

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Inter Partes Review No.: IPR2023-00976

**REPLY DECLARATION OF DR. KEVIN JEFFAY IN SUPPORT OF
PETITIONER DISH NETWORK L.L.C.'S
PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 8,929,710**

I, Kevin Jeffay, declare as follows:

1. I make this declaration based upon my own personal knowledge and, if called upon to testify, would testify competently to the matters stated herein.

2. I have been asked by DISH Network L.L.C. to provide technical assistance in connection with the *inter partes* review of U.S. Patents No. 8,929,710 and 9,538,122 (which I refer to as the “’710 Patent” and “’122 Patent,” respectively). Specifically, this declaration is provided in response to issues put forth within either or both of “PATENT OWNER’S RESPONSE TO THE PETITION FOR INTER PARTES REVIEW OF U.S. PATENT NO. 8,929,710 PURSUANT TO 37 C.F.R. § 42.120” (“Patent Owner Response”) and “DECLARATION OF IMMANUEL FREEDMAN IN SUPPORT OF DIGITAL BROADCASTING SOLUTIONS, LLC’S PATENT OWNER RESPONSE” (“Freedman Declaration” or Ex. 2006).

3. I have previously set forth my opinions and the bases thereof in my previous declaration entitled “DECLARATION OF DR. KEVIN JEFFAY IN SUPPORT OF PETITIONER DISH NETWORK L.L.C.’S PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,929,710” (“Jeffay Declaration” or Ex. 1002).

4. In this reply declaration, I incorporate the entirety of the Jeffay Declaration as the basis for my opinion expressed herein. To the extent that any supplemental opinions and bases thereof are provided herein, this is only in response

to certain erroneous rebuttal positions that I have observed within any of the Patent Owner Response, the Freedman Declaration and/or the “Oral deposition of IMMANUEL FREEDMAN, Ph.D.” taken Apr. 25, 2024 (“Freedman Transcript”).

5. I have concluded that nothing within any of the Patent Owner Response, the Freedman Declaration or the Freedman Transcript causes my opinion to change regarding invalidity of the ’710 Patent as described in the Jeffay Declaration.

6. My materials considered for forming my opinions herein have included at least the documents referenced in the Jeffay Declaration, as well as the Freedman Declaration and the documents cited therein.

7. My compensation is not based on the content of my opinions or the resolution of this matter.

8. Patent Owner argues that Casagrande ’771 does not disclose the “second command” found in claim elements 1[c], 9[c], 9[d], 9[e], and 18[c] of the ’710 Patent because Casagrande ’771 does not explicitly teach any additional step the user must take to initiate playback after selecting the first A/V stream 1504 or the second A/V stream 1514. Patent Owner Response at 12. I understand that Patent Owner’s conclusion is based on a narrow construction of “first command” that excludes the initiation of playback. *Id.* at 7. Even if the Board adopted this construction, Casagrande ’771 still renders this element obvious.

9. For example, a POSITA viewing the user interaction described in Casagrande would have understood that it renders the claims obvious at least because it would be obvious to allow the user to first designate a desired program, or program variant to watch (i.e., to select whether a complete first stream, or a shortened second stream is desired, corresponding to the first command) followed by a second command to indicate that selection is complete and playback should begin. This method of implementing a user interface on a set-top box (i.e., permitting user selections, followed by a second interaction to show that selection is complete and processing of the selections by the system should begin) was well-known at the time of the alleged invention of the claims of the '710 Patent, often described as a confirmation dialog, prompt, overlay, or screen, and provided a way to ensure user selection was intentional, not erroneous, and complete. *See generally* Ex. 1015 (U.S. Patent No. 8,489,990) at 73:40-47 (describing, for example, a confirmation screen displayed after the selection of playlist that confirms the selection and initiates playback of the selection); *see also* Ex. 1016 (U.S. Patent No. 7,612,898); Ex. 1017 (U.S. Patent No. 6,448,986); Ex. 1018 (U.S. Pat. App. Pub. No. 2007/0136692); Ex. 1019 (U.S. Pat. App. Pub. No. 2006/0274086). Thus, a POSITA would have found the claimed “second command” obvious in view of the teachings of Casagrande '771.

10. Patent Owner also argues that the combination of Casagrande '771 and Russ does not disclose or render obvious the second scenario found in elements 1[d], 9[f], and 18[d] (e.g., “provide said video program in its entirety to said display device in response to receiving said second command if said second command is received during a second period of time and said DVR is in said first playback state”). Patent Owner Response at 18. However, Casagrande '771 expressly permits the user to select the full length first A/V stream, which in the combination with Russ would be available during the second time period. Ex. 1006 at 19:63-65, 13:5-12. Further, nothing in Russ describes that a commercial is no longer viewable once its ad insertion tag expires. But regardless, a POSITA would not implement the combination in such a way because Casagrande shows that users may *prefer* to watch commercials in certain instances. *Id.* at 14:49-51. Thus, a POSITA would have found these elements obvious in view of the teachings of Casagrande '771 and Russ.

11. With regards to dependent claims 3 and 12, Patent Owner argues that the Petition takes two irreconcilable positions, foreclosing the possibility of some commercials being skipped while showing others. Patent Owner Response at 25 and 28. However, Patent Owner ignores Casagrande '771's disclosure that “a user may be presented with a menu of available segments of the television program, and may select one or more of the available segments for presentation.” Ex. 1006 at 4:1-4; Ex. 1002, ¶135. Casagrande '771 teaches that the user's selection guides the

segments that are skipped or shown. Indeed, “[b]ased upon user selection of the particular segments from the selection menu, the receiving device responsively outputs the selected segments, skipping presentation of the undesignated segments.” Ex. 1006 at 4:4-12; Ex. 1002, ¶135. There is no reason why this disclosure would preclude the user from selecting some commercials or segments, but not others. Indeed, Casagrande ’771 expressly contemplates that the user might desire to watch commercials in certain instances. *See, e.g.*, Ex. 1006 at 14:49-51.

12. Importantly, Casagrande ’771 does not suggest that the restrictions against fast forwarding or skipping apply equally to all commercial segments, and Russ confirms that not every commercial would be subject to the same restrictions as others. For example, Russ discusses commercial segments as organized by “slot” with the time-based restriction specific to the slot. *See, e.g.*, Ex. 1008, ¶[0035] (“The commercial *slot* would also preclude trick play for only a specified length of time...”). It follows that that some commercials may be skipped while others may not be skipped. Ex. 1002, ¶85. Indeed, it is possible that the particular limitations may change based on the particular commercial slot, with some commercials having a longer time restriction on skipping than others (i.e., commercials in some slots can be skipped after two weeks, while others only after a month from first broadcast has passed). Thus, Casagrande ’771 and Russ render obvious the additional limitations of displaying only a portion of the secondary video content.

13. My opinions are based on my years of experience in the field of managed content delivery in multimedia networking and distribution systems and their associated software and equipment.

All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true. I further understand that willful false statements and the like are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code. I declare under penalty of perjury that the foregoing is true and correct. Executed on June 3, 2024.



Kevin Jeffay, Ph.D.