

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EBAY, INC.,

Petitioner,

v.

LEXOS MEDIA IP, LLC,

Patent Owner.

Case IPR2024-00336

U.S. Patent No. 5,995,102

PETITION FOR *INTER PARTES* REVIEW

OF U.S. PATENT NO. 5,995,102

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LIST OF EXHIBITS¹

Exhibit	Title
EX1001	U.S. Patent No. 5,995,102 entitled <i>Server System and Method for Modifying a Cursor Image</i> to James Samuel Rosen et al. (“the ’102 Patent”).
EX1002	U.S. Patent No. 6,118,449 entitled <i>Server System and Method for Modifying a Cursor Image</i> to James Samuel Rosen et al. (“the ’449 Patent”).
EX1003	Declaration of Dr. Craig Rosenberg.
EX1004	U.S. Patent No. 6,437,800 to Mark A. Malamud (“Malamud”).
EX1005	U.S. Patent No. 5,835,911 to Toru Nakagawa, et al. (“Nakagawa”).
EX1006	U.S. Patent No. 5,937,417 to Jakob Nielsen (“Nielsen”).
EX1007	<i>Lexos Media IP, LLC v. APMEX, Inc.</i> , No. 2:16-cv-00747-JRG-RSP (“ <i>APMEX</i> ”), Early Claim Construction Opinion and Order, Dkt. 86 (E.D. Tex., Mar. 16, 2017).
EX1008	<i>Lexos Media IP, LLC v. Amazon.com, Inc.</i> , No. 2:22-cv-00169-JRG, Parties’ Joint Claim Construction and Prehearing Statement, Dkt. 89 (E.D. Tex., May 16, 2023) (including the exhibits attached thereto).
EX1009	U.S. Patent No. 5,754,176 to Chris Crawford (“Crawford”).
EX1010	File History of the ’102 Patent.
EX1011	File History of the ’449 Patent.
EX1012	Curriculum Vitae of Dr. Craig Rosenberg.
EX1013	Appendices to the Declaration of Dr. Craig Rosenberg.
EX1014	<i>Lexos Media IP, LLC v. Amazon.com, Inc.</i> , No. 2:22-cv-00169-JRG, Claim Construction Memorandum Opinion and Order, Dkt. 130 (E.D. Tex. Sep. 5, 2023)
EX1015	<i>Lexos Media IP, LLC v. Nike, Inc.</i> , No. 2:22-cv-00311-JRG, Claim Construction Order, Dkt. 187 (E.D. Tex. Nov. 2, 2023)

¹ Given the near complete overlap of the documents relied upon in this IPR Petition and those relied upon in the IPR Petition on the related ’449 Patent, Petitioner has included in this list and in both Petitions all documents relied upon in the two IPR Petitions so that the Board need only refer to one set of Exhibits.

Petition for *Inter Partes* Review
U.S. Patent No. 5,995,102

Exhibit	Title
EX1016	<i>Lexos Media IP, LLC v. Overstock.Com, Inc.</i> , No. 2:22-cv-2324-JAR-ADM, Memorandum and Order, Dkt. 99 (D. Kan. Dec. 4, 2023)
EX1017	<i>Lexos Media IP, LLC v. eBay, Inc.</i> , 6:22-cv-00648, Parties' Joint Claim Construction and Prehearing Statement (Dkt. 76) (W.D. Tex. Oct. 17, 2023) (including the exhibits attached thereto)
EX1018	Lex Machina Stay Statistics on N.D. Cal.

I. INTRODUCTION

eBay, Inc. (“Petitioner”) requests *inter partes* review (“IPR”) of claim 72 (the “Challenged Claim”) of U.S. Patent No. 5,995,102 (“the ’102 Patent”) (EX1001) assigned to Lexos Media IP, LLC (“Lexos” or “Patent Owner”). A Motion for Joinder is being submitted herewith, requesting this proceeding be joined with IPR2023-01000, stylized *Amazon.com Inc. v. Lexos Media IP, LLC* (“the Amazon IPR”). A trial was instituted against the ’102 Patent in the Amazon IPR on December 12, 2023. The instant Petition is a copycat of the petition filed in the Amazon IPR and is being timely filed. As recognized by the Institution Decision in the Amazon IPR, this Petition shows that there is a reasonable likelihood of invalidity of the Challenged Claim. For the reasons set forth below and in the corresponding Motion for Joinder, review should be instituted, and the Challenged Claim should be found unpatentable and canceled.

II. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(b)

A. Real Parties-in-Interest

Pursuant to 37 C.F.R. § 42.8(b)(1), Petitioner identifies the following as the real party-in-interest: eBay, Inc.

B. Related Matters

Petitioner is contemporaneously filing an IPR petition against claims 1, 27 38, and 53 of U.S. Patent No. 6,118,449 (“the ’449 Patent”), which is a continuation of

the '102 Patent.² A motion for joinder accompanies the '449 patent petition, seeking joinder to IPR2023-01001, which was instituted on December 12, 2023.

The '102 Patent, the '449 Patent, and U.S. Patent No. 7,975,241 (“the '241 Patent”) (collectively, the “Lexos Patents”) are asserted against Petitioner in *Lexos Media IP, LLC v. eBay, Inc.*, No. 3:23-cv-06314-LJC (N.D. Cal.) (the “Northern District Litigation”).³ A complaint for patent infringement was first served on Petitioner on June 6, 2022 in *Lexos Media IP, LLC v. eBay, Inc.*, 6:22-cv-00648 (W.D. Tex.) (“the Western District Case”). On December 6, 2023, Judge Albright issued an Order granting Petitioner’s request to transfer venue to the Northern District of California. *See Lexos Media IP, LLC v. eBay, Inc.*, 3:23-cv-6314 (N.D. Cal.) (“the Northern District Litigation”). The Northern District Litigation is in an early stage: a Rule 26(f) report is due by February 29, 2024, and an initial case management conference is scheduled for March 7, 2024. Petitioner’s Motion to

² For consistency and ease of reference for the Board across both related IPR Petitions, all citations to the specification in both Petitions will be made to the column and line numbers of the '102 Patent (EX1001).

³ Lexos alleges in the District Court Litigation that it is the owner of the '102 and '449 Patents. Lexos is recorded as the current assignee of those Patents.

Dismiss Lexos' Second Amended Complaint, filed June 13, 2023, also remains pending.

In addition to the Northern District Litigation, Lexos appears to be currently asserting the '102 and '449 Patents in the following cases:

Lexos Media IP, LLC v. Amazon.com, Inc., No. 2:22-cv-00169 (E.D. Tex.);

Lexos Media IP, LLC v. Walmart Inc., No. 2:22-cv-00316 (E.D. Tex.);

Lexos Media IP, LLC v. Overstock.com, Inc., No. 2:22-cv-02324 (D. Kan.);

Lexos Media IP, LLC v. Nike, Inc., No. 2:22-cv-00311 (E.D. Tex.);

Lexos Media IP, LLC v. Gap Inc., No. 2:22-cv-00299 (E.D. Tex.);

Lexos Media IP, LLC v. Ulta Beauty, Inc., 2:22-cv-00292 (E.D. Tex.);

Lexos Media IP, LLC v. Office Depot, LLC, No. 2:22-cv-00273 (E.D. Tex.);

and

Lexos Media IP, LLC v. Target Corp., No. 2:22-cv-00175 (E.D. Tex.).

Also, in addition to the Western District Case, Lexos appears to have previously asserted the '102 Patent and/or the '449 Patent (or those patents were at issue) in the following cases, all of which are now terminated:

Lexos Media IP, LLC v. CDW LLC, No. 2:22-cv-00275 (E.D. Tex.);

Lexos Media IP, LLC v. MSC Industrial Direct Co., No. 3:22-cv-01736 (N.D. Tex.);

Lexos Media IP, LLC. v. ABT Elecs., Inc., No. 1:22-cv-04878 (N.D. Ill.);

Lexos Media IP, LLC v. N. Tool & Equip. Co., No. 2:22-cv-00355 (E.D. Tex.);

Lexos Media IP, LLC v. Ace Hardware Corp., No. 2:22-cv-00304 (E.D. Tex.);

Lexos Media IP, LLC v. The TJX Cos., No. 2:22-cv-00285 (E.D. Tex.);

Lexos Media IP, LLC v. La-Z-Boy Inc., No. 6:21-cv-00205 (W.D. Tex.);

Lexos Media IP, LLC v. ASICS Am. Corp., No. 6:21-cv-00117 (W.D. Tex.);

Lexos Media IP, LLC v. Luxottica Grp. SpA, No. 6:21-cv-00096 (W.D. Tex.);

Lexos Media IP, LLC v. Gift Svcs., Inc., No. 6:20-cv-01156 (W.D. Tex.);

Lexos Media IP, LLC v. Urban Outfitters, Inc., No. 6:20-cv-01142 (W.D. Tex.);

Ralph Lauren Corp. v. Hirshfeld, No. 20-1862 (Fed. Cir.);

Ralph Lauren Corporation v. Lexos Media IP, LLC, No. 20-1864 (Fed. Cir.);

Ralph Lauren Corporation et al v. Lexos Media IP, LLC, IPR2018-01749 (P.T.A.B.);

Ralph Lauren Corporation et al v. Lexos Media IP, LLC, IPR2018-01755 (P.T.A.B.);

Lexos Media IP, LLC v. Jos A Bank Clothiers, Inc., No. 1:17-cv-01317 (D. Del.);

Lexos Media IP, LLC v. Oriental Trading Co., No. 1:17-cv-01318 (D. Del.);

Lexos Media IP, LLC v. Ralph Lauren Corp., No. 1:17-cv-01319 (D. Del.);

Lexos Media IP, LLC v. TJX Cos., No. 1:17-cv-01320 (D. Del.);

Lexos Media IP, LLC v. Williams-Sonoma, Inc., No. 1:17-cv-01321 (D. Del.);

Lexos Media IP, LLC v. AmeriMark Direct, LLC, No. 2:17-cv-00372 (E.D. Tex.);

Lexos Media IP, LLC v. Boscov's Dep't Store, LLC, No. 2:17-cv-00373 (E.D. Tex.);

Lexos Media IP, LLC v. APMEX, Inc., No. 2:16-cv-00747 (E.D. Tex.);

Lexos Media IP, LLC v. Costco Wholesale Corp., No. 2:16-cv-00748 (E.D. Tex.);

Lexos Media IP, LLC v. Musician's Friend, Inc., No. 2:16-cv-00749 (E.D. Tex.);

Lexos Media IP, LLC v. Nordstrom, Inc., No. 2:16-cv-00750 (E.D. Tex.);

Lexos Media IP, LLC v. Saks Inc., No. 2:16-cv-00751 (E.D. Tex.);

Lexos Media IP, LLC v. Victoria's Secret Stores Brand Mgmt., Inc., No. 2:16-cv-00752 (E.D. Tex.);

Lexos Media IP, LLC v. Recreational Equip., Inc., No. 2:15-cv-02107 (E.D. Tex.);

Lexos Media IP, LLC v. Sears Brands, LLC, No. 2:15-cv-02098 (E.D. Tex.);

Lexos Media IP, LLC v. The Neiman Marcus Group, LLC, No. 2:15-cv-02100 (E.D. Tex.);

Lexos Media IP, LLC v. Express, LLC, No. 2:15-cv-02073 (E.D. Tex.);

Lexos Media IP, LLC v. Avon Prods., Inc., No. 2:15-cv-02052 (E.D. Tex.);

Lexos Media IP, LLC v. The Home Depot USA, Inc., No. 2:15-cv-02051 (E.D.

