

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

FERID ALLANI,
Patent Owner.

IPR2025-00857
Patent 10,943,058

Record of Oral Hearing
Held: August 5, 2026

Before JEFFREY S. SMITH, GEORGIANNA W. BRADEN, and
BRIAN P. MURPHY *Administrative Patent Judges*.

IPR2025-00857
Patent 10,943,058

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IPR2025-00857
Patent 10,943,058

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P R O C E E D I N G S

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JUDGE SMITH: Good morning, everybody. Welcome to the Patent Trial and Appeal Board. My name is Judge Jeffrey Smith. With me here in Alexandria is Judge Brian Murphy, and in Dallas, Judge Georgianna Braden. We are here today to hear IPR 2025-000857, concerning U.S. patent number 820524 -- I'm sorry, not that patent number. Wrong patent number. Patent number 10,943,058, where Apple is a Petitioner and Ferid Allani is the Patent Owner. We have a line open for the public. So, if the parties wish to discuss confidential information, please notify us before discussing anything confidential.

The panel has access to all papers filed with the Board, including demonstratives. When presenting your case, please identify which slide number you are discussing so that when we read the transcript, we can identify the slide being discussed. Each party has 60 minutes to present arguments for this hearing. Petitioner will open the hearing by presenting his case regarding the challenged claims for which the Board instituted trial. Patent Owner will then respond to Petitioner's arguments. Petitioner may reserve time for rebuttal to respond to arguments presented by Patent Owner, and Patent Owner may reserve time for surrebuttal.

I'll put the time on the clock up here. I'm only going to call out the time after the total time has expired. I ask you to track your own time during your presentation. Petitioner, please come up to the podium and state your name and the names of those who are here with you.

MR. HART: Good morning, Your Honors. Paul Hart with Erise IP for Petitioner, Apple. With me today is Hunter Horton, also from Erise

1 IP, and we have Patrick Arnett, in-house Counsel from Apple.

2 JUDGE SMITH: And you had a LEAP request granted, is that
3 right?

4 MR. HART: Yes, for Mr. Horton.

5 JUDGE SMITH: And how much extra time was granted in the
6 request?

7 MR. HART: We've requested 10 extra minutes.

8 JUDGE SMITH: Ten extraminutes. Okay, so your time will be
9 70 minutes then.

10 MR. HART: Thank you, Your Honor.

11 JUDGE SMITH: Okay, thank you. Do you wish to reserve time
12 for rebuttal?

13 MR. HART: I'll reserve 15 minutes for rebuttal.

14 JUDGE SMITH: Fifteen minutes. Again, I'm just calling this up
15 to have a general idea of how much time you want to have for your case in
16 chief. Everybody I've asked this question to has actually gone over. So, if
17 you go over, I'm not going to stop you from going over, but I just want to --

18 MR. HART: I do it every time.

19 JUDGE SMITH: If you go too far over, I'll give you a heads up.

20 MR. HART: Great. Thank you.

21 JUDGE SMITH: Okay. Thank you. And Patent Owner, please
22 step up to the podium and state your name and the names of those who are
23 here with you.

24 MR. HUDNELL: Good morning, Your Honors. Lewis Hudnell
25 for Patent Owner, Ferid Allani, from Hudnell Law Group. With me today is
26 my co-counsel, Jeff Goehring of Nixon & Vanderhye.

1 JUDGE SMITH: Do you wish to reserve time for surrebuttal?

2 MR. HUDNELL: I do, 15 minutes.

3 JUDGE SMITH: Okay. Thank you.

4 MR. HUDNELL: Thank you.

5 JUDGE SMITH: So, we're ready to hear the parties. Petitioner,
6 you'll go first. Let me set up the clock. Okay, you may begin when ready.

7 MR. HART: Thank you, Your Honor. Since institution, there
8 have been meaningful developments with respect to the two most prominent
9 disputes remaining between the parties. The first relates to icon. Although
10 Patent Owner did not address the meaning of icon pre-institution and was, at
11 the time in the litigation, asserting that text-based links satisfy the claim term
12 icon, it reversed course in its Patent Owner response, asserting for the first
13 time that icon excludes the text-based links it had accused of infringement in
14 the litigation. The second key dispute for which there has been meaningful
15 development relates to beforehand locally stored. And I'm sorry, I am not
16 seeing the slides. Are you all seeing the slides?

17 JUDGE BRADEN: No.

18 JUDGE MURPHY: No, at least I have them separately up, but --

19 MR. HART: Okay. Do I need to click anyplace?

20 MS. BOBO: Yes.

21 MR. HART: You told me to press that button. Thank you. Okay.
22 Back in action. Okay. The second key dispute relates to beforehand locally
23 stored. At institution, the Board expressed skepticism that Petitioner's
24 primary prior art reference, Rossmann, would satisfy beforehand locally
25 stored as properly construed. Here today, Petitioner is not disputing the
26 Board's interpretation of beforehand locally stored. We are accepting that

1 interpretation of the claims, but Petitioner has meaningfully developed the
2 record with testimony both from Petitioner's expert and Patent Owner's
3 expert. And with that additional development, we are going to demonstrate
4 today that Rossmann's disclosures do satisfy even the Board's interpretation
5 of beforehand locally stored. So, with those two significant developments
6 that have occurred post-institution, I'm going to try and move through these
7 initial kind of place-setting slides fairly quickly.

8 JUDGE MURPHY: Counsel, and also please reference the slide
9 number as you go for the clarity of our transcript.

10 MR. HART: Absolutely. Thank you, Your Honor. I'm starting
11 with DX-2. This is Figure 1 from the challenged patent, the '058 patent.
12 The basic premise of the '058 patent is to provide a way for a user to browse
13 through what the patent calls selection pages as a way to hone down a search
14 for information that is ultimately retrieved from the internet. These selection
15 pages are displayed in those boxes at the top of Figure 1, P0, P1, PN, minus
16 M.

17 They include icons allowing the user to click through selection
18 pages to arrive at a final selection page that has a direct access icon that
19 takes the user out to the internet to retrieve the information that is not stored
20 locally. So, an example that the patent provides is the user can select sport
21 on a first selection page, team sports or collective sports on the next page,
22 basketball on the third, and then can go out to the internet to retrieve the
23 information they need about a particular basketball event.

24 JUDGE SMITH: Okay. Hang on a minute. It looks like our
25 colleague in Dallas --

26 MR. HART: Yeah.

1 JUDGE SMITH: -- can't hear us.

2 (Whereupon, the above-entitled matter went off the record at 10:08
3 a.m. and resumed at 10:09 a.m.)

4 MR. HART: All right. Very good. So, again, DX-2 is just the
5 general premise of the invention. It allows a user to surf through a couple of
6 selection pages without contacting a server to minimize the communication
7 involved in searching for information that is ultimately retrieved from the
8 internet. DX-3 has an exemplary claim. This is claim 1 from the 05 patent.
9 Very wordy, but I have annotated the language that we're going to focus on
10 today. As I covered, the claims are really about providing these --

11 JUDGE SMITH: Just a second. Let me go back to DX-2 for a
12 second. I just want to make sure I understand this. Did you say for DX-2,
13 this is before the internet connection takes place?

14 MR. HART: So, the boxes at the top are selection pages that are
15 stored locally on the device, and those allow the user to go from sports to
16 team sports to basketball, on the device, without reaching out to the internet.
17 Once they obtain the selection page that is the subject matter they care about
18 and are looking for, there will be direct access icons. When one of those is
19 clicked, that takes them to the internet. So, it avoids the initial clicks or the
20 in-between clicks between starting the search and ultimately clicking the
21 search that obtains information from the internet.

22 JUDGE SMITH: Okay. So, there's an initial amount of
23 information that's already stored?

24 MR. HART: The beforehand locally stored issue that I alluded to
25 earlier relates to that.

26 JUDGE SMITH: Okay, okay.

1 MR. HART: These need to be stored on the device when the
2 preliminary search begins.

3 JUDGE SMITH: Okay, got it.

4 MR. HART: So, if we go to DX-3, this is Claim 1. We see
5 references to selection pages that are beforehand locally stored. They are on
6 the device and they contain those icons that allows the user to search both
7 locally through the selection pages and then eventually, clicking a direct
8 access icon that takes them out to the internet to retrieve information.

9 Down at the bottom, fourth to last limitation. This is alluding to
10 the concept of surfing between themes and subthemes across those selection
11 pages. So, again, sports, team sports, basketball on the device, and then
12 when you find the link you want, that takes you out to the internet for the
13 information.

14 DX-4 summarizes Petitioner's grounds here. All four grounds are
15 based primarily on the combination of Rossmann and Himmel. Rossmann is
16 a mobile device that downloads HDML decks of cards. Those provide those
17 selection pages that the user can click through on the device. Himmel adds
18 to Rossmann the concept of direct access icons, so links within Rossmann's
19 system that allow the user to go out to the web and retrieve information. All
20 the remaining disputes between the parties focus largely on this core
21 combination of Rossmann and Himmel, that forms the foundation of all
22 proposed grounds in this proceeding.

23 JUDGE SMITH: Well, let me ask you before you go on. There's a
24 lot of dispute about whether the combination of Rossmann and Himmel has
25 a search engine, but that issue seems moot, given that Ground 3 has a search
26 engine. And I didn't see a response from Patent Owner on Ground 3. Given

1 that, do we need to really discuss whether Rossmann and Himmel has a
2 search engine, or is that --

3 MR. HART: No, I think you're exactly right, Your Honor. Mr.
4 Horton, our LEAP practitioner, is going to handle that issue, so I don't want
5 to steal his thunder.

6 JUDGE SMITH: Oh.

7 MR. HART: But yes, I do think you're exactly right that that has
8 been presented. Adar has been presented as an alternative theory that
9 renders moot whether Himmel's search link satisfies the search engine on the
10 web.

11 JUDGE SMITH: Okay.

12 MR. HART: And I think you're also correct that that has not been
13 meaningfully responded to by Patent Owner.

14 JUDGE SMITH: Okay.

15 MR. HART: I do still have the icons there, in part to give Mr.
16 Horton an opportunity to argue the search engine issue. These are the four
17 remaining issues between the parties. I touched on the first two. Again,
18 beforehand locally stored -- this was language that the Board construed at
19 institution. Construing this language to require a temporal relationship, such
20 that Rossmann's decks must exist on the device in memory when the user
21 starts clicking through those cards, searching for that ultimate link that takes
22 them out to the internet.

23 As I mentioned, we're not disputing the Board's interpretation of
24 that language. We are applying the Board's interpretation and showing that
25 as the record has developed, Rossmann's process satisfies even the Board's
26 interpretation of beforehand locally stored. Icon is an interesting procedural

1 issue. So, the parties were actively arguing over the meaning of icon in the
2 Markman process down below when this petition was filed.

3 Petitioner, Apple, was actually asking the District Court to
4 construe icon to require pictorial symbols, excluding text-based links.
5 Patent Owner was fighting that construction, advocating plain and ordinary.
6 Patent Owner ultimately prevailed after the petition was filed. So, in the
7 District Court, the District Court rejected Apple's narrow interpretation that
8 would have required pictorial symbols and adopted Patent Owner's proposal
9 for plain and ordinary.

10 JUDGE MURPHY: Is that with respect to Claim 1 or the
11 independent claims?

12 MR. HART: Icon is in every claim, so this applies to all
13 challenged claims.

14 JUDGE MURPHY: What about the dependent claims? So, what
15 particularly -- I mean, I don't know if you want to get into this now or later,
16 but I'm particularly interested in claim differentiation, dependent Claims 19
17 and 20, and how they bear on that analysis with respect to the independent
18 claims.

19 MR. HART: Yes, I do want to get there. Let me wait until we get
20 to that slide, if you don't --

21 JUDGE MURPHY: Okay.

22 MR. HART: -- mind, Your Honor, but that is an important issue
23 here. So, essentially what we have here is a Patent Owner who prevailed in
24 obtaining a broad construction in the District Court and is now seeking a
25 narrow construction inconsistent with its win in the District Court, hoping to
26 preserve the validity of these claims.

1 Search engine on the web, Mr. Horton is going to handle. The
2 question for the Board is essentially whether a search engine on the web has
3 to search the entire web or whether a search engine that covers pages within
4 a single domain is sufficient. The Board found at institution it was, and
5 there's no reason for the Board to deviate from that finding in its final
6 written decision.

7 Final issue is specifically designed and what it means in the claims
8 for these selection pages to be specifically designed. As I will cover,
9 Rossmann's HDML decks provide the structure that Patent Owner claims is
10 required by that specifically designed language. So, I'll get into that last.

11 DX-6 kicks off the first issue, beforehand locally stored. As I
12 mentioned, the Board construed this at institution. The Board interpreted the
13 beforehand locally stored language to require a temporal limitation. The
14 selection pages that are in Rossmann's system obtained by downloading a
15 deck of cards, must be received by the device and stored in the device's
16 memory before the preliminary search begins. That was the analysis the
17 Board performed at institution. We are not disputing that.

18 The Board also found that in Rossmann's system, the preliminary
19 search begins when the user makes that first selection, such as clicking XYZ
20 information. So, we're not disputing the Board's analysis. We are accepting
21 that analysis, and we are applying that analysis, showing that as the record
22 has developed, Rossmann's system does satisfy even the Board's
23 construction that it laid out at institution. In the petition, Petitioner Matt
24 Rossmann's cache case embodiment --

25 JUDGE MURPHY: Counsel, you're on Slide 8 now, right?

26 MR. HART: I am on Slide 8. Thank you.

1 JUDGE MURPHY: Yeah. So, tell me, in the cache case
2 application of Rossmann, to our claim construction --

3 MR. HART: Okay.

4 JUDGE MURPHY: -- how does this satisfy the initial storage
5 before a preliminary search --

6 MR. HART: Yes.

7 JUDGE MURPHY: -- is made?

8 MR. HART: So, in the petition, we focused on a single use of a
9 deck in the cache case embodiment of Rossmann. So, when the user clicks
10 XYZ information for the very first time, the device reaches out, downloads
11 the deck of cards, which is essentially all of the pages captured by XYZ
12 information or XYZinformation.com. That is stored in cache memory, and
13 the user can click through those pages without further communication with
14 the server.

