



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,634	05/20/2011	7,461,353	SV.95000634	8853

59860 7590 04/06/2022
LAW OFFICE OF R. ALAN BURNETT
4108 131ST AVE. SE
BELLEVUE, WA 98006

EXAMINER

BASEHOAR, ADAM L

ART UNIT	PAPER NUMBER
----------	--------------

3992

MAIL DATE	DELIVERY MODE
-----------	---------------

04/06/2022

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple Inc.
Requester and Cross-Appellant

v.

Patent of SoftView LLC
Patent Owner and Appellant

Appeal 2021-005530
Reexamination Control 95/000,634
Patent US 7,461,353 B2
Technology Center 3900

Before ALLEN R. MacDONALD, ERIC B. CHEN, and
BRIAN J. McNAMARA, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ Related Appeal 2022-000153 (Reexamination Control No. 95/002,132) is directed to a reexamination of the same patent as this appeal. Patent Owner's Appeal Br. 1. This appeal and its related appeal are directed to the same issues. These appeals are decided concurrently. This decision has been incorporated by reference into the related 2022-000153 decision.

I. STATEMENT OF THE CASE²

Appellant appeals under 35 U.S.C. § 134 from a final decision of the Primary Examiner rejecting claims 2–28, 30–32, 34, 35, 37, 38, 41, 44–46, 50, 53–55, 60, 61, 69–83, 85–105, 107–111, 122–126, 128–135, 137, 140, 141, 144, 145, 147, 150–152, 154, 156–159, 161–177, 184–203, 205–209, 215, 216, 226–236, 238–242, 245–248, 251, 253, 254, 257, 259, 264–271, 274–277, 285–303, 305–310, and 318–321. We have jurisdiction under 35 U.S.C. § 315(b). We reverse the Examiner’s decision rejecting these claims.

Cross-Appellant appeals under 35 U.S.C. § 134 from a final decision of the primary examiner favorable to the confirmation/patentability of claims 106, 182, 204, 282, 304, and 322. We have jurisdiction under 35 U.S.C. § 315(b). We reverse the Examiner’s decision favorable to the confirmation /patentability of these claims.

II. INTRODUCTION

A. Background

U.S. Patent 7,461,353 issued December 2, 2008 from application No. 11/045,757, filed on January 28, 2005 as a division³ of application No. 09/878,097, filed on June 8, 2001, now U.S. Patent 7,210,099, which is a continuation-in-part of application No. 09/828,511, filed on Apr. 7, 2001, now abandoned. At filing, application No. 11/045,757 claimed priority to application No. 09/828,511 (still pending at that time). Normally, U.S. Patents 7,210,099 and 7,461,353 would have each had an expiration date of

² Hearing held on December 8, 2021.

³ Related U.S. Patent 7,831,926 issued November 9, 2010 from application No. 11/738,486, filed on April 21, 2007 as a continuation of application No. 09/878,097.

April 7, 2021. However, the term of U.S. Patent 7,210,099 was adjusted by 818 days to expire on July, 5, 2023, and the term of U.S. Patent 7,461,353 was adjusted by 376 days to expire on April 18, 2022.

As filed, application No. 11/045,757 contained sixteen (16) claims all directed to translating Web content from its original format into a scalable vector representation of the Web content.

During prosecution, amendments expanded the number of claims which then characterized the invention in essentially three ways.

- 1) translating at least a portion of HTML-based Web content from its original format into scalable content, and then scaling that scalable content while preserving the original page layout, functionality and design of the content;
- 2) processing HTML-based Web content to produce scalable content, and then scaling that scalable content while preserving the original page layout, functionality and design of the content at zoom levels and panned views; and
- 3) without limiting to either translating or processing, a) enabling a Web page to be browsed at various zoom levels and panned views while preserving the original page layout, functionality, and design of the Web content at each zoom level and panned view, or even more broadly, b) enabling a Web page to be browsed at various zoom levels and panned views.

As issued on December 2, 2008, U.S. Patent 7,461,353 contained 319 claims.

On May 20, 2011, Cross Appellant (Requester) filed a Request for Inter Partes Reexamination of U.S. Patent 7,461,353, which reexamination

95/000,634 is the subject of this appeal. On August 31, 2012, an unrelated Requester (Motorola Mobility LLC) filed a Request for Inter Partes Reexamination of U.S. Patent 7,461,353, which second reexamination 95/002,132 is not the subject of this appeal.⁴ On April 13, 2012, the present Cross Appellant (Requester) filed a separate Request for Ex Parte Reexamination (Control No. 90/009,994) of U.S. Patent 7,461,353.

On October 2, 2012, Kyocera Corporation petitioned for an *inter partes* review challenging the patentability of claims 1, 33, 36, 43, 48, 51, 52, 58, 59, 66, 118, 138, 139, 149, 183, 252, 283, and 317 of U.S. Patent 7,461,353. On March 29, 2013, the Board entered a Decision in IPR2013-00007 to institute an *inter partes* review on the challenges raised by Kyocera Corporation. Subsequently, IPR2013-00256, brought by Motorola Mobility LLC on April 29, 2013, raised the same challenges and later was joined to the IPR2013-00007 proceeding. All challenged claims were determined to be unpatentable by a Final Written Decision (FWD) on March 27, 2014.

We hold all of the challenged claims, i.e., claims 1, 33, 36, 43, 48, 51, 52, 58, 59, 66, 118, 138, 139, 149, 183, 252, 283, and 317 of the '353 Patent, are unpatentable under 35 U.S.C. §103(a). Specifically, the preponderance of the evidence shows that claims 1, 33, 36, 43, 48, 51, 52, 58, 59, 118, 138, 139, 149, 183, 252, 283, and 317 of the '353 Patent are unpatentable as obvious over the combination of Zaurus and Pad++. We further hold that

⁴ Additionally, related U.S. Patent 7,831,926, (term adjusted to expire June 15, 2023) is the subject of two inter partes reexamination appeals which are before this Panel. Per the agreement of Patent Owner and both Third Party Requestors (2022-000153/2022-000154 Hearing Transcript 52–53, and 2022-000716 Hearing Transcript []), the transcripts of hearings in all four related inter partes reexamination appeals are being placed in the record for each of the four related inter partes reexaminations.

the preponderance of the evidence shows that claim 66 of the '353 Patent is unpatentable over Zaurus, Pad++, and SVG.

We also hold that, under a preponderance of the evidence, claims 1, 33, 36, 43, 48, 51, 52, 58, 59, 118, 138, 139, 149, 183, 252, 283, and 317 of the '353 Patent are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Zaurus, Hara, and Tsutsumitake and that claim 66 is unpatentable over the combination of Zaurus, Hara, Tsutsumitake and SVG.

FWD 36–37.

The Board's FWD was then appealed to the United States Court of Appeals for the Federal Circuit by the Patent Owner. The Board's FWD was subsequently affirmed on February 9, 2015. *Softview LLC v. Kyocera Corp.*, 592 F. App'x 947 (Fed. Cir. 2015)(Rule 36). As a result, on January 12, 2016, the Office issued an "Inter Partes Review Certificate," thus indicating that further judicial review was not sought. The Certificate cancelled claims 1, 33, 36, 43, 48, 51, 52, 58, 59, 66, 118, 138, 139, 149, 183, 252, 283, and 317 of U.S. Patent 7,461,353. A "Cancelled Claim Appendix" containing copies of these cancelled claims is attached.

During the *inter partes* review, the processing of all reexaminations was stayed. That stay was lifted on November 27, 2015. Subsequently, Ex Parte Reexamination 90/009,994 confirmed amended claims 5, 23–27, 60, 61, 122, 137, 140, 141, 147, 156, 174–177, 238–242, 248, 259, and 274–277 to be patentable as amended, added new claims 320–322, and cancelled claims 84 and 220. The remaining claims were not reexamined. On December 29, 2017, the Ex Parte Reexamination Certificate for 90/009,994 was issued.⁵

⁵ Related U.S. Patent 7,831,926 has followed a similar path with two Inter Partes Reexaminations (95/000,635 and 95/002,126), an Ex Parte

B. Status of the Claims in the Present Appeal

The Claims Appendix of Patent Owner's Appeal Brief lists the status of the appealed claims. Patent Owner's Appeal Brief 68–134. However, as to numerous claims, the Panel disagrees with the status listed in the appendix. This distinction between issued and amended/new claims is not result determinative under the Panel's interpretation of § 42.73(d)(3)(i). *See* Section III. B.2.b).(2). *infra*. However, while the Panel disagrees, Patent Owner argues that § 42.73(d)(3)(i) is not applicable in a reexamination confirming a previously *issued* claim. Should Patent Owner's view ultimately prevail, then the distinction between issued and amended/new claims may be critical.

First, in amendments included in the Patent Owner's Amendment and Response filed on July 24, 2017, many claims were labeled as “(Amended).” These claims include claims 5, 23–27, 60, 61, 122, 137, 140, 141, 147, 156, 174–177, 238–242, 248, 259 and 274–277. Also, in the July 24, 2017 amendments, claims 320–322 were labeled as “(New).” All these claims are now labeled in the Claim Appendix as “(Issued).” We presume that Patent Owner is labeling all these claims as “(Issued)” based on the Office procedure for handling an ex parte reexamination certificate when there is, as here, a still pending unmerged inter partes reexamination. The MPEP states:

Reexamination 90/009,995 (affirmed *In re Softview LLC*, 847 F. App'x 930 (Fed. Cir. 2021)(Rule 36)); and two *inter partes* reviews IPR2013-00004 and IPR2013-000257 (affirmed *Softview LLC v. Kyocera Corp.*, 592 F. App'x 949 (Fed. Cir. 2015)(Rule 36)). We do not otherwise discuss herein Patent 7,831,926 and its various proceedings.

The second [reexamination] request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent.

MPEP § 2686.01 IV (9th ed. Rev. 10.2019, rev. June 2020). However, under Patent Owner's interpretation of § 42.73(d)(3)(i), this Office procedure would permit Patent Owner in an ex parte reexamination (where a Requestor has no appeal rights) to use an amendment in an ex parte reexamination certificate to extinguish (without recourse) the Requestor's statutory right to an appeal in an inter partes reexamination.

THIRD-PARTY REQUESTER.— A third-party requester—

(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent[.]

35 U.S.C. § 315(b) (pre-AIA). Where there is a conflict between Office procedure and a statute, we determine that the statute prevails. Therefore, contrary to the MPEP procedure, until the time for appeal has expired or any appeal proceeding has terminated in this inter partes reexamination, the we treat all these claims as they are labeled (“(Amended)” or “(New)”) in the Patent Owner's Amendment and Response filed on July 24, 2017.

Second, many dependent claims in the Claim Appendix are labeled as “(Issued)” when they have been amended via an amendment to another claim from which they depend. Such claims should have been labeled as “(Amended),” and include at least claims 9, 12–14, 16, 17, 19–21, 71–83, 85, 86, 88–111, 126, 129, 130, 132, 134, 135, 162–164, 166, 167, 215, 226–236, 245–247, 251, 265, 266, 268, 270, and 271.

C. Exemplary Claims in the Present Appeal

Exemplary independent claims 5, 37, and 87 under appeal read as follows:

5. A wireless device, comprising:
 - processing means;
 - wireless communications means, to facilitate wireless communication with a network that supports access to the Internet;
 - a display;
 - memory; and
 - storage means, in which a plurality of instructions are stored that when executed by the processing means enable the wireless device to perform operations including,
 - rendering a browser interface via which a user is enabled to request access to an original Web page, the Web page comprising HTML-based Web content having an original format defining an original width and height of the Web page and an original page layout, functionality, and design of content on the Web page;
 - in response to a user request to access the Web page, retrieving the Web page via the wireless communication means, and translating the HTML-based Web content from its original format into scalable content that supports a scalable resolution-independent representation of the Web page that preserves the original page layout, functionality and design of the content defined by its original format when scaled and rendered; and
 - scaling the scalable content to render the Web page on the display such that a width of the Web page is rendered to fit across the display; and
 - parsing markup language code to determine the original page layout of display content within the Web page, wherein the original page layout defines a layout location for a plurality of HTML objects, including HTML text objects, HTML graphic layout objects, and HTML graphic image objects included in the HTML-based Web content for the Web page;

- defining a primary datum corresponding to the original page layout; and, for each HTML object,
 - defining an object datum corresponding to the layout location for the HTML object;
 - generating a vector from the primary datum to the object datum for the HTML object; and
 - creating a reference that links the HTML object to the vector that is generated.

37. A mobile phone, comprising:
a processor,
a wireless communications device, to facilitate wireless communication with a network that supports access to the Internet;
a display; and
flash memory, operatively coupled to the processor, in which a plurality of instructions are stored that when executed by the processor enable the mobile phone to perform operations including,
rendering a browser interface via which a user is enabled to request access to a Web page comprising HTML-based Web content defining an original page layout, functionality, and design of content on the Web page;
retrieving the Web page via the wireless communications device, and processing the HTML-based Web content to produce scalable content; and
employing at least one of the scalable content or data derived therefrom to,
render the Web page on the display; and
re-render the display in response to associated user inputs to enable the Web page to be browsed at various zoom levels and panned views while preserving the original page layout, functionality, and design of the Web page content at each zoom level and panned view
[The mobile hand-held device of claim 36, wherein the device comprises a mobile phone].

87. A mobile hand-held device, comprising:
a processor,
a wireless communications interface, to facilitate wireless communication with a network that supports access to the Internet;
a display; and
non-volatile memory, operatively coupled to the processor, in which a plurality of instructions are stored that when executed by the processor enable the mobile hand-held device to perform operations including,
rendering a browser interface on the display via which a user is enabled to request access to a Web page comprising HTML-based Web content defining an original page layout, functionality, and design of content on the Web page;
in response to a user request of the Web page,
retrieving the Web page via the wireless communications interface;
rendering the Web page such that a width of the Web page is rendered to fit across the display; and
re-rendering the display in response to associated user inputs to enable the Web page to be browsed at various zoom levels and panned views while preserving the original page layout, functionality, and design of the Web [a e] page content at each zoom level and panned view.

