



US007831926C2

(12) **INTER PARTES REEXAMINATION CERTIFICATE (1674th)**
United States Patent
Rohrbaugh et al.

(10) **Number:** **US 7,831,926 C2**(45) **Certificate Issued:** **Dec. 10, 2024**

(54) **SCALABLE DISPLAY OF INTERNET
CONTENT ON MOBILE DEVICES**

(75) Inventors: **Gary B. Rohrbaugh**, Bellingham, WA
(US); **Scott A. Sherman**, Seattle, WA
(US)

(73) Assignee: **SOFTVIEW L.L.C.**, Bellingham, WA
(US)

Reexamination Request:

No. 95/000,635, May 23, 2011

Reexamination Certificate for:

Patent No.: **7,831,926**

Issued: **Nov. 9, 2010**

Appl. No.: **11/738,486**

Filed: **Apr. 21, 2007**

Reexamination Certificate C1 7,831,926 issued Dec. 6, 2021

Related U.S. Application Data

(63) Continuation of application No. 09/878,097, filed on
Jun. 8, 2001, now Pat. No. 7,210,099, which is a
(Continued)

(51) **Int. Cl.**

G06F 17/00 (2019.01)
G06F 3/0488 (2022.01)
G06F 9/451 (2018.01)
G06F 16/957 (2019.01)
G06F 16/958 (2019.01)
G06F 40/103 (2020.01)
G06F 40/134 (2020.01)
G06F 40/143 (2020.01)
H04L 67/04 (2022.01)

(Continued)

(52) **U.S. Cl.**

CPC **G06F 40/143** (2020.01); **G06F 3/0488**
(2013.01); **G06F 9/451** (2018.02); **G06F**
16/9577 (2019.01); **G06F 16/986** (2019.01);
G06F 40/103 (2020.01); **G06F 40/134**

(2020.01); **H04L 67/04** (2013.01); **H04L**
67/565 (2022.05); **G06F 3/0481** (2013.01);
G06F 16/95 (2019.01); **G06F 16/9537**
(2019.01); **G06F 16/957** (2019.01); **G06F**
16/9574 (2019.01); **G06F 16/958** (2019.01);
G06F 2203/04806 (2013.01); **G06F 2212/1048**
(2013.01); **G06Q 30/02** (2013.01); **G09G 5/24**
(2013.01); **G09G 2340/0407** (2013.01); **G09G**
2340/0492 (2013.01); **H04L 67/02** (2013.01)

(58) **Field of Classification Search**

None

See application file for complete search history.

(56) **References Cited**

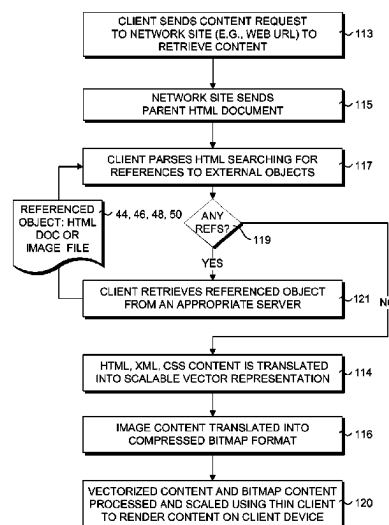
To view the complete listing of prior art documents cited
during the proceeding for Reexamination Control Number
95/000,635, please refer to the USPTO's Patent Electronic
System.

Primary Examiner — Adam L Basehoar

(57) **ABSTRACT**

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. The mobile devices employ soft-
ware-based processing of original Web content, including
HTML-based content, XML, cascade style sheets, etc. to
generate scalable content. The scalable content and/or data
derived therefrom are then employed to enable the Web
content to be rapidly rendered, zoomed, and panned. Display
lists may also be employed to provide further enhancements
in rendering speed.

**At the time of issuance and publication of this certificate,
the patent remains subject to pending reexamination
control number 95/002,126 filed Aug. 31, 2012. The claim
content of the patent may be subsequently revised if a
reexamination certificate issues from the reexamination
proceeding.**



Related U.S. Application Data

continuation-in-part of application No. 09/828,511,
filed on Apr. 7, 2001, now abandoned.

- (60) Provisional application No. 60/217,345, filed on Jul.
11, 2000, provisional application No. 60/211,019,
filed on Jun. 12, 2000.

- (51) **Int. Cl.**

<i>H04L 67/565</i>	(2022.01)
<i>G06F 3/0481</i>	(2022.01)
<i>G06F 16/95</i>	(2019.01)
<i>G06F 16/9537</i>	(2019.01)
<i>G06Q 30/02</i>	(2023.01)
<i>G09G 5/24</i>	(2006.01)
<i>H04L 67/02</i>	(2022.01)

**INTER PARTES
REEXAMINATION CERTIFICATE**

THE PATENT IS HEREBY AMENDED AS
INDICATED BELOW. 5

AS A RESULT OF REEXAMINATION, IT HAS BEEN
DETERMINED THAT:

Claims 1-28, 30-52, 55, 59, 69, 72 and 75 were previously 10
cancelled.

Claims 29, 53-54, 56-58, 60-68, 70-71, 73-74 and 76-88
are cancelled.

* * * * *



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,635	05/23/2011	7831926	SV.95000635	4626

59860 7590 10/24/2024
LAW OFFICE OF R. ALAN BURNETT
4108 131ST AVE. SE
BELLEVUE, WA 98006

EXAMINER

BASEHOAR, ADAM L

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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10/24/2024

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.

Transmittal of Communication to Third Party Requester <i>Inter Partes</i> Reexamination	Control No. 95/000,635	Patent Under Reexamination 7831926	
	Examiner Adam L Basehoar	Art Unit 3992	AIA (FITF) Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

_____ (THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS) _____

POLSINELLI PC
PO Box 140310
Kansas City MO 64114-0310

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

NOTICE OF INTENT TO ISSUE INTER PARTES REEXAMINATION CERTIFICATE	Control No. 95/000,635	Patent Under Reexamination 7831926
	Examiner Adam L Basehoar	Art Unit 3992

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

1. ☒ Prosecution on the merits is (or remains) closed in this inter partes reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. Cf. 37 CFR 1.313(a). A Certificate will be issued in view of:
 - a. ☐ The communication filed on _____ by _____.
 - b. ☐ Patent owner's failure to file an appropriate timely response to the Office action dated _____.
 - c. ☐ The failure to timely file an Appeal with fee by all parties to the reexamination proceeding entitled to do so. 37 CFR 1.959 and 41.61
 - d. ☐ The failure to timely file an Appellant's Brief with fee by all parties to the reexamination proceeding entitled to do so. 37 CFR 41.66(a).
 - e. ☒ The decision on appeal by the ☐ Board of Patent Appeals and Interferences ☒ Court dated 06 April 2022
 - f. ☒ Other: Decision by the United States Court of Appeals for the Federal Circuit (CAFC) on 06/06/2024
2. ☒ The Reexamination Certificate will indicate the following:
 - a. Change in the Specification: ☐ Yes ☒ No
 - b. Change in the Drawings: ☐ Yes ☒ No
 - c. Status of the Claims:
 - (1) Patent claim(s) confirmed _____.
 - (2) Patent claim(s) amended (including dependent on amended claim(s)): _____
 - (3) Patent claim(s) cancelled: 29,53-54,56-58,60-68,70-71,73-74 and 76-88.
 - (4) Newly presented claim(s) patentable: _____.
 - (5) Newly presented cancelled claims: _____.
 - (6) Patent claim(s) ☐ previously ☐ currently disclaimed: _____
 - (7) Patent claim(s) not subject to reexamination: _____.
3. ☐ Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
4. ☐ Note attached NOTICE OF REFERENCE CITED, (PTO-892).
5. ☒ Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
6. ☐ The drawings filed on _____ is: ☐ approved ☐ disapproved.
7. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. § 119(a) - (d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of the certified copies have

☐ been received.
☐ not been received.
☐ been filed in Application No. _____.
☐ been filed in reexamination Control No. _____.
☐ been received by the International Bureau in PCT Application No. _____.

* Certified copies not received: _____.

8. ☒ Note Examiner's Amendment.
9. ☒ Other: See Continuation Sheet.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

/ADAM L BASEHOAR/ Primary Examiner, Art Unit 3992	
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Continuation of 9. Other: Claims 30, 31, 40, 41, 43, 52, 55, 59, 72 and 75 were held invalid in a final decision by the Court of Appeals for the Federal Circuit. *Softview LLC v. Kyocera Corp. and Motorola Mobility LLC.*, No. 2014-1599 (Fed. Cir. Feb. 9, 2015). Thereafter, claims 30, 31, 40, 41, 43, 52, 55, 59, 72, and 75 were cancelled in the Inter Partes Review Certificate issued on 01/15/2016. Thus, claims 30, 31, 40, 41, 43, 52, 55, 59, 72 and 75 are withdrawn from consideration in the instant reexamination.

Additionally, claims 1-28, 32-39, 42, 44-51 and 69 were cancelled in the Ex Parte Reexamination Certificate issued on 12/06/2021. Thus, claims 1-28, 32-39, 42, 44-51 and 69 are also withdrawn from consideration in the instant reexamination.

DETAILED ACTION

1. This Office Action addresses claims 29, 53, 54, 56-58, 60-68, 70, 71, 73, 74, and 76-88 of United States Patent Number 7,831,926 B2 (Rohrbaugh et al.), for which it has been determined in the Order Granting *Inter Partes* Reexamination (hereafter the “Order”) mailed 08/08/2011 that a substantial new question of patentability (SNQ) was raised in the Request for *Inter Partes* reexamination filed on 05/23/2011 (hereafter the “Request”).

The Examiner notes that claims 30, 31, 40, 41, 43, 52, 55, 59, 72 and 75 of the Rohrbaugh ‘926 patent were held invalid in a final decision by the Court of Appeals for the Federal Circuit (Softview LLC v. Kyocera Corp. and Motorola Mobility LLC., No. 2014-1599 (Fed. Cir. Feb. 9, 2015)). Thereafter, claims 30, 31, 40, 41, 43, 52, 55, 59, 72, and 75 were cancelled in the *Inter Partes* Review Certificate issued on 01/15/2016. Thus, claims 30, 31, 40, 41, 43, 52, 55, 59, 72 and 75 were previously withdrawn from consideration in the instant reexamination proceeding.

Similarly, via the related 90/009,995 *Ex Parte* reexamination proceeding, claims 1-28, 32-39, 42, 44-51 and 69 of the Rohrbaugh ‘926 patent were cancelled in the *Ex Parte* Reexamination Certificate issued on 12/06/2021. Thus, claims 1-28, 32-39, 42, 44-51 and 69, which were being reexamined, are now withdrawn from consideration in the instant reexamination proceeding.

2. On 03/29/2021 a Right of Appeal Notice (“RAN”) was mailed in which at least (i) claims 1-28, 32-39, 42, 44-51, 53, 54, 56-58, 60-68, 70, 71, 73, 74, 76, 77 and 79-88 were rejected, and (ii) claims 29 and 78 were deemed patentable/confirmed.

