

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

GoTV STREAMING, LLC,
Patent Owner.

IPR2023-00759
Patent 8,103,865 B2

Before RICHARD M. LEOVITZ, BRIAN J. McNAMARA, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

LEOVITZ, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background and Summary*

Netflix, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–20, 31, and 34 of U.S. Patent No. 8,103,865 B2 (Ex. 1001, “the ’865 patent”) on April 20, 2023. Paper 2 (“Pet.”); Paper 5 (filing date accorded). GoTV Streaming, LLC (“Patent Owner”) filed a Preliminary Response. Paper 4 (Patent Owner Mandatory Notices); Paper 7 (“Prelim. Resp.”).

An *inter partes* review may be instituted only if “the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). The following findings of fact and conclusions of law are not final, but are made for the sole purpose of determining whether Petitioner meets the threshold for initiating review. Any final decision shall be based on the full trial record, including any response timely filed by Patent Owner. Any arguments not raised by Patent Owner in a timely filed response may be deemed waived.

For the reasons below, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that at least one of the claims challenged in the petition is unpatentable. *See* 37 C.F.R. § 42.108(c) (2023). Accordingly, we institute an *inter partes* review of the challenged claims on all grounds raised in the Petition.

B. *Real Parties in Interest*

Petitioner identifies the real parties in interest as Netflix, Inc. and Netflix Streaming Services, Inc. Pet. 81. Patent Owner identifies only itself the real party in interest. Paper 4, 2.

C. Related Matters

The parties identify *GoTV Streaming, LLC. v. Netflix Inc.*, Case 2:22-cv-07556 (C.D. Cal., filed Oct. 17, 2022), as a related district court proceeding. Pet. 1, 81–82; Paper 4, 2.

Two related *inter partes* review proceedings are also disclosed: 1) *Netflix, Inc. v. GoTV Streaming, LLC*, IPR2023-00757 (PTAB filed April 7, 2023); and 2) *Netflix, Inc. v. GoTV Streaming, LLC*, IPR2023-00758 (PTAB filed April 7, 2023). Paper 4, 2.

D. The '865 Patent

The '865 patent is titled “Server Method and System for Rendering Content on a Wireless Device.” Ex. 1001, code (54). The patent issued on January 24, 2012. Ex. 1001, code (45). The '865 patent claims priority to U.S. Application No. 11/888,879, filed August 1, 2007. Ex. 1001, codes (21), (22).

E. Challenged Claims

Petitioner challenges the patentability of claims 1–20, 31, and 34. Claims 1 and 12, the challenged independent claims, are reproduced below as annotated by Petitioner with bracketed numbers:

Claim 1 [1pre] A server implemented method for processing data for a wireless device, comprising:

[1a] receiving from the wireless device a request for an application program, said request including an indication of a type of the wireless device;

[1b] executing, in response to receiving said request, said application program to generate a wireless device generic template including a plurality of content items;

[1c] sending a custom configuration to the wireless device, said custom configuration being specific to said application program;

[1d] generating a page description based on said wireless device generic template and a capability of the wireless device,

[1e] said page description having at least one discrete low level rendering command that is within said rendering capability of said wireless device but that is of a syntax that is wireless device generic; and

[1f] sending said page description to the wireless device such that the wireless device is capable of presenting at least one content item from said plurality of content items using both said page description and said custom configuration.

Claim 12 [12pre] A non-transitory processor-readable medium storing code representing instructions to cause a processor to:

[12a] receive a request for an application program from a wireless device, said request including an indication of a type of the wireless device;

[12b] execute said application program to generate a wireless device generic template including a plurality of content items;

[12c] request, using said indication of said type of the wireless device, a device profile from a library of device profiles,

[12d] said device profile providing an indication of a rendering capability of the wireless device;

[12e] eliminate, using said device profile, at least one content item from said plurality of content items from said wireless device generic template to define a device specific template associated with the wireless device,

[12f] said at least one content item being unsupported by the wireless device;

[12g] translate said device specific template into a page description having at least one discrete low level rendering command that is within said rendering capability of the wireless device but that is of a syntax that is wireless device generic; and

[12h] send said page description to the wireless device.

F. Prior Art and Asserted Grounds

Petitioner raises the following grounds of unpatentability with respect to the challenged claims (Pet. 2):

Claims Challenged	35 U.S.C. § ¹	Reference(s)
1–20, 31, 34	103	Hariki, ² Harris ³
1–20, 31, 34	103	Hariki, Harris, Dees ⁴

Petitioner also relies on the Declaration of Benjamin B. Bederson, Ph.D. (Ex. 1002, “Bederson Declaration” or “Bederson Decl.”).

II. ANALYSIS

A. *Legal Standards*

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–1327 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review). Furthermore, Petitioner must explain with particularity how the prior art would have rendered the challenged claims unpatentable. 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.104(b)(4) (“The petition

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102 and 103. We apply the pre-AIA version of 35 U.S.C. § 103 because it appears the claims at issue have an effective filing date prior to March 16, 2013, the effective date of the AIA. *See* Ex. 1001, codes (22), (60).

² Hariki, US 2007/0150617 A1, published Jun. 28, 2007 (Ex. 1005, “Hariki”).

³ Harris et al., US 2003/0023755A1, published Jan. 30, 2003 (Ex. 1006, “Harris”).

⁴ Dees, US 2003/0137539 A1, published Jul. 24, 2003 (Ex. 1007, “Dees”)

must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”).

A claim is unpatentable under 35 U.S.C. § 103 if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when presented, objective indicia relating to obviousness.⁵ See *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements,” but “must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

⁵ The record at this point contains no contentions of objective indicia relating to obviousness.

B. Level of Ordinary Skill in the Art

Petitioner argues:

A person of ordinary skill in the art (“POSITA”) at the time of the earliest available priority date (August 1, 2007) for the ’865 patent would have had a bachelor’s degree in electrical or computer engineering, or a closely related scientific field such as computer science, and two years of work experience with remote page display rendering and/or remote server applications. Alternatively, any lack of work experience could be remedied with additional education (e.g., a Ph.D.) concentrating on multimedia content transmission and/or remote server applications, and likewise, a lack of education can be remedied with additional work experience in multimedia content transmission and/or remote server applications (e.g., 4-5 years). Bederson, ¶38.

Pet. 9–10.

Patent Owner “generally concurs” that a POSITA “would have an electrical/computer engineering degree or a degree in a closely related field.” Prelim. Resp. 19. However, Patent Owner further adds 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.” *Id.* (citing Ex. 1001, 1:13–16).

The statements quoted by Patent Owner from the ’865 patent are in the section titled “Technical Field.” Ex. 1001, 1:13–16. Dr. Bederson defined the prior art as “the *field of technology* to which a patent is related.” Ex. 1002 ¶ 36 (emphasis added). Thus, it is not inconsistent with Dr. Bederson’s definition of the level of ordinary skill in the art to require the work experience to be in the technical field of the ’865 patent.

Patent Owner does not dispute Petitioner’s alternative view that the lack of work experience could be “remedied with additional education” (Pet.

9–10). Prelim. Resp. 19 (“More education may substitute for less experience, and vice versa.”).

