UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

WILDSEED MOBILE LLC,
Patent Owner

Case IPR2023-00245
U.S. Patent No. 10,959,040

PATENT OWNER PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107(a)

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Patent Trial and Appeal Board
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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	File History of U.S. Patent No. 9,161,960
2002	Case No. 3:22-cv-04928, Plaintiff Wildseed Mobile, LLC'S Patent L.R. 3-1 Disclosure of Asserted Claims and Infringement Contentions
2003	U.S. Patent No. 10,959,040 Invalidity Contentions
2004	File History of U.S. Patent No. 10,251,021

I. INTRODUCTION

The Board should deny institution of *inter partes* review of claims 1-20 of U.S. Patent No. 10,959,040 ("the '040 patent") for three reasons. First, the Petition advances three- and four-reference combinations that rely on declaration testimony from Petitioner's proffered expert, Dr. Houh. But Dr. Houh's opinions should not be given any weight because (1) he does not qualify as a person of ordinary skill in the art under Petitioner's own definition, and (2) his opinions on key issues repeat—often *verbatim*—the conclusory arguments presented in the Petition. Because Petitioner relies on Dr. Houh's testimony throughout the Petition, every ground of unpatentability lacks evidentiary support from the perspective of a skilled artisan on key issues—such as the teachings of the references and motivations to support the proposed combinations—and thus the Petition fails to demonstrate a reasonable likelihood of prevailing on any ground.

Second, Petitioner relies on combinations of references which do not disclose or render obvious at least two limitations of the independent claims of the '040 patent. With respect to one of these limitations—"infer one or more entertainment preferences of a user of a mobile device based on retrieved information about media accessed by the mobile device and a plurality of media content types of the media, the plurality of media content types including textual media, image media, audio media, and video media"—the Petition ignores the

requirement to base the inference of user preferences on a *plurality* of media content types. None of the references cited for this limitation teach it. The Petition's cited art also fails to disclose, teach, or suggest another independent claim limitation: a server that determines, infers, or receives user location information or a portable media player device that transmits its location to a server. Compounding these deficiencies, the Petition impermissibly combines embodiments from a cited reference without explanation. Petitioner also does not provide any reason at all why the claim would have been obvious despite the missing teachings. The Petition therefore fails to demonstrate a reasonable likelihood of prevailing on any challenged claim.

Third, the Board should deny institution under the Board's precedential *Fintiv* decision in view of resources already expended in the parallel litigation. Rather than diligently preparing and filing its Petition, as Petitioner asserts, Petitioner waited until just one day before the one-year § 315(b) deadline. As a result, the parties have already served infringement and invalidity contentions, proposed claim constructions, and are proceeding with discovery. Each of the references relied on in the Petition is also cited in the invalidity contentions in the parallel proceeding. And Petitioner has not provided a *Sotera* or *Sand* stipulation. For at least these reasons, the Board should deny institution.

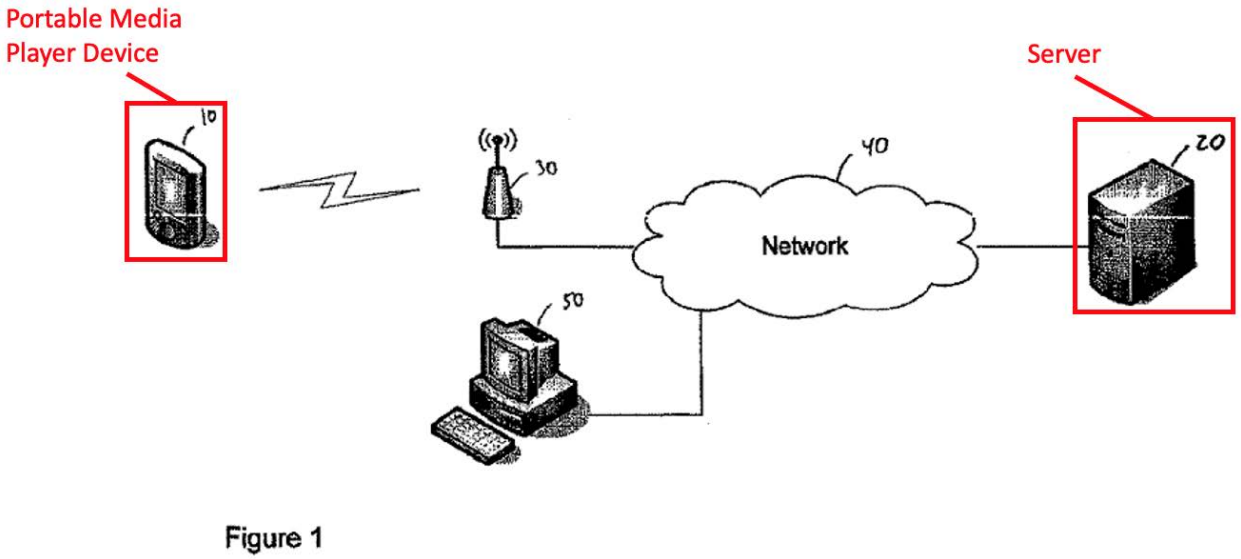
II. THE ’040 PATENT

A. Summary

The ’040 patent, titled “Venue and Event Recommendations for A User of A Portable Media Player Device,” issued on March 23, 2021. The ’040 patent is a continuation of U.S. Patent No. 10,251,021 (“the ’021 patent”), which is a continuation of U.S. Patent No. 9,141,960 (“the ’960 patent”). The ’040 patent claims priority to the ’960 patent, which was filed on June 23, 2008, and U.S. Provisional Application No. 60/945,677, filed on June 22, 2007. EX1001, [45], [54], [60], [63].

The ’040 patent notes that “[w]ith the advance of storage technology, the amount of media that can be stored in a portable media player device has grown exponentially.” *Id.*, 1:50-53. Additionally, “with the advance of telecommunications and networking technology, the number of sites offering media and other media-rich environments to provide new and/or replacement media content for portable media player devices have also grown exponentially.” *Id.*, 1:53-57.

The ’040 patent “relates to venue or event recommendations for a user of a portable media player device.” *Id.*, 1:20-22. The ’040 patent describes a server that transmits the venue or event recommendations to the portable media player device. *Id.*, 3:58-4:19.



EX1001, FIG. 1 (annotated).

The server infers the preferences of the user of a portable media player device based on an analysis of a wide variety of media types, such as "music, podcasts, books or audiobooks, video, photos or other images." EX1001, 5:36-42. The current location of the user of the portable media player device is also inferred. *Id.*, 4:25-28. The server transmits venue or event recommendations based on the user's inferred preferences and current location. *Id.*, 4:28-40. Figure 2 illustrates the role of the server in determining the location and entertainment preferences of the user, and generating a recommendation for a venue or event.

