

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK L.L.C. AND DISH TECHNOLOGIES L.L.C.,

Petitioner,

v.

DIGITAL BROADCASTING SOLUTIONS, LLC,

Patent Owner.

***Inter Partes* Review No. IPR2023-00976**

Patent No. 8,929,710

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

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Cases

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<i>Xerox Corp., et al. v. Bytemark, Inc.</i> , No. IPR2022-00624, Paper 9 (P.T.A.B. Aug. 24, 2022)	9, 24

EXHIBIT LIST

Exhibit	Description
2001	Defendant’s Initial Invalidity Contentions, <i>Digital Broadcasting Solutions LLC v. Dish Network L.L.C.</i> , No. 2:22-cv-00335-JRG (Jan. 20, 2023).
2002	http://www.graphics.stanford.edu/courses/cs448-98-fall/dtv/dvcr.html (Fall 1998).
2003	http://www.graphics.stanford.edu/courses/cs448-98-fall/ (Fall 1998)
2004	https://www.sfgate.com/entertainment/article/WHAT-S-NEW-IN-1999-Consumers-Testing-New-2953718.php
2005	U.S. Patent Publication No. 2009/0238536 (“ <i>Gratton</i> ”)
2006	Declaration of Dr. Immanuel Freedman
2007	CV of Dr. Immanuel Freedman

I. INTRODUCTION

Digital Broadcasting Solutions, LLC (“Patent Owner”) respectfully submits this Sur-Reply to Petitioner’s Reply (Paper 14, the “Reply”) in *inter partes* Review No. IPR2023-00976 of U.S. Patent No. 8,929,710 (EX1001, the “’710 Patent”).

II. PETITIONER’S REQUEST TO DISREGARD DR. FREEDMAN’S DECLARATION SHOULD BE DENIED.

Petitioner’s request to disregard the declaration of Patent Owner’s expert witness, Dr. Freedman (Reply, pp. 1-2), should be denied because it is based on misrepresentations of his testimony.

First, Petitioner misrepresents to the Board that “[w]hen initially asked about the claimed limitations, Dr. Freedman explained that the user had nothing to do with the commands.” *Id.* (citing EX1020,61:2-3). Here is the actual question and answer:

Q. So, that is the sense you’re using the word distinct, to mean that they have to be two entirely different interactions by the user?

A. We really can’t, in my view, import interaction with the user into this. We’re not speaking about users anywhere in this. We’re speaking about commands and we’re speaking about states.

EX1020,60:20-61:4.

Dr. Freedman was not asked about the source of the commands. *See id.* And he is correct that the focus of claim 1 is on the commands and states. *See* EX1001,11:46-12:16. When reminded of the single occurrence of “user” in the

claim—“a controller configured to receive commands from a user” (EX1001,11:57)—and given the chance to consult the patent claims, Dr. Freedman correctly testified that the two claimed commands correspond to two separate user interactions. EX1020,61:5-19.

Second, Petitioner misrepresents Dr. Freedman’s testimony regarding playback states. Reply,p. 2. Dr. Freedman correctly testified that “[i]n Romanette 1 the process is configured to provide the video program in its entirety to a display device in response to receiving a second command regardless of the playback state, if a second command is received during the first period of time,” consistent with the language of claim 1. EX1020,58:4-15; *see also* EX1001,11:62-66.

Third, Petitioner alleges that Dr. Freeman “showed a fundamental lack of understanding of the . . . prior art.” Reply,p. 1. Tellingly, however, Petitioner fails to cite any alleged examples. *See id.*,pp. 1-2. It is also telling that despite these alleged issues with Dr. Freedman’s testimony, Petitioner cites to his deposition transcript only once outside of Petitioner’s request to disregard Dr. Freedman’s 68-page declaration in its entirety. *See id.* at 7.

