

IPR2023-00939 (U.S. Patent No. 8,510,407)
PO's Preliminary Response

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

DODOTS LICENSING SOLUTIONS LLC,
Patent Owner
Case IPR2023-00939
U.S. Patent No. 8,510,407

**PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR
INTER PARTES REVIEW OF UNITED STATES PATENT NO. 8,510,407**

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION.....	1
II. THE '407 PATENT.....	4
A. The background of the claimed invention.....	4
B. The previous Lenovo '407 IPR.	8
III. THE LEVEL OF ORDINARY SKILL IN THE ART.....	10
IV. CLAIM CONSTRUCTION.	11
V. THE SLIVKA REFERENCE.....	12
A. The prosecution of the Slivka patent.....	13
B. Availability of the Slivka application, the Slivka FH, and the Slivka appendices to the public.	14
VI. APPLE FAILS TO ESTABLISH THAT THE PRIMARY REFERENCE IT <i>ACTUALLY</i> RELIES ON IS 102(E) PRIOR ART.....	17
A. Apple fails to identify with particularity the grounds for challenging each claim and the evidence that supports each of those grounds.....	17
B. Apple fails to establish that the Slivka documents it relies on as its primary reference are §102(e) prior art.....	20
1. Slivka application is not §102(e) prior art.	20
2. The Slivka file history is not §102(e) prior art.	22
C. Apple fails to establish that the appendices are part of the patent or the patent application.	23
D. Even if the appendices were part of the unpublished application, the appendices are not 102(e) prior art.....	28

E.	The unavailability of the Slivka application and Slivka FH (along with the appendices) as §102(e) prior art is fatal to Apple's petition and necessitates its denial.....	30
VII.	PETITIONER FAILS TO MEET THE REQUIREMENTS OF §§37 C.F.R. 42.104(B)(3) AND 42.104(B)(4).....	31
VIII.	PETITIONER DOES NOT EXPLAIN ANY DEFECT IN THE EXAMINER'S PRIOR CONSIDERATION OF SLIVKA UNDER THE TWO-PART <i>ADVANCED BIONICS</i> FRAMEWORK APPLYING THE <i>BECTON DICKINSON</i> FACTORS.....	35
IX.	CONCLUSION.....	37

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,</i> IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020).....	3, 35, 36
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG,</i> IPR2017-01586, Paper 8, 17-18 (Dec. 15, 2017)	35, 37
<i>Benitec Biopharma Ltd. v. Cold Spring Harbor Laboratory,</i> IPR2016-00014, Paper 7 (P.T.A.B. Mar. 23, 2016)	36
<i>Carefusion Corporation v. Baxter International, Inc.,</i> IPR2016-01456, Paper 9 (P.T.A.B. Feb. 6, 2017).....	33, 34
<i>Clickbooth.com LLC v. Essociate, Inc.,</i> IPR2015-00464, Paper 9 (P.T.A.B. July 9, 2015)	32
<i>Duodecad IT Services Luxembourg S.A.R.L, et al. v. WAG Acquisition, LLC.,</i> IPR2015-01036, Paper 17 (P.T.A.B. October 20, 2016).....	22, 23
<i>Floteck Indus., Inc. v. Nat’l Oilwell DHT, L.P.,</i> IPR2015-01210, Paper 11 (P.T.A.B. Nov. 6, 2015).....	32
<i>Harmonic Inc. v. Avid Tech., Inc.,</i> 815 F.3d 1356 (Fed. Cir. 2016)	17
<i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.,</i> 821 F.3d 1359 (Fed. Cir. 2016)	17
<i>Lenovo Holding Co, Inc. et al. v. DoDots Licensing Sols.,</i> IPR2019-00988 (PTAB September 9, 2020).....	8
<i>Lenovo Holding Co. v. DoDots Licensing Sols. LLC,</i> 2021 U.S. App. LEXIS 36126 (Fed. Cir. Dec. 8, 2021).....	1, 5, 10
<i>Lindsay Corporation v. Valmont Industries,</i> IPR2015-01039, Paper 7 (P.T.A.B. Sept. 24, 2015).....	32

IPR2023-00939 (U.S. Patent No. 8,510,407)
PO's Preliminary Response

<i>Medshape, Inc. v. Cayenne Med., Inc.</i> , IPR2015-00848, Paper 9 (P.T.A.B. Sep 14, 2015).....	33
<i>Ex parte Miyazaki</i> , 89 U.S.P.Q.2d 1207 (BPAI Nov. 19, 2008)	33
<i>On Demand Mach. Corp. v. Ingram Indus.</i> , 2003 U.S. Dist. LEXIS 28275 (E.D. MO. 2003).....	29
<i>Phillips v AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (en banc)	11
<i>Riverwood Int'l Corp. v R.A. Jones & Co.</i> , 324 F.3d 1346 (Fed. Cir. 2003)	29
<i>SAS Institute, Inc. v. Complementsoft, LLC</i> , IPR2013- 00226 Paper 9 (P.T.A.B. Aug. 12, 2013).....	32
<i>Sequenom, Inc., v. The Board of Trustees of the Leland Stanford Junior University</i> IPR2014-00337, Paper 11 (P.T.A.B. July 16, 2014).....	21, 22

Statutes

35 U.S.C. § 102(e)	<i>passim</i>
35 U.S.C. § 112(f).....	31
35 U.S.C. §122.....	15, 21
35 U.S.C. § 282(b)	11
35 U.S.C. § 312(a)(3).....	17
35 U.S.C. § 316(e)	17
35 U.S.C. §325(d)	3

Other Authorities

37 C.F.R. §1.11(a).....	16, 23
37 C.F.R. §1.96	<i>passim</i>

37 C.F.R. § 42.100(b)	11
37 C.F.R. §42.104(b)	<i>passim</i>
65 FR 57024.....	15, 21

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	<i>Lenovo Holding Co, Inc. et al. v. DoDots Licensing Sols.</i> , IPR2019-00988 (PTAB Jan. 19, 2021)
2002	<i>Lenovo Holding Co. v. DoDots Licensing Sols. LLC</i> , 2021 U.S. App. LEXIS 36126, at *2 (Fed. Cir. Dec. 8, 2021)
2003	US Patent No. 6,061,695 ("Slivka") as granted and available from the USPTO Patent Center
2004	Slivka application made available by the USPTO Patent Center
2005	Document and Transaction history from USPTO Patent Center relating to the Slivka patent disclosing a "Request to Make of Record Noted Concerns in Granted Patent" letter sent by the Slivka patent owner
2006	Excerpts from prosecution history of '407 patent showing an IDS filed by the patent owner on March 4, 2013 (highlight added by Patent Owner)
2007	Excerpts from prosecution history of '407 patent showing Examiner's comments on the IDS filed by the patent owner on March 4, 2013 (highlights added by Patent Owner)
2008	Copy of the MPEP Chapter 600 and patent rules as they existed in 1996 when the application was filed
2009	Unabridged, prosecution history of the Slivka patent
2010	Claim construction order from Western District of Texas in <i>DoDots Licensing Sol'n LLC v. Samsung</i> , Case No. 6:22-CV-00535-ADA-DTG
2011	Transmittal Letter accompanying the Slivka patent application
2012	Defendants' Proposed Claim Constructions, dated March 1, 2023, in <i>DoDots Licensing Sol'n LLC v. Apple Inc., et al.</i> , Case No. 6:22-CV-00533-ADA-DTG

Patent Owner DoDots Licensing Solutions LLC (“DoDots” or “patent owner”) submits this Patent Owner Preliminary Response to Apple Inc.’s (“petitioner” or “Apple”) petition (Paper No. 2, “petition”) and requests the Board to deny institution of *inter partes* review of claims 1-16 of U.S. patent no. 9,369,407 (“the ’407 patent,” Ex. 1001).

