

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

IPR2025-00537
U.S. Patent No. 8,825,801

PATENT OWNER'S PRELIMINARY RESPONSE

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

TABLE OF CONTENTS

I.	INTRODUCTION	1
A.	Summary	1
B.	Prior Art and Asserted Grounds.....	2
C.	The '801 Patent	3
II.	PETITIONERS HAVE NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CLAIM CHALLENGED IN GROUND 1 OR 2	4
A.	Relevant Legal Principles.....	4
B.	Ground 1: Claims 1-25 Are Not Obvious Over Neibauer in view of Miller, Cheng, and Squibbs.....	7
1.	Petitioners take inconsistent positions on “application-based information channel”	7
2.	Neibauer, Miller, Cheng, and Squibbs, either alone or in combination, do not disclose “integrating/integrate into the mobile information channel information associated with at least one wireless networking functionality” (Limitations 1[F] / 23[H] / 25[H]).	8
a)	Petitioners fail to distinguish “inserting” and “integrating”	9
b)	Petitioners fail to identify the integration into the mobile information channel “information associated with at least one wireless networking functionality of said at least one wireless network”	12
C.	Ground 2: Claims 1-25 Are Not Obvious Over Neibauer in view of Miller, Cheng, Squibbs, and Harvey	15

1. Neibauer, Miller, Cheng, Squibbs, and Harvey, either alone or in combination, do not distinguish “inserting” and “integrating,” (Limitations 1[C] / 1[E] / 1[F], 23[E] / 23[G] / 23[H], 25[E] / 25[G] / 25[H]).	16
2. Neibauer, Miller, Cheng, and Squibbs and Harvey, either alone or in combination, do not identify the integration of “information associated with at least one wireless networking functionality of said at least one wireless network,” (Limitations 1[F] / 23[H] / 25[H]).	17
D. The Petition Relies on Improper Combinations Contrary to Federal Circuit Law	19
1. Grounds 1-2: Reliance on Neibauer and Cheng	19
a) Yahoo! Clubs + Yahoo! Mobile: Distinct Purposes	19
b) Yahoo! Clubs + Cheng: Technical Incompatibility	26
c) No reasonable expectation of success	32
III. CONCLUSION	33

TABLE OF AUTHORITIES

Cases	Page(s)
<i>Abiomed, Inc. v. Maquet Cardiovascular, LLC</i> , IPR2017-01204, Paper 8 (P.T.A.B. Oct. 23, 2017).....	20
<i>Apple Inc. v. Arigna Technology</i> , IPR2022-01037, Paper 9 (P.T.A.B. Dec. 2, 2022)	20
<i>Cisco Sys., Inc. v. C-Cation Tech, LLC</i> , IPR2014-00454, Paper 12 (P.T.A.B. Aug. 29, 2014).....	4
<i>Eli Lilly & Co v. Teva Pharm. Int’l GmbH</i> , 8 F.4 th 1331 (Fed. Cir. 2021)	6
<i>Enzo Biochem, Inc. v. Gen-Probe Inc.</i> , 424 F.3d 1276 (Fed. Cir. 2005)	33
<i>Google LLC v. Makor Issues & Rights Ltd.</i> , IPR2017-00815, Paper 31 (P.T.A.B. Aug. 10, 2018).....	8
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966).....	4
<i>Harmonic Inc. v Avid Tech., Inc.</i> , 815 F.3d 1356 (Fed. Cir. 2016)	4
<i>In re Baxter Int’l, Inc.</i> , 678 F.3d 1357 (Fed. Cir. 2012)	4
<i>In re Magnum Oil Tools Int’l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016)	5, 6, 32
<i>In re NuVasive, Inc.</i> , 842 F.3d 1376 (Fed. Cir. 2016)	5
<i>In re Stepan Co.</i> , 868 F.3d 1342 (Fed. Cir. 2017)	20

<i>In re Wright</i> , 569 F.2d 1124 (CCPA 1977)	19
<i>Intel Corporation v. Tela Innovations</i> , IPR2019-01521, Paper 65 (P.T.A.B. Mar. 9, 2021)	20
<i>Interconnect Plan. Corp. v. Feil</i> , 774 F.2d 1132 (Fed. Cir. 1985)	5
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007)	5
<i>Meta Platforms, Inc. v. Eight kHz, LLC</i> , IPR2023-01003, Paper 9 (P.T.A.B. Jan. 9, 2024)	10
<i>Meta Platforms, Inc. v. Eight kHz, LLC</i> , IPR2023-01004, Paper 9 (P.T.A.B. Jan. 9, 2024)	8
<i>Pfizer, Inc. v. Apotex, Inc.</i> , 480 F.3d 1348 (Fed. Cir. 2007)	6
<i>Plantronics, Inc. v. Aliph, Inc.</i> , 724 F.3d 1343 (Fed. Cir. 2013)	19
<i>Procter & Gamble Co. v. Teva Pharms. USA, Inc.</i> , 566 F.3d 989 (Fed. Cir. 2009)	6
<i>Reactive Surfaces Ltd. v. Toyota Motor Corp.</i> , IPR2019-00867, Paper 6 (P.T.A.B. Sep.18, 2019)	20
<i>Samsung Elecs. Co. v. Elm 3DS Innovations, LLC</i> , 925 F.3d 1373 (Fed. Cir. 2019)	6
<i>Samsung SDI Co. v. Ube Industries, Inc.</i> , IPR2017-02116, Paper 8 (P.T.A.B. Mar. 12, 2018)	20
<i>Unique Concepts, Inc. v. Brown</i> , 939 F.2d 1558 (Fed. Cir. 1991)	10
<i>W.L. Gore & Associates, Inc. v. Garlock, Inc.</i> , 721 F.2d 1540 (Fed. Cir. 1983)	5