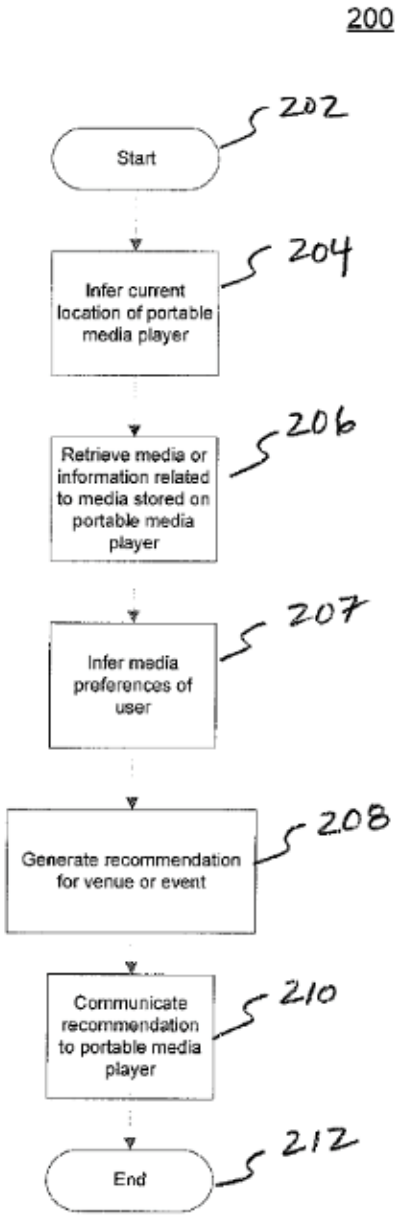


FIGURE 2

EX1001, FIG. 2.

B. Prosecution History

As noted above, the ’040 patent is a continuation of the ’021 patent, which in turn is a continuation of the ’960 patent. Relevant portions of the prosecution

histories of each of the ’040 patent, the ’021 patent, and the ’960 patent are discussed below.

1. ’040 Patent Prosecution History

The application that issued as the ’040 patent was rejected by the Examiner on the ground of nonstatutory double patenting over the claims of the grandparent ’960 patent. Additionally, the Examiner rejected most of the claims as allegedly being obvious over Spiegelman and Baudino. EX1002, 159-185.

In response, the Applicant cancelled all pending claims and presented new claims. *Id.*, 122-128. The Examiner rejected these new claims only on the ground of nonstatutory double patenting over the claims of the grandparent ’960 patent and the parent ’021 patent. *Id.*, 100-109.

After the Applicant filed a terminal disclaimer, *id.*, 86-92, the Examiner allowed the claims, *id.*, 34-42.

2. ’021 Patent Prosecution History

The prosecution history of the ’021 patent provides guidance as to the meaning and scope of the challenged claims of the ’040 patent.

After filing the application that became the ’021 patent, the Applicant filed a preliminary amendment, cancelling the original claims and adding new claims, including claim 21, which issued as claim 1. EX2004, 0255-0260. Claim 21 included a limitation requiring the server to infer the entertainment preferences of the user of the media player device based at least in part on the retrieved plurality of media or retrieved information about said plurality of media:

> infer, based at least in part on the retrieved plurality of media or the retrieved information about said plurality of media, one or more entertainment preferences of a user of the media player device;

Id., 256.

After a double patenting rejection over the parent ’960 patent, the Applicant filed a terminal disclaimer. *Id.*, 0231-0237, 0215-0216. The Examiner then rejected claim 21 as anticipated by the Spiegelman reference. *Id.*, 0177-0194, 0196.

The Applicant amended claim 21 to require the server to infer the user’s entertainment preferences based at least in part on the type of media stored on, or accessed by, the portable media player device:

> infer, based at least in part on the retrieved ~~plurality of~~ media, ~~or~~ the retrieved information about ~~said plurality of~~the media, and one or more plurality of media types of the media stored on or accessed by the portable media player device, one or more entertainment preferences of a user of the ~~media player~~portable media player device;

Id., 0164.

The Applicant also amended dependent claim 22 to identify the plurality of media types used to infer the user's entertainment preferences:

> 22. (Currently Amended) The one or more NTCRM~~non-transitory computer-readable media~~ of claim 21, wherein the plurality of media types comprises textual media, image media, music media, podcast media, and video media ~~generate a recommendation comprises generate a recommendation based at least in part on a genre of music played at the venue or event of interest and on a music genre preference of the user inferred by the computer server based at least in part on music media stored in, or accessed using, the media player device~~.

Id.

The Applicant argued that Spiegelman did not disclose "that the event recommendations are based on the type of media accessed or stored by the consumer." *Id.*, 0172.

The Examiner agreed that the amendment overcame Spiegelman, but rejected the amended claims 21 and 22 over the combination of Spiegelman and Martin. *Id.*, 0143-0159.

The Applicant responded by arguing that, while Martin discloses performing "taste analysis," it does not disclose basing recommendations on the type of media accessed by the user. *Id.*, 0120-0121.

The Applicant then amended claim 21 to require *more than one* media content type:

infer one or more entertainment preferences of a user of the portable media player device, based at least in part on the retrieved media, the retrieved information about the media, and ~~one or more~~a plurality of media content types of the media stored on or accessed by the portable media player device~~, one or more entertainment preferences of a user of the portable media player device~~;

Id., 0093.

The Applicant further clarified, when distinguishing Martin, that claim 21 requires determining a user's preferences for more than one type of media. In contrast, "*Martin* is only concerned with identifying a user's taste (i.e., preference for a particular genre) for one type of content (e.g., audio/music)." *Id.*, 0101. The Applicant also distinguished Martin on the basis that claim 21 requires the server to rely on a plurality of media content types for determining the user's preferences: "There is no focused and specific examples within Martin that utilize a plurality of media content types stored or accessed by a user for recommending mediasets to the user or group of users." *Id.*, 0101.

The Examiner agreed that the Applicant's arguments overcame the Spiegelman-Martin combination, but rejected claims 21 and 22 over the combination of Spiegelman, Baudino, and Martin. *Id.*, 0065-0080.

The Applicant responded by amending claim 21 to include *all four* of the specific media types (*i.e.*, textual, image, audio, and video media) used to infer the user's entertainment preferences from claim 22:

> infer one or more entertainment preferences of a user of the portable media player device based at least in part on the retrieved media, the retrieved information about the media, and a plurality of media content types of the media stored on or accessed by the portable media player device, wherein the plurality of media content types comprises textual media, image media, audio media, and video media;

Id., 0051.

The Applicant argued that Martin merely discusses that "pictures and e-books could be a type of 'media item,'" but there was no explanation of "how pictures or e-books as being a type of media item as discussed by Martin would be utilized by the event recommendation system of Spiegelman as modified by *Baudino*." *Id.*, 0060. Thus, the Examiner's combination was flawed.

The Examiner agreed with the Applicant's argument and allowed the claims, with claim 21 issuing as claim 1. *Id.*, 0034-0039, 0045-0046.

3. '960 Patent Prosecution History

The prosecution history of the '960 patent also provides guidance as to the meaning and scope of the challenged claims of the '021 patent.

Claim 1 of the originally filed application that led to the '960 patent included a limitation requiring a server to infer a media preference of a user:

> wherein the recommendation is based at least in part on the . . . inferred media preference of a user of the portable media player device, *wherein the inferred media preference is determined based at least in part on media stored on or accessed* using the portable media player device.

EX2001, 0018. The initial version of claim 1 did not require basing the inference of the user's preferences on more than one type of media. *Ibid.*

After a rejection by the Examiner, the Applicant amended claim 1:

> inferring, by the server, based at least in part on the retrieved one or more of media or media-associated meta data, one or more entertainment preferences of a user of the portable media player device;

Id., 0077. The amended claim 1 did not yet require basing the inference of a user's entertainment preferences on more than one of media or media-associated metadata.

After another rejection, however, the Applicant further amended claim 1 to require basing the inferred entertainment preferences of the user on a *plurality* of media or retrieved information about said *plurality* of media.

