

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

FERID ALLANI,
Patent Owner.

IPR2025-00857
Patent 10,943,058 B2

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

SMITH, *Administrative Patent Judge*.

JUDGEMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

Petitioner filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–27 of U.S. Patent No. 10,943,058 B2 (Ex. 1001, “the ’058 patent”) pursuant to 35 U.S.C. § 311(a). We issued an institution decision. Paper 15 (“Inst. Dec.”). Patent Owner filed a Patent Owner’s Response pursuant to 35 U.S.C. § 313. Paper 20 (“PO Resp.”). Petitioner filed a Reply (Paper 29, “Reply”) and Patent Owner filed a Sur-Reply (Paper 35, “Sur-Reply”). We heard oral argument from the parties on August 5, 2026. (Paper 39, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6(b)(4) and § 318(a). This Decision is a final written decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of claims 1–27 of the ’058 patent. We determine Petitioner has shown by a preponderance of the evidence that claims 1–27 are unpatentable.

A. Real Parties-in-Interest

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

B. Related Matters

The parties state that the ’058 patent is currently asserted in *Allani v. Apple Inc.*, No. 6:24-cv-00304 (W.D. Tex.) and *Allani v. Google LLC*, No. 6:24-cv-00305 (W.D. Tex.). Pet. 77; Paper 3, 2.

C. The ’058 Patent¹

The aim of the ’058 patent is to provide a method for accessing information sources and services on the Web that is quicker and easier to use

¹ The ’058 patent was filed on Sept. 9, 2014, and is a continuation of application No. 13/585,065 filed on Aug. 14, 2012, which is a division of

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

D. Illustrative Claims

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

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

application No. 10/169,355, filed as application No. PCT/FR00/03759 on Dec. 29, 2000. Ex. 1001, codes (22), (60).

- [1(a)(1)] said first selection page being specifically designed for containing a selection icon for locally accessing said second selection page,
- [1(a)(2)] said second selection page being specifically designed for containing a selection icon for locally accessing said third selection page,
- [1(a)(3)] said third selection page being specifically designed for containing one or more direct access icons for directly accessing an information- or service-providing Web site, and
- [1(b)] at least one selection page being specifically designed for containing one or more icons for directly accessing a search engine on the Web,
- [1(c)] wherein the control and processing device or devices are programmed for: enabling a preliminary search locally performed within said communication device in different themes and sub themes within said plurality of selection pages, and
- [1(c)(1)] emitting on the communication network, in response to selection of a direct access icon in a selection page being currently displayed, an address of an information- or service-providing Web site corresponding to said selected direct access icon,
- [1(c)(2)] said address being locally generated during the preliminary search and selection,
- [1(d)] wherein the apparatus is implemented in a mobile phone.

Ex. 1001, 5:36–6:9.

- 24. [24(Pre)] A mobile communication device connectable to remote sources of information or services through a communication network, the communication device comprising a display, data storage, a processor, a controller and a plurality of pages locally stored in said data storage and displayable on said display,
- [24(a)] wherein a first one of said locally stored pages is specifically designed to include at least one direct access icon capable of being selectively activated to connect said mobile communication device to a first predetermined one of said remote sources of information or services and at

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

Ex. 1001, 7:42–8:14.

E. Asserted Challenges to Patentability

Petitioner asserts that claims 1–27 of the '058 patent are unpatentable based on cited evidence of record in the following challenges (Pet. 4):

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

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

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

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

3	1, 2, 4–6, 10–23, 25, 27	103(a)	Rossmann, Himmel, King, Adar ⁵
4	3, 7–9	103(a)	Rossmann, Himmel, King, Adar, Boyle ⁶

II. ANALYSIS

A. Level of Ordinary Skill in the Art

In determining the level of ordinary skill in the art at the critical time, we consider the type of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the educational level of active workers in the field. *See Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986); *see Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1011 (Fed. Cir. 1983).

Petitioner contends that:

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

Pet. 3 (citing Ex. 1003 ¶¶ 37–39). Patent Owner does not challenge this definition. *See generally* PO Resp. After reviewing the entire record, we determine that Petitioner's proffered level of ordinary skill in the art is consistent with the level demonstrated in the cited prior art references. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("the prior art

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

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

itself[may] reflect[] an appropriate level” as evidence of the ordinary level of skill in the art) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)). We, therefore, apply Petitioner’s definition in our analysis.

B. Claim Construction

We interpret a claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2020). Under this standard, we construe the claim “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.*; see *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

The parties propose constructions of “icon,” “beforehand locally stored,” and “specifically designed to include.” Pet. 4–8; PO Resp. 8–30, 42–44; Reply 4–16, 25–27; Sur-Reply 2–11, 19–20. We determine that “beforehand locally stored,” “icon,” and “specifically designed to include” are the only terms that need to be expressly construed to resolve a controversy between the parties.

1. “beforehand locally stored”

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

In our Decision to Institute, we determined that the plain meaning of “beforehand locally stored” requires the claimed selection pages to be present

on the local device before a user conducts a preliminary search. Dec. Inst. 8. We determined that a user could download and store selection pages to the local device, and that such downloading and storing must occur before the user locally performs a preliminary search in order for the selection pages to be “beforehand locally stored” within the scope of claims 1 and 27. *Id.* We construed the terms “said selection pages being beforehand locally stored” recited in claim 1 and “said selection pages being . . . beforehand locally stored” recited in claim 27 as requiring the selection pages to be locally stored before a user locally performs a preliminary search. *Id.*

In its Response, Patent Owner contends that this construction of beforehand locally stored “is fully consistent with a user downloading, configuring, or customizing the selection pages and icons on the device . . . so long as that configuration is completed before the user subsequently performs the preliminary search through those pages.” PO Resp. 9. Patent Owner contends that dependent claims 3 and 9 “describe a process of downloading and storing updated pages—a process that, under the Board’s construction [from the Decision to Institute] must be completed before the user performs a preliminary search.” *Id.* at 10.

In its Reply, Petitioner does not challenge the Board’s construction of “beforehand locally stored” from the Decision to Institute. Reply 18. Rather, Petitioner agrees with Patent Owner that “beforehand locally stored” does not exclude a user from downloading and storing updated selection pages, as long as the selection pages are present before a user begins the locally performed search. *Id.* at 19 (citing PO Resp. 8–9). Petitioner also agrees with the Board that the selection pages can be stored in non-volatile memory. *Id.* (citing Inst. Dec. 8, 10).

We continue to construe the terms “said selection pages being beforehand locally stored” recited in claim 1 and “said selection pages being . . . beforehand locally stored” recited in claim 27 as requiring the selection pages to be locally stored before a user locally performs a preliminary search. *See* Dec. Inst. 8. We agree with the parties that “beforehand locally stored” does not exclude a user from downloading and storing updated selection pages as recited in claims 3 and 7–9, as long as the selection pages are present before a user begins the locally performed search. PO Resp. 8–9; Reply 18–19. We also agree with Petitioner that the selection pages can be stored in non-volatile memory as we stated in our Institution Decision. *See* Inst. Dec. 10 (citing Ex. 1001, 4:5–7).

