

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

CONVERGENT MEDIA SOLUTIONS, LLC,
Patent Owner.

Case IPR2016-00047
Patent 8,640,183 B2

Before JAMESON LEE, LYNNE E. PETTIGREW, and
JOHN F. HORVATH, *Administrative Patent Judges*.

HORVATH, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Unified Patents Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute *inter partes* review of claims 1–5, 16, 18, 24–26, 32–38, 40–42, 49, 51–53, 55, and 58–61 (“the challenged claims”) of U.S. Patent No. 8,640,183 B2 (Ex. 1001, “the ’183 patent”). Convergent Media Solutions, LLC, (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”). Upon consideration of the Petition and Preliminary Response, we instituted an *inter partes* review to determine the patentability of the challenged claims. Paper 13 (“Dec. Inst.”).

Subsequent to institution, Patent Owner filed a Response (Paper 16, “PO Resp.”), and Petitioner filed a Reply (Paper 20, “Pet. Reply”). Neither Petitioner nor Patent Owner requested oral argument, and we determined oral argument was not necessary to resolve this proceeding. Paper 22.

We have jurisdiction under 35 U.S.C. § 6(b). This is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons set forth below, we enter adverse judgment against claims 60 and 61, and find Petitioner has shown by a preponderance of the evidence that claims 1–5, 16, 18, 24–26, 32–38, 40–42, 49, 51–53, 55, 58, and 59 of the ’183 patent are unpatentable.

B. Related Matters

Petitioner identifies the following as matters that could affect, or be affected by, a decision in this proceeding: *Convergent Media Solutions LLC v. AT&T Inc.*, Case No. 3-15-cv-02156 (N.D. Tex.); *Convergent Media Solutions LLC v. Hulu, Inc.*, Case No. 3-15-cv-02158 (N.D. Tex.); *Convergent Media Solutions LLC v. Netflix Inc.*, Case No. 3-15-cv-02160

(N.D. Tex.). Pet. 2. Patent Owner identifies each of the preceding matters as well as the following as a matter that could affect, or be affected by, a decision in this proceeding: *Convergent Media Solutions LLC v. Roku, Inc.*, Case No. 3-15-cv-02163 (N.D. Tex.). Paper 4, 2.

C. Evidence Relied Upon

Reference		Effective Date	Exhibit
Chen	US 8,479,238 B2	May 14, 2001 ¹	Ex. 1003
Elabbady	US 7,483,958 B1	Mar. 26, 2002 ²	Ex. 1004

Petitioner also relies upon the Declaration of Jon Weissman. Ex. 1002.

D. The Instituted Ground of Unpatentability

We instituted *inter partes* review of the '183 patent on the following ground of unpatentability (Dec. Inst. 27):

References	Basis	Claims Challenged
Chen and Elabbady	§ 103(a)	1–5, 16, 18, 24–26, 32–38, 40–42, 49, 51–53, 55, and 58–61

II. ANALYSIS

A. The '183 Patent

The '183 patent relates to systems and methods for navigating hypermedia using multiple coordinated input/output device sets. Ex. 1001, 3:13–15. The method allows “a user and/or an author to control what

¹ Chen was filed on May 14, 2002, but is entitled to claim priority to a provisional application filed on May 14, 2001. See § II.C *infra*.

² Elabbady was filed on March 26, 2002 and issued on January 27, 2009. It is prior art under 35 U.S.C. § 102(e) based on its March 26, 2002 filing date.

resources are presented on which device sets.” *Id.* at 3:15–17. The device sets may include laptops, desktops, tablets, personal digital assistants (PDAs), televisions (TVs), set-top boxes, video cassette recorders (VCRs) and digital video recorders (DVRs). *Id.* at 16:28–43, 18:32–59, 19:32–47. The term hypermedia refers to “any kind of media that may have the effect of a non-linear structure of associated elements,” and includes “graphics, video, and sound.” *Id.* at 7:13–22. The ’183 patent characterizes video and sound as examples of “continuous media,” or a “representation of ‘content’ elements that have an intrinsic duration, that continue (or extend) and may change over time.” *Id.* at 20:5–9.

The multiple input/output device sets described in the ’183 patent may be coordinated using “a device set management process that performs basic setup and update functions . . . to pre-identify and dynamically discover device sets.” Ex. 1001 37:36–43. This management process can “be based on and compatible with related lower-level processes and standards defined for linking such existing devices and systems . . . based on UPnP, HAVi, OSGi, Rendezvous and/or the like.” *Id.* at 37:46–50. The process enables basic communications among the devices in the device set, and “provide[s] discovery, presence, registration, and naming services to recognize and identify devices as they become available to participate in a network, and to characterize their capabilities.” *Id.* at 37:50–55.

Claims 1 and 58–60 of the ’183 patent are independent. Claim 1, reproduced below, is illustrative of the claims of the ’183 patent. Each of the other challenged claims depends from claim 1 or claim 60.

