EXHIBIT 2005

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

FERID ALLANI, *Plaintiff*, v. APPLE INC., *Defendant*.	Case No.: 6:24-cv-304-ADA JURY TRIAL DEMANDED

DEFENDANT'S INVALIDITY CONTENTIONS AND P.R. 3-3 AND 3-4 DISCLOSURES

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Exhibits

Exhibits A-01 – A-08	Invalidity claim charts for U.S. Patent No. 8,271,877
Exhibits B-01 – B-08	Invalidity claim charts for U.S. Patent No. 10,943,058

. INTRODUCTION

A. Preliminary Statement

Pursuant to Local Patent Rules 3-3 and 3-4 and the Court's Amended Scheduling Orders, Defendant Apple Inc. ("Defendant" or "Apple") provide the following Invalidity Contentions for U.S. Patent Nos. 8,271,877 (the "'877 Patent") and U.S. Patent No. 10,943,058 (the "'058 Patent"), collectively the "Asserted Patents." Apple contends that each of the Asserted Claims is invalid under at least 35 U.S.C. §§ 101, 102, 103, and/or 112.

B. Asserted Patents and Claims

Plaintiff Ferid Allani ("Mr. Allani" or "Plaintiff") asserts the following claims (the "Asserted Claims") of the Asserted Patents against the Defendant in its P.R. 3-1 and 3-2 Infringement Contentions (the "Infringement Contentions") served October 17, 2024:

Asserted Patent	Asserted Claims
'877 Patent	Claims 12, 15, 17-19
'058 Patent	Claims 24-27

For the purposes of these contentions, Apple only addresses those claims specifically asserted by Mr. Allani. Apple's exclusion from these Invalidity Contentions of any patent claims that Mr. Allani has not asserted in its Infringement Contentions is not an admission that those unasserted patent claims are valid. Apple reserves the right to amend or supplement this disclosure as necessary in light of any changes or amendments made, for any reason, to Mr. Allani's infringement theories, Infringement Contentions, or asserted claims.

C. General Reservations

These Invalidity Contentions are based on Defendant's current knowledge of the Asserted Patents and prior art, along with Defendant's understanding of Plaintiff's infringement allegations

set forth in its Infringement Contentions. Defendant's investigation of the prior art is ongoing, and Defendant expressly reserves the right to supplement these Invalidity Contentions as the case proceeds. For example, Plaintiff (or its counsel) or third parties may be in possession of prior art that Defendant may rely on. Defendant expressly reserves the right to supplement these Invalidity Contentions in light of additional information obtained by Plaintiff or through third-parties.

As another example, this case is still at an early stage. Discovery has not yet begun, the Court has not issued its claim construction order or even begun the claim construction process, and Plaintiff has so far provided little information and few documents in discovery. Defendant's investigations and discovery into third-party sources of prior art are also underway but not complete. Defendant may seek third-party discovery related to the prior art, including documents and testimony related to the prior art. Defendant may also commission reverse engineering studies of certain product prior art identified herein. Discovery from these third parties and reverse engineering studies may reveal information that impacts the disclosures and contentions herein. Defendant also has not yet deposed the inventor of the Asserted Patents or their prosecution counsel, and discovery remains ongoing for these patents. Defendant reserves all rights to amend, modify, or supplement these contentions based on information learned through further investigation or discovery following the date of these Invalidity Contentions, in view of the Court's construction of the Asserted Claims, in response to any findings as to the priority date of the Asserted Claims, in reaction to positions that Plaintiff or expert witness(es) may take concerning claim construction, infringement, and/or invalidity issues, and for any other proper reason.

The references disclosed herein and discussed in the claim charts attached hereto may disclose the limitations of the Asserted Claims explicitly, implicitly, or inherently, or they may be relied upon to show the state of the art as of the relevant time. The claim charts cite particular

teachings and disclosures of the prior art as applied to features of the Asserted Claims. However, persons having ordinary skill in the art generally may view an item of prior art in the context of other publications, literature, products, and/or understanding. Accordingly, the cited portions are only examples, and Defendant reserves its right to rely on uncited portions of the prior art references and on other publications and expert testimony as aids in understanding and interpreting the cited portions, as providing context, thereto, and as additional evidence that the prior art discloses a claim limitation. Defendant further reserves the right to rely on uncited portions of the prior art references, other publications, and testimony to establish bases for combinations of certain cited references that render the claims obvious. Defendant further notes that where a figure is cited in a claim chart, the claim chart should be understood to incorporate the detailed description that discusses that figure or any reference number or element that appears in that figure and any claims that claim any element disclosed in that figure. Defendant further notes that where specific passages of the specification are cited in a claim chart, the claim chart should be understood to incorporate any figure that is discussed in those specific passages of the specification and any claims that claim any element discussed in those specific passages of the specification.

Defendant's obviousness contentions and combinations are provided in the alternative to their anticipation contentions and are not to be construed to imply that any prior art reference included in the combinations is not by itself anticipatory. Defendant may present obviousness contentions and combinations in addition and as an alternative to an assertion of anticipation.

Prior art not included in this disclosure, whether known or not known to Defendant, may become relevant. Defendant is currently unaware of the extent, if any, to which Plaintiff will contend that limitations of the Asserted Claims are not disclosed in the prior art identified by Defendant. To the extent that such an issue arises, Defendant reserves the right to identify

additional teachings in the same references or in other references that anticipate or would have made the addition of the allegedly missing limitation obvious.

Nothing in these Invalidity Contentions is intended, nor should be construed, as a waiver of any claim construction argument or non-infringement position. Defendant's statements herein (including the accompanying claim charts) reflect Defendant's present understanding of the purported potential scope of the claims that Plaintiff appears to be advocating by way of its Infringement Contentions. They are not to be seen as any acquiescence to Plaintiff's interpretation of any claims. Defendant disagrees that any such claim scope is proper. Defendant reserves the right to supplement these contentions to address any supplemental infringement contentions. For purposes of these Invalidity Contentions, Defendant identifies prior art references and provides element-by-element claim charts based on the apparent constructions of the Asserted Claims advanced by Plaintiff in its Infringement Contentions. Nothing herein shall be interpreted as an admission that: (1) the Asserted Claims are infringed by any of Defendant's products or instrumentalities, (2) any particular feature or aspect of any of the accused instrumentalities practices any limitation of the Asserted Claims, (3) there is 35 U.S.C. § 112 support for any limitation of the Asserted Claims, or (4) any of Plaintiff's proposed or implied constructions are supportable or proper.

D. Deficiencies with Plaintiff's Infringement Contentions

The Local Patent Rules and the Court's Docket Scheduling Order contemplate that these Invalidity Contentions would be prepared and served in response to Plaintiff's Infringement Contentions. However, Plaintiff's Infringement Contentions are deficient in numerous respects and fail to identify specifically where each element of each asserted claim is found within each Accused Instrumentality. Among other things, the Infringement Contentions lack requisite specificity, do not adequately explain Plaintiff's infringement theories for numerous claim

limitations, do not adequately disclose the alleged factual bases for Plaintiff's infringement allegations, do not specify whether each element of each Asserted Claim is present literally or under the doctrine of equivalents, and present only boilerplate contentions for infringement of many of the claims. To the extent that Plaintiff contends that a claim limitation is found within and met by a particular element of a given Defendant's Accused Instrumentality, Defendant alleges that the existence of that same element in the prior art is also sufficient to meet that same claim limitation.

Defendant's reservation of rights due to the deficiencies with Plaintiff's Infringement Contentions includes the right to search for and identify new or additional prior art and to provide invalidity contentions related to any such art, as well as to amend or supplement their invalidity theories and claim charts in response to any further amendment or supplementation by Plaintiff of its Infringement Contentions.

I. CLAIM CONSTRUCTION

Claim construction proceedings have not yet begun in this case. To the extent that these Invalidity Contentions rely on or otherwise embody particular constructions of terms or phrases in the Asserted Claims, Defendant is not proposing any such constructions as proper constructions of those terms or phrases at this time. The Court established separate deadlines for the parties' proposed claim constructions, and Defendant will disclose its proposed constructions accordingly. For purposes of these Invalidity Contentions, Defendant may adopt alternative claim construction positions. Portions of these Invalidity Contentions, including the claim charts attached as Exhibits, may be based on the underlying claim constructions and/or interpretations as understood from Plaintiff's Infringement Contentions and the claim construction positions Plaintiff has previously taken in cases involving the same or related patents. Nothing stated herein shall be construed as an admission or a waiver of any construction of any claim term or as an admission that Defendant

agrees with Plaintiff's apparent interpretation of the claims. Further, nothing stated herein shall be construed as a waiver of Defendant's right to challenge the Court's claim constructions on appeal on any basis. Defendant's Invalidity Contentions have, at least in part, relied upon Plaintiff's apparent claim construction positions implied by Plaintiff's Infringement Contentions. These Invalidity Contentions are not, and shall not be used as, evidence of Defendant's claim construction positions or contentions. Furthermore, nothing in these Invalidity Contentions shall be treated as an admission that any Accused Instrumentality, or any other product or service, meets any limitation of the Asserted Claims. References to the preamble of a claim in these Invalidity Contentions are not an admission that the preamble is or is not, in fact, a limitation of a claim. Defendant is presently unaware of Plaintiff's claim construction positions, including what terms Plaintiff believes should be construed and any proposed constructions thereof. Therefore, Defendant reserves the right to supplement these Invalidity Contentions in response to any claim construction positions taken by Plaintiff.

