UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner

v.

MOBILE DATA TECHNOLOGIES LLC,
Patent Owner

IPR2024-00248
Patent 9,032,039 B2

PATENT OWNER'S RESPONSE TO PETITION
35 U.S.C. § 316(a)(8), and 37 C.F.R. § 42.120

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EXHIBIT LIST

Ex.	Description
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2002	*Curriculum Vitae* of Kevin C. Almeroth, Ph.D. [WITHDRAWN]
2003	U.S. Patent Application Publication No. 2005/0171645 to Dowling et al. ("Dowling")
2004	Declaration of Erik Dykema (PHV Application)
2005	Reserved
2006	Reserved
2007	Declaration of Dr. Nenad Medvidovic in Support of Patent Owner's Responses to Petitions
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2019	Robin Osborne, *A Brief History of HTML Part 1* (July 17, 2025), available at https://www.robinosborne.co.uk/tag/chtml/ last viewed Sept. 30, 2024
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2022	*Jornada 820 palmtop PC, 1998*, available at https://www.hp.com/hpinfo/abouthp/histnfacts/museum/personalsystems/0038/index.html, last viewed Sept. 30, 2024
2023	Pen Computing Magazine, *LG Electronics Phenom II* (Dec. 1997), available at https://www.pencomputing.com/WinCE/phenom2.html, last viewed Sept. 30, 2024

Mobile Data Technologies, LLC ("MDT") submits this Patent Owner's Response ("POR") to the Petition (Paper 2, "Pet.") for inter partes review ("IPR") of claims 19-23 (the "Challenged Claims") of U.S. Patent No. 9,032,039 ("'039 Patent", EX1001) filed by Meta Platforms, Inc. ("Petitioner"). The Board instituted IPR. Paper 11 ("Decision").

I. INTRODUCTION

Petitioner's obviousness analysis is fundamentally flawed, as explained below. Further, the record provides clear evidence that the Challenged Claims are patentably distinct from the prior art, and thus Petitioner has not met its burden of showing the Challenged Claims are invalid. Patent Owner requests that the Board issue a Final Written Decision affirming the patentability of the Challenged Claims.

A. Overview of Technology in 2002

The state of the art of mobile devices in 2002 was remarkably different than what people are used to today. Medvidovic (EX2007) at 35-44. Mobile devices were able to access the internet, but their capabilities (screen, processing, user input, and navigational) were greatly limited. *Id*. at 41. In addition, internet usage over mobile devices was essentially one-way. *Id*. at 42. That is, the internet pages that were accessible by mobile devices in 2002 were specially-modified mobile versions of the full webpage. These mobile versions were significantly pared down, including limited graphics and were generally designed to push information to the user. These

webpage versions were essentially one-way communications; they had limited, if any, bi-directional interaction capabilities. *Id*.

B. The ’039 Patent

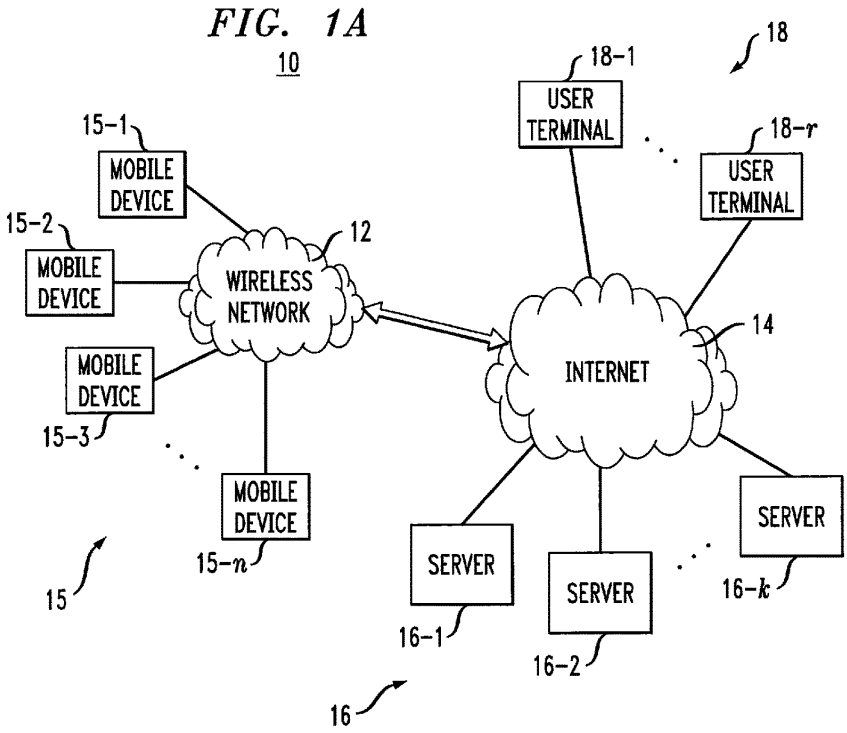
The ‘039 Patent is titled “Method, Apparatus and System for Management of Information Content for Enhanced Accessibility Over Wireless Communication Networks,” and was issued by the U.S. Patent & Trademark Office on May 12, 2015. ‘039 Patent (EX1001) (face). The ’039 Patent is generally directed to accessing information content over wireless networks via web-enabled mobile devices, such as mobile telephones, personal digital assistants (PDAs), palm computers, and the like. *See* ‘039 Patent, 1:34-48. In 2024, we are accustomed to this technology and use it daily; at the time of the claimed invention of the ’039 Patent in 2002, however, the limited display space and navigational capabilities of these mobile devices presented a challenge with regard to creating, publishing, distributing, or otherwise managing information content via the mobile devices. *Id*. Indeed, the ’039 Patent clarifies that users may wish to make content available via mobile devices, but the “conventional techniques” of that time have been “unable to meet this need in a satisfactory manner.” *Id*., 1:49-52.

These “conventional techniques,” per the ’039 Patent, include web site authoring tools and web logging (“blogging”) tools that are not optimized for use when generating content for shared access via mobile devices because they fail to

provide suitable integration of messaging, collaboration, location-based services, and other wireless networking functionalities with the generation of content. *Id*., 1:53-61. Moreover, the conventional techniques fail to provide a mechanism that facilitates user interaction of such content using mobile devices via wireless networks. *Id*., 1:64-67. Accordingly, the '039 Patent describes various techniques that assist mobile device users with managing information content in a manner that overcomes the drawbacks of these conventional techniques. *Id*., 1:64-2:6.

With this in mind, "mobile devices" of the '039 Patent are generally described as any type of portable information processing device capable of communicating over a network, such as a mobile phone, a hand-held computer, a laptop computer, a watch, and a portable game player, among others. *See id*., 4:24-36. In the context of the drawbacks of the conventional techniques described above, the mobile devices are also characterized as having limited display space and navigational capabilities. *Id*., 1:34-48. Accordingly, the term, "mobile device" in the context of the problem identified by the '039 Patent includes the mobile devices that benefit from "creating, publishing, distributing or otherwise managing information content so as to provide optimal presentation consistent with *the limited display space and navigational capabilities of typical mobile devices*." *Id*., 1:45-48 (emphasis added); Medvidovic, ¶¶60-62.

Regardless of the type of mobile device being employed, the '039 Patent discloses that the mobile devices (e.g., mobile devices 15) are coupled to a wireless network 12, which then provides a connection to the Internet 14 as show in FIG. 1A reproduced below:



As shown in FIG. 1A, the mobile devices 15 connect to the wireless network 12, which is separate from the Internet 14.

At the time of the invention (circa 2002), mobile devices with limited display space and navigational capabilities, such as mobile phones and PDAs, would connect to the Internet via wireless networks, such as a Wireless Application Protocol ("WAP"), a 3G network, or the like, as depicted in FIG. 1A. Medvidovic,

¶¶39-41. With this in mind, the ’039 Patent provides techniques for efficient generation and management of mobile sites (e.g., information content accessible via the mobile device 15 over the wireless network 15) that are advantageously integrated with wireless networking functionalities of the wireless network 12. *See* ’039 Patent, 2:11-15; 5:22-25. In this way, the ’039 Patent aims to solve the noted issues related to facilitating the management of information content to enable optimal presentation while consistent with the limited display space and navigational capabilities of mobile devices. *See id*. Indeed, by providing content and information related to a wireless networking functionality of the mobile device to a server, the ’039 Patent equips these mobile devices to insert and integrate this transmitted information into a previously established application-based information channel that permits interactions between the mobile devices and additional users. *See id*., Claim 19.

Keeping this in mind, the claims at issue in the ’039 Patent should be read in the context of the described challenges for mobile devices with respect to providing content from mobile devices to channels that can be accessible by other mobile users. That is, the “mobile devices” of the ’039 Patent are read in the context of the problem identified by the ’039 Patent of “creating, publishing, distributing or otherwise managing information content so as to provide optimal presentation consistent with *the limited display space and navigational capabilities of typical mobile devices*.”

Id., 1:45-48 (emphasis added). As such, "mobile device," as claimed in the '039 Patent, is distinct from devices (e.g., laptop computers, desktop computers) employing conventional techniques, such as web site authoring tools (e.g., via the Internet), that do not manage information content presentation for typical mobile devices. *Id*., 1:44-56.

C. Independent Claim 19

The sole independent claim challenged in the Petition, claim 19, requires a server that receives: (1) content for insertion into a previously established application-based information channel; and (2) information associated with at least one wireless networking functionality of a mobile device *from the mobile device*; and integrates the content and the information associated with the wireless networking functionality of the mobile device into the previously established application-based information channel. Claim 19 further requires the previously established application-based information channel to *permit interaction between a user of the mobile device* and one or more additional users.

As will be established below, the Petitioner failed to carry its burden of establishing that claim 19 is invalid over the prior art in Ground 1. Additionally, since the Petitioner failed to carry its burden with respect to independent claim 19, Ground 2, which includes claim 23 dependent from claim 19, also fails.

