

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADOBE INC.,
Petitioner

v.

EXPRESS MOBILE, INC.,
Patent Owner.

Case IPR2021-01228
Patent No. 9,063,755

PATENT OWNER PRELIMINARY RESPONSE

Under 37 C.F.R. § 42.107

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Ex. 2003	Declaration of Dr. Kevin C. Almeroth ("Almeroth Decl.")
Ex. 2004	Curriculum Vitae of Dr. Kevin C. Almeroth
Ex. 2005	<i>Express Mobile v. Google</i> - Ex. C-20 to Google's Invalidity Contentions
Ex. 2006	Prosecution History - International Search Report
Ex. 2007	<i>In re Express Mobile Cases</i> , 3:20-cv-08297-RS, Dkt. 49 (April 5, 2021)
Ex. 2008	<i>Shopify Inc v. Express Mobile, Inc.</i> , No. 19-cv-00439, D.I. 306 (D. Del. Oct. 13, 2021)
Ex. 2009	<i>Express Mobile, Inc. v. Adobe Inc. et al.</i> , No. 20-cv-08297-RS, Dkt. 51 (N.D. Cal.)
Ex. 2010	Excerpt from Adobe's Invalidity Contentions, submitted on July 19, 2021 in <i>Express Mobile, Inc. v. Adobe Inc. et al.</i> , No. 20-cv-08297-RS
Ex. 2011	<i>Shopify Inc. et al. v. Express Mobile, Inc.</i> , No. 19-cv-439-RGA, D.I. 288 (Jan. 22, 2021)
Ex. 2012	Excerpt from Rebuttal Expert Report of Kevin C. Almeroth, Ph.D., dated October 7, 2020, submitted in <i>Shopify Inc v. Express Mobile, Inc.</i> , No. 19-cv-00439-RGA (D. Del.)
Ex. 2013	Excerpt from Opening Expert Report of Philip Greenspun, Ph.D., dated July 31, 2021, submitted in <i>Express Mobile, Inc. v. GoDaddy.com LLC</i> , No. 19-cv-1937-RGA (D. Del.)
Ex. 2014	Letter from Devlin, T. to Adobe Inc., dated February 6, 2020
Ex. 2015	<i>Express Mobile, Inc. v. Adobe Inc. d/b/a Adobe Systems Inc.</i> , No. 3-20-cv-08297, Dkt. 1 (N.D. Cal.) (November 24, 2020)
Ex. 2016	<i>Shopify v. Express Mobile</i> , No. 19-cv-439-RGA (D. Del.), Shopify Inc. and Shopify (USA) Inc.'s Initial Invalidity Contentions (Nov. 22, 2019)
Ex. 2017	Scheduling Order in <i>Express Mobile v. GoDaddy</i> , 19-cv-01937 (D. Del.), Dkt. 14 ("GoDaddy Scheduling Order")
Ex. 2018	Joint Claim Construction and Prehearing Statement Pursuant to Patent L.R. 4-3, No. 19-cv-6559 et al. (N.D. Cal.), Dkt. 69

I. Introduction

The Board should deny institution for several reasons. First, Petitioner relies on previously considered and cumulative references which, in any event, do not disclose or render obvious at least four claim limitations of the '755 patent. For four claim limitations relating to the “player” claim language and relevant input and output “symbolic names,” Petitioner fails to identify any teachings from the asserted primary reference (Huang) that disclose the limitations, and unsuccessfully attempts to combine that reference with a secondary reference (Shenfield), that the POSA would not have even been motivated to combine with Huang.

These same four limitations were the basis for the Board’s recent denial of institution in *Google LLC v. Express Mobile, Inc.*, IPR2021-00709, Paper 7 (P.T.A.B. Oct. 4, 2021). Petitioner identifies no teachings in Shenfield that remedy the significant deficiencies in Huang that were the basis for decision in *Google*, and indeed does not even attempt to rely on Shenfield to remedy the deficiencies for two of the limitations. The petition therefore, as in *Google*, fails to demonstrate a reasonable likelihood of prevailing on any challenged claim.

Second, apart from *Google*, the Board should deny institution in view of ongoing parallel litigation. The parallel litigation, as well as numerous additional litigations involving the '755 patent, will reach trial long before any final Board decision in this proceeding. Meanwhile, Petitioner’s claim construction positions

here primarily adopt those taken or proposed in pending cases in district court (*see* Petition, § VIII), making claim construction proceedings in this case unnecessary.

Third, the Board should deny institution under Section 325(d). Petitioner relies on only one ground, having a primary reference and one secondary reference. But the Patent Office has already considered the primary reference. And Petitioner relies on the secondary reference (Shenfield) only for two of the four limitations that the Board has already found deficient in the primary reference (Huang). The Board should decline to rehash the same issues of patentability that the Office already considered. For at least these three reasons, the Board should deny institution.

II. Background

A. Background of the Technology

The '755 patent arose from a recognition that “[i]nternet-connected mobile devices [were] becoming ever more popular,” but that many mobile devices “d[id] not have the capabilities of non-mobile devices including computing, input and output capabilities” with web services available on the Internet. Ex. 1001 (“’755 patent”) at 1:15-18. Before the invention of the '755 patent, accessing web services from a web page or a web application required manually coding the following data flow: receiving and parsing user inputs to a web page, connecting to a web service, sending user inputs to the remote web service, receiving and parsing outputs from the web services, and generating HTML code to display the outputs.

The '755 patent notes that the ubiquity of the Internet drives access from a wide range of devices: “[t]he mobility of the user while using . . . devices provides challenges and opportunities for the user of the Internet.” ’755 patent at 1:19-21. For example, “there are a large number of types of devices and they tend to have a shorter lifetime in the marketplace,” and “[t]he programming of the myriad of mobile devices is a time-consuming and expensive proposition.” ’755 patent at 1:21-25. For this reason, there was “a need in the art for a method and apparatus that permits for the efficient programming of mobile devices,” which “should be easy to use and provide output for a variety of devices.” ’755 patent at 1:23-26. The ’755 patent addresses these needs by providing an efficient way of generating code that allows a device retrieve and display information directly from web services.

The ’755 patent relates to an architecture that allows for the display of web service content on a device. In some embodiments, the system includes a database of web services sent directly to a device over a network. *Id.* at 1:35-37, 10:31-43. The patent also describes an authoring tool configured to define an object for presentation on the display, select a component of a web service included in the database, associate the object with the selected component, and produce code (for example, an application and a player, in some embodiments) that when executed on the device, provides the selected component on the display of the device. ’755 patent at 1:34-42, 2:1-3. In this way, the device includes code that allows the device to

efficiently and directly access web services without the requirement of an intermediary.

III. The petition fails to demonstrate a reasonable likelihood of prevailing on any challenged claim

Petitioner’s two proposed references, Huang and Shenfield, operate in a fundamentally different manner from one another, and are therefore not a viable combination whatsoever. Even if combined, they would disclose a system that operates in a fundamentally different manner than the claimed invention. As described below, Huang teaches away from a device directly communicating with a web service, and any proposed combination of Huang and Shenfield would be forced to use an intermediary to communicate information between a device and a web service. As the disclosures of Huang and Shenfield (both individually and collectively) operate in a fundamentally different way than the claimed invention, the Petitioner’s proposed combination fails to disclose or render obvious—and indeed, teaches away from—numerous claim elements, as discussed below.

A. Summaries of the asserted references

1. Huang

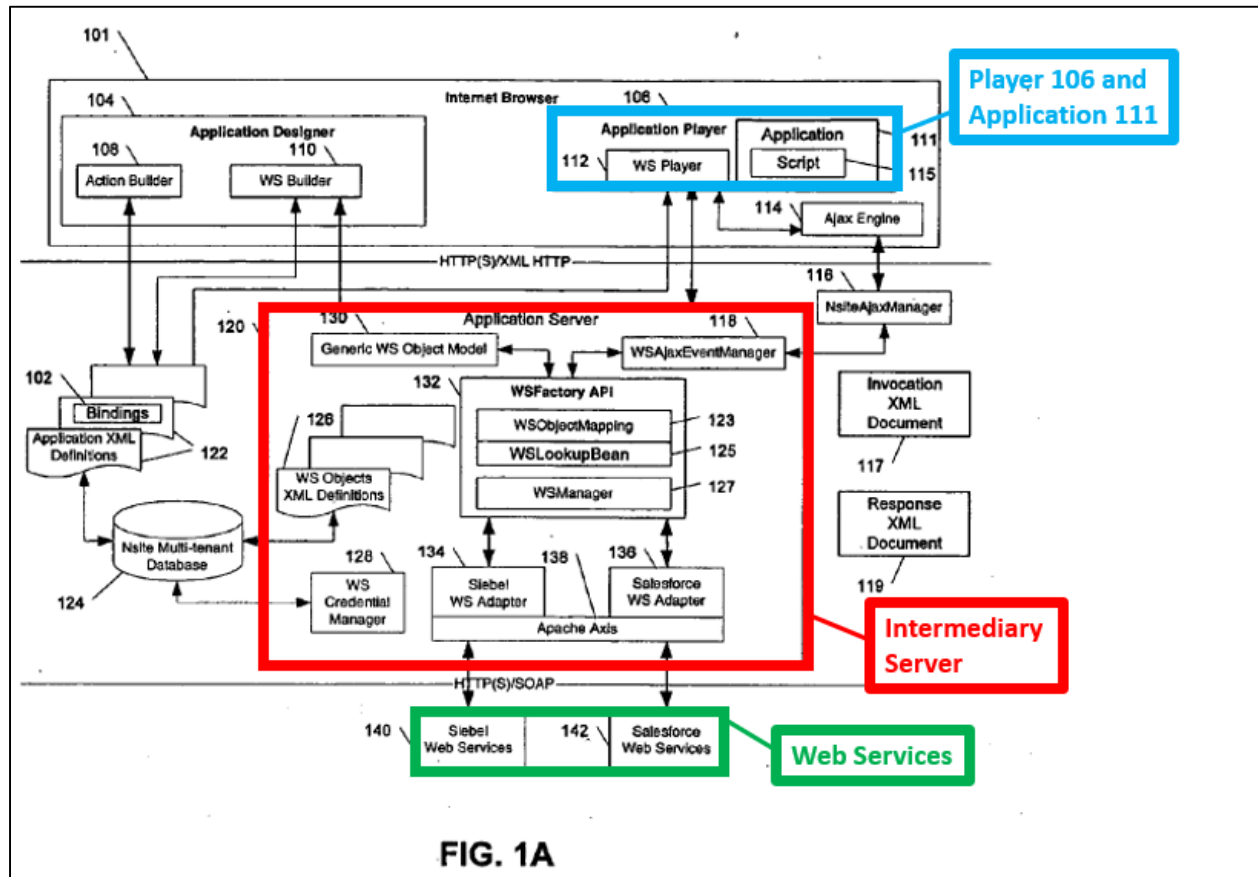
Huang teaches using an intermediary to communicate information between a device and a web service. Huang’s “goal is to access databases and/or business logic of organizations via web services” and to do so in a “vendor-independent” manner. Ex. 1005 (“Huang”) at ¶¶ 007, 057, 075. As Huang explains, “[o]ne approach to

invoking the web service object would be to call vendor-specific objects directly from applications.” Huang at ¶ 074. However, Huang disparages and teaches away from a device directly communicating with a web service because “[t]hat approach requires the application to know details about each vendor specific object, and ties the application to a particular web services vendor.” *Id.*

Accordingly, Huang proposes a system that relies on a Generic Web Service Model (also referred to as a Generic WS Object or a WSOBJect) and a Web Service Factory Application Programming Interface. *See id.* at ¶¶ 044, 074. Specifically, in Huang’s system, “[a]pplications interact with the generic web services object and need not contain hard-coded dependencies on vendor specific objects [i.e., objects of the web service].” *Id.* at ¶ 74.

