

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. LEBOVITZ, BRIAN J. McNAMARA, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining No Challenged Claims Unpatentable
35 U.S.C. § 318(a)

Denying in Part and Dismissing in Part Patent Owner's Motion to
Exclude Evidence
37 C.F.R. § 42.64

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.”).

We determined that the Petition established a reasonable likelihood that Petitioner would prevail with respect to at least one claim, and we instituted an *inter partes* review as to all challenged claims of the ’865 patent and all grounds of unpatentability asserted in the Petition. Paper 9 (“Institution Dec.”).

Following institution of the trial, Patent Owner filed a Response. (Paper 18, “PO Resp.”). Petitioner filed a Reply (Paper 22, “Pet. Reply”). Patent Owner responded by filing a Sur-reply (Paper 23, “PO Sur-reply”).

An oral hearing was conducted on August 6, 2024 by video. A transcript of the hearing is part of the record. Paper 32 (“Hearing Tr.”).

Petitioner objected to evidence filed by Patent Owner (Paper 19) and subsequently filed a Motion to Exclude (Paper 27). Patent Owner filed an opposition to Petitioner’s motion (Paper 28). Petitioner filed a reply to Patent Owner’s opposition (Paper 29). As discussed below, we grant in part and dismiss in part Petitioner’s Motion to Exclude.

We have jurisdiction under 35 U.S.C. § 6. This decision is a Final Written Decision issued pursuant to 35 U.S.C. § 318(a). For the reasons discussed below, we determine that Petitioner has not proven by a

preponderance of the evidence that any of claims 1–20, 31, and 34 of the ’865 patent are unpatentable.

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, GoTV Streaming, LLC, as 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. Netflix’s Motion for Summary Judgment of invalidity as to the ’865 patent was granted for indefiniteness under 35 U.S.C. § 112. Ex. 2006.

The District Court’s ruling on indefiniteness does not interfere with the Board’s decision in this proceeding because we find that Petitioner’s challenge is insufficient for reasons relating to a different limitation. *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801, 813 (Fed. Cir. 2021). “For example, the indefiniteness of one limitation may not preclude the Board from rejecting a challenge by finding that another limitation is missing” from the asserted art or combinations. *Id.*

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 convention 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).

The '865 patent issued after the Examiner found that a patent publication by Ho (U.S. Pat. No. 7,636,792 B1) did not anticipate the claims and after Applicant overcame rejections made by the Examiner under 35 U.S.C § 112 (Applicant arguments dated Dec. 21, 2010 and Aug. 8, 2011 in Serial No. 11/888,799, which led to the '865 Patent). The Examiner did not state the reasons for allowance (Notice of Allowance in Serial No. 11/888,799, dated Sept. 7, 2011).

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	References
1–20, 31, 34	103(a)	Hariki, ² Harris ³
1–20, 31, 34	103(a)	Hariki, Harris, Dees ⁴

Petitioner provides a Declaration of Benjamin B. Bederson, Ph.D. (Ex. 1002). Patent Owner provides a Declaration of Stuart Lipoff (Ex. 2005). Deposition testimony of Dr. Bederson (Ex. 2014) and Mr. Lipoff (Ex. 1033) was also provided.

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

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”).

Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review). Furthermore, Petitioner must explain with particularity how the prior art would have rendered the challenged claims unpatentable. 35 U.S.C. § 312(a)(3) (2018); 37 C.F.R. § 42.104(b)(4) (2024) (“The petition 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(a) 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

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

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).

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.” PO Resp. 22. 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 identified the “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). PO Resp. 22 (“More education may substitute for less experience, and *vice versa*.”). Patent Owner adds that “[t]o the extent that there is a difference between ‘Petitioner’s and Patent Owner’s descriptions of an ordinary skilled [artisan],’ *see* Inst. Dec. 8, Patent Owner does not believe such differences impact the patentability analysis.” PO Resp. 22.

For purpose of this Final 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.

C. Overview of the ’865 Patent

The ’865 patent discloses that “a need has arisen to enable software vendors to provide generic applications regardless of the wireless device type, thereby relieving software vendors from having to tailor their applications for each given wireless device type.” Ex. 1001, 2:21–24. The ’865 patent also identifies a need “to not only relieve software vendors from tailoring their applications for a given wireless device type but to provide an output that is device specific based on the wireless device attributes where the output is generated from a generic application.” *Id.* at 2:25–29.

The ’865 patent describes a process in which a wireless device, in communication with a server, requests an application by sending a message to the server. Ex. 1001, 3:2–6. The message can include “information

identifying the wireless device type and its capability.” *Id.* In response to the message from the wireless device, the server accesses a library of applications to obtain the requested application. *Id.* at 3:7–11. The server “may identify a custom configuration to be used for the requested application and the device type.” *Id.* at 3:12–14. The custom configuration “provides the ‘look and feel’ of the content of the requested application.” *Id.* at 3:15–17. “The custom configuration is specific to the display and audio capabilities of the wireless device and is also specific to the wireless device.” *Id.* at 3:22–25. “The custom configuration customizes the look and feel of the content displayed on the wireless device from execution of the requested application.” *Id.* at 18:41–43.

When the executed application produces dynamic pages, a template engine of the server produces template screens of the requested application, which the ’865 patent describes as being “a high level generic template or page description.” Ex. 1001, 3:3143. For example, the template can be in extensible markup language (XML) format. *Id.* at 3:39–40. The generic template contains dynamic data. *Id.* at 17:4–9, 18–27; 19:44–45.

The ’865 patent explains that the server “tailors the template based on the device profile and device capability.” Ex. 1001, 3:53–55. The patent discloses that a template engine is coupled to a library of device profiles. *Id.* at 17:28–31. The library of device profiles may include information on device capabilities. *Id.* The server determines the device capabilities by accessing the device profiles. *Id.* at 17:33–37. “As a result, the template engine 550 may eliminate content from its dynamic template output that is not supported by the client 510.” *Id.* at 17:38–40.

The server “translates the template . . . into a series of basic commands based on the device profile and device capabilities.” Ex. 1001, 3:56–59. The basic commands “are written in a device independent syntax but tailored based on the wireless device capability” and considered to be “low level compilation operable to render objects using the plurality of rendering blocks of the wireless device.” *Id.* at 3:59–63. The device independent syntax can be written in XML. *Id.* at 17:6–7.

In more detail, the ’865 patent describes the template or page description as including basic commands, including, for example, “basic command 410” which is “a description for rendering an image” or “basic command 430 [which] may be the description for rendering a video clip.” *Id.* at 15:62–64.

[T]he specific commands based on the client’s capability are written in a syntax that is device generic regardless of the wireless device type. However, the parameters of the basic commands are tailored based on the wireless device capabilities. The basic commands are then transmitted to the client 510 for rendering. In one embodiment, the basic commands are the compiled page description 400.
Ex. 1001, 13:8–15.

The ’865 patent explains that the requested application content is sent to the wireless device and “received as compiled content that includes a series of basic commands representing a page description.” Ex. 1001, 13:11–18.

Figure 7 of the ’865 patent provides an overview of the process:

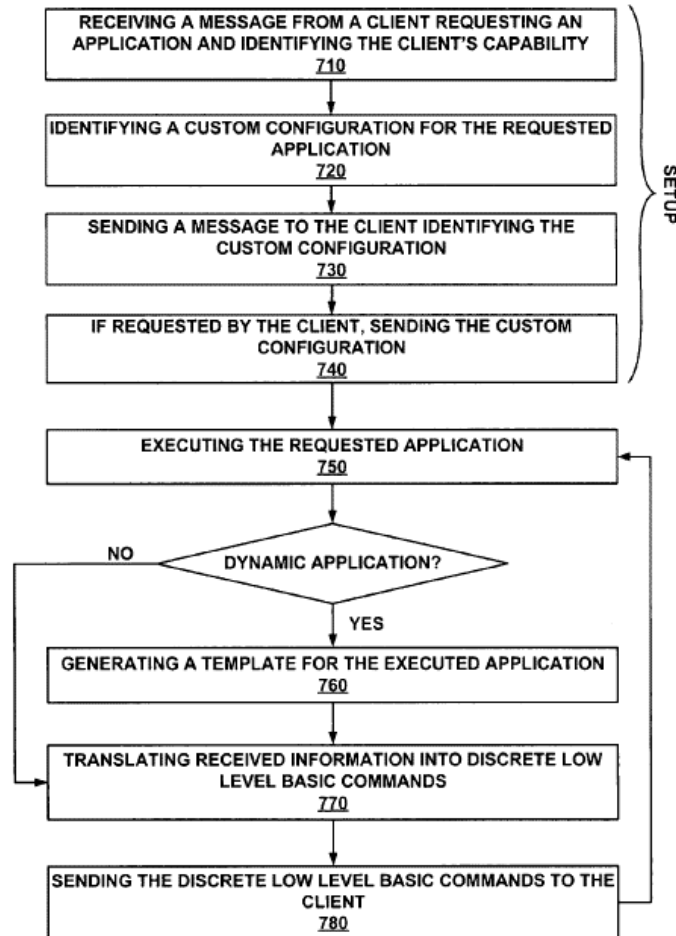


Figure 7, reproduced above, “shows an exemplary computer controlled flow diagram of a server implemented method for processing data for a wireless device.” Ex. 1001, 4:50–52. A message is received by the server from a client requesting an application (710). The message also identifies the client’s capability (710). The server identifies the custom configuration for the requested application (720), sends a message to the client identifying the custom configuration (730), and if the client does not have it, the server sends the custom configuration to the client (740). The application is executed by the server, and when the application is dynamic, it generates a generic template (760) and translates or compiles it into basic commands which serve as the page description (770). *See* Ex. 1001, 13:14–

17 (“the requested application content is received as compiled content that includes a series of basic commands representing a page description.”). The page description comprising the basic commands is sent to the client (780). *See* Ex. 1001, 19:21–20:2 for a complete description of Fig. 7.