Tex.);

Lexos Media, Inc. v. Zynga, Inc., No. 1:12-cv-07994 (S.D.N.Y.);

Lexos Media, Inc. v. Zynga, Inc., No. 2:12-cv-00395 (M.D. Fla.); and

Zynga Inc. v. Lexos Media, Inc., No. 5:12-cv-01952 (N.D. Cal.).

As explained herein, various claim terms of the '102 Patent have been construed in various ones of these proceedings; none of those constructions affect the instant IPR.

Ralph Lauren Corporation (“RLC”) previously petitioned for *inter partes* review of claims 70-73 of the '102 Patent (IPR2018-01749), and review was instituted. In a Final Written Decision (“FWD”), the Board held that RLC (1) had demonstrated that claims 71 and 73 were unpatentable as obvious, but (2) had not demonstrated unpatentability of claims 70 and 72. *Ralph Lauren Corp. v. Lexos Media IP, LLC*, IPR2018-01749, Paper 21 at 35 (P.T.A.B. Apr. 3, 2020). RLC appealed, and the Federal Circuit affirmed the Board’s decisions. *Ralph Lauren Corp. v. Hirshfeld*, 852 Fed. App’x 540 (Fed. Cir. 2021).

C. Counsel and Service Information

Counsel for Petitioner eBay, Inc.	
Lead Counsel	Back-Up Counsel
Heath J. Briggs (Reg. No. 54,919)	Joshua L. Raskin (Reg. No. 40,135)

briggsh@gtlaw.com Greenberg Traurig, LLP 1144 15 th Street, Suite 3300 Denver, CO 80202 Phone: (303) 685-7418 Fax: (303) 572-6500	Joshua.Raskin@gtlaw.com Greenberg Traurig, LLP One Vanderbilt Avenue New York, NY 10017 Phone: (212) 801-6930 Fax: (212) 801-6400
Back-Up Counsel	Back-Up Counsel
Brian J. Prew (Reg. No. 76,717) prewb@gtlaw.com Greenberg Traurig, LLP One Vanderbilt Avenue New York, NY 10017 Phone: (212) 801-3129 Fax: (212) 801-6400	Vimal M. Kapadia (Reg. No. 73,310) Vimal.Kapadia@gtlaw.com Greenberg Traurig, LLP One Vanderbilt Avenue New York, NY 10017 Phone: (212) 801-2241 Fax: (212) 801-6400
Back-Up Counsel	
Kathryn E. Albanese (Reg. No. 78,153) Katie.Albanese@gtlaw.com Greenberg Traurig, LLP One Vanderbilt Avenue New York, NY 10017 Phone: (212) 801-6533 Fax: (212) 801-6400	

A power of attorney pursuant to 37 C.F.R. §42.10(b) accompanies this Petition. Petitioner consents to and prefers electronic service by emailing ebay-Lexos-IPRs@gtlaw.com and counsel identified above.

III. PAYMENT OF FEES

Petitioner authorizes the U.S. Patent & Trademark Office to charge Deposit Account No. 50-2638 for the necessary fees for this Petition.

IV. GROUNDS FOR STANDING

Petitioner certifies that the '102 Patent is available for review. As noted above, Petitioner is filing herewith a Motion for Joinder to the Amazon IPR (IPR2023-01000), which was instituted on December 12, 2023. The Motion for Joinder and this Petition are timely, being filed within one month of the institution date of the Amazon IPR. 37 C.F.R. § 42.122. Moreover, although Petitioner was served with a complaint for patent infringement relative to the '102 Patent more than 1-year ago, the one-year bar of § 315(b) does not apply to Motions for Joinder. 35 U.S.C. §315(b).

V. PRECISE RELIEF REQUESTED

A. Challenged Claim

Petitioner requests review of claim 72 of the '102 Patent (the “Challenged Claim”) and cancellation of that claim as unpatentable.

B. Statutory Grounds of Challenge

The Challenged Claim should be canceled as unpatentable in view of the following grounds:

Ground 1: Claim 72 is obvious under pre-AIA 35 U.S.C. § 103 over U.S. Patent No. 6,437,800 (“Malamud”).

Ground 2: Claim 72 is obvious under pre-AIA 35 U.S.C. § 103 over Malamud and U.S. Patent No. 5,835,911 (“Nakagawa”).

Ground 3: Claim 72 is obvious under pre-AIA 35 U.S.C. § 103 over U.S. Patent No. 5,937,417 (“Nielsen”) and Malamud.

For purposes of this proceeding only, Petitioner assumes the earliest effective filing date of the ’102 Patent is June 25, 1997, which is the filing date of U.S. Application No. 08/882,580 to which the ’102 Patent claims priority.

Malamud issued on August 20, 2002 from Application No. 08/329,724, which was filed on October 26, 1994, as a continuation of Application No. 08/054,564, filed on April 28, 1993. Nakagawa issued on November 10, 1998 from Application No. 517,133, which was filed on August 21, 1995, as a continuation-in-part of Application No. 385,460, filed on February 8, 1995. Nielsen issued on August 10, 1999 from Application No. 08/643,893, which was filed on May 7, 1996. Therefore, Malamud, Nakagawa, and Nielsen each qualify as prior art under at least § 102(e) (pre-AIA).

As addressed in Section X, below, none of the grounds presented herein have been previously considered.

VI. LEVEL OF ORDINARY SKILL

A person of ordinary skill in the art (“POSITA”) at the claimed priority date would have had experience in the fields of human factors engineering or human computer interaction. (EX1003 at ¶¶31-35.) The POSITA would have at least a bachelor’s degree in computer science, computer engineering, human factors

engineering, or a related field and would have had at least two years of relevant work experience in the fields of UI design, or equivalent experience.⁴ (*Id.*)

VII. OVERVIEW OF THE '102 PATENT

A. Priority Date of the '102 Patent

The '102 Patent issued on November 30, 1999 from U.S. Patent Application No. 08/882,580, which was filed on June 25, 1997. Therefore, the earliest possible priority date for the '102 Patent is June 25, 1997.

B. State of the Art Before the Application for the '102 Patent

1. Cursors in Graphical User Interfaces

A graphical user interface (“GUI”) is one form of human-computer interface that was in widespread use by 1997. (EX1003 at ¶40.) The “desktop metaphor” is one well-known type of GUI that was used before 1997 and remains in use today. A desktop metaphor GUI uses graphical icons to represent computer files and applications on a virtual desktop, and users can interact with the icons using a pointing device, such as a mouse, rollerball, touchpad, or stylus pen. (*Id.*)

Computer interface devices, including pointing devices and display screens, generally have “drivers,” which are programs dedicated to communicating between

⁴ Dr. Rosenberg qualified as a POSITA by the asserted priority date, and he is qualified to testify to what such a person would have understood at the time of the claimed invention. (EX1003 at ¶36.)

the device and other software like application programs or the operating system (“OS”). (*Id.* at ¶¶43-44.) The OS manages computer hardware and software resources, and it can act as an intermediary between application programs and the hardware drivers. (*Id.*) For example, a “display driver” can accept commands from the OS and generate signals to the display device to render the desired text or image, including GUI elements, on the display device’s screen. (*Id.*)

When a user moves a pointing device, such as a mouse, an image called a “cursor” moves correspondingly onscreen. (*Id.*) The cursor’s image is the actual image drawn by the OS’s display function or application to visually indicate the cursor’s position on the screen. (*Id.*) Cursor images generally include a single pixel, called the “hotspot,” that identifies the location on the screen where input from a user, such as a mouse click, would have an effect. (*Id.* at ¶49.)

Applications and code other than the OS can also affect the cursor’s appearance. (*Id.* at ¶45.) For example, an application may modify displayed graphical elements, such as the cursor image, by sending data and/or commands to the OS. (*Id.*)

While OSs have for decades provided standard images for cursors, such as an arrow or a pointing hand, they also allowed applications to customize the appearance of cursors. (*Id.* at ¶¶51-54.) Because cursors were a core part of the user experience, and the user’s attention was often focused on or near the cursor on-screen, computer

designers commonly placed additional information around the cursor. (*Id.* at ¶¶59-60.) For example, U.S. Patent No. 5,754,176 to Crawford (filed on October 2, 1995) describes a “tooltip” system built into Microsoft Windows to display help information when a user held the cursor over an object displayed on the screen. (EX1009 at 2:28-37.)

2. Client/Server Systems

The client/server architecture is a fundamental system design that has been well-known for decades. (EX1003 at ¶¶61-63; EX1005 at 3:1-5.) Client/server systems can function in many ways. For example, a client can download an application from a server and run that application locally. (EX1003 at ¶64.) Alternatively, applications can be run on a remote server, with display information sent to the client computer for display to a user. (*Id.*)

Client/server systems have long been a critical part of the internet, such as where web browsers allow users’ computing devices (*i.e.*, “clients”) to download web pages with graphical information from websites hosted in servers. (*Id.* at ¶65.) Given the well-known use of custom cursors and the equally well-known use of client/server systems to transmit information between a server and client, it is little surprise that these practices to modify a cursor’s image using content transmitted between a server and client was likewise well known. (*Id.*) This approach was built into the widely used “X Windows” system, first released in 1986. (*Id.* at ¶¶52-54.)