On 04/06/2022 a Decision on appeal by the Patent Trial and Appeal Board (“PTAB”) was rendered (“We affirm the Examiner’s decision to reject claims 64 and 66 under 35 U.S.C. § 103(a) as unpatentable over Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, and Pad++ Tour. We reverse the Examiner’s decision not to adopt the rejection of claims 29 and 78 under 35 U.S.C. § 103(a) as being unpatentable over Pad++ Tour and Patent Owner’s admitted prior art and enter a new rejection based thereon. We reject claims 29 and 78 under 35 U.S.C. § 103(a) as unpatentable over Pad++ Tour and HTML 4.0 Standard” – underline emphasis added) and mailed which at least (i) affirmed the rejection of independent claims 64 and 66, and (ii) entered a new ground of rejection for claims 29 and 78.

On 06/06/2024 a Decision by the United States Court of Appeals for the Federal Circuit (“CAFC”) was rendered (“AFFIRMED. *See* Fed. Cir. R. 36”) and mailed which affirmed the PTAB’s Decision. Subsequently, the CAFC rendered another Decision (“The petition for panel rehearing is denied. The petition for rehearing en banc is denied. The mandate of the court will issue September 3, 2024.”) on 08/27/2024 which denied Patent Owner’s (PO) combined “PETITION FOR PANEL REHEARING AND REHEARING *EN BANC*.” Finally, on 09/03/2024, the formal Mandate from the CAFC was issued.

3. This current Office Action is a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (hereafter “NIRC”). If all claims in the case stand rejected, proceedings in the case are considered terminated on the issue date of the United States Court of Appeals for the Federal Circuit’s mandate. Therefore, all claims (i.e., claims 29, 53, 54, 56-58, 60-68, 70, 71, 73, 74, and 76-88) currently stand rejected with no claims having been found confirmed and/or patentable.

Thus, claims 29, 53, 54, 56-58, 60-68, 70, 71, 73, 74, and 76-88 are now cancelled (see: MPEP 1214.06(I); MPEP 1216.01(I)(A); and MPEP 2687(I)(E), (II)(A), and (VII)).

4. The Examiner also notes that the Rohrbaugh '926 patent appears to have expired on 11/09/2022 due to non-payment of the required maintenance fees under 37 CFR 1.362.

Additionally, the Rohrbaugh '926 patent appears to have earlier expired on 04/18/2022 due to the conclusion of its patent term. The Rohrbaugh '926 patent, via the approved terminal disclaimer filed on 04/21/2010 during the original prosecution history of Application No.

11/738,486, disclaims the terminal portion of its patent term which would extend beyond the expiration date of U.S. Patent No. 7,461,353. Thus, the expiration date of the 7,461,353 patent determines the expiration date of the Rohrbaugh '926 patent which is subject to the disclaimer (see: MPEP 2701(I) and (V)).

Once the patent in a reexamination proceeding expires, all amendments to the patent claims and all claims added during the proceeding must be withdrawn. Further, all presently rejected and objected claims are canceled by Examiner's Amendment (see: MPEP 2687(VI)(M)). 37 CFR 1.530(j) further states that "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." Thus, the cancellation of the original patent claims is the only "amendatory" change permitted in an expired patent (see: MPEP 2250(III)).

Related Proceeding Notification

5. The Rohrabough '926 patent is also subject to the currently pending 95/002,126 *Inter Partes* reexamination proceeding. The instant 95/000,635 *Inter Partes* reexamination proceeding has not been merged with the 95/002,126 *Inter Partes* reexamination proceeding.

Claim Status Summary

6. The current status of the claims (i.e., claims 1-88) of the Rohrabough '926 patent in this *Inter Partes* Reexamination proceeding are as follows:

- Claims 29, 53, 54, 56-58, 60-68, 70, 71, 73, 74, and 76-88 are canceled below via the Examiner's Amendment
- Claims 30, 31, 40, 41, 43, 52, 55, 59, 72 and 75 were previously canceled (e.g., see: *Inter Partes* Review Certificate issued on 01/15/2016) and are thus withdrawn from consideration in the instant reexamination proceeding
- Claims 1-28, 32-39, 42, 44-51 and 69 were previously canceled (e.g., see: *Ex Parte* Reexamination Certificate issued on 12/06/2021) and are thus withdrawn from consideration in the instant reexamination proceeding

Information Disclosure Statement

7. Regarding Information Disclosure Statement (IDS) submissions, MPEP 2656 recites the following: "Where patents, publications, and other such documents are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the document has explained its content and relevance. The initials of the

examiner placed adjacent to the citations on the form PTO/SB/08A and 08B or its equivalent, without an indication to the contrary, do not signify that the document has been considered any further than noted above.”

Accordingly, the IDS submission filed by Patent Owner on 03/31/2022 has been considered by the Examiner only with the scope required by MPEP 2656, unless otherwise noted.

Examiner's Amendment

8. An Examiner's Amendment (see: MPEP 2687(III)) to the record appears below. As noted above, all live claims (i.e., claims 29, 53, 54, 56-58, 60-68, 70, 71, 73, 74, and 76-88) currently stand rejected in the instant reexamination proceeding. Accordingly, claims 29, 53, 54, 56-58, 60-68, 70, 71, 73, 74, and 76-88 are now being canceled. The changes made by this Examiner's Amendment will be reflected in the reexamination certificate to issue in due course.

Please cancel claims 29, 53, 54, 56-58, 60-68, 70, 71, 73, 74, and 76-88 as follows:

Claim 29	(Canceled)
Claim 53	(Canceled)
Claim 54	(Canceled)
Claims 56-58	(Canceled)
Claims 60-68	(Canceled)
Claim 70	(Canceled)
Claim 71	(Canceled)
Claim 73	(Canceled)

Claim 74 (Canceled)

Claims 76-88 (Canceled)

Conclusion

9. All correspondence relating to this *Inter Partes* reexamination proceeding should be directed:

Electronically: Registered users may submit via the USPTO patent electronic filing system at <https://patentcenter.uspto.gov/>.

By Mail to: Mail Stop *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner of Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany St.
Alexandria, VA 22314

For electronic transmissions, 37 CFR 1.8(a)(1)(i)(C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the USPTO patent electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office Action.

Any inquiry concerning this communication or earlier communications from the Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

/Adam L Basehoar/
Primary Examiner, Art Unit 3992

Conferees:

/JOSHUA D CAMPBELL/
Primary Examiner, Art Unit 3992

/ALEXANDER J KOSOWSKI/
Supervisory Patent Examiner, Art Unit 3992

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

SOFTVIEW LLC,
Appellant

v.

APPLE INC., MOTOROLA MOBILITY LLC,
Appellees

2023-1006, 2023-1008

Appeals from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in Nos. 95/000,635,
95/002,126.

JUDGMENT

ALAN BURNETT, Law Office of R. Alan Burnett, Bellevue, WA, argued for appellant.

PARTH SAGDEO, Orrick, Herrington & Sutcliffe LLP, Boston, MA, argued for appellees. Apple Inc. also represented by MELANIE L. BOSTWICK, Washington, DC; MARK S. DAVIES, White & Case LLP, Washington, DC; JAMES P. MURPHY, Polsinelli PC, Houston, TX.

SONAL NARESH MEHTA, Wilmer Cutler Pickering Hale

and Dorr LLP, Palo Alto, CA, for Motorola Mobility LLC. Also represented by MADELEINE C. LAUPHEIMER, Boston, MA; JOHN C. ALEMANNI, Kilpatrick Townsend & Stockton LLP, Raleigh, NC; DAVID A. REED, Atlanta, GA.

THIS CAUSE having been heard and considered, it is

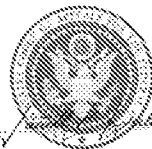
ORDERED and ADJUDGED:

PER CURIAM (LOURIE, BRYSON, and REYNA, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

June 6, 2024
Date


Jarrett B. Perlow
Clerk of Court

United States Court of Appeals for the Federal Circuit

SOFTVIEW LLC,
Appellant

v.

APPLE INC., MOTOROLA MOBILITY LLC,
Appellees

2023-1006, 2023-1008

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. 95/000,635,
95/002,126.

MANDATE

In accordance with the judgment of this Court, entered
June 6, 2024, and pursuant to Rule 41 of the Federal Rules
of Appellate Procedure, the formal mandate is hereby
issued.

FOR THE COURT

September 3, 2024
Date


Jarrett B. Perlow
Clerk of Court



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,635	05/23/2011	7831926	SV.95000635	4626

59860 7590 09/22/2022
LAW OFFICE OF R. ALAN BURNETT
4108 131ST AVE. SE
BELLEVUE, WA 98006

EXAMINER

BASEHOAR, ADAM L

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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09/22/2022

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 Respondent

v.

SOFTVIEW L.L.C.
Patent Owner and Appellant

Appeal 2022-000716
Reexamination Control 95/000,635
Technology Center 3900
Patent 7,831,926 B2

Before ALLEN R. MACDONALD, ERIC B. CHEN, and
BRIAN J. MCNAMARA, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

On May 5, 2022, Patent Owner SoftView, L.L.C. requested rehearing under 37 C.F.R. § 41.77(a)(2) and 37 C.F.R. § 41.79(a)(2), of our Decision on Appeal entered April 6, 2022 (“Decision” or “Dec.”), in which we affirmed of the Examiner’s final decision to reject independent claims 64 and 66, reversed Examiner’s decision not to reject dependent claims 29 and 78, and entered a new ground of rejection for claims 29 and 78 under 35 U.S.C. § 103(a).

In response to Patent Owner’s request for rehearing, Requester Apple filed written comments, dated June 6, 2022.

The Request for Rehearing is *denied*.

ANALYSIS

Claims 29 and 78—Pad++ Tour and Admitted Prior Art

First, Patent Owner argues “[u]nder 37 CFR 1.948(a)(2) and MPEP § 2617 the Examiner correctly did not adopt the [Requester’s] new proposed ground.” (Req. Reh’g 1.) However, a request for rehearing must “state with particularity the points believed to have been misapprehended or overlooked” by the Board. 37 C.F.R. § 41.79(b)(1). Patent Owner has not sufficiently explained how the panel’s agreement with the Requester’s arguments amounts to misapprehending or overlooking Patent Owner’s previously presented arguments. Instead, Patent Owner is merely reiterating argument previously presented.

Second, Patent Owner argues “[t]he Mozilla rendering engine, Applicant’s Admitted Prior Art (AAPA), cannot be the basis for a ground in an *Inter Partes* Reexamination.” (Req. Reh’g. 4.) In particular, Patent

Owner argues “[t]he Mozilla rendering engine comprises a library of software modules that are neither patents nor printed publications, and thus cannot be used as a basis for a ground of rejection in an Inter Partes Reexamination (whether in the initial request or a subsequent proposal under a new ground).” (*Id.* at 5.)

