

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

MOBILE DATA TECHNOLOGIES LLC,
Patent Owner.

Case IPR2024-00248
Patent 9,032,039

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

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U.S. Patent No. 9,032,039

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 Application Publication No. 2005/0171645 to Dowling et al. (“Dowling”)

Mobile Data Technologies, LLC (“MDT”) submits to this Preliminary Response (“POPR”) to the Petition (Paper 2, “Pet.”) for inter partes review (“IPR”) of claims 19-23 of U.S. Patent No. 9,032,039 (“’039 Patent”, Ex. 1001) filed by Meta Platforms, Inc. (“Petitioner”).

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 ‘039 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. 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	19-20, 22-23	Neibauer (EX1003), Cheng (EX1005), Squibbs (EX1011)
2	21	Ground 1 + Bandera (EX1017)
3	19-20, 22-23	Ground 1 + Harvey (EX1010)
4	21	Ground 2 + Harvey

Grounds 1 and 3 challenge independent claims 19 and 23, with the references Neibauer, Cheng and Squibbs being common to the challenged claims.

C. The '039 Patent

The '039 Patent is titled Method, Apparatus and System for Management of Information Content for Enhanced Accessibility Over Wireless Communication Networks, and was issued by the U.S. Patent & Trademark Office on May 12, 2015. Ex 1001 (face).

In one embodiment, the '039 Patent describes a method that enables a mobile device user to transfer content from the mobile device to a server for insertion into a previously established application-based information channel so that the mobile device user can interact with one or more additional users. The '039 Patent describes in col. 9, lines 8-28:

The content management site in the illustrative embodiment is designed to generate and otherwise manage dynamic, time-sensitive, task-oriented mobile sites, including wireless collaborative workspaces and communities. The content management site allows content such as data, media, multimedia, messages, news, features, events, polls, competitions and advertising to be rapidly created, entered into the system, and then subsequently syndicated, distributed, shared, collaborated with or acted upon by users of mobile devices.

By utilizing the content management site, system users can create one or more personal or business mobile sites with various sets of features, and then share such sites via the mobile Internet or other wireless network with friends, family, colleagues, or other groups of any type. The content management site makes it simple for unsophisticated users

to upload, enter, create, syndicate, distribute or otherwise manage content that is important to them, in a manner that allows such content to be accessed, shared, and acted upon from a mobile device.

The invention also transfers information associated with at least one wireless networking functionality of the mobile device from the mobile device to the server.

The '039 Patent indicates in col. 5, lines 51-65:

Examples of such information include information specifying at least one messaging action implementable over the wireless network, information specifying at least one collaboration action implementable over the wireless network, and information specifying at least one location-based service action implementable over the wireless network. Other types of information associated with wireless networking functionalities may also or alternatively be used. Id.

The content and the information associated with the at least one wireless networking functionality of the mobile device is integrated into the previously established application-based information channel. This element is described in col. 5, lines 51-65 and col. 9, lines 8-28 of the '039 Patent, which are set forth above.

The invention also enables other content from at least one of the additional users to be interested into the previously established application-based information channel. For example, the '039 Patent indicates in col. 17, lines 16-22:

Furthermore, the invention allows users to more efficiently communicate, collaborate and otherwise interact with their friends or

colleagues instantly and seamlessly within a single system that provides a mobile web site integrating existing wireless networking functionalities, such as IM, SMS, MMS, location-based services, or email, with personally authored content.”

D. The Challenged Claims

The challenged claims 19-23 include independent claims 19 and 23, which are set forth below.

19. A method comprising:
 - receiving, at a server from a mobile device, content for insertion into a previously established application-based information channel, the previously established application-based information channel permitting interaction between a user of the mobile device and one or more additional users;
 - receiving, at the server from the mobile device, information associated with at least one wireless networking functionality of the mobile device;
 - integrating the content and the information associated with said at least one wireless networking functionality of the mobile device into the previously established application-based information channel; and
 - inserting other content from at least one of the additional users into the previously established application-based information channel.
23. A server comprising:
 - at least one processing element comprising a processor coupled to a memory; and
 - at least one network interface;
 - said at least one processing element being configured to:

receive, from a mobile device, content for insertion into a previously established application-based information channel, the previously established application-based information channel permitting interaction between a user of the mobile device and one or more additional users;

receive, from the mobile device, information associated with at least one wireless networking functionality of the mobile device;

integrate the content and the information associated with said at least one wireless networking functionality of the mobile device into the previously established application-based information channel; and

insert other content from at least one of the additional users into the previously established application-based information channel.