C. Summary of the '102 Patent

Consistent with the foregoing description of the state of the art in June 1997, the '102 Patent admits that it was “not new” to change the shape of cursor images:

Presently, pointer icons change from application to application and can also change within an application depending upon where on the screen the pointer is located, what state the computer exists in at a given moment, and what tools are being used, among other factors. Generally, pointers change shape to reflect an internal state of the computer or the present function within an application.

(EX1001 at 3:39-46.) But the '102 Patent identifies alleged deficiencies:

While it is not new for pointers and cursors to change shape, pointers are not presently used to convey advertising. In conventional systems, the appearance of the cursor or pointer does not change to correspond with on-line content being displayed on the screen.

(*Id.* at 3:46-50.) Thus, the Background section of the patent explains that “there is a need for a simple means to deliver advertising elements, i.e., logos, animations, sound, impressions, text, etc., without the annoyance of totally interrupting and intrusive content delivery, and without the passiveness of ordinary banner and frame advertisements which can be easily ignored.” (*Id.* at 2:27-32.)

The '102 Patent purports to address those deficiencies through “[a] system for modifying a cursor image . . . to a specific image having a desired shape and appearance” (*id.* at Abstract) where the specific image represents a corporate name or logo, a brand logo, an advertising or marketing icon or slogan, or animated advertising image, to provide on-screen advertising. (*Id.* at 2:44-47, 2:63-3:3, 3:64-4:3.) The cursor’s appearance can also correspond to the content displayed on the user’s screen. (*Id.* at 2:58-62, 7:7-9.) For example, the '102 Patent discloses that the cursor modification can be the rendering of the cursor as a baseball bat on a sports website (*id.* at 17:33-34) or as a pink cursor on a website about Pink Panther (*id.* at 17:34-35). The '102 Patent provides other examples of a modified cursor image, such as a witch on a broomstick for Halloween (*id.* at 17:35-36) or as the Statue of Liberty for Fourth of July (*id.* at 17:36-37).

Figure 8 of the '102 Patent, annotated below, shows an example where the cursor is modified from a standard pointer arrow (shown in Figure 7) into the “specific image” of a bottle (designated “44a” and with the red circle highlight added) to advertise a cola drink:

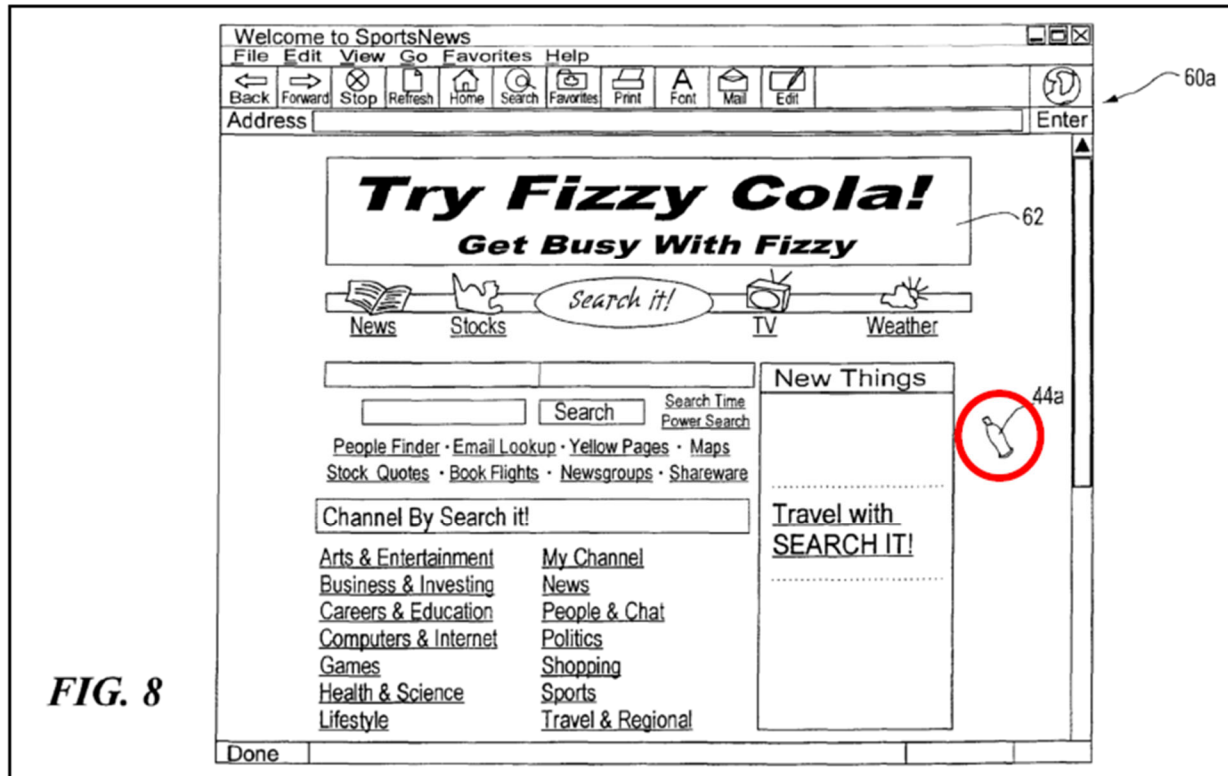


Figure 8 (annotated).

VIII. CLAIM CONSTRUCTION

Under *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), claim terms are typically given their ordinary and customary meanings as understood by a POSITA at the time of the invention based on the claim language, specification, and the prosecution history of record. *Id.* at 1312-16. However, “[t]he Board is required to construe ‘only those terms...that are in controversy, and only to the extent necessary to resolve the controversy.’” *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (alteration in original) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

As noted in the Amazon IPR, aside from the previously construed claim term from the *APMEX* case (addressed below), it is believed that no constructions of any other claim terms are necessary for the Board to find claim 72 is unpatentable.⁵ *Ralph Lauren Corp. v. Lexos Media IP, LLC*, IPR2018-01749, Paper No. 21 at 11 (P.T.A.B. Apr. 3, 2020) (finding no claim terms of the '102 Patent needed construction).

As noted in the Amazon IPR, while Amazon and Patent Owner agreed to the construction of some claim terms and have proposed competing constructions for some claim terms in that district court litigation (EX1008), Petitioner contends that those proposed constructions do not affect this Petition because the limitations of the Challenged Claim are disclosed in, or rendered obvious by, the prior art under both Amazon's and Patent Owner's proposed constructions. The analysis set forth below would not differ under either Amazon's or Patent Owner's proposed construction.

⁵ Petitioner reserves all rights to raise claim construction and other arguments, including challenges under 35 U.S.C. §§ 101 or 112, in district court as relevant to that proceeding. *See, e.g., Target Corp. v. Proxicom Wireless, LLC*, IPR2020-00904, Paper 11 at 11-13 (P.T.A.B. Nov. 10, 2020). A comparison of the claims to any accused products in litigation may raise controversies that are not present here given the similarities between the prior art references and the '102 Patent.

A. Claim Term Construed in *APMEX*: “said specific image including content corresponding to at least a portion of said information to be displayed on said display of said user’s terminal”

As noted in the Amazon IPR, Lexos asserted the ’102 Patent in *Lexos Media IP, LLC v. APMEX, Inc.*, No. 2:16-cv-00747-JRG-RSP (E.D. Tex.) (“*APMEX*”), and the district court construed the term “said specific image including content corresponding to at least a portion of said information to be displayed on said display of said user’s terminal” to mean “an image representative of at least a portion of the subject or topic being displayed on the screen.” (EX1007 at 12-13). Amazon and Patent Owner agreed with that construction (EX1008 at 3), and Petitioner also agrees that construction should be applied here, even adopting that construction in the Western District Case. (EX1017 at 2).

As noted in the Amazon IPR, that construction does not change the analysis regarding any of the grounds presented here because, as discussed below, Malamud’s preview cursor contains content corresponding to the object displayed on the user’s screen to which the pointer is pointing. Additionally, Nielsen’s tooltips contain content corresponding to the object displayed on the user’s screen to which the pointer is pointing.

In the Board’s Institution Decision in the Amazon IPR (“the Amazon I.D.”), the Board noted the *APMEX* construction but found that it did not need to construe

any claim terms to institute trial. IPR2023-01000, Paper 9 at 15-17 (P.T.A.B. Dec. 12, 2023).

B. Subsequent Claim Constructions

Since the filing of the Amazon IPR, claim terms from the '102 Patent have been construed in three litigations. *See* EX1014 (*Lexos Media IP, LLC v. Amazon.Com, Inc.*, No. 2:22-cv-169-JRG, Claim Construction Memorandum Opinion and Order, Dkt. 130 (E.D. Tex. Sep. 5, 2023)); EX1015 (*Lexos Media IP, LLC v. Nike, Inc.*, No. 2:22-cv-311-JRG, Claim Construction Order, Dkt. 187 (E.D. Tex. Nov. 2, 2023)); and EX1016 (*Lexos Media IP, LLC v. Overstock.Com, Inc.*, No. 2:22-cv-2324-JAR-ADM, Memorandum and Order, Dkt. 99 (D. Kan. Dec. 4, 2023)). In the Amazon IPR, Lexos submitted the *Amazon* litigation constructions. (IPR2023-01000, POPR at 29, explaining EX2008.) The Amazon I.D. noted Patent Owner's submission and concluded:

“[w]e do not understand Patent Owner to be making any arguments regarding the grounds in the Petition that specifically rely on, require, or differ from the constructions in the district court's Order....Thus, at this time, we note these constructions, but do not construe any terms.”

IPR2023-01000, Paper 9, at 16-17 (P.T.A.B. Dec. 12, 2023) (emphasis added). Accordingly, the *Amazon* district court constructions do not impact this Petition or the Motion for Joinder.

The *Nike* court generally adopted the *Amazon* constructions, except the additional term “*corresponding to*” as used in the phrase “*cursor image data corresponding to [a/said] specific image*”” was given its plain meaning while an additional requirement of “*and that indicates where user input can be received*” was added to the *Amazon* construction of the terms “*cursor image*” / “*initial cursor image*.” (EX1015 at 6-11.)

