

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

GoTV Streaming, LLC,
Patent Owner

Case: IPR2023-00757
U.S. Patent No. 8,989,715

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

Filing Date: April 23, 2024

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EXHIBIT LIST

No.	Description
1001	U.S. Patent No. 8,989,715 (“’715 <i>Patent</i> ”)
1002	Expert Declaration of Ben Bederson (“ <i>Bederson</i> ”)
1003	Curriculum Vitae of Benjamin B. Bederson, Ph.D.
1004	File History of U.S. Patent No. 8,989,715 (“’715 <i>FH</i> ”)
1004	(Corrected) File History of U.S. Patent No. 8,989,715
1005	File History of U.S. Patent No. 8,478,245 (“’245 <i>FH</i> ”)
1006	U.S. Patent Application Publication No. 2007/0150617 (“ <i>Hariki</i> ”)
1007	U.S. Patent Application Publication No. 2003/0023755 (“ <i>Harris</i> ”)
1008	U.S. Patent No. 7,447,486 (“ <i>Tamura</i> ”)
1009	U.S. Patent No. 6,996,627 (“ <i>Carden</i> ”)
1010	U.S. Patent No. 6,669,564 (“ <i>Young</i> ”)
1011	U.S. Patent No. 6,732,183 (“ <i>Graham</i> ”)
1012	U.S. Patent No. 6,507,727 (“ <i>Henrick</i> ”)
1013	Webpage excerpt from Computer History Museum at https://www.computerhistory.org/t dih/april/6/ (last accessed March 29, 2023)
1014	https://www.webdesignerdepot.com/2009/05/the-evolution-of-cell-phone-design-between-1983-2009/
1015	Excerpts from Dan R. Olsen, Jr., Developing user interfaces (1998)

No.	Description
1016	Alok Sinha, Client-server computing, in Communications of the ACM, 35, 7 (1992)
1017	Tim Berners-Lee, Robert Cailliau, Ari Luotonen, Henrik Frystyk Nielsen, and Arthur Secret, The World-Wide Web, Communications of the ACM 37, 8 76-82 (August 1994), available at http://dx.doi.org/10.1145/179606.179671
1018	Eric Kasten, HTML: A Gentle Introduction, Linux Journal (July 1995), available at https://www.linuxjournal.com/article/1081
1019	U.S. Patent Application Publication No. 2013/0124961 (“ <i>Linburn</i> ”)
1020	U.S. Patent No. 8,111,326 (“ <i>Talwar</i> ”)
1021	Docket Control Order, <i>GovTV Streaming, LLC v. Netflix, Inc.</i> , No. 2:22-cv-07556-RGK-SHK, Dkt. 61 (C.D. Cal. Feb. 13, 2023)
1022	Complaint in <i>GovTV Streaming, LLC v. Netflix, Inc.</i> , No. 2:22-cv-07556-RGK-SHK (C.D. Cal. October 17, 2022)
1023	Webarchive.gov Zenzui
1023	Memorandum In Opposition To GoTV Streaming, LLC’s Motion For Judgment As A Matter Of Law
1024	Declaration of Stephen A. Marshall in support of Petitioner’s unopposed motion for pro hac vice admission.
1025	Deposition of Mr. Stuart Lipoff (April 2, 2024) (“ <i>Lipoff Dep.</i> ”)
1026	Excerpts From Trial Transcript Day 2
1027	<i>Associated</i> , Cambridge Learner’s Dictionary (3rd ed. 2007)
1028	<i>From</i> , Merriam-Webster’s Collegiate Dictionary (11th ed. 2007)

No.	Description
2001	CAMPBELL-KELLY ET AL., Mainframes to Smartphones: A History of the International Computer Industry, Ch. 11 (Harvard Univ. Press 2015)
2002	GALAZZO, Timeline from 1G to 5G: A Brief History on Cell Phones (Sept. 21, 2020), available at https://www.cengn.ca/information-centre/innovation/timeline-from-1g-to-5g-a-brief-history-on-cell-phones/
2003	Media Mall – Games & Games – Motorola (March 23, 2006)
2004	Suite, Definition & Meaning - Merriam-Webster, <i>available at</i> https://www.merriam-webster.com/dictionary/suite
2005	U.S. Patent No. 7,380,205 to Bezrukov et al. (filed Oct. 28, 2003)
2006	TUTENEL ET AL., Rule-Based Layout Solving and Its Application to Procedural Interior Generation, Netherlands Organization for Scientific Research and the Netherlands ICT Research and Innovation Authority (2009)
2007	KRÖNER, Adaptive Layout of Dynamic Web Pages, Deutsches Forschungszentrum für Künstliche Intelligenz GmbH (2000)
2008	Scheduling Order, <i>GoTV Streaming, LLC v. Netflix, Inc.</i> , 2:22-cv-07556 (C.D. Cal. issued Feb 14, 2023) (Doc. 62)
2009	Klausner Decisions re Motions to Stay Pending IPR, Docket Navigator (generated June 8, 2023)
2010	Order Granting Stipulated Stay Pending IPR, <i>Flexstent, LLC v. Abbott Labs.</i> , No. 5-18-cv-02479 (C.D. Cal. Oct. 18, 2019) (Doc.77)
2011	Order Denying Renewed Stipulated Stay Pending IPR, <i>Shenzhen Gooloo E-Commerce Co., Ltd. v. Pilot, Inc.</i> , No. 2-22-cv-02219 (C.D. Cal. Jan. 12, 2023) (Doc. 95)

