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Paper 42
Date: October 2, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner.

IPR2023-00628
Patent 7,233,790 B2

Before JEFFREY S. SMITH, STACEY G. WHITE, and STEPHEN E. BELISLE, *Administrative Patent Judges.*

SMITH, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

A. Background and Summary

Petitioner, Netflix, Inc., filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1–14 of U.S. Patent No. 7,233,790 B2 (Ex. 1001, "the '790 patent") pursuant to 35 U.S.C. § 311(a). We issued an Institution Decision (Paper 17, "Inst. Dec.") instituting the petitioned review.

VideoLabs, Inc. ("Patent Owner") then filed a Patent Owner Response (Paper 24, "PO Resp.") to the Petition. Petitioner filed a Reply (Paper 28, "Reply") to the Patent Owner Response. Patent Owner filed a Sur-Reply (Paper 31, "PO Sur-Reply) to the Reply. We also granted Petitioner's Motion to Submit Supplemental Information. *See* Papers 20, 22, 26, 29.

We have jurisdiction under 35 U.S.C. § 6(b)(4) and § 318(a). This Decision is a final written decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of claims 1–14 of the '790 patent. We determine Petitioner has shown by a preponderance of the evidence that those claims are unpatentable.

B. Real Parties-In-Interest

Petitioner identifies itself (Netflix, Inc.) and Netflix Streaming Services, Inc. as its real parties-in-interest. Pet. 71. Patent Owner identifies itself (VideoLabs, Inc.) as well as VL IP Holdings LLC and VL Collective IP LLC as real parties-in-interest. Paper 4, 2.

C. Related Matters

The Petition states that the '790 patent is the subject of the following proceedings:

> *VideoLabs, Inc. v. Netflix Inc.*, No. 1-22-cv-00229, D. Del., filed Feb. 23, 2022;

Starz Entertainment, LLC v. VL Collective IP, LLC, No. 1-21-cv-01448, D. Del., filed Oct. 13, 2021;

Unwired Planet, LLC v. Apple, Inc., No. 3-13-cv-04134, N.D. Cal., filed Sept. 19, 2012;

Unwired Planet, LLC v. Apple, Inc., No. 3-12-cv-00505, D. Nev., filed Sept. 19, 2012.

Pet. 71. Patent Owner identifies the following additional proceeding as one in which the '790 patent was involved (Paper 19):

Ex Parte Reexamination Proceeding No. 90/015,063, issued Aug. 11, 2023.[1]

II. THE '790 PATENT

The '790 patent relates to "facilitating management and delivery of digital content from multiple content suppliers to multiple wireless services subscribers in multiple domains." Ex. 1001, 1:14–18. The '790 patent explains that a download manager acts as an intermediary between content suppliers and wireless services subscribers. *Id.* at 4:11–15, Fig. 2.

[1] On August 11, 2023, a reexamination certificate was issued which amended independent claims 1 and 8. Ex. 2018.

Figure 3 of the ’790 patent is shown below.

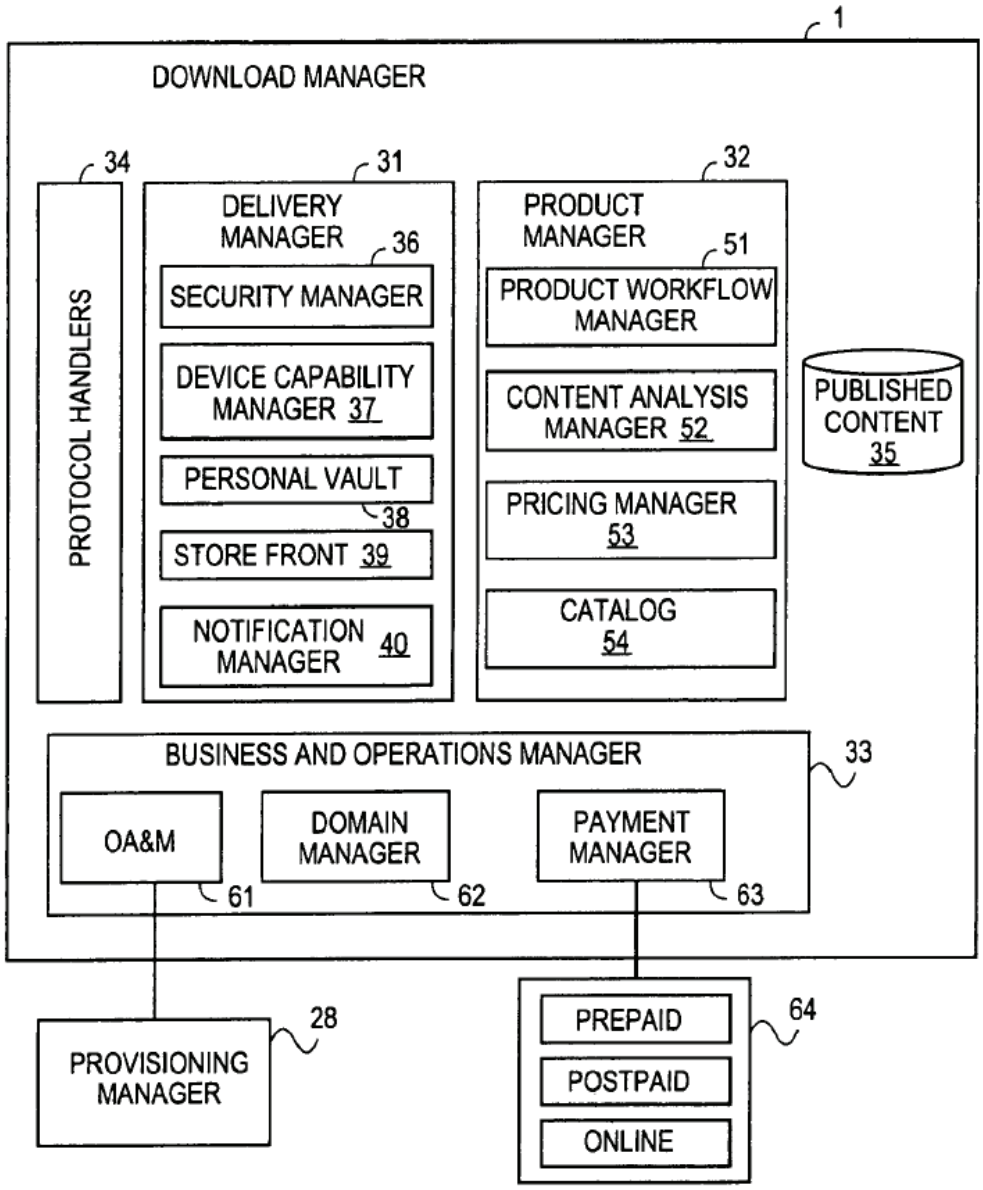

Figure 3, shown above, schematically illustrates the components of the download manager along with a provisioning manager. Ex. 1001, 3:15–16. In the embodiment of Figure 3, download manager 1 includes delivery manager 31, product manager 32, business & operations manager 33, and multiple protocol handlers 34. *Id.* at 6:36–38. “[P]roduct manager 32 is the download manager’s interface to the various content suppliers and provides centralized product cataloging (including enabling qualified content

suppliers to register content for analysis and publication) and complete product life cycle support." *Id.* at 6:46–50. Product manager 32 includes product catalog 54 that contains descriptions of all published items of content (products), and specifically includes, for each product entry, a reference to at least one implementation of that product, wherein an implementation can be a binary file representing the product. *Id.* at 9:37–42, Fig. 3. Delivery manager 31 includes device capability manager 37 that is responsible for device recognition, capability determination, and management. *Id.* at 7:31–39, Fig. 3. The '790 patent explains that "[w]hen a request to view available products is received from the client device," the product manager determines from the product catalog which products are supported by the client based on the capabilities of that client device. *Id.* at 12:9–13. The download manager then sends a response to the client "to cause the client device to display product information relating to only those products supported by the client device." *Id.* at 12:13–17.

III. ILLUSTRATIVE CLAIM

Independent claim 1 of the '790 patent as amended[2] recites:

> 1. A method of providing access to digital content for use on wireless communication devices, the method comprising:
>
> receiving and storing in a server system a plurality of items of digital content to be made available for use in wireless communication devices used by a plurality of wireless services subscribers, including receiving and storing a plurality of different implementations of at least one of the items of digital content, where each implementation of any given item of digital content corresponds to a different set of device capabilities;
>
> operating the server system to maintain a product catalog containing a description of the items of digital content, wherein the product catalog includes, in association with each item of digital content, a reference to each implementation of said item of digital content;
>
> receiving a request from one of the wireless communication devices;
>
> in response to the request, selecting a portion of the product catalog to be presented on the one wireless communication device, based in part on device capabilities of the one wireless communication device; and
>
> presenting the selected portion of the product catalog to the one wireless communication device, such that the selected portion, as presented, provides a single description of each item of digital content in said portion, regardless of a number of implementations that are available for each said item.

Ex. 2018, 1:20–2:8.

Independent claim 2 recites:

> 2. A method of providing access to digital content for use on wireless communication devices, the method comprising:

[2] On August 11, 2023, a reexamination certificate was issued which amended independent claims 1 and 8. Ex. 2018.

receiving and storing in a server system a plurality of items of digital content to be made available for use in wireless communication devices used by a plurality of wireless services subscribers,

including receiving and storing a plurality of different implementations of at least one of the items of digital content, where each implementation of any given item of digital content corresponds to a different set of device capabilities;

operating the server system to maintain a product catalog containing a description of the items of digital content, wherein the product catalog includes, in association with each item of digital content, a reference to each implementation of said item of digital content;

receiving a request from a wireless device used by one of the subscribers;

in response to the request, selecting a portion of the product catalog to be presented to the subscriber, based on device capabilities of the wireless device used by the subscriber; and

presenting the selected portion of the product catalog to the subscriber via a wireless network, such that the selected portion, as presented to the subscriber, provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item.

Ex. 1001, 15:34–61.

IV. ASSERTED GROUNDS

Petitioner asserts that claims 1–14 of the '790 patent are unpatentable on the following grounds (Pet. 22).

Claim(s) Challenged	35 U.S.C. §[3]	Reference(s)/Basis
1–4, 8–11	102(a), (e)	Mehta[4]
1–14	103(a)	Mehta, Schläpfer[5]

Petitioner is supported by testimony from Anthony Wechselberger (Exs. 1002, 1026). Patent Owner opposes Petitioner's challenges and is supported by testimony from Dr. Michael T. Goodrich (Ex. 2020).

V. LEVEL OF ORDINARY SKILL

Petitioner identifies a person of ordinary skill as someone with "a bachelor's degree in electrical or computer engineering, or a closely related scientific field such as computer science, and two years of work experience with digital multi-media content distribution and management, and associated system infrastructures." Pet. 16. "Alternatively, any lack of experience could be remedied with additional education (*e.g.*, a master's degree), and likewise, a lack of education can be remedied with additional work experience (*e.g.*, 4–5 years)." *Id*. Patent Owner does not address the level of ordinary skill. *See generally*, PO Resp.

