

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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GOOGLE LLC,  
Petitioner,

v.

SAFECAST LIMITED LLC,  
Patent Owner.

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IPR2023-00652  
Patent 9,392,302

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**PATENT OWNER'S PRELIMINARY RESPONSE  
TO PETITION FOR *INTER PARTES REVIEW***

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## I. INTRODUCTION

On March 1, 2023, Google LLC. (“Petitioner”) submitted a Petition for *Inter Partes* Review (“Petition”) of U.S. Patent No. 9,392,302 (“the ‘302 Patent”, “Ex. 1001”), challenging Claims 1-4, 6-9 and 12-15 (“Challenged Claims”). Pursuant to 37 C.F.R. § 42.107, Patent Owner Safecast Limited LLC, (“Patent Owner”) files this Preliminary Response to the Petition, setting forth reasons the Board should deny institution.

Petitioner challenges the patentability of Claims 1-4, 6-9 and 12-15 of the ’302 Patent based on two (4) different alleged prior art references as follows.

U.S. Pat. App. Pub. No. 2002/0144262 (“Plotnick”);

U.S. Pat. No. 8,413,189, (“Parekh”);

Petitioner requests institution of the IPR proceeding on the following grounds.

| Ground | Claims              | Basis                     |
|--------|---------------------|---------------------------|
| 1      | 1–4, 6–9, and 12–15 | §103– Plotnick and Parekh |
| 2      | 1–4, 6–9, and 12–15 | §103– Plotnick            |

Petitioner fails to establish a reasonable likelihood that the Challenged Claims are unpatentable. Patent Owner will specifically address each of Petitioners arguments in the following sections.

## **II. OVERVIEW OF THE '302 PATENT**

### **A. Brief Description**

The application that issued as the '302 Patent was filed on May 29, 2013, which was based on international Application No.PCT/GB2011/052259 filed on November 18,2011. Ex.1001, Cover.

#### **1. Problems identified in the prior art**

The '302 Patent generally discloses a system for controlling which advertisements are played in a recorded program during later playback. Ex. 1001, at Abstract.

The '302 Patent describes issues about recorded program as follows:

In many countries there are regulations laid down by the broadcasting authorities which specify the minimum time between advertising breaks in programmes, the maximum length of an advertising break, the maximum number of seconds of advertising which can be broadcast within an hour's viewing. In addition, the time of day at which some adverts may be shown may also be strictly controlled. If a programme is recorded and viewed at a different time of day, it contains all of the adverts which were originally broadcast, some of which may be unsuitable for that time. There are no controls which can remove unsuitable advertisements from time-shifted programmes. Ex. 1001,1:13-44.

## 2. Summary of the Claimed Subject Matter

In order to address the deficiencies of prior recorded program system, the '302 Patent provides a system for controlling which advertisements are played in a recorded program during later playback. Ex. 1001, at Abstract.

The system can include a PVR 60 with connections to a TV aerial 20, modem 22, the Internet 24, and viewer's TV set 68. Ex. 1001, 4:43–55. PVR 60 has an advertisement database 70, programme database 80, and rules database 90 for storing, respectively, advertisements, broadcast programme segments, and rules that apply to the advertisements. Ex. 1001, 4:57–62.

Each advertisement has a header which records the duration of the advert, any restriction on the time of day at which it may be viewed, and other information about its nature. The header in each advert contains a series of fields as shown in Table 1(reproduced below). Ex. 1001, 3:63–4:41.

PVR 60 ensures that advertisements shown with a recorded program are legally acceptable. Ex. 1001, 6:33–37. PVR 60 checks the Real Time of day signal, the rules database 90, and selects an advertisement. Ex. 1001, 6:40–53. PVR 60 reads the header information associated with the advertisement and checks for restrictions against playing the advertisement at the current time. Ex. 1001, 6:54–62. If there are time restrictions, PVR 60 selects the next advertisement in the database and checks that advertisement, repeating until a suitable advertisement is found.

Once it finds a suitable advertisement, PVR 60 checks other information from the advertisement header. Ex. 1001, 6:63–7:16. PVR 60 then shows the queued advertisements to the viewer and records button depressions from the viewer. Ex. 1001, 7:17–22.

TABLE 1

| Fields in advertisement headers |                                                                              |
|---------------------------------|------------------------------------------------------------------------------|
| Field Name                      | Activity                                                                     |
| Time of Day validity            | Code to indicate time of day when advert may be shown.                       |
| Days validity                   | Code to indicate the days of the week when advert may be shown               |
| Advert identifier               | Number with check digit to uniquely identify the advert                      |
| Frame length                    | Number giving exact length of advert in frames                               |
| Start date                      | Earliest date and time of permitted showing                                  |
| End date                        | Latest date and time of permitted showing                                    |
| Urgency matrix                  | Table of hours indicating advertiser's preferred time of showing             |
| Interactive or Passive          | Specifies if a button depression is expected                                 |
| Showings                        | Number of times advert is to be shown                                        |
| Viewings                        | Number of times this advert has been shown in time-shifted programme viewing |
| Frequency                       | Minimum period to elapse before repeat showing                               |
| When last selected              | Date and time when advert last selected for viewing                          |
| Special expiry                  | Optional Field                                                               |
| Warnings                        | Keywords to match against viewing regulations                                |

**'302 Patent - Table 1**

## **B. The '102 Patent Prosecution History**

The application that issued as the '302 Patent was filed on May 29, 2013, which was based on international Application No.PCT/GB2011/052259 filed on November 18, 2011. The '302 Patent claims priority to foreign application GB1020361.0 filed on December 1, 2010. Id., Cover Ex.1001, Cover.