Throughout the attached Exhibits, Defendant provides examples of where references disclose subject matter recited in preambles, without regard to whether the preambles are properly considered to be limitations of the Asserted Claims. Defendant reserves the right to argue, at the appropriate stage of this case, that the preambles are or are not limitations.

Moreover, Defendant reserves the right to argue that certain claim elements of the Asserted Claims do not in fact limit the scope of the Asserted Claims.

II. ASSERTED PATENTS

A. Priority Dates of the Asserted Patents

The '877 Patent claims priority to a French application filed December 30, 1999 and a PCT application filed December 29, 2000; the '058 Patent was filed on January 15, 2015, and is a

continuation of an application filed August 14, 2012 (now abandoned), which is a division of the ’877 Patent.

In its Infringement Contentions, Plaintiff contends that the Asserted Patents are entitled to the priority date of the French application filed December 30, 1999, but absent a priority determination by the United States Patent Office, there is no presumption that the Asserted Patents are entitled to such Earlier Application priority dates, and Plaintiff bears the burden of establishing such priority. *PowerOasis, Inc. v. T-Mobile USA, Inc.,* 522 F.3d 1299, 1305-06 (Fed. Cir. 2008) (“PowerOasis has conceded that unless the asserted claims are accorded an earlier filing date than the 2000 CIP Application, the MobileStar Network is § 102(b) prior art. Once T-Mobile established by clear and convincing evidence that the MobileStar Network was § 102(b) prior art to the asserted claims…, the burden was on PowerOasis to come forward with evidence to the contrary. The district court therefore correctly placed the burden on PowerOasis to come forward with evidence to prove entitlement to claim priority to an earlier filing date.”). Defendant contends that the priority dates of the Asserted Patents are no earlier than December 29, 2000 for the ’877 Patent and September 9, 2014 for the ’058 Patent. To date, Plaintiff has presented no evidence showing entitlement to the priority date of the French application to which they claim priority. Absent such evidence, Defendant denies that the Asserted Patents are entitled to the priority dates Plaintiff alleges, and Defendant reserves the right to rebut any evidence of an earlier priority presented by Plaintiff.

B. State of the Art

Defendant sets forth a summary of its current understanding of the state of the art for general subject matter of the Asserted Patents as follows and in the Sections regarding the Disclosures of the Asserted Patents below. Defendant expressly reserves the right to rely on each of the prior art references discussed below or in its invalidity contentions Exhibits with respect to each of the

Asserted Claims for purposes of demonstrating the State of the Art for the Asserted Patents. *See* Exhibits A to B. Defendant also reserves the right to rely on the discussions of the state of the art and prior art for the Asserted Patents and their file histories in explaining the state of the art and the references' correspondence with the claims of the Asserted Patents. Defendant further expressly reserves the right to supplement its summary of the state of the art, including for example, by information from any of the authors or named inventors on any of the prior art references, by personnel familiar with systems based on any of the prior art, or by technical experts retained on behalf of any party.

1. Applicants' Admitted Prior Art

Statements made by the Applicants during prosecution of the Asserted Patents and statements and representations made by Plaintiff accusing the Defendant of infringing the Asserted Patents by implementing prior art technology constitute "Applicants' Admitted Prior Art" or "AAPA".

Statements made by the Applicants in the specification and/or during prosecution of the Asserted Patents and any related patents/applications, such as in the "Background of the Invention" section that describe the related art known to the Applicants, are admissions that can be relied upon for both anticipation and obviousness determinations, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories set forth in 35 U.S.C. § 102. *See* MPEP §§ 2129 and 608.01(c).

Defendant reserves the right to rely on Applicants' Admitted Prior Art to demonstrate the invalidity of the Asserted Claims.

2. Apparatuses For Accessing Information on the Internet Were Known

As the Asserted Patents admit, at the time of the alleged inventions, the use of the Internet and Web for accessing information and sources was drastically increasing. In particular,

navigation software like Internet Explorer™ and/or Netscape Navigator™ were widely used and equipped every personal computer and workstation connected to the internet. These navigation software systems permitted access to search engine sites such as Yahoo!™ or Voila™ allowing queries which yielded website results classified in order of relevance. Additionally, "portal" sites, the function of which is proposing to a user direct access to some pre-selected sites and access to heading was being developed at the time of the invention. The Asserted Patents admit that "Document EP0847019 discloses a method for selecting an item of information in an information processing system, wherein a user is provided with an access to two items of information through respectively two structures of multi-levels hierarchical menus. The second structure of menu comprises at least the sub-menus provided in the first structure of menu and the second sub-assembly includes at least the items of information included in the first sub-assembly. A user leaving the first structure of menu in a particular sub-menu enters the second structure of menu in a sub-menu that corresponds to this particular sub-menu."

The prior art discloses apparatuses for accessing information on the internet using mobile or cellular devices. For example, U.S. Patent No. 5,983,073 ("Ditzik"), which was filed on April 4, 1997, and therefore qualifies as prior art under 35 U.S.C. § 102(e), discloses a "small light weight modular microcomputer based computer and communications system." Ditzik, Abstract. Ditzik discloses a device capable of "cellular or PCS communications" capable of relaying "voice and data information to/from a wide area communication network." Ditzik, 2:58-65. Ditzik's device "provide[d] full Internet access on a wireless mobile platform, where the user can access the World wide web and execute most of the available Internet browser functions and plug-ins. The computer system would be capable of performing most of the Internet data access, download, upload and conferencing functions." Ditzik, 3:15-21.

The prior art also discloses apparatuses for accessing information on the internet using selection pages organized in a tree manner that allow a user to directly access a particular website. For example, U.S. Patent No. 5,781,909 ("Logan"), which was filed on February 13, 1996, and therefore qualifies as prior art under 35 U.S.C. § 102(e), discloses "[a] network based hypertext display system employing a supervisory computer interconnected with one or more information display units and one or more remote document serves via a network, such as the Internet…The control file determines the extent to which the display unit can access remotely stored information and provides additional information which is used to alter the presentation to the user." Logan, Abstract. Logan discloses that "[i]nteractive displays which are closely similar is style and content to those needed for kiosk systems are now being created in large quantities by businesses seeking the exposure offered by the World Wide Web, the Internet system of interlinked hypertext documents. Businesses, institutions and individuals are presenting a rapidly increasing volume of promotional, tutorial, entertainment, and reference information on interactive 'web pages made' and available to any computer having standard web browsing software and Internet service connection." Logan, 1:31-40.

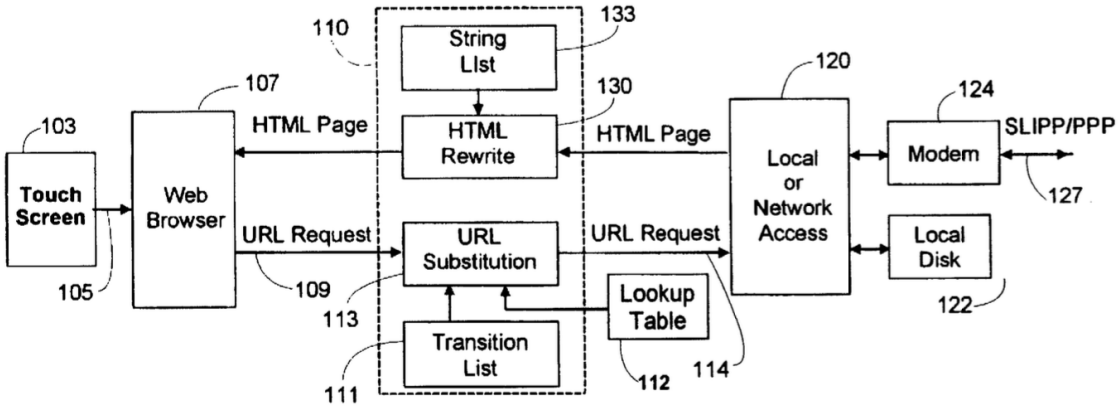

Fig. 2

Figure 2 is a block diagram of the principal components of a controlled access HTML display system employed to implement an embodiment of the kiosk unit employing the invention. Logan at Fig. 2; 2:47-51. Figure 2 discloses a network based hypertext display system employing a supervisory computer interconnected with one or more information display units and one or more remote document servers via a network, such as the Internet. Logan, Abstract.

