

Google Can't Get PTAB To Eye Website Patents

By **Andrew Karpan**

Law360 (October 5, 2021, 3:16 PM EDT) -- Google was dealt a blow in its fight with a small mobile technology company Monday when the Patent Trial and Appeal Board refused to review four Express Mobile website development patents that also have been asserted against Facebook, eBay, Microsoft and others.

The patent board handed down the rulings in a quartet of opinions that all rejected inter partes review petitions Google lodged against patents owned by Express Mobile Inc., a small and particularly litigious company headquartered about 75 miles away from Mountain View, where Google is based.

According to the PTAB rulings, the earliest patent of the bunch — U.S. Patent Nos. 6,546,397, a purported 2003 invention that covers a way that lets users plug settings into a web browser — had been asserted in "over 80 other terminated district court proceedings," in addition to the 22 lawsuits that are currently ongoing in federal courts in Texas, California, Delaware and Florida.

The lawsuit Google is fighting is in the U.S. District Court for the Western District of Texas, where **the country's most prolific patent judge** turned down **the tech giant's efforts** to send the case to California federal court back in August. Google is currently petitioning the Federal Circuit to overturn that finding.

In its efforts to beat the 2003 patent at the board, Google claimed, in part, that Express Mobile's invention was already covered by a slightly older patent that was issued to Microsoft a year earlier. (Microsoft is also among the companies that Express Mobile has sued and that lawsuit is in the midst of claims construction in the Northern District of California.)

But the board found that the older patent Google dug up only "dictates what products ultimately will be displayed on a website."

"Petitioner has not explained persuasively how this describes elements on a website," Administrative Patent Judge Amanda Wieker wrote for the panel for that one.

On paper, this was not strong enough of a connection for the patent board to decide to call a hearing to actually review Google's challenge, the board held.

Google had similar luck with the three other petitions against Express Mobile patents that the board delivered its take on. A trio of related patents, all were issued in 2018 and all allegedly covered a way of authoring software code to be used in mobile devices by finding ways to convert device-independent code into device-specific code, which can then be used by those kinds of devices.

But the collection of older inventions Google asserted at the PTAB only "converts vendor specific names ... to generic names," Judge Kristi Sawert wrote for the board in one of the opinions that covered those patents.

Express Mobile attorney Sal Lim of Feinberg Day Kramer Alberti Lim Tonkovich & Belloli LLP, told Law360 on Tuesday that the rulings reflected a "clean sweep and resounding victory for Express Mobile, as it is rare to receive four IPR institution denials from the PTAB all in one day."

The patent board has yet, however, to deliver its opinion on the fifth patent that Express Mobile has also asserted against Google in district court, which also covers web browser technology and which Facebook had separately challenged.

Counsel for Google in the case did not respond to a request for comment on the rulings.

The patents-at-issue are U.S. Patent Nos. 6,546,397; 9,928,044; 9,471,287; and 9,063,755.

Administrative Patent Judges Jeffrey S Smith, Amanda F. Wieker and Kristi Rupert Sawert sat on the board for all decisions.

Google is represented by Naveen Modi, Joseph E. Palys, Daniel Zeilberger and Arvind Jairam of Paul Hastings LLP.

Express Mobile is represented by Robert F. Kramer, Elizabeth Day, David Alberti, Sal Lim, Russell Tonkovich and Marc Belloli of Feinberg Day Kramer Alberti Lim Tonkovich & Belloli and Bridget Smith of Lowenstein & Weatherwax LLP.

The cases are Google LLC v. Express Mobile Inc., case numbers IPR2021-00700, IPR2021-00711, IPR2021-00710 and IPR2021-00709, at the Patent Trial and Appeal Board.

--Additional reporting by Kevin Stawicki. Editing by Amy Rowe.