References cited by the Examiner include GB 2464630 (“Poel”), U.S. Patent App. Publ. No. 2004/0205829 (“Hane”), U.S. Patent App. No. 2002/0015093 (“Dureau”) Ex.1004, 182–191. U.S. Patent App. No. 2004/0158870 A1(“Paxton”), and U.S. Patent App. No. US 2006/0013556 A1(“Poslinski”). Ex.1004,270.

During prosecution of the ‘124 Patent, the examiner issued a Non-Final Rejection, holding that Poel disclosed selecting stored advertisements to insert into advertising slots according to time and date indicators Ex. 1004, 184. In response, the Applicant amended the claims to specify that the broadcasting regulation is a “local broadcasting time regulation” “which restricts the time of day at which said advertisement may be shown.” Ex. 1004, 203. The Applicant argued that Poel’s headers are not related to broadcasting regulations, but rather are time and date limitations set by advertisers. Ex. 1004, 205–206.

On August 18, 2014, the Examiner issued a Final Rejection finding that Poel discloses “local broadcasting regulations” under the broadest reasonable interpretation of the claims, which the Examiner proposed was “general rules/criteria utilized/implemented upon local broadcasting content.” Ex. 1004, 215. On October 6, 2014, the Applicant amended the claims to add that the “local broadcasting time regulation” is “laid down by a broadcasting authority.” Ex. 1004, 238.

On March 23, 2015, the Examiner issued a Non-Final Rejection, admitting that Poel fails to explicitly disclose the local broadcasting regulations are laid down by a broadcasting authority. But Paxton disclose the limitation. Ex. 1004, 272.

In response to further rejections, the Applicant amended the claims to add “control means is further arranged to update the second field in the header of said advertisement when said advertisement is again shown during time-shifted viewing,” Ex. 1004, 380.-383.

On March 13, 2016, “A Notice of Allowance” was issued, the Examiner stated that “the Prior art fails to disclose, teach, or suggest all of the limitations of the claimed invention. Particularly, the Prior Art fails to disclose, teach, or suggest to "update the second field in the header of said advertisement when said advertisement is again shown during time-shifted viewing". As such, the Claims are deemed allowable. Ex. 1004, 477.

### **C. Claim Construction**

According to 37 C.F.R. §42.100(b), in an inter partes review, claim terms are construed using the same standard used in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.

The ordinary and customary meaning of a term may be evidenced by a variety of sources, including the words of the claims themselves, the specification, drawings, and prior art. However, the best source for determining the meaning of a claim term is the specification – the greatest clarity is obtained when the specification serves as a glossary for the claim terms. The words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir.2004).

In accordance with these principles, Patent Owner submits that the terms of the '302 Patent are clear on their face, patent owner reserves all rights to raise claim construction arguments in district court and in this proceeding should the Board grant institution.

Petitioner construes the claims in accordance with plain and ordinary meaning of the terms in Grounds 1. In Ground 2, Petitioner construes the claims based on how Patent Owner appears to apply the claims in its Preliminary Infringement Contentions attached as Ex-1022. Pet., 4. It is obvious that claim construction In Ground 2 is not in compliance with the regulations of 37 C.F.R. §42.100(b).

### **III. LEVEL OF ORDINARY SKILL IN THE ART**

For purposes of this Response, PO adopt Petitioner's proffered level of ordinary skill in the art because it comports with the technology and claims of the '302 Patent as well as the asserted prior art.

### **IV. THE ASSERTED PRIOR ART**

#### **A. Plotnick (Ex. 1005)**

Plotnick describes a method of presenting viewers with an alternative brief version of a recorded advertisement when they choose to fast-forward through or skip (or any other trick play event) the recorded advertisement. The alternative advertisement may be displayed instead of or in conjunction with the recorded advertisement (i.e., fast-forwarding advertisement is displayed in one portion of the Screen (i.e., background or portion of a split Screen) and the alternative brief version is displayed in another portion). Ex.1005, Abstract.

Plotnick describes a system in relation to the recording and playback of advertisements utilizing a PVR. Ex.1005, ¶0095.

A PVR-enabled set-top box (STB PVR) includes a data tagging unit 308 adding metadata descriptors to video to be recorded. The metadata is used by the PVR to identify and characterize programs. Ex.1005, ¶0107. Metadata includes descriptive items such as title, genre, cast, production company and production crew, language and other program related information. Metadata may also include the

contents typical or intended demographic and psychographic groups. Ex.1005, ¶0136. The STB PVR further comprises a tag extraction system 330 to extract metadata descriptors from recorded video. Ex.1005, ¶0109.

The STB PVR includes a client-side STB ad targeting system 600, the system 600 permit the device to analyze viewer behavior (shows watched, channel surfing habits, commercial watching, etc.), infer viewer profiles (demographic, psychographic, and behavioral attributes), select and present advertisements based on user profiles derived from one or more of the following: a demographic database, volunteered information, profiles, or an autonomous agent. Ex.1005, ¶0134.