Rather than having a device interact directly with a web service, Huang discloses using a WSOBJectMapping, “which maps, i.e., converts, the Generic WS Object Model 130 (WSOBJect) to vendor-specific Application Programming Interfaces.” *Id.* at ¶ 044; *see also id.* at ¶ 057 (“it is desirable to allow the Designer 104 and Player 106 applications to work with multiple web services To allow the Designer 104 and Player 106 to be vendor-independent and work with multiple web services without the need for vendor-specific code in the Designer 104, the Player 106, or the Internet Browser 101, a Generic WS Object 130 is provided in the server 120.”).

Huang's use of the intermediary, including its WSOBJECTMapping, is illustrated in Figure 1A, below (annotated).



Id. at Fig. 1A (annotated). As shown and described, Huang's intermediary Application Server 120 (annotated in red) allows the application and player (annotated in blue) to know no details about vendor specific objects of a web service (annotated in green). *Id.* at ¶ 074. Instead, the intermediary server receives generic requests from the application and player and *converts* the requests into queries specific to a web service. *See, e.g., id.* at ¶¶ 044, 074. Then the intermediary, alone, interacts with the web service. *Id.* at ¶ 124. Huang's web service implementation

uses the intermediary server to display web services in a browser. *Id.* at ¶¶ 41-42 & FIG. 1A. Additionally, Huang’s system implements a page-based web services application in a web browser, as discussed below.

2. Shenfield (U.S. Patent Pub. No. 2006/0200749)

Petitioner primarily relies on Huang for purportedly disclosing almost all claim elements of claim 1 of the ’755 patent.

To the extent that Petitioner relies on Shenfield, Shenfield is directed toward a “Web Application” converter that “convert[s] a page-based application to a component based application for execution on a device.” Shenfield at Abstract. As Shenfield notes, the conversion was designed to move away from the disadvantage of page-based applications on web browsers, which “ha[d] a disadvantage of requesting pages (screen definitions in HTML) from the Web Service, which hinders the persistence of data contained in the screens.” Ex. 1007 (“Shenfield”), ¶ 3. The component application, instead of being run in a browser is “executed within [a] terminal runtime environment 206, which supports access to Web Service 106 operations.” Shenfield, ¶ 39. The component-based application model, according to Shenfield, “combines the simplicity of browser-based applications with the efficiency of native application execution.” Shenfield, ¶ 54. Therefore, the focus of the claimed invention in Shenfield is to convert browser-based, single page applications to the component based model using “conversion tools” disclosed in the

specification. *See* Shenfield, ¶ 90 & Claim 1. The specification illustrates multiple examples of such application “conversions.” Shenfield, ¶¶ 96-100.

The description of Shenfield by Adobe and its expert, Dr. Cullimore, is incomplete. Adobe glosses over central details discussed in Shenfield’s specification, and in particular the fact that Shenfield is solely directed to a conversion from browser-based Applications to component-based ones, not to a distinct Application and Player (let alone an Application and Player that have been construed as being “separate” by the District Court in Delaware, *see* Petition at 12-13 (citing Ex. 1004)).

B. The Petition fails to demonstrate a reasonable likelihood that any claims of the ’755 Patent are unpatentable

The Petition fails to establish a reasonable likelihood that any claims of the ’755 patent are unpatentable. The Board specifically held as much in the *Google IPR*, where the Board “determine[d] that the information presented in the Petition does not establish that there is a reasonable likelihood that Petitioner would prevail with respect to obviousness of claims 1, 2, 7, and 11 of the ’755 Patent.” *Google LLC v. Express Mobile Inc.*, IPR2021-00709, Paper 7, at 17.

The basis for the Board’s *Google* decision was based on its comprehensive analysis of four limitations of independent claim 1 that are not disclosed or rendered obvious by the Huang reference—the very same primary reference that Adobe has cited here. *Id.* at 11-17. With respect to these limitations, as discussed below, Huang

continues to suffer from the same deficiencies outlined by the Board in its Institution Decision. For two of the limitations, Petitioner solely relies on the disclosures of Huang; to the extent that Petitioner relies on the disclosure of the secondary reference, Shenfield, Petitioner ignores that (1) the POSA would not have even been motivated to combine Shenfield with Huang, and their proposed combination only serves to highlight Adobe's (attempted) hindsight reconstruction ; and (2) even if combined, the references would not cure the deficiencies in Huang.

According to Dr. Almeroth's declaration (Ex. 2003), there is in fact "no likelihood" that Adobe's petition will be successful. Ex. 2003 ¶ 40. Huang discloses a system that operates in a fundamentally different manner than as described in claim 1 of the '755 patent. By its use of the intermediary server 120, Huang discloses—and touts the benefits of—a system that allows a device that knows no specific details of any web service. Claim 1 of the '755 patent, conversely, embraces the approach that Huang disparages. Specifically, claim 1 allows a device to communicate directly with a web service, and thus know specific details of the web service vendor's objects. In this way, the patented claims allow a device to efficiently communicate with a web service to provide and retrieve information without the use of an intermediary server.

Likewise, to the extent that Petitioner seeks to combine Huang with Shenfield, Petitioner (and its expert) provide generic reasons for the alleged combination, but

ignore that Huang and Shenfield are directed to fundamentally different problems. Meanwhile, “[f]undamental differences between the references are central to th[e] motivation to combine inquiry,” and such “fundamental differences” can be fatal to a motivation to combine. *Adidas AG v. Nike Inc.*, 963 F.3d 1355, 1359 (Fed. Cir. 2020). For example, whereas Huang is directed at the use of an intermediary server that can be used in connection with web services supplied by different vendors and displayed in browsers, Shenfield is directed to converting web service applications *away* from browser-based application to component-based applications.

Huang and Shenfield are directed to disparate solutions for problems in the web service field, and any proposed combination that Petitioner advances is hindsight driven and would neither have been attempted by a POSA nor would have been successfully combined. Indeed, attempting to combine Shenfield with Huang would have forced the POSA to alter the “principles of operation” of Huang and would have made Huang inoperable for its intended purpose of serving browser-based applications. *See Adidas*, 963 F.3d at 1358-59.

Even if a POSA would have combined Huang and Shenfield, any combination of the two references would fail to teach certain claim elements of the ’755 Patent, as discussed below. Ex. 2003 ¶¶ 40-41. The four limitations of independent claim 1 for which Huang and Shenfield are deficient are discussed in detail below. Because these four limitations (or corresponding limitations) are present in every challenged

claim of the Petition, there is not a reasonable likelihood that the Board will make a finding that any of the challenged claims in the Petition are unpatentable.¹

1. Huang and Shenfield fail to disclose or render obvious “the device provides the user provided one or more input values and corresponding input symbolic name to the web service”

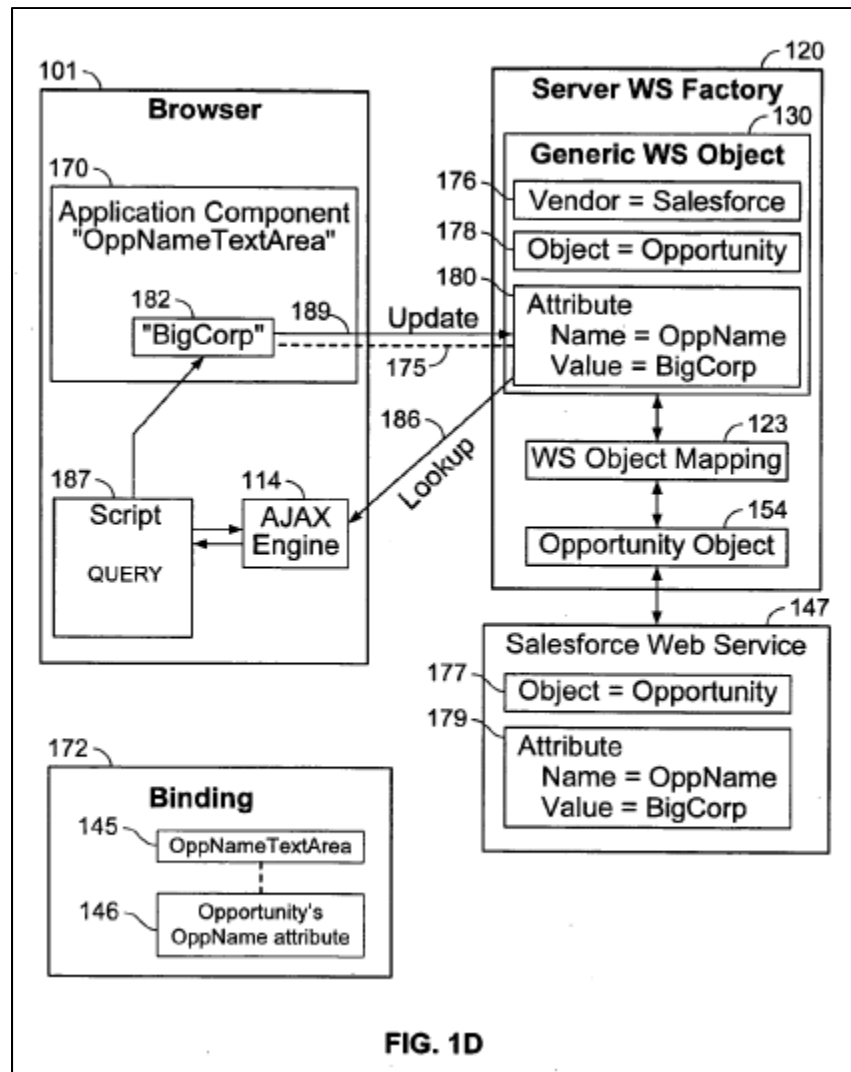
Huang in view of Shenfield fails to disclose or render obvious this element. Indeed, the Petition does not discuss Shenfield in connection with this claim element at all, and instead relies solely on Huang. *See* Paper 2, Petition at 61-62.

