UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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KYOCERA CORPORATION
MOTOROLA MOBILITY LLC
Petitioner

v.

SOFTVIEW LLC
Patent Owner
_____

Case IPR2013-00004
Case IPR2013-00257
Patent 7,831,926 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 12, the Board entered a Decision to Institute an *inter partes* review on the following challenges raised by Kyocera Corporation to the patentability of claims 30, 31, 40, 41, 43, 52, 55, 59, 72, and 75 (Challenged Claims) of U.S. Patent No. 7,831,926 B2 (the '926 Patent) owned by Softview LLC ("Patent Owner"):

Challenged Claims as obvious under 35 U.S.C. § 103 over the combination of Zaurus[1], Pad++[2], and SVF[3]; and

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[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] Specification for the Simple Vector Format v. 1.1, Jan. 16, 1995; New CAD System Works With AutoCAD Drawings Without Translation," June 17, 1996, retrieved from:
http://web.archive.org/webI19961019052917/http://soft:source.cominet
PX 1009 news.html ; "Bring New CAD Viewing Power to the Internet," Mar. 4, 1996, retrieved
from:http://web.archive.org/webI19961019052917/http://softsource.cominet
news.html, (collectively, "SVF"), Ex. 1009

Challenged Claims as obvious under 35 U.S.C. § 103 over the combination

of Zaurus, Hara[4], Tsutsumitake[5], and SVG[6].

IPR2013-00257, brought by Motorola Mobility LLC, raised the same

challenges and later was joined to this proceeding. IPR2013-00257, Paper 10.

Kyocera Corporation and Motorola Mobility are referred to collectively as

"Petitioner."

On July 19, 2013, Patent Owner filed a Patent Owner's Response. ("PO

Resp.," Paper 25). On September 23, 2013, Petitioner filed a Consolidated Reply

to Patent Owner's Response. ("Petitioner's Reply," Paper 28). On November 22,

2013, Patent Owner filed a Motion to Exclude. ("Mot. to Exclude," Paper 42). An

oral hearing was held on January 7, 2014, concurrent with the oral hearing in

related consolidated proceeding, IPR2013-00007/IPR2013-00256, 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 claims 30, 31, 40, 41, 43, 52, 55, 59, 72, and 75 are unpatentable

under 35 U.S.C. § 103 over Zaurus, Pad++, and SVF. Patent Owner's Motion to

Exclude is denied.

THE '926 PATENT (EXHIBIT 1001)

As indicated by its title, the '926 Patent is drawn to the scalable display of

Internet content, e.g., Hypertext Markup Language (HTML)-based content,

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[4] Japanese Unexamined Patent Application Publication H10-326169 ("Hara"),
Ex. 1008
[5] Japanese Laid Open Patent Application H10-21224 ("Tsutsumitake"), Ex. 1005
[6] Ferraiolo, Jon, Scalable Vector Graphics Requirements: W3C Working Group
Draft, Oct. 29, 1998. ("SVG"), Ex. 1007

cascade style sheets (CSS), and Extensible Markup Language (XML) on mobile devices, by enabling the content to be rendered, zoomed, and panned for better viewing on small screens and standard monitors. Ex. 1001, col. 2, ll. 32-43, col. 5. ll. 11-15. Patent Owner's expert describes the '926 Patent and related patent, U.S. Patent No. 7,461,353 ("the '353 Patent"),[7] as "being 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. 4:35-45." Declaration of Glenn Reinman (Reinman Decl.), Ex. 2003 ¶ 9. According to the '926 Patent, a client side viewer receiving Internet content has an Internet browser and uses the simple vector format (SVF) originally designed to handle common computer-aided design (CAD) file formats to describe the current web content. Ex. 1001, col. 4, ll. 35-49. 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).