Contrary to Patent Owner’s arguments, 37 C.F.R. § 1.104(c)(3), states that “[i]n rejecting claims *the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding*, as to any matter affecting patentability and, insofar as rejections in applications are concerned” (emphasis added). Accordingly, Patent Owner’s argument that Patent Owner’s admissions cannot be used as a basis for an obviousness rejection is legally incorrect.

Third, Patent Owner argues the following: (i) “[t]he publicly documented evidence of the great difficulties both Microsoft and Netscape/Mozilla had in implementing CSS in a rendering engine/Web browser refutes any assertion that implementing CSS in a rendering engine or Web browser was within the ordinary skill in that art” (Req. Reh’g 6); (ii) “Wolf further states ‘A PHOSITA [person having ordinary skill in the art] in 2000-2001 would also not attempt to write original code to support HTML 4, CSS 1, or CSS 2, and there would be no chance such an attempt would have succeeded without undue experimentation’” (*id.* at 8 (emphasis omitted)); and (iii) “it took 50+ man-years for highly skilled software developers and software engineers at Mozilla to implement HTML 4, CSS 1 and parts of CSS 2” (*id.*).

With respect to Patent Owner's admissions, page 11 of our Decision states:

The '926 patent discloses the following:

As will be recognized by those skilled in the art, *the functions performed in blocks 150, 152, and 154 [of Figure 5] are commonly performed by conventional browsers during a pre-rendering process. In some browsers, these functions are performed by the Mozilla rendering engine, which comprises open source software that is readily available for use by developers. At present, the software for the Mozilla rendering engine may be accessed via the Internet at www.mozilla.org. Accordingly, in one embodiment, the present invention uses core functionality provided by the Mozilla rendering engine source code to perform the functions of block 150, 152, and 154.*

(Col. 17, ll. 31–41 (emphases added).)

The process is initiated when the proxy server receives the HTML corresponding to the parent document (and frame documents, if appropriate), whereupon *a pre-rendering parsing of the HTML is performed to determine where to place the various objects on the display page in a block 150.* For example, elements such as tables, column definitions, graphic images, paragraphs and line breaks are identified. If frames are included, each frame is examined in the sequential order it appears in the HTML document, or the order in which the HTML documents corresponding to the frames in a frameset are downloaded to the browser.

(Col. 16, ll. 45–55 (emphasis added).) The Wolf Declaration further states the following:

The '926 . . . patent[] disclose[s] using the Mozilla (Gecko) rendering engine during *prerendering processing operations* to parse and process the HTML and CSS source code and generate HTML objects and associated page layout information, including bounding boxes.

(¶ 17 (emphasis added).)

In general, to be enabling under 35 U.S.C. § 112, a patent application must sufficiently disclose an invention to enable those skilled in the art to make and use it and the Specification need not disclose what is well known in the art. *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463 (Fed. Cir. 1984). Moreover, although a prior art patent is presumed to be enabled, such presumption can be rebutted. *In re Sasse*, 629 F.2d 675, 681 (CCPA 1980). Thus, the '926 patent is presumed to be enabled and need not disclose what is well known in the art by those skilled in the art, including parsing and processing the HTML CSS source code and generate HTML objects in the Mozilla rendering engine. However, Patent Owner's arguments: (i) directly conflict with the admissions from column 16, lines 45–55 and column 17, lines 31–41 of the '926 patent; and (ii) apparently undermine the presumption of enablement for the '926 patent.

Fourth, Patent Owner argues the following: (i) “[i]t is irrefutable that Mozilla failed to implement a full-page zooming Web browser on a desktop browser that preserved the original page layout, functionality, and design of HTML-based Web Content until 2007, even though this desired functionality was identified as a feature (to be implemented) in 1999” (Req. Reh’g 8); (ii) “[t]he [Pad++] Tour suggestion provides no evidence a POSITA at the time of the invention would be motivated to even attempt to implement Pad++ on a PDA [personal digital assistant] and would have had a reasonable expectation of success in doing so without undue experimentation” and “Bederson *et al.* abandoned development of the Pad++

web browser in 1998 in view of ‘great advancements in HTML’” (*id.* at 12);

(iii) “[a]t the time of the invention, there were no open-source browsers that ran on mobile devices with touch-sensitive displays” (*id.* at 16); (iv)

[t]his isolated and conclusory statement [from page 141 of Pad++ Tour, which states “[t]his seems especially attractive for systems which have small screens, such as handheld computers (i.e. PDA’s)”] is a mere suggestion of a conceptual use of Pad++ that is insufficient to constitute a motivation to combine Pad++ with a PDA or any mobile device for that matter for the purpose of implementing a zoomable browser

(*id.* at 19); and (v) “Pad++ was not designed to run on a PDA” (*id.*).

However, “the test [for obviousness] is what the combined teachings of the references would have suggested to those of ordinary skill in the art,” and not “whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Although Patent Owner’s evidence may demonstrate that specific combinations of commercially available products—HTML, Web browsers (e.g., Netscape Navigator or Microsoft Internet Explorer), and PDAs (e.g., Nokia, Palm, or Apple Newton devices)—were not physically compatible in 2000–2001, such evidence does not overcome the *prima facie* case of obviousness. As recognized by the Supreme Court, “[a] person of ordinary skill [in the art] is also a person of ordinary creativity, not an automaton.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). Accordingly, one of ordinary skill in demonstrating “ordinary creativity” would have reason to consider using or modifying the technical features of commercially available products or develop prototypical products, particularly in view of Pad++ Tour’s explicit

suggestion that it “seems especially attractive for systems which have small screens” (p. 19).

Last, Patent Owner argues that “[a]s the ’926 patent is now expired, the Phillips standard must be applied in construing the claims for which all rejections are asserted” (Req. Reh’g 13) and “[t]o establish a *prima facie* case of obviousness all limitations must be addressed, and the entirety of the claim must be construed anew under the *Phillips* standard” (*id.* at 14). However, Patent Owner does not propose any constructions or demonstrate how applying any other constructions under the *Phillips* standard would change the outcome. In addition, the claim construction standard could not affect the outcome here because the Board’s constructions in *Softview LLC v. Kyocera Corp. and Motorola Mobility LLC*, Nos. IPR2013-00004, Paper 53 (PTAB Mar. 27, 2014) and IPR2013-00257, Paper 12 (PTAB Mar. 27, 2014), both of which also involved the ’926 patent, were based on Patent Owner’s own explanation of the meaning of the claimed features during prosecution and on Patent Owner’s proposed *Phillips* standard claim constructions submitted in connection with *SoftView LLC v. Apple Inc.*, No. 1:10-cv-00389 (D. Del. May 10, 2010). Finally, “[t]here has never been a requirement for an examiner to make an on-the-record claim construction of every term in every rejected claim [A]ll that is required of the [Patent] [O]ffice to meet its *prima facie* burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of [35 U.S.C.] § 132.” *In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011).

Claims 29 and 78—Pad++ Tour and HTML 4.0 Standard

First, Patent Owner argues that “the Examiner correctly did not adopt the proposed . . . new ground in the RAN [Right of Appeal Notice].” (Req. Reh’g 21.) In particular, Patent Owner argues that “[t]he Appeal Decision does not address why the Examiner not adopting this proposed new ground was errant but rather just indicates the Examiner’s decision is reversed without further explanation” and “[t]he Examiner’s actions were proper under 37 CFR [§] 1.948(a)(2) and MPEP § 2617.” (*Id.* at 22). However, as stated on pages 22–24 of our Decision (Dec. 22–24), and as acknowledged by Patent Owner (Req. Reh’g 21), claims 29 and 78 were rejected under 35 U.S.C. § 103(a) pursuant to our authority to enter a new ground of rejection under 37 C.F.R. § 41.50(b). As such, 37 C.F.R. § 1.948(a)(2) is not applicable.

Second, Patent Owner argues the following:

[T]he HTML 4.0 Standard does not specify how CSS is implemented, which is defined by separate CSS Standards . . . nor specify “methods” for implementing HTML 4.0. Third, development of complex software, such as a rendering engine supporting HTML 4.0, is anything but predictable. The only thing predictable is that it would involve an extraordinary level of experimentation and failure along the way, as would be recognized by a POSITA at the time of the invention.

(Req. Reh’g 23.) Similarly, Patent Owner argues that “Wolf testified (above) it took highly-skilled developers and software engineers 50+ man years to develop the first version of Gecko, which supported HTML 4.0, CSS 1, and parts of CSS 2” and “[c]onsidering implementation of HTML 4.0 alone (without CSS), there is no evidence a POSITA could have

implemented HTML 4.0 in anything remotely close to one and a half to two-man years.” (*Id.* at 25.)

Page 23 of our Decision states the following:

HTML 4.0 Standard further explains that “[s]tyle sheets simplify HTML markup and largely relieve HTML of the responsibilities of presentation” and “give both authors and users control over the presentation of documents – font information, alignment, colors, etc.” (§ 2.3.5.) Moreover, with respect to style sheets, HTML 4.0 Standard explains that “[s]tyle sheets represent a major breakthrough for Web page designers, expanding their ability to improve the appearance of their pages.” (§ 14.1.) In particular, HTML Standards explains that a “cascading” style sheet “is the capability provided by some style sheet languages such as CSS to allow style information from several sources to be blended together.” (*Id.*) (Dec. 23.) Thus, in a single printed publication, HTML 4.0 Standard provides information with respect to both: (i) HTML documents; and (ii) the improvement of HTML document appearance using cascading style sheets.

In general, a prior art patent is presumed to be enabled, *Sasse*, 629 F.2d at 681, and such prior art patent need not disclose what is well known in the art, *Lindemann*, 730 F.2d at 1463. Similarly, prior art printed publications are presumptively enabling. *In re Antor Media Corp.*, 689 F.3d 1282, 1288 (Fed. Cir. 2012). Accordingly, HTML 4.0 Standard is presumptively enabled and need not disclose what is well known in the art—implementation of CSS in the HTML markup language.

Third, Patent Owner argues that “[the Board] provides no evidence of any consideration regarding the required ‘reasonable expectation of success’ prong.” (Req. Reh’g 23.)

Pages 22–23 of our Decision states:

Pad++ Tour explains the following:

The Pad++ HTML browser will lay out sub-documents in two columns next to the parent document. Because Pad++ is zoomable, there is always enough space between those two columns for placing further documents reached from those sub-documents!

HTML 4.0 Standard relates to “[t]he publishing language used by the World Wide Web is HTML (from HyperText Markup Language).”

. . . .

HTML 4.0 Standard further explains that “[s]tyle sheets simplify HTML markup and largely relieve HTML of the responsibilities of presentation” and “give both authors and users control over the presentation of documents – font information, alignment, colors, etc.” HTML Standards explains that a “cascading” style sheet “is the capability provided by some style sheet languages such as CSS to allow style information from several sources to be blended together.”

(Dec. 22–23 (citations omitted).) Thus, Pad++ discusses use of an HTML browser on a zooming user interface, and HTML 4.0 Standard discusses the features of the HTML publishing language, including a cascading style sheet. Because both references relate to HTML, the identical publishing language used by the World Wide Web, the proposed modification of Pad++ with HTML 4.0 Standard would result a reasonable expectation of success. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (the teachings of the prior art provide a sufficient basis for a reasonable expectation of success).