Claim 1 requires an “Application and Player [that] are provided to the device” and that “the device provides the user provided one or more input values and corresponding input symbolic name to the web service.” ’755 patent at claim 1. The Petition, relying on Dr. Cullimore, opines that the claimed “device” is disclosed in Huang by a computer that hosts web browser 101, as highlighted in blue in the above annotated Fig. 1A (in my Summary of Huang section). Ex. 1002 ¶ 192; Paper 2, Petition at 58-60; Ex. 2003 ¶ 43.

¹ As Dr. Almeroth explains in paragraph 64 of his declaration (Ex. 2003), the remaining claims of the petition, claims 3, 5-7, 11-12, 14, 16-18, and 22, either depend directly or indirectly from claim 1 or directly or indirectly from claim 12. Claim 12 is substantially identical to claim 1 with respect to the four limitations addressed here. Indeed, Petitioner’s expert Dr. Cullimore treats claims 1 and 12 as being the same for purposes of his analysis. *See* Ex. 1002 ¶¶ 242, 243.

Specifically, Dr. Cullimore refers to the “browser that runs on a device” (bounded by the yellow box annotation in his Figure 1A in paragraph 192), as referencing the claimed device. The Petitioner asserts, relying on Figure 1D, that the claimed web service is disclosed by Huang’s Salesforce web service, as highlighted in green in the above annotated Fig. 1A and shown in Dr. Cullimore’s annotated Figure 1D. Ex. 1002 ¶ 199. Huang discloses that a vendor web service may be, for example, the Siebel web service 140 or the Salesforce web service 142, as shown in green at the annotated Fig. 1A. *See, e.g.*, Huang at ¶¶ 40, 57.

As discussed above in the summary of Huang, the computer running the browser and the web services of Huang do not interact, but instead require an intermediary server 120. Thus, a POSA would understand that what Dr. Cullimore opines is the “device” does not provide anything, including “one or more input values and corresponding input symbolic name” “to the web service,” as required by claim 1. Ex. 2003 ¶ 43. To the extent that anything is provided to what Petitioner and Dr. Cullimore opines is the claimed “web service,” it is provided by the intermediary server 120. This is shown above in the annotated Fig. of 1A and is reiterated with respect to Fig. 1D, as shown below (and as is annotated in Paragraph 199 of Dr. Cullimore’s disclosure):



Huang at Fig. 1D.

Huang expressly discloses that “an application running in an Application Player 106, which is in turn running in the browser 101, *interacts with the WS Factory 120* running in a server 120.” *Id.* at ¶ 057 (emphasis added); Ex. 2003 ¶ 43. Huang’s application and player (on the browser of the purported device) cannot interact with the purported web server, and thus cannot provide any user input, symbolic names, or information to the web server. Ex. 1005 at ¶ 057. Instead, the

application and player must interact with a generic WS Object on the intermediary server 120. *Id.*

Moreover, the intermediary server 120 does not merely pass information along to the web service. Instead it “maps” (i.e., converts) a generic WS Object provided by the device and then provides any results of the mapping to the web service. *Id.* Huang describes this in more detail in paragraph 123. As Huang describes, the WSLookupBean 125 of the intermediary server 120 (shown in Fig. 1B, above) receives information from the device and uses a lookup table to convert the information and generate a “query string.” Huang at ¶ 123. The WSFactory of the intermediary server 120 then “receives the query string and makes the underlying web service call to the web service.” *Id.* Thus, only the intermediary server—and not the purported device—provides values to the web service. In addition, because of the conversion within the intermediary server, the information provided to the web service differs from that provided by the device to the intermediary server 120. Ex. 2003 ¶ 43.

In sum, Petitioner’s proposed combination of references operates in a fundamentally manner and thus does not disclose or render obvious this element for two separate reasons, either of which a POSA would understand to mean that Huang does not disclose or render obvious this claim element. Ex. 2003 ¶ 44. *First*, Huang’s purported “device” provides no information to the **web service** at all, only

the intermediary server 120 does. *Second*, to the extent Huang’s web service receives some input symbolic name, Huang’s purported web service would not receive any symbolic name that came from the purported device because intermediary server 120 would convert any such name before making a web service call to the web server. Ex. 2003 ¶ 44. As discussed above, Huang discloses a device that does not know web service-specific information, including “symbolic names required for evoking one or more web components,” as recited in claim 1. The purported device of Huang simply does not know any “symbolic names required for evoking one or more web components,” and thus certainly cannot provide any. Thus, even taking at face value Dr. Cullimore’s identification of “OppName” as a symbolic name of the web service attribute, Petitioner still fails to point to disclosures that teach this limitation. Ex. 1002 ¶ 199; Ex. 2003 ¶ 44.

Additionally, the intermediary server 120 of Huang, which provides information to the web service, is *not* part of the purported device (the computer running the browser), and Dr. Cullimore offers no opinion to the contrary. Dr. Cullimore opines that “*Huang’s* application and player are provided to the device for execution because the player is provided to and executes in a browser that runs on a device.” Ex. 1002 ¶ 192. On the contrary, Huang provides that intermediary server 120 provides player 106. Huang at ¶ 41 (“The Designer 104 and Player 106 are provided to the Internet Browser 101 *by a server* 120 as web pages.” (emphasis

added)). Thus, intermediary server 120 is not within the purported device; otherwise, the server could not provide player 106 to the device because the player 106 would already be within the device (and Huang would thus fail to satisfy the “Player [is] provided to the device” limitation of claim 1). Ex. 2003 ¶ 45.

A POSA would readily recognize that the server 120 is separate from a device running a browser, as Huang describes it as such. For example, Huang describes the server 120 as a server that provides web pages, such as an “application server computer program such as JBoss.” Huang at ¶ 041. Huang also describes the server 120 communicating with the computer over a network using network protocols, and further describes the server as having a different address than the computer. *Id.* Dr. Cullimore offers no opinion that server 120 is within the purported device, and a POSA would readily recognize that it is not. Huang’s intermediary server is not part of the web service 156. Huang discloses that intermediary server 120 “communicates with the web service via a network protocol” (Ex. 1005, ¶ 043), which a POSA would understand to mean to that the intermediary server and web service are separate. Ex. 2003 ¶ 45.

It would not be obvious to a POSA to modify Huang to cure the deficiencies discussed above, and Dr. Cullimore offers no opinion to the contrary. As discussed above, Petitioner’s proposed combination fails to disclose or render obvious this element in at least two respects: (1) Huang’s purported “device” provides no

information to the web service at all, only the intermediary server 120 does; and (2) to the extent Huang's web service receives some sort of input symbolic name, the name would not be come from the device, but instead it would be generated by the intermediary server 120. Ex. 2003 ¶ 46. Dr. Cullimore offers no opinion that it would be obvious to modify the proposed combination to cure these deficiencies.

Petitioner's expert, Dr. Cullimore, implicitly admits that Huang does not explicitly disclose providing input symbolic name to the web service. Without explanation, he states in a conclusory fashion that "[a] POSITA would have understood from *Huang's* disclosures that *Huang's* system associates the input value to the bound symbolic name, and both are sent to the web service because a POSITA would understand that raw data without any identifying information could not be used by a web service because the web service would have been unable to identify to what attribute the value relates." Ex. 1002 ¶ 198. To the extent he identifies anything, he alleges that "BigCorp" is an input value corresponding to the OppName symbolic name (*id.* ¶ 199), but does not explain how or why that is a symbolic name or how "BigCorp" corresponds to an input corresponding to that name.

It is plain that Dr. Cullimore uses hindsight to assert that *Huang* teaches these elements, as "OppName" is nowhere identified as an identifier akin to a symbolic name in *Huang* (he just cherry-picks it from Figure 1D), and "BigCorp" is identified as a "value 182 of the *application component 170*," not as an input value of an input

symbolic name. Huang at ¶ 169 (emphasis added); Ex. 2003 ¶ 47. Moreover, any such symbolic name would not be provided by the device, as claim 1 requires. To the extent the purported web service receives any input symbolic name, the name would be generated and provided not by the device, but by intermediary server 120, which uses mapping to convert the name before it is provided to the web service. Ex. 2003 ¶ 47.

Dr. Cullimore further admits this by implication in his annotated Figure 1D (Ex. 1002 ¶ 199), where he conspicuously highlights the alleged input symbolic name and web service in yellow within both the browser 101 and Salesforce Web Service 148, but glosses over (and does not highlight) the intermediary “Server WS Factory” 120 which is used to provide the alleged input to the web service. As a POSA would understand, whether the web service necessarily receives a symbolic name (as Dr. Cullimore opines) is a question of whether *intermediary server 120* provides an input symbolic name, not the device, as the claims require. For these at least these reasons, Huang does not disclose or render obvious this limitation. Ex. 2003 ¶ 47. Shenfield does not cure these deficiencies of Huang and Dr. Cullimore offers no opinion to the contrary for this limitation.

Ultimately, the Board correctly found that this limitation was not taught by Huang. *See Google ’755 IPR Institution Decision*, at 13-14. As the Board correctly noted, “Huang does not necessarily provide the claimed ‘input symbolic name’ to

the web service.” *Id.* at 14. Instead, Huang uses a “vendor specific adaptor to interact with the web service.” *Id.* This is consistent with the arguments above, and with Dr. Almeroth’s testimony, which explained that Huang uses an intermediary server to provide any alleged input symbolic names to a web service, not the device itself as the claim requires. *See* Ex. 2003 ¶¶ 43-48. Because the Petition offers no additional argument based on Shenfield for this limitation (*see* Paper 2, Petition at 61-62), Adobe’s Petition should be denied for this reason alone.

2. Huang and Shenfield fail to disclose or render obvious “the web service utilizes the input symbolic name and the user provided one or more input values.”

