

CASE IPR2025-00856
U.S. Patent No. 8,271,877

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

FERID ALLANI
Patent Owner.

CASE IPR2025-00856
U.S. Patent No. 8,271,877

PATENT OWNER'S PRELIMINARY RESPONSE

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TABLE OF ABBREVIATIONS

Abbreviation	Term
Allani	Patent Owner Ferid Allani
Petitioner or Apple	Petitioner Apple Inc.
Petition	Paper 1 of IPR2025-00856
POSITA	Person of ordinary skill in the art
The '271 patent	U.S. Patent No. 8,271,877
The '058 patent	U.S. Patent No. 10,943,058
The Challenged Patents	The '877 and '058 patents
The Challenged Claims	Claims 1-19 of the '877 patent
PTAB or the Board	Patent Trial and Appeal Board
IPR	<i>Inter Partes</i> Review
WDTX	Western District of Texas
Rossmann	U.S. Patent No. 6,119,155
Himmel	U.S. Patent No. 6,037,934
King	U.S. Patent No. 6,353,839
Boyle	U.S. Patent No. 6,138,158
Logan	U.S. Patent No. 5,781,909

LIST OF EXHIBITS

EX2001	Letter from Lewis E. Hudnell, III to Jayna Whitt, Esq. dated November 2, 2012
EX2002	Original Complaint for Patent Infringement in <i>Allani v. Apple Inc.</i> , Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2003	Executed Summons in <i>Allani v. Apple Inc.</i> , Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2004	Cover Pleading of Plaintiff's Preliminary Infringement Contentions in <i>Allani v. Apple Inc.</i> , Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2005	Cover Pleading of Defendant's Preliminary Invalidity Contentions in <i>Allani v. Apple Inc.</i> , Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2006	Cover Pleading of Defendant's First Amended Preliminary Invalidity Contentions in <i>Allani v. Apple Inc.</i> , Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2007	Cover Pleading of Defendant's Second Amended Preliminary Invalidity Contentions in <i>Allani v. Apple Inc.</i> , Case No. 6-24-cv-00304-ADA (W.D. Tex.)

EX2008	Scheduling Order in <i>Allani v. Apple Inc.</i> , Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2009	Claim Construction Order in <i>Allani v. Apple Inc.</i> , Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2010	Law360 Article dated May 11, 2021
EX2011 EX2012	Time to Milestone Statistics Excerpts from discovery responses served in <i>Allani v. Apple Inc.</i> , Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2013	Email from counsel for Apple dated July 1, 2025
EX2014	Notices of Subpoena served by Apple in <i>Allani v. Apple Inc.</i> , Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2015	Notice of Agreed Extension of Deadline in <i>Allani v. Apple Inc.</i> , Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2016	Declaration of Mahdi Eslamimehr PH.D., MBA
EX2017	CV of Mahdi Eslamimehr PH.D., MBA

I. INTRODUCTION

The Board should exercise its discretion and deny institution for the reasons set forth in Patent Owner's Request for Discretionary Denial of Institution filed July 22, 2025. Even if the Board determines under its discretion that it should institute review, which the Board should not, the Board should deny the Petition because Apple is not reasonably likely to prevail on any Challenged Claim. Tellingly, Apple has found no reference that anticipates the Challenged Claims. Instead, Apple resorts to improper hindsight to cobble together multiple non-analogous prior art references to show a *prima facie* case of obviousness. But none of the grounds asserted show that the Challenged Claims are unpatentable as obvious under 35 U.S.C. §103(a). Moreover, grounds 1-2 fail to establish that a POSITA would be motivated to combine the asserted prior art to arrive at the claimed invention. Even assuming that the asserted prior art references could be combined, their combination fails to disclose several elements of the Challenged Claims. Accordingly, all grounds to institute review should be denied.

II. THE '877 PATENT

The Challenged Patents are directed to a novel method and device for accessing information and services on the Web. They are the result of the pioneering work of inventor Mr. Ferid Allani. Mr. Allani's invention was a major technological breakthrough that allowed the user to immediately find the service and information

he or she needed among the vast information available on the Web through a communications device using a simple icon or series of icons. The icons allow the user to navigate remote information sources more efficiently by minimizing search delays and improving usability. With Mr. Allani's invention, a user who needs information or a service on the Web can access it with a simple click on their communication device without having to know or enter the address of the information or service that the user wishes to access.

At the time of the invention, traditional web navigation relied on search engines and portal sites, which required users to manually sift through multiple layers of search results and hyperlinks to reach their desired destination.¹ This approach was slow, tedious, and impractical for users unfamiliar with computer tools or the Internet.² Mr. Allani solved these problems by introducing a tree-structured menu of pre-stored selection pages that allow users to navigate their communication devices locally before generating and emitting only the final web address necessary to access the desired resource. One of the purposes of the invention was therefore to enable users unfamiliar with computer and Internet tools to have quick and easy access and for familiar users to gain speed and reduce the costs associated with use.³

¹ EX1001 at 1:10-35.

² *Id.* at 1:40-50.

³ *Id.*; *id.* at 1:65-2:1; *id.* at 2:27-36.

The Challenged Claims are directed to an improved graphical user interface that enables a mobile device user to access internet information sources and services more quickly and easily. The elements of the claims include pre-stored selection pages that are organized in a hierarchical menu and displayed on the user's device.⁴ The selection pages include two types of icons: (1) selection icons, which lead to other locally stored selection pages and (2) direct access icons, which, when selected, transmit an address of a remote information source to the network.⁵ The addresses are either pre-stored in a local database or generated dynamically during the selection process.⁶

The claimed invention significantly reduces network congestion, search time, and user frustration by shifting preliminary navigation steps to the local device.⁷ Instead of querying the web repeatedly, a user can efficiently browse locally stored selection pages and only issue a single, well-defined request to access the final web resource.⁸ By enabling efficient pre-selection of information sources, minimizing network requests, and offering a structured, intuitive interface, Mr. Allani's

⁴ *Id.* at 2:8-12.

⁵ *Id.* at 2:17-21.

⁶ *Id.* at 2:22-26.

⁷ *Id.* at 2:27-36.