III. CLAIM CONSTRUCTION

A. “a first period of time”

Petitioner urges the Board to reject Patent Owner’s construction of the term “a first period of time” because it allegedly “departs from the term’s plain and

ordinary meaning and is inconsistent with the specification and claims.” Reply,p. 3 (emphasis added). Petitioner is incorrect because, as shown in the Patent Owner Response, Patent Owner’s construction is consistent with the plain language of the claims, as well as the specification. Paper 11,pp. 5-7. Conspicuously absent from the Reply is any discussion of the prosecution history, let alone Patent Owner’s analysis thereof, which stands unrebutted. *Compare* Reply,pp. 3-5 *with* Paper 11,p. 6. The fact remains that the patentee explained to the Examiner that the claimed “first period of time” begins after transmission of the entire “video program:”

a digital video recorder (“DVR”) that stores a video program and plays at least a portion of the video program back at a later time (e.g., a time more convenient to the user of the DVR, etc.) . . . In a first state, the DVR is configured to play the program as it was originally recorded (e.g., with both the program and auxiliary data). In a second state, the DVR is configured to play the program data without the auxiliary data (or a portion thereof) . . . To this end, the claimed invention provides that if the video program is being watched within a first period of time (e.g., within a day or two of the video program being transmitted to the DVR, etc.), then the video program will be played back in its entirety (e.g., including both program and auxiliary data).

EX1003,pp. 108-109 (emphasis added). Patentee’s statement to the Examiner is clear and unambiguous: the “first period of time” starts after the video program is transmitted. *See id.* Petitioner did not attempt to rebut Patent Owner’s analysis of

the prosecution history for the simple reason that there is no rebuttal. And the patentee's own description of his claims, which is consistent with the claim language and embodiments disclosed in the specification, should control.

Petitioner's argument that Patent Owner's construction "would exclude DVR buffering or storing 'live' content" is inapposite to the relevant claim language and other embodiments disclosed in the specification. In Claim 1, the "first period of time" is *before* "said second period of time" ("wherein said second period of time is a period of time after said first period of time") and *after* "receiving said video program" and "storing said video program." EX1001,11:44-12:16. Each of the independent claims further provides for:

at least one processor configured to (i) provide said video program in its entirety to a display device in response to receiving said second command regardless of a playback state of said DVR if said second command is received during a first period of time,

E.g., EX1001,11:62-66 (claim 1) (emphasis added). However, that limitation cannot be met until "said video program [is received and stored] in its entirety," which is not the case for "live" content or buffered content that has not been completely transmitted.

Accordingly, the "first period of time" should be construed to start after transmission of the entire "video program."

B. “first command”

The Reply avoids the crux of the issue with construction of the term “first command:” whether the “first command” can initiate playback of the video program. *See* Reply,p. 5. The answer is “no.” Petitioner seeks to improperly conflate the meanings of the “first command” and “second command” such that either command can initiate playback to support its defective invalidity grounds. The plain language of the claim requires that the “first command changes said DVR from a first playback state to a second playback state” (EX1001,11:58-59) whereas the “second command initiates playback of said video program from said memory device” (EX1001,11:60-61). Petitioner’s proposed construction should be rejected because it would render superfluous the explicit differentiation between the “first command” and “second command” recited in the claims.

IV. GROUND 1: THE COMBINATION OF *CASAGRANDE* AND *RUSS* DOES NOT RENDER OBVIOUS CLAIMS 1-19 OF THE ’710 PATENT.

The Patent Owner Response showed why *Casagrande* and *Russ* are fundamentally different than the ’710 Patent. *See* Paper 11,pp. 8-10. The Reply does not rebut that showing; instead, it merely states that *Casagrande* and *Russ* “are directed to DVR systems that have commercial skip features and ‘trick play’ preclusion functionalities.” *See* Reply,p. 6. But general DVR features are not sufficient to render invalid the claims of the ’710 Patent.

At its core, *Casagrande* does nothing more than allow the user to select to play one of two audio/visual streams: (1) a “first audio/visual stream” that includes “segments” and “interstitials” (e.g., commercials) or (2) a “second audio visual stream” that the DVR generates by removing the “interstitials” from the “first audio/visual stream” and, in some cases, replacing the removed “interstitials” with “substitute content.” EX1006,2:23-47, 8:63-9:5, 13:13-31, 19:63-66. As a result, the user is merely selecting which stream to view, not changing the “playback state” of the DVR.

