

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD. and SAMSUNG ELECTRONICS
AMERICA, INC.,

Petitioners

v.

MOBILE DATA TECHNOLOGIES LLC,

Patent Owner

IPR2025-00535
U.S. Patent No. 9,032,039

PATENT OWNER'S PRELIMINARY RESPONSE

35 U.S.C. § 313, and 37 C.F.R. § 42.107(a)

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2001	E-mail serving amended infringement contentions in EDTX-Litigation
2002	Comparison between the specifications of the ‘039 and ‘801 Patents
2003	Petition for <i>Inter Partes</i> Review in IPR2025-00536 (Jan. 31, 2025)
2004	Federal Register / Vol. 89, No. 77 / Friday, April 19, 2024 / Proposed Rules (Pages 28693-28706)
2005	Return of Service filed in the EDTX-Litigation (June 21, 2024)
2006	E-mail from the Board regarding the 535 and 536 IPR panel assignments (May 2, 2025)
2007	Decision Granting Institution of <i>Inter Partes</i> Review in IPR2024-00248 (June 11, 2024)
2008	E-mail from Erick S. Robinson memorializing the phone conversation with Petitioners’ counsel (September 26, 2024)
2009	Comparison of independent claims of the ‘039 and ‘5801 Patents
2010	U.S. Patent No. 6,594,347 (“Calder”)
2011	Examples of verbatim copy-pasting from Meta-MDT-IPRs by Petitioners
2012	U.S. Patent Application No. 2005/0177645 A1 (“Dowling”)
2013	E-mail exchange between Erick S. Robinson and Petitioners’ counsel regarding a stay (October 17, 2024)
2014	E-mail exchange between Erick S. Robinson and Petitioners’ counsel regarding a stay (February 19, 2025)
2015	E-mail exchange between Erick S. Robinson and Petitioners’ counsel wherein Petitioners shared their motion to stay with Patent Owner (March 4, 2025)
2016	Second Amended Docket Control Order in the EDTX-Litigation (December 19, 2024)
2017	United States District Courts — National Judicial Caseload Profile (September 30, 2024)
2018	E-mail from Petitioners’ counsel serving their initial and additional disclosures (October 16, 2024)
2019	E-mail from Petitioners’ counsel serving their invalidity contentions (January 31, 2025)
2020	E-mail from Petitioners providing materials produced by third-party Microsoft Corporation and Sybase, Inc. in response to Petitioners’ subpoena in the EDTX-Litigation (April 25, 2025)

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2021	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (March 7, 2025)
2022	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 24, 2025)
2023	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 21, 2025)
2024	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 11, 2025)
2025	E-mail from Petitioners providing materials produced by third-party AT&T Mobility LLC in response to Petitioners' subpoena in the EDTX-Litigation (February 5, 2025)
2026	Patent Owner's Infringement Contentions in the EDTX-Litigation (September 4, 2024)
2027	Petitioners' Invalidity Contentions in the EDTX-Litigation (January 31, 2025)
2028	E-mail exchange between Homayoon Rafatijo and Petitioners' counsel regarding Petitioners' contacting the Board for filing their proposed <i>Sotera</i> stipulation (April 21-23, 2025)
2029	E-mail from Petitioners' counsel with a draft of a proposed communication to the Board (April 30, 2025)
2030	E-mail from Petitioners' counsel with sharing with Patent Owner their proposed <i>Sotera</i> stipulation (April 18, 2025)
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2034	Petition for <i>Inter Partes</i> Review in IPR2024-00248 (Dec. 6, 2023)
2035	Summary of verbatim (or nearly verbatim, strikethrough added) matches between the '535 petition to the Houh Declaration (Ex.1002)
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Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107(a), Mobile Data Technologies, LLC (“Patent Owner” or “MDT”) submits this Preliminary Response to the Petition for *Inter Partes* Review (“IPR”) of U.S. Patent No. 9,032,039 (the “’039 Patent”), filed by Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioners”), challenging claims 1-4, 8-9, 13-15, 17-25 and 28-30 (the “Challenged Claims”) of the ’039 Patent. Paper 4 (“’535 IPR Petition” or “Petition”). Because Petitioners fail to meet their burden of showing a reasonable likelihood they would prevail with respect to at least one claim challenged in the Petition, institution should be denied.

I. INTRODUCTION

A. Procedural History

On June 10, 2024, Patent Owner filed a patent infringement complaint (the “Complaint”) against Petitioners in the United States District Court for the Eastern District of Texas. *Mobile Data Technologies LLC v. Samsung Electronics Co. Ltd. et al.*, 2:24-cv-00435-JRG-RSP (E.D. Tex.) (“EDTX-Litigation”). In the Complaint, Patent Owner asserted four patents: the ’039 Patent, U.S. Patent Nos. 8,825,801 (“the ’801 Patent”), 9,619,578 (“the ’578 Patent”), and 9,922,348 (“the ’348 Patent”). Patent Owner served its infringement contentions on September 4, 2024, for these patents. On October 6, 2024, Patent Owner filed an Amended Complaint, adding U.S. Patent No. 8,793,336 (“the ’336 Patent”) to the EDTX-Litigation. On the same

day, Patent Owner served its amended infringement contentions in which “[n]othing else was added other than a chart for the asserted claims of the ‘336 [Patent] and the file history for the ‘336 [Patent].” Ex.2001.

Nearly eight months into the EDTX-Litigation, and after the service of both invalidity and infringement contentions, Petitioners filed *ten* IPR petitions—two IPR petitions against each Asserted Patent. More specifically, on January 31, 2025, Petitioners filed the ‘535 IPR Petition. On March 11, 2025, a notice of filing date was accorded to the ‘535 IPR Petition, thereby establishing a three-month deadline of June 11, 2025 in which Patent Owner may file a Preliminary Response.

On March 26, 2025, the USPTO Acting Director Coke Morgan Stewart issued a memo introducing interim processes to manage the Patent Trial and Appeal Board’s (PTAB) workload, effectively creating a new, bifurcated, review scheme, in which discretionary denial considerations are analyzed first by the USPTO Director, in consultation with at least three PTAB judges. The Director will then issue a decision either denying institution or allowing the petition to be assigned to a three-judge panel, per the normal procedure. As a matter of right, the Patent Owner may submit a Discretionary Denial (“DD”) brief, due within two months of the notice of filing date of an IPR petition.

On May 7, 2025 (well within the two-month filing period of May 11, 2025), Patent Owner filed a DD Brief, presenting the Board with various independent

reasons to exercise their discretion to deny institution of the ‘535 IPR Petition. *See* Paper 8.

In the DD Brief, Patent Owner presented the following four independent reasons as to why the Board should exercise its discretion to deny institution of the ‘535 IPR:

1. Petitioners have failed to provide any adequate justification for its parallel petitions and thus under the *Consolidated Trial Practice Guide* (“CTPG”), the ‘535 IPR Petition, which is “lower-ranked,” should be discretionarily denied.¹

2. Under the *General Plastic* factors, Petitioners’ serial petitions on the same patents as in the Meta-MDT-IPRs should be denied.²

3. Under *Advanced Bionics*, the art asserted in the ‘535 IPR Petition was before the Examiner during examination of the ‘039 Patent, and Petitioners have made no demonstration that the Office erred in a manner

¹ The parallel petitions reasoning is discussed in Patent Owner’s DD Brief at pages 4-11. *See* Paper 8 at 4-11; *see also* Exs.2003-2006 and 2011.

² The *General Plastic* factors reasoning is discussed in Patent Owner’s DD Brief at pages 12-19. *See* Paper 8 at 12-19; *see also* Exs.2005, 2007, 2008, and 2011.

material to the patentability of the challenged claims.³

4. The *Fintiv* factors weigh heavily in favor of denial. The EDTX-Litigation is proceeding on a schedule for an April 2026 jury trial—five months before any IPR would conclude between Petitioners and Patent Owner, even if the Board were to institute. In addition, there is substantial overlap between the ‘535 IPR Petition and the EDTX-Litigation as Petitioner relies on system art in the EDTX-Litigation that corresponds to the references relied upon in the Petition. Furthermore, the ‘535 IPR Petition relies excessively on expert testimony and lacks merit.⁴

B. Summary

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

³ The *Advanced Bionics* reasoning is discussed in Patent Owner’s DD Brief at pages 19-29. *See* Paper 8 at 19-29; *see also* Exs. 2009-2012, 2014, and 2034.

