

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EBAY, INC.
Petitioner,

v.

LEXOS MEDIA IP, LLC
Patent Owner.

Case IPR2024-00337
Patent 6,118,449

**PATENT OWNER LEXOS MEDIA IP, LLC'S PRELIMINARY RESPONSE
TO EBAY'S PETITIONS AND MOTIONS FOR JOINDER
TO *INTER PARTES* REVIEW**

TABLE OF CONTENTS

I. INTRODUCTION	1
II. PROCEDURAL HISTORY	5
III. ARGUMENT: EBAY’S PETITIONS DO NOT SHOW THE REASONABLE LIKELIHOOD OF SUCCESS REQUIRED FOR INSTITUTION, LET ALONE THE COMPELLING EVIDENCE REQUIRED FOR JOINDER	7
A. MALAMUD (GROUND 1) DOES NOT PROVIDE COMPELLING EVIDENCE OF INVALIDITY OR EVEN A REASONABLE LIKELIHOOD THEREOF.	9
1. MALAMUD DOES NOT DISCLOSE SENDING THE INSTRUCTIONS AND CONTENT TO GENERATE ITS ICONS, AND THEREFORE CANNOT DISCLOSE THE “INFORMATION TO BE DISPLAYED” LIMITATIONS FOUND WITHIN THE CHALLENGED CLAIMS.....	9
2. IT WOULD NOT HAVE BEEN OBVIOUS TO MODIFY MALAMUD.....	14
3. MALAMUD DOES NOT TEACH THE “SPECIFIED CONTENT INFORMATION” LIMITATION OF THE CHALLENGED CLAIMS	16
B. MALAMUD & NAKAGAWA (GROUND 2) DOES NOT PROVIDE COMPELLING EVIDENCE OF INVALIDITY OR EVEN A REASONABLE LIKELIHOOD THEREOF.	19
C. NIELSEN & MALAMUD (GROUND 3) DOES NOT PROVIDE COMPELLING EVIDENCE OF INVALIDITY, OR EVEN A REASONABLE LIKELIHOOD OF PREVAILING.....	20
IV. ARGUMENT: THE BOARD SHOULD DISCRESSIONARILY DENY EBAY’S JOINDER MOTIONS.....	25
V. CONCLUSION	26

TABLE OF AUTHORITIES

Page(s)

Statutes

35 U.S.C. § 314(a)	1, 8
35 U.S.C. § 315(b)	3
35 U.S.C. § 325(d)	2

IPR Proceedings

IPR2020-00019, <i>Apple, Inc. v. Fintiv, Inc</i>	2
IPR2022-00861, <i>Code200 v. Bright Data Ltd</i>	3-4, 7-9

Pursuant to the Board’s Order, Paper 9, Patent Owner Lexos Media IP, LLC submits this preliminary response in opposition to the Motions for Joinder to *Inter Partes* Reviews, IPR2024-00336, Paper 3 and IPR2024-00337, Paper 3, filed by Petitioner eBay, Inc. to join its “copycat” petitions, *id* at Paper 2, with the *Amazon v. Lexos Media* proceedings in IPR2023-01000 and IPR2023-01001.¹

I. INTRODUCTION

The Board should not decide to institute eBay’s “copycat” petition and allow joinder thereof to the Amazon petition in the Amazon IPR2023-01000 (and IPR2023-01001) IPR proceedings.

As an initial note, eBay’s petitions do not demonstrate a reasonable likelihood that the petitioner will prevail at trial on any of the three asserted obviousness grounds in the petition. This is due in part to eBay’s failure to show *Malamud* teaches or renders obvious specific limitations of the challenged claims, as explained herein. These substantive failings of *Malamud* are being brought into better focus now than they were in the Patent Owner’s Preliminary Response in the Amazon IPR matters. In the *Amazon* IPRs, Patent Owner’s Preliminary Response focused the Board’s attention on discretionary denial of institution under 35 U.S.C. § 314(a)

¹ Each of the Petitions and Joinder Motions is substantially identical to the other in the two proceedings. For convenience, citations will be to the Petition and Joinder Motion relating to IPR2023-01000.