1. A method for use in a second computerized device set which is configured for wireless communication using a wireless communications protocol that enables wireless communication with a first computerized device set, wherein the first and second computerized device sets include respective first and second continuous media players, the method comprising:

making available to a user a first user interface that allows the user to select a continuous media content to be presented to the user, wherein the continuous media content includes a set of encoded video data;

making available to the user a second user interface that allows the user to select to have the continuous media content presented on either one of the first computerized device set and the second computerized device set;

receiving discovery information at the second computerized device set in accordance with a device management discovery protocol that is implemented at a communication layer above an internet protocol layer, and

wherein the discovery information allows the second computerized device set to determine that the first computerized device set is capable of receiving the continuous media content and playing the continuous media content;

wherein, in the event the user selects, via the second user interface, to have the continuous media content presented on the second computerized device set, the second media player decoding the continuous media content for presentation on the second computerized device set;

wherein, in the event the user selects, via the second user interface, to have the continuous media content presented on the first computerized device set, wirelessly transmitting, in accordance with a wireless local area network protocol, at least a resource indicator, wherein the resource indicator comprises at least one of a URL, URI, and URN, from the second computerized device set to the first computerized device set, wherein the resource indicator facilitates obtaining the continuous media content for presentation to the user on the first computerized device set; and

wherein the continuous media content is not presented on the second computerized device set during presentation on the first computerized device set, and the first user interface and the second user interface together comprise a unified media selection and presentation user interface, wherein the unified media selection and presentation user interface presents user input controls for selection of the continuous media content and for selection of either one of the first computerized device set and the second computerized device set for presentation of the continuous media content.

Ex. 1001, 164:22–165:6.

B. Claim Construction

The Board interprets claims of an unexpired patent using the broadest reasonable interpretation in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S.Ct. 2131, 2144–46 (2016). Even under the rule of broadest reasonable interpretation, claim terms are generally given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d

1249, 1257 (Fed. Cir. 2007). Only those terms which are in controversy need to be construed and 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).

Petitioner proposes we construe the term “*unified media selection and presentation user interface*.” Pet. 7–8. The term appears in each of independent claims 1 and 58–60 in the phrase:

the first user interface and the second user interface together comprise a *unified media selection and presentation user interface*, wherein the unified media selection and presentation user interface presents user input controls for selection of the continuous media content and for selection of either one of the first computerized device set and the second computerized device set for presentation of the continuous media content.

E.g., Ex. 1001, 164:65–165:6 (emphasis added).

Petitioner contends the term “unified” is not defined in the Specification, and does not appear in the Specification other than in the claims, and in the context of the ’183 patent’s disclosure of unrelated “unified messaging services.” Pet. 8; *see also* Ex. 1001, 103:35–42. Relying on a dictionary definition of “unify,” Petitioner contends the term “unified media selection and presentation user interface” should be construed to mean “a coherent set of user interfaces for selecting media and selecting a presentation device.” *Id.*; *see also* Ex. 1006, 1287 (defining “unify” to mean “to make into a unit or a coherent whole : UNITE”).

In our Decision to Institute, we agreed with Petitioner that the term “*unified media selection and presentation user interface*” does not appear in

the Specification, other than in the claims. As Petitioner noted, the term “unify” means “to make into a unit or a coherent whole : UNITE.” Ex. 1006, 1287. The term “unite” means “to become one or *as if one*,” and “to act in concert.” Ex. 3001, 1291 (emphasis added). Accordingly, in our Decision to Institute, we construed the term “*unified media selection and presentation user interface*” to mean “one or more user interfaces that, together, present controls for selecting continuous media content and a continuous media content presentation device.” Dec. Inst. 8.

The parties do not challenge this construction. See PO Resp.; see also Pet. Reply. On the complete record before us, we maintain this construction of the term “*unified media selection and presentation user interface*.”

C. Whether Chen Is Prior Art to the '183 Patent

Chen was filed on May 14, 2002, and claims priority to U.S. Provisional Application No. 60/290,788 (“the ’788 provisional”) filed on May 14, 2001. See Ex. 1003. The ’183 patent was filed on October 26, 2012, and claims priority, through a chain of continuations, to three provisional applications, including U.S. Provisional Application No. 60/379,635 (“the ’635 provisional”) filed on May 10, 2002. *Id.*

Patent Owner argues Chen, based on its May 14, 2002 filing date, is not prior art to the challenged claims of the ’183 patent because the challenged claims are entitled to claim priority to the May 10, 2002 filing date of the ’635 provisional. PO Resp. 2–3. Patent Owner provides a detailed claim chart mapping the disclosure in the ’635 provisional to the subject matter recited in the challenged claims. *Id.* at App’x, 1–31.

Petitioner argues Patent Owner has failed to show the challenged claims are entitled to claim priority to May 10, 2002 because the ’635

provisional does not support the following negative limitation recited in all of the independent claims: “the continuous media content is not presented on the second computerized device set during presentation on the first computerized device set.” Pet. Reply 19; *see also* Ex. 1001, 164:63–65.

Patent Owner argues this limitation is supported by a table in the appendix of the ’635 provisional that discloses using a TV (first device) as a main video screen, and using a PC/PDA (second device) to either duplicate the TV screen or display a different screen. *See* PO Resp., App’x, 16–17; Ex. 2002, 157. Patent Owner further argues this limitation is supported by disclosure in the ’635 provisional that “a primary video program be viewed on the TV . . . [and] interactive text such as [a] browser screen (or secondary video elements) be viewed on the PC/PDA for ease of reading and interaction, and to avoid disturbing viewing of the ongoing TV program by the interactor or others.” *Id.* at 156:5–8.

