

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

FERID ALLANI,

Patent Owner.

Case No. IPR2025-00857

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

PATENT OWNER’S SUR-REPLY

TABLE OF CONTENTS

I. INTRODUCTION	1
II. ROSSMANN'S BARE TEXT MENU ITEMS ARE NOT THE CLAIMED "ICONS" (REPLY § II)	2
A. The plain and ordinary meaning: a stylized graphical or symbolic selectable element	2
B. Claim differentiation confirms Patent Owner's construction	3
C. The specification's examples — which the Reply does not address	4
D. The prosecution history: the applicant's conduct controls, and it is consistent	6
E. The extrinsic record is one-sided, and Petitioner's expert has never engaged it	8
F. Litigation conduct construes nothing	10
III. THE REPLY'S EXPANSION OF THE PETITION'S GRAPHICAL- MODIFICATION THEORY TO ALL CLAIMS CANNOT CARRY PETITIONER'S BURDEN (REPLY § III)	11
IV. THE BOARD CORRECTLY CONSTRUED "BEFOREHAND LOCALLY STORED," AND ROSSMANN STILL DOES NOT MEET IT (REPLY § IV)	12
A. The Reply's two scenarios are, respectively, rejected and new	12
B. Rossmann's own words defeat both scenarios	13
C. The purported admissions are nothing of the kind	15
D. The theory collides with the allowance record — and cannot save claims 1–20 regardless	15
V. HIMMEL DOES NOT SUPPLY "ONE OR MORE ICONS FOR DIRECTLY ACCESSING A SEARCH ENGINE ON THE WEB" (REPLY § V)	16
VI. "SPECIFICALLY DESIGNED" EXCLUDES PAGES THAT MERELY DISPLAY LINKS IN OPERATION (REPLY § VI)	18
VII. CONCLUSION	20

TABLE OF AUTHORITIES

Cases

<i>Axonics, Inc. v. Medtronic, Inc.</i> , 75 F.4th 1374 (Fed. Cir. 2023).....	11, 13
<i>Bicon, Inc. v. Straumann Co.</i> , 441 F.3d 945 (Fed. Cir. 2006).....	15, 19
<i>In re Magnum Oil Tools Int’l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016).....	11
<i>Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	13, 17
<i>Littelfuse, Inc. v. Mersen USA EP Corp.</i> , 29 F.4th 1376 (Fed. Cir. 2022).....	3
<i>Merck & Co. v. Teva Pharms. USA, Inc.</i> , 395 F.3d 1364 (Fed. Cir. 2005).....	16
<i>Omega Eng’g, Inc. v. Raytek Corp.</i> , 334 F.3d 1314 (Fed. Cir. 2003).....	6
<i>Salazar v. Procter & Gamble Co.</i> , 414 F.3d 1342 (Fed. Cir. 2005).....	6
<i>TriVascular, Inc. v. Samuels</i> , 812 F.3d 1056 (Fed. Cir. 2016).....	11
<i>Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.</i> , 853 F.3d 1272 (Fed. Cir. 2017)	13

Regulations

37 C.F.R. § 42.23(b)	12
37 C.F.R. § 42.24	20

I. INTRODUCTION

The Reply rests on three moves. First, it recasts examiner parentheticals from superseded rejections as a construction of "icon," while assuring the Board that Patent Owner "never attempted to differentiate text icons from its claims... until now in its POR." Reply, 6–7. Petitioner's own exhibit disproves that statement. In March 2019, the applicant argued that Logan taught "hypertext or HTML documents," not "selection pages containing icons," and the Examiner's Response to Arguments confirms she understood exactly that distinction — five years before this proceeding. Ex. 1002, 521–23, 533. Second, the Reply attempts to rescue twenty-three claims with a cache theory the Board already rejected, supplemented by a "prior session" hypothesis found nowhere in Rossmann or the Petition — and irreconcilable with the allowance-winning distinction of pages "merely... retrieved from Web browsing." Paper 13, 5; Inst. Dec. ("ID"), 13; Ex. 1002, 626–27. Third, the Reply answers Patent Owner's construction of "icon" with a one-paragraph extension of a two-claim Petition theory to all twenty-seven claims, sponsored by a declarant who has never analyzed what "icon" meant to a skilled artisan in 1999: by his own account, he "applied Patent Owner's interpretation," Ex. 1003, ¶82, and confirmed at deposition that he "did not perform an analysis" of the term's plain and ordinary meaning. Ex. 2019, 19:7–13. Each section of the Reply fails on the record Petitioner itself filed. The challenged claims should be confirmed.

