s declaration [and were] endorsed by the Federal Circuit under the *Phillips* standard and constructions with which [Patent Owner] agrees.” Prelim. Reply 4 (referring to *Lenovo*, *see* footnote 2 (citing Ex. 1014; Ex. 2002)), *see also id.* at 3 (citing Prelim. Resp. 16–18).

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 pages 2–3, 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 apparent response to Petitioner's contention that "Patent Owner was [not] unduly burdened by Dr. Schmidt's typo," 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]." *Id.* 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. 18.

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. 2. Standing alone, there is no dispute that the Petition uses the correct claim construction standard 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 he signed the Declaration (Mar. 28, 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. 2–3. 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; *see* section II.E.1, 2. 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. 2–5; Prelim. Resp. 9–12 (discussing *Lenovo*). 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 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 1374 (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. 2.

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. 18.

On this record, we find the Declaration contains an error in its statement of the claim construction standard. Ex. 1003 ¶¶ 26–29. Denying the Petition on that basis alone would be “unduly strict.” *Cf. Netflix, Inc. v. DivX, LLC*, 2023 WL 5838696, at *1 (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.

4. 37 C.F.R. § 42.104(b)(3) and (b)(4)

Patent Owner contends that “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).” Prelim. Resp. 2. The basis for the contention is insufficiently explained.

Patent Owner argues that Petitioner “fails to offer a construction as required under 37 C.F.R. § 42.104(b)(3) for a means-plus-function claim limitation” and that “failure to provide any support for the means-plus-function term” is a ground for denial. Prelim. Resp. 2.

However, Patent Owner does not specify the means-plus-function claim limitation that Petitioner supposedly has failed to provide a construction for. *See generally* Prelim. Resp. 2–3.

Petitioner replies, *inter alia*, that “means-plus-function claims are not at issue—in this proceeding or in the co-pending district court case.” Prelim. Reply 6. And Patent Owner responds that “to date, [Petitioner] has not argued that any term in the ’545 patent should be construed as a means-plus-function limitation.” Prelim. Sur-reply 6.

Thus, it appears the parties agree that no means-plus-function claim limitations are at issue in this case.

Given this, Patent Owner’s argument concerning Petitioner not satisfying 37 C.F.R. §§ 42.104(b)(3) and 42.104(b)(4) is not sufficiently developed on this record.

F. Overview of the Prior Art References

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. . . . active 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.

Ex. 1005, 7:21–48.

Figure 3A, illustrating a pictorial representation of a user interface desktop (Ex. 1005, 3:61–62), is reproduced below. The composite desktop and its components are illustrated in Figure 3A, a pictorial representation of a user interface desktop, which is reproduced below.

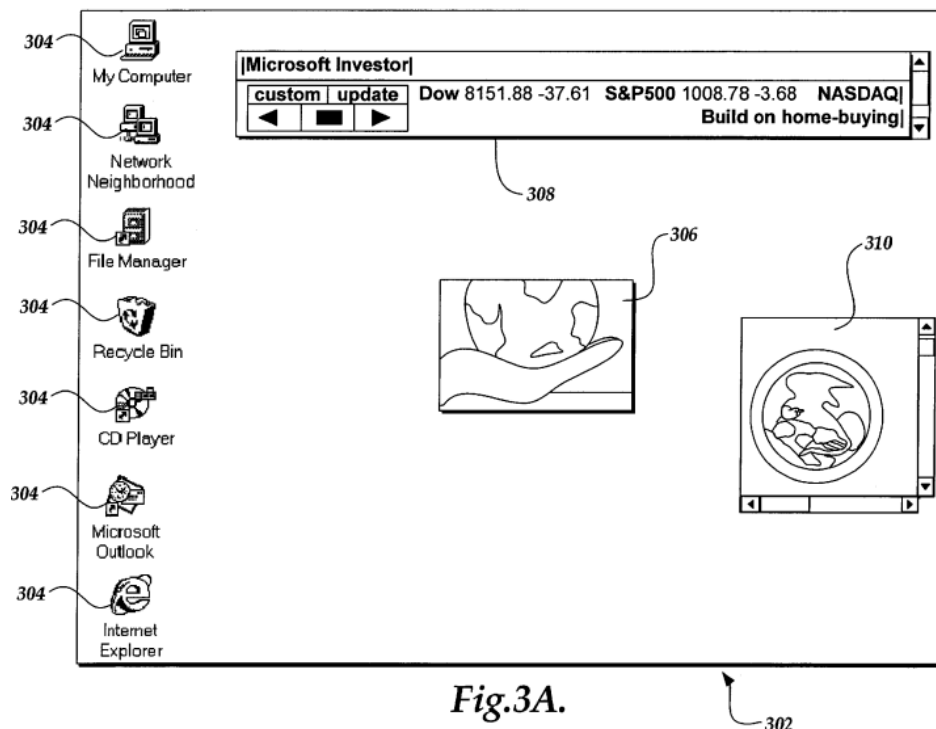


Figure 3A illustrates a desktop 302, icons 304, a static desktop component 306, an active desktop component 308, and a Web page desktop component 310. Ex. 1005, 7:9–48.

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).

Figure 1, illustrating an embodiment of a mobile device in a system (Ex. 1006, 2:39–41), is reproduced below.

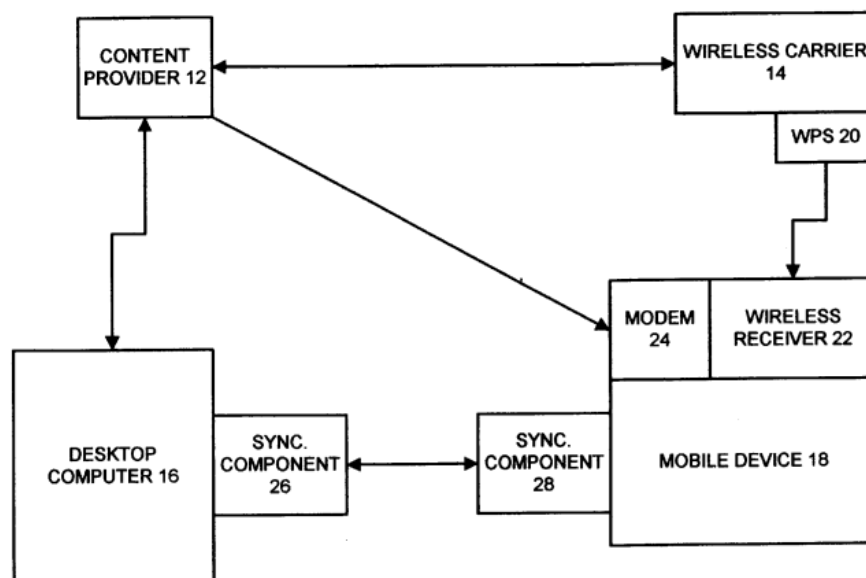


Figure 1 illustrates a system 10 including content provider 12, wireless carrier 14, desktop computer 16 and mobile device 18. Ex. 1006, 2:62–67.

Wecker indicates that content structure files (also termed “content 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. *Beer (Ex. 1007)*

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 Abstr.; *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.

