Paper 7
Filed: August 17, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
PETITIONER,

v.

GOTV STREAMING, LLC,
PATENT OWNER.

CASE IPR2023-00758
PATENT 8,478,245

PATENT OWNER'S PRELIMINARY RESPONSE
37 C.F.R. § 42.107

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Proceedings with Parallel District Court Litigation (June 21, 2022).....55

CURRENT EXHIBIT LIST[1]

No.	Brief Description
1001	U.S. Patent No. 8,478,245
1002	Expert Declaration of Ben Bederson ("Bederson")
1003	Curriculum Vitae of Benjamin B. Bederson, Ph.D.
1004	File History of U.S. Patent No. 8,478,245
1005	U.S. Patent Application Publication No. 2007/0150617 ("Hariki")
1006	U.S. Patent Application Publication No. 2003/0023755 ("Harris")
1007	U.S. Patent No. 7,447,486 ("Tamura")
1008	U.S. Patent No. 6,996,627 ("Carden")
1009	U.S. Patent No. 6,669,564 ("Young")
1010	U.S. Patent No. 6,732,183 ("Graham")
1011	U.S. Patent No. 6,507,727 ("Henrick")
1012	Webpage excerpt from Computer History Museum at https://www.computerhistory.org/tdih/april/6/ (last accessed March 29, 2023)
1013	https://www.webdesignerdepot.com/2009/05/the-evolution-of-cell-phone- design-between-1983-2009/
1014	Excerpts from Dan R. Olsen, Jr., Developing user interfaces (1998)
1015	Alok Sinha, Client-server computing, in Communications of the ACM, 35, 7 (1992)
1016	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
1017	Eric Kasten, HTML: A Gentle Introduction, Linux Journal (July 1995),
1018	U.S. Patent Application Publication No. 2013/0124961 ("Linburn")
1019	U.S. Patent No. 8,111,326 ("Talwar")

[1] Relevant portions of exhibits may be highlighted to help the Panel locate cited sections.

No.	Brief Description
1020	Order re Scheduling Conference, *GoTV Streaming, LLC v. Netflix, Inc.*, 2:22-cv-07556 (C.D. Cal. issued Feb. 13, 2023) (Doc. 61)
1021	Complaint in *GoTV Streaming, LLC v. Netflix, Inc.*, No. 2:22-cv-07556-RGK-SHK (C.D. Cal. October 17, 2022)
1022	U.S. Patent Application Publication No. 2003/0106022 ("Goodacre")
1023	https://web.archive.org/web/20070406171650/http://www.zenzui.com/produc ts.html
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	Cingular MEdia Mall Games and Motorola Page (March 23, 2006), *available at* https://web.archive.org/web/20060323054853/http://www-xl.cingularextras.com/fuel/enduser/portal/endUserHTMLDir?c1=3&dc=0 and https://web.archive.org/web/20060323054841/http://www-xl.cingularextras.com/fuel/enduser/portal/endUserHTMLSelectPhone?makeName=motorola&dc=0
2004	Suite, Definition & Meaning - Merriam-Webster, *available at* https://www.merriam-webster.com/dictionary/suite
2005	U.S. Patent No. 7,380,205 to Bezrukov et al. (filed Oct. 28, 2003)
2006	Scheduling Order, *GoTV Streaming, LLC v. Netflix, Inc.*, 2:22-cv-07556 (C.D. Cal. issued Feb 14, 2023) (Doc. 62)
2007	Klausner Decisions re Motions to Stay Pending IPR, Docket Navigator (generated June 8, 2023)
2008	Order Granting Stipulated Stay Pending IPR, *Flexstent, LLC v. Abbott Labs.*, No. 5-18-cv-02479 (C.D. Cal. Oct. 18, 2019) (Doc.77)

No.	Brief Description
2009	Order Denying Renewed Stipulated Stay Pending IPR, *Shenzhen Gooloo E-Commerce Co., Ltd. v. Pilot, Inc.*, No. 2-22-cv-02219 (C.D. Cal. Jan. 12, 2023) (Doc. 95)
2010	Renewed Joint Stipulation to Stay Case Pending Resolution of *Inter Partes Reviews* of '653 Patent, *Shenzhen Gooloo E-Commerce Co., Ltd. v. Pilot, Inc.*, No. 2-22-cv-02219 (C.D. Cal. Jan. 11, 2023) (Doc. 94)
2011	Klausner Time to Trial in Patent Cases, Docket Navigator (generated June 8, 2023)
2012	U.S. District Court—Judicial Caseload Profile for Central California from Federal Court Management Statistics–Profiles (Mar. 31, 2023), *available at* https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0331.2023.pdf
2013	Order Denying Netflix's Motions, including for Invalidity under § 101, *GoTV Streaming, LLC v. Netflix, Inc.*, 2:22-cv-07556 (C.D. Cal. issued May 24, 2023) (Doc. 109)
2014	Order re Scheduling Conference , *GoTV Streaming, LLC v. Netflix, Inc.*, 2:22-cv-07556 (C.D. Cal. issued Feb. 13, 2023) (Doc. 61)
2015	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, *GoTV Streaming, LLC v. Netflix, Inc.*, 2:22-cv-07556 (C.D. Cal. served June 23, 2023)
2016	ZHANG, Systematic Approach to Construct and Assess Power Electronic Conversion Architectures Using Graph Theory and Its Application in a Fuel Cell System, 2019, Vol. 12 Iss. 6, pp. 1499–1509, The Institution of Engineering and Technology (2019), *available at* https://ietresearch.onlinelibrary.wiley.com/doi/epdf/10.1049/iet-pel.2018.6143
2017	U.S. Patent No. 7,404,032 to Ware et al. filed July 13, 2004 ("Ware").
2018	Declaration of Joshua S. Wyde regarding authentication of exhibits (Aug. 17, 2023)

CLAIM LISTING[2]

	Limitation
[1pre]	**1.** A method of rendering content on a wireless device, said method comprising:
[1a]	receiving an identification of a custom configuration of a plurality of rendering blocks of said wireless device,
[1b]	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;
[1c]	receiving compiled content generated in part from execution of said application
[1d]	wherein said compiled content comprises render commands expressed in a syntax that is generic to said wireless device;
[1e]	using a graphical user interface comprising said plurality of rendering blocks to generate renderable content based on said compiled content and said custom configuration; and
[1f]	rendering said renderable content on said wireless device, wherein said receiving compiled content comprises: receiving first compiled content specific to a first page of said application; and receiving second compiled content specific to a second page of said application
[1g]	wherein said custom configuration is applicable to both said first and second compiled content.
[2]	**2.** A method as described in claim **1** wherein said using a graphical user interface comprising said plurality of rendering blocks to generate renderable content comprises: processing said compiled content using a reader of said wireless device; and issuing commands from said reader to individual rendering blocks of said graphical user interface based on said rendering commands of said compiled content.
[3]	**3.** A method as described in claim **1** wherein said render able content comprises audio content and display content.

[2] As the Preliminary Response presents the claim listing in its body in fragments and grouped by limitation type, rather than in numerical order, all claim limitations are presented here together so the Panel may easily view them in order and in context. Patent Owner uses Petitioner's numbering designation for consistency, but designates three sub-limitations for 23h.

	Limitation
[4]	**4.** A method as described in claim **1** wherein said compiled content is partially resultant from said application operating on a remote server.
[5]	**5.** A method as described in claim **1** wherein said compiled content is specific to the rendering capabilities of said wireless device.
[6]	**6.** 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.
[7]	**7.** A method as described in claim **6** wherein said custom configuration comprises a syntax that is generic regarding said wireless device type.
[8]	**8.** A method as described in claim **1** wherein said custom configuration comprises configuration information and content specific to said application.
[9]	**9.** 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 further said identifying said custom configuration comprises receiving an identifier that identifies said custom configuration.
[10]	**10.** A method as described in claim **1** further comprising receiving and storing said custom configuration.
[11]	**11.** A method as described in claim **1** wherein said plurality of rendering blocks of said graphical user interface comprises: a first block that controls the rendering of ticker information across a display screen of said wireless device; a second block that controls the rendering of button images on said display screen; and a third block that controls the rendering of audio on a speaker of said wireless device.
[12pre]	**12.** A non-transitory computer usable medium comprising instructions therein that when executed by a processor implement a method of rendering content on a wireless device, said method comprising:
[12a]	receiving an identification of a custom configuration of a plurality of rendering blocks of said wireless device,
[12b]	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;
[12c]	receiving compiled content generated in part from execution of said application
[12d]	wherein said compiled content comprises render commands expressed in a syntax that is generic to said wireless device;
[12e]	using a graphical user interface comprising said plurality of rendering blocks to generate renderable content based on said compiled content and said custom configuration; and

	Limitation
[12f]	rendering said renderable content on said wireless device, wherein said receiving compiled content comprises: receiving first compiled content specific to a first page of said application; and receiving second compiled content specific to a second page of said application,
[12g]	wherein said custom configuration is applicable to both said first and second compiled content.
[13]	**13.** A non-transitory computer usable medium as described in claim **12** wherein said using a graphical user interface comprising said plurality of rendering blocks to generate renderable content comprises: processing said compiled content using a reader of said wireless device; and issuing commands from said reader to individual rendering blocks of said graphical user interface based on said rendering commands of said compiled content.
[14]	**14.** A non-transitory computer usable medium as described in claim **12** wherein said renderable content comprises audio content and display content.
[15]	**15.** A non-transitory computer usable medium as described in claim **12** wherein said compiled content is partially resultant from said application operating on a remote server.
[16]	**16.** A non-transitory computer usable medium as described in claim **12** wherein said compiled content is specific to the rendering capabilities of said wireless device.
[17]	**17.** A non-transitory computer usable medium as described in claim **12** 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.
[18]	**18.** A non-transitory computer usable medium as described in claim **17** wherein said custom configuration comprises a syntax that is generic regarding said wireless device type.
[19]	19. A non-transitory computer usable medium as described in claim **12** wherein said custom configuration comprises configuration information and content specific to said application.
[20]	**20.** A non-transitory computer usable medium as described in claim **12** wherein said custom configuration is one of a plurality of memory-stored custom configurations stored by said wireless device and wherein further said identifying said custom configuration comprises receiving an identifier that identifies said custom configuration.
[21]	**21.** A non-transitory computer usable medium as described in claim **12** wherein said method further comprises receiving and storing said custom configuration.

	Limitation
[22]	**22.** A non-transitory computer usable medium as described in claim **12** wherein said plurality of rendering blocks of said graphical user interface comprises: a first block that controls the rendering of ticker information across a display screen of said wireless device; a second block that controls the rendering of button images on said display screen; and a third block that controls the rendering of audio on a speaker of said wireless device.
[23pre]	**23.** A wireless device operable to communicate with a remote server, said wireless device comprising:
[23a]	a transceiver coupled to a bus and operable to receive a custom configuration that is associated with an application,
[23b]	said transceiver also operable to receive compiled content generated in part from execution of said application and
[23c]	comprising a plurality of rendering commands expressed in a syntax that is generic to said wireless device;
[23d]	a memory coupled to said bus and operable to store said compiled content and said custom configuration;
[23e]	a processor coupled to said bus and operable to implement the following: a graphical user interface comprising a plurality of rendering blocks and operable to generate renderable content based on said compiled content and said custom configuration
[23g]	an engine for reading said compiled content and responsive thereto for causing said graphical user interface to generate said renderable content based on said render commands;
[23f]	wherein said custom configuration is operable to configure said plurality of rendering blocks to render content in a manner customized to said application;
[23h.1]	a display device coupled to said bus and operable to render a portion of said renderable content,
[23h.2]	wherein said compiled content comprises: a first compiled content specific to a first page of said application; and a second compiled content specific to a second page of said application,
[23h.3]	wherein said custom configuration is applicable to both said first and second compiled content.
[24]	**24.** The wireless device as described in claim **23** wherein said engine is further operable to issue commands to individual rendering blocks of said graphical user interface based on said plurality of rendering commands of said compiled content.
[25]	**25.** The wireless device as described in claim **23** further comprising an audio rendering device coupled to said bus and wherein said renderable content comprises audio content and display content.

	Limitation
[26]	**26.** The wireless device as described in claim **23** wherein said compiled content is partially resultant from said application operating on a remote server.
[27]	**27.** The wireless device as described in claim **23** wherein said compiled content is specific to the rendering capabilities of said wireless device.
[28]	**28.** The wireless device as described in claim **23** 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.
[29]	**29.** The wireless device as described in claim **28** wherein said custom configuration is expressed in a syntax that is generic to said wireless device type.
[30]	**30.** The wireless device as described in claim **23** wherein said custom configuration comprises configuration information and content specific to said application.
[31]	**31.** The wireless device as described in claim **23** wherein said custom configuration is one of a plurality of memory-stored custom configurations stored in said memory.
[32]	**32.** The wireless device as described in claim **23** wherein said plurality of rendering blocks of said graphical user interface comprises: a first block that controls the rendering of ticker information across said display screen of said wireless device; a second block that controls the rendering of button images on said display screen; and a third block that controls the rendering of audio on a speaker of said wireless device.
[33]	**33.** The wireless device as described in claim **23** wherein said plurality of rendering blocks of said graphical user interface comprises: a first block that controls the rendering of a scroll bar on said display screen of said wireless device; a second block that controls the rendering of an input box on said display screen of said wireless device; and a third block that control the rendering of a text display region on said display screen of said wireless device.

I. INTRODUCTION

The Board should decline to institute Netflix, Inc.'s ("Petitioner's") request for an *inter partes* review of U.S. Patent No. 8,478,245 ("'245 Patent" or "Patent-at-Issue"). First, Petitioner is asserting the claims are unpatentable as obvious over Harris and Hariki that will have been considered in a parallel district court proceeding well before the final written decision in in this IPR. As such, this proceeding is a duplicative additional expense for all constituents rather than a less expensive alternative to address unpatentability as Congress conceived post grant reviews.