⁸ *Id.*

invention streamlines web navigation for users, particularly those unfamiliar with conventional search methods.⁹

The Challenged Patents claim priority to a French patent filed on December 30, 1999, under the number FR 2 803 929 and issued on September 17, 2004 under the number FR 99 16704 and now expired.¹⁰ Accordingly, the Challenged Claims are entitled to a priority date at least as early as December 30, 1999.

III. DEFICIENCIES OF THE ALLEGED PRIOR ART

A. Rossmann

Rossmann describes a method for accelerating navigation among multiple web pages using Handheld Device Markup Language (HDML) on mobile devices. The Rossmann system operates through a fundamentally different architecture than the Challenged Claims. Rossmann's HDML "decks" are downloaded on demand from a server.¹¹ Critically, these decks are downloaded from the server first, then cached locally for subsequent navigation within that delivered content, not beforehand locally stored.¹² The HDML decks comprise links that, when selected, cause retrieval of another menu deck from the server, not a direct connection to a target remote resource.¹³ Rossmann discloses "[i]f the received request cannot be

⁹ *Id.*

¹⁰ EX1001.

¹¹ EX2016 at ¶53.

¹² *Id.*

¹³ *Id.*

satisfied by one of the cards in the received deck, which means the request has to be satisfied in a new deck, a connection initiated by the client module 146 to the server device 144 is made to fetch the new deck.”¹⁴ As such, Rossmann describes a server-driven, on-demand delivery model where pages become locally available only after being downloaded from the server—the opposite of “beforehand locally stored” selection pages that must exist on the device prior to the user’s preliminary search and selection activities.

Each HDML deck contains only the next navigational step, not the complete multi-level tree required for a preliminary search of prestored selection pages.¹⁵ This server-reliant model does not teach the Challenged Claims, which all require selection pages to be navigable locally in different themes and sub-themes before network access is triggered.¹⁶ Rossmann also does not teach the Challenged Claims, which all require a direct access icon that triggers network access after local navigation is complete by emitting an address to the network corresponding to the selected icon.¹⁷

¹⁴ EX1004 at 8:48-60.

¹⁵ EX2016 at ¶54.

¹⁶ *Id.*

¹⁷ *Id.* at ¶55.

B. Himmel

Himmel discloses a bookmark-based authorization system for controlling Internet access on mobile devices, not a system with pre-stored selection pages containing direct access icons. In one embodiment, the system operates through “a plurality of bookmark sets” where “when a request to retrieve an Internet file... the designated URL is checked against the URLs in the active bookmark set.”¹⁸ Upon successful match, the system proceeds to “RETRIEVE PAGE” from the server.¹⁹ In another embodiment, Himmel discloses a “consumer hot list” bookmark set that “can be used to control user access to the web.”²⁰ Himmel’s bookmarks therefore operate as network access control mechanisms—they are not integrated into selection pages, nor are they part of beforehand locally stored selection pages organized in a tree menu structure.²¹

C. King

King discloses a URL management system that enables use of variables within URLs. The system allows variables within addresses, such as URLs with text substitution and context-sensitive conversion, and variables are automatically escaped when placed in a URL parameter.²² King further provides examples of

¹⁸ EX1005 at Abstract.

¹⁹ EX1005 at Fig. 2.

²⁰ EX1005 at 18:53-21:26.

²¹ EX2016 at ¶56.

²² EX1006 at Abstract.

variable substitution affecting URL parameters in HDML actions.²³ King focuses on parameterizing preexisting server-defined URLs through variable substitution rather than device-side generation of website addresses.²⁴ Its menus are presented dynamically over the network, and the URLs are generated in response to server-driven interaction.²⁵ It does not teach (i) locally pre-stored selection pages or (ii) locally generating addresses on a mobile device without reliance on a server-provided URL template.²⁶

D. Boyle

Boyle teaches techniques for providing updated web information to HDML-compatible mobile devices. Boyle involves an update notification system where “when one or more pages of information are updated, users of those client devices subscribing to the updated pages of information receive a notification from one of the server devices that stores the updated information.”²⁷ The system allows “client devices to fetch the updated information from the server device” and is “relevant for devices that may have cached a local copy of the outdated content.”²⁸ As such, Boyle describes an on-demand content refresh system for cached HDML decks, not the

²³ *Id.* at 9:49–10:27, 10:13–27.

²⁴ EX2016 at ¶65.

²⁵ *Id.*

²⁶ *Id.*

²⁷ EX1007 at 2:9-28.

²⁸ EX1007 at 2:27-28, 5:23-36.

claimed architecture of updating “selection pages” that are “beforehand locally stored,” “organized in a tree menu structure,” and specifically designed to include a set of icons. Boyle’s system addresses keeping cached server content current, not maintaining the claimed device-side selection page architecture with integrated pictorial icon sets.

Boyle’s update notification system operates fundamentally differently from the claimed architecture. Boyle describes a supervisory/management server for “pushing” updated content to a client device.²⁹ While Boyle allows updating stored content, it presumes either periodic or persistent connectivity as “[w]hen one or more pages of information are updated, users of those client devices subscribing to the updated pages of information receive a notification from one of the server devices that stores the updated information.”³⁰ This feature undermines the ’877 patent’s purpose of avoiding network access until the final selection.³¹ Boyle’s updates replace or modify content, not preload an entire multi-level menu tree for local searching.³² Boyle also does not disclose direct access icons leading to a final network address without intermediate downloads.³³

²⁹ EX2016 at ¶70.

³⁰ *Id.*; EX1006 at 2:5–20.

³¹ EX2016 at ¶70.

³² *Id.*

³³ *Id.*

IV. LEGAL STANDARDS RELEVANT TO THE CHALLENGE

A. Nonobviousness

Under pre-AIA 35 U.S.C. § 103, a patent is invalid only “if the differences between the subject matter . . . patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”³⁴ Obviousness under § 103 hinges on four fact-driven findings: “(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; and (4) objective evidence of nonobviousness.” The level of ordinary skill in the art is usually evidenced by the references themselves.³⁵

However, “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity

³⁴ See 35 U.S.C. § 103(a); *see also* *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Nat’l Steel Car, Ltd. v. Canadian Pac. Ry., Ltd.*, 357 F.3d 1319, 1334 (Fed. Cir. 2004); *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966).