I. Introduction.

Petitioner asks the Board to institute an inter partes review of the ’407 patent, which DoDots has asserted in a concurrently pending district court litigation. But this Board has once before determined that the ’407 patent is not unpatentable in a previous IPR brought by Lenovo Holding Co (“Lenovo ’407 IPR”). Ex. 2001. The Federal Circuit affirmed the Board’s final written decision. *See Lenovo Holding Co. v. DoDots Licensing Sols. LLC*, 2021 U.S. App. LEXIS 36126, at *2 (Fed. Cir. Dec. 8, 2021) (*attached* as Ex. 2002).

Apple’s attempt to have this Board adjudicate the validity of the ’407 patent once again should be denied for the reasons set forth below:

First, Apple cobbles together three separate documents and attempts to characterize them as a single §102(e) prior art reference. *See e.g.*, Petition at 7, 10. Specifically, while Apple argues that its primary reference is a patent called “Slivka,” a closer review of the petition shows that Apple is actually relying on (and citing to) three separate Slivka documents to construct its obviousness

argument: (i) U.S. Patent No. 6,061,695 (the “Slivka patent”); (ii) an unpublished patent application that matured into the Slivka patent (“Slivka application”); and (iii) the file history associated with the Slivka patent (“Slivka FH”). Apple without any support argues that these three documents should be treated collectively as a single §102(e) prior art reference. There is no basis for this conclusion because, as set forth below, the unpublished Slivka application *and* the Slivka FH are *not* (and cannot be) 102(e) references.

Apple’s obviousness argument is largely based on the contents of the appendices that were submitted with the Slivka application. Apple argues that the appendices teach several of the claim elements found in the independent claims of the ’407 patent. However, as discussed below, the appendices are not part of either the Slivka patent or the Slivka patent application. In fact, the appendices are not even included when a user obtains a copy of the Slivka patent from the USPTO Patent Center. The *only* way for the public to obtain the appendices is to order the Slivka FH. Moreover, the appendices themselves are not 102(e) prior art.

Ultimately, the unavailability of Slivka application or the Slivka FH (along with the appendices included in the Slivka FH) as §102(e) prior art is fatal to Apple’s petition and should lead to its denial.

Denial of the petition is warranted also because the petitioner fails to meet its threshold burden set forth in 37 C.F.R. §§ 42.104(b)(3), and 42.104(b)(4).

Petitioner has taken up contradictory and irreconcilable positions on claims terms in this proceeding and the district court. While arguing to the district court that a phrase in the '083 patent claims should be construed as a means-plus-function limitation, the petitioner in this petition fails to identify the structure corresponding to the claimed function, as required under 37 C.F.R. §§ 42.104(b)(3). While DoDots does not believe that the claims of the '083 patent contain any means-plus-function limitation, Apple's failure to set forth a construction it believes is correct (and has advocated for in the district court) and the failure to provide any support for the means-plus-function term are independent grounds for denial. This defect in the petition affects all challenged claims. The Board has consistently denied IPR petitions that fail to meet the threshold requirements set forth in 37 C.F.R. §§ 42.104(b)(3) and 42.104(b)(4).

Apple's petition should also be denied under 35 U.S.C. §325(d) because the Slivka patent was substantively considered by the PTO during prosecution of the '407 patent. Apple does not and cannot demonstrate otherwise. Likewise, Apple also has not shown any errors made by the patent examiner in applying the Slivka patent. The patent examiner's decision to allow the '407 patent after considering the Slivka patent should result in the denial of Apple's petition under *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020).

II. The '407 patent.

A. The background of the claimed invention.

In the late 1990s, more than seven years before the first iPhone was released, the inventors John and George Kembel (twin brothers and Stanford University alumnae) developed “dot” technology, which today is known as the mobile app. The '407 patent, titled “Accessing and displaying network content,” discloses the fundamental technology used in modern-day mobile apps and the stores used to download and install those apps onto mobile devices (e.g., Apple App Store and Samsung Galaxy Store).

At that time of the invention, accessing Internet content involved the use of downloaded web browsers running on a personal computer or mobile device. But web browsers were limiting and hindered the way in which web content was viewed on mobile devices. For example, users and application developers had limited control over the presentation of internet content; content was essentially trapped within the frame of the browser. *See* Ex. 1001 at 2:25-30. The Kembels recognized early on that there was dissatisfaction with web browsers and there was a “growing desire for individual users to fully control the aggregation and presentation of content and web applications that appear on a client computer.” *See Id.* at 2:30-36. The Kembels sought to eliminate the need for web browsers. To do so, they developed an approach of delivering content over the Internet outside a

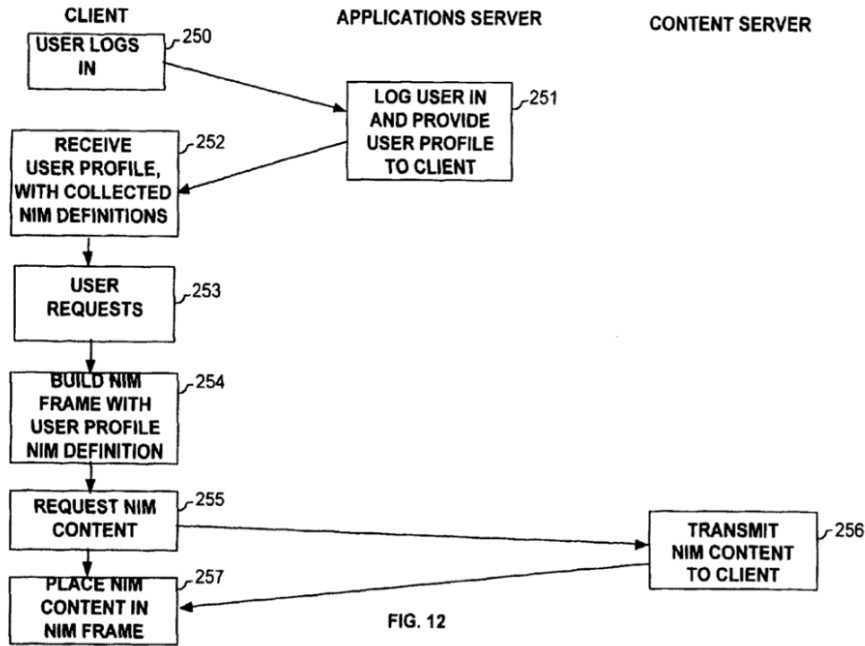
web browser. Notably, when the Kembels conceived of their patented technology, there was no word for mobile apps. So, the Kembels coined the terms “dot” or “Network Information Monitor (NIM)” —which today are colloquially referred to as an app. These “dots” are “fully configurable frame[s] with one or more controls” through which content is presented on the display of a device and viewed by the user. *See Id.* at 5:21-28.