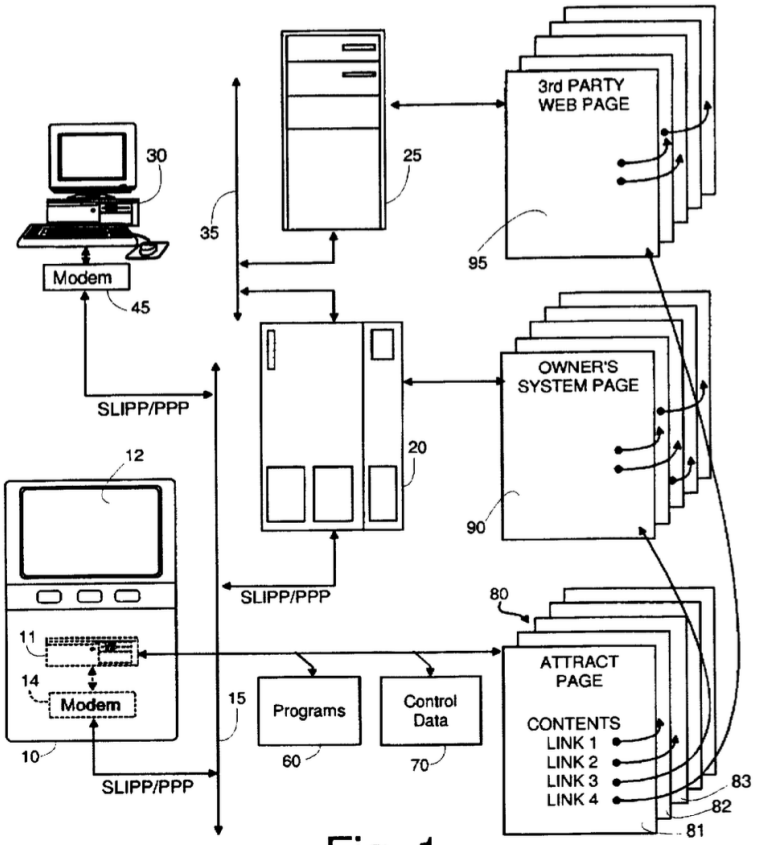

Fig. 1

Figure 1 provides an exemplary embodiment of the inventions disclosed in Logan, specifically, an illustration of the principal components used to implement a programmable, interactive HTML display kiosk system. *Id*. at 2:44-46. As shown in Figure 1, an interactive computer display kiosk **10** which implements the invention consists of a kiosk cabinet within which a personal computer **11** and a touch-screen monitor **12** are mounted. The personal computer **11** is connected via a modem **14** and dial-up or leased telephone lines **15** to a remotely located computer **20** which provides a conventional serial data SLIPP or PPP modem link to the Internet service. The remote computer **20** also operates as a World Wide Web server and is connected via high-speed Internet TCP/IP Internet network lines **35** to other computers on the Internet, such as the second web server computer seen at **25**. The servers **20** and **25** provide access to stored

information to connected client computers such as the kiosk **10** and a person computer **30** which is also connected via a modem SLIPP/PPP connection over the telephone lines **15** to computer **20**. The modem **14** provides data communications via the telephone SLIP/PPP lines **15** while a modem **45** similarly provides data communications for the personal computer **30**. Logan at 3:30-50.

Logan also discloses the above method, wherein a preliminary search for information or service, locally performed within said communication device in different themes and sub themes within a plurality of successively displayed selection pages, said selection pages being organized in a structure of tree menu and beforehand locally stored within said communication device, each said selection page comprising a set of icons for directly accessing an information- or service-providing web site and one or more selection icons for locally accessing and displaying another selection page within said structure of tree menu, wherein at least one of said selection pages comprises two or more direct access icons. For example, Logan discloses that, in Figure 1, "the hypertext documents stored locally on the hard disk of the kiosk computer **11** preferably includes an attract page **81** which, as illustrated, might contains imbedded hypertext links LINK1 AND LINK2 to other locally stored pages **82** and **83** respectively, as well as LINK3 to a home page **90** stored by the web server computer **20**, and LINK4 to a further web page **95** stored on the web server computer **25**. By touching the touchscreen **82** at the position where highlighted text, or a graphic, which visually represents the linked subject matter appears, the kiosk user can request the display of the linked information, which itself typically contains links to other web pages, and so on." *Id*. at 4:55-65; *see also id.* at 14:14-23 ("The automated development session depicted in FIG. 9 begins with the display of the kiosk's 'attract page' which constitutes the root page for the hierarchy of pages which are associated by hypertext links. The attract page, illustrated by the page **81** seen in FIG. 1 is advantageously stored on the kiosk computer's local hard drive during

normal use. In the absence of any activity by a user of the kiosk for a predetermined timeout duration, the kiosk computer automatically restores the display of the attract page so that all users are presented with the same beginning point."); Figs. 6 and 8 (disclosing "anchor images").

Logan further discloses the above method, comprising a step for emitting on the communication network, in response to a selection of a direct access icon in a selection page being currently displayed, an address of an information- or service-providing web site corresponding to said selected icon, said address being locally generated during the display and selection steps and directly accessing said information- or service-providing web site. For example, with respect to Figure 2, Logan discloses that "[t]he access mechanism 120, like the web browser program 107, is convention URL's which translate into local disk addresses, such as: 'file:C\\WINDOWS\Desktop\HTML\HOME.HTM' are accessed directly from local storage, whereas URL's which identify information stored on remote servers, such as: http://www.micotouch.com/products/rj234.hnnl/ are retrieved by the kiosk computer utilizing TCP/IP software, such as the dynamic link library WINSOCK.DLL for Windows 3.1 or WSOCK32.DLL supplied by Microsoft with Windows 95. Depending on the content of the URL in the request 114, the linked data specified by the URL Request 114 is obtained either from the kiosk's local storage system, illustrated by local disk 122 in FIG. 2 or by transmitting an http/ip Internet message requesting the information via a modem 124 and SLIP/PPP connection 126 to the remote Internet web server (not shown) which holds the requested information." *Id*. at 6:25-67.

III. INVALIDITY UNDER 35 U.S.C. §§ 102 and 103

Defendant contends that each Asserted Claim is invalid at least under 35 U.S.C. § 102, including pre-AIA subsections 102(a), 102(b), 102(e), 102(f), and 102(g), and/or under 35 U.S.C. § 103. Pursuant to the Scheduling Order and the Local Rules, Defendant's contentions as to how

each identified prior art reference either anticipates or renders obvious the Asserted Claims are described in detail in the following section and in Exhibits A to B.

Subject to Defendant's Introduction, Preliminary Statement, and other reservations listed herein, Defendant identifies the prior art patents, publications, and systems in the tables below and in Exhibits A to B, which anticipate and/or render obvious the Asserted Claims. Each prior art reference identified in Exhibits A to B expressly, implicitly, or inherently anticipates or renders obvious one or more of the claims of the Asserted Patents, either alone or in combination with other prior art references (specifically, the references disclosed in in Exhibits A to B, as explained in more detail below) or the knowledge of those of ordinary skill in the art at the time of the alleged invention. Additional anticipatory references and obviousness combinations are possible, and Defendant reserves the right to identify any such additional references or use any such additional combinations. In particular, Defendant is unaware of the extent, if any, to which Plaintiff will contend that the claim limitations are not met by the prior art identified by Defendant, or to which Plaintiff will contend that certain prior art references cannot or would not be combined. To the extent that an issue arises with any such limitation, elements, or combinations, Defendant reserves the right to identify other prior art references, disclosures, or combinations that would have made obvious the addition of the allegedly missing claim limitation.

Additionally, persons of ordinary skill in the art at the time of the alleged inventions generally read a prior art reference as a whole and in the context of other publications and literature. Numerous prior art references, including those identified herein and in the attached exhibits, reflect common knowledge and the state, scope, and content of the prior art before the priority date of the Asserted Claims of the Asserted Patents. Defendant may rely on uncited portions of the prior art references and on other publications and expert testimony to provide context and as aids to

understanding and interpreting the portions that are cited. Defendant further notes that certain references, often only describe that which is new and do not describe those features and elements that are well-known to a person of ordinary skill in the art. For example, a literature reference may describe methods and devices for accessing information sources and services on the Internet without describing the elements that are needed to perform these methods. In such a case, Defendant intends to rely on one or more of the references set forth herein for the disclosure of such well-known elements, and Defendant reserves the right to include expert testimony and other background references for such purposes.

If, and to the extent, Plaintiff challenges the correspondence of the references in the Exhibits with respect to particular limitations of the Asserted Claims of the Asserted Patents, Defendant reserves the right to supplement these Invalidity Contentions to identify additional combinations, motivations to modify, or explanations for particular references with additional particularity.

Additionally, Defendant believes that certain non-parties and current or former employees thereof may have possession of relevant information and/or documents constituting prior art to the Asserted Patents. Defendant is continuing its investigation into these and other companies and its products. Defendant reserves the right to supplement these Invalidity Contentions to identify additional references, combinations, motivations to modify, or explanations for particular references based on any information and/or documents provided by the former employees and/or successors-in-interests of companies or individuals who may possess relevant information and/or documents constituting prior art to the Asserted Patents. The concepts disclosed and claimed in each of the Asserted Patents are not new, and had been disclosed, used, offered for sale, sold, and practiced by others prior to the claimed priority date of the patents. The prior art identified herein

and in the Exhibits, individually or in combination, invalidates the Asserted Claims under 35 U.S.C. §§ 102 (a), (b), (e), (f), (g) and §103. Because discovery has just begun, Defendant expects to gather additional information about the identified prior art, and other prior art, through third-party discovery or other discovery, and thus may amend and supplement these Invalidity Contentions, if necessary once they obtain that discovery and have meaningful and reasonable time to analyze it. As described in more detail below, claims of the Asserted Patents are also invalid under 35 U.S.C. §§ 101 and 112.

A. Identification of Prior Art

1. Prior Art Patents and Published Patent Applications

Defendant identifies the following prior art patents and published patent applications that anticipate and/or render obvious the Asserted Claims, and/or are background evidence of the state of the art.