In other words, *Casagrande* is akin to online streaming services where two versions of a video program are available to be played: a first one with commercials (typically for free) and a second one that is commercial-free (typically for pay). In *Casagrande*, the user is merely selecting which stream to play. In the claimed invention, however, the user only has one stored video program to choose from, where “a second command initiates playback of said video program from said memory device” and the portions played back are *automatically selected* based on (1) playback state of the DVR (set via the “first command”) and (2) time. EX1001,11:57-12:14. As discussed below, these features are absent from both *Casagrande* and *Russ*.

A. Ground 1 Fails to Render Obvious Limitations 1[c], 9[c], and 18[c].

Petitioner's obviousness arguments rest on an improper reading of the claims that conflates the meanings of the "first command" and "second command." The Reply concedes that *Casagrande* "teaches that the 'user may select...whether the first A/V stream...is outputted to the display device.'" Reply, pp. 6-7 (quoting EX1006, 19:63-66) (emphasis added). The fact that one of the streams is being outputted to the display device means that the command that precipitated that output initiated playback. The Petition identified that command as the claimed "first command," which is contrary to the claim language. *See* Pet., p. 30.

Petitioner argues that the Board should disregard that unambiguous disclosure in *Casagrande* because "this selection may be overridden by the system. . . ." Reply, p. 7 (citing EX1006, 19:64-20:2, 19:15-19, 4:1-12, 23-32). Petitioner's first citation (19:64-20:2) states that the user may be restricted from selecting which A/V stream is played back; it does not state that the "first command" does anything other than initiate playback, contrary to the language of the claims. Petitioner's second citation (19:15-19) reinforces the fact that Petitioner's "first command" initiates playback because it "command[s] the receiving device 1510 to output the first A/V stream 1504 to the display device 1514 for presentation." The third citation (4:1-12) pertains to creation of a menu that corresponds to the available video segments, and selection of a segment initiates playback: "Based upon user selection of

particular segments from the selection menu, the receiving device responsively outputs the selected segments. . . .” EX1006,4:5-7 (emphasis added). The fourth citation (4:23-32), which is irrelevant, pertains to whether the user can skip segments, without reference to how playback is initiated.

The fact remains that *Casagrande* does nothing more than allow the user to select to play one of two audio/visual streams: (1) a “first audio/visual stream” that includes “segments” and “interstitials” (e.g., commercials) or (2) a “second audio visual stream” that the DVR generates by removing the “interstitials” from the “first audio/visual stream” and, in some cases, replacing the removed “interstitials” with “substitute content.” EX1006,2:23-47, 8:63-9:5, 13:13-31, 19:63-66. This is distinguishable from the claimed invention where a “second command” initiates playback of a *single* video program and a controller determines *automatically* which portions of the video program are provided to the display device based (in part) on a selected playback state of the DVR—a state that is selected via a “first command.”

Faced with that shortcoming in *Casagrande*, Petitioner essentially argues that it would have been obvious to rewrite *Casagrande* with no support other than a copycat opinion in the reply declaration of Dr. Jeffay.¹ See Reply,p. 7 (citing

¹ Petitioner does not argue that it would have been obvious to combine *Casagrande* with *Russ* to satisfy these claim limitations. Pet.,pp. 29-31; Reply,pp. 6-8.

EX1015,¶9).² But Dr. Jeffay’s declaration should be afforded no weight because it does nothing more than restate Petitioner’s argument without any additional supporting evidence or reasoning. *Compare* Reply, pp. 7-8 with EX1014,¶9; *Xerox Corp., et al. v. Bytemark, Inc.*, No. IPR2022-00624, Paper 9, pp. 15-16 (P.T.A.B. Aug. 24, 2022) (precedential) (declaration is entitled to little weight when it contains an exact restatement of the petition’s arguments without any additional supporting evidence or reasoning). Moreover, a “confirmation dialog” or “confirmation prompt” does not resolve the shortcoming in Petitioner’s obviousness argument because the “first command” would have initiated playback (contrary to the claim language), whereas the subsequent dialog/prompt would merely confirm.

