UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner.

Case: IPR2023-00628
Patent No. 7,233,790 B2

PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 7,233,790 B2

Petition Filing Date: February 22, 2023

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EXHIBIT LIST

Exhibit Number	Description
1001	Patent-at-Issue: U.S. Patent No. 7,233,790 to Kjellberg, "Device Capability Based Discovery, Packaging and Provisioning of Content for Wireless Mobile Devices," filed on June 19, 2003 ("the '790 patent").
1002	Expert Declaration of Anthony Wechselberger.
1003	U.S. Patent Application Publication No. 2002/0131404 to Mehta, "Method and System for Maintaining and Distributing Wireless Applications," filed on November 28, 2001 ("Mehta").
1004	File History of the '790 patent (Application No. 10/600,746) ("'790 patent FH").
1005	U.S. Provisional Application No. 60/393,024.
1006	U.S. Provisional Application No. 60/392,383.
1007	U.S. Provisional Application No. 60/393,041.
1008	U.S. Provisional Application No. 60/392,999.
1009	C. Schläpfer, M. Kubik, and G. Zavagli, "Mobile Applications with J2ME," A White Paper, Ericsson Radio Systems AB, July 7, 2001 ("Schlapfer").
1010	U.S. Patent No. 7,283,811 to Gidron, "System and Method for Aggregation of User Applications for Limited-Resource Devices," filed on November 15, 2001 ("Gidron").
1011	U.S. Patent No. 7,266,369 to Moles, "System and Method for Provisioning or Updating a Mobile Station Using Over-The-Air Transfer of Interpreted Byte-Code Program," filed on April 4, 2000 ("Moles").
1012	U.S. Patent No. 8,107,937 to Jokinen, "System and Method for Automatic Provisioning Detection and Notification," filed on July

	31, 2001 ("Jokinen").
1013	U.S. Patent No. 7,093,198 to Paatero, "Skins for Mobile Communication Devices," filed on August 16, 2001 ("Paatero").
1014	U.S. Patent Application Publication No. 2002/0069263 to Sears, "Wireless Java Technology," filed on September 28, 2001 ("Sears").
1015	U.S. Patent Application Publication No. 2002/0124065 to Barritt, "Mobile Computing System Architecture," filed on August 6, 2001 ("Barritt").
1016	U.S. Patent Application Publication No. 2003/0101246 to Lahti, "System and Method for Identifying and Accessing Network Services," filed on November 29, 2001 ("Lahti").
1017	EP 1303153B1 to Chanrasiri, "Apparatus and method for selecting software modules in a mobile terminal," filed on October 8, 2002 ("Chanrasiri").
1018	*Starz Entm't, LLC v. VL Collective IP, LLC*, Amended Joint Claim Construction Chart, pages 1-14 (Dkt. 80).
1019	*Unwired Planet, LLC v. Apple, Inc.*, Joint Claim Construction Statement, pages 1-7 (Dkt. 199).
1020	*VideoLabs, Inc. v. Netflix Inc.*, Motion to Dismiss for Failure to State a Claim filed by Petitioner, pages 1-5 (Dkt. 15).
1021	*VideoLabs, Inc. v. Netflix Inc.*, Opening Brief in Support re Motion to Dismiss for Failure to State a Claim filed by Petitioner, pages 1-31 (Dkt. 16).
1022	*VideoLabs, Inc. v. Netflix Inc.*, Answering Brief in Opposition re Motion to Dismiss for Failure to State a Claim filed by Patent Owner, pages 1-32 (Dkt. 18).
1023	*VideoLabs, Inc. v. Netflix Inc.*, Reply Brief re Motion to Dismiss for Failure to State a Claim filed by Petitioner, pages 1-18 (Dkt. 19).
1024	M. Eyer, "The Challenge of a Standard Software API," 2000 NCTA

	Tech. Papers, pp. 242-253, May 7-10, 2000.
1025	*Starz Entm't, LLC v. VL Collective IP, LLC*, Claim Construction Order, pages 1-4 (Dkt. 88).

I. INTRODUCTION

Petitioner respectfully requests *Inter Partes* Review of claims 1-14 of U.S. Patent No. 7,233,790 (Ex. 1001), filed June 19, 2003 and assigned to VideoLabs, Inc. ("Patent Owner").

At its core, the '790 patent purports to cover the basic idea of using a product catalog to manage different versions of a given item of digital content destined for use on wireless devices whereby each version of content corresponds to a different set of wireless device capabilities. Unsurprisingly, this simple concept was well-known before the '790 patent. For example, all of four independent claims are anticipated by Mehta, which predates the '790 patent but was never considered by the Patent Office. The remaining claims contain minor variations on the theme, all of which were well-known in the art at the time of the purported invention. Thus, as described further in this Petition, the prior art renders every claim of the '790 patent anticipated or obvious and therefore unpatentable.

As demonstrated below, there is a high likelihood that Petitioner will prevail with respect to each of the challenged claims and, therefore, Petitioner respectfully requests that the Board institute trial. Please assess any fee deficiency or credit to Deposit Account No. 232405.

II. DISCRETIONARY ANALYSIS FOR REVIEW

There is no reason for the Board to discretionarily deny this petition. Petitioner hereby stipulates that, if the Board grants institution, it will not assert in the parallel district court proceeding a ground that was raised or could have reasonably been raised in this proceeding. When a petitioner presents such a stipulation, "the PTAB will not discretionarily deny institution in view of parallel district court litigation." *USPTO Director's Memorandum: Interim Procedure For Discretionary Denials In AIA Post-Grant Proceedings With Parallel District Court Litigation* at 3, 7 (June 21, 2022); *see also Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13-14 (PTAB Dec. 1, 2020).

A. *Fintiv* Factors

The *Fintiv* factors do not weigh in favor of denying institution of trial in this matter. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

For example, while no motion to stay pending IPR has yet been filed in the Delaware district court case, *Fintiv* factor one is neutral given that courts commonly stay cases upon IPR institution. *VMWare, Inc. v. Intell. Ventures II LLC*, IPR2020-00859, Paper 13 at 12 (PTAB Nov. 5, 2020) (finding factor one neutral, even though Petitioner had not previously sought a stay, and despite Patent

Owner's argument that the district court judge was "unlikely" to issue a stay pending IPR institution).

Fintiv factors two (trial date), three (investment in proceedings), and four (overlap of issues) all weigh against the Board's exercising its discretion to deny institution. The Delaware district court case is in its infancy: there have been no infringement or invalidity contentions, or claim construction exchanges or briefing; the initial case management conference has yet to be held; a claim construction hearing has not been calendared; and the trial date has yet to be set. Petitioner filed a partial motion to dismiss, including for lack of patentable subject matter under 35 U.S.C. § 101, on June 10, 2022. Exs. 1020-1023. A hearing on that motion took place on February 9, 2023, and a decision is pending.

Fintiv factor five has no weight because Petitioner and Patent Owner are the same parties as in the district court. *Weatherford U.S. v. Enventure Global Tech., Inc.*, IPR2020-01684, Paper 16 at 11–13 (PTAB Apr. 14, 2021). *Fintiv* explained that "it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding." *Fintiv*, IPR2020-00019, Paper 11 at 11. Here, Petitioner filed this Petition even before that, as Patent Owner has yet to serve contentions fully identifying the purportedly infringed claims. Accordingly, Petitioner has been diligent in pursuing

its Petition; this too weighs against the Board's exercising its discretion to deny institution.

Finally, *Fintiv* factor six (other circumstances) does not weigh in favor of denying institution. This Petition is strong on the merits and demonstrates that all claims of the '790 patent are rendered anticipated or obvious.

Considering the *Fintiv* factors overall, institution would best serve the efficiency and integrity of the system.

B. *Becton Dickinson*/*Advanced Bionics*/*General Plastics* Factors

Denying institution under 35 U.S.C. § 325(d) would not be appropriate here, because the grounds and arguments relied on by this Petition were not previously presented to the Patent Office. None of the relied-upon art was considered during prosecution. This is the only IPR filed against the challenged claims.

Further, because this is Petitioner's first petition against the '790 patent, the *General Plastic* factors do not weigh against institution. *See General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, 16 (PTAB Sept. 6, 2016) (precedential).

III. PATENT OVERVIEW AND PRIORITY DATE

A. Background of Digital Content Provisioning Systems for Wireless Communication Devices[1]

Content provisioning systems for wireless communication devices were hardly new by the early 2000s. By the turn of the millennium, the popularity of such devices (*e.g.*, cellular phones) had significantly increased, and applications (*e.g.*, audio and/or video applications) for these devices became much more common. Ex. 1011, 1:44-46, 1:66-2:3; Ex. 1001, 1:32-45.

Various techniques for provisioning digital content to a wireless device over a wireless network existed prior to 2002. Others had already described a technique for automatically detecting unprovisioned devices in a wireless network and subsequently initiating provisioning procedures. Ex. 1012, 2:47-51. Additionally, the art already included a technique for provisioning user applications to a wireless device through an integrated platform that handled all aspects of aggregation and management of such applications. Ex. 1010, 2:64-3:8.

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[1] This background, and the Grounds of Unpatentability herein, are further supported by the Declaration of Petitioner's expert, Anthony Wechselberger, who has over forty years of experience related to digital content management systems. Ex. 1002.

Those in the art also recognized that users' wireless (and wired) devices had different sets of capabilities. Ex. 1003, [0085]; Ex. 1010, 2:23-32; Ex. 1012, 12:4-12; Ex. 1024, pp. 243, 248, 250-252. Accordingly, those in the art would have recognized the feasibility of an integrated content provisioning system to provide appropriate digital content corresponding to the capabilities of the user's wireless device. Ex. 1003, [0005], [0085]; Ex. 1010, 2:23-32, 2:64-3:8.

B. Summary of the Alleged Invention of the '790 Patent

The '790 patent, filed June 19, 2003, summarizes the invention as "a method and apparatus for providing access to content for use on wireless communication devices." Ex. 1001, Summary of the Invention. According to the patent, multiple items of content are stored in a server system and made available for use in wireless communication devices used by wireless services subscribers. *Id*.; *see also id.*, Abstract. Every independent claim of the '790 patent requires maintaining a product catalog that includes a description of multiple items of content and references to different versions of each item of content, where each version corresponds to a different set of device capabilities. *Id*.; *see also id*., Cls. 1, 2, 8, 9.

More specifically, the patent describes a download manager 1, which acts as an intermediary between multiple content suppliers 2 and multiple customers 3. *Id*., 4:11-15, Fig. 2. The download manager 1 includes a product manager 32 that interfaces with various content suppliers and provides centralized product

cataloging. *Id*., 6:46-52. The product manager 32 determines, from a product catalog 54, which products are supported by the client device based on the capabilities of the client device. *Id*., 12:9-13. The download manager 1 includes a device capability manager 37 that conducts device recognition and device capability determination and management. *Id*., 7:31-39.

Figure 3 (reproduced below) from the patent illustrates these elements along with other elements such as a provisioning manager 28.

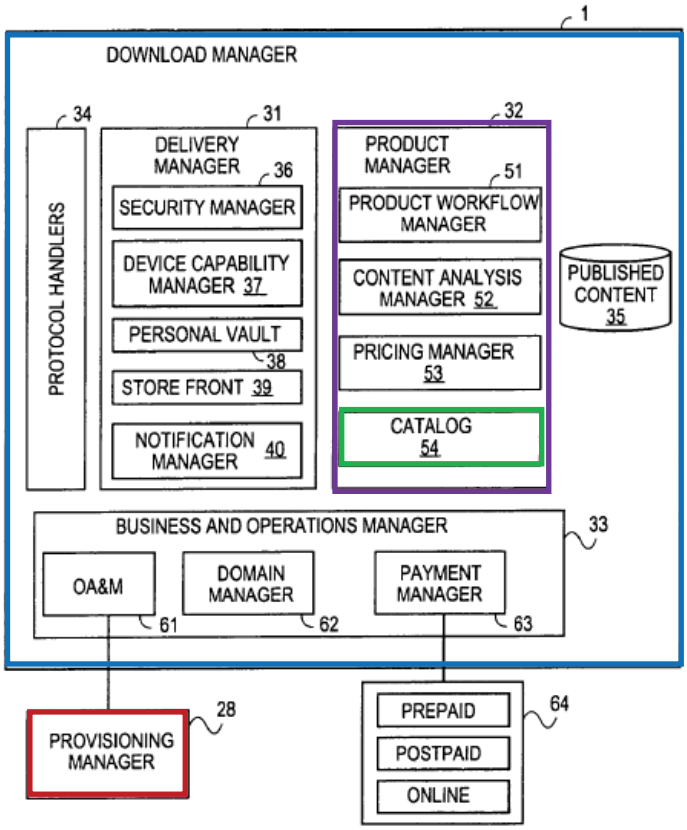

FIG. 3

Ex. 1001, Fig. 3 (annotated).

Upon receiving a request for an item of content from a client device, the provisioning manager 28 downloads the content using a provisioning protocol of the selected provisioning model. *Id*., 13:39-44; *see also* Ex. 1002, ¶¶ 50-54.

