

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner.

Case IPR2023-00630
Patent No. 7,440,559

**PETITIONER'S REPLY TO PATENT OWNER RESPONSE IN *INTER*
PARTES REVIEW OF U.S. PATENT NO. 7,440,559**

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I. INTRODUCTION

The Board instituted review of all of the '559 patent's claims as being anticipated by Cassin (EX1004) and obvious over Cassin in view of Houston (EX1005).

PO's Response ("POR") fails to raise any genuine issue of merit. The record remains clear. Both Cassin and the '559 patent claims are directed to a system for controlling the flow of content from the server to a client computer, and thus Cassin anticipates the '559 patent. At bottom, the POR seeks to either mischaracterize and/or selectively ignore Cassin's express teachings.

Likewise, PO's arguments regarding the combination of Cassin and Huston are unavailing. Cassin teaches controlling the flow of content through the server instructing the client computer to download content. Huston teaches a delete command for deleting content from the client computer. It stands to reason that a POSITA would have been motivated to use such a well-known feature of a delete command, as disclosed in Huston, to facilitate an improved Cassin system.

Accordingly, the Board should find the claims of the '559 patent unpatentable.

II. PATENT OWNER MISCHARACTERIZES BOTH THE '559 PATENT AND CASSIN

The overlap between the '559 patent claims and Cassin's disclosures is ineluctable.

The '559 patent specifically discloses a “content flow manager . . . capable of controlling the terminal to delete at least one piece of content from a memory of the terminal, and/or download at least one piece of content from a source of content.” EX1001, 3:20-24. The control flow manager controls the terminal using basic status information, such as user information including “user preferences, capabilities of the terminal and/or previous contents stored by the terminal,” or a list of content available from the server. *Id.*, 3:4–9.

Similarly, Cassin teaches a media content delivery system in which a server obtains a list of content available to the client based on user information received from the client and then “attempts to send the first media content item” to the client. EX1004, [0164]. If “the client computer does not have the media content item, then the client computer accepts the download of the media content item from the server computer” by downloading and “stor[ing] the media content item” in its local content repository. *Id.*, [0163].

Attempting to differentiate Cassin, PO characterizes the '559 patent as allegedly a “hybrid ‘push/pull’ system” in which the server does not “tak[e] action

directly,” but instead “instructs the terminal to go and get the content.” POR, 1. First, neither the ’559 patent specification nor its claims call for any such system. Second, PO’s baseless characterization overstates the role of the terminal and is categorically at odds with the ’559 patent’s disclosure because the server can take action directly by instructing the client to download content that the server attempts to send. Thus, the ’559 patent claims are not limited to only the client pulling content from the server.

Indeed, the ’559 patent criticized prior systems in which mobile terminals utilized the “pull” technique to download content from a server because those systems had “inefficient content flow control” between the terminal and the server/content provider. EX1001, 2:27-31; 47-49 (“current techniques for downloading content can suffer from inefficient control of content received”). Accordingly, the ’559 patent repeatedly discloses that it is the “content flow manager” (*i.e.*, the server) that controls, *i.e.*, takes action, for the “downloading and storage of content . . . at the terminal.” *Id.*, 11:10–13; *see, e.g.*, Abstract, 3:4-6 (“in contrast to conventional techniques for downloading content to a terminal, the network entity can control the flow of content to the terminal”); 3:31-36; 11:3-5; 11:56-61; 13:55–56.

In addition to mischaracterizing the ’559 patent, PO also ignores express disclosures in Cassin in attempting to distinguish it from the ’559 patent. PO

contends in Cassin, the “server computer sends” or delivers “content to the client computer.” POR, 10. This disregards the fact that in Cassin, the server instructs the client to download content by sending it content—the client computer is the component that “accepts the media content item from the server,” and “stores the media content item in the local content repository.” EX1004, [0163, 0164]. PO further attempts to differentiate Cassin by asserting that “Cassin teaches away from streaming content,” but to the contrary, Cassin expressly teaches that its system can support “synchronous delivery” or “streaming” content. EX2002 ¶49; EX1004 ¶¶127–30, 148, 176. Regardless, the ’559 patent claims are not limited to a system that only streams content. Thus, this demonstrates that PO’s attacks of the Petition are predicated on factual inaccuracies.