³⁵ See *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

will be combinations of what, in some sense, is already known.”³⁶ “Some rational underpinning must be provided . . . conclusory statements are insufficient.”³⁷

B. Person of Ordinary Skill in the Art

Under 35 U.S.C. §103(a), obviousness is determined by resolving the level of skill in the pertinent art.³⁸ A POSITA at that time would be a person with a bachelor’s degree in computer science, computer engineering, or a closely related discipline and two years of relevant professional experience in software engineering or a similar field. Alternatively, someone with an advanced degree and less professional experience or less education and more professional experience would also qualify as a POSITA.³⁹

C. Claim Construction

The Board applies the claim construction standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).⁴⁰ Under *Phillips*, claim terms are afforded “their ordinary and customary meaning.”⁴¹ “[T]he ordinary and customary

³⁶ *KSR*, 550 U.S. at 418-19.

³⁷ *In re Karn*, 441 F.3d 997, 988 (Fed. Cir. 2006) (emphasis added).

³⁸ *See KSR*, 550 U.S. at 406 (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966)).

³⁹ EX2016 at ¶25.

⁴⁰ *See* 37 C.F.R. § 42.100(b); *see also Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*, 83 Fed. Reg. 51,340 (Oct. 11, 2018) (applicable to *inter partes* reviews filed on or after November 13, 2018).

⁴¹ *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005).

meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.”⁴² Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy.⁴³ Other than the terms specifically addressed below, Allani assumes that each term of the Challenged Claims is interpreted as construed by the Court in the district court litigation. Allani reserves the right to offer additional constructions should a review be instituted on any of the proposed grounds.

1. “a preliminary search for information or service, locally performed within said communication device” or “a preliminary search locally performed within said communication device”

Allani contends that the plain meaning of this term requires that the initial search for information occur on selection pages pre-stored on the communication device. The patent specification makes clear that the beforehand storing of the claimed selection pages is an implementation step not performed by the user:

Furthermore, it is particularly advantageous *to plan* in the welcome page icons for selecting a consulting language among a plurality of proposed languages, for example, under the form of flags for States wherein each proposed language is used. For that, several sets of selection pages *beforehand stored* each corresponding to a proposed language will be provided.⁴⁴

⁴² *Id.* at 1313.

⁴³ *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

⁴⁴ EX1001 at 2:59-65 (emphasis added).

It is these pre-stored pages that allow the user to achieve the advantages of the invention:

Thus, by locally *implementing* preliminary selection steps in pages organized in a tree manner and operating as rolling menus, and by finally emitting on the Internet only a complete address for accessing a well-targeted information source, the mean time duration observed for accessing searched information is drastically reduced.⁴⁵

2. “beforehand locally stored”

Allani contends that the plain meaning of the term “beforehand locally stored” requires that the claimed selection pages be pre-stored on the claimed communications device *before* the user conducts the preliminary search. As noted above, the patent specification makes clear that the beforehand storing of the claimed selection pages is an implementation step not performed by the user.⁴⁶

3. “direct access icon”

Allani contends that the claimed “direct access icons” also are predefined. In other words, the district court’s construction should be properly understood to mean that the website corresponding to the icon is not determined by user action. This interpretation flows from the plain claim language, which requires that the claimed selection pages be “beforehand locally stored.” Because the claims require that each

⁴⁵ *Id.* at 2:28-32 (emphasis added).

⁴⁶ *See supra* at n. 44; *see also* EX1001 at 4:53-55 (“the whole operations for selecting themes and sub-themes having been beforehand locally realized by means of the method according to the invention.”).

selection page include one or more direct access icons, the direct access icons must also be beforehand locally stored, and hence predefined.

V. GROUND 1: CLAIMS 1-6, 9-15, AND 17-19 ARE NOT OBVIOUS OVER ROSSMANN, HIMMEL, AND KING

Even if the Board does not exercise its discretion and deny institution, which it should, the Board should deny the Petition to institute review of the challenged claims because neither of the two grounds raised in the Petition provides a basis for the Board to find that there is a reasonable likelihood of prevailing on any claim challenged in the Petition. Below, Allani provides examples of why these grounds clearly fail to render the Challenged Claims unpatentable and expressly reserves the right to provide additional reasons and support should a review be instituted on any proposed ground.

A. Claim 1(Pre) – _A method for accessing information- or service providing web sites, from a mobile communication device connected through a communication network and provided with a display, comprising:

The parties do not contend that the preamble is a limitation on the claim.

Therefore, it is irrelevant to the validity analysis.

B. Claim 1(a)(1) - 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,

1. a preliminary search for information or service, locally performed within said communication device

Rossmann does not disclose claim 1(a)(1) because Rossmann does not teach a preliminary search for information pre-stored on a communication device as required by the plain claim language. As the Petition admits, Rossmann teaches that a user initiates a communication session request to a server device and downloads an HDML deck from a server device to be cached locally in a mobile device in RAM.⁴⁷ This initial step shows that the HDML decks are not pre-stored. The Petition further states “[u]pon receiving a request from the user, the client module in the mobile device 142 first consults the work memory 148 therein to determine if the requested deck is available.”⁴⁸ If the request is met by one of the cards in the deck, then that card is accessed without any communication with the server.⁴⁹ If not, “a connection initiated by the client module 146 to the server device 144 is made to fetch the new deck.”⁵⁰ The Petition states that Rossmann teaches an application of the latter scenario “where a user performs a local preliminary search for information within the mobile device *after* fetching a new deck.”⁵¹ A search for information within the mobile device after fetching a new deck also is not a search of pre-stored

⁴⁷ Petition at 17.

⁴⁸ *Id.* (quoting Rossmann at 8:49-55).

⁴⁹ *Id.* (citing Rossmann at 8:49-55).

⁵⁰ *Id.* (quoting Rossmann at 8:55-64).

⁵¹ *Id.* at 17.

information.