<i>Wasica Fin. GmbH v. Cont'l Auto. Sys.</i> , 853 F.3d 1272 (Fed. Cir. 2017)	33
--	----

Statutes

35 U.S.C. § 103	2, 4, 7
35 U.S.C. § 313	1

Other Authorities

<i>Consolidated Trial Practice Guide</i> , U.S. Patent & Trademark Office (2019)	4
---	---

Regulations

37 C.F.R. § 42.107	1
37 C.F.R. § 42.6	33
37 C.F.R. § 42.65	33

EXHIBIT LIST

Ex.	Description
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 IPR2025-00538 (Feb. 3, 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 IPR2024-00247 (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 ‘801 and ‘5801 Patents
2010	Reserved
2011	Examples of verbatim copy-pasting from Meta-MDT-IPRs by Petitioners
2012	Reserved
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)

Ex.	Description
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 sharing with Patent Owner their proposed <i>Sotera</i> stipulation (April 21, 2025)
2031	Reserved
2032	Petitioners' proposed <i>Sotera</i> stipulation for '537 and '538 IPRs (April 21, 2025)
2033	Petitioners' claim chart against '801 Patent based on the Yahoo! System art (January 31, 2025)
2034	Petition for <i>Inter Partes</i> Review in IPR2024-00247 (Dec. 6, 2023)
2035	Summary of verbatim (or nearly verbatim) matches between the '537 Petition to the Houh Declaration (Ex.1002)
2036	Reserved
2037	U.S. Patent Application Publication 2002/0120757 ("Sutherland")
2038	Order of the EDTX court for expedited motion practice

Ex.	Description
2039	E-Mail from Petitioners providing Casio America, Inc.’s declarations certifying business records in response to Petitioners’ subpoena in the EDTX-Litigation (May 9, 2025)
2040	Petitioners’ expert declaration from the ‘535 IPR.
2041	Petitioners’ expert declaration from the ‘541 IPR.
2042	Patent Owner’s and Meta’s February 21, 2025 joint email to the Board regarding the settlement of the MDT-Meta-Litigation and Meta-MDT-IPRs
2043	Prosecution history of the ‘039 Patent
2044	Reserved
2045	Reserved
2046	U.S. Patent Application Publication 2002/0035609 (“Lessard”)
2047	Redacted version of Samsung’s Motion for Relief from Protective Order filed in the EDTX-Litigation (May 29, 2025)
2048	Declaration of Mahdi Eslamimehr for IPR2025-00537 of U.S. Patent No. 8,825,801

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. 8,825,801 (the “’801 Patent”), filed by Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioners”), challenging claims 1-25 (the “Challenged Claims”) of the ’801 Patent. Paper 4 (“’537 IPR Petition” or “Petition”). Institution should be denied because Petitioners fail to meet their burden to show a reasonable likelihood they would prevail with respect to at least one claim challenged in the Petition.

I. INTRODUCTION

A. Summary

Petitioners have taken inconsistent positions regarding Neibauer’s alleged disclosure of a “mobile information channel.” Petitioners have also failed to establish that the prior art discloses: “integrating/integrate into the mobile information channel information associated with at least one wireless networking functionality” because Petitioners fail to distinguish “inserting” and “integrating” and fail to identify the integration into the mobile information channel “information associated with at least one wireless networking functionality of said at least one wireless network” as required in all independent claims. These are two independent reasons for why an IPR trial should not be instituted.

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 for at least two distinct reasons. First, Petitioners have failed to provide a reasoned analysis that would have motivated a POSITA to combine the various and distinct chapters of Neibauer together, much less combine Neibauer and Cheng. Ex.2048, ¶¶53, 57, 61, 68. Second, Petitioners have also failed to provide any meaningful discussion of a reasonable expectation of success, which is a separate and distinct point of analysis in any obviousness inquiry. Ex.2048, ¶¶11-12.

Because Petitioners have not met their burden, institution of this IPR should be denied.

