

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,

Petitioner

v.

VIDEOLABS, INC.,

Patent Owner

IPR2023-00630
U.S. Patent 7,440,559

PATENT OWNER'S SUR-REPLY

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Declaration of Jaime F. Cardenas-Navia in Support of Motion for Admission <i>Pro Hac Vice</i>
2002	Expert Declaration of Dr. Michael Goodrich
2003	Deposition Transcript of Anthony Wechselberger

Pursuant to the Board’s Scheduling Order (Paper 18), Patent Owner submits this Sur-Reply in response to Petitioner’s Reply.

I. Introduction

In its Response, Patent Owner (“PO”) demonstrated that Cassin and Huston do not disclose or render obvious many of the challenged claim elements. In particular, Cassin discloses that it is the *server*, not the *terminal*, that “perform[s] . . . actions to thereby control the flow of content to the terminal”—the server never “instructs” the terminal to do anything. Similarly, Huston does not teach or suggest that the alleged “instruct[ions]” are in “response to the content status” or “based upon the terminal status information.” These deficiencies cut through each of the challenged claims. In Reply, Petitioner largely fails to rebut PO’s evidence and argument. Instead, it mischaracterizes the claim language and the references in an attempt to conceal their fundamental differences. Petitioner has not shown that any claim of the ’559 patent is unpatentable.

II. Ground 1: Cassin Does Not Anticipate Claims 1-14.

A. Cassin Does Not Disclose 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.

The central dispute regarding this term is whether Cassin’s alleged “responses” “*instruct[]* the terminal to perform one or more actions to thereby control the flow of content to the terminal” or whether it is the server itself that

“*perform[s]*” the actions. Petitioner admits that in Cassin it is the server, not the terminal, that “send[s] [the terminal] content” (i.e., performs the action). Reply, 4. In order to maintain its anticipation argument, Petitioner asserts that the claim language is met when “*the server take[s] action directly* by instructing the client to download content that the server attempts to send.” *Id.*, 3 (emphasis added). In other words, Petitioner’s argument is that by “sending” the content, the server is somehow “instruct[ing] the client to download content.” *Id.*, 4. Petitioner’s argument makes no sense and is contrary to the claim language.

As a matter of logic, the server sending content cannot “instruct the client to download content,” because the content has already been sent by the server and is already at the terminal. The plain language of the claim requires that the server instruct the *terminal* to perform an action—it is not met when the server “take[s] action directly.” That is the fundamental problem with Cassin: the purported “instruct[ions]” from the server to the terminal are in fact just the server “sending [the terminal] content”—in other words, performing the action itself. POR, 19-20, 22-37. Any actions the terminal takes are not in response to instructions from the server.

Petitioner’s Reply identifies three alleged “responses”¹ are addressed below.

¹ Petitioner’s Reply does not discuss the following alleged “responses” from the Petition: “sending the client computer the list of content the user is entitled” (the

1. First alleged “response”

The first alleged “response” (which is from Cassin’s first protocol) is the server computer’s “attempt[] to send a first media content item on the list to the client computer.” Reply, 13-14; 11. This alleged “response” fails for two reasons.

First, the “response” does not “instruct” the terminal to take an action to control the flow of content to the terminal. Under Petitioner’s theory, the server sending the content to the server is “instruct[ing]” the client to “accept[]” or refuse the content based on whether the client already has the content, and the client’s “accepting” or refusing the content are the claimed “actions to thereby control the flow of content to the terminal.” *Id.*, 13-14; 11.² But, as Petitioner acknowledges, whether the client accepts or refuses the content is based only on “if [the client] already has the media content item in its repository.” Reply, 13. The server has not instructed the client to do anything—the client takes an action based on other factors (whether or not it already has the media content item). POR, 31-32. Notably, PO pointed out in its Response that Petitioner’s expert, Mr. Wechselberger, testified that the client computer’s actions (accepting the content or not) are based “on

first “response” addressed in the POR) and “not delivering the first media content item to the client computer” (the fourth “response” addressed in the POR). POR, 20-21; Reply, 13-15.