For purpose of this Decision, we generally adopt Petitioner’s definition of the level of ordinary skill in the art, but add that the work experience is in the technical field defined in the ’865 patent. Ex. 1001, 1:13–16.

To the extent that there are differences between Petitioner’s and Patent Owner’s descriptions of an ordinary skilled worker, we encourage the parties to address during trial how such differences would impact the patentability analysis.

C. Claim Construction

We construe claim terms “using the same claim construction standard” that district courts use to construe claim terms in civil actions under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b). Under that standard, claim terms “are given their ordinary and customary meaning, which is the meaning the term would have to a person of ordinary skill in the art at the time of the invention.” *Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc.*, 904 F.3d 965, 971 (Fed. Cir. 2018) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc)). The meaning of claim terms may be determined by “look[ing] principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17).

An inventor may rebut the presumption of a term being given its ordinary and customary meaning by providing a definition of the term in the specification “with reasonable clarity, deliberateness, and precision.” *In re*

Paulsen, 30 F.3d 1475, 1480 (Fed. Cir. 1994). In the absence of such a definition, limitations are not to be read from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Petitioner asserts that it “is unaware of any ‘prior claim construction determination’ related to the ’865 patent.” Pet. 10. Petitioner states that it “believes that no express constructions of the claims are necessary to assess whether the prior art reads on the challenged claims.” *Id.* Petitioner, relying on *Phillips*, asserts that “the claims should be given their plain and ordinary meaning,” *Id.*

Patent Owner responds that “Petitioner purports to give all claim terms their plain and ordinary meaning,” but contends that this position is “belied by the fact that Petitioner puts forth constructions for terms throughout the petition,” citing specific examples in which Petitioner is asserted to have defined or explained a claim term. Prelim. Resp. 19–20. Patent Owner states that to the extent necessary, it will address Petitioner’s proposed constructions as they arise. *Id.* at 20.

That Petitioner has implicitly defined and explained terms at various times in the Petition is factually supported by Patent Owner’s citations to the Petition. See Prelim. Resp. 20. Nonetheless, “only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.” *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999); see *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017). Based on the current record, we determine that no claim term requires an explicit construction to decide whether Petitioner satisfies the “reasonable likelihood” standard for instituting trial.

D. Overview of Asserted Prior Art

1. Hariki (Exhibit 1005)

Hariki teaches that “to help users manage their mobile and network devices, various types of customization capabilities have been provided with wireless devices and communication services.” Ex. 1005 ¶ 5. Hariki discloses that mobile phone service and equipment providers may “provide 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.*

In one embodiment of its customization system, Hariki describes a content provider computer, which can be a World-Wide Web (WWW) server, that stores data in the form of web pages and transmits these pages as Hypertext Markup Language (HTML) files over the internet to mobile devices, or other client computers on the network. Ex. 1005 ¶ 21. Hariki explains that the server can execute “a web server process to serve web pages over network 110.” *Id.* Hariki explains that for this embodiment, the mobile device runs a web browser program to access the pages served by server 102.” *Id.*

Hariki teaches that a “customized user interface for a plurality of different makes and types of mobile devices” can be provided by server 102 to a mobile device. Ex. 1005 ¶ 24. The customized user interface is referred to by Hariki as a “UI skin.” *Id.* The UI skin allows 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.* Hariki discloses that “different categories of UI skins can be developed for different types of mobile devices and different makes of mobile devices.” *Id.*

A content provider associated with server 102 “executes a user interface authoring tool 104 that generates a *content package* for each mobile device and downloads the user interface to the appropriate mobile device upon request of the mobile device user.” Ex. 1005 ¶ 25. The server-based UI authoring tool allows content providers to create content packages embodying UI skins. *Id.* ¶ 28. The content package data “is generated from common resource data information [on the server] for each mobile device model.” *Id.* ¶ 29. “The resource files can contain various types of data objects relating to the user interface elements of the mobile devices, such as image files, sound files, screen layouts, icons, movies, and so on.” *Id.* ¶ 31. *See also id.* ¶ 18 (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”). Hariki teaches that the customizable aspects or items of the UI are extracted from the resources. *Id.* ¶ 18. Resource profiles “are defined by device manufacturers for each model of mobile device.” *Id.* Hariki teaches that the resource profiles “specify the composition, format, and appearance of one or more user interface elements displayed or executed by the mobile device.” *Id.*

Hariki discloses that the mobile device “includes a resource API to download UI content package data from a UI content server.” Ex. 1005 ¶ 19. Hariki further discloses that the mobile device “is configured to run one or more application programs 122 or software modules to execute or access the resources provided by the UI content package.” *Id.* ¶ 40. Hariki explains that, through the resource API functionality, “the mobile device is able to change the UI skin of the application 506 by UI content packages that are downloaded from a UI content server. *Id.* ¶ 42. “[T]he resident application 506 is functionally coupled to resource API 508, which contains a number of

functional components,” including engines such as a Flash engine, PNG engine, and JPEG engine. *Id.* ¶ 43. “These engines process the applicable resource using the appropriate playback format depending upon the type of data or program elements in the resource.” *Id.*; *see also id.* ¶ 47.

2. *Harris (Exhibit 1006)*

Harris discloses “a platform that enables a content developer to distribute uniform content to multiple types of requesting mobile devices.” Ex. 1006, (57). “By authoring content in a generic markup language and using the technologies included in the Mobile Content Framework (MCF),” Harris disclose that “the content developer is able to provide content to multiple types devices without providing different versions of the content.” *Id.*

In Harris’s system, an electronic device is interfaced with a network. Ex. 1006 ¶ 15. The electronic device can be a web server. *Id.* ¶ 24 (“process begins when an electronic device, such as a web server”). “The electronic device includes content and the MCF. *Id.* ¶ 15. The MCF includes a number of different components, including WAX (Wireless Abstract XML) and device stylesheet components. *Id.* ¶¶ 7, 11, 22.

Harris’s MCF abstracts content to allow the distribution of uniform content to multiple types of requesting devices. Ex. 1006 ¶ 7. Harris discloses that the MCF includes the generic markup language WAX. *Id.* Harris explains that content “is first translated into WAX from the original language of the content provider, or is created in WAX originally, and then converted into a device appropriate language for a requesting mobile device.” *Id.* Harris explains that the great level of abstraction provided by WAX “enables the subsequent conversion of WAX into the languages used by the requesting mobile devices such as WML, HDML and HTML.” *Id.*

Harris teaches that the mobile device capabilities are kept in a device and capability registry 24 of the MCF. Ex. 1006 ¶¶ 20, 21. Harris further discloses that device and capability registry contains rules used to determine the type of device connecting to the MCF. *Id.* ¶ 21. “Once the type of device is identified, attributes [of the device] such as screen size, color depth, browser version and type, and translation rules become known.” *Id.*

The MCF includes a WAX stylesheet component 42 and a device stylesheets component 44. Ex. 1006 ¶ 22. “The WAX stylesheets component 42 dictates the presentation of the WAX content.” *Id.* The device stylesheets component 40 “tailors the presentation of the content to the requesting device based on the attributes possessed by the requesting device.” *Id.*

Harris explains that its process begins when there is a request from a mobile device, which is accepted by a web server. Ex. 1006 ¶ 24. The web server generates WAX. *Id.* The headers of the request can be examined by the MCF to identify the type of device and stylesheet to use for device-specific translation. *Id.*

E. Ground 1 Based on Hariki and Harris

Petitioner argues that claims 1–20, 31, and 34 are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Hariki and Harris. Pet. 18–42. Claims 1 and 12 are the only independent claims which are challenged. Claim 1 is directed to a server implemented method for processing data for a wireless device. Ex. 1001, 20:42–63. Claim 12 is directed to a non-transitory processor-readable medium storing code representing instructions to cause a processor to carry out steps which overlap with the steps recited in claim 1. *Id.* at 21:36–59.

