

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. IPR2023-00977**

Patent No. 9,538,122

**PATENT OWNER'S PRELIMINARY RESPONSE TO THE PETITION
FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,538,122
PURSUANT TO 37 C.F.R. § 42.107**

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TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	STATEMENT OF THE PRECISE RELIEF REQUESTED	2
III.	THE PETITION SHOULD BE DENIED BECAUSE IT DOES NOT ESTABLISH A REASONABLE LIKELIHOOD OF SUCCESS ON ANY CHALLENGED CLAIM.	2
A.	The '122 Patent.....	3
B.	Level of Ordinary Skill in the Art	6
C.	Claim Construction – The Petition Should Be Denied for Failure to Comply With 37 C.F.R. § 42.104(b)(3).	6
D.	Ground 1 – The Combination of <i>Casagrande, Russ, and Miller</i> Does Not Render Obvious Claims 1-20 of the '122 Patent.	9
1.	Independent Claim 1	11
i.	1[a] “a tuner for receiving a plurality of video programs . . .”	11
ii.	1[b] “a memory device for storing said plurality of video programs, allowing said one of said plurality of video programs to be played back at a later time”.....	13
iii.	1[c] “a controller configured to receive commands from a user of said DVR . . .”	13
iv.	1[d] “at least one processor configured to . . .”.....	15
2.	Independent Claims 11 and 18.....	23
3.	Dependent Claims 2-10, 12-17, 19, and 20	23
E.	Ground 2 – <i>Dow</i> Does Not Anticipate Claims 1, 3-5, 7-11, 18, and 19 of the '122 Patent.....	24
1.	Independent Claim 1	26
i.	1[a] “a tuner for receiving a plurality of video programs . . .”	27

ii.	1[b] “a memory device for storing said plurality of video programs, allowing said one of said plurality of video programs to be played back at a later time”.....	29
iii.	1[c] “a controller configured to receive commands from a user of said DVR . . .”	30
iv.	1[d] “at least one processor configured to . . .”.....	31
2.	Independent Claims 11 and 18.....	37
3.	Dependent Claims 3-5, 7-10, 13-16, and 19	37
F.	Ground 3 – The Combination of <i>Dow</i> , <i>Russ</i> , and <i>Miller</i> Does Not Render Obvious Claims 1-20 of the ’122 Patent.....	38
1.	Independent Claim 1	38
i.	1[a][ii] “said tuner can be tuned to said single channel to receive said plurality of video programs”.....	38
ii.	1[b] “a memory device for storing said plurality of video programs, allowing said one of said plurality of video programs to be played back at a later time”.....	39
iii.	1[c] “