² Petitioner alleges that PO’s Response does not “include this language of the client accepting or refusing the server’s download offer.” Reply at 11, n. 3. That is not true. POR at 11, 31-32, 33, 41,

determining the media contents that [the client] does not have in the local content repository 685”—not on a response from the server instructing it to take that action. POR, 31-32 (citing EX2003, 26:22-27:16, 23:11-15). Petitioner did not reference, much less rebut, this testimony from its own expert. Reply, 13-14.

Petitioner also alleges that “Cassin’s server attempts to send or deliver a media content item or items to the client” “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.’” Reply, 12. Petitioner’s argument is nonsensical. “[T]he server [] controlling the flow of content” does not “necessarily mean[] that the server ‘instructs the terminal to perform one or more actions.’” Much the opposite, it simply means that the server is controlling the flow of content **by taking action itself**—precisely what the ’559 patent teaches against. EX1001, 10:45-59, 2:25-39; cl. 1.

Petitioner attempts to find support by pointing to an embodiment where a “method of controlling storage of content generally includes the terminal 10 **downloading or otherwise receiving, at one or more points in time, one or more pieces of content.**” Reply, 11-12 (quoting EX1001, 11:57-60) (emphasis in original). Nothing about this out-of-context excerpt even suggests, that is it defining

or referencing the claim term “instructs”.³ It is undisputed that, in the ’559 patent, the terminal can “download[] or otherwise receive[]” content—it just does so pursuant to instructions from the server. In addition to the clear claim language, the specification repeatedly confirms that the server’s response must “instruct[]” the terminal, not take the action itself. EX1001, 3:26-51, 13:38-50; 14:12-23. It is thus perfectly consistent that PO has stated in other proceedings that, in the ’559 patent, “terminals can now *automatically* be instructed to download certain content” and that “content already stored on a terminal can be *automatically* deleted.” Reply, 12 (quoting EX1026, 9, emphasis in Reply). It is irrelevant for these purposes whether the steps occur “automatically.” The point is that the server sends *instructions* for the terminal to take some action (e.g., downloading or deleting content) and then the terminal takes that action—instead of the server just doing it itself, as Cassin discloses.

Dr. Goodrich’s analogy regarding Cassin’s first protocol further illustrates of why this alleged “response” does not “instruct” the terminal to take an action to

³ To the extent Petitioner is belatedly presenting a claim construction argument with respect to “instructs,” it should have proposed a construction as required by 37 CFR § 42.104 (b)(3). Regardless, Petitioner’s argument is incomplete and unconvincing because Petitioner does not show how the cited portions of the ’559 patent define the term “instructs,” or provided *any* support for construing “instructs” contrary to its plain and ordinary meaning.

control the flow of content to the terminal.⁴ In that analogy, when the waitress attempts to bring the paired house wine to the customer (i.e., the server attempts to serve the content to the client), he may determine that he already has the appropriate wine in his backpack and reject the wine (i.e., the client accepts or refuses the content based on whether it already has that content). EX2002, ¶87; POR, 32, 28. The waitress takes action—she brings the wine to the customer. The waitress does not “instruct” the customer to accept or refuse the wine—the customer decides to accept or reject the wine that has already been brought to it based on whether or not it already has wine. Just so here. The server takes action by sending the content itself. The server is not instructing the client to do anything when it sends content to the client—the client’s next action (accepting or refusing the content) is based purely on whether or not it already has the content.

Second, the first alleged “response” is not a response “to the content status” “based upon the terminal status information.” The only alleged “content status including terminal status information” that Petitioner identifies for the first alleged “response” is “user information.”⁵ But Cassin’s “user information” does not disclose

⁴ Petitioner alleges that Dr. Goodrich’s “restaurant analogies” are “incomplete and not analogous to Cassin” but does not identify any fault with them or engage with them substantively. Reply at 13, n.4.

⁵ The Petition identified other types of “content status,” POR at 21-22 (cataloging the Petition’s assertions), but in Reply Petitioner only identifies “user information” for this alleged “response.” Reply at 13-14, 7, 8; POR at 29-30.

“content status including terminal status information.” POR, 25-26, 30.