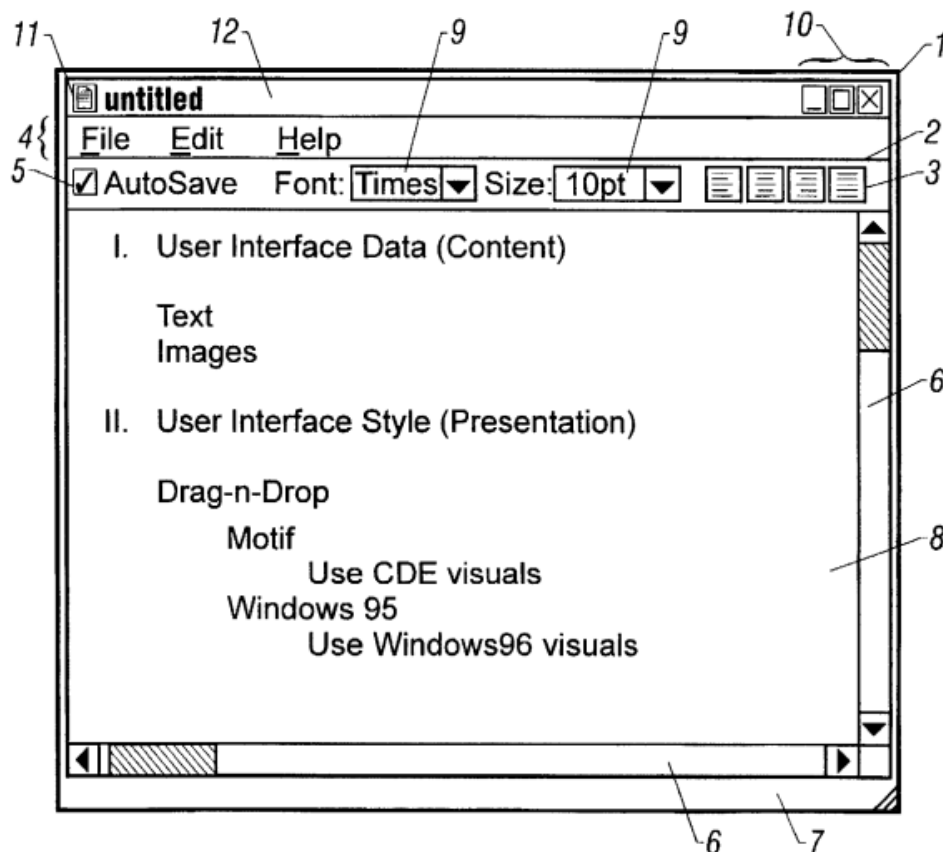


Figure 1 illustrates user interface widgets for user interface design. Figure 1 shows a window 1, separator 2, toolbar buttons 3, menu bar 4, radiobutton 5, sliders 6, status bar 7, content area 8, dropdown listboxes 9, window control buttons 10, window icon 11, and title bar 12. Ex. 1007, 4:1–9.

4. Shimada (Ex. 1008)

Shimada relates to “a data converting device functioning as a relay for relaying multimedia data transmitted through a plurality of kinds of transmission media.” Ex. 1008, 1:15–1:48. Shimada provides a “data converting device having information output means for outputting the data after the conversion process . . . above is executed and data that is newly generated.” *Id.* at 1:50–54.

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.

Shimada’s system comprises a server that stores screen configuration data “for defining the screen configuration of the client screen display.” Ex. 1008, 6:4–6. According to Shimada, with respect to:

screen configuration data describing configuration of [a] screen output of an information processing unit, [a] predetermined rule adds a display area of the screen configuration and converts it to a screen configuration data capable of displaying a plurality of screen configurations on the same screen.

Id. at Abstr. Figure 5 shows an example of screen configuration data.

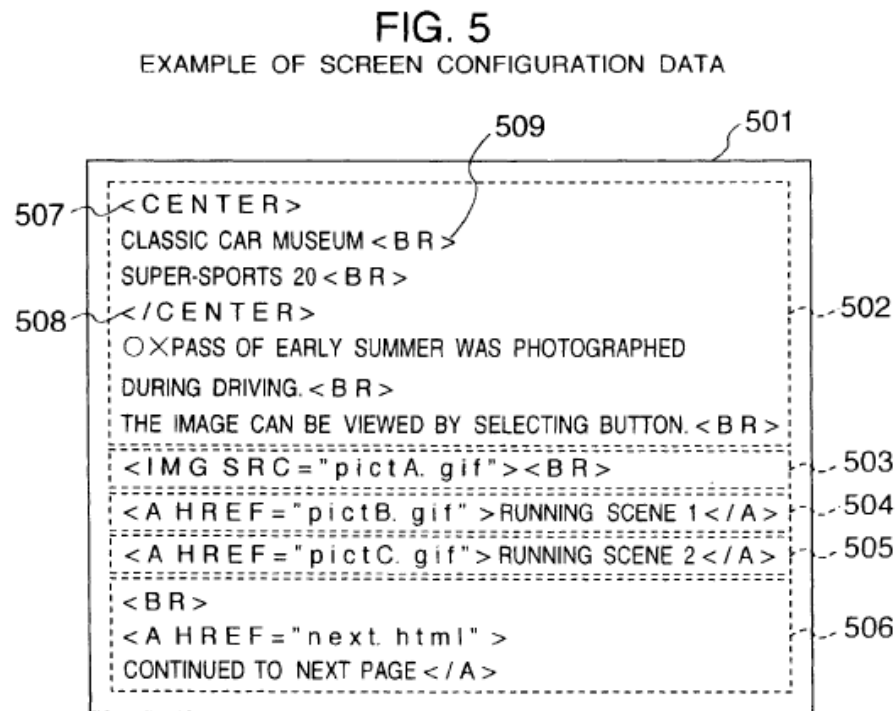


Figure 5 illustrates an example of screen configuration data. Ex. 1008, 4:11.

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.

5. 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.

6. Darnell (Ex. 1011)

Darnell is directed to HTML (Hypertext Markup Language) and web page design, including page and tag structure. Ex. 1011.

7. Krishna (Ex. 1021)

Krishna describes a “software program that operates in connection with a dynamic content publishing program.” Ex. 1021, Abstr. Krishna further describes a Viewer program that is:

activated to locate and interpret . . . object content and actions contained in [a] template file. As a result, the Viewer program then causes information to be displayed within each region of the screen in accordance with the instructions in the template file. The Viewer program also executes any actions between objects as required.

Id. at 2:15–21.

G. Patent Owner Arguments Regarding Burden of Production

Patent Owner contends Petitioner fails to meet its burden of production with respect to challenged claims 1–16 due to two improper shortcuts it believes Petitioner has taken. Prelim. Resp. 18–21. “[T]he Board should deny institution” due to these shortcuts. *Id.* at 21.

First, according to Patent Owner, Petitioner provides tables in lieu of patentability arguments for challenged claims 16 and 20 under Ground 1B. Prelim. Resp. 19–20 (reproducing the two tables from Pet. 59 (covering limitations [16.1]–[16.5]), 62 (covering limitations [20.2]–[20.5])). As an

example, we reproduce Petitioner’s table included in its challenge of claim 20 along with the preceding heading and sentence:

[20.2]-[20.5]

The Brown-Wecker-Beer combination renders these claims obvious in the same manner as explained above for the corresponding claims listed in the following table. SAMSUNG-1003, ¶¶136-139; see *In re Harza*, 274 F.2d at 671.

Claim	Corresponding Claim
[20.2]	[1.7], [11]
[20.3]	[1.5], [11]
[20.4]	[1.8], [11]
[20.5]	[11], [18]

[21]

Pet. 62; Prelim Resp. 20. The table for claim 16 is similar. See Pet. 59; Prelim. Resp. 20.

Patent Owner argues that said tables are a shotgun approach to argument and forces the Board to play archeologist with respect to its invalidity arguments with respect to its challenge of claims 16 and 20. Prelim. Resp. 18–19. “For example, it is unclear from the above table whether [1.7] should be interpreted as a reference to the ‘external document,’ that includes a custom listing of challenged claim elements, or to the section 1.7 or both.” *Id.* at 20 (citing Pet. iv–ix).

The sentences preceding the tables make it clear that Petitioner’s position for a particular limitation is the “same” as its position for the corresponding limitations in the table. So, for example, Petitioner’s position for limitation [20.2] is that the “Brown-Wecker-Beer combination renders [it] obvious in the *same* manner as explained” for limitations [1.7] and [20.1]. Pet. 62 (emphasis added). The table provides an efficient way for

Petitioner to make the same argument. The Board is not forced to play archeologist with respect to Petitioner's invalidity arguments. It is clear from the tables that Petitioner is repeating the same arguments provided earlier in the Petition, albeit for different claims.

Second, according to Patent Owner, "Petitioner takes another shortcut via footnote 2, which applies to all claims including claim 9–15." Prelim. Resp. 21 (reproducing footnote 2). Footnote 2 of the Petition states: "Descriptions of the references and combinations thereof are incorporated into each mapping that includes citations to these references. All emphasis is added unless otherwise indicated." Pet. 8, footnote 2.

Patent Owner states that "[Petitioner] point[s] to 'references and combinations thereof' that are somehow 'incorporated into each mapping' 'that included citations to these references.'" Prelim. Resp. 8. Patent Owner interprets this as Petitioner "[not] putting forward a specific prior-art combination and explanation of the alleged significance of any combinations in its petition." *Id.*

To the contrary, notwithstanding what the footnote says, the Petition indeed provides an explanation for why a specific prior art combination would have rendered obvious every claim limitation. *See* Pet. 8–104.

Patent Owner's arguments do not provide a basis to deny the Petition.

H. Ground 1A

Petitioner challenges claims 1–4, 6–10, and 13–15 as unpatentable under 35 U.S.C. § 103(a) over the combination of Brown and Wecker. Pet. 8–50.

