UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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IRONSOURCE LTD.,
Petitioner,

v.

DIGITAL TURBINE INC.,
Patent Owner.

————————————

PGR2021-00096
Patent 10,782,951 B2

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Before KALYAN K. DESHPANDE, MONICA S. ULLAGADDI, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

AHMED, *Administrative Patent Judge*.

DECISION
Granting Institution of Post-Grant Review
*35 U.S.C. § 324*

## I.     INTRODUCTION

IronSource Ltd. ("Petitioner") requested a post-grant review of claims 1–18 (the "challenged claims") of U.S. Patent 10,782,951 B2 (Ex. 1001, "the '951 patent").  Paper 2 ("Petition" or "Pet.").  Digital Turbine Inc. filed a Preliminary Response.  Paper 7 ("Prelim. Resp.").  We authorized additional briefing to address arguments regarding (1) the applicability of 35 U.S.C. § 325(d) to the present proceeding, and (2) claim construction of the term "installation client."  Paper 8; Ex. 3001.  Accordingly, Petitioner filed a Reply (Paper 13, "Prelim. Reply")[1] and Patent Owner filed a Sur-Reply (Paper 10, "Prelim. Sur-Reply").

Under 35 U.S.C. § 324(a), a post-grant review may not be instituted unless it is determined that it is more likely than not that at least one of the challenged claims is unpatentable.  Based on the information presented in the Petition and the supporting evidence, we are persuaded that the Petition presents information demonstrating it is more likely than not that at least one of the challenged claims is unpatentable.  Accordingly, we institute a post-grant review of the challenged claims on the grounds set forth in the Petition.

Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far.  This is not a final decision as to patentability of the challenged claims.  Any final decision will be based on the full trial record, including any response to the Petition timely filed by Patent Owner.

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[1] We ordered Petitioner to file a corrected Preliminary Reply because Petitioner's initial filing (Paper 9) failed to comply with the requirements of 37 C.F.R. § 42.6.  Paper 12.

## II. BACKGROUND

### A. Real Parties in Interest

Petitioner identifies itself as the real party-in-interest. Pet. 1. Patent Owner identifies itself as the real party-in-interest. Paper 6, 1.

### B. Related Matters

The parties identify U.S. Patent Application Serial No. 16/992,194 ("the '194 application," now issued as U.S. Patent 11,157,256 B2) that claims the benefit of the '951 patent. Pet. 1; Paper 6, 1.

### C. The '951 Patent (Ex. 1001)

The '951 patent, titled "Instant Installation of Apps," was filed on February 23, 2018, as Application No. 15/903,054 ("the '054 application"). Ex. 1001, codes (21), (22), (54). The patent describes an installation client for installing new software applications ("apps") on a device, without redirecting the device to an app store. *Id.* at 1:45–47. The installation client enables users to download new apps in the background while maintaining interaction with their currently-used application. *Id.* at 1:66–2:5.

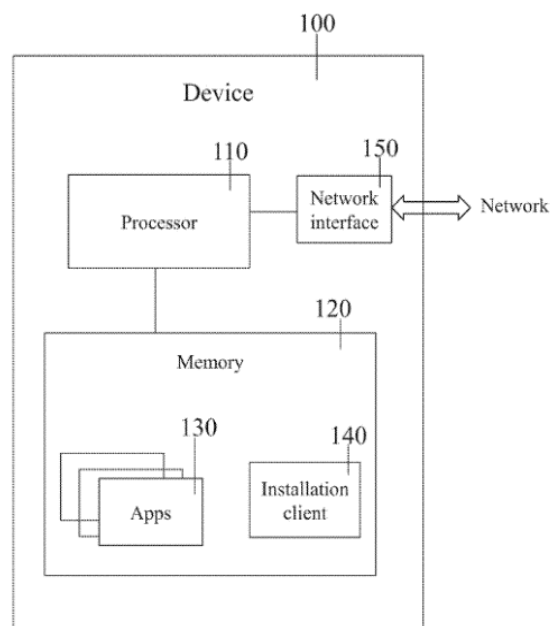Figure 1 of the '951 patent is reproduced below.

Figure 1, above, shows a block diagram of device 100 for running software applications, which includes processor 110 connected to non-transitory memory 120 which stores apps 130 and installation client 140.  *Id.* at 9:15–17, 29–47.  Device 100 may be a mobile device.  *Id.* at 9:34–35.

The '951 patent describes the following example of a user using an app running on device 100:

> The current app displays an "instant install" link (e.g. an ad containing a clickable link) for a different app (denoted herein the new app).  When the user selects the "instant install" link in order to download the new app, installation client 140 is invoked to run in the background.  The current app is not exited.  The user may continue to use the current app without being aware that installation client 140 is now active in the background. Installation client 140 automatically downloads an installation file for the new app . . . .  The installation file is used to install the new app on the device.

*Id.* at 9:36–47.

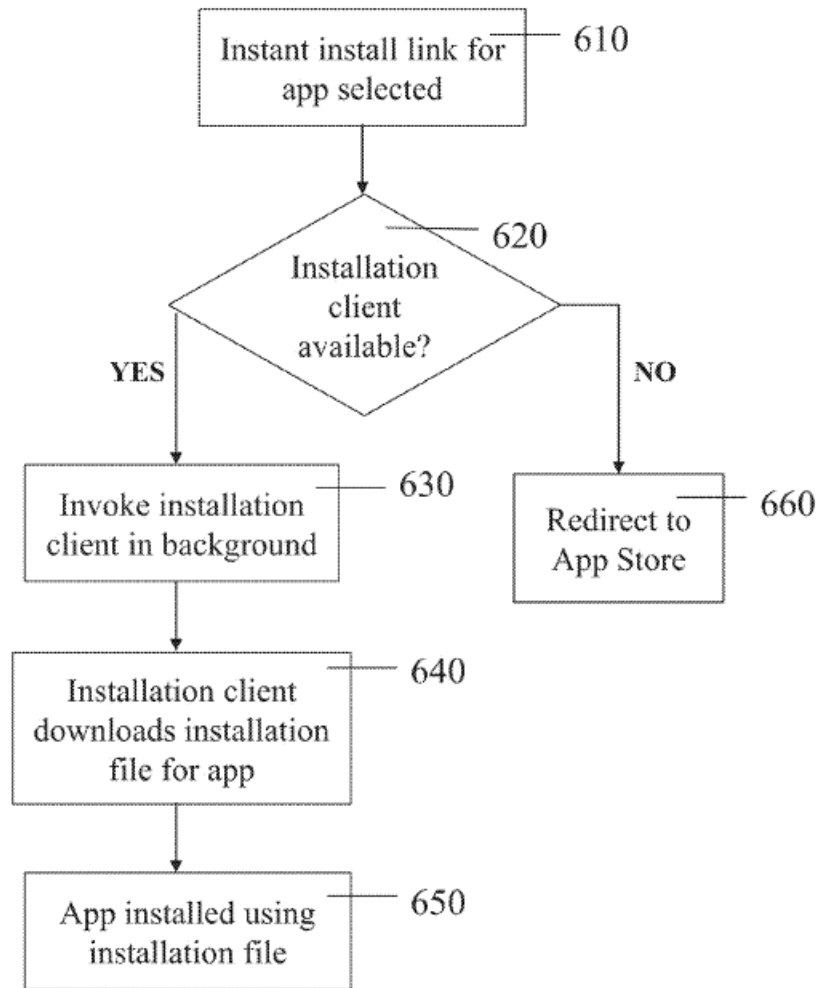Figure 6 of the '951 patent is reproduced below.



Figure 6, above, shows a flowchart illustrating a method for installing software applications on a device, beginning with selecting an install link for an app (step 610), followed by determining whether an installation client is available (step 620). *Id.* at 13:48–56. If "YES," the installation client is invoked in the background (step 630), and proceeds to download the installation file for the app (step 640) and install the app using the installation file (step 650). *Id.* at 13:57–62. If "NO," the device is redirected to an app store (step 660). *Id.* at 13:63–64.

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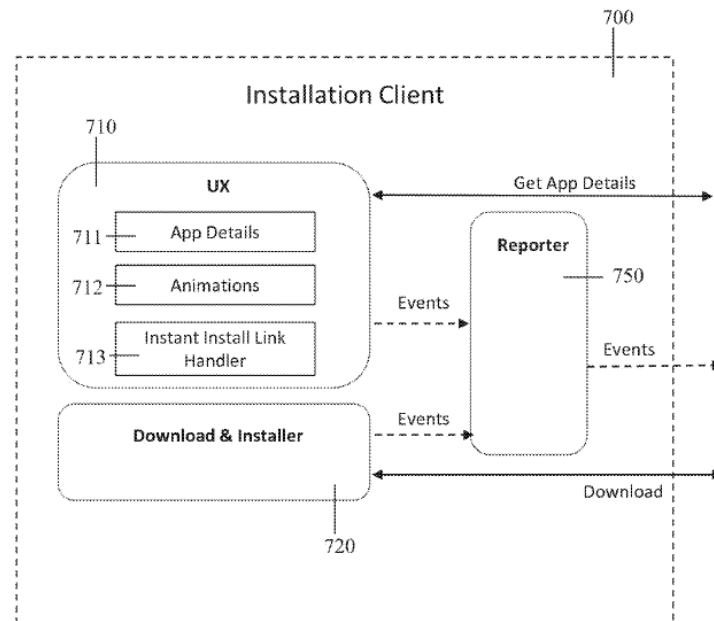Figure 7 of the '951 patent is reproduced below.



Figure 7, above, shows a schematic diagram of installation client 700, including several modules. *Id.* at 14:4–8. User Experience (UX) module UX 710 handles interaction with the user, and supports functionality such as providing app details, handling animations for display, and handling operations when an install link is selected. *Id.* at 14:12–25. Download and Installer 720 downloads and installs the new app when the install link is selected. *Id.* at 14:32–36. Reporter 750 monitors events occurring in the installation client, such as clicks on links, user confirmation to install app, successful download, successful install and other status/failure related events. *Id.* at 14:36–45.

D.    *Challenged Claims*

Petitioner challenges claims 1–18, of which claims 1, 12, and 17 are independent claims. Claim 1 is reproduced below.

