

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

MOBILE DATA TECHNOLOGIES LLC,
Patent Owner.

IPR2024-00247
Patent 8,825,801 B1

PATENT OWNER'S PRELIMINARY RESPONSE
35 U.S.C. §313, and 37 C.F.R. §42.107(a)

TABLE OF CONTENTS

	Page
I. INTRODUCTION.....	1
A. Summary	1
B. ‘801 Patent	2
C. Prior Art and Asserted Grounds.....	3
II. THE PETITION IS GROUNDED IN ART THAT WAS ALREADY BEFORE THE EXAMINER, AND THUS INSTITUTION SHOULD BE DENIED UNDER §325(D)	3
A. Relevant Legal Principles	4
B. All Petitioned Art Was Previously Presented, Substantially Similar, or Cumulative.....	6
C. Petitioner Does Not Show the Examiner Materially Erred	13
III. PETITIONER HAS FAILED TO ESTABLISH A REASONABLE LIKELIHOOD THAT ANY CLAIM IS UNPATENTABLE	17
A. Relevant Legal Principles	17
B. Person of Ordinary Skill in the Art.....	19
C. Claim Construction.....	19
D. Non-Obviousness of Grounds Based on Neibauer, Miller, Cheng, and Squibbs (Claims 1-25)	19
1. Neibauer	21
2. Cheng.....	23
3. Claims 1, 23, and 25.....	24
1. Petitioner’s Motivation to Combine Neibauer and Cheng is Deficient.....	30
2. All Remaining Claims That Rely on Neibauer and Cheng Fail for the Same Reasons.....	40
IV. CONCLUSION.....	41

TABLE OF AUTHORITIES

	Page(s)
Federal Cases	
<i>Advanced Bionics, LLC v. Med-EL Elektromedizinische Gerate GMBH,</i> IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020).....	<i>passim</i>
<i>In re Baxter Int’l, Inc.,</i> 678 F.3d 1357 (Fed. Cir. 2012)	19
<i>Becton, Dickinson and Co. v. B. Braun Melsungen AG,</i> IPR2017–01586, Paper 8 (PTAB Dec. 15, 2017).....	5, 7, 14, 16
<i>Biocon Pharma Ltd, v. Novartis Pharmaceuticals Corporation,</i> IPR2020-01263, Paper 12 (PTAB Feb. 16, 2001).....	8
<i>BMW of North America, LLC v. Stragent,</i> LLC, IPR2021-00418 Paper 12 (PTAB Jul. 19, 2021)	8
<i>Cisco Sys., Inc. v. C-Cation Tech, LLC,</i> IPR2014-00454, Paper No. 12 (PTAB Aug. 29, 2014).....	19
<i>Endo Pharms Sol’ns, Inc. v. Custopharm Inc.,</i> 894 F.3d 1374 (Fed. Cir. 2018)	31
<i>Google LLC v. Kewazinga Corp.,</i> IPR2021-00524 Paper 17 (PTAB Aug. 24, 2021).....	8
<i>Harmonic Inc. v Avid Tech., Inc.,</i> 815 F.3d 1356 (Fed. Cir 2016)	19
<i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.,</i> 821 F.3d 1359 (Fed. Cir. 2016)	39, 40, 41
<i>KSR Int’l Co. v. Teleflex Inc.,</i> 550 U.S. 398 (2007).....	19
<i>In re Magnum Oil Tools Int’l, Ltd.,</i> 829 F.3d 1364 (Fed. Cir. 2016)	19, 20

IPR2024-00247
U.S. Patent No. 8,825,801

<i>Medichem, S.A. v. Rolabo, SL</i> , 437 F.3d 1157 (Fed. Cir. 2006)	41
<i>In re NuVasive, Inc.</i> , 842 F.3d 1376 (Fed. Cir. 2016)	19
<i>Plas-Pak Indus., Inc. v. Sulzer Mixpac AG</i> , 600 F. App'x 755 (Fed. Cir. 2015)	39
<i>SAS Institute Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018)	18
<i>Vital Connect, Inc. v. Bardy Diagnostics, Inc.</i> , IPR2023-00381, Paper 7, 20 (PTAB July 11, 2023)	14
<i>Xerox Corp. et al. v. Bytemark, Inc.</i> IPR2022-00624, Paper 9 (PTAB Aug. 24, 2022)	21

IPR2024-00247

U.S. Patent No. 8,825,801

EXHIBIT LIST

Ex.	Description
2001	Declaration of Kevin C. Almeroth, Ph.D. (“Almeroth”)
2002	<i>Curriculum Vitae</i> of Kevin C. Almeroth, Ph.D.
2003	U.S. Patent No. 7,802,207 to Agboatwalla et al. (“Agboatwalla”)
2004	U.S. Patent Application Publication No. 2002/0035609 to Lessard et al. (“Lessard”)
2005	U.S. Patent Application Publication No. 2002/0120757 to Sutherland et al. (“Sutherland”)

Patent Owner Mobile Data Technologies, LLC (“MDT”) submits this Preliminary Response to the Petition (Paper 2, “Pet.”) for *inter partes* review (“IPR”) of claims 1-25 of U.S. Patent No. 8,825,801 B1 (Ex. 1001, “’801 Patent”, or “’801”).

I. INTRODUCTION

A. Summary

Institution of an IPR is discretionary, and is authorized when, first, “the same or substantially the same prior art” was not previously present to the U.S. Patent and Trademark Office (35 U.S.C. §325(d)), and second, “the information presented in the petition ... and any response ... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition” (35 U.S.C. §314(a)).

Institution should be denied because Petitioner does not satisfy the threshold for institution of this IPR because it presents the same or substantially similar prior art previously before the Office and considered by the examiner during the pendency of the original examination of the challenged claims of the ‘801 Patent, and Petitioner has failed to articulate any material error permitting reconsideration of the previously considered prior art. If the Board declines to deny institution in view of the previously considered prior art, institution should be denied because Petitioner’s obviousness arguments are deficient as they have not shown there is a reasonable likelihood that it would prevail in establishing the unpatentability of at least one

challenged claim. Petitioner fails to address the differences between the claimed subject matter and the prior art, and provide a reasoned analysis of how and why a person of ordinary skill in the art (“POSITA”) would combine the prior art lacking claimed features in view of the knowledge of a POSITA, and show they would have had a reasonable expectation of success. At least due to the weak showing of invalidity in view of the same or substantially the same prior art, institution of this IPR should be denied.

B. ‘801 Patent

The ‘801 Patent is directed to a collaborative web-based information content management system, involving situations where “mobile device users link to and take further action on a persistent version of a given set of shared information content.” ‘801, 1:59-61. The patent is focused on the two-way functionality of the system, which it describes as “a mechanism that facilitates uniform, action-driven content access and associated user interaction via wireless networks.” *Id.*, 1:62-64. To that end, “[t]he system is configured to operate independently of the user device operating system or other user device configuration parameters, such that a given user may author, create, publish, send, convey, share, receive, respond to, subscribe to, collaborate with, track, transact, maintain and manage personalized messaging content from any type of user device running any operating system.” *Id.*, 18:44-50.

