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.

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PGR2022-00053
Patent 11,157,256 B2

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

AHMED, *Administrative Patent Judge.*

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
Granting Petitioner's Motion on Collateral Estoppel
Granting Patent Owner's Revised Motion to Amend
Dismissing Petitioner's Motion to Exclude
35 U.S.C. §§ 326(d), 328(a); 37 C.F.R. § 42.64(c)

I. INTRODUCTION

IronSource Ltd. ("Petitioner") requested a post-grant review of claims 1–22 (the "challenged claims") of U.S. Patent 11,157,256 B2 (Ex. 1001, "the '256 patent"). Paper 1 ("Petition" or "Pet."). Digital Turbine Inc. ("Patent Owner") filed a Preliminary Response. Paper 9. Applying the standard set forth in 35 U.S.C. § 324(a), we instituted a post-grant review of the challenged claims. Paper 10 ("Inst. Dec.").

After institution, Patent Owner filed a Patent Owner Response (Paper 14, "PO Resp."), Petitioner filed a Reply to Patent Owner's Response (Paper 19, "Pet. Reply"), and Patent Owner filed a Sur-reply (Paper 34, "PO Sur-reply"). Additionally, Patent Owner filed a Contingent Motion to Amend under 37 C.F.R. § 42.221 (Paper 15), Petitioner filed an Opposition to the MTA (Paper 29), and we issued a preliminary guidance preliminarily determining Patent Owner had failed to show that the proposed substitute claims had requisite written description support under 35 U.S.C. § 112(a) and also that Petitioner has demonstrated a reasonable likelihood of establishing that proposed substitute claims are unpatentable as obvious in view of the asserted art (Paper 27).

Patent Owner then filed a Revised Contingent Motion to Amend (Paper 35, "Revised MTA" or "RMTA"). Petitioner filed an Opposition to the Revised MTA (Paper 39, "RMTA Opp."), Patent Owner filed a Reply to Petitioner's Opposition to the Revised MTA (Paper 48, "RMTA Reply"), and Petitioner filed a Sur-reply to Patent Owner's Reply to the Revised MTA (Paper 52, "RMTA Sur-reply").

An oral argument was held in this proceeding on January 26, 2024, and a transcript was entered into the record. Paper 57 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6. This Decision is a final written decision under 35 U.S.C. § 328(a) as to the patentability of claims 1–22 of the '256 patent. For the reasons discussed below, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–22 of the '256 patent are unpatentable. We grant Patent Owner's Revised Contingent Motion to Amend as to proposed substitute claims 23–37.

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 4, 1.

B. Related Matters

The parties identify PGR2021-00096 challenging U.S. Patent 10,782,951 ("the '951 patent"), of which the '256 patent is a continuation. Pet. 1; Paper 4, 1.

C. The '256 Patent (Ex. 1001)

The '256 patent, titled "Instant Installation of Apps," was filed on August 13, 2020, as Application No. 16/992,194 ("the '194 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 1:52–54. The installation client enables users to download new apps in the background while maintaining interaction with their currently-used application. *Id.* at 2:6–12.

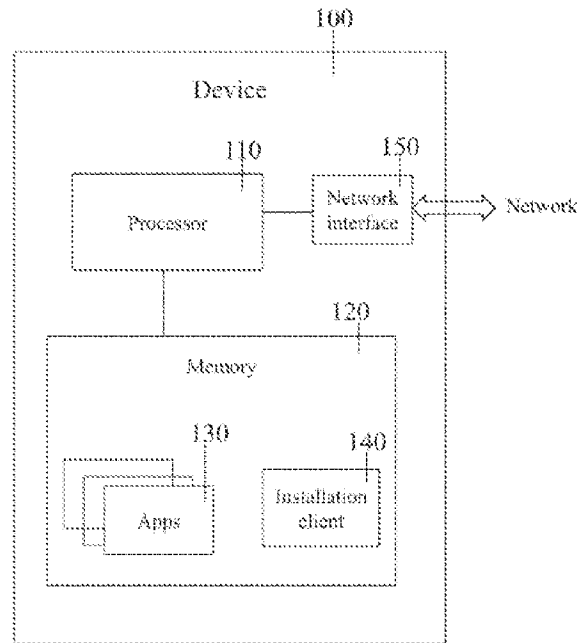Figure 1 of the '256 patent is reproduced below.

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 9:22–25, 9:36–54. Device 100 may be a mobile device. *Id.* at 9:41–42.

The '256 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 9:43–54.

The '256 patent describes different methods for downloading the application file. *See id.* at 9:59–10:3. For example, "installation client 140 obtains address information (e.g. a link) to the installation file" by "[q]uerying an address repository (e.g. on an external server) over the network and receiving the address information in response to the query." *Id.*

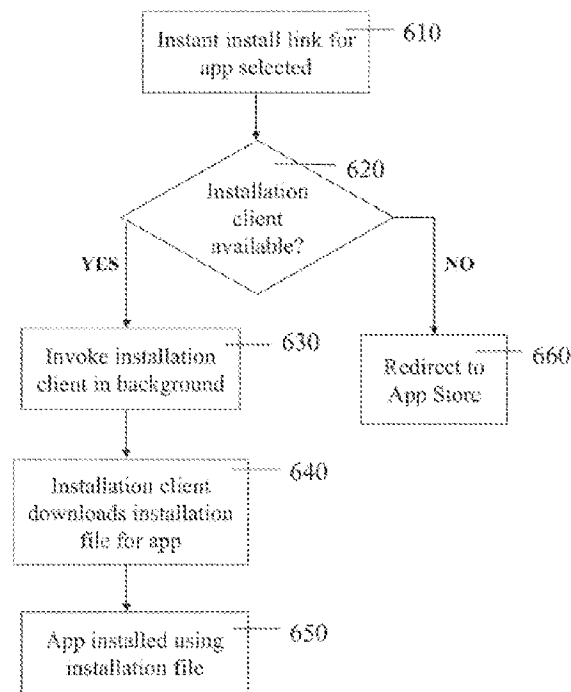Figure 6 of the '256 patent is reproduced below.

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 13:55–63. 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 13:64–14:2. If "NO," the device is redirected to an app store (step 660). *Id.* at 14:3–4.

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