

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

FERID ALLANI,
Patent Owner.

IPR2025-00857
Patent 10,943,058 B2

Before JAMESON LEE, JEFFREY S. SMITH, and BRIAN P. MURPHY,
Administrative Patent Judges.

SMITH, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Petitioner filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–27 of U.S. Patent No. 10,943,058 B2 (Ex. 1001, “the ’058 patent”) pursuant to 35 U.S.C. § 311(a). Patent Owner filed a Preliminary Response (Paper 9, “Prelim. Resp.”) pursuant to 35 U.S.C. § 313. Patent Owner’s request for discretionary denial was denied and the Petition was referred to the Board. Paper 11. Pursuant to an Order from the Board, the parties proposed constructions of certain claim terms. Papers 12–14.

Institution of an *inter partes* review may not be authorized by statute “unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Upon consideration of the record before us, we determine Petitioner has demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of at least one of claims 1–27 of the ’058 patent. Accordingly, we institute the requested *inter partes* review.

A. *Real Parties-in-Interest*

Petitioner identifies itself as the real party-in-interest. Pet. 77. Patent Owner identifies itself as the real party-in-interest. Paper 3, 2.

B. *Related Matters*

The parties state that the ’058 patent is currently asserted in *Allani v. Apple Inc.*, No. 6:24-cv-00304 (W.D. Tex.) and *Allani v. Google LLC*, No. 6:24-cv-00305 (W.D. Tex.). Pet. 77; Paper 4, 2.

C. The '058 Patent¹

The aim of the '058 patent is to provide a method for accessing information sources and services on the Web that is quicker and easier to use than current methods. Ex. 1001, 1:64–67. The '058 patent describes “one or more steps for displaying a page of selection among a plurality of selection pages organized within a structure of tree menu and beforehand locally stored within said communication device, each page of selection comprising a set of icons.” *Id.* at 2:7–11. The set of icons include a direct access icon, such as a hyperlink to a website, and a selection icon, such as a link to another beforehand locally stored selection page. *Id.* at 2:16–20, 2:34–35, 2:48–50, 3:13–33.

D. Illustrative Claims

Challenged claims 1 and 24 of the '058 patent are reproduced below along with Petitioner's labels for the limitations in brackets (Pet. 79–80, 82–83).

1. [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

¹ The '058 patent was filed on Sept. 9, 2014 and is a continuation of application No. 13/585,065 filed on Aug. 14, 2012, which is a division of application No. 10/169,355, filed as application No. PCT/FR00/03759 on Dec. 29, 2000. Ex. 1001, codes (22), (60).

information and a selection icon for locally accessing another selection page within said tree menu structure, wherein said plurality of selection pages includes:

- [1(a)] a first selection page, a second selection page and a third selection page,
- [1(a)(1)] said first selection page being specifically designed for containing a selection icon for locally accessing said second selection page,
- [1(a)(2)] said second selection page being specifically designed for containing a selection icon for locally accessing said third selection page,
- [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, and
- [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,
- [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, and
- [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,
- [1(c)(2)] said address being locally generated during the preliminary search and selection,
- [1(d)] wherein the apparatus is implemented in a mobile phone.

Ex. 1001, 5:36–6:9.

- 24. [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,

[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,

[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,

[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,

[24(c)] wherein the mobile communication device is a mobile phone.

Ex. 1001, 7:42–8:14.

E. Asserted Grounds

Petitioner asserts that claims 1–27 of the '058 patent are unpatentable on the following grounds (Pet. 4):

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	24–26	103(a)	Rossmann, ² Himmel ³
2	1, 2, 4–6, 10–23, 27	103(a)	Rossmann, Himmel, King ⁴
3	1, 2, 4–6, 10–23, 25, 27	103(a)	Rossmann, Himmel, King, Adar ⁵
4	3, 7–9	103(a)	Rossmann, Himmel, King, Adar, Boyle ⁶

II. ANALYSIS

A. Level of Ordinary Skill in the Art

Petitioner contends that:

A [person of ordinary skill in the art] at the time of the '058 Patent would have had bachelor's degree in computer engineering, electrical engineering, or a related field, with two to three years of experience with web-based information systems. Additional education or experience might substitute for the above requirements. *Dec.*, ¶¶37-39.