Alternatively, the Panel should decline to institute on the merits. At a high level, the Patent-at-Issue concerns configuring and rendering a remotely executing application on a wireless device. However, Hariki is not concerned with this subject matter, but, instead, teaches a more efficient way of putting together a device "skin" that changes the look of the entire device environment. The Patent-at-Issue also claims the remotely executing application generating pages expressed in a syntax that is "generic"—i.e., not specific to the wireless device type—that Petitioner concedes Hariki does not disclose, arguing Harris has these features. However, Harris is centered upon providing device *specific* and *arbitrary*—to use Petitioner's word—content from a web server to a web browser. Given the disparate nature of the references and the Patent-at-Issue, the Petitioner takes vague and unreasonable

positions in an attempt to shoehorn the references within the claim scope. This Preliminary Response will now discuss these and other issues that show Petitioner has failed to demonstrate it is more likely than not that any claim is unpatentable over Hariki in view of Harris.

II. OVERVIEW OF THE PATENT-AT-ISSUE

A. Family and Priority

The Patent-at-Issue was filed on August 1, 2007 and does not claim priority to an earlier application. Ex. 1001 at (22). As such, the effective priority date is the filing date, and the Patent-at-Issue's patentability should be judged under the pre-AIA statutes.

B. Historical Context

By 2005, people were beginning to "web surf" on their smartphones; however, the Internet capabilities of existing devices were primitive because phones' internet interfaces were designed for low-bandwidth networks. Ex. 2001, 13–14. For instance, "3G," launched in Japan by NTT DoCoMo in 2001, only had 2 Mbps data transferring capabilities on average, which allowed "the ability to surf the internet (basic HTML pages at the time)." Ex. 2002, at 2; *see also* Pet. 7 (characterizing 3G as capable of transferring low bandwidth type data, such as "emails and instant messages"). 3G gave rise to new smartphone form factors, such as the Blackberry (launched in 2002) shown below.

Image of the BlackBerry 5810, Ex. 2002, at 2.

Petitioner's "state of the art" references—Carden, Tamura, Young, Graham, and Henrick, *see* Pet. 3–4 & n.3—confirm the situation. While Petitioner cites Carden for the proposition that "well before 2003" users could "experience content with a large amount of data, such as video and music, on their cellular phones," Pet. 3–4 (citing Ex. 1008, 1:17–20),[3] the citation does not support such a contention. Indeed, Patent Owner can find no discussion in Carden of cellular technology or users experiencing video and music over such a connection. The closest Carden comes to such a discussion is its contemplation of non-persistent connections such as connections via "dial up telephone lines." *Id.* 5:65–67.

Tamura validates Carden, saying that while a user could download video or music, "radio base stations d[id] not have enough line or channel capacity for delivering such rich contents to users' cellular phones." Ex. 1007 1:21–24.

[3] Patent Owner looked to the IPR2023-00757 Petition ("'757 Petition") (Paper 2) with similar description to discern the referenced exhibits.

Therefore, Tamura proposed that multiple mobile terminals could simultaneously receive the same content via a public channel to share bandwidth. *Id.* 16:56–67.

Likewise, Henrick notes that wireless devices are "unsuitable for transferring quality media." Ex. 1011, 1:49–52. Therefore, Henrick proposes allowing a user to search for content on a wireless device, but sending the content to a "second device . . . a personal computer owned by the user that is connected to the Internet via an always-on connection, such as a cable modem." *Id.* 2:12–19.

Young and Graham are primarily concerned with non-mobile computers. Young is simply discussing delivery of software, such as the game "Myst," Ex. 1009, 1:16–24, that would run on "personal computers," *id.* 9:12–16, and Graham discusses broadcasting audio/video to a "client 112 [that] represents a computer, such as a PC compatible computer, running a browser application 102 . . . [such as] Netscape Navigator," Ex. 1010, 7:57–60.

"The smartphone market changed radically with the arrival of Apple's iPhone in June 2007." Ex. 2001, 12. The iPhone, shown below, was touted as "revolutionary" in that it was not just a phone and a music player, but an "Internet communicator" where the entire user interface of the iPhone was a touchscreen. *Id.*

Ex. 2002, at 2–3.

It was around this time, in August of 2007, that the Patent-in-Suit was filed. At this moment, the wireless device marketplace offered many different mobile devices, each with very different hardware-specific attributes. The Panel can view the variety by perusing the pictures in the first 74 pages of Petitioner's Exhibit 1013. Therefore, game manufacturers would provide different versions of games based upon phone maker, model, and phone capabilities as seen in the Cingular Games page circa 2006:

Ex. 2003 at 5; *see also id.* 7.

While personal wireless devices were becoming more powerful, such that each device could run its own applications, interactions with servers were still very limited due to the primitive browser interfaces that were a legacy of the wireless networks' low bandwidths as described above.

Apple would not unveil its software development kit for the iPhone until March 2008 or launch its App Store until July of that same year. Ex. 2001, at 14. It was not until November 2007, that Google, T-Mobile, HTC, Qualcomm, and Motorola announced the formation of the Open Handset Alliance for the development of the Android operating system, and Google's own app store, Android Market, was not announced until August 2008. *Id.* 15. 4G wireless networks that had a minimum of 12.5 Mbps bandwidth were not commercially introduced until 2009. Ex. 2002, at 3.

C. Subject Matter

Circa August 1, 2007, wireless devices generally ran "application[s] locally." Ex. 1001, 2:6–8. And there were multiple types of portable wireless devices, multiple manufacturers of each type of device, multiple models from each manufacturer, and multiple versions of each model. *Id.* 1:30–34. Each particular combination of type, manufacturer, model, and version of a device potentially had unique "device attributes" (i.e., rendering capability, display resolution, color capability, display size, etc.). *Id.* 1:34–38; 11:22–33; 11:45–58.

Therefore, developers that wished to write an application to run on multiple devices and "fully utilize" each device's attributes had to tailor versions of the application per device, building each one "from the ground up." *Id.* 1:40–46; 54–57. Given that providers had to pay to develop, debug, and qualify every version of an application, *id.* 1:47–50, many software developers simply chose to limit their titles to a few platforms, *id.* 1:65–2:3.

Additionally, maintenance of an application (i.e., upgrades, updates, and patches to the code) across target platforms similarly required a costly per-device effort. *Id.* 2:4–10. And even if the application developer did provide updates, many users failed to install the update to the locally running applications because it was a "laborious process" of "navigating through multiple pages in order to determine whether an update [was] ready" and "actively initiat[ing] the update process." *Id.* 2:10–17.

In light of the state of application development at the time, the Patent-at-Issue contemplates a method and system for rendering applications on a wireless device where: (1) the application "output . . . is device specific based on the wireless device attributes," *id.* 2:27–28, with its own "look and feel," *id.* 7:59–8:1; 10:58–60; 18:41–43; yet (2) the developers can still write a "generic application" being less concerned with "tailoring their applications for a given device type," *id.* 2:28–29. Additionally, the claimed solution allows for developers to maintain applications centrally,

"eliminating the need to update/patch each application on each wireless device." *Id.* 2:40–45.

D. Invention as Illustrated through Embodiments

The following discussion recapitulates key concepts from the Patent-at-Issue specification using concrete examples.

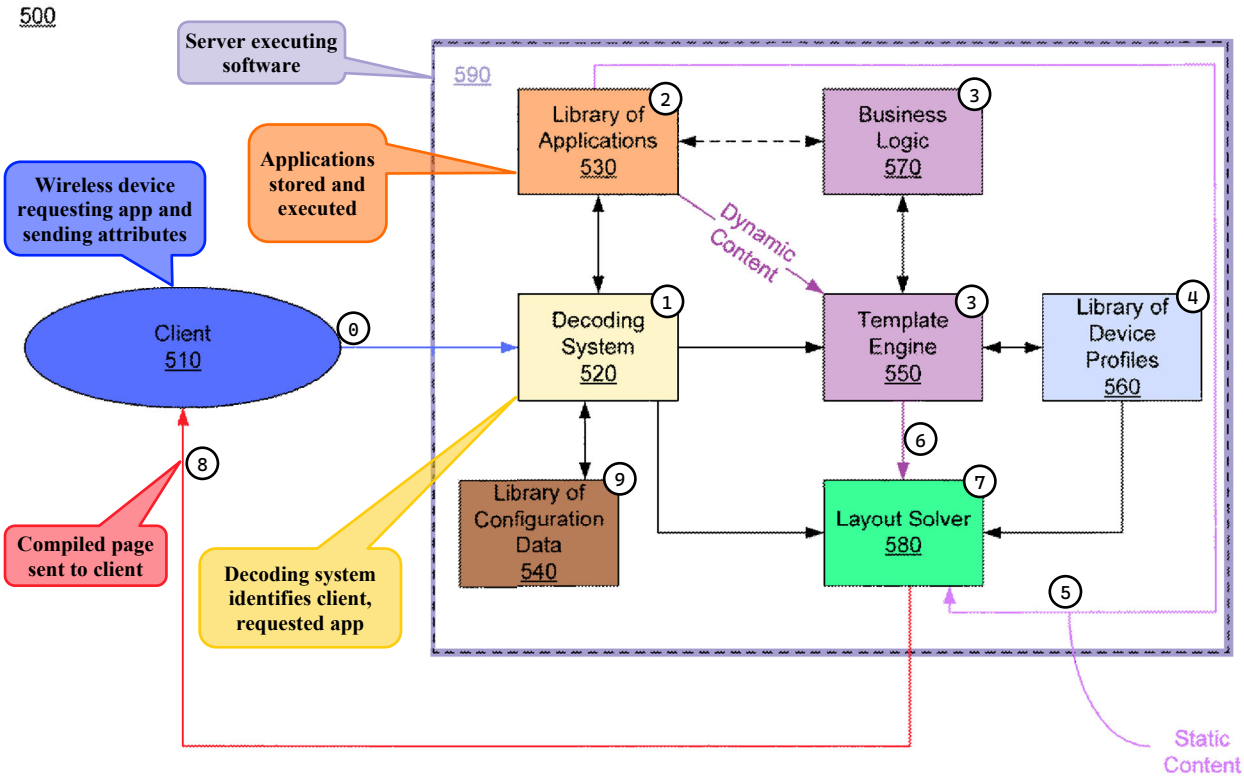
1. Applications

In the context of the Patent-at-Issue, an application can be "defined by an application description file and a set of static resources, e.g., images, sounds, URLs, etc. The application description file describes all the screens of the application and the custom configuration of the application." *Id.* 16:46–50. For example, an "application" may be all the screens, resources, and custom configurations to implement the Texas Hold'em Poker application. *Id.* 16:40–43.

The Patent-at-Issue's applications are "stored" and "executed" "on the remote server," *id.* 2:40–41; 2:66–67; 3:11–12; 5:58–60; 6:10–11; 16:45–46, in contrast to traditional applications that were downloaded and locally run on wireless devices.[4]

[4] Petitioner argues that an application "is not limited to one residing only on a client or only on a server" because Petitioner reads claim four as "further limit[ing] the 'application' in claim 1 to 'operat[e] on a remote server.'" Pet. 36 n.10 (mistakenly referencing similar claim 3 of U.S. Patent No. 8,989,715 in the '757 Petition). This is incorrect. Claim 4 further limits the "compiled content" to being "partially

The generic applications may be stored in a library of applications 530 and executed on a remote server 590.



Ex. 1001 Fig. 5.[5] At ⓪ a client "request[s] an application [and] identif[ies] the client's 510 type and its capabilities." *Id.* 16:35–38. In response, at ①, the "decoding system" on the server "locate[s] and execute[s] the requested application." *Id.* 16:40–43.

resultant" from the application, and merely makes explicit that the application is "operating on a remote server."

[5] All color, balloon text, circle numbering, and annotations in figures are Patent Owner's additions unless otherwise noted.

Upon execution, at ②, the application generates the pages "for display on the wireless device." *Id.* 16:62–63. This page can contain only static content, such as "pictures or . . . pure text." *Id.* 16:65–67. Or this page may be a "generic template describing the screen" *Id.* 17:6–7.

In the case of the generic template page, at ③, a "template engine," also executing on the server, may first "merge[] screens of [the] application and dynamic data provided by the business logic" to "provide[] a high level template (e.g., extensible markup language (XML) format)," *id.* 17:9–27, and then consult the "library of device profiles," at ④, to "eliminate content from its dynamic template output that is not supported by the client," *id.* 17:28–40. For example, the template engine "may eliminate audio component[s] from the generic template output" when "the client 510 does not have audio capability," or "eliminate big images" "when the client 510 is short in memory." *Id.* 17:40–45.