D. 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).

As indicated by Patent Owner, the District Court construed the following claim terms: “rendering command,” “discrete low level rendering command,” and “rendering blocks.” Ex. 2006, 3, 10. None of these terms is in dispute in this proceeding. We therefore do not need to address any of these terms for this proceeding because they are not “necessary to resolve the controversy.” *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999); *see* PO Resp. 23.

In addition to the terms construed directly below, we address the meaning of the phrase “syntax that is wireless device generic” recited in limitation [1e] in section F. below under the heading of Claim 1, limitation [1e].

“custom configuration being specific to said application program”

Petitioner contends that the limitation 1[c] and 34[a] of “sending a custom configuration to the wireless device, said custom configuration being specific to said application program” should be given its plain and ordinary meaning. Pet. Reply 2. Because Petitioner is responding to Patent Owner’s Response, we begin with Patent’s Owner interpretation of the claim limitation.

Although Patent Owner acknowledges that the ’865 patent does not explicitly define “specific to said application program” (PO Reply 23), Patent Owner cites the disclosure that contrasts “generic” with “specific”:

According to an embodiment of the present invention, the remote server executes a generic application. It is generic in that it is not specific to any device or any set of device capabilities. The server will eventually translate the output of the application to a device specific set of commands for transmission to the device 110 for rendering.

Ex. 1001, 6:10–15.

Mr. Lipoff testifies that from this teaching one of ordinary skill in the art “would understand that ‘specific to’ concerns a particular device and its capabilities.” Ex. 2005 ¶ 101.

In this context, the ’865 patent discloses:

Embodiments of the present invention relieve software vendors from tailoring their applications based on each wireless device type because the server tailors the output of a generic application based on the wireless device capability.

Ex. 1001, 5:54–58.

Based on these disclosures, Patent Owner contends that “specific to” as recited in the claim “refer[s] to the application/template being created with a particular device in mind, for example, crafting the application/template so that it is in accord with a particular device’s capabilities.” PO Resp. 24 (citing Ex. 2005 ¶ 102). Patent Owner also uses the synonyms “made for” and “tailored to” for “specific to.” *Id.* at 24–26 (*see* Ex. 1001, 5:54–58; Ex. 2005 ¶¶ 103–104).

In response, Petitioner contends that “sending a custom configuration to the wireless device, said custom configuration being specific to said application program” as recited in limitations 1[c] and 34[a] should be given “its plain and ordinary meaning.” Pet. Reply 2. Petitioner contends that the “custom configuration should support rendering of the claimed page description on the wireless device, and this is expressed best in the inventors’ own terms” as recited in the limitation. *Id.* Petitioner, citing the ’865 patent, further contends that “the custom configuration is ‘specific to’ the application by supporting the rendering operations on a wireless device called for by the application on the server.” *Id.* at 3 (Ex. 1001, 12:17–43; 3:22–25). Petitioner argues that “the custom configuration must be specific

to the server application in that it supports rendering of the page description based on the wireless device capabilities.” *Id.*

Petitioner argues that “none of PO’s citations justify limiting ‘specific to’ the application to ‘created for or tailored to’ the application.” Pet. Reply 3. Petitioner argues that the Federal Circuit in *Los Angeles Biomedical v. Eli Lilly & Co.*, 849 F.3d 1049 (Fed. Cir. 2017), “has rejected narrow claim construction of a term when the PO failed to sufficiently set out the narrower meaning in the specification.” *Id.* Petitioner states:

Here, the phrase “created for” is not used in the ’865 *patent* specification, and there is no evidence of a clear intent to limit the claim term to “tailored to,” particularly as PO applies that proposed construction. Therefore, as in *Los Angeles Biomedical*, PO’s narrow proposed construction should be rejected in favor of plain and ordinary meaning.

Pet. Reply 4.

We are not persuaded by Patent Owner’s proposed claim construction that the phrase “specific for” limits the custom configuration to a configuration “made for” the application program.

We begin with the guiding principles which govern claim interpretation. As held in *Phillips*, 415 F.3d at 1315:

The claims, of course, do not stand alone. Rather, they are part of “a fully integrated written instrument,” [*Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996)], 52 F.3d at 978, consisting principally of a specification that concludes with the claims. For that reason, claims “must be read in view of the specification, of which they are a part.” *Id.* at 979. As we stated in [*Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996)] the specification “is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.” 90 F.3d at 1582.

We thus first turn to the Specification of the '865 patent. The '865 patent discloses, in its background section, that “each application must be tailored in accordance with the wireless device attributes to fully utilize the capabilities of the wireless device.” Ex. 1001, 1:40–43. The '865 patent discloses that “the increase in the number of applications, the types of wireless devices and the need to tailor each application to a given wireless device type has increased the cost of developing applications.” *Id.* at 1:47–50. The '865 patent identifies a need “to not only relieve software vendors from tailoring their applications for a given wireless device type but to provide an output that is device specific based on the wireless device attributes where the output is generated from a generic application.” *Id.* at 2:25–29. The '865 patent describes fulfilling this need with a “custom configuration” that “may be used to customize the appearance of content generated by a requested application rendered on the rendering blocks” of the wireless device. *Id.* at 2:54–57.

It is further disclosed in the '865 patent that the “engine/reader of the wireless device receives the basic commands that are tailored and are specific to the wireless device based on device’s attributes and capabilities.” Ex. 1001, 4:3–5. “The graphical user interface of the wireless device uses the received basic commands and the custom configuration to render the received page.” *Id.* at 4:6–9. “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 4:9–12. “[T]he custom configuration is used to customize the ‘look and feel’ of the requested application (e.g., background color). The engine/reader may receive messages and content from the server.” *Id.* at 4:13–15.

The '865 patent further discloses that the decoding system of the server may “access a library of custom configuration data 540, where each application may have a *corresponding* custom configuration data to customize the appearance of the application.” Ex. 1001, 16:51–55 (emphasis added). *See also id.* at 11:59–61 (“In response to the message 212, the server 230 identifies the requested application and its corresponding custom configuration to be used by the client 210.”).

The “custom configuration” is asserted in the '865 patent to address the problem of having to tailor each application to a specific device. See Ex. 1001, 2: 20–65. It accomplishes this goal by using the custom configuration on the wireless device via the device rendering blocks to take the output from the application and adapt it or customize it for display on the wireless device. *Id.* at. 2:53–65.

The phrase “specific to” is not disclosed in the '865 patent’s description of “custom configuration,” but the Patent teaches that each application has a custom configuration that is “corresponding” to the application. Ex. 1001, 16:51–55; 11:59–61. We understand from these disclosures that “corresponding” to the application means the “custom configuration” makes the application program “device specific.” *Id.* at 2:25–29. In this light, we construe “custom configuration being specific to said application program” to mean that the custom configuration has the ability to customize or tailor the application program’s appearance to the capabilities of a specific device, e.g., using rendering blocks. The custom configuration makes the application program content “device specific” by providing “the ‘look and feel’ of the content of the requested application.” See Ex. 1001, 3:15–17.

Our construction is consistent with construction by the District Court of California in Case No. 2:22-cv-07556. Ex. 2006. In this litigation, the court construed “custom configuration” to mean “a configuration that determines the look and feel of the application.” *Id.* at 8.

In reaching our claim constructions, we emphasize that we do not agree with Patent Owner that “specific to” refers to the “application/template being *created* with a particular device in mind, for example, crafting the application/template so that it is in accord with a particular device’s capabilities.” PO Resp. 24 (emphasis added) (citing Ex. 1001, 3:29–30). The ’865 patent does not disclose how the custom configurations are made, or if they are made with only one device in mind. Rather, the ’865 patent discloses “a library of custom configuration data 540, where each application may have a corresponding custom configuration data to customize the appearance of the application.” Ex. 1001, 16:51–54. Thus, we reject Patent Owner’s contentions that “specific to” means that the custom configuration was “made for” or “created” for the recited application program.

Patent Owner’s expert Mr. Lipoff testifies:

Turning to the meaning of “specific to” as understood in the relevant field concerning distributed applications, a POSITA would recognize that something specific to an application is “application-specific.” POSITAs understand that “application-specific” when discussing software means “created or written for a specific application.” Ex. 2011. Therefore, the common understanding of “specific to said application,” triangulates with the specification and claims to again point a POSITA to understand “specific to” to mean “created for,” “written for,” “tailored to,” etc.

Ex. 2005 ¶ 106.

Mr. Lipoff does not cite disclosure from the '865 patent to support his opinion. Instead, Mr. Lipoff cites to Exhibit 2011, an entry from “Wiktionary,” which defines “application-specific” as asserted by Mr. Lipoff. But the term in the '865 patent is “specific to said application program,” different from the hyphenated term relied on by Mr. Lipoff. Furthermore, the definition is from Wiktionary. Mr. Lipoff did not establish that this definition was available on the effective filing date of the application and therefore a definition known at this time to the ordinarily skilled artisan. *See Phillips*, 415 F.3d at 1312–13. Nor did Mr. Lipoff sufficiently explain why this definition is probative of how an ordinarily skilled artisan would interpret the claims of the '865 Patent in view of the disclosure on which the claims are based.

Petitioner’s argument that the recited custom configuration is specific for the application because it is specific “to the server application in that it supports rendering of the page description based on the wireless device capabilities” (Pet. Reply 3) is not persuasive.

The custom configuration is stored on the server. Ex. 1001, 16:52–53. The server sends the customized configuration to the client device. *Id.* at 16:54–61. The rendering of the page description takes place on the wireless device (*see* Ex. 1001, Fig. 6 (“RENDERING THE RENDERABLE CONTENT ON THE WIRELESS DEVICE”); 1:14–17, 2:49–50 (“low level basic commands that layout content, position, etc. for rendering application content on the wireless device.”)). In sum, the server identifies a custom configuration that *corresponds* to the application and sends it to the wireless device where it is used to render the application. The custom configuration does not modify the web server process or adapt the web server process in

any way. The custom configuration is selected from a library and sent to the device in the same way that any custom configuration is sent to a wireless device. The process of selection and sending is generic, not specific to the web server process.

