

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KYOCERA CORPORATION,
Petitioner

v.

PATENT OF SOFTVIEW, INC.,
Patent Owner

Case IPR2013-00004
IPR2013-00257
Patent 7,831,926

Case IPR2013-00007
IPR2013-00256
Patent 7,461,353

Before BRIAN McNAMARA, STACEY WHITE (VIA VIDEO HOOKUP)
AND BRYAN MOORE, *Administrative Patent Judges*.

RECORD OF ORAL HEARING

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PROCEEDINGS

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JUDGE MCNAMARA: Good morning. Everybody be seated.
Okay. Good morning again and welcome to the Board, the Patent Trial
Appeal Board. Today we have the oral hearing in, let me see, Case IPR
2013-00004, which has been joined with IPR 2013-00257 and IPR
2013-00007, which has been joined with IPR 2013-00256.
We have allowed, I believe, three hours for these hearings. And
I think the trial order basically says we'll hear, let me see, first from the
Petitioner on the underlying case. I think we have an issue also pending on
the -- we have an issue pending on claim construction, and we also have a -- is
there a motion to exclude, I think?
So, we'll hear from the Petitioner first on the underlying issues.
Then we'll hear from the Patent Owner -- the Patent Owner, and then we'll go
from there. Is everybody ready to proceed?
MR. CHU: We are, Your Honor.
MR. LU: Yes.
JUDGE MCNAMARA: Let's begin with the Petitioner. Did
you want to reserve some time or anything?
MR. COHEN: Yes. We would like to reserve approximately
45 minutes or so, at least the time we don't use for rebuttal.
JUDGE MCNAMARA: Okay. So, you expect this to be about
a 45-minute discussion?
MR. COHEN: Yes, Your Honor.

1 JUDGE MCNAMARA: Okay.

2 MR. COHEN: My name is Eric Cohen. I represent Petitioner
3 Kyocera Corporation. With me is my associate, Michael Tomsa, my partner,
4 Richard Bower, both with -- all of us are with the law firm of Katten Munchin
5 Rosenman, LLP. With me also is Ms. Maria Nelson, who is the chief IP
6 counsel of Kyocera.

7 I should let my co-counsel introduce himself and his team, and
8 then we'll begin.

9 MR. ALEMANNI: Good morning, Your Honor, I'm John
10 Alemanni with Kilpatrick, Townsend & Stockton representing Mobility --
11 Motorola Mobility LLC. and with me is David Reece.

12 JUDGE MCNAMARA: Good morning, all.

13 MR. ALEMANNI: Good morning.

14 MR. COHEN: Good morning, Your Honor.

15 JUDGE MCNAMARA: Let me point out also that we have
16 Judge Stacey White remotely from Dallas, I believe.

17 JUDGE WHITE: Yes, Dallas.

18 JUDGE MCNAMARA: With me today, and this is Judge
19 Moore.

20 MR. COHEN: Good morning, Judge White. We're going to
21 focus in this hearing on certain issues of prior art and certain issues. We're
22 not waiving any other arguments. All the other arguments have been briefed.
23 Everything is fully briefed and we stand on our briefs.

24 So we would like to focus on what we think are some of the

1 more important issues in this hearing.

2 JUDGE MCNAMARA: Okay. I see you have some
3 demonstratives.

4 MR. COHEN: We do. We have some demonstrative exhibits.
5 We filed the demonstratives with the Board.

6 JUDGE MCNAMARA: Does the court reporter have a copy?

7 MR. COHEN: The court reporter does have a copy.

8 JUDGE MCNAMARA: Okay. Do you have another extra
9 copy? Another copy around that you can give us up here?

10 MR. COHEN: Yes. Now, in addition to the demonstratives,
11 we're also going to be looking at some pages from the record. So -- and we're
12 not going to do the demonstratives in order.

13 JUDGE MCNAMARA: That's perfectly fine.

14 MR. COHEN: Okay. So and I've got this clicker and I hope I
15 can hit the right button. I have been practicing, but I'm not sure I'm all that
16 good.

17 JUDGE MCNAMARA: Good luck.

18 MR. COHEN: Thank you. So we would like to start looking at
19 Claim 1 of the '353 Patent. This was a claim the Board characterized in one
20 of his decisions including the IPR as it represented a claim. And, so we chose
21 this claim just to highlight some of the issues here.

22 We have bracketed in blue the claim limitations that relate to
23 the hardware. This claim is a wireless device. Some of the claims that claim
24 wireless device as mobile devices, mobile phones. All of the hardware

1 limitations are basically standard features found at the time of the invention.
2 Any PDA, they are found in the Zaurus PDA that we cited, and that is one of
3 the pieces of prior art that is involved in virtually every combination. And
4 those hardware elements that are found in Zaurus are common to all PDAs at
5 the time. We don't think that they're disputed.

6 The rest of the claim involves limitations that I'm going to
7 characterize as software limitations. And some of those claim limitations are
8 contested. And, so the issue really is, are those software claim elements, the
9 ones that are contested, found in a combination of Zaurus and Pad++ or in
10 Zaurus and the other combinations that are before the Board? We're going to
11 focus on Zaurus and Pad++.

12 As Your Honor indicated, there is a claim construction issue,
13 what is the proper construction of the -- what I'm going to call the preserves
14 limitation. And then finally, was there a motivation to combine the teachings
15 of the Zaurus publication. And there is a total of about 340 pages of them in
16 Pad++.

17 Just we have, I think, six prior art exhibits for you to focus on,
18 too. We'll answer questions on Tsutsumitake, Hara, SVG and SVF if the
19 Board has any questions. Actually, Mr. Alemanni and I are going to divide
20 the argument, so he is going to handle the questions on those two prior art
21 references. And so if the Board has a question and one of us is prepared to
22 answer it and the other one is standing here, we'll switch if that's okay with
23 the Board.

24 Okay. What was Zaurus? Zaurus was like any other PDA with

1 wireless Internet access. It has a touch screen, a display, memory, storage, so
2 on, so forth. So Zaurus was like any PDA. And just to sort of highlight an
3 issue up front, we filed from the petition a declaration -- actually two
4 declarations have been submitted by a Dr. Jack Grimes.

5 I have here page 20 from PX-1021 of the Grimes' declaration.
6 And we've highlighted -- we have taken the liberty of highlighting paragraph
7 118 where Dr. Grimes opines that the Pad++ references provides an enabling
8 disclosure for one skilled in the art or an implementation on a PDA having a
9 smaller display.

10 So Dr. Grimes, although he didn't -- and this declaration --
11 these declarations were filed in three exams filed by Apple at least the year
12 before we filed our petition for an Inter Parts Review and we just basically
13 copied them and submitted them with our petition. And then subsequently we
14 retained Dr. Grimes. Dr. Grimes gave an opinion on combining Pad++ to the
15 PDA.

16 So what is different about Zaurus from any other PDA? And
17 now I'm going to look at Defendant's Demonstrative Exhibit 5. Zaurus had a
18 zoomable browser. That's what's different. And what we're looking at here in
19 Demonstrative Exhibit 5 is Plaintiff's Exhibit 1004 at pages 645 to 646. And
20 these are the translations of the documentation for Zaurus.

21 So translation, why the translation? Zaurus was only marketed
22 in Japan. But the documentation, of course, is a printed publication and it's
23 prior art. So this clearly says that you can reduce or -- it's looking at a web
24 page. You can reduce it or you can magnify it by tapping on this one button,

1 which is part of it.

2 Moving to Defendant's Demonstrative Exhibit No. 9, Pad++. It
3 is a collection of articles totaling 300 and -- about 340 pages. It discloses
4 vector graphics. That was in the original Grimes declaration, Exhibit 1021 at
5 paragraphs 25, 26. It discloses zooming and panning, again in the Grimes
6 declaration, and discloses scalable

7 vector-based content that supports a scalable
8 resolution-independent representation of the HTML-based content, as the
9 Board found in its decision at page 26. And I believe that's cited from the
10 decision on the '353 Patent.

11 Pad++ can follow links across the Internet as Dr. Grimes found
12 in his original declaration, Exhibit 1021. And in his original declaration,
13 Dr. Grimes opined that Pad++ preserves -- discloses preserving the layout and
14 functionality of the web page when zoomed and panned.

15 So a combination of Pad++ with Zaurus we say discloses all of
16 the elements in all of the claims and in combination of other references --
17 either alone or in combination of other references as the Board found in its
18 decision. And I'm not going to go through each one because we have got a lot
19 of claims, a lot of references.

20 Issue: Does Pad++ disclose preserving the original layout
21 functionality and design? Plaintiff's Demonstrative Exhibit 11, 12 and 13
22 show three pages from the Pad++ documentation and --

23 JUDGE MCNAMARA: I know you've been using designations
24 Plaintiff and Defendant. I assume you're talking about the Plaintiff in the

1 litigation being the Patent Owner here and the Defendant being the Petitioner.

2 Is that right?

3 MR. COHEN: I hope I have been using it in that way, but I'll
4 try to be clear.

5 JUDGE MCNAMARA: I just wanted to make sure we were
6 talking about the same parties.

7 MR. COHEN: This is my first time in the patent office arguing
8 in an inter parts review, which I'm sure is going to be true of most of us. So
9 let me -- thank you for the reminder. It's an old habit.

10 Dr. Grimes -- just to make the record clear, Dr. Grimes
11 submitted on behalf of the Petitioner, he submitted on behalf of Apple, who is
12 the Defendant in the lawsuit and the filing of the re-exam.

13 So does Pad++ disclose preserving the original page layout,
14 functionality and design? And the answer is, looking at pages 287, 289 and
15 291 of Exhibit 1006, the Pad++ tour, the answer is yes.

16 When looking at Demonstrative 11, Petitioner's Demonstrative
17 Exhibit 11, this is Ben Bederson's home page. This is a screen shot of Ben
18 Bederson's home page. And what was this displayed on? It was obviously
19 displayed on a desktop computer because that's what the folks who designed
20 Pad++ were working with. This shows the -- Ben Bederson's home page at
21 one zoom level. Note that the heading is centered. And just note the layout
22 of this.

23 Defendant's Demonstrative Exhibit 12, another zoom level. It's
24 zoomed out a little bit from the first one. Layout is exactly the same. It is just

1 zoomed out.

2 Demonstrative Exhibit 13, this is from page 289 of
3 Exhibit 1006. Pad++ tour. And again, this is zoomed way in but the layout is
4 the same, and Dr. Grimes opined that the hyperlinks in this all worked.

5 Now I don't want to -- I'm going to sort of -- their argument
6 here is, "Well, this doesn't show what the original page layout was." There is
7 no evidence that anything that Ben Bederson put in his home page or any
8 code that he put in his home page is missing. It's not a very complicated
9 home page. It doesn't have a lot of format. But there is no evidence that it
10 had it in the first instance. There is nothing in Dr. Grimes' declaration that
11 said that it -- there is no evidence. He never looked at the original HTML
12 code. There is no evidence that anything here was missing. So under any
13 construction, any construction, whether you adopt theirs or ours, Pad++
14 preserves the original page layout functionality and design.

15 JUDGE MCNAMARA: Let me ask this question. What is
16 layout? What is the layout and the functionality and the design? One of the
17 issues that the Patent Owner has brought up is that the original layout,
18 functionality and design isn't preserved. And they say, well, for example, you
19 know, maintaining the layout after the web page has been initially rendered
20 doesn't mean that it preserves the original layout, functionality and design.

21 So the question that comes to my mind then is, what do we
22 mean when we talk about layout, functionality and design?

23 MR. COHEN: With Your Honor's permission, I am going to
24 get to that. And I would rather do that in sequence.

1 JUDGE MCNAMARA: Okay. That's perfectly fine, but I just
2 want to -- you understand what the underlying question we have is.

3 MR. COHEN: That is the issue. But if we look at this -- if you
4 look at these three pages, nothing in the layout or design has changed when
5 you zoom in or out and the functionality works.

6 So under -- regardless of what it is or how you define it, one
7 cannot determine any differences in looking at these three zoomed versions of
8 these pages. There isn't any. It's all preserved. And so the question is -- and
9 so if their question is well, what was the HTML code? I mean there is no
10 evidence that what was in that code isn't preserved.

11 So let's move on. And let's just keep that in mind. And I'm
12 now at the claim construction issue, how to construe this term. So how does
13 this issue arise? Well, the petition explained that the Pad++ preserved the
14 original layout, functionality and design based on the slides I just showed you.
15 I'm now looking at Demonstrative Exhibit 20.

16 In their decision the Board found, based on the evidence that
17 was submitted, that we had at least satisfied the threshold to declare the inter
18 party review that Pad++ preserved the original layout, functionality and
19 design based on the Grimes declaration and the Pad++ references.

20 When we got this, the response of the Patent Owner, frankly,
21 we were shocked. Because the Patent Owner's response took the position that
22 is 180 degrees opposite of an explanation they gave when they added the
23 preserve limitation to the claims by amendment and then defined it.

24 They filed this amendment on May 20, 2008. I'm looking at

1 Exhibit 1002. At page 142. This is the prosecution history of the '353 Patent.
2 In context, when was this? May 20, 2008. It was about -- it was over a year
3 after Steve Jobs announced the introduction of the iPhone. I have blown up
4 Exhibit 1002 of the prosecution of the '353 Patent at pages 144 and 145. This
5 is the amendment. The claims previous to this May 20, 2008 amendment, the
6 claim said -- the claim said it "supports a scalable resolution-independent
7 representation of a web page that substantially retains the original page layout
8 and attributes of the content."

9 They couldn't get that claim language approved by the
10 examiner. The examiner rejected it on multiple occasions saying it was
11 indefinite under Section 112. They amended it. They amended it to say
12 preserves the original layout, functionality, a word that they added and design
13 of the content defined by its original format when scaled and rendered.

14 They amended it. Now, of course, where is this word
15 "preserved" found? The word, if you look at the specification, and we did a
16 word search, it's not found anywhere in the specification except for the claim.
17 You can't look at the specification and say, "What does preserve mean?"
18 because it wasn't there to begin with.

19 Now we're looking at page 2006 of the -- of that same
20 amendment and this is where the remarks section begins. And this refers to
21 an interview that occurred on May 5, 2008, 15 days before the amendment
22 was filed.

23 At page 218, so now we're -- this is a long remarks section. At
24 page 218, there is a heading, "Discussion new claim technology. Preserves

1 the original page layout, functionality and design of the Web content." This is
2 the heading. This is where the explanation starts about what this new claim
3 term means. Begins at page 218 of the '353 prosecution.

4 This is Defendant's -- excuse me. This is the Petitioner's
5 Demonstrative Exhibit 21 where we -- where we show the definition that they
6 gave. And it's now -- this is on page 233. Remember, the section started on
7 page 218. They have given approximately 15 pages of explanation of the
8 technology before they get around to defining it. And this is a definition.
9 "With respect to the scope of the terminology" -- the scope of the
10 terminology. This is a definition. There is no question about -- there can be
11 no question about this. "Preserving the," and then they bracket the language
12 -- "overall layout, functionality and design" and it's in quotes. "This refers to
13 preserving the design as interpreted by the browser."

14 Now, there is a footnote there. And the footnote says it's really
15 the browser's rendering it. "While at different zoom levels and panned
16 views." So it's as interpreted by the browser while at different zoom levels
17 and panned views. In other words, when you zoom in and out, it's preserved
18 after it's been laid out on the screen by the browser.

19 JUDGE MCNAMARA: Excuse me. Go back to that footnote
20 again, Footnote 8.

21 MR. COHEN: Can we blow that up, please? And this may not
22 be very clear when we blow it up.

23 JUDGE MCNAMARA: That's okay. You can just read it to
24 me. What does it say?

1 MR. COHEN: "More particularly, differences in page
2 interpretation will generally be a function of the browser's rendering engine."

3 JUDGE MCNAMARA: Now, I'm looking at that definition
4 that you have shown on the screen. "With respect to the scope of the
5 terminology preserving the overall layout, functionality and design of the
6 content, this refers to preserving the design as interpreted by the browser."
7 Now, Counsel, I will ask you some questions because I really don't
8 understand what the "design as interpreted by the browser" means. But it
9 goes on to say, "While at different zoom levels and panned views, as opposed
10 to rendering the content identically to how it is rendered by a particular
11 desktop browser that may interpret the page design differently."