> inferring, by the server, based at least in part on the retrieved ~~one or more of~~ plurality of media or the retrieved information about said plurality of media~~media-associated meta data~~, one or more entertainment preferences of a user of the portable media player device;

Id., 0119.

Further, in distinguishing the Ng reference cited by the Examiner, Applicant argued that entering user preference information does not satisfy the *inferring* portion of this claim limitation: "Thus, Ng teaches that a user 'preference' is either entered by the user of the device . . . or is *inferred based on the user's location . . .*" *Id.*, 0131 (emphasis in original).

After further rejections (but no further amendment to this limitation) and an appeal to the Board, in which the Board agreed with Applicant's claim interpretation, *see id.*, 0223-0224, claim 1 of the '960 patent issued with this language.

C. Person of Ordinary Skill in the Art (POSITA)

"[T]he level of skill in the art is a prism or lens through which … the Board views the prior art and the claimed invention." *Okajima v. Bourdeau*, 261 F.3d 1350, 1354-55 (Fed. Cir. 2001). "This reference point prevents these factfinders from using their own insight or, worse yet, hindsight, to gauge obviousness." *Id*.

Petitioner and Dr. Houh allege that a POSITA "would have been knowledgeable with the field of portable devices and venue or event recommendations," and had some experience (depending upon level of formal education) "working in the field." Pet., 13; EX1003, ¶20. The '040 patent's disclosure and claims support the proposition that a POSITA would have these qualifications and specific experience, beginning with the title: "Venue and Event Recommendations for A User of a Portable Media Player Device." EX1001, [54]; *see also id*., Abstract ("A method and system for generating by a server, a recommendation for a venue or an event of interest proximally located to an inferred current location of a user of a portable media player device."). Claim 1, for example, recites a "mobile device" and "generat[ing] a recommendation message

indicating the identified venue or event" as a venue or event "being of interest to the user." EX1001, 8:23, 8:31-32, 8:35-36. Accordingly, at this stage of the proceeding, Patent Owner applies Petitioner's definition of a POSITA, including the requirement that a POSITA "would have been knowledgeable with the field of portable devices and venue or event recommendations," and had some experience (depending upon level of formal education) "working in the field." Pet., 13; EX1003, ¶20. Patent Owner, however, reserves the right to dispute other aspects of Petitioner's definition of a POSITA or to advance a definition requiring different or additional qualifications.

As explained below, Petitioner's expert, Dr. Houh, does not have the specific experience required under Petitioner's own definition of a POSITA for the '040 patent, and thus the Board should not credit any of his opinions rendered from the perspective of a POSITA.

D. Claim Construction

Patent Owner agrees with Petitioner that the terms of the challenged claims should be given their plain and ordinary meaning. Pet., 13-14. Further discussion regarding the plain meaning of certain claim limitations is relevant to resolving the parties' dispute. In particular, claim 1 recites a server with processor circuitry arranged to "infer one or more entertainment preferences of a user of a mobile device based on retrieved information about media accessed by the mobile device

and a plurality of media content types of the media, the plurality of media content types including textual media, image media, audio media, and video media." EX1001, Claim 1. More specifically, the clause, "*the plurality of media content types including* textual media, image media, audio media, and video media," requires that the inference of the user's entertainment preferences be based on *all* of the enumerated types of media.

Indeed, during prosecution of the application leading to the'021 patent, which is the '040 patent's parent, the Applicant's following statements during prosecution, made to distinguish the Martin reference, disavowed any construction of this "plurality of media content types" language whereby the inference of the user's entertainment preferences is based on only one type of media:

- "Martin is only concerned with identifying a user's taste (i.e., preference for a particular genre) for one type of content (e.g., audio/music)."
- "There is no focused and specific examples within Martin that utilize a plurality of media content types stored or accessed by a user for recommending mediasets to the user or group of users."

EX2004, 101; *see also id.*, 51 (adding limitation: "wherein *the plurality of media content types comprises* textual media, image media, audio media, *and* video media"),[1] 61; *Poly-America, L.P. v. API Indus., Inc.*, 839 F.3d 1131, 1137 (Fed.

[1] Emphasis is added throughout unless otherwise noted.

Cir. 2016) (finding a clear and unmistakable disavowal of claim scope in statements made in response to the examiner's rejection); *see also Advanced Cardiovascular Sys., Inc. v. Medtronic, Inc.*, 265 F.3d 1294, 1305 (Fed. Cir. 2001) ("The prosecution history of a related patent can be relevant if, for example, it addresses a limitation in common with the patent in suit."); *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 980 (Fed. Cir. 1999) ("When multiple patents derive from the same initial application, the prosecution history regarding a claim limitation in any patent that has issued applies with equal force to subsequently issued patents that contain the same claim limitation."). Thus, a POSITA would have understood the plain meaning of this limitation to require that the inference of the user's entertainment preferences be based on all of the enumerated types of media.

Further, during prosecution of the application leading to the grandparent '960 patent, Applicant's statements regarding a similar "inferring" limitation, made to distinguish the Ng reference, disavow any construction of this limitation whereby the user's entertainment preferences are provided or otherwise obtained, rather than inferred as claimed. *See E.I. du Pont De Nemours & Co. v. Unifrax I LLC*, 921 F.3d 1060, 1070 (Fed. Cir. 2019) ("When a parent application includes statements involving 'common subject matter' with the terms at issue, those statements are relevant to construction of the terms in the child patent."); *Ormco Corp. v. Align Technology, Inc.*, 498 F.3d 1307, 1314 (Fed. Cir. 2007) ("When the

application of prosecution disclaimer involves statements from prosecution of a familial patent relating to the same subject matter as the claim language at issue in the patent being construed, those statements in the familial application are relevant in construing the claims at issue."); *Omega Eng'r, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1333 (Fed. Cir. 2003) ("[P]rosecution disclaimer may arise from disavowals made during the prosecution of ancestor patent applications."). For example, by distinguishing the Ng reference by stating, "Ng teaches that a user 'preference' is either entered by the user of the device . . . or is inferred based on the user's location," the Applicant made a clear disavowal of claim scope that covers the user providing user preference information. EX2001, 0131. And even if not a clear disavowal, the Applicant's arguments inform the meaning of this term.

The above claim construction also applies to independent claims 10 and 17, which the Petition acknowledges include substantially similar limitations. Pet., 53, 59.

III. THE BOARD SHOULD NOT CREDIT DR. HOUH'S OPINIONS BECAUSE HE IS NOT A POSITA AND KEY PORTIONS OF HIS DECLARATION MERELY REPEAT THE PETITION.

The Board should not credit the declaration testimony of Petitioner's proffered expert, Dr. Houh, because (1) Dr. Houh does not meet Petitioner's own definition of a POSITA—his declaration and CV confirm that he lacks the specific experience required under Petitioner's definition; and (2) key portions of his

declaration—such as the proffered motivations to combine the references in Petitioner's three- and four-reference combinations—repeat, often *verbatim*, the arguments in the Petition.

This fatal flaw infects the entire Petition. The Petition advances three grounds of unpatentability, each of which is based on three- or four-reference combinations. Pet., 20. Petitioner relies on Dr. Houh's opinions from the perspective of a POSITA throughout the Petition to, for example, purportedly explain the teachings of the references, motivations to combine the references, and why a POSITA would have reasonably expected success in making the proposed combinations. *See generally* Pet. But because Dr. Houh is not a POSITA and key portions of his declaration merely repeat the arguments in the Petition, his opinions are neither relevant nor reliable and should not be given any weight.