The client-side STB ad targeting system 600 includes a metadata decoder 608 delivers all received meta data to the system 600. Ex.1005, ¶0136. Ads 1002 are received by the STB PVR from a downstream ad feed 1000 for storage and subsequent presentation to the viewer. Control data related to ads (ad metadata) 1006 is received by the STB PVR from a downstream control feed 1004. The control data 1006 includes descriptions of the ad content, target audience, encoding attributes, delivery instructions, and contract limitations. Ex.1005, ¶0154. The ad metadata 1006 will either be saved or discarded, depending upon whether the ad was saved or discarded. Additionally, the processing component 10101 updates the ad metadata 1006 based on ad delivery and user interaction.Ex.1005, ¶0156.

The system of Plotnick includes a server-side ad management system (AMS) 700 other than the client-side STB ad targeting system 600. The server side AMS 700 matches the ads to the advertising opportunities that occur in the package of programming either delivered to subscribers in real time or stored on the Subscriber's PVR hard disk drive. Ex.1005, ¶0146.

The server-side AMS 700 comprises different head-end servers that are used to segment the subscribers, deliver content and metadata to the Set-top boxes, collect ad insertion results, and collect privacy protected Summary data about the subscriber viewing habits. Ex.1005, ¶0164. The server-side AMS 700 comprises a STB data server 1112. Ex.1005, ¶0165.

The server-side AMS 700 comprises a traffic and billing system 712. The traffic and billing system 712 manages the advertising campaign and controls advertising campaigns for broadcast systems, personal video recorders, and video on demand. The Sales force enters requirements for viewership ratings, frequency of viewership by the target audience, and flight information, which indicates the networks and times for displaying the advertisement. Ex.1005, ¶0169.

Plotnick describes that if the ads are displayed to the subscriber, the STB data server 1112 generates an ad play report 1160. The ad availability information 1158 and the ad play reports 1160 are formatted 1162 to create reports/logs 1164 that are

forwarded to the T&B system 712. The traffic and billing system 712 bills the advertiser based on requirements Satisfied during the campaign. Ex.1005, ¶0169.

## **B. Parekh (Ex. 1007)**

Parekh discloses a “method of determining advertising content to be included in a broadcast.” Ex-1007, Abstract. Parekh’s advertisements have “inclusion criterion used to determine both whether and how that item of advertising is to be included in a broadcast.” Ex-1007, 2:37-40.

Parekh describes a system for social broadcasting, illustrated in Figure 1 below, the system includes a user interface 102 coupled to social broadcasting server 104, which includes one or more database(s) 106. Social broadcasting server 104 may be coupled with other third parties, such as content provider(s) 108, regulator(s) 110, promoter(s) 112, and/or advertiser(s) 114. Social broadcasting server 104 is coupled to one or more media outlets, for example a broadcast platform 116 and broadcast station and/or infrastructure 118. Ex-1007, 3:22-33.

Social broadcasting server 104 couples with content providers 108, including content providers, content owners, content distributors, or syndicators, for content to be considered for broadcasting on broadcast station(s) 118. Regulators 110 include non-governmental and governmental bodies, commissions, or agencies such as the Federal Communications Commission ("FCC"), or enablers of laws such as the Digital Millenium Copyright Act ("DMCA") which provide regulatory and legal

requirements to social broadcasting server 104 for consideration when broadcasting on broadcast station(s) 118. Ex-1007, 4:4-14.

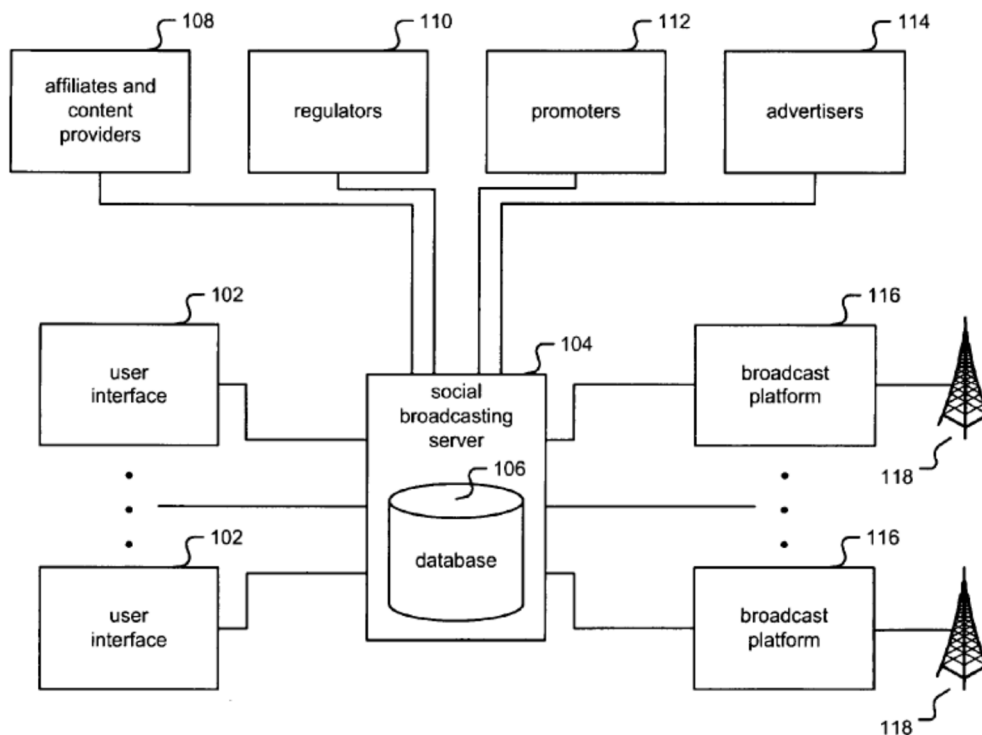


FIG. 1

Parekh, figure 1

**V. PETITIONER HAS NOT DEMONSTRATED A REASONABLE  
LIKELIHOOD OF SUCCESS FOR THE GROUNDS ADVANCED IN THE  
PETITION, AND THE PETITION SHOULD BE DENIED**

