

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

FERID ALLANI,

Patent Owner.

Inter Partes Review Case No. IPR2025-00857

U.S. Patent No. 10,943,058 B2

PATENT OWNER'S RESPONSE

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I. The Board’s Institution Decision Confirms That Petitioner’s Challenges to the Majority of the Patent’s Claims Lack Merit

In its Decision granting institution (Paper 15, “Inst. Dec.”), the Board resolved a central claim construction dispute in this case—the meaning of “beforehand locally stored”—squarely in Patent Owner’s favor. Inst. Dec. 8. This construction, the *only* claim term the Board found necessary to construe, *id.* at 7, dictated the outcome for the vast majority of the challenged claims. Applying its construction, the Board concluded that “[p]etitioner has not shown a reasonable likelihood that independent claims 1 and 27, as well [as] claims 2–20, which depend from claim 1, would have been obvious over Petitioner’s combinations of prior art in grounds 2–4.” *Id.* at 13. The Board further concluded that Petitioner had not shown a reasonable likelihood of prevailing on dependent claim 22, which recites “said selection pages are locally stored in the data storage beforehand.” *Id.* In total, **Petitioner failed to meet even the lower “reasonable likelihood” threshold for twenty-three of the twenty-seven challenged claims**—claims 1–20, 22, and 27. *Id.* at 17.

The Board reached this result after full adversarial briefing, including supplemental claim construction submissions from both parties (Papers 12–14) and Petitioner’s Reply to Patent Owner’s Preliminary Response (Paper 13, “Pet. Prelim. Reply”). The Board considered each of Petitioner’s arguments and rejected them. Nothing in the trial record warrants departing from this well-reasoned construction. As demonstrated below, the plain claim language, the specification’s consistent disclosure, and the fundamental inventive concept of the ’058 patent all compel the Board’s construction.

A. The Board Correctly Construed “Beforehand Locally Stored” To Require Pre-Storage Before the Preliminary Search

The Board held that “beforehand locally stored” in claims 1 and 27 “requir[es] the selection pages to be locally stored before a user locally performs a preliminary search.” Inst. Dec. 8. This construction flows directly from the plain and ordinary meaning of the word “beforehand,” which means “in advance” or “ahead of time.” The temporal relationship embedded in the claim language is unambiguous: the selection pages must already be present on the local device *before* a user begins the locally performed preliminary search.

The claim structure reinforces this reading. Claim 1 recites “enabling a preliminary search locally performed . . . within said plurality of selection pages,” with those “selection pages being beforehand locally stored.” Ex. 1001, 5:40–44, 5:65–67. The word “beforehand” modifies “locally stored” and establishes a temporal prerequisite: the pages are stored *before* the activity they enable (the preliminary search) takes place. Claim 27 contains the same structure, reciting “a preliminary search . . . locally performed . . . within a plurality of successively displayed selection pages, said selection pages being organized in a tree menu structure and beforehand locally stored.” Ex. 1001, 8:27–34. In both claims, “beforehand locally stored” is a participial phrase describing the state of the selection pages at the time the preliminary search is performed—they must already be locally stored.

B. Petitioner’s Arguments Against the Board’s Construction Are Without Merit

In its Preliminary Reply, Petitioner advanced two alternative arguments against the Board’s construction. Paper 13 at 2–5. The Board rejected both, and rightly so.

1. The Construction Does Not Improperly Exclude User Involvement

Petitioner first argued that Patent Owner’s construction improperly “exclud[es] user involvement” in the downloading of selection pages and “finds no support in the intrinsic record.” Paper 13 at 2–3. Petitioner pointed to the specification’s disclosure of downloading updated pages “periodically or on demand” (Ex. 1001, 5:14–19), to dependent claim 3 (which recites receiving data for updating selection pages by downloading from a server), and to dependent claim 9 (which recites updating information received “on demand”). Paper 13 at 3–4.

This argument mischaracterizes the Board’s construction. The Board did not hold that a user can never be involved in downloading selection pages. It held that the selection pages must be “locally stored before a user locally performs a preliminary search.” Inst. Dec. 8. The construction addresses *when* storage must occur relative to the search, not *who* initiates the storage process. As the Board explained: “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.’” *Id.* (emphasis added). The Board thus expressly contemplated that a user *could* be involved in downloading—but the downloading must be completed before the preliminary search begins. Petitioner’s objection attacks a construction the Board did not adopt. To be clear, Patent Owner’s construction is fully consistent with a user downloading, configuring, or customizing the selection pages and icons on the device—for instance, by choosing which categories, sites, or icons to include—so long as that configuration is completed before the user subsequently performs the preliminary search through those pages. The temporal boundary the claims establish runs between the act of storing the pages

locally and the act of searching through them; the claims impose no limitation on who performs the storing or how it is initiated.

The specification’s “on demand” updating disclosure is entirely consistent with—not contrary to—the Board’s construction. The specification describes updating as a background maintenance function: “[I]t is easy to conceive a process for downloading, periodically or on demand, an updating of a set of pages used in the method according to the invention, from a management server towards a plurality of office automation and communication apparatuses.” Ex. 1001, 5:14–19. Whether updating occurs “periodically” (automatically) or “on demand” (when triggered), the updated pages must be downloaded and locally stored *before* a user can perform a preliminary search through them. Updating the stored pages and then searching through them are sequential operations. The specification’s updating disclosure therefore confirms rather than undermines the Board’s temporal construction.

Likewise, dependent claims 3 and 9 support the Board’s construction. Claim 3 recites receiving “data for updating selection pages” and processing that data “so that new selection pages are stored in the data storage device or devices.” Ex. 1001, 6:14–18. Claim 9 adds that the updating information is received “on demand.” *Id.* at 6:36–37. These claims describe a process of downloading and storing updated pages—a process that, under the Board’s construction, must be completed before the user performs a preliminary search. The claims say nothing about downloading pages *during* a search, and Petitioner points to no claim language that would support such an interpretation.

2. The Construction Is Not Based on Importing Embodiments into the Claims

Petitioner alternatively argued that Patent Owner “improperly reads in embodiments” from the specification. Paper 13 at 4 (citing *Samsung Elecs. Co. v.*

Power2B, Inc.). But the Board’s construction is not based on importing limitations from any particular embodiment. It is based on the *plain meaning of the claim language itself*. The word “beforehand” has a clear temporal meaning, and the Board simply gave effect to that meaning. As the Board stated, it was adopting the “plain meaning of ‘beforehand locally stored.’” Inst. Dec. 8. No resort to the specification was necessary to reach this result, though the specification confirms it at every turn.

Petitioner’s reliance on *Guardant Health, Inc. v. Vidal* (Paper 13 at 3) actually undercuts Petitioner’s position. *Guardant* holds that courts “[d]epart from the plain and ordinary meaning in only two instances: lexicography and disavowal.” 2023 WL 3262962, at *2. Here, the Board *applied* the plain and ordinary meaning—“beforehand” means “in advance.” It is Petitioner who seeks to depart from plain meaning by reading “beforehand” out of the claims, effectively construing “beforehand locally stored” to mean merely “locally stored”—rendering the word “beforehand” superfluous. Such a construction violates the canon against rendering claim terms meaningless. *See Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (“[C]laims are interpreted with an eye toward giving effect to all terms in the claim.”).

C. The Specification Uniformly Confirms the Board’s Construction

Although the Board’s construction rests on plain meaning, the entire disclosure of the ’058 patent confirms that the selection pages are designed to be pre-stored on the communication device, establishing the local data that enables the user’s subsequent preliminary search. Every relevant passage reinforces a two-phase architecture: first, the pages are stored locally; then, the user searches through them.