II. ROSSMANN'S BARE TEXT MENU ITEMS ARE NOT THE CLAIMED "ICONS" (REPLY § II)

A. The plain and ordinary meaning: a stylized graphical or symbolic selectable element

Patent Owner's construction is the one stated in the POR: an "icon" is "a stylized graphical or symbolic representation — a pictogram, glyph, logotype, or simplified graphic element — as distinct from plain text." POR, 19–20. That meaning includes purely graphical icons, and it equally includes *stylized text*: a designed wordmark or logotype, a word presented within a bounded button or oval, or the "semi-graphic marks" the patent itself claims. Ex. 1001, claim 19. The patent's paradigm icons are logotypes, Ex. 1001, 2:39–40 — and a logotype *is* stylized text; the stylization is what distinguishes a logotype from a company name typed in system font. What the plain meaning excludes is bare, unstyled text: running prose, list entries, and hyperlinks whose only visual treatment marks them as selectable.

That last line is not arbitrary; the specification draws it. The passage the Reply dismisses as "background" describes prior-art portal pages whose choices — "designation[s]," "icon[s]," or "fixed or animated image[s]" — were each selectable by "[p]ointing and clicking... on the corresponding active zone." Ex. 1001, 1:23–29. The clickable text on those portal pages is the specification's Category 1: a "designation." Conventional link formatting — underlining, color — merely marks text as selectable; it cannot be the stylization that transforms a designation into an

icon, or the specification's three-way distinction collapses into a one-way street. Stylization, as the patent uses it, is visual treatment that constitutes the element as a discrete, bounded symbol or control. That is what the patent depicts, what the inventor built, and — as shown below — what every intrinsic example confirms.

B. Claim differentiation confirms Patent Owner's construction

The Reply's claim-differentiation argument, Reply, 13–14, assumes its conclusion. Under Patent Owner's construction, *both* dependent claims narrow claim 1: claim 19 narrows to "logotypes, graphic marks or semi-graphic marks"; claim 20 narrows to "icons compris[ing] textual elements" — that is, stylized-text icons such as labeled buttons and wordmarks. Ex. 1001, claims 19–20. *Littelfuse, Inc. v. Mersen USA EP Corp.*, 29 F.4th 1376, 1380 (Fed. Cir. 2022), requires only that the independent claim cover the dependent claim's embodiments. It does: an icon comprising textual elements — a stylized word; a word within a bounded control — satisfies claim 20 without being bare text. Nothing in the "comprising" convention changes that; a stylized word is still a "textual element."

Claim 12 does no work for Petitioner either. Reply, 14. Under the proper construction, claim 1's icons need not present graphic features at all — a logotype or semi-graphic mark is an icon without them. Ex. 1001, claims 19–20; 4:9–27. Claim 12 then narrows claim 1 in two respects: it requires that both icon types present graphic features, and that those features be capable of being distinguished

from one another — "the selection icons present graphic features that are distinctive from those of the direct access icons." Ex. 1001, claim 12. That is genuine narrowing, fully consistent with Patent Owner's construction; it nowhere implies that claim 1's icons may be bare text, which is not an icon of any kind. Petitioner's own applications confirm the point. To satisfy claim 12, the Petition asserted that Rossmann's plain text on a four-line character display "present[s] graphic features illustrating particular categorical themes." Pet., 52. To satisfy claim 19, it asserted that "Sears" "represents a logotype because it is a text logo related to the company name." Pet., 58–59. Readings that find "graphic features" in unadorned text, and a "logotype" in a name as such, erase the very characteristics those words denote.