⁴ The *Fintiv* factors reasoning is discussed in Patent Owner’s DD Brief at pages 29-61. *See* Paper 8 at 29-61; *see also* Exs. 2002, 2005, 2006, 2008, 2013-2020, 2026-2030, 2032, 2033, and 2035.

that the petitioner would prevail with respect to at least one of the claims challenged in the petition” (35 U.S.C. §314(a)).

Here, institution should be denied because Petitioners do not satisfy the threshold for institution of this IPR. First, Petitioners present the same or substantially similar prior art previously before the Office and considered by the Examiner during the pendency of the original examination of the challenged claims of the ‘039 Patent, and Petitioners have failed to articulate any material error permitting reconsideration of the previously considered prior art.

Second, institution should be denied because Petitioners have not shown there is a reasonable likelihood they would prevail in establishing the unpatentability of at least one challenged claim.

Petitioners fail to address the differences between the claimed subject matter and the prior art. More specifically, Petitioners have failed to establish the prior art discloses: 1) “identifying a[n] ... application-based information channel” (into which content from a mobile device, including captured content from a mobile device, is to be inserted), as generally recited in the independent claims of the ‘039 Patent; 2) “information associated with ... the wireless networking functionality of the mobile device”, as generally recited in the independent claims of the ‘039 Patent ; and 3) limitations regarding “Inserting” and “Integrating” as recited in independent claims 19, 22, and 23. Furthermore, Petitioners have failed to provide a reasoned

analysis of how and why a person of ordinary skill in the art (“POSITA”) would combine the prior art lacking claimed features in view of the knowledge of a POSITA, most notably failing to provide a reasoned analysis as to how a POSITA would combine Neibauer and Cheng, the primary prior art relied upon in Petition. Because Petitioners have not met their burden, institution of this IPR should be denied.

C. Prior Art and Asserted Grounds

Petitioners assert the Challenged Claims are unpatentable based on the following grounds under 35 U.S.C. §103:

Ground	Challenged Claims(s)	Reference(s)/Basis
1	1-4, 8, 9, 13-15, 17-20, 22-25, 28-30	Neibauer, Cheng, Squibbs, Ausems
2	21	Ground 1 + Bandera
3	1-4, 8, 9, 13-15, 17-20, 22-25, 28-30	Ground 1 + Harvey
4	21	Ground 2 + Harvey

Grounds 1-4 challenge independent claims 1, 17, 18, 19, 22, and 23, with the references Neibauer, Cheng, Squibbs, and Ausems being common to the Challenged Claims.

D. The '039 Patent

The '039 Patent is titled “Method, Apparatus and System for Management of Information Content for Enhanced Accessibility Over Wireless Communication

Networks,” and was issued by the U.S. Patent & Trademark Office on May 12, 2015.
Ex.1001 (face).

In one embodiment, the ‘039 Patent describes a method that enables a mobile device user to transfer content from the mobile device to a server for insertion into a previously established application-based information channel so that the mobile device user can interact with one or more additional users.

The ‘039 Patent also describes transferring information associated with at least one wireless networking functionality of the mobile device from the mobile device to the server.

The content and the information associated with the at least one wireless networking functionality of the mobile device is integrated into the previously established application-based information channel. *See, e.g.*, Ex.1001, 5:51-65, 9:8-28.

The ‘039 Patent also enables other content from at least one of the additional users to be inserted into the previously established application-based information channel.

E. The Challenged Claims

The Challenged Claims 1-4, 8-9, 13-15, 17-25 and 28-30 include independent claims 1, 17, 18, 19, 22, and 23, set forth below.

1. A method comprising:

- 1[A] capturing content at a mobile device;
- 1[B] identifying a previously established application-based information channel into which the captured content is to be inserted, the identified application-based information channel permitting interaction between a user of the mobile device and one or more additional users;
- 1[C] determining information associated with at least one wireless networking functionality of the mobile device;
- 1[D] providing the captured content from the mobile device to at least one server for insertion in association with the determined information into the identified application-based information channel; and
- 1[E] receiving other content, at the mobile device via the identified application-based information channel, from at least one of the additional users.

17. A non-transitory computer-readable storage medium having embodied therein executable code of one or more software programs, wherein said executable program code when executed by a processing element of the mobile device causes the mobile device to perform the method of claim 1.

18. A mobile device comprising:

- 18[A] at least one processing element comprising a processor coupled to a memory; and
- 18[B] at least one network interface;
- 18[C] said at least one processing element being configured to:
- 18[D] capture content at the mobile device;
- 18[E] identify a previously established application-based information channel into which the captured content is to be inserted, the identified application-based information channel permitting interaction between

a user of the mobile device and one or more additional users;

18[F] determine information associated with at least one wireless networking functionality of the mobile device;

18[G] provide, via said at least one network interface, the captured content from the mobile device to at least one server for insertion in association with the determined information into the identified application-based information channel; and

18[H] receive other content, via the identified application-based information channel, from at least one of the additional users.

19. A method comprising:

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

19[B] receiving, at the server from the mobile device, information associated with at least one wireless networking functionality of the mobile device;

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

19[D] inserting other content from at least one of the additional users into the previously established application-based information channel.

22. A non-transitory computer-readable storage medium having embodied therein executable code of one or more software programs, wherein said executable program code when executed by a processing element of the server causes the server to perform the method of claim **19**.

23. A server comprising:

23[A] at least one processing element comprising a processor coupled to a memory; and

23[B] at least one network interface;

23[C] said at least one processing element being configured to:

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

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

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

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

II. THE PETITION IS GROUNDED IN ART THAT WAS ALREADY BEFORE THE EXAMINER, AND THUS INSTITUTION SHOULD BE DENIED UNDER § 325(D)⁵

The art asserted in the ‘535 IPR Petition was before the Examiner during examination of the ‘039 Patent, and Petitioners have made no demonstration that the Office erred in a manner material to the patentability of the challenged claims. Thus, under *Advanced Bionics*, the Petition should be denied.

A. Relevant Legal Principles

In determining whether to institute an IPR, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). The Board uses a two-part framework for evaluating arguments under Section 325(d): (1) whether the same or substantially the same art was previously presented to the Office or whether the same or substantially the same arguments were previously presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims. *Advanced*

⁵ Patent Owner’s DD Brief also argued the Board should exercise its discretion to deny institution under Section 325(d). *See* Paper 8 at 19-29 and Exs. 2009-2012, 2014, and 2034.

Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6, 8 (P.T.A.B. Feb. 13, 2020) (precedential).

When applying the first part of the *Advanced Bionics* framework, the Board considers the *Becton, Dickinson* factors that address the Board's discretion to deny institution when a petition presents the same or substantially the same prior art or arguments previously presented to the Office during examination, including:

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

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8, 17-18 (P.T.A.B. Dec. 15, 2017) (precedential as to § III.C.5, first paragraph). Factors (a), (b), and (d) relate to whether the same or substantially the same art or arguments were previously presented to the Office during examination, and factors (c), (e), and (f) relate to whether a petitioner demonstrates that the Office erred in a manner material to the patentability of the claims. *Advanced Bionics*, Paper 6 at 9-11. Only

if the same or substantially the same art or arguments were previously presented to the Office during examination does the Board then consider whether the petitioner has demonstrated a material error by the Office. *Id.*

Regarding the first prong of *Advanced Bionics*, Petitioners failed to meet their duty of candor by misrepresenting to the Board that that “no asserted reference is substantially the same as any art previously presented” (Petition at 71), **even though Neibauer, Cheng, and Squibbs were made of the record by the Examiner.**

Regarding the second prong of *Advanced Bionics*, Petitioners made no showing that the Office made a “material error” to the patentability of the challenged claims. Indeed, the Petition states that because “no asserted reference is substantially the same as any art previously presented” (which is incorrect), “[t]hus, the Board need not reach Part 2.”