A POSITA would not have understood the preliminary searches performed locally within Rossmann's mobile device to be consistent with the disclosures of the '877 patent because they do not concern preliminary searches of pre-stored information.⁵² In this regard, the Petition's reliance on the passage at 2:27-36 of the '877 patent is misplaced and taken out of context. Although this passage describes a preliminary search of local pages performed by the user before the final target information is obtained, the specification also makes clear that the local pages are pre-stored.⁵³ Rossmann does not disclose this feature because the HDML decks in Rossmann are not pre-stored. Rather, Rossmann discloses that the user must first download the decks to the communications device before conducting what the Petition contends constitutes a preliminary search of local pages. In this way, Rossmann relies on network-dependent navigation of user-selected HDML decks, unlike the '877 patent's locally performed preliminary search of pre-stored selection pages.⁵⁴ As such, Rossmann's search does not serve the same goal as the preliminary search in the '877 patent. Rossmann's alleged preliminary search is network-dependent whereas the '877 patent's preliminary search is not.⁵⁵

⁵² EX2016 at ¶¶41-44.

⁵³ EX1001 at 2:59-65, 4:53-55.

⁵⁴ EX2016 at ¶¶43-44; EX1004 at 6:20-29; 8:48-60.

⁵⁵ EX2016 at ¶¶43-44.

C. Claim 1(a)(2) - said selection pages being organized in a structure of tree menu and beforehand locally stored within said communication device,

Rossmann does not claim 1(a)(2) because Rossmann does not disclose selection pages that are “beforehand locally stored.” Petitioner contends that Rossmann’s HDML cards correspond to selection pages and “are stored ‘before’ the final target information is obtained and therefore are ‘beforehand locally stored’ as claimed.”⁵⁶ This contention, however, is inconsistent with the plain claim language. As noted above, the ’877 patent uses “beforehand” to mean stored before any navigation begins: “[The] selection pages [are] organized within a structure of tree menu and beforehand locally stored.”⁵⁷ The user can thus begin his or her search by locally navigating prestored selection pages. Conversely, Rossmann’s “storage” occurs only after a user initiates navigation and only for the single HDML deck retrieved.⁵⁸ A POSITA would understand Rossmann as teaching on-demand caching, not advance preloading of an entire tree of selection pages.⁵⁹ Treating Rossmann’s reactive storage as “beforehand” is therefore inconsistent with the plain claim language and does not disclose this limitation.⁶⁰

⁵⁶ Petition at 22.

⁵⁷ EX1001 at 2:8-16.

⁵⁸ EX2016 at ¶46.

⁵⁹ *Id.*; EX1004 at 6:20–29; 8:48–60.

⁶⁰ EX2016 at ¶46.

D. Claim 1(a)(3) - each said selection page comprising a set of icons including one or more direct access 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,

Rossmann does not teach claim 1(a)(3) because, as Petition admits, Rossmann does not teach a selection page comprising both selection icons and “direct access icon.” Instead, Petitioner claims that Himmel teaches downloading locally stored bookmark sets, which Petitioner considers to be sets of direct access icons.⁶¹ But Himmel’s bookmark sets are not direct access icons. As noted above, the plain claim language requires that the claimed selection pages be beforehand locally stored. Because the Challenged Claims require that the claimed selection pages comprise both one or more selection icons and one or more direct access icons, then the direct access icons, by definition, must also be beforehand hand locally stored. Himmel, however, does not teach bookmark sets that are beforehand locally stored on selection pages. Rather, Himmel teaches downloading a bookmark sets from a web server to a web client running on the user's computer.⁶² Such downloads are initiated by the user and are not beforehand locally stored.⁶³ Additionally, a POSITA would

⁶¹ Petition at 26-27.

⁶² EX2016 at ¶¶56-58; EX1005 at 21:3-17.

⁶³ EX2016 at ¶¶56-58; EX1005 at 21:3-17; *see also* Petition at 27 (stating that a “consumer hotlist” bookmark can be download by a pull operation “*by the user.*”)(emphasis added).

not have been motivated to combine Rossmann and Himmel. Petitioner does not provide an articulated, evidence-based reason why a POSITA would modify Rossmann’s server-driven deck flow with Himmel’s bookmark sets to achieve selection pages with direct access icons that are beforehand locally stored. General appeals to usability or “design choice” are conclusory and entitled to little weight.⁶⁴ Rossmann and Himmel represent fundamentally incompatible system architectures that cannot be harmoniously combined.

In Rossmann’s architecture, a server first delivers an HDML deck to a mobile device, which then enables local navigation within the downloaded decks. Network access is conditional and secondary—triggered only when local content is exhausted.⁶⁵ The system’s intelligence lies in avoiding network traffic by maximizing local navigation within server-delivered content.⁶⁶ Himmel’s architecture, on the other hand, bypasses local navigation entirely through controlled network access upon bookmark selection.⁶⁷ Network access is primary—every bookmark triggers an attempt at network access without any local preliminary search.⁶⁸ As such, these systems operate on opposite principles regarding when and

⁶⁴ 37 C.F.R. § 42.65(a).

⁶⁵ EX2016 at ¶60.

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ *Id.*

how network access occurs.⁶⁹ Rossmann defers network access to minimize latency; Himmel prioritizes network access for specified content.⁷⁰ A POSITA would recognize that combining these contradictory approaches would require abandoning the core operational logic of one or both systems.⁷¹

Combining these references would not be a simple modification but would require a complete redesign of both systems.⁷² To accommodate Himmel-style network access, Rossmann would need an entirely new user interface paradigm that bypasses its “cache-first, network-second” logic.⁷³ This design would require abandoning Rossmann’s core innovation—intelligent caching to minimize network requests.⁷⁴ In actuality, the references teach away from combination. Rossmann explicitly addresses the “poor performance of the internet on early mobile devices” caused by excessive network requests.⁷⁵ Its entire purpose is reducing “latency of the information delivery” and minimizing “network traffic.”⁷⁶ Himmel’s focus on controlled network access directly contradicts this design goal. Its design assumes network access is desirable once a bookmark is selected, teaching away from local-

⁶⁹*Id.*

⁷⁰*Id.*

⁷¹*Id.*

⁷² *Id.* at ¶61.