[3] The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), amended 35 U.S.C. §§ 102, 103. Because the '790 patent has an effective filing date prior to the effective date of the applicable AIA amendment, we refer to the pre-AIA version of §§ 102, 103.
[4] U.S. Publication No. 2022/0131404 A1; pub. Sept. 19, 2002 (Ex. 1003).
[5] Schläpfer et al., Mobile Applications with J2ME, July 7, 2001 (Ex. 1009).

The level of ordinary skill in the art usually is evidenced by the references themselves. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978). As Petitioner's description of a person of ordinary skill appears commensurate with the subject matter before us, we apply Petitioner's definition for purposes of this Decision.

VI. CLAIM CONSTRUCTION

We interpret claim terms using "the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b)." 37 C.F.R. § 42.100(b) (2019). In this context, claim terms "are generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (citations omitted) (en banc). "In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence." *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). Extrinsic evidence is "less significant than the intrinsic record in determining 'the legally operative meaning of claim language.'" *Phillips*, 415 F.3d at 1317 (citations omitted).

We construe only those claim terms that require analysis to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (holding that "only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy"). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re*

Paulsen, 30 F.3d 1475, 1480 (Fed. Cir. 1994). Petitioner and Patent Owner agree that no claim terms require specific construction to resolve the unpatentability issues presented in the Petition. Pet. 23; PO Resp. 10–11. We agree and do not construe any terms.

VII. ANALYSIS

A. Legal Standards

"In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable." *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify "with particularity . . . the evidence that supports the grounds for the challenge to each claim")); *see also* 37 C.F.R. § 42.104(b) (requiring a petition for *inter partes* review to identify how the challenged claim is to be construed and where each element of the claim is found in the prior art patents or printed publications relied upon).

To establish anticipation, each and every element in a claim, arranged as recited in the claim, must be found in a single prior art reference. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). Although the elements must be arranged or combined in the same way as in the claim, "the reference need not satisfy an *ipsissimis verbis* test," i.e., identity of terminology is not required. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009) (citing *In re Bond*, 910 F.2d 831, 832–33 (Fed. Cir. 1990)).

A claim is unpatentable under 35 U.S.C. § 103(a) if "the differences between the subject matter sought to be patented 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) when in evidence, objective evidence of obviousness or nonobviousness, i.e., secondary considerations.[6] *See Graham v. John Deere Co*., 383 U.S. 1, 17–18 (1966). 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.

Additionally, the obviousness inquiry typically requires an analysis of "whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2016) (requiring "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")). Furthermore, Petitioner does not satisfy its burden of proving obviousness by employing "mere conclusory statements," but "must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

B. Claims 1–4 and 8–11 As Anticipated By Mehta

1. Mehta – Exhibit 1003

Mehta relates to "maintaining and distributing wireless applications to wireless devices over a wireless network." Ex. 1003 ¶ 2. Mehta discloses a Mobile Application System ("MAS") that "is a collection of interoperating

[6] The parties do not direct us to any objective evidence of non-obviousness.

server components that work individually and together in a secure fashion to provide applications, resources, and other content to mobile subscriber devices." *Id.* ¶ 59.

Figure 1 of Mehta is shown below.

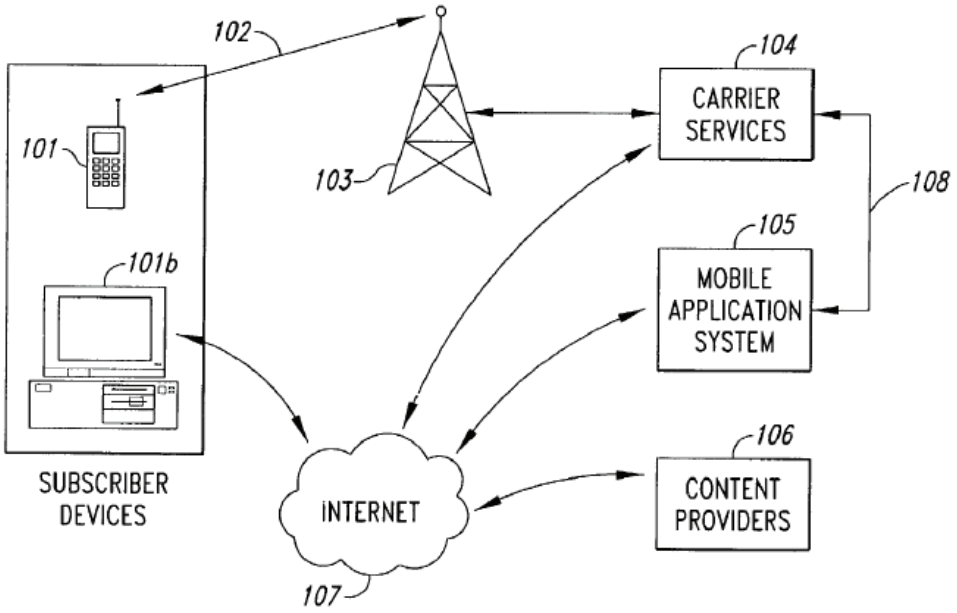

Fig. 1

Figure 1 above is a block diagram that illustrates how subscribers request and download software from an MAS. *Id.* ¶ 18. The MAS includes a provisioning manager which includes verifiers "used to determine compatibility of an application." *Id.* ¶ 82, Fig. 5. When the MAS receives a request, the "Device Verifier" of the provisioning manager "determines the type and capabilities of the subscriber device" and "whether the device capabilities are sufficient to support a specific application." *Id.* ¶¶ 82–85. Mehta's MAS may analyze "a subscriber profile, a device profile, and an application profile to determine whether the subscriber is authorized to use the application and whether the application's needs . . . are met by the device." *Id.* ¶ 67. The MAS then "compiles and returns a list of

applications that are available and appropriate based on the subscriber, application profiles, and device profiles." *Id.* ¶ 70.

2. Independent Claim 2

Preamble

The preamble of claim 2 recites a "method of providing access to digital content for use on wireless communication devices, the method comprising." Petitioner contends that Mehta discloses the preamble in describing a Mobile Application System ("MAS") and methods for providing applications, resources, and other content to mobile subscriber devices. Pet. 26–27, 31 (citing Ex. 1003 ¶¶ 2, 5, 59–60, 62, 103, 127). Patent Owner does not contend otherwise. We find that Petitioner has shown that Mehta discloses the features recited in the preamble of claim 2.[7]

"Receiving and Storing" and "Including"

Claim 2 recites "receiving and storing in a server system a plurality of items of digital content to be made available for use in wireless communication devices used by a plurality of wireless services subscribers."

Claim 2 recites "including receiving and storing a plurality of different implementations of at least one of the items of digital content, where each implementation of any given item of digital content corresponds to a different set of device capabilities."

The Petition's Contentions

Petitioner contends that Mehta discloses the "receiving and storing" limitation in describing an MAS that receives applications from content providers and carrier services to provision them for deliver to the subscriber

[7] Because Petitioner has shown that the features in the preamble are satisfied by the prior art, we need not determine whether the preamble is limiting. *See Vivid Techs.*, 200 F.3d at 803.

device. Pet. 27–28, 31 (citing Ex. 1003 ¶¶ 59, 62, 64, 68). Petitioner contends that Mehta discloses the "including" limitation in describing an MAS that stores and supports functionally equivalent programs that are capable of running multiple kinds of devices. Pet. 28–29, 31 (citing Ex. 1003 ¶¶ 64, 68, 98).

Summary of the Subsequent Contentions of the Parties

Patent Owner contends that the claims require receiving and storing both "a plurality of items of digital content" and "a plurality of different implementations of at least one of the items of content." PO Resp. 13. Patent Owner contends that Figure 6 of the challenged patent shows the relationship between a product and its implementations. *Id*. Patent Owner contends that the description of Figure 6 discloses that a product catalog contains both "descriptions of all published items of content" and "a reference 58 to at least one implementation 57 of that product." *Id*. at 14 (quoting Ex. 1001, 9:37–48); Ex. 2020 ¶¶ 56–57; *see* PO Resp. 15–16 (quoting Ex. 1001, 11:56–59 ("At block 803 the download manager 1 stores the product definition, the implementations, and a list of all of the supported devices and provisioning protocols.")).

Patent Owner contends that Petitioner maps the applications received by Mehta's MAS to the claimed "plurality of items of content," as well as to the claimed "implementations" of the items of content. PO Resp. 16. Patent Owner contends that Mehta does not disclose that its applications have different implementations for different device types. *Id*. at 18. According to Patent Owner, each application in Mehta is its own file, unlike an item of content in the challenged patent, which is made up of other subsidiary files, or implementations. *Id*. This means, according to Patent Owner, that each application of Mehta is for a separate device, rather than an item of content

having multiple implementations, each of which corresponds to a different device as claimed. *Id*. at 18–19.

Patent Owner further contends that Mehta's reference to functionally equivalent programs does not disclose that such programs have multiple implementations of an item of content. PO Resp. 21. According to Patent Owner, Mehta discloses two different items of content that share a function, not two implementations of a single piece of content. *Id*. Patent Owner contends that functionally equivalent programs, such as Microsoft Word and Apple Pages, are different applications that accomplish the same function, not different implementations of the same application. *Id*. at 22.

Petitioner contends that a software program in Mehta describes the claimed "item of digital content," and a binary file representing a version of that software program, where each version corresponds to a different set of device capabilities, describes the claimed "implementation" of the item of digital content. Reply 5 (citing Pet. 28–29). Petitioner contends that Figure 9D of Mehta shows an item of digital content, which is "Kbrowser," and an implementation, which is the .jar file of "Kbrowser." *Id*. at 6. Petitioner concludes that the Petition, contrary to Patent Owner's contention, does not point to the same application of Mehta to satisfy both the "item of digital content" and the "implementation" limitations. *Id*.

Petitioner contends that Mehta discloses the claimed "different implementations of at least one of the items of digital content" in describing that when a content provider submits an application, it may submit additional information about the application, including the URL, Title, Version, and Description. Reply 7 (citing Ex. 1003 ¶ 98, Figs. 9B and 9C). Petitioner contends that Mehta discloses that this additional information "allows the MAS to store and support functionally equivalent programs

having the same name that are capable of running on multiple kinds of devices," which describes the "plurality of different implementations of at least one of the items of digital content" as claimed. *Id*. (quoting Ex. 1003 ¶ 98); Ex. 1002 ¶ 66.