C. Prior Art and Asserted Grounds

Petitioner asserts the challenged claims are unpatentable based on the following grounds under 35 U.S.C. §103:

Ground	Challenged Claims(s)	Reference(s)/Basis
1	1-25	Neibauer (EX1003), Miller (EX1004), Cheng (EX1005), Squibbs (EX1011)
2	1-25	Ground 1 + Harvey (EX1010)

Grounds 1 and 2 challenge independent claims 1, 23, and 25 with the references Neibauer, Miller, and Cheng being common to all challenged claims.

II. THE PETITION IS GROUNDED IN ART THAT WAS ALREADY BEFORE THE EXAMINER, AND THUS INSTITUTION SHOULD BE DENIED UNDER §325(D)

Petitioner’s cursory 35 U.S.C. §325(d) analysis both minimizes the extent of the problem caused by Petitioner’s conscious choice of art, and makes no real effort to deal with that problem. As discussed in detail below, the key references presented in the Petition are the same as those previously considered by the Examiner, and the remainder (which Petitioner acknowledges serve minimal roles in the grounds) are cumulative to art also before the Examiner.

Petitioner voices the words “materially erred” but does not actually identify any tangible error beyond the circularity of the Examiner not having used

Petitioner's references to reject the claims. Instead of explaining the supposed error, Petitioner merely appeals to its petitioned grounds and darkly alludes to an adverse reexamination result for a predecessor parent patent with significantly different claims—differences Petitioner makes no effort to address or even acknowledge. This level of handwaving has often been rejected by the Board in the past, and there is no basis here for the Board to second-guess the Examiner's representation that he considered the very references Petition now bases its grounds on, and apparently did not see the same significance in them as Petitioner now alleges.¹ Patent Owner thus respectfully requests that the Board exercise its discretion to deny review under §325(d).

A. Relevant Legal Principles

The Board may deny institution of a proceeding if the petitioner challenges the patent on matters previously presented to the Office. *Advanced Bionics, LLC v. Med-EL Elektromedizinische Gerate GMBH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential). Denial is proper if (1) the petitioner presents the same, or substantially the same, prior art or arguments previously presented to the Office, and (2) the petitioner fails to demonstrate that the Office erred in a manner material

¹ The '801 Patent was assigned to the same Examiner that examined all earlier patents in the family, including the one subject to reexamination.

to the patentability of the challenged claims. *See id.* at 8. Under this framework, the Board may determine whether the *Advanced Bionics* test is satisfied by looking to the non-exclusive list of factors listed in *Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017–01586, Paper 8 (PTAB Dec. 15, 2017) (precedential in part). *See Advanced Bionics*, Paper 6 at 9, n.10; *see also Becton, Dickinson*, Paper 8 at 17–18 (listing factors):

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art;
- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

For Part 1 of the *Advanced Bionics* framework, the Board first evaluates Becton, Dickinson factors (a), (b), and (d). *Advanced Bionics* at 10. If it is determined that the same or substantially the same art or arguments were previously presented to the USPTO, then under Part 2 the Board considers factors (c), (e), and

(f) to assess “whether the petitioner has demonstrated a material error by the Office” in its prior consideration of that art or arguments. *Id.*

The Board defers to “previous Office evaluations of the evidence of record unless material error is shown.” *Id.*, 9. A showing of material error is a high threshold: “[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Id.*, 9.

B. All Petitioned Art Was Previously Presented, Substantially Similar, or Cumulative

All of the petitioned grounds are nearly entirely based on Neibauer and Cheng and Squibbs. Pet. 3. Petitioner correctly acknowledges that these references were considered and made of record by the Examiner, and indeed they appear in IDS forms in entries that were not lined through, as well as on the face of the ’801 Patent.²

² The page ranges for Neibauer that Petitioner relies on here have minor additions and subtractions from those listed in the IDS entries, and the Petition does occasionally refer to the added page ranges for, e.g., a secondary theory or additional support for a motivation to combine. But Petitioner’s principal theories in the petitioned grounds all rely on pages that were previously presented, which

EX1022, Pages 00276 (covering Neibauer, pp. 467-491), 00241 (covering Neibauer, pp. 115-180), and 00254 (Cheng). Although the reexamination of US 8,135,801 does not appear on the IDS forms in the prosecution history of the or this '801 Patent, this reexamination involving Neibauer and Cheng was pending before the Office in a proceeding pertaining to the this '801 Patent prior to the filing of this patent, and only concluding shortly after the patents issued.

The rest of the references are, in Petitioner's words, "cited primarily for ancillary features or to account for claim construction positions proposed in the pending litigation." Pet. 10. Petitioner states without explanation or support that "*Advanced Bionics* does not apply" to these references (Pet. 3), but that misstates the Board's precedent. *Advanced Bionics* applies to "the same ***or substantially the same*** prior art" (*Advanced Bionics*, Paper 6 at 8) (emphasis added), and *Becton, Dickinson* factors (a) and (b) explicitly contemplate asserted art that is not exactly the same as that previously considered during prosecution. The Board routinely finds art not itself expressly considered to be substantially similar to art that was. See, e.g., *Advanced Bionics*, Paper 6 at 19 (finding that prior art not actually considered nonetheless "disclose[s] information already considered by the Office");

presumably is why Petitioner concedes without caveat that Neibauer was considered by the Examiner.

Biocon Pharma Ltd, v. Novartis Pharmaceuticals Corporation, IPR2020-01263, Paper 12 at 10-11 (PTAB Feb. 16, 2001) (“Thus, we agree with Patent Owner that [petitioned references not previously considered] do not provide any additional information relevant to the claim limitation at issue that was not already presented to, and considered by the Office.”); *Google LLC v. Kewazinga Corp.*, IPR2021-00524 Paper 17 at 16 (PTAB Aug. 24, 2021) (finding art initialed in an IDS “cumulative of [petitioned art] for the teachings upon which Petitioner relies”); *BMW of North America, LLC v. Stragent, LLC*, IPR2021-00418 Paper 12 at 9-10 (PTAB Jul. 19, 2021) (finding part 1 of *Advanced Bionics* satisfied because key art had been previously presented to the Office, even though some secondary references had not been).

The same is true here. Notwithstanding their passing appearance in Petitioner’s grounds, even these secondary references are substantially similar to art previously before the Examiner for the content Petitioner relies on:

Miller (EX1004): Petitioner relies on Miller solely for “the ability of a user to create a web-based community and specify the specific features (e.g. message board, etc.) to include.” Pet. 10, 18. That functionality is disclosed in US 7,802,207 to Agboatwalla et al., which was before the Examiner. EX1022, Page 00254. For example, Agboatwalla discloses:

A method for generating a user-sharable network user interface is provided. A management interface is displayed. The management interface allows a user to select and manage information displayed on an information screen of a habitat. The management interface includes information of one or more content sources. The user is allowed to select portions of the information available in the content sources. The selected information of the content source is marked and stored. The marked information is retrieved and displayed on the information screen. The information screen includes at least one view. Each view contains at least one window for displaying the marked information. A permission status of a second user is checked to determine whether the second user is authorized to see a window. The second user is allowed to see the window of the information screen of the first user if the second user is authorized.

The first user may set permissions for allowing other users to view view(s) and/or window(s). As an option, the second user can add and/or remove content from the window.