Huang in view of Shenfield fails to disclose or render obvious this element. Once again, as with the last claim element the Petition does not discuss Shenfield in connection with this claim element at all, and solely relies on a discussion of Huang. *See* Paper 2, Petition at 62-63. Claim 1 requires that “the web service utilizes the input symbolic name and the user provided one or more input values.” ’755 patent at claim 1. The word “the” in this term refers to the previously described input symbolic name provided by the device. *See* Claim 1; Ex. 2003 ¶ 49. As discussed immediately above (and as the Board has already agreed), the web service never receives the input symbolic name from the device in Huang. A POSA would understand that, because the web service never receives the input symbolic name it can never utilize it. Ex. 2003 ¶ 49.

Instead, Huang teaches that a web service utilizes attributes, not from the purported device, but from Vendor-Specific WS Objects of the intermediary server 120. Huang at ¶¶ 069, 104, Fig. 1D. As Huang describes, and as shown in Huang’s Figure 1D, the Salesforce Web Service 147 (what Dr. Cullimore opines is the web service) processes a Vendor-Specific WS-Object 147, which is created by the Server WS Factory 120. As noted above, Huang discloses that the device knows *no details* about *vendor specific objects*. Huang at ¶ 074. But as Huang describes, the details of the vendor specific objects is precisely what the web service “utilizes.” Thus, a POSA would understand that Huang discloses that the purported web service is not utilizing any input symbolic name provided by the purported device, and indeed teaches away from doing so. *See id.*; Ex. 2003 ¶ 49. For these reasons, neither Huang nor Shenfield render this element obvious, and Dr. Cullimore offers no opinion to the contrary.

Additionally, to the extent that Dr. Cullimore or the Petition identified the “OppName” in Figure 1D as the input symbolic name in the preceding limitation for an input value of “BigCorp” (which, for reasons I explained above, is not even a disclosure of a symbolic name or an input value corresponding to that symbolic name, as required), neither the Petition nor Dr. Cullimore provide any disclosure from Huang that would suggest that the alleged “input symbolic name and the user provided one or more input values” is somehow utilized “for generating one or more

output values having an associated output symbolic name.” *See* Paper 2, Petition at 62 (highlighting certain portions of Fig. 1D); Ex. 2003 ¶ 50. Indeed, the disclosures that Dr. Cullimore cites simply refer to generic filtering and retrieval capabilities that are divorced from any reference to an “output symbolic name” or the display of output values. *See* Ex. 1002 ¶ 201 (citing Ex. 1005 at ¶¶ 62, 109).

Specifically, one of the disclosures refers to “reduce the quantity of data to be retrieved from a web service” through a filtering operation (Ex. 1005 at ¶ 62), and the other refers to “retrieval of web service objects” (*id.* ¶ 109)—neither reference particular output values tied to a previous input value, or identify an “output symbolic name” as claimed. This reinforces that Huang, alone or in combination with Shenfield (which neither Petitioner nor Dr. Cullimore address in connection with this claim element), does not teach this limitation.

As with the preceding limitation, the Board in the *Google* case has already found that this limitation was not taught by Huang. *See Google ’755 IPR Institution Decision*, at 13-14. As the Board correctly noted (and Dr. Almeroth again agrees), “the web service of Huang receives a converted name from the intermediary server, rather than ‘the input symbolic name’ from the device as claimed,” and therefore did not “teach[] this limitation.” *Id.* This is consistent with the arguments above, and with Dr. Almeroth’s testimony, which explain that Huang uses an intermediary server to provide any alleged input symbolic names to a web service, not the device

itself as the claim requires. *See* Ex. 2003 ¶¶ 49-51. Because the Petition offers no additional argument based on Shenfield for this limitation (*see* Paper 2, Petition at 62-63), Adobe’s Petition should be denied for this reason alone.

3. Huang and Shenfield fail to disclose or render obvious “an authoring tool configured to . . . produce a Player.”

Huang in view of Shenfield also fails to disclose or render obvious this claim element. Claim 1 requires “an authoring tool configured to . . . Produce a player.” ’755 patent at claim 1. For this limitation, the Petition solely relies on the combination of Huang and Shenfield. *See* Paper 2, Petition at 52-57. Likewise, Dr. Cullimore admits that *Huang* alone does not teach the limitation, and argues only that an alleged combination of Huang and Shenfield discloses the claim element. *See* Ex. 1002 ¶¶ 179-90. Dr. Almeroth agrees with Dr. Cullimore that Huang alone does not teach the *claimed* Player, or an authoring tool that is configured to “produce a Player” as claimed. Ex. 2003 ¶ 52.

It would not have been obvious to modify Huang’s “designer” (what Adobe claims is the authoring tool), to produce the claimed Player. *See* Ex. 1002 ¶ 189. A POSA would not be motivated nor find it obvious to make such a modification. Huang does not disclose, suggest, or render obvious that its designer 104 does (or could be modified to) produce the claimed Player. Huang’s designer 104 is an “Application Designer” and is referred to as such throughout the specification. *See*

id. at Figs. 1A, 2A, 2B, 7, ¶¶ 014, 015, 020, 067, 078, 103, 104, 105, 114, 118, 133; Ex. 2003 ¶ 53.

Moreover, a POSA would understand that Huang’s designer 104 cannot produce the player 106. *Id.* The purported authoring tool (designer 104) and the purported player (player 106) are both provided to the browser by the intermediary server 120. Huang at ¶ 41. After receipt, the designer 104 executes on the web browser. *Id.* at ¶ 41, Fig. 1A. As Dr. Almeroth explains, a POSA would understand that the designer 104 would “produce” the player 106 in the server, before it is even executed. Ex. 2003 ¶ 53. Neither the Petition nor Dr. Cullimore address these deficiencies at all.

The Petition asserts that one reason the POSA would have successfully combined Huang and Shenfield was “because *Huang*’s designer already generates code.” Paper 2, Petition at 57; Ex. 1002 ¶ 189 (Dr. Cullimore noting that Huang’s “designer already generated code in the form of applications, thus indicating that it can also produce code in the form of players”). However, as Dr. Almeroth confirms, it is not correct that simply because designer 104 is configured to generate one type of software, it would be easy or obvious to modify it to produce any other type of software; and that offering such any conclusion is based on hindsight. Ex. 2003 ¶ 54.

Moreover, A POSA would not find it obvious or be motivated to significantly retool designer 104 to also produce a different type of software. Huang discloses the web browser receiving player 106 from server 120. *See id.*; Huang at ¶ 41. As the browser receives player 106 from server 120, there would be no reasonable motivation to modify Huang so that a designer running on the browser would reproduce a player 106 that is already available, and Dr. Cullimore provides none.

Generating a player is an entirely different and much more difficult undertaking than producing an application. Huang states that “Applications created by the Designer 104 are stored in Extensible Markup Language (XML) format as XML definitions 122 in a database 124, and loaded into the Player 106 as the application 111.” Huang at ¶ 042. Saving data in XML format is fundamentally different from and significantly simpler than generating Java Server Pages (JSP) or JavaScript that implements a player especially code for a Player with the additional requirements of the claims (*e.g.*, the inclusion of device dependent code).

Neither the idea of using Designer 104 to generate JSP/JavaScript nor how to do so is disclosed anywhere in Huang. Dr. Cullimore does not explain how this wholesale change can be made to Huang’s designer 104 and why such change would not break existing functionality of the designer. A POSA would not be motivated to create a whole new designer that can simultaneously generate XML definitions for an application and JSP/JavaScript for a player. Dr. Cullimore opines that a POSA

would be motivated to “leverage[e] an already existing resource in Huang[]” (Ex. 1002 ¶ 189), but fails to explain how any resource in Huang’s designer 104 could be leveraged to produce a player.

Indeed, no resources would be leveraged: to produce a player—software completely different than the application—designer 104 require a wholesale redesign. Ex. 2003 ¶ 54. That is, a designer would have to start from scratch and reproduce an entirely different designer 104. As such, Petitioner’s proposal would actually waste resources by discarding the functionality already made available by Huang’s designer 104. For these reasons, Huang does not disclose or render obvious this limitation. Ex. 2003 ¶ 54.

Petitioner and Dr. Cullimore are also wrong to the extent they assert that the POSA “would have been motivated to substitute *Huang*’s players with *Shenfield*’s players written in device-specific code that can provide instructions tailored to optimize the display of content specified in *Huang*’s device-independent applications for each runtime environment.” Ex. 1002 ¶ 185; Pet. at 56 (asserting that POSA “would have been motivated to replace *Huang*’s players with *Shenfield*’s device-specific code (*player*)”). A POSA would have been discouraged from

substituting the player taught in *Huang* with *Shenfield*'s purported "players,"² which Dr. Cullimore relies on for alleged disclosures of a device-dependent player.

As discussed above, the application player in *Huang* runs within a browser 101, as Figures 1A and 1D of *Huang* confirm. Ex. 2003 ¶ 55. This, including the claim language among other disclosures, underscores that the application (and associated Player) discussed in *Huang* is fundamentally "browser-based." *Huang* at Claim 1 ("wherein the accessing is via a web browser"), FIGS. 1A, 1D, & ¶ 40 ("The Player 106 is a browser based application 111"). This is in direct contrast to *Shenfield*, which *discourages* the POSA from using a browser-based application, and in fact encourages conversion *away from* such applications to a component-based applications. *Shenfield* at ¶ 5 ("[A] method is disclosed for converting a page-based [browser-based] application to a component based application configured for execution on a devices"); *id.* ¶ 53 ("Unlike browser-based applications 107 that require a Web Server to host additional components . . . to connect HTML pages data/requests with a service endpoint, the component application model allows end-to-end direct connectivity.").

² Dr. Almeroth does not agree that *Shenfield* teaches a Player, as claimed, although Dr. Cullimore attempts to apply that label to *Shenfield*'s teachings. Ex. 2003 ¶ 55 n.1.

Because Shenfield is about the conversion of browser-based applications to component-based ones and discourages the use of the browser-based applications taught in Huang, the POSA with Huang would have been discouraged from combining Huang with Shenfield. Ex. 2003 ¶ 54. Thus, as a matter of law, the references cannot be combined because a POSA with Huang “would be led in a direction divergent from the path that was taken by the applicant.” *Ricoh Co., Ltd. v. Quanta Computer Inc.*, 550 F.3d 1325, 1332 (Fed. Cir. 2008). For similar reasons, the references cannot be combined because Huang and Shenfield have “fundamental differences” in their operation. *Adidas*, 963 F.3d at 1358-59.