**A. Requirements for Showing Obviousness Under 35 U.S.C. § 103**

The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so called secondary considerations. *Graham v.*

*John Deere Co.*, 383 U.S. 1, 17–18 (1966). The Board has held that a failure to identify the differences between the claimed subject matter and the prior art is fatal to an obviousness challenge. See, *Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00355, Decision Denying Institution of *Inter Partes* Review, Paper 9 at 9-10 (P.T.A.B. June 26, 2015) (denying institution for failure to identify the differences between the claimed subject matter and the prior art).

In arriving at an obviousness determination, the Board must sufficiently explain and support the conclusions that the prior art references disclose all the elements recited in the Challenged Claims and a relevant skilled artisan not only could have made, but would have been motivated to combine all the prior-art references in the way the patent claims. *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017). That is, even if all the claim elements are found across a number of references, an obviousness determination must consider whether a person of ordinary skill in the art would have been motivated to combine those references. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *Los Angeles Biomedical Res. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly Co.*, 849 F.3d 1049, 1067 (Fed. Cir. 2017) (vacating and remanding an obviousness determination, in part, because the Board did not make factual findings as to whether there was an apparent reason to combine all three prior art references to achieve the claimed invention and whether a POSITA would have had a

reasonable expectation of success from such a combination). This combination determination, as supported by an articulated motivation to combine, requires a plausible rationale as to why those prior art references would have worked together. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013). Absent some articulated rationale, a “common sense” finding is no different than the conclusory statement “would have been obvious.” *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017). Of additional importance, “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references.” *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008).

**B. Petitioner Fails to Establish in Ground 1 that Challenged Claims 1–4, 6–9 and 12–15 are Obvious Over Plotnick and Parekh**

**1. Claim 1**

Independent claim 1 has been divided into elements for consideration by the Petitioner as follows:

1[a] A system for automating compliance with local broadcasting regulations laid down by a broadcasting authority and applicable to advertisements, said advertisements being provided during time-shifted viewing/listening comprises:

1[b] programme supply means to supply broadcast digital video/audio programmes having therein periodic breaks for the insertion of advertisements;

1[c] advertisement supply means to supply advertisements within the periodic breaks,

1[c.1] each advertisement having associated therewith a header comprising a first field related to a local broadcasting time regulation laid down by the broadcasting authority, which local broadcasting time regulation restricts the time of day at which said advertisement may be shown,

1[c.2] and a second field related to the number of times said advertisement has previously been shown during time-shifted viewing;

1[d] rules database means containing rules relating to said local broadcasting time regulation;

1[e] clock means to supply a real-time clock signal; and

1[e.1] control means arranged to read said first field and said clock signal and said rules database and to apply said local broadcasting time regulation to each advertisement before said advertisement is shown;

1[f] wherein the control means is further arranged to update the second field in the header of said advertisement when said advertisement is again shown during time-shifted viewing.

**a. Plotnick in combination of Parekh does not teach the limitation 1[a]**

Plotnick does not teach the limitation “automating compliance with local broadcasting regulations laid down by a broadcasting authority and applicable to advertisements”.

To argue that Plotnick teaches the limitation “automating compliance with local broadcasting regulations laid down by a broadcasting authority and applicable to advertisements”, Petitioner proffers that Plotnick discloses “To select appropriate advertising, Plotnick’s advertisements contain “control data 1006,” which is metadata that “includes descriptions of the ad content, target audience, encoding attributes, delivery instructions, and contract limitations.” Ex1005, ¶154. Moreover, Plotnick discloses that there are “requirements for ... frequency of viewership by the target audience, and flight information, which indicates the networks and times for displaying the advertisement.” Ex1005, ¶169. Advertisements are also selected based on “what time of day it is, what day of the week, ... and other criteria that would be well within the scope of the current invention.” Ex1005, ¶194. Pet., 33.

Petitioner then concludes that “Metadata to select ads based on **“time of day”** or **“day of the week”** encompass metadata relating to time restrictions of local broadcasting time regulations set by a local broadcasting authority. (Citing Ex.1002, ¶106). Plotnick’s system automates compliance with such regulations

because the PVR processes metadata and filters to select appropriate advertisements without user action. (Citing Ex.1002, ¶106). Pet., 33.

Plotnick really depicted time restrictions of advertisements, but the restrictions are entered by the sales force, not laid down by the local broadcasting authority. Plotnick discloses “The sales force enters requirements for viewership ratings, frequency of viewership by the target audience, and flight information, which indicates the networks and times for displaying the advertisement (ad campaign data 1152)”, Plotnick never mention that the time regulations is set by a local broadcasting authority.

Therefore, Plotnick does not teach the limitation “automating compliance with local broadcasting regulations laid down by a broadcasting authority and applicable to advertisements”.

