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Paper 13
Date: January 3, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

DODOTS LICENSING SOLUTIONS LLC,
Patent Owner.

IPR2023-00938
Patent 8,020,083 B1

Before HUBERT C. LORIN, AMBER L. HAGY, and SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Apple Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1–16 of U.S. Patent No. 8,020,083 B1 (Ex. 1001, "the '083 patent"). DoDots Licensing Solutions LLC ("Patent Owner") filed a Preliminary Response (Paper 7, "Prelim. Resp."). Petitioner also filed a Preliminary Reply (Paper 9, "Prelim. Reply") and Patent Owner filed a Preliminary Sur-reply (Paper 11, "Prelim. Sur-reply").[1]

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition, the Preliminary Response, Preliminary Reply, and Preliminary Sur-reply shows that "there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a).

Upon consideration of the arguments and evidence presented by Petitioner, we deny Petitioner's request to institute an *inter partes* review as to the challenged claims of the '083 patent on the grounds of unpatentability presented.

B. Related Proceedings

The parties indicate that the '083 patent is the subject of *Samsung Electronics Co., Ltd. v. DoDots Licensing Solutions LLC*, IPR2023-00621; *DoDots Licensing Solutions LLC v. Apple Inc. et al.*, No. 6:22-cv-00533, (W.D. Tex. May 24, 2022); and *DoDots Licensing Solutions LLC v.*

[1] The Board authorized the filing of these papers. *See* Order (Paper 8).

Samsung Electronics Co., Ltd. et al., No. 6:22-cv-00535 (W.D. Tex. May 24, 2022). Pet. 73; Paper 3(Patent Owner's Mandatory Notices), 1–2.

Petitioner notifies us that the '083 patent was the subject of IPR2019-01278 filed by Lenovo Holding Company, Inc., et al.[2] Pet. 4 & n.1. Patent Owner refers to IPR2019-00988 as involving the validity of the '083 patent; however, that *inter partes* review involved a related patent. Prelim. Resp. 1, 8–10 (citing Ex. 2001).

C. Real Parties in Interest

Petitioner identifies only itself as a real party in interest. Pet. 73. Patent Owner identifies only itself as a real party in interest. Paper 3, 1.

D. The '083 Patent (Ex. 1001)

The title of the '083 patent is "System and Methods for Creating and Authoring Internet Content Using Application Media Packages." Ex. 1001, code (54). The '083 patent discloses, in part, a software component for accessing and displaying network content. *Id.* at code (57). This component, termed an "Application Media Package" or "Dot," is a "fully configurable frame with one or more controls" with content optionally presented through the frame. *Id.* at 3:57–59, 5:40–48. When a Dot is opened by a user, the frame is presented in the user's display, and network content is retrieved and presented in a viewer enclosed by the frame. *Id.* at 23:5–17. The network content may be identified via URLs included in the

[2] The Board's decision in IPR2019-01278 (Ex. 1008), which determined no challenged claims were unpatentable, was affirmed by the Federal Circuit. *See Lenovo Holding Company, Inc. v. DoDots Licensing Solutions LLC*, 2021 WL 5822248 (Fed. Cir. 2021); Ex. 1009; Ex. 2002.

Dot. *Id.* at code (57), 13:47–52, 14:14–16. The specification describes that the Dot "stands in contrast to present web browsers, which are branded by the browser vendor and which have limited means by which to alter the controls associated with the browser." *Id.* at 5:44–48.

A server may store a number of Dots and provide a Dot to a client system upon request. *Id.* at 7:5–23, 20:63–21:42, 22:53–23:19, Figs. 1, 6, 8. A user at the client system may then store or use the Dot. *Id.* at 23:20–62.

E. Illustrative Claim

Petitioner challenges claims 1–16 of the '083 patent. Pet. 1. Claims 1 and 9 are the only independent claims among the challenged claims. Claim 1 is reproduced below:

> 1. A client device, the client device comprising:
>
> electronic storage having stored thereon a plurality of networked information monitor templates defining a plurality of networked information monitors, the plurality of networked information monitor templates comprising a first networked information monitor template defining a first networked information monitor, wherein the first networked information monitor template comprises:
>
> (1) a content reference that comprises a network location at which content for the first networked information monitor is accessible via a TCP/IP protocol;
>
> (2) a definition of a graphical user interface of the first networked information monitor that lacks controls for manually navigating a network, and that includes a frame within which content received from the network location can be displayed, and frame characteristics defining one or more a color, a size, or a position on the electronic display of the frame; and

(3) instructions configured (i) to cause the first networked information monitor to request content from the network location in the content reference via the TCP/IP protocol, and (ii) to cause the first networked information monitor to generate the graphical user interface of the first networked information monitor with the content received from the network location via the TCP/IP protocol within the frame;

an electronic display; and

one or more processors configured to access the first networked information monitor template, and to execute the first networked information monitor template such that the graphical user interface of the first networked information monitor is presented to a user on the electronic display having content received from the content reference therein.