No.	Description
2012	Renewed Joint Stipulation to Stay Case Pending Resolution of <i>Inter Partes</i> Reviews of '653 Patent, <i>Shenzhen Gooloo E-Commerce Co., Ltd. v. Pilot, Inc.</i> , No. 2-22-cv-02219 (C.D. Cal. Jan. 11, 2023) (Doc. 94)
2013	Klausner Time to Trial in Patent Cases, Docket Navigator (generated June 8, 2023)
2014	U.S. District Court—Judicial Caseload Profile for Central California from Federal Court Management Statistics—Profiles (Mar. 31, 2023)
2015	Order Denying Netflix's Motions, including for Invalidity under § 101, <i>GoTV Streaming, LLC v. Netflix, Inc.</i> , 2:22-cv-07556 (C.D. Cal. issued May 24, 2023) (Doc. 109)
2016	Order re Scheduling Conference, <i>GoTV Streaming, LLC v. Netflix, Inc.</i> , 2:22-cv-07556 (C.D. Cal. issued Feb. 13, 2023) (Doc. 61)
2017	Excerpts from Redacted and De-designated Corrected Declaration of Dr. John Villasenor Regarding Invalidity of U.S. Patent Nos. 8,989,715; 8,478,245; and 8,103,865, <i>GoTV Streaming, LLC v. Netflix, Inc.</i> , 2:22-cv-07556 (C.D. Cal. served June 23, 2023)
2018	Declaration of Joshua S. Wyde regarding authentication of exhibits (Aug. 10, 2023)
2019	Excerpts from Trial Transcript Day 2, <i>GoTV Streaming, LLC v. Netflix, Inc.</i> , No. 2:22-cv-07556 (C.D. Cal. Oct. 18, 2023)
2020	Excerpts from Trial Transcript Day 3, <i>GoTV Streaming, LLC v. Netflix, Inc.</i> , No. 2:22-cv-07556 (C.D. Cal. Oct. 19, 2023)
2021	Defendant Netflix, Inc.'s Notice of Motion and Rule 50(a) Motion for Judgment as a Matter of Law, <i>GoTV Streaming, LLC v. Netflix, Inc.</i> , No. 2:22-cv-07556 (C.D. Cal. Oct. 19, 2023) (Dkt. 389)
2022	Declaration of Mr. Stuart Lipoff (" <i>Lipoff</i> ")

No.	Description
2023	Generate, Free On-Line Dictionary of Computing, <i>available at</i> https://foldoc.org/generate (last updated June 15, 1995)
2024	Output, TechTerms.com; The Computer Dictionary, <i>available at</i> https://techterms.com/definition/output (last updated December 12, 2006)
2025	From, Merriam-Webster.com Dictionary, <i>available at</i> https://www.merriam-webster.com/dictionary/from (last visited December 12, 2023)
2026	Customized, Merriam-Webster.com Dictionary, <i>available at</i> https://www.merriam-webster.com/dictionary/customized (last visited Jan. 05, 2024)
2027	Application-Specific, Wiktionary, <i>available at</i> https://en.wiktionary.org/wiki/application-specific (last visited Dec. 15, 2023)
2028	Excerpt from 10-K statement filed by Netflix with the Securities and Exchange Commission (Jan. 26, 2023)
2029	Excerpt from Netflix Women In Tech Event - UI Engineering - August 2018, Jessica Berglund, Netflix UI engineer, 22:43–23:02, <i>available at</i> https://www.youtube.com/watch?v=YpIGejJiaBo
2030	Ethan Kao Deposition Designations Video, <i>GoTV Streaming, LLC v. Netflix, Inc.</i> , No. 2:22-cv-07556 (C.D. Cal. Oct. 19, 2023) (Dkt. 413-13)
2031	Deposition of Dr. Benjamin Bederson (Jan. 10, 2024) (“ <i>Bederson Dep.</i> ”)
2032	Second Declaration of Joshua S. Wyde regarding authentication of exhibits (Jan. 26, 2024)
2033	Audio Transcription

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No.	Description
3001	Ex. 3001
3002	Ex. 3002
3003	Exhibit 3003
3004	Exhibit 3004

AUTHORITIES LIST

Cases

<i>ACTV, Inc. v. Walt Disney Co.</i> , 346 F.3d 1082 (Fed. Cir. 2003).....	2
<i>B/E Aerospace, Inc. v. C&D Zodiac, Inc.</i> , 962 F.3d 1373 (Fed. Cir. 2020).....	17
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LISTING OF CHALLENGED CLAIMS

Claim 1	
1[pre]	A method of generating content that is renderable by a wireless device, said method comprising:
1[a]	transmitting, to said wireless device, an identification of a custom configuration of a plurality of rendering blocks of said wireless device,
1[b]	wherein said custom configuration is associated with an application and configures said plurality of rendering blocks to render content in a manner customized to said application; and
1[c]	transmitting, to said wireless device, compiled content comprising (i) first compiled content specific to a first page of said application and (ii) second compiled content specific to a second page of said application,
1[d]	wherein said compiled content is generated in part from execution of said application,
1[e]	wherein said compiled content comprises render commands expressed in a syntax that is generic to said wireless device, and
1[f]	wherein said custom configuration is applicable to said first and second compiled content,
1[g]	wherein said compiled content and said custom configuration are usable by a graphical user interface comprising said plurality of rendering blocks to generate renderable content based on said compiled content and said custom configuration.

Claim 2	
[2]	A method as described in claim 1 wherein said renderable content comprises audio content and display content.
Claim 3	
[3]	A method as described in claim 1 wherein said compiled content is partially resultant from said application operating on a remote server.
Claim 4	
[4]	A method as described in claim 1 wherein said compiled content is specific to the rendering capabilities of said wireless device.
Claim 5	
[5]	A method as described in claim 1 wherein each of said plurality of rendering blocks operates specific to a wireless device type of said wireless device and each is instructed using a syntax that is generic to said wireless device type.
Claim 6	
[6]	A method as described in claim 5 wherein said custom configuration comprises a syntax that is generic regarding said wireless device type.
Claim 7	
[7]	A method as described in claim 1 wherein said custom configuration comprises configuration information and content specific to said application.