Ground 1 relies on three primary prior art references, Neibauer (EX1003), Cheng (EX1005), and Squibbs (EX1011), which fail to teach or suggest all of the recitations of independent claim 19 even when combined. First, although Neibauer provides the ability for users to create web-based communities for sharing information through a feature called Yahoo! Clubs, this feature is only described as being a web-based feature implementable via the Internet. Neibauer, pp.477-480. Contrary to the Petitioner's assertion in the Petition, Neibauer never mentions that the Yahoo! Clubs feature is accessible to mobile devices (i.e., devices with limited display and navigational capabilities). Neibauer merely describes a Yahoo! Mobile feature that enables mobile devices to receive text messaging, emails, and event data but never teaches that the mobile device provides content to be inserted a web-based feature such as Yahoo! Clubs. *See* Neibauer, pp.166-180. Neither Cheng nor Squibbs cures this deficiency.

Moreover, none of the cited references teach or suggest a server receiving: (1) content for insertion into a channel; and (2) information associated with a wireless networking functionality of a mobile device *from the mobile device*. Indeed, Neibauer never mentions sending any data from the mobile device via Yahoo! Mobile. Instead, Yahoo Mobile! is only described as being capable of *receiving* data at mobile devices and never affords a mobile device user the ability to send content and information associated with a wireless networking functionality for insertion

into a channel accessible to the mobile device. *See id*. Additionally, in view of the constructions provided below, the Board's interpretation of a laptop computer being able to access the Yahoo! Clubs website is inconsistent with the use of the term "mobile device" in the context of the '039 Patent. Thus, Petitioner failed to carry its burden of establishing that claims 19-20 and 22-23 are invalid over the prior art in Ground 1. Grounds 2-4 fail for the same reasons as Ground 1.

II. PERSON OF ORDINARY SKILL IN THE ART

For purposes of the POR, MDT applies Petitioner's characterization of a person of ordinary skill in the art ("POSITA"). Patent Owner hereby affirmatively withdraws the expert declaration and C.V. submitted with Patent Owner's preliminary response (EX2001, 2002). *PTAB Consolidated Trial Practice Guide,* §II(c), p. 51.

III. CLAIM CONSTRUCTION

In an IPR, claims are construed according to *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-17 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R. § 42.100(b) (2020). In construing claims, courts look first to the intrinsic evidence. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Courts may consider extrinsic evidence to resolve ambiguities that cannot be resolved through intrinsic evidence alone. *Id.* at 1583.

A. "Mobile Device"

The term "mobile device" in independent claim 19 and associated dependent claims should be construed consistently with its plain and ordinary meaning, as well as the intrinsic and extrinsic record, to mean "a portable device with limited display space and limited navigational capabilities that connects to a mobile site and/or mobile channel via a wireless network."

The intrinsic evidence supports this construction. First, the Background of the Invention explains specific challenges faced by mobile devices for generating and sharing content as opposed to computer (e.g., PC and/or a fully-capable laptop) web experience: "conventional techniques such as web site authoring tools and web logging ('blogging') are not optimized for using in the generation of information content for shared access via mobile devices. because they fail to facilitate the process of "creating, publishing, distributing, or otherwise managing information content so as to provide optimal presentation consistent with the limited display space and navigational capabilities of typical mobile devices." '039 Patent, 1:45-58. This section continues:

> These and other conventional techniques suffer from a number of significant drawbacks, including a failure to provide suitable integration of messaging, collaboration, location-based services or other wireless networking functionality with the generation of shared information

> content. As a result, it is generally not possible for different mobile device users to link to and take further action on a persistent version of a given set of shared information content.

Id. at 1:57-61. The challenges aimed to be solved by the '039 Patent include facilitating the process of managing information content to provide optimal presentation consistent with the limited display space and navigational capabilities of typical mobile devices. *Id*., 1:44-48; Medvidovic, ¶¶60-62.

Second, the '039 Patent is clearly directed to wireless communications via these mobile devices, noting that the mobile device is a "portable information processing device capable of being configured for communication over a network." *See, e.g.,* '039 Patent, 4:26-29. The specification also characterizes the invention of the '039 Patent with respect to integrating information content of multiple mobile devices over wireless networks. *Id*., 2:11-32.

Third, the '039 Patent specifies that the "mobile devices 15 can collectively comprise a wide variety of different devices configurable for communication over the network 12." *Id.*, 4:24-25. This "communication over the network 12" includes communication for the generation and management of mobile sites, in contrast to conventional web sites. The very first sentence of the "SUMMARY OF THE INVENTION" section of the '039 Patent clearly establishes that the '039 Patent is

directed to "generation and management of mobile sites." *Id*., 2:11-15. For example, the '039 Patent discloses "users can create one or more personal or business *mobile sites* with various sets of features, and then share such sites via the mobile Internet or *other wireless network* with friends, family, colleagues, or other groups of any type." *Id.* 10:19-23 (emphases added).

Further, the '039 Patent is replete with examples of mobile site generation and/or use of mobile information channels to overcome the lack of mobile device functionality of "conventional techniques" used for non-mobile devices. *Id.* 1:34-2:7; *see also id*. 2:4-7 ("a need exists for improved techniques for managing information content in a manner that overcomes one or more of the drawbacks of the conventional techniques described above."). Thus, mobile devices must include the capability to read a mobile site to access network content. Medvidovic, ¶¶61, 82-85 and 270.

In the context of the '039 Patent, web experiences of mobile devices clearly diverge from conventional techniques provided by computers, such as fully-capable PCs and/or laptops. *Id*. at ¶84. While the specification lists "laptop computer" in a laundry list of items that may be included as "mobile devices," a POSITA would understand these laptops to be a subset of laptops having limited capabilities, such as a laptop running a mobile operating system (e.g., Windows CE) such as IBM's WorkPad z50, HP's Jornada 820, or LG Electronics Phenom. *Id*. As such, to the

extent that laptops are included as mobile devices, a POSITA would understand these laptops to be a subset of laptops having limited capabilities, as described throughout the specification, thus using mobile sites to facilitate network information sharing. *Id*. A POSITA would *not* understand a mobile device to include the full capabilities of laptops that simply use conventional sites for information sharing. *Id*. This is especially true in the context of the '039 Patent, which repeatedly demonstrates mobile device connectivity through mobile sites, not conventional sites. *Id.; see also* ¶¶44, 61.

Because the term "mobile device" is described throughout the '039 Patent in the context of its display space limitations and navigational limitations, a POSITA would reasonably interpret a "mobile device" as consistent with the construction provided above *and* excluding a traditional laptop computer[1], which does not suffer from the limitations of a mobile device. Medvidovic, ¶¶45, 60-64.

Moreover, claim terms must be construed "in light of the surrounding claim

[1] Patent Owner further asserts that a POSITA at the time of the invention would have understood the single reference in the specification to laptop computers to refer specifically to laptop computers existing that were configured to interact with mobile content through mobile networks (such as those running Windows CE), and not refer to traditional laptop computers.

language, such that words in a claim are not rendered superfluous." *Dig.-Vending Servs. Int'l, LLC v. Univ. of Phx., Inc.*, 672 F.3d 1270, 1275 (Fed. Cir. 2012). Construing "mobile device" to include a traditional laptop computer would render the reason for the entire patent moot, as well as the rest of the claims superfluous. In 2002, at the time of filing, the inventive aspect of the '039 Patent was the ability to activate information channels on a mobile device and interact with those channels bi-directionally on a mobile device, where a mobile device is understood as a portable handheld device, which were fairly new and novel technology at the time. As the Petition acknowledges, there was a "growing popularity of mobile computing and mobile devices" at the time of filing. Pet. at 21. This clearly refers to portable handheld devices, *not* traditional laptop computers, which were not new in 2002. Medvidovic, ¶62. Petitioner's construction of mobile device as including a traditional laptop computer would render moot the main reason for the invention: creating a system to allow known technology (such as a desktop interface) to be accessible and interactable on a mobile, portable, handheld device. *Id.*

In its decision, the Board concluded that the term "mobile device" includes a laptop computer. Decision (Paper 11), p.23. Respectfully, Patent Owner submits that the Board does not account for claims "conform[ing] to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims" to find "clear support … in the description so that the meaning of the terms in the

claims may be ascertainable by reference to the description." *See* 37 C.F.R. § 1.75(d)(1). In other words, reading a traditional (i.e., full capability) laptop computer as a mobile device is an inaccurate representation of the term "mobile device" in light of the specification because performing the claimed methods on a traditional laptop computer would not solve the "important challenge" of "provid[ing] optimal presentation consistent with the limited display space and navigational capabilities of typical mobile devices." '039 Patent, 1:44-48; Medvidovic, ¶¶45, 60-64.

This construction is consistent with the general understanding of the term "mobile device" at the time of invention, as shown by the prior art references relied upon by Petitioner. Medvidovic, ¶63; *see, e.g.,* Neibauer at 111 (characterizing mobile devices as "Pagers, Cell phones, Web phones, Personal digital assistants (PDAs)" and cautioning users of the Yahoo! Mobile feature that to perform functions using Yahoo! Mobile, the user will need a PDA that uses a mobile operating system (e.g., Palm OS Windows CE); Cheng, 5:11-35 (characterizing mobile devices as handheld/portable devices, such as Palm operating system devices, smart phones that typically have a small screen and limited memory); Squibbs ¶108 (describing a mobile device as "a cellular-radio-based mobile device (phone or e.g., a PDA with mobile radio capability).").

The extrinsic record also supports this construction. The definition of "mobile

device" according to the National Institute of Standards and Technology is "[a] portable computing device that: (i) has a small form factor such that it can easily be carried by a single individual; (ii) is designed to operate without a physical connection (e.g., wirelessly transmit or receive information); (iii) possesses local, non-removable data storage; and (iv) is powered-on for extended periods of time with a self-contained power source." *See, e.g.,* EX2011.

In view of the prior art references cited by the Petitioner and the intrinsic evidence provided by the specification, a POSITA would agree with the construction of "mobile device" provided above and also understand this term to *exclude* traditional laptop computers. Medvidovic, ¶61.

B. "Wireless Network"

The term "wireless network" in independent claim 19 and associated dependent claims should be construed consistently with its plain and ordinary meaning, as well as the intrinsic record, to mean "a network separate from the internet that facilitates connection to the internet by a mobile device."