C. The specification's examples — which the Reply does not address

The Reply repeats the Petition's textual-icon examples — "an icon AD11 'calendar,'" "an icon 'Return'" — as though the POR never answered them. Reply, 14. It did, and the Reply is silent on each answer. The quoted word is the icon's *label*; the element is what the patent depicts. Figure 1 renders the icons AD11 and AD12 as bounded shapes containing their labels, POR, 22; Ex. 1001, Fig. 1, and the accompanying description states that the depicted icons LO1 through LOi "featur[e] logotypes, graphic or semi-graphic marks." Ex. 1001, 4:9–27. The specification separately attends to "the shape and the design of these icons." Ex. 1001, 5:47–48. None of this is the vocabulary of bare text.

The file history says the same. The inventor's October 12, 1999 email describes selection "by pressing a 'Button' icon." Ex. 1002, 474. And the screenshot Petitioner itself reproduced at Petition 7 — from the inventor's declaration, Ex. 1002, 475 — shows every selectable element, from "GAP" and "Jean Paul Gaultier" to "E-Mail," "Retour au Sommaire," "Imprimer," and "Internet," as text inside an oval or rectangular bordered button. Not one element on that screen is bare text. Petitioner placed that image before the Board to prove "textual icons"; what it proves is text *stylized into controls* — precisely Patent Owner's construction. Asked at deposition whether the "Gap" oval is an icon, Petitioner's declarant answered that he "do[es]n't have an opinion." POR, 22–23 (quoting Ex. 2019). The Reply offers no response to the ovals, the buttons, or the inventor's own words, and its footnoted observation that the claims do not recite "active zones," Reply, 15 n.3, misses the point: the intrinsic record consistently presents icons as discrete bounded controls, consistent with claims 21 and 24–26's requirement of elements "capable of being selectively activated."

Finally, the Reply's only affirmative answer to the specification's three-way taxonomy is that the patent "correlates" nothing to "designation." Reply, 14–15. Petitioner nowhere says what a "designation" *is*, if not the textual label the word denotes — and its declarant does not either. The drafter chose three disjunctive

categories and then claimed "icons." Words in a list mean different things; that is the ordinary force of the disjunctive, and Petitioner offers nothing against it but silence.

D. The prosecution history: the applicant's conduct controls, and it is consistent

The Reply's prosecution-history showing, Reply, 7–12, consists of examiner parentheticals in rejections. But claim scope in view of prosecution turns on the *applicant's* statements and conduct; an examiner's unilateral characterizations do not create disclaimer and cannot settle a term's ordinary meaning. *Salazar v. Procter & Gamble Co.*, 414 F.3d 1342, 1345 (Fed. Cir. 2005). Measured by the applicant's conduct, the record is consistent.

When the Examiner anticipated over Cole with the parenthetical "links represent icons," the applicant responded that Cole's pages were server-generated rather than locally stored, Ex. 1033, 168–70, 177–78 — an architectural distinction, not an adoption of the parenthetical. When the Examiner cited Walden, the applicant's response was expressly conditional: Walden's HTML pane "may include hyperlinks, but fails to include any selection icons." Ex. 1033, 363. An *even-if* assumption made to defeat a rejection on other grounds is not a clear and unmistakable disclaimer. *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1324–26 (Fed. Cir. 2003). When the Examiner cited Hsu, the applicant's appeal brief contested "portal" and direct access — architecture again. Ex. 1002, 408–09.