At the time of invention described in the '407 patent (i.e., in the late 1990s), web browsers (e.g., Microsoft Internet Explorer, Netscape Navigator) were installed on computers and used to retrieve and display websites and their webpages. A person would manually navigate between the different webpages of a website by e.g., (1) entering a webpage in a URL entry field, or (2) using forward and backward browsing buttons to move between web pages. The '407 patent changed this paradigm.

As the Federal Circuit, DoDots' patents “relate to a method for accessing and displaying Internet content in a graphical user interface (“GUI”).” *Lenovo v. DoDots*, 2021 U.S. App. LEXIS 36126, at *2. The way the patented technology does that is to use a “Networked Information Monitor (NIM)” or “Dot” as a way to view content in a format other than the conventional web browser. The NIM or Dot (now mobile app) allowed for the display of content via a data structure that defined the characteristics of the Dot called a “NIM template.” *Id.*

The NIM (mobile app), which is generated by the NIM template, is a “fully configurable frame with one or more controls; the frame through which content is optionally presented. The configurable frame used in accordance with the invention 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.” Ex. 1001 at 5:24-28. And a NIM developer (*i.e.*, Mobile App Developer) “has full control over all aspects of the appearance and functionality of NIM frame 137. Thus, a NIM developer has the ability to control, for example, the functionality located at any corner of frame 137, functionality placed along the top or bottom of the frame, or on the sides of the frame.” *Id.* at 17:32-37. Such customizability provided added flexibility over traditional web browsers.

Figure 12 of the '407 patent further describes how a NIM template is delivered to user's device to eventuate the installation of a NIM (*i.e.*, an app):



Id. at Fig. 12. The process is similar to how users today download and execute apps from the Apple App Store. Specifically, a NIM template is transmitted by TCP/IP to define the Dot that will receive content and interaction for a user over a network. When the user “clicks on the name of a NIM” [i.e., the name of the app], a request is sent “to the applications server 50 via the transmission channel 44 (step 241).” *Id.* at 20:8-13. The client computing device then retrieves the NIM definition from the NIM template database” (app store), installs the app using information in the .apk file (NIM template) and, when the user runs the app, creates a frame in the display of the user interface. *Id.* at 20:18-42. Put another way, the patent lays out the process for delivering both the data defining the

creation of a NIM and also retrieving the content to be displayed within the frame of the NIM.

B. The previous Lenovo '407 IPR.

The Board previously considered the validity of the '407 patent in *Lenovo Holding Co, Inc. et al. v. DoDots Licensing Sols.*, IPR2019-00988 (PTAB September 9, 2020) (attached as Ex. 2001). There, the Board found that the '407 patent discloses, in part, a software component for accessing and displaying network content. *See* Ex. 2001 at 4. 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.* When a user opens a Dot, the frame is presented in the user’s display, and network content is retrieved and presented in a viewer enclosed by the frame. *Id.* A “NIM template” defines the characteristics of a specific NIM, including fully configurable frame characteristics, viewer and control characteristics, and NIM content references. *Id.*

One key dispute in the prior Lenovo IPR proceeding related to the construction of the term “networked information monitor template” (“NIM template”). The Board concluded (and the Federal Circuit affirmed) that this term means “a data structure that defines the characteristics of a NIM, including the NIM frame, view, and control characteristics, which excludes executable applications/compiled code.” *See.*, Ex. 2001 at 14, *See also.*, Ex. 2002. Though the

construction itself is important, the reasons for reaching this construction are equally important.

The Board noted that according to the specification, claims, and prosecution history, a NIM template is a data structure that defines the characteristics of a NIM, including the NIM frame, view and control characteristics, and that excludes executable applications/compiled code. *See Id.* at 13-14. According to the claims, the NIM template, stored in electronic storage of a client computing device (1.A), includes the definition of a NIM (1.C) / “viewer graphical user interface having a frame.” *See Id.* at 14.

Though the Board noted that the meaning of a NIM template is not specifically defined in the '407 patent specification, the patent makes clear that each NIM template “defines the characteristics of a specific NIM, including fully configurable frame characteristics, view and control characteristics, and NIM content references.” *Id.*

The Board acknowledged that the '407 specification, “does not indicate that the data structure for the NIM template contains compiled code.” *Id.* at 15. As a result, the Board agreed that the definition of a NIM “is content, rather than compiled code.” *Id.* at 16. The Board further noted that the specification’s teaching that “[a]n application-type NIM, such as a web calendar or web mail, may be changed by the user, by the content provider, or by other content, while

advantageously avoiding the need to distribute and support a hard-coded compiled application.” *Id.*

The Board concluded that “[f]rom these disclosures, we understand that the Specification prohibits the NIM template from using compiled code or being an executable application. Our review of the Specification did not identify disclosure of use of compiled code or an executable application as the NIM template.” *Id.* at 15. In summarizing its position, the Board stated, “[t]he Specification does not describe any NIM template that uses compiled code or executable applications.” *Id.* at 18. Rather, the Specification provides that “each NIM Definition contains just enough information to define, layout, and initialize a NIM’s components (frame, controls, etc.)” and “the definition is content, rather than compiled code.” *Id.*

Based on its constructions, the Board found that the prior art Lenovo relied on did not render the ’407 patent unpatentable. The Federal Circuit affirmed the Board. *See Lenovo v. DoDots*, 2021 U.S. App. LEXIS 36126.

III. The level of ordinary skill in the art.

In the Lenovo ’407 IPR, the Board found that a person of ordinary skill in the art “would have a bachelor’s degree in electrical or computer Engineering, Computer Science, or a related field and have three or more years of corresponding

industry work experience.” Ex. 2001 at 9. DoDots agrees that this is the correct standard for a POSITA and adopts it for this IPR.

IV. Claim construction.

In an *inter partes* review, claims are “construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b), including construing the claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b). The proper claim construction standard is the one set forth in *Phillips v AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

With respect to the '407 patent, this Board, the Court of Appeals, Federal Circuit and the United States District Court, Western District of Texas have already construed some of the claim terms. DoDots adopts each of the prior claim construction Orders for this IPR.

