

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC and YOUTUBE, LLC,
Petitioner

v.

ROBOCAST, INC.,
Patent Owner

Case IPR2023-00590
U.S. Patent 7,155,451

PATENT OWNER'S PRELIMINARY RESPONSE

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Exhibit List

Exhibit	Description
2001	Order Denying Motion to Stay in <i>Robocast, Inc. v. Netflix, Inc.</i> , No. 1:22-cv-00305-RGA (D. Del.)
2002	Microsoft Press Release, 2001
2003	Order on Motions for Summary Judgment in <i>Robocast, Inc. v. Microsoft Corp.</i> , No. 1:10-cv-01055 RGA (D. Del.)
2004	Scheduling Order in <i>Robocast, Inc. v. YouTube, LLC and Google LLC</i> , No. 1:22-00304-RGA (D. Del.) and <i>Robocast, Inc. v. Netflix, Inc.</i> , No. 1:22-cv-00305-RGA (D. Del.)
2005	Order on Motion to Dismiss in <i>Robocast, Inc. v. YouTube, LLC and Google LLC</i> , No. 1:22-00304-RGA (D. Del.)
2006	Order Denying Motion to Transfer in <i>Robocast, Inc. v. YouTube, LLC and Google LLC</i> , No. 1:22-00304-RGA (D. Del.)
2007	Defendants' Answer to Complaint in <i>Robocast, Inc. v. YouTube, LLC and Google LLC</i> , No. 1:22-00304-RGA (D. Del.)
2008	Initial Infringement Contention cover pleading in <i>Robocast, Inc. v. YouTube, LLC and Google LLC</i> , No. 1:22-00304-RGA (D. Del.)

I. INTRODUCTION

Petitioner's request for *inter partes* review ("IPR") of claims 1-21 and 37-38 of U.S. Patent 7,155,451 ("’451 Patent") should be denied for the reasons set forth herein.

First, because the ’451 Patent is expired, the PTAB does not have jurisdiction to hear this IPR. Second, the Board should exercise its discretion to deny the Petition under 35 U.S.C. §314(a). The District of Delaware is unlikely to stay pending litigation asserting the ’451 Patent in that court (*Robocast, Inc. v. YouTube, LLC et al.*, No. 1:22-cv-00304 (the "YouTube Litigation"), and *Robocast, Inc. v. Netflix, Inc.*, No. 1:22-cv-00305) (the "Netflix Litigation"), because the ’451 Patent is only one of three patents asserted in these cases and institution of IPR proceedings for each of these asserted patents have already been denied. Additionally, Petitioner challenges only 23 of the 64 claims of the ’451 Patent in this IPR, and omits claims presently asserted in the litigations.¹ In fact, the District of Delaware has already

¹ Petitioner has filed a second petition challenging another 22 claims of the ’451 Patent (*see* IPR2023-00591), but as explained in Patent Owner's Objection to Petitioner's Filing of Multiple Petitions, Petitioner's filing of multiple petitions was improper, and the Board should exercise its discretion to deny one of the petitions for this reason alone.

denied a request to stay premised on IPRs challenging only some of the claims asserted in the aforementioned litigations. *See* EX2001.

Third, none of the six asserted grounds in the Petition demonstrate a reasonable likelihood that Petitioner will prevail with respect to at least one of the challenged claims as required by 35 U.S.C. §314(a). Petitioner repeatedly misunderstands and mischaracterizes the asserted references in ways that are fatal to its cause.

II. U.S. PATENT 7,155,451

A. Background of the Patented Technology

The '451 Patent is directed to improving the web browsing experience for Internet users as it existed in the mid-1990s, a time when the World Wide Web was still in its relative infancy, but the available content was rapidly increasing. It claims several paradigms for improving the web browsing experience by automating the delivery and presentation of web content. These paradigms included innovative and improved methods to deliver and present web content on a user's computer that is retrieved from a plurality of different Internet-accessible data resources, notably including multimedia resources comprising video and/or audio content. A press release issued by Microsoft in December, 2001 described Patent Owner's company and the technologies that would ultimately become its patented inventions as

“pioneering,” and “offering viewing automation tools for a variety of display devices.” EX2002 at 2.

The '451 Patent solved a technological problem that existed with respect to Internet web browsing as it was then being practiced by computer users in the early 1990s, specifically that computer users browsing the Internet had no easy and efficient means available for accessing, retrieving and consuming content from a multitude of different Internet-accessible resources. *See, e.g.*, EX1001 at Abstract, FIG. 7, 5:51-6:4. Rather, each resource needed to be accessed one at a time, with the user's web browser requiring substantial decisional input from the user, *i.e.*, laboriously clicking through a series of links and/or web pages in order to individually navigate to each such resource and obtain its corresponding content. *Id.* The '451 Patent explains that this prior art approach was problematic because it undesirably “require[d] a significant amount of user effort and decision-making to drive the web surfing experience,” and thereby resulted in a very cumbersome and time consuming web browsing experience for computer users browsing the Internet. *Id.* at 6:3-4.

Patent Owner's inventive solution includes a key active step recited and captured in every challenged claim wherein a provider creates an organized arrangement of content corresponding to a plurality of different Internet-accessible resources in the form of a “show structure of nodes.” *See, e.g.*, EX1001 at Abstract,

FIGS. 2B-2F, 1:28-30, 3:6-16, 3:30-39, 4:15-17, 5:28-34, 6:64-7:60, 8:28-30. Each of these “nodes” is an identifier of a distinct resource that includes its address. The “show structure” specifies one or more paths through the plurality of nodes that can serve to sequence and schedule how content obtained from these resources is provided to the user’s computer. *Id.* In accordance with certain claimed “show structure of nodes” embodiments, items of content corresponding to each different resource are automatically accessed from the Internet and presented on the user’s computer in continuous sequential fashion one after another, all without requiring any input from the user beyond (at most) a single initial click that serves to commence the show structure. *Id.*

As stated in the intrinsic record, the innovative methods of the ’451 Patent thus solve the problem identified in the prior art by greatly reducing the number of clicks and decisions required of a computer user when browsing the Internet to retrieve content from a multitude of different Internet-accessible resources, thereby providing for the first time a significantly easier and more efficient way for computer users to be able to “play” the Internet automatically by exerting the minimal effort of making just a single click. *See, e.g.*, EX1001 at Abstract, FIG. 7, 2:59-61, 5:51-6:4; EX1024 at 249 (Response to June 18, 2001 Office Action at p. 13), 126-27 (Brief on Appeal dated March 7, 2003 at pp. 5-6); EX1028 at 7-8 (Provisional Appl. No. 60/025,360 at 1-2).

Challenged independent claim 1, as well as claim 11, which depends from independent claim 10, captures embodiments that further require “interactively variable duration information.” *Cf.* EX1001 at FIG. 7, 3:30-35, 5:30-33; 9:27-32; 11:7-9, 15:62-16:6, 16:25-31. This “interactively variable duration information” represents the duration for which content corresponding to an Internet-accessible resource from the show structure will be presented by default to the web browsing computer user/viewer, and it enables the user/viewer to change that duration such that the amount of time for which resource content will be presented can be increased or decreased. *Id.*

Challenged independent claim 10 is directed to a method for automatically accessing and displaying a sequence of resources, the content of which is “derived via a communications network.”

Challenged independent claim 37 is directed to a method for displaying content on a user’s computer utilizing a “multidimensional show structure of nodes,” where at least two nodes of the show structure are “spanned concurrently” and content from the nodes is “displayed during an overlapping time period.”

As described herein, at least one or more of the foregoing limitations is missing from Petitioner’s cited references and combinations.

B. Level of Ordinary Skill in the Art

A person of ordinary skill in the art at the time of the invention would have the equivalent of a four-year degree from an accredited institution (usually denoted as a B.S. degree) in computer science, computer engineering or the equivalent, and experience with, or exposure to, topics in computer networking, multimedia, and web systems. A person of ordinary skill in the art would also have approximately 3-5 years of professional experience with these topics. Additional graduate education could substitute for professional experience, while significant experience in the field might substitute for formal education.

C. Claim Construction

The Board has the benefit of the claim construction rulings issued by United States District Court Judge Richard Andrews of the District of Delaware in the prior *Microsoft* and *Apple* cases involving the very patent challenged here. *See* EX1023 (*Microsoft/Apple* claim construction order). Patent Owner believes that these prior district court constructions should be adopted for purposes of this proceeding and has consequently applied them in its analysis below. While “Petitioner does not believe express claim construction is necessary at this time,” the Petition nonetheless presents extensive arguments for how the prior art allegedly “renders the challenged claims obvious under the district court’s constructions.” *See* Pet. at 7-8, 14-16, 24, 27, 61-62, 64. Accordingly, because both parties have applied the prior district court

constructions, the Board should do so as well in rendering its institution decision herein.

Notably, such an approach would comport with what has already transpired in three previous IPRs involving the same or closely related Robocast patents wherein the Board expressly adopted and applied these prior district court constructions when denying institution. For example, in the *Netflix* -00081 IPR directed to the challenged '451 Patent, the Board employed all of those same constructions plus the district court's additional constructions for the terms "multidimensional show structure of nodes" and "at least two of said nodes are spanned concurrently." *Netflix, Inc. v. Robocast, Inc.*, IPR2023-00081, Paper 19 at 11-12 (May 11, 2023). In the *Unified* -01125 IPR involving related U.S. Patent No. 8,965,932 ("932 Patent"), the Board relied upon the district court's constructions for "node," "show structure of nodes," and "interactively variable duration information." *Unified Patents, LLC v. Robocast, Inc.*, IPR2022-01125, Paper 13 at 14 (Jan. 20, 2023). Moreover, in the *Netflix* -00182 IPR involving related U.S. Patent No. 8,606,819 ("819 Patent"), the Board likewise used those same three prior district court constructions. *Netflix, Inc. v. Robocast, Inc.*, IPR2023-00182, Paper 14 at 15-16 (June 9, 2023). No grounds exist for departing from this well-reasoned approach here.

In particular, here the Board should adopt and apply the following three prior district court constructions of relevance to the issues raised in the Petition, with any additional claim language being accorded its plain and ordinary meaning:

1. “Show Structure of Nodes”

This term should once again be subject to the district court’s construction of **“a structure that is arranged for the display of content by specifying one or more paths through a plurality of nodes. The show structure of nodes specifies the duration of any display.”** EX1023 at 2.

In its summary judgment order in the *Microsoft* case, the court further clarified that there is no requirement for “a separate durational requirement in the term ‘show structure of nodes’ separate from the construction of ‘node.’” EX2003 5.

