UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner

v.

EXPRESS MOBILE, INC.,
Patent Owner

Case IPR2021-01226
Patent No. 7,594,168

PATENT OWNER'S PRELIMINARY RESPONSE

Under 37 C.F.R. § 42.107

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Submitted Electronically via PTAB E2E

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Exhibit	Description
Ex. 2001	Declaration of Glenn Weadock ("Weadock Decl.")
Ex. 2002	Curriculum Vitae of Glenn Weadock
Ex. 2003	Request for Ex Parte Reexamination of U.S. Patent No. 7,594,168 (Sept. 25, 2020)
Ex. 2004	Notice of Intent to Issue Ex Parte Reexamination Certificate for U.S. Patent No. 7,594,168 in Control No. 90/014,583 (July 14, 2021)

I. INTRODUCTION

U.S. Patent No. 7,594,168 ("the '168 patent") was filed January 24, 2003, and discloses and claims an inventive system and methodology for building web pages by defining each web page as a collection of objects and styles, storing information related to those objects and style in a database, and using that information to render a web page dynamically via a browser and runtime engine. Patent Owner is a leader in the business of developing mobile app and web site design and creation platforms. Patent Owner's Chairman of the Board and CTO, Steven Rempell, is the inventor of the '168 patent, among other patents. Mr. Rempell has over 50 years of experience in technology companies, with much of that work focused on web-based technologies and applications.

This is the second post-issuance attack on the '168 patent.[1] Facebook, Inc. ("Petitioner") requests this Board institute inter partes review of claims 1-4 and 6 of the '168 patent (the "Petition") for the Patent Office to yet again assess the validity of the claims post-issuance. The Board should deny institution because the Petition fails to demonstrate a reasonable likelihood that the single challenged claim of the

[1] In September 2020, Unified Patents, LLC requested *ex parte* reexamination of the patent. Ex. 2003. The Office has since determined that "Original Claims 1-6 are patentable." Ex. 2004, 3.

’168 patent will be found unpatentable, as required by 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(c). Indeed, that the challenged claim is not obvious is apparent on the face of the petition: Petitioner is forced to break claim elements into multiple sub-elements and rely on multiple different combinations of references as allegedly disclosing different sub-elements. This grab-bag approach smacks of hindsight analysis, and, indeed, Petitioner fails to provide any analysis or reason why it would be obvious to combine so many disparate references to pick up the different elements and sub-elements of the claim. And even within many of the sub-elements, Petitioner’s chosen reference does disclose the sub-element.

II. SUMMARY OF THE TECHNOLOGY

The ’168 Patent is directed towards groundbreaking innovations in web design technology. The ’168 patent describes “a Browser Based build engine” and a “Browser Based Interface . . . between the web designer and the build engine,” which allows a user to easily build a website. Ex. 1001, 1:61-65. The user interface allows a user to select settings within the browser that allow the user to build (and view) a web site in real time, and the system stores information associated with those settings in a database. These settings are, for example, “styles,” which include a collection of attributes to be applied to objects on a page. These styles define attributes such as transformations and time lines for objects on a web page, such as button and image objects. *Id.*, 30:25-31:56.

The patent describes an architecture that allows one to implement web site building seamlessly, including "a run time generation procedure that creates a compressed web site specific customized run time engine program file, with its associated database and build engine generated HTML shell file." *Id.*, 2:19-23. The patent explains that "[t]he entire web site build process is WYSIWYG (what you see is what you get), with the web designer working directly on and with the final web page." *Id.*, 2:40-43. The browser-based interface includes "interface objects with a look and feel that is identical to that of MS Windows, yet includes technologies that equal or surpass those of high end word processors, desk top publishers, and image processing software programs, particularly in the areas of interaction, animation, and timeline technologies." *Id.*, 2:57-63. And "[t]he run time engine includes multimedia capabilities often rivaling the digital processing capabilities seen on television and in the movies." *Id.*, 2:63-65.