1. [pre1] A mobile device configured for running software applications, comprising:

[a] a network interface configured for communicating over a network;

[b] at least one non-transitory computer readable storage medium storing instructions; and

[c] at least one processor associated with said network interface and said storage medium, configured for executing said instructions to:

[d] identify that a link for installation of a first software application is selected by user interaction with a second software application running on said device, the link being embedded in content displayed on said device by the second software application;

[e] in response to said identifying, determine whether an installation client for downloading and installing applications on said device is available on said device, said installation client comprising a third software application;

[f] when said installation client is available on said device:

[f1] invoke, without exiting said second software application, said installation client for downloading and installing applications on said device to run in the background on said device;

[f2] instruct said installation client to automatically download an installation file of said first software application to said device over said network using said network interface in the background on said device, without directing said user interaction to an app store; and

[f3] using said downloaded installation file, install said first software application on said device in the background on said device while maintaining a user experience of interaction with said second software application in the foreground; and

[g] when said installation client is unavailable on said device, redirect said device to an app store for downloading and installing said first software application on said device.

Ex. 1001, 20:64–21:35 (annotations from Pet. 9–10).

E.     *The Asserted Grounds*

Petitioner asserts that claims 1–18 would have been unpatentable on the following grounds, relying on the declaration testimony of Kevin C. Almeroth, Ph.D. (Ex. 1008).  *See* Pet. 4, 26–89.

| Claim(s) Challenged | 35 U.S.C. § | Reference(s)/Basis |
|---|---|---|
| 1–18 | 101 | Eligibility |
| 1, 3–12, 14–18 | 102(a) | Pasha[2] |
| 2, 4–6, 11, 13, 14, 16, 18 | 103 | Pasha[3] |
| 2, 13 | 103 | Pasha, Yamada[4] |
| 6, 14 | 103 | Pasha, Molinet[5] |

## III.    ANALYSIS

A.     *Eligibility for Post-Grant Review*

Post-grant review is available only for patents that, at one point, contained at least one claim with an effective filing date, as defined by 35 U.S.C. § 100(i), on or after March 16, 2013.  Also, the request for post-grant review must be filed *no later than* nine months after the patent is granted.  35 U.S.C. § 321(c).  Petitioner asserts that the '951 patent is available for post grant review.  Pet. 3.  We agree.  The filing date for the '951 patent is February 23, 2018, and the patent issued on

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[2] U.S. Patent 10,353,686 B1, issued July 16, 2019 (Ex. 1003, "Pasha").
[3] Although the Petition omits claims 11, 16, and 18 from its listing of challenged claims under Ground 3 (Pet. 4), the Petition challenges these claims as obvious in view of Pasha.  *Id.* at 74, 81–82.
[4] U.S. Patent Application No. 2010/0095294 A1, published April 15, 2010 (Ex. 1004, "Yamada").
[5] U.S. Patent Application No. 2016/0142859 A1, published May 19, 2016 (Ex. 1005, "Molinet").

September 22, 2020, exactly nine months before the filing date of the petition, June 22, 2021. Ex. 1001, codes (22), (45); Paper 4, 1.

### B. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art "would be qualified to perform work as described in the '951 patent through a combination of formal education in computer programming, computer science or similar discipline and/or work experience, such as two or more years of computer programming experience." Pet. 13 (citing Ex. 1008 ¶ 39). Petitioner further contends that formal education "in this field may range widely from certificate programs specifically directed to creating apps for mobile devices to advanced degrees up to and including a Ph.D. degree in computer science or a related field, such as computer engineering." *Id.* Patent Owner does not propose any particular skill level in its Preliminary Response. *See generally* Prelim. Resp.

We determine, on the current record, that the level of ordinary skill proposed by Petitioner is consistent with the '951 patent and the asserted prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978). We adopt that level in deciding whether to institute trial. We will make a final determination as to the level of ordinary skill in the art, however, based on the full trial record.

### C. Claim Construction

In this post-grant review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.200(b) (2020). The claim construction standard includes construing claims in accordance with the ordinary and customary meaning of such claims as understood by one of

ordinary skill in the art at the time of the invention. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc). In construing claims in accordance with their ordinary and customary meaning, we take into account the specification and prosecution history. *Phillips*, 415 F.3d at 1315–17. Additionally, only terms that are in controversy need to be construed, and these need be construed only to the extent necessary to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (holding that "only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy"); *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs.* in the context of an *inter partes* review).

Petitioner proposes that the claim terms "link and "deep link" are well understood terms in the art, and also contends that the '951 patent provides express definitions for some of the claim terms. Pet. 21–24. In response, Patent Owner "accepts Petitioner's claim constructions at face value for purposes of the Patent Owner's Preliminary Response," but "reserves the right to subsequently challenge Petitioner's constructions should trial be instituted." Prelim. Resp. 9. For the purposes of this Decision, we need only address the parties' dispute as to the proper construction of the term "installation client." *See* Prelim. Reply, 5–6.

For "installation client," Petitioner contends that the patentee acted as his own lexicographer and expressly defined the term as follows:

> [T]he term "installation client" means an application running on the device and having the role of downloading and installing software applications on the device (e.g. installing an app on a mobile phone). The installation client may be a standalone client or a component of another client having additional

functionalities. The installation client runs in the background for
at least part of the time that it is active.

Pet. 22–23 (quoting Ex. 1001, 2:64–3:4). Patent Owner does not dispute
that the specification provides a definition for the term, but instead argues
that Pasha's disclosure of "an App Manager component for downloading an
application package and a *separate* Installer component for installing the
application package" does not meet that definition. Prelim. Resp. 25–27
(citing Ex. 1003, 8:65–67, 9:20–25; Ex. 1008 ¶ 120). According to Patent
Owner, "Figure 7 of '951 patent illustrates the Downloader & Installer
Module which 'downloads and installs the new app when the instant install
link is selected.'" *Id.* at 26–27 (citing Ex. 1001, 14:26–27, Fig. 7).

Petitioner responds that Patent Owner's position "requires further
limiting the 'installation client' to only a single component or functional
block of software and is contrary to the proper and undisputed construction."
Prelim. Reply, 6 (citing Ex. 1001, 14:5–12).

For the purposes of this Decision, we agree with Petitioner. Figure 7
of the '951 patent shows the Downloader & Installer Module as a module
*within* the "installation client," not as the installation client *itself*. Ex. 1001,
14:4–45 (discussing "installation client 700" and its various modules); Fig. 7
(showing Download & Installer 720 as part of Installation Client 700). The
'951 patent states:

> Installation client 700 is represented as several modules
> performing separate functions. The division of functionality
> demonstrated in FIG. 7 is illustrative, and not intended to be
> limiting. Other embodiments of an installation client may
> organize the various functions performed by the installation
> client 700 in a different manner.

*Id.* at 14:6–12. Accordingly, the proper construction of the term
"installation client" does not limit the number or arrangement of components

required to meet the claim element, and more specifically, does not limit installation client to only a single component or functional block.

We determine that we do not need to expressly construe any other terms in order to determine whether to institute. The parties are reminded that our construction is preliminary and that our ultimate interpretation of the claim terms will be based on the complete record developed during trial.

### D. Subject Matter Eligibility under 35 U.S.C. § 101

Petitioner asserts that the challenged claims are unpatentable under 35 U.S.C. § 101 because they are directed to ineligible subject matter. Pet. 26–52. For the reasons that follow, we are not persuaded that Petitioner establishes it is more likely than not to prevail with respect to this ground at this stage of the proceeding.

### 1. Principles of Law

35 U.S.C. § 101 defines patentable subject matter, but the Supreme Court has "long held that this provision contains an important implicit exception" that "[l]aws of nature, natural phenomena, and abstract ideas are not patentable." *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012) (quotation omitted). "Eligibility under 35 U.S.C. § 101 is a question of law, based on underlying facts." *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1166 (Fed. Cir. 2018). To determine patentable subject matter, the Supreme Court has set forth a two-part test.

"First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts" of "laws of nature, natural phenomena, and abstract ideas." *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 217 (2014). A court must be cognizant that "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract

ideas" (*Mayo*, 566 U.S. at 71), and "describing the claims at . . . a high level
of abstraction and untethered from the language of the claims all but ensures
that the exceptions to § 101 swallow the rule." *Enfish, LLC v. Microsoft
Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016). Instead, "we evaluate the
focus of the claimed advance over the prior art to determine if the character
of the claim as a whole, considered in light of the specification, is directed to
excluded subject matter." *Trading Techs. Int'l, Inc. v. IBG LLC*, 921 F.3d
1084, 1092 (Fed. Cir. 2019) (quotation omitted). "The inquiry often is
whether the claims are directed to 'a specific means or method' for
improving technology or whether they are simply directed to an abstract
end-result." *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1326 (Fed.
Cir. 2017).

If the claims are directed to an abstract idea or other ineligible
concept, then we continue to the second step and "consider the elements of
each claim both individually and 'as an ordered combination' to determine
whether the additional elements 'transform the nature of the claim' into a
patent-eligible application." *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S.
at 79, 78). The Supreme Court has "described step two of this analysis as a
search for an 'inventive concept'—*i.e.,* an element or combination of
elements that is sufficient to ensure that the patent in practice amounts to
significantly more than a patent upon the ineligible concept itself." *Id.* at
217–18 (quotation omitted). However, "[t]he abstract idea itself cannot
supply the inventive concept, no matter how groundbreaking the advance."
*Trading Techs.*, 921 F.3d at 1093 (internal quotation omitted).

In January 2019, the U.S. Patent and Trademark Office (USPTO) published revised guidance on the application of § 101.[6]  Patent Examining Procedure ("MPEP") now incorporates this revised guidance and subsequent updates at § 2106 (9th ed. Rev. 10.2019, rev. June 2020).[7]

Under MPEP § 2106, we first look to whether the claim recites:

(1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes) ("Step 2A, Prong One"); and

(2) additional elements that integrate the judicial exception into a practical application ("Step 2A, Prong Two").[8]

MPEP § 2106.04(a), (d).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look, under Step 2B, to whether the claim:

(3) adds a specific limitation beyond the judicial exception that is not "well-understood, routine, conventional activity" in the field; or

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[6] 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) ("Guidance").  In response to received public comments, the Office issued further guidance on October 17, 2019, clarifying the 2019 Revised Guidance.  USPTO, *October 2019 Update: Subject Matter Eligibility* (the "October 2019 Update").  "All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance." 84 Fed. Reg. at 51; *see also* October 2019 Update at 1.
[7] All references to the MPEP are to the Ninth Edition, Revision 10.2019 (Last Revised June 2020), unless otherwise indicated.
[8] "Examiners evaluate integration into a practical application by: (1) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (2) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application."  MPEP § 2106.04(d)(II).