1. Independent Claim 1

The first ground of unpatentability is based on Hariki and Harris. We summarize Petitioner’s unpatentability evidence for each limitation and, limitation by limitation, address Patent Owner’s arguments.

[1a] *receiving from the wireless device a request for an application program, said request including an indication of a type of the wireless device;*

Petitioner contends limitation [1a] is described by Hariki. Pet. 22. As evidence, Petitioner points to the disclosure in Hariki in which a web browser on mobile device 108 or 109 accesses web pages served by server computer 102. *Id.* (citing Hariki ¶ 21 (“server 102 can executes a web server process to serve web pages over network 110”)). Specifically, Petitioner contends that “POSITAs would have understood that the web browser running on the mobile device sends a request to the web server process, which receives the request, to access the corresponding HTML files” meets the limitation of the claimed “request for an application program.” *Id.* Petitioner cites the Bederson Declaration ¶¶ 114–132 to support its contentions. *Id.* The “web server process” is asserted by Petitioner to be the requested application program. Citing the Bederson Declaration, Petitioner contends that “POSITAs would not have understood a distinction in ‘accessing’ and ‘requesting’ the web server process to receive the HTML files. [Bederson] ¶ 118.” *Id.* at 21. In other words, Petitioner’s position is that the claimed request for an application program is met by the mobile device’s request in Hariki to access a “web server process” to obtain HTML files. The “web server process” is the application.

Limitation [1a] further recites “said request including an indication of a type of the wireless device.” Petitioner cites Hariki’s disclosure that server

102 can generate customized interfaces for different models and types of mobile devices, which Petitioner asserts a person of ordinary skill in the art would have understood to indicate that “the server would have determined what type of mobile device is making the request from the information received from the mobile device.” Pet. 22–23 (citing Hariki ¶¶ 20, 24, 25, 32). To make this determination, Petitioner further states that a POSITA would have understood “the device would have sent its type or other identifying information to identify the type.” *Id.* at 23–24 (citing Bederson ¶¶ 122–123). Petitioner contends that this disclosure from Hariki therefore teaches that the request from the wireless device is “including an indication of a type of the wireless device.” *Id.*

Harris is additionally cited by Petitioner for describing “a detailed process of sending HTML files to a client mobile device where the HTML files are tailored to the particular mobile device” to establish that “the mobile device sends a request to the server that indicated its device type” as required by limitation [1a]. Pet. 24–25 (citing Harris ¶¶ 3, 24; Bederson Decl. ¶¶ 125–127).

Petitioner states that “POSITAs would have been motivated to combine Hariki and Harris because, while each discloses sending content specific to a mobile device, each describes in detail different aspects of the customization” process. Pet. 26 (citing Bederson ¶ 130).

Patent Owner argues that “Hariki also does not disclose receiving from a wireless device a request for a ‘web server.’” Prelim. Resp. 22. Patent Owner states that a request “for” an application does not mean “addresses to,” the process which occurs when the web browser on the mobile device in Hariki *addresses* a request for web pages to the server 102 in Hariki. *Id.* To

support this interpretation, Patent Owner refers to disclosure in the '865 patent where a request is for certain content. *Id.* at 22–23.

On the current record, Petitioner has sufficiently shown that a request for an application program is met by Hariki's disclosure of a request for a web server process to deliver HTML files. Patent Owner's argument that such a request is not a request for an application program is unavailing. Patent Owner does not point to a definition in the Specification that would exclude the request for an application program for being a request to *access* a program on the server. Although the term “for” may have been used in the '865 patent⁶ to mean a request for content (Prelim. Resp. 22–23), we do not narrow claims based on specific embodiments in the Specification. “Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.” *Superguide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). Thus, when the browser in Hariki makes a request to the server for a web page, it is also making a request “for” the “web server process” (the claimed “application program”) because the web server process is the application needed to serve the requested page over the internet to the mobile device.

Patent Owner also argues alternatively that the requested HTML files are not application programs. Prelim. Resp. 21. However, we do not

⁶ “At step 219, the device requests the first page of the application. At step 220, the server 230 sends the requested application content (e.g., the first page of the requested application).” Ex. 1001, 3:11–14; Figure 2A listing step 219 as “Request for first page.”

understand Petitioner to make this argument. Petitioner's argument, as we best understand it, is that the request for the HTML files is a request for the web server process to perform its function as an application that serves files. Pet. 22 (citing Ex. 1005 ¶ 21 (“[S]erver 102 can execute[] a web server process to serve web pages over network 110.”)).

[1b] *executing, in response to receiving said request, said application program to generate a wireless device generic template including a plurality of content items;*

Petitioner contends that Harris in combination with Hariki “discloses” limitation [1b]. Pet. 26. Petitioner asserts that the WAX stylesheet described by Harris is the claimed “wireless device generic template.” *Id.*

Harris discloses, according to Petitioner, WAX (Wireless Abstract XML) stylesheets “which are abstract and not specific to a mobile device (i.e., ‘wireless device generic template’) that include content (i.e., ‘plurality of content items’) tailored by the device stylesheets.” Pet. 28 (citing Ex. 1006 ¶¶ 7, 22; Ex. 1002 ¶ 137). *See supra* pp. 11–12 (summary of Harris). As evidence that WAX is generic, Petitioner cites Harris's disclosure at paragraph 7:

WAX is designed to enable the content developer to describe content at a more abstract level than that used in individual protocols. The greater level of abstraction enables the subsequent conversion of WAX into the languages used by the requesting mobile devices such as WML, HDML and HTML. Typical markup languages focus on how content is rendered on the device, while WAX focuses on generic but smart objects whose transformation is tailored to specific devices.

Ex. 1006 ¶ 7.

In other words, Petitioner's position is that WAX is generic, as required by [1b], and is subsequently converted into device-specific languages.

Petitioner cites the disclosure in Harris that the template generation process begins when a HTTP request is made from a mobile device. *Id.* Petitioner further cites Harris's disclosure that the headers of the HTTP request are examined by the MCF to determine the type of requesting device. Pet. 28 (citing Ex. 1006 ¶ 24). "WAX is then translated 'into a language the requesting device can understand' and customized content is returned to requesting device." *Id.* (citing Ex. 1006 ¶ 24). Because the WAX stylesheets ("wireless device generic template") are generated in response to the HTTP request from the mobile device, Petitioner contends that the claim limitation [1b] is met by Harris's disclosure. *Id.* at 28–29.