12 There's a lot there, so let me first ask you what it means to --
13 what is the design as interpreted by the browser? Is it the appearance? What
14 is it?

15 MR. COHEN: Okay. Again, we're going to get there. I have a
16 perfect example to show you. I just want to stress here they said, "Again, the
17 page layout to be preserved is as interpreted by the browser rather than as a
18 comparison to how it is rendered by a particular desktop browser."
19 Defendant's Demonstrative Exhibit 23 just points out that this definition that
20 they gave in prosecution is exactly 180 degrees opposite of what they said in
21 their -- what they said in prosecution is 180 degrees opposite of what they
22 said in their opposition.

23 So let's -- and I'm just going to jump up to Demonstrative
24 Exhibit 28, because I think this answers Your Honor's question. They

1 explain in their -- in the explanation of the technology, they explain the
2 different browsers, different existing browsers. Each browser is going to
3 interpret a web page differently. I mean, for example, some browsers might
4 not support certain plug-ins like Acrobat, Flash, TIFF images even. You
5 couldn't -- you had to have a plug-in when you -- back then when you got on
6 the patent office web page to pull out the images of the patent. So not all
7 browsers supported these plug-ins.

8 And the different -- so now we get to what is HTML? I think of
9 it as we call them HTML tags, and it's basically, if you remember the old
10 WordPerfect formatting, when you put a begin tag and an end tag to say I
11 want this bolded or I want to center this, things like that. So HTML had those
12 tags. And back in the day when you wrote a web page, you would have to use
13 those tags if you want to bold something. I actually did that once. It was a
14 painful exercise.

15 But, so on the left-hand side we have Netscape Navigator
16 displaying a web page and on the right-hand side of Demonstrative Exhibit 28
17 we have Internet Explorer displaying the web page.

18 And what they said -- and this is actually from page 229 of the
19 -- what they said about this was "It will be observed" -- now there was another
20 -- there was a previous page that looked almost identical to the Netscape
21 browser. It was Mozilla. Because they have the same rendering, it looked
22 almost exactly the same. And they said, "Portions of the web page are
23 rendered in a different manner by the IE7 browser, notably the left-hand
24 column." So let's look at the left-hand column, what's different?

1 Well, we'll see there is a lot differences. Okay. So the
2 left-hand column of Netscape has a lot of formatting. It's got boxes. They've
3 got -- it's got words in boxes. There is a background, color, the lettering is
4 white against the dark background and it looks to me as if this is a table. And
5 then you've got some ads and some other things.

6 On the right-hand side, we have the same column as rendered
7 by the Internet Explorer -- Internet Explorer 7 browser. There is no
8 formatting at all. Now I would suggest that the formatting that's in Netscape
9 must have been HTML codes because as far as anybody knows, that kind of
10 formatting, the columns, the background and all those things would be
11 defined by HTML tags, it's not shown at all in the Microsoft Internet Explorer
12 7 browser on page 229 of the prosecution history.

13 So in conventional browsers, and they made this point, every
14 conventional browser is going to render -- is going to display a web page on
15 the screen differently. So you know we have -- I mean the layout I suppose if
16 the arrangement's columns and figures and everything. So how does this
17 work? How does HTML do this?

18 Well, HTML doesn't define a specific layout, spacial layout on
19 a screen. It basically defines relationships between objects. So you know --
20 so object two is to the lower right-hand side of object one and object three is
21 to the left of object two. And so when conventional browsers do this, they
22 basically -- they parse through all these objects and they set up a rendering
23 tree and then you sort of walk the rendering tree to put everything in its place
24 relative to each other.

1 But every browser does it differently. Every rendering of the
2 engine does this differently and they explained the prosecution history. The
3 fonts are going to be different because some browsers, some computers don't
4 support certain fonts. I mean certain font sizes may not be supported. And
5 Dr. Grimes explained this, by the way, in his reply declaration in chapter and
6 verse. I mean a lot of this is different.

7 And so the conclusion -- what they said was preserving the
8 layout meaning after it's been rendered by the browser because you have no
9 idea what the original -- what the layout is or the design is until it's rendered
10 by the browser. None whatsoever.

11 Not only are the left-hand columns different, but look at -- in
12 Demonstrative Exhibit 29 we have looked -- we have outlined in red other
13 parts of the web page and they are different. There are things that are
14 missing. There is formatting that is missing.

15 Not only are objects missing, and I suppose you could say these
16 objects might be plug-ins that aren't supported, but if you look at the left-hand
17 side of the upper red box on the Netscape page, it looks like there is some
18 other formatting there. It is a part of that content exists in the Microsoft
19 Internet Explorer page, but it is not -- it is not formatted the same. There is a
20 lot that's missing.

21 So that's what he was referring to. And this explanation, these
22 two figures on page 228 and 229 precede the definition by three or four pages.
23 That's what they're referring to.

24 Now they also -- they also made the same definition in the

1 prosecution of the '926 Patent. So what happened in the '926 Patent, the
2 examiner added the preserved limitation by an examiner's amendment. And
3 then they filed comments in response to the examiner's amendment, and they
4 -- in those comments they gave an almost identical definition.

5 With respect to preserving the original page layout, the page
6 layout to be preserved is determined as interpreted by the rendering/layout
7 engine on it rather than as a comparison to how the web page may be rendered
8 by a particular desktop browser. That is what they did in prosecution. So
9 when they filed their opposition, what did they say? "Simply maintaining the
10 layout after a web page has been initially rendered does not meet these claim
11 limitations." Well, their opposition and Dr. Grimes' declaration filed in
12 support of their opposition never mentioned the prosecution history. And I
13 don't know how the Patent Owner can satisfy his duty of candor by making an
14 argument like this and not even referring to or distinguishing the prosecution
15 history.

16 So we were very surprised. Could he have anticipated this
17 when we filed our petition? No. You wouldn't anticipate that they would
18 make this kind of argument? They never made it in district court. This
19 phrase was not at issue. The construction of this phrase was not at issue in the
20 district court.

21 Now in the district court, we argued the preserved word -- the
22 word preserved not found in the specification anywhere is indefinite. Because
23 if you look back through what they said does and doesn't preserve, it's loony
24 tunes. You can't figure it out.

1 Now Judge Stark said, oh, yes, you can. It is the look and feel.
2 We disagree with that. And if we go back to the District Court and have to go
3 back and litigate that case, that is certainly an issue we'll raise on appeal.

4 JUDGE MCNAMARA: Well again, that does raise the
5 question as to what the layout actually is. Is it the appearance or is it --

6 MR. COHEN: We say it is the appearance once it's been put
7 on the screen by the rendering of it. According to Dr. Grimes and basically
8 according to the explanation that they gave and actually directly following
9 their explanation they say this is how one of ordinary skill in the art would
10 understand it. It has got to be after it's been laid out on the screen because
11 there is no layout until it's been rendered because the layout is a function of
12 the -- of the web page.

13 And how it's -- you know, what's the design? I mean maybe is
14 has columns, maybe it has this, maybe it has that but if the rendering engine
15 doesn't support all the HTML codes, which Internet Explorer rendering engine
16 obviously didn't at the time, then it's whatever shows up on the screen.

17 Now what did they argue in claim construction? The original
18 functionality and design must be -- refers to the web page as designed for a
19 desktop computer. Well, what does that mean? We just saw web pages
20 designed for a -- a web page designed for a desktop computer. That looked
21 pretty different when you looked at the next page and looked at the Internet
22 Explorer.

23 We, in the district court, we said we agreed that original would
24 mean it's designed for a desktop computer because the whole purpose of their

1 invention was to be able to display web pages -- was not to be able to display
2 the web pages designed for mobile devices. We're all familiar with the web
3 pages that we pull up when we take out our iPhone or our smart phone and
4 you pull down and say, the New York Times. We type in
5 www.newyorktimes.com and what comes up now -- it's different than then but
6 what comes up now is a mobile version. And that mobile version doesn't
7 zoom.

8 And this is going to be -- this is going to be very significant if
9 we get back and litigate this on the damages part of the case because this
10 whole zooming in and out on the web page on a small device is not really that
11 important anymore because most web pages and most, you know, web page
12 providers also have a mobile web page that shows up when you get a smart
13 phone. So we think this invention, which they thought was a big deal is not
14 all that important anymore. And that's why we agreed to that definition. It
15 had nothing to do with the whole preserved limitation.

16 Now again, if you look at what they said -- I've juxtaposed on
17 Demonstrative Exhibit 30 -- if you look at what they said, the definition they
18 gave, now it makes perfect sense in view of the Netscape and the Internet
19 Explorer web pages.

20 "With respect to the scope of the terminology 'preserving the
21 overall layout, functionality, and design' of the content, this refers to
22 preserving the design as interpreted by the browser while at different zoom
23 levels and panned views" -- in other words, it preserved when you're zooming
24 in and out -- "as opposed to rendering the content identically to how it is

1 rendered by a particular desktop browser that may interpret the page design
2 differently."

3 I mean this makes perfect sense. Now next question. We're in
4 a proceeding where the Board has to adopt the broadest reasonable
5 construction. How does the Board -- how should the Board treat the
6 definitions that they gave during prosecution?

7 I mean -- and this is a little bit different here. We're not talking
8 about -- normally in litigation where there's a statement made in prosecution
9 we're saying, "Oh, they disavowed claim coverage. They disavowed claim
10 scope." This is really a little bit different. They added a phrase in prosecution
11 and they defined it. And so, in essence, in the prosecution they were acting as
12 their own lexicon.

13

14 We found the case, and it's a litigation case, the Sunovion case.
15 And there is actually a Fed 2nd cite now -- 3rd cite. I'm sorry. I'm back in the
16 last century. You know, this was a case in which the prosecution history
17 showed the applicants repeatedly defined their invention. And this was the
18 case in which the claim term was added in prosecution and wasn't done in the
19 specification in accordance to the term based on the prosecution history
20 definition. That case is well worth reading.

21 So here, we're talking about the broadest reasonable
22 construction. We're not talking about narrowing. But we're saying the
23 broadest reasonable construction should at least include the definition that
24 they gave in prosecution. That's the broadest reasonable construction. Maybe

1 it includes something else but it should at least include their definition.

2 And, of course, the Board observed the paper number 32,
3 referring back to our agreed definition of original -- and by the way, original
4 is an adjective that modifies six different terms in that one claim that we
5 looked at. That wouldn't be -- the agreed construction is not determinative of
6 the broadest reasonable construction in this proceeding, and we agree with
7 that.

8 Dr. Grimes said in his reply declaration that one skilled in the
9 art would understand that there is no layout until it's been processed by the
10 rendering engine, and we made the point that rendering engines display things
11 differently.

12 So now, let's talk about the motivation to combine references.

13 JUDGE MCNAMARA: Can we go back to your Slide No. 30,
14 your Demonstrative Exhibit No. 30? And you're talking now about Grimes
15 and what happens after rendering, and I just wanted to focus on what comes
16 after that comma, after what you've underlined in red, as opposed to the
17 rendering content identically as to how it is rendered by a particular desktop
18 browser. That's talking about after rendering, right?

19 MR. COHEN: Correct.

20 JUDGE MCNAMARA: Which is how you are construing the
21 claim? In other words, you're saying that the rendered web page is what we're
22 talking about that is zoomed, right? And --

23 MR. COHEN: At various zoom levels, yes.

24 JUDGE MCNAMARA: At various zoom levels, right. And,

1 you know, just in reading this language, it says, "As opposed." So it seems if
2 you could just talk about a little bit, that sentence appears to be saying that
3 after rendering is not what we're talking about.

4 MR. COHEN: I would respectfully disagree with that, Judge.
5 You know, first of all, you said "our definition." It's not our definition. It's
6 their definition.

7 JUDGE MCNAMARA: Right.

8 MR. COHEN: And preserving -- okay. This is preserving the
9 design as interpreted by the browser. In other words, we're preserving the
10 design as interpreted by the browser. Not whatever the design was before it
11 was interpreted by the browser.

12 And that's why we say at -- "while at different zoom levels and
13 panned views." They're saying as opposed to rendering the content identically
14 as to how it is rendered by a particular desktop browser.

15 So they're saying there that the original page layout and design
16 is not the design, the layout and design rendered by Netscape Navigator. And
17 it is not the design rendered by Microsoft Internet Explorer. You can't define
18 it that way because those are different. You could never tell anybody what
19 the original page layout and design was by fixing it to a particular -- even then
20 a conventional browser because you would have no idea what it would look
21 like. You would have to -- the browser has to display it before you know how
22 it's going to look, the layout and design. How it is going to be on that
23 particular screen.

24 And let me give you an example. You have a computer. You

1 know, remember the old cathode ray displays that we all hated, the ones that
2 we couldn't read after a few days? Especially as we got older. What was the
3 resolution, 640 by 480?

4 And you've also got -- you also have the slides that were set on
5 high resolution. You know, so the web page is going to look different on the
6 lower resolution screen than it does on the higher resolution screen. Even
7 back then you have the Apple Macintosh or you had a Windows machine, and
8 they -- they supported different fonts. The web page would look different
9 depending on what machine you used. It looked different depending on what
10 browser you used.

11 The only thing that makes sense is to say it's after it's been
12 displayed. In other words, after it's been rendered by the browser.

13 JUDGE MCNAMARA: Let me ask you this. Clearly, when
14 I'm designing a web page, I don't have it in front of me to know, to see, so I
15 can't see it to see what it's going to look like. But I know what I want to get.
16 And so there is code that I build into my web page design to make it lay out
17 the way I expect it to lay out.

18 And, so is any of that part of your definition of preserving the
19 original layout?

20 MR. COHEN: Please pull out Exhibit 1042. I have an answer
21 for you. It's not mine.

22 JUDGE MCNAMARA: Okay.

23 MR. COHEN: And if we could zoom in on -- this is an article.
24 I think it's around 1997. "All aboard the Internet." What did the author say?

1 "Let's talk about a major problem that all web designers face. You have very
2 little if any control over how your web pages will look on another person's
3 computer."

4 That's your answer. And it goes on to say the browser is using
5 different fonts and do things differently and so on and so forth. That's the
6 answer. You didn't back then have a whole lot of control on how it would
7 look.

8 JUDGE MCNAMARA: You had some control. I guess my
9 point is, you know, it wasn't just a random display. Fact of the matter is it
10 came out looking something like what I intended it to look like.

11 MR. COHEN: Yes.

12 JUDGE MCNAMARA: And that's what I'm getting to in terms
13 of this preserving the original layout and design. I mean, you know, there are
14 two ways to look at it. You can say, "Well, I designed it a certain way. I
15 expected it to look a certain way." Or it was rendered a certain way and now
16 I'm just trying to copy that rendering on to something else larger or smaller or
17 zoomed or not zoomed. And I think to some extent that that's where -- where
18 I'm still trying to figure out where everybody's coming from.

19 MR. COHEN: Okay. So let's think about that for a minute.
20 You designed it to look a certain way and have certain features but they've
21 said -- they said in the prosecution history, the Patent Owner said, you know,
22 the browser may not support all those features. So well then --

23 JUDGE MCNAMARA: Well, assume for a moment I know
24 what browser I'm working with, so I know -- I'm expecting it to appear a

1 certain way on Internet Explorer. And so I have something in mind. I know
2 what I want to get. Otherwise, we'd have -- if we took it to the extreme; we'd
3 have no way of ever knowing what a web page is going to look like.

4 MR. COHEN: I agree. But the thing is when you're designing
5 a web page and you may be designing it for Internet Explorer and this is
6 exactly the problem, you have no way of knowing what it's going to look like
7 when somebody using Netscape pulled it up. I mean Internet Explorer was
8 the predominant browser at the time. And so maybe you would design it for
9 Internet Explorer and not care. But the point they're making here in the
10 prosecution is, depending on the browser it could look a lot different. And the
11 problem is if you're saying -- if you're talking about the free rendering design,
12 then how do we define it? What are we talking about?