A. Dr. Houh lacks the specific experience required under Petitioner's own definition of a POSITA, and thus the Board should not credit his opinions from the perspective of a POSITA.

"To offer expert testimony from the perspective of a skilled artisan in a patent case—like for claim construction, validity, or infringement—a witness must at least have ordinary skill in the art." *Kyocera Senco Industrial Tools Inc. v. Int'l Trade Commission*, 22 F.4th 1369, 1376-77 (Fed. Cir. 2022). "Without that skill, the witness' opinions are neither relevant nor reliable." *Id*.; *see also Avail Medsystems, Inc. v. Teladoc Health, Inc.*, IPR2022-00444, Paper 10 at 22-26, 28-

29, 31 (P.T.A.B. July 21, 2022) (in decision denying institution, according no weight to expert's "testimony from the perspective of a skilled artisan" because the expert lacked the specific experience with teleconferencing systems required under the adopted definition of a skilled artisan); *Incyte Corp. v. Concert Pharmaceuticals, Inc.*, PGR2021-00006, Paper 68 at 8-9 (P.T.A.B. May 11, 2022) (in final written decision, according no weight to expert's opinions "with regard to issues of treating hair loss disorder" because the expert lacked the specific experience with such issues that were required under the adopted definition of a POSITA).

In *Kyocera*, the Federal Circuit held that it was an abuse of discretion to admit any expert testimony from the perspective of a skilled artisan when the expert lacks the specific experience required of such a skilled artisan. *Kyocera,* 22 F.4th at 1375-78. In particular, "[t]he level of ordinary skill in the art" of the patent-at-issue in *Kyocera* "require[d] experience in power *nailer* design." *Id*. at 1377. Although Kyocera's expert had "advanced degrees in engineering and extensive experience in the design and manufacture of fastener driving tools," *id*. at 1376, he lacked the specific experience with power *nailer* design required under the adopted definition of a POSITA, *id*. at 1377. Accordingly, the court held that it was improper to rely on the expert's testimony "on any issue that is analyzed through the lens of an ordinarily skilled artisan." *Id*. at 1377-78.

Like the expert in *Kyocera*, Dr. Houh lacks the specific experience required of a POSITA of the '040 patent, and thus his opinions from the perspective a POSITA should be given no weight. Again, Petitioner and Dr. Houh assert that a POSITA "would have been knowledgeable with the field of portable devices and venue or event recommendations," Pet., 13; EX1003, ¶¶19-21, but Dr. Houh's Declaration and CV do not establish that he has knowledge or familiarity with either (1) portable devices or (2) with venue or event recommendations, *see* EX1003, ¶¶7-18; EX1019. Although Dr. Houh's educational background includes degrees in electrical engineering and computer science, there is no indication that he obtained specific experience with portable devices and with venue or event recommendations during his education. EX1003, ¶8; EX1019, 1.

Nor does Dr. Houh's work experience demonstrate this specific experience. Rather, his work experience includes: (i) working as a teaching assistant in computer architecture courses, EX1003, ¶10; (ii) doctoral research, including design of network components, device drivers, setting up a web server, maintaining networking devices, and study of Ethernet specifications, *id.*, ¶11; (iii) building web pages that initiated video sessions, *id.*, ¶12; (iv) preparing a Ph.D. thesis on the topic of network traffic flows, *id.*, ¶13; (v) starting a company that provided website design services and targeted advertising opportunities, *id.*, ¶14; (vi) designing and implementing software for a business telephone system for

streaming packetized audio over data networks, *id.*, ¶¶15-16; (vii) building a test platform for testing Voice-over-IP, *id.*, ¶17; (viii) founding a company that created speech recognition algorithms and a social network, *id.*, ¶18; and (ix) working as president of a company that provided supplemental science, technology, engineering, and mathematics ("STEM") education to children, *id.*, ¶9.

To be sure, in his CV, Dr. Houh holds himself out as a "[t]echnical consultant specializing in Social Networking, Web 2.0, Web Site Development, Data Networking, Optical Networking, Telecommunications, Media Streaming and Voice Over IP." EX1019, 2. Notwithstanding the breadth of his alleged expertise, neither the experiences described in his declaration nor the experiences listed in his CV demonstrates that Dr. Houh has any experience related to portable devices or to venue or event recommendations, as required under Petitioner's definition of a POSITA. Accordingly, under Petitioner's own definition, Dr. Houh is not a POSITA, and his opinions from the perspective of a POSITA—which are relied upon throughout the Petition—are not entitled to any weight.

B. Key portions of Dr. Houh's declaration repeat—often *verbatim*—the Petition, and thus the Board should not credit those opinions.

"[C]onclusory expert testimony is inadequate to support an obviousness determination . . . ." *TQ Delta, LLC v. Cisco Systems, Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019); *see also In re Magnum Oil Tools International, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016) ("To satisfy its burden of proving obviousness, a

petitioner cannot employ mere conclusory statements."). The Board does not credit declaration testimony that "merely repeats, *verbatim*, the conclusory assertion for which it is offered to support." *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15-16 (P.T.A.B. August 24, 2022) (precedential) (emphasis in original); *see also id*. at 15 ("[T]he cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight."); 37 C.F.R. § 42.65(a).

Key portions of Dr. Houh's declaration repeat—often *verbatim*—the arguments presented in the Petition, and thus are not entitled to any weight. For example, all three of the Petition's grounds of unpatentability rely on combining Sasaki, Ellis, and Jacobi. Pet., 20. Such combinations require the petitioner to demonstrate "that a person of ordinary skill in the art would have been motivated to combine the prior art in the way claimed by the . . . claims at issue and had a reasonable expectation of success in doing so." *Personal Web Technologies, LLC v. Apple, Inc.*, 848 F.3d 987, 991 (Fed. Cir. 2017). Dr. Houh's opinions as to why a POSITA would have allegedly combined and reasonably expected success in combining Sasaki with Ellis and Sasaki-Ellis with Jacobi repeat, without additional support, the conclusory arguments in the Petition. *Compare* Pet., 24-29, *with*

EX1003, ¶¶58-72[2]. Such opinions are entitled to little or no weight, leaving key aspects of Petitioner's challenge supported only by mere attorney argument.

As discussed below, the Petition fails to demonstrate that the Sasaki-Ellis combination teaches or suggests key claim elements and that a POSITA would have been motivated to combine and reasonably expected success in combining Sasaki and Ellis. In addition to the fatal flaws discussed below, the Petition's heavy reliance on Dr. Houh's irrelevant and unreliable opinions warrants denying institution.

IV. THE PETITION FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CHALLENGED CLAIM.

Petitioner's proposed combination of Sasaki and Ellis[3] fails to disclose, teach, or suggest multiple limitations in each of the '040 patent's independent claims. As described below, neither Sasaki nor Ellis teaches relying on a plurality of media content types to infer a user's entertainment preferences. Instead, Ellis discloses a device that pertains only to audio content and teaches away from applying its teachings to other content types, such as video. Sasaki and Ellis also

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[2] The mere reproduction of block quotes from the asserted references in the declaration does not add more than the citation of those paragraphs in the Petition.