(4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

MPEP § 2106.05(d); *See* Guidance, 84 Fed. Reg. at 52, 55, 56.

We evaluate the parties' arguments under the Office's Guidance. Our reviewing court has warned that "the Office Guidance is not, itself, the law of patent eligibility" and "does not carry the force of law." *In re Rudy*, 956 F.3d 1379, 1382 (Fed. Cir. 2020); *see also cxLoyalty, Inc. v. Maritz Holdings Inc.*, No. 2021-1307, 2021 WL 416719, *6 n.1 (Fed. Cir. Feb. 8, 2021); *Cleveland Clinic Found. v. True Health Diagnostics LLC*, 760 F. App'x 1013, 1020 (Fed. Cir. 2019). Rather, "it is our [reviewing court's] case law, and the Supreme Court precedent it is based upon, that must control." *Rudy*, 956 F.3d at 1383 (citation omitted). Thus, although our analysis here is framed in terms of the Guidance, our decision is based upon governing precedent of the United States Supreme Court and our reviewing court's interpretation and application thereof.

>        2.    *Analysis*

*Alice* Step One asks whether the claims are directed to a judicial exception, such as an abstract idea. *See Alice*, 573 U.S. at 217. The USPTO Guidance frames this question as a two prong inquiry under Step 2A: Prong 1, whether the claims recite any of the groupings of abstract ideas listed in the Guidance, and if so, Prong 2, whether the abstract idea is integrated into a practical application. *See* Guidance, 84 Fed. Reg. at 54–55.

Petitioner contends that the claims recite the abstract idea of "improving a user experience by downloading and installing software as a background task." Pet. 27. Petitioner further contends that "the essence of all of the claims of the '951 patent is revealed in the express claim language

in element [f3]: '*install said first software application on said device in the background on said device while maintaining a user experience of interaction with said second software application in the foreground.*'" *Id.* at 28–29. Petitioner argues that the objective of the '951 patent is to improve advertising performance by reducing interruption to a user and thus improving conversion rates. *Id.* at 29 (citing Ex. 1001, 1:67–2:2). Petitioner contends that "the purported improvement of the '951 patent is the user experience, and not the underlying technology that facilitates such a user experience." *Id.* Petitioner also argues that the claimed "abstract idea is not only a fundamental computer operation, but is an example of multitasking, which represents a basic task in organizing human activity." *Id.* at 30.

Patent Owner responds that, under Prong 1 of the Guidance, Petitioner's proposed abstract idea overgeneralizes the claims and omits the limitations that led to allowance. Prelim. Resp. 11–15. Patent Owner argues that the '951 patent claims "specifically recite an installation method that includes the technical solution of identifying a link, determining whether an installation client is available on the device, invoking the installation client – for downloading and installing the applications in the background – when it is available." *Id.* at 13. Patent Owner argues that the claims do not recite the desired result, namely improving the user experience, but a specific solution for accomplishing the desired benefit. *Id.* at 13–14 (citing *Koninklijke KPN N.V. v. Gemalto M2M GMBH*, 942 F.3d 1143, 1151 (Fed. Cir. 2019). Patent Owner further argues that Petitioner ignores the limitations found by the examiner to distinguish the prior art, including "invoking the installation client" and downloading the app "in the background on said device, without directing said user interaction to an app store." *Id.* at 15–16 (citing Ex. 1002, 173, 210).

On the current record, Patent Owner's argument has merit. Petitioner's analysis of the independent claims described above only loosely corresponds to the actual limitations recited in the claim. The Federal Circuit has "cautioned that courts 'must be careful to avoid oversimplifying the claims' by looking at them generally and failing to account for the specific requirements of the claims." *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299, 1313 (Fed. Cir. 2016) (quoting *In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016)). But "failing to account for the specific requirements of the claims" is what Petitioner's analysis of the claim limitations appears to do. Petitioner's argument that "the essence of all the claims" is captured by a single claim element not only ignores that that limitation recites installing software, which we are not persuaded is an abstract idea, but also asks us to disregard multiple technical aspects recited in the claims, such as identifying a link, determining whether an installation client is available on the device, invoking the installation client, and redirecting to the device an app store. *See, e.g.*, Ex. 1001, 21:6–35.

Nor are we persuaded by Petitioner's characterization of the claims as directed to *multitasking*, which Petitioner characterizes as representing a basic task in *organizing human activity*. Pet. 30. Although the Guidance recognizes certain methods of organizing human activity, including certain activity between a person and a computer, as constituting a patent-ineligible abstract idea, we are not persuaded that the claims here fall within the scope of such activity. *See* 84 Fed. Reg. at 52 (listing fundamental economic principles or practices, commercial or legal interactions, and managing personal behavior or relationships as *organizing human activity*); October 2019 Update at 5 ("this grouping is limited to activity that falls within the

enumerated sub-groupings . . . , and is not to be expanded beyond these enumerated sub-groupings except in rare circumstances"). Although the claimed invention may result in multitasking on the device, the claims are directed to downloading and installing an application in the background instead of directing the user to an app store, thereby maintaining user experience with the foreground application, and do not recite an abstract idea. And although that process does result in improving user experience, the claims recite more than that mere result; they recite specific steps— invoking, without exiting the foreground software application, the installation client for downloading and installing applications on the device to run in the background—that accomplish the desired result. *See Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1305–06 (Fed. Cir. 2018) (finding a method that employs a new kind of file in a computer security system directed to a non-abstract improvement in computer functionality, rather than the abstract idea of computer security writ large); *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014) (finding claims that address the problem of retaining website visitors after clicking on an advertisement hyperlink not directed to an abstract idea).

Accordingly, based on the current record, we question whether Petitioner establishes sufficiently that the claims are directed to a judicial exception under Step 2A of the Guidance. Nevertheless, because Petitioner has shown that it is more likely than not that challenged claims are unpatentable under 35 U.S.C. §§ 102, 103 (*see infra* §§ III.F–I), we include this ground in the instituted post-grant review. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1354, 1359–60 (2018); *see also PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (interpreting the statute to

require "a simple yes-or-no institution choice respecting a petition,
embracing all challenges included in the petition").

        E.     *Overview of the Asserted Art for Anticipation and Obviousness*

        1.     *Pasha (Ex. 1003)*

Pasha discloses a method for installing applications on computing devices, including mobile devices. Ex. 1003, 1:5–6, 36–38. Specifically, Pasha discloses a "direct application install feature" that allows a user to download and install a downloadable application, while interacting with a host application. *Id.* at 1:42–50. The downloadable application may be downloaded directly without requiring the user to interact with an app store. *Id.* at 1:50–54.

Figure 1 of Pasha is reproduced below.
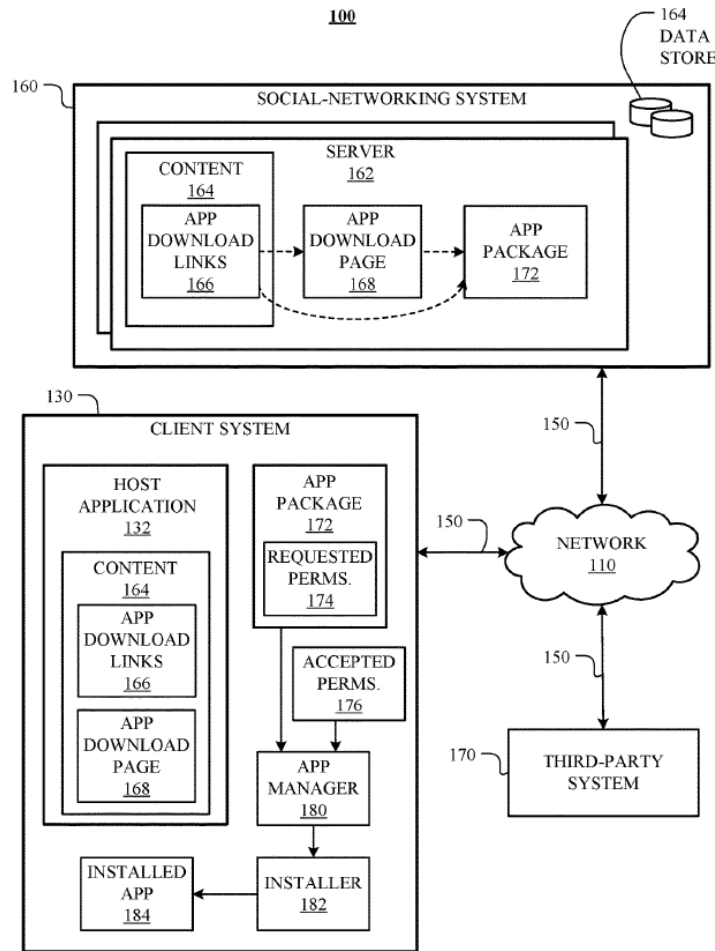


*FIG. 1*

Figure 1, above, shows computer network environment 100, including client system 130, social-networking system 160, and third-party system 170, all connected by network 110. *Id.* at 2:31–35. Client system 130 includes host application 132 which includes app download links 166. *Id.* at 8:6–31. Client system 130 also includes App Manager 180 and Installer 182. *Id.* at 8:59–9:38.

Pasha explains that App Manager 180 may control portions of the application download and install process. *Id.* at 17:21–24. Specifically, Pasha discloses that "App Manager 180 may perform at least a portion of one or more of the steps 310–350 of FIG. 3, and the Installer may perform at

least the portion of step 350 that involves requesting the operating system of the client device 130 to install the application package on the client device 130." *Id.* at 17:35–39.

Figure 3 of Pasha is reproduced below.