Patent Number / Patent Publication	Country of Origin	Filing Date or Priority Date	Date of Issue/Publication
U.S. Patent No. 5,781,909 ("Logan")	United States	Feb. 13, 1996	July 14, 1998
U.S. Patent No. 6,526,424 ("Kanno")	United States	Sep. 29, 1997	Feb. 25, 2003
U.S. Patent No. 6,658,418 ("Burns")	United States	Feb. 27, 1996	Dec. 1, 2003
EP09442181A1 ("Ringot")	France	Mar. 16, 1999	Sep. 22, 1999
JPH11-068823 ("Shoichi")	Japan	Aug. 11, 1997	Mar. 9, 1999
WO 99/61984 ("Hawkins")	France	May 29, 1998	Dec. 2, 1999

2. Prior Art Non-Patent Publications

Defendant identifies the following prior art non-patent publications that anticipate and/or render obvious the Asserted Claims, and/or are background evidence of the state of the art.

Title	Author/Publisher	Date of Publication
NetHopper Version 3.2 User's Manual	AllPen Software Inc.	1997
Smartcode HandWEB Web browser for PalmPilot™ and Palm III™	Smartcode Software, Inc.	1998
A bookmarking service for organizing and sharing URLs	Keller *et al.*, Computer Networks and ISDN Systems, Volume 29	1997
Using CompuServe	Ellsworth *et al.*, Que Corporation	1994
Using CompuServe	Stevenson *et al.*, Que Corporation	1995
The Tablet Newspaper[1]	Knight-Ridder, Inc. Information Design Lab	1994
An Empirical Evaluation of User Interfaces for Topic Management of Web Sites	Amento et al., CHI '99: Proceedings of the SIGCHI conference on Human Factors in Computing Systems	May 1999
Handbook for the Palm VII™ Organizer	3Com Corporation	1998
The Event Horizon User Interface Model for Small Devices	Taivalsaari, Sun Microsystems	March 1999
WebView: A Graphical Aid for Revisiting Web Pages	Cockburn *et al.*, Proceedings of the OZCHI'99 Australian Conference on Human Computer Interaction	1999
onCue how it works!	Alan Dix aQtive limited	September 1999
Design of User Interfaces for the Web	Dix, Alan	September 1999

[1] https://www.youtube.com/watch?v=JBEtPQDQNcI

Prior Art Systems

Defendant identifies the following prior art systems that anticipate and/or render obvious the Asserted Claims. Such prior art systems are believed to have implemented methods of accessing information sources and services on the Internet, and/or may also have had additional features relevant to the Asserted Claims.

System	Offer/Use Date	Manufacturer
Apple Newton	1997	Apple, Inc.
Ericsson R380	March 18, 1999	Ericsson
Palm VII	May 1999	3Com
Palm III	March 9, 1998	Palm Computing, Inc., a 3Com company
PalmPilot	March 10, 1997	U.S. Robotics
HP 620LX/660LX	1998	Hewlett-Packard Co.
"Dialo" PDC-Integrated Personal Information Terminal	1998	Toshiba
Casio Cassiopeia A-20	May 1999	Casio
Ericsson MC16 / HP 360LX:	June 1998	Hewlett-Packard Co.
Nokia 9110 Communicator	September 1998	Nokia
Psion Series 5/5mx	1997	Psion PLC
Toshiba Cuaderia	1997	Toshiba
CompuServe / CompuServe Information Manager	1997	H&R Block; America Online
Windows 95	1995	Microsoft
The Microsoft Network	1995	Microsoft
America Online	1995	America Online
OnCue	1999	aQtive limited

Defendant reserves the right to rely on additional materials describing the identified systems and/or corroborating that they were known, used, or sold and/or the materials describing them were publicly available prior to the priority date of the Asserted Claims, including materials that may be produced in response to several third-party subpoenas and any systems described in

the publications listed above. Defendant reserves the right to rely on reverse engineering or teardowns of these items or prior art systems containing these items. Defendant will serve subpoenas on companies believed to have information regarding these and related products and reserve the right to supplement these contentions based on the information so obtained if necessary. Additionally, Plaintiff may have materials regarding certain prior art systems in its possession from current or previous litigations.

B. Bases for Anticipation and/or Obviousness

Defendant contends that each Asserted Claim is invalid at least under 35 U.S.C. § 102, including pre-AIA subsections 102(a), 102(b), 102(e), 102(f), and 102(g), and/or under 35 U.S.C. § 103. Pursuant to the Scheduling Order and the Local Rules, Defendant's contentions as to how each identified prior art reference either anticipates or renders obvious the Asserted Claims are attached as Exhibits. For each Asserted Patent, the Exhibits contain a separate chart for each anticipating and/or primary obviousness reference detailing where that reference teaches each limitation of the Asserted Claims. Defendant reserves the right to combine each anticipating and/or primary obviousness reference with (1) other anticipating and/or obviousness references, or (2) a combination thereof. Defendant also reserves the right to rely on other references disclosed or incorporated by reference in these Invalidity Contentions, in the Asserted Patents, any patents or applications related to the Asserted Patents, in the file history of the Asserted Patents or any related patents or applications, and in the attached Exhibits.

Defendant's claim charts may disclose multiple theories of invalidity in a single chart. Each chart directed to an anticipatory product/system may also describe that the product/system alone, in light of the knowledge and skill in the art, or in light of other one or more other prior art references, renders each Asserted Claim obvious.

Where Defendant cites to a particular figure in a prior art reference, the citation should be understood to encompass the caption and description of the figure as well as any text relating to the figure in addition to the figure itself. Conversely, where a cited portion of text refers to a figure, the citation should be understood to include the figure as well. Furthermore, while Defendant has generally identified at least one citation per limitation present in a reference or combination, every disclosure of the same or similar limitation in the same reference or combination is not necessarily identified. To focus the issues, Defendant cites particularly pertinent portions of identified references, even where a reference or combination may contain additional support for a particular claim element. Thus, Defendant may rely on uncited portions of the prior art references for additional support for a particular element. Defendant may rely upon other prior art identified in future supplements, corroborating references, documentation, source code, products, and testimony, including materials obtained through further investigation and third-party discovery of the prior art identified herein, that demonstrates the invalidating functionality identified in these Invalidity Contentions or that show the state of the art in the relevant time period (irrespective of whether such references themselves qualify as prior art to the Asserted Patent), and expert testimony to provide context to or aid in understanding the cited portions of the identified prior art. Similarly, where there are multiple references relating to a single prior art product or system, Defendant may cite only to a single reference for a particular limitation, even though other references may also contain similar teachings. Thus, Defendant may rely on uncited references relating to a particular prior art document or system for additional support for a particular element. Any prior art disclosed as anticipating a limitation also renders that limitation obvious.

Additionally, persons of ordinary skill in the art at the time of the alleged inventions generally read a prior art reference as a whole and in the context of other publications and literature.

Numerous prior art references, including those identified herein and in the attached exhibits, reflect common knowledge and the state, scope, and content of the prior art before the priority date of the Asserted Claims of the Asserted Patents. Defendant may rely on uncited portions of the prior art references and on other publications and expert testimony to provide context and as aids to understanding and interpreting the portions that are cited.

To the extent that any claim limitation is not anticipated pursuant to 35 U.S.C. § 102, Defendant contends that any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged inventions, in view of the state of the art and knowledge of those skilled in the art under 35 U.S.C. § 103. Each Asserted Claim would have been obvious in view of each reference cited in the attached Exhibits either alone or combined with the knowledge that was possessed by one of ordinary skill in the art. Additionally, each Asserted Claim would have been obvious to one of ordinary skill in the art in view of the combination of any one of the prior art references identified in the attached Exhibits with one or more of the other references identified or discussed in the same Exhibits.

In general, a claimed invention is invalid due to obviousness "if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art." 35 U.S.C. § 103; *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966). The ultimate determination of whether an invention is or is not obvious is a legal conclusion based on underlying factual inquiries including: "(1) the scope and content of the prior art; (2) the differences between the prior art and the claims; (3) the level of ordinary skill in the art at the time of invention; and (4) objective evidence of nonobviousness." *See, e.g.*, *Miles Labs., Inc. v. Shandon, Inc.*, 997 F.2d 870, 877 (Fed. Cir. 1993); *see Graham*, 383 U.S. at 17-18. The U.S.

Supreme Court decision in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007) reaffirmed Graham, but further held that a claimed invention can be obvious even if there is no explicit teaching, suggestion, or motivation for combining the prior art to produce that invention.

In particular, those of ordinary skill in the art at the time of the alleged inventions of the Asserted Patents would have been motivated to modify or combine the prior art references because, for example: (a) the references in general deal with the same or related subject matter; (b) one of ordinary skill in the art would have been motivated by the problem that the inventor was attempting to solve, or with other problems that would have been faced in reaching a solution, and would have looked to references that concerned similar issues or taught how to overcome the problems faced; (c) the combinations were obvious to try and would have operated in their known and expected way; (d) the combinations were within the technical skill and understanding of a person of ordinary skill in the art; (e) the combinations would have been motivated by the developments in technology; and (f) the combinations reflect various design choices that would have been known to one of ordinary skill in the art and within that person's technical capability to implement (i.e., technically feasible). The various motivations described above provide a basis for combining or modifying references, as detailed below, to render each of the Asserted Claims obvious. In addition, the Court can consider the inferences and creative steps a person of ordinary skill in the art would employ in making such combinations. *See KSR*, 127 S. Ct. at 1741 ("a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ").