1. Independent claim 1

Petitioner contends that the combination of Brown and Wecker (“art combination”) would have rendered obvious the method as claimed. *See* Pet. 14–38.

We observe that, with the exception of arguments addressed above, Patent Owner has not responded to Petitioner’s position as to the preamble ([1pre]) and limitations [1.1]–[1.8] with any particularity at this stage of the proceeding. *See generally* Prelim. Resp. 22–27. As to these limitations, we have reviewed the evidence Petitioner has presented, briefly discussed below, and based on our evaluation of that evidence, we determine that at this stage Petitioner sufficiently shows on this record that the art combination would have rendered obvious the subject matter recited in said preamble ([1pre]) and limitations [1.1]–[1.8].

Patent Owner puts forward an argument concerning Jones (Ex. 1010) which pertains to Petitioner’s contentions relative claim 2. We treat that argument separately in section II.H.3. below.

[1pre] A computer-implemented method of obtaining content over a network and displaying the content to a user, the method being implemented in a client computing device in operative communication with a server over a network, the client computing device including electronic storage, a display, and one or more processors configured to execute one or more computer program modules, the method comprising:

Petitioner contends that, if the preamble is limiting, the Brown-Wecker combination renders [1.pre] obvious. Pet. 14.

A computer-implemented method of obtaining content over a network and displaying the content to a user, the

*method being implemented in a client computing device
in operative communication with a server over a network*

For this portion of the preamble, Petitioner shows, *inter alia*, that Brown teaches “a ‘**computer-based method** (‘**computer-implemented method**’) of creating a composite desktop built from Web content,’ and that ‘an operating system user interface shell program executes on a computer, preferably a general purpose personal computer.’” Pet. 14 (quoting Ex. 1005, 2:54–56, 4:32–34).

In support, Dr. Schmidt explains that “[a] POSITA would have understood or found obvious that ‘a computer-based system’ and ‘personal computer’ includes a ‘**client computing device**,’ as a computer is frequently referred to as a ‘client.’” Ex. 1003 ¶ 43 (citing 2:54–57, 4:32–40, claim 15); Pet. 15. According to Dr. Schmidt, “[a] POSITA also would have understood that Brown’s ‘Web content’ is ‘**content over a network**.’” Ex. 1003 ¶ 43 (citing Ex. 1005, 2:54–57).

the client computing device including electronic storage,

For this portion, Petitioner shows that Brown discloses that the “general purpose computing device in the form of a conventional personal computer” includes a “system memory.” Pet. 15 (quoting Ex. 1005, 4:55–58).

Dr. Schmidt explains that “[a] POSITA would have understood or found obvious that a system memory is a form of ‘**electronic storage**’ because a POSITA would have understood that memory is an example of electronic storage.” Ex. 1003 ¶ 45; Pet. 15.

a display,

Petitioner provides an annotated version of Figure 1 of Brown, reproduced below, showing, outlined in red, “an electronic display, which Brown refers to as a ‘monitor’,” thereby showing that Brown teaches a “display.” Pet. 17 (quoting Ex. 1005, 5:38–39) (emphasis omitted).

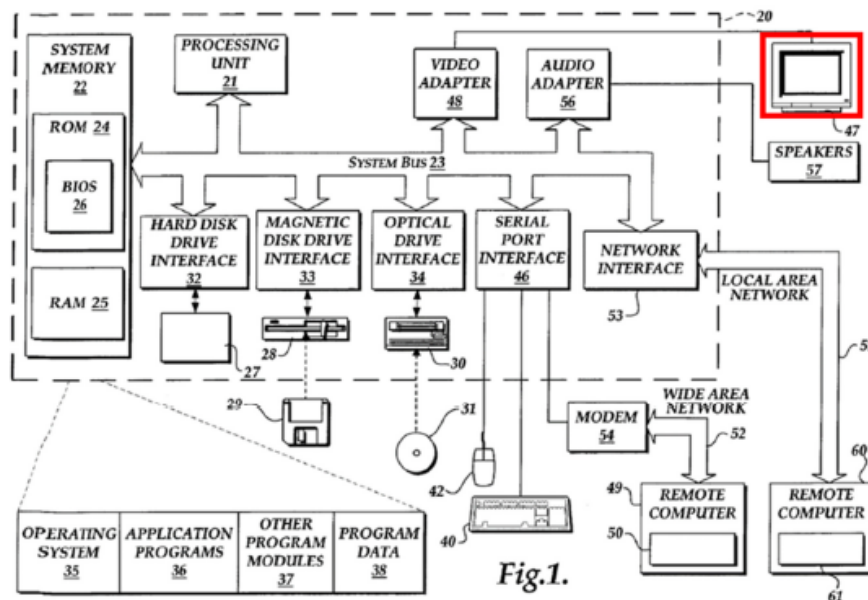


Figure 1 of Brown illustrates a general purpose computer system with the display annotated with a red outline. Ex. 1005, 3:56–57; 5:38–39.

and one or more processors configured to execute one or more computer program modules

Lastly, Petitioner provides annotated versions of Figures 1 and 2 of Brown, reproduced below, showing an “‘HTML viewer’ and ‘composite desktop shell’ (**‘one or more program modules’**) that access and execute the HTML instructions that define the desktop components.” Pet. 18 (citing Ex. 1005, 6:26–40; Ex. 1003 ¶ 47).

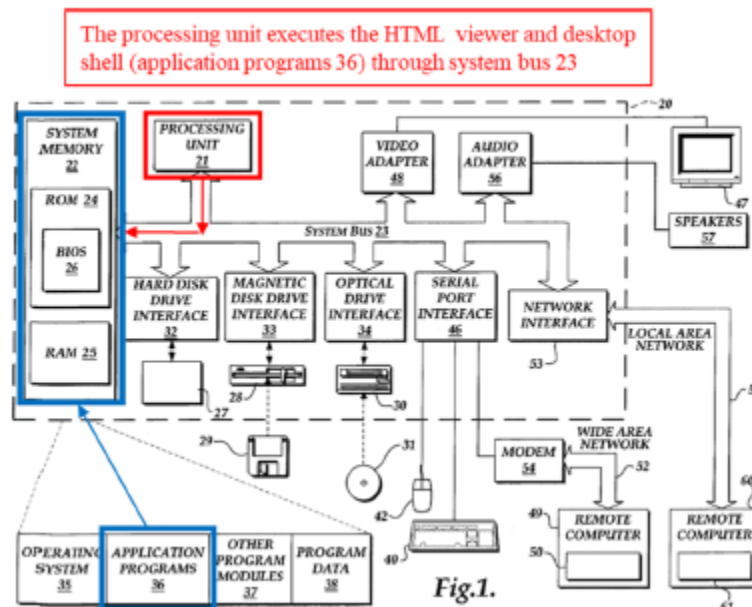


Figure 1 of Brown illustrates a general purpose computer system with the processing unit annotated with a red outline and application programs outlined in blue. Ex. 1005, 3:56–57; 6:26–40.

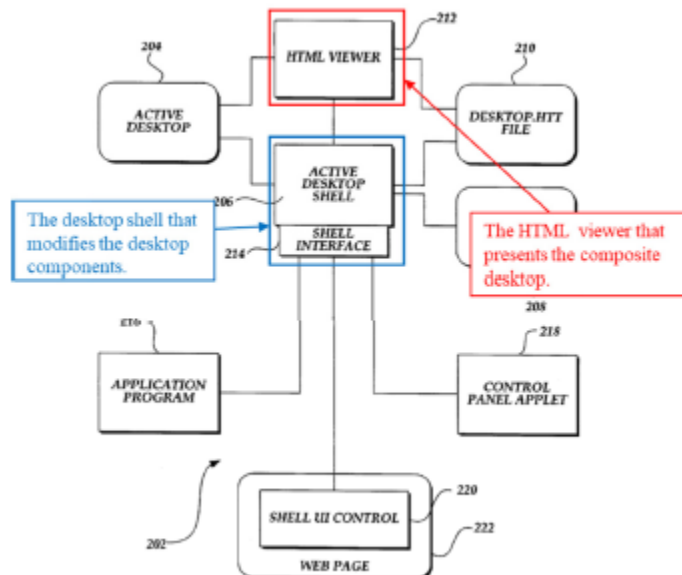


Figure 2 of Brown depicts “a system 202 for manipulating and viewing a composite desktop 204 includes a composite desktop shell 206 as the core object controlling the composite desktop,” with the HTML viewer outlined in red and the desktop shell outlined in blue. Ex. 1005, 6:10–13, 6:26–40.