15 The Board at institution found that because the deck is downloaded
16 after the user presses XYZ information, it does not preexist in memory
17 before the preliminary search starts. What the developed record has shown,
18 both through cross-examination of Patent Owner's expert and a supplemental
19 declaration of Petitioner's expert, is that those decks are stored in cache
20 memory for extended periods of time. Patent Owner's expert conceded that
21 the cache is replaced after 24 hours, and that if the user comes back and
22 searches for different information in XYZ information, that card that was
23 initially downloaded from the first search --

24 JUDGE MURPHY: How does that satisfy the storage requirement
25 before a preliminary search?

26 MR. HART: So, the preliminary search is the process of clicking

1 through those selection pages to get to your ultimate link that you want to
2 reach out and get information from. If I go to Slide 25, this shows the pages
3 that are captured by the deck that was downloaded in response to the user
4 selecting XYZ information.

5 So, for example, the first time the user clicks XYZ information, the
6 deck is downloaded. They click through in a preliminary search to the
7 ultimate Figure 4F, click Town A, that's the town they want to get weather
8 information about. In our combination, that is a direct access link that goes
9 out and gets the weather from the internet. That provides their answer at 4G.
10 When the user comes back a second time, that deck still exists in cache
11 memory. It's stored in cache memory for up to 24 hours according to Patent
12 Owner's own expert. So, when the user comes back, for example, and wants
13 weather about Town B -- maybe they're traveling from Town A to Town B
14 that day -- when they click XYZ information, that deck already exists in
15 memory.

16 JUDGE MURPHY: Yeah, but why is that subsequent search
17 preliminary?

18 MR. HART: Because they still have to go through those same
19 steps of clicking through these selection pages. That's the preliminary
20 process of the search is to get to --

21 JUDGE MURPHY: Even though they've already been stored in
22 the cache memory?

23 MR. HART: The decks have been stored, so that provides the
24 structure of those pages, and that's been stored in memory. The search
25 process, according to the patent, is the process of clicking through sports,
26 team sports, basketball, to ultimately get to something where you can reach

1 out and get information from the internet. So, in this example, the second
2 time the user comes back and wants weather about Town B, they are
3 initiating a new preliminary search.

4 JUDGE MURPHY: So, how are we supposed to measure that
5 temporal delta? Like, is it five minutes later? An hour later, 24 hours later?

6 MR. HART: On this record, Patent Owner's expert has testified
7 that typically, cache remains for 24 hours. So, that is the amount of time
8 that we are utilizing.

9 JUDGE MURPHY: How does that fit within our claim
10 construction?

11 MR. HART: Your claim construction requires a set of selection
12 pages to be stored beforehand, locally stored in the device when the user
13 begins a preliminary search. We have shown that because those decks are
14 cached and are stored for a full day, the user can come back and do
15 additional preliminary searches using that same deck.

16 JUDGE MURPHY: Well, they're making searches. The question
17 is, are they preliminary with respect to our claim construction?

18 MR. HART: Sure.

19 JUDGE MURPHY: I mean, we said in the DI -- now look, we can
20 change our mind and you can persuade us, but you're basically talking about
21 a 24-hour wait period where there's no access, if you will. No search in the
22 cached memory, but then they come back to it -- I guess, go through the
23 protocol again --

24 MR. HART: Sure.

25 JUDGE MURPHY: -- of stepping through the XYZ cards and
26 then make a search. And you're calling that a preliminary search?

1 MR. HART: We are.

2 JUDGE MURPHY: So, second search.

3 MR. HART: It absolutely is a second search, but it goes through
4 these same steps and is the same preliminary search process that we have
5 mapped and you have analyzed for purposes of the petition's theory.

6 JUDGE MURPHY: Is there anything in the spec that reflects your
7 view or your application, if you will, of the Rossmann cache memory
8 embodiment, with such a -- call it a 24-hour waiting period?

9 MR. HART: So, the Rossmann reference does teach that the decks
10 are stored in memory and that a deck can be -- as the user clicks through is
11 what Rossmann teaches. When the user makes a selection, the system looks
12 to see if the currently stored deck serves that selection or not.

13 JUDGE MURPHY: I'm sorry, but I was referring to the '058
14 patent.

15 MR. HART: Oh.

16 JUDGE MURPHY: There are disclosed embodiments in the
17 patent at issue -- Patent Owner's patent --

18 MR. HART: Sure.

19 JUDGE MURPHY: -- that would reflect that type of embodiment
20 given our construction of beforehand locally stored --

21 MR. HART: Um-hum.

22 JUDGE MURPHY; -- meaning before a preliminary search.

23 MR. HART: On this record, there is a concession from Patent
24 Owner that the '058 patent allows users to download, to customize, to
25 modify. So, this is not something that exists as static on the device.

26 JUDGE MURPHY: But there's no concession by Patent Owner

1 that the Rossmann cache case satisfies the claim construction?

2 MR. HART: Certainly true, which is why it's still one of the --

3 JUDGE MURPHY: Right.

4 MR. HART: -- disputed issues.

5 JUDGE MURPHY: Well, that's -- right. Okay.

6 MR. HART: And to directly address your question, there is no
7 express disclosure in the '058 patent. This is a column and a half disclosure.

8 It's a very short, very brief --

9 JUDGE MURPHY: Understood.

10 MR. HART: -- low on detail patent. There is no express
11 discussion of coming back a second time and what that means in the context
12 of a preliminary search. I will say that in the context of the Board's analysis
13 and what constituted the preliminary search here in the single-use case that
14 was presented in the petition, that exact same process occurs a second time
15 under the theory that we are now presenting to the Board that satisfies the
16 Board's analysis.

17 JUDGE MURPHY: So, your theory essentially depends on a first
18 search being completed?

19 MR. HART: Yes.

20 JUDGE MURPHY: And whatever the waiting period might be
21 -- could be 10 minutes, could be an hour, could be 24 hours. The patent
22 doesn't say, but your point is, a first preliminary search is completed.

23 MR. HART: Yes.

24 JUDGE MURPHY: That search is ended.

25 MR. HART: Yes.

26 JUDGE MURPHY: And then the user comes back and makes a

1 second search, going through the cache memory of the downloaded deck.

2 MR. HART: That's exactly right. And so, it's that preserving the
3 deck, the fundamental feature in Rossmann in the cache case embodiment,
4 that the decks are preserved in memory and they are saved for 24 hours. It
5 may be that the next search the user initiates is not served by that stored
6 deck. And in that use case, we are out of the scope of these claims.

7 JUDGE MURPHY: Right. But how are we supposed to know?

8 JUDGE SMITH: Could you go to Slide 25, again? So, the claims
9 talk about preliminary search, and I'm just curious. So, during the first
10 search, when the deck is not in cache-- what is the preliminary search in the
11 first search when the deck is not in cache?

12 MR. HART: So, this was the issue the Board weighed in on at
13 institution. The Board found that when the user at page 4B, which actually
14 scrolls over to 4C, those are the same page, that is a user choosing XYZ
15 information in 4C. That is the beginning of a preliminary search.

16 JUDGE SMITH: And then what's the actual search then when it
17 transitions from preliminary to --

18 MR. HART: Sure, that's when you obtain the information. Again,
19 in the patent context, the '058, you're doing this preliminary search going
20 from selection page to selection page to finally find a direct access icon that
21 takes you out to the internet for the information, the fresh information --

22 JUDGE SMITH: So, what --

23 MR. HART: -- you care about.

24 JUDGE SMITH: When you do the second search then --

25 JUDGE MURPHY: Yes.

26 JUDGE SMITH: -- which one of these figures, 4A through 4G, do

1 you start on for the second search?

2 MR. HART: So, you will go through this exact same process.

3 JUDGE SMITH: You start at 4A.

4 MR. HART: So, you start at 4A. When you go to 4B and you
5 scroll down to XYZ information at 4C, that is the beginning of the
6 preliminary search, according to the Board's analysis. That selection will be
7 served by the deck that is already in memory.

8 JUDGE SMITH: So, 4C is the preliminary search for the --

9 MR. HART: That's the --

10 JUDGE SMITH: -- second search?

11 MR. HART: Exactly, Your Honor. The start of the second
12 preliminary search.

13 JUDGE SMITH: And then everything is already local.

14 MR. HART: Yes.

15 JUDGE SMITH: And then let's say this is your first search, you
16 did it at 6:00 in the morning on your way to work, and now your second
17 search, it's 6:00 at night, you're home from work, you want to go to the
18 grocery store. So, you want to know what the weather is like. It's 6:00 at
19 night. So, you go to Town A again, and then you get the evening, is it going
20 to rain or --

21 MR. HART: Or a different town. So, there are lots of information
22 served by these decks.

23 JUDGE SMITH: Okay.

24 MR. HART: And that's really one of the core concepts in this
25 theory, is the fact that Rossmann preserves those decks in memory and
26 allows the user to come back and use a previously stored deck satisfies this

1 beforehand locally stored. It will not, as Judge Murphy observed, it will not
2 happen every time, but it does support the use case of a user coming back
3 and making a second -- going through a second preliminary search that is
4 served by a previously downloaded and currently stored deck of cards.

5 JUDGE SMITH: You mentioned in your opening remarks that
6 there is some information that's permanently locally stored. Is that right?
7 Going back to Slide 2, if I understand what you're saying correctly, these
8 three boxes at the top, these are all permanently stored?

9 MR. HART: I'm not sure that they -- I'm not sure that I said
10 permanently. If I did, I was just --

11 JUDGE SMITH: Oh.

12 MR. HART: -- kind of high-level explaining the basic concept.

13 JUDGE SMITH: They don't need access to the internet to --

14 MR. HART: The point is that you're trying to minimize how many
15 times the device reaches out across the internet for information. So, this is
16 really targeting bandwidth-limited connections. And so, these selection
17 pages are surfed locally, just like you're surfing locally through Rossmann's
18 cards.

19 JUDGE SMITH: So, when you search through these pages locally,
20 could you perform a search just using these pages here that are surfed
21 locally, or do you still need to go to a deck?

22 MR. HART: Theoretically, all the claims have a requirement for a
23 direct access icon. And the point of those --

24 JUDGE SMITH: I see.

25 MR. HART: -- direct access icons is to take you out to the
26 internet.

1 JUDGE SMITH: I see. I see.

2 MR. HART: So, the point is to do your preliminary searching to
3 get to that direct icon you're looking for without a bunch of communications
4 out to the internet. It minimizes the communication in that preliminary
5 process.

6 JUDGE SMITH: So, in this figure, there's no preliminary search
7 that leads you to a direct --

8 MR. HART: Sorry, there is in fact a preliminary search as you go
9 from P0 to P1, to that last box on the top right, where I have annotated in
10 green one of those icons and a green arrow that comes down to a URL. The
11 preliminary search is getting you from the left to the right, clicking through
12 those selection pages, and then when you click that direct access icon, that's
13 what takes you out to the internet to get the information you need.

14 JUDGE SMITH: So, does this figure meet the claim?

15 MR. HART: Yes, I would have to go through element by element
16 to make sure this depicts everything in all the claims, but it absolutely
17 captures the basic concept of having locally stored selection pages that are
18 beforehand locally stored, as well as having direct access icons that take you
19 out to the internet.

20 JUDGE SMITH: Okay.

21 MR. HART: So, coming back to DX-9, this is the testimony from
22 Patent Owner's expert. He conceded that when a deck is stored in memory,
23 when the user comes back with a similar request to visit the same page it's
24 already previously downloaded, it doesn't need an internet connection. This
25 subsequent search, preliminary search that is based on a preserved deck from
26 a first search, does not require connection to the internet, does not require

1 additional communications, and that's why it satisfies the Board's beforehand
2 locally stored construction.

3 JUDGE MURPHY: And so, if I can just summarize for myself,
4 top level. So, you're saying that in Rossmann, coming back to do that
5 preliminary search through previously stored deck of HTML, or the HTML
6 deck of cards, it's essentially the same thing as what you just went through
7 with Figure 1.

8 MR. HART: Yes. Yes, Your Honor.

9 JUDGE MURPHY: Until you get to a direct access icon to reach
10 the internet, which is the point of the patent, is an efficient search strategy.

11 MR. HART: That's right.

12 JUDGE MURPHY: Right? To eliminate latency, whatever,
13 multiple internet searches, that kind of thing, right?

14 MR. HART: That's exactly right, Your Honor. Yes.

15 JUDGE MURPHY: Okay, I understand.

16 MR. HART: All right. Thanks very much, Your Honor. DX-11
17 just touches on Axonics, and this is the essential framework that we are
18 operating under further developing the record. Despite the fact that the
19 Board expressed skepticism at institution, we have developed the record to
20 show that Rossmann -- the same embodiment of Rossmann that we relied on
21 in the petition, satisfies the Board's interpretation of beforehand locally
22 stored.

23 JUDGE SMITH: Patent Owner brought this up in surreply. I just
24 want to -- you haven't had a chance to address it yet. Patent Owner's
25 argument in their surreply, and I'm sure they'll get to this in their case in
26 chief -- let me just make sure I get their argument correctly, at least as I

1 understand it. If I'm wrong, Patent Owner will correct me. But Patent
2 Owner is saying that, look, we granted you claim construction briefing
3 before institution. You picked your claim construction theory. You could
4 have done this before institution. And this is Patent Owner's words:
5 "Petitioner had notice and chose its theory." What do you say to that?

6 MR. HART: Sure. So, I have two responses to that. One is legal
7 in nature about the logic behind the Axonics decision. The other is
8 procedural in nature. So, as of institution, when that pre-institution briefing
9 was occurring, we did not have a theory on the record about this subsequent
10 search with a preserved deck. So, that was not -- it was not possible for us to
11 rely on that theory at institution. We also had not had an opportunity to
12 depose or cross-examine Patent Owner's expert where he conceded that, yes,
13 in fact, Rossmann's decks are preserved and can be used a second time. So,
14 the information we are relying on here showing that the prior art we
15 presented in the petition satisfies the Board's interpretation of this claim
16 language was not available. That is something that had to be developed
17 post-institution. So, that's just practical procedural why we didn't do it at
18 that time.

19 Under Axonics, the Axonics decision talks about fundamental
20 fairness. If a claim construction is introduced that the Petitioner has not
21 previously addressed, estoppel mandates that that Petitioner be permitted an
22 opportunity to show that the prior art satisfies that claim construction. That's
23 the situation we have here.