The intrinsic evidence supports this construction. First, the specification explains that the term "wireless network" refers to a network that is "coupled to the Internet 14, a set of mobile devices 15, a set of servers 16 and a set of user terminals 18." *Id*., 3:42-46. FIG. 1A of the '039 Patent also supports this construction. As shown in the reproduced FIG. 1A above, the mobile devices 15 connect to the

wireless network 12, which is separate from the Internet 14. Medvidovic, ¶¶74-76 and 86-90.

The extrinsic evidence also supports this construction. Indeed, wireless networks are described as providing a wireless connection between devices to transmit data and enable the devices to access the Internet. Medvidovic, ¶76.

C. "Wireless Networking Functionalities of the Mobile Device"

The term "wireless networking functionalities of the mobile device" in independent claim 19 and associated dependent claims should be construed consistently with its plain and ordinary meaning, as well as the intrinsic record, to mean "functionality implementable by the mobile device via the wireless network independent of the Internet."

The intrinsic evidence supports this construction. First, the specification explains that the term "wireless networking functionalities" to include actions implementable over a wireless network," independent of Internet. '039 Patent, 5:51-65. In other words, actions that are capable of being performed over the wireless network, independent of the Internet. The specification describes example actions as "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."

Medvidovic, ¶¶77-78, 86-90.

D. "Application-Based Information Channel"

The term "application-based information channel" in independent claim 19 does not require an express construction and should be given its plain and ordinary meaning as "a computer program-based medium for transferring information," as proposed by Patent Owner in the pending litigation. EX1025. Petitioner adopts this construction for the purposes of the present IPR. Pet., p.27.

Petitioner provides Grounds 3-4 based upon ***Petitioner's*** proposed construction of this term in litigation. Pet., p.53. Petitioner notes that "[i]n the event the Board finds it unnecessary to construe this term, these grounds need not be further considered." *Id.* Here, because there is mutual agreement that the term "application-based information channel" means a "computer program-based medium for transferring information accessible to more than one user via the internet," the alternative construction applicable to Grounds 3-4 is not used and, thus, as Petitioner suggests, Grounds 3-4 are moot and "need not be further considered." *Id*. Even if considered, Petitioner's arguments fail as shown in Section IV.D. below.

IV. ARGUMENT

A. Legal Precedent

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 Petitioner's 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.

"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.,*

LLP v. Toyota Motor Corp., IPR2019-00867, Paper 6 at 8 (PTAB Sep. 18, 2019) (*quoting In re Stepan Co.*, 868 F.3d 1342, 1345-46 n.1 (Fed. Cir. 2017)).

"It is improper to combine references where the references teach away from their combination." M.P.E.P. §2145 (subheading X.D.2., entitled "References Cannot Be Combined Where Reference Teaches Away from Their Combination" and citing *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983)).

Petitioner bears the burden to demonstrate unpatentability, and that burden never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.,* 800 F. 3d 1375, 1378 (Fed Cir. 2015).

B. Asserted Grounds and Cited References

Petitioner asserts the challenged claims are unpatentable based on the following grounds:

Ground	Challenged Claims	Basis for Challenge under 35 U.S.C. §103
1	19-20, 22-23	Neibauer (EX1003), Cheng (EX1005), and Squibbs (EX1011)
2	21	Ground 1 Prior Art + Bandera (EX1017)
3	19-20, 22-23	Ground 1 Prior Art + Harvey (EX1010)
4	21	Ground 2 Prior Art + Harvey (EX1010)

Pet. 2.

1. Neibauer

The 2000 book titled How to Do Everything with Yahoo!, by Alan Neibauer, explains how the Internet portal called Yahoo! is a place on the Internet that offers users services, such as access to the Internet, and is a repository of and a conduit of user content and Yahoo! services for registered users. Neibauer, pp. xv, 4; Medvidovic, ¶93. Petitioner acknowledges this content from Neibauer was considered by the Examiner and made of record in granting the claims of the ’039 Patent. Pet. 4 (citing EX1022, Pages 00170 (covering Neibauer, pp. 467-491) and 00186 (covering Neibauer, pp. 115-180)). Nevertheless, Petitioner attempts to relitigate the prosecution history of the ’039 Patent in view Neibauer.

a. Chapter 21: Yahoo! Clubs

In particular, Petitioner submits that Neibauer discloses a feature called Yahoo! Clubs that allows users to create web-based communities for users to share information through photo sharing and other features. Pet. p.10. Neibauer describes accessing the Yahoo! Clubs feature by accessing a website (e.g., http://clubs.yahoo.com/) to open a webpage that includes a list of clubs, and a user can navigate (e.g., through clicks of a mouse) the list of clubs. The Yahoo! Clubs feature is described and depicted in Neibauer as being accessed by a personal computer with a “full size” display:

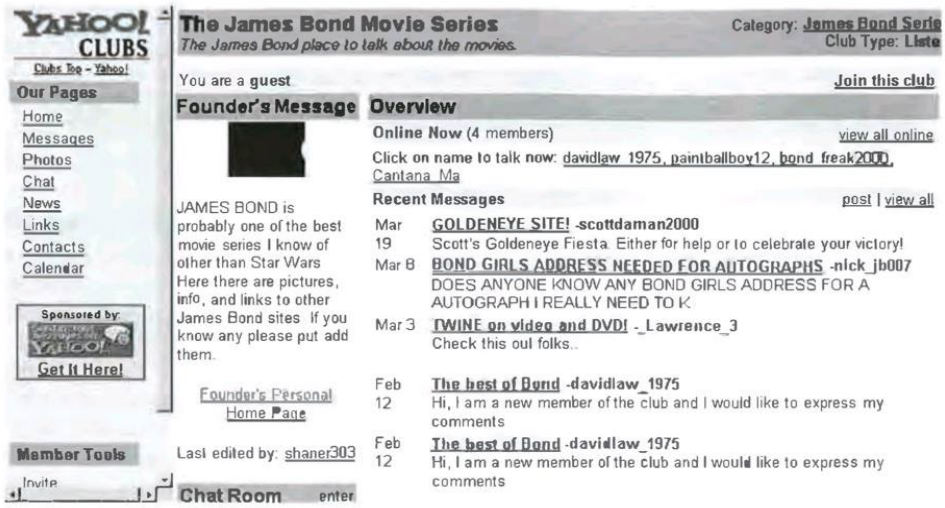


FIGURE 21-8 Club page

Neibauer at 475 ("Club page"); Medvidovic, ¶¶95-108.

Neibauer also describes the Yahoo! Clubs photo album feature, a website that allows users to add photos and descriptions of the photos via the website as depicted in FIG. 21-10 reproduced below. Neibauer, p.473-478; Medvidovic, ¶¶108-109.

FIGURE 21-10 Club photo album

Neibauer, p.478.

b. Chapter 7: Yahoo! Mobile

Keeping the Yahoo! Clubs *website-enabled* feature in mind, Petitioner then points to a separate section of Neibauer to illustrate that Neibauer provides the ability to access Yahoo! Services via mobile devices, such as cell phones. Pet. p.10. Neibauer describes a Yahoo! Mobile feature that allows users to check their mail and calendar and be notified about meetings, stock quotes, sports scores, the weather, and auctions. Neibauer, p.166. But to perform any operations via Yahoo! Mobile, Neibauer cautions the user that the mobile device needs to be a "PDA that uses Palm OS Windows CE, a modem, and a Web browser." *Id.*; Medvidovic, ¶¶96-97. In this way, Neibauer recognizes that a "mobile device" is consistent with the Patent Owner's claim construction provided above. Medvidovic, ¶63.

Further, it is clear that the Yahoo! Mobile feature relies on the mobile device's connection to the Internet to enable its capability of presenting notifications (e.g., alerts, mail, meetings) provided from web-based sources. *See id.* (requirement of Web browser). In other words, Yahoo! Mobile only provides the user with the ability to view information that has been received via the Internet, as opposed to being received from a mobile device. Medvidovic, ¶¶97-98.

Nothing in Neibauer suggests that the features described in Chapter 21 (Yahoo! Clubs) could be performed via mobile devices. Medvidovic, ¶98. On the contrary: the limited nature of Yahoo! Mobile (in view of the technical limitations

of mobile devices in 2000) reinforces why Yahoo! Clubs (as described in Neibauer's Chapter 7) was not – and could not have been – accessed via Yahoo! Mobile. Medvidovic, ¶95-100. Even assuming (incorrectly) that Yahoo! Clubs was accessible in 2000 via Yahoo! Mobile, that would, at best, provide a mobile user the ability to view information received from the Internet. Accordingly, when considering the Yahoo! Clubs feature in view of the limitations of the Yahoo! Mobile feature, it is clear that Yahoo! Mobile, at best, provides mobile device users the ability to ***receive data*** from the Yahoo! Clubs website but does not provide mobile device users the ability to ***provide content*** to the Yahoo! Clubs website. *Id.* Neibauer *never* mentions providing a user the ability to add content, much less photos and descriptions of photos, *to* the Yahoo! Clubs website *from* a mobile device. *Id.* Indeed, given the limited display space and navigational capabilities of typical mobile devices, it is unreasonable to believe that the website depicted in FIG. 21-10 would be presentable on a mobile device or capable of performing the functions related to inserting content into the Yahoo! Clubs website. Medvidovic, ¶98.

Additionally, Yahoo! Clubs, as described in Neibauer, is depicted as involving "full featured" webpages that allow users to perform various operations (e.g., add photo) via the Internet and a desktop browser. *See id*. at ¶¶99, 101-109. That is, the photos and descriptions of the photos added to the Yahoo! Clubs website are

provided via an Internet-based platform designed for access by personal computers (PCs)—not mobile devices. *Id*. Indeed, neither Yahoo! Clubs nor Yahoo! Mobile permit or contemplate uploading content from a mobile device for integration into a channel facilitating interaction between the mobile device user and other users. *Id*.