D. References

The Examiner relies on the following references, collectively referred to as the Pad++ references:

Name	Reference	Date
Bederson, Benjamin B., et al. (hereinafter "Bederson-1")	"Pad++: A Zoomable Graphical Interface System", CHI '95 Mosaic of Creativity	May 1995
Bederson, Benjamin B., et al. (hereinafter "Bederson-2")	"Space-Scale Diagrams: Understanding Multiscale Interfaces," CHI '95 Proceedings	1995

Bederson, Benjamin B., et al. (hereinafter “Bederson-3”)	“A Zooming Web Browser,” SPIE, Vol. 2667, 260–71	May 1996
Bederson, Ben, et al. (hereinafter “Bederson-4”)	“Implementing a Zooming User Interface: Experience Building Pad++,” Software-Practice and Experience, Vol. 28(1), 1101–35	August 1998
Bederson, Benjamin B., et al. (hereinafter “Bederson-5”)	“Pad++: A Zoomable Graphical Sketchpad for Exploring Alternate Interface Physics,” Journal of Visual Languages and Computing, Vol. 7, 3–31	1996
Meyer, Jonathan (hereinafter “Pad++ Brief Tour”)	A Brief Tour Through Pad++	April 1997

Also, the Examiner relies on the following references:

Name	Reference	Date
(hereinafter “Nokia”)	Nokia Unveils World’s First All-In-One Communicator for the Americas, Nokia Press Release	Sept. 19, 1996
(hereinafter “Palm”)	3Com Announces the Palm VII Connected Organizer, the First Handheld Solution for Out-of-the-box Wireless Internet Access, Palm™ press release	Dec. 2, 1998
Robles, Emilo, et al. (hereinafter “Newton”)	Apple Outlines Plethora of Newton Wireless Communications Solutions at MessagePad 120 Launch	Jan. 30, 1995
(hereinafter “Locatio”)	Locatio Beginner’s Guide	July 30, 1999

Bray, Tim (hereinafter “Bray”)	“XML Support in IE5,” http://www.xml.com/pub/a/1999/03/ie5/first-x.html	Mar. 18, 1999
Hightower, Ron R., et al. (hereinafter “PadPrints”)	“PadPrints: graphical multiscale Web histories.” Proceedings of the 11th annual ACM symposium on User interface software and technology. ACM	1998
(hereafter “Reference Manual”)	Pad++ Reference Manual version 0.2.7	July 9, 1996
(hereafter “Programmer’s Guide”)	Pad++ Programmer’s Guide version 0.2.7	June 10, 1996

Further, the Examiner relies on the following references, collectively referred to as “HTML Standards”:

Name	Reference	Date
(hereinafter “HTML 3.2 Standard”)	W3C, “HTML 3.2 Reference Specification, W3C Recommendation,” pp. 1–44	Jan. 14, 1997
(hereinafter “HTML 4.0 Standard”)	W3C, “HTML 4.0 Specification, W3C Recommendation,” pp. 1– 363	Dec. 18, 1997

Furthermore, the Panel relies on the following references:

Name	Reference	Date
Morris	US 5,020,090	May 28, 1991
Culbert	US 5,708,816	Jan. 13, 1998
Kato	US 6,088,730	July 11, 2000
Ausems	US 6,434,403 B1	Aug. 13, 2002
O’Sullivan	US RE38,127 E	May 27, 2003

III. ANALYSIS

We address herein Appellant's (Patent Owner's) appeal of the Examiner's rejections under 35 U.S.C. § 103, which we reverse.

We present herein a new ground of rejection as to all claims, which subsumes Cross-Appellant's (Requester's) appeal of the Examiner's final decision favorable to the patentability of claims 106, 182, 204, 282, 304, and 322. Therefore, except as to the ultimate conclusion reversing the Examiner's decision favorable to the confirmation/patentability of these claims, we do not separately address Cross-Appellant's appeal.

A. Examiner's Rejections

1. Listing of Section 103 Rejections

a) Pad++

“[C]laims 2–28, 31, 34, 35, 38, 41, 44–46, 50, 53–55, 60, 61, 69–80, 83, 85–104, 109–111, 122–126, 128–135, 137, 140, 141, 145, 147, 151, 152, 154, 156–159, 161–177, 184–202, 205, 207–209, 215, 216, 226–236, 238–242, 246, 248, 251, 254, 257, 259, 264–271, 274–277, 285–302, 307–310, 318, and 319, . . . are rejected under 35 USC 103(a) as obvious over Pad++ (see: Request pages 19–21 and 30–60 and Claims Chart CC-A pages 1–1366, which are hereby incorporated by reference).” Right of Appeal Notice (RAN) 21–41.

b) Pad++, Nokia, and Palm

“[C]laims 30, 32, 37, 81, 82, 107, 108, 144, 150, 205, 206, 245, 247, 253, 305, and 306, . . . are rejected under 35 USC 103(a) as obvious over Pad++, in view of Nokia, and further in view of Palm (see: Request pages 21–22 and 60–61 and Claims Chart CC-B pages 1–13, which are hereby incorporated by reference).” RAN 41–42.

c) Pad++ and Newton

“[C]laims 30, 32, 37, 81, 82, 107, 108, 144, 150, 205, 206, 245, 247, 253, 305, and 306, . . . are rejected under 35 USC 103(a) as obvious over Pad++ in view of Newton (see: Request pages 22–23 and 61–62 and Claims Chart CC-C pages 1–15, which are hereby incorporated by reference).” RAN 42–43.

d) Pad++ and Locatio

“[C]laims 30, 32, 37, 81, 82, 107, 108, 144, 150, 205, 206, 245, 247, 253, 305, and 306, . . . are rejected under 35 USC 103(a) as obvious over Pad++ in view of Locatio (see: Request pages 23–24 and 62–63 and Claims Chart CC-D pages 1–30, which are hereby incorporated by reference).” RAN 44–45.

e) Pad++ and Bray

“[C]laims 105, 203, and 303, . . . are rejected under 35 USC 103(a) as obvious over Pad++ in view of Bray (see: Request pages 24–25 and 63–64 and Claims Chart CC-E pages 1–39, which are hereby incorporated by reference).” RAN 45–46.

f) Pad++ and Common Knowledge

“[C]laims 320 and 321, . . . are rejected under 35 USC 103(a) as obvious over Pad++ in view of Common Knowledge of One of Ordinary Skill in the Art (see: 3PR Comments at page 21 and Claims Chart CC-A pages 1–47, which are hereby incorporated by reference).” RAN 55–56.

g) Pad++ and HTML Standards

“[C]laims 5, 23–27, 60, 61, 70, 122, 137, 140, 141, 147, 156, 174–177, 216, 238–242, 248, 259, and 274–277, . . . are rejected under 35 USC 103(a) as obvious over Pad++ in view of the HTML Standards (see: 3PR

Comments at pages 32–33 and Claims Chart CC-A pages 1–1366, which are hereby incorporated by reference).” RAN 56.

h) Pad++ and AAPA (Appellant’s Admitted Prior Art)

“[C]laims 5, 23–27, 60, 61, 70, 122, 137, 140, 141, 147, 156, 174–177, 216, 238–242, 248, 259, and 274–277, . . . are rejected under 35 USC 103(a) as obvious over Pad++ in view of the AAPA (see: 3PR Comments at pages 32 and Claims Chart CC-A pages 1–1366, which are hereby incorporated by reference).” RAN 56–57.

2. Case Law

As with an *ex parte* appeal, in an appeal of a 35 U.S.C. § 103 rejection in an *inter partes* reexamination:

An appellant may attempt to overcome an examiner’s obviousness rejection on appeal to the Board by submitting arguments and/or evidence to show that the examiner made an error in either (1) an underlying finding of fact upon which the final conclusion of obviousness was based, or (2) the reasoning used to reach the legal conclusion of obviousness. Similarly, the applicant may submit evidence of secondary considerations of non-obviousness.

The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon. Specifically, the Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue.

Filing a Board appeal does not, unto itself, entitle an appellant to *de novo* review of all aspects of a rejection. If an appellant fails to present arguments on a particular issue — or, more broadly, on a particular rejection — the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection.

Ex parte Frye, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (internal citations omitted).

As articulated by the Federal Circuit, the Examiner's burden of proving non-patentability is by a preponderance of the evidence. *See In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) (“[P]reponderance of the evidence is the standard that must be met by the PTO in making rejections”). “A rejection based on section 103 clearly must rest on a factual basis[.]” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). “The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *Id.*

3. *Patent Owner's Arguments*

Patent Owner (Appellant) raises numerous concerns about the Examiner's various rejections under 35 U.S.C. § 103. Patent Owner's Appeal Brief, Patent Owner's Respondent Brief, and Patent Owner's Rebuttal Brief. However, our review finds three concerns which we deem to be dispositive of the Examiner's rejections before us. We limit our discussion of the Examiner's rejections to those three concerns.

4. *The Panel's Analysis*

a) *Incorporation of the Claim Charts*

In Patent Owner's Appeal Brief, Patent Owner argues:

The rejections follow a pattern where the Examiner adopts the rejections provided by the 3PR [third party requester] in the Reexamination Request, summarizes the arguments made by the PO and 3PR (as opposed to addressing the arguments in view of the evidence on record supporting the arguments), and then rejects arguments provided by PO without explaining why the Examiner accepts the prevailing argument (of the 3PR).

....

For example, the Examiner states (RAN at 21–22)[:]

Referring to claims 2–28 ... and 319, said claims are rejected under 35 USC 103(a) as obvious over Pad++ (see: Request pages 19–21 and 30–60 and Claims Chart CC-A pages 1–1366, which are hereby incorporated by reference).

This rejection *merely parrots the assertions made in the Reexamination Request* by 3PR (*without separate Examiner analysis* for most/all claim elements), which does not establish a *prima facie* case of obviousness for any claim, much less all claims for which the request is asserted. See M.P.E.P. 2242.

While M.P.E.P 2262 permits bodily incorporation of claim charts, it also requires, “The first Office action must be sufficiently detailed that the pertinency and manner of applying the cited prior art to the claims in each rejection is clearly set forth therein.”

Incorporation of a 1366-page claim chart does not meet this requirement. This level of incorporation by reference will force the board to “play archeologist with the record.” See, *Gen. Access Sols. v. Sprint Spectrum L.P.*, 2019-1856 (Fed. Cir. May. 11, 2020), where reference to a twenty-nine-page claim chart attached as an exhibit was held improper (absent separate presentation of evidence).

Moreover, the materials incorporated by reference are merely attorney arguments that were adopted by the Examiner, with the Examiner not articulating separate substantial evidence to establish a *prima facie* case of obviousness including failure to construe and address all claim elements. This is improper.

Patent Owner’s Appeal Brief 12–13 (emphasis added).

Essentially, Patent Owner presents a general (non-specific) argument that the rejections should be reversed based on (a) the large size of the claim chart incorporated by reference for the patent’s 200+ claims, and (b) the rejections’ obviousness determinations being “without separate Examiner

analysis.” We disagree. First, contrary to Patent Owner, we do not find the rejections to be without separate Examiner analysis. E.g., pages 12–13 of the Patent Owner’s Appeal Brief provides an example by quoting from the RAN at 21–22, but Patent Owner overlooks the rest of the Examiner’s analysis at pages 22–41 of the RAN.

Second, as to the claim chart, it is not the size of the claim chart that controls. Rather, as recognized by Patent Owner in quoting the MPEP, it is whether “the pertinency and manner of applying the cited prior art to the claims in each rejection is clearly set forth” (MPEP § 2262) by the claim chart being used as part of the rejection.

Third, beyond the general argument *supra*, we do not find in Patent Owner’s briefing any particular limitation argued where the Patent Owner specifies why the Examiner’s incorporation by reference fails.

Fourth, we disagree with Patent Owner’s generalized argument. However, to the extent that Patent Owner argues the rejection analysis is insufficient as to a particular limitation, our review necessarily requires “review[ing] the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue” (*Frye*, 94 USPQ2d at 1075), including reviewing the sufficiency of the rejection analysis as to any incorporated by reference claim chart regarding that particular limitation.

b) Issue Preclusion

Also, Patent Owner argues:

The Final Written Decisions in IPR2013-00004 & IPR2013-00257 (’926 FWD) and IPR2013-00007 and IPR2013-00256 (’353 FWD) were appealed to the Federal Circuit Court of Appeals, which issued two Rule 36 Orders without opinion.

As stated in *Rates Technology, Inc. v. Mediatix Telecom, Inc.*, 688 F.3d 742, 750 (Fed. Cir. 2012) (emphasis added),

Rule 36 allows us to “enter a judgment of affirmance without opinion” under certain circumstances. Since there is no opinion, a Rule 36 judgment simply confirms that the trial court entered the correct judgment. It does not endorse or reject any specific part of the trial court’s reasoning.

In *Phil-Insul Corp. v. AirLite Plastics Co.*, 854 F.3d 1344 (Fed. Cir. 2017), the Federal Circuit clarified that collateral estoppel cannot apply where the appellate court affirmed, without explanation, the judgment of a trial court that ‘determined two issues, either of which could independently support the result,’ because it is not known which issues were ‘necessary’ or ‘essential’ to the final appellate judgment. *Id.* at 1343-44.

In the ’353 FWD claims were rejected over two separate combinations of art: (1) Zaurus, Pad++, and SVF; and (2) Zaurus, Hara, Tsutsumitake, and SVF. SVG was added to both for claim 66.

There cannot be preclusion with respect to any determination concerning any individual reference or combination of references, including Pad++ and SVF, **as the Rule 36 Order did not identify** which issues were ‘necessary’ or ‘essential’ to the cancellation of any claim.

Patent Owner’s Respondent Brief 5 (emphasis added, some boldface omitted).

Essentially, Patent Owner argues a general rule exists that there cannot be issue preclusion when the Federal Circuit issues a Rule 36 Order because the Rule 36 Order does not identify which issues were “necessary” or “essential” to the cancellation of a claim. We disagree. Contrary to Patent Owner’s argument, the *Phil-Insul Corp.* decision does not present such a holding. Rather, the decision states:

[F]or estoppel to apply, there must be no uncertainty as to whether the precise issue was raised and determined *in the prior suit*. *De Sollar v. Hanscome*, 158 U.S. 216, 221, 15 S.Ct. 816, 39 L.Ed. 956 (1895) (“[I]t is of the essence of estoppel by judgment that it is certain that the precise fact was determined *by the former judgment*.”).

Phil-Insul Corp. v. Airlite Plastics Co., 854 F.3d at 1356–57 (emphasis added). It is the analysis of the former decision that is required, not identification of issues in the Rule 36 Order.

While we disagree with Patent Owner as to the Rule 36 phrasing of how issue preclusion is analyzed, we do agree with the general thrust of Patent Owner’s argument, i.e., that a particularized analysis is required. Issue preclusion is only appropriate if the following conditions are met:

- (1) the issue is identical to one decided in the first action;
- (2) the issue was actually litigated in the first action;
- (3) resolution of the issue was essential to a final judgment in the first action; and
- (4) the party against whom estoppel is invoked had a full and fair opportunity to litigate the issue in the first action.

Innovad Inc. v. Microsoft Corp., 260 F.3d 1326, 1334 (Fed. Cir. 2001).

To the extent that the Examiner relies on issue preclusion, our review necessarily requires determining if the Examiner has addressed how the four conditions *supra* are met.

c) The Pad++ References

In the Final Written Decision of IPR2013-00007, the panel determined that the combination of Zaurus and Pad++ (and alternatively, the combination of Zaurus, Hara, and Tsutsumitake) renders obvious zooming while preserving layout, functionality, and design of a web page. FWD 17

(“Zaurus preserves the *layout* and *design* of the web page.”), FWD 21
 (“Bederson’s [Pad++] disclosure of preserving hyperlinking capability
 demonstrates preserving the *functionality* of HTML in a zoomed view.”)
 (Emphasis added).