⁷³ *Id.*

⁷⁴ *Id.*

⁷⁵ EX1004 at Abstract.

⁷⁶ *Id.*

first preliminary search architectures.⁷⁷ A POSITA would recognize that Rossmann and Himmel solve different problems through contradictory approaches and would not be motivated to combine them into the claimed local-first, pre-stored selection page architecture.⁷⁸

Rossmann's conditional server fetch of HDML decks conflicts with a system in which selection pages are all present beforehand and navigation is local until a final selection.⁷⁹ Grafting Himmel's network retrieval onto Rossmann would push network access earlier in the flow, contrary to the '877 architecture that defers network access until after a local preliminary search.⁸⁰ This change undermines Rossmann's principle of operation and is not suggested by either reference.⁸¹ Implementing a device-resident, multi-level tree of selection pages "beforehand," with qualifying icons would require substantial redesign on the constrained mobile devices disclosed in Rossmann, which had limited computing resources.⁸² Neither Rossmann nor Himmel provides guidance for creating and maintaining such a preloaded tree on such a device.⁸³ Himmel also contemplates that its bookmarking

⁷⁷ *Id.*

⁷⁸ EX2016 at ¶61.

⁷⁹ *Id.* at ¶62.

⁸⁰ *Id.*

⁸¹ *Id.*

⁸² *Id.*; EX1004 at 2:8-34.

⁸³ EX2016 at ¶62.

technology would be implemented on traditional computing systems, not the mobile communications devices disclosed in Rossmann.⁸⁴

Even if a POSITA contemplated modifying Rossmann to incorporate Himmel's bookmarking technology, a POSITA would not have had a reasonable expectation of success making this modification. As noted above, Rossmann and Himmel concern different device form factors.⁸⁵ Petitioner cites no evidence that Rossmann could accommodate Himmel's bookmarking technology given Rossmann's limited computing resources. Implementing the claimed selection-page tree with icon sets on 1999 mobile devices would require substantial memory and processing resources that were severely constrained at the time.⁸⁶ Neither Rossmann nor Himmel provides guidance for creating and maintaining a preloaded tree of selection pages specifically designed to include pictorial icon sets, nor for device-side generation of website addresses during icon selection on such resource-limited platforms.⁸⁷

Even if Rossmann could accommodate Himmel's bookmarking technology, Petitioner cites no evidence that Rossmann could accommodate or that this combination would yield selection pages that are beforehand locally stored in a tree

⁸⁴ *Id.*; EX1005 at 3:66-4:11.

⁸⁵ EX2016 at ¶63; *compare* EX1004 at 2:8-34 with EX1005 at 3:66-4:11.

⁸⁶ EX2016 at ¶63.

⁸⁷ *Id.*

menu and icons within those pages that, when selected, send a direct request to the corresponding web server. Petitioner claims that pages with both selection and direct access icons like the modified Rossmann-Himmel system were already known in the art as disclosed in Logan.⁸⁸ But as Petitioner's expert admits, Logan discloses an "attract page" displayed on a public access kiosk, which contains links to local and remote information sources.⁸⁹ The kiosks disclosed in Logan include a personal computer, which is connected to the internet via a modem and operates in a fixed-location, broadband environment.⁹⁰ The '877 patent, by contrast, addresses "a communication device connected via a network to the Internet" where "preliminary selection steps" can be performed on the device itself rather than over the network.⁹¹ Logan's focus on persistent broadband kiosk operation is not reasonably pertinent to the '877 patent's local multi-level navigation for mobile devices. Petitioner does not explain how a mobile UI engineer in 1999 would have looked to a fixed-location, broadband-connected kiosk with an "attract page" system to solve the problem identified in the '877 patent: "[avoiding] delays from busy networks and [simplifying] browsing for users poorly accustomed to Internet searches."⁹²

⁸⁸ Petition at 30 (citing EX1003 at ¶113).

⁸⁹ EX1003 at ¶56; EX1025 at 4:55-68.

⁹⁰ EX1025 at 3:30-50.

⁹¹ EX1001 at abstract, 1:65-2:16.

⁹² EX1001 at 1:36-43.

Moreover, Petitioner cites no evidence that Rossmann's mobile communications devices could accommodate the modified Rossmann-Himmel pages, much less prestore these pages.

As detailed in further below, the combined teachings still fails to disclose multiple limitations of independent claim 1 (and mirrored device claim 12), including "beforehand locally stored" selection pages including "direct access icons" and "locally generated" addresses.

E. Claim 1(a)(4) - wherein at least one of said selection pages comprises two or more direct access icons, and

Rossmann-Himmel does not disclose a selection page comprising two or more direct access icons because Rossmann-Himmel does not disclose selection pages with direct access icons that are beforehand locally stored for the reasons stated in claim 1(a)(2) and 1(a)(3) above. A POSITA would not have been motivated to combine Rossmann and Himmel for the reasons stated in claim 1(a)(3) above.

F. Claim 1(b) - 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,

Rossmann-Himmel does not claim 1(b) because Rossmann-Himmel does not disclose selection pages with direct access icons that are beforehand locally stored for the reasons stated in claim 1(a)(2) and 1(a)(3) above. A POSITA would not have

been motivated to combine Rossmann and Himmel for the reasons stated in claim 1(a)(3) above.

G. Claim 1(b)(1) - said address being locally generated during the display and selection steps and directly accessing said information- or service-providing web site.

Rossmann-Himmel does not disclose claim 1(b)(1) because, as Petitioner admits, Rossmann does not disclose “said address being locally generated.”⁹³ Petitioner contends that King discloses this feature and that a POSITA would have been motivated to apply King's teaching to the Rossmann-Himmel system.⁹⁴ But not only would a POSITA not have been motivated to combine Rossmann and Himmel for the reasons stated in claim 1(a)(3) above, a POSITA would not have been motivated to modify the Rossmann-Himmel system with King except in hindsight.

Using the '877 patent to identify pieces of prior art and then simply pulling in additional references to fill in the gaps is firmly prohibited as amounting to hindsight reconstruction by using the invention itself.⁹⁵ Impermissible hindsight must be avoided and the Board must be cautious of arguments that rely on such *ex post* reasoning.⁹⁶

⁹³ Petition at 33.