“because the factors identified in *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”), weigh in favor of denying institution.” PTAB *Amazon* Institution Decision (`102 Patent), Paper 9 (the “Amazon `102 Patent Institution Decision”) at 7. *See also* the Patent Owner Preliminary Response, Paper 8 (“POPR re: Amazon IPR”) at 3-23.² This focus was due to the imminent trial of the underlying patent litigation between Amazon and Patent Owner. *See* POPR re: Amazon IPR at 3-23. Patent Owner additionally argued that the Board “should exercise discretion to deny institution under 35 U.S.C. § 325(d) based on the 1749 IPR.”³ *See id.* at 25-26. The Patent Owner in the Amazon IPRs also challenged the arguments of Petitioner Amazon on their merits. *See id.* at 27-61.

In this proceeding, the stage and status of the litigation involving eBay and Patent Owner is markedly different from that of the litigation involving Amazon and Patent Owner. For this reason, Patent Owner will not, in this proceeding, rely on the *Fintiv* factors relied upon the Amazon IPRs. In addition, because the Board thoroughly

² All references to the filings in the Amazon IPRs will be to the Amazon IPR regarding the `102 Patent, unless indicated otherwise.

³ The “1749 IPR” is a reference to the inter partes review proceeding IPR2018-01749 (*Ralph Lauren v. Lexos*).

addressed the similarities and differences in the prior art at issue in the Amazon IPRs and the 1749 IPR, Patent Owner will not again discuss those similarities and differences. Instead, here, Patent Owner will focus more specifically on the merits, and lack thereof, of eBay's arguments for institution of its IPRs, with the understanding that the Board does not require a repletion of the arguments made in the POPR re Amazon IPR. Patent Owner additionally relies upon its opposition to eBay's Motion for Joinder for, without such joinder, eBay's IPR's would be barred as time-barred under 35 U.S.C. § 315(b). Lexos Media responds herein by showing the specific failings of Malamud, Nakagawa, and Nielson to teach or disclose the limitations of the challenged claims.

While eBay argues that joinder is appropriate here because the circumstances are similar to *Code200 v. Bright Data Ltd*, IPR2022-00861 proceedings ("the Code200 IPR"), the facts this case present substantially different circumstances than in the Code200 IPR. There, the Board denied institution and joinder and Director Vidal, in a rare occurrence, initiated a *sua sponte* review and vacated the Board's decision. See Code200 IPR, Paper 18 (August 23, 2022). Upon reconsideration, the Board decided to grant institution of the copycat petition because "the merits of this action present[ed] **a compelling unpatentability challenge.**" Code200, Paper 19 at 39 (emphasis supplied). Specifically, the Code200 Board expressly determined that "the Petition presents **compelling evidence that three prior art references**, including Border, which

was not before the jury in the Teso litigation, ***anticipate*** many of the claims of the '319 patent.” *Id.* at 14. (emphasis supplied.)

eBay argues that a similarly compelling unpatentability challenge exists here simply because the Board granted institution of review on the Amazon IPR2023-01000 and IPR2023-01001 IPR petitions. *See* eBay Reply to Patent Owner’s Opposition to Motion for Joinder, Paper 8. But eBay points to nowhere in the institution decision wherein the Board found any compelling evidence of invalidity. ***The Board made no such finding of compelling evidence of invalidity.*** To the contrary, throughout the institution decision the Board repeatedly cautioned that its finding were based upon “the present record” and “for the purposes of institution.” *See* IPR2023-01000 IPR, Institution Decision, Paper 9 at 23, 24, 25, 26, 27, 28, 29 34, 35 (and similarly IPR2023-01001 IPR, Institution Decision, Paper 9 at 24, 27, 28, 29, 31, 32, 38.)

Because the Board has found no compelling evidence, and because no compelling evidence of invalidity exists, eBay’s Petition should not be granted and its Motion for Joinder should be denied. Instead, the Board should honor the policy encouraging settlement of patent disputes, as well as the wishes of the parties to the IPR2023-01000 and IPR2023-01001 IPR proceedings who wish to terminate them.

II. PROCEDURAL HISTORY

On May 24, 2022, Patent Owner Lexos Media sued Amazon for infringement of two patents – the `102 Patent and the `449 Patent in *Lexos Media IP, LLC v. Amazon.com Inc.*, No. 2:22-cv-00169-JRG (E.D. Tex.) (the “Lexos-Amazon Litigation”).

On December 27, 2022, Lexos Media added the `241 Patent to the litigation – a patent not involved in these IPR proceedings.

On June 5, 2023, Amazon filed the Amazon IPRs challenging the patentability of the `102 and `449 Patents. IPR2023-01000 and -01001 (collectively, “Amazon IPRs”), Paper 1.