Prior to the '168 patent, web pages were stored in a relatively fixed manner, leading to the slow and inflexible rendering of the web pages on a user's device. *See id.*, 1:25-29 ("Conventional mark-up and scripting languages . . . are remarkably slow and inefficient."), 1:48-57 ("HTML and JavaScript are incapable of reformatting text and scaling buttons or images dynamically"). The '168 patent (and its related patent, U.S. Patent No. 6,546,397) taught a new approach by storing information representative of web page settings in a database. *See, e.g., id.*, 61:66-

62:10. When a browser is later pointed to a web page, that representative information may be downloaded, and then the web page code may be constructed on the fly through the use of a "runtime engine" and the data representing the objects and their assigned styles.

III. THE PETITION FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CHALLENGED CLAIM.

The Board should decline review because there is no likelihood that Petitioner will prevail on the merits with respect to claim 1 of the '168 patent, or any of its challenged dependent claims.

Additionally, the Petition is rife with impermissible hindsight analysis of the exact kind disapproved of by the Board. Petitioner splits claim 1 into a variety of elements, which are addressed by different combinations. In other cases, Petitioner asserts combinations against only a small portion of a claim element (*see*, e.g., Pet., 36-37, asserting a three-reference combination against the phrase "time lines").

In *DirecTV, LLC v. Qurio Holdings, Inc.,* IPR2015-02006, Paper 6 (PTAB Apr. 4, 2016), the Board held that "given the extent of the proposed modifications as well as the thin reasoning proffered for each modification, we conclude that the Petition improperly 'reli[es] upon ex post reasoning' and impermissible hindsight reconstruction to piece together the combination . . . in a manner meant to resemble the . . . patent claims . . . This type of piecemeal analysis is precisely the kind of hindsight that [we] must not engage in." *Id.*, 13-14 (internal citations omitted)

(brackets in original). This Petition certainly displays the "piecemeal analysis" that the Board has explicitly warned Petitioners against utilizing. *See also id.* ("Care must be taken to avoid hindsight reconstruction by using the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.") (internal citations omitted). In its Petition, Petitioner has clearly "use[d] the patent in suit as a guide through [a] maze" of various asserted references, their configurations and, in some cases, characterizations changing as Petitioner moves from claim element to claim element. This tactic plainly displays the failure of the Petition to demonstrate that the challenged claims are taught, and the Board should reject Petitioner's arguments otherwise.

A. Ground 1 of the Petition Fails: Claim 1 And Its Challenged Dependent Claims Are Not Rendered Obvious by the combination of Reynolds, Lemay Web, Lemay Java, Perry, and Witkowski

1. Reynolds fails to teach or suggest "a server comprising a build engine configured to accept user input to create a web site, the web site comprising a plurality of web pages, each web page comprising a plurality of objects" (Claim 1[a]/[b])

The asserted reference, *Reynolds*, fails to teach at least the claimed "server comprising a build engine configured to accept user input to create a web site, the web site comprising a plurality of web pages, each web page comprising a plurality of objects" as recited in what Petitioner calls claim 1[a]/[b] of the '168 patent.

Petitioner incorrectly identifies *Reynolds*' "ibook" as the claimed "web site." In support of this assertion, Petitioner provides no specific definition of "web site" or non-conclusory statement to explain how an ibook is a web site. *See, e.g.*, Pet., 20 ("The '**website**' in Reynolds corresponds to an 'interactive Web book,' or "ibook'"), 24 ("an ibook website corresponds to the claimed '**web site**.'"). Per *Reynolds*, an ibook is in fact a "self-extending, self-sustaining information-redistributing Web robot, which is resident on a data network such as the Internet or an intranet." Ex. 1003, 1:26-29. Not all content available via the Web is a "web site," and not all collections of web pages saved to a database are "web sites." Ex. 2001, ¶32. There is no evidence provided in the petition that a "Web robot" is a web site or even has the characteristics of a web site. Pet., 20-24. In fact, the only mention in *Reynolds* of the term "Web site" explicitly refers to Web sites as targets for the advertisement of an ibook, differentiating the two terms. Ex. 1003, 14:14-24; Ex. 2001, ¶31.

