

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

STARZ ENTERTAINMENT, LLC, STARZ,	)	
LLC, STARZPLAY MANAGEMENT US,	)	
LLC, and STARZPLAY US, LLC,	)	C.A. No. 21-1448-JLH
	)	
Plaintiffs/Counter-Defendants,	)	
	)	JURY TRIAL DEMANDED
v.	)	
	)	
VL COLLECTIVE IP, LLC and	)	
VIDEOLABS, INC.,	)	
	)	
Defendants/Counter-Plaintiffs.	)	

STARZ’S SECOND AMENDED DISCLOSURE OF INVALIDITY CONTENTIONS

I. INTRODUCTION

Pursuant to Section 5 of the Court’s Scheduling Order (D.I. 18), the parties’ stipulations amending the Scheduling Order (D.I. 39, 44, 47, 48, 54, 164), and the parties’ Stipulations to Amend Infringement and Invalidity Contentions (D.I. 99, 169), Plaintiffs/Counter-Defendants Starz Entertainment, LLC; Starz, LLC; StarzPlay Management US, LLC; and StarzPlay US, LLC (collectively, “Starz”) hereby provide their second amended invalidity contentions.

Starz’s second amended invalidity contentions address U.S. Patent No. 7,233,790 (“the ’790 patent”); U.S. Patent No. 7,440,559 (“the ’559 patent”); and U.S. Patent No. 8,605,794 (“the ’794 patent”) (collectively, “the asserted patents”). Defendants VL Collective IP, LLC and VideoLabs, Inc. (collectively, “VideoLabs”) assert claims 1, 2, 4, 5, 6, 7, 8, and 9 of the ’790 patent, claims 1, 2, and 4 of the ’559 patent, and claims 1, 3, 5, 9, 12, 13, 15, 16, 17, 20, and 21 of the ’794 patent (collectively, “the asserted claims”).

II. GENERAL RESERVATIONS

The contentions set forth below are contentions as required in the Scheduling Order. Starz reserves the right to revise or supplement these contentions in light of party and third-party

discovery, any amendments to VideoLabs' infringement contentions, any review and analysis by expert witnesses, and further investigation and discovery regarding the claims and defenses asserted by the Parties. For example, Starz expressly reserves the right to amend these contentions after review of any further amendments to VideoLabs' infringement contentions, after disclosure by VideoLabs of any information that it failed to provide in its disclosures under the Scheduling Order and/or the applicable rules of this Court, or after VideoLabs otherwise amends its disclosures in any way. Further, because discovery is ongoing, Starz reserves the right to revise, amend, and/or supplement the information provided herein, including identifying other bases of invalidity based on the identified and charted references, and also charting and relying on additional references. Further, Starz reserves the right to revise, amend, or supplement its invalidity contentions when VideoLabs provides additional discovery. Further, Starz reserves the right to revise its ultimate contentions concerning the invalidity of the asserted claims, which may change depending upon further and ongoing investigation, further construction of the asserted claims and/or positions that VideoLabs or expert witnesses may take concerning infringement, and/or invalidity issues.

Prior art not included in this disclosure, whether known or not known to Starz, may become relevant. In particular, Starz is currently unaware of the extent, if any, to which VideoLabs will contend that limitations of the asserted claims are not disclosed in the prior art identified by Starz. To the extent that such an issue arises, Starz reserves the right to identify other prior art that would anticipate and/or render obvious the allegedly missing limitations of the claims, alone and/or in combination with identified or additional prior art. Further, Starz reserves the right to rely on any prior art or item sought or to be sought from third parties that are solely within those third parties' possession, custody, or control and have not yet been produced during discovery. Starz reserves

the right to rely on any prior art found in the prosecution histories of the applications leading to the asserted patents or otherwise identified in connection with this litigation.

For claim limitations construed by the Court, Starz's contentions have interpreted the claim language consistent with the Court's Claim Construction Order (D.I. 88). To the extent that the following contentions reflect interpretations of other claim limitations consistent with or implicit in VideoLabs' infringement allegations as set forth in VideoLabs' Counterclaims or infringement contentions, no inference is intended nor should any be drawn that Starz agrees with VideoLabs' infringement allegations or claim interpretations, and Starz expressly reserves the right to contest such allegations. Starz offers such contentions in response to VideoLabs' infringement allegations as set forth in the Counterclaims and infringement contentions. Specifically, Starz bases these invalidity contentions at least in part upon the claim scope and certain claim interpretations that are implicitly or explicitly asserted by VideoLabs, and nothing herein should be construed or represented as evidencing any express or implied agreement with any of VideoLabs' claim construction or infringement positions.

Starz intends to rely on admissions concerning the scope of the prior art relevant to the asserted patents found in, *inter alia*, the asserted patents and related patents and/or patent applications (both foreign and domestic); the patent prosecution histories for the asserted patents and related patents and/or patent applications (both foreign and domestic) (including all prior art cited therein); any deposition testimony of the named inventors on the asserted patents and related patents and/or patent applications (both foreign and domestic) in this matter or any other matter; evidence and testimony relating to the level of ordinary skill in the art; and the papers filed and any evidence submitted by VideoLabs in connection with this matter.

Starz's claim charts cite to particular teachings and disclosures of the prior art as applied to features of the asserted claims. However, persons having ordinary skill in the art generally may view an item of prior art in the context of other publications, literature, products, and understanding. As such, the cited portions are only examples, and Starz reserves the right to rely on uncited portions of the prior art references and on other publications, expert testimony, and other evidence as aids in understanding and interpreting the cited portions, as providing context thereto, and as additional evidence that the prior art discloses a claim limitation or any of the asserted claims as a whole. Starz further reserves the right to rely on uncited portions of the prior art references, other publications, and testimony, including expert testimony, to establish bases for combinations of certain cited references that render the asserted claims obvious.

The references discussed in the claim charts may disclose the elements of the asserted claims explicitly and/or inherently, and/or they may be relied upon to show the state of the art in the relevant timeframe. The suggested obviousness combinations are provided in addition to and/or in the alternative to Starz's anticipation contentions and are not to be construed to suggest that any reference included in the combinations is not by itself anticipatory. The combinations of prior art references referred to in these invalidity contentions are exemplary. Starz reserves the right to rely on any combination of prior art references to the extent that such prior art references are identified in Starz's contentions served in accordance with the Scheduling Order. The rationale or motivations to combine the prior art references identified in these invalidity contentions are also exemplary. As discovery is ongoing, Starz reserves the right to amend or supplement the rationale or motivation to combine the prior art references identified in these contentions.

The following discussion and exhibits provide exemplary prior art citations and obviousness positions. The citations and discussion in the charts are organized by claim (and claim

limitation) for convenience, but each limitation or claim section applies to the larger context of each claim, any related dependent or independent claims, and all claims containing similar limitations or elements. For example, citations as to any recited limitation, step, or component in the claims apply wherever each such limitation, step, or component is repeated elsewhere in the claims or asserted patents. Where Starz cites to a particular drawing or figure in the attached claim charts, the citation encompasses the description of the drawing or figure as well as any text associated with the drawing or figure. Similarly, where Starz cites to particular text concerning a drawing or figure, the citation encompasses that drawing or figure as well as any other text associated with the drawing or figure. Relatedly, certain portions of patent or other prior art disclosures build upon other disclosures, even if they are referred to as a separate or alternative embodiment. Thus, Starz's citations to structures or functions incorporate by reference all disclosures to related structures or functions, including any additional detail provided as to the operation or design of those structures or functions.

Discovery of the named inventors is ongoing. Starz reserves the right to assert that the asserted claims are invalid under 35 U.S.C. § 102(f) if they obtain evidence that one or more of the named inventors should not have been named as an inventor or that one or more persons who should have been named as an inventor were not named. In either event, Starz will supplement their contentions to address the misjoinder and/or non-joinder of inventors by, *inter alia*, identifying the persons who should not have been named inventors (or who should have been named) and describing the relevant facts and circumstances.

Starz incorporates by reference all other prior art references, charts, theories, and disclosures served on VideoLabs in any prior or pending court action or proceeding before the Patent Trial and Appeal Board or USPTO, including but not limited to, *VideoLabs, Inc. v. Netflix*,

Inc., 1-22-cv-00229 (D. Del.); *VideoLabs, Inc. v. Amazon.com, Inc.*, 6-22-cv-00079 (W.D. Tex.); *VideoLabs, Inc., v. Apple Inc.*, 3-23-cv-01307 (N.D. Cal.); *Unified Patents, LLC v. VL Collective IP LLC*, IPR2022-01086 (PTAB); *Netflix, Inc. v. VideoLabs, Inc.*, IPR2023-00628 (PTAB); *Netflix, Inc v. VideoLabs, Inc.*, IPR 2023-00630 (PTAB); *Netflix, Inc. v. VL Collective IP, LLC*, IPR2023-00891 (PTAB); and *Ex Parte* Reexamination No. 90/015,063, as if recited herein.

Starz also reserves the right to challenge any of the claim terms herein under 35 U.S.C. § 112, including by arguing that they are indefinite, not supported by the written description, or not enabled. Nothing stated herein shall be construed as a waiver of any argument available under 35 U.S.C. §§ 101, 102, 103, and/or 112.

III. RELEVANT PRIOR ART

In Section IV below, Starz identifies the prior art references that anticipate and/or render obvious the asserted claims of the asserted patents. As set forth in more detail in the attached claim charts, the identified patents and publications are prior art under at least 35 U.S.C. §§ 102(a), (b), (e), (f), and/or (g).¹ Starz has identified each prior art patent by its inventor, title, number, country of origin, date of filing, date of issue, and, where applicable, the relevant priority date. Each prior art publication is identified by its title, date of publication, and, where feasible, author and publisher. For prior art under 35 U.S.C. § 102(b), Starz has identified the item offered for sale or publicly used or known, the date by which the offer or use took place or the information became known, and the identity of the person or entity that made the use or made and received the offer, or the person or entity that made the information known or to whom it was made known, to the full extent currently known.

¹ Unless otherwise indicated, all citations are to the pre-AIA provisions of Title 35 of the U.S. Code.

A. Priority Dates

'790 patent: Based on the information reasonably available to Starz, the priority date for the '790 patent is June 19, 2003, the filing date of application No. 10/600,746, the application that led to the '790 patent. VideoLabs bears the burden of showing on a claim-by-claim basis that it is entitled to a priority date earlier than June 19, 2003. VideoLabs has not done so. If VideoLabs demonstrates that any of the asserted claims of the '790 patent are entitled to a priority date before June 19, 2003, then Starz reserves the right to identify additional prior art references that anticipate or make obvious the asserted claims of the '790 patent.

'559 patent: Based on the information reasonably available to Starz, the priority date for the '559 patent is October 22, 2003, the filing date of application No. 10/690,692, the application that led to the '559 patent.

'794 patent: Based on the information reasonably available to Starz, the priority date for the '794 patent is March 16, 2006, the filing date of the PCT application from which the '794 patent is based. VideoLabs bears the burden of showing on a claim-by-claim basis that it is entitled to a priority date earlier than March 16, 2006. VideoLabs has not done so. If VideoLabs demonstrates that any of the asserted claims of the '794 patent are entitled to a priority date before March 16, 2006, then Starz reserves the right to identify additional prior art references that anticipate or make obvious the asserted claims of the '794 patent.

