

CASE IPR2025-00857
U.S. Patent No. 10,943,058

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

FERID ALLANI
Patent Owner.

CASE IPR2025-00857
U.S. Patent No. 10,943,058

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
The Interim Processes Memo	Interim Processes for PTAB Workload Management dated March 26, 2025
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

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.)
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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 Declaration 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 in an effort 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 1-4 fail to establish that a POSITA would have been 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 '058 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 EX1003 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 and cards 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 can not be

⁹ *Id.*

¹⁰ EX1001.

¹¹ EX2016 at ¶36.

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 ¶37.

¹⁶ *Id.*

¹⁷ *Id.*

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 The bookmarks function as gatekeepers that check requested URLs against stored lists before allowing network retrieval, which is fundamentally different from direct access icons that are pre-designed components of local selection pages and cause direct server requests upon selection.²²

¹⁸ EX1005 at Abstract.

¹⁹ EX1005 at Fig. 2.

²⁰ EX1005 at 18:53-21:26.

²¹ EX2016 at ¶38.

²² *Id.*

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.²³ King further provides examples of variable substitution affecting URL parameters in HDML actions.²⁴ King focuses on parameterizing preexisting server-defined URLs through variable substitution rather than device-side generation of website addresses.²⁵ Its menus are presented dynamically over the network, and the URLs are generated in response to server-driven interactions.²⁶ 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.²⁷

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

²³ EX1006 at Abstract.

²⁴ *Id.* at 9:49–10:27, 10:13–27.

²⁵ EX2016 at ¶41.

²⁶ *Id.*

²⁷ *Id.*

the server devices that stores the updated information.”²⁸ 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.”²⁹ As such, Boyle describes an on-demand content refresh system for cached HDML decks, not the 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.³⁰ 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.”³¹ This feature undermines the ’058 patent’s

²⁸ EX1007 at 2:9-28.

²⁹ EX1007 at 2:27-28, 5:23-36.

³⁰ EX2016 at ¶43.

³¹ EX2016 at ¶43; EX1007 at 2:9-20.

purpose of avoiding network access until the final selection.³² Boyle's updates replace or modify content, not preload an entire multi-level menu tree for local searching.³³ Boyle also does not disclose direct access icons leading to a final network address without intermediate downloads.³⁴

E. ADAR

Adar teaches a centralized bookmark database that maintains users' bookmark collections, with downloadable bookmark data and a shared bookmarks program that can be received "from the database 1022 at the beginning of a session of use."³⁵ The user's bookmark collection can be "maintained and modified locally at the user's system 1010" such that "many operations performed by the shared bookmark system can be executed at the user's system 1010 without any further communication with the database 1022."³⁶ This describes a bookmark management system with downloadable URL lists, not the claimed architecture of "beforehand locally stored" selection pages "specifically designed to include a set of icons" within a tree menu structure.³⁷

³² EX2016 at ¶43.

³³ *Id.*

³⁴ *Id.*

³⁵ EX1008 at 10:41-53 & Fig. 10.

³⁶ EX1008 at 10:47-57.

³⁷ EX2016 at ¶44.

IV. LEGAL STANDARDS

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.”³⁸ 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.³⁹

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

³⁸ 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).

³⁹ 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.”⁴⁰ “Some rational underpinning must be provided . . . conclusory statements are insufficient.”⁴¹

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.⁴² 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.⁴³

C. CLAIM CONSTRUCTION

The Board applies the claim construction standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).⁴⁴ Under *Phillips*, claim terms are afforded “their ordinary and customary meaning.”⁴⁵ “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of

⁴⁰ *KSR*, 550 U.S. at 418-19.

⁴¹ *In re Karn*, 441 F.3d 997, 988 (Fed. Cir. 2006) (emphasis added).

⁴² *See KSR*, 550 U.S. 406 (quoting *Graham*, 383 U.S. at 17).

⁴³ EX2016 at ¶25.

⁴⁴ *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).

⁴⁵ *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005).

ordinary skill in the art in question at the time of the invention.”⁴⁶ Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy.⁴⁷ 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.⁴⁸

⁴⁶ *Id.* at 1313.

⁴⁷ *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

⁴⁸ EX1001 at 2:58-64 (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.⁴⁹

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.⁵⁰

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

⁴⁹ *Id.* at 2:24-29 (emphasis added).

⁵⁰ *See* EX1001 at 4:65-67 (“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 24-26 ARE NOT OBVIOUS OVER ROSSMANN AND HIMMEL

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 four 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 24(Pre) – A mobile communication device connectable to remote sources of information or services through a communication network, the communication device comprising a display, data storage, a processor, a controller and a plurality of pages locally stored in said data storage and displayable on said display**

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

Therefore, it is irrelevant to the validity analysis.

B. Claim 24(a) – wherein a first one of said locally stored pages is specifically designed to include at least one direct access icon capable of being selectively activated to connect said mobile communication device to a first predetermined one of said remote sources of information or services and at least one selection icon capable of being selectively activated to display a second one of said locally stored pages on said display,

1. a first locally stored page specifically designed to include a direct access icon

Rossmann does not teach “locally stored pages” required by claim 24(a).

The '058 patent teaches that screen-pages are “locally stored in a storage unit, for example a hard disk unit or a CD-ROM, of the apparatus wherein this method is implemented.”⁵¹ A POSITA would understand that claimed “locally stored page[s]” reside in the claimed “data storage” which is non-volatile memory taught by the '058 patent.⁵² In contrast, Rossmann teaches that “the phone 120 typically receives a single HDML deck from the server device and stores the deck as cached in RAM 134.”⁵³ A POSITA would understand claim 24’s requirement of “locally stored pages” in “data storage” to mean pages intentionally resident in the device’s non-volatile memory for navigation, not transient cached copies stored in RAM dependent on prior retrieval.⁵⁴

⁵¹ EX1001 at 4:5-7.