Last, Patent Owner argues that: (i) “[i]n addition to implementing a zoomable browser supporting HTML 4 and at least CSS 1, the POSITA would need to implement the combination on a mobile device with a touch-

sensitive display” and “[n]one of the PDAs and mobile phones of record have sufficient memory to implement a browser supporting HTML 4 and CSS 1 alone” (Req. Reh’g 27); and (ii) “Pad++ had 24 contributors over approximately 4 years” and “all these contributors failed to implement a browser that came close to supporting even HTML 2.0” (*id.* at 28).

Again, “the test [for obviousness] is what the combined teachings of the references would have suggested to those of ordinary skill in the art,” and not “whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.” *Keller*, 642 F.2d at 425. Although Patent Owner’s evidence may demonstrate that specific combinations of commercially available products—HTML, Web browsers (e.g., Netscape Navigator or Microsoft Internet Explorer), and PDAs (e.g., Nokia, Palm, or Apple Newton devices)—were not physically compatible, such evidence does not overcome the prima facie case of obviousness. As recognized by the Supreme Court, “[a] person of ordinary skill [in the art] is also a person of ordinary creativity, not an automaton.” *KSR*, 550 U.S. at 421. Accordingly, one of ordinary skill in demonstrating “ordinary creativity” would have reason to consider using or modifying the technical features of commercially available products or develop prototypical products.

Claims 64 and 66—Pad++ Tour

First, Patent Owner argues the following:

The Examiner’s rejection is based on a clearly errant assertion that claims 64 and 66 permit manual/dynamic zooming to be performed following tapping on a column or paragraph. In

affirming the Examiner's rejection, the Appeal Decision affirms the Examiner's errant claim construction. If this is not the case, Patent Owner respectfully request the Board draw a line in the sand and indicate whether any additional operations such as manual/dynamic zooming are permitted after the claimed tapping operations to obtain the resulting zoomed view on columns and paragraphs.

(Req. Reh'g 29; *see also id.* at 32–33.)

However, our Decision did not articulate a claim construction that “permit[s] manual/dynamic zooming to be performed following tapping on a column or paragraph,” as argued by Patent Owner. Pages 14–15 of our Decision states the following:

The Examiner found that Pad++ Tour, which illustrates screen snapshots of both an HTML document and a zoomed-in view of the same HTML document, corresponds to the limitations: (i) “enabling a user to view a column of the Web content at a higher resolution than a current resolution by tapping on the column . . .” and (ii)

enabling a user to view a paragraph of the Web content at a higher resolution than a current resolution by tapping on the paragraph”

In particular, the Examiner stated that “the Pad++ Tour reference meets the limitation by more specifically showing dynamically zooming in . . . on a paragraph of text (see: Pad++ Tour, p. 89) of an initially displayed HTML document (see: Pad++ Tour, p. 87), wherein said paragraph of text is displayed across the display.”

(Dec. 14–15.) In other words, according to the Examiner, “zooming” is performed on the “initially displayed HTML document” in Pad++ Tour to obtain a “paragraph of text displayed across the display,” and thus, Pad++ Tour teaches the limitations “enabling a user to view a column of the Web content at a higher resolution than a current resolution by tapping on the

column” and “enabling a user to view a paragraph of the Web content at a higher resolution than a current resolution by tapping on the paragraph.” Both of these statements from pages 14–15 of our Decision cite to page 49 of the Right of Appeal Notice and describe the same single zooming operation performed on the same HTML document, and not two separate zooming operations—(i) “tapping on a column or paragraph” followed by (ii) “manual/dynamic zooming”—as argued by Patent Owner.

Second, Patent Owner argues that “now that the ’926 patent has expired, the claims must be construed under the *Phillips* standard” and “the entirety of the claims, including independent claim 52 must be construed (all claim elements and limitations).” (Req. Reh’g 29.) As discussed previously, Patent Owner does not propose any constructions or demonstrate how applying any other constructions under the *Phillips* standard would change the outcome. The claim construction standard could not affect the outcome here because the Board’s constructions in two related *inter partes* reviews, both of which also involved the ’926 patent, were based on Patent Owner’s own explanation of the meaning of the claimed features during prosecution and on Patent Owner’s proposed *Phillips* standard claim constructions submitted in connection with a previously litigated case district court. Also discussed previously, “[t]here has never been a requirement for an examiner to make an on-the-record claim construction of every term in every rejected claim [A]ll that is required of the [Patent] [O]ffice to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in

a sufficiently articulate and informative manner as to meet the notice requirement of [35 U.S.C.] § 132.” *Jung*, 637 F.3d at 1363.

Third, Patent Owner argues the following:

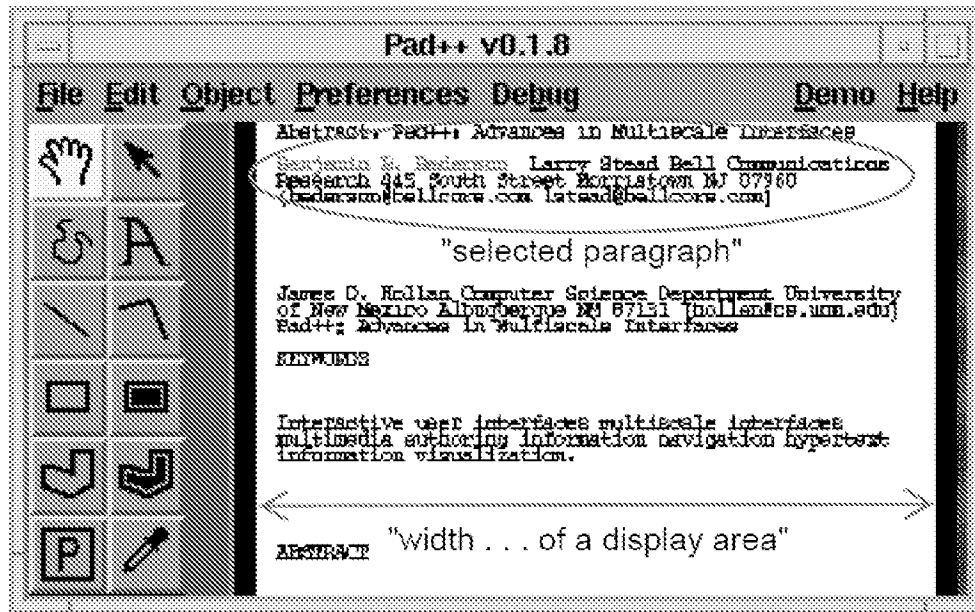
The display [illustrated on page 93 of Pad++ Tour] is NOT re-rendered such that content corresponding to the selected paragraph is displayed across the touch-sensitive display. Manual/dynamic zooming doesn’t select anything. Rather, it zooms the entire Pad++ substrate based on where the mouse cursor is. And the Web page content shown is clearly not displayed across the display.

(Req. Reh’g 35–36 (emphasis omitted); *see also id.* at 40–43.) Similarly, Patent Owner argues that:

This assertion [from page 18 of our Decision] is false: “the sub-document “Abstract: Pad++: Advances in Multiscale Interfaces” is zoomable, such that the text fills the screen horizontally and displays a paragraph (e.g., title, authors, and keywords of a technical publication);”. First, in this example the text clearly does not fill the screen horizontally. It might fill approximately 80% of the Window used for the Pad++ application, but it does not fill the screen horizontally.

(Req. Reh’g 36.)

From Pad++ Tour, the HTML document, entitled “Abstract: Pad++: Advances in Multiscale Interfaces” (p. 93), is reproduced below with additional annotations—an ellipse to indicate the “selected paragraph” and a double-sided arrow to indicate “width . . . of a display area”:



The above figure illustrates Pad++ displaying an HTML document.

As discussed on page 17 of our Decision (Dec. 17), Pad++ Tour explains that “[w]hen you click on a piece of text, Pad++ zooms in so that [the] text fills the screen horizontally and appears near the top of the screen vertically” (p. 54 (emphasis added).) This description from Pad++ Tour is illustrated in the above figure, in which the “piece of text . . . appears near the top of the screen” is indicated by the ellipse (e.g., “Abstract: Pad++: Advances to Multiscale Interfaces”) and the “text [that] fills the screen horizontally” is indicated by the double-sided arrow. Accordingly, Patent Owner’s arguments are contradicted by Pad++ Tour. Moreover, although Patent Owner argues that “[text] might fill approximately 80% of the Window used for the Pad++ application, but it does not fill the screen horizontally,” independent claims 64 and 66 recite “displayed across at least one of a width . . . of a display area” and does not required filling the width of “the touch-sensitive display.”

Fourth, Patent Owner argues that “[t]he Pad++ outline, which is referred to as ‘An outline viewer,’ is discussed and illustrated three times in the Tour document.” (Req. Reh’g 36.) In particular, Patent Owner argues the following:

The outline viewer is not the Web browser. This functionality (when you click on a piece of text, Pad++ zooms in so that that text fills the screen horizontally and appears near the top of the screen vertically) is provided by the outline viewer. It is not supported in the Web browser.

(*Id.* at 38.)

However, Pad++ Tour explains that “[o]nce you add zooming to a user interface, new kinds of interactions are possible” and “[t]he following sections introduce three sample applications that we have developed which use zooming” (p. 49): (1) “[a]n outline viewer” (*id.*); (2) “[a] file browser” (p. 73); and (3) “[a]n HTML browser” (p. 86). Our Decision relies upon the third application of zooming, the “HTML browser,” rather than the “outline viewer,” as argued by Patent Owner.

Fifth, Patent Owner argues that “under a touchscreen graphical user interface (GUI) such as implemented on a mobile device, it is not possible to select any object within a Web page, regardless of type, without a bounding box for the object” and “Pad++ used the anchor tag bounding boxes to enable selection of hyperlinks (as do all Web browsers) and the bounding box for the HTML object to enable selection of the entire page.” (Req. Reh’g 44.)

However, Patent Owner previously presented the same argument in its Appeal Brief, arguing the following:

Pad++ does not generate a bounding box for a paragraph.
Pad++ does not teach or suggest zooming on any HTML object in a Web page (MSML is not HTML), much less an HTML paragraph that Pad++ never generates a bounding box for nor would benefit from generating such a bounding box.

(PO Appeal Br. 49.) Similarly, Patent Owner previously presented the same argument in its Rebuttal Brief, arguing the following:

Also, Pad++ does not include a Pad++ paragraph object nor generate a bounding box for a paragraph. Rather, the Pad++ parser, upon encountering a paragraph start tag (<p>) generates individual lines of text comprising Pad++ text objects spanning the width of the browser window until encountering a subsequent tag.

(PO Rebuttal Br. 14.) Patent Owner’s previously presented arguments were addressed on page 20 of our Decision—“Patent Owner’s arguments are not commensurate in scope with either claim 64 or claim 66, because the claims do not recite ‘bounding box.’” Again, Patent Owner is reiterating arguments previously presented, and accordingly, Patent Owner has failed to “state with particularity the points believed to have been misapprehended or overlooked” by the Board as required by 37 C.F.R. § 41.79(b)(1).