**300**

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        ┌─────────────────────────────────────────────────┐
        │ Presenting, in a user interface of a host       │
        │ application, content that includes a download    │
310 ─── │ link referencing a downloadable application,     │
        │ wherein the user interface of the host           │
        │ application performs operations unrelated to     │
        │ downloading applications                         │
        └─────────────────────────────────────────────────┘
                             │
                             ▼
        ┌─────────────────────────────────────────────────┐
320 ─── │ Receiving, in the host application, selection    │
        │ of the download link                             │
        └─────────────────────────────────────────────────┘
                             │
                             ▼
        ┌─────────────────────────────────────────────────┐
330 ─── │ Sending, to a server computer system, a request │
        │ to download the downloadable application         │
        └─────────────────────────────────────────────────┘
                             │
                             ▼
        ┌─────────────────────────────────────────────────┐
340 ─── │ Receiving an application package that            │
        │ corresponds to the downloadable application      │
        └─────────────────────────────────────────────────┘
                             │
                             ▼
        ┌─────────────────────────────────────────────────┐
        │ Installing the downloadable application on the   │
350 ─── │ computer system from the application package by  │
        │ executing program code having permission to      │
        │ install applications                             │
        └─────────────────────────────────────────────────┘
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*FIG. 3*

Figure 3, above, shows method 300 for downloading and installing applications. *Id.* at 16:28–60. The method begins when a user interface presents a download link for an application in a host application (step 310). *Id.* Next, the host application receives selection of the download link (step 320) and sends a request to download the application to a server computer system (step 330). *Id.* at 18:59–19:5, 19:51–61. The downloadable application is then received as an application package in step 340, and the application package is installed (step 350). *Id.* at 19:54–65. During installation, the user may continue to use host application 132 while application package 172 is downloaded and installed. *Id.* at 19:65–20:4.

Pasha discloses checking for App Manager 180 and Installer 182 when a download is requested. *Id.* at 18:50–54. If the App Manager and Installer are not present, "the ordinary app store for the operating system may be used as a fallback." *Id.* at 18:55–58.

Pasha discloses that client system 130 may be an electronic device, including hardware, software, or a combination of components capable of carrying out the described method. *Id.* at 3:20–25. The client system may be a computer system connected to a network. *Id.* at 3:25–30. More specifically, Pasha discloses computer system 600, which be a mobile telephone, with software to perform the disclosed method. *Id.* at 23:29–46.

### 2. Yamada (Ex. 1004)

Yamada teaches master installer software that sequentially runs a plurality of software installers allowing a user to perform all of the installation operations as if installing one piece of software. Ex. 1004 ¶ 14. Yamada teaches closing the installation software when the installation operation commands are completed. *Id.* ¶ 66.

### 3. Molinet (Ex. 1005)

Molinet discloses contextual deep linking of mobile applications. Ex. 1005 ¶ 3. Molinet discloses that the development of app stores on smartphones has created a system where users can easily install new applications and add functions to their devices. *Id.* ¶ 5. Molinet describes a method for improving the cohesiveness between applications using contextual deep linking. *Id.* ¶¶ 5, 16. Molinet describes a contextual deep link as indicating a particular configuration for an application, for example a reference to a location in an application. *Id.* ¶ 25. Other configurations may include particular settings, parameters, variables, and other options for the application. *Id.*

### F.    Anticipation over Pasha

Petitioner contends that claims 1, 3–12, and 14–18 are unpatentable under 35 U.S.C. § 102(a) as anticipated by Pasha. Pet. 52–74. For the reasons that follow, we are persuaded that the evidence, including Dr. Almeroth's testimony, sufficiently supports Petitioner's arguments and therefore establishes it is more likely than not to prevail with respect to this ground at this stage of the proceeding.

### 1.    Independent Claim 1

#### a)   Preamble

Claim 1 recites "[a] mobile device configured for running software applications, comprising." Ex. 1001, 20:64–65. Petitioner argues that Pasha discloses computer system 600, which may include a mobile device, for running software applications. Pet. 52–53 (citing Ex. 1003, 1:36–38; 23:14–56).

Patent Owner does not specifically respond to this argument. *See generally* Prelim. Resp. Based on our review of the current record, we determine that the information presented sufficiently supports, for purposes of institution, Petitioner's assertion that Pasha discloses the preamble of claim 1.[9]

#### b)   Limitations 1[a]–1[c]

Limitations 1[a]–[c] recite structural features of the claimed device. Specifically, limitation 1[a] recites "a network interface configured for communicating over a network." Ex. 1001, 20:66–67. Limitation 1[b] recites "at least one non-transitory computer readable storage medium

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[9] At this stage of the proceeding, we do not decide whether the preamble of claim 1 is limiting.

storing instructions." *Id.* at 21:1–2. Limitation 1[c] recites "at least one processor associated with said network interface and said storage medium, configured for executing said instructions to." *Id.* at 21:3–5. Petitioner contends that Pasha discloses computer system 600 which includes processor 602 for executing instructions, memory 604 for storing instructions executed by processor 602, and communication interface 610. Pet. 53–56 (citing Ex. 1003, 23:57–24:65, 29:31–30:36, Fig. 6). Petitioner further contends that Pasha's communication interface 610 includes an interface for communicating over a network. *Id.* at 53–54 (citing Ex. 1003, 25:50–26:15).

Patent Owner does not specifically respond to these contentions. *See generally* Prelim. Resp. Based on our review of the current record, we determine that the information presented supports sufficiently, for purposes of institution, Petitioner's assertion that Pasha discloses these limitations.

c) *Limitation 1[d]*

Limitation 1[d] recites "identify[ing] that a link for installation of a first software application is selected by user interaction with a second software application running on said device, the link being embedded in content displayed on said device by the second software application." Ex. 1001, 21:6–10. Petitioner contends that Pasha describes a mobile device (client device 130) executing previously-installed host application 132. Pet. 56 (citing Ex. 1003, 7:61–66). Petitioner further contends that Pasha discloses the user interface of host application 132 (second application) presents content to the user that includes a download link 166 referencing a downloadable application (first software application). *Id.* (citing Ex. 1003, 16:31–34, 1:50–54). Petitioner argues that "download link 166 presented in the content of host application 132 for download of another application

discloses the claimed 'link for installation of a first software application' which is 'embedded in content displayed on said device by the second application.'" *Id.* at 56–57 (citing Ex. 1003, 6:67–7:8, 16:61–17:3). According to Petitioner, Pasha discloses that user selection of the link can occur through "the touch or click on a hyperlink that has the text 'Download Now'" displayed in the host application while the user is interacting with the host application. *Id.* at 57 (citing Ex. 1003, 18:59–19:9, 8:44–58, 21:53–57).

Patent Owner does not specifically respond to these contentions. *See generally* Prelim. Resp. Based on our review of the current record, we determine that the information presented supports sufficiently, for purposes of institution, Petitioner's assertion that Pasha discloses these limitations.

### d) Limitation 1[e]

Limitation 1[e] recites "in response to said identifying, determine whether an installation client for downloading and installing applications on said device is available on said device, said installation client comprising a third software application." Ex. 1001, 21:11–15. Petitioner argues that "Pasha discloses that the host application 132 may use an App Manager 180 and Installer 182 'to perform the installation and download operations' associated with downloading the application from the host application user interface." Pet. 58 (citing Ex. 17:21–34). Thus, Petitioner argues that App Manager 180 and Installer 182 disclose the claimed "installation client for downloading and installing applications on said device." *Id.* Petitioner further argues that Pasha discloses that when "a download is requested," checking to determine whether App Manager 180 and Installer 182 are "present and accessible on the client device," and thus discloses determining whether an installation client is available. *Id.* at 58–59 (citing Ex. 1003, 8:53–67, 18:50–54).

Patent Owner argues that Pasha does not disclose the claimed "installation client." *See* Prelim. Resp. 25–32. Patent Owner contends that "the installation client is an application having the role of (1) downloading *and* (2) installing software applications on the device." *Id.* at 26 (citing Pet. 22–23; Ex. 1008 ¶ 55). Patent Owner argues that "Pasha discloses an App Manager component for downloading an application package and a *separate* Installer component for installing the application package." *Id.* at 27 (citing Ex. 1003, 8:65–67, 9:20–25). Specifically, Patent Owner argues that Pasha's App Manager and Installer perform different functions, and Pasha does not consider the two components interchangeable. *Id.* at 28–29 (citing Ex. 1003, 17:24–27, 17:30–34, 18:4–6, 18:36–37, 19:62–65, Fig. 1). Patent Owner further faults Petitioner for taking inconsistent positions, referring to Pasha's App Manager as well as the combination of the App Manager and Installer as the claimed installation client. *Id.* at 29–32 (citing Pet. 38, 58–61, 63; Ex. 1008, ¶ 73). Patent Owner argues that Petitioner's position would require that Pasha "be modified to meet the claimed invention [and] is a de facto admission that the independent claims are not anticipated." Prelim. Sur-reply 6 (citing *Net MoneyIN, Inc. v. VeriSign, Inc.,* 545 F.3d 1359, 1371 (Fed. Cir. 2008)).

As discussed above (*supra* Section II.C.1), at this preliminary stage, we do not construe "installation client" so narrowly as to limit the number or arrangement of components required to meet that claim element. Also, as discussed above (*id*.), the specification of the '951 patent supports that multiple modules performing separate functions may comprise the installation client. Therefore, based on our review and consideration of the current record, we are not persuaded by Patent Owner's argument that Pasha fails to disclose the claimed installation client.