⁵² EX2016 at ¶47.

⁵³ EX1004 at 6:27-29.

⁵⁴ EX2016 at ¶47.

Additionally, a POSITA would not have been motivated to combine Rossmann and Himmel. Rossmann's system is designed to primarily use a locally cached "deck" of pages as the primary mode of navigation.⁵⁵ Requests to external resources on a network are only made as a last resort when the local content is insufficient.⁵⁶ In contrast, Himmel's bookmarks are designed for a system with unfettered network access because they always trigger a network request.⁵⁷ Combining Rossmann with Himmel would reintroduce the latency and network cost Rossmann was designed to avoid.⁵⁸

Furthermore, providing a "consistent user interface" does not provide a motivation to combine Rossmann and Himmel because Rossmann already provides a structured navigation model.⁵⁹ Rossmann's hierarchical, cache-based interface already delivers a consistent user experience within its own framework.⁶⁰ Adding Himmel's bookmarks would not enhance consistency but introduce a conflicting interface paradigm: a flat list of external URLs that bypasses Rossmann's designed

⁵⁵ EX2016 at ¶57.

⁵⁶ *Id.*

⁵⁷ *Id.*

⁵⁸ EX2016 at ¶58.

⁵⁹ EX2016 at ¶59.

⁶⁰ *Id.*

navigation sequence. A POSITA would recognize that the result would be less consistent, not more.⁶¹

The addition of Himmel would also not “simply navigation.” To the contrary, because Himmel’s bookmarks always trigger network retrieval, thus increasing latency and dependence on network availability, a POSITA would understand that incorporating Himmel into Rossmann would complicate navigation by mixing local card hierarchies with remote network fetches, making the system slower and less reliable rather than simpler.⁶²

Petitioner also fails to account for the different form factors used in the Rossmann and Himmel systems.⁶³ There would be no expectation of success in implementing the resource intensive methods of Himmel in the resource-limited mobile device of Rossmann.⁶⁴

Thus, Petitioner and Bederson do not sufficiently show that a POSITA would be motivated to combine Rossmann and Himmel.⁶⁵

⁶¹ *Id.*

⁶² EX2016 at ¶60.

⁶³ *Compare* EX1004 at 2:8-34 *with* EX1005 at 3:66-4:11.

⁶⁴ EX2016 at ¶61.

⁶⁵ EX2016 at ¶62.

C. Claim 24(a)(1) – wherein said second one of said locally stored pages is specifically designed to include at least one second direct access icon capable of being selectively activated to connect said mobile communication device to a second predetermined one of said remote sources of information or services, and at least one second selection icon capable of being selectively activated to display a third one of said locally stored pages on said display

Rossmann fails to teach a second locally stored page for the same reasons it fails to teach the first locally stored page as stated in claim 24(a) above.

D. Claim 24(b) – wherein said third one of said locally stored pages is specifically designed to include at least one third direct access icon capable of being selectively activated to connect said mobile communication device to a third predetermined one of said remote sources of information or services, or at least one third selection icon capable of being selectively activated to display a fourth one of said locally stored pages on said display

Rossmann fails to teach a third locally stored page for the same reasons it fails to teach the first locally stored page as stated in claim 24(a) above.

E. Claim 25 – The mobile communication device according to claim 24, wherein at least one of the selection pages is further specifically designed to include one or more icons for directly accessing a search engine on the Web.

As noted above, Rossmann-Himmel does not disclose all of the limitations of claim 24. Because claim 25 incorporates all of the limitations of claim 24, Rossmann-Himmel does not disclose all of the limitations of claim 25 and thus does not render claim 25 obvious.

Furthermore, neither Rossmann nor Rossmann-Himmel teach claim 25 because, as Petitioner admits, Rossmann does not teach a selection page including

an icon “for directly accessing a search engine on the Web.”⁶⁶ Petitioner asserts that “it would have been obvious, based on Himmel’s disclosures, to download a ‘search engine’ icon along with the rest of the hot list icons for display on Rossmann’s mobile device.”⁶⁷ Himmel does not teach a “search engine” as a POSITA would understand it.⁶⁸ A POSITA would understand that a search engine permits a search on the Web, as the ’058 patent describes.⁶⁹ In contrast, a POSITA would understand that Himmel describes a functionality that operates within a single website.⁷⁰ Furthermore, even if Himmel did teach a “search engine,” there would be no motivation to combine Rossmann and Himmel to add it for the reasons discussed above.

F. Claim 26 – The mobile communication device according to claim 24, wherein selective activation of a direct access icon comprises emitting, on the communication network an address of the first, second or third predetermined one of said remote sources.

As noted above, Rossmann-Himmel does not disclose all of the limitations of claim 24. Because claim 26 incorporates all of the limitations of claim 24, Rossmann-Himmel does not disclose all of the limitations of claim 26 and thus does not render claim 26 obvious.

⁶⁶ Paper 1 at 30.

⁶⁷ *Id.*

⁶⁸ EX2016 at ¶¶39, 54-55.

⁶⁹ EX1001 at 5:1-4; EX2016 at ¶39.

⁷⁰ EX1005 at 18:66-19:1; EX2016 at ¶39.

