Trials@uspto.gov
571-272-7822

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KYOCERA CORPORATION
MOTOROLA MOBILITY, INC
Petitioner

v.

SOFTVIEW LLC
Patent Owner

Case IPR2013-00007
Case IPR2013-00256
Patent 7,461,353 B2

Before BRYAN F. MOORE, BRIAN J. McNAMARA, and STACEY G. WHITE, Administrative Patent Judges.

McNAMARA, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. 42.73

BACKGROUND

On March 29, 2013, in Paper 11, the Board entered a Decision to Institute an *inter partes* review on the following challenges raised by Kyocera Corporation to the patentability of claims 1, 33, 36, 43, 48, 51, 52, 58, 59, 118, 138, 139, 149, 183, 252, 283, and 317 ("Challenged Claims") of U.S. Patent No. 7,461,353 B2 (the '353 Patent) owned by Softview LLC ("Patent Owner"):

> Challenged Claims 1, 33, 36, 43, 48, 51, 52, 58, 59, 118, 138, 139, 149, 183, 252, 283, and 317as obvious under 35 U.S.C. § 103 over the combination of Zaurus[1], Pad++[2];
>
> Challenged Claim 66 as obvious over the combination of Zaurus, Pad++ and SVG[3];

[1] Power Zaurus Personal Digital Assistant Documentation ("Zaurus"), Ex. 1004
[2] Bederson, Benjamin B. and Hollan James D., Pad++: A Zoomable Graphical Interface System, CHI '95 Mosaic of Creativity, May 1995; Bederson, Benjamin B. and Furnas, George W, Space-Scale Diagrams: Understanding Multiscale Interfaces, CHI '95 Proceedings, 1995; Bederson, Benjamin B., et al, A Zooming Web Browser, SPIE, Vol. 2667, 260-71, May 1996; Bederson, Ben and Meyer, Jon, Implementing a Zooming User Interface: Experience Building Pad ++, Software-Practice and Experience, Vol. 28(1), 1101-35, Aug. 1998; Bederson, Benjamin B., et al., Pad++: A Zoomable Graphical Sketchpad for Exploring Alternate Interface Physics, Journal of Visual Languages and Computing, Vol. 7, 3-31, 1996; Pad++ Reference Manual Version 0.2.7, published July 9, 1996; Pad++ Programmer's Guide Version 0.2.7, published June 10, 1996 (collectively, "Pad++"), Ex. 1006
[3] Ferraiolo, Jon, Scalable Vector Graphics Requirements: W3C Working Group Draft, Oct. 29, 1998. ("SVG"), Ex. 1007

Challenged Claims 1, 33, 36, 43, 48, 51, 52, 58, 59, 118, 138, 139, 149, 183, 252, 283, and 317 as obvious over the combination of Zaurus, Tsutsumitake[4], and Hara[5];

Challenged Claim 66 as obvious under 35 U.S.C. § 103 over the combination of Zaurus, Tsutsumitake, Hara, and SVG.

IPR2013-00256, brought by Motorola Mobility LLC, raised the same challenges and later was joined to this proceeding. IPR2013-00256, Paper 10. Kyocera Corporation and Motorola Mobility are referred to collectively as "Petitioner."

On July 19, 2013, Patent Owner filed a response brief. (PO Resp., Paper 25). Petitioner filed a Consolidated Reply to Patent Owner's Response. (Paper 28). Patent Owner filed a Motion to Exclude. (Mot. to Exclude, Paper 41) and Petitioner replied (Reply to Mot. to Exclude, Paper 42). An oral hearing was held on January 7, 2014, concurrent with the oral hearing in related consolidated proceeding, IPR2013-00004/IPR2013-00257, between the same parties.

In this Final Written Decision, we determine pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 that Petitioner has shown, by a preponderance of the evidence, that all challenged claims are unpatentable under 35 U.S.C. § 103.

THE '353 PATENT (EXHIBIT 1001)

As indicated by its title, the '353 patent is drawn to the scalable display of Internet content, e.g., Hyper Text Markup Language (HTML)-based content, cascade style sheet (CSS) content and XML content on mobile devices by enabling the content to be rendered, zoomed, and panned for better viewing on small screens

[4] Japanese Laid Open Patent Application H10-21224 ("Tsutsumitake"), Ex. 1005
[5] Japanese Unexamined Patent Application Publication H10-326169 ("Hara"), Ex. 1008

and standard monitors. Ex. 1001, col. 2, ll. 22-39, col. 5, ll. 18-22. A client side viewer receives the Internet content in an Internet browser, e.g., a micro-browser or a browser plug-in, and uses the simple vector format (SVF) originally designed to handle common computer aided design (CAD) file formats to describe the current web content. *Id.* at col. 4, ll. 43-63. Translation of the content into a scalable vector representation can be done by a third party proxy service (Fig. 1A), the content provider's web site (Fig. 1B) or at the client (Fig. 1C).

Figure 5 illustrates the logic used by the invention when translating content into a scalable vector representation. *Id.* at col. 3, ll. 50-52. Pre-rendering parsing of a received HTML document identifies elements such as tables, column definitions, graphic images, paragraphs, and line breaks, and determines where to place objects on a display. *Id.* at col. 15, ll. 45-52. When using frames, the display page is divided into multiple frame areas, which enables a single displayed page to include source code from several HTML documents. *Id.* at col. 15, ll. 33-36. During pre-rendering, each frame is examined in the sequential order it appears in the HTML document, and during further processing, actual objects are rendered in their respective positions. *Id.* at col. 15, ll. 52-57. The content is separated into objects based on logical groupings of content, and a page layout is built using bounding boxes produced for each object. *Id.* at col. 16, ll. 19-38, col. 17, ll. 15-29). The '353 Patent admits that the above steps commonly are performed by conventional browsers in the pre-rendering process, but indicates that the steps it discloses to use layout data generated in the pre-rendering process to generate a scalable vector representation of the original page content depart from the prior art. *Id.* at col. 17, ll. 30-45.

The '353 Patent discloses that generating a scalable vector representation begins by defining a page datum point as an X,Y value and a datum point as an

X,Y value for each object's bounding box. *Id.* at col. 17, ll. 45-64, col. 18, ll. 1-5. A vector between the page datum point and the datum point for each bounding box is then generated and stored. *Id*. A frame datum can also be assigned and vectors drawn from the page datum to the frame datum to establish the frame's offset and from the frame datum to each object in the frame. *Id.* at col. 18, ll. 5-16. The scalable vector representation then is completed by a reference that links each object's contents, attributes such as type (image, text), and bounding box parameters such as height and width to the object's vector. *Id.* at col. 18, ll. 18-26.