B. Ground 1 Fails to Render Obvious Limitations 1[d], 9[f], and 18[d].

First Scenario: The combination of *Casagrande* and *Russ* does not disclose the first scenario (i.e., limitations 1[d](i), 9[f](i), 18[d](i)). *Casagrande* “uses the identified restrictions to determine whether to allow particular features associated with the output of the presentation stream, such as fast-forwarding and the like.” EX1006,24:53-56. The shortcoming in *Casagrande* remains that those “identified restrictions” are not based on time, but the claims require specific timing (i.e., “if

² The Reply cites to EX1015,¶9, but EX1015 does not contain paragraph markers, so Patent Owner assumes that Petitioner meant to cite EX1014.

said second command is received during a first period of time”). The Reply tacitly concedes that *Casagrande* discloses no time-based restrictions. *See* Reply, pp. 9-10 (“the Petition relies on the combination with Russ, which expressly includes limitations on skipping commercials based on the passage of a ‘specified length of time, such as two weeks.’”).

Petitioner’s argument fails for two reasons. First, Petitioner’s argument that the “Petition relies on the combination with Russ” is, at best, a misrepresentation. The portion of the Petition for limitations 1[d](i), 9[f](i), 18[d](i) contains no reference to Russ (EX1008). *See* Pet., pp. 31-32. Second, *Russ* uses “ad-insertion tags” to “differentiate between the program and commercials.” *See* EX1008, ¶[0026]. Frames within the program “are preferably tagged to indicate a splicing point when a commercial break is coming.” *Id.*, ¶[0027]. Through the tags, commercials are inserted or replaced. *Id.*, ¶[0028]. And the same tag can also specify an expiration date, after which “the tag would become inactive or replaceable.” *See id.*, ¶[0035]. At that point, the commercial would no longer be viewable (because the tag is inactive) or the commercial would be replaced with a different commercial (because the tag is replaced). *See id.* As *Russ* explains, the “commercial slot,” defined by the tag, is a holder for a commercial that changes after expiration. *Id.* (“A non-persistent commercial slot could display a particular ad for a company

during a specified length of time before the commercial slot could then display a commercial for a different company.”).

Accordingly, *Russ* does not disclose providing “said video program in its entirety . . . during a first period of time.” In other words, it is the “tag” that determines whether the commercial can be skipped—not the time at which the video program is played back. And if the tag expires (after a period of time), the commercial would either be non-viewable or replaced by a new commercial—not the transmitted commercial (or “second portion”) as claimed. *See id.*; *see also* EX2006, ¶74. Petitioner provides no rebuttal to Patent Owner’s argument or the expert testimony of Dr. Freedman. *See Reply*, p. 10.

Second Scenario: The combination of *Casagrande* and *Russ* does not disclose the second scenario (i.e., limitations 1[d](ii), 9[f](ii), 18[d](ii)). *Casagrande* does not disclose the second scenario because the limitation by the “content provider” remains the same regardless of whether “said second command is received during a second period of time” or at some other time. *See* EX1006, 19:66-20:2, 5:66-6:3; EX2006, ¶71. In other words, it is the “content provider” that determines whether a commercial can be skipped—not the time period as claimed. And as discussed for the first scenario, *Russ* does not disclose the required time-based functionality because if the tag expires (after a period of time), the commercial would either be

non-viewable or replaced by a new commercial—not the transmitted commercial (or “second portion”) as claimed.

Petitioner argues that *Russ* discloses this limitation because Patent Owner “wrongly assumes commercial tags expire after a specified time, after which commercials are never shown.” Reply, p. 12. But *Russ* unambiguously states that if a commercial tag will preclude trick play for a period of time, it does so by having an associated expiration date:

The commercial slot could also preclude trick play for only a specified length of time, such as two weeks. For example, a tag corresponding with a commercial could expire after a period of time after which the tag would become inactive or replaceable.