And when the Examiner mapped Logan's textual "LINK[s]" to the icon limitations, the applicant did what the Reply tells the Board never happened. The Reply asserts Patent Owner "never attempted to differentiate text icons from its claims, despite the litany of rejections providing that opportunity, until now in its POR." Reply, 6–7. In March 2019, the applicant argued that the invention "gathers in a unique location a plurality of selection pages fully dedicated to host selection icons and direct-access icons," and that a skilled artisan "would not have found in Logan any teaching for designing within the Iki apparatus a plurality of selection pages containing icons and *not hypertext or HTML documents*." Ex. 1002, 521–23 (emphasis added). The Examiner's May 2019 Response to Arguments restates that argument in precisely those terms before disagreeing with it. Ex. 1002, 533. Whatever else may be said of that exchange, it establishes that the icons-versus-hypertext distinction was drawn by the applicant in 2019 — years before this petition and the district-court action — and understood by the Office as such.

Petitioner will say the Examiner disagreed and the applicant moved on. So she did, and so he did: allowance came on the independent "specifically designed" ground, Ex. 1002, 625–27, 645–46, which is why no inference of acquiescence arises — the applicant never had to accept the Examiner's parenthetical to obtain the patent, and an unsuccessful argument does not concede its opposite. What the applicant's

papers never did, anywhere in either prosecution, is assert or accept that a bare text link is an "icon."

The examiner-side record, taken accurately, points the same direction. The first office action found that Cole "teaches links on the selection pages" but not "a set of icons," adding Treyz "to graphically enhance the pages." Ex. 1033, 128–29. Across both prosecutions, every *logotype* limitation required additional graphical art — Treyz, Van Horn ("the logotype of the merchant site is displayed as an icon"), Matthews ("symbols are logotypes"). Ex. 1033, 129, 252, 342. And the Iki-based mappings that carried the final three rejections of the '058 prosecution uniformly described the icon-satisfying disclosure as a "graphical image corresponding to identifiers." Ex. 1002, 427, 481, 535, 585. A record in which examiners reached for graphical disclosures when available, demanded graphical art for logotypes, and heard the applicant distinguish "icons" from "hypertext" cannot establish that the ordinary meaning of "icon" *includes* bare text. That question returns to the specification and the evidence of skilled artisans' understanding — where the record is one-sided.

E. The extrinsic record is one-sided, and Petitioner's expert has never engaged it

Nine technical dictionaries spanning 1997 to 2005 uniformly define "icon" as a pictorial or graphical symbol. Ex. 2018; POR, 27–30. The Reply's answer is a

footnote asserting the intrinsic record is "unambiguous." Reply, 16 n.4. That premise is the dispute. And Petitioner's treatment of dictionaries is asymmetric: it discards Patent Owner's era-appropriate technical dictionaries as entitled to "no weight" while resting its own § V position on a 1999 dictionary and two 2026 web pages. The IEEE definition Patent Owner cites — "a symbol that is a pictorial indication of a command" — is, nearly verbatim, the construction Petitioner proposed in district court. Ex. 2018; Ex. 1055, 2. The Barron's dictionary is Petitioner's declarant's own cited source for other terms. Exs. 1016, 1022; POR, 30.

Against this, Petitioner offers no affirmative evidence of the 1999 meaning of "icon" — none. Its declarant's opening report states the basis for every icon opinion in one sentence: "I have applied Patent Owner's interpretation for my opinions herein." Ex. 1003, ¶82. At deposition he confirmed he "did not perform an analysis... of what the plain and ordinary meaning is or how a person of skill in the art would have understood it." Ex. 2019, 19:7–13. He declined to apply the dictionary definitions, Ex. 2019, 111:17–112:1, 112:23–113:6 , and his supplemental declaration's new "opinion" remains expressly conditioned on "the intrinsic record and... my understanding of Patent Owner's infringement allegations." Ex. 1052, ¶5. Cross-examination on that declaration completed the arc: nothing prevented the analysis originally — "That's probably right," Ex. 2021, 16:21–24; asked why he could not have done it then, "I don't have an answer for that question, sitting here

today," *id.*, 17:20–18:3; and the new opinion remains an analysis of "the intrinsic record and my view of Patent Owner's infringement allegations," *id.*, 19:23–20:2 — still not an analysis of what a skilled artisan understood in 1999. On the only question that matters — what a skilled artisan in 1999 understood an "icon" to be — Patent Owner's evidence stands un rebutted.