Petitioner contends that Patent Owner, in asserting that Microsoft Word and Apple Pages are functionally equivalent, but are not different implementations of the same content, does not address Mehta's disclosure of storing "functionally equivalent programs having the same name." Reply 8 (quoting Ex. 1003 ¶ 98). Petitioner further cites the deposition testimony of Patent Owner's expert Dr. Goodrich, who testifies that Microsoft Word for Windows and Microsoft Word for Apple Mac are "different implementations for the same product." Reply 9–10 (quoting Ex. 1029, 43:14–24, 47:15–22; 48:5–11).

Petitioner contends that, contrary to Patent Owner's contention, the 2-layer hierarchy shown in Figures 5 and 6 of the challenged patent are not required by the claims. Reply 10. Petitioner contends that under the plain and ordinary meaning, the claims require receiving and storing "a plurality of different implementations of at least one of the items of digital content," but do not require storing the different implementations in a multi-level database or data structure. *Id*. (citing Ex. 1001, 9:38–40, Fig. 5). Petitioner contends that the plain and ordinary meaning of this term is bolstered by the '790 patent's Specification, which discloses "[a]n implementation 57 can be simply a binary file ("a binary") representing the product." *Id*. (quoting Ex. 1001, 9:40–42; Ex. 1025, 2–3).

Patent Owner contends that Figure 9D of Mehta shows a single item of content, "Kbrowser," having a single implementation, the .jar file of "Kbrowser." PO Sur-Reply 3. According to Patent Owner, Figure 9D of

Mehta shows that Mehta discloses that a given application only has a single implementation, rather than "a plurality of different applications" as claimed. *Id*.

Patent Owner contends that its expert, Dr. Goodrich, testifies that the MAS of Mehta would list Microsoft Word for Windows and Microsoft Word for Apple Mac as separate applications, not different implementations of the same applications. PO Sur-Reply 6 (citing Ex. 1029, 47:15–48:20). According to Dr. Goodrich, "when Mehta is disclosing functionally equivalent . . . it's revealing it to describe how to disambiguate" programs "not clustered in terms of implementations." Ex. 1029, 45:11 –17. In Mehta, "functionally equivalent programs even with the same name can nevertheless be distinguished based on other metadata." *Id*. at 45:18–21. Patent Owner contends that once Microsoft Word for Windows and Microsoft Word for Apple Mac are submitted to the MAS of Mehta, "the metadata would distinguish them and they would be considered completely different products in this scenario." *Id*. at 7 (citing Ex. 1029, 47:15–48:20).

Analysis

We find that Petitioner persuasively shows that Mehta discloses both "receiving and storing . . . a plurality of items of digital content" and an "implementation of [an] item of digital content" as recited in claim 2. Both Petitioner and Patent Owner agree that Figure 9D of Mehta shows an item of digital content as claimed in describing "Kbrowser" and an implementation of the item of digital content as claimed in describing the .jar file of "Kbrowser." Reply 6; PO Sur-Reply 3. We agree with Petitioner and find that the applications received by Mehta's MAS describe the claimed "plurality of items of content." Pet. 27–28 (citing Ex. 1003 ¶¶ 59, 64, 68; Ex. 1001, 3:48–56). We also agree with Dr. Goodrich and find that the

application Microsoft Word describes an item of digital content. Ex. 2020 ¶ 39. Thus, the parties agree that Mehta describes the claimed plurality of items of digital content.

The dispute centers over whether Mehta discloses "receiving and storing a plurality of different implementations of at least one of the items of digital content, where each implementation of any given item of digital content corresponds to a different set of device capabilities." *See* PO Sur-Reply 3. The parties have framed this dispute, in part, as whether Microsoft Word for Windows and Microsoft Word for Apple Mac are different implementations of the same application or are different applications. Reply 8–11; PO Sur-Reply 6–7.

Dr. Goodrich, in his declaration, testifies that "Microsoft Word is [a] piece of content, while the versions of Microsoft Word for Windows and Microsoft Word for Apple Macs are different implementations." Ex. 2020 ¶ 39. Dr. Goodrich, in his deposition, when asked if "one of ordinary skill in the art at the time of the '790 patent would also understand that Microsoft Word for Windows and Microsoft Word for Mac are also functionally equivalent, correct?" answered "Yes . . . . But they would be even stronger than simply functionally equivalent. They would be different implementations of the same product." Ex. 1029, 43:14–24. However, later in his deposition, Dr. Goodrich testifies that Microsoft Word for Windows and Microsoft Word for Apple Mac are separate applications, not different implementations of the same application. Ex. 1029, 48:1–20. We disagree with this later testimony. Neither Dr. Goodrich nor Patent Owner persuasively explains why Dr. Goodrich changed his unambiguous position from both his declaration and his earlier deposition testimony.

For example, Dr. Goodrich testifies in his deposition that "for the Lion King example, a .MP3 and a .MOV are different implementations of the same product. They're also functionally equivalent, but functionally equivalent is broader." Ex. 1029, 45:7–11. Dr. Goodrich continues, "when Mehta is disclosing functionally equivalent, it is not referring to it as different implementations of the same product. Instead, it's [describing] how to disambiguate [applications] not clustered in terms of implementations . . . based on other metadata." *Id*. at 45:14–21. This explanation is unpersuasive because it is inconsistent with Dr. Goodrich's declaration testimony, in which Dr. Goodrich explicitly testifies that the different versions of Lion King, as well as the different versions of Microsoft Word, are different implementations of the same product. Ex. 2020 ¶ 39.

Specifically, in his declaration, Dr. Goodrich testifies that the "various versions of Lion King (such as an .mp3 file or an .mov file) are the implementations of the Lion King. For another example, . . . the versions of Microsoft Word for Windows and Microsoft Word for Apple Macs are different implementations." Ex. 2020 ¶ 39. Dr. Goodrich testifies again that "Microsoft Word for Windows and Microsoft Word for Apple Macs" are "multiple implementations of an individual item of digital content." Ex. 2020 ¶ 70. Further, the reason given in the explanation in his deposition, that Mehta needs to disambiguate applications that are not clustered in terms of implementations based on other metadata, would also apply to the different versions of Lion King, yet Dr. Goodrich consistently testifies that these different versions are different implementations, both in his declaration and in his deposition. *Id*.; Ex. 1029, 45:7–10.

Petitioner contends, and we agree, that the inconsistent testimony of Dr. Goodrich appears to be an attempt to cure Patent Owner's and Dr. Goodrich's incomplete analysis of Mehta's disclosure. *See* Reply 7–8. In particular, the Petition quotes Mehta's disclosure that the MAS stores "functionally equivalent programs having the same name that are capable of running on multiple kinds of devices that even may be written using different languages." Pet. 28 (quoting Ex. 1003 ¶ 98). Dr. Goodrich addresses this disclosure by explaining that two applications, such as Microsoft Word and Apple Pages, are functionally equivalent but are two different applications, not multiple implementations of a single application. Ex. 2020 ¶ 70. In this analysis, Dr. Goodrich does not address the full disclosure of Mehta, which describes that the "functionally equivalent programs hav[e] the same name" (Ex. 1003 ¶ 98), such as Dr. Goodrich's example of Microsoft Word for Windows and Microsoft Word for Apple Macs. *See id*. Thus, although Dr. Goodrich is correct in testifying that some functionally equivalent programs, such as Microsoft Word and Apple Pages, are not different implementations of an item of digital content, he is also correct in testifying that "Microsoft Word for Windows and Microsoft Word for Apple Macs" are "multiple implementations of an individual item of digital content." *Id*. Yet Dr. Goodrich does not identify any difference between the multiple implementations of Microsoft Word and the functionally equivalent programs having the same name as described by Mehta.

We agree with Petitioner that the subsequent inconsistent deposition testimony of Dr. Goodrich, namely, that Microsoft Word for Windows and Microsoft Word for Apple Macs are not different implementations, is an attempt to narrow the scope of the claimed "different implementations" by

improperly reading an example from the Specification into the claims. *See* Reply 10. Contrary to Dr. Goodrich's testimony, the claims do not exclude storing the "implementations" in Mehta's "flat database" (*see* Ex. 1029, 48:12–20), nor do the claims require "cluster[ing] in terms of implementations" (*see* Ex. 1029, 45:11–21). Although Figures 5 and 6 of the Specification show an example of arranging implementations in a 2-layer hierarchy, or a clustered rather than flat database, we do not read this example into the claims. The Federal Circuit has held that "it is improper to read limitations from a preferred embodiment described in the specification – even if it is the only embodiment – into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited." *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1327 (Fed. Cir. 2012); *Phillips*, 415 F.3d at 1323 (internal quotations omitted) ("[C]laims may embrace different subject matter than is illustrated in the specific embodiments in the specification.").

Patent Owner has not shown "a clear indication in the intrinsic record that the patentee intended the claims to be so limited." *Dealertrack*, 674 F.3d at 1327. To the contrary, the Specification discloses that an implementation "can be simply a binary file (a 'binary') representing the product" and "any particular product may have multiple implementations published on the download manager." Ex. 1001, 9:40–48. The Specification also discloses that "the invention is not limited to the embodiments described" and that "the specification and drawings are to be regarded in an illustrative sense rather than a restrictive sense." Ex. 1001, 15:11–18. We agree with Petitioner that the plain and ordinary meaning of the claim requires receiving and storing "a plurality of different implementations of at least one of the items of digital content," but does not

require storing the implementations in a multi-level data structure. *See* Reply 10 (citing Ex. 1029, 48:1–3, 48:12–16; Ex. 1001, 9:38–42, Fig. 5; Ex. 1025, 2–3).

For these reasons, we do not credit the deposition testimony of Dr. Goodrich that Microsoft Word for Windows and Microsoft Word for Apple Mac are different applications, not different implementations of the same application. Rather, we agree with the original testimony of Dr. Goodrich and find that Microsoft Word for Windows and Microsoft Word for Apple Mac are different implementations of the same application. Ex. 2020 ¶¶ 39, 70; Ex. 1029, 43:14–24. We agree with Petitioner and Mr. Wechselberger and find that Mehta's disclosure of receiving and storing functionally equivalent programs having the same name that are capable of running on multiple kinds of devices, such as Microsoft Word for Windows and Microsoft Word for Apple Mac, describes "receiving and storing a plurality of different implementations of at least one of the items of digital content, where each implementation of any given item of digital content corresponds to a different set of device capabilities." *See* Pet. 31; Reply 7–11; Ex. 1002 ¶¶ 65–66.

We find that Petitioner has shown by a preponderance of the evidence that Mehta discloses the "receiving and storing" and "including" limitations of claim 2.

"Operating"

Claim 2 recites "operating the server system to maintain a product catalog containing a description of the items of digital content, wherein the product catalog includes, in association with each item of digital content, a reference to each implementation of said item of digital content."

The Petition's Contentions

Petitioner contends that Mehta discloses this limitation in describing an MAS that includes a data repository that stores applications along with descriptions of the applications. Pet. 29–32 (citing Ex. 1003 ¶¶ 64, 67, 97–99). Based on the evidence and arguments of record, Petitioner has sufficiently demonstrated that Mehta discloses this limitation of claim 2.