1. The Method Description Requires Pre-Stored Selection Pages

The Summary of the Invention describes the method as comprising “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.” Ex. 1001, 2:7–11 (emphasis added). The specification does not describe pages that *might* be locally stored at some point. The selection pages *are* “beforehand locally stored” as a precondition to the display and selection steps that follow.

The Detailed Description states that the tree structure of selection pages is “locally stored in a storage unit, for example a hard disk unit or a CD-ROM, of the apparatus wherein this method is implemented.” Ex. 1001, 4:4–7. While the Board correctly held that the claims do not limit the storage medium to non-volatile memory (Inst. Dec. 10), the specification’s choice of exemplary storage media is nevertheless revealing of the inventor’s conception: the selection pages are locally resident content available on the device in advance of the user’s preliminary search, not transient data fetched from a network on the fly during that search.

2. The Worked Example Confirms the Pre-Storage Requirement

The patent’s sole worked example is entirely consistent with the Board’s construction. A user navigates locally through a hierarchy of pre-stored selection pages—from an initial page P_0 containing theme icons, through a SPORT page P_i , through successive sub-theme pages, to a page P_{n-m} dedicated to the basketball championship—before *any* network communication occurs. Ex. 1001, 3:60–4:55. The specification describes this as “a single request-answer sequence, the whole operations for selecting themes and sub-themes having been *beforehand locally realized* by means of the method according to the invention.” *Id.* at 4:62–67 (emphasis added). The phrase “beforehand locally realized” directly mirrors the

claim term “beforehand locally stored,” confirming that all local operations—including the availability of the selection pages—are established in advance of the user’s search.

3. *The Multilingual Disclosure Further Confirms Pre-Storage*

The specification describes a multilingual feature in which “several sets of selection pages beforehand stored each corresponding to a proposed language will be provided.” Ex. 1001, 2:62–64. This discloses complete sets of pages stored on the device in advance, available for the user’s preliminary search. The user selects a language, and the corresponding pre-stored set becomes the basis for the preliminary search. *Id.* at 2:58–67. Notably, this disclosure is agnostic as to how or by whom the sets are loaded onto the device—whether by the manufacturer, a management server, or the user’s own configuration—so long as they are locally stored before the preliminary search begins.

D. Rossmann Does Not and Cannot Satisfy the “Beforehand Locally Stored” Requirement

Having established the correct construction, the Board correctly found that Rossmann’s (Ex. 1004) deck-of-cards system does not satisfy the “beforehand locally stored” limitation of claims 1 and 27. Inst. Dec. 13. Rossmann’s architecture is fundamentally server-driven. The mobile device receives HDML “decks”—groups of “cards” (screen displays)—from a server over the network, and stores them temporarily in cache RAM. Ex. 1004, 6:27–36. Critically, when a user’s request “can not be satisfied by one of the cards in the received deck,” a new network “connection initiated by the client module 146 to the server device 144 is made to fetch the new deck.” *Id.* at 8:55–59. Thus, each time the user navigates beyond the

cards in the current deck, Rossmann requires a network round-trip to obtain additional content.

1. The Board Correctly Determined When the Preliminary Search Begins in Rossmann

The dispute over Rossmann turns on a factual question: at what point in Rossmann’s Figure 4 sequence does the user’s “preliminary search” begin? Petitioner contended that the preliminary search begins only *after* the second deck of cards (Figures 4D–4G) has been downloaded, when the user begins navigating through those cards. Paper 13 at 5; Pet. 18–21. Patent Owner contended that the preliminary search begins when the user selects “XYZ Information” as shown in Figure 4C, because that selection is itself the user’s first navigational choice in a search for information. Inst. Dec. 12–13.

The Board agreed with Patent Owner. Inst. Dec. 13. This finding is correct. In the context of the ’058 patent, the “preliminary search” is the user’s process of navigating through selection pages by choosing themes and sub-themes. *See* Ex. 1001, 5:65–67 (claim 1: “enabling a preliminary search locally performed within said communication device in different themes and sub themes within said plurality of selection pages”). When a user in Rossmann selects “XYZ Information” in Figure 4C, the user is making a thematic selection—choosing a category of information to explore. That is the beginning of the preliminary search. Rossmann itself confirms that this selection triggers a network download: “[T]he resource locator for the selection is transmitted to the server device 144 by the client module in mobile device 142 over the data capable mobile telephone network 140. In response to the selection, the server device 144 processes the request containing the selection, and in this embodiment, transmits another card deck to the mobile device.” Ex. 1004, 10:51–61. Indeed, Rossmann explains that “[t]he client module 146 in the mobile

device 142 establishes a connection to the server that hosts the web site addressed by www.xyzinfo.com. The server sends a new deck to the phone.” *Id.* at 11:1–8. The cards in the new deck (Figures 4D–4G) thus arrive *during* the user’s search, not “beforehand.”

2. *Petitioner’s Characterization of Rossmann’s Architecture Highlights the Fundamental Mismatch*

Petitioner’s own description of Rossmann confirms the problem. Petitioner stated that “after selecting XYZ Information in Figure 4B, a new deck is downloaded with displays for www.xyzinfo.com (Figs. 4C–4G).” Paper 13 at 5. This is consistent with Rossmann’s disclosure. *See* Ex. 1004, 10:51–61; *id.* at 11:1–8. In other words, Petitioner concedes that the user’s navigational choice *triggers* a network download. This is precisely the architecture the ’058 patent was designed to avoid—where “a delay corresponds to each request-answer step, with a variable duration conditioned by non-controllable parameters like traffic on the network.” Ex. 1001, 1:34–38.

In Rossmann, the user’s navigation through decks of cards is interleaved with network downloads. Rossmann’s own description confirms this: after a communication session is established, “the phone 120 typically receives a single HDML deck from the server device and stores the deck as cached in RAM 134.” Ex. 1004, 6:27–30. The user may then navigate among the cards within that deck without further network communication. *Id.* at 8:50–55. But when the user’s selection points beyond the current deck—as occurs when the user selects “XYZ Information”—the system must fetch a new deck from the server. *Id.* at 8:55–59. As Rossmann explains, “the newly received deck is preferably stored in the cache memory, thus the subsequent navigation takes place within the deck.” *Id.* at 11:13–14. In other words, each level of the hierarchy may require a fresh network fetch. *All* network communication to the final step of accessing the targeted website, with all

intermediate navigation occurring locally through pre-stored pages. Ex. 1001, 2:25–30, 4:62–67. This is a fundamental architectural difference, not a matter of characterization.

3. Petitioner’s Fallback Argument—That Rossmann’s Pages Are “Beforehand” Stored Once Cached in RAM—Was Properly Rejected

Petitioner argued in the alternative that even under Patent Owner’s construction, Rossmann satisfies “beforehand locally stored” because the cards in the second deck (Figures 4D–4E) are “cached locally in RAM” before the user navigates through them. Paper 13 at 5. The Board rejected this argument. Inst. Dec. 13. Rossmann itself describes this caching as part of the network fetch: after the user selects “XYZ Information,” “[t]he server sends a new deck to the phone,” and “the newly received deck is preferably stored in the cache memory.” Ex. 1004, 11:5–14. The caching of the new deck is thus inseparable from—and consequent to—the user’s navigational selection that triggered the network fetch.

The Board’s rejection was correct. Petitioner’s fallback argument rests on an artificial slicing of the preliminary search—treating it as beginning only when the user navigates within the second deck, rather than when the user initiates the search by selecting a category in the first deck. But the claims do not support this parsing. The “preliminary search” is a unitary process of navigating through selection pages in different themes and sub-themes. See Ex. 1001, 5:65–67. The user’s selection of “XYZ Information” is part of that unitary search—it is the user choosing a theme. The cards that arrive after that selection, regardless of when they are cached in RAM, were not “beforehand locally stored” relative to the search as a whole.