F. Litigation conduct construes nothing

The Reply's estoppel narrative, Reply, 4–6, confuses infringement contentions with claim construction. Preliminary contentions apply claims to products on an incomplete record; they are expressly preliminary and construe nothing. POR, 18. At *Markman*, Patent Owner urged plain and ordinary meaning and disputed the "indication of a command" clause of Petitioner's proposal — never the word "pictorial." POR, 18–19. The court adopted plain and ordinary meaning; it did not hold that the plain meaning embraces bare text. Ex. 1055, 2. If Petitioner may advance that court-adopted plain meaning here after stipulating away its own narrower proposal, Reply, 6 n.2, then the parties share a single question — what the plain meaning *is* — and that question is answered by the intrinsic and expert record above, not by accusation charts since superseded. Nor was the cited Edwards testimony the flat equation the Reply presents: he testified that "at least some" hyperlinks "could accurately be characterized as icons," and, pressed on blue underlined link text, that a hyperlink "could be associated with an icon." Ex. 1054,

53:20–22, 54:14–15. The Institution Decision's passing description of a direct access icon "such as a hyperlink," ID, 3, preceded any joined dispute over the term and decided nothing. *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016).

III. THE REPLY'S EXPANSION OF THE PETITION'S GRAPHICAL-MODIFICATION THEORY TO ALL CLAIMS CANNOT CARRY PETITIONER'S BURDEN (REPLY § III)

The Petition advanced its "add graphics" theory for two claims — claim 12, and claim 19 "[a]lternatively." Pet., 52–53, 58–59. The Reply now extends it "for all claims 1–27" in a single paragraph. Reply, 17–18. *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1384 (Fed. Cir. 2023), permits a petitioner to respond to a construction first advanced in a response; it does not relieve the petitioner of its burden to make an element-by-element showing, which cannot shift to the patentee or the Board. *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380–81 (Fed. Cir. 2016). Claims with distinct icon architectures — claim 21's three-page, three-role structure; claim 24's selectively-activated elements; claim 25's search-engine icon — receive no analysis at all. A cross-reference is not a case.

On the merits, the theory lacks a motivation. Rossmann's design answers devices whose displays are "perhaps four lines high by twelve or twenty characters" and whose "graphics capabilities are very limited or nearly nonexistent." Ex. 1004, 2:17–20. Rossmann's generic statement that "a card can contain text and images," Ex. 1004, 8:67–9:1, and the welcome-card graphic of Figure 4A, establish at most

capability — and Petitioner itself insists, in § VI, that capability is not use. Every navigational menu Rossmann actually discloses, Figs. 4B–4G, is plain numbered text with an arrow marker. The proffered reasons to change that do not fit: Himmel's data-charge rationale is specific to Himmel's own bookmark interface; the Palm III and Nokia 7110 are different devices, not Rossmann's constrained system; and the HDML "SRC option" is, again, capability. Ex. 1003, ¶¶164–65. What Petitioner must supply — a reason to convert every mapped menu item, across the claimed architecture, into a stylized icon on a four-line character display — is nowhere identified.

The fallback also concedes the primary case. Petitioner's declarant admits Rossmann's mapped menu items "have no graphical element, they're purely text," Ex. 2019, 108:13–17; that Rossmann reserves "icon" for its arrow indicators, Ex. 2019, 104:19–105:2; Ex. 1004, 9:11–15, 9:64–10:2; and that "the pointer itself" is *not* a claimed icon. Ex. 1003, ¶88. The only elements Rossmann calls icons are ones Petitioner's expert disclaims; the elements Petitioner maps are ones Rossmann never calls icons at all.