B. *Advanced Bionics* Factors

1. Neibauer, Cheng, and Squibbs

“[T]he first part of the *Advanced Bionics* framework is satisfied if either substantially the same prior art or substantially the same arguments were previously presented to the Office.” *Nokia of America Corp. v. Alexander Soto and Walter Soto*, IPR2023-00680, Paper 18, 4 (P.T.A.B. Mar. 4, 2024) (Director Review) (emphasis in original). “Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure

Statement (IDS), in the prosecution history of the challenged patent.” *Advanced Bionics*, Paper 6 at 7-8. In a precedential Director Review decision, the Director clarified the Advanced Bionics framework, explaining that “a petitioner **must provide an analysis even when the asserted prior art is on an IDS, but the Examiner did not apply the reference.**” *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13, 5 (P.T.A.B. May 19, 2025) (precedential as to §A). The Examiner evaluated Neibauer, Cheng, and Squibbs during examination of the ‘039 Patent. Indeed, each of these references appear in IDS forms, as well as on the face of the ‘039 Patent. Ex.1022 at 170, 186, 199, 312. Specifically, the IDS forms note that Examiner must “[i]nitial if reference considered ... or [d]raw line through a citation if ... not considered.” The Examiner initialed the IDS forms without lining through Neibauer, Cheng, and Squibbs. *See, e.g., id.* at 174, 314.

Indeed, the Examiner annotated each IDS page including Neibauer, Cheng, and Squibbs adding the following statement:

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /JJ/

Id.

In addition, the Examiner had knowledge of Neibauer and Cheng because of a prior reexamination proceeding on a related patent. The application that matured into the ‘039 Patent was filed on September 11, 2014. Ex.1001 at 1. The great-

grandparent of the ‘039 Patent is U.S. Patent 8,135,801 (the “‘5801 Patent”). An *inter partes* reexamination was instituted on the ‘5801 Patent. And on May 14, 2012, in that reexamination, the ‘5801 Patent—with materially different claims and limitations than those of the ‘039 Patent (*see* Ex.2009 (comparing independent claims of the ‘039 and ‘5801 Patents))—was found to be invalid based on the combination of Neibauer and Cheng. The PTAB affirmed in October 2014. *See* Ex.1024. The Examiner of the ‘039 Patent was the same Examiner of the great-grandparent ‘5801 Patent that was later reexamined, and **the Examiner of the ‘039 Patent also considered that reexamination decision while examining the ‘039 Patent.** Ex.1022, 197 (Examiner “initialing” an IDS with only three references identified—all of which related to the reexamination, including the Decision that references Neibauer and Cheng). Accordingly, there is no doubt that the Examiner had knowledge of the reexamination proceeding and its use of Neibauer and Cheng.

Aside from Petitioners’ failure to abide by their duty of candor, the Board should not bless Petitioners’ invitation to second-guess the Examiner’s judgment not to apply Neibauer, Cheng, and Squibbs (alone or in combination) to the ‘039 Patent. The Board defers to “previous Office evaluations of the evidence of record unless material error is shown.” *Advanced Bionics*, Paper 6 at 9. A showing of material error is a high threshold: “[i]f reasonable minds can disagree regarding the purported

treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Id.*

Here the claims of the ‘039 Patent are materially different from those of the ‘5801 Patent invalidated during the reexamination proceeding. *See* Ex.2009. Nevertheless, the reexamination decision was made part of the record of the ‘039 prosecution history by the Examiner, showing that the Examiner considered the potential relevance of the reexamination proceeding. And, as established above, Petitioners have not even attempted to make any showing of “material error” by the Office. Petition at 71. Even if Petitioners could rely on the reexamination outcome for the ‘5801 Patent to argue that the Examiner of the ‘039 Patent committed “material error” by not rejecting the ‘039 Patent claims based on Neibauer and Cheng (they cannot because it was not included in the Petition), such an argument would fail.

2. Ausems

Petitioners add Ausems to their Neibauer Grounds in an attempt to circumvent *Advanced Bionics*. But *Advanced Bionics* applies to “the same or substantially the same prior art” (*Advanced Bionics*, Paper 6 at 8), and *Becton, Dickinson* factors (a) and (b) explicitly contemplate whether the asserted art is cumulative of the prior art involved in the examination or whether there are material differences between the two.

Petitioners cite Ausems for three reasons, each of which is cumulative of references relied upon by the Examiner during prosecution of the '039 Patent. First, Petitioners rely on Ausems as teaching “a mobile device that incorporated a digital camera for recording, storing, and transmitting digital images.” Petition at 18-20. But Calder—a prior art reference specifically discussed by the Examiner—also teaches a mobile device with a video camera for image capture. Ex.1022 at 161; Ex.2010, 2:27-30 (“[A]lternatively the mobile device may have a video camera for image capture whereby an interpretation of the image is converted into tones and the tones are transmitted to a telephony server.”).

Second, Petitioners use Ausems for teaching a “mobile device [that] could have been ‘a GPS-based navigational device.’” Petition at 43. But as Petitioners’ expert testimony shows, the same is taught by the previously considered Squibbs: “Squibbs explains that the cell phone can determine location information in a number of ways, including from ‘a location server of the mobile radio infrastructure,’ or using ‘a GPS system built into the cell phone.’” Ex.1002, ¶89 (citing Squibbs, ¶0098; ¶0101). And as discussed above, Squibbs was presented to the Office during prosecution.

Third, Petitioners cite Ausems for teaching elements like CPU and memory. Petition at 44-45. But Cheng, cited during examination, also describes these elements. Cheng, *e.g.*, 23:16-20 (“Although computer system 1100 is illustrated

having a single processor, a single hard disk drive and a single local memory, the system 1100 is optionally suitably equipped with any multitude or combination of processors or storage devices.”), 23:29-31 (“CPU 1204 is the central processing unit of the system, performing calculations and logic operations required to execute a program.”).

Accordingly, Ausems is cumulative of references considered during the prosecution history (i.e., Calder, Squibbs, and Cheng). Thus, its inclusion by Petitioners was unnecessary, notably given that Petitioners included both Squibbs and Cheng. *See Intel Corp. v. Interdigital, Inc.*, IPR2024-01441, Paper 13, 15-16 (P.T.A.B. Apr. 1, 2025).

3. Bandera

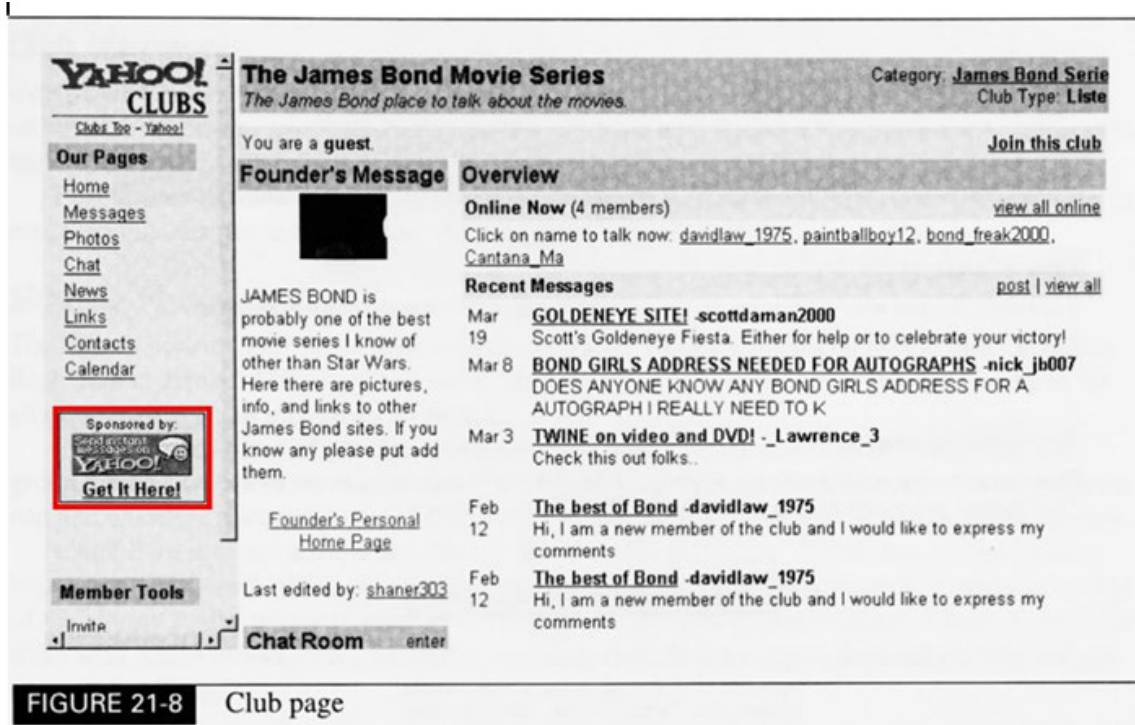
Petitioners’ reliance on Bandera is limited to dependent claim 21, and their arguments are taken verbatim from Meta’s Petition in the Meta-MDT-IPRs. *See* Ex.2011, 21-23, Row#26. Petitioners use Bandera for teaching “advertising based on the location of the mobile device” or “location-based advertisement.” Petition at 64-65. Petitioners need not rely on Bandera to teach this, and to the extent they do, Bandera is substantially similar to US 2005/0177645 to Dowling et al., which was before the Examiner. Ex.1022, 208. For example, Dowling discloses “a geographical web browser” that provides “a new means for advertising locally available items such as products and services.” Ex.2012, [0064]. Specifically, Dowling teaches an