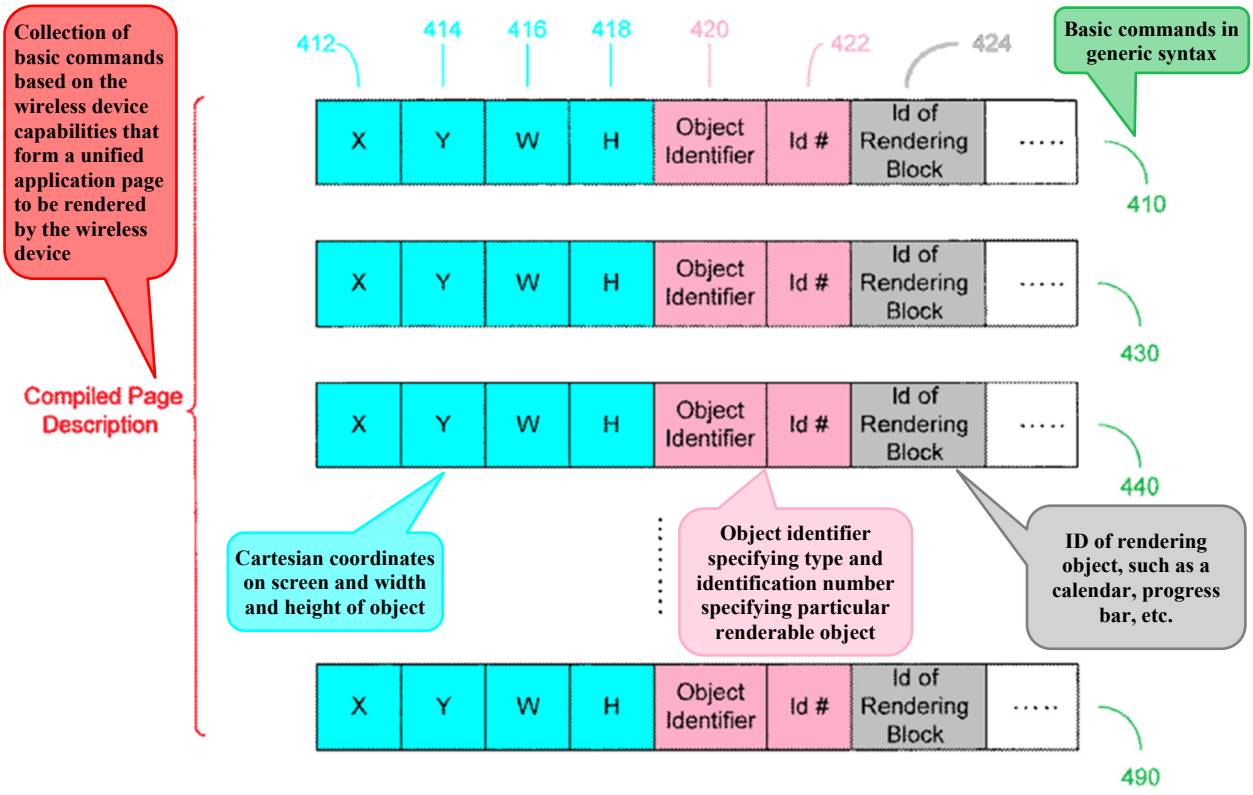
Whether the page is static (i.e., a "generic template supplied from 530," at ⑤) or dynamic (i.e., a "template supplied from 550," at ⑥), the generic application pages at this point "do not contain any specific or actual screen dimensions but rather only contain relative screen locations." *Id.* 17:49–53. In this sense, they are "wireless device generic." *Id.*

2. Compiled Content and Rendering Blocks

The Patent-at-Issue teaches that an application's generic pages can be fed into

a "layout solver," at ⑦, that actually "translates the received information into a series of basic commands based on the client's capabilities," *id.* 17:54–60; 18:2–7, to create a "compiled page" that is sent to the wireless client device at ⑧, *id.* 18:12–15. Note that while the compiled page's basic commands and their parameters are tailored to, and based on, the wireless device capabilities, the syntax of these commands is still "device generic." *Id.* 18:8–12.

The Patent-at-Issue illustrates what a compiled page for an application may look like:



Ex. 1001 Fig. 4. The compiled page contains a series of basic commands, including 410 to 490. Note that the compiled pages may now specify actual "Cartesian coordinates 412 and 414 of a screen region" as well as "the width 416

and the height 418 of the screen region." *Id.* 16:4–9.

The basic commands can also include an "object identifier," that specifies the type of "renderable component" to be displayed (e.g., a designator for "text, image, video, audio, and the like") and an "identification number" that specifies the particular renderable component of the designated type to be rendered. *Id.* 13:26–34; 15:62–64; 16:17–23.

The render commands found in the exemplary device specific page description also include the identifications of the "rendering blocks." Rendering blocks are conceptually part of the wireless device's graphical user interface ("GUI") that are "preconfigured to operate and store data" and "perform discrete rendering operations." *Id.* 2:53–54; 4:9–12; 7:21–25. That is, the rendering blocks "render content and enable a user to interact with the requested application." *Id.* 8:22–24. Examples of a GUI's rendering blocks include text; a text box; an image; a pop-up, drop-down or tabbed menu; audio/video controls; a scrolling ticker; check box/radio buttons; a rating panel; poll results; a drawing canvas; a hierarchical tree; scroll bars; a progress bar; a table; a calendar; and the like. *Id.* 8:27–45.

The specification also notes that not all components of a basic command are shown in Figure 4, and "that basic commands may further include other field components for additional information[,] e.g., immediate data, such as text." *Id.* 16:27–29.

In sum, a "collection of basic commands . . . forms a single unified page to be rendered by the wireless device." *Id.* 15:65–67.

3. Custom Configuration

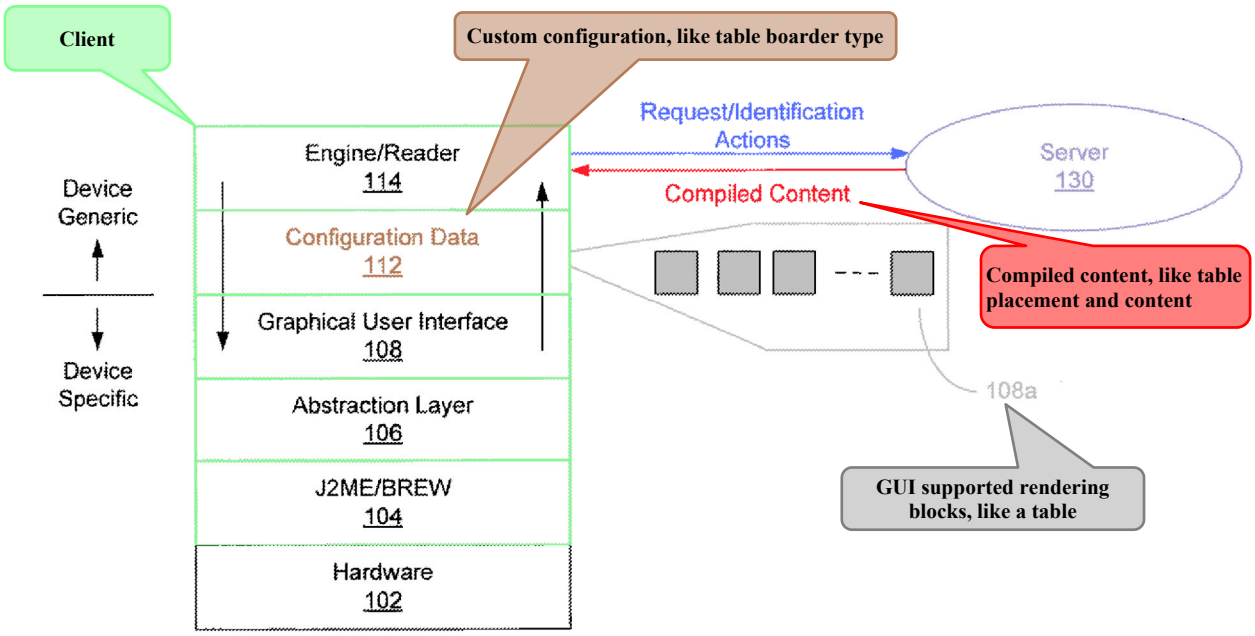
As taught by the Patent-at-Issue, if the client requests to run an application, the decoding system can also "access a library of custom configuration data 540," shown as ⑨ above, "to customize the appearance of the application" and "send the identified custom configuration to the client." *Id.* 16:51–61.

The client can use the custom configuration to configure the GUI's rendering blocks to set how they "operate and look" that—in aggregate—sets "the look and feel" of the application. *Id.* 7:59–66; 10:58–60; 18:41–43. For example, custom configuration data may configure the GUI rendering blocks' fonts, colors, border thickness, images, background images, icon type/image, menu styles, sound, video, etc., *id.* 8:52–10:57, such as "customiz[ing] a 'submit' icon to look like an airplane flying away when pressed," *id.* 7:63–65.

The custom configuration may be globally applicable to pages of an application. I.e., new application compiled content can be rendered using the GUI's rendering blocks that were previously configured without the application sending new, or resending the previous, custom configuration data. *See, e.g.*, *id.* 14:30–33 & Fig. 2B.

4. Client

The Patent-at-Issue refers to the software on the wireless devices that interacts with the server, displays application content, and detects user interaction with the application as the "client." *Id.* 6:20–24. The client generally comprises the "software stack" conceptualized as residing at a higher level than the wireless device hardware as shown in "Blocks 104 through 114" below. *Id.* 6:61–63.



Ex. 1001 Fig. 1B. It is the client that "draw[s] the screen according to the description as specified by the received discrete low level basic commands and in accordance with the identified custom configuration." *Id.* 13:34–37. Specifically, the client can configure rendering blocks with the configuration data, and then an engine/reader can process the compiled content to ultimately render the application's pages. *Id.* 7:29–34; 18:63–19:4.

III. OVERVIEW OF THE CITED REFERENCES

A. Hariki

Hariki concerns "a mobile device UI configuration system that allows a UI skin package content provider to easily generate a new UI resource file for new or different mobile devices, and make these UI skin packages available for download and installation on user mobile devices." Ex. 1005 [0008]. With these "UI skins," Hariki "provide[s] user interface (UI) customization capabilities that allow users to personalize their phones or mobile devices with custom ringtones, background displays (wallpaper), menu configurations, and the like," *id.* [0005], to replace the "default user interface for each model of device," *id.* [0007].

Specifically, Hariki contemplates a "user interface authoring tool" that "maintains a common database of resources for each mobile device model" "defined by device manufacturers." *Id.* [0019]. The "resources comprise files, links to files, and/or data or program objects associated with the configurable aspect of the user interface for each mobile device." *Id.* [0019]. "Thus, as shown in FIG. 2, a resource profile is provided for device A, and a resource profile is provided for device B. With reference to FIG. 1, these can correspond to resource profiles for mobile devices 108 and 109, respectively." *Id.* [0031].

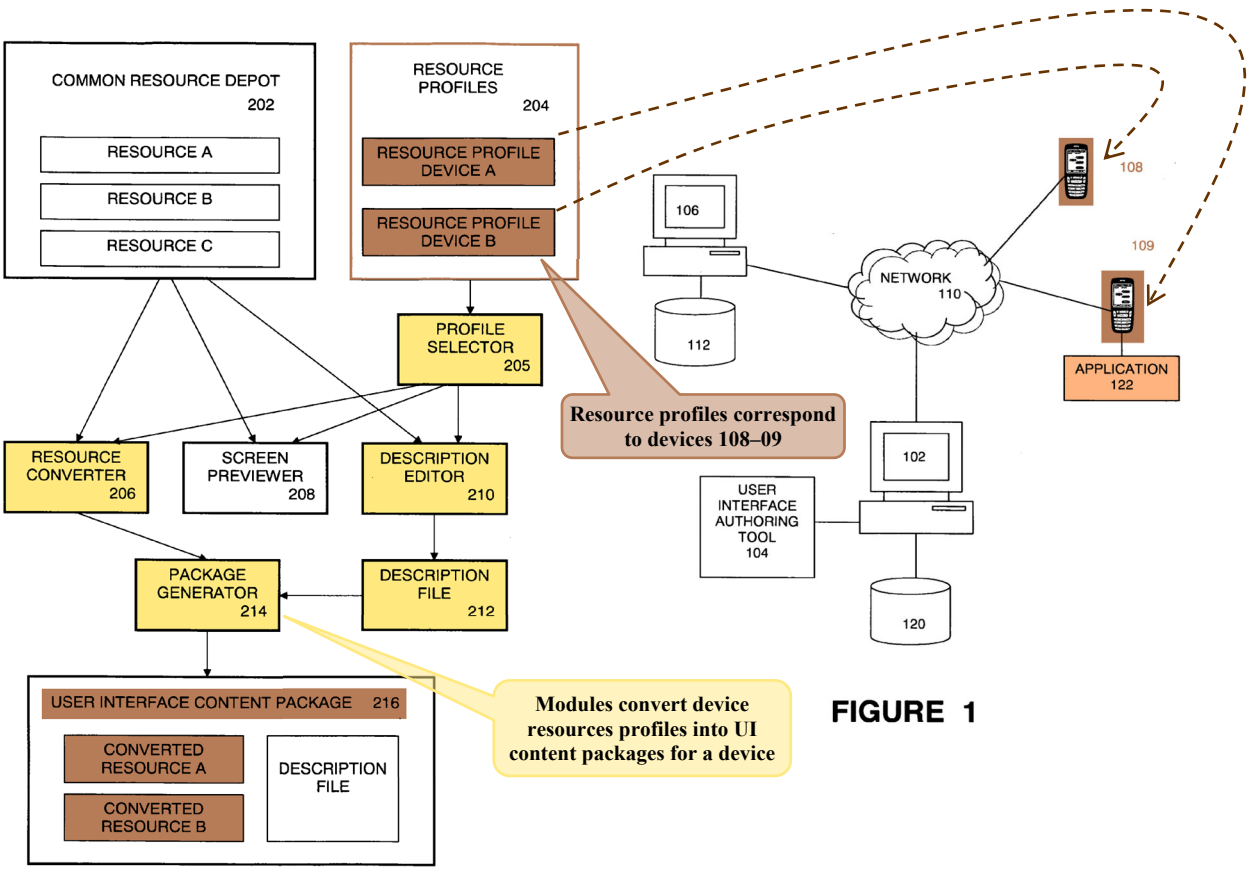


FIGURE 1

FIGURE 2

Ex. 1005 Figs. 1–2.