Sixth, Patent Owner argues the following:

Pad++ teaches . . . holding down the middle mouse button zooms the Pad++ substrate such that all Pad++ objects are zoomed together – the zoom level of all content is changed as if you had a huge stretchable rubber-like sheet. . . . This is not using a mouse click input or something that could be equated to tapping. The user interactively controls the amount of zoom via use of real-time animation as the zoom is performed; when the

desired zoom level is displayed, the user releases the mouse button, and the zoom stops.

(Req. Reh’g 46.) However, Patent Owner previously presented the same argument in its Appeal Brief, arguing the following:

Dynamically zooming in on a paragraph of text (see: Pad++Tour, p. 89) could not have been performed in response to a mouse-click input. Rather, to obtain this view, the user would have needed to hold down the middle mouse button. Tapping would be an analogous input to clicking an object with a mouse, not holding a (middle) mouse button down, which was required by Pad++ to dynamically zoom in.

(PO Appeal Br. 56.) Patent Owner’s previously presented arguments were addressed on page 20 of our Decision:

Pad++ Tour explains that “[y]our whole desktop could be zoomable” and “[t]his seems especially attractive for systems which have small screens, such as handheld computers (i.e. PDA’s).” (P. 141.) Moreover, one of ordinary skill in the art would recognize that a PDA device would include a pen or pointing device for input.

Again, Patent Owner is reiterating arguments previously presented, and accordingly, Patent Owner has failed to “state with particularity the points believed to have been misapprehended or overlooked” by the Board as required by 37 C.F.R. § 41.79(b)(1).

Seventh, Patent Owner argues the following:

[T]his [real-time zooming] would require support for real-time interactive display of Web pages on a PDA; however even if Pad++ could be implemented on a PDA with the fastest processor available at the time of the invention the (Intel SA-1110 processor) user could not control the zoom level using “manual” zooming. Bederson himself failed to implement manual/dynamic zooming using “Piccolo” in 2002, deeming “the animations were so slow as to make it unusable.”

(Req. Reh’g 46 (emphasis omitted).)

However, Patent Owner previously presented the same argument in its Rebuttal Brief, arguing the following:

Pad++ taught and achieved real-time zooming on a 200 MHz Pentium Pro PC (desktop computer), which included a numeric co-processor (aka floating point unit (FPU)). The empirical test evidence simulating the zoom performance of Pad++ running on a PDA with a 206 MHz Intel SA-1110 processor demonstrates it could not come remotely close to support real time zooming.

(PO Rebuttal Br. 15.) Patent Owner’s previously presented arguments were addressed on page 21 of our Decision—“Patent Owner’s arguments are not commensurate in scope with either claim 64 or claim 66, because the claims do not recite ‘real-time zooming.’” Again, Patent Owner is reiterating arguments previously presented, and accordingly, Patent Owner has failed to “state with particularity the points believed to have been misapprehended or overlooked” by the Board as required by 37 C.F.R. § 41.79(b)(1).

Last, Patent Owner argues that “[a]ppealed claim 29 recites identical language as claim 29 in Reexamination Request No. 90/009,995, which was determined to be patentable as indicated in the *Ex Parte* Reexamination Certificate 11956th for 7,831,926 issued on December 6, 2021.” (Req. Reh’g 47.) Accordingly, Patent Owner argues that “rejecting claims that have already been confirmed by the PTO in parallel reexamination over substantially identical art and substantially identical rebuttal evidence is arbitrary and capricious and in violation of 5 U.S.C. § 706.” (*Id.* at 48.)

In a previous *ex parte* reexamination, referenced by Patent Owner, *Ex parte Softview LLC*, No. 2019-001127, 2020 WL 2217051, at *15 (PTAB May 1, 2020), *aff’d*, 847 F. App’x 930 (Fed. Cir. 2021), we reversed the

Examiner's decision to reject dependent claim 29 under 35 U.S.C. § 103(a) over Pad++, SVF, and Bray. In particular, we concluded that although the Examiner established a prima facie case of obviousness, the Examiner did not consider Patent Owner's rebuttal evidence. (*Id.*)

In our current Decision, we reversed the Examiner's decision not to adopt the rejection of claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Pad++ Tour and Patent Owner's admitted prior art, and pursuant to our authority under 37 C.F.R. § 41.50(b), we rejected claim 29 under 35 U.S.C. § 103(a) as unpatentable over Pad++ Tour and HTML 4.0 Standard. Patent Owner's admitted prior art and HTML 4.0 Standard were not of record in the previous *ex parte* reexamination and thus, Patent Owner's characterization of "parallel reexamination[s] over substantially identical art" is inaccurate. Accordingly, a patentability determination of claim 29 from the previous *ex parte* reexamination is not inconsistent with the rejections in the current *inter partes* reexamination of claim 29 over various combinations of Pad++ Tour, Pad Patent Owner's admitted prior art, and HTML 4.0 Standard because the two reexamination proceedings apply different prior art references and are based on different records. *Stevenson v. Sears Roebuck Co.*, 713 F.2d 705, 710 (Fed. Cir. 1983) ("[T]he prior holding of validity is not necessarily inconsistent with the subsequent holding of invalidity" due to "different prior art references or different records.")).

CONCLUSIONS

The Request for Rehearing has been considered and is *denied*.

Outcome of Decision on Rehearing:

Claims	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
64, 66	103(a)	Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, Pad++ Tour	64, 66	
29, 78	103(a)	Patent Owner's admitted prior art, Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, Pad++ Tour, JP 169, SVF, VML	29, 78	
29, 78	103(a)	Pad++ Tour, HTML 4.0 Standards	29, 78	
Overall Outcome			29, 64, 66, 78	

Final Outcome of Appeal after Rehearing:

Claim Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed	New Ground
64, 66	103(a)	Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, and Pad++ Tour	64, 66		
29, 78	103(a)	Patent Owner's admitted prior art,			29, 78

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Reexamination Control 95/000,635
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		Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, Pad++ Tour, JP 169, SVF, VML			
29, 78	103(a)	Pad++ Tour, HTML 4.0 Standards			29, 78
Overall Outcome			64, 66		29, 78

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING DENIED

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,635	05/23/2011	7831926	SV.95000635	4626

59860 7590 04/06/2022
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EXAMINER

BASEHOAR, ADAM L

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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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 Respondent

v.

SOFTVIEW L.L.C.
Patent Owner and Appellant

Appeal 2022-000716
Reexamination Control 95/000,635
Technology Center 3900
Patent 7,831,926 B2

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

CHEN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ Related Appeal No. 2022-000154 (Reexamination Control No. 95/002,126) is directed to a reexamination of the same patent as this appeal. (PO Appeal Br. 1.) This appeal and its related appeal are directed to the same issues. These appeals are decided concurrently.

Patent Owner SoftView, L.L.C. appeals under 35 U.S.C. § 134(b) and 35 U.S.C. § 315(a) (pre-AIA) the Examiner's final decision to reject independent claims 64 and 66. The Examiner confirmed the patentability of claims 29 and 78. Claims 30, 31, 40, 41, 43, 52, 55, 59, 72, and 75 were cancelled in a previous *inter partes* review proceeding. Claims 1–28, 32–39, 42, 44–51, and 69 were cancelled in a previous *ex parte* reexamination proceeding. Claim 70 was cancelled in the current proceeding. The rejections of claims 53–63, 65, 67, 68, 71, 73, 74, 76, 77, and 79–88 were not appealed.

Requester Apple appeals the Examiner's decision not to reject claims 29 and 78 under certain grounds proposed by Requester.

A video conference hearing was held on January 27, 2022, with both parties in attendance. The record includes a written transcript of the oral hearing.

We AFFIRM and enter new grounds of rejection.

STATEMENT OF THE CASE

A request for *inter partes* reexamination of the '926 patent, assigned Reexamination Control No. 95/000,635, was filed on May 23, 2011, by Third-Party Requester Apple.

A subsequent request for *ex parte* reexamination of U.S. Patent No. 7,831,926 B2 (the '926 patent) was filed on May 29, 2012, and assigned Reexamination Control No. 90/009,995. The Examiner's decision to reject claims 1–28, 32–39, 42, 44–51, and 69 was affirmed, but the Examiner's decision to reject claim 29 was reversed. *Ex parte SoftView LLC*, No. 2019-

001127 (PTAB May 1, 2020), *aff'd*, 847 F. App'x 930 (Fed. Cir. 2021). The reexamination proceeding resulted in the issuance of an *Ex parte* Reexamination Certificate (11956th) on December 6, 2021, US 7,831,926 C1, in which claims 1–28, 32–39, 42, 44–51, and 69 were cancelled, but the patentability of claim 29 was confirmed.

The '926 patent, entitled “Scalable Display of Internet Content on Mobile Devices,” issued November 9, 2010 to Gary B. Rohrabough and Scott A. Sherman, based on Application No. 11/738,486, filed April 21, 2007.

The '926 patent is said to be a continuation of Application No. 09/878,097, filed June 8, 2001, now U.S. Patent No. 7,210,099, which is a continuation-in-part of Application No. 09/828,511, filed April 7, 2001, now abandoned. The '926 patent is also said to claim priority to U.S. Provisional Application No. 60/211,019, filed June 12, 2000, and U.S. Provisional Application No. 60/217,345, filed July 11, 2000.

The '926 patent is said to be assigned to SoftView, L.L.C., the real party in interest. (Appeal Br. 1.)

Patent Owner's Invention

Patent Owner's invention relates to mobile devices that are enabled to support resolution-independent scalable display of Internet (Web) content, allowing Web pages to be scaled (zoomed) and panned for better viewing on smaller screen sizes. (Abstract.)

Related Litigation

The '926 patent and related U.S. Patent 7,461,353 B2² has been asserted in *SoftView LLC v. Apple Inc.*, No. 1:10-cv-00389 (D. Del. May 10, 2010) and *SoftView LLC v. HTC Corp.*, No. 1:12-cv-00984 (D. Del. July 26, 2012). (Appeal Br. 1–2.)

The '926 patent was also subject to *inter partes* review in *Softview LLC v. Kyocera Corp. and Motorola Mobility LLC*, Nos. IPR2013-00004 and IPR2013-00257 (PTAB Mar. 27, 2014), *aff'd*, 592 F. App'x 949 (2015). As a result of this *inter partes* review, claims 30, 31, 40, 41, 43, 52, 55, 59, 72 and 75 were cancelled.