2. “*icon*”

Patent Owner contends that the claim term “icon” recited in independent claims 1, 21, 24, and 27, as well as several dependent claims, “requires a graphical or symbolic selectable element—distinct from a mere textual designation.” PO Resp. 19 (emphasis omitted). To support this contention, Patent Owner relies on intrinsic and extrinsic evidence including the claims, the specification, the prosecution history, expert testimony, and several dictionaries. *Id.* at 18–30. Regarding the claims, Patent Owner argues that claim 20 recites that “the icons comprise textual elements” and asserts that this means that an icon includes, but is not limited to, text. *Id.* at 21 (citing *CIAS, Inc. v. All. Gaming Corp.*, 504 F.3d 1356, 1360 (Fed. Cir. 2007)).

In Reply, Petitioner contends that the claimed “icon” encompasses a textual icon as well as a graphical or symbolic icon. Reply 4. To support this contention, Petitioner also relies on intrinsic and extrinsic evidence, including the claims, the specification, the prosecution history, and Patent

Owner’s proposed construction in the corresponding district court litigation. Regarding the claims, Petitioner contends that “Claim 20 recites ‘wherein the icons comprise textual elements’” and asserts that “[b]y definition, an independent claim is broader than a claim that depends from it, so if a dependent claim reads on a particular embodiment of the claimed invention, the corresponding independent claim must cover that embodiment as well.” *Id.* at 12–13 (quoting *Littelfuse, Inc. v. Mersen USA EP Corp.*, 29 F.4th 1376, 1380 (Fed. Cir. 2022)). Petitioner further contends that “the word ‘comprise,’ like ‘include,’ means that the claim requires only that element alone, and allows it in combination with other unrecited subject matter.” *Id.* at 13 (citing *Hewlett-Packard Co. v. Repeat-O-Type Stencil Mfg. Corp.*, 123 F.3d 1445, 1451 (Fed. Cir. 1997); MPEP § 2163) (emphasis omitted). Petitioner then argues that the “fact that ‘icon’ may include additional elements does not preclude that icon may also comprise only ‘textual elements’ consistent with the rest of the record.” *Id.*

In Sur-Reply, Patent Owner, relying on dependent claim 19, contends that “an ‘icon’ is ‘a stylized graphical or symbolic representation—a pictogram, glyph, logotype, or simplified graphic element—as distinct from plain text.” Sur-Reply 2. Patent Owner contends that “claim 20 narrows to ‘icons compris[ing] textual elements’—that is, stylized-text icons such as labeled buttons and wordmarks.” *Id.* at 3 (alteration in original). Patent Owner contends that “an icon comprising textual elements—a stylized word; a word within a bounded control—satisfies claim 20 without being bare text.” *Id.* Patent Owner also relies on the specification, the prosecution history, dictionary definitions, and the corresponding district court litigation to support its contention. *Id.* at 4–12.

After reviewing the evidence cited by the parties for determining the meaning of “icon” as claimed, including the dependent claims, the specification, the prosecution history, and the extrinsic evidence including expert testimony and dictionary definitions, we determine that the plain meaning of “icon” is readily apparent from the claims themselves. *See Phillips*, 415 F.3d at 1314 (“In some cases, the ordinary meaning of claim language as understood by a person of ordinary skill in the art may be readily apparent even to lay judges.”). We find that the plain meaning of “icon” as claimed encompasses at least “textual elements” because claim 20 recites “the icons comprise textual elements.” *See id.* (“Other claims of the patent in question, both asserted and unasserted, can also be valuable sources of enlightenment as to the meaning of a claim term.”).

We highlight that the additional intrinsic evidence cited by the parties is consistent with the plain meaning. For example, Figures 1 and 2 of the specification show icons comprising textual elements. As another example, during prosecution of the ’058 patent, the Examiner found that the claimed icons were taught by textual hyperlinks. Ex. 1002, 586, 592. In order to overcome the Examiner’s rejection and obtain an allowance (*id.* at 641–50), applicant subsequently amended the claims to recite “specifically designed,” thus implicitly conceding to the Examiner’s interpretation of icon as encompassing textual hyperlinks. *Id.* at 625–640; *see* PO Resp. 43–44 (citing Ex. 1002, 626–27, 645–46) (acknowledging that the Examiner allowed the claims because applicant amended the claims to recite “specifically designed for containing a set of icons.”).

With respect to the district court litigation, the district court determined that its construction of “icon” is the plain and ordinary meaning. Ex. 1055, 2. We agree with this construction and apply the plain and ordinary meaning,

which is recited explicitly in the claims themselves as discussed above. Although the parties here provide additional arguments regarding the proposed constructions made before the district court, we find these arguments moot in view of the district court construing the claim term icon under its plain and ordinary meaning.

Similarly, the extrinsic evidence, such as expert testimony and dictionary definitions, is outweighed by the plain and ordinary meaning of “icon” as “textual elements” as recited by the claims themselves. *See Phillips*, 415 F.3d at 1317 (“However, while extrinsic evidence can shed useful light in the relevant art, we have explained that it is less significant than the intrinsic evidence in determining the legally operative meaning of claim language.”).

3. “*specifically designed to include*”

Petitioner contends that Patent Owner proposed construing “specifically designed to include” in the corresponding district court litigation, in light of the prosecution history of the ’058 patent, as meaning “used to include,” such that the device must be used to include selection pages comprising the claimed icons. Pet. 7–8 (citing Ex. 1036, 15–18; Ex. 1003 ¶ 80).

Patent Owner contends that during prosecution, applicant amended the claims to recite that each selection page be “specifically designed” to contain the claimed set and arrangement of icons. PO Resp. 42–43 (citing Ex. 1002, 625, 630–31, 633). Patent Owner contends that in the remarks to the amendment, applicant explained that “designed to” is not satisfied by mere capability, and distinguished the amended claims from the prior art which was not specifically designed and constructed in the required manner. *Id.* at 43 (citing Ex. 1002, 626–27). Patent Owner relies on the testimony of its

expert, Dr. Eslamimehr, who testifies that the amended claims recite that “[e]ach page must be deliberately authored to include the specific icon types required by the claims’ within a fixed local structure (Ex. 2020 ¶ 34).” *Id.* at 44 (alteration in original).

Petitioner contends that neither the claim language nor the prosecution history requires the term “specifically designed” to mean deliberately authored fixed pages with intentional icon placement across a hierarchy. Reply 25–26. Petitioner contends that during prosecution, applicant said that “[r]equiring an element to be ‘specifically designed’ for another element narrows the claim because it requires more than the first element being merely capable of being used with the second element.” *Id.* at 26 (citing Ex. 1002, 626) (alteration in original). Petitioner contends that the scope of “specifically designed to include,” read in light of the prosecution history, encompasses “used to include,” meaning that in operation the page must actually include the claimed icons—not merely be capable of doing so. *Id.* at 27 (citing Ex. 1003 ¶ 127).

In Sur-Reply, Patent Owner contends that during prosecution, the Examiner relied on Logan to reject the claims, but “Logan’s pages did display the mapped elements in operation: the Examiner mapped Logan’s ‘LINK[s]’ 1–4 as the claimed selection and direct access icons” and that “applicant nonetheless obtained allowance by distinguishing those pages as ‘merely pages retrieved from Web browsing and stored.’” Sur-Reply 19 (citing Ex. 1002, 626–27) (alteration in original). Patent Owner contends that the “distinction the record draws is not ‘subjective intent,’” and that “[n]o designer’s mental state need be examined.” *Id.* at 19–20.