According to Dr. Schmidt, “[a] POSITA would have understood or found obvious that both the ‘HTML viewer’ and ‘composite desktop shell’ are ‘**executed**’ by ‘**one or more processors**’ because processors were known in the art to execute such programs.” Ex. 1003 ¶ 48; Pet. 19–20.

We have reviewed the evidence. In our view, at this stage, Petitioner sufficiently shows on this record that the Brown-Wecker combination renders [1.pre] obvious.⁶

[1.1] transmitting a request to the server over the network, the request requesting [NIM] template;

transmitting a request to the server over the network

Petitioner shows that Brown teaches that “its client device can download content.” Pet. 25 (citing, *inter alia*, Ex. 1005, 2:4–12). “Indeed, Brown describes that “[a] ‘client’ computer connected to the Internet can **download** (“**transmitting ... a request**”) digital information from ‘**server**’ **computers** connected to the Internet (“**over the network**”).” *Id.* (quoting Ex. 1005, 2:4–8; citing Ex. 1003 ¶ 61) (alterations in original).

Dr. Schmidt explains in support that “[a] POSITA would have understood or found obvious that this transmission would occur ‘**to a server over [a] network**’ because Brown describes the use of ‘uniform resource locators’ or ‘URLs’ which are known to correspond to such network locations hosted on such servers.” Ex. 1003 ¶ 62 (citing Ex. 1005, 3:24–33, 11:43–67, 12:1–43); Pet. 25.

⁶ At this stage of the proceeding, we do not determine whether the preamble is limiting. *See Vivid Techs.*, 200 F.3d at 803.

the request requesting [NIM] template

Petitioner contends that “Brown’s HTML instructions correspond to a “[NIM] template.” Pet. 24 (citing Ex. 1003 ¶ 60).

Dr. Schmidt explains that “a POSITA would have recognized or found obvious that the ‘HTML instructions’ that define Brown’s ‘desktop components’ are a ‘[NIM] template’” because these HTML instructions have similar features.” Ex. 1003 ¶ 54 (citing Ex. 1005, 11:39–67, 12:1–43); Pet. 24.

Dr. Schmidt further explains that “a POSITA would have recognized or found obvious that a set of Brown’s HTML instructions includes all of [the] features” of a “NIM template”; that is, “a **data structure** that defines the **characteristics of a NIM**, including the **NIM frame, view, and control characteristics**, [which] excludes executable applications/compiled code.” Ex. 1003 ¶ 54 (referring to Petitioner’s proposed construction for “NIM template,” see section II.E.2) (alteration in original).

Petitioner details how Brown’s HTML instructions include all of the features of a “NIM template” as that term is construed:

- “Brown describes that these [HTML] instructions are ‘generated from the data stored in the registry 208’ (“**a data structure**”). Pet. 23 (citing Ex. 1005, 14:7–8);
- “Brown describes that ‘lines 14–17 [in the example code [see Ex. 1005, 11:56–67, 12:1–10]] comprise HTML instructions that **describe the active desktop component 308**,’ (‘**defines the characteristics of [the] NIM**).’ *Id.* (citing Ex. 1005, 12:61–62) (primary alterations in original);
- “Brown describes that ‘[f]loating **frames** are designated by

the ‘IFRAME’ tag,” which “Brown’s HTML instructions utilize to **‘define the frame of the desktop component.’**” *Id.* (citing Ex. 1005, 12:65–66, 11:56–67, 12:1–10; Ex. 1003 ¶ 56) (alteration in original);

- “visual features of the desktop component (**‘the view’**) are defined by the HTML instructions.” *Id.* (citing Ex. 1005, 11:56–67, 12:1–10; Ex. 1003 ¶ 57);
- “Brown’s HTML instructions provide the ability to designate a desktop component as ‘resizable’ (**‘a control characteristic’**).” *Id.* (Ex. 1005, 11:56–67, 12:1–10); and,
- “Brown’s HTML instructions do not contain **‘applications’** or **‘compiled code.’**” *Id.* at 23–24 (citing Ex. 1005, 11:56–67, 12:1–10; Ex. 1003 ¶ 59).

We have reviewed the evidence. In our view, at this stage, Petitioner sufficiently shows on this record that the combination of Brown and Wecker satisfies limitation [1.1].

[1.2] receiving the requested [NIM] template from the server over the internet, the requested [NIM] template having been transmitted from the server over the network responsive to the transmitted request, the [NIM] template comprising:

Petitioner relies, *inter alia*, on its discussion of limitation [1.1] which addresses transmitting a request for a NIM template to a server over a network. Pet. 26 (citing Ex. 1003 ¶ 65).

Dr. Schmidt further explains that a “POSITA would have understood or found obvious that, once requested from the web server, the client would receive the content included in the request (**‘receiving the requested networked information monitor template from the server over the**

internet ... responsive to the transmitted request’).” Ex. 1003 ¶ 65
(alteration in original); Pet. 26.

We have reviewed the evidence. In our view, at this stage, Petitioner sufficiently shows on this record that the combination of Brown and Wecker satisfies limitation [1.2].

*[1.3] a definition of a viewer graphical user interface within
which content in a web browser-readable language may be
presented on the display of the client computing device; and
a definition of a viewer graphical user interface*

Petitioner shows, *inter alia*, that “Brown refers to its composite desktop (and all Windows-based desktops) as a ‘GUI desktop.’” Pet. 27 (citing Ex. 1005, 1:35–38, Fig. 3A). Petitioner explains that “[b]ecause Brown’s HTML instructions define the desktop component, a POSITA would have recognized or found obvious that they contain ‘a definition of a graphical user interface’,” as this portion of [1.3] calls for. *Id.* (emphasis omitted).

*within which content in a web browser-readable
language may be presented on the display of the client
computing device*

Petitioner shows that “Brown . . . describes that desktop components are ‘implemented as floating frames’ that bound the content of the component (**‘within which content ... is presented’**).” Pet. 28 (quoting Ex. 1005, 12:63–64; referring to the “monitor” depicted in annotated Figure 1 (reproduced above)) (second alteration in original). According to Dr. Schmidt, “[a] POSITA would have recognized or found obvious from this disclosure that a display would be used to **[present] content on the display**

of the client computing device.” Ex. 1003 ¶ 67 (second alteration in original).

Petitioner further shows that “Brown also describes that Web pages or documents presented in desktop components ‘[function] similarly to the corresponding Web page **viewed in a browser window.**” Pet. 28 (quoting Ex. 1005, 11:24) (alteration in original). Dr. Schmidt explains that a “POSITA also would have recognized that HTML is an example of a ‘**web-browser readable,**’ as HTML is one of the most common examples of such a language.” Ex. 1003 ¶ 68; Pet. 29.

We have reviewed the evidence. In our view, at this stage, Petitioner sufficiently shows on this record that the combination of Brown and Wecker satisfies limitation [1.3].

[1.4] a definition of a first content element for the [NIM] template, the definition of the first content element referencing a first network location from which the first content element for the [NIM] template is served over the network;

Petitioner contends that “one of Brown’s example desktop components includes ‘a URL corresponding to a CDF [Channel Definition Format] file.’” Pet. 29 (quoting Ex. 1005, 13:4–5). Petitioner quotes Brown as teaching that “CDF files are used to implement ‘subscriptions’ in which information is regularly retrieved and updated (‘served over the network’) within the active desktop component.” *Id.* at 30 (quoting Ex. 1005, 13:4–7; citing Ex. 1003 ¶ 71) (emphasis omitted).

Dr. Schmidt explains that “[a] POSITA would have recognized the CDF subscription to be ‘**a first content element . . . referencing a first network location**’ because CDF subscriptions reference a URL, at which, content is available.” Ex. 1003 ¶ 70 (second alteration in original); Pet. 29.

Dr. Schmidt further explains that “a POSITA would have understood or found obvious that a Uniform Resource Locator (‘URL’) to be a ‘network location’ as this is the most common use of a URL.” Ex. 1003 ¶ 72; Pet. 30. Petitioner adds that “URLs are commonly thought of as pointers to a filename in a directory **on a Web server.**” Pet. 30–31 (quoting Ex. 1011, 103).

We have reviewed the evidence. In our view, at this stage, Petitioner sufficiently shows on this record that the combination of Brown and Wecker satisfies limitation [1.4].