example of a location-based advertising:

The user interested in a certain product or service logs into a geographically controlled web site and configures the packet filter to display information related to a user's needs. In one example the mobile unit 105 enters a new city and the user is interested in finding a mall with a particular clothing store within. As the user drives along, a web page comes up and provides directions to the shopping mall and also optionally provides an inside map of the mall to include directions to the desired store.

Id. Dowling's disclosure that was before the Examiner during the prosecution of the '039 Patent is substantially similar to the disclosure Petitioners rely on in Bandera.

To be clear, Petitioners do not cite Bandera to teach the delivery of advertising content on the same web page as other content (e.g., a photo) requested by a mobile user. And in fact, Petitioners need not cite Bandera for that. As Petitioners allege, Neibauer "shows an exemplary club page with an advertisement placed on it." Petition at 51.



(Neibauer, p.475, Fig. 21-8 (red box added).)

Petition at 52. Accordingly, Petitioners rely on Bandera in a limited fashion: “The web server, in response, generates a requested web page that includes an advertising object. The web server selects the advertising object ‘based on a user location and/or on the time of day.’” Petition at 49. As shown above, Dowling discloses the same.

4. Harvey

Petitioners’ use of Harvey in Grounds 3 and 4 of the Petition only highlights their abuse of the IPR process. Petitioners openly admit that the only reason Grounds 3 and 4 based on Harvey are asserted in the Petition is to “account for a construction of ‘application-based information channel’ proposed by Meta in the MDT-Meta-

Litigation.” Petition at 67. Petitioners have not proposed the MDT-Meta-Litigation construction for “application-based information channel” in the district court, nor do they propose that construction in the Petition. *See* Petition at 5-7. There is no reason for Petitioners to burden the Board with Grounds 3 and 4 based on Harvey in the Petition when neither Petitioners nor Patent Owner have ever adopted the construction proposed by Meta in the MDT-Meta-Litigation for “application-based information channel.” Meta introduced Grounds 3 and 4 in the Meta-MDT-IPRs only because its own litigation claim construction required it. Petitioners’ assertion of these grounds completes their mimicry of the Meta-MDT-IPRs. Accordingly, the Board should not consider Grounds 3 and 4 based on Harvey.

Thus, all art necessary to decide institution is the same or substantially similar to art presented to and considered by the Examiner. Because of this, the Board need not reach the question of whether the same or substantially the same arguments were previously presented to the Office and may proceed to the second part of the *Advanced Bionics* framework. *Advanced Bionics*, Paper 6 at 20.

As established above, Petitioners made no attempt to satisfy the second part of the *Advanced Bionics* framework, instead relying upon their erroneous statement that “*Advanced Bionics* Part 1 is not satisfied because none of the asserted references were cited or applied during prosecution.” Petition at 71. Thus, the Board should deny institution here under *Advanced Bionics*.

III. PETITIONERS HAVE NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CLAIM CHALLENGED IN GROUNDS 1-4

Petitioners assert four obviousness grounds of unpatentability. Petition at 2. The Board need only consider the validity of independent claims 1, 17, 18, 19, 22, and 23. As discussed below, the Petition fails to establish a reasonable likelihood that Petitioners will prevail and thus a trial therefore should not be instituted.

A. Relevant Legal Principles

Review cannot be instituted unless the Petition demonstrates a reasonable likelihood that at least one of the challenged claims is unpatentable. 35 U.S.C. §314(a); 37 C.F.R. §42.108(c). Under §314, the Board is required to make “a binary choice – either institute review or don’t.” *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018).

It is Petitioners’ burden to show why the challenged claims are unpatentable. *Harmonic Inc. v Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016). The Board “will not take on the role of advocate for a party, trying to make out a case the party has not adequately stated.” Board of Patent Appeals and Interferences, Standing Order ¶121.5.2 (Mar. 8, 2011). Rather, it is Petitioner’s duty to provide sufficient grounds for the institution of a review “focus[ing] on concise, well organized, easy-to-follow arguments supported by readily identifiable evidence of record.” *Cisco*

Sys., Inc. v. C-Cation Tech, LLC, IPR2014-00454, Paper 12 at 11 (P.T.A.B. Aug. 29, 2014).

The ultimate determination of obviousness under 35 U.S.C. §103 is a question of law based on underlying factual findings. *In re Baxter Int’l, Inc.*, 678 F.3d 1357, 1362 (Fed. Cir. 2012) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)). “To satisfy its burden of proving obviousness, a petitioner cannot employ merely conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380-81 (Fed. Cir. 2016).

The “factual inquiry” into the reasons for “combin[ing] references must be thorough and searching, and the need for specificity pervades.” *In re NuVasive, Inc.*, 842 F.3d 1376, 1381-82 (Fed. Cir. 2016) (internal quotations and citations omitted). The specific reasoning must include some rational underpinning to combine the prior art elements as claimed to support the conclusion of obviousness. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). It is Petitioners’ burden to demonstrate a motivation to combine, and a reasonable expectation of success. *See In re Magnum Oil Tools*, 829 F.3d at 1381. Mere conclusory statements are insufficient. *Id.*, at 1380.

B. Grounds 1-4: Claims 1-4, 8, 9, 13-15, 17-25, 28-30 Are Not Obvious Over Neibauer in view of Cheng, Squibbs, and Ausems, or further in view of Bandera and/or Harvey

Grounds 1 and 3 challenging independent claims 1, 17, 18, 19, 22, and 23 rely on unpatentability over at least Neibauer, in view of Cheng, Squibbs, and Ausems (Ground 1) and further in view of Harvey (Ground 3) under 35 U.S.C. §103. Grounds 2 and 4 challenging dependent claim 21 (ultimately depending from independent claim 19) rely on unpatentability over at least Neibauer, in view of Cheng, Squibbs, Ausems, and Bandera (Ground 2) and further in view of Harvey (Ground 4) under 35 U.S.C. §103.

1. Grounds 1 and 3: Neibauer, Cheng, Squibbs, Ausems, and Bandera, either alone or in combination, do not disclose “identifying a[n] ... application-based information channel”

Regarding Grounds 1 and 3, the Petition asserts that the features of Yahoo! and the uses of its services and tools (referencing various excerpts from Neibauer, notably referencing the Yahoo! Clubs feature) renders the majority of the claim limitations obvious.