Claim 8	
[8]	A method as described in claim 1 wherein said custom configuration is one of a plurality of memory-stored custom configurations stored by said wireless device, and wherein said method further comprises transmitting an identifier that identifies said custom configuration.
Claim 9	
9[pre]	A non-transitory computer readable medium comprising instructions therein that when executed by a processor implement a method of generating content that is renderable by a wireless device, said method comprising:
9[a]	transmitting, to said wireless device, an identification of a custom configuration of a plurality of rendering blocks of said wireless device,
9[b]	wherein said custom configuration is associated with an application and configures said plurality of rendering blocks to render content in a manner customized to said application; and
9[c]	transmitting, to said wireless device, compiled content comprising (i) first compiled content specific to a first page of said application and (ii) second compiled content specific to a second page of said application,
9[d]	wherein said compiled content is generated in part from execution of said application,
9[e]	wherein said compiled content comprises render commands expressed in a syntax that is generic to said wireless device, and
9[f]	wherein said custom configuration is applicable to said first and second compiled content,

9[g]	wherein said compiled content and said custom configuration are usable by a graphical user interface comprising said plurality of rendering blocks to generate renderable content based on said compiled content and said custom configuration.
Claim 10	
[10]	A non-transitory computer readable medium as described in claim 9 wherein said renderable content comprises audio content and display content.
Claim 11	
[11]	A non-transitory computer readable medium as described in claim 9 wherein said compiled content is partially resultant from said application operating on a remote server.
Claim 12	
[12]	A non-transitory computer readable medium as described in claim 9 wherein said compiled content is specific to the rendering capabilities of said wireless device.
Claim 13	
[13]	A non-transitory computer readable medium as described in claim 9 wherein each of said plurality of rendering blocks operates specific to a wireless device type of said wireless device and each is instructed using a syntax that is generic to said wireless device type.
Claim 14	
[14]	A non-transitory computer readable medium as described in claim 13 wherein said custom configuration comprises a syntax that is generic regarding said wireless device type.

Claim 15	
[15]	A non-transitory computer readable medium as described in claim 9 wherein said custom configuration comprises configuration information and content specific to said application.
Claim 16	
[16]	A non-transitory computer readable medium as described in claim 9 wherein said method further comprises transmitting an identifier that identifies said custom configuration.
Claim 17	
17[pre]	A server that is programmed to generate content that is renderable by a wireless device, comprising:
17[a]	a library of applications
17[b]	a library of custom configuration data comprising a custom configuration that configures a plurality of rendering blocks of said wireless device to render content in a manner customized to an application from said library of applications requested by said wireless device; and
17[c]	a layout solver that transmits compiled content to said wireless device, said compiled content comprising (i) first compiled content specific to a first page of said application and (ii) second compiled content specific to a second page of said application,
17[d]	wherein said compiled content is generated in part from execution of said application by said server,
17[e]	wherein said compiled content comprises render commands expressed in a syntax that is generic to said wireless device, and

17[f]	wherein said custom configuration is applicable to said first and second compiled content,
17[g]	wherein said compiled content and said custom configuration are usable by a graphical user interface comprising said plurality of rendering blocks to generate renderable content based on said compiled content and said custom configuration.
Claim 18	
[18]	A server as described in claim 17 wherein said renderable content comprises audio content and display content.
Claim 19	
[19]	A server as described in claim 17 wherein said compiled content is specific to the rendering capabilities of said wireless device.
Claim 20	
[20]	A server as described in claim 17 wherein said custom configuration comprises configuration information and content specific to said application.

I. INTRODUCTION

Petitioner submits this Reply to Patent Owner's ("PO") Response, Paper 21 ("POR") concerning Claims 1-20 ("challenged claims") of U.S. Patent No. 8,989,715. PO's arguments should be rejected and the challenged claims found unpatentable and cancelled for at least the reasons set forth in the IPR Petition, Paper 2 ("Petition" or "Pet.") and accompanying exhibits, the Board's decision granting institution of the IPR, Paper 11 ("Decision" or "Inst. Dec."), the deposition testimony of PO's expert, Stuart Lipoff, and the additional reasons below.

As explained below, PO's arguments with respect to the challenged claims should be rejected at least because they hinge on unsupportable proposed claim constructions and because the prior art cited in the Petition reads on the challenged claims.

II. CLAIM CONSTRUCTION

PO proposes claim constructions for three terms in the POR in an attempt to narrow the claims without sufficient support. These terms need no construction, and Petitioner has ascribed their plain and ordinary meaning.

A. “Customized to Said Application” Should Be Given Its Plain and Ordinary Meaning

Claims 1[b]/9[b]/17[b]

PO provides multiple narrow constructions – “tailored to,” “created for,” “consciously designed,” and “written for” an application – for the term “customized to said application” before settling on “created for” as PO’s proposed construction. *POR*, 16-17. However, for several reasons, this term needs no construction because POSITAs can readily understand its plain and ordinary meaning.

First, POSITAs reading the claim language can readily understand the plain and ordinary meaning of “customized to said application” from the expressly stated relationship between the custom configuration and the application. Specifically, the claims state that the “custom configuration is *associated with* an application.” It is this relationship that dictates how the custom configuration is applied to render content in a manner customized to the application. PO tellingly disregards the “associated with” language that precedes and gives meaning to the term “customized to said application.” The Federal Circuit has held that “[w]hile certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be considered in determining the ordinary and customary meaning of those terms.” *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003). The specification confirms that no construction is needed for the claim

term beyond what is already described in the claims, i.e., “associated with.” ’715 *Patent*, 18:40-42 (“The custom configuration customizes the look and feel of the content displayed on the wireless device from execution of the requested application.”). Furthermore, the plain and ordinary meaning of “associated” is “related to something.” Ex. 1027. Accordingly, the claim limitation only requires that the custom configuration be related to an application and render content consistent with the relationship between the custom configuration and the application.