On September 14, 2023 Lexos Media filed its preliminary response to the Amazon IPRs on September 14, 2023. IPR2023-01000, Paper 8.

On June 22, 2022, Patent Owner initiated a lawsuit against eBay for infringement of U.S. Patent Nos. 5,995,102, and 6,118,449 captioned *Lexos Media IP, LLC v. eBay, Inc.*, No. 22-CV-00648-ADA (W.D. Tex.) (the “Lexos Litigation”).

On December 12, 2023, the Board granted institution of the Amazon IPRs. IPR2023-01000, Paper 9.

On December 14, 2023, Amazon and Lexos Media participated in court-ordered mediation in the Texas District Court litigation and, during that mediation, entered into a settlement agreement settling all claims asserted in the Lexos-Amazon Litigation and the Amazon IPRs. This settlement was initially memorialized on December 14 in a

Binding Term Sheet, IPR2023-01000, EX1014, and then in a more detailed Settlement Agreement on December 22. *Id.* at EX 1015. The Binding Term Sheet provided that Amazon would “file a motion to terminate the IPRs within five business days of the signing of the final agreement.” IPR2023-01000, EX1014 at 1. The final Settlement Agreement between Amazon and Lexos Media contained a similar provision regarding the termination of the Amazon IPRs (Section 9.14). IPR2023-01000, EX1015 at 11.

On December 16, 2023, Lexos Media and Amazon jointly filed a motion to dismiss the underlying Eastern District patent litigation between them with prejudice, informing the Court and the public that the parties had “resolved Lexos’s claims for relief asserted against Amazon in this matter.” EX2001.

On December 20, 2023, eBay filed two “copycat” IPRs, mirroring the Amazon IPRs. IPR2024-00336, Paper 2, IPR2024-00337, Paper 2. These petitions were accompanied by the Joinder Motions. *Id.*, Paper 3 (both). When eBay filed its petitions and Joinder Motions, it was aware of the imminent final settlement of the Texas District Court litigation and the Amazon IPRs. IPR2024-00336, Paper 3 at 4.

On January 11, 2024, the Board granted Amazon and Lexos Media leave to file a motion to terminate the Amazon IPRs.

On January 12, 2024, Amazon and Lexos Media filed Joint Motions to Terminate the Amazon IPRs. IPR2023-01000, Paper 11. In the Joint Motions to Terminate, Amazon refutes eBay’s assertion that Amazon does not oppose eBay’s Joinder Motions.

Id at 4-5. Each of the Joint Motions to Terminate expressly states that “[t]he parties jointly oppose eBay’s petition for joinder because Amazon and Patent Owner have resolved the [Amazon IPR] proceeding and do not desire it to continue, and joinder would allow eBay to continue the IPR contrary to the intent of the settlement” *Id*.

On February 7, 2024, the Board ordered Patent Owner file a preliminary response addressing the joinder issues or to file a waiver thereof by February 21, 2024. IPR2024-00336, Paper 9.

III. ARGUMENT: EBAY’S PETITIONS DO NOT SHOW THE REASONABLE LIKELIHOOD OF SUCCESS REQUIRED FOR INSTITUTION, LET ALONE THE COMPELLING EVIDENCE REQUIRED FOR JOINDER

eBay points to the circumstances and decisions in *Code200 v. Bright Data Ltd*, IPR2022-00861 (“Code200”) to argue joinder is similarly appropriate here. But the present circumstances are substantially different here than were presented in Code200. As eBay recognizes, Code200 was “[i]n stark departure from the norm.” eBay Mot. at 5. There, per the norm, applying the General Plastics factors the Board originally denied Code200’s motion for joinder (and institution) because “if we granted joinder here, ‘Petitioner would stand in to continue a proceeding that would otherwise be terminated.’” Code 200, Paper 12 at 8. Director Vidal, in a rare occurrence, initiated *sua sponte* review, vacated the decision denying institution and remanded for reconsideration of the General Plastics factors. Code 200, Paper 18 (August 23, 2022).