Petitioner’s interpretation would also produce absurd results. Under Petitioner’s logic, *any* system that downloads a page from a network and stores it

locally—even momentarily in a cache—before displaying it to the user would satisfy “beforehand locally stored.” Every web browser necessarily caches pages in memory before rendering them on screen. If that were sufficient, the term “beforehand locally stored” would add nothing to the claims and would capture the very conventional web browsing the patent identifies as the *problem* to be solved. *See* Ex. 1001, 1:28–42. The Board should reject an interpretation that would render the “beforehand locally stored” limitation meaningless.

E. The Board Should Maintain Its Construction in the Final Written Decision

The Board’s construction of “beforehand locally stored” was reached after considering Petitioner’s full range of arguments—both the “no user exclusion” argument and the “cached in RAM” fallback. Paper 13 at 2–5. The Board had the benefit of adversarial briefing from both parties on the issue (Papers 12–14) and engaged substantively with each argument before ruling. Nothing in the trial record provides any basis for the Board to depart from its well-reasoned construction.

To summarize: the plain meaning of “beforehand” (meaning “in advance”); the claim structure requiring selection pages to be locally stored before the preliminary search; the specification’s consistent description of pre-stored pages as a precondition to the locally performed search; the inventive concept’s dependence on eliminating network latency during local navigation; the sole worked example; the updating disclosure; and the multilingual functionality all point in a single direction. “Beforehand locally stored” means what it says—the selection pages must be locally stored before the user’s preliminary search begins. This construction excludes Rossmann from satisfying the limitation, and Petitioner’s challenges to claims 1–20, 22, and 27 should accordingly fail.

II. The Plain and Ordinary Meaning of “Icon” Requires a Graphical or Symbolic Selectable Element

The Board did not construe the term “icon” in its Institution Decision. *See* Inst. Dec. 7–8. Petitioner argues—purportedly for “judicial efficiency”—that Patent Owner’s “plain and ordinary meaning” of “icon” “must at least include textual icons,” based on allegations in the WDTX complaint and Plaintiff’s preliminary infringement contentions. That argument should be rejected.

Claim construction in this IPR is governed by *Phillips*, not by early accused-product charts. And the very infringement contentions Petitioner relies on are expressly preliminary—“based on the information available” at the time—and do not offer a construction of the term “icon.” Additionally, Plaintiff “reserves the right to amend” consistent with the Court’s rules and orders. A party’s preliminary application of a term to accused UI elements cannot rewrite the patent’s intrinsic meaning, and it certainly cannot collapse the patent’s express “designation” versus “icon” distinction.

Nor do the PTAB “judicial efficiency” decisions cited in the Petition compel Petitioner’s requested “textual icons” floor. Those decisions, at most, reflect a discretionary practice of allowing a petitioner to proceed using the same construction the patent owner is actually relying upon in the related district-court litigation.

Here, Patent Owner’s claim-construction position in WDTX was that “icon” “does not require any further construction beyond the plain and ordinary meaning of the word as used in the claims,” Ex. 1040. Apple’s position in that litigation was the opposite direction—seeking to narrow “icon” to “a symbol that is a pictorial indication of a command.” Patent Owner disputed Apple’s construction only to the extent that it required an “indication of a command.” Patent Owner never disputed that an “icon” is “a symbol that is [] pictorial.”

Nothing in that record establishes, and Petitioner does not cite, any district-court construction holding that the “plain and ordinary meaning” of “icon” includes bare selectable text. The Board should therefore construe “icon” in the ordinary course under Phillips based on the intrinsic evidence, which confirms that an “icon” is a graphical or symbolic selectable element that may incorporate text as a component but is distinct from a mere textual “designation.”

Patent Owner submits that the proper construction of this term is independently dispositive of every ground in the Petition. Based on a thorough review of the intrinsic evidence—the claim language, the specification, the prosecution history, and the understanding of a person of ordinary skill in the art (“POSITA”) as of the October 12, 1999 priority date—*the plain and ordinary meaning of “icon” requires a graphical or symbolic selectable element—distinct from a mere textual designation.*

A. The Specification Establishes a Three-Way Distinction

The specification’s description of the prior art provides an express taxonomy of visual elements on a Web portal page. Column 1, lines 23–26 states: “The choices of a site or of a heading are represented either by a designation or by an icon or a fixed or animated image.” Ex. 1001, 1:23–26. This passage uses the disjunctive “either . . . or . . . or” structure to set up three categories of visual representation: (1) a “designation”—i.e., a textual label or name; (2) an “icon”—a stylized graphical or symbolic element; and (3) a “fixed or animated image”—i.e., a photographic or realistic pictorial representation.

Because the specification itself presents these as distinct alternatives, whatever an “icon” is, it cannot be a mere “designation” (a bare text label). A POSITA reading this passage as of October 1999 would understand “icon” to occupy the middle ground: a stylized graphical or symbolic representation—a pictogram,

glyph, logotype, or simplified graphic element—as distinct from plain text. This three-way taxonomy is consistent with how the computing arts understood these categories at the priority date, where “icons” referred to stylized symbolic graphics (such as desktop folder icons or application icons), distinct from text labels.

B. The Specification’s Examples Confirm the Graphical Nature of “Icon”

Throughout the specification, every concrete example of an “icon” involves a graphical or symbolic visual element. The specification repeatedly describes icons as reproducing “the logotype of this site” (col. 2, ll. 39–40) and refers to icons comprising “logotypes” of “commercial brands” and “merchant sites” (col. 3, ll. 63–65). It describes “icons of languages” represented as national flags (col. 2, ll. 60–61). It describes icons as including “graphic or semi-graphic marks” (col. 3, ll. 63–64)—terms that denote visually stylized elements. And it states that icons “can be fixed or dynamic” (col. 5, ll. 24–25), implying visual behavior rather than static text.

Even where the specification describes icons bearing functional labels such as “calendar” (AD11) or “1st division games” (AD12), these are described as icons with those labels—not as bare text strings. The specification further states that selection icons “preferably include” “an item or thematic title” (col. 2, ll. 41–42), reinforcing that any textual content is an optional component of the icon rather than the icon itself.

C. Icons Are Selectable Elements Associated with Active Zones

The specification confirms that icons are not passive display elements but selectable controls. Each icon is associated with an “active zone”—a selectable region on a selection page. The specification explains that “pointing and clicking by means of a mouse on the corresponding active zone” causes the system to respond

to the user’s selection (col. 1, ll. 26–29). The “active zone” disclosure confirms that the icon is understood as a discrete, bounded, interactive graphical control element—not merely a passage of text that happens to be clickable. Apple expert, Dr. Benjamin Bederson, confirmed in his deposition that it was common practice to implement icons with bounding boxes. Allani Ex. 2019, 65:4–66:23, 69:14–24.

D. The Dependent Claims Are Consistent with This Construction

Two dependent claims further define the composition of icons. Claim 19 recites that “the icons comprise logotypes, graphic marks or semi-graphic marks.” Claim 20 recites that “the icons comprise textual elements.” At first glance, Claim 20’s reference to “textual elements” might appear to suggest that bare text qualifies as an icon. This tension is resolved by the word “comprise.” In patent claim parlance, “comprises” is a term of art meaning “includes but is not limited to.” *CIAS, Inc. v. All. Gaming Corp.*, 504 F.3d 1356, 1360 (Fed. Cir. 2007). Claims 19 and 20 state what icons *comprise*—that is, what they include as constituent components—not that icons *are* those things. An icon may incorporate a text label as one component of a composite graphical element, just as Claim 19 says icons may incorporate logotypes and graphic marks.

