

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

SAFECAST LIMITED LLC,

Patent Owner.

IPR2023-00652
Patent No. 9,392,302

**PATENT OWNER'S SUR-REPLY TO
PETITIONER'S REPLY**

TABLE OF CONTENTS

A.	Petitioner Fails to Establish in Ground 1 that Challenged Claims 1–4, 6–9 and 12–15 are Obvious Over Plotnick and Parekh	4
1.	Claim 1.....	4
a.	Petitioner Fails To Rebut PO’s Showing That Petitioner’s combination of Plotnick and Parekh discloses 1[c.1].....	4
b.	Petitioner Fails To Rebut PO’s Showing That Petitioner’s combination discloses 1[e.1]	19
c.	Plotnick in combination of Parekh does not Render Claim 1 Obvious ..	19
2.	Claims 2–4, 6–9	20
3.	Claim 12.....	20
4.	Claims 13-15.....	21
B.	Petitioner Fails to Establish in Ground 2 that Challenged Claims 1–4, 6–9 and 12–15 are Obvious Over Plotnick	21
	CONCLUSION.....	22

Patent Owner's Exhibits

Exhibit No.	Description
2001	Regulatory and Industry Standards Applicable to Mature, Indecent and Obscene Programming Source: https://www.dwt.com/insights/2003/10/regulatory-and-industry-standards-applicable-to-ma
2002	PTAB Issues Claim Construction Final Rule Source: https://www.uspto.gov/patents/ptab/procedures/ptab-issues-claim-construction

Petitioner's Reply fails to rebut the POR's arguments, underscoring Petitioner's failure of proof.

A. 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

a. Petitioner fails to rebut PO's showing that petitioner's combination of Plotnick and Parekh discloses 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"

Regarding the term "a local broadcasting time regulation," the reply contents that claims do not require the "first field" to have "a local broadcasting time." Instead, the claims recite a "first field related to a local broadcasting time regulation. Plotnick in view of Parekh teaches headers (from Plotnick) that would have included information related to local broadcast time regulations (from Parekh), which is what the challenged claims recite. Rep. 5-6.

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. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). 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, 13USPQ2d 1320, 1322 (Fed. Cir. 1989); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir.2004).

Quite apart from the written description and the prosecution history, the claims themselves provide substantial guidance as to the meaning of particular claim terms. *See Vitronics*, 90 F.3d at 1582; *see also ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003)

The language of claim 1 defines “which local broadcasting time regulation restricts the time of day at which said advertisement may be shown,” which means that the “local broadcasting time regulation” is not a broad “time regulation” to regulate the time of all advertisements, but a specific restriction of **the time of day at which said advertisement may be shown according to** “local broadcasting time regulation.” The specification also supports that the first field is the restriction of the time of day at which said advertisement may be shown. The header in each advert contains a series of fields as shown in Table 1:

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

Table 1 of the '302 Patent

The first field in the head is “Time of Day validity.” The specification depicts that “[T]he Time of Day validity Field may, if required, indicate multiple periods in a day.” the '302 Patent, 4:24-25.

Although the ordinary and customary meaning “local broadcasting time regulation” is only a “regulation” to restrict the time of day of all advertisements, it is inconsistent with the specification and the claim language, in this case, the specification and the claim language control.

Thus, claim 1 requires the “first field” to have “a local broadcasting time” of the advertisement which is regulated by the “local broadcasting time regulation.”

Petitioner relies on the combination of Plotnick and Parekh to teach the limitation 1[c.1].

The reply argues that:

Plotnick teaches that advertisements have “ad metadata” in “control data 1006, which has multiple fields regarding a variety of characteristics relating to the advertisement including, e.g., information relating to the “time of day” when the advertisement should be shown. Paper 1 at 42–43 (citing Ex-1005 ¶¶154, 155, 169, 194 and Ex-1006 ¶¶50–51). Plotnick’s ad metadata also includes information regarding the content of the advertisement, e.g., the product brand, which could indicate whether the content is child-friendly. *Id.* at 44–45 (citing Ex-1005 at Figs. 6C, 6B and Ex-1002 ¶¶98, 125–127). Reply, 2-3.