III. CASSIN ANTICIPATES THE CHALLENGED CLAIMS OF THE ’559 PATENT

Claims 1, 2, 4, 7, 8, 10, 13, 14, 16, 19, 20, and 22 of the ’559 patent are anticipated by Cassin.

A. Cassin teaches “terminal status information comprising a listing of at least one piece of content stored in the memory of the terminal”

Cassin’s “indication to the server computer that it currently has the media content item” is the claimed “terminal status information comprising a listing of at least one piece of content” stored in the memory of the terminal.” Pet., 22.

Cassin makes it abundantly clear that the “indication” sent to the server *can* be a list of content items stored on the client computer. Specifically, claims 130 and 132 of Cassin recite a “second indication” that the server receives from a remote device, *i.e.*, a client computer, which includes a “*list* of a second group of media content items including at least a second media content item, which is the media content.” EX1004, cls. 130, 132 (emphasis added). Notably, claim 132 recites a “*list*” like the ’559 patent claims—it is not just a “group of media content items,” as PO asserts. POR, 41. Claim 133 further narrows claim 132 to limit the list of a second group of media content items to those “that the remote device will accept for delivery,” *i.e.*, items not currently stored on the client computer. Because a dependent claim is narrower than a claim from which it depends, *see Littelfuse, Inc. v. Mersen USA EP Corp.*, 29 F.4th 1376, 1380 (Fed. Cir. 2022), the scope of the “list” recited in claim 132 is certainly broad enough to include a list of media content items that *are* stored on the client computer. EX1003, ¶¶92-93. Netflix’s expert, Mr. Wechselberger, confirmed that a POSITA would readily recognize that disclosure from the dependent claims of Cassin. Ex. 2003, 71:1–72:10. Therefore, PO’s argument that “a POSITA would understand that Cassin does not disclose that this ‘indication’ includes a ‘list of the media content items already stored on the client computer’” is without merit. POR, 40.

PO insists that Cassin “does not disclose what is included in the ‘indication’” and therefore does not satisfy the claimed “terminal status information comprising a listing of at least one piece of content.” POR, 40. While Cassin’s specification does not define the parameters of an “indication,” that simply means that the scope of “indication” is broad, and a POSITA would have understood consistent with Cassin what would fall within the scope of that term. Thus, Mr. Wechselberger’s testimony that Cassin does not “define the structure or contents of the indication” is consistent with Cassin’s disclosure and that does not undermine his analysis that the scope of “indication” undoubtedly includes a “list of the media content items already stored on the client computer” as recited in Cassin’s claims. *See Therasense, Inc. v. Becton, Dickinson & Co.*, 593 F.3d 1289, 1295 (Fed. Cir. 2010), *opinion vacated then reinstated in relevant part*, 649 F.3d 1276 (Fed. Cir. 2011) (“The claims of a prior art patent are part of its disclosure.”). That other information could possibly fall within the scope of an “indication” does not negate that an “indication” satisfies the claimed “list of the media content items already stored on the client computer.”

PO’s expert Dr. Goodrich’s opinion that the scope of Cassin’s “indication” would be limited to “preferably be the smallest amount of data, such as a simple ‘yes’ or ‘no,’” and that it “would not be obvious to make the ‘indication’ an actual list of content, which would require more data than necessary” directly contradicts

Cassin’s claims that expressly state the “indication” includes a “list of a second group of media content items.” EX2002, ¶120. Moreover, Dr. Goodrich’s opinion that if the client computer were to send a list of all the content items it has stored, such a list “could break the system” due to its large size is simply incredulous. EX1025, 89:11–21. Any concerns about the size of the list would be equally applicable to the server computer sending a list of content items to which the user is entitled, which is expressly recited in the ’559 patent and in Cassin. *See, e.g.*, Ex. 1004 ¶¶164, 166.

B. Cassin teaches “a response to the content status that instructs the terminal [or controller] to perform one or more actions to thereby control the flow of content to the terminal based upon the terminal status information”

PO’s main attack on this limitation is premised on the flawed conclusion that Cassin’s “server does not send *instructions* for the terminals to take an action, but takes the action itself.” POR, 20. But that argument mischaracterizes and ignores Cassin’s express disclosures.