EX1008, ¶[0035]. There is no support in *Russ* for the transmitted commercial to be skippable only after a first period of time. In fact, *Russ* provides the opposite—that “trick play functionality such as fast forward, **would not work for certain commercials** as specified.” *Id.*, ¶[0033] (emphasis added). As such, “trick play” preclusion is commercial based, not time based. Accordingly, neither *Casagrande* nor *Russ* discloses this limitation.

Third Scenario: The combination of *Casagrande* and *Russ* does not disclose the third scenario (i.e., limitations 1[d](iii), 9[f](iii), 18[d](iii)). *Casagrande* does not disclose the third scenario because the limitation by the “content provider”

remains the same during the first and second periods of time—there is no determination based on whether “said second command is received during said second period of time” as is required by the claims. *See* EX1006,19:66-20:2, 5:66-6:3; EX2006,¶77. The Reply does not identify any disclosure in *Casagrande* to the contrary. *See* Reply,pp. 13-14.

Here again for *Russ*, it is the same “tag” that (1) determines whether a commercial can be skipped and (2) specifies an expiration date for the commercial. *See* EX1008, ¶[0035] (e.g., so-called “trick play” functionality). Thus, like *Casagrande*, the determination of whether a commercial can be skipped is not based on time, but on the specific commercial, or the “tag” associated therewith. *See* EX2006, ¶79. The commercial that is included with the transmitted video program (i.e., the “second portion”) is either skippable or not. While commercial skipping may resume (e.g., after a period of time), it is not the transmitted commercial that is skipped, but a new (or replacement) commercial. *See id.*, ¶80.

Even under Petitioner’s flawed reading of *Russ*, where “trick play” preclusion is time based, the proposed combination would merely result in *Casagrande* offering only a first stream (e.g., with commercials) during a “trick play” preclusion period and offering both streams (e.g., one with commercials and one without) once preclusion ends. As such, the proposed combination would not (automatically) choose between providing “said video program in its entirety” (second scenario) or

providing “only a portion of said video program” (third scenario) based on the “period of time” and “playback state” as required by the claims. The proposed combination would, at best, determine which audio-visual stream(s) are available for playback, but the user would still select which stream to playback. As a result, the user is merely selecting which stream to view—the DVR is not choosing between providing “said video program in its entirety” (second scenario) or providing “only a portion of said video program” (third scenario) based on the “period of time” and “playback state” as required by the claims.

C. Ground 1 Fails to Render Obvious Dependent Claims 3 and 12.

The Reply rests on two assertions for these dependent claims. First, Petitioner argues that “Casagrande does not suggest that the restrictions against fast forwarding or skipping apply equally to all commercial segments.” Reply,p. 15. Not so. *Casagrande* plainly states that “commercials within a television program may be associated with restrictions against fast forwarding or skipping. . . .” EX1006,24:38-40. *Casagrande* does not teach or suggest that a subset of the commercials can be associated with restrictions, so Petitioner has failed to meet its burden.

Second, Petitioner argues that “Russ discusses commercial segments as organized by ‘slot’ with the time-based restriction specific to the slot.” Reply,p. 15. Petitioner’s second argument is improper because the Petition does not contain any reference to *Russ* for claims 3 and 12. See Pet.,pp. 40-42. Putting that aside,

Petitioner also fails to provide any support in *Russ* other than the unsupported opinions of Dr. Jeffay. *See Reply*, pp. 15-16.

D. Ground 1 Fails to Render Obvious Dependent Claim 17.

There is no reasonable dispute that claim 17 requires that at least two “times:” (1) “said at least one time of when said second portion of said video program begins” and (2) “said at least one time of when said second portion of said video program ends.” EX1001,14:11-14. Together, the two “times” define the beginning and end of the “second portion of said video program.” *See id.* The claim also requires “wherein each of one said at least one times is received by said DVR after said video program is stored on said memory device.” *Id.*,14:20-24 (emphasis added).

Because the claim includes a temporal limitation, Petitioner must show when the alleged “times” are received by the DVR to meet its burden. Petitioner’s only citation to *Casagrande* in the Reply merely states that “the communication interface 1502 may receive the supplemental content 1506 and the location information 1508 by employing the same technology used to receive the first A/V stream.” Reply, pp. 16-17 (citing EX1001,18:6-9).³ But that citation merely states that the alleged

³ Petitioner’s citation appears to be a typographical error because it refers to the Petition, so Patent Owner assumes that Petitioner meant to cite to EX1006, which is *Casagrande*.