24 There's an interesting case study here. We had two petitions
25 originally. One, the '877 patent is parent to the '058. That has beforehand
26 locally stored in every claim. The Board expressed skepticism of

1 beforehand locally stored with respect to Rossmann and denied institution.
2 Because institution was denied, Apple, Petitioner, can now show in other
3 tribunals, the CRU in an ex parte reexamination or the District Court
4 litigation, that Rossmann satisfies even the Board's interpretation of
5 beforehand locally stored.

6 In this case, only some claims have beforehand locally stored. So,
7 all claims were instituted under SAS, as they have to be. But you expressed
8 skepticism of the ones that include beforehand locally stored. Estoppel will
9 kick in at the conclusion of this proceeding with respect to all claims. So,
10 this is our only opportunity to show that beforehand locally stored is
11 satisfied by Rossmann, and that's what we're doing through this subsequent
12 use using a preserved deck. So, that's the legal side of this issue.

13 JUDGE MURPHY: And is it correct that Petitioner is relying on
14 the same embodiment or embodiments in Rossmann that were identified in
15 the petition?

16 MR. HART: Exactly. Exactly the same embodiment. The cache
17 case embodiment is the core, was the core of the theory in the petition. It is
18 the core of the theory we're presenting now. We are just showing that using
19 that cache case embodiment with a preserved deck satisfies the Board's
20 interpretation. DX-12 picks up the second primary dispute between the
21 parties, and that relates to the meaning of icon.

22 JUDGE SMITH: I guess before you get too involved in this, I just
23 want to pick up on Judge Murphy's point that he made earlier. I mean under
24 Phillips, for the claim construction, we start with the claims themselves, and
25 if we can understand the meaning or the scope of the claim from the claims
26 themselves, we're done. If we can't, we go to the spec. If we can't

1 understand it from the spec, we go to the prosecution history. And then if
2 we still can't do it, only then we go to extrinsic evidence. There's a lot of
3 arguments from both parties talking about the specification, the prosecution
4 history, the extrinsic dictionary definitions, all this stuff. Do we really need
5 to go through all that, given that Claim 20 says that the icons comprise
6 textual icons? Isn't that enough for us to determine from the claims
7 themselves the scope of icons?

8 MR. HART: Yes, Your Honor. I do think that Claims 19 and 20,
9 while maybe not dispositive, are certainly strongly indicative that the
10 independent claim icon --

11 JUDGE SMITH: Why wouldn't it be dispositive?

12 MR. HART: I think our position is that an icon is broad enough to
13 capture text-based links, graphical-based icons or symbols, as well as
14 graphical plus text icons. So, broad enough to capture any of those
15 variations. Claim 19 requires it further limits the icon to logotypes, graphic
16 marks, or semigraphic marks. So, this is limiting only to the class of icons
17 that include graphics. Claim 20, where the icons comprise textual elements,
18 is saying that whatever else is in the icon, it must at least have some text.

19 JUDGE SMITH: But I mean, at least in terms of resolving this
20 dispute, I mean, maybe there are other disputes where it's an issue. But as
21 far as we're concerned, if we just say that the scope of icon encompasses
22 text, why isn't that enough for us to make a decision?

23 MR. HART: It is. The issue's done. That's exactly what we're
24 asking you to do, is to conclude that the term icon in these claims is broad
25 enough to capture text-based links without graphics. That is how the Patent
26 Office interpreted the term during prosecution. It's how Patent Owner

1 interpreted the term when it filed the lawsuit, the parallel lawsuit. It
2 interpreted icon to capture text-based links in its infringement allegations in
3 the District Court.

4 And it actually pushed back on Petitioner, Apple's, Markman
5 position, where Apple sought to narrowly construe icon to require pictorial
6 symbols. And it prevailed in Markman. It obtained that broad construction
7 at Markman. All we are asking this Board to do is to adopt the same broad
8 construction that was applied by the Patent Office, that was interpreted by
9 Patent Owner, that was adopted by the District Court to sync up everybody's
10 understanding what it means.

11 JUDGE SMITH: I mean, do we really need to adopt the
12 construction beyond Claim 20 says it comprises textual elements and that's
13 the end? Do we need all these other constructions that -- what the patent
14 examiner did with it?

15 MR. HART: Well, the Patent Owner is arguing that an icon must
16 at least include some graphics and that 20 simply requires that it also, in
17 some cases, include text. Patent Owner's position is that it can never be just
18 text alone without graphics. So, I do think that is an important issue that
19 must be resolved. I think 20 is very persuasive.

20 JUDGE SMITH: But doesn't 20 answer that question? Doesn't
21 Claim 20 answer the question?

22 MR. HART: I would love if it did, but I do think that there is an
23 argument to be resolved. I don't want the decision to turn on something that
24 is at risk of appeal. So, I do think there is an argument that if graphics are
25 required of the underlying icon of all icons, that 20 still works. It just says
26 that you have to have graphics plus some text.

1 JUDGE SMITH: Twenty doesn't say you have to have graphics.

2 MR. HART: It doesn't. It further limits an icon to require at least
3 some textual element.

4 JUDGE SMITH: And Claim 1 doesn't say anything about what an
5 icon is.

6 MR. HART: I'm fully on board that we are correct --

7 JUDGE SMITH: Right.

8 MR. HART: -- that the icon --

9 JUDGE SMITH: It sounds like you want to take us through the --

10 MR. HART: I promise you, I don't like to hear myself talk, but I
11 do want to click through the slides. I do think the simplest explanation of
12 what's happening here is that everybody, including Patent Owner,
13 understood that text-based links were captured by icon. That is the
14 conclusion we're asking you to reach. This is a case of Patent Owner
15 obtaining a broad construction in the District Court, and then doing a 180
16 and asking for a narrow construction, a conflicting construction at the PTAB
17 to preserve the validity of its patent. And I don't think that should be
18 allowed. I think it's pure gamesmanship. So, I do want to click through at
19 least quickly. I know I'm, as I always do, running out of time here, but I do
20 want to quickly show kind of the sequence of events here so you understand
21 --

22 JUDGE BRADEN: And so, you're on Slide 14 now?

23 MR. HART: I just clicked up to Slide 14, Your Honor. Thank you
24 very much.

25 JUDGE BRADEN: Thanks.

26 MR. HART: So, briefly, Slide DX-14 provides a timeline with

1 regard to the parties' dispute of icon. So, on the left, we have June and
2 October of 2024. Patent Owner filed its complaint, served its initial
3 contentions in the District Court litigation, accusing basic text links of
4 satisfying the term icon in the claims. February 2025, Apple -- Petitioner,
5 Apple, filed its first Markman brief advocating a narrow construction of icon
6 that requires pictorial symbols.

7 March 2025, Patent Owner pushed back on that. It filed its
8 responsive Markman brief and said, Apple was wrong. Plain and ordinary
9 should control, and its expert conceded that basic hyperlinks, text-based
10 hyperlinks, satisfied icon. The petition was filed in April of 2025. Because
11 Apple was advocating a narrow construction in the District Court litigation
12 in an open Markman proceeding, it could not file its petition based on a
13 conflict -- couldn't affirmatively advocate a conflicting claim construction.

14 So, it asked this Board to adopt Patent Owner's interpretation of
15 icon, which includes text-based links. The next, May 2025, the Court issued
16 its Markman order. It rejected Apple's attempt to narrow icon to graphical
17 or pictorial symbols, adopted plain and ordinary, and then the IPR was
18 instituted. And in its institution decision, the Board accepted that text-based
19 links, such as those in Rossmann, do satisfy the claim term, icon. So, up to
20 this point, Apple asked for a narrow construction requiring symbolic
21 pictorial icons. It lost.

22 JUDGE MURPHY: Thank you. Counsel, if you know, what's the
23 exhibit number for the Court's Markman order of May 6th, 2025?

24 MR. HART: I don't know off the top of my head, but my
25 colleague will get that.

26 JUDGE MURPHY: But it's in the record, right?

1 MR. HART: Yes, absolutely, Your Honor. DX-15. So, after this
2 proceeding was instituted, everybody agreed text-based icons -- or text-
3 based links are captured by icon. Patent Owner shifts theories. It disowns
4 its prior infringement allegations, says those were just preliminary. It asked
5 this Court to narrowly construe icon to exclude text-based links. So,
6 essentially, after having won, prevailed on obtaining a broad construction in
7 Markman, it turned around and asked this Board to give it an inconsistent,
8 narrow construction at the PTAB to save its claims.

9 JUDGE MURPHY: But I mean, the fact is both parties are going
10 back and forth in District Court and the PTAB, which they do. So, for our
11 purpose, we're just trying to focus on the claim language first and foremost.

12 MR. HART: Yes.

13 JUDGE MURPHY: And then obviously we need to at least
14 consider the District Court's construction, which is why I asked for that. I
15 don't have the exhibit number off the top of my head.

16 MR. HART: It's Exhibit 1055, Your Honor.

17 JUDGE MURPHY: 1055. Thank you.

18 MR. HART: And your point is exactly right. You're trying to get
19 to the right answer.

20 JUDGE MURPHY: Yeah.

21 MR. HART: DX-16, and one of the concerns is that you don't
22 want to create inconsistencies between tribunals. So, Apple attempted to
23 obtain a narrow construction and lost. In the Revvo decision from Director
24 Squires, he addressed exactly the scenario we find ourselves in. He said, if a
25 party advances a narrow construction in the District Court, and the District
26 Court declines to adopt that narrow construction, the party would have

1 sufficient reason for advancing the broader Court-adopted construction in a
2 proceeding before the Board. Apple accepts that it lost that Markman
3 position. It has stipulated --

4 JUDGE SMITH: Hang on a second. Hang on a second.

5 MR. HART: Yes, Your Honor.

6 JUDGE SMITH: It looks like we lost Dallas again. So, let's see.

7 MR. HART: We can see you moving again.

8 JUDGE BRADEN: Perfect. Thank you. And thank you for
9 speaking so I could confirm that I could hear you guys. Thank you.

10 JUDGE SMITH: Okay.

11 MR. HART: Back to DX-16. This is the Revvo decision from
12 Director Squires. So, this is the exact situation we find ourselves in. Apple
13 advanced a narrow construction at Markman, lost. It has now accepted that
14 the broad construction controls, stipulated that it will not argue that text links
15 are excluded from the claimed icons. And this is the opportunity to sync up
16 the tribunals and construe icon consistently with the District Court.

17 JUDGE MURPHY: Well, I mean, so Counsel, I'm looking at
18 Exhibit 1055, and all it says for the Court construction is, "plain and
19 ordinary meaning." So, what am I to make of that? Is there an analysis
20 behind that?

21 MR. HART: Less than we would like. What --

22 JUDGE MURPHY: Well, is there anything in the record other
23 than this document, Exhibit 1055, that we need to consider because we're
24 required to consider the Court's construction of a claim limitation that's in
25 dispute here?

26 MR. HART: Certainly, Your Honor. What we do have in the

1 record is the parties' competing proposals to the District Court in the
2 Markman process. And so, we have Apple's proposed construction, which
3 was rejected by the District Court, when it granted a plain and ordinary
4 meaning. And that is not in my slides, but it is in Patent Owner slides. So, I
5 will direct you --

6 JUDGE MURPHY: Well, you're talking about the parties'
7 submissions, right?

8 MR. HART: That's right. So, the parties briefed up competing
9 positions. Patent Owner disputed Petitioner, Apple's, Markman position.
10 Petitioner, Apple, advocated for a construction of icon that is, "a symbol that
11 is a pictorial indication of a command." The parties fought about whether
12 that was right or not, and the District Court rejected that.

13 JUDGE MURPHY: All right.

14 MR. HART: So --

15 JUDGE MURPHY: Did the District Court issue any document
16 other than 1055 that reflects the Court's claim construction?

17 MR. HART: I would have to go back to the record. My firm's not
18 handling the District Court litigation, so I don't want to misstate on the
19 record, but I can certainly look that up.

20 JUDGE MURPHY: I mean, in my experience, it's typical that
21 there's an opinion that goes with the order. And we need to have it --

22 MR. HART: Understood.

23 JUDGE MURPHY: -- if we're going to do this, right? So, could
24 you please -- I'll ask Counsel for both parties to please double-check that and
25 --

26 MR. HART: If there is a written analysis beyond the actual order

1 itself construing the claims, we will absolutely make sure it's part of this
2 record.

3 JUDGE MURPHY: Okay. Thank you.

4 MR. HART: Yes, Your Honor. Coming back to my slides. So, in
5 addition to this Markman process, where Patent Owner is trying to take the
6 opposite position with the PTAB that it took in the District Court, Apple is
7 trying to accept the District Court's construction and make sure everything is
8 consistent and synced up. The prosecution history provides ample evidence
9 to show how icon was interpreted, particularly by the office.

10 So, the '877 patent file history is Exhibit 1033. And I have here on
11 DX-17 -- DX-17, 18, and 19 all provide examples from the file history of the
12 parent '877 patent, and the current challenged '058 patent, showing that over
13 and over, the Patent Office understood the claimed icon term to include text-
14 based links with no graphical --

15 JUDGE SMITH: But I think the Patent Owner's point is that,
16 yeah, the examiner said this, but the Applicant never agreed to that during
17 -- I mean, examiners say all kinds of things during prosecution, and then
18 -- but it's not prosecution history estoppel on the part of the Applicant, if
19 Applicant never agreed to it. Applicant wrote, prosecution said no, that's not
20 what icon means. So, why would we -- I mean, what the examiner said is,
21 again, it's something to consider persuasive, but it's not binding if Applicant
22 never agreed to it.

23 MR. HART: So, Patent Owner has taken the position that none of
24 this rises to the level of disclaimer. And that, in fact, gets the analysis
25 backwards. We are arguing that the term icon should be construed broadly
26 to capture graphical icons as well as text-based icons. There is no disclaimer

1 argument. There's no disclaimer threshold that we need to satisfy here.
2 We're simply showing the Board that the office over and over advanced text-
3 based links against these claimed icons. There were also office actions --

4 JUDGE SMITH: The examiner eventually allowed the claim.

5 MR. HART: Yes, for other reasons. That's where the specifically
6 designed language led to allow it. So, it was unrelated to whether icons
7 could be text or not. I don't think that there is a clear statement from Patent
8 Owner in the record or from the Applicant in either of these file histories
9 where they affirmatively push back on the theory that an icon could capture
10 text-based links. In fact, as we saw from the infringement contentions in the
11 complaint in the litigation, Patent Owner itself understood icon broadly
12 enough to capture text-based links.