Patent Owner argues that the WAX stylesheets are not generated by the web server. Prelim. Resp. 28. "Harris is silent as to when or how the WAX stylesheets are generated." *Id.* (citing Ex. 1006 ¶¶ 22, 24, 25).

Patent Owner also asserts that Petitioner is mistaken that Harris teaches that the template generation process begins when the HTTP request is accepted by the web server from the mobile device. Prelim. Resp. 28. Patent Owner contends that Petitioner has confused a determination of what XSL stylesheet to use with a WAX stylesheet. *Id.* at 28–29. Moreover, Patent Owner asserts that the XSL stylesheet is not generated by the MCF, but it is already in place. *Id.* at 29.

On the current record, Patent Owner's argument is unavailing. Harris discloses Mobile Content Framework 8 (MCF 8) which is shown in Figure 2 of Harris as comprising 16 components. Ex. 1006 ¶ 11, Fig. 2. The MCF 8 is also shown in Figure 1 as located on electronic device 2, the latter which can be a web server. *Id.* ¶ 24. Harris discloses that "the MCF 8 includes a WAX stylesheets component 42." *Id.* ¶ 22; *see also* Ex. 1002 ¶ 135. Thus, even if there is no explicitly worded statement by Harris that the WAX stylesheet is

generated by the MCF, the WAX stylesheet component is expressly shown as being part of the MCF, and thus the MCF necessarily generates the WAX stylesheet. Ex. 1006 ¶ 22, Fig. 2. Petitioner's statement that Harris is "silent" as to how the WAX stylesheets are generated (Prelim. Resp. 28) is inconsistent with Harris's disclosure.

Patent Owner's argument that Harris does not disclose the WAX stylesheet generation begins when the HTTP request is accepted by the web server is also not supported by Harris's disclosure. Harris expressly teaches:

The process by which the illustrative embodiment of the present invention provides customized content to requesting mobile devices is depicted in FIG. 3. *The process begins when an electronic device [2], such as a web server accepts a connection and an HTTP request from a mobile device and the servlet engine directs the request to the appropriate page or servlet destined to generate WAX (step 60).*

Ex. 1006 ¶ 24 (emphasis added).

Harris teaches that "[f]ollowing the beginning of the session, WAX content is generated (step 68)." Ex. 1006 ¶ 24. The WAX stylesheets are used to "dictate[] the presentation of the WAX content." *Id.* ¶ 22. "The MCF exploits the capabilities and accommodates the limitations of different types of wireless devices by converting WAX content to device-specific content." *Id.* ¶ 14. "[T]he device stylesheets component 40 tailors the presentation of the content to the requesting device based on the attributes possessed by the requesting device." *Id.* ¶ 22.

From this disclosure, particularly that WAX content is generated at the beginning of the session, it is clear on the current record that Harris teaches that WAX stylesheets (the "wireless device generic template") are generated in response to the HTTP request from the mobile device because

the WAX stylesheets are necessary to present the WAX content, which is subsequently used to create the device specific content.

There is no confusion in the Petition between the WAX and XSL stylesheets as alleged by Patent Owner. The recited limitation [1b] involves the WAX stylesheets, not the XSL stylesheets.

[1c] *sending a custom configuration to the wireless device, said custom configuration being specific to said application program;*

Hariki teaches that server 102 (Ex. 1005 ¶ 25) can provide a customized user interface (UI) skin⁷ to the mobile device, “such as the format and display of menus, commands, subwindows, and so on.” Ex. 1005 ¶ 26 (cited at Pet. 30). Hariki further discloses “a UI package generator produces a downloadable UI content package consisting of the description file and the converted resource files.” *Id.* ¶ 19 (cited at Pet. 30). Petitioner contends that, based on these disclosures, “POSITAs would have understood that the converted resource files and the description file in Hariki’s UI content package corresponded to ‘custom configuration’ and ‘identification of [the] custom configuration,’ respectively.” Pet. 30 (citing Bederson Decl. ¶ 143).

Petitioner further contends that the “POSITAs would have understood that in the context of accessing a WWW server to receive HTML files, the Hariki-Harris system would have sent the customized UI when executing the web server process.” Pet 30–31 (citing Ex. 1005 ¶ 21 (“[S]erver computer 102 . . . is a content provider server computer that provides content data,

⁷ Ex. 1005 ¶ 5: “The ability to change or customize the colors, fonts, sounds, and functions of the device UI, generally referred to as the ‘UI skin’ can greatly enhance the marketability of a device.”

application programs, diagnostic tools, program components, or any other content or executable objects to the mobile device 108.”)).

With respect to the claimed requirement of the “custom configuration being specific to said application program,” Petitioner contends that, when the web server is accessed, the configurable aspects of the UI, such as changing display image or color, are configured by the converted resources in the UI content package. Pet. 31 (citing Ex. 1005 ¶ 31; Ex. 1002 ¶ 147).

Petitioner concludes:

Hariki discloses a server running a web server process sending converted resource files as part of a UI content package to a mobile device (i.e., “sending a custom configuration to the wireless device”), where the converted resources are specific to an application program on the server (“said custom configuration being specific to said application program”).

Pet. 31 (citing Ex. 1002 ¶ 148).

In response to Petitioner’s contentions, Patent Owner argues that the custom configuration must be specific to the application program, i.e., the web server, but “the web server does not run locally on the wireless devices where the engines are present.” Prelim. Resp. 30. Patent Owner contends that “*Hariki*’s wireless device-resident engines used for *locally* running applications do not process or convert resources for a *remote* web server, and therefore the “custom configuration” is not specific to the “application program” as claimed. *Id.*

On the current record, we are persuaded by Patent Owner’s argument that limitation [1c] is not described by *Hariki* as asserted by Petitioner.

Patent Owner argues on the current record that the UI custom configuration of *Hariki* is not “specific” to the remote web server which executes the “web server process,” the latter which is the “application” of

claim 1. Petitioner’s argument, on the other hand, is that the configuration is specific to the web server process because the configuration is generated when the mobile device accesses the “web server process,” thereby making it specific to the web server process. Pet. 30–31. However, the claim recites that “custom configuration being specific to said application program.”

Petitioner identifies the web server process as the application. The “custom configuration” that Petitioner relies on is the UI skin which is customized, and therefore is “being specific to” the wireless device or application executed on the wireless device. Ex. 1005 ¶¶ 19, 25, 26. Consistently, as explained in the ’865 patent, “[the] custom configuration is specific to the display and audio capabilities of the wireless device and is also specific to the wireless device.” Ex. 1001, 3:22–25. The ’865 patent, in contrast, discloses that generic applications “stored on a remote server” are “appreciated” as not being “device specific.” Ex. 1001, 2:66–3:1. Thus, a custom configuration specific to an application program indicates more than just residing on a web server that generates or sends the configuration to a mobile device which is customized for that device or application executed on it.

In an attempt to establish that Hariki discloses limitation [1c] of claim 1, Petitioner cites Hariki’s disclosure that each resource file on the web server is converted to a format or embodiment that is compatible with an application on the mobile device. Pet. 30 (citing Ex. 1005 ¶ 43). The compatible parameters are “image size, color, position, and so on.” *Id.* (citing Ex. 1005 ¶¶ 146–148). According to Petitioner:

POSITAs would have thus understood that, when the web server process is accessed, the converted resources in the UI content package [the asserted “custom configuration”]

configure the configurable aspects of the UI, by e.g., changing a display image or color.