C. Representative Claims

Claim 2 is representative of the issues for this petition and is reproduced below with the claim elements.

U.S. Patent No. 7,233,790, Claim 2
2[pre] A method of providing access to digital content for use on wireless communication devices, the method comprising:
2[a][1] 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,
2[a][2] 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;
2[b] 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;
2[c] receiving a request from a wireless device used by one of the subscribers;
2[d] 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
2[e] 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.

Claim 2 and its dependent claims are representative of independent claims 1, 8, and 9, and dependent claims of claim 9. For example, independent claim 9 and

its dependent claims are similar to claim 2 and its dependent claims, except that claim 9 and its dependent claims are written in apparatus form.

Claim 9	Representative Claim 2
9[pre] A system comprising:	See corresponding evidence for element 2[pre] (if preamble limiting)
9[a] a processor; and	Evidence for this limitation is separately provided in element 9[a]
9[b][1] a storage facility accessible to the processor and containing code which, when executed by the processor, causes the processing system to receive and store a plurality of items of digital content to be made available for use in wireless communication devices used by a plurality of wireless telecommunications subscribers,	See corresponding evidence for element 2[a][1]; evidence for the limitation of "a storage facility" is separately provided in element 9[b][1]
9[b][2] 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;	See corresponding evidence for element 2[a][2]
9[c] 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;	See corresponding evidence for element 2[b]

Claim 9	Representative Claim 2
9[d] receive a request from a wireless device used by one of the subscribers;	See corresponding evidence for element 2[c]
9[e] in response to the request, select 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	See corresponding evidence for element 2[d]
9[f] cause the selected portion of the product catalog to be presented to the subscriber via a wireless telecommunications 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.	See corresponding evidence for element 2[e]

Likewise, independent claim 1 is similar to claim 2, but facially broader in claim scope.

Claim 1	Representative Claim 2
1[pre] A method of providing access to content for use on wireless communication devices, the method comprising:	See corresponding evidence for element 2[pre] (if preamble limiting)
1[a][1] receiving and storing a plurality of items of content to be made available for use in wireless communication devices used by a plurality of wireless services	See corresponding evidence for element 2[a][1]

Claim 1	Representative Claim 2
subscribers,	
1[a][2] including receiving a plurality of different implementations of at least one of the items of content, where each implementation of any given item of content corresponds to a different set of device capabilities; and,	See corresponding evidence for element 2[a][2]
1[b] maintaining a product catalog containing a description of the items of content, the product catalog including, in association with each item of content, a reference to each implementation of said item of content.	See corresponding evidence for element 2[b]

Independent claim 8 is similar to claim 2, but written in apparatus form and facially broader in claim scope.

Claim 8	Representative Claim 2
8[pre] A system comprising:	See corresponding evidence for element 2[pre] (if preamble limiting)
8[a] a network interface through which to communicate over a communication network; and	Evidence for this limitation is separately provided in element 8[a]
8[b][1] a download manager to receive and store a plurality of items of content to be made available for use in wireless communication devices used by a plurality of wireless	See corresponding evidence for element 2[a][1]; evidence for the limitation of "a download manager" is separately provided in

Claim 8	Representative Claim 2
telecommunications subscribers,	element 8[b][1]
8[b][2] including receiving a plurality of different implementations of at least one of the items of content, where each implementation of any given item of content corresponds to a different set of device capabilities; and,	See corresponding evidence for element 2[a][2]
8[c] maintain a product catalog containing a description of the items of content, the product catalog including, in association with each item of content, a reference to each implementation of said item of content.	See corresponding evidence for element 2[b]

D. The Prosecution History

The '790 patent issued from U.S. Patent Application No. 10/600,746 ("'746 Application"), filed June 19, 2003, which claimed priority to the June 28, 2002 filing of U.S. Provisional Application Nos. 60/393,024 (Ex. 0005; "the '024 provisional application"), 60/392,383 (Ex. 0006; "the '383 provisional application"), 60/393,041 (Ex. 0007; "the '041 provisional application"), and 60/392,999 (Ex. 0008; "the '999 provisional application"). *See* Ex. 1001, Field 22, 60.

The Examiner indicated that method claims 5-8 and 10-11 were allowable in the first office action. Ex. 1004, 65. In response, Patent Owner amended the remaining claims to embrace the allowable claims. The Patent Owner cancelled claims 1-4, changed dependency of claim 9, and added new claims 12-18 that recite limitations substantially similar to the allowable method claims in apparatus format. *Id*., 52-57.

As the reasons for allowance, the Examiner relied on the prior art failing to disclose "receiving and storing a plurality of different implementations of the items of content" and the art's failure to "teach maintaining a catalog describing the items of content." *Id*., 43.

E. Priority Date (June 19, 2003)

Patent Owner is not entitled to priority to an application before the June 19, 2003 filing date of the '790 patent.[2] Although the applicants, during prosecution, claimed priority to the June 28, 2002 filing date of the '024, '383, '041, and '999 provisional applications, applicants never demonstrated that the provisional applications actually support the issued claims of the '790 patent. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015)

[2] The references used in Grounds 1 and 2 are prior art to both the alleged June 28, 2002, and proper June 19, 2003 priority dates.

("[B]ecause the PTO does not examine provisional applications as a matter of course[,] such a presumption is . . . not justified" for patents that seek to claim the benefit of a provisional application). Nor do the provisional applications actually support such a claim.

For example, the provisionals do not contain supporting disclosure of "the product catalog including, in association with each item of content, *a reference* to each implementation of said item of content" as recited in claims 1, 2, 8, and 9 (emphasis added). The '041 and '999 provisional applications mention a "product catalog," but fail to disclose that the "product catalog" includes a reference to each implementation of the item of content. *See, e.g.*, Ex. 0007, 5, Ex. 0008, 4. Further, Patent Owner never demonstrated that the provisional applications contain supporting disclosure of "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" as recited in claims 2 and 9 (emphasis added).

Because the claimed priority applications fail to describe, least the limitations discussed above prior to June 19, 2003, and because those limitations permeate the claims that are the subject of this Petition, Patent Owner cannot claim priority to an application before this date. *See Res. Corp. Techs., Inc. v. Microsoft*

Corp., 627 F.3d 859, 869-70 (Fed. Cir. 2010) ("Entitlement to a filing date extends only to subject matter that is disclosed.").

F. Level of Ordinary Skill in the Art

A person of ordinary skill in the art on the priority date for the '790 patent ("POSITA") would have had 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. 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). Ex. 1002, ¶ 26.

IV. IDENTIFICATION OF PRIOR ART

A. U.S. Patent Application Publication No. 2002/0131404 to Mehta (Ex. 1003)

Mehta is prior art under pre-AIA § 102(a) and (e) because it was filed on November 28, 2001 and published on September 19, 2002. Mehta was not disclosed to or considered by the Patent Office during prosecution of the '790 patent.

Mehta is directed to computer- and network-based methods and systems for maintaining and provisioning wireless applications to wireless devices. Ex. 1003, [0005], [0059], Abstract. Mehta teaches a Mobile Application System ("MAS")

that maintains and distributes wireless applications and other content to wireless subscriber devices over a wireless network. *Id*., [0059-60]. Figure 1, reproduced below, shows a block diagram that illustrates how subscribers 101, 101b of wireless services request and download software applications from the MAS 105:

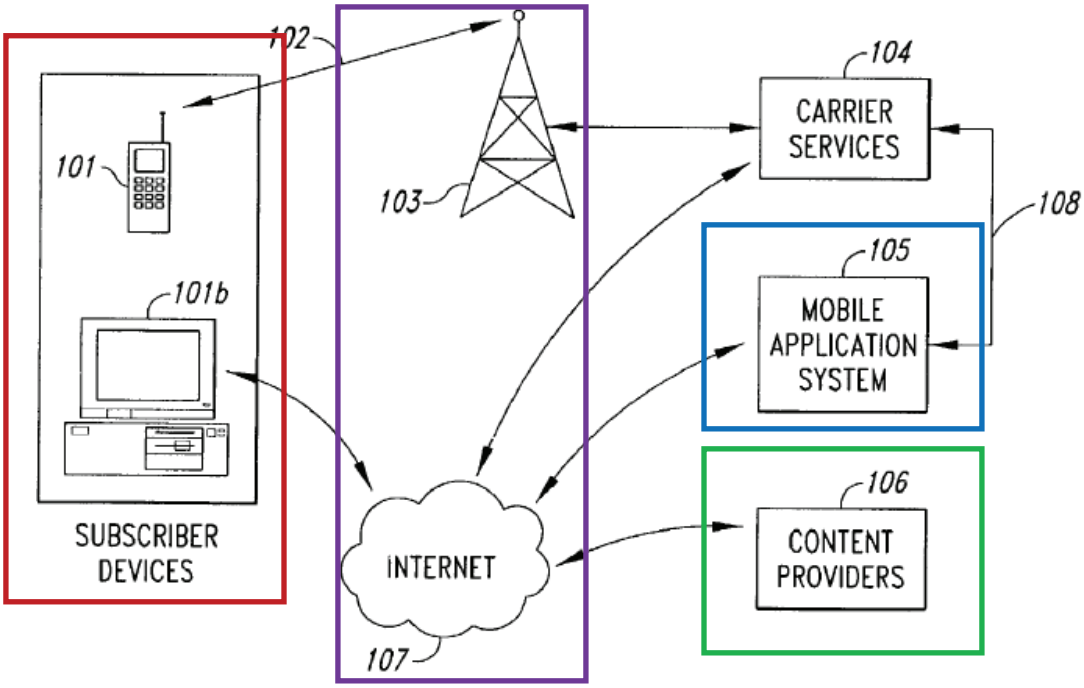

Fig. 1

Ex. 1003 (Mehta), Fig. 1 (annotated).

Even the most cursory comparison of Mehta with the '790 patent (Fig. 2 reproduced below) confirms the striking similarities of the respective disclosures:

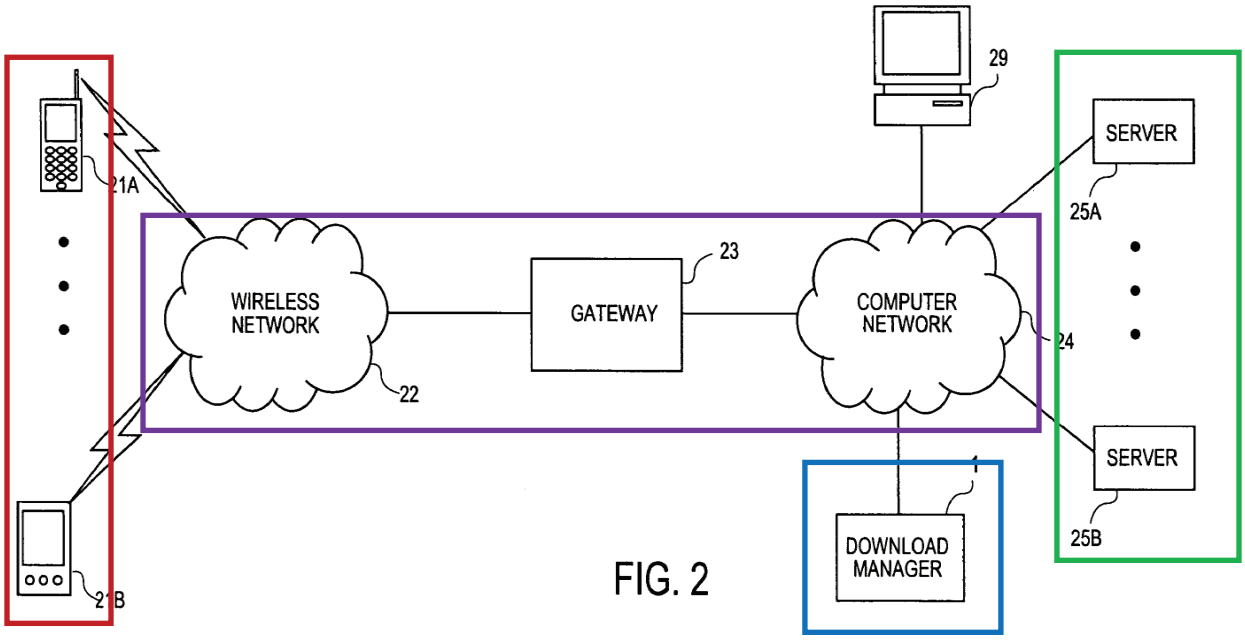

FIG. 2

Ex. 1001 ('790 patent), Fig. 2 (annotated).

Mehta's MAS "determines the type and capabilities of the subscriber device from which the request was made and determines whether the device capabilities are sufficient to support a specific application." Ex. 1003, [0085]. Specifically, the MAS analyzes various profiles such as "a subscriber profile, a device profile, and an application profile" stored in "a data repository" to ensure that a specific application can execute successfully on the subscriber device. *Id*., [0005], [0067], [0099]. Upon receiving a request from the subscriber, the MAS determines an initial list and "filters this initial list based upon subscriber and device capabilities" to select an appropriate version of the requested item from the initial list. *Id*., [0067]. Subsequently, the MAS "provisions and packages the requested

application, and sends the packaged application to the requesting subscriber device." *Id*., [0070]; *see also* Ex. 1002, ¶ 37-40.