During prosecution of the ’058 patent, applicant said

Requiring an element to be "specifically designed" for another element narrows the claim because it requires more than the first element being merely capable of being used with the second element.

The term "configured to" is generally construed narrowly to mean "made to" and "designed to" rather than broadly to require merely "capable of". See *In re Giannelli*, 739 F. 3d 1375, 1379-80 (Fed. Cir. 2014) (the phrase "configured to" requires more than "mere capability." Rather, that term is synonymous with "made to" and "designed to."). However, rather than use "configured to", in order to avoid any confusion as to the narrower scope of the claims as amended, Applicant herein directly and explicitly requires "designed to." *In re Giannelli* at 1379-80 (Fed. Cir. 2014) (reversing an obviousness rejection because (1) the claims were properly construed narrowly to mean "designed to" and not broadly to encompass merely "capable of", and (2) the USPTO had not explained the motivation for modifying the prior art to meet the "design to" requirement) See also MPEP 2111.04, citing to *In re Giannelli*, for the proposition that a claim can be narrowed to require that it be "designed and constructed to be used" in a specific manner (as a rowing machine in the case of *In re Giannelli*).

Logan has not been specifically designed and constructed in the required manner, so it does not cure all deficiencies of the primary reference Iki (which lacks any tree menu structure). Logan describes only "remote web" pages 90, 95 that are merely pages retrieved from Web browsing and stored in a web computer 25. Iki as modified by Logan would result on in a tree menu structure wherein not all levels of the tree included the required selection pages specifically designed for containing the claimed set of icons.

Ex. 1002, 626–27 (emphasis omitted).

Thus, during prosecution, applicant distinguished the amended claim from the prior art combination of Iki and Logan by asserting that “Logan describes only ‘remote web’ pages 90, 95” and as a result, in the combination, “not all levels of the tree included in the required selection

pages [are] specifically designed for containing the claimed set of icons.”
Ex. 1002, 627. Remote web pages 90, 95 of Logan are shown in Figure 1 of
Logan which is reproduced below:

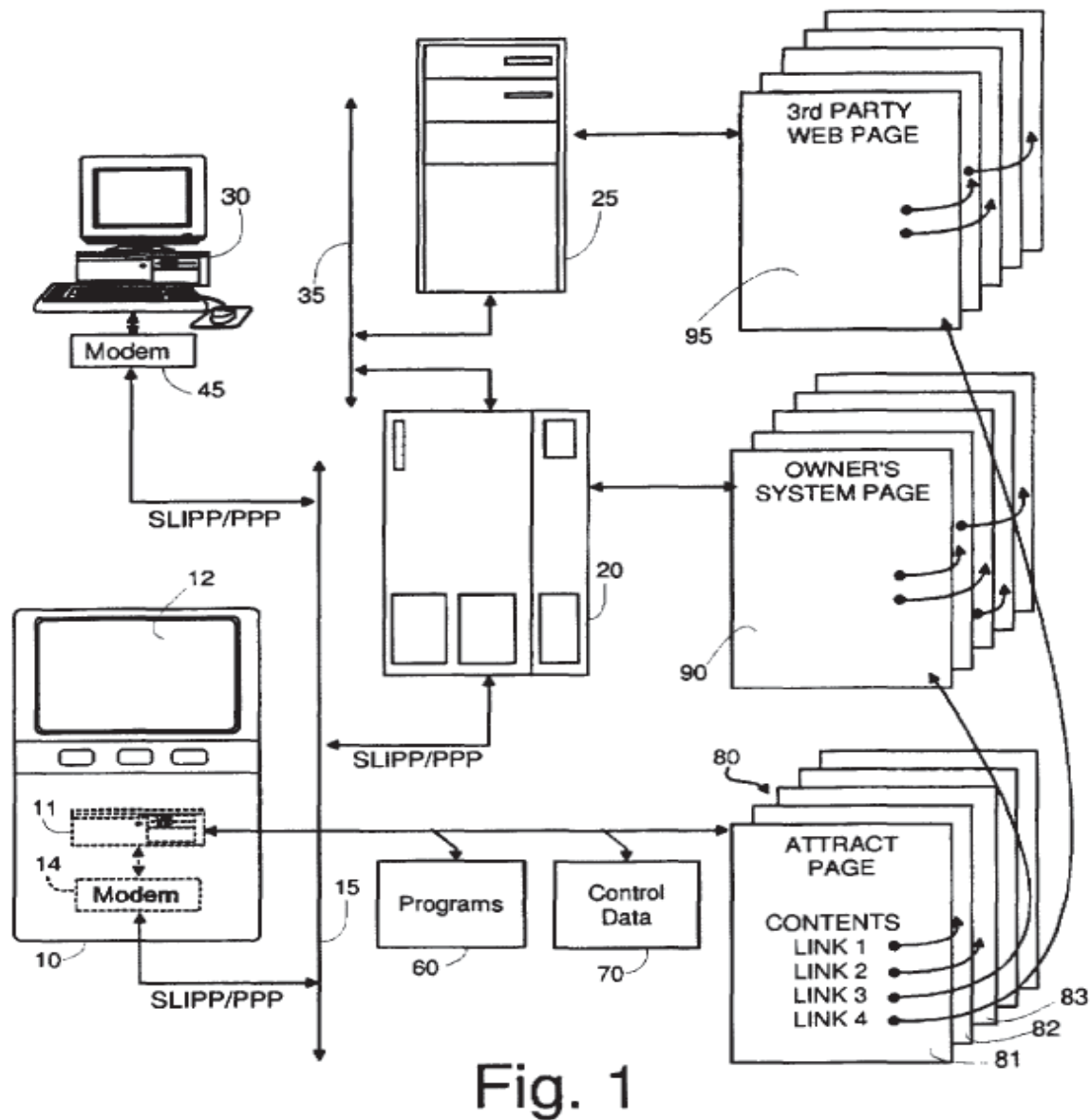


Fig. 1

Ex. 1025, Fig. 1. Figure 1 above shows

the hypertext documents stored locally on the hard disk of the kiosk computer 11 preferably includes an attract page 81 which, as illustrated, might contain[] imbedded hypertext links LINK1 AND LINK2 to other locally stored pages 82 and 83 respectively, as well as LINK3 to a home page 90 stored by the

web server computer 20, and LINK4 to a further web page 95 stored on the web server computer 25.

Ex. 1025, 4:55–62.

As shown in Figure 1 of Logan, web pages 90, 95 do not show selection pages containing a set of icons, which supports applicant’s remarks that “Logan has not been specifically designed and constructed in the required manner, so it does not cure all deficiencies of the primary reference Iki (which lacks any tree menu structure). Logan describes only ‘remote web’ pages 90, 95 that are merely pages retrieved from Web browsing and stored in a web computer 25.” Ex. 1002, 626–27 (emphasis omitted). In light of applicant’s remarks in the prosecution history, we agree with Petitioner that the scope of “specifically designed to include” encompasses “used to include,” such that the device must be used to include selection pages comprising the claimed icons.