IV. THE BOARD CORRECTLY CONSTRUED "BEFOREHAND LOCALLY STORED," AND ROSSMANN STILL DOES NOT MEET IT (REPLY § IV)

A. The Reply's two scenarios are, respectively, rejected and new

Scenario one — decks "cached locally in RAM" before display — is the argument Petitioner made in its pre-institution reply and the Board rejected. Paper 13, 5; ID, 13. Section 42.23(b) authorizes response to the institution decision; it does not authorize resubmitting a rejected argument as though unaddressed. Scenario two — a deck "remain[ing] available in RAM... from a prior interaction," Reply, 20 — appears nowhere in the Petition, which staked its showing on the Figure 4 browsing sequence. Pet., 18–21. A reply may not supply an evidentiary theory the petition lacked. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016); *Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.*, 853 F.3d 1272, 1286–87 (Fed. Cir. 2017). Nor does *Axonics* assist: the construction adopted at institution was Patent Owner's from the preliminary phase, briefed at the Board's direction — Petitioner had notice and chose its theory.

B. Rossmann's own words defeat both scenarios

Rossmann's decks do not pre-exist the search; they are produced by it. The server "generates HDML decks along with CGI program 158, *in response to data from or choices made by the user*," and "fetches corresponding decks... *in response to the request* from the mobile device." Ex. 1004, 8:44–52. Pages generated in

response to the user's in-search requests cannot be "beforehand locally stored" relative to the search that calls them into being. The work-memory passage confirms the point in its own terms: decks are "normally kept in the work memory" — volatile RAM — and "[u]pon receiving a request from the user," the client "first consults the work memory" to see whether "the requested deck" is among "the received deck[s]." Ex. 1004, 8:52–58. That is an in-session cache check of just-received material. Nothing in Rossmann discloses a user *beginning* a preliminary search after decks persist from a prior session; the Reply's "[i]f a deck remains available," Reply, 20, is its declarant's hypothesis, Ex. 1052, ¶¶39–40, not a disclosure — and the same deposition testimony the Reply quotes acknowledges such caches may be "replaced 'after 24 hours.'" Ex. 1053, 69:10–13. Cross-examination confirmed it. Petitioner's declarant invoked, for the first time, Rossmann's multi-deck push at 13:60–66 — a passage appearing nowhere in his declarations — and then conceded that those pushed decks "are sent as a result of the user searching for the first deck," Ex. 2021, 66:20–24; that absent user action they "would not have been downloaded," *id.*, 66:25–67:4; and that, "at a high level," Rossmann's cached decks are stored only after "a user has performed some action to select or request those decks." *Id.*, 67:19–68:8. His "completely different session" gloss, *id.*, 68:9–14, is testimony, not disclosure.

Even indulging the hypothesis, one persisted deck is not the claimed invention. Claims 1 and 27 require the preliminary search to occur "in different themes and sub themes within said *plurality* of selection pages," organized as a tree, all beforehand locally stored. A single deck supplies "only the next navigational step, not the complete multi-level tree." Ex. 2016, ¶37; Ex. 2020, ¶67. Petitioner identifies no disclosure of the full tree resident before any search begins. And the Board's construction is the only one that keeps "beforehand" in the claim: under Petitioner's reading, every browser that caches content before rendering it "beforehand locally store[s]" that content, and the limitation does no work. POR, 16–17; *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950–51 (Fed. Cir. 2006).

C. The purported admissions are nothing of the kind

POR 9 addressed *who* may place the pages on the device — the user or the manufacturer — "so long as that configuration is completed before" the search. It says nothing endorsing mid-search caching; it presupposes the opposite. And Dr. Eslamimehr's cache testimony, Ex. 1053, 69:17–70:1, was conditioned throughout: a *previously requested* deck, within the cache window, for a revisit to *the same page*. Testimony that a revisited page can render from cache is not testimony that Rossmann performs a preliminary search through a beforehand-stored tree.