Parekh teaches that before playing a media item, including advertisements, in a dynamic media system, the system should apply guidelines and rules, including rules based on FCC broadcasting time regulations, based on metadata associated with each advertisement. *Id.* (citing Ex1007 at 11:14–20, 11:26–36). Reply, 3-4.

a POSITA would have been motivated to implement Plotnick’s system, which controls the “time of day” that an advertisement is played by using a metadata field in Plotnick’s advertisement header, by combining the Parekh teaching to apply rules based on local broadcasting time regulations. *Id.* at 45–47 (citing Ex-1002 ¶¶128–129). Reply, 4. Thus, applying Parekh’s time of day rules, which include

consideration of local broadcasting regulations, would have been a straightforward combination requiring only minor adjustment to the Plotnick system. Paper 1 at 47 (citing Ex-1002 ¶129). Reply, 4.

The Petition further explained the motivation to seek implementation details regarding FCC broadcasting time regulations, as taught in Parekh, and apply them to Plotnick. *Id.* at 29–31. Specifically, the rationale behind the FCC regulation restricting profane and obscene content at certain times of day—to prevent children from being exposed to harmful content—was a frequent topic of news articles and publications. *Id.* (citing Ex-1002 ¶¶100, 110 (citing Exs-1028–1034); Ex-1028 at 1 (quoting D.C. Circuit decision regarding government interest in “the well-being of minors”); Ex-1030 at 1 (“serves the goal of confining this material to hours minors are less likely to be exposed to it”)). Reply, 4-5.

As the Petition and Petitioner’s expert explain, a POSITA would have been motivated to ensure that advertisements were time-appropriate based on the timing restriction set forth in those laws because violation of the laws would incur legal and financial consequences and because the rationale behind the law—to protect children from being exposed to inappropriate content—was a public concern at the time of the invention. *Id.* (citing Ex-1002 ¶100); Ex-1002 ¶110 (citing, e.g., Ex-1028, Ex-1030); Ex-1040 ¶225. Reply, 5.

Petitioner contents the rationale behind the combination of Plotnick and Parekh as follows:

“Parekh teaches a similar method for selecting advertisements based on time of day regulations,” and “both disclose using metadata associated with each advertisement to control when and how the advertisement is played.” Pet. 47 (citing Ex-1005 ¶ 194; Ex. 1002 ¶ 129). Based on the combined teachings, Petitioner asserts that “[a]pplying the teachings of Plotnick and Parekh regarding adding metadata and associated rules to control ad timing in accordance with FCC regulations would have led to the expected result that an advertisement would only be selected for playback when permitted by such rules.” Pet. 47 (citing Ex. 1002 ¶ 129).

Patent Owner respectively submit that Parekh disclose a different method from the '302 Patent for selecting advertisements based on time of day regulations.”

Referring to Fig.1 (reproduced below), Parekh discloses a social broadcasting system. Social broadcasting server 104 couples with regulators 110. **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**. Regulators 110 also include enablers of rules or policies for the broadcast station 118 itself, or for the rules or policies of the

social broadcasting service. Advertisers 114 include advertisers, ad networks, ad network services, ad relevancy services, ad broker services, sales teams and any nonprofessional or professional third party interested in advertising a message on broadcast station(s) 118. Parekh. 4: 4-25.

The cited portion of Parekh shows that **Regulators 110 of the** social broadcasting system determines the time of day at which the advertisement may be shown (**when broadcasting on broadcast station(s)**).

To depict how the **Regulators 110 determines the time of day at which the advertisement may be shown, referring to Fig. 3A(reproduced below)**, Parekh discloses a rules engine as follows