Agboatwalla (EX2003), 2:32-50. Agboatwalla's disclosure is substantially similar to the material Petitioner relies on in Miller.

Squibbs (EX1011): Petitioner relies on Squibbs for location-based features of the challenged claims, namely "a technique for displaying a photo album by showing, on an electronic map, the location of where the photo was taken based on location information provided with the photo." Pet. 10, 36. That functionality is disclosed in U.S. Patent Application Publication No. 2002/0035609 to Lessard,

which was before the Examiner. EX1022, Page 00262. For example, Lessard discloses:

FIG. 4 illustrates the activity diagram related to the creation of a location bookmark. After having received a creation request (400), the system determines whether the creation of the LBK corresponds to live creation or remote creation (401). In the case of live creation, the invention first determines the positioning system to be used (402) to obtain the positioning coordinates of the mobile station (ex. GPS, TOA, E-OTD, etc.). In accordance with the technology used, the system then communicates with the said positioning system and obtains the position of the user (403). In the case of remote creation, the geographic position is obtained (404) by asking the user to select the geographic position of the LBK through the use of a Geographic Information System (GIS) server. For example, this can be done by using a mouse to pinpoint the position of the LBK the user wants to create on a map (provided by the GIS server).

Once the geographic position of the place, object, event, etc. has been identified, the user may input related information such as a description (text, image, audio, video, etc.), search keywords, personal notes, start and end date in the case of an event, etc. Where applicable, the invention automatically acquires information that is also part of the LBK such as the date of creation, the name of the author, the accuracy of the geographic position, the street address (through the GIS server), etc. The data acquired is then streamed or sent through the network to the application server (405) that rearranges the information accordingly

and stores it in a central database (406) so as to subsequently allow the user to easily access the said data. The system finally sends to the user a confirmation as regards the creation process (407).

Lessard (EX2004), [0096]-[0097]. Lessard's disclosure is substantially similar to the material Petitioner relies on in Squibbs.

Harvey (EX1010): Petitioner states that Harvey is added to a second, parallel set of grounds "solely to account for a potential construction of "mobile information channel" proposed by Petitioner in the pending litigation. If the Board chooses not to adopt that construction here, it need not consider these grounds." Pet. 10, 67-68. But Petitioner also represents to the Board in its Claim Construction section that "for purposes of this IPR, express constructions are not required." Pet. 8. Patent Owner agrees that express constructions are not required at this stage, and thus that the Board need not consider Petitioner's parallel Ground 2 relying on Harvey.

Regardless, Harvey too is cumulative to art already before the Examiner. Petitioner relies on Harvey solely for "the ability of a community creator to author content for a community before the community is created and launched." Pet. 68. That functionality is disclosed in US 2002/0120757 to Sutherland et al., which was before the Examiner. EX1022, Page 00260. For example, Sutherland discloses:

1) In this invention, a member of a photosharing community can create named groups of people by adding individuals email addresses or

userids to the group. The system would automatically match email addresses with existing userids.

2) The member then gives access to one or more albums to each group and sends an email containing the invitation URL to the group.

3) On receipt of the URL, each invited member is given an option to accept membership in the group and thus access to group albums. The URL may only be used by those to whom it is addressed.

4) Invited members use their own password to access shared albums and see a list of all their personal albums and any shared albums at their will. Thus, each member of the photo sharing community has only one password to remember, and only one location to check to see a list of albums and groups.

5) The owner of the group may retract access by any invited member. The owner can also see if invited members have accepted the invitation and may re-invite users.

6) The owner of a group may offer extended access to any member, this allows for multiple group members to be able to upload images for example.

Sutherland (EX2005), [0029-0034]. Sutherland's disclosure is substantially similar to the material Petitioner relies on in Harvey.

Thus, all art advanced in the Petition is the same or substantially similar to art presented to and considered by the Examiner. Because of this, the Board need not reach the question of whether the same or substantially the same arguments were

previously presented to the Office, and may proceed to the second part of the *Advanced Bionics* framework. *Advanced Bionics*, Paper 6 at 20.

C. Petitioner Does Not Show the Examiner Materially Erred

Though Petitioner purports to show material error by the Board, it does not identify any purported error that does not simply collapse into the Examiner not having rejected the claims over the grounds in the Petition. In essence, Petitioner simply walks through the prosecution history, identifies one or more limitations the Examiner said were not present in certain art, and then directs the Board to its petitioned grounds. This approach is inadequate under *Becton, Dickinson* factors c, e, and f, which Petitioner does not even mention much less satisfy.

Simply appealing to the petitioned grounds does not suffice, as the Board has held: “Petitioner’s alleged grounds of unpatentability cannot establish material error *per se* under our binding precedent. . . . Otherwise, the reasonable likelihood standard of § 314(a) and the second part of the *Advanced Bionics* framework (‘material error’) would collapse into one.” *Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper 7, 20 (PTAB July 11, 2023).

Petitioner appeals to the Examiner’s characterization of the “closest prior art” (Pet. 4-5), but omits that the applicant expressly responded: “To the extent that concessions in the Statement that the prior art of record fails to disclose certain paraphrased limitations of the independent claims may be interpreted as implying

that other limitations of the claims are conventional or otherwise fail to distinguish these claims over the prior art, Applicant respectfully traverses.” EX1022, Page 337. Thus, Petitioner’s apparent theory—that simply applying Neibauer and Cheng to Cheah (the Examiner’s cited “closest art”) would have resulted in the claims not having issued—is unsupported speculation. And in any event, as discussed in greater detail in Section III.D.3.a below, all of Petitioner’s grounds are deficient at least with respect to the claim limitations related to sharing access to content over a mobile information channel (e.g., “inserting content provided by the first user into the mobile information channel” and “receiving additional content relating to the mobile information channel from one or more of said additional users via one or more respective mobile devices associated with at least one wireless network”), which are included in the paraphrased limitations the Examiner expressly found lacking in Cheah. Finally, Cheah itself appears in the IDS initialed by the Examiner, ***immediately above Cheng***. EX1022, Page 254 (Cheah, line 2; Cheng, line 3). This cuts directly against Petitioner’s inference that the Examiner was not actually considering the submitted art, and in fact supports the notion that the Examiner simply reached a different conclusion about Cheng’s relevance than Petitioner would now have the Board second-guess.

And to the extent Petitioner implies the Examiner should have picked and chosen from the references in the petitioned grounds in combination with other art

the Examiner cited, that cannot show material error either. Such an approach would have required the Examiner to combine Petitioner’s references with his own, and Petitioner does not say a word about what that combination would be or why a POSITA would have made it. This is inadequate under *Becton, Dickinson* factors e and f.