In the present Inter Partes Reexamination, each independent claim
 under reexamination recites the “layout and design” and “functionality”
 limitations, and the Examiner relies solely on Pad++ to teach such
 limitations. For example:

Pad++ teaches operations including rendering a browser
 interface via which a user is enabled to request access to an
 original Web page, the Web page comprising HTML based Web
 content having an original format defining an original width and
 height of the Web page and an original page *layout, functionality, and design* of content on the Web page (Bederson-
 3 at 260, 262, 264; Bederson-5 at 12–13; Bederson-4 at 1103.
 Pad++ enables “navigation of WWW pages written using
 standard HTML [and that] HTML provides [Web content
 defining] text, images, bullets items, and horizontal rules.”
 Bederson-3 at 264.)

RAN 23.

Essentially, Patent Owner argues at pages 32–40 of Patent Owner’s
 Appeal Brief that the Examiner has not adequately explained the findings of
 facts as to Pad++ teaching the claimed original page layout and design of
 content on the Web page. We agree with Appellant that more is required as
 to the layout and design requirement.

The Examiner finds:

Pad++ teaches translating the HTML based Web content from its
 original format into scalable content that supports a scalable
 resolution independent representation of the Web page that
 preserves the original page *layout, functionality and design* of
 the content defined by its original format when scaled and

rendered (Bederson-2 at 4; Bederson-3 at 260, 262, 264; Bederson-4 at 1104, 1120, 1128–1129, 1131–1132; Bederson-5 at 23.)

RAN 24 (emphasis added). Additionally, as discussed *supra*, the Examiner incorporates by reference the claim chart regarding these particular limitation. However, for amended claim 5, reviewing the Examiner’s analysis and the claim chart (CC-A-1–23 and CC-A-38–47) for patent claims 1 and 5, we are unable to determine what particular features in Pad++ the Examiner believes correspond to the layout and design. The Examiner’s analysis for each independent claim is similarly structured.

The Examiner attempts to further supplement this analysis by pointing out:

[W]hile the simple Pad++ browser does not implement each and every feature of HTML, the Pad++ references do disclose preserving the layout, functionality, and design of the Web page. The Examiner notes the PTAB reached a similar determination in the Final Written Decision issued 03/27/2014 (see: Final Written Decision, p. 22: “Although...nor Bederson implements each and every feature of HTML...***Bederson disclose preserving the layout, functionality, and design*** of the part of the web page that is translated” . . .).”

RAN 68–69.

We agree with the Examiner that the FWD analysis is sufficient to show Pad++ teaches the functionality limitation for the reasons set forth in the FWD. *See* FWD 20–22. However, we disagree with the Examiner that the FWD holds that “Bederson disclose preserving the layout and design of the part of the web page that is translated.” FWD 22. This phrase appears in the FWD as part of the sentence:

Although neither Zaurus nor Bederson implements each and every feature of HTML, as discussed above, both Zaurus and

Bederson disclose preserving the layout, functionality and design of the part of the web page that is translated (claim 1) or processed (claim 36).

FWD 22. When we review the phrase in its sentence and in the context of the full analysis of the FWD (where layout and design are found in Zaurus, and functionality is found in Pad++), we conclude that the meaning is not that found by the Examiner. Rather, we read the sentence as stating that “[together] Zaurus and Bederson disclose preserving the layout, functionality and design of the part of the web page that is translated” as that is consistent with the remainder of the FWD analysis.

We conclude, consistent with Patent Owner’s arguments, that there is currently insufficient articulated reasoning to support the Examiner’s finding that Pad++, alone or in the proposed combinations, teach, suggest, or otherwise render obvious the layout and design limitation of the claims.

Therefore, we conclude that there is insufficient articulated reasoning to support the Examiner’s final conclusion that the claims would have been obvious to one of ordinary skill in the art at the time of Appellant’s invention.⁶

⁶ The Final Written Decision (FWD) on March 27, 2014 provides the opportunity to supplement the Examiner’s findings as to the layout and design limitation of the claims via new ground of rejection based on the FWD findings as to Zaurus (e.g., by way of issue preclusion). However, we exercise our discretion to not pursue that path at this time as the new ground we do pursue herein (based on 37 C.F.R. § 42.73(d)(3)(i) Estoppel) is more comprehensive.

B. New Ground of Rejection – 37 C.F.R. § 42.73(d)(3)(i)

1. Rules of Practice Before the Patent Trial and Appeal Board

a) The Rules

We quote from both Part 41 (Appeals and Interferences) and Part 42 (Trial Proceedings) to show their parallel terminology and structure.

37 C.F.R. § 41.1 (a) reads as follows (emphasis added):

Scope. Part 41 ***governs appeals and interferences*** before the Patent Trial and Appeal Board.

37 C.F.R. § 42.1 (a) reads as follows (emphasis added):

Scope. Part 42 ***governs proceedings*** before the Patent Trial and Appeal Board.

37 C.F.R. § 42.2 **Definitions** includes the following:

Judgment means a final written decision by the Board, or a termination of a proceeding.

37 C.F.R. § 42.73 **Judgment.** (a) and (b) read as follows:

(a) A judgment, except in the case of a termination, disposes of all issues that were, or by motion reasonably could have been, raised and decided.

(b) *Request for adverse judgment.* A party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include:

- (1) Disclaimer of the involved application or patent;
- (2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial;
- (3) Concession of unpatentability or derivation of the contested subject matter; and
- (4) Abandonment of the contest.

37 C.F.R. § 42.73 *Estoppel* at (d)(3)(i) reads as follows:

Patent applicant or owner. A patent applicant or owner is precluded from taking action inconsistent with the adverse judgment, including obtaining in any patent:

A claim that is not patentably distinct from a finally refused or cancelled claim.

37 C.F.R. § 41.127 **Judgment.** (a) and (b) read as follows (emphasis added):

(a) *Effect within Office*—

(1) *Estoppel.* A judgment disposes of all issues that were, or by motion could have properly been, raised and decided. A losing party who could have properly moved for relief on an issue, but did not so move, may not take action in the Office after the judgment that is inconsistent with that party's failure to move, except that a losing party shall not be estopped with respect to any contested subject matter for which that party was awarded a favorable judgment.

(2) *Final disposal of claim.* **Adverse judgment** against a claim is a final action of the Office requiring no further action by the Office to dispose of the claim permanently.

(b) *Request for adverse judgment.* A party may at any time in the proceeding request judgment against itself. Actions construed to be a request for adverse judgment include:

(1) Abandonment of an involved application such that the party no longer has an application or patent involved in the proceeding;

(2) Cancellation or disclaiming of a claim such that the party no longer has a claim involved in the proceeding;

(3) Concession of priority or unpatentability of the contested subject matter; and

(4) Abandonment of the contest.

b) Application of 37 C.F.R. § 42.73(d)(3)(i)

As to both of the following points of Patent Owner and Examiner agreement during this reexamination, we disagree for the reasons set forth *infra*. Patent Owner and the Examiner mistakenly agree that the claims on appeal are all patentably distinct from the claims cancelled during an *inter partes* review of the patent. RAN 61–62, 99–101. Thus, Patent Owner and the Examiner mistakenly agree § 42.73(d)(3)(i) estoppel is not applicable.

Also, Patent Owner appears to argue that § 42.73(d)(3)(i) is limited to only circumstances covered by § 42.73(b) *Request for adverse judgment*.

§ 42.73(d)(3)(i) was recently addressed by the Federal Circuit. In *Arthrex, Inc. v. Smith & Nephew, Inc.*, [880 F.3d 1345, (Fed. Cir. 2018)], the patent owner appealed from the PTAB's entry of an adverse judgment under 37 C.F.R. § 42.73(b). The issue on appeal was whether the PTAB erred in doing so, because the patent owner disclaimed all claims the petitioner challenged before the PTAB issued an institution decision. The patent owner was aggrieved because “[t]he purpose of § 42.73(b) is to define the circumstances in which the estoppel provision of 37 C.F.R. § 42.73(d) applies.[”] [*Arthrex*, 880 F.3d at 1350].

Patent Owner’s Rebuttal Brief at page 2.⁷

We disagree with Patent Owner’s interpretation of the rule. Although § 42.73(b) does include adverse judgments that are requested by a party, the court in *Arthrex* does not say the purpose of § 42.73(b) is to define the *only* circumstances in which the estoppel provision of 37 C.F.R. § 42.73(d) apply. Nor does § 42.73(d)(3)(i) expressly limit itself to only “requested” adverse

⁷ Patent Owner also points to the *Choon’s Design, LLC v. Zenacon, LLC* holding that 37 C.F.R. § 42.73(d)(3)(i) is not applicable in an infringement action. 2015 WL 539441 (E.D. Mich. 2015). We fail to see the relevance of this decision as it is not disputed that the Rule is limited to proceedings before the Office.

judgments. To the contrary, we conclude § 42.73(d)(3)(i) more expansively covers a claim that is not patentably distinct from a “finally refused claim,” when the adverse judgment is under either § 42.73(a) or § 42.73(b). Further, the use of the term “adverse judgment” elsewhere in the rules supports a more inclusive interpretation of “adverse judgment” in practice before the Patent Trial and Appeal Board:

Adverse judgment against a claim is a final action of the Office requiring no further action by the Office to dispose of the claim permanently.

§ 41.127(a)(2).

However, we do conclude that applicability of § 42.73(d)(3) to a pre-AIA *inter partes* reexamination of the issued patent claims (request filed prior to September 16, 2012) is limited by statute to only those issued patent claims for which a “substantial new question of patentability” is raised (35 U.S.C. § 312 (pre-AIA)⁸) “on the basis of any prior art cited under the provisions of section 301” (35 U.S.C. § 311 (pre-AIA)⁹). On August 8, 2011, the Examiner determined:

A substantial new question of patentability (“SNQ”) affecting claims 1–319 of USPN 7,461,353 B2 to Rohrabough et al. is raised by the inter partes reexamination request filed 05/20/2011.

Order Granting Request for Inter Partes Reexamination 2. We do not find before us where Patent Owner disputes Examiner’s determination that an SNQ is raised as to claims 1–319.

For the reasons set forth *infra*, we reject claims 2–28, 30–32, 34, 35, 37, 38, 41, 44–46, 50, 53–55, 60, 61, 69–83, 85–111, 122–126, 128–135,

⁸ As in effect for a request filed prior to September 16, 2011.

⁹ As in effect for a request filed prior to September 16, 2011.

137, 140, 141, 144, 145, 147, 150–152, 154, 156–159, 161–177, 182, 184–209, 215, 216, 226–236, 238–242, 245–248, 251, 253, 254, 257, 259, 264–271, 274–277, 282, 285–310, and 318–322 (all the claims subject to this reexamination) based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claims finally cancelled during an *inter partes* review of the patent which is the subject of this reexamination.

2. *Preliminary Matters*

Certain issues appear repeatedly throughout the new grounds. Rather than addressing these issues repeatedly, we address each issue once here.

a) *Applicable Section 103 Arguments*

The majority of Patent Owner’s appeal arguments are not directed to the issue of estoppel upon which the new ground is based. However, as a courtesy to Patent Owner, we address those § 103 arguments we deem equally relevant to whether the claims are patentably distinct.

b) *The Effect of the IPR Certificate*

(1)

An “Inter Partes Review Certificate,” cancelled claims 1, 33, 36, 43, 48, 51, 52, 58, 59, 118, 138, 139, 149, 183, 252, 283, and 317 of U.S. Patent 7,461,353. *See* attached Cancelled Claim Appendix. The cancelation of these claims by the Certificate put the public on notice that these claims are now in the public domain. *Cf. Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1384 (Fed. Cir. 1998) (in interpreting 35 U.S.C. § 253, the court stating that “[t]he public is entitled to rely upon the public record of a patent in determining the scope of the patent’s claims. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed.Cir.1996). This reliance

enables businesses, as well as others, to plan their future conduct in as certain an environment as possible. *See id.*”).

(2)

On January 6, 2022, Patent Owner in a hearing for a first related second Inter Partes Reexamination 95/002,132 raised the argument that estoppel under § 42.73(d)(3)(i) is not applicable in a reexamination because Patent Owner is not “obtaining” a claim as set forth in the rule. Also, Patent Owner points to two non-precedential PTAB decisions (IPR2017-00428 and IPR2015-00458) as showing that “obtaining” in the rule also does not include “confirming” of an issued claim in an *inter partes* review. Thus, Patent Owner argues “the regulation is inapplicable to the PTO confirming issued unamended claims in a patent subject to reexamination.” 2022-000153/2022-000154 Hearing Transcript 17.

This argument is unpersuasive. First, as to Patent Owner’s argument that § 42.73(d)(3)(i) is not applicable in a reexamination confirming a previously issued claim, Patent Owner is mistaken. The Notice of Final Rule Making, 77 Federal Register 48612, in response to Comment 213 states:

Under 35 U.S.C. 316(a)(4), as amended, and 35 U.S.C. 326(a)(4), the Office is required to prescribe regulations setting forth ***the relationship between the review and other proceedings in the Office (e.g., examination)***. Section 42.73(d)(3)(i), as adopted in this final rule, merely provides estoppel against claims that are ***patentably indistinct*** from those claims that were lost, and claim amendments that were presented and denied, during a trial.

77 Fed. Reg. 48649 (emphasis added). We conclude that, like examination, a reexamination is one of the “other proceedings in the Office,” and is

covered by Section 42.73(d)(3)(i) that “provides estoppel against claims that are patentably indistinct from claims that were lost.” *Id.*

Second, as to Patent Owner’s argument that § 42.73(d)(3)(i) is not applicable to an *inter partes* reexamination because this rule has been held to not be applicable in an *inter partes* review confirming a previously issued claim, Patent Owner is partially mistaken. In the PTAB’s *inter partes* review decisions cited by Patent Owner, the patent owners were merely defending a challenged claim against a charge of unpatentability by petitioner; these cited *inter partes* review proceedings involved no examination (or examination-like) action by the Office. However, had such an examination (or examination-like) action occurred, then § 42.73(d)(3)(i) is applicable (e.g., for claims amended in an *inter partes* review).¹⁰

“Paragraph (d)(3) of § 42.73 applies to derivation proceedings, *inter partes* review, post-grant review, and covered business method review.” 77 Fed. Reg. 48649. 35 U.S.C. § 316(a)(pre-AIA) covering an *inter partes* reexamination and 35 U.S.C. § 328(b) covering a final written decision in an *inter partes* review each use the identical “confirming any claim of the patent determined to be patentable” language. However, Patent Owner overlooks that while the term “confirming” is used in each statute, the two activities of reviewing the patentability of a claim challenged by a petitioner

¹⁰ In an *inter partes* review, it is an amendment that triggers the examination of the amended claims. However, in an *inter partes* reexamination, even though they also may include an amendment that similarly triggers the examination of the amended claims, it is the substantial new question of patentability that triggers the examination of the issued patent claims.

and examination of a claim by the Office are not the same and lead to different results under § 42.73(d)(3)(i).

For these reasons, and given the strong concern with protecting the public¹¹, we conclude “obtaining” in the rule includes “confirming” in a reexamination. We conclude that § 42.73(d)(3)(i) is applicable for those claims in a reexamination for which a “substantial new question of patentability” is raised.