The '926 Patent describes the logic used by the invention when translating content into a scalable vector representation. *Id.* at col. 3, ll. 40-42, Fig. 5. 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

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[7] The '353 patent is the subject of co-pending IPR2013-00007.

page layout is built using bounding boxes produced for each object. *Id.* at col. 16, ll. 19-38, col. 17, ll. 15-29. The '926 Patent acknowledges that the above steps commonly are performed by conventional browsers in the pre-rendering process, but indicates that the disclosed use of layout data generated in the pre-rendering process to generate a scalable vector representation of the original page content departs from the prior art. *Id.* at col. 17, ll. 30-45.

The '926 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 then is 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 from the frame datum to each object in the frame. *Id.* at col. 18, ll. 5-16. The scalable vector representation is then 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 computer aided design (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 by (i) 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' bounding boxes relative to the fixed frame. *Id.*

at col. 19, ll. 39-57. Using the latter approach, respective offsets in X and Y (-ΔX and -ΔY) 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

Independent claims 30 and 52, which are illustrative, are shown below:

30. A mobile phone, comprising:
a processor,
wireless communications means operatively coupled to the processor, to facilitate communication with a mobile service provider 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 by the processor enable the mobile phone to perform operations including,
rendering a browser interface via which a user is enabled to request to access to a Web page having an original format comprising HTML-based content defining an original page layout, functionality, and design of content on the Web page;
retrieving HTML-based content associated with the Web page;
translating at least a portion of the HTML-based content from its original format to produce translated content including scalable vector-based

content that supports a scalable resolution-independent representation of the HTML-based content that preserves an original page layout, functionality and design of the at least a portion of the HTML-based content when scaled and rendered; and

employing the scalable vector-based content to render a view of at least a portion of the Web page on the display using a first scale factor,

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

52. 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.

CLAIM CONSTRUCTION

As discussed in 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. 10-389-LPS (D. Del.). Dec. to

Institute (Paper 12), 19-20. A dispute concerning the meaning of another term, i.e.,

"preserve[s] an original page layout, functionality and design," emerged after the

Patent Owner Response argued that this claim feature recites a major distinction

over the art cited in Petitioner's challenges. PO Resp. (Paper 25) 2. In claim

construction briefing authorized by the Board, Patent Owner argues that the

original page layout, functionality, and design that must be preserved means "as

viewed on a conventional desktop browser." *See*, Patent Owner's Supplement

Claim Construction Brief. Paper 38. Petitioner argues that "what is being

preserved is the layout of the webpage after it has been processed by the browser."

See, Petitioner's Supplement Claim Construction Brief. Paper 37. Petitioner's

proposed construction is consistent with statements made by Patent Owner during

prosecution of the related '353 Patent, which is the subject of IPR2013-00007,

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.

IPR2013-00007, Ex. 1002, 233. In a footnote, Patent Owner noted that differences

in page interpretation will be generally a function of the browser's rendering

engine (*a.k.a.* layout engine). *Id.*

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, *see*, IPR2013-00007, Ex. 1002, 229-31,[8] but during the final hearing, argued that preserving the look and feel of the website 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 a web page would understand that that was the same web page as the one that they were using in connection with a desktop computer." Tr. 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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[8] The '353 and '926 Patents have the same specification. During prosecution of the '353 Patent, Patent Owner noted that,

> "Even 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. . . . However, 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.

IPR2013-00007, Ex. 1002, 231.

We begin our claim construction analysis with the language of the claims. The "preserving limitation" in claim 30 recites:

> a scalable resolution-independent representation of the HTML-based content that *preserves an original page layout, functionality and design of the at least a portion of the HTML-based content* when scaled and rendered (Emphasis added)

As an antecedent to the disputed "preserving limitation," claim 30 recites that the claimed mobile phone can render a browser interface that enables a user to request access to a "web page having an original format comprising HTML-based content defining an original page layout, functionality and design of content on the Web page." Ex. 1001, claim 30. Claim 30 next recites "translating <u>at least a portion of the HTML-based content</u>" from its original format into "translated content including scalable vector-based content that supports a scalable resolution-independent representation of the HTML-based content that preserves an original page layout, functionality and design of <u>the at least a portion of the HTML-based content</u> when scaled and rendered." *Id.* (emphasis added). Thus, claim 30 does not recite preserving the entire or layout, functionality, and design, but only that original layout, functionality, and design that corresponds to the translated portion of the HTML-based content.