E. The Specification’s Labeled-Icon Examples Do Not Support a Bare-Text Construction

In the Petition, Apple argues that the ’058 Patent’s references to icons bearing textual labels—such as “an icon AD11 ‘calendar,’” “an icon AD12 ‘1st division games,’” and “an icon ‘Return’” (col. 2, ll. 41–44; col. 4, ll. 9–27)—demonstrate that bare text qualifies as an “icon.” Pet. at 7. This argument fails for several independent reasons.

First, each of the cited passages uses a consistent grammatical structure: “an icon [reference designator] ‘[label].’” The noun is “icon”—a graphical element—and the quoted text is its *label*, not its identity. This is precisely how icons have always been referenced in the computing arts—one speaks of “the Trash icon” or “the Print icon” using a textual name to identify a graphical element, not to equate the name with the element.

Second, the passage at column 2, lines 41–44, states that “selection icons preferably include an item or thematic title opening an access to a page.” The operative verb is “include.” A selection icon includes a thematic title in one embodiment; it does not consist of one. Reading “thematic title” as the icon itself would violate the specification’s three-way distinction—a bare thematic title is precisely a “designation,” the first category in the disjunctive taxonomy.

Third, the same examples, icons AD11 and AD12, are illustrated in Figure 1 of the ‘058 patent with an oval around them, thereby indicating that they are graphical in nature and not just text. Ex. 1001, Fig. 1.

Fourth, if “icon” were construed to encompass bare selectable text, the specification’s opening taxonomy would be rendered incoherent. A clickable text string is precisely a “designation.” The two categories would overlap entirely, rendering the disjunctive “or” meaningless.

Apple also points to the related ’877 Patent’s Claim 6, which claims a “thematic title” icon. This does not help the bare-text construction. A “thematic title icon” is most naturally read as an icon associated with or bearing a thematic title—an icon whose label describes a theme or category (such as “Sport” or “Travel”). The thematic title identifies the icon’s function or destination; it does not define the icon’s form. Nothing in the related patent’s claim language requires that a thematic title displayed as bare text, without any graphical or symbolic element, constitutes an “icon.”

F. The Allani Declaration Confirms That Icons Are Graphical Button Elements

Apple further argues that during prosecution, the inventor filed a declaration (EX1002, pp. 466–479) describing “selectable icons for navigating to email, to a printer, to return to a summary page” with labels such as “Return to Summary” and “Next Page,” and that this demonstrates icons can be bare text. Pet. at 7. This argument affirmatively supports Patent Owner’s construction.

The very document Apple relies upon undermines its position. In the October 12, 1999 email attached to the declaration, the inventor described his invention as one in which “[t]he user makes his choices either by pressing a ‘Button’ icon in the case of a touch screen, or by tapping the keyboard.” EX1002, p. 474. The inventor’s own chosen term was “Button icon”—not “text label” or “designation.” A “button” in the GUI arts as of 1999–2000 was universally understood to be a graphical control element—a bounded, visually distinct, interactive region—not a bare text string.

Most critically, the screenshot (EX1002, p. 475) actually depicts the icons the inventor was describing. Every icon on the screen—without exception—is rendered as a graphical button element: a bordered, shaded, rectangular control with text incorporated as a label within the button. Not one element on this screen is bare text. The very “Return to Summary,” “Previous Page,” and “Next Page” elements Apple highlights are graphical buttons with text labels inside them. The screenshot provides direct visual confirmation that the inventor understood “icon” to mean a graphical control element incorporating text, not text standing alone.

Apple’s argument rests on a conflation: it quotes the text labels of the icons (“Return to Summary,” “Previous Page,” “Next Page”) and treats those labels as if they were the icons. But the declaration says there are “selectable icons for navigating to email, to a printer, to return to the summary page.” EX1002, p. 468,

¶12. The phrase “icons for navigating to” describes icons whose function is to navigate to those destinations. It does not describe icons consisting of the text of those destination names. When the actual depiction is consulted—as it must be, since the declaration expressly incorporates the screenshot—the icons are graphical buttons. Apple asks the Board to credit the text labels while ignoring the graphical depiction that is part of the same exhibit.

G. The Prosecution History Confirms That “Icon” Means a Graphical Element

The prosecution history of the ’058 Patent and its grandparent ’877 Patent provides further confirmation that the term “icon” was consistently understood—by the Examiner and the Applicant alike—to require a graphical element. Critically, this understanding was maintained under the PTO’s broadest reasonable interpretation (“BRI”) standard, which is broader than the *Phillips* standard applicable in this proceeding.

In the ’877 Patent prosecution, the Examiner’s first office action drew an express distinction between textual “links” and graphical “icons.” The Examiner acknowledged that Cole (US 5,933,827) taught “links on the selection pages” but found that Cole “does not explicitly teach each page of selection comprising a set of icons.” EX1033 at 128. To supply the missing limitation, the Examiner relied on Treyz (US 6,587,835), with the stated motivation “in order to graphically enhance the pages displayed to the user.” *Id.* (emphasis added). The Examiner thus concluded that textual links were not icons—something graphical was required.

This passage is dispositive. The Examiner, applying the broadest reasonable interpretation of the claims, concluded that textual “links” on Cole’s selection pages were not icons. Something more was required—something graphical. The Examiner needed a reference that supplied graphical elements on the selection pages, and she

found it in Treyz. Her rationale for the combination—“graphically enhance”—is effectively her gloss on what the “icon” limitation adds beyond what a bare textual link provides.

In subsequent office actions of the ’877 Patent, the Examiner consistently mapped the “icon” limitation to graphical disclosures in the prior art. When the Examiner applied Matthews (US 7,454,706) as the primary reference, she cited for icons accessing merchant sites and “col. 7, lines 57–59; symbols are logotypes” for the logotype icon limitation—each time pointing to figures and graphical depictions, not bare text descriptions. EX1033 at 251–252. Similarly, when the Examiner applied Iki (US 6,816,172), she cited Iki’s Figures 5 and 6—the graphical user interface screens—as the disclosure meeting the “icon” elements. EX1033 at 460–461.

In the ’058 Patent prosecution itself, the Examiner consistently characterized the prior art disclosure meeting the “icon” limitations as a “graphical image corresponding to identifiers to a remote web server.” EX1002 at 426. This formulation appears over two dozen times across the Examiner’s Answer and every subsequent office action through allowance.

This pattern persisted through the final office action of May 2019 (EX1002 at 535) and every subsequent office action. The Examiner never once identified a bare text string, a URL, or an unadorned text label in any prior art reference as satisfying the “icon” limitation. Every mapping, without exception, pointed to a graphical element. After the RCE and withdrawal of appeal, the Examiner introduced new prior art references but continued to apply the same graphical understanding, mapping “icon” limitations to “graphical image corresponding to identifiers to a remote web server” in the October 2018 non-final office action (EX1002 at 480–481) and the May 2019 final action (EX1002 at 535). The prosecution history as a

whole—spanning over a dozen office actions, an appeal, and an RCE—tells a single, consistent story: “icon” requires a graphical element.

If the Examiner did not treat bare text as falling within even the broadest reasonable interpretation of “icon,” it follows *a fortiori* that bare text does not satisfy the term under the narrower *Phillips* standard. See *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

H. The Applicant’s Walden Argument Was Not a Concession That Hyperlinks Are “Icons”

Dr. Bederson, argues that during prosecution of the ’877 Patent, the Applicant effectively conceded that bare hyperlinks qualify as “direct access icons” by distinguishing Walden (US 6,456,303) on the ground that it lacked “selection icons” rather than disputing the Examiner’s mapping of Walden’s hyperlinks to “direct access icons.” EX1003, ¶93 at 71. This argument fails for several reasons.