Hariki explains that various "modules" (205–12) use the resource profiles for the devices to create a UI content package 216 for a device. *Id.* [0032–33]. Specifically, "[t]he profile selector 205 selects a resource profile 204 depending upon the device model selected by the content provider. The corresponding resource 202 for that model is then converted by resource converter 206." *Id.* [0032]. "A description editor component 210 produces description files 212 . . . [and t]he description file 212 and the converted resource output from resource converter 206 are processed by a package generator component 214 . . . [that] takes the resource

and description and creates a UI content package 216." *Id.* [0033].

Once created, "[t]he actual UI content package to be downloaded is generally selected by the user of the mobile device." *Id.* [0044]. And "the user can change the UI content by changing the [device's settings through the] setting application 504." *Id.* With the skin in place, "one or more application programs 122 or software modules . . . access the resources provided by the UI content package." *Id.* [0040]. That is, any application or program "can playback or perceive the image, video, sound files, etc. of the resources provided by the UI content package." *Id.* In this way, "UI skins allow a user to customize the 'look and feel' or application program environment of a device by altering display and/or sound output aspects of the device, such as backgrounds, title bars, buttons, alert sounds, and so on." *Id.* [0024].

B. Harris

Harris concerns "delivery of the same content to multiple mobile devices using different device protocols." Ex. 1006 [0002]. To do this, Harris envisions a mobile content framework ("MCF") that uses "a generic markup language, referred to as Wireless Abstract XML (hereafter WAX)." *Id.* [0007]. A designer may author pages "created in WAX originally," or "content [may be] first translated in to WAX from the original language of the content provider." *Id.* The content may be stored at any "content location" interfaced with the WAX server. *Id.* [0008].

Whatever the source and wherever the content resides, the MCF may translate

the "WAX language . . . to a requesting device's native language . . . [or] from WAX to languages like WML, HDML and HTML." *Id.* [0018]. For example, WAX element "<wax:button>" may be sent "as a 'soft-key' for WAP devices, but as a 'link' for devices which understand only HTML." *Id.* [0030].

However, Harris also notes that "even when two devices employ the same language, there is no guarantee that they each interpret and render content the same way. For example, the way WML is rendered on Nokia devices is very different from the way it is rendered on devices from other manufacturers." *Id.* [0003]. Therefore, "not only [does Harris] translate[] [WAX] into a specific language appropriate for the device, but . . . [the translation] is tailored based upon the attributes of the requesting device." *Id.* [0018]. That is, the MCF may handle "the idiosyncrasies of each device," such as considering the fact that Nokia's WAP browser "does not display lists in the same fashion as the [WAP] browsers on phones from other manufacturers." *Id.* [0017]. The MCF may even "address special characteristics of . . . devices (special character encodings, scripting languages, etc.)," *id.* [0028], by running the translated WAX files, for example intermediate HTML files, through "another level of processing in order to accommodate device requirements such as character encoding," *id.* [0034].

Harris also teaches that, in one embodiment, an automated testing environment can make sure the content will be displayed correctly *before* the

translated device-specific files are deployed to a device. *Id.* [0035].

Ultimately, only the device-specific "customized content is . . . returned to the requesting device." *Id.* [0024] & Fig. 3.

IV. LEVEL OF ORDINARY SKILL IN THE ART

Patent Owner generally concurs with Petitioner that a person of ordinary skill in the art ("POSITA") would have an electrical/computer engineering degree or a degree in a closely related field. Pet. 17. And Patent Owner's view is that the POSITA would have a couple of years' experience in the "field of wireless communication systems" and "[m]ore particularly, . . . method[s] and system[s] for rendering applications on a wireless device." Ex. 1001, 1:13–16. More education may substitute for less experience and vice versa.

V. CLAIM CONSTRUCTION

Patent Owner has already explained in Sections II.C–D above beginning on page 6, the many of the claim terms in view of the Patent-at-Issue's discussion of its embodiments. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc) ("[C]laims must be read in view of the specification."). As such, Patent Owner will not repeat the discussion here.

Petitioner purports to give all claim terms their plain and ordinary meaning. Pet. 17–18. One, this is inconsistent with the position Netflix has taken in district court, as discussed in Section VII.F beginning on page 59 when discussing *Fintiv*

Factor 6. Two, Petitioner's "ordinary meaning" position is belied by the fact that Petitioner puts forth constructions for terms throughout the petition. *See, e.g.*, *id.* 26–27 & n.7 (defining "renderable content"); 39 (giving example of "syntax that is generic to said wireless device"); 51 n.12 (defining "commands"); 52–53 (describing "reader"); 55 n.13 (intimating that "renderable content" is indefinite); and 61 (defining "syntax"). To the extent necessary, Patent Owner will likewise address Petitioner's proposals as they arise in context.

VI. HARIKI IN VIEW OF HARRIS FAILS TO RENDER ANY CLAIM OBVIOUS

A. Hariki Fails to Disclose Limitations 1b/12b/23f

[1a/12a] receiving an identification of a custom configuration of a plurality of rendering blocks of said wireless device, **[1b/12b/23f]** wherein said custom configuration is [associated with an application and/operable to] configure[s] said plurality of rendering blocks to render content in a manner customized to said application;

1. The "Custom Configuration" Petitioner Points to in Hariki Is Not Associated with (1b/12b), and Does Not Customize Rendering Blocks for (1b/12b/23f), an Application

Hariki does not teach a "custom configuration . . . associated with an application [that] configures said plurality of rendering blocks to render content in a manner customized to said application." Petitioner identifies the "converted resource files . . . in Hariki's UI content package" as "the claimed 'custom configuration,'" Pet. 30; However, Hariki's converted resource files are associated

with, and render content in a manner customized to, *a device*, rather than *an application* as required by the claims.

Hariki teaches that when "mobile devices 108 and 109 are delivered to the users [the devices come] with a default user interface that presents a set UI skin consisting of a particular screen configuration, size, color scheme, font, menu scheme, keypad button assignment, ringtone selection, and so on." Ex. 1005 [0026]. The UI customization skin that Hariki envisions overrides this default skin and customizes some "aspects of *a mobile device*." *Id.*[6]

The customizable items are noticeably device features. For example, Hariki discusses that the UI customization "allow[s] users to personalize their phones or mobile devices with custom ringtones, background displays (wallpaper), menu configurations, and the like." *Id.* [0005]. And common experience informs that the referred to background is the *device* screen shown when no applications are running, ringtones are the sound made when the *device* receives a call, and the menu configurations are for *device* navigation. Hariki even notes that the more granular customizations, "[t]he ability to change or customize the colors, fonts, sounds, and functions," are "of the *device* UI." *Id.* Overall, Hariki is clear that the UI customization "alter[s] display and/or sound output aspects *of the device*."

[6] In this Preliminary Response, all emphasis in quotes is Patent Owner's unless otherwise noted.

Id. [0024]. Petitioner agrees. Pet. 35 ("[A] UI content package . . . alter[s] the look and feel of aspects of the display and sound *of the mobile device*.").

Indeed, Hariki explicitly says the process for creating a UI skin starts with "resources . . . [that are] *associated* with the configurable aspect of the user interface *for each mobile device*" as a whole. Ex. 1005 [0019]. That is, "[t]he resource profiles specify the type, format, size, placement, and various other parameters for each user interface element *for the device* . . . [as] shown in FIG. 3." *Id.* [0035].

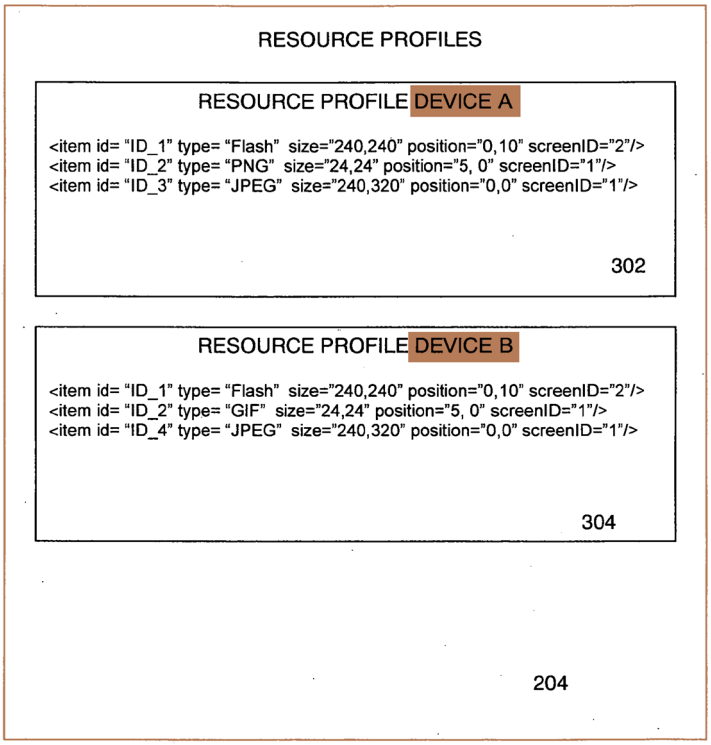


FIGURE 3

Ex. 1005 Fig. 3.

And even after the resources in the *device* profiles are converted and packaged as shown in Figure 2, "[t]he UI content package [216 still] contains the UI skin for

the target mobile device." *Id.* [0033].