1. Cassin teaches several forms of “content status including terminal status information”

Although Cassin teaches several forms of the claimed “content status including terminal status information” Cassin’s “user information” is one example.

The ’559 patent explains that the “status information in the content status can include *any of a number of different pieces of information* regarding the

terminal 10 and the contents stored therein.” EX1001, 12:18-20 (emphasis added).

The ’559 patent provides examples of “terminal status information”: “terminal status information *can* include information reflecting user preferences, capabilities of the terminal, previous contents stored by the terminal, and/or the use of such previous contents.” EX1001, 3:63–66 (emphasis added). “*To facilitate control of the flow of content . . .* a terminal is capable of sending a content request that includes terminal status information.” *Id.*, 2:62-65 (emphasis added). The underlying point is that the claimed “terminal status information” is used to facilitate control of the flow of content, can be a wide variety of information about the terminal and its contents, and is not limited to the examples the ’559 patent discloses. *Id.*

There are several forms of “content status that is based upon the terminal status information” taught in Cassin, and as explained below, some are specific to either the first protocol or the second. But both protocols disclose that after a connection between the client and server have been established, “the client computer sends *user information* to the server” and the “server computer uses the user information to query the database 640.” EX1004, [0164, 0167] (emphasis added). Like the ’559 patent’s “terminal status information,” Cassin explains that the client “transmits *user information* to the server computer to “*facilitate the delivery of media content to the client computer.*” *Id.*, [0155]. Cassin also

contemplates that such user information could be used to reflect user preferences, which are expressly included within the scope of the claimed “terminal status information.” EX1004, ¶91 (user information can be used to select advertisements “that will most likely appeal to” the consumer); EX1001, 3:63–66. Therefore, Cassin’s “user information” is undoubtedly a “content status that is based upon the terminal status information” since it is used to query the database to facilitate the delivery of media content to the client.

Instead of considering the relevant portions of Cassin to understand what is “user information,” PO misdirects focus to an example of *statistical user information*. See POR, 25 (“Cassin only gives one example of ‘user information’: ‘The sponsor for this content item knows from the statistical user information gathered for that user, that the woman is between 35-50 years of age’”). But statistical user information is not user information. Indeed, the statistical user information that PO identifies in Cassin is not used to query the database to facilitate the delivery media content. Thus, PO’s basis for contending that Cassin’s “user information” is not “content status including terminal status information” is baseless.

2. Cassin teaches “a response to the content status that instructs the terminal . . .”

As explained below, Cassin’s two protocols individually¹ teach the claimed “response to the content status that instructs the terminal [or controller] to perform one or more actions to thereby control the flow of content to the terminal based upon the terminal status information.” Pet., 25–26.

PO contends “Cassin only discloses the server computer sending content itself (either the media content item or the list of media content items) to the client computer—and doing so “automatically.” POR, 22. In other words, PO argues “Cassin does not disclose sending *instructions* for the client computer to then do something to control the flow of content.” *Id.*, 23. This characterization is wrong for several reasons.

¹ PO asserts the Petition “relies on a combination of two separate embodiments to satisfy the claim requirements.” POR, 24. This is false. As explained below, the first-protocol and second-protocol embodiments disclosed in Cassin both independently meet the “response” limitations of the challenged claims. The Petition does not and did not need to combine the two protocols to establish that Cassin anticipates the ’559 patent.

First, PO’s account of Cassin is replete with factual inaccuracies. As explained above in Section II, PO overstates the role of the terminal in the ’559 patent. Moreover, when the server offers a media item for the client to download, the server is “instructing the terminal to perform one or more actions to thereby control the flow of content.” Pet., 25–26. Depending on whether or not the client computer has the media content, the client will either “refuse[] the download” (if it has the content) or “accepts the download of the media content item from the server and stores the media content in the local content repository” (if the client does not have the content). EX1004, [0163].² Contrary to PO’s characterization of Cassin, by refusing or accepting the download offer, the client is doing “something to control the flow of content” in response to the server’s instruction to download the content. POR, 23.³

Second, the ’559 patent expressly discloses “a method of controlling storage of content generally includes the terminal 10 *downloading or otherwise receiving*,

² Both parties agree that paragraphs [0162-0163] apply to both of Cassin’s first and second protocols. POR, 26; EX2002, 16:7–21; EX1025, 29:20–30:4.