Petitioner’s *only* affirmative support for its contention otherwise is its argument that “Cassin also contemplates that such user information could be used to reflect user preferences” and that the specification of the ’559 patent states that “terminal status information can include information reflecting user preferences.” Reply, 8-9 (citing EX1004, ¶191⁶; EX1001, 3:63–66). Petitioner mischaracterizes Cassin and the ’559 patent. The relevant portion of Cassin explains that “user information” is simply information about users—such as their gender, age, and income—and that that user data can be used to target advertisements. EX1004, ¶191; POR at 25. Cassin does not disclose that “user information” includes *any* information about content or terminal status—and thus “user information” does not constitute “content status including terminal status information.”

In contrast, the ’559 patent explains that “terminal status information can include *information reflecting user preferences*.” EX1001, 3:63–66. A plain reading of “information reflecting user preferences” in the context of the ’559 patent means information about what content the user prefers—not user demographic data (like the gender, age, and income data disclosed by Cassin) as those do not directly “reflect[] user preferences.” This is particularly true in light of the plain meaning of “content status including terminal status information,” which requires that the

⁶ Petitioner cited to Paragraph 91, apparently in error.

information relate to “content” or the “terminal status” (status of the terminal).

Petitioner faults PO for referring to Cassin’s discussion of “statistical user information,” asserting that “statistical user information” is categorically different than “user information.” Reply, 9. As an initial matter, Petitioner does not dispute that Cassin’s discussion of “statistical user information” is Cassin’s *only* example of “user information.” Reply, 7-9; POR, 25. Thus, if Petitioner were right that Cassin’s discussion of “statistical user information” were irrelevant to “user information,” then Cassin simply does not disclose what “user information” is—much less that it is “content status including terminal status information”—and thus does not disclose this element.

Additionally, Petitioner’s argument cannot be squared with its own reliance on Cassin’s discussion of “statistical user information” to argue what “user information” means. Reply, 8 (quoting EX1004, ¶191). Petitioner cannot use misleading partial quotations regarding “statistical user information” to argue that Cassin’s “user information” discloses the claimed “content status,” but then allege that that very same passage is irrelevant when quoted in full to show otherwise.

Petitioner’s argument is also substantively baseless. Petitioner argues that “statistical user information” “is not used to query the database to facilitate the delivery media content” and thus cannot be “user information” (which is “used to query the database”). Reply, 9. But Petitioner has no basis or support for its

assertion that “statistical user information” is not used to query the database. *Id.*; Cassin, ¶191. Nor does Cassin ever imply that “statistical user information” and “user information” refer to wholly different types of data. *Id.*, ¶¶35, 122, 154, 164, 166, 185, 191, cl. 68 (every reference to “user information”). Thus, a POSITA would understand Cassin to be referring to “user data” when it discusses “statistical user information” and that neither reference discloses “content status including terminal status information.”

2. Second alleged “response”

Petitioner’s second alleged “response” (which is also from Cassin’s first protocol) is the server computer’s attempt to deliver the *second* media content. Reply, 14. Under this theory, the alleged “response” and “actions” are same as in the first theory; the only difference is the alleged “content status” and “terminal status information.” *Id.* This second theory fails for the same reason as the first: the alleged “response” is just the server sending the content (i.e., taking action) itself, and the “response” does not instruct the client to perform its next action (whether or not to accept the content). POR, 32-34. As Mr. Wechselberger testified (and Petitioner did not dispute in its Reply), “after [the client has indicated that it already has the first piece of content], **the server computer sends the next piece of content.**” EX2003, 24:1-12 (emphasis added). The server, not the terminal, performs the action.

3. Third alleged “response”

Petitioner’s third alleged “response” (which is from Cassin’s second protocol) is “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 . . .’” Reply, 15. Petitioner’s third alleged “response” is even further from the claim language than the first two. POR, 34-37. As PO explained previously, there are *no further client actions* after the server sends the media content items from the client’s list. *Id.*, 35. Unlike in the first protocol, the client does not accept or refuse the content. *Id.*, 35-36; Reply, 15. The client already told the server what items it does not have *before* the server sends the alleged “response,” and thus the server sends the content directly to the client without any action from the terminal. POR, 35-36; Reply, 15. The server sending content and the terminal doing *nothing in* response does not disclose an instruction for the terminal to take action to control the flow of content. POR, 34-37.

