

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,

Petitioner,

v.

PLAYVUU, INC.,

Patent Owner.

CASE NO.: IPR2023-00848
U.S. PATENT NO. 10,931,911

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

	<u>Page</u>
I. RELATED MATTERS	1
II. INTRODUCTION	1
III. OVERVIEW OF THE '911 PATENT	3
A. Summary Of The Patent	3
B. Claims	4
IV. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION PURSUANT TO 35 U.S.C. § 325(d)	5
A. The Examiner Considered The Same And Similar Prior Art During Prosecution (<i>Becton, Dickinson</i> Factors (a), (b), (c) And (d))	7
B. Petitioner Has Not Demonstrated That The Office Erred In A Manner Material To The Patentability Of Challenged Claims (<i>Becton,</i> <i>Dickinson</i> Factors (e) And (f)).	21
V. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION PURSUANT TO 35 U.S.C. §314(a)	23
A. Application Of The <i>Fintiv</i> Factors Weighs In Favor Of Denying Institution	24
1. <i>Fintiv</i> Factors 1 & 2 Favor Denying Institution: The Court Has Not Entered A Stay, And Trial Is Scheduled To Begin Before A Final Written Decision Is Due	25
2. <i>Fintiv</i> Factor 3 Favors Denying Institution: The Parties Have Made Significant Investments In The Concurrent Litigation	26
3. <i>Fintiv</i> Factors 4 & 5 Favor Denying Institution: Petitioner Is The Defendant In The Concurrent Litigation, And The Issues Substantially Overlap Between The Petition And The Concurrent Litigation	26

4.	<i>Fintiv</i> Factor 6 Favors Denying Institution: Petitioner’s Delay In Filing The IPR Petition, The Lack Of Merit Of The Grounds Asserted, And Other Circumstances.....	27
VI.	THE PETITION SHOULD BE DENIED UNDER 35 U.S.C. § 314(a) FOR FAILING TO DEMONSTRATE A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY CHALLENGED CLAIM.....	28
A.	Petitioner Has Not Conducted A Proper Obviousness Analysis Of The Challenged Claims.	32
1.	The Petition Does Not Adequately Inform The Reader Of The Basis For Each Ground Of Unpatentability	33
2.	The Petition Ignores The Differences Between The Prior Art Cited And The Claims	34
3.	The Petition Does Not Articulate Any Reason Why The Prior Art Would Have Been Combined, Other Than To State The Secondary Reference(S) Teach The Feature Of The Claim	36
B.	Petitioner’s Reliance On Portions Of Cohen Allegedly Copied By Patent Owner Is Misplaced.	39
C.	Petitioner’s Repeated Statements That Patent Owner Was “Wrong” Are Not Warranted And Unfounded	43
D.	Petitioner’s Analysis Of Claims 2-11 In Each Ground Is Flawed For The Same Reasons Discussed Above	49
VII.	CONCLUSION.....	53

TABLE OF AUTHORITIES

	<u>Page(s)</u>
<u>Cases</u>	
<i>3M Co. v. Westech Aerosol Corp.</i> , IPR2018-00576, 2019 WL 3729475 (P.T.A.B. Aug. 7, 2019).....	11
<i>3M Co. v. Westech Aerosol Corp.</i> , IPR2018-00576, 2020 WL 578975 (P.T.A.B. Feb. 4, 2020).....	11
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i> , IPR2019-01469 (PTAB Feb. 13, 2020).....	6, 21
<i>Fidelity Nat’l Info. Servs., Inc. v. DataTreasury Corp.</i> , IPR2014-00489, 2014 WL 4059220 (P.T.A.B. Aug. 13, 2014).....	11
<i>Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha</i> , IPR2016-01357 (PTAB Sept. 6, 2017).....	2, 23, 27, 28
<i>Graham v. John Deere Co. of Kansas City</i> , 383 U.S. 1 (1966).....	28, 32
<i>Harmonic Inc. v. Avid Tech, Inc.</i> , 815 F.3d 1356 (Fed. Cir. 2016)	5
<i>In re Kahn</i> , 441 F.3d 977 (Fed. Cir. 2006).....	31
<i>In re Rouffet</i> , 149 F.3d 1350 (Fed. Cir. 1998)	38, 39, 44, 50
<i>Juniper Networks, Inc.</i> , IPR2017-00642 (Mar. 14, 2018).....	21
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	31, 32
<i>NHK Spring Co., Ltd. v. Intrix-Plex Techs., Inc.</i> , IPR2018-00752 (PTAB Sept. 12, 2018).....	23, 24, 28

Richdel, Inc. v. Sunspool Corp.,
 714 F.2d 1573, 1579-80 (Fed. Cir. 1983) 44

United Cannabis Corporation v. Pure Hemp Collective Inc.,
 Appeal No. 2022-1363 (Fed. Cir. May 8, 2023) 40

Statutes and Codes

37 CFR §42.6(a)(3).....10

MPEP §2141(II).....33

U.S.C. § 314(a) *passim*

U.S.C. § 325(d) 2, 6

EXHIBIT LIST

Exhibit No.	Description
EX2001	Declaration of Michael Shamos, Ph.D.
EX2002	Curriculum Vitae of Michael Shamos, Ph.D.

I. RELATED MATTERS

U.S. Patent No. 10,931,911 (“the ’911 Patent”) (EX1001) has been asserted by Patent Owner in *Playvuu, Inc. v. Snap Inc.*, Case No. 2:22-cv-06019 (C.D. Cal.), filed on August 24, 2022 (“concurrent litigation”).

II. INTRODUCTION

Patent Owner Playvuu, Inc. (“Playvuu” or “Patent Owner”) hereby submits this preliminary response to the petition for *inter partes* review (“Petition”) of claims 1-11 (“Challenged Claims”) of the ’911 Patent, filed by Snap Inc. (“Snap” or “Petitioner”). As set forth herein, Patent Owner submits that the Board should exercise its discretion and deny institution. The Petition identifies the same primary reference, Cohen (2009/0164034 A1) [EX1004], previously considered by the Office during examination of the ’911 Patent, and the secondary references relied upon by Petitioner are cumulative of or less relevant than the secondary references relied upon during examination. Further, Petitioner has asserted the same prior art against the ’911 Patent in the concurrent litigation, and a final written decision will not be due until after the commencement of the trial in the case. Finally, Petitioner fails to demonstrate a reasonable likelihood of success on the grounds challenging the patentability of the Challenged Claims.

First, the Board should exercise its discretion to deny institution under 35 U.S.C. § 325(d), because Petitioner presents the same primary prior art reference previously considered by the Office during prosecution of the '911 Patent. The Petition asserts the Challenged Claims are obvious based on Cohen in view of combinations of Chu, Sherman, Joslin, Lei, and Austerberry. However, as explained in detail in Section IV below, during the prosecution of the '911 Patent, the Examiner evaluated Cohen alone, and Cohen in combination with other references that contain cumulative or more relevant disclosures than the secondary documents relied upon in the Petition, and nonetheless allowed the Challenged Claims.

Second, the Board should exercise its discretion to deny institution under 35 U.S.C. § 314(a). Application of the *Fintiv* factors weighs heavily in favor of denying institution. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB March 20, 2020). One of the purposes of IPRs is to be an “effective and efficient alternative” to litigation. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017). Here, instituting an *inter partes* review would not be an effective or efficient alternative to litigation, particularly given that the Petition is not strong on its merits, Petitioner has raised the same grounds against the '911 Patent in the concurrent litigation, and trial is set

in the concurrent litigation for August 13, 2024—before a final written decision would be due.

Third, the Board should deny the Petition because it fails to demonstrate a reasonable likelihood of success that at least one claim is unpatentable. The grounds in the Petition, which assert unpatentability based on obviousness, are premised on a fundamentally flawed obviousness analysis. Petitioner ignores the differences between the cited documents and the Challenged Claims, and does not provide a rational reason to combine the cited documents in a manner that satisfies the features recited by the Challenged Claims. In addition, Petitioner’s obviousness analysis is improperly vague, rendering it difficult to follow and respond, due in part to Petitioner’s broad definition of, and repeated use of the term “teaches.”

For these reasons, as detailed further below, Patent Owner respectfully requests that the Board deny institution.

III. OVERVIEW OF THE ’911 PATENT

A. Summary Of The Patent

The ’911 Patent is directed to a method for audio-visual content creation that is more efficient and user-friendly than other then-existing methods. The ’911 Patent claims a sophisticated method that provides an innovative user interface for creating audio-visual content with a combination of media generation and editing

steps, including the addition of backgrounds and overlays, as well as latency editing, selective transparency, the setting of privacy attributes, and the encoding of a streamable video for sharing over a network. The '911 Patent thus combines sophisticated software for generating audio/video content that would have previously required multiple, complex devices, with software and hardware for encoding and sharing the generated content over a network according to a computerized privacy setting.