As such, *Reynolds* does not concern a web site "build engine." Rather, *Reynolds* discloses a system for submitting and viewing content in ibooks, which are a specialized type of web content, accessed and viewed with a specialized application (the "IBOOK CLIENT" shown in Fig. 3, including an "authoring tool," "enrollment tool," "navigation tool," and "replication tool"). Ex. 1003, 1:24-29; Fig. 3; Ex. 2001, ¶32.

Thus, *Reynolds* does not purport to disclose anything related to "a server comprising a build engine configured to accept user input to create a web site." At best, *Reynolds* describes a system for creating an engine configured to accept user input to create a "Web robot" or "ibook," a distinct concept from a web site under *Reynolds*' own disclosure. Because Petitioner relies only on *Reynolds* to satisfy this claim element, *Reynolds*' failure to disclose a web site dooms the entire petition.

2. Reynolds, Lemay Web, and Lemay Java fail to teach or suggest "accept[ing] user input to associate a style with objects of the plurality of web pages, wherein each web page comprises at least one button object or at least one image object, and wherein the at least one button object or at least one image object is associated with a style that includes values defining transformations and time lines for the at least one button object or at least one image object" (Claim 1[c])

Reynolds, *Lemay Web,* and *Lemay Java* fail to disclose or render obvious at least the claimed "accept[ing] user input to associate a style with objects" and "style that includes values defining transformations and time lines for the at least one button object or at least one image object" as recited in claim element 1[c] of the '168 patent. Ex. 1001, cl. 1.

As a preliminary matter, Petitioner does not assert that any of the asserted references fully discloses element 1[c]. Rather, Petitioner splits 1[c] into multiple sub-elements, each of which is allegedly disclosed by a separate reference or combination. Specifically, Petitioner only asserts that *Reynolds* discloses "accept

user input" and "objects of the plurality of web pages," relying on *Lemay Web* for "style," "wherein each web page comprises at least one button object or at least one image object," and "wherein the at least one button object or at least one image object is associated with a style that includes values defining transformations and time lines for the at least one button object or at least one image object." Pet., 30-35. Finally, Petitioner asserts *Lemay Java* only against a particular previous construction of "time line." *Id.*, 36-37. Such a division of the claim element into piecemeal portions that are each assigned to different references is improper, and highlights Petitioner's clear reliance on hindsight. *DirecTV*, Paper 6, 13-14. Notwithstanding this improper piecemeal approach to obviousness, Petitioner's combination fails for several reasons.

First, the combination does not disclose the claimed "style." Petitioner does not assert that *Reynolds* discloses a "style." Petitioner instead alleges that *Lemay Web* discloses "style[s]" in the form of individual variables that can be programmed into an object using a programming language. Pet., 33-34. This assertion misconstrues the language of the claim itself. As the claim makes clear, a style "*includes* values defining transformations and time lines," and is stored alongside the object in the database.

In contrast, even taking Petitioner's representation as valid, *Lemay Web* does not disclose "styles" that are applied to any individual objects. Rather, *Lemay Web*

discloses hard-coded variables associated with a Java Applet. Ex. 2001, ¶35. Petitioner identifies the "WIDTH, HEIGHT, STARTIMAGE, ENDIMAGE, PAUSE, or REPEAT attributes" as the style, alleging that a user "can input any one or more of these attributes to associate a style with objects of the plurality of web pages as described above." Pet., 34. Petitioner draws no distinction between these "values" and the "style," though these necessarily must be separate and distinct concepts because they are identified separately in the claim language.

Compounding the problem that Petitioner's application of *Lemay Web* to the claim renders the term "style" meaningless because the alleged "values defining transformation and time lines" are themselves a "style," the '168 patent clearly describes styles as independent collections of attributes which are either preset or modifiable and are applied to objects as a set by the authoring tool. Ex. 1001, 31:57-32:18. This fundamentally distinguishes a "style" from the act of manually programming individual attributes into page code while creating an object.