Ex. 1001, 47:42–48:8.

F. Asserted References

Petitioner relies on the following references (Pet. 5):

Name	Reference	Ex. No.
Slivka et al.[3]	U.S. Patent No. 6,061,695, issued May 9, 2000	1004
Anabuki	U.S. Patent No. 6,091,518, issued Jul. 18, 2000	1006
Powell	Powell, Thomas A., "HTML: The Complete Reference"	1013

[3] We refer here only to U.S. Patent No. 6,061,695 ("the '695 patent"). *See* Pet. 8 ("U.S. Patent No. 6,061,695 to Slivka, et al. ('*Slivka*') . . . *Slivka* (Ex. 1004) . . ."). Although Petitioner contends that certain appendices included in the '695 patent's file history are part of the '695 patent (*see id.* (referring to Ex. 1005, 69–245)), we consider these appendices to be separate from the patent for purposes of this decision, as explained *infra* in our analysis.

Petitioner also relies on the Declaration of Dr. Loren Terveen (Ex. 1003, "Terveen Decl.").

G. Asserted Grounds

Petitioner contends that claims 1–16 of the '083 patent are unpatentable under the following grounds (Pet. 5):

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–5, 9–13	§ 103[4]	Slivka[5] alone or with Powell
6–8, 14–16	§ 103	Slivka, Powell, Anabuki

II. ANALYSIS

"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 of persuasion does not shift to Patent Owner. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

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[4] The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), amended 35 U.S.C. §§ 102 and 103. Because the challenged claims of the '083 patent claim an effective filing date before the effective date of the applicable AIA amendments (*see* Ex. 1001, code (22)), we refer to the pre-AIA versions of 35 U.S.C. §§ 102 and 103 throughout this Decision.

[5] *See supra* n.3.

We determine that Petitioner has not satisfied its burden from the onset to show with particularity why the patent it challenges is unpatentable. Our determination is based on finding that Petitioner's challenge relies on appendices (Ex. 1005, 69–245) that were not published with the '695 patent (Ex. 1004). As discussed herein, we conclude, on the record before us, that Petitioner has insufficiently shown that the relied-upon appendices qualify as prior art under 35 U.S.C. § 102(e), as Petitioner asserts. *See* Pet. 8.

A. '695 patent and Slivka Appendices

The primary reference in both grounds is denominated "Slivka." Petitioner contends that "Slivka" references both (a) U.S. Patent No. 6,061,695 (Ex. 1004) and (b) appendices contained in the file history of the '695 patent (Ex. 1005, 69–245 (the "Slivka Appendices")). Pet. 8. This is reflected in Petitioner's invalidity contentions, which rely on disclosures from both the '695 patent and the Slivka Appendices. *See, e.g.*, Pet. 8–14; *see also* Prelim. Resp. 20, 30–31 (noting Petitioner's reliance on the Slivka Appendices).

It is not disputed that the '695 patent qualifies as prior art under 35 U.S.C. § 102(e), as Petitioner asserts.

There is a dispute, however, over whether the Slivka Appendices qualify as prior art under § 102(e), as Petitioner asserts. *Id.; see, e.g.*, Prelim. Resp. 20 ("[Petitioner] cannot identify which 102(e) provision covers the unpublished Slivka application or the appendices because neither are prior art under §102(e).")

The dispute stems from the fact that the Slivka Appendices were not published in the '695 patent (i.e., the document Petitioner submitted into

evidence (Ex. 1004)). It is plainly evident from perusing the '695 patent that the Slivka Appendices are not there. On its face, the '695 patent does not include the contents of any of the Slivka Appendices and the public would be justified in believing the '695 patent does not include them.