First, the passage is an *arguendo* argument, not a concession. The Applicant’s response took the classic “even if” form: even if Walden’s HTML pane contained what the Examiner characterized as direct access icons, the reference still failed because there were no “selection icons” on the same page. An *arguendo* assumption made for the purpose of showing a rejection fails on other grounds is not a “clear and unmistakable” disclaimer of claim scope. See *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1325–26 (Fed. Cir. 2003).

Second, the Examiner herself agreed that Walden failed to teach the claimed icons. As recorded in the interview summary, the Examiner concluded that “the reference to Walden does not render obvious provision of two or more direct access icons” and that “all rejections” based on Walden “would be withdrawn.” EX1033 at 360. The Examiner’s withdrawal is itself an acknowledgment that Walden’s hyperlinks did not satisfy the “icon” limitation.

Third, such an interpretation conflicts with Dr. Bederson’s own understanding of hyperlinks and icons, which he admitted during his deposition have “pretty big difference[s].” Ex. 2019, 83:16-84:9.

I. Every Contemporaneous Technical Dictionary Defines “Icon” To Require a Graphical or Pictorial Element

The extrinsic evidence overwhelmingly confirms that the plain and ordinary meaning of “icon” in the computing arts as of the ’058 patent’s October 12, 1999 priority date required a graphical, pictorial, or symbolic visual element—not mere text. Nine contemporaneous technical dictionaries spanning the period from 1997 to 2005—including every dictionary identified by both parties in their extrinsic evidence disclosures for this term in the district court litigation—uniformly define “icon” in terms that demand a visual or graphical component. Ex. 2018. Not one defines “icon” as a text string, a textual label, or a designation. The following chart summarizes the key definitional language from each source:

Source	Year	Ex. 2018 Cite	Key Definitional Language	Graphical / Pictorial Requirement
<i>Barron’s Dictionary of Computer and Internet Terms</i> (7th ed.)	2000	Page 004	“a small picture on a computer screen that represents a particular object, operation, or group of files”	“small picture”
<i>The Dictionary of Computing & Digital Media: Terms & Acronyms</i>	1999	Page 008	“Any graphic symbol that represents an object, function, or task”	“graphic symbol”

<i>IEEE Standard Dictionary of Electrical and Electronics Terms</i> (6th ed.)	1997	Page 014	“A symbol that is a pictorial indication of a command or object”	“pictorial indication”
<i>IEEE Standard Dictionary of Electrical and Electronics Terms</i> (7th ed.)	2000	Page 010	“A symbol that is a pictorial indication of a command or object”	“pictorial indication”
<i>Microsoft Computer Dictionary</i> (4th ed.)	1999	Page 019	“A small image displayed on the screen to represent an object that can be manipulated by the user”	“small image”
<i>Newton’s Telecom Dictionary</i> (15th ed.)	1999	Page 030	“A picture or symbol representing an object, task, command or choice”	“picture or symbol”
<i>Newton’s Telecom Dictionary</i> (21st ed.)	2005	Page 024	“A picture or symbol representing an object, task, command or choice”	“picture or symbol”
<i>Random House Webster’s Computer & Internet Dictionary</i> (3rd ed.)	1999	Page 035	“A small picture that represents an object or program”	“small picture”
<i>Webster’s New World Computer</i>	2003	Page 040	“[A]n onscreen symbol that represents a program, data file, or some other computer entity or function”	“onscreen symbol”

Dictionary (10th ed.)				
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The consistency across these nine independent sources is striking. Every definition uses explicitly visual or graphical language: “small picture,” “graphic symbol,” “pictorial indication,” “small image,” “picture or symbol,” or “onscreen symbol.” Not one source defines “icon” as a text string, a hyperlink, a textual label, or a word on a screen. This unanimity is dispositive. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005) (en banc) (technical dictionaries are among the “many tools” courts consult to determine the ordinary meaning of claim terms); *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584 n.6 (Fed. Cir. 1996) (technical dictionaries and treatises are “useful resources” for determining the meaning of claim terms to persons of ordinary skill in the art).

Several definitions are particularly instructive. The two IEEE dictionaries—the preeminent source of standardized terminology in the electrical and computer engineering fields—define “icon” as “a symbol that is a **pictorial indication** of a command or object.” Ex. 2018, Page010, Page014 (emphasis added). The word “pictorial” is unambiguous: it means “of or relating to a picture.” A numbered text entry in a list—such as “1. XYZ Information” in Rossmann’s Figure 4B—is not a “pictorial indication” of anything. Similarly, the *Microsoft Computer Dictionary* defines an icon as “a small **image** displayed on the screen,” Ex. 2018, Page019, and *Barron’s* and *Random House Webster’s* both define it as a “small **picture**.” Ex. 2018, Page004, Page035. A bare text string is not an “image” or a “picture” under any standard usage of those terms.

Notably, several of these dictionaries accompany their “icon” definitions with illustrative figures. *Barron’s* (7th ed.) includes a figure captioned “ICONS REPRESENTING PROGRAMS” depicting eight small graphical images—a letter, a printer, a notepad, a paintbrush, and similar pictograms—each representing a

software application. Ex. 2018, Page004. The accompanying text explains that icons “are used extensively in graphical user interfaces such as Microsoft Windows, the Macintosh, and the OS/2 Desktop.” These illustrations confirm that the dictionaries’ authors understood “icon” to refer to miniature graphical depictions, not text labels. Notably, Dr. Bederson relies on other versions of *Barron’s* to support his opinions not related to the term “icon.” Exs. 1016, 1022.

These dictionary definitions corroborate what the intrinsic record already makes plain. The specification’s three-way taxonomy—distinguishing “designation” (text), “icon” (graphical symbol), and “fixed or animated image” (photographic or realistic picture)—maps precisely onto the dictionary definitions, which uniformly place “icon” in the category of graphical or pictorial representations rather than textual labels. Petitioner’s construction—which would allow a bare text string like “1. XYZ Information” to qualify as an “icon”—finds no support in any contemporaneous technical dictionary. To the contrary, every authoritative source confirms that a person of ordinary skill in the art would have understood “icon” to require some form of graphical, pictorial, or symbolic visual element.

III. Rossmann Does Not Disclose an “Icon” as That Term Is Properly Construed

Under the proper construction of “icon,” Rossmann (Ex. 1004) fails to disclose any element that satisfies the “icon” limitations recited throughout the challenged claims. Every navigable element in Rossmann’s disclosed interface is a numbered text string in a list—precisely the type of “designation” that the ’058 patent’s specification expressly distinguishes from an “icon.”

A. Rossmann’s “Choice Cards” Present Numbered Text Lists

Rossmann discloses a system for navigating hierarchical information on a mobile phone using “choice cards” that present menus to the user. Ex. 1004, 8:65–9:11. Figures 4A through 4G illustrate the complete navigation sequence. Every selectable element shown in these figures is a numbered text string—for example, Figure 4B shows “1. ABC Corp. Sales,” “2. XYZ Information,” “3. Financial Info,” “4. Personal Web Site”; Figure 4D shows “1. World News,” “2. Local News,” “3. Financial News,” “4. News Brief.” Ex. 1004, Figs. 4B, 4D. The user selects an item by pressing the corresponding numbered key on the phone keypad or by scrolling a text-based arrow indicator and pressing a soft key. Ex. 1004, 9:11–15. There are no graphical symbols, logotypes, pictograms, or stylized visual elements of any kind.