Second, a POSITA would not have been motivated to combine *Reynolds*, *Lemay Web,* and *Lemay Java* (asserted as a combination only for a particular definition of "time line"). As an initial matter, *Reynolds* and *Lemay Web* are not directed to the same technology. Ex. 2001, ¶¶48-49. As discussed above in connection with 1[a]/1[c], *Reynolds* does not disclose, nor does it concern, "web sites." *Reynolds* concerns a system for ibooks, which are "Web robots." Ex. 1003,

1:26-29. *Lemay Web*, on the other hand, is a generalized manual for Web content intended for individuals just beginning to learn about how to create Web pages. Ex. 1004, 25 ("Who Should Read This Book . . . If you've seen what's out on the Web, and you want to contribute your own content, this book is for you.").

Petitioner premises the combination of *Reynolds* and the *Lemay* references chiefly on the idea that *Reynolds* "faced" "a host of problems" in "building [the Reynolds] web site building system." Pet., 38. Yet, Petitioner and its expert do not identify even *one* of the "host of problems" faced by *Reynolds*, and they do not explain how the combination of *Reynolds* and *Lemay Web/Java* addresses any of these supposed problems. *Id.*, 38-39; Ex. 2001, ¶¶48-55.

Petitioner's argument also mischaracterizes the claim. Petitioner alleges that a POSITA would have been motivated to "adapt the Reynolds ibook creation system to support the animated image objects of Lemay Web" and that "Reynolds … clearly contemplates that a passage could include the Animator Java applet described in Lemay Web." Pet., 39. But the claim does not require simply that a single passage *could* include a single animated image object. Rather, claim 1[c] specifies that "**each web page comprises at least one** button object or at least one image object … associated with a style." Ex. 1001, cl. 1 (emphasis added). Petitioner provides no explanation as to why a POSITA would have been motivated to create a combination wherein *each passage* includes animated image objects when *Reynolds* is centered

around text-based ibooks. Ex. 2001, ¶53. Thus, for the reasons stated above, the combination cannot render claim 1[c] obvious.

3. Reynolds, Lemay Web, and Lemay Java fail to teach or suggest "and wherein each web page is defined entirely by each of the plurality of objects comprising that web page and the style associated with the object" (Claim 1[d])

Reynolds, *Lemay Web,* and *Lemay Java* fail to disclose or render obvious at least the claimed "wherein each web page is defined entirely by each of the plurality of objects comprising that web page and the style associated with the object" as recited in claim element 1[d] of the '168 patent. Ex. 1001, cl. 1.

First, the combined references fail to disclose "style" as described in the '168 patent. Petitioner asserts that *Reynolds* alone discloses this element and renders it obvious, without explaining this assertion. Pet., 40. Petitioner asserts in the alternative that the combination of *Reynolds*, *Lemay Web,* and *Lemay Java* discussed in connection with claim 1[c] renders obvious claim 1[d]. *Id.* This combination suffers the same flaws that it did in connection with claim 1[c]. Namely, *Lemay Web* does not disclose a "style," and Petitioner does not assert that *Reynolds* or *Lemay Java* disclose or render obvious a "style." *See* Section III.A.2. This alone means that the combination cannot disclose element 1[d].

Second, Petitioner incorrectly suggests that ibook pages are "defined entirely by the passages … and their associated styles." Pet., 42. Petitioner alleges that "it would have been obvious that … each passage would have included an animated

image object." Pet., 40. Petitioner does not credibly explain how it would have been obvious, practical, or sensible to take *Reynolds*' ibook system and place an animated Java image in *every single passage* of an ibook. Ex. 2001, ¶53.

Even worse, Petitioner's argument misses both the language of the claim and Petitioner's own previous arguments. Petitioner now alleges in 1[d] that the "object" is the passage, yet in 1[c] identified the "object" as the animated image. Pet., 38, 43. Under Petitioner's interpretation, for a page to be defined *entirely* by the object and its associated styles (which, by Petitioner's earlier argument, were the variables applying to the animated object itself), Petitioner's combination would even further undermine the aim of *Reynolds*. Pet., 34.

