UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC and YOUTUBE, LLC,
Petitioner

v.

ROBOCAST, INC.,
Patent Owner

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Case IPR2023-00592
Patent 8,965,932 B2

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**PETITIONER'S PRELIMINARY REPLY**[1]

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[1] Petitioner is also concurrently filing this preliminary reply (without substantial change) in IPR2023-00590 and IPR2023-00594, which address U.S. Patent Nos. 7,155,451 and 8,606,819, respectively.

As authorized by the Board during the conference call of July 26, 2023, Petitioner respectfully submits the following preliminary reply to address claim construction issues relating to "**interactively variable duration information**."

## I. The District Court's Construction of "Interactively Variable Duration Information" Does Not Limit When the Viewer Must Be Able to Change the Duration Parameter.

Patent Owner contends that the district court's construction requires that the viewer "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*." (POPR, Paper 9, at 11 (italics in original).)[2] But the district court's actual construction – which is binding on neither the Board nor Petitioner – was simply: "a parameter specifying how long a content is to be displayed by default before a subsequent content is

[2] Petitioner notes at the outset that the Petition presented an obviousness theory that satisfies Patent Owner's current proposed construction. (Petition at 26-28.) If this theory has a reasonable likelihood of prevailing, the Board may institute IPR and defer the claim construction issue for decision based on the post-institution evidentiary record, if necessary to issue a final written decision. *See Well-man, Inc. v. Eastman Chem. Co*., 642 F.3d 1355, 1361 (Fed. Cir. 2011) ("[C]laim terms need only be construed to the extent necessary to resolve the controversy.").

displayed, where the viewer of the content can change the parameter." (EX1023, 0022.) Nothing in this construction places restrictions on when the viewer must be able to change the parameter. The construction thus allows the user to change the default duration parameter either before or during content display. In fact, the district court declined to adopt Patent Owner's proposed construction that expressly stated that the time "may be varied by the user during display." (EX1023, 0022.)

Patent Owner's position appears to be based on the first two sentences in the district court's reasoning, appearing within the passage quoted below:

> The Court 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. The Court, however, also finds that some duration information must be provided when the show structure of nodes is created. Whether the software automatically assigns a preset time period or the user chooses one, the "interactively variable duration information" is provided contemporaneously with "said step of creating [a show structure of nodes]."

(EX1023, 0023.) Patent Owner relies on the first two sentences to argue that the court's construction requires users to be able to change the duration of display during display of the content – despite the fact that this language does not appear in the construction actually adopted by the court, and the fact that the court used permissive language ("should be able") in describing this alleged requirement.

And the very next sentence in the passage above further calls into question Patent Owner's argument. It begins with "[t]he Court, however," with the word "however" indicating an intention to contrast or deviate from what was just stated. The Court went on to observe that "**interactively variable duration information**" appears within the step of creating the show structure of nodes – a step that obviously occurs prior to the display of content associated with the show structure. The claim thus requires "**providing**" interactively variable duration information as part of the pre-display step of show structure creation.

Nor is there any magic to the word "**interactively**," which simply refers to the ability of the user to change the duration parameter. The court observed that "[w]hether the software automatically assigns a preset time period or the user chooses one, the 'interactively variable duration information' is provided contemporaneously with 'said step of creating [a show structure of nodes].'" (EX1023, 0023 (emphasis added).) A user can thus "**interactively**" change a display duration by choosing a different duration when creating or editing a show structure, whose content can later be viewed by the user in accordance with the show structure.

Petitioner thus respectfully agrees with Judge Cygan's dissenting opinion in *Netflix, Inc. v. Robocast, Inc.*, IPR2023-00081, Paper 19, at 65-66 (PTAB May 11, 2023). The majority in *Netflix* concluded that, based on the district court's construction, the term requires "providing a variable duration parameter in the

creating step, but that parameter is capable of being varied by the user during the displaying step." *Id.* at 14-15 (emphasis added). Aside from the issues identified by Judge Cygan and above, the Board overlooked the fact the patent identifies post-creation periods other than display (discussed below), such as editing an existing show structure, in which the user can interactively vary the duration.

Thus, even if the Board were to (incorrectly) conclude that "**interactively variable duration information**" requires that duration information be changeable by a user after creation of the show structure, it does not necessarily follow that it must be changeable during display. There is no basis, for example, to narrow the claim to exclude changing duration when editing an existing show structure, by a user who later views the content. (Petition at 25-27; POPR at 51-52.)

## II. Requiring that the User Be Able to Change the Duration Parameter During Display Is Inconsistent with the Intrinsic Record.

The written description provides numerous examples of changing the display duration prior to display. First, the "RoboPublisher" embodiment expressly allows a user, during creation or editing of a show structure, to change the display duration. ('932, 14:21-24 ("FIG. 6 is a flow chart diagram that is useful for describing the operation of a RoboPublisher program, which is the publishing tool used to create and modify show structures for viewing via RoboGuide, RoboSurf and/or Robosites."), 14:35-40 ("At step **212** [of Figure 6] the user is presented with a dialog box. At step **214** the user is presented with the dialog box options for setting…

duration for all resources…."), 14:56-63 ("At step **228** the Modify Choice selection gives the user options **230** to edit the parameters of the 'next' node… [including] how long the node will be displayed before a subsequent node is loaded. This can be done on a per resource basis, since some resources require more time than others.").) Second, a user can change display duration when pressing the "Play" button, which begins presentation of information. ('932, 16:25-31; *see also id.*, 16:27-29 ("… the Play button also lets a user set parameters such as… length of time each item is displayed….").) This feature likewise does not require that the particular content, whose duration is being changed by the user, be currently displayed. Patent Owner has offered no justification for excluding these embodiments from the claimed "**interactively variable duration information**."

Moreover, claim 12 of the '932 patent expressly requires displaying interactively variable duration information "during presentation of said content." (EX1001 at 18:27-29.) The applicant thus knew how to write claims expressly requiring that actions relating to "**interactively variable duration information**" take place during display of the content. Had he intended such a requirement to apply to interactively changing the duration parameter, he would have written the claims to so require.

For the foregoing reasons, therefore, Patent Owner's proposed construction should be rejected, and IPR should be instituted on all grounds.

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Respectfully submitted,

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## CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Section 42.6, that the attached **PETITIONER'S PRELIMINARY REPLY** is being served via electronic mail on the 2nd day of August 2023 upon the Patent Owner's attorneys of record in this proceeding as follows:

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