Summary of the Subsequent Contentions of the Parties

Patent Owner contends that the claims require "maintaining a product catalog," with "the product catalog including, in association with each item of content, a reference to each implementation of said item of content." PO Resp. 23–24. Patent Owner contends that Figure 5 of the '790 patent demonstrates the relationship between a product entry and implementations of the product in the product catalog. *Id.* at 24.

Patent Owner contends that Mehta does not disclose "a 'product catalog including, in association with each item of content, a reference to each implementation'" as claimed. PO Resp. 25. In particular, Patent Owner recognizes that Petitioner maps the claimed "product catalog" to Mehta's data repository, and the claimed "reference" to Mehta's URL or other location reference of an application. *Id*. at 26. Patent Owner, in contending that the URL is not stored in Mehta's application profile, argues that the URL is used by the MAS to retrieve the application and store the application in applications store 1216. PO Resp. 26–27 (citing Ex. 1003 ¶ 131, Fig. 12). Patent Owner, relying on Figure 9A of Mehta, contends that a content provider submits Mehta's URL or other location reference of an application to a content provider website when submitting the application to the MAS. *Id.* at 27–28. According to Patent Owner, the URL or other location reference is the location of the application on the internet before it is

submitted to the MAS, but it is not a reference to the application in the MAS and is not stored in the data repository. *Id*. at 28 (citing Ex. 2020 ¶¶ 79–80).

Petitioner contends that once a content provider submits an application, the content provider website requests additional information about the application being submitted, which becomes part of the application profile. Reply 11 (citing Ex. 1003, Fig. 9B). Petitioner contends that the administrator of the content provider website uses information submitted by the content provider, which includes the submitted application, to create an application profile, which is stored and maintained in a data repository. *Id*. at 12 (citing Ex. 1003 ¶¶ 67, 99, Fig. 5, Fig. 9D). Petitioner contends that although the URL or other location reference is the location of the application before it is submitted to the MAS, the URL or other location reference is stored in the data repository. *Id*. at 13.

Patent Owner contends that Figure 5 and paragraphs 67 and 68 of Mehta, contrary to Petitioner's contention, do not mention the URL. PO Sur-Reply 8. Patent Owner contends that the URL shown in Figure 9D is used to identify an application to download, but does not indicate that the URL is stored in the application profile. *Id*. at 9.

Analysis

We agree with Petitioner that the URL shown in Figure 9D of Mehta is stored in an application profile, and the application profile is stored in the data repository for the reasons given by Petitioner. *See* Reply 11–13. In particular, Mehta discloses that an "Administrator uses the information submitted by the content provider . . . to create an application profile, which is stored and maintained in a data repository." Ex. 1003 ¶ 99; *see id*. at ¶ 98 ("additional information from the content provide[r] about the application to be submitted . . . becomes part of the application profile."). Figure 9D of

Mehta shows a section labeled "Application Profile" which includes a URL for the application. *Id*. at ¶ 99, Fig. 9D. Therefore, contrary to Patent Owner's contention, Figure 9D explicitly shows that the URL is part of the application profile. Given that Mehta discloses (a) a content provider submits information about an application, including a URL for the application, (b) an administrator uses the information submitted by the content provider to create an application profile which is stored in a data repository, and (c) the application profile includes the URL for the application as shown in Figure 9D, we are persuaded that Mehta describes including the URL in the application profile and storing the application profile in the data repository.

We disagree with Patent Owner's contention that the MAS has no reason to store the URL in the data repository after it has downloaded the application (PO Sur-Reply 9), because this contention is inconsistent with Mehta's description of storing application profiles in the MAS, and storing applications outside of the MAS. Ex. 1003 ¶¶ 73, 97–99, Fig. 5, Fig. 9D. We find that Mehta, consistent with Petitioner's contentions and Mr. Wechselberger's testimony, discloses that an "application profile . . . is stored and maintained in a data repository (e.g., data repository 511 in Fig. 5)," and that the application profile includes a URL. Ex. 1003 ¶ 99, Fig. 5, Fig. 9D; *see id.* at ¶¶ 73, 97–98. In addition, Figure 5 of Mehta shows "carrier's application store" and "remote application hosts," both of which are located outside of MAS 500. Mehta discloses that the content provider chooses whether to host the application on a carrier's application store or on a remote server. *Id.* at ¶ 97. Given that Mehta discloses storing the application profiles within MAS 500 of Figure 5 and hosting the applications outside of MAS 500 (either on the application store or on a remote server),

we disagree with Patent Owner that the MAS has no reason to store the URL. One reason to store the URL is because the application is hosted outside of the MAS as shown in Figure 5. We agree with Petitioner and find that Figure 5 of Mehta includes data repository 511 which stores application profiles, where each application profile includes a URL for an application as shown in Figure 9D. *See* Reply 12.

We find that Petitioner has shown by a preponderance of the evidence that Mehta discloses the "operating" limitation of claim 2.

"Receiving a Request"

Claim 2 recites "receiving a request from a wireless device used by one of the subscribers." Petitioner contends that Mehta discloses this limitation in describing an MAS receives a wireless services request from a wireless subscriber. Pet. 32–33 (citing Ex. 1003 ¶¶ 6061, 64, Fig. 1). Patent Owner does not contend otherwise. We find that Petitioner has shown that Mehta discloses this limitation of claim 2.

"In Response"

Claim 2 recites "in response to the request, selecting a portion of the product catalog to be presented to the subscriber, based on device capabilities of the wireless device used by the subscriber." Petitioner contends that Mehta discloses this limitation in describing an MAS that analyzes various profiles to determine whether an application version meets the devices requirements of a subscriber. Pet. 33–35 (citing Ex. 1003 ¶¶ 67, 139, Fig. 4). Patent Owner does not contend otherwise. We find that Petitioner has shown that Mehta discloses this limitation of claim 2.

"Presenting"

Claim 2 recites "presenting the selected portion of the product catalog to the subscriber via a wireless network, such that the selected portion, as

presented to the subscriber, provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item."

The Petition's Contentions

Petitioner contends that Mehta discloses this limitation in describing an MAS that that filters the list of content to only identify those applications that are supported by the subscriber's device." Pet. 35–37 (citing Ex. 1003 ¶¶ 67, 9, 16, 117). We find that Petitioner has shown that Mehta discloses this limitation of claim 2.

Summary of the Subsequent Contentions of the Parties

Patent Owner contends that Mehta does not disclose the claimed "selected portion, as presented to the subscriber, provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item." PO Resp. 29. Patent Owner also argues that the Petition does not explain how Mehta discloses this limitation. *Id*. at 29–30. In particular, Patent Owner recognizes that Petitioner relies on Mehta's application discovery process, which provides a list of applications that are supported by the subscriber's device to the subscriber, but asserts that Petitioner does not explain how Mehta's application discovery process describes this limitation. *Id*. at 31. Patent Owner also contends that Mehta's disclosure of functionally equivalent applications that have the same name but are written in different languages could result in two programs, "Program A" and "Program B," with the same name that are both compatible with a user's computer. *Id*. at 31–32. Patent Owner contends that in this case, the MAS of Mehta would show both applications to the user. *Id*. at 32. Thus, according to Patent Owner, Mehta

does not disclose "providing only a single description . . . regardless of the number of implementations" as claimed.

Petitioner contends that the Petition explains that Mehta expressly discloses that application discovery returns a list of content that can be downloaded that match criteria that are designated by the subscriber, and in some embodiments, "the MAS only lists those applications that are supported by the subscriber's device." Reply 13 (citing Pet. 36; Ex. 1003 ¶¶ 6, 117). Petitioner contends that Figure 11F of Mehta shows a screen display of a subscriber's personal access list of applications, which includes a name and description of each application in the list. *Id*. at 13–14. Petitioner contends that Figure 11F shows a single name and a single description of each application, which describes "only a single description of each item of digital content" as claimed. *Id*. at 14–15. Petitioner further contends that Figure 2 of Mehta also shows a single description of each game, or item of content. *Id*. at 15. Petitioner contends that Patent Owner's hypothetical regarding "Program A" and "Program B" should be disregarded because those programs have different names. *Id*. at 16.

Patent Owner contends that Figure 11F of Mehta shows a single description of each item of content because Figure 11F only shows items of content with a single implementation. PO Sur-Reply 10. Patent Owner contends that Mehta is silent on whether only a single description would be provided if there were multiple implementations. *Id*. at 11.

Analysis

We agree with Petitioner. Mehta discloses storing "functionally equivalent programs having the same name that are capable of running on multiple kinds of devices that even may be written using different languages." Ex. 1003 ¶ 98. Mr. Wechselberger testifies that this disclosure

shows that Mehta's "MAS receives, stores and supports functionally equivalent programs capable of running on multiple devices because each program corresponds to a different device having different device capabilities (e.g., written using different languages)." Ex. 1002 ¶ 66. This testimony is consistent with that of Dr. Goodrich, who testifies that "each application has a single version made for a particular device type." Ex. 2020 ¶ 66.

Dr. Goodrich later testifies that paragraph 98 of Mehta describes that there could be two functionally equivalent programs with the same name that are compatible with a single user's computer. *Id*. at ¶ 88; *see* PO Resp. 31–32 (citing Ex. 2020 ¶¶ 87–88). We do not credit this later testimony, because it is inconsistent with Dr. Goodrich's earlier testimony that "each application," or program of Mehta, is "made for a particular device type." Ex. 2020 ¶ 66. We agree with Mr. Wechselberger and find that a person of ordinary skill in the art at the time of invention would have understood that Mehta's disclosure of functionally equivalent programs having the same name that are capable of running on multiple kinds of devices means that each program corresponds to a different device having different capabilities.

Further, Mehta discloses that "the MAS only lists those applications that are supported by the subscriber's device. This allows the subscriber to avoid the problem of having to explicitly select a compatible application." Ex. 1003 ¶ 117; *see* Pet. 36–37 (citing Ex. 1002 ¶¶ 75, 77).
Mr. Wechselberger testifies that a person of ordinary skill in the art at the time of invention would have understood this disclosure to mean that the MAS provides the subscriber with only a single subscriber-appropriate version that will work for the subscriber. Ex. 1002 ¶ 77. Although Patent Owner contends that Mehta is silent on whether only a single description

would be provided if there were multiple implementations (PO Sur-Reply 10–11), we agree with Mr. Wechselberger and find that when multiple implementations have the same name, each implementation corresponds to a different device, and therefore, the MAS would only present to the subscriber the one implementation that works with the subscriber's device. Ex. 1002 ¶¶ 66, 75, 77.

