

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner.

IPR2023-00628
Patent 7,233,790 B2

Before JEFFREY S. SMITH, STACEY G. WHITE, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background and Summary

Petitioner, Netflix, Inc., filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–14 of U.S. Patent No. 7,233,790 B2 (Ex. 1001, “the ’790 patent”) pursuant to 35 U.S.C. § 311(a). Patent Owner, VideoLabs, Inc., filed a Preliminary Response (Paper 6, “Prelim. Resp.”) pursuant to 35 U.S.C. § 313. On August 11, 2023, a reexamination certificate was issued which amended claims 1 and 8. Ex. 2018. With our authorization (Paper 12), Petitioner filed a Reply (Paper 15) and Patent Owner filed a Sur-Reply (Paper 16) directed to whether the Board should institute in light of the amendments to claims 1 and 8.

Pursuant to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we institute an *inter partes* review as to claims 1–14 of the ’790 patent on the grounds of unpatentability asserted in the Petition.

B. Real-Parties-In-Interest

Petitioner identifies itself (Netflix, Inc.) and Netflix Streaming Services, Inc. as its real parties-in-interest. Pet. 71. Patent Owner identifies itself (VideoLabs, Inc.) as well as VL IP Holdings LLC and VL Collective IP LLC as real parties-in-interest. Paper 4, 2.

C. Related Matters

The Petition states that the '790 patent is the subject of the following proceedings:

VideoLabs, Inc. v. Netflix Inc., No. 1-22-cv-00229, D. Del., filed Feb. 23, 2022;

Starz Entertainment, LLC v. VL Collective IP, LLC, No. 1-21-cv-01448, D. Del., filed Oct. 13, 2021;

Unwired Planet, LLC v. Apple, Inc., No. 3-13-cv-04134, N.D. Cal., filed Sept. 19, 2012;

Unwired Planet, LLC v. Apple, Inc., No. 3-12-cv-00505, D. Nev., filed Sept. 19, 2012.

Pet. 71. Patent Owner identifies the following additional proceeding as one in which the '790 patent was involved (Prelim. Resp. 1):

Ex Parte Reexamination, Control No. 90/015,063, filed June 23, 2022.¹

II. THE '790 PATENT

The '790 patent relates to “facilitating management and delivery of digital content from multiple content suppliers to multiple wireless services subscribers in multiple domains.” Ex. 1001, 1:14–18. The '790 patent explains that a download manager acts as an intermediary between content suppliers and wireless services subscribers. *Id.* at 4:11–15, Fig. 2.

¹ Although the Petition was filed February 23, 2023 (Paper 1), and Patent Owner filed its initial Mandatory Notices on April 11, 2023 (Paper 4), Patent Owner did not inform the Board of the then-pending reexamination of the '790 patent until the filing of its Preliminary Response on July 5, 2023, at which point the Office already had issued a Notice of Intent to Issue *Ex-Parte* Reexamination Certificate (Paper 6, 1; Ex. 2011).

Figure 3 of the '790 patent is shown below.