B. 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	1-25	Neibauer, Miller, Cheng, and Squibbs
2	1-25	Ground 1 + Harvey

Grounds 1-2 challenge independent claims 1, 22, 23, and 25, with the references Neibauer, Miller, Cheng, and Squibbs being common to the Challenged Claims.

C. The '801 Patent

The '801 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 September 2, 2014. Ex.1001 (face). Ex.2048, ¶25.

In one embodiment, the '801 Patent describes an innovative method that enables a mobile device user to transfer content from the mobile device to a server for insertion into a mobile information channel so that the mobile device user can interact with one or more additional users. Ex.2048, ¶26.

The '801 Patent also describes transferring information associated with at least one wireless networking functionality of a wireless network from the mobile device to the server. Ex.2048, ¶27.

The content and the information associated with the at least one wireless networking functionality of the wireless network is integrated into the mobile information channel. *See, e.g.*, Ex.1001, 5:63-6:10. Ex.2048, ¶28.

The '801 Patent also enables other content from at least one of the additional users to be inserted into the mobile information channel. Ex.2048, ¶29.

II. PETITIONERS HAVE NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CLAIM CHALLENGED IN GROUND 1 OR 2

Petitioners assert two obviousness grounds of unpatentability. Petition, 2. For this Response, the Board need only consider the validity of independent claims 1, 22, 23, and 25. As discussed below, MDT and its expert Mahdi Eslamimehr, Ph.D (Ex.2048) demonstrate that the Petition fails to establish a reasonable likelihood that Petitioners will prevail and thus an IPR trial therefore should not be instituted.

A. Relevant Legal Principles

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 PTAB Consolidated Trial Practice Guide ("CTPG") advises that a petitioner must "focus on *concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence* of record." CTPG, 39. It is Petitioners' 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, 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). In addition, the references must be viewed without the benefit of hindsight vision afforded by the claimed invention. *See, e.g., W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983); *Interconnect Plan. Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985) (“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”).

For a combination of prior art references to render a claimed invention obvious, at the time the invention was made a POSITA must have (1) been motivated to combine the teachings of the prior art references and (2) had a reasonable expectation of success in making such combination. *See, e.g., Samsung Elecs. Co. v.*

Elm 3DS Innovations, LLC, 925 F.3d 1373, 1380-81 (Fed. Cir. 2019) (holding that a patent challenger must show both a motivation to combine and a reasonable expectation of success; affirming Board’s finding of lack of reasonable expectation of success despite that the references were in the “same technological field”); *Eli Lilly & Co v. Teva Pharm. Int’l GmbH*, 8 F.4th 1331, 1344 (Fed. Cir. 2021) (“[W]e must first emphasize the clear distinction in our case law between a patent challenger’s burden to prove that a skilled artisan would have been motivated to combine prior art references and the additional requirement that the patent challenger also prove that the skilled artisan would have had a reasonable expectation of successfully achieving the claimed invention from the combination.”); *see also Procter & Gamble Co. v. Teva Pharms. USA, Inc.*, 566 F.3d 989, 994 (Fed. Cir. 2009) (“A party seeking to invalidate a patent based on obviousness must demonstrate ‘by clear and convincing evidence that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.’” (quoting *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1361 (Fed. Cir. 2007))). It is Petitioner’s burden to demonstrate **both** 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. Ground 1: Claims 1-25 Are Not Obvious Over Neibauer in view of Miller, Cheng, and Squibbs

Ground 1 alleges independent claims 1, 22, 23, and 25 are unpatentable over Neibauer, in view of Miller, Cheng, and Squibbs under 35 U.S.C. §103. Not only do Petitioners present improper prior art combinations, mixing references and embodiments without explanation, but also their stated motivation for the combination is nonsensical and they provide no support that a POSITA would have a reasonable expectation of success. Further, even considering Petitioners' proposed combination of the references, the asserted combinations fail to teach or suggest explicit limitations.

1. Petitioners take inconsistent positions on “application-based information channel”

As a threshold matter, Petitioners and their expert take inconsistent positions across Petitioners' multiple IPRs, pointing to the same feature in Neibauer—the club photo sharing feature—for the “mobile information channel” in this Petition, the “application-based information channel” in the ‘535-IPR Petition, and the “web-based shared information channel” in the ‘541-IPR Petition. More specifically, to support this Petition, Petitioners' expert states that the club photo-sharing feature is the claimed “mobile information channel.” Ex.1002, ¶¶109, 130, 134. In the ‘535-IPR Petition, Petitioners' expert testimony stated that “[t]he club photo sharing feature is an ‘application-based information channel’” because the club is an

application. Ex.2040, ¶¶144; 139. In the ‘541-IPR, the expert argued that the very same feature is a “web-based shared information channel.” Ex.2041, ¶¶75, 123. There, the expert based his conclusion on the notion that the club is a webpage accessible from a website. *Id.*, ¶104.

Neither Petitioners nor their expert provide any explanation as to how these three different claim terms can be met by the same club photo sharing feature in Neibauer. **The Board should resolve this double-speak against Petitioners on the 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).