We agree with Petitioner that even though multiple implementations can have the same name, Mehta displays the name only once, regardless of the number of implementations that have the same name. *See* Reply 13–15; *see id*. at 16–17 (citing Ex. 1003 ¶ 67, Fig. 2); Pet. 36–37 (citing Ex. 1002 ¶¶ 75–77). In particular, we agree with Petitioner and find that Mehta displays a single description of the item "Amark" in Figure 11F only once, and displays a single description of each game shown in Figure 2 only once, even though multiple implementations of an item and multiple implementations of a game can have the same name. We find that Mehta, in displaying the title of an application only once as shown in Figures 2 and 11F, even though multiple applications can have the same title, describes "presenting . . . only a single description of each item of digital content . . . regardless of the number of implementations" of the item as claimed.

Returning again to Patent Owner's example of "Microsoft Word for Windows" and "Microsoft Word for Apple Mac," which are different implementations of the digital content item "Microsoft Word" as discussed above, we rely on the disclosure of Mehta and the testimony of Mr. Wechselberger in finding that when a user's computer[8] is an Apple Mac,

[8] Claim 2 recites "receiving a request from a wireless device." In the related district court proceeding, the court did not construe "wireless device," other than to say that it is "not restricted to 'personal mobile devices.'" Ex. 1025,

Mehta's MAS would determine that an implementation of Microsoft Word is compatible with the user's computer and would list a single description of this digital content item using the title of the item (in this case, Microsoft Word) as shown in Figures 2 and 11F, regardless of the number of implementations of the item having the same title "Microsoft Word." Ex. 1003 ¶¶ 98, 117, Fig. 2, Fig. 11F; Ex. 1002 ¶¶ 66, 75, 77.

We are persuaded that Petitioner has shown by a preponderance of the evidence that Mehta anticipates claim 2.

3. Dependent Claims 3 and 4

Claim 3 depends from claim 2 and recites "wherein said selecting a portion of the product catalog comprises: in response to the request, determining the identity of the wireless device used by the subscriber." Petitioner contends that Mehta discloses this limitation in describing that the subscriber verifier determines the type and capabilities of the subscriber device. Pet. 37–38 (citing Ex. 1003 ¶¶ 83–84). We find that Petitioner has shown that Mehta discloses this limitation of claim 3.

Claim 3 recites "wherein each implementation of the plurality of items of digital content has been previously associated in the server system with at least one device identity, according to corresponding device capabilities supported by the implementation." Petitioner contends that Mehta discloses this limitation in describing that the deployment manager provisions each application for specific device or subscriber profiles. Pet. 38 (citing Ex.

2; *see* Pet. 24. In arguing that "[b]oth programs [of Mehta] could be compatible with a single user's computer," Patent Owner indicates that the scope of the claimed "wireless device" encompasses a single user's computer. PO Resp. 31-32; Ex. 2020 ¶ 88.

1002 ¶ 79). We find that Petitioner has shown that Mehta discloses this limitation of claim 3.

Claim 3 recites "selecting the portion of the product catalog to be presented to the subscriber based on the identity of the wireless device used by the subscriber." Petitioner contends that Mehta discloses this limitation in describing that the initial list is based upon subscriber and device capabilities, and the final list to be presented to the subscriber is based on the type and capabilities of the subscriber's device. Pet. 38–39 (citing Ex. 1003 ¶¶ 67, 85, 139). We find that Petitioner has shown that Mehta discloses this limitation of claim 3.

Patent Owner does not raise any arguments with respect to claim 3. "Where a party does not raise any arguments with respect to any other claim limitation, nor does it separately argue the dependent claim, the dependent claim stands or falls together with the independent claim." *Incept LLC v. Palette Life Sciences, Inc.*, 77 F.4th 1366, 1375 (Fed. Cir. 2023) (internal citations and markings omitted). Claim 3 falls with independent claim 2.

Claim 4 depends from claim 2 and recites "receiving from the subscriber a request for one of the items of digital content in said portion of the product catalog." Petitioner contends that Mehta discloses this limitation in describing a data repository that stores applications, where subscribers of wireless services request and download the applications. Pet. 39–40 (citing Ex. 1003 ¶¶ 61, 64, 81–82, Fig. 1). Patent Owner does not contend otherwise. We find that Petitioner has shown that Mehta discloses this limitation of claim 4.

Claim 4 recites "selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber."

The Petition's Contentions

Petitioner contends that Mehta discloses this limitation in describing receiving a request to download an application, verifying that the request is appropriate and permitted for download to the device and user, and sending the application to the requesting device. Pet. 41 (citing Ex. 1002 ¶ 83).

Summary of the Subsequent Contentions of the Parties

Patent Owner contends that Petitioner maps Mehta's application discovery process to both "presenting the selected portion of the product catalog" recited in claim 2, and to "selecting an implementation of the requested item" recited in claim 4. PO Resp. 33. Patent Owner also contends that Mehta's application discovery process verifies applications based on device capabilities, therefore, subsequently "selecting an implementation" would not be based on device capabilities, because the compatibility of the applications with the device capabilities has already been verified. *Id*. at 33–34. Patent Owner contends that Mr. Wechselberger testifies that Mehta, during the application discovery process, filters a list of applications for compatibility with the wireless device, and therefore does not subsequently re-check the applications for compatibility. *Id*. at 34 (quoting Ex. 2021, 53:11–20).

Petitioner contends that Mehta's application discovery process filters a list of applications to include only appropriate applications that the user may select for download, and presents the list to the user. Reply 16–17. Petitioner contends that once a user selects an application to download, the MAS retrieves the application, verifies that the application is appropriate for download to that device, and sends the application to the device. *Id*. at 17. Petitioner contends that Mr. Wechselberger's deposition testimony is consistent with Mehta's disclosure. *Id*. Petitioner contends that Mehta,

consistent with Mr. Wechselberger's testimony, discloses that the MAS confirms that an application is compatible with a device during the application discovery process, then, when the application is selected for download, the verification routine checks whether the device has the resources required by the application, not whether the application is compatible. *Id*. at 17–18 (citing Ex. 2021, 53:11–20; Ex. 1003 ¶ 139).

Patent Owner contends that the application discovery process and the download process are alternative processes that are not taken one after another. PO Sur-Reply 11–14. Patent Owner further contends that even if Mehta discloses sequentially performing an application discovery process, then performing a download process that includes verifying whether a device has resources required by the application, Petitioner does not explain how verifying whether a device has resources required by an application describes "***selecting*** an implementation of the requested item of digital content" as claimed. *Id*. at 14–15 (emphasis in original).

Analysis

We agree with Petitioner and find that Mehta describes performing an application discovery process that displays a list of applications that are available and appropriate based on capabilities of the wireless device. Ex. 1003 ¶ 70. We agree with Petitioner and find that Mehta performs a selection process that includes receiving a request to download an application and verifying that the application is appropriate for the device. *Id*.; *see id*. at ¶¶ 64–67, 139, Figs. 3–5.

We disagree with Patent Owner that Mehta's use of the word "alternatively" means that Mehta performs either discovering applications or selecting an application for download but not both (PO Sur-Reply 11–14), and find that the selection process of Mehta is performed after the

application discovery process. Ex. 1003 ¶¶ 67, 70, 139, Figs. 3 and 4; Ex. 1002 ¶¶ 82–83. We find that Mehta uses the word "alternatively" to distinguish the process for selecting an application for download as shown in Figure 3 from the process of discovering applications as shown in Figure 4, not that only one of the two processes are performed. *See* Ex. 1003 ¶¶ 67, 70, 139, Figs. 3 and 4. Rather, we find that both processes would be performed sequentially. That is, a person of ordinary skill in the art would have understood that after the application discovery process of Mehta presents a list of appropriate applications to the user, the user then selects an application from the list for download. Ex. 1003 ¶¶ 67, 70, 139, Figs. 3 and 4; Ex. 1002 ¶¶ 82–83 (quoting Ex. 1003 ¶¶ 67, 70, 139). Otherwise, displaying the list of applications without then selecting and downloading one of the applications from the list would make no sense.

We do not agree with Patent Owner's contention that "during application discovery in Mehta, applications are selected 'based on device capabilities,' and so it would make no sense to check the application again" (PO Sur-Reply 14 (citing PO Resp. 33–35; *see* Ex. 2020 ¶ 93)) because Patent Owner's contention is inconsistent with the disclosure of Mehta, which describes selecting an application based on device capabilities when discovering applications and also when selecting the application for download. Ex. 1003 ¶¶ 67, 70, 139, Figs. 3 and 4. Contrary to Patent Owner's contention, we find that Mr. Wechselberger's deposition testimony—that Mehta describes an application discovery process that determines whether an application is compatible with the wireless device and a selection process that includes determining whether the device has resources required by the application—is consistent with the disclosure of Mehta. Ex. 2021, 53:11–20; Ex. 1002 ¶¶ 82–83; Ex. 1003 ¶¶ 67, 70, 139.

We agree with Petitioner and Mr. Wechselberger that Mehta's selection process that includes determining whether a device has resources required by an application describes "selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device" as claimed. Ex. 1002 ¶¶ 82–83; Reply 17 (citing Pet. 41; Ex. 1003 ¶¶ 70, 139; Ex. 1002 ¶ 83). That is, Mehta's selection process only selects an implementation for download to a device when the device has the required resources. *Id*. We find that Petitioner has shown that Mehta discloses this limitation of claim 4.

Claim 4 recites "downloading the selected implementation of the item of digital content to the wireless device used by the subscriber." Petitioner contends that Mehta discloses this limitation in describing downloading the selected application to the subscriber device. Pet. 42–43 (citing Ex. 1002 ¶ 84, Fig. 3. Patent Owner does not contend otherwise. We find that Petitioner has shown that Mehta discloses this limitation of claim 4.

We are persuaded that Petitioner has shown by a preponderance of the evidence that Mehta anticipates claims 3 and 4.

4. Independent Claim 9

Petitioner contends that claim 9 recites limitations similar to those recited in claim 2, and that Mehta anticipates claim 9 for the reasons given in the Petition's analysis of claim 2. Pet. 46–47. Patent Owner disagrees for the reasons given in Patent Owner's analysis of claim 2. PO Resp. 12–32. We are persuaded that Petitioner has shown by a preponderance of the evidence that Mehta anticipates claim 9 for the reasons given in our analysis of claim 2.

5. Dependent Claims 10 and 11

Petitioner contends that claim 10 contains limitations similar to those recited in claim 3, that claim 11 recites limitations similar to those recited in claim 4, and that Mehta anticipates claims 10 and 11 for the reasons given in the Petition's analysis of claims 3 and 4. Pet. 48. Patent Owner does not present arguments regarding claim 10. Patent Owner contends disagrees with Petitioner's contention that claim 11 is anticipated by Mehta for the reasons given in Patent Owner's analysis of claim 4. PO Resp. 32–35. We are persuaded that Petitioner has shown by a preponderance of the evidence that Mehta anticipates claim 9.