Moreover, no POSA would have combined Huang with Shenfield in a manner that meets the requirements of the “produce a Player” limitation. The Petition, along with Dr. Cullimore’s opinion, is purely based on hindsight. Ex. 2003 ¶ 56. As noted above, nothing identified as a “Player” is taught in Shenfield, and Dr. Cullimore simply adds that label to certain teachings of Shenfield, which have no connection whatsoever to the claim requirements of the “Player” recited and claimed in the ’755 patent. *Id.*

In paragraphs 185 through 189 of Dr. Cullimore’s report that Petitioner cites, he suggests that Shenfield’s disclosures include device-dependent code and are somehow “similar” to Huang so as to motivate a combination, but he (along with Petitioner) does not explain how there is any similarity whatsoever between Huang’s

browser-based application and Shenfield’s *converted*, non-browser based application. Ex. 2003 ¶ 56. This is why, as Petitioner’s expert admits, “the modified *Huang-Shenfield* system would utilize a player that operates *in the native runtime environment and would not rely on a web browser.*” Ex. 1002 ¶ 205 (emphasis added). Therefore, the POSA attempting to combine Huang with Shenfield would lose all the advantages of browser-based application taught in Huang. Ex. 2003 ¶ 56. This reinforces that the POSA would not combine the references, that Huang’s principle of operation would be undermined in a combination with Shenfield, and that the fundamental differences between the references negate the combination.³

As noted above, moreover, Shenfield’s focus on application conversion undermines the combination. Dr. Cullimore avoids the conversion issue entirely because that issue underscores that Shenfield is not about a Player that interacts with an application. Ex. 2003 ¶ 57. Instead, Shenfield’s alleged “Player” is nothing more

³ Dr. Cullimore appears to acknowledge this problem, separately suggesting that *Shenfield*’s invention could be run in browsers because its component applications can be “executed as native code or interpreted by another software module” (Ex. 1002 ¶ 185), but there is nothing in Shenfield or in this disclosure that would suggest to a POSA that Shenfield’s application should be run in a browser. To the contrary, the disclosures of Shenfield collectively demonstrate that the component applications were precisely meant to be non browser-based to achieve the advantages of the invention. Ex. 2003 ¶ 56.

than a converted Application. Shenfield does not have a separate “Application” and “Player,” but instead just teaches a pre-conversion “Application” and a post-conversion “Application.” This is yet another reason that a POSA would not have been motivated by Shenfield to include the claimed “Player” within Huang, let alone one that is “produced by” the authoring tool as claimed. Ex. 2003 ¶ 57. As noted above, the “designer” of Huang does not produce any Player code, and Shenfield does not have any authoring tool that would be understood to produce any such Player code even if it existed, since Shenfield is nothing more than a converter between a page-based, browser application and a component-based one.

In sum, Huang in view of Shenfield would not be understood to render the “produce a Player” limitation obvious for a litany of independent reasons set forth above, including but not limited to the fact that the POSA would have been discouraged from combining the references in the first place. Indeed, the opinion in the *Google* IPR again confirms Huang’s problems with this limitation. In the decision denying institution, the Board correctly concluded that “the player disclosed by Huang is sent from server 120 to browser 101 (which executes the player and the Application Designer), not produced by the Application Designer,” and Google (the Petitioner) there, admitted as much. Google IPR Institution Decision at 13. Dr. Almeroth agrees with the Board’s decision that “Huang does not disclose how the designer or any other resource of Huang would produce a

player,” and notes that nothing in Shenfield referenced by Dr. Cullimore cures the Petition’s deficiencies on this limitation. Ex. 2003 ¶¶ 58-59. This furnishes yet another independent reason why the Petition should be denied.

4. Huang and Shenfield fail to disclose or render obvious “said Player receives the output symbolic name”

Huang in view of Shenfield also fails to disclose that the “web service” utilize the input symbolic name from the device “for generating one or more output values having an associated output symbolic name.” ’755 patent at claim 1. As discussed above, the combination does not teach or render this limitation obvious, quite independent from the requirement of a “Player.” Additionally, the combination of Huang in view of Shenfield does not teach or render obvious the “producing a Player limitation,” as discussed above, as the combination does not include the *claimed Player* or teach the *production* of such a Player. For these reasons alone, Huang and Shenfield do not render this claim limitation obvious alone or in combination.

Indeed, this Claim limitation *also specifically* requires that “***said Player*** receives the output symbolic name.” ’755 patent at claim 1 (emphasis added). Neither the Petitioner or Dr. Cullimore identify any disclosure of Huang or Shenfield that teaches any purported Player receiving any purported output symbolic name. *See generally* Ex. 1002 ¶¶ 203-211. A POSA would understand that Huang in view of Shenfield does not disclose this functionality or render it obvious. Ex. 2003 ¶ 61.

To the extent that Dr. Cullimore cites anything, he cites references that discuss the possibility of querying a web service “value,” which might be displayed, along with other generic citations. *See* Ex. 1002 ¶ 203 (citing Ex. 1005, ¶¶ 57, 70). These generic citations (and the others cited by Dr. Cullimore) do nothing to link Huang’s disclosures to an “output symbolic name,” let alone make a connection between any Player in Huang and an output symbolic name as claimed.

This is also true with respect to Figure 1A and Dr. Cullimore’s assertion that Huang “mediates” the communications between the Application and a web service. *See* Ex. 1002 ¶¶ 206-207. Indeed, the annotated version of Figure 1A on page 128 of Dr. Cullimore’s declaration reinforces that Huang’s Player, at most, mediates communications between the *Application Server* and the application (as shown with the red circle)—not communications between the application and the web service. This Figure and associated disclosures likewise have no relation to the Player’s receipt of an “output symbolic name” or the web service architecture recited in the ’755 patent. Ex. 2003 ¶ 61. This simply reinforces that, in *Huang*, the purported device has no knowledge of web service specificities and a POSA would understand that it would not be obvious to provide the output symbolic name discussed in the web service element of the claim to the player. *Id.*

In paragraph 211, Dr. Cullimore implicitly acknowledges the deficiencies of this limitation based on Huang alone, and asserts that this limitation would have been

obvious based on the combination of Huang and Shenfield. Ex. 2003 ¶ 62. But as noted above, the POSA would not even have combined these references for the reasons given above.

In fact, Dr. Cullimore's only reference to Shenfield in connection with this limitation is to a portion that references "message processing" and "instructions" in connection with Shenfield's "workflow components." See Ex. 1002 (citing Ex. 1007 ¶ 45). This teaching in Shenfield has nothing to do with the receipt of output symbolic names by anything, let alone the claimed Player or associated web services, and Dr. Cullimore simply makes generic, conclusory statements about how these teachings relate to the display of outputted messages. Ex. 2003 ¶ 62. Likewise, Dr. Cullimore provides no explanation of how or why this teaching would have motivated the POSA to combine the references in a manner that meets this limitation. This reinforces that the combination of Huang and Shenfield would not render this claim limitation obvious, even if the references were somehow combined (which, as noted above, they would not have been).

Finally, in connection with this limitation, the *Google* IPR decision again reaffirms the problems with the combination. In the decision denying institution, the Board (correctly, in Dr. Almeroth's view), found that this limitation was not taught by Huang. See *Google* IPR decision at 15-16; Ex. 2003 ¶ 63. Shenfield,

again, does not cure the deficiencies cited by the Board, and therefore the Petition must again be denied.

IV. The Board should exercise its broad discretion to deny institution under Sections 314(a) and 325(d).

The Board has broad discretion under both Section 314(a) and 325(d) to deny institution of *inter partes* reviews. Apart from the numerous reasons that the Board should decline to institute this IPR based on the Petition’s lack of merit, as discussed above, the Board should also exercise its discretion to deny institution under Section 314(a) and 325(d) for three reasons. *First*, several parallel district court trials involving the ’755 patent, including one scheduled for January 2022, will conclude well before any Final Written Decision would issue in this IPR, and each of the six factors outlined by the Board in *Apple Inc. v. Fintiv, Inc.* favor denying institution.

Second, Petitioner presents the same or substantially the same references and arguments already considered by the Patent Office through both the Examiner during prosecution and the PTAB in the *Google IPR*, as Petitioner itself admits. *Compare* Paper 2, Petition at 2–3 (“Statutory Grounds of Challenge”) *and Google*, IPR2021-00709, Paper 7 at 6 (“Asserted Ground[s] of Unpatentability”); *see also* Paper 2, Petition at 85 (noting that the Petition here “relies on . . . the same base reference as the earlier-filed Google IPR,” and that “the grounds asserted in Adobe’s Petition has similarities with Google’s IPR” (cleaned up)). The Patent Office has already determined that the challenged claims are patentable over the same primary

reference and similar arguments involving a secondary reference and it did not err.

Third, the petition is a follow-on; it is the third to challenge the '755 patent before the PTAB. The Board already denied institution of the first petition, filed over six months ago by Google. *See Google LLC v. Express Mobile, Inc.*, IPR2021-00709 (“*Google IPR*”), Paper 7 (Oct. 4, 2021). Under *General Plastic v. Canon*, denying institution is necessary to prevent the “abuse of the review process by repeated attacks on patents” by Petitioner and other district court defendants. The Board should deny institution.

A. The Board should exercise its discretion under Section 314(a) to deny institution in view of several parallel and advanced district court proceedings.

Multiple district court trials will conclude before any final written decision would issue in this IPR. Instituting IPR would be duplicative of parallel litigation and would risk multiple tribunals reaching inconsistent results, wasting the Board’s resources. The Board balances six factors, set forth in *Apple Inc. v. Fintiv, Inc.*, when weighing a discretionary denial under these circumstances. IPR2020-00019, Paper 11 (Mar. 20, 2020). Each of those factors favor denying institution.

1. Factor 1 strongly favors denial because parallel litigation has not been stayed and evidence indicates that no stay will be granted.

There are 20 pending district court litigations involving the '755 patent, most of which have not been stayed.

Petitioner also presents no evidence that a stay might be granted in these parallel litigations. Petitioner only speculates about its litigation pending in the Northern District of California, and others pending in the same venue. Petitioner guesses, for example, that “Judge Seeborg will likely grant a stay because he often grants stays,” and that “Judge Seeborg is likely to stay the ten other pending cases asserting the ’755 patent and also assigned to him as well.” Paper 2, Petition at 78.

Petitioner’s wishful thinking is not evidence. The actual evidence here indicates the opposite: that the district court would not grant a stay. Petitioner has not moved for a stay pending this IPR, and it conveniently omits that Judge Seeborg already denied Petitioner’s motion to stay pending reexamination of other patents. Ex. 2007, *In re Express Mobile Cases*, 3:20-cv-08297-RS, Dkt. 49 (April 5, 2021). As a result, there is *no stay* in the Northern District of California cases with respect to the ’755, ’287, and ’044 patents—for which claim construction proceedings remain ongoing, and for which Express Mobile just filed its opening claim construction brief this past Friday, October 22, 2021. Were Defendants to attempt to seek a stay in the Northern District of California litigation once again, Express Mobile would oppose, and the district court would most certainly deny the motion. This is particularly true now given that the Board has already denied the *Google IPR*.