“eliminate”

Petitioner contends that the term “eliminate” recited in limitation 12[e] should be given its plain and ordinary meaning. Pet. Reply 5. We agree with Petitioner. We also agree with Petitioner that “claim construction is not necessary here because the scope of ‘eliminate’ is clear from the specification and the words of the claims, and the term should not be improperly or unnecessarily limited.” *Id.* at 7.

Patent Owner clarifies that, in its opinion, the meaning of “eliminate” is “remove.” PO Sur-reply 6. We also agree with Patent Owner that this is the plain meaning of “eliminate.” Petitioner does not provide a different meaning.

Petitioner asserts that in the Institution Decision, “a narrow construction of ‘eliminate’” was rejected when the Decision “disagreed with the PO’s interpretation that a first content [is] not eliminated when it is replaced by a second content.” Pet. Reply 6. The analysis cited by Petitioner was not a claim construction, but merely a response to Patent Owner’s preliminary arguments. Institution Dec. 39.

E. 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 a 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 a server 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.* ¶ 19 (the resources comprise “files, links to files, and/or data or program objects associated with the configurable aspect[s] 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.* 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 further discloses that the “profile selector 205 selects a resource profile 204 depending upon the device model selected by the content provider” and then the “resource 202 for that model is then converted by resource converter 206” to form a converted resource. *Id.* ¶ 32.

Hariki discloses that the mobile device “includes a resource API [application programming interface] to download UI content package data

[containing converted resources] 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 discloses that “the content developer is able to provide content to multiple types [of] 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, Fig. 1. The MCF includes a

number of different components, including WAX (Wireless Abstract XML) and device stylesheet components. *Id.* ¶¶ 7, 11, 22, Fig. 2.

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 greater 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 explains that its process begins when there is an HTTP request from a mobile device, which is accepted by a web server. Ex. 1006 ¶ 24. "The headers of the HTTP request 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)." *Id.* The registry is consulted to determine the device capabilities, e.g., screen size, browser version, etc. *Id.* A session is begun and the WAX content is generated.⁶ *Id.* The "resulting WAX is fed into the content translation system where the WAX content is translated" into a language that the requesting device can understand. *Id.* "The WAX stream is examined in order to substitute the most appropriate image with regards to the device, and user preferences." *Id.* Harris discloses that "WAX is translated into a language the requesting device can

⁶ "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." Ex. 1006 ¶ 7.

understand.” *Id.* See Harris’s Fig. 3 for a flow chart beginning with a request from a wireless device for a page to the content returned to the device.

Harris teaches that the mobile device’s 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, Fig. 2. “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.*

F. Ground 1 Based on Hariki and Harris

Petitioner argues that claims 1–20, 31, and 34 are unpatentable under 35 U.S.C. § 103(a) 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.

As explained in more detail below, the Petition relies on Harris for the claimed “generic template” and “page description” and Hariki for disclosing the claimed “application program” and “custom configuration.”

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, Ex. 1002 ¶¶ 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. [Ex. 1002] ¶ 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.

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 Ex. 1002 ¶¶ 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, 24⁷; Ex. 1002 ¶¶ 125–127).

Petitioner states that "POSITAs would have been motivated to combine Hariki and Harris because, while each discloses sending content

⁷ "The headers of the HTTP request are examined by the MCF 8 [on the web server] in order to determine the type of device and a suitable XSL stylesheet to use for later device-specific translation (step 62)." Ex. 1006 ¶ 24.

specific to a mobile device, each describes in detail different aspects of the customization” process. Pet. 26 (citing Ex. 1002 ¶ 130).

Patent Owner does not dispute Petitioner’s contentions that limitation [1a] is described by the combination of Hariki and Harris, which we find to be supported by a preponderance of the evidence.

[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 id.* at 21–23 (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.

The claim limitation further requires that the generic template is generated in response to the request for the application program. To meet this limitation, Petitioner begins with 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 (the claimed "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.

Consistently, 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 session is initiated by the HTTP request. 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 that Harris teaches that WAX stylesheets (the claimed “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.

Patent Owner does not dispute Petitioner’s contentions that limitation [1b] is described by Harris, which we find to be supported by a preponderance of the evidence.

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

Limitation [1c] requires sending a custom configuration to the wireless device where “said custom configuration being specific to said application program.” As discussed in more detail below, the Petition identified the “custom configuration” as the user interface (UI) skin of Hariki and the “program” as the web server process, also of Hariki.

Hariki teaches that server 102 (Ex. 1005 ¶ 25) provides a customized user interface (UI) skin⁸ 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 that “a UI package generator produces a

⁸ 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.”

downloadable UI content package consisting of the description file and the converted resource files.” *Id.* ¶ 19 (cited at Pet. 30). Petitioner contends that the UI content package “includes a converted resource such as a Flash, PNG, or JPEG object used by engines that ‘process the applicable resource using the appropriate playback format,’ such as the Flash engine for an applet or JPEG engine for a photograph.” Pet. 30 (citing Ex. 1005 ¶ 43). The engines are resident on the mobile device. Ex. 1005, Fig. 5, showing mobile handset 502 comprising various engines. 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” of the wireless device. Pet. 30 (citing Ex. 1002 ¶ 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 [to the wireless device] 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, 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:

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).

Patent Owner acknowledges Petitioner’s contention that the claimed “custom configuration” is Hariki’s UI skin comprising converted resource files⁹ and description files. PO Resp. 29. Patent Owner contends that the “converted resource files” in Hariki’s skin are not “specific to” to the web server (the claimed “application program”) because they are for the mobile device and executed on the mobile device. *Id.* at 30 (citing Ex. 1005 ¶¶ 19, 25). Mr. Lipoff describes the process of creating “resource files” for the mobile device using a resource profile defined by manufacturers for each mobile device. Ex. 2005 ¶ 126. Mr. Lipoff concludes from this disclosure that the “UI skin does not take into account any web server during its construction and ultimately is not used or usable by a web server as it is written and created for applications running on mobile devices.” *Id.*

The Petition describes Hariki’s “server computer 102” which sends HTML files over the Internet to mobile devices. Pet. 30–31. Petitioner, citing Dr. Bederson’s testimony (Ex. 1002 ¶ 145), asserts that “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. 31. Petitioner further asserts that POSITAs would have understood that Hariki discloses “said custom configuration being specific to said application program” because “when the web server process is accessed, the converted resources

⁹ “The resources provided by the common resource database are converted to the formats dictated by the resource profiles and a UI package generator produces a downloadable UI content package consisting of the description file and the converted resource files.” Ex. 1005 ¶ 19.

in the UI content package configure the configurable aspects of the UI, by e.g., changing a display image or color.” *Id.* (citing Ex. 1002 ¶¶ 147, 148).

In response, Patent Owner argues that Petitioner does not explain “why merely sending a custom configuration that is not affected by the sending application, and will not be used by the sending application, makes the custom configuration ‘specific to’ the sender.” PO Resp. 32. Patent Owner contends that the custom configuration is not specific to the web server process because it is created for the wireless mobile device without regard for the server that provides the UI skin to the wireless device. *Id.* Patent Owner also asserts that Dr. Bederson’s testimony is conclusory and “generally entitled to little or no weight.” *Id.*

Patent Owner further argues that the claim limitation “is not met from a server’s ‘generation’ of a custom configuration for a mobile device, or a server’s ‘sending’ of a custom configuration to be used by a mobile device” because “wherever generated and wherever sent from” it is not written for and specific to the HTML web server which Petitioner identifies as the claimed application. PO Resp. 33.

Citing Petitioner’s assertion that the custom configuration is specific to the web server application because “when the web server process is accessed, the converted resources in the UI content package configure the configurable aspects of the UI, by e.g., changing a display image or color,” Patent Owner argues that there is no support in Dr. Bederson’s declaration for this conclusion. PO Resp. 33 (citing Ex. 1002 ¶ 147).

In response, Petitioner contends that “sending a custom configuration to the wireless device, said custom configuration being specific to said application program” as recited in step [c] of claim 1 and claim 34 should be

given “its plain and ordinary meaning.” Pet. Reply 2. Petitioner contends that the “custom configuration should support rendering of the claimed page description on the wireless device, and this is expressed best in the inventors’ own terms” as recited in the limitation. *Id.* Petitioner, citing the ’865 patent, further contends that “the custom configuration is ‘specific to’ the application by supporting the rendering operations on a wireless device called for by the application on the server.” *Id.* at 3 (Ex. 1001 12:17-43; 3:22-25). Petitioner argues that “the custom configuration must be specific to the server application in that it supports rendering of the page description based on the wireless device capabilities.” *Id.*

Petitioner further explains that “UI packages are specific to the content that is served by the web server and do not just happen to reside on a common server.” Pet. Reply 8. Petitioner contends the “pairing between the UI packages and the application content is a shared objective of the ’865 patent and *Hariki*.” *Id.* at 8–9. “In other words, the UI content packages are tailored to (i.e., PO’s construction of ‘specific to’) the web server content to align with the content provider’s objective in *Hariki*.” *Id.* at 9. *See also* Pet. 31 (“POSITAs would have thus understood that, when the web server process is accessed, the converted resources in the UI content package configure the configurable aspects of the UI, by e.g., changing a display image or color. *Bederson*, ¶147. Accordingly, *Hariki* discloses ‘said custom configuration being specific to said application program.’ *Id.*, ¶147.”).