6. Claims 1 and 8

As a result of reexamination, original claims 1 and 8 have been replaced by amended claims 1 and 8. Ex. 2018. Mr. Wechselberger testifies that the Petition and supporting evidence demonstrates that amended claims 1 and 8 are anticipated by Mehta and would have been obvious in view of Mehta and Schläpfer. Ex. 1026 ¶¶ 19, 53; *see id*. ¶¶ 20–52. Petitioner contends that amended claims 1 and 8 are anticipated by Mehta. Reply 29–30 (citing Ex. 1026; Ex. 1029, 17:6–17). Patent Owner disagrees for the reasons given in Patent Owner's analysis of claim 2. PO Resp. 12–32. We agree with Mr. Wechselberger and find that Petitioner has shown by a preponderance of the evidence that Mehta anticipates amended claims 1 and 8 for the reasons given in our analysis of claim 2.

C. Claims 1–14 As Obvious Over Mehta and Schläpfer

1. Schläpfer – Exhibit 1009

Schläpfer is a white paper to "provid[e] insight into Java technology for the application development on mobile devices." Ex. 1009, 3. Schläpfer describes the Java 2 Micro Edition ("J2ME"), which is an edition of Java designed for embedded devices and resource-constrained devices. *Id.* at 4. A "[P]rofile" is "defined as a set of APIs for a specific vertical market and relies upon the underlying configuration's capabilities to create new, market-specific APIs." *Id.* at 4–6.

The Mobile Information Device Profile ("MIDP") addresses devices with a small display, touch screen or keypad, and capable of communicating via a mobile network with limited bandwidth. *Id.* at 4–6. Applications written "according to the MIDP specifications are called MIDlets." *Id.* Schläpfer discloses provision of MIDlets. *Id.* at 11. The MIDlets may be combined with supporting files, a manifest, and an application descriptor to form a "jar file." *Id.* at 7. The application descriptor includes mandatory attributes such as name, version, vendor, URL, and size. *Id.* at 7–8.

Summary of Contentions Regarding Schläpfer's Prior Art Status

Patent Owner contends that Schläpfer is not prior art because Petitioner has not established that it was accessible to a person of ordinary skill exercising reasonable diligence before the effective filing date of the '790 patent, which is June 19, 2003. PO Resp. 37; *see* Pet. 14–16 (contending that the effective filing date of the '790 patent is June 19, 2003); PO Resp. 9 (Patent Owner does not dispute Petitioner's contention that the effective filing date is June 19, 2003). Patent Owner contends that Petitioner's evidence, at best, shows that an individual accessed Schläpfer through a URL shown in a European Patent Specification (Ex. 1017, field

[56]) on November 29, 2002, but that Petitioner has not shown that a person of ordinary skill in the art could have found this URL using reasonable diligence, nor that such person of ordinary skill could have accessed Schläpfer through the URL. *Id.* at 38.

Petitioner relies on the testimony of a librarian, Ms. June Munford, in contending that the URL cited in Exhibit 1017 was referenced on Ericsson's public website by August 3, 2002, before the effective filing date of the '790 patent. Reply 20–21 (citing Ex. 1030 ¶ 9). Petitioner contends that "Ms. Munford concluded that 'Ericsson was clearly advertising and distributing copies of [Schläpfer] to the public as of August 3, 2002." *Id*. at 21.

Patent Owner contends that Ms. Munford's testimony shows a screenshot of Schläpfer located at a URL on August 3, 2003, which is after the effective filing date of the '790 patent, and a screenshot of a different website that includes the URL on August 3, 2002, which is before the effective filing date. PO Sur-Reply 16. Patent Owner contends that although the evidence shows that Schläpfer was located at the URL on August 3, 2003, a different document or a different version of Schläpfer may have been located at the URL on August 3, 2002. *Id*. at 16–17 (citing Ex. 2022, 15:8–16:3, 16:19–17:6, 19:22–20:14). Patent Owner also contends that even if Schläpfer was located at the URL before the effective filing date of the '790 patent, Petitioner has not shown that the URL was publicly accessible, because there may have been access restrictions. *Id*. at 17–18 (citing Ex. 2022, 23:20–24:6, 25:30–26:9, 26:16–28:5).

Analysis

We disagree with Patent Owner's contention that Petitioner has not shown, by a preponderance of evidence, that Schläpfer was located at the

URL before the effective filing date of the '790 patent. First, although it is possible that an earlier version of Munford was located at the URL on August 3, 2002, we find this possibility unlikely given that Schläpfer itself lists a date of July 2001. Ex. 1009. Second, there is no evidence that other versions of Schläpfer or other documents were ever located at the URL. *See* Ex. 2022, 15:17–16:18 (Ms. Munford, when asked whether it was possible to change what the URL was pointing to, testifies that "I have no evidence that it happened."), 17:15–22, 19:13–20, 20:16–21:10, 22:9–23:4. Finally, Ms. Munford's testimony and supporting evidence that Schläpfer was located at the URL on August 3, 2002 is consistent with the URL of Exhibit 1017, which shows that Schläpfer was available at the URL on November 29, 2002. We rely on Exhibit 2017 and the testimony of Ms. Munford in finding that Petitioner shows, by a preponderance of evidence, that Schläpfer was located at the URL before the effective filing date of the '790 patent. Ex. 1030 ¶¶ 6–9; Ex. 1017.

We also disagree with Patent Owner's contention that Petitioner has not shown by a preponderance of evidence that Schläpfer was publicly accessible before the effective filing date of the '790 patent. Again, although it is possible that the URL for Schläpfer may have had access restrictions, we find this possibility unlikely given that the URL was published on Ericsson's website with no evidence of any access restrictions. Ex. 2022, 25:3–26:15 (Ms. Munford, when asked whether Ericsson's website containing the URL pointing to Schläpfer had access restrictions, testifies that "[i]t is theoretically possible, although it would be a rather strange presentation given that it is offered freely in a Java-based competition" and that "the context of the content page suggests otherwise" because "it doesn't outline any access restrictions. It doesn't provide any

instructions for accessing [ ] material. It simply provides a link."); Ex. 1030 ¶ 9.

Ms. Munford's testimony is consistent with Exhibit 1017, which shows that the URL pointing to Schläpfer was accessed by someone external to Ericsson on November 29, 2002, which further indicates that the URL did not have access restrictions. We are persuaded by Ms. Munford's testimony "that Ericsson was clearly advertising and distributing copies of [Schläpfer] to the public as of August 3, 2002." Ex. 1030 ¶ 9.

We are persuaded that Petitioner has shown, by a preponderance of evidence, that Schläpfer was publicly accessible before the effective filing date of the '790 patent. Accordingly, we find that Schläpfer is prior art to the '790 patent.

2. Reasons to Combine the Teachings of Mehta and Schläpfer

Petitioner contends a person of ordinary skill would have had reason to combine the teachings of Mehta and Schläpfer because both references concern distributing digital contents to mobile devices over a wireless network. Pet. 66. Petitioner also contends Mehta provides a motivation to look to Schläpfer because Mehta "recognizes the issue of resource constraints on mobile devices and contemplates taking steps to address those constraints." Pet. 67 (citing Ex. 1003 ¶¶ 10, 12). Petitioner contends that a person of ordinary skill would have combined Mehta's MAS with Schläpfer's teachings of limited screen space of mobile devices and limited bandwidth of the mobile network, and an application descriptor and associated attributes. *Id.* at 66 (citing Ex. 1009, 11). Mr. Wechselberger testifies that a person of ordinary skill in the art would have provided a single description of each supported application of Mehta in order to

accommodate the viewing capabilities of the requesting device as taught by Mehta, such as limited screen space and signal processing capabilities of the mobile device as taught by Schläpfer. Ex. 1002 ¶¶ 106–108.

Petitioner argues that a person of ordinary skill would have had a reasonable expectation of success in combining the teachings of Mehta and Schläpfer because the two references rely on Java for distributing digital content to mobile devices and refer to the specific J2ME edition of Java. Pet. 68. Petitioner also contends that a person of ordinary skill would have known that a provisioning model includes a corresponding set of provisioning attributes and descriptors. *Id.* at 68–70.

Patent Owner contends that a person of ordinary skill in the art would not have been motivated to combine the teachings of Mehta and Schläpfer. PO Resp. 41–43, 52. We address Patent Owner's contention in detail below in our analysis of the contentions of the parties.

3. Claims 2–4 and 9–11 and Amended Claims 1 and 8

Summary of the Anticipation Contentions of the Parties

Petitioner contends that Mehta discloses the limitations of claims 2–4 and 9–11 and amended claims 1 and 8 for the reasons given in the anticipation ground. Pet. 48–53, 63–65; Reply 29–30 (citing Ex. 1026; Ex. 1029, 17:6–17). Patent Owner disagrees for the reasons given in Patent Owner's analysis of claim 2. PO Resp. 35–52. We are persuaded that Petitioner has shown that Mehta anticipates amended claims 1 and 8 and claims 2 and 9 for the reasons given in our analysis of claim 2.

The Petition's Contentions Regarding the Combination

Petitioner further contends that to the extent Mehta alone may not disclose "provid[ing] only a single description of each item of digital content in said portion, regardless of the number of implementations of each said

item" as recited in claim 2, the combination of Mehta and Schläpfer teaches this limitation. Pet. 51–52. Petitioner contends that Mehta discloses the subscriber avoids the problem of having to explicitly select a compatible application when the MAS only lists the applications that are supported by the subscriber's device. *Id.* at 51 (citing Ex. 1003 ¶ 117). Petitioner contends that Schläpfer discloses that mobile devices have a small display and communicate over a mobile network with limited bandwidth. *Id.* (citing Ex. 1009, 7). Mr. Wechselberger testifies that a person of ordinary skill in the art would have provided a single description of each supported application of Mehta in order to accommodate the viewing capabilities of the requesting device as taught by Mehta, such as limited screen space and signal processing capabilities of the mobile device as taught by Schläpfer. Ex. 1002 ¶¶ 106–108.

Summary of the Subsequent Contentions of the Parties

Patent Owner contends that the combination of Mehta and Schläpfer does not teach "provid[ing] only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item" as claimed, and that Petitioner relies on impermissible hindsight. PO Resp. 39–40. According to Patent Owner, Schläpfer discloses that the screen space and signal processing capabilities of mobile devices was limited, but does not suggest limiting the amount of content shown due to the limited screen space by only showing a single description of each item. *Id*. (citing Ex. 2020 ¶¶ 104–105). Dr. Goodrich testifies that there were many ways to limit the amount of content shown, such as displaying less information or only displaying the most valuable applications. Ex. 2020 ¶ 105.