The "portion of the HTML-based content" in claim 30 corresponds to the disclosure relating to Figure 6, in which the HTML retrieved corresponds to objects whose bounding boxes at least partially fall within the display bounding box. However, claim 30 is not limited to the embodiment illustrated in the specification. Claim 30 recites only a representation that preserves an original page layout, functionality and design when scaled and rendered of <u>the at least a</u>

portion of the HTML-based content. Claim 30 cannot be interpreted to preserve a particular conventional desktop layout because claim 30 does not recite what portion of the HTML-based content that defines the conventional desktop layout is scaled and rendered. Construing the claim broadly, but reasonably, 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.[9] 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 52 recites:

> employing the scalable content…to render a view of the
> Web page on the touch sensitive display and re-render
> the Web page…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.

Thus, claim 52 recites two renderings. The first rendering of a view of the Web page is not limited to one that preserves the original page layout, function, and design. The re-rendering or scaled view preserves the original layout, function, and design defined by the HTML content as interpreted by a rendering engine, such as one in the client device. Ex. 1001, col. 5 -6. Claim 52 does not recite that the rendering engine renders a layout, function, and design that conforms to one as viewed on a conventional desktop, or rendered by a conventional desktop browser.

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

As previously discussed, the '926 Patent describes the relationships between a web page and HTML. Ex. 1001, col. 7.ll. 27-60. In HTML, tags define the layout and display information for a web page, including tables, paragraph boundaries, graphic image positions and bounding box sizes, type face styles, sizes, and colors, borders, and other presentation attributes. *Id.* at col. 7, ll. 47-52, col. 15, ll.19-32. A pre-rendering parsing of the HTML document is performed to determine where to place various objects on the display page. *Id.* at col. 15, ll. 48-50. Some objects, such as plain text, are rendered immediately, while other objects, such as graphic images must be retrieved before being fully rendered. *Id.* at col. 15, ll. 57-60. A web page may have all its information in a single frame, or may contain multiple frames as shown in Figure 4, which has adjacent frames 212 and 214. *Id.* at col. 7, ll. 33-37, col.12, ll. 21-22. When multiple frames are present, they are processed sequentially, and objects are rendered in their respective positions. *Id.* at col. 15, ll. 52-58. As the primary HTML is parsed, content that should logically appear together, for example within a substantially rectangular outline, is grouped into objects, while other content, such as headlines, user interface objects, and graphic layout objects are identified, so that a page layout is built by defining a bounding box for each object. *Id.* at col 8, ll. 19-39, col. 16. ll. 19-38. The page layout is generated in conjunction with defining the bounding boxes, so that the location of an object is based on the location of other related and non-related objects. *Id.* at col. 16, ll. 19 - col. 17, l. 4. -.

The '926 Patent describes all of the above functions as commonly performed by conventional browsers during a pre-rendering process, and at least in the case of the Mozilla browser, by the Mozilla rendering engine. *Id.* at col. 17, ll. 31-41.

Claim 30 recites preserving the original layout, function, and design of the at least a portion of the HTML-based content (which defines the original layout,

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function, and design). Claim 52 recites preserving the original function, layout,
and design defined by the HTML-based content in the re-rendering as interpreted
by the browser's rendering engine. In both cases, the preservation of the original
layout, function, and design turns on what elements of the HTML are translated to
be interpreted by the browser, rather than the how that HTML is viewed on a
desktop. Therefore, 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.