Further, since Yahoo! Clubs is only implementable via the Internet as a website, the ability afforded to Yahoo! Clubs users to add photos and descriptions corresponds to a functionality implementable via the Internet, ***not*** implementable via a wireless network separate from the Internet. Medvidovic, ¶¶99-109. Indeed, as will be discussed in more detail below, Neibauer never provides the ability to send content and information associated with a *wireless networking functionality* of the mobile device for insertion into an information channel permitting interaction between a user of a mobile device and other users.

The Petition fails to provide evidence and analysis that overcome these deficiencies. Medvidovic, ¶111.

c. Neibauer is Nonanalogous Art

The appropriate field of endeavor is determined "by reference to explanations of the invention's subject matter." *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). As discussed above, doing so reveals that Neibauer is *not* reasonably pertinent to the problem addressed by the '039 Patent which explains that "conventional techniques suffer from a number of significant drawbacks, including a failure to provide suitable

integration of messaging, collaboration, location-based services or other wireless networking functionality with the generation of shared information content." '039 Patent 1:44-61; Medvidovic, ¶¶158-160.

Petitioner never explains how Neibauer solves these problems. And despite stating that Neibauer "would have been reasonably pertinent to problems facing the inventors[]" (Pet. at 21), the Petition *never* identifies any such "problems." The assertion of Petitioner's expert is likewise conclusory (claiming that Neibauer "would have been reasonably pertinent to problems facing the inventors including how to implement a web-based system for managing information content and making that content available to users over the Internet."). EX1002, ¶104.

First, as explained above, that is not the problem solved by the '039 Patent (i.e., "it is generally not possible for different mobile device users to link to and take further action on a persistent version of a given set of shared information content[;]" '039 Patent 1:61-64). Medvidovic, ¶159. Neibauer, however, is not an invention and is not attempting to solve *any* problem. Medvidovic, ¶93-94; 156-157. At best, Neibauer's "problem" could be said to be laypeople's general ignorance of basic Internet functions such as sending emails and web searching. *Id*.

Additionally, a reference is only considered reasonably pertinent to the problem addressed by the patent "if a reference disclosure and the claimed invention have a same purpose…." *Ex Parte Van Herpen*, No. 2014-009097, 2016 WL

7097661, at *3 (P.T.A.B. Nov. 29, 2016) (*citing In re Clay*, 966 F.2d 656, 658-59 (Fed. Cir. 1992)). Neibauer's purpose is to act as a simplistic reference guide to help laypeople perform basic computing functions (e.g., accessing web-based email). This is a far different purpose than that of the '039 Patent, which is distinctly directed to allowing bidirectional information sharing from mobile device via an information channel. '039 Patent, 1:61-67. Therefore, Neibauer and the '348 Patent do not have the same purpose, confirming that Neibauer is not reasonably pertinent to the problem addressed by the '039 Patent.

Thus, Neibauer is nonanalogous art and cannot be used to render obvious any claims of the '039 Patent. Because each of Grounds 1-4 rely on Neibauer, they fail for this reason as well.

2. Cheng

In an attempt to cure the deficiencies of Neibauer, Petitioner asserts that it would be obvious to provide the Yahoo! Clubs features from Neibauer to users of mobile devices in view of Cheng (EX1005). Pet. p.10.

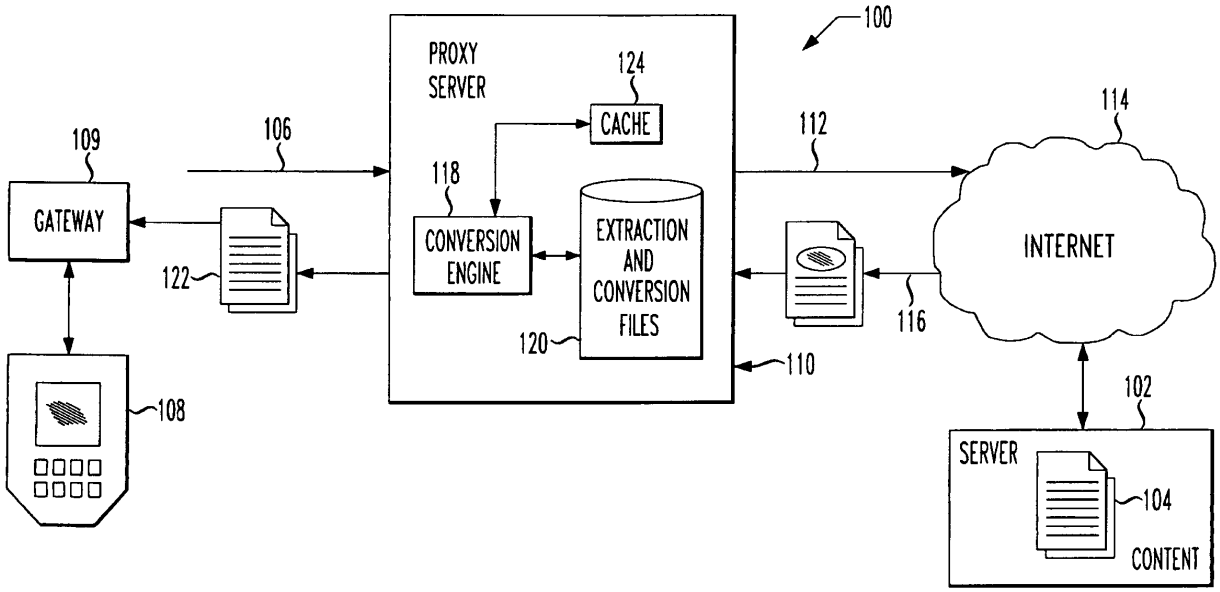
Cheng describes a method by which a proxy server can access a website and reformat its visual elements so they can be viewed by a mobile device. Cheng, Abstract; Medvidovic, ¶121. Cheng discloses that when the proxy server receives a request from a mobile device to view a particular web page, the proxy 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. *Id.*; Medvidovic, ¶122.

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. Medvidovic, ¶¶121, 127, 276, 284. 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). Cheng, 4:56-5:10; and 17-22 (exemplary SW-Transforms); *Id.*, ¶¶122-128. 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.*

As shown below, Cheng is limited to the transfer of data one-way, from the conventional website (web page 104), through the proxy server (110), into a reformatted web page (122) that is *transmitted to* the mobile device (108):

FIG. 1



Cheng, FIG. 1.

But nowhere does Cheng suggest transmission of content *from the mobile device*. Medvidovic, ¶¶126-128. Instead, Cheng's disclosure is limited to "dynamically extracting a portion of content from a web page and reformatting the extracted content for *viewing* on a mobile device." Cheng, 1:14-16. Cheng only describes its mobile device as receiving information for viewing, not sending such content.

Petitioner relies on Cheng to show that a mobile device could have accomplished the claimed interactive features missing from Neibauer. Cheng, however, is deficient in this regard because it only provides for transmission of data from a website to be displayed on a mobile device but does not provide for transmission in the other direction (i.e., sending data for integration into a channel from the mobile device to the server hosting the website). Medvidovic, ¶¶120, 126-

128. Indeed, the only data that Cheng is capable of sending from a mobile device is a request 106 for a given web page 104. Cheng, 3:58-63. The request 106 cannot be construed as being the same as content for insertion into a previously established application-based information channel permitting interaction between a mobile device user and others. Further, there is no suggestion that Cheng's proxy server or other mobile device would have been designed to support such upstream data transfer. Medvidovic, ¶¶120-128. The Petition fails to present evidence and analysis that overcomes this deficiency.

3. Squibbs

In an attempt to cure the deficiencies of Neibauer and Cheng with respect to wireless networking functionalities of the mobile device, Petitioner asserts that it would be obvious in view of Squibbs (EX1011).

Squibbs describes a technique of recording and displaying (such as photos) along with the location where the photo was taken. Squibbs, Abstract. Medvidovic, ¶144. In a particular embodiment, Squibbs describes a digital camera 90 that transmits photo image data to a cell phone 20, which, in turn, uploads the image data over a cellular connection to service system 40 for storage on network store 43. Squibbs, ¶0101, Fig. 11 (showing transfer 105); *Id*. Squibbs explains that the cell phone can determine location information of the image data in a number of ways, including by using "a location server of the mobile radio infrastructure," or using "a

GPS system built into the cell phone." Squibbs, ¶98; *Id*. After determining the location information, the cell phone may upload the photo image data and the location information to a network store 43. Squibbs, ¶0101; *Id.*

4. Combination of Neibauer and Squibbs

Neibauer in combination with Squibbs does not teach or suggest content sharing using a mobile device, as required by the claims. Petitioner asserts it would be obvious to combine the geographic location of a photo determined according to Squibbs with the photo sharing feature provided in Yahoo! Clubs in Neibauer. Pet. p.37. Indeed, Petitioner asserts that the Yahoo! Clubs photo sharing feature would be adapted to display location information associated with uploaded photos via map-based user interfaces similar to the maps depicted in FIGS. 6-7 of Squibbs and a Yahoo! Maps feature detailed in Neibauer. *See id*., 36-38. As shown below, both Squibbs and the Yahoo! Clubs of Neibauer require a personal computer, not a mobile device. Medvidovic, ¶¶145-147. There is no teaching in any of the prior art of sharing information from a mobile device with other users. *Id.*

Referring first to Squibbs, the map-based user interfaces depicted in FIGS. 6-7 of Squibbs are generated by an album program 50, which resides on a personal computer (e.g., PC 5). Squibbs, ¶¶31-32, 64. After the cell phone 20 of Squibbs transmits the location information to the network store 43, the album program 50 stored in the PC 5 receives the location data (e.g., location log 100) from network

store 45 to generate the respective maps. Squibbs, ¶¶113-114; FIG. 12. As such, the map-based user interfaces generated by the album program 50 and depicted in FIGS. 6-7 of Squibbs are clearly designed for presentation via a display that is ***part of a PC*** and not a previously established application-based information channel permitting interaction with a mobile device (e.g., with limited display space and limited navigational capabilities). Medvidovic, ¶146.