D. The theory collides with the allowance record — and cannot save claims 1–20 regardless

Claims 1 and 27 also require selection pages "specifically designed" for their icon sets. The applicant secured allowance by distinguishing Logan's pages as "merely pages retrieved from Web browsing and stored." Ex. 1002, 626–27. Rossmann's browsing-fetched, cache-retained decks are that architecture; Petitioner's § IV theory thus depends on the very page provenance the applicant distinguished to obtain the patent. See § VI, *infra*. Independently, claim 1 requires "one or more icons for directly accessing a search engine on the Web" — limitation [1(b)] — for which Petitioner relies on the same Himmel disclosure addressed next. Even were "beforehand locally stored" met, claims 1–20 stand or fall with § V.

V. HIMMEL DOES NOT SUPPLY "ONE OR MORE ICONS FOR DIRECTLY ACCESSING A SEARCH ENGINE ON THE WEB" (REPLY § V)

Giving the claim words their effect is not "importation." Claim 24 already reaches direct access icons to any remote source; claim 25 adds "a search engine on the Web"; claim 21 lists a search engine, a portal, and a document as three distinct destinations, "for permitting a user to control searches on the Web." Ex. 1001, claims 21, 24–25. Petitioner's reading collapses the categories and renders "on the Web" surplusage. *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005). The specification's only named examples are Yahoo! and Voila, Ex. 1001, 1:14–19; its architecture requires each direct access icon to correspond to a stored

address that is emitted on selection, Ex. 1001, 2:13–24; and when the Examiner needed this limitation during prosecution, she cited Cole — whose "search engines" are Yahoo!, Alta Vista, and Web Crawler-style keyword engines over cataloged pages. Ex. 1002, 586; Ex. 1057, col. 5.

Himmel offers nothing of the kind — by design. The word "search" appears twice in Himmel's specification. Once for bookmark title-matching. And once in the passage Petitioner relies on, which is a *problem statement*: prior websites offered "a somewhat rudimentary common interface with features such as 'search', 'contact-us', etc.," whose managing "code... is embedded code in the web page," implemented in "unique and often obtuse fashions, bewildering the consumer." Ex. 1005, 18:66–19:9. The next sentence pivots — "In this embodiment of the invention" — to Himmel's solution: standardized bookmark sets whose Retail consumer hot list ("Purchase," "On-Sale Today," "Review Order," "Review Shopping Cart," "Consumer Address") contains no search entry at all, each entry mapping to a server page or form. Ex. 1005, 19:9–20:7; col. 20. Himmel's invention exists to move users *away from* embedded site dialogs — search included — toward a fixed list that omits the feature. Petitioner's combination asks the skilled artisan to build a direct access icon to the problem Himmel discards. That is not a "search engine on the Web"; it is not even Himmel's preferred practice.

The Reply's new anchor theory fares no better. That the 1998 HTML specification *permits* fragment identifiers, Ex. 1065, does not place one in Himmel, which discloses no anchor, no address, and no independent identity for any search dialog — only "embedded code in the web page." Ex. 1005, 19:3–4. The theory and its supporting exhibit appear for the first time in reply, Ex. 1052, ¶¶45–48, and should be disregarded for that reason alone. *Intelligent Bio-Sys.*, 821 F.3d at 1369–70. And an anchor to a location inside a retailer's page would still not be a search engine on the Web.

Petitioner's extrinsic showing undermines itself. Its 1999 dictionary defines a search engine as "a program that searches" — an indexed, addressable service — and its observation that some engines serve "a single Internet site" describes engines, not embedded dialogs. Ex. 1061, 5. Its remaining support consists of a modern textbook chapter and a blog post dated April 4, 2026, offered for how marketing writers describe platforms a quarter-century after the priority date. Exs. 1063–64. Claim meaning is fixed at the effective filing date; 2026 usage answers nothing — and Petitioner cannot assign Patent Owner's nine era-appropriate dictionaries "no weight," Reply, 16 n.4, while asking the Board to construe a 1999 claim from a 2026 blog. As for Ground 3, adding Adar's bookmark to Yahoo! inside Himmel's bookmark manager supplies neither a selection page "specifically designed to include" the search-engine icon nor the claimed three-page architecture; the

Petition's Ground 3 analysis, Pet., 65–67, never maps them, and the Institution Decision addressed only motivation. ID, 16–17. The fallback inherits every structural defect of the primary theory.