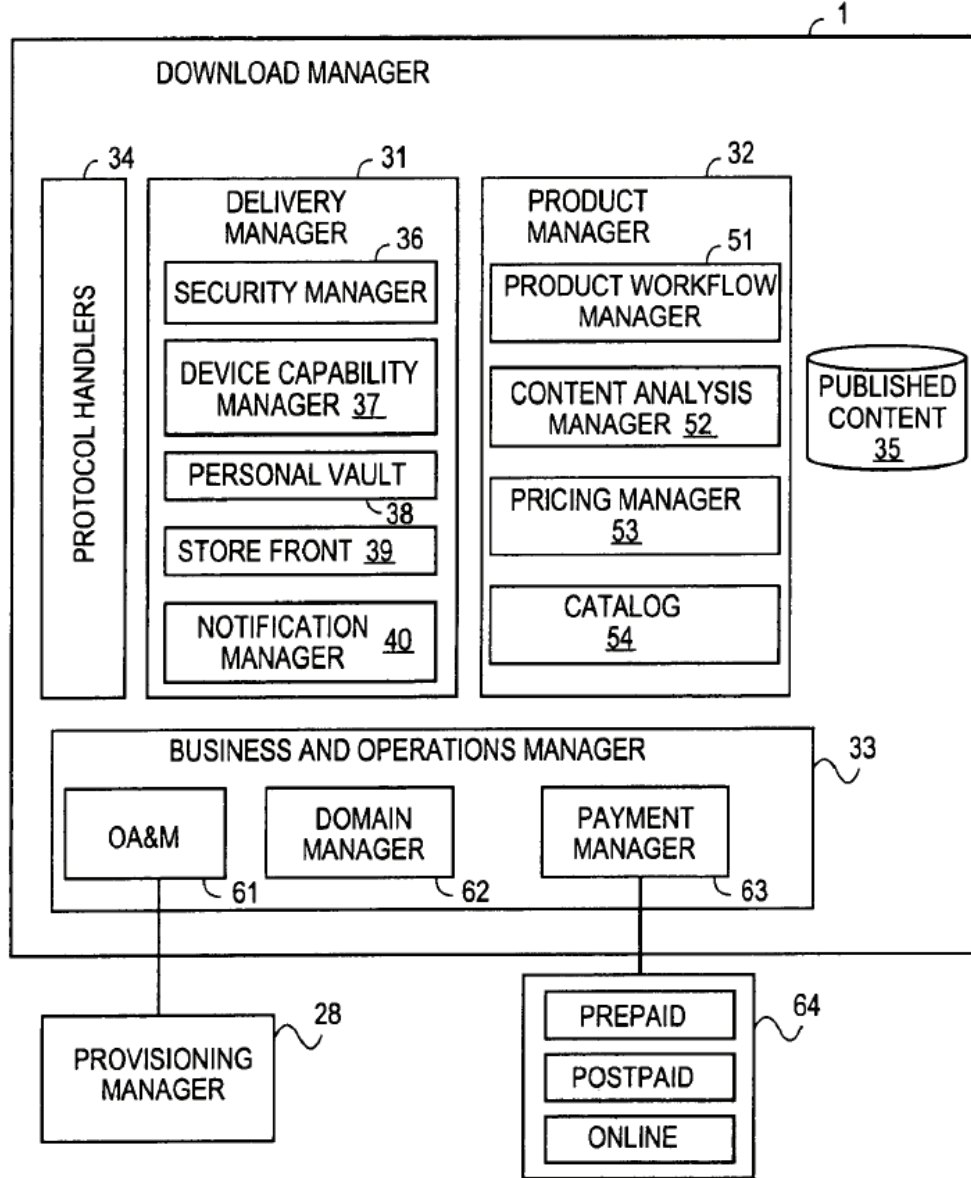


Figure 3 above schematically illustrates the components of the download manager along with a provisioning manager. Ex. 1001, 3:15–16. In the embodiment of Figure 3, download manager 1 includes delivery manager 31, product manager 32, business & operations manager 33, and multiple protocol handlers 34. *Id.* at 6:36–38. “[P]roduct manager 32 is the download manager's interface to the various content suppliers and provides centralized product cataloging (including enabling qualified content

suppliers to register content for analysis and publication) and complete product life cycle support.” *Id.* at 6:46–50. Product manager 32 includes product catalog 54 that contains descriptions of all published items of content (products), and specifically includes, for each product entry, a reference to at least one implementation of that product, wherein an implementation can be a binary file representing the product. *Id.* at 9:37–42, Fig. 3. Delivery manager 31 includes device capability manager 37 that is responsible for device recognition, capability determination, and management. *Id.* at 7:31–39, Fig. 3. The ’790 patent explains that “[w]hen a request to view available products is received from the client device,” the product manager determines from the product catalog which products are supported by the client based on the capabilities of that client device. *Id.* at 12:9–13. The download manager then sends a response to the client “to cause the client device to display product information relating to only those products supported by the client device.” *Id.* at 12:13–17.

III. ILLUSTRATIVE CLAIM

Independent claim 1 of the '790 patent as amended² recites:

1. A method of providing access to digital content for use on wireless communication devices, the method comprising:

receiving and storing in a server system a plurality of items of digital content to be made available for use in wireless communication devices used by a plurality of wireless services subscribers, including receiving and storing a plurality of different implementations of at least one of the items of digital content, where each implementation of any given item of digital content corresponds to a different set of device capabilities;

operating the server system to maintain a product catalog containing a description of the items of digital content, wherein the product catalog includes, in association with each item of digital content, a reference to each implementation of said item of digital content;

receiving a request from one of the wireless communication devices;

in response to the request, selecting a portion of the product catalog to be presented on the one wireless communication device, based in part on device capabilities of the one wireless communication device; and

presenting the selected portion of the product catalog to the one wireless communication device, such that the selected portion, as presented, provides a single description of each item of digital content in said portion, regardless of a number of implementations that are available for each said item.

Ex. 2018, 1:20–2:8.

Independent claim 2 recites:

2. A method of providing access to digital content for use on wireless communication devices, the method comprising:

² On August 11, 2023, a reexamination certificate was issued which amended claims 1 and 8. Ex. 2018.

receiving and storing in a server system a plurality of items of digital content to be made available for use in wireless communication devices used by a plurality of wireless services subscribers,

including receiving and storing a plurality of different implementations of at least one of the items of digital content, where each implementation of any given item of digital content corresponds to a different set of device capabilities;

operating the server system to maintain a product catalog containing a description of the items of digital content, wherein the product catalog includes, in association with each item of digital content, a reference to each implementation of said item of digital content;

receiving a request from a wireless device used by one of the subscribers;

in response to the request, selecting a portion of the product catalog to be presented to the subscriber, based on device capabilities of the wireless device used by the subscriber; and

presenting the selected portion of the product catalog to the subscriber via a wireless network, such that the selected portion, as presented to the subscriber, provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item.

Ex. 1001, 15:34–61.

IV. ASSERTED GROUNDS

Petitioner asserts that claims 1–14 of the ’790 patent are unpatentable on the following grounds (Pet. 22).

Claim(s) Challenged	35 U.S.C. § ³	Reference(s)/Basis
1–4, 8–11	102(a), (e)	Mehta ⁴
1–14	103(a)	Mehta, Schläpfer ⁵

V. LEVEL OF ORDINARY SKILL

Petitioner identifies a person of ordinary skill as someone with “a bachelor’s degree in electrical or computer engineering, or a closely related scientific field such as computer science, and two years of work experience with digital multi-media content distribution and management, and associated system infrastructures.” Pet. 16. “Alternatively, any lack of experience could be remedied with additional education (*e.g.*, a master’s degree), and likewise, a lack of education can be remedied with additional work experience (*e.g.*, 4–5 years).” *Id.* Patent Owner does not address the level of ordinary skill. *See generally*, Prelim. Resp.

The level of ordinary skill in the art usually is evidenced by the references themselves. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978). As Petitioner’s description of a person of ordinary skill appears commensurate with the subject matter before us, we apply Petitioner’s definition for purposes of this Decision.

³ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 102, 103. Because the ’790 patent has an effective filing date prior to the effective date of the applicable AIA amendment, we refer to the pre-AIA version of §§ 102, 103.

⁴ U.S. Publication No. 2022/0131404 A1; pub. Sept. 19, 2002 (Ex. 1003).

⁵ Schläpfer et al., Mobile Applications with J2ME, July 7, 2001 (Ex. 1009).

VI. CLAIM CONSTRUCTION

We interpret claim terms using “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2019). In this context, claim terms “are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (citations omitted) (en banc). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). Extrinsic evidence is “less significant than the intrinsic record in determining ‘the legally operative meaning of claim language.’” *Phillips*, 415 F.3d at 1317 (citations omitted).

We construe only those claim terms that require analysis to determine whether to institute *inter partes* review. See *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (holding that “only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy”). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). Petitioner contends that “no claim terms require specific construction to resolve the unpatentability issues presented” in the Petition. Pet. 23. We agree and do not construe any terms at this stage.

VII. ANALYSIS

A. Legal Standards

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *see also* 37 C.F.R. § 42.104(b) (requiring a petition for *inter partes* review to identify how the challenged claim is to be construed and where each element of the claim is found in the prior art patents or printed publications relied upon).

To establish anticipation, each and every element in a claim, arranged as recited in the claim, must be found in a single prior art reference. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). Although the elements must be arranged or combined in the same way as in the claim, “the reference need not satisfy an *ipsissimis verbis* test,” i.e., identity of terminology is not required. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009) (citing *In re Bond*, 910 F.2d 831, 832–33 (Fed. Cir. 1990)).

A claim is unpatentable under 35 U.S.C. § 103(a) if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective evidence

of obviousness or nonobviousness, i.e., secondary considerations.⁶ *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). An obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418.

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2016) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). Furthermore, Petitioner does not satisfy its burden of proving obviousness by employing “mere conclusory statements,” but “must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

B. Claims 1–4 and 8–11 As Anticipated By Mehta

1. Mehta – Exhibit 1003

Mehta relates to “maintaining and distributing wireless applications to wireless devices over a wireless network.” Ex. 1003 ¶ 2. Mehta discloses a Mobile Application System (“MAS”) that “is a collection of interoperating server components that work individually and together in a secure fashion to provide applications, resources, and other content to mobile subscriber devices.” *Id.* ¶ 59.

⁶ The parties do not direct us to any objective evidence of non-obviousness at this stage of the proceeding.

Figure 1 of Mehta is shown below.

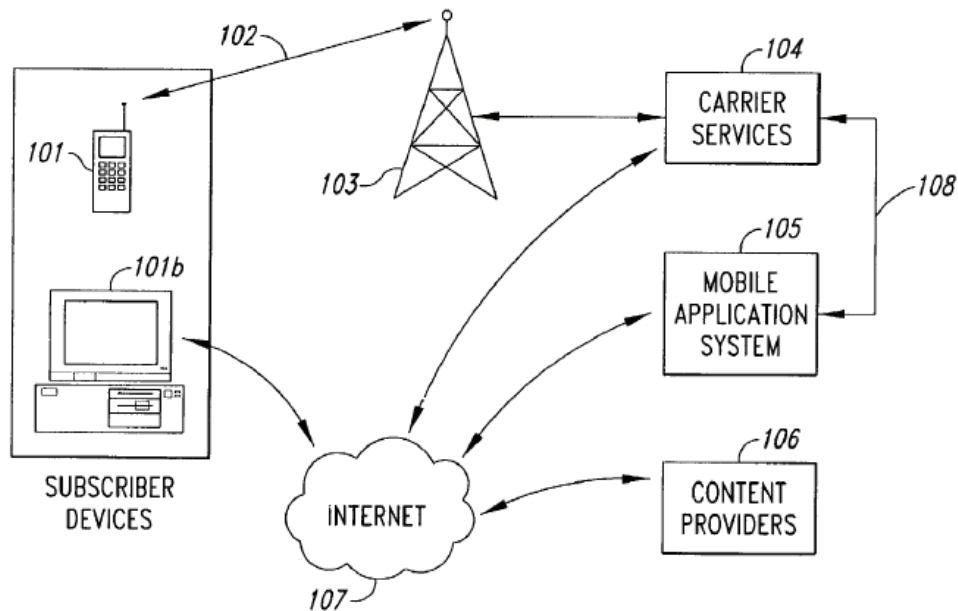


Fig. 1

Figure 1 above is a block diagram that illustrates how subscribers request and download software from an MAS. *Id.* ¶ 18. The MAS includes a provisioning manager which includes verifiers “used to determine compatibility of an application.” *Id.* ¶ 82, Fig. 5. When the MAS receives a request, the “Device Verifier” of the provisioning manager “determines the type and capabilities of the subscriber device” and “whether the device capabilities are sufficient to support a specific application.” *Id.* ¶¶ 82–85. Mehta’s MAS may analyze “a subscriber profile, a device profile, and an application profile to determine whether the subscriber is authorized to use the application and whether the application’s needs . . . are met by the device.” *Id.* ¶ 67. The MAS then “compiles and returns a list of applications that are available and appropriate based on the subscriber, application profiles, and device profiles.” *Id.* ¶ 70.