⁹⁴ *Id.*

⁹⁵ *See KSR*, 550 U.S. at 421.

⁹⁶ *See Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1361 (Fed. Cir. 2016).

Petitioner violates these principles by alleging that King provided the missing element of URL generation. Not only does Rossmann-Himmel fail to disclose much more than just URL generation, but the need for URL generation only becomes apparent based on facts gleaned from the '877 patent, not the alleged prior art. Indeed, Rossmann-Himmel teaches away from locally generating an address because the addresses generated by Himmel's bookmarking technology are not generated locally. A POSITA would only be led to the flawed combination of Rossmann-Himmel and King if a POSITA starts with the claimed elements of the '877 patent and seeks to find them in the alleged prior art.⁹⁷ Because this combination only makes sense in hindsight, it does render the Challenged Claims obvious.

H. Claim 2 – The method according to claim 1, characterized in that the locally generated addresses are locally stored in a table or base of addresses.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1. Because claim 2 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 2 and thus does not render claim 2 obvious.

⁹⁷ EX2016 at ¶68.

Specifically, Rossmann-Himmel-King does not disclose locally generated addresses for the reasons set forth in claim 1(b)(1) above. A POSITA also would not have been motivated to modify the Rossmann-Himmel system with King's URL generation except in hindsight as set forth in claim 1(b)(1) above. A POSITA further would not have found it obvious to store Rossmann-Himmel-King's URLs in a well-known data structure in RAM, such as a table, except in hindsight for the reasons set forth in claim 1(b)(1) above.

I. Claim 3 - The method according to claim 1, characterized in that the locally generated addresses are generated in the progress of the display and selection steps.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1. Because claim 3 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 3 and thus does not render claim 3 obvious.

Specifically, Rossmann-Himmel-King does not disclose locally generated addresses for the reasons set forth in claim 1(b)(1) above. A POSITA also would not have been motivated to modify the Rossmann-Himmel system with King's URL generation except in hindsight as set forth in claim 1(b)(1) above.

J. Claim 4 - The method according to claim 1, characterized in that the direct access icons comprise icons for accessing merchant sites.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1. Because claim 4 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 4 and thus does not render claim 4 obvious.

Specifically, Rossmann-Himmel does not disclose beforehand locally stored selection pages with direct access icons for the reasons set forth in claim 1(a)(3) above. A POSITA also would not have been motivated to modify Rossmann with Himmel's bookmarking technology for the reasons set forth in claim 1(a)(3) above.

Petitioner contends that Himmel teaches that its bookmark sets may be applied in a kiosk or point of sale environment and that it would have been obvious to apply this application in Rossmann's invention.⁹⁸ This argument, however, represents an improper use of an obvious to try rationale. The Petition fails to show that the claimed solution would have been selected from a finite number of identified, predictable solutions, with a reasonable expectation of success.⁹⁹ A POSITA further would not have been motivated to implement Rossmann's invention in the vendor kiosk environment described in Himmel.¹⁰⁰ As noted above, Rossmann and Kimmel concern different device form factors. A POSITA would not have understood that

⁹⁸ Petition at 40.

⁹⁹ *See Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1359 (Fed. Cir. 2007).

¹⁰⁰ *Contra* Petition at 41.

Rossmann's methods are applicable to kiosks applications as there is no disclosure in Rossmann suggesting that it could be applied outside of the context of mobile computing devices and related devices.¹⁰¹ Moreover, implementing Rossmann's invention in Himmel's kiosk environment does not teach the claimed invention, which is directed to mobile communication devices.¹⁰²

K. Claim 5 - The method of claim 4, characterized in that an icon for directly accessing a merchant site includes a logotype of said merchant site.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 4. Because claim 5 incorporates all of the limitations of claim 4, Rossmann-Himmel-King does not disclose all of the limitations of claim 5 and thus does not render claim 5 obvious.

Specifically, Rossmann-Himmel does not disclose beforehand locally stored selection pages with direct access icons for the reasons set forth in claim 1(a)(3) above. A POSITA would not have been motivated to modify Rossmann with Himmel's bookmarking technology for the reasons set forth in claim 1(a)(3) above. A POSITA also would not have been motivated to combine Rossmann-Himmel with King for the reasons set forth in claim 1(b)(1) above. A POSITA further would not

¹⁰¹ See, e.g., EX1001 at 1:18-23.

¹⁰² EX1001 at 5:12-18, 5:20-23.

have been motivated to implement Rossmann in Himmel's kiosk environment for the reasons set forth in claim 4 above.

L. Claim 6 - The method according to claim 1, characterized in that an icon for accessing a selection page includes a thematic title.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1. Because claim 6 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 6 and thus does not render claim 6 obvious.

Specifically, Rossmann-Himmel-King does not disclose selection pages that are beforehand locally stored for the set forth in claim 1(a)(2) above. A POSITA would not have been motivated to combine Rossmann's HDML decks and Himmel's bookmarking technology for the reasons set forth in claim 1(a)(2) above.

M. Claim 9 - The method according to claim 1, wherein said at least one selection page comprising two or more direct access icons comprises direct access icons corresponding to distinct sources of information or services.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1. Because claim 9 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 9 and thus does not render claim 9 obvious.

Specifically, Rossmann-Himmel does not disclose selection pages with direct access icons that are beforehand locally stored for the reasons stated in claim 1(a)(2)

and 1(a)(3) above. A POSITA would not have been motivated to combine Rossmann and Himmel for the reasons stated in claim 1(a)(3) above.

N. Claim 10 - The method according to claim 1 wherein said mobile communication device is a mobile phone.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1. Because claim 10 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 10 and thus does not render claim 10 obvious.

Additionally, a POSITA would not have been motivated to combine Rossmann, Himmel, and King for the reasons discussed above.

O. Claim 11 - The method according to claim 1 further comprising displaying on said display a page from a web site in response to selecting a direct access icon.

As noted above, Rossmann-Himmel does not disclose all of the limitations of claim 1. Because claim 11 incorporates all of the limitations of claim 1, Rossmann-Himmel does not disclose all of the limitations of claim 11 and thus does not render claim 11 obvious.