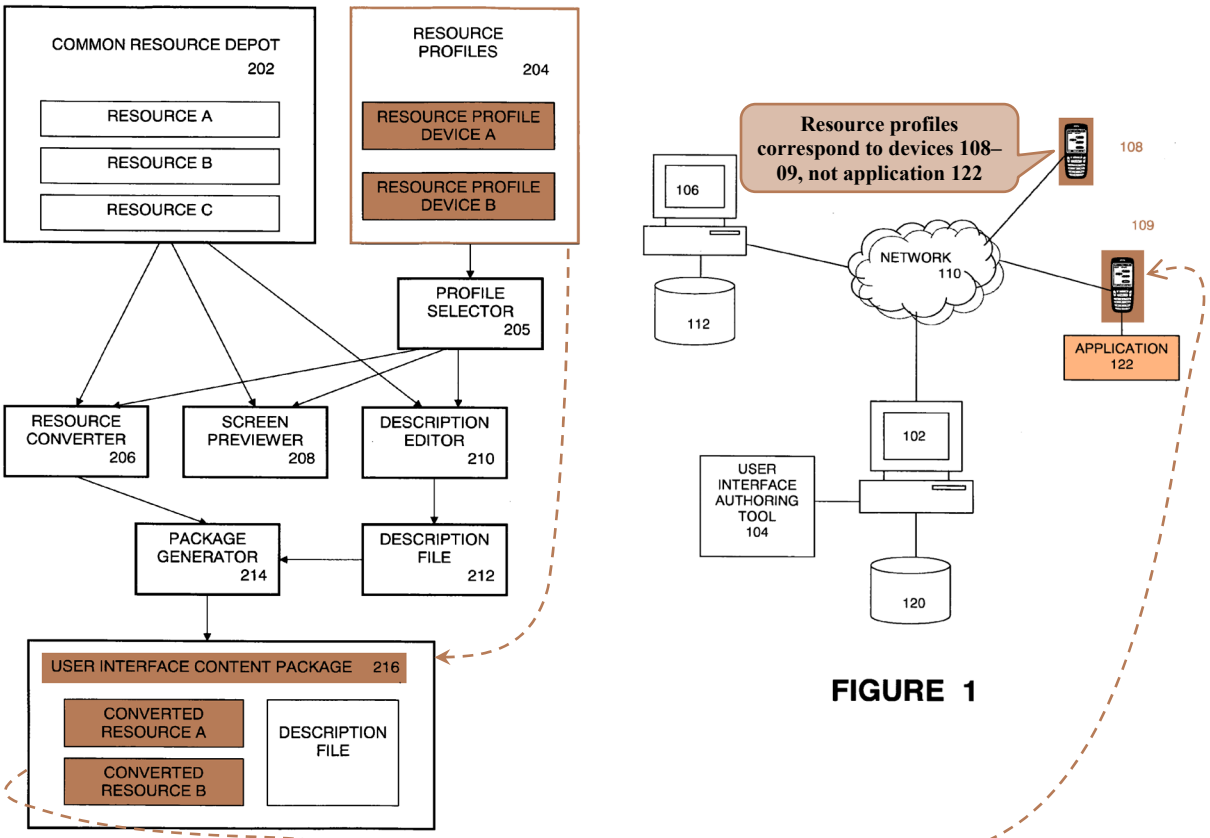


FIGURE 1

FIGURE 2

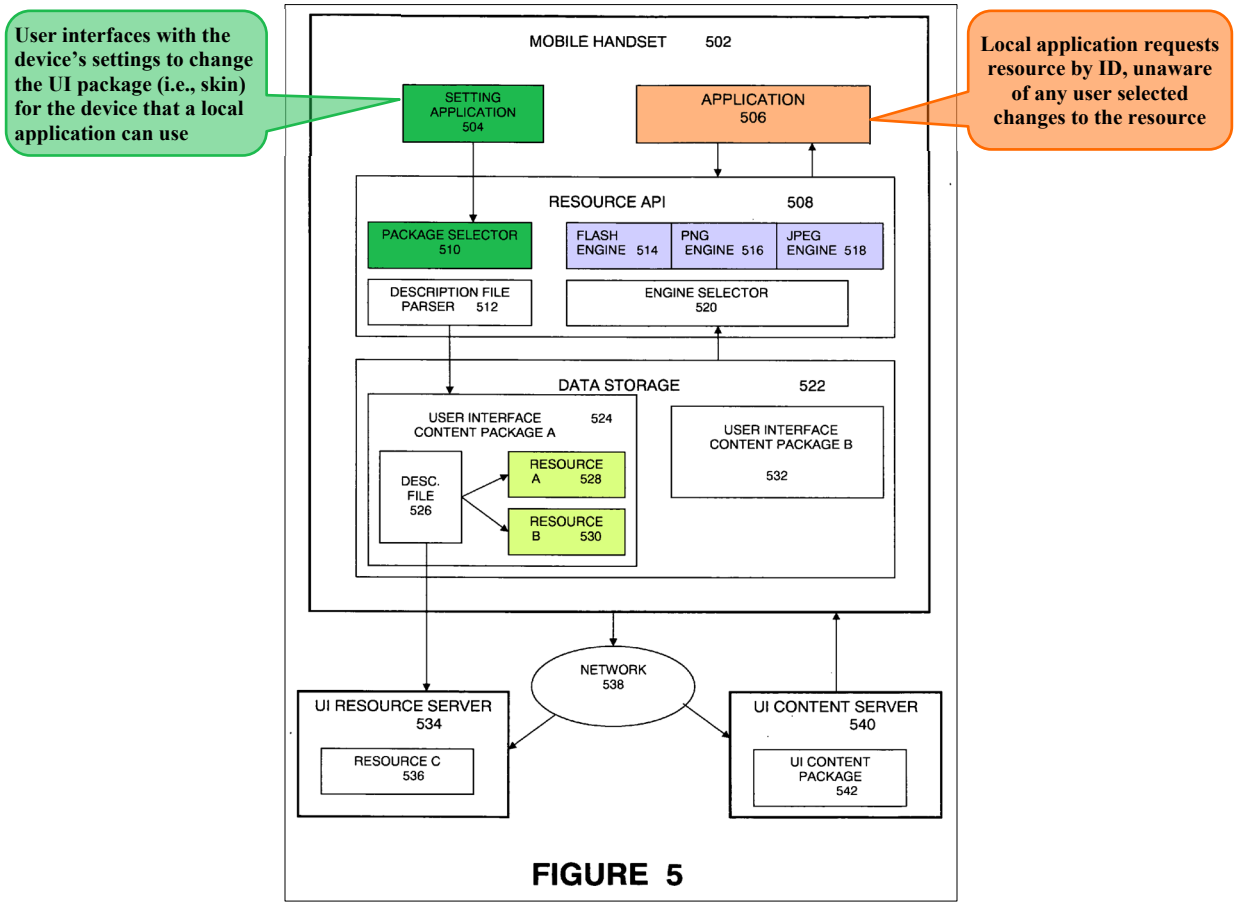
Ex. 1005 Figs. 1–2. "Thus, as shown [above] in FIG. 2, a resource profile is provided *for device* A, and a resource profile is provided *for device* B" that "correspond to resource profiles *for mobile devices* 108 and 109 [of FIG. 1], respectively," *id.* [0030], because "[t]he profile selector 205 selects a resource profile 204 *depending upon the device model,*" *id.* [0032]. Accordingly, the resource profiles of Hariki are *device* specific rather than *application* specific.

This device-level customization is also seen in Hariki's description of its method of creating a new user interface content package UI through an authoring

tool that begins by selecting a device—not an application—specific resource profile and ends with a device—not an application—specific UI skin content package. *Id.* [0036] ("The method begins in step 401 with selection and retrieval of the appropriate resource profile *for the device* from the resource profiles 204."), [0037] ("[A] common resource file database can be used to generate different UI content packages *for each mobile device* in a network.").

And while Hariki does say that applications running on a device "can gain access to local or external resources by simply specifying a resource ID" within a UI content package, *id.* [0051], the applications are simply unaware of the UI skin changes the user makes "to customize the 'look and feel' or application program *environment* of a device," *id.* [0024]. This is clear from Hariki's teaching that "*the mobile device* is able to change the UI skin of the application 506 . . . without requiring modification of the application itself." *Id.* [0042].

For instance, Hariki explains that "the user can change the UI content by changing the setting application 504" which "sets the UI content package data for the application program [506] . . . [a]s shown in FIG. 5." *Id.* [0044].



Ex. 1005 Fig. 5.

The resource files of Hariki's UI content package are simply not associated with, and do not render content in a manner customized to, an application; they operate on the device as a whole.

2. Petitioner's Hariki Citations also Support that the Device Skin Is Not "Associated with" or "Customized to" an Application

Petitioner points to Hariki's language that a new device skin changes the

"application program *environment* of a device," Pet. 35 (citing Ex. 1005 [0024]). "Environment" references the entire program ecosystem, not any one application. Indeed, Hariki overtly notes "the mobile device . . . is configured to run one or more application programs 122 [plural] or software modules [plural] to execute or access the resources provided by the UI content package." Ex. 1005 [0040]. Because the skin affects *all* applications running in the device's program *environment*, the UI content package resources are not "associated" with or "customized" for a specific application.

Next, Petitioner notes that Hariki teaches that a resource may be "converted to an appropriate format for use by the application." Pet. 35–36 (citing Ex. 1005 [0039]). But Hariki discloses only two resource conversion embodiments, Ex. 1005 [0039], and both affect the device as a whole, neither customizing rendering blocks for a particular application. "In [the first] embodiment, the content server performs the necessary resource retrieval and conversion operations and downloads the resources directly to the mobile device . . . [as] the resource profiles 204 specify." *Id.* In this server conversion case, the resources from the Common Resource Depot 202 are converted by the Resource Converter 206 per the resource profile for *the device* shown in 204 and chosen by the Profile Selector 206. Ex. 1005 [0032]. These converted resources are bundled in Hariki's UI Content Packages downloaded to the device as shown in item 524 of Figure 5 above, and

equally accessible to all applications through the Resource API (i.e., are not specific for an application).

"In [the second] embodiment, the mobile device handset itself contains components to facilitate the downloading and conversion of resource files or data objects from *common* UI package content *for use in resident application programs*," plural. *Id.* [0039]. In the device conversion embodiment, the mobile device has multiple "engines" for processing Flash, PNG, or JPG formats that will process the resource depending upon the type of data or program in the resource, but, again, the engines provide this service for all applications on the device, and the engine used is based upon the file type. *Id.* [0043] & Fig. 5. Therefore, Hariki's conversion of resources to an "appropriate" format is not the teaching of conversion "customized to said application" as the claims require.

3. The "Custom Configuration" Petitioner Points to in Hariki, the UI Skin, Is Not Associated with the Two Petitioner-Identified Applications, the Web Browser and Web Server

Petitioner identifies two applications for limitation 1b. Initially, Petitioner says the application is "the web browser" running on the wireless devices 108–09. Pet. 36. Then, in an attempt to identify an "application" that is not exclusively executing on the wireless device, Petitioner identifies "the web server process [on server 102] that serves HTML files to the mobile device." *Id.* 36–37. Neither alleged application is "associated" with Hariki's alleged "custom configuration" (UI

skin).

As for the web browser, Hariki does not teach that the browser ever accesses a UI content package. But even if it did, as previously explained, converted resources are "common" UI package content in that they are for use by all "resident application programs," and are not associated with any one application. Therefore, the UI skin would not set the look and feel of the web browser differently than other applications who are also accessing the same resource API, so the UI skin would not be particularly associated with the web browser.

As for the web server, Petitioner's theory rests on the fallacious proposition that "POSITAs would have recognized the user interface authoring tool and web server process were part of the same suite of programs because they [1] reside on the server together and [2] that the authoring tool generated the custom UI for mobile devices accessing the web server process." Pet. 36–37. For [1], everyday experience informs that programs residing on the same computer do not have to be part of a suite, i.e., "a set of computer programs designed to work together and usually sold as a single unit." *See* Ex. 2004 (https://www.merriam-webster.com/dictionary/-suite). Indeed, Petitioner does not argue that the web server and the user interface authoring tool interact in any way. And even a cursory review of Hariki's Figure 2, the "functional diagram of a user interface authoring tool" Ex. 1005 [0012], [0028], shows no such interaction. The authoring tool and web server are not part of a

program suite.

For [2], Petitioner does not explain why, even if the authoring tool provided a "UI content package" to a remote device, and that remote device had a web browser that interfaced with the UI content package and displayed content from a web server running on the same server as the authoring tool, the UI content package would be associated with this particular web server. Hariki says that "the mobile devices run[] a web browser program to access the web pages [not only] served by server computer 102 [but] any other available content provider or supplemental server, such as computer 106." *Id.* [0021]. Therefore, there is simply nothing that makes downloading web content from a web server that happens to be co-resident on the server running the authoring tools special such that the "UI content package" on the wireless device is *associated with* this web server any more than any other web server serving the same or different content.

Given that Petitioner's bases for asserting a web server that happens to be running on the same computer as the authoring tool means the web server is associated with the UI skin on the wireless device is incorrect, so is the assertion.

4. The "Custom Configuration" Petitioner Points to in Hariki, the UI Skin, Does Not Configure a Plurality of Rendering Blocks to Render Content in a Manner Customized to Petitioner's Two Identified Applications, the Web Browser and Web Server

These limitations not only require the custom configuration be associated with an application, but they require that the custom configuration also *configure* a

plurality of rendering blocks to customize the application. Petitioner does not make this showing.

Petitioner's argument as to why the UI content package allegedly *configures rendering blocks* for these applications is reproduced here in its entirety:

> Furthermore, *Hariki* explains that the UI content package is specific to the mobile device type and the application programs. *Hariki*, ¶27. Accordingly, POSITAs would have understood that the UI content package is customized to the web server-web browser interaction and consequently customized to those applications. *Bederson*, ¶129.

Pet. 37. Petitioner first cites Hariki at [0027], but this paragraph only discusses how customizable UI elements are "generated," "downloaded," and "made available" to a device, Ex. 1005 [0027], not that the UI elements are *customized* to any particular application. Then Petitioner simply puts forth its conclusion, solely citing its expert who merely parrots the Petition's cursory statement with no analysis. Pet. 37 (citing Ex. 1002 ¶129). This is not valid "evidence." Director Review, *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624-12, at 5 (PTAB Feb. 10, 2023) (agreeing that a Panel was right to disregard a declaration that "copies, word-for-word, Petitioner's conclusory assertions").

The Petitioner puts forth no real evidence or argument that the UI skin configures rendering blocks customized for the browser/web server applications,

because it cannot. Even if the UI skin could configure a wireless device's web browser, there would be nothing *custom* about the configuration. As previously explained, converted resources—whether pre-converted on the server or converted on the mobile—are "common" UI package content in that they are for use by *all* "resident application programs" through the resource API. Therefore, the UI package content would not be customized to the web browser, the alleged application.

And Hariki does not contemplate that the web server application is running or rendering *anything* on the wireless devices, so there is *nothing* of this web server application for the UI skin on the wireless device to even customize. Indeed, this is why Petitioner conflates the server with the browser, referring to the "web server-web browser *interaction*," Pet. 37, trying to impute the browser's rendering to server.

More subtle than this muddying of the waters—but no less improper—Petitioner also implicitly shifts the previously identified application from the web server *itself* to the *content sent by* the web server that "interacts" with the browser.[7]

[7] Petitioner is more explicit in Limitation [1f]. There, Petitioner alleged Harris' devices received content "specific" to a first/second page of an application by providing a soft-key for WAP devices but a link for HTML devices. The soft-key/link is the content sent to a device *by* a web server and rendered *in* a browser, not a web server application. Pet. 50–51 (citing Ex. 1007 ¶30.).

Not only is this a change of what the identified "application" is, Petitioner has a separate problem: Hariki does not teach that the identified custom configuration, the UI skin, affects the *content* sent by the web server in any way, much less configures the rendering of the content in a manner particular for web server 102 differently than from content from any other web server. Hariki's UI skin may change items such as a browser's title bars because browser is running in the device's "application environment," *see* Ex. 1005 [0024], but does not affect content *within* the browser application that is specified by the HTML as Petitioner concedes, Pet. 11 (explaining that it is the HTML that "describ[es] the visual presentation"). Therefore, the UI skin would not customize rendering blocks to render content in a manner customized to content sent from the web server and this limitation is still not met.

5. Petitioner Does Not Address How the Combined Hariki-Harris System Modification to the "Application" Meets This Limitation

Petitioner makes a vague proposal to modify Hariki's web server—the alleged application—in view of Harris for limitation 1f/12f. Pet. 48–49. However, Petitioner never attempts to show that the modified combination teaches this limitation. That is, Petitioner does not explain why the UI skin is associated with, and configures a plurality of rendering blocks to render content in a manner customized to, the *modified* web-server Petitioner envisions for other limitations. Indeed, Petitioner recognizes that Hariki and Harris "each describe[] . . . different

aspects of . . . customization," *id.* 50, but makes no attempt to reconcile this fact with regard to this limitation. Therefore, Petitioner has additionally not shown this limitation is met through the Hariki-Harris combination petitioner uses for the claims as a whole.

6. Limitation Summation

Under any of Petitioner's theories, Hariki does not meet these limitations that are an important aspect of the Patent-at-Issue's claimed invention. Petitioner is reading "associated with an application" to mean any possible enunciated relationship no matter how tenuous. But the Patent-at-Issue explains a custom configuration is "associated with an application" and "customized to said application" in the sense that "each application may have a *corresponding* custom configuration data to customize the appearance of *the application*." Ex. 1001, 16:51–54. That is, the Patent-at-Issue contemplates multiple applications, *see, e.g.*, Fig. 5 (item 530) (showing a library of applications), and the custom configuration is "the theme" that determines the "look and feel" of *each application* vis-à-vis other applications, *id.* 3:14–15; 4:12–15; 16:51–54. In such a manner, an aviation application may "customize a 'submit' icon to look like an airplane flying away," *id.* 7:66–8:1, and a calendar application could set a "scroll bar . . . [to] an image of a shamrock leaf during St. Patrick's day," *id.* 10:60–64. Hariki does not provide the application-level customization found and claimed in the Patent-at-Issue,

whether considering Hariki's web browser or web server.