Our construction is consistent with the claims and the objectives of the
invention, as described in the '926 Patent specification. Both claims 30 and 52
recite that an original layout, function, and design of a web page is defined by
HTML-based content. There is no dispute with the statement in the '926 Patent
that HTML is a standardized language that describes the layout of content on a
web page and attributes of the content. Ex. 1001, col. 7, ll. 45-60. Our
construction of preserving capabilities and appearances consistent with the
translated portion of the HTML is consistent with the limitation in claim 30 that
concerns "the at least a portion of the HTML-based content" and the limitation in
claim 52 that recites, "as interpreted by the browser." The Background of the
Invention notes that fixed resolution Web pages used for displaying Internet
content designed for desktop computers present a technical problem for displaying
Internet content on small screens in hand held devices. *Id.* at col. 2, ll. 14-28. The
Summary of the Invention states that the claimed mobile devices employ novel
processing of original Web content, including HTML-based content, to generate
scalable content, which is then employed to enable the Web content to be rapidly
rendered, zoomed, and panned. *Id.* at col 2, ll. 32-41. The specification is silent on

how closely the rendered content should match the web page as viewed on a
conventional desktop.

ANALYSIS OF PETITIONER'S PRIOR ART CHALLENGES

Obviousness over Zaurus, Pad++, and SVF

Claims 30 and 52

A patent 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

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 '926 Patent describes,
as conventional, the use of HTML to specify the layout, design, and function of a
web page. The '926 Patent also describes the zoom and pan capabilities of 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, ll. 49-65. Patent Owner's expert
states that the invention claimed in 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. 4:35-45." Reinman Decl., Ex. 2003 ¶ 9. Although
Patent Owner disputes whether the evidence supports a combination of Bederson's
description of Pad++ with Zaurus, with or without SVF, there appears to be little
dispute that Bederson discloses vectorized content. PO Resp. 34.

In view of Patent Owner's arguments our analysis of claims 30 and 52 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 is 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, Paper 12, 22. Zaurus includes a processor to render a browser (with limitations), 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 '926 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.

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." IPR2013-00007, 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.[10]

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. *Id.* at 644. Zaurus further discloses
compatibility with client side clickable maps, so that by clicking inside a displayed
map, one can jump to the page that corresponds to that portion. *Id.* at 638. Thus,
Zaurus discloses a system that maintains the primary features of the 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 at least a portion of the HTML-based content (claim 30) and as
rendered by its rendering engine (claim 52).

During the oral hearing, Patent Owner argued that under its proposed
construction, which we do not adopt, the "preserving limitation" in the claims

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[10] The '926 Patent defines an HTML document as any document that contains web
page content other than <u>only</u> graphic content. Ex. 1001, col. 7, ll. 57-60. This
would include documents with graphics and other content, 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. Tr. 64-67.

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, the display is different from instances where the home page is displayed by using a PC, for example, by not displaying 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 discloses a browser, referred to as Pad++ that "allows Web pages to remain visible at varying scales while they are not being specifically visited, so the viewer can 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. 29-33.

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 '926 Patent
as well. The '926 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. 44-49. Figures 7A, 7B, 8A,
8B and 9A and 9B are representations of nominal and zoomed views on a Palm
device. The '926 Patent does not illustrate how these nominal or zoomed views
would appear on a conventional desktop. Thus, in the '926 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, 161-2, 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 '926 Patent
mention forms as a feature of HTML. Ex. 1001, col. 15, ll. 29-30. 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 of 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. 24-25. 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 the Yahoo page as it 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 '926 Patent provides no evidence that the
Palm device screens illustrated in the '926 Patent preserve the layout, functionality,
and design of a web page as viewed on a conventional desktop.

During prosecution of the related '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. IPR2013-00007, 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 a 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 30 requires preserving the original layout, function, and design of the at least a portion of the HTML based content," i.e., the translated portion. Claim 52 recites re-rending a Web page while preserving an original page layout functionality and design as defined by the HTML-based Web content, as interpreted by a rendering engine. 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 30) or interpreted by the rendering engine (claim 52).

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 '926 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), Ex. 1006, 287, and a zoomed view focusing on a portion of the document with "hotwords" that provide hyperlinks. Ex. 1006, 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 be motivated to combine the teachings of these references.