Parekh does not teach the limitation “said advertisements being provided during time-shifted viewing/listening”.

Parekh discloses a “rules engine” that controls “what [media items] are played on-air and in what order ... with a combination of guidelines and rules, such as [] regulations from regulators 110.” Ex-1007, 11:14-20. These rules “may be static which apply at all times or dynamic which apply only under certain conditions, such as time of day or size of online audience.” Ex-1007, 11:26-28. Examples of such

rules include “FCC regulations for content, including: that indecent and/or profane material may not be broadcast outside the FCC Safe Harbor[.]” Ex-1007, 11:29-31.

Such FCC regulations are local broadcasting time regulations laid down by a broadcasting authority, thus Parekh discloses “automating compliance with local broadcasting regulations laid down by a broadcasting authority and applicable to advertisements”.

Parekh does not teach the limitation “said advertisements being provided during time-shifted viewing/listening”.

Regarding the term “time-shifted”, the ’302 Patent describes that

If a programme is recorded and viewed at a different time of day, it contains all of the adverts which were originally broadcast, some of which may be unsuitable for that time. One result is that children may see inappropriate adverts, and another is that advertisers are at present not allowed to charge for the time-shifted viewing of adverts.

The cited portion of the ’302 Patent shows that “time-shifted” means that a programme is recorded and viewed at a different time (than the broadcast) of day. the ’302 Patent need to determine advertising content to be compliance with local broadcasting regulations laid down by a broadcasting authority during “time-shifted” period. On the contrary, Parekh depicts a method of determining advertising content to be included in a broadcast, Ex-1007, Abstract. Advertising content in

Parekh need to be compliance with local broadcasting regulations laid down by a broadcasting authority during broadcasting time, not during “time-shifted” period.

Therefore, Parekh does not teach the limitation “said advertisements being provided during time-shifted viewing/listening”.

Plotnick in combination of Parekh does not teach the limitation 1[a]

To argue that Plotnick in combination of Parekh teaches the limitation 1[a], Petitioner argues as follows

A POSITA would have been motivated to implement Parekh’s business rules that ensure compliance with applicable regulations (e.g., FCC time regulations) in Plotnick because Plotnick teaches “day part” and “time of day” as considerations for ad selection. Plotnick is silent on what specific time of day considerations to implement, but a POSITA would have known that applicable FCC regulations are such considerations that define what is legal based on time of day. Ex,1005, ¶¶161, 194; Ex,1002, ¶¶106-110. A POSITA seeking to implement time of day considerations as suggested in Plotnick would have sought further teachings about such time considerations in other ad-targeting teachings and would have been motivated to implement the teaching in Parekh to ensure that ads complied with FCC regulations. Ex,1002, ¶¶107, 109. Pet.,34-35.

Petitioner further argues a POSITA would have had a reasonable expectation of success in combining these teachings. Plotnick’s system uses similar rules to

Parekh's "business rules" (i.e., time-based regulations), including criteria limiting advertisements based on "time of day" or "day of the week." A POSITA implementing Parekh's teachings would have known to add time restrictions defined in FCC regulations into the Plotnick's system because it would have simply required adding applicable restriction rules, including times when certain types of content are not allowed according to the FCC regulation as taught in Parekh, and applying such rules based on ad metadata about the content in each ad, as taught in Plotnick. Ex.1002, ¶111. Pet., 35.

Patent owner respectfully disagrees with Petitioner.

Office personnel must resolve the Graham factual inquiries. Then, Office personnel must articulate the following: (2) finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately. MPEP. 2143. 1.A (2)

Plotnick's system uses rules to limit advertisements based on "time of day" or "day of the week." As set forth above, the rules are set by the sales force, not by the local broadcasting authority. The purpose of the rules of Plotnick based on "time of day" or "day of the week" is to increase profits during time-shifted viewing/listening. The purpose of FCC regulations in Parekh is to remove unsuitable advertisements

from programme during broadcasting period, not during time-shifted viewing/listening.

Since the purpose of FCC regulations in Parekh is to remove unsuitable advertisements from programme during broadcasting period, not during time-shifted viewing/listening, FCC regulations of Parekh cannot combined into Plotnick's system to remove unsuitable advertisements during time-shifted viewing/listening. Plotnick in combination of Parekh does not teach the limitation 1[a].

**b. Plotnick in combination of Parekh does not teach the limitation 1[c.1]**

First, Plotnick and Parekh does not teach “header”. Plotnick and Parekh disclose Metadata associated with advertisement, not “header”. Metadata serves as a form of documentation that assists in organizing, searching, and interpreting data (advertisement). Metadata stored separately in a metadata file. For example, Plotnick describes that the ad metadata is separate from ad.. “The ad metadata 1006 will either be saved or discarded, depending upon whether the ad was saved or discarded. Additionally, the processing component 10101 updates the ad metadata 1006 based on ad delivery and user interaction.Ex.1005, ¶0156.

Headers, on the other hand, are specific pieces of information located at the beginning of a file. They are part of a standardized structure or protocol and contain instructions, parameters, or control data for processing the associated file.

Second, Plotnick and Parekh does not teach “a first field related to a local broadcasting time regulation laid down by the broadcasting authority, which local broadcasting time regulation restricts the time of day at which said advertisement may be shown”.