B. A Paper entitled "Mobile Applications with J2ME" to Schlapfer (Ex. 1009)

Schlapfer is prior art under, least pre-AIA § 102(a) because it was published on July 7, 2001.[3] Schlapfer was not disclosed to or considered by the Patent Office during prosecution of the '790 patent.

Schlapfer is a paper that discusses Java technology related to mobile devices and applications as of July 2001. Ex. 1009, 3. Specifically, it describes Java 2 Micro Edition ("J2ME") as a platform for "[s]ervice providers who wish to deliver content to their customers over resource-constrained devices." *Id*., 4. Schlapfer teaches that such mobile devices "have a small display ... and are capable of communicating via a mobile network with limited bandwidth." *Id*., 7.

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[3] *See* Ex. 1009, 26. Schlapfer was cited in EP 1303153B1 (Ex. 1017, field (56)) ("SCHLÄPFER, KUBIK, ZAVAGLI: 'Mobile Applications with J2ME A White Paper' [Online] 7 July 2001 (2001-07-07) , ERICSSON RADIO SYSTEMS XP002223102 Retrieved from the Internet: < URL: http://www.ericsson.co.th/mobilityworld/Ja va/White_Paper.pdf> [retrieved on 2002-11-29] chapters 1,2,3,4.1-4.5,5.4").

Section 4.4 of Schlapfer discloses the provisioning of MIDlets that are applications written according to the Mobile Information Device Profile for the J2ME Platform ("MIDP"). *Id*., 7, 11, 12. A number of MIDlets can be contained in a single jar file, which is called a MIDlet suite. *Id*., 7. A jar file is optionally accompanied by an application descriptor. *Id*. An application descriptor is a text file containing selected information from the manifest file, together with the total size of the jar file. *Id*. The file extension of this application descriptor is .jad, and includes mandatory attributes such as name, version, vendor, URL, and size. *Id*., 7, 8; *see also* Ex. 1002, ¶¶ 41-43.

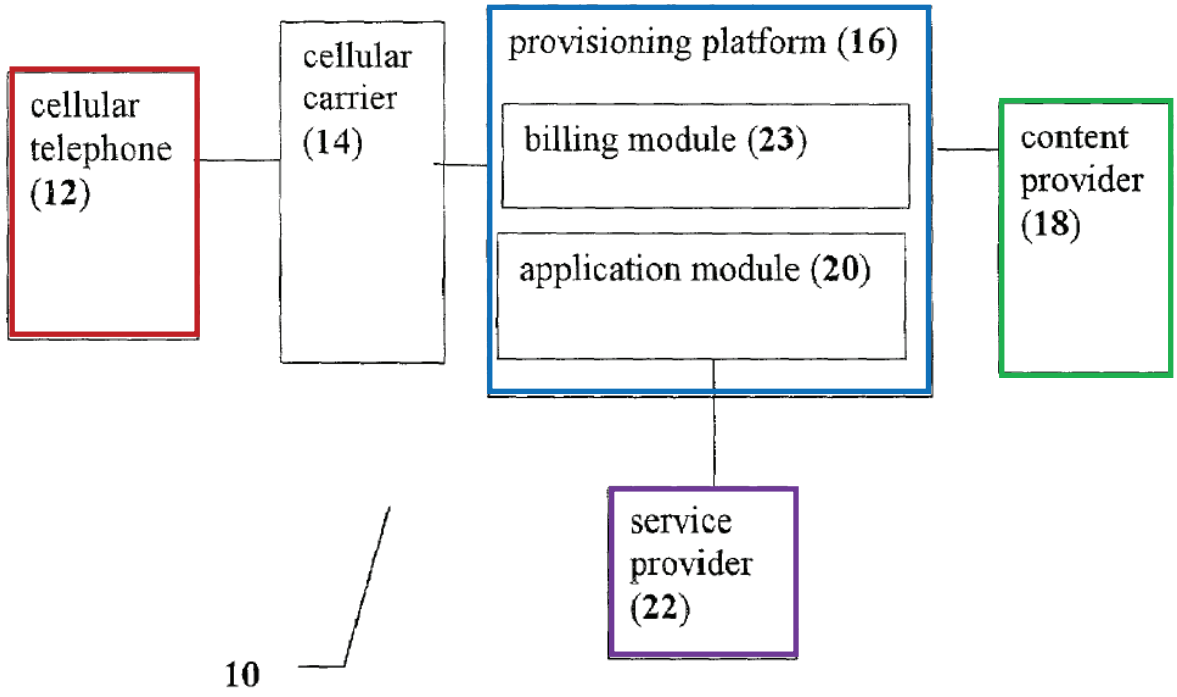
C. Other Evidence Regarding the State of the Art

The prior art in Exs. 1010-1016 further demonstrates the state of the art, level of ordinary skill in the art, common knowledge in the art, and/or common sense in the art, and is therefore also relevant to the background of the invention and the invalidity analysis herein. *See also* Ex. 1002, ¶¶ 33-36, 44-49. For example, Gidron (U.S. Patent No. 7,283,811, Ex. 1010)[4] teaches an integrated

[4] The face of the '790 patent identifies U.S. Patent Publication No. 2003/0060188 to Gidron (filed on February 21, 2002) as a reference considered by the examiner; this Publication is a continuation-in-part of the Gidron patent (filed on November 15, 2001) cited herein.

platform that handles aggregation and management of applications from content providers to be delivered to users' wireless devices. Ex. 1010, 1:12-22, 2:58-3:17, Abstract, cl. 2. Figure 2, as reproduced below, shows a block diagram of Gidron's integrated system 10, including content provider 18, service provider 22, user 12 of wireless services, and provisioning platform 16.

Figure 2



Ex. 1010, Fig. 2 (annotated), *see also id*., 6:64-7:37.

Gidron discloses that the service provider 22 controls access by the user to the content or user applications according to *capabilities of the user's device 12* (*id*., Abstract); the content provider 18 optionally specifies *different versions of the application* to be automatically downloaded according to the location of the user's device 12 (*id*., 8:13-19); the system 10 collects information such as *the identity of*

the user's device 12 (*id*., 10:28-39); the provisioning platform 16 includes *an application repository 20* where user applications are organized with information about the available applications (*id*., 8:41-43); and each user *only views application(s)* that are suitable for the particular service package to which the user is subscribed (*id*., 9:32-38) (emphasis added).

Gidron is prior art under pre-AIA §§ 102(a) and (e) because it was filed on November 15, 2001 and issued on October 16, 2007.

V. IDENTIFICATION OF CHALLENGE AND RELIEF REQUESTED

Petitioner requests *Inter Partes* Review of claims 1-14 of the '790 patent and requests that the Board find these claims to be unpatentable based on the following specific statutory grounds and prior art.

Ground 1: U.S. Patent Application Publication No. 2002/0131404 to Mehta (Ex. 1003) anticipates claims 1-4 and 8-11 under § 102.

Ground 2: U.S. Patent Application Publication No. 2002/0131404 to Mehta (Ex. 1003) in view of a published paper entitled "Mobile Applications with J2ME" to Schlapfer (Ex. 1009) renders obvious claims 1-14 under § 103(a).

VI. CLAIM CONSTRUCTION

The Board construes claims "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). Under this standard, the words of a claim generally are given

their "ordinary and customary meaning," which is the meaning the term would have to a person of ordinary skill, the time of the invention, in the context of the entire patent including the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

For this IPR, Petitioner applies the plain and ordinary meaning of all claim terms and contends that no claim terms require specific construction to resolve the unpatentability issues presented herein.[5] *See, e.g.*, *Aurobindo Pharma USA, Inc. v. Andrx Corp.*, IPR2017-01648, Paper 34, 11 (PTAB Dec. 28, 2018) (citing *Nidec Motor Corp. v. Zhongshan Borad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017)).

Patent Owner apparently agrees with this approach. In a related district court proceeding, Patent Owner applied the plain and ordinary meaning of all

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[5] Petitioner does not, however, waive any argument in any litigation. The parallel Delaware district court case is in its infancy, and there have been no claim construction exchanges, infringement contentions, or claim construction briefing. Petitioner does not set forth here arguments regarding claim construction disputes not properly addressed in this forum, such as those related solely to non-infringement, indefiniteness, lack of written description, and inoperability. 35 U.S.C. §§ 101 and 112.

claim terms of the '790 patent without requiring specific construction while the opposing party proposed constructions for some terms. There, the parties fully briefed the constructions of the disputed terms. *Starz Entm't, LLC v. VL Collective IP, LLC*, Amended Joint Claim Construction Chart, pages 5-7 (Dkt. 80), Case No. 1:21-cv-01448 (D. Del.) (Ex. 1018). A claim construction order has issued, as summarized in the table below. *Starz Entm't, LLC v. VL Collective IP, LLC*, Claim Construction Order, pages 2-3 (Dkt. 88), Case No. 1:21-cv-01448 (D. Del.) (Ex. 1025).

Claim Term	**Patent Owner's Proposed Construction**	**Opposing Party's Proposed Construction**	**Court's Claim Construction Order**
"wireless communication devices"/"wireless device" [Claims 1, 2, 4, 5, 6, 7, 8, 9]	No construction necessary Alternatively, if the Court decides to construe the term, "an electronic or electrical device capable of remote wireless communication, including Internet access"	"Personal mobile communication and computing devices, such as cellular telephones, personal digital assistants (PDAs) and two-way pagers"	No construction necessary (not restricted to "personal mobile devices")
"content"/"digital content"/"product"/ "digital product" [Claims 1, 2, 4, 5,	No construction necessary Alternatively, if the Court decides	"Software and/or data embodying a file for purchase by a wireless services subscriber and/or	"software and/or data embodying a file for delivery or purchase"

6, 8, 9]	to construe the term, "software and/or data embodying a file for delivery or purchase by a customer"	telecommunications subscriber"	
"implementation" [Claims 1, 2, 4, 8, 9]	No construction necessary	"One or more binary files (or "binaries"), software applications, and/or executable files representing a product"	"one or more binary files (or "binaries"), software files, software applications, and/or executable files representing a product"

Similarly, in another related district court proceeding involving the '790 patent, neither Patent Owner nor the opposing party offered a specific construction of any claim term from the patent. *Unwired Planet, LLC v. Apple, Inc.*, Joint Claim Construction Statement, pages 2-3 (Dkt. 199), Case No. 3:13-cv-04134-VC (N.D. Cal.) (Ex. 1019).

Petitioner notes that the asserted prior art references teach all the elements of the challenged claims under any of the above-discussed constructions, as set forth *infra* in Section VII.

VII. GROUNDS OF UNPATENTABILITY

A. Ground 1: Mehta Anticipates Claims 1-4 and 8-11 of the '790 Patent

Mehta discloses each limitation of claim 1, as explained below.[6]

1. Claim 1

a. 1[pre]: "A method of providing access to content for use on wireless communication devices, the method comprising:"

To the extent the preamble is limiting, Mehta discloses this element. Specifically, Mehta discloses "methods and systems" (*e.g.*, "a Mobile Application System (MAS)") for "provid[ing] applications, resources, and other content to mobile subscriber devices, such as wireless devices." Ex. 1003, [0005]; *see id.*, [0002], [0059], [0103], Abstract. The MAS may be "on one or more general purpose computer systems and wireless networks." Ex. 1003, [0127]; Ex. 1002, ¶ 63.

Mehta discloses that "the subscriber devices 101 comprise electronic devices capable of communication over wireless network 102, such as wireless handsets, phones, electronic organizers, personal digital assistants, portable e-mail machines, game machines, pages, navigation devices, etc." Ex. 1003, [0062]. Thus, Mehta

[6] While independent claim 2 is representative of independent claims 1, 8, and 9, Petitioner addresses claim 1 first for the convenience of the Board's review.

satisfies element 1[pre] under any of the constructions for "wireless communication devices" (and "wireless device") discussed *supra* in Section VI.

Further, Mehta discloses that applications or other content to be provided to mobile subscriber devices include, for example, games, text, graphics, audio, and video. *Id*., [0059-0060]. Thus, Mehta satisfies element 1[pre] under any of the constructions for "content" (and "digital content," "product," and "digital product") discussed *supra* in Section VI.

b. 1[a][1]: "receiving and storing a plurality of items of content to be made available for use in wireless communication devices used by a plurality of wireless services subscribers,"

Mehta discloses this element. Mehta explains that "[t]he MAS is a collection of interoperating server components that work individually and together in a secure fashion []." Ex. 1003, [0059]. The MAS "receive[s] applications from content providers and carrier services, to provision them for delivery to the subscriber devices." *Id*., [0068]. The applications received by the MAS corresponds to "a plurality of items of content" of claim 1. This is in perfect accord with the '790 patent, the specification of which counsels that "[a]s used in this description, the terms 'digital content', 'digital product', 'content', and 'product' are used interchangeably and mean software and/or data embodying things such as games and other applications, applets or the like; images;

screensavers; wallpaper; ring tones; etc[].” Ex. 1001, 3:48-56. The MAS may store the received applications “locally in a carrier’s application data repository [] which may be located in the MAS.” Ex. 1003, [0064].