2. *Independent Claim 2*

The preamble of claim 2 recites a “method of providing access to digital content for use on wireless communication devices, the method comprising.” Petitioner contends that Mehta discloses the preamble in describing a Mobile Application System (“MAS”) and methods for providing applications, resources, and other content to mobile subscriber devices. Pet. 26–27, 31 (citing Ex. 1003 ¶¶ 2, 5, 5960, 62, 103, 127). Patent Owner does not contend otherwise at this stage of the proceeding.⁷ Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has sufficiently demonstrated that Mehta discloses the features recited in the preamble of claim 2.⁸

Claim 2 recites “receiving and storing in a server system a plurality of items of digital content to be made available for use in wireless communication devices used by a plurality of wireless services subscribers.” Petitioner contends that Mehta discloses this limitation in describing an MAS that receives applications from content providers and carrier services to provision them for deliver to the subscriber device. Pet. 27–28, 31 (citing Ex. 1003 ¶¶ 59, 62, 64, 68). Based on the evidence and arguments currently

⁷ Patent Owner does not challenge any of the proposed grounds at this stage of the proceeding, with the exception of contending that the Petition does not address amended claims 1 and 8 as discussed below.

⁸ Because Petitioner has shown that the features in the preamble are satisfied by the prior art, we need not determine whether the preamble is limiting at this time. *See Vivid Techs.*, 200 F.3d at 803.

of record, for purposes of institution, Petitioner has sufficiently demonstrated that Mehta discloses this limitation of claim 2.

Claim 2 recites “including receiving and storing a plurality of different implementations of at least one of the items of digital content, where each implementation of any given item of digital content corresponds to a different set of device capabilities.” Petitioner contends that Mehta discloses this limitation in describing an MAS that stores and supports functionally equivalent programs that are capable of running multiple kinds of devices. Pet. 28–29, 31 (citing Ex. 1003 ¶¶ 64, 68, 98). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has sufficiently demonstrated that Mehta discloses this limitation of claim 2.

Claim 2 recites “operating the server system to maintain a product catalog containing a description of the items of digital content, wherein the product catalog includes, in association with each item of digital content, a reference to each implementation of said item of digital content.” Petitioner contends that Mehta discloses this limitation in describing an MAS that includes a data repository that stores applications along with descriptions of the applications. Pet. 29–32 (citing Ex. 1003 ¶¶ 64, 67, 97–99). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has sufficiently demonstrated that Mehta discloses this limitation of claim 2.

Claim 2 recites “receiving a request from a wireless device used by one of the subscribers.” Petitioner contends that Mehta discloses this limitation in describing an MAS receives a wireless services request from a wireless subscriber. Pet. 32–33 (citing Ex. 1003 ¶¶ 6061, 64, Fig. 1). Based on the evidence and arguments currently of record, for purposes of

institution, Petitioner has sufficiently demonstrated that Mehta discloses this limitation of claim 2.

Claim 2 recites “in response to the request, selecting a portion of the product catalog to be presented to the subscriber, based on device capabilities of the wireless device used by the subscriber.” Petitioner contends that Mehta discloses this limitation in describing an MAS that analyzes various profiles to determine whether an application version meets the devices requirements of a subscriber. Pet. 33–35 (citing Ex. 1003 ¶¶ 67, 139, Fig. 4). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has sufficiently demonstrated that Mehta discloses this limitation of claim 2.

Claim 2 recites “presenting the selected portion of the product catalog to the subscriber via a wireless network, such that the selected portion, as presented to the subscriber, provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item.” Petitioner contends that Mehta discloses this limitation in describing an MAS that filters the list of content to only identify those applications that are supported by the subscriber’s device.” Pet. 35–37 (citing Ex. 1003 ¶¶ 67, 9, 16, 117). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has sufficiently demonstrated that Mehta discloses this limitation of claim 2.

Based on the evidence and arguments currently of record, for purposes of institution, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in showing that Mehta anticipates claim 2.

3. *Dependent Claims 3 and 4*

Claim 3 depends from claim 2 and recites “wherein said selecting a portion of the product catalog comprises: in response to the request, determining the identity of the wireless device used by the subscriber.” Petitioner contends that Mehta discloses this limitation in describing that the subscriber verifier determines the type and capabilities of the subscriber device. Pet. 37–38 (citing Ex. 1003 ¶¶ 83–84).

Claim 3 recites “wherein each implementation of the plurality of items of digital content has been previously associated in the server system with at least one device identity, according to corresponding device capabilities supported by the implementation.” Petitioner contends that Mehta discloses this limitation in describing that the deployment manager provisions each application for specific device or subscriber profiles. Pet. 38 (citing Ex. 1003 ¶ 79).

Claim 3 recites “selecting the portion of the product catalog to be presented to the subscriber based on the identity of the wireless device used by the subscriber.” Petitioner contends that Mehta discloses this limitation in describing that the initial list is based upon subscriber and device capabilities, and the final list to be presented to the subscriber is based on the type and capabilities of the subscriber’s device. Pet. 38–39 (citing Ex. 1003 ¶¶ 67, 85, 139).

Claim 4 depends from claim 2 and recites “receiving from the subscriber a request for one of the items of digital content in said portion of the product catalog.” Petitioner contends that Mehta discloses this limitation in describing a data repository that stores applications, where subscribers of wireless services request and download the applications. Pet. 39–40 (citing Ex. 1003 ¶¶ 61, 64, 81–82, Fig. 1).

Claim 4 recites “selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber.” Petitioner contends that Mehta discloses this limitation in describing receiving a request to download an application, verifying that the request is appropriate and permitted for download to the device and user, and sending the application to the requesting device. Pet. 41 (citing Ex. 1002 ¶ 83).

Claim 4 recites “downloading the selected implementation of the item of digital content to the wireless device used by the subscriber.” Petitioner contends that Mehta discloses this limitation in describing downloading the selected application to the subscriber device. Pet. 42–43 (citing Ex. 1002 ¶ 84, Fig. 3).