13 So, over and over through two separate prosecutions and in the
14 early stages of the current parallel litigation, the office and Patent Owner all
15 understood that an icon captured a text-based link with no graphical
16 component. It does not need to rise to the level of disclaimer. We're not
17 suggesting that anything was disclaimed. Quite the opposite.

18 JUDGE SMITH: Yeah, I don't mean to cut you short. Just in
19 terms of getting to -- I would like to hear some arguments about specifically
20 designed because those arguments I actually don't really understand. But to
21 this point, I don't see how -- the information you're giving us about the
22 District Courts and plain and ordinary meaning, the examiner said text
23 hyperlinks are icons. I mean, I don't see how this adds anything beyond
24 what we already have from Claim 20.

25 So, I mean to your point that icon encompasses text, we have that
26 from Claim 20. These other things are consistent with that, but -- well, I

1 mean, this is your time. I don't want to tell you how to spend your time. I'm
2 just saying I would like to hear specifically designed because that's -- on this
3 record, that's the thing I'm most unclear about.

4 MR. HART: Understood, Your Honor. I'm dense, but not quite
5 that dense. I will move off the icon issue for now, and I will jump to
6 specifically designed, to make sure we have plenty of time to resolve the
7 issue --

8 JUDGE SMITH: Okay.

9 MR. HART: -- that you would like to cover, and I think it's
10 important to cover. As I alluded to earlier, Mr. Horton from my team, the
11 LEAP practitioner, is going to be handling the search engine. So, I'm going
12 to skip search engine and let Mr. Horton come back to that. So, I am now
13 down on DX-33 for the specifically designed issue. Here we have
14 exemplary language in Claim 1, for selection page being specifically
15 designed for containing a selection icon for locally accessing said selection
16 page. So, this specifically designed for containing language comes in often
17 in these claims in the context of specifically designed to have pages of a
18 certain makeup containing certain icons, comprising selection icons,
19 comprising direct access icons, that sort of thing.

20 So I, as you apparently have, have struggled to understand what
21 this means and how it limits the claim through this case. Patent Owner has
22 taken a number of positions that are internally inconsistent throughout this
23 proceeding, which has made the process of understanding this claim
24 language that much more difficult. On DX-34, in its Patent Owner response
25 at page 44, Patent Owner suggested that specifically designed requires
26 deliberate authorship.

1 So, this is something that would require looking at the designer's
2 mental state. What did the designer intend this system to do? How did the
3 author intend that system to look? But its surreply at page 20 distanced that
4 position. No designer's mental state need be examined. So, we can take the
5 question of mental state and author's intent off the table for purposes of
6 understanding specifically designed.

7 The next conflicting issue is whether user involvement is excluded.
8 In the surreply at page 19, Patent Owner insisted that pages that come into
9 existence on request are not selection pages specifically designed to contain
10 the claim icon sets. But in its Patent Owner response at page 9, Patent
11 Owner conceded that its interpretation of the claims is fully consistent with a
12 user downloading, configuring, or customizing the selection pages and icons
13 on the device. So, we have conflicting positions in a number of different
14 respects. That was Slide DX-35 I was just reading from.

15 So, that gets us to the question, what is specifically designed?
16 What does it require? And what does it distinguish in the prior art? I think a
17 fair reading of what the Patent Owner's position on specifically designed
18 means and how it impacts these claims is that it distinguishes classic web
19 surfing. If a user is clicking one by one, page one, to page two, to page
20 three, and those pages happen to have an icon layout as required by the
21 claims, that is not enough. There must be some built-in structure that
22 mandates those pages have the desired or the claimed icon arrangement.

23 So, it is something different, something more than classic page-by-
24 page web surfing. That's exactly what Rossmann's HDML decks provide.
25 When Rossmann's device downloads an HDML deck, it includes all of those
26 pages that the user can click through locally on the device. It provides that

1 structure, distinguishing it from classic web surfing where you're contacting
2 the server with every click, and it aligns perfectly with my best
3 understanding of what the Patent Owner is saying with respect to
4 specifically designed to include in this case.

5 JUDGE MURPHY: And is that also consistent with our
6 construction of beforehand locally stored?

7 MR. HART: It is, Your Honor, yes. So, it provides that structure,
8 that hierarchy, and those pages with their icon layouts, regardless of when
9 that deck was downloaded. Any questions on specifically designed?

10 JUDGE SMITH: I just want to make sure that the argument
11 between Petitioner and Patent Owner is -- you're saying because these pages
12 have these -- contain these icons, they're specifically designed to contain
13 these icons?

14 MR. HART: It's slightly more than that. It's because when that
15 deck is downloaded, the deck creates the hierarchy, the structure, that
16 mandates which icons appear on which pages. So, it is the structure that
17 mandates the specific icon arrangement in our combination.

18 JUDGE SMITH: Okay. Okay. Thank you.

19 MR. HART: If there are no further questions on that, I don't want
20 to leave my colleague with too little time on search engine. So, I'm going to
21 have Mr. Horton step up and handle the search engine issue next.

22 MR. HORTON: Thank you, Your Honors. I'll be handling the
23 search engine on the web limitations. So, I think I'm going to skip to
24 Petitioner Slide DX-32. So, here, I think it was previously alluded that the
25 Ground 3 position may obviate the rest of the analysis for the other slides
26 that I was going to get at. So, here in Slide DX-32, Patent Owner fails to

1 substantively address Petitioner's alternative argument in Ground 3. Here, if
2 the Board finds that Claim 25 requires a standalone search engine, Adar
3 supplies that feature. Adar teaches an express bookmark to Yahoo, and
4 that's consistent with the embodiments in the '058 specification discussing
5 conventional search engines like Yahoo or Voila. So, under the broad
6 interpretation or narrow interpretation here, the Rossmann-Himmel-Adar
7 system in Ground 3 would meet the claims.

8 JUDGE MURPHY: So, just so I'm clear, this argument for
9 Ground 3 assumes Patent Owner's construction is correct?

10 MR. HORTON: Yes, that's correct.

11 JUDGE MURPHY: And so, on that theory, you wouldn't be
12 disputing that claim construction because Adar, in your opinion, discloses
13 what a search -- the Yahoo search engine, in particular?

14 MR. HORTON: That's exactly right.

15 JUDGE MURPHY: Patent Owner will speak for themselves.
16 You're saying there was no argument from Patent Owner addressed to that
17 issue?

18 MR. HORTON: Yeah, Patent Owner never challenged Adar's
19 teachings or the specific merits of Ground 3. Patent Owner's arguments tied
20 directly to the independent claims. And so, if the Board were to reject
21 Patent Owner's arguments related to those independent claims, then Ground
22 3 would meet Claim 25, the search engine icon there.

23 JUDGE MURPHY: Okay. Thank you, Counsel.

24 MR. HART: And with that, we'll reserve the -- unless there are
25 any remaining questions before Patent Owner. Okay, very good. We'll
26 reserve the rest of our time for rebuttal.

1 JUDGE SMITH: Okay.

2 MR. HUDNELL: Is it possible to take a quick five-minute break?

3 JUDGE SMITH: You want to take a five-minute break? Okay.

4 MR. HUDNELL: That's right.

5 JUDGE SMITH: Okay, that's fine. We'll break for five minutes.

6 MR. HART: Your Honors, I do have courtesy copies of

7 Petitioner's slides, if either of you would like a copy.

8 JUDGE SMITH: No, we have them.

9 MR. HART: Okay.

10 JUDGE SMITH: Yeah.

11 MR. HART: Very good.

12 (Whereupon, the above-entitled matter went off the record at 10:57
13 a.m. and resumed at 11:04 a.m.)

14 MR. HUDNELL: Good morning again, Your Honors. Lewis
15 Hudnell, Hudnell Law Group, for Patent Owner Ferid Allani. I'd like to start
16 with just a little bit of an overview of the '058 patent, but really specifically
17 to address some of the comments that Petitioner made with respect to Figure
18 1 of the '058 patent. So, just a couple points I wanted to make clear.

19 So, what we see here in Figure 1 are a series of selection pages
20 -- P0 -- and this is on Slide 3 -- P0, P1, PN through M. These are all
21 selection pages. What the patent defines as a selection page is that it must
22 include two things. It has to include selection icons, which are icons that
23 take you to other locally stored pages. And it has to include direct access
24 icons -- icons that take you out to remote sources, such as the web or the
25 internet.

26 So, what I've illustrated here on Slide 3 is which icons are selection

1 icons and which icons are direct access icons. So, as you can see on P0, we
2 have the red indicates selection icons, icons that take you to other locally
3 stored information. These are designated by TH. And if you recall earlier,
4 Petitioner referred to these as theme icons -- sports, music, weather,
5 whatever the case may be. Theme icons, these take you to other locally
6 stored pages. That's what the TH stands for.

7 On P0, also you have LO, logotype icons is what the patent calls
8 them. These are direct access icons. So, if you clicked on one of these on
9 P0, you would go out to the internet. And so, each page has to have both, a
10 selection icon and the direct access icon. So, that's one point. Second point
11 I wanted to make clear, Your Honor, is that it's not the case that you have to
12 navigate through every single page to get to the final direct access icon,
13 because as you can see here, P0 has both direct access and selection icons.
14 So, does P1. So, does PN through M.

15 So, you could navigate through TH1 to an ST icon subtheme,
16 stands for subtheme, subtheme 1 on P1, and then find your direct access icon
17 on PN through M, or you could find it earlier. The way the patent is set up,
18 you could have a direct access icon on any given page, is the point. And
19 then the third point I want to make, Your Honor, and this will sort of relate
20 to some of the discussion regarding the specially designed term, the
21 beforehand locally stored term, is that all of these pages -- what the patent
22 requires is that all these pages have to be beforehand locally stored. All the
23 selection pages have to be beforehand locally stored.

24 So, what that in turn means is that the icons need to be defined for
25 the page that gets stored. And so, the selection icons need to be defined for
26 the page that gets stored, and so do the direct access icons need to be defined

1 for the page that is stored in the device, for the embodiment of the '058
2 patent. So, I just wanted to make those points clear ahead of time before
3 jumping into the further discussion. I think you're familiar with the
4 instituted grounds on Slide 4, so I won't spend much time on that. And same
5 thing with the instituted --

6 JUDGE SMITH: Just real quickly on --

7 MR. HUDNELL: Yes.

8 JUDGE SMITH: -- Slide 4.

9 MR. HUDNELL: Yes.

10 JUDGE SMITH: Is Petitioner correct that you didn't provide a
11 response to Ground 3?

12 MR. HUDNELL: I believe that statement is incorrect, Your Honor
13 --

14 JUDGE SMITH: Okay.

15 MR. HUDNELL: -- and I can explain that when I get to the search
16 engine term.

17 JUDGE SMITH: Okay.

18 MR. HUDNELL: Unless you'd like me to point to it now.

19 JUDGE SMITH: No, no, no, no.

20 MR. HUDNELL: Okay.

21 JUDGE SMITH: I just wanted a yes or no answer right now.

22 MR. HUDNELL: Yeah, sure.

23 JUDGE SMITH: You could keep the flow that you have.

24 MR. HUDNELL: Okay. So, instituted grounds, Slide 4.

25 Summary of the institution decision on Slide 5. I'm assuming that you're
26 familiar with it. Slide 6 is the slide that I really kind of wanted to

1 emphasize, which is -- which shows the missing limitations of Patent
2 Owner's asserted prior art and how it applies to the different claims. And we
3 do believe that the icon term is dispositive of all the claims. It appears in all
4 the claims. Beforehand locally stored is not in all the claims. And so, that's
5 why it would only -- that's why Grounds 1 through 20, 22, and 27 weren't
6 instituted because those claims have the beforehand locally stored limitation.
7 The search engine claim is not universal. It's not in claims 24 and 26. And
8 then specifically designed is also dispositive. It would cover all of the
9 claims.

10 Slide 7 is just a graphical illustration of the limitations that are
11 missing from that summary that I just provided, as it applies to claim 1 of
12 the '058 patent. Claim 1 is missing the beforehand locally stored limitation,
13 specifically designed icon and search engine on the web. Claim 21 is
14 missing specifically designed icon and search engine on the web. That was
15 Slide 8, this is Slide 9. Claim 24 is missing specifically designed icon. And
16 Claim 27 is missing beforehand locally stored, specifically designed and
17 icon and search engine on the web. That's Slide 10. So, I wanted to start
18 with actually icon because I think it's important to understand what
19 happened here with respect to the term icon.

20 And before I do that, I just want to answer a couple of questions
21 that you raised to Petitioners. So, first of all, in the District Court litigation,
22 there is no written opinion -- written Markman opinion -- beyond what
23 you've seen in the exhibit that Petitioner pointed to you. Judge Albright did
24 not -- I'm lead Counsel in the litigation. Judge Albright did not articulate
25 any reasoning behind his claim construction. It's just that chart that you see
26 in that exhibit.

1 JUDGE SMITH: He just said plain and ordinary meaning.

2 MR. HUDNELL: That's it.

3 JUDGE SMITH: Okay.

4 MR. HUDNELL: Correct.

5 JUDGE MURPHY: So, you're confirming that for the record?

6 MR. HUDNELL: I am, yes. I haven't seen it. I'm involved in
7 -- I'm lead counsel on litigation. It doesn't exist.

8 JUDGE MURPHY: We just want to be sure.

9 MR. HUDNELL: Yeah. The second thing that I want to clarify,
10 and I think this is important with respect to the term icon, is that Patent
11 Owner never challenged the pictorial symbol part of Apple's construction in
12 District Court litigation. So, and we make this argument in our brief, but if
13 you wanted to read our brief in the District Court litigation, it's at Exhibit
14 1040. And I'll jump to Apple's construction from the District Court
15 litigation real quick. Apple pulled their construction --

16 JUDGE SMITH: Which slide are you on?

17 MR. HUDNELL: I'm sorry, Slide 21. Apple's construction in the
18 District Court litigation came straight out of an IEEE dictionary, and they
19 argued that iPod should be construed as a symbol that is a pictorial
20 indication of a command. And if you read our brief in the District Court at
21 Exhibit 1040, we only had an issue with the indication of a command part of
22 Apple's construction. We never contested that an icon was a symbol that is
23 pictorial in nature. We've never said that. We never said in the District
24 Court. We've never even said that here.