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 patent with significantly different claims—differences Petitioner makes no effort to address or even acknowledge.

This level of handwaving has oft 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 '309 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 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.* at 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.* at 9.

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

All of the petitioned grounds are nearly entirely based on Neibauer, Cheng, and Squibbs. Pet. 10-11. 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 '039 Patent. EX1022, pp. 170, 186, 199, 312.^{2 3}

The rest of the references play minor and/or provisional roles in the claims. Pet. 11 (“Ground 2 cites to Bandera (EX1017) solely for features of dependent claim 21. Grounds 3-4 are substantially similar to Grounds 1-2, but add Harvey (EX1010), solely to account for a potential construction of “application-based 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.”) (emphasis original).

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

³ Petitioner relies on the published application of Squibbs, while the resulting patent (US 6,914,626) was considered by the Examiner.

Petitioner states without explanation or support that “*Advanced Bionics* does not apply” to these references⁴ (Pet. 3-4), 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”); *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*,

⁴ The Petition refers to Ausems (EX1006), which was not used in this petition. Presumably this is a typo and was intended to refer to Bandera (EX1017).

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 the secondary references relevant to determining institution are substantially similar to art previously before the Examiner for the content Petitioner relies on:

Harvey (EX1010): Petitioner states that Harvey is added to a second, parallel set of grounds “solely to account for a potential construction of “application-based 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. 11. But Petitioner also represents to the Board in its Claim Construction section that “[for purposes of this IPR, express constructions are not required.” Pet. 9. Patent Owner agrees that express constructions are not required at this stage, and thus that the Board need not consider Petitioner's parallel grounds 3-4 relying on Harvey.

Bandera (EX1017): Petitioner relies on Bandera in a single dependent claim, for the straightforward notion of “selecting and delivering advertisements to an Internet user based on the physical location of their mobile device.” Pet. 49. That functionality is disclosed in US 2005/0177645 to Dowling et al., which was before the Examiner. EX1022, p.208. For example, Dowling discloses:

A geographical web browser allows a user to navigate a network application such as the Word Wide Web by physically navigating in geographical coordinates and roaming through coverage areas of cellular base stations, wireless LANs, microcells, and other such broadcast domains.

Dowling (EX2003), Abstract.

A geographical web browser has an added advantage of providing a new means for advertising locally available items such as products and services. The user interested in a certain product or service logs into a geographically controlled web site and configures the packet filter to display information related to a user's needs. In one example the mobile unit **105** enters a new city and the user is interested in finding a mall with a particular clothing store within. As the user drives along, a web page comes up and provides directions to the shopping mall and also optionally provides an inside map of the mall to include directions to the desired store.

Dowling, [0064]. Dowling's disclosure is substantially similar to the material Petitioner relies on in Bandera.

Thus, all art necessary to decide institution 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.

A wholesale appeal 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. 5-6), but omits that the applicant expressly responded: “To the extent the 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, p.338.

Thus, Petitioner’s apparent theory—that simply applying Neibauer and Cheng to Gobburu (the Examiner’s cited “closest prior 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 below, all of Petitioner’s grounds are deficient at least with respect to the limitation “permitting interaction between a user of the mobile device and one or more additional users” which was included in the limitations in Claim 1 the Examiner expressly found lacking in Gobburu, as well as other related limitations. *Id.* p.305.