[3] Petitioner's asserted ground also relies on Jacobi. Pet., 20. Petitioner, however, does not rely on Jacobi for the limitations discussed herein.

fail to disclose, teach, or suggest a server that determines or receives the location of the user of the portable media player device or a portable media player device that transmits its location to a server. Sasaki discloses only portable terminal devices that send location information to other portable terminal devices, not to a server. And Ellis teaches only a portable device that determines its own location for use locally and does not send it to a server. Further, the Petition impermissibly combines embodiments from Sasaki without explanation.

A. Summaries of the Asserted References

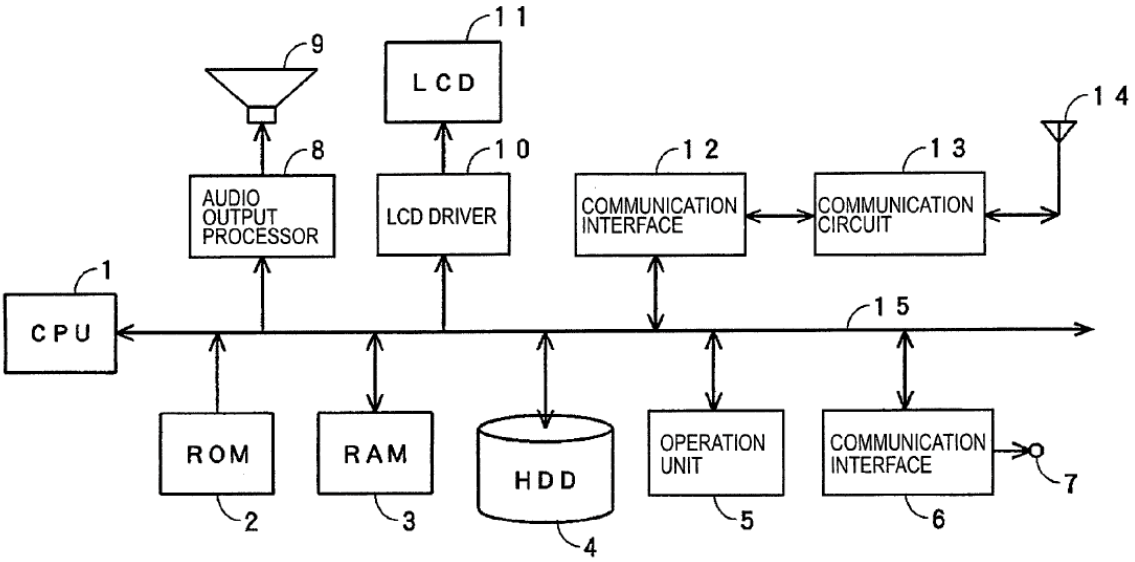
1. Sasaki

Sasaki relates to the transmission of electronic media content recommendations to users of portable media terminals. Sasaki discloses a first embodiment involving the transmission of media content recommendation information from one portable terminal device to another portable terminal device, and a second embodiment involving the transmission of media content recommendation information from a server to a portable terminal device. EX1004, ¶¶0029-0111 (terminal-to-terminal embodiment), ¶¶0112-0130 (server-to-terminal embodiment).

The portable terminal device, illustrated by Figure 1, includes "a central processing unit (CPU) 1, a read-only memory (ROM) 2, a random access memory (RAM) 3, a hard disk drive (HDD) 4, an operation unit 5, a communication

interface 6, a communication terminal 7, an audio output processor 8, a speaker 9, an LCD (liquid crystal display) driver 10, an LCD 11, a communication interface 12, a communication circuit 13, and a transmitting/receiving antenna 14." *Id.*, ¶0029.

FIG. 1



EX1004, FIG. 1.

The portable terminal device can receive "audio data such as music, and image data such as still images and video … and can record and store the audio data and the image data in the HDD 4." EX1004, ¶¶45-47. The server of the server-to-terminal embodiment includes similar components but does not need audio and video playback systems and therefore does not include an audio output processor, speaker, LCD driver, and LCD. *Id.*, ¶0113.

The particular media content recommendation information may be based on preferences of the user receiving the recommendation. *Id.*, ¶¶0083, 0099-0100, 0119. Although preferences are taken into account, in each embodiment, the user preference information is explicitly provided, e.g., registered in the hard disk drive (HDD) of the terminal device or stored beforehand at the server. *Id.*, ¶¶0073, 0126, 0128, 0130.

Sasaki's Figure 3A illustrates the content recommendation data stored "in the transmitting area of the HDD 4," including "information of recommenders' recommendation comments, and locations at which sample data items of recommended content are stored." *Id.*, ¶0066.

FIG. 3A

RECOMMENDATION COMMENT INFORMATION, ETC.	SAMPLE
MANHATTAN! AT DUSK!	NYview.jpg
THIS PIECE OF MUSIC IS THE BEST OF Mike XXXXX, THE SECOND NUMBER OF ALBUM "XXX".	Rocking.mp3

IEX1004, FIG. 3A.

As discussed with respect to Sasaki's Figure 3C, user preference information is explicitly entered into the terminal device: "As shown in FIG. 3C, *by entering*, in the preference information area of the HDD 4, *preference information including content types and preference keywords* of the user of the terminal device, and using the preference information to selectively use pieces of content recommendation

information, only a piece of content recommendation information that matches user's preferences can be obtained." EX1004, ¶0073; *see also id.*, ¶0085 ("[P]reference information . . . is registered in the preference information area of the HDD 4 in [the] terminal device . . . ."). In Sasaki's server-to-terminal embodiment, users update the preference information stored by the server by using a "personal computer at a home to access a service site through a network such as the Internet" or by using "a terminal device such as a cellular phone." *Id.*, ¶0128; *see also id.*, ¶0126 ("[P]reference information . . . [is] stored beforehand . . . ."). There is no disclosure in Sasaki of a server inferring or determining a user's preferences.