Petitioner does not dispute these arguments from PO’s response, but merely repeats its bald assertions from the Petition. *Compare* Reply, 15 *with* Pet., 26.

B. Cassin Does Not Disclose Server Status Information That Comprises A Listing Of At Least One Piece Of Content Available From The Source.

Petitioner alleges that the content stored in the “content repository 645” in Cassin is the “content available from the source.” Pet., 25, 23; Reply, 16. In turn,

Petitioner alleges that Cassin’s “list” of all content to which the user is entitled” that results from “a query of database 640” is “server status information [that] comprises a listing of at least one piece of content available from the source.” Reply, 16-17. But Cassin’s alleged “list” of content cannot be the claimed “server status information” because it comes only from the “database 640,” which does not necessarily accurately reflect the availability of the content from the “content repository 645,” the source of content. POR, 37-39.

Petitioner argues that the list of content from “database 640” *does* necessarily reflect the contents of the “content repository 645” because Cassin explains that the database “must include metadata about the media content available to the system.” Reply, 16 (quoting EX1004, ¶146). But, given that it is impossible for the database 640 to necessarily reflect the contents of the first content repository 645, a POSITA would understand that passage to mean that database 640 includes metadata about the media content available to the system *as best it knows*. See EX1004, ¶¶0146, 0164, 0166.

Petitioner next argues that “Cassin discloses that the media files may be stored directly in the database.” Reply (citing EX1004, ¶146). But Cassin simply states that “[t]he database need not contain the media files themselves. As an alternative, *the media files may be stored within a first content repository 645* associated with the server computer system 610.” EX1004, ¶146. Cassin only discloses that the

media files “need not” be stored in the database 640—not that they ever actually are stored there.⁷

Finally, Petitioner asserts that “PO’s speculation is nonsensical and plainly not consistent with the intended operation of Cassin.” Reply at 17. Petitioner’s assertion, unsupported by evidence or reasoning, is baseless. Nothing in Cassin discloses that database 640 is contemporaneously synchronized with the content in the first content repository 645. Petitioner’s assertion that the effect of Cassin’s disclosure would be “nonsensical” does not change that disclosure. And Petitioner’s assertion that “[t]here 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,” *id.*, applies the wrong standard. The fact that Cassin does not teach away or “preclude” an element is not relevant to anticipation. *Krippelz v. Ford Motor Co.*, 667 F.3d 1261, 1269 (Fed. Cir. 2012) (“teaching away is not relevant to an anticipation analysis; it is only a component of an obviousness analysis”).

⁷ Petitioner alleges that Dr. Goodrich changed his testimony on this issue during his deposition. Reply, 17 n.5. As Dr. Goodrich explained, he was being asked about a mapping that was not in the Petition or Mr. Wechselberger’s declaration and that he thus had not considered. EX1025, 66:19-67:7, 42:20-43:3, 44:7-14, 44:18-46:20. Despite being outside the scope of his opinion, he still attempted to answer Petitioner’s hypothetical questions. *Id.*, 44:18-46:20.

**C. Cassin Does Not Disclose Terminal Status Information
Comprising A Listing Of At Least One Piece Of Content Stored
In The Memory Of The Terminal.**

The parties' dispute turns on whether Cassin discloses that the "indication to the server computer that it currently has the media content item" includes "a listing of at least one piece of content stored in the memory of the terminal." It does not. POR, 39-42.

Petitioner effectively acknowledges that Cassin does not actually disclose this limitation. Reply, 6 ("Cassin's specification does not define the parameters of an 'indication'"). Nonetheless, Petitioner argues that Cassin's generic reference to an "indication" that the client "currently has the media content item" broadly discloses all possible indications, including "a listing of at least one piece of content stored in the memory of the terminal." *Id.*, 6. Petitioner's argument is wrong as a matter of law. A reference must actually disclose each element to anticipate a claim. *Microsoft Corp. v. Biscotti, Inc.*, 878 F.3d 1052, 1068 (Fed. Cir. 2017) ("a prior art reference must disclose all elements of the claim within the four corners of the document, and it must disclose those elements arranged as in the claim;" it does not anticipate unless "a person of skill in the art, reading the reference, would at once envisage the claimed arrangement or combination.") (citations omitted). And that makes sense. Otherwise, a reference to a "computer" would disclose all possible claims for any specific type of computer. Asserting that Cassin's indication *could*

have included “a listing of at least one piece of content stored in the memory of the terminal,” does not show that Cassin discloses this element. POR, 44-45.