A display list of vectors for the vectorized HTML content is built, as is known from CAD arts, and a user selectable scale and offset are determined. *Id.* at col. 19, ll. 14-25. The bounding boxes are processed using the scale and offset, and a bounding box defining the limits of the display content is determined. *Id.* at col. 19, ll. 32-35. Scaling and offset can be accomplished either (i) by mapping vectors to a virtual display area in memory with much more resolution than the actual display, and reducing the scaling of the objects in the virtual display to how they will appear in the actual display, or (ii) by using a fixed reference frame corresponding to the client's screen resolution and scaling and offsetting the vectors's bounding boxes relative to the fixed frame. *Id.* at col. 19, ll. 39-56. Using the latter approach, respective offsets in X and Y ($-\Delta X$ and $-\Delta Y$) are applied to the starting point and the vectors are scaled by an amount SF, producing a new datum (starting point) for each bounding box relative to the rendered page datum, which remains fixed, but may, or may not, be displayed depending on the offset and scaling. *Id.* at col. 19, l. 58 - col. 20, l. 17. Once the bounding boxes are offset and scaled, the content (e.g., image and text) corresponding to objects having at least a part of their bounding boxes on the screen is retrieved from the client device's display list and scaled. *Id.* at col. 20, ll. 18-44. A display limit bounding

box defines the portion of the display screen that actually will be used to display content. *Id.* at col. 19, l. 58 - col. 20, l. 7. The portions of the scaled content falling within the display limit bounding box are rendered on the client's display device. *Id.* at col. 20, ll. 45-47.

ILLUSTRATIVE CLAIMS

Apparatus claims 1 and 36, which are illustrative, are shown below.

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

Claim 33 further limits the scalable content of claim 1 to vector based content. Claim 118 is a method claim limited to operations, which generally correspond to the operations performed by the apparatus recited in claim 1.

> 36. A mobile hand-held device, comprising:
> a processor,
> a wireless communications device, to facilitate wireless communication with a network that supports access to the Internet;
> a display; and
> flash memory, operatively coupled to the processor, in which a plurality of instructions are stored that when executed by the processor enable the mobile hand-held 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 the Web page via the wireless communications device, and processing HTML-based Web content to produce scalable content; and
> employing at least one of the scalable content or data derived therefrom to,
> render the Web page on the display; and
> re-render the display in response to associated user inputs to enable the Web page to be browsed at various zoom levels and panned views while preserving the original page layout, functionality, and design of the Web page content at each zoom level and panned view.

Claim 43 limits the scalable content recited in claim 36 to vector-based content. Claim 48 limits claim 36 to enabling a user to zoom on a column of the web content, such that the display is re-rendered to fit across the display. Claim 51 similarly limits claim 36 when the selected content is an image. Claim 52 limits claim 51 to selecting the image by tapping the display. Claim 66 limits claim 36 to preserving aspects of the web page design that are defined by cascaded style sheets.

Claim 149, which is drawn to a method, and claim 252, which is drawn to a machine readable medium, both recite limitations which generally correspond to the operations recited in claim 36. Claim 183 limits the method in claim 149 to

vector-based content and claim 283 limits the machine readable medium in claim 252 to vector-based content.

Claim 58, which depends from apparatus claim 36, recites additional operations including parsing HTML-based code and logically grouping selected content into objects. Method claim 138, which depends from claim 118, recites similar parsing and logical grouping features. Claim 59, which depends from claim 58, and claim 139, which depends from method claim 138, recite generating a bounding box.

Independent claim 317 recites a hand-held device comprising a variety of the features recited in the claims discussed above.

CLAIM CONSTRUCTION

As discussed in our our Decision to Institute, we construed the claim terms as the Petitioner represented they were construed by the district court in co-pending litigation,*SoftView LLC v. Apple Inc.*, Case No. 1:10-cv-00389-LPS (D. Del.). Dec. to Institute, Paper 11, 20-22. A dispute concerning the meaning of another term, i.e., "preserve[s] an original page layout, functionality and design," ("the preserving limitation") emerged after the Patent Owner Response argued in this proceeding and in IPR2013-00004 that this claim feature recites a major distinction over the art cited in Petitioner's challenges. PO Resp. 2.

We authorized briefing concerning the proper construction of the preserving limitation in this proceeding and in IPR2013-00004, which concerns U.S. Patent No. 7,831,926 B1 (the '926 Patent) that has a common specification with the '353 Patent. Petitioner filed the same claim construction brief in each proceeding. Patent Owner filed essentially the same claim construction brief in each proceeding. Neither party argued that the preserving limitation should be construed differently in IPR2013-00004 and IPR2013-00007. We thoroughly

addressed the construction of the preserving limitation in IPR2013-00004 and determined that the preserving limitation should be construed to mean *maintains the features of the web page's capabilities and appearances in a manner consistent with the translated portion of HTML code defining those capabilities and appearances.* IPR2013-00004, Final Written Decision. Neither Petitioner nor Patent Owner argued that the preserving limitation should be construed differently in this proceeding. As discussed below, the construction we adopted in IPR2013-00004 concerning the '926 Patent applies to the claims of the '353 Patent as well.

Patent Owner argues that the original page layout, functionality, and design that must be preserved is the layout "as viewed on a conventional desktop browser." *See,* Patent Owner's Supplemental Claim Construction Brief (Paper 37), 2-3. Petitioner argues that "what is being preserved is the layout of the webpage after it has been processed by the browser." See, Petitioner's Supplemental Claim Construction Brief (Paper 36). Petitioner's proposed construction is consistent with statements made by Patent Owner during prosecution of the'353 Patent, that:

> With respect to the scope of the terminology "preserving the [overall layout, functionality and] design" of the content, this refers to preserving the design as interpreted by the browser while at different zoom levels and panned views as opposed to rendering the content identically to how it is rendered by a particular desktop browser that may interpret the page design differently..

Id. at 4 (citing Ex. 1002, 233). In a footnote on page 233, Patent Owner noted that differences in page interpretation generally will be a function of the browser's rendering engine (*a.k.a.* layout engine). Ex. 1002, 233 n.8.

We do not adopt either Petitioner's or Patent Owner's proposed constructions. Patent Owner's construction introduces uncertainty because the claims do not refer to a conventional desktop browser, and the proposed construction does not define a conventional desktop browser. Patent Owner agrees

that, using the same HTML code, different browsers produce different displays, Ex. 1002, p. 229-31[6], but argues that preserving the look and feel of the web site, as rendered on a desktop browser, is sufficient. *See,* Tr. 51-61. At the oral hearing, Patent Owner argued that "you need to preserve the look and feel so that a person using the web page would understand that that was the same web page as the one that they were using in connection with a desktop computer." *Id*. at 60-61. Due to uncertainty regarding the scope of differences that would be permissible on the target device browser, while maintaining the look and feel as rendered by a conventional desktop browser, we determine that Patent Owner's proposed construction provides no more insight than the current "preserving" claim language.

Petitioner's construction requires that the zoomed version reproduce the layout of the page as initially displayed, but places no requirements on processing performed by the browser's initial rendering of the web page, and does not recognize a relationship between the web page as displayed and the HTML defining its format.

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[6] The '353 and '926 Patents have the same specification. During prosecution of the '353 Patent, Patent Owner noted that,

> [e]ven when rendering the same Web page source content (i.e., the HTML code definition of the web page), conventional web browsers may not render the (non-scaled) Web page identically. Scaling Web pages may also result in alteration of the page layout . . . [h]owever, . . . the overall layout, functionality and appearance (design) of the scaled Web pages defined by the HTML code for the Web page are preserved . . . . Preserving functionality generally pertains to preserving the interoperability of various HTML-based Web page content, such as hyperlinks and UI [user interface] controls such as input forms defined via corresponding HTML-based code. Ex. 1002, 231.