B. Claims

The '911 Patent includes 11 claims of which claims 1, 10 and 11 are independent. Exemplary Claim 1 recites as follows:

[1. Pre.] A method for generating and sharing audio/video content to a social network, comprising:

[1.1] initiating a content creation process in response to a request from a user;

[1.2] prompting the user to record content;

[1.3] prompting the user to select an audio composition from a list of compositions retrieved from a host server;

[1.4] presenting the user with a record button;

[1.5] presenting the user with a selection of visual media content for use as a background, wherein upon selecting an instance of pre-recorded visual media content from the selection, the user is presented with an interface to selectively edit the instance of pre-recorded visual media content;

[1.6] providing simultaneous aural playback of the audio composition during a recording session, thereby permitting the user to hear the composition during recording;

[1.7] generating recorded content based on the recording session by compositing video captured during the recording session with the instance of pre-recorded visual media content, such that the video captured during the recording session is selectively made transparent to reveal the instance of pre-recorded visual media content;

[1.8] displaying a preview of the recorded content to the user, wherein the preview of the recorded content enables the user to change the timing or latency of the recorded content to relative to the selected audio composition;

[1.9] selecting a privacy attribute for the recorded content;

[1.10] sending the recorded content to the host server, wherein the host server is configured to store multimedia content to facilitate access to other users according to the selected privacy attribute;

[1.11] receiving a request to publish the recorded content;

[1.12] in response to the request to publish, processing and encoding individual components of the recorded content to create a streamable video; and

[1.13] publishing the streamable video by copying the streamable video to a media server.

IV. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION PURSUANT TO 35 U.S.C. § 325(d)

Institution of *inter partes* review is discretionary. *Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“the PTO is permitted, but never compelled, to institute an IPR proceeding”). Specifically, Section 325(d) states that “[i]n determining whether to institute. . . the Director may take into account whether . . . the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17 (PTAB Dec. 15, 2017)

(precedential) and *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential); and *Agrinomix, LLC v. Mitchell Ellis Prods., Inc.*, IPR2017-00525, Paper 6 (PTAB Jun. 14, 2017) (denying institution on grounds based on prior art that was considered during prosecution even though the prior art reference was not relied upon to reject all the challenged claims).

In evaluating whether to exercise its discretion under § 325(d) when the same or substantially the same prior art or arguments previously were presented to the Office, the Board weighs the following non-exclusive factors “(a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.” *Becton, Dickinson & Co.*, IPR2017-01586, Paper 8 at 17-18.

A. The Examiner Considered The Same And Similar Prior Art During Prosecution (*Becton, Dickinson* Factors (a), (b), (c) And (d)).

The prior art cited by the Petitioner is the same as, and substantially similar to, the prior art already considered by the Examiner during prosecution of the '911 Patent. EX. 2001, ¶36. First, *Becton, Dickinson* factors (a), the lack of *material* differences between the prior art evaluated during prosecution of the '911 Patent and the prior art cited in the Petition, and (b), the cumulative nature of the asserted art and the prior art evaluated during examination, weigh in favor of denying institution.

As an initial matter, the primary reference relied on in each of the four grounds raised in the Petition is Cohen, which was cited and evaluated by the Examiner. *See* Ex. 1002 at 81; EX 2001 ¶36. The remaining references cited in the Petition are not materially different than the prior art evaluated during prosecution of the '911 Patent. Petitioner even admits to the similarities between Cohen, which was considered by the Examiner, and Chu, Sherman, and Joslin, which have also been cited by the Petitioner. (Petition, at 84 (“As discussed herein, Cohen, Chu, Sherman, and Joslin, teach similar systems...”)).

A brief summary of the prosecution history of the '911 Patent, and a comparison with Petitioner's discussion of the prior art cited in Grounds 1-4, shows that there are no material differences between the respective art. Claims 1-10 were

rejected as obvious over Cohen in view of Gentile, US 2010/0027961, further in view of Maigret *et al.*, US 2008/0109306. Final rejection dated June 10, 2020 – EX1002, pp. 0078-0091; EX 2001 ¶37. The Examiner recognized the differences between Cohen and the claims, which are essentially the same as the patented claims, the only difference being the addition of the word “audio” in element 1[i]:

Cohen fails to explicitly disclose presenting the user with a selection of visual media content for use as a background, wherein upon selecting an instance of pre-recorded visual media content from the selection, the user is presented with an interface to selectively edit the instance of pre-recorded visual media content;

generating recorded content based on the recording session by compositing video captured during the recording session with the instance of pre- recorded visual media content, such that the video captured during the recording session is selectively made transparent to reveal the instance of pre-recorded visual media content;

EX1002, pg. 0082; EX 2001 ¶37.

The Examiner relied on Gentile as disclosing “presenting the user with a selection of visual media content for use as a background, wherein upon selecting an instance of pre-recorded visual media content from the selection, the user is presented with an interface to selectively edit the instance of pre-recorded visual media content.” *Id.* The Examiner further stated that Gentile discloses “generating

recorded content based on the recording session by compositing video captured during the recording session with the instance of pre-recorded visual media content, such that the video captured during the recording session is selectively made transparent to reveal the instance of pre-recorded visual media content.” *Id.* The Examiner concluded that it would have been obvious to modify Cohen’s system to include the features of Gentile to allow “a more seamless integration with existing scenes in video compositing.” *Id.*; EX 2001 ¶38.

The Examiner presented an alternative obviousness argument by relying on Maigret as disclosing “receiving a request to publish the recorded content; in response to the request to publish, processing and encoding individual components of the recorded content to create a streamable video; and publishing the streamable video by copying the streamable video to a media server.” *Id.* at pg. 0083. The Examiner concluded that it would have been obvious to modify Cohen’s system to include the features of Maigret to “improve the distribution system for media content.” *Id.*; EX 2001 ¶39.

With respect to the added feature of independent claim 12 that recited detecting user movement in the video captured during the recording session, the Examiner relied on Crawford, *et al.*, US 2011/0053688, as “detecting user movement in the video captured during the recording session and representing that

movement by a trailing light (*trail of flames or sparks*).” *Id.* at pg. 0089, emphasis in original. The Examiner concluded that it would have been obvious to modify Cohen’s system to include the features of Crawford to “enhance [the] object in media modification.” *Id.*; EX 2001 ¶40.

The Petition simply replaces Gentile, Maigret, and Crawford, with Chu, Sherman, Joslin, Lei, and Austerberry, all of which contain essentially the same disclosures, but in some instances are further afield from Cohen’s system. EX 2001 ¶41. While Petitioner states that the secondary references to Chu, Sherman, Joslin, Lei, and Austerberry, are “non-cumulative,” the Petition is devoid of any evidence to support the statement. Ex 2001 ¶56. In fact, Petitioner does not explain how the newly applied references are different from (much less more relevant than) the prior art cited by the Examiner during prosecution of the ’911 Patent. *Id.*

For example, Petitioner states on page 20 of the Petition that Chu is non-cumulative, and cites to EX 1003, ¶159 of its expert report. Ex 2001 ¶56. The Petition makes no further statements regarding any differences between Chu and the art cited by the Examiner. While Petitioner references paragraph 159 of EX 1003, which in turn includes additional discussion of the relevance of Chu, none of that discussion is present in the Petition, thereby precluding Petitioner from relying on it. *See* 37 CFR §42.6(a)(3); *3M Co. v. Westech Aerosol Corp.*, IPR2018-00576, 2019

WL 3729475 (P.T.A.B. Aug. 7, 2019), Final Written Decision; *3M Co. v. Westech Aerosol Corp.*, IPR2018-00576, 2020 WL 578975 (P.T.A.B. Feb. 4, 2020) (Decision Denying Petitioner’s Request for Rehearing at page 3) (“Rehearing Decision”), affirmed by the Federal Circuit in a non-precedential opinion; *see also Fidelity Nat’l Info. Servs., Inc. v. DataTreasury Corp.*, IPR2014-00489, 2014 WL 4059220 (P.T.A.B. Aug. 13, 2014) (PTAB refused to consider evidence in an expert declaration that was not also discussed in the petition). Petitioner repeats the same with respect to Sherman (pg. 21, referencing EX 1003 ¶166), Joslin (pg. 22, referencing EX 1003 ¶175), Lei (pg. 22, referencing EX 1003 ¶180), and Austerberry (pg. 23, referencing EX 1003 ¶184). EX 2001 ¶57. Even if Petitioner can rely on these improperly incorporated by reference arguments, the statements made by its expert regarding the prior art are conclusory at best, and not relevant to the basis in which Petitioner combines the cited art. *Id.*

As explained below, prior art cited by the Examiner was more relevant to the ’911 Patent claims than the secondary references relied upon by Petitioner. As one example, Gentile discloses the same subject matter that Petitioner contends three separate documents, Chu, Sherman, and Joslin disclose.