VI. GROUND 2: CLAIMS 1, 2, 4-6, 10-23, AND 27 ARE NOT OBVIOUS OVER ROSSMANN, HIMMEL, AND KING

A. Claim 1(Pre) – Apparatus for accessing information- or service-providing Web sites, comprising a communication device connectable through a communication network to the Internet, control and processing device or devices, data storage device or devices, and a display said storage device or devices containing a plurality of selection pages within a tree menu structure, said selection pages being beforehand locally stored in said data storage device or devices and each being specifically designed for containing a set of icons including at least one of a direct access icon for directly accessing remote sources of information and a selection icon for locally accessing another selection page within said tree menu structure, wherein said plurality of selection pages includes

Rossmann does not teach the limitations of the preamble of claim 1 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.”⁷¹ This contention, however, is inconsistent with the plain claim language. As noted above, the ’058 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.”⁷² The user can thus begin his or her search by locally navigating prestored selection pages.⁷³ Conversely, Rossmann’s “storage” occurs only after a user initiates

⁷¹ Paper 1 at 35.

⁷² EX1001 at 2:8-10; EX2016 at ¶¶27-31.

⁷³ EX2016 at ¶29-31.

navigation and only for the single HDML deck retrieved.⁷⁴ A POSITA would understand Rossmann as teaching on-demand caching, not advance preloading of an entire tree of selection pages.⁷⁵ Treating Rossmann's reactive storage as "beforehand" is therefore inconsistent with the plain claim language and does not disclose this limitation.⁷⁶

B. Claim 1(a) – a first selection page, a second selection page and a third selection page

The recited first, second, and third selection pages are among the plurality of selection pages recited in the preamble. The claimed selection pages must be "beforehand locally stored." For the reasons discussed above in connection with the preamble of claim 1, Rossmann does not teach selection pages that are "beforehand locally stored," and thus does not teach the limitations of claim 1(a).

C. Claim 1(a)(1) – said first selection page being specifically designed for containing a selection icon for locally accessing said second selection page

The recited first selection page is one of the plurality of selection pages recited in the preamble. The claimed selection pages must be "beforehand locally stored." For the reasons discussed above in connection with the preamble of claim

⁷⁴ EX2016 at ¶¶36, 68, 78.

⁷⁵ EX2016 at ¶¶36, 63; EX1004 at 6:20–29; 8:48–60.

⁷⁶ EX2016 at ¶¶36, 63, 68, 78.

1, Rossmann does not teach selection pages that are “beforehand locally stored,” and thus does not teach the limitations of claim 1(a)(1).

D. Claim 1(a)(2) – said second selection page being specifically designed for containing a selection icon for locally accessing said third selection page

The recited second selection page is one of the plurality of selection pages recited in the preamble. The claimed selection pages must be “beforehand locally stored.” For the reasons discussed above in connection with the preamble of claim 1, Rossmann does not teach selection pages that are “beforehand locally stored,” and thus does not teach the limitations of claim 1(a)(2).

E. Claim 1(a)(3) – said third selection page being specifically designed for containing one or more direct access icons for directly accessing an information- or service-providing Web site

The recited third selection page is one of the plurality of selection pages recited in the preamble. The claimed selection pages must be “beforehand locally stored.” For the reasons discussed above in connection with the preamble of claim 1, Rossmann does not teach selection pages that are “beforehand locally stored,” and thus does not teach the limitations of claim 1(a)(3).

Additionally, Rossmann does not teach the limitations of claim 1(a)(3) because, as Petition admits, Rossmann does not teach a selection page comprising both selection icons and “direct access icons.” Instead, Petitioner claims that Himmel teaches downloading locally stored bookmark sets, which Petitioner

considers to be sets of direct access icons.⁷⁷ 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 computer.⁷⁸ Such downloads are initiated by the user and are not beforehand locally stored.⁷⁹

Furthermore, a POSITA would 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.⁸⁰ Rossmann and Himmel represent

⁷⁷ Paper 1 at 21.

⁷⁸ EX2016 at ¶38; EX1005 at 21:3-17.

⁷⁹ EX2016 at ¶38; EX1005 at 21:3-17; *see also* Paper 1 at 22 (stating that a “consumer hotlist” bookmark can be download by a pull operation “*by the user.*”) (emphasis added).

⁸⁰ 37 C.F.R. § 42.65(a).

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.⁸¹ The system is designed to avoid network traffic by maximizing local navigation within server-delivered content.⁸² Himmel's architecture, on the other hand, bypasses local navigation entirely through controlled network access upon bookmark selection.⁸³ Network access is primary—every bookmark immediately triggers an attempt at network access without any local preliminary search.⁸⁴ As such, these systems operate on opposite principles regarding when and how network access occurs.⁸⁵ Rossmann defers network access to minimize latency; Himmel prioritizes network access for specified content.⁸⁶ A POSITA would recognize that combining these contradictory approaches would require abandoning the core operational logic of one or both systems.⁸⁷

⁸¹ EX2016 at ¶57.

⁸² EX2016 at ¶¶35, 57, 60.

⁸³ EX2016 at ¶¶38, 57.

⁸⁴ EX2016 at ¶¶38, 57, 60.

⁸⁵ EX2016 at ¶58, 60.

⁸⁶ EX2016 at ¶¶57-58.

⁸⁷ *Id.*.

Combining these references would not be a simple modification but would require a complete redesign of both systems.⁸⁸ To accommodate Himmel-style network access, Rossmann would need an entirely new user interface paradigm that bypasses its “cache-first, network-second” logic.⁸⁹ This design would require abandoning Rossmann’s core principle—intelligent caching to minimize network requests.⁹⁰ 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.⁹¹ Its entire purpose is reducing “latency of the information delivery” and minimizing “network traffic.”⁹² 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-first preliminary search architectures.⁹³ 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.⁹⁴

⁸⁸ EX2016 at ¶57.

⁸⁹ *Id.*

⁹⁰ EX2016 at ¶¶57-58.

⁹¹ EX1004 at Abstract.

⁹² *Id.*

⁹³ *Id.*

⁹⁴ EX2016 at ¶¶57-62.