As a threshold matter, Petitioners take inconsistent positions: the club photo-sharing feature is the application-based information channel in the ‘535 Petition, the web-based shared information channel in the ‘541 Petition, and the mobile information channel in the ‘537 Petition. Their expert does the same. In the ‘535-IPR, Petitioners’ expert testimony stated that “[t]he club photo sharing feature is an

‘application-based information channel’” because the club is an application. Ex.1002, ¶¶144; 139. In the ‘541 IPR, the expert argued that the very same feature is a “web-based shared information channel,” basing his conclusion on the notion that the club is a webpage accessible from a website. Ex.2038, ¶¶75, 104, 123. In the ‘537-IPR, the expert used the club photo-sharing feature to map the claimed “mobile information channel.” Ex.2039, ¶¶109, 130, 134. Neither Petitioners nor their expert provide any explanation to resolve these inconsistencies. And to the extent Petitioners and their expert imply that that “web-based shared information channel,” “application-based information channel,” and “mobile information channel” are equivalent, neither Petitioners nor their expert provide any explanation as to why. Ex.1002, ¶¶139, 144. **The Board should resolve this double-speak against Petitioners on merits.** See *Google LLC v. Makor Issues & Rights Ltd.*, IPR2017-00815, Paper 31, 24 (P.T.A.B. Aug. 10, 2018) (noting a party’s failure to “explain persuasively” why it has “taken inconsistent positions between IPRs with respect to this limitation.”); see also *Meta Platforms, Inc. v. Eight kHz, LLC*, IPR2023-01004, Paper 9, 29-30 (P.T.A.B. Jan. 9, 2024) (pointing to inconsistencies in the petitioner’s positions regarding the prior art teachings across two IPRs).

Turning to Petitioners’ argument in this IPR, Petitioners assert the club photo-sharing feature is the “application-based information channel” into which content from a mobile device, including captured content from a mobile device, is to be

inserted, as generally recited in the independent claims (e.g., limitation 1[B] of claims 1 and 17, limitation 18[D] of claim 18, limitation 19[A] of claims 19 and 22, and limitation 23[D] of claim 23).

The Petition asserts the claimed step of “identifying a[n] ... application-based information channel” “takes place when Neibauer’s server receives a photo uploaded by a club member to be shared with other club members”, and further asserts that “Neibauer’s club photo sharing feature is an ‘application-based information channel.’” Petition at 21.

However, Neibauer simply discloses use of the Yahoo! website for accessing the various features, including the clubs feature, in contrast to use of an “application-based” information channel, as generally recited in the claims. In fact, there is no disclosure of use of an “application” whatsoever for the Yahoo! Clubs feature. Ex.2037, ¶¶75, 76. Rather, as admitted by Petitioners’ expert, the Yahoo! Clubs feature is accessible from a *webpage on the Yahoo! website*, which allows users to search existing clubs relating to specific topics of interest, and a user clicks a hyperlink for a given club. Ex.1002, ¶51; Neibauer, 473. In particular, Neibauer explicitly states a user can “Access Yahoo! clubs by clicking Clubs on the *Yahoo! home page* or by going directly to <http://clubs.yahoo.com/> to open the page....” *Id.* Petitioners’ expert also concedes that Yahoo! Clubs is accessed using the Yahoo! home page. Ex.1002, ¶¶27, 100, 106, 115. Accordingly, a user utilizes the Yahoo!

website to further access and use the web-based Yahoo! Clubs feature for the sharing of content, in contrast to an “application-based information channel,” as generally claimed. Ex.2037, ¶¶75, 76. Therefore, the Yahoo! Clubs feature is hosted and provided via a web-based means, in contrast to the claimed “application-based” information channel. In particular, the photo sharing provided by Yahoo! Clubs is merely a feature that is web-based, in contrast to being application-based. Ex.2037, ¶¶75, 76.

Petitioners do not rely on any of the remaining references to cure the deficiencies of Neibauer for limitation 1[B] (or similar limitations 18[D] (of claim 18), limitation 19[A] (of claims 19 and 22), and limitation 23[D] (of claim 23). *See* Petition at 20-23. Nor can they. Neither Cheng, nor Ausems, nor Squibbs (asserted in Ground 1) nor Bandera (further asserted in Ground 2) teaches or suggests at least the claim limitation “identifying a previously established application-based information channel” into which content from a mobile device, including captured content from a mobile device, is to be inserted.

Cheng merely discloses systems and methods of extracting content from a web page and reformatting the extracted content for viewing on a mobile device. Cheng, 1:11-16. Cheng is simply relied upon for the teaching of proxy servers and use of such servers in making web content viewable on mobile devices. In fact, the Petition acknowledges that:

Cheng provides “bolt-on” functionality, with the proxy server capable of converting and reformatting any existing HTML-based web page into a format suitable for display on a mobile device. (EX-1002, ¶¶69, 73-74, 92-93; Cheng, 2:30-32 (“The [reformatting] may be done for at least one of groups of devices, individual devices, web site-specific conversions, or for all web sites.

Petition at 16; *see also* Ex.1002, ¶95 (describing Cheng as “including the ability to make web-based information content available on mobile devices. Cheng would also have been reasonably pertinent to problems facing the inventors, including how to implement a web-based system for making information content available to mobile device users”).

As such, Cheng is completely unrelated to the use, and devoid of any teaching, of an “application-based information channel.” Rather, Cheng is limited to use with website-specific conversions. Ex.2037, ¶¶55-57, 78.

The Petition does not rely on Ausems, Squibbs, and Bandera for teaching or suggesting limitation 1[B] (or similar limitation 18[D] of claim 18, limitation 19[A] of claims 19 and 22, and limitation 23[D] of claim 23). Even if it did, these references are similarly deficient as none teach or suggest an “application-based information channel.” Thus, even the teachings of one or more of the remaining

references were combined with Neibauer, such a combination would still fail to teach or suggest this limitation.⁶

2. Grounds 1 and 3: Neibauer, Cheng, Squibbs, Ausems, and Bandera, either alone or in combination, do not disclose “information associated with ... wireless networking functionality of the mobile device”

Furthermore, as to limitation 1[C], the Petition fails to identify any “information associated with at least one wireless networking functionality of the mobile device.” Petitioners map the claimed “captured content” onto “the photo selected by the [Neibauer’s] club member for the album” (Petition at 10), but map the claimed “information associated with ... the wireless networking functionality of the mobile device” onto Neibauer’s “textual message content” that accompanies the photo. Petition at 25. As Petitioners concede, Neibauer’s “textual message” is content itself, specifically, it is “a textual name and description of the photo.” Petition at 25-26. Petitioners do not explain how “a textual name and description of the photo” constitutes information associated with a functionality of a mobile device. Furthermore, in the ‘537-IPR (IPR2025-00537), Petitioners expressly stated that claimed content in the ‘801 Patent—with nearly identical specification and claim terms as the ‘039 Patent—include both photo and textual message. Ex.2036, 27

⁶ As established in Section C below, Petitioners have failed to establish a motivation to combine these references and thus any such combination would be improper.

(“The ‘content’ thus corresponds to the *first user providing textual messages* (with respect to the club message board and club chat mobile information channels), and *photographs* (with respect to the photo sharing mobile information channel).”). Petitioners are caught in a double-speak. *See Makor Issues*, IPR2017-00815, Paper 31, 24 (noting a party’s failure to “explain persuasively” why it has “taken inconsistent positions between IPRs with respect to this limitation.”); *see also Eight kHz*, IPR2023-01004, Paper 9, 29-30.

3. Grounds 3 and 4 based on Harvey do not cure the deficiencies in Grounds 1 and 2

As a threshold matter, Patent Owner highlights yet another aspect of *Petitioners’ abuse of the IPR process*. Petitioners’ Ground 3 addresses limitations that are not in the claims of the ‘039 Patent. Petitioners state:

The “*content management site*,” as explained for Ground 1, corresponds to the website for creating and managing a new club based on the proposed combination, and the “*mobile website*” to the club website made available to club members via mobile devices, under the proposed combination. (EX-1002, ¶242.) With respect to the requirement that the “*content management site*” permit the user to add “*user-authored content*,” to the extent not already obvious over Neibauer, this would have been obvious in further view of Harvey.