For completeness, a copy of the District Court's claim construction order in the co-pending litigation against Samsung is attached as Ex. 2010. Patent Owner has not made any arguments based on the District Court's claim construction in this document but expressly reserves the rights to do so in any further proceedings as appropriate.

V. The Slivka reference.

Apple's petition describes its grounds of invalidity using the following table and identifies its primary reference as "Slivka":

Proposed Grounds of Unpatentability	
<u>Ground 1</u>	Claims 1-4, 6-11, 13-16, and 18-23 are obvious under pre-AIA 35 U.S.C. § 103(a) over <i>Slivka</i> in view of <i>Powell</i>
<u>Ground 2</u>	Claims 5 and 17 are obvious under pre-AIA 35 U.S.C. § 103(a) over <i>Slivka</i> in view of <i>Powell</i> and <i>Votipka</i>
<u>Ground 3</u>	Claims 12 and 24 are obvious under pre-AIA 35 U.S.C. § 103(a) over <i>Slivka</i> in view of <i>Powell</i> and <i>Anabuki</i>

Petition at 7.

Though the above table states that Apple is relying on a patent called Slivka, a closer review of the petition, however, shows that Apple actually relies on *three separate Slivka documents* in both Grounds 1 and 2—specifically, Apple relies on (i) the Slivka patent; (ii) the unpublished Slivka application; and (iii) the Slivka file history. Apple suggests that these three documents—Slivka patent, Slivka application, and Slivka FH—should be treated collectively as a single §102(e) prior art reference.¹ The reasons behind Apple's attempt to blur the nature of its

¹ In its petition, Apple argues that the Slivka patent is §102(e) prior art. *See* Petition at 10 (stating "*Slivka* was filed December 6, 1996 and issued May 9, 2000, qualifying as prior art at least under 35 U.S.C. §102(e)(pre-AIA).") Apple does not argue that the Slivka patent (and for that matter, either the Slivka application or the Slivka FH) qualify as prior art under any other §102 section. For that reason, this POPR will set forth arguments only on why the Slivka application and the Slivka FH are not prior art references under §102(e).

primary reference becomes apparent upon review of how the Slivka application was submitted, what the Slivka patent includes and, more importantly, what the Slivka patent does not include, and when each of the three Slivka documents were available to the public.

A. The prosecution of the Slivka patent.

The Slivka application was filed on December 6, 1996. The application was accompanied by a transmittal letter that, among other things, stated the following:

Transmitted herewith for filing is the patent application of:
Inventors: Benjamin W. Slivka, Teresa Martineau, Christopher Ralph Brown, George Pitt, Satoshi Nagajima, Sankar Ramasubthamanian, Mike Sheldon
For: OPERATING SYSTEM SHELL WITH HYPERTEXT DESKTOP
Enclosed are:
[X] 34 pages of specification, 4 pages of claims, an abstract, an unsigned Combined Declaration and Power of Attorney and 177 pages of appendices.

Exs. 2009 and 2011 (highlights added).

The transmittal letter that accompanied the Slivka application notes that the application contains “34 pages of specification, 4 pages of claims, an abstract, an unsigned Combined Declaration *and* Power of Attorney and 177 pages of appendices.” *Id.* The 177 pages of appendices contain twenty separate appendices. Appendices A, C, D, E and F, which form the backbone of Apple’s petition, set forth code for an HTM file.²

² An HTM file “is a webpage written using Hypertext Markup Language (HTML).” *See generally* <https://fileinfo.com/extension/htm>.

- Appendix A is a 2-page printout of a HTML file titled “DESKTOP.HTML”
- Appendix C is a 3-page printout of a HTML file titled “INFOPANE.HTML”
- Appendix D is a 2-page printout of a HTML file titled “NEWS.HTML”
- Appendix E is a 1-page printout of a HTML file titled “TICKER.HTML”
- Appendix F is a 1-page printout of a HTML file titled “TICKHOST.HTML”

These statements evince Slivka's intention that the 177 pages of appendices, which includes Appendices A, C, D, E and F that Apple relies on to construct its invalidity arguments, are separate from the patent specification. *Id.*

Indeed, the transmittal letter shows Slivka did *not* take any of the steps required by 37 C.F.R. §§1.96(a) and (b) to submit the appendices relating to computer program listings with the Slivka application. *Id.* Specifically, 37 C.F.R. §1.96 requires computer program listings to be submitted as drawings or as part of the specification (by positioning the printed copies of appendices between the specification and the claims) or submitting computer printout sheets for use as camera ready copy when a patent is subsequently printed or as a microfiche. Ex. 2008 at 21-22.

B. Availability of the Slivka application, the Slivka FH, and the Slivka appendices to the public.

The Slivka application was *never* published because 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” did not become effective until November 29, 2000. *See* 65 FR 57024 (Changes to Implement Eighteen-Month Publication of Patent Applications effective November 29, 2000 discussing amendments to 35 U.S.C. §122(b)(1)). Moreover, on or after November 29, 2000, the Slivka application remained unpublished under 35 U.S.C. §122 in view of the rule that “an application shall not be published if that application is no longer pending.” *See* 35 U.S.C. §122(b)(2)(i). Given that the Slivka patent issued on May 9, 2000, the Slivka application was “no longer pending” on or after November 29, 2000 and therefore was never published. *Id.*

The first publication of anything related to Slivka was the Slivka patent itself on May 9, 2000, approximately thirteen months *after* the effective filing date of the '407 patent (i.e., April 26, 1999). But as published, the Slivka patent did *not* include any of the appendices, including appendix A, C, D, E and F. *See* Ex 1001. Indeed, to this day, the appendices are not included with the Slivka patent when the Slivka patent is obtained from the USPTO Patent Center. *See* Ex. 2003.

Moreover, today, while the Slivka application is one of two documents accessible online as part of the file history, it does not include a copy of any appendix (including appendices A, C, D, E, and F). *See* Exs. 2004 and 2005. It appears that the Slivka patent owner sent a “Request to Make of Record Noted Concerns in Granted Patent” on March 1, 2001. *See* Ex. 2005. This request is not

available publicly and, therefore, the public has no way to determine what the purported concerns were. *Id.* The request, however, neither resulted in a certificate of correction to the granted patent nor resulted in a change to the patent application that is available for download today from the USPTO Patent Center. *See* Ex 2003, and Ex. 2004. Indeed, the patent office did not even make the “Request to Make of Record Noted Concerns in Granted Patent” part of the file history. *Id.* The end result is that neither the Slivka patent application as filed nor the Slivka patent included the appendices. *Id.*

The only way for the public to obtain a copy of the appendices submitted with the Slivka application is to obtain a copy of the patent file history. *See* Ex. 2009. But, as per 37 C.F.R. §1.11(a), the Slivka FH can become “open to inspection by the public” only upon the issuance of the Slivka patent. In other words, the Slivka FH (and, therefore, the appendices) was *not* available to the public until at least May 9, 2000, which is 13 months *after* the April 26, 1999 effective filing date of the '407 patent.³

³ In its petition, Apple fails to provide any evidence on when the Slivka FH was available to the public. DoDots, therefore, assumes that 37 C.F.R. §1.11(a) was followed and the Slivka FH was available to the public on or after the issuance of the Slivka patent on May 9, 2000.