“times” are received using the same technology without any reference to the relative timing of receipt.

V. GROUND 2: *DOW* DOES NOT ANTICIPATE CLAIMS 1-5, 7-13, AND 16-19 OF THE '710 PATENT.

The Reply argues that “Dow is not fundamentally different from the ’710 Patent as PO’s Response argues,” but fails to identify any disclosure in *Dow* of the time-based limitations that are required by the claims. *See* Reply, pp. 17-18. That is because *Dow* is fundamentally different. *Dow* recognizes that predecessor VCRs included commercial-skipping functionality. *See* EX1007, 1:31-2:60. But those “commercial-skipping VCRs” had shortcomings that limited their ability to accurately detect commercials. *See id.* *Dow* recognizes that the digital storage in a DVR (as opposed to the analog storage in a VCR) can be used to provide better event detection (e.g., detection of commercials) and navigation through those events. *See id.*, 3:14-48. In other words, the DVR in *Dow* is performing commercial detection on the device itself, without any information about commercials (including time-based limitations) being provided as part of the transmitted video program. That is why Petitioner was unable to identify any disclosure in *Dow* of the time-based limitations that are required by the claims. *See* Reply, pp. 17-18.

A. Ground 2 Fails to Anticipate Limitations 1[c], 9[c], and 18[c].

Like the discussion of *Dow* (Reply, pp. 17-18), Petitioner's arguments for limitations 1[c], 9[c], and 18[c] ignore the fact that the "first playback state" and "second playback state" correspond to more than simply whether commercial-skipping functionality is active or inactive. Reply, p. 18. They also place time-based limitations on navigation through a program, as discussed in further detail below for limitations 1[d], 9[f], and 18[d]. *Dow* does not disclose those time-based limitations, so *Dow* does not anticipate limitations 1[c], 9[c], and 18[c].

B. Ground 2 Fails to Anticipate Limitations 1[d], 9[f], and 18[d].

Petitioner's arguments for limitations 1[d], 9[f], and 18[d] rely on the Board rejecting Patent Owner's construction of "a first period of time." See Reply, pp. 18-24. Petitioner provides no alternative argument under Patent Owner's construction of the term, so Petitioner cannot meet its burden if the Board adopts Patent Owner's construction of "a first period of time."

First Scenario: *Dow* does not anticipate the first scenario (i.e., limitations 1[d](i), 9[f](i), 18[d](i)). The Reply fails to identify any disclosure in *Dow* regarding time-based limitations on navigation through a program. See Reply, pp. 20-21. First, Petitioner argues that this scenario is met because *Dow* refers to a "time index of the video file." See *id.*, p. 20 (citing EX1007, 6:45-51). But Petitioner's argument boils down to nothing more than a word-spotting exercise for the word "time." The time

index is a file that cross-references portions of an MPEG video stream to the elapsed time of the video:

Most DVRs store video content as compressed video files using a digital compression standard, such as MPEG. In order to provide time-based access to and navigation of the video files, DVRs may generate a companion index file containing a time index of the video file. For example, the index file may correlate GOPs (Group of Pictures, a unit of MPEG compressed data) to elapsed time. DVRs may use the data from the index file to enable time-based manipulation of the video data stream during play back.

EX1007,3:14-22 (emphasis added). It does nothing more than allow the DVR to skip to specific times within the video stream. *See id.*,3:14-22, 6:64-67. It does not provide any time-based limitations on navigation through a program.

Second, Petitioner argues that this scenario is met because “the challenged claims do not recite a ‘determining’ feature.” Reply,pp. 20-21. As previously discussed, it is not Patent Owner’s position that the claims recite a “determining” function. But the express language of the claims requires time-based limitations on navigation through a program, which Petitioner ignores because *Dow* contains no such disclosure.

Third, Petitioner does not rebut the fact that neither “live view mode” nor “delayed view mode” can meet the language of the claims. *Compare* Paper 11,pp.