Second, the ’715 *Patent* does not limit “customized to said application” to “created for” an application. The Federal Circuit has rejected narrow claim construction of a term when the patent failed to sufficiently set out the narrower meaning in the specification. In *Los Angeles Biomedical v. Eli Lilly & Co.*, the patent owner in the case argued two constructions, “constant level” and “steady state,” for “continuous long-term regimen.” 849 F.3d 1049, 1062 (Fed. Cir. 2017). The Court rejected the “steady state” construction because it was not disclosed in the specification and rejected “constant level” because that applicant had not “demonstrated a clear intention to limit the claim scope” by “set[ting] out [a] different meaning in the specification in a manner sufficient to give one of ordinary skill in the art notice of the change from ordinary meaning.” *Id.* Here, the phrase

“created for” is not used in the *'715 Patent* specification. Therefore, as in *Los Angeles Biomedical*, PO’s narrow claim construction should be rejected in favor of its plain and ordinary meaning.

Third, while advocating for their already narrow construction, PO offers additional constructions that further narrow the scope, including “consciously designed for,” “tailored to,” “designed for” an application, and “made with the application in mind.” *POR*, 16-17. However, “customized to said application” should not be limited to any of these constructions. *Kara Tech. Inc. v. Stamps.com Inc.*, 582 F.3d 1341, 1348 (Fed. Cir. 2009) (“The patentee is entitled to the full scope of his claims, and we will not limit him to his preferred embodiment or import a limitation from the specification into the claims.”). The *POR* argues that the custom configuration must correspond to an individual application (*id.*, 17), suggesting a strict one-to-one relationship, but PO cannot negate the language of the claims themselves. The claims do not require that the custom configuration be *consciously designed* or created exclusively for an application. The patent simply discloses that there is a correspondence between a custom configuration and an application that allows for rendering content on a mobile device. *'715 Patent*, 2:52-54; 7:56-59; 11:4-6; 18:40-42.

Ultimately, the claims plainly state that the rendering blocks are configured to render content for the application to the extent that the custom configuration is “associated with” the application, which defines the relevant relationship between the custom configuration and the application, such that the rendering blocks will be customized. A claim construction is not necessary here because the scope of “customized to said application” is clear from the words of the claim, and those words should not be improperly or unnecessarily limited.

B. “Application” Should Be Given Its Plain and Ordinary Meaning

Claims 1[c]/9[c]/17[c] and 1[d]/9[d]/17[d]

PO attempts to construe “application” narrowly as “remote application,” but PO’s arguments fail because PO ignores the claim language, argues contrary to the patent’s written description, and takes Petitioner’s litigation positions out of context. *POR*, 18-28.

As an initial but important matter, PO’s proposed claim construction of “application” as “remote application” fails to construe the term “application” and merely adds a material limitation to it. This is blatantly improper. The Federal Circuit has held that “while proper claim construction requires an examination of the written description and relevant prosecution history to determine the meaning of claim limitations, *additional limitations may not be read into the claims.*” *Storage*

Tech. Corp. v. Cisco Sys. Inc., 329 F.3d 823, 828, 831 (Fed. Cir. 2003) (emphasis added). PO's limiting claim construction also fails for several other reasons.

First, PO is incorrect that any construction, let alone a limiting construction, is necessary. PO argues in part that the application must be remote in order to transmit compiled content to the mobile device. However, Claims 1 and 9 do not require that an application transmit compiled content to a mobile device. The claims are directed to "transmitting, to said wireless device, compiled content," which only requires that compiled content be transmitted to a mobile device from some source. In deposition, PO's expert could not point to any claim language that required the application to transmit compiled content; instead, he stated that the compiled content "needs to be external to the wireless device" and "come from a source side of the information." *Lipoff Dep.*, 48:20-49:4.

There is no claim language that requires the application to transmit the compiled content, which even PO's expert cannot refute. Furthermore, even if a particular embodiment in the patent discloses a remote application transmitting the compiled content to a mobile device, it would be improper to import that embodiment into the claim. *Superguide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) ("[A] particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than

the embodiment.”). PO’s position that the “application” must run remotely from the mobile device is precisely what *Superguide Corp.* bars, namely, reading a narrow embodiment, such as the one disclosed in Fig. 5 of the *'715 Patent*, into much broader claim language that only requires “transmitting, to said wireless device, compiled content.” Transmission of compiled content by a server meets this claim limitation under the plain and ordinary meaning, without limitation on where the claimed application is located.

Second, claim differentiation further supports Petitioner’s position and PO is incorrect to argue otherwise. “[T]he presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005). Claims 3 and 11, which depend from independent Claims 1 and 9, respectively, first introduce the limitation that the application resides on a remote server and give rise to the presumption that the application is not required to be remote from the mobile device in Claims 1 and 9. This is confirmed by the two independent claims not even including the terms “server” or “remote.” The embodiment captured by Claim 17 includes a server and states that a layout solver on the server transmits compiled content to the wireless device, but does not disclose where the layout solver is in relation to the application. *'715 Patent*, 22:27-28. PO’s

expert states that the layout solver transmits the compiled content upon receiving some input from a library of applications but does not say that the actual application transmits the compiled content. *See Lipoff Dep.*, 77:9-78:5.