(3)

Also, on January 6, 2022, in a hearing for a second related second Inter Partes Reexamination 95/002,126, the Patent Owner raised an argument that “patentably distinct” under § 42.73(d)(3)(i) is not in the obviousness sense. 2022-000153/2022-000154 Hearing Transcript 59.

This argument is unpersuasive. The phrase “patentably distinct” is used elsewhere in the Rules (i.e., § 41.201 Definitions (in Patent Interferences)) and has been interpreted to mean “a claim is patentably distinct from the interference count, in the sense of 35 U.S.C. § 103, if the apparatus claimed by the count does not render what is being claimed by the claim at issue obvious.” *Davis v. Loesch*, 998 F.2d 963, 965 n.2 (Fed. Cir.1993). Similarly, in double patenting situations, “patentably distinct” has been interpreted to mean “[i]f the rejected claim defines *more* than an obvious variation, it is *patentably distinct*.” *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1278 (Fed. Cir. 1992). *Eli Lilly and Co. v. Barr Laboratories, Inc.*, 251 F.3d 955, 968 (Fed. Cir. 2001)

¹¹ As we note *supra*, the public is entitled to rely upon the public record of a patent in determining the scope of the patent’s claims.

(“A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim.”).

We conclude that the proper interpretation of the phrase “patentably distinct” in § 42.73(d)(3)(i) is in the obviousness sense.

(4)

Further, on January 27, 2022, in a hearing for a third related second Inter Partes Reexamination 95/000,634, the Patent Owner raised an argument that a proceeding is not subsequent as discussed in the comments to § 42.73 if that proceeding was commenced prior to the related *inter partes* review. 2022-000716 Hearing Transcript [].

This argument is unpersuasive. The Federal Circuit stated:

When the Board entered an adverse judgment, an estoppel effect attached, as 37 C.F.R. § 42.73(d)(3)(i) precludes a patent owner “from taking action inconsistent with the adverse judgment, including obtaining in any patent . . . [a] claim that is not patentably distinct from a finally refused or canceled claim.” At the time of the adverse judgment, Arthrex had two *pending* continuation patent applications that ***this estoppel provision would impact***. Those two applications have since issued as patents.

Arthrex, 880 F.3d at 1347 (emphasis added). In *Arthrex*, the “two pending continuation patent applications” were filed in 2005 and 2014, and the *inter partes* review was filed in 2016.

We conclude that § 42.73(d)(3)(i) is applicable here where the current Inter Partes Reexamination was filed before the now completed related *inter partes* review, but the reexamination is still pending before the Office.

c) *The Form of Our New Ground of Rejection*

For simplicity, we present the estoppel issues *infra* in the same format the Office uses for rejections under 35 U.S.C. § 103.

Also, in view of the circumstances of this case where the patentability of the cancelled claims has been fully decided with no further judicial review possible, we discern no need to discuss with particularity the limitations of the cancelled claims, even to the extent they are included in the challenged claims of this Inter Partes Reexamination.

d) The Form of Any Patent Owner Response

We conclude that Patent Owner is estopped from arguing that limitations of the relevant cancelled claims render the challenged claims patentable over those cancelled claims because of the issuance in IPR2013-00007 on the Certificate cancelling those claims. Therefore, if Patent Owner intends to assert such arguments, Patent Owner should explain why it is not estopped from arguing that the limitations of those cancelled claims, which are incorporated into challenged claims, demonstrate patentability.

e) Translating vs. Processing vs. Zooming

As we noted *supra* in Section II.A. *Background*, U.S. Patent 7,461,353 issued with claims which characterized the invention as either (a) translating into scalable content, then scaling the content (e.g., claim 1), (b) processing to produce scalable content, then scaling the content (e.g., claim 36), or (c) zooming without limiting to either translating or processing (e.g., claim 317). Also as noted *supra*, the Office cancelled each of claims 1, 36, and 317 as a result of *inter partes* review.

We conclude that there is no meaningful difference between claiming “translating into scalable content, then scaling the content,” and “processing to produce scalable content, then scaling the content.” That is, we conclude that this claim difference does not render claims patentably distinct from

each another. This conclusion is supported by the Specification which uses the word “process” in describing “translating”:

With reference to the flowchart of FIG. 5, the process for translating the HTML content into a scalable vector representation proceeds as follows.

Spec. 15:43–55.

Further, we conclude a claim to zooming without limiting to either translating or processing is not patentably distinct from claims that differ by being limited to (a) translating into scalable content, then scaling the content or (b) processing to produce scalable content, then scaling the content. We reach this conclusion because “zooming” is merely a generic recitation of the function accomplished by the scaling in (a) and (b). This conclusion is supported by the Specification which shows the phrase “to be scaled” is understood as “zoomed”:

In accordance with aspects of the invention, mobile devices enabled to support resolution-independent scalable display of Internet (Web) content to allow Web pages to be scaled (zoomed) and panned for better viewing on smaller screen sizes are disclosed.

Spec. 2:22–25.

In summary, we conclude that characterizing the invention in these three ways does not by itself render such claims patentably distinct from each other.

f) Entire vs. Portion

The Cross-Appellant correctly points out that “the claims do not recite preserving ‘the *entire* HTML-based Web content.’” Third Party Requester’s Respondent Brief 7. In the face of this, Patent Owner argues (Patent Owner’s Rebuttal Brief 5–6) that the broadest reasonable interpretation of

many of the amended claims now requires that in those amended claims all the HTML-based content (i.e., the entire HTML-based content) that defines the original page layout and functionality of the web page content must be preserved. These amendments consist of (a) deleting the phrase “at least a portion of” (e.g., amended claim 5), or (b) inserting the article “the” to limit the antecedent basis of “HTML-based Web content” (e.g., amended claims 37 and 38). Patent Owner’s Amendment and Response to 2nd Non-final Action 56–58. We agree with Patent Owner that these amendments have the effect of limiting the amended claims to preserving the entire HTML-based Web content.

However, we disagree with Patent Owner’s (and the Examiner’s) conclusion that “preserving ‘the *entire* HTML-based Web content’” renders the so amended claims patentably distinct from the claims cancelled during an *inter partes* review of the patent. We explain our conclusion by focusing on the difference between limitations in cancelled patent claim 1 and amended claim 5 on appeal (formerly claim 5/1). Cancelled claim 1 recites:

the Web page comprising HTML-based Web content having an original format defining an original width and height of the Web page and an original page layout, functionality, and design of content on the Web page,

and

translating *at least a portion of* the HTML-based Web content from its original format into scalable content that supports a scalable resolution-independent representation of the Web page that preserves the original page layout, functionality and design of the content defined by its original format when scaled and rendered.

Cancelled Claims Appendix (emphasis added). The related portions of amended claim 5 on appeal differ in that the “at least a portion of” has been

deleted. As discussed *supra*, the effect of this amendment is to require the entire HTML-based Web content be translated.

Essentially, cancelled claim 1 required HTML-based Web content that includes A=(layout), B=(functionality), C=(design), and X=(additional content), and only the ABC portion of the content was required to be translated and preserved when scaling. The phrase “at least a portion of” in cancelled claim 1 defines the relationship between the starting content and the translated and preserved content. Deleting the phrase in amended claim 5 has the effect of requiring that the entire HTML-based Web content be translated and preserved when scaling. Not unreasonably, Patent Owner and Examiner appear to construe amended claim 5 as covering having HTML-based Web content that includes A=(layout), B=(functionality), C=(design), and X=(additional content), and the entirety of the ABCX content is required to be translated and preserved when scaling. However, we conclude that while amended claim 5 covers this situation, amended claim 5 is not so limited. Rather, because the “at least a portion of” limitation in cancelled claim 1 was what required the Web content to have X=(additional content) before the translation, removal of the “at least a portion of” limitation means that in amended claim 5 the HTML-based Web content is not required to have additional content X. Thus, appealed claim 5 also covers situations where the translated and preserved ABC (as in claim 1) is the entire HTML-based Web content (i.e., additional content X is not required).

We conclude the Examiner was mistaken in determining the amended claims to be patentably distinct based on their “preserving ‘the *entire* HTML-based Web content.’” We conclude that this limitation includes situations that differ from the cancelled claims only in that the now claimed

starting HTML-based Web content (to ultimately be preserved and scaled) is more limited than in the cancelled claims (but is otherwise fully encompassed (i.e., only lacking X)). Thus, the amended claims and cancelled claims includes situations that are identical as to the HTML-based Web content that is translated, preserved, and scaled (i.e., ABC).

Stated differently, as compared to the cancelled “at least a portion of” claims, the amended claims directed to translating (or alternatively processing) the “entire” HTML-based Web content now covers two embodiments (1) starting with *the same* HTML-based Web content as in the cancelled claims, and translating/processing, preserving, and scaling *more* Web content than in the cancelled claim, and (2) starting with *less than* the HTML-based Web content in the cancelled claims, and translating /processing, preserving, and scaling *the same* Web content as in the cancelled claim. It is based on embodiment (2) that we conclude the amendment, to preserve/scale the “entire” Web content, does not result in the so amended claims being patentably distinct from the cancelled claims.

g) HTML Objects vs. Pad++ Objects

In the '353 Final Written Decision, the Board determined:

The standard objects supported by Pad++ include colored text, graphics, portal and HTML, with standard input widgets (buttons, sliders, etc.) supplied as extensions. [Ex. 1006] at 156 [Bederson-5 at page 6].

FWD 21. Specifically, Bederson-5 states “[t]he standard objects that pad++ supports are colored text, graphics, images, portals and hypertext markup language (HTML).”

During the prosecution of this *inter partes* reexamination, the Examiner determined:

Clearly the HTML document content processed and rendered by Pad++ are derived from regular HTML objects (see: Bederson-1, p. 24: “Pad++ can read in hypertext files written in Hypertext Markup Language (HTML)”; Bederson-3, p. 261: “visualization of standard HTML pages”, p. 264: “visualization and navigation of WWW pages written using standard HTML. . .include text, images, bullet items, and horizontal rules. . .HTML provides header tags”; Bederson-4, p. 1104: “object such as an HTML page composed of many characters, line segments and image”; Bederson-5, p. 6: “pad++ supports. . .hypertext markup language (HTML)”, p. 12: “Pad++ reads hypertext written in....HTML. . . can follow links across the internet. . .zooming mechanisms are employed”; Pad++ Tour, p. 86-89: “An HTML browser. . . Pad++ displaying an HTML document”, p. 91-93: “relevant document is loaded into Pad++”). . . .

The Examiner notes the PTAB reached a similar determination regarding the obviousness of HTML objects in general in the Final Written Decision issued 03/27/2014 (see: Final Written Decision, pp. 21-22: “Bederson describes objects in the Pad++ hierarchy. . .standard objects supported by Pad++ include colored text, graphics, portal and HTML. . .Bederson disclose preserving the layout, functionality and design of the part of the web page that is translated”). Similarly, the PTAB also found PO’s argument unpersuasive that Pad++ only generates Pad++ objects and treats entire Web pages in Pad++ as a single object (see: Final Written Decision, p. 26: “features of Pad++. . .pertain to moving objects as a whole, which in the case of an HTML item would be an entire web page. . .Bederson discloses an example of Pad++ to zoom in on a portion of Bederson’s home web page (an HTML document). . .Pad++ discloses zooming on a portion of a web page. . .the selection of which tags to implement is a matter that would be well within the knowledge and abilities of a person of ordinary skill in the art and would be obvious”).

RAN 72–74.

Patent Owner argues Pad++ does not teach HTML objects and states, “[c]laims under Issue 1 were amended to clarify the objects were HTML objects.” Patent Owner’s Appeal Brief 30.

Pad++ clearly does not teach HTML objects. As observed by Howard, 90. . . . In the Pad++ browser, the HTML content for a Web page is parsed and Pad++ objects including Pad++ text objects and Pad++ image objects are generated, along with hyperlinks associated with some of text and image objects. There are no HTML objects that are generated. The Pad++ object hierarchy is shown below. The HTML object is a Pad++ object corresponding to an entire Web page, which is treated in Pad++ as a single object.

Patent Owner’s Appeal Brief 32.

The Cross-Appellant responds:

Patent Owner argues that the claims are patentable because the claims “were amended to clarify the objects were HTML objects.” PO Brief p.30. However, these amendments do not meaningfully narrow the claims from those found unpatentable during IPR.

Third Party Requester’s Respondent Brief 13.

Importantly, the ’353 Patent specification does not define or even use the term “HTML objects” or distinguish “HTML objects” from any other object. Rather, the specification simply uses the term “objects” to refer to objects created from HTML content on a web page. Indeed, the “objects” recited in the claims prior to amendment were *generated from* the HTML-based Web content. Thus, a POSITA would have understood that the “objects” in the claims prior to amendment were necessarily *HTML* objects to begin with, and therefore PO’s amendment to insert the word “HTML” before “object” does nothing to narrow the claims in any way. Ex. N ¶¶15–23.

. . . .

The specification makes clear that the term “objects” refers to logical groupings of HTML content. [’353 Patent],

16:19–20. Those logical groupings of HTML content may include, for example, text content and images, parsed from an HTML document. *Id.*, 16:22–31. Therefore, a POSITA would understand the description of “objects” in the specification to refer to “HTML” objects. Ex. N ¶¶24–35. In fact, Patent Owner cites this description as support for the claim amendment “HTML object” in the July 24, 2017 Response. See Appendix A, claim 25 (citing as support 12:48–17:41); FIGs. 4B, 5. There is no written description to support Patent Owner’s erroneous assertion that an “HTML object” is different from the objects described in the specification and recited in the original claims. Therefore, because the addition of “HTML” before “object” does nothing to further limit the claims, the Board’s finding that Pad++ discloses “objects” applies equally to “HTML” objects in the amended claims.

Third Party Requester’s Respondent Brief 14–15 (emphasis omitted).

Patent Owner then argues in rebuttal:

While a POSITA may have understood the “objects” in the claims prior to amendment were necessarily HTML objects to begin with, the PTAB panels members clearly were not POSITAs in the HTML and CSS arts and construed “object” to cover the use of object in Pad++. Pad++ creates what it refers to as a single HTML object (item) for the entire page. The claims require generation of multiple HTML objects.

Patent Owner’s Rebuttal Brief 21–22. Patent Owner then repeats:

As observed by Howard, 90. . . . In the Pad++ browser, the HTML content for a Web page is parsed and Pad++ objects including Pad++ text objects and Pad++ image objects are generated, along with hyperlinks associated with some of text and image objects. There are no HTML objects that are generated. The Pad++ object hierarchy is shown below. The HTML object is a Pad++ object corresponding to an entire Web page, which is treated in Pad++ as a single object.

Patent Owner’s Rebuttal Brief 22.

We agree with the reasoning of Cross-Appellant, Examiner, and the PTAB in its FWD, that Pad++ objects are inclusive of HTML objects. Similarly, the “objects” in the cancelled claims would be understood to be inclusive of HTML objects. Thus, we conclude that adding of “HTML” before “object” in the amended claims does nothing to render the amended claims patentably distinct from the cancelled claims. At best, addition of “HTML” before “object” merely limits the full scope of the cancelled claim to an obvious subset of that scope.