³ Notably, none of PO’s cited quotes from Cassin include this language of the client accepting or refusing the server’s download offer.

at one or more points in time, one or more pieces of content from a content source” EX1001, 11:57-60 (emphasis added). Thus, when Cassin’s server attempts to send or deliver a media content item or items to the client, the server is controlling the flow of content, which necessarily means that the server “instructs the terminal to perform one or more actions [*i.e.*, downloading and storing] to thereby control the flow of content to the terminal.”

Thus, when the server “automatically” delivers content to the client or “automatically” instructs the client to download content, that is consistent with the ’559 patent claims. Indeed, even PO characterized the ’559 patent in this way in a recently filed amended complaint. EX1026, 9 (“terminals can now *automatically* be instructed to download certain content, such as when a new season of a previously watched show is released. As another example, content already stored on a terminal can be *automatically* deleted”) (emphasis added) (internal citations omitted).

Accordingly, as explained below, there are multiple ways in which both Cassin’s first and second protocols teach the limitations of the ’559 patent including the claimed “a response to the content status that instructs the terminal . . . based upon the terminal status information.” PO’s arguments

attacking this analysis should be disregarded as PO conflates the first and second protocols.⁴

(1) First Protocol

Regarding Cassin’s first protocol, after the server queries its database with the client’s user information (*i.e.* “content status including terminal status information”), the database “responds with a list of all content to which that user is entitled,” which is the claimed “server status information comprises a listing of at least one piece of content available from the source.” Pet., 23–24. The server then sends that list to the client. EX1004, [0164]. Afterwards, the server computer “attempts to send a first media content item on the list to the client computer.” *Id.* The client then determines in step 860 if it already has the media content item in its repository. *Id.* If the client “does not have the media content item, then in step 880, the client computer takes action, accepting the download of the media content from the server and storing it to its repository. *Id.*; *see also id.*, [0163]. Thus, PO’s argument that “the user’s only actions are to say whether or not it has content already” is simply not true. POR, 33. Accordingly, in this situation, based upon the user information used to query the server’s database, the server responds by

⁴ PO also includes various restaurant analogies, which are incomplete and not analogous to Cassin. *See, e.g.*, POR, 36.

instructing the client to download the selected media content item, which satisfies the claimed “response to the content status . . . based upon the terminal status information.” Pet, 25–26. When the server instructs the client to download the media content item, the server satisfies the claimed “instructs the terminal to perform one or more actions to thereby control the flow of content to the terminal.” *Id.*

The ’559 patent’s claims read on another part of Cassin’s first protocol. After performing step 860, if the client has the media content item in its repository, then “the client computer provides an indication to the server computer that it currently has the media content item, such that the server computer will offer the next media item on the list” (*i.e.*, the second media content item). EX1004, [0164]. If the client does not have the second media content item, then the client will take action to accept the download and download and store the second media content item. Pet., 25–26 (citing EX1004, [0164-1065]). As explained in Section III.A, *supra*, the indication sent from the client is the claimed “terminal status information comprising a listing of at least one piece of content stored in the” terminal’s memory. Thus, the server’s response to the indication to offer the next media content item is the claimed “response to the content status that instructs the terminal to perform one or more actions to thereby control the follow of content.”

(2) Second Protocol

Unlike independent claims 7, 13, and 19, claim 1 of the '559 patent and its dependent claims do not require the “terminal status information” to “compris[e] a listing of at least one piece of content stored in memory.” Thus, the limitation “a response . . . that instructs the terminal to perform one or more actions . . . based upon the terminal status information” in claim 1 of the '559 patent reads on Cassin’s second protocol.

Like the first protocol, the second protocol uses the client’s user information to query the server database, the server responds with a first list of content that the user is entitled, and the server sends the first list to the client. EX1004, [0166]. The client then “identifies those media content items on the first list that it does not already have in the local content repository,” and the client computer then sends to the server “a second list of only those media content items contained in the first list that it currently does not have stored” in its repository. *Id.* The server then “delivers those media content items contained in the second list to the client computer.” *Id.* The client accepts the download of content from the server and stores it in its repository. *Id.*, [0163]. In this situation, the second list is the claimed “content status including terminal status information,” and the server delivering those media content items on the second list to the client is the claimed “response to the content status that instructs the terminal . . .” Pet., 26.