At this stage of the proceeding, we are also not persuaded that Petitioner's arguments are inconsistent across the Petition. The Petition clearly alleges that "the App Manager 180 and Installer 182 disclose the claimed 'installation client for downloading and installing applications on said device.'" Pet. 58. Petitioner's description of Pasha's App Manager is consistent with Pasha's disclosure itself. For example, although Pasha discloses that "the host application 132 may use an App Manager component 180 and an Installer component 182," it also states that "[t]he App Manager 180 may control portions of the application download and install process." Ex. 1003, 17:22–26; Pet. 38. Pasha further discloses that "[t]he App Manager 180 [*itself*] may perform at least a portion of one or more of the steps 310–350 of FIG. 3," i.e., including the step of "[i]nstalling the downloadable application on the computer system from the application package by executing program code having permission to install applications." Ex. 1003, 17:35–36, Fig. 3. Patent Owner's argument that Pasha's "App Manager does not have the role of installing software applications," is therefore contrary to Pasha's disclosure. Also, Petitioner's reasoning and evidentiary underpinnings here are based not so much on modifying Pasha, as Patent Owner suggests, as explaining *how* one of ordinary skill in the art would have understood Pasha's disclosure. Between its App Manager and Installer, Pasha discloses the claimed functionality of the "installation client," but, similar to the '951 patent, Pasha teaches flexibility between the use of those components to implement the claimed functionality. For the purposes of institution, we are unpersuaded that Petitioner fails to meet its threshold burden of showing anticipation under *Net MoneyIN*. *See, e.g., Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1344 (Fed. Cir. 2016) (explaining that a reference need not always

include an express discussion of the actual combination to anticipate so long as it teaches that the disclosed components or functionalities may be combined and one of skill in the art would be able to implement the combination).

Based on our review of the current record, we therefore determine that the information presented supports sufficiently, for the purpose of institution, Petitioner's assertion that Pasha discloses this limitation.

### e) Limitation 1[f]

Limitation 1[f] recites "when said installation client is available on said device." Ex. 1001, 21:16. Petitioner argues that "element [f] is a transitional statement regarding the availability of the installation client that, when true, proceeds to elements [f1]–[f3]." Pet. 59. Petitioner argues that Pasha discloses that, when available, App Manager 180 and Installer 182 may be executed on the client device. *Id.* (citing Ex. 1003, 18:36–58, 22:24–25; Ex. 1008 ¶ 75).

Patent Owner does not specifically respond to these contentions. *See generally* Prelim. Resp. Based on our review of the current record, we determine that the information presented supports sufficiently, for purposes of institution, Petitioner's assertion that Pasha discloses this limitation.

### f) Limitation 1[f1]

Limitation 1[f1] recites "invoke, without exiting said second software application, said installation client for downloading and installing applications on said device to run in the background on said device." Ex. 1001, 21:17–20. Petitioner argues that Pasha discloses that when the App Manager 180 and the Installer 182 are available, the user may continue to use the host application 132 in the foreground while downloading and installing application package 172 in the background. Pet. 59–60 (citing

Ex. 1003, 19:62–20:9). Petitioner argues that "Pasha discloses that the claimed 'installation client' (the App Manager 180 and the Installer 182) is invoked to 'run in the background' during the downloading and installing of the application package 132." *Id*. at 60 (citing Ex. 1003, 19:67–20:4).

Patent Owner argues that Pasha does not disclose invoking the installation client because "Pasha does not say that either the App Manager or Installer is invoked (i.e., called or activated); it merely says '[t]he user may continue to use the host application 132 while the application package 172 is being downloaded and installed.'" Prelim. Resp. 34 (citing Ex. 1003, 19:67–20:4). Patent Owner asserts that during prosecution, it distinguished the cited prior art, Cayre,[10] by emphasizing that "invoke" requires that "the [claimed] installation client is invoked in response to the user selecting a link," which Patent Owner contends resulted in allowance of the claims. *Id.* at 35 (citing Ex. 1002, 146; Prelim. Resp. § II.B); *see also id.* at 8 (citing Ex. 1002, 146, 210). Pasha, Patent Owner argues, like Cayre, does not invoke an installation client in response to a user selecting a link because App Manager 180 is running before selecting the download link. *Id.* at 35–36 (citing Ex. 1003, 16:28–29, Fig. 3).

Petitioner responds that in contrast to Cayre, Pasha's host application receives selection of an app download link, and in response, invokes the app manager and installer components to "perform the installation and download operations." Prelim. Reply, 4–5 (citing Ex. 1003, 17:21-34). Petitioner contends that Patent Owner's argument that Pasha's App Manager cannot be invoked because it is "necessarily running" on the device is contrary to the

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[10] U.S. Patent Publication No. 2017/0192764/A1, published July 6, 2017 (Ex. 1019, "Cayre").

plain meaning for "invoke" as "to call or activate." *Id.* at n.1 (citing Pet. 39; Prelim. Resp. 33–34). Petitioner contends that whether the "installation client" is running in the background when it is "invoked" or called to perform its function is irrelevant. *Id.*

At this stage of the proceeding, we find Petitioner's arguments persuasive. Pasha discloses that the App Manager 180 and the Installer 182 are called to perform installation and download functions while the host application remains in the foreground. Ex. 1003, 19:62–20:9; *see also id.* at 17:18–20 ("the link 166 may be selected *to initiate* the download process without the use of a store-like interface"). To the extent Patent Owner argues that Pasha's installation client is not "invoked" because it is already running before a link is selected by the user, Patent Owner offers no support for such a narrow interpretation of the claim term. *See* Ex. 1001, 13:57–58 (stating merely that an installation client is *invoked* if it is *available*). Moreover, we agree with Petitioner that Pasha contemplates that "the App Manager and Installer need not be running when a download is requested." Prelim. Reply 5 n.1 (citing Ex. 1003, 18:50–58; Pet. 64); Ex. 1003, 18:50– 58 ("When a download is requested . . . a check may be performed to determine whether the App Manager 180 and installer 182 are present and *accessible* on the client device 130." Emphasis added).

Based on our review of the current record, we therefore determine that the information presented supports sufficiently, for purposes of institution, Petitioner's assertion that Pasha discloses this limitation.

### g) *Limitation 1[f2]*

Limitation 1[f2] recites "instruct said installation client to automatically download an installation file of said first software application to said device over said network using said network interface in the

background on said device, without directing said user interaction to an app store." Ex. 1001, 21:21–26. Petitioner argues that Pasha discloses that selecting app download link 166 initiates download of Application Package 172 by App Manager 180 via network 150. Pet. 60–61 (citing Ex. 1003, Fig. 3, 8:44–64, 17:39–43). Petitioner argues that Pasha also discloses installing applications in the background and without requiring the user to interact with an app store. *Id.* at 61–62 (citing Ex. 1003, 1:50–57, 17:4–20, 19:67–20:9).

Patent Owner does not specifically respond to these contentions. *See generally* Prelim. Resp. Based on our review of the current record, we determine that the information presented supports sufficiently, for purposes of institution, Petitioner's assertion that Pasha discloses this limitation.

### h)   Limitation 1[f3]

Limitation 1[f3] recites "using said downloaded installation file, install said first software application on said device in the background on said device while maintaining a user experience of interaction with said second software application in the foreground." Ex. 1001, 21:27–31. Petitioner argues that Pasha discloses that Installer 182 installs application package 172 on client device 130 in the background while the user interacts with host application 132 in the foreground. Pet. 63 (citing Ex. 9:22–25, 16:35–48, 19:62–65, 19:67–20:9).

Patent Owner does not specifically respond to these contentions. *See generally* Prelim. Resp. Based on our review of the current record, we determine that the information presented supports sufficiently, for purposes of institution, Petitioner's assertion that Pasha discloses this limitation.

*i)   Limitation 1[g]*

Limitation 1[g] recites "when said installation client is unavailable on said device, redirect said device to an app store for downloading and installing said first software application on said device." Ex. 1001, 21:32–35. Petitioner contends that Pasha discloses that when "a download is requested . . . a check may be performed to determine whether the App Manager 180 and installer 182 are present and accessible on the client device 130," and that "[i]f the App Manager 180 and Installer 182 are not 'present and accessible' during the check, 'the ordinary app store for the operating system may be used as a fallback.'" Pet. 64 (citing Ex. 1003, 18:50–58). Petitioner argues that Pasha's use of the app store as a fallback discloses redirecting the device to an app store. *Id.*

Patent Owner argues that redirecting "is a *positive action* that brings the user to the app store," which Pasha does not disclose. Prelim. Resp. 37–38. According to Patent Owner, the availability of an app store that may be used "as a fallback" is not the same as positively redirecting the device to the app store, as claimed. *Id.* (citing Ex. 1003, 18:55–58).

The '951 patent explains that "the term 'redirected to an app store' means that user interaction using the device is shifted to a site and/or application for obtaining apps." Ex. 1001, 11:10–12. We are persuaded for the purpose of institution, that Pasha's disclosure of the "app store for the operating system *may be used* as a fallback" meets the claimed redirection or shifting.[11] Ex. 1003, 18:54–58. Dr. Almeroth testifies that the claimed "step

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[11] To the extent Patent Owner contends that specific user interaction is required as part of the claimed redirection, we find no express support in the specification for such a requirement. *See* Ex. 1001, 11:10–16. The parties may address the issue as one of claim interpretation during trial.

is simply choosing a conventional, albeit less desirable alternative, when a more desirable (but also conventional) alternative cannot be used," and that "Pasha discloses taking this exact same alternative." Ex. 1008 ¶ 171 (citing Ex. 1003, 18:54–58). Dr. Almeroth's testimony is the only testimony we have before us in this proceeding relative to Pasha, and we find it persuasive for institution.

Based on our review of the current record, we therefore determine that the information presented supports sufficiently, for purposes of institution, Petitioner's assertion that Pasha discloses this limitation.

### 2. Independent Claims 12 and 17

Claim 12 recites "a method for installation of software applications on a mobile device, comprising: executing, by at least one hardware processor operating in said device," and also recites other limitations that are similar to those in claim 1. *See* Ex. 1001, 22:7–39. Petitioner contends that Pasha discloses the preamble because it discloses "software running on one or more computer systems 600 performs one or more steps of one more method described." Pet. 52–53 (citing Ex. 1003 at 23:14–56, Fig. 6; Ex. 1008 ¶¶ 61–62). Petitioner further contends that Pasha discloses that the computer system 600 may be "a mobile telephone, a personal digital assistant (PDA), [or] a tablet computer system," with "a direct application install feature that may be used by third-party applications to download and install additional applications onto a mobile device." *Id.* at 53 (citing Ex. 1003, 1:36–38). For the remaining limitations of claim 12, Petitioner combines its arguments for with those directed to the limitations of claim 1, discussed above. *Id.* at 55–64 (citing Pet. §§ X.B.1(d)–(k)); Ex. 1008 ¶¶ 61–87.