Petitioner further argues that it is “a matter of common sense that the UI packages would have to be specific to the application content because only then can the content be displayed in a certain way on a wireless device, as intended by *Hariki*.” Pet. Reply 10. Petitioner connects this to the “web

server application” by stating that the “the UI skins would be used in combination with the server-produced HTML content to customize the HTML for rendering on a client.” *Id.* “Therefore, the UI content package is specific to the web server application and renders content that is related to the application and the server is not ‘merely sending a custom configuration that is not affected by the sending application’ as incorrectly argued by PO. *POR*, 32.” *Id.*

We are not persuaded by these arguments that the claim limitation [1c] is described by the combination of Hariki and Harris.

As explained in the Claim Construction section, the limitation that the “custom configuration being specific to said application program” means that the custom configuration has the ability to customize or tailor the application program’s appearance and “look and feel” to the capabilities of a specific device. *See supra* at 14–21. As explained below, this requirement is not satisfied by the disclosure in Hariki cited by Petitioner.

The custom configuration described by Hariki is the user interface, i.e., the UI skin, that “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.” Ex. 1005 ¶ 24.

The UI skin is provided by the server to a mobile wireless device. Hariki explains that the server, which delivers content to a user, has “a UI package generator [that] produces a downloadable UI content package consisting of the description file and the converted resource files.” Ex. 1005 ¶¶ 19, 24.

The UI authoring system allows content providers to create content packages embodying UI skins for distribution and

downloading to mobile devices on the network. The content package for each UI skin contains information specific to the type of device, manufacturer of the device, operating system, application programs, and other relevant information regarding the mobile device.

Ex. 1005 ¶ 28.

The content from the server is adapted to the specific wireless device by the UI skin. Neither the content nor the UI skin is adapted to the web server process (the claimed “application program”) because the web server process provides them in a generic manner to the wireless device. Ex. 1005 ¶ 21. There is no customization to the web server process. The same web server process, using the same routine, delivers a UI specific to the wireless device in the same way regardless of the UI content. *Id.* ¶ 28. Petitioner’s contention of the alleged pairing between UI packages and content (Pet. Reply 8–9) does not establish that there is specificity to the web server process that provides these items to the wireless device. It is true that the UI authoring tool is based on the server. Ex. 1005 ¶ 28. But the description of that tool by Hariki does not invoke the web server process in which the UI is provided to the mobile device. *See id.* ¶¶ 28–37.

We are not persuaded by Petitioner’s argument that it would be common sense to have the UI package specific to the web server “because only then can the content be displayed in a certain way on a wireless device, as intended by Hariki.” Pet. Reply 10. Petitioner’s argument does not establish that being specific to the web server application makes the appearance of the content also specific to the wireless device. The content is made specific to the wireless device by the custom configuration created using the server-based UI authoring tool. Ex. 1005 ¶ 28. Petitioner has not provided evidence that the process in which the UI package is sent by the

web server process to the mobile device is specific to the web server process or different in any way depending on the UI content package.

Dr. Bederson testifies in his declaration that “[b]ecause the converted resources in the UI content package are generated and sent when the mobile device access[es] the web server process, it is my opinion that *Hariki* discloses ‘said custom configuration being specific to said application program.’” Ex. 1002 ¶ 147. Dr. Bederson appears to be interpreting “specific to” to mean that the UI is generated upon the “specific” request by the user’s wireless device to access the web server process. We do not agree.

Dr. Bederson does not identify the disclosure in *Hariki* where the UI skin is generated when server access is requested. *See id.* Petitioner has the burden to explain with particularity how the prior art would have rendered the challenged claims unpatentable.

Hariki’s discussion of the server-based UI authoring tool discloses that “content providers . . . create content packages embodying UI skins for distribution and downloading to mobile devices on the network.” Ex. 1005 ¶ 28. Citing Fig. 4, *Hariki* discusses that “a method of generating and downloading UI skins . . . begins in step 401 with selection and retrieval of the appropriate resource profile for the device from the resource profiles 204.” Ex. 1005 ¶ 36. *Hariki* describes how the UI skin is generated and packaged. *Id.* Fig. 4, a flow chart of the steps, concludes “DOWNLOAD UI CONTENT PACKAGE WITH CONVERTED FILES TO MOBILE DEVICE UPON REQUEST.” We understand this request to be made by the user for the UI content package. *Id.* ¶ 25 (“server computer 102 is operated by a content provider, and 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”). In sum, Hariki does not indicate the UI skin is generated when a request is made for an application. But rather it is generated and then provided upon request by a user to the user’s mobile wireless device.

Second, Dr. Bederson is defining “specific to” inconsistently with the disclosure in the Specification of the ’865 patent which describes “specific to” as indicating the custom configuration’s ability to customize or tailor the application program’s appearance to the capabilities of a specific device. *See* Ex. 1001, 2:25–29, 11:59–61, 16:51–59 (as discussed in “C. Claim Construction.”). The plain language of the claim reflects this interpretation: “said custom configuration being specific to said application program.”

Hariki explains that “resources” are maintained by a content provider. Ex. 1005 ¶ 31. 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.* “The 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.* ¶ 32. “The package generator 214 takes the resource and description and creates a UI content package 216.” *Id.* ¶ 33. The UI package is downloaded to the target mobile device. *Id.* ¶ 36. Bederson does not explain how these steps make any change to the web process server or are specific to it.

For the reasons discussed above, Petitioner has not met the burden of demonstrating by a preponderance of the evidence that limitation [1c] is described or suggested by Hariki.

[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 the claimed “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). In Harris, the “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.* (emphasis omitted) (citing Ex. 1006 ¶ 18). Petitioner further explains that Harris discloses that the WAX files are “translated to be rendered in different ways, specific to the mobile device.” *Id.* (citing Ex. 1006 ¶ 30; Ex. 1002 ¶ 152). These disclosures, according to Petitioner, describe limitation [1d] of claim 1.

WAX content is generated for the requested content after an HTTP request is accepted by the web server. Ex. 1006 ¶ 24. Harris teaches that “[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)” into a language understood by the wireless device. *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.) Harris teaches, as described above, that the device stylesheet is used to directly generate the HTML files (the “page description”) 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. In other words, the disclosure in Harris that the HTML file is generated from WAX content, which itself is generated using the WAX stylesheet, sufficiently teaches that generation of the HTML file is “based on” the WAX stylesheet.

Patent Owner does not dispute Petitioner’s contentions that limitation [1d] is described by the combination of Hariki and Harris, which we find to be supported by a preponderance of the evidence.

[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).

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 discloses 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.

In sum, we construe “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.” Ex. 1001, 7:27–29. These device-generic commands are executed on the wireless device using rendering blocks that operate in a device-specific manner. *Id.*

Consistently, 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 ¶¶ 29–30; Ex. 1002 ¶ 161¹⁰). Petitioner contends that HTML has the 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 “HTML 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

¹⁰ “For example, Harris explains that commands such ‘<wax:button>’ [shown in WAX in paragraph 29] are rendered differently in different devices, and text may be displayed in different languages. Harris, ¶ 30.”

capability of said wireless device but that is of a syntax that is wireless device generic.”

Patent Owner does not dispute Petitioner’s contentions that limitation [1e] is described or suggested by the combination of Hariki and Harris, which we find to be supported by a preponderance of the evidence.

[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 Ex. 1002 ¶ 168). More specifically, Petitioner contends that Harris’s “detailed process of sending HTML files to a client mobile device where the HTML files are tailored to the particular mobile device” corresponds the claim limitation of a wireless device capable of presenting a content item from the page description (the HTML file of Harris). Pet. 24 (citing Ex. 1002 ¶ 125).

For using a content item of the custom configuration, Petitioner turns to the description in Hariki of a mobile device comprising a resource API 508 and a resident application 506. Pet. 40–41. 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.

With regard to the limitation of presenting content (such as an image or text), Petitioner cites (Pet. 42) Hariki’s UI content package that “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.” Ex. 1005 ¶ 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 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.

The mobile device uses an engine to present images, movies, etc. from the resources in the UI content package and HTML files obtained from the server. Ex. 1005 ¶¶ 21 (“The content provider computer 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 110”), 24 (“server computer 102 is operated by a content provider that can generate a customized user interface for a plurality of different makes and types of mobile devices”).

Consistently, 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.’” Ex. 1002 ¶ 173 (citing Ex. 1005 ¶ 24). 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.

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 HTML file is the claimed page description, and the UI package is the claimed custom configuration.

Patent Owner does not dispute Petitioner’s contentions that limitation [1f] is described or suggested by the combination of *Hariki* and *Harris*, which we find to be supported by a preponderance of the evidence.

(i) *Reason to combine*

Petitioner contends that “POSITAs would have understood that the methods disclosed by Harris were compatible with and could be adapted and applied to Hariki because Harris’ platform is of the same general architecture as Hariki’s client-server system.” Pet. 24–25 (citing Ex. 1002 ¶ 126).

To the extent that Hariki is not relied upon for the limitation that the mobile device sends a request to the server that indicated its device type, Petitioner contends that the ordinarily skilled artisan would have been motivated to combine Hariki’s client-server system with Harris’s teachings directed to serving HTML pages tailored to a particular mobile device because “POSITAs would have been motivated to find ways of generating and sending information from applications such as a web server process customized to a particular mobile device and looked to *Harris*.” Pet. 25 (citing Ex. 1002 ¶ 127).

Petitioner contends that the ordinarily skilled artisan “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.” Pet. 26.

Patent Owner does not identify any defects in this reasoning.

(ii) *Summary*

For the reasons given above, we determine that Petitioner has not met the burden of demonstrating by a preponderance of the evidence that claim 1 is unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Hariki and Harris.

(iii) *Dependent Claims 3–7, 9–11, and 31*

Petitioner asserts that claims 3–7, 9–11, 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. 44–58. Claims 3–7, 9–11, and 31 incorporate all the limitations in claim 1. 35 U.S.C. § 112 ¶ 4 (2006). Thus, Petitioner fails to show, by a preponderance of that evidence, that claims 3–7, 9–11, and 31 would have been obvious over Harris and Hariki. *See 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.”).