We find the disclosure in the ’635 provisional cited by Patent Owner adequately supports the negative limitation of not presenting media content on the second device when the media content is presented on the first device because it can be reasonably interpreted to mean displaying a movie on the TV, and displaying something else, e.g., a web page reviewing the movie on the PDA, in order to avoid disturbing a viewer watching the movie on the TV. *See Santarus, Inc. v. Par Pharmaceutical, Inc.*, 694 F.3d 1344, 1351 (Fed. Cir. 2012) (“Negative claim limitations are adequately supported when the specification describes a reason to exclude the relevant limitation. Such written description support need not rise to the level of disclaimer.”).

Upon reviewing the evidence cited by Patent Owner, and the arguments advanced by Patent Owner and Petitioner, we find, for the

reasons stated in the Patent Owner's Response, that Patent Owner has shown the challenged claims of the '183 patent are supported by the disclosure in the '635 provisional, and are entitled to claim priority to May 10, 2002. *See* P.O. Resp., App'x, 1–31.

Petitioner argues that Chen is nonetheless prior art to the challenged claims of the '183 patent because Chen is entitled to claim priority to the May 14, 2001 filing date of the '788 provisional, and because the material from Chen relied upon to challenge the claims of the '183 patent is also supported by the '788 provisional. Pet. Reply 1–19. Petitioner provides detailed claim charts mapping disclosures in the '788 provisional to the subject matter recited in Chen's claims, and to the material from Chen relied upon to challenge the claims of the '183 patent. *Id.* at 1–7, 9–19. Patent Owner, who did not request permission to file a sur-reply, has not challenged the evidence in Petitioner's Reply proffered to show that the '788 provisional supports Chen's claims and the material from Chen relied upon to challenge the claims of the '183 patent.

Upon reviewing the evidence cited by Petitioner, we find, for the reasons stated in Petitioner's Reply, that Petitioner has shown that Chen is prior art to the challenged claims of the '183 patent under 35 U.S.C. § 102(e), and that the '788 provisional supports the material from Chen Petitioner relied upon to challenge the claims of the '183 patent. *See* Pet. Reply, 1–7, 9–19 (citing Ex. 1010, 4, 7–11, Figs. 1, 2b, 4–11).

D. Unpatentability of claims 60 and 61

Petitioner argues claims 60 and 61 of the '183 patent would have been obvious over Chen and Elabbady. *See* Pet. 18, 20–21, 33–37. Patent Owner

does not contest Petitioner's challenge to the patentability of these claims, but instead "requests the cancellation of claims 60-61." See PO Resp. 1.

The Board's rules permit a party to "request judgment against itself at any time during a proceeding." 37 C.F.R § 42.73(b). The Board construes a party's "[a]bandonment of the contest," as a request for adverse judgment. 37 C.F.R § 42.73(b)(4). Accordingly, we construe Patent Owner's lack of response to Petitioner's challenge to claims 60 and 61, and Patent Owner's request to cancel claims 60 and 61 to be an "abandonment of the contest," and a request for adverse judgment as to those claims. We, therefore, enter adverse judgment against claims 60 and 61.

E. Alleged Obviousness of Claims 1–5, 16, 18, 24–26, 32–38, 40–42, 49, 51–53, 55, 58, and 59 over Chen and Elabbady

Petitioner argues claims 1–5, 16, 18, 24–26, 32–38, 40–42, 49, 51–53, 55, 58, and 59 of the '183 patent would have been obvious under 35 U.S.C. § 103(a) in view of the combination of Chen and Elabbady. Pet. 4.

1. Overview of Chen (Ex. 1003)

Chen discloses a system and method "for content-based non-linear control of video data playback." Ex. 1003, 1:64–65. Figure 3 of Chen is reproduced below.

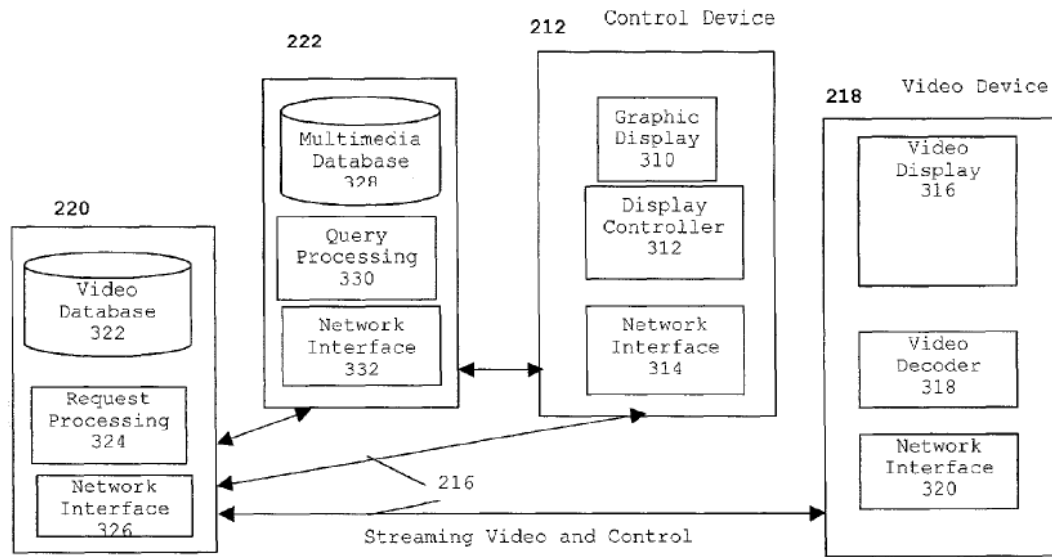


Figure 3

Figure 3 of Chen is a schematic illustration of the topology of Chen's networked system for non-linear control of video playback.