Claim 17 recites "a non-transitory computer readable medium including instructions that, when executed by at least one processor, cause

the at least one processor to perform operations for installing software applications on a mobile device," and also recites other limitations that are similar to those in claim 1. Ex. 1001, 22:55-23:22. Petitioner contends that Pasha discloses the recited instructions because it discloses a computer system 600 with "software running on one or more computer systems 600 performs one or more steps of one more method described." Pet. 52–53 (citing Ex. 1003 at 23:14–56). Petitioner further contends that Pasha discloses that the computer system 600 includes memory 604 and storage 606 and which both may contain "instructions for processor 602 to execute or data for processor 602 to operate on." *Id.* at 54 (citing Ex. 1003, 23:57–65, 24:35–65, 29:31–30:36). For the remaining limitations of claim 17, Petitioner combines its arguments with those directed to the limitations of claim 1, discussed above. *Id.* at 54–64 (citing Pet. §§ X.B.1(c)–(k)); Ex. 1008 ¶¶ 61–87).

Patent Owner does not present separate argument for claims 12 and 17. *See* Prelim. Resp. 24–39 (arguing both grounds and all challenged claims together).

For the reasons discussed above with regard to claim 1, and because Petitioner sufficiently shows that Pasha discloses the additional elements recited in claims 12 and 17, we determine that Petitioner has established it is more likely than not that Pasha anticipates the subject matter of claims 12 and 17.

### 3. *Dependent Claims 3–11, 14–16 and 18*

Petitioner argues that Pasha additionally anticipates dependent claims 3–11, 14–16 and 18. Pet. 64–74.

Claim 3 depends on claim 1 and additionally recites "wherein, upon being instructed to automatically download said installation file, said

installation client downloads said installation file onto said device from a respective network address of said installation file." Ex. 1001, 21:40–44. Petitioner contends that Pasha discloses download links 166 which are displayed in the content 164 of the host application 132 may be hyperlinks that include "Uniform Resource Locator(s) ('URLs') identifying the network location (e.g., network host name or address, and path on the host)" from which an application package 172 may be downloaded by the client device 130. Pet. 65 (citing Ex. 1003, 7:2–8). Petitioner further contends that Pasha discloses that the "App Manager [180] may download the application package 172 . . . from the server 162," i.e., the network address contained in the hyperlink URL. *Id.*

Claim 4 depends on claim 3 and additionally recites "wherein said installation client retrieves said respective network address over said network from an app information server." Ex 1001, 21:45–47. Petitioner contends that Pasha discloses that the content of the host application 132, which may include one or more application download links 166 in the form of URL hyperlinks having network address information contained therein, may be provided by "a third party system 170." Pet. 65–66 (citing Ex. 1003, 7:2–17). According to Petitioner, the third party system 170 may be hosted by an app store operator, such as a vendor of the client device 130 or the client device's operating system. *Id.* at 66 (citing Ex. 1003, 7:18–20). Petitioner contends that Pasha therefore discloses the network address contained in the URL provided in the content of the host app 132 is received over network 150 from the app store operator, i.e., an app information server. *Id.* (citing Ex. 1003 at 7:18–20, 17:35–43, Fig. 3).

Claim 5 depends on claim 3 and further recites "wherein said installation client constructs said respective network address using

information included in said link." Ex. 1001, 21:48–50.  Petitioner contends
that "constructing" could be "for example by retrieving the address for the
app specified by the link from a non-transitory internal memory device 100."
Pet. 66–67 (quoting Ex 1001 at 9:57–59).  Petitioner further contends that
the App Manager 180 of Pasha "constructs" the network address using
information contained in a URL of an application download link 166, so that
App Manager 180 can download the application package 172 from that
network address.  *Id.* at 67 (citing Ex. 1001, 7:2–8, 8:44–67, 17:35–18:3; Ex.
1008 ¶¶ 95–96).

Claims 6 and 14 depend from independent claims 1 and 12,
respectively, and further recite "wherein said installation client is invoked
when said link comprises a deep link linking said installation of said first
software application to said installation client."  Ex. 1001, 21:51–54, 22:43–
46.  Petitioner contends that Pasha discloses the application download link
166 displayed in the content of the host application may be in the form of a
URL hyperlink "identifying the network location . . . from which an
application package 172 may be downloaded by the client system 130,"  and
that selection of that link *automatically* initiates the download of the
associated application package 172.  Pet. 68 (citing Ex. 1003, 7:2–9, 8:44–
58, 17:35–43).  Petitioner argues that although Pasha does not explicitly use
the term "deep link," Pasha's download link 166 is functionally a deep link
because selection of the link causes automatic download to ensue, without
any additional user input, by invocation of App Manager 180.  *Id.* at 69
(citing Ex. 1008 ¶¶ 98–99).

Claims 7 and 15 depend on independent claims 1 and 12, respectively,
and further recite "wherein said installation client prompts for user
confirmation of said installation of said first software application prior to

said automatic download and performs said automatic download only when said confirmation is obtained." Ex. 1001, 21:55–59, 22:47–51. Petitioner contends that Pasha discloses that the "App Manager 180 may control the download process by checking permissions," and may "present a request to the user for approval to perform operations corresponding to the requested permissions." Pet. 69–70 (citing Ex. 1003, 8:67–9:14, 16:8–17, 22:22–51). Petitioner further contends that Pasha discloses that if the set of permissions accepted by the user 176 does not match the set of requested permissions 174, "then the application is not downloaded and installed," and "[i]f the lists match, then the application download and install process may be initiated." Id. (citing Ex. 1003, 20:21–38, 9:15–38). Petitioner further contends that Pasha discloses that the permission request may be performed at any suitable point in the download and install operations prior to execution of the installed application 184, including prior to downloading the application package. Id. at 70–71 (citing Ex. 1003, 17:39–43, 20:28–31, 22:43–51).

Claim 8 depends on claim 7 and further recites "wherein said prompting for user confirmation comprises retrieving information associated with said first software application from a server over said network using said network interface and displaying said information on a display of said device." Ex. 1001, 21:60–64. Petitioner contends that Pasha discloses that the "application developer may include in the downloaded application package 172, a list of requested permissions 174," which meets the claimed "information associated with said first software application." Pet. 71 (citing Ex. 1003, 7:42–50, 8:59–67, 17:39–43, 20:10–14). Petitioner further contends that Pasha's download of the application packages uses its communication interface 610, which interfaces with one or more networks.

*Id.* at 71–72 (citing Ex. 1003, 16:28–31, 17:39–43, 23:14–28 25:50–26:15). According to Petitioner, the requested permissions in Pasha are displayed in a dialogue box or other user interface in the host application. *Id.* at 72 (citing Ex. 1003, 8:67–9:7, 16:8–13, 22:22–42).

Claim 9 depends on claim 7 and further recites "wherein said installation client resumes running in the background when a response is received to said prompting." Ex. 1001; 21:65–67. Petitioner contends that Pasha discloses that if the accepted permissions 176 and requested permissions 174 match, "then the application download and install process may be initiated." Pet. 72 (citing Ex. 1003, 19:67–20:9, 20:31–38; Pet. § X(B)(1)(h)).

Claim 10 depends on claim 1 and further recites "wherein said installation client comprises integrated security processes." Ex. 1001, 22:1–2. Petitioner contends that Pasha discloses that "application package 172 may be encrypted and signed, e.g., using public-key encryption," to prevent unauthorized modification," and that "an encrypted application package may be decrypted using appropriate decryption keys at the time it is installed" on the client device 130. Pet. 73 (citing Ex. 1003, 7:53–57; Ex 1008 ¶ 109). Petitioner further contends that application package 172 may be provided on a server of a social-networking system 160 or other third-party system 170 and signed with a digital signature using a private key associated with either the social-networking system 160 or other third-party system 170, and Pasha's client may verify the downloaded application package. *Id.* (citing Ex. 1003, 17:35–50, 18:4–6).

Claims 11, 16 and 18 depend from independent claims 1, 12, and 17, respectively. Claim 11 further recites "wherein said at least one processor is further configured for executing said instructions to redirect said device to

said app store when said invocation of the installation client fails," and claims 16 and 18 recite a similar limitation. Ex. 1001, 22:3–6, 22:52–54, 23:23–26. Petitioner contends that Pasha discloses that when "a download is requested, or at other times, e.g. when the host application is opened, a check may be performed to determine whether the App Manager 180 and Installer 182 are present and accessible on the client device 130," and if not accessible, then "the ordinary app store for the operating system may be used as a fallback." Pet. 74 (citing Ex. 1003, 18:50–54, 18:55–58). Petitioner contends that Pasha does not specify all of the conditions that may cause App Manager 180 and Installer 182 not to be accessible, but this broad range of conditions includes the specific condition of having the invocation of App Manager 180 and Installer 182 fail. *Id.* (citing Ex. 1008 ¶ 110).

Patent Owner did not present separate arguments directed specifically at dependent claims 3–11, 14–16, and 18. *See generally* Prelim Resp. Based on our review of the current record, and in particular, Petitioner's arguments set forth above as well as portions of Pasha and Dr. Almeroth's testimony cited above, we determine that Petitioner has established it is more likely than not that Pasha anticipates the subject matter of claims 3–11, 14–16 and 18.

### G. Obviousness over Pasha

Petitioner argues that dependent claims 2, 4–6, 11, 13, 14, 16 and 18 are unpatentable under 35 U.S.C. § 103 as obvious in view of Pasha. Pet. 74–82. For the reasons that follow, we are persuaded that the evidence, including Dr. Almeroth's testimony, sufficiently supports Petitioner's arguments and therefore establishes it is more likely than not it will prevail with respect to this ground at this stage of the proceeding.

Claims 2 and 13 depend on claims 1 and 12, respectively, and further recite "wherein said at least one processor is further configured for executing said instructions to close said installation client when said installation of said first software application is completed." Ex. 1001, 21:36–39, 22:40–42. Petitioner contends that although Pasha does not explicitly disclose closing the installation client, it would have been an obvious design choice to a person of ordinary skill in the art to have Pasha's App Manager 180 and Installer 182 close after installation of the application is complete. Pet. 75 (citing Ex. 1008 ¶¶ 117–118). Petitioner contends that a person of ordinary skill in the art "would have understood a choice between speed (having the app remain open and ready to perform its function again) or conserving resources (closing the app), such as storage, processing power, and battery life." *Id.* (citing Ex. 1008 ¶ 118). Petitioner further contends that a person of ordinary skill in the art "would have understood that computers have limited computational power, and running applications, processes, and other modules on mobile devices which are not active and/or not providing any utility to the computer would waste those limited computational resources," and would have been motivated to close Pasha's App Manager and Installer after an application package had been downloaded and installed. *Id.* at 75–76 (citing Ex. 1008 ¶ 118).