Moreover, as shown above, the Yahoo! Clubs feature of Neibauer is a web-enabled feature that is designed for use via a computing device that is unencumbered by the limited display space and navigational capabilities of a mobile device. Indeed, the Yahoo! Map page includes a Zoom Out and Zoom In bar positioned above the displayed map to allow the user to navigate to different scales of view in the depicted map, as shown in the reproduced image below. Neibauer, p.225.

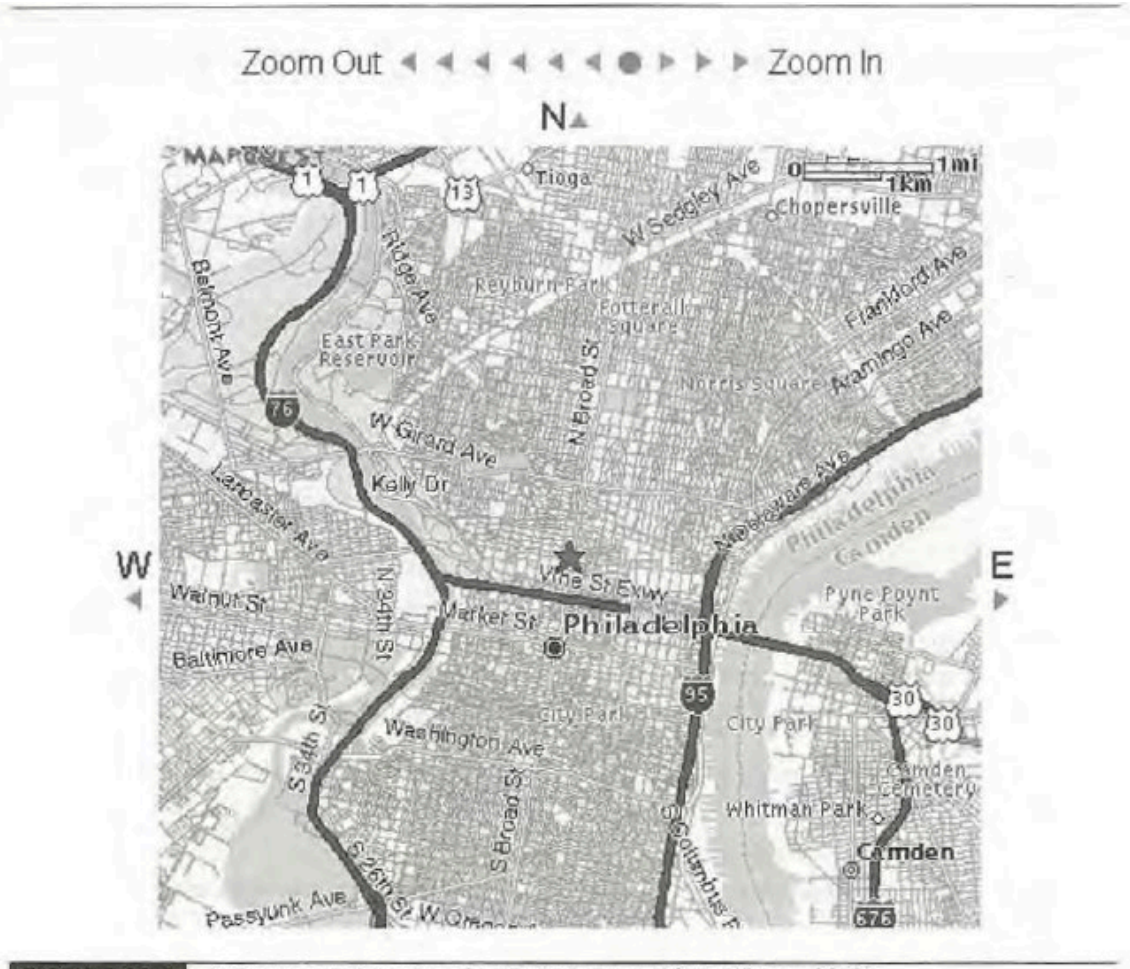


FIGURE 10-3 Map zoomed out two levels (compare this to Figure 10-2)

Neibauer, p.225.

The zoom in/out navigation tools provided on the Yahoo! Map feature cannot be provided on an information channel permitting interaction between mobile device users due to the limited display space and navigational capabilities of the mobile devices. Medvidovic, ¶147. Moreover, Neibauer never describes that the Yahoo! Mobile feature is capable of presenting complex graphics and interactive features (e.g., Zoom) via a mobile device. *Id*. Instead, Neibauer, like Squibbs, clearly contemplates accessing the Yahoo! Map via desktop computers because the map is

a depicted as a separate object in the browser window that can be saved and annotated in the Windows Paint program. Neibauer, p.225. Indeed, it would be impossible to perform the functions provided in Neibauer to save the map image via a mobile device as detailed in the instructions for doing so in Neibauer.

See id., e.g., p.227 (Instructional Navigational Graphic).

In this way, and as will be discussed in detail below, the combination of Neibauer, Cheng, and Squibbs fails to integrate content and information associated with a wireless networking functionality (e.g., location data) provided by a mobile device into an application-based information channel permitting interaction between a user of the mobile device and other users, as required by the claims. Indeed, none of the cited references provides for the transmission of any information associated with a wireless networking functionality for integration into a previously established application-based information channel permitting interactions from a mobile device with a limited display space and limited navigational capabilities. Medvidovic, ¶149.

5. Combination of Neibauer and Cheng

Petitioner's proposed combination of Neibauer and Cheng fares no better. Neibauer in combination with Cheng does not teach or suggest content sharing using a mobile device. Petitioner maps the "receiving . . . from a mobile device" and "permitting interaction between a user of the mobile device and one or more

additional users" to the upstream transfer of data, such as pictures, from a mobile device running the Yahoo! Clubs website disclosed in Neibauer. Pet. 13-19; Petitioner relies on Neibauer alone to disclose these limitations except, in the alternative, Petitioner turns to Cheng to support using Yahoo! Clubs on a mobile device. Pet. pp.19-24.

Petitioner represents Neibauer discloses the key limitations of claim 19 as recited in limitation 19[a]. *Id*. at 13. Limitation 19[a] states:

> ***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***;

(emphasis added).

Petitioner maps Neibauer's clubs, messaging, chat, and photography features of the Yahoo! Clubs functionality discussed in Chapter 21 to the claimed server that receives content "from a mobile device" as well as the "application-based information channel" that "permit[s] interaction between a user of the mobile device and one or more additional users for sharing content between the first user and one or more additional users." *Id*. at 13-19. As established above, the term "mobile device" when construed in conjunction with the specification, means "a portable device with limited display space and limited navigational capabilities that connects

to a mobile site and/or mobile channel via a wireless network" and does not include typical laptop computers.

Since the information channel must facilitate interaction with a mobile device user, and since a traditional laptop computer is inconsistent with the term "mobile device" as properly construed in light of the specification, Neibauer fails to teach or suggest an information channel permitting interaction between a user of a mobile device and other users and sending content form a mobile device for insertion/integration into the information channel.

Turning now to Neibauer, Petitioner has mapped the claim language related to "receiving . . . from a mobile device, content for insertion into a previously established application-based information channel" that "permit[s] interaction between a user of the mobile device and one or more additional users for sharing content between the first user and one or more additional users" to the Yahoo! Clubs functionality. Pet. pp.13-18. However, Neibauer is devoid of providing such functionality via mobile devices as provided in the context of the specification. Indeed, there is no evidence that the Yahoo! Clubs functionality could have been supported by users accessing the services on a mobile device. Medvidovic, ¶123. Indeed, Yahoo! Clubs compare closely to the web site authoring tools and web blogging tools described as "conventional techniques" described as not being

optimized for use when generating content for shared access via mobile devices in the ’039 Patent. ’039 Patent, 1:53-61.

Neibauer’s deficiency with regard to disclosing receiving content from and permitting interaction with a user of a mobile device of limitation 19[a] is not cured by the “Yahoo! Mobile” and “Yahoo! To Go” functionalities. Petitioner attempts to explain that these features teach and suggest the notion of mobile content sharing because some features of Yahoo! were accessible by a mobile device. Pet. 25. The notion of sharing is belied by the fact that the “Yahoo! Mobile” and “Yahoo! To Go” functionalities are limited to a user’s one-way access for viewing information originating with the Yahoo! software platform. Neibauer, pp. 156, 166-167. Indeed, there is no evidence that if the Yahoo! Clubs feature could be offered through the Yahoo! Mobile or Yahoo! To Go services, that it would have allowed mobile users to actually post content. Medvidovic, ¶125. Neibauer presents the Yahoo! Mobile and Yahoo! To Go features as only providing a unidirectional access to view information from a limited number of Yahoo! Services, which exclude Yahoo! Clubs and Yahoo! Maps. *See id*., at ¶109; *cf. Reactive Surfaces Ltd.*, IPR2019-00867, Paper 6 at 8 (requiring motivation to combine multiple embodiments from a single reference).

The technology needed to provide user-interactive features were outside the capabilities of mobile devices at that time and what Neibauer discusses in Chapter

7, such as the required screen size, mobile device memory, processing power, and wireless bandwidth. *Id*. ¶¶107-109. Comparing the features of the club pages to what content and features of Yahoo! Mobile and Yahoo! To Go that were capable of being displayed on a mobile device (e.g., PDA) at the time indicates it would not be technically feasible to do so. *Id*. The deficiencies of Neibauer are not solved by Cheng.

Focusing on the word "mobile" in claim 19, Petitioner argues Cheng discloses accessing non-mobile webpages, such as Neibauer, into a format accessible by mobile devices. Pet. 19. Cheng's proxy server model would not have supported two-way content sharing for mobile devices. Cheng discloses a unidirectional re-formatting of a conventional source website for viewing on a circa 2000 mobile device. Cheng, 4:56-5:10; Medvidovic, ¶¶120-126 and 285. In other words, Cheng fails to provide the ability to send content for insertion into a previously established application-based information channel that permits interaction between a mobile device user and others, such that the content is integrated into the previously established application-based information channel. Indeed, Cheng's disclosure of translating a conventional web page for viewing on a mobile device does not provide any additional understanding of how an exchange of information would be accomplished in the reverse, from a mobile device back to the conventional web page, much less to a previously established application-based information channel

permitting interaction between a mobile device user and others. Indeed, to render a claim obvious, the prior art taken as a whole must enable a skilled artisan to make and use the claimed invention. *See In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005). Accordingly, since Cheng fails to describe providing content from a mobile device to a previously established application-based information channel or a server, and since Cheng fails to provide any insight as to how a POSITA would perform this operation, Cheng fails to cure the deficiency of Neibauer.