Control device 212, multimedia server 222, video server 220, and video device 218 are interconnected via network 216. Ex. 1003, 4:44–5:67, Fig. 2. Control device 212 can be a personal digital assistant (PDA), tablet, palmtop, laptop, or desktop computer. *Id.* at 4:47–60. Control device 212 “acts as a dynamic control pad for initiating video playback of content specific information,” and is “capable of inputting control command, communicating data, and playing multimedia data such as . . . still images, text, preview videos, or the like.” *Id.* at 4:47–53. Control device 212 connects to network 216 using a wireless communications protocol such as Bluetooth or IEEE 802.11b. *Id.* at 4:55–57.

Video device 218 includes a video display 316, “a video decoder 318 which decodes compressed video data, and a video device network interface 320 which interfaces the video display to the network.” Ex. 1003, 6:19–22 (emphasis omitted). Video device 218 “may be a television monitor,

computer monitor, or [a] similar device.” *Id.* at 5:4–7. Video device 218 may connect to network 216 through a wireless connection. *Id.* at 5:10–11.

Control device 212 provides a “Graphical User Interface (GUI), for display of information and solicitation of consumer input/instruction.” Ex. 1003, 6:40–42. To control video playback on video device 218, “control device [212] generates URLs, which pass parameters to a CGI application running under the HTTP server on the video device.” *Id.* at 6:43–47. The parameters include a URL (MediaURL) that points to the video to be displayed, and an IP address (VideoDevice) identifying the video device 218 on which the video is to be displayed. *Id.* at 6:49–54.

Figures 4 and 7 of Chen are reproduced below.

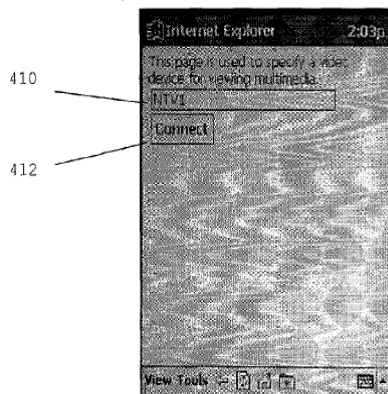


Figure 4



Figure 7

Figure 4 of Chen is an illustration of a GUI (graphical user interface) that allows a user to select a video device on which video data is to be displayed. *Id.* at 7:4–5. Figure 7 of Chen is an illustration of a GUI that allows a user to select a video from a list of displayed videos. *Id.* at 7:60–8:10. The GUI shown in Figure 4 of Chen includes “an input field 410 for the consumer to specify the video device that is to be controlled,” and a connection button 412 that “instructs the control device that the video device indicated in the

input field is to be provided video data.” *Id.* at 7:5–11. Input field 410 can be “a list of all available video devices to which the consumer has access.” *Id.* at 7:13–15. The list can be “a predetermined list of device names maintained on a server” or a list of device names discovered using a discovery protocol such as Address Resolution Protocol (ARP). *Id.* at 7:15–17, 7:23–25. In addition, the list can include “names entered by the consumer” or previously selected by the consumer. *Id.* at 7:18–20.

2. Overview of Elabbady (Ex. 1004)

Elabbady discloses “methods and systems for sharing media content between various devices.” Ex. 1004, 1:14–17. Figure 2A of Elabbady is reproduced below.

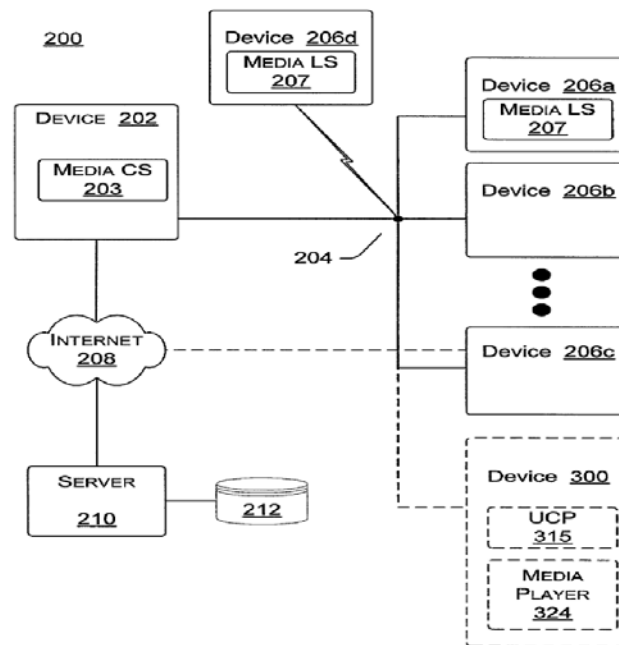


Figure 2A of Elabbady is a block diagram of a media content sharing environment having a plurality of networked devices including one device configured to provide a media catalog service (CS) and other devices configured to provide media library services (LS). *Id.* at 2:36–40.