Specifically, Petitioner's combination would have to consist of an ibook where each passage consists *only* of animated Java Applets defined by their associated variables. *Reynolds*, however, is directed to ibooks, which are web-based books consisting primarily of text, not slideshows of animated images devoid of readable content. Petitioner's arguments in 1[c] regarding motivation to combine were already insufficient, as discussed above, and the arrangement proposed by Petitioner for claim 1[d] is even less rational when compared to the stated purpose of *Reynolds*. Ex. 2001, ¶¶53.

Third, despite Petitioner's usage of *three* separate references for various sub-elements of claim 1[d], Petitioner's combination relies entirely on a selective—and

incorrect—reading of *Reynolds*. To satisfy claim 1[d]'s requirement that "each web page is defined entirely by each of the plurality of objects comprising that web page and the style associated with the object," Petitioner improperly takes *Reynolds*' Fig. 8 and states that only the lower half of the ibook page is the "web page." Pet., 41-42.

Petitioner asserts that the rest of Fig. 8 represents "user interface features of navigation tool 84." *Id.*, 42. Yet, *Reynolds* itself contradicts this assertion, identifying menu 196 located in the portion Petitioner alleges is the "navigation tool" and "not part of the actual web page" as containing information drawn from the passages of the ibook. Ex. 1003, 10:35-52. Petitioner's reasoning behind excluding these portions from the "web page" is apparent: a user cannot program an animated Java Applet into menu 196, meaning that a portion of the content displayed when viewing an ibook is *not*—and cannot be—defined by or associated with the "style" identified by Petitioner (parameters controlling a Java Applet). Thus, in addition to the reasons detailed above, the combination of *Reynolds*, *Lemay Web,* and *Lemay Java* does not disclose or render obvious claim 1[d].

4. Reynolds, Perry, and Witkowski fail to teach or suggest "produc[ing] a database with a multidimensional array comprising the objects that comprise the web site including data defining, for each object, the object style, an object number, and an indication of the web page that each object is part of" (Claim 1[e])

Reynolds, *Perry,* and *Witkowski* fail to disclose or render obvious at least the claimed "produc[ing] a database with a multidimensional array comprising the objects that comprise the web site including data defining, for each object, the object style, an object number, and an indication of the web page that each object is part of" as recited in claim element 1[d] of the '168 patent. Ex. 1001, cl. 1.

First, *Reynolds* cannot disclose "a database with a multidimensional array comprising the objects that comprise the web site" as alleged by Petitioner. As discussed above in connection with elements 1[a] and 1[b], *Reynolds* does not disclose a "web site," and Petitioner does not assert that *Perry* or *Witkowski* discloses a "web site." Instead, *Reynolds* discloses an ibook, which is a "Web robot." Ex. 1003, 1:26-29. For this reason alone, the asserted references cannot disclose claim 1[e].

Second, the combination of *Reynolds*, *Perry*, and *Witkowski* cannot disclose a "style" as required by claim 1[e]. Petitioner, previously relying on *Reynolds* and the *Lemay* references to disclose the "style" of claim 1, now alleges that *Reynolds, Perry,* and *Witkowski* disclose a "style" without the *Lemay* references. Pet., 45-46. Presumably, in at attempt to avoid a five-reference combination for a single claim

element, Petitioner silently abandons the references relied upon previously for "style[s]." As discussed previously, neither *Reynolds* nor the *Lemay* references disclose a "style," and Petitioner provides no disclosure from *Perry* or *Witkowski* regarding "style[s]." Ex. 2001, ¶35. The combination thus fails to disclose or render obvious claim 1[e].

Third, Petitioner's assertion that *Reynolds* discloses and renders obvious "storing in a database 'the objects that comprise the web site including data defining, for each object, the object style, **an object number**, and an indication of the web page that each object is a part of'," is based on a speculative interpretation of the visual annotations of *Reynolds*' Fig. 7. Pet., 46-48. Yet, Petitioner offers no reasoned analysis to support that assertion. Specifically, Petitioner asserts that *Reynolds* renders obvious the storage of an object number because "an ordinarily skilled artisan would have appreciated that a number is the simplest and most easily-implemented way" of keeping track of which pages contain which passages. Pet., 48.