13 Are you saying, well, it has to be able to display all HTML
14 tags? Well, you know what if it displays all but one? And by the way, there
15 is nothing in the claim that says you have to translate and render all of the
16 HTML tags.

17 The problem is, where -- how do you -- it's undefinable. Where
18 do you draw that line? So I want to get -- I'm running a little over where I
19 want to be. I just want to say a few things about motivational problems.
20 Their argument, as we understand it, focuses on software that they pulled
21 down from the web, some software for Pad++. Some version of it. And they
22 say, well, it didn't do this, didn't do that, didn't do something else. And our
23 response is, so what?

24 What should be combined is what Pad++ teaches, not the

1 specific code that somebody pulled down. Dr. Grimes in response says, look,
2 a skilled programmer given the teachings of Pad++ would have been able to
3 write a program and run is on a PDA such as Zaurus. They say, well, Zaurus
4 was a proprietary system. So I mean this isn't how you combine reference. It
5 doesn't matter.

6 And is doesn't matter especially because if the invention was in
7 writing software that would implement translating HTML into vector-based
8 graphics, and that was the invention. They didn't disclose any software.
9 There is no code in that specification. And, you know, if you live by the
10 sword, you die by the sword. If you write a broad specification in general
11 terms and your disclosure is just general and it's not specific, what can we
12 glean from the absence of any software? What do we conclude from that?

13 Either that their invention is not enabled -- but we can't do that
14 in this proceeding, so we have to presume it's enabled. If we presume it's
15 enabled, then you have got to presume that one skilled in the art, a skilled
16 programmer could take the teachings of Pad++ and write a code. You have
17 got to presume that.

18 And they say, well, the only thing is Pad++, that was written for
19 a desktop computer. So, okay, if they're saying a web page is designed for a
20 desktop computer, then Pad++ would fit and those pages we showed you from
21 pages 287, 289, 291, it meets that -- it meets their test. It's shown on a
22 desktop computer.

23 If they say it has to be designed for a conventional browser as
24 designed for a conventional browser, that phrase is not anywhere in the

1 claims. So one last point. One last point, and I think this is an important one.

2 They say it only mentions PDA displays in Pad++. Again, this is a so what?

3 Let's compare page 155 of Exhibit 1006, the Pad++ reference,
4 with page 27 -- it's actually column five of the '353 Patent, and let's see what
5 they say. And we've blown these up ahead of time.

6 Pad++ -- this is what Pad++ says, a blowup of this thing down
7 here. "The system is being designed to operate in platforms ranging from
8 high-end graphic work stations, PDAs, and interactive -- from high-end
9 graphic work stations to PDAs, personal digital assistants and interactive
10 desktop documents."

11 Okay. What does the patent say? Besides making small
12 displays eminently usable this technology extends web content in some
13 surprising new arenas." And it goes on to say it can be used on billboards.

14 So both the patent and Pad++ say, you know, we've got a
15 common problem. When you bring up a web page, you've got to make the
16 web page viewable on a display whether it is a small display or a large
17 display. They both say the same thing.

18 I'm going to pass the baton to my colleague Mr. Alemanni.

19 JUDGE MCNAMARA: Okay. You have used up about
20 46 minutes of your initial time, so do you want to continue at this point?

21 MR. ALEMANNI: I think we'll continue, Your Honor, if
22 that's okay, and reserve whatever we have left at the end.

23 JUDGE MCNAMARA: Okay.

24 MR. ALEMANNI: Thank you. Actually, if I may -- good

1 morning, again. If I may, I want to back up maybe a half step because I think
2 you asked a very important question.

3 When the patent says or when the claims are preserving the
4 layout, functionality and design, what is a layout, functionality and design?
5 And I think Judge McNamara that you're getting at the core of design, and
6 that is when you put the HTML together, you have sort of an idea of what the
7 page is going to look like. You design HTML, as you've said, for a particular
8 browser with sort of an idea of what it's going to look like.

9 If you back through the term or through the phrase, the next
10 term you come to is functionality. I think we intuitively understand
11 functionality relates to things like hyperlinks. So when the page is on the
12 screen, does the hyperlink still work? So design is kind of how does it look?
13 Functionality, do the hyperlinks still work?

14 Then we get to layout. And layout is where my colleague, Mr.
15 Cohen, was going with his description. Each rendering engine renders the
16 page differently when it sets up the layout. For instance, the patent has a
17 description where it talks about that a developer could go out to the Mozilla
18 website at the time the patent was filed. They could download the Mozilla
19 rendering engine, which was open. It was freely available to any developer
20 and then they could use that rendering engine to create the layout of the page.
21 So it would retrieve a web page from the web. It would download that web
22 page. It would go through the web page and parse all the elements out, the
23 things that you created. So if you created a heading, if you created
24 hyperlinks, if you created images that you wanted to show on the page, it

1 would pull all those elements out and then it would arrange them into a layout
2 on the page and it did this on this principle. And that's what the layout used to
3 be preserved. Well, that last step doesn't occur until the rendering engine has
4 processed the page. So you have your design, what you want it to look like,
5 and you have your functionality and the things you want to work it.

6 JUDGE MCNAMARA: Can I just ask you to speak just a little
7 bit slower.

8 MR. ALEMANNI: Yes, I'm sorry. So you have the design,
9 what you wanted the page to look like. You have the functionality. Again,
10 the things that you have designed on the page that should work in a certain
11 way, such as hyperlink.

12 The last piece is the layout, which is what the rendering engine
13 does. And until that rendering engine has had a chance to go through and
14 parse all the elements in the page, create the bounding boxes that are
15 necessary to lay out that content, you don't have a layout.

16 So our point is that until the rendering engine has processed that
17 page, you don't have a layout. And that's what must be preserved. The
18 design, the functionality and the layout.

19 And with that, I'll move on to some elements I want to describe
20 or address. These are elements from a number of claims. What these
21 elements all have in common is sort of a basic problem. And it is actually an
22 ancient problem. That is that there is something on the screen that the user
23 wants to see in more detail.

24 This is an ancient problem. People have always had things that

1 they wanted to see more closely, so you can move an object closer to your eye
2 to see or perhaps use a magnifying glass. The problem with seeing something
3 specific on a screen is well known in the computer arts. In fact, the patent
4 specification describes it in the pan arts, you can zoom or pan a page or
5 design in order to see it more clearly.

6 The limitations that are in the claims are build the width and
7 height to fill the display. Zoom only selectable portion display. Do that in
8 response to user input. Some of the more specific ones is zooming in on a
9 column or image by tapping.

10 And I've put up a representative claim, that's 317, which is a
11 hand-held device, which enables -- is for enabling the user to zoom and pan a
12 view of the web page and also zoom out on a particular aspect of that page by
13 tapping.

14 And I'm going to show -- I want to show a reference or page
15 from one of the Pad++ references. I want to make one quick point. BJ, can
16 you pull up -- I think it's 1006, page 144?

17 There's a little confusion over what Pad++ is and what it is we
18 put in the petition. When we referred to Pad++ in the petition, we are
19 referring to a collection of documents, a collection of printed publications.

20 JUDGE MCNAMARA: I notice.

21 MR. ALEMANNI: They have one thing in common. And that
22 is at their core they use a widget called Pad++. The Pad++ widget itself is
23 written in C++, so it's a core piece of software.

24 What the professors and grad students are working with that

1 figured it out is, hey, this is going to be really hard for somebody to work with
2 because every time they want to make a change, they have to recompile the
3 link, their program. And so there's any of us who have done software
4 programming, they can be a pain. So what they did is they wrote interfaces.
5 Sort of wrappers around that core piece of code, so it would be easier to
6 develop applications. They wrote wrappers in TCL, they wrote wrappers in
7 scheme and Perl, et cetera.

8 So all of the documents at their core talk about this Pad++
9 widget and then the various applications that these professors and grad
10 students wrote as they were exploring how you could use this widget. But I
11 just wanted to make that clear because I think it gets a little confusing as you
12 look through all the different references and what it is that ties all of these
13 together.

14 We can go back to the slide you had. Thank you. So Pad++,
15 one of the applications that it does describe is a browser-type application, a
16 particular implementation of a browser. If you look at the screen on the left,
17 that screen on the very far left, the box that BJ is highlighting right now is the
18 first web page that the user looked at. So it's very small on the left.

19 The page that's actually big on that section on the left is the
20 second page or one of the secondary pages the user looked at. When the user
21 clicks in that first screen on that page on the far left, what happens is that the
22 page on the far left is expanded so that it more fully fills the screen.

23 Again, what does the user want to do? If that page on the left is
24 too small, I want to make it bigger. How do I do that? I click on that page,

1 and that particular page gets bigger and it more fully fills the screen so I can
2 see it more clearly.

3 So Pad++ talks about the idea that a user may want to zoom
4 something and that they can zoom it, including a web page. It also talks about
5 zooming via corresponding user input. What's the user input? It's describing
6 clicking. So the user clicks on a page, the page becomes the current focus so
7 the page is bigger.

8 Now how does Pad++ do this? I talked about bounding boxes.
9 I talked about the layout being set up, being created by the conventional
10 browsers by using bounding boxes. That was well known at the time Pad++
11 was written. It was well known at the time the patent was filed. So Pad++
12 described in several places it was using bounding boxes. It doesn't describe in
13 minute detail how it does it because it doesn't need to. That was well known
14 at that time.

15 So I pulled one quote. "Objects are stored in Pad++ in a
16 hierarchy of bounding boxes." Again, it's a hierarchy because you're going to
17 have objects in Pad++ like HTML pages that aren't simple objects. They're
18 not lines. They're compound objects. They have images. They have
19 hyperlinks. They have text.

20 So those objects are stored in a hierarchy of bounding boxes so
21 they can be zoomed together or zoomed independently. And again, as I
22 described, conventional browsers did the process. These first three boxes in
23 Figure 5 that are shown on the screen are described by the patent as a
24 conventional process.

1 So elements of a page, the page is retrieved, it's parsed.

2 Elements such as column definitions and graphic images, the things that you
3 set up in your web page are identified.

4 Then the rendering engine, the actual rendering engine, takes
5 each of these elements and puts it in its own bounding box. So there will be a
6 bounding box for a column, a bounding box for a graphic image and even a
7 bounding box that contains those bounding boxes for the whole web page.

8 So again, Pad++ does it precisely how the conventional
9 browsers did it. Can you pull up -- I'm actually going to go to 1006, 24. It's
10 one of the Pad++ references. So Pad++ mentions a number of different
11 commands. One of the commands that Pad++ makes available to the
12 developer who is using the Pad++ widget is the center command. What the
13 center command does is it changes the view on the screen so that the specified
14 item, the largest dimension of its bounding box -- so I have an item contained
15 within a bounding box, the largest dimension of that is filled -- it's enlarged to
16 fill the screen and the bounding box is centered.

17 So I click on the bounding box, the bounding box grows and it
18 fills the screen and it's placed in the center of the screen. So Pad++ makes
19 this command available to someone who wanted to build a browser and it will
20 take a bounding box and increase it. There's a number of parameters there.
21 The user can specify which particular element that they want to expand, for
22 instance, an image. Or they specify a tag, which is a group of IDs. So they
23 can take an entire web page and expand it, is some of the implementations
24 that are shown in the documentation. But either is possible in the Pad++.

1 We also talk -- excuse me, we also talk about the center box
2 command, which is another command that's in the Pad++ documentation.
3 What that allows the user to do is to actually -- or the developer to do is
4 implement a function like taking a box on the screen and stretching it around
5 an element. So you would supply the coordinates for a bounding box. And
6 then that bounding box is enlarged and it fills the screen.

7 So Pad++, the graphics widget provides all sorts of
8 functionality. It can be used to zoom in on a layout that had been created with
9 bounding boxes. So the conventional process is you retrieve the page, parse
10 it, create the bounding boxes. Putting content on a web page is also well
11 known because there were plenty of conventional browsers that knew how to
12 put a heading on a page or put a hyperlink on a page.

13 The part of this that is supposedly new is preserving that design,
14 layout, functionality while allowing the content to zoom in and out. Pad++
15 allows it. It takes the bounding boxes, which are at the core of the layout, and
16 allows you to fill the screen with the bounding box.

17 Tapping is recited explicitly in the claims. Pad++ teaches that
18 you can click on a particular link and expand it to fill the screen. One of skill
19 in the art in 1999 or 2000 would have known that you could use clicking, you
20 could use tapping, you could use keyboard entry. I mean there were a number
21 of ways to cause something to happen on a computer.

22 Just to make sure that we have completely shown that this was
23 existing in the art at that time, we added the Zaurus reference. The way a user
24 would interact with Zaurus was with a stylus and a tap screen, just as they did

1 with the invention described in the specification or with the application
2 described in the specification. You can use keys, icons, buttons, menus, et
3 cetera.

4 And I'll point out that the specifications just barely mentions
5 tapping. I mean it's clear from the specification it was well known. It only
6 says there's tapping. So you must have known what tapping was. The
7 program must have known how to implement it; otherwise it would have to go
8 into detail.

9 And then, Jack Grimes backed it up. He said those are standard
10 coding practices. Clicking with a mouse, tapping of the stylus is
11 interchangeable in 1999 and then to add on top of that, I mean that's a
12 particular user interface for implementing. Zaurus actually talks about the
13 fact that you can zoom into a web page in response to tapping.

14 So the other point I wanted to cover briefly, the p:tab was stated
15 previously. "In order to establish a proper nexus in relation to secondary
16 considerations the Patent Owner must offer proof that the sales were a direct
17 result of the unique characteristics of the claimed invention as opposed to
18 other economic and commercial factors unrelated to the quality of the
19 patented subject matter." And I'm quoting from Microsoft v. Proxyconn, IPR
20 2012-26.

21 We believe and we've shown that SoftView has not established
22 the proper nexus between the secondary considerations and the claimed
23 invention. And I would like to reserve the rest of my time -- the rest of our
24 time for rebuttal or address the particular issues has SoftView raises, unless

1 there are further questions.

2 JUDGE MCNAMARA: I guess there are no further questions.

3 You have 32 minutes left.

4 MR. ALEMANNI: Thank you.

5 MR. CHU: Good morning, Your Honors, Morgan Chu on
6 behalf of SoftView. I wonder if I can make an inquiry of Judge White. My
7 question to Judge White is whether you're able to see the slides or a set of
8 slides were sent to you?

9 JUDGE WHITE: I have a set of slides here, so I'm -- on my
10 screen I can see -- I have both available to me.

11 MR. CHU: You actually see what is on the screen here?

12 JUDGE WHITE: Yes. Amber is over there and I can see.

13 MR. CHU: Great. Excellent. So, first of all --

14 JUDGE MCNAMARA: Before you begin, I just want to make
15 sure we're on the same page procedurally with what we're doing. The Patent
16 Owner now is -- you have not moved to amend any claims, so you're going to
17 address all your issues at this point, which include the motions to exclude. At
18 least that's your motion.

19 Now, you have an opportunity to rebut their motion to exclude
20 when we're done, but you're -- this is your opportunity to talk about the claim
21 construction issues and present your case in chief on the motion to exclude.

22 MR. CHU: We do understand that, Your Honor.

23 JUDGE MCNAMARA: Do you want me to save any specific
24 time to remind you?

1 MR. CHU: I suppose if you remind us after we've used 30, 60
2 and 75 minutes, that would be great but we're going to --

3 JUDGE MCNAMARA: I will remind you at 45.

4 MR. CHU: Okay. That's great. And we are going to try and
5 reserve five or ten minutes to rebut whatever they argue in connection with
6 the motion to exclude. So, first, let me say that I am going to describe the
7 SoftView invention, and then I'm going to turn the podium over to my
8 colleague, Sam Lu, who is to my left.

9 MR. LU: Good morning.

10 MR. CHU: Mr. Lu is going to discuss the claim construction
11 issues. And then I will return and discuss the PAD ++ and Zaurus
12 combination. And then Alan Heinrich, who is immediately to my left, another
13 one my colleagues --

14 MR. HEINRICH: Good morning.

15 MR. CHU: -- is going to address HARA, other combinations,
16 the motion to exclude, objective indicia of non-obviousness. So, first, what
17 was happening in the 1990s? There was an exponential growth of the World
18 Wide Web. There was a million pages, ten million, a hundred million. By the
19 end of the 1990s, every commentator said there are literally billions of pages
20 with HTML content. And that's key and important because that's what we're
21 talking about. We're talking about HTML-tag pages or the portions of pages
22 that are tagged with HTML capability.