In the *Overstock* litigation, the parties agreed that the majority of the *Amazon* and *Nike* constructions should be adopted, while disputing two constructions. (EX1016 at 6-7.) Nonetheless, all terms were construed per the *Amazon* and *Nike* constructions. (*Id.* at 8-14.) Neither the *Nike* nor the *Overstock* district court constructions impact this Petition or the Motion for Joinder as the prior art reads on the Challenged Claim under any reasonable construction of the claim terms.

In the Western District Case, Petitioner and Patent Owner agreed to the construction of some claim terms while proposing competing constructions for other claim terms.⁶ (EX1017). None of the competing constructions affect this Petition because the limitations of the Challenged Claim are disclosed in, or rendered obvious by, the prior art under any reasonable construction. Moreover, as

⁶ Judge Albright transferred the case to the Northern District of California before conducting a *Markman* hearing.

recognized by the Amazon I.D., there is currently no reason to specifically construe any terms in order to apply the prior art to the claims. Accordingly, Petitioner agrees to move forward in accordance with the Amazon I.D., where all terms of the '102 Patent are currently construed in accordance with their plain and ordinary meaning.⁷

IX. DETAILED EXPLANATION OF GROUNDS

A. Overview of Prior Art References

1. Malamud (EX1004)

Malamud relates to “information cursors” for use in an OS or in application programs. (EX1004 at Abstract.) “[An] information cursor includes a pointing portion to point to objects displayed on a video display and an information portion to display information about an object to which the pointing portion points.” (*Id.*) One type of information cursor is a “preview cursor,” which is shown in Malamud’s Figure 3, reproduced below:

⁷ Again, Petitioner reserves all rights to raise claim construction and other arguments, including challenges under 35 U.S.C. §§ 101 or 112, in district court as relevant to that proceeding.

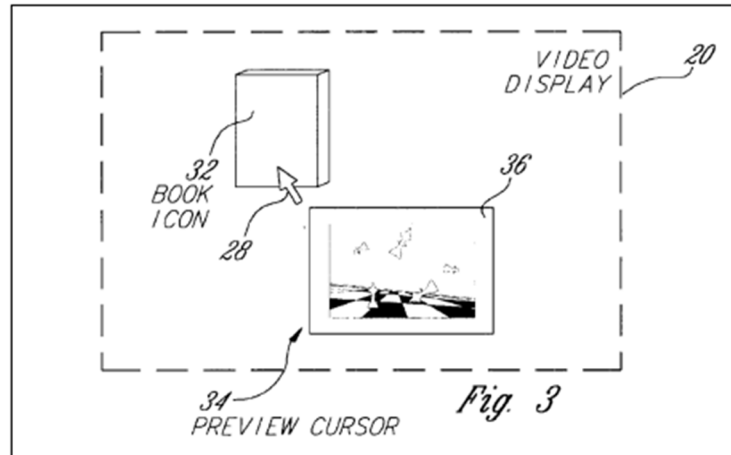
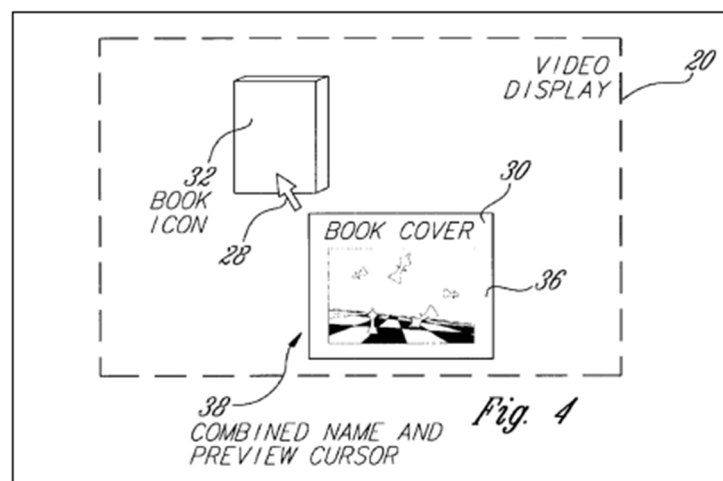


Figure 3 illustrates a preview cursor 34 pointing to book icon 32. (*Id.* at 3:59-65.) The preview cursor 34 includes pointing portion 28 in the shape of an arrow pointing to book icon 32 (*id.* at 3:65-68), and it includes preview portion 36, which holds a preview of the contents of the object to which the pointing portion is pointing (*id.* at 3:61-4:3).

Figure 4 illustrates another type of information cursor, a “combined name and preview cursor” 38 pointing to book icon 32. (*Id.* at 4:4-18.)



Like a preview cursor, a combined name and preview cursor include a pointing portion 28 in the shape of an arrow and a preview portion 36, which holds

a preview of the contents of the object the cursor is pointing to. (*Id.* at 4:8-9, 4:14-15.) But the combined name and preview cursor also includes a name box in which the name of the object being pointed to can be displayed. (*Id.* at 4:10-13.)

To implement the display of information cursors, the OS of the computer maintains a message queue for each program that generates windows, and when a mouse event occurs, such as movement of the mouse or a mouse click, a message from the OS is placed into the queue for the program. (*Id.* at 4:56-5:9.) Malamud teaches that the windows procedure for the application program then determines if there is a named entity at the location pointed to by the cursor. (*Id.* at 5:28-36.) If not, either a conventional cursor is displayed, or an information cursor is displayed with the information portion blank. (*Id.* at 5:39-45.) If there is a named entity at that location, then the windows procedure for the application program responds by passing a message to the OS that indicates the type of information cursor to be displayed and information to be included in the cursor display (*e.g.*, a text string for a name box and/or a pointer to graphical information for a preview cursor). (*Id.* at 5:36-45, 5:47-6:16.) The application program can also control whether the use of information cursors is enabled. (*Id.* at 5:66-6:17.)

2. Nakagawa (EX1005)

Nakagawa relates to a system and method for software distribution and maintenance through which “a software vendor can provide a number of users with

software over a network.” (EX1005 at Title, Abstract, 1:13-16.) In the “Background of the Invention” section, Nakagawa explains that by August 1995, there was “well-known prior art to distribute and obtain software update information” for a user’s computer from a server. (*Id.* at 1:21-22, 1:34-37.) Nakagawa explains that such systems could be used by a vendor to distribute software to customers over a network, or that a user could obtain software over a network by accessing a software library stored remotely for download. (*Id.* at 1:34-41, 1:46-50.) Nakagawa further explains that an executable program can be compiled on a vendor’s computer and then downloaded by the user’s computer, or the source files for a program can be downloaded and then compiled into an executable program on the user’s computer. (*Id.* at 1:66-2:6.) Nakagawa says that these methods are carried out in what was known as a “client/server method.” (*Id.* at 3:1-5.)

3. Nielsen (EX1006)

Nielsen relates to a system and method for displaying “tooltips” on web pages. (EX1006 at Abstract, 1:1-6, 1:51-54.) In the “Background of the Invention” section, Nielsen explains that a user views a web page through a browser program. (*Id.* at 1:19-20.) Through the browser program, the user submits a request to a web server for a web page that is then transmitted to the user’s computer. (*Id.* at 1:19-28.) Nielsen explains that information displayed on web pages might be compact, such

as abbreviations, and therefore there was a need to present users with additional information about the things displayed on web pages. (*Id.* at 1:29-48.)

Nielsen teaches a solution to this problem through an extension to HTML (HyperText Markup Language) that permits web page designers to include “tooltips” for web pages. (*Id.* at 1:51-62.) As Nielsen explains, “tooltips” “are text areas that display automatically when the user places the cursor over predetermined text on a display device.” (*Id.* at 1:54-56.) The use of tooltips was already known in the art (*see, e.g.*, EX1009 at 2:28-46 (describing tooltips in Windows systems)), but Nielsen teaches extending the use of tooltips to web pages and extending the use beyond just text, such as displaying a graphical image as a tooltip when the cursor is placed over another graphical object displayed on the screen. (*See, e.g.*, EX1006 at 1:51-62, 3:35-41, 3:61-4:4.)

Nielsen further teaches that a web page can specify the use of a tooltip through text included in the HTML code. The first part of the HTML code identifies that a tooltip is being used and identifies the tooltip that will be displayed. (*Id.* at 3:52-56.) For example, `<TOOLTIP TXT = “London Heathrow”>` would cause the text “London Heathrow” to be displayed when the tooltip is invoked by placing the cursor over the text or object that would trigger the tooltip display. (*Id.* at 3:52-56, 5:3-8, Fig. 5(a).) But the displayed tooltip is not limited to text, as an “icon or other illustrations” can also be displayed as the tooltip. (*Id.* at 3:61-63.)

The next part of the HTML code identifies the information that the cursor must point to on the user's display to trigger the display of the tooltip. (*Id.* at 3:64-4:4.) In the example shown in Fig. 5(a), this information is "LHR," which indicates that when the cursor hovers over the text "LHR" displayed on the screen, the tooltip will be invoked, and "London Heathrow" will be displayed. (*Id.* at 5:3-8; Fig. 5(a); Fig. 4.) Nielsen further teaches that information displayed on the user screen that triggers the display of the tooltip is not limited to text, but can be "any information that has a visual appearance on a display device 160 including images, literal character strings and, animations . . . []." (*Id.* at 3:65-4:2.)

Nielsen teaches that the tooltip is preferably displayed in proximity to the object on the user's display screen that triggered the display of the tooltip when the cursor was hovered over it. (*Id.* at 7:9-14, 7:19-32.)

B. Motivation to Combine References

1. Legal Standard

A patent claim is invalid as obvious if the differences between the claimed subject matter and the prior art are such that the claimed subject matter as a whole would have been obvious to a POSITA at the time the invention was made. 35 U.S.C. § 103. Obviousness is a question of law based on underlying facts, including: (1) "the scope and content of the prior art," (2) the "differences between the prior art and the claims at issue," (3) "the level of ordinary skill in the pertinent art," and (4)

any “secondary considerations,” or objective indicia, of nonobviousness. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

The Supreme Court has given examples of motivations for combining or modifying prior art references, including “interrelated teachings of multiple patents,” and the “background knowledge,” “creativity,” and “ordinary skill and common sense.” *KSR*, 550 U.S. at 418-21. The Court has further recognized that a combination may be “obvious to try” if “[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill [in the art] has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.” *Id.* at 421. The Federal Circuit has provided similar guidance, noting that “[t]he reason, suggestion, or motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved.” *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009).