Petitioner makes one final invitation to the Board to connect the dots on its behalf by ominously stating that “the PTO cited and relied on both Neibauer and Cheng in the successful reexamination of the earlier ’801 patent” (a predecessor to the series of MDT patents Meta has petitioned). Pet. 9-10. Setting aside Petitioner’s gentle exaggeration (the PTAB affirmed the Examiner’s rejection on grounds not involving Cheng (EX1024, Page 0014)), Petitioner’s apparent inference—that the reexamination result shows that not rejecting the ’801 claims over Neibauer was material error—is belied by the vast differences between the claims (emphasis added):

US 8,135,801	’801 Patent
1. A method for managing information content in a network-based communication system, the method comprising the steps of:	1. A method comprising:
providing a first web-based interface accessible to a first user, the first web-	providing an interface permitting a first user to control activation of a

based interface being configured to permit the first user to designate a plurality of other users that will share access to content with the first user, in accordance with accessibility rules established by the first user; and	mobile information channel through which the first user can share access to content with a plurality of additional users;
generating a second web-based interface wherein access to the content via the second web-based interface is controlled in accordance with the accessibility rules established by the first user via the first web-based interface.	activating the mobile information channel responsive to input received from the first user via the interface;
	inserting content provided by the first user into the mobile information channel;
	receiving additional content relating to the mobile information channel from one or more of said additional users via one or more respective mobile devices associated with at least one wireless network;

	inserting at least a portion of the additional content into the mobile information channel; and
	integrating into the mobile information channel information associated with at least one wireless networking functionality of said at least one wireless network.

In sum, Petitioner’s reluctance to shoulder its burden and perform any substantive analysis should be fatal to its vague allusions of error. The Board has ample grounds to exercise its discretion to decline review.

III. PETITIONER HAS FAILED TO ESTABLISH A REASONABLE LIKELIHOOD THAT ANY CLAIM IS UNPATENTABLE

Petitioner asserts two obviousness grounds of unpatentability. Pet. 3. For the purpose of this Response, the Board need only consider the validity of independent claims 1, 23, and 25 of the grounds. As shown below, the Petition fails to establish a reasonable likelihood that Petitioner will prevail. A trial therefore should not be instituted.

A. Relevant Legal Principles

Review cannot be instituted unless the Petition demonstrates a reasonable likelihood that at least one of the challenged claims is unpatentable. 35 U.S.C. §314(a); 37 C.F.R. §42.108(c). Under §314, the Board is required to make “a binary

choice – either institute review or don’t.” *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018).

It is Petitioner’s burden to show why the challenged claims are unpatentable. *Harmonic Inc. v Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir 2016). The Board “will not take on the role of advocate for a party, trying to make out a case the party has not adequately stated.” Standing Order ¶121.5.2 (B.P.A.I. Mar. 8, 2011). Rather, it is Petitioner’s duty to provide sufficient grounds for the institution of a review “focus[ing] on concise, well organized, easy-to-follow arguments supported by readily identifiable evidence of record.” *Cisco Sys., Inc. v. C-Cation Tech, LLC*, IPR2014-00454, Paper No. 12 at 11 (PTAB Aug. 29, 2014).

The ultimate determination of obviousness under 35 U.S.C. §103 is a question of law based on underlying factual findings. *In re Baxter Int’l, Inc.*, 678 F.3d 1357, 1362 (Fed. Cir. 2012) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1996)). “To satisfy its burden of proving obviousness, a petitioner cannot employ merely conclusory statements. The petitioner 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, 1380-81 (Fed. Cir. 2016). The “factual inquiry” into the reasons for “combin[ing] references must be thorough and searching, and the need for specificity pervades.” *In re NuVasive, Inc.*, 842 F.3d 1376, 1381-82 (Fed. Cir. 2016) (internal quotations and citations omitted). The

specific reasoning must include some rational underpinning to combine the prior art elements as claimed to support the conclusion of obviousness. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). It is Petitioner's burden to demonstrate a motivation to combine, and a reasonable expectation of success. *See In re Magnum Oil Tools*, 829 F.3d at 1381. Mere conclusory statements are insufficient. *Id.*, 1380.

B. Person of Ordinary Skill in the Art

For purposes of this Response, MDT applies Petitioner's characterization of a POSITA. EX2001 ¶¶42-44.

C. Claim Construction

For purposes of this Response, MDT submits no express constructions are required, and that the ordinary and customary meanings of the claim terms apply. EX2001 ¶¶32-35.

D. Non-Obviousness of Grounds Based on Neibauer, Miller, Cheng, and Squibbs (Claims 1-25)

The two grounds challenging claims 1-25 rely on unpatentability over at least Neibauer, in view of Cheng under 35 U.S.C. §103, and further cite to the declaration of Vijay K. Madisetti, Ph.D. (EX1002), as support. Pet. 9-10.³

³ A comparison of Dr. Madisetti's declaration with the Petition shows they are nearly carbon copies of each other. Many of Petitioner's conclusory arguments are supported only by a citation to nearly identical text in Dr. Madisetti's declaration,

Claim 1 recites, in part a method whereby a first user controls activation of a ***“mobile information channel through which the first user can share access to content with a plurality of additional users,”*** whereby content provided by the first user and content received from mobile devices of additional users is inserted into the mobile information channel for sharing. EX1001, 18:56-19:7. Independent claims 23 and 25 recite commensurate limitations.

Petitioner’s obviousness arguments depend upon combining two separate and distinct features of certain Yahoo! functionality discussed by Neibauer that were not possible on mobile devices at the time, and in the alternative, functionality of a proxy server as disclosed by Cheng. The Petition fails to account for all of the claim limitations as arranged in the claim, and the technological limitations of the view-only, read-only mobile access functionality of the prior art disclosures. The Petition merely identifies where the claim limitations are found in the prior art, and as Kevin C. Almeroth, Ph.D. explains, fails to convincingly address how the prior art would be combined and why, and that there would be a reasonable expectation of success. EX2001.

which itself is conclusory and unsupported. The Board thus should give little weight to Dr. Madisetti’s opinions. *Xerox Corp. et al. v. Bytemark, Inc.* IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential).

1. Neibauer

The 2000 book titled *How to Do Everything with Yahoo!*, by Alan Neibauer, explains how the Internet portal called Yahoo! is a place on the Internet that offers users services, such as access to the Internet, and as a repository of and a conduit of user content and Yahoo! services for registered users. EX1003, pp. xv, 4. According to Neibauer, all someone at the time needed was a computer with a “dial-up connection” and they could access the Yahoo! service. *Id.*, 4. Neibauer describes aspects of the Yahoo! service from a user’s perspective in a “how-to” type of format. EX2001 ¶52.

Two chapters of Neibauer, addressing separate aspects of the Yahoo! services, are of primary interest to, and are referenced by, Petitioner in asserting invalidity of the challenged claims. The first is Chapter 7 titled “Your Yahoo! Home Away from Home” (pp. 155-180), and the second is Chapter 21 titled “Communicating with Clubs, Message Boards, Personals, and More” (pp. 467-491). EX2001 ¶53. Petitioner acknowledges this content from Neibauer was considered by the Examiner and made of record in granting the claims of the ‘336 Patent. Pet. 4-5 (citing EX1022, Pages 00276 (covering Neibauer, pp. 467-491) and 00241 (covering Neibauer, pp. 115-180)). Each of these sections shows users how to access and use the corresponding Yahoo! features.

Chapter 7 discusses the Yahoo! Briefcase functionality that is limited to allowing a user to store and access files at the Yahoo! software platform (p. 156), and the one-way Yahoo! Mobile functionality that is limited to allowing a user to view Yahoo! services and Yahoo! generated and stored content sent to a user's mobile device (pp. 166-167):

Using Briefcase, you can store your files online and access them from any computer that is connected to the Internet. With Yahoo! Mobile, you can get your e-mail, view your calendar, and even be alerted about news, financial information, and weather conditions from a pager or other mobile device.