B. Prior Art Patents and Patent Publications

Starz contends that the asserted claims are invalid under 35 U.S.C. §§ 102 and/or 103 based on the prior art patent publications identified in Section IV below, for each asserted patent. These patent publications constitute prior art under 35 U.S.C. § 102, and their patent numbers, countries of origin, and dates of publication and/or issue are included on the face of those documents. Starz

further incorporates by reference all patent publications identified on the face of the asserted patents and any additional patent publications identified herein. Starz reserves the right to supplement this list as it learns in the course of discovery of other prior art patent publications that would anticipate and/or render obvious the asserted claims.

C. Prior Art Publications

Starz contends that the asserted claims are invalid under 35 U.S.C. §§ 102 and/or 103 based on the published works of prior art identified in Section IV below for each asserted patent. These publications constitute prior art under 35 U.S.C. § 102, and their titles, authors, publishers, and dates of publication are included on the face of those documents. Starz reserves the right to supplement this list as it learns in the course of discovery of other published works of prior art that would anticipate and/or render obvious the asserted claims.

D. Prior Art Under 35 U.S.C. §§ 102(f) and 102(g)

Because Starz has not yet completed discovery in this case, Starz reserves the right to supplement this disclosure with facts, documents, or other information learned at a later point through discovery or further investigation.

IV. STATEMENT OF ANTICIPATION AND OBVIOUSNESS

Starz contends that the prior art references identified in Starz's contentions anticipate and/or render obvious the asserted claims. Starz attaches Exhibits A-1 to A-6; B-1 to B-16; and C-1 to C-13, which provide exemplary disclosures showing how a person having ordinary skill in the art would have found that the prior art anticipates and/or renders obvious the asserted claims. The charts identify primary references, and in some cases, secondary references and obviousness contentions. The prior art references listed below and described in the Exhibits are prior art under at least 35 U.S.C. §§ 102(a), (b), and/or (e).

In addition to the prior art references charted, Exhibit D, which is incorporated herein in its entirety, identifies additional prior art references that disclose or describe the general state of the art and knowledge of one skilled in the art at the time of the purported inventions and the filings of the asserted patents. These references (without limitation) may be used to show the state of the art and/or may be used as supporting references in an obviousness combination.

Starz also incorporates here by reference, whether or not cited in Exhibits A-C, all prior art cited in the asserted patents and all prior art cited in the prosecution histories of the asserted patents, any prior art cited in any PTAB proceedings, any foreign counterparts, and any prior art identified by any party in any litigation or administrative proceeding related to the asserted patents or any related patents.

A. '790 Patent

1. Anticipation

The table below lists the prior art references that anticipate one or more of the asserted claims of the '790 patent under 35 U.S.C. § 102. The attached claim charts in Exhibits A-1 to A-6 provide citations to portions of the references, illustrating where and how the prior art explicitly discloses every element of the asserted claims. To the extent that any element is not provided by an expressly enabling disclosure by the referenced prior art, all elements of the asserted claims would still be the inherent result of putting into practice the systems and methods described by the prior art referenced herein, as set forth below.

Reference	Filing Date / Priority Date	Date of Issue or Publication	Short Cite
U.S. 6,345,279 B1	April 23, 1999	February 5, 2002	Li '279 or Li
U.S. 2008/0301231 A1 U.S. 2002/0131404 A1	November 28, 2001	December 4, 2008 September 19, 2002	Mehta
U.S. 8,219,704 B2 U.S. 7,363,384 B2	July 11, 2001	July 10, 2012 April 22, 2008	Chatani

Reference	Filing Date / Priority Date	Date of Issue or Publication	Short Cite
U.S. 2010/0022270 A1	June 26, 2002	January 28, 2010	Mikkelsen
U.S. 2003/0110234 A1	November 8, 2001	June 12, 2003	Egli
U.S. 6,704,024 B2	November 29, 2000	March 9, 2004	Robotham

2. Obviousness

The table below lists prior art references that render one or more of the asserted claims of the '790 patent invalid as obvious under 35 U.S.C. § 103, alone or in combination with the knowledge of a person having ordinary skill in the art and/or other prior art. The attached claim charts in Exhibits A-1 to A-6 demonstrate where and how each limitation of the asserted claims is found in the references listed below, either expressly or inherently in the larger context of the passage, as understood by a person having ordinary skill in the art. The following references are prior art under at least 35 U.S.C. §§ 102(a), (b), and/or (e).

a. Prior Art Patents and Patent Publications That Render Obvious the Asserted Claims of the '790 Patent

Patent or Patent Publication No.	Filing Date / Priority Date	Date of Issue or Publication	Short Cite
U.S. 6,345,279 B1	April 23, 1999	February 5, 2002	Li '279 or Li
U.S. 2008/0301231 A1 U.S. 2002/0131404 A1	November 28, 2001	December 4, 2008 September 19, 2002	Mehta
U.S. 8,219,704 B2 U.S. 7,363,384 B2	July 11, 2001	July 10, 2012 April 22, 2008	Chatani
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U.S. 2003/0110234 A1	November 8, 2001	June 12, 2003	Egli
U.S. 6,704,024 B2	November 29, 2000	March 9, 2004	Robotham

b. Prior Art Publications That Render Obvious the Asserted Claims of the '790 Patent

Title	Publication Date	Author/Publisher	Short Cite
"Mobile Applications with J2ME," A White Paper	July, 7, 2001	C. Schläpfer, M. Kubik, and G. Zavagli; Ericsson Radio Systems AB	Schläpfer

c. Motivation to Combine

In *KSR*, the Supreme Court emphasized that an idea that is the result of ordinary innovation, ordinary skill, or common sense should not be patentable. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). The Supreme Court held that a person of ordinary skill in the art is "a person of ordinary creativity, not an automaton" and "in many cases a person of ordinary skill in the art will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 420-21. Although a patent challenger is not required to show that one of ordinary skill in the art would have had a specific motivation to combine prior art references, such a showing may be helpful to the obviousness analysis. *Id.* at 418; *see also id.* at 402.

One of skill in the art would have been motivated to combine the references identified herein because, for example, the identified combinations fall into one or more of the following categories:

- A combination of elements known in the prior art according to known methods to yield a predictable result;
- A combination that is a simple substitution of one or more known elements for another to obtain a predictable result;
- A combination that involves using a known technique to improve a similar device or method in the same way;
- A combination that involves applying a known technique to a known device or method ready for improvement to yield a predictable result;

- A combination that results from a finite number of identified, predictable solutions with a reasonable expectation of success such that the solution was one that was “obvious to try;”
- A combination that results from known work in one field of endeavor prompting variations of it for use either in the same field or a different field based on design incentives or other market forces in which the variations were predictable to one of ordinary skill in the art; and
- A teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to modify the prior art reference or to combine the teachings of various prior art references to arrive at the claimed invention.

In addition, the motivation to combine the teachings of the prior art disclosed herein is found in the prior art themselves and (1) the nature of the problem being solved; (2) the express, implied, and inherent teachings of the prior art; (3) the knowledge of persons of ordinary skill in the art; (4) the fact that the prior art is generally directed towards apparatuses, methods, and/or systems related to streaming media content; and/or (5) the predictable results obtained in combining the different elements of the prior art. Moreover, for each combination presented, the combination would have been motivated at least by the fact that the references identify and address the same issues and suggest very similar or complementary solutions to those issues.

In light of these rationales, the asserted claims of the '790 patent are invalid in view of at least the combinations of references disclosed below. The references all refer to the same field of endeavor, particularly to managing the publication, purchase, and delivery of digital products to end users with wireless devices. Here, a POSITA at the relevant time would have been well aware that digital content could be received and stored in multiple formats that correspond to a range of user devices having different capabilities. Li observes that content providers may “develop multiple versions of multimedia content, each suitable for a class of client devices.” (Li, 1:48-50).

A POSITA would also have been aware of the need to control methods for delivering content stored in multiple formats according to different wireless device capabilities, thereby enabling a wide range of users to access digital content. For example, Li notes that “there is a growing demand for providing universal access to such multimedia content to a wide variety of devices over a wide range of network environments.” (Li, 1:27-30). Therefore, Li is directed to adapting multimedia content to methods for enabling the delivery of such content because “multimedia delivery methods need to account for the composite nature of Web documents, and the variety of client platform capabilities, user interests, network constraints and authoring policies.” (Li, 1:38-41). Mehta describes a similar need “for deploying software more easily to wireless devices” and relates to provisioning content “compatib[le] with a requesting subscriber device.” (Mehta ’231, [0004]-[0005]). Chatani explains “it would be highly desirable for both Internet content providers and Internet users to have a way of optimizing Internet content and service levels to the user’s hardware and communications capabilities” and describes systems and methods to “transfer content over a network from a content provider to a user node.” (Chatani ’704, Abstract, 2:62-67). And as Egli recognizes, “different devices often support different formats and communication transport protocols.” (Egli, [0008]).

Thus, a POSITA would have been aware of the need to develop dynamic methods of delivering digital content to any end-user device. In this context, a POSITA would have found it obvious to use and combine various interrelated prior art techniques for receiving digital content in different formats and storing it for later presentation, packaging, and delivery to the end users upon request. These combinations would be combinations of prior art elements according to known methods to yield predictable results as well as simple substitution of one known element for another to obtain predictable results. A POSITA would have been motivated to make these

combinations at least to meet the “growing demand for providing universal access to such multimedia content to a wide variety of devices.” (Li, 1:27-29).

d. Exemplary Prior Art Combinations

Starz provides the following identification of preliminary and exemplary combinations of prior art that render obvious the currently asserted claims of the '790 patent.