Device 202 provides a media catalog service 203 to devices 206a-d over network 204. Ex. 1004, 5:24–29. Network 204 can be established using “a Universal Plug-and-Play (UPnP) protocol that provides a peer-to-peer network capability that can support various devices through wired and/or wireless connections.” *Id.* at 5:54–58. Devices 202 and 206a-d can be any devices capable of sharing media content, including PCs, laptops, desktops, notebooks, tablets, PDAs, digital TVs, DVDs, and set-top boxes. *Id.* at 3:23–46, 5:66–6:6. Media content refers to “information that may be shared, processed, and/or played or otherwise reproduced,” and includes audio, video, and multimedia data. *Id.* at 6:66–7:5. Any of devices 202 and 206a-d can play media content. *Id.* at 8:57–62.

Devices 202 and 206a-d can also be coupled to media server 210 that includes database 212 of shareable media content. Ex. 1004, 5:32–45. Any of devices 206a-d (e.g., 206a) can query media catalog 203 on device 202, and device 202 will return the URL of a media item responsive to the query to device 206a. *See, e.g., id.* at 9:47–51, 10:11–22. Device 206a can use the URL to get the media item from media server 210. *Id.* at 10:24–38.

3. Reasons to Combine Chen and Elabbady

Petitioner’s challenge to claims 1–5, 16, 18, 24–26, 32–38, 40–42, 49, 51–53, 55, 58, and 59 of the ’183 patent is based on modifying Chen to include several teachings from Elabbady.

First, Petitioner argues that to the extent Chen’s control device 212 (e.g., a PDA) does not teach selecting itself to play a selected video, Elabbady teaches doing so. Pet. 14–15. Relying on its expert, Petitioner argues “[i]t would have been obvious to modify *Chen*’s control device PDA to . . . present encoded video data” as taught by Elabbady, because doing so

would have combined elements and functions “that [were] known and commonly implemented in PDAs at the time.” *Id.* at 15 (citing Ex. 1002 ¶ 45). Petitioner argues modifying Chen in this way would have provided “a more desirable system, one where multiple media browsing devices also have the ability to playback selected data, using devices and functionalities that were well-known at the time.” *Id.* Petitioner further argues a person of ordinary skill in the art would have found it obvious to “modify *Chen*’s control device 212 PDA with *Elabbady*’s first device 202 [PDA] having video data playback capability. . . . because the PDAs in both systems are ordinary, common PDAs, and the implementation of a known function would have been straightforward and predictable.” *Id.* at 15–16.

Second, Petitioner argues that to the extent Chen’s Address Resolution Protocol (ARP) is not a discovery protocol implemented at a layer above an internet protocol (IP) layer, Elabbady teaches using UPnP discovery protocol, which is implemented above the IP layer. Pet. 16–17. Relying on its expert, Petitioner argues it would have been obvious to replace Chen’s ARP-based discovery protocol with Elabbady’s UPnP-based discovery protocol in order “to provide ‘zero-configuration networking’ of *Chen*’s control and video devices.” *Id.* at 17 (citing Ex. 1002 ¶ 49). Petitioner argues modifying Chen in such a manner “would merely replace one technique for identifying available devices—ARP—with another known technique for identifying available devices—UPnP,” and the substitution would have been obvious because it “provides predictable, if not equivalent, results.” *Id.*

Patent Owner argues it would not have been obvious “to modify Chen’s control device 212 with [] Elabbady’s first device 202 because these

two devices are performing completely different and separate functions.”
PO Resp. 18. Patent Owner argues Chen’s control device 212 “selects video data to be played on video device 218,” and Elabbady’s first device 202 “provides a media catalog service 203 which gathers and/or distributes information about media content to other devices.” *Id.*

We are not persuaded by Patent Owner’s arguments, which do not address the specific manner Petitioner has proposed modifying Chen in view of Elabbady. Petitioner has not proposed bodily incorporating the entire functionality of Elabbady’s first device 202 into Chen’s control device 212. Rather, Petitioner has proposed modifying Chen’s control device 212 to allow it to display selected videos on itself, as well as on video devices 218, because “*Elabbady* demonstrates how the PDA control device 212 of *Chen* could be modified to include additional functions of playing videos on the PDA.” Pet. Reply 24. Instead of addressing the merits of Petitioner’s proposed combination, Patent Owner sets forth various alternative combinations of Chen and Elabbady, none of which were proposed by Petitioner, and explains why those combinations are defective. *See* PO Resp. 17–21. As Petitioner correctly notes, Patent Owner’s arguments “fail[] to address the particular combination set forth in the Petition,” and fail to “set forth any evidence or expert testimony to demonstrate why one of ordinary skill in the art would not have modified *Chen* in view of Elabbady in the manner set forth in the Petition.” Pet. Reply 24.

Upon consideration of Petitioner’s proposed combination of Chen and Elabbady and Patent Owner’s arguments against the same, we are persuaded by Petitioner’s reasoning that a person of ordinary skill in the art would have found it obvious to modify Chen based on the teachings of Elabbady in the

manner proposed by Petitioner. *See* Pet. 14–17. In particular, Petitioner has identified familiar elements in Chen and Elabbady that were known in the art, and has proposed combining those known elements according to known methods or substituting those known elements for others known in the field to obtain predictable results. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

4. Comparison of Claims 1–5, 16, 18, 24–26, 32–38, 40–42, 49, 51–53, 55, 58, and 59 to the Combination of Chen and Elabbady

We have reviewed the Petition, Patent Owner’s Response, and Petitioner’s Reply. For the reasons that follow, notwithstanding Patent Owner’s arguments to the contrary, we are persuaded that Petitioner has demonstrated by a preponderance of evidence that claims 1–5, 16, 18, 24–26, 32–38, 40–42, 49, 51–53, 55, 58, and 59 are unpatentable over the combination of Chen and Elabbady.