Pet. 3 (citing Ex. 1003 ¶¶ 37–39). Patent Owner contends that:

A [person of ordinary skill in the art] 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

² US Patent No. 6,119,155 issued Sept. 12, 2000 (Ex. 1004).

³ US Patent No. 6,037,934 issued Mar. 14, 2000 (Ex. 1005).

⁴ US Patent No. 6,353,839 B1 filed Apr. 30, 1998, issued Mar. 5, 2002 (Ex. 1006).

⁵ US Patent No. 6,493,702 B1 filed May 5, 1999, issued Dec. 10, 2002 (Ex. 1008).

⁶ US Patent No. 6,138,158 issued Oct. 24, 2000 (Ex. 1007).

similar field. Alternatively, someone with an advanced degree and less professional experience or less education and more professional experience would also qualify as a [person of ordinary skill in the art].

Prelim. Resp. 11. Given that Patent Owner’s definition of a person of ordinary skill substantially overlaps with Petitioner’s definition, and given that Patent Owner does not challenge Petitioner’s definition, we apply Petitioner’s definition for purposes of this Decision.

B. Claim Construction

The parties propose constructions of several claim terms. Pet. 4–8; Prelim. Resp. 11–14; Papers 13, 14. For purposes of this Decision, we determine that “beforehand locally stored” in independent claims 1 and 27 is the only term that needs to be construed in order to resolve a controversy between the parties.

Claim 1 recites “enabling a preliminary search locally performed . . . within said plurality of selection pages,” with “said selection pages being beforehand locally stored.” Claim 27 recites a method comprising “a preliminary search . . . locally performed . . . within a plurality of successively displayed selection pages,” with “said selection pages being . . . beforehand locally stored.”

Patent Owner contends that the plain meaning of the term “beforehand locally stored” requires that the claimed selection pages are pre-stored on the claimed communications device before the user conducts a preliminary search. Prelim. Resp. 13. Patent Owner contends that the Specification makes clear that the beforehand storing of the claimed selection pages is an implementation step not performed by the user. *Id.* (citing Ex. 1001, 4:65–67).

Petitioner contends that the Specification discloses a process for downloading, on demand, an updated set of pages, but does not limit the downloading to an automated action that excludes a user. Paper 13, 3. Petitioner also contends that claim 3 recites downloading data for updating selection pages. *Id.* at 3–4. Petitioner contends that the claim is agnostic as to whether the downloading is performed by the user or the device. *Id.* at 4. Finally, Petitioner contends that claim 9 recites receiving updated selection pages on demand. *Id.*

Patent Owner contends that the Specification’s disclosure of “on demand” downloading updated selection pages does not encompass a user downloading the updated selection pages. Paper 14, 1–2. Patent Owner contends that the structure of claims 1 and 27 require that a preliminary search is locally performed within a plurality of selection pages, which means that the selection pages must already be present, or “beforehand locally stored,” before the preliminary search is performed. *Id.* at 3.

We agree with Patent Owner that the plain meaning of “beforehand locally stored” requires the claimed selection pages to be present on the local device before a user conducts a preliminary search. Even if we were to agree with Petitioner that a user could download and store selection pages to the local device, such downloading and storing must occur before the user locally performs a preliminary search in order for the selection pages to be “beforehand locally stored” within the scope of claims 1 and 27.

We construe the terms “said selection pages being beforehand locally stored” recited in claim 1 and “said selection pages being . . . beforehand locally stored” recited in claim 27 as requiring the selection pages to be locally stored before a user locally performs a preliminary search.