Claim No.	Exemplary Invalidity Grounds under 35 U.S.C. § 103
1	Li alone or in combination with Mehta, Chatani, Mikkelsen, Egli, Robotham, and/or Schläpfer. Mehta alone or in combination with Li, Chatani, Mikkelsen, Egli, Robotham, and/or Schläpfer. Chatani alone or in combination with Li, Mehta, Mikkelsen, Egli, Robotham, and/or Schläpfer. Mikkelsen alone or in combination with Li, Mehta, Chatani, Egli, Robotham, and/or Schläpfer. Egli alone or in combination with Li, Mehta, Chatani, Mikkelsen, Robotham, and/or Schläpfer. Robotham alone or in combination with Li, Mehta, Chatani, Mikkelsen, Egli, and/or Schläpfer.
2	Li alone or in combination with Mehta, Chatani, Mikkelsen, Egli, Robotham, and/or Schläpfer. Mehta alone or in combination with Li, Chatani, Mikkelsen, Egli, Robotham, and/or Schläpfer. Chatani alone or in combination with Li, Mehta, Mikkelsen, Egli, Robotham, and/or Schläpfer. Mikkelsen alone or in combination with Li, Mehta, Chatani, Egli, Robotham, and/or Schläpfer. Egli alone or in combination with Li, Mehta, Chatani, Mikkelsen, Robotham, and/or Schläpfer. Robotham alone or in combination with Li, Mehta, Chatani, Mikkelsen, Egli, and/or Schläpfer.
4	<i>See grounds of claim 2.</i>
5	<i>See grounds of claim 4.</i>
6	<i>See grounds of claim 5.</i>
7	<i>See grounds of claim 6.</i>
8	<i>See grounds of claim 1.</i>
9	<i>See grounds of claim 2.</i>

For example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Mehta with Schlöpfer. Mehta and Schlöpfer are in the same field of endeavor. In view of Schlöpfer's teaching that mobile devices have "a small display ... and are capable of communicating via a mobile network with limited bandwidth," a POSITA would be motivated to provide only a single description of each item of digital content regardless of the number of implementations of each item in the system of Mehta. A POSITA would also be motivated to use a provisioning model having a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices, and/or sending a packaged requested item to the wireless device according to a provisioning protocol associated with a selected provisioning model, as described in Schlöpfer, to implement the systems and methods of Mehta. It would have been within the ability of a POSITA to combine the teachings of Mehta's and Schlöpfer. A POSITA would have a reasonable expectation of success combining Mehta with Schlöpfer because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Mehta with Li. Mehta and Li are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and the presentation of only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item, as described in Li to implement Mehta's teaching of the provision of a content list to be provided to the subscriber. It would have been within the ability of a POSITA to combine them. A POSITA would have a reasonable

expectation of success combining Mehta with Li because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Mehta with Mikkelsen. Mehta and Mikkelsen are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and the presentation of only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item, as described in Mikkelsen to implement Mehta's teaching of the provision of a content list to be provided to the subscriber. It would have been within the ability of a POSITA to combine them. A POSITA would have a reasonable expectation of success combining Mehta with Mikkelsen because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Chatani with Schlöpfer. Chatani and Schlöpfer are in the same field of endeavor. In view of Schlöpfer's teaching that mobile devices have "a small display ... and are capable of communicating via a mobile network with limited bandwidth," a POSITA would be motivated to provide only a single description of each item of digital contention, regardless of the number of implementations of each item in the system of Chatani. A POSITA would also be motivated to use a provisioning model having a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices, and/or sending a packaged requested item to the wireless device according to a provisioning protocol associated with a selected provisioning model, as described in Schlöpfer to implement the systems and methods of Chatani. It would have been within the ability of a POSITA to combine the

teachings of Chatani and Schlöpfer. A POSITA would have a reasonable expectation of success combining Chatani with Schlöpfer because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Chatani with Li. Chatani and Li are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and the presentation of only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item, as described in Li to implement Chatani's teachings regarding the provision of content to user devices. It would have been within the ability of a POSITA to combine them. A POSITA would have a reasonable expectation of success combining Chatani with Li because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Chatani with Mikkelsen. Chatani and Mikkelsen are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and the presentation of only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item, as described in Mikkelsen to implement Chatani's teachings regarding the provision of content to user devices. It would have been within the ability of a POSITA to combine them. A POSITA would have a reasonable expectation of success combining Chatani with Mikkelsen because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Chatani with Mehta. Chatani and Mehta are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and the presentation of only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item, as described in Mehta to implement Chatani's teachings regarding the provision of content to user devices. A POSITA would have also been motivated to add the use provisioning models that correspond to different sets of device capabilities and include a provisioning protocol and a corresponding set of provisioning attributes and descriptors, as described in Mehta to implement the systems and methods of Chatani. It would have been within the ability of a POSITA to combine them. A POSITA would have a reasonable expectation of success combining Chatani with Mehta because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Li with Schlöpfer. Li and Schlöpfer are in the same field of endeavor. In view of Schlöpfer's teaching that mobile devices have "a small display ... and are capable of communicating via a mobile network with limited bandwidth," a POSITA would be motivated to provide only a single description of each item of digital contention regardless of the number of implementations of each item in the system of Li. A POSITA would also be motivated to use a provisioning model having a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices, and/or sending a packaged requested item to the wireless device according to a provisioning protocol associated with a selected provisioning model, as described in Schlöpfer to implement the systems and

methods of Li. It would have been within the ability of a POSITA to combine the teachings of Li and Schlöpfer. A POSITA would have a reasonable expectation of success combining Li with Schlöpfer because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Li with Mikkelsen. Li and Mikkelsen are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and the presentation of only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item, as described in Mikkelsen to implement Li's teachings regarding the provision of multimedia content to client devices. It would have been within the ability of a POSITA to combine them. A POSITA would have a reasonable expectation of success combining Li with Mikkelsen because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Li with Mehta. Li and Mehta are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and the presentation of only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item, as described in Mehta to implement Li's teachings regarding the provision of multimedia content to client devices. A POSITA would have also been motivated to add the use of provisioning models that corresponding to a different set of device capabilities and include a provisioning protocol and a corresponding set of

provisioning attributes and descriptors, as described in Mehta to implement the systems and methods of Li. It would have been within the ability of a POSITA to combine them. A POSITA would have a reasonable expectation of success combining Li with Mehta because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Mikkelsen with Schläpfer. Mikkelsen and Schläpfer are in the same field of endeavor. In view of Schläpfer's teaching that mobile devices have "a small display ... and are capable of communicating via a mobile network with limited bandwidth," a POSITA would be motivated to provide only a single description of each item of digital contention regardless of the number of implementations of each item in the system of Mikkelsen. A POSITA would also be motivated to use a provisioning model having a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices, and/or sending a packaged requested item to the wireless device according to a provisioning protocol associated with a selected provisioning model, as described in Schläpfer to implement the systems and methods of Mikkelsen. It would have been within the ability of a POSITA to combine the teachings of Mikkelsen and Schläpfer. A POSITA would have a reasonable expectation of success combining Mikkelsen with Schläpfer because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Mikkelsen with Li. Mikkelsen and Li are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and the presentation of only a single description of each item of digital content in said

portion, regardless of the number of implementations of each said item, as described in Li to implement Mikkelsen's teachings regarding the transmission, delivery, and playback of audio and visual files. It would have been within the ability of a POSITA to combine them. A POSITA would have a reasonable expectation of success combining Mikkelsen with Li because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Mikkelsen with Mehta. Mikkelsen and Mehta are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and the presentation of only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item, as described in Mehta to implement Mikkelsen's teachings regarding the transmission, delivery, and playback of audio and visual files. A POSITA would have also been motivated to add the use provisioning models that correspond to different sets of device capabilities and include a provisioning protocol and a corresponding set of provisioning attributes and descriptors, as described in Mehta to implement the systems and methods of Mikkelsen. It would have been within the ability of a POSITA to combine them. A POSITA would have a reasonable expectation of success combining Mikkelsen with Mehta because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Egli with Schlöpfer. Egli and Schlöpfer are in the same field of endeavor. In view of Schlöpfer's teaching that mobile devices have "a small display ... and are capable of communicating via a mobile network with limited bandwidth," a POSITA would be motivated to

provide only a single description of each item of digital contention regardless of the number of implementations of each item in the system of Egli. A POSITA would also be motivated to use a provisioning model having a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices, and/or sending a packaged requested item to the wireless device according to a provisioning protocol associated with a selected provisioning model, as described in Schlöpfer to implement the systems and methods of Egli. It would have been within the ability of a POSITA to combine the teachings of Egli and Schlöpfer. A POSITA would have a reasonable expectation of success combining Egli with Schlöpfer because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Egli with Li. Egli and Li are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and the presentation of only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item, as described in Li to implement Egli's online media delivery system. It would have been within the ability of a POSITA to combine them. A POSITA would have a reasonable expectation of success combining Egli with Li because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Egli with Mehta. Egli and Mehta are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and

the presentation of only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item, as described in Mehta to implement Egli's teachings regarding an online media delivery system. A POSITA would have also been motivated to add the use provisioning models that correspond to different sets of device capabilities and include a provisioning protocol and a corresponding set of provisioning attributes and descriptors, as described in Mehta to implement the systems and methods of Egli. A POSITA would also have been motivated to add the use of different versions of content in Mehta's data repositories corresponding to differences sets of devices capabilities to be received and stored prior to performing additional transformations, as taught in Egli. It would have been within the ability of a POSITA to combine them. A POSITA would have a reasonable expectation of success combining Egli with Mehta because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Egli with Mikkelsen. Egli and Mikkelsen are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and the presentation of only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item, as described in Mikkelsen to implement Egli's teachings regarding an online media delivery system. It would have been within the ability of a POSITA to combine them. A POSITA would have a reasonable expectation of success combining Egli with Mikkelsen because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Robotham with Schlöpfer. Robotham and Schlöpfer are in the same field of endeavor. In view of Schlöpfer's teaching that mobile devices have "a small display ... and are capable of communicating via a mobile network with limited bandwidth," a POSITA would be motivated to provide only a single description of each item of digital contention regardless of the number of implementations of each item in the system of Robotham. A POSITA would also be motivated to use a provisioning model having a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices, and/or sending a packaged requested item to the wireless device according to a provisioning protocol associated with a selected provisioning model, as described in Schlöpfer to implement the systems and methods of Robotham. It would have been within the ability of a POSITA to combine the teachings of Robotham and Schlöpfer. A POSITA would have a reasonable expectation of success combining Robotham with Schlöpfer because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Robotham with Li. Robotham and Li are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and the presentation of only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item, as described in Li to implement Robotham's teachings regarding the transmission and display of visual content on a client device. It would have been within the ability of a POSITA to combine them. A POSITA

would have a reasonable expectation of success combining Robotham with Li because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Robotham with Mehta. Robotham and Mehta are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and the presentation of only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item, as described in Mehta to implement Robotham's teachings regarding the transmission and display of visual content on a client device. A POSITA would have also been motivated to add the use provisioning models that correspond to different sets of device capabilities and include a provisioning protocol and a corresponding set of provisioning attributes and descriptors, as described in Mehta to implement the systems and methods of Robotham. It would have been within the ability of a POSITA to combine them. A POSITA would have a reasonable expectation of success combining Robotham with Mehta because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Robotham with Mikkelsen. Robotham and Mikkelsen are in the same field of endeavor. A POSITA would be motivated to add the selection of a portion of the product catalog to be presented to the subscriber based on device capabilities of the wireless device used by the subscriber, and the presentation of only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item, as described in Mikkelsen to implement Robotham's teachings regarding the transmission and display of visual

content on a client device. It would have been within the ability of a POSITA to combine them. A POSITA would have a reasonable expectation of success combining Robotham with Mikkelsen because it only involves the predictable use of prior art elements according to their established functions.

B. '559 Patent

1. Anticipation

The table below lists the prior art references that anticipate one or more of the asserted claims of the '559 patent under 35 U.S.C. § 102. The attached claim charts in Exhibits B-1 to B-16 provide citations to portions of the references, illustrating where and how the prior art explicitly discloses every element of the asserted claims. To the extent that any element is not provided by an expressly enabling disclosure by the referenced prior art, all elements of the asserted claims would still be the inherent result of putting into practice the systems and methods described by the prior art referenced herein, as set forth below.