VI. Apple fails to establish that the primary reference it *actually* relies on is 102(e) prior art.

Apple bears the burden of proving obviousness in this IPR pursuant to 35 U.S.C. § 316(e). To do so, Apple must establish that each of the references it relies on – the Slivka patent, the Slivka application, and the Slivka FH - qualify as prior art under §102(e) to the '407 patent.

A. Apple fails to identify with particularity the grounds for challenging each claim and the evidence that supports each of those grounds.

An IPR petition must identify “*with particularity*, each claim challenged, *the grounds on which the challenge to each claim is based*, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3)(emphasis added); *see also* 37 C.F.R. §42.104(b) (specifying necessary elements of a petition). As the Federal Circuit explained, “[i]t is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)). *See also* *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (stating “[i]n an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable”).

Apple fails to meet this threshold burden here by, among other things, (i) failing to identify which portion of *Slivka* it relies on for its invalidity argument and (ii) whether each of the three *Slivka* documents it relies on—the *Slivka* patent, the unpublished *Slivka* application, and the *Slivka* FH—qualifies as prior art under either §102(e)(1) or (e)(2). In fact, the petition attempts to treat the three separate *Slivka* documents as a single reference. This is improper. Though convenient for Apple to combine these three separate documents and consider them to be a single §102(e) reference, it is erroneous to do so because, as discussed in the following sections, the unpublished *Slivka* application *and* the *Slivka* FH are *not* 102(e) references.

As an initial matter, Apple's description of its two grounds of unpatentability is misleading. Page 7 of the petition describes the three grounds in the following way:

Proposed Grounds of Unpatentability	
<u>Ground 1</u>	Claims 1-4, 6-11, 13-16, and 18-23 are obvious under pre-AIA 35 U.S.C. § 103(a) over <i>Slivka</i> in view of <i>Powell</i>
<u>Ground 2</u>	Claims 5 and 17 are obvious under pre-AIA 35 U.S.C. § 103(a) over <i>Slivka</i> in view of <i>Powell</i> and <i>Votipka</i>
<u>Ground 3</u>	Claims 12 and 24 are obvious under pre-AIA 35 U.S.C. § 103(a) over <i>Slivka</i> in view of <i>Powell</i> and <i>Anabuki</i>

But contrary to the impression it creates, Apple does not rely on a single *Slivka* document in Grounds 1, 2 or 3. Instead, Apple's petition actually relies on three separate sets of *Slivka* documents: the *Slivka* patent, the *Slivka* application, and the

Slivka FH. Therefore, Apple's Ground 1 is more accurately characterized as the Slivka patent in view of the Slivka application, the Slivka FH, and Powell.

Likewise, Ground 2 is more accurately characterized as the Slivka patent in view of the Slivka application, the Slivka FH, Powell, and Votipka. Ground 3 should be characterized as the Slivka patent in view of the Slivka application, the Slivka FH, Powell, and Anabuki.

Apple's failure to meet its threshold burden is further compounded by the fact that the petition does not even identify the specific 102(e) provision (i.e., 102(e)(1) or (e)(2)) under which the three Slivka documents supposedly qualify as prior art. The petition also does not meet the other requirements for establishing that the three Slivka documents are 102(e) references. Specifically, Apple is required to set forth (i) the effective filing date for each of these three separate documents, (ii) whether the Slivka patent as granted contains the same subject matter as the unpublished Slivka application, Slivka file history, or both, (iii) the statutory basis for asserting Slivka, the Slivka application, and/or the Slivka FH as §102(e) prior art against the '407 patent; and (iv) stating how a disclosure in the Slivka patent is entitled to the filing date of the Slivka application if the subject matter of the appendices is missing in one or both of either the Slivka application or the Slivka patent. *See* MPEP 2136 (requiring determination of the appropriate pre-AIA 35 U.S.C. 102(e) date for each potential reference where each application,

each priority document, and the patents issuing therefrom are treated as separate documents, and the examples show instances where an application may not have a 102(e) effective date at all).

Apple's petition is silent with respect to each of these points above, leaving DoDots and the Board to guess Apple's theory on how each of the three categories of the Slivka documents qualifies as prior art. Additionally, the Board and DoDots must also guess the nature of the specific prior art theories the petitioner relies on in its petition. These failings and fundamental omissions in Apple's petition necessitate the denial of Apple's petition.

B. Apple fails to establish that the Slivka documents it relies on as its primary reference are §102(e) prior art.

Apple's petition argues that the appendices submitted along with the Slivka specification teach certain of the elements in claim 1 of the '407 patent. *See, e.g.*, Petition at 9, 11-17, 29, 44, 49, 55-56, and 65. But Apple fails to show that the unpublished Slivka application and the Slivka FH, which includes the appendices (namely, A, C, D, E and F), are prior art under §102(e)(1) or §102(e)(2). Patent Owner and the Board must now guess, when it is clearly not their burden to do so.

1. Slivka application is not §102(e) prior art.

Apple cannot identify which 102(e) provision covers the unpublished Slivka application or the appendices because neither are prior art under §102(e). The

Board's decision in *Sequenom, Inc., v. The Board of Trustees of the Leland Stanford Junior University* IPR2014-00337, Paper 11 (P.T.A.B. July 16, 2014) is instructive in this regard.

In *Sequenom*, the Board noted *only* “[t]wo types of documents may be relied upon under §102(e) to show that claims are unpatentable, (1) an application for patent, published under 35 U.S.C. §122(b), . . . or (2) a patent granted on an application for patent.” *Id.* at 3 (internal citations omitted). Here, neither the Slivka application nor the twenty appendices are an application for patent published under 35 U.S.C. §122(b). As discussed above, the Slivka application was *never* published because 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. *See* 65 FR 57024; 35 U.S.C. §122(b)(1).

Likewise, the Slivka application and appendices certainly are not a patent granted on an application for a patent under 35 U.S.C. § 102(e). For this reason and as in *Sequenom*, neither the unpublished Slivka application nor the unpublished appendices qualify as 102(e) references. Accordingly, because the unpublished Slivka application and appendices are not prior art under §102(e), Apple's petition should be denied.

2. The Slivka file history is not §102(e) prior art.

Apple attempts to circumvent the §102(e) requirements by arguing that the entire Slivka file history, which includes the Slivka application and the appendices, is a 102(e) reference. This argument is nonsensical because a file history is a collection of documents as opposed to a single document; at best, the documents comprising a file history can only be a printed publication. The Slivka FH, therefore, *can never be* §102(e) prior art because the collection of documents in a file history is neither an application for a patent published under section §122(b) nor a granted patent. *See Sequenom, supra*.