Rossmann further describes its interface elements as “items” in a “menu” that are “numbered accordingly” and selected by “depressing a key corresponding to the choice.” Ex. 1004, 9:8–11. Additional figures show the same pattern: Figure 4E displays “1. News Brief,” “2. Stock Inquiries,” “3. Weather,” “4. Traffic Info”; Figure 4F displays “1. Town A,” “2. Town B,” “3. Town C.” In every case, the selectable elements are bare text strings—precisely the “designations” that the ’058 patent’s specification expressly distinguishes from “icons.”

B. Rossmann’s Own Specification Confirms the Text-Only Nature of Its Interface

Rossmann’s specification expressly acknowledges the severe graphical limitations of its target devices: “[T]he memory capacity of mobile computing devices are generally less than 250 kilobytes and their LCD display is perhaps four lines high by twelve or twenty characters and their graphics capabilities are very limited or nearly nonexistent.” Ex. 1004, 2:17–20. A device with “nearly nonexistent” graphics capabilities is, by Rossmann’s own admission, incapable of

rendering the kind of “stylized graphical or symbolic” elements that constitute “icons” under the ’058 patent. Rossmann never uses the word “icon” to describe its choice-card items and never describes any graphical symbol, logotype, or pictogram in its navigable menus.

Indeed, when Rossmann does use the term “icon,” it refers to something other than its menu items. Rossmann uses “icon” to describe the arrow indicator (“►”) that appears next to a selected menu item and the up/down scroll arrows that appear when the display contains more items than can fit on screen. Ex. 1004, 9:11–15, 9:50–10:2. Rossmann thus draws the same distinction as the ’058 patent: the numbered text entries are menu items (i.e., textual designations), while the graphical arrow symbols are “icons.” This usage confirms that Rossmann itself does not treat its text-based menu items as “icons.”

In addition to the numbered text items, Rossmann discloses “soft keys” labeled “OK” and “Back” that appear at the bottom of the display. Ex. 1004, Figs. 4B–4G; 9:54–60. These soft keys are text labels mapped to physical generic buttons on the phone keypad. They are not graphical icons; they are textual labels that describe the function of a physical button. Like Rossmann’s numbered menu items, the soft keys fall squarely within the “designation” category of the ’058 patent’s taxonomy.

C. Petitioner’s Expert Confirms That Rossmann Reserves the Term “Icon” for the Arrow Indicators

Petitioner’s own expert, Dr. Bederson, confirmed at deposition that Rossmann uses the term “icon” only to describe its arrow indicators—not its navigable text menu items. When asked whether Rossmann describes arrow 312 as an icon, Dr. Bederson testified that Rossmann “appears to be referring back to the same downward arrow 312 and describes it as an icon.” Allani Ex. 2019, 104:19–105:2.

He further confirmed that he did not “recall it using the term icon elsewhere.” *Id.* Rossmann’s own terminology thus demonstrates a clear internal distinction between “icons” (the arrow glyphs—small, stylized, graphical symbols) and “items” or “choices” (the numbered text strings in the menu). This usage is entirely consistent with the ’058 patent’s own taxonomy and with the dictionary definitions of “icon” discussed in Section II.I above.

D. Petitioner Does Not Rely on Rossmann’s Actual “Icons”

This distinction is dispositive because Petitioner does not map the claimed “direct access icons” or “selection icons” to the arrow indicators that Rossmann itself calls “icons.” Petitioner cannot do so, because the arrow indicators are passive scroll indicators that do not access any information source or navigate to any selection page. See Ex. 1004, 10:1–18. Instead, Petitioner maps the claimed “icons” to Rossmann’s numbered text menu items—“1. ABC Corp. Sales,” “2. XYZ Information,” “3. Weather,” and the like. See Pet. 15–21. But these are the very elements that Rossmann itself declines to call “icons.” Dr. Bederson himself acknowledged this, confirming under oath that “these menu items that—in Rossmann that you’re calling icon, they have no graphical element, they’re purely text,” to which he answered: “Yes, that’s right.” Allani Ex. 2019, 108:13–16.

The incongruity is stark: Petitioner asks the Board to treat as “icons” elements that even the prior art reference itself does not consider icons. Rossmann—a reference in the same technical field, addressing the same type of mobile device interface—reserved the word “icon” exclusively for graphical symbols (the arrows) and used different terminology (“items,” “choices”) for the text-based navigable entries. A person of ordinary skill in the art reading Rossmann would understand this distinction and would not consider Rossmann’s numbered text menu items to be “icons.”

E. Dr. Bederson's Analysis Does Not Establish That Rossmann Teaches "Icons"

Dr. Bederson's declaration does not independently establish that Rossmann's text menu items are "icons" within the meaning of the '058 patent. At deposition, Dr. Bederson repeatedly confirmed that he did not form his own opinion about the meaning of "icon" and instead applied what he characterized as "patent owner's interpretation." Allani Ex. 2019, 18:17–23, 19:7–13, 25:5–8. He refused to say whether a POSITA in 1999 would understand "icon" to encompass text-only elements, stating "I did not perform an analysis" of the plain and ordinary meaning and did not "have an answer for that question." Id. at 19:7–13.

Dr. Bederson's own declaration further underscores that Rossmann's navigable elements are text, not icons. In his declaration, Dr. Bederson coined the term "text-based links" to describe the Rossmann elements he maps to the claimed "icons." Ex. 1003, ¶ 86. At deposition, he confirmed this was a "descriptive term" he used "because they are text-based, and they are links that a user can select for navigating to additional information." Allani Ex. 2019, 85:3–9, 85:20–22. Dr. Bederson also used the phrases "hyperlink icons" (Ex. 1003, ¶ 81), "hyperlinks" (id. ¶ 91), and "text-based hyperlinks" (id. ¶ 176) to describe Rossmann's elements. When asked whether these terms were all the same thing or different things, Dr. Bederson could not provide a clear answer, instead asserting only that "Rossmann discloses all of those things." Allani Ex. 2019, 88:17–89:6. The proliferation of text-centric labels reflects Dr. Bederson's own recognition that Rossmann's elements are fundamentally textual in nature.

Dr. Bederson was also presented with two contemporaneous dictionary definitions of "icon"—both defining the term as a "small image" or "small picture" on a computer screen. Allani Ex. 2019, 97:12–22 (Microsoft Computer Dictionary);

111:17–112:1 (Dictionary of Computer and Internet Terms). When asked whether a POSITA would understand “icon” as defined in these dictionaries, whether Rossmann’s menu items would meet these definitions, or whether anything in these definitions suggests an icon could be text-only, Dr. Bederson refused to offer any opinion, stating he “just don’t have an opinion” and “did not perform that analysis.” *Id.* at 98:19–20, 112:23–113:6. This absence of independent expert analysis is telling: Petitioner’s own expert could not—or would not—opine that a POSITA would understand Rossmann’s text items to be “icons.”

F. Rossmann Fails to Teach the “Icon” Limitations of the Challenged Claims

Because Rossmann’s numbered text menu items are “designations” under the ’058 patent’s taxonomy—not “stylized graphical or symbolic selectable elements”—Rossmann does not disclose any element that qualifies as an “icon.” And because every asserted ground of unpatentability relies on Rossmann to supply the “icon” limitations, Petitioner has failed to demonstrate that any combination of prior art renders the challenged claims unpatentable. The Board’s Institution Decision did not construe “icon” or address this deficiency. See *Inst. Dec.* 7–8. Patent Owner respectfully submits that, upon full briefing, this independently fatal deficiency should be resolved.