Moreover, Dr. Goodrich opined that a POSITA would not envisage Cassin’s “indication” to include the claimed “listing” because they would understand that the “‘indication’ would preferably be the smallest amount of data.” EX2002, ¶120. Petitioner disagrees with Dr. Goodrich’s opinion, arguing that it “directly contradicts Cassin’s claims that expressly state the ‘indication’ includes a ‘list of a second group of media content items’” and that Cassin and the ’559 patent⁸ disclose “the server computer sending a list of content items.” Reply, 6-7. Petitioner’s attorney argument misunderstands Dr. Goodrich’s opinion. The point is that a POSITA would not “at once envisage” that Cassin’s indication includes the claimed “listing” because a POSITA would understand that it is possible and preferable to use less data. EX2002, ¶120. The fact that Cassin discloses sending different lists of data in different contexts—where perhaps it is not possible or preferable to do otherwise—does not undercut Dr. Goodrich’s unrebutted expert testimony.

Petitioner only makes a single affirmative argument in support of its contention that Cassin discloses this element. Reply, 5. Petitioner points to Cassin claim 132, which requires a list of “media content items,” and Cassin claim 133,

⁸ Of course, the ’559 patent’s inventive disclosures cannot be used to show what was common knowledge before the ’559 patent was invented.

specifies that the list is of media content items that the client *will* “accept for delivery” (i.e., a list of media content items the client *does not have*). *Id.*; EX1004, cls. 130, 132. Petitioner argues that since claim 133 recites a list of content that the client does not have, “the scope of the ‘list’ recited in claim 132 is certainly broad enough to include” the content the client *does* have. Reply, 5 (emphasis added). This suffers from a similar legal error as discussed above. While it is true that “[t]he claims of a prior art patent are part of its disclosure,” Reply, 6, the scope of the claims are not synonymous with the *disclosure* of the claims. It appears that Petitioner is attempting to construe Cassin’s claims under *Phillips*, but Cassin must be interpreted based on the anticipation standard. *Microsoft* 878 F.3d at 1068 (Fed. Cir. 2017). Put another way, the fact that the claims in Cassin might *cover* a listing of content stored at the terminal does not mean that they actually disclose a listing of content stored at the terminal. *Id.*

III. Ground 2: Cassin and Huston Do Not Render Obvious Any Claim of the ’559 Patent.

A. Petitioner Does Not Provide Any Obviousness Allegations For A Number Of Claim Elements.

PO noted that Cassin does not disclose the following claim elements and that the Petition does not provide any additional analysis or assertions regarding obviousness:

- “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”; (POR, 43)

- “server status information that comprises a listing of at least one piece of content available from the source”; (POR, 44)

Petitioner confirms in its Reply that it is only arguing that these elements are disclosed by Cassin—not that they are rendered obvious either by Cassin itself or in view of Huston. Reply, 18, n.6.

B. Cassin And Huston Do Not Teach Or Suggest Terminal Status Information Comprising A Listing Of At Least One Piece Of Content Stored In The Memory.

As explained above, Cassin does not disclose terminal status information comprising a listing of at least one piece of content stored in the memory. Section II.C. Petitioner thus argues “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.” Reply, 19. Petitioner does not supply any evidence or support for its contention whatsoever. *Id.* In contrast, Dr. Goodrich explained that “POSITA would understand that Cassin’s ‘indications’ should contain as little data as possible to increase speed and decrease storage requirements” and “[i]t would thus not be obvious to add additional, unnecessary information, such as a listing of at least one piece of content stored in the memory.” POR, 44-45; *see* Section II.C.