Pet. 31.

These operations take place when the web server process is accessed. In other words, as we understand Petitioner's arguments, the custom configuration is sent by the web server process and unique to this process having been processed by the web server which executes the web server process. Thus, the "custom configuration" is "specific to" the web server process" because the web server process creates the custom configuration.

This argument is also unavailing. As indicated by Patent Owner (Prelim. Resp. 70), Petitioner's statements are conclusory, particularly the testimony by Dr. Bederson, and do not provide adequate explanation or evidence why one of ordinary skill in the art would have interpreted "being specific to said application program" as being specific to the web server process that creates the custom configuration and serves it over the network to the wireless device. *See, e.g.*, Ex. 1002 ¶ 147.

Although we are not persuaded that Petitioner has established the combination of Hariki and Harris discloses claim limitation [1c], we address the remaining limitations of claim 1 under this ground because Petitioner cites them in its challenge to claim 12 based on Hariki, Harris, and Dees.

[1d] *generating a page description based on said wireless device generic template and a capability of the wireless device,*

To meet limitation [1d], Petitioner cites the disclosure from Harris that "MCF 8 dynamically translates WAX into other markup languages using XML-based technologies." Pet. 32 (citing Ex. 1006 ¶ 18). The "[c]ontent is translated from WAX to languages like WML, HDML and HTML." Ex. 1006 ¶ 18. Petitioner identifies the translated HTML files as a

“page description” which is based on WAX, the “wireless device generic template.” Pet. 32 (“POSITAs would have understood that device specific HTML files are written in a generic syntax but include tags that are ready for rendering” by the wireless device.) (citing Ex. 1002 ¶ 150). Harris further teaches “content is not only translated into a specific language appropriate for the device, but also (unlike traditional XSL stylesheets) is tailored based upon the attributes of the requesting device.” *Id.* ¶ 18. Petitioner further explains that Harris discloses that the WAX files are “translated to be rendered in different ways, specific to the mobile device.” Pet. 32 (citing Ex. 1006 ¶ 30; Ex. 1002 ¶ 152). These disclosures, according to Petitioner, describe limitation [1d] of claim 1.

Patent Owner argues that the limitation [1d] requires HTML files to be “based on said wireless device generic template,” “not the newly identified WAX content or device stylesheet.” Prelim. Resp. 32. Patent Owner contends that “there is nothing in Harris that teaches the “HTML files” are based on the “WAX stylesheets,” the Petitioner-identified “wireless device generic template.” *Id.*

We are not persuaded on the current record that Petitioner fails to provide sufficient evidence that the combination of Hariki and Harris teaches limitation [1d].

Petitioner identifies the page description as the “HTML files.” Pet. 33. Petitioner identifies the WAX stylesheet as the “wireless device generic template.” *Id.* at 28, 29.

As we read Harris’s process, after an HTTP request is accepted by the web server, WAX content is generated for the requested content. Ex. 1006 ¶ 24 (“WAX may also be generated from other sources outside of MCF. . . . As part of the WAX content generation process, interfaces into existing

authentication and authorization systems may be programmed.”). Harris further teaches “[o]nce all the content generation processing is complete, the resulting WAX is fed into the content translation system where the WAX content is translated (step 70).” *Id.* An XSL stylesheet “is used to perform the translation. The customized content is then returned to requesting device.” *Id.*

Harris discloses:

The WAX stylesheets component 42 dictates the presentation of the WAX content, and the device stylesheets component 40 tailors the presentation of the content to the requesting device based on the attributes possessed by the requesting device.

Ex. 1006 ¶ 22.

Thus, the WAX stylesheet is used to generate the WAX content, and the WAX content is translated into device-specific content by the device stylesheet, such as the XSL stylesheet.

The claim requires that the generating a page description is “*based on* said wireless device generic template.” (Emphasis added.) It is true that Harris teaches, as indicated above, that the device stylesheet is used to directly generate the HTML files from the WAX content for presentation to the device. Ex. 1006 ¶¶ 22, 24. But the claim does not require that the page description (the HTML file) is *directly derived* from the use of the wireless device generic template (the WAX stylesheet). The claim recites “based on.” The creation of the page description begins with WAX and thus is “based on” WAX.

Patent Owner, in traversing Petitioner’s evidence that the limitation [d] is described by Harris, does not explain why “based on” in claim 1 must mean that the page description is based *directly* on the wireless generic template. Patent Owner does not provide a definition of “based on” that

would define how it is used to generate the page description. Thus, the disclosure in Harris that the HTML file is generated from WAX content, which itself is generated using the WAX stylesheet, sufficiently discloses that generation of the HTML file is “based on” the WAX stylesheet as asserted by Petitioner.

Patent Owner identifies the disclosure in Harris in which an XSL stylesheet is used for the device-specific translation of the WAX content. Prelim. Resp. 33. However, Patent Owner contends that the use of WAX content and the XSL stylesheet is irrelevant because these items are not the “wireless device generic template.” Pet. 33.

This argument is unavailing on the current record. The “wireless device generic template” is the WAX stylesheet which is used to generate the WAX content. The WAX content is translated into device-specific content using an XSL stylesheet. Pet. 33 (citing Ex. 1006 ¶ 24). Patent Owner, in making its argument, failed to acknowledge the role of the WAX stylesheet in generating the HTML files. The generation of the HTML files is “based on” the WAX stylesheet and XSL stylesheet because both are necessary to produce the HTML files. As discussed above, Patent Owner has not provided a reason, in the present evidence before us, for reading the claim limitation, and specifically the “based on” language, to exclude Harris’s process of translating WAX content into HTML files using the WAX stylesheet.

[1e] said page description having at least one discrete low level rendering command that is within said rendering capability of said wireless device but that is of a syntax that is wireless device generic; and

Petitioner states that Harris’s process describes WAX as being “dynamically translated to a requesting device’s native language” to tailor

the content to the requesting device. Pet. 33 (citing Ex. 1006 ¶¶ 7, 17–19). Petitioner further explains that this process is accomplished by keeping mobile devices and their capabilities in device and capability registry 24. *Id.* (citing Ex. 1006 ¶¶ 19, 21, Fig. 2). The registry, according to Petitioner, provides “‘attributes such as screen size, color depth, browser version and type, and translation rules’ based on device type and application.” *Id.* at 33–34 (citing Ex. 1006 ¶ 21; Ex. 1002 ¶ 156). Based on this disclosure, Petitioner states that the combination of Hariki and Harris “tailors the HTML pages to the specific attributes (i.e., the claimed ‘rendering capabilities’) of the mobile device.” *Id.* at 34 (citing Ex. 1002 ¶ 157).