Upon reconsideration, the Board decided to grant institution of the copycat petition because “the merits of this action present[ed] **a compelling** unpatentability challenge.” Code200, Paper 19 at 39. Specifically, the Board expressly determined that “the Petition presents **compelling evidence** that three prior art references, including Border, which was not before the jury in the Teso litigation, anticipate many of the claims of the ’319 patent.” *Id.* at 14. (emphasis supplied.) No such compelling evidence of invalidity exists here. The Amazon Petition did not assert even a single anticipatory reference, each ground is based upon combining references to argue obviousness. *See* IPR 2023-01000, Institution Decision, Paper 9 at 6. Moreover, as the Board recognized in its Institution Decision, the principal prior art reference, Malamud, was the subject of IPR2018-01749, which had upheld the validity of the claims challenged here including by appeal to the Federal Circuit. *See id.* at 2-3, 10.

Throughout the institution decision, the Board repeatedly stated that its findings were preliminary, *i.e.*, that they were based only upon “the present record” and “for the purposes of institution.” *See, id.* at 23, 24, 25, 26, 27, 28, 29 34, 35 (and similarly IPR2023-01001, Paper 9 at 24, 27, 28, 29, 31, 32, 38.) eBay’s implicitly invites the Board to hold that any time a Board has decided to institute review, it has inherently found “compelling evidence” of unpatentability. The Board should decline such an invitation because it conflates the “compelling evidence” language of Code200 with the “reasonable likelihood” standard for institution under 35 U.S.C. 314(a). As

explained below, eBay’s petitions do not even meet the “reasonable likelihood” institution standard, much less the “compelling evidence” joinder standard.

A. MALAMUD (GROUND 1) DOES NOT PROVIDE COMPELLING EVIDENCE OF INVALIDITY OR EVEN A REASONABLE LIKELIHOOD THEREOF.

1. Malamud does not disclose sending the instructions and content to generate its icons, and therefore cannot disclose the “information to be displayed” limitations found within the challenged claims

eBay makes no anticipation arguments.⁴ All of its asserted grounds are based upon obviousness. eBay Petitions at 6. eBay asserts claim 72 as obvious over Malamud; else, Malamud and Nakagawa; else over Nielsen and Malamud.

The Challenged Claims, including Claim 72, contain several limitations regarding the term “specified content information.” These limitations include that the specified content information be provided from a server in response to a request for this information from the user’s terminal. This limitation is consistent with the Common Specification’s teaching that the inventions are directed to online advertising and, in particular, to changing the cursor images used on served webpages for advertising or promotional purposes so that they correspond to material displayed on the webpage content when the initial cursor is moved over that content. The claims also require that the “specified content information” include both the information to

⁴ That eBay can identify no anticipating references clearly distinguishes the circumstances here from those in Code200, in which the Board found that three references each presented clear evidence of anticipation.

be displayed as well as the cursor display instructions for modifying the initial cursor image into a specific image that corresponds to the information to be displayed when the user moves the initial cursor image over that particular content to be displayed.

While eBay asserts throughout its Petitions that Malamud discloses that its application program sends the claimed “information to be displayed” to the operating system (which eBay necessarily identifies as the Windows icons), eBay does not actually support this assertion. As eBay itself acknowledges, the Malamud specification only sends “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).” IPR2024-00336, Paper 1 (“eBay Petition”) at 23. At best, this data corresponds to the cursor display instructions for the specific image.

But the “cursor display instructions” claim requirement is a ***distinct element*** of claim 72 from the “information to be displayed” requirement. The former instructs on how to modify the display of the cursor image and may identify the specific image, whereas the latter is the information to be displayed and over which the cursor is moved to trigger the cursor modification. eBay glosses over this latter claim requirement, stating only that “Malamud further teaches that the application program provides the information to be displayed in the window for that application.” *Id.* at 38. eBay thus implicitly suggests that the Malamud application provides the icons.

eBay cites three passages in Malamud in support of its implicit proposition that Malamud sends the icons: 3:36-41, 3:63-4:3, 5:24-30 and Fig. 3.

But none of these passages states or even suggests that Malamud provides the instructions or content to generate these icons. The first passage only describes an example name cursor 26 that displays the phrase “Book Cover” in its name box 30 when its pointing portion 28 points to the book icon 32. Malamud at 3:36-41. The second passage only describes that the preview cursor 34 includes graphical content that is displayed in its preview portion 36 when the pointing portion 28 points to the book icon 32. *Id.* at 3:63-4:3. The third passage only describes that the operating system monitors the cursor position and sends the cursor position to the Malamud application, which in turn determines whether a named entity (i.e., an icon) is present at that cursor position. *Id.* at 5:24-30. None of these passages describe or suggest that Malamud sends the book icon 32. This lack of teaching is fatal to eBay’s Petition.