As set forth above, Plotnick does not teach the limitation “automating compliance with local broadcasting regulations laid down by a broadcasting authority and applicable to advertisements” in limitation 1[a], correspondingly, Plotnick does not teach “a first field related to a local broadcasting time regulation laid down by the broadcasting authority, which local broadcasting time regulation restricts the time of day at which said advertisement may be shown”.

Petitioner proffers that Plotnick thus discloses control metadata having a field with information related to applicable local broadcasting time regulations laid down by applicable broadcasting authorities because such metadata would include, for instance, information about limitations based on whether the ad content is profane, indecent, relates to alcohol, should not be shown to children during the day, or any other such information related to applicable broadcasting time regulations. Ex.1002, ¶125. For example, Figures 6B and 6C of Plotnick show identification of advertisements by brand, which could signal that the content is not child-friendly (e.g., an alcohol or casino brand). See Ex.1005, FIG. 6C (shown below). Pet. 44-45.

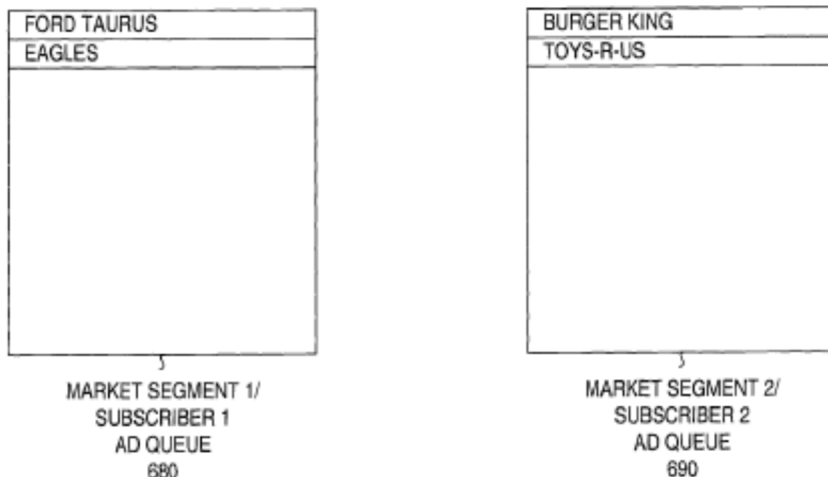


**FIG. 6C**

FIG. 6C only shows market segments of ad queue, the market segments does not related to local broadcasting time regulations laid down by applicable broadcasting authorities, Since “A subscriber segmentation module 924 uses demographic, geographic, and subscriber data to form groups of subscribers that fall into predefined market Segments”. Ex.1005, ¶152.

Although Parekh discloses a “rules engine” that controls “what [media items] are played on air” by applying “a combination of guidelines and rules, such as station policies and regulations from regulators 110.” Ex.1007, 11:14-20. Parekh also discloses that metadata is associated and transmitted, processed, and stored with each advertisement in a “media database 340.” Ex.1007, 10:32–37, 10:57, 11:11–13, 9:66–10:4. Since the programme and ad in Parekh are not recorded and viewed at a different time (than the broadcast) of day, there is no need to store local

broadcasting time regulations in a header of the ad, since the local broadcasting time regulations can be stored in the “rules engine”.

Therefore, Plotnick and Parekh do not teach the limitation “a first field related to a local broadcasting time regulation laid down by the broadcasting authority, which local broadcasting time regulation restricts the time of day at which said advertisement may be shown”.

**c. Plotnick in combination of Parekh does not teach the limitation 1[c.2]**

Regarding the limitation “a second field related to the number of times said advertisement has previously been shown during time-shifted viewing”, table 1 of the '302 patent has corresponding field name in advertisement header--viewings (Number of times this advert has been shown in time-shifted programme viewing.

| TABLE 1                         |                                                                              |
|---------------------------------|------------------------------------------------------------------------------|
| Fields in advertisement headers |                                                                              |
| Field Name                      | Activity                                                                     |
| Time of Day validity            | Code to indicate time of day when advert may be shown.                       |
| Days validity                   | Code to indicate the days of the week when advert may be shown               |
| Advert identifier               | Number with check digit to uniquely identify the advert                      |
| Frame length                    | Number giving exact length of advert in frames                               |
| Start date                      | Earliest date and time of permitted showing                                  |
| End date                        | Latest date and time of permitted showing                                    |
| Urgency matrix                  | Table of hours indicating advertiser's preferred time of showing             |
| Interactive or Passive          | Specifies if a button depression is expected                                 |
| Showings                        | Number of times advert is to be shown                                        |
| Viewings                        | Number of times this advert has been shown in time-shifted programme viewing |
| Frequency                       | Minimum period to elapse before repeat showing                               |
| When last selected              | Date and time when advert last selected for viewing                          |
| Special expiry                  | Optional Field                                                               |
| Warnings                        | Keywords to match against viewing regulations                                |

**'302 patent – Table 1**

To argue that Plotnick teaches the limitation, Petitioner proffers “Plotnick discloses that the processing component 1010 “updates the ad metadata 1006 based on ad delivery and user interaction.” Ex-1005, ¶156; Ex-1002, ¶130. Additionally, after an advertisement is presented, “the system updates the ad metadata and transmits an insertion report to the head-end.” Ex. 1005, ¶163. As Plotnick explains, the system includes updates to the “ad metadata” based on “ad delivery.” A POSITA would have understood these metrics include the number of times the ad was shown to the user. Ex,1002, ¶130. For example, Plotnick explains that “[t]he traffic and billing system 712 tracks the insertion results and bills the advertiser based on the insertions.” Ex.1005, ¶170. Additionally, Plotnick teaches “upstream data transport module” for sending data and reports to the broadcaster. Ex.1005, ¶141.” Pet., 47-48.