C. Alleged Obviousness of Claims 24–26 in view of Rossmann and Himmel (Ground 1)

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

1. Claim 24(Pre)

The preamble states

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

Petitioner contends that Rossman teaches the preamble in discloses a mobile communication device that accesses remote sources of information or services through a communication network, where Rossmann's mobile communication device includes a display, data storage, processor, controller, and a plurality of locally stored pages stored in data storage for display. Pet. 13–16 (citing Ex. 1004, Figs. 1, 2, 4A–4G, 2:66–3:3, 3:19–34, 4:48–5:5, 5:42–43, 6:11–59, 7:50–53, 8:47–49, 11:3–6, 12:18–34, 13:60–63).

Patent Owner presents no arguments to the contrary. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

Based on the entirety of the trial record, we find Petitioner has demonstrated by a preponderance of the evidence that Rossamnn teaches the preamble of claim 24.

2. Limitation 24(a) and the combination of Rossmann and Himmel

Limitation 24(a) recites

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

a. Petitioner's Contentions

Petitioner contends that the plain and ordinary meaning of “icon” encompasses textual icons and that “direct access icon” means an icon that, when selected, causes an address of at least one remote information or service source to be transmitted to a network. Pet. 16. As discussed above, we agree that the plain meaning of icon encompasses textual icons, and that

we do not need to construe “direct access icon” in order to resolve the parties’ dispute. *See supra*, Section II.B.

Petitioner next contends that Rossmann discloses a set of locally stored pages stored in memory on a mobile device. Pet. 16. In particular, Petitioner contends that Rossmann teaches, in Figure 4A through 4G, that a user interested in weather searches and navigates through locally stored decks and cards to ultimately display the weather in Town A. *Id.* at 16–18 (citing Ex. 1004, Fig. 2, Figs. 4A–4G, 6:20–29, 6:33–36, 8:49–55, 9:37–45, 9:62–10:4, 10:34–11:56, 13:66–14:1).

Petitioner then contends that Rossmann teaches that the HDML cards comprise selection icons that locally access and display other selection pages, such as the local news icon in Figure 4D that accesses the corresponding HDML card shown in Figure 4E. Pet. 19–20 (citing Ex. 1004, Figs. 4C–4E, 6:20–29, 9:54–59, 9:62–65, 11:15–33). Petitioner further contends that a person of ordinary skill in the art would have understood that Rossmann’s selectable choices on a given displayed HDML card teach the claimed selection icons. *Id.* at 20–21 (citing Ex. 1003 ¶¶ 81–89).

Petitioner argues that although Rossmann does not explicitly teach a selection page that includes both a selection icon and a direct access icon, Rossmann does teach a selection page that includes both local hyperlinks to other stored cards and links to a server to download new decks. Pet. 21 (citing Ex. 1003 ¶ 91). Petitioner also argues that Himmel teaches direct access icons in disclosing locally stored bookmark sets that a user can select to access a specific URL, such as a consumer hot list bookmark set that includes URLs for popular web actions such as purchase, on-sale today, review order, review shopping cart, and consumer address. *Id.* at 21–22

(citing Ex. 1005, Abstract, Figs. 1, 6A, 6B, 1:5–8, 4:54–57, 5:22–27, 6:19–22, 14:9–24, 15:42–43, 18:53–21:17; Ex. 1003 ¶¶ 92–93).

Petitioner contends that a person of ordinary skill in the art would have modified Rossmann to include several advantages expressly taught by Himmel: Himmel’s consumer hot list bookmark set for the benefits of providing a user with a consistent user interface when accessing a website; to simplify navigation for the user by providing an additional navigation aid; to provide more immediate access to commonly used web actions; to reduce the network traffic required to navigate through webpages to arrive at a particular web function; and to reduce usage charges and data usage. Pet. 22–23 (citing Ex. 1003 ¶¶ 94–99; Ex. 1004, 2:38–56, 12:24–34, 14:35–44; Ex. 1005, 18:63–65, 20:11–16). Petitioner contends that modifying Rossmann’s Figures 4A through 4G to include Himmel’s consumer hot list bookmark set yields each selection page including both selection icons for navigating to other local pages along with direct access icons such as on sale today to directly navigate to a predetermined web site to perform a common web action. *Id.* at 23–25 (citing Ex. 1003 ¶¶ 96–100; Ex. 1004, Figs. 4D–F).

Petitioner contends that the selection page of Rossmann as modified by the bookmark set of Himmel teaches a first locally stored page specifically designed to include a direct access icon because the selection page is “used to include” a direct access icon, such as on sale today, and that during use, this selection page is programmed to display the set of direct access icons for selection by the user. Pet. 25 (citing Ex. 1003 ¶¶ 96–100); *see id.* at 21–24. Petitioner contends that a person of ordinary skill in the art would have had a reasonable expectation of success because technology for bookmarking websites and web actions was known at the time of invention, modifying Rossmann to utilize known bookmark manager software would

have been straight forward, Rossmann already includes hardware and programming instructions to access a web server, and Himmel teaches that known prior art methods utilized both selection and direct access icons on a single page. *Id.* at 25–26 (citing Ex. 1003 ¶¶ 101–103; Ex. 1004, 2:38–41, 14:21–44; Ex. 1005, Fig. 6A, 21:27–34).

b. Patent Owner’s Contentions and the Board’s analysis for “icon”

Patent Owner contends that under the proper construction of icon, Rossmann does not disclose an icon as claimed. PO Resp. 30. Patent Owner contends that every navigable element in Rossmann’s disclosed interface is a numbered text string in a list, which the specification of the ’058 patent distinguishes from an icon. *Id.* Patent Owner contends that every selectable element shown in Figures 4A through 4G is a numbered text string, such as “2. XYZ Information” shown in Figure 4B. *Id.* at 31. Patent Owner contends that Rossmann uses the term “icon” to describe its arrow indicators, but not to describe the numbered text items. *Id.* at 31–32. Patent Owner contends that Petitioner’s expert, Dr. Bederson, confirmed that Rossmann uses the word “icon” only to describe its arrow indicators. *Id.* at 32–33. Patent Owner contends that the Petition does not map the claimed “direct access icons” or the claimed “selection icons” to the arrow indicators of Rossmann. *Id.* at 33. Patent Owner contends that Dr. Bederson testified that Rossmann discloses text based links, but did not testify whether a person of ordinary skill in the art would have considered the claim term “icon” to encompass Rossmann’s text based links. *Id.* at 34–35. Patent Owner contends that because Rossmann’s numbered menu items are not stylized graphical or symbolic selectable elements, Rossmann does not disclose the “icon” limitations as claimed. *Id.* at 35.

Patent Owner’s contentions are based on Patent Owner’s construction of the claimed icons as excluding textual icons, which we find unpersuasive as discussed above in our claim construction. *See supra* Section II.B. We find that the combination of Rossmann and Himmel teaches the claimed “at least one direct access icon” such as on sale today (Ex. 1005, 20:3–10; *see id.* at 19:40–48, 20:63–64, Fig. 15) and “at least one selection icon” such as “2. XYZ Information” (Ex. 1004, Figs. 4A–4G) for the reasons given by Petitioner and Dr. Bederson, which are supported by the record. *See* Pet. 19–26 discussed above.

c. Patent Owner’s Contentions and the Board’s analysis for “specifically designed”

Patent Owner contends that “Petitioner likewise fails to show any asserted combination that provides a locally stored page ‘specifically designed’ to include an icon.” PO Resp. 44 (citing Ex. 2020 ¶ 72). Patent Owner contends that “Rossmann’s decks are generated by CGI program in response to user’s choices . . . and Himmel’s bookmark sets are user populated.” Sur-Reply 20. Patent Owner contends that “[p]ages that come into existence on request, and lists a user assembles, are the browsing- and user-derived structures the applicant distinguished—not selection pages specifically designed to contain the claimed sets.” *Id.*

Petitioner contends that it “applied PO’s construction of ‘specifically designed to include’ as ‘used to include,’ meaning that in operation the page must actually include the claimed icons—not merely be capable of doing so.” Reply 27 (citing Pet. 7–8). Petitioner contends that “Dr. Bederson likewise applied that construction and explained that, in the Rossmann-Himmel modified system, the selection pages contained the claimed set of icons,

including selection icons for local navigation and direct-access icons for accessing remote sources.” *Id.* (citing Ex. 1003 ¶ 127).