2. **Neibauer, Miller, Cheng, and Squibbs, either alone or in combination, do not disclose “integrating/integrate into the mobile information channel information associated with at least one wireless networking functionality” (Limitations 1[F] / 23[H] / 25[H]).**

Regarding Limitation 1[F], Petitioners contend that “Neibauer, alone or in combination with Cheng, renders obvious” this claim limitation. Petition, 33.

a) Petitioners fail to distinguish “inserting” and “integrating”

The Petition’s obviousness case rises or falls on the premise that “inserting” content and “integrating” wireless-network information are interchangeable. Petition, 34-35. Ex.2048, ¶74. The intrinsic record teaches the opposite. At a minimum, these are separate claim limitations. Petitioner’s own language shows that it simply collapses the two limitations—1[C]/1[E] versus 1[F]—into the same bucket. *Id.* Because the cited art (and the Petition’s mapping) addresses only **insertion** by end-users, not **integration**, Ground 1 fails on its face. Ex.2048, ¶69.

The ’801 specification draws a distinction between “inserting” and “integrating.” Ex.2048, ¶79. For example, the specification describes several exemplary methods, including “**inserting** content provided by the first user into the mobile information channel, . . . **inserting** at least a portion of the additional content into the mobile information channel, and **integrating** into the mobile information channel information associated with at least one wireless networking functionality.” Ex.1001, 2:20-28. This distinction carries over to claim 1, which recites this same language. Ex.2048, ¶71.

However, Petitioners blur this distinction by conflating the two terms. The Petition states limitations 1[E] and 1[D] are “largely redundant of 1[C].” Petition, 30, 31. For limitation 1[E], the Petition explains that this is because “the content provided by other club members (*“the additional content”*) would also have been

inserted into the club message board, club photo sharing feature, or club chat, in the same way.” Petition, 33. This is sharp practice. *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1563 (Fed. Cir. 1991) (“[O]ur interpretation [should] give[] full effect to the recitation of two distinct elements in the claimed structure.”); *Meta Platforms, Inc. v. Eight kHz, LLC*, IPR2023-01003, Paper 9, 31-32 (P.T.A.B. Jan. 9, 2024) (“At this stage, we question whether Petitioner’s approach of using its analysis of limitation 1[B] as a shorthand for ten other allegedly ‘similar’ limitations that use different language and pertain to different steps, without any further explanation, is sufficient to meet its burden.”).

Worse yet, for limitation 1[F], Petitioners simply state “[a]s shown in the discussion of limitations 1[C]-1[E], any other club member can contribute additional new messages, photos and chat messages for the club message board, club photo sharing feature, and private chat (‘the mobile information channel’), respectively.” Petition, 34. Petitioners attempt to rewrite the claim language by stating “[t]his **additional information** is associated with a ‘messaging action’ and ‘collaboration action’ because it provides **messaging content** and makes that content available to the founder and other members, allowing them to collaborate on topics of interest.” *Id.* However, *under Petitioners’ argument, this is exactly the same information (i.e. content) as the inserting step* described in 1[E] and 1[C], and thus is *not* additional information; thus, Petitioners’ argument makes no sense. It is also

incorrect because term 1[F] requires “*integrating into the mobile information channel **information** associated with at least one wireless networking functionality of said at least one wireless network.*”. Petitioners’ argument addresses none of this information—it merely repeats the “insertion of content” step, echoing their expert’s conclusory views. Ex.2048, ¶¶77-78.

Moreover, none of the cited references state *where* any of the integration occurs, other than on a message board. The ‘801 Patent is clear: 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, 9:53-56, emphasis added; Ex.2048, ¶¶79-80. It is important to note that the claimed “content” comes from the *users* (*Id.*, Claim 1); -however- “information associated with wireless networking functionality” is not user content, but is generated from *network services*, such as SMS, MMS, billing, etc.¹ See Ex.1001, 9:48-50; Ex.2048, ¶79. Petitioners fail to make this distinction.

¹ The ‘801 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

Ex.2048, ¶81. The Petition never points to any element in Neibauer, Miller, Cheng, or Squibbs 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. Ex.2048, ¶81. Instead, the Petition re-labels ordinary postings on a club message board as *integration*, which is ineffective.

b) Petitioners fail to identify the integration into the mobile information channel “information associated with at least one wireless networking functionality of said at least one wireless network”

Petitioners attempt to show this *integration* step by referring to Squibbs’ ability to determine the location of where a photograph was taken, stating “Squibbs explains that digital cameras that included Global Positioning System (GPS)

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, 5:63-6:10.

receivers were known in the art, as were systems that could display the location where the photo was taken on an electronic map.” Petition, 35, citing Squibbs ¶¶0003-0004. As established below, however, Squibbs does not meet limitation 1[F] because the image (content) and location information from Squibbs are already pre-packaged before any inclusion into a mobile information channel, and thus the information associated with at least one wireless networking functionality” is not integrated into the mobile information channel. Ex.2048, ¶¶87-89.