The Claims

Claims 1 (cancelled), 29, 64, and 66 are illustrative of the claimed subject matter, with disputed limitations in italics:

1. (Cancelled) A mobile device, comprising:
 - a processor,
 - a wireless communications device operatively coupled to the processor, to facilitate communication with a network via which Web content may be accessed;
 - a touch-sensitive display;
 - a memory, operatively coupled to the processor; and
 - storage means, operatively coupled to the processor, in which a plurality of instructions are stored that when executed

² Also subject to *inter partes* review in *SoftView LLC v. Kyocera Corp. and Motorola Mobility LLC*, Nos. IPR2013-00007 and IPR2013-00256 (PTAB Mar. 27, 2014), *aff'd*, 592 F. App'x 947 (Fed. Cir. 2015), and subject to multiple *ex parte* and *inter partes* reexaminations (Application Nos. 90/009,994, 95/000,634, and 95/002,132).

by the processor enable the mobile phone to perform operations including,

- enabling a user 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 HTML-based Web content associated with the Web page;

- translating the HTML-based Web content to produce scalable vector-based page layout information;

- employing the scalable vector-based page layout information and/or data derived therefrom to,

- render a view of at least a portion of the Web page on the touch-sensitive display using a first scale factor; and

- re-render the Web page in response to associated user inputs to enable a user to iteratively zoom in and out views of the Web page on the display while preserving the original page layout, functionality, and design of the content on the Web page defined by the HTML based Web content,

- wherein preservation of the functionality defined by the HTML-based content includes preservation of hyperlink functionality.

29. The mobile device of claim 1, *wherein the HTML-based Web content includes cascading style sheet content defining layout and presentation attributes for the Web page.*

64. A mobile device, comprising:

- a processor,

- wireless communications means, to facilitate wireless communication with a network via which Web content may be accessed;

- a touch-sensitive display;

flash memory, operatively coupled to the processor, in which a plurality of instructions are stored that when executed by the processor enable the mobile device 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 and processing the HTML-based Web content to produce scalable content; and

employing the scalable content and/or data derived therefrom to, render a view of the Web page on the touch-sensitive display; and

re-render the Web page in response to associated user inputs to enable the user to iteratively zoom in and out views of the Web page while preserving an original page layout, functionality, and design defined by the HTML-based Web content as interpreted by a rendering engine,

wherein preservation of the functionality defined by the HTML-based Web content includes preservation of hyperlink functionality, and wherein execution of the instructions performs further operations comprising enabling a user to view a paragraph of the Web content at a higher resolution than a current resolution by tapping on the paragraph via the touch-sensitive display, wherein in response thereto, *the display is re-rendered such that content corresponding to the selected paragraph is displayed across at least one of a width and height of a display area of the touch-sensitive display.*

66. A mobile device, comprising:

a processor,

wireless communications means, to facilitate wireless communication with a network via which Web content may be accessed;

a touch-sensitive display;

flash memory, operatively coupled to the processor, in which a plurality of instructions are stored that when executed by the processor enable the mobile device 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 and processing the HTML-based Web content to produce scalable content; and

employing the scalable content and/or data derived therefrom to, render a view of the Web page on the touch-sensitive display; and

re-render the Web page in response to associated user inputs to enable the user to iteratively zoom in and out views of the Web page while preserving an original page layout, functionality, and design defined by the HTML-based Web content as interpreted by a rendering engine,

wherein preservation of the functionality defined by the HTML-based Web content includes preservation of hyperlink functionality, and wherein execution of the instructions performs further operations comprising enabling a user to view a paragraph of the Web content at a higher resolution than a current resolution by tapping on the paragraph via the touch-sensitive display, wherein in response thereto, *the display is re-rendered such that content corresponding to the selected paragraph is displayed across at least one of a width and height of a display area of the touch-sensitive display.*

REFERENCES

Name	Reference	Date
Benjamin B. Bederson & James D. Hollan ("Bederson-I")	Pad++: <i>A Zoomable Graphical Interface System</i> , CHI '95 MOSAIC OF CREATIVITY	1995

Benjamin B. Bederson & George W. Furnas (“Bederson-2”)	<i>Space-Scale Diagrams: Understanding Multiscale Interfaces</i> , CHI ‘95 Proceedings	1995
Benjamin B. Bederson et al. (“Bederson-3”)	<i>A Zooming Web Browser</i> , 2667 SPIE 260–71	1995
Ben Bederson & Jon Meyer (“Bederson-4”)	<i>Implementing a Zooming User Interface: Experience Building Pad ++</i> , 28 SOFTWARE–PRACTICE & EXPERIENCE 1101–35	1998
Benjamin B. Bederson et al. (“Bederson-5”)	<i>Pad++: A Zoomable Graphical Sketchpad for Exploring Alternate Interface Physics</i> , 7 J. VISUAL LANGUAGES & COMPUTING 3–31	1996
Jonathan Meyer (“Pad++ Tour”)	A Brief Tour Through Pad++	1997
Dave Raggett (“HTML 3.2 Standard”)	HTML 3.2 Specification, World Wide Web Consortium (W3C)	Jan. 14, 1997
Dave Raggett, Arnaud Le Hors, and Ian Jacobs, eds. (“HTML 4.0 Standard”)	HTML 4.0 Specification, World Wide Web Consortium (W3C)	Dec. 18, 1997
Tim Bray (“Bray”)	<i>XML support in IE5</i> , XLM.com	Mar. 18, 1999
Brian Matthews et al. (“VML”)	<i>Vector Markup Language (VML)</i> , World Wide Web Consortium Note, Note-VML-19980513	May 13, 1998
SoftSource, LLC (“SVF”)	Specification for the Simple Vector Format v. 1.1	Jan. 15, 1995
SoftSource, LLC (“SVF Press 1”)	New CAD System Works With AutoCAD Drawings Without Translation	June 17, 1996

SoftSource, LLC ("SVF Press 2")	Bring New CAD Viewing Power to the Internet	Mar. 4, 1996
Hara et al. ("JP 169")	JP H10-326169	Dec. 8, 1998

The Non-Adopted Rejections

Requester appeals the Examiner's decision not to adopt the following proposed rejections:

1. Claims 29 and 78 as unpatentable under 35 U.S.C. § 103(a) over Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, and Bray.
2. Claims 29 and 78 as unpatentable under 35 U.S.C. § 103(a) over various combinations of HTML 3.2 Standard, HTML 4.0 Standard, Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, JP 169, SVF, and VML.
3. Claims 29 and 78 as unpatentable under 35 U.S.C. § 103(a) over various combinations of Patent Owner's admitted prior art, Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, JP 169, SVF, and VML.
4. Claims 29 and 78 as unpatentable under 35 U.S.C. § 103(a) over JP 169, Bray, and either SVF or VML.

The Rejections

Patent Owner appeals the Examiner's decision to reject the following pending claims:

Claims 64 and 66 stand rejected under 35 U.S.C. § 103(a) over Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, and Pad++ Tour.³

Patent Owner also relied upon the following in rebuttal to the Examiner's rejections:

Declaration under 37 C.F.R. § 1.132 of Wolf (formerly Scott Collins), dated July 15, 2017 (Patent Owner Ex. A).

Declaration under 37 C.F.R. § 1.132 of Michael L. Howard, November 16, 2016 (Patent Owner Ex. B).

ANALYSIS

Requester's Appeal—Claims 29 and 78

The Examiner did not adopt Requester's proposed rejection of claims 29 and 78 as unpatentable under 35 U.S.C. § 103(a) over Pad++ Tour and Patent Owner's admitted prior art (RAN 31–32), in which Requester argued that “[t]he ’926. . . Patent[] also admit[s] that the Mozilla rendering engine was in the prior art” and “the Mozilla (Gecko) rendering engine during pre-rendering processing operations to parse and process the HTML and CSS source code” (Requester Comments 25, filed Aug. 16, 2017). We do not agree with the Examiner's determination.

³ The Examiner inadvertently omitted Pad++ Tour from the statement of the rejection. (RAN 47–49.)

The '926 patent discloses the following:

As will be recognized by those skilled in the art, *the functions performed in blocks 150, 152, and 154 [of Figure 5] are commonly performed by conventional browsers during a pre-rendering process. In some browsers, these functions are performed by the Mozilla rendering engine, which comprises open source software that is readily available for use by developers.* At present, the software for the Mozilla rendering engine may be accessed via the Internet at www.mozilla.org. Accordingly, in one embodiment, the present invention uses core functionality provided by the Mozilla rendering engine source code to perform the functions of block 150, 152, and 154.

(Col. 17, ll. 31–41 (emphases added).)

The process is initiated when the proxy server receives the HTML corresponding to the parent document (and frame documents, if appropriate), whereupon *a pre-rendering parsing of the HTML is performed to determine where to place the various objects on the display page in a block 150.* For example, elements such as tables, column definitions, graphic images, paragraphs and line breaks are identified. If frames are included, each frame is examined in the sequential order it appears in the HTML document, or the order in which the HTML documents corresponding to the frames in a frameset are downloaded to the browser.

(Col. 15, ll. 45–55 (emphasis added).)

The Wolf Declaration further states the following:

The '926 . . . patent[] disclose[s] using the Mozilla (Gecko) rendering engine during *prerendering processing operations* to parse and process the HTML and CSS source code and generate HTML objects and associated page layout information, including bounding boxes.

(¶ 16 (emphasis added).)

In view of Patent Owner's disclosure in the '926 patent that:

(i) "a pre-rendering parsing of the HTML is performed to determine where to place the various objects on the display page in a block 150";
(ii) the function performed in block 150, pre-rendering parsing of HTML, is "commonly performed by conventional browsers"; and (iii) Patent Owner's declaration evidence that pre-rendering processing operations parse and process the HTML and CSS source code, the '926 patent admits that the limitation "wherein the HTML-based Web content includes cascading style sheet content defining layout and presentation attributes for the Web page" was well-known to one of ordinary skill in the art.

Patent Owner argues that "Wolf's quoted statements relate to the minimum HTML and CSS support a PHOSITA would want to implement at the time of the invention, but does not assert implementing a browser supporting HTML 4/4.01 and CSS would be within the skill of a PHOSITA." (PO Respondent Br. 32.) In particular, Patent Owner points to paragraph 28 of the Wolf Declaration, which states the following:

A PHOSITA in 2000-2001 could not have modified Pad++ to implement the numerous unsupported HTML elements to produce an HTML 3.2 browser, much less an HTML 4/4.01 browser. The Pad++ browser employed a simple single-pass HTML parser that generated PAD++ objects for a handful of HTML tags, and did not implement dozens of HTML tags, including tags that are fundamental to page layout such as tables, divs, and spans. It also had no CSS support. A PHOSITA in 2000-2001 would also not attempt to write original code to support HTML 4, CSS 1, or CSS 2, and there would be no chance such an attempt would have succeeded without undue experimentation. As discussed above, it took a team of highly-skilled developers and software engineers 50+ man-years to develop the first version of Gecko that was

released in a commercial Web browser (Netscape Navigator 6 in November, 2000).

(¶ 28.) However, Patent Owner’s arguments are not commensurate in scope with claim 29, because the claim neither recites a specific HTML version nor a specific CSS version. In addition, in direct contradiction to Patent Owner’s argument that “a PHOSITA could not modify Pad++ to support existing HTML and CSS standards . . . [and] would have no motivation to attempt to do so,” Wolf also states that “[i]n the 2000-2001 timeframe, anyone (or company) developing a Web browser would want to have the browser comply with HTML 4/4.01 and relevant portions of CSS 1 and CSS 2” (¶ 26). Although we recognize Wolf’s statement that “it took a team of highly-skilled developers and software engineers 50+ man-years to develop the first version of Gecko,” such statement applies to the specific situation of implementing HTML 4.0 with CCS 2.