2. “Node”

This term should once again be subject to the district court’s construction of **“an identifier of a resource that includes an address to the resource and the duration for which the resource's content is to be presented by default.”** EX1023 at 16.

The district court’s construction indicates that a “node” and a “resource” are separate and distinct entities. For example, a “node” is not itself described as *comprising* a “resource,” but rather as merely being an “*identifier* of a resource.”

Moreover, the “resource’s content” which is to be presented/displayed to the user in accordance with the show structure is identified separately from the content of the “node” itself, with the latter node content only needing to include address and duration information relating to the “resource.” Finally, the fact that a “node” includes an “address to the resource” suggests that the “resource’s content” is located somewhere apart from the “node” and is *not* coextensive with the location of the node’s own content. If a node comprises the resource itself, there is no need for the node to also contain (a) an identifier of a resource or (b) an address to the resource.

As such, the district court’s construction is fully consistent with the plain language of the challenged claims. For example, in the challenged claims, “nodes” and “resources” are separately recited as distinct structural claim limitations from one another, with the relationship between them being that “each node identif[ies] a resource from a plurality of accessible resources.” EX1001 at Claim 1, 37; *see also id.* at Claim 10 (“each node identifying a corresponding resource”).

The claim language also distinguishes between the content of the “nodes” themselves as opposed to the content of the corresponding “resources” which they identify. In the challenged claims, it is exclusively *resource content* that is “display[ed]...in accordance with said show structure.” *Id.* at Claim 1, Claim 10, Claim 37.

Moreover, the claim language establishes that *resource content* is physically located separate and apart from *node content*. Thus, the challenged claims contemplate resource content needing to be “accessed/retrieved” from a location outside of the node, including over a communications network, before it can be presented to the user in accordance with a show structure of “nodes.” *Id.* at Claims 1, 10, and 37.

The district court’s construction is likewise consistent with numerous claimed embodiments in the specification of the ’451 Patent. Indeed, the specification describes “nodes” as merely being *identifiers* of separate and distinct “resources.” EX 1001 at 7:2-3 (“Each node identifies an available resource”); 7:58-60 (“available resources...[are] identified by available nodes”). During playback, a show structure “presents the [resource] content identified by node[s]” to the computer user, with that resource content first needing to be “accessed” from some other location separate and apart from where the nodes themselves are residing. *Id.* at 7:17-20, 7:24-27, 7:33-36, 3:32-37, 8:30-32, 9:26-29. In contrast to the *resource content* that gets presented/displayed to the user during a show, the content of the nodes themselves is described as follows: “Each node in the structure includes both an address from which the [resource] information may be accessed and an indication of the duration for which the content will be presented.” *Id.* at 3:26-31.

3. “Interactively Variable Duration Information”

This term should once again be subject to the district court’s construction of **“a parameter specifying how long a content is to be displayed by default before a subsequent content is displayed, where the viewer of the content can change the parameter.”** EX1023 at 22.

Under this construction, the “interactively variable duration information” limitation requires that the computer end user who is the viewer of the show structure resources must be able to change the default duration time for how long the content of a particular resource is presented *while that content is actually being presented/displayed to the end user pursuant to a show structure*. Indeed, in clarifying precisely what was intended by its construction, the district court expressly stated that it “agrees with Robocast that the user should be able to vary the duration of the content *during show structure playback*. This is the ‘interactive’ component of the claim.” EX1023 at 23 (emphasis added).

In the prior *Netflix* -00081 IPR, the Board extensively analyzed this identical claim limitation, and the district court’s construction thereof, in holding as follows: “we adopt the *Microsoft* court’s construction of ‘interactively variable duration information’...[and] we further make clear that the [variable duration] parameter is provided during the step of creating a show structure and capable of being varied during the step of ‘displaying [*i.e.*, presenting] a content corresponding to each of

said resources automatically in accordance with said show structure.” *Netflix, Inc. v. Robocast, Inc.*, IPR2023-00081, Paper 19 at 17 (May 11, 2023); *accord id.* at 14-15, 16-17, 35, 46-47. As the Board explained, “[t]his is consistent with the *Microsoft* court’s view, expressed in the claim construction decision, that the interactive component of the claim is the user being able to vary the duration of content during show structure playback.” *Id.* at 15 n. 2. *See also id.* at 14-15 (“the *Microsoft* court construed claim 1 [of the ’451 Patent] to require providing a variable duration parameter in the creating step, but that the parameter is capable of being varied by the user during the displaying step.”).

In short, in assessing the same position that Patent Owner is presently reasserting herein, the *Netflix* -00081 Board held that “[w]e conclude that Patent Owner’s position is the most consistent with the *Microsoft* court’s construction and the intrinsic evidence.” *Id.* at 13. In support of its conclusion, the Board provided a detailed analysis demonstrating how both the plain language of the ’451 Patent claims, as well as its specification disclosures, fully support the district court’s determination that the “interactively variable duration information” limitation requires that a user must be able to vary the duration of the resource content during show structure playback. *Id.* at 16-17. The Board’s prior analysis and ultimate conclusions should equally govern in this proceeding.

Finally, just as the Board observed in the *Netflix* -00081 IPR, insofar as “Petitioner disagrees with the *Microsoft* court’s construction and wants us to change or expand it, Petitioner should have explained this in the Petition and supported it with evidence.” *Id.* at 15 (citing 37 C.F.R. § 42.104(b)(3) (The Petition must “[p]rovide a statement of the precise relief requested for each claim challenged” and must identify “[h]ow the challenged claim is to be construed.”)). Petitioner has failed to do so and must now live with the consequences.

4. “Multidimensional Show Structure of Nodes”

This term should be construed as “show structure of nodes, in which the nodes are presented concurrently for at least some portion of the show.” EX1023 at 13.

5. “At Least Two of Said Nodes are Spanned Concurrently”

This term should be construed as “nodes are accessed such that the content corresponding to at least two nodes is accessed at the same time.” *Id.*, 24.

Additionally, with respect to terms 1-3 above, which are common to the ’932 Patent, the PTAB adopted each of the above constructions in its decision denying institution of IPR2022-01125. *Unified Patents, LLC v. Robocast, Inc.*, IPR2022-01125, Paper 13 (Jan. 20, 2023) (Decision Denying Institution of *Inter Partes* Review) at 13-15.

D. Priority Date

The '451 Patent is subject to pre-AIA provisions of 35 U.S.C. *et seq.*, and all of the references relied upon in the Petition are asserted to be prior art pursuant to 35 U.S.C. §102. Patent Owner reserves the right to present evidence of prior invention with respect to each of the references in the event of institution.

III. THE PTAB DOES NOT HAVE JURISDICTION OVER EXPIRED PATENTS

In *Oil States*, the Supreme Court explained that the “decision to *grant*² a patent is a matter involving public rights—specifically, the grant of a public franchise.” *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365, 1373 (2018). “Specifically, patents are public franchises that the Government grants to the inventors of new and useful improvements.” *Id.* (internal quotation marks omitted). The Court explained that “Congress [has] significant latitude to assign [the] adjudication of public rights to entities other than Article III courts.” *Id.* at 1368. In exercising its “significant latitude,” Congress grants public franchises “subject to the qualification that the PTO has the authority to reexamine—and perhaps cancel—a patent claim in an inter partes review.” *Id.* at 1368, 1374 (internal quotation marks omitted). Accordingly, so long as the public franchise exists, the PTO may have

² Emphasis is added, unless indicated otherwise.

jurisdiction to amend and cancel the claims of the patent (e.g., via *inter partes* review).

The Court “emphasize[d] the narrowness of [its] holding,” which addressed “only the precise constitutional challenges that Oil States raised” in that case. *Id.* at 1379. Importantly, because Oil States concerned a patent (No. 6,179,053) that was still in force at the time of the final written decision in the IPR (and the Supreme Court’s decision), the “precise constitutional challenge” did not involve an expired patent as is the case here, and the Supreme Court has yet to address the PTAB’s jurisdiction to conduct *inter partes* review of expired patents.

When a patent expires, the public franchise ceases to exist and the franchisee (e.g., the patent owner) no longer has the right to exclude others. At most, the franchisee may be entitled to collect damages from the public franchise that formerly existed through an infringement action in district court. But because the public franchise no longer exists, the PTO has nothing in its authority to cancel or amend. Expiration removes the patent from the PTO’s jurisdiction and returns it to the sole jurisdiction of the Article III courts, which have exclusive authority to govern claims for damages. If this were not so, the PTO would purport to have authority to retroactively modify a public franchise that no longer exists, in a setting where the expired public franchise does not enjoy any presumption of validity and in which amendment of claims is no longer permitted.

There is thus strong reason for a different outcome with respect to expired patents. In particular, the Court noted that in an IPR the patent owner “can file a motion to amend the patent by voluntarily canceling a claim or by ‘propos[ing] a reasonable number of substitute claims.’ §316(d)(1)(B).” *Id.* at 1371. The Court concluded that “inter partes review involves the same interests as the determination to grant a patent in the first instance,” and that “the primary distinction between inter partes review and the initial grant of a patent is that inter partes review occurs after the patent has issued.” *Id.* at 1374 (emphasis in original). But in the case of an expired patent, the “primary distinction” is the inability to amend the claims.

The ’451 Patent expired long before the Petition was filed on June 30, 2022. With the expiration of the patent, the Board ceased to have jurisdiction over the ’451 Patent, and this IPR should be terminated as a result.

IV. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 314(A)

The Petition will waste the Board’s resources because substantial investments have been made in parallel proceedings. Moreover, a stay of the parallel proceedings is highly unlikely at least because the Board has denied institution of IPRs filed by Netflix and Unified Patents against all three asserted patents, and institution decisions in the current set of IPRs filed by Petitioner are not expected until September 2023. As set forth below, all or a vast majority – i.e., at least five of the

six – *Fintiv* factors weigh in favor of denying institution. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9 (Mar. 20, 2020) (precedential).

A. Factor 1 favors denial because a stay is unlikely.

Factor 1 favors denial because the parallel litigation has not been stayed, and is not likely to be stayed. As of this filing, no motion to stay has been filed in the YouTube Litigation.

And in the parallel Netflix Litigation, the District Court denied Netflix’s motion to stay pending IPR, stating unequivocally that “[t]he case is moving forward.” EX2001. The Court granted Netflix leave to renew the motion if IPR2023-00081 or IPR2023-00182 were instituted but, since then, the Board has denied institution in both proceedings.