3. *Independent Claim 37*

We reject appealed claim 37 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 36 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 37 differs from cancelled claim 36 in that it includes the article “the” to limit the antecedent basis of “HTML-based Web content” to be the entire HTML-based Web content. However, for the reasons discussed *supra* in Section III.B.2.f., such an amendment does not render claim 37 patentably distinct.

Also, appealed claim 37 differs from cancelled claim 36 in that it includes a “mobile phone” limitation. As to the § 103 rejection, Patent Owner argues:

Pad++ was never implemented on a mobile device, PDA, or mobile phone. A PHOSITA at the time of the invention would not have any motivation to attempt to do so, could not do so without undue experimentation, and would have no reasonable expectation of success.

Patent Owner's Appeal Brief 51. We do not find Patent Owner's mobile phone argument applicable here because, other than the mobile phone limitation, claim 37 is directed to a mobile hand-held device with Web page rendering that is not otherwise patentably distinct from the mobile hand-held device of cancelled claim 36 (Cancelled Claim Appendix attached).

The only remaining issue is whether it would have been obvious to supplement with telephone functionality the processor of the mobile hand-held device of cancelled claim 36. We conclude that it would have been obvious to do so as the combination of a processor/computer and a mobile telephone was known well before Patent Owner's earliest June 12, 2000 filing date. *See* for example Morris, US 5,020,090, issued May 28, 1991; and O'Sullivan US RE38,127 E, issued May 27, 2003 (filed February 5, 1992). Particularly, O'Sullivan states, "[i]t is a primary object of the present invention to provide a novel and improved portable hybrid communication system incorporating an integrated, portable unit which includes a personal computer, cellular transmitter." O'Sullivan, col. 2:45–48. O'Sullivan also states, "[t]he portable personal computer 90 may be any programmable computing device, such as a hand-held calculator or portable computer." O'Sullivan, col. 5:63–65.

4. *Independent Claim 38*

We reject appealed claim 38 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 36 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

As with appealed claim 37, appealed claim 38 differs from cancelled claim 36 in that it includes the article "the" to limit the antecedent basis of

“HTML-based Web content” to be the entire HTML-based Web content. However, for the reasons discussed *supra* in Section III.B.2.f., such an amendment does not render claim 37 patentably distinct.

Similar to claim 37, appealed claim 38 differs from cancelled claim 36 in that it includes a “Personal Digital Assistant (PDA)” limitation. Again, the only remaining issue is whether it would have been obvious to supplement the processor of the mobile hand-held device of cancelled claim 36 by adding PDA utilities. We conclude that it would have been obvious to do so because a PDA is a known form of computing device and appealed claim 38 does not require any particular PDA utilities (even a basic calendar function would suffice). *See* for example: Culbert US 5,708,816, issued January 13, 1998; and *see* Kato US 6,088,730 issued July 11, 2000 (filed January 12, 1998).

Personal computing has undergone a revolution over the past decade. The steady increase in the computing power of microchips, coupled with advances in the miniaturization of electronics and the development of strong, lightweight materials and batteries, has fostered the creation of a large market in ever smaller computing devices. Such computing devices include notebook computers, such as Apple Computer, Incorporated’s PowerBook™ and Duo™ notebook computers, which are lightweight and offer the computing power of desktop computers. ***Smaller still are the relatively new hand held computing devices, otherwise known as personal digital assistants, or PDAs.***

Culbert, col. 1:14–25 (emphasis added).

A primary use of a PDA is to manage and to browse personal information or PIM (Personal Information Manager) data, such as a calendar, a schedule, an address book, a memorandum book or the like.

Kato, col. 2:8–11. Further, the Examiner finds “Pad++ discloses the device comprises one of a Personal Digital Assistant (PDA) or hand-held computer [e.g., PDAs running Pad++]. Bederson-5 at 5.” RAN 38. Given that adding software utility tools to processor devices is ubiquitous in the art, we conclude that adding minimal PDA utility to cancelled claim 36 would have been obvious.

5. *Independent Claim 5*

We reject appealed claim 5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 138/118 which were finally cancelled during an *inter partes* review of the ’353 patent which is the subject of this reexamination.

Except for the limitations discussed *infra*, claim 5 is a combination of the cancelled sub-combination claims 1 and 138/118. Our review does not find any additional synergy from the combination of cancelled claims 1 and 138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 5 is not patentably distinct from the cancelled sub-combination claims.

Also, appealed claim 5 differs from cancelled claims 1 and 138/118 in that it is amended to remove the “at least a portion” limitation of cancelled claims 1 and 118. However, for the reasons discussed *supra* in Section III.B.2.f., such an amendment does not render claim 5 patentably distinct from cancelled claims 1 and 138/118.

Further, appealed claim 5 is amended to recite “HTML” objects. However, for the reasons discussed *supra* in Section III.B.2.g., such an

amendment does not render claim 5 patentably distinct from cancelled claims 1 and 138/118.

Finally, amended claim 5 includes text objects, graphic layout objects, and graphic image objects. Cancelled claim 138/118 recites parsing HTML-based code and logically grouping selected content into objects. Bederson-3 at page 264 discloses “visualization and navigation of WWW pages written using standard HTML” in Pad++ and states “HTML provides very few basic types. Examples include text, images, bullets items, and horizontal rules.” We conclude an artisan would understand these examples to be text objects, graphic layout objects, and graphic image objects. Given that cancelled claim 138/118 includes HTML objects and standard HTML includes as basic types the claimed text objects, graphic layout objects, and graphic image objects. We conclude that adding use of text objects, graphic layout objects, and graphic image objects to the combination of cancelled claims 1 and 138/118 would have been obvious and does not render appealed claim 5 patentably distinct over the cancelled claims.

6. Claims Depending from Claim 5

a) Dependent Claim 2 – User Selectable Portion

We reject appealed claim 2/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1, claim 138/118, and claim 48/36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 2/5 adds “a user-selectable portion of a display” to its parent appealed claim 5. The resulting claim 2/5 is a combination of the cancelled sub-combination claims 1, 138/118, and 48/36 (a user selected column).

Our review does not find any additional synergy from the combination of cancelled claims 1, 138/118, and 48/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 2/5 is not patentably distinct from the cancelled sub-combination claims.

b) Dependent Claim 3 – Real Time Rendering

We reject appealed claim 3/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 33/1 (the scalable content comprises vector-based content) and claim 138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 3/5 adds “re-rendered in real-time” to its parent appealed claim 5. “Real-time” in U.S. Patent 7,461,353, is described as follows, “because the resulting file graphics are handled as vectors, the end user can control real time changes in the size of text and graphics as well as what portion of the file is viewable in the display.” '353, col. 4:67–5:3. We conclude the '353 patent describes “real time changes” as a characteristic of using vectors for scaling. Contrary to Patent Owner’s arguments (e.g., Patent Owner’s Appeal Brief 45–47), the '353 patent does not describe “real-time” in terms of a particular length of time or a user’s perception of time.

Our review does not find any additional synergy from the combination of cancelled claims 33/1 and 138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 3/5 is not patentably distinct from the cancelled sub-combination claims.

c) Dependent Claim 4 - Hyperlink

We reject appealed claim 4/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1, claim 138/118, and claim 317 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 4/5 adds “at least one hyperlink” to its parent appealed claim 5. The resulting claim 4/5 is a combination of the cancelled sub-combination claims 1, 138/118, and 317 (at least one hyperlink).

Our review does not find any additional synergy from the combination of cancelled claims 1, 138/118, and 317. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 4/5 is not patentably distinct from the cancelled sub-combination claims.

d) Dependent Claim 6 – Different Resolutions

We reject appealed claim 6/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 6/5 adds “displayed at different resolutions by scaling” to its parent appealed claim 5. The resulting claim 6/5 is a combination of the cancelled sub-combination claims 1 (“a scalable resolution-independent representation”) and 138/118 (“a scalable resolution-independent representation”).

Our review does not find any additional synergy from the combination of cancelled claims 1 and 138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore,

we conclude that based on the combined limitations, appealed claim 6/5 is not patentably distinct from the cancelled sub-combination claims.

e) Dependent Claim 7 – Return to Previous View

We reject appealed claim 7/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1, claim 138/118, and claim 317 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 7/5 adds “returning the display of the Web page to a previous view” to its parent appealed claim 5. The resulting claim 7/5 is a combination of the cancelled sub-combination claims 1, 138/118, and 317 (zoom out to a previous view of the Web page).

Our review does not find any additional synergy from the combination of cancelled claims 1, 138/118, and 317. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 7/5 is not patentably distinct from the cancelled sub-combination claims.

f) Dependent Claim 8 – Pan a View

We reject appealed claim 8/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1, claim 138/118, and claim 36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 8/5 adds “pan a view” to its parent appealed claim 5. The resulting claim 8/5 is a combination of the cancelled sub-combination claims 1, 138/118, and 36 (panned views).

Our review does not find any additional synergy from the combination of cancelled claims 1, 138/118, and 48/36. Rather, in the combination the

limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 8/5 is not patentably distinct from the cancelled sub-combination claims.

g) Dependent Claim 9 – Real Time Panning

We reject appealed claim 9/8/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 33/1, claim 138/118, and claim 36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 9/8/5 adds “panned in real-time” to its parent appealed claim 8/5. As discussed *supra* for appealed claim 3, the resulting claim 9/8/5 is a combination of the cancelled sub-combination claims 33/1 (the scalable content comprises vector-based content), 138/118, and 36 (panned views).

Our review does not find any additional synergy from the combination of cancelled claims 33/1, 138/118, and 48/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 9/8/5 is not patentably distinct from the cancelled sub-combination claims.

h) Dependent Claim 10 – Different Aspect Ratio

We reject appealed claim 10/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 10/5 differs from cancelled claims 1 and 138/118 in that it adds “different aspect ratios” to its parent appealed claim 5. The patent discloses:

By enabling different scaling factors to be applied to the X and Y axes, the present invention enables the aspect ratio of a rendered display image to be adjusted to better fit the aspect ratio of the client device.

’353, col. 21:10–13.

The issue is whether it would have been obvious to add different aspect ratios to the limitations of claim 5 discussed *supra*. That is, would it have been obvious to separately modify the X and Y axes. We conclude that it would have been obvious to do so because Bederson-4 at 1132 discloses that calculations can be done on the x-axis separately (as the Examiner and Third Party Requester both point out; RAN 30; Claim Chart A at 58–64).

Our review does not find any additional synergy from the combination of cancelled claims 1 and 138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 10/5 is not patentably distinct from the cancelled sub-combination claims.

i) Dependent Claim 11 – Column Zoom

We reject appealed claim 11/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1, claim 138/118, and claim 48/36 which were finally cancelled during an *inter partes* review of the ’353 patent which is the subject of this reexamination.

Appealed claim 11/5 adds “zoom on a column” to its parent appealed claim 5. The resulting claim 11/5 is a combination of the cancelled sub-

combination claims 1, 138/118, and 48/36 (zoom a user selected column to fit across the display).

Our review does not find any additional synergy from the combination of cancelled claims 1, 138/118, and 48/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 11/5 is not patentably distinct from the cancelled sub-combination claims.

j) Dependent Claim 12 – Column Reformatted

We reject appealed claim 12/11/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1, claim 138/118, and claim 48/36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 12/11/5 differs from cancelled claims 1, 138/118, and 48/36 in that it adds “the column is reformatted to fit characteristics of the display” to its parent appealed claim 11/5. We agree with the Examiner that adding such to appealed claim 11/5 would have been obvious because:

Pad++ is designed to support that panning and zooming of “standard objects ... (broadly disclosing column objects)” Bederson-5 at 6. Pad++ zooms and pans HTML objects such as “HTML...text, images, bullets items, and horizontal rules.” Bederson-3 at 264. Pad++ discloses that “[c]licking on a page when it is distant causes Pad++ to pan and zoom so that the page fills most of the screen (reformatted to fit characteristics of the display when re-rendered).” Bederson-5 at 14. Also See Bederson-5 at 10. As a column is a frame object identified by horizontal rules and text, one of ordinary skill in the art would understand that Pad++ reformats the content of the column to fit characteristics of the display when re-rendering.

RAN 31–32.

Our review does not find any additional synergy from the combination of cancelled claims 1, 138/118, and 48/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 12/11/5 is not patentably distinct from the cancelled sub-combination claims.

k) Dependent Claim 13 – Column Tapping

We reject appealed claim 13/11/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1, claim 138/118, and claim 48/36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 13/11/5 differs from cancelled claims 1, 138/118, and 48/36 in that it adds “user input comprises tapping on the column” to its parent appealed claim 11/5. We conclude that it would have been obvious to do so because a tapping is a known form of user input for a PDA. *See for example:* Ausems US 6,434,403 B1, issued August 13, 2002 (filed February 19, 1999).

The user may select the item by tapping the location on display 145 at which the item is displayed.

Ausems, col. 7:24–25 (emphasis added).

Our review does not find any additional synergy from the combination of cancelled claims 1, 138/118, and 48/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 13/11/5 is not patentably distinct from the cancelled sub-combination claims.

l) Dependent Claim 14 – Column Across Display

We reject appealed claim 14/11/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1, claim 138/118, and claim 48/36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 14/11/5 adds “rendered to fit across the display” to its parent appealed claim 11/5. The resulting claim 14/11/5 is a combination of the cancelled sub-combination claims 1 (rendered to fit across the display), 138/118, and 48/36.

Our review does not find any additional synergy from the combination of cancelled claims 1, 138/118, and 48/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 14/11/5 is not patentably distinct from the cancelled sub-combination claims.

m) Dependent Claim 15 – Image Zoom

We reject appealed claim 15/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1, claim 138/118, and claim 51/36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 15/5 adds “zoom on an image” to its parent appealed claim 5. The resulting claim 15/5 is a combination of the cancelled sub-combination claims 1, 138/118, and 51/36 (zoom on an image).

Our review does not find any additional synergy from the combination of cancelled claims 1, 138/118, and 51/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore,

we conclude that based on the combined limitations, appealed claim 15/5 is not patentably distinct from the cancelled sub-combination claims.

n) Dependent Claim 16 – Image Tapping

We reject appealed claim 16/15/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1, claim 138/118, and claim 52/51/36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 16/15/5 adds “tapping” to its parent appealed claim 15/5. The resulting claim 16/15/5 is a combination of the cancelled sub-combination claims 1, 138/118, and 52/51/36 (tapping on an image).

Our review does not find any additional synergy from the combination of cancelled claims 1, 138/118, and 52/51/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 16/15/5 is not patentably distinct from the cancelled sub-combination claims.

o) Dependent Claim 17 – Image Across Display

We reject appealed claim 17/15/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1, claim 138/118, and claim 51/36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 17/15/5 adds “rendered to fit across the display” to its parent appealed claim 15/5. The resulting claim 17/15/5 is a combination of the cancelled sub-combination claims 1 (rendered to fit across the display), 138/118, and 51/36 (rendered to fit across the display).