V. The Phrase “Directly Accessing a Search Engine on the Web” Requires Access to a Standalone Web Search Service

Claim 25 of the ’058 Patent requires that at least one locally stored selection page is “specifically designed to include one or more icons for directly accessing a search engine on the Web.” *Ex.* 1001, 8:15–17. Claim 21 contains an analogous

limitation requiring “at least one icon for directly accessing a search engine for permitting a user to control searches on the Web.” Ex. 1001, 7:28–29.

The Board’s Institution Decision accepted Petitioner’s argument that Himmel’s site-specific search function satisfies this limitation, finding it was “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.” Inst. Dec. 11. As demonstrated below, the claim language, the specification, and the understanding of a POSITA all compel the conclusion that this phrase does not encompass a search dialog embedded within a single website’s web page, which is all Himmel discloses.

A. The Specification Uses “Search Engine” Exclusively to Refer to Standalone Web Search Services

The specification identifies the term “search engines” by its only named examples:

“These navigation software permit access to sites providing with search engines like Yahoo!™ or Voila™ allowing to emit requests in natural language and to receive in return a plurality of sites classified by decreasing relevance order.”

Ex. 1001, 1:14–19.

Yahoo! and Voila were standalone web search services, each operating at its own domain (yahoo.com, voila.fr), each returning results from across multiple websites on the Web. The specification does not use the term “search engine” anywhere to describe a search function embedded within a single website. A POSITA reading the specification would understand “search engine” to refer to this

type of resource—an independently addressable web-based search service—not a search box coded into the HTML of a retailer’s web page.

The specification further describes the purpose of including search engine icons in the locally stored selection pages:

“[T]he different consulted pages can advantageously include icons for accessing one or more search engines for permitting the user to take again as he likes the control of his searches on the Web.”

Ex. 1001, 5:1–4.

The phrase “the control of his searches on the Web” confirms that the search engine is one that permits searching across the Web—not within a single website. The specification envisions that a user navigating the locally stored selection pages may want to abandon the pre-authored navigation path and turn to a search engine to conduct an independent search across the Web. A search dialog embedded in sears.com does not give a user “control of his searches on the Web.” It gives the user control of searches within one retailer’s product catalog.

B. The Specification’s Address Architecture Requires an Independently Addressable Resource

The specification’s description of how direct access icons function further confirms that the claimed “search engine on the Web” must be an independently addressable resource. The specification teaches that the addresses of information sources corresponding to direct access icons are “beforehand locally stored in a table or base of addresses.” Ex. 1001, 2:20–24. As Dr. Eslamimehr explains, the patent “confirms this structure by teaching that the ‘addresses of information sources corresponding to direct access icons [are] beforehand locally stored in a table,’ ”

including addresses for portals, documents, and search engines.” Allani Ex. 2020 ¶31 (citing Ex. 1001, 2:20–24).

When the user selects a direct access icon, the device performs “a step for emitting on the communication network, in response to a selection of an icon in a page of selection currently displayed, the address of a source of information corresponding to said selected icon.” Ex. 1001, 2:13–16. When the icon is for a search engine, the device emits the address of the search engine. This presupposes that the search engine is the kind of resource that has its own address—its own URL on the Web—that can be stored in a table and emitted on a network. A standalone web search engine like Yahoo! has such an address. A search dialog whose code is embedded in the HTML of a retail website does not.

C. The Claim Structure Treats “Search Engine on the Web” as a Distinct Category of Resource

Claim 24, from which claim 25 depends, already requires direct access icons that connect the device to “remote sources of information or services”—i.e., websites generally. Ex. 1001, 7:42–8:14. Claim 25 then adds a separate requirement: an icon for “directly accessing a search engine on the Web.” If a “search engine on the Web” were merely any search function available at any website, this additional limitation would be entirely redundant with the direct access icons already required by claim 24, which can connect to any website—including those with embedded search features.

Similarly, claim 21 lists three distinct types of resources to be “directly accessed” by icons: (1) “a search engine for permitting a user to control searches on the Web”; (2) “a portal of Web site”; and (3) “a document provided by said Web site.” Ex. 1001, 7:28–39. Each is treated as a separate category of remotely

addressable resource. A search engine is not a subsidiary feature of a portal—it is a separate, independently addressable destination.

D. “On the Web” Cannot Be Read Out of the Claim

The phrase “on the Web” modifies “search engine,” identifying the type of search engine being directly accessed: a search engine that is itself a resource on the Web—that is, a search engine that exists as an independently addressable destination on the World Wide Web, directly accessible at its own web address.

If “on the Web” were read to mean merely that the search functionality exists somewhere within the web environment, the phrase would be entirely superfluous. Every feature of every website exists “on the Web” in that trivial sense. The “contact-us” link on sears.com exists “on the Web.” The “Review Order” button exists “on the Web.” A proper construction must give independent meaning to every term. *See Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005). “On the Web” distinguishes a search engine that is itself an addressable destination on the Web from a search function that is merely a feature embedded within another website.

As Dr. Eslamimehr explains: “The Board’s conclusion that Himmel’s internal search function satisfies this limitation effectively reads the phrase ‘on the Web’ out of the claim.” Allani Ex. 2020 ¶58.

E. Himmel’s Embedded Search Dialog Does Not Satisfy This Limitation

Himmel’s only reference to a “search” capability appears in its background discussion of common website features:

“On many Web sites, an attempt has been made to provide a somewhat rudimentary common interface with features such as ‘search’, ‘contact-

us’, etc. The dialog to access these features is found usually at the bottom or top of the Web page. However, the code to manage the dialog is embedded code in the web page.”

Ex. 1005, 19:1–7.

Himmel further explains the problem this creates: “[C]ommon tasks such as ‘purchase,’ ‘order’ and others are implemented using custom dialogs. Each site decides to implement the custom dialog in unique and often obtuse fashions, bewildering the consumer with a plethora of different user interfaces.” Ex. 1005, 19:5–9.

The “search” Himmel describes is, by its own language, a dialog whose code is “embedded code in the web page” of a retail website. It is a UI element—a search box—sitting “at the bottom or top of the Web page” alongside other site-specific features like “contact-us.” It is not a standalone web resource. It is not accessible at its own URL. It is not a separately addressable destination on the Web.

Notably, “search” is not among the consumer hot list bookmark items that Himmel’s invention provides for retail websites. The retail consumer hot list items Himmel identifies are: “Purchase,” “On-Sale Today,” “Review Order,” “Review Shopping Cart,” and “Consumer Address.” Ex. 1005, 19:65–20:7. “Search” appears only in the background discussion as an example of a “somewhat rudimentary” existing website feature—one that Himmel itself characterizes as part of the problem of inconsistent, “obtuse” website interfaces.

F. Himmel’s Search Dialog Fails Each Element of the Claimed Phrase

“Directly accessing.” The ’058 Patent’s architecture requires that each direct access icon have a corresponding address—a URL—that is “beforehand locally

stored in a table” and emitted on the communication network when the icon is selected. Ex. 1001, 2:20–24; Allani Ex. 2020 ¶31. Himmel’s embedded search dialog has no such address. It is not a separately addressable resource that can be the target of a direct navigation. It is, by Himmel’s own description, “embedded code in the web page” of a retail website. Ex. 1005, 19:5–7. There is no URL for the search dialog that could be stored in a table of addresses and emitted to “directly access” it. The user can interact with the search dialog only after first navigating to the retail website that contains it.

“A search engine.” A search dialog embedded in sears.com’s HTML is not a “search engine” as that term was understood in the art. It does not crawl, index, or search across multiple websites. It is a form field on a retailer’s page that searches only that retailer’s product catalog. The specification’s only named examples of “search engines”—Yahoo! and Voila—are standalone web services that return results from across the entire Web. Ex. 1001, 1:14–19.