Even setting that aside, Petitioner’s apparent argument—that the Examiner should have combined Neibauer and Cheng with Gobburu and rejected on that basis—lacks any specificity that might show material error. Petitioner says not a word about that combination, what it would look like, 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). Setting aside Petitioner’s gentle exaggeration (the PTAB affirmed the Examiner’s rejection on grounds not involving Cheng (EX1024 at 14)), Petitioner’s apparent inference—that the reexamination

result somehow shows that not rejecting the '039 claims over Neibauer was material error—is belied by the fundamental differences between the claims:

US8,135,801	'039 Patent
1. A method for managing information content in a network-based communication system, the method comprising the steps of:	19. A method comprising:
providing a first web-based interface accessible to a first user, the first web-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	receiving, at a server from a mobile device, content for insertion into a previously established application-based information channel, the previously established application-based information channel permitting interaction between a user of the mobile device and one or more 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.	receiving, at the server from the mobile device, information associated with at least one wireless networking functionality of the mobile device;
	integrating the content and the information associated with said at least one wireless networking functionality of the mobile device into the previously established application-based information channel; and
	inserting other content from at least one of the additional users into the previously established application-based information channel.

And what is more, the Examiner of the '039 Patent not only was the same Examiner of the predecessor '801 Patent that was reexamined, but *considered that reexamination decision while examining the '039 Patent*. EX1022, p.197 (Examiner-initialed IDS containing only three references, all related to the reexamination). Petitioner grapples with none of this.

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 four obviousness grounds of unpatentability. Pet. 3. For the purpose of this Response, the Board need only consider the validity of independent claims 19 and 23 of Grounds 1 and 3. 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.*, at 1380.

B. Person of Ordinary Skill in the Art

For purposes of the POPR, MDT applies Petitioner's characterization of a person of ordinary skill in the art ("POSITA").

C. Claim Construction

For purposes of this Response, MDT agrees with Petitioner that no express claim constructions are required.

D. Non-Obviousness of Grounds Based on Neibauer, Cheng, and Squibbs (Claims 19-20, 22-23)

All four grounds challenging claims 19-20 and 22-23 rely on unpatentability over at least Neibauer, in view of Cheng and in further view of Squibbs under 35 U.S.C. §103, citing the declaration of Vijay K. Madiseti, Ph.D. (EX1002), as support. Pet. 9-10.

Claim 19 recites, in part "receiving, at a server from a mobile device, content for insertion into a previously established application-based information channel permitting interaction between a user of the mobile device and one or more

additional users,” “receiving, at the server from the mobile device, information associated with at least one wireless networking functionality of the mobile device,” and integrating or inserting the content and device information into the previously established application-based information channel. Thus, the application-based information channel permits interaction between users by sharing content and other information from their mobile devices. Independent claim 23 recites 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.

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. Neibauer, pp. xv, 4.

Petitioner acknowledges this content from Neibauer was considered by the Examiner and made of record in granting the claims of the '309 Patent. Pet. 4 (citing EX1022, Pages 00170 (covering Neibauer, pp. 467-491) and 00186 (covering Neibauer, pp. 115-180)).

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. 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 that is limited to allowing a user

to view Yahoo! services and Yahoo! generated and stored content sent to a user's mobile device (p. 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, ¶¶58, 60, 63. 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). Cheng, 4:56-5:10; and col. 17-22 (exemplary SW-Transforms); EX2001, ¶59. 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 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, ¶¶58, 60. 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.* ¶¶61-62. 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.* ¶63.

Petitioner relies on Cheng to show that a mobile device could have accomplished the claimed interactive features missing from Neibauer. However, Cheng is deficient in this regard because it only provides for transmission of data from a website to be displayed on a mobile device, but does not provide for transmission in the other direction (i.e., sending data from the mobile device to the server hosting the website). EX2001, ¶¶75-76, 80. The Cheng proxy server would have had to have been designed to support such upstream data transfer. *Id.* ¶86. The Petition fails to present evidence and analysis that overcomes this deficiency.