Nor is it surprising that Malamud also does not send the icons. Malamud sought to solve a perceived problem with using a status bar to display information about named files when pointing to their Windows icons. *See* Malamud, Background of the Invention, 1:15-31. So, the Malamud application took advantage of the new ability of Windows version 3.1 to support information cursors by providing the same status bar information in an information cursor instead. *Id.* at 4:33-38. Therefore, the Malamud specification not only never states that the application sends the icons, but it is replete

with description that the icons are pre-existing and the application only responds with cursor display instructions when a user points to an icon. Indeed, the Malamud specification recognizes in its Background of the Invention section that the icons are pre-existing objects: “[i]n certain operating systems, such as the Microsoft WINDOWS, version 3.1, operating system... a window may have a status bar that displays information about the object to which the cursor is currently pointing. As the cursor is moved to point at different objects, the contents of the status bar changes accordingly” and that the only problem that the Malamud Application addresses is that “the status part is...not connected with the cursor and does not move with the cursor.” *Id.* at 1: 18-31. The Malamud specification explains that icons exist, but that there is a problem with the status bar, so the Malamud application will take advantage of the ability for Windows 3.1 to support information cursors to display the relevant text or graphics within the information cursors’ content boxes instead of in the status bar.

The Malamud specification is therefore explicit that the icons are already displayed; the operating system sends a message to Malamud’s application (5:5:24-27) with the cursor location, and a Windows procedure within the Malamud application determines whether or not cursor is located over a named object for which the operating system needs to be sent the information cursor display instructions. (5:14-45) (“After the windows procedure has determined what is at the specified

cursor position, the procedure passes a message to the operating system 22 (FIG. 1) 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).” (5:47-53.) Malamud thus explicitly presumes the existence of the Windows icons and clearly teaches that the Malamud application only supplies the desired content and instructions for the display of information cursors for those icons. Indeed, the Windows 3.1 operating system provides user interfaces for the creation of such icons for files stored on the computer on which the operating system is installed.

While the parties agreed that the term “specified content information” generically means “information provided to a user’s terminal for use in the display, such as a web page,” that does not alter the fact that the claim requires the “specified content information” include both the cursor display instructions that will transform the initial cursor image into the specific image, and the corresponding information to be displayed that will trigger the cursor change when the initial cursor image is moved over it. Because Dr. Rosenberg does not explain why or how Malamud at the time of the download would include the claimed “specific image” (i.e., the content to be displayed within in the information cursor box) or ever include the “information to be displayed” (i.e., the icon), and because both Ground 1 and Ground 2 rely upon eBay’s unsupported and incorrect proposition that Malamud sends the icons, eBay does not establish any reasonable likelihood of proving either of these grounds.

The Board recognized that whether Malamud sends the information to be displayed is uncertain and contested. *See* IPR 2023-0100, Institution Decision, Paper 9 at 19 - 23 (discussing whether or not Malamud discloses this limitation and concluding only that “[o]n the present record and for the purposes of institution, however, Petitioner sufficiently shows that Malamud’s application program ***may be*** providing the information displayed on the terminal.”) *Id.* at 23. Patent Owner contends Malamud fails to meet the reasonable likelihood standard required for institution because, when fully considered, Malamud explicitly presumes the existence of the Windows icons and clearly teaches that the Malamud application only supplies the desired content and instructions for the display of information cursors for those icons. Indeed, the IPR2023-01000 and IPR2023-01001 institution decisions did not address the testimony of Dr. Shamos explaining how the Windows 3.1 operating system provides user interfaces for the creation of such icons for files stored on the computer on which it is installed. *See* Dr. Shamos’ Rebuttal Report to Dr. Houh’s Invalidity Report, EX2002 at ¶¶ 211-226, 236. Regardless, this is far short of the clear evidence of unpatentability found in Code200 to justify institution and joinder.⁵

2. It Would Not have been Obvious to Modify Malamud

⁵ Indeed, the argument that Malamud discloses the application sending the “information to be displayed” is so attenuated that the first set of experts and patent lawyers tasked with applying Malamud as an invalidating reference in the Ralph Lauren IPRs did not even attempt to make that argument in their Petition.

eBay’s argument that it would have been obvious to modify Malamud to include the required server connection also falls of the clear evidence of invalidity and indeed does not meet the reasonable likelihood standard when subjected to scrutiny. eBay’s entire argument in this regard is premised upon the fact that “it was well-known to a POSITA by June 1997 that a user could request and download an application program from a server.” eBay Petition at 34. But no evidence or support is listed in Malamud or in Dr. Rosenberg’s declaration that downloading a pre-installed generic Malamud application would result in sending to the user terminal the claimed “specified content information” including any specific images or icons.

eBay cites to a single paragraph (¶ 97) of the accompanying declaration of Dr. Rosenberg, which merely repeats the same conclusory statement made by eBay in its brief.