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.⁹⁵ Grafting Himmel's network retrieval onto Rossmann would push network access earlier in the flow, contrary to the '058 architecture that defers network access until after a local preliminary search.⁹⁶ This change undermines Rossmann's principle of operation and is not suggested by either reference.⁹⁷ 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.⁹⁸ Neither Rossmann nor Himmel provides guidance for creating and maintaining such a preloaded tree on such a device.⁹⁹ Himmel also contemplates that its bookmarking technology would be implemented on traditional computing systems, not the mobile communications devices disclosed in Rossmann.¹⁰⁰

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

⁹⁵ EX2016 at ¶¶57-58.

⁹⁶ *Id.*

⁹⁷ *Id.*

⁹⁸ EX2016 at ¶¶57, 61; EX1004 at 2:8-34.

⁹⁹ EX2016 at ¶61.

¹⁰⁰ EX2016 at ¶61; EX1005 at 3:66-4:11.

Himmel concern different device form factors.¹⁰¹ 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.¹⁰² 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.¹⁰³

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 menu and icons within those pages that, when selected, send a direct request to the corresponding web server.

¹⁰¹ EX2016 at ¶61; *compare* EX1004 at 2:8-34 *with* EX1005 at 3:66-4:11.

¹⁰² EX2016 at ¶61.

¹⁰³ *Id.*

F. Claim 1(b) – at least one selection page being specifically designed for containing one or more icons for directly accessing a search engine on the Web

Neither Rossmann nor Rossmann-Himmel teach claim 1(b) because, as Petitioner admits, Rossmann does not teach a selection page including an icon “for directly accessing a search engine on the Web.”¹⁰⁴ Petitioner asserts that “it would have been obvious, based on Himmel’s disclosures, to download a ‘search engine’ icon along with the rest of the hot list icons for display on Rossmann’s mobile device.”¹⁰⁵ Himmel does not teach a “search engine” as a POSITA would understand it.¹⁰⁶ A POSITA would understand that a search engine permits a search on the Web, as the ’058 patent describes.¹⁰⁷ In contrast, a POSITA would understand that Himmel describes a functionality that operates within a single website.¹⁰⁸ Furthermore, even if Himmel did teach a “search engine,” there would be no motivation to combine Rossmann and Himmel to add it for the reasons discussed above.

¹⁰⁴ Paper 1 at 30.

¹⁰⁵ *Id.*

¹⁰⁶ EX2016 at ¶39.

¹⁰⁷ EX1001 at 5:1-4; EX2016 at ¶39.

¹⁰⁸ EX1005 at 18:66-19:1; EX2016 at ¶39.

G. Claim 1(c) – wherein the control and processing device or devices are programmed for: enabling a preliminary search locally performed within said communication device in different themes and sub themes within said plurality of selection pages

Rossmann does not disclose claim 1(c) 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.¹⁰⁹ 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.”¹¹⁰ If the request is met by one of the cards in the deck, then that card is accessed without any communication with the server.¹¹¹ If not, “a connection initiated by the client module 146 to the server device 144 is made to fetch the new deck.”¹¹² The Petition states that Rossmann teaches an application of the latter scenario “where a user interested in the weather searches and navigates through locally stored decks and cards to ultimately display the weather in

¹⁰⁹ Paper 1 at 16.

¹¹⁰ *Id.* at 17 (quoting Rossmann at 8:49-55).

¹¹¹ *Id.* (citing Rossmann at 8:49-55).

¹¹² *Id.* (quoting Rossmann at 8:55-64).

Town A for information within the mobile device,”¹¹³ *i.e.*, the search is performed after fetching a new deck. A search for information within the mobile device after fetching a new deck also is not a search of pre-stored 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 ’058 patent because they do not concern preliminary searches of pre-stored information.¹¹⁴ In this regard, the Petition’s reliance on the passages at 2:27-36 and 2:64-3:4 of the ’058 patent is misplaced and taken out of context. Although these passages describe 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.¹¹⁵ 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 ’058 patent’s locally performed preliminary search of pre-stored selection pages.¹¹⁶ As such, Rossmann’s search does not serve

¹¹³ *Id.* at 17.

¹¹⁴ EX2016 at ¶¶37, 63, 68, 76.

¹¹⁵ EX1001 at 2:58-64, 4:65-67.

¹¹⁶ EX2016 at ¶¶37, 63, 68, 76; EX1004 at 6:20–29; 8:48–60.

the same goal as the preliminary search in the '058 patent. Rossmann's alleged preliminary search is network-dependent whereas the '058 patent's preliminary search is not.¹¹⁷

H. Claim 1(c)(1) – emitting on the communication network, in response to 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 direct access icon

Rossmann-Himmel does not teach “selection pages” or “direct access icons” for the same reasons discussed in connection with claim 1(a)(1) and claim 1(a)(3) above.

I. Claim 1(c)(2) – said address being locally generated during the preliminary search and selection

Rossmann-Himmel does not disclose claim 1(c)(2) because, as Petitioner admits, Rossmann does not disclose “said address being locally generated.” 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. 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.

¹¹⁷ EX2016 at ¶¶37, 63, 68, 76.

Using the '058 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.¹¹⁸ Impermissible hindsight must be avoided, and the Board must be cautious of arguments that rely on such *ex post* reasoning.¹¹⁹

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 '058 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 '058 patent and seeks to find them in the alleged prior art.¹²⁰ Because this combination only makes sense in hindsight, it does not render the Challenged Claims obvious.

¹¹⁸ See *KSR*, 550 U.S. at 421.

¹¹⁹ See *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1361 (Fed. Cir. 2016).

¹²⁰ EX2016 at ¶¶63-67.

J. Claim 2 – The apparatus according to claim 1, characterized in that the direct access icons comprise icons for accessing commercial sites.

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.