Petition at 67 (italics used by Petitioners for claim terms). Thus, Petitioners’ Ground 3 addresses requirements (e.g., “user-authored content”) that are not in the claims, rendering the entire Ground 3 useless.

Even overlooking this, Petitioners burden the Board with their verbatim copy-pasting from Meta’s IPR positions regarding Harvey only for its disclosure of “the ability to add content to a community before the community is created.” Petition at 67-68. For all other limitations, Petitioners refer to their arguments for Ground 1, which is deficient as discussed above. *Id.*

Harvey, however, fails to cure the deficiencies of the cited references as previously discussed, specifically failing to teach or suggest limitation 1[B]: identifying an application-based information channel that is “previously established” (and thus also fails to teach or suggest similar limitations 18[D] (of claim 18), limitation 19[A] (of claims 19 and 22), and limitation 23[D] (of claim 23)). Ex.2037, ¶¶79-84.

Petitioners assert Harvey discloses a “previously established” information channel because “[t]he key feature of Harvey here is the ability of a community creator to author content for a community before the community is created and launched.” Petition at 68 (emphasis in original); *see also id.* (“Harvey therefore discloses the ability to add content to a community using the community-creation tool, before the community is created.”).

However, Harvey fails to teach or suggests at least the claim limitation “identifying a previously established application-based information channel,” as generally recited in the independent claims (e.g., limitation 1[B]). Harvey describes

the use of a community creating module, described as being capable of permitting a creator to create a community and designate applications and content to be presented in the community. Ex.2037, ¶80. Petitioners suggest the community that Harvey describes is the information channel. The capabilities of this community (information channel), however, are permitted during the creation of the community, and do NOT occur before the creation of the community, as the Petition asserts. Ex.2037, ¶83. Thus, Harvey’s community is not a “previously established application-based information channel.” Interestingly, Petitioners cite Harvey’s discussion about creation of the community and designation of content for the community that clearly states the designation of content occurs during the creation of the community: “Harvey explains that ‘[t]he community creating module permits the creator to create a community, and designate applications and content presented in the community by a user interface.’” Petition at 68 (citing Harvey, 4:28-30). Yet, Petitioners distort this by saying “Harvey therefore discloses the ability to add content to a community using the community-creation tool, before the community is created.” Petition at 68; Ex.2037, ¶84.

Furthermore, Petitioners and their expert appear to be lumping the terms “created” and “launched” as if they are a single action. In particular, the Petition asserts “[t]he key feature of Harvey, for purposes of this ground, is its disclosures of a community creator being able to add content to a community before the community

is created and launched.” Petition at 68 (emphasis in original). However, Petitioners’ statement is factually incorrect. The creation and subsequent launching of a given community are two separate actions. The addition of content to a given community occurs during the creation of the community, not before the creation of the community. Accordingly, while a community creator may add content to a community before it is launched, the community creator cannot add content to a community before the community itself is created. Petitioner’s expert statement is thus inaccurate and misleading. Ex.2037, ¶85.

In addition, Harvey is generally directed to web-based community creation (Harvey, 7:49-56, 8:49-50), in which a user can establish a connection with a community, among other ways, “through browser access to an appropriate website.” Harvey, 29:59-62. As such, Harvey suffers from the same deficiencies as Neibauer. Thus, even if one were to combine the teachings of Harvey with Neibauer (and any other remaining references), such a combination would still fail to teach or suggest at least limitation 1[B] (and thus also fails to teach or suggest similar limitations 18[D] (of claim 18), limitation 19[A] (of claim 19), and limitation 23[D] (of claim 23)).

4. Neibauer, Cheng, Squibbs, Ausems, Bandera, and Harvey, either alone or in combination, do not disclose limitations regarding “Inserting” and “Integrating”

Regarding claims 19, 22, and 23, Petitioners obviousness case depends on the

false premise that “inserting” content and “integrating” content and wireless-network information are interchangeable acts. Petition at 49-52. To the contrary, however, the intrinsic record teaches that “inserting” is distinct from “integrating.” At a minimum, these are separate claim limitations. Petitioners’ own language shows that it simply collapses the two limitations—19[C] versus 19[D] (and 23[F] versus 23[G])—into the same bucket. *Id.* Because the cited art (and the Petition’s mapping) addresses only **insertion** by end-users, not **integration**, each of Petitioners Grounds 1 and 3 fails on its face.

a) “Integrate” and “Insert” are defined differently in the claims

The claims and specification make clear that “inserting” and “integrating” are different. In particular, claim 19 recites, among other things:

“**integrating** the content and the information associated with said at least one wireless networking functionality of the mobile device into the previously established application- based information channel”

(limitation 19[C]); and

“**inserting** other content from at least one of the additional users into the previously established application-based information channel.”

(limitation 19[D]). Claim 23 includes similar recitations (i.e., limitations 23[F] and 23[G] are similar to limitations 19[C] and 19[D], respectively).

Petitioners blur this distinction between the two distinct claim terms—integrating and inserting—by conflating the two terms. First, the Petition states that limitation 19[C] is “substantially similar to limitation...1[D].” Petition at 50. Unlike limitation 19[C], however, limitation 1[D], does not contain any requirement of “integrating” and instead requires “insertion” of content into the application-based information channel.

Second, Petitioners incorrectly construe limitation 19[C], specifically by suggesting that limitation 19[C] requires that 1) the content is ***inserted and integrated*** into the application-based information channel (Petition at 50 (asserting the uploaded photo (“*the content*”) would have been inserted and integrated into ... the club photo sharing feature” [the application-based information channel])); 2) the content is also ***integrated*** with the information associated with wireless networking functionality (Petition at 50 (asserting that “under the proposed combination, the photo would have been integrated with the ‘*information associated with said at least one wireless networking functionality of the mobile device*’.”))).

This is not what limitation 19[C] requires. Again, limitation 19[C] requires the content and the information associated with wireless networking functionality are ***both integrated*** into the application-based information channel. Limitation 19[C] says nothing about inserting. Furthermore, limitation 19[C] does not require the content and the information associated with wireless networking functionality to

be integrated with one another; instead, as shown above, limitation 19[C] requires the content and the information are integrated into the application-based information channel.

Petitioners' confusion continues with limitation 19[D], which requires "*inserting* other content ... into the ... application-based information channel." The Petition states that limitation 19[D] "is substantially identical to limitation 1[E]" and is "obvious for the same reasons." Petition at 52. While limitation 19[D] requires "inserting other content," limitation 1[E], however, says nothing about inserting. Indeed, it makes no sense that content (i.e., photos) provided by other club members ("*the additional content*") would have been *inserted* into the same group photo album as required by limitation 19[D] in the same way as described for limitation 1[E]. Petition at 39-40. Petitioners' argument does not address how content can be both inserted and integrated in one step (as Petitioners suggest regarding limitation 19[C], even though limitation 19[C] says nothing about inserting), but then additional content is just inserted in a subsequent step (limitation 19[D]). Thus, Petitioners' reliance on their arguments for limitation 1[E] to establish limitation 19[D] fails.

Moreover, none of the cited references state *where* any of the integration occurs, other than on a message board. The '039 Patent is clear that the integration occurs on a server: the "services integration server **39 controls the integration of**

information associated with these wireless networking functionalities with the content of the mobile site generated via the content management site.” Ex.1001, 9:42-45 (emphasis added). It is important to note that the claimed “content” comes from the *users*. *Id.*, Claim 1. “Information associated with wireless networking functionality,” however, is not user content, but is generated from *network services*, such as SMS, MMS, billing, etc. as described above.⁷ Petitioners fail to address this distinction. The Petition never points to any element in Neibauer, Cheng, Squibbs, Ausems, Bandera, or Harvey, that performs the integration function of server 39 or that merges SMS, MMS, or other service data into displayed content. Neibauer’s club “message board” is simply a database of user posts—an insertion site. Instead,

⁷ The ‘039 specification is clear that the user content and the wireless network information are not the same:

“Advantageously, the information content of a given mobile site ***generated in the system*** 10 may be configured ***so as to integrate therewith information*** associated with at least one wireless networking functionality of the wireless network 12. This information may be determinable based at least in part on one or more parameters associated with the above-noted mobile information channels or M-channels. Examples of such information include information specifying at least one messaging action implementable over the wireless network, information specifying at least one collaboration action implementable over the wireless network, and information specifying at least one location-based service action implementable over the wireless network. Other types of information associated with wireless networking functionalities may also or alternatively be used.”

