

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 No. 7,155,451

PATENT OWNER'S PRELIMINARY SUR-REPLY

In accordance with the Board’s conference call held on July 26, 2023, Patent Owner hereby submits its Preliminary Sur-Reply in response to Petitioner’s Preliminary Reply (Paper 10).¹

Patent Owner’s Preliminary Response previously demonstrated that the Delaware district court’s prior construction of the “interactively variable duration information” limitation of claim 1 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 is displayed *while that content is actually being displayed to the end user pursuant to a show structure*. POPR 11-13. Indeed, in its *Markman* Order, the district court expressly explained 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

¹ Petitioner’s Preliminary Reply is a classic “bait and switch” inconsistent with the spirit of what the Board authorized. After arguing in a July 20th email and during the conference call that it needed a full 5-page reply brief in order to address three different significant issues, Petitioner has now completely disregarded its two lead issues and devoted the entire 5 pages exclusively to raising new claim construction arguments. Moreover, these new arguments violate the letter of 37 C.F.R. § 42.33(b).

added). Furthermore, Patent Owner also showed that in a prior closely related IPR proceedings involving the challenged '451 patent, a similarly constituted Board panel to here has already embraced this understanding of the district court's construction and adopted and applied it in denying institution. *See Netflix, Inc. v. Robocast, Inc.*, IPR2023-00081, Paper 19 at 13-17, 35, 46-47 (May 11, 2023)(“'0081 Inst. Den.”).

Petitioner now newly argues that Patent Owner has misinterpreted the district court's construction, which ostensibly “does not limit when the viewer must be able to change the duration parameter,” and thus could encompass the ability to interactively vary duration information “before...content display” such as when “creating or editing a show structure” pursuant to the claim's initial “creating” step. Reply 1-4. In defense of this reading, Petitioner first baldly asserts without supporting evidence that the district court's use of “should” language when explaining its claim construction was merely “permissive” in nature, meaning that the ability to vary duration during show structure playback would be allowable but not required. To the contrary, however, “should” is commonly understood as conveying that which is obligatory in nature. *See, e.g., [Should - definition of should by The Free Dictionary](#)*. This is precisely how the prior '0081 Board correctly comprehended it. *See* ('0081 Inst. Den. at 14)(“[T]he *Microsoft* court expressly states that the duration is varied during show structure playback, which is a clear

reference to claim 1's step of 'displaying content corresponding to each of said resources automatically in accordance with said show structure.'").

Petitioner next argues that the district court's explanation as to the intended meaning of its construction was not part of the court's "actual construction," and that there supposedly is "[n]othing in this [actual] construction" which would itself restrict interactive variability to needing to be available during show structure playback. Reply 1-2. But Petitioner is wrong on both counts. First, there is no legitimate basis for disregarding the court's explanation of its claim construction merely because it appears in the text portion rather than the claim charts portion of the *Markman* Order. Second, restrictions consistent with the court's explanation do in fact appear in the "actual construction." Indeed, the formal construction expressly requires that the ability to interactively vary duration information must be present at the time when the claimed computer end-user is acting as a "viewer of the content," which only occurs during the displaying playback step. By contrast, Petitioner now effectively admits that the end-user would *not* be a "viewer" as the construction requires during the earlier step of creating/editing a show structure because that "step obviously occurs prior to the display of content associated with the show structure." *Id.* at 3-4 (content might only "later be viewed by the user in accordance with the show structure" after the creating/editing has been finished); *id.* at 2 (creating/editing step occurs "before...content display.").

Recognizing the possibility that Patent Owner has correctly characterized the district court's construction, Petitioner also alternatively argues that such a construction is erroneous for allegedly being "inconsistent with the intrinsic record." Reply 4-5. But any such argument first raised in a reply brief must be disregarded as violative of 37 C.F.R. § 42.104(b)(3). In its Petition, Petitioner never took issue with any aspect of the court's construction, and instead contended that the "prior art cited herein, as demonstrated below, renders the challenged claims obvious under the district court's constructions." Pet. 8.

In any event, here Petitioner ignores the most important intrinsic evidence of all -- the claim language -- which is fully consistent with the requirement that duration information be interactively variable during show structure playback. As the prior '0081 Board properly found, the plain language of claim 1 recites such duration information in the "displaying" step, and characterizes it as "representing the duration within which a corresponding content to said resource is being displayed so as to enable a user to vary said duration," suggesting that a user is interacting with the variable duration information parameter during the displaying step. *Cf.* '0081 Inst. Den. at 16.

Petitioner's misguided charges of "inconsistency" with the intrinsic record likewise ignore the relevant prosecution histories. For example, in the file wrapper for the challenged '451 patent, the applicant explained "interactively variable

duration information” in its winning appeal brief as allowing the user to vary duration for how long resource content currently “is being displayed” to the user “in accordance with the show structure.” EX1024 at 00332. Similarly, in an earlier response to an office action, the applicant indicated that this same claim term implicated how “a user can speed up or slow down the rate at which the consecutive resources are being displayed” to that user via a show structure. *Id.* at 00177.

Ultimately, Petitioner’s only proffered evidence of “inconsistency” rests upon its contention that the ’451 patent’s “written description provides numerous examples of changing the display duration prior to display.” Reply 4. But even assuming *arguendo* that Petitioner has accurately described such examples, they are in no sense “inconsistent” with the district court’s construction because they simply fail to implicate the claimed “interactively variable duration information,” and nothing in those embodiments purports otherwise. Meanwhile, the prior ’0081 Board identified multiple other specification embodiments which it believed are fully consistent with the court’s construction, yet Petitioner has now knowingly declined to address any of them in its reply brief. *See* Instit. Den. at 16-17 (citing ’451 patent at 10:49-11:43).

Finally, Patent Owner has already demonstrated that the Petition’s theories must fail under a proper reading of the district court’s construction. POPR 48-56.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on this 11th day of August, service of the foregoing PATENT OWNER’S PRELIMINARY SUR-REPLY was made on the counsel of record for the Petitioner by filing this document through the Patent Trial and Appeal Board’s P-TACTS System as well as delivering a copy via electronic mail to the following address:

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