Also since then, Petitioner filed additional petitions (including the present petition) for IPR against all three asserted patents. *See* IPR2023-00591 (’451 Patent); -00592 (’932 Patent); -00593 (’932 Patent); and -00594 (’819 Patent) (collectively the “Google petitions”). Decisions on institution regarding the Google petitions are not expected to issue until at least September 2023.

Notwithstanding the Google petitions, the fact remains at this stage, where no IPR challenging any patent asserted in the companion district court cases has been instituted—and the Board has denied institution in IPR2022-01125, IPR2023-00081 and IPR2023-00182—a stay is highly unlikely. *See, e.g., Advanced Microscopy Inc.*

v. Carl Zeiss Microscopy, LLC, No. 15-cv-516-LPS-CJB, 2016 WL 558615, at *2 (D. Del. Feb. 11, 2016); *Ansell Healthcare Products LLC v. Reckitt Benckiser LLC*, No. 15-cv-00915-RGA, D.I. 105 (D. Del. Dec. 1, 2016); *Canvs Corp. v. United States*, 118 Fed. Cl. 587, 591-92 (Fed. Cl. 2014) (a stay “must be based on more than the mere fact that a petition for *inter partes* review was filed.”).

Additionally, Judge Andrews is unlikely to stay the companion district court cases—in which 3 patents are asserted—based on institution of this IPR alone. *See e.g. Cirba, Inc. d/b/a Densify et al v. VMware, Inc.* C.A. 1-19-cv-00742-LPS, D.I. 1101 (D. Del. Dec. 6, 2021) (denying motion to stay where only a minority of the asserted patents were subject to an instituted IPR); *see also VARTA Microbattery GMBH v. Guangdong Mic-Power New Energy Co.*, Case 2:21-cv-00036-JRG (E.D. Tex. Jan. 7, 2022); *Blitzsafe Texas LLC v. Maserati N.A. Inc.*, Case 2:19-cv-00378-JRG (E.D. Tex. Jan. 26, 2021); *BFCyber Corp. v. Google LLC*, Case No. 2:20-cv-00274-JRG (E.D. Tex. Jan. 4, 2022).

Further, the Google petitions—each filed just shy of one year after the companion district court cases were filed—are not likely to lead to a stay, at least because institution decisions are not expected until late-September 2023. At such time, the parties will have made substantial progress in the companion district court cases. *Toshiba Samsung Storage Tech. Korea Corp. v. LG Elecs., Inc.*, 193 F. Supp. 3d 345, 348 (D. Del. 2016) (noting that status of the litigation is factor considered

when deciding whether to stay litigation pending IPR); *see also* EX2004. Therefore, for all the above reasons, Factor 1 weighs in favor of discretionary denial.

B. Factor 2 favors denial or is neutral.

Although the YouTube Litigation is scheduled for trial in February 2025 and the Netflix Litigation is scheduled for trial in March 2025, which is roughly six months after the Board's projected statutory deadline to enter a Final Written Decision – i.e., late-September 2024 – the District Court and parties will have made significant and substantial investments of resources in the parallel YouTube Litigation and Netflix Litigation by September 2024. EX2004. Specifically, claim construction will have completed, document production and overall fact discovery will have closed, expert reports (and reply reports) will have been exchanged and expert depositions will have been completed. *Id.* Furthermore, after the Board provides a Final Written Decision, the parties then have the right to appeal that decision to the United States Court of Appeals for the Federal Circuit. 35 U.S.C. § 141(c). The appeals process can take more than an additional year and a half to conclude, thus likely extending the matter into late 2025 – well after trial in the parallel YouTube Litigation and Netflix Litigation. Thus, Factor 2 weighs in favor of discretionary denial or is neutral at most.

C. Factor 3 favors denial because substantial effort will have been expended by the deadline for institution.

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. The parallel YouTube Litigation and Netflix Litigation have been active for over a year and significant time and resources have already been expended. For example, the District Court has largely denied Petitioner’s and Netflix’s motions to dismiss, and also denied Petitioner’s motion to transfer. EX2005; EX2006. Petitioner served its answer in December and the pleadings are now closed. EX2007. As noted above, Judge Andrews also denied Netflix’s motion to stay and, in doing so, stated unequivocally that “[t]he case is moving forward.” EX2005.

In addition, the case management conference was held on February 13, 2023, the Scheduling Order issued on February 21, 2023, and discovery is well underway. Indeed, Petitioner and Netflix have already produced their respective Core Technical Documents and Patent Owner has served its initial infringement contentions. Petitioner and Netflix’s initial invalidity contentions are due shortly (on July 6). *See* EX2004. In addition, Patent Owner has served requests for production on Petitioner and, further, has already served responses to Netflix’s first set of interrogatories, requests for production, and requests for admission. Petitioner has also served its

own set of interrogatories and requests for production. Patent Owner has also already produced over 4.2 million pages of documents. And again, a stay of the companion district court cases is unlikely. *See Fintiv* Factor 1. Per the District Court’s Scheduling Order, by the time of the Board’s institution decision, the parties will have already prepared and filed a Joint Claim Construction Chart with the claim construction briefing beginning shortly thereafter. EX2004. These significant endeavors are clear indicators that institution would lead to significant duplicative costs. Therefore, Factor 3 weighs in favor of discretionary denial.

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

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. Petitioner has asserted affirmative defenses of invalidity of all three asserted patents, including the ’451 Patent, for obviousness under §103. EX2007 at 10. Further, Petitioner has provided no indication that it will forego asserting the same grounds for invalidity raised in its Petition in the District Court.

E. Factor 5 favors denial because Petitioner is a party in the parallel proceedings

Factor 5 favors denial of institution because Petitioner is a defendant in the parallel YouTube Litigation, asserting invalidity of the '451 Patent as an affirmative defense. EX2007.

F. Factor 6 favors denial because the merits are weak.

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.” *Id.* at 14-15. As explained in Section V below, the Petition’s invalidity arguments suffer several fatal flaws. For example, Shimizu does not disclose the “nodes” of the challenged claims as properly construed. As explained in the Claim Construction section above, the term “node” should properly be construed as “an identifier of a resource that includes an address to the resource and the duration for which the resource's content is to be presented by default.” *Supra*, p. 8-10. In turn, the phrase “show structure of nodes” should be construed as “a structure that is arranged for the display of content by specifying one or more paths through a plurality of nodes. *Id.*, p. 8. The show structure of nodes specifies the duration of any display.” *Id.*

As discussed below, Petitioner relies exclusively upon the hypertext nodes disclosed in its base reference, Shimizu, as ostensibly supplying the “nodes” required by independent claims 1, 10, and 37 (as well as the claimed “show structure of nodes” and the “resources” for which the claimed “nodes” need to serve as identifiers). Pet. at 11-16. However, for at least the reasons detailed below, Shimizu’s hypertext nodes cannot possibly qualify as the recited “nodes” of independent claims 1, 10, and 37 as properly construed.³

³ In the event Petitioner seeks leave to address the *Fintiv* factors in a reply, and in the event such leave is granted, any attempt by Petitioner to salvage its defective invalidity theory with new arguments should be rebuffed. *See, e.g.*, IPR2023-00081, Paper 19 at n. 8:

[I]mproper new argument [in a preliminary reply] will not be considered. See 37 C.F.R. § 42.23(b) (“A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution.”). Petitioner was given permission to submit a preliminary reply addressing the *Fintiv* factors. See Ex. 3001. Petitioner offers its new argument in response to Patent Owner’s argument that the merits of Petitioner’s challenges are compelling. Petitioner, however, was not invited to offer new argument and evidence to bolster its case to make it more compelling.

G. Petitioner does not present compelling evidence of unpatentability that would require institution.

As shown in detail in the following sections, Petitioner does not present compelling evidence of unpatentability. Each ground contains multiple fatal flaws. Accordingly, the Board should consider the *Fintiv* factors when considering whether to institute the Petition.

* * *

All or a vast majority – i.e., at least five of the six – *Fintiv* factors support denying institution. In 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.

V. GROUNDS 1-6: PETITIONER FAILED TO DEMONSTRATE A REASONABLE LIKELIHOOD THAT SHIMIZU IN VIEW OF BENEDICT AND FOX RENDERS THE CHALLENGED CLAIMS OBVIOUS

A. Overview of Shimizu

Shimizu issued to Fuji Xerox Co., Ltd. and describes a system and apparatus “for managing hypertext composed of **nodes holding information** and of link information defining the relations between the nodes so as to **display the information held by each of the nodes** in accordance with the link information.” EX1003, Abstract (emphasis added). Shimizu discloses that the apparatus comprises:

- “a node information management part for managing the nodes and for storing the information held by the nodes;”
- “a link information management part for putting into an order the link information defining the relations between the nodes;”
- “a link order manipulation part for manipulating the order of the link information;” and
- “a display control part for displaying the nodes successively in accordance with the order of the link information.”

Id.

Shimizu’s FIG. 5, shown below, is a block diagram of the “major component parts” of the disclosed hypertext apparatus. *Id.* at 5:61-63.

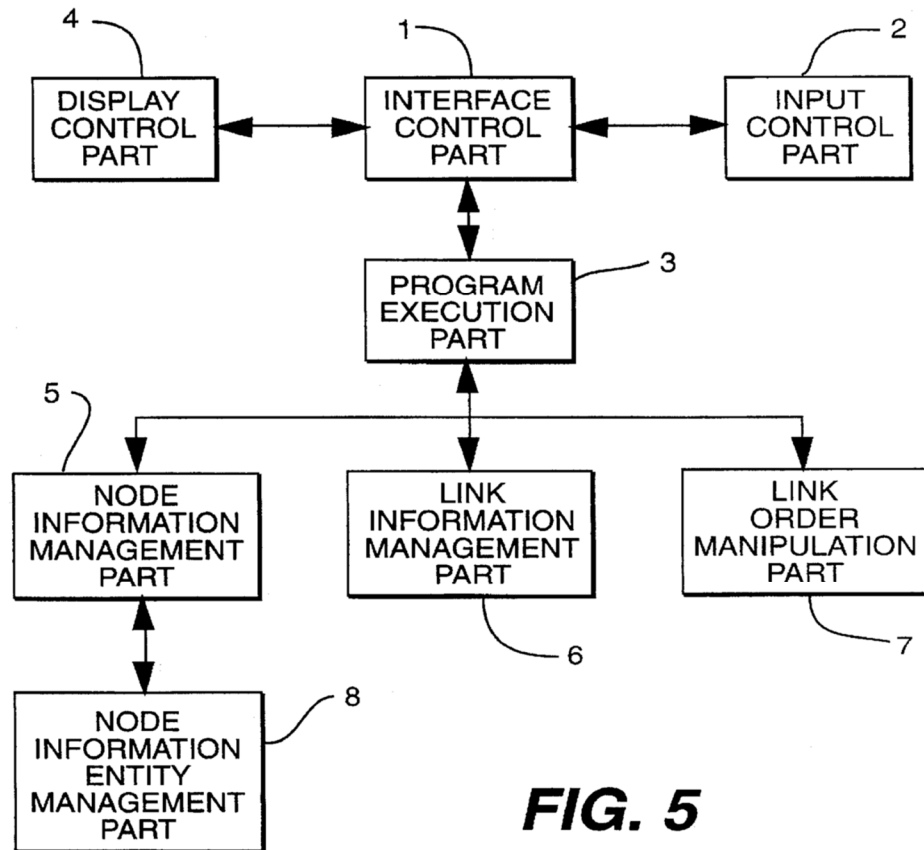


FIG. 5

EX1003, FIG. 5. “In FIG. 5, reference numeral 1 is an interface control part; 2 is an input control part; 3 is a program execution part; 4 is a display control part; 5 is a node information management part; 6 is a link information management part; 7 is a link order manipulation part; and 8 is a link information entity management part.”