VI. "SPECIFICALLY DESIGNED" EXCLUDES PAGES THAT MERELY DISPLAY LINKS IN OPERATION (REPLY § VI)

The Reply's rule — that a page which "actually displays the mapped... icons during operation" is "used to include" them, and "[t]hat is all" the claims require, Reply, 27 — is refuted by the event that produced the claims. Logan's pages *did* display the mapped elements in operation: the Examiner mapped Logan's "LINK[s]" 1–4 as the claimed selection and direct access icons. Ex. 1002, 533, 586. The applicant nonetheless obtained allowance by distinguishing those pages as "merely pages retrieved from Web browsing and stored." Ex. 1002, 626–27. If operational display sufficed, the amendment that produced allowance accomplished nothing — a construction the law forbids. *Bicon*, 441 F.3d at 950–51.

The distinction the record draws is not "subjective intent," Reply, 27 n.6; it is structural provenance. Indeed, "subjective intent" was Petitioner's own theory: it told the district court the phrase is indefinite "because it requires a subjective intent," Ex. 1036, 15–17 — an argument the court rejected in holding the term definite. Ex. 1055. Having lost that premise, Petitioner cannot re-attribute it to Patent Owner. Pages "fully dedicated to host selection icons and direct-access icons," Ex. 1002, 522, are

authored as selection pages; pages that accumulate links through browsing, caching, or user population are not — whatever they display. No designer's mental state need be examined; the pages' origin and role are objective facts. Nor is this a rewritten construction: "used to include" was Patent Owner's answer to Petitioner's indefiniteness attack, and the district court found the phrase definite with its plain meaning. Ex. 1055; Ex. 1036, 15–17. The content of that plain meaning is supplied by the intrinsic record above — not by Petitioner's substitute, "includes."

Applied here, Rossmann's decks are generated by CGI program in response to the user's choices, Ex. 1004, 8:44–47, and Himmel's bookmark sets are user-populated. Ex. 1005, 19:9–13. Pages that come into existence on request, and lists a user assembles, are the browsing- and user-derived structures the applicant distinguished — not selection pages specifically designed to contain the claimed icon sets.

VII. CONCLUSION

The Board's construction of "beforehand locally stored" was correct and disposes of claims 1–20, 22, and 27; limitation [1(b)] independently protects claims 1–20; "icon," properly construed, defeats every ground; and claims 21 and 23–26 additionally fail on "search engine on the Web" and "specifically designed." Patent Owner respectfully requests that the Board confirm the patentability of all challenged claims.

CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

Pursuant to 37 C.F.R. § 42.24, the undersigned certifies that this Patent Owner's Sur-Reply contains 4,643 words as counted by the word-processing system used to prepare this paper, exclusive of the table of contents, table of authorities, certificate of service, and this certification.

Respectfully submitted,

Dated: July 29, 2026

By: /s/ Lewis E. Hudnell, III
Lewis E. Hudnell, III
Reg. No. 51,185
Stanley H. Thompson, Jr.
(Special counsel to Hudnell Law Group P.C.)
Reg. No. 45,160
Hudnell Law Group P.C.
800 W. El Camino Real
Suite 180
Mountain View, CA 94040
T: 650-564-3698
F: 347-772-3034

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 SUR-REPLY and accompanying Exhibit 2021 were served on July 29, 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: July 29, 2026

By: /s/ Lewis E. Hudnell, III

Reg. No. 51,185

HUDNELL LAW GROUP, P.C.

Counsel for Patent Owner