Petitioner contends that:

Chu teaches a “personalized karaoke recording studio” for users to audio- and video-record themselves singing over user-selected karaoke songs in front of user-selectable backgrounds (EX1005, 2:36-48; 3:9-17, 3:59-4:2, 5:1-32, 12:49-64), and composite the background and users’ performance using chroma-key technology (3:19-58, 5:34-48). After recording, users may review the videos, add titles/messages, and permanently save them as, *e.g.*, MPEG files via MPEG converter 137.”

Petition at pg. 20.

Gentile discloses everything Petitioner contends *Chu* discloses, including user-selectable backgrounds, (multiple disclosures), compositing the video recorded with the selected video using chroma-key technology, (EX 1013 at paras. [0059], [0075], and [0163], and converting them to flash video file, MPEG, JPEG, and/or other file types for viewing at a display or submission to a content sharing website (para. [0090]). EX 2001 ¶42. Gentile is more relevant than *Chu* by disclosing converting the recorded content to create a streamable video, essentially the same subject matter that Petitioner relies on *Sherman* as disclosing. *Id.*

Petitioner contends that:

Sherman teaches a “video karaoke system” that “allow[s] dubbing an actor’s voice” in a video clip. EX1006, Abstract, ¶[0002], ¶[0024]. *Sherman* provides user interfaces for user selection of a movie clip to record over. EX1006, ¶[0014]. *Sherman* teaches: (i) segmenting/replacing the clip’s static portions with another background

or video; and (ii) video of a user may be captured and used to replace an actor in the clip. EX1006, ¶[0024]. The resulting video clip can be saved and edited. EX1006, ¶[0017]. The file components can be saved together as, *e.g.*, an MPEG, for distribution. EX1006, ¶[0023]. *Sherman* teaches using clips for webbased invitations. EX1006, ¶[0038].

Petition at 21; EX 2001 ¶43.

Gentile discloses everything Petitioner contends Sherman discloses, including providing user interfaces for user selection of a movie clip to record over. (“For instance, the washed media content **104** of the database **101** can comprise one or more video clips, such as movie clips comprising video and/or audio content, usable in the background of a combined video image.” EX 1013 at para. [0050]); EX 2001 ¶44. Gentile discloses using a movie clip and replacing an original actor. Abstract. Gentile discloses recreating the background of the movie clip after removing a character, and replacing a movie clip’s background (*i.e.*, static portion) with another background or video. EX 1013 at paras. [0010], [0011], [0036]. Gentile discloses editing the video (*id.* at para. [0057]), and converting the edited video files to a flash video file, MPEG, JPEG, and/or other file types for viewing at a display or submission to a content sharing website (para. [0090]). Gentile therefore discloses

the same subject matter relied upon by Petitioner as being disclosed by both Chu and Sherman, and is more relevant than Chu and Sherman. EX 2001 ¶44.

The Examiner also relied on Maigret as disclosing “receiving a request to publish the recorded content; in response to the request to publish, processing and encoding individual components of the recorded content to create a streamable video; and publishing the streamable video by copying the streamable video to a media server.” EX1002 at pg. 0083. Maigret therefore discloses the same subject matter of Sherman upon which Petitioner relies. EX 2001 ¶45.

Petitioner contends that:

Joslin teaches a system that “inserts a participant realistically into familiar background media” (e.g., a movie) to create new video content using chroma-key techniques. EX1007, Abstract, 1:61-67. The background media is user-selected from a “digital library.” EX1007, 2:51-59. The “images of a live participant are inserted, real time, as an actor” in the selected background media (EX1007, 3:45-65) and stored for viewing (EX1007, 2:39-44). The recording’s “format and resolution” may be modified “for internet video streaming, and upload[ed] to a server for later download by the participant via the internet.” EX1007, 3:36-44, 10:33-39.

Petition at 22; EX 2001 ¶46.

Petitioner appears to rely on Joslin for essentially the same teachings as Chu, all which were disclosed by Gentile. EX 2001 ¶47. Gentile discloses inserting a participant realistically into a familiar background (*e.g.*, a movie clip) to create a new video content using chroma-key techniques. Gentile at paras. [0010] – [0013], [0059], [0075], and [0163]. Gentile also discloses modifying or editing the new video (para. [0057]), and converting the edited video files to a flash video file, MPEG, JPEG, and/or other file types for viewing at a display or submission to a content sharing website (para. [0090]). Gentile therefore discloses the same subject matter relied upon by Petitioner as being disclosed by Chu, Sherman, and Joslin, and is more relevant than Chu, Sherman, and Joslin. EX 2001 ¶47.

As above, the Examiner also relied on Maigret discloses modifying the video and encoding it to create a streamable video. *Id.*

Petitioner contends that:

Lei teaches adding a trail line showing object movement (*e.g.*, trail lines 17 and 73 in FIG. 18) in a recorded video. EX1008, Abstract, ¶¶[0003], [0111]-[0114].

Petition at 22. Petitioner relies on Lei (Grounds 2 and 4) as allegedly disclosing element [11k] of claim 11 – “detecting user movement in the video captured during

the recording session and representing that movement by a trailing light.” EX 2001 ¶48.

During prosecution, the Examiner relied upon Crawford as disclosing this element. The Examiner stated that Crawford “discloses detecting user movement in the video captured during the recording session and representing that movement by a trailing light (*trail of flames or sparks*) ([0054]). EX1002 at pg. 0089, emphasis in original; EX 2001 ¶49. Crawford discloses “a second object enhancement image may be included in the augmentation images in the form of a trail/trailing image with the controller determining a path traveled or followed by the tracked game object relative to the game surface and then positions the trail image to be mapped to the position of the traveled path (e.g., a series of sparks or flame following a rolling flame ball image projected upon a ball or other game piece).” EX 1032 at para. [0011]; EX 2001 ¶49.

Both Lei and Crawford disclose systems to modify and edit video. Crawford relates to interactive video entertainment (*e.g.*, games) systems, and Lei relates to intelligent video surveillance systems. EX 2001 ¶50. Neither document is particularly relevant to the systems disclosed by Cohen, Chu, Sherman, or Joslin, but Crawford would appear closer to the disclosures of these references by at least disclosing augmenting video in the entertainment field. *Id.* Lei is concerned with

surveillance, and is further afield from the Crawford reference cited by the Examiner. *Id.*

Petitioner contends that:

Austerberry teaches capturing audio/video, encoding it in streamable form (*e.g.*, MPEG), and placing the encoded file on a server for streaming. EX1014, Ch. 1, 4-11, 13. *Austerberry* also teaches improving encoding processes by preprocessing the audio/video signals before encoding (*e.g.*, by adjusting video levels, de-interlacing, cropping, and noise reduction). EX1014, 170-184. EX1003, ¶¶58-59.

Petition at 9.

Gentile discloses the same subject matter as *Austerberry* by disclosing the use of various editing software such as FINAL CUT PRO, PHOTOSHOP, AFTER EFFECTS, ADOBE AUDITION, SOUNDTRACK PRO, and/or the like (para. [0057]), which permit the same pre-processing allegedly disclosed by *Austerberry* (adjusting video levels, de-interlacing, cropping, and noise reduction). *Austerberry* therefore is no more germane to the '911 Patent claims than the prior art cited by the Examiner during prosecution. EX 2001 ¶51.

It is clear from the above summary that the documents relied upon by Petitioner are cumulative of and less relevant than the prior art already considered by the Examiner during prosecution of the '911 Patent. EX 2001 ¶52. Chu,

Sherman, and Joslin, all teach compositing video to allow a user to appear in a background. *See* Petition at 20 (Chu teaches “composit[ing] the background and users’ performance using chroma-key technology), at 21 (Sherman teaches “replacing the clip’s static portions with another background or video. . . video of a user may be captured and used to replace an actor in the clip”), and at 22 (Joslin teaches “insert[ing] a participant realistically into familiar background media. . . using chroma-key techniques.”). *Id.*

This is no different from Gentile, which was cited and evaluated by the Examiner, which discloses “presenting the user with a selection of visual media content for use as a background,” and “generating recorded content based on the recording session by compositing video captured during the recording session with the instance of pre- recorded visual media content.” Ex 1002 at 0082. Indeed, Gentile is more relevant to the Challenged Claims than any of Chu, Sherman, or Joslin because it is a single document that discloses the same subject matter as the cumulative teachings of each of Chu, Sherman, and Joslin. EX 2001 ¶53.