Further, in Mehta, the subscriber devices 101 communicate across the wireless network 102 to the wireless carrier services 104, whose services the subscriber has arranged to use. *Id*., [0062]; Ex. 1002, ¶ 64.

c. <u>1[a][2]: “including receiving a plurality of different implementations of at least one of the items of content, where each implementation of any given item of content corresponds to a different set of device capabilities; and,”</u>

Mehta discloses this element. With respect to “implementations,” the specification of the ’790 patent states that “[a]n implementation 57 can be simply a binary file (a ‘binary’) representing the product.” Ex. 1001, 9:40-42. The ’790 patent specification also states that “any particular product may have multiple implementations published on the download manager, each of which may be designed for a different specific client device or set of client devices.” *Id*., 9:45-48. Claim 1 recites that “each implementation . . . corresponds to a different set of device capabilities.” *Id*., Cl. 1. In view of the intrinsic evidence discussed above, a POSITA would understand that “implementations” of claim 1 would include versions of a digital content, where each version corresponds to a different set of

device capabilities, which is consistent with the claim constructions discussed *supra* in Section VI. Ex. 1002, ¶ 65.

Mehta discloses that the MAS "receive[s] applications from content providers and carrier services" (Ex. 1003, [0068]) and "store[s] and support[s] *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" (*id*., [0098]) (emphasis added). The MAS receives, stores and supports functionally equivalent programs capable of running on multiple kinds of devices because each program corresponds to a different device having different device capabilities (*e.g.*, written using different languages). *Id*., [0098]. Further, Mehta describes that "[t]he device capability is also examined to determine whether the requested application can be run satisfactorily on the subscriber device." *Id*., [0064]; Ex. 1002, ¶ 66. For these reasons, Mehta expressly discloses element 1[a][2].

d. <u>1[b]: "maintaining a product catalog containing a description of the items of content, the product catalog including, in association with each item of content, a reference to each implementation of said item of content."</u>

Mehta discloses this element. Mehta discloses that the MAS includes "a data repository" that "store[s]" applications. Ex. 1003, [0064]. Mehta also discloses that "the content provider may include *a name and a short description of*

the application" that are stored in the data repository. *Id*., [0098] (emphasis added); *see also id*. ("additional information from the content provide[r] about the application . . . becomes part of an application profile when the application is approved"); *see also id*., [0099] ("the data generated during the inspection process to create an application profile, which is stored and maintained in a data repository"). "[T]he MAS searches a data repository of published applications for those that meet criteria specified in the [subscriber] request." *Id*., [0067]. Thus, "a data repository" of Mehta stores applications along with associated information (*e.g.*, a name and a short description) of the applications and provides a search function to find applications that meet criteria specified in the subscriber request. In view of these teachings of Mehta, a POSITA would have understood that Mehta's "data repository" is essentially identical to the '790 patent's "product catalog containing a description of the items of content" of claim 1. Ex. 1002, ¶ 67.

With respect to "a reference to each implementation of said item of content" of claim 1, the specification of the '790 patent states that "[h]ence, any particular product entry in the catalog 54 can include references to multiple implementations of the product." Ex. 1001, 9:49-51. Mehta discloses that "designating a URL [] identifies a file (an application or service) to download." Ex. 1003, [0064]; *see also id*., [0097] ("a content provider . . . enters *a reference* to the location of a file

(e.g., a URL or other location *reference*) that the content provider desires to submit") (emphasis added). A POSITA would have understood that Mehta's use of "a URL" or "other location reference" would correspond to "a reference to each implementation of said item of content" of claim 1 because "a URL" or "other location reference" of Mehta provides a reference to each application to be downloaded from the MAS. Ex. 1002, ¶ 68.

2. Claim 2

a. 2[pre]: "A method of providing access to digital content for use on wireless communication devices, the method comprising:"

To the extent the preamble is limiting, Mehta discloses this element. The evidence described for element 1[pre] of Ground 1 meets element 2[pre].

b. 2[a][1]: "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,"

Mehta discloses this element. The evidence described for element 1[a][1] of Ground 1 meets element 2[a][1].

c. 2[a][2]: "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;"

Mehta discloses this element. The evidence described for element 1[a][2] of Ground 1 meets element 2[a][2].

d. 2[b]: "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;"

Mehta discloses this element. The evidence described for element 1[b] of Ground 1 meets element 2[b].

e. 2[c]: "receiving a request from a wireless device used by one of the subscribers;"

Mehta discloses this element. Mehta's Figure 1 "illustrates how subscribers of wireless services request and download software applications from a Mobile Application System." Ex. 1003, [0061]. As can be seen in Fig. 1 reproduced below, the MAS 105 receives a request from a wireless device 101. *Id*., [0060], [0061]; *see also id*., [0064] ("Steps 301-408 demonstrate how the MAS handles an incoming request to download an application from a subscriber device . . .").

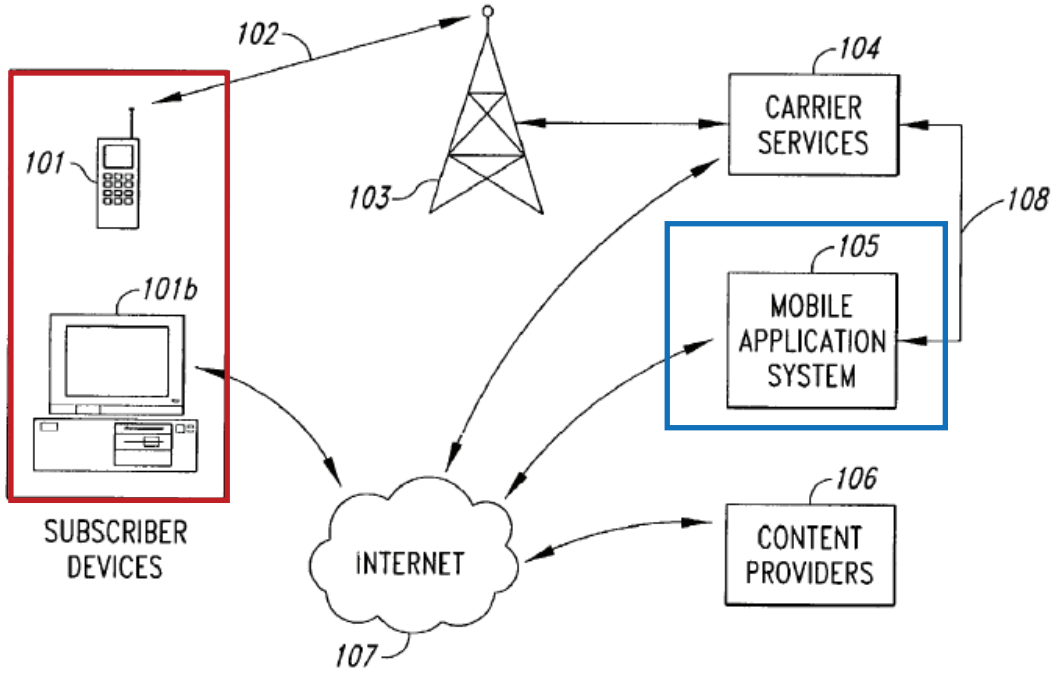


Fig. 1

Ex. 1003, Fig. 1 (annotated); Ex. 1002, ¶ 73.

f. 2[d]: "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"

Mehta discloses this element. Mehta discloses that "[t]he device profile contains information relevant to *the capabilities of the subscriber device* such as memory capacity, processor type, processing speed, maximum size of a downloadable application, etc." Ex. 1003, [0139] (emphasis added). Upon receiving a request from the subscriber, the MAS determines an initial list and "*filters this initial list based upon subscriber and device capabilities*" (as shown in

step 404 of Fig. 4; reproduced below) to select a portion of the initial list to be presented to the subscriber. *Id*., [0067] (emphasis added); Ex. 1002, ¶ 74. During this process, the MAS analyzes various profiles such as "a subscriber profile, a device profile, and an application profile" stored in the data repository to determine whether an application version, as reflected in the application profile, meets the device requirements, as reflected in the device profile. Ex. 1003, [0067]. Thus, Mehta expressly discloses that in response to a request from the subscriber, the MAS selects a portion of the initial list to be presented to the subscriber based on the subscriber's device capabilities.

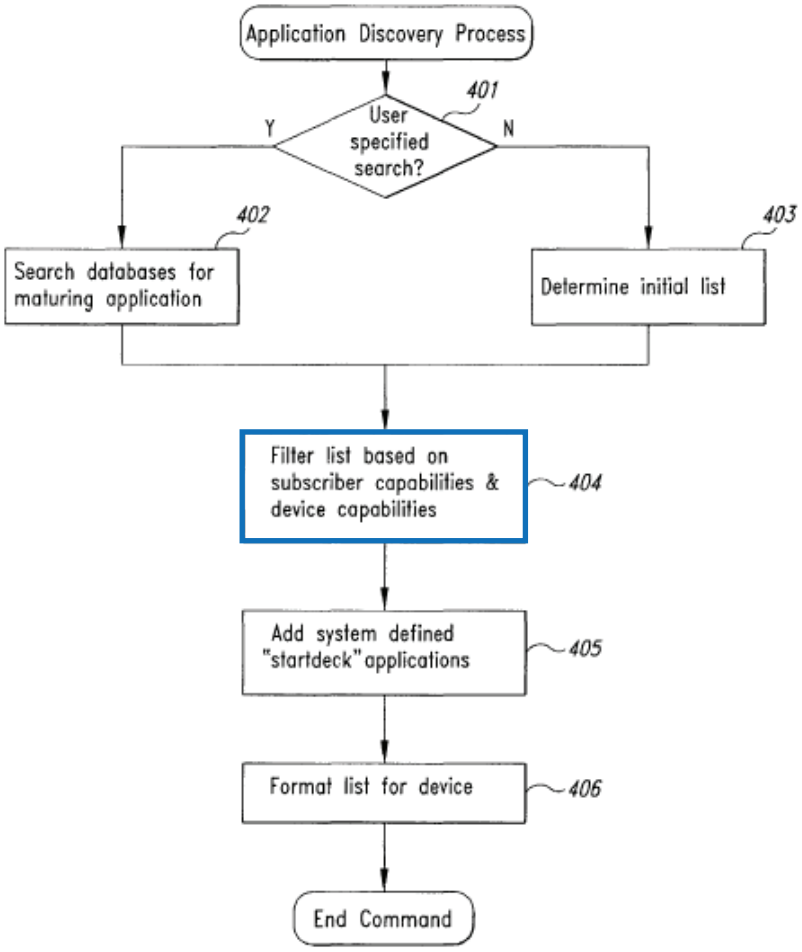


Fig. 4

Ex. 1003, Fig. 4 (annotated); Ex. 1002, ¶ 74.

g. 2[e]: "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."

Mehta discloses this element. Mehta discloses that "application discovery returns a list of content that can be downloaded that match criteria that are designated by the subscriber." Ex. 1003, [0006]. As part of the verification process, Mehta describes that "the list provided to the subscriber device during application discovery is filtered to display only content that has been verified according to these procedures" (*id*., [0007]), the procedures described include "verifying that the device can support the API and resource requirements of the content" (*id*.), and "the MAS *only lists those applications that are supported by the subscriber's device*" (*id*., [0117] (emphasis added)). *See also* Ex. 1002, ¶ 75.

Further, "a subscriber browses to a site on a network, such as the Internet, and specifies a request to download content at a particular address, for example, a URL." Ex. 1003, [0009]. "[T]he MAS provisions content for the subscriber … the requested content is also verified for the subscriber's device to increase the likelihood that the content will execute properly on the device." *Id*. Finally, "the MAS provides a command interface to the system, which supports application discovery, content downloading, and content downloading history." *Id*., [0016]; Ex. 1002, ¶ 76.

In addition, Mehta discloses that "the subscriber [could] *avoid 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*., [0117]

(emphasis added). In view of the above disclosure of Mehta, the MAS provides the subscriber with only a portion of the list of applications, corresponding to the versions that will work for the subscriber and regardless of the number of application versions, so that the subscriber can avoid the problem of having to explicitly select a compatible application. Ex. 1002, ¶ 77. Thus, Mehta expressly discloses this limitation.

3. Claim 3

a. 3[a]: "A method as recited in claim 2, 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, 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; and"

Mehta discloses this element. Mehta discloses that "[t]he Subscriber Verifier *601 determines the identity of the subscriber* from whom the request originated" (Ex. 1003, [0084]) and "[t]he Device Verifier 602 *determines the type and capabilities of the subscriber device* from which the request was made and determines whether the device capabilities are sufficient to support a specific application . . . The device profile is examined to determine whether the device has the characteristics required by the requested application to execute properly on the subscriber device." *Id*., [0085] (emphasis added). A POSITA would have

understood that determining the type and capabilities of the subscriber device in Mehta would correspond to "determining the identity of the wireless device used by the subscriber" of claim 3. Ex. 1002, ¶ 78.