The Board's decision in *Duodecad IT Services Luxembourg S.A.R.L, et al. v. WAG Acquisition, LLC.*, IPR2015-01036, Paper 17 (P.T.A.B. October 20, 2016) is also instructive. In *Duodecad*, the patent owner argued that a patent file history is not prior art. Though dismissing this argument, the Board provided clarity on how and when a file history becomes prior art. Specifically, the Board noted that a file history qualifies as a "printed publication" when it becomes publicly available. *Id.* at 18-19. In support of this argument, the Board agreed with the petitioner that a "application file wrapper of a U.S. patent or U.S. application publication may be used a prior art as of the patent or publication date, respectively, in that it then constitutes prior public knowledge or prior public availability" under MPEP 901.01 and MPEP 2127. *Id.* at 17.

Though the Slivka FH can never be §102(e) prior art, per *Duodecad*, the Slivka FH can qualify as prior art as a “printed publication” only when it becomes available to the public. Here, Apple has failed to provide any evidence that the Slivka FH was publicly available before the Slivka patent issued on May 9, 2000. Nor can Apple provide any such evidence because, under 37 CFR §1.11(a), the Slivka file history only became “open to inspection by the public” as of the date the Slivka patent issued on May 9, 2002 (i.e., thirteen months *after* the April 26, 1999 effective filing date of the '407 patent).

For this reason, not only is the Slivka file history not a §102(e) reference, it is also unavailable as prior art under any other §102 provision. Petitioner, therefore, has not carried its burden to show that the documents it relies on (namely, the Slivka application and the Slivka FH) are actually prior art and for at least this reason, the petition should be denied.

C. Apple fails to establish that the appendices are part of the patent or the patent application.

There is no dispute that the appendices were *not* published along with the Slivka patent. Even today, a member of the public cannot obtain the appendices by simply downloading the Slivka patent from the Patent Center. This is further confirmed by the fact that Apple's attachment of the Slivka patent to its petition as Ex. 1001 does not include the appendices. Indeed, the petition is conveniently

silent on these appendices not being part of the Slivka patent publication. Petition at 10.

The appendices are only found as part of the Slivka FH. Apple's own submission verifies this because Apple only includes the appendices in the copy of file history it provides as Ex. 1002. Apple's petition, however, is silent on where the petitioner or the Board can access these appendices. Apple has failed to meet its burden in this regard as well.

As mentioned above, the reality is that the appendices were submitted separately from the specification and even the Slivka applicant did not consider them as part of the specification as seen from the relevant portion of the transmittal (reproduced below):

Transmitted herewith for filing is the patent application of:

Inventors: Benjamin W. Slivka, Teresa Martineau, Christopher Ralph Brown, George Pitt, Satoshi Nagajima, Sankar Ramasubthamian, Mike Sheldon

For: OPERATING SYSTEM SHELL WITH HYPERTEXT DESKTOP

Enclosed are:

- [X] 34 pages of specification, 4 pages of claims, an abstract, an unsigned Combined Declaration and Power of Attorney and 177 pages of appendices.**
- [X] 7 sheet(s) of formal drawings.**

Exs. 2009 and 2011 (highlights added).

Moreover, the appendices cannot be considered part of the Slivka application because Slivka failed to comply with MPEP 608.05 and 37 C.F.R.

1.96, which set forth the specific steps an applicant is required to take when depositing computer program listings with a patent application.

The “BACKGROUND” section of MPEP 608.05 states, “[a] computer program listing, as used in these rules, means the printout that lists, in proper sequence, the instructions, routines, and other contents of a program for a computer.” *See* Ex. 2008 at 600-88. In this case, appendices A, C, D, E and F are “computer program listing[s]” because they list instructions or routines of a HTML program.

MPEP 608.05 further provides, “[t]he general description of the computer program listing will appear in the specification while computer program listing may appear either directly or as a microfiche as appendix to the specification and be incorporated into the specification by reference.” *Id.* 37 C.F.R. §1.96(a) tracks MPEP 608.05 and specifies the manner in which an applicant must submit a “computer program listing,” such as Slivka’s appendices A, C, D, E and F. Section 1.96(a) states 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.” Ex. 2008 at 600-87. Section 1.96(b) states that “[i]f a computer program listing printout is 11 or more pages long, applicants may submit such listing in the form of microfiche...” *Id.* In Slivka, each of appendices A, C, D, E and F are contained on ten printout pages or less. Yet, Slivka neither submitted the

appendices as a drawing nor as part of the specification. Moreover, Slivka did not submit the computer program listing by way of a microfiche.⁴ In fact, the transmittal letter expressly identifies the appendices as being submitted *separate from* the “34 pages of specification.” Ex. 2011. Simply put, there is no record showing that before grant of the patent, Slivka made any request asking that the appendices be treated as part of the specification or take any measures to incorporate the appendices into drawings or weave them into the specification via amendments. Further, as mentioned above, though it appears that the patent owner sent a “Request to Make of Record Noted Concerns in Granted Patent” on March 1, 2001, the request is not available in the file history and, therefore, there is no way to determine what the purported concerns were. And there is no certificate of correction included with the Slivka patent.

In view of Slivka’s failure to comply with MPEP 608.05 and 37 CFR 1.96, the Slivka patent does not include the “computer program listing” appendices, including appendices A, C, D, E and F. As a result, the appendices that Apple

⁴ Even if Slivka’s “computer program listing” is deemed to be over ten pages, Slivka still failed to comply with the regulatory requirements. Specifically, 37 CFR 1.96(b) notes that “[i]f a computer program listing printout is 11 or more pages long, applicants may submit such listing in the form of microfiche, referred to in the specification (see § 1.77(c)(2)). Such microfiche filed with a patent application is to be referred to as a microfiche appendix.” There is no indication that the Slivka applicants submitted their “computer program listing” in the required microfiche format.

relies on cannot be used as prior art references to the '407 patent because appendix A, C, D, E and F were not publicly available until at least May 9, 2000, nearly thirteen months after the priority date of the '407 patent.

Apple's petition states in a conclusory manner that "Slivka's specification incorporates several appendices stamped with the filing date, December 6, 1996..." and, therefore, the appendices are part of the "entire disclosure of the [Slivka] patent and...can be relied on to reject the claims." Petition at 10 (citing to MPEP §2136.02). But the falsity of this statement is clear and readily apparent because Apple can only cite to the Slivka FH and not to the patent or patent application to support its say-so contention. *Id.* And the Slivka FH does not support Apple's bare assertion. The fact is, the Slivka application does not incorporate the appendices because the Slivka applicant *expressly* noted that the appendices were being submitted separate from the specification. *See* Ex. 2007. Additionally, as indicated above, the appendices were submitted in a manner that does not comply with the requirements under 37 CFR §1.96 for submitting "computer program listings."