The Slivka Appendices were filed with the specification of the Slivka application on December 6, 1996. Petitioner correctly points out that the Slivka Appendices have a date stamp of "DEC 6 1996," the filing date of the '695 patent. Pet. 8; *see* Ex. 1005, 69. There is also a Transmittal Letter in the file history stating that a patent application is "[t]ransmitted herewith for filing" and "[e]nclosed are . . . 34 pages of specification, 4 pages of claims, an abstract, an unsigned Combined Declaration and Power of Attorney and 177 pages of appendices" and "7 sheet(s) of formal drawings," also with the same date stamp of "DEC 6 1996." Ex. 1005, 254.

The question is whether the Slivka Appendices, though not published in the '695 patent, were made part of the specification when they were filed. Otherwise, they should be treated as separately-filed documents that do not qualify as prior art under § 102(e).

B. Incorporation

1. Parties' Views and Our Analysis

Petitioner provides several reasons for why it believes the Slivka Appendices were incorporated in the specification of the '695 patent when they were filed on December 6, 1996. *See* Pet. 8; Prelim. Reply 1, 3 ("Because Slivka's appendices were incorporated in the ['695 patent] disclosure at the time of filing, it is proper for Petitioner to rely on the

appendices as part of 'the entire disclosure' of the ['695 patent] as a §102(e) reference.") (quoting "MPEP 2136.02").

First, Petitioner argues that there are "clear and consistent references to the appendices throughout the specification." Prelim. Reply 1 (citing Ex. 1004, 18:56 (Appendices A and B), 18:64–65 (C–F), 19:24–29 (I–L), 6:41, 17:22–24 (Q), 12:34–36 (R), 15:32–33 (S), and 17:1–3 (T)).

Patent Owner disagrees. "Every appendix is characterized as simply being 'attached hereto' or 'attached … respectively.' Referencing appendices as being attached is not incorporating the contents of the appendices into the 'entire disclosure' of [the] specification." Prelim. Sur-reply 3 (quoting MPEP 2136.02).

The '695 patent states that the appendices are "attached." In fact, they are not attached. They are missing from the '695 patent as published. The material relied on under 102(e) must be present in the issued patent or application publication. *See* MPEP § 2136.02 (6th ed. Rev. 2) ("When a U.S. patent is used to reject claims under pre-AIA 35 U.S.C. 102(e), the disclosure relied on in the rejection must be present in the issued patent."). Here, the appendices were not "present" in the '695 patent as issued because they were not incorporated by reference. *See Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282–83 (Fed. Cir. 2000) (citing *In re de Seversky*, 474 F.2d 671, 674 (CCPA 1973)) ("To incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various documents."); *see also Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1346 (Fed. Cir. 2009) (quoting *de Seversky*, 474 F.2d at

674) ("[M]ere reference to another application, or patent, or publication is not an incorporation of anything therein.")

For these reasons, we agree with Patent Owner that the references to appendices throughout the specification of the '695 patent do not in themselves mean the contents of the Slivka Appendices were incorporated in the '695 patent.

Second, Petitioner argues that the Slivka Appendices were included "with the originally filed application, stamped with the filing date." Prelim. Reply 1 (citing Ex. 1005, 69–245).

Patent Owner responds that it

> agrees that the appendices were filed with the application and other documents, and that all of the documents were stamped with the same filing date. Reply at 1. But that fact carries no weight. Filing a collection of documents that includes an application and appendices does not mean that the appendices are incorporated into the patent specification.

Sur-reply 2. We agree. The fact that the Slivka Appendices were filed with, and on the same day as, the patent application, which is not disputed, does not provide us any insight into whether the missing Slivka Appendices were or were not incorporated in the '695 patent on December 6, 1999, such that they should be considered part of the '695 patent.

Third, Petitioner argues that the "Applicant expressly not[ed] the incorporation of the appendices to the Examiner during prosecution of the ['695 patent]." Prelim. Reply 1 (citing Ex. 1005, 254).

We agree with Patent Owner that "Slivka did *not* note that he was incorporating the appendices to the specification." Prelim. Resp. 2 (emphasis original). Petitioner cites to the Transmittal Letter ("Ex. 1005,

254"), but there is no mention there about the Slivka Appendices having been incorporated. Prelim. Reply 1; Ex. 1005, 254.