Petitioner also makes no mention of the parallel litigation pending in venues other than the Northern District of California, including four with much earlier trial dates

for the '755, '287, and '044 patents (one just months from now):

- 1) *Shopify Inc. v. Express Mobile, Inc.*, No. 1-19-cv-00439 (D. Del.) – **January 10, 2022 (> 12 months before FWD)**
- 2) *Express Mobile, Inc. v. GoDaddy.com, LLC*, No. 1-19-cv-01937 (D. Del.) – **March 7, 2022 (> 10 months)**
- 3) *Express Mobile, Inc. v. Google LLC*, No. 6-20-cv-00804 (W.D. Tex.) – **September 12, 2022 (> 4 months)**
- 4) *Express Mobile, Inc. v. Atlassian Corporation PLC*, No. 6-20-cv-00805 (W.D. Tex.) (September 12, 2022) – **September 12, 2022**

None of these parallel litigations with earlier trial dates have been stayed, and there is no indication that these cases will be stayed. Indeed, in *Shopify Inc. v. Express Mobile, Inc.*, No. 1-19-cv-00439 (D. Del.), for which trial is set to begin January 10, 2021, the Court has already denied Shopify's motion for summary judgment of non-infringement, the parties are making pre-trial exchanges, and the Court has already entered its order approving the schedule for those exchanges. *See* Ex. 2008, *Shopify Inc v. Express Mobile, Inc.*, No. 19-cv-00439, D.I. 306 (D. Del. Oct. 13, 2021) (approving pre-trial exchange dates beginning on October 27, 2021 through the beginning of trial on January 10, 2022).

This factor strongly favors denial.

2. Factor 2 strongly favors denial because trial in parallel litigation will conclude well before the final written decision.

Trial in parallel litigation will conclude well before the deadline for the Board's final written decision. When "the court's trial date is earlier than the

projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Fintiv*, Paper 11 at 9. This remains true even if the Petitioner is not a party to the parallel trial. *See Fitbit, Inc. v. Philips North Amer. LLC*, IPR2020-00828, Paper 13 at 8-11 (P.T.A.B. Nov. 3, 2020) (finding that although **Petitioner’s trial date was not set**, the third-party trial “will ... take place several months prior to the final decision”). “This proximity inquiry is a proxy for the likelihood that the trial court will reach a decision on validity issues before the Board reaches a final written decision.” *Philip Morris Products, S.A. v. RAI Strategic Holdings, Inc.*, IPR2020-00921, Paper 9 at 16 (P.T.A.B. Nov. 16, 2020).

Numerous Board decisions, including the Board’s informative Decision Denying Institution in *Fintiv* (following the precedential Order in *Fintiv*), have held that trial scheduled prior to the FWD deadline weighs in favor of denying institution. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (P.T.A.B. May 13, 2020) (informative) (**two months**); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 (P.T.A.B. May 15, 2019) (**one month**); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00162, Paper 16 (P.T.A.B. June 5, 2019) (**one month**); *Netflix, Inc. et al. v. Uniloc 2017 LLC*, IPR2020-00008, Paper 13 (P.T.A.B. Apr. 13, 2020) (**two months**); *Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00961, Paper 10 (P.T.A.B. Oct. 16, 2019) (**three months**); *Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00962, Paper 10

(P.T.A.B. Oct. 16, 2019) (**three months**); *Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00963, Paper 8 (P.T.A.B. Oct. 28, 2019) (**three months**); *see also Fitbit*, IPR2020-00828, Paper 13 at 8-11 (third-party trial “will ... take place several months prior to the final decision”). The Board should follow the guidance of these decisions.

Here, multiple district court trials are set to occur before the FWD deadline in this IPR (January 23, 2023) and, in the *Shopify* litigation, even before the Institution Decision deadline (January 23, 2022), a fact that Petitioner, again, conveniently omits. *See* Paper 2, Petition at 78–79. Petitioner’s focus on its own litigation, and “the ten other cases Express Mobile brought in the same district,” is misplaced. *Id.* at 79. The Board has broad discretion to deny institution in view of parallel and duplicative proceedings even if the Petitioner is not a party to those proceedings. *See Fintiv*, IPR2020-00019, Paper 11 at 14 (“Even when a petitioner is unrelated to a defendant, however, if the issues are the same as, or substantially similar to, those already or about to be litigated, or other circumstances weigh against redoing the work of another tribunal, the Board may, nonetheless, exercise the authority to deny institution.”); *Fitbit*, IPR2020-00828, Paper 13 at 8-11. The Board should exercise its discretion here.

This factor strongly favors denial.

3. Factor 3 strongly favors denial because, by the institution deadline, the parties and the trial courts will have made significant investment in the parallel litigations.

Multiple district courts, Express Mobile, Petitioner, and several other defendants will have made significant investment in parallel litigation by the institution deadline of January 23, 2022. With respect to the Petitioner's parallel litigation, the parties served infringement contentions and invalidity contentions (including the same obviousness ground, *Huang* in view of *Shenfield*) with respect to the '755, '287, and '044 patents, claim construction discovery (including briefing) is underway, and the claim construction hearing will occur over a month before the Institution Decision deadline. Ex. 2009, *Express Mobile, Inc. v. Adobe Inc. et al.*, No. 20-cv-08297-RS, Dkt. 51 at 1 (N.D. Cal.) (claim construction hearing: December 8, 2021); Ex. 2010, *id.*, Adobe's Invalidity Contentions, pgs. 30–31, 75–79 (July 19, 2021). Petitioner focuses on work remaining to be done and overlooks the investment that has already been made. Paper 2, Petition at 79–80. These efforts indicate that institution would lead to significant duplicative costs.

These costs only multiply across the other parallel litigations before other district courts, several of which are at a more advanced stage. Before the institution decision, for example, Judge Andrews of the District of Delaware, will have already conducted a five-day jury trial in the *Shopify* case concerning the '755 patent and substantially the same invalidity ground (with the same primary reference, *Huang*)

raised by the Petitioner. Ex. 2011, *Shopify Inc. et al. v. Express Mobile, Inc.*, No. 19-cv-439-RGA, D.I. 288 (Jan. 22, 2021); Ex. 2012, *id.*, Rebuttal Expert Report of Kevin C. Almeroth, Ph.D. (October 7, 2020) (responding to Shopify’s expert’s obviousness opinions based on *Huang*). The trial date in that case is January 10, 2022. Ex. 2008 (Shopify Order re Pre-Trial Exchanges) at 2 (confirming January 10, 2022 start of trial).

In *Express Mobile v. GoDaddy*, which is currently slated for trial on March 7, 2022, Defendant GoDaddy (and its expert) has also raised *Huang* as a primary reference in combination with a similar secondary reference. Ex. 2013, *Express Mobile, Inc. v. GoDaddy.com, LLC*, No. 1-19-cv-01937 (D. Del.), Opening Expert Report of Philip Greenspun, Ph.D., Regarding Invalidity of the Patents-in-Suit at p. 180 (¶ 427) (July 30, 2021) (“*Huang* in combination with *Stevens*”); Ex. 2017 (GoDaddy Scheduling Order) at 16 (confirming trial date of March 7, 2022).

Petitioner’s claim of diligence with respect to the filing of its Petition is not only irrelevant, it is incorrect. Paper 2, Petition at 82. Express Mobile notified Petitioner of its infringement of the ’755 patent by at least February 2020. Ex. 2014, Letter from Devlin, T. to Adobe Inc. (February 6, 2020). Petitioner was thus aware of its infringement for well over a year before it filed the petition on July 6, 2021—almost 18 months after Adobe had been placed on notice of its infringement. Petitioner does not offer any explanation for its lengthy delay.

This factor strongly favors denial.

4. Factor 4 strongly favors denial because there is significant overlap between the issues raised in the petition and parallel litigation.

There is significant overlap between the issues raised in the Petition and in parallel litigation, including the underlying parallel litigation between Express Mobile and Petitioner. This strongly favors denial.

The petition advances its sole invalidity ground of obviousness as being *Huang* in view of *Shenfield*. Paper 2, Petition at 2–3. The same ground—*Huang* in view of *Shenfield*—is advanced by Petitioner in its invalidity contentions in its parallel litigation. Ex. 2010, *id.*, Adobe’s Invalidity Contentions, pgs. 30–31, 75–79 (July 19, 2021).⁴

Several other defendants have also advanced the same or substantially similar ground in advanced parallel litigation, including in both invalidity contentions and expert reports. For example, in the *Shopify* litigation going to trial on January 10,

⁴ That Adobe presents additional invalidity contentions in the trial court does not favor institution. *See Intel Corporation v. VLSI Technology LLC*, IPR2020-00498, Paper 16 at 8 (P.T.A.B. Aug. 19, 2020) (“Although Petitioner’s Final Invalidity Contentions include other combinations of references challenging overlapping claims, *see id.*, that difference alone does not negate that the same combinations of references asserted in the Petition also are asserted in Petitioner’s Final Invalidity Contentions.”).

2022 (before the institution deadline), Shopify’s expert is expected to raise obviousness, again with *Huang* as a primary reference in certain proposed obviousness grounds. *See* Ex. 2012, *Shopify Inc. et al. v. Express Mobile, Inc.*, No. 19-439-RGA (D. Del.), Rebuttal Expert Report of Kevin C. Almeroth, Ph.D. (October 7, 2020) (responding to Shopify’s expert’s obviousness opinions based on *Huang*); Ex. 2005 at 1-2 (Exhibit C-20 to Google’s Invalidity Contentions, raising obviousness in view of *Huang*).

Petitioner focuses only on its parallel litigation with Express Mobile, and its alleged stipulation “that if IPR is instituted, it will not assert the same invalidity grounds in this petition, as well as any invalidity grounds with the same primary references as this petition.” Paper 2, Petition at 80. However, Petitioner has not made any such stipulation before the trial court and has not informed Express Mobile it intends to make such a stipulation. Indeed, it is not clear that Express Mobile could enforce the supposed stipulation in the underlying litigation, and it should therefore be disregarded by the Board.

Even if the Board credits Petitioner’s alleged stipulation, it is like the one in *Philip Morris* which the Board found to be “narrowly crafted”:

<i>Philip Morris</i> Stipulation	Petitioner’s Stipulation
“Petitioner stipulates that it will not pursue any IPR grounds in the EDVA	“Petitioner hereby stipulates that if IPR is instituted, it will not assert the same

<i>Philip Morris</i> Stipulation	Petitioner’s Stipulation
case if the Board institutes.”	invalidity grounds in this petition, as well as any invalidity grounds with the same primary references as this petition, in the ExMo-Adobe Litigation.”