Ex.1001, 5:51-65.

the Petition re-labels ordinary postings on a club message board as *integration* and thus fails to meet the claim limitation.

C. The Petition Relies on Improper Combinations Contrary to Federal Circuit Law

In addition to the deficiencies identified above, Petitioners' obviousness arguments fail because they rely on combining fundamentally distinct embodiments within Neibauer and improperly merging disparate references (or disparate subject matter in a given reference) without a sufficient articulated rationale. Established precedent forbids combining features from unrelated embodiments or references absent a clear teaching or suggestion to do so. *See In re Wright*, 569 F.2d 1124, 1127 (CCPA 1977); *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1354 (Fed. Cir. 2013). Petitioners have failed to establish any such clear teaching or suggestion to combine the disparate embodiments in Neibauer or Neibauer with the other references.

1. Grounds 1-4: Reliance on Neibauer and Cheng

a) Yahoo! Clubs + Yahoo! Mobile: Distinct Purposes

Neibauer consists of 21 distinct chapters, each describing various features of Yahoo! and the uses of its services and tools, including use of e-mail, chat, and news, as well as personalization of a user's browser, ability to connect with people, and also find information. Petitioners attempt to combine completely different aspects of Neibauer without meeting their burden to justify such a combination. Petitioners rely on Chapter 21, specifically pointing to Yahoo! Clubs, suggesting that the

Yahoo! Clubs feature discloses aspects of the claimed methods and systems of managing information content of the '039 Patent. Petition at 12. Petitioners rely on Yahoo! Clubs as disclosing “creating web-based communities (‘clubs’) for users to share information through photo sharing and other features” in which Yahoo! Clubs provides “a photo sharing feature that allows a club member to select a photo to upload and share with club members”. Petition at 10. However, the Yahoo! Clubs disclosure (i.e., pages 473-483) does not contain any teaching or suggestion to use mobile devices.

Petitioners attempt to remedy this lack of disclosure by pointing to a completely separate chapter of Neibauer, specifically Chapter 7, which describes the Yahoo! Mobile and Yahoo! To Go features. Petition at 12. Chapter 7 (pages 166 through 180), provides detailed descriptions of the Yahoo! Mobile and Yahoo! To Go features, specifically providing various summaries and descriptions of the benefits of these features and guided walkthrough of how a user can set up their mobile device (e.g., pagers, cell phones, web phones, and personal digital assistants (PDAs)) and what is available as far as content on Yahoo! Mobile and Yahoo! To Go.

While Petitioners acknowledge “Neibauer does not expressly disclose the Yahoo! Clubs feature was one of the Yahoo! features that could be made accessible via mobile devices” (Petition at 12), Petitioners argue that “it would have been

obvious to extend the mobile device functionality in Neibauer to cover that feature, in order to allow user-created clubs to be accessed by users via mobile devices...as this would have been viewed as a logical (and obvious) extension of the existing mobile features described in Neibauer.” *See* Petition at 12; Ex.1002, ¶¶96-97.

Petitioners rely on improper and unsupported speculation that Yahoo! Clubs could have been adapted for mobile use, but Neibauer is completely silent as to the availability of the Yahoo! Clubs feature on a user’s mobile device or even how one would implement the Yahoo! Clubs feature for mobile device usage. Ex.2037, ¶39. Rather, Neibauer describes the use of the Yahoo! Mobile and Yahoo! To Go features for allowing a user to use basic Yahoo! services, such as mail and messenger services, calendar services, receiving preferred mobile alerts (i.e., stock quotes, weather alerts, horoscope alerts, etc.). Ex.2037, ¶38.

In particular, Yahoo! screenshots included in Neibauer show that none of the user-interactive features discussed in Chapter 21 regarding Yahoo! Clubs were available for the types of devices described in Chapter 7. Ex.2037, ¶38. Indeed, Chapter 7 describes the provision of very limited functionality for handheld mobile devices, specifically “pagers, cell phones, Web phones, and personal digital assistants (PDAs).” Neibauer at 156. For example, Neibauer describes a briefcase function that allows remote access to files, but Yahoo only provided 10 MB of free storage. *See, e.g.*, Neibauer at 156. The major feature of Yahoo! Briefcase was the

ability to remotely access file sizes greater than 1.4MB, the size of a single floppy disk. *Id.*

For Yahoo! Mobile and Yahoo! To Go, support existed for only a limited number of device types: “pagers, cell phone, Web phones, and Personal digital assistants (PDAs).” Neibauer at 166. For example, for a PDA, Yahoo! To Go supports the following features:

My PDA

The Yahoo! On Your PDA option on Yahoo! To Go lets you set up to browse Yahoo! using a custom menu from the Web browser on your PDA. Clicking My PDA lets you configure Yahoo! for your PDA and see some sample PDA pages so you can get an idea how you can use Yahoo! to your best advantage, as shown here.



Note

To set up Yahoo! on your PDA, you'll need a PDA with Palm Organizer, a modem, and a browser.

To set up Yahoo! for your PDA, follow these steps:

1. Click My PDA and then click Continue to display the options shown in Figure 7-14.
2. Enter a device name.
3. Select the device type: Palm III, Palm IV, Palm VII, Visor, pdQ Smartphone, Windows CE, Apple Newton, or Other.
4. Select the browser type: HandWeb, ProxiWeb, pdQ Browser, Avantgo, Qbrowser, or Other.
5. Select the modem type: Minstrel, Palm (clip-on), GSM Phone, or Other.
6. Select either Monochrome or Color.
7. Click Submit.

Neibauer at 171. PDAs had very limited functionality, especially as compared to more recent devices. The ability of PDAs to display web pages was highly limited and the features supported by Yahoo were similarly limited. *Id.* Finally, these devices did not contain the functionality, like GPS, that would have been necessary

to support the kinds of combinations alleged by Petitioners, and also suffered from significant hardware constraints. Ex.2037, ¶¶41, 42.

Neibauer Figure 7-15 (shown below) illustrates functionality available on Yahoo! Mobile. None of Yahoo! Clubs, Message Boards, or Photo Albums, which Petitioners extensively rely on in their invalidity theories, were available on a PDA through Yahoo! Mobile and Yahoo! To Go. These functionalities of Yahoo! Clubs, Message Boards, or Photo Albums described in Chapter 21 are media-rich, user interactive features that are outside the capabilities of the handheld mobile devices described in Neibauer (“pagers, cell phones, Web phones, and PDAs”) available at the time and outlined in Chapter 7. Ex.2037, ¶44.

The screenshot shows the Yahoo! Mobile website interface for personalizing content. At the top, the 'YAHOO! MOBILE' logo is on the left, and a welcome message 'Welcome, Barbara! Yahoo! - My Yahoo! - Help' is on the right. Below the logo is a section titled 'Personalize Content for Your PDA'. This section contains instructions: 'Add or Delete content on this page by checking or un-checking the boxes. Be sure to click **Finished** when you're done.' To the right of the instructions are two buttons: 'Change Layout' and 'Finished'. Below this is a section titled 'Choose Your Content'. It contains two columns of checkboxes, all of which are checked. The left column includes: Address Book, Calendar, Lodging, Mail, and Movie Showtimes. The right column includes: People Search, Ski Reports, Sports, Stock Quotes, and Weather. At the bottom of the form is a section titled 'You're Now Ready to Browse Yahoo! on your PDA!'. Below this title is a paragraph of text: 'Click **Finished** and go to: <http://mobile.yahoo.com/home> from your PDA to see your personalized Yahoo! start page.'