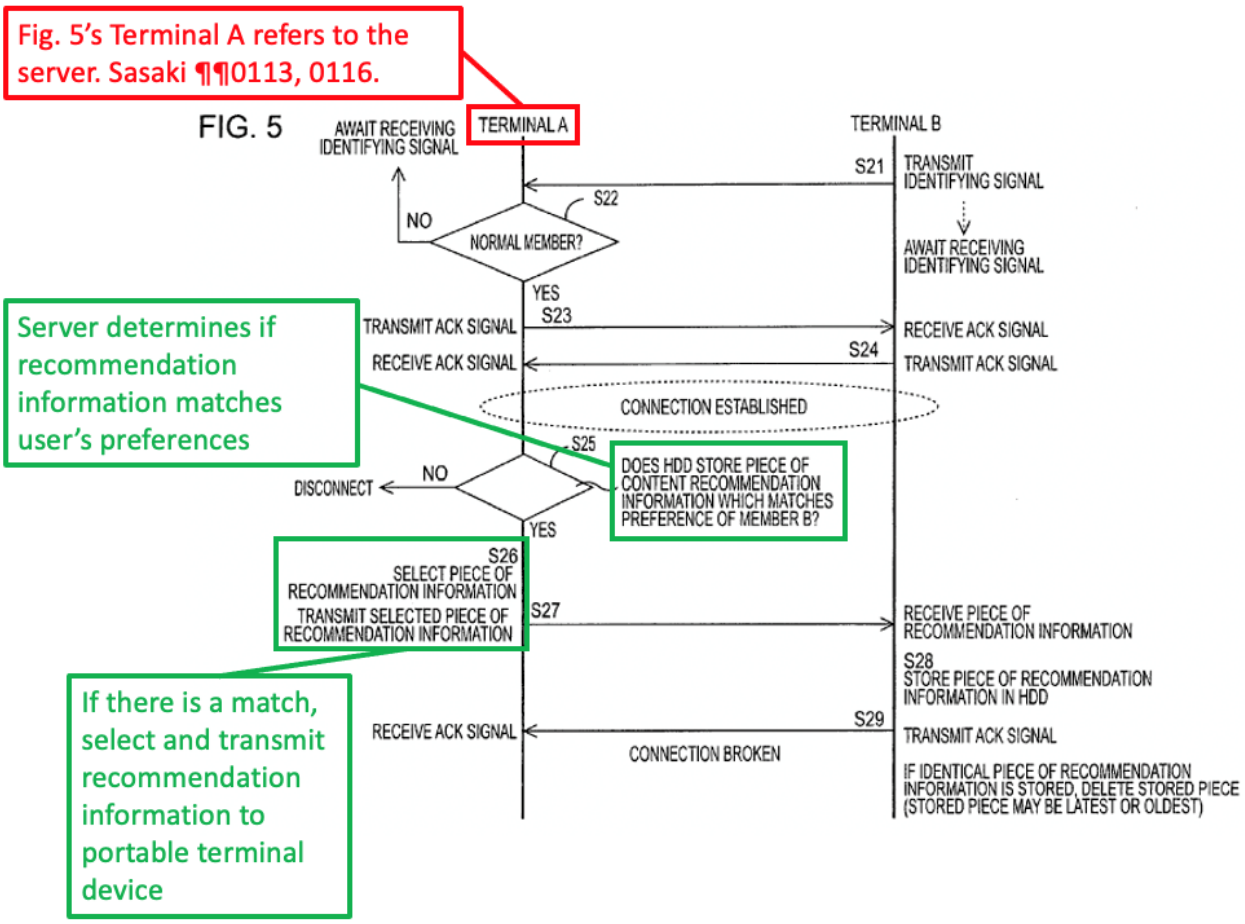
FIG. 3C

CONTENT TYPE	PREFERENCE KEY WORDS
MUSIC	MIKE XXXXX; ROCK; BEATLES; LOVE
PHOTOGRAPH	MOUNT FUJI; NIGHT VIEW; LANDSCAPE; PROSPECT; MOUNTAINS, SEA, SKY; DUSK; SUNSET

IEX1004, FIG. 3C.

Sasaki's Figure 5 depicts the sequence of communications for Sasaki's second (server-to-terminal) embodiment. In this embodiment, "communication is performed between the server [located at a service spot] and terminal device B." EX1004, ¶0113. Sasaki describes a "service spot" as "a predetermined area in which various types of information are provided to users or members"—"such as CD/DVD shops and bookstores, sightseeing areas, attraction places, art museums,

museums, movie theaters, coffee shops, hotel lobbies, and other public facilities"—"and in which a server for providing content recommendation information to terminal devices is installed." *Id.*, ¶0114.



IEX1004, FIG. 5 (annotated).

"At the service spot, the installed server provides content recommendation information to a user's terminal device and the terminal device receives and stores the content recommendation information in the HDD 4 of the terminal device." EX1004, ¶0115. In this regard, "the CPU 1 of the server determines whether or not the HDD 4 of the server stores a piece of content recommendation information

which matches a preference of the member of terminal device B." *Id.*, ¶0119. If there is a match, "the server selects the piece of content recommendation information that matches the preference of the member of the terminal device B, and, in step S27 transmits the selected piece of content recommendation." *Id.*, ¶0120.

Sasaki's discussion of the first (terminal-to-terminal) embodiment describes the transmission of recommendation and location information. But in this embodiment, portable terminal A "determines whether or not any one piece of the content recommendation information [stored in the transmitting area of HDD 4 in terminal device A] matches the one or more preference keywords of preference information from terminal device B," *id.*, ¶0099, and, if there is a match, "transmits the selected piece of content recommendation information to terminal device B," *id.*, ¶0100. Regarding the first embodiment, Sasaki further describes the portable terminal device communicating its location as part of the content recommendation information:

> [T]he content recommendation information to be transmitted does not contain only the information shown in FIG. 3A. Necessary information, such as an owner of a transmitting terminal device, a date and time of transmission, *and a place of transmission*, is added to the content recommendation information . . . .

Id., ¶0068. In other words, the terminal device that is *providing* the recommendation information—namely, terminal device A, which corresponds to

the *server* in the second (server-to-terminal) embodiment—transmits location information. In contrast, in Sasaki's second embodiment (server-to-terminal) the portable terminal device only *receives* recommendation information, so it does not transmit its location.

2. Ellis

Ellis relates to radio systems, including "enhanced radio reception and processing features, utilizing multiple radio receivers, digital storage of radio content, independent control of radio reception and playback, listener profiles, and two-way communication features." EX1005, ¶0002.

According to Ellis, "[r]adio is a very popular entertainment source today." *Id.*, ¶0003. "It is used in many locations-in the home, in the automobile, at the office, and on the go." *Id.* Ellis recognizes, however, that "radio functions have been fairly constant for years." *Id.* Ellis states that "[a] system is needed that allows a radio listener to better control the audio content she hears." *Id.*, ¶0007.

Ellis discloses an "Enhanced Radio System (ERS)," which is a portable device that "may be used at home, at the office, in the shower, on the go, in the car, on the boat, or in any other environment." *Id.*, ¶¶0021, 0024. The ERS "may tune in one or more radio sources, such as broadcast radio, satellite radio, Internet radio, shortwave radio, and radio scanner." *Id.*, ¶0025. The ERS simultaneously stores "content from multiple radio receivers" and allows the user to "quickly select

output from the stored content." *Id.*, ¶0021. The ERS "may … keep track of user radio preferences, and may have the ability to recognize specific content items, such as songs, that the user may like." *Id.*, ¶0185. Although Ellis describes the ability of the ERS to connect to a "central facility," *id.* ¶0265, the only examples of the system determining user listening preferences describe the ERS portable device itself performing the determination. *Id.*, ¶¶0212, 0221.

B. Sasaki and Ellis fail to teach a "server" that "*infer[s]* one or more entertainment preferences of a user of a mobile device based on retrieved information about media accessed by the media device and *a plurality of media content types* of the media, the plurality of media content types including textual media, image media, audio media, and video media."

Claim 1 requires that the server "*infer[s]* one or more entertainment preferences of a user of a mobile device based on retrieved information about media accessed by the media device and *a plurality of media content types* of the media, the plurality of media content types including textual media, image media, audio media, and video media." EX1001, Claim 1. As Petitioner acknowledges, claims 10 and 17 have substantially similar limitations. Pet., 53, 59.