A POSITA, who is “a person of ordinary creativity, not an automaton,” would have been motivated to combine the teachings in Malamud, Nakagawa, Nielsen in

the manner claimed by the Challenged Claim. *ClassCo, Inc. v. Apple, Inc.*, 838 F.3d 1214, 1219 (Fed. Cir. 2016) (citing *KSR*, 550 U.S. at 421); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073-75 (Fed. Cir. 2015).

2. Motivation to Download Malamud's Application Program from a Server, and the Obviousness of Doing So

Malamud describes an application program that runs on a user's computer and modifies a cursor image when the cursor points to an object on the display screen, where the modified cursor image is related to the object the cursor points to on the display screen. (EX1004 at Abstract, 1:35-42.) Malamud does not describe how the user's computer obtains the application program, but it was well-known in the art that application programs could be downloaded over a network from a server, and it would have been common sense to do so given the reduction in distribution costs and increased speed by which users could obtain the latest version of an application program using a client-server system. (EX1003 at ¶¶88-93.)

There were a finite number of ways for a user computer to obtain an application program, such as having the application program pre-installed on a computer; copying the application program to the user's computer from a floppy disc, CD ROM, or an external drive; or copying it to the user's computer from a server over a network. (*Id.* at ¶92.) Any application program that used Malamud's cursor modification method that did not come pre-installed on a computer at the time of purchase would have needed to be distributed using one of the other methods.

(*Id.*) And distribution over a network would be faster and less expensive than distribution via floppy disc, CD ROM, or other external media. A POSITA would therefore have been motivated to distribute Malamud's application program from a server to user computers over a network because that would lower costs by eliminating the need to produce and distribute copies of the program on floppy discs or CD ROMS, and it would increase the speed at which users could obtain the program. (*Id.*) Additionally, by distributing the application program from a server over a network, users could receive the most up-to-date version of the program, while a program distributed by floppy disc or CD ROM could become outdated upon the release of a newer version of the program before the user even received the floppy disc or CD ROM. (*Id.*)

A POSITA thus would have been motivated to distribute Malamud's application program over a network using a server, and it would have been well within the technical skill of a POSITA to do so with a high likelihood of success. (*Id.* at ¶93.) This distribution of Malamud's application program from a server would not have been innovative, but rather the result of ordinary skill and common sense. (*Id.*)

3. Motivation to Combine the Teachings of Malamud and Nakagawa, and the Obviousness of that Combination

As disclosed in Nakagawa, software applications could be distributed by a vendor to individuals that had purchased the software, or the software could be made

available in a software library on a network server from which users could request and download application programs. (EX1005 at 1:34-37, 1:46-49, 1:52-54, 3:1-5.) For the reasons discussed in the preceding section, a POSITA would have been motivated to distribute application programs, including Malamud's application program containing the cursor-modification functionality, from a server to users over a network as disclosed in Nakagawa. (EX1003 at ¶¶115-117.)

A POSITA therefore would have been motivated to combine the teachings of Malamud and Nakagawa to distribute Malamud's application program to users over a network from a server, and it would have been well within the technical skill of a POSITA to do so with a high likelihood of success. (*Id.*) This combination of Malamud with the teachings of Nakagawa regarding software distribution from a server would not have been innovative, but rather the result of ordinary skill and common sense. (*Id.*)

4. Motivation to Combine the Teachings of Nielsen and Malamud, and the Obviousness of that Combination

Nielsen teaches a system and method for displaying tooltips on a web page that has been downloaded from a server. (EX1006 at Abstract, 1:51-57.) The tooltip is displayed when the cursor hovers over text or a graphical image on the user's display screen, and the tooltip provides additional information in the form of text or graphical information about the object to which the cursor is pointing. (*Id.* at

1:51-57, 3:35-41, 3:61-63, 3:65-4:4.) The tooltip is displayed in proximity to the object to which the cursor is pointing. (*Id.* at 6:28-32, 7:8-14.)

Malamud is a contemporary reference to Nielsen and from the same field of endeavor, as Malamud similarly teaches a system and method for displaying additional information about an object to which the cursor is pointing on a display screen. (EX1004 at Abstract, 1:35-42.) Like Nielsen, Malamud teaches that the additional information that is displayed can be in the form of text or a graphical image. (*Id.* at 2:66-3:6, 3:59-4:18.) Thus, Nielsen and Malamud address similar problems and provide similar solutions. (EX1003 at ¶143.)

While Nielsen teaches that the additional information is displayed in proximity to the object to which the cursor is pointing, Malamud teaches that the additional information is displayed as part of a modified cursor image. (EX1004 at Abstract, 3:59-4:18.) A POSITA would have been motivated to combine the teachings of Nielsen with Malamud's teaching of displaying the additional information as part of a modified cursor image because a user's attention is often focused on the cursor when navigating a computer display through the use of a pointing device such as a mouse. (EX1003 at ¶144.) When a user is looking at the cursor, the user could miss information displayed elsewhere on a screen. (*Id.*)

For example, Nielsen teaches displaying a tooltip in proximity to the object that the cursor is hovering over, such as above the object. (EX1006 at 7:8-14.) But

that could be a large object that takes up a significant portion of a display screen. If a cursor were to hover over the bottom portion of such an object, and a tooltip were displayed above the object, the user might miss the tooltip if the user's attention is focused on the cursor location on the screen. (EX1003 at ¶145.) By making Nielsen's tooltip appear as part of a modified cursor image, the additional information (*i.e.*, text and/or graphics) would appear at the location on the screen where the user's attention is most likely focused. (*Id.*) Therefore, a POSITA would have been motivated to combine the teachings of Nielsen and Malamud in this manner. (*Id.*) Moreover, such a modification would have been well within the technical skill level of a POSITA, as it could have been implemented by processing Nielsen's tooltip instruction in a manner to display the tooltip information as part of a modified cursor as disclosed in Malamud. (*Id.*) Such a modification would have had a high chance of success, as software is not an unpredictable art, and the software would have functioned according to its programming. (*Id.*)

C. Ground 1: Claim 72 is Rendered Obvious by Malamud

Element 72[Preamble]: A method for modifying an initial cursor image displayed on a display of a user terminal connected to at least one server, comprising:

Malamud teaches a method for modifying on the display of a user terminal an initial cursor image, such as a "conventional cursor," to a specific cursor image that

includes a graphical image of the object to which the cursor is pointing. Specifically, Malamud teaches that when the cursor is at a location on the display screen where no named entity is present, a “conventional cursor” image or an “information cursor” without any corresponding specific information is displayed. (EX1004 at 5:39-44.) When the cursor is moved over a named entity displayed on the screen, the cursor image is modified to an “information cursor” that includes text and/or a graphical image related to the object on the display screen to which the cursor is pointing. (*Id.* at 5:32-39; *id.* at 2:66-3:1 (“The present invention provides ‘information cursors’ which display graphical or textual information about an object to which the cursor points.”); *id.* at 3:59-4:3 (discussing a “preview cursor,” which depicts a graphical image object on the display screen to which the cursor points).)

Malamud does not address whether the user’s computer is connected by a network to a server, but connecting user computers to a server was desirable, beneficial, well known to POSITAs, and commonplace well before June 1997. (*See* § IX(B)(2); EX1003 at ¶¶88-93; EX1005 at 3:1-5.) For example, it was quite common by that time to have computers connected to one or more servers in many different contexts, such as: in an enterprise, where employee computers were connected to company servers; in an educational setting, where student computers were connected to a school server; or in a home, where an individual’s computer would connect to internet servers. (EX1003 at ¶89.) The inventors of the ’102 Patent

admit that, by 1997, millions of people all over the world were using personal computers to access digital content over the internet. (EX1001 at 1:9-19.) Thus, a POSITA would have been motivated to use Malamud's method for modifying a cursor image on a computer connected to a server (*see supra* § IX(B)(2)), and it would have been obvious to do so (EX1003 at ¶¶88-94).

Element 72[a]: receiving a request at said at least one server to provide specified content information to said user terminal;

Malamud teaches the use of information cursors, including a “preview cursor,” by an application program. (EX1004 at Abstract (“Information cursors are provided for use in an operating system and/or *application programs*.”) (emphasis added).) The application program includes content to be displayed on the screen when the program is run, and it includes instructions regarding the modified cursor, such as whether to display an information cursor, when to display the cursor, the type of information cursor to display, and an indication of the content of the information cursor. (*Id.* at 5:24-45, Figs. 3 and 4 (depicting book icon 32, which relates to the application running in that window), 4:56-59 (discussing windows displayed on the screen generated by various programs), 3:59-4:18 (discussing the “preview cursor” and the “combined name and preview cursor”); EX1003 at ¶96 (explaining that Malamud's application program contains information to display objects on a user's screen, including objects to which the cursor can point as well as

modified cursors (*i.e.*, information cursors)).) Thus, Malamud teaches specified content information in the form of an application program that includes information for use in the display on the user's terminal.⁸

Malamud is silent as to how the data processing system (the user computer) obtains the application program, but it was well-known to a POSITA by June 1997 that a user could request and download an application program from a server. (EX1003 at ¶¶88-93; *see, e.g.*, EX1005 at 3:1-9.) A POSITA would also have been motivated to download application programs, such as the one described in Malamud, from a server for the reasons set forth in section IX(B)(2). Thus, it would have been obvious to a POSITA to combine Malamud's teaching of an application program for modifying a cursor image with the well-known procedure of downloading an application program from a server. That combination renders this claim limitation obvious, as the request to download Malamud's application program from a server would be a request to a server to provide specified content information to a user

⁸ Amazon, Patent Owner and Petitioner agree that the claim terms "specified content information" and "content information" mean "information provided to a user's terminal for use in the display, such as a web page." (EX1008 at 3; EX1018 at 2; EX1001 at Abstract, 2:58-62, 3:4-9, 24:14-24.)