Claim differentiation “can be overcome by *strong* contrary evidence such as definitional language in the patent or a clear disavowal of claim scope.” *Interdigital Commc’ns, LLC v. Int’l Trade Comm’n*, 690 F.3d 1318, 1324 (Fed. Cir. 2012) (emphasis added). The ’715 Patent specification does not define the application as one that resides only on a remote server and the independent claims do not disavow that the application could reside elsewhere, other than on a remote server. This is fatal as “the presumption [of claim differentiation] is ‘especially strong’ in this case, because ‘the limitation in dispute is the only meaningful difference between an independent and dependent claim, and one party is urging that the limitation in the dependent claim should be read into the independent claim.’” *Id.*, 1324-25.

Third, contrary to PO’s argument, it is not necessary to limit “application” to “remote application” to avoid written description issues. It is settled law that “[e]ven when the specification describes only a single embodiment, the claims of the patent will not be read restrictively unless the patentee has demonstrated a clear intention to limit the claim scope using ‘words or expressions of manifest exclusion or restriction.’” *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1372 (Fed. Cir.

2014). The independent claims are purposefully broad and do not claim a remote application in order to capture all possible locations of the application. *'715 Patent*, 20:28-35. Furthermore, POSITAs would have understood that the application can reside on a mobile device in one embodiment just as it can reside on a server in another. *Bederson*, ¶¶60, 91 (“Web browsers are client applications...a web browser can open a special kind of document written using Hypertext Markup Language (HTML) and render it.”). Therefore, PO’s attempt to limit the claims to one embodiment – where the application is remote – fails to observe the understanding of POSITAs and scope of known technologies at the time of the patent.

Fourth, PO relies on cherry-picked testimony in the district court trial to incorrectly argue that there is agreement that the claimed application must be executing remotely from the mobile device. At the district court, Petitioner was characterizing and addressing PO’s asserted infringement theory.¹ Petitioner’s statements during trial that the “application lives on the server” were made in the

¹ Petitioner did not argue invalidity in the district court trial. Petitioner’s IPR position that the claimed “application” can reside on either the server or the mobile device is relevant to invalidity but outside the scope of Petitioner’s district court non-infringement defense.

context of the infringement positions argued by Plaintiff at trial (i.e., the accused application is on a remote server) (*see, e.g.*, Ex. 1026, 28:8-17; 70:16-20) and related to explanations of why Petitioner could not infringe under those theories, not any assertions as to the scope of the claim in all contexts. This context is confirmed by both the PO's and Petitioner's experts testifying only on infringement at trial. Ex. 1026, 17:16-19; 246:11-14. Furthermore, the Board allows Petitioners to advance positions that are different from the district court proceedings. *Bumble Trading LLC v. KinectUS LLC*, IPR2021-00765, Paper 13, at 18 (Oct. 21, 2021) ("That there was an inconsistency between the Petition and what was argued initially in the [district court] action does not persuade us that there is a current substantive disagreement over the meanings of certain terms."). Contrary to PO's assertion that Petitioner now advances a position in conflict with that in the district court (Footnote 7, *POR*, 26), as in the Board-cited *Samsung Elecs. Co.* case² and the *Bumble Trading LLC* case,³ Petitioner is advocating for a plain and ordinary meaning. PO is not only comparing

² *Samsung Elecs. Co. v. Smart Mobile Techs. LLC*, IPR2022-01248, Paper 13, at 58 (PTAB Jan. 24, 2023).

³ *Bumble Trading LLC v. KinectUS LLC*, IPR2021-00765, Paper 13, at 18 (PTAB Oct. 21, 2021).

Petitioner's positions from two separate proceedings, but also two completely different inquiries in those separate proceedings – non-infringement at the district court and invalidity at the PTAB – so the Board should reject PO's arguments that both parties agree on the claimed "application" executing only on a remote server.

Fifth, PO is incorrect that POSITAs would have understood that the claimed application is remote because "Dr. Benjamin B. Bederson, has not stated that the application in the Patent-at-Issue could be local." *Lipoff*, ¶109. To the contrary, Dr. Bederson expressly explained in his deposition that the application does not necessarily have to be remote and can reside on the mobile device. *Bederson Dep.*, 60:7-17.

Accordingly, a claim construction is not necessary here because the scope of "application" is clear from the words of the claims and the specification, and the term should not be improperly or unnecessarily limited to "remote application."

C. "Generated in Part From Execution of Said Application" Should Be Given Its Plain and Ordinary Meaning

Claims 1[d]/9[d]/17[d]

PO spends several pages addressing the construction of "generated in part from execution of said application," but offers no coherent construction at any point. Rather than construe the term, PO instead advances the argumentative conclusion that "to meet this claim limitation the identified application must produce/output

some part of the identified compiled content.” *POR*, 33 (emphasis in original). In essence, PO attempts to limit generation of compiled content such that the executing application is the immediate source of compiled content. To this end, PO argues that “from” should be read strictly as “source of,” to get around both the Petitioner’s and Board’s position that “from” in the context of the claims and specification means “upon.” *Id.*, 28. PO also improperly attempts to group “in part” with the generated compiled content rather than the triggering event of execution. *Id.*, 29. However, consistent with the Board’s Decision, a claim construction is not necessary here because the scope of the claim limitation is clear from the words of the claims themselves.

While PO argues that the specification does not teach that the execution of the client software “generates” the compiled content as an initiating cause (*POR*, 31), the specification, in fact, confirms Petitioner’s position. For example, the patent discloses that an application is initially executed in step 750 of Fig. 7. *’715 Patent*, 19:38-20:9. This execution step triggers a series of generation and transmission steps that ultimately lead to transmission of the compiled content to a client at step 780. *Id.* Additionally, the patent discloses that “[d]uring application execution, pages are generated for display on the wireless device.” *Id.*, 16:61-62. Even PO’s expert defined “generated” as a “side effect of the execution of an algorithm or program.”