Specifically, Rossmann-Himmel-King 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(c)(2) 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.¹²¹ 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

¹²¹ Paper 1 at 48-49.

identified, predictable solutions, with a reasonable expectation of success.¹²² A POSITA further would not have been motivated to implement Rossmann's invention in the vendor kiosk environment described in Himmel.¹²³ As noted above, Rossmann and Himmel concern different device form factors. A POSITA would not have understood that 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.¹²⁴ Moreover, implementing Rossmann's invention in Himmel's kiosk environment does not teach the claimed invention, which is directed to mobile communication devices.¹²⁵

K. Claim 4 – The apparatus 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, including beforehand locally stored selection pages with direct access icons, for the reasons set forth in claim 1(a)(3) above. Because claim

¹²² See *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1359 (Fed. Cir. 2007).

¹²³ *Contra* Paper 1 at 49.

¹²⁴ See, e.g., EX1004 at 1:18-23.

¹²⁵ EX1001 at 5:27-33, 6:8-9, 7:35-36, 7:42-43, 8:24-25.

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.

Furthermore, a POSITA would not have been motivated to combine Rossmann and Himmel for the reasons set forth in claim 1(a)(3) above and would not have been motivated to combine Rossmann-Himmel and King for the reasons set forth in claim 1(c)(2) above.

L. Claim 5 – The apparatus according to claim 1, 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-King does not disclose all of the limitations of claim 1, including beforehand locally stored selection pages with direct access icons, for the reasons set forth in claim 1(a)(3) above. Because claim 5 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 5 and thus does not render claim 5 obvious.

Furthermore, a POSITA would not have been motivated to combine Rossmann and Himmel for the reasons set forth in claim 1(a)(3) above and would not have been motivated to combine Rossmann-Himmel and King for the reasons set forth in claim 1(c)(2) above.

M. Claim 6 – The apparatus according to claim 1, wherein at least one of the selection pages is specifically designed to include both at least one direct access icon and at least one selection icon.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1, including beforehand locally stored selection pages with direct access icons, for the reasons set forth in claim 1(a)(3) above. 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.

Furthermore, a POSITA would not have been motivated to combine Rossmann and Himmel for the reasons set forth in claim 1(a)(3) above and would not have been motivated to combine Rossmann-Himmel and King for the reasons set forth in claim 1(c)(2) above.

N. Claim 10 – The apparatus according to claim 1, wherein the second selection page displays information corresponding to a sub-category of the first selection page.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1, including beforehand locally stored selection pages, for the reasons set forth in claim 1(a)(3) above. 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.

Furthermore, a POSITA would not have been motivated to combine Rossmann and Himmel for the reasons set forth in claim 1(a)(3) above and would

not have been motivated to combine Rossmann-Himmel and King for the reasons set forth in claim 1(c)(2) above.

O. Claim 11 – The apparatus according to claim 1, wherein said control and processing device or devices are configured to receive information from the information- or service-providing Web site corresponding to said selected direct access icon via the communication network.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1, including beforehand locally stored selection pages with direct access icons, for the reasons set forth in claim 1(a)(3) above. Because claim 11 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 11 and thus does not render claim 11 obvious.

Furthermore, a POSITA would not have been motivated to combine Rossmann and Himmel for the reasons set forth in claim 1(a)(3) above and would not have been motivated to combine Rossmann-Himmel and King for the reasons set forth in claim 1(c)(2) above.

P. Claim 12 – The apparatus according to claim 1, wherein the selection icons present graphic features that are distinctive from those of the direct access icons.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1, including beforehand locally stored selection pages with direct access icons, for the reasons set forth in claim 1(a)(3) above. Because claim

12 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 12 and thus does not render claim 12 obvious.

Furthermore, a POSITA would not have been motivated to combine Rossmann and Himmel for the reasons set forth in claim 1(a)(3) above and would not have been motivated to combine Rossmann-Himmel and King for the reasons set forth in claim 1(c)(2) above.

Q. Claim 13 – The apparatus according to claim 1, wherein selection of a direct access icon in a selection page being displayed comprises clicking on said icon.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1, including beforehand locally stored selection pages with direct access icons, for the reasons set forth in claim 1(a)(3) above. Because claim 13 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 13 and thus does not render claim 13 obvious.

Furthermore, a POSITA would not have been motivated to combine Rossmann and Himmel for the reasons set forth in claim 1(a)(3) above and would not have been motivated to combine Rossmann-Himmel and King for the reasons set forth in claim 1(c)(2) above.

R. Claim 14 – The apparatus according to claim 1, wherein said selection pages stored in said data storage device or devices are downloaded thereto.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1, including beforehand locally stored selection pages, for the reasons set forth in claim 1(a)(3) above. Because claim 14 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 14 and thus does not render claim 14 obvious.

Furthermore, a POSITA would not have been motivated to combine Rossmann and Himmel for the reasons set forth in claim 1(a)(3) above and would not have been motivated to combine Rossmann-Himmel and King for the reasons set forth in claim 1(c)(2) above.

S. Claim 15 – The apparatus according to claim 1, wherein said selection pages stored in said data storage device or devices are downloaded thereto over a mobile connection.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1, including beforehand locally stored selection pages, for the reasons set forth in claim 1(a)(3) above. Because claim 15 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 15 and thus does not render claim 15 obvious.

Furthermore, a POSITA would not have been motivated to combine Rossmann and Himmel for the reasons set forth in claim 1(a)(3) above and would

not have been motivated to combine Rossmann-Himmel and King for the reasons set forth in claim 1(c)(2) above.

T. Claim 16 – The apparatus according to claim 1, wherein said selection pages operate as rolling menus.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1, including beforehand locally stored selection pages, for the reasons set forth in claim 1(a)(3) above. Because claim 16 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 16 and thus does not render claim 16 obvious.

Furthermore, a POSITA would not have been motivated to combine Rossmann and Himmel for the reasons set forth in claim 1(a)(3) above and would not have been motivated to combine Rossmann-Himmel and King for the reasons set forth in claim 1(c)(2) above.