Petitioner relies on the combination of Sasaki and Ellis to argue that this limitation would have been obvious.[4] However, neither Sasaki nor Ellis discloses,

[4] As noted above, Petitioner's asserted ground also relies on Jacobi. Pet., 20. Petitioner, however, also does not rely on Jacobi for the inferring limitation.

teaches, or suggests relying on all of the claimed types of media to infer a user's preferences. In fact, Sasaki does not disclose *inferring* a user's preferences at all. Instead, as discussed above, Sasaki discloses a system where user preferences are explicitly provided. Sasaki explains that "*by entering*, in the preference information area of the HDD 4, *preference information including content types and preference keywords* of the user of the terminal device, and using the preference information to selectively use pieces of content recommendation information, only a piece of content recommendation information that matches user's preferences can be obtained." EX1004, ¶0073; *see id.*, ¶0085. In Sasaki's second (server-to-terminal) embodiment, users update the preference information stored by the server by using a "personal computer at a home to access a service site through a network such as the Internet" or by using "a terminal device such as a cellular phone." *Id.*, ¶0128; *see id.*, ¶0126. However, as discussed above, explicitly providing user preference information, as disclosed in Sasaki, was disavowed during prosecution of the grandparent '960 patent with respect to similar claim language. *Supra* Sections II.B.3, II.D; EX2001, 0131. Therefore, Sasaki does not disclose the inferring limitation.

Ellis discloses a system that only determines a user's preferences for one type of media: radio (i.e., audio) content. The examples cited in the Petition each refer to determining preferences based on what a user has *listened* to:

> The system may also monitor the content *listened to* by the user, and automatically determine the groups liked and disliked . . . .

EX1005, ¶0212.

> The system may also determine user preferences automatically by monitoring what content the user *listens to*.

Id., ¶0185.

> In step 2220, the system may determine user information automatically by monitoring the content the user *listens to*. For example, the system may add points to a specific song, artist, genre, or other type of item or grouping, based on the user *listening to* an entire item.

Id., ¶0221; Pet., 34-35. Nowhere does Ellis disclose, teach, or suggest relying on video, image, or textual content to determine user preferences, let alone relying on all of them in addition to audio content.

Furthermore, the claims require a *server* to infer the user preferences. Ellis instead discloses a portable Enhanced Radio System (ERS) that determines user preference information *locally without the use of a server*. EX1005, ¶¶0212, 0221. Ellis, therefore, does not disclose this limitation. Ellis explains that "[r]adio recommendations might be especially useful to a traveling user who is not familiar with local stations." *Id.*, ¶0044. Therefore, "these features may be built into a portable ERS." *Id.* Ellis explains that "a single ERS may be used both portably or in the car, or in the car or at home." *Id.*, ¶0160.

In sum, neither Sasaki nor Ellis—individually or in combination—disclose inferring user preferences based on a plurality of media types, as required by the claims. And Ellis discloses only inferring a user's audio preferences locally without the use of a server. Therefore, the combination of Sasaki and Ellis fails to either disclose or render obvious this limitation.

C. Sasaki and Ellis fail to teach "access one or more sources of information about venues or events *proximal to a current location of the user.*"

Claim 1 requires the server to "access one or more sources of information about venues or events *proximal to a current location of the user*." EX1001, Claim 1. Claim 10 requires that the mobile device receive from the server a recommendation wherein "the event or venue of interest is selected from one or more sources of information about a plurality of venues or events *proximate to the inferred current location of the user*." *Id.*, Claim 10. Claim 17 requires the mobile device to receive a recommendation from the server wherein "the event or venue of interest is selected from one or more sources of information about a plurality of venues or events *proximate to the inferred current location of the user*." *Id.*, Claim 17.

Sasaki and Ellis neither disclose nor render obvious a server that determines or uses the current location of the user or a portable media player device that transmits its location to a server.[5]

At the outset, Patent Owner notes that Petitioner's asserted ground combines features of two distinct embodiments from Sasaki without even attempting to explain why or how a person of ordinary skill in the art would have been motivated to make the combination. For this reason alone, Petitioner fails to satisfy its burden and the Petition should be denied. *See Abiomed, Inc. v. Maquet Cardiovascular, LLC*, IPR2017-01204, -01205, Paper 9 (IPR2017-01204), Paper 8 (IPR2017-01205) at 9-11 (P.T.A.B. Oct. 23, 2017) (finding that "Petitioner has failed to establish sufficiently that the features of [] different embodiments [of the asserted reference] are interchangeable or provide sufficient rationale to combine the teachings of those different embodiments"); *In re Stepan Co.*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017) ("Whether a rejection is based on combining disclosures from multiple references, *combining multiple embodiments from a single reference*, or selecting from large lists of elements in a single reference, *there must be a motivation to make the combination* and a reasonable expectation that such a

[5] As noted above, Petitioner's asserted ground also relies on Jacobi. Pet., 20. Petitioner, however, also does not rely on Jacobi for the location limitation.

combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.").

In particular, Petitioner does not explain why the portable media device would transmit location information to the server in Sasaki's second (server-to-terminal) embodiment when the portable device is the device receiving, rather than sending, a recommendation. This is particularly true because the server is described as being located at a "service spot," *i.e.*, "a *predetermined area* in which various types of information are provided to users or members" such as "CD/DVD shops and bookstores [and] sightseeing areas." EX1004, ¶¶0113-0114. There would be no need for the portable device to transmit its location to the server in this embodiment because the location of the service spot is already known and communication happens only when the terminal device is close enough to receive an identifying signal from the server. *See id.*, FIG. 5, ¶0054.

Petitioner relies on Sasaki's teaching that the portable media device can transmit location information. Pet., 34. To be sure, the first embodiment of Sasaki discloses a portable terminal device transmitting location information to another portable terminal device. EX1004, ¶¶0068-0069, 0080-0081. As the Petition recognizes, however, the location information "is part of the 'content recommendation information'" that is being sent. Pet., 34. In other words, the portable device that transmits location information related to the recommendation

information is the device that is sending a recommendation to another portable device in Sasaki's first embodiment. EX1004, ¶¶0068-0069, 0080-0081. But this teaching is unrelated to the second embodiment where the portable device is *receiving* the recommendations from the server. *Id.*, ¶¶0112-0130. Thus, Sasaki does not teach a server that determines the current location of a user or that receives location information from a user.

Petitioner relies on Ellis for *using* the geographic information to make local recommendations. Pet., 34. Petitioner does not rely on Ellis for providing user location information *to a server*, and Ellis does not remedy the deficiencies of Sasaki discussed above. Ellis's Enhanced Radio System (ERS) is simply a portable device that knows its own location. EX1005, ¶¶0044, 0225, 0226. The portable ERS uses its location information to determine available radio stations or identify events by using information stored locally on the ERS itself. *Id.*, ¶¶0233-0235. Ellis does not disclose a server that determines the current location of a user or that receives location information from the ERS.

Accordingly, Sasaki and Ellis—alone or in combination—do not disclose or render obvious a server that determines or uses the current location of the user or a portable media player device that transmits its location to a server.

D. Petitioner fails to establish a motivation to combine Sasaki and Ellis.

In addition to the missing elements discussed above, Petitioner fails to establish sufficient motivation to combine Sasaki and Ellis. Indeed, a POSITA would not have combined Sasaki and Ellis because the references address distinct problems. Ellis applies to radio content only, whereas Sasaki relates to content recommendations regarding various types of non-radio data.

Highlighting the differences between radio and non-radio content, Ellis discusses certain advancements in television viewing functionality. For example, "[p]ersonal video recorders, such as those manufactured by TiVo, allow a user to easily record a television program, and also provide VCR-like controls for television programs." EX1005, ¶0005. Ellis refers to several patents related to playback of recorded television content. *Id*. However, according to Ellis, these patented advancements in television viewing are irrelevant to radio because "these types of improvements have been optimized for the needs of the television viewer." *Id*.