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

Petitioner maps the “receiving . . . from a mobile device” and “permitting interaction between a user of the mobile device and one or more additional users” limitations onto the upstream transfer of data such as pictures from a mobile device running the Yahoo! Clubs website disclosed in Neibauer. Pet. 13-19; EX2001 ¶¶81,

83. Petitioner relies on Neibauer alone to disclose these limitations except, in the alternative, for the proposition of using Yahoo! Clubs on a mobile device Petitioner turns to Cheng (Pet. 19-24). 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 19 as recited in limitation 19[a]. *Id.* at 13. Limitation 19[a] states:

receiving, at a server from a mobile device, content for insertion into a previously established application-based information channel, the previously established application-based information channel ***permitting interaction between a user of the mobile device and one or more additional users;***

(emphasis added).

Petitioner maps Neibauer's clubs, messaging, chat, and photography features of the Yahoo! clubs functionality discussed in Chapter 21 to the claimed server that receives content "from a mobile device" as well as the "application-based information channel" that "permit[s] interaction between a user of the mobile device and one or more additional users for sharing content between the first user and one or more additional users." *Id.* at 13-19. These several pages of mapping of the Yahoo! Clubs features and conclusory statement that Neibauer discloses the claimed features is supported by a citation to a nearly identical recitation of the same text and conclusion found in the supporting declaration of Madisetti (¶¶88-90). 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 “receiving . . . from a mobile device, content” and “permitting interaction between a user of the mobile device and one or more additional users” limitations. *Id.* at 13-19.

While Petitioner has mapped the claim language to the disclosure of Neibauer, Petitioner does not provide any additional explanation for how Neibauer “receiv[es] . . . from a mobile device, content for insertion into a previously established application-based information channel” and “permit[s] interaction between a user of the mobile device and one or more additional users for sharing content between the first user and one or more additional users” as the limitations are arranged in the claim. Neibauer is devoid of such functionality as it is focused only on the read-only functionality of mobile access to traditional websites. There is no evidence that the Yahoo! Clubs functionality could have been supported by users accessing the services on a mobile device.

The deficiency of the prior art to teach or suggest receiving content from and permitting interaction with a user of a mobile device of limitation 19[a] is not cured by the “Yahoo! Mobile” and “Yahoo! To Go” functionality. Petitioner reaches to that 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. Pet. 25. 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. Neibauer, 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 ¶¶60-62. Neibauer presents the Yahoo! Mobile and Yahoo! To Go features as only providing a unidirectional access to view information from a limited number of Yahoo! services.

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, such as the required screen size, mobile device memory, processing power, and wireless bandwidth. *Id.* ¶58. Comparing the features of the club pages to what content and features of 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. *Id.* ¶¶59-62, 65-66. The deficiencies of Neibauer are not solved by Cheng.

Focusing on the word “mobile” in claim 1, Petitioner argues Cheng discloses accessing non-mobile webpages, such as Neibauer, into a format accessible by mobile devices. Pet. 19. Cheng’s proxy server model would not have supported two-way content sharing for mobile devices. Cheng discloses a unidirectional re-

formatting of a conventional source website for viewing on a circa 2000 mobile device. Cheng, 4:56-5:10; and EX2001, ¶¶70-76. Cheng's disclosure of translating a conventional web page for viewing on a mobile device does not provide any additional understanding of how an exchange of information would be accomplished in the reverse, from a mobile device back to the conventional web page alone or in combination with the disclosure of Neibauer. Accordingly, combining Cheng with the system of Neibauer would not support sharing because Cheng too merely provides one-way access and viewing of information by a mobile device of content originating at a server. Cheng, 3:31-33 (discussing how the proxy server 110 "'sits' between the client (e.g., the mobile device(s) 108) and the origin web server(s) 102 that provide Web content 104."); EX2001, ¶80.

As such, the lack of Neibauer alone, or in combination with Cheng, to disclose, teach, or suggest bidirectional sharing of information to facilitate an interaction between a user and a mobile user 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).

4. 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 combination⁵ in order to allow a user to make use of the relied-on functionality in Clubs on a mobile device. Pet. 22-26. 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

⁵ Petitioner also adds Squibbs to this combination to satisfy certain other claim limitations, but for the functionality of the purported combined system discussed here Petitioner relies only on the combination of Neibauer and Cheng.