Petitioner also alleges that the element is rendered obvious by Cassin and Huston. Reply, 19-20. In particular, Petitioner argues that Huston discloses a differencing engine 240 that compares versions of content stored on the caches (the alleged “terminals”) to versions of the corresponding content stored on the origin servers, and that “a POSITA would have understood that the differencing engine 240 would receive an identification of the versions of the content stored on the caches” in order to make that comparison. Reply, 19. But Huston does not disclose or suggest that the differencing engine 240 receives any information from the cache, much less “an identification of the versions of the content stored on the caches.”

Mr. Wechselberger acknowledged at his deposition that Huston does not actually disclose an embodiment in which the differencing engine receives information regarding what is stored in caches from the caches. EX2003, 53:16-54:5. And Petitioner acknowledges that Huston discloses an embodiment in which “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.” Reply, 20 (internal quotations omitted); EX1003, ¶41. Given this, there is simply no basis to assume that a POSITA would come up with an alternative undisclosed embodiment in which the differencing engine 240 receives any information from the cache. Moreover, Petitioner has not shown that it would be obvious to add a “listing of at least one piece of content stored in the memory” to

Cassin based on Huston's tenuous teachings, particularly in light of Dr. Goodrich's testimony that a POSITA would find it preferable to use less data, discussed above.

C. Cassin And Huston Do Not Teach Or Suggest A Response To The Content Status That Instructs The Terminal To Delete At Least One Piece Of Content From The Memory Of The Terminal Based Upon The Listing Of At Least One Piece Of Content Stored In The Memory Of The Terminal.

Claims 2, 3, 5, 8, 9, 11, 14, 15, 17, 20, 21, 23 require that the alleged "response to the content status that instructs the terminal to delete at least one piece of content" must be in response "to the content status" and "based upon the listing of at least one piece of content stored in the memory of the terminal." Petitioner alleges that Huston discloses this element, not that Huston renders it obvious. Pet., 44-45; Reply, 21-22. It does neither. As explained in PO's Response, Petitioner's alleged "response" ("the 'Delete' command") "issues in response to new content in the origin server, not in response to a content status from the terminal server and not based on terminal status information." POR, 48-49.

In Reply, Petitioner acknowledges that Huston discloses that the "Delete" command happens based on new content at the origin server. Reply, 21; EX1003, ¶152. Petitioner, however, seemingly implies that Huston discloses other embodiments in which the "Delete" command issues based on some information from the terminal, not based on new content at the origin server. *Id.* It does not.

Petitioner argues that "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.” Reply, 21. But Huston is clear that the referenced “comparing” is triggered when a new version has been created in the origin server. EX1005, 6:42-7:9. In particular, in that same paragraph, Huston explains that “[d]ifferencing engine 240 may use a variety of techniques to determine differences between content stored on traffic servers 216, 218 and origin servers 202, 204, 206” and provides two examples, both of which only involved receiving information from the origin server—not from the terminal. EX1005, 7:2-9 (“differencing engine 240 may request from origin servers 202, 204, 206 information . . .”), (“differencing engine 240 may negotiate with origin servers 202, 204, 206 to periodically receive information . . .”). Thus, Petitioner’s purported other “embodiment” is not a different embodiment at all, but simply a quote about the same embodiment in which the delete command is issued in response to information from the origin server, not from the terminal.

Similarly, Petitioner cites two other embodiments from Huston (without analysis or supporting evidence), but neither disclose the claim element. Reply, 21-22 (citing EX1005, 11:33–36, 12:62–67). First, Huston discloses “automatically delet[ing] [pre-fetched content] from a cache after the expiration of a specified period of time.” EX1005, 11:33–36. But this deletion is based on “a specified period

of time” not any information from the terminal. *Id.* Additionally, Huston does not disclose (and Petitioner does not argue) that this “automatic[] delet[ion]” is done because of a “response . . . that instructs” from the server. Indeed, that would make no sense as the point is that the content is “automatically deleted” without need for an instruction from the server. *Id.*

Second, Huston states that “[p]referential treatment may be used to specify whether certain objects can be deleted at all, a minimum amount of time that an object must remain in a cache before being deleted, or a relative priority to establish an order in which objects are deleted from a cache, when necessary.” EX1005, 12:62–67. Nothing in this passage discloses or even suggests a “response . . . that instructs” the terminal to delete content, much less that the “response” is in response to information from the terminal.