Petitioner cites the disclosure in the ’865 patent that describes the page description as being written in device generic syntax, but with parameters “tailored based on the wireless device capabilities.” Pet. 35 (citing Ex. 1001, 13:19–22). Petitioner characterizes this disclosure as describing the claimed “render commands.” *Id.* Petitioner also identifies the description in the ’865 patent of syntax and basic commands in the page description. *Id.* at 35–36 (citing Ex. 1001, 13:27–34, 15:59–67). Petitioner contends that the ’865 patent “does not disclose how to distinguish a ‘low level rendering command’ from any other type of rendering command.” *Id.* at 35 n.8. Petitioner states “to the extent that ‘low level rendering command’ is disclosed, the rendering commands in HTML files disclose this feature. Bederson [Ex. 1002], ¶ 158.” *Id.*

Petitioner reproduces an example of WAX language and asserts that the language is device generic and contains commands that are rendered differently in different devices. Pet. 36–37 (citing Ex. 1006 ¶ 30; Ex. 1002 ¶ 161). Petitioner contends that HTML has same syntax in all devices receiving it, and is also device independent. *Id.* at 37 (citing Ex. 1002 ¶ 162).

Petitioner further contends that the POSITA would have understood that “HTLM files include tags that include low level commands to render content on a client device” which are sent to a browser on a mobile device and rendered into pages. Pet. 38 (citing Ex. 1002 ¶¶ 163–165; Ex. 1001, 17:66–18:1).

Based on these disclosures, Petitioner concludes that Harris describes HTML as a page description which meets the limitation [1e] of “having at least one discrete low level rendering command that is within said rendering capability of [the/said] wireless device but that is of a syntax that is wireless device generic.”

Patent Owner contends that Harris does not describe limitation [1e] as alleged by Petitioner, specifically arguing that HTML is not “wireless device generic template.” Prelim. Resp. 35 (“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], so is not ‘device generic.’”).

We first address the recited phrase “syntax that is wireless device generic.” The ’865 patent discloses that while “the wireless device receives the basic commands that are tailored and are specific to the wireless device based on device’s attributes and capabilities,” the “syntax of these commands is device generic.” Ex. 1001, 4:3–6. The ’865 patent explains that the rendering blocks, which perform the rendering of the application content, “operate in a way that is device specific.” *Id.* at 7:27–29. The ’865 patent further explains:

According to one embodiment, the requested application content is received as compiled content that includes a series of basic commands representing a page description. Basic commands are precompiled by the server 230 and ready for

rendering by the client 210. It is appreciated that basic commands are written in a syntax that is device generic regardless of the device type but whose parameters are tailored based on the wireless device capabilities. As such, precompiled basic commands are discrete low level rendering commands tailored based on the rendering capability of the client 210.

Ex. 1001, 13:15–25.

The '865 patent disclose that “the basic commands are low level compilation operable to render objects using the plurality of rendering blocks of the wireless device.” Ex. 1001, 3:61–63.

The graphical user interface of the wireless device uses the received basic commands and the custom configuration to render the received page. Each command is typically associated with an operation to be performed by a rendering block of the wireless device and carries parameters, content, etc., for operation of that rendering block.

Id. at 4:6–12.

Furthermore, the '865 patent explains that the graphical interface “includes a number of individual rendering blocks 108a that perform discrete rendering operations to render a received page description. Ex. 1001, 7:21–23. “The engine/reader 114 passes commands to these rendering blocks to perform the rendering of the application content.” *Id.* at 7:23–25. The '865 patent teaches that “[w]hile the rendering blocks operate in a way that is device specific, they communicate using a device generic syntax.” *Id.* at 7:27–29.

From this disclosure, we understand “syntax that is wireless device generic” to indicate that the rendering commands are “written in a syntax that is device generic regardless of the device type.” *Id.* However, these device generic commands are executed on the wireless device using rendering blocks that operate in a device-specific manner. *Id.* at 7:27–29.

Patent Owner contends that Petitioner incorrectly states that “HTML is a standardized language that has the same syntax no matter what device is receiving it.” Prelim. Resp. 34 (citing Pet. 37). To support this argument, Patent Owner cites the disclosure in Harris that “even when two devices employ the same language, there is no guarantee that they each interpret and render content the same way.” Ex. 1006 ¶ 3.

Patent Owner’s position is not fully supported by its proffered evidence. In the context of the ’865 written description, a command can be “wireless device generic,” but device specific when implemented on a device because of the device’s rendering blocks. *See supra* pp. 28–29. Harris’s statement that devices may interpret and render content differently is consistent with the disclosure in the ’865 patent that basic commands are written in device generic syntax, but the rendering blocks used to render the content are device specific, permitting a command to be executed differently depending on the specific device and its rendering blocks. Thus, two devices can receive the same syntax, but implement the command differently. *See* Prelim. Resp. 35.

Patent Owner further contends that Petitioner is defining the recited “wireless device generic” syntax incorrectly. Prelim. Resp. 34. Patent Owner argues, citing paragraph 18 of Harris, “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].” Prelim. Resp. 35.

This argument does not persuade us that Petitioner fails to provide sufficient evidence on this record to show the description of the recited limitation is taught by the combination of Hariki and Harris.

Harris, as indicated by Patent Owner, discloses that WAX “can be dynamically translated into a requesting device’s native language.” Ex. 1006 ¶ 18. Content can also “tailored based upon the attributes of the requesting device.” *Id.* However, the translation into native or device-specific language (Ex. 1006 ¶¶ 18, 19, 22) does not establish that some of the commands are still device generic, or that the language, itself, is not device specific because it is used by different devices. Paragraph 3 of Harris, cited by Patent Owner, states that “two devices can employ the same language,” indicating that a language may be generic to certain types of devices.

Accordingly, we are not persuaded on the current record, that Patent Owner’s evidence undermines the reasonable likelihood that Petitioner could prevail in showing the obviousness of claim limitation in [1e] view of Hariki and Harris.

[1f] sending said page description to the wireless device such that the wireless device is capable of presenting at least one content item from said plurality of content items using both said page description and said custom configuration.

Petitioner cites Harris’s disclosure of sending customized content in “a language the requesting device can understand” to a “requesting device” as meeting the claim limitation of sending the page description to the wireless device. Pet. 24, 39 (citing Bederson ¶ 168).

Petitioner also turns to the description in Hariki of a mobile device comprising a resource API 508 and a resident application 506. Pet. 40–41. The resource API 508 contains functional components, including a PNG engine and a JPEG engine, to “process the applicable resource using the appropriate playback format depending upon the type of data or program elements in the resource.” Ex. 1005 ¶ 43. Application 506 “uses one or more resources for a UI content package.” *Id.* ¶ 41. Application 506 also “may be

a software program or utility that alters the appearance or functionality of the mobile device, or it may be a program that, when executed, provides a service to the user, or any other functionality.” *Id.* “Through the resource API functionality, the mobile device is able to change the UI skin of the application 506 by UI content packages that are downloaded from a UI content server.” *Id.* ¶ 42. Hariki further teaches “the resident application 506 is functionally coupled to resource API 508.” *Id.* ¶ 43.

Based on these disclosures, Petitioner contends that “POSITAs would have thus understood that Hariki’s resource API and engines use the converted resources in the UI package and HTML file resources and format them into renderable content for the application for display as “the ‘look and feel’ or application program environment of a device.” Pet. 42 (citing Ex. 1005 ¶¶ 24, 47; Ex. 1002 ¶ 173).