C. Analysis of Ground 1

Petitioner contends that claims 24–26 would have been obvious over the combination of Rossmann and Himmel. Pet. 13–32. In doing so, Petitioner explains how the combination satisfies each claim limitation and provides supporting testimony from its expert, Professor Benjamin Bederson. *See id.*

Contentions for the Reason to Combine the Teachings of Rossmann and Himmel

Patent Owner contends that a person of ordinary skill in the art would not have been motivated to combine the teachings of Rossmann and Himmel. Prelim. Resp. 16. According to Patent Owner, using the bookmark of Himmel always results in accessing the network, which causes the latency that Rossman was trying to avoid. *Id.*

Petitioner contends that Rossmann’s cards include local hyperlinks to other stored cards as well as links to a server to download new decks. Pet. 21. Petitioner contends that Himmel’s bookmarks are hyperlinked URLs for directly accessing websites over the Internet. *Id.* Petitioner contends that a person of ordinary skill in the art would have included Himmel’s bookmarks that provide immediate access to a particular web function such as making a purchase in Rossmann’s hyperlinked cards for the benefit of reducing network traffic when accessing the particular web function. Pet. 23–25.

We agree with Petitioner. Rossman discloses times when accessing a web page over the network is unavoidable. Col. 8; *see* Pet. 21. Himmel teaches that using a bookmark to directly access a desired page is quicker than navigating through intermediate pages to get to the desired page. *See* Pet. 22–23, 25. Patent Owner does not address Rossman’s disclosure that a request to a network web page may be unavoidable, and does not address

Himmel's disclosure of making a direct request to the desired web page to save time and conserve network resources when accessing the desired web page. On this record, we agree with Petitioner that adding Himmel's bookmarks to Rossmann's cards provides the benefit of directly accessing a particular web function, thus reducing network traffic and data usage as compared to navigating multiple web pages to arrive at the particular web function.

Contentions for "Locally Stored Pages" in Claim 24

Patent Owner contends that Rossmann does not teach "locally stored pages" as recited in limitation 24(a). Prelim. Resp. 15. Patent Owner contends that the claimed "locally stored pages" read in light of the Specification means that the pages are stored in the device's non-volatile memory such as a hard disk or CD-ROM, not transient cached copies stored in RAM as taught by Rossmann. Prelim. Resp. 15 (citing Ex. 1001, 4:5–7).

We disagree. The claim does not limit the medium that locally stores the pages to non-volatile memory, and the Specification lists hard disk and CD-ROM as non-limiting examples. Thus, Patent Owner's contention that the pages must be stored in non-volatile memory is not commensurate with the scope of the claim. We are sufficiently persuaded that the decks of cards stored in the RAM of Rossmann teach "locally stored pages" as claimed. *See* Pet. 15–18.

We find that Petitioner has shown a reasonable likelihood that claim 24 would have been obvious over the combination of Rossmann and Himmel. Patent Owner does not challenge Petitioner's showing with respect to the additional limitations in dependent claim 26. We find that Petitioner

has shown a reasonable likelihood that claim 26 would have been obvious over the combination of Rossmann and Himmel.

Contentions for the “Search Engine” in Claim 25

For claim 25, Patent Owner contends that the combination does not teach a selection page including an icon “for directly accessing a search engine on the Web” as recited in claim 25. Prelim. Resp. 18–19. According to Patent Owner, Himmel describes a functionality that operates within a single website, not a search engine that permits a search on the Web as claimed. *Id.* at 19.

Petitioner contends that Himmel teaches common functions such as search. Pet. 30. Petitioner contends that a person of ordinary skill would have included Himmel’s search function for a particular website in Rossmann’s cards for the benefit of quickly navigating to specific information or products directly without sifting through multiple pages. *Id.* at 31.

We agree with Petitioner’s contentions that Himmel teaches common functions such as search, and that a person of ordinary skill would have included Himmel’s search function for a particular website for the benefit of quickly navigating the site without sifting through multiple pages. On this record, we are sufficiently persuaded that accessing a search function for searching within a single website as described by Himmel teaches “directly accessing a search engine on the Web” as claimed.

We find that Petitioner has shown a reasonable likelihood that claim 25 would have been obvious over the combination of Rossmann and Himmel.