[1.5] responsive to instructions included in the requested [NIM] template, presenting the viewer graphical user interface defined by the [NIM] on the display of the client computing device separate from and outside of any other graphical user interface that includes user controls for specifying the first network location from which the first content element for the [NIM] is served over the network;

Petitioner relies, in part, on its position with respect to limitation [1.3] which addresses a “viewer graphical user interface.” Pet. 31 (citing Ex. 1003 ¶ 73) (emphasis omitted).

responsive to instructions included in the requested [NIM] template, presenting the viewer graphical user interface defined by the [NIM] on the display of the client computing device

Petitioner has shown that “Brown’s ‘computer-based system’ includes an electronic ‘**display**’, which Brown refers to as a “monitor.”” Pet. 31 (citing Ex. 1005, 5:38–39; *see also* annotated Fig. 1 above).

Dr. Schmidt explains that “[a] POSITA would have recognized or found obvious from this disclosure that a display would be used to present content to a viewer (‘**presenting ... on the display of the client computing**

device’).” Ex. 1003 ¶ 74 (second alteration in original); Pet. 31. Dr. Schmidt further explains that “[a] POSITA would have recognized or found obvious that the ‘presenting’ of the ‘**viewer graphical user interface**’ is performed ‘**responsive to instructions included in the requested networked information monitor template**’ as Brown’s HTML instructions are used to render the desktop component.” Ex. 1003 ¶ 75 (citing Ex. 1005, 11:56–67, 12:1–10); Pet. 31–32.

separate from and outside of any other graphical user interface that includes user controls for specifying the first network location from which the first content element for the [NIM] is served over the network;

Petitioner contends that “Brown describes its ‘desktop components’ as ‘**distinct** geometric region[s]’ (‘**separate from and outside**’).” Pet. 32–33 (quoting Ex. 1005, 7:21–23, citing Fig. 3A) (alteration in original). Petitioner explains that, “[r]eferencing Brown’s FIG. 3A above, it can be seen that desktop components lack “user controls for specifying the first network location from which the first content element for the networked information monitor is served over the network.”” *Id.* at 33 (citing Ex. 1005, Fig. 3A; Ex. 1003 ¶ 77) (emphasis omitted).

In support, Dr. Schmidt testifies that “a POSITA would have recognized or found obvious in reviewing Brown’s figures that the components are displayed ‘**separate from and outside of any other graphical user interface**.’” Ex. 1003 ¶ 76 (citing Ex. 1005, 7:21–23, Fig. 3A); Pet. 32–33.

We have reviewed the evidence. In our view, at this stage, Petitioner sufficiently shows on this record that the combination of Brown and Wecker satisfies limitation [1.5].

[1.6] responsive to instructions included in the requested [NIM] template, transmitting over the network a first content request to the first network location referenced by the definition of the first content element for the [NIM] template;

Petitioner shows that Brown teaches “[a] ‘client’ computer connected to the Internet can **download** (**‘transmitting ... a first content request’**)” digital information from ‘server’ computers connected to the Internet.” Pet. 34 (quoting Ex. 1005, 2:6–8; citing Ex. 1003 ¶ 78) (alterations in original).

Dr. Schmidt explains that “[a] POSITA would have understood or found obvious that this transmission would include a reference to ‘**a first network location referenced by the definition of the first content element**’ because Brown describes the use of ‘uniform resource locators’ or ‘URLs’ which are known to correspond to such network locations.” Ex. 1003 ¶ 79 (citing Ex. 1005, 3:24–33, 11:43–67, 12:1–43); Pet. 34–35.

We have reviewed the evidence. In our view, at this stage, Petitioner sufficiently shows on this record that the combination of Brown and Wecker satisfies limitation [1.6].

[1.7] receiving, over the network, the first content element transmitted responsive to the first content request;

Petitioner relies, in part, on its discussion of limitation [1.3]. Pet. 36.

Petitioner shows that “Brown describes that CDF subscriptions ‘are used to implement ‘subscriptions’ in which information is regularly retrieved (**‘receiving ... the first content element’**) and updated.” Pet. 36 (citing Ex. 1005, 12:1–8, 13:4–13) (alteration in original); *see also* discussion of limitation [1.4].

According to Dr. Schmidt, “[a] POSITA would have understood or found obvious that, once requested from the web server (**‘over the network’**), the client would receive the content included in the request (**‘in response to the first content request’**).” Ex. 1003 ¶ 82; Pet. 36.

We have reviewed the evidence. In our view, at this stage, Petitioner sufficiently shows on this record that the combination of Brown and Wecker satisfies limitation [1.7].

[1.8] presenting the received the first content element in the viewer graphical user interface defined by the [NIM] template, wherein the definition of the viewer graphical user interface and/or the first content element define all controls for enabling a user to interact with the first content element through the viewer graphical user interface.

Petitioner relies, in part, on its discussion of limitations [1.4] and [1.5]. Pet. 37.

presenting the received the first content element in the viewer graphical user interface defined by the [NIM] template,

Regarding this portion of limitation [1.8], Dr. Schmidt testifies that “[a] POSITA would have recognized or found obvious that Brown’s **‘content element[s]’ are ‘[presented] ... in the viewer graphical user interface defined by the networked information monitor template.’**” Ex. 1003 ¶ 85 (citing Ex. 1005, Fig. 3A); Pet. 37.

wherein the definition of the viewer graphical user interface and/or the first content element define all controls for enabling a user to interact with the first

content element through the viewer graphical user interface.

Petitioner provides an annotated version of Brown Figure 3A, reproduced below, to show that “Brown’s desktop components define ‘all controls for enabling a user to interact with the first content element,’ as all controls presented in the GUI are within the frame.” Pet. 37 (citing Ex. 1005, Fig. 3A).

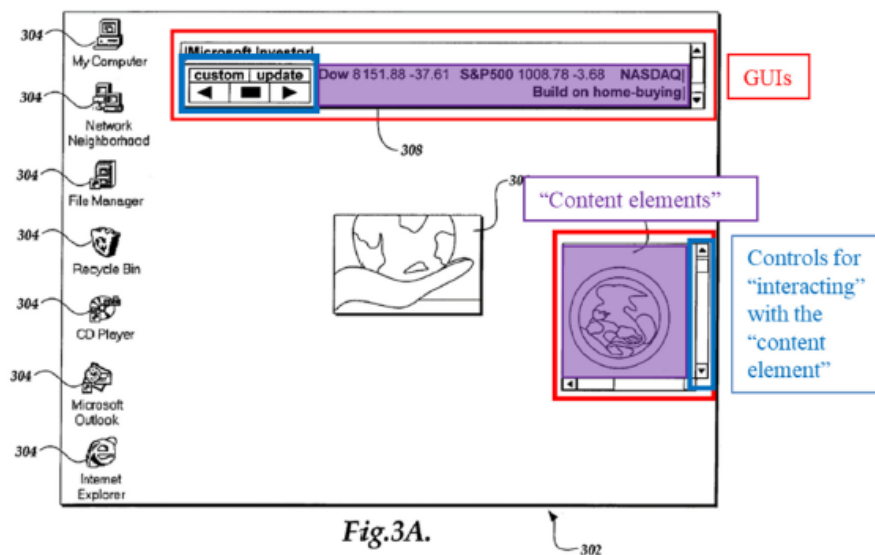


Figure 3A of Brown illustrates a desktop 302, icons 304, a static desktop component 306, an active desktop component 308, and a Web page desktop component 310, annotated to show “GUIs,” “Content elements,” and “Controls,” outlined in red. Ex. 1005, 7:9–48.

Dr. Schmidt explains that “[a] POSITA would have recognized or found obvious that a ‘viewer graphical user interface and/or ... content element’ would define ‘all controls for enabling a user to interact with [the] content element.’” Ex. 1003 ¶ 85; Pet. 37.

We have reviewed the evidence. In our view, at this stage, Petitioner sufficiently shows on this record that the combination of Brown and Wecker satisfies limitation [1.8].

We are persuaded that the evidence relied upon by Petitioner sufficiently supports Petitioner's position that the combination of Brown and Wecker would have rendered obvious the subject matter of claim 1.

2. Claims 2–4, 6–10, 13–15 Depending from Claim 1

Petitioner argues that claims 2–4, 6–10, and 13–15 depending from claim 1 are also taught or rendered obvious over the art combination. Pet. 38–50.

Along with our reasons discussed with respect to the challenge of claim 1, we are persuaded that the evidence relied upon by Petitioner sufficiently supports Petitioner's contentions regarding claims 2–4, 6–10, and 13–15.

Patent Owner does not provide any specific arguments challenging Petitioner's patentability position as to these claims. *See* Prelim. Resp. 22–23.