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. Ex. 1002 ¶ 217.

[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.

We found that Petitioner established by a preponderance of the evidence that the combination of Hariki and Harris describes or makes obvious both limitations [1a] and [1b].

[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 “a profile from a library of device profiles” 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.

Patent Owner does not dispute Petitioner’s contentions that limitation [12c] is described by the combination of Hariki and Harris, which we find to be supported by a preponderance of the 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 claimed “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.

Patent Owner does not dispute Petitioner’s contentions that limitation [12d] is described by the combination of Hariki and Harris, which we find to be supported by a preponderance of the 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. Hariki in combination with Harris is cited as disclosing this limitation. Pet. 61. Petitioner specifically cites the disclosure in Harris in which tags are added and removed from the WAX language as making the claim limitation obvious. *Id.*

We begin by addressing Harris’s disclosure to give background to Petitioner’s contentions regarding claim limitation [12e].

Harris discloses that content from an electronic device is requested by a mobile device. Ex. 1006 ¶ 24. The mobile device can be “cellular phones, PDAs, cable TV or satellite TV set-top boxes, and other similar devices with limited resources including stationary devices (i.e.: a wired set-top box).” *Id.* ¶ 15. The electronic device can be a server. *Id.* ¶ 24. The electronic device in

Harris includes Mobile Content Framework 8 (“MCF”). *Id.* ¶ 20. The MCF includes WAX style sheet component 42. *Id.* ¶ 22. WAX is Wireless Abstract XML, which is a high level markup language. *Id.* ¶ 16. “The WAX stylesheets component 42 dictates the presentation of the WAX content.” *Id.* ¶ 22. Petitioner identifies the WAX stylesheet as the claimed wireless device generic template. Pet. 29. The content is authored in WAX and “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.” Ex. 1006 ¶ 18.

Harris explains (citing Fig. 3):

The headers of the HTTP request 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). . . . Following the beginning of the session, WAX content is generated (step 68). . . Once 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). Dynamic Image and Text Processing is performed (step 72) along with XSL processing (step 74). The WAX stream is examined in order to substitute the most appropriate image with regards to the device, and user preferences. User preferences may include interface choices, key mappings, key behavior, functionality, the amount of information to be rendered, language and location. WAX is translated into a language the requesting device can understand. . . The customized content is then returned to requesting device (Step 76).

Id. ¶ 24.

For the “eliminate” aspect of limitation [12e], the Petition refers to the subsequent disclosure in Harris that tags “can be added and removed from the WAX language.” Pet. 61 (citing Ex. 1006 ¶ 26). Petitioner also cites

Harris’s disclosure of translating the “id” [identifier] of “welcome” in WAX to “Bonjour” for users who specify French as their preferred language, or to “Welcome to our site, please take a look around” for a wireless device that has a larger display. Ex. 1006 ¶ 30. Petitioner’s expert, Dr. Bederson, after summarizing this description in Harris, testifies:

It is my opinion that [] content on WAX stylesheets can be removed, not converted to a language, or reduced in length to eliminate portions of the content (corresponding to the claimed “eliminate, using said device profile, at least one content item”) based on a specific mobile device’s capability such as small display size stored in registry of devices.

Ex. 1002 ¶ 224.

In response, Patent Owner contends that the claim limitation requires *removing* a content item “using said device profile.” PO Resp. 35 (emphasis added). Patent Owner explains that “[a] device profile ‘includes information about the specific wireless device capabilities.’ Ex. 1006, 17:28–31.” *Id.* To illustrate, Patent Owner reproduces the WAX Stylesheet referred to in the Petition:

```
<?xml version=" 1. 0" encoding="utf-8"?>
<wax:wax xmlns:wax="http://www.kargo.com/wax" version="O.9">
  <wax:doc version="1.0">
    <wax:title>NY Nightlife</wax:title>
    <wax:block id="splash">
      <!--EXAMPLE 1 -->
      <wax : button href="index?a=rnain"
keytype="accept" type="go" labelid="enter" />
      <wax:p align="center">
        <!--EXAMPLE 2 -->
        <wax: img srcid="logo" alt="My Nightlife"
border="O" />
```

-continued

```
        <wax:br/>
    <!--EXAMPLE 3 -->
    <wax: text id="welcome" />
    <!--EXAMPLE 4 -->
    <% if ((String)session.getAttribute("lang") ==
        null)
    out .println ("<wax:a
    href=\ "index?a=chlang\ ">Choose
    Language</wax:a>");
    %>
    <wax:br/>
    <wax:br/>
    </wax:p>
    </wax:block>
    </wax:doc>
</wax:wax>
```

Ex. 1006 ¶ 29

Patent Owner argues that simply removing tags from the WAX language does not meet the claim limitation. PO Resp. 39.

Patent Owner's expert, Mr. Lipoff, identifies the following as tags in the WAX sample: "<wax:title>," "<wax:block>," "<wax:button>," "<wax:img>," and "<wax:text>." Ex. 2005 ¶ 148. Mr. Lipoff states that the claim limitation "requires elimination from the specific generic template generated in limitation 12[b]," but Harris "only discusses that the WAX tags may generally change, without instructing that a particular content item used in a Petitioner-identified generated template be eliminated." *Id.* ¶ 149. Mr. Lipoff further states that Harris "only gives examples of adding tags to prospectively support 'new types of devices.'" *Id.* (citing Ex. 1006 ¶ 28).

According to Mr. Lipoff, Harris's asserted removal of tags is not using the device profile, i.e., the "XML registry of devices" of Harris. Ex. 2005 ¶ 150 (*see* Pet. 61 (heading "e.")). Mr. Lipoff explains that "removal of a tag 'from the WAX language' would not convert a particular WAX Stylesheet into a 'device specific template associated with the wireless device,' because such a global change to the WAX language is again not based upon any one device profile." *Id.*

Patent Owner contends, with respect to Harris's Example 3 of the WAX Stylesheet copied above, that the element is not removed or eliminated, but it is "modified . . . after filtering." PO Resp. 43. Patent Owner asserts that the "filtered WAX is then translated to HTML, in this case, and '[t]he customized content is then returned to [the] requesting device.' Ex. 1006 [0024]." PO Resp. 44. Patent Owner explains:

For instance, the WAX "logo content item" becomes the WAX filtered "logo content item" that then becomes the HTML "logo content item." The "logo content item" is not removed. Similarly, the WAX "welcome content item" becomes the WAX filtered "welcome content item" that then becomes the HTML "welcome content item." The "welcome content item" is not removed.

PO Resp. 45.

Patent Owner also argues that altering a content item, e.g., hello to bonjour, is not eliminating the content item, but is creating a content item which was "one theoretic possible content item that could exist." PO Resp. 46.

In response, Petitioner asserts that Patent Owner "speculates" that Harris "might disclose an alteration as opposed to elimination," but citing paragraph 30 of Harris, contends that Harris "discloses that displayed text or images are selectively eliminated or included in a WAX template to make it

specific to a device’s capability.” Pet. Reply 12. Petitioner states this is “particularly important because the claim limitation requires only that a content item be eliminated from a generic template to make the template specific to a device’s capability.” *Id.* Petitioner further asserts that “Harris discloses that content can be added and removed from the WAX stylesheet. Bederson Dep., 93:7-15, 94:8-14; Harris, ¶30.” *Id.*

We begin first by adopting the definition of “eliminate” suggested by Patent Owner, to “remove.” *See supra* p. 21 (“Claim Construction”). This definition is consistent with the ’865 patent which discloses eliminating content (Ex. 1001, 3:44–48, 17:3–48) and the plain and ordinary meaning of the term. PO Resp. 27.

There are two disclosures in Harris asserted to meet claim limitation [12e]: 1) the addition and removal of tags; and 2) altering the content in the WAX stylesheet.

The cited disclosure about tag addition and removal is reproduced below:

The content developer can configure and add to the framework in a number of areas. Tags can be added and removed from the WAX language. A new tag can be a composite of existing tags, or it can represent an entirely new idea. Content filters can be inserted to add new functionality, or address special characteristics of new types of devices (special character encodings, scripting languages, etc.). As new devices become available, the content developer can freely add these new devices to the registry, as well as rules to recognize those devices.

Ex. 1006 ¶ 28

The tags are described by Harris as “being attached to content” and to “operate at a higher level of abstraction than prior standard wireless markup languages.” *Id.* ¶ 18. “Once a WAX stream has been generated, it is fed into

the translation engine. The stream of WAX enters into a set of filters that alter many of the ‘logical’ tags into ‘physical’ tags.” *Id.* ¶ 34.

The disclosure in Harris of tags, attached to content and that can be “removed,” meets the limitation of “eliminate . . . at least one content item” from the generic template because removing a tag would remove the content item because the tag is associated with the content. Patent Owner’s expert, Mr. Lipoff, attempts to denigrate this disclosure by arguing that Harris only teaches that the tags “generally change” and that Harris only gives examples of adding tags. Ex. 2005 ¶ 149. We do not find this argument persuasive because Harris explicitly discloses that a tag can be “removed.” Ex. 1006 ¶ 28. A specific working example is not needed in view of this explicit disclosure. “[A] reference is not limited to the disclosure of specific working examples.” *In re Mills*, 470 F.2d 649, 651 (CCPA 1972); *see also In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991) (“Patents [and publications] are part of the literature of the art and are relevant for all they contain.”).

Patent Owner further argues that the removal of the tags does not use the device profile as required by the claim. PO Resp. 40, 46. Petitioner responds “that content is selected for inclusion in a specific WAX stylesheet based on a device’s capability.” Pet. Reply 12. Petitioner cites paragraph 32 of Harris to support its argument. *Id.* at 12–13. We reproduce the relevant part of paragraph 32 below, and parts of the following paragraph 33 as well:

The MCF 8 moves the decision as to which image or text element to display out of WAX, and into resource registries. The framework uses the registries to decide what is the best content to deliver to a device at any given time. The process of dynamically deciding what content to deliver is known as “Dynamic Item Selection”, and is used for both image and text selection.