Thus, to summarize Petitioner’s argument, Hariki’s resource API and various engines make the wireless device “capable of presenting at least one content item from said plurality of content items” of the wireless device generic template “using both said page description and said custom configuration” as recited in the claim. The page description is the HTML file and the custom configuration is the UI package.

Patent Owner argues that Petitioner identified the WAX template as the page description (citing Pet. 33–37) and that Petitioner is incorrect because no WAX template or WAX is sent to the mobile device. Prelim. Resp. 36.

On the present record before us, this argument is unavailing.

On page 33, lines 1–2, of the Petition, Petitioner states that “generating HTML files” is (“i.e.”) “generating a page description.” Patent Owner cites pages 33–37 for Petitioner’s identification as WAX or WAX

template as a “page description.” Prelim. Resp. 36. However, absent a clear indication where in these pages this asserted identification is made, we rely on Petitioner’s statement on page 33 of the Petition that an HTML file is a page description. Indeed, Patent Owner admits in its Preliminary Response that Petitioner identified the page description as HTML files. Prelim. Resp. 37.⁸

Next, Patent Owner argues that “the wireless device must be capable of presenting at least one image or text delivered by the web server using the UI skin converted resource files.” Prelim. Resp. 37. Patent Owner argues that Hariki’s “engines process content retrieved by an ID for an application, Ex. 1005 [0051] & Fig. 7, not images sent by an application to an engine.” *Id.* at 38.

This argument is unavailing. Hariki describes a customized user interface, referred to as a UI skin, that allows a user to customize the application environment or an application on a mobile device. Ex. 1005 ¶¶ 24, 42. The UI skin is provided to a user over the internet by a server computer. *Id.* ¶¶ 24, 25, 40. The UI skin is provided as a package with resource files. *Id.* ¶¶ 38, 40. “The UI content package contains the UI skin for the target mobile device and contains images or data for the various UI elements, such as image files, movie files, and/or sound files.” *Id.* ¶ 33. The mobile device can run applications which can execute and access “resources provided by the UI content package. The applications can be any program that can playback or perceive the image, video, sound files, etc. of the

⁸ “Petitioner previously identified ‘content items’ as the images and text to be delivered to the requesting devices from the web server, Pet. 27, the ‘page description’ as ‘HTML files,’ *id.* 33, and the ‘custom configuration’ as the ‘converted resource files . . . in Hariki’s UI content package.’”

resources provided by the UI content package.” *Id.* ¶ 40. Hariki further discloses:

the resident application 506 is functionally coupled to resource API 508, which contains a number of functional components such as package selector 510, description file parser 512, an engine selector 520, and one or more engines, such as Flash engine 514, PNG (portable network graphics) engine 516, JPEG (joint photographic experts group) engine 518, and any other similar engines. These engines process the applicable resource using the appropriate playback format depending upon the type of data or program elements in the resource.

Ex. 1005 ¶ 43.

From this disclosure, it is evident that the mobile device uses an engine to present images, movies, etc. from the resources in the UI content package obtained from the server. Patent Owner’s contention therefore that the engines do not process images sent to the engine is not supported by the evidence in the record at this time. The resource ID referenced by Patent Owner is simply used to access the resource, but it is the resource itself (image, etc.) identified by the resource ID which is used by the engine.

Ex. 1005 ¶¶ 50, 51.

Patent Owner contends:

even if Petitioner is correct that an engine could process a web server image, this would not meet the claim limitation because Resource API engines were not the previously identified custom configuration—the UI skin resources were—that must be used to display previously identified content items, the text and images from the web server.

Prelim. Resp. 38.

Patent Owner’s argument is not consistent with the evidence currently before us in this record. As explained above, the UI content package obtained from the web server contains images, etc., which are used by

engines on the mobile device to process and display these images, etc.
Ex. 1005 ¶¶ 24, 25, 33, 38, 40. Relying on this express disclosure in Hariki, Dr. Bederson testifies in his declaration that “*Hariki’s* resource API and engines use the converted resources in the UI package and HTML file resources and format them into renderable content for the application for display as ‘the “look and feel” or application program environment of a device.’” Bederson Decl. ¶ 173. Thus, it is the UI skin resources which contain the images, etc., sent by the server which are processed by the resource API’s engines.

Summary

Although Petitioner provides sufficient evidence that limitations [1a], [1b], and [1d]–[1f] are described or suggested by the combination of Hariki and Harris, Petitioner does not present adequate evidence that limitation [1c] is made obvious by the combination of Hariki and Harris. Accordingly, in view of this deficiency, on the current record, it is not like reasonably likely that Petitioner could prevail in showing the obviousness of claim 1 in view of Hariki and Harris.

Dependent Claims 2–11 and 31

Petitioner asserts that claims 2–11 and 31, which depend from claim 1, are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Hariki and Harris. Pet. 43–57. Claims 2–11 and 31 incorporate all the limitations in claim 1. 35 U.S.C. § 112 ¶ 4 (2006).

Based on the current record and for the reasons discussed above for claim 1, Petitioner has not demonstrated a reasonable likelihood of proving that claims 2–11 and 31 are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Hariki and Harris.

2. *Independent claim 12*

The patentability of independent claim 12 is also challenged on the basis of the combination of Hariki and Harris. We summarize Petitioner’s unpatentability evidence for each limitation and, limitation by limitation, address Patent Owner’s arguments.

[12pre] *A non-transitory processor-readable medium storing code representing instructions to cause a processor to*

Petitioner describes Hariki’s system, including a server that communicates over a network to mobile device. Pet. 58–59. Hariki discloses that its system is “embodied in machine-readable medium.” Ex. 1005 ¶ 59 (cited at Pet. 59). Dr. Bederson testifies, based on this disclosure, that Hariki “discloses a processor-readable medium” as recited in the claim. Bederson Decl. ¶ 217. Patent Owner does not respond to Petitioner’s evidence that the claim preamble of claim 12 is described in the Hariki publication.

[12a] *receive a request for an application program from a wireless device, said request including an indication of a type of the wireless device;*

[12b] *execute said application program to generate a wireless device generic template including a plurality of content items;*

Petitioner states that claim limitations [12a] and [12b] are “substantively identical to” limitations [1a] and [1b] in claim 1. Pet. 60. Patent Owner addressed these limitations in its response to claim 1. We found that Patent Owner’s arguments are unavailing with respect to both limitations. *See supra* pp. 13–19.

[12c] request, using said indication of said type of the wireless device, a device profile from a library of device profiles,

Petitioner contends that the “device and capability registry 24” of Harris’s MCF is an XML file which is consulted to determine device capabilities. Pet. 60–61 (citing Ex. 1006 ¶¶ 21, 24; Ex. 1002 ¶ 222). For example, Harris discloses:

All mobile devices and their capabilities are kept in a device and capability registry 24. The device and capability registry 24 is an XML file, and allows the content developer to group devices together, while also keeping track of the specific features of each device.

Ex. 1006 ¶ 21.

Harris further discloses:

The headers of the HTTP request [from mobile device] are examined by the MCF 8 in order to determine the type of device and a suitable XSL stylesheet to use for later device-specific translation (step 62). An XML registry of devices is consulted to determine device capabilities (screen size, browser version, etc.) (step 64).

Id. ¶ 24.