In ¶ 96 of his declaration, Dr. Rosenberg highlights the same flaw in eBay’s analysis regarding the specified content information because, here again, there is nothing to demonstrate that Malamud sends the icons to the operating system for display on the user’s screen. In particular, Dr. Rosenberg only states in ¶ 96:

“The application program comprises “specified content information” because it 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, 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”).) Thus, Malamud discloses an application program that includes information for use in the display on the user’s terminal.”

Notably, Dr. Rosenberg does not state that Malamud sends the icons. Rather, this statement clearly omits claim 72’s limitation that the “specified content information” that is transmitted to the user’s terminal from the server includes the “information to be displayed” that will trigger the cursor image modification to a corresponding specific image when the initial cursor image is moved over it. Dr. Rosenberg also cites to EX1008 (Joint Claim Construction Statement in the Amazon District Court Case) for the proposition that the parties agreed that the term “specified content information” generically means “information provided to a user’s terminal for use in the display, such as a web page” but that agreement does not supersede or alter the claim’s requirements for what the specified content information must include. Namely, the specified content information must include the triggering information to be displayed. Therefore, eBay fatally fails to support its proposition that Malamud includes the icons for display.

3. Malamud does not teach the “specified content information” limitation of the challenged claims

eBay also fails to show any reasonable likelihood for ultimately prevailing in proving claim 72 obvious over Malamud because it does not address how downloading a copy of the Malamud application from a server would result in the

specified content information being transmitted by such a download. In particular, Dr. Rosenberg does not explain why or how Malamud at the time of the download would include either the claimed “specific image” (i.e., the content to be displayed within in the information cursor box) or the “information to be displayed” (i.e., the icon). Instead, he merely offers a conclusory statement that ‘the request to download Malamud’s application program from a server is a request to provide specified content information to a user terminal.’ eBay Petition, 48; Rosenberg Decl., ¶ 97. This conclusory statement, in addition to the flaws described above, is contradicted by the declaration of Dr. Shamos in the Amazon IPR proceeding, who has clearly and unequivocally testified that a downloadable copy of the Malamud application would not have included either of these kinds of information because it would not know what files are stored on the computer to which it was downloaded. IPR2023-01000, EX2001 at ¶¶ 77, 80. It is also contradicted by Malamud itself, which contemplates that there are existing files (“named entities”) on the computer that have icons (“objects”) associated with them and that the purpose of the information cursors is to provide a different mechanism to provide the information for these files that was, in the past, displayed in a status bar. See Malamud at 1:18-31, 2:10-12, 3:65-67, 4:33-38, 5:15-45.

Nowhere does the Malamud specification state that the application itself includes the file for which the icon is to be displayed or even the icon to be displayed.

Moreover, the Malamud specification makes clear that the Malamud application does not provide everything displayed in a window. For example, Malamud is clear that Windows 3.1 provides the information cursor. *See, id.*, 3:6-8 (“Information cursors are made available by an operating System to applications that are run on the operating system.”) and 5:15 (“The appearance of the cursors on the video display 20 (FIG. 1) is dictated by bitmaps stored within the operating system 22.”) The only response from the application to the cursor position message received from the operating system that is described in Malamud is to provide the operating system with the type of information cursor to be displayed and its content:

FIG. 7 is a flowchart showing in more detail the steps that must be performed in order to realize step 56 of FIG. 6. After the window procedure has determined what is at the specified cursor position, the procedure passes a message to the operating system 22 (FIG. 1) 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). Suppose that the application program desires to display a name cursor 26 (FIG. 2a). A message requesting that a name cursor be displayed is passed to the operating system 22 along with a text string for the name to be displayed in the name box 30. However, if the cursor to be displayed is a preview cursor 34 (FIG. 3), a message specifying that a preview cursor is required is sent. The message includes a pointer to a bitmap of graphical information that the operating system 22 should use in the preview portion 36. Still further, a property cursor 46 may be requested in the message. The message, in such a case, includes a text String for the text of property information to be displayed in the property box 42.