Our review does not find any additional synergy from the combination of cancelled claims 1, 138/118, and 51/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 17/15/5 is not patentably distinct from the cancelled sub-combination claims.

p) Dependent Claims 18–21 – Paragraph Operations

We reject appealed claims 18/5, 19/18/5, 20/18/5, and 21/18/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claims which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination. Our reasons are the same as for claims 11/5, 12/11/5, 13/11/5, and 14/11/5 discussed *supra*.

Although the operations in claims 18–21 are directed to a paragraph and the operations in claims 11–14 are directed to a column, we find no meaningful difference. A paragraph is a distinct portion of written or printed material dealing with a particular idea, and a column is a vertical arrangement on a page of horizontal lines of type. Both are well-known arrangements of printed material, and the claimed computer/display operations performed on one would be recognized by an artisan as equally applicable to the other.

q) Dependent Claim 22 – Text/Layout Connection & Image Connection

We reject appealed claim 22/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 22/5 differs from cancelled claims 1 and 138/118 in that it adds “receiving . . . text and layout attributes via a first connection”

and “receiving . . . at least one image via a second connection” to its parent appealed claim 5. We agree with the Examiner that adding such to appealed claim 5 would have been obvious because:

Citations to '353 evidence what was known in the art, that Web pages in the prior art included text, layout attributes, and images. See '353 at 7:38–65. '353 suggests that content could be received via a first connection and other content could be received via a second connection. '353, at 7:28–65, 8:5–18, 16:39–67 (“conventional web content retrieval techniques”, retrieving files that may be stored locally on the web server and web page’s content may comprise one or more documents that are stored at remote locations ... / references to other objects... image files...stored locally to the server or stored on a remote server). '353 at 7:56–67, “HTML is a standardized language that describes the layout of content on a web page, and attributes of that content...defined by sets of tags...” As evidenced above, the receiving of content by way of a first and second connection was well known in the art at the time of the filing of the '353 patent. Thus, one of ordinary skill in the art would have found this feature obvious. See '353 at 17:31–34, “As will be recognized by those skilled in the art, the functions performed in blocks 150, 152, and 154 are commonly performed by conventional browsers during a pre-rendering process.”

RAN 37–38.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 22/5 is not patentably distinct from the cancelled sub-combination claims.

r) Dependent Claim 23 – Different Scale Factors

We reject appealed claim 23/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 33/1 and claim 138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 23/5 differs from cancelled claims 1 and 138/118 in that it adds “a vector-based display list associated with the scalable content” and “re-render the display at different scale factors” to its parent appealed claim 5. However, scalable content comprising vector-based content is found in cancelled claim 33/1, and we conclude that re-rendering at different scale factors is merely another way of saying “scaling the scalable content” found in cancelled claims 1 and 118.

Our review does not find any additional synergy from the combination of cancelled claims 33/1 and 138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 23/5 is not patentably distinct from the cancelled sub-combination claims.

s) Dependent Claim 28 – Scalable Font

We reject appealed claim 28/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 28/5 differs from cancelled claims 1 and 138/118 in that it adds “scaling a scalable font” to its parent appealed claim 5. We agree with the Examiner that adding such to appealed claim 5 would have been obvious because:

“In Pad++, all the fonts used with the renderer share two global font caches...The font cache mechanism accelerates rendering of small-sized text...The font cache lets Pad++ zoom text quickly ...” (scaling a scalable font to render the scalable text content)
Bederson-4 at 1109.

RAN 38.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 28/5 is not patentably distinct from the cancelled sub-combination claims.

t) Dependent Claim 30 – Mobile Phone

We reject appealed claim 30/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 30/5 differs from cancelled claims 1 and 138/118 in that it adds “mobile phone” to its parent appealed claim 5. The issue is whether it would have been obvious to supplement with telephone functionality the processing means of the wireless device of cancelled claim 1. We conclude that it would have been obvious to do so for the same reasons set forth for claim 37 *supra*.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 30/5 is not patentably distinct from the cancelled sub-combination claims.

u) Dependent Claim 31 – PDA or Hand-held Computer

We reject appealed claim 31/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 31/5 differs from cancelled claims 1 and 138/118 in that it adds “Personal Digital Assistant (PDA) or hand-held computer” to its parent appealed claim 5. The issue is whether it would have been obvious to supplement with PDA utilities the processing means of the wireless device of cancelled claim 1. We conclude that it would have been obvious to do so for the same reasons set forth for claim 38 *supra*. Further, Pad++ suggests it is beneficial to combine PDA utilities with a zoomable interface (such as in cancelled claims 1 and 138/118):

This new system, Pad++, serves as a substrate for exploration of novel interfaces for information visualization and browsing in complex, information-intensive domains. The system is being designed to operate on platforms ranging from high-end graphics workstations to PDAs (Personal Digital Assistants) and interactive set-top cable boxes.

Bederson-5 at 5.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 31/5 is not patentably distinct from the cancelled sub-combination claims.

v) *Dependent Claim 32 - Mobile Service Provider Network*

We reject appealed claim 32/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 32/5 differs from cancelled claims 1 and 138/118 in that it adds “a mobile service provider network” to its parent appealed claim 5. The issue is whether it would have been obvious to supplement with a mobile service provider network the processing means of the wireless device of cancelled claim 1. We conclude that it would have been obvious to do so as Pad++ suggests it is beneficial to combine a mobile service provider network with a zoomable interface (such as in cancelled claims 1 and 138/118):

Today, there is much more information available than we can access readily and effectively. The situation is further complicated by the fact that we are on the threshold of a vast increase in the availability of information because of new network and computational technologies. Paradoxically, while we continuously process massive amounts of perceptual data as we experience the world, we have perceptual access to very little of the information that resides within our computing systems or that is reachable via network connections.

Bederson-5 at 5.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 32/5 is not patentably distinct from the cancelled sub-combination claims.

w) *Dependent Claim 34 – Desktop, Notebook, or Laptop*

We reject appealed claim 34/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 34/5 differs from cancelled claims 1 and 138/118 in that it adds “one of a desktop computer, notebook computer or laptop computer” to its parent appealed claim 5. The issue is whether it would have been obvious to use desktop hardware to implement the processing means of the wireless device of cancelled claim 1. We conclude that it would have been obvious to do so for the same reasons set forth for claim 31 *supra*.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 34/5 is not patentably distinct from the cancelled sub-combination claims.

x) *Dependent Claim 35 – Billions of Web Pages*

We reject appealed claim 35/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 35/5 differs from cancelled claims 1 and 138/118 in that it adds to its parent appealed claim 5:

35. The wireless device of claim 5, wherein the device enables a user to browse, zoom, and pan billions of Web pages in a manner that preserves the original layout, functionality, and design of the HTML-based Web page content of each Web page.

We conclude that the “enables” limitation is a statement of intended use. That is, the “enables a user” limitation is merely “for use” claim language. Such, “for use” language does not add a structural limitation to the claimed system or method. *See In re Anderson*, 662 F. App’x 958, 963 (Fed. Cir. 2016).

Moreover, as Patent Owner acknowledges, 3,000,000+ websites existed in 1999. Patent Owner’s Appeal Brief 38. Patent Owner’s contends that there is “no . . . evidence that billions of ‘simple’ HTML-based Web pages existed by June 2001.” Patent Owner’s Appeal Brief 50. However, an artisan would recognize that the layout, functionality (e.g., clicking on a hyperlink to a website), and design of cancelled claim 1 would potentially include billions of such “simple” web pages having two hyperlinks linking to two unique websites from the 3,000,000+ websites (i.e., $3,000,000 \times 2,999,999$). Patent Owner correctly contends “[t]he number of ‘simple’ HTML-based Web pages by June 2001 was not remotely close to a billion.” Patent Owner’s Appeal Brief 50. However, Patent Owner’s contention is unpersuasive because it fails to consider the vast number of Web pages that would have been obvious to an artisan at that time. Accordingly, even assuming that the “for use” language were to be construed as limiting, the prior art renders obvious the “billions” limitation.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 35/5 is not patentably distinct from the cancelled sub-combination claims.

y) Dependent Claim 320 – HTML Paragraph Objects

We reject appealed claim 320/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 320/5 differs from cancelled claims 1 and 138/118 in that it adds to its parent appealed claim 5:

320. The wireless device of claim 5, wherein the HTML text objects include HTML paragraph objects.

We conclude that it would have been obvious to include paragraph objects for the same reasons set forth for claims 18–21 *supra*.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 320/5 is not patentably distinct from the cancelled sub-combination claims.

*z) Dependent Claim 321 – HTML table object,
HTML table row objects, and HTML table data objects*

We reject appealed claim 321/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1, claim 138/118, and claim 48/36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 321/5 differs from cancelled claims 1 and 138/118 in that it adds to its parent appealed claim 5:

321. The wireless device of claim 5, wherein the plurality of HTML objects include an HTML table object, a plurality of HTML table row objects, and a plurality of HTML table data objects.

We conclude that it would have been obvious to include table objects for the same reasons set forth for columns as to claim 11 *supra*. An artisan would recognize that a table is a well-known arrangement of plural columns of printed material, and the claimed computer/display operations performed on a column would be recognized by an artisan as equally applicable to constructing a table. Further, an artisan would recognize that such column operation need only be performed redundantly to construct such table.

Our review does not find any additional synergy from the combination of cancelled claims 1, 138/118, and 48/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 321/5 is not patentably distinct from the cancelled sub-combination claims.

aa) Dependent Claim 322 – Cascaded Style Sheet Defining Layout

We reject appealed claim 322/321/5 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1, claim 138/118, claim 48/36. and claim 66/36 (cascaded style sheet data defining aspects of the Web page design) which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 322/321/5 differs from cancelled claims 1, 138/118, and 48/36 in that it adds to its parent appealed claim 321/5:

322 (emphasis added). The wireless device of claim 321, wherein the HTML-based Web content includes Cascaded Style Sheet (CSS) content ***defining formatting used to layout content*** associated with the HTML table object.

Although claim 322 differs from cancelled claim 66 in that claim 321 is directed to “layout” and claim 66 was directed to “design,” we find no

meaningful difference as layout and design are well-known synonyms of each other. Therefore, an artisan would recognize that cancelled claim 66 CSS operations directed to design are equally applicable to layout.

7. Independent Claim 24

We reject appealed claim 24 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

We reject claim 24 for the same reasons set forth for claim 5 *supra*. Our review does not find any additional synergy from the combination of cancelled claims 1 and 138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 24 is not patentably distinct from the cancelled sub-combination claims.

8. Claims Depending from Claim 24

a) Dependent Claim 25 – Bounding Box

We reject appealed claim 25/24 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 139/138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 25/24 adds “generating a bounding box” to its parent appealed claim 24. The resulting claim 25/24 is a combination of the cancelled sub-combination claims 1 and 139/138/118 (generating a bounding box).

Our review does not find any additional synergy from the combination of cancelled claims 1 and 139/138/118. Rather, in the combination the

limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 25/24 is not patentably distinct from the cancelled sub-combination claims.

b) Dependent Claim 26 – Mapping to Virtual Display

We reject appealed claim 26/25/24 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 139/138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 26/25/24 adds “mapping . . . to a virtual display in memory” to its parent appealed claim 25/24. The issue is whether it would have been obvious to supplement with mapping to a virtual display the processing means of the wireless device of cancelled claim 1. We conclude that it would have been obvious to do so for reasons set forth for by the Examiner:

Pad++ discloses dynamic memory employed for rendering purposes, building a display list via use of the scalable content and rendering display list content on a virtual display in the dynamic memory and scaling the display list content to re-render the display of the Web page. See Bederson-3 at 262 and tree layout (display list) system that permits users to dynamically add to and reorganize a tree of web pages. Bederson-4 at 1121 teaches retrieving objects in display-list order, so they can be drawn with the correct overlapping behavior. See discussion on R-tree hierarchical structure (display list content) based on bounding regions. Bederson-4 at 1120.

RAN 39–40.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 139/138/118. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore,

we conclude that based on the combined limitations, appealed claim 26/25/24 is not patentably distinct from the cancelled sub-combination claims.

c) Dependent Claim 27 – User-Selectable Zoom And Pan

We reject appealed claim 27/26/25/24 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 33/1, claim 139/138/118, and 48/36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 27/26/25/24 recites a host of limitations (e.g., user-selectable, scale factor, zoom level, panned view, virtual display, bounding boxes) discussed *supra*. We conclude that it would have been obvious to include these limitations of claim 27/26/25/24 for the same reasons set forth for claims 2, 23, and 26 *supra*.

Our review does not find any additional synergy from the combination of cancelled claims 33/1, 139/138/118, and 48/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 27/26/25/24 is not patentably distinct from the cancelled sub-combination claims.

9. Independent Claim 87

We reject appealed claim 87 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Except for the limitations discussed *infra*, claim 87 is a combination of the cancelled sub-combination claims 1 and 36. Our review does not find

any additional synergy from the combination of cancelled claims 1 and 36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 87 is not patentably distinct from the cancelled sub-combination claims.

10. Claims Depending from Claim 87

a) Dependent Claim 99 – Pan While Zoomed

We reject appealed claim 99/87 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 99/87 differs from cancelled claims 1 and 36 in that it adds “pan a view of the web page while in a zoomed state” to its parent appealed claim 87. We conclude that it would have been obvious to do so because Pad++ discloses that panning while zoomed is a known form of display navigation.

This gives both a sense of context to the viewer as well as speeding up the animation since most of the panning is performed when zoomed out which covers much more ground than *panning while zoomed in*.

Bederson-5 at 7 (emphasis added).

Our review does not find any additional synergy from the combination of cancelled claims 1 and 36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 99/87 is not patentably distinct from the cancelled sub-combination claims.

b) Dependent Claim 105 – XML Code

We reject appealed claim 105/87 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 105/87 differs from cancelled claims 1 and 36 in that it adds “comprises XML code” to its parent appealed claim 87. We conclude that it would have been obvious to do so because Bray discloses that XML can be used with HTML, “you could just take XML and turn it into HTML and deliver that.” Bray 1.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 105/87 is not patentably distinct from the cancelled sub-combination claims.

c) Dependent Claim 106 – Cascaded Style Sheet Defining Design

We reject appealed claim 106/87 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 66/36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 66/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 106/87 is not patentably distinct from the cancelled sub-combination claims.

d) Dependent Claim 110 – LAN or WAN

We reject appealed claim 110/87 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 110/87 differs from cancelled claims 1 and 36 in that it adds “a Local Area Network or a Wide Area Network” to its parent appealed claim 87. We agree with the Examiner that adding such to appealed claim 87 would have been obvious because:

Bederson-3 at 269 discusses students zooming (student LAN) into a web page (World Wide Web on wide area network). Furthermore, '353 at 7:38-55 evidences what was known in the art, that LAN and WAN connections were used to access web page content.

RAN 40.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 110/87 is not patentably distinct from the cancelled sub-combination claims.