B. Hariki in View of Harris Fails to Disclose Limitation 1c/12c/23b under Petitioner's Web-Browser-Is-the-Application Theory

[1c]/[12c]/[23b] [receiving/said transceiver also operable to receive] compiled content generated in part from execution of said application

These limitations mandate that execution of the previously identified application at least in part generates the received compiled content Petitioner identifies HTML files from a web server that are received at a web browser. Pet. 37–38. Hariki does not disclose this limitation, as Petitioner explicitly admits. Pet. 49 ("*Hariki* . . . does not expressly disclose how the HTML files are generated."). Therefore, the Petitioner invokes Harris.

However, Petitioner's first-identified application, the web browser running on a wireless device, even in a Hariki-Harris system, does not generate the Petitioner-identified compiled content, the HTML files from the server. Petitioner admits that "Hariki serves HTML files from a web server that are received at a web browser." Pet. 37. And the Petitioner does not advocate for any changes to this basic aspect of Hariki based on Harris. So, the HTML files could not have been "generated" by the web browsers on the wireless devices, as the HTML files are completely generated outside the wireless devices and *before* the web browser even receives the HTML.

Petitioner's argument is that a browser supposedly generates HTML, because in some instances Harris MCF may be prompted to generate HTML from WAX via

a browser's "HTTP request." *Id.* 38. This is incorrect, because it is ultimately the MCF that generates the HTML, regardless of what prompted the MCF to action. For example, in the Patent-at-Issue a wireless device can "request[] an application" from the server via a message from the reader. Ex. 1001 3:2–4. This prompts action because "[t]he requested application is executed on the server" "[i]n response." *Id.* 3:7–12, Yet, the specification does not say the wireless device generates the application, instead identifying that it is the server that "produces dynamic or static pages" "during execution of an application [on] the server." *id.* 3:31–33.

C. Hariki in View of Harris Does Not Disclose Limitation 1d/12d/23c

> **[1d]/[12d]/[23c]** [wherein said compiled content comprises/comprising a plurality of] render[ing] commands expressed in a syntax that is generic to said wireless device;

For these limitations, Petitioner argues that Harris' Wireless Abstract XML ("WAX") files constitute "said compiled content" and that "the WAX language used a syntax that was device generic." Pet. 40–41. Petitioner also includes an afterthought that "HTML itself is in a syntax that is generic to the mobile device." Pet. 38.

1. Harris' WAX Files Cannot Be "Said Compiled Content" Because WAX Was Not Identified for Prior "Compiled Content" and Is Further Not Received at the Wireless Device

Petitioner argues that Harris' WAX files are "said compiled content," with "said" referring to the claim's previous invocation of compiled content. Pet. 41. But

Petitioner cannot now identify WAX files as *said* compiled content for this limitation, where Petitioner had previously identified HTML files as "compiled content" in limitations 1c/12c/23b. *Wi-Lan, Inc. v. Apple, Inc.*, 811 F.3d 455, 462 (Fed. Cir. 2016) (reminding courts that a prior art element identified for one limitation must be the same element for a subsequent limitation referring to the same "said limitation"); *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1306 (Fed. Cir. 2005) (agreeing that "the" referring to a previous limitation means the structure in the limitation must be the same as that in the previous limitation).

Petitioner also says that "the Hariki-Harris system, content data received by the mobile device for rendering is expressed in WAX." Pet. 41. This is simply not true. Harris' MCF performs a "conversion of WAX into the languages used by the requesting mobile devices such as WML, HDML and HTML" *prior* to sending the converted language to the mobile device, so the WAX itself is not "received by the mobile device." Ex. 1006 [007] & Fig. 3. Therefore, this WAX cannot be the received "compiled content."

2. Harris' WAX Is Translated into Syntax that is *Specific* to Said Wireless Device so Is Not Device Generic

The thrust of Petitioner's argument is focused on the WAX files because Petitioner is aware that the Harris system "convert[s] WAX content to *device-specific* content," Ex. 1006 [0014], the opposite of "syntax that is generic to said wireless device." *See e.g.*, *id.* [0018] ("The WAX language may be dynamically

translated to a requesting device's native language . . . [or] other markup languages . . . like WML, HDML and HTML . . . a specific language appropriate for the device.").

Petitioner disregards Harris' many teachings that its output is device-specific and argues that the output syntax is nonetheless "generic to the mobile device . . . [because] HTML is a standardized language that has the same syntax no matter what device is receiving it." Pet. 38. One, Harris notes even if a "standardized language" is used, it still must be tailored for particular devices because "even when two devices employ the same language, there is no guarantee that they each interpret and render content the same way." Ex. 1005 [0003]. As such, after the WAX is translated to a device-specific language such as HTML, "[t]he stream can then be filtered through another level of processing in *order to accommodate device requirements* such as character encoding." *Id.* [0034]. Therefore, two devices both receiving HTML will not always receive "the same syntax" as Petitioner alleges, so the HTML is not in a "syntax that is wireless device generic," even under Petitioner's "has same syntax no matter what device is receiving it" definition.

Two, and more importantly, Petitioner is defining "device generic" syntax incorrectly. The Patent-at-Issue is clear that "syntax that is device generic [is such because it is the same] *regardless of the wireless device type,*" Ex. 1001, 18:8–10, in the same way the Patent-at-Issue's applications can be "generic regardless of the

wireless device type," *id.* 6:26–28. This is illustrated in the Patent-at-Issue's Figure 4 that shows syntax such as X, Y coordinates, width and height, object identifiers, etc. regardless of the device receiving the compiled content so the reader can always expect and "interpret[] commands of a generic syntax." *Id.* 2:51–52. In contrast, what language Harris sends—whether it be HTML, the device's native language, or another markup language—is a function of the wireless device. Ex. 1006 [0018].

Therefore, Petitioner is incorrect that the output from the WAX processing in a Hariki-Harris system "is expressed . . . using a syntax that is device independent," Pet. 41, and Harris' HTML also does not "comprise[] render commands expressed in a syntax that is generic to said wireless device."

D. Hariki in View of Harris Does Not Disclose Limitation 1e/12e/23e

> **[1e]/[12e]/[23e]** [using/a processor coupled to said bus and operable to implement the following:] a graphical user interface comprising [a/said] plurality of rendering blocks [and operable] to generate renderable content based on said compiled content and said custom configuration

1. Petitioner Does Not Explain How HTML Files Would Use Converted Resources

Hariki as modified by Harris like Petitioner suggests does not teach using a GUI with a plurality of rendering blocks based on the HTML files (the alleged compiled content) and the UI skin resources (the alleged custom configuration). All Petitioner can say for this limitation is that Hariki's web browser "receives both

HTML files and converted resources, Pet. 43, but *receiving* the two items does not show that Hariki's GUI uses rendering blocks to render content *based on both*.

Indeed, Hariki teaches that for an HTML file to use a UI skin resource, the HTML code must "properly reference" the resource so that it can be "located . . . [and] retrieved by the resource API and input to the engine selector for processing by the appropriate engine," Ex. 1005 [0051] & Fig. 7, but Hariki alone or in combination with Harris does not teach, and Petitioner does not explain how this would happen. Indeed, Petitioner implicitly admits that "*Hariki* does not expressly disclose using the engines in the resource API to generate renderable content from the received HTML files" by proposing using "*Harris* to modify *Hariki*'s resource API to include additional engines to convert and render HTML files for display on the mobile device." *Id.* 44–45. But Hariki does not say that the web server has access to the resource ID numbers, merely noting that the web server is running on the same computer as the authoring tool. Ex. 1005 [0021]. And Petitioner does not argue that the HTML files translated from WAX per Harris could or would know how to reference Hariki's UI content package either. Therefore, whether the Resource API has three or thirty engines, the HTML files still have no idea what resources are available in a custom UI skin.

2. Petitioner's Proposed Modification Still Does Not Meet the Claim Limitation

Assuming for argument's sake that a POSITA implemented Petitioner's

suggested modification, such alteration still does not meet this limitation whereby the GUI must generate renderable content based on Petitioner's identified custom configuration, the converted resources shown in items 528–30 & 536 below.

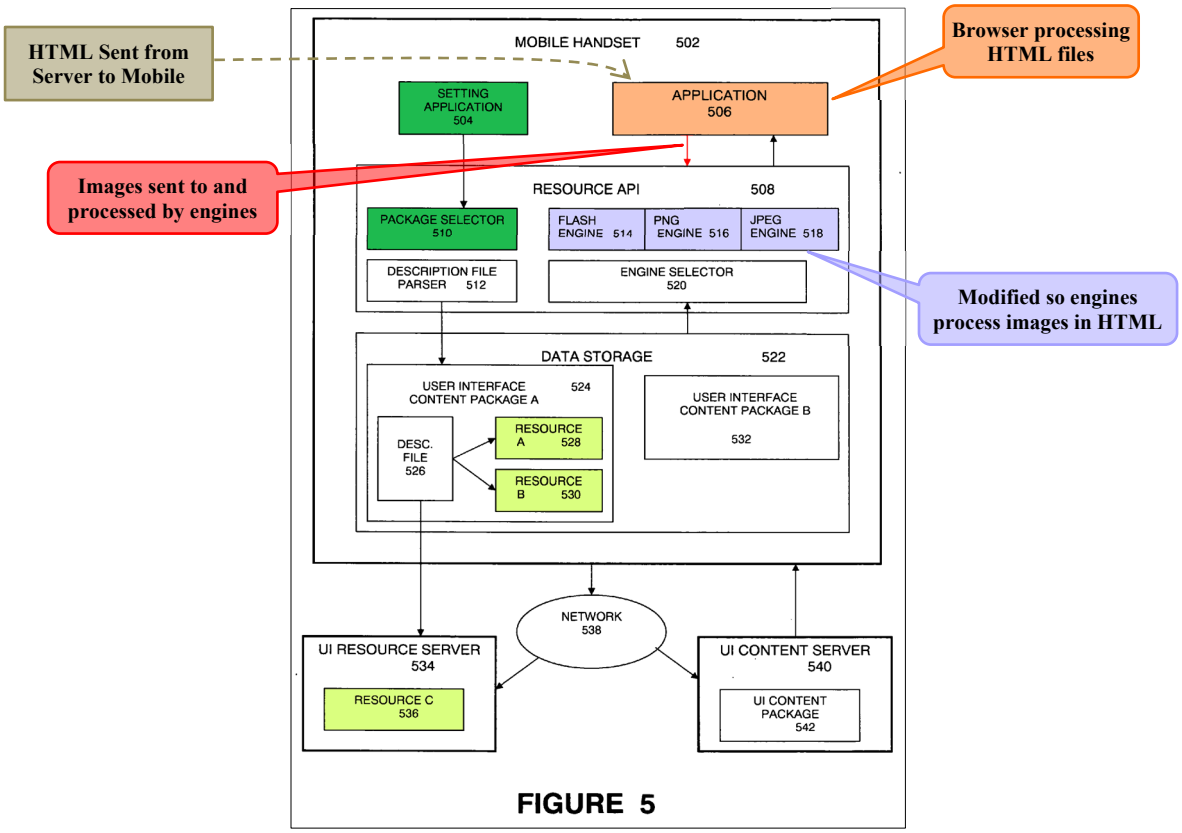


FIGURE 5

Ex. 1005 Fig. 5. As seen above, even if a server sent HTML content to a browser application 506, and the browser application used existing or new Resource API 508 engines 514–518 to process HTML images, this processing does not implicate the converted resources, Petitioner's identified custom configuration, that are found in the Data Storage 522 or a UI Resource Server 534. The HTML files would simply send information for the engines to process, and Petitioner again does not tie the HTML to any of the converted resources.

Indeed, Petitioner's allowance that Harris discloses "an automated testing environment [that] will make sure content will display[] correctly *before* they are deployed to a device," Pet. 45 (citing Ex. 1006 [0035]), only reinforces the conclusion that this limitation is not met. If the display is done *prior to* the HTML files being deployed to the device where the UI skin resources are accessed through the resource API, any test rendering cannot be using the UI skin resources; yet, the files are "displayed correctly." This teaching further supports that the Hariki-Harris HTML does not access, reference, or use any UI skin resources.

3. Petitioner's Motivation to Combine Hariki and Harris is Flawed

Ignoring that the proposed combination does not meet the claim limitations, Petitioner's alleged motivation to combine is also deficient. Petitioner cites Hariki's teaching that its API can add more engines and Harris' Background Section that notes "mobile device[s] displayed content in different ways," *id.* 44–45 (citing Ex. 1006 [0003–04]), for the proposition that a POSITA would change Hariki to process HTML files via its resource API engines. But Harris *already solved the problem* that different devices render content in different ways by generating "[c]ontent . . . specifically for each device . . . [whereby t]he MCF . . . generic markup language . . . can be translated into a variety of different mobile device markup languages." Ex. 1006 [0007]. Moreover, Hariki's "mobile devices [*already*] run[] a web browser program to access [and render] the web pages served

by . . . any . . . available content provider." Ex. 1005 [0021]. Petitioner simply does not explain why Harris' solution is deficient, or would be improved in the slightest, by changing Hariki's current browser functionality to use the API rendering engine to process HTML files. Just because two references *could* be combined, does not show that they *would* be combined. *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1069 (Fed Cir. 2016) ("[W]hile a skilled artisan might have had a reasonable expectation of success in [making the modification] . . . there was an insufficient motivation to [do so].").