23 Now, what were people doing at this time at the end of the
24 1990s in thinking about smaller devices? Large desktop browsers were just

1 great for accessing those many pages on the Internet. And let me address the
2 way in which one can think of layout, functionality and design in response to
3 Judge McNamara's questions.

4 Think of the New York Times, if you're seeing the physical
5 newspaper. It has, I believe, six columns. Those columns are part of the
6 layout. They are equal in size. At the very top, you have a horizontal frame
7 with the fancy type that says New York Times.

8 The copyright appears in a small box someplace. Think of the
9 Wall Street Journal. In the left column they have what is akin to an annotated
10 index. It will say, "Fighting broke out in Sudan, New Federal Reserve Chief
11 Confirmed by the Senate," whatever it is. The columns and the other frames
12 and the format are the layout.

13 People that have worked on a yearbook, for example, say, okay,
14 we're going to have 20 photos of the graduating seniors or we're going to
15 break it up and have the bottom half of the page have a human interest story
16 of the graduating class.

17 What is the functionality? Well, the functionality might be
18 some of the most common ones filling out a form. Adding text, Google
19 searching or searching with Bing, to be fair to the two companies. Someone
20 has to put in some words, hit a button. That's part of the functionality.

21 What else is important for functionality? Well, given we just
22 passed the holiday season, I want to go to Amazon, I want to go to eBay, I
23 want to buy a purse for my wife, I want to do something else. Will I have to
24 add my name, my credit card information or my PayPal information or

1 something else? That is functionality, as well as clicking a hyperlink.

2 What is the design? The design is the color. The design
3 includes the fonts, and other similar things. So what were people doing when
4 they were thinking about small devices? Because they started first with these
5 beautiful web pages by the end of the 1990s where someone could view all of
6 the New York Times or the Washington Post or another publication or a
7 Yahoo! news page, which had a different layout, functionality and design in
8 comparison to either the Times or the Post.

9 People were thinking, gosh, wouldn't it be nice if we could do
10 that on a small device on a small screen of a device? But they were having
11 problems. So people who were trying to port the experience of the World
12 Wide Web on a conventional browser on a desktop began to create
13 technology that were stripper browsers. They would make what would appear
14 on the screen of the small device anemic in comparison to the robust New
15 York Times' page.

16 There were a group of other people that got together, and it's a
17 worldwide group. 13 of the largest companies in the world concerned about
18 the Internet. And they said, "We're going to solve this problem because we're
19 the ones who are designing the hardware and the software for these small
20 devices. We're selling the service to service those small devices." And they
21 came up with something called WAP, W-A-P, Wireless Application Protocol.

22 It had a different mark-up language. Now who were these
23 companies? I said worldwide. Well Erickson, based in Europe. Google,
24 Microsoft, Samsung, Nokia, T-Mobile, Vodaphone and others. So you know

1 some are device makers. Some are people who want to sell their search
2 services. Some people are carriers but they decided that they could come
3 together and create their own protocol. And if it worked, then they would
4 encourage the authors of those many billions of web pages to use their WAP
5 protocol and their new mark-up language so that their small devices could
6 have a good looking display, but it wasn't going to be a display that preserved
7 either the look and feel or specifically the layout, functionality and design.

8 And, in fact, what they did was they tried to simplify everything
9 and they took out a lot of the functionality. They were taking out -- ripping
10 out a lot of the layout and design.

11 So both those with the stripper browsers as well as this
12 consortium of 13 companies with the WAP protocol, they marched directly to
13 the left in terms of the technology, and that's what everyone was doing.

14 So here comes the folks at SoftView up in Washington, Seattle
15 area, and they are thinking about this problem. And they are saying, wait, we
16 have an installed base of billions of HTML web pages. What can we do to
17 harness the power of that installed base instead of getting everyone to rewrite
18 their HTML web pages with a new mark-up language or with a stripper
19 browser?

20 And they said, let's find a way to do two key things that are key
21 elements of the claims. One is to preserve the layout, functionality and design
22 of the HTML content. Now keep in mind that when someone sees a web
23 page, then and today, part of that web page might have nothing at all to do
24 with HTML content. A plug-in, as an example, is completely different. So

1 that's the first thing they said, the first important requirement of the claims.

2 And then they said, well, with the small screen, wouldn't it be
3 great if we had a good way to zoom? Now, zooming was known. Zooming
4 was known in the prior art. That isn't part of the invention. But what they
5 wanted was a way to tap on a column or click on a column and zoom just to
6 the column. So notice, if I wanted to just read one column in my six-column
7 New York Times web page, that's hard no matter how good my zooming
8 capability is because it's going to take in the adjacent columns. And if I want
9 to then read the rest of the column after I've read one paragraph, what do I
10 have to do? I have to manually do some more work.

11 So they're saying instead of the dumb zooming that existed with
12 respect to web pages, let's have smart zooming. Someone can easily click and
13 just see the column, scroll down and read the entire column. Or tap and see
14 an image and have the image blow up.

15 That's what they conceived of, that's what they sweated over,
16 that's what they designed, that's what they built and that's what they put in
17 their application to the United States Patent Office for which the two patents
18 at issue today were granted.

19 That is the background of the invention, and now I'll turn it over
20 to Mr. Lu.

21 MR. LU: Good morning, Your Honors. My name is Samuel
22 Lu and I'll be addressing claim construction this morning. I think it probably
23 makes sense to start off with the parties' respective claim constructions.

24 SoftView argues that preserving the original layout requires

1 preserving layout as designed for a desktop computer, whereas petitioners
2 argue that this claim term includes preserving the layout as interpreted by the
3 browser. In other words, the mobile browser at issue.

4 This next slide shows the practical differences between the
5 parties' respective claim constructions. SoftView's construction again
6 requires preserving web pages as --

7 JUDGE MCNAMARA: Will you do me a favor? And I
8 probably should have asked this of Petitioner, as well, but for the purposes of
9 the record and to make it easier to the court reporter, when you're referring to
10 a particular exhibit or a page from your exhibits, will you identify which one
11 it is? This is like DX-58 so that we know when we're -- when we see the
12 record that which one you are looking at at the time?

13 MR. LU: Absolutely.

14 JUDGE MCNAMARA: Thank you.

15 MR. LU: So in this Exhibit DX-58, we have a New York
16 Times web page as it would be viewed on a desktop computer. As I
17 mentioned, SoftView's construction requires preserving this web page as
18 designed for a desktop computer on a mobile device. And so you would
19 translate the HTML, you would then render it on the mobile device and you
20 would have the same look and feel preserving the layout, functionality and
21 design on the mobile device.

22 And that preservation extends to zoom operations that would be
23 performed on the mobile device. Let's contrast this with Petitioner's claim
24 construction. It does not require preserving the web page as designed for a

1 desktop computer. It would include it, but if you were to use a stripper
2 browser, it would not -- that would still be covered under Petitioner's claim
3 construction.

4 What do I mean by that? Well, on the left we have a web page,
5 a New York Times web page as rendered on a desktop.

6 JUDGE MCNAMARA: Exhibit 59.

7 MR. LU: Exhibit 59, yes. If that web page, the HTML of that
8 web page, were translated and rendered on a mobile device, using a mobile
9 browser that stripped out content, for instance, photos, menus and other
10 functionality, we would see something that looks like that, which is on the
11 mobile device.

12 And Petitioners argue that preservation simply requires
13 preserving what is initially rendered on the mobile device in subsequent
14 zooms. And this, Your Honors, is the difference between the party's
15 respective claim construction.

16 So moving on to Slide DX-61, let's take a look at some
17 exemplar claim language from the '353 Patent. And it's important to note for
18 purposes of this discussion that original page layout, functionality and design
19 appears at least twice in the claims.

20 In the first part of the claim, the limitation is rendering a
21 browser interface via which a user is enabled to request access to an original
22 web page and that web page comprises HTML-based web content having an
23 original format defining an original page layout, functionality and design of
24 content of the web page. So this is the antecedent basis for an original page

1 layout, functionality and design of content.

2 And we see that, that original page layout, functionality and
3 design of content is defined by the web page comprising HTML-based
4 content having an original format. In other words, before the mobile browser
5 translates, before the mobile browser renders, we have already defined an
6 original page layout, functionality and design of content on the web page.

7 Now, I notice Petitioners made the argument, Gosh, you have
8 no idea what a web page looks like until it gets rendered on a mobile browser.
9 Could we pull up DX-5, please? Our DX-5?

10 Well, as the Board observed, that's not true. When one codes
11 an HTML web page, one has an expectation of what that web page looks like.
12 Whether one surfs on a Safari browser or a Chrome browser or an Internet
13 Explorer browser, when one goes to the Google search page one knows sort
14 of what one expects. The same would be true of Amazon, the same would be
15 true of eBay, the same would be true of the New York Times. And, in fact,
16 the patent's very clear that major Internet content providers have chosen to
17 create their web pages using fixed-resolution structures. This gives them the
18 ability to control the look and feel of their websites.

19 In other words, HTML is used to define a web page, and that
20 gives them the ability to control the look and feel. Could we go back to
21 DX-61, please? So as we explained a few moments ago, HTML defines an
22 original page layout, functionality and design. And that's encompassed in this
23 first element of the claim.

24 The second element of the claim has the language at issue,

1 which is preserves the original page layout, functionality and design of the
2 content defined by its original format when scaled and rendered. Again, we're
3 talking about the original page layout, functionality and design defined by its
4 original format, which again refers --

5 JUDGE MCNAMARA: Hold on. It defines by its original
6 format when scaled and rendered. So I'm having a little trouble. Where is the
7 "when scaled and rendered?" What does that modify?

8 MR. LU: When scaled and rendered refers to rendering the
9 image of the web page, the original with its original page layout, functionality
10 and design and also refers to subsequent zooms. So in other words, not only
11 does the original rendering have to preserve the layout, functionality and
12 design but subsequent zooms and pans of the web page have to preserve the
13 original layout, functionality and design.

14 And Petitioner's claimed construction ignores that first part and
15 says, look, it doesn't matter what the desktop original page layout,
16 functionality and design looks like. You render whatever it is the stripper
17 browser interprets and as long as you preserve subsequent zooms after that,
18 you're good, under their claim construction.

19 If you take a look at Claim 30 of the '926 Patent, we again see a
20 similar construction in the claims. A user is enabled to request to access to a
21 web page having an original format comprising HTML-based content
22 defining an original page layout, functionality and design of content on the
23 web page.

24 Again, the antecedent basis for an original page layout,

1 functionality and design makes it clear that it's the HTML-based content that
2 defines this layout, functionality and design. And all of that is defined before
3 the translating operation occurs and before the rendering operation occurs.

4 Now, let's take a look and see what the patent specification has
5 to say about this. As Your Honors are aware, Exhibit DX-63, as Your Honors
6 are aware, the Federal Circuit considers summaries of the invention and
7 abstracts of the invention to be particularly important in determining the
8 meaning of the claim term.

9 Portions of the patent specification are known to define the
10 invention as a whole. And the brief summary of the invention states that "The
11 methods and software enables users of various devices to view and interact
12 with web pages, maintaining the look and feel of browsing such pages with a
13 conventional desktop browser."

14 The brief summary of invention goes on to say in Exhibit
15 DX-64, "The rendered displays provide substantially the same or identical
16 layout as the original web page enabling users to easily navigate to selected
17 content and features on familiar web pages."

18 This is the crux of the invention, being able to take a look at an
19 Amazon web page on your mobile device and to be able to use the same sort
20 of user interface that one is familiar with on the desktop computer.

21 This same language appears in the abstract of the '353 Patent.
22 Again, another area where the Federal Circuit has instructed courts to look for
23 to determine the most meaningful support for claim construction. But the
24 prosecution history also supports SoftView's construction.

1 JUDGE MCNAMARA: DX-66 at the moment.

2 MR. LU: I will --

3 JUDGE MCNAMARA: I'm sorry, it just occurred to me,
4 though, when we're reading the transcript, it might be good to know the
5 exhibit screen you're talking about.

6 MR. LU: I will endeavor to do that. So Slide DX-66 is a
7 demonstration of the SoftView device. And during the interview, a SoftView
8 browser running on a Toshiba Pocket PC was demonstrated to the Patent
9 Office. "Inventor Gary Rohrabach demonstrated the SoftView browser's
10 ability to scale and render web pages to fit the Toshiba's display while
11 preserving the layout, functionality and design of the web pages in a manner
12 similar to a desktop browser such as Internet Explorer, Firefox, Netscape
13 Navigator, et cetera. Claims corresponding to each of these features are
14 included in the present application." And this, I believe, is the same sort of
15 remarks from which the prosecution history that Petitioners have cited and
16 we'll be discussing in a few moments.

17 Moving on to DX-67, we again have additional discussion of
18 the meaning of the claim terms in the patent prosecution history, and it talks
19 about preserving the look and feel, i.e., functionality of browsing such pages
20 with a conventional browser. It talks about "providing a full web browsing
21 experience similar to that experience when browsing the same web pages
22 using a desktop browser."

23 Again, additional language also from the prosecution history
24 that talks about rendering a page substantially the same as the page appears

1 when rendered by a desktop browser.

2 We even have figures from the patent prosecution history that
3 shows a desktop browser and shows how that would be rendered on a mobile
4 device preserving the layout, functionality and design.

5 If preserving were simply preserving the web page as it were
6 first rendered on a mobile device, this comparison would have been irrelevant
7 but it's not. It's a focus of SoftView's discussion in the prosecution history.

8 And indeed, it's a focus of discussion in the same set of remarks
9 that defendants point to as purportedly showing that SoftView was defining,
10 preserving in such a way as not to require preservation of the desktop layout,
11 functionality and design.

12 JUDGE MCNAMARA: So what's this meaning then of the
13 language in the prosecution history where you say you preserved the overall
14 layout, functionality and design of the content. This refers to preserving the
15 design as interpreted by the browser, while at different zoom levels and
16 panned views as opposed to rendering the content as it would appear --
17 identically to how it is rendered by a particular desktop browser?

18 MR. LU: Sure thing. Let's jump then to DX-73, please. So
19 this is the language that Your Honor just read. And in particular, I would like
20 to focus on the last phrase that Judge Moore had asked about, which is "as
21 opposed to rendering the content identically to how it is rendered by a
22 particular desktop browser that may interpret the page design differently."

23 This quotation has been taken out of context by Petitioners in
24 arguing for their claim construction. And let's see why. So SoftView was

1 merely noting in Exhibit DX-74 that there were minor differences between
2 commercially available conventional desktop browsers.

3 Two pages earlier in that same set of remarks, SoftView stated
4 that even when rendering the same web page source code, i.e., the HTML
5 code definition of the web page, conventional web browsers may not render
6 the non-scaled web pages identically. And this makes sense, because you've
7 got web browsers made by Apple, Safari. You've got a web browser made by
8 Google, Chrome. You've got a web browser made by Explorer, Microsoft,
9 Internet Explorer. And they may render the web pages slightly differently.

10 What SoftView was saying is, look, you don't need to preserve
11 the identical page layout of Internet Explorer when you render it on a mobile
12 device. You simply need to preserve the look and feel of that. So that one
13 using an Internet Explorer web page on a -- who then switches over to a
14 mobile device would be able to see, recognize and take advantage of the user
15 interface, the knowledge that they gained using that same web page on a
16 desktop computer.

17 JUDGE MCNAMARA: So here is the problem. How close do
18 you have to keep the look and feel?

19 MR. LU: Well, the question becomes the following. You need
20 to preserve the look and feel so that a person using a web page would
21 understand that that was the same web page as the one that they were using in
22 connection with a desktop computer.

23 And the patent contains examples of what's necessary in order
24 to preserve that layout, functionality and design. So, for instance, forms.

1 Imagine going to a Google web page where one cannot enter a search term.
2 Would that preserve the layout, functionality and design? Absolutely not. It's
3 not the same web page. There's no forms.