Finally, there appears to be no dispute that, as discussed in our Decision to Institute, Bederson discloses vector scaling, in a manner similar to SVF. Patent Owner argues only that SVF does not cure the deficiencies of the combination of Zaurus and Pad++. PO Resp. 40.

In consideration of the above, we are persuaded that claims 30 and 52 would have been obvious over the combination of Zaurus, Bederson, and SVF.

Claims 31, 40, 41, 43, 55, 59, 72, and 75

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 just to that column. The '926 Patent mentions this capability at column 20, lines 58-60. The '926 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 '926 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. These features are recited in, among others, dependent claims 31, 40, and 41.

Claim 31 recites the further limitation on claim 30 that execution of the instructions performs operations allowing the user to zoom on a user selectable

portion of a display using a touch sensitive display. Like claim 31, claim 55, which depends from claim 52, adds the further limitation that executing the instructions enables the user to zoom in on a user selectable portion of the display in response to a user input via the touch sensitive display. Patent Owner argues that, although it is a touch sensitive device, the reduce and magnify capabilities of Zaurus do not allow the user to select the portion of the display on which to zoom in. PO Resp. 42. Claims 31 and 55 do not require that the user select a portion of the display before the zooming operation, only that operations allow the user to zoom in on a user selectable portion of the display. Zaurus describes magnifying or reducing the entire display in response to the user activation of the magnify key. The portion of the screen on which a user zooms in or selects to view, however, is determined by the user activating the horizontal scrolling keys and the vertical scrolling bar with the touch screen. Thus, applying the broadest reasonable construction, Zaurus discloses executing instructions that perform operations that allow the user to select a portion of the display using a touch sensitive display. We conclude, based on a preponderance of the evidence that claims 31 and 55 would have been obvious to one of ordinary skill in the art based on the combination of Zaurus, Pad++ and SVF.

Claim 40 recites that execution of the operational instructions allows the user to view a column of web content at a higher resolution than the current resolution by tapping the column via the touch sensitive display, and re-rendering the display, such that the content corresponding to the selected column is displayed to fit across the touch sensitive display. We previously noted that Zaurus discloses selecting content with a touch sensitive display. 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

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specify translations and scale. Ex. 1006, 144, 148. Pad++ discloses a bounding

box (Ref Guide, 17, (Ex. 1006, 19)) and commands such as "center" and

"centerbox" to center and scale items to fill a part of the screen (Ex. 1006, 24) as

well as the ability to specify the width of an item (Ex. 1006, 4). *See,* Decision To

Institute, Paper 12, 29-30. 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. SVF discloses that width can be specified with text and that the text will be

scaled to fit the width. Ex. 1009, 6, 19.

Claim 41 recites that the web content contains at least one image and that

execution of the instructions performs further operations enabling a user to view an

image at higher resolution by tapping on the image, such that the display is re-

rendered for the image to fit across at least one of a width and height of a display

area of the touch sensitive display. 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. Ex. 1006, 24.

Addressing claim 40[11] Patent Owner argues that these features of Pad++ are

not 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. ¶¶ 75-76. Patent Owner also argues that

Pad++ does not implement HTML tags for columns. *Id.* 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. PO Resp. 43-44. As previously discussed, Bederson disclosed an example

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[11] Patent Owner appears to apply the same arguments to claim 41, although claim
41 is not specifically argued.

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, Bederson discloses zooming on a portion of a web page. The '926 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. 33-37, col. 15, ll. 52-58. The '926 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, Bederson also defines and scales objects using bounding boxes. *See* Decision to Institute, Paper 12, 8-12.

As previously discussed, even if Bederson did not implement all available HTML tags, 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. Zaurus disclosed a touch screen to navigate 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.