Petitioner provides sufficient evidence that [12c] is described by Harris. Patent Owner does not respond to Petitioner’s evidence.

[12d] said device profile providing an indication of a rendering capability of the wireless device;

As evidence of limitation [12d] of claim 12, Petitioner references the same disclosures as for limitation [12c] of an XML registry of devices “consulted to determine device capability.” Ex. 1006 ¶ 24 (cited at Pet. 61). We understand the rendering capability to correspond to the “device capabilities (screen size, browser version, etc.)” disclosed in paragraph 24 of Harris. *See* Ex. 1002 ¶ 223; Ex. 1006 ¶ 24. Petitioner’s evidence is sufficient to establish that [12d] is described by Harris. Patent Owner provides no response to Petitioner’s evidence.

[12e] eliminate, using said device profile, at least one content item from said plurality of content items from said wireless device generic template to define a device specific template associated with the wireless device,

Limitation [12e] of claim 12 recites that at least one content item is eliminated from the wireless device generic template (i.e., the WAX stylesheet).

Petitioner cites the disclosure in Harris that in translating WAX to HTML, text may be changed to adjust language or the message. Pet. 62 (citing Ex. 1006 ¶ 30; Ex. 1002 ¶ 224).

Patent Owner argues:

nothing gets eliminated from the WAX content, much less from the WAX stylesheet petitioner previously identified as the template. When the MCF processes the WAX, regardless of the produced translation, the WAX content stays the same. For example, the WAX tag with “id=’welcome’” is still present in the WAX file regardless of the HTML produced.

Prelim. Resp. 40–41.

We are not persuaded by this argument that Petitioner has not sufficiently shown limitation [12e] of claim 12 is described by Harris.

Harris discloses that “MCF 8 uses its own brand of markup language known as Wireless Abstract XML (WAX) with which to describe content.” Ex. 1006 ¶ 16. “The WAX stylesheets component 42 dictates the presentation of the WAX content.” *Id.* ¶ 22. In paragraph 30 referenced by Petitioner, Harris explains:

The text “logo” is used to index into a set of rules to determine the best image to display for the specific device. For example, the framework may determine that “logo.gif” is the best image for the given device or possibly that “logo-nok7100.wbmp” is the best image.

Thus, the Mobile Content Framework 8 (“the framework”), which includes the WAX stylesheets component 42, selects images and text (e.g., image selection component 32, text selection component 36). Ex. 1006 ¶ 22. The WAX stylesheets component dictates how the WAX content, including the images and text, is presented. *Id.* The WAX stylesheet, generated by component 42, comprises the images and texts from components 32 and 36, or links to these items, to generate the WAX content.

Patent Owner’s argument that the tag “wax:text id=’welcome’” is still present in the WAX stylesheet fails to adequately address Petitioner’s argument, based on paragraphs 9 and 30 of Harris, that the “welcome” is changed to “Bonjour” for French speakers or to “Welcome to Our Site, please take a look around!” *See* Ex. 1006 ¶ 29 showing samples of WAX. In other words, the WAX stylesheet is changed by eliminating the “welcome” and replacing it with “Bonjour” or “Welcome to Our Site, please take a look around!” Patent Owner does not explain how the content would remain the same when the term “welcome” has been changed. Thus, on the current record, Petitioner has provided sufficient evidence that the [12e] is described in Harris.

[12f] said at least one content item being unsupported by the wireless device;

Petitioner contends that Harris discloses “discloses removing, not converting, or reducing in length content items in WAX stylesheets based on a specific mobile device’s capability such as small display size stored in registry of devices.” Pet. 63. Petitioner argues, citing Bederson Declaration ¶¶ 226–227, “POSITAs would have understood that content on WAX stylesheets can be removed (i.e., eliminate all other terms except ‘welcome’), when a small screen size is not capable of displaying the entire text (i.e., ‘please take a look around’).” Pet. 63.⁹ Patent Owner does not provide a response to this evidence which we find sufficient to support the obviousness of the claim limitation.

[12g] translate said device specific template into a page description having at least one discrete low level rendering command that is within said rendering capability of the wireless device but that is of a syntax that is wireless device generic; and

Limitation [12g] recites the same language in limitation [1e] of “page description having at least one discrete low level rendering command that is within said rendering capability of said wireless device but that is of a syntax that is wireless device generic.” We have considered Patent Owner’s argument for limitation [1e], but found it unpersuasive when the evidence on the current record is considered in its entirety. *See supra* pp. 26–30.

⁹ Ex. 1006 ¶ 30 (“‘Welcome to Our Site, please take a look around’ for wireless devices, having a larger display. Example 4 shows how Java code may be inserted directly into the WAX.”)

[12h] *send said page description to the wireless device.*

Limitation [12h] recites the same language as limitation [1f] of “send said page description to the wireless device.” We addressed Patent Owner’s these arguments for limitation [1f] and found them unpersuasive. *See supra* p. 30.

Summary

Petitioner provides sufficient evidence that it is reasonably likely that Petitioner could prevail in showing the obviousness of claim 12 in view of Hariki and Harris.

Dependent Claims 13–20 and 34

Petitioner asserts that claims 13–20 and 34, which depend from claim 12, are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Hariki and Harris. Pet. 64–66. Patent Owner’s Preliminary Response does not separately address these dependent claims.

Based on the evidence in the present record, we are persuaded that Petitioner has shown sufficiently for purposes of this Decision that the combination of Hariki and Harris teaches or suggests all of the limitations recited in claims 13–20 and 34.

F. Ground 2 Based on Hariki, Harris, and Dees

Petitioner argues that claims 1–20, 31, and 34 are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Hariki, Harris, and Dees. Pet. 66–77. Petitioner refers to the challenge based on Hariki and Harris for claims 1–4, 8–20, 31, and 34. We thus refer back to the discussion of these claims under Ground 1 and our explanation as to why Patent Owner’s arguments are unavailing.

For claims 5–7 and 16–18, Petitioner additionally cites Dees. *Id.* at 67–75.

Patent Owner states, in response, that because Petitioner has not shown that claims 1 and 12 are obvious, Petitioner failed to meet its burden to show a reasonable likelihood that that any of the narrower claims that depend from claims 1 and 12 are likely unpatentable. Prelim. Resp. 41.

Based on the evidence in the present record, we are persuaded that Petitioner has shown sufficiently for purposes of this Decision that the combination of Hariki, Harris, and Dees teaches or suggests all of the limitations recited in claims 5–7 and 16–18.

CONCLUSION

We determine that Petitioner establishes a reasonable likelihood that it would prevail in showing that at least one of the challenged claims 1–20, 31, and 34 of the ’865 patent is unpatentable. Hence, we institute an *inter partes* review of all challenged claims on all challenges included in the Petition. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018) (noting that the language of 35 U.S.C. § 314(b) “indicates a binary choice—either institute review or don’t”); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (interpreting the statute as requiring “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”). At this juncture in the proceeding, we have not made a final determination with respect to the patentability of the challenged claims, or with respect to claim construction.

III. ORDER

It is

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–20, 31, and 34 of the '865 patent is instituted commencing on the entry date of this Decision; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of trial. The trial will commence on the entry date of this Decision and proceed in accordance with a separately entered Scheduling Order.

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