C. Cassin teaches receiving “server status information” that “comprises a listing of at least one piece of content available from the source”

Cassin teaches the claimed “server status information [that] comprises a listing of at least one piece of content available from the source.” In both of Cassin’s protocols, the server sends a “list of all content to which the user is entitled” to the client computer. Pet., 23–24. That list is the result of a query of database 640, which accesses a first content repository 645 “that stores multimedia content in the form of media files.” *Id.*, 23.

PO argues that such a list of content does not satisfy the “server status information” limitation because information stored in the database 640 “does not truly indicate the availability of the content from the source.” POR, 39. In other words, PO speculates, without any substantiation other than its expert’s opinion, that the database 640 may not be perfectly synchronized with the first content repository 645, such that the database would return files that were not truly available from the source. *Id.*, 38–39.

PO’s speculation, however, is not supported by Cassin. Cassin’s disclosures make clear to a POSITA that the information in the database does in fact reflect the content available at the source because the database “must include metadata about the media content *available to the system.*” EX1004, ¶146 (emphasis added). That is, Cassin instructs a POSITA that the database must reflect the content available to

the system, which would necessarily include all content actually stored in first content repository 645. Moreover, Cassin discloses that the media files may be stored directly in the database,⁵ further reinforcing the conclusion that the database is intended to reflect the content available to the system in real time. *Id.* (content may be stored in first content repository 645 “as an alternative” to storing the content in the database).

More generally, the end result of PO’s speculation is nonsensical and plainly not consistent with the intended operation of Cassin. There is nothing in Cassin that would preclude a POSITA from understanding that the database gets updated to ensure it is current with the contents of the repository 645.

Accordingly, PO’s arguments fail to rebut Netflix’s showing that Cassin discloses the claimed “server status information comprises a listing of at least one piece of content available from the source.”

⁵ Dr. Goodrich initially acknowledged this point in his deposition, but then attempted to retreat from it following a break. EX1025, 42:20–24, 66:9–67:18. He stated that his answers given on the topic earlier in the deposition were “partial incomplete answers” and that he “would require more time” to develop an opinion on those express disclosures in Cassin, thus demonstrating his lack of knowledge and preparedness regarding Cassin. *Id.*, 65:4–7, 66:3–4.

IV. THE CHALLENGED CLAIMS ARE OBVIOUS OVER CASSIN AND HUSTON

Cassin teaches nearly all of the limitations claimed in the '559 patent.

Although Cassin teaches how a user can manually delete content, Cassin does not expressly teach the server instructing the client “to delete as least one piece of content.” Huston, which is a central system for “managing and providing content to users” discloses this limitation. EX1005, Title. A POSITA would have been motivated to combine Cassin with Huston to improve upon its system to include a command that would allow the server to instruct the client computer to delete content. Thus, the '559 patent claims are obvious over Cassin in view of Huston.⁶

A. Huston and Cassin disclose “terminal status information comprising a listing of at least one piece of content stored in the memory”

As explained above in Section III.A, *supra*, Cassin teaches this limitation. To the extent Cassin’s indication in the first protocol somehow does not disclose this limitation, Mr. Wechselberger explains how Cassin alone in view of its

⁶ Regarding Ground 2, PO asserts Cassin does not disclose certain limitations of the challenged claims, but these arguments fail for the same reasons discussed with respect to Ground 1, *supra*.

disclosures relating the first and second protocol would render this limitation obvious. EX1003, ¶¶159-160.

Regarding the first protocol, Mr. Wechselberger opines the “indication sent by the client to the server comprises a listing of media content item(s) that is stored in its repository, which is the claimed “terminal status information.” *Id.* With respect to the second protocol, instead of “sending a listing of files the client computer does not already have [], consistent with the disclosure at paragraph [0164], it would have been obvious for a POSITA to try to identify, based on the list sent from the server computer, the media content items the client has in its repository and put that information in a listing,” which is then sent to the server as “terminal status information.” *Id.* (internal citations omitted).