If, and to the extent, Plaintiff challenges the correspondence of the references in the Exhibits with respect to particular limitations of the Asserted Claims of the Asserted Patents, Defendant reserves the right to supplement these Invalidity Contentions to identify additional

combinations, motivations to modify, or explanations for particular references with additional particularity.

Additionally, Defendant believes that certain non-parties and current or former employees thereof may have possession of relevant information and/or documents constituting prior art to the Asserted Patents. Defendant is continuing its investigation into these and other companies and its products. Defendant reserves the right to supplement these Invalidity Contentions to identify additional references, combinations, motivations to modify, or explanations for particular references based on any information and/or documents provided by the former employees and/or successors-in-interests of companies or individuals who may possess relevant information and/or documents constituting prior art to the Asserted Patents. The concepts disclosed and claimed in each of the Asserted Patents are not new, and had been disclosed, used, offered for sale, sold, and practiced by others prior to the claimed priority date of the patents. The prior art identified herein and in the Exhibits, individually or in combination, invalidates the Asserted Claims under 35 U.S.C. §§ 102 (a), (b), (e), (f), (g) and §103. Because discovery has not yet opened, Defendant expects to gather additional information about the identified prior art, and other prior art, through third-party discovery or other discovery, and will thus amend and supplement these Invalidity Contentions once they obtain that discovery and have meaningful and reasonable time to analyze it. As described in more detail below, claims of the Asserted Patents are also invalid under 35 U.S.C. § 112.

Moreover, Defendant reserves the right to rely on inventor admissions concerning the scope of the prior art relevant to the Asserted Patents found in, *inter alia*, the prosecution histories of the Asserted Patents or related patents and/or patent applications, any testimony or declarations of the named inventors concerning the Asserted Patents or related patents, and any papers or

evidence submitted by Plaintiff in connection with this litigation, any other pending or future litigation brought by Plaintiff involving the Asserted Patents or related patents, or *inter partes review* proceedings involving the Asserted Patents or related patents. Defendant also may establish what was known to a person having ordinary skill in the art through treatises, published industry standards other publications, products, and/or testimony.

The accompanying claim charts (Exhibits A to B[2]) set forth bases for anticipation and obviousness, including identifying where exemplary prior art references disclose, alone or in combination with other references, each element of each Asserted Claim on a limitation-by-limitation basis. Defendant's claim charts are exemplary and are not intended to be exhaustive. Defendant notes that other combinations of the references cited herein may be relied upon for invalidity of any or all of the Asserted Claims of the Asserted Patents. To the extent prior art evidence is cited for a particular claim feature, that evidence similarly applies to that same or similar feature that appears elsewhere in any other Asserted Claim of the Asserted Patents, whether or not that evidence is repeated.

Each prior art reference identified in Exhibits A to B anticipates or renders obvious one or more of the claims of the Asserted Patents, either alone or in combination with other prior art references (specifically, the references disclosed in Exhibits A to B) or the knowledge of those of ordinary skill in the art at the time of the alleged invention, including at least the knowledge of reflected in the references identified in Part III.A, above. Each of the prior art references included in Exhibits A to B can be combined with one or more other prior art reference in Exhibits A to B

[2] Exhibit A includes Exhibits A-01 through A-08; Exhibit B includes Exhibits B-01 through B-08.

to render obvious one or more claims of the Asserted Patents, and the examples of combinations included in the attached charts are intended for emphasis only.

In addition to the foregoing prior art and grounds of anticipation and obviousness, all of the prior art cited and all grounds disclosed during the prosecution of each of the Asserted Patents, their family members, or foreign counterparts, either during initial prosecution or during subsequent post grant proceedings, and all arguments made by Patentee during such proceedings, are incorporated by reference herein. Plaintiff is and has been involved in proceedings involving the Asserted Patents and related patents. Any statements made by Plaintiff or other Defendants in those proceedings are fairly within the scope of Defendant's Invalidity Contentions and are incorporated by reference herein.

Defendant may rely on all past, present, co-pending, and future post-grant review proceedings involving the Asserted Patents (collectively, the "Post-Grant Proceedings"), and any statements made or to be made by Plaintiff or other Defendants in such proceedings. For the avoidance of doubt, and without limitation, Defendant incorporates by reference all relevant statements made or to be made by Plaintiff or other Defendants (including analysis and explanations regarding obviousness, combinations, motivations to combine, etc.) in the Post-Grant Proceedings.

Defendant may rely on all past, present, co-pending, and future litigation involving the Asserted Patents (collectively, the "Other Litigations"), and any statements made or to be made by Plaintiff or other Defendants in the Other Litigations. For the avoidance of doubt, and without limitation, Defendant incorporates by reference all relevant statements made or to be made by Plaintiff or other Defendants (including analysis and explanations regarding obviousness,

combinations, motivations to combine, etc.) in the Other Litigations, which include but are not limited to the following:

Title	Civil Action #	Court
Allani v. Apple, Inc. et al.	RG 20/01312	Paris Judicial Court
Allani v. Apple, Inc. et al.	RG 23/01389	Paris Court of Appeal
Allani v. Google Inc.	6:24-cv-00305	W.D. Tex.

1. Disclosures for U.S. Patent No. 8,271,877

In the table below, Defendant identifies a non-exhaustive list of prior art references that, alone, or in combination, anticipate or render obvious the Asserted Claims of the '877 Patent.

References	Claims	Grounds	Exhibit
Logan	12, 15, 17-19	§§ 102, 103	A-01
Hawkins	12, 15, 17-19	§§ 102, 103	A-02
Kanno	12, 15, 17-19	§§ 102, 103	A-03
Toshiba	12, 15, 17-19	§§ 102, 103	A-05
WebView	12, 15, 17-19	§§ 102, 103	A-06
aQtive onCue	12, 15, 17-19	§§ 102, 103	A-07
Palm VII	12, 15, 17-19	§§ 102, 103	A-08

Defendant reserves the right to rely on additional materials describing these activities and/or corroborating that they were conceived and/or reduced to practice and/or the materials describing them were publicly available prior to the priority date of the Asserted Claims, including materials that may be produced in response to several third-party subpoenas and any systems described in the publications listed above. Defendant reserves the right to rely on reverse engineering or teardowns of the above prior art systems. Defendant will serve subpoenas on companies believed to have information regarding these and related products and reserve the right to supplement these contentions based on the information so obtained if necessary. Additionally, Plaintiff may have materials regarding certain prior art systems in its possession from current or previous litigations.

2. Disclosures for U.S. Patent No. 10,943,058

In the table below, Defendant identifies a non-exhaustive list of prior art references that, alone, or in combination, anticipate or render obvious the Asserted Claims of the ’058 patent.

References	Claims	Grounds	Exhibit
Logan	24-27	§§ 102, 103	B-01
Hawkins	24-27	§§ 102, 103	B-02
Kanno	24-27	§§ 102, 103	B-03
Toshiba	24-27	§§ 102, 103	B-05
WebView	24-27	§§ 102, 103	B-06
aQtive onCue	24-27	§§ 102, 103	B-07
Palm VII	24-27	§§ 102, 103	B-08

Defendant reserves the right to rely on additional materials describing the identified systems and/or corroborating that they were known, used, or sold and/or the materials describing them were publicly available prior to the priority date of the Asserted Claims, including materials that may be produced in response to several third-party subpoenas and any systems described in the publications listed above. Defendant reserves the right to rely on reverse engineering or teardowns of the above prior art systems. Defendant will serve subpoenas on companies believed to have information regarding these and related products and reserve the right to supplement these contentions based on the information so obtained if necessary. Additionally, Plaintiff may have materials regarding certain prior art systems in its possession from current or previous litigations.

C. Reasons to Combine and Obviousness of Claimed Invention

Under *KSR Int’l v. Teleflex Co.*, a motivation to combine prior art references is not necessarily required to show obviousness under 35 U.S.C. § 103. 550 U.S. 398 (2007). Nonetheless, one of ordinary skill in the art at the time of the invention would have been motivated and had a reasonable expectation of success to make one or more combinations of the prior art references cited in Exhibits A and B because, for example, each would have been merely: (a) a combination of prior art elements according to known methods to yield predictable results; (b) a

simple substitution of one known element for another to obtain predictable results; (c) a use of a known technique to improve similar devices in the same way; (d) application of a known technique to a known device ready for improvement to yield predictable results; (e) obvious to try; and/or (f) known work in one field of endeavor prompting variations of it for use in either the same field or a different one based on design incentives or other market forces since the variations are predictable to one of ordinary skill in the art.

The charts of Exhibit A apply the prior art to the ’877 Patent in detail and present specific anticipatory references or exemplary combinations of prior art references that render obvious every asserted claim. Exhibit B does the same for the ’058 Patent. The charts also include some exemplary motivations one of ordinary skill would have had to combine certain exemplary references, or otherwise demonstrate that any differences between the scope of the claims and the prior art would have been obvious to a person having ordinary skill in the art. However, the same motivations apply equally to combinations of any or all references within each Exhibit.

For example, a person of ordinary skill in the art would have been motivated to combine any reference in Exhibits A to B with one or more of the other prior art references identified in Exhibits A to B, respectively, at least because the references share well-known and common objectives, subject matter, and approaches, and/or were developed during the same time period. Additionally, such combinations would have been within that person’s skill at the time of invention and would amount to applying a known technique to a known device ready for improvement to yield predictable results. The down-conversion technology claimed in the Asserted Patents was well known in the art and is reflected in the numerous references cited and analyzed in Exhibits A to B.