40-41 *with* Reply,p. 21. That is because in either mode, the entire “video program” has yet to be received as required by the claims. Moreover, the DVR in *Dow* is performing commercial detection on the device itself, without any information about commercials (including time-based limitations) being provided as part of the transmitted video program, so the *Dow* DVR would need additional time to detect commercials before it could allow commercial skipping. EX1007,3:14-48. This is why *Dow* provides that “commercial skip is always inactive in live view mode and delayed view mode” as insufficient time is available to detect commercials, as the entire video program has not yet been received and stored. *Id.*,24:43-48.

Instead, Petitioner points to an ambiguous statement in *Dow* that “[o]ther relationships to operation mode and control signals may be defined for other navigation features.” Reply,p. 21. But, here again, Petitioner fails to identify any disclosure of time-based limitations on navigation through a program.

Second Scenario: *Dow* does not anticipate the second scenario (i.e., limitations 1[d](ii), 9[f](ii), 18[d](ii)). Petitioner presents no new argument, other than to concede that *Dow* does not disclose this limitation under Patent Owner’s construction of “a first period of time.” See Reply,p. 22.

Third Scenario: *Dow* does not anticipate the third scenario (i.e., limitations 1[d](iii), 9[f](iii), 18[d](iii)). Here again, Petitioner relies on the same “time index of the video file” that Petitioner relied on for the first scenario. See Reply,pp. 22-

23. But that file does nothing more than allow the DVR to skip to specific times within the video stream:

Most DVRs store video content as compressed video files using a digital compression standard, such as MPEG. In order to provide time-based access to and navigation of the video files, DVRs may generate a companion index file containing a time index of the video file. For example, the index file may correlate GOPs (Group of Pictures, a unit of MPEG compressed data) to elapsed time. DVRs may use the data from the index file to enable time-based manipulation of the video data stream during play back.

EX1007,3:14-22 (emphasis added). Petitioner fails to identify any disclosure of time-based limitations on navigation through a program, let alone the specific requirements of the third scenario.

C. Ground 2 Fails to Anticipate Dependent Claims 3 and 12.

Petitioner does not dispute that it cites to two different embodiments in *Dow* in an attempt to satisfy the requirements of dependent claims 3 and 12. *Compare* Paper 11, pp. 44-45 *with* Reply, p. 24. It is improper to combine different embodiments for anticipation unless doing so would have been “immediately apparent to one of ordinary skill in the art.” *Unified Patents Inc. v. Intellectual Ventures I LLC*, IPR2016-01643, Paper No. 51 29 (P.T.A.B. Mar. 26, 2018) (citing *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1382 (Fed. Cir.

2015)). Petitioner has made no such showing. Nor would such a combination have been immediately apparent because the two embodiments in *Dow* are mutually exclusive.

D. Ground 2 Fails to Anticipate Dependent Claim 17.

There is no reasonable dispute that claim 17 requires that at least two “times:” (1) “said at least one time of when said second portion of said video program begins” and (2) “said at least one time of when said second portion of said video program ends.” EX1001,14:11-14. Together, the two “times” define the beginning and end of the “second portion of said video program.” *See id.* The claim also requires “wherein each of one said at least one times is received by said DVR after said video program is stored on said memory device.” *Id.*,14:20-24 (emphasis added). Because the claim includes a temporal limitation, Petitioner must show when the alleged “times” are received by the DVR to meet its burden. Petitioner’s citations to *Dow* actually show that the two “times” are not “received by said DVR after said video program is stored on said memory device” as required by the claim.

First, Petitioner cites to a “metadata table [that] is ‘derived from guide data’ communicated alongside the received video data.” Reply, p.25 (citing EX1007,17:20-21,14:17-19). By Petitioner’s own admission, the guide data itself is “communicated alongside the received video data,” not “received by said DVR after said video program is stored on said memory device” as required by the claim. The

metadata table fares no better because it is generated on the DVR, so it is not “received by said DVR” as required by the claim.