25 And so, the notion that we were arguing that icon could include
26 text in the District Court is simply false. If Judge Albright had just chopped

1 off indication of command from Apple's construction and construed an icon
2 to be a pictorial symbol or something-- the first part of the language here,
3 that would have been it. That would have been the construction, because the
4 only part that we were challenging was an indication of the command. And
5 so, when Judge Albright determines that it's plain and ordinary meaning,
6 first of all, because there's no opinion, we don't know what he means by that,
7 but it could mean that he understands what an icon is, that it is a picture, and
8 he was not accepting Apple's construction.

9 JUDGE MURPHY: Yeah, but that's speculation. That's --

10 MR. HUDNELL: It is speculation, but it's --

11 JUDGE MURPHY: That's why I'm asking if there's opinion.

12 You're --

13 MR. HUDNELL: There's not.

14 JUDGE MURPHY: -- saying there's no opinion. There's nothing.

15 MR. HUDNELL: There's not.

16 JUDGE MURPHY: So, that's an argument we can't consider.

17 MR. HUDNELL: But to take Apple's point of view of this, it's
18 also speculation that the plain and ordinary meaning of icon includes text --

19 JUDGE MURPHY: It's not --

20 MR. HUDNELL: -- under Judge Albright's construction. I'm
21 sorry?

22 JUDGE SMITH: Claim 20, literally -- this is Claim 20.

23 MR. HUDNELL: Yeah.

24 JUDGE SMITH: The apparatus according to Claim 1, wherein the
25 icons comprise textual elements. That's Claim 20. Claim 20 literally says
26 icons comprise textual elements.

1 MR. HUDNELL: Yes. And I'm --

2 JUDGE SMITH: That's what it says.

3 MR. HUDNELL: And I want to go to Claim 20.

4 JUDGE SMITH: Okay.

5 MR. HUDNELL: Yes.

6 JUDGE SMITH: Okay.

7 MR. HUDNELL: So, and in fact --

8 JUDGE SMITH: What slide are you on now?

9 MR. HUDNELL: This is from Petitioner's --

10 JUDGE SMITH: Okay.

11 MR. HUDNELL: -- demonstratives, DX-23.

12 JUDGE SMITH: Okay.

13 MR. HUDNELL: You are correct that icons comprise textual
14 elements. That's what Claim 20 says, but what we submit that that means is
15 that you have an icon that has text in it. It makes no sense to say if icon can
16 be text, it would make no sense for Claim 20 to say, wherein text comprises
17 textual elements. Similarly, with respect to Claim 19, if an icon could just
18 be text, it would make no sense to say, wherein the text comprises local
19 types, graphic marks, or semigraphic marks. The point is, is that an icon --

20 JUDGE SMITH: According to who? When you say it doesn't
21 make sense, it doesn't make sense according to who? You?

22 MR. HUDNELL: That's our argument, Your Honor.

23 JUDGE SMITH: According to you, okay.

24 MR. HUDNELL: Yes, that's our argument. And then --

25 JUDGE SMITH: There's no expert testimony on whether it would
26 make sense to one of ordinary skill in the art for an icon to be text?

1 MR. HUDNELL: I would have to -- I believe I might have asked
2 Petitioner's declarant in this case that in his deposition. I'll check it when I
3 sit down.

4 JUDGE SMITH: Okay.

5 MR. HUDNELL: But if I can find that, I'll cite it to you. But I
6 don't have that cite right off the top of my head.

7 JUDGE MURPHY: Well, DX-22, which is Petitioner's
8 Demonstrative 22 --

9 MR. HUDNELL: Yes.

10 JUDGE MURPHY: -- suggests there's no extrinsic evidence
11 regarding that term's meaning, at least according to Patent Owner.

12 MR. HUDNELL: I don't know that I agree with that, Your Honor.
13 I mean, this is a --

14 JUDGE MURPHY: Now's the time to tell us.

15 MR. HUDNELL: Right, and that's what I'm saying. On DX-22,
16 you have their cite of our expert's testimony. My response was, I believe I
17 might have asked Petitioner's expert this same question. I just don't have the
18 cite off the top of my head. So, if I can find it at the break, I'll cite it to you.
19 If not, then I'll confirm that I don't have it.

20 JUDGE MURPHY: Okay, thank you.

21 JUDGE BRADEN: And Counselor, looking --

22 MR. HUDNELL: Yes.

23 JUDGE BRADEN: -- at Petitioner's Slide DX-20, it references
24 Patent Owner's infringement allegations, which are Exhibit 1059.

25 JUDGE SMITH: Yes.

26 JUDGE BRADEN: Page 14 of that exhibit, where it specifically

1 denotes a direct access icon that is complete text, and where it appears as
2 though Patent Owner is saying that complete text is an icon. Is that correct?
3 How else are we supposed to read that?

4 MR. HUDNELL: Several points about DX-20, Your Honor. First,
5 PO's June 3rd, 2024 infringement allegations. This is not our -- to clarify
6 what this means, June 3rd is when we filed the District Court litigation. So,
7 Exhibit 1059 comes from our complaint. This is not from our infringement
8 contention. So, I just want to make that first point clear.

9 The second point is, Your Honor, in this exhibit, in this document,
10 in our complaint, we never proposed a claim construction. There's no
11 construction that says icon means this, and therefore what we're pointing to
12 satisfies the definition of icon. In fact, you won't find that in any of our
13 infringement contentions in this case.

14 JUDGE BRADEN: Does this document, Exhibit 1059, indicate
15 that this textual -- that this text line, which says something about while using
16 app, is a direct access icon and therefore infringes the claims?

17 MR. HUDNELL: The third thing I was going to say, Your Honor,
18 directly to that question, is I can't see on this exhibit if this line is surrounded
19 by a box, because if it is, then that may be the reason why it's being called an
20 icon here. I can't see it from this slide. There's other information here that
21 could be considered part of an icon. So, I can't tell from this, just this image
22 here.

23 JUDGE SMITH: What other information is in this figure that
24 could be considered?

25 MR. HUDNELL: Well, it's not only could that text be in a box,
26 there's a box around the entire thing, Your Honor.

1 JUDGE SMITH: So, icon is a box? Icon requires box?

2 MR. HUDNELL: I was going to --

3 JUDGE SMITH: Why are you bringing in box?

4 MR. HUDNELL: Because I was going to try to tie that point back
5 to the Claim 20 point. So, let me just switch slides here for a second. The
6 reason why the box is significant is because in Figure 1, each of the icons is
7 surrounded by a box. And why this would satisfy Claim 20 is because the
8 icon is the oval shape that has text in it. So, an icon comprising textual
9 elements is exactly what's shown in Figure 1 on Slide 3. Similarly, if we
10 look at the cover page of our presentation, and this is in the record, this is an
11 image, an early image, of the inventor's design.

12 You can see that all the boxes here have circles around them and
13 there's text in the middle. So, these would satisfy what Claim 20 calls an
14 icon with comprising textual elements. You don't have a graphic, but you
15 have a circle -- an oval around the text. So, that's an icon comprising textual
16 elements. That's what we think an icon is. It requires some sort of graphical
17 pictorial symbol to indicate that it's actually an icon and not just text.

18 JUDGE SMITH: Why can't the symbol be -- I still don't
19 understand why the symbol can't be the text itself, if it's clear that if you
20 click on the text, it links to a website.

21 MR. HUDNELL: Because that's --

22 JUDGE SMITH: For example, if the text is blue -- if all the text is
23 black, except you see this word that's blue, I mean, that would meet your
24 definition of what you said an icon is.

25 MR. HUDNELL: I think that goes to the point that we were trying
26 to make about the extrinsic record, Your Honor. Here on Slide 18, every

1 definition of icon presented by the Patent Owner and the Petitioner in the
2 District Court litigation requires some sort of graphical element, picture,
3 graphic. It cannot just be -- there's no definition of icon in any of these
4 dictionaries that says it's just plain text.

5 JUDGE SMITH: I'm with you, I'm with you. When I looked at
6 this, I thought this was a good point, that the ordinary meaning of icon is
7 what you have here, some kind of picture. But then you have Claim 20. I
8 mean, Claim 20 throws all of this out the window. We don't even get to the
9 dictionary definition if the intrinsic evidence itself is enough. So, we have
10 this intrinsic evidence in the claims. We don't even get to the spec. The
11 claim itself says icon comprises textual elements. So, all of this goes out
12 -- all of these dictionary definitions go out the window.

13 MR. HUDNELL: Understood, Your Honor, and I understand your
14 point. Like I said, our argument is that comprising textual elements means
15 that you have an icon, something that is pictorial that has text written on it.
16 That's what we submit.

17 JUDGE MURPHY: Counsel, what about Figure 2 in the '058
18 patent? Figure 2 seems to have a series of alphanumeric text icons, and
19 there's no oval or anything else. There's just a patent drawing box around
20 multiple icons.

21 MR. HUDNELL: The answer to that question, Your Honor, is
22 Figure 2 is depicting something slightly different. And if you look at the
23 description of Figure 2 in column 3, Line 50, 51 says, Figure 2 features the
24 mechanism for accessing on a tree mode the address of search information
25 implemented in the method according to the invention. And so, what we
26 submit, Your Honor, is Figure 2 is merely just showing the tree structure.

1 The icons are still -- it's not like the patent says in Figure 1 you have icons
2 with graphics, and then in Figure 2 you have icons without graphics. The
3 patent consistently refers to all those symbols in Figure 2 as icons. The fact
4 that it doesn't have a box in Figure 2 is not evidence that it's not an icon. It's
5 just that Figure 2 is just picking something different, but all the text
6 throughout the entire patent consistently refers to those designations, AD,
7 TH, SH, ST, excuse me, as icons.

8 JUDGE MURPHY: Yes.

9 MR. HUDNELL: So, we don't think that Figure 2 changes
10 anything.

11 JUDGE MURPHY: Well, the Figure 2 description is referring to
12 text elements as icons.

13 MR. HUDNELL: But it never calls those elements -- it never says
14 that those elements are text. It says that they are icons.

15 JUDGE MURPHY: Right.

16 MR. HUDNELL: Yes.

17 JUDGE MURPHY: I guess that's the point.

18 MR. HUDNELL: That's the point. And there's no definition either
19 in the patent or in the intrinsic record where an icon is text. So, a person of
20 ordinary skill in the art looking at Figure 2 would understand that those are
21 icons, that they have some sort of graphical, pictorial, symbolic element.

22 JUDGE MURPHY: That's not shown in the figure.

23 MR. HUDNELL: Because the figure is showing the tree structure
24 and not how the icons actually appear on the screen of the selection page.

25 JUDGE MURPHY: Okay.

26 JUDGE SMITH: Let me ask you this.

1 MR. HUDNELL: Yes.

2 JUDGE SMITH: I'm looking at your Sur-Reply on page three.
3 I'm just going to read you.

4 MR. HUDNELL: Sur-Reply.

5 JUDGE SMITH: That first full paragraph under Section B, claim
6 differentiation confirms Patent Owner's construction. I just want to get your
7 take on that. The last sentence of that first paragraph under Section B: "An
8 icon comprising textual elements—a stylized word, a word within a bounded
9 control—satisfies claim 20 without being bare text. . . . A stylized word is
10 still a 'textual element.'" So, you're saying here that a stylized word is an
11 icon comprising textual elements. Is that right?

12 MR. HUDNELL: An icon?

13 JUDGE SMITH: The last sentence on that first -- do you see that
14 last sentence?

15 MR. HUDNELL: Yeah, I see it. An icon comprising textual
16 elements, a stylized word, a word within bounded control, satisfies Claim 20
17 without being bare text. So, what it's saying is, in the box that I showed you
18 here, you have a bounded word because there's an oval around the text, but
19 it's also saying that that text in the icon could be stylized. I think that's what
20 we're saying here, Your Honor.

21 JUDGE SMITH: I mean, isn't all text stylized, at least in terms of
22 font size and font type? Doesn't all text get styled?

23 MR. HUDNELL: I would assume so. I'm not a text expert, but the
24 point is that the icon comprises that. It's not is that. Petitioner wants to say
25 that the icon is text. The claim says an icon comprises textual elements, and
26 what we're saying here is that textual elements could be a stylized word, a

1 script word, but you still have to have an icon.

2 JUDGE SMITH: The bounded control features, that is the thing
3 that separates it from just the text?

4 MR. HUDNELL: Correct.

5 JUDGE SMITH: So, why couldn't a word that is attached to a
6 hyperlink --why isn't that a bounded control? The word itself is the bounded
7 control.

8 MR. HUDNELL: I think this is a -- let me -- if I could jump back
9 to Petitioner's deck for just one second on this point, it's this slide here. This
10 is DX-14. So, Petitioner cites against us at the dot that's next to the March
11 2025 date -- the testimony of our expert about whether a hyperlink could be
12 an icon, and he says at least some of the hyperlinks that are displayed within
13 web pages could accurately be characterized as icons.

14 And so, I think what he's saying here, Your Honor, is exactly your
15 point. It depends on what it looks like. Maybe it's just text, maybe it's an
16 icon, but he did not say that all hyperlinks are icons. He said that some. So,
17 again, what that means is you have to look at the hyperlink and determine,
18 does this fit the definition of icon or does it not?

19 So, jumping back into Patent Owner's presentation and looking at
20 Slide -- where'd it go -- Slide 16. There is some disclosure in the
21 specification. That suggests that the icons do require graphics. And it's this
22 part that we've quoted here from column 2, lines 41 through 44, where it
23 says that the selection icons prefer to include an item or thematic title,
24 opening and access to a page dedicated to a given activity or theme, and
25 present graphic features that are distinctive from those of the direct access
26 icons.

1 And so, I think a fair reading of this is that both the selection icons,
2 the red circles that I showed you on Slide 3, and the blue circles that I
3 showed you on Slide 3, they have graphic features, but they have to be
4 distinct. I think that this part of the specification supports the theory that all
5 the icons in this disclosure specification have a graphical element.

6 On Slide 21, I touch on, again, the point that I started with, was
7 that Apple's construction -- that Apple was actually advocating a
8 construction of icon in the District Court of a symbol that is a pictorial
9 indication of a command. So, even Apple agreed at that point in time that
10 based on the intrinsic record, and all the extrinsic evidence that they cited,
11 that an icon required a symbol or pictorial element. And again, the only part
12 that we challenged was that it had to be an indication of a command.

13 JUDGE SMITH: What do you say about their arguments now that
14 the examiner construed the scope of icon to encompass text with a
15 hyperlink?