As previously noted, the parties do not argue a different claim construction should apply in the '353 Patent and the '926 Patent, which is the subject of IPR2013-00004, and which we decide contemporaneously with this proceeding. We explained our construction of the preserving limitation in detail in our Final Written Decision in IPR2013-00004. We agree that the same construction should apply to the preserving limitation in the '353 Patent. The preserving limitation in claim 1 recites:

> a scalable resolution-independent representation of the Web page that *preserves the original page layout, functionality and design of the content* defined by its original format when scaled and rendered

As an antecedent to the disputed "preserving limitation," claim 1 recites that the claimed wireless device [mobile phone in the '926 Patent] can render a browser interface that enables a user to request access to a web page "comprising HTML-based web content having an original format defining an original width and height of the Web page and an original page layout, functionality and design of content on the Web page." Ex. 1001, claim 1. Claim 1 also recites "translating at least a portion of the HTML-based Web content from its original format into scalable content that supports a scalable resolution-independent representation of the Web page that preserves the original page layout, functionality, and design of the content defined by its original format when scaled and rendered." Thus, claim 1 does not recite preserving the entire layout, functionality, and design, but only the original layout, functionality, and design that corresponds to the translated portion of the HTML-based web content.

Claim 1 is not limited to a vector based representation. Claim 1 recites only a representation that preserves an original Web page layout, functionality and design when scaled and rendered as defined by at least a portion of the HTML-based web content. Claim 1 cannot be interpreted to preserve a particular

conventional desktop layout because claim 1 does not recite what portion of the HTML-based web content that defines the conventional desktop layout is scaled and rendered. Construing the claim broadly, a portion of the HTML-based content could be scaled and rendered that would preserve only some features of the original layout, function, and design, as viewed on a conventional desktop.[7] While preserving the original layout, functionality, and design of the translated portion of the HTML-based content, the web page rendered on the claimed device may, or may not, appear as it would on a conventional desktop, depending upon what portion of the HTML-based content is translated.

The "preserving limitation" in claim 36 recites:

> employing at least one of the scalable content or data derived therefrom to, render the Web page on the display; and re-render the display . . . to enable the Web page to be browsed at various zoom levels and panned views while preserving an original page layout, functionality, and design of the Web page content at each zoom level and panned view.

Thus, claim 36 recites two renderings. The first rendering of the Web page on the display of the mobile device employs the scalable content, and is not limited to one that preserves the original page layout, function, and design. Claim 36 includes a "retrieving limitation" that recites retrieving the web page, which comprises HTML-based content defining an original page layout, functionality, and design. Although the remainder of the retrieving limitation recites "processing HTML-based Web content to produce scalable content," it does not recite what HTML-based Web content is processed. Specifically, the retrieving limitation recites processing HTML based Web content generally, and does not recite

[7] As discussed further herein, Patent Owner criticizes the prior art references as primitive devices that implement only a portion of available HTML capabilities.

processing the previously recited "HTML based Web content defining an original page layout, functionality, and design of content on the Web page."

The second rendering recited in claim 36 is a re-rendering of the display. As discussed above, the display of the Web page in the first rendering is not limited to one that preserves the original layout, functionality and design of the Web page. The re-rendering provides zooming, while preserving the original page layout, functionality, and design of the Web page content at each zoom level. This is possible only to the extent that the scalable content was produced from HTML based Web content that was processed, as recited in the retrieving limitation.

In consideration of the language of the claims of the '353 Patent, the language of the claim of the '926 Patent, as discussed in our Final Written Decision in IPR2013-00004, and the parties' contentions that the preserving limitation be construed to have the same meaning in the '353 and '926 Patents, we apply the same construction in both patents. Thus, as previously noted, we construe the preserving limitation to mean, *maintains the features of the web page's capabilities and appearances in a manner consistent with the translated portion of HTML code defining those capabilities and appearances.*

ANALYSIS OF PETITIONER'S PRIOR ART CHALLENGES

Grounds Based on Zaurus and Pad++

Claims 1, 33, 36, 43, 58, 59, 66, 118, 138, 139, 149, 183, 252, and 283

Claim 1 is drawn to an apparatus, i.e., a wireless device. Patent Owner notes that claim 118 is a method claim corresponding to apparatus claim 1. Claim 36 is also drawn to an apparatus, i.e., a mobile hand-held device. PO Resp. 18. Patent Owner notes that claims 149 and 252 are method and machine readable medium claims that correspond to apparatus claim 36. *Id*. None of these claims is limited to a vector-based system. Claim 33, which depends from claim 1, claim 183,

which depends from claim 149, and claim 282, which depends from claim 252, recite vector-based content. Patent Owner argues that claims 1, 33, 36, 43, 58, 59, 66, 118, 138, 139, 149, 183, 252, and 283 would not have been obvious over the combination of Zaurus and Pad++ based on the preserving limitation.[8]

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc*., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

We analyze the instituted grounds of unpatentability in accordance with the above-stated principles. We also recognize that prior art references must be "considered together with the knowledge of one of ordinary skill in the pertinent art." *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (quoting *In re Samour*, 571 F.2d 559, 562 (CCPA 1978)). Moreover, "it is proper to take into account not only specific teachings of the reference, but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." *In re Preda*, 401 F.2d 825, 826 (CCPA 1968). That is because an obviousness analysis "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a

[8] Patent owner does not present separate arguments concerning claim 66, for which trial was instituted based on the combination of Zaurus, Pad++, and SVG.

person of ordinary skill in the art would employ." *KSR*, 550 U.S. at 418; *see also In re Translogic Tech., Inc.*, 504 F.3d, 1249, 1259 (Fed. Cir. 2007).

As we discussed above under Claim Construction, the '353 Patent describes as conventional the use of HTML to specify the layout, design, and function of a web page. The '353 Patent also describes the zoom and pan capabilities of the simple vector format (SVF, also referred to as "vectorized content") as known in the CAD art and under consideration by the World Wide Web Consortium for adoption as a standard for vector content on the web. Ex. 1001, col. 4, l. 57 – col. 5, l. 6. Patent Owner's expert states that the invention claimed in the '353 Patent (and the '926 Patent) is "directed toward a browser that extends the web to mobile devices by supporting full-page browsing with zoom and pan, using for example, SVF (Simple Vector Format) to describe web content. '926 Patent, col. , ll. 35-45." Reinman Decl., Ex. 2003 ¶ 9. Although Patent Owner disputes whether the evidence supports a combination of Bederson's description of Pad++ with Zaurus, there appears to be little dispute that Bederson discloses vectorized content. PO Resp. 34.

In view of Patent Owner's arguments, our analysis of the claims turns on whether the Zaurus and Bederson references can be combined, and whether that combination of references renders the "preserving limitation" obvious, i.e., whether it would have been obvious to *maintain the features of the page's capabilities and appearances in a manner consistent with the translated portion of HTML code defining those capabilities and appearances.*

The Zaurus PDA

We begin our consideration of the scope and content of the prior art with Zaurus. Zaurus discloses extending the web to a mobile, handheld device with a small screen. Ex. 1004, 652 -54. As discussed in our Decision to Institute, Zaurus

is a handheld PDA with a wireless communication means to access web content (when used with a digital cellular phone adapter). Dec. to Institute, 23. Zaurus includes a processor to render a browser (with limitations), and provides vertical and horizontal scrolling and magnified and reduced views of web pages. *Id.* Zaurus includes a touch sensitive screen and a browser that has the ability to process HTML-based content up to HTML 3.2, but does not have the ability to render multiple frames properly. Ex. 1004, 105, 127-8. The '353 Patent notes that web pages may be provided as a single frame or multiple frames. Ex. 1001, col.15, ll. 33-36. Zaurus does not ignore multiple frames in web pages. In Zaurus, pages composed of multiple frames are viewed by displaying them frame by frame. Ex. 1004, 105, 638. The frame is selected using a touch screen, so that the selected frame is displayed. Ex. 1004, 647.