D. Analysis of Grounds 2–4

For grounds 2–4, Petitioner contends that claims 1–23, 25, and 27 would have been obvious over several combinations of prior art, all of which include Rossmann and Himmel. Pet. 33–74. In doing so, Petitioner explains how the combinations satisfy the claim limitations, and provides supporting testimony from its expert, Professor Benjamin Bederson. *See id.*

Contentions for “Beforehand Locally Stored” in Claims 1 and 27

For independent claims 1 and 27, Patent Owner contends that Rossmann does not disclose selection pages that are “beforehand locally stored” as recited in the preamble of claim 1 and limitation 27(a)(1) of claim 27. Prelim. Resp. 20–21, 46. According to Patent Owner, the plain claim language that the selection pages are “beforehand locally stored” means that the selection pages are stored before any navigation begins during the locally performed preliminary search. *Id.* at 20–21. Patent Owner contends that Rossmann’s cards, in contrast to the selection pages of claims 1 and 27, are stored after a user initiates a search. *Id.*

Petitioner contends that even if “beforehand locally stored” requires downloading selection pages before the user begins a search, Rossmann’s Figures 4A–4G teach this. Paper 13, 4–5 (citing Pet. 18–21). According to Petitioner, a preliminary search for the weather begins after a user downloads an initial deck of cards shown in Figures 4A and 4B, selects “XYZ Information” as shown in Figure 4C, and downloads a new deck of cards which are shown in Figures 4D–4G. *Id.* at 5; *see* Pet. 18–21. Petitioner contends that the user performs the preliminary search using the cards shown in Figures 4D and 4E, which occurs after the cards were downloaded and locally cached in RAM. *Id.*

Patent Owner, in contrast, contends that the user begins the preliminary search when a user selects “XYZ Information” as shown in Figure 4C. According to Patent Owner, Rossmann’s teaching of downloading the new deck of cards shown in Figures 4D–4G occurs after the preliminary search has already begun and therefore does not teach selection pages that are “beforehand locally stored” as recited in claims 1 and 27.

We agree with Patent Owner that Rossmann does not teach selection pages that are “beforehand locally stored” for the reasons given by Patent Owner. In particular, we agree with Patent Owner, that the preliminary search begins when the user selects “XYZ Information” as shown in Figure 4C, which causes Rossmann’s system to download the deck of cards shown in 4D–4G during the preliminary search. Therefore, Rossmann does not teach “enabling a preliminary search locally performed . . . within said plurality of selection pages,” with “said selection pages being beforehand locally stored” as recited in claim 1, nor the similar limitation of claim 27. Petitioner does not rely on any other prior art in grounds 2–4 to teach “beforehand locally stored.”

Petitioner has not shown a reasonable likelihood that independent claims 1 and 27, as well claims 2–20, which depend from claim 1, would have been obvious over Petitioner’s combinations of prior art in grounds 2–4. Also, claim 22, which depends from claim 21, recites “said selection pages are locally stored in the data storage beforehand.” Therefore, Petitioner has not shown a reasonable likelihood that claim 22 would have been obvious over the prior art applied by Petitioner in grounds 2 and 3.

Contentions for “Locally Stored Pages” in Claim 21

For independent claim 21, Patent Owner contends that “locally stored pages” recited limitations 21(Pre), 21(a), and 21(b) are not taught by the combination of Rossmann, Himmel, and King for the reasons given in Patent Owner’s discussion of limitation 24(a). Prelim. Resp. 43–44. We disagree with Patent Owner for the reasons given in our discussion of limitation 24(a) in our analysis of ground 1.

Contentions for “Search Engine” in Claim 21

Patent Owner contends that the combination of Rossmann, Himmel, and King does not teach an “icon for directly accessing a search engine for permitting a user to control searches on the Web” recited in limitation 21(c) for the reasons given in Patent Owner’s analysis of limitation 1(b), which contains a similar limitation. Prelim. Resp. 44. In particular, Patent Owner contends that Himmel teaches a search engine that operates within a single website, but does not “control searches on the Web” as claimed. *Id.* at 28 (addressing limitation 1(b)). Petitioner contends that Himmel teaches common functions such as search, and that a person of ordinary skill would have included Himmel’s search function for a particular website for the benefit of quickly navigating the search menu without sifting through multiple pages. Pet. 60 (citing Pet. 30–31). On this record, we agree with Petitioner for the reasons given by Petitioner and the reasons discussed in our analysis of claim 25 above.