Id. at 5:46-65.

The above contradicts eBay’s proposition that the Malamud application creates everything in a window. Moreover, consistent with how operating systems work,

Malamud expressly states: “[t]he operating system 22 (FIG. 1) logically divides the user interface into a number of windows. In general, each window has a separate window procedure associated with it.” *Id.* 4:53-55. Therefore, the application does not create a window. And even if it create a window, nowhere does it contemplate that the application contains the files that are to be displayed or the icons. Therefore, eBay does not (and cannot) support the proposition that a pre-installed copy would contain the files and their icons. Indeed, the statement eBay relies upon the notion that “a program may generate multiple windows” is true for any program (*e.g.*, Word, Adobe Acrobat, Excel, Publisher, etc.) and is not necessarily even a reference to the Malamud application. However, even if this were true, it would not be any evidence that a downloadable copy of Malamud comes pre-installed with files and their icons. That argument is fabricated from whole cloth.

For at least these reasons, eBay fails to show a reasonable likelihood of prevailing on invalidating the challenged claims, much less clear evidence of invalidity.

B. MALAMUD & NAKAGAWA (GROUND 2) DOES NOT PROVIDE COMPELLING EVIDENCE OF INVALIDITY OR EVEN A REASONABLE LIKELIHOOD THEREOF.

eBay utilizes the combination of Malamud and Nakagawa to bolster its argument that “a POSITA would have been motivated to download Malamud’s application program from a server in view of Nakagawa” for the same conclusory allegation that “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.” eBay Petition, 44; Rosenberg Decl, ¶¶ 121, 128.

However, this combination suffers from the same flaw as described above in connection with Ground 1 because it does not address the fact that no version, downloaded or not, of the Malamud application program transmits the Windows icons (“information be displayed” element) for the named entities stored on the user terminal and that a downloaded version of Malamud is not demonstrate to include the content to be displayed in the information cursor (“specific image”). For that reason, Ground 2 raises no reasonable likelihood of eBay prevailing on the merits after trial, much less clear evidence of invalidity to justify instituting trial for the purposes of joining eBay to the IPR2023-01000 and IPR2023-01001 proceedings that the parties have requested to be terminated.

C. NIELSEN & MALAMUD (GROUND 3) DOES NOT PROVIDE COMPELLING EVIDENCE OF INVALIDITY, OR EVEN A REASONABLE LIKELIHOOD OF PREVAILING.

eBay asserts that “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...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.” eBay Petition, 47-48. *See also, id.* at 31:

(“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. Therefore, a POSITA would have been motivated to combine the teachings of Nielsen and Malamud in this manner. 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. 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.”) (internal citations omitted.)

This statement has several flaws. First, it does not address that Nielsen’s specification describes that the tooltip was a proposed extension of the HTML protocol. In other words, the tooltip functionality in Nielsen was a proposed addition the HTML protocol for a webpage designer’s benefit, namely so that they could add a pair of tooltip tags to the webpage’s HTML file for any given character string to be displayed as part of the visible content of the webpage. Then a webpage designer would add the tooltip content as metadata between that pair of tags. The result being that when a webpage user moved their cursor over one of the words for which the tooltip tags and metadata had been made part of the HTML file, the tooltip would appear nearby.

But neither Dr. Rosenberg nor eBay address that the posited modification of Nielsen would require making changes to the HTML protocol. The HTML protocol is controlled by the Internet Engineering Task Force (IETF), the group responsible for any changes thereto. First, A POSITA would have to petition the IETF for such a change, which the IETF would have to review and approve. Then, even if that change was approved, every browser in the world would have to be updated in order to use the modified protocol as it would change the effect of having a tooltip tag in the HTML document. None of these obstacles to modification of Nielsen are considered by eBay in its characterization of such modifications as having a “high chance of success.”

Dr. Rosenberg asserts that a motivation to make such a change exists because:

“[i]f 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.*)”

See also, eBay Petition, 31. But this argument for motivation fails to take into account that Nielsen teaches displaying a tooltip in proximity to the object that the cursor is hovering over because that is the functional behavior of tooltip tags that has been baked into the HTML protocol. If the tooltip tags and their corresponding

behavior were eliminated from the HTML protocol, there would be no teaching of any tooltips whatsoever in Nielsen.