Patent Owner argues that HTML is limited to anything that preserves the layout, functionality, and design and "excludes things like active scripting." Tr. 67. Zaurus also discloses differences in the ways its browser processes certain HTML content, for example using a smaller number of font sizes. Ex. 1004, 639. Patent Owner recognized such browser font limitations during prosecution of the related '353 Patent stating "the Web page's design is a matter of interpretation by the particular browser . . . browsers may substitute fonts for fonts (as defined by corresponding HTML code) that are not supported by the browser." Ex. 1002, 233. Zaurus's ability to default to a standard font size, if the HTML data does not specify a size, further indicates that Zaurus incorporates a browser that recognizes HTML-based information used to define web site design features. Ex. 1004, 640. The inability of Zaurus to render properly web pages using certain plug-ins and scripts, or to implement a full complement of HTML features, does not mean

Zaurus cannot be applicable as prior art that teaches implementing HTML on a handheld, mobile device, such as a phone.[9]

Zaurus discloses the ability to switch from a reduced view to a magnified view, as well as a left and right scrolling control and a vertical scrolling bar, to view material not currently on the screen. Ex. 1004, 641, 644-45. Zaurus provides hyperlink functionality, Ex. 1004, 94, 608, but is silent on whether it maintains hyperlink functionality in a magnified display. Zaurus also discloses that by touching the screen one can display a list of web pages opened after connection to the Internet and switching to a selected page. Ex. 1004, 644. Zaurus further discloses compatibility with client side clickable maps, so that by clicking inside a displayed map, one can jump to the page which corresponds to that portion. Ex. 1004, 638. Thus, Zaurus discloses a system that maintains the primary features of a page's appearance in a manner consistent with the portion of HTML code that the Zaurus browser uses. To the extent that the browser in Zaurus provides a limited implementation of HTML, Zaurus preserves the layout and design of the web page defined by the translated portion of the HTML-based Web content (claim 1) and that portion of the HTML content which is processed in the retrieved Web page (claim 36).

[9] The '353 Patent defines an HTML document as any document that contains web page content other than only graphic content. Ex. 1001, col. 8, ll. 1-4. This would include documents with graphics and other contents, as well as scripts and documents using extensible mark-up language (XML). During the oral hearing, however, Patent Owner argued that HTML is limited to anything that preserves the layout, functionality, and design and "excludes things like active scripting." Tr. 67. Patent Owner noted that a box where plug-in content might appear is rendered, but the content with the box is not rendered in the case of Microsoft Internet Explorer because that is a plug in, although another browser might render that content. *Id.* at 64-67.

During the oral hearing, Patent Owner argued that under its proposed construction, which we do not adopt, the "preserving limitation" in the claims requires preserving "the look and feel so that a person using a web page would understand that that was the same web page as the one they were using in connection with a desktop computer." Tr. 60-61. Zaurus does not implement a desktop browser, nor does the specification or claims require implementing a desktop browser in a mobile device. Zaurus discloses that due to its implementation, its display is different from the home page as displayed by using a PC; for example, Zaurus does not display background images of a home page. Ex. 1004, 639. Even with its limited implementation, however, a person using a Zaurus PDA would understand that the same web page as the one being used in connection with a desktop browser was being displayed. Thus, Zaurus falls within the scope of Patent Owner's stated understanding of its proposed claim construction. Tr. 59-61.

Bederson and Pad++

Zaurus discloses only a limited ability to magnify a screen display. Ex. 1004, 645. Bederson, however, discloses a browser, referred to as Pad++ that "allows [Web] pages to remain visible at varying scales while they are not specifically being visited, so the viewer may examine many pages at once. In addition, Pad++ allows users to zoom in and out of pages, enabling explicit control of how much context is viewed at any time." Ex. 1006, 106. Bederson notes that Pad++ was being developed for use on platforms ranging from high-end graphics workstations to PDAs and interactive set-top boxes. *Id.* at 155. Bederson further discloses that using Pad++, one's whole desktop could be zoomable and that this feature "seems especially attractive for systems which have small screens, such as handheld computers (i.e., PDAs)." *Id.* at 341. We are not persuaded by Patent

Owner's assertion that one would not be motivated to port Bederson's Pad++ browser to Zaurus because of technical difficulties resulting from limited computing capacity and system incompatibilities. PO Resp. 29-34.

Bederson discloses zooming primarily for navigation purposes, i.e., for allowing users to identify the web pages they have visited. Patent Owner notes that Pad++ was designed to provide users with a roadmap enabling them to trace their paths from one hyperlink to another, Tr. 70-71, or to show the hierarchy of relationships between web pages. Reinman Decl., Ex. 2003 ¶ 18. We agree. In Bederson's paradigm users navigate a single large information surface on which documents can be placed at any position and scaled to any size with panning, zooming, and hyperlinks. Ex. 1006, 117. One aspect of Pad++ described by Bederson is the use of "dynamic objects" that restructure themselves in response to users' actions. When a user clicks on a link, Pad++ adds the new page to a tree visible to the user and places the new page at the center of the screen as "the current focus" at a size suitable for viewing. *Id.* at 106. A user can designate any page as the current focus by clicking on it. *Id.* In this context, the motivation for Pad++ to provide the ability to zoom in to a page in the roadmap is clear.

Patent Owner argues that Pad++, as described by Bederson, supports only a small subset of HTML. PO Resp. 10, Reinman Decl., Ex. 2003 ¶¶ 29-34. Based on Pad++'s implementation of only a subset of HTML, Patent Owner argues that Pad++ does not disclose preserving the original layout, functionality, and design as claimed. Patent Owner's expert, Dr. Reinman, disagrees with the opinion of Petitioner's expert, Dr. Grimes, that Bederson preserves the original layout of a single web page when zoomed and panned. Dr. Reinman states that Section 3 of the Pad++ Brief Tour shows only how the web page looks after it has been rendered by Pad++, not the original page before being rendered by Pad ++,

precluding a determination of whether the original page layout, functionality, and design is preserved. Reinman Decl., Ex, 2003 ¶ 23. This is true in the '353 Patent as well. The '353 Patent includes a listing (with some omissions for clarity) of the HTML corresponding to web page 210, which is shown as a drawing in Figure 4A, rather than as a display produced by a browser as it would appear on a conventional desktop computer. Ex. 1001, col. 12, ll. 48-54. Figures 7A, 7B, 8A, 8B, 9A, and 9B are representations of nominal and zoomed views on a Palm device. The '353 Patent does not illustrate how these nominal or zoomed views would appear on a conventional desktop. Thus, in the '353 patent, one cannot tell how well the display on the Palm device preserves the original layout, function and design of the HTML-based code as viewed on a conventional desktop.