Patent Owner’s contentions are inconsistent with our construction of “specifically designed to include” as encompassing “used to include.” *See supra* Section II.B. Based on the entirety of the trial record, we agree with Petitioner and Dr. Bederson and find that the selection pages of the combination of Rossmann and Himmel include selection icons for local navigation and direct access icons for accessing remote sources.

d. Conclusion for limitation 24(a)

We agree with Petitioner and Dr. Bederson and find that adding Himmel’s bookmarks to Rossmann’s cards provides the benefit of directly accessing a particular web function, thus reducing network traffic and data usage as compared to navigating multiple web pages to arrive at the particular web function, and find that a person of ordinary skill in the art would have had a reasonable expectation of success in making the combination. *See* Pet. 21–26; Ex. 1003 ¶¶ 90–103. Accordingly, we find that Petitioner has demonstrated by a preponderance of the evidence that the combination of Rossman and Himmel teaches limitation 24(a).

3. Limitation 24(a)(1)

Limitation 24(a)(1) recites

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

Petitioner contends that the combination of Rossmann and Himmel teaches this limitation as shown in Petitioner’s modified Figure 4E, which

shows a second locally stored page that displays a second direct access icon such as “Purchase,” and a selection icon such as “Formal” to display a third locally stored page. Pet. 26–27 (citing Ex. 1003 ¶ 105).

Patent Owner presents no arguments to the contrary. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *Dynamic Drinkware*, 800 F.3d at 1378.

Based on the entirety of the trial record, we agree with Petitioner and Dr. Bederman and find that Petitioner has demonstrated by a preponderance of the evidence that the combination of Rossman and Himmel teaches limitation 24(a)(1).

4. *Limitation 24(b)*

Limitation 24(b) recites

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

Petitioner contends that the combination of Rossmann and Himmel teaches this limitation as shown in Petitioner’s modified Figure 4F, which shows selection icons such as suits and blouses, and a third direct access icon such as review order. Pet. 27–28 (citing Ex. 1003 ¶ 106).

Patent Owner presents no arguments to the contrary. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *Dynamic Drinkware*, 800 F.3d at 1378.

Based on the entirety of the trial record, we agree with Petitioner and Dr. Bederson and find that Petitioner has demonstrated by a preponderance of

the evidence that the combination of Rossmann and Himmel teaches limitation 24(b).

5. *Limitation 24(c)*

Limitation 24(c) recites “wherein the mobile communication device is a mobile phone.” Petitioner contends that Rossmann teaches this limitation in disclosing a mobile phone. Pet. 28–29 (citing Ex. 1004, Figs. 1 and 2, 6:12–14).

Patent Owner presents no arguments to the contrary. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *Dynamic Drinkware*, 800 F.3d at 1378.

Based on the entirety of the trial record, we agree with Petitioner and find that Petitioner has demonstrated by a preponderance of the evidence that Rossmann teaches limitation 24(c).

6. *Claim 25*

Claim 25 depends from claim 24 and recites “wherein at least one of the selection pages is further specifically designed to include one or more icons for directly accessing a search engine on the Web.”

The parties dispute whether the scope of the claimed icon “for directly accessing a search engine on the Web” encompasses Himmel’s search function for searching within a particular website, or whether the claim term requires a conventional search engine such as Yahoo. Pet. 30–31; PO Resp. 35–42; Reply 22–24; Sur-Reply 16–19. Petitioner then argues in the alternative that even under Patent Owner’s narrower construction, the limitation is met by the Petition’s later challenge (in Ground 3) based on the prior art combination including Adar, which discloses a Yahoo search engine. Pet. 64–65; Reply 24–25. According to Petitioner, the combination of

Rossmann, Himmel, King and Adar renders claim 25 obvious by teaching a direct access icon for a conventional search engine.

Given that in Ground 3, Petitioner maps the direct access icon recited in claim 25 for “a search engine on the Web” to Adar’s disclosure of a conventional search engine such as Yahoo, we apply the same mapping approach in our analysis of Ground 1. As a result, we find that for claim 25 in Ground 1, the Petition has not shown that the combination of Rossmann and Himmel teaches a direct access icon for a conventional search engine on the Web.

7. Claim 26

The Petition establishes that Rossmann-Himmel teaches when a user selects a direct access icon hyperlink on a displayed page, an address is emitted over the Internet to the website the user selected. Pet. 31–32. For example, Himmel teaches “[e]ach hyperlink contains URL location information that serves as an address of the web site.” *Id.* (citing Ex. 1005, 5:35–36) (alteration in original). When a user selects a direct access icon, e.g., “Purchase” or “On-Sale Today” associated with the ABC Sales Corp. website, the specific URL containing the address corresponding to that web action would be “emitted” over the Internet to retrieve that webpage. *Id.* (citing Ex. 1005, 2:4–7, 5:28–6:28, 19:22–31; Ex. 1003 ¶ 114).

Patent Owner does not present arguments contesting Petitioner’s contentions for claim 26. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *Dynamic Drinkware*, 800 F.3d at 1378. Based on the entirety of the trial record, we agree with Petitioner and Dr. Bederson and find the Petition establishes by a preponderance of the evidence that the combination of Rossmann and Himmel teaches the limitation of claim 26.

Pet. 31–32 (citing Ex. 1004, 10:26–34; Ex. 1005, 2:4–7, 5:28–6:28, 19:22–31; Ex. 1003 ¶¶ 94–95, 114–115).

8. Conclusion for Ground 1 based on the combination of Rossmann and Himmel

We find that the Petition shows by a preponderance of the evidence that the combination of Rossmann and Himmel renders claims 24 and 26 obvious for the reasons given in the Petition, but does not show that claim 25 is unpatentable.

D. Alleged Obviousness of Claims 1, 2, 4–6, 10–23, and 27 in View of Rossmann, Himmel, and King (Ground 2)

Petitioner contends that claims 1, 2, 4–6, 10–23, and 27 would have been obvious over the combination of Rossmann, Himmel, and King. Pet. 33–64 (citing Ex. 1003 ¶¶ 76–113, 118–119, 123–126, 135–158, 160–166, 169–175, 181, 183, 192, 194). In doing so, Petitioner explains how the combination satisfies each limitation and provides supporting testimony from Dr. Bederson. *See id.*

Each of independent claims 1, 21, and 27 require an icon for directly accessing a search engine on the Web. The Petition relies on its contentions for claim 25 from Ground 1 to show this limitation. Pet. 40, 60, 63. Because the Petition has not shown that the combination of Rossmann and Himmel teaches this limitation as discussed in our analysis of claim 25 above, we find that the Petition has not shown that the combination of Rossmann and Himmel teaches this limitation in claims 1, 21, and 27. However, as discussed below in our analysis of Ground 3, we find that the combination of Rossmann, Himmel, King, and Adar teaches this limitation. Because the Petition, in its analysis of Ground 3, incorporates the remaining contentions from Ground 2, we address these contentions here before turning to Ground 3.