Id. at 5:63 – 6:1.

Shimizu explains that the hypertext “[n]odes serve as the units of such information as text information, image information, sound information and motion pictures.” EX1003 at 6:1-3. Further, “[t]he node information management part 5 [of

FIG. 5] manages a plurality of node information structures holding the information about each node.” *Id.* at 6:31-33.

Next, Shimizu’s FIG. 6 shows “a node information structure [9] held by the node information management part 5 [of FIG. 5].” *Id.* at 6:44-45. As discussed below in Section V.D, these “node information structures” are not themselves hypertext nodes but, rather, are at most independent elements merely “associated with” the nodes.

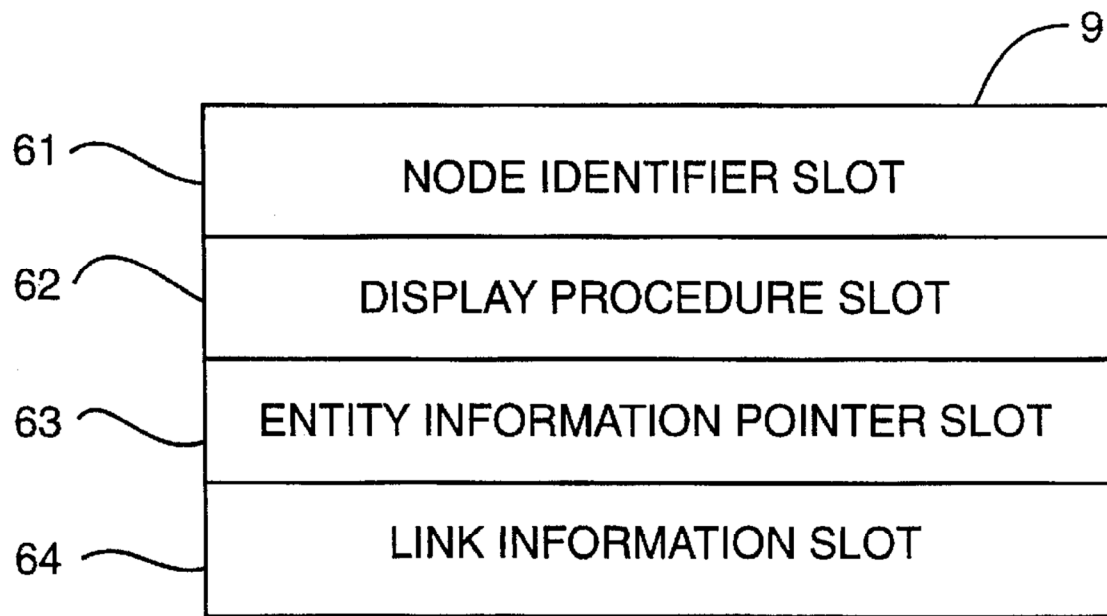


FIG. 6

Id., FIG. 6.

Referring now to FIGS. 8 and 9, Shimizu describes “[h]ow the embodiment of the invention works ... using a case in which the order of links between nodes is

manipulated.” *Id.* at 7:9-19. According to Shimizu, “FIG. 8 is a view of a typical user interface screen display provided by an application program running on the embodiment.” *Id.*

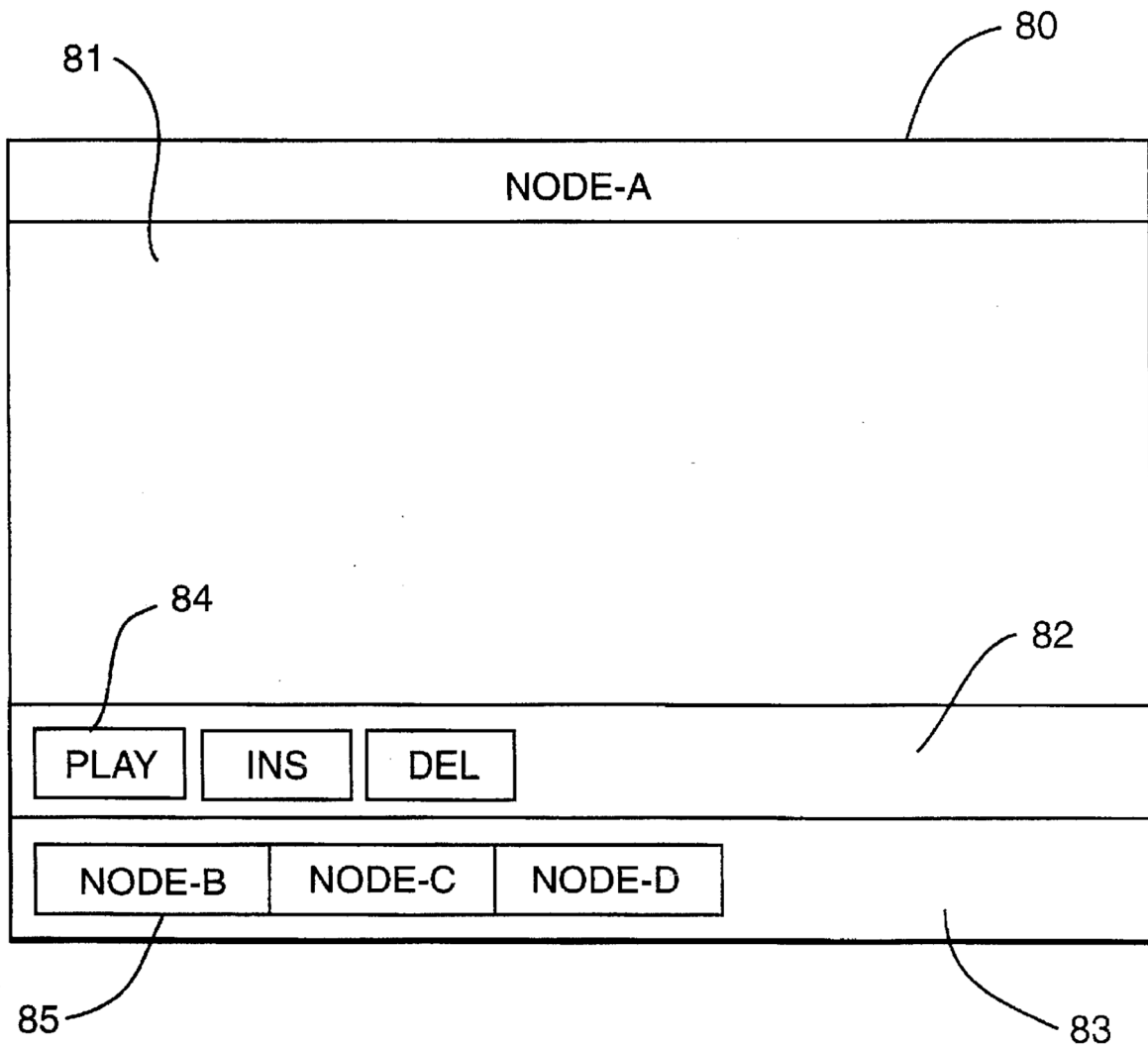


FIG. 8

Id., FIG. 8. Shimizu explains that, “[a]s depicted in FIG. 8, the interface control part 1 and display control part 4 (see FIG. 5) act to open a window 80 in which to display

the node A.” *Id.* “The window 80 is made up of a node content display area 81, an operation designating area 82 and an order display area 83.” *Id.*

In FIG. 9, Shimizu provides “a conceptual view of typical nodes and links and the relations in effect therebetween when the order of link information is changed.” *Id.* at 7:49-51.