Finally, Petitioner argues that “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.’” Reply, 22 (emphasis added). But the claim requires that the alleged “response” is a response “to the content status” from the terminal and “based upon the listing of at least one piece of content stored in the memory of the terminal.” Simply disclosing a response that “involves” “a listing of at least one piece of content stored in the memory of the terminal” does not

meet the claim language.

D. A POSITA Would Not Be Motivated To Combine Cassin And Huston.

Petitioner has not shown that a POSITA would be motivated to combine Cassin and Huston, in particular to combine Huston's "delete" command with Cassin. Petitioner's arguments that Cassin does not teach away from Huston's delete command and a POSITA would have been motivated to combine them, Reply, 22-23, miss the point. Cassin is entirely focused to provide non-duplicative content. POR, 49-50. That is why Cassin discloses manually deleting content, but no suggestion of the server deleting content on the terminal. *Id.* Petitioner's argument that Cassin actually concerns "manag[ing] how long media content items remain available to its users" is unsupported by Cassin.

Petitioner next argues that "a POSITA would have known how to modify Cassin to send 'delete' commands from the server," but the basis for that assertion is that Cassin already "teaches instructing the client computer to download content and includes a manual delete command on its user interface." Reply, 24. Cassin does not disclose "instructing the client computer to download content," but only sending the content directly to the terminal itself. *See Section II.A*; POR, 50-51. There is no mechanism in Cassin for issuing instructions, and thus a POSITA would not have a reasonable expectation of success in adding Huston's delete command (or any command) to Cassin. POR, 50-51.

IV. Ground 3: Huston Does Not Render Obvious Any Claim of the '559 Patent.

Petitioner inexplicably asserts that “patent owner raises no substantive arguments to challenge ground 3 of the petition.” Reply, 25. That is not true. PO identifies the elements not rendered obvious by Huston and cites to its previous analysis of Huston. POR, 51–53. Petitioner’s so-called “detailed explanations” of Ground 3 are high-level descriptions and allegations, not even divided by claim element, and often without any support (from Huston or Petitioner’s expert). Pet., 51-58. As explained in the POR, Petitioner did not provide any additional analysis of Huston for Ground 3 beyond what it provided in Ground 2, POR, 51-53, and thus PO cited to its Ground 2 arguments to show why Ground 3 fails, instead of repeating them.

First, PO explained that Huston does not render obvious “receiving any information from the terminals, including ‘a content status including terminal status information’” or that the “terminal status information compris[es] a listing of at least one piece of content stored in’ memory.” POR, 51, 52 45-47, 17; *see also* Section III.B. The Petition asserts that “a POSITA would have understood that the differencing engine would receive a communication from the traffic servers identifying the versions of the content stored on the caches 236, 238” and “that this communication would include a listing of at least one piece of content stored in the traffic servers.” Pet., 53-54. But Petitioner does not cite *any* support for these

allegations. As explained above, this element would not be obvious to a POSITA, Section III.B, particularly given Petitioner's failure to provide any support for this element in Ground 3.

Second, PO explained that Huston does not disclose "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." POR, 52, 53, 48-50, 17; *see also* Section III.C. The Petition does not even use the word "response" in its analysis of claim 1 for Ground 3, much less explain how the alleged "response . . . that instructs" is in response "to the content status" and "based upon the terminal status information." Pet., 51-55. As explained above, Huston does not render obvious a "response . . . that instructs" that is in response "to the content status" and "based upon the terminal status information," *see* Section III.C.

V. CONCLUSION

For the reasons stated above, the Petition fails to show that any challenged claim is unpatentable.

Dated: April 26, 2024

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CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that Patent Owner's Sur-Reply consists of 5,598 words, excluding the table of contents, certificate of service, this certificate of compliance, or table of exhibits. The Sur-Reply complies with the type-volume limitation of 5,600 words as mandated in 37 C.F.R. § 42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare this paper (Microsoft Word).

Dated: April 26, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

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