Lipoff, ¶100. This interpretation aligns with the specification and Petitioner’s argument that compiled content can be generated as a side effect of the application’s execution. PO cites nothing in the patent – neither in the claims nor the specification – to demonstrate that “generation” should be limited to immediate output of the compiled content by the executing application. Further, PO relies on the term “from” in isolation to support its position that the executing application is the source of the compiled content. However, the plain and ordinary meaning of “from” in the *context of the claim language* is the “starting point of an activity” or “upon.” Ex. 1028. Indeed, the claim recites “from execution of the application,” indicating to POSITAs that the recited generation occurs upon execution, and not that the generated compiled content is “from” the application. To do so would read out the term “execution.” The Board agreed with this interpretation in the Decision. *Inst. Dec.*, 79.

Additionally, PO looks to the phrase “in part” to bolster its argument by suggesting that part of the compiled content must be output by the application, therefore requiring execution of the application on a server or other remote source of the compiled content. *POR* at 32. In other words, PO ties “in part” to “generated” so that the output (compiled content) must be the immediate result of execution of the application at the location where compiled content is created. Consistent with

the Board’s interpretation, however, “in part” modifies the triggering action (execution of said application) such that the compiled content results at least due to the occurrence of application execution. This is supported by the specification, which teaches that the compiled content for transmission to the mobile device is made when the application executes. *’715 Patent*, 16:61-62, 19:38-67. As PO recognizes, other content for the compiled content, such as third party stock information, is generated independently of application execution. *Id.*, 18:15-24. All that is required is that the execution of an application triggers generation of the compiled content.

Therefore, a claim construction is not necessary here because the scope of the claim term at issue is clear from the written description and the claims.

III. *HARIKI* IN COMBINATION WITH *HARRIS* RENDERS OBVIOUS CLAIMS 1-20

A1. In the *Hariki/Harris* System, UI Packages Work in Concert With the Web Server’s Content to Properly Display Content on a Mobile Device

Claims 1[b]/9[b]/17[b]

PO applies its narrow claim constructions and ignores the common objectives of the *’715 Patent* and the prior art to assert that *Hariki*’s web server cannot be the claimed “application” because the UI content packages and the web server are not

sufficiently related. *POR*, 1-2, 36-40.⁴ However, PO’s argument fails because *Hariki*’s objective is to display content-provider-supplied HTML content on a mobile device per the mobile device’s corresponding UI content package so that the content has a certain look, which requires an association between the HTML content and the UI content packages. *Hariki*, ¶¶21, 24; *Bederson*, ¶¶127-130. Even under PO’s flawed claim construction proposals (*see* Section II.A), this limitation is obvious in view of *Hariki* and *Harris*.

The *Hariki/Harris* system discloses this broad claim limitation.⁵ Consistent with the Petition, the *Hariki/Harris* web server process that serves content to mobile

⁴ It is undisputed that Petitioner offered two distinct scenarios in its Petition: one in which the web browser residing on a mobile device is the claimed “application,” and another in which the web server residing on a server is the claimed “application.” *Pet.*, 36-37; *Bederson Dep.*, 17:3-19:22, 59:2-7; *Bederson*, ¶¶60, 128; *Lipoff Dep.*, 43:10-15. PO incorrectly contends that Petitioner intermingles these scenarios. *POR*, 35, 36.

⁵ In the Decision, the Board stated concerns the Petition did not provide sufficient basis to consider the web server as the application. *Inst. Dec.*, 65-66. The arguments provided herein further explain the Petition position that the web server can be the

devices (or “web server”) is considered the “application”; the converted resource of the UI content package (or “UI content package”) is the “custom configuration”; and the HTML pages or files are the “compiled content.” The claim limitations here require that the UI content packages be “associated with” the web server and render content in a manner customized to said application. Accordingly, as explained in Section II.A, the claim limitations only require that *Hariki*’s UI package be related to an application and render content consistent with the relationship between the UI package and the application.

In *Hariki*, the UI authoring tool, which generates the UI content packages, and the web server do not just happen to reside on a common server. A content provider provides both the content and the corresponding UI content packages for different mobile devices. *Hariki*, ¶¶21, 24. *Hariki*’s objective is to enable the content provider to offer UI content packages to different types of mobile devices. *Id.*, ¶¶8, 9. This is similar to the ’715 *Patent*’s objective, where vendors provide the custom configuration and application content for use on different wireless devices (’715

application. These arguments are responsive because they “simply expand[] on previously raised arguments.” *Rembrandt Diagnostics, LP v. Alere, Inc.*, Case No. 2021-1796, 11 (Fed. Cir. Aug. 11, 2023).

Patent, 2:18-21) and the custom configuration “customize[s] the appearance of content” and “preprogram[s] the plurality of rendering blocks to operate and look a certain way” (*id.*, 2:51-57). PO’s expert confirms that “in order to practice the claim as it’s written, the custom configuration needs to be there before the application starts sending content to the rendering blocks.” *Lipoff Dep.*, 23:12-16. Therefore, POSITAs would have understood that *Hariki*’s content provider’s intention is to display their HTML content on a mobile device per the mobile device’s corresponding UI content package so that the content has a certain look. *Bederson*, ¶¶127-130; *see also Bederson Dep.*, 63:12-16 (“[Content provider] would understand [] that the UI skin would be sent to a client along with content such as HTML content from a server, and those things together would support the customization of that HTML content.”).