U. Claim 17 – The apparatus according to claim 1, wherein at least one of the selection pages is a trunk of the tree menu structure.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1, including beforehand locally stored selection pages, for the reasons set forth in claim 1(a)(3) above. Because claim 17 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 17 and thus does not render claim 17 obvious.

Furthermore, a POSITA would not have been motivated to combine Rossmann and Himmel for the reasons set forth in claim 1(a)(3) above and would not have been motivated to combine Rossmann-Himmel and King for the reasons set forth in claim 1(c)(2) above.

V. Claim 18 – The apparatus according to claim 1, wherein the control and processing device or devices are configured to command a request-answer sequence characterized in that the request comprises the address of the information- or service-providing Web site, and wherein the request-answer sequence is preceded by a locally implemented selection of themes and sub-themes.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1, including beforehand locally stored selection pages with direct access icons, for the reasons set forth in claim 1(a)(3) above. Because claim 18 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 18 and thus does not render claim 18 obvious.

Furthermore, a POSITA would not have been motivated to combine Rossmann and Himmel for the reasons set forth in claim 1(a)(3) above and would not have been motivated to combine Rossmann-Himmel and King for the reasons set forth in claim 1(c)(2) above.

W. Claim 19 – The apparatus according to claim 1, wherein the icons comprise logotypes, graphic marks or semi-graphic marks.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1, including beforehand locally stored selection pages with direct access icons, for the reasons set forth in claim 1(a)(3) above. Because claim 19 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 19 and thus does not render claim 19 obvious.

Furthermore, a POSITA would not have been motivated to combine Rossmann and Himmel for the reasons set forth in claim 1(a)(3) above and would not have been motivated to combine Rossmann-Himmel and King for the reasons set forth in claim 1(c)(2) above.

X. Claim 20 – The apparatus according to claim 1, wherein the icons comprise textual elements.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1, including beforehand locally stored selection pages with direct access icons, for the reasons set forth in claim 1(a)(3) above. Because claim 20 incorporates all of the limitations of claim 1, Rossmann-Himmel-King does not disclose all of the limitations of claim 20 and thus does not render claim 20 obvious.

Furthermore, a POSITA would not have been motivated to combine Rossmann and Himmel for the reasons set forth in claim 1(a)(3) above and would not have been motivated to combine Rossmann-Himmel and King for the reasons set forth in claim 1(c)(2) above.

Y. Claim 21(Pre) – A communication device connectable to remote sources of information or services through a communication network, the communication device comprising a display, data storage, a processor, a controller and a plurality of pages locally stored in said data storage and displayable on said display

The requirement of “a plurality of pages locally stored in said data storage” in claim 21(Pre) is not taught by Rossmann-Himmel-King for the reasons discussed above in connection with claim 24(a).

Z. Claim 21(a) – wherein a first one of said locally stored pages is specifically designed to include at least one selection icon capable of being selectively activated to display a second one of said locally stored pages on said display

The requirement of “locally stored pages” in claim 21(a) is not taught by Rossmann-Himmel-King for the reasons discussed above in connection with claim 24(a).

AA. Claim 21(b) – wherein said second one of said locally stored pages is specifically designed to include at least one direct access icon capable of being selectively activated to connect said communication device to a predetermined one of said remote sources of information or services, and at least one second selection icon capable of being selectively activated to display a third one of said locally stored pages on said display

The requirement of “locally stored pages” in claim 21(b) is not taught by Rossmann-Himmel-King for the reasons discussed above in connection with claim 24(a).

BB. Claim 21(c) – wherein at least one of said first, second and third locally stored pages is further specifically designed to include at least one icon for directly accessing a search engine for permitting a user to control searches on the Web

The requirement of an “icon for directly accessing a search engine for permitting a user to control searches on the Web” in claim 21(c) is not taught by Rossmann-Himmel-King for the reasons discussed above in connection with claim 1(b).

CC. Claim 21(d) – wherein at least one of said first, second and third locally stored pages is further specifically designed to include at least one icon for directly accessing a portal of Web site and one icon for directly accessing a document provided by said Web site

Rossmann-Himmel-King does not teach “directly accessing a document provided by said Web site.” The ’058 patent distinguishes between a site’s HTML pages and “documents.” For example, the specification states that “[i]n response to such a request, the requesting station can receive either directly a document, *or usually* a new HTML page containing itself a more and less high number of links

among which the user will still have to make a new choice.”¹²⁶ This distinction is also made in reference to Fig. 2, which the specification describes as containing “an icon AD12 ‘1st division games’ for directly accessing *a document* presenting the next matches of the 1st division of soccer and provided by the official site of the soccer federation”¹²⁷ Fig. 2 itself shows a leader from reference number AD12 to a box labeled “Document.”¹²⁸

Petitioner argues that Himmel’s hotlinks cause “redirection to another *web document*.”¹²⁹ Petitioner further argues, however, that Himmel’s “‘Purchase’ icon directly accesses a document provided by the Sears website, *such as the Purchase webpage*.”¹³⁰ A POSITA would understand that the “web document” referred to in Himmel is a webpage, *i.e.*, an HTML page.¹³¹ As noted above, the ’058 patent distinguishes HTML pages from documents. Thus, Himmel does not teach the claimed “directly accessing a document.”¹³²

¹²⁶ EX1001 at 1:30-34 (emphasis added).

¹²⁷ *Id.* at 4:21-23 (emphasis added).

¹²⁸ *Id.* at Fig. 2.

¹²⁹ Petition at 61.

¹³⁰ Petition at 61.

¹³¹ EX2016 at ¶40.

¹³² *Id.*

DD. Claim 22 – The communication device according to claim 21, characterized in that said selection pages are locally stored in the data storage beforehand.