1. Exemplary combinations for U.S. Patent No. 8,271,877

The ’877 Patent states that “[t]he aim of the invention is to propose a method for accessing information sources and services on the Web, that is quicker and easier to use than the present methods for accessing information on Internet, notably with a objective of integration within interactive terminals and office automation and communication equipments.” ’877 Patent, 1:65-2:3. According to the disclosure, this “objective is reached with a method for accessing information sources and services on the Web, from a communication device connected through a communication network to the Internet network, comprising: one or more steps for displaying a page of selection among a plurality of selection pages organized within a structure of a tree menu and beforehand locally stored within said communication device, each page of selection comprising a set of icons and, a step for emitting on the communication network, in response to a selection of an icon in a page of selection currently displayed, the address of a source of information corresponding to said selected icon.” *Id*. at 2:4-16. The specification explains that, “by locally implementing preliminary selection steps in pages organized in a tree manner and operating as rolling menus, and by finally emitting on Internet only a complete address for accessing a well-targeted information source, the mean time duration observed for accessing searched information is drastically reduced.” *Id*. at 2:27-32.

The specification discloses an embodiment of the invention represented in Figures 1 and 2:

> Now, with reference to FIG. 1, an example of use of the access method according to the invention, implemented in an Internet terminal or in an office automation and communication apparatus, is described.
>
> A first page Po, displayed during the initialization of the apparatus, for example contains:

Icons LO1, LO2,…,Loi featuring logotypes, graphic of semi-graphic marks, merchant sites or portals for entering major commercial brands, for example a chain of hotels or restaurants or a large-scale distribution company,

Icons TH1, TH2, TH3,…, THj, THk each corresponding to a general purpose category or theme, for example sport, television, weather forecast or stock exchange

The first page Po constitutes the trunk of a tree structure schematically represented in FIG. 2 for the whole screen pages locally stored in a storage unit, for example a hard disk unit or a CD-ROM, of the apparatus wherein this method is implemented.

If the user of the apparatus points on the icon of theme TH1, for example the SPORT theme, and clicks on this icon, a page P1 dedicated to the SPORT theme is then displayed. This page P1 contains for example:

An icon Lox for accessing a site dedicated to a plurality of sports and an icon Loy for accessing a site of a major soccer club,

An icon AD11 "calendar" for directly accessing a weekly calendar of sport events provided on the above-cited multi-sport site,

An icon AD12, "1st division games" for directly accessing to a document presenting the next matches of the 1st division of soccer and provided by the official site of the soccer federation,

Icons ST11, ST12,…, ST1i,…,ST1j for selecting sub-categories or sub-themes, and

An icon "return" permitting to come back to initial page Po.

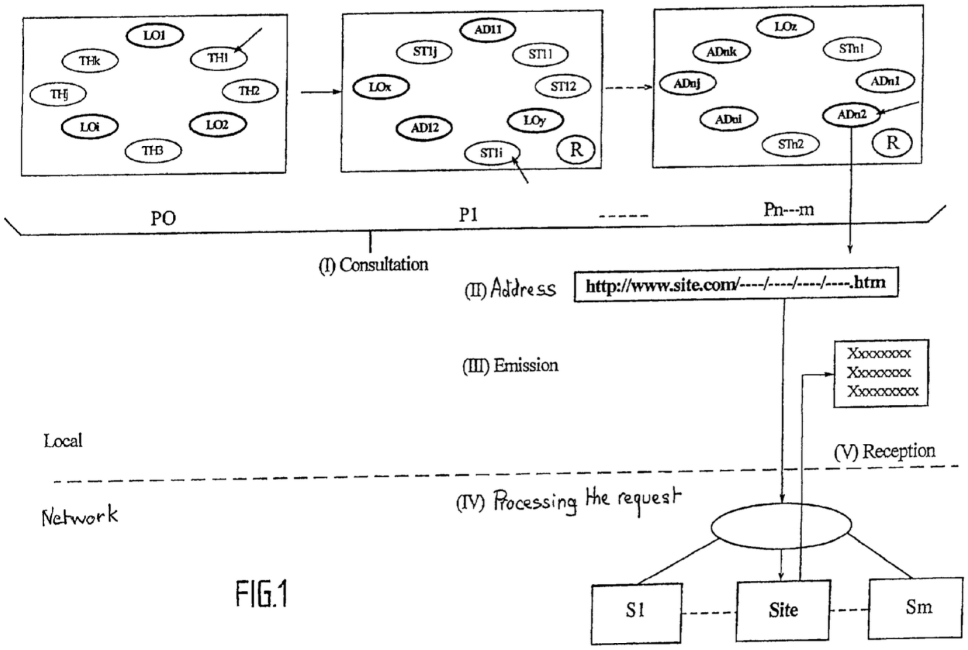

FIG.1

’877 Patent, Fig. 1.

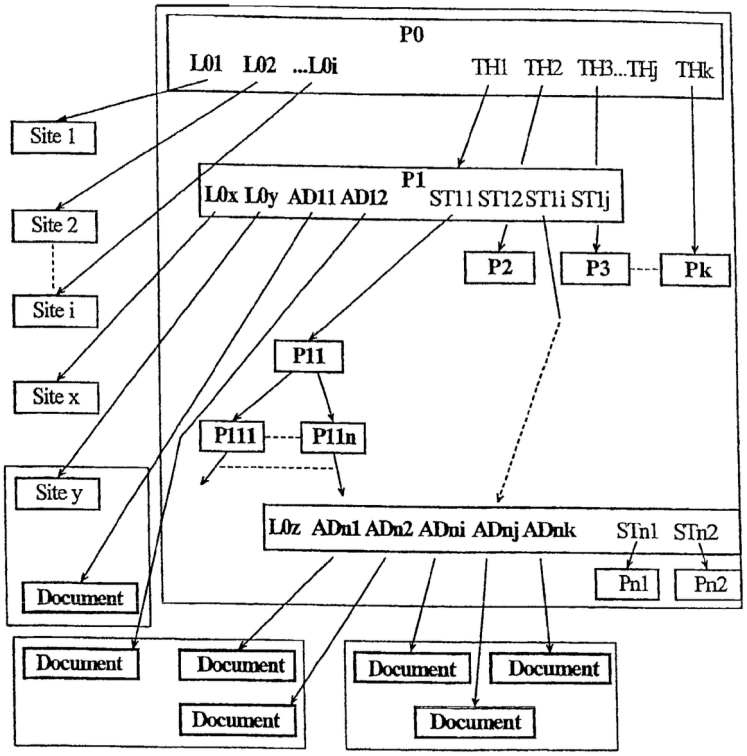

FIG.2

’877 Patent, Fig. 2.

Similar to the asserted ’877 Patent, the prior art references of Exhibit A relate, directly or indirectly, to organizing information on a user interface so a user can directly access a specific internet site. A person of ordinary skill in the art would have recognized that simply combining known technologies, *e.g.*, such as organizing information into themes and subthemes so they are more navigable for users, would yield predictable results and would have been well within that person’s skill at the claimed priority date of the ’877 Patent. *See* Exhibit A. A person of ordinary skill in the art would have also recognized that combining any of these references would simply be the substitution of one known element or technology or would apply a known technique to improve a known or similar device, in the same way and to yield a predictable result. *See* Exhibit A. Similarly, a person of ordinary skill in the art would have recognized that various aspects of the

Asserted Claims were each also matters of mere design choice to persons of skill in the art. *See* Exhibit A.

Accordingly, it would have been within the skill of a person of ordinary skill in the art to modify each of the references of Exhibit A, in view of the knowledge of a person of ordinary skill in the art (including as reflected in Exhibits A) and/or in view of the other references in Exhibit A to obtain the alleged inventions claimed by the '877 Patent, as shown in the following exemplary combinations. However, the specific combinations discussed below are merely exemplary, as the same considerations apply to making combinations of any of the identified prior art.

(i) Logan

Logan anticipates the asserted claims under at least 35 U.S.C. § 102. Logan further renders the asserted claims invalid as obvious under 35 U.S.C. § 103, either alone or in combination with one or more other references charted or cited throughout Exhibit A of Apple's Invalidity Contentions. As reflected in Exhibit A-01 and throughout Exhibit A, it would have been within the skill of a person of ordinary skill in the art to modify the disclosures of Logan to overcome any differences between Logan and the claimed inventions of the '877 Patent. As reflected in Exhibit A-01 and throughout Exhibit A, one of ordinary skill would also have had reason to combine Logan with the other references identified in Exhibit A because each is directed to the same or similar field of endeavor and each teaches methods and/or systems to address the same or similar problem in the field, namely that of organizing information to provide direct access to internet sites to users.

For example, a person of ordinary skill in the art would have had reason to combine Logan with each, any, or all of:

- U.S. Patent No. 6,526,424 ("Kanno")
- U.S. Patent No. 6,658,418 ("Burns")

- EP09442181A1 ("Ringot")
- JPH11-068823 ("Shoichi")
- WO/99/61984 ("Hawkins")

in this case, as all were directed to methods of organizing and retrieving information from an internet source; and a person of skill in the art, looking at how to improve such methods, would have looked to similar methods.

In all such instances a person of ordinary skill in the art would have the background knowledge reflected, for example, in Exhibit A.