Claim 4 depends from claim 3 and further recites "wherein said installation client retrieves said respective network address over said network from an app information server." Ex. 1001, 21:45–47. Petitioner contends that to the extent Pasha does not anticipate this claim, it renders it obvious. Pet. 76. Petitioner contends that to the extent Pasha may be considered lacking explicit language regarding whether the network address is received by the App Manager, (1) it was well known that the functionality

provided by separate software applications, modules, or components which all run on the same device in parallel could readily be substituted for one another, or combined into a single application, and (2) the App Manager would be a routine design choice to retrieve the network address. *Id.* at 76–77 (citing Ex. 1008 ¶¶ 119–121). Petitioner points out that the '951 patent describes that UX module 710, which provides App Details 711 for display, and the Download & Installer Module 720, which downloads and installs the new app when the instant install link is selected, are separate modules "performing separate functions." *Id.* (citing Ex. 1001, 14:4–31, 9:55–63). Petitioner therefore contends that the specific functional block that performs this routine operation would have merely been a matter of design choice for a person of ordinary skill in the art, and that in the case of Pasha, the App Manager, which ultimately uses the retrieved network address, would have clearly been a logical choice for performing this function. *Id.* (citing Ex. 1008 ¶ 121).

Claim 5 depends on claim 3 and further recites "wherein said installation client constructs said respective network address using information included in said link." Ex. 1001, 21:48-50. Petitioner contends that Pasha renders claim 5 obvious for the reasons discussed relating to obviousness of claim 4. Pet. 77–78.

Claims 6 and 14 depend on claims 1 and 12, respectively, and further recite "wherein said installation client is invoked when said link comprises a deep link linking said installation of said first software application to said installation client." Ex. 1001, 21:51–54, 22:43–46. Petitioner contends that to the extent Pasha does not anticipate these claims, it renders them obvious. Pet. 79–80. Petitioner further contends that even if Pasha does not explicitly use the term "deep link," a person of ordinary skill in the art would have

understood that application download link 166 to functionally be a deep link because selection of the application download link 166 causes "automatic" download to ensue, without any additional user input. Pet. 80 (citing Ex. 1008 ¶ 126). Petitioner further contends that "deep links" were well understood for specifying a specific page within a website and/or a specific location within an app, and such use in Pasha would have been recognized by a person of ordinary skill in the art as an obvious design choice. *Id.* (citing Ex. 1007; Ex. 1008 ¶ 127).

Claims 11, 16 and 18 depend on claims 1, 12 and 17, respectively. Claim 11 further recites "wherein said at least one processor is further configured for executing said instructions to redirect said device to said app store when said invocation of the installation client fails," and claims 16 and 18 recite a similar limitation. Ex. 1001, 22:3–6, 22:52–54, 23:23–26. Petitioner contends that to the extent Pasha does not anticipate these claims, it renders them obvious. Pet. 81. Petitioner contends that a person of ordinary skill in the art would clearly have understood that if App Manager 180 and Installer 182 are not present and accessible, an invocation of these apps would certainly fail. *Id.* at 81–82 (citing Ex. 1008 ¶ 126). Petitioner contends that a person of ordinary skill in the art would have understood that redirecting the device to the app store when invocation of App Manager 180 and Installer 182 failed was an obvious modification to Pasha. *Id.* at 82 (citing Ex. 1008 ¶¶ 129–130).

Patent Owner does not specifically address any of Petitioner's citations and arguments for this ground. *See* Prelim. Resp. 39 (arguing that Grounds III–V are deficient because "Petitioner failed to meet their burden to show that the independent claims are anticipated"). Based on our review of the current record, and in particular, Petitioner's arguments set forth

above as well as portions of Pasha and Dr. Almeroth's testimony cited above, we determine that Petitioner has established it is more likely than not to prevail in showing that the Pasha renders the subject matter of claims 2, 4–6, 11, 13, 14, 16 and 18 obvious.

### H. Obviousness over Pasha and Yamada

Petitioner argues that dependent claims 2 and 13 are unpatentable under 35 U.S.C. § 103 as obvious by Pasha in view of Yamada. Pet. 82–86. Petitioner contends that Yamada discloses a "master installer," which includes an "administrative account installer," that performs software installation operations and receives "installation operation commands." Pet. 83 (citing Ex. 1004 ¶¶ 35, 45, 52–66). Petitioner further contends that Yamada discloses that when "execution of all of the installation operation commands is completed, the administrator account installer is closed." *Id.* (citing Ex. 1004 ¶ 66).

Petitioner argues that a person of ordinary skill in the art would have been motivated to combine Pasha and Yamada because they are in the same field of endeavor, i.e., the installation of software on computing device using installation applications. Pet. 84 (citing Ex. 1003, 8:59–9:14, 17:21–18:58; Ex. 1004 ¶¶ 14–15). Petitioner further argues that Yamada teaches closing an installation after completion to avoid lowering the computer's security level, and that those teachings would have motivated a person of ordinary skill in the art to close Pasha's App Manager 180 and Installer 182 after the downloading and installation of the app package 172 onto the client device 130. *Id.* at 85 (citing Ex. 1004 ¶¶ 14, 17–18; Ex. 1008 ¶¶ 134–137). According to Petitioner, such a modification to Pasha's system would have

"increased the level of security on the client device for tasks performed after the downloading and installing." *Id.* at 86 (citing Ex. 1008 ¶ 137).

Patent Owner does not specifically address any of Petitioner's citations and arguments for this ground. *See* Prelim. Resp. 39. Based on our review of the current record, and in particular, Petitioner's arguments set forth above, portions of Pasha and Yamada cited above, and the portions of Dr. Almeroth's testimony cited above, we determine that Petitioner has established it is more likely than not to prevail in showing that the combination of Pasha and Yamada renders the subject matter of claims 2 and 13 obvious.

### I.    *Obviousness of Pasha and Molinet*

Petitioner argues that dependent claims 6 and 14 are obvious in view of Pasha in view of Molinet. Pet. 86–88. Petitioner contends that Molinet describes "contextual deep linking," where a server may send a link that causes an application on the client device to open or initiate if the application is already installed. Pet. 87 (citing Ex. 1005 ¶¶ 3, 25, 29, 83). Petitioner contends that the contextual deep link may further indicate "a particular configuration for an application" including "particular settings, parameters, variables, and other options for the application." *Id.* at 88 (citing Ex. 1005 ¶ 25).

Petitioner contends that a person of ordinary skill in the art would have been motivated to combine Pasha and Molinet because both address technical problems in the same field of endeavor: providing URL links in mobile applications, and installing applications onto mobile devices. *Id.* (citing Ex. 1003, 6:61–7:23, 8:59–9:14, 17:21–18:58; Ex. 1005 ¶¶ 22–23, 26–27). Petitioner further contends that a person of ordinary skill in the art would have been motivated to adapt Molinet's "contextual deep link" into

Pasha's application download link such that opening the link would initiate the App Manager and would provide a setting for the App Manager to download the application associated with the link. *Id.* at 88–89 (Ex. 1005 ¶¶ 5, 29, 83, 120–24; Ex. 1008 ¶¶ 142-44). Petitioner also contends that a person of ordinary skill in the art would have been motivated to make such a combination so that the application download link in the form of a contextual deep link would be able to function under any context of the client device. *Id.* at 89.

Patent Owner does not specifically address any of Petitioner's citations and arguments for this ground. *See* Prelim. Resp. 39. Based on our review of the current record, and in particular, Petitioner's arguments set forth above, portions of Pasha and Molinet cited above, and the portions of Dr. Almeroth's testimony cited above, we determine that Petitioner has established it is more likely than not to prevail in showing that the combination of Pasha and Molinet renders the subject matter of claims 6 and 14 obvious.

## IV. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 325(D)

Institution of post grant review is discretionary. *See Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (stating in context of *inter partes* review that "the PTO is permitted, but never compelled, to institute an IPR proceeding."); 35 U.S.C. § 324(a). Pursuant to 35 U.S.C. § 325(d), in determining whether to institute a post grant review, "the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." In evaluating arguments under § 325(d), we use

[a] two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

*Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017–01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph) (listing factors to consider in evaluating the applicability of § 325(d)).

### A. Patent Owner's Contentions

Patent Owner contends that we should deny the Petition under § 325(d) because Petitioner relies on substantially similar art and argument that was presented and considered during prosecution of the '951 patent and its continuation, the '194 application. Prelim. Resp. 40–44. Patent Owner argues that Petitioner has failed to demonstrate that the examiner materially erred in allowing the claims during either prosecution. *Id.* at 42–44.

First, Patent Owner contends that Pasha is substantially the same as and cumulative to Cayre, which was cited during prosecution of the '951 patent.[12] *Id.* at 41–43. Specifically, Patent Owner contends that the examiner cited Cayre for teaching an installation client for downloading and installing applications on a device to run in the background of the device, but later found the claims patentable over Cayre. *Id.* at 42 (citing Ex. 1002,

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[12] The claims of the '054 application were rejected as obvious over U.S. Patent Application 2016/0216954 A1, published July 17, 2018 ("Jitkoff") and Cayre. *See* Ex. 1002, 144–146.

146, 213). Patent Owner contends that Petitioner cites Pasha for an installation client that also runs in the background, and therefore, presents the substantially the same art and argument as those that were presented during prosecution of the '951 patent. *Id.* at 42.

Second, Patent Owner contends that, during the prosecution of the '194 child application, the examiner found similar claims allowable over Pasha. *Id.* at 43 (citing Ex. 2001, 4–5; 177–181). Specifically, Patent Owner contends the examiner found that the cited references, *including Pasha*, did not teach claim limitations related to (1) invoking the installation client for downloading and installing applications in the background, and (2) redirecting to an app store when installation client is unavailable. *Id.* at 43–44 (citing Ex. 2001, 4–5). Patent Owner argues that "[n]othing in the record indicates that the examiner failed to fully evaluate the considered art or that additional evidence or facts warrant reconsideration," and Petitioner has failed to demonstrate that the examiner materially erred in allowing the claims. *Id.* at 44.