Regarding the limitation of previously associating each implementation with device identity of claim 3, Mehta discloses that "[t]he Deployment Manager 506 obtains applications and provisions *each application instance* for its intended (requested) use when an instance of an application is requested. It may also pre-deploy ('pre-provision') applications for *specific device and/or subscriber profiles* by *preparing applications for those profiles in advance* and storing the results for quick access in the cache 505, or other data repository." Ex. 1003, [0075] (emphasis added). "The cache 505 is used to provide faster delivery of the requested application to the subscriber device." *Id*. Thus, Mehta expressly discloses previously associating each application with device identity (*i.e.*, specific device and/or subscriber profiles) to provide faster delivery of the requested application to the subscriber device. Ex. 1002, ¶ 79.

b. <u>3[b]: "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."</u>

Mehta discloses this element. As discussed in Section VII.A.3.a, which is incorporated by reference herein, the Device Verifier 602 in Mehta determines the type and capabilities (*i.e.*, identity) of the subscriber device. Ex. 1003, [0085].

Mehta discloses that the MAS filters the initial list based upon subscriber and device capabilities, and the final list to be presented to the subscriber device is "*filtered to display only content that has been verified*." *Id*., [0067], [0139] (emphasis added). Thus, Mehta expressly discloses that the MAS selects a portion of the initial list to be presented to the subscriber based on the type and capabilities (*i.e.*, identity) of the subscriber's device. Ex. 1002, ¶ 80.

4. Claim 4

a. 4[a]: "A method as recited in claim 2, further comprising: receiving from the subscriber a request for one of the items of digital content in said portion of the product catalog;"

Mehta discloses this element. As discussed in Section VII.A.1.d, which is incorporated by reference herein, Mehta discloses a MAS that includes "a data repository" that stores applications, which corresponds to the "product catalog" of claim 1. Ex. 1003, [0064] ("The applications are stored [] in data repository [] which may be located in the MAS"). As shown in Fig. 1 of Mehta (reproduced below), "subscribers of wireless services [101, 101b] request and download software applications from a Mobile Application System [105]." *Id*., [0061].

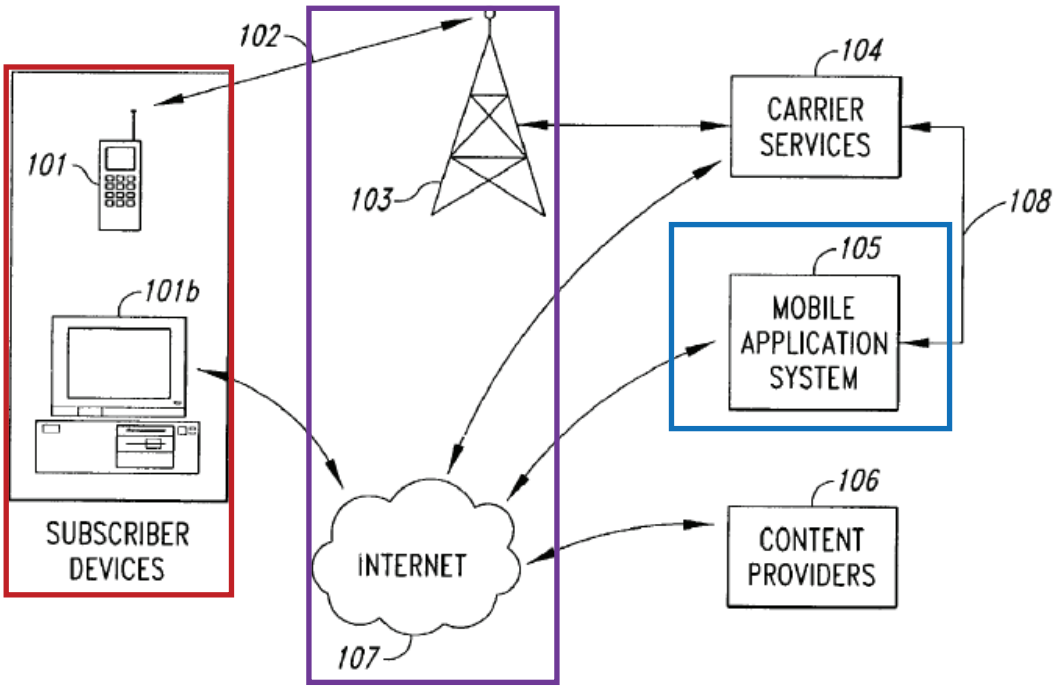


Fig. 1

Ex. 1003, Fig. 1 (annotated). Those downloads may be performed over the wireless network 103 or the Internet 107, either of which can be used as a communication pathway between the subscriber devices 101 and/or 101b, and the MAS 105. Ex. 1002, ¶ 81.

Further, Mehta discloses that "when input request [] is *a request to download a designated application* [stored in the data repository], the MAS retrieves the application, verifies that it is appropriate and permitted for download to that device and user, provisions and packages the requested application, and sends the packaged application to the requesting subscriber device." Ex. 1003,

[0070] (emphasis added). This too confirms the disclosure of a subscriber request for a particular item of content in Mehta. Ex. 1002, ¶ 82.

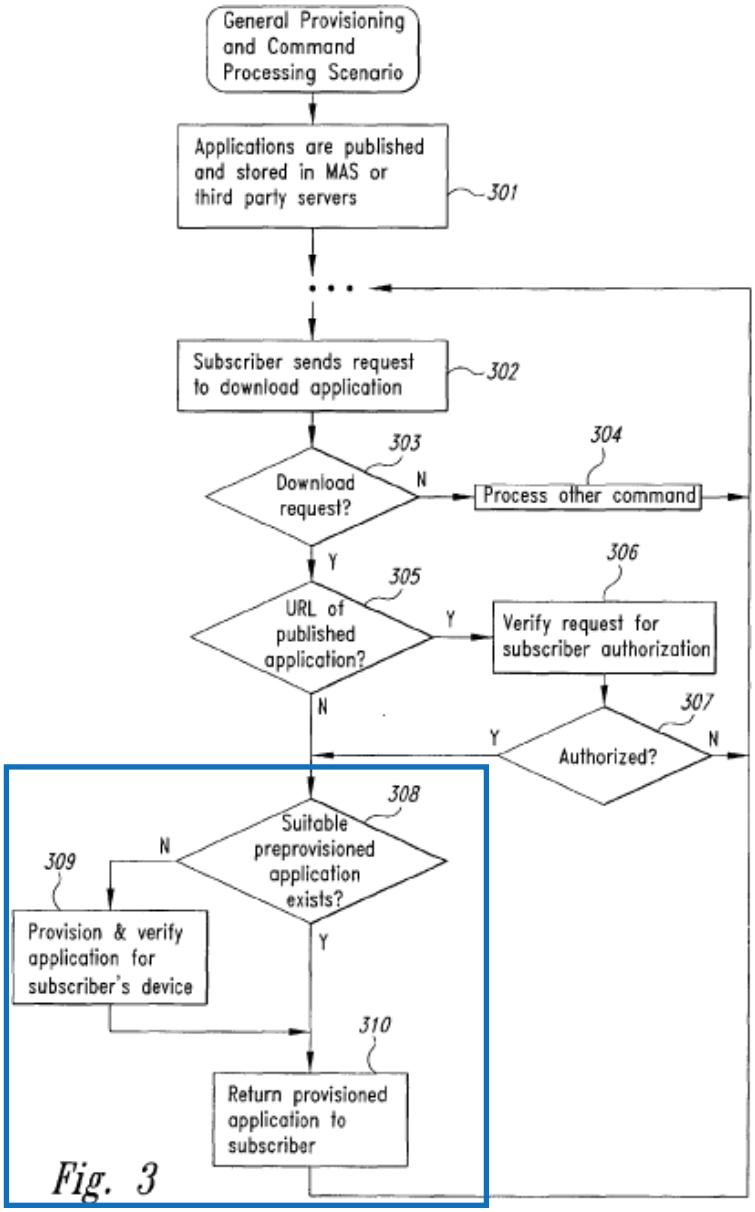
For, least these reasons, Mehta expressly discloses element 4[a].

b. 4[b]: "selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber; and"

Mehta discloses this element. Mehta discloses that upon receiving a request from the subscriber, the MAS determines an initial list and "*filters this initial list based upon subscriber and device capabilities*" to present only appropriate versions from which the user may select an item for download. Ex. 1003, [0067] (emphasis added). During this process, the MAS analyzes various profiles such as "a subscriber profile, a device profile, and an application profile" stored in the data repository to determine whether the application version, as reflected in the application profile, meets the device requirements, as reflected in the device profile. *Id.* Upon receipt of a request to download a selected item of content, "the MAS retrieves the application, verifies that it is appropriate and permitted for download to that device and user, provisions and packages the requested application, and sends the packaged application to the requesting subscriber device." *Id.*, [0070]. Thus, Mehta expressly discloses that the MAS selects an appropriate version of a requested application based on the capabilities of the subscriber's device. Ex. 1002, ¶ 83.

c. 4[c]: "downloading the selected implementation of the item of digital content to the wireless device used by the subscriber."

Mehta discloses this element. Mehta discloses that via the MAS, "applications, resources, and other content can be downloaded to [subscriber] devices, such as wireless devices." Ex. 1003, [0005]. Figure 3, as reproduced below, shows that "[i]n [step] 309, the [selected] application is provisioned for the specific subscriber device . . . [i]n step 310, the MAS sends off the provisioned application to the subscriber device for *downloading*." *Id*., [0066] (emphasis added). Thus, Mehta expressly discloses that the MAS downloads the selected and provisioned application to the subscriber device.



Ex. 1003, Fig. 3 (annotated); Ex. 1002, 84.

5. Claim 8

Mehta anticipates claim 8 in view of substantially the same evidence of anticipation for claim 2.

a. 8[pre]: "A system comprising:"

To the extent the preamble is limiting, Mehta discloses this element. The evidence described for element 2[pre] of Ground 1, such as "a Mobile Application System (MAS)" meets element 8[pre]. Ex. 1003, [0005].

b. 8[a]: "a network interface through which to communicate over a communication network; and"

Mehta discloses this element. Mehta discloses, referring to Fig. 1, that the MAS 105 "*communicates* with the carrier services 104, for example, *across a high bandwidth communications channel 108 or a publicly accessible network, such as the Internet 107*, to provide provisioned applications to the subscriber devices 101." Ex. 1003, [0062] (emphasis added); *see also id*., [0077] ("the application is . . . transmitted to the customer as outgoing data 502"). In view of the above disclosure of Mehta, a POSITA would have understood that the MAS 105 would inherently employ an interface for communicating through the chosen network (108 or 107) with the subscriber devices 101. Ex. 1002, ¶ 87; *Finisar Corp. v. DirecTV Grp.*, *Inc.*, 523 F.3d 1323, 1335 (Fed. Cir. 2008) ("To anticipate a claim, a single prior art reference must expressly or inherently disclose each claim limitation.").

c. 8[b][1]: "a download manager to receive and store a plurality of items of content to be made available for use in wireless communication devices used by a plurality of wireless telecommunications subscribers,"

Mehta discloses this element. The evidence described for element 2[a][1] of Ground 1 meets element 8[b][1]. Regarding "a download manager to receive and store a plurality of items of content," Mehta discloses that the MAS "receive[s] applications from content providers and carrier services" (Ex. 1003, [0068]) and the MAS includes "Applications Store 1216" that is "a data repository that stores applications suitable for downloading to the subscriber device 1201" (*id*., [0131]). In view of this disclosure of Mehta, a POSITA would have understood that the MAS of Mehta would correspond to "a download manager" of claim 8. Ex. 1002, ¶ 88.

d. 8[b][2]: "including receiving a plurality of different implementations of at least one of the items of content, where each implementation of any given item of content corresponds to a different set of device capabilities; and,"

Mehta discloses this element. The evidence described for element 2[a][2] of Ground 1 meets element 8[b][2].

e. 8[c]: "maintain a product catalog containing a description of the items of content, the product catalog including, in association with each item of content, a reference to each implementation of said item of content."

Mehta discloses this element. The evidence described for element 2[b] of Ground 1 meets element 8[c].

6. Claims 9-11 based on Mehta

Mehta discloses each element of claims 9-11. As referenced above in Section III.C, which is incorporated by reference herein, claim 9 and its dependent claims 10 and 11 are anticipated in view of the same evidence of anticipation for claim 2 and its dependent claims 3 and 4.

The evidence described for element 2[pre], such as "a Mobile Application System (MAS)" meets **Element 9[pre]**. Ex. 1003, [0005].