Ex. 1006 ¶ 32.

WAX is marked up with “logical” image and text identifiers. The processor looks up the “logical” identifier in the appropriate image or text registry, and processes rules to determine which is the best “physical” item. The WAX stream is filtered on the fly to represent the “physical” item. Rules can be placed into the registry to deliver content based on many different variables such as the actual type of device, a device’s group (devices can be placed into many different groups, such as “big browser” or “color browser”, or “PDA”), and the user’s preferred language (for serving different language pages without having to modify the page content).

Ex. 1006 ¶ 33.

As explained above, WAX is marked up with “logical” identifier/images. Harris explains that the device registry (“the XML registry of devices”; *see* Ex. 1006 ¶ 24) determines what to use as the “physical” image representation of the “logical” image in WAX. This decision is based on rules in the XML registry of device. Ex. 1006 ¶ 33 (“Rules can be placed into the registry to deliver content based on many different variables”). The claim requires “eliminate, using said device profile, at least one content item from said plurality of content items.” But in Harris, as described in paragraphs 24, 32, and 33, the device profile in the XML registry is used to determine what physical image to display based on the logical image in WAX. Harris discloses that tags are added or removed from WAX (*id.* ¶ 28), but this modification to WAX occurs before WAX is filtered “on the fly” to present the logical item as a physical item. Ex. 1006 ¶ 33 (*see* text copied above). The tags are added and removed by the “content provider” to alter the “WAX language.” Ex. 1006 ¶ 28. Mr. Lipoff’s testimony is consistent with this disclosure, indicating that filtering comes after modification of WAX. Ex. 2005 ¶ 144. That is, the WAX language is modified and then it is translated using the XML registry of devices. Thus, the cited disclosure from

Harris does not support Petitioner's contention that the claim limitation is described by Harris. The device profile is not being used to eliminate or remove tags; this step occurs before the device profile is consulted.

Petitioner does not adequately explain how the steps in Harris of removing/adding tags is "using said device profile."

The second issue to address is the disclosure in Harris's paragraph 30 of whether altering the content in the WAX stylesheet meets limitation [12e].

Paragraph 30 contains the following disclosure:

Examples 2 and 3 illustrate WAX's Dynamic Item Processing feature [the examples are from the WAX stylesheet reproduced above]. In Example 1 [sic, Example 2] the text "logo" is placed into the srcid attribute [see WAX language reproduced above from paragraph 29] instead of the URL to the actual image. 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. WAX itself does not determine the "physical image" to display, only the "logical" image. Example 3 illustrates the same principal [sic, principle], but with text. The id "welcome" [see WAX language reproduced above from paragraph 29] may be translated to "Bonjour" for users who specify French as their preferred language or possibly "Welcome to our site, please take a look around" for wireless devices, having a larger display.

As explained above, Example 2 has "logo" under the image id of the WAX language. The "logo" is used by the MCF to dynamically select the physical image file, such as "logo.gif," to display on the device. In this example, nothing is being eliminated from WAX which serves as the "wireless device template." The template stays the same. The MCF (the "framework") processes the abstract identifier, using the device profile, to

determine the physical logo to display. Ex. 1006 ¶ 32 (“The MCF 8 moves the decision as to which image or text element to display out of WAX, and into resource registries.”).

Harris specifically discloses that “WAX stylesheets component 42 dictates the presentation of the WAX content, and the device stylesheets component 40 [sic, 44] tailors the presentation of the content to the requesting device based on the attributes possessed by the requesting device,” indicating that WAX itself is not changed, but the content from WAX is subsequently modified using MCF components, such as Device Stylesheets. Ex. 1006 ¶ 22.

In Example 3 of the WAX Stylesheet (Ex. 1006 ¶ 29), the abstract id in WAX is “welcome.” Ex. 1006 ¶ 30. It is described as being “translated” into two different possible alternatives. *Id.* The WAX is not being changed. The abstract id is converted or changed when the WAX is translated into the device-specific language: “WAX focuses on ‘logical widgets’ that are translated to device-specific content.” *Id.* ¶ 16. In more detail, Harris explains:

The MCF 8 utilizes the WAX language to help tailor content to specific requesting devices. Content is translated from WAX into a device-specific language and is also tailored to take advantage of features and accommodate limitations in the requesting device. The MCF 8 includes registries listing device capabilities which are utilized to provide appropriate amounts and types of content to the requesting device.

Id. ¶ 19.

Dr. Bederson, Petitioner’s expert, testifies that it is his “opinion that that content on WAX stylesheets can be removed, not converted to a language, or reduced in length to eliminate portions of the content (corresponding to the claimed “eliminate, using said device profile, at least

one content item”) based on a specific mobile device’s capability such as small display size stored in registry of devices. Ex. 1002 ¶ 224. Dr. Bederson testifies that WAX content is translated to HTML, and then states his opinion that:

content on WAX stylesheets can be removed, not converted to a language, or reduced in length to eliminate portions of the content (corresponding to the claimed ‘eliminate, using said device profile, at least one content item’) based on a specific mobile device’s capability such as small display size stored in registry of devices.”

Ex. 1002 ¶ 224.

However, Dr. Bederson fails to explain how translation of WAX is equivalent to removing content items from WAX. *Id.*

In sum, Petitioner has not met the burden of establishing by a preponderance of the evidence that limitation [12e] is described or suggested by the combination of Hariki and Harris.

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

The “said” content item is a reference to the content item recited in limitation [12e] which content item is eliminated using the device profile. Limitation 12[e] is discussed above. Patent Owner separately challenges the last clause of limitation [12f] that the content item being eliminated is “being unsupported by the wireless device.” We have already determined that Petitioner failed to provide sufficient evidence that the combination of Harris and Hariki teaches or suggests limitation [12e] “eliminate, using said device profile, at least one content item from said plurality of content items from said wireless device generic template.” However, we will address

Patent Owner’s argument regarding limitation [12f] nonetheless because it is relevant to limitation [12e].

In the Petition, it was argued that Harris 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 the Bederson Declaration, Ex. 1002 ¶¶ 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. Dr. Bederson concludes that “it is my opinion that the Hariki-Harris combination discloses eliminating extra text that is unsupported by a mobile device’s small screen size (corresponding to the claimed “said at least one content item being unsupported by the wireless device”).” Ex. 1002 ¶ 227.

Patent Owner contends that the combination of Hariki and Harris does not meet limitation [12f] “because Harris only adds/modifies content—as explained in limitation 12[e]—that is supported by the wireless device. . . . That is, Harris teaches ‘choos[ing] appropriate content for the requesting device,’ not removing inappropriate content. *Id.*; Ex. 2005 ¶ 151.” PO Resp. 47 (emphasis removed). Patent Owner further contends, as it does for limitation [12e], that the content in WAX “persists” and is customized for wireless devices by MCF. *Id.* at 48. As evidence, Patent Owner points to Harris’s disclosure that the MCF chooses “a suitable XSL stylesheet to use for later device-specific translation.” *Id.* (citing Ex. 1006 ¶ 24).

Patent Owner also contends that Harris generates items supported by the wireless device, not removing them. *Id.* (citing Ex. 2005 ¶ 155; Ex. 1006 ¶¶ 20, 24).

We agree with Patent Owner.

In limitation [12f], the “content item being unsupported by the wireless device” is an item which has been “eliminate[d], using said device profile, . . . from said plurality of content items from said wireless device generic template to define a device specific template.” We have already found that an item is not being eliminated using the device profile.

Assuming that elimination does occur of the item, we turn to Petitioner’s example of “eliminating extra text” when a content item is not supported by the wireless device, such as having a small screen that “is not capable of displaying the entire text.” Pet. 63; Ex. 1002 ¶ 227. As Patent Owner points out, the extra text which is eliminated is not from the generic template. The template and its content items persist, but when they are translated and customized by the MCF, text may be eliminated, changed, or customized based on the device profile.

In sum, Petitioner has not met the burden of establishing by a preponderance of the evidence that limitation [12f] is described or suggested by the combination of Hariki and Harris.

[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.”

For the reasons discussed above for limitation [1e], Petitioner has not met the burden of demonstrating by a preponderance of the evidence that limitation [12g] is described or suggested by the combination of Hariki and Harris.

[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.” Patent Owner does not dispute Petitioner’s contentions that limitations [1f] and [12h] are described or suggested by the combination of Hariki and Harris, which we find to be supported by a preponderance of the evidence.

(i) *Summary*

For the reasons given, we determine that Petitioner has not met the burden of demonstrating by a preponderance of the evidence that claim 12 is unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Hariki and Harris.

(ii) *Dependent Claims 14–18 and 20*

Petitioner asserts that claims 14–18 and 20, which depend from claim 12, are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Hariki and Harris. Pet. 58–65. Claims 14–18 and 20 incorporate all the limitations in claim 12. 35 U.S.C. § 112 ¶ 4.

Based on the current record and for the reasons discussed above for claim 12, Petitioner has not met the burden of demonstrating that claims 14–

18 and 20 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Hariki and Harris.

3. *Dependent Claims 2 and 13*

Patent Owner separately addresses dependent claims 2 and 13 of the '865 Patent. PO Resp. 50. Claims 2 and 13 are reproduced below:

2. The method of claim 1, wherein said wireless device generic template includes relative screen location and display object size information and is independent of screen dimensions of the wireless device.

13. The non-transitory processor-readable medium of claim 12, wherein said wireless device generic template contains relative screen location and display object size information independent of screen dimensions of the wireless device.