This limitation is also rendered obvious by Cassin and Huston. EX1003, ¶161. Huston teaches “differencing engine 240 selects content to be deleted by comparing versions of content stored on caches 236, 238 to versions of the corresponding content stored on the origin servers.” EX1005, 6:45–48. As Mr. Wechselberger explained, “a POSITA would have understood that the differencing engine 240 would receive an identification of the versions of the content stored on the caches 236, 238” in order to make that comparison. EX1003, ¶161. In that context, the list of the content (and the associated versions) stored on caches 236, 238 is the claimed “terminal status information.”

PO's attack of Mr. Wechselberger's opinion is unavailing. Specifically, PO argues "a POSITA would understand that the differencing engine would already be aware of what content is on the traffic servers" and thus would not need to obtain a listing of the information stored in the caches. POR, 46 (citing EX1005, 7:38–49; EX2002, ¶¶123–24). But the same paragraph of Huston relied on by PO also discloses that it applies to only "one embodiment" and that "[d]ifferencing engine 240 may be located elsewhere and is not limited to any particular location." EX1005, 7:38–49; *see also* EX2003, 55:22–56:9. As Mr. Wechselberger opined, if the differencing engine were located apart from the origin servers and traffic servers as depicted in Figure 2A, it would need to receive "an identification of the versions of the content stored on the caches 236, 238." EX1003, ¶161. Mr. Wechselberger further elaborated that it would have been obvious to a POSITA that the differencing engine "could get the information more directly about what's on the traffic server's cache by using th[e] [communication lines 242, 244 depicted in Fig. 2A of Huston than] to simply ask for it." EX2003, 53:12–15; *see also* EX1005, Fig. 2A. Thus, PO's attacks on Mr. Wechselberger's opinions should be disregarded as they fail to take into account Huston's full disclosures.

B. Huston and Cassin disclose “a response that instructs the terminal to delete at least one piece of content based upon the listing of at least one piece of content stored in the memory of the terminal”

PO does not dispute that Huston teaches the claimed “deleting at least one piece of content.” Instead, PO argues that Huston does not teach the remainder of the limitation but that argument is based on PO’s overly narrow reading of Huston. Specifically, PO asserts that the “Delete” command in Huston only “issues in response to new content in the origin server, not in response to a content status” or “terminal status information.” POR, 48–49. While one embodiment of Huston involves deleting a first version of content” when the “differencing engine 240 detects that a second version of the content has been created and is available,” PO ignores the remainder of the disclosure in Huston. EX1005, 7:60–63.

Huston in fact discloses “a response that instructs the terminal to delete at least one piece of content based upon the listing of at least one piece of content stored in the memory of the terminal.” Huston explains the decision to delete an item of content is made “according to a variety of selection criteria,” which PO has not considered. *Id.*, 6:42–44. For example, Huston’s differencing engine may “select[] content to be deleted by comparing versions of content stored on caches 236, 238 to versions of the corresponding content stored on [the] origin servers,” not just when a new version has been created. *Id.*, 6:45–48. *See also id.* 11:33–36,

12:62–67. As explained in Section IV.A, *supra*, a POSITA would have understood that the comparison of versions of content stored on caches 236, 238 to versions of content stored on the origin server would necessarily involve “a listing of at least one piece of content stored in the memory of the terminal” as claimed in the ’559 patent, which would also satisfy the claimed “terminal status information.” *Id.*, 6:45–48; EX1003, ¶¶143, 179.

C. A POSITA would have been motivated to combine Cassin and Huston

Mr. Wechselberger thoroughly explains why a POSITA would be motivated to combine Cassin and Huston. EX1003, ¶¶144-147, 201-205. PO does not dispute that Cassin and Huston are analogous art. Instead, PO advances the following three arguments challenging the motivations to combine Cassin and Huston: (1) Cassin teaches away from “the server being able to instruct the terminal to delete content,” POR, 49; (2) Cassin did not provide a motivation to allow the server computer to delete content from the client computer, *id.*, 50; and (3) a POSITA would not have known how to modify Cassin to send delete commands to the client computer, *id.*, 50–51. None of those points withstand scrutiny.