Patent Owner contends that Mehta and Schläpfer are not analogous to each other because they are from different fields of endeavor. PO Resp. 41. According to Patent Owner, Mehta is from the field of provisioning applications, and Schläpfer is from the field of application development. *Id*. at 41–42 (citing Ex. 2020 ¶ 107). Patent Owner contends that Mehta's teaching of resource constraints is described in the context of provisioning applications, whereas that of Schläpfer is in the context of creating applications to be small. *Id*. at 42. Patent Owner contends that a person of ordinary skill would not have known how to combine Mehta and Schläpfer. *Id*. (citing Ex. 2020 ¶ 109). Patent Owner contends that Mehta only discloses single version applications without multiple applications, and that Mehta would have to be fundamentally changed to incorporate multiple versions of applications. *Id*. at 43 (citing Ex. 2020 ¶ 110).

Petitioner contends that Schläpfer teaches the known problem of a mobile devices having a small display screen with limited space. Reply 21 (citing Ex. 1009). Petitioner contends that Mehta teaches a small display screen for a mobile device that, when displaying a list of available applications, only lists the titles of those applications that are supported by the device. *Id.* at 21–22 (citing Ex. 1003, Fig. 2, ¶ 63). Petitioner contends that a person of ordinary skill in the art, when faced with the known problem of a mobile device that has a small display screen, would display only a single description of each item of content, such as the title of each available game as taught by Mehta, to yield the benefit of limiting the amount of information displayed on the small screen with limited space. *Id*. at 22–23 (citing Ex. 1003, Fig. 2; Ex. 1002 ¶¶ 105–108). Petitioner also contends that Mehta discloses "multiple implementations" as claimed, therefore, Mehta would not have to be fundamentally changed because it already incorporates

multiple versions of an application. *Id*. at 23 (citing Ex. 1029, 47:15–22, 54:21–55:10; Ex. 1003, Figs. 9B, 9D, and 10C).

Patent Owner contends that Schläpfer merely acknowledges the reality at the time that display space was limited, which Mehta already acknowledges. PO Sur-Reply 19. Patent Owner contends that because Mehta's display space is already limited, a person of ordinary skill in the art, after reading Schläpfer's duplicative disclosure, would not have had a reason to further limit data displayed by Mehta. *Id*. Patent Owner contends that even if one were motivated to limit the amount of displayed data, a person of ordinary skill could have done so by displaying less information, or by only displaying the most important applications. *Id*. at 19–20 (citing Ex. 2020 ¶ 105).

Analysis

We disagree with Patent Owner's contention that Mehta only displays a single implementation of each application for the reasons given above in our analysis of the anticipation ground. Therefore, we disagree with Patent Owner's contention that Mehta would have to be fundamentally changed in order to show multiple implementations. We also disagree with Patent Owner's contention that a person of ordinary skill would not have had a reasonable expectation of success in combining the two references. Rather, we agree with Petitioner that a person of ordinary skill in the art would have had a reasonable expectation of success in combining the teachings of Mehta and Schläpfer because both references use Java to distribute digital content to mobile devices. Pet. 68 (citing Ex. 1002 ¶ 139).

We disagree with Patent Owner's contention that Mehta and Schläpfer are non-analogous to claim 2. We find that the field of endeavor of the '790 patent is providing content to wireless devices and that Mehta and Schläpfer

are also in the field of providing content to wireless devices. Ex. 1001, 1:13–15 (The "present invention pertains to systems and methods for providing digital content to wireless service subscribers"); Ex. 1003 ¶ 2 ("The present invention relates to a method and system for . . . distributing wireless applications to wireless devices"); Ex. 1009, 3-2 (Discussing downloading Java applications to a device), 4-10 (The "user should be able to download applications to the mobile device"), 4-11 Fig. 2 (showing the process of downloading an application to the device, including performing application discovery, retrieving a descriptor for the application, and downloading the application); *see In re Bigio*, 381 F.3d 1320, 1325-26 (Fed. Cir. 2004) (citing *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)).

We disagree with Patent Owner's contention that Petitioner relies on impermissible hindsight. We agree with Petitioner that Schläpfer describes the known problem of a mobile device having limited resources such as a small display screen and that a person of ordinary skill would have therefore recognized that the amount of information displayed on the small screen would be limited. Pet. 51–52 (citing Ex. 1009, 4–6; Ex. 1002 ¶ 106); Reply 21–22 (citing Ex. 1002 ¶ 108). We agree with Petitioner that Mehta discloses displaying only the titles of applications such as games on the screen of the mobile device. Reply 22–23 (citing Ex. 1003 ¶ 63, Fig. 2; Ex. 1002 ¶¶ 105–108).

Although Dr. Goodrich identifies two other ways to accomplish limiting the amount of information shown on a small screen (Ex. 2020 ¶ 105), this testimony does no more than show three identified, predictable solutions. "When there is a design need . . . to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options." *KSR*, 550 US at 421. Here,

there is a design need to limit the amount of information displayed on a small screen as taught by Schläpfer and Mehta, therefore, a person of ordinary skill has good reason to pursue the known option of displaying only a single description of each item of digital content regardless of the number of implementations of each item as taught by Mehta.

We find that a person of ordinary skill in the art at the time of invention, faced with the known problem of displaying items of digital content on a mobile device having a small display screen as taught by Schläpfer, would have displayed only a single description of each item of digital content—such as the title—regardless of the number of implementations of each item as taught by Mehta for the benefit of limiting the amount of information displayed on the small display screen as suggested by both Schläpfer and Mehta.

We are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Mehta and Schläpfer renders obvious claims 2–4 and 9–11 and amended claims 1 and 8.

4. Claims 5 and 12

Claim 5 depends from claim 4 and recites "associating each of the items of digital content in the server system with a plurality of different provisioning models, each of the provisioning models corresponding to a different set of device capabilities."

The Petition's Contentions

Petitioner contends that Mehta discloses this limitation in describing a plurality of different provisioning models, and that a person of ordinary skill in the art would have associated each of the items of digital content with the provisioning models for the benefit of distributing content for use on a

particular device by a particular customer, in order to handle the device capabilities. Pet. 54–55 (citing Ex. 1003 ¶¶ 59, 85, 131).

Summary of the Subsequent Contentions of the Parties

Patent Owner contends that Mehta discloses four different provisioning models, walled-garden provisioning, open provisioning, static provisioning, and dynamic provisioning, but that Petitioner does not explain why these models correspond to device capabilities. PO Resp. 44. Patent Owner contends that the four provisioning models do not have anything to do with any set of device capabilities. *Id*. at 46 (citing Ex. 2020 ¶¶ 113–115). Patent Owner contends that Mr. Wechselberger's deposition testimony that Mehta describes additional provisioning models is not in the Petition and is incorrect. *Id*. at 48–52.

Petitioner contends that Mehta has extensive disclosures about provisioning. Reply 23 (citing Ex. 1003 ¶¶ 11–15, 72–76, 80–81, 135–144). Petitioner contends that Mehta's provisioning refers to "the customizing and distributing of content for a particular use, for example, for use on a particular kind of subscriber device by a particular customer," and that a person of ordinary skill in the art would have therefore understood that Mehta discloses more than the four exemplary models identified in its specification. *Id*. at 23–24 (citing Ex. 1002 ¶¶ 59, 116).

Petitioner contends that Mehta's provisioning process considers device capabilities, and that a person of ordinary skill in the art would have employed provisioning models that correspond to particular device capabilities. *Id*. at 24 (citing Ex. 1003 ¶ 85; Ex. 1002 ¶¶ 115–116). Petitioner contends that Mehta discloses using multiple provisioning models simultaneously, such as walled garden and static provisioning. *Id*. Petitioner contends that Mehta discloses "[p]rovisioning includes one or

more of the steps of retrieving, inspecting . . . and packaging, and may include additional steps as needed to ready an application for downloading to a target device." *Id*. at 25 (citing Ex. 1003 ¶ 64). Petitioner contends that a person of ordinary skill in the art would have recognized that various considerations in the provisioning process, such as device capabilities, application packaging, or encryption, may require selection of additional provisioning models based on device capabilities. *Id*. (citing Ex. 1003 ¶¶ 12, 64, 85; Ex. 1002 ¶ 116).

Patent Owner contends that Petitioner's argument that Mehta describes more than four provisioning models is a new theory. PO Sur-Reply 21. Patent Owner contends that the only four provisioning models identified in the Petition are walled garden, open, dynamic, and static. *Id*. at 22. Patent Owner contend that although the Petition contends that Mehta discloses "at least four different types of provisioning models," this contention does not explain how Mehta's general discussion of provisioning meets this claim limitation. *Id*. at 22–23. Patent Owner also contends that Mehta's disclosure of provisioning in general does not teach provisioning models corresponding to different sets of device capabilities. *Id*. at 24–25.

Analysis

We disagree with Patent Owner's contention that the Petition does not explain how Mehta teaches each of "the provisioning models corresponding to a different set of device capabilities" as claimed. *See* PO Resp. 44–45. The Petition contends that, in view of Mehta's teachings that provisioning is the customizing and distributing of content for use on a particular kind of subscriber device, a person of ordinary skill in the art would have associated each of the items of digital content with a plurality of different provisioning

models for the benefit of handling different sets of device capabilities. Pet. 54–55 (citing Ex. 1003 ¶¶ 8–9, 59, 61, 85, 131; Ex. 1002 ¶¶ 115–116); see Reply 23–25 (citing Ex. 1003 ¶¶ 8–9, 11–15, 64, 72–76, 80–81, 85, 112, 135–144, Fig. 6; Ex. 1002 ¶¶ 115–16). We agree with Petitioner and find that Mehta teaches different provisioning models for applications to handle different device capabilities. Ex. 1003 ¶¶ 8–9, 11–15, 59, 61, 64, 72–76, 80–81, 85, 112, 131, 135–144, Fig. 6; Ex. 1002 ¶¶ 115–16.

For example, Mehta discloses that "content is provisioned by . . . packaging code for the intended subscriber device" and that "[d]uring the provisioning process, . . . content can be packaged appropriate to the requesting device." Ex. 1003 ¶¶ 10, 12. Mehta discloses that "[p]rovisioning . . . is the customizing and distributing of content . . . for use on a particular kind of subscriber device." *Id*. ¶ 59. Mehta discloses that the "MAS 105 also provides a multitude of tools . . . for customizing the applications." *Id*. ¶ 61. Mehta discloses that provisioning "may include additional steps as needed to ready an application for downloading to a target device. *Id*. ¶ 64. Mehta discloses that a device verifier "determines the type and capabilities of the subscriber device . . . and determines whether the device capabilities are sufficient to support a specific application." *Id*. ¶ 85. Mehta discloses creating a device profile for each device that is supported by the MAS, and using information from the device profile to verify device capabilities during the provisioning process. *Id*. ¶ 112. Mehta discloses "Provisioning Components 1214" that "enable the MAS 1209 . . . to verify the appropriateness of the request for use by . . . a particular subscriber device, to customize the requested application appropriately, and to send the provisioned application to the subscriber device 1201." *Id*. ¶ 131.