Patent Owner admits that the claimed "functionality" in the preserving limitation includes clicking on a hyperlink. Tr. 48. In Pad++, an object includes an HTML page composed of many characters, line segments, and images. Ex. 1006, 120. Pad++ discloses reading HTML and following links across the Internet. *Id.* at 89, 105, 161-62, 183. Thus, Bederson discloses preserving HTML functionality, i.e., hyperlinking, associated with a Web page. *Id.*

Patent Owner's argument appears to be that, in Pad++, Bederson does not disclose preserving all the functionality of HTML. Patent Owner's expert, Dr. Reinman, provides a list of HTML features that are not implemented in Pad++. Ex. 2003 ¶ 29. For example, Patent Owner argues that Bederson does not disclose the specific functionality of creating forms. Only two lines in the '353 Patent mention forms as a feature of HTML. Ex. 1001, col. 15, ll. 30-31. Nevertheless, according to Patent Owner, the ability to create forms is of particular importance to e-commerce, and is not disclosed in Bederson. PO Resp. 24, Reinman Decl. Ex. 2003 ¶ 34. Referring to Figure 5 on page 163 of Exhibit 1006, Patent Owner

states that the Pad++ reproduction of the Yahoo page does not include a search term input box. PO Resp. 25. Patent Owner has not demonstrated that the original Yahoo page included such a search box, but argues that the burden is on the Petitioner to show how the Yahoo page would have appeared on a desktop. According to Patent Owner, in the absence of such a showing, there is no evidence of the original layout, functionality, and design of the Yahoo page in Bederson. Tr. 72. As noted above, however, the '353 Patent provides no evidence that the Palm device screens illustrated in the '353 Patent preserve the layout, functionality, and design of a web page, as viewed on a conventional desktop.

During prosecution of the '353 Patent, Patent Owner argued that in the implementation of a browser, it may be desirable to change user interface behavior based on a current use and/or context. Ex. 1002, 232. Patent Owner states it may be advantageous to implement a context-based, user interface that may result in a different action for the same user inputs, depending on a current use or zoom context. *Id.* Patent Owner uses the example of tapping on a column which may have the effect of zooming on the column or activating a hyperlink in the column, depending upon the browser implementation. Patent Owner states that preserving content functionality only means that the functionality defined by corresponding HTML code is supported, without limiting the particular user interface for how that activation is facilitated. *Id.*

Bederson describes objects in the Pad++ hierarchy, which include user inputs, such as checkboxes, and choice menus. Ex. 1006, 144-45. The standard objects supported by Pad ++ include colored text, graphics, portal and HTML, with standard input widgets (buttons, sliders, etc.) supplied as extensions. *Id.* at 156. Bederson's disclosure of preserving hyperlinking capability demonstrates preserving the functionality of HTML in a zoomed view. Bederson also notes that

tools for interacting with documents, such World Wide Web browsers like Mosaic and Netscape, all predefine interactive widgets within the client and provide hooks so that documents may access those widgets. *Id.* at 179. Thus, Bederson provides user input functionality.

As discussed above, claim 1 requires preserving the original layout, function, and design of the translated portion of the HTML-based Web content. Claim 36 recites rendering the Web page on the mobile, hand-held device display using scalable content, based on retrieving the Web page, which comprises HTML based Web content defining the original page layout, functionality, and design, and processing unspecified HTML-based Web content into scalable content. Claim 36 does not recite processing all of the HTML-based Web content, or any particular HTLM-based Web content that preserves the original layout, functionality, and design, into scalable content. Claim 36 next recites re-rendering the display while preserving the original page layout, functionality, and design of the Web page. Thus, the original layout, functionality and design of the Web page content is preserved to the extent it was displayed on the mobile device, i.e., to the extent that the mobile device processed the HTML. Although neither Zaurus nor Bederson implements each and every feature of HTML, as discussed above, both Zaurus and Bederson disclose preserving the layout, functionality and design of the part of the web page that is translated (claim 1) or processed (claim 36).

The underlying issue is not, as Patent Owner suggests, whether Zaurus and/or Bederson disclose implementing all the features of HTML with zooming on a device with a small screen. The issue is whether, in view of their disclosures, the claims of the ’353 Patent would have been obvious under 35 U.S.C. § 103. Bederson discloses that Pad++ is a primitive browser, but suggests that a zooming version of the Netscape and Mosaic browser could be implemented using the

techniques in Pad++. Ex. 1006, 286. Bederson then provides a screen shot of Pad++ displaying Bederson's home page (an HTML document), *id.* at 287, and a zoomed view focusing on a portion of the document with "hotwords" that provide hyperlinks. *Id*. at 289. The hyperlinks change color when scrolled over (one of several possible ways a browser can display hyperlinks in an HTML document) and can be followed to display the target of the link. *Id.* at 291. This display shows the home page and the linked page side by side. The user can zoom in on the linked page by clicking on it. *Id.* at 293. Bederson's implementation of web page zooming appears to be a proof of concept, rather than a mere suggestion. The fact that Bederson did not implement all, or even many, of the known capabilities of HTML does not alter the fact that Pad++ demonstrates the concept, suggests it could be applied to the Netscape and Mosaic browsers, and states that it was being designed for use on devices with small screens, such as PDAs. Thus, we are persuaded that one of ordinary skill would have been motivated to combine the teachings of these references.

Patent Owner does not provide arguments rebutting Petitioner's challenges to each individual claim. In consideration of the above, we conclude, by a preponderance of the evidence, that claims 1, 33, 36, 43, 58, 59, 66, 118, 138, 139, 149, 183, 252, and 283 would have been obvious over the combination of Zaurus and Pad++.

Patent Owner groups its arguments concerning claim 66, which is the subject of a slightly different challenge, requiring a further combination with SVG, with its arguments concerning claims 1, 33, 36, 43, 58, 59, 118, 138, 139, 149, 183, 252, and 283. Thus, Patent Owner's response to the challenge to claim 66 is based solely on its arguments concerning Zaurus and Pad++. Upon consideration of claim 66, we determine by a preponderance of the evidence, that claim 66 would

have been obvious to one of ordinary skill n the art over the combination of Zaurus, Pad++ and SVG. .

Claims 48, 51, 52, and 317

Claim 48 depends from claim 36, and recites enabling a user to zoom on a column of the web via a user input and rendering the display such that the content of the column is displayed across the display. Claim 51 depends from claim 36, and recites zooming on an image, such that the image is rendered to fit across the screen. Claim 52 depends from claim 51, and recites the user input comprises tapping on the image via the display. In addition to other features, independent claim 317 recites implementing the above features, such that a user is enabled to zoom and pan a view of the Web page, activate a displayed hyperlink while at a given zoom level, zoom in on an image of the Web page by tapping on the image, zoom on a column of the Web page by tapping the column via the display, and zoom out to a previous view of the Web page.

Patent Owner argues that claim 317 is distinguished because it recites enabling the user to zoom in on an image by tapping on the image via the display. PO Resp. 40-41. Patent Owner further argues that claims 48, 51, and 52, are similar in scope, with the further distinction that the column or image can be rendered across the display. *Id.* at 41.