Specifically, Rossmann-Himmel does not disclose selection pages with direct access icons that are beforehand locally stored for the reasons stated in claim 1(a)(3) above. A POSITA would not have been motivated to combine Rossmann and Himmel for the reasons stated in claim 1(a)(3) above.

- P. Claim 12(Pre) – _A device for accessing information- or service- providing web sites² comprising a mobile communication device connectable through a communication network to the Internet, control and processing device or devices, data storage device or devices, a display, and pointing and selection device or devices, said storage device or devices containing a plurality of selection pages each comprising a set of icons, characterized in that, for each said selection page, the set of icons includes one or more direct access icons for directly accessing an information- or service-providing web site and one or more selection icons for locally accessing another selection page within a structure of a tree menu, wherein at least one of said selection pages comprises two or more direct access icons, and in that the control and processing device or devices are programmed for:**

Rossmann-Himmel does not disclose 12(pre) because Rossmann-Himmel does not disclose selection pages with direct access icons that are beforehand locally stored for the reasons stated in claim 1(a)(3) above. A POSITA would not have been motivated to combine Rossmann and Himmel for the reasons stated in claim 1(a)(3) above.

- Q. Claim 12(a) – enabling a preliminary search locally performed within said communication device in different themes and subthemes within a plurality of selection pages organized in said structure of tree menu and beforehand locally stored in said data storage means within said communication device,**

Rossmann does not disclose claim 12(a) because Rossmann does not teach a preliminary search for information pre-stored on a communication device for the reasons set forth in claim 1(a)(1) above.

- R. Claim 12(a)(1) – _each said selection page comprising a set of icons including one or more icons for directly accessing an**

information- or service-providing web site and one or more selection icons for locally accessing and displaying on the display means another selection page within said structure of tree menu, and

Rossmann-Himmel does not disclose 12(a)(1) because Rossmann-Himmel does not disclose selection pages with direct access icons that are beforehand locally stored for the reasons stated in claim 1(a)(3) above. A POSITA would not have been motivated to combine Rossmann and Himmel for the reasons stated in claim 1(a)(3) above.

S. Claim 12(b) – _emitting on the communication network, in response to selecting a direct access icon by the pointing and selection device or devices in a selection page being currently displayed, an address of an information- or service-providing web site corresponding to said selected direct access icon,

Rossmann-Himmel does not claim 12(b) because Rossmann-Himmel does not disclose selection pages with direct access icons that are beforehand locally stored for the reasons stated in claim 1(a)(2) and 1(a)(3) above. A POSITA would not have been motivated to combine Rossmann and Himmel for the reasons stated in claim 1(a)(3) above.

T. Claim 12(b)(1) – said address being locally generated during the preliminary search and selection steps.

Rossmann-Himmel-King does not disclose claim 12(b)(1) because Rossmann-Himmel-King does not disclose “said address being locally generated” for the reasons stated in claim 1(b)(1) above. A

POSITA would not have been motivated to modify the Rossmann-Himmel system with King's URL generation except in hindsight as set forth in claim 1(b)(1) above.

U. Claim 13 - The device according to claim 12, characterized in that the control and processing device or devices are further arranged for locally generating addresses for information sources in the progress of preliminary search and selection steps.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 12. Because claim 13 incorporates all of the limitations of claim 12, Rossmann-Himmel-King does not disclose all of the limitations of claim 13 and thus does not render claim 13 obvious.

Specifically, Rossmann-Himmel-King does not disclose locally generated addresses for the reasons set forth in claim 1(b)(1) above. A POSITA also would not have been motivated to modify the Rossmann-Himmel system with King's URL generation except in hindsight as set forth in claim 1(b)(1) above.

V. Claim 14 - The device according to claim 12, further comprising at least one document processor, characterized in that it is arranged for being installed in a public booth in substitution of an existing phone device.

As noted above, Rossmann-Himmel does not disclose all of the limitations of claim 12. Because claim 14 incorporates all of the limitations of claim 12, Rossmann-Himmel does not disclose all of the limitations of claim 14 and thus does not render claim 14 obvious.

Specifically, a POSITA would not have been motivated to implement Rossmann in Himmel's kiosk environment for the reasons set forth in claim 4 above.

W. Claim 15 - The device according to claim 12, characterized in that the direct access icons comprise icons for accessing commercial sites.

As noted above, Rossmann-Himmel does not disclose all of the limitations of claim 12. Because claim 15 incorporates all of the limitations of claim 12, Rossmann-Himmel does not disclose all of the limitations of claim 15 and thus does not render claim 15 obvious.

Specifically, Rossmann-Himmel does not disclose beforehand locally stored selection pages with direct access icons for the reasons set forth in claim 1(a)(3) above. A POSITA would not have been motivated to modify Rossmann with Himmel's bookmarking technology for the reasons set forth in claim 1(a)(3) above. A POSITA also would not have been motivated to combine Rossmann-Himmel with King for the reasons set forth in claim 1(b)(1) above. A POSITA further would not have been motivated to implement Rossmann in Himmel's kiosk environment for the reasons set forth in claim 4 above.

X. Claim 17 - The device according to claim 12, wherein said at least one selection page comprising two or more direct access icons comprises direct access icons corresponding to distinct sources of information or services.

As noted above, Rossmann-Himmel does not disclose all of the limitations of claim 12. Because claim 17 incorporates all of the limitations of claim 12, Rossmann-Himmel does not disclose all of the limitations of claim 17 and thus does not render claim 17 obvious.

Specifically, Rossmann-Himmel does not disclose selection pages with direct access icons that are beforehand locally stored for the reasons stated in claim 1(a)(2) and 1(a)(3) above. A POSITA would not have been motivated to combine Rossmann and Himmel for the reasons stated in claim 1(a)(3) above.

Y. Claim 18 - The device according to claim 12 wherein said mobile communication device is a mobile phone.

As noted above, Rossmann-Himmel does not disclose all of the limitations of claim 12. Because claim 18 incorporates all of the limitations of claim 12, Rossmann-Himmel does not disclose all of the limitations of claim 18 and thus does not render claim 18 obvious.