C. Ground 1: Non-Obviousness of Grounds Based on Neibauer, Cheng, and Squibbs (Claims 19-20, 22-23)

All four grounds challenging claims 19-20 and 22-23 rely on unpatentability over at least Neibauer, in view of Cheng and in further view of Squibbs under 35 U.S.C. §103, citing the declaration of Vijay K. Madisetti, Ph.D. (EX1002), as support. Pet. 9-10. As shown, the combination of Neibauer, Cheng, and Squibbs fails to teach or suggest the recitations of claims 19-20 and 22-23. Medvidovic, ¶¶267-306.

1. Independent Claim 19

a. Neibauer, Cheng, and Squibbs fail to teach "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[a])

Petitioner maps the Yahoo! Clubs feature and its ability to allow users to add photographs along with names and descriptions of the photographs as "receiving

content." Pet., pp.13-15. Petitioner also maps the Yahoo! Clubs photo sharing feature as an "application-based information channel" and refers to the mobile information channels or M-channels, as described in the specification of the '039 Patent, for its context. *See id*., pp.16-17. Petitioner then quotes from the specification's description of M-channels to clarify its definition: "allow unsophisticated users to easily and efficiently author message data or other types of information content to be made accessible via a collaborative workspace, a data mailbox, a collaborative community, **or other type of mobile site or portion thereof** generated or otherwise managed in the system 10." '039 Patent, 8:5-11, (emphasis added).

In Petitioner's haste to map Yahoo! Clubs to the application-based information channel in the context of the M-channel described in the specification, Petitioner failed to recognize that the M-channel corresponds to *a mobile site or a portion thereof*. In this way, Yahoo! Clubs cannot be interpreted as teaching an application-based information channel that permits interaction with a user of a mobile device, as constructed above, because Yahoo! Clubs is not a mobile site or a portion thereof that permits interaction with a mobile device. Instead, Yahoo! Clubs is a traditional website that cannot be implemented on a mobile device having limited display space and navigational capabilities, and thus suffers from the issues

identified in the ‘’039 Patent for managing content provided from mobile devices using “conventional techniques.” ’039 Patent, 1:53-61.

Petitioner recognizes this deficiency and attempts to assert that the laptop computer could access the Yahoo! Clubs feature via web browser software because the specification makes a *single mention* of a laptop computer in a list of possible mobile devices. Pet. p.18. However, as discussed above, a laptop computer interacting with an application-based information channel to insert content would not suffer from any of the identified issues described in the patent related to “provide optimal presentation consistent with *the limited display space and navigational capabilities of typical mobile devices*.” ‘039 Patent, 1:34-48. Indeed, conventional laptop computers presented visualizations in a similar fashion as desktop computers. Medvidovic, ¶278. As such, it is unreasonable to interpret a laptop computer accessing the Yahoo! Clubs feature as an application-based information channel permitting interaction with a mobile device, as recited in 19[a]. Indeed, Petitioner admits that a conventional laptop computer providing the same functionality as desktop computers could run web browser software to visit web pages on the Internet. Pet., p.18. Since the Yahoo! Clubs feature is only described as being accessible via conventional computing devices unencumbered by the display and navigational limitations of typical mobile devices, the Yahoo! Clubs feature does

not correspond to an application-based information channel permitting interaction between a mobile device user and others.

With regard to construing the mobile device as a handheld device, Petitioner referred to the "Yahoo! Mobile" and the "Yahoo! To Go" features in Neibauer in an attempt to cure the deficiency noted above. Pet., p.19. Petitioner admits that Neibauer does not expressly disclose that Yahoo! Clubs was accessible via mobile devices but feebly asserts that it would be obvious to extend Yahoo! Clubs to mobile devices. *Id*. Petitioner first argues that it would have been obvious to make Yahoo! Clubs available for use on a mobile device because Yahoo! itself made certain other services available for use on personal digital assistants ("PDAs") through its Yahoo! Mobile and Yahoo! To Go services. *Id*. But the primitive Yahoo! services available on a PDA via Yahoo! Mobile and Yahoo! To Go reflected the "limited memory, slow data transmission, and small screens" the experts agree were available on mobile devices at the time. Medvidovic, ¶¶109 and 279; EX1002 ¶105 (citing EX1012 p.320); *see also* EX1003, 171:

Neibauer, p.171.

All these examples are designed to only fill the width of the PDA screen and are text only, with no images at all. Again, this is not surprising: memory, bandwidth, and screen space at the time were at a premium. Medvidovic, ¶107. Compare these minimalist renditions to desktop browser views of some of the Clubs functionality Petitioner relies on:

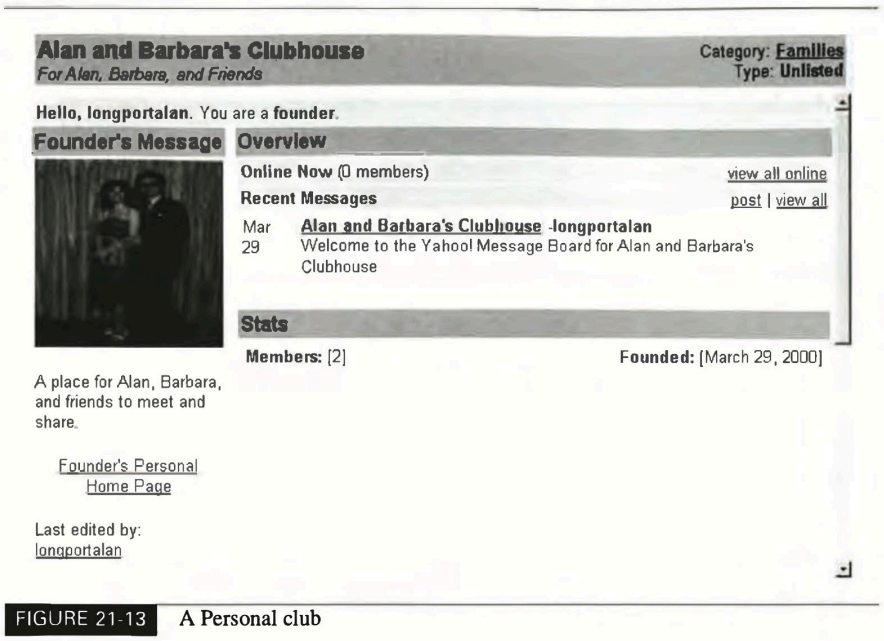


FIGURE 21-13 A Personal club

The James Bond Movie Series Category: James Bond Serie
The James Bond place to talk about the movies Club Type: Liste

Blueraja's BOND GIRL Album Back To: Album List

Created by blueraja3 on 22-Nov-1999

Showing 1 - 12 of 12 photos | View Thumbnails Add Photo

Photo Name and Caption	Contributor	Size	Posted	Edit	Delete
Denise Richards - Stunning Blue Bikini	blueraja3	21 KB	22-Nov-1999		
Denise Richards - Seductive Stare	blueraja3	22 KB	22-Nov-1999		
Denise Richards - Sexiest Denise Pic	blueraja3	48 KB	22-Nov-1999		
Denise Richards - Too Sexy! Too Sexy!	blueraja3	13 KB	22-Nov-1999		
Famke Janssen - Modeling Lingerie	blueraja3	53 KB	22-Nov-1999		
Famke Janssen - Sexiest Bond Girl Ever	blueraja3	13 KB	22-Nov-1999		
Famke Janssen - Sexy Black Leather	blueraja3	10 KB	22-Nov-1999		

FIGURE 21-10 **Club photo album**

EX1003, p. 483 (Figure 21-13, club home page), p. 478 (Figure 21-10, club photo album).

Petitioner relies on the two-way sharing of photos with mobile devices: mobile devices being able to receive and view the Yahoo! Clubs website, as well as upload pictures to club photo albums ("Add Photo" button in Figure 21-10). Pet. 13-15. Neibauer's Yahoo Mobile! and Yahoo! To Go examples, however, do not disclose any ability of the mobile devices to upload pictures to club photo albums.

With that in mind, Petitioner's bare assertion that it would have been obvious to provide Clubs through Yahoo Mobile and/or Yahoo! To Go (Pet. 19) is purely conclusory and unsupported by record evidence. *See* Medvidovic ¶109. Petitioner argues that a POSITA would have been motivated by market forces, but this too is

conclusory and unsupported and does not even attempt to explain what these supposed market forces would be that Yahoo!, one of the leading Internet portals at the time, was not already subject to. Indeed, the story told by the record evidence is that Yahoo! did not already provide Yahoo! Clubs functionality through Yahoo Mobile and Yahoo! To Go was because contemporaneous mobile devices were incapable of supporting it. *Id*., ¶282.

Weary of the strained use of Yahoo! Mobile to obviate this feature, Petitioner pivots to a fallback[2] obviousness combination by adding Cheng's translation proxy server. Pet. 19. But Petitioner already argued it would have been obvious to adapt Neibauer to provide Clubs through Yahoo Mobile and Yahoo! To Go based on Neibauer alone, and does not articulate any purported differences in capability between Yahoo Mobile or Yahoo! To Go and Cheng's translation proxy server that would have caused a POSITA to find Yahoo Mobile or Yahoo! To Go deficient in a way that Cheng would solve. Medvidovic, ¶¶123 and 283.

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[2] Despite Petitioner presenting Yahoo! Mobile/Yahoo! To Go and Cheng as alternative obviousness theories, some limitations in the grounds appear dependent on the Neibauer-Cheng combination (e.g., limitation 19(d) (Pet. 42)). This is consistent with Petitioner not advancing any grounds using Neibauer without Cheng.