Further, Lei is not materially different from Crawford, which was also considered by the Examiner during prosecution of the ’911 Patent, and which discusses tracking movement of objects. Specifically, Crawford discloses a “tracking system 524 that tracks movement and position of a game object. . .[and]

generates augmentation content or images 528 that are projected by projection system 526.” Crawford [0051]. Indeed, Crawford is more relevant to the Challenged Claims than is Lei because Crawford is at least concerned with entertainment, whereas Lei is a video surveillance system in which tracking movement and positioning serves a substantially different purpose. EX 2001 ¶54.

Finally, Austerberry, which discusses encoding audio/video and making it streamable, is not materially different from Maigret, which was also considered by the Examiner during prosecution of the '911 Patent and also discloses that a media format “may be formatted in a streaming format.” Maigret at [0081]. Thus, Cohen, Gentile, Maigret, *and* Crawford, which were already considered by the Examiner during prosecution of the '911 Patent, disclose the same subject matter as the prior art cited by Petitioner. EX 2001 ¶55.

The third *Becton, Dickinson* factor (c), the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection, strongly favors denial. Cohen, the primary reference relied on by Petitioner, along with Gentile, Maigret, and Crawford were each considered by the Examiner, and serve as the basis for denial. Ex. 1002 at 81, 85, and 87.

The fourth *Becton, Dickinson* factor (d), the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on

the prior art or Patent Owner distinguishes the prior art, also weighs in favor of denial. Cohen, Gentile, Maigret, and Crawford, were distinguished during the prosecution of the '911 Patent, and Patent Owner distinguishes the prior art cited in the Petition in the same or similar manner.

During prosecution of the '911 Patent, the Examiner rejected claims 1-10 as obvious over Cohen in view of Gentile and further in view of Maigret; claim 11 as obvious over Cohen in view of Gentile and further in view of Maigret; and claim 12 as obvious over Cohen in view of Crawford and Maigret. Ex. 1002 at 81, 85, and 87. Patent Owner distinguished the Challenged Claims from the Examiner referenced prior art in an appeal filed November 9, 2020. Ex. 1002 at 51-66. After Patent Owner distinguished its claims from the cited prior art, the Examiner issued a Notice of Allowance. Ex. 1002 at 17 (“Applicant's arguments filed in the Brief of 11/09/2020 have been fully considered. The prior art fail[s] to either disclose or suggest the combination of features as arranged and claimed by applicant.”).

Specifically, after claims 1-10 were rejected, Patent Owner distinguished Cohen, Gentile, and Maigret on the basis that, “None of Cohen, Gentile, or Maigret disclose ‘receiving a request to publish ... [and] in response to the request to publish, processing and encoding ... to create a streamable video,’ either alone or in combination,” “the portions of Cohen the Examiner cites do not disclose or teach a

content creation process as claimed by the Examiner,” and “Cohen does not disclose ‘presenting the user with a record button’ as asserted by the Examiner.” Ex. 1002 at 56, 57, and 58, respectively. Despite this, Petitioner now argues “Cohen teaches receiving a request to publish the recorded content. . . .” “Cohen does teach a ‘content creation process,’” and “Cohen teaches presenting the user with a record button. . . .” Petition at 62, 35, and 43, respectively.

Therefore, Petitioner’s arguments overlap those made during the prosecution of the ’911 Patent, favoring denial.

B. Petitioner Has Not Demonstrated That The Office Erred In A Manner Material To The Patentability Of Challenged Claims (*Becton, Dickinson* Factors (e) And (f)).

Where substantially similar prior art and/or arguments were previously raised before the Examiner, the Petitioner bears the burden of showing how the Examiner erred in his/her consideration of the prior art. *See, e.g., Juniper Networks, Inc.*, IPR2017-00642, Paper 31 at 10-11 (Mar. 14, 2018). The Petitioner must show that the error is clear and material, and if the petitioner fails to show that the Office erred, the Director may exercise his discretion not to institute *inter partes* review. An example of a material error “may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 8.

Petitioner has not met its burden of showing the Office erred in a manner material to patentability. Further, Petitioner's argument that the Cohen specification is similar to that of the '911 Patent is a red herring. Cohen and the '911 Patent are directed to different inventions, have different figures, and have entirely different claims. Further, Petitioner's argument ignores that Cohen was cited by the Examiner, and was used by the Examiner as a grounds for rejection. Further, Patent Owner distinguished Cohen, making Petitioner's attempt to use Cohen to invalidate the '911 Patent by citing similarities in the specifications a needless waste of the Board's resources.

Petitioner provides nothing new from what was already known and considered by the Examiner during prosecution. Petitioner's repeated references to Patent Owner's distinctions from the prior art cited during prosecution as being "wrong" does not rise to the level of showing the Examiner made a mistake. While the Patent Owner was not "wrong" for the reasons set out in Section VI(C) below, Petitioner has presented no evidence that the Examiner was convinced by any allegedly "wrongful" statements or arguments, nor has Petitioner presented evidence that the Examiner did not fully consider all of Cohen's teachings.

In view of the foregoing, it is appropriate for the Board to exercise its discretion under § 325(d) to deny institution because all the *Becton, Dickinson* factors weigh in favor of denying institution.

V. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION PURSUANT TO 35 U.S.C. §314(a)

The Board should also exercise its discretion to deny the Petition under 35 U.S.C. § 314(a) because the *Fintiv* factors weigh in favor of denying institution. Instituting an *inter partes* review would not be an effective or efficient alternative to litigation given the weaknesses in the Petition, the fact that Petitioner has raised the same patentability grounds in the concurrent litigation, and given the advanced stage of the concurrent litigation. *See NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (denying institution under §314(a) where petitioner asserts same prior art and arguments in a concurrent district court proceeding that was in an advanced state, because institution would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court litigation.”) (quoting *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB. Sept. 6, 2017)).

The '911 Patent is asserted in the concurrent litigation, in which trial is currently set for August 13, 2024. (EX1048). As such, the concurrent litigation will

be complete before any final written decision would issue in this proceeding. Further, the prior art references relied on in this proceeding are the same as those asserted by Petitioner in the concurrent litigation, with the sole exception of *Lei*. Additionally, the Challenged Claims are substantially the same in scope as those asserted in the concurrent litigation.

Granting institution in this circumstance would needlessly duplicate the concurrent litigation, and unnecessarily waste the Board's resources. *See NHK Spring Co.*, IPR2018-00752, Paper 8 at 20. For at least these reasons and those further set forth below, the Board should exercise its discretion to deny institution pursuant to §314(a).

A. Application Of The *Fintiv* Factors Weighs In Favor Of Denying Institution.

In *Fintiv*, the Board identified factors relating to “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding,” each of which supports denial here. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020). The *Fintiv* factors include: (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (2) proximity of the court's trial date to the Board's projected statutory deadline for a final written decision; (3) investment in the parallel proceeding by the court and the parties; (4) overlap

between issues raised in the petition and in the parallel proceeding; (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and (6) other circumstances that impact the Board's exercise of discretion, including the merits. *Id.* As set forth below, a balancing of these factors demonstrates that efficiency and integrity of the AIA are best served by denying institution.

1. *Fintiv* Factors 1 & 2 Favor Denying Institution: The Court Has Not Entered A Stay, And Trial Is Scheduled To Begin Before A Final Written Decision Is Due

Petitioner has not filed a motion to stay, and has given no indication that it intends to do so. As such, this factor currently favors denial of institution. Even if the District Court were to grant a stay of the case, the other *Fintiv* factors discussed below, individually and collectively, weigh in favor of the Board exercising its discretion to deny institution pursuant to § 314(a).

Currently, trial in the concurrent litigation is set for August 13, 2024. As such, the concurrent litigation will resolve the validity and infringement issues concerning the '911 Patent before a final written decision in this *inter partes* review is due. This factor weighs heavily in favor of the Board exercising its discretion to deny institution pursuant to § 314(a). "If the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*." *Fintiv*, IPR2020-00019, Paper 11 at 9.

2. *Fintiv* Factor 3 Favors Denying Institution: The Parties Have Made Significant Investments In The Concurrent Litigation

The parties have been actively litigating the concurrent litigation for well over a year (since August 24, 2022), and have exchanged infringement and invalidity contentions (which include detailed claim charts that address the same prior art cited in the Petition), have engaged in discovery, have fully briefed a motion to dismiss on Section 101 grounds, have fully briefed the claim construction issues, and have each created and presented a technology tutorial for use by the Court in connection with its claim construction hearing. In summary, this lawsuit has been actively litigated for over a year during which time both parties have made significant investments with respect to time and resources in prosecuting their claims and defenses as described above. As such, *Fintiv* Factor 3 weighs in favor of the Board exercising its discretion to deny institution pursuant to § 314(a).