Compare IPR2020-00921, Paper 9 at 19; Paper 2, Petition at 82. Petitioner can still pursue substantially overlapping arguments in the trial court, using cumulative primary references and the same or cumulative secondary references.

Even if Petitioner’s “stipulation” were given credence, the claim construction issues in this IPR also will overlap with those in the parallel litigation. Both tribunals apply the same claim construction standard (i.e., *Phillips*). Petitioner supposedly “applies the district court construction” of several claim terms. Paper 2, Petition at 13. But Petitioner’s positions before the Board and the district court materially differ. In the District Court proceeding, Adobe has taken numerous claim construction positions that deviate from positions that were adopted by district courts—these include, for example, proposed constructions of Application, Player, and device-dependent code that contain materially distinct language from the constructions that have been adopted in the *GoDaddy* and *Shopify* proceedings. Ex. 2018 (Adobe L.R. 4-3 Statement) at 1, 10, 13, 18 (showing Defendants’ (including Adobe’s) Preliminary Constructions of Application, Player, and device-dependent

code that are different from Express Mobile's (and the *Shopify/GoDaddy* Court's) proposed constructions of those terms).

While Patent Owner generally disagrees that Petitioner's proposed constructions before the trial court are proper, the Board should reject Petitioner's gamesmanship. There is no question that the petition fails to demonstrate any likelihood of success under Petitioner's proposed constructions in the parallel proceeding. Petitioner should not be allowed to pick different theories in different forums. Claim construction proceedings for the '755, '287, and '044 patents are well underway in the district court, and the Board should exercise its discretion to avoid duplicating this work.

This factor strongly favors denial.

5. Factor 5 favors denial because Adobe is both Petitioner in this IPR and Defendant in the parallel litigation.

The Petitioner in this IPR, Adobe, is the Defendant in the parallel district court proceeding. Petitioner is incorrect that this factor is "neutral." Paper 2, Petition at 80. Identity of the parties is the precise inquiry of this factor. And the identity of the parties favors denial. *See Fintiv DDI*, Paper 15 at 15 ("Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.").

6. Factor 6 strongly favors denial because the merits of the Petition are weak and lacking evidence.

Even “if the merits of the grounds raised in the petition are a close[] call, then that fact has favored denying institution when other factors favoring denial are present.” *Fintiv*, Paper 11 at 14-15.⁵ The merits here not a “close call.” *Id.* The Petition suffers several fatal flaws, including several fatal flaws in the primary reference (*Huang*) that the Board identified when it denied institution on the merits in the *Google IPR*, along with additional deficiencies in the proposed combination of *Huang* with *Shenfield*, as discussed above. This factor strongly favors denial.

The efficiency and integrity of the system are best served by denying institution. Every *Fintiv* factor supports that conclusion. The Board should deny institution.

⁵ Even if the Board disagrees on the merits, strong merits alone are not enough to save a petition from discretionary denial. *Supercell Oy v. GREE, Inc.*, IPR2020-00310, Paper 13 at 19 (P.T.A.B. June 18, 2020) (“Despite Petitioner's strong case on the merits, we determine that the facts underlying factors 2-5 collectively outweigh the facts underlying factor 6.”); *see also Garmin International, Inc. v. Koninklijke Philips N.V.*, IPR2020-00754, Paper 11 at 16-19 (P.T.A.B. October 27, 2020).

B. The Board should exercise its discretion to deny institution because the Patent Office previously considered the same or substantially the same references and did not err.

The Examiner considered Petitioner’s primary reference (*Huang*) during prosecution and further considered art cumulative of Petitioner’s only secondary reference (*Shenfield*). The Board did the same when it denied institution in the *Google IPR*. Petitioner admits that its petition shares “similarities” with the already-denied *Google IPR*:

[T]his Petition relies only on one ground to assert obviousness—*Huang* in view of *Shenfield*—and on the same base reference as the earlier-filed *Google IPR*. Accordingly, “the grounds asserted in Adobe’s Petition has similarities with Google’s IPR that will allow the Board to evaluate the Board to evaluate the two petitions efficiently.”

Paper 2, Petition at 85 (cleaned up, quoting *Netflix, Inc. v. Realtime Adaptive Streaming LLC*, IPR2018-01630, Paper 13 at 14 (P.T.A.B. Apr. 19, 2019)).

Here, Adobe’s admission underscores that the Board is in a position here to “efficiently” deny the instant Petition. Petitioner makes no showing—or even assertion—that the Patent Office erred when it determined that the challenged claims are patentable over these references. Nor can it for the various reasons discussed above it. The Board applies a two-part framework, set forth in *Advanced Bionics*, when weighing a discretionary denial under § 325(d). Under that framework, the Board should deny institution.

1. Petitioner advances the same or substantially the same art and arguments that were previously presented to the Patent Office.

Step 1 of the Section 325(d) framework—“whether the same or substantially the same art or arguments were presented to the Office”—is satisfied. *Advanced Bionics, LLC v. Med-El Electromedizinische Geräte GMBH*, IPR2019-01469, Paper 8 at 10 (P.T.A. B. Feb. 13, 2020). Petitioner advances the same or substantially the same art and arguments—one ground, *Huang* in view of *Shenfield*—that is either identical or cumulative to art previously presented to the Patent Office during both prosecution and the *Google IPR*.

a) The Examiner considered Huang during prosecution and the Board considered Huang when it denied institution in the Google IPR.

Petitioner leans almost exclusively on its primary reference, *Huang*. After reviewing only the cover page of the issued '755 patent, Petitioner states: “The USPTO did not consider *Huang* and *Shenfield* during prosecution of the '755 patent.” Paper 2, Petition at 3 (citing Ex.1001). This is not true.

The Examiner did consider *Huang*. The '755 patent application was filed as PCT Application No. PCT/US2009/039695. Ex. 1001, '755 patent at Cover Page. In connection with the PCT application, the International Searching Authority issued an International Search Report and Written Opinion (“ISR”). Ex. 2006. The ISR cited only five references considered to be relevant to the patentability of the '755

patent. *Id.* at 2. One of them is *Huang*. *Id.*

Express Mobile presented the ISR to the Examiner early in the prosecution of the '755 patent. Ex. 1004 at 971. This presentation satisfies the first inquiry under the two-part framework. *See Boragen, Inc. v. Syngent Aparticipations AG*, IPR2020-00214, Paper 16 at 22, 35 (P.T.A.B. May 5, 2020) (denying institution under § 325(d) after finding that a reference was “presented during prosecution” when it was “cited among a relatively short list of references . . . in the Information Disclosure Statements as well as the International Search Report submitted early in the prosecution”); *see also id.* at 21-22 (“a rejection applying a reference . . . is not a prerequisite to a finding that the reference was already presented to the Office under § 325(d)”).

The Examiner also actively considered *Huang*. For example, the Examiner entered a search query for *Huang*’s publication number, “2007/0118844.” Ex. 1004 at 1277 (searching for *Huang* at 16:04 and not performing another search for over 1.5 hours at 17:47). Simply put, the Examiner considered *Huang*, but did not determine that the reference rose to the level of being used as a basis to reject the claims.

Lastly, if Express Mobile’s presentment and the Examiner’s consideration of *Huang* were not already enough, the Board thoroughly considered *Huang* when it denied institution in the *Google IPR*. Google, like Petitioner here, raised a single

ground using *Huang* as the primary reference. *See Google IPR*, Paper 7, Institution Decision at 8–16 (Oct. 4, 2021). The Board, in denying institution, considered *Huang* and determined that it fails to disclose four limitations of the challenged claims. *Id.* at 12–16. Adobe’s Petition here is flawed with respect to the same four limitation as discussed above, and nothing in *Shenfield* cures the deficiencies.

b) The Examiner considered art cumulative of Shenfield during prosecution, and the Board did the same when it denied institution in the *Google IPR*.

Under the second *Becton, Dickinson* factor, Shenfield is cumulative of art that the Office considered during prosecution. “A reference is cumulative when it teaches no more than what a reasonable examiner would consider to be taught by the prior art already before the PTO.” *Roku, Inc. v. Universal Elecs., Inc.* IPR2019-01619, Paper 11 at 12 (P.T.A.B. April 2, 2020) (quoting *Regeneron Pharm., Inc. v. Merus N.V.*, 864 F.3d 1343, 1350 (Fed. Cir. 2017)). As discussed above, Petitioner relies on only Huang (and not Shenfield at all) for two of the four limitations in question—“the device provides the user provided one or more input values and corresponding input symbolic name to the web service,” and “the web service utilizes the input symbolic name and the user provided one or more input values for generating one or more output values having an associated output symbolic name.” Paper 2, Petition at 61-63. For these two limitations, therefore, Adobe’s Petition is cumulative to what Google previously argued in its denied IPR. To the extent that

Adobe relies on Shenfield to cure Huang’s deficiencies in “produce a Player” and “Player receives the output symbolic name” limitations, Shenfield does not cure the deficiencies and in fact teaches away from any possible combination.

The first inquiry is satisfied when the same or substantially the same art *or* arguments were presented to the Office. *Advanced Bionics* at 10. The Office also considered the same or substantially the same argument that Petitioner asserts here, namely that a person of skill in the art would be motivated to combine Shenfield and Huang. As set forth above, Petitioner’s alleged motivation to combine Shenfield and Huang is generic—at an extremely high level of abstraction—and (if credited) would basically allow for combination of any two references that have some relationship to web services, even if the proposed references run crosswise with one another. Notwithstanding that Petitioner improperly uses the claims as a roadmap for its motivations to combine, these generic motivations apply to any reference, such as Shenfield, that allegedly disclose aspects of the claimed Player.

Part one of the Section 325(d) framework is satisfied.

2. Petitioner fails to identify any material error in the Examiner’s or Board’s previous evaluation of the art and arguments.

Petitioner has not satisfied Step 2 of the Section 325(d) framework—“whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, IPR2019-01469, Paper 8 at

10. “If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.” *Advanced Bionics* at 8–9.

Here, Petitioner makes no assertion that the Examiner and the Board erred, and thus cannot make its required showing of material error. Moreover, neither the Examiner nor the Board erred. Both the Examiner and the Board considered *Huang* and art cumulative to *Shenfield* during prosecution and the *Google IPR*, and there is no basis in the record to conclude that the Examiner and Board erred, especially given the fundamental departures of *Huang* (and *Huang* + *Shenfield*) from the challenged claims. Petitioner’s request that the Board revisit the same issues and reach a different conclusion is not a new argument or evidence that warrants reconsideration of the claims over the same or substantially the same art.