Neibauer, p. 156.

Chapter 21 discusses various functionalities of the Yahoo! service where users with a Yahoo! account can use services such as message boards, and clubs. *Id.*, pp. 468-476. Club messages are posted to and accessed at a "private message board" at the club page. *Id.*, p. 477. Photos are posted to, viewable at, and stored in albums at the club page, and are maintained by the club at the Yahoo! software platform. *Id.* Club chats are conducted on the club page. *Id.*, p. 479. None of the services of Chapter 7 or 21 permit or contemplate sharing between users where both users can receive and upload content to facilitate an interaction between users. The Petition fails to provide evidence and analysis that overcome this deficiency.

2. Cheng

Cheng is a U.S. patent describing a method by which a proxy server can access a web site and reformat its visual elements so they can be viewed by a mobile device. Cheng, Abstract. Cheng's method starts when the proxy server receives a request from a mobile device to view a particular web page. *Id.* The proxy server subsequently extracts images and text data from the requested web page and re-formats the data so that it can be viewed properly by the mobile device that made the initial request. *Id.*

Cheng contemplates a type of universal website translation service that operates in the form of a go-between proxy server for one-way conversion of conventional websites into a format viewable on mobile devices at the time. EX2001 ¶¶70-75. Cheng's proxy server purports to operate by receiving (or retrieving a cached copy of) a website, and then applying an operator-specified series of transformations to the website content that Cheng calls "SW-Transforms," which could be specified on a global basis (for all recipients) or on a device-specific basis (based on a recipient's specific mobile device). EX1005, 4:56-5:10; and col. 17-22 (exemplary site-mining methods); EX2001 ¶71. Cheng's SW-Transforms include the capability of adding, replacing, or removing HTML tags and/or text from the source web page in order to attempt to format it for viewing at the destination mobile device. *Id.* From Dr. Almeroth's experience, given capabilities of website

technology available in 2002, such as HTML, Java, Javascript, and Flash, and the small screens, limited memory, and very limited low-bandwidth non-audio functionality of mobile phones and PDAs at the time, the prophetic universal website translation functionality of Cheng was not technically feasible in 2002, and there is no evidence it was ever commercialized. EX2001 ¶¶70, 72. At that time, successful deployment of the solution contemplated by Cheng is co-dependent upon the design and characteristics of the conventional website, and the capabilities of each mobile phone. *Id.* ¶¶73-74. Further, the technology of Cheng is limited to the transfer of data one-way, from the conventional website, through the proxy server translator, to the mobile device. *Id.* ¶75.

Petitioner relies on Cheng, in the alternative, to show that a mobile device could have accomplished the claimed interactive features missing from Neibauer. Pet. 21. However, Cheng is deficient in this regard because it only provides for reformatting of data from a website to be displayed on a mobile device, but does not provide for reformatting in the other direction (i.e., re-formatting data from the mobile device to be displayed on a web page). EX2001 ¶¶75-76. The Petition fails to present evidence and analysis that overcomes this deficiency.

3. Claims 1, 23, and 25

Petitioner relies on Neibauer's Yahoo Clubs! feature to teach the key limitations of claim 1. Pet. 12 ("Most of the key limitations of claim 1 are introduced

in this limitation, and thus, will be covered in this section.”). Petitioner also alleges Neibauer discloses “mobile information channels” alone (*Id.*, 14-17 (discussing club features)), and in combination with Cheng (*Id.*, 17 (“Petitioner will provide a separate discussion below as to why the information channels in Neubauer qualify as “mobile” information channels, based on Neibauer alone and in view of Cheng.”)). Thus, Petitioner relies solely on Neibauer to disclose key limitations, *and* on Cheng. *Id.*, 21-29 (discussing Cheng).

a. Petitioner’s Combination of Neibauer and Cheng Does Not Disclose the Claimed Invention.

Petitioner maps onto the upstream transfer of data such as pictures from the mobile device through the Cheng proxy server to the Neibauer web server. Pet. 12, 20; EX2001 ¶¶81. Petitioner relies on Neibauer to disclose all limitations of claim 1 except, in the alternative, if the claimed “information channels” are deemed to facilitate “mobile” technology, Petitioner turns to Cheng (Pet. 21-24). Neibauer alone, or in combination with Cheng do not teach or suggest content sharing using a mobile device.

Petitioner represents Neibauer discloses the key limitations of claim 1 as recited in limitation 1[a]. Pet. 12. Limitation 1[a] states:

providing an interface permitting a first user to control activation *of a mobile information channel through which the first user can share access to content with a plurality of additional users*; and

(emphasis added)

Petitioner maps Neibauer’s clubs, messaging, chat, and photography features of the Yahoo! Clubs functionality discussed in Chapter 21 to the claimed “mobile information channel through which the first user can share access to content with a plurality of additional users.” *Id.*, 14-17. These several pages of mapping of the Yahoo! Clubs features and conclusory statement that Neibauer discloses the claimed sharing is supported by a citation to a nearly identical recitation of the same text and conclusion found in the supporting declaration of Madisetti (EX1002, ¶¶88-94). This is in support of Petitioner’s argument that because the features can be used by users for sending and receiving content between club members, that Neibauer discloses at least the claimed “share access to content with a plurality of additional users.” *Id.*, 16.

Petitioner argues that because each of the club founder and club members can access the Yahoo! club services via web-based interfaces, and that that interaction allows for the exchange of information between them via mobile information channels as discussed for limitation 1[a], that Neibauer therefore discloses an information channel “through which the first user can share access to content with a plurality of additional users.” Pet. 16.

Petitioner further relies on the explanation that Neibauer and Cheng’s disclosure of limitation 1[a] also supports the prior art disclosing limitation 1[c]

(“inserting content provided by the first user into the mobile information channel” (Pet. 30)) and limitation 1[d] (“receiving additional content relating to the mobile information channel from one or more of said additional users via one or more respective mobile devices associated with at least one wireless network” (Pet. 33)). But, Petitioner’s conclusions are deficient.

While Petitioner has mapped the claim language to the disclosure of Neibauer, Petitioner does not provide any additional explanation for how the information is *shared with a plurality of users* as the limitations are arranged in the claim. Neibauer is devoid of such functionality as it is focused only on the limited read-only functionality of mobile access to traditional websites. EX2001 ¶¶54-57. There is no evidence that the Yahoo! Clubs functionality could have been supported by users accessing the services on a mobile device. *Id.*

The deficiency of the prior art to teach or suggest the sending and receiving of content between users to facilitate the shared access of limitation 1[a] is not cured by the “Yahoo! Mobile” functionality. Confusingly, Petitioner argues “Neibauer discloses three features that each independently discloses a mobile information channel,” but then abandons the limitation “mobile” in the claimed “mobile information channel” stating in a conclusory manner that it “adds nothing of significance because ... it would have been obvious that each of the features of Neibauer relied upon above (e.g. club message board, chat, photo sharing) could

have been adapted to *allow for content sharing using a mobile device.*” Pet. 20 (emphasis added). Petitioner reaches to the “Yahoo! Mobile” and “Yahoo! To Go” functionality for support that the features of Neibauer relied upon above teach and suggest mobile content sharing because some features of Yahoo! were accessible by a mobile device. *Id.* The notion of sharing is belied by the fact that the “Yahoo! Mobile” and “Yahoo! To Go” functionality is limited to a user’s one-way access and viewing of information originating with the Yahoo! software platform. EX1003, pp. 156, 166-167. There is no evidence that if the Yahoo! Clubs feature could be offered through the Yahoo! Mobile or Yahoo! To Go services, that it would have allowed mobile users to actually post content. EX2001 ¶58. Neibauer only presents the Yahoo! Clubs and mobile features as providing a unidirectional access to information of other users or Yahoo!.