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 available for use on personal digital assistants ("PDAs") through its Yahoo! Mobile and Yahoo! To Go services. Pet. 19. 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 ¶105 (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. Again, this is not surprising: memory, bandwidth, and screen space at the time were at a premium. EX2001 ¶¶61-64.

Compare these minimalist renditions to desktop browser views of some of the Clubs
functionality Petitioner relies on:

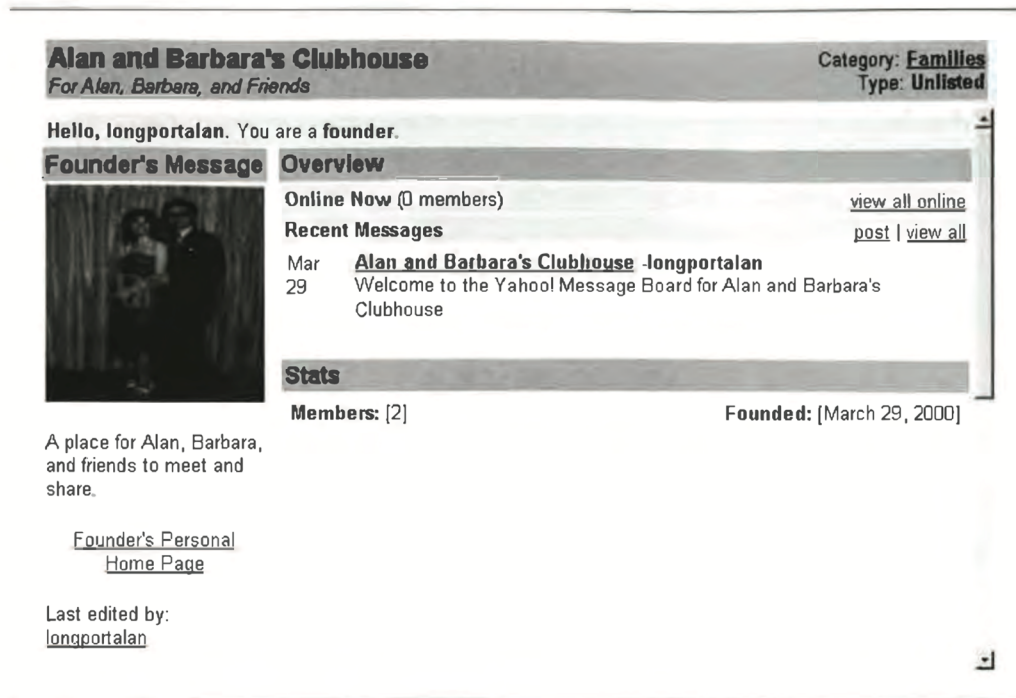
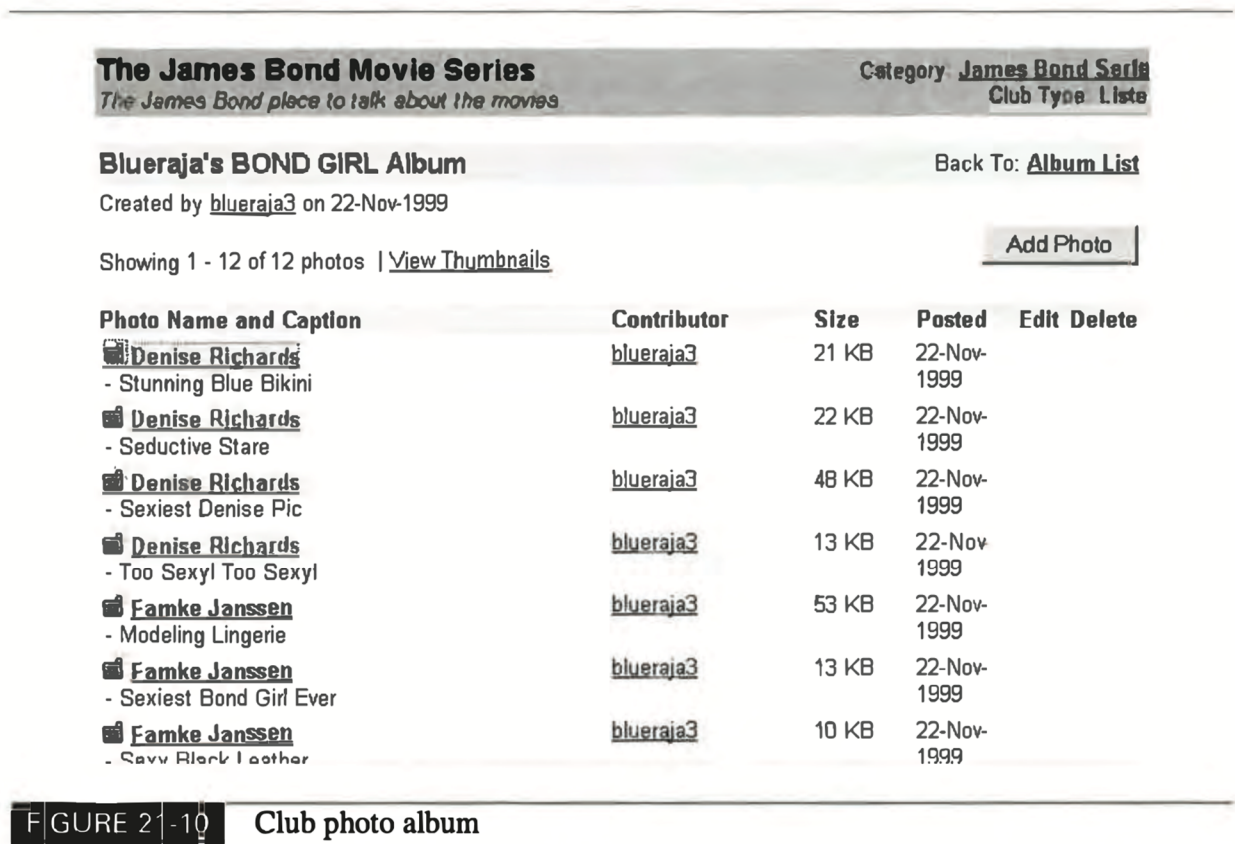