Squibbs discloses different ways to associate location data with an image, including a GPS-enabled camera—where the location data comes from the camera—and a cell phone that has both GPS and the capability of running a program to determine location—where the location data comes from the cell phone. Ex.2048, ¶83. In all methods disclosed by Squibbs, however, the location data is associated with the image before integration into the mobile information channel. Ex.2048, ¶83. In Squibbs, attaching location data to a photo using *only* the camera requires the use of the camera’s internal GPS receiver. Ex.2048, ¶83. Squibbs also discloses a method where the camera transmits a photo to a cell phone via “an infrared or short-range radio link” between the camera and cell phone. Squibbs, [0096]; Ex.2048, ¶83. The cell phone then determines its location either by *the cell phone’s* GPS or “a program run by the data handling subsystem for requesting location information from a location server of the mobile radio infrastructure.” Ex.2048, ¶83. The cell

phone location data is then sent back to the camera via the aforementioned link, which is “operative to receive this location data and *associate it with the last-taken photo.*” Squibbs, [0099] (emphasis added); Ex.2048, 83.

Petitioners also point to Squibbs’ disclosure of a method “*uniting a digital photo and location data.*” Squibbs, [0101] (emphasis added). Ex.2048, ¶84. This is where a photo is sent from the camera to the cell phone through the link, and then from the cell phone “to a network store 43 of a service system . . . [which] . . . resides either in the mobile infrastructure or is accessible via the latter over a data-capable bearer Service. En route to the store, or upon loading into the store, location information 98 on the mobile phone is requested and *associated with the photo image data.*” Squibbs, [0101] (emphasis added); Ex.2048, ¶84.

In all examples in Squibbs cited by Petitioner, the act of associating (or integrating) the location data with the corresponding photo occurs either i) in the camera with its own GPS, ii) in the camera using location data from the cell phone via the link, or iii) in the data store. In any of these scenarios, a user will have a collection of photos associated with locations on the camera or in a data store. Ex.2048, ¶85.

However, this is not what is required by limitation 1[F]. Ex.2048, ¶86. Limitation 1[F] requires the “integration into the mobile information channel information . . . of *said* at least one wireless network.” The “said at least one wireless

network” refers to element 1[D], which requires actively receiving additional content from respective mobile devices. It does *not* require, as Petitioners allege, to insert images with the information *already integrated* into the mobile information channel. Per the claim language, the integration must occur *when the content is being inserted in the mobile information channel*. Ex.2048, ¶86. In Petitioner’s use of Squibbs, there is no indication that the network used to “reunite” the location data and the image data is the same (said) network used by additional mobile devices to send the additional content. Ex.2048, ¶88.

Because Squibbs *always* pairs location data with an image *before* any insertion into a multi-user mobile information channel—and because that pairing involves only the image owner’s cell phone and its own network resources—Squibbs’ disclosure cannot meet limitation 1[F]. Ex.2048, ¶89. The Petition’s attempt to treat pre-packaged **(image + location)** files as evidence of in-channel integration collapses the timing and network requirements that claim 1 expressly sets. Consequently, even when combined with Neibauer, Squibbs leaves the claim’s “integration into the mobile information channel” element unsatisfied. Ex.2048, ¶¶87-89.

C. Ground 2: Claims 1-25 Are Not Obvious Over Neibauer in view of Miller, Cheng, Squibbs, and Harvey

Ground 2 challenging independent claims 1, 22, 23, and 25 is “substantially the same as Ground 1 except that it adds Harvey ... to account for a construction of

‘mobile information channel’ proposed by Petitioner in litigation.” Petition, 66. This statement from Samsung’s Petition is incorrect as Samsung has not proposed any claim constructions of any terms in the EDTX-Litigation. Instead, it was Meta who proposed a construction in the MDT-Meta-Litigation of the term “mobile information channel” including a content management site. Petition, 66. There is no reason for Petitioners to burden the Board with Ground 2 based on Harvey here when neither Petitioners nor PO has ever adopted the construction proposed by Meta in the MDT-Meta-Litigation for “mobile information channel.” Indeed, in the 535-IPR, Petitioners agree that the Grounds including Harvey “need not be considered by the Director or the Board.” IPR2025-00535, Paper 9, 36. Regardless, even if considered, Harvey does not cure the deficiencies of Ground 1 shown in §III.B.1 above.

1. **Neibauer, Miller, Cheng, Squibbs, and Harvey, either alone or in combination, do not distinguish “inserting” and “integrating,” (Limitations 1[C] / 1[E] / 1[F], 23[E] / 23[G] / 23[H], 25[E] / 25[G] / 25[H]).**

Harvey does not distinguish “inserting” and “integrating.” Ex.2048, ¶¶90-91. Notably, Petitioners do not point to any disclosure in Harvey, nor do they provide any analysis for Harvey with respect to “inserting” or “integrating.” Thus, Harvey in combination with Neibauer, Miller, Cheng, and Squibbs fails to distinguish the claim terms “inserting” and “integrating.” Ex.2048, ¶¶90-91.