Said another way, Nielsen operates because the HTML protocol supports its functionality. Therefore, in Nielsen any character string can easily have its own corresponding tooltip; all the webpage designer must do is place the tooltip tags into the HTML next to the character string and place in between the tags whatever tooltip information that the use wishes to be displayed. Replacing tooltips with the claimed cursor modification of the Challenged Claims' modified cursor images requires having the IETF group approve new tags that operate differently in the HTML protocol and then updating all browsers to support those new tags. It also requires a complete redesign of Nielsen wherein instead of a static tooltip that is displayed in a single fixed location, there is a movable information cursor in which the dynamically updated content must be displayed in different locations; and instead of a static tooltip that displays only after the user stops moving their cursor, the information cursor technology immediately displays the tooltip in response to movement over the character string.

But there would be no reasonable expectation of success in making these changes and no motivation to do so because Nielsen deliberately requires that the tooltip is ***not displayed in response to moving the cursor*** over the character string but only after a preset pause of the cursor over that character string. This is to indicate that the user

wishes to see the tooltip information. Otherwise, the tooltip would be displayed when the user is simply moving their cursor from one part of the display to another, whether the user wishes to see the tooltip content or not. But none of these problems are addressed by eBay in regards high likelihood of success or motivation to combine.

Indeed, there would be no motivation to make these changes because Nielsen does not want tooltips to be indiscriminately and automatically displayed in response to cursor movement over the text string, in direct opposition to what is required by the Challenged Claims. Therefore, a POSITA would not have been motivated to change the tooltip content to be automatically displayed in an information cursor simply by moving the cursor over the character string, as eBay suggests.

The fact of the matter is, as Dr. Shamos points out, and putting aside that there is no high degree of likely success in changing the HTML protocol to effectuate the change, there would be no motivation to do so ***because Nielsen does not want tooltips to be indiscriminately and automatically displayed in response to cursor movement*** over the text string. Instead, Nielsen wants the tooltip to only be displayed after there is a cessation of movement over that text string so that there is an indication that the user actually wants to see the tooltip. EX2002 at ¶255, 267. Therefore, eBay does not show a reasonable likelihood of prevailing at trial that a POSITA would have been motivated to change the tooltip content to be automatically displayed in an

information cursor simply by moving the cursor over the character string, as eBay suggests.

IV. ARGUMENT: THE BOARD SHOULD DISCRESSIONARILY DENY EBAY'S JOINDER MOTIONS

Patent Owner refers the Board to Paper 8 in the instant IPR. Because eBay cannot show any compelling evidence of invalidity to justify granting institution of its Petition, it should not be allowed to join an IPR proceeding against the wishes of both Petitioner Amazon and Patent Owner who seek to terminate that proceeding. Had eBay believed Amazon's Petition presented a compelling unpatentability challenge, it could have filed its own petition anytime during its one-year statutory period. eBay should not be permitted to join when it only sought joinder after the parties had settled. The parties in the Amazon IPRs decided to dismiss the Amazon IPR proceedings and had actually already moved to dismiss the underlying litigation.

Based on the totality of the circumstances, therefore, the Board should grant the Joint Motions to Terminate the Amazon IPRs and, consistent with the strong policy reasons to favor settlement, deny Petitioner eBay's Joinder Motions, as there would not be a proceeding to which the eBay Petitions may be joined. Even if the Board did not grant the Joint Motions to Terminate prior to a hearing on eBay's Joinder Motions, the imminent termination of the Amazon IPRs dictates that the Joinder Motions be denied as undermining the strong policy regarding and respecting settlement.

V. CONCLUSION

For these reasons, Patent Owner Lexos Media IP, LLC, respectfully requests that the Board deny eBay's Petitions for *Inter Partes* review and Motions for Joinder.

Respectfully submitted,

February 21, 2024

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CERTIFICATE OF COMPLIANCE

Patent Owner certifies that Patent Owner's Preliminary Response Contains 6,299 words exclusive of a table of contents, a table of authorities, mandatory notices under § 42.8, a certificate of service or word count, or appendix of exhibits or claim listing, according to Microsoft Word.

Dated: September 14, 2023

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing document has been served in its entirety by filing the **OPPOSITION TO MOTION FOR JOINDER TO *INTER PARTES* REVIEW** has been served on the following counsel of record for Petitioner eBay, Inc.:

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