FIGURE 21-13 A Personal club



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: mobile devices being able to receive and view the Yahoo! Clubs website, as well as upload pictures to club photo albums (“Add Photo” button in Figure 21-10). Pet. 13-15. 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. 19) 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. EX2001 ¶¶58, 61-66.

Undeterred by these warning signs, Petitioner pivots to a fallback⁶ obviousness combination by adding Cheng's translation proxy server. Pet. 19. But Petitioner already argued it would have been obvious to adapt Neibauer to provide Clubs through Yahoo Mobile and Yahoo! To Go based on Neibauer alone, and does

⁶ Despite Petitioner presenting Yahoo! Mobile/Yahoo! To Go and Cheng as alternative obviousness theories, some limitations in the grounds appear dependent on the Neibauer-Cheng combination (e.g., limitation 19(d) (Pet. 42)). Consistent with this is the fact that Petitioner opted not to advance grounds using Neibauer without Cheng.

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. 23), 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*. 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. EX2001 ¶¶ 73-74. 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.

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. 24), 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. 23. 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.*

b. Petitioner does not show a reasonable expectation of success

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.

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

Grounds 1 and 3 challenging independent claims 19 and 23 rely on Neibauer and Cheng. Ground 2 relies on Ground 1, and Ground 4 relies on Ground 3. Because the combination of Neibauer and Cheng does not render obvious independent claims 19 and 23, it cannot render obvious dependent claims 20-22, and institution based on Grounds 1-4 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 8,074 words using the word count feature of Microsoft Word.

Dated: March 13, 2024

/Kevin S. Tuttle/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR 42.6, the undersigned hereby certifies that the above-captioned Mobile Data Technologies LLC's Preliminary Response of U.S. Patent No. 9,032,039 was served via electronic mail on March 13, 2024, as authorized by Petitioner's Mandatory Notices dated December 6, 2023 Paper 2 at 2), to the following e-mail correspondence of record:

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