3. Patent Owner's Arguments Regarding Jones

In the section entitled "VIII. PETITIONER HAS FAILED TO SHOW A REASONABLE LIKELIHOOD OF SUCCESS FOR ANY GROUNDS 1A, 1B, 2A, 2B, AND 2C," Patent Owner draws our attention to this statement in the Petition: "Third, Brown additionally directs the reader to 'Jones,' a co-pending application directed to "managing position and size for a desktop component." Prelim. Resp. 22 (citing "Pet. 44" (sic, quoting Pet. 41)); Pet. 41 (citing Ex. 1005, 13:39–44 ("Component manipulation controls are described in further detail in the copending patent application, Managing Position and Size for a Desktop Component, by Brown et al., filed on Feb. 17, 1998, having attorney docket number MSFT-1-11313, which is incorporated herein by reference in its entirety."); Ex. 1010 (Jones), Cover).

Patent Owner contends that “Brown merely cites to an attorney docket number and has no patent number citation to Jones.” Prelim. Resp. 22. To the extent Patent Owner is arguing that this undermines Petitioner’s position we disagree.

Patent Owner acknowledges that Jones was “expressly considered by the Patent Examiner” and that Jones is cited on the IDS in the patent application file of the ’545 patent. Prelim. Resp. 22–23 (citing Ex. 2003). Said IDS associates “Jones” with U.S. Patent 6,819,345. Ex. 2003, 8 (reference 6N). Thus, it appears Patent Owner understands what Petitioner is referring to when it states that “Brown additionally directs the reader to ‘Jones’.” Pet. 41.

Furthermore, in referring to “Jones,” Petitioner cites Ex. 1010, which is a copy of U.S. Patent No. 6,819,345, and the “Cover” of the ’545 patent records “6,819,345 B1 11/2004 Jones et al.” among the references cited. Ex. 1001, 3, code (56). Thus, Petitioner is clear about the patent it refers to as “Jones.”

Also, although Patent Owner’s argument is relevant to Petitioner’s position as to claim 2, it does not undermine it. *See* Pet. 38–42. Petitioner provides three alternative disclosures by which Brown teaches the claimed definition, only one of which mentions Jones. *Id.* at 41 (citing Ex. 1010 (Jones); Ex. 1003 ¶ 89). Since Patent Owner has not responded to the substance of Petitioner’s challenge as to claim 2, Patent Owner’s argument does undermine Petitioner’s position based on the other two disclosures.

Finally, Patent Owner argues that Petitioner neither establishes the critical date for Jones nor does Petitioner explain how or why a POSITA

would combine Jones with Brown or why Brown and Jones should be treated as one reference. Prelim. Resp. 22–23.

The difficulty with this argument is that it incorrectly characterizes Petitioner’s challenge (as to claim 2) as based on a combination of Brown and Jones. Petitioner is not relying on Jones as a separate reference. Rather, Petitioner relies on Brown and it is Brown which “directs the reader to ‘Jones’.” Pet. 41. This is necessarily so because Jones “is *incorporated* herein [i.e., Brown] by *reference in its entirety*.” Ex. 1005, 13:43–44 (emphasis added). Consequently, Jones is effectively part of Brown. *See Finjan LLC v. ESET, LLC*, 51 F.4th 1377, 1382 (Fed. Cir. 2022):

Patents that are incorporated by reference are “effectively part of the host [patents] as if [they] were explicitly contained therein.” *X2Y Attenuators, LLC v. U.S. Int’l Trade Comm’n*, 757 F.3d 1358, 1362–63 (Fed. Cir. 2014) (alterations in original) (citations omitted). Incorporation by reference of a patent “renders ‘the entire contents’ of that patent’s disclosure a part of the host patent.” *Id.* at 1363 (citing *Ultradent Prods., Inc. v. Life-Like Cosmetics, Inc.*, 127 F.3d 1065, 1069 (Fed. Cir. 1997); Manual of Patent Examining Procedure § 608.01(p) (6th ed. 1996)). Accordingly, definitions in any incorporated patents or references are a part of the host patent.

I. Ground 1B

Petitioner challenges claims 5, 11, 12, and 16–21 as unpatentable under 35 U.S.C. § 103(a) over the combination of Brown and Wecker in view of Beer. Pet. 54–58.

At this stage of the proceeding, it is unnecessary for us to provide a detailed assessment of claims 5, 11, 12, and 16–21 under Ground 1B because Petitioner has demonstrated a reasonable likelihood of success in demonstrating that at least one claim (i.e., claim 1) of the ’545 patent is

unpatentable under Ground IA. *See* 37 C.F.R. § 42.108(c) (2021). We add the following remarks.

1. Claims 5, 11, 12 Depending from Claim 1

Petitioner argues that claims 5, 11, and 12 depending from claim 1 are also taught or rendered obvious over the art combination. Pet. 38–50.

Along with our reasons discussed with respect to the challenge of claim 1, we are persuaded that the evidence relied upon by Petitioner sufficiently supports Petitioner’s contentions regarding claims 5, 11, and 12.

Patent Owner does not provide any specific arguments challenging Petitioner’s patentability position as to these claims. *See* Prelim. Resp. 22–23.

2. Independent claim 16

Petitioner argues that independent claim 16 is taught or rendered obvious over the art combination. Pet. 58 (relying in part on its arguments with respect to claim 11 and limitations [1.6]–[1.8]; citing Ex. 1003 ¶¶ 125–129).

As to claim 16, we have reviewed the evidence Petitioner has presented and based on our evaluation of that evidence, we determine that at this stage Petitioner sufficiently shows on this record that the art combination would have rendered obvious the subject matter recited in said preamble ([16pre]) and limitations [16.1]–[16.5].

We observe that Patent Owner has not responded to Petitioner’s position as to the preamble ([16pre]) and limitations [16.1]–[16.5] with any particularity at this stage of the proceeding. *See generally* Prelim. Resp. 22–27.

3. Claims 17–21 Depending from Claim 16

Petitioner argues that claims 17–21 depending from claim 16 are also taught or rendered obvious over the art combination. Pet. 59–63.

Along with our reasons discussed with respect to the challenge of claim 16, we are persuaded that the evidence relied upon by Petitioner sufficiently supports Petitioner’s contentions regarding claims 5, 11, and 12.

Patent Owner does not provide any specific arguments challenging Petitioner’s patentability position as to these claims. *See* Prelim. Resp. 22–23.

J. Ground 2A

Petitioner challenges claims 1–4, 6, 7, 9, 10, and 13–15 as unpatentable under 35 U.S.C. § 103(a) over the combination of Shimada and Buchholz. Pet. 63–94.

At this stage of the proceeding, it is unnecessary for us to provide a detailed assessment of 1–4, 6, 7, 9, 10, and 13–15 under Ground 2A because Petitioner has demonstrated a reasonable likelihood of success in demonstrating that at least one claim (i.e., claim 1) of the ’545 patent is unpatentable under Ground IA. *See* 37 C.F.R. § 42.108(c) (2021). We add the following remarks.

1. Independent claim 1

Petitioner contends that the combination of Shimada and Buchholz would have rendered obvious the method as claimed. *See* Pet. 68–97.

We observe that Patent Owner responds to Petitioner’s contention with additional arguments only as it relates to limitation [1.4], i.e., “a definition of a first content element for the [NIM] template, the definition of the first content element referencing a first network location from which the

first content element for the [NIM] template is served over the network.”
See, e.g., Prelim. Resp. 23: “Petitioner fails to demonstrate how a local HTML file of Shimada that includes content that is presented on a NIM meets ‘definition of the first content element referencing a first network location from which the first content element for the networked information monitor template is served over the network’” ([1.4]).

Patent Owner has not responded to Petitioner’s position with arguments other than those addressed above as to the preamble ([1pre]) and limitations [1.1]–[1.3] and [1.5]–[1.8] with any particularity at this stage of the proceeding. *See generally* Prelim. Resp. 23–27. As to these limitations, we have reviewed the evidence Petitioner has presented, and based on our evaluation of that evidence, we determine that at this stage Petitioner sufficiently shows on this record that the combination of Shimada and Buchholz would have rendered obvious the subject matter recited in the preamble ([1pre]) and limitations [1.1]–[1.3] and [1.5]–[1.8]. Our discussion below of limitation [1.4] addresses Patent Owner’s specific arguments.