16 MR. HUDNELL: Yes, Your Honor, I think -- and I think you
17 already addressed this point. We don't think that the examiner's
18 interpretation controls the Patent Owner, never conceded to that, never
19 affirmatively adopted that interpretation. We think the law is --

20 JUDGE SMITH: You never adopted it, but one thing I'm not clear
21 of, and maybe you could clear this up for me -- it's not clear to me that -- it
22 looked like there was an appeal brief filed, but it didn't go to appeal. It was
23 pulled back from appeal during prosecution. I'm just doing this off the top
24 of my head, so forgive me if I get -- but long story short --

25 MR. HUDNELL: Um-hum.

26 JUDGE SMITH: -- the examiner kept saying that the text

1 connected to a hyperlink is an icon. Appellant, or Applicant kept saying no,
2 and then eventually the case got allowed. Did the case get allowed because
3 the examiner changed his mind and said, you're right, the text with the
4 hyperlink is not an icon, or did it get allowed because the Applicant
5 amended the claim and included a limitation that the examiner found
6 allowable?

7 MR. HUDNELL: I'm not sure the answer to that question, Your
8 Honor, and I'm not sure which prosecution that appeal brief --

9 JUDGE SMITH: Well, just the prosecution of this case that led to
10 an allowance. Was it allowed by responding to the examiner saying, no, Mr.
11 or Ms. Examiner, that this text with the hyperlink is not an icon, and the
12 examiner said, you're right, here's your patent, or did the Applicant actually
13 amend the claim and then the examiner said, okay, the claim is allowable?
14 Did you know which is it?

15 MR. HUDNELL: Yeah, I'm sorry, I don't know the answer to that,
16 Your Honor. But just to follow up on that point, it is not the case, and we
17 point this out in our Sur-Reply -- it's not the case that the Patent Owner
18 never challenged the equating of hyperlinks with icons. And here's some
19 text from the prosecute -- from part of the prosecution where the Applicant
20 explicitly said, therefore, one skilled in the art of information access would
21 not have found Logan -- in Logan any teaching for designing within the Iki
22 apparatus a plurality of selection pages containing icons and not hypertext or
23 HTML documents.

24 So, while Petitioner's argument has been that in every single
25 instance, Patent Owner never challenged the examiner's equating of
26 hypertext to an icon, it's not true because it did happen with respect to this

1 reference Logan here. And I was looking at Slide --

2 JUDGE SMITH: I understand, I understand.

3 MR. HUDNELL: -- Slide 24.

4 JUDGE SMITH: I understand. I'm sorry, which slide?

5 MR. HUDNELL: Slide 24. Yes.

6 JUDGE SMITH: I understand that Applicant disputed this point
7 with the examiner, but I mean, if -- and I'll have -- and maybe on your
8 rebuttal, you could tell me if -- it would be more persuasive if the examiner
9 agreed with the Applicant and allowed it versus Applicant said, okay, I don't
10 want to fight this anymore, and amended the claim and then the examiner
11 -- I mean, if -- because Applicant had the appeal route available. If
12 Applicant really felt strongly about it, they could appeal, but if they just
13 decided to not fight the examiner anymore on this point, then the fact that
14 they argued about it is less persuasive. So, if you could let me know --

15 MR. HUDNELL: I'll see if I can find it, Your Honor.

16 JUDGE SMITH: Okay.

17 MR. HUDNELL: Yes. So, then that brings us to Rossmann,
18 which Patent Owner submits does not disclose icons. Assuming icon is
19 construed to mean requires some graphical element, I think what's
20 significant about Rossmann is that the menu items that you see here in
21 Figures 4 -- and I'm on Slide 26 -- that you see in Figure 4C, 4D, and 4E,
22 Rossmann calls these items 1, 2, 3, and 4 menu items.

23 But then when Rossmann talks about the up-down arrows that you
24 see in that figure, and the support here is on Slide 27, column 10, lines 10
25 through 23 of Rossmann. And then also -- yeah, sorry, just that one
26 reference here. In that text, Rossmann calls the arrow pointing to the right

1 and the up-down arrow icons. It doesn't -- he doesn't call the menu items
2 which are just plain text icons. We think that is significant evidence to show
3 that the menu items in Rossmann are icons. And similarly, Himmel doesn't
4 change that because Himmel merely adds text-based hyperlinks to
5 Rossmann with no pictorial element, and therefore -- and this is, I'm sorry,
6 Slide 29 -- and therefore, the combination of Himmel and Rossmann doesn't
7 disclose icons.

8 JUDGE SMITH: I thought Petitioner said that if we adopt your
9 construction of icon, Himmel does have icon under your construction.

10 MR. HUDNELL: Himmel has icons associated with -- and I'm
11 going to point you to the specific part of Himmel that Petitioner was looking
12 at. So, Petitioner draws on Figure 15 of Himmel, and what they point to are
13 icons that first, they point to a series of icons near the top of the figure.
14 There's no discussion in the specification about Rossmann, what these
15 actually lead to. And so, what they're saying is, well, if you take the icon
16 from here, there's one that looks like a Netscape Navigator icon next to
17 internet, and if you graph that over to the Himmel hot list, you have a direct
18 access icon, but there's no disclosure that says that you can do that. In fact,
19 even item 551 of Himmel, which is the dropdown hot list, there's no
20 disclosure about what's in that either.

21 The text is actually very confusing on this point because it lists
22 certain items, 552, 553, 554 as being part of this 551 drop down, but those
23 items aren't even listed in the figure. And so, now we're taking an item that's
24 not even designated in the Figure 15 and saying we can take that icon and
25 add it to a group of bookmarks at 551, and that that is a disclosure of an
26 icon. We just think that the disclosure here in Rossmann fails for that

1 reason. So, yes, they point to it, but we don't see how you get there based on
2 Rossmann's disclosure.

3 JUDGE SMITH: Okay.

4 MR. HUDNELL: So, now I want to move on to beforehand
5 locally stored -- that term. And we think the answer here is fairly
6 straightforward, Your Honors. In that based on the construction that you
7 adopted at the institution stage, Rossmann does not teach beforehand locally
8 stored. When Petitioner was presenting, they conceded that in this cache
9 case embodiment, which is now sort of the base of their theory, that the
10 search that the user of the Rossmann device would perform is a second
11 search. A second search, based on pages that came out of a first search is
12 not a preliminary search before those items were stored. It's not a search
13 before those -- the items were -- getting my directions confused here. Sorry,
14 Your Honors. That preliminary search did not happen before those items
15 -- those items were not stored before that search.

16 JUDGE MURPHY: Well, the theory is that when you do a first
17 preliminary search on the downloaded deck and then the search ends, the
18 same deck is still stored. You can come back and access it, and you go back
19 to Figure 4C in Rossmann to begin the same protocol of a "preliminary
20 search". So, why is that not consistent with our claim construction?

21 MR. HUDNELL: It's not consistent with the claim construction
22 because the items that were already in the cache had been the result of a
23 prior search. And so the second search is not -- the items are not beforehand
24 locally stored as to the second -- to the first search because the user had to
25 search to get those items in the cache in the first place. So, if you have a
26 first search and then you download the items and then the second search and

1 you access the same items, you do not have it beforehand locally stored
2 because you had to search using the first search to get those items that the
3 user is accessing on the second search.

4 JUDGE MURPHY: Is there something either in the specification
5 or the prosecution history that sheds light on that? I mean, essentially, that's
6 a limitation within this claim phrase, beforehand locally stored. And I can
7 see your point, and I can see Petitioner's point. And so, the question is,
8 what's the breadth of that phrase, right? I mean, doesn't it come down to
9 that?

10 MR. HUDNELL: That's right, Your Honor. And I think what we
11 think is probably the closest to what you're looking for is the sections of the
12 specification that we cite here on Slide 32. And in our Patent Owner's
13 preliminary response, when we argued for the construction of "beforehand
14 locally stored," we argued that this was what we called an implementation
15 step, meaning a setup step, that you had to have this information in the
16 device before anyone even comes along and touches the device.

17 Now, you agree with our construction. I don't know if you
18 accepted our underlying rationale, but we cited all these passages here in our
19 preliminary response to support that construction, meaning that those items
20 had to be there before the user came along and did his search.

21 JUDGE MURPHY: I can't read them and my screen went out.

22 MR. HUDNELL: Yeah.

23 JUDGE MURPHY: So, can you take me through those passages?

24 MR. HUDNELL: Sure, sure, Your Honor. So, the first one comes
25 from column 2, lines 58 to 64 of the '058 patent. It says, "Furthermore, is
26 particularly advantageous to plan in the welcome page icons for selecting a

1 consulting language among a plurality of proposed languages. For example,
2 under the form of flags for states wherein each proposed language is used.
3 For that, several sets of selection pages beforehand stored, each
4 corresponding to a proposed language, will be provided."

5 So, what it's saying here is that in order to set this system up for
6 people who speak different languages, you have to have built into the pages
7 the English language version, the French language version, the Spanish
8 language version. This just happens at the implementation. It's not I go out
9 to the internet like in Rossmann and then start downloading pages based on
10 the user's decision. The designer who set this system up had to actually
11 build this into the page itself.

12 The second passage comes from column 2, lines 24 through 29. It
13 says, "Thus, by locally implementing preliminary selection steps and pages
14 organized in a tree manner and operating as rolling menus, and by finally
15 emitting on the internet only a complete address" -- it goes on, but the point
16 is, is that it's talking about -- again, it references implementing.

17 Implementing these pages at the beginning before the user even gets --

18 JUDGE MURPHY: What you're saying is it has to be done before
19 the very first search?

20 MR. HUDNELL: I think that that's what these passages from the
21 specification suggest, Your Honor. Exactly. One other thing that's not cited
22 here that I think is pretty significant is from the '058 patent. This is column
23 4, lines 5 -- line 4 through 8. It says --

24 JUDGE MURPHY: Wait.

25 MR. HUDNELL: The --

26 JUDGE MURPHY: I'm sorry, give me that cite again.

1 MR. HUDNELL: Yeah, sure. Column 4, lines 4 through 8. It
2 says, this first page, P0, constitutes the trunk of a tree structure schematically
3 presented in Figure 2 for the whole screen pages locally stored in a storage
4 unit. For example, a hard disk unit or a CD-ROM of the apparatus, wherein
5 the method is implemented. Okay, hard disks and CD-ROM. This is non-
6 volatile memory. This gives the notion that these pages are stored in the
7 device. If you look at the disclosure --

8 JUDGE MURPHY: Oh, they're pre-stored.

9 MR. HUDNELL: Pre-stored in the device.

10 JUDGE MURPHY: Right?

11 MR. HUDNELL: Correct. If you look at the disclosure in
12 Rossmann, and particularly in this cache embodiment, it talks about storing
13 pages in RAM memory, random access memory, volatile memory, meaning
14 this is going to change over time. So, there's a clear distinction between how
15 those pages are stored in Rossmann versus what the Patent Owner is
16 suggesting how his pages should be stored in the '058 patent.

17 JUDGE SMITH: But that's not in the claim.

18 MR. HUDNELL: I agree it's not in the claim, but you have to read
19 the claims in light of the specification. And the question was, is there
20 anything in the specification that would suggest that these pages exist before
21 the --

22 JUDGE SMITH: Well, I thought -- it's been a while since I've read
23 the DI, but I thought we did address this in the DI. We said the claim
24 doesn't require -- the claim encompasses this nonvolatile memory, but it
25 doesn't require this nonvolatile memory. I thought we already addressed
26 that, but to your point about reading the claim in light of the spec, the section

1 that you're citing says, "for example, a hard disk unit" --

2 MR. HUDNELL: Right.

3 JUDGE SMITH: -- "or a CD-ROM." It doesn't say it requires
4 non-volatile. It's just listing an example as to what --

5 MR. HUDNELL: I'm just saying it's evidence that what the
6 applicant was thinking of was pre-storing these pages at the implementation
7 stage.

8 JUDGE MURPHY: Right, but I mean, the concept behind the
9 invention is efficiency, right? To reduce latency, make searching more
10 efficient, not requiring multiple internet access links, et cetera, to make it
11 easier for a user. Why doesn't the theory that Petitioner presented in the
12 reply, in response to our claim construction, satisfy that same goal?

13 In other words, it's now been stored, granted, after a first search, if
14 you will. The search is over, the user comes back sometime later, searches
15 again, it's already before that search, it's locally stored, and they go through
16 that preliminary protocol before they have to access the internet through a
17 direct access icon or what have you. Why isn't that consistent with our
18 claim construction? I mean, because the spec is exemplary. And so, you get
19 this notion of where's the line between improperly reading a preferred
20 embodiment that's not in the claim language --

21 MR. HUDNELL: Yeah.

22 JUDGE MURPHY: -- and trying to give life meaning to the claim
23 language based on the specification?

24 MR. HUDNELL: I think the straightforward answer, Your Honor,
25 is that the claim requires that the preliminary search, that the selection pages
26 have to be beforehand stored before the preliminary search. And in

1 Petitioner's theory, they're not.

2 JUDGE MURPHY: But it comes down to what's a preliminary
3 search. Petitioner's saying it's still a preliminary search for the next search,
4 because they can follow the same protocol and get the same efficiency of not
5 having to go to the internet --

6 JUDGE SMITH: Well --

7 JUDGE MURPHY: -- as I understand it.

8 JUDGE SMITH: Well, what's a preliminary search? Why don't
9 we start with that? What would that -- because Petitioner told us his
10 construction of preliminary search. He said it's when you get -- when you
11 do all that clicking to get down to XYZ information, that's the preliminary
12 search. What is the preliminary search? You know, looking at Rossmann,
13 those Figures 4A through 4G or whatever it is, what's the preliminary search
14 in these figures in Rossmann?

15 MR. HUDNELL: Well, Petitioner says the preliminary search is at
16 the beginning at 4C, where the user selects -- and this is our slide, Patent
17 Owner's Slide 25, where the user selects item 2, menu item 2, XYZ
18 information. They say that is the start of the preliminary search, and then
19 you --

20 JUDGE SMITH: That's the end of the preliminary search.

21 MR. HUDNELL: -- flow on from there. I'm sorry?

22 JUDGE SMITH: I thought that was the end of the -- is that the --

23 MR. HUDNELL: That is the beginning of the preliminary search.

24 JUDGE SMITH: Okay.

25 MR. HUDNELL: Right?

26 JUDGE SMITH: Okay.

1 MR. HUDNELL: And so the reason that you all found that this
2 did not satisfy the claim is because the decks that get stored do not get stored
3 before that search begins. Now what they're saying, well, let's just do it
4 twice. Let's start at Figure 4C and do a search and then wait a minute, five
5 minutes, 10 minutes, 24 hours, whatever the case may be, and come back
6 and do the search again. Well, now the deck is stored. It's beforehand
7 locally stored, but it's not because the preliminary search was the first
8 search, not the second search. I think that's the answer to the question.