Reference	Filing Date / Priority Date	Short Cite
U.S. 7,881,658 B2	October 9, 2003	Weisman
U.S. 7,650,621 B2	October 9, 2001	Thomas
U.S. 8,078,032 B1	October 15, 2001	Hatanaka
U.S. 7,634,532 B2	May 26, 2003	Kawamura
U.S. 7,130,908 B1	March 13, 2001	Pecus
U.S. 7,269,854 B2	August 23, 1998	Simmons
U.S. 8,090,768 B2 U.S. 7,451,177 B1	April 11, 2000	Johnson
WO 2002/014990 A1	August 10, 2001	Fältskog
U.S. 6,553,412 B1	April 28, 2000	Kloba
<i>Multimedia routing server for in-home services—requirements and referential architecture</i>	May 2002	Lu
<i>Enhanced Streaming Services in CDN</i>	July 2001	Cranor
U.S. 7,243,136	January 18, 2000	Huston

Reference	Filing Date / Priority Date	Short Cite
U.S. 2003/0023427	July 26, 2001	Cassin

2. Obviousness

The tables below list prior art references that render one or more of the asserted claims of the '559 patent invalid as obvious under 35 U.S.C. § 103, alone or in combination with the knowledge of a person having ordinary skill in the art and/or other prior art. The attached claim charts in Exhibits B-1 to B-16 demonstrate where and how each limitation of the asserted claims is found in the references listed below, either expressly or inherently in the larger context of the passage, as understood by a person having ordinary skill in the art. The following references are prior art under at least 35 U.S.C. §§ 102(a), (b), and/or (e).

a. Prior Art Patents and Patent Publications That Render Obvious the Asserted Claims of the '559 Patent

Patent or Patent Publication No.	Filing Date / Priority Date	Date of Issue or Publication	Short Cite
U.S. 7,881,658 B2	October 9, 2003	February 1, 2011	Weisman
U.S. 7,650,621 B2	October 9, 2001	January 19, 2010	Thomas
U.S. 8,078,032 B1	October 15, 2001	December 13, 2011	Hatanaka
U.S. 7,634,532 B2	May 31, 2002	December 15, 2009	Kawamura
U.S. 7,130,908 B1	March 13, 2001	October 31, 2006	Pecus
U.S. 7,269,854 B2	August 23, 1998	April 20, 2006	Simmons
WO 2002/014990 A1	August 10, 2001	February 21, 2002	Fältskog
U.S. 6,553,412 B1	April 28, 2000	April 22, 2003	Kloba
U.S. 2002/0165987 A1	April 9, 2002	November 7, 2002	Arisaka
U.S. 2002/0073205 A1	August 2, 2001	June 13, 2002	Mostafa
U.S. 2003/0221014 A1	May 24, 2002	November 27, 2003	Kosiba
U.S. 8,090,768 B2	April 11, 2000	January 3, 2012	Johnson
U.S. 7,451,177 B1		November 11, 2008	
U.S. 7,243,136	January 18, 2000	January 17, 2002	Huston
U.S. 2003/0023427	July 26, 2001	January 30, 2003	Cassin

b. Prior Art Publications That Render Obvious the Asserted Claims of the '559 Patent

Title	Publication Date	Author/Publisher	Short Cite
<i>Enhanced Streaming Services in CDN</i>	July 2001	Charles D. Cranor, et al., IEEE	Cranor
<i>Multimedia routing server for in-home services—requirements and referential architecture</i>	May 2002	Jin Lu, et al., IEEE Transactions on Consumer Elects. (Vol. 48, Issue 2)	Lu

c. Motivation to Combine

Starz incorporates by reference the legal standard for motivations to combine set forth in Section IV.A.2.b, *supra*, as though fully set forth herein.

The Asserted Claims of the '559 patent are invalid in view of the combinations of references disclosed above. By 2003, a POSITA would have been well aware that multimedia content could be delivered to terminals via networks, such as the Internet. For example, Cranor notes that “[w]ith the emergence of broadband access networks and powerful personal computer systems, the demand for network delivered full-motion streaming video is growing.” (Cranor, p. 1). Lu also observes that “[b]roadband access networks and home networks have made it possible to deliver interactive multimedia content to home appliances,” such as televisions and handheld devices. Weisman recognizes that “[s]treaming media technologies have been widely taught.” (Weisman, 4:8). Likewise, Hatanaka sought to overcome the “drawbacks” of conventional information processing apparatuses by “providing an improved and novel information processing apparatus and method, capable of checking out a desire content easily and quickly to a portable device connected to the information processor.” (Hatanaka, 1:33-39). And Arisaka explains that “technology is available to distribute content in formats suited for individual terminals.” (Arisaka, [0005]).

A POSITA would also have been aware of the need to control the flow of multimedia content to the terminals in order to provide a high-quality experience. Cranor recognizes this need in a streaming-based approach: “[f]or Internet-based streaming to approach the same level of entertainment value as broadcast media, CDNs [content distribution networks] must drastically improve the quality of streaming they can support. Additionally, streaming CDNs will have to support more sophisticated services to accommodate new business models and new types of service offerings.” (Cranor, p. 1). And Weisman identifies “an unmet need for immediate, portable access to an open-ended library of entertainment and informational programming that is both extensive and personalized.” (Weisman, 5:2-5). As explained by Weisman, this need was well known because “audiences have made themselves clear with their consumer electronics purchases: The shows they want, when they want them.” (Weisman, 2:38-40). Furthermore, Kosiba recognizes an existing need for “a method for transferring non-sequential portions of a multimedia file from a server to a terminal where playback may begin prior to completion of the transfer of the entire file” and for “tailoring the content of the transfer based on terminal characteristics.” (Kosiba, [0004], [0007]).

Johnson describes a similar need in a non-streaming approach: “[o]ne technique to download a program of Internet information for user playback that does not require the use of communication facilities during playback, is to download the information at a time prior to the desired playback time. In this type of system, as well as in other embodiments, it is desirable to allow a user to specify the particularly content, categories of content, or the general nature of the content desired.” (Johnson ’768, 2:44-51). Thomas similarly observes that television platform servers were capable of providing program listings “in response to requests generated from the set-top boxes” while providing an invention that adapts on-demand media delivery systems to be

“provided independent of the type of equipment (e.g., set-top box, personal computer, etc.) that is used to interact with the system.” (Thomas, 1:49-52, 2:1-4).

Fältskog relates to an additional aspect of flow control that would have been known to a POSITA—the need to prevent unauthorized use of the content: “there is a need, both from content providers as well as endusers, of a system that can offer and deliver content on a wireless carrier, quickly, simple and flexible, at a low cost, in a way that prevents pirate copying or other illegal use of copyright protected material.” (Fältskog, p. 3, ll. 4-8).

Accordingly, a POSITA would have known various ways to provide multimedia content to terminals using the Internet. A POSITA would likewise have been aware of the need to provide high-quality experience to the end users who are ultimately consuming the content. In this context, a POSITA would have found it obvious to use and combine various prior art techniques for controlling the flow of content between content sources and user terminals. A POSITA would have been motivated to make these combinations at least to provide “more sophisticated services to accommodate new business models and new types of service offerings” as recognized by Cranor. (Cranor, p. 1). A POSITA would also have been motivated to select and combine the teachings in order to accommodate new business models and new types of service offerings. These combinations are combinations of prior art elements according to known methods to yield predictable results as well as simple substitution of one known element for another to obtain predictable results.

d. Exemplary Prior Art Combinations

Starz provides the following identification of preliminary and exemplary combinations of prior art that render obvious the currently asserted claims of the ’559 patent.

Claim No.	Exemplary Invalidity Grounds under 35 U.S.C. § 103
1	Lu alone or in combination with Cranor, Johnson, Mostafa, Fältskog, Cassin, and/or Huston. Lu in combination with Pecus, Simmons, and/or Kloba. Pecus alone or in combination with Cranor, Johnson, Mostafa, Fältskog, Cassin, and/or Huston. Pecus in combination with Simmons and/or Kloba. Simmons alone or in combination with Cranor, Johnson, Mostafa, Fältskog, Cassin, and/or Huston. Simmons in combination with Kloba. Kloba alone or in combination with Cranor, Johnson, Mostafa, Fältskog, Cassin, and/or Huston. Weisman alone or in combination with Thomas, Hatanaka, Lu, Cranor, Johnson, Arisaka, Kosiba, Cassin, and/or Huston. Weisman in combination with Mostafa, Fältskog, Pecus, Simmons, and/or Kloba. Thomas alone or in combination with Hatanaka, Lu, Cranor, Pecus, Johnson, Arisaka, Kosiba, Cassin, and/or Huston. Thomas in combination with Mostafa, Fältskog, Simmons, and/or Kloba. Hatanaka alone or in combination with Lu, Cranor, Johnson, Mostafa, Fältskog, Cassin, Pecus, and/or Huston. Hatanaka in combination with Kawamura, Pecus, Simmons, and/or Kloba. Kawamura alone or in combination with Lu, Cranor, Johnson, Mostafa, Fältskog, Weisman, Arisaka, Kosiba, Cassin, and/or Huston. Kawamura in combination with Pecus, Simmons, and/or Kloba. Arisaka alone or in combination with Johnson, Thomas, Weisman, and/or Kosiba. Kosiba alone or in combination with Johnson, Thomas, Weisman, and/or Arisaka. Johnson alone or in combination with Thomas, Arisaka, Weisman, and/or Kosiba. Cassin alone or in combination with Huston, Weisman, Arisaka, Kosiba, and/or Johnson.
2	<i>See grounds of claim 1.</i>
4	<i>See grounds of claim 2.</i>