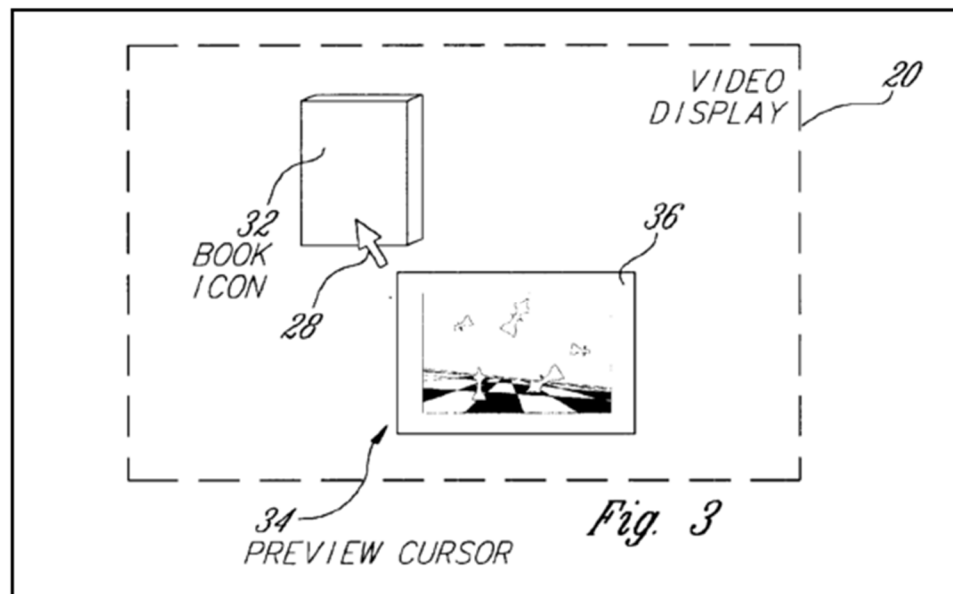
terminal because, as discussed above, the application program would include information for use in the display on the user's computer. (EX1003 at ¶97.)

Element 72[b]: providing said specified content information to said user terminal in response to said request, said specified content information including at least one cursor display instruction and at least one indication of cursor image data corresponding to a specific image; and

As discussed in conjunction with claim element 72[a], it would have been obvious in view of Malamud for a user to request and receive from a server an application program comprising specified content information because the disclosed application program includes information regarding the display of elements depicted by the application program, including objects to which the cursor can point and modified cursors (*i.e.*, information cursors).

The application program in Malamud includes at least one cursor display instruction in the program, as evidenced by cursor display message generated by the application program. (EX1004 at 5:47-62 (describing the message that is passed describing the type of cursor to display and information about the contents of the modified cursor image); EX1003 at ¶100.) For example, the application program in Malamud contains instructions whether to display an information cursor, and if so, the type of information cursor (such as a preview cursor or a combined name and preview cursor) for each entity displayed in the application window. (EX1004 at

3:59-4:18; 5:24-45; 5:46-62.) Malamud also teaches that, for a preview cursor, the application program transmits, and therefore contains, an indication of cursor image data in the form of “a pointer to a bitmap of graphical information that the operating system 22 should use in the preview portion 36.” (*Id.* at 5:57-62.) The bitmap is a “specific image” that is displayed as a modified cursor image, and it relates to an object on the display screen to which the cursor is pointing because it provides further information about the object. (*Id.* at 5:57-62, 3:59-4:3; EX1003 at ¶100.) For example, Malamud teaches that if the cursor is pointing to a book, the bitmap can constitute an image that provides further information about the book. (EX1004 at 3:65-4:3; *see. e.g., id.* at Fig. 3.)



Thus, this limitation would have been obvious to a POSITA in view of Malamud. (EX1003 at ¶¶98-101.)

Element 72[c][i]: transforming said initial cursor image displayed on said display of said user terminal into the shape and appearance of said specific image in response to said cursor display instruction, wherein said specified content information includes information that is to be displayed on said display of said user's terminal, wherein said specific image includes content corresponding to at least a portion of said information that is to be displayed on said display of said user's terminal, and

Malamud teaches that when the cursor is not pointing to a named object in the window for the application, “either a conventional cursor is displayed or the information containing portion (*e.g.*, name box 30, preview portion 36, or property box 40) of the information cursor is shown in blank (step 57).” (EX1004 at 5:39-44.) The conventional cursor or the information cursor lacking any corresponding specific information is an “initial cursor image.”

Malamud further teaches determining whether the cursor has been moved over an object displayed in the application's display window that has an identity (*i.e.*, an information cursor for that object). (*Id.* at 5:32-34.) Malamud instructs that “[i]f a named entity is present at the specified cursor position, the information regarding the object at the specified cursor position is displayed in the information cursor (step 56).” (*Id.* at 5:36-39.) This is achieved in accordance with the instructions in the application program regarding the details about the information

cursor for that object. For example, if the information cursor is a preview cursor, this modified cursor image will include a graphical image related to the object on the display screen to which the cursor is pointing. (*Id.* at 3:59-4:3.) That graphical image is the specific image contained in the bitmap. (*Id.* at 5:57-62.) The instructions are implemented using code in the application to process the instructions cause a message to be passed from the application program's window procedure to the OS that "tells the operating system what type of cursor to display and sets forth the contents and type of information to be displayed in the cursor (step 58 in FIG. 7)." (*Id.* at 5:47-53.) Thus, Malamud teaches transforming the initial cursor image into the shape and appearance of the specific image in response to a cursor display instruction. (EX1003 at ¶103.)

Malamud further teaches that the application program provides the information to be displayed in the window for that application. (EX1004 at 3:36-41, 3:63-4:3; *see also id.* at 5:24-30 (discussing the application program controlling the display in a particular window); *see, e.g., id.* at Fig. 3 (depicting book icon 32 generated by the application program).) Thus, the "specified content information" received from the server in the form of the application program would include "information that is to be displayed on said display of said user's terminal." (EX1003 at ¶104.)

And as discussed above, the preview cursor (*i.e.*, the modified cursor image) includes a graphical image related to the object in the application window to which the cursor is pointing. (EX1004 at 3:59-4:18.) For example, if the cursor is pointing to a book, the preview cursor would include an image related to the subject matter of the book. (*Id.*) Therefore, Malamud teaches that the “specific image includes content corresponding to at least a portion of said information that is to be displayed on said display of said user’s terminal.” (EX1003 at ¶105.)

Element 72[c][iii]: wherein said cursor display instruction indicates a cursor display code operable to process said cursor display instruction to modify said cursor image to said cursor image in the shape and appearance of said specific image responsive to movement of said cursor image over a display of said at least a portion of said information to be displayed on said display of said user’s terminal.

Malamud’s application program includes instructions regarding the display of the information cursors for entities displayed on the screen, and the program contains code that is used to process the instructions and prepare and pass a message to the OS that indicates what type of cursor to display and, for a preview cursor, a pointer to a bitmap that should be displayed in the modified cursor image. (EX1004 at 5:47-62, Figs. 6-7.) Because the instruction includes information regarding the type of information cursor to be displayed, the instruction indicates what cursor display

code⁹ must be used to process the instruction to generate and transmit the proper message and to display the cursor appropriately. (See EX1004 at 5:47-62, Figs. 6-7; EX1003 at ¶¶107-108.) For example, Malamud teaches cursor display code in the form of an algorithm that would implement portions of Figures 6 and 7. (EX1004 at Figs. 6-7.) The cursor display instruction indicates whether an information cursor is associated with a displayed object and the type of information cursor, and that instruction would indicate what cursor display code should be used to process the instruction, format and transmit the message, and properly display the cursor based

⁹ In the *Amazon* district court litigation, Amazon contends that “cursor display code” should be given its plain and ordinary meaning. (EX1008 at Ex. 1, p. 1.) Patent Owner asserts that “cursor display code” means “computer code for modifying the display of the cursor image.” (*Id.*) Irrespective of which is correct, Malamud satisfies Patent Owner’s proposed construction, as the code in Malamud that interprets, transmits, and implements the instructions in the application program regarding whether to display an information cursor for a particular object or location, the type of information cursor to display, and what graphical information to display is “computer code for modifying the display of the cursor image.” (EX1004 at 5:46-62, Figs. 6-7; EX1003 at ¶107.)

on the type of information cursor. (*Id.* at 5:46-62, Figs. 6-7 (which would be implemented in code); EX1003 at ¶¶107-108.)

The instructions in the application program also includes a pointer to a bitmap, which specifies the shape and appearance of the specific image (*i.e.*, the image of the modified cursor). (EX1004 at 5:46-62; EX1003 at ¶108.) Malamud teaches that the cursor image is modified in response to the movement of the cursor over an object displayed in the application window (EX1004 at 5:24-39), and that object is a “display of said at least a portion of said information to be displayed on said display of said user’s terminal.”

While disclosed in Malamud, it also would have been obvious to a POSITA that a cursor display instruction indicates the cursor display code to use to process the cursor display instruction, as it was well known for application programs to indicate the code to use to display information on a user’s screen. (EX1003 at ¶109.) Additionally, by identifying the type of information cursor to display, the cursor display instruction indicates what cursor display code is needed to transfer the instruction information to the OS through the appropriate application programming interface (API) for that particular type of information cursor. (*Id.*) Such code is cursor display code because it causes the cursor image to change to the modified cursor image. (*Id.*) Thus, claim 72 would have been obvious to a POSITA in view of Malamud.

D. Ground 2: Claim 72 is Rendered Obvious by Malamud and Nakagawa

Element 72[Preamble]: A method for modifying an initial cursor image displayed on a display of a user terminal connected to at least one server, comprising:

As discussed above in Section IX(C), Element 72[Preamble], Malamud discloses a method for modifying an initial cursor image on a display of a user's terminal. Malamud does not address whether the user's computer is connected by a network to a server, but connecting user computers to a server was desirable, beneficial, commonplace, and well known to POSITAs well before June 1997. (*See* § IX(B)(2)-(3); EX1003 at ¶¶88-93, 112-113, 115-117; EX1005 at 3:1-5.) For example, Nakagawa discloses a user computer connected over a network to a server so that a user can request and download software from a server, as well as downloading updates to the software. (*See, e.g.*, EX1005 at Abstract ("A number of sets of software may be systematically distributed and maintained via a network connecting many vendors and users of client/server software."); *id.* at 1:13-16 ("The present invention relates to a software distribution and maintenance system and method with which a software vendor can provide a number of users with software over a network"); *id.* at 1:46-54 (describing a user's ability to download software from a vendor at the user's request).) The inventors of the '102 Patent even admit that, by 1997, millions of people all over the world were using personal computers

to access digital content over the internet. (EX1001 at 1:9-19.) Additionally, a user would have been motivated to combine the teachings of Malamud and Nakagawa. (*See supra* § IX(B)(3).) Thus, it would have been obvious to a POSITA to use Malamud's method for modifying a cursor image in conjunction with Nakagawa's disclosure of downloading software to a user's computer through a network connected to a server. (EX1003 at ¶¶120-122.)