Furthermore, to achieve *Hariki*’s objective, it would have been a matter of common sense for the UI content package to be applicable to and customized for the web-server-generated content because only then can the content be displayed in a certain way on a mobile device. *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379-1380 (Fed. Cir. 2020) (affirming “the Board’s conclusion that the challenged claims would have been obvious because ‘it would have been a matter of common sense’ to incorporate a second recess [not expressly disclosed] in the

Admitted Prior Art” to achieve the prior art’s objective of maximizing airplane space). This is confirmed by Dr. Bederson’s explanation that *Hariki*’s content providers – who create UI content packages embodying UI skins – would know that the UI skins would be used in combination with the server-produced HTML content to customize the HTML content for rendering on a client. *Bederson Dep.*, 62:6-21. Even PO’s expert admits that it is possible for “two different programs [to] interact with each other that are not sold together [as part of a suite].” *Lipoff Dep.*, 35:3-6. Therefore, the UI content package is associated with the web server application and renders content that is accordingly related to the application.

A2. The ’715 Patent’s Claims Do Not Require the Claimed Application to Transmit Compiled Content and, Therefore, *Hariki*’s Web Browser Reads on the Claimed “Application”

Claims 1[c]/9[c]/17[c]

Petitioner also presents a scenario in which the *Hariki/Harris* web browser is considered the “application”; the converted resource of the UI content package (or “UI content package”) is the “custom configuration”; and the HTML pages or files are the “compiled content.” PO counters that because the web browser in the *Hariki/Harris* system does not transmit HTML pages, it cannot be the claimed “application.” *POR*, 1-2, 41-43. PO’s argument fails, however, because it presumes

a limitation on the source of the transmission that is not present anywhere in the claims.

Whether the *Hariki* or *Harris* web browser transmits HTML files is irrelevant to the claim limitation at issue. As explained in Section II.B, Claims 1 and 9 are directed to a method of “transmitting, to said wireless device, compiled content,” which only requires that compiled content be transmitted to a mobile device from some source. An application that resides on a mobile device and receives compiled content transmitted by a server meets this claim limitation. Similarly, Claim 17 discloses that a layout solver on the server transmits compiled content to the wireless device but does not limit how the layout solver is situated in relation to the application or require that the application transmit compiled content. *’715 Patent*, 22:27-28; *Lipoff Dep.*, 77:9-78:5.

The *Hariki/Harris* system, therefore, reads on the claim limitations because a server – an external source – transmits multiple HTML files to a mobile device’s web browser application. *Hariki*, ¶¶19, 21; *Pet.*, 40-43.

A3. The '715 Patent's Independent Claims Do Not Require That the Claimed "Application" Reside Remotely From the Mobile Device and, Therefore, *Hariki*'s Web Browser Reads on the Claimed "Application"

Claims 1[c]/9[c]/17[c] and 1[d]/9[d]/17[d]

Ignoring the plain claim language, PO improperly argues that *Hariki*'s web browser cannot be the claimed "application" because it resides locally on a mobile device and, therefore, cannot transmit HTML files to itself. *POR*, 1-2, 43-44. However, PO's argument fails because Claims 1, 9, and 17 do not require that the "application" transmit compiled content to a mobile device or preclude the web browser from being the "application." *See* Sections II.B and III.A2. The *Hariki/Harris* remote server transmits multiple HTML files to the web browser application that resides on the mobile device, which reads on the claim limitation. *Hariki*, ¶21.

A4. The '715 Patent's Independent Claims Do Not Require That the Claimed "Application" Output Compiled Content and, Therefore, *Hariki*'s Web Browser Reads on the Claimed "Application"

Claims 1[d]/9[d]/17[d]

PO relies on its narrow construction of "generated in part from execution of said application" to argue that the claims require the "application" (here, the web browser) to output compiled content. From this, PO asserts that the web browser cannot be the claimed application because the MCF in the *Hariki/Harris* system

outputs the compiled content. *POR*, 1-2, 44-48. PO's arguments fail because, once again, they mischaracterize the claims and Petitioner's positions.

As explained in Section II.C, this claim limitation requires only that the compiled content is generated upon the execution of the application. The *Hariki/Harris* web browser generates the HTML files, to some extent, when it identifies content for generation by the MCF. *Hariki*, ¶¶21, 38; *Harris*, ¶¶3, 7, 24; *Pet.*, 40-43. In other words, execution of the web browser on a mobile device in the *Hariki/Harris* system triggers content generation at the server. *Id.* The Board agreed with this interpretation in the Decision. *Inst. Dec.*, 79. PO's expert confirmed this same interaction in the '*715 Patent* – upon receiving a web browser's HTTP request, the server generates and transmits content to the browser. *Lipoff Dep.*, 51:10-52:5; *see also Bederson Dep.*, 40:9-13.

B. *Hariki's* UI Content Packages Are Applicable to HTML Files Within the Web Browser

Claims 1[f]/9[f]/17[f]

Without providing sufficient evidence, PO argues that *Hariki's* resource files are not applicable to HTML files within the browser. *POR*, 49-52. PO ignores the '*715 Patent's* and *Hariki's* shared objective of using a custom configuration to render content properly on a mobile device.

While *Harris* discloses that the MCF generates HTML files, the applicability of the UI packages to the HTML files is disclosed by *Hariki* in the *Hariki/Harris* system. *Pet.*, 47-48. *Hariki*'s objective is to enable a content provider to offer UI content packages to different mobile devices. *Hariki*, ¶¶8, 9. To that end, the mobile device in *Hariki* uses UI content packages to customize its web browser to look a certain way. *Id.*, ¶¶19, 21, 24. This customization requires that the UI content package be applicable to the HTML files that are received from the web server and displayed in the web browser. *Id.*, ¶¶19, 41-42. POSITAs would have understood that customizing the application program environment using the UI content package would mean that the converted resources of the UI content package were applicable to all HTML files displayed in the application. *Bederson*, ¶148. Dr. Bederson also confirmed in his deposition that "the resource profile is customized for a particular browser application that might know how to, for example, render one kind of image, but perhaps not another." *Bederson Dep.*, 70:11-15. In the Decision, the Board agreed with Petitioner that the UI content package affects the content displayed on the web browser and is, therefore, applicable to the HTML files within the browser. *Inst. Dec.*, 85-86.