For example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Weisman with Hatanaka. Weisman and Hatanaka are in the same field of endeavor. A POSITA would be motivated to use a terminal comprising a memory, as described in Hatanaka, to implement Weisman's teaching of instructing the terminal to at least one of delete at least one piece of content from the memory of the terminal, or download at least one piece of

content from the source. It would have been within the ability of a POSITA to combine the teachings of Weisman and Hatanaka. A POSITA would have a reasonable expectation of success combining Weisman with Hatanaka because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Weisman with Johnson. Weisman and Johnson are in the same field of endeavor. A POSITA would be motivated to use a terminal comprising a memory, as described in Johnson, to implement Weisman's teaching of instructing the terminal to at least one of delete at least one piece of content from the memory of the terminal, or download at least one piece of content from the source. It would have been within the ability of a POSITA to combine the teachings of Weisman and Johnson. A POSITA would have a reasonable expectation of success combining Weisman with Johnson because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Weisman with Arisaka. Weisman and Arisaka are in the same field of endeavor. A POSITA would be motivated to use a terminal comprising a memory, as described in Arisaka, to implement Weisman's teaching of instructing the terminal to at least one of delete at least one piece of content from the memory of the terminal, or download at least one piece of content from the source. It would have been within the ability of a POSITA to combine the teachings of Weisman and Arisaka. A POSITA would have a reasonable expectation of success combining Weisman with Arisaka because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Weisman with Kosiba. Weisman and Kosiba are in the same field of endeavor. A POSITA would be motivated to use a terminal comprising a memory, as described in Kosiba, to implement Weisman's teaching of instructing the terminal to at least one of delete at least one piece of content from the memory of the terminal, or download at least one piece of content from the source. It would have been within the ability of a POSITA to combine the teachings of Weisman and Kosiba. A POSITA would have a reasonable expectation of success combining Weisman with Kosiba because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Weisman with Pecus. Weisman and Pecus are in the same field of endeavor. A POSITA would be motivated to provide responses to the content status, as described in Pecus, to implement Weisman's teaching of instructing the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Weisman and Pecus. A POSITA would have a reasonable expectation of success combining Weisman with Pecus because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Thomas with Pecus. Thomas and Pecus are in the same field of endeavor. A POSITA would be motivated to provide responses to the content status, as described in Pecus, to implement Thomas's teaching of instructing the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Thomas and Pecus. A POSITA would have a reasonable

expectation of success combining Thomas with Pecus because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Thomas with Johnson. Thomas and Johnson are in the same field of endeavor. A POSITA would be motivated to use a terminal comprising a memory, as described in Johnson, to implement Thomas's teaching of instructing the terminal to at least one of delete at least one piece of content from the memory of the terminal, or download at least one piece of content from the source. It would have been within the ability of a POSITA to combine the teachings of Thomas and Johnson. A POSITA would have a reasonable expectation of success combining Thomas with Johnson because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Thomas with Arisaka. Thomas and Arisaka are in the same field of endeavor. A POSITA would be motivated to use a terminal comprising a memory, as described in Arisaka, to implement Thomas's teaching of instructing the terminal to at least one of delete at least one piece of content from the memory of the terminal, or download at least one piece of content from the source. It would have been within the ability of a POSITA to combine the teachings of Thomas and Arisaka. A POSITA would have a reasonable expectation of success combining Thomas with Arisaka because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Thomas with Kosiba. Thomas and Kosiba are in the same field of endeavor. A POSITA would be motivated to use a terminal comprising a memory, as described

in Kosiba, to implement Thomas's teaching of instructing the terminal to at least one of delete at least one piece of content from the memory of the terminal, or download at least one piece of content from the source. It would have been within the ability of a POSITA to combine the teachings of Thomas and Kosiba. A POSITA would have a reasonable expectation of success combining Thomas with Kosiba because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Hatanaka with Pecus. Hatanaka and Pecus are in the same field of endeavor. A POSITA would be motivated to provide responses to the content status, as described in Pecus, to implement Hatanaka's teaching of instructing the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Hatanaka and Pecus. A POSITA would have a reasonable expectation of success combining Hatanaka with Pecus because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Kawamura with Weisman. Kawamura and Weisman are in the same field of endeavor. A POSITA would be motivated to use a processor configured to receive server status information regarding a source of content wherein the server status information comprises a listing of at least one piece of content available from the source, as described in Weisman, to implement Kawamura's teaching of a processor configured to send, to the terminal, a response to the content status that instructs the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Kawamura and Weisman. A POSITA would have a reasonable expectation of success

combining Kawamura with Weisman because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Kawamura with Johnson. Kawamura and Johnson are in the same field of endeavor. A POSITA would be motivated to use a processor configured to receive, from a terminal located remote from the apparatus, a content status including terminal status information, and configured to receive server status information regarding a source of content, wherein the server status information comprises a listing of at least one piece of content available from the source, as described in Johnson, to implement Kawamura's teaching of a controller and a second client that control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Kawamura and Johnson. A POSITA would have a reasonable expectation of success combining Kawamura with Johnson because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Kawamura with Arisaka. Kawamura and Arisaka are in the same field of endeavor. A POSITA would be motivated to use a processor configured to receive, from a terminal located remote from the apparatus, a content status including terminal status information, and configured to receive server status information regarding a source of content, wherein the server status information comprises a listing of at least one piece of content available from the source, as described in Arisaka, to implement Kawamura's teaching of a controller and a second client that control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Kawamura and Arisaka. A POSITA would have a reasonable

expectation of success combining Kawamura with Arisaka because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Kawamura with Kosiba. Kawamura and Kosiba are in the same field of endeavor. A POSITA would be motivated to use a processor configured to receive, from a terminal located remote from the apparatus, a content status including terminal status information, and configured to receive server status information regarding a source of content, wherein the server status information comprises a listing of at least one piece of content available from the source, as described in Kosiba, to implement Kawamura's teaching of a controller and a second client that control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Kawamura and Kosiba. A POSITA would have a reasonable expectation of success combining Kawamura with Kosiba because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Arisaka with Johnson. Arisaka and Johnson are in the same field of endeavor. A POSITA would be motivated to implement the receipt of server status information regarding a source of content, wherein the server status information comprises a listing of at least one piece of content available from the source, as described in Johnson, to implement Arisaka's teaching of instructing the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Arisaka and Johnson. A POSITA would have a reasonable expectation of success combining Arisaka with Johnson because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Arisaka with Thomas. Arisaka and Thomas are in the same field of endeavor. A POSITA would be motivated to implement the receipt of server status information regarding a source of content, wherein the server status information comprises a listing of at least one piece of content available from the source, as described in Thomas, to implement Arisaka's teaching of instructing the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Arisaka and Thomas. A POSITA would have a reasonable expectation of success combining Arisaka with Thomas because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Arisaka with Kosiba. Arisaka and Kosiba are in the same field of endeavor. A POSITA would be motivated to implement the receipt of server status information regarding a source of content, wherein the server status information comprises a listing of at least one piece of content available from the source, as described in Kosiba, to implement Arisaka's teaching of instructing the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Arisaka and Kosiba. A POSITA would have a reasonable expectation of success combining Arisaka with Kosiba because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Kosiba with Johnson. Kosiba and Johnson are in the same field of endeavor. A POSITA would be motivated to use a processor, as described in Johnson, to

implement Kosiba's teaching of instructing the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Kosiba and Johnson. A POSITA would have a reasonable expectation of success combining Kosiba with Johnson because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Kosiba with Thomas. Kosiba and Thomas are in the same field of endeavor. A POSITA would be motivated to use a processor, as described in Thomas, to implement Kosiba's teaching of instructing the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Kosiba and Thomas. A POSITA would have a reasonable expectation of success combining Kosiba with Thomas because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Kosiba with Arisaka. Kosiba and Arisaka are in the same field of endeavor. A POSITA would be motivated to use a processor, as described in Arisaka, to implement Kosiba's teaching of instructing the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Kosiba and Arisaka. A POSITA would have a reasonable expectation of success combining Kosiba with Arisaka because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Cassin with Huston. Cassin and Huston are in the same field of endeavor.

A POSITA would be motivated to use a processor configured to receive, from a terminal located remote from the apparatus, a content status including terminal status information, as described in Huston, to implement Cassin's teaching of a processor configured to send, to the terminal, a response to the content status that instructs the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Cassin and Huston. A POSITA would have a reasonable expectation of success combining Cassin with Huston because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Cassin with Weisman. Cassin and Weisman are in the same field of endeavor. A POSITA would be motivated to use a processor configured to receive, from a terminal located remote from the apparatus, a content status including terminal status information, as described in Weisman, to implement Cassin's teaching of a processor configured to send, to the terminal, a response to the content status that instructs the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Cassin and Weisman. A POSITA would have a reasonable expectation of success combining Cassin with Weisman because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Cassin with Arisaka. Cassin and Arisaka are in the same field of endeavor. A POSITA would be motivated to use a processor configured to receive, from a terminal located remote from the apparatus, a content status including terminal status information, as described in Arisaka, to implement Cassin's teaching of a processor configured to send, to the

terminal, a response to the content status that instructs the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Cassin and Arisaka. A POSITA would have a reasonable expectation of success combining Cassin with Arisaka because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Cassin with Kosiba. Cassin and Kosiba are in the same field of endeavor. A POSITA would be motivated to use a processor configured to receive, from a terminal located remote from the apparatus, a content status including terminal status information, as described in Kosiba, to implement Cassin's teaching of a processor configured to send, to the terminal, a response to the content status that instructs the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Cassin and Kosiba. A POSITA would have a reasonable expectation of success combining Cassin with Kosiba because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Cassin with Johnson. Cassin and Johnson are in the same field of endeavor. A POSITA would be motivated to use a processor configured to receive, from a terminal located remote from the apparatus, a content status including terminal status information, as described in Johnson, to implement Cassin's teaching of a processor configured to send, to the terminal, a response to the content status that instructs the terminal to perform one or more actions to thereby control the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Cassin and Johnson. A POSITA would have a reasonable

expectation of success combining Cassin with Johnson because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Johnson with Thomas. Johnson and Thomas are in the same field of endeavor. A POSITA would be motivated to provide an instruction to the terminal to perform one or more actions, as described in Thomas, to implement Johnson's teaching of controlling the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Johnson and Thomas. A POSITA would have a reasonable expectation of success combining Johnson with Thomas because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Johnson with Arisaka. Johnson and Arisaka are in the same field of endeavor. A POSITA would be motivated to provide an instruction to the terminal to perform one or more actions, as described in Arisaka, to implement Johnson's teaching of controlling the flow of content to the terminal. It would have been within the ability of a POSITA to combine the teachings of Johnson and Arisaka. A POSITA would have a reasonable expectation of success combining Johnson with Arisaka because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Johnson with Kosiba. Johnson and Kosiba are in the same field of endeavor. A POSITA would be motivated to provide an instruction to the terminal to perform one or more actions, as described in Kosiba, to implement Johnson's teaching of controlling the flow of content to the terminal. It would have been within the ability of a POSITA to combine the

teachings of Johnson and Kosiba. A POSITA would have a reasonable expectation of success combining Johnson with Kosiba because it only involves the predictable use of prior art elements according to their established functions.

C. '794 Patent

1. Anticipation

The table below lists the prior art references that anticipate one or more of the asserted claims of the '794 patent under 35 U.S.C. § 102. The attached claim charts in Exhibits C-1 to C-13 provide citations to portions of the references, illustrating where and how the prior art explicitly discloses every element of the asserted claims. To the extent that any element is not provided by an expressly enabling disclosure by the referenced prior art, all elements of the asserted claims would still be the inherent result of putting into practice the systems and methods described by the prior art referenced herein, as set forth below.