Based on the evidence and arguments currently of record, for purposes of institution, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in showing that Mehta anticipates claims 3 and 4.

4. Independent Claim 9

Petitioner contends that claim 9 recites limitations similar to those recited in claim 2, and that Mehta anticipates claim 9 for the reasons given in the Petition’s analysis of claim 2. Pet. 46–47. Based on the evidence and arguments currently of record, for purposes of institution, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in showing that Mehta anticipates claim 9.

5. Dependent Claims 10 and 11

Petitioner contends that claim 10 contains limitations similar to those recited in claim 3, that claim 11 recites limitations similar to those recited in claim 4, and that Mehta anticipates claims 10 and 11 for the reasons given in

the Petition’s analysis of claims 3 and 4. Pet. 48. Based on the evidence and arguments currently of record, for purposes of institution, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in showing that Mehta anticipates claim 9.

6. *Claims 1 and 8*

Patent Owner contends that the Petition addresses only the original pre-amendment versions of claims 1 and 8, which no longer exist. Prelim. Resp. 1. Patent Owner contends that the Petition does not present any arguments with respect to amended claims 1 and 8, and therefore, cannot satisfy the “reasonable likelihood” institution standard for amended claims 1 and 8. *Id.* at 9–11.

We agree that original claims 1 and 8 no longer exist because original claims 1 and 8 have been replaced by amended claims 1 and 8. However, the issue of whether the Petition and supporting evidence satisfies the “reasonable likelihood” standard for amended claims 1 and 8 does not determine whether we can institute, because, as discussed above in our analysis of claim 2, Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one claim of the ’790 patent challenged in the Petition. Therefore, we institute on all grounds and all claims challenged in the Petition which, in this case, are claims 1–14, where claims 1 and 8 are the currently existing claims as amended by the reexamination certificate. *See PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018).

We describe below why we do not believe that our decision runs afoul of the Supreme Court’s cautionary words that “nothing suggests the Director enjoys a license to depart from the petition and institute a different inter partes review of h[er] own design.” *Id.* (quoting *SAS Institute, Inc. v. Iancu*, 134 S.Ct. 1348, 1356 (2018)).

Petitioner contends that the Petition as originally filed puts Patent Owner on notice of how the prior art asserted in the grounds anticipates or teaches the limitations added to amended claims 1 and 8. Paper 15, 1–2. Petitioner contends that, when analyzing amended claims 1 and 8, the Board can consider arguments already presented in the Petition with respect to limitations from other claims, which were added by amendment to claims 1 and 8. *Id.* at 2–4 (citing *Eizo Corp. v. Barco N.V.*, IPR2014-00358 (PTAB July 23, 2014) (Paper 11)). Petitioner contends that considering arguments already presented in the Petition when analyzing amended claims 1 and 8 does not amount to an amendment to the Petition, because neither Petitioner nor the Board is proposing a new ground, rather, the grounds remain the same. *Id.* at 45. Petitioner contends that it can file a motion to submit supplemental information to confirm that the analysis of the original claims found in the Petition as originally filed fully address claims 1 and 8 as amended. *Id.* at 5–6. Petitioner contends that such supplemental information would clarify the record that the Petition as originally filed, not a conclusion reached by the Board, shows that the challenged claims are unpatentable. *Id.*

Patent Owner contends that the Petition does not address the amended claims. Paper 16, 1, 3. Patent Owner contends that in *Eizo*, the Board properly considered claim 64 as amended by a reexamination certificate, because it was a combination of two original claims, 64 and 94, that were addressed in the Petition. *Id.* at 4. Patent Owner contends that Petitioner cannot amend the Petition and cannot submit supplemental information to allow an entirely new analysis of the claims. *Id.* at 6–7.

Both parties seem to agree that the Board can analyze a challenged claim that was amended to include limitations from another challenged

claim. Paper 15, 2–4; Paper 16, 4. Both parties seem to agree that the Petition cannot be amended, and that a new ground cannot be added to the Petition. Paper 15, 45; Paper 16, 6–7. Both parties seem to disagree on the factual question of whether the grounds and supporting evidence in the Petition sufficiently address the limitations of amended claims 1 and 8. Paper 15, 2; Paper 16, 1.

The contentions of the parties appear consistent with the Supreme Court’s statements about *inter partes* review. The Supreme Court has held that “the petition must identify each claim challenged, the grounds for the challenge, and the evidence supporting the challenge.” *SAS Institute, Inc. v. Iancu*, 138 S.Ct. 1348, 1353 (2018). Here, the Petition identifies claims 1–14 as the challenged claims, grounds 1 and 2 as the grounds for the challenge, and Mehta, Schläpfer, and the testimony of Mr. Wechselberger, along with other exhibits, as the evidence supporting the challenge. Pet. 26–70. Thus, the Petition, on this record, appears to satisfy *SAS*. The issue at this stage appears to be whether the grounds and supporting evidence in the Petition show that amended claims 1 and 8 are unpatentable. *See Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1384 (Fed. Cir. 2023) (The Federal Circuit held that “where a patent owner in an IPR first proposes a claim construction in a patent owner response, a petitioner must be given the opportunity in its reply to argue and present evidence of anticipation or obviousness under the new construction, at least where it relies on the same embodiments for each invalidity ground as were relied on in the petition.”).