Contentions for “Directly Accessing a Document” in Claim 21

Limitation 21(d) recites, in relevant part, “one icon for directly accessing a portal of a Web site and one icon for directly accessing a document provided by said Web site.” Patent Owner contends that the

combination of Rossmann, Himmel, and King does not teach “directly accessing a document provided by said Web site” as claimed. Prelim. Resp. 44. In particular, Patent Owner contends that Himmel links to another webpage, not to a document. *Id.* at 45.

Petitioner contends that the scope of the claimed “portal of a Web site,” read in light of the Examiner’s explanation during prosecution, encompasses a website combining content from different sources on a single interface. Pet. 60–61 (citing Ex. 1002, 483). Petitioner contends that, consistent with the Examiner’s explanation, the Sears homepage shown in Figure 15 of Himmel, which combines content from different sources on a single interface, teaches the claimed “portal of a Web site.” *Id.* at 61.

Petitioner contends that Himmel teaches the claimed “directly accessing a document provided by said Web site” in describing the “Purchase” hotlink associated with the Sears website which links to a web document. Pet. 61. In particular, Petitioner contends that Himmel’s “Purchase” icon directly accesses a document provided by the Sears website, such as the Purchase webpage. *Id.* (quoting Ex. 1005, 19:27–30 (“redirection to another web document.”)).

We highlight that the Specification of the ’058 patent discloses “an icon . . . for directly accessing to a document presenting the next matches of the 1st division of soccer and provided by the official site of the soccer federation.” Ex. 1001, 4:20–23. Neither the Specification nor the claim, on this record, seems to limit the claimed “document” to exclude Himmel’s Purchase web document. We are persuaded, on this record, that Petitioner’s explanation that the Sears homepage shown in Figure 15 of Himmel teaches the claimed “portal of a Web site,” and that Himmel’s “Purchase” hotlink,

which redirects to the Purchase web document, teaches “one icon for directly accessing a document provided by said Web site” as claimed in limitation 21(d).

We find that Petitioner has shown a reasonable likelihood that claim 21 would have been obvious over the combination of prior art applied by Petitioner in grounds 2 and 3. Patent Owner does not challenge Petitioner’s showing with respect to the additional limitations in claim 23 which depends from claim 21. We find that Petitioner has shown a reasonable likelihood that claim 23 would have been obvious over the combination of prior art applied by Petitioner in grounds 2 and 3.

Contentions for “Search Engine” in Claim 25

Petitioner contends that Adar teaches this limitation in disclosing a bookmark to a search engine that can be sent to a user. Pet. 66. Petitioner contends that a person of ordinary skill in the art would have added the bookmark to a search engine taught by Adar to the bookmark manager of Himmel for the benefit of providing instant navigation to a search engine when a user wants to seek information not found in Rossmann’s deck of cards. *Id.* at 66–67. Patent Owner contends that there is no motivation to combine the teachings of Adar with those of Rossmann, Himmel, and King for reasons similar to those presented with respect to Patent Owner’s contentions regarding ground 1. Prelim. Resp. 49–50. We disagree with Patent Owner on this record for the reasons discussed in our analysis of ground 1 above. Further, since we are sufficiently persuaded that the combination of Rossmann and Himmel teaches an icon “for directly accessing a search engine” as discussed in our analysis of ground 1, we are sufficiently persuaded that the combination of Rossmann, Himmel, King,

and Adar teaches this limitation. We find that Petitioner has shown a reasonable likelihood that claim 25 would have been obvious over the combination of prior art applied by Petitioner in ground 3.

III. CONCLUSION

Based on the arguments presented in the Petition, we conclude that Petitioner has not demonstrated a reasonable likelihood of prevailing with respect to claims 1–20, 22, and 27 of the '058 patent challenged in the Petition. However, Petitioner has demonstrated a reasonable likelihood of prevailing with respect to claims 21 and 23–26 of the '058 patent challenged in the Petition. Accordingly, we institute a trial on all claims and all grounds asserted in the Petition. The Board has not made a final determination under 35 U.S.C. § 318(a) with respect to the patentability of the challenged claims.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–27 of the '058 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '058 patent shall commence on the entry date of this Decision, and notice is hereby given of the institution of a trial.

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