First, Cassin does not teach away from instructing the terminal to delete an item of content. Cassin says nothing to discourage or criticize an approach that would involve the server sending “delete” commands to the client computer. In

fact, Cassin already discloses one approach to deleting content—allowing users to do it manually via a user interface. EX1004, ¶169. Just because Cassin teaches deleting content manually, that does not mean that other approaches to deleting content are precluded or discouraged. Indeed, it is well-settled that “[a] reference that ‘merely expresses a general preference for an alternative invention but does not criticize, discredit, or otherwise discourage investigation into’ the claimed invention does not teach away.” *Meiresonne v. Google, Inc.*, 849 F.3d 1379, 1382 (Fed. Cir. 2017) (quoting *Galderma Labs., L.P. v. Tolmar, Inc.*, 737 F.3d 731, 738 (Fed. Cir. 2013)). Thus, there is no basis to conclude that Cassin teaches away from the server instructing the terminal to delete an item of content.

Second, a POSITA would have been motivated to combine Cassin’s server with Huston’s delete command to delete content from the client computer. Mr. Wechselberger explains, “Cassin teaches that it would be advantageous to also manage how long media content items remain available to its users.” EX1004, ¶¶178, 180, 182). One approach to “enforce that media content is no longer available to a particular user” is to issue instructions from the server to the terminal to delete particular items of content. *Id.*, 33; EX1003, ¶204. Thus, PO’s argument that adding “a delete command is contrary to the ‘intended purpose’ of Cassin” is without merit. Moreover, “automatically deleting outdated content or files from a remote device” was well-known in the art as of the priority date of the ’559 patent .

EX1003, ¶202. *See Intel Corp. v. PACT XPP Schweiz AG*, 61 F.4th 1373, 1380–81 (Fed. Cir. 2023) (“There is a motivation to combine when a known technique ‘has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way,’ using the ‘prior art elements according to their established functions.’” (citations omitted)).

Third, a POSITA would have known how to modify Cassin to send “delete” commands from the server. Mr. Wechselberger articulates that “a POSITA would have needed to modify the server in Cassin to send an instruction to invoke a delete command on the client.” *Id.* ¶ 205. He further opines that a POSITA would have known how to make that modification; indeed, Mr. Wechselberger stated that doing so “would have been obvious and straightforward,” would have “required no more than ordinary skill,” and could have been achieved with a reasonable expectation of success. *Id.* As explained above, Cassin teaches instructing the client computer to download content and includes a manual delete command on its user interface. It would have been obvious to include a similar delete command in Cassin and as taught by Huston to give the server the ability to delete certain content on the client side. EX1003, ¶205. Accordingly, PO’s argument that, because “[t]here is no mechanism in Cassin to be able to send instructions to the client computer . . . and thus a POSITA would not have a reasonable expectation of success in combining Cassin and Huston,” is incredulous. POR, 51.

For the above reasons, PO has failed to rebut PO's showing that a POSITA would have been motivated to combine Cassin and Huston.

V. PATENT OWNER RAISES NO SUBSTANTIVE ARGUMENTS TO CHALLENGE GROUND 3 OF THE PETITION

The POR devotes all of two pages to contending that Huston alone does not render the challenged claims obvious, as asserted in Ground 3 of the Petition. POR, 51–53. The Petition, by contrast, offers detailed explanations as to how the challenged claims were rendered obvious by Huston's disclosures. Pet., 51–58. Rather than challenge those explanations with substantive argument, PO simply restates positions taken elsewhere in its Response; as explained above, those arguments all fail. POR, 51–53. Accordingly, PO has offered no other basis to refute the Petition's showing with respect to Ground 3.

VI. CONCLUSION

For the foregoing reasons, the Board should find that the challenged claims are unpatentable.

Respectfully submitted,

Dated: March 15, 2024

By: // Aliza George Carrano //
Lead Counsel for Petitioner

CERTIFICATE OF COMPLIANCE

The undersigned certifies that this Petition complies with the applicable type-volume limitations of 37 CFR § 42.24. Exclusive of the portions exempted by 37 CFR § 42.24(a), this Petition contains 5,453 words as counted by the word processing program used for its preparation (Microsoft Word 2021).

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on March 15, 2024, a copy of the foregoing document was served by email directed to the following counsel of record and distribution list:

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