We encourage the parties, during the course of the trial, to explain whether the grounds and supporting evidence show that claims 1 and 8 as amended are unpatentable. In particular, we encourage the parties to address (1) whether the Petition puts Patent Owner on notice of how the prior art

asserted in the grounds anticipates or teaches the limitations of amended claims 1 and 8, (2) whether considering arguments already presented in the Petition when analyzing amended claims 1 and 8 amounts to adding a new ground, (3) whether considering arguments already presented in the Petition when analyzing amended claims 1 and 8 amounts to amending the Petition, and (4) whether filing supplemental information to clarify that the Petition as originally filed shows that amended claims 1 and 8 are unpatentable amounts to a new analysis of the claims. We provide the following comparison of amended claims 1 and 8 with original claims 1 and 8 and claims 2 and 9 to guide the parties.

Amended claim 1 recites a “method of providing access to digital content for use on wireless communication devices, the method comprising.” Claim 2 recites a “method of providing access to digital content for use on wireless communication devices, the method comprising.” On this record, the preamble of amended claim 1 appears to be identical to the preamble of claim 2 as addressed in the Petition.

Amended claim 1 recites “receiving and storing in a server system a plurality of items of digital content to be made available for use in wireless communication devices used by a plurality of wireless services subscribers, including receiving and storing a plurality of different implementations of at least one of the items of digital content, where each implementation of any given item of digital content corresponds to a different set of device capabilities.” Claim 2 recites

receiving and storing in a server system a plurality of items of digital content to be made available for use in wireless communication devices used by a plurality of wireless services subscribers, including receiving and storing a plurality of different implementations of at least one of the items of digital

content, where each implementation of any given item of digital content corresponds to a different set of device capabilities.

On this record, this limitation of amended claim 1 appears to be identical to a limitation recited in claim 2 as addressed in the Petition.

Amended claim 1 recites “operating the server system to maintain [maintaining] a product catalog containing a description of the items of digital content, wherein the product catalog [including] includes, in association with each item of digital content, a reference to each implementation of said item of digital content.” Claim 2 recites “operating the server system to maintain a product catalog containing a description of the items of digital content, wherein the product catalog includes, in association with each item of digital content, a reference to each implementation of said item of digital content.” On this record, this limitation of amended claim 1 appears to be identical to a limitation recited in claim 2 as addressed in the Petition.

Amended claim 1 recites “receiving a request from one of the wireless communication devices.” Claim 2 recites “receiving a request from a wireless device used by one of the subscribers.” To the extent that the limitations appear to be different, we leave it to the parties to explain whether the scope of the limitations is the same, and if not, whether the analysis of the claims in the Petition shows that Mehta describes this limitation of amended claim 1.

Amended claim 1 recites “in response to the request, selecting a portion of the product catalog to be presented on the one wireless communication device, based in part on device capabilities of the one wireless communication device.” Claim 2 recites “in response to the request, selecting a portion of the product catalog to be presented to the

subscriber, based on device capabilities of the wireless device used by the subscriber.” To the extent that the limitations appear to be different, we leave it to the parties to explain whether the scope of the limitations is the same, and if not, whether the analysis of the claims in the Petition shows that Mehta describes this limitation of amended claim 1.

Amended claim 1 recites “presenting the selected portion of the product catalog to the one wireless communication device, such that the selected portion, as presented, provides a single description of each item of digital content in said portion, regardless of a number of implementations that are available for each said item.” Claim 2 recites “presenting the selected portion of the product catalog to the subscriber via a wireless network, such that the selected portion, as presented to the subscriber, provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item.” To the extent that the limitations appear to be different, we leave it to the parties to explain whether the scope of the limitations is the same, and if not, whether the analysis of the claims in the Petition shows that Mehta describes this limitation of amended claim 1.

The preamble of amended claim 8 recites a “system that provides access to digital content for use on wireless communication devices, said system comprising.” The preamble of claim 9 recites a “system comprising.” We leave it to the parties to explain whether the preamble of amended claim 8 is limiting, and if so, whether the analysis of the claims in the Petition shows that the preamble of amended claim 8 is described by Mehta.

Amended claim 8 recites “a network interface through which to communicate over a communication network.” This limitation is found in original claim 8.

Amended claim 8 recites “a download manager to.” This limitation is found in original claim 8.

Amended claim 8 recites

receive and store a plurality of items of digital content to be made available for use in wireless communication devices used by a plurality of wireless telecommunications subscribers, including receiving and storing a plurality of different implementations of at least one of the items of digital content, where each implementation of any given item of digital content corresponds to a different set of device capabilities.”

Claim 9 recites

receive and store a plurality of items of digital content to be made available for use in wireless communication devices used by a plurality of wireless telecommunications subscribers, including receiving and storing a plurality of different implementations of at least one of the items of digital content, where each implementation of any given item of digital content corresponds to a different set of device capabilities.”

On this record, this limitation of amended claim 8 appears to be identical to a limitation recited in claim 9 as addressed in the Petition.

Amended claim 8 recites “maintain a product catalog containing a description of the items of digital content, wherein the product catalog [including] includes, in association with each item of digital content, a reference to each implementation of said item of digital content.” Claim 9 recites “maintain a product catalog containing a description of the items of digital content, wherein the product catalog includes, in association with each item of digital content, a reference to each implementation of said item of digital content.” On this record, this limitation of amended claim 8

appears to be identical to a limitation recited in claim 9 as addressed in the Petition.

Amended claim 8 recites “receive a request from one of the wireless communication devices.” Claim 9 recites “receive a request from a wireless device used by one of the subscribers.” To the extent that the limitations appear to be different, we leave it to the parties to explain whether the scope of the limitations is the same, and if not, whether the analysis of the claims in the Petition shows that Mehta describes this limitation of amended claim 8.