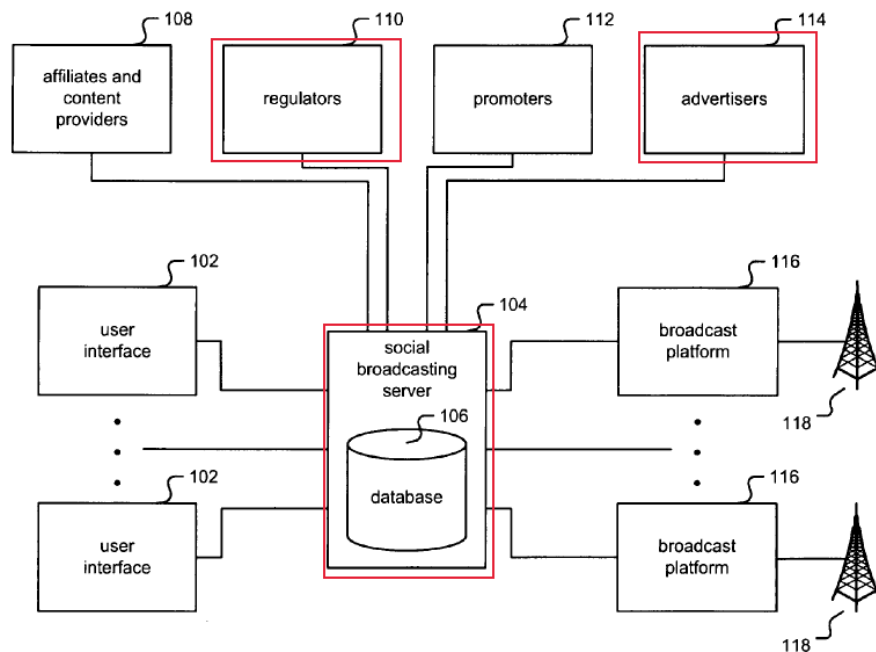


FIG. 1

Fig. 1 of Parekh

To depict how the **Regulators 110 determines the time of day at which the advertisement may be shown, referring to Fig. 3A(reproduced below)**, Parekh discloses a rules engine as follows:

[r]ules engine 308 is used to temper the indication of control from the user community with regards to what tracks are played on-air and in what order from gaming platform server 322 with a combination of guidelines and rules, such as station policies and regulations from regulators 110. Parekh. 11: 15-20.

Examples of business rules include FCC regulations for content, including: **that indecent and/or profane material may not be broadcast outside the FCC Safe Harbor.** (Parekh, 11:29-31)

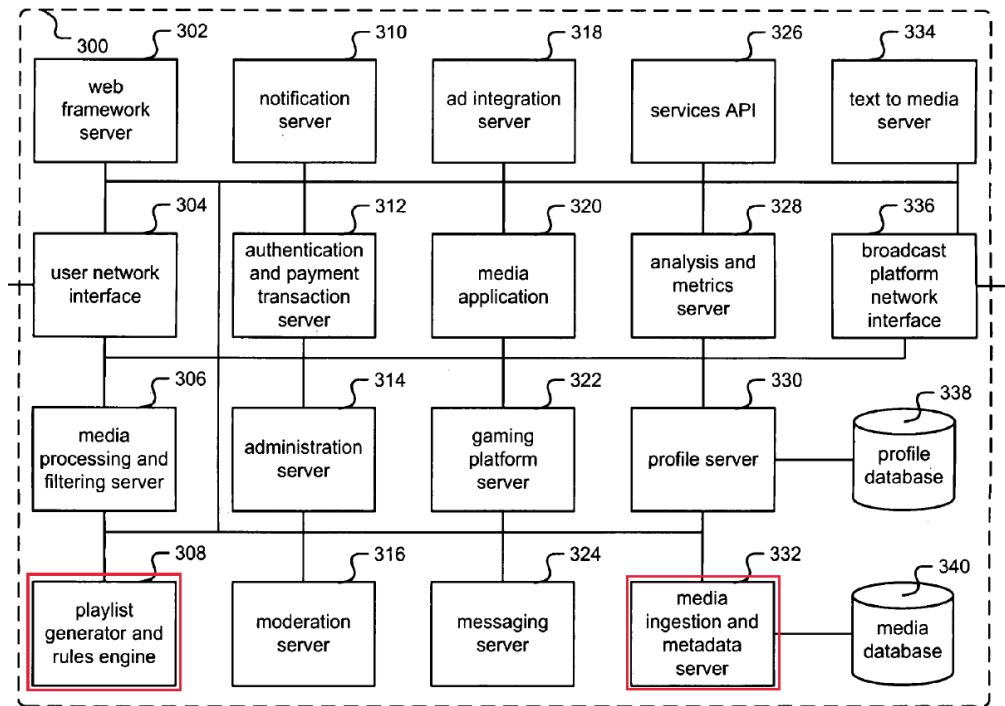


FIG. 3A

Fig. 3A of Parekh

The cited portion of rules engine shows that, in order to **determines the time of day at which the advertisement may be shown**, the rules engine will examine the content of an advertisement, if the content of the advertisement includes indecent and/or profane material, the advertisement can only be broadcast inside the FCC Harbor based on regulations from regulators 110.

Regarding the “metadata,” Parekh discloses how the Media Ingestion and metadata server 332 "ingest" content and stores the ingested data into a metadata:

Media ingestion and metadata server 332, in part to take content from disparate sources and "ingest" or normalize format and content for a consistent

broadcast, add, modify or delete metadata about each content piece. Parekh, 9:66-10:2.

FIG. 3C (reproduced below) is a flowchart illustrating an embodiment of a process for user-generated content uploading. The process may be implemented by media ingestion and metadata server 332 and/or social broadcasting server 104. Parekh,10:59-62.