Reference	Filing Date / Priority Date	Short Cite
U.S. 5,627,656	August 12, 1996	Sonohara
U.S. 5,751,280	December 11, 1995	Abbott
U.S. 2006/0204214	March 14, 2005	Shah
U.S. 7,096,416	October 30, 2000	Smith
<i>Elementary stream management in MPEG-4</i>	March 1999	Herpel
<i>Middle-tier for Multimedia Synchronization</i>	October 2001	Aygun
<i>International Standard 13818-1:1996: Information technology—Generic coding of moving pictures and associated audio information: Systems</i>	April 15, 1996	MPEG-2

2. Obviousness

The tables below list prior art references that render one or more of the asserted claims of the '794 patent invalid as obvious under 35 U.S.C. § 103, alone or in combination with the knowledge of a person having ordinary skill in the art and/or other prior art. The attached claim charts in Exhibits C-1 to C-13 demonstrate where and how each limitation of the asserted claims is found in the references listed below, either expressly or inherently in the larger context of the passage, as understood by a person having ordinary skill in the art. The following references are prior art under at least 35 U.S.C. §§ 102(a), (b), and/or (e).

a. Prior Art Patents and Patent Publications That Render Obvious the Asserted Claims of the '794 Patent

Patent or Patent Publication No.	Filing Date / Priority Date	Date of Issue or Publication	Short Cite
U.S. 5,751,280	December 11, 1995	May 12, 1998	Abbott
U.S. 2006/0204214	March 14, 2005	September 14, 2006	Shah
U.S. 5,794,018	March 2, 1995	August 11, 1998	Vvrilo
U.S. 2005/0034005 A1	June 15, 2000	February 10, 2005	Lauder App
U.S. 6,802,019	June 15, 2000	October 5, 2004	Lauder Parent
U.S. 7,096,416	October 30, 2000	August 22, 2006	Smith
U.S. 5,627,656	August 13, 1993	May 6, 1997	Sonohara

b. Prior Art Publications That Render Obvious the Asserted Claims of the '794 Patent

Title	Publication Date	Author/Publisher	Short Cite
<i>Bitstream syntax description: a tool for multimedia resource adaptation within MPEG-21</i>	September 2003	Gabriel Panis, et al., Signal Processing: Image Communication, Vol. 18, Issue 8	Panis
<i>Elementary stream management in MPEG-4</i>	March 1999	C Herpel, IEEE Transactions on Circuits and Systems for Video Technology, Vol. 9, No. 2	Herpel

Title	Publication Date	Author/Publisher	Short Cite
<i>Middle-tier for Multimedia Synchronization</i>	October 2001	Ramazon Savas Aygun, MULTIMEDIA '01: Proceedings of the 9h ACM Int'l Conference on Multimedia	Aygun
<i>Object Composition and Playback Models for Handling Multimedia Data</i>	June 1994	Rei Hamakawa & Jun Rekimoto, Multimedia Systems	Hamakawa
<i>A Knowledge and Component Based Multimedia Adaptation Framework</i>	March 13, 2004	Klaus Leopold, et al., Proceedings of the IEEE Sixth Int'l Symposium on Multimedia Software Engineering	Leopold
<i>Coding Format Independent Multimedia Content Adapt</i>	November 26, 2003	Christian Timmerer, et al., Proceedings Volume 5242, Internet Multimedia Management Systems IV	Timmerer
<i>International Standard 13818-1:1996: Information technology—Generic coding of moving pictures and associated audio information: Systems</i>	April 15, 1996	ISO/IEC	MPEG-2

c. Motivation to Combine

Starz incorporates by reference the legal standard for motivations to combine set forth in Section IV.A.2.b, *supra*, as though fully set forth herein.

The Asserted Claims of the '794 patent are invalid in view of the combinations of references disclosed above. The references all refer to the same field of endeavor, particularly to methods and systems for synchronizing content. By 2005, a POSITA would have been well aware of the importance of synchronizing content, including media content, such as image/video and audio content, for optimal presentation to a viewer, as well as the various methods to achieve such

synchronization. For example, Abbott discloses that “[r]ecent advances in data handling and data communications techniques have enabled the entertainment industry to provide movies and other audio, video, or multi-media program materials to viewers in a viewer’s home at a time requested by the viewer.” (Abbott, 1:16-20). As a further example, Sonohara discloses “a motion picture reproducing apparatus for recording audio data and video data, in a file and reproducing the data contained in the file for a long period of time, in synchronism with the audio data.” (Sonohara, 1:11-14). And, as explained by Smith, “[i]n order for [a] mixed-media presentation to flow smoothly, it is necessary to synchronize the different media elements so that they will be presented at the correct moment in the presentation.” (Smith, 1:27-30). Indeed, synchronization can allow for “interactive delivery of program material to a viewer.” (Abbott, 21:1-4); *see also* Aygun at Abstract (“The synchronization rules generated by the middle-tier assists the synchronization model to provide user interactions while keeping the synchronization specification minimal.”). Moreover, as set forth in Exhibits C-1 to C-13, a POSITA would have been aware of manipulating segments of content using rules. *See, e.g., id.*; *see also* Shah at [0045] (“In particular, the editor component 206 can utilize a set of guidelines and/or rules to define a placement of an audio segment in the image/video segment-line to form a soundtrack (e.g., the audio) for the authored video.”). Accordingly, a POSITA would have a reasonable expectation of success in combining the related prior art, as it would involve combinations of prior art elements according to known methods to yield predictable results, as well as simple substitution of one known element for another to obtain predictable results.

d. Exemplary Prior Art Combinations

Starz provides the following identification of preliminary and exemplary combinations of prior art that render obvious the currently asserted claims of the ’794 patent.

Claim No.	Exemplary Invalidity Grounds Under 35 U.S.C. § 103
1	Abbott alone or in combination with Shah, Vvrilo, Lauder, Smith, Sonohara, Panis, Herpel, Aygun, Hamakawa, Leopold, Timmer, and/or MPEG-2. Shah alone or in combination with Abbott, Vvrilo, Lauder, Smith, Sonohara, Panis, Herpel, Aygun, Hamakawa, Leopold, Timmer, and/or MPEG-2. Sonohara alone or in combination with Abbott, Vvrilo, Lauder, Smith, Panis, Herpel, Aygun, Hamakawa, Leopold, Timmer, and/or MPEG-2. Aygun alone or in combination with Abbott, Shah, Vvrilo, Lauder, Smith, Sonohara, Panis, Herpel, Hamakawa, Leopold, Timmer, and/or MPEG-2. Herpel alone or in combination with Abbott, Shah, Vvrilo, Lauder, Smith, Sonohara, Panis, Aygun, Hamakawa, Leopold, Timmer, and/or MPEG-2. Smith alone or in combination with Abbott, Shah, Vvrilo, Lauder, Sonohara, Panis, Herpel, Aygun, Hamakawa, Leopold, Timmer, and/or MPEG-2. Panis in combination with Abbott, Shah, Aygun, Herpel, and/or Smith. Panis in combination with Smith and in further combination with Hamakawa, Vvrilo, Lauder, Shah, Abbott, and/or MPEG-2. Leopold in combination with Abbott, Shah, Aygun, Herpel, and/or Smith. Leopold in combination with Smith and in further combination with Hamakawa, Vvrilo, Lauder, Shah, Abbott, and/or MPEG-2. Timmerer in combination with Abbott, Shah, Herpel, Aygun, and/or Smith. Timmerer in combination with Smith and in further combination with Hamakawa, Vvrilo, Lauder, Shah, Abbott, and/or MPEG-2. MPEG-2 alone or in combination with Abbott, Sonohara, and/or Smith.
3	<i>See grounds of claim 1.</i>
5	<i>See grounds of claim 1.</i>
9	<i>See grounds of claim 1.</i>
12	<i>See grounds of claim 5.</i>
13	<i>See grounds of claim 1.</i>
15	<i>See grounds of claim 13.</i>
16	<i>See grounds of claim 1.</i>
17	<i>See grounds of claim 9.</i>
20	<i>See grounds of claim 1 in combination with Aygun, Smith, Hamakawa, Vvrilo, Shah, Abbott, and/or MPEG-2.</i>
21	<i>See grounds of claim 9 in combination with Aygun, Smith, Hamakawa, Vvrilo, Shah, Abbott, and/or MPEG-2.</i>

For example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Abbott with Sonohara. Abbott and Sonohara are in the same field of endeavor. In view of Sonohara's teaching that numbered image data portions and sound data portions are output synchronously and sequentially, a POSITA would be motivated to output each of the content-related second data segments together with an associated one of the content-related first data segments in the systems and methods of Abbott. It would have been within the ability of a POSITA to combine the teachings of Abbott and Sonohara. A POSITA would have a reasonable expectation of success combining Abbott with Sonohara because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Abbott with Smith. Abbott and Smith are in the same field of endeavor. In view of Smith's teaching that static and streaming media files are linked together during a synchronization process, a POSITA would be motivated to output each of the content-related second data segments together with an associated one of the content-related first data segments in the systems and methods of Abbott. It would have been within the ability of a POSITA to combine the teachings of Abbott and Smith. A POSITA would have a reasonable expectation of success combining Abbott with Smith because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Abbott with Herpel. Abbott and Herpel are in the same field of endeavor. A POSITA would be motivated to add an assignment rule for assigning each one of the content-related second data segments to one of the content-related first data segments, as described in Herpel, to implement Abbott's teaching of sequentially outputting content-related first data

segments and content-related second data segments according to their chronological sequence. It would have been within the ability of a POSITA to combine the teachings of Abbott and Herpel. A POSITA would have a reasonable expectation of success combining Abbott with Herpel because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Sonohara with Abbott. Sonohara and Abbott are in the same field of endeavor. A POSITA would be motivated to use first and second data segments from separate first and second data files, as described in Abbott, to implement Sonohara's teaching of outputting together with an associated one of the content-related first data segments on the basis of an assignment rule for assigning each one of the content-related second data segments to one of the content-related first data segments. It would have been within the ability of a POSITA to combine the teachings of Sonohara and Abbott. A POSITA would have a reasonable expectation of success combining Sonohara with Abbott because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Sonohara with Smith. Sonohara and Smith are in the same field of endeavor. A POSITA would be motivated to use first and second data segments from separate first and second data files, as described in Smith, to implement Sonohara's teaching of outputting together with an associated one of the content-related first data segments on the basis of an assignment rule for assigning each one of the content-related second data segments to one of the content-related first data segments. It would have been within the ability of a POSITA to combine the teachings of Sonohara and Smith. A POSITA would have a reasonable expectation of success

combining Sonohara with Smith because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Sonohara with Herpel. Sonohara and Herpel are in the same field of endeavor. A POSITA would be motivated to add an assignment rule for assigning each one of the content-related second data segments to one of the content-related first data segments, as described in Herpel, to implement Sonohara's teaching of sequentially outputting content-related first data segments and content-related second data segments according to their chronological sequence. It would have been within the ability of a POSITA to combine the teachings of Sonohara and Herpel. A POSITA would have a reasonable expectation of success combining Sonohara with Herpel because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Smith with Sonohara. Smith and Sonohara are in the same field of endeavor. A POSITA would be motivated to add an assignment rule not based on a timestamp, as described in Sonohara, to implement Smith's teaching of sequentially outputting the content-related first data segments and the content-related second data segments according to their chronological sequence. It would have been within the ability of a POSITA to combine the teachings of Smith and Sonohara. A POSITA would have a reasonable expectation of success combining Smith with Sonohara because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Smith with Abbott. Smith and Abbott are in the same field of endeavor.