2. **Neibauer, Miller, Cheng, and Squibbs and Harvey, either alone or in combination, do not identify the integration of “information associated with at least one wireless networking functionality of said at least one wireless network,” (Limitations 1[F] / 23[H] / 25[H]).**

As shown above, the combination of Neibauer, Miller, Cheng, and Squibbs does not identify the integration of “information associated with at least one wireless networking functionality of said at least one wireless network.” Ex.2048, ¶¶90-91. Again, Harvey does not cure this deficiency of Ground 1. Petitioners do not point to any disclosure in Harvey, nor do they provide any analysis for Harvey with respect to the integration of “information associated with at least one wireless networking functionality of said at least one wireless network.” Ex.2048, ¶¶90-91.

Additionally, Harvey does not teach that content can be added to a community before it is “created” as Petitioners claim. Ex.2048, ¶¶92-94. 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.2048, ¶92. Petitioners suggest that the community that Harvey describes is the mobile 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.2048, ¶92. Thus, Harvey does not teach “the ability to add content to a community *before* the community is created.” Petition, 67-68. 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, 67 (citing Harvey, 4:28-30). Yet, Petitioners distort this by saying that "Harvey therefore discloses the ability to add content to a community *before* the community is created." Petition, 68.

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 "Harvey allows a community creator to author content for a community before the community is launched." Petition, 67 (emphasis in original); Ex.2048, ¶94. However, Petitioners' conclusion blurs the line between "launch" and "create": "Harvey therefore discloses the ability to add content to a community before the community is created." Petition, 68. The creation and subsequent launching of a given community are two separate actions. Ex.2048, ¶94. The addition of content to a given community occurs *during* the creation of the community, *not before* the creation of the community. Ex.2048, ¶94. 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.

Thus, Harvey in combination with Neibauer, Miller, Cheng, and Squibbs fails to disclose this claim limitation. Ex.2048, ¶¶90-91.

D. 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 1-2: 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. “When an obviousness argument relies on ‘combining multiple embodiments from a single reference, ... there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.” *Reactive Surfaces Ltd. v. Toyota Motor Corp.*, IPR2019-00867, Paper 6, 8 (P.T.A.B. Sep.18, 2019) (quoting *In re Stepan Co.*, 868 F.3d 1342, 1345-46 n.1 (Fed. Cir. 2017)); *see also Intel Corporation v. Tela Innovations*, IPR2019-01521, Paper 65, 25 (P.T.A.B. Mar. 9, 2021) (“It is not sufficient to demonstrate that each of the components in a challenged claim is known in the prior art; Petitioner must also explain why a POSITA would have combined the elements disclosed in the separate embodiments described in [a single reference].”); *Apple Inc. v. Arigna Technology*, IPR2022-01037, Paper 9, 20 (P.T.A.B. Dec. 2, 2022); *Samsung SDI Co. v. Ube Industries, Inc.*, IPR2017-02116, Paper 8, 21 (P.T.A.B. Mar. 12, 2018); *Abiomed, Inc. v. Maquet Cardiovascular, LLC*, IPR2017-01204, -01205, Paper 8, 8-12 (P.T.A.B. Oct. 23, 2017). Petitioners have not even attempted to make this showing.

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 ‘801 Patent. Petition, 9. Petitioners rely on Yahoo! Clubs as disclosing a system that “allows users to create

web-based communities for users to share information” in which Yahoo! Clubs provides “photo sharing and other features” and “the ability to access Yahoo! services via mobile devices.” Petition, 9. However, the Yahoo! Clubs disclosure (i.e., pages 473-483) does not contain any teaching or suggestion to use mobile devices. Ex.2048, ¶¶37-38.

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, 9, 19. Chapter 7 (pages 166 through 174), 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 that the Yahoo! Clubs feature was available on handhelds” (Petition, 19), Petitioners argue that “it would have been obvious over Neibauer alone to allow user-created clubs to be accessed by handheld devices disclosed elsewhere in Neibauer.” *See* Petition, 19-20; Ex.1002, ¶¶111, 155. Petitioners add that “[t]his would have been viewed as a

logical (and obvious) extension to the existing features described in Neibauer.”
Petition, 20; Ex.1002, ¶¶111, 155.

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.2048, ¶¶37-43. 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.2048, ¶¶40-42.

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.2048, ¶¶40, 43. 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, 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, 156; Ex.2048, ¶39. 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, 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.