3. *Fintiv* Factors 4 & 5 Favor Denying Institution: Petitioner Is The Defendant In The Concurrent Litigation, And The Issues Substantially Overlap Between The Petition And The Concurrent Litigation

Petitioner asserts four grounds in its Petition, all based on the same primary reference: *Cohen*, in combination with *Chu*, *Sherman*, *Joslin* and *Austerberry* for Claims 1-10 and *Cohen* in combination with *Chu*, *Sherman*, *Joslin*, *Austerberry*, and *Lei* for Claim 11. With the exception of *Lei*, the Petitioner asserted the exact same

prior art against Patent Owner in the concurrent litigation. As such, there is a substantial overlap of the issues raised in the Petition and the concurrent litigation. Additionally, Petitioner is the sole defendant in the concurrent litigation, and no other party has been sued for infringement of the '911 Patent.

As such, *Fintiv* Factors 4 and 5 weigh in favor of the Board exercising its discretion to deny institution pursuant to § 314(a).

4. *Fintiv* Factor 6 Favors Denying Institution: Petitioner's Delay In Filing The IPR Petition, The Lack Of Merit Of The Grounds Asserted, And Other Circumstances

As explained in Section IV above and Section V.A.1I below, the Petition lacks merit and relies upon the same primary reference that was previously before, and substantively evaluated by, the Office during prosecution of the '911 Patent. Petitioner's attempt to raise the same prior art previously evaluated by the Office in front of the district court in the concurrent litigation and the Board compounds the inefficiencies created by this Petition and further warrants denial.

The efficient resolution of patent challenges is foundational to the *inter partes* review system and the America Invents Act ("AIA") generally—it is “an objective of the AIA . . . to provide an effective and efficient alternative to district court litigation.” *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017). This objective is frustrated when, as here,

a party delays filing a petition until such time that the *inter partes* review, if instituted, would result in a final written decision only after the overlapping validity issues have been resolved by a district court. *See NHK Spring*, IPR2018-00752. Such tactics also needlessly consume the finite resources of the Board. *Gen. Plastic*, IPR2016-01357, Paper 19 at 16-17.

As such, *Fintiv* Factor 6 weighs in favor of the Board exercising its discretion to deny institution pursuant to § 314(a).

VI. THE PETITION SHOULD BE DENIED UNDER 35 U.S.C. § 314(a) FOR FAILING TO DEMONSTRATE A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY CHALLENGED CLAIM

The PTAB should further deny institution because Petitioner's obviousness analyses set forth in Grounds 1-4 are fundamentally flawed. Petitioner has not carried out a proper analysis under *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966) because it has failed to adequately inform Patent Owner and the PTAB what the differences are between the cited prior art and the present claims, and/or how those differences are met or otherwise satisfied by any of the multiple secondary references cited. The Petition's deficiency in this regard is exacerbated by Petitioner's definition of the term "teaches," as including actually disclosing, or suggesting, or rendering obvious. Petition at pg. 33, fn 3. This leaves the Board and the Patent Owner guessing as to whether Petitioner is contending: (i) the primary

reference, Cohen actually discloses a feature or element of the claim; (ii) the prior art suggests or renders obvious a feature or element of the claim; or (iii) the prior art does not disclose or suggest or render obvious a feature or element of the claim, and a secondary reference is relied upon to satisfy that feature or element.

The Petition raises even more questions in its obviousness analyses by first describing the combination of prior art, and then later addressing the various embodiments of the claims. For example, in Section VII(A)(1), Petitioner describes how Cohen is to be combined with various secondary documents, but does not point out why the combination is needed, or what specific element or feature of the claim the combination purports to satisfy. Ground I appears to be based on the combined teachings of Cohen in view of Chu, Sherman, and Joslin, yet this section VII(A)(1) only addresses the combination of these four documents at pages 30 and 31. Prior to that discussion, the combinations addressed by Petitioner are:

- Cohen in view of Chu (with or without Sherman/Joslin) – is this a combination of only Cohen and Chu, or Cohen, Chu, and Sherman, or Cohen, Chu, and Joslin, or Cohen, Chu, Sherman and Joslin? If the Ground of unpatentability is premised on the combination of all 4 documents, then it is improper to combine just two, or three of the documents without considering the disclosure of the other documents, which may or may not teach away from the combination. Petition at 28 and 29;

- Cohen in view of Chu and Sherman (with/without Joslin) – is this a combination of only Cohen, Chu, and Sherman, or Cohen, Chu, Sherman and Joslin?

The PTAB and Patent Owner should not be forced to read Petitioner’s mind as to what prior art is being cited as its basis to render obvious the Challenged Claims, how all of the prior art is to be combined, and what features or embodiments of the claims do the various proposed combinations address.

The alleged rationale for each combination appears to be the same, and repeated for each purported combination:

In combination, these teachings would have provided an improved multimedia-creation system with additional user-selectable content (*e.g.*, user-selectable backgrounds) and compositing functionality. *Id.* A POSITA would have understood these additions were desirable by 2009-2010. *Id.*

Petition at 29, (twice), 30, and 31. Different words are used in the paragraphs on pages 29, 30, and 31, but the rationale is the same. That is, Petitioner contends that the combination would have been made to provide an “improved” system, with additional functionality, and that the improvement or additional functionality was desirable. Glaringly absent from Petitioner’s reasoning for the multiple combinations is any discussion as to why Cohen requires any such modification in

the first place, how the combination would have been made without disrupting the purpose and function of Cohen, how the combination “improves” Cohen’s system, or why the combination would have been desirable without any discussion of any deficiency of Cohen (or difference between Cohen and the Challenged Claims).

The Supreme Court made it clear in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) that the analysis as to whether there is any apparent reason to combine the prior art to arrive at the claimed invention must be made explicit, *citing In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). *KSR Int’l Co.*, 550 U.S. at 502. Petitioner’s apparent reason to combine the prior art, which prior art is being combined, and which element or feature of the Challenged Claims is satisfied by the combination is not explicitly set forth in the Petition. Patent Owner is at a severe disadvantage as to how to address the obviousness contentions set out in Grounds 1-4, and should not be forced to guess how the art is combined, what the differences are between the prior art and the challenged claims, and why Petitioner contends those differences would have been satisfied by its proposed combination.

Finally, the Petition is littered with underlining, giving the appearance that the underlined text is taken directly from the referenced document. Instead, the underlined text is Petitioner's and/or its expert's argument, and in most if not all instances, the actual terms and phrases in the underlined text cannot be found in the referenced prior art. The underlined text is purposefully misleading and makes it nearly impossible for the reader to know whether the text is actual documentary disclosure, or Petitioner's spin on what the respective document discloses. The issue is exacerbated by the fact that after the underlined passages, Petitioner cites to, in some cases, dozens of paragraphs of one or more documents and its expert's report.

For at least these additional reasons, the Board should deny institution.

A. Petitioner Has Not Conducted A Proper Obviousness Analysis Of The Challenged Claims.

As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Supreme Court are as follows:

- (A) Determining the scope and content of the prior art;
- (B) Ascertaining the differences between the claimed invention and the prior art; and

- (C) Resolving the level of ordinary skill in the pertinent art.

383 U.S. at 17; MPEP §2141(II).

1. The Petition Does Not Adequately Inform The Reader Of The Basis For Each Ground Of Unpatentability

Section VII(A)(2) of the Petition addresses independent claim 1, and discusses each element thereof. For each and every element of the claim, Petitioner simply states that the “*Cohen/Chu/Sherman/Joslin* combination ***teaches***” that particular element, “rendering it obvious, because” Petition at 33, 34, 35, 39, 43, 45, 46, 52, 56, 58, 60, 62, 65, and 70, italics in original, bold and italic emphasis added, referencing elements [1a] – [1s]. Petitioner defines “teaches” as “‘teaches or suggests,’ or otherwise renders obvious” at footnote 3 on page 33.

It is not clear from the Petition, however, whether all four documents must be combined to satisfy each separate element of the claim. In fact, all four documents are not discussed with respect to nearly every element of the claim. The following lists the inconsistencies between the first sentence beneath each claim element header (quoted above) that states all four documents “teach” the element, and the actual discussion of that element:

1. Element [1b] – no discussion of Joslin;
2. Element [1c] – no discussion of Chu or Joslin;
3. Element [1d] – no discussion of Sherman or Joslin;
4. Element [1e] – no discussion of Chu or Joslin;

5. Element [1f] – no discussion of Joslin;
6. Element [1i] – no discussion of Sherman or Joslin;
7. Element [1l] – no discussion of Chu, Sherman, or Joslin;
8. Element [1n] – no discussion of Chu, Sherman, or Joslin;
9. Element [1o] – no discussion of Chu;
10. Element [1s] – no discussion of Chu.