1. *Claim 1(Pre)(1)*

Claim 1(Pre)(1) states

Apparatus for accessing information- or service-providing Web sites, comprising a communication device connectable through a communication network to the Internet, control and processing device or devices, data storage device or devices, and a display

Petitioner contends that Rossmann teaches claim 1(Pre)(1) in disclosing a mobile device that accesses information providing Websites, downloading a deck of cards as shown in Figures 4A through 4G, and locally navigating those cards to obtain weather information about town A. Pet. 34 (citing Ex. 1004, 9:37–11:56).

Patent Owner does not address this limitation, but the burden remains on Petitioner to demonstrate unpatentability. *Dynamic Drinkware*, 800 F.3d at 1378. Based on the entirety of the trial record, we agree with Petitioner and Dr. Bederson (Ex. 1003 ¶ 121) that Petitioner has demonstrated by a preponderance of the evidence that Rossmann teaches claim 1(Pre)(1).

2. *Claim 1(Pre)(2)*

Claim 1(Pre)(2) states

said storage device or devices containing a plurality of selection pages within a tree menu structure, *said selection pages being beforehand locally stored* in said data storage device or devices

a. *Petitioner's Contentions*

Petitioner contends that Rossmann teaches this by storing HDML cards locally in the RAM of the mobile device. Pet. 35–36 (citing Ex. 1004, Fig. 7, 6:20–37, 7:50–53, 12:18–34; Ex. 1003 ¶ 123). Petitioner further contends that Rossmann's HDML cards are hypertext that link to other cards in the deck and represent website information in a downward tree structure, such that the cards are hierarchically linked hypertext pages that are nodes of tree structure web sites. *Id.* at 36–38 (citing Ex. 1004, Fig. 5, 11:34–55,

13:53–54; Ex. 1003 ¶¶ 124–125). Petitioner next contends that even under the Board’s construction of “beforehand locally stored,” Rossman teaches this limitation. Reply 20. In particular, Petitioner contends that Rossmann discloses meeting a user’s request for a certain page with one of the cards of a deck stored in RAM. *Id.* at 19–20 (citing Ex. 1004, 8:47–55). Petitioner then contends that a user’s request is served by a deck already stored in cache and does not require “any communication with the server device.” *Id.* at 20 (citing Ex. 1004, 8:49–55). Petitioner contends that the “deck is stored in work memory 148 ‘before’ a user begins its preliminary search, satisfying the claim as construed.” *Id.* (citing Ex. 1052 ¶¶ 36–38). Petitioner argues that this scenario described in Rossmann occurs when a deck remains available from a prior interaction, and a user wants to perform a later navigation through that deck after the deck has been locally stored. *Id.* (citing Ex. 1052 ¶¶ 39–40).

Petitioner also contends that its claim construction arguments are proper and acceptable under *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1384 (Fed. Cir. 2023). According to Petitioner, because of the Board’s construction in the Decision to Institute, “*Axonics* provides that ‘a petitioner must be given the opportunity in its reply to argue and present evidence of anticipation or obviousness under the new construction,’ particularly when a Petitioner does not introduce new art and relies on the same embodiments. This applies to new constructions adopted by the Board at Institution. 37 C.F.R. § 42.23(b) (a petitioner reply ‘may only respond to arguments raised in the corresponding . . . patent owner response, or decision on institution.’).” Reply 21 (emphasis omitted, alteration in original). Petitioner contends that “Apple relies on the same Rossmann-Himmel grounds, the same Rossmann HDML decks/cards, and the same Rossmann cache-case disclosures

identified in the Petition and Dr. Bederson's declaration. The only issue is how those same disclosures apply under the Board's construction of 'beforehand locally stored.' This is a proper analysis under *Axonics*." *Id.* at 22.

Here, Petitioner relies on the same grounds and relies on the same prior art and the same embodiments as it relied on in the Petition, and explains how those same disclosures apply under our claim construction of beforehand locally stored in the Decision to Institute. The court in *Axonics* held that "when the Board adopts a new claim construction following institution, an IPR petitioner must have adequate notice and an opportunity to respond under the new construction." 75 F.4th at 1383. The Reply is Petitioner's first opportunity to respond to our claim construction and is proper in view of *Axonics*.

b. Patent Owner's Contentions and the Board's analysis of "beforehand locally stored"

Patent Owner contends that the server of Rossmann "generates HDML decks along with CGI program 158, in response to data from or choices made by the user," and "fetches corresponding decks . . . in response to the request from the mobile device." Sur-Reply 13 (quoting Ex. 1004, 7:53–59). Patent Owner contends that pages generated in response to the user's search request cannot be beforehand locally stored relative to the search that calls them into being. *Id.* at 13–14. Patent Owner further contends that Rossmann's deck is downloaded and stored only after a user has performed some action, and that Dr. Bederson's testimony that a user would perform a completely different session is not disclosed in Rossmann. *Id.* According to Patent Owner, Petitioner's contention that "[i]f a deck remains available" for a second search (Reply 20) is a hypothesis, not a disclosure. *Id.*

Patent Owner also contends that even if one deck persists in local memory and is available for a second search, claims 1 and 27 require the preliminary search to occur in different themes and sub themes within said plurality of selection pages, organized as a tree, all beforehand locally stored. Sur-Reply 15 (citing Ex. 2016 ¶ 37; Ex. 2020 ¶ 67). Patent Owner contends that Petitioner has not identified a disclosure of the full tree resident before the search begins. *Id.*

Rossmann discloses

According to one embodiment, the received deck or decks are normally kept in the work memory 148 of the phone 142 in FIG. 3. Upon receiving a request from the user, the client module in the mobile device 142 first consults the work memory 148 therein to determine if the requested deck is available. If the received request is met by one of the cards in the received deck, the deck or the corresponding card in the deck is accessed without requiring any communication with the server device.

Ex. 1004, 8:47–55. Dr. Bederson testifies that: (1) as described by this passage of Rossmann, the deck that is preserved in work memory 148 is present in that local memory before the user begins a navigation session through its cards; (2) the deck is “beforehand locally stored” relative to the user’s navigation session (“preliminary search”) because storing the deck in RAM precedes the user searching through the deck’s cards; (3) Rossmann contemplates that a deck downloaded and stored in RAM during a session may remain available in work memory for a subsequent session: (4) a deck that persists from a prior session is stored before a user begins a fresh navigation search: and (5) when that user initiates navigation through the preserved deck, the selection pages were already stored before the search commenced. Ex. 1052 ¶ 38 (citing Ex. 1004, 8:47–49)

Dr. Bederson's testimony that Rossmann's deck is beforehand locally stored is supported by Rossmann, which describes that, upon receiving a request from a user, the device consults the memory to determine if the requested deck is available, and if so, "the deck is accessed without requiring any communication with the server device," for example, without accessing the Internet. Ex. 1004, 8:47–55; Ex. 1052 ¶ 37. Dr. Bederson's testimony that Rossmann contemplates downloading and storing a deck that remains available in work memory for a subsequent navigation session is supported by Rossmann's disclosure that "[t]he received deck or decks are normally kept in the work memory 148 of the phone," and that "[u]pon receiving a request from the user, the client module . . . consults the work memory 148 therein to determine if the requested deck is available." Ex. 1004, 8:47–55; Ex. 1052 ¶ 39. Dr. Bederson's testimony also is consistent with that of Patent Owner's expert, who testifies that "if the user previously requested that deck being downloaded, and if it is still within a time frame that cache lives, and when user made a similar request to visit the same page it has already downloaded, yes, doesn't need Internet connection." Ex. 1053, 69:17–70:1.