The cited portion of the Petition shows that Plotnick does not explicitly teaches “a second field related to the number of times said advertisement has previously been shown during time-shifted viewing”. Petition relies on the inherent teaching of Plotnick.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534,28 USPQ2d 1955, 1957 (Fed. Cir. 1993)

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d1461, 1464 (Bd. Pat. App. & Inter. 1990).

Plotnick disclose “updates the ad metadata 1006 based on ad delivery and user interaction.” “ad delivery” means the ad is delivered from advertiser to PVC system. As to the “user interaction”, Plotnick describes that a user interface 628, typically implemented through on-screen graphics and a remote control or remote keyboard, facilitates all the control and interactions with the television viewer. Some of the interactions will be used by the client-side STB ad targeting system 600 to help build the viewer profiles necessary to do individual ad targeting. Ex.1005, ¶140.

The user interface 628 Supplies user events 1030 based on viewer interaction with the remote control and the front panel of the set-top box. These events 1030 include channel changes, Volume changes, and VCR-like controls of the PVR. Ex.1005, ¶160.

The cited portion of Plotnick shows that “user interaction” includes channel changes, Volume changes, and VCR-like controls of the PVR, not include “the number of times the ad was shown to the user.”

Although Plotnick discloses “[t]he traffic and billing system 712 tracks the insertion results and bills the advertiser based on the insertions”. The insertion is

different from “the number of times the ad was shown to the user”. For example, in one aspect, an insertion is conduct, but the viewer does not view the inserted ad, in another aspect, an insertion is conduct, but the viewer views one the inserted ad for several times, since the ad is recorded in the PVR.

The limitation “the number of times the ad was shown to the user” does not necessarily flow from the teachings of Plotnick, therefore, Plotnick does not inherently teach the limitation.

Parekh disclose an analysis, reporting, analytics, and metrics server 328, in part to analyze station statistics with information equal to or superior to Arbitron or Nielsen ratings based in part on user community information, analyze demographics statistics of the user community for a given period of time, and report statistical information. Ex.1007,9:55-61. But Parekh does not disclose “the number of times the ad was shown to the user”.

Therefore, Plotnick and Parekh do not teach the limitation “a second field related to the number of times said advertisement has previously been shown during time-shifted viewing.

**d. Plotnick in combination of Parekh does not teach the limitation 1[f]**

The limitation 1[f] recites “wherein the control means is further arranged to update the second field in the header of said advertisement when said advertisement is again shown during time-shifted viewing”.

In support of the notion that Plotnick renders obvious element 1[f], Petitioner proffers that the processing component 1010 (“control means”) “updates the ad metadata 1006 based on ad delivery and user interaction.” Ex.1005, ¶156. After showing an advertisement to a viewer, “the system updates the ad metadata and transmits an insertion report to the head-end.” Ex.1005, ¶163. Petitioner argues that a POSITA would have been motivated to implement “updating” metadata after an advertisement is shown by updating a second field of the header when an advertisement is shown, including during time-shifted viewing, because updating such metadata in the second field of the header would ensure that metadata in the header is accurate and up to date. Ex.1002, ¶148. Pet., 56-57.

However, as set forth above, Plotnick does not teach the limitation “a second field related to the number of times said advertisement has previously been shown during time-shifted viewing”, thus, Plotnick does not disclose “update the second field”. Since the second field is the base of the “update the second field”.

Petitioner further argues that “a POSITA would have been motivated to store updated information in the same second header field because this would ensure that if that item is considered for playback again, the system would be able to decide whether to play the item using accurate and up-to-date information. Ex.1002, ¶148. Updating such information would also ensure that the advertising campaign and targeting criteria are met. Ex.1002, ¶¶60-61, 148. For instance, an advertiser may

have purchased only a certain number of plays or may have a rule about the frequency at which their ad is shown, e.g., to avoid annoying the viewer. Ex.1002, ¶60. These were well-known criteria that would have used up-to-date metadata regarding how many times the ad was played. Ex.1002, ¶¶60-61, 148.

On the other hand, the '302 Patent explains that viewings field is the number of times this advert has been shown in time-shifted programme viewing. Showings field is the number of times advert is to be shown, Frequency field is the minimum period to elapse before repeat showing. Ex1001, table 1. The Showings Field is included to prevent too frequent showing with the risk of viewer boredom. Ex1001,4: 32-33. Showings and Frequency Fields can be set to prevent the same advert being shown too often to the same viewer. Ex1001,6: 1-3.

The '302 Patent shows that, to prevent too frequent showing with the risk of viewer boredom, fields in an advertisement header must include two fields, Showings field and viewings field.

Petitioner states that “update the second field in the header of said advertisement when said advertisement is again shown during time-shifted viewing” can ensure that advertising campaign and targeting criteria are met. For instance, an advertiser may have purchased only a certain number of plays or may have a rule about the frequency at which their ad is shown, e.g., to avoid annoying the viewer”. But Plotnick discloses neither viewings field nor showings field required to ensure

that advertising campaign and targeting criteria are met. It stands to reason that Petitioner has used hindsight to bridge the gap: the claimed invention is providing a roadmap that the element would have fit into the prior art. This is an exercise in impermissible hindsight analysis.