Amended claim 8 recites “in response to the request, select a portion of the product catalog to be presented on the one wireless communication device, based in part on device capabilities of the one wireless communication device.” Claim 9 recites “in response to the request, select a portion of the product catalog to be presented to the subscriber, based on device capabilities of the wireless device used by the subscriber.” To the extent that the limitations appear to be different, we leave it to the parties to explain whether the scope of the limitations is the same, and if not, whether the analysis of the claims in the Petition shows that Mehta describes this limitation of amended claim 8.

Amended claim 8 recites “present the selected portion of the product catalog to the one wireless communication device, such that the selected portion, as presented, provides a single description of each item of digital content in said portion, regardless of a number of implementations that are available for each said item.” Claim 9 recites

cause the selected portion of the product catalog to be presented to the subscriber via a wireless telecommunications network, such that the selected portion, as presented to the subscriber, provides only a single description of each item of digital content

in said portion, regardless of the number of implementations of each said item.

To the extent that the limitations appear to be different, we leave it to the parties to explain whether the scope of the limitations is the same, and if not, whether the analysis of the claims in the Petition shows that Mehta describes this limitation of amended claim 8.

C. Claims 1–14 As Obvious Over Mehta and Schläpfer

1. Schläpfer – Exhibit 1009

Schläpfer is a white paper to “provid[e] insight into Java technology for the application development on mobile devices.” Ex. 1009, 3. Schläpfer describes the Java 2 Micro Edition (“J2ME”), which is an edition of Java designed for embedded devices and resource-constrained devices. *Id.* at 4. A “[P]rofile” is “defined as a set of APIs for a specific vertical market and relies upon the underlying configuration’s capabilities to create new, market-specific APIs.” *Id.* at 7.

The Mobile Information Device Profile (“MIDP”) addresses devices with a small display, touch screen or keypad, and capable of communicating via a mobile network with limited bandwidth. *Id.* at 7. Applications written “according to the MIDP specifications are called MIDlets.” *Id.* Schläpfer discloses provision of MIDlets. *Id.* at 11. The MIDlets may be combined with supporting files, a manifest, and an application descriptor to form a “jar file.” *Id.* at 7. The application descriptor includes mandatory attributes such as name, version, vendor, URL, and size. *Id.* at 7–8.

2. Reasons to Combine the Teachings of Mehta and Schläpfer

Petitioner contends a person of ordinary skill would have had reason to combine the teachings of Mehta and Schläpfer because both references

concern distributing digital contents to mobile devices over a wireless network. Pet. 66. Petitioner also contends Mehta provides a motivation to look to Schläpfer because Mehta “recognizes the issue of resource constraints on mobile devices and contemplates taking steps to address those constraints.” Pet. 67 (citing Ex. 1003 ¶¶ 10, 12). Petitioner contends that a person of ordinary skill would have combined Mehta’s MAS with Schläpfer’s teachings of limited screen space of mobile devices and limited bandwidth of the mobile network, and an application descriptor and associated attributes. *Id.* at 66 (citing Ex. 1009, 11). Mr. Wechselberger testifies that a person of ordinary skill in the art would have provided a single description of each supported application of Mehta in order to accommodate the viewing capabilities of the requesting device as taught by Mehta, such as limited screen space and signal processing capabilities of the mobile device as taught by Schläpfer. Ex. 1002 ¶¶ 106–108.

Petitioner argues that a person of ordinary skill would have had a reasonable expectation of success in combining the teachings of Mehta and Schläpfer because the two references rely on Java for distributing digital content to mobile devices and refer to the specific J2ME edition of Java. Pet. 68. Petitioner also contends that a person of ordinary skill would have known that a provisioning model includes a corresponding set of provisioning attributes and descriptors. Pet. 68–70.

For purposes of this Decision, we are persuaded that Petitioner cites sufficient evidence to support its contention that a person of ordinary skill would have had reason to combine the teachings of Mehta and Schläpfer.

3. *Claims 1 and 8*

We encourage the parties, during the course of the trial, to explain whether ground 2 and supporting evidence shows that claims 1 and 8 as amended are unpatentable, as discussed above in our analysis of ground 1.

4. *Claims 2–4 and 9–11*

Petitioner contends that Mehta discloses the limitations of claims 2–4 and 9–11 for the reasons given in ground 1. Pet. 48–53, 63–65. Petitioner further contends that to the extent Mehta alone may not disclose providing only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item as recited in claim 2, the combination of Mehta and Schläpfer teaches this limitation. Pet. 51–52. Petitioner contends that Mehta discloses the subscriber avoids the problem of having to explicitly select a compatible application when the MAS only lists the applications that are supported by the subscriber’s device. *Id.* at 51 (citing Ex. 1003 ¶ 117). Petitioner contends that Schläpfer discloses that mobile devices have a small display and communicate over a mobile network with limited bandwidth. *Id.* (citing Ex. 1009, 7). Mr. Wechselberger testifies that a person of ordinary skill in the art would have provided a single description of each supported application of Mehta in order to accommodate the viewing capabilities of the requesting device as taught by Mehta, such as limited screen space and signal processing capabilities of the mobile device as taught by Schläpfer. Ex. 1002 ¶¶ 106–108.

Based on the evidence and arguments currently of record, for purposes of institution, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in showing that the combination of Mehta and Schläpfer renders obvious claims 2–4 and 9–11.

5. *Claims 5 and 12*

Claim 5 depends from claim 4 and recites “associating each of the items of digital content in the server system with a plurality of different provisioning models, each of the provisioning models corresponding to a different set of device capabilities.” Petitioner contends that Mehta discloses this limitation in describing a plurality of different provisioning models, and that a person of ordinary skill in the art would have associated each of the items of digital content with the provisioning models for the benefit of distributing content for use on a particular device by a particular customer, in order to handle the device capabilities. Pet. 54–55 (citing Ex. 1003 ¶¶ 59, 85, 131).