4 The same would be true of an Amazon web page or an eBay
5 web page. How can you search for a tennis racket on an eBay web page if
6 there is no form that allows you to enter that? Frames. That's another
7 important aspect of web pages. A frame is basically a -- a web page often
8 consists of multiple frames, each frame displaying a different set of web page
9 content. Well if a web page -- if a browser did not support frames and only
10 showed you one of those frames or showed you one frame after one frame
11 after one frame on the top of each other as opposed to the layout that was
12 defined by the web page designer, that would not be preservation.

13 Columns. Mr. Chu gave the example of a five-column or
14 six-column New York Times web page. That again is something that is
15 required in preservation.

16 Tables. Tables are basically lists of information that are put
17 within a table. Again, a very, very key feature. For instance, on ESPN where
18 folks are -- go to check box scores and baseball statistics.

19 The list can go on. But the basic idea is that there are certain
20 key aspects of HTML tags that are central to preservation. The ones I gave
21 you are good examples. The patent provides others.

22 JUDGE MCNAMARA: I guess the Petitioner had shown us a
23 couple of examples. I think there was an example with a couple of columns
24 and the columns looked a little different. And so is that preserving the

1 original layout and design?

2 MR. LU: Well, I'm glad you asked that, because that's actually,
3 what I was going to discuss next, Your Honor.

4 JUDGE MCNAMARA: Okay.

5 MR. LU: But let me -- so can we go to Exhibit DX -- the
6 1054-29?

7 (Pause.)

8 MR. LU: So while we're putting that up, I believe that the slide
9 that I'm going to be putting up would be the one that Your Honor was
10 referring to. It was a comparison of the Internet Explorer web page and the
11 Netscape Navigator 9 browser, and there were a couple of boxes that were
12 colored in blue and in red. So let's take a quick look and see exactly what's
13 being discussed here.

14 Can I get Exhibit 1054-26? Now, Mr. Cohen talked quite a bit
15 about plug-ins, and that's what's being shown in those two web pages, the
16 differences. And the patent prosecution history talks about that this doesn't
17 imply that all the content associated with the web page must be retrieved or
18 downloaded. Content may be referenced that is not supported by the
19 requesting browser. And that includes Flash, that includes TIFF, that includes
20 Active-X.

21 And, so if we can go to Exhibit 1002_226? The patent
22 prosecution history goes on to say when it describes these two browsers that
23 Mr. Cohen had shown in Exhibit DX-29, that we're talking about an Internet
24 Explorer 7 browser where certain features have been disabled for security

1 reasons and it is also missing some plug-ins.

2 And so the practice perspective, if you can go to 1002_229, is
3 that when that Wall Street Journal page that was being displayed on Netscape
4 Navigator and on Internet Explorer was shown, the example web page
5 included various embedded non-HTML content requiring support of one or
6 more plug-ins.

7 So if you could go to advertising slides, as well. Similarly, you
8 were taught -- that was the lower right-hand corner of the red box. Similarly,
9 when you talk about the upper right-hand corner of the red box, that was an
10 advertising AT&T and the patent prosecution history at PX1002-230 to 231
11 indicates that that source code for the AT&T advertisement in the upper
12 right-hand corner is blocked via a security setting.

13 Okay. What do we have here? We have two web pages that
14 look differently. And the reasons for the difference is because of security
15 settings that are turned on or off depending on the browser and because of
16 plug-in content, which the patent specification made clear in bold was not
17 HTML content.

18 JUDGE MCNAMARA: Excuse me. Pardon me. Before you
19 put anything up, can we find out, A, what it is you're putting up and whether
20 or not there is any objection to it?

21 MR. LU: Sure. We were putting up the claim language, which
22 was in one of the slides that we provided to petitioners. And I don't need that
23 if it's going to delay things. Why don't we --

24 MR. COHEN: As long as you represent that's the claim

1 language.

2 MR. LU: Yes, it's the claim language.

3 MR. COHEN: That's fine.

4 MR. ALEMANNI: The only objection I have is I can't see it
5 from here so it's not clear to me what we're --

6 MR. COHEN: Is that from certain of your slides?

7 MR. LU: Yes, it is.

8 MR. COHEN: Can you just pass us a note to let us know what
9 one it is?

10 MR. LU: Sure. So we're talking about two different web
11 pages. Which the differences --

12 JUDGE MCNAMARA: Hold on a second. Is it possible to
13 turn it just a little bit better so that it faces -- sort of perpendicular to where it
14 is right now?

15 (Pause.)

16 MR. LU: So we're talking about two different web pages
17 whose differences could be attributed to either turning off or on security
18 settings for plug-ins. And the key point that we would make here is that
19 plug-ins are not HTML content.

20 That was made in the slides that -- in the prosecution history.
21 Not once but twice. If you could pull up Kyocera PX-1002_231.

22 (Pause.)

23 MR. LU: "Plug-ins may be required to render non-HTML
24 content that is embedded in some web pages or used in a separate window

1 launched from a web page. Notably, the plug-in content is not a web page."

2 Well, if you take a look at the claim language -- and I'm just
3 putting up exemplar Claim 1 right now, what the patent talks about is
4 requesting access to the original web page comprising HTML-based web
5 content translating that HTML-based web content from its original formatting
6 to scalable content and preserving the original page layout, functionality and
7 design whose antecedent basis

8 is simply HTML-based web content.

9 So the differences that Mr. Cohen pointed to in those two
10 respective web pages are not HTML -- based out of HTML content. What the
11 patent specification was talking about is, look, the conventional desktop
12 browsers may render things differently. And it may render things differently
13 for one of two reasons. Reason number two is that plug-ins may be required
14 to render non-HTML content.

15 What is reason number one? Can you go to Petitioner's
16 1054-27? Well, number one is the fact that certain web pages, one made by
17 Safari of Apple, one made by Internet Explorer of Microsoft, might render
18 things slightly differently. And it's telling here that they focus on this
19 language even though the paragraph number two, which mentions that
20 non-HTML content and plug-ins is not part of a web page. That's covered
21 over.

22 And I think that that's very, very important for consideration of
23 what's going on here. The claims only require preservation of HTML content.
24 It does not require preservation of non-HTML content. It does not --

1 JUDGE WHITE: Counsel?

2 MR. LU: Which --

3 JUDGE WHITE: Counsel, let me interrupt.

4 MR. LU: Yes.

5 JUDGE WHITE: Are you saying that this is to the exclusion of
6 anything other than plain vanilla textual HTML tags? Does it exclude
7 scripting and things like that?

8 MR. LU: It is limited to HTML content that preserves the
9 layout, functionality and design of the web page. It excludes things like
10 plug-ins. It excludes things like active scripting.

11 JUDGE MCNAMARA: So the HTML content then that puts
12 the box where it's located on that page is covered by this claim, but whatever
13 is inside that box, if it has to be put there by a plug-in, is not?

14 MR. LU: That's correct. And in fact, the patent prosecution
15 history discusses how a box where the plug-in content might appear is
16 rendered because that is HTML, but the content within that box is not
17 rendered in the case of the Microsoft Explorer because that is a plug-in.
18 Okay?

19 So I just wanted to turn back to another slide. DX-70. And part
20 of the reason why I think this is important to conclude SoftView's discussion
21 of the prosecution history is because this is a notice of allowance from the
22 examiner providing his broadest reasonable interpretation consistent with the
23 patent specification. And he says the claimed invention advantageously
24 provides a finer level of detail when displaying HTML web pages designed

1 for desktop computers on a small screen device. The patent examiner in the
2 case who saw the demonstration and read the prosecution history to allow
3 these claims had the same understanding as SoftView.

4 I'd like to turn to PX 1026_28. Now, in Mr. Cohen's
5 presentation he mentioned that the Petitioners were forced to address this
6 brand new 180-degree claim construction argument because this never came
7 up in the district court case.

8 And what I've pulled up is actually Petitioners claim
9 construction briefs in the district court case where they actually argued for the
10 claim construction that SoftView took in the district court case and that
11 SoftView is taking here before the Board, which is the argument that the
12 original layout of the HTML as requested by the browser cannot necessarily
13 be the layout as it would appear in that browser as SoftView asserted during
14 prosecution because such layout is not yet determined when the HTML is
15 requested. "Instead, original must refer to layout as viewed on a conventional
16 desktop browser, which is how the HTML is defined at the time of request,
17 i.e., before it is interpreted by the browser in question."

18 Now, as I mentioned SoftView never asserted what Petitioners
19 are claiming we asserted in prosecution, but the rest of this is 100 percent
20 correct. And it shows -- illustrates that the broadest reasonable construction
21 cannot encompass Petitioners claim construction because they've indicated
22 that it must be limited to determining the layout as viewed on a conventional
23 desktop browser.

24 In other words, that there is no dispute that original refers to

1 how a web page was defined to be shown on a desktop browser. I just wanted
2 to go to one final slide, which is DX-80 on this particular issue.

3 And DX-80 again cites that portion from the summary of the
4 inventions that I mentioned earlier about maintaining the look and feel of
5 browsing such pages with a conventional desktop browser. And this indicates
6 that there is no dispute that original refers to how the web page was defined to
7 be shown on a desktop computer.

8 Well, the interesting part is this comes straight from Petitioners
9 claim construction slides in the District Court. So if we're going to be
10 pointing fingers here, it's clear that it's Petitioners who have done a 180 in
11 changing their claim construction. It was SoftView that was quite surprised
12 when they came up with this brand new argument in the reply brief.

13 Let me just take a few moments to address a couple of other
14 minor points. Petitioners brought up the Dr. Grimes' declaration. As you
15 know, Dr. Grimes -- that was in the reply declaration for addressing the
16 motion to exclude, but that's also disfavored extrinsic expert witness evidence.

17 And Petitioners also brought up the argument that one has very
18 little control over the design of the web page. Well, we dispute that notion
19 and it's -- the patent clearly teaches otherwise. And I believe the Board's own
20 experience navigating on various web pages, you know, which has specific
21 branding. Google being one, Amazon being another, ESPN, CNN, New York
22 Times being others would illustrate that it's not a completely random process
23 as Petitioners seem to suggest as to how layout, functionality and design
24 would appear on a mobile browser compared with the desktop browser.

1 We pause here and ask if there are any questions relating to
2 claim construction? Thank you. Turning things back over to Mr. Chu.

3 JUDGE MCNAMARA: Thank you very much.

4 MR. CHU: Good morning again, Your Honors. I'm going to
5 discuss the PAD++ and the Zaurus combination. And if we can pull up
6 DX-81, please? Okay. This just shows where we are in the overall
7 presentation. And just as a reminder, there are two key types of claims.
8 There are the preserving the HTML content with the layout, functionality and
9 design. And then there are other claims, some of which also include the
10 preserving limitation that have the smart zooming, the context-base tap to
11 zoom to a column or tap to zoom to an image as an example.

12 Now, let's start with the PAD++. By way of background,
13 what's the problem that they were trying to address with respect to all of the
14 discussion in, I think, the nine references with respect to web browsing.

15 They had to believe that human beings would be utterly
16 confused if they jump from one hyperlink to another, and that they had to
17 have a sense of how they got to the particular web page they were.

18 And they wanted to be able to show this on a desktop screen.
19 So here is an example of the screen in DX-94. And what we're showing in
20 that box is from one of the Bederson references. And you can see that there
21 are boxes of rectangles. Each of them represents a different web page and we
22 have gotten to a particular web page that is highlighted.

23 A way to think about this metaphor is if someone took a trip
24 down Old Route 66. Someone might say, well, I was in Arizona. Then I

1 turned off the road and I went to visit the Grand Canyon. And I have some
2 photographs, so I put it up on my bulletin board. That's the equivalent of a
3 screen here. And then I took some pictures of a cactus. And I put the picture
4 up on the bulletin board. Same thing someone knows where they traveled by
5 these pictures of the different websites.

6 So here we're seeing -- in DX-95, we're seeing a Yahoo page.
7 And there is no evidence of original Yahoo page layout, functionality and
8 design in PAD++. Opposing counsel said something really quite interesting.
9 Interesting from a legal perspective. He said, well, there is no evidence of
10 what the original layout, functionality and design of the Bederson home page
11 is, and somehow suggested that it was on the Patent Owner's burden to show
12 what that original was. And then he proceeded to argue that the Bederson
13 home page in fact preserved the original layout and functionality and design.

14 I would suggest, politely, that the burden is on the Petitioners
15 not only for this entire proceeding, but if they're relying on the Bederson
16 references to show that they preserved the original layout, functionality and
17 design, they would have to show it.

18 We can see on this Yahoo page, this looks almost as if it was a
19 Frankenstein creation. It looks nothing like a Yahoo page that was ever
20 created for a desktop browser. Now, we asked the Petitioner's expert,
21 Dr. Grimes, about this. And he said in Slide 99, "Well, I'm not sure what the
22 original layout is." We asked him again and on the same slide he said, "I
23 don't know what the original layout was," answering a question specifically
24 about that Yahoo page, so --

1 JUDGE MCNAMARA: Can you go back to the previous slide
2 for just one second?

3 MR. CHU: Yes.

4 JUDGE MCNAMARA: Okay. So that's DX-98. And you
5 were talking about that -- that picture of Yahoo there?

6 MR. CHU: Yes.

7 JUDGE MCNAMARA: That particular display, as I
8 understand it, and from the way you described what Bederson was trying to
9 accomplish is not really a display that is designed to show the Yahoo website.
10 It is designed to show the user where he's been. So is that -- does that have
11 any implication here?

12 MR. CHU: It's a big difference, Your Honor. The other boxes,
13 of course, are designed to show where someone has been. You can't see much
14 content on this particular slide. The box that is blown up, you can see the
15 content. And that is the way that PAD++ would render the website.

16 And as I think Your Honors know, the PAD++ has
17 old-fashioned double zoom. It could blow up that box so that its dimensions
18 would fill the screen of the display for PAD++.

19 Remember, again, the display is a conventional desktop
20 browser display, so it's a relatively large display. The layout, functionality
21 and design of what we see here, the Frankenstein version of the Yahoo page
22 doesn't somehow magically convert into the beautiful robust HTML version
23 when that's blown up. It is just zoomed and blown up as described in the
24 Bederson references.

1 JUDGE WHITE: Counsel?

2 MR. CHU: Yes.

3 JUDGE WHITE: If this particular application was designed for
4 use on a desktop, then would this not qualify as an original layout that's for a
5 desktop browser since this is what was viewed on a desktop?

6 MR. CHU: One could view it either way, but let's take it in the
7 context of what's described in the patents at issue. What they are describing is
8 how it is viewed on a conventional desktop browser. In other words, they
9 discuss Netscape Navigator, Internet Explorer and other kinds of things like
10 that.

11 Now, let's suppose that all of us, the four of us, we got together
12 and said, Let's come up with some really crazy desktop browser that knocks
13 out every other piece of text, knocks out every other image.

14 Well, I don't think that has any place or -- in this particular
15 discussion. But, in fact, the key question here is did PAD++ preserve the
16 original layout, functionality and design even on its desktop browser? And it
17 didn't. It threw away key tags for HTML. Let me get you some examples of
18 those key tags.

19 JUDGE MCNAMARA: Before you do that, I promised I
20 would remind you when you've used up 45 minutes.

21 MR. CHU: Thank you very much. But I assigned 31 of those
22 minutes to Mr. Lu. An example is the form. That's the search box in Yahoo.
23 That's the billing information from my Amazon.com order. Those are
24 probably the two most popular features on the World Wide Web, at least

1 today and also at that time.

2 It throws away, doesn't do anything with columns as another
3 example. Centering. And we'll see some other examples along the way. So
4 here we see on DX-102 a list, no forms, no tables, no frames, no word list, no
5 text input fields.

6 Here on DX-120, Pad++ discloses a surface with multiple web
7 pages. In each page, this is key, is a single object in PAD++. And it is only
8 the objects, which are also called items in the Bederson references that can be
9 zoomed up -- oh, DX-110, excuse me. And I think I misspoke earlier. I was
10 really referring to DX-98.

11 All right. This is DX-111. PAD++ treats an entire web page as
12 a single object. Now this is from the Bederson reference. And it says in part,
13 "We use the term object to mean a graphical entity that is manipulated as
14 whole by the system. This might be a compound object such as an HTML
15 page."