Admitting that zooming was known and is not part of the invention, Tr. 50, Patent Owner argues that the subject matter claimed is "smart zooming" – a way to tap or click on a column and zoom only to that column. The '353 Patent mentions this capability at column 20, lines 58-60. The '353 Patent also mentions selecting an image by tapping on it, Ex. 1001, col. 18, ll. 61-62, or zooming in on a paragraph, *id.* at col. 18, ll. 62-63. In the context of selecting a paragraph, the '353 Patent states that the display may be reformatted to fit the characteristics of

the display, rather than following the original format in the zoom out view. *Id.* at col. 18, ll. 64-67. The '353 Patent does not discuss these features in detail.

Zaurus describes magnifying or reducing the entire display in response to the user activation of the magnify key. Ex. 1004, 641, 644-45. The portion of the screen that a user zooms in on or selects to view, however, is determined by the user activating the horizontal scrolling keys and the vertical scrolling bar with the touch screen. *Id.* at 641. Thus, applying the broadest reasonable construction, Zaurus discloses executing instructions that perform operations that enable a user to zoom on a column (claim 48) or image (claim 51) via a corresponding user input, such that the display is re-rendered with the column or image fitting across the display.

Pad ++ also provides extensive disclosure of zooming user interfaces. *See, e.g.,* Ex. 1006, 117-151. Pad++ discloses that a user can zoom out a little, pan a little, and zoom in, with the result that the user has covered a wide expanse of space. *Id.* at 148. Pad++ discloses that it provides support for zoomable, graphical objects and navigation within a graphical workspace. *Id.* at 88. Pad++ includes a renderer that performs all rendering to the screen, maintaining a stack of transformations, including separate stacks of view transformations and object transformations that specify translations and scale. *Id.* at 144, 148. Pad++ discloses a bounding box (*Id.* at 19) and commands such as "center" and "centerbox" to center and scale items to fill a part of the screen (*Id.* at 24) as well as the ability to specify the width of an item (*Id.* at 4). *See* Decision to Institute, 29-30; Ex. 1030 ¶¶ 132-135. Pad++ also provides for manipulating text items that display a string of characters on the screen in one or more lines. Ex. 1006, 41-42, 77-79.

As discussed above, Pad++ provides bounding boxes containing images and commands that allow the images in the bounding boxes to be expanded so the largest dimension fills the specified amount of the screen. *Id.* at 24, Dec. to Institute, 12-14; Grimes Decl. Ex. 1030 ¶¶ 131-136.

Patent Owner argues that these features of Pad++ are not directed to zooming on a portion of a web page, such as a column or image, but pertain to moving objects as a whole, which in the case of an HTML item would be an entire web page. PO Resp. 43; Reinman Decl. Ex. 2003 ¶¶ 75-76. Patent Owner also argues that Pad++ does not implement HTML tags for columns. PO Resp. 43. Patent Owner further argues that Pad++ lacks these features because Pad++ was designed for navigating across multiple pages, and not for viewing of elements within particular web pages. *Id.* at 43-44.

Bederson discloses an example of using Pad++ to zoom in on a portion of Bederson's home web page (an HTML document) selected by a user. Ex. 1006, 286, 289, 291, 293. Thus, Pad++ discloses zooming on a portion of a web page. The '353 Patent discloses that it is conventional to represent a web page using frames and to render objects in their respective positions. Ex. 1001, col. 7, ll. 44-48, col. 15, ll. 52-58. The '353 Patent also discloses that it is conventional to generate the page layout in conjunction with bounding boxes. *Id.* at col. 16, ll. 21-41. As discussed above, Pad++ also defines and scales objects using bounding boxes. *See* Dec. to Institute, 10-14.

As previously discussed, even if Pad++ does not implement all available HTML tags, such as those defining columns, the selection of which tags to implement is a matter that would be well within the knowledge and abilities of a person of ordinary skill in the art and would be obvious under 35 U.S.C. § 103.

Finally, we are not persuaded by arguments that the references do not disclose tapping on a screen to designate material to be zoomed. As discussed above, Zaurus discloses a touch screen to navigate an HTML document. Bederson states that Pad++ could be designed for use on handheld devices with small screens and the expedient of tapping the screen corresponds to clicking with a mouse on a large screen device. Grimes Decl., Ex. 1030 ¶¶128-130 (citing Bederson Deposition Testimony, Ex. 1032, 77-79).

In view of the evidence, we are persuaded that dependent claims 48, 51 and 52 would have been obvious over the combination of Zaurus and Pad++. As discussed above, independent claim 317 recites zooming features similar to those in claims 48, 51 and 52. As discussed above, Pad++ discloses a zooming interface applicable to images, as well as other objects, such as columns. We are persuaded that a person of ordinary skill in the art could choose to implement some or all of these features in a single apparatus, such as that recited in claim 317. Thus, we determine, by a preponderance of the evidence, that claims 48, 51, 52, and 317 would have been obvious over the combination of Zaurus and Pad++.

Obviousness Over Zaurus, Hara, Tsutsumitake and SVG

Claims 1, 33, 36, 43, 58, 59, 66, 118, 138, 139, 149, 183, 252, and 283

As previously discussed, Zaurus discloses a mobile touch-screen device, with a limited HTML browser, on which a web page can be displayed, magnified and scrolled to view portions of the web page. *See* Zaurus PDA, *supra.* Hara discloses a client device receiving an HTML document from a server, analyzing the HTML to determine whether image tags indicate there is image data to be displayed and processing the images for display and magnification depending upon the resolution of the client device. Ex. 1008 ¶¶ 0011-14, ¶¶ 0058-62. In describing the display of WWW clickable data, *id.* at ¶ 0043, Hara discloses using

(x,y) coordinates, vectors from an origin to the x-y coordinates, and tables for shifting the display based on the magnification. *Id*. at ¶¶ 0063-68.

Tsutsumitake discloses a device that receives and stores a document in an external format, such as HTML, and converts the document to an internal format suitable for display on a screen of the device, e.g., using information blocks, such that a tag, an X coordinate, and a Y coordinate to indicate the type of information (e.g., text, image) and the display position of each block. Ex. 1005 ¶¶ 0010, 0025-27, Figs. 2-5. When a document is to be displayed, the current scroll position is determined, the document state information is retrieved and the current scroll position is subtracted from the y coordinate value in the stored internal format, and the cursor is moved to display the document. *Id.* ¶¶ 0035-38, Fig. 6.

The parties agree that Hara discloses resizing images on a web page. PO Resp. 45, Pet. Reply 10. As we previously noted, during the oral hearing Patent Owner admitted that zooming was known in the art and is not part of the invention. Tr. 50. Thus, we agree with Petitioner's expert that Hara's disclosure of adapting the display to the resolution of the target device motivates the combination of Zaurus and Hara to provide zooming on the target device. Ex. 1030 ¶¶ 136-43.