Notwithstanding that Petitioner admits that *Reynolds* does not discuss this element aside from numbering in a diagram (*See* Pet., 48 ("Reynolds does not specify whether the passages numbers … are stored in the database (as opposed to identifying passages in the figure)"), using a number to identify which passages below to which pages would not be the most straightforward method. Ex. 2001, ¶59-

60. To implement Petitioner's "simplest and most easily-implemented" system, 1) each page in the database would be required to store a list of numbers of associated passages, and 2) each passage also must separately be stored with a number in order to link the two together. Ex. 2001, ¶59. There are a variety of simple ways of tracking such associations not involving separately-stored numerical identifiers, such as having each web page contain a list of pointers to passages related to that web page. Petitioner provides no non-conclusory argument or evidence to support its hindsight assertion that the '168 patent's claim 1[e] is the most obvious way to implement *Reynolds*.

Fourth, Petitioner's motivation to combine analysis regarding *Reynolds*, *Perry*, and *Witkowski* is generalized, conclusory, and speculative. Petitioner does not attempt to provide any specific analysis as to why a POSITA would have looked to *Perry* and *Witkowski* when considering *Reynolds* at any point in connection with claim 1[e]. Pet., 49-57. *Perry*, for example, discusses an array of arrays in the context of a C++ program. *See generally*, Ex. 1006. *Witkowski* relates to a system for "performing incremental refreshes to materialized views defined by one-to-N lossless joins." Ex. 1007, Abstract. Petitioner does not give any reason as to why a POSITA working with *Reynolds*' ibook system would have not only looked to one, but both references simultaneously in concert with *Reynolds*. Ex. 2001, ¶58.

Rather, Petitioner's obviousness argument is premised on a conclusory and fanciful argument regarding the "natural and fundamental way human beings organize information in the 'real world.'" Pet., 55. Namely, Petitioner alleges that because human beings often use spreadsheets and similar data structures in the "real world," two-dimensional arrays are the most obvious way to store data in *Reynolds*. *Id.* Petitioner goes even further and asserts that there would only be two options available to a POSITA implementing *Reynolds,* a multidimensional array, or "a brand new and untested home-grown data storage technique." *Id.*, 57.

This is incorrect. Ex. 2001, ¶¶59-60. A POSITA, and indeed a person with even basic knowledge of programming, would recognize that a two-dimensional array is not always the most straightforward or effective method of data storage. There are a wide variety of common ways to organize and store data beyond a multidimensional array, each tailored to specific purposes, such as linked lists, lookup tables, registries, non-relational databases, and many others. Ex. 2001, ¶58.

Not only is Petitioner's motivation to combine analysis conclusory, it is also nonsensical. Petitioner proposes a two-dimensional array where *each ibook passage*, divorced from connected ibooks, is stored sequentially in an array, with each index then containing an array of the objects and data making up said ibook passage. Pet., 54. Petitioner does not explain why the "most straightforward" way would have been to sequentially store what could have been thousands or tens of

thousands of ibook passages in the ibook system in such a manner, particularly when Petitioner alleges that the second dimension in the database would store, for each passage, an indication of which ibook or page a passage belonged to. *Id.* This would mean that, to load a given ibook, the database would need to be searched sequentially to retrieve individually each and every passage associated with that ibook. Ex. 2001, ¶60. Such a database schema would be time- and resource-intensive and would have been avoided by any competent software engineer. *Id.* Thus, the combination of *Reynolds*, *Perry*, and *Witkowski* proposed by Petitioner does not render obvious claim 1[e].

5. Reynolds, Lemay Web, and Lemay Java fail to teach or suggest "wherein the database is produced such that a web browser with access to a runtime engine is configured to generate the web-site from the objects and style data extracted from the provided database." (Claim 1[g])

Reynolds, *Lemay Web,* and *Lemay Java* fail to disclose or render obvious at least the claimed "wherein the database is produced such that a web browser with access to a runtime engine is configured to generate the web-site from the objects and style data extracted from the provided database" as recited in claim element 1[g] of the '168 patent. Ex. 1001, cl. 1.