For example, claim 1 recites a method for use in a second computerized device set configured for wireless communication with a first computerized device set, and requires making available to a user a first user interface that allows the user to select a continuous media content to be presented to the user, wherein the continuous media content includes a set of encoded video data. Ex. 1001, 164:22–32. Petitioner demonstrates how the combination of Chen and Elabbady discloses this limitation. *See* Pet. 9–12, 18–19. Figure 3 of Chen discloses control device 212 (second device) is in communication with video device 218 (first device) over network 216, and that network 216 can be a wireless 802.11b network. Ex. 1003 4:45–58, 5:4–12, Fig. 3. Figure 7 of Chen discloses presenting a first user interface

on control device 212 (second device) to allow a user to select encoded video for presentation to the user. *Id.* at 3:36–38, 7:60–8:10, Fig. 7.

Claim 1 requires making available to the user a second user interface that allows the user to select to have the continuous media content presented on either one of the first or second computerized device sets. Ex. 1001, 164:33–36. Petitioner demonstrates how the combination of Chen and Elabbady discloses this limitation. *See* Pet. 11–12, 14–16, 19–20. Figure 4 of Chen discloses presenting a second user interface on control device 212 (second device) to allow a user to select a video device from among a list of available video devices. *See* Ex. 1003, 7:4–20, Fig. 4. The list includes “*all available video devices* to which the consumer has access.” Ex. 1003, 7:13–20 (emphasis added). Chen’s control device 212 is a video device because it can play videos. *Id.* at 4:47–53. For example, Chen’s control device 212 can be a tablet, laptop, or desktop computer, and Chen’s video device can be the computer’s monitor. *Id.* at 4:59–60, 5:4–7. Moreover, as discussed in § II.E.3, *supra*, Petitioner, relying on the opinion of its expert, persuasively argues that it would have been obvious to modify Chen to allow control device 212 (a PDA) to select itself as the video device on which to play selected videos because Elabbady teaches selecting and playing videos on a PDA. *See* Pet. 14–16; Ex. 1002 ¶¶ 43–46.

Claim 1 requires receiving discovery information from a device management discovery protocol implemented at a communication layer above the IP layer that allows the second computerized device set to determine that the first computerized device set is capable of receiving and playing the continuous media content. Ex. 1001, 164:37–45. The ’183 patent discloses the discovery management protocol can be, for example,

UPnP protocol. *Id.* at 37:35–55. Petitioner demonstrates how the combination of Chen and Elabbady discloses this limitation. *See* Pet. 16–17, 20–21. Chen discloses using an ARP-like discovery protocol to discover all networked video devices capable of playing selected videos. Ex. 1003, 7:23–25. Elabbady discloses using UPnP protocol to discover all networked devices 202 and 206a-d capable of playing selected videos. Ex. 1004, 5:24–31, 5:46–65. Petitioner’s expert, Dr. Weissman, declares UPnP protocol is implemented at a communication layer above the IP layer. Ex. 1002 ¶ 48. Dr. Weissman’s opinion is consistent with Elabbady’s disclosure that UPnP “leverages” TCP/IP protocol, implying UPnP is implemented above and uses IP protocol. *Id.* at 5:58–60. As discussed in § II.E.3, *supra*, Petitioner, relying on the opinion of its expert, persuasively argues that it would have been obvious to modify Chen by replacing Chen’s ARP-based discovery protocol with Elabbady’s UPnP-based discovery protocol because the modification would have been a simple substitution of one known device discovery technique for another to achieve a predictable result of zero-configuration networking. *See* Pet. 16–17; Ex. 1002 ¶¶ 47–49.

Claim 1 requires decoding the continuous media content for presentation on the second computerized device set when the user selects the second media device set using the second user interface. Ex. 1001, 164:46–51. Petitioner demonstrates how the combination of Chen and Elabbady discloses this limitation. *See* Pet. 11–12, 21–22. Chen discloses playing a selected video on a video device selected from a list of video devices. Ex. 1003, Fig. 4. The list includes “*all available video devices to which the consumer has access.*” *Id.* at 7:13–20 (emphasis added). Chen’s control device 212 is a video device because it can play videos. *Id.* at 4:47–53. For

example, Chen's control device 212 can be a tablet, laptop, or desktop computer, and Chen's video device can be the computer's monitor. *Id.* at 4:59–60, 5:4–7. Moreover, as discussed in § II.E.3, *supra*, Petitioner, relying on the opinion of its expert, persuasively argues that it would have been obvious to modify Chen to allow control device 212 (a PDA) to select itself as the video device on which to play selected videos because Elabbady teaches selecting and playing videos on a PDA. *See* Pet. 14–16; Ex. 1002 ¶¶ 43–46. Chen discloses video devices, such as control device 212, “can decode compressed digital video data.” *Id.* at 5:5–6.

Claim 1 requires wirelessly transmitting a resource indicator, comprising at least one of a URL, URI, and URN, from the second computerized device set to the first computerized device set when the user selects, via the second user interface, presenting the continuous media content on the first computerized device set. Ex. 1001, 164:52–62. Petitioner demonstrates how the combination of Chen and Elabbady discloses this limitation. *See* Pet. 12–14, 22–23. Chen discloses control device 212 and video devices 218 use wireless communication protocols to communicate over network 216, and control device 212 initiates video playback on a selected video device 218 by “generat[ing] URLs, which pass parameters to a CGI application running under the HTTP server on the [selected] video device.” *See* Ex. 1003, 4:55–58, 5:9–10, 6:43–54, 8:21–25.