Patent Owner further argues the following:

Respondent [Patent Owner] has provided irrefutable evidence that highly-skilled engineers at Mozilla were unable to implement a desktop browser supporting full-page zooming until 2007. Mozilla’s “Minimo” mobile browser did not preserve the original page layout or design. Appellant’s [Requester] assertions that a PHOSITA, at the time of the invention, could have done on a mobile device what Mozilla failed to do on a desktop until 2007 and did not do on a mobile device is not supported by any factual evidence.

(PO Respondent Br. 34 (emphasis omitted).) In particular, Patent Owner points to paragraph 26 of the Howard Declaration, which states the following:

Mozilla did not fully implement a browser on a PDA or mobile phone until at least 2004, and this implementation did

not preserve the original page layout or design. This development was under the Mini-Mozilla (“Minimo”) project. (¶ 87.) However, Pad++ Tour expressly states that “[y]our whole desktop could be zoomable” and “[t]his seems especially attractive for systems which have small screens, such as handheld computers (i.e. PDA’s).” (P. 141.) Although we recognize that “Mozilla did not fully implement a browser on a PDA or mobile phone until at least 2004,” such evidence does not necessarily mean that one of ordinary skill in the art would have excluded all web browsers from the implementation on a PDA or mobile phone.

Accordingly, we reverse the Examiner’s decision not to reject claims 29 and 78 under 35 U.S.C. § 103(a) over Patent Owner’s admitted prior art and Pad++ Tour and we enter a new ground of rejection based thereon.

We do not reach the cumulative rejections of claims 29 and 78 under 35 U.S.C. § 103(a) because it is unnecessary to reach the propriety of the Examiner’s decision not to reject these claims on a different basis. *Cf. In re Gleave*, 560 F.3d 1331, 1338 (Fed. Cir. 2009) (not reaching additional obviousness rejections).

Patent Owner’s Appeal—Claims 64 and 66

The Examiner found that Pad++ Tour, which illustrates screen snapshots of both an HTML document and a zoomed-in view of the same HTML document, corresponds to the limitations: (i) “enabling a user to view a column of the Web content at a higher resolution than a current resolution by tapping on the column . . . the display is re-rendered such that

content corresponding to the selected column is displayed across the touch-sensitive display,” as recited in independent claim 64; and (ii)

enabling a user to view a paragraph of the Web content at a higher resolution than a current resolution by tapping on the paragraph . . . the display is re-rendered such that content corresponding to the selected paragraph is displayed across at least one of a width and height of a display area of the touch-sensitive display.

(RAN 49.) In particular, the Examiner stated that “the Pad++ Tour reference meets the limitation by more specifically showing dynamically zooming in on a paragraph of text (see: Pad++ Tour, p. 89) of an initially displayed HTML document (see: Pad++ Tour, p. 87), wherein said paragraph of text is displayed across the display.” (RAN 49.) Requester agrees and argues that “[t]he Pad++ references teach that the Web browser could process HTML documents that include text, line segments, images, bullet items and horizontal rules” (Requester Respondent Br. 10), “Pad++ teaches clicking on an object and having it fill the screen,” and “it was well known in the prior art that PDAs such as the Palm device included a touch-sensitive display that the user could tap using a stylus” (*id.* at 11). We agree with the Examiner’s determination.

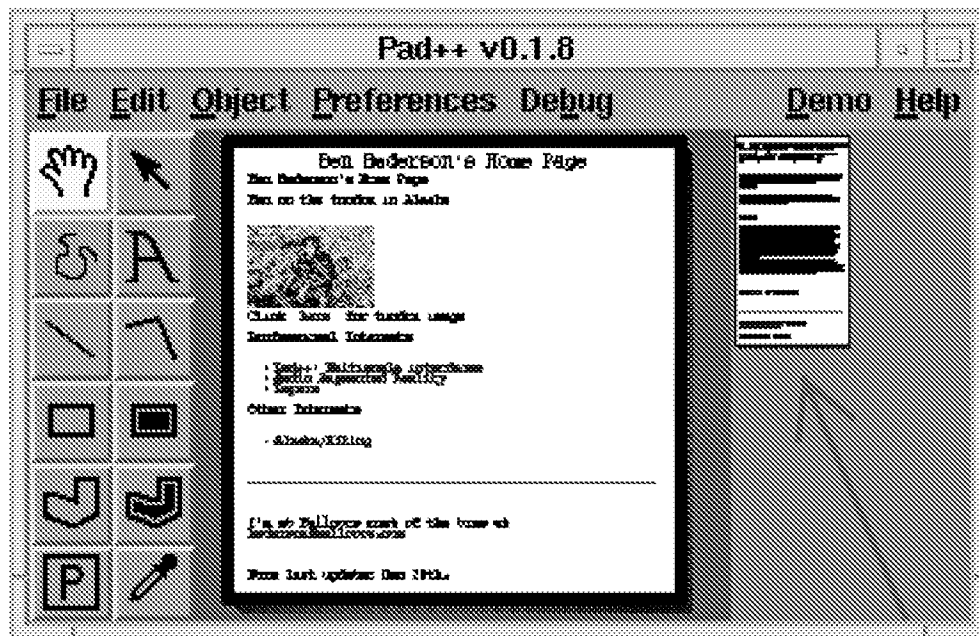
Pad++ Tour relates to a computer screen having a zoomable surface, “[f]or example, several million pages of text could be fit on the surface by reducing it sufficiently in scale, making any number of on-line information services, encyclopedias, etc., directly available.” (P. 2.) In one example of zooming a user interface, entitled “An HTML browser,” Pad++ Tour explains the following:

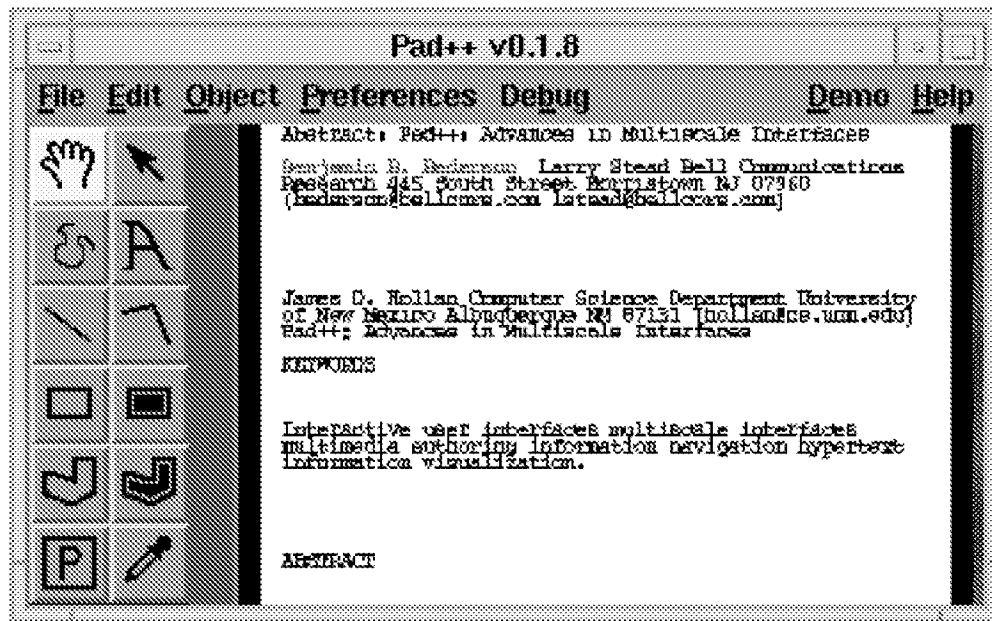
A zooming version of Mosaic and Netscape? This is not such a strange idea. The third example Pad++ application we will look at is a simple Pad++ web browser.

Although the web browser we show here is still fairly primitive, you could imagine a much more advanced version. Does the idea of using a zoomable Web browser excite you?

(P. 86.)

In two unreferenced figures, reproduced below, Pad++ Tour depicts screen snapshots of: (i) “Pad++: Multiscale interfaces” HTML document (annotated with an arrow) loaded next to the regularly sized HTML document entitled “Ben Bederson’s Home Page” (p. 91) and (ii) the zoomed-in view of the same HTML document, entitled “Abstract: Pad++: Advances in Multiscale Interfaces” (p. 93):





In particular, Pad++ Tour explains the following:

When you follow a link, the relevant document is loaded into Pad++ and placed on the surface to the right of the original document, at a smaller scale. Here you can see the ‘Pad++: Multiscale interfaces’ document loaded beside the home page.

The Pad++ HTML browser will lay out sub-documents in two columns next to the parent document. Because Pad++ is zoomable, there is always enough space between those two columns for placing further documents reached from those sub-documents!

(P. 91.) Pad++ Tour also explains that “[w]hen you click on a piece of text, Pad++ zooms in so that that text fills the screen horizontally and appears near the top of the screen vertically.” (P. 54.)

Moreover, Pad++ Tour explains the following:

Pad++ could also be viewed as a way to implement an alternative windowing system based on zooming. Your whole desktop could be zoomable. This seems especially attractive for systems which have small screens, such as handheld computers (i.e. PDA’s).

(P. 141.) Moreover, one relevant definition of a “PDA” (personal digital assistant) is “[a] lightweight palmtop computer designed to provide specific functions like personal organization (calendar, note taking, database, calculator, and so on) as well as communications,” such that “[m]any PDA devices rely on a pen or other pointing device for input instead of a keyboard or mouse.”⁴

Because Pad++ Tour explains that: (i) clicking on the “Pad++: Multiscale interfaces” link on “Ben Bederson’s Home Page” lays out the sub-document next to the parent document; (ii) the sub-document “Abstract: Pad++: Advances in Multiscale Interfaces” is zoomable, such that the text fills the screen horizontally and displays a paragraph (e.g., title, authors, and keywords of a technical publication); and (iii) Pad++ is attractive for systems having small screens, such as PDA devices having a pen or pointing device, Pad++ Tour teaches the limitations “enabling a user to view a column of the Web content at a higher resolution than a current resolution by tapping on the column . . . the display is re-rendered such that content corresponding to the selected column is displayed across the touch-sensitive display” and

enabling a user to view a paragraph of the Web content at a higher resolution than a current resolution by tapping on the paragraph . . . the display is re-rendered such that content corresponding to the selected paragraph is displayed across at least one of a width and height of a display area of the touch-sensitive display.

First, Patent Owner argues that “Pad++ could support a very limited set of HTML tags” and “[i]t is irrefutable that Pad++ could not interpret

⁴ MICROSOFT® COMPUTER DICTIONARY 396 (5th ed. 2002).