16 And elsewhere in the Bederson references, they make clear that
17 they sometimes use the word "item" to be the equivalent of "object." And if
18 there is any doubt, Dr. Grimes, the Petitioner's expert, in paragraph 16, makes
19 clear that he is using objects and items with respect to the Bederson references
20 as the same. That is an item is not a proper subset of a web page in the
21 Bederson references.

22 JUDGE MCNAMARA: Let me ask you one quick question
23 about the term "object," because it has been brought around a couple times
24 here. Are we using the term "object" to mean a whole page or elements of a

1 web page or what?

2 MR. CHU: So I'm right now, because it is used differently in
3 different references, I am --

4 JUDGE MCNAMARA: Okay.

5 MR. CHU: -- only defining how it is used in the Bederson
6 references. With respect to web pages, it makes clear, as we showed, it's from
7 Exhibit 1006 at page 120, I think. If that's not the slide number, that is the
8 actually exhibit. And it makes clear that the entire web page is one object.

9 Elsewhere they use the word "item" as equivalent to or the
10 same as "object." And when discussing whether they call it an object or an
11 item, zooming or using center or the center box commands, it is working on
12 the entire web page as a whole and not a part.

13 And, in fact, when Mr. Bederson and his colleagues was
14 thinking about the problem that the SoftView inventors solved, they were
15 thinking about it in a way that's 180 degrees different. They were moving
16 immediately to the left where the SoftView inventors moved 180 degrees to
17 the right, and the Bederson people made that explicit in expressed statements
18 in the exhibits before this court, and in black and white that they were
19 teaching away from the SoftView invention.

20 And let's call up in Exhibit 1006, page 104 if we can. So this is
21 from the Bederson reference and it's a zooming web browser. And let's blow
22 up the third paragraph. Now, this third paragraph is really quite interesting
23 and shows how they were teaching away from the claimed invention.

24 "While our browser supports multi-scaled representation of

1 existing HTML pages, we have also extended HTML to support multi-scale
2 layout within a page." Now remember what they were dealing with in most
3 of the reference is how to do and get a visualization across different web
4 pages all of which were single unified objects. Now they are beginning to
5 think about how can we look at something within a page?

6 And then they go on to say, "This extension multi-scale markup
7 language, MSML, is at an early stage of development." This is exactly
8 parallel to what the WAP group, the 13 leading companies was doing. They
9 said, let's come up with a new markup language. And if it takes off and we
10 get everyone in the world to write with a new markup WAP language, we will
11 be successful.

12 That's exactly what they're doing here. They are teaching 180
13 degrees away from what the SoftView inventors were doing. And notice how
14 powerful the thinking it of the SoftView inventors. They are not going to
15 require web page writers, designers to rewrite their web pages with a new
16 markup language. They're going to harness the power of the installed base of
17 the existing web page, so that a designer can design the web page, the layout,
18 functionality and design, using HTML and it can be transferred to a small
19 device and preserving that layout, functionality and design.

20 Continuing on with the slides where we left off. Pad++ does
21 not treat HTML columns or images as separate objects. In PAD++ zooming
22 occurs at the web page level. Now let's go to talk about the Zaurus pretty
23 briefly. This is just one example at DX-114, which indicates that Zaurus does
24 not preserve original page layout, functionality and design. And much more

1 is said in the Zaurus references about changes that they have with respect to
2 the normal HTML web page. Certain home pages would look differently,
3 fonts would look differently. Many, many different things would look
4 different.

5 So now these two principal references. We have Zaurus. It
6 doesn't preserve the original layout page and design of the HTML portions of
7 a page. And the same is true of Pad++.

8 Now let me see. This is a key limitation combining two pieces
9 of prior art, neither of which have this key limitation, doesn't lead to the
10 conclusion that that combination somehow is sufficient to invalidate those
11 claims that have the preservation limitations.

12 So let's go on to the smart zooming or the context-based
13 zooming. As mentioned before, one example is tapping on a column to zoom
14 or tapping on an image to zoom. Let's go look at Zaurus. Zaurus is now
15 DX-120 on the screen. Zaurus does not disclose zooming on a user-selectable
16 portion of display.

17 What does it have? It has a kind of zoom that is the
18 old-fashioned prior art dumb zoom. And this one is a real rickety zoom. It's a
19 toggle switch. You have two views. You toggle the switch to reduce or you
20 toggle it to magnify it. You can't do something in between. You can't make it
21 127 percent or 150 percent. It is really dumb zooming.

22 So if you want to zoom in on a particular column, the
23 right-hand column of a newspaper, you just can't do it by -- in the same sense
24 of just selecting the column and getting that column to fit across the display,

1 which are the words that are used in the actual claims.

2 Let's go to DX-123. Professor Reinman makes clear that
3 Pad++ only teaches zooming in and out of entire web pages. And let's go to
4 now DX-124. Pad++ does not disclose context-based tap-to-zoom claims. It
5 in fact throws away, doesn't use for any purpose, even rendering its
6 Frankenstein-like page, any of these like <col>, <col group>, <div> or
7 <table>, things that would allow someone to try and define a column as an
8 example. Well, if you can't even define a column, you can't possibly
9 tap-to-zoom on that column.

10 Professor Reinman also testified that he operated the Pad++
11 software and confirmed that the user cannot zoom in on a user-selectable
12 column or image. This is DX-126. Now, I want to go to DX-127. And note
13 one of the statements in the Board's decision, which is that "Pad++ discloses a
14 bounding box and commands such as center and center box to center and
15 scale items to fill a part of the screen as well as the ability to specify the width
16 of the items." And that by itself is a fair statement. But the problem is, the
17 bounding box, center and center box and other API commands, are not
18 context-based.

19 There is no teaching, and as I indicated earlier when they began
20 to think about it, they were teaching away by requiring the use of a new
21 markup language of their own.

22 JUDGE MCNAMARA: Excuse me. Just tell me a little bit
23 more about what you mean by "not context-based."

24 MR. CHU: Okay. I'm using the word "context-based" to be the

1 same as smart zooming. Here, for Claims 48, 51, 52 and 317 in the '353
2 Patent, that means in the cause of some of those claims tapping on a column
3 and having that column fit across the display.

4 Tapping on an image and having that image fit across the
5 display. Other kinds of zoom, if you tapped -- and I'm not speaking
6 specifically about Pad++, but other kinds of zooming, if you tapped or clicked
7 on it, it would just zoom it 125, 150 percent. But in fact, the Pad++ zooming
8 was even dumber because first it's treating the entire web page as one object.
9 But what it's doing is it's centering it and getting the entire web page to fill the
10 display. Well, that's nice but that's not even the same as regular zooming.

11 Let me make one other comment about their special MSML
12 language. Well, how would they go about doing that? That's a really tough
13 problem. They have to get people to use that language. Let's suppose that
14 Pad++ could be changed? Well, first of all, if we're going to change it, it's not
15 part of their teaching. And let's suppose we could use a bounding box, again
16 not taught at all, to try and focus on a column. Not taught at all.

17 Well, if you could do that and zoom on it, you only get
18 paragraph one. Now you have to go and write some code to be able to get
19 paragraph two or paragraph three. You can't just scroll down. And you have
20 to do this for each part of the six New York Times columns that the user
21 might want to watch. You're writing a lot of code just to read the New York
22 Times. It's much easier to go to the newsstand and buy the New York Times.
23 But now you've done it for one web page and you pat yourself on the back.
24 Well, there are billions of web pages where nobody has done anything like

1 that.

2 So you see Pad++. Okay, good for the metaphor of traveling
3 down Route 66. Really bad for context-based or smart zooming. So I'm
4 going to discuss the fact that there was no motivation to combine these two
5 references.

6 Again, I'm referring to now DX-136. This is Pad++ where
7 there are multiple pages and links between them and the use of large
8 zoomable information surface. I'm going to skip a slide or two here.

9 Here are on DX-141 the two references to PDAs. In the
10 340-plus pages of small typewritten Bederson references, that's it. Two
11 throwaway references. Hope that maybe we can use something with the
12 PDA. Is there any teaching of how to use it in a PDA? Not here, not
13 elsewhere. No place else in the reference is there any teaching.

14 We could stop there, but there is more than that. And let's go to
15 DX-142 where Professor Reinman makes clear that based on his review of the
16 Bederson references the lone phrases do not disclose implementing a
17 zoomable web browser on a PDA, nor would one of ordinary skill in the art
18 understand that.

19 And on DX-143, Pad++ comprised a number of divergent
20 elements including PadDraw, portals and lenses. Now we haven't discussed
21 this very much, but these are things that perhaps might be or hoped for in
22 terms of rendering on a small display by Pad++. Nothing to do with the web
23 browser at all.

24 Okay. Now, we're going to try to combine this with Zaurus,

1 which was slow, 60 megahertz versus the 200 megahertz Pentium Pro
2 platform, which was really a speedy Ferrari at the time for the Pad++ prior art.

3 Zaurus was also a very low resolution. Now, what are the
4 requirements for Pad++ if we're going to port it? This is DX-145. Well, they
5 want to maintain the smooth, real-time interaction because they want to have
6 this animation metaphor. It uses a lot of computer resources. And basically
7 the Pad++ developers, Mr. Bederson and others, conclude we're using up all
8 our resources besides the fact that we've thrown away a lot of the HTML
9 information and it doesn't work.

10 And after a while they go another way and they start talking
11 about Jazz. And they go on trying to take their work to a different level, but
12 they give up on using Pad++. It just doesn't work with the speediest Ferrari.

13 So here it is, they're talking about Jazz. And this is DX-146.
14 And I'll just go to the second highlighted part. "This makes Pad++ difficult to
15 port to either different operating systems or different graphics systems in a
16 clean manner." So we got the Pad++ inventor saying, hey, it doesn't work to
17 port it to some smaller slow device.

18 We already showed that doctor -- Professor Reinman had the
19 same idea. So that's two. Two to zero. Now, let's go the Apple executive
20 Scott Forstall. Brilliant man. You can find reams of information about him.
21 One of the top designers and the designer of the iOS for Apple. Senior vice
22 president at Apple from 2007 to '12. Steve Jobs' right-hand man.
23 Responsible for creating the iPhone's iOS platform. DX-150.

24 Now, I'm going to go to DX-151, 152, and 53. This deposition

1 is taken in the district court litigation where Apple is a defendant. So he's got
2 a certain incentive to be consistent with the Apple point of view, and he's
3 asked a series of questions. And I'm going to paraphrase part of what he said:

4 "One challenge had to do with the content that was created for a
5 window size significantly different from a mobile phone. There were
6 challenges related to the performance of a processor."

7 He goes on to say, "There's many different challenges we had
8 with the iPhone which are different from a desktop. They revolve around a
9 number of different features, including the size of the screen, the computing
10 power, the touch screen and the like."

11 "Question. So in light of these and potentially other challenges,
12 is it fair to say you couldn't just take a web browsing solution for a desktop
13 and just port it to a mobile phone?"

14 Answer by Mr. Forstall, "Correct." So now we have Mr.
15 Bederson, Professor Reinman and Scott Forstall, who is a senior executive at
16 Defendant Apple, all saying "we would never combine this."

17 Now there is certain else interesting mentioned in the brief.
18 One of the great leaders in displaying computer technology and ease of
19 human interaction was Xerox. And everyone is familiar with Xerox PARC,
20 Palo Alto Research Centers. They tried using the tickle language, the same as
21 Pad++ language on a small device and the small device was called the PARC,
22 P-A-R-C, tap, and it just didn't work for them. And they went in a different
23 direction.

24 In short, there was no motivation to combine. Everyone was

1 really going in different directions. So here is the sum. We have Zaurus and
2 Pad++, neither teaches preserving. Neither teaches smart zooming. Combining
3 them doesn't make either preserving or smart zooming obvious, much less
4 both of them. Thank you. Now, I'll turn it over Mr. Heinrich.

5 JUDGE MCNAMARA: Okay. Just so you know, there's about
6 24 minutes left.

7 MR. HEINRICH: Good morning, Your Honors. I'll make the
8 best of what my colleagues have left me. So I'm at looking --

9 JUDGE MCNAMARA: You won't be the first.

10 MR. HEINRICH: So I'm going to say a few remarks about the
11 Hara prior art reference. Petitioners have not raised that in their presentation
12 this morning, but I just want to make a few points about Hara. That's
13 Exhibit 1008.

14 Now, if we can pull up 1008, page 22.1? So just as a little bit
15 of background, Hara is one of the references that Petitioners are combining
16 with Zaurus. They are basically two sets of combinations here. One is the
17 Zaurus Pad++ set of combinations and the other is the Zaurus plus Hara set of
18 combinations with a few additional references. And as we saw with the other
19 set of combinations, the Hara/Zaurus combination also don't include --

20 JUDGE MCNAMARA: Hold on just a second.

21 MR. CHU: Mr. Heinrich is like Oz. He's such a powerful
22 orator he echoes in the chambers.

23 JUDGE MCNAMARA: Ready to go? We can proceed.

24 MR. HEINRICH: Thank you so much. So the Hara/Zaurus

1 combinations likewise fail to disclose all of the elements of the SoftView
2 claims much less make those claims obvious.

3 So Hara was addressing a very specific problem. And that
4 problem was displaying an image that was designed for a low-resolution
5 screen on a higher resolution screen. And what Hara says here in paragraph
6 four -- this is Exhibit 1008 at page 22, "Is that when a low resolution data
7 is displayed on a high resolution display device, the display area becomes
8 extremely small. In WWW data often data such as maps and the like are
9 generated as image data and thus it has become -- thus it has been quite likely
10 that when this data is displayed, it becomes impossible to read."

11 So you have an image that's designed for a low-resolution
12 device that shows up as too small on a high-resolution display. So Hara
13 teaches a system that automatically resizes the image to match the higher
14 resolution display and then displays it on the device.

15 If we can go to Slide DX-158, please? So Hara says here, "The
16 present invention provides an information processing device capable of
17 converting the display size of image data in accordance with the
18 resolution of the display screen, to display in a size that can be recognized
19 by the user."

20 And what happens in Hara is that the image is resized in the
21 background before it's displayed. So you can think of Hara as correcting the
22 size of the image and then sending the data to the video RAM and then to
23 display.

24 Once its displayed, there is no disclosure whatsoever about

1 changing the size of the image because the problem that Hara is addressing
2 has been fixed at that point. So there is no zooming on images disclosed in
3 Hara. There is no rendering images at multiple zoom levels. In fact, for that
4 reason, there's no scaling of images whatsoever in Hara. In addition --

5 JUDGE MCNAMARA: I'm a little confused by that. You just
6 explained that Hara is taking an image that on a low-resolution device I can
7 read it, but I can't read it on a high-resolution device. And then doing
8 something to it so that I can read it on a high-resolution device presumably
9 making it larger. But that's not zooming is what you're saying?

10 MR. HEINRICH: That's correct because it only ever shows up
11 at the converted size. So it's showing up as a single size on the display and
12 there's no provision in the Hara reference to change the size of the image after
13 it's displayed.

14 So you're really just correcting the image size so that the image
15 size matches the resolution of the screen.

16 JUDGE MCNAMARA: Okay.

17 MR. HEINRICH: There is also no disclosure in Hara of
18 resizing any other elements in a web page. Hara is only directed to resizing
19 images. So there is no disclosure of, for example, producing a scalable
20 resolution-independent representation of a web page as claimed in Claim 1.

21 Now, further, because Hara is only resizing images and not any
22 other elements in the web page, such as texts or the like, there's no disclosure
23 in Hara of preserving the original layout because what Hara discloses is you
24 change the image size in the background before display, and then you may

1 have to rearrange the rest of the elements on the page.

2 So if we can please turn to Slide DX-164? Hara says in
3 paragraph 84 of the reference, "Note that when the image data and the other
4 data overlap due to the resolution conversion of the image data as set forth
5 above, then it is necessary to take action such as changing the display location
6 of the other data so as not to overlap the image data."