E. Hariki in View of Harris Fails to Disclose Limitation 1f/12f/23h.2

[1f]/[12f]/[23h.2] [rendering said renderable content on said wireless device,] wherein said [receiving] compiled content comprises: [receiving/a] first compiled content specific to a first page of said application; and [receiving/a] second compiled content specific to a second page of said application,

These limitations require the received "compiled content" rendered on the wireless device comprise specific "pages *of*"—not "pages served by" or "pages consumed by"—the application previously identified. Petitioner identifies the "compiled content" as "HTML files" from "World-Wide Web (WWW) server [102]." Pet. 46–47. Petitioner previously identified the "application" as the wireless device's web browser or, in the alternative, the web server resident on the computer 102 that also hosts the user interface authoring tool. Pet. 35–37.

If the application is the web browser running on a wireless device, as

petitioner first contends, these limitations then require that the Petitioner-identified compiled content, the HTML files, must include content specific to two pages *of* a web browser application. They do not. Hariki does not speak of the browser running remotely from a wireless device and having its interface, including any "pages," sent to a device. Nor does Hariki relate that the locally running browser and its pages were transmitted from server 120.[8] Indeed, Petitioner says that "HTML files received by a mobile device are rendered into pages *in* a web browser on the mobile device," Pet. 47, not that the rendered pages are pages *of* a web browser application. That is, Petitioner admits the "HTML files are a compilation of tags (e.g., the tags are aggregated into a file) *that direct a web browser to display content on device* [sic]," *id.*, but do not direct a device to display a web browser application.

The best Petitioner can say is that the HTML pages are "specific to" the web browser "because that browser application requested the content." Pet. 48. This cannot be correct. The browser can request content from any provider on the Internet. Ex. 1005 [0021–22]. If this made the pages "specific" to the browser, it

[8] To the extent Hariki says anything regarding how the web browser is installed on the device, it is when Hariki refers to the "native UI or mobile device browser," Ex. 1006 [0006], implying that the browser is installed by the "device manufacturers [that mostly] provide a single default user interface for each model of device," *id.* [0007].

would make all content from everywhere sent to the browser "specific." To the contrary, as Petitioner describes, the web technologies, including HTML, enable "computers to communicate *arbitrary* information," Pet. 9, not browser-specific information.

Likewise, for Petitioner's Hariki-Harris combination, Petitioner says Harris' "WAX file[s] are translated . . . specific to the mobile *device*," for example, a WAX button element may be displayed as a "soft-key" for WAP *devices*, but as a "link" for *devices* which understand only HTML. Pet. 50. First, this speaks of pages being *device*-specific, not application specific. Additionally, providing a device with content in the only language the device understands does not make the content specific to any pages of an application, including a browser, otherwise all pages everywhere, whether run through a WAX translation or not, that are written in the device's supported language would be "specific to" the browser application.

Similarly, if the application is the web server running on computer 102, as petitioner alternatively contends, these limitations then require that the Petitioner-identified compiled content, the HTML files, must include content specific to pages *of* that web server application. But Hariki does not disclose transmitting a web server application to the wireless devices in any format, instead noting that the web server process resides on "server 102." Ex. 1005 [0021]. Petitioner, likewise, concedes that Hariki "serves HTML files *from* a web server," Pet. 37, not that the HTML files

constitute content for pages *of* a web server application.

Instead, Petitioner argues that the HTML files are "specific to the web server application . . . because that application is generating the HTML." Pet. 51. But the information and functionality conveyed *by* the HTML is not particular to any device, much less a web server application, because Harris specifies that the content can come from any content creator in any "original language" and from any "content location." Ex. 1006 [0007–08]. Under Petitioner's web-server-is-the-application theory, then, all content everywhere regardless of its nature, is "specific to" a web server application solely because it was handled by the web server. This simply does not give meaning to the claim language requiring that the compiled content must be specific to pages of the application, because Harris' HTML, the alleged "compiled content," is unbounded and not particular to a web server. This is not application-specific content, but "arbitrary information." *See* Pet. 9.

This is an important claimed difference. In the Patent-at-Issue the compiled content gets processed and becomes the pages *of the application*. I.e., "the pages *of the application*," Ex. 1001, 6:33, are the "series of basic commands, precompiled and ready for audio and video rendering by the wireless device," *id.* 6:27–29, such as those shown in Figure 4. *Accord* Pet. 47 (citing Patent-at-Issue 17:66–18:1 & Fig. 4 that explain and show it is the basic commands that render *the application* on the client). For instance, the Patent-at-Issue's server 590 may send compiled content

that will ultimately be pages of a "Texas Holdem" application.

In the end, Petitioner's argument is that the HTML is "specific to" the web server, merely because "the pages [were] served by the web server" and "specific to" the web browser merely because the pages were "consumed by the web browser." Pet. 51. But serving and consuming pages does not make the content served specific to pages *of* the serving and consuming applications. The web browser running on the wireless device in Hariki may be analogous to the Patent-at-Issue's client 210 that *consumes* pages *of* an application but is not *the* claimed application. *See* Ex. 1001, 13:18–19. Hariki's web server may be akin to the Patent-at-Issue's server 590 that is *serving* applications but is not *the* claimed application. Hariki simply does not disclose that the HTML files are content specific to pages of the web browsing and web serving applications Petitioner identifies.

Finally, to reiterate, to the extent Petitioner contends the web server of Hariki is akin to the claimed "application," Petitioner fails to show how its proposed modified version of Hariki's web server in view of Harris for this limitation would then meet limitation 1b that has specific requirements directed to said "application."

F. Hariki in View of Harris Does Not Disclose Limitation 1g/12g/23h.3

[1g]/[12g]/[23h.3] wherein said custom configuration is applicable to both said first and second compiled content.

Petitioner's identified "custom configuration," the "converted resource files . . . in Hariki's UI content package," Pet. 30, is not "applicable" to Petitioner's

identified first/second "compiled content," the "HTML files" from server 102, *id.* 51.

The converted resource files in Hariki's UI content package are applicable to an application environment where the web browser is running, not content rendered by the web browser. Indeed, Petitioner performs a metaphorical sleight of hand for this limitation to improperly shift from the former to the latter. Petitioner first says the "the mobile device is able to change the UI skin of the application 506" (i.e., the web browser that Petitioner has previously identified as one application). *Id.* 52. Then Petitioner switches and says the UI content package is "applicable to all HTML files . . . *displayed in* the application"—rather than the application itself. *Id.*

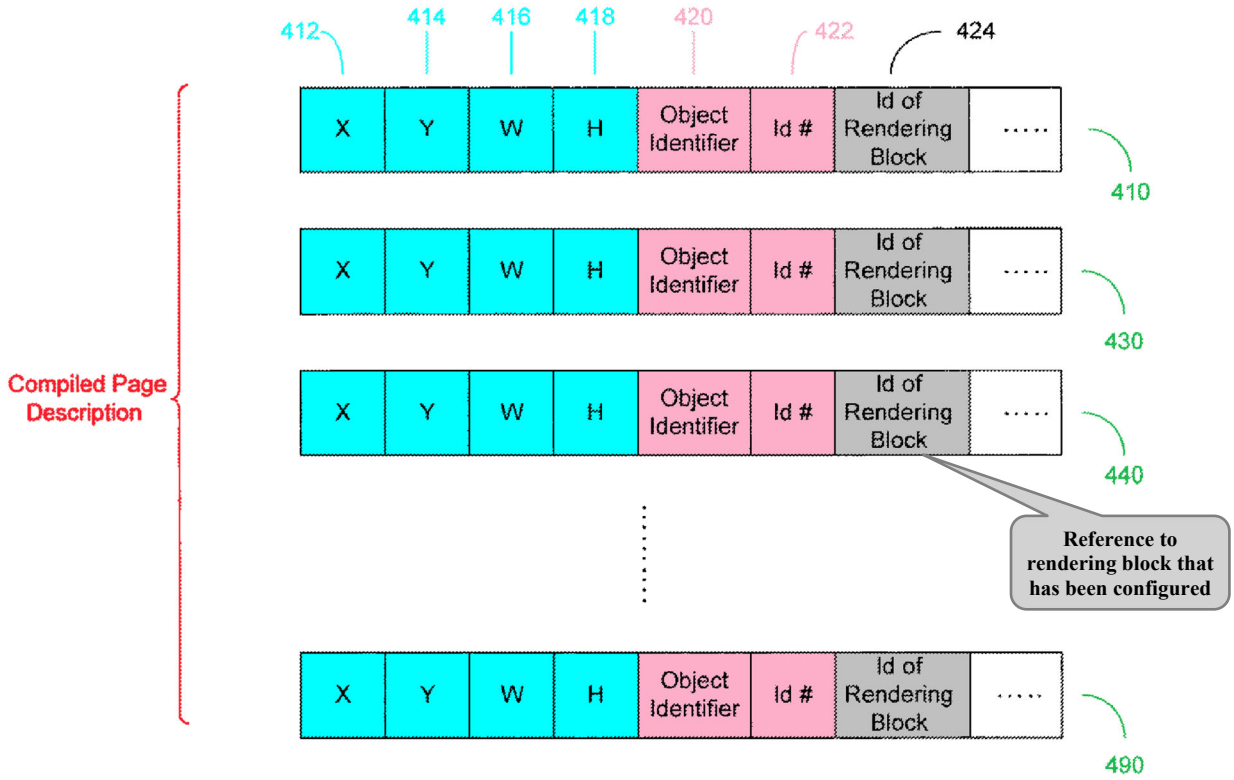
The problem for Petitioner is that, as previously described, Hariki does not teach the UI skin affects the content displayed by the web browser. Indeed, Petitioner implicitly concedes this is so when Petitioner suggests that Hariki's API could *be modified* "to include engines to render and display HTML files." Pet. 46. All Hariki teaches is that the UI skin may change the application environment which may affect all applications, including perhaps the browser's "title bar." Ex. 1005 [0024]. This makes sense as it is the "HTML [that] describes the content in terms of how the content is displayed," *see, e.g.*, Ex. 2005, 1:14–15 (U.S. Patent No. 7,380,205 to Bezrukov *et al.* (filed Oct. 28, 2003)), not mobile device UI skins. *Accord* Pet. 11 (acknowledging HTML "describ[es] the visual presentation"), 47

("HTML files are a compilation of tags (e.g., the tags are aggregated into a file) *that direct a web browser to display content on device* [sic]."). Therefore, while Petitioner speculates that the UI skin might affect the web browser, nothing teaches the UI skin customizes a browser's rendered content, and the UI skin is not "applicable" to HTML files.

Indeed, the UI skin resource files could not be applicable—literally applied—to the rendering as instructed by the HTML, because the HTML commands would have to use some aspect of the converted resource files, and the references and Petitioner do not indicate that HTML files from the server are aware of the resources in Hariki's UI content package on the wireless devices.[9] Again, Hariki teaches that to be "utilized by [an] application" the "resources referenced by the descriptor file" in the user interface content package "must be referenced in some way." Ex. 1005 [0039]. For instance, an "application 506 on the mobile device [may] . . . refer to resources . . . by [an] ID." *Id.* [0049]. But Hariki does not say that the web server has access to the resource ID numbers, merely noting that the web server is running on the same computer as the authoring tool. *Id.* [0021]. And Petitioner does not argue that the HTML files in a Hariki-Harris combination could or would know how to reference Hariki's UI content package.

[9] This holds true if the first and second compiled content pages are pages *of* the application as required by limitations 1f/12f/23h.2, or HTML pages in general.

By way of contrast, the Patent-at-Issue teaches that (1) the "custom configuration . . . *preprogram[s] the plurality of rendering blocks* to operate and look a certain way," Ex. 1001, 2:54–57, 7:58–63; 8:21–22; and (2) the layout solver at the server puts together application pages that are a set of "basic commands [, i.e. a] low level compilation operable to render application content on the client 510 *using the [preprogrammed] rendering blocks* of the wireless device," *id.* 17:66–18:1. The rendering blocks that were customized thus can be "applicable" to the compiled content via reference to the IDs of the rendering blocks as shown in Figure 4 below.



Ex. 1001 Fig. 4. In this way, "[t]he GUI 108 may then render the page of the application based on the received basic commands and the customized

preprogrammed plurality of rendering blocks." *Id.* 11:3–5.

In sum, Petitioner fails to show that the UI skin is, or could be, applicable to the HTML files, so fails to show that Hariki in view of Harris teaches these limitations.

G. Hariki Does Not Meet Limitation 23a

[23a] a transceiver coupled to a bus and operable to receive a custom configuration that is associated with an application,

Petitioner identifies the "UI content package" as corresponding to a custom configuration and a "web browser" as the application, Pet. 71–72; however, as explained for limitations 1b/12b, the UI content package is not associated with the web browser, *see* Section VI.A beginning on page 20. The UI content package affects the entire device, and Petitioner's speculation that a web browser could use the skin, Pet. 72, like all programs, does not make the configuration "associated" with the browser, in the same manner an "airplane flying away" for a submit button is associated with an aviation application as taught by the Patent-at-Issue, Ex. 1001, 7:66–8:1.

Additionally, Petitioner's statement that "*Hariki's* mobile devices would include a . . . bus," only supported by the fact that some other patent showed a bus connected to an antenna, Pet. 73–74, is insufficient to show this limitation is taught. While non-applied prior art can support a finding of inherency, *Monsanto Tech. LLC v. E.I. DuPont de Nemours & Co.*, 878 F.3d 1336, 1345 (Fed. Cir. 2018), the non-

applied art must show the limitation at issue was *necessarily* present, *PAR Pharm., Inc. v. TWI Pharm., Inc.*, 773 F.3d 1186, 1196 (Fed. Cir. 2014). Because there are non-bus communication architectures, including at least point-to-point, ring, and star, see, e.g., Ex. 2016, at 1 and Ex. 2017, 9:57–62; 22:51–56, just because Goodacre used a bus does not mean Hariki must have done so.