Nevertheless, Petitioner presents Cheng as a universal solution "capable of converting and reformatting any existing HTML-based web page into a format suitable for display on a mobile device" (Pet. 23), but that careful language ignores the fact that Cheng's conversion process applied not only to the ***format*** of a web page, but also to its ***content*** and ***capabilities***. Indeed, Cheng freely acknowledges that its aspirational goal of a universal website translator for mobile devices was practically and perhaps significantly limited by the capabilities of those devices. *Id*. at ¶127.

To this end, Cheng provides six columns of exemplary "SW-Transforms" that might be used to convert, downscale, and/or completely delete content from an original website such that the remainder might be successfully displayed on a mobile device, but again Petitioner offers no evidence of the capabilities required by the Yahoo! Clubs webpages shown in Neibauer beyond conclusory, unsupported statements cut-and-pasted by its expert. *See id*. at ¶127. Indeed, Cheng's down conversion process involves removing HTML tags from the original web page to accommodate the capabilities of the browser on the mobile device presenting the reformatted web page 122. *See* Cheng, 12:55-64; Medvidovic ¶285.

As discussed above, the capabilities of browser applications implemented by mobile devices in the early 2000s were extremely limited. To perform any web browsing functionalities, these mobile devices employed certain protocols, such as

Wireless Application Protocol (WAP), iMode, compact HTML, and other protocols to facilitate access to mobile versions of traditional websites. *See* Medvidovic, ¶286 citing EX2017 and EX2018. These protocols enabled mobile devices, limited by processing power, memory, storage, screen size, bandwidth, and input methods, to access mobile versions of websites *but provided limited support for complex elements like tables, jpeg images, and fonts*. *See id*. citing EX2019.

In view of the protocols available at the time on mobile devices, a POSITA would look to Cheng to remove HTML tags from web pages that included input elements related to sending content to a server via the mobile device based on the mobile device's inability to support those types of functions. *Id*., at ¶287. As such, Cheng would more likely be used to ***remove the ability*** to add photos to a mobile version of Yahoo! Clubs when down converting the Yahoo! Clubs webpage from mobile device use in view of the limited capabilities of the mobile device user. *Id*. Nevertheless, there is no record evidence that Cheng's translation tool could have been successfully applied to the Yahoo! Clubs webpages for any mobile devices available at the time, and, if so, whether the functionalities Petitioner relies on would have worked.

Regardless of whether it was feasible for Cheng to translate the Yahoo! Clubs webpages for mobile device use, there is no suggestion as to Cheng being capable of supporting upstream data transfers of content for insertion into an application-

based information channel permitting interaction between a mobile device user and others. That is, Cheng only provides for transmission of a request 106 for a website to be displayed on a mobile device but does not provide any mechanism for sending content for insertion into a channel from the mobile device in the other direction (i.e., sending data from the mobile device to the server hosting the website). *Id.*, ¶¶119-123, 288. The request 106 merely includes an HTTP request for accessing a web page 104, such that a reformatted web page 122 is returned to the mobile device. Cheng, 3:58-63, 5:46-49. The request 106 is thus just an attempt to access the Yahoo! Clubs page and cannot be construed as being the same as content that is designated for insertion into a previously established application-based information channel permitting interaction between a mobile device user and others. Medvidovic, ¶120.

Petitioner proposed that the web-based club photo sharing features, including uploading photos to photo albums, in Neibauer would be obvious to be made available to mobile device without providing any evidence as to how Cheng or Neibauer would be capable of facilitating that functionality. Patent Owner reminds the Board that it is Petitioner's 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. As such, Patent Owner stresses that is no reasonable expectation of success in enabling Cheng or Neibauer

to provide functions related to using a mobile device to send any type of content for insertion into an application-based channel permitting interaction with the mobile device because Cheng only describes a process for converting web pages published on the Internet for view on a mobile device. *See* Medvidovic, ¶¶174-177 and 288.

"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*, at 1380-81 (emphasis added). Since the Petitioner has not provided any evidence on the record to support to support the legal conclusion that the reformatted web page 122 provided to the mobile device in Cheng would include the ability to insert content into an application-based information channel permitting interactions with a mobile device, Petitioner failed to carry its burden as to this limitation.

b. *Neibauer, Cheng, and Squibbs fail to teach "receiving, at a server from a mobile device, information associated with at least one wireless network of the mobile device;" (19[b])*

Petitioner maps the textual name and description of the photo provided to the Yahoo! Clubs feature as "wireless networking functionality." Pet., pp.29-31. Petitioner further clarifies the textual information providing a name and description of the photo corresponds to a "messaging action" and a "collaboration action" in the context of examples of wireless networking functionality examples provided in the

'039 Patent. *See id*. Petitioner then haphazardly states that the proposed combination, without specifying any particular combination, would render "information associated with at least one wireless networking functionality of the mobile device" as obvious in the form of messaging actions of a club member through a mobile device, such that the messaging content would be accessible to club members via Yahoo! Clubs. *Id*., at 31. As established above, neither Neibauer nor Cheng, alone or in combination with each other, teaches or suggests a mobile device capable of sending content for insertion into the claimed channel from a mobile device. Moreover, Petitioner has provided no evidence on the record that discloses enabling a mobile device to provide textual information for insertion into the Yahoo! Clubs webpage. Accordingly, Petitioner is relying on a conclusory statement unsupported by objective evidence to assert that Neibauer and/or Cheng teaches receiving information associated with a wireless networking functionality of a mobile device, as recited in 19[b], which is insufficient under established caselaw. *In re Magnum Oil Tools*, at 1380-81.

Further, Petitioner ignores a key phrase in which dependent claims 6 and 7, as well as the specification, characterizes the term, "wireless networking functionality." That is, Petitioner ignores the language indicating that the messaging action or collaboration action is *implementable over a wireless network*. As shown in FIG. 1, the "wireless network" is a network connected to *but different than the*

Internet. '039 Patent, 3:42-46, FIG. 1A. More specifically, the specification explains that mobile devices 15-1…15-n are coupled to wireless network 12, which is coupled to Internet 14. *Id*.

Referring now to information associated with a wireless network functionality, the specification provides examples of this information, such as information specifying a messaging action *implementable over the wireless network*, information specifying a collaboration action *implementable over the wireless network*, and information specifying location-based services *implementable over the wireless network*. *Id*., 5:57-63. Moreover, the specification clearly notes that one type of wireless networking functionality includes providing access to the Internet. *Id*., 1:38-43. As such, a POSITA would clearly recognize that information of the wireless networking functionalities, as claimed in '039 Patents, corresponds to information related to capabilities provide by the wireless network 12, *not* the Internet 14. *See* Medvidovic, ¶89. Accordingly, in order to teach or suggest "information associated with at least one wireless functionality of the mobile device," Neibauer or Cheng must disclose a functionality that is capable of being performed by a mobile device accessing the wireless network. *Id.*, ¶293. In other words, the functionality must rely on the wireless network that *may* connect the mobile device to the Internet and cannot include functionalities that are only implementable using the Internet without the wireless network. *Id.*

It is clear that the textual information provided in Neibauer for insertion into Yahoo! Clubs is not a wireless functionality implementable using a mobile device via a wireless network (e.g., independent of the Internet). *Id.*, ¶294. As discussed above, Yahoo! Clubs is a webpage that is only accessible via a conventional computer and hosted on an Internet website. Neibauer, p.473 (referencing http://clubs.yahoo.com/). As such, all of the functionalities provided by Neibauer are implementable while a user is accessing the Internet and independent of a wireless network that connects the user's device to the Internet. *See* Medvidovic, ¶100, 294. That is, the functionality for providing messaging or collaboration actions is implementable via the Internet. *Id*. at ¶294. The wireless network and the wireless network functionalities of the mobile device never come into use in Neibauer. Indeed, there is no suggestion in Neibauer that a mobile device can use a separate wireless network to connect to the Internet and provide content for insertion into Yahoo! Clubs. As discussed above, Yahoo! Mobile is limited to only receiving events and alerts pushed from the Internet to the mobile device. *See* Neibauer, pp.166-180; Medvidovic, ¶294. Moreover, as discussed above, Petitioner provides no evidence as to Yahoo! Mobile being capable of providing the ability for mobile device users to provide any content for insertion into Yahoo! Clubs.

Cheng fails to cure this deficiency. As mentioned above, Cheng only describes sending a request 106 for accessing a web page 104 and never provides

the ability to send a message or collaboration action towards the servers hosting the web page 104. Cheng, 3:58-63; Medvidovic, ¶295. As such, Cheng does not disclose a wireless networking functionality of a mobile device implementable over a wireless network other than the ability to send a website request, which is not integrated into a channel for use by the mobile device. *Id.*

Petitioner also points out that the specification indicates that information associated with a wireless networking functionality corresponds to location information about the mobile device and looks to Squibbs to disclose this element. Pet., p.31. According to this interpretation, Petitioner is asserting that it would be obvious to use the same mobile device that sends the content for insertion into the application-based channel permitting interaction between a mobile device user and others to also send location information as described by Squibbs. However, since neither Neibauer nor Cheng provides the ability to send content from a mobile device for insertion into the mobile device accessible channel, the device described Squibbs would need to disclose this feature to render the proposed combination of Neibauer, Cheng, and Squibbs obvious.

However, Squibbs fails to cure this deficiency. Indeed, Squibbs merely describes sending location information of a cell phone 20 to a PC 5 or a network store 43/45 for storage in location log 100, which is eventually retrieved by the PC 5. Squibbs, ¶¶113-115. In other words, Squibbs never provides location information

or any other content for insertion into a channel permitting interactions between a mobile user and other users. Indeed, Squibbs only describes retrieving the location information for use by an album program 50 that is only described as being executed on a PC 5. Squibbs, ¶0101; Medvidovic, ¶¶297-298.