Claim 1 requires not presenting the continuous media content on the second computerized device set during presentation on the first computerized device set. Ex. 1001, 164:63–65. Petitioner demonstrates how the combination of Chen and Elabbady discloses this limitation. *See* Pet. 14. For example, Chen discloses that when video is being presented on

video device 218 (first device), a user interface for soliciting user input to control video playback is presented on control device 212 (second device). Ex. 1003, 6:40–43. The user interface can include icons for playing, pausing, or stopping the video on video device 218 (first device), or for increasing, decreasing, or muting the volume of sound produced by video device 218. *Id.* at 6:58–67.

Finally, claim 1 requires the first user interface and the second user interface to comprise a unified media selection and presentation user interface presenting user input controls for selection of the continuous media content and for selection of either one of the first or second computerized device sets for presentation of the continuous media content. Ex. 1001, 164:65–165:6. Petitioner demonstrates how the combination of Chen and Elabbady discloses this limitation. *See* Pet. 12, 23. As discussed *supra*, Figure 7 of Chen discloses presenting a first user interface on control device 212 (second device) to allow a user to select an encoded video, and Figure 4 of Chen discloses presenting a second user interface on control device 212 to allow a user to select a video device from among a list of video devices. *See* Ex. 1003, 3:36–38, 7:4–20, 7:60–8:10, Figs. 4, 7. The list includes “*all video devices to which the consumer has access,*” and Chen’s control device 212 is a video device because it can play videos. *Id.* at 4:47–53, 7:13–20. Thus, Chen discloses that together, the user interfaces shown in Figures 4 and 7 present controls for selecting continuous media content and a continuous media content presentation device. *See* Ex. 2003, 5:58–62, 6:38–43, 7:4–11, 8:7–10, Figs. 4, 7, 8. The user interfaces shown in Figures 4 and 7 of Chen, therefore, comprise a unified media selection and presentation user interface. *See* § II.B, *supra*.

Like claim 1 discussed above, based upon our review of the Petition, Patent Owner's Response, and Petitioner's Reply, and notwithstanding Patent Owner's arguments to the contrary, we are persuaded that Petitioner has demonstrated by a preponderance of evidence that claims 2–5, 16, 18, 24–26, 32–38, 40–42, 49, 51–53, 55, 58, and 59 are unpatentable over the combination of Chen and Elabbady, for the reasons presented by Petitioner. *See* Pet. 9–37.

Patent Owner argues claims 1–5, 16, 18, 24–26, 32–38, 40–42, 49, 51–53, 55, 58, and 59 are patentable over the combination of Chen and Elabbady because the combination “lack[s] the ‘second user interface’ and neither [reference] enable[s] any of the ‘video data’ . . . to be presented on a ‘second computerized device set.’” PO. Resp. 4. Patent Owner's arguments are specifically directed to the patentability of independent claim 1. *Id.* at 5–22. Patent Owner does not dispute that Petitioner has shown, by a preponderance of evidence, how the prior art discloses the limitations recited in dependent claims 2–5, 16, 18, 24–26, 32–38, 40–42, 49, 51–53, and 55. Instead, Patent Owner argues that these claims, as well as independent claims 58 and 59, are patentable for the same reasons as claim 1. *Id.* at 22–23.

Patent Owner's argument for the patentability of claim 1 is based on a distinction Chen makes between “video data” and “multimedia data.” PO Resp. 5–6. In particular, because Chen identifies “video data” as data used to display video source material and “multimedia data” as data based on the content of video data, such as preview videos, Patent Owner argues the combination of Chen and Elabbady lacks a second user interface because Figure 4 of Chen can only be used “to select ‘video data’ to be played back

on an *external or separate video device 218*,” and cannot be used to select “video data” to be played back on control device 212. *Id.* at 11–12 (emphasis added); *see also* Ex. 1003, 3:19–29.

Patent Owner advances four reasons why Figure 4 of Chen cannot be used to select “video data” to be played back control device 212. First, Patent Owner argues “Chen describes that control device 212 is only capable of displaying **multimedia data** and ‘preview videos’, never **video data**.” PO Resp. 15 (citing Ex. 1003, 5:4–13, 5:58–62, 6:18–21) (emphases in original). Second, Patent Owner argues control device 212 is not a “video device” because Chen teaches “video device 218 and control device 212 are two separate and distinct parts and are not interchangeable.” *Id.* (citing Ex. 1003, 4:47–5:13, 6:11–37, Figs. 2–3). Third, Patent Owner argues the “connect” button 412 shown in Figure 4 of Chen requires control device 212 to control a separate video device because to “connect” means “to join (two or more things) together.” *Id.* (citing Ex. 2004). Fourth, Patent Owner argues Chen “explicitly states that the control device 212 is to be used to play ‘video data’ on a ‘separate device.’” *Id.* at 16 (citing Ex. 1003, 9:12–18).