Claim 5 recites “each provisioning model including a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices.” Petitioner contends that the combination of Mehta and Schläpfer teaches this limitation. Pet. 55. Petitioner contends that Mehta discloses extending known protocols using well-known techniques to provide support for additional protocols. *Id.* (citing Ex. 1003 ¶ 71). Petitioner contends that a person of ordinary skill would have included a set of provisioning attributes and descriptors for the provisioning model as taught by Schläpfer. *Id.* at 55–56 (citing Ex. 1009, 78, 1112).

Claim 12 recites limitations similar to those found in claim 5. Petitioner contends that the combination of Mehta and Schläpfer teaches the limitations of claim 12 for the reasons given in its analysis of claim 5. Pet. 65.

Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has sufficiently demonstrated a reasonable

likelihood of prevailing in showing that the combination of Mehta and Schlöpfer renders obvious claims 5 and 12.

6. *Claims 6 and 13*

Claim 6 depends from claim 5 and recites “receiving from the subscriber a request for one of the items of digital content in said portion of the product catalog.” Petitioner contends that Mehta discloses this limitation for the reasons given in its analysis of claim 4. Pet. 56.

Claim 6 recites “identifying device capabilities of the wireless device used by the subscriber.” Petitioner contends that Mehta discloses this limitation in describing determining the type and capabilities of the subscriber device. Pet. 56–57 (citing Ex. 1003 ¶¶ 64, 85).

Claim 6 recites “selecting one of a plurality of provisioning models associated with the requested item in the server system, based on the device capabilities of the wireless device used by the subscriber.” Petitioner contends that Mehta discloses this limitation in describing that the MAS selects an appropriate provisioning model based on device capabilities. Pet. 57–58 (citing Ex. 1003 ¶¶ 89, 61, 64, 131).

Claim 6 recites “packaging the requested item according to the selected provisioning model.” Petitioner contends that Mehta discloses this limitation in describing that during the provisioning process, the content can be packaged appropriate to the requesting device. Pet. 58 (citing Ex. 1003 ¶¶ 12, 15).

Claim 6 recites “provisioning the requested item in the wireless device used by the subscriber according to the selected provisioning model.” Petitioner contends that Mehta discloses this limitation in describing that the application is provisioned for a specific device. Pet. 59–60 (citing Ex. 1003 ¶¶ 64, 66, 131, Fig. 3).

Claim 13 recites limitations similar to those recited in claim 6. Petitioner contends that Mehta teaches the limitations of claim 6 for the reasons given in Petitioner's analysis of claim 6. Pet. 65.

Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has sufficiently demonstrated a reasonable likelihood of prevailing in showing that the combination of Mehta and Schläpfer renders obvious claims 6 and 13.

7. Claims 7 and 14

Claim 7 depends from claim 6 and recites "said packaging the requested item comprises creating a provisioning descriptor for the requested item according to the selected provisioning model, and associating the provisioning descriptor with the requested item." Petitioner contends that the combination of Mehta and Schläpfer teaches this limitation. Pet. 60–62. Petitioner contends that Mehta describes packaging content appropriate to the requesting device during the provisioning process, and that Schläpfer discloses provisioning applications accompanied by an application descriptor. *Id.* at 61 (citing Ex. 1003 ¶ 12; Ex. 1009, 78, 1112).

Claim 7 recites "said provisioning the requested item in the wireless device comprises sending the packaged requested item to the wireless device used by the subscriber according to a provisioning protocol associated with the selected provisioning model." Petitioner contends that Mehta discloses this limitation in describing sending the packaged application to the requesting subscriber device according to the determined protocol. Pet. 62–63 (citing Ex. 1003 ¶¶ 70, 134, Fig. 5).

Claim 14 recites limitations similar to those recited in claim 7. Petitioner contends that the combination of Mehta and Schläpfer teaches the

limitations of claim 14 for the reasons given in Petitioner's analysis of claim 7. Pet. 65.

Based on the evidence and arguments currently of record, for purposes of institution, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in showing that the combination of Mehta and Schlöpfer renders obvious claims 7 and 14.

VIII. CONCLUSION

Based on the arguments presented in the Petition, we conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to claims 1–14 of the '790 patent challenged in the Petition. Accordingly, we institute a trial on all claims and all grounds asserted in the Petition. The Board has not made a final determination under 35 U.S.C. § 318(a) with respect to the patentability of any challenged claim. Any final determination will be based on the record developed during trial. We place Patent Owner on express notice that any argument not asserted in a timely-filed Response to the Petition, or in another manner permitted during trial, may be deemed waived, even if that argument was presented in the Preliminary Response.

IX. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–14 of the '790 patent is instituted with respect to the grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '790 patent shall commence on the entry date of this Decision, and notice is hereby given of the institution of a trial.

IPR2023-00628
Patent 7,233,790 B2

FOR PETITIONER:

Aliza George Carrano
Heather Schneider
Indranil Mukerji
WILLKIE FARR & GALLAGHER LLP
acarrano@willkie.com
hschneider@willkie.com
imukerji@willkie.com

FOR PATENT OWNER:

Christine E. Lehman
Michael J. X. Matulewicz-Crowley
Jaime Cardenas-Navia
Naveed S. Hasan
REICHMAN JORGENSEN LEHMAN & FELDBERGER LLP
clehman@reichmanjorgensen.com
mmatulewicz-crowley@reichmanjorgensen.com
jcardenas-navia@reichmanjorgensen.com
nhasan@reichmanjorgensen.com