In view of the evidence, we are persuaded that, based on a preponderance of the evidence, dependent claims 40 and 41 would have been obvious over the combination of Zaurus, Pad++, and SVF. Neither Patent Owner nor Petitioner presents additional arguments concerning claims 43, 59, 72, and 75. We addressed these claims in our Decision To Institute. Paper 12, 31-41. Based on our review of the evidence, we determine that Petitioner has shown by a preponderance of the evidence that claims 43, 59, 72, and 75 also would have been obvious over the combination of Zaurus, Pad++ and SVF.

Obviousness Over Zaurus, Hara, Tsutsumitake and SVG

Claims 30 and 52

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 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, claims 30 and 52 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.[12] SVG also discloses that all objects and

attributes (including text and line widths) should grow/shrink uniformly with zoom

level. Ex. 1007 ¶ 28. Therefore, we conclude, based on a preponderance of the

evidence, that claims 30 and 52 would have been obvious to a person of ordinary

skill in the art over the combination of Zaurus, Hara, Tsutsumitake, and SVG.

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[12] In our earlier discussion of claim 31, 40, 41, 43, 55, 59, 72, and 75, we noted
that, in the context of selecting a paragraph, the '926 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.

Claims 31, 40, 41, 43, 55, 59, 72, and 75

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 selectable portion of the display, but do not require that the user 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 40 and 41 recite executing instructions that allow a user to view a column (claim 40) or image (claim 41) 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 displayed across the display.

The '926 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. 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 40 and 41 would have been obvious to one of ordinary

skill in the art. Patent Owner presents no arguments concerning any of the other claims challenged on this ground.

In view of the above, we conclude that Petitioner has demonstrated by a preponderance of the evidence that claims 31, 40, 41, 43, 55, 59, 72, and 75 would have been obvious to one of ordinary skill in the art over the combination of Zaurus, Hara, Tsutsumitake, and SVG.

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 claim 30 of the '926 Patent. PO Resp. 51; Ex. 2034.

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.,* 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 (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) (Paper 32). We have considered Patent Owner's Exhibit 2034, which purports to show that the iPhone and Android devices include the features of claim 30. 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, 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. Patent Owner also has not established that the subject matter of the '926 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 Patent Owner do not overcome the case of obviousness established by Petitioner by a preponderance of the evidence.

<div align="center">MOTION TO EXCLUDE</div>

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.* at 11-12; (v) the entirety of Petitioner's Reply on the basis that it relies on improper evidence, *id.* at 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 14-15; and (viii) Lutz Declaration (Ex. 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 Response 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 43, (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 another 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 that, 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. In this case, however, the references are not applied specifically to the claims, and the grounds on which the Board instituted review did not change.

Exhibit 1044[13] is a modified version of Patent Owner's Exhibit 2034, which attempts to map claim 30 to Android devices. Patent Owner's expert, Dr. Reiman, cited Exhibit 2034, which resembles an infringement chart, as evidence of the praise for and commercial success of Android devices incorporating the claims of the '926 Patent. Ex. 2003 ¶ 100. Petitioner was entitled to respond to the assertions made in conjunction with Patent Owner's Exhibit 2034. 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

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[13] Patent Owner also objects to Ex. 1043, which concerns IPR2013-00007/IPR2013-000256, and similarly relates the challenged claims of '353 Patent to Apple and Android products and to prior art.

establishing that Patent Owner began investigating possible infringement by Apple at the time Steve Jobs announced the iPhone.

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 that Petitioner has shown by a preponderance of the evidence that claims 30, 31, 40, 41, 43, 52, 55, 59, 72, and 75 unpatentable under 35 U.S.C. §103(a). Specifically, the claims are unpatentable as obvious over the combination of Zaurus, Pad++, and SVF. We further hold that Petitioner has shown by a preponderance of the evidence that claims 30, 31, 40, 41, 43, 52, 55, 59, 72, and 75 are unpatentable under 35 U.S.C. § 103(a) over the combination of Zaurus, Hara, Tsutsumitake and SVG.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 30, 31, 40, 41, 43, 52, 55, 59, 72, and 75 of the '926 are unpatentable;

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

FURTHER ORDERED that because this is a final 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.

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