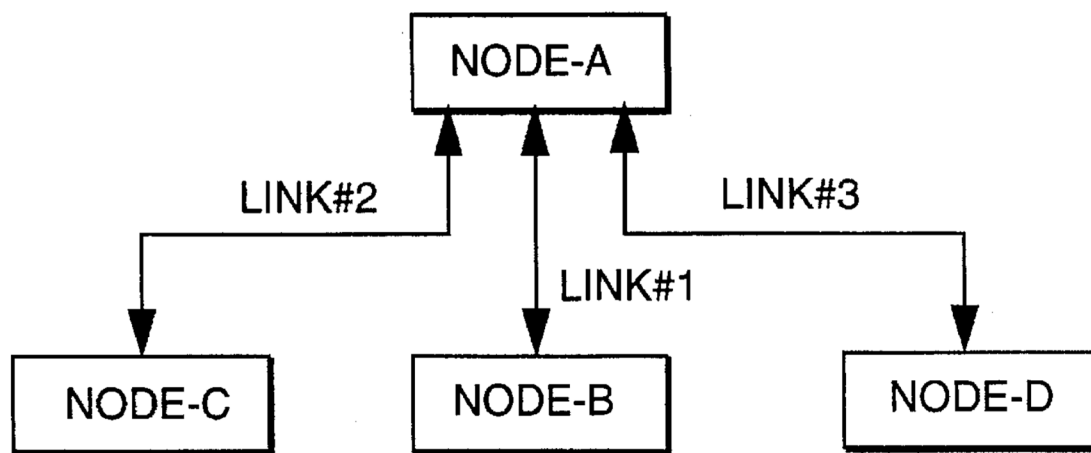
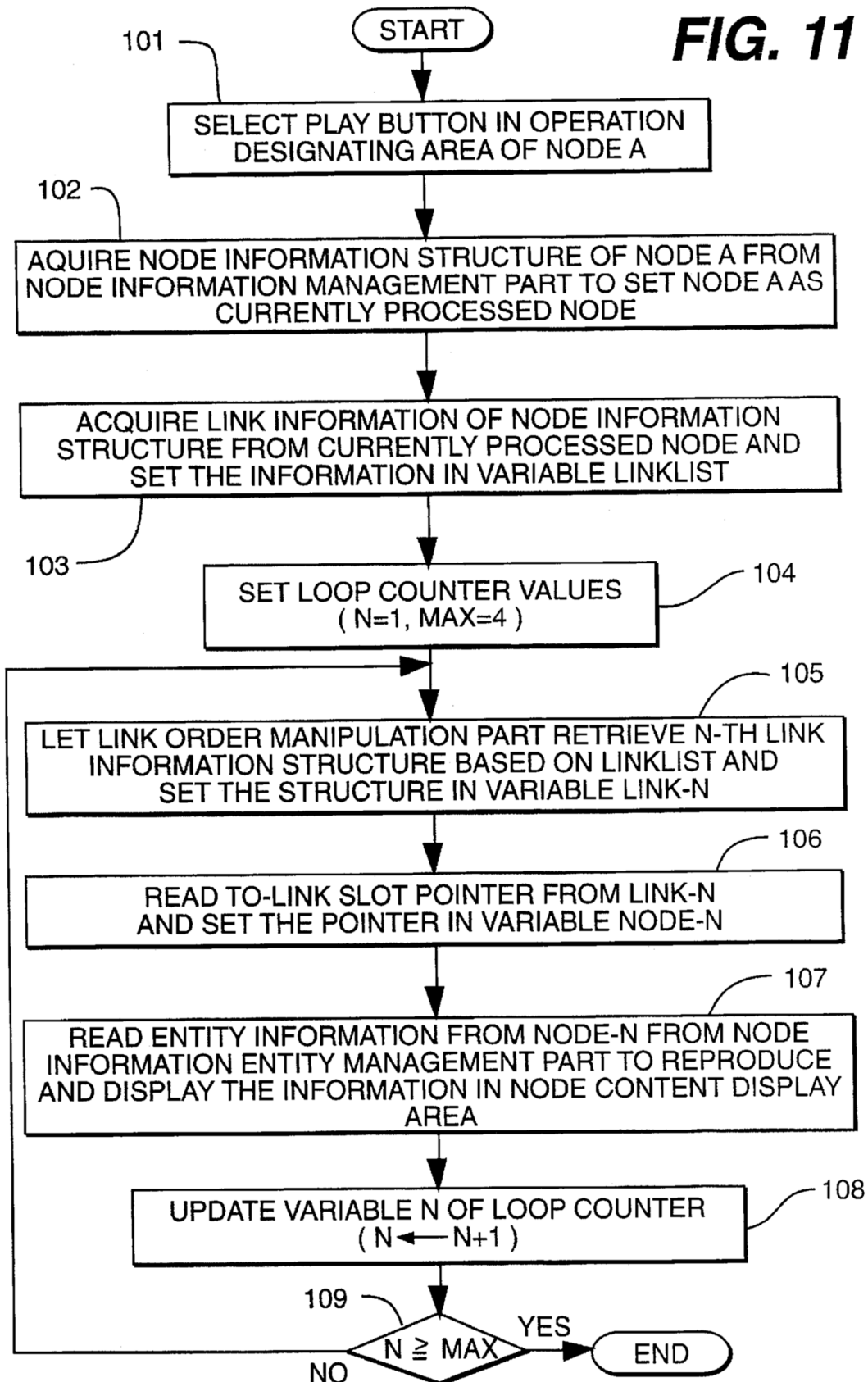


FIG. 9

Shimizu explains that the PLAY button in FIG. 8 is clicked “in order to designate the display of node contents in the order specific to the node A.” *Id.* at 7:57-65. Next, “the node information of the nodes linked successively according to the link information of the node A is displayed.” *Id.* “Specifically, the content of the node A is displayed first followed by the contents of the nodes C, B and D, in that order, inside the node content display area 81 of the window 80 [of FIG. 8].” *Id.*

Referring now to FIG. 11, Shimizu describes it as “a flowchart of steps in which the embodiment displays the contents of the nodes in accordance with the order of their links.” *Id.* at 8:11-16. Shimizu explains that “[t]his processing is started using the mouse to click the "PLAY" button in the operation designating area 82 of the window 80 in FIG. 8”, after which “[t]he contents of the linked nodes are displayed in the order set by the link information.” *Id.* The recited steps include step 105 wherein “items of...node information start to be displayed consecutively,” and step 107 in which content is read from out of the next node up for display to the end-user. *Id.* at 8:11-13, 33-34.

FIG. 11



B. Overview of Benedict

Benedict is a reference guide for using Harvard Graphics software, which was “designed for creating business presentations.” EX1004 at 19. According to Benedict, “[w]ith Harvard Graphics, you can create professional-looking slides on your desktop computer.” *Id.* The slides can then be displayed in the form of a presentation on a computer screen. *Id.*

The section of Benedict primarily relied on by Petitioner is titled *Creating “ScreenShows and HyperShows.”* Pet. at 16-19, 23-27, 34 (citing EX1004 116-17, 119-23, 134-36). According to Benedict, “ScreenShow enables you to do more than present one slide after another on your computer screen, however; you also can enhance your presentation by adding special effects that make the transition from one slide to another more interesting.” EX1004 at 116. In addition, Benedict teaches that HyperShow “enable[s] you to control the flow of your presentation spontaneously,” for instance, “you can skip ahead to slides that are more relevant to an idea or question from the audience.” *Id.*

Benedict describes an “Edit ScreenShow Effects” feature, which allows for customizing the slides to be shown in a self-running “ScreenShow” slide presentations to provide a variety of effects used for transitioning from one slide to the next. *Id.* at 120. As shown in Benedict’s Fig. 17.1, when this feature is selected from a pop-up menu, a user interface is presented in the form of an “Edit

ScreenShow Effects” dialog box. *Id.* This dialog box contains a text box labeled “Slide display time” which allows the user to set or change the duration time for which an individually selected slide will be displayed when shown in a “ScreenShow” slide presentation. *Id.* The dialog box also has an option for selecting a global duration time that would apply to all of the presentation slides. *Id.*

Notably, Benedict teaches that these display time and duration time features are available to its users only for purposes of initially creating or editing slides prior to when those slides will be displayed to a viewer in a self-running “ScreenShow” presentation. This is explained in the sub-section entitled “*Creating Self-Running Presentations*,” which states that in order “[t]o create a self-running presentation, you must set the display time for the slides and create the link that begins the presentation again.” *Id.* at 134; 135 (“To create a self-running presentation, access the Edit ScreenShow Effects dialog box...”).

Last, in the context of HyperShows—as opposed to ScreenShows—Benedict’s Table 17.3 sets forth a number of “HyperShow Destinations,” including “Next slide”, which enables the user to move to the next slide in the presentation, and “Previous slide”, which enables the user to move to the previous slide in the presentation. *Id.* at 124. Benedict teaches that HyperShows—again, as opposed to ScreenShows—are subject to such direct manual control by the viewer. *See, e.g., id.* at 123 (“HyperShows are more interactive than ScreenShows because viewers

control what slide appears next.”); *id.* at 116 (“HyperShow keys and buttons enable you to control the flow of your presentation spontaneously, without editing the original slide order.”).

C. Overview of Fox

Fox is a reference guide which describes itself as “three books in one,” with a section teaching “what the Web is, how to access it, and how to navigate around using a number of popular tools,” a section presenting a “toolbox” of available technologies with which to develop Web content, and a final section presenting a “tutorial on starting your own Web site.” EX1005 at 26-27. Petitioner draws on many different sections of Fox in order to support its argument, including sections describing basic terminology and technologies underlying the Web, sections describing common gateway interfaces (“CGIs”), and sections describing specific Web applications such as Netscape and Slipknot. Pet. at 19-25, 28-35.

The early sections of Fox describe technologies and terminologies required to understand the Web. For example, it discusses the navigation of web pages through links and the use of universal resource locator (“URL”) addresses to direct a browser to files or other resources on the Web. *See* EX1005 at 44-47, 49. Later sections of Fox discuss Web programming patterns and techniques such as CGIs, which are “any executable code, script, or program supported by the operating system that runs on your server” that are executed by the server in response to a request received by

the server; their output is delivered to the Web client from which the request originated. *Id.* at 408-409.

Other portions of Fox are concerned with design principles used when creating websites. For example, Fox discusses purposes for which websites can be useful to businesses and individuals, and the importance of implementing a consistent user interface on a webpage to maintain user engagement. *See id.* at 253, 262-263. These sections additionally provide information on how the HTML which makes up the visible content of webpages can be structured and customized to achieve the desired appearance of output text. *Id.* at 290. Other portions explain how meta tags can be used in HTML to instruct the browser to, for example, periodically reload a webpage. *Id.* at 324-324.