The Board should deny institution.

C. The Board should exercise its discretion under Section 314(a) to deny institution because the petition is a serial, follow-on petition that abuses the Board’s post-grant review process.

Petitioner is the third party to collaterally challenge the ’755 patent. Google filed the first petition over six months ago, which the Board already denied. *Google*, IPR2021-00709, Paper 7. The Board has repeatedly cautioned that, as here, “[m]ultiple staggered petitions challenging the same patent and same claims raise the potential for abuse.” *General Plastic Industrial Co., Ltd. v. Canon Kabushiki*

Kaisha, IPR2016-01357, Paper 19 at 17 (P.T.A.B. Sept. 6, 2017). The Board balances the non-exhaustive factors set forth in *General Plastic* when weighing a discretionary denial under these circumstances. Those factors, on the whole, favor denying institution.

1. Factor 1—whether the same or different petitioners filed the earlier petitions against the ’755 patent.

Factor 1—“whether the same petition previously filed a petition directed to the same claims of the same patent”—is not dispositive. *General Plastic*, IPR2016-01357, Paper 19 at 9. The Board routinely exercises its discretion to deny institution of a follow-on petition filed by different petitioners. *See, e.g., United Fire Protection Corp. v. Engineered Corrosion Sol’ns, LLC*, IPR2018-00991, Paper 10 at 11 (P.T.A.B. Nov. 15, 2018) (“Our discretion under 35 U.S.C. § 314(a), however, is not limited to situations where the same party files multiple petitions.”); *Valve Corp. v. Elec. Scripting Prod., Inc.*, IPR2019-00062, Paper 11 at 2 (P.T.A.B. April 2, 2019) (“our application of the *General Plastic* factors is not limited solely to instances when multiple petitions are filed by the same petitions”).

2. Factor 2 strongly favors denial because Petitioner knew of *Huang* and *Shenfield* before filing the petition.

Petitioner admits that it knew of both *Huang* and *Shenfield* “before Google filed its request for IPR on March 31, 2021,” several months before Petitioner filed the instant IPR. Paper 2, Petition at 83–84. That Petitioner “filed only one business

day after the SAP IPR” and challenged some (but not all) different claims than Google challenged is of no moment. *Id.* at 83. Petitioner “knew of the prior art asserted in the second petition” well before it was filed. *General Plastic*, IPR2016-01357, Paper 19 at 9.

Also, Petitioner’s claim that it only learned of these references “shortly before” Google’s petition is specious. As discussed above concerning § 325(d), the Examiner considered *Huang* and many references cumulative to *Shenfield* during prosecution of the ’755 patent. Petitioner knew, or at least should have known, of the ’755 patent, its prosecution history, and the art cited and considered therein, at least because: (1) on May 15, 2017, Express Mobile sued Petitioner’s subsidiary, Magento, for patent infringement and Express Mobile provided Magento agreements relating to the ’755 patent by April 2019; (2) on February 6, 2020, Express Mobile provided Petitioner notice of its infringement of the ’755 patent by letter; and (3) on November 24, 2020, Express Mobile filed the underlying, parallel litigation against Petitioner. Ex. 2015, *Express Mobile, Inc. v. Adobe Inc. d/b/a Adobe Systems Inc.*, No. 3-20-cv-08297, Dkt. 1 ¶ 189 (N.D. Cal.) (November 24, 2020) (Complaint); Ex. 2014, Letter from Devlin, T. to Adobe Inc. (February 6, 2020).

With regard to *Shenfield*, various defendants have referenced *Shenfield* as a possible reference for nearly two years—well over a year before Adobe filed its Petition. Indeed, Shopify listed *Shenfield* on the face of its Initial Invalidity

Contentions. *See* Ex. 2016, *Shopify v. Express Mobile*, No. 19-cv-439-RGA (D. Del.), Shopify Inc. and Shopify (USA) Inc.’s Initial Invalidity Contentions (Nov. 22, 2019), at p. 32 (listing “U.S. Patent Appl. Publ. No. 2006/0200749”). Given the apparent coordination and timing of IPR petitions between various defendants with the Huang primary reference, and the similarity between Shopify and Adobe’s invalidity contentions (which also include both Huang and Shenfield), there can be no doubt that Adobe could have brought forward the Huang and Shenfield obviousness ground many months ago.

This factor strongly favors denial.

3. Factor 3 favors considering the petition on its merits because Petitioner filed its petition two days before Express Mobile filed its preliminary response in the *Google IPR*.

Petitioner filed its petition two days before Express Mobile filed its preliminary response in the *Google IPR*. This factor favors considering the petition on its merits.

4. Factor 4 strongly favors denial because Petitioner waited months after learning of *Huang* and *Shenfield* to file its petition.

Petitioner waited several months, if not much longer, since learning of *Huang* and *Shenfield* “before Google filed its request for IPR on March 31, 2021” to file its Petition. Paper 2, Petition at 83; *see also supra* Factor 2. Again, as noted above, various defendants have presented both Huang and Shenfield as alleged invalidity

references nearly two years ago. This factor strongly favors denial.

5. Factor 5 strongly favors denial because Petitioner does not provide an adequate explanation for its delay.

Petitioner does not provide an adequate explanation for its (at least) months-long delay. Petitioner argues, again, that it waited “only one business day after the SAP IPR,” but this conveniently overlooks the *Google IPR*, filed over 3 months earlier. Paper 2, Petition at 85.

As to the *Google IPR*, the petition is not “directed at largely different claims than Google’s petition.” *Id.* There is substantial overlap between the two petitions or, in Petitioner’s words: “the grounds asserted in Adobe’s Petition has similarities with Google’s IPR.” Paper 2, Petition at 85. Both petitions challenge independent system claim 1 of the ’755 patent, among other claims. *Compare* Paper 2, Petition and *Google IPR*, Paper 1, Petition. Any differences between overlapping and non-overlapping claims does not warrant a serial challenge to the ’755 patent, let alone excuse Petitioner’s delay in bringing its challenge.

This factor strongly favors denial.

6. Factor 6 is neutral because, though the Board’s resources are finite and already-burdened, the Board already considered the same or substantially the same references and arguments when denying the *Google IPR*.

Factor 6 is neutral. The Board’s resources are certainly finite and regularly taxed. But Express Mobile sees no reason why this IPR would unduly burden the

Board, especially since Petitioner raises the same or substantially the same art and arguments as the already-denied *Google IPR*.

7. Factor 7 is neutral because there is no reason to suggest the Board could not issue a Final Written Decision within one year of institution.

Factor 7 is neutral. Express Mobile sees no reason why the Board could not meet the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination within a year of institution.

This factor, however, does not favor considering the petition on its merits, as Petitioner suggests. Paper 2, Petition at 85–86. Petitioner leans on “similarities with Google’s IPR” to argue for institution. Paper 2, Petition at 85–86. This does not support Petitioner’s cause. That the already-denied *Google IPR* and this IPR share “similarities” is why the Board should exercise its discretion under Section 325(d) and deny institution.

8. Additional Factor 8—“the extent to which the petitioner and any prior petitioners were similarly situated defendants or otherwise realized a similar-in-time hazard regarding the challenged patent” (*Shenzen Silver Star*)—strongly favors denial.

The factors set forth in *General Plastic* are “non-exhaustive”; “additional factors may arise in other cases for consideration, where appropriate.” *General Plastic*, IPR2016-01357, Paper 19 at 16, 18. One additional factor the Board has considered is “the extent to which the petitioner and any prior petitioners were

similarly situated defendants or otherwise realized a similar-in-time hazard regarding the challenged patent.” *See Shenzhen Silver Star Intelligent Tech. Co., Ltd. v. iRobot Corp.*, IPR2018-00761, Paper 15 at 18 (P.T.A.B. Sept. 5, 2018) (Saindon, J., concurring). This additional factor is appropriate to consider here, and it strongly favors denial.

Starting in April 2015, Express Mobile began to enforce its patents against various defendants using Express Mobile’s claimed technology. Starting in May 2017, Express Mobile began to enforce two patents against Petitioner’s subsidiary Magento and, in February 2020, expressly notified Petitioner by letter of Petitioner’s infringement of the ’755 patent. Ex. 2014, Letter from Devlin, T. to Adobe Inc. (February 6, 2020).

Fast-forward to present day, Petitioner (along with Google and SAP) is one of twenty similarly-situated defendants in co-pending, parallel litigation concerning the ’755 patent. Paper 2, Petition at 86–89 (“Related Matters”). In the context of Express Mobile’s enforcement campaign, Petitioner (like the other similarly-situated defendants) realized or certainly should have realized a similar-in-time hazard regarding the ’755 patent. There is simply no legitimate reason for Petitioner to have waited months, if not years, to file its petition.

This factor strongly favors denial.

General Plastic and its progeny make clear that permitting unfettered, serial petitions “is unfair to patent owners and is an inefficient use of the *inter partes* review process.” *General Plastic*, IPR2016-01357, Paper 19 at 17 (Sept. 6, 2017). Four *General Plastic* factors (2, 4, 5, and 8) strongly favor denial, two factors (6 and 7) are neutral, and two factors (1 and 3) favor considering the petition on its merits. These factors, taken as a whole, favor denial of this follow-on petition. The Board should deny institution.

V. Conclusion

Petitioner has failed to meet the burden under 37 C.F.R. § 42.108(c) of showing a reasonable likelihood of success that the claims are unpatentable. In its only ground, the petition fails to account for numerous limitations and does not either cure or address the numerous deficiencies that warranted denial of the Petitions at issue in the Google IPR. Moreover, the Board should exercise its discretion to deny institution in light of parallel proceedings. The Board should further deny institution under 35 U.S.C. § 325(d) as the petition raises the same or substantially the same prior art and arguments as prior petitions, including the denied Google Petition. As such, Patent Owner respectfully requests that the Board deny institution of an *inter partes* review.

Date: October 25, 2021

Respectfully submitted,

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CERTIFICATION UNDER 37 C.F.R. §42.24

Under the provisions of 37 C.F.R. §42.24, the undersigned hereby certifies that the foregoing document contains 13,649 words, and thus complies with the word-count limits of 37 C.F.R. § 42.24.

Date: October 25, 2021

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned hereby certifies that a copy of the foregoing PATENT OWNER PRELIMINARY RESPONSE and Exhibits 2003 - 2018 were served on October 25, 2021 by filing this document through the Patent Trial and Appeal Board End to End as well as by delivering a copy via the delivery method indicated to the attorneys of record for the Petitioner as follows:

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