For its part, Patent Owner contends that "appendices A, C, D, E and F are 'computer program listing[s]' because they list instructions or routines of a HTM program," in accordance with the meaning of "computer program listing" set forth in the then-current version of MPEP 608.05. Prelim. Resp. 25 (citing the "BACKGROUND" section of then-current MPEP 608.05), 26 & n.4. Patent Owner contends that "the appendices cannot be considered part of the Slivka application because Slivka failed to comply with [then-current] MPEP 608.05 and 37 C.F.R. § 1.96[6], which set forth the specific steps an applicant is required to take when depositing computer program listings with a patent application." Prelim. Resp. 25.

Petitioner disputes that any of the appendices are computer program listings of the type to be subject to the then-current version of 37 C.F.R. 1.96. Pet. Reply 1–3. Moreover, according to Petitioner, "even if the 'Computer Program Listings' requirements did apply to Slivka's appendices, [Patent Owner] cites no support for its assertion that failure to comply with such requirements results in the appendices being excluded from the patent disclosure." *Id*. at 3.

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[6] At the time of submission in 1996, 37 C.F.R. § 1.96(a) stated that "[i]f the computer program listing is contained on 10 printout pages or less, it must be submitted either as drawings or as part of the specification." 37 C.F.R. § 1.96(b) stated that "[i]f a computer program listing printout is 11 or more pages long, applicants may submit such listing in the form of microfiche . . . ." *See* Ex. 2008, 21–22.

We agree with Petitioner on the latter point. On the present record, the relevant guidance and regulation at the time described how appendices containing computer program listings should be submitted and how proper submissions would be handled, but does not describe the effect if submissions were not compliant. Patent Owner does not adequately explain the connection between compliance with computer program listing requirements and the effective incorporation of such listings in a patent specification. But this does not change the ultimate result in this case.

We note Petitioner's discussion about the "policy rationale underlying § 102(e)." Prelim. Reply 3. It is similarly wanting. According to Petitioner, "§102(e) dictates that prior art *disclosed* to the patent office before the priority date qualifies as prior art even if it does not become publicly available until later." *Id*. (citing in support *Hazeltine Research, Inc. v. Brenner*, 382 U.S. 252, 255–256 (1965) and *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926)). But Petitioner's cited authorities do not help settle the incorporation question before us; the holding in these cases assumes incorporation is already established. *Cf. Hazeltine Research*, 382 U.S. at 253 (describing the issue as involving "disclosures made by patents previously issued"); *Alexander Milburn*, 270 U.S. at 399–401 (discussing disclosure in "Clifford's application" that matured into a patent and noting that "Clifford had done all that he could do to make his description public. He had taken steps that would make it public as soon as the Patent Office did its work.").

2. Southwest Software

We find a different decision by our reviewing court, *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 1295 (Fed. Cir. 2000)

("*Southwest Software*"), not cited by either party, instructive on how to assess whether the Slivka Appendices are a part of the specification of the '695 patent.

Southwest Software concerned, *inter alia*, U.S. Patent No. 5,170,257 B1 ("the '257 patent"). The '257 patent expressly states that "a computer program listing printout appendix" is "[i]ncorporated herein." *Southwest Software*, 226 F.3d at 1291 (*quoting* the '257 patent, col. 1, ll. 8–19). Although this language appeared in the published patent, the "Program Printout Appendix" was discovered, during a trial involving that patent, to be missing from a certified copy of the '257 patent. To correct the omission, the patent owner requested that the Patent and Trademark Office (PTO) issue a certificate of correction under 35 U.S.C. § 254. *Id.* The Federal Circuit noted the following:

> [T]he PTO granted the request and issued a certificate of correction adding the Program Printout Appendix to the patent. The PTO determined that the appendix had been filed with the application for the '257 patent and that the separation and loss of the appendix, as well as the failure to print the appendix in the issued patent, were the result of an error on its part. The PTO effected the correction by doing two things. First, it added the following sentence at the end of the paragraph quoted above: "A complete copy of the Program Printout Appendix is included." Second, it inserted the Appendix after line 63 in column 13 of the patent, immediately before the recitation of the claims.

Id.