Lastly, some of the portions of Fox which Petitioner relies on are specific to Web applications from the era during which it was written. For example, Fox describes how to use SlipKnot, an early browser which was more limited than later browsers such as Mosaic and Netscape. *See id.* at 112. SlipKnot was slow and unable to support many Web features discussed elsewhere in Fox such as email, fill-in forms, and transparent images. *Id.*

D. Shimizu, in Combination with Benedict, Does Not Disclose or Suggest “creating a show structure of nodes” [1a, 10b, and 37a]

The claimed “nodes” are introduced in claim element 1[a], which recites “creating a show structure of nodes, each node identifying a resource from a plurality of accessible resources,” claim element 10[b], which similarly recites, *inter alia*, “creating a show structure of nodes, each node identifying a corresponding resource by recording a sequence of said resources,” and claim element 37[a], which similarly recites “creating a multidimensional show structure of nodes, each node identifying a resource from a plurality of accessible resources.” EX1001. These same “nodes” and/or their “show structures” are later described in claim elements 1[b]-1[c], 10[c]-10[e], and 37[b]-[c], which recite how the content of the “resources” identified by the “nodes” gets accessed and presented through the end-user’s computer in accordance with the show structure of nodes. *Id.*

As explained in the Claim Construction section above, here the term “node” should properly be construed as “an identifier of a resource that includes an address to the resource and the duration for which the resource's content is to be presented by default.” *Supra*, p. 8-10. In turn, the phrase “show structure of nodes” should be construed as “a structure that is arranged for the display of content by specifying one or more paths through a plurality of nodes. The show structure of nodes specifies the duration of any display.” *Id.*

Petitioner relies exclusively upon its base reference Shimizu as ostensibly supplying the “nodes” required by independent claims 1, 10, and 37. In particular, the Petition maps the claimed “nodes” to the “hypertext nodes” disclosed in Shimizu. Pet. at 11. As to the claimed “show structure of nodes,” the Petition alleges that it “corresponds to a set of nodes and their links or connections to other nodes” as disclosed in Shimizu, and Petitioner points to FIGS. 9 and 10 of Shimizu as allegedly providing representative examples. *Id.* at 11-12 (citing EX1003 at 6:30-35; 7:49-8:5; FIGS. 9 and 10). Finally, with regard to the “resources” for which the claimed “nodes” need to serve as *identifiers*, the Petition contends that they map to the items of so-called “entity information” disclosed in Shimizu which “may be a character string, image information, motion pictures, or sounds.” *Id.* at 13-14 (citing EX1003 at 5:55-59). For at least the three reasons detailed below, however, Shimizu’s hypertext nodes cannot possibly qualify as the recited “nodes” of independent claims 1, 10, and 37 as properly construed.

First, as discussed in the Claim Construction section above, the district court’s claim construction, the claim language itself, and the specification demonstrate that a node includes an address to a resource, which is separate and distinct from the node itself. Shimizu’s hypertext nodes do not serve as *identifiers* of separate and distinct “resources” consisting of content different from their own which gets presented/displayed to computer end-users in accordance with a show structure as

the claim language requires. Rather, in Shimizu the hypertext nodes *comprise* the “resources” because they actually *include* the items of “entity information” which Petitioner has alleged are the “resources,” and what Petitioner has labeled as *resource content* is in fact the informational content of the hypertext nodes themselves. As such, unlike Patent Owner’s claimed inventions, pursuant to Shimizu’s alleged show structures it is the hypertext nodes’ *own content* that gets presented/displayed to end-users instead of content belonging to distinguishable “resources” that the hypertext nodes have merely identified. Thus, here Petitioner’s mapping to Shimizu fails because it is a non sequitur to suggest that the hypertext nodes function as *identifiers* of themselves.

As explained in Shimizu’s background section, in hypertext systems the hypertext nodes have conventionally been used as the units for containing and holding the systems’ informational content. *See, e.g.,* EX1003 at 1:17-19 (“Hypertext apparatuses were first developed as a system capable of holding information in units called nodes ... [and of] **displaying character information held by the nodes**”) (emphasis added); *id.* at 1:23-28 (“Recent years have seen the advent of hypertext systems that handle *node-held information (called node information hereinafter)* composed of so-called multimedia information. Multimedia information comprises not only characters but also monochromatic and color images, sounds, and motion pictures.”) (emphasis added); *id.* at 1:41-45 (“Each **node**

comprises not only the so-called **node information representing the content of the node** but also a plurality of link information items for controlling the node information. These nodes together with their information constitute the main part of hypertext”) (emphasis added).

Consistent with the background prior art, Shimizu explains that in its own hypertext system the hypertext “[n]odes serve as the units of such information as text information, image information, sound information and motion pictures.” EX1003 at 6:1-3. Accordingly, it is clear that the items of “entity information” which Petitioner has mistakenly attempted to characterize as being “resources” that the hypertext nodes merely serve to identify—*e.g.*, the aforementioned “character string[s], image information, motion pictures, or sounds”—are actually *components of the hypertext nodes themselves* such that their content is informational content contained within the nodes. In other words, Petitioner’s “entity information” is simply a subset of hypertext “node information,” which Shimizu has expressly defined in the passages quoted above as being “node-held information” that “[e]ach node comprises.” Indeed, as Shimizu teaches, its system manages “such node information as character strings, images, motion pictures, and sound.” EX1003 at 6:40-41; *See also id.* at FIG. 11, step **107** (reading “entity information” from out of a node).

Further demonstrating that Shimizu's hypertext nodes are themselves the "resources" as opposed merely being resource **identifiers** as claimed, it is their **own content** that gets presented/displayed to computer end-users by Shimizu's alleged show structures rather than other different content belonging to separate and distinct "resources" as recited in independent claims 1, 10, and 37. Indeed, beginning with the Abstract, Shimizu teaches that the purpose of its alleged show structures is "to display the information held by each of the nodes in accordance with the link information." EX1003 at Abstract, 3:54-55, 4:20-23. Similarly, the Summary of the Invention repeatedly confirms that Shimizu's alleged show structures are for "defining the relations between the nodes so as to display the information held by each of the nodes in accordance with the link information." *Id.* at 4:20-22; *accord id.* at 3:46-49, 53-55, 62-63; 4:30-34. Shimizu's FIG. 9 provides a typical example of how its alleged show structures would function:

[T]he node information of the nodes linked successively according to the link information of node A is displayed. Specifically, the content of the node A is displayed first followed by the contents of nodes C, B, and D, in that order, inside the node content display area 81 of the window 80.

Id. at 7:60-65. Moreover, "FIG. 11 is a flowchart of steps in which the [show structure] embodiment displays the contents of the nodes in accordance with the order of their links," including step **105** wherein "items of ... node information start

to be displayed consecutively,” and step **107** in which content is read from out of the next node up for display to the end-user. *Id.* at 8:11-13, 33-34, 49-52.⁴ Because Shimizu’s nodes themselves comprise the content to be displayed, they do not satisfy a proper reading of the district court’s claim construction.

Unable to consistently maintain the Petition’s false distinction between Shimizu’s hypertext nodes and supposedly separate “information entity” resources, Petitioner likewise admits that it is actually the nodes’ own content that gets presented/displayed to end-users through Shimizu’s alleged show structures. *See, e.g.*, Pet. at 10 (Shimizu “discloses displaying content ... because **the content of each node** is presented in an organized (ordered) sequence.”) (emphasis added); *id.* at 16 (“Shimizu discloses ... **node content** is displayed before proceeding to the next node.”) (emphasis added). This same concession has likewise been made by Petitioner’s expert, Mr. Schmandt. *See, e.g.*, EX1002 ¶ 110 (in Shimizu’s show structures “**node content is displayed** to a user in a particular sequence as indicated by link information.”) (emphasis added); *id.* at ¶ 126 (Shimizu’s “display procedure

⁴ Similarly, in Shimizu’s own claim set, each of its independent claims is expressly directed to “nodes holding information” and to their alleged show structures that serve to “display the information held by each of said nodes in accordance with said link information.” EX1003.

slot 62...points to a program function or procedure used to display the **node content**") (emphasis added); *id.* at ¶ 49 ("Shimizu ... Figure 8 shows a user interface screen for presenting **node content** to the user.") (emphasis added).

In sum, Shimizu's hypertext nodes are not *identifiers* of separate and distinct "resources;" rather, they *are* the "resources" because they comprise the "entity information" content which gets presented/displayed to computer end-users through Shimizu's alleged show structures.

Second, Shimizu's hypertext nodes also do not qualify as the recited "nodes" of independent claims 1, 10, and 37 as properly construed because the Petition fails to demonstrate that they each "include[] an address" to a "resource" consisting of content different from their own. Here, Petitioner seeks to rely upon "entity information pointer slot **63**" as shown in FIG. 6 as ostensibly containing the required "addresses" in the form of pointers identifying the locations of "entity information" items that would ostensibly constitute the required "resources." Pet. at 15. However, Petitioner's theory is unpersuasive for several reasons. As an initial matter, FIG. 6 does not even depict a Shimizu hypertext node, but instead portrays a "node information structure 9" which is a data structure held by the node information management part 5 of the end-user's computer. EX1003 at 5:34-36, 6:44-48. This "node information structure" is distinguishable from a hypertext node. As Shimizu explains, "node information structures" are data structures that "hold[]...information

about each node.” *Id.* at 6:30-33. Such data structures are not themselves hypertext nodes, and at most are independent elements merely “associated with” those nodes. *Id.* at 9:18-20, 25-27, 41-42. Accordingly, even were it true that the “node information structure 9” shown in FIG. 6 contains a “resource” address, that would fail to establish that Shimizu’s hypertext nodes themselves—*i.e.*, the putative claimed “nodes”—“include[] an address to the resource” as required.

In any event, Shimizu teaches that the locations pointed to by the pointers of “entity information slot 63” are the locations of the hypertext nodes themselves, rather than addresses to “entity information” that is separate and distinct from those nodes. Indeed, Shimizu expressly recites that “Step **107** accesses and reads the entity information linked by the entity information pointer of the node information structure designated **by the pointer pointing to the acquired node.**” EX1003 at 8:49-52 (emphasis added). As stated in FIG. 11 at step 107, this is what allows the alleged Shimizu show structure to “read entity information from NODE-N” in order to “display the information in [the] node content display area.” The fact that “entity information” items are evidently accessed and read from out of the host locations of the hypertext nodes themselves should be expected because, as Patent Owner has demonstrated above, these items are actually **components of the hypertext nodes** and consist of informational content contained within the nodes.

Not surprisingly then, Shimizu describes the storage locations of hypertext nodes in the exact same terms as the storage locations for the “entity information” items that they comprise. *See, e.g.*, EX1003 at 1:43-45 (“These nodes together with their information constitute the main part of hypertext and are stored in primary or secondary storage”); *id.* at 2:52-53 (“nodes currently stored in primary or secondary storage.”); *id.* at 3:13-15 (“node information held by the nodes” is read from “primary or secondary storage”); *id.* at 6:39-41 (“node information [such] as character strings, images, motion pictures and sounds [are] stored illustratively in primary or secondary storage.”).

Finally, even were Petitioner somehow correct that the pointers of “entity information slot 63” point to unique locations where only the “entity information” items reside, those pointers would *not* be the claimed *resource addresses* because for all the same reasons that Patent Owner has previously established, the “entity information” items are not separate and distinct “resources” from Shimizu’s hypertext nodes as required.