Petitioner attempts to suggest that a proposed combination of Neibauer and Squibbs would include uploading a photo from a mobile device and transmitting a geographic location associated with the photo from the mobile device. Pet., p. 37. However, as mentioned above, the same mobile device that the Petitioner uses for providing the photo sharing feature of Neibauer cannot be the mobile device of Squibbs. Indeed, Squibbs uses separate devices to send photo data and location data to the network store, and neither device sends the data for insertion or integration into a channel permitting interactions with a mobile device. In fact, Niebauer is only accessible via the Internet and a conventional computer, while the photo data and the location data are only accessible to the PC 5 (another conventional computer) in Squibbs. Medvidovic, ¶298.

Moreover, Petitioner's suggested combination of Neibauer, Cheng, and Squibbs is gleaned due to improper hindsight. When prior art references require a selected combination or modification to render obvious a subsequent invention, there must be some reason for the combination or modification other than the hindsight gained from the invention itself, i.e., *something in the prior art as a whole*

must suggest the desirability, and thus the obviousness, of making the combination or modification. *See Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). With this in mind, nothing in the prior art references is suggesting the proposed combination. Medvidovic, ¶¶299-300. Instead, the Petitioner, without any evidentiary basis, is suggesting that it would be obvious to modify the Yahoo! Mobile feature, which only describes mobile devices as receiving limited data types (e.g., events, alerts), to display the complex map graphics of Yahoo! Maps *and* present location information on the displayed maps as described by Squibbs. In other words, Petitioner never provides *any objective evidence in Neibauer or Squibbs* that provides any reasoning as to the desirability for making the proposed modification. For example, Petitioner asserts that the photo sharing feature would be adapted to display location information associated with photos uploaded by club members. Pet., p.37. However, the photo sharing feature of Yahoo! Clubs only mentions including a name and description of the photo as data types to be added to the uploaded photos. *See* Neibauer, p.478 and FIG.21-10. Neibauer never mentions the desirability of adding location information to the added photos.

Further, Neibauer provides the ability to organize photos into user-defined albums that are added by the user. *Id.*, p.479. As such, Neibauer provides an adequate means for organizing photos. Medvidovic, ¶301. Nevertheless, Petitioner

asserts that the ability to associate a location with a photo would provide a benefit by improving the classification of the photos, which Squibs explains has been a problem for families and individuals needing to have a logical organization that is valid over a lifetime and intuitive for the user. *See* Squibbs, ¶2. However, since Neibauer never describes its user-based classification technique for organizing photos as being problematic with respect to organizing the photos, and since none of the photos or albums described in Neibauer are even remotely related to a location (e.g., Blueraja's BOND GIRL ALBUM, James Bond of FIG. 21-10), there is no objective evidence on the record to reason that a POSITA would be motivated to combine Neibauer with Squibbs to include location information in the proposed manner outside of the improper hindsight that the Petitioner has gleaned from the invention. *See* Neibauer, p.477.

Petitioner also attempted to suggest that it would be obvious to adapt the photo sharing feature of Neibauer to display location information associated with photos uploaded by club members via a map-based user interface of Squibbs as an extension of the Yahoo! Maps feature. Pet., p.38. Again, Petitioner makes huge leaps of logic in asserting that the proposed combination would be obvious without citing to any evidence in the prior art. Indeed, although Neibauer described how a user could annotate a map to identify objects of interest, none of these annotations are related to locations of photos as suggested by Squibbs. Neibauer, pp.226-228.

Indeed, Petitioner merely concludes that Neibauer's ability to display maps and its suggestion to annotate them with locations is naturally combinable with Squibbs. Pet., p.39. However, Neibauer never mentions the desirability of presenting locations of photos on its map, and Squibbs never mentions the desirability of sharing location data for photos to be shared on an Internet-based platform for others to view. Instead, Squibbs is limited to view on the PC 5 for an individual user to allow the user to achieve a logical organization of photos that is valid over a lifetime and intuitive for the user. *See* Squibbs, ¶¶2 and 112. As such, neither Neibauer nor Squibbs provides any evidence within the prior art references themselves as to the desirability of the Petitioner's proposed combination, which is only achieved by hindsight bias. Medvidovic, ¶¶301-302.

c. *Neibauer, Cheng, and Squibbs fail to teach "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;" (19[c])*

As mentioned above, none of the prior art references disclose inserting or integrating content and a wireless networking functionality of a mobile device received from the mobile device into a previously established application-based information channel permitting interaction between a user of a mobile device and one or more additional users, as required by claims 19[a], 19[b], and 19[c]. Under a first theory, Petitioner's mapping of Neibauer's club photo sharing feature to the previously established application-based information channel fails to teach this

limitation because the photo sharing feature fails to permit interaction between a user of a mobile device and one or more additional users, as required by 19[a]. Pet., p.41; Neibauer, p.477. Moreover, Cheng fails to cure this deficiency because Cheng merely converts original web page 104 into reformatted webpage 122 and never provides the functionality for sending content for insertion or integration into a channel permitting interaction between a mobile device user and other. Cheng, 5:46-49. Finally, Squibbs merely sends location data to a network store 43/45 or the PC 5 for use by an album program 50 executable on the PC 5 and never provides access, let alone content, to a channel permitting interaction between a mobile device user and other. Squibbs, ¶¶112-115; Medvidovic, ¶303.

Under a second theory, Petitioner asserts that the photo sharing feature of Neibauer shown in FIG. 24-10 could be adapted to display an electronic map of where the photo was taken as disclosed in Squibbs. Pet., pp.41-42. Although the proposed combination is only achieved through impermissible hindsight as discussed above, the combination still fails to disclose integrating content and a wireless networking functionality of a mobile device received from the mobile device into a previously established application-based information channel permitting interaction between a user of a mobile device and one or more additional users, as required by claims 19[a], 19[b], and 19[c]. That is, the photo sharing feature of Neibauer, the maps feature of Neibauer, and the maps feature of Squibbs

are not capable of permitting a user of a mobile user to interact (e.g., act reciprocally) with one or more additional users. Medvidovic, ¶¶304-306. Indeed, Neibauer and Squibbs are only accessible via conventional computers—not mobile devices with limited display space and limited navigational capabilities.

2. Claim 20

Claim 20 depends from claim 19 and requires "wherein integrating the content and the information associated with said at least one wireless networking functionality of the mobile device comprises: [a] obtaining location information of the mobile device; and [b] inserting additional content into the previously established application-based information channel based on the obtained location information." As established above with respect to limitations 19[a], 19[b], and 19[c], none of the prior art references disclose integrating content and a wireless networking functionality of a mobile device received from the mobile device into a previously established application-based information channel permitting interaction between a user of a mobile device and one or more additional users. For the same reasons, none of the prior art references discloses inserting additional content into the previously established application-based information channel based on obtained location information.

3. Independent Claim 22

Claim 22 refers to claim 19 and requires: "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." As shown above, Petitioner has not met its burden of showing the limitations in claim 19 are obvious over the cited art. As such, Petitioner has also not met its burden of establishing the similarly recited elements in claim 22 are obvious in view of Neibauer, Cheng, and Squibbs.

4. Independent Claim 23

With regard to independent claim 23, Patent Owner refers to the Petitioner's deficiencies described above with respect to independent claim 19. That is, Petitioner failed to meet its burden with regard to rendering the elements of claim 19, as well as the similarly recited elements in claim 23, obvious in view of Neibauer, Cheng, and Squibbs.

D. Ground 2: Non-Obviousness of Grounds Based on Neibauer, Cheng, Squibbs, and Bandera (Claim 21)

Ground 2 relies on Ground 1. Because the combination of Neibauer, Cheng, and Squibbs does not render obvious independent claim 19, it cannot render obvious dependent claim 21. Moreover, Bandera (EX1017) does not cure the deficiencies of Neibauer, Cheng, and Squibbs. That is, Bandera, like the other prior art references fail to disclose integrating content and a wireless networking functionality of a

mobile device received from the mobile device into a previously established application-based information channel permitting interaction between a user of a mobile device and one or more additional users.

In contrast, Bandera merely sends location data of a mobile device to a web server, such that the web server can generate a webpage with an advertising object. Bandera, 6:46-7:8. The webpage of Bandera, thus, does not integrate any content or wireless networking functionality into a previously established application-based information channel permitting interaction between a user of a mobile device and one or more additional users. Medvidovic, ¶309. Accordingly, Petitioner has not met its burden with regard to dependent claim 21.

E. Grounds 3-4: Non-Obviousness Based on Ground 1 and Harvey (Claims 19-20, 22-23); and Ground 2 and Harvey (Claim 21)

Grounds 3-4 are the same as Grounds 1-2 except that they add Harvey (EX1010) to account for construction of "application-based information channel" as proposed by Petitioner in litigation. As mentioned above, Patent Owner and Petitioner agree to the plain and ordinary meaning of "application-based information channel" as proposed above, which is different than Petitioner's proposed construction in the litigation, thus rendering these grounds moot.

Nevertheless, because the combination of Neibauer, Cheng, and Squibbs does not render obvious independent claim 19, it cannot render obvious claims 19-23 in

view of Harvey because Harvey does not cure the deficiencies of Neibauer, Cheng, Squibbs, and Bandera. Medvidovic, ¶310. That is, Harvey, like the other prior art references, fails to at least disclose integrating content and a wireless networking functionality of a mobile device received from the mobile device into a previously established application-based information channel permitting interaction between a user of a mobile device and one or more additional users. In contrast, Harvey merely provides a community creating module for creating a web-based community. Harvey, 7:49-46. The web-based community of Harvey does not integrate any content or wireless networking functionality into a previously established application-based information channel permitting interaction between a user of a mobile device and one or more additional users. Indeed, Harvey never mentions a mobile device anywhere in its disclosure. Accordingly, Petitioner has not met its burden with regard to Grounds 3 and 4.

V. CONCLUSION

For the reasons above, Petitioner's proposed grounds of unpatentability fail. Thus, Patent Owner asks the Board to find all challenged claims patentable.

Date: October 1, 2024

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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 Response contains 12,777 words using the word count feature of Microsoft Word.

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CERTIFICATE OF SERVICE

I hereby certify that on October 1, 2024, I caused a true and correct copy of the foregoing Patent Owner's Response to Petition for *Inter Partes* Review to be served via electronic mail upon the following attorneys of record for the Petitioner:

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