The recited selection pages are among the selection pages that must be "beforehand locally stored." For the reasons set forth in claim 1(Pre) above, Rossmann does not teach selection pages that are "beforehand locally stored," and thus does not teach the limitations of claim 22.

EE. Claim 27(a) –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

Rossmann-Himmel-King does not disclose a “preliminary search” for the reasons set forth in claim 1(c) above.

FF. Claim 27(a)(1) – said selection pages being organized in a tree menu structure and beforehand locally stored within said communication device, each said selection page being specifically designed to include a set of icons

Rossmann-Himmel-King does not disclose “selection pages being organized in a tree menu structure and beforehand locally stored within said communication device,” for the same reasons Rossmann does not disclose selection pages that are “beforehand locally stored” for the reasons set forth in claim 1(Pre) above.

GG. Claim 27(a)(2) – said selection pages further comprising a first selection page, a second selection page, and a third selection page

The recited first, second, and third selection pages are among the selection pages recited in claim 27(a)(1). The claimed selection pages must be “beforehand

locally stored.” For the reasons set forth in claim 1(Pre) above, Rossmann does not teach selection pages that are “beforehand locally stored,” and thus does not teach the limitations of claim 27(a)(2).

HH. Claim 27(a)(3) – said first selection page being specifically designed to include a selection icon for locally accessing said second selection page

The recited first selection page is one of the selection pages recited in claim 27(a)(1). The claimed selection pages must be “beforehand locally stored.” For the reasons set forth in claim 1(Pre) above, Rossmann does not teach selection pages that are “beforehand locally stored,” and thus does not teach the limitations of claim 27(a)(3).

II. Claim 27(a)(4) – and said second selection page being specifically designed to include a selection icon for locally accessing said third selection page

The recited second selection page is one of the selection pages recited in claim 27(a)(1). The claimed selection pages must be “beforehand locally stored.” For the reasons set forth in claim 1(Pre) above, Rossmann does not teach selection pages that are “beforehand locally stored,” and thus does not teach the limitations of claim 27(a)(4).

JJ. Claim 27(a)(5) – said third selection page being specifically designed to include one or more direct access icons for directly accessing an information- or service-providing Web site

The recited third selection page is one of the selection pages recited in claim 27(a)(1). The claimed selection pages must be “beforehand locally stored.” For the reasons set forth in claim 1(Pre) above, Rossmann does not teach selection pages that are “beforehand locally stored,” and thus does not teach the limitations of claim 27(a)(5). Furthermore, for the reasons set forth in claim 1(a)(3) above, Rossmann does not teach the limitations of claim 27(a)(5) because Rossmann does not teach a selection page comprising both selection icons and “direct access icons.”

KK. Claim 27(b) – 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 disclose “selection pages” or “direct access icons” for the same reasons discussed in connection with claim 1(a)(1) and claim 1(a)(3) above.

LL. Claim 27(b)(1) – said address being locally generated during said displaying and selection and for directly accessing said information- or service-providing Web site

Rossmann-Himmel-King does not teach locally generated addresses for the same reasons discussed in connection with claim 1(c)(2) above.

MM. Claim 27(c) – wherein: at least one of said selection pages further being specifically designed to include one or more icons for directly accessing a search engine on the Web

Rossmann-Himmel-King does not teach “icons for directly accessing a search engine on the Web” for the same reasons discussed in connection with claim 1(b) above.

VII. GROUND 3: CLAIMS 1, 2, 4-6, 10-23, 25, 27 ARE OBVIOUS OVER ROSSMANN, HIMMEL, KING, AND ADAR

A. A Search Menu Is Not a Search Engine

Petitioner states that it is advancing Ground 3 “should Patent Owner argue ... that Rossmann-Himmel’s ‘search’ icon to access a search menu within a webpage is not a conventional ‘search engine’ as that term is used in the ’058 Patent.”¹³³ Patent Owner does dispute that Rossmann-Himmel discloses the “search engine” limitation for the reasons discussed in connection with claim 1(b) above.

B. Claims 1, 2, 4-6, 10-23, 25, 27

- 1. Claim 1(b) – at least one selection page being specifically designed for containing one or more icons for directly accessing a search engine on the Web***

There is no motivation to combine Rossmann-Himmel or Rossmann-Himmel-King with Adar, for reasons similar to the lack of motivation to combine

¹³³ Petition at 65.

Rossmann and Himmel. Like the bookmarks in Himmel, Adar's bookmarks are tools of unconditional network access where a click always triggers a network request, with no local-first logic.¹³⁴ Integrating Adar's direct network bookmarks into Rossmann's architecture would require bypassing its local-check logic entirely.¹³⁵ A POSITA would need to create a new class of icons routed through an always-online pathway, fundamentally changing Rossmann's control flow.¹³⁶ This would be a substantial reconstruction and redesign, not a straightforward substitution.¹³⁷

The result would reintroduce the latency and network cost Rossmann was designed to avoid, confusing users with inconsistent response times and undermining its stated purpose of efficient navigation for resource-constrained devices.¹³⁸ Such a modification would render the system unsatisfactory for its intended purpose.¹³⁹ Thus, Petitioner and Bederson do not sufficiently show that a POSITA would be motivated to combine Rossmann-Himmel or Rossmann-Himmel-King and Adar.¹⁴⁰

¹³⁴ EX2016 at ¶45.

¹³⁵ *Id.*

¹³⁶ *Id.*

¹³⁷ *Id.*

¹³⁸ EX2016 at ¶72.