Defendant expressly reserves the right to supplement or amend these combinations after receiving third-party discovery.

(ii) Shoichi

Shoichi renders the asserted claims invalid as obvious under 35 U.S.C. § 103, either alone or in combination with one or more other references charted or cited throughout Exhibit A of Apple's Invalidity Contentions. As reflected throughout Exhibit A, it would have been within the skill of a person of ordinary skill in the art to modify the disclosures of Shoichi to overcome any differences between Shoichi and the claimed inventions of the '877 Patent. As reflected throughout Exhibit A, one of ordinary skill would also have had reason to combine Shoichi with the other references identified in Exhibit A because each is directed to the same or similar field of endeavor and each teaches methods and/or systems to address the same or similar problem in the field, namely that of organizing information to provide direct access to internet sites to users.

For example, a person of ordinary skill in the art would have had reason to combine Shoichi with each, any, or all of:

- U.S. Patent No. 5,781,909 ("Logan")
- U.S. Patent No. 6,658,418 ("Burns")
- EP09442181A1 ("Ringot")

- U.S. Patent No. 6,526,424 ("Kanno")
- WO 99/61984 ("Hawkins")

in this case, as all were directed to methods of organizing and retrieving information from an internet source; and a person of skill in the art, looking at how to improve such methods, would have looked to similar methods.

In all such instances a person of ordinary skill in the art would have the background knowledge reflected, for example, in Exhibit A.

Defendant expressly reserves the right to supplement or amend these combinations after receiving third-party discovery.

(iii) Kanno

Kanno anticipates the asserted claims under at least 35 U.S.C. § 102. Kanno further renders the asserted claims invalid as obvious under 35 U.S.C. § 103, either alone or in combination with one or more other references charted or cited throughout Exhibit A of Apple's Invalidity Contentions. As reflected in Exhibit A-03 and throughout Exhibit A, it would have been within the skill of a person of ordinary skill in the art to modify the disclosures of Estabrook to overcome any differences between Estabrook and the claimed inventions of the '877 Patent. As reflected in Exhibit A-03 and throughout Exhibit A, one of ordinary skill would also have had reason to combine with the other references identified in Exhibit A because each is directed to the same or similar field of endeavor and each teaches methods and/or systems to address the same or similar problem in the field, namely that of organizing information to provide direct access to internet sites to users.

For example, a person of ordinary skill in the art would have had reason to combine Kanno with each, any, or all of:

- U.S. Patent No. 5,781,909 ("Logan")

- U.S. Patent No. 6,658,418 ("Burns")
- EP09442181A1 ("Ringot")
- JPH11-068823 ("Shoichi")
- WO 99/61984 ("Hawkins")

in this case, as all were directed to methods of organizing and retrieving information from an internet source; and a person of skill in the art, looking at how to improve such methods, would have looked to similar methods.

In all such instances a person of ordinary skill in the art would have the background knowledge reflected, for example, in Exhibit A.

Defendant expressly reserves the right to supplement or amend these combinations after receiving third-party discovery.

(iv) Hawkins

Hawkins anticipates the asserted claims under at least 35 U.S.C. § 102. Hawkins further renders the asserted claims invalid as obvious under 35 U.S.C. § 103, either alone or in combination with one or more other references charted or cited throughout Exhibit A of Apple's Invalidity Contentions. As reflected in Exhibit A-02 and throughout Exhibit A, it would have been within the skill of a person of ordinary skill in the art to modify the disclosures of Hawkins to overcome any differences between Hawkins and the claimed inventions of the '877 Patent. As reflected in Exhibit A-02 and throughout Exhibit A, one of ordinary skill would also have had reason to combine with the other references identified in Exhibit A because each is directed to the same or similar field of endeavor and each teaches methods and/or systems to address the same or similar problem in the field, namely that of organizing information to provide direct access to internet sites to users.

For example, a person of ordinary skill in the art would have had reason to combine Hawkins with each, any, or all of:

- U.S. Patent No. 5,781,909 ("Logan")
- U.S. Patent No. 6,658,418 ("Burns")
- EP09442181A1 ("Ringot")
- JPH11-068823 ("Shoichi")
- U.S. Patent No. 6,526,424 ("Kanno")

in this case, as all were directed to methods of organizing and retrieving information from an internet source; and a person of skill in the art, looking at how to improve such methods, would have looked to similar methods.

In all such instances a person of ordinary skill in the art would have the background knowledge reflected, for example, in Exhibit A.

Defendant expressly reserves the right to supplement or amend these combinations after receiving third-party discovery.

2. Exemplary combinations for U.S. Patent No. 10,943,058

The '058 Patent describes communication devices and methods for selectively accessing remote sources of information and services on the Web through a communication network. '058 Patent, Abstract. The '058 Patent shares the same disclosure as the '877 Patent, described above in Section C.1.

Similar to the asserted '058 Patent, the prior art references of Exhibit B relate, directly or indirectly, to organizing information on a user interface so a user can directly access a specific internet site. A person of ordinary skill in the art would have recognized that simply combining known technologies, *e.g.*, such as organizing information into themes and subthemes so they are more navigable for users, would yield predictable results and would have been well within that person's skill at the claimed priority date of the '058 Patent. *See* Exhibit B. A person of ordinary skill in the art would have also recognized that combining any of these references would simply be the substitution of one known element or technology or would apply a known technique to

improve a known or similar device, in the same way and to yield a predictable result. *See* Exhibit B. Similarly, a person of ordinary skill in the art would have recognized that various aspects of the Asserted Claims were each also matters of mere design choice to persons of skill in the art. *See* Exhibit B.

Accordingly, it would have been within the skill of a person of ordinary skill in the art to modify each of the references of Exhibit B, in view of the knowledge of a person of ordinary skill in the art (including as reflected in Exhibits B) and/or in view of the other references in Exhibit B to obtain the alleged inventions claimed by the '058 Patent, as shown in the following exemplary combinations. However, the specific combinations discussed below are merely exemplary, as the same considerations apply to making combinations of any of the identified prior art.

(i) Logan

Logan anticipates the asserted claims under at least 35 U.S.C. § 102. Logan further renders the asserted claims invalid as obvious under 35 U.S.C. § 103, either alone or in combination with one or more other references charted or cited throughout Exhibit B of Apple's Invalidity Contentions. As reflected in Exhibit B-01 and throughout Exhibit B, it would have been within the skill of a person of ordinary skill in the art to modify the disclosures of Logan to overcome any differences between Logan and the claimed inventions of the '058 Patent. As reflected in Exhibit B-01 and throughout Exhibit B, one of ordinary skill would also have had reason to combine Logan with the other references identified in Exhibit B because each is directed to the same or similar field of endeavor and each teaches methods and/or systems to address the same or similar problem in the field, namely that of organizing information to provide direct access to internet sites to users.

For example, a person of ordinary skill in the art would have had reason to combine Logan with each, any, or all of:

- U.S. Patent No. 6,526,424 ("Kanno")

- U.S. Patent No. 6,658,418 ("Burns")
- EP09442181A1 ("Ringot")
- JPH11-068823 ("Shoichi")
- WO/99/61984 ("Hawkins")

in this case, as all were directed to methods of organizing and retrieving information from an internet source; and a person of skill in the art, looking at how to improve such methods, would have looked to similar methods.

In all such instances a person of ordinary skill in the art would have the background knowledge reflected, for example, in Exhibit B.

Defendant expressly reserves the right to supplement or amend these combinations after receiving third-party discovery.

(ii) Shoichi

Shoichi anticipates the asserted claims under at least 35 U.S.C. § 102. Shoichi further renders the asserted claims invalid as obvious under 35 U.S.C. § 103, either alone or in combination with one or more other references charted or cited throughout Exhibit B of Apple's Invalidity Contentions. As reflected throughout Exhibit B, it would have been within the skill of a person of ordinary skill in the art to modify the disclosures of Shoichi to overcome any differences between Shoichi and the claimed inventions of the '058 Patent. As reflected throughout Exhibit B, one of ordinary skill would also have had reason to combine Shoichi with the other references identified in Exhibit B because each is directed to the same or similar field of endeavor and each teaches methods and/or systems to address the same or similar problem in the field, namely that of organizing information to provide direct access to internet sites to users.

For example, a person of ordinary skill in the art would have had reason to combine Shoichi with each, any, or all of:

- U.S. Patent No. 5,781,909 ("Logan")

- U.S. Patent No. 6,658,418 ("Burns")
- EP09442181A1 ("Ringot")
- U.S. Patent No. 6,526,424 ("Kanno")
- WO 99/61984 ("Hawkins")

in this case, as all were directed to methods of organizing and retrieving information from an internet source; and a person of skill in the art, looking at how to improve such methods, would have looked to similar methods.

In all such instances a person of ordinary skill in the art would have the background knowledge reflected, for example, in Exhibit B.

Defendant expressly reserves the right to supplement or amend these combinations after receiving third-party discovery.

(iii) Kanno

Kanno anticipates the asserted claims under at least 35 U.S.C. § 102. Kanno further renders the asserted claims invalid as obvious under 35 U.S.C. § 103, either alone or in combination with one or more other references charted or cited throughout Exhibit B of Apple's Invalidity Contentions. As reflected in Exhibit B-03 and throughout Exhibit B, it would have been within the skill of a person of ordinary skill in the art to modify the disclosures of Estabrook to overcome any differences between Estabrook and the claimed inventions of the '058 Patent. As reflected in Exhibit B-03 and throughout Exhibit B, one of ordinary skill would also have had reason to combine with the other references identified in Exhibit B because each is directed to the same or similar field of endeavor and each teaches methods and/or systems to address the same or similar problem in the field, namely that of organizing information to provide direct access to internet sites to users.