Patent Owner argues that Tsutsumitake is cumulative of Hara because it is cited as a reference that discloses translating HTML to x-y coordinate information. PO Resp. 47. Patent Owner contends that Hara's disclosure of image resizing does not disclose resizing text and that Hara discloses moving objects to avoid overlapping them after conversion. PO Resp. 45. Therefore, Patent Owner argues that Hara does not preserve the original layout, functionality, and design of the web page. However, as previously discussed, the claims recite that the original layout, functionality and design is defined by the HTML content. Ex. 1001, claims 30, 52. *See also,* Claim Construction, *supra.*

Tsutsumitake discloses preserving the original layout, functionality, and design of the document (web page), because it analyzes the syntax of the external format, converts the external format (HTML) into an internal format, and uses tags, X and Y coordinates, and scroll position, to generate the display. Ex. 1005 ¶¶ 0025-29, Fig. 3. We are persuaded that extending Hara's disclosure of resizing an object tagged as an image to objects with other HTML tags is a routine matter that produces predictable results.[10] Therefore, we conclude that claims 1 and 36, which are not limited to a vector based representation, and dependent claims 33 and 43 which recites that the scalable content is vector based, would have been obvious to a person of ordinary skill in the art over the combination of Zaurus, Hara, Tsutsumitake. Patent Owner does not argue the remaining claims separately. Thus, we conclude that claims 1, 33, 36, 43, 58, 59, 118, 138, 139, 149, 183, 252, and 283.

Claim 66, which is challenged on the basis of the combination of Zaurus, Hara, Tsutsumitake, and SVG is not discussed separately. Therefore, Patent Owner rebuts this challenge based solely on its arguments concerning Zaurus, Hara, and Tsutsumitake. Upon consideration of Patent Owner's arguments, we conclude that claim 66 would have been obvious to one of ordinary skill in the art over the combination of Zaurus, Hara, Tsutsumitake, and SVG.

Claims 48, 51, 52, and, 317

Patent Owner argues the subject matter of the invention is not zooming, but instead is "smart zooming" – a way to tap or click on a column and zoom just to that column. Tr. 50-51. Dependent claims 31 and 55 recite zooming on a user

[10] In our earlier discussion of claims, we noted that, in the context of selecting a paragraph, the '353 Patent states that the display may be reformatted to fit the characteristics of the device, rather than following the original format in the zoom out view. Ex. 1001, col. 18, ll. 64-67.

selectable portion of the display, but do not require that the user to select the portion of the display before the zooming operation. Thus, as previously discussed, these features are disclosed in Zaurus, which discloses magnifying an entire display and allowing the user to scroll to the desired subject matter.

Claims 48 and 51 recite executing instructions that allow a user to view a column (claim 48) or image (claim 51) at a higher resolution by tapping a touch sensitive display and re-rendering the display such that the content corresponding to the column or image is shown across the display. Claim 52 depends from claim 51 and recites that the user input comprises tapping on the image via the display. In addition to other features, claim 317 recites implementing the above features such that a user is enabled to zoom and pan a view of the web page, activate a displayed hyperlink while at a given zoom level, zoom in on an image of the web page by tapping on the image, zoom on a column of the web page by tapping the column via the display and zoom out to a previous view of the web page.

The ’353 Patent discloses that it is conventional in HTML to group content that should appear together into logical groupings. Ex. 1001, col. 16, ll. 19-38. As discussed above, Tsutsumitake discloses converting a document from an external format into an internal coordinate format to produce X-Y coordinates that define a vector. Tsutsumitake specifically identifies HTML as one such external format. Ex. 1005 ¶ 0026. Thus, Tsutsumitake discloses grouping content in the same manner as it is grouped in a web page defined by HTML, whether such tags indicate the presence of an image, a column, or some other display characteristic. As discussed above Hara discloses resizing objects, specifically images, identified by HTML tags. In Hara, the images can be resized to match the width or height of the display screen or a user specified size. Ex. 1008 ¶¶ 0047-48. As previously discussed, Zaurus discloses navigating a web page with a touch screen. Thus, we

conclude the features recited in claims 48, 51, 52 and 317 would have been obvious to one of ordinary skill in the art in view of the combination of Zaurus, Hara, and Tsutsumitake.

Objective Indicia of Non-obviousness

Objective criteria constitute independent evidence of non-obviousness. *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1378 (Fed. Cir. 2013). However, as discussed below, the objective indicia argued in the Patent Owner Response, PO Resp. 51-59, do not establish a nexus with the claimed subject matter.

Citing *Power-One v. Artesyn Techs., Inc.*, 599 F.3d 1343, 1352 (Fed. Cir. 2010) and *Gambro Lunda AB v.Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 (Fed. Cir. 1997) Patent Owner argues that praise by others, particularly a competitor, is evidence of non-obviousness. PO Resp. 51. However, the CIO Magazine 2001 Venture OnStage recognition award cited by Patent Owner, *id.* at 52, is not praise by a competitor and states that it was based on the CEO's presentation of the company's technology and vision. Ex. 2010. Patent Owner has not demonstrated a specific nexus between that award and the claimed subject matter.

Similarly, Patent Owner's arguments concerning the success of the Apple devices, such as the iPhone, do not establish the requisite nexus. Petitioner contends that Patent Owner has not shown it ever sold a commercially successful product, Pet. Reply 11. Patent Owner's objective indicia arguments are predicated on the assumption that the iPhone and Android products implement the features of the subject claims. Patent Owner contends that high praise and commercial success of iPhone and Android products can be mapped to the functionality of claims 1 and 30 of the '353 Patent. PO Resp. 51, Exs. 2034-35.

Where the patent is said to cover a feature or component of a product, the patent owner has the burden of showing that the commercial success derives from the feature, in this case the Internet browser in a handheld device. *Tokai Corp., v. Easton Enters. Inc,* 632 F. 3d 1358, 1369 (Fed. Cir. 2011). Where that feature is found in the product of another there must be proof that the feature falls within the claims. *E.g., Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988) (infringer's counsel stated at trial that the patent had been copied); *Hughes Tool Co. v. Dresser Indus., Inc*., 816 F.2d 1549, 1552 (Fed. Cir. 1987) (patented O-ring seal copied by defendant). In order to establish a proper nexus, the patent owner must offer proof that the sales were a direct result of the unique characteristics of the claimed invention – as opposed to other economic and commercial factors unrelated to the quality of the patented subject matter. *Microsoft v. Proxyconn, Inc,*. IPR2012-00026, slip op. at 4 (PTAB Mar. 8, 2013) (Paper32). We have considered Patent Owner's Exhibits 2034 and Ex. 2035, which purport to show that the iPhone and Android devices include the features of claims 1 and 317. However, Patent Owner has not shown that the sales of the iPhone and Android devices are a result of the claimed invention.

Although Patent Owner cites comments lauding the Internet browsing capabilities of the iPhone and Android devices, including a statement made in the Wall Street Journal that the iPhone's game changing feature is its Safari browser, PO Resp. 54, Ex. 2022, the iPhone's implementation of the Safari browser was just one of its many features. Patent Owner does not address the numerous other features cited as important to the iPhone device, including its use as a phone, Apple's representation that the iPhone is "the best iPod [media player] we ever made," and its e-mail capability. Ex. 2011, 4. Patent Owner also has not established that the subject matter of the '353 claims, rather than Apple's extensive

distribution network and marketing presence are the reason the iPhone and similar devices have been a success. The same is true of Android based devices. In contrast to the Declaration of Dr. Reinman, a computer science expert with knowledge of computer technologies, Petitioner's expert Dr. Lutz, an expert on marketing and consumer behavior, states that the success of such devices can be attributed to numerous factors, including product, promotion, price and place and that the web browser in the iPhone was just one of the several important features contributing to its success. Ex. 1049 ¶¶ 11-12, 41-55. Thus, the objective indicia cited by the Patent Owner do not overcome the case of obviousness established by Petitioner by a preponderance of the evidence.