Dependent claims 2 and 13 require the “wireless device generic template” to include “relative screen location and display object size information and is independent of screen dimensions of the wireless device.”

Petitioner, as discussed above, identifies the WAX stylesheet as the claimed “generic template.” Pet. 43. For the limitation “relative screen location,” Petitioner points to the disclosure in the WAX language example of “<wax:p align='center'>” as a content alignment command in WAX for center alignment. *Id.* (citing Ex. 1006 ¶ 29).

Petitioner cites Harris’s disclosure that its system “ensures the best type and length of text is used, the best type and size of image is used, and that the content is well suited and customized for the device attributes.” Ex. 1006 ¶ 7 (cited at Pet. 43). Petitioner further cites from paragraph 18 of Harris that “a WAX ‘Date-Chooser’ renders one way on the limited screen sizes of mobile phones (possibly through a series of WML decks and

another way on a PDA (all on one Screen).” Pet. 43–44 (quoting from Harris ¶ 18).

Petitioner concludes that one of ordinary skill in the art would have understood that “to optimally present content to various types of mobile devices and PDAs, *Harris*’ generic WAX stylesheet includes specific location and size information for its content that are implemented through alignment commands such as ‘center,’ which is a physical location relative to the edges of the containing window.” Pet. 44 (citing Ex. 1002 ¶ 178).

In response, Patent Owner argues that the “center” command alone does not meet the claim limitation because the claim also requires including “display object size information . . . independent of screen dimensions of the wireless device.” PO Resp. 52.

Patent Owner also contends that the “Wax ‘Date Chooser’” does not meet the claim limitation because it is a function of the screen dimension, while the claim requires it to be “independent” of screen dimensions. PO Resp. 51. Patent Owner also argues that Petitioner is relying on the filtered WAX which is not the same as the claimed “wireless device generic template.” *Id.* at 51–52.

As discussed below, we agree with Patent Owner that this limitation is not described or suggested by the combination of Harris and Hariki.

For instance, claim 13 recites “wherein said wireless device generic template contains relative screen location and display object size information independent of screen dimensions of the wireless device.” Claim 2 includes similar language.

Petitioner contends that Harris’s description of a system that “ensures the best type and length of text is used, the best type and size of image is

used, and that the content is well suited and customized for the device attributes” (Ex. 1006 ¶ 7) supports its argument that the claim limitation “display object size information independent of screen dimensions of the wireless device” is described by Harris. Pet. 43. We do not agree.

The disclosure referenced by Petitioner refers to the MCF transforming WAX, using device attribute records, into content customized for a specific wireless device’s attributes. Ex. 1006 ¶ 7. The information about customizing the content is not contained in the wireless device generic template as required by the claim, but instead the “customization process uses device attribute records stored in databases to choose appropriate content for the requesting device.” *Id.* Thus, Petitioner’s contention that “display object size” is met by this disclosure in Harris is not supported by the evidence of record.

Harris’s discussion of the “WAX ‘Date-Chooser’” also does not support Petitioner’s argument that the limitation in claims 2 and 13 is described by Harris. The “Date-Chooser” is an example of a rule in “[s]ome devices” that “require their own translation rules.” Ex. 1006 ¶ 18. Harris explains that a “developer can specialize the behavior of any WAX tag (new and old by updating or adding to the translation rules.” *Id.* “Content is translated from WAX into a device-specific language and is also tailored to take advantage of features and accommodate limitations in the requesting device.” *Id.* ¶ 19. The WAX translator component is part of the MCF. *Id.* ¶ 22. The size information for the “Date-Chooser” is therefore not contained in the generic template, but instead the generic WAX is translated by the WAX translator component in the MCF into device-specific language for display on a specific type of wireless device.

The other disclosure identified by Petitioner as meeting the claim limitations is the WAX language examples of “<wax:p align=‘center’>” as a content alignment command in WAX for center alignment. *Id.* (citing Ex. 1006 ¶ 29). Patent Owner does not disagree that this command centers the “relative screen location . . . independent of screen dimensions of the wireless device. PO Resp. 52 (“assuming this is true for the sake of argument”). However, Patent Owner disagrees that this disclosure teaches “display object size information independent of screen dimensions of the wireless device.”

Petitioner does not provide a persuasive response. As explained above, Patent Owner identifies disclosures in which WAX is transformed in post-filtering by MCF to modify object size dependent on the screen and other attributes of the requesting wireless device. The so-called “tailoring” does not occur “on the generic stylesheets” as asserted by Petitioner, but instead is performed based on device attributes when WAX is translated into content.

For the reasons discussed above, in addition to the deficiencies in Petitioner’s showings for the base claims, Petitioner has not met the burden of demonstrating by a preponderance of the evidence that claims 2 and 13 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Hariki and Harris.

4. *Claims 8 and 19*

Patent Owner separately addresses dependent claims 8 and 19 of the ’865 Patent. PO Resp. 53. Claims 8 and 19 are copied below:

8. The method of claim 1, wherein said page description includes at least one display rendering command and at least one audio rendering command.

19. The non-transitory processor-readable medium of claim 12, wherein said page description includes at least one display rendering command and at least one audio rendering command.

The “page description” is asserted by Petitioner to be the HTML files.

Petitioner contends that Harris’s HTML files contain a display rendering command. Petitioner contends:

the *Hariki-Harris* system discloses generating HTML files (i.e., “generating a page description”) from WAX content from WAX and device stylesheets. . . . *Harris* further discloses “in the translation process, elements (or tags) in the WAX file are translated to be rendered in different ways, specific to the mobile device. *Bederson*, ¶198. For example, “[t]he <wax:button> element is displayed as a ‘soft-key’ for WAP devices, but as a ‘link’ for devices which understand only HTML.” *Harris*, ¶30. Accordingly, *Harris* discloses a display rendering command. *Bederson*, ¶198.

Pet. 50.

For the “audio rendering command,” Petitioner references Hariki’s disclosure of a user interface UI content package which

“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.” Hariki, ¶ 24. The resource files in the UI content package “can contain various types of data objects relating to the user interface elements of the mobile devices, such as ...sound files, ... movies.” *Id.*, [¶ 31].

Pet. 50 (emphasis omitted).

The Petition concludes that to render the referenced “sound files” one of ordinary skill in the art would understand that an audio rendering

command is required. Pet. 50–51 (citing Ex. 1002 ¶ 199); Ex. 1002 ¶ 129 (describing how UI skins that alter sound output can be downloaded and stored on a device).

Patent Owner contends that Petitioner does not establish that Hariki discloses an audio rendering command in a page description as required by the claims. PO Resp. 53. Patent Owner contends that Harris’s HTML files serve as the “page description” in Petitioner’s analysis. *Id.* However, Patent Owner argues that “the UI content package is not the HTML files, and there is no teaching that the HTML files have an audio rendering command. Ex. 2005 ¶162.” *Id.*

Petitioner responds that Patent Owner has ignored the obviousness standard under which the Hariki-Harris combination “discloses this limitation.” Pet. Reply 18. “In the *Hariki/Harris* system, UI content packages and HTML files work in concert to customize and render various content on a wireless device. *Hariki*, ¶¶21, 24.” *Id.* Petitioner contends that one of ordinary skill in the art “would have understood that the HTML files would include embedded audio rendering commands – similar to the display rendering commands disclosed by *Harris*, ¶30 – that in conjunction with the UI content package audio files render audio content on the wireless device. *Hariki*, ¶¶21, 24; *Bederson*, ¶199; *Pet.*, 50-51.” *Id.*

Patent Owner contends that Petitioner changed its invalidity position in the Reply. PO Sur-reply 18. “Petitioner went from arguing that ‘Hariki in combination with Harris discloses this feature,’ Pet. 50 . . . to ‘Hariki in view of Harris . . . makes this limitation obvious,’ Reply 18.’ Sur-reply 18 (emphasis omitted). Patent Owner also complains that, in the Petition, it was argued that “to render audio content, an audio rendering command is

required,” but not that this “required” “audio rendering command” was in the HTML. Sur-reply 18–19 (emphasis omitted) (citing Pet. 51).

Patent Owner contends that Petitioner argues for the first time in the Petitioner’s Reply (Paper 22) that a person of ordinary skill in the art “‘would have understood that the HTML files would include embedded audio rendering commands,’ similar to the audio rendering commands in the UI skin upon which Petitioner previously relied. Reply 18.” PO Sur-reply 19 (emphasis omitted). Patent Owner assert that “[s]uch departure is improper.” *Id.* (citing *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016)).

The claims require the “page description” to include the audio company, i.e., the HTML file. Patent Owner contends that Petitioner does not provide evidence that HTML files would include embedded audio rendering commands, arguing that Hariki’s paragraphs 21 and 24, and Dr. Bederson’s paragraph 199 do not disclose audio rendering commands in HTML. PO Sur-reply 10.

We agree with Patent Owner that Petitioner’s argument that Hariki and Harris make the “obvious” the limitation recited in the claim is a new argument not previously made. Petitioner alleges that Patent Owner “ignores the obviousness standard under which Hariki/Harris discloses” the audio rendering limitation. Pet. Reply 18.

We do not agree. The word “obvious” or “obviousness” appears only five times in the entire Petition, each time only in the headings or in the discussion that no evidence of secondary considerations have been put forth. Pet. i, ii, 18, 66, 77. The discussion of claim 1 in the Petition does not use the term “obvious” or “obviousness.” The few times in which motivation to

combine Hariki and Harris is discussed, none relate to the disputed audio limitation. *See* Pet. 3, 25, 26, 69 (cited in second patentability challenge based on Dees), 70 (cited in second patentability challenge based on Dees).