HTML used to lay out page content in columns (HTML tables, HTML <div> tags, spans or any other structure used to lay out page content in columns, notably CSS.” (PO Appeal Br. 28; *see also id.* at 42, 48.)

However, Patent Owner’s arguments are not commensurate in scope with either claim 64 or claim 66, because the claims do not recite “HTML tags.”

Second, Patent Owner argues that “Pad++ does not disclose any browser screenshots where the content of a paragraph is ‘displayed across at least one of a width and height of a display area of the [touch-sensitive] display’ when the page is clicked on.” (PO Appeal Br. 35 (emphasis omitted); *see also* PO Rebuttal Br. 14.) Similarly, Patent Owner argues that

PHOSITA would not have considered this [a screen snapshot of “Ben Bederson’s Home Page” with a truncated sentence “Click here for tundra ima” on page 89 of Pad Tour++] to be a zoom on a column or a paragraph within a Web page nor conclude that the content in this HTML document is re-rendered such that it is rendered across the width of a display or display area. (PO Appeal Br. 43–44 (emphasis omitted).) However, as discussed previously, the Examiner also cited to the figures on pages 91 and 93 of Pad++ Tour.

Third, Patent Owner argues that “Pad++ does not support zooming on any HTML content within a web page, regardless of the selection method” and “[t]he zoom was agnostic to the underlying content – it doesn’t matter whether it was a web page, or any other type of Pad++ content.” (PO Appeal Br. 38 (emphasis omitted); *see also* PO Rebuttal Br. 22.) Similarly, Patent Owner argues that “Pad++’s browser [from Figure 5 of Bederson-5] implemented two zoom behaviors for mouse clicks: Clicking anywhere (other than a hyperlink) on an ‘out of focus’ page causes it to be enlarged,

but does not cause the page to be displayed to be rendered across the screen.” (PO Appeal Br. 44–45.) However, the Examiner also cited to pages 91 and 93 of Pad++ Tour for teaching the limitation “the display is re-rendered such that content corresponding to the selected paragraph is displayed across at least one of a width and height of a display area of the touch-sensitive display,” and Patent Owner has not provided any persuasive arguments or evidence as to why the Examiner’s findings with respect to Pad++ Tour are erroneous.

Fourth, Patent Owner argues that “Pad++ does not generate a bounding box for a paragraph” and “Pad++ does not teach or suggest zooming on any HTML object in a Web page (MSML is not HTML), much less an HTML paragraph that Pad++ never generates a bounding box for nor would benefit from generating such a bounding box.” (PO Appeal Br. 49; *see also* PO Rebuttal Br. 14.) However, Patent Owner’s arguments are not commensurate in scope with either claim 64 or claim 66, because the claims do not recite “bounding box.”

Fifth, Patent Owner argues that “Bederson’s testimony provides no evidence that the (unknown) touchscreen was the only input device being used for the ZIB program, and it is irrefutable that the touchscreen was not for a PDA.” (PO Appeal Br. 56.) However, as discussed previously, Pad++ Tour explains that “Pad++ could also be viewed as a way to implement an alternative windowing system based on zooming” and “[t]his seems especially attractive for systems which have small screens, such as handheld computers (i.e. PDA’s).” (P. 141.)

Sixth, Patent Owner argues that “[d]ynamically zooming in on a paragraph of text (see: Pad++Tour, p. 89) could not have been performed in response to a mouse-click input” and “[t]apping would be an analogous input to clicking an object with a mouse, not holding a (middle) mouse button down, which was required by Pad++ to dynamically zoom in.” (PO Appeal Br. 56.) Similarly, Patent Owner argues that “[t]here is no disclosure in any Pad++ document nor the browser source code itself disclosing the ability to zoom on any HTML element within a Web page by tapping on the HTML element, much less zooming on column (which Pad++ could not interpret) or paragraph by tapping on it.” (PO Rebuttal Br. 19–20.) Again, Pad++ Tour explains that “[y]our whole desktop could be zoomable” and “[t]his seems especially attractive for systems which have small screens, such as handheld computers (i.e. PDA’s).” (P. 141.) Moreover, one of ordinary skill in the art would recognize that a PDA device would include a pen or pointing device for input.

Last, Patent Owner argues that “Pad++ taught and achieved real-time zooming on a 200 MHz Pentium Pro PC (desktop computer), which included a numeric co-processor” and “[t]he empirical test evidence simulating the zoom performance of Pad++ running on a PDA with a 206MHz Intel SA-1110 processor demonstrates it could not come remotely close to support real-time zooming.” (PO Rebuttal Br. 15.) However, Patent Owner’s arguments are not commensurate in scope with either claim 64 or claim 66, because the claims do not recite “real-time zooming.”

Accordingly, we affirm the Examiner's decision to reject claims 64 and 66 under 35 U.S.C. § 103(a) as unpatentable over Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, and Pad++ Tour.

NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50(b)

We enter the following new ground of rejection:

Claims 29 and 78 are rejected under 35 U.S.C. § 103(a) as unpatentable over Pad Tour++ and HTML 4.0 Standard.

As discussed previously, in one example of zooming a user interface, entitled "An HTML browser," Pad++ Tour explains the following:

A zooming version of Mosaic and Netscape? This is not such a strange idea. The third example Pad++ application we will look at is a simple Pad++ web browser.

Although the web browser we show here is still fairly primitive, you could imagine a much more advanced version. Does the idea of using a zoomable Web browser excite you?

(P. 86.) Pad++ Tour explains the following:

When you follow a link, the relevant document is loaded into Pad++ and placed on the surface to the right of the original document, at a smaller scale. Here you can see the 'Pad++: Multiscale interfaces' document loaded beside the home page.

The Pad++ HTML browser will lay out sub-documents in two columns next to the parent document. Because Pad++ is zoomable, there is always enough space between those two columns for placing further documents reached from those sub-documents!

(P. 93.)

HTML 4.0 Standard relates to “[t]he publishing language used by the World Wide Web is HTML (from HyperText Markup Language).” (§ 2.2.) In particular, HTML 4.0 Standard explains the following:

Most people agree that HTML documents should work well across different browsers and platforms. Achieving interoperability lowers costs to content providers since they must develop only one version of a document. If the effort is not made, there is much greater risk that the Web will devolve into a proprietary world of incompatible formats, ultimately reducing the Web’s commercial potential for all participants.

. . . .

HTML has been developed with the vision that all manner of devices should be able to use information on the Web: PCs with graphics displays of varying resolution and color depths, cellular telephones, hand held devices, devices for speech for output and input, computers with high or low bandwidth, and so on.

(§ 2.2.1.) HTML 4.0 Standard further explains that “[s]tyle sheets simplify HTML markup and largely relieve HTML of the responsibilities of presentation” and “give both authors and users control over the presentation of documents – font information, alignment, colors, etc.” (§ 2.3.5.)

Moreover, with respect to style sheets, HTML 4.0 Standard explains that “[s]tyle sheets represent a major breakthrough for Web page designers, expanding their ability to improve the appearance of their pages.” (§ 14.1.) In particular, HTML Standards explains that a “cascading” style sheet “is the capability provided by some style sheet languages such as CSS to allow style information from several sources to be blended together.” (*Id.*)

A person of ordinary skill in the art would have recognized that incorporating the cascading style sheets of HTML 4.0 Standard with the

Pad++ HTML browser of Pad++ Tour would have improved Pad++ Tour by providing the advantage of improving the appearance of Web pages, including style information from several sources. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”).

Alternatively, the combination of HTML 4.0 Standard and Pad++ Tour is nothing more than adding the known cascading style sheet of HTML 4.0 Standard with the known HTML browser of Pad++ Tour, to yield predictable results. *See id.* at 416 (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

Accordingly, the combination of Pad++ Tour and HTML 4.0 Standard teaches the limitation “wherein the HTML-based Web content includes cascading style sheet content defining layout and presentation attributes for the Web page.”

Pursuant to our authority under 37 C.F.R. § 41.50(b), we reject claims 29 and 78 under 35 U.S.C. § 103(a) as unpatentable over Pad++ Tour and HTML 4.0 Standard.

DECISION

We affirm the Examiner’s decision to reject claims 64 and 66 under 35 U.S.C. § 103(a) as unpatentable over Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, and Pad++ Tour.

We reverse the Examiner's decision not to adopt the rejection of claims 29 and 78 under 35 U.S.C. § 103(a) as being unpatentable over Pad++ Tour and Patent Owner's admitted prior art and enter a new rejection based thereon.

We reject claims 29 and 78 under 35 U.S.C. § 103(a) as unpatentable over Pad++ Tour and HTML 4.0 Standard.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed	New Ground
64, 66	103(a)	Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, and Pad++ Tour	64, 66		
29, 78	103(a)	Patent Owner's admitted prior art, Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, JP 169, SVF, VML			29, 78
29, 78	103(a)	Pad++ Tour, HTML 4.0 Standards			29, 78

29, 78	103(a)	Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, Bray ⁵			
29, 78	103(a)	HTML 3.2 Standards, HTML 4.0 Standards, Bederson-1, Bederson-2, Bederson-3, Bederson-4, Bederson-5, JP 169, SVF, VML ⁶			
29, 78	103(a)	JP 169, Bray, SVF, VML ⁷			
Overall Outcome			64, 66		29, 78

Pursuant to 37 C.F.R. § 41.77(a), the above-noted reversal of the Examiner’s decision not adopting the proposed rejection of claims 29 and 78 constitutes a new ground of rejection and is hereby designated as such. Section 41.77(b) provides that “[a] new ground of rejection . . . shall not be considered final for judicial review.” That section also provides that Patent 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 proceeding as to the rejected claims:

⁵ Cumulative rejection.

⁶ Cumulative rejection.

⁷ Cumulative rejection.

(1) *Reopen prosecution.* The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.

(2) *Request rehearing.* The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

In accordance with 37 C.F.R. § 41.79(a)(1), the “[p]arties to the appeal may file a request for rehearing of the decision within one month of the date of: . . . [t]he original decision of the Board under § 41.77(a).” A request for rehearing must be in compliance with 37 C.F.R. § 41.79(b). Comments in opposition to the request and additional requests for rehearing must be in accordance with 37 C.F.R. § 41.79(c) & (d), respectively. Under 37 C.F.R. § 41.79(e), the times for requesting rehearing under paragraph (a) of this section, for requesting further rehearing under paragraph (d) of this section, and for submitting comments under paragraph (c) of this section may not be extended.

An appeal to the United States Court of Appeals for the Federal Circuit under 35 U.S.C. §§ 141-144 and 315 and 37 C.F.R. § 1.983 for an *inter partes* reexamination proceeding “commenced” on or after November 2, 2002 may not be taken “until all parties’ rights to request rehearing have been exhausted, at which time the decision of the Board is final and

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appealable by any party to the appeal to the Board.” 37 C.F.R. § 41.81. *See also* MPEP § 2682 (8th ed., Rev. 8, July 2010).

Requests for extensions of time in this *inter partes* reexamination proceeding are governed by 37 C.F.R. § 1.956. *See* 37 C.F.R. § 41.79.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED
37 C.F.R. § 41.77(b)

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