7 So Hara is teaching changing the layout not preserving it.

8 JUDGE MCNAMARA: But does Hara change the layout or
9 does Hara -- although Hara changes the layout, let me give you that, does it
10 somehow -- does it somehow sort of preserve the look and feel? I mean it's
11 just moving things around so they don't overlap?

12 MR. HEINRICH: Well, so to back up, there is -- there are two
13 reasons why there is no preservation in Hara. One is because it changes the
14 layout as this passage makes clear.

15 The other is that there is no translating going on in Hara.
16 Because the claim requires translating the HTML content into this scalable
17 resolution-independent representation of a web page and then preserving as
18 you render that translated web page.

19 None of that is going on in Hara because there is just a resizing
20 of an image and there is no resizing much less translating of a web page into a
21 scalable representation in Hara. So let's actually go to Slide 169.

22 Now I want to focus on Figures 8(b) and 8(c) because in the
23 decision granting the IPR, the Board stated, "Hara in Figure 8(c) discloses an
24 image selected by a pointing device that is scaled to fit across the width and

1 height of the screen."

2 So I want to focus on this, because the Board, respectfully, was
3 incorrect in the analysis of the Hara reference. If we can go to page 1008,
4 page 30, and we'll pull up in a little bit more detail Figures 8(b) and 8(c)?

5 What we see in Figure 8(b) in Hara is really a representation of
6 the problem. 8(b) is showing us an image that was designed for a lower
7 resolution display that's now being displayed on a higher resolution
8 display.

9 And what we see is the image is being displayed smaller than it
10 should be. So this is what's happening in the conventional system that doesn't
11 make use of Hara. What Hara describes is in the background, before we ever
12 see anything like 8(b), changing the size of the image so that it shows up on
13 the screen in the first instance the way it is in 8(c).

14 So let's take a look at the corresponding text in paragraph 41.
15 So Hara states, "Here the present invention has the distinctive feature that low
16 resolution image data that is conventionally displayed as shown in Figure
17 8(b)" -- again, that's the way it's going to be without Hara. Instead with Hara's
18 invention, "Will be displayed in accordance with the resolution of the display
19 screen, the display size of the application, as in Figure 8(c)."

20 So we can go to the next slide, please? Slide 171. So there is
21 no disclosure in Hara selecting the image in 8(b) and zooming on the image to
22 get 8(c). It's just resizing it in the background to avoid the problem of having
23 the image that appears too small.

24 And Professor Reinman laid this out in this declaration. He

1 stated, this is DX-171. "There is no disclosure in Hara" -- let's go back to
2 171. "There is no disclosure in Hara of a user clicking on the image in Figure
3 8(b) with a pointing device and then resizing the image as shown in 8(c)."
4 And that opinion from Dr. Reinman has been un rebutted in this proceeding.

5 So with my little time left, I want to turn to the motions to
6 exclude. And there are three main issues here. First, the Petitioners made a
7 strategic decision to rely on in their petitions expert declarations that were
8 submitted in a different proceeding that raised different issues that were
9 submitted by different requesters.

10 Now in these proceedings, as we know, every single ground of
11 rejection involves a combination with the Zaurus reference. In Dr. Grimes'
12 opening declarations, he did not say a single word about Zaurus. He didn't
13 express any opinions about Zaurus whatsoever. And instead, what Petitioners
14 did is they saved all of Dr. Grimes' opinions on Zaurus for their reply brief.
15 Since every combination of Zaurus involves every rejection involves an
16 obviousness combination with Zaurus, that means that Dr. Grimes did not
17 opine on the ultimate issue of obviousness until the reply papers were
18 submitted depriving SoftView of an opportunity to respond.

19 I mean we know from the Board's rules that new evidence in
20 reply is not allowed if it could have been raised in the opening papers and if --
21 or if it goes to the Petitioner's prima facie case.

22 We would submit that both of those provisions were violated
23 here, clearly since every single combination involves Zaurus, those new
24 opinions for the first on Zaurus go directly to Petitioner's prima facie case.

1 Another major issue is that Petitioners waited until their reply to
2 raise a claim construction issue. Now we've heard Petitioner's counsel to say
3 that they were shocked to see SoftView's claim construction positions in our
4 opposition. Well that's curious because as Mr. Lu demonstrated, SoftView
5 took exactly the same claim construction positions in the District Court
6 proceeding and, in fact, in those proceedings, Petitioners agreed with
7 SoftView's interpretation of what the original was that needed to be preserved.

8 So they knew full well what our claim construction position
9 was, but they waited until the reply to raise it. Now that presses us in at least
10 three ways. We appreciate the Board's opportunity for the five-paged claim
11 construction brief. But first, we did not have an opportunity to put in any
12 evidence, any expert evidence on claim construction, whereas Dr. Grimes
13 waxed poetic on claim construction in his reply declaration over more than 10
14 pages.

15 Two, we did not have the benefits of knowing that Petitioners
16 would do a 180 on claim construction when we were doing our prior art
17 analysis. And three, and most significant, is that there is a reason why Rule
18 104 of this body's rules says that the petition must include a section on how
19 the challenge claims are to be construed. And that reason is that one of the
20 first due dates in an IPR proceeding is a date for a motion to amend claims.
21 So the Petitioners have to put the Patentee on notice how the claims are going
22 to be construed, according to the Petitioners, so the Patentee can decide
23 whether to file a motion to amend.

24 Well, why is that meaningful? Well think about the rule of

1 claim construction in these proceedings, the broadest reasonable
2 interpretation. Why is that the rule in prosecution or in re-examination or
3 now IPRs? Because these proceedings give the Patentee an opportunity to
4 amend its claims. But if Petitioners hide in the grass and they knew full well
5 what the Patentee's claim construction positions are and raise those claim
6 construction issues for the first time in reply, they deny the Patentee an
7 opportunity to consider whether to file a motion to amend.

8 So finally, just briefly, a third problem with the reply papers
9 from Petitioners is they raise five brand new piece of prior art. Dr. Grimes
10 even opined on the motivation to combine those five new pieces of prior art
11 with the prior art of record.

12 So, in sum, this was really an egregious example of improper
13 reply evidence on these three very vital points, and we would submit,
14 respectfully, that the Board is setting precedent here. We're in the early stages
15 of IPR and the Board has said that new evidence in reply will subject reply
16 papers to a total exclusion. That's absolutely appropriate here where the
17 Petitioners cited the Grimes reply declaration 37 times in their 15-page reply.

18 So Petitioners should be following the rules and putting forth
19 their prima facie case and evidence in support of it in their petition, putting
20 their claim construction positions in the petition so that Patentees have a full
21 and fair opportunity to respond and that did not happen here. So we would
22 respectfully request exclusion of both Petitioners' reply and the Grimes reply
23 declaration as well as the Grimes supplemental declaration.

24 JUDGE MCNAMARA: Thank you very much. You'll have

1 about seven minutes for rebuttal on the motion to exclude issue, if you
2 choose. All right. I believe there is about 34 minutes left for the Petitioner.

3 MR. ALEMANNI: Thank you, Your Honor. Again, my name
4 is John Alemanni. Ready? Your Honor, you asked a very important question
5 and that was, you asked Mr. Lu what it means to preserve. And I thought the
6 answer was very interesting. It's point out the major problem with the
7 construction that SoftView proposes.

8 He replied to you, and I think I quoted this accurately, "A
9 person would have to understand it was the same page." "A person would
10 have to understand it was the same page."

11 BJ, can you pull up DX-28, please? So here's two pages from
12 the prosecution history that we discussed at length before. The page on the
13 left is Netscape Navigator. The page on the right is Internet Explorer.

14 So would a person understand that the page on the right is the
15 same page as the page on the left? I mean would they put money on it?
16 Could they advise a client that the page on the right doesn't refer but the page
17 on the left does? I mean how do you explain the scope of that claim to
18 someone if the construction is, a preserve is a person would have to
19 understand that it is the same page.

20 I have no idea. You can take that down. Thank you. Mr. Chu
21 introduced a couple of terms during his presentation in relation to zooming.
22 One was context-based and one was smart zooming.

23 I'll note that neither of those terms appears in any claim. They
24 don't appear in the specification. The term context-based appears in the

1 prosecution history and I only found it once and it's in relation to semantic
2 zooming.

3 Semantic zooming is that when you go from different layers of
4 zooming on a page, the page changes. So if I'm looking at Washington, DC
5 or if I'm looking at Virginia, I may not see the roads that are present in
6 Alexandria. But as I zoom in, more detail appears.

7 So there were several terms that were brought into the
8 construction arguments that Mr. Chu made that are not anywhere to be found,
9 so I'm sure how that affects the scope of the claims.

10 Let me switch over and show another issue with construction.
11 Can you go to Patent Owner's Slide DX-59, please? So we argued in our
12 briefing that the Board is not controlled by the constructions in District Court.

13 When we agreed with SoftView or agreed not to object to their
14 proposed construction of the original, this is exactly why we didn't, because
15 we agreed with SoftView. You go to the New York Times web page on a
16 current browser. If you go to your iPhone and your Android device, you try
17 to pull up the same page on a mobile device, you're going to pull up a mobile
18 version of the web page.

19 Now when I did this last night, I pulled up a different version.
20 It actually had the video. It doesn't matter, we agree that when you pull up the
21 mobile version, the mobile version does not infringe this patent. That is why
22 we agreed to the term but it's not controlling here and it's not relevant to the
23 phrase preserving the original layout, functionality and design. You can take
24 that down.

1 JUDGE MCNAMARA: Let me ask you a question. As I
2 recall, during the discussion of this particular slide, DX-58, 59, there was
3 some references to a stripped-down browser or stripper browser I think is
4 what it's called.

5 MR. ALEMANNI: Right.

6 JUDGE MCNAMARA: Are you saying that what's shown here
7 in DX-59 is not a stripper browser, it is a different browser? It's a mobile
8 browser? What is it that you're actually saying? I know it's not your exhibit
9 but what do you understand this exhibit to show?

10 MR. ALEMANNI: So I don't know what a stripper browser is.
11 What this exhibit shows is that if there is a page on the left that was designed
12 for a desktop computer or for an iPad or for an Android tablet, something with
13 a larger screen or a billboard, whatever, a large screen device. And as the
14 New York Times has a separate set of web pages that it makes available on a
15 site called mobile.newyorktimes.com. So it's a different URL that the user
16 requests, brings up a different set of web pages. And those pages don't zoom.
17 The reason that we agreed with SoftView that that can't infringe is because
18 there's no zooming enabled on a mobile web page like that.

19 JUDGE MCNAMARA: Okay. I'd like the record to show that
20 you just highlighted that spot. Could you please go back to that highlight
21 again?

22 MR. ALEMANNI: Again, this DX-59, for the record.

23 JUDGE MCNAMARA: Yeah, DX-59. And what you're
24 highlighting -- tell us what you're highlighting there, please.

1 MR. ALEMANNI: That is the URL or the web address for the
2 page that is displayed on that mobile device.

3 JUDGE MCNAMARA: So it is mobile.newyorktimes.com.

4 MR. ALEMANNI: Correct.

5 JUDGE MCNAMARA: And that would be different, as I
6 understand what you're telling me, that is different from the New York Times
7 web page that might otherwise be displayed on a computer and then may be
8 ported over to the mobile device and expanded under this patent, correct?

9 MR. ALEMANNI: And that's absolutely correct and that's how
10 most major websites work now. If you go to ccn.com on a desktop, you see
11 cnn.com. If you go to CNN.com on a mobile device, then you go to
12 m.cnn.com, which is a different version from the website. I think most people
13 these days are familiar with the differences when they try to go with a small
14 device.

15 JUDGE MCNAMARA: So my understanding from what
16 you're telling me is this isn't the same web page?

17 MR. ALEMANNI: No, it's not. And then actually that brings
18 up another point. If we're done with the slide, I'll take it down?

19 JUDGE MCNAMARA: Yes, thank you.

20 MR. ALEMANNI: You can take it down. Thank you. I think
21 in Mr. Chu's presentation it's evident that we're confusing different things. So
22 Pad++, as I described, is a ca++ program. It's also a set of interfaces that were
23 built in various different languages. There were also many implementations
24 that were built. There were the browsers that Mr. Chu showed. There was

1 the software that Dr. Reinman downloaded. So there were a lot of different
2 implementations. But the fact that people use Pad++ to build applications
3 does not take away from the teachings of the references.

4 The conventional browsers all parse web pages. They all
5 identify elements in web pages. They all create bounding boxes to lay out
6 information. That's exactly what Pad++ did. They don't claim that was new.
7 They point out in the patent specifications that you can just go to the web and
8 download the source code for doing that.

9 It was all well known to display tags on the web page, display
10 them on the screen. The HTML standard is one of the things that the patent
11 references prior art, because it was out there.

12 One of skill in the art would know to go out and look at the
13 HTML tags in order to implement the tags. What is purportedly new about
14 the invention is the ability to take that layout information and then put it in a
15 way on the screen that you can zoom in and out.

16 Pad++ does just that. It takes bounding boxes, provides a set of
17 commands and allows the developer to build a browser application in which
18 you can zoom in and out of web pages.

19 The idea that Pad++ is a stripper browser is just incorrect.
20 Now, it did not implement all of the tags, that's true, but if you can bring out
21 PX-1006, page 152, please? And if you'll blow up the second paragraph. I
22 heard Mr. Chu mention this many times. Pad++ reads hypertext written in
23 HTML. That's what it does. If you write a browser in Pad++, it reads
24 hypertext written in HTML.

1 Can you pull up the Patent Owner's Slide DX-98, please? So I
2 just want to make one comment about this. So these documents were written
3 in the mid to late '90s. This is what web pages looked like back then. I mean
4 I know they look really cool now, but this is what they looked like. Now I'm
5 not saying everything is there, I'm not saying some of the tags weren't ignored
6 when that page was rendered, but it's not -- I can't really recall. Is it crazy,
7 loony or something like that. But it is not that. It's a web page. And that's
8 what web pages looked like in mid to late '90s. Nothing spectacular but you
9 could get where you wanted to go.

10 JUDGE MCNAMARA: Do you know whether the Yahoo!
11 web page at the time that that document was written, that reference was
12 written, if that's what the Yahoo! Web page looked like at that time?

13 MR. ALEMANNI: As I understand the way these documents
14 were put together based on a deposition of Mr. Bederson, they
15 downloaded web pages from the web and stored them locally and then
16 allowed the program to go through and process and just show them because
17 these were systems that they were building to explore different possibilities of
18 the widget. So I believe that that is a snapshot of a Yahoo! web page at some
19 point in time while they were doing development. I don't know in fact
20 whether they went out to the web or whether they actually had a local but I
21 believe that is in fact the basic instrumentally of the web page.

22 JUDGE MCNAMARA: That's kind of the question I'm asking.
23 Did Bederson or whatever manipulate the page or did Pad++ manipulate the
24 page or is this pretty much what the Yahoo! page looked like at the time?

1 MR. ALEMANNI: He didn't design the page but this is pretty
2 much what the Yahoo! web page looked like. There are things missing. As
3 SoftView's pointed out there are certain tags where in the programming it
4 says, okay, you see a form, so it recognized that there was a form in HTML
5 but then it would ignore it and actually put it on the screen but that's not what
6 they were trying to get at. They were trying to score other possibilities with
7 the teachings that Pad++ provided.

8 MR. CHU: Your Honor, because this is --

9 JUDGE MCNAMARA: I'm actually -- we'll come back to you
10 in a minute.

11 MR. CHU: Okay.

12 MR. ALEMANNI: Can you pull up the PX-111, please?

13 (Pause.)

14 MR. ALEMANNI: PX-111, please. I'm sorry, Slide 111. No,
15 their Slide 111. I'm sorry. I think it's the next slide actually. Yes. I just
16 wanted to point out on the left-hand side of this. This is the slide that they
17 referred to.

18 I made this exact point. Pad++ was able to treat objects, simple
19 objects. This is poly-line objects. It was also able to treat compound objects
20 such as an HTML page, which is what they have underlined. But if you
21 continue reading that, you realize that's actually a hierarchy. It's an HTML
22 page composed of characters and line segments and images. And it was
23 known by conventional browsers when you looked at an HTML page, you
24 would parse out those individual elements and put them in bounding boxes. I

1 just wanted to make the point that this supports that.