A POSITA would be motivated to add an assignment rule not based on a timestamp, as described in Abbott, to implement Smith's teaching of sequentially outputting the content-related first data segments and the content-related second data segments according to their chronological sequence. It would have been within the ability of a POSITA to combine the teachings of Smith and Abbott. A POSITA would have a reasonable expectation of success combining Smith with Abbott because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Smith with Herpel. Smith and Herpel are in the same field of endeavor. A POSITA would be motivated to add an assignment rule not based on a timestamp, as described in Herpel, to implement Smith's teaching of sequentially outputting the content-related first data segments and the content-related second data segments according to their chronological sequence. It would have been within the ability of a POSITA to combine the teachings of Smith and Herpel. A POSITA would have a reasonable expectation of success combining Smith with Herpel because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Shah with Abbott. Shah and Abbott are in the same field of endeavor. A POSITA would be motivated to add synchronizing content-related first data segments of a first data file and content-related second data segments of a second data file, as described in Abbott, to implement Shah's teaching of synchronizing audio to video segments. It would have been within the ability of a POSITA to combine the teachings of Shah and Abbott. A POSITA would have a reasonable expectation of success combining Shah with Abbott because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Shah with Sonohara. Shah and Sonohara are in the same field of endeavor. A POSITA would be motivated to add synchronizing content-related first data segments of a first data file and content-related second data segments of a second data file, as described in Sonohara, to implement Shah's teaching of synchronizing audio to video segments. It would have been within the ability of a POSITA to combine the teachings of Shah and Sonohara. A POSITA would have a reasonable expectation of success combining Shah with Sonohara because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Shah with Smith. Shah and Smith are in the same field of endeavor. A POSITA would be motivated to add synchronizing content-related first data segments of a first data file and content-related second data segments of a second data file, as described in Smith, to implement Shah's teaching of synchronizing audio to video segments. It would have been within the ability of a POSITA to combine the teachings of Shah and Smith. A POSITA would have a reasonable expectation of success combining Shah with Smith because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Aygun with Hamakawa. Aygun and Hamakawa are in the same field of endeavor. A POSITA would be motivated to add at least one of media data and metadata represented by at least one of the first data file and the second data file, as described in Hamakawa, to implement the systems and methods of Aygun. It would have been within the ability of a POSITA to combine the teachings of Aygun and Hamakawa. A POSITA would have a reasonable

expectation of success combining Aygun with Hamakawa because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Leopold with Aygun. Leopold and Aygun are in the same field of endeavor. A POSITA would be motivated to add outputting on the basis of an assignment rule, as described in Aygun, to implement Leopold's teaching of sequentially outputting content-related first data segments and content-related second data segments. It would have been within the ability of a POSITA to combine the teachings of Leopold and Aygun. A POSITA would have a reasonable expectation of success combining Leopold with Aygun because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Panis with Aygun. Panis and Aygun are in the same field of endeavor. A POSITA would be motivated to add predefinable assignment rules, as described in Aygun, to implement Panis's teaching of the gBSD Schema for generating an adapted bitstream to sequentially output content-related first and second data segments. It would have been within the ability of a POSITA to combine the teachings of Panis and Aygun. A POSITA would have a reasonable expectation of success combining Panis with Aygun because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Panis with Abbott. Panis and Abbott are in the same field of endeavor. A POSITA would be motivated to add assignments rules not based on a timestamp, as described in Abbott, to implement Panis's teaching of the gBSD Schema for generating an adapted bitstream to sequentially output content-related first and second data segments. It would have been within

the ability of a POSITA to combine the teachings of Panis and Abbott. A POSITA would have a reasonable expectation of success combining Panis with Abbott because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of Timmerer with Herpel. Timmerer and Herpel are in the same field of endeavor. A POSITA would be motivated to add an assignment rule for assigning each one of the content-related second data segments to one of the content-related first data segments, as described in Herpel, to implement Timmerer's teaching of sequentially outputting content-related first data segments and content-related second data segments according to their chronological sequence. It would have been within the ability of a POSITA to combine the teachings of Timmerer and Herpel. A POSITA would have a reasonable expectation of success combining Timmerer with Herpel because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of MPEG-2 with Abbott. MPEG-2 and Abbott are in the same field of endeavor. A POSITA would be motivated to use assignment rules and predefinable assignment rules, as described in Abbott, to implement MPEG-2's teaching of sequentially outputting, by a device for synchronizing content-related data, the content-related first data segments and the content-related second data segments according to their chronological sequence in such a way that each of the content-related second data segments is output together with an associated one of the content-related first data segments. It would have been within the ability of a POSITA to combine the teachings of MPEG-2 and Abbott. A POSITA would have a reasonable expectation of success

combining MPEG-2 with Abbott because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of MPEG-2 with Sonohara. MPEG-2 and Sonohara are in the same field of endeavor. A POSITA would be motivated to use assignment rules and predefinable assignment rules, as described in Sonohara, to implement MPEG-2's teaching of sequentially outputting, by a device for synchronizing content-related data, the content-related first data segments and the content-related second data segments according to their chronological sequence in such a way that each of the content-related second data segments is output together with an associated one of the content-related first data segments. It would have been within the ability of a POSITA to combine the teachings of MPEG-2 and Sonohara. A POSITA would have a reasonable expectation of success combining MPEG-2 with Sonohara because it only involves the predictable use of prior art elements according to their established functions.

As another example, and without limitation, it would have been obvious to a POSITA to combine the teachings of MPEG-2 with Smith. MPEG-2 and Smith are in the same field of endeavor. A POSITA would be motivated to use assignment rules and predefinable assignment rules, as described in Smith, to implement MPEG-2's teaching of sequentially outputting, by a device for synchronizing content-related data, the content-related first data segments and the content-related second data segments according to their chronological sequence in such a way that each of the content-related second data segments is output together with an associated one of the content-related first data segments. It would have been within the ability of a POSITA to combine the teachings of MPEG-2 and Smith. A POSITA would have a reasonable expectation of success

combining MPEG-2 with Smith because it only involves the predictable use of prior art elements according to their established functions.

V. OTHER INVALIDITY GROUNDS

Starz hereby identifies grounds upon which the asserted claims are invalid for failure to meet the requirements of 35 U.S.C. §§ 101, and 112. These contentions shall not be construed as an admission that any claim construction advanced by Starz in this case is in any way inconsistent, flawed, or erroneous. Nor should these contentions prevent Starz from advancing claim construction and/or non-infringement positions in lieu of, or in addition to, invalidity positions. Further, these contentions shall not be construed as an admission of or acquiescence to VideoLabs' purported construction of the claim language or of other positions advanced by VideoLabs during the course of this litigation. Starz's Invalidity Contentions under 35 U.S.C. §§ 101 and 112 may depend, in part, on VideoLabs' alleged scope of the asserted claims. Consequently, Starz identifies only the issues under 35 U.S.C. §§ 101 and 112 of which they are presently aware.

A. 35 U.S.C. § 101

Each of the asserted claims of the asserted patents are invalid under 35 U.S.C. § 101 for claiming ineligible subject matter. Starz hereby incorporates by reference the reasons for patent ineligibility under 35 U.S.C. § 101 set forth in Starz's Motion to Dismiss and supporting papers (D.I. 19, 20, 21, 27) and reserves the right to contend that the asserted claims are invalid under 35 U.S.C. § 101.

Without limitation of the foregoing, Starz further notes that the claims of the patents-in-suit are directed to data manipulation, such as synchronizing two data segments based on an unspecified "assignment rule" ('794 patent), controlling the flow of content based on general status information ('559 patent), and/or maintaining a product catalog that stores and uses references to

implementations of the content ('790 patent). This is “a familiar class” of abstract ideas. *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed Cir. 2016); see *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“A process that start[s] with data, add[s] an algorithm, and end[s] with a new form of data [i]s directed to an abstract idea.”). The “well-known computer components” in the claims, such as servers and processors, do “not render these claims any less abstract.” *Bozeman Fin. LLC v. FRB of Atlanta*, 955 F.3d 971, 979 (Fed. Cir. 2020); see *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 224 (2014).

The claims also contain no inventive concept. The patents-in-suit do not purport to improve computer components. Instead, they allege advances in data manipulation, like cataloguing multiple implementations of content instead of just one. See D.I. 1-1 Ex. 1 at Abstract, 1:22-2:17. But the abstract idea itself “cannot supply the inventive concept.” *BSG Tech. LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018).

B. 35 U.S.C. § 112

1. Enablement and Written Description

To comply with the enablement requirement of 35 U.S.C. § 112, the patent specification must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993). Courts consider multiple factors to determine whether experimentation is undue, including: “(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.” *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

To comply with the written description requirement of 35 U.S.C. § 112, the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention. *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997). Further, to satisfy the written description requirement, the disclosure of the patent must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, [the inventor] was in possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). “An applicant demonstrates that he was in possession of the invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the invention.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). “[T]he written description inquiry looks to the four corners of the specification to discern the extent to which the inventor(s) had possession of the invention as broadly claimed. The knowledge of ordinary artisans may be used to inform what is actually in the specification, but not to teach limitations that are not in the specification, even if those limitations would be rendered obvious by the disclosure in the specification.” *Rivera v. Int’l Trade Comm’n*, 857 F.3d 1315, 1322-23 (Fed. Cir. 2017) (citations omitted). In other words, even if something reflects an obvious variation of the invention disclosed in the specification, the claims are invalid for lack of written description.

The asserted claims are invalid for failure to enable and/or provide a written description of the alleged invention as required by 35 U.S.C. § 112. A person skilled in the art would not be able to make and use the claimed inventions by reading the specification. For example, the asserted patents fail to sufficiently describe or enable at least the following limitations:

a. '790 Patent

Claim Element	Claims	§ 112 Grounds
“associating each of the items of digital content in the server system with a plurality of different provisioning models ... each provisioning model including a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices”	5	Lack of written description pursuant to pre-AIA § 112, para. 1; Lack of enablement pursuant to pre-AIA § 112
“a reference to each implementation of said item of content”	1, 2, 8, 9	Lack of written description pursuant to pre-AIA § 112, para. 1; Lack of enablement pursuant to pre-AIA § 112

For example, the term “associating each of the items of digital content in the server system with a plurality of different provisioning models ... each provisioning model including a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices” is invalid as lacking written description and enablement because there is no support in the specification for the term “provisioning model(s)” that describes or enables the full scope of the term. For example, the '790 patent specification merely describes the benefits of provisioning models, that provisioning models are selected based on device capabilities, and that provisioning models make use of provisioning attributes and descriptors. However, the '790 patent specification fails to explain how the provisioning models are selected and utilized based on the device capabilities, or how and when each item of digital content in the server system is to be associated with provisioning models. As a result, this term lacks written description as the specification fails to describe the invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention.

Furthermore, this term is not enabled as the specification fails to teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.