B.     *Petitioner's Preliminary Reply*

Petitioner responds that Pasha was not cited during the prosecution of the '951 patent and is not the same or substantially the same as Cayre. Prelim. Reply, 1–5. Petitioner argues that Pasha was never cited during the prosecution of the '951 patent, and was only cited in the '194 application prosecution in an information disclosure statement ("IDS") filed *after* a notice of allowance. *Id.* at 1–2 (citing Ex. 2001, 14–15, 22–23). Petitioner argues that Pasha's citation in the continuation application has less relevance to the challenged claims. *Id.* (citing *Microsoft Corp. v. Parallel Networks Licensing, LLC*, IPR2015-00483, Paper 10, 15 (PTAB July 15, 2015)).

Petitioner further argues that the '194 application claims differ from the challenged claims because, among other things, they recite a "network-connected" device rather than a "mobile device." *Id.* at 2–3. Petitioner therefore argues that Pasha was not previously presented to the Office on the challenged claims under *Advanced Bionics* prong one.

Applying *Advanced Bionics* prong two, Petitioner argues that even if the examiner applied Pasha to substantially the same claim language in the '194 application, the examiner erred in overlooking the teachings of Pasha. *Id.* at 3. Specifically, Petitioner argues that despite being provided with the Petition, the examiner made no attempt to address Petitioner's showing of anticipation by Pasha. *Id.*

As to Cayre, Petitioner contends that there are significant differences between the disclosures of Cayre and Pasha. *Id.* at 4. For example, Petitioner argues, Cayre does not disclose identifying a link being selected that causes an application to be downloaded and installed, and Cayre's "'first application' is neither invoked by another application nor invokes another application to perform the download and installation." *Id.* at 4–5 (citing Ex. 1002, 144–146; Ex. 1019, code (57), ¶¶ 41–46, 54). In contrast, Petitioner argues, "Pasha's host application displays and receives selection of an app download link . . . and in response, invokes the app manager and installer components to 'perform the installation and download operations.'" *Id.* at 4–5 (citing Pet. 58–59, citing Ex. 1003, 17:21–34). Petitioner also argues that Cayre does not teach redirecting the device to an app store, which the Petition alleges Pasha does. *Id.* at 5 (citing Pet. 64; Ex. 1002, 174; Ex. 1003, 18:50–58).

### C. Patent Owner's Preliminary Sur-Reply

Patent Owner responds that the Federal Circuit "has many times applied the prosecution history of one patent in a family to a related patent in the same family," and therefore, the examiner's consideration of Pasha in the '194 application is relevant here. Prelim. Sur-Reply 3 (citing *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1345 (Fed. Cir. 2004); *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 980 (Fed. Cir. 1999)). Patent Owner contends that "the claims [of the '951 patent and the '194 application] are identical in the portions material to consideration of the § 325(d) analysis." *Id.* at 3–4 (citing Ex. 1002, 213; Ex. 2001, 4–5). Patent Owner further contends that the examiner did not overlook Pasha during prosecution of the '194 application because he addressed the substance of Pasha in the Notice of Allowance of the '194 application claims. *Id.* at 4 (citing Ex. 2001, 4).

### D. Analysis

#### 1. First Prong: Whether the art or arguments presented in the Petition are the same or substantially the same as those previously presented

As part of our analysis under the first prong of the *Advanced Bionics* framework, we look to *Becton, Dickinson* factors (a), (b), and (d) to evaluate "the similarities and material differences between the asserted art and the prior art" previously presented to the Office during a proceeding pertaining to the challenged patent (factor (a)), "the cumulative nature of the asserted art and the prior art evaluated" previously (factor (b)), and "the extent of the overlap between the arguments" previously presented "and the manner in which petitioner relies on the prior art" (factor (d)). *Advanced Bionics*, Paper 6 at 9–10 n.10 (citing *Becton, Dickinson*, Paper 8 at 17–18).

*a) Whether Pasha is substantially the same as Cayre
cited during prosecution of the '951 patent*

We are not persuaded that Pasha is substantially the same art as
Cayre. Patent Owner argues that the examiner's rejection in view of Cayre's
teaching of an installation client was based on an identical argument
advanced by the Petition based on Pasha for the same claim limitation.
Prelim. Resp. 41–42 (citing Ex. 1002, 146, 213, Pet. 60). Patent Owner
therefore concludes that "the first prong of the *Advanced Bionics* is met
because both the same or substantially the same art and the same or
substantially the same arguments previously were presented to the Office."
*Id.* at 42.

Specifically, we are not persuaded that a previously presented
argument on *just one of many* claim limitations is sufficient to establish that
substantially the same art or arguments were previously presented. Even
though the examiner cited Cayre as teaching an installation application, that
does not, in and of itself, mean that Pasha is substantially the same as Cayre.
Cayre fails to disclose many of the teachings of Pasha that Petitioner relies
on. For example, Petitioner points out, and we agree, Cayre fails to teach a
link that can be selected to cause an application to be installed, or an
installation client that can be invoked, or redirecting the device to app store
when an installation client is unavailable. *See* Prelim. Reply 4–5 (citing Ex.
1002, 144–146, 174; Ex. 1019, code (57), ¶¶ 41–46, 54). Notably, portions
of these limitations were added via examiner amendment while allowing the
claims over Cayre. *See* Ex. 1002, 207–214. In contrast, the Petition alleges
that Pasha discloses each of these aspects of the challenged claims. Pet. 56–
64. As such, we are persuaded of the distinctions between Cayre and Pasha,

and are persuaded that the former's disclosure is not cumulative to the latter's disclosure.

Likewise, there is little, if any, overlap between arguments made during examination and the manner in which Petitioner relies on the two different references. *See* Ex. 1002, 146 (the examiner relying on Cayre as a secondary reference, solely for teaching of an application that can run in the background).

Accordingly, we do not find that Petitioner's asserted grounds of unpatentability rely upon the same or substantially the same prior art or arguments considered during examination of the '951 patent. *See Oticon Medical AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15 at 20 (PTAB Oct. 16, 2019) (precedential) (declining to exercise discretion when new, non-cumulative prior art was asserted in the Petition).

> b) *Whether Pasha was previously presented to the Office during prosecution of the '194 application*

Patent Owner argues that the examiner allowed nearly identical claims of the '194 child application over Pasha, specifically addressing Pasha in the Notice of Allowance. Prelim. Resp. 43–44. Section 325(d), however, is directed to "same or substantially the same prior art or arguments *previously* [] presented to the Office." Emphasis added; *see also Advanced Bionics*, Paper 6 at 10 (the *Becton, Dickinson* factors "provide guidance as to whether the art presented in the petition is the 'same or substantially the same' as the prior art *previously* presented to the Office"). Because Pasha was presented to the Office during prosecution of the '194 application claims, *after* the Petition was filed, we determine that it was not *previously* presented to the Office and the first part of the *Advanced Bionics* framework is not satisfied.

We construe "previously presented" in 35 U.S.C. § 325(d) to refer to art and arguments presented to the Office prior to the *filing* of the petition at issue. Construing "previously presented" to encompass art and arguments presented to the Office after the filing of the petition but prior to the decision on institution would provide a loophole for patent owners with pending related applications to avoid AIA proceedings by simply filing the same art in an Information Disclosure Statement in a related application for consideration by the examiner instead of the Board. Such an attempt to avoid institution and Board review is an abuse of the process that undermines the policy considerations under § 325(d). Importantly, an information disclosure statement does not include an analysis identifying whether Petitioner has met their burden under § 324. *Advanced Bionics* provides a framework for an analysis under § 325(d), and explains that the "framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown." *Advanced Bionics* at 9. Section 325(d) should not be understood to permit a patent owner to request an Office evaluation of the evidence presented in a petition in an information disclosure statement in a related pending application subsequent to the filing of a petition. An examiner's consideration of such a request, i.e., consideration of the Petition and supporting evidence towards substantially similar claims concurrent with an earlier filed post-grant review proceeding, does not constitute art or arguments "previously presented" to the Office, and thus, cannot support exercising our discretion to deny review under § 325(d).

### 2. Conclusion

Specifically, we determine that Cayre is not cumulative to Pasha and Pasha was not *previously* presented to the Office. Furthermore, the Petition

includes other grounds that do not rely solely on Pasha, including a ground under § 101, and, therefore, the Petition, as a whole, is not sufficiently implicated under § 325(d) such that the entire Petition should be denied. Based on the totality of evidence before us, we decline to exercise discretion under 35 U.S.C. § 325(d) not to institute post grant review.

## V. CONCLUSION

After considering the evidence and arguments presented in the Petition, Preliminary Response, Preliminary Reply, and Preliminary Sur-Reply, we determine that the information presented shows that it is more likely than not that Petitioner would prevail in establishing that at least one of the challenged claims of the '951 patent is unpatentable on the grounds asserted in the Petition. Thus, we institute a post grant review as set forth in the Order below. Trial shall commence on the entry date of this Decision.

## VI. ORDER

It is therefore,

ORDERED that, pursuant to 35 U.S.C. § 324(a), a post-grant review of the '951 patent is hereby instituted on the challenge to claims 1–18 under 35 U.S.C. § 101 as unpatentable as claiming patent-ineligible subject matter;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 324(a), a post-grant review of the '951 patent is hereby instituted on the challenge to claims 1, 3–12, and 14–18 under 35 U.S.C. § 102(a) as unpatentable over Pasha;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 324(a), a post-grant review of the '951 patent is hereby instituted on the challenge to claims 2, 4–6, 13, and 14 under 35 U.S.C. § 103 as unpatentable over Pasha;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 324(a), a post-grant review of the '951 patent is hereby instituted on the challenge to claims 2 and 13 under 35 U.S.C. § 103 as unpatentable over Pasha and Yamada;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 324(a), a post-grant review of the '951 patent is hereby instituted on the challenge to claims 6 and 14 under 35 U.S.C. § 103 as unpatentable over Pasha and Molinet; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 324(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial commencing on the entry date of this Decision.

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