Third, Shimizu’s hypertext nodes further fail to qualify as the recited “nodes” of independent claims 1, 10, and 37 as properly construed because the Petition does not establish that they each “include[] ... the [default] duration” for presenting/displaying content different from their own that belongs to some separate and distinct “resource.” Here, Petitioner seeks to rely upon two passages from

Shimizu as supposedly teaching this required default duration parameter. *See* Pet. at 16-19 (citing EX1003 at 3:9-16 (“it [is] possible to create an application program that may be displayed on the screen by reading, from primary or secondary storage and within a predetermined time, the node information held by the nodes that are linked sequentially”); *id.* at 5:11-14 (“This makes it possible to build with ease an application program illustratively causing the display of the nodes to be switched in a specific order and at predetermined intervals.”). However, Petitioner’s theory is unavailing on multiple grounds. As an initial matter, even if these “predetermined times” or “predetermined intervals” could be considered relevant default duration parameters, the Petition fails to prove that they would be **included within Shimizu’s hypertext nodes**—*i.e.*, the putative claimed “nodes” —as the governing claim construction expressly requires. If anything, Petitioner’s cited passages appear to suggest to the contrary that these ostensible default duration parameters would instead be features of the application programs used for managing Shimizu’s alleged show structures.

Moreover, Shimizu teaches that these ostensible default duration parameters would control how long the informational content **of the hypertext nodes themselves** would be presented/displayed, rather than how long separate resource content identified by the nodes would be shown to viewing end-users as required by a proper understanding of the claim construction of the term “nodes.” Indeed,

Petitioner's first cited passage at 3:9-16 refers to displaying the "node information held by the nodes," while its second cited passage at 5:11-14 likewise references the "display of the nodes." Similarly, Petitioner itself has repeatedly admitted that these Shimizu parameters actually serve to establish default durations for presenting **the hypertext nodes' own informational content**. *See, e.g.*, Pet. at 16 ("Shimizu discloses a default display time, *i.e.*, a 'predetermined' time or interval in which **node content** is displayed before proceeding to the next node.") (emphasis added); *id.* at 19 (POSITAs would have been motivated to make this parameter adjustable because "some **nodes** may have had **content** that was more complex than other nodes, thus justifying a longer display time to provide the user with more time to view and digest their content.") (emphases added).

In addition, these same concessions have also been made by Petitioner's expert witness, Mr. Schmandt. *See, e.g.*, EX1002 at ¶ 117 ("Shimizu discloses a default display time (*i.e.*, a 'predetermined' time or interval in which **node content** is displayed before proceeding to the next node)") (emphasis added); *id.* at ¶ 125 ("**nodes** may have included **content** that was more complex justifying a longer display time to provide the user with more time to view and digest the content.") (emphases added).

Even assuming Shimizu's hypertext nodes include durational information (which they do not), Shimizu's hypertext nodes do not comprise a "default" duration

that **can be changed**. Petitioner appears to acknowledge this in arguing that “Shimizu does not appear to disclose whether the **predetermined [default] intervals can be changed by a user**. But this would have been obvious in further view of Benedict.” Pet. at 16 (emphasis added). But Benedict does not disclose a default duration which can be changed. Instead, for Benedict, by default, slides are only changed by a user pressing a key:

The keys you use to move around in a ScreenShow are default keys. Default keys enable you to jump to a slide other than the next slide in the presentation. When you press a key that is not a default, the next slide in the presentation appears.

EX1004 at 00118.

Requiring a user to press a key is inconsistent with limitations 1[b], 10[c], and 37[b], which require accessing resources “without requiring user input.”

Petitioner relies on Figure 17.1 of Benedict, which “allows the user to specify how long a slide will be displayed before moving to the next slide.” Pet. at 17. But that time is not a default. As Benedict clearly states, “The default for the time is blank because **Harvard Graphics continues to display the slide until you press a key**. You can set a display time, however, by typing a time in the Slide display time: Text box.” EX1004 at 00121 (emphasis added).

Petitioner further argues that the display time allows the user to create self-running presentations. Pet. at 17. But once again, there is no default time for which

a slide will be presented. In order to create a self-running presentation, the user must override the default, which does not specify any duration and instead requires a key press to advance to the next slide. As Benedict explains, “To create a self-running presentation, you **must set the display time** for the slides” EX1004 at 00134.

In conclusion, because the “node” limitation as properly construed appears in each of the independent claims challenged herein (*i.e.*, claims 1, 10, and 37), the Petition’s failure to demonstrate that Shimizu’s hypertext nodes satisfy that limitation, or that Benedict cures Shimizu’s shortcomings, means that Petitioner is not reasonably likely to prevail in showing that any of the challenged claims in this proceeding would have been obvious under any of the grounds asserted.

E. Shimizu and Benedict Do Not Disclose or Suggest “Interactively Variable Duration Information” [1c; 11]

Claim element 1[c] and claim 11, which depends on independent claim 10, require “**interactively variable duration information.**” More specifically, claim element 1[c] recites “wherein said step of creating further comprises the step of providing an **interactively variable duration information**, representing the duration within which a corresponding content to said resource is being displayed so as to enable a user to vary said duration.” EX1001 (emphasis added). Claim 11 similarly recites “said step of creating further comprises the step of providing an **interactively variable duration information**, representing the duration within

which a corresponding content to said resource is being displayed.” EX1001 (emphasis added).

As explained in the Claim Construction section above, the phrase “interactively variable duration information” should properly be construed as “a parameter specifying how long a content is to be displayed by default before a subsequent content is displayed, where the viewer of the content can change the parameter.” (*Supra*, pp. 11-13). As further explained in that section, this construction requires that a computer user who is the viewer of the show structure resources must be able to change the default duration time for how long the content of a particular resource is presented *while that content is actually being presented/displayed to the viewer pursuant to a show structure playback. Id.* In other words, the claim language requires that while “interactively variable duration information” must be *provided* during the preliminary step of creating a show structure, it must be *capable of being varied* by a viewer during the subsequent step of presenting/displaying the show structure’s resource content to that viewer. *Id.*

The Petition alleges that the hypertext nodes disclosed in its Shimizu base reference include default duration parameters for how long the content of their corresponding resources are to be presented/displayed as called for by the governing claim construction for “nodes.” Pet. at 16, 18 (citing EX1003 at 3:9-16, 5:11-14). However, Petitioner admits that “Shimizu does not appear to disclose whether the

predetermined [duration] intervals can be changed by a user” as would be required by the “interactively variable duration information” limitation recited in claim element 1[c] and claim 11. *Id.* at 16; *Accord* EX1002 ¶ 118 (“Shimizu does not appear to disclose ... whether such intervals between nodes can be changed.”). The Petition thus seeks to rely upon Benedict for ostensibly supplying this missing limitation to its proposed Shimizu/Benedict combination. *Id.* at 18 (“the content resources of a node would have been displayed for a predetermined (default) interval as disclosed in Shimizu, which the user could have changed in accordance with Benedict.”); *accord at id.* at 25-28; EX1002 ¶ 148.

By way of background, the Petition indicates that POSITAs would have looked to Benedict as analogous prior art for combining with Shimizu because both are purportedly “in the same field of organized and sequenced presentation of content” to computer users. Pet. at 18. More specifically, the Petition describes Benedict as disclosing “Harvard Graphics software that, similar to Microsoft PowerPoint, allowed users to create computer-based slide presentations.” Pet. at 16; *see also* EX1002 ¶¶ 52, 121. Similar to its contentions about Shimizu, Petitioner suggests that Benedict provides teachings of relevance to Patent Owner’s claimed “nodes” and “show structures of nodes.” For example, the Petition asserts that “nodes ... are represented as slides” in Benedict. Pet. at 59. Moreover, the Petition analogizes the “show structures of nodes” to the so-called “ScreenShow” slide

presentations in Benedict which in some embodiments can display their slides on a computer screen in sequential order one after the other in an automatic “self-running presentation.” Pet. at 23-26.

The Petition presents two alternative independent theories for how Benedict ostensibly teaches the claimed “interactively variable duration information” limitation, with each theory relying upon a different Benedict disclosure. First, the Petition touts the “Edit ScreenShow Effects” feature in Benedict, which allows for slides to be shown in a self-running “ScreenShow” slide presentation, which transitions from one slide to the next. Pet. at 17-18, 23, 25-26. As shown in Benedict’s Fig. 17.1, when this feature is selected from a pop-up menu, a user interface is presented in the form of an “Edit ScreenShow Effects” dialog box. *Id.* This dialog box contains a text box labeled “Slide display time” which allows the user to set or change the duration time for which an individually selected slide will be displayed when shown in a “ScreenShow” slide presentation. *Id.* The dialog box also has an option for selecting a global duration time that would apply to all of the presentation slides. *Id.* According to the Petition, because this feature allows a user “to edit the display time for each slide individually or for all slides,” the “duration information for a node ... can be interactively varied by the user” in satisfaction of the pertinent claim limitation. Pet. at 26.

Under Petitioner’s first theory, however, Benedict actually fails to teach “interactively variable duration information” as properly construed because there is no evidence whatsoever that the “Edit ScreenShow Effects” feature would be available to viewers of the show structure content for changing the display duration for how long the content is being presented *while they are actually viewing that presentation*. To the contrary, all evidence demonstrates that Harvard Graphics software makes this feature available to its users only for purposes of initially creating or editing slides *prior to* when those slides will subsequently be displayed to a viewer in a self-running “ScreenShow” presentation. Mapping to claim 1, the “Edit ScreenShow Effects” feature would thus allow the durations for resource content to be varied during the preliminary claimed step of “creating a show structure,” but *not* during the later claimed step of automatically presenting the show structure’s resource content “through said user’s computer” to an intended viewer as the claim language requires.

Indeed, Benedict presents its “Edit ScreenShow Effects” feature in a chapter entitled “*Creating ScreenShows and HyperShows.*” EX1004 at 00116, 00119-00122. The specific functionality that Petitioner relies upon within that feature allowing for setting and changing the default duration display times for slides is discussed under a further subheading entitled “*Creating Self-Running Presentations,*” and its accompanying text states that in order “[t]o create a self-

running presentation, you must set the display time for the slides and create the link that begins the presentation again.” *Id.* at 134; *cf. id.* at 00135 (“To create a self-running presentation, access the Edit ScreenShow Effects dialog box...”). For its part, Petitioner acknowledges that the “user for purposes of ... [the Edit ScreenShow Effects feature] would be the user creating or editing the presentation” Pet. at 26. Moreover, Petitioner likewise concedes that this feature’s variable “display time [functionality] allows the user to create ‘self-running’ presentations that advance to the next slide after a specified period. *Id.* at 17-18.