We address each of Patent Owner’s arguments below, and explain why we do not find them persuasive. As an initial matter, however, we note that Patent Owner does not cite to any expert testimony explaining how one of ordinary skill in the art would have understood Chen’s disclosure. Consequently, Patent Owner’s interpretation of what Chen does and does not disclose is little more than attorney argument having marginal probative value. *See Johnston v. IVAC Corp.*, 885 F.2d 1574, 1581 (Fed. Cir. 1989) (“Attorney’s argument is no substitute for evidence.”); *In re Pearson*, 494

F.2d 1399, 1405 (CCPA 1974). Moreover, Patent Owner's arguments are limited to alleging deficiencies in Chen, rather than deficiencies in the specific combination of Chen and Elabbady proposed by Petitioner. Consequently, because "[n]on-obviousness cannot be established by attacking references individually where the [challenge] is based upon the teachings of a combination of references," Patent Owner's argument are of marginal probative value for this reason as well. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (internal citation omitted)).

Turning now to Patent Owner's first argument, we disagree that Chen discloses control device 212 is only capable of playing multimedia data, and not video data. The portions of Chen cited by Patent Owner to support this argument are silent as to whether control device 212 is or is not capable of displaying video data. See PO Resp. 15; Ex. 1003 5:4–13, 5:58–62, 6:18–21. Moreover, as Patent Owner acknowledges, Chen's control device 212 is *capable of displaying* preview videos, and Patent Owner cites no evidence suggesting that a device that is capable of displaying preview videos would be incapable of displaying videos. See P.O. Resp. 7–8; Ex. 1003 4:50–53. Consequently, we find Patent Owner's first argument unconvincing.

Regarding Patent Owner's second argument, we disagree that Chen teaches control device 212 and video devices 218 *must be* separate and distinct devices. For example, although Chen discloses that control device 212 and video devices 218 are separate and distinct devices in network 216, Chen describes network 216 as an *exemplary* network configuration rather than a mandatory network configuration. See Ex. 1003, 2:26–29, Figs. 2–3. Moreover, Chen teaches control device 212 and video device 218 can be integrated. For example, Chen teaches the control device can be a *laptop*

computer and the video device can be a *computer monitor*. *Id.* at 4:59–63, 5:4–7. A laptop computer and its monitor represent an integrated control device 212 and video device 218. We also reiterate that Patent Owner’s arguments are based on the teachings of Chen alone, rather than the combined teachings of Chen and Elabbady. As Patent Owner admits, however, Elabbady teaches that it was known to those skilled in the art at the time that the functionality of Chen’s control device 212 and video device 218 could have been combined into a single device:

In essence, the functionality of Chen’s control device 212 and video device 218 are combined into **a single device 300** of Elabbady. In other words, the ability to select a video (on the control device 212 in Chen) and the ability to watch encoded video data (on the video device 218 in Chen), is performed **by the same device 300**.

PO Resp. 19 (emphases in original). Consequently, we find Patent Owner’s second argument unconvincing.

Regarding Patent Owner’s third argument, we first note that Chen labels control 412 in Figure 4 a “connection” button rather than a “connect” button as Patent Owner contends. *See* PO Resp. 15; Ex. 1003, 7:9–11. Regardless, because Chen discloses the function performed by connection button 412, we need not resort to dictionary definitions to understand that function. Chen discloses that, when selected, connection button 412 “instructs the control device that the video device indicated in the input field is to be provided video data.” Ex. 1003, 7:9–11. The video device indicated in the input field is selected from “a list of *all available video devices* to which the consumer has access.” *Id.* at 7:4–7, 13–15 (emphasis added). As noted *supra*, Chen’s control device 212 is a video device because it is

capable of playing video. *Id.* at 4:47–53. Moreover, Chen discloses control device 212 can be a laptop computer, and video device 218 can be a computer monitor. *Id.* at 4:59–63, 5:4–7. Thus, the video device indicated in the input field can be the monitor or display of the laptop computer, and selecting “connection button **412**” can simply instruct the laptop to output a selected video to the laptop’s display. Consequently, we find Patent Owner’s third argument unconvincing.

Regarding Patent Owner’s fourth argument, we agree with Patent Owner that Chen discloses its invention “finds application in self-contained home entertainment system[s] . . . where a consumer uses a control device to find/select video or multimedia content to be delivered to a separate device.” Ex. 1003, 9:12–18. This disclosure, however, does not teach away from modifying Chen in the manner proposed by Petitioner, so that Chen’s modified system finds application in a home entertainment system in which Chen’s modified control device 212 (a PDA) selects multimedia content to be displayed, and then either selects itself as the video device on which to display the selected content (as taught by Elabbady) or selects a separate video device on which to display the selected content (as taught by Chen). To teach away, Chen must criticize, discredit, or otherwise discourage the modification of Chen proposed by Petitioner, and nothing in Chen does so. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Consequently, we find Patent Owner’s fourth argument unconvincing.

III. CONCLUSION

For the reasons discussed above, we find Petitioner has demonstrated, by a preponderance of the evidence, that claims 1–5, 16, 18, 24–26, 32–38,

40–42, 49, 51–53, 55, 58, and 59 of the '183 patent are unpatentable over Chen and Elabbady under 35 U.S.C. § 103(a). Moreover, pursuant to Patent Owner's request for cancellation, we enter adverse judgment against claims 60 and 61.

IV. ORDER

It is ORDERED that adverse judgment is entered against claims 60 and 61 of the '183 patent;

FURTHER ORDERED that claims 1–5, 16, 18, 24–26, 32–38, 40–42, 49, 51–53, 55, 58, and 59 of the '183 patent are unpatentable; and

FURTHER ORDERED that, because this Decision is final, a party to the proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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