“On the Web.” Himmel’s search dialog does not exist as an independently addressable resource “on the Web.” It has no URL of its own. It has no domain of its own. It cannot be navigated to independently. It is, by Himmel’s own description, “embedded code in the web page” of a retail site. Ex. 1005, 19:5–7. It is the paradigmatic example of something that is not a “search engine on the Web”—it is a feature of a website, not a resource on the Web.

G. The Board’s Institution Finding Was Error

The Board found it was “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.” Inst. Dec. 11. This finding conflates two fundamentally different things. A search dialog embedded in the HTML of sears.com is not “a search engine on the Web” any more than the

“contact-us” dialog on sears.com is an email service on the Web. Both are embedded code in a web page. Neither is a separately addressable resource. Neither has its own URL. Neither can be “directly accessed” by storing its address in a table and emitting that address on a network.

As Dr. Eslamimehr explains: “This interpretation overlooks the claim language and the plain meaning of ‘search engine on the Web.’ The ’058 Patent distinguishes between site-specific search features and a general-purpose web search engine, which permits a user to ‘control searches on the Web’ rather than just within a single domain. The Board’s conclusion that Himmel’s internal search function satisfies this limitation effectively reads the phrase ‘on the Web’ out of the claim. Nothing in Himmel suggests that the search functionality it discloses permits global or cross-site searching, nor does Dr. Bederson identify any such feature in his declaration.” Allani Ex. 2020 ¶58.

Dr. Eslamimehr further concludes: “[E]ven if Himmel’s search icon allows a user to locate content within a vendor’s website, it does not meet the requirement of a direct access icon that initiates a search engine ‘on the Web.’ The Petition offers no evidence that a POSITA would understand a local, domain-limited search function to satisfy the broader functionality required by the claim.” Allani Ex. 2020 ¶59. Moreover, “[n]either the Petition nor Dr. Bederson identifies any disclosure in Himmel that initiates a global search engine.” Allani Ex. 2020 ¶73.

VI. “Specifically Designed” Was Added as a Narrowing Limitation, Was the Focus of the Applicant’s Case-Law Argument, and Was Material to Allowance

During prosecution, Patent Owner amended the claims to add (and then rely upon) the express requirement that each “selection page” be “specifically designed” to contain the claimed set and arrangement of icons. *See, e.g.*, the June 12, 2020

amendment listing claim language requiring each locally stored selection page to be “specifically designed for containing a set of icons including ... a direct access icon ... and a selection icon ...” (Ex. 1002 at 630–631), as well as dependent claims requiring pages “specifically designed to include” particular combinations of selection and direct-access icons (Ex. 1002 at 633). In the accompanying remarks, Patent Owner emphasized that these amendments “narrow” the claims by requiring that the selection pages “have been specifically designed for containing the claimed set of icons, including selection icons and direct-access icons.” (Ex. 1002 at 625.)

Patent Owner then grounded that narrowing in Federal Circuit authority distinguishing “design/configuration” limitations from mere “capability.” Specifically, the remarks explained that requiring an element to be “specifically designed” “requires more than” being “merely capable” of use, and cited *In re Giannelli*, 739 F.3d 1375, 1379–80 (Fed. Cir. 2014) for the proposition that “configured to” requires more than “mere capability” and is synonymous with “made to” and “designed to.” (Ex. 1002 at 626.) To eliminate any doubt about the intended narrowing effect, Patent Owner expressly stated that—rather than use “configured to”—Applicant “directly and explicitly requires ‘designed to,’” again invoking *Giannelli*’s holding that “designed to” is not satisfied by mere capability. (Ex. 1002 at 626.) Patent Owner then applied that principle to the asserted references, arguing that Logan was not “specifically designed and constructed in the required manner,” and therefore did not cure the deficiencies of the primary reference. (Ex. 1002 at 626–627.)

The Examiner allowed the claims only after this amendment-and-argument sequence. The Notice of Allowability expressly states that it is “responsive to Amendment filed 06/12/2020,” and confirms that “claims 1–4 and 6–28” were allowed. (Ex. 1002 at 645.) The Examiner’s Amendment likewise reflects allowance of those claims and reiterates the allowed independent-claim language requiring that

the locally stored selection pages are “each being specifically designed for containing a set of icons” (Ex. 1002 at 646.) This intrinsic record confirms that “specifically designed” is a substantive, narrowing limitation that must be given effect in the Board’s claim construction and in evaluating whether Petitioner has shown that the asserted prior art teaches or suggests the required pre-authored page structure—not merely a system that could be repurposed or is theoretically capable of performing similar navigation functions.

Patent Owner’s expert testimony is consistent with—and reinforces—this prosecution-history understanding. Dr. Eslamimehr explains that the challenged claims require a multi-page, locally stored hierarchy in which each page is “specifically designed” to include particular icon types and page-to-page navigation roles (Ex. 2020 ¶ 28), and that the combined requirements of “beforehand locally stored,” “specifically designed,” and hierarchical tree organization distinguish the claims from the cited art because “[e]ach page must be deliberately authored to include the specific icon types required by the claims” within a fixed local structure (Ex. 2020 ¶ 34). He further explains that Petitioner’s theories improperly conflate general navigational benefits with the actual claim requirements: Claim 21 requires navigation through “locally stored, pre-authored selection pages ... where each page is ‘specifically designed’ to include precise configurations of selection and direct access icons,” not merely eventual access to a destination (Ex. 2020 ¶ 62), and similarly for Claim 24’s required progressive hierarchy of locally stored pages “each ‘specifically designed’ to include” the claimed combinations (Ex. 2020 ¶ 69). In Dr. Eslamimehr’s opinion, Petitioner likewise fails to show any asserted combination that provides a locally stored page “specifically designed” to include an icon for directly accessing a search engine, as required by Claim 25 (Ex. 2020 ¶ 72).

VII. Conclusion

For the foregoing reasons, the Board should find that Petitioner has not demonstrated by a preponderance of the evidence that any challenged claim of U.S. Patent No. 10,943,058 B2 is unpatentable. The Board's construction of "beforehand locally stored" is correct and should be maintained in the Final Written Decision, which disposes of Petitioner's challenges to claims 1–20, 22, and 27. The proper construction of "icon"—which the Board has not yet addressed—independently disposes of every remaining ground, as neither Rossmann nor Himmel discloses any element that qualifies as an "icon" under the '058 patent's own taxonomy. Additionally, Himmel's embedded search dialog does not satisfy the "directly accessing a search engine on the Web" limitation of claims 21 and 25. Patent Owner respectfully requests that the Board confirm the patentability of all challenged claims of the '058 patent.

WORD COUNT CERTIFICATION

Pursuant to 37 C.F.R. § 42.24, the undersigned certifies that this Patent Owner's Response contains 11,181 words as counted by the word-processing system used to prepare this paper, exclusive of the table of contents, table of authorities, mandatory notices, certificate of service, and this certification.

Respectfully submitted,

Dated: February 25, 2026

By: /s/ Jeffrey M. Goehring
Reg. No. 52,948
Nixon & Vanderhye, P.C.
Counsel for Patent Owner

CERTIFICATE OF SERVICE

I certify that the foregoing PATENT OWNER'S RESPONSE was served on February 25, 2026, on the Petitioner by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) as well as e-mailing a copy to ptab@eriseip.com .

Dated: February 25, 2026

By: /s/ Jeffrey M. Goehring
Reg. No. 52,948
Nixon & Vanderhye, P.C.
Counsel for Patent Owner