9 JUDGE SMITH: But the claim says a preliminary search, which, I
10 mean, there could be more than one preliminary. You could have first
11 preliminary search, which is part of the first search. And then after you're
12 done with that, you could come back and do a second search that has a
13 second preliminary search.

14 MR. HUDNELL: Right. And I think the difference between the
15 '058 and Rossmann, like if I jump to the '058 picture here, Figure 1, Slide
16 15. The '058, it doesn't matter when you do that search. Doesn't matter
17 whether you do one, two, three, four, five infinite preliminary searches. The
18 selection pages are already there, no matter when you start. With Rossmann,
19 you have to have that first search to get the deck into the device.

20 JUDGE SMITH: I think we all agree with you on that. Well, I'll
21 speak for myself. I agree with you on that. I think even Petitioner, but I'll
22 speak for myself. That's true. The question that I'm struggling with is how
23 is that reflected in the claim? That it doesn't matter how many searches you
24 do or where you start or when you start.

25 MR. HUDNELL: Well --

26 JUDGE SMITH: This system doesn't need to download whatever

1 it is, the selection pages. Is that what it's --

2 MR. HUDNELL: Yeah, selection pages.

3 JUDGE SMITH: It doesn't need to download the selection pages.
4 How is that reflected in the claim?

5 MR. HUDNELL: Well, I think the -- you're right, the claim says a
6 preliminary search. And so as I said, whether you do that search once,
7 twice, three times, no matter what, with the '058 patent, the decks are
8 already there. The difference with Rossmann is you have a -- if I were to
9 write the claim, it would say a first preliminary search and a second
10 preliminary search. And so, because you have -- because what they're
11 pointing to is that the second preliminary search is the first preliminary
12 search, and it's not because the decks exist in Rossmann because of the first
13 preliminary search, not the second preliminary search.

14 JUDGE SMITH: In terms of technology, what's the technological
15 difference between having -- the '058 patent has this stored in memory
16 before -- as you say, before any search, and then versus in Rossmann, there
17 has to be a first search, but then after the first search is done, for the second
18 search in Rossmann -- doing a second search in Rossmann and doing a
19 second search using the '058 patent technology, what's the technological
20 difference between those two searches?

21 MR. HUDNELL: Well, I don't profess to be an expert in the
22 technology, but to answer your question, I think that the '058 design further
23 reduces -- you mentioned the goal here. The '058 design further reduces
24 those calls to the internet because all the pages are pre-stored. In Rossmann,
25 if I have to do a first preliminary search to get decks into the device and then
26 do a second preliminary search to get decks into the device, and then maybe

1 I want to come back and do a third preliminary search, well, now I've got
2 two sets of decks in the device. And every search that I do after that, I keep
3 accumulating decks into the device. That is -- I think that is technically
4 different than having all those decks beforehand locally stored before any
5 search takes place.

6 JUDGE MURPHY: Okay. You're saying we should read the
7 claim as requiring pre-storage period before any search -- before the very
8 first search?

9 MR. HUDNELL: I think that the decks have to be present before
10 the first search. Yes. Now, granted, the '058, there is some disclosure and
11 Patent -- sorry, Petitioner pointed this out that the user can go ahead and in
12 order to update the decks, there can be downloading and customizing and
13 setting those decks in place. That does happen. The '058 patent does
14 discuss that, but then once it's actually in use, all the decks are present.
15 Excuse me, all these selection pages are present.

16 JUDGE SMITH: So, how's that different than what Rossmann
17 does?

18 MR. HUDNELL: Well, because Rossmann is hitting the internet
19 every time for those to create what the '058 already has.

20 JUDGE SMITH: Only --

21 MR. HUDNELL: I'm sorry?

22 JUDGE SMITH: Only if it doesn't have it.

23 MR. HUDNELL: Correct.

24 JUDGE SMITH: So, the '058 patent, if it needs to update, it goes
25 to the internet and updates?

26 MR. HUDNELL: No, no, no, no. I wasn't saying that. What I

1 was saying is that -- I'll find the exact passage. Thought I had it highlighted,
2 but let me just -- give me a second.

3 JUDGE SMITH: That's okay. You're well into your rebuttal time.
4 I just want --

5 MR. HUDNELL: Yeah, let me --

6 JUDGE SMITH: If you want to -- yeah.

7 MR. HUDNELL: I'll find it for you.

8 JUDGE SMITH: Yeah.

9 MR. HUDNELL: I'll find it for you.

10 JUDGE SMITH: Okay.

11 MR. HUDNELL: Yeah, I see I am well into my rebuttal time. I
12 think that I've -- just want to make sure I've hit everything I wanted to say
13 about beforehand locally stored and icon. Yeah, I'll --

14 JUDGE SMITH: Real briefly, could you -- real briefly, the
15 -- maybe in a couple of sentences, the specifically designed, could you tell
16 us what your contention is for specifically designed? Why the cited art
17 doesn't have it?

18 MR. HUDNELL: So, briefly, Your Honor, specifically designed
19 to include -- what we're saying that means is that it's not that the device is
20 capable of doing these things. It has to be set up to have selection icons,
21 direct access icons within the construct of a selection page. Why we
22 distinguish from what the Patent Owner -- I'm sorry, I keep calling them
23 Patent Owner -- the Petitioner is arguing is that their specifically designed
24 means specifically designed on the fly. Meaning if I go to Rossmann -- if
25 we go back real quick to Slide 25 -- if I go to Rossmann and I select XYZ
26 information, well, now I'm obtaining the deck related to XYZ information.

1 I'm storing it in my device, and now the device is specifically designed to
2 include that.

3 But if I select item number three, financial info, that's a different
4 whole different set of decks that I'm downloading to the device. And so,
5 what is specifically designed to include these selection pages, it's not
6 specifically designed to include these selection pages because it's based on
7 the user selection of the decks that it selects. Whereas in the '058 patent, as I
8 mentioned a few minutes ago, all the decks are already preexisting.

9 JUDGE SMITH: Okay.

10 MR. HUDNELL: I think that's --

11 JUDGE SMITH: Okay.

12 MR. HUDNELL: -- the distinction.

13 JUDGE SMITH: And then one last thing, maybe.

14 MR. HUDNELL: Sure.

15 JUDGE SMITH: Could you point to us where you, in your Patent
16 Owner response, contested Ground 3?

17 MR. HUDNELL: Yes, it is on -- it's in paper 35, page 18, and
18 bottom of 18. Running to the top of 19.

19 JUDGE SMITH: Okay, thank you.

20 MR. HUDNELL: Thank you, Your Honors.

21 JUDGE SMITH: Okay, you may begin when ready.

22 MR. HART: All right. Thanks very much, Your Honor. I want to
23 start on icon. I think it's important to go back and look at the sequence of
24 events and what actually happened in the Markman proceeding. As Judge
25 Murphy has acknowledged, the lower -- the record from the District Court is
26 not a model of clarity, but there are a few important items we can draw out

1 of that record. The first is that Apple's proposed construction excluded text
2 links as icons.

3 Patent Owner fought against that construction. Patent Owner
4 never conceded in the District Court that it was proper to exclude text links,
5 and in fact, it could not have made that argument because at the time it was
6 alleging that basic text links with no graphical components infringed the
7 icon terms in the asserted claims. Judge Braden asked Patent Owner
8 whether they had in fact accused basic text links with no graphical
9 components of infringing the icon terms. He said he wasn't sure. He should
10 know.

11 We've looked at the record. There are a number of examples
12 where Patent Owner alleged infringement pointing to basic text with no
13 graphical components. That's his case. They alleged infringement. They
14 did not dispute that point during Markman. They wanted the broadest
15 construction they could get during Markman, and they got it. So, Apple
16 made an attempt to exclude text links. Apple lost.

17 Apple presented the District Court the same extrinsic evidence that
18 Patent Owner is presenting you, the Board, the pictorial symbol indicating a
19 command. That was Apple's construction. It was based in part on those
20 same dictionary definitions, the IEEE dictionary definitions. The District
21 Court rejected that. So, Apple was trying to get the District Court to exclude
22 text links. Apple failed. Now Apple has stipulated that it will not argue
23 again that text links are excluded.

24 JUDGE MURPHY: Okay.

25 MR. HART: So, we must adopt a broad interpretation that
26 captures text --

1 JUDGE SMITH: Well, I think --

2 JUDGE MURPHY: Well --

3 JUDGE SMITH: Oh. You can go.

4 JUDGE MURPHY: It's not that we must --

5 MR. HART: Sure.

6 JUDGE MURPHY: -- do anything. We are trying to decide the
7 issue. I would like you to address the two parts of the specification, Figure
8 2, and its representation of what it calls icons, and what Counsel for Patent
9 Owner pointed us to in the spec, which is the first sentence beginning at
10 Column 2, line 41.

11 MR. HART: Let me --

12 JUDGE MURPHY: The notion that the selection icons present
13 graphic features that are distinctive from those of the direct access icons.

14 JUDGE SMITH: Absolutely.

15 MR. HART: Let me start with that one since I have that up on the
16 screen.

17 JUDGE SMITH: Okay.

18 MR. HART: So, on the display, we have Column 2 from the '058
19 patent. Here, my highlighting is not working perfectly, but this is the
20 passage that you were directed to by Patent Owner. The selection icons
21 preferably include an item or thematic title opening an access page dedicated
22 to a given activity or theme -- nothing about graphics yet -- and present
23 graphic features that are distinctive from those of the direct access icons.

24 That is the only intrinsic evidence Patent Owner pointed you to, to
25 support construing just the term icon as requiring graphical components. If
26 we go down to the claims, Claim 12 is that language. So, dependent Claim

1 12, which I have highlighted here on the screen, recites the apparatus
2 according to Claim 1, wherein the selection icons present graphic features
3 that are distinctive from those of the direct access icons.

4 JUDGE SMITH: Right.

5 MR. HART: We concede that icons can include graphics. The
6 question for the Board is whether they must include graphics.

7 JUDGE MURPHY: So, it's the notion of claim differentiation
8 again, because Claim 12 is dependent on --

9 MR. HART: I think the Claim 12 question is very similar to the
10 Claim 19 and 20 questions that Judge Smith keeps raising. The icon must be
11 construed broadly. It can have text, it can have graphics. It doesn't mandate
12 graphics. That's the key point to take away here.

13 JUDGE SMITH: I think Patent Owner's point, as far as I
14 understand it, it's not that the icon excludes text. I think Patent Owner
15 agrees the icon can include text, but it has to include some boundary that can
16 be recognized by the user around the text. It can't just be text by itself.
17 There has to be text, along with some distinctive feature that sets that text
18 apart from the rest of the screen.

19 MR. HART: And I hope I'm characterizing your earlier statement
20 correctly, but I believe you suggested that if it's clear that the text is
21 selectable, that may be sufficient to deem that text an icon. And I think
22 that's exactly what we have in Rossmann. So, Rossmann, if I go to Slide 25
23 in Petitioner slides, so DX-25, and let me -- here we have the selection pages
24 in Rossmann. These are the pages that are displayed in response to a user
25 selecting XYZ information.

26 Rossmann is all about -- its entire graphic user interface is about

1 presenting the user selectable lines of text. It numbers those selectable lines
2 of text. It provides a caret indication of which one you're currently
3 selecting, so that when you click the soft button OK, you know which one
4 you have just selected. These are indicative of selectable text by the very
5 nature of Rossmann's design. So, these are not bare text where a user is
6 unaware that they're selectable.

7 The whole point of Rossmann's display, and the way these are laid
8 out and numbered is to indicate to the user what is selectable and what is
9 not. So, these are selectable text icons. They do indicate to the user that
10 they are selectable. So, under Judge Smith's suggestion that that may be
11 enough, I would agree that that is enough. And that's what we have in
12 Rossmann. Even if you require something more than bare text, something
13 that indicates that that text is selectable, we have that in Rossmann.

14 JUDGE SMITH: Okay.

15 MR. HART: I want to turn to -- let's see here, covered that. I want
16 to turn to the prosecution history again. We've talked about the fact that in
17 both the parent patent and in the '058 challenged patent, the examiner
18 asserted or mapped bare text links to icons over and over and over. Patent
19 Owner suggested there was pushback from the Applicant during those
20 processes -- I'm sorry, during those prosecution processes -- and specifically
21 suggested that there was pushback about whether bare text satisfied icon.
22 That is not a correct characterization of the record. The allowance did not
23 result from a distinction between icons and bare clickable text. The
24 allowance of the '058 patent resulted when the Applicant added, specifically
25 designed to include. That was the last back and forth in the negotiation
26 between the Applicant and the Patent Office. So, the Applicant added

1 specifically designed to include to secure allowance. They did not obtain
2 allowance by distinguishing bare text clickable items from the claimed
3 icons.

4 In Patent Owner's Slide 24, this was the back and forth related to
5 Logan and whether Logan's hypertext or HTML documents were icons.
6 This was discussed earlier in Patent Owner's presentation. If you read the
7 full context of this back and forth between the office, this is actually an
8 architectural distinction, not a distinction that distinguishes graphical icons
9 from text-based links. The hypertext or HTML documents fail to satisfy the
10 selection pages according to Patent Owner because they were not of the type
11 that would create the selection pages or the commands that the claims
12 require.

13 Recall these claims require specific architecture where a selection
14 page has to include specific icons -- a first selection page, a second selection
15 page, and a third selection page in the claims. Each one of those has
16 different requirements for the types of icons they contain. Selection icons
17 are icons you click to go between locally stored pages and direct access
18 icons take you to the internet. This was an architectural distinction
19 regarding Logan in this back and forth with the Patent Office. The Patent
20 Owner was not, or the Applicant at the time was not distinguishing bare text
21 from the claim icons, and certainly the Patent Office never accepted a
22 distinction of the sort. In --

23 JUDGE MURPHY: Counsel, I want to make sure you address the
24 application of Rossmann to the beforehand locally stored.

25 MR. HART: I absolutely will. I'm going to make one more point
26 on icon. So, this relates to the combination of Rossmann and Himmel.