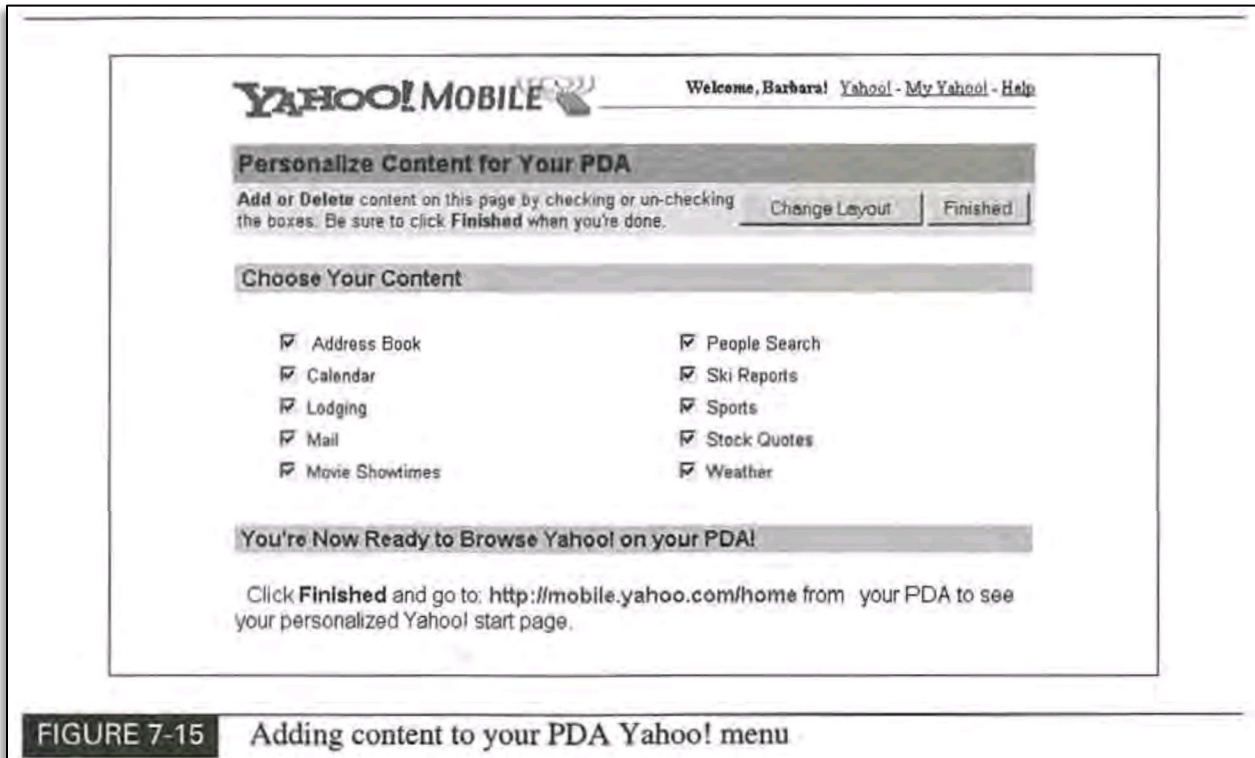
To set up Yahoo! for your PDA, follow these steps:

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, 171; Ex.2048, ¶¶40, 42. 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.2048, ¶¶43-44.

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. Ex.2048, ¶¶38, 43. 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.2048, ¶¶43-48.



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.2048, ¶¶46-49.

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. Ex.2048, ¶47. 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.2048, ¶¶43, 46-47.

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.2048, ¶¶49-52. 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, 9-10. 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, 25; Ex.2048, ¶96.

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 Petitioners rely. Cheng's methods and systems would not have solved the deficiencies of Neibauer discussed herein. Ex.2048, ¶¶97-98.

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.2048, ¶54. 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.2048, ¶¶62-64, 100-102.

Regarding one-way functionality, Petitioners attempt to argue that Cheng teaches “receiving content from a mobile device.” Petition, 22-24. This is a complete misunderstanding of Cheng, and is wrong. As described in Cheng, the invention relates to “dynamically extracting and reformatting existing web page content,” and “reformatting the extracted content for viewing on a mobile device.” Cheng, 1:11-16. There is *nothing* about sending content from a mobile device to any other device. However, in an attempt to argue this point, Petitioners refer to Cheng’s Figure 4, which shows a user interface for creating a device profile. There are several tabs, with one in particular labeled “414 - UA input.” From this lone figure and a citation from the specification that says identifies 414 as one of the “HTTP request headers,” (Cheng, 8:54-62) Petitioners conclude that Cheng “teaches that a mobile device user

can input text, image, and file data into the mobile device.” Petition, 28; Ex.2048, ¶¶103-104.

This is wrong for several reasons. First, as indicated, Cheng is aimed at the download of conventional web-based material via a proxy server that modifies it for a mobile device. Ex.2048, ¶¶54, 105. There is no disclosure in the figures or written specification anywhere about sending content from a mobile device. Second, upon careful reading of this passage, it is clear that the “HTTP request headers” are used for “[w]hen a user *requests a web page* 104 using a mobile device.” Cheng, 8:54-62, emphasis added. The device headers (including 414) are not used to upload info to a server, they instead “*serve to identify the mobile device* 108 to the proxy server” (Cheng, 8:54-62, emphasis added) when the mobile device requests a download. There is *never* any input of “text, image, and file data” into the mobile device; this is simply the type of data that the mobile user is *requesting from the server*. Ex.2048, ¶¶104-105.