Moreover, a review of MPEP 2136.02 shows that it undercuts Apple's assertions and actually support DoDots's position. MPEP 2136.02 expressly provides, "[w]hen a U.S. patent, a U.S. patent application publication, or an international application publication 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 or application publication.” This MPEP section confirms that only a U.S. patent, a U.S. patent publication or an international application publication can be used to reject claims under §102(e). In other words, contents of a file history (such as the appendices here) cannot be properly relied upon to reject claims under §102(e). The foregoing language also notes that the disclosure relied upon “must be present in the issued patent or application publication.” As already explained, the appendices are not “present” in either the Slivka patent or the unpublished Slivka application. Moreover, Apple’s citation in its petition to the Slivka FH as opposed to the patent or patent application when discussing the appendices is further evidence that the appendices are not “present” in the Slivka patent or the unpublished Slivka application.

For at least these reasons and contrary to the petitioner’s position, the Slivka specification does not incorporate the appendices and the petition should be denied.

D. Even if the appendices were part of the unpublished application, the appendices are not 102(e) prior art.

That the patent office did not print any of the computer-code appendices between the specification and claims or with the issued Slivka patent or include a reference to microfiche or another location where the public can access the

appendices demonstrates that the applicant did not comply with 37 C.F.R. 1.96, and that the appendices are not part of the Slivka unpublished application or ultimately the Slivka patent. Moreover, in *Riverwood Int'l Corp. v R.A. Jones & Co.*, 324 F.3d 1346, 1354 (Fed. Cir. 2003), the Federal Circuit noted that where an application “was *not available to the public*,” among other things, it was not prior art under any statutory provision.⁵ (emphasis added) (citing to *In re Ehrreich*, 590 F.2d 902 (CCPA 1979)); *see also On Demand Mach. Corp. v. Ingram Indus.*, 2003 U.S. Dist. LEXIS 28275 (E.D. MO. 2003) (acknowledging the *Riverwood* decision).

Here, the Slivka application was never published. Moreover, the Slivka FH, which is the only location of the appendices, was only available to the public on or after May 9, 2000, at least thirteen months after the '407 patent's effective filing date. Therefore, as in *Riverwood*, even assuming the appendices are part of the unpublished Slivka application (which they are not), the unpublished appendices became available as prior art only on or after May 9, 2000, and cannot qualify as §102(e) prior art.

For at least this reason, a denial of Apple's petition is warranted.

⁵ The *Riverwood* court found that the application was not prior art also because it was “not the work of another.” *Riverwood Int'l Corp.*, 324 F.3d at 1354. This situation is, however, not present in and not relevant to this case.

E. The unavailability of the Slivka application and Slivka FH (along with the appendices) as §102(e) prior art is fatal to Apple's petition and necessitates its denial.

Apple and its expert Dr. Loren Terveen argue that appendices A, C, D, E and F disclose several elements in claims 1 and 13 (the only two independent claims) of the '407 patent. Specifically, the petition and the supporting expert declaration rely on the appendices and the code disclosed in those appendices for at least the following elements of the independent claims:

- "...networked information monitor template associated with a networked information monitor, the networked information monitor template having therein a definition of a viewer graphical user interface having a frame within which time-varying content in a web browser-readable language may be presented..." Ex. 1003 at 58-69; Petition at 25-29.
- "...accessing the networked information monitor defined by the networked information monitor template..." Ex. 1003 at 106; Petition at 61.

Aside from the Slivka appendices, Apple's petition does not argue that other prior art documents purportedly also disclose the features recited in the foregoing claim elements. Consequently, once the Slivka application and the Slivka FH (along with the appendices it includes) are rejected as §102(e) prior art (for reasons set forth above), Apple cannot meet its burden under 37 CFR §42.104(b)(4) requiring that the petition "specify where each element of the claim is found in the

prior art patents or printed publications relied upon” The unavailability of the Slivka application and Slivka file history as §102(e) prior art is, therefore, fatal to Apple’s petition and necessitates denying Apple’s petition.

VII. Petitioner fails to meet the requirements of §§37 C.F.R. 42.104(b)(3) and 42.104(b)(4).

42.104(b)(3) requires Petitioner to provide a statement detailing “[h]ow the challenged claim is to be construed.” This provision also requires, “[w]here the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.” As is apparent, 42.104(b)(3) compels the petitioner to (1) set forth how the challenged claim is to be construed; and (2) when a claim contains a means-plus-function, the construction must identify the specific portion of the specification that describes the structure for each claim function. Here, Apple fails to meet either of these prerequisites in its petition.

In the concurrently-pending district court litigation, Petitioner argued that the phrase “computer program modules being configured to access the networked information monitor defined by the networked information monitor template” found in claim 1 of the ‘407 patent (and all claims depending on claim 1) is both a

means plus function claim element and indefinite.. See Ex. 2012, pg. 4. And, to date, Apple has not disavowed this position that the foregoing phrase should be construed as a means-plus-function limitation. But despite its position in the pending litigation that this phrase is a means-plus-function limitation, Apple does not identify “the specific portions of the specification that describe the structure corresponding to each claimed function,” as § 42.104(b)(3) requires.

Petitions that fail to identify corresponding structure in the specification are consistently denied under 37 C.F.R. §§ 42.104 (b)(3). *See e.g., Floteck Indus., Inc. v. Nat’l Oilwell DHT, L.P.*, IPR2015-01210, Paper 11 at 8-9 (P.T.A.B. Nov. 6, 2015); *Lindsay Corporation v. Valmont Industries*, IPR2015-01039, Paper 7 at 11 (P.T.A.B. Sept. 24, 2015); *SAS Institute, Inc. v. Complementsoft, LLC*, IPR2013-00226, Paper 9 at 11 (P.T.A.B. Aug. 12, 2013) (“SAS does not identify what structure in the Specification it believes corresponds to the means-plus-function limitation of claim 11. This failure is fatal to SAS’s challenge of claims that include that limitation.”); *Clickbooth.com LLC v. Essociate, Inc.*, IPR2015-00464, Paper 9 at 12 (P.T.A.B. July 9, 2015) (“As such, Petitioner fails to identify corresponding structure for any of the means-plus-function limitations and, therefore, fails to comply with 37 C.F.R. § 42.104(b)(3). Accordingly, we decline to institute *inter partes* review [of the challenged claims].”).

Moreover, to proclaim that a limitation is definite in an IPR and indefinite in a district court case is impossible to reconcile with the fact that the Board employs a “*lower threshold* of ambiguity when determining indefiniteness” than district courts. See *Ex parte Miyazaki*, 89 U.S.P.Q.2d 1207, 1211 (BPAI Nov. 19, 2008)(precedential)); See also *Medshape, Inc. v. Cayenne Med., Inc.*, IPR2015-00848, Paper 9 at 8 (P.T.A.B. Sep 14, 2015) (denying institution on claims) (“A claim term that does not satisfy the definiteness requirement under *Nautilus* likewise fails to satisfy the definiteness requirement of *Miyazaki*.”).