Additionally, a POSITA would not have been motivated to combine Rossmann, Himmel, and King for the reasons discussed above.

Z. Claim 19 - The device according to claim 12 wherein a page from a web site is displayed on said display in response to selecting a direct access icon.

As noted above, Rossmann-Himmel does not disclose all of the limitations of claim 12. Because claim 19 incorporates all of the limitations of claim 12,

Rossmann-Himmel does not disclose all of the limitations of claim 19 and thus does not render claim 19 obvious.

Specifically, Rossmann-Himmel does not disclose selection pages with direct access icons that are beforehand locally stored for the reasons stated in claim 1(a)(3) above. A POSITA would not have been motivated to combine Rossmann and Himmel for the reasons stated in claim 1(a)(3) above.

VI. Ground 2: Claims 7-8, 16 Are Not Obvious Over Rossmann, Himmel, King, And Boyle

Ground 2 should be rejected because it is based on impermissible hindsight. For the reasons set forth below, Petitioner fails to show any reasonable likelihood that it will prevail on ground 2. Accordingly, the Petition to institute review on ground 2 should be denied.

A. Claim 7 - The method according to claim 1, characterized in that it further comprises an updating of the plurality of locally stored selection pages.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1. Because claim 7 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 7 and thus does not render claim 7 obvious.

Specifically, Rossmann-Himmel-King does not disclose selection pages that are beforehand locally stored for the set forth in claim 1(a)(2) above. A POSITA

would not have been motivated to combine Rossmann's HDML decks and Himmel's bookmarking technology for the reasons set forth in claim 1(a)(2) above.

A POSITA also would not have been motivated to combine Rossmann, Himmel, King, and Boyle.

Rossmann-Himmel-King does not disclose claim 1(b)(1) because, as Petitioner admits, Rossmann-Himmel-King does not disclose a process to update Rossmann's HDML decks when new web information is available.¹⁰³ Petitioner contends that Boyle discloses this feature and that a POSITA would have been motivated to apply Boyle's teaching to the Rossmann-Himmel-King system.¹⁰⁴ But not only would a POSITA not have been motivated to combine Rossmann and Himmel for the reasons stated in claim 1(a)(2) above, a POSITA would not have been motivated to modify the Rossmann-Himmel-King system with Boyle except in hindsight.

Using the '877 patent to identify pieces of prior art and then simply pulling in additional references to fill in the gaps is firmly prohibited as amounting to hindsight reconstruction by using the invention itself.¹⁰⁵ Impermissible hindsight must be

¹⁰³ Petition at 57-58.

¹⁰⁴ *Id.* at 60.

¹⁰⁵ *See KSR*, 550 U.S. at 421.

avoided and the Board must be cautious of arguments that rely on such *ex post* reasoning.¹⁰⁶

Petitioner violates these principles by alleging that Boyle provides the missing element of updating outdated HDML decks.¹⁰⁷ Not only does Rossmann-Himmel-King fail to disclose much more than just updating outdated HDML decks, but the need for updating outdated HDML decks only becomes apparent based on facts gleaned from the '877 patent, not the alleged prior art. Indeed, Rossmann-Himmel-King teaches away from updating locally stored selection pages because Rossmann's HDML decks are not beforehand locally stored. A POSITA would only be led to the flawed combination of Rossmann-Himmel-King and Boyle if a POSITA starts with the claimed elements of the '877 patent and seeks to find them in the alleged prior art.¹⁰⁸ Because this combination only makes sense in hindsight, it does render the Challenged Claims obvious.

Further, the addition of Boyle's update/notification mechanisms does not supply missing limitations from Ground 1.¹⁰⁹ Updating local content presupposes the existence of the specific content to be updated. Here, Petitioner has not shown the claimed plurality of "selection pages" that are "beforehand locally stored" in a

¹⁰⁶ See *Arendi*, 832 F.3d at 1361.

¹⁰⁷ *Id.*

¹⁰⁸ EX2016 at ¶72.

¹⁰⁹ EX2016 at ¶71.

“tree menu,” nor qualifying “direct access icons,” nor “locally generated” addresses.

Without that baseline, Boyle’s updates cannot remedy the deficiencies.¹¹⁰

B. Claim 8 - The method according to claim 7, characterized in that this updating is achieved by downloading from a management server.

As noted above, Rossmann-Himmel-King-Boyle does not disclose all of the limitations of claim 7. Because claim 8 incorporates all of the limitations of claim 7, Rossmann-Himmel-King does not disclose all of the limitations of claim 8 and thus does not render claim 8 obvious.

Specifically, Rossmann-Himmel-King does not disclose selection pages that are beforehand locally stored for the set forth in claim 1(a)(2) above. A POSITA also would not have been motivated to modify the Rossmann-Himmel-King system with Boyle’s system for updating outdated addresses except in hindsight as set forth in claim 7 above.

C. Claim 16 - The device according to claim 12, characterized in that 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.

As noted above, Rossmann does not disclose all of the limitations of claim 12. Because claim 16 incorporates all of the limitations of claim 12, Rossmann does not disclose all of the limitations of claim 16 and thus does not render claim 16 obvious.

¹¹⁰ *Id.*

Specifically, Rossmann-Himmel-King does not disclose selection pages that are beforehand locally stored for the set forth in claim 1(a)(2) above. A POSITA also would not have been motivated to modify the Rossmann-Himmel-King system with Boyle's system for updating outdated addresses except in hindsight as set forth in claim 7 above.

VII. CONCLUSION

In conclusion, the Petition is not reasonably likely to prevail on any of the grounds asserted against the Challenged Claims. Accordingly, all grounds to institute review should be denied.

Date: August 22, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Under 37 C.F.R. § 42.24, I certify that Sections I-VII of this **PATENT OWNER'S PRELIMINARY RESPONSE** have a total of 8,386 words according to the word count tool in Microsoft Word™.

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Date: August 22, 2025

CERTIFICATE OF SERVICE

I certify that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** was served on August 22, 2025 on Petitioner by filing this document through Patent Trial and Appeal Case Tracking System (P-TACTS) as well as e-mailing a copy to PTAB@eriseip.com.

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