Regarding **Element 9[a]**, Mehta discloses various processors used in the MAS. *See id*., [0080], [0131], claim 45. For example, "a CPU 1213" of the general purpose computer system 1200 operating the MAS is shown in Fig. 12, which is reproduced below:

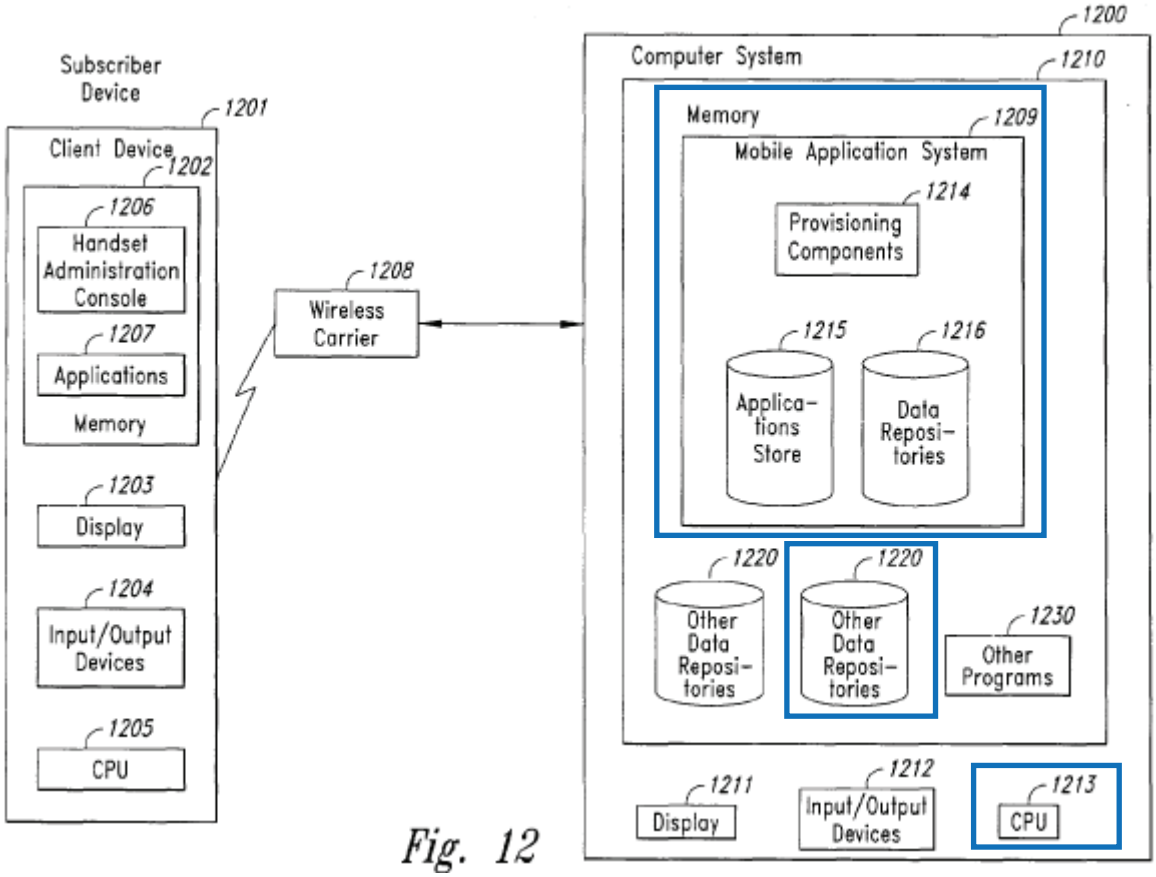


Fig. 12

Ex. 1003, Fig. 12 (annotated); *see id.*, [0131]; Ex. 1002, ¶ 93.

The evidence described for element 2[a][1] meets **Element 9[b][1]**. Regarding "a storage facility," Mehta discloses "a memory 1210" of the general purpose computer system 1200 operating the MAS. Ex. 1003, [0131], Fig. 12. It also references "other data repositories" 1220. Ex. 1003, [0131]; Ex. 1002, ¶ 94.

The evidence described for element 2[a][2] meets **Element 9[b][2]**. The evidence described for element 2[b] meets **Element 9[c]**. The evidence described for element 2[c] meets **Element 9[d]**. The evidence described for element 2[d] meets **Element 9[e]**. The evidence described for element 2[e] meets **Element 9[f]**.

The evidence described for claim 3, such as Mehta's disclosure of filtering the initial list to display only content that has been verified, meets **Dependent claim 10**. Ex. 1003, [0067], [0139]; Ex. 1002, ¶ 96. The evidence described for claim 4, such as Mehta's disclosure of filtering the initial list based upon subscriber and device capabilities, meets **Dependent claim 11**. Ex. 1003, [0067]; Ex. 1002, ¶ 96.

B. Ground 2: Mehta and Schlapfer Render Obvious Claims 1-14 of the '790 Patent

Mehta (Ex. 1003) in combination with Schlapfer (Ex. 1009) renders obvious claims 1-14 of the '790 patent. Ground 2 is not duplicative of Ground 1 because it is the only Ground based on Mehta and Schlapfer.

1. Claim 2

Mehta (Ex. 1003) in combination with Schlapfer (Ex. 1009) renders obvious claim 2 of the '790 patent. Mehta discloses all of the elements of the representative claim 2. To the extent that Patent Owner criticizes Mehta for providing an inadequate disclosure of the element "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" of element 2[e], however, the combination of Mehta and Schlapfer conclusively addresses it. As discussed below, Schlapfer, which was also not disclosed or cited to the Patent Office during prosecution,

teaches that the mobile devices have a small display, which when combined with Mehta, renders element 2[e] obvious in view of the combination.

a. 2[pre]: "A method of providing access to digital content for use on wireless communication devices, the method comprising:"

To the extent the preamble is limiting, Mehta discloses this element. The evidence described for element 2[pre] of Ground 1 meets element 2[pre].

b. 2[a][1]: "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,"

Mehta discloses this element. The evidence described for element 2[a][1] of Ground 1 meets element 2[a][1].

c. 2[a][2]: "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;"

Mehta discloses this element. The evidence described for element 2[a][2] of Ground 1 meets element 2[a][2].

d. 2[b]: "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;"

Mehta discloses this element. The evidence described for element 2[b] of Ground 1 meets element 2[b].

e. 2[c]: "receiving a request from a wireless device used by one of the subscribers;"

Mehta discloses this element. The evidence described for element 2[c] of Ground 1 meets element 2[c].

f. 2[d]: "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"

Mehta discloses this element. The evidence described for element 2[d] of Ground 1 meets element 2[d].

g. 2[e]: "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."

Mehta discloses this element. As discussed in Section VII.A.2.f, which is incorporated by reference herein, Mehta discloses that upon receiving a request from the subscriber, the MAS filters the initial list based upon subscriber and device capabilities to select a portion of the initial list to be presented to the subscriber. Ex. 1003, [0067]. Mehta describes that "the verification that the device can support the content is determined by comparing an application profile associated with the content with a device profile that is associated with the subscriber's device . . . *the list provided to the subscriber device* during application discovery is *filtered to display only content that has been verified according to*

these procedures." *Id*., [0007] (emphasis added). Further, Mehta describes that "the MAS only lists those applications that are supported by the subscriber's device." *Id*., [0117]; Ex. 1002, ¶ 105.

However, to the extent Patent Owner argues that Mehta does not expressly 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" of element 2[e], the predictable combination of Mehta and Schlapfer would remove any doubt of the claim's unpatentability. Mehta discloses that "the subscriber [could] *avoid 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. Ex. 1003, [0117] (emphasis added); Ex. 1002, ¶ 106. Further, Schlapfer describes that the mobile devices "have *a small display* . . . and are capable of communicating via a mobile network with *limited bandwidth*." Ex. 1009, 7 (emphasis added). It was well-known to a POSITA at the time of the alleged invention that the screen space and signal processing capabilities of mobile devices was limited, and that implementations and utility of devices within wireless infrastructures had to be constrained accordingly, including accommodating limited bandwidth networks. *See also* Ex. 1010, 1:59-63 ("Cellular telephones have limited resources, and as such can be considered to be limited resource devices. They are *limited by* at least one of *available memory, storage space, size*

of the display screen, and/or *computational power*, as represented by the ability to perform various data processing tasks.") (emphasis added); Ex. 1002, ¶ 106.

In view of Mehta's teaching of avoiding the problem of having to explicitly select a compatible application by only listing the applications that are supported by the subscriber's device, and Schlapfer's teaching of limited screen space of the mobile devices and limited bandwidth of the mobile network, "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" of element 2[e] would have been obvious to a POSITA at the time of the alleged invention. Ex. 1002, ¶¶ 107-108.

2. Claim 3

a. 3[a]: "A method as recited in claim 2, 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, 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; and"

Mehta discloses this element. The evidence described for element 3[a] of Ground 1 meets element 3[a].

b. 3[b]: "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."

Mehta discloses this element. The evidence described for element 3[b] of Ground 1 meets element 3[b].

3. Claim 4

a. 4[a]: "A method as recited in claim 2, further comprising: receiving from the subscriber a request for one of the items of digital content in said portion of the product catalog;"

Mehta discloses this element. The evidence described for element 4[a] of Ground 1 meets element 4[a].

b. 4[b]: "selecting an implementation of the requested item of digital content, based on device capabilities of the wireless device used by the subscriber; and"

Mehta discloses this element. The evidence described for element 4[b] of Ground 1 meets element 4[b].

c. 4[c]: "downloading the selected implementation of the item of digital content to the wireless device used by the subscriber."

Mehta discloses this element. The evidence described for element 4[c] of Ground 1 meets element 4[c].

4. Claim 5

Mehta discloses all of the elements of claim 5, except potentially for "a corresponding set of provisioning attributes and descriptors" of element 5[b]. As discussed below, Schlapfer describes an application descriptor and its attributes. Ex. 1009, 7, 8.

a. 5[a]: "A method as recited in claim 4, further comprising 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,"

Mehta discloses this element. Mehta discloses that "[p]rovisioning, as it is discussed herein, is 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." Ex. 1003, [0059] (emphasis added). "[T]he Device Verifier 602 [in Provisioning Manager 600, as shown in Fig. 6] determines *the type and capabilities of the subscriber device* from which the request was made and determines whether the device capabilities are sufficient to support a specific application." *Id*., [0085] (emphasis added), Fig. 6. Mehta then discloses at least four different types of provisioning models (*i.e.*, "walled-garden provisioning," "open provisioning," "static provisioning," and "dynamic provisioning"). *Id*., [0008], [0009], [0061], [0131]; Ex. 1002, ¶ 115.

A POSITA would have understood, in view of the above teachings of Mehta, that it would have been obvious to associate each of the items of digital content in the server system with a plurality of different provisioning models because Mehta describes that "[p]rovisioning . . . is the customizing and distributing of content . . . *for use on a particular kind of subscriber device* by a particular customer" while disclosing at least four different types of provisioning

models, and the MAS of Mehta handles a different set of device capabilities. Ex. 1003, [0059], [0085], [0131] (emphasis added); Ex. 1002, ¶ 116. For these reasons, Mehta discloses element 5[a].

b. 5[b]: "each provisioning model including a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices."

The predictable combination of Mehta and Schlapfer discloses this element. Regarding distribution of content using "a provisioning protocol" of claim 5, Mehta discloses that "[a]n example Protocol Manager 503 has built-in support for *WAP and HTTP protocols* and can be extended using well-known techniques to provide support for additional formats and *protocols*." Ex. 1003, [0071] (emphasis added); Ex. 1002, ¶ 117.

Mehta arguably does not expressly disclose "a corresponding set of provisioning attributes and descriptors" of element 5[b]. Even if Mehta does not expressly disclose this element, Schlapfer confirms that it was well-known to a POSITA at the time of the alleged invention that a provisioning model would include a corresponding set of provisioning attributes and descriptors. Ex. 1002, ¶ 118. Section 4.4. of Schlapfer describes provisioning of MIDlets that are applications written according to the Mobile Information Device Profile for the J2ME Platform ("MIDP"). Ex. 1009, 7, 11, 12. A number of MIDlets can be

contained in a single jar file that is optionally accompanied by "*an application descriptor*." *Id*., 7 (emphasis added). "An application descriptor is a text file containing selected information from the manifest file, together with the total size of the jar file" and used "to determine whether the terminal is capable of running the application." *Id*., 7, 8. The file extension of this application descriptor is .jad, and includes mandatory *attributes* such as name, version, vendor, jar URL, and jar size. *Id*. (emphasis added); *see also id*., 8 (listing optional *attributes* such as description, icon, info URL, and data size) (emphasis added); Ex. 1002, ¶ 118.

In view of these teachings of Mehta and Schlapfer, element 5[b] would have been obvious to a POSITA at the time of the alleged invention.