11. Independent Claim 122

We reject appealed claim 24 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 58/36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

We reject claim 122 for similar reasons set forth for claim 5 *supra*, including its discussion of cancelled claim 138/118 which parallels cancelled

claim 58/36. Our review does not find any additional synergy from the combination of cancelled claims 1 and 58/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 122 is not patentably distinct from the cancelled sub-combination claims.

12. Claims Depending from Claim 122

a) Dependent Claim 145 – Hand-held Device

We reject appealed claim 145/122 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 58/36 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 58/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 145/122 is not patentably distinct from the cancelled sub-combination claims.

b) Dependent Claim 147 – Vector-based Content

We reject appealed claim 147/122 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1, claim 58/36, and claim 43/36 (scalable vector-based content) which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Our review does not find any additional synergy from the combination of cancelled claims 1, 58/36, and 43/36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore,

we conclude that based on the combined limitations, appealed claim 145/122 is not patentably distinct from the cancelled sub-combination claims.

13. Independent Claim 285

We reject appealed claim 285 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 317 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 317. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 285 is not patentably distinct from the cancelled sub-combination claims.

14. Claims Depending from Claim 285

a) Dependent Claim 309 – Web Browser

We reject appealed claim 309 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 1 and claim 317 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 309/285 differs from cancelled claims 1 and 317 in that it adds “a Web browser” to its parent appealed claim 285. We agree with the Examiner that adding such to appealed claim 285 would have been obvious because:

Pad++ teaches operations including rendering a browser interface via which a user is enabled to request access to an original Web page, the Web page comprising HTML based Web content having an original format defining an original width and height of the Web page and an original page layout, functionality,

and design of content on the Web page (Bederson-3 at 260, 262, 264; Bederson-5 at 12-13; Bederson-4 at 1103. Pad++ enables “navigation of WWW pages written using standard HTML [and that] HTML provides [Web content defining] text, images, bullets items, and horizontal rules.” Bederson-3 at 264.).

RAN 23.

Our review does not find any additional synergy from the combination of cancelled claims 1 and 317. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 309 is not patentably distinct from the cancelled sub-combination claims.

15. Remaining Independent Claims

a) Independent Claim 50

We reject appealed claim 50 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 48/36 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 50 differs from cancelled claim 48/36 in that it includes a “user input comprises tapping” limitation. The only remaining issue is whether it would have been obvious to supplement with tapping for user input the mobile hand-held device of cancelled claim 48/36. We conclude that it would have been obvious to do so because tapping is a known form of user input as discussed *supra* with regard to claim 13.

b) Independent Claim 53

We reject appealed claim 50 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 48/36 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 53 differs from cancelled claim 48/36 in that it includes paragraph operations. The only remaining issue is whether it would have been obvious to supplement the mobile hand-held device of cancelled claim 48/36 with such paragraph operations. We conclude that it would have been obvious to do so as discussed *supra* with regard to claims 18–21.

c) Independent Claim 60

We reject appealed claim 60 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 59/58/36 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 60 differs from cancelled claim 59/58/36 in that it does not include the “at least a portion” limitation of cancelled claim 36. However, for the reasons discussed *supra* in Section III.B.2.f., such does not render claim 60 patentably distinct from cancelled claim 36.

Also, appealed claim 60 differs in that it includes “HTML” objects. However, for the reasons discussed *supra* in Section III.B.2.g., such does not render claim 60 patentably distinct from cancelled claim 36.

Further, appealed claim 60 differs in that it includes “mapping . . . to a virtual display.” However, we conclude that including such would have been obvious for reasons set forth *supra* for claim 26.

d) Independent Claim 69

We reject appealed claim 69 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 36 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 69 differs from cancelled claim 36 in that it does not include the “at least a portion” limitation of cancelled claim 36. However, for the reasons discussed *supra* in Section III.B.2.f., such does not render claim 69 patentably distinct from cancelled claim 36.

Also, appealed claim 69 differs in that it includes “enables a user to browse, zoom, and pan billions of Web pages.” However, we conclude that including such would have been obvious for reasons set forth *supra* for claim 35.

e) Independent Claim 70

We reject appealed claim 70 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 36 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 70 differs from cancelled claim 36 in that it does not include the “at least a portion” limitation of cancelled claim 36. However, for the reasons discussed *supra* in Section III.B.2.f., such does not render claim 70 patentably distinct from cancelled claim 36.

f) Independent Claim 133

We reject appealed claim 133 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 43/36 and claim

138/118 which were finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

We reject appealed claim 133 for the reasons discussed *supra* as to appealed claims 5 and 18–21.

g) Independent Claim 144

We reject appealed claim 144 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 118 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Also, we reject appealed claim 144 for the reasons discussed *supra* as to appealed claim 37.

h) Independent Claim 150

We reject appealed claim 150 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 149 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Also, we reject appealed claim 150 for the reasons discussed *supra* as to appealed claim 37.

i) Independent Claim 151

We reject appealed claim 151 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 149 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Also, we reject appealed claim 151 for the reasons discussed *supra* as to appealed claim 38.

j) Independent Claim 174

We reject appealed claim 174 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 58/36 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Also, we reject appealed claim 174 for the reasons discussed *supra* as to appealed claim 5.

k) Independent Claim 182

We reject appealed claim 182 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 66/36 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 182 differs from cancelled claim 66/36 in that it does not include the “at least a portion” limitation of cancelled claim 36. However, for the reasons discussed *supra* in Section III.B.2.f., such does not render claim 182 patentably distinct from cancelled claim 66/36.

l) Independent Claim 184

We reject appealed claim 184 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 149 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 184 differs from cancelled claim 149 in that it includes “the” to eliminate an “at least a portion” interpretation such as for of cancelled claim 36. However, for the reasons discussed *supra* in Section III.B.2.f., such does not render claim 184 patentably distinct from cancelled claim 149.

Also, appealed claim 184 differs in that it includes “enabl[es] a user to browse, zoom, and pan billions of Web pages.” However, we conclude that including such would have been obvious for reasons set forth *supra* for claim 35.

m) Independent Claim 185

We reject appealed claim 185 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 48/36 which was finally cancelled during an *inter partes* review of the ’353 patent which is the subject of this reexamination.

Appealed claim 185 differs from cancelled claim 48/36 in that it does not include an “at least a portion” limitation such as for of cancelled claim 36. However, for the reasons discussed *supra* in Section III.B.2.f., such does not render claim 185 patentably distinct from cancelled claim 48/36.

Also, appealed claim 185 differs in that it includes “enables a user . . . to browse, zoom, and pan billions of Web pages.” However, we conclude that including such would have been obvious for reasons set forth *supra* for claim 35.

n) Independent Claim 209

We reject appealed claim 209 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 138/118 which was finally cancelled during an *inter partes* review of the ’353 patent which is the subject of this reexamination.

Appealed claim 209 differs from cancelled claim 138/118 in that it does not include an “at least a portion” limitation such as for of cancelled claim 118. However, for the reasons discussed *supra* in Section III.B.2.f.,

such does not render claim 209 patentably distinct from cancelled claim 138/118.

o) Independent Claim 216

We reject appealed claim 216 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 118 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 216 differs from cancelled claim 118 in that it does not include an “at least a portion” limitation such as for of cancelled claim 118. However, for the reasons discussed *supra* in Section III.B.2.f., such does not render claim 216 patentably distinct from cancelled claim 118.

p) Independent Claim 239

We reject appealed claim 239 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 138/118 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 239 differs from cancelled claim 138/118 in that it does not include an “at least a portion” limitation such as for of cancelled claim 118. However, for the reasons discussed *supra* in Section III.B.2.f., such does not render claim 239 patentably distinct from cancelled claim 138/118.

q) Independent Claim 253

We reject appealed claim 253 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 36 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 253 differs from cancelled claim 36 in that it includes a “mobile phone” limitation. The issue is whether it would have been obvious to supplement with telephone functionality the processing means of the wireless device of cancelled claim 36. We conclude that it would have been obvious to do so for the same reasons set forth for claim 37 *supra*.

Also, appealed claim 253 differs from cancelled claim 36 in that it does not include an “at least a portion” limitation such as for of cancelled claim 36. However, for the reasons discussed *supra* in Section III.B.2.f., such does not render claim 253 patentably distinct from cancelled claim 36.

Further, appealed claim 253 differs in that it includes “enables a user . . . to browse, zoom, and pan billions of Web pages.” However, we conclude that including such would have been obvious for reasons set forth *supra* for claim 35.

r) Independent Claim 254

We reject appealed claim 254 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 36 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 254 differs from cancelled claim 36 in that it does not include an “at least a portion” limitation such as for of cancelled claim 36. However, for the reasons discussed *supra* in Section III.B.2.f., such does not render claim 254 patentably distinct from cancelled claim 36.

Also, appealed claim 254 differs in that it includes “enables a user . . . to browse, zoom, and pan billions of Web pages.” However, we conclude that including such would have been obvious for reasons set forth *supra* for claim 35.

s) Independent Claim 274

We reject appealed claim 274 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 58/36 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 274 differs from cancelled claim 58/36 in that it does not include an “at least a portion” limitation such as for of cancelled claim 36. However, for the reasons discussed *supra* in Section III.B.2.f., such does not render claim 274 patentably distinct from cancelled claim 58/36.

Also, appealed claim 274 differs in that it includes “HTML” objects. However, for the reasons discussed *supra* in Section III.B.2.g., such does not render claim 274 patentably distinct from cancelled claim 58/36.

Further, appealed claim 274 differs in that it includes “enables a user . . . to browse, zoom, and pan billions of Web pages.” However, we conclude that including such would have been obvious for reasons set forth *supra* for claim 35.

t) Independent Claim 282

We reject appealed claim 282 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 66/36 which was finally cancelled during an *inter partes* review of the '353 patent which is the subject of this reexamination.

Appealed claim 282 differs from cancelled claim 66/36 in that it does not include an “at least a portion” limitation such as for of cancelled claim 36. However, for the reasons discussed *supra* in Section III.B.2.f., such does not render claim 282 patentably distinct from cancelled claim 66/36.

Also, appealed claim 282 differs in that it includes “enables a user . . . to browse, zoom, and pan billions of Web pages.” However, we conclude that including such would have been obvious for reasons set forth *supra* for claim 35.

u) Independent Claim 318

We reject appealed claim 318 based on estoppel under 37 C.F.R. § 42.73(d)(3)(i) as not being patentably distinct from claim 317 and claim 36 which were finally cancelled during an *inter partes* review of the ’353 patent which is the subject of this reexamination.

Our review does not find any additional synergy from the combination of cancelled claims 317 and 36. Rather, in the combination the limitations merely perform as they did in each sub-combination. Therefore, we conclude that based on the combined limitations, appealed claim 318 is not patentably distinct from the cancelled sub-combination claims.

16. All Remaining Claims

The remaining claims are dependent claims which limit their independent claims by adding *one or more limitations* discussed *supra* for other claims. We conclude that adding these one or more limitations would have been obvious for the reasons already discussed *supra*.

17. 37 C.F.R. § 41.77(b)

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.77(b). 37 C.F.R. § 41.77(b) provides “a new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.77(b) also provides that the owner, WITHIN ONE MONTH FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. The owner of the patent may file a response requesting reopening of prosecution before the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.79 by the Board upon the same record. . . .

IV. EFFECT OF THE EXPIRATION OF 7,461,353

As we note *supra*, U.S. Patent 7,461,353, which is the subject of this inter partes reexamination, will expire on April 18, 2022. If this inter partes reexamination is still pending at that time, any further proceedings will be consistent with 37 C.F.R. § § 1.530(j) and (k).

(j) *No enlargement of claim scope.* No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amendment may be proposed for entry in an expired patent. Moreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent.

(k) *Amendments not effective until certificate.* Although the Office actions will treat proposed amendments as though they have been entered, the proposed amendments will not be effective until the reexamination certificate is issued and published.

A. Effect on the Claims

Upon expiration of U.S. Patent 7,461,353, all amendments proposed during this inter partes reexamination will be withdrawn *except for* amendments cancelling claims and any claim amendments herein that were also set forth in the related Ex Parte Reexamination Certificate that issued on December 29, 2017 covering amendments to claims 5, 23–27, 60, 61, 122, 137, 140, 141, 147, 156, 174–177, 238–242, 248, 259 and 274–277, and adding new claims 320–322. For all other remaining claims which are not cancelled, any proposed amendments are withdrawn and those claims will be as they were when this inter partes reexamination was filed. In this case, they will be as they were issued.

The following claims will revert to depending from a claim that was cancelled during the *inter partes* review of U.S. Patent 7,461,353.

Claims 2–4, 6–22, 28, 30–32, 34, and 35, will revert back to dependency from cancelled claim 1.

Claims 37, 38, 41, 44–46, and 69, will revert back to dependency from cancelled claim 36.

Claims 123–126, 128–135, 144, and 145, will revert back to dependency from cancelled claim 118.

Claims 150–152, 154, 157–159, 161–173, 182, and 184, will revert back to dependency from cancelled claim 149.

Claims 253, 254, 257, 264–271, and 282, will revert back to dependency from cancelled claim 252.

Claims 318 and 319, will revert back to dependency from cancelled claim 317.

The following claims will revert back to a claim as originally issued in U.S. Patent 7,461,353, that is, revert back to a claim that lacks limitations the Patent Owner relies on to argue (but we disagree) the amended claim is patentably distinct.

Independent claim 70, will revert back to “processing *at least a portion* of the HTML-based Web content” as will its dependent claims 71–83, 85, and 86.

Independent claim 209, will revert back to “translating *at least a portion* of the HTML-based Web content” as will its dependent claim 215.

Independent claim 216, will revert back to “translating *at least a portion* of the HTML-based Web content” as will its dependent claims 226–236, 245–247, and 251.

B. Effect on this Decision

Upon expiration of U.S. Patent 7,461,353, the only effect on this Decision will be that the analysis simplifies as to all limitations added to the claims by proposed amendments that will be withdrawn. For example, the “Entire vs. Portion” discussion at Section III. B. 2. f). *supra* and the “HTML Objects” discussion at Section III. B. 2. g). *supra* each becomes moot for claims with dependency from cancelled claims 1, 36, 118, 149, and 252, as well as for claims 70, 209, and 216 and the claims depending therefrom, because these added limitations will no longer be present in these claims.

V. CONCLUSIONS

The Examiner erred in rejecting claims 2–28, 30–32, 34, 35, 37, 38, 41, 44–46, 50, 53–55, 60, 61, 69–83, 85–105, 107–111, 122–126, 128–135, 137, 140, 141, 144, 145, 147, 150–152, 154, 156–159, 161–177, 184–203, 205–209, 215, 216, 226–236, 238–242, 245–248, 251, 253, 254, 257, 259, 264–271, 274–277, 285–303, 305–310, and 318–321 as being unpatentable under 35 U.S.C. § 103.

The Examiner erred in making a final decision favorable to the patentability of claims 106, 182, 204, 282, 304, and 322.

We newly reject all claims subject to this reexamination based on 37 C.F.R. § 42.73(d) estoppel as not being patentably distinct from claims finally cancelled during an *inter partes* review of the patent which is the subject of this reexamination.