Patent Owner cannot adequately address the Petitioner's proposed combination without knowing what art Petitioner relies on to satisfy the respective features of the claims. For example, does Patent Owner have to address each of Cohen, Chu, Sherman, and Joslin when discussing, for example, element [1l] or [1n], or just Cohen? The first sentence in Petitioner's analyses for each of claim features [1l] and [1n] begins by stating that Cohen, Chu, Sherman, and Joslin teach that feature, but then only Cohen is discussed with respect to each feature. The Petition should be denied for failing to adequately inform the Board or the Patent Owner the basis for each Ground of unpatentability.

2. The Petition Ignores The Differences Between The Prior Art Cited And The Claims

Despite relying on combinations of from 4 to 6 different references, the Petition never sets forth the differences between the primary reference, Cohen, and the Challenged Claims. In fact, Petitioner never admits that there are any differences between what Cohen "teaches" and the Challenged Claims, but yet does not advance

an anticipation argument, or an obviousness argument based solely on Cohen. To complicate matters even more, Petitioner loosely defines the term “teaches” and leaves it to the Board and the Patent Owner to guess whether the document being discussed: (a) actually discloses what Petitioner contends it “teaches;” (b) “suggests” what Petitioner contends it “teaches;” or (c) “renders obvious” what Petitioner contends it “teaches.” These are very different things, and require entirely different proofs to establish whether a document “discloses” a claimed element, or whether a document “renders obvious” a claimed element. By simply contending that a document “teaches” an element of the claims, and loosely defining “teaches” as Petitioner has done here, Petitioner has failed to satisfy its burden of showing a reasonable likelihood of prevailing on any of proposed Grounds of unpatentability.

In addition, in addressing the differences the Examiner has already admitted exist between Cohen and the respective claim elements, Petitioner simply presents a number of *ad hominem* attacks on Patent Owner, alleging Patent Owner was somehow “wrong” to agree with the Examiner. Petitioner then fails to acknowledge whether any difference actually exists, and instead, in each instance, simply states: “Moreover, even if Cohen were deficient (it isn’t), [secondary reference(s)] teach [the element].” Petition at 35, 38, 42, 44, 51, 64, and 69. If Cohen were not deficient and actually disclosed (not “teaches” as Petitioner loosely uses that term) a given

element of the claim as Petitioner contends throughout its obviousness analysis (*i.e.*, element [1b]), then why is any secondary document needed?

In other words, if Cohen discloses initiating a content creation process in response to a request from a user, as Petitioner contends it “teaches” (*id.* at 34-36), why go to the trouble of modifying Cohen by using Chu’s or Sherman’s initial instructions on a start screen? Moreover, if Cohen discloses prompting the user to record content, as Petitioner contends it “teaches” (*id.* at 36-38), why modify Cohen by using Sherman’s alleged disclosure of prompting users to pick movies? *Id.* at 38. Picking a movie as in Sherman is not a prompt to record content.

3. The Petition Does Not Articulate Any Reason Why The Prior Art Would Have Been Combined, Other Than To State The Secondary Reference(S) Teach The Feature Of The Claim

Section VII(A)(2) of the Petition constitutes the majority of Petitioner’s discussion of the features recited by the Challenged Claims. In each instance in which a combination of references is discussed, Petitioner fails to disclose how the references would have been combined. While the previous section of the Petition (Section VII(A)(1)) discussed in general how different documents were to be combined, there was no discussion regarding why the combination was needed or what claim feature was addressed by the combination. Patent Owner cannot

determine whether the generic combinations disclosed in Section VII(A)(1) apply to any of the specific combinations discussed later in Section VII(A)(2).

Indeed, the bases for the combinations of prior art set forth in Section VII(A)(1) of the Petition do not correlate with the various combinations discussed in Section VII(A)(2). For example, Petitioner combines at least Cohen with Chu and Sherman to satisfy feature [1b] of claim 1 (Petition at 35) and combines Cohen with Sherman to satisfy feature [1c] (*id.* at 38). The only reason for the proposed combinations set forth in the Petition is because the secondary references “teach” the respective feature [1b] or [1c]. *Id.* at 35 and 38. But when discussing how or why the prior art should be combined in the previous Section VII(A)(1), the Petition is devoid of any discussion of: (a) how or why Chu’s and Sherman’s disclosure of a start screen that contains initial instructions would have been combined with Cohen (feature [1b]); or (b) how or why Sherman’s disclosure of a start screen prompting users to pick movies would have been combined with Cohen, (feature [1c]). Indeed, Section VII(A)(1) of the Petition does not mention Chu or Sherman’s disclosure of a start screen, or Sherman’s disclosure of a start screen prompting users to pick movies. *Id.* at 28-30.

In a similar manner, Petitioner relies on the combination of at least Cohen and Chu to satisfy the feature of claim [1i], which recites providing simultaneous aural

playback of the audio composition during a recording session. *Id.* at 51-52. But when discussing how or why the prior art should be combined in Section VII(A)(1), Petitioner does not describe how or why Chu’s alleged disclosure of playing the selected, chosen musical composition would have been combined with Cohen, (feature [1i]). *Id.*: 28-29. As noted previously, when Petitioner discusses combining prior art with respect to a particular claim feature, the Petition simply states: “Moreover, even if Cohen were deficient (it isn’t), [secondary reference(s)] teach [the element].” *Id.* at 35, 38, 42, 44, 51, 64, and 69. Petitioner provides no analysis as to why the alleged disclosure of the secondary reference would have been combined with Cohen, or how the disclosures would have been combined.

The mere identification that a document discloses a certain feature or element recited by a claim is insufficient to establish that a person having ordinary skill in the art would have found it obvious to modify a primary reference to include that feature. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998):

As this court has stated, ‘virtually all [inventions] are combinations of old elements.’ *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 U.S.P.Q. 8, 12 (Fed. Cir. 1983) (‘Most, if not all, inventions are combinations and mostly of old elements.’). Therefore an examiner may often find every element of a claimed invention in the prior art. If

identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’ *Sensonic, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed. Cir. 1996).

149 F.3d at 1357.

Petitioner’s obviousness analyses for each of Grounds 1-4 is similar to the obviousness analysis the Federal Circuit found deficient in *In re Rouffet*. Petitioner’s analyses for most of the elements of independent claim 1 set out in Section VII(A)(2) of the Petition merely contends what the prior art “teaches.” Petitioner has failed to establish a reasonable likelihood of prevailing on any of Grounds 1-4 and the Board should deny institution.

B. Petitioner’s Reliance On Portions Of Cohen Allegedly Copied By Patent Owner Is Misplaced.

Petitioner repeatedly contends that Patent Owner “copied” portions of Cohen in the ’911 Patent, attacking Patent Owner as a “copyist that invented nothing,” and contending that the patent agent who drafted the ’911 Patent’s disclosure “copied from Cohen” and then “hid that fact from the Examiner(s).” Petition at 7, 17, 18. It

is common practice for patent practitioners to copy disclosures from prior art, especially when it is background information well-known to a person of ordinary skill in the art. Indeed, the Federal Circuit found this practice to be acceptable in *United Cannabis Corporation v. Pure Hemp Collective Inc.*, Appeal No. 2022-1363 (Fed. Cir. May 8, 2023).

Patent Owner does not deny that there are common disclosures in both the '911 Patent and Cohen, but there are significant differences when it pertains to the language recited by the Challenged Claims. Some common disclosures include the boilerplate language at the beginning and end of the detailed description. Other common disclosures with some overlap include:

1. the description of the audio recording feature (EX 1001: 4, ll. 5-21), which is well-known in the art;
2. The network and communications over the network (EX 1001: 5, l. 48 to col. 6, l. 25), which exists nearly verbatim in numerous other patents (US 8,782,222; 10,187,461), all prepared and filed by the same firm;
3. The recording engine description (EX 1001: 8, ll. 36-52), features well known in the art;
4. The timer module and the preview module, also features well known in the art;
5. The host server (EX 1001: 10, ll. 41-50), another well-known feature; and

6. Audio/multimedia repository module and user interface (EX1001: 10, l. 61 to col. 12, l. 25), again all of which are well known.

Petitioner admits that much of the disclosure that is common to both Cohen and the '911 Patent are well known. Petition at 7-10, 16, 17, among others. The common subject matter includes matter well known in the art.