5. Claim 6

a. 6[a]: "A method as recited in claim 5, further comprising: receiving from the subscriber a request for one of the items of digital content in said portion of the product catalog;"

Mehta discloses this element. The evidence described for element 4[a] of Ground 2 meets element 6[a].

b. 6[b]: "identifying device capabilities of the wireless device used by the subscriber;"

Mehta discloses this element. Mehta discloses that in response to "the subscriber send[ing] a request to download an application [in step 302]," "the subscriber's request is *verified for* authorization, *device capability*, and if

appropriate, pre-paid billing authorization [in step 306]." Ex. 1003, [0064] (emphasis added); Ex. 1002, ¶ 121. Mehta also discloses that "[t]he Device Verifier 602 *determines the type and capabilities of the subscriber device* from which the request was made and determines whether the device capabilities are sufficient to support a specific application . . . The device profile is examined to determine whether the device has the characteristics required by the requested application to execute properly on the subscriber device." Ex. 1003, [0085] (emphasis added). Thus, Mehta expressly discloses identifying device capabilities of the subscriber's device.

c. 6[c]: "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;"

Mehta discloses this element. As discussed in Section VII.B.4.a, which is incorporated by reference herein, Mehta discloses at least four different types of provisioning models (*i.e.*, "walled-garden provisioning," "open provisioning," "static provisioning," and "dynamic provisioning"). Ex. 1003, [0008], [0009], [0061], [0131]. For example, when "the MAS determines [] the designated URL specifies a published application," "*walled-garden provisioning* is [] performed [] and . . . the subscriber's request is verified for authorization, *device capability*[.]"

Id., [0064] (emphasis added). Thus, Mehta discloses that the MAS selects an appropriate provisioning model based on the device capabilities. Ex. 1002, ¶ 122.

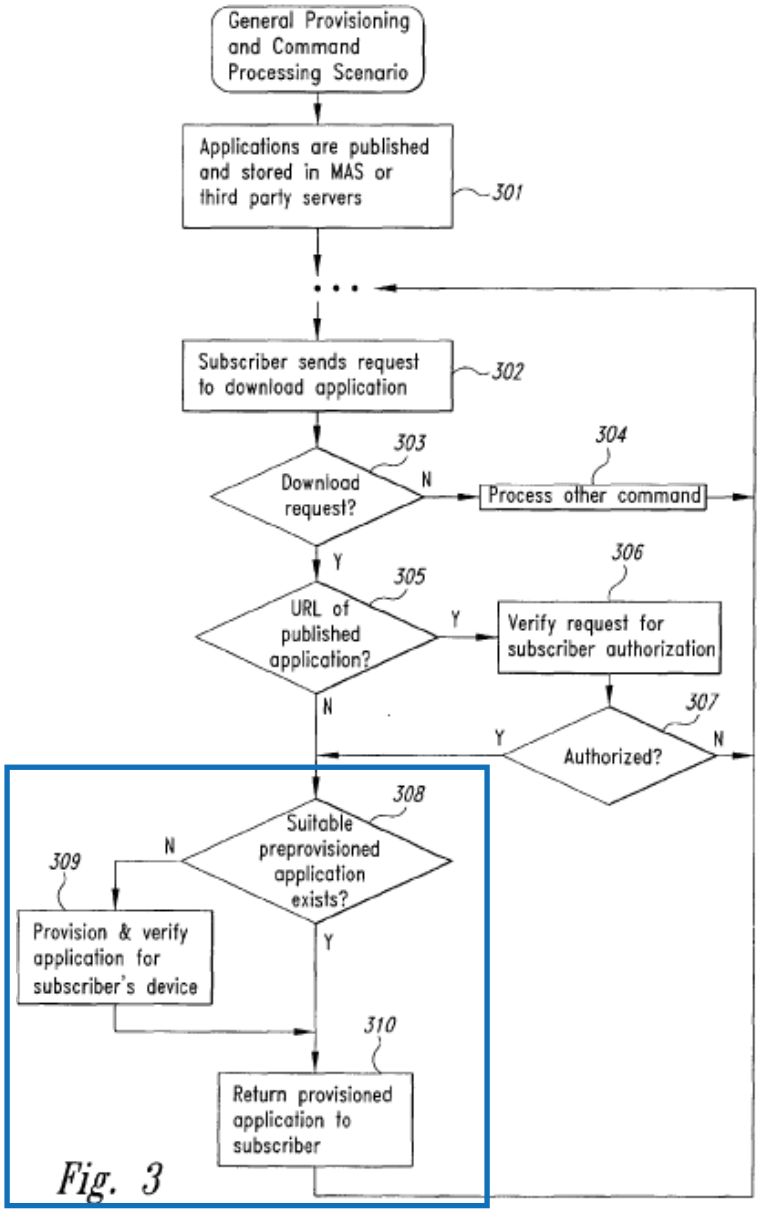
As another example, Mehta discloses that "[t]he applications may be pre-provisioned ('*static provisioning*') for quick downloading to the subscriber device 1201, or the applications may be provisioned upon request ('*dynamic provisioning*'). The Data Repositories 1215 provide data repository and retrieval services to establish levels of subscription and *device capabilities* (to host the profiles used in profile management) and to determine applications suitable for each customer device." Ex. 1003, [0131] (emphasis added); Ex. 1002, ¶ 123. For these reasons, Mehta expressly discloses element 6[c].

d. <u>6[d]: "packaging the requested item according to the selected provisioning model; and"</u>

Mehta discloses this element. Mehta discloses that "[i]n one embodiment, *provisioning* includes application code inspection, optimization, instrumentation, and *packaging*." Ex. 1003, [0015] (emphasis added). Further, Mehta discloses that "*[d]uring the provisioning process*, the inspected, optimized, or instrumented content can be *packaged* appropriate to the requesting device." *Id*., [0012] (emphasis added); Ex. 1002, ¶ 124. Thus, Mehta expressly discloses packaging the requested content according to the selected provisioning process.

e. 6[e]: "provisioning the requested item in the wireless device used by the subscriber according to the selected provisioning model."

Mehta discloses this element. As discussed in Section VII.B.5.c, which is incorporated by reference herein, Mehta discloses that when "the MAS determines [] the designated URL specifies a published application," "*walled-garden provisioning* is [] performed [as a selected provisioning model]." Ex. 1003, [0064] (emphasis added). Mehta also discloses that "[t]he applications may be pre-provisioned ('*static provisioning*' [as a selected provisioning model]) for quick downloading to the subscriber device 1201, or the applications may be provisioned upon request ('*dynamic provisioning*' [as a selected provisioning model])." *Id*., [0131] (emphasis added). Figure 3, as reproduced below, shows that "[i]n [step] 309, the application is provisioned for the specific subscriber device . . . [i]n step 310, the MAS sends off the provisioned application to the subscriber device for downloading." *Id*., [0066]. For these reasons, Mehta expressly discloses element 6[e]. Ex. 1002, ¶ 125.



Ex. 1003, Fig. 3 (annotated).

6. Claim 7

a. 7[a]: "A method as recited in claim 6, wherein: 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; and"

The predictable combination of Mehta and Schlapfer discloses this element. Mehta discloses that "*[d]uring the provisioning process*, the inspected, optimized, or instrumented content can be *packaged* appropriate to the requesting device." Ex. 1003, [0012] (emphasis added). As discussed in Section VII.B.4.b, which is incorporated by reference herein, while Mehta arguably does not expressly disclose "a provisioning descriptor," Section 4.4. of Schlapfer discloses *provisioning* of MIDlets that are applications written according to the Mobile Information Device Profile for the J2ME Platform ("MIDP") (Ex. 1009, 7, 11, 12), and a number of MIDlets can be contained in a single jar file that is optionally accompanied by "*an application descriptor*" (*id*., 7) (emphasis added). "An application descriptor is a text file containing selected information from the manifest file, together with the total size of the jar file" and used "to determine whether the terminal is capable of running the application." *Id*., 7, 8; Ex. 1002, ¶ 126.

Further, Mehta describes that "[i]n step 2704, the [Package Application] routine *packages* the application *using a determined file format by encapsulating the provisioned application with information* sufficient to enable the Handset Administration Console (See, for example, the Handset Administration Console of FIG. 2) executing on a wireless device to extract the application." Ex. 1003, [0148] (emphasis added). A POSITA would have understood that the information encapsulating the provisioned application in Mehta would correspond to "a

provisioning descriptor" of claim 7, and Mehta's use of such information during the packaging process would correspond to "associating the provisioning descriptor with the requested item" of claim 7. Ex. 1002, ¶ 127. In view of these teachings of Mehta and Schlapfer, element 7[a] would have been obvious to a POSITA at the time of the alleged invention.

b. 7[b]: "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."

Mehta discloses this limitation. For example, Mehta discloses that "when input request 501 [as shown in Fig. 5 reproduced below] is a request to download a designated application, the MAS [500] retrieves the application, verifies that it is appropriate and permitted for download to that device and user, provisions and packages the requested application, and *sends the packaged application to the requesting subscriber device*." Ex. 1003, [0070] (emphasis added). Mehta also discloses that "the Protocol Manager [503 shown in Fig. 5 below] encodes/translate[s] the outgoing data message *according to the determined protocol*." *Id*., [0134] (emphasis added); Ex. 1002, ¶ 128. For these reasons, Mehta expressly discloses element 7[b].

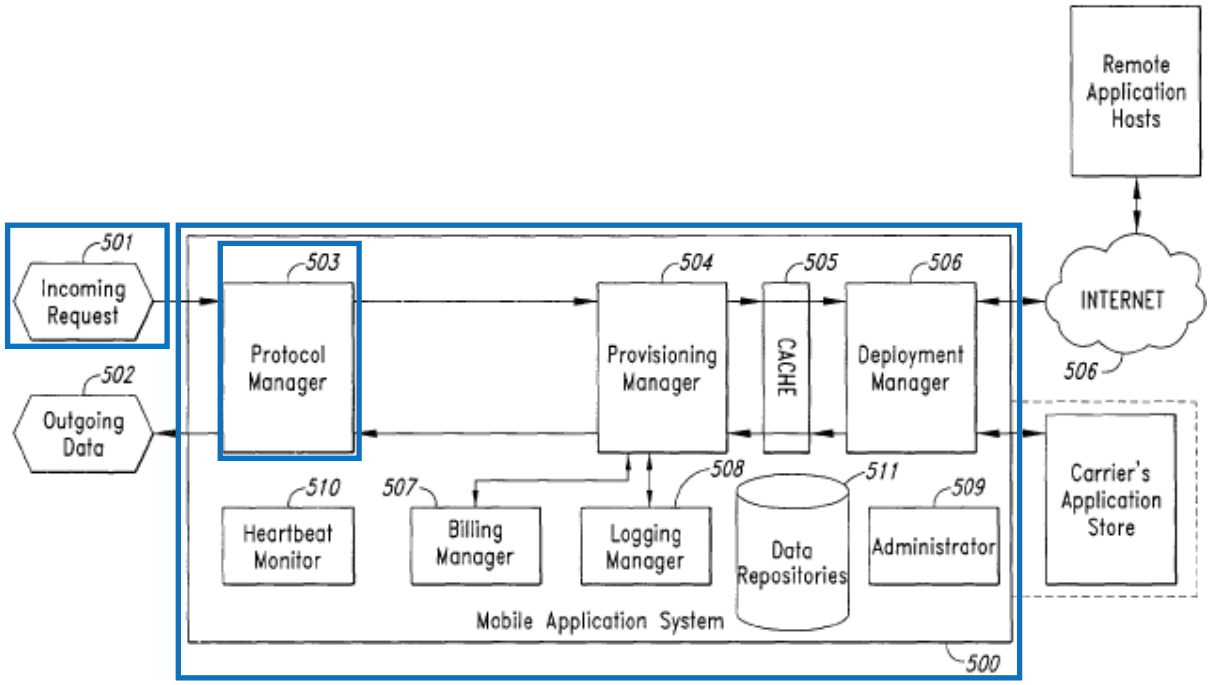


Fig. 5

Ex. 1003, Fig. 5 (annotated).

7. Claims 9-14 in View of Mehta and Schlapfer

As referenced above in Section III.C, which is incorporated by reference herein, claim 9 and its dependent claims are obvious in view of the same evidence of obviousness for claim 2 and its dependent claims.

The evidence described for element 2[pre], such as "a Mobile Application System (MAS)" meets **Element 9[pre]**. Ex. 1003, [0005].