For example, a person of ordinary skill in the art would have had reason to combine Kanno with each, any, or all of:

- U.S. Patent No. 5,781,909 ("Logan")
- U.S. Patent No. 6,658,418 ("Burns")
- EP09442181A1 ("Ringot")
- JPH11-068823 ("Shoichi")
- WO 99/61984 ("Hawkins")

in this case, as all were directed to methods of organizing and retrieving information from an internet source; and a person of skill in the art, looking at how to improve such methods, would have looked to similar methods.

In all such instances a person of ordinary skill in the art would have the background knowledge reflected, for example, in Exhibit B.

Defendant expressly reserves the right to supplement or amend these combinations after receiving third-party discovery.

(iv) Hawkins

Hawkins anticipates the asserted claims under at least 35 U.S.C. § 102. Hawkins further renders the asserted claims invalid as obvious under 35 U.S.C. § 103, either alone or in combination with one or more other references charted or cited throughout Exhibit B of Apple's Invalidity Contentions. As reflected in Exhibit B-02 and throughout Exhibit B, it would have been within the skill of a person of ordinary skill in the art to modify the disclosures of Hawkins to overcome any differences between Hawkins and the claimed inventions of the '058 Patent. As reflected in Exhibit B-02 and throughout Exhibit B, one of ordinary skill would also have had reason to combine with the other references identified in Exhibit B because each is directed to the same or similar field of endeavor and each teaches methods and/or systems to address the same or similar problem in the field, namely that of organizing information to provide direct access to internet sites to users.

For example, a person of ordinary skill in the art would have had reason to combine Hawkins with each, any, or all of:

- U.S. Patent No. 5,781,909 ("Logan")
- U.S. Patent No. 6,658,418 ("Burns")
- EP09442181A1 ("Ringot")
- JPH11-068823 ("Shoichi")
- U.S. Patent No. 6,526,424 ("Kanno")

in this case, as all were directed to methods of organizing and retrieving information from an internet source; and a person of skill in the art, looking at how to improve such methods, would have looked to similar methods.

In all such instances a person of ordinary skill in the art would have the background knowledge reflected, for example, in Exhibit B.

Defendant expressly reserves the right to supplement or amend these combinations after receiving third-party discovery.

IV. INVALIDITY UNDER 35 U.S.C. § 112

Various claims of the Asserted Patents are also invalid for indefiniteness, lack of enablement, and/or lack of written description under 35 U.S.C. § 112. Under § 112, a patent must provide sufficient description of the claimed invention to permit or enable a person of ordinary skill in the art to make and use the claimed invention. The enablement requirement is satisfied only if one skilled in the art can practice the invention based on the teachings of the patent without undue experimentation. *See AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1244 (Fed. Cir. 2003). A patent must also sufficiently disclose the invention to reasonably convey to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

Further, the Supreme Court has determined that 35 U.S.C. § 112 "require[s] that a patent's claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty." *Nautilus, Inc., v. Biosig Instruments, Inc.*, 134 S. Ct 2120, 2129 (2014). Claims are also invalid as indefinite where they are means-plus-function claims and the specification fails to disclose any corresponding structure for performing the recited functions. *See, e.g.*, *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1350-51 (Fed. Cir. 2015); *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1383-85 (Fed. Cir. 2009).

A. Lack of Enablement and Written Description

Based on the information currently available, the Asserted Claims of the Asserted Patents are invalid for lack of enablement and/or written description under § 112, ¶ 1 due to at least the following terms and phrases:

- "A device for accessing information- or service-providing web sites comprising a mobile communication device connectable through a communication network to the Internet" – '877 Patent Claims 12, 15, 17-19
- "wherein the mobile communication device is a mobile phone" – '058 Patent Claims 24-27.

Furthermore, even to the extent individual claim limitations are sufficiently described, the claims are invalid for lack of written description because the particular combinations of claim limitations found in the Asserted Claims are not sufficiently described to "clearly allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed." *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

Each of the terms and phrases listed above fail to inform a person of ordinary skill in the art how to make and use the invention without undue experimentation. In particular, for each of the terms and phrases above, the specification fails to include any specific working example of

how to achieve the claimed invention, and instead merely lists a desired outcome. Furthermore, each of the terms and phrases listed above are not fully described in the specifications thereof, such that the purported inventors failed to have possession of the claimed invention. The above terms and phrases are exemplary and any similar terms or phrases appearing elsewhere in the Asserted Claims of the Asserted Patents lack enablement and/or written description for the same reasons.

B. Failure to Particularly Point Out and Distinctly Claim the Subject Matter which the Inventor Regards as the Invention

Based on the information currently available, the Asserted Claims of the Asserted Patents fail to inform those skilled in the art about the scope of the invention with reasonable certainty under § 112, ¶ 2 due to, at least, the following terms and phrases:

- "the control and processing device or devices are arranged for receiving by downloading from a management server data for updating selection pages, and for processing said updating data so as that new selection pages are stored to be displayed" – '877 Patent Claim 16
- "down converting said input signal at said first matched filtering/correlating module according to a first control signal" – '177 Patent Claim 14.

Each of the terms and phrases listed above renders the claims invalid as being indefinite because their meanings are unclear, such that when read in light of the specification and prosecution history, the claim term fails to inform those skilled in the art about the scope of the invention with reasonable certainty. In addition, many of the claim terms and phrases are part of system claims that include method steps, and as held in *IPXL Holdings v. Amazon.com*, 430 F.3d 1377 (Fed. Cir. 2005), indefiniteness results for claims that claim activities of a user of an apparatus in an apparatus claim. *See also MasterMine Software, Inc. v. Microsoft Corp.*, 874 F.3d 1307 (Fed. Cir. 2017). The above terms and phrases are exemplary and any similar terms or

phrases appearing elsewhere in the Asserted Claims of the Asserted Patents are indefinite for the same reasons.

V. INVALIDITY UNDER 35 U.S.C. § 101

Various claims of the Asserted Patents are also invalid for lack of subject matter eligibility under 35 U.S.C. § 101. Whether an invention is eligible for patent protection under 35 U.S.C. § 101 is a "threshold test." *See Bilski v. Kappos*, 130 S. Ct. 3218, 3225 (2010). Under this "threshold test," the court "must first determine whether the claims at issue are directed to a patent-ineligible concept," such as an abstract idea, a law of nature, or a natural phenomenon. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014). If so, the court must then "consider the elements of each claim both individually and "as an ordered combination" to determine whether the additional elements "transform the nature of the claim" into a patent-eligible application." *See id*. (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (20120)).

In *Alice*, the Supreme Court set forth a two-part test to analyze patent eligibility: (1) determine whether the claims are directed to an abstract idea or other patent-ineligible concept, and (2) if so, determine whether the claim has an "inventive concept" sufficient to transform the claim to a patent-eligible concept. *Id*. at 2355. But "well-understood, routine, conventional activity" or technology, including general purpose computers and computer networks, do not provide an "inventive concept." *Id*. at 2357-59. "Thus, if a patent's recitation of a computer amounts to a mere instruction to implement an abstract idea on a computer, that addition cannot impart patent eligibility." *Id*. at 2358; *see also Bancorp Servs., LLC v. Sun Life Assur. Co. of Canada (U.S.)*, 687 F.3d 1266 (Fed. Cir. 2012).

Specifically, the following Asserted Claims are directed to unpatentable subject matter:

- The asserted claims of the '877 Patent pertain to unpatentable subject matter as set forth in Exhibit A-04.

- The asserted claims of the ’058 Patent pertain to unpatentable subject matter as set forth in Exhibit B-04.

VI. ACCOMPANYING DOCUMENT PRODUCTION - P.R. 3-4

Pursuant to P.R. 3-4, and based on the Complaint and Defendant’s investigation and understanding of Plaintiff’s Infringement Contentions, Defendant is producing technical documentation sufficient to show the operation of any aspects or elements of an Accused Instrumentality identified by Plaintiff’s P.R. 3-1(c) charts. Defendant reserves the right to supplement these disclosures with additional documentation.

Defendant is also producing concurrently with these Invalidity Contentions, a single set bearing production numbers APLALLANI_00000001 – APLALLANI_00008876 of all prior art references identified in these Invalidity Contentions. These prior art references are cited herein and support the contentions presented. Accordingly, Defendant reserves the right to supplement its production as additional prior art references, documentation, and/or corroborating evidence concerning prior art documents, apparatuses, and methods are obtained during the course of discovery.

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Respectfully submitted,

/s/ Garland Stephens

Garland Stephens
garland@bluepeak.law
Anna Dwyer
anna@bluepeak.law
John Brinkmann
john@bluepeak.law
BLUE PEAK LAW GROUP LLP
3139 West Holcombe Blvd, PMB 8160
Houston, TX 77025
Telephone: 281-972-3036

COUNSEL FOR DEFENDANT APPLE INC.

CERTIFICATE OF SERVICE

I hereby certify that on January 9, 2025 the foregoing document was served via e-mail upon all counsel of record in this case.

By: */s/ Hannah Kim*