The content is checked against a commercial database (382), ... The content is analyzed for "airability" (386), analogous to rules interpreted and/or provided for by moderation server 316. This may involve automated, semi-automated and/or manual ways of rendering the content to analyze for airability. If (388) problems are detected, the content is rejected (396), otherwise **the content is reviewed by a screener to find any content issues (390), such as illegal recordings or profanity.** If (392) it fails the review, it is rejected (396), otherwise **it is added to the media database 340 with the appropriate metadata (394).** Parekh,10:63-11:13.

The cited portion of rules engine shows that Media ingestion and metadata server 332 reviews the content to find **illegal recordings or profanity materials of an advertisement by a screener and stores the reviewed information to a metadata (394).**

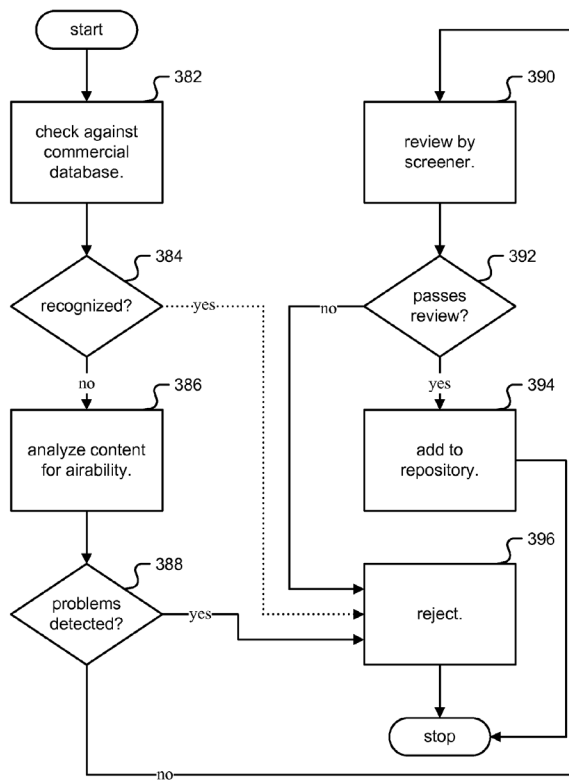


FIG. 3C

Fig. 3C of Parekh

The above citation of Parekh shows that, in order to compliance with FCC broadcasting time regulations, at first, Media ingestion and metadata server 332 reviews the content to find illegal recordings or profanity materials of an advertisement by a screener and stores the reviewed information to a metadata (394). Then, rules engine 308 examines the content of the advertisement, it checks the metadata (394) to find whether or not the content of the advertisement includes profanity material, if the content of the advertisement includes profanity material,

the rules engine 308 will broadcast the advertisement inside the FCC Safe Harbor based on FCC regulations from regulators 110.

Therefore, in order to compliance with FCC broadcasting time regulations, the metadata of an advertisement of Parekh includes “content information about whether or not the content of the advertisement includes profanity material,” the metadata need not to include “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.”

Furthermore, the use of content to select broadcasting time of programming to compliance with FCC broadcasting time regulations, including advertisements, was well-known. For example, Pursuant to a 1996 Congressional directive, the broadcast, motion picture and cable industries jointly adopted voluntary rules to **rate programming** that contains violence and sexual or other indecent material, known as the TV Parental Guidelines, the programs can be rate as TV-Y, TV-Y7, TV-G, TV-PG, TV-14, TV-MA. Ex. 2001, 2-5. FCC rules ban the broadcasting of indecent programs except between the hours of 10 p.m. and 6 a.m., a period known as the "safe harbor hours." Ex. 2001, 6.

Plotnick’s PVR enables users to view advertisements during time-shifted viewing. 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.” Plotnick, ¶154.

Patent owner appreciates Petitioner’s argument that “applying Parekh’s time of day rules, which include consideration of local broadcasting regulations, would have been a straightforward combination requiring only minor adjustment to the Plotnick system.” Reply, 4. But Petitioner makes a mistake in considering that Parekh discloses the same method as the ’302 Patent for selecting advertisements based on time of day regulations.

As set forth above, in order to compliance with FCC broadcasting time regulations, the metadata of an advertisement of Parekh includes “content information about whether or not the content of the advertisement includes profanity material.” The rules engine 308 examines the content of the advertisement, it checks the metadata to find whether or not the content of the advertisement includes profanity material, if the content of the advertisement includes profanity material, the rules engine 308 will broadcast the advertisement inside the FCC Safe Harbor based on FCC regulations from regulators 110. That is, “the local broadcasting time regulation restricts the time of day at which said advertisement may be shown” is not included in the metadata, but determined by the rules engine 308 based on the metadata and FCC broadcasting time regulations stored in the rules engine 308.