C. *Hariki's* Web Server Application Resides With a UI Authoring Tool on a Server, and a Selected UI Content Package Configures Blocks to Render the Content on a Mobile Device

Claims 17[a]/17[b]

PO makes a scattershot argument regarding the library limitations of Claim 17 that *Hariki's* web server cannot be the claimed “application” because it is not part of a suite, and that the resource files cannot be part of the library of applications because that would somehow make the authoring tool the claimed “application.” *POR*, 53. PO’s arguments fail, however, because the web server has been shown to be the claimed application that works together with a UI authoring tool to render provider-supplied content in a specified manner on mobile devices (Section III.A1); the UI content package resource files configure blocks such as title bars, buttons, and sounds that render the content on a mobile device that is customized to the web server application (*Bederson*, ¶119); and the entire mobile device display is impacted by the UI skin (*Bederson Dep.*, 68:17-69:2).

D. *Harris' MCF* That Generates and Transmits HTML Files Reads on the Claimed “Layout Solver” Because the '715 Patent Claims Do Not Require the “Layout Solver” to Be the “Application”

Claim 17[c]

Consistent with the rest of the *POR*, PO ignores the claim language and mischaracterizes Petitioner’s position to argue that neither *Hariki's* user interface

authoring tool nor web browser can be the layout solver because they do not transmit content. *POR*, 54-56. However, PO's argument fails because the Petitioner does not assert either of those elements as the layout solver.

Claim 17 states that the "layout solver" is part of the server system but does not disclose where the "layout solver" is in relation to the application. *'715 Patent*, 22:27-29. Fig. 5 of the *'715 Patent* shows an intricate relationship between the layout solver and various modules, and an arrow going from the layout solver to the client. *Id.*, Fig. 5. However, the figure and specification do not provide a limiting disclosure of the relationship between the layout solver and the application or change the plain language of the claims to require that the application transmit the compiled content. *Id. Harris* discloses that a server's MCF translates a device generic template (e.g., WAX language) to a device specific set of commands (e.g., HTML) that are used to lay out content on the device. *Pet.*, 71; *Bederson*, ¶202. *Harris'* MCF, therefore, reads on the "layout solver" limitation of Claim 17[c] whether the web server residing on the server is considered the application or the web browser residing on the mobile device is considered the application.

E. *Hariki*'s Web Server Application Operates Remotely on a Remote Server and Serves Web Pages to Mobile Devices

Claims 3/11

Once again, PO mischaracterizes Petitioner's position by arguing that *Hariki* and *Harris* do not disclose the *web browser* residing on a remote server as expressly claimed in Claims 3 and 11. *POR*, 57. Petitioner does not argue that the web browser is the claimed "application" for Claims 3 and 11, so PO's point is moot.

As explained in Section III.A1, the *Hariki/Harris web server* that resides on a remote server can be the "application" for Claims 3 and 11. *Hariki* discloses that "server 102 can execute a web server process to serve web pages over network 110." *Hariki*, ¶21. The web server is executed on a remote server as shown in Fig. 1, where the server and client are separated by a telecommunications or Wide Area Network. *Id.*, ¶¶20, 21. Accordingly, the HTML pages are partially resultant from the web server application running on a remote server that is not part of the mobile device. *Bederson*, ¶162; *Pet.*, 54.

IV. THERE IS INSUFFICIENT NEXUS BETWEEN PETITIONER'S COMMERCIAL SUCCESS AND THE CHALLENGED CLAIMS TO ESTABLISH OBJECTIVE INDICIA OF NONOBVIOUSNESS

PO did not present sufficient nexus between Netflix's commercial success as a pioneering streaming company and the challenged claims to make a case for secondary consideration. *Oracle Corp. v. Crossroads Systems, Inc.*, IPR2014-01207,

Paper 78 (PTAB Jan. 29, 2016) (“To establish a proper nexus between a claimed invention and the commercial success of a product, a patent owner must offer proof that the sales [of the allegedly successful product] were a direct result of the unique characteristics of the claimed invention—as opposed to other economic and commercial factors unrelated to the quality of the patented subject matter.”). Netflix’s success is from its award-winning content and diverse user base, and not as a direct result of the unique characteristics of the challenged claims. In fact, PO even admits in the POR that Netflix has been a commercial success due only in part to the challenged claims. *POR*, 57. A finding of infringement of a single claim in the district court proceeding is also not sufficient nexus to establish an objective indicia of nonobviousness, especially given the plethora of reasons – scale and quality of content, large user base, and being an early mover in the field – for Netflix’s success.

V. CONCLUSION

The Board should find the challenged claims unpatentable and cancel them.

Dated: April 23, 2024

Respectfully submitted,

Aliza George Carrano

Lead Counsel for Petitioner

CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that the foregoing Petitioner's Reply to Patent Owner's Response contains 5,558 words, excluding those portions identified in 37 C.F.R. §42.24(c), as measured by the word-processing system used to prepare this paper.

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CERTIFICATE OF SERVICE

I certify that on April 23, 2024, I caused a true and correct copy of the foregoing Petitioner's Reply to Patent Owner's Response to be served on the Patent Owner via electronic mail to Patent Owner's counsel of record below:

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