In discussing some of the features of independent claim 1, the last paragraph in Petitioner's discussion of the respective feature states that the respective element's "functionality was generally known," and then contends that Patent Owner relied on certain paragraphs of the '911 Patent as support for the respective element, and that those paragraphs "include material copied from Cohen." Petition at 33, 34, 36, 38, 42, 45, 52, 58, 59, and 62. Petitioner does not provide any specific citation to what material was allegedly "copied from Cohen," but only states that certain paragraphs "include" material copied. Moreover, even if Petitioner were correct in each instance, there are 5 or 6 features of the claims in which Petitioner does not contend "include material copied from Cohen."

In at least one instance, and likely more, Petitioner's allegation regarding material copied from Cohen is not accurate. Petitioner contends that "Patent Owner identified its ¶¶[0058] and [0088] as supporting [1n] (EX1002, 53), which include material copied from Cohen (see EX1004, ¶¶[0039], [0140])." Petition at 62. Patent

Owner reproduces paragraphs [0058] and [0088] from the '911 Patent's originally filed application, and paragraphs [0039] and [0140] from Cohen below.

Paragraphs [0058] and [0088] from the '911 Patent

[0058] The host server **121** is, in some embodiments, able to communicate with client devices **101-103** via the network **110**. In addition, the host server **121** is able to retrieve data from the user database **122** and the content database **125**. In some embodiments, the host server **121** is able to facilitate the generation of audio and video content, multimedia-content sharing over a network (e.g., the network **110**) among various users of the client devices **101-103**. The host server **121** can store multimedia content to be provided to other users, for example, for on-demand audio and/or video playback and recording. For example, users can listen to audio content or view video content shared by other users. Users can also, in some embodiments, record voice or audio recordings over pre-recorded compositions comprising of beats or melodies- otherwise known as generating audio content. These compositions may be provided by other users stored on the host system over a network. These recording sessions can be conducted in real-time or near real-time as the user is generating the audio or video content, for example.

EX1002, pg 153.

[0088] One embodiment of the present disclosure includes a sharing module **224**. The sharing module **224** can be any combination of hardware components and/or software agents able to manage, track, modify, and/or enforce the privacy attributes of audio content. The sharing module **218** may receive commands related to privacy attributes of user content. The multimedia content owner (e.g., recording user of an audio or video content, etc.) typically has the ability to set the privacy attributes of owned content. The multimedia content may be shown on the user's public profile or kept as a private draft, etc., with further reference to **FIG. 15**.

Id. at 161.

Paragraphs [0039] and [0140] from Cohen

[0039] In one aspect, the present disclosure relates to recording an audio track or video content over a network, in some instances, in real-time or in near real-time.

EX1004, ¶[0039].

[0140] After the recording session, the recording user is presented with the options of previewing the recording mixed with the selected multimedia content (e.g., a selected beat), re-recording the audio or video content, and/or saving the mixed multimedia content. In one embodiment, when the user saves the recorded content, the recorded content is published and listed as a challenge to the original content. Tracks that are challenges to one another may be displayed and indicated as such that users can browse different vocal expressions or physical gestures (e.g., rap, sing, etc.) recorded over the same beat or the same multimedia content. Perusing users can comment as well as rate the challenges.

Id at ¶[0140].

A cursory comparison of these paragraphs reveals that there is no subject matter copied, and that these portions of Cohen clearly do not disclose claim feature [1n].

C. Petitioner’s Repeated Statements That Patent Owner Was “Wrong” Are Not Warranted And Unfounded

Section III(C) of Petition states:

Patent Owner's Appeal Brief argued *Cohen* (and *Gentile*, *Crawford*, and *Maigret*) failed to teach [1b], [1e], [1i], and [1r]. EX1002, 57-58. But, as discussed in those elements below, PO's arguments were wrong as to *Cohen* and/or failed to acknowledge the claimed elements were well-known to POSITAs by 2009-2010.

Petition at 16. With respect to the last portion of the second sentence, Patent Owner is under no obligation, duty, or otherwise to acknowledge that any claimed element was well-known, especially if the element was not known to Patent Owner at the time. Indeed, whether one or more, or in fact all of the claimed elements were well-known to a POSITA does not resolve the obviousness issue. Most, if not all, inventions are combinations and mostly of old elements. *In re Rouffet*, 149 F.2d at 1357; *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80 (Fed. Cir. 1983). Even if known, there must be some reason to combine the known elements to arrive at the claimed invention, and the mere identification of a claim element as known in the art is insufficient. *Id.*

With respect to Petitioner's contentions that Patent Owner was "wrong" or Patent Owner's "arguments were wrong," Patent Owner addresses them in turn below.

Claim [1b]

Patent Owner wrongly argued during prosecution that *Cohen* doesn't teach [1b] because it's missing a "content creation process" and therefore cannot teach "initiating" it. EX1002, 57. EX1003, ¶232. But *Cohen* does teach a "content creation process." See [1c]-[1s]. EX1003, ¶233. The distinction Patent Owner argues (*Cohen*'s videos are only for playback during audio recording) is baseless, as *Cohen* teaches audio *and* video recording during audio playback.

Petition at 35.

Patent Owner argued that the "portions of *Cohen* the Examiner cited do not disclose or teach a content creation process as claimed by the Applicant." EX1002, 57. Petitioner has not shown that this statement is "wrong," but rather Petitioner and its expert refer to unrelated portions of *Cohen* that were not cited by the Examiner as allegedly disclosing this element, and that are not relevant to the claimed feature.

Claim [1e]

Patent Owner wrongly argued during prosecution *Cohen* doesn't teach [1e]. EX1002, 58. EX1003, ¶278. Patent Owner misrepresented *Cohen*, which repeatedly teaches [1e] per the above. EX1003, ¶279.

Petition at 44.

Here again, Patent Owner argued during prosecution that the portion of *Cohen* relied upon by the Examiner, paragraph [0174] did not disclose "presenting the user

with a record button.” EX1002, 58. Patent Owner did not argue or otherwise contend that Cohen did not disclose a record button, but rather made the distinction that the claim requires “presenting a record button,” and that a physical (or virtual) button that is already present on a device, has not been “presented” to a user. *Id.* The portions of Cohen relied upon by Petitioner and its expert all concern paragraphs not relied upon by the Examiner, and all concern buttons that are already present on the interface. In other words, they were not “presented” to the user in the context of the challenged claims.

Claim [1i].

Patent Owner wrongly argued during prosecution *Cohen* doesn’t teach [1i]. EX1002, 58. EX1003, ¶306. Patent Owner misrepresented *Cohen*, which teaches [1i] per the above. EX1003, ¶307. *Cohen*’s video recording functionality is not limited to the “challenge” embodiments (as Patent Owner argued); *Cohen* repeatedly teaches video recording functionality throughout, and teaches combining its embodiments with each other. *See, e.g.*, EX1004, ¶[0217]. EX1003, ¶307.

Petition, 51.

Petitioner again mischaracterizes Patent Owner’s prosecution arguments. Patent Owner stated that the paragraph relied upon by the Examiner, para. 0074, “provides only that the recording engine can perform simultaneous aural playback

of a beat to the recording user during a recording session *when the recording user has requested to record over a beat.*” EX1002, 58, emphasis in original. Patent Owner further argued that the competition module of Cohen, while recording video during audio playback, does not use audio (“the audio composition”) that was prompted to the user to select. *Id.* at 58, 59.

Petitioner relies on paragraph [0217] of Cohen to support its argument that Cohen teaches combining its embodiments with each other. But Petitioner fails to articulate how or why the various embodiments of Cohen can or would have been combined, or which embodiments would have been combined with which embodiments. In one embodiment of Cohen, a user selects an audio component from a list, and then the selected audio component is played back (*e.g.*, audible) during an audio recording session to record and mix a user’s recording with the selected audio component. EX1004, ¶[0074]. In an entirely unrelated embodiment, Cohen discloses a competition module in which a challenger track is generated by recording a user’s voice over a beat. *Id.* at ¶[0114]. The challenge track may be combined with a video or image, but not a video or image generated by the user. During the challenge, a challenger, who is not the user, can record video during the recording session. *Id.* Petitioner fails to disclose how a person having ordinary skill in the art would have combined, for example, the competition or challenge embodiment of

Cohen, with other embodiments of Cohen, and/or what would result from that combination.

Petitioner contends that a video recording session initiated from a challenge button is no different from one initiated by the record button in Cohen; both processes record video over underlying compositions as they are playing. Petition at 51. Petitioner fails to appreciate that this claim feature provides aural playback of a specific audio composition by virtue of the definitive article “the” before “audio composition.” This claim feature refers back to the previously recited claim feature that requires the user to “select an audio composition from a list of compositions retrieved from a host server.” The audio that is played during the challenge session of Cohen is not an audio composition selected from a list of compositions retrieved from a host server, as required by the claims. Patent Owner is unaware of how any other embodiments of Cohen could be combined with this challenge session embodiment of Cohen to modify the challenge session embodiment in a manner that satisfies the features of the claims.