Since “Plotnick’s ad metadata also includes information regarding the content of the advertisement, Reply, 2. combined with Parekh, in order to compliance with FCC broadcasting time regulations, the metadata of an advertisement of Plotnick should also include “content information about whether or not the content of the advertisement includes profanity material,” and since “The server side AMS 700 of Plotnick 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,” Plotnick, ¶154. Accordingly, the server side AMS 700 of Plotnick will also include FCC broadcasting time regulations, such that, similar to rules engine 308 of Parekh, the server side AMS 700 can determine “the local broadcasting time regulation restricts the time of day at which said advertisement may be shown,” there is no need that metadata of an advertisement of Plotnick comprises “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.”

Further, to the extent that “the local broadcasting time regulation” is only a broad “time regulation” to regulate the time of all advertisements, not “the time of day at which said advertisement may be shown,” “the local broadcasting time regulation” is stored in the rules engine 308 of Parekh, similar to Parekh, in order to protect children from being exposed to inappropriate content during time-shifted

viewing, It is rather Plotnick's server side AMS 700, not the metadata of an advertisement, should store "the local broadcasting time regulation."

The claim elements of the '302 Patent recites "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." Parekh describes the similar but distinct methods to "protect children from being exposed to inappropriate content." Neither Parekh nor Plotnick discloses "the metadata of an advertisement includes the local broadcasting time regulation." 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.

The advantages of the subject matter of Claim 1 include "protect children from being exposed to inappropriate content" during time-shifted viewing. Comparing with the combination of Plotnick and Parekh, the '302 Patent need only one time to determine "the time of day at which said advertisement may be shown" and stores it in the header of the advertisement when a PVR records the advertisement, on the contrary, the "the time of day at which said advertisement may be shown" is not included in the metadata of the combination of Plotnick and Parekh, the metadata only include "content information about whether or not the content of the

advertisement includes profanity material,” when playing back the advertisement several times, at each time, it need to determine “the time of day at which said advertisement may be shown” with a method as set forth above.

Thus, Petitioner has not met his burden to show how the combination of Plotnick and Parekh teaches the limitation 1[c.1].

b. Petitioner Fails To Rebut PO’s Showing That Petitioner’s combination discloses 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”

As set forth in section IV.1.a, Plotnick and Parekh does not teach that each advertisement has a header with a first field having metadata relating to a local broadcasting time regulation, therefore, Plotnick and Parekh does not teach “control means arranged to read said first field” in the limitation 1[e.1] .

c. 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[c.1], and 1[e.1]. *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 2–4, 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

Claim 12 is directed to a Personal Video Recorder and contains similar elements of claim 1, 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 1[c.1], and 1[1e.1] as required by claim 1. Similarly, Plotnick in combination of Parekh does not teach the above elements in 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” 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” 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.

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

The reply argues that “Ground 2 maps to Patent Owner’s interpretation of the challenged claims in the civil action.” And “37 C.F.R. § 42.100(b) states that claims shall be construed using the same claim construction standard as that used in a civil action under 35 U.S.C. § 282(b).”

The PTAB explains that “under the final rule, when construing a claim term in an IPR, PGR, or CBM, the PTAB will take into consideration any prior claim construction determination that has been made in a civil action, or a proceeding before the International Trade Commission (ITC), if that prior claim construction is timely made of record in that IPR, PGR, or CBM” Ex. 2001,1.

In ground 2, Petitioner applies Patent Owner’s constructions from the civil action. But there is not any prior **claim construction determination** that has been made in a civil action. 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 above, 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[c.1] and 1[e.1] as required by claim 1. Plotnick does not teach 12[c], and 12[g] 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.

CONCLUSION

For the reasons discussed above, Patent owner respectfully requests the Board confirm that the Challenged Claims of the '302 patent are patentable.

Respectfully submitted,

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Dated: May 7, 2024

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CERTIFICATION OF WORD NUMBER

Counsel for Patent Owner hereby certifies that the foregoing document contains 3853 words as calculated using the word count function of Microsoft Word, not including material excluded under 37 C.F.R. 42.24(a)(1).

Date: May 7, 2024

/s/ Jacob B. Henry
Jacob B. Henry

CERTIFICATE OF SERVICE

I hereby certify that all counsel of record who have appeared in this case are being served on this day of May 7, 2024, with a copy of the foregoing via e-mail.

/s/ Jacob B. Henry
Jacob B. Henry