First, *Reynolds*, taken alone or in combination with the *Lemay* references, does not disclose a "web site," as discussed above in relation to claim 1[a]/[b]. *Reynolds* instead discloses a system for submitting to and viewing content contained

in ibooks, which are a specialized type of web content accessed and viewed with a specialized system. The combination of *Reynolds* with the *Lemay* references does not cure this deficiency, and the combination thus fails to disclose or render obvious claim 1[g] for this reason alone.

Second, *Reynolds*, taken alone or in combination with the *Lemay* references, contains no disclosure or teaching of "style[s]." As discussed in relation to claim 1[c]-1[e], Petitioner's proposed "style" does not satisfy the claim language and is incompatible with the disclosure and stated purpose of *Reynolds*. Because Petitioner's combination does not disclose or render obvious a "style," it cannot disclose or render obvious claim 1[g].

6. Claims 2-4 and 6

Because claims 2-4 and 6 depend from claim 1, claims 2-4 and 6 are not obvious over *Reynolds*, *Lemay Web*, *Lemay Java*, *Perry*, and *Witkowski* for the same reasons set forth above.

B. Ground 2 of the Petition Fails: Claim 1 And Its Challenged Dependent Claims Are Not Rendered Obvious by the combination of Reynolds, Lemay Web, Lemay Java, Perry, Witkowski, and Coombs

Petitioner continues its improper piecemeal analysis in Ground 2, bringing a *sixth* reference to bear on claim 1. Pet., 73. In doing so, Petitioner tacitly acknowledges that neither *Reynolds* alone nor the combination of *Reynolds*, *Lemay Web, Lemay Java*, *Perry*, and *Witkowski* sufficiently teach a "website" including

each element of claim 1. *Coombs* does not cure this deficiency. Ex. 2001, ¶61. Petitioner presupposes that the only potential deficiency in *Reynolds*' disclosure of a "website" is the lack of a "separate and dedicated domain name," which it asserts is obvious in combination with *Coombs*. Pet., 74-75. As discussed above in reference to claim 1[a], *Reynolds*' disclosure is lacking for many additional reasons. *Reynolds* is not a "website" building system, it is a system for creating and viewing "ibooks," which *Reynolds* defines as "self-extending, self-sustaining information-redistributing Web robot[s], which [are] resident on a data network such as the Internet or an intranet." Ex. 1003, 1:26-29. Petitioner also sidesteps the obvious—that *Reynolds* was aware of websites, and did not teach or suggest any modification of an ibook into a website. *Reynolds* referred to websites separately as a location an ibook creator might advertise ibooks. Ex. 1003, 14:14-24. The capability to advertise web content via a website does not, as Petitioner suggests, mean that the content itself is a website. Pet., 73-75.

In addition to the deficiencies of *Coombs* identified above, *Coombs* does nothing to address the underlying failures of the various combinations of *Reynolds*, *Lemay Web, Lemay Java*, *Perry*, and *Witkowski* assembled by Petitioner throughout Ground 1. For the foregoing reasons Ground 1 fails, so too does Ground 2.

IV. CONCLUSION

Petitioner has failed to meet the burden of showing a reasonable likelihood of success that the claims are unpatentable as Petitioner's asserted references, taken alone or in combination, are insufficient to disclose or render obvious any of the challenged claims of the '168 patent, as discussed above. As such, Patent Owner respectfully requests that the Board deny institution of an *inter partes* review.

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), counsel for Patent Owner Express Mobile, Inc. certifies that this document complies with the type-volume limitation of 37 C.F.R. § 42.24(b). According to Microsoft Office Word's word count, this document contains approximately 4,876 words, including any statement of material facts to be admitted or denied in support, and excluding the table of contents, table of authorities, mandatory notices under § 42.8, exhibit list, certificate of service or word count, or appendix of exhibits or claim listing.

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CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of Patent Owner's Preliminary Response Under 37 C.F.R. § 42.107 and Exhibits 2001-2004 are being served electronically on October 20, 2021, to the names and email addresses below:

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