Ellis explains that "[r]adio listeners typically have different needs than television viewers." *Id.*, ¶0006. For example, "television viewing typically happens in a fixed environment in a home, while radio listening often happens in varied, often mobile, environments." *Id.* Additionally, "[a] television viewer may sit and watch a program through its completion" whereas "[a] radio listener more often

listens casually while pursuing other activities, and may often switch between stations." *Id*.

Ellis also identifies technological reasons why improving video and radio consumption requires different approaches. For example, "[b]ecause digitized audio content requires much less memory than digitized video content, it is less expensive to store a significant amount of radio content." *Id*., ¶0010. Additionally, "[a] radio tuner is also less costly than a television tuner, so a system that monitors multiple radio stations at once is quite feasible." *Id*. In view of Ellis's express discussion, a POSITA would not have combined Ellis and Sasaki.

The Petition and Dr. Houh's declaration ignore these passages of Ellis in their discussion on motivation to combine. EX1003, ¶¶58-65; Pet., 24-26. Indeed, they must in order to provide their manufactured motivation to combine the references. Moreover, Dr. Houh's declaration substantially recites the content of the Petition without providing additional analysis or evidence on the issue of combining Sasaki and Ellis. EX1003, ¶¶58-65; Pet., 24-26. Again, Dr. Houh's declaration testimony should therefore be disregarded on this issue. *Xerox*, IPR2022-00624, Paper 9 at 15-17; 37 C.F.R. § 42.65(a).

For these reasons, Ellis's disclosure of determining a user's preferences for radio content is inapplicable to the problem of determining preference information

for other types of media disclosed in Sasaki and a POSITA would not have been motivated to combine the references.

V. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION IN VIEW OF PARALLEL PROCEEDINGS.

The Board should deny institution under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) ("Fintiv") because the *Fintiv* analysis favors denial. As set forth below, four of the *Fintiv* factors weigh in favor of denying institution.

A. Factor 1 is neutral because the parallel litigation has not been stayed.

Factor 1 is neutral because the parallel litigation has not been stayed and the Petition presents no evidence that a stay may be granted. The district court litigation has not been stayed in view of this IPR Petition and Petitioner has not moved for such a stay nor indicated that it will file a motion to stay. Patent Owner will oppose any motion to stay.

B. Factor 2 is neutral or does not favor exercising discretion because no trial date has been set.

Factor 2 is neutral or does not favor exercising discretion because no trial date has been set and therefore it is unknown whether the district court will reach a decision on validity issues before the Board issues a final written decision.

C. Factor 3 favors denial because, by the institution deadline, the parties and the trial court will have made significant investment in the parallel litigation.

Factor 3 favors denial. This factor considers "the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision." *Fintiv*, Paper 11 at 9. Here, the parallel litigation proceeded for twelve months prior to the filing of the Petition on November 30, 2022, one day before the § 315(b) deadline. As such, significant time and resources have been being expended in the parallel litigation. The parties served infringement contentions and invalidity contentions prior to the case's transfer to the Northern District of California. Since the transfer, Patent Owner has served infringement contentions, Petitioner served invalidity contentions on March 3, 2023, and the parties have served and responded to written discovery requests. By the institution decision due date, the parties will have exchanged proposed terms for construction and will have completed claim construction discovery. These significant endeavors are clear indicators that institution would lead to significant duplicative costs.

Petitioner's claim of diligence in filing the Petition lacks credibility. Pet., 14-15. Petitioner waited 12 months after the Complaint was served in district court and more than six months after serving its initial invalidity contentions in the

Western District of Texas prior to filing the Petition. Petitioner does not offer any explanation for its lengthy delay. This factor therefore favors denial.

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

Factor 4 also favors denial. When a "petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial." *Fintiv*, Paper 11 at 12. Here, Petitioner challenges all the claims asserted in the parallel district court litigation. EX2002.

Additionally, there is substantial overlap between the references and invalidity theories applied in the Petition and the invalidity contentions presented in the parallel litigation. EX2003. The invalidity contentions in the parallel proceeding recite the arguments from the Petition almost verbatim. *Id.* The same combinations of Sasaki, Ellis, Jacobi, Havinis, and Teicher are presented. *Id.* The only substantial difference is that claims 3, 8, and 15, which are not asserted in the parallel proceeding, are not included in the invalidity contentions. *Id.*

Further, Petitioner has not stipulated, either in the district court or in the Petition, that it will not pursue invalidity in the parallel litigation based on any instituted IPR ground. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 18-19 (P.T.A.B. Dec. 1, 2020) (precedential as to § II.A); *Sand*

Revolution II, LLC v. Continental Intermodal Group–Trucking LLC, IPR2019-01393, Paper 24 at 11-12 (P.T.A.B. June 16, 2020) (informative). As things stand, Petitioner could pursue substantially overlapping invalidity arguments in the trial court, using identical references. This potential overlap of issues favors denying the Petition to avoid the Board duplicating the trial court's efforts and potentially reaching inconsistent results.

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

Factor 5 favors denial because the Petitioner in this IPR, Google, is the defendant in the parallel district court proceeding. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (P.T.A.B. May 13, 2020) (informative) ("Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial."). Petitioner is incorrect that this factor is neutral simply because it is normally the case that a petitioner and defendant would be the same party. Identity of the parties is the precise inquiry of this factor. Therefore, because the parties are the same, this factor weighs clearly in favor of discretionary denial.

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

Factor 6 also favors denial. Factor 6 is a catchall, considering "other circumstances that impact the Board's exercise of discretion, including the merits."

Fintiv, Paper 11 at 14. "[I]f the merits of the grounds raised in the petition are a close[] call, then that fact has favored denying institution when other factors favoring denial are present." *Fintiv*, Paper 11 at 14-15. Despite Petitioner's assertion, the Petition does not present "compelling evidence of unpatentability" sufficient to save it from discretionary denial. Pet., 18. As explained in Section IV, above, the Petition's invalidity arguments suffer several fatal flaws, failing to meet even the reasonable likelihood threshold required for institution. The "compelling merits" standard is a higher standard than the institution threshold, and thus the Petition's invalidity arguments are even further from satisfying the compelling merits standard. June 21, 2022 *Fintiv* Memorandum, 4-5; *see also CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 3 (P.T.A.B. Feb. 27, 2023) (precedential, *sua sponte* Director review decision) ("[T]he compelling merits standard is a higher standard than the standard for institution set by statute.").

Accordingly, four of the six *Fintiv* factors support denying institution, one is neutral, and the other is neutral or does not favor exercising discretion. Balancing these factors and taking a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review, the Board should deny institution.

VI. CONCLUSION

Petitioner failed to meet its burden under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(c) to show a reasonable likelihood of success that the any of the challenged claims is unpatentable. Moreover, the Board should exercise its discretion to deny institution in light of parallel proceedings. As such, Patent Owner respectfully requests that the Board deny institution of *inter partes* review.

Respectfully submitted,

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CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))

1. This Patent Owner Preliminary Response complies with the type-volume limitation of 14,000 words, comprising 8,650 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

2. This Patent Owner Preliminary Response complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word 2016 in 14-point Times New Roman font.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER PRELIMINARY RESPONSE UNDER 37 C.F.R. § 42.107(a)** and **EXHIBITS 2001-2004** were served electronically via e-mail on March 14, 2023, in their entireties on the following counsel of record for Petitioner:

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