Thus, Petitioner has not met his burden to show how Plotnick teaches the limitation 1[f].

As set forth above, Parekh does not teach the limitation “a second field related to the number of times said advertisement has previously been shown during time-shifted viewing”, thus, Parekh does not disclose “update the second field”.

Therefore, Plotnick in combination of Parekh does not teach the limitation 1[f].

**e. Plotnick in combination of Parekh does not Render Claim 1 Obvious**

Petitioner fails to undertake a Graham analysis, because Plotnick in combination of Parekh lacks evidence of crucial limitations of claim 1, such as the elements 1[a], 1[c.1], 1[c.2], and 1[1f]. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Therefore, Plotnick in combination of Parekh does not render claim 1 obvious because it has not established its prima facie case, since “obviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003).

## **2. Claims 1–4, 6–9**

Claims 2–4 and 6–9 depend from claim 1 and are not obvious over Plotnick in view of Parekh for at least the same reasons.

## **3. Claim 12**

Independent claim 12 has been divided into elements for consideration by the Petitioner as follows:

12[a] A Personal Video Recorder (PVR) for use in a system for automating compliance with local broadcasting regulations laid down by a broadcasting authority and applicable to advertisements, said advertisements being provided during time-shifted viewing/listening, the PVR comprising:

12[b] data storage means storing a programme episode database, an advertisement database, and a rules database,

12[c] each stored advertisement having associated therewith a header comprising a first field related to a local broadcasting time regulation laid down by the broadcasting authority, which local broadcasting time regulation restricts the time of day at which said advertisement may be shown,

12[d] and a second field related to the number of times said advertisement has previously been shown during time-shifted viewing, wherein the rules database contains rules relating to said local broadcasting time regulation, and wherein the stored programme episodes have periodic breaks for the insertion of advertisements;

12[e] input connection means for connection to a source of video/audio signals and a real-time clock signal;

12[f] output means for connection to a consumer's viewing/listening unit; and

12[g] control means arranged to read said first field and said clock signal and said rules database and to apply said local broadcasting time regulation to each advertisement before said advertisement is shown during one of the periodic breaks;

12[h] wherein the control means is further arranged to update the second field in the header of said advertisement when said advertisement is again shown during time-shifted viewing.

Claim 12 is directed to a Personal Video Recorder and contains similar elements of claim 1, and Claim 12 only adds the “output means” (element (12[f])), which is merely a connection between the PVR and television set.

As set forth above, Plotnick in combination of Parekh does not teach the limitation “automating compliance with local broadcasting regulations laid down by a broadcasting authority and applicable to advertisements”, Section V.B.1. a., supra. Plotnick in combination of Parekh does not teach 1[c.1], 1[c.2], and 1[1f] as required by claim 1. Section V.B. b-d., supra.

Similarly, Plotnick in combination of Parekh does not teach the above elements in 12[a], 12[c], 12[d], and 12[h] as required by claim 12.

Thus, Plotnick in View of Parekh does not teach all elements of claim 12 of the '302 Patent, petitioner fails to establish that challenged claim 12 is obvious over Plotnick and Parekh.

#### **4. Claims 13-15**

Claims 13-15 depend from claim 12 and are not obvious over Plotnick in view of Parekh for at least the same reasons.

#### **C. Petitioner Fails to Establish in Ground 2 that Challenged Claims 1–4, 6–9 and 12–15 are Obvious Over Plotnick**

In Ground 2, Petitioner construes the claims based on how Patent Owner appears to apply the claims in its Preliminary Infringement Contentions attached as Ex, 1022, 3-4. and Ex, 1023, 2-3. Pet., 73. It is obvious that claim construction In Ground 2 is not in compliance with the regulations of 37 C.F.R. §42.100(b). petitioner fails to establish in ground 2 that challenged claims 1–4, 6–9 and 12–15 are obvious over Plotnick since the arguments are based on false claim construction.

As explained in Section V.B., in the case of claim construction being in compliance with the regulations of 37 C.F.R. §42.100(b), claims 1–4, 6–9 and 12–15 are not obvious over Plotnick in view of Parekh, Thus claims 1–4, 6–9 and 12–15 are not obvious over Plotnick alone. Particularly, Plotnick does not teach 1[a], 1[c.1], 1[c.2], and 1[1f] as required by claim 1. Plotnick does not teach 12[a], 12[c], 12[d], and 12[h] as required by claim 12. Claims 2–4 and 6–9 depend from claim 1,

Claims 13-15 depend from claim 12, therefore, claims 1–4, 6–9 and 12–15 are not obvious over Plotnick.

## **VI. CONCLUSION**

For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition in its entirety.

Dated: July 12, 2023

Respectfully submitted,

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### **CERTIFICATION OF WORD NUMBER**

Counsel for Patent Owner hereby certifies that this PATENT OWNER SAFecast LIMITED LLC'S PRELIMINARY RESPONSE TO PETITION FOR INTER PARTES REVIEW OF U.S. PATENT NO. 9,392,302 and 7,200 words as calculated using the word count function of Microsoft Word, not including material excluded under 37 C.F.R. 42.24(a)(1).

Dated: July 12, 2023

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**CERTIFICATE OF SERVICE**

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