Regarding **Element 9[a]**, Mehta discloses this limitation (*i.e.*, "a processor"). Mehta discloses various processors used in the MAS. *See id.*, [0080],

[0131], claim 45. For example, "a CPU 1213" of the general purpose computer system 1200 operating the MAS is shown in Fig. 12, which is reproduced below:

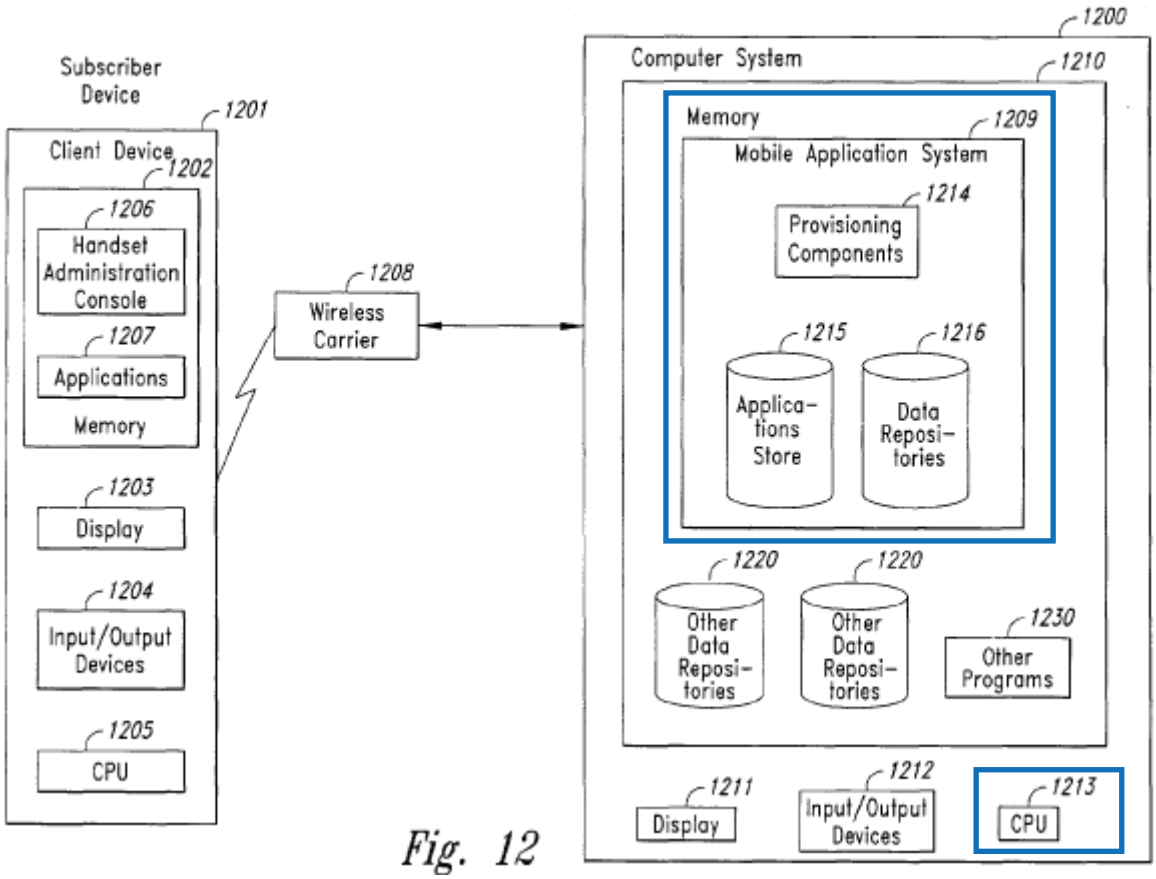


Fig. 12

Ex. 1003, Fig. 12 (annotated); *see id.*, [0131]; Ex. 1002, ¶ 131.

The evidence described for element 2[a][1] meets **Element 9[b][1]**. Regarding "a storage facility," Mehta discloses "a memory 1210" of the general purpose computer system 1200 operating the MAS. Ex. 1003, [0131], Fig. 12; Ex. 1002, ¶ 132.

The evidence described for element 2[a][2] meets **Element 9[b][2]**. The evidence described for element 2[b] meets **Element 9[c]**. The evidence described

for element 2[c] meets **Element 9[d]**. The evidence described for element 2[d] meets **Element 9[e]**. The evidence described for element 2[e] meets **Element 9[f]**.

The evidence described for claim 3, such as Mehta's disclosure of filtering the initial list to display only content that has been verified, meets **Dependent claim 10**. Ex. 1003, [0067], [0139]; Ex. 1002, ¶ 134. The evidence described for claim 4, such as Mehta's disclosure of filtering the initial list based upon subscriber and device capabilities, meets **Dependent claim 11**. Ex. 1003, [0067]; Ex. 1002, ¶ 134. The evidence described for claim 5, such as Schlapfer's disclosure of an application descriptor and attributes, meets **Dependent claim 12**. Ex. 1009, 7, 8; Ex. 1002, ¶ 134. The evidence described for claim 6, such as Mehta's disclosure of at least four different types of provisioning models (*i.e.*, "walled-garden provisioning," "open provisioning," "static provisioning," and "dynamic provisioning"), meets **Dependent claim 13**. Ex. 1003, [0008], [0009], [0061], [0131]; Ex. 1002, ¶ 134. The evidence described for claim 7, such as Mehta's disclosure of provisioning and packaging the requested application, and sending the packaged application to the requesting subscriber device, meets **Dependent claim 14**. Ex. 1003, [0070]; Ex. 1002, ¶ 134.

8. Claims 1 and 8 in view of Mehta and Schlapfer

As discussed above in Ground 1, which is incorporated by reference herein, the elements of claims 1 and 8 are disclosed by Mehta. *See supra* Sections VII.A.1 and VII.A.5.

9. Obviousness Based on Mehta and Schlapfer

There are compelling motivations to combine the relevant digital content provisioning features from Mehta and Schlapfer with a reasonable expectation of success.

For example, a POSITA would have found it obvious to combine Mehta's teachings of a mobile application system (*i.e.*, "MAS") with Schlapfer's teachings of limited screen space of mobile devices and limited bandwidth of the mobile network, and an application descriptor and associated attributes. A POSITA would have looked to Schlapfer because it is analogous art to Mehta. Ex. 1003, [0002] (the invention relates to "maintaining and distributing wireless applications to wireless devices over a wireless network"); Ex. 1009, 11 ("the user should be able to download applications to the mobile device on the go to keep the wireless experience" via "Over the Air (OTA) User Initiated Provisioning"). Both Mehta and Schlapfer are directed to distributing digital contents to mobile devices over a wireless network. *See* Ex. 1003, [0002, 0005]; Ex. 1009, 3, 11, 12; Ex. 1002, ¶ 137.

Mehta itself also provides motivation to look to Schlapfer. Mehta recognizes the issue of resource constraints on mobile devices and contemplates taking steps to address those constraints. For example, Mehta describes "optimizing the content for smaller size and greater speed," Ex. 1003, [0010], and packaging content so that "the packaging compresses the content," *id.*, [0012]. In this same vein, it was well-known to a POSITA at the time of the alleged invention that the mobile devices had limited screen space. *See* Ex. 1010, 1:59-63 ("Cellular telephones have *limited resources*, and as such can be considered to be limited resource devices. They are *limited by* at least one of available memory, storage space, *size of the display screen*, and/or computational power, as represented by the ability to perform various data processing tasks.") (emphasis added); Ex. 1013, 6:33-39 ("Designed to closely model the World-Wide Web architecture, specifications of, for example, the standard naming model, content typing, content formats, protocols, etc., have been developed for *a general-purpose application environment for wireless mobile communication devices having limited CPU speeds*, memory battery life, *display size*, and a wide variety of input devices."); Ex. 1014, [0039] ("To compensate for *the limited display, storage and network bandwidth capabilities of mobile devices*, a log of the frequency of download of applications may aid users in finding popular applications, and in ranking and narrowing user search results.") (emphasis added). Ex. 1002, ¶ 138. *See Randall*

Mfg. v. Rea, 733 F.3d 1355, 1362 (Fed. Cir. 2013) ("[T]he knowledge of [a skilled] artisan is part of the store of public knowledge that must be consulted when considering whether a claimed invention would have been obvious.").

Additionally, a POSITA would have combined Mehta and Schlapfer with a reasonable expectation of success. A POSITA considering Mehta as modified by Schlapfer would have had a reasonable expectation in doing so because the two references both look to the use of Java for distributing digital content to mobile devices. Schlapfer provides recent development in Java technology regarding digital content provisioning for mobile devices. Ex. 1009, 3, 11, 12. Mehta describes the use of Java throughout its specification. Ex. 1003, Cls. 21, 42, 58, 72, [0015, 0064, 0080, 0092, 0095, 0097, 0098, 0105, 0106, 0113, 0130, 0133, 0145, 0148]. Mehta also refers to "J2ME" that is discussed in depth by Schlapfer. *See* Ex. 1003, [0070]; Ex. 1009, 5-14; Ex. 1002, ¶ 139.

Similarly, it was well-known to a POSITA, the time of the alleged invention that a provisioning model would include a corresponding set of provisioning attributes and descriptors. For example, while Mehta does not specifically use the terms "provisioning attributes" and/or "provisioning descriptors," it discloses relevant features. Regarding the "provisioning descriptors" of claim 5, the specification of the '790 patent states that "*[t]he content descriptor* specifies the *name* of the content to be provisioned, the *size* of the content, a location (*e.g.*, *a*

URL) at which the content is stored, and the content *type* of the content." Ex. 1001, 13:30-33 (emphasis added). Mehta discloses that "the content provider may include *a name and a short description* of the application" (Ex. 1003, [0098]); "[t]he recorded [provisioned application] data includes information pertaining to the incoming request 501 and the deployed application such as the subscriber ID, the *size* of the download . . ." (*id*., [0076]); and "designating *a URL* [] identifies a file (an application or service) to download" (*id*., [0064]) (emphasis added). Further, Mehta describes that "[i]n step 2704, the [Package Application] routine packages the application *using a determined file format by encapsulating the provisioned application with information* sufficient to enable the Handset Administration Console (See, for example, the Handset Administration Console of FIG. 2) executing on a wireless device to extract the application." Ex. 1003, [0148] (emphasis added). A POSITA would have understood that the information encapsulating the provisioned application in Mehta would correspond to "provisioning descriptors" of claim 5. Ex. 1002, ¶ 140.

Regarding the "provisioning attributes" of claim 5, the specification of the '790 patent does not offer any definition or explanation. A POSITA would have understood that "provisioning attributes" would have the plain and ordinary meaning of information related to provisioning. Mehta describes that "*[a]s a provisioned application is being delivered to a user*, the details about the

transaction typically are recorded in the Logging Manager 508, which is accessible to the Billing Manager 507 to enable a variety of billing methods. *The recorded data includes information pertaining to the incoming request 501 and the deployed application such as the subscriber ID, the size of the download, the time and date of the download, the particular application downloaded, etc.*" Ex. 1003, [0076] (emphasis added). A POSITA would have understood that the information pertaining to the provisioned and deployed application such as the subscriber ID, the size of the download, the time and date of the download, the particular application downloaded would correspond to the "provisioning attributes" of claim 5. Ex. 1002, ¶ 141. Accordingly, a POSITA would have combined the teachings of Mehta and Schlapfer with a reasonable expectation of success.

VIII. SECONDARY CONSIDERATIONS

Petitioner is unaware of any evidence of secondary considerations that would support a finding of non-obviousness. The asserted prior art demonstrates there is no evidence of failure by others and that the features recited in the challenged claims were readily available in the prior art.

IX. MANDATORY NOTICES

A. Real Parties-in-Interest

The real parties-in-interest here are Netflix, Inc. and Netflix Streaming Services, Inc. No other party is directing, controlling, or funding this *Inter Partes* Review proceeding (IPR).

B. Related Matters

As of the filing date of this Petition, and to the best knowledge of Petitioner, the '790 patent is or has been the subject of the following proceedings:

VideoLabs, Inc. v. Netflix Inc., Case 1:22-cv-00229 (D. Del.)

Starz Entertainment, LLC v. VL Collective IP, LLC, Case 1:21-cv-01448 (D. Del.)

Unwired Planet, LLC v. Apple, Inc., Case 3:13-cv-04134 (N.D. Cal.)

Unwired Planet, LLC v. Apple Inc., Case 3:12-cv-00505 (D. Nev.)

C. Lead/Back-up Counsel

Petitioner is filing a power of attorney designating Aliza George Carrano (Reg. No. 70,637, accarrano@willkie.com) as lead counsel, and Indranil Mukerji (Reg. No. 46,944, imukerji@willkie.com) and Stephen A. Marshall (*pro hac vice* to be filed, smarshall@willkie.com) as back-up counsel, all of Willkie Farr & Gallagher LLP, 1875 K Street NW, Washington, DC 20006. Petitioner has paid

the required fee under 37 C.F.R. §§ 42.15(a) and 42.103 through P.R.P.S. Please assess any fee deficiency or credit to Deposit Account No. 232405.

D. Service Information

Petitioner consents to e-mail service at the addresses of lead and back-up counsel and Netflix-VL_WFG@willkie.com. Hand delivery is also available to the addresses of lead and back-up counsel.

X. GROUNDS FOR STANDING

Petitioner certifies that the '790 patent is available for *Inter Partes* Review, and Petitioner is not barred or estopped from challenging the claims on the Ground identified herein.

XI. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board institute *inter partes* review trial and cancel claims 1-14 of the '790 patent as unpatentable.

Respectfully submitted,

Dated: February 22, 2023

By: *// Aliza George Carrano //*
Lead Counsel for Petitioner

CERTIFICATE OF COMPLIANCE

The undersigned certifies that this Petition complies with the applicable type-volume limitations of 37 CFR § 42.24. Exclusive of the portions exempted by 37 CFR § 42.24(a), this Petition contains 12,848 words as counted by the word processing program used for its preparation (Microsoft Word 2016) and is in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24(a)(1)(i).

// Aliza George Carrano //
Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on February 22, 2023, I caused a true and correct copy of the foregoing materials:

- Petition for *Inter Partes* Review of U.S. Patent No. 7,233,790
- Exhibits 1001-1025
- Table of Exhibits for Petition for *Inter Partes* Review of U.S. Patent No. 7,233,790 (Exs. 1001-1025)
- Petitioner's Powers of Attorney

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