Element 72[a]: receiving a request at said at least one server to provide specified content information to said user terminal;

As discussed in Section IX(C), Element 72[a], Malamud teaches specified contention information in the form of an application program that includes information for use in the display on the user's terminal. Malamud is silent as to how the data processing system (user computer) obtains the application program, but it was well-known to a POSITA by June 1997 that a user could request to download an application program from a server, as disclosed in Nakagawa. (Ex. 1005 at 3:1-9; EX1003 at ¶¶88-93, 112-113, 115-117.) For example, Nakagawa discloses a user computer connected over a network to a server so that a user can request and download software from a server, as well as downloading updates to the software. (*See, e.g.*, EX1005 at Abstract ("A number of sets of software may be systematically distributed and maintained via a network connecting many vendors and users of client/server software."), 1:13-16 ("The present invention relates to a software

distribution and maintenance system and method with which a software vendor can provide a number of users with software over a network”), 1:46-54 (describing a user’s ability to download software from a vendor at the user’s request).)

A POSITA would also have been motivated to download application programs, such as the one described in Malamud, from a server, as described in Nakagawa, for the reasons set forth in Sections IX(B)(2)-(3).

Thus, it would have been obvious to a POSITA to combine Malamud’s teaching of an application program for modifying a cursor image with the Nakagawa’s disclosure of the well-known procedure of downloading an application program from a server. That combination renders this claim limitation obvious, as the request to download Malamud’s application program from a server would be a request to a server to provide specified content information to a user terminal. (EX1003 at ¶¶125-128.)

Element 72[b]: providing said specified content information to said user terminal in response to said request, said specified content information including at least one cursor display instruction and at least one indication of cursor image data corresponding to a specific image; and

As discussed in conjunction with claim element 72[a], it would have been obvious in view of Malamud and Nakagawa for a user to request from a server, and receive in response, an application program. The application program comprises

specified content information because it includes information regarding the display of elements depicted by the application program, including objects to which the cursor can point and modified cursors (*i.e.*, information cursors), and it includes at least one cursor display instruction and an indication of cursor image data corresponding to a specific image. (*See* § IX(C) at Element 72[b]; EX1003 at ¶¶130-131.)

It would have been obvious to a POSITA to download Malamud's application program (comprising specified content information) from a server as disclosed in Nakagawa in response to a request (*see* § IX(B)(3)), where Malamud's application program includes a cursor display instruction and an indication of cursor image data relating to a specific image. (EX1004 at 5:47-62 (describing the message that passes information from the instruction describing the type of cursor to display and the contents of the modified cursor image); EX1003 at ¶¶130-131.) For example, the application program in Malamud contains instructions whether to display an information cursor, and if so the type of information cursor (such as a preview cursor or a combined name and preview cursor) for each entity displayed in the application window. (EX1004 at 3:59-4:18; 5:24-45; 5:46-62.) Malamud also teaches that, for a preview cursor, the application program transmits, and therefore contains, an indication of cursor image data in the form of "a pointer to a bitmap of graphical information that the operating system 22 should use in the preview portion 36." (*Id.*

at 5:57-62.) The bitmap is a “specific image” that is displayed as a modified cursor image, and it relates to an object on the display screen to which the cursor is pointing because it provides further information about the object. (*Id.* at 5:57-62, 3:59-4:3; EX1003 at ¶131.) For example, Malamud teaches that if the cursor is pointing to a book, the bitmap can constitute an image that provides further information about the book. (EX1004 at 3:65-4:3.)

Thus, this limitation would have been obvious to a POSITA in view of Malamud and Nakagawa. (EX1003 at ¶¶129-132.)

Element 72[c][i]: transforming said initial cursor image displayed on said display of said user terminal into the shape and appearance of said specific image in response to said cursor display instruction, wherein said specified content information includes information that is to be displayed on said display of said user’s terminal, wherein said specific image includes content corresponding to at least a portion of said information that is to be displayed on said display of said user’s terminal, and

As addressed in Section IX(C), Element 72[c][i], Malamud teaches this claim limitation.

Element 72[c][ii]: wherein said cursor display instruction indicates a cursor display code operable to process said cursor display instruction to modify said cursor image to said cursor image in the shape and appearance of said specific

image responsive to movement of said cursor image over a display of said at least a portion of said information to be displayed on said display of said user's terminal.

As addressed in Section IX(C), Element 72[c][ii], Malamud teaches this claim limitation and/or renders it obvious. Thus, claim 72 would have been obvious to a POSITA in view of Malamud and Nakagawa.

E. Ground 3: Claim 72 is Rendered Obvious by Nielsen and Malamud
Element 72[Preamble]: A method for modifying an initial cursor image displayed on a display of a user terminal connected to at least one server, comprising:

Nielsen teaches a method for displaying a tooltip on a display of a user terminal connected to at least one server. (EX1006 at Abstract, 1:18-26, 1:51-57.) The tooltip, which can be text and/or a graphic relating to the object to which the cursor is pointing (*id.* at 3:37-41, 3:52-56, 3:61-63), is displayed in proximity to the displayed object to which the cursor is pointing (*id.* at 7:8-12, 7:19-22). Malamud also teaches displaying text and/or a graphic relating to the object to which the cursor is pointing. (EX1004 at Abstract, 1:40-42, 3:59-4:17.) Malamud teaches that this text and/or graphic can be part of a modified cursor. (*Id.* at 3:59-4:3.). A POSITA would have been motivated to modify the teachings of Nielsen such that the tooltip is not displayed above the object to which the cursor is pointing, but rather is

displayed as part of a modified cursor image to ensure that user sees the supplemental information or graphic. (*See supra* § IX(B)(4); EX1003 at ¶¶142-145.) Thus, it would have been obvious to a POSITA to modify the teachings of Nielsen to modify an initial cursor image into a modified cursor image that includes the tooltip. (EX1003 at ¶¶146-148.)

Element 72[a]: receiving a request at said at least one server to provide specified content information to said user terminal;

Nielsen teaches receiving a request at server to provide specified content information. Specifically, Nielsen teaches that a user requests a web page from a server, and the server sends the HTML code for the requested web page to the user's computer. (EX1006 at 1:9-26, 1:51-57.) The HTML code for the web page includes information provided to a user's terminal for use in the display, including the web page content to be displayed and tooltip display instructions for displaying tooltips. (*Id.* at 1:18-26, 1:51-57, 3:36-41, 3:46-4:7.) As discussed above, a POSITA would have been motivated to modify Nielsen's tooltip display instructions to make them cursor display instructions, as taught by Malamud, and it would have been obvious to do so. (*See* § IX(E) at Element 72[Preamble]; *see also* § IX(B)(4) (regarding motivation to combine the teachings of Nielsen and Malamud); EX1003 at ¶¶142-145, 149-150.)

Element 72[b]: providing said specified content information to said user terminal in response to said request, said specified content information including at least one cursor display instruction and at least one indication of cursor image data corresponding to a specific image; and

Nielsen teaches that the server provides the specified content information in the form of HTML code for a web page to the user's computer in response to the user's request for the web page. (EX1006 at 1:12-14, 1:18-26.) The HTML code for the web page is specified content regarding the web page information to be displayed, and it includes instructions regarding the display of tooltips, such as an indication whether any tooltips are to be displayed, what is to be displayed, and the information on the user's screen to which the cursor must point to invoke the display of the tooltips. (*Id.* at 1:51-62, 3:35-41, 3:46-4:7.) While Nielsen's tooltips are displayed as separate images, a POSITA would have been motivated to display the tooltips as part of a modified cursor image, and it would have been obvious to do so. (*See* § IX(B)(4) (discussing the motivation to combine the teachings of Nielsen and Malamud); EX1003 at ¶¶142-145.) Thus, it would have been obvious to modify Nielsen's teachings to make the tooltip display instruction a *cursor* display instruction, which would make the indication of a bitmap for a graphical tooltip image into an indication of *cursor* image data corresponding to a specific image. (EX1003 at ¶¶151-152.)

Element 72[c][i]: transforming said initial cursor image displayed on said display of said user terminal into the shape and appearance of said specific image in response to said cursor display instruction, wherein said specified content information includes information that is to be displayed on said display of said user's terminal, wherein said specific image includes content corresponding to at least a portion of said information that is to be displayed on said display of said user's terminal, and

Nielsen teaches transforming the display on the user's terminal to display a tooltip when the cursor points to an object on the display screen that has an associated tooltip. (EX1006 at Abstract, 1:51-62, 3:35-41.) While Nielsen's tooltip is displayed as a separate image, a POSITA would have been motivated to modify the teachings of Nielsen such that the tooltip is displayed as part of a modified cursor image, as taught in Malamud, and it would have been obvious to do so. (See § IX(B)(4) (discussing the motivation to combine the teachings of Nielsen and Malamud); EX1003 at ¶¶142-145.) The modified cursor image is in the shape and appearance of the specific image specified by the bitmap and would be displayed in response to the tooltip instruction when the cursor is placed over an object on the screen that has an associated tooltip (EX1006 at 3:35-41, 3:46-4:7), and the tooltip instruction would be a cursor display instruction when the tooltip is displayed as part

of a modified cursor image by combining the teachings of Nielsen and Malamud. (EX1003 at ¶154.)

The specified content information received from the server in Nielsen (*i.e.*, the HTML code for the web page, including the tooltip instructions), includes information displayed on the user's computer, in the form of the web page and the tooltips. (EX1006 at 1:12-26, 1:51-57, 1:66-2:9.) Nielsen discloses that the displayed tooltip relates to and provides further information about an object on the computer display screen pointed at by the cursor. (*Id.* at 1:54-62, 3:35-41.) Similarly, Malamud teaches that the information cursor, such as a preview cursor or a combined name and preview cursor, also relates to the object on the computer display screen to which the cursor is pointing. (EX1004 at Abstract, 1:35-43, 2:9-12, 2:66-3:6.)

Therefore, a POSITA would have been motivated to combine the teachings of Nielsen and Malamud, and this limitation would have been obvious in view of those references. (*See* § IX(B)(4) (discussing the motivation to combine the teachings of Nielsen and Malamud); EX1003 at ¶¶142-145, 153-156.)