And further, petitioner provides no reason for abandoning its litigation claim construction positions in its petition. This is particularly problematic because even though the same claim construction standard applies in both forums, petitioner makes no effort to justify the abandonment of its indefiniteness means-plus-function district-court construction and the contradictions in its approach here. Instead, petitioner ignores that issue altogether in the petition. Petitioner’s failure to take ownership of its competing and contradictory claim constructions here and in the district court is sufficient reason alone to reject the Petition in its entirety. In *Carefusion Corporation v. Baxter International*, the Board found that this approach was insufficient and denied institution:

We agree with Patent Owner that Petitioner has failed to provide a sufficient statement of how the challenged claims are to be construed as required by 37 C.F.R. § 42.104(b)(3). Petitioner states that it relies

on constructions advanced by Patent Owner in the related litigation; remarkably, however, Petitioner also states that it does not agree that those constructions are in fact correct. See Petition at 9. *As such, Petitioner has failed to indicate that it agrees with, proposes, or adopts the constructions attributed to Patent Owner. See Toyota Motor Corp. v. Blitzsafe Texas, LLC*, Case IPR2016-00422, slip op. at 26–27 (P.T.A.B. Jul. 6, 2016) (Paper 12).

Carefusion Corporation v. Baxter International, Inc., IPR2016-01456, Paper 9 at 7 (P.T.A.B. Feb. 6, 2017) (emphasis added).

Further, in *Carefusion Corp.*, the Board saw through petitioner's equivocating on indefiniteness in the district court and agreed with the patent owner's position, noting that petitioner failed to identify "the structure, material, or acts corresponding to the claimed function" and holding that "[p]etitioner's assertion that the claim terms are indefinite [in the district court] does *not* excuse [p]etitioner's failure to provide the required claim construction" under 37 C.F.R. § 42.104(b)(3). *Carefusion Corporation v. Baxter International, Inc.*, IPR2016-01456, Paper 9 at 8-9.

Petitioner here certainly does not agree with the patent owner's proposed constructions, nor does it adopt DoDots' constructions other than for the purposes of this IPR only. Petitioner's failure to address its district court means-plus-function and indefiniteness construction and the ambiguities in its positions here, and failure to identify corresponding structure warrant denial of the petition.

Indeed, Apple's petition —where there is no stipulated construction, no Board-sanctioned claim construction, no citations to the '407 patent, and no argument or explanation in favor of the constructions presented—is a model of how *not* to meet the standard set forth in § 42.104(b)(3). This is reason enough to deny the petition in its entirety.

VIII. Petitioner does not explain any defect in the examiner's prior consideration of Slivka under the two-part *Advanced Bionics* framework applying the *Becton Dickinson* factors.

As Apple's petition acknowledges, the examiner considered Slivka during prosecution of the application that resulted in the '407 patent. *See* Petition at 5; *See also* Exs. 2006 and 2007 (highlights added by DoDots for ease of reference). Each page of the IDS includes a statement in all caps at the bottom from the Examiner Kenny Lin indicating, “[A]LL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /KL/” Ex. 2007 at 1-4. Notably, the Slivka reference, found on the first line of page 2 of 4 of the IDS, does not contain a line through it, thereby, clearly indicating that Examiner Lin substantively considered the Slivka reference during prosecution of the '407 patent. *Id.* at 2. Indeed, the first reference listed on page 1 of 4 of the IDS (Franco) was crossed out by the examiner indicating that he did not consider this reference. *Id.* at 1.

Petitioner tries to downplay this critical fact by arguing (contrary to express evidence) that the “examiner did not substantively discuss Slivka when evaluating

the Challenged Claims” Petition at 5. It is worthwhile noting that Apple cannot argue or even suggest that the Slivka references was not substantively considered by the examiner during prosecution. All Apple can argue is that the Slivka reference was not “discuss[ed]” in an office action. Examiner Lin’s decision to not “discuss” Slivka in an office action could be due to several reasons: the examiner could have found Slivka to be inapplicable or, as discussed above, not even prior art. The Board confirmed, for the purposes of 325(d), that citation of a reference in a signed IDS is sufficient for the reference to be considered previously presented. *See Benitec Biopharma Ltd. v. Cold Spring Harbor Laboratory*, IPR2016-00014, Paper 7 at 10 (P.T.A.B. Mar. 23, 2016) (“[a]n Examiner’s initials on an IDS form ‘provides . . . a clear record in the application to indicate which documents have been considered by the examiner in the application.’”) That Examiner Lin indicates that he considered Slivka but did not reject the claims in light of Slivka (and other prior art not lined through) strongly bolsters the validity of the claims, instead of undermining them.

Moreover, in failing to perform the analysis required under 35 U.S.C. §102(e), petitioner has not and cannot meet its burden of establishing whether the same prior art or arguments were previously presented to the office. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469,

Paper 6 (Feb. 13, 2020); *Becton, Dickinson & Co. v. B. Braun Melsungen AG*,

IPR2017-01586, Paper 8, 17-18 (Dec. 15, 2017).

Petitioner also makes no argument that the examiner made an error in not issuing a rejection based on Slivka. For this additional reason, the Board should deny institution in view of *Advance Bionics* and the *Becton Dickinson* factors.

IX. Conclusion.

For the foregoing reasons, patent owner respectfully requests the Board to deny institution of the petition in its entirety.

Dated: October 10, 2023

Respectfully submitted,

By: /Jason S. Charkow/

Jason S. Charkow (USPTO Reg. No. 46,418)*

Richard Juang (USPTO Reg. No. 71,478)*

Chandran B. Iyer (USPTO Reg. No. 48,434)

Ronald M Daignault*

jcharkow@dagignaultiyer.com

cbiyer@dagignaultiyer.com

richard.juang@gmail.com

rdaignault@daignaultiyer.com

DAIGNAULT IYER LLP

8618 Westwood Center Drive

Suite 150

Vienna, VA 22182

**Not admitted in Virginia*

Attorneys for DoDots Licensing Solutions LLC

CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,020,083 specified in 37 C.F.R. § 42.24 has 8,163 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using automated count of typed words using Microsoft Word for Office 365 and a manual count of words in each of the printed figures.

Dated: October 10, 2023

Respectfully Submitted,
By: / Jason S. Charkow /
Jason S. Charkow
USPTO Reg. No. 46,418

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S
PRELIMINARY RESPONSE was served electronically via email on October 10,
2023, on the following counsel of record for Petitioner:

Paul R. Hart (Reg. No. 59,646)
Adam P. Seitz (Reg. No. 52,206)
Kevin Rongish (Reg. No. 78,716)

ERISE IP, P.A.
5299 DTC Blvd., Ste. 1340
Greenwood Village, Colorado 80111
Telephone: (913) 777-5600
Fax: (913) 777-560
Paul.Hart@eriseip.com
kevin.rongish@eriseip.com
adam.seitz@eriseip.com
PTAB@eriseip.com

Dated: October 10, 2023

Respectfully Submitted,
By: / Jason S. Charkow /
Jason S. Charkow
USPTO Reg. No. 46,418