One of the issues in the case was whether the PTO's certificate of correction (that added the Program Printout Appendix to the patent) was effective for causes of action arising before it issued (so as to be effective in the then-pending district court litigation, which was on appeal to the Federal

Circuit). In the course of deciding that issue, the Federal Circuit made this observation:

> For example, a patent with a single claim in means-plus-function form might, through a PTO mistake, omit from the specification the structure, material, or acts corresponding to the function recited in the claim. Until the PTO issues a certificate of correction pursuant to 35 U.S.C. § 254 adding the corresponding structure, *such a claim would appear invalid to the public, and reasonable competitors would be justified in conducting their affairs accordingly*. In such a case, where the claim is invalid on its face without the certificate of correction, it strikes us as an illogical result to allow the patent holder, once the certificate of correction has issued, to sue an alleged infringer for activities that occurred before the issuance of the certificate of correction. Moreover, it does not seem to us to be asking too much to expect a patentee to check a patent when it is issued in order to determine whether it contains any errors that require the issuance of a certificate of correction. In this case, the omission of the Program Printout Appendix from the '257 patent resulted in the absence of approximately 330 pages of text from the specification. It would seem that such an error would be readily apparent.

Southwest Software, 226 F.3d at 1295–1296 (emphasis added). The Federal Circuit remanded to determine if the uncorrected patent would have been invalid for failure to comply with the enablement and best mode requirements then in effect without the disclosure in the Program Printout Appendix. *Id.* at 1297.

Similar to the '257 patent at issue in *Southwest Software*, the '695 patent omits the Slivka Appendices. In contrast to the '257 patent, the '695 patent does not even contain an express statement about the incorporation of appendices. Accordingly, as was the case for the '257 patent with respect to the Program Printout Appendix prior to the filing of the certificate of

correction, we find the'695 patent does not include the contents of the Slivka Appendices.

C. Prior Art Status of the Slivka Appendices

We have determined that Petitioner's challenge relies on the Slivka Appendices (Ex. 1005, 69–245) missing from the '695 patent (Ex. 1004) as published because the Slivka Appendices were not incorporated by reference into the '695 patent specification. Thus, there is no sufficient indication on this record to establish a reasonable likelihood that the Slivka Appendices are available prior art for an *inter partes* review, as they are not part of the patent. 35 U.S.C. § 311(b); *see Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper No. 29 at 12–13 (December 20, 2019) (precedential) (discussing the standard at institution for a showing regarding the public availability of non-patent art).

On this record, Petitioner has not sufficiently shown that the Slivka Appendices, as separately-filed documents, should be accorded their stamped "DEC 6 1996," date for prior art purposes. As Patent Owner correctly explains, "the rule requiring publication of applications 'after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought' was not effective until November 29, 2000." Prelim. Resp. 15, 21 (citing 65 Fed. Reg. 57,024). For applications filed before November 29, 2000, as here, "the prosecution history of an application remain[ed] confidential until the application itself issue[d] as a patent." *Hyatt v. U.S. Patent and Trademark Office*, 797 F.3d 1374, 1378 (Fed. Cir. 2015). The current record, at most, might support a likelihood that the Slivka Appendices could be accorded the date they were first made

publicly available, which is May 9, 2000, the date the '695 patent issued. *See* 37 C.F.R. § 1.11 (a) ("After a patent has been issued or a statutory invention registration has been published, the specification, drawings, and all papers relating to the case in the file of the patent or statutory invention registration are open to inspection by the public, and copies may be obtained by paying the fees therefore."). As Patent Owner points out, however, this is "at least thirteen months after the '083 patent's effective filing date," i.e., April 26, 1999 (based on a claim for priority to, *inter alia*, U.S. Provisional Application Ser. No. 60/131,083). Prelim. Resp. 30; Ex. 1001, 1:8–16. In addition, Petitioner only presents a case for availability of the Slivka reference under pre-AIA § 102(e). Pet. 8; Prelim. Reply.

On this record, Petitioner does not establish a reasonable likelihood that the Slivka Appendices are "(1) an application for patent, published under section 122(b), . . . or (2) a patent granted on an application for patent." 35 U.S.C. § 102(e). Accordingly, the relied-upon Slivka Appendices do not qualify as prior art under § 102(e), as Petitioner asserts. *See* Pet. 8.

III. CONCLUSION

Each of Petitioner's invalidity contentions relies, in part, on disclosures from the Slivka Appendices, which Petitioner asserts qualify as prior art under § 102(e). Pet. 5. Because Petitioner has not established a reasonable likelihood of showing that the material it relies on was available as prior art at the time of the invention, we determine that the Petitioner has not satisfied its burden from the onset to show with particularity why the patent claims it challenges are unpatentable. 35 U.S.C. § 312(a)(3).

Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of any of claims 1–16 of the '083 patent under the asserted grounds, all of which rely on the Slivka Appendices.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review of claims 1–16 of the '083 patent is denied.

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