For example, the term “a reference to each implementation of said item of content” is invalid as lacking written description and enablement because there is no support in the specification for the term that describes or enables the full scope of the term. For example, the ’790 patent specification fails to describe how all implementations are stored with respect to each item of content. Further, the specification for example fails to describe or enable the full scope of the term “implementation” under the court’s claim construction of the term, i.e., “one or more binary files (or ‘binaries’), software files, software applications, and/or executable files representing a product,” as it fails to describe how a claimed “implementation” can be each of a binary file, software file, software application, and executable file representing a product *See* D.I. 88 at 3. As a result, this term lacks written description as the specification fails to describe the invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention. Furthermore, this term is not enabled as the specification fails to teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.

b. ’559 Patent

Claim Element	Claims	§ 112 Grounds
“the processor is configured to send, to the terminal, a response to the content status that instructs the terminal to perform one or more actions to thereby control the flow of content to the terminal based upon the terminal status information and the server status information”	1	Lack of written description pursuant to pre-AIA § 112, para. 1; Lack of enablement pursuant to pre-AIA § 112

For example, the term “the processor is configured to send, to the terminal, a response to the content status that instructs the terminal to perform one or more actions to thereby control the flow of content to the terminal based upon the terminal status information and the server status information” is invalid as lacking written description and enablement because there is no support in the specification for the term that describes or enables the full scope of the term. For example, the ’559 specification fails to disclose instructions to the terminal to perform actions to control the flow of content to the terminal other than whether to download or delete content. Such actions are encompassed by the dependent claims to claim 1, and as such the full scope of the term “instructs the terminal to perform one or more actions to thereby control the flow of content to the terminal” is not fully described or enabled to a person of ordinary skill in the art. As a result, this term lacks written description as the specification fails to describe the invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention. Furthermore, this term is not enabled as the specification fails to teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.

c. ’794 Patent

Claim Element	Claims	§ 112 Grounds
“each of the content-related second data segments is output together with an associated one of the content-related first data segments on the basis of an assignment rule for assigning each one of the content related second data segments to one of the content-related first data segments”	1	Lack of written description pursuant to pre-AIA § 112, para. 1; Lack of enablement pursuant to pre-AIA § 112
“each of the content-related second data segments being output together	9	Lack of written description pursuant to pre-AIA § 112, para. 1;

Claim Element	Claims	§ 112 Grounds
with an associated one of the content-related first data segments based upon of an assignment rule for assigning each one of the content-related second data segments to each one of the content-related first data segment”		Lack of enablement pursuant to pre-AIA § 112

For example, the terms “each of the content-related second data segments [is/being] output together with an associated one of the content-related first data segments [on the basis of/based upon of] an assignment rule for assigning each one of the content related second data segments to [each] one of the content-related first data segments” are invalid as lacking written description and enablement because there is no support in the specification for the term “assignment rule” that describes or enables the full scope of the terms. For example, dependent claims 16 and 17, which depend from independent claims 1 and 9, respectively, require the claimed assignment rule to be “predefinable.” Likewise, dependent claims 20 and 21, which depend from independent claims 1 and 9, respectively, require the claimed assignment rule to be “not based on a timestamp.” Thus, the full scope of the term “assignment rule” as claimed in independent claims 1 and 9 includes assignment rules that are both non-predefinable and capable of being based on a timestamp. *See, e.g., Markman* Hearing Transcript at 109:6-14. However, the ’794 patent specification fully lacks any description, explanation, or demonstration of such assignment rules that would convey to persons skilled in the art that the inventors were in possession of the full scope of the invention as of the filing date. As a result, these terms lack written description as the specification fails to describe the invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention. Furthermore, these terms are not enabled as the

specification fails to teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.

2. Indefiniteness

The claims of a patent must “particularly point out and distinctly claim the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112. A claim is invalid as indefinite if it is not sufficiently precise to permit a potential competitor to determine whether or not it is infringing. *Morton Int’l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470 (Fed. Cir. 1993). Specifically, “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 891, 901 (2014). Furthermore, when a claim includes a term of degree, the patent “must provide ‘some standard of measuring that degree’ such that the claim language provides ‘enough certainty to one of skill in the art when read in context of the invention.’” *GE Lighting Solutions, LLC v. Lights of Am., Inc.*, 663 Fed. App’x. 938, 940 (Fed. Cir. 2016); *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370 (Fed. Cir. 2014). For terms of degree, “the patent must provide that additional information in the form of ‘objective boundaries.’” *Id.*; *see also Berkheimer v. HP Inc.*, 881 F.3d 1360, 1364 (Fed. Cir. 2018). Finally, to comply with 35 U.S.C. § 112, claims must “positively recite structural relationships” between the essential elements of the claimed invention. *In re Collier*, 397 F.2d 1003, 1005 (C.C.P.A. 1968); *Courtesy Prods., L.L.C. v. Hamilton Beach Brands, Inc.*, No. 13-2012-SLD, 2015 U.S. Dist. LEXIS 155572, at *8 (Nov. 18, 2015).

Under this standard, a person skilled in the art would not be able to determine the scope of the invention because of the indefiniteness of at least the following terms:

a. '790 Patent

Claim Element	Claims
“provisioning model” / “provisioning models”	5, 6, 7

For example, the term “associating each of the items of digital content in the server system with a plurality of different provisioning models ... each provisioning model including a provisioning protocol and a corresponding set of provisioning attributes and descriptors for provisioning digital content in wireless devices” is invalid as for indefiniteness because there is no support in the specification for the term “provisioning model(s)” that describes or enables the full scope of the term. For example, the '790 patent specification merely describes the benefits of provisioning models, that provisioning models are selected based on device capabilities, and that provisioning models make use of provisioning attributes and descriptors. However, the '790 patent specification fails to explain how the provisioning models are selected and utilized based on the device capabilities, the scope of device capability information that is required to make such a selection, or how and when each item of digital content in the server system is to be associated with a particular provisioning model. As a result, this term is invalid as indefinite because this term, when read in light of the specification delineating the patent, and the prosecution history, fails to inform, with reasonable certainty, those skilled in the art about the scope of the invention.

b. '559 Patent

Claim Element	Claims
“a content status including terminal status information”	1

For example, the term “a content status including terminal status information” is invalid for indefiniteness because there is no support in the specification for the term “a content status including terminal status information” that describes or enables the full scope of the term. For example, the '559 patent specification gives unbounded descriptions of when a content status can

be sent, what information it contains about a terminal (i.e., the terminal status information), and what communications between the terminal and processor are considered content statuses. As a result, this term is invalid as indefinite because this term, when read in light of the specification delineating the patent, and the prosecution history, fails to inform, with reasonable certainty, those skilled in the art about the scope of the invention.

c. '794 Patent

Claim Element	Claims
“each of the content-related second data segments is output together with an associated one of the content-related first data segments on the basis of an assignment rule for assigning each one of the content related second data segments to one of the content-related first data segments”	1
“each of the content-related second data segments being output together with an associated one of the content-related first data segments based upon of an assignment rule for assigning each one of the content-related second data segments to each one of the content-related first data segment”	9
“assignment rule for assigning each one of the content-related second data segments to one of the content-related first data segments” / “assignment rule for assigning each one of the content-related second data segments to each one of the content-related first data segment” / “assignment rule”	1, 3, 9, 16, 17
“the assignment rule is not based on a timestamp”	20, 21
“device for synchronizing” / “synchronization device” / “device”	1, 9, 17, 21
“for each of the content-related second data segments, the content-related first data segments are assigned by specification of a number”	3
“predefinable”	16, 17

For example, the terms “each of the content-related second data segments is output together with an associated one of the content related first data segments on the basis of an assignment rule for assigning each one of the content related second data segments to one of the content related first data segments” / “each of the content-related second data segments being output together with an associated one of the content-related first data segments based upon of an assignment rule for assigning each one of the content-related second data segments to each one of the content-related first data segment” / “assignment rule for assigning each one of the content related second data segments to one of the content related first data segments” / “assignment rule for assigning each one of the content related second data segments to each one of the content related first data segment” / “assignment rule” / “the assignment rule is not based on a timestamp” / “for each of the content-related second data segments, the content-related first data segments are assigned by specification of a number” are invalid as indefinite for the reasons described by Starz in the parties’ Joint Claim Construction Brief (D.I. 78), the arguments of which are incorporated by reference herein.

For example, the terms “device for synchronizing” / “synchronization device” / “device” are invalid as indefinite because the ’794 patent specification fails to provide one of ordinary skill in the art with a sufficient clear indication of the scope or meaning of the device that is capable of performing the claimed methods and systems. For example, the applicants added the claim terms “device for synchronizing” and “synchronization device” merely to overcome an examiner’s rejection of the claims under 35 U.S.C. § 101 on the grounds that the claims as originally written were not tied to a particular machine. *See, e.g.*, Final Rejection Office Action (dated 6/29/2012); Applicant Arguments/Remarks Made in an Amendment (dated 11/29/2012); Final Rejection Office Action (dated 5/8/2013); Applicant Arguments/Remarks Made in an Amendment (dated

6/28/2013). However, no disclosures were added to the specification to describe the scope or structure of the “device” such that one of ordinary skill in the art would have a sufficient clear indication of the scope or meaning of the device that is capable of performing the claimed methods and systems. As a result, these terms are invalid as indefinite because these terms, when read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.

For example, the term “predefinable” is invalid as indefinite because the ’794 patent specification fails to provide one of ordinary skill with a sufficient clear indication of the scope or meaning of when an assignment rule is “predefinable.” For example, the ’794 patent specification fails entirely to describe to one of ordinary skill in the art the objective boundaries of when in the claimed methods or systems an assignment rule must be defined in order to be considered “predefin[ed]”, and the extent to which the assignment rule must be “predefine[ed]” at such time. As a result, this term is invalid as indefinite because this term, when read in light of the specification delineating the patent, and the prosecution history, fails to inform, with reasonable certainty, those skilled in the art about the scope of the invention.

The above identification of claims/claim elements are exemplary, and Starz reserves the right to supplement the identification of claims and claim elements that do not comply with the enablement, written description, and indefiniteness requirements of Section 112. Specifically, to the extent that an element identified below, or its variation, appears in claims other than the ones specified below, it also renders those additional claims invalid under Section 112. Claims that depend on these additional claims and on the claims identified below are also invalid under Section 112. Starz reserves the right to identify additional claims and claim elements that do not comply with the requirements of Section 112 should VideoLabs make further allegations based on

claim scope lacking the requisite Section 112 support, including in any amended infringement contentions. Furthermore, this identification of claims/claim elements should not be interpreted as reflecting Starz's position on the construction of any claim/claim element.

VI. DOCUMENT PRODUCTION ACCOMPANYING SECOND AMENDED INVALIDITY CONTENTIONS

A. Document Production Pursuant to Paragraphs 6(a)-(e)

Starz previously produced potentially relevant documents in its possession, custody, or control pursuant to paragraphs 6(a)-(e) of the Scheduling Order. With these Second Amended Invalidity Contentions, Starz has produced copies of additional prior art identified pursuant to paragraph 5(a) of the Scheduling Order. Specifically, Starz has produced documents bearing production numbers STARZ-VL 0001081955 – STARZ-VL 0001082086.

Starz's investigation is ongoing, and Starz reserves all rights to supplement or amend its document production and identification as it locates or becomes aware of additional responsive information and as discovery progresses.

TABLE OF EXHIBITS

Exhibits	Description
A	Invalidity Charts for the '790 patent
B	Invalidity Charts for the '559 patent
C	Invalidity Charts for the '794 patent
D	Prior Art Reflecting the General State of the Art

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