1 JUDGE SMITH: What slide is that?

2 MR. HART: This is Slide 29 in the Patent Owner's presentation.
3 So, on this slide, Patent Owner suggested that the addition of Himmel to
4 Rossmann does not add graphics, and I believe Judge Smith pointed out that
5 we had, in fact, advanced a theory where Himmel's graphics would be added
6 to Rossmann satisfying even Patent Owner's interpretation of icon, and that's
7 exactly right. And I will take you to DX-26 and DX-27 in the Petitioner's
8 presentation.

9 So, as we've talked about, some of the dependent claims have more
10 specific requirements of those icons. Claims 12 and 19 specifically require
11 graphics of some sort. We did advance a theory in the petition that
12 Rossmann's text-based icons would be modified pursuant to Himmel to
13 include graphics. So, that was in our petition. That theory applies to all the
14 claims. The claims all require icons. That theory, the motivation to make
15 that modification, applies to all challenged claims equally, as it does to
16 Claims 12 and 19. So, this is not new art. This is not a new theory. The full
17 motivation was included in our petition. And I would point out that neither
18 Patent Owner, nor Patent Owner's expert ever pushed back on this theory for
19 Claims 12 and 19, that a POSITA would have been motivated to make
20 Rossmann's text links graphical in nature based on the teachings of Himmel.

21 If we go to DX-27, importantly, Patent Owner in its surreply
22 addresses this argument. It does not push back on the technical feasibility or
23 capability of Rossmann accepting graphical links. That is something that is
24 largely settled on this record. Rossmann is capable of displaying graphics.
25 In fact, Rossmann's opening page includes graphics. Rossmann has arrows
26 that indicate various things on all of its pages. So, Rossmann is capable of

1 including graphics. The argument that Patent Owner advances in its Sur-
2 Reply, as we have here on DX-27, they allege that the Petitioner failed to
3 substantiate that motivation -- or I'm sorry, that combination with a
4 motivation to make the combination.

5 And that's simply not true. Here, Dr. Bederson regarding Claim 12
6 in his opening declaration, Exhibit 1003, paragraph 162, explained the
7 justifications, the reasons why one of skill in the art would be motivated to
8 make those text links in Rossmann graphical in nature. So, this theory
9 applies to all claims and satisfies even Patent Owner's interpretation of icon,
10 which would require some graphical component.

11 And with that, let me turn to "beforehand locally stored." Patent
12 Owner, especially toward the end, suggested that beforehand locally stored
13 requires selection pages that preexist on the device before there's any
14 interaction with the device. Your Honors asked all the questions I would
15 have asked, so I want to reiterate a few important points here. That is not in
16 the claims. Patent Owner did not point the Board to any language in the
17 claims that requires this ultimate preexistence before a user has interacted.
18 The claims simply require that the selection pages exist in memory before
19 the preliminary search begins, which I covered in my opening remarks.

20 JUDGE SMITH: Well, it sounds like --

21 JUDGE MURPHY: But -- go ahead. Sorry.

22 JUDGE SMITH: It sounds like Patent Owner is saying that there's
23 only one preliminary search and then every search subsequent to that is not a
24 preliminary search.

25 MR. HART: That definition of preliminary search has not been
26 advanced in this case. It is not supported by the record, as the Board held,

1 and we are not disputing. A preliminary search begins when the user makes
2 that first selection. So, when that user selects XYZ information, that is the
3 start of a preliminary search, and that preliminary search continues through
4 until the user obtains the information that they are seeking. There is no
5 support in this record for saying that a device can conduct one and only one
6 preliminary search.

7 Under our theory, when that user conducts the first preliminary
8 search, gets the weather for Town A, and then hours later comes back and
9 says I'm curious about the weather in Town B, the deck preexists in memory
10 when they click XYZ information for that second time, for that subsequent
11 search. That deck is beforehand locally stored for that second preliminary
12 search.

13 JUDGE MURPHY: But why doesn't the specification, at least the
14 portions that Counsel pointed us to --

15 MR. HART: Yeah.

16 JUDGE MURPHY: Yeah, we're struggling with the notion of their
17 preferred embodiments -- pre-storage with a hard drive or CD-ROM or
18 something like that. That's not in the claim, but when you read the various
19 descriptions that we were pointed to, it at least suggests that there's this
20 notion of you have a base set of stored icons so that you can avoid having to
21 go to the internet multiple times, and you can perform that "preliminary
22 search." Would that exclude your theory, or why doesn't it exclude your
23 theory?

24 MR. HART: Sure. Interpreting the specification to suggest, it is
25 possible to have a device with concrete, permanent, pre-established selection
26 pages that never get adjusted based on user conduct, I think that is a fair

1 gleaning of an idea in the specification. That idea is not reflected in the
2 claims. As the Board has already analyzed, these claims cover what has to
3 happen when a preliminary search begins. There's no suggestion in the
4 claim, certainly, that these devices are limited to one and only one
5 preliminary search.

6 I have here on DX-35 Patent Owner's response at page 9 where
7 they explained Patent Owner's construction is fully consistent with a user
8 downloading, configuring, customizing selection pages and icons on the
9 device. This record demonstrates that these claims, these challenged claims,
10 are more flexible than the interpretation you heard from Patent Owner.
11 These claims should not be interpreted or construed to require a concrete and
12 static set of selection pages and icons that cannot be modified in response to
13 user actions.

14 That is the answer. The claims, whether the patent specification
15 itself may suggest the possibility of something much more limited does not
16 limit the scope of these claims, which even Patent Owner has admitted are
17 more flexible and allow for user customization, downloading, and
18 configuration.

19 JUDGE MURPHY: And would that include updating, as well?
20 Updating the --

21 MR. HART: Absolutely. And in fact, the dependent claims
22 require updating. If I take you to -- and I am running out of time, I do want
23 to leave at least 30 seconds for my colleague to address the --

24 JUDGE MURPHY: Well, take your time. You're trying to
25 identify some of the dependent claims for us on this point.

26 MR. HART: That's exactly right, Your Honor. Dependent Claim

1 7 is a good example. Apparatus, according to Claim 1, wherein said control
2 and processing device or devices are configured to receive from a server
3 data for updating information associated with at least one of a selection
4 page, a direct access icon and a selection icon. So, again, these claims
5 contemplate a customizable, a more liberal and flexible platform than what
6 Patent Owner suggested, which is a device that is never changed and comes
7 out of the factory --

8 JUDGE SMITH: So, with Claim 7 -- the scope of beforehand
9 locally stored under Claim 7, it seems the same as the cache case for
10 Rossmann. Is that right?

11 MR. HART: That the claims contemplate the possibility of storing
12 something and then coming back to it for an update?

13 JUDGE SMITH: That this contemplates getting this information
14 that you need from the internet and then coming back and doing the search.

15 MR. HART: And that was certainly part of the Board's analysis at
16 institution, particularly for the motivation to combine Himmel and
17 Rossmann. Himmel adds these kind of direct access icons, links out to the
18 internet to Rossmann's structure. But absolutely, Rossmann contemplates
19 this need to go out to the internet to get information, just like the '058 patent
20 does. This '058 patent, worth noting, is being asserted against iPhones, and
21 against things like Apple Music in iPhones, not things that are built-in,
22 permanent, and unmodifiable. And so, this very strict possible reading of
23 the '058 patent that was alluded to in Patent Owner's presentation directly
24 conflicts with how these claims have been asserted in the litigation.

25 JUDGE MURPHY: So, if I can summarize, your point is
26 permanent storage beforehand locally stored pages is not required. And

1 updating is permitted. It's in the dependent claim, or at least one dependent
2 Claim 7, and it's also described in the specification. I guess there's some
3 type of management server component that can update.

4 MR. HART: That's right, Your Honor.

5 JUDGE MURPHY: And then you're pointing us to Patent Owner's
6 response page -- was it 9?

7 JUDGE SMITH: Page 9, yeah.

8 MR. HART: Yes, sir.

9 JUDGE MURPHY: That you're suggesting is an admission
10 against interest.

11 MR. HART: That's exactly right. An admission against an
12 interpretation of the claims that would have required all of this to be pre-
13 built in, pre-established, and unrelated to any user conduct or pinging a
14 server communications. That's right.

15 JUDGE MURPHY: All right, thank you.

16 MR. HART: I know my colleague was looking up the search
17 engine item, so I'd like to let him just briefly --

18 JUDGE SMITH: That's fine.

19 MR. HART: -- provide a response on that.

20 MR. HORTON: Let's see if I can get this to show on the screen.
21 Do I need to click something to get that?

22 JUDGE SMITH: Yes.

23 MR. HORTON: Or do I just need to drag it? Well, I can do it
24 without it and just read it into the record. So, I have Patent Owner's
25 surreply, which should be paper 32, just for clarity of the record. Patent
26 Owner, I believe, pointed to the bottom of page 18 and the top of page 19,

1 which contains two sentences that purportedly address Ground 3. Looking
2 at those sentences, I'm not seeing an independent challenge to Adar's
3 teachings.

4 So, we relied on Adar's bookmark to Yahoo as teaching the search
5 engine icon. Those two sentences specifically reference the purported
6 deficiencies with the specifically designed to include language and the
7 claimed three-page architecture. So, there's no independent challenge that
8 Adar's bookmark to Yahoo satisfies the claims. Patent Owner appears to be
9 resting on the independent theories for the independent claims.

10 JUDGE MURPHY: Yeah. Counsel, can you just read that
11 sentence into the record from that?

12 MR. HORTON: Yes.

13 JUDGE MURPHY: Patent Owner's surreply. Was it bottom of
14 page 18?

15 MR. HORTON: Yes, that's correct. So, it says: "as for Ground 3,
16 adding Adar's bookmark to Yahoo inside Himmel's bookmark manager
17 supplies neither a selection page 'specifically designed' to include the search
18 engine icon, nor the claimed three-page architecture; the petition's Ground 3
19 analysis . . . never maps them, and the institution decision addressed only
20 motivation. . . . The fallback inherits every structural defect of the primary
21 theory."

22 JUDGE MURPHY: Thank you.

23 JUDGE SMITH: Okay, let's see. We gave Petitioners some extra
24 time, so I'll give you some extra time, too, if you need more time.

25 MR. HUDNELL: I'm not sure that I will, Your Honor, but --

26 JUDGE SMITH: Okay.

1 MR. HUDNELL: -- we'll see, depending on your --

2 JUDGE SMITH: We ask a lot of questions.

3 MR. HUDNELL: -- questions.

4 JUDGE SMITH: Yeah.

5 MR. HART: You may need to press the power button on the next
6 one.

7 MR. HUDNELL: All right.

8 MR. HART: Outside of the realm of my expertise.

9 MR. HUDNELL: It might be coming. There we go. Okay.

10 Okay. So, there were three points that I indicated I would get back to you
11 about, Your Honors. The first one, I think Petitioner already addressed,
12 which was about the prosecution history as it applied to icon. And I think
13 we generally agree with their assessment in the appeal. The ultimate
14 allowance was based on the addition of the specially designed limitation and
15 not directly weighted on the icon limitation. So, we would agree with that
16 description. So, that was the first point.

17 The second point -- well, I guess just sticking with icon, the second
18 point is I thought that I had asked Petitioner's declarant in his deposition
19 about Claim 20. I did ask him about Claim 20. That discussion begins
20 -- this is Exhibit -- sorry, this is -- yeah, Exhibit 2019 is his deposition
21 transcript. The discussion begins on page 56, line 22, but the specific text I
22 want to point you to is on page 57, lines 5 through 9. I asked him, okay
23 -- question, okay, "Is an icon comprising textual elements different than just
24 text?" Answer --

25 JUDGE SMITH: Sorry, could you just give me a second? What is
26 this that you're reading from?

1 MR. HUDNELL: This is Exhibit 2019.

2 JUDGE SMITH: Yeah.

3 MR. HUDNELL: Deposition transcript, page 56 of the -- page 57
4 of the transcript.

5 JUDGE SMITH: Okay.

6 MR. HUDNELL: Line 5.

7 JUDGE SMITH: Okay, got it. Thank you.

8 MR. HUDNELL: I asked him, okay, question, okay, "Is an icon
9 comprising textual elements different than just text?" His answer was
10 -- answer, "I think an icon comprising textual elements includes just text, but
11 it is not limited to just text." And I think that is our point. You when you
12 look at Claim 20, yes, we are -- as I said earlier, with respect to our cover
13 slide, you can have text in the icon, but it's not limited to that. That's why
14 it's called an icon, because you have an icon that includes, that comprises
15 text, and that's what you see on the cover slide.

16 Third point I indicated that I would get back to you on, Your
17 Honor, and actually Petitioner touched on this, was the downloading element
18 of the '058 patent. I just want to be clear that we are -- Petitioner included
19 some very strict and static and unchangeable language. And I don't think
20 that I said that during my presentation as it applies to the selection pages. I
21 acknowledged that they could be updated. And the text that I was searching
22 for and I've now found is at column 5, line 14 through 19.

23 It says: "Furthermore, it is easy to conceive a process for
24 downloading, periodically or on demand, an updating of a set of pages used
25 in the method according to the invention, from a management server towards
26 a plurality of office automation and communication apparatuses wherein this

1 method is implemented.”

2 And so, my point was not that once you set up the invention as
3 claimed and the selection pages are static. They can be updated, but the
4 point is, is that updating happens before any preliminary search. And it's
5 really more of a -- as it describes here, from a management server. We're
6 not talking about the user deciding, oh, I want to go to XYZ information or
7 this other site and creating the beforehand locally stored pages. No, this
8 happens before the user even gets to those pages.

9 And so therefore, that first search, the preliminary search is the
10 first search that happens after those pages are beforehand locally stored.
11 That's the point. It's not that these pages are just simply static, for eternity.
12 They can be updated, but that search, the preliminary search that the user
13 does, has to happen after those pages are stored. Those are the three points I
14 wanted to address. Your Honor, unless you have any further questions, I
15 would cede the rest of my time.

16 JUDGE SMITH: None from me.

17 JUDGE MURPHY: None from me.

18 JUDGE BRADEN: No.

19 JUDGE SMITH: Okay. Thank you.

20 JUDGE BRADEN: I have no further questions.

21 MR. HUDNELL: Thank you, Your Honors.

22 JUDGE SMITH: All right. Well, I guess you didn't need that
23 extra time. All right. We're off the record.

24 (Whereupon, the above-entitled matter went off the record at 12:29
25 p.m.)

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