FIGURE 7-15 Adding content to your PDA Yahoo! menu

Indeed, the various Clubs pages in Neibauer that Petitioners rely on clearly show the resource-intensive nature of Yahoo! Clubs, including: 1) the screen size required to display the interface; 2) the memory required to receive the website code and render the page on the screen; and 3) the bandwidth required to receive the website code in a time frame the user would find acceptable. Ex.2037, ¶44.

Accordingly, a POSITA would not have been motivated to combine these two distinct aspects of Neibauer, as they are provided in completely separate and distinct portions of the disclosure (Yahoo! Mobile and Yahoo! To Go services provided in Chapter 7 while Yahoo! Clubs provided in Chapter 21), and there was no contemplation of implementing the Yahoo! Clubs feature via mobile devices. Furthermore, even assuming a POSITA would have been motivated to provide support for Yahoo! Clubs on a handheld mobile device, it would have the highly simplified interface consistent with what is shown for basic web features like stock quotes and thus a POSITA would not have expected such an interface to include support for multimedia, including viewing, posting, and sharing photos. Ex.2037, ¶48.

In addition, to a POSITA, it would be reasonable that the reason Yahoo! did not offer more services in Yahoo! Mobile and Yahoo! To Go, was because, for example, each type of device required specific configuration and the common types of handheld mobile devices would not support the more advanced features offered

by Yahoo!. This understanding would have been consistent with what a POSITA would have understood about handheld mobile device technology available in the early 2000s: screens were small, memory was limited, and wireless technologies available at the time had very slow transfer rates. Ex.2037, ¶¶49, 50. Speculation cannot substitute for disclosure.

b) Yahoo! Clubs + Cheng: Technical Incompatibility

All of Petitioners' grounds rest on the combination of Neibauer's disclosure of Yahoo! Clubs with Cheng's proxy server. Petition at 7-8. Petitioners argue that a POSITA would have been motivated to make this combination in order to allow a user to make use of the relied-on functionality in Yahoo! Clubs on a mobile device. Petition at 9-18.

However, Petitioners' entire argument is based on the misconception that mobile devices available at the time of the invention were capable of receiving and displaying complex websites such as those shown in Neibauer, much less capable of supporting the internal functionality needed for the interactive features of Clubs on which Petitioner relies. Cheng's methods and systems would not have solved the deficiencies of Neibauer discussed herein.

Cheng discloses a go-between proxy server that could be used to attempt to convert conventional web sites for viewing on the typical handheld mobile devices of the time, which had small screens, limited memory, and received data over low-

bandwidth connections. Ex.2037, ¶55. However, Cheng's system only discloses simplistic, one-way functionality: a mobile device sends a request for a web page to a proxy server; the proxy server forwards that request to an actual web server (or retrieves the page from the proxy server's internal cache if it had been previously retrieved from the web server and stored in the cache), applies the appropriate set of SW-Transforms to the web page based on the capabilities of the requesting mobile device; and sends the translated page to the mobile device. Ex.2037, ¶90.

As such, a POSITA also would understand that, even if they were to engage in the level of experimentation needed to adapt Yahoo! Clubs to an available mobile device with all the required functionality intact, it would not matter: the POSITA still would not have had a reasonable expectation of success in combining Neibauer and Cheng because Yahoo! Clubs requires two-way interaction and transfer of content (e.g., both viewing photos in an album and uploading new photos to the album), while Cheng's proxy server is only configured to handle content delivery in a single, downstream direction. Modifying Cheng's proxy server to support upstream content delivery would be well outside the capabilities of a POSITA. Ex.2037, ¶94.

Cheng's method starts when the proxy server receives a request from a mobile device to view a particular web page, and the proxy server subsequently extracts images and text data from the requested web page and re-formats the data so that it

can be viewed properly by the mobile device that made the initial request. Ex.1005, Abstract. Cheng contemplates a type of universal website translation service that operates in the form of a go-between proxy server for one-way conversion of conventional websites into a format viewable on mobile devices at the time. In particular, Cheng's proxy server purports to operate by receiving (or retrieving a cached copy of) a website, and then applying an operator-specified series of transformations to the website content that Cheng calls "SW-Transforms," which could be specified on a global basis (for all recipients) or on a device-specific basis (based on a recipient's specific mobile device). *See*, Ex.1005 at 4:56-5:10, cols. 17-22; Ex.2037, ¶57. Cheng's SW-Transforms include the capability of adding, replacing, or removing HTML tags and/or text from the source web page in order to attempt to format it for the destination mobile device. *Id.* Ex.2037, ¶¶56, 57.

Cheng discloses SW-Transforms that convert, downscale, and/or fully delete content from the original website so that at least some of it could be displayed on a mobile device. Most notably, Cheng discloses SW-Transforms that completely remove certain HTML tags and content, giving as a specific example the removal of client-side scripting:

RemoveTagAndContent

Description: This rule tells the conversion engine to remove a specific tag, and the information that appears within the tags, from a Web site or Web content.

Syntax: sw-transform “Mozilla/3.0
(compatible; HandHTTP 1.1
” RemoveTagAndContent:TAG

Example: To remove the SCRIPT tag so that all of the client-side script on a specific Web site or page is removed, the following may be entered:
sw-transform “Mozilla/3.0
(compatible; HandHTTP 1.1
”SCRIPT

Note:

The RemoveTagandContent tag will not be completely effective if the Web content being transformed is poorly formatted (e.g., there is an open tag without a close tag). The conversion engine will attempt to clean up the HTML, but may not be completely effective. Also, this tag does not have any meaning for empty tags.

Cheng at 19:42-60. Thus, if this SW-Transform were applied to a website that relied on client-side scripting, that **website functionality would not work properly on the mobile device** because the SW-Transform would have removed the scripting. Ex.2037, ¶59.

Additionally, Cheng’s SW-Transforms, by explicitly removing embedded JavaScript and applets, would inherently disable client-side interactivity essential for operations like form validation, dynamic content updates, or responsive navigation elements. The removal of these scripts substantially degrades user experience and interactivity. Indeed, a significant proportion of the functionality offered by Yahoo! Clubs—such as real-time member status updates or interactive photo-upload tools—

would likely rely on such client-side scripting mechanisms, making them fundamentally incompatible with the transformation methods described in Cheng. Ex.2037, ¶60.

Furthermore, Cheng envisions content delivery in only a one-way data transfer: from the server hosting the requested website, through the proxy server translator, and to the client mobile device. Ex.2037, ¶63. But the independent claims of the '039 Patent recite two-way, interactive functionality, where the mobile device not only receives but sends content. Cheng's SW-Transforms scheme, particularly the RemoveTagAndContent used to strip functionality such as scripts from web pages for incapable mobile, shows that Cheng's system was not a panacea, but rather might work for certain combinations of website content and mobile devices and might work poorly or not at all for other combinations. Thus, it is impossible for a POSITA to know how Yahoo! coded its Clubs and related web pages—and thus whether and to what extent Cheng's translation system would have allowed successful operation on a mobile device—from the minimal disclosure in Neibauer. Ex.2037, ¶92.

Absent any such evidence that a POSITA actually *could* have achieved such a combination, Petitioner's arguments that a POSITA *would* have sought to do so amount to nothing more than anachronistic, impermissible hindsight.

Accordingly, for the foregoing reasons, Petitioners fail to demonstrate that a POSITA would have been motivated to combine the at least Neibauer and Cheng, such combination cited and relied upon references across Grounds 1–4. The combinations proposed are speculative, hindsight-driven, and incompatible with the teachings of the prior art.

IV. CONCLUSION

Based on the deficiencies identified above, Petitioners have not shown that they have a reasonable likelihood of prevailing on any of the proposed grounds. The Board should decline to institute an IPR proceeding based on the Petition.

Date: June 11, 2025

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), the undersigned hereby certifies that the foregoing Patent Owner's Preliminary Response to Petition for *Inter Partes* Review contains 10,175 words using the word count feature of Microsoft Word.

Date: June 11, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on June 11, 2025, I caused a true and correct copy of the foregoing Patent Owner's Preliminary Response to Petition for *Inter Partes* Review to be served via electronic mail upon the following attorneys of record for the Petitioners:

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