H. Hariki in view of Harris Does Not Meet Limitation 23g

[23g] an engine for reading said compiled content and responsive thereto for causing said graphical user interface to generate said renderable content based on said render commands;

Patent Owner understands Petitioner to map Hariki's API engines to the engine in this limitation as set forth for Claim 2.[10] *See* Pet. 52–55. This theory is flawed.

The Patent-at-Issue and the limitation itself makes it clear that the "engine" recited in the claim is the reader "for reading said compiled content." *See, e.g.*, Fig. 1B (referring to "Engine/Reader" 114). Petitioner identifies the compiled

[10] Petitioner references "claims [1e] and 2," but relies upon argument "discussed in Section VIII.A.1.b" dealing with limitation *1a*. Pet. 76. Then Petitioner says "[t]he only difference between [23g] and [1e] is that [23g] claims an 'engine for reading' in the mobile device," *id.*; but this is objectively false given that 1e is drawn to using a GUI comprising "rendering blocks" and using the "custom configuration," while claim 23g concerns an engine for reading compiled content. Indeed, the Petitioner already mapped limitation 23e that does deal with the GUI to limitation 1e. *Id.* 75.

content as HTML from the server. Pet. 38. Under petitioner's theory, it is *the browser*—that petitioner has already mapped to the application, Pet. 36—that processes HTML as Petitioner admits, Pet. 10–11 (describing how web browser applications "open," "interpret," and "render" HTML documents), not Hariki's engines. While using the same word, Hariki's "engines" fetch resources for applications and process retrieved content based upon type (e.g., the JPG engine is invoked for JPEG files). Ex. 1005 [0043], [0051]. Hariki's engines do not read the Petitioner-identified compiled content, the HTML, as required by the limitation.

And as already explained, Petitioner has put forward no motivation to make Hariki's engines process HTML or explanation how such a combination could work. See Sections VI.D.3 and VI.D.1.

I. The Patent-At-Issue's Dependent Claims Are Non-Obvious

Because Petitioner has not shown a reasonable likelihood that independent claims, 1, 12, and 23, are unpatentable, Petitioner has also failed to meet its burden for any dependent claim. *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.").

VII. THE BOARD SHOULD DENY INSTITUTION UNDER SECTION 314(A)

A. Factor 1: Whether the Court Granted a Stay or Evidence Exists That One May Be Granted if a Proceeding Is Instituted

Neither Party has filed a motion to stay. While this generally makes the factor neutral if the Parties do not submit evidence showing how a district court litigation would rule on such a motion, see *Sand Revolution II, LLC, v. Continental Intermodal Grp.—Trucking LLC*, IPR2019-01393-24, at 7 (PTAB June 16, 2020) (informative), in the parallel litigation, *GoTV Streaming, LLC v. Netflix Inc.*, No. 2:22-cv-07556 (C.D. Cal. filed Oct. 17, 2022), there is strong evidence that the presiding judge, Judge Klausner, will not grant a stay. He has only stayed 1 of 19 such requests, Ex. 2007, at 1, and that one grant was a stipulated stay from 2019, Ex. 2008. But Judge Klausner recently even denied a *stipulated* motion to stay *the day after it was filed* despite the fact the parties indicated the PTAB found "[n]early all of the claims at issue. . . invalid." Ex. 2009; Ex. 2010 ¶6. The District Court's disfavor for stay pending IPRs, pushes this factor in support of discretionary denial.[11]

[11] Patent Owner acknowledges that the Board in many cases counts this factor as neutral despite evidence that a Court will not stay a similarly-timed case, see *VMWare, Inc. v. Intell. Ventures II LLC*, IPR2020-00859-13, at 12 (PTAB Nov. 5, 2020); however, Patent Owner respectfully suggests that the Board should realistically account for a judge's past practices when a party presents such evidence

While Judge Klausner would almost certainly deny a stay request, as explained in Factor 2, trial is set to occur *before* the institution decision, so the Board should simply check whether Petitioner requested a stay and put this factor in the correct column accordingly.[12] *See Apple Inc. v. Maxell, Ltd.*, IPR2020-00200-21, at 4 (PTAB Feb. 3, 2021) (explaining that the Board's consideration of the *Fintiv* factors is not constrained to the facts as they existed when the Petition was filed, and the Board may consider after-arising events).

B. Factor 2: Proximity of the Court's Trial Date to the Board's Projected Statutory Deadline for a Final Written Decision

Petitioner filed this Preliminary Response on August 17, 2023. The statutory deadline for this Panel to issue an institution decision is therefore November 17, 2023, 35 U.S.C. § 314(b), and a final written decision would not issue until around November 17, 2024, 35 U.S.C. § 316(a)(11).

Trial in the parallel district court case is set to occur about two months from this filing, October 17, 2023. Ex. 2006 at 1. Therefore, the district court proceeding should be over before the Panel decides whether to institute. And the trial should be

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and make an informed decision regarding this factor, while moderating the factor's weight given there is some speculation—albeit educated—as to future occurrences.

[12] Given that trial will occur before institution, Petitioner's suggestion that "[u]pon institution of this petition, Petitioners may file a motion to stay the parallel litigation," is more than non-committal, it is an illusory suggestion. Pet. 74.

complete over a year prior to the projected statutory deadline for a final written decision.

The *Fintiv* factors arose in a case where the Board denied institution because a parallel district court proceeding was scheduled to finish before the Board would have reached a final decision. Here, the Panel will not even reach its institution decision prior to trial in the parallel district court case. This factor also weighs heavily against institution. *Ericsson Inc. v. Collision Comms., Inc.*, IPR2022-01233-13, at 13 (PTAB Jan. 19, 2023) ("[T]rial in the . . . district court proceeding appears imminent, which weighs heavily in favor of denying institution.").

Patent Owner is aware that the Director's Interim Procedure[13] allows consideration of the entire district's time-to-trial statistics, at 8–9 & n.12, that Petitioner cites as being 22.9 months;[14] however, the Director also allows consideration of judge-specific data, Director Review, *Vector Flow, Inc. v. HID Global Corp*., IPR2023-00353-11, at 5, 7 (PTAB Aug. 10, 2023). And the better measure of reality, time to trial in patent cases in front of the actual judge hearing the district court case is 15 months on average, with a median of 14 months. Ex. 2011. Nonetheless, even the general statistics puts the trial date in

[13] Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022).

[14] Updated statistics now show 25.8 months. *See* Ex. 2012 at 1.

December 2023 or January 2024, ten or eleven months ahead of the anticipated final written decision in this case, though there have been no schedule slips of key milestones so far that would indicate trial will not occur as currently scheduled.

Ultimately, the Board should simply take judicial notice of the state of affairs when it is making its institution decision, not let abstractions trump reality, and find that this second factor also weighs heavily against institution.

C. Factor 3: Investment in the Parallel Proceeding by the Court and the Parties

For Factor 3, Petitioner again disregards the foreseeable progress in the parallel case, and, instead, focuses on the situation when Petitioner filed its Petition. Pet. 85. Petitioner's assertion that the "court has not yet issued substantive orders relating to the '245 patent," Pet. 85, is no longer true. Regarding patentability, the district court has found that the claims of the Patent-at-Issue are "directed to specific improvements in computer capabilities rather than an abstract idea, thereby satisfying the first step of the *Alice* test." Ex. 2013 at 6–7. Similarly, Petitioner's statement that "expert reports have not been prepared on any issues in the Netflix litigation," Pet. 85, is also out of date. Fact and expert discovery are complete. Ex. 2014, at 1. Petitioner served opening reports on June 13, 2023, Patent Owner served rebuttal reports on June 30, 2023, and invalidity experts have been deposed. Indeed, the time for dispositive motions regarding invalidity, August 2, 2023, has passed. *Id.* And by the time the Board is making its institution decision, the Parties,

district court, and jury will have made even more of an investment by hearing and considering Defendant's invalidity case at trial.

This proceeding cannot serve as "a less-expensive alternative to district court litigation to resolve certain patentability issues" as Congress envisioned, *Patent Quality Assurance, LLC v. VLSI Tech. LLC*, IPR2021-01229-102, at 39 (PTAB Dec. 22, 2022), but will be a *duplicative* one, merely adding cost.

Factor 3 is not a "close call"; it weighs heavily in favor of discretionary denial.

D. Factor 4: Overlap Between Issues Raised in the Petition and in the Parallel Proceeding

There is substantial overlap among the proceedings, because the same prior art references at issue in this proceeding, Hariki and Harris, are also at issue in the district court litigation.[15]

And even though the Petition "challenges claims in addition to those that are challenged in the district court, it is still inefficient to proceed because the district court will resolve the validity of enough overlapping claims to resolve key issues in the petition." *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019-11, at 13 (PTAB Mar. 20, 2020) (precedential). Indeed, Petitioner does not offer any analysis of material differences of the claims at issue in the IPR in relation to the "grounds,

[15] Netflix's provided an expert report asserting claims 1, 4, 5, and 16 of the '245 Patent are rendered obvious over Hariki and Harris. Ex. 2015, at 7.

arguments, and/or evidence . . . presented in the district court." *Google LLC v. Agis Software Dev., LLC*, IPR2020-00873-16, at 13 (PTAB Nov. 25, 2020).

Additionally, while Petitioner has offered a stipulation "that it will not pursue the ground identified in this Petition before the district court," Pet. 86, this is less than a full *Sotera* stipulation that agrees not to raise "any grounds that could have reasonably been raised in the petition," so does not—even in the abstract—mitigate the possibility of duplicative work or the possibility of conflicting decisions required to avoid discretionary denials. *Cf. Sotera Wireless Inc. v. Masimo Corp.*, IPR2020-01019-12, at 13 (PTAB Dec. 1, 2020) (precedential). More importantly, this stipulation does nothing in reality given that the district court trial is scheduled ahead of the Board's institution deadline.

Therefore, Factor 4 militates in favor of discretionary denial.

E. Factor 5: Whether the Petitioner and the Defendant in the Parallel Proceeding Are the Same Party

It is undisputable that "Petitioner and Patent Owner are the same parties as in the district court." Pet. 77. While panels have split regarding where this factor lands in this situation, many find that Factor 5 is not neutral, and "[i]f the petitioner and the defendant in the parallel proceeding are the same, this factor weighs in favor of discretionary denial." *See, e.g.*, *Cisco v. Ramot*, IPR2020-00122-15, at 10 (PTAB May 15, 2020) (Paper 15). This factor too, then, favors discretionary denial.

F. Factor 6: Other Circumstances That Impact the Board's Exercise of Discretion, Including the Merits

While Petitioner proposes that all terms be given broad plain and ordinary meanings in this proceeding in an attempt to show unpatentability, Pet. 18, Netflix has taken inconsistent positions in the related litigation, proposing specific narrow constructions in an attempt to avoid infringement. Ex. 2015, at 4–5. For instance, Petitioner has proposed that "render commands" found in every claim must be an "instruction"—that Petitioner says is a command that causes a device to do something, such as perform an action, *id.* 13–14—yet does not explain how the petitioner-identified HTML are "instructions," merely stating that HTML is a "high-level syntax." *See, e.g.*, Pet. 45–47. This is gamesmanship, *Facebook, Inc. v. Sound View Innovations, LLC*, IPR2017-00998-13, at 17–18 (PTAB Sept. 5, 2017), and, if allowed would foster lack of "uniformity" between the district court and the PTAB that ultimately jeopardizes the overall "integrity of the patent system," *Kiosoft Techs., LLC v. Payrange Inc.*, CBM2020-00026-11, at 16–18 (PTAB Mar. 22, 2021). The Board should not allow Petitioner to silently disavow its previously proposed district court proposal and proceed with the inconsistent and ill-defined plain and ordinary meaning in a stretch to show unpatentability.

Petitioner says that it "raises a compelling, meritorious challenge that the patent owner cannot meaningful [sic] rebut." Pet. 86. "Compelling" is a much higher standard than set forth by statute for institution and means the analysis

"plainly lead[s] to a conclusion that one or more claims are unpatentable." *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064-102, at 49 (PTAB Oct. 4, 2022) (precedential). Patent Owner is not merely relying upon a *Fintiv* procedural challenge but has addressed the merits of Petitioner's arguments. And Patent Owner submits that Petitioner has not even met the normal institution standard whereby there is a "reasonable likelihood" that the challenger would prevail on one or more claims, § 35 U.S.C. § 314(a), much less the "highly likely" compelling standard.

Thus, both the Petition's merits and the potential problems inherent in Petitioner's inconsistent claim construction proposals mean that this is not such an unusual case that every *Fintiv* factor should be ignored to address "compelling" unpatentability, and Factor 6 also weighs heavily in favor of denying institution.

VIII. CONCLUSION

As noted in the second part of this Preliminary Response, an IPR proceeding would not achieve the statutory goal of providing a faster and cheaper alternative to determining unpatentability over the prior art, but would increase the burden of all constituents and conclude long after the parallel litigation ended. Therefore, the Panel should discretionarily decline to institute an IPR trial.

Should the panel choose not to discretionarily deny the Petition based upon the needless duplicity, the Board should still decline to institute on the merits, because Petitioner has failed to meet its threshold showing that there is a reasonable

likelihood that at least one of the claims challenged in the Petition is unpatentable as the references are missing many limitations found in every claim and Petitioner fails to show a POSITA would modify Hariki in view of Harris.

Dated: August 17, 2023

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Per § 42.24(a)–(b) the undersigned certifies that the number of words in the paper, PATENT OWNER'S PRELIMINARY RESPONSE, is:

12,793

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Dated: August 17, 2023

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CERTIFICATE OF SERVICE

The undersigned certifies that on the seventeenth day of August, 2023, a complete and entire copy of the foregoing "PATENT OWNER'S PRELIMINARY RESPONSE," including exhibits, if any, was served on the date below on the following counsel of record shown below via email per Petitioner's consent to electronic service, see Paper 2 at 88:

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