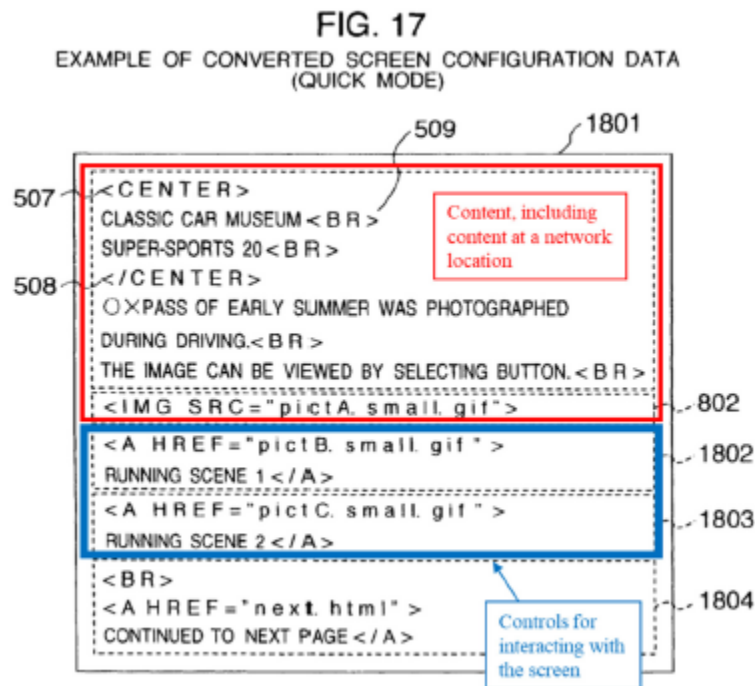
a. Petitioner’s Position Regarding Limitation [1.4]

Petitioner argues claim element 1.4 is obvious in light of Shimada. Pet. 82–84 (citing Ex. 1003 ¶¶ 169–171).

Petitioner contends that Shimada shows a NIM template. *See* Pet. 72–81 (discussing limitation [1.1])

According to Petitioner, “[a] POSITA would have recognized or found obvious that the ‘screen configuration data’ [of Shimada] is a ‘[NIM] template’ because screen configuration data has similar features.” Pet. 79 (citing Ex. 1008. 6:7–51; Ex. 1003 ¶ 163) (emphasis omitted). Petitioner

provides an annotated version of Figure 17 of Shimada, reproduced below, which it contends shows “screen configuration data,” i.e., a NIM template.



Dr. Schmidt testifies that Shimada’s “screen configuration data” is “also an HTML data structure that defines the presentation of content.” Ex. 1003 ¶ 156; Pet. 74.

Petitioner explains that Shimada’s “screen configuration data” include all of the features of a “NIM template,” as that term is construed⁷, because “Shimada’s screen configuration data contains multiple pieces of content and buttons (**“defines the characteristics of a NIM, including the NIM**

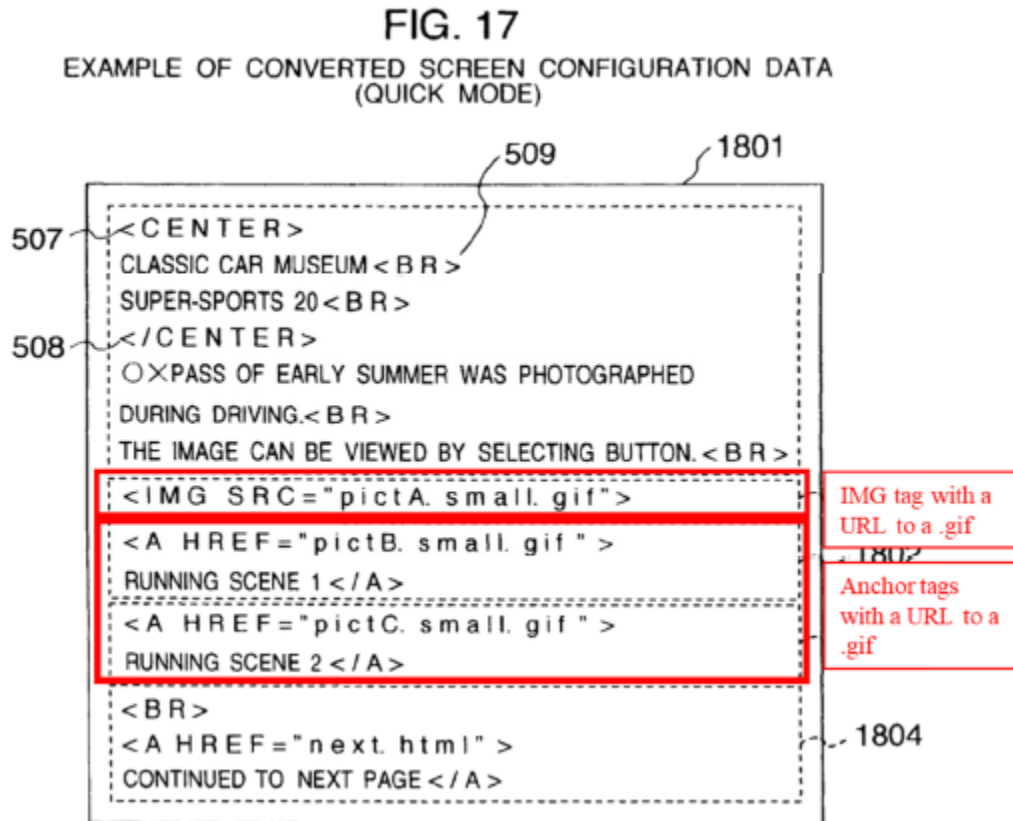
⁷ See section II.E.2 (“a data structure which defines the characteristics of a NIM, including the NIM frame, view, and control characteristics, and which exclude executable applications/compiled code.”).

frame, view, and control characteristics”). Pet. 79 (citing Ex. 1008, Fig. 17). Petitioner further explains that Shimada’s HTML screen configuration data does not contain ‘applications’ or ‘compiled code.’” *Id.* at 80 (citing Ex. 1008, 6:59–62, Figs. 16, 17; Ex. 1003 ¶ 164 (“A POSITA would have understood the advantages of a platform independent language, like HTML, and would have been motivated to avoid including additional compiled code that would render these advantages moot.”)) (emphasis omitted).

Per limitation [1.4], the NIM template comprises “a definition of a first content element for the [NIM] template, the definition of the first content element referencing a first network location from which the first content element for the [NIM] template is served over the network.” Thus, the NIM template must comprise a content element *referencing a first network location from which the first content element is served over the network*.

In that regard, Petitioner shows that Shimada teaches “the addition of a new screen display area to the screen configuration information which is **received from the server 101** and contains **data to be displayed and information** on the configuration of the screen for displaying this data.” Pet. 82 (quoting Ex. 1008, 5:52–65; citing Ex. 1003 ¶ 169).

Petitioner provides an annotated version of Shimada Figure 17, reproduced below, that it contends shows “URLs in screen configuration data.” Pet. 83, 84.



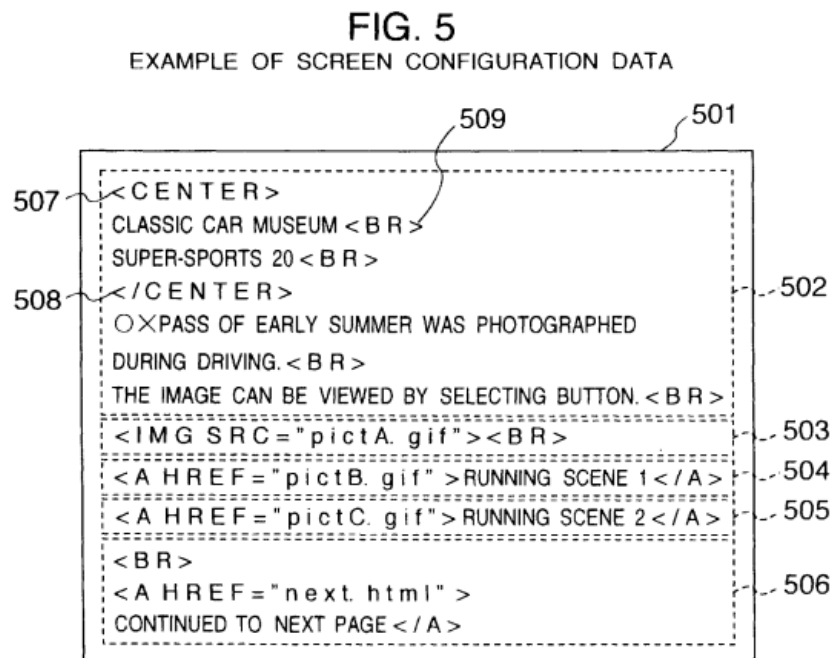
According to Dr. Schmidt, “a POSITA would have recognized or found obvious that both Shimada’s IMG and anchor tags include a **URL** that ‘comprises a **network location** at which content ... is accessible’ (‘a **first network location**’) because Shimada describes these tags as including an ‘address representing a static image’ which is obtained from a ‘server.’” Ex. 1003 ¶ 171 (citing Ex. 1008, 6:30–51)(alteration in original); Pet. 83. We reproduce the cited passage from Shimada:

[] in the description 503 is a tag referred to as “imaging”. Here, this tag describes that the data designated by [SRC=“ ”] is buried at this portion in the text. [pictA.gif] designated here is the address representing a static image. The client 105 requests the server 101 to transfer this pict A.gif, receives this data from the server 101 and displays it on the Screen in Succession to the text 602, so that the static image

603 is finally displayed on the screen of the client 105 as shown in FIG. 6.