In *KSR*, although the Supreme Court emphasized “an expansive and flexible approach” to the obviousness question, 550 U.S. at 415, it also reaffirmed the importance of determining “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 418. The Petition, however, identified no such reason to place Hariki’s audio UI rendering command in HTML. The Petition addresses “a reasonable expectation of success in implementing Harris’ content generation scheme with Hariki’s customization.” Pet. 25. In making this statement, the Petition describes Hariki’s disclosure of the user interface UI skins which can alter sound output aspects of the device, but does not describe implementing it in Harris’s customized HTML files. Pet. 25–26. The Petition describes, in detail, Hariki’s UI content packages which would have been sent when executing the web server process, but does not describe the UI content packages as being sent as part of HTML. *Id.* at 31. Separately, the Petition describes Harris’s process of customizing the content sent to the requesting device in the form of an HTML file. *Id.* at 32–33.

The Petition also describes how Harris, in a discussion of WAX, describes the limitation of “low level rendering command that is within said rendering capability of said wireless device” as recited in independent claim 1. Pet. 36–38.

The Petition describes the disclosure in Hariki of HTML content files (*see* Ex. 1005 ¶ 21) and the customized UI (Pet. 18–19): “*Hariki* discloses a

method of generating UI skins and providing content data by a server (i.e., ‘server implemented method for processing data’) to a mobile device (i.e., ‘for a wireless device’). *Bederson*, ¶113.” Pet. 21. The Petition identifies Hariki’s UI content package as the claimed “custom configuration.” Pet. 30–31 (discussion limitation [1c], citing Ex. 1002 ¶¶ 143–147. However, there is no discussion of the obviousness of putting UI content commands in Hariki’s HTML.

Dr. Bederson contends that Hariki “discloses a server that sends HTML files that include low level commands to a mobile device.” Ex. 1002 ¶¶ 165, 185. However, Dr. Bederson does not identify the disclosure in Hariki that supports this opinion. Neither the Petition nor Dr. Bederson identify what specific commands are present in Hariki’s HTML files. *See* Pet. 38, 42. The Petitioner refers to low level commands as “tags,” but the “tags” described in the Petition are those in the WAX file of Harris. Pet. 32, 38; Ex. 1002 ¶ 198 (“*Harris* further discloses [] in the translation process, elements (or tags) in the WAX file are translated to be rendered in different ways, specific to the mobile device. *Bederson*, ¶198.”). Hariki’s UI is also described in the Petition as containing rendering commands, including audio commands. Pet. 50–51. The Petition, however, does not identify a reason to put such commands in Hariki’s or Harris’s HTML files.

In discussing limitation [1f] (“sending said page description to the wireless device”), the Petition states:

Hariki discloses a server that sends HTML files that include low level commands to a mobile device (i.e., “sending said page description to the wireless device”) and the mobile device that uses the received converted resources in the UI package and HTML file resources and formats them into renderable content for the application for display (i.e., “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”).

Pet. 42–43.

Thus, the Petition discloses how the HTML files and UI interact, but does not suggest moving the low level rendering commands in the UI, such as the audio rendering commands (Hariki ¶¶ 24, 31), into the HTML. Petitioner had the opportunity to explain why it would have been obvious to have placed the audio rendering commands into the HTML files. But, instead, Petitioner and its expert described the separate attributes of the UI and HTML. The statement in the Petition that “Hariki in combination with Harris discloses this feature” is insufficient under *KSR* because no reason was provided as to why it would have been obvious to the ordinarily skilled artisan to place audio commands from the UI skin into the HTML files. Dr. Bederson testified in his declaration that Hariki’s UI content package can contain sound files, that “Hariki discloses that renderable content comprises audio content,” and that therefore “to render audio content, an audio rendering command is required.” Ex. 1002 ¶ 199. However, the claim requires the audio command to be in the HTML file, the claimed page description.

For the reasons given above, in addition to the deficiencies in Petitioner’s showings for the base claims, Petitioner has not met the burden of demonstrating by a preponderance of the evidence that claims 8 and 19 are unpatentable under 35 U.S.C. § 103(a) as obvious in view of Hariki and Harris.

5. *Claim 34*

Patent Owner separately argues limitation [a] of claim 34 of the '865 Patent. PO Resp. 29. Limitation 34[a] is copied below.

[34a] “send a custom configuration to the wireless device, said custom configuration being specific to said application program, the wireless device operable to present a content item from said plurality of content items using said page description and said custom configuration.”

Limitation [34a] of dependent claim 34 recites the same language as limitation [1c].

We addressed Patent Owner’s arguments for limitation [1c] and found them persuasive. *See supra* pp. 31–39.

For the reasons discussed above, Petitioner has not met the burden of demonstrating by a preponderance of the evidence that claim 34 is described or suggested by the combination of Hariki and Harris.

G. *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(a) 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. *Id.* We thus refer back to the discussion of these claims under Ground 1 and our explanation as to why Petitioner did not meet the burden of establishing by a preponderance that claims 1 and 12 are unpatentable under 35 U.S.C. § 103(a).

For dependent claims 5–7 and 16–18, Petitioner additionally cites Dees. Pet. 67–75. Dees does not make up for the deficiencies in Hariki and Harris found for claims 1 and 12. For example, Dees is cited for disclosing low level rendering commands (Pet. 68–71), display position and orientation

(*id.* at 71–73), and rendering blocks (*id.* at 73–75). Petitioner thus fails to show, by a preponderance of the evidence, that claims 5–7 and 16–18, which incorporate all the limitations of dependent claims 1 and 12, would have been obvious over Harris, Hariki and Dees. *See Fine*, 837 F.2d at 1076.

III. PETITIONER’S MOTION TO EXCLUDE EVIDENCE

Petitioner initially raised objections to Exhibits 2005 and 2007–2012. Paper 19. In the subsequently filed Motion to Exclude, as explained below, Petitioner seeks to exclude only Exhibits 2007–2012. Paper 27. Petitioner asserts the exhibits “are inadmissible because they are not relevant; that is, they do not have any tendency to make a fact of consequence in this proceeding more or less probable.” Paper 27, 1. Petitioner also asserts the exhibits should be excluded because “they should also be excluded under Federal Rule of Evidence 403 due to the risk of unfair prejudice and confusion of the issues.” *Id.*

Exhibits 2007–2012 are screenshots of dictionary entries obtained from various online sources. Patent Owner relies on these definitions as extrinsic evidence in support of its claim construction positions. Paper 18, 25, 28. Mr. Lipoff referred to these definitions in his declaration. Ex. 2005 ¶¶ 99, 104, 106, 111.

Of the six exhibits, five bear copyright dates or other dated information after the August 1, 2007, priority date of the ’865 patent:

Exhibit	Year	Citation
2007	2024 copyright	Tailored, Cambridge Dictionary, <i>available at</i> https://dictionary.cambridge.org/dictionary/english/tailored?q=tailored 1 (last visited Dec. 18, 2023)
2008	2024 copyright	Discrete, Merriam-Webster.com Dictionary, <i>available at</i> https://www.merriam-webster.com/dictionary/discrete (last visited Dec. 13, 2023)

2009	2022 copyright	Discrete, American Heritage Dictionary, <i>available at</i> https://www.ahdictionary.com/word/search.html?q=discrete (last visited Dec. 13, 2023)
2010	1998 copyright	Discrete, Merriam-Webster's Collegiate Dictionary (1998)
2011	last edited Jan 3. 2023	Application-Specific, Wiktionary, <i>available at</i> https://en.wiktionary.org/wiki/application-specific (last visited Dec. 15, 2023)
2012	2022 copyright	Eliminate, The American Heritage Dictionary of the English Language, <i>available at</i> https://www.ahdictionary.com/word/search.html?q=eliminate (last visited Dec. 19, 2023)

The “words of a claim are generally given their ordinary and customary meaning,” which is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.” *Phillips*, 415 F.3d at 1312–13. Patent Owner did not provide evidence that Exs. 2007, 2008, 2009, 2011, and 2012 were available before the invention was made (*i.e.*, Aug. 1, 2007). As shown in the table above, these exhibits have dates identifying information that suggests publication after the effective filing date. Thus, we agree with Petitioner that Exhibits 2007, 2008, 2009, 2011, and 2012 should be excluded as not credible evidence of how one of ordinary skill would have understand the terms recited in the issued claims of the '865 patent because Petitioner did not establish these definitions were available at the time the invention was made. Consequently, Patent Owner's Motion to Exclude Exhibits 2007, 2008, 2009, 2011, and 2012 is granted.

Exhibit 2010 appears to have been published in 1998, prior to the filing date of the application which led to the '865 patent. Exhibit 2010 is the definition of the term “discrete,” which appears in claims 1 and 12 (“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.”). The term “discrete” is not at issue in this proceeding. We do not rely on the definition of “discrete” or on Exhibit 2010 in rendering this Final Written Decision. We thus consider the Motion to Exclude Exhibit 2010 to be moot and dismiss it as to Exhibit 2010 only.

In sum, Petitioner’s Motion to Exclude is granted in part as to Exhibits 2007, 2008, 2009, 2011, and 2012 and dismissed in part as moot as to Exhibit 2010.

IV. CONCLUSION

For the foregoing reasons, we determine that Petitioner has not demonstrated by a preponderance of the evidence that any challenged claims of the ’865 patent are unpatentable.

In summary:

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Shown Patentable
1–20, 31, 34	103(a)	Hariki, Harris		1–20, 31, 34
1–20, 31, 34	103(a)	Hariki, Harris, Dees		1–20, 31, 34
Overall Outcome				1–20, 31, 34

V. ORDER

It is

ORDERED that claims 1–20, 31, and 34 of the '865 patent have not been proven unpatentable by a preponderance of the evidence;

FURTHER ORDERED that because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

FURTHER ORDERED that Petitioner's Motion to Exclude is granted in part as to Exhibits 2007, 2008, 2009, 2011, and 2012.

FURTHER ORDERED that Petitioner's Motion to Exclude is dismissed in part as moot as to Exhibit 2010.

IPR2023-00759
Patent 8,103,865 B2

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