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.2048, ¶102-105.

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; Ex.2048, ¶55. 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.2048, ¶56. 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.2048, ¶¶56-59.

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.2048, ¶60.

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.2048, ¶¶59-61.

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.2048, ¶¶62-64, 100-102. But the independent claims of the '801 Patent recite two-way, interactive functionality, where the mobile device not only receives but sends content. Ex.2048, ¶¶100-102. 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.2048, ¶¶65, 102-106.

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 Neibauer and Cheng, such combination cited and relied upon references across Grounds 1–2. The combinations proposed are speculative, hindsight-driven, and incompatible with the teachings of the prior art.

c) No reasonable expectation of success

It is Petitioner’s burden to demonstrate both 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. First, as established above, Petitioners have not established any motivation to combine the references; this failure alone is dispositive. Second, Petitioners make no showing of a reasonable expectation of success regarding combining the various and distinct chapters in Neibauer. For the proposed Neibauer Cheng combination, Petitioners make only a single, conclusory statement regarding a reasonable expectation of success. Petition, 26 (“A POSITA would also have had a reasonable expectation of success as Cheng

relies on known and industry-standard technologies.”). This is plainly insufficient, as “attorney argument is no substitute for evidence.” *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005). The Federal Circuit has held that “a party’s unsworn attorney argument... is not evidence” and cannot rebut record evidence. *Wasica Fin. GmbH v. Cont’l Auto. Sys.*, 853 F.3d 1272, 1284-85 (Fed. Cir. 2017).

Petitioners’ reliance on their expert’s testimony (Petition, 26, citing Ex.1002, ¶120.) does not cure the deficiency, as the expert merely repeats the conclusory assertion without any meaningful analysis. Ex.1002, ¶120. This fails to meet the evidentiary requirements of 37 C.F.R. § 42.65(a) and improperly circumvents the prohibition on incorporation by reference under 37 C.F.R. § 42.6(a)(3).

III. 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: July 14, 2025

Respectfully submitted,

/Eugene Goryunov/

Eugene Goryunov (Reg. No. 61,579)

Homayoon Rafatijo (Reg. No. 80,870)

BROWN RUDNICK LLP

1900 N Street NW

Washington, D.C. 20036

Tel: (202) 536-1700

Fax: (202) 536-1701

Erick Robinson, Esq. (Reg. No. 51,354)

Jayne Partridge (Reg. No. 39,011)

Patrick M. Dunn (Reg. No. 70,474)

Jayne C. Piana (Reg. No. 48,424)

BROWN RUDNICK LLP

811 Main Street, 18th Fl.

Houston, TX 77002

Tel: (281) 815-0511

Fax: (281) 605-5699

Ian G. DiBernardo (Reg. No. 40,991)

BROWN RUDNICK LLP

Times Square Tower, 47th Fl.

7 Times Square

New York, NY 10036

Tel: (212) 209-4800

Fax: (212) 209-4801

Attorneys for Patent Owner

Mobile Data Technologies LLC

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 6,969 words using the word count feature of Microsoft Word.

Date: July 14, 2025

Respectfully submitted,

/Eugene Goryunov/

Eugene Goryunov (Reg. No. 61,579)

Attorneys for Patent Owner

Mobile Data Technologies LLC

CERTIFICATE OF SERVICE

I hereby certify that on July 14, 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:

Lori Gordon (Reg. No. 50,633)
Goodwin Procter LLP
1900 N St. N.W.
Washington, D.C. 20036
Phone: (202) 346-4000
Fax: (202) 346-4444
Gordon-ptab@goodwinlaw.com

Doug Kline (Reg. No. 35,574)
GOODWIN PROCTER LLP
100 Northern Avenue
Boston, MA 02210
Phone: (617) 570-1000
Fax: (617) 523-1231
dkline@goodwinlaw.com

Naomi Birbach (Reg. No. 67,113)
Goodwin Procter LLP
620 Eighth Avenue
New York, NY 10018
Phone: (212) 813-8800
Fax: (212) 355-3333
NBirbach@goodwinlaw.com

Srikanth Reddy
(*pro hac vice* application to be filed)
GOODWIN PROCTER LLP
100 Northern Avenue
Boston, MA 02210
Phone: (617) 570-1000
Fax: (617) 523-1231
sreddy@goodwinlaw.com

Date: July 14, 2025

Respectfully submitted,

/Eugene Goryunov/

Eugene Goryunov (Reg. No. 61,579)
BROWN RUDNICK LLP
1900 N Street NW
Washington, D.C. 20036
Tel: (202) 536-1700
Fax: (202) 536-1701

Attorneys for Patent Owner
Mobile Data Technologies LLC