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed	New Ground
2–28, 31, 34, 35, 38, 41, 44–46, 50, 53– 55, 60, 61, 69– 80, 83, 85–104, 109–111, 122–126, 128–135, 137, 140, 141, 145, 147, 151, 152, 154, 156–159, 161–177, 184–202, 205, 207– 209, 215, 216, 226– 236, 238– 242, 246, 248, 251, 254, 257, 259, 264– 271, 274– 277, 285– 302, 307– 310, 318, 319	103	Pad++		2–28, 31, 34, 35, 38, 41, 44–46, 50, 53–55, 60, 61, 69– 80, 83, 85– 104, 109– 111, 122– 126, 128– 135, 137, 140, 141, 145, 147, 151, 152, 154, 156– 159, 161– 177, 184– 202, 205, 207–209, 215, 216, 226–236, 238–242, 246, 248, 251, 254, 257, 259, 264–271, 274–277, 285–302, 307–310, 318, 319	

Claim(s) Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed	New Ground
30, 32, 37, 81, 82, 107, 108, 144, 150, 205, 206, 245, 247, 253, 305, 306	103	Pad++, Nokia, Palm		30, 32, 37, 81, 82, 107, 108, 144, 150, 205, 206, 245, 247, 253, 305, 306	
30, 32, 37, 81, 82, 107, 108, 144, 150, 205, 206, 245, 247, 253, 305, 306	103	Pad++, Newton		30, 32, 37, 81, 82, 107, 108, 144, 150, 205, 206, 245, 247, 253, 305, 306	
30, 32, 37, 81, 82, 107, 108, 144, 150, 205, 206, 245, 247, 253, 305, 306	103	Pad++, Locatio		30, 32, 37, 81, 82, 107, 108, 144, 150, 205, 206, 245, 247, 253, 305, 306	
105, 203, 303	103	Pad++, Bray		105, 203, 303	

Claim(s) Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed	New Ground
320, 321	103	Pad++, common knowledge		320, 321	
5, 23–27, 60, 61, 70, 122, 137, 140, 141, 147, 156, 174– 177, 216, 238–242, 248, 259, 274–277	103	Pad++, HTML standards		5, 23–27, 60, 61, 70, 122, 137, 140, 141, 147, 156, 174–177, 216, 238– 242, 248, 259, 274– 277	
5, 23–27, 60, 61, 70, 122, 137, 140, 141, 147, 156, 174– 177, 216, 238–242, 248, 259, 274–277	103	Pad++, AAPA		5, 23–27, 60, 61, 70, 122, 137, 140, 141, 147, 156, 174–177, 216, 238– 242, 248, 259, 274– 277	

Claim(s) Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed	New Ground
2–28, 30– 32, 34, 35, 37, 38, 41, 44–46, 50, 53– 55, 60, 61, 69– 83, 85– 111, 122– 126, 128– 135, 137, 140, 141, 144, 145, 147, 150– 152, 154, 156–159, 161–177, 182, 184– 209, 215, 216, 226– 236, 238– 242, 245– 248, 251, 253, 254, 257, 259, 264–271, 274–277, 282, 285– 310, 318– 322		Estoppel under 37 C.F.R. § 42.73(d)			2–28, 30– 32, 34, 35, 37, 38, 41, 44–46, 50, 53–55, 60, 61, 69–83, 85–111, 122–126, 128–135, 137, 140, 141, 144, 145, 147, 150–152, 154, 156– 159, 161– 177, 182, 184–209, 215, 216, 226–236, 238–242, 245–248, 251, 253, 254, 257, 259, 264– 271, 274– 277, 282, 285–310, 318–322
Overall Outcome				2–28, 30– 32, 34, 35, 37, 38, 41, 44–46, 50,	2–28, 30– 32, 34, 35, 37, 38, 41, 44–46, 50,

				53–55, 60, 61, 69–83, 85–105, 107–111, 122–126, 128–135, 137, 140, 141, 144, 145, 147, 150–152, 154, 156– 159, 161– 177, 184– 203, 205– 209, 215, 216, 226– 236, 238– 242, 245– 248, 251, 253, 254, 257, 259, 264–271, 274–277, 285–303, 305–310, 318–321	53–55, 60, 61, 69–83, 85–111, 122–126, 128–135, 137, 140, 141, 144, 145, 147, 150–152, 154, 156– 159, 161– 177, 182, 184–209, 215, 216, 226–236, 238–242, 245–248, 251, 253, 254, 257, 259, 264– 271, 274– 277, 282, 285–310, 318–322
--	--	--	--	--	--

REVERSED; 37 C.F.R. § 41.77(b)

CANCELLED CLAIMS APPENDIX

The following claims 1, 33, 36, 43, 48, 51, 52, 58, 59, 66, 118, 138, 139, 149, 183, 252, 283, and 317 of U.S. Patent 7,461,353 B2 were finally cancelled by IPR2013-00007 and IPR2013-00256. Emphasis added.

1. A **wireless device**, comprising:
 - [A.] processing means;
 - [B.] wireless communications means, to facilitate wireless communication with a network that supports access to the Internet;
 - [C.] a display;
 - [D.] memory; and
 - [E.] storage means, in which a plurality of instructions are stored that when executed by the processing means enable the wireless device to perform operations including,
 - [i.] rendering a browser interface via which a user is enabled to request access to an original Web page, the Web page comprising HTML-based Web content having an original format defining an original width and height of the Web page and ***an original page layout, functionality, and design of content on the Web page***;
 - [ii.] in response to a user request to access the Web page,
 - [a.] retrieving the Web page via the wireless communication means, and ***translating at least a portion*** of the HTML-based Web content from its original format into scalable content that supports a scalable resolution-independent representation of the Web page that ***preserves*** the original page layout, functionality and design of the content defined by its original format ***when scaled and rendered***; and
 - [b.] scaling the scalable content to render the Web page on the display such that a width of the Web page is rendered to fit across the display.

33. The wireless device of claim 1, wherein a portion of the scalable content comprises ***vector-based content***.

36. A **mobile hand-held device**, comprising:
- [A.] a processor,
 - [B.] a wireless communications device, to facilitate wireless communication with a network that supports access to the Internet;
 - [C.] a display; and
 - [D.] flash memory, operatively coupled to the processor, in which a plurality of instructions are stored that when executed by the processor enable the mobile hand-held device to perform operations including,
 - [i.] rendering a browser interface via which a user is enabled to request access to a Web page comprising HTML-based Web content **defining an original page layout, functionality, and design of content on the Web page**;
 - [ii.] retrieving the Web page via the wireless communications device, and **processing** HTML-based Web content **to produce scalable content**; and
 - [iii.] employing at least one of the scalable content or data derived therefrom to,
 - [a.] render the Web page on the display; and
 - [b.] re-render the display in response to associated user inputs to enable the Web page to be browsed at various zoom levels and panned views while **preserving** the original page layout, functionality, and design of the Web page content **at each zoom level and panned view**.

43. The mobile hand-held device of claim 36, wherein at least a portion of the scalable content comprises **scalable vector-based content**.

48. The mobile hand-held device of claim 36, wherein execution of the instructions performs further operations comprising enabling a **user** to **zoom on a column** of the Web content via a corresponding user input, wherein in response thereto, the display is re-rendered such that content corresponding to the **selected** column is **rendered to fit across the display**.

51. The mobile hand-held device of claim 36, wherein the Web content includes *at least one image*, and wherein execution of the instructions performs further operations comprising enabling a *user* to *zoom on an image* via a corresponding user input, wherein in response thereto, the display is re-rendered such that the *image* is rendered to *fit across the display*.

52. The mobile hand-held device of claim 51, wherein the corresponding user input comprises *tapping* on the *image* via the display.

58. The mobile hand-held device of claim 36, wherein execution of the instructions performs further operations comprising:

[iv.] parsing HTML-based code corresponding to the retrieved Web page to determine the original page layout of the content on the Web page;

[v.] *logically grouping selected content into objects*;

[vi.] *defining a primary datum* corresponding to the original page layout; and,

[vii.] for each object

[a.] *defining an object datum* corresponding to a layout location datum for the object's associated display content;

[b.] *generating a vector* from the primary datum to the object datum for the object; and

[c.] creating a reference that links the object to the vector that is generated.

59. The mobile hand-held device of claim 58, wherein execution of the instructions performs further operations comprising:

[viii.] *generating a bounding box for each object*, the bounding box representing a portion of a rendered display page occupied by the object's associated group of content.

66. The mobile hand-held device of claim 36, wherein a portion of the HTML-based Web content comprises *cascaded style sheet data* defining aspects of the Web page design that are preserved at each zoom level and panned view.

118. A method, comprising:

[A.] rendering a browser interface on a display of a device via which a user is enabled to request access to a Web page, the Web page comprising HTML-based Web content having an original format defining an original width and height of the Web page and an original page layout, functionality, and design of content on the Web page;

[B.] in response to a user request to access the Web page, retrieving the Web page via the device, and translating at least a portion of the HTML-based Web content from its original format into scalable content that supports a scalable resolution-independent representation of the Web page that preserves the original page layout, functionality and design of the content defined by its original format when scaled and rendered; and

[C.] scaling the scalable content to render the Web page on the display such that a width of the Web page is rendered to fit across the display.

138. The method of claim 118, further comprising:

[D.] parsing markup language code corresponding to the retrieved Web page to determine the original page layout of the content on the Web page;

[E.] *logically grouping selected content into objects*;

[F.] *defining a primary datum* corresponding to the original page layout; and,

[G.] for each object,

[i.] *defining an object datum* corresponding to a layout location datum for the object's associated display content;

[ii.] *generating a vector* from the primary datum to the object datum for the object; and

[iii.] creating a reference that links the object to the vector that is generated.

139. The method of claim 138, further comprising:

[H.] *generating a bounding box for each object*, the bounding box representing a portion of a rendered display page occupied by the object's associated group of content.

149. A method, comprising:

[A.] rendering a browser interface on a *hand-held device* via which a user is enabled to request access to a Web page comprising HTML-based Web content *defining an original page layout, functionality, and design of content* on the Web page;

[B.] retrieving the Web page via the hand-held device, and *processing* HTML-based Web content *to produce scalable content*; and

[C.] employing at least one of the scalable content or data derived therefrom to;

[i.] render the Web page on a display of the hand-held device; and

[ii.] re-render the display in response to associated user inputs to enable the Web page to be browsed at various zoom levels and panned views while *preserving* the original page layout, functionality, and design of the Web page content *at each zoom level and panned view*.

183. The method of claim 149, wherein a portion of the scalable content comprises *vector-based content*.

252. A machine-readable medium having a plurality of instructions comprising a Web browser tangibly stored thereon, which when executed enable a device to perform operations comprising:

[A.] rendering a browser interface on a display associated with the device via which a user is enabled to request access to a Web page comprising HTML-based Web content defining an original page layout, functionality, and design of content on the Web page;

[B.] retrieving the Web page and *processing* HTML-based Web content *to produce scalable content*; and

[C.] employing at least one of the scalable content or data derived therefrom to,

[i.] render the Web page on the display; and

[ii.] re-render the display in response to associated user inputs to enable the Web page to be browsed at various zoom levels and panned views while preserving the original page layout, functionality, and design of the Web page content at each zoom level and panned view of the Web page,

wherein the Web browser enables a user of the device to browse, zoom, and pan *billions of Web pages* in a manner that *preserves* the original layout, functionality, and design of the HTML-based Web page content of each Web page *at each zoom level and panned view*.

283. The machine-readable medium of claim 252, wherein a portion of the scalable content comprises *vector-based content*.

317. A *hand-held wireless device*, comprising:
- [A.] a processor,
 - [B.] a wireless communications interface, to facilitate wireless communication with a network that supports access to the Internet;
 - [B.] a display; and
 - [C.] non-volatile memory, operatively coupled to the processor, in which software comprising a browser is stored, the browser comprising a plurality of instructions that when executed by the processor enable the device to perform operations including,
 - [i.] rendering a browser interface on the display via which a user is enabled to request access to a Web page including at least one image, at least one column, at least one *hyperlink* to an external reference and having a width and height;
 - [ii.] retrieving the Web page via the wireless communications interface;
 - [iii.] rendering the Web page on the display such that at least one of the width and height of the Web page is fully displayed; and
 - [iv.] enabling the *user* to,
 - [a.] *zoom and pan* a view of the Web page;
 - [b.] *activate a currently displayed hyperlink* to an external reference while at a given zoom level and panned view, wherein in response to an activation of a hyperlink to an external reference, Web content associated with the external reference is retrieved and rendered on the display;

- [c.] *zoom in on an image* of the Web page *by tapping* on the image via the display;
- [d.] *zoom in on a column* of the Web page *by tapping* on the column via the display; and
- [e.] *zoom out to a previous view of the Web page.*

Appeal 2021-005530
Reexamination Control 95/000,634
Patent US 7,461,353 B2

FOR PATENT OWNER:

LAW OFFICE OF R. ALAN BURNETT
4108 131ST AVE SE
BELLEVUE, WA 98006

FOR THIRD PARTY REQUESTER:

POLSINELLI PC
1000 LOUISIANA STREET, 53rd FLOOR
HOUSTON, TX 77002

Notice of References Cited				Application/Control No.		Applicant(s)/Patent Under Reexamination	
				95/000,634		SoftView LLC	
				Examiner		Art Unit	
				Adam Basehoar		3900	
				Page 1 of 1			

U.S. PATENT DOCUMENTS								
*		DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS	DOCUMENT SOURCE **	
							APS	OTHER
*	A	US 5,020,090	5/28/91	Morris			☐	☐
*	B	US 5,708,816	1/13/98	Culbert			☐	☐
*	C	US 6,088,730	7/11/00	Kato			☐	☐
*	D	US 6,434,403 B1	8/13/02	Ausems			☐	☐
*	E	US RE38,127 E	5/27/03	O'Sullivan			☐	☐
☐	F						☐	☐
☐	G						☐	☐
☐	H						☐	☐
☐	I						☐	☐
☐	J						☐	☐
☐	K						☐	☐
☐	L						☐	☐
☐	M						☐	☐

FOREIGN PATENT DOCUMENTS									
*		DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS	DOCUMENT SOURCE **	
								APS	OTHER
☐	N							☐	☐
☐	O							☐	☐
☐	P							☐	☐
☐	Q							☐	☐
☐	R							☐	☐
☐	S							☐	☐
☐	T							☐	☐

NON-PATENT DOCUMENTS				
*		DOCUMENT (Including Author, Title Date, Source, and Pertinent Pages)	DOCUMENT SOURCE **	
			APS	OTHER
☐	U		☐	☐
☐	V		☐	☐
☐	W		☐	☐
☐	X		☐	☐

*A copy of this reference is not being furnished with this Office action. (See Manual of Patent Examining Procedure, Section 707.05(a).)

**APS encompasses any electronic search i.e. text, image, and Commercial Databases.

U.S. Patent and Trademark Office

PTO-892 (Rev. 03-98) **Notice of References Cited**