Furthermore, we disagree with Patent Owner's contention that Petitioner has not identified a disclosure of "a preliminary search to occur 'in different themes and sub themes within said plurality of selection pages,' organized as a tree, all beforehand locally stored." Sur-Reply 15 (emphasis omitted). We find that the Petition explains how the deck of Figures 4A through 4G of Rossmann shows the claimed selection pages. *See* Pet. 15–21; Ex. 1004, 6:20–37, 7:50–53, 8:47–64, 9:37–45, 9:54–59, 9:62–10:4, 10:34–11:56, 12:18–34, 13:66–14:1; Ex. 1003 ¶¶ 80–89. Also, Patent Owner's contention that Rossmann's work memory only stores one persisted deck (Sur-Reply 15) is inconsistent with Rossmann's disclosure that "the received

deck or decks are normally kept in the work memory 148.” Ex. 1004, 8:47–49.

Moreover, as Patent Owner acknowledges, our construction of “beforehand locally stored” “is fully consistent with a user downloading, configuring, or customizing the selection pages and icons on the device” PO Resp. 9; *see also* Reply 21 (citing Ex. 1053, 69:17–70:1) (Patent Owner’s expert testifying that if a deck in Rossmann is “already downloaded, yes, doesn’t need Internet connection”). Patent Owner’s position is reinforced by dependent claims 7 and 9, which recite control devices “configured to receive, *from a server, data for updating* information associated with at least one of *a selection page, a direct access icon and a selection icon*” (claim 7), “wherein said updating information is received on demand” (claim 9). In short, updating a selection page resets the clock for the next “preliminary search” where a user navigates through the updated selection page that is “beforehand locally stored” (e.g., cached) on the device.

We agree with Petitioner and Dr. Bederson that when a user downloads and stores one or more decks of Rossmann in the work memory during a first search, such as the deck shown in Figures 4A through 4G, then subsequently performs a second search using the one or more decks stored in the work memory, the one or more decks are “beforehand locally stored” as claimed.

Based on the entirety of the record, we agree with Petitioner and Dr. Bederson that Petitioner has demonstrated by a preponderance of the evidence that Rossmann teaches claim 1(Pre)(2).

3. *Claim 1(Pre)(3)*

Claim 1(Pre)(3) states

and each being specifically designed for containing a set of icons including at least one of a direct access icon for directly

accessing remote sources of information and a selection icon for locally accessing another selection page within said tree menu structure

Petitioner contends that the combination of Rossmann and Himmel teaches this for the reasons given in Petitioner’s analysis of claim 24 in Ground 1. Pet. 38–39 (citing Ex. 1003 ¶¶ 90–104, 126).

Patent Owner relies on arguments presented for Ground 1, that the combination of Rossmann and Himmel does not teach the claimed icons and does not teach the claimed “specifically designed,” which we find unpersuasive for the reasons given above in our analysis of Ground 1. *See supra* Section II.C.2.

We agree with Petitioner and Dr. Bederson that Petitioner has demonstrated by a preponderance of the evidence that the combination of Rossmann and Himmel teaches the preamble of claim 1.

4. Limitations 1(a), 1(a)(1), 1(a)(2), and 1(a)(3)

Petitioner contends that these limitations are taught by Rossmann for the reasons given in Petitioner’s analysis of limitations 24(a), 24(a)(1), and 24(b) as discussed in Ground 1. Pet. 39–40.

We agree with Petitioner for the reasons given above in our analysis of Ground 1. *See supra* Section II.C.2-4.

5. Limitation 1(b)

Limitation 1(b) recites “one or more icons for directly accessing a search engine on the Web.” Independent claims 21 and 27 similarly recite “one icon for directly accessing a search engine for permitting a user to control searches on the Web,” and “one or more icons for directly accessing a search engine on the Web,” respectively. The Petition contends that Himmel teaches each of these limitations for the reasons given in the Petition’s

analysis of claim 25 in Ground 1. *See* Pet. 40, 60, and 63. For the reasons given above in our analysis of claim 25, we find that Himmel does not teach the claimed search engine under Patent Owner’s construction. *See supra* Section II.C.6.

6. Limitation 1(c)

Limitation 1(c) recites

wherein the control and processing device or devices are programmed for: enabling a preliminary search locally performed within said communication device in different themes and sub themes within said plurality of selection pages

Petitioner contends that Rossmann teaches this limitation in describing that a user can perform a preliminary search for information or service, locally within the mobile device in different themes and sub-themes within a plurality of displayed selection pages by locally navigating through a downloaded HDML deck, as discussed in Petitioner’s analysis of claim 24 in Ground 1. Pet. 40–43 (citing Ex. 1004, Figs. 4C–4G, 2:48–51, 12:24–34; Ex. 1003 ¶¶ 135, 137–140).

Patent Owner does not address this limitation, but the burden remains on Petitioner to demonstrate unpatentability. *Dynamic Drinkware*, 800 F.3d at 1378. Based on the entirety of the trial record, we agree with Petitioner and Dr. Bederson that Petitioner has demonstrated by a preponderance of the evidence that Rossmann teaches limitation 1(c).

7. Limitation 1(c)(1)

Limitation 1(c)(1) recites

emitting on the communication network, in response to selection of a direct access icon in a selection page being currently displayed, an address of an information- or service-providing Web site corresponding to said selected direct access icon

Petitioner contends that the combination of Rossmann and Himmel teaches this limitation for the reasons given in Petitioner’s analysis of claims 24 and 26 in Ground 1. Pet. 43–44 (citing Ex. 1004, 10:26–34; Ex. 1005, 2:4–7, 5:28–6:28, 19:22–31; Ex. 1003 ¶¶ 94–95, 141–142).

Patent Owner does not address this limitation, but the burden remains on Petitioner to demonstrate unpatentability. *Dynamic Drinkware*, 800 F.3d at 1378. Based on the entirety of the trial record, we agree with Petitioner and Dr. Bederson that Petitioner has demonstrated by a preponderance of the evidence that the combination of Rossmann and Himmel teaches limitation 24(c)(1).

8. *Limitation 1(c)(2) and the combination of Rossmann-Himmel and King*

Limitation 1(c)(2) recites “said address being locally generated during the preliminary search and selection.” Petitioner contends that the combination of Rossmann and Himmel teaches a user display with selectable menu items that include URL addresses to a desired webpage. Pet. 44 (citing Ex. 1004, 5:20–29, 10:26–34; Ex. 1005, 4:54–57, 5:35–36; Ex. 1003 ¶ 144). Petitioner argues that when a user selects an item, the desired webpage is retrieved such that the user directly accesses the website. *Id.* at 44–45 (citing Ex. 1003 ¶ 144).