[]0 and [] in the description 504 are referred to as "anchor tags", and the portion encompassed by these tags becomes a button on the Screen of the client 105. When the user clicks this button, the client 105 transmits the transfer request of the data designated by [HREF=""] in the anchor tag to the server. [pictB.gif] is the address representing the Static image 702. In the description 504, a text [running Scene 1] encompassed by the anchor tags becomes the button 604 in FIG. 6 at the time of screen display. When the user selects this button, the client 105 transmits the transfer request of the static image 702 to the server 101, and displays finally the static image 702 as shown in FIG. 7.

Ex. 1008, 6:30–51. Description 503 (image tag) and 504 (anchor tag) are shown in Shimada Figure 5, reproduced below:



b. Patent Owner's Argument Regarding Limitation [1.4]

Patent Owner argues that Petitioner fails to demonstrate how a local HTML file in Shimada that includes content that is presented on a NIM meets “definition of the first content element referencing a first network location from which the first content element for the *networked information monitor* template is served over the network.” Prelim. Resp. 23. According to Patent Owner, “[t]he issue turns on the disclosed components of Shimada in the html file being local references, which precludes accessing the content over the network at a later time.” *Id.* at 24 (citing Pet. 74).

Patent Owner disagrees with Petitioner that the image and anchor tags shown in Petitioner's annotated version of Shimada Figure 17 (see above) comprise a “network location” as limitation [1.4] requires. “[T]he HTML file of Shimada includes *content that is presented and controls for interacting with the screen in the same file*.” Prelim. Resp. 24. Patent Owner explains that the “images are stored locally and retrieved via a relative URL” and that that is evidenced by the notation “” in the html file. *Id.* at 26.

[E]very 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.

Id. at 27. Patent Owner explains that the tags shown in Shimada Figure 17 are “relative” tags which retrieve locally stored images/files and not “absolute” URLs which retrieve information from a network. *Id.* at 26.

“The relative URLs fetch information that is locally-stored information and does not and cannot be retrieved ‘from a network.’” *Id.*

c. Conclusion Regarding Limitation [1.4]

Patent Owner presents a strong argument that Shimada Figure 17 illustrates image and anchor tags in the form of relative URLs, suggesting they point to locally stored images/files.

However, Shimada teaches that “[t]he client 105 requests the server 101 to transfer this pict A.gif, receives this data from the server 101.” Ex. 1008, 6:34–35; Pet. 83. Similarly, Shimada teaches that “the client 105 transmits the transfer request of the data designated by HREF=” in the anchor tag to the server.” Ex. 1008, 6:42–43; Pet. 83. These disclosures suggest, as Petitioner contends, that the image and anchor tags illustrated in Shimada Figure 17 include a URL to permit communicating with a server. Dr. Schmidt provides supporting testimony; that is, “a POSITA would have recognized or found obvious that both Shimada’s IMG and anchor tags include a URL that “comprises a network location at which content . . . is accessible” (“a first network location”) because Shimada describes these tags as including an “address representing a static image” which is obtained from a ‘server.’” Ex. 1003 ¶ 171 (citing Ex. 1008, 6:30–51) (alteration in original); Pet. 83; *see also* Ex. 1003 ¶ 170 (“A POSITA would have understood or found obvious that the network could be the internet.”). At this stage, Dr. Schmidt’s testimony is unrebutted.

For that reason, at this stage, Patent Owner’s argument does not undermine Petitioner’s position.

2. Claims 2–4, 6, 7, 9, 10, 13–15 Depending from Claim 1

Along with our reasons discussed with respect to the challenge of claim 1 and Patent Owner’s argument, we are persuaded that the evidence relied upon by Petitioner sufficiently supports, for purposes of trial institution, Petitioner’s contentions regarding claims 2–4, 6, 7, 9, 10, 13–15.

Patent Owner does not provide any specific arguments challenging Petitioner’s patentability position as to these claims. See Prelim. Resp. 23–27.

K. Ground 2B

Petitioner challenges claims 5, 8, and 12 as unpatentable under 35 U.S.C. § 103(a) over the combination of Shimada, Buchholz, and Darnell. Pet. 94–99.

At this stage of the proceeding, it is unnecessary for us to provide a detailed assessment of claims 5, 8, and 12 under Ground 2B because Petitioner has demonstrated a reasonable likelihood of success in demonstrating that at least one claim (i.e., claim 1) of the ’545 patent is unpatentable under Ground IA. See 37 C.F.R. § 42.108(c) (2021). We add the following remarks.

1. Claims 5, 8, 12 Depending from Claim 1

Along with our reasons discussed with respect to the challenge of claim 1 and Patent Owner’s argument, we are persuaded that the evidence relied upon by Petitioner sufficiently supports Petitioner’s contentions regarding claims 5, 8, and 12.

Patent Owner does not provide any specific arguments challenging Petitioner’s patentability position as to these claims. See Prelim. Resp. 23–27.

L. Ground 2C

Petitioner challenges claims 11 and 16–21 as unpatentable under 35 U.S.C. § 103(a) over the combination of Shimada, Buchholz, and Krishna. Pet. 99–104.

At this stage of the proceeding, it is unnecessary for us to provide a detailed assessment of claims 11 and 16–21 under Ground 2C because Petitioner has demonstrated a reasonable likelihood of success in demonstrating that at least one claim (i.e., claim 1) of the ’545 patent is unpatentable under Ground IA. *See* 37 C.F.R. § 42.108(c) (2021). We add the following remarks.

1. Claim 11 Depending from Claim 1

We are persuaded that the evidence relied upon by Petitioner sufficiently supports Petitioner’s contentions regarding claim 11.

Patent Owner does not provide any specific arguments challenging Petitioner’s patentability position as to this claim. *See* Prelim. Resp. 23–27.

2. Independent Claim 16

Petitioner argues that independent claim 16 is rendered obvious over the combination of Shimada, Buchholz, and Krishna. Pet. 102 (relying in part on its arguments with respect to claim 11 and limitations [1.6]–[1.8]; citing Ex. 1003 ¶¶ 207–212).

As to these limitations, we have reviewed the evidence Petitioner has presented and based on our evaluation of that evidence, we determine that at this stage Petitioner sufficiently shows on this record that the combination of Shimada, Buchholz, and Krishna would have rendered obvious the subject matter recited in said preamble ([16pre]) and limitations [16.1]–[16.5].

We observe that Patent Owner has not responded to Petitioner's position as to the preamble ([16pre]) and limitations [16.1]–[16.5] with any particularity at this stage of the proceeding. *See generally* Prelim. Resp. 23–27.

3. Claims 17–21 Depending from Claim 16

We are persuaded that the evidence relied upon by Petitioner sufficiently supports Petitioner's contentions regarding claims 17–21.

Patent Owner does not provide any specific arguments challenging Petitioner's patentability position as to these claims. *See* Prelim. Resp. 23–27.

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of at least one of claims 1–21 of the '545 patent. Accordingly, we grant the Petition and institute an *inter partes* review of the '545 patent.

Because a decision to institute is “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition,” *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 & n.2 (Fed. Cir. 2018) (citing *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018), and corresponding USPTO Guidance, <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial> (Apr. 26, 2018)), and because we have determined that at least one ground set forth in the Petition satisfies the threshold for institution, trial is instituted on the proposed grounds based on Brown, Wecker, Beer, Shimada, Buchholz, Darnell, and Krishna.

IV. ORDER

It is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review of claims 1–21 of the '545 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), *inter partes* review of claims 1–21 of the '545 patent shall commence on the entry date of this Order, and notice is hereby given of the institution of *inter partes* review.

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