Second, Petitioner cites to “index data” that “may be received with a broadcast or transfer of a video program.” Reply, p. 26 (citing EX1007, 17:64-65). Petitioner’s quotation disingenuously omits the preceding sentence that provides necessary context:

Index data may be generated by the indexing logic 516 and the event indexer module 536 and stored in the index files 556. In some embodiments, some or all of the index data may be received with a broadcast or transfer of a video program.

EX1007, 17:61-65. In view of the full context, *Dow* can either generate the index data locally (if it is missing from the broadcast) or some or all of the index data can be received with the video program. *See id.* *Dow* contains no disclosure of receiving the index data “after said video program is stored on said memory device” as required by the claim.

VI. GROUND 3: THE COMBINATION OF *DOW* AND *RUSS* DOES NOT RENDER OBVIOUS CLAIMS 1-19 OF THE ’710 PATENT.

The Reply does not contain any substantive response to the section of the Patent Owner Response regarding Petitioner’s third ground. *See* Reply, p. 26. Despite Petitioner’s misrepresentation to the contrary, the Patent Owner Response

contains arguments specific to Ground 3, which are not addressed by Petitioner. *See* Paper 11, pp. 50-58.

As discussed above, *Dow* fails to anticipate the challenged claims. Petitioner relies on *Russ* primarily for its disclosure of “trick play” preclusion. However, as discussed above, *Russ* unambiguously states that “trick play” preclusion is commercial based—not time based (*see* Section IV(B) above) and that it is the local cable operator or the presentation programmer (not time) that determines whether “trick play” functionality is precluded for a specific commercial. EX1008, ¶[0033]. As such, the proposed combination would not result in the claimed “first period of time” where the entire video program is provided regardless of playback state and a “second period of time” where either the entire video program or a portion thereof is provided, depending on the playback state of the DVR.

Petitioner also alleges that “PO’s Response also fails because it ignores analysis from Petitioner and Dr. Jeffay that ‘[a] POSA viewing the teachings of...Dow...would have naturally looked to *Russ* for additional details regarding the implementation of such functionalities on DVRs.’” Reply, p. 26 (citing Paper 2, 20-21; Ex[1002] ¶86). That exact quotation does not occur anywhere in the record (and certainly not in Paper 2, which is Petitioner’s Power of Attorney), but a close match occurs in Petitioner’s general section on “Motivations to Combine.” Paper 1, p. 20. Like many of Dr. Jeffay’s other opinions, he merely parrots the arguments from the

petition with no further support or analysis. *Compare* Pet.,pp. 20-21 with EX1002,¶86. Accordingly, it should be afforded no weight. *See Xerox Corp., et al. v. Bytemark, Inc.*, No. IPR2022-00624, Paper 9, pp. 15-16 (P.T.A.B. Aug. 24, 2022) (precedential) (declaration is entitled to little weight when it contains an exact restatement of the petition's arguments without any additional supporting evidence or reasoning). Moreover, the Patent Owner Response identifies shortcomings in Dr. Jeffay's opinion, with regard to specific claim limitations, that Petitioner fails to rebut. *See* Paper 11,p. 52,p. 54.

Accordingly, Ground 3 fails to render obvious claims 1-19 of the '710 Patent.

VII. CONCLUSION

For the foregoing reasons, and all the reasons discussed in Patent Owner's Response, Petitioner has not established that the cited references render any of the challenged claims unpatentable.

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), I hereby certify that the foregoing Patent Owner's Sur-Reply to Petitioner's Reply contains 5,349 words as measured by the word processing software used to prepare the document, excluding the cover page, signature block, and portions exempted under 37 C.F.R. § 42.24(a) or (b).

DATED: July 9, 2024

Respectfully submitted,

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Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on July 9, 2024, the foregoing document was served on counsel of record for Petitioner by filing this document through the End-to-End System, as well as via electronic mail to counsel of record for Petitioner at the following addresses: Eliot D. Williams (eliot.williams@bakerbotts.com), G. Hopkins Guy (hop.guy@bakerbotts.com), Ali Dhanani (ali.dhanani@bakerbotts.com), and Thomas Carter (thomas.carter@bakerbotts.com).

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