Petitioner next contends that although the combination of Rossmann and Himmel does not detail the process of locally generating an address when a user selects a direct access icon, King teaches well-known URL generation in an HDML environment. Pet. 45 (citing Ex. 1006, Fig. 5, 8:65–14:14; Ex. 1003 ¶ 146). According to Petitioner, a person of ordinary skill in the art would have applied King’s inline variable management technique to the selectable menu items taught by the combination of Rossmann and

Himmel for the benefit of “solv[ing] the problem of using client state in displays without the necessity of the server round trip and without incurring all the memory and processing requirements of a full scripting language” as taught by King. *Id.* at 45–46 (citing Ex. 1006, 2:26–30; Ex. 1003 ¶¶ 147–150). Petitioner contends that a person of ordinary skill in the art would have had a reasonable expectation of success because King elucidates processes already described in the HDML 2.0 specification and incorporated by reference into Rossmann. *Id.* at 46 (citing Ex. 1003 ¶¶ 146–150).

Patent Owner does not address this limitation separately. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *Dynamic Drinkware*, 800 F.3d at 1378.

We agree with Petitioner and Dr. Bederson that Petitioner has demonstrated by a preponderance of the evidence that the combination of Rossmann, Himmel, and King teaches limitation 1(c)(2), that a person of ordinary skill in the art would have applied King’s inline variable management technique to the selectable menu items taught by the combination of Rossmann and Himmel for the benefits of using client state in displays without the necessity of server round trip and without the memory and processing requirements of a full scripting language, and would have had a reasonable expectation of success in doing so.

9. Limitation 1(d)

Limitation 1(d) recites “wherein the apparatus is implemented in a mobile phone.” Petitioner contends that Rossmann teaches this limitation for the reasons given in the Petition’s analysis of limitation 24(c) in Ground 1. Pet. 46.

Patent Owner does not address this limitation, but the burden remains on Petitioner to demonstrate unpatentability. *Dynamic Drinkware*, 800 F.3d

at 1378. Based on the entirety of the trial record, we agree with Petitioner and find that Petitioner has demonstrated by a preponderance of the evidence that Rossmann teaches limitation 1(d).

Conclusion for Ground 2 based on Rossmann, Himmel, and King

We find that Himmel does not teach the search engine of independent claims 1, 21, and 27 under Patent Owner’s construction of the term, therefore, the Petition has not shown that the combination of Rossmann, Himmel, and King renders claims 1, 2, 4–6, 10–23, and 27 obvious.

E. Alleged Obviousness of Claims 1, 2, 4–6, 10–23, 25, and 27 in View of Rossmann, Himmel, King, and Adar (Ground 3)

Petitioner contends that claims 1, 2, 4–6, 10–23, 25, and 27 would have been obvious over the combination of Rossmann, Himmel, King, and Adar. Pet. 64–67. In doing so, Petitioner explains how the combination satisfies each limitation and provides supporting testimony from Dr. Bederson. *See id.*

In particular, Petitioner contends that the combination of Rossmann, Himmel, and King teaches the limitations of claim 1 discussed in detail in Ground 2, section II.D. above, with the exception of limitation 1(b): “at least one selection page being specifically designed for containing one or more icons for directly accessing a search engine on the Web.” Pet. 65–66 (citing Ex. 1003 ¶ 201). Petitioner contends that Adar teaches limitation 1(b) because Adar discloses that a bookmark for the Yahoo search engine can be sent to a user. *Id.* at 66 (citing Ex. 1008, Fig. 10, 2:59–65, 5:58–65, 7:12–13, 10:41–57, 11:4–14). Petitioner contends that a person of ordinary skill in the art would have modified Himmel’s bookmark manager software to include Adar’s downloadable bookmark for the Yahoo search engine for the benefit of downloading and providing the user with immediate access to the Yahoo

search engine. *Id.* at 66–67 (citing Ex. 1003 ¶¶ 204–205). Petitioner contends that a person of ordinary skill in the art would have had a reasonable expectation of success in making this modification because it would have required only simple programming changes to Himmel’s bookmark manager software with known bookmarking functionality, along with additional database storage in the communication architecture of the combination of Rossmann, Himmel, and King. *Id.* at 67 (citing Ex. 1003 ¶¶ 205–206).

Patent Owner’s Response does not present any arguments against Petitioner’s showing that Adar teaches the search engine of limitation 1(b) under Patent Owner’s construction of this term. Patent Owner’s Sur-Reply contains one sentence of attorney argument that adding Adar does not supply a selection page “specifically designed to include” the search engine icon or “the claimed three-page architecture.” Sur-Reply 18–19. We read Patent Owner’s cryptic argument to be based on its proposed construction of “specifically designed to include,” which we address in section II.B.3. above.

Based on the trial record, we agree with Petitioner that Adar teaches limitation 1(b) under Patent Owner’s construction of a search engine on the Web. We agree with Petitioner and Dr. Bederson that a person of ordinary skill in the art would have added Adar’s downloadable bookmark for Yahoo to Himmel’s set of downloadable bookmarks for the benefit of providing the user with immediate access to the Yahoo search engine, and would have had a reasonable expectation of success in doing so. We also agree with Petitioner and Dr. Bederson that the combination of Rossmann, Himmel, and King teaches the remaining limitations of claim 1 as set forth in Ground 2 above.

Accordingly, we find that the Petition shows, by a preponderance of evidence, that the combination of Rossmann, Himmel, King, and Adar renders claim 1 obvious. With respect to claims 2, 4–6, 10–23, 25, and 27, we find that the Petition shows, by a preponderance of evidence, that the combination of Rossmann, Himmel, King, and Adar renders these claims obvious.

F. Alleged Obviousness of Claims 3, 7–9 in View of Rossmann, Himmel, King, Adar, and Boyle (Ground 4)

Petitioner contends that claims 3 and 7–9 would have been obvious over the combination of Rossmann, Himmel, King, Adar, and Boyle. Pet. 67–74. In doing so, Petitioner explains how the combination satisfies each limitation and provides supporting testimony from Dr. Bederson. *Id.* (citing Ex. 1003 ¶¶ 208–209, 213–219).

Patent Owner does not address this limitation, but the burden remains on Petitioner to demonstrate unpatentability. *Dynamic Drinkware*, 800 F.3d at 1378. Based on the entirety of the trial record, we agree with Petitioner and Dr. Bederson for the reasons given in the Petition. We find that the Petition shows, by a preponderance of evidence, that the combination of Rossmann, Himmel, King, Adar, and Boyle renders claims 3 and 7–9 obvious.

III. CONCLUSION

We determine that a preponderance of the evidence establishes that claims 1–27 are unpatentable, as shown in the following table:

Claim(s)	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
24–26	103(a)	Rossmann, Himmel	24, 26	25
1, 2, 4–6, 10–23, 27	103(a)	Rossmann, Himmel, King		1, 2, 4–6, 10–23, 27
1, 2, 4–6, 10–23, 25, 27	103(a)	Rossmann, Himmel, King, Adar	1, 2, 4–6, 10–23, 25, 27	
3, 7–9	103(a)	Rossmann, Himmel, King, Adar, Boyle	3, 7–9	
Overall Outcome			1–27	

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–27 of the '857 patent have been proven by a preponderance of evidence to be unpatentable; and

FURTHER ORDERED that, because this is a final written decision, parties to this proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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