2 And then my last point, I'll turn it over to my colleague, Mr.
3 Cohen. Can you bring up PX-2031, page 2? And I think the second
4 paragraph, if you blow it up, Mr. Chu described Mr. Forstall's describing the
5 process in developing the -- I don't know -- I don't remember exactly how he
6 said it, but really difficult. We have no doubt that it was. I'm sure it was a
7 major undertaking. And he said that one of the features that the browser was
8 important. He may have thought that. That's not what made a consumer
9 demand and that's certainly not enough to draw a nexus to the claimed
10 invention. But I want to point out here that in 2005 this is exactly an exhibit
11 that SoftView provided. It's a background or bio on Mr. Forstall.

12 In 2005 when Jobs began planning -- excuse me, when Jobs
13 began planning the iPhone, he had a choice to either shrink the map, to take
14 desktop -- a desktop experience and shrink it, or enlarge the iPod. And he
15 favored the former approach and pitted those two teams together. The leader
16 of the iMac was Forestall. So the idea that you would take the teachings of
17 something like Pad++, even if it didn't say explicitly within the reference that
18 it can be put on a PDA, the idea that you could take a desktop browser like
19 Pad++, shrink it into a mobile device was definitely something that at least
20 Apple had thought about and actually the approach that they followed. At
21 least according to the material that SoftView provided.

22 And that's all I have, and I'm going to turn it over to my
23 colleague, Mr. Cohen. Thank you very much.

24 MR. COHEN: Thank you, Your Honor. I will try to be brief.

1 There is sort of an overarching theme that we see in SoftView's argument.
2 And it even goes back to patent prosecution, and that is mixing up the timing
3 of when we're looking at web pages.

4 As my colleague said, web pages are a lot different now than
5 they were back at the time of the alleged invention, back in 2000 or at the
6 time of Pad++. And web pages appear a lot differently now than they did
7 then.

8 And I want to bring up -- I'd like to bring up DX-30 again, our
9 Demonstrative Exhibit 30. 30. These pictures in the prosecution history of
10 these web pages -- and then -- and counsel, opposing counsel, pointed out to
11 pictures of PDAs from the prosecution history. Those screen shots that are in
12 the prosecution history, those are not found in the patent. They are not from
13 the patent.

14 Any attempt that they're making to use these, any attempt -- and
15 it's interesting. They were using screen shots made after the invention to
16 justify a limitation, preserve limitations that they didn't add until that
17 amendment. And that amendment was filed after -- after Apple came out with
18 the iPhone. And they talked about a demonstration. And the demonstration
19 took place over a year after Apple introduced the iPhone. They didn't submit
20 an affidavit of Mr. -- of the inventor saying that the software that's in the
21 device that we're using for this demonstration was created at the time of the
22 invention.

23 Opposing counsel said that the first thing that SoftView thought
24 of was when they went to do this zoomable browser was to preserve the

1 layout, functionality and design. Well if that's true, then why doesn't it appear
2 in the specification? Why wasn't it added until after Apple introduced the
3 iPhone? I would submit there is no evidence to support counsel's argument.

4 I'd like to -- if you can bring up their PX-61, please? Do the
5 claims require that all HTML code be translated? Not this one. DX-61, claim
6 1, "In response to a user request to access the web page, retrieving and
7 translating at least a portion of the HTML-based web content." What does
8 that mean? It doesn't say -- none of these claims say translating all of the
9 HTML code, not one. Not a single one.

10 Counsel was asked a question about the scripting language.
11 And if you could, bring up Exhibit 1001, and go to page 28. This is the '353
12 Patent. And if we could blow up that lower left-hand, the last paragraph there
13 on the lower left-hand column?

14 It says, "In addition to basic HTML web page documents may
15 contain XML as well as scripting" -- go up and pull up the top of column 8 --
16 "scripting language code such as Java script. However, for simplicity any
17 documents containing web page content other than only graphic content that
18 are discussed herein will be referred to as HTML documents."

19 So contrary to counsel's argument specification says HTML
20 does include scripting language. Now, I want to -- I want to reinforce two
21 things. Number one, if we can bring up exhibit -- our demonstrative
22 Exhibit 11, please?

23 My statement misinterpreted by counsel was that there is no
24 evidence that anything is missing from Mr. Bederson's web page. As my

1 co-counsel observed, web pages are different. Were a lot simpler back then
2 than they are now. And they have presented no evidence of anything that's
3 missing. And the clear import of our demonstrative Exhibits 11, 12 and 13,
4 which reflect pages 287, 289 and 291 of Exhibit 1006 is very simple. You
5 zoom in and out of Mr. Bederson's web page and the layout and design are
6 preserved. And Dr. Grimes says in his original declaration the functionality
7 was preserved. The hyperlinks worked. There can't be any dispute about that.

8 And you have to take this for what it teaches. Pad++ teaches
9 what? It teaches vector-based scalable graphics. And let's think about that for
10 a minute. Vector-based scalable graphics. You define vectors by -- in the
11 prior art by defining the relationships of the bounding boxes. You define
12 those by vectors.

13 That was all taking math. If you scale a vector-based drawing,
14 the layout is inherently preserved. It's a mathematical fact. It is sophistry to
15 say that this web page isn't preserved. It's nonsense. It's inherent in the use of
16 vectors.

17 Now, I want -- I want to talk briefly about motivation to
18 combine. And the point here is that under any interpretation this preserves
19 limitation, Pad++ teaches it. On the motivation to combine, we say there is a
20 motivation to combine not only because these various references, they
21 addressed a common problem. And what was the problem? It wasn't just -- it
22 wasn't confined to how do we display a web page on a small device, it was
23 how do we display a web page on different sized screens? And as it is in the
24 patent, and as the Pad++ -- as Pad++ authors said, it could be from a large

1 device to a small device. When you have various sized displays, you have to
2 solve the problem of how to display that web page so it looks good.

3 So and this is true of Pad++. It deals -- it teaches the problems
4 of scalable graphics. Zaurus is a PDA. The only thing different about Zaurus
5 and the PDAs that Dr. Grimes described in his earlier declarations is that
6 Zaurus also teaches zooming. We didn't need to put in any extra for that, it is
7 self-evident. I mean even I can understand that.

8 Now, I'd like to -- I'd like to bring up their Slide 70. Their --
9 SoftView's Demonstrative Exhibit 70. Now, they quote here a part of the
10 notice of allowance. And they use the phrase, "Under the broadest reasonable
11 interpretation of the claimed limitation consistence with the Applicant's
12 specification."

13 Well what was the examiner talking about? So why don't we
14 actually look at Exhibit 1002, page 55. Let's look at that. Let's see what the
15 examiner was referring to. Page 55, please.

16 Okay. So the examiner was referring to -- under the broadest
17 reasonable construction of the claim as a whole, they defined invention over
18 those three prior art references that were then at issue. Please take that -- go
19 back to the regular size.

20 And then in the last paragraph the examiner starts talking about
21 the reasons for allowance. "The claim invention takes HTML-based web
22 content in its original format which defines layout, functionality." She
23 underlines functionality. That supports a -- "it's a scalable content that
24 supports the scalable resolution-independent representation of the HTML

1 website. In other words, the claimed invention converts an HTML web page
2 into a vector-graphics web page and displays the web page on PDA." Hold it
3 right here.

4 In the re-exam, all of the claims that did not recite vector were
5 rejected. And the examiner wasn't convinced that Pad++ disclosed vector
6 graphics. And the re-exam stopped when this Board stayed them. The
7 examiner didn't have an opportunity to consider Dr. Grimes' declaration.

8 But the examiner said, Okay, you're using vector graphics.
9 That is the reason for allowance. Let's go to the next page, page 56. Okay.
10 Let's look at the top part of page 56.

11 She says, "Additionally, the claimed invention preserves the
12 functionality." Now she's talking about preservation, but she's talking about
13 functionality of a web page after it's been translated into a vector graphics
14 web page and displayed on a PDA.

15 All right. And then she cites Applicant's remarks on pages 91
16 to 94 of the response dated May 20, 2008. And what were those pages?
17 Well, I will tell you they are pages 231 to 235. And those are the pages --
18 those include pages 233 where they gave their definition. And 234 and 235
19 where they said that the definition they gave applies to all the different
20 renditions of preserved limitations.

21 Now I would like to discuss very briefly our response to their
22 motion to exclude. We think there is absolutely no merit to it. We disagree --
23 first of all, the phrase "preserves the original page layout, functionality and
24 design" was not -- was not at issue. The whole phrase was not at issue. The

1 construction of that phrase was not at issue in the district court. We agreed on
2 the construction of the word "original." We said "preserves" is indefinite.
3 But we did not think -- we did not think that they would -- that they would
4 accuse us of doing a 180. We think they did a 180.

5 Now, they talked about Zaurus. Zaurus is a PDA like any other
6 PDA. And Frank did -- Dr. Grimes gave opinions on PDAs. The only thing
7 that he didn't give an opinion on was a PDA that zoomed. We didn't need an
8 expert declaration on that.

9 The Bertek case that we cite in our opposition to their motion is
10 a case in which a patent -- a Petitioner didn't file a declaration in support of
11 his petition. And after the Patent Owner filed a declaration of an expert in
12 opposition, the Petitioner filed an expert declaration in reply and that Board
13 said that's okay. You can't expect the Petitioner to anticipate every issue that
14 the Patent Owner will raise in an opposition.

15 Well what about claim construction? The Board gave the
16 Patent Owner an opportunity to brief the claim construction issue. They
17 complained that -- they complained that they didn't have the opportunity to
18 submit an expert declaration. Well, a couple of things. One, Dr. Reinman
19 never discusses the prosecution history when he gives his opinion in the
20 opposition. Not once. You think he would have read it, referred to it? I
21 mean it boggles my mind that they can stand there with a straight face and
22 say, "We didn't have an opportunity." And here is the chicanery that can
23 result if the Board were to interpret the rule that they rely on so rigidly that
24 you can never raise a claim construction issue in reply. And that is, if you

1 don't raise a claim construction issue in the petition, it would be -- it would
2 just lay it wide open for the Patent Owner to argue anything they would want,
3 regardless of what the specification says, regardless of what the prosecution
4 history says, totally oblivious to how a claim might be properly construed.

5 We know from litigation and I know all of the judges are --
6 have litigation experience. That oftentimes in litigation claim construction
7 issues don't arise until the issue is joined. We often find in litigation that
8 claim construction issues arise even after a court's construed the claim. And
9 when you get down to trial, the parties raise an argument and the court says,
10 "Wait a minute. That raises a new claim construction issue." And the courts
11 always deal with it. It's an issue of law.

12 Now they claim -- they complain that Dr. Grimes gave an
13 opinion. His opinion was basically that one of skill in the art would
14 understand -- would understand the claim language as they define it, would
15 agree with the definition that they gave when they were prosecuting the
16 patent. And, in fact, they basically say so in the prosecution. So there is
17 nothing really unique about that but it is a question of law for you judges to
18 decide.

19 So what about Dr. Grimes in his reply declaration? He was
20 responding to what Dr. Reinman said. So basically what they're asking is,
21 don't look at our reply brief, don't look at anything Dr. Grimes said in his
22 reply declaration. Of course it would make your jobs a lot easier because you
23 would have less to read. We don't think that's fair. We don't think that's
24 justice. And we certainly don't think that that is the way the rules ought to be

1 interpreted.

2 And finally, they had every opportunity to take Dr. Grimes'
3 deposition after he filed his reply brief. Your Honor may recall we had a
4 conference call. And they said, "We want to depose Dr. Grimes." And we
5 said, "You don't need our permission. The rules provide for it. And we'll
6 make him available." They decided not to depose him. They could have
7 asked him all these questions. They didn't. They could have asked -- they
8 could have said, "Oh, if you're going to let us file briefs, we would like to file
9 another declaration of Dr. Reinman to address these claim construction
10 issues." We wouldn't have opposed it. They never asked. I mean I think
11 there's various -- in a sense, we are where we are because of the decisions
12 they made not because of what we did.

13 Now I have nothing in addition to add, except one more thing to
14 point out that I still don't understand how the claims would be construed if
15 you adopt their proposed definition. I think it would render the claims
16 indefinite but we win either way, but I think it's important. These claims are
17 invalid either way under the combinations that we've cited, but I think it is
18 important to decide this claim construction issue, as I said before, because
19 these re-examinations are pending and these examiners are going to have to
20 pull these up. We only have 20 claims out of about 380 claims at issue here,
21 and that the Board's decision is going to inform the examiners, so we think
22 that it is in the interest of judicial economy for the Board to decide this issue
23 in this proceeding.

24 So unless the Board has any further questions or any of my

1 colleagues want me to say anything else, I will -- I'll be done.

2 JUDGE MCNAMARA: Okay. I have no further questions.

3 Anybody else? Okay. Thank you. We have about eight minutes to hear from
4 the Patent Owner in response to the motion to exclude. There was an issue
5 that came up during the Petitioner's presentation concerning, I guess, the
6 Yahoo! thing and perhaps DX-59. Anyway, I will give you -- you can use
7 one of those minutes to address those two things.

8 MR. CHU: I'll use 30 seconds to address Yahoo! Can we call
9 up DX-103 and then DX-104? And this slide was not shown before, DX-103.
10 These are many of the HTML tags that were not implemented by Pad++. On
11 the right is Figure 5 from the Bederson reference, 1006_163.

12 Just pull up DX-104. In evidence Professor Reinman's
13 statement to the effect that many of these tags were not used at all and that, in
14 fact, the layout is different. And then, of course, as a reminder, when
15 Dr. Grimes was asked about it, he didn't know what the original layout was.

16 What I rose to do, Your Honor, was to object because in that
17 instance and other instances, there were representations made about what is in
18 the record. In that particular instance, I assumed that opposing counsel just

19

20 inadvertently made a misstatement about something that was in
21 the record. There is nothing in the record that shows the original layout was
22 preserved.

23 In addition, because forms and buttons, like search buttons on
24 Yahoo! were not use by Pad++, the functionality could not be preserved.

1 JUDGE MCNAMARA: Thank you. All right. Let's go to the
2 -- address the motion to exclude.

3 MR. LU: I was going to address DX-59.

4 JUDGE MCNAMARA: 30 seconds.

5 MR. LU: All right. Thank you, Your Honor. Could you pull
6 up the next one? So, Your Honor, this is simply a demonstrative. No one
7 uses stripper browsers anymore. So when we took the content from the
8 mobile website, it was simply to illustrate a stripped out content. And the fact
9 that that's all that Petitioners would require. It wasn't meant to show the
10 natural conversion.

11 JUDGE MCNAMARA: It probably would have been a good
12 idea if you told us that in the first place. Thank you.

13 MR. LU: Understood.

14 JUDGE MCNAMARA: Motion to exclude?

15 MR. HEINRICH: I'll be very brief. First, the Petitioners say,
16 well, they didn't expect the claim construction issue to arise here because
17 well, the whole phrase wasn't at issue in the District Court. The precise issue
18 that we're arguing about here is what is it that has to be preserved? Is it the
19 original as it appears on a conventional desktop browser or is it the first
20 rendering? And there was agreement on that point. So it is disingenuous to
21 say that the claim construction issue took Petitioners by surprise.

22 This is certainly not a case to make an exception to the Rule
23 104 that claim construction issues must be raised in the petition. And I would
24 just also point out that we were -- we didn't have the opportunity to put in a

1 sur-reply in response to their new evidence in reply. I think opposing counsel
2 suggested otherwise, but that's simply not correct.

3 And finally, the opportunity to depose the other side's expert
4 does not make up for our lack of ability to put in responsive rebuttal
5 testimony, expert testimony, rebutting the ultimate issue of obviousness that
6 they waited until the reply brief to put into evidence. That's all, Your Honor.

7 JUDGE MCNAMARA: Thank you all very much. I want to
8 thank you all for coming today and for a spirited argument, and actually for
9 your extensive knowledge of the record. It is very helpful to us. We'll take
10 the case under advisement. And does anybody have anything else?

11 MR. COHEN: No, Your Honor.

12 JUDGE MCNAMARA: We're adjourned. Thank you.

13 (Whereupon, the hearing concluded.)