The technology needed to provide user-interactive features were outside the capabilities of mobile devices at that time and what Neibauer discusses in Chapter 7. *Id.* Such as the required screen size, mobile device memory, processing power, and wireless bandwidth. *Id.* Comparing the features of the club pages to what content and features in Yahoo! Mobile and Yahoo! To Go that was capable of being displayed on a PDA at the time indicates it would not be technically feasible to do so. EX2001 ¶¶59-62, 65-66. The deficiencies of Neibauer are not solved by Cheng. Pet. 21.

Even if the mobile device could have supported all of the Clubs website functionality such that it could have engaged in upstream data transfer as Petitioner relies on, that is only half the battle: the Cheng proxy server would have had to have been designed to support such upstream data transfer. EX2001 ¶86. Cheng is explicitly designed for one-way data transfer in response to a request from a mobile client. EX2001 ¶¶75-76, 80.

This is not academic hairsplitting: Unlike downloading data to a client, which a server does in response to a specific request, uploading data to a server often implies a persistent connection between the two, which among other things requires the server to keep track of the client's state. *Id.* ¶86. An intermediary such a proxy server, which again presents itself to the content server as and plays the role of the client, would have to account for issues like persistent connections with and state tracking of the actual client using the proxy server. *Id.* Cheng is devoid of any such teaching. *Id.* In fact, Cheng's disclosure of a cache, which saves previously-requested web pages locally in the proxy server so that the proxy server can return that local copy rather than querying the origin web server every time, would directly interfere with the sort of two-way communication scheme Petitioner advances. *Id.* ¶87.

Again, there is no record evidence of how the upload functionality disclosed in Neibauer worked and what accommodations would have been required for Cheng

to support it, and in any event Petitioner proposes only an unmodified Cheng that does not disclose or even suggest it is configured for supporting client-to-server uploads. As a result, even if the Board were to find sufficient motivation to combine and reasonable expectation of success for Petitioner's Neibauer-Cheng combination, it still would not disclose all the limitations of the challenged claims.

As such, the lack of Neibauer alone, or in combination with Cheng, to disclose, teach, or suggest bidirectional sharing of access to content with a plurality of users and mobile users does not render the challenged claims obvious. *Endo Pharms Sol'ns, Inc. v. Custopharm Inc.*, 894 F.3d 1374, 1379-81 (Fed. Cir. 2018) (holding that patents were not invalid for obviousness where the prior art did not disclose some of the claim limitations and rejecting challenger's assertion that one of the limitations was inherently disclosed in the prior art).

1. Petitioner's Motivation to Combine Neibauer and Cheng is Deficient

All of Petitioner's grounds rest on the combination of Neibauer's disclosure of Yahoo! Clubs ("Clubs") with Cheng's proxy server. Pet. 3. Petitioner argues that a POSITA would have been motivated to make this combination⁴ in order to allow

⁴ Petitioner also adds Miller, Squibbs, and Harvey to this combination to satisfy certain other claim limitations, but for the functionality of the purported combined

a user to make use of the relied-on functionality in Clubs on a mobile device. Pet. 24-26. But an unspoken, basic fallacy pervades Petitioner's entire argument: that mobile devices available at the time of the invention were capable of receiving and displaying complex websites such as those shown in Neibauer at all, much less capable of supporting the internal functionality needed for the interactive features of Clubs Petitioner relies on. Absent any such evidence that a POSITA actually *could* have achieved such a combination, Petitioner's arguments that a POSITA *would* have sought to do so amount to nothing more than anachronistic, impermissible hindsight.

For these reasons and others explained in detail below, Petitioner's theories are conclusory, aspirational, and not tethered to record evidence, and thus do not satisfy Petitioner's burden to show a motivation to combine and a reasonable expectation of success.

a. Petitioner's motivations to combine are conclusory, internally inconsistent, and contradicted by record evidence

Petitioner first argues that it would have been obvious to make Clubs available for use on a mobile device because Yahoo! itself made certain other services

system discussed here Petitioner relies only on the combination of Neibauer and Cheng.

available for use on personal digital assistants (“PDAs”) through its Yahoo! Mobile and Yahoo! To Go services. Pet. 24-25. But the primitive Yahoo! services available on a PDA via Yahoo! Mobile and Yahoo! To Go reflected the “limited memory, slow data transmission, and small screens” the experts agree were available on mobile devices at the time. EX2001 ¶¶64-70; EX1002 ¶114 (citing EX1012 p.320); see also EX1003, 171:



All these examples are designed to only fill the width of the PDA screen and are text only, with no images at all. EX2001 ¶¶61-62. Again, this is not surprising: memory, bandwidth, and screen space at the time were at a premium. *Id.* ¶¶61-64. Compare these minimalist renditions to desktop browser views of some of the Clubs functionality Petitioner relies on:

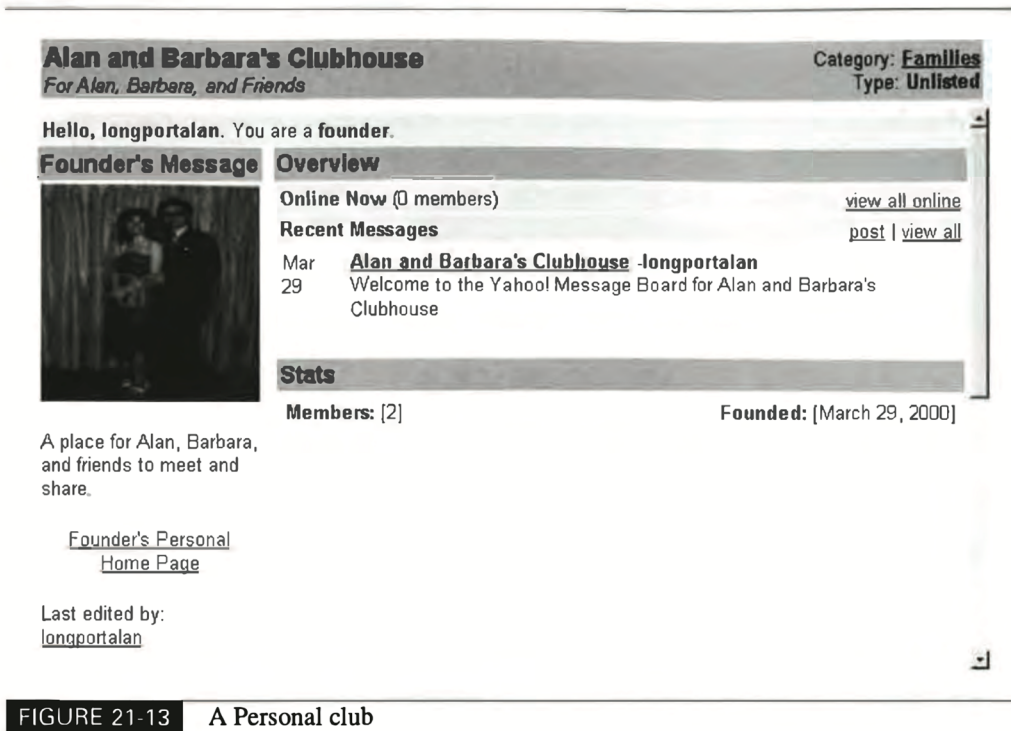


FIGURE 21-13 A Personal club

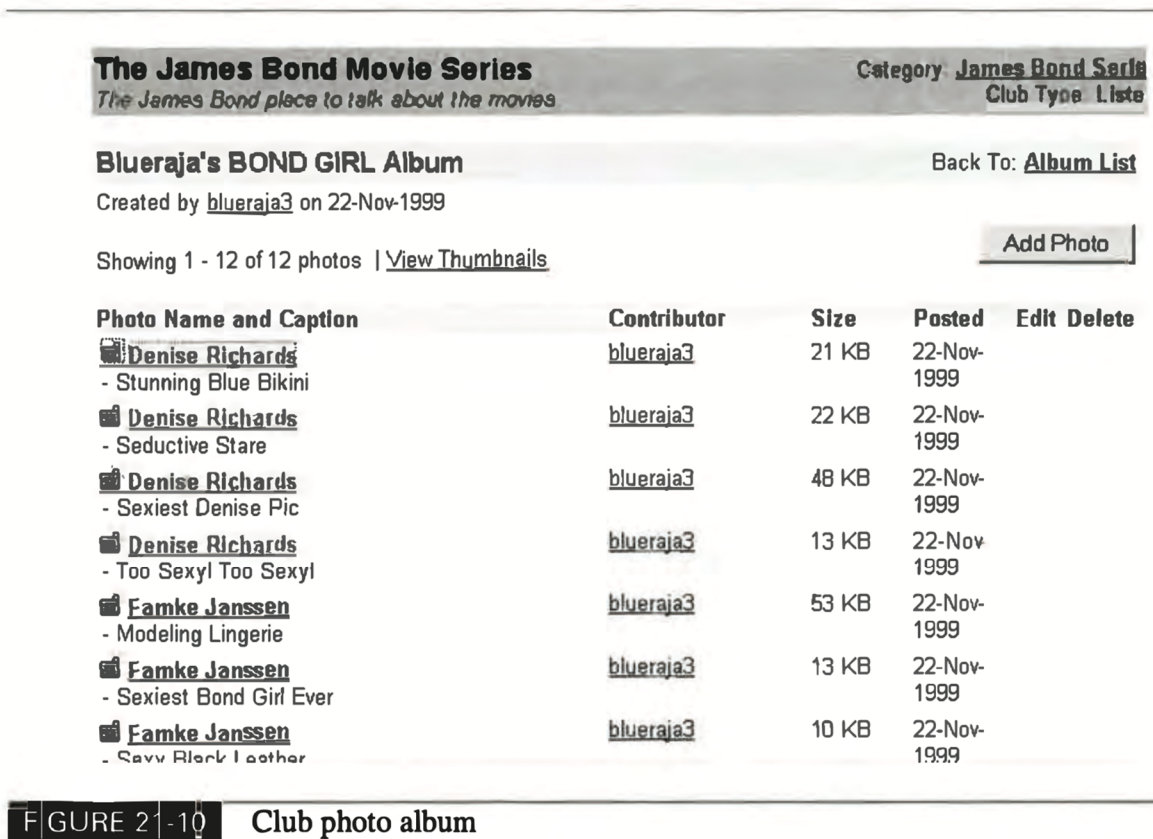


FIGURE 21-10 Club photo album

EX1003, p. 483 (Figure 21-13, club home page), p. 478 (Figure 21-10, club photo album).

Of particular note is that Petitioner relies on the two-way sharing of photos with mobile devices: both mobile devices being able to receive and view the main club picture uploaded by the founder (first image, below “Founder’s Message” in Figure 21-13), and uploading of additional pictures to club photo albums by mobile device users (second image, “Add Photo” button in Figure 21-10). Pet. 11-12. Neibauer’s Yahoo! Mobile and Yahoo! To Go examples do not show any comparable functionality, and Petitioner does not allege otherwise.

With that in mind, Petitioner’s bare assertion that it would have been obvious to provide Clubs through Yahoo! Mobile and/or Yahoo! To Go (Pet. 25-26) is purely conclusory and unsupported by record evidence. EX2001 ¶¶77, 53-66. Petitioner argues that a POSITA would have been motivated by market forces, but this too is conclusory and unsupported, and does not even attempt to explain what these supposed market forces would be that Yahoo!, one of the leading Internet portals at the time, was not already subject to. Indeed, the story told by the record evidence is that Yahoo! did not already provide Clubs functionality through Yahoo! Mobile and Yahoo! To Go was because contemporaneous mobile devices were incapable of supporting it. *Id.* ¶¶58, 61-66.

Undeterred by these warning signs, Petitioner pivots to a fallback obviousness combination by adding Cheng’s translation proxy server. Pet. 21, 24. But Petitioner already argued it would have been obvious to adapt Neibauer to provide Clubs through Yahoo! Mobile and/or Yahoo! To Go based on Neibauer alone, and does not articulate any purported differences in capability between Yahoo! Mobile or Yahoo! To Go and Cheng’s translation proxy server that would have caused a POSITA to find Yahoo! Mobile or Yahoo! To Go deficient in a way that Cheng would solve. EX2001 ¶¶78-79.

Petitioner presents Cheng as a universal solution “capable of converting and reformatting any existing HTML-based web page into a format suitable for display on a mobile device” (Pet. 24), but that careful language elides the fact that Cheng’s conversion process applied not only to the *format* of a web page, but also to its *content* and *capabilities*. EX2001 ¶¶73-74. Indeed, Cheng freely acknowledges that its aspirational goal of a universal website translator for mobile devices was practically and perhaps significantly limited by the capabilities of those devices. *Id.* To this end, Cheng provides six columns of exemplary “SW-Transforms” that might be used to convert, downscale, and/or completely delete content from an original website such that the remainder might be successfully displayed on a mobile device (*id.*), but again Petitioner offers no evidence of the capabilities required by the Clubs webpages shown in Neibauer beyond conclusory, unsupported statements cut-and-

pasted by its expert. Thus there is no record evidence if and how Cheng's translation tool could have been successfully applied to the Clubs webpages for any mobile devices available at the time, and, if so, whether the functionalities Petitioner relies on still would have worked. EX2001 ¶80.

Petitioner argues as an additional motivation to combine Neibauer and Cheng that transcoding proxy servers for mobile devices were known and in commercial use (Pet. 21, 26), but again this both cuts against Petitioner's motivation to combine and amplifies its lack of supporting evidence. If such transcoding proxy servers were already in commercial use, there would have been no need and thus no motivation for a POSITA to start over with Cheng rather than just using an already-available proxy—if indeed a POSITA would have seen a transcoding proxy server as a viable solution at all. Furthermore, if transcoding proxy servers at the time actually were capable of converting the Clubs websites into a form usable by contemporaneous mobile devices, certainly some fraction of Yahoo!'s millions of users actually would have done so and Petitioner could have dramatically simplified its petitions by simply bringing forth such evidence.