Element [1r]

Patent Owner wrongly argued during prosecution that Cohen doesn’t teach [1o]-[1s]. EX1002, 56-67. EX1003, ¶391. Per the above, a POSITA would have understood Cohen to teach [1r], or would have considered such functionality obvious.

Petition at 68, 69.

Petitioner mischaracterizes Patent Owner's arguments, which again were directed to the specific disclosures of Cohen relied upon by the Examiner. Nor does Petitioner show where Cohen discloses receiving a request to publish (Petitioner refers to a user's request to share already published content, not a request to publish it), much less creating a streamable video in response to such a request. Cohen requires a specialized widget interface to accompany any of the content generated from its system, such that any user without that interface will not be able to play it.

D. Petitioner's Analysis Of Claims 2-11 In Each Ground Is Flawed For The Same Reasons Discussed Above

Most of the Petition is devoted to addressing the features of independent claim 1 (pages 32-73) with respect to Ground 1. Petitioner has failed to establish a reasonable likelihood of success in showing that claim 1 would have been obvious in view of the art cited in Ground 1, for the reasons stated in Sections A-C above. Petitioner likewise fails to establish a reasonable likelihood of success in showing that claims 2-10 would have been obvious in view of the art cited in Ground 1, that claim 11 would have been obvious as alleged in Ground 2, and that claims 1-11 would have been obvious as alleged in Grounds 3 and 4.

Petitioner's analysis of claims 2-11 set out on Pages 73-87, and its one paragraph analysis of Grounds 3 and 4 on pages 87-88 suffer from same infirmities

discussed above with respect to the analysis of Ground 1, independent claim 1. For example, the Petition ignores the differences between the cited art and the features recited by dependent claims 2-11, and further fails to provide any rationale or reason for combining the art in the manner alleged to arrive at the features of the claims. In addition, the Petition states in the first sentence addressing each of claims 2-9 that the “Cohen/Chu/Sherman/Joslin combination ‘teaches’ Claim [].” Petition, 73-79. For dependent claims 2-9, the Petition then simply contends that certain prior art, not all 4 references relied upon in the proposed Ground, “teaches” the feature recited by the dependent claim. Even if true, merely identifying that a document discloses a certain feature or element recited by a claim is insufficient to establish that a person having ordinary skill in the art would have found it obvious to modify a primary reference to include that feature. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998).

With respect to independent claim 10, Petitioner relies on the same fundamentally flawed analysis discussed above with respect to independent claim 1. For the features of independent claim 10 that are not present in independent claim 1, Petitioner addresses these features in the same manner as it addressed the dependent claims 2-9. That is, the Petition states in the first sentence addressing features [10p] and [10q] that the “Cohen/Chu/Sherman/Joslin combination ‘teaches’ [],” (Petition, 82 and 83), and then simply contends that certain prior art, not all 4 references relied

upon in the proposed Ground, “teaches” the feature recited by the particular claim feature. As stated previously, this is insufficient to establish obviousness.

Ground 2 is discussed at pages 83-87 of the Petition, where the combination of prior art from Gound 1 is also combined with Lei. Petitioner fails to carry out a proper obviousness analysis by, *inter alia*, failing to set forth the differences between the prior art and the claim feature at issue, and failing to provide a rationale or reason for combining the art in the manner alleged to arrive at the features of the claims. While the first paragraph of this section discusses the combination of all 5 references in general, there is no discussion of combining all 5 references with respect to the features of claim 11 that are addressed here.

Petitioner relies on the same fundamentally flawed analysis discussed above with respect to independent claim 1 for features common to both claims 1 and 11. For the features of independent claim 11 that are not present in independent claim 1, Petitioner addresses these features in the same manner as it addressed the dependent claims 2-9. That is, the Petition states in the first sentence addressing features [11k] that the “Cohen/Chu/Sherman/Joslin/Lai combination ‘teaches’ [11k],” (Petition, 85), and then simply contends that certain prior art, not all 5 references relied upon in the proposed Ground, “teaches” [11k]. As stated previously, this is insufficient to establish obviousness.

It is unclear to Patent Owner how Lei's intelligent video surveillance system features would be relevant at all to Cohen's system for recording over an audio track. Detecting movement in Lei's video surveillance system serves a valuable purpose that is irrelevant in Cohen's system. Petitioner simply contends that a skilled artisan "would have understood the addition of more user-editing capabilities was recognized as desirable," (Petition at 84, *citing* EX1003, ¶¶511-512), and contends that a POSITA would have been motivated to combine the prior art "to provide a system with additional special effect options." Petition at 84, *citing* EX1003, ¶¶514-517. Claim feature [11k] does not generically recite an "additional special effect," but rather recites "detecting user movement in the video captured during the recording session and representing that movement by a trailing light." EX1001, at 22: 32-34. Petitioner does not address why the addition of showing movement by a trailing light would be desirable in Cohen's system, even if the addition of more user-editing capabilities were desirable. It is the claimed feature, not some generic, unknown feature that is relevant to the obviousness analysis.

Finally, Petitioner's one paragraph discussion of Grounds 3 and 4 is deficient for the same reasons discussed above. These Grounds are identical to Grounds 1 and 2, but each relies on the additional document to Austerberry. Petitioner relies on Austerberry as allegedly disclosing "pre-processing and encoding steps (which

teach two separate steps, *see* [1r]),” and contends that combining Austerberry with Cohen/Chu/Sherman/Joslin’s MPEG conversion process would be made “to provide improved conversion.” Petition at 87. Petitioner does not disclose what that improvement might be, or how Austerberry’s conversion process disclosed 7 years before Cohen could improve Cohen’s conversion process in the rapidly advancing field of video compression technology.

For the foregoing reasons, Petitioner has failed to establish a reasonable likelihood of prevailing on any of Grounds 1-4 and the Board should deny institution.

VII. CONCLUSION

For the reasons presented above, the Board should deny institution.

Dated: September 14, 2023

Respectfully submitted,

/Patrick A. Doody/

Patrick A. Doody (Reg. No. 35,022)

Pillsbury Winthrop Shaw Pittman LLP

1650 Tysons Boulevard

McLean, VA 22102

Telephone: (703) 770-7755

patrick.doody@pillsburylaw.com

Christopher Kao (*pro hac vice* to be filed)

David J. Tsai (*pro hac vice* to be filed)

Pillsbury Winthrop Shaw Pittman LLP

Four Embarcadero Center, 22nd Floor

San Francisco, CA 94111

Telephone: (415) 983-1000

christopher.kao@pillsburylaw.com
david.tsai@pillsburylaw.com

Counsel for Patent Owner
Playvuu, Inc.

CERTIFICATE OF COMPLIANCE

1. The undersigned certifies that this brief complies with the type volume limitations of 37 C.F.R. § 42.24(a)(1)(i). This paper contains 11,509 words (excluding table of contents, table of authorities, certificate of service, certificate of compliance, and table of exhibits) as calculated by the word count feature of Microsoft Word, the word processing program used to create it.

2. The undersigned further certifies that this paper complies with the typeface requirements of 37 C.F.R. § 42.6(a)(2)(ii) and typestyle requirements of 37 C.F.R. § 42.6(a)(2)(iii). This paper has been prepared in a proportionally spaced typeface using Microsoft Word in Times New Roman 14-point font.

Dated: September 14, 2023

Respectfully submitted,

/Patrick A. Doody/

Patrick A. Doody (Reg. No. 35,022)

Pillsbury Winthrop Shaw Pittman LLP

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of **PATENT OWNER'S PRELIMINARY RESPONSE** is being served by electronic mail this 14th day of September, 2023, on the following counsel of record:

Lead Counsel

Daniel Yannuzzi
SHEPPARD, MULLIN, RICHTER &
HAMPTON LLP
12275 El Camino Real, Suite 100
San Diego, CA 92130

Email: LegalTm-
Snap-IPR@sheppardmullin.com

Back-Up Counsel

Timothy Cremen
Eric Gill
SHEPPARD, MULLIN, RICHTER &
HAMPTON LLP
12275 El Camino Real, Suite 100
San Diego, CA 92130

Email: LegalTm-
Snap-IPR@sheppardmullin.com

Dated: September 14, 2023

Respectfully submitted,

/Patrick A. Doody/
Patrick A. Doody (Reg. No. 35,022)
Pillsbury Winthrop Shaw Pittman LLP