Second, as an alternative theory for how Benedict supposedly teaches “interactively variable duration information,” the Petition purports to rely upon a completely different disclosure pertaining to *skip button functionality* which is described as allowing a user the “ability to skip to another node during display of node content.” Pet. at 26-27 (citing EX1004 at 00121, 00124). Here, the example of skip button functionality identified by the Petition is Benedict’s “Next slide” button which when pressed by the user “[m]oves to the next slide in the presentation.” EX1004 at 00124. According to Petitioner, this “Next slide” button constitutes “a second and independent way of showing ‘**an interactively variable duration information**’” as properly construed. Pet. at 26 (emphasis in original).

Here the Petition’s second theory must fail, however, because Petitioner does not support it with any affirmative arguments or evidence of its own despite bearing

the burden of proof in these proceedings. **To the contrary, Petitioner actually acknowledges that it disagrees with this theory and believes it to be incorrect.** *See, e.g.*, Pet. at 27 (“Petitioner does not concede that this [skip button] functionality satisfies the claim” limitation); EX1002 ¶ 146 (“I am further informed that Petitioner does not agree that such [skip button] functionality satisfies the requirement of interactively variable duration information.”). Perhaps needless to say, Petitioner enjoys no reasonable likelihood of success for prevailing on a theory herein which it does not consider to be correct has not directly advocated for.

In lieu of providing any affirmative arguments or evidence of its own, Petitioner instead seeks to rely solely on the premise that Patent Owner has somehow previously made an admission that *skip button functionality* would satisfy the “interactively variable duration information” limitation. In this regard, the Petition asserts that “Patent Owner in the pending litigation appears to be taking the position that this limitation is satisfied by a user’s ability to skip to another node during the display of node content.” Pet. at 26-27. *See also* EX1002 ¶ 146 (“I am informed that in the pending litigation, Patent Owner has taken the position that a user can interactively vary the duration through a user interface control that allows the user to skip or advance to the next item.”). As its only evidence of this supposed “admission,” the Petition points to ¶ 27 of the Complaint filed in the parties’ “Related Matters” litigation. Pet. at 26-27 (citing EX1029). **But as any review of ¶**

27 will confirm, Petitioner’s contention that such an “admission” was made is an outright falsehood given that this passage nowhere even references or addresses *skip button functionality* at all.⁵ Rather, the only accused functionality mentioned therein is a completely different “scrubber bar interface” used for varying display duration within the resource content of a single node. Accordingly, Petitioner’s efforts to manufacture a dispositive “admission” against interest by Patent Owner must fail.

Finally, it is noteworthy that Benedict does not even teach the use of its “Next slide” buttons in relation to the self-running “ScreenShow” presentations that Petitioner seeks to analogize to the claimed “show structures of nodes.” Instead, as Petitioner admits, the “Next slide” buttons are a feature only of Benedict’s “HyperShow” presentations. Pet. at 34. In complete contrast to the *claimed “show structures”* wherein node resources are presented to the viewer “automatically” and “without requiring user input,” Benedict’s HyperShows are subject to direct manual control by the viewer. *See, e.g.*, EX1004 at 00123 (“HyperShows are more

⁵ Equally false is what the Petition characterizes as “Patent Owner’s own theory” which is founded upon the same ostensible “admission” that was never in fact made. Pet. at 27. Patent Owner has never espoused this alleged theory at any time in any forum.

interactive than ScreenShows because viewers control what slide appears next.”); *id.* at 00116 (“HyperShow keys and buttons enable you to control the flow of your presentation spontaneously, without editing the original slide order.”). In resting upon the false premise of a Patent Owner “admission,” Petitioner never bothered to address this discrepancy.

In conclusion, because the “interactively variable duration information” limitation as properly construed appears in independent claim 1, the Petition’s failure to demonstrate that Benedict discloses that limitation means that Petitioner is not reasonably likely to prevail in showing that any of the challenged claims in Ground 1 would have been obvious. For the same reason, Petitioner is not reasonably likely to prevail in showing that claim 11 would have been obvious.

F. Petitioner Has Failed to Establish a Motivation to Combine or Reasonable Expectation of Success

First, the Petition relies on Benedict for a number of claim elements admittedly absent from Shimizu, but fails to establish that a POSITA would have been motivated to combine Shimizu with Benedict, or that a POSITA would have had a reasonable expectation of success in doing so. Rather, in its barebones attempt to rationalize why a POSITA would have been motivated to combine Shimizu with Benedict and had a reasonable expectation of success in doing so (which appears to rely almost exclusively on its expert’s opinion that is improperly incorporated by

reference in violation of 37 CFR § 42.6(a)(3) to avoid exceeding the word count limits of 37 CFR § 42.24), Petitioner attempts to equate Shimizu's alleged disclosure of displaying node content in a sequential order with Benedict's disclosure of displaying slides in a sequential order. *See* Pet. at 16-19. However, Petitioner (correctly) does *not* allege that Benedict discloses nodes consistent with the district court's claim construction or any other teachings of the '451 Patent, or even content derived from a plurality of resources. Petitioner contends that a single resource corresponds to a single data file. *See* Pet. at 10. It thus follows that because Benedict discloses a single data file, namely a presentation file, it discloses content from a single resource. Petitioner fails to explain why a POSITA would have been motivated to combine the alleged disclosure from a reference comprising a plurality of resources (Shimizu) with one comprising only a single resource (Benedict) or had a responsible expectation of success in doing so, so its argument has no merit and should be given little weight.

Petitioner's motivation to combine argument is also unavailing for an additional reason. By way of background, Petitioner argues, as part of its motivation to combine argument, that "Shimizu ... discloses displaying node content for a 'predetermined' time or interval before switching to the next node." Pet. at 18. As discussed herein in § V above, Petitioner relies on two passages from Shimizu as supposedly teaching the required default duration. *See* Pet. at 16, 18-19 (citing

EX1003 at 3:9-16 (“it [is] possible to create an application program that may be displayed on the screen by reading, from primary or secondary storage and within a predetermined time, the node information held by the nodes that are linked sequentially”); *id.* at 5:11-14 (“This makes it possible to build with ease an application program illustratively causing the display of the nodes to be switched in a specific order and at predetermined intervals.”).

As an initial matter, the passages relied on do not provide any specifics as to *how* duration information would be implemented. Instead, they are merely speculative and aspirational statements, postulating only about what is “possible.” Petitioner further argues that Shimizu’s disclosure that it is “possible” to create a system “that emphasizes temporal relations between nodes (e.g., chronological tables),” somehow “suggests the ability to vary the display duration between nodes.” Pet. at 18. But Petitioner offers no explanation as to how this disclosure in Shimizu suggests varying the display duration or how it suggests the claimed requirement (in claims 1 and 11) of “*interactively variable* duration information.”

Moreover, it is not sufficient for Shimizu to simply teach a time interval between nodes. Rather, as discussed in the Claim Construction section above, **the node itself must “include ... the duration** for which the resource’s content is to be presented by default.” EX1023 at 16 (emphasis added). The Petition fails to provide any argument or evidence demonstrating that the described predetermined intervals

are included in Shimizu's nodes. Instead, the passages Petitioner relies on teach only that the "predetermined time" would be associated with the **application program** used to display the nodes.

Because Petitioner has failed to show that Shimizu discloses **nodes, which include a default duration**, its arguments concerning an alleged motivation to combine with Benedict must similarly fail.

Second, the Petition relies on Fox for a number of claim elements absent from Shimizu and Benedict, but fails to establish that a POSITA would have been motivated to combine Fox with Shimizu and Benedict, or that a POSITA would have had a reasonable expectation of success in doing so. The '451 Patent claims are directed to technology for sequencing networked content, such as content accessible over the Web, for display according to a show structure of nodes. *See* EX1001 at 1:14-18 ("This invention relates generally to computer networks, and **specifically to a method of sequencing and scheduling web pages**, via a suite of software applications.") (emphasis added), 10:49-58. Petitioner admits that Shimizu and Benedict "do not expressly disclose a system in which content resources are accessible via the Web." Pet. at 19. Petitioner instead contends that a POSITA would have combined Fox's alleged disclosure of navigating the Web with Shimizu and Benedict to yield the claimed inventions. *Id.* at 19-20. But Petitioner has failed to establish that a POSITA would have been motivated to combine Fox, which is

directed to software for displaying Web resources, with Shimizu and Benedict, which are both directed to software for displaying content accessed locally, or from the same computer on which the applications of Shimizu and Benedict run.

Shimizu does not disclose accessing resources from the Internet, the World Wide Web, or any other computer network; Petitioner contends that Shimizu's disclosure of "secondary storage" could refer to network-accessible storage, but point to no supporting disclosure within Shimizu or elsewhere suggesting such an interpretation. *Id.* at 19 (citing EX1003 at 6:39-43, 2:49-53). Similarly, Benedict does not disclose accessing resources from the Internet, World Wide Web, or any other computer network as a source for content, as Petitioner admits. *Id.*

In recognition of these deficiencies, Petitioner posits that it would have been obvious to combine Shimizu's and Benedict's alleged teachings of applications for accessing and displaying local content with Fox's alleged teachings of an application for accessing and displaying Web content. *Id.* at 20-22. However, Petitioner, nor its expert, provide no explanation as to how a POSITA would overcome the inherent technical difficulties involved accessing a Web, which Fox explains involve locating a host computer, establishing a connection with the appropriate port of said host computer using the appropriate protocol, and receiving and decoding a Web resource located on the host, then displaying that Web resource within an application, along with locally-stored content. *See* EX1005 at 0049-50.

Unable to point to any portion of Fox (or any other reference) which explains how these technical challenges would be overcome, Petitioner is instead silent on the issue. Because Petitioner has failed to establish why a POSITA would have been motivated to make such a combination or have had a reasonable expectation of success in doing so, Petitioner's argument has no merit and should be given little weight.

VI. CONCLUSION

Petitioner has failed to meet its burden under 37 C.F.R. § 42.108(c) of showing a reasonable likelihood of prevailing against any challenged claim. The Board should further deny institution under 35 U.S.C. § 314(a) in light of parallel proceedings. As such, Patent Owner respectfully requests that the Board deny institution of an *inter partes* review.

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Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), counsel for Patent Owner Robocast, Inc. certifies that this document complies with the type-volume limitation of 37 C.F.R. § 42.24(b). According to Microsoft Office Word's word count, this document contains 13,855 words, including any statement of material facts to be admitted or denied in support, and excluding the table of contents, table of authorities, mandatory notices under § 42.8, exhibit list, certificate of service or word count, or appendix of exhibits or claim listing.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** was served electronically via e-mail on June 20, 2023, in its entirety on the following counsel of record for Petitioner:

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