Furthermore, Petitioner's theory is expressly based on applying Cheng in its entirety as "bolt-on" functionality to a likewise unmodified Neibauer, and even argues a single entity could operate both the Neibauer web server and Cheng proxy. Pet. 24-25. Again, this theory appears to be results-oriented and conclusory,

ignoring the real-world ramifications of such a choice and why they would actually steer a POSITA away from it. EX2001 ¶88. A proxy server such as Cheng's is designed to be transparent to the web server: to the web server, the proxy server appears to be the client. EX2001 ¶87. But the converse is not true: the proxy server is not at all transparent to the *client*. EX2001 ¶89. Indeed, Cheng acknowledges only two ways for a mobile device to route requests through its proxy server: either through a permanent connection between the client and proxy server via a device configuration (which would route any and all traffic through that proxy), or a "decorated URL" (e.g., www.proxyserver.com/?url=http://www.originalwebserver.com). *Id.* Either possibility would be awkward for a mobile device user wanting to view a website of an enterprise that employed Petitioner's Neibauer-Cheng combination: either the user would have to manually reconfigure the proxy server in their mobile device to point to the Neibauer-Cheng proxy server every time they wanted to view the enterprise's web pages (and then remove or change their proxy connection for other web pages), or the user would have to enter a "decorated URL" in the ponderous form shown above every time they wanted to view the enterprise's web pages. *Id.* ¶90. These unnecessary contortions would be unacceptable to a user, and would discourage a POSITA from designing a mobile-capable website by crudely "bolting on" a Neibauer web server and Cheng proxy server as Petitioner suggests. *Id.*

Neibauer and Cheng disclose technologies optimized for unidirectional communication, and Petitioner fails to address how the technological limitations of the prior art references optimized for one-way communication would be modified to provide a more sophisticated bi-directional communication, or sharing of content between users when one is a mobile user. There is no evidence or explanation of how the specialized systems would work in reverse, or supporting analysis and reasoning that a POSITA would have an expectation of success. *Plas-Pak Indus., Inc. v. Sulzer Mixpac AG*, 600 F. App'x 755, 758 (Fed. Cir. 2015) (“[B]asic principles under which the [prior art] was designed to operate, or that render the prior art ‘inoperable for its intended purpose,’ may fail to support a conclusion of obviousness.” (internal quotations omitted)).

b. Petitioner does not show a reasonable expectation of success

Petitioner ignores the fundamental teachings of the prior art references that would dissuade a POSITA from combining the prior art, and that they would have and a reasonable expectation of success in accordance with the claims as a whole. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016) (“The reasonable expectation of success requirement refers to the likelihood of success in combining references to meet the limitations of the claimed invention.

. . . [O]ne must have . . . a reasonable expectation of achieving what is claimed in the patent-at-issue.”).

Petitioner’s “bolt-on” approach to Cheng’s proxy server glosses over the level of experimentation that would be required to program that proxy server to translate a specific website such as Yahoo! Clubs to work on a specific mobile device available at the time. EX2001 ¶91. Petitioner treats Cheng like a mythical “babel fish” that automatically and magically converts any website for use on any device, when in reality Cheng merely discloses a *framework* for *attempting* to do so: an exemplary set of “SW-Transforms” that attempt to alter the content of an original website to make the remainder viewable on a given mobile device. EX2001 ¶¶91-93. Cheng discloses SW-Transforms that can be applied on a device-specific basis (to conform all web pages to some specific constraint of a certain mobile device) and a site-specific basis (to adapt the contents of a certain web page or group of pages on a web site for all mobile devices). *See, e.g.*, EX1004, 11:45-62; 12:25-31; EX2001 ¶93. Cheng states: “The number of possible conversions is virtually infinite.” *Id.*

Cheng thus discloses a methodology for conversion and a decidedly finite number of exemplary SW-Transforms (EX1004, cols. 17-22), but beyond that leaves a POSITA on their own to determine what might be required to make a specific website work on a specific device. EX2001 ¶93. Thus, a POSITA examining Cheng would have no idea whether its disclosed system would work at all to translate the

Clubs web pages to form viewable on a mobile device available at the time—much less with all of the functionality usable that Petitioner relies on—and would have to engage in undue experimentation to determine which of Cheng’s SW-Transforms might work, or whether the POSITA would have to develop new ones from Cheng’s “virtually infinite” set of possibilities. *Id.* This sort of blue-sky exploration does not rise to a reasonable expectation of success. *See Medichem, S.A. v. Rolabo, SL*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (“to have a reasonable expectation of success, one must be motivated to do more than merely to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result”).

And in any event, regardless of the level of experimentation required to make Cheng’s translation work on Neibauer’s web pages, a POSITA still would not have a reasonable expectation of success because, as discussed above, Cheng’s proxy server is only designed for downstream content delivery and Yahoo! Clubs requires two-way interaction and transfer of content, and modifying Cheng to do so would be outside the capabilities of a POSITA. EX2001 ¶94.

2. All Remaining Claims That Rely on Neibauer and Cheng Fail for the Same Reasons

Grounds 1 and 2 challenging independent claims 1-25 rely on Neibauer and Cheng. Because the combination of Neibauer and Cheng do not render obvious the

IPR2024-00247

U.S. Patent No. 8,825,801

Ground 1 claims, it cannot render obvious Ground 2 claims, and institution based on Grounds 1 and 2 should be denied.

IV. CONCLUSION

For the foregoing reasons, institution of this IPR should be denied.

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), the undersigned hereby certifies that the foregoing Patent Owner's Preliminary Response contains 8,769 words using the word count feature of Microsoft Word.

Dated: March 13, 2024

/Kevin S. Tuttle/

Kevin S. Tuttle (Reg. No. 52,307)

Attorney for Mobile Data

Technologies LLC

CERTIFICATE OF SERVICE

Pursuant to 37 CFR 42.6, the undersigned hereby certifies that the above-captioned Mobile Data Technologies LLC's Patent Owner's Preliminary Response of U.S. Patent No. 8,825,801 was served via electronic mail on March 13, 2024, as authorized by Petitioner's Mandatory Notices, to the following e-mail correspondence of record:

Heidi L. Keefe, hkeefe@cooley.com
Phillip E. Morton, pmorton@cooley.com
Andrew C. Mace, amace@cooley.com
Mark R. Weinstein, mweinstein@cooley.com
COOLEY LLP
ATTN: Patent Group
1299 Pennsylvania Ave. NW, Suite 700
Washington, DC 20004

Date: March 13, 2024

Respectfully Submitted,
SPENCER FANE LLP

By: /s/Kevin S. Tuttle
Kevin S. Tuttle (Reg. No. 52,307)
Spencer Fane LLP
1000 Walnut Street, Suite 1400
Kansas City, Missouri 64106-2140
Customer No. 21129
Telephone: (816) 474-8100
Fax: (816) 474-3216
*Attorneys for Mobile Data
Technologies LLC*