We find that Mehta's packaging code, device profiles, multitude of tools, and additional steps teach the claimed "provisioning models." We find that Mehta's disclosure of provisioning using packaging code appropriate to the requesting device teaches the claimed "each of the provisioning models corresponding to a different set of device capabilities." Ex. 1003 ¶ 10, 12. We find that Mehta's disclosure of creating a device profile for each device and using information from the device profile to determine capabilities of the device during provisioning teaches the claimed "each of the provisioning models corresponding to a different set of device capabilities." *Id*. ¶¶ 85, 112, 131. We find that Mehta's disclosure of a multitude of tools for customizing the application for use on a particular kind of subscriber device, as well as Mehta's disclosure of additional steps to ready an application for downloading to a target device, teach the claimed "each of the provisioning models corresponding to a different set of device capabilities." *Id*. ¶¶ 61, 64; *see id*. ¶¶ 59, 131. We agree with Petitioner that the provisioning of Mehta includes customizing an application for use on a particular device, and that a person of ordinary skill in the art would have selected appropriate provisioning models of Mehta, such as packaging code appropriate to the requesting device, the device profile of the requesting device, a multitude of tools, and additional steps, in order to customize the application according to the capabilities of the device as taught by Mehta. Pet. 54–55; Reply 23–25.

We disagree with Patent Owner's contention that the four types of provisioning models discussed in Mehta, walled-garden, open, dynamic, and static, do not teach provisioning models corresponding to different device capabilities. *See* PO Resp. 45–50. We find that the names of these four types of provisioning "are made for convenience of discussion alone, as the

different types of provisioning share many similar functions." Ex. 1003 ¶ 61. For example, Mehta uses the term static provisioning or pre-provisioning to describe an application that has already been provisioned and is available for downloading, and dynamic provisioning to describe an application that has not been previously provisioned. *Id*. ¶¶ 8, 15, 65, 131. Mehta discloses that both walled-garden and open types of provisioning use either a statically provisioned application or a dynamically provisioned application. *See id*. ¶ 64 (The steps to provision applications "are applicable to either provisioning scenario—using walled-garden or open provisioning"), ¶¶ 15, 65–66 (Describing provisioning by using a pre-provisioned application if it exists, otherwise, dynamically provisioning the application); Reply 24–25. Mehta discloses that both the statically provisioned applications and the dynamically provisioned applications are customized according to the capability of the subscriber device. Ex. 1003 ¶ 65 (Disclosing that pre-provisioned applications are pre-customized and dynamically provisioned applications are dynamically customized). Thus, contrary to Patent Owner's contention, each of Mehta's four provisioning types identified in the Petition customizes an application according to the capability of the subscriber device, and does so using provisioning models corresponding to different sets of device capabilities as discussed above.

We disagree with Patent Owner's contention that Petitioner's Reply raises a new theory that Mehta vaguely discloses more than four provisioning models because Mehta generally discusses provisioning. PO Sur-Reply 21. Petitioner contends in Reply that Mehta's extensive disclosure regarding provisioning teaches considering device capabilities in order to customize content for a particular device, and that a person of ordinary skill in the art, after considering the device's capabilities, would

have customized content by selecting additional provisioning models based on the device's capabilities in order to ready an application for downloading to the device. Reply 23–25 (citing Ex. 1003 ¶¶ 8–9, 11–15, 64, 72–76, 80–81, 85, 112, 135–144, Fig. 6; Ex. 1002 ¶¶ 115–16).

Similarly, the Petition contends that, in view of Mehta's teachings that provisioning is the customizing and distributing of content for use on a particular kind of subscriber device, a person of ordinary skill in the art would have associated each of the items of digital content with a plurality of different provisioning models for the benefit of handling different sets of device capabilities. Pet. 54–55 (citing Ex. 1003 ¶¶ 8–9, 59, 61, 85, 131; Ex. 1002 ¶¶ 115–116). Petitioner's contentions in the Petition as well as the Reply rely on Mehta's teachings of different provisioning models as discussed above. We find that Petitioner did not raise a new argument in Reply. Rather, Petitioner's Reply properly responds to arguments raised in Patent Owner's Response. *See* 37 C.F.R. § 42.23; *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064 (Fed. Cir. 2015).

We find that the combination of Mehta and Schläpfer teaches this limitation of claim 5.

Claim 5 recites "each provisioning model including a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices."

The Petition's Contentions

Petitioner contends that the combination of Mehta and Schläpfer teaches this limitation. Pet. 55. Petitioner contends that Mehta discloses extending known protocols using well-known techniques to provide support for additional protocols. *Id.* (citing Ex. 1003 ¶ 71). Petitioner contends that a person of ordinary skill would have included a set of provisioning

attributes and descriptors for the provisioning model as taught by Schläpfer. *Id.* at 55–56 (citing Ex. 1009).

Summary of the Subsequent Contentions of the Parties

Patent Owner contends that Petitioner has not shown how Schläpfer's disclosure of an application descriptor that includes attributes such as name, size, and URL has anything to do with the claimed provisioning model. PO Resp. 51–52; PO Sur-Reply 25–26. Patent Owner contends that Petitioner has not shown motivation to combine Mehta and Schläpfer because Mehta's provisioning models have nothing to do with Schläpfer's descriptors and attributes. PO Resp. 52. Patent Owner further contents that Schläpfer and Mehta are non-analogous art. PO Sur-Reply 26.

Petitioner contends that the scope of the claimed "provisioning descriptors," read in light of the Specification, encompasses at least the disclosed embodiment of a content descriptor that is downloaded during provisioning and includes attributes such as name, size, and URL. Reply 25–26 (citing Ex. 1001, 13:28–33, 13:36–37); Pet. 68–69. Petitioner contends that the application descriptor of Schläpfer, which is sent to the mobile device during provisioning and includes attributes such as name, size, and URL, teaches "provisioning attributes and descriptors" as claimed. *Id*. at 25. Petitioner contends that a person of ordinary skill in the art would have known that provisioning models include a corresponding set of provisioning attributes and descriptors and would have looked to Schläpfer's teachings for guidance in implementing the provisioning attributes and descriptors. *Id*. at 28–29 (citing Ex. 1002 ¶ ¶ 140–41).

Analysis

We find that Schläpfer discloses an application descriptor that includes attributes such as name, size, and URL. Ex. 1009, 4–6, 4–7. We

find that Schläpfer discloses that the application descriptor is downloaded to a device during provisioning. *Id*. at 4–10, 4–11, 6–17, 6–18. We agree with Petitioner that the application descriptors and attributes described by Schläpfer teach the claimed "provisioning attributes and descriptors." We agree with Mr. Wechselberger and find that a person of ordinary skill in the art would have understood that the provisioning models taught by Mehta would include the provisioning attributes and descriptors taught by Schläpfer. Ex. 1002 ¶¶ 118, 140–41. We find that including the provisioning attributes and descriptors taught by Schläpfer in the provisioning models of Mehta "simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement," therefore, "the combination is obvious." *KSR*, 550 US at 417.

We find that the combination of Mehta and Schläpfer teaches this limitation of claim 5.

Claim 12 recites limitations similar to those found in claim 5. Petitioner contends that the combination of Mehta and Schläpfer teaches the limitations of claim 12 for the reasons given in its analysis of claim 5. Pet. 65. Patent Owner disagrees for the reasons given in Patent Owner's analysis of claim 5. PO Resp. 50–52.

We are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Mehta and Schläpfer renders obvious claims 5 and 12.

5. Claims 6 and 13

Claim 6 depends from claim 5 and recites "receiving from the subscriber a request for one of the items of digital content in said portion of

the product catalog." Petitioner contends that Mehta discloses this limitation for the reasons given in its analysis of claim 4. Pet. 56.

Claim 6 recites "identifying device capabilities of the wireless device used by the subscriber." Petitioner contends that Mehta discloses this limitation in describing determining the type and capabilities of the subscriber device. Pet. 56–57 (citing Ex. 1003 ¶¶ 64, 85).

Claim 6 recites "selecting one of a plurality of provisioning models associated with the requested item in the server system, based on the device capabilities of the wireless device used by the subscriber." Petitioner contends that Mehta discloses this limitation in describing that the MAS selects an appropriate provisioning model based on device capabilities. Pet. 57–58 (citing Ex. 1003 ¶¶ 89, 61, 64, 131).

Claim 6 recites "packaging the requested item according to the selected provisioning model." Petitioner contends that Mehta discloses this limitation in describing that during the provisioning process, the content can be packaged appropriate to the requesting device. Pet. 58 (citing Ex. 1003 ¶¶ 12, 15).

Claim 6 recites "provisioning the requested item in the wireless device used by the subscriber according to the selected provisioning model." Petitioner contends that Mehta discloses this limitation in describing that the application is provisioned for a specific device. Pet. 59–60 (citing Ex. 1003 ¶¶ 64, 66, 131, Fig. 3).

Claim 13 recites limitations similar to those recited in claim 6. Petitioner contends that Mehta teaches the limitations of claim 6 for the reasons given in Petitioner's analysis of claim 6. Pet. 65.

We are persuaded that Petitioner has shown that the combination of Mehta and Schläpfer renders obvious claims 6 and 13.

6. Claims 7 and 14

Claim 7 depends from claim 6 and recites "said packaging the requested item comprises creating a provisioning descriptor for the requested item according to the selected provisioning model, and associating the provisioning descriptor with the requested item." Petitioner contends that the combination of Mehta and Schläpfer teaches this limitation. Pet. 60–62. Petitioner contends that Mehta describes packaging content appropriate to the requesting device during the provisioning process, and that Schläpfer discloses provisioning applications accompanied by an application descriptor. *Id.* at 61 (citing Ex. 1003 ¶ 12; Ex. 1009, 78, 1112).

Claim 7 recites "said provisioning the requested item in the wireless device comprises sending the packaged requested item to the wireless device used by the subscriber according to a provisioning protocol associated with the selected provisioning model." Petitioner contends that Mehta discloses this limitation in describing sending the packaged application to the requesting subscriber device according to the determined protocol. Pet. 62–63 (citing Ex. 1003 ¶¶ 70, 134, Fig. 5).

Claim 14 recites limitations similar to those recited in claim 7. Petitioner contends that the combination of Mehta and Schläpfer teaches the limitations of claim 14 for the reasons given in Petitioner's analysis of claim 7. Pet. 65.

We are persuaded that Petitioner has showed that the combination of Mehta and Schläpfer renders obvious claims 7 and 14.

VIII. CONCLUSION

In summary, we determine a preponderance of the evidence establishes claims 1–14 of the '790 patent are unpatentable, as shown in the following table:[9]

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–4, 8–11	102	Mehta	1–4, 8–20	
1–14	103	Mehta, Schläpfer	1–14	
Overall Outcome			1–14	

[9] Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

IX. ORDER

It is hereby:

ORDERED that claims 1–14 of the ’790 patent have been proven by a preponderance of the evidence to be unpatentable; and

FURTHER ORDERED that, because this is a final written decision, parties to this 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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