MOTION TO EXCLUDE

A motion to exclude is required to preserve an objection to the admissibility of evidence. 37 C.F.R. § 42.64(c). Patent Owner has moved to exclude the following: (i) Grimes Declaration (Ex. 1030) on the basis that it improperly addresses new prior art references, advances claim construction positions and belatedly comments further on Zaurus, Mot. to Exclude 2-9; (ii) Bederson Deposition Transcript (Ex. 1032) on the basis that it is not prior art or expert testimony, *Id.* at 9; (iii) new prior art references (Exs. 1037-1041) on the basis that they were submitted belatedly and constitute new challenges to patentability, *Id.* at 9-11; (iv) new invalidity claim charts which (Ex. 1043 -1044) as an attempt to belatedly inject new invalidity arguments into the proceeding, *Id.* 11-12; (v) the entirety of Petitioner's Reply on the basis that it relies on improper evidence, *Id.* 12-13; (vi) transcripts of experts Gary Rohrbach and Robert Alan Burnett (Ex. 1047-1048) as irrelevant to any issue in the proceeding, *Id.* at 13; (vii) Grimes Supplemental Declaration (Ex. 1052) as not correcting evidence, but advancing new invalidity theories and belated opinions of Zaurus, obviousness and claim

construction, *id.* at 13-15; and (viii) Lutz Declaration (Exhibit 1053) as supplemental evidence rather than a correction in the form of supplemental evidence, *id.* at 15.

A motion to exclude is neither a substantive sur-reply, nor a proper vehicle for arguing whether a reply or supporting evidence is of appropriate scope. *Zynga Inc. v. Personalized Media Commc'ns, LLC*, IPR2013-00162, slip op. at 3 (PTAB Aug. 28, 2013) (Paper 16), *Berk-Tek LLC v. Belden Tech., Inc.*, IPR2013-00057, slip op. at 3 (PTAB Oct. 31, 2013) (Paper 39). In this case, the Patent Owner reply raised several substantive issues that were not raised in the Petition. These included the proper construction of the preserving limitation and non-obviousness based on objective criteria of commercial success, both of which we have discussed extensively.

A petitioner reply to a patent owner response may address only issues raised in the corresponding opposition. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012). Petitioner was entitled to rebut Patent Owner's arguments concerning the construction of the preserving limitation and the objective criteria of non-obviousness. We agree with Petitioner that Dr. Grimes' Declaration (Ex. 1030) was drawn to issues raised in Patent Owner Response that Petitioner could not have addressed in the Petition. Petitioner's Opposition to Motion to Exclude, Paper 42, (Opp. To Motion to Exclude), 3. In addition, the Board provided the parties an opportunity for additional claim construction briefing. Thus, the parties were afforded an additional opportunity to respond to each other concerning the construction of the preserving limitation.

Dr. Grimes' Declaration (Ex. 1030) and Petitioner's Reply cite additional exhibits which, as noted above, are the subject of Patent Owner's Motion to Exclude. Dr. Grimes' citation to the Bederson deposition transcript specifically

addresses Patent Owner's contentions concerning zooming and a touchscreen and is consistent with Ex. 1006 in the Petition. Ex. 1030 ¶¶ 128, 131; Ex. 1032, 77-79. The additional references noted by Dr. Grimes (Exs. 1037 - 1041) were not presented as new challenges to the claims, but to support that tapping a touch screen was well known in the art. Ex. 1030 ¶ 129. We recognize the possibility that, in some circumstances, expert testimony concerning references other than those cited in the Petition can operate effectively as new challenges to the claims. However, in this case, the references are not applied specifically to the claims and the grounds on which the Board instituted review did not change.

Exhibit 1044[11] is a modified version of Patent Owner's Exhibits 2034 and 2035, which attempts to map claims 1 and 317to Apple and Android devices. Patent Owner's expert Dr. Reinman cited Exhibits 2034 and 2035, each of which resembles an infringement chart, as evidence of the praise and commercial success of Android devices incorporating the claims of the '353 Patent. Reinman Decl., Ex. 2003 ¶ 100. Petitioner was entitled to respond to the assertions made in conjunction with Patent Owner's Exhibits 2034 and 2035. Petitioner responded by adding a third column to the charts to show that the success of the Android devices was not the result of the claimed subject matter, because the claimed subject matter was disclosed in the prior art. Petitioner's response did not propose new challenges to the claims, but was merely responsive to the chart submitted by Patent Owner. We also find no basis for excluding Exhibits 1047 and 1048, which are citations from transcripts of testimony in the co-pending litigation establishing that Patent Owner began investigating possible infringement by Apple at the time Steve Jobs announced the iPhone.

[11] Patent Owner also objects to Ex. 1044, which concerns IPR2013-00004/IPR2013-000257 and similarly relates the challenged claims of '926 Patent to Apple and Android products and to prior art.

Petitioner submitted Exhibits 1052 and 1053 in response to objections from Patent Owner. Much of Dr. Grimes' Declaration in Exhibit 1052 refers to his earlier Declaration and attempts to address issues raised by Patent Owner. We are not persuaded that Exhibit 1052 proposes new invalidity theories, as Patent Owner contends. Exhibit 1053 by Dr. Lutz is responsive to Patent Owner's objections that Dr. Lutz's previous Declaration was not supported by sufficient facts and data. Exhibit 1053 points out references he relied upon in his earlier declaration and confirms his opinion. It does not provide supplemental evidence.

In consideration of the above, we deny Patent Owner's Motion to Exclude in its entirety.

CONCLUSION

This is a final written decision of the Board under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. We hold all of the challenged claims, i.e., claims 1, 33, 36, 43, 48, 51, 52, 58, 59, 66, 118, 138, 139, 149, 183, 252, 283, and 317 of the '353 Patent, are unpatentable under 35 U.S.C. §103(a). Specifically, the preponderance of the evidence shows that claims 1, 33, 36, 43, 48, 51, 52, 58, 59, 118, 138, 139, 149, 183, 252, 283, and 317 of the '353 Patent are unpatentable as obvious over the combination of Zaurus and Pad++. We further hold that the preponderance of the evidence shows that claim 66 of the '353 Patent is unpatentable over Zaurus, Pad++, and SVG.

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

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1, 33, 36, 43, 48, 51, 52, 58, 59, 66, 118, 138, 139, 149, 183, 252, 283, and 317 of the '353 Patent are held unpatentable;

FURTHER ORDRED that Patent Owner's Motion to Exclude is DENIED; and

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

PETITIONER KYOCERA: (via electronic transmission)
Richard P. Bauer (richard.bauer@kattenlaw.com)
Michael Tomsa (michael.tomsa@kattenlaw.com)
Eric C. Cohen (eric.cohen@kattenlaw.com)

PETITIONER MOTOROLA MOBILITY LLC
John C. Alemanni (jalemanni@kilpatricktownsend.com)
Candice C. Decaire (CDecaire@kilpatricktownsend.com)
David A. Reed (DaReed@kilpatricktownsend.com)

PATENT OWNER: (via electronic transmission)
Ben Yorks (byorks@irell.com)
Babak Redjaian (bredjaian@irell.com)