¹³⁹ *Id.*

¹⁴⁰ *Id.*

VIII. GROUND 4: CLAIMS 3, 7-9 ARE OBVIOUS OVER ROSSMANN, HIMMEL, KING, AND BOYLE OR ALTERNATIVELY, OVER ROSSMANN, HIMMEL, KING, ADAR, AND BOYLE

A. Claim 3 – The apparatus according to claim 1, 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 that new selection pages are stored in the data storage device or devices.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1 and there is no motivation to combine Rossmann-Himmel-King with Adar. 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.

Furthermore, Petitioner admits that neither Rossmann-Himmel-King nor Rossmann-Himmel-King-Adar teach a process to update Rossmann's HDML decks when new web information is available.¹⁴¹ Petitioner proposes tacking on yet another reference, Boyle, to fill this deficiency.¹⁴²

However, this is no motivation to combine Boyle with the Rossmann-Himmel-King or Rossmann-Himmel-King-Adar combinations. Boyle's update notification system operates fundamentally differently from the claimed architecture. Boyle teaches a server-centric push-notification system where web

¹⁴¹ Petition at 69.

¹⁴² *Id.*

servers send notifications to mobile devices about updated content, allowing users to “make a decision to fetch the update.”¹⁴³ This describes an on-demand content refresh system for cached HDML decks, not the claimed architecture of updating “selection pages” that are “beforehand locally stored.”¹⁴⁴ Updating transient or server-generated pages is not equivalent to pre-authoring and storing pages designed to include both direct access and selection icons.¹⁴⁵

But not only would a POSITA not have been motivated to combine Boyle with the Rossmann-Himmel-King or Rossmann-Himmel-King-Adar for the reasons stated above, a POSITA would not have been motivated to modify the Rossmann-Himmel-King or Rossmann-Himmel-King-Adar systems with Boyle except in hindsight.

Using the '058 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.¹⁴⁶ Impermissible hindsight must be avoided and the Board must be cautious of arguments that rely on such *ex post* reasoning.¹⁴⁷

¹⁴³ EX1007 at 5:31-36, 7:12-29; EX2016 at ¶42.

¹⁴⁴ EX2016 at ¶43.

¹⁴⁵ EX2016 at ¶80-83.

¹⁴⁶ See *KSR*, 550 U.S. at 421.

¹⁴⁷ See *Arendi*, 832 F.3d at 1361.

Petitioner violates these principles by alleging that Boyle identifies a need to inform users of updates.¹⁴⁸ However, Petitioner identifies no statement in Rossmann that there is a need to update its HDML decks. The only context in which the word “updated” is used in Rossmann is to refer to a server being updated.¹⁴⁹ A POSITA would understand that updating Rossmann’s deck is not critical because Rossmann’s decks are transient server-authored content intended only for temporary storage.¹⁵⁰ Thus, because the updates are maintained server side, the updates would be delivered the next time an HDML deck is requested and there is no need for Boyle’s push notifications. The need for updating selection pages only becomes apparent based on facts gleaned from the ’058 patent and its disclosed architecture, not the alleged prior art. A POSITA would only be led to the flawed combination of Rossmann-Himmel-King-Boyle or Rossmann-Himmel-King-Adar-Boyle if a POSITA starts with the claimed elements of the ’058 patent and seeks to find them in the alleged prior art. Because this combination only makes sense in hindsight, it does not render the Challenged Claims obvious.

Further, the addition of Boyle's update/notification mechanisms does not supply the missing limitations from Ground 2. Updating local content presupposes

¹⁴⁸ Petition at 71.

¹⁴⁹ EX1004 at 11:39-41.

¹⁵⁰ EX2016 at ¶80-83.

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 "tree menu," nor qualifying "direct access icons," nor "locally generated" addresses. Without that baseline, Boyle's updates cannot remedy the deficiencies.

B. Claim 7 - The apparatus according to claim 1, wherein said control and processing device or devices are configured to receive, from a server, data for updating information associated with at least one of a selection page, a direct access icon and a selection icon.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1 and there is no motivation to combine Rossmann-Himmel-King with Adar. Because claim 7 incorporates all of the limitations of claim 1, neither Rossmann-Himmel-King nor Rossmann-Himmel-King-Adar discloses all of the limitations of claim 7 and thus does not render claim 7 obvious.

Furthermore, incorporating Boyle to gap fill Rossmann-Himmel-King and Rossmann-Himmel-King-Adar's failure to disclose updating direct access icons and selection icons is improper for the reasons discussed above in connection with claim 3.

C. Claim 8 - The apparatus according to claim 7, wherein said updating information is received periodically.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1 and there is no motivation to combine Rossmann-Himmel-King with Adar. Because claim 8 incorporates all of the limitations of claims 1

and 7, neither Rossmann-Himmel-King nor Rossmann-Himmel-King-Adar discloses all of the limitations of claim 8 and thus does not render claim 8 obvious.

Furthermore, incorporating Boyle to gap fill Rossmann-Himmel-King and Rossmann-Himmel-King-Adar's failure to disclose updating direct access icons and selection icons periodically is improper for the reasons discussed above in connection with claim 3.

D. Claim 9 - The apparatus according to claim 8, wherein said updating information is received on demand.

As noted above, Rossmann-Himmel-King does not disclose all of the limitations of claim 1 and there is no motivation to combine Rossmann-Himmel-King with Adar. Because claim 9 incorporates all of the limitations of claims 1, 7, and 8, neither Rossmann-Himmel-King nor Rossmann-Himmel-King-Adar discloses all of the limitations of claim 9 and thus does not render claim 9 obvious.

Furthermore, incorporating Boyle to gap fill Rossmann-Himmel-King and Rossmann-Himmel-King-Adar's failure to disclose receiving updating information on demand is improper for the reasons discussed above in connection with claim 3.

IX. 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-IX of this **PATENT OWNER'S PRELIMINARY RESPONSE** have a total of 11,420 words according to the word count tool in Microsoft Word™.

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Date: August 22, 2025

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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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