Element 72[c][ii]: wherein said cursor display instruction indicates a cursor display code operable to process said cursor display instruction to modify said cursor image to said cursor image in the shape and appearance of said specific image responsive to movement of said cursor image over a display of said at

least a portion of said information to be displayed on said display of said user's terminal.

Nielsen teaches HTML code for web pages, where the code contains tooltip instructions. (EX1006 at Abstract, 1:51-62.) The tooltip instruction includes information regarding whether a tooltip is to be displayed and the type of tooltip to be displayed, such as text or a graphical image. (*Id.* at 3:35-41, 3:46-63.) The tooltip therefore indicates the web browser code operable to process the instruction to display the appropriate type of tooltip. (*See, e.g., id.* at 1:36-37 (discussing that the browser software displays the tooltip as specified by the web page designer); *id.* at 3:54-56 (identifying the HTML text that indicates the presence of a tooltip that must be processed by the appropriate browser code); *id.* at 3:61-63 (identifying that a tooltip can also indicate that the tooltip should be displayed as an icon or other illustration); 5:20-58 (describing the processing that is performed using the browser code when a tooltip instruction is detected).) Nielsen further teaches an algorithm implemented by code to display the tooltip appropriately. (*Id.* at 5:18-6:20; *see also* Fig. 6(a) (step 606 indicating that the presence of a tooltip instruction indicates what portion of the algorithm, implemented by code, should be used to process the HTML code).)

The processing of Nielsen's tooltip instruction in the HTML code causes a tooltip to be displayed in response to the user placing the cursor over an object on

the displayed web page, where the object has an associated tooltip. (*Id.* at 3:35-41.)

The tooltip takes the shape of the specific image in the form of an icon or other illustration as identified by the tooltip instruction and related to an image displayed on the screen and to which the cursor is pointing. (*Id.* at 3:35-41, 3:61-63.)

While Nielsen's tooltip is displayed as a separate image, a POSITA would have been motivated to modify the teachings of Nielsen to display the tooltip as part of a modified cursor image, as taught in Malamud, and that modification would have been obvious. (*See* § IX(B)(4) (discussing the motivation to combine the teachings of Nielsen and Malamud); EX1003 at ¶¶142-145.) Modifying the teachings of Nielsen in such a manner would result in Nielsen's tooltip instruction being a cursor display instruction, Nielsen's tooltip display code being cursor display code, and Nielsen's tooltip being a modified cursor image in the shape and appearance of the specific image. (EX 1003 at ¶¶158-160.)

Thus, the combination of Nielsen and Malamud renders claim 72 obvious.

X. DISCRETIONARY DENIAL IS NOT APPROPRIATE

A. The Board Should Not Deny Institution Under *Fintiv*

Institution is appropriate under the six-factor test set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (precedential) ("*Fintiv*"), as further clarified by Director Vidal's June 21, 2022 interim procedure for discretionary denials (the "June 21st Memo") available at:

https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf.

In determining whether to exercise discretion to deny institution in view of a parallel proceeding, the Board considers the *Fintiv* factors and “takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv*, IPR2020-00019, Paper 11 at 6. Importantly, the June 21st Memo explained that “the PTAB will not rely on the *Fintiv* factors to discretionarily deny institution in view of parallel district court litigation where”—as here—“a petition presents compelling evidence of unpatentability.” June 21st Memo at 2.

Turning initially to the fourth and dispositive factor here (overlap between issues), Petitioner stipulates that, if this IPR is instituted, Petitioner will not pursue the grounds raised, or that reasonably could have been raised, in this IPR. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (P.T.A.B. Dec. 1, 2020) (precedential). There is therefore no overlap with arguments made in the district court proceedings. This stipulation “mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB,” and the Director has clarified that the PTAB will not discretionarily deny institution where, as here, Petitioner has made a *Sotera* stipulation. June 21st Memo, 7-8. Discretionary denial under the *Fintiv* factors is therefore not appropriate. The Board in the Amazon IPR recognized as much. (Amazon IPR, Paper 9, at 7-8.)

However, turning briefly to the additional factors for the sake of completeness, the first factor (stay) favors Petitioner. Petitioner will likely be seeking a stay of the Northern District Litigation and believes the district court would grant a stay if an IPR trial is instituted. The Northern District of California routinely grants a stay in cases where an IPR has been instituted. (EX1018.)

The second and third factors strongly favor Petitioner. As explained previously, on December 6, 2023, Judge Albright issued an Order granting Petitioner's request to transfer venue to the Northern District of California. No trial date is set in the Northern District Litigation and it is highly unlikely trial will be occur before the final written decision would issue in this case. Moreover, if the Board grants Petitioner's Motion for Joinder and institutes trial, the District Court case would likely be stayed pending outcome of this IPR. There has also been minimal investment in the Northern District Litigation. Conversely, the Board has already instituted trial in the Amazon IPR (IPR2023-01000), which Petitioner seeks to join via its contemporaneously filed Motion for Joinder.

The fifth factor (same parties) is neutral given the preceding considerations. Although Petitioner is also the Defendant in the parallel Northern District Litigation, Petitioner's above stipulation (addressed in regard to factor 4) should address the concern underlying this factor.

The sixth factor (other circumstances) strongly weighs in favor of institution.

As set forth in this Petition, and as confirmed by the Board’s Institution Decision in the Amazon IPR, the merits of the grounds are compelling. As the Director has explained, where “the information presented in the institution stage presents a compelling unpatentability challenge, that determination alone demonstrates that the PTAB should not discretionarily deny institution under *Fintiv*.” June 21st Memo at 4–5.

B. The Board Should Not Deny Institution Under 35 U.S.C. § 325(d)

As noted in the Amazon IPR, the Board also should not exercise its discretion under §325(d) to deny institution. Amazon Petition at 53-56, citing *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential). The Board agreed and already declined to exercise its discretion under § 325(d) in the Amazon IPR. (Amazon IPR, Paper 9 at 9-13.) Since this is a copycat Petition, no additional prior art or grounds are raised herein, and an *Advanced Bionics* analysis is inapplicable.

C. The Board Should Not Deny Institution Under *General Plastic*

As explained in the accompanying Motion for Joinder, the Board should not discretionarily deny this Petition under *General Plastic*.

XI. CONCLUSION

As recognized by the Board in the Amazon IPR, Petitioner has demonstrated a reasonable likelihood that it will prevail in challenging of patentability claim 72 of the '102 Patent. Petitioner therefore respectfully requests that the Board institute *inter partes* review on the '102 Patent and cancel claim 72 as unpatentable on the grounds identified herein.

Dated: December 20, 2023

Respectfully submitted,
/Heath Briggs/
Heath J. Briggs, Reg. No. 54,919
Greenberg Traurig, LLP
1144 15th St., Suite 3300
Denver, CO 80202

Joshua L. Raskin, Reg. No. 40,135
Brian J. Prew, Reg. No. 76,717
Vimal M. Kapadia, Reg. No. 73,310
Kathryn E. Albanese, Reg. No. 78,153
Greenberg Traurig, LLP
One Vanderbilt Avenue
New York, NY 10017

Counsel for Petitioner eBay Inc.

LISTING OF CHALLENGED CLAIM OF THE '102 PATENT

Claim 72

Element 72[Preamble]: A method for modifying an initial cursor image displayed on a display of a user terminal connected to at least one server, comprising:

Element 72[a]: receiving a request at said at least one server to provide specified content information to said user terminal;

Element 72[b]: providing said specified content information to said user terminal in response to said request, said specified content information including at least one cursor display instruction and at least one indication of cursor image data corresponding to a specific image; and

Element 72[c][i]: transforming said initial cursor image displayed on said display of said user terminal into the shape and appearance of said specific image in response to said cursor display instruction, wherein said specified content information includes information that is to be displayed on said display of said user's terminal, wherein said specific image includes content corresponding to at least a portion of said information that is to be displayed on said display of said user's terminal, and

Element 72[c][ii]: wherein said cursor display instruction indicates a cursor display code operable to process said cursor display instruction to modify said cursor image to said cursor image in the shape and appearance of said specific image responsive

to movement of said cursor image over a display of said at least a portion of said information to be displayed on said display of said user's terminal.

CERTIFICATE OF WORD COUNT UNDER 37 CFR § 42.24(d)

Under the provisions of 37 CFR § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Petition for *Inter Partes* Review totals 11,151 words, excluding the parts exempted by 37 C.F.R. § 42.24(a). This word count was determined using the built-in word count function tool in Microsoft® Word for Microsoft 365 MSO used to prepare the document.

Dated: December 20, 2023

Respectfully submitted,

/Heath Briggs/

Heath J. Briggs, Reg. No. 54,919
Greenberg Traurig, LLP
1144 15th St., Suite 3300
Denver, CO 80202

Joshua L. Raskin, Reg. No. 40,135
Brian J. Prew, Reg. No. 76,717
Vimal M. Kapadia, Reg. No. 73,310
Kathryn E. Albanese, Reg. No. 78,153
Greenberg Traurig, LLP
One Vanderbilt Avenue
New York, NY 10017
Phone: (212) 801-9200
Fax: (212) 801-6400

CERTIFICATE OF SERVICE

The undersigned hereby certifies that true copies of the foregoing PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 5,995,102 and supporting materials (Exhibits 1001-1018, Power of Attorney) have been served in their entirety this 20th day of December, 2023, by United States Postal Service (USPS) Priority Express Mail, or by means at least as fast and reliable USPS Priority Express Mail, at the correspondence address for the attorney of record for the '102 Patent shown in the USPTO's Patent Center:

WEINGARTEN SCHURGIN GAGNEBIN & HAYES LLP
TEN POST OFFICE SQUARE
BOSTON, MA 02109

Dated: December 20, 2023

Respectfully submitted,

/Heath Briggs/
Heath J. Briggs, Reg. No. 54,919
Greenberg Traurig, LLP
1144 15th St., Suite 3300
Denver, CO 80202

Joshua L. Raskin, Reg. No. 40,135
Brian J. Prew, Reg. No. 76,717
Vimal M. Kapadia, Reg. No. 73,310
Kathryn E. Albanese, Reg. No. 78,153
Greenberg Traurig, LLP
One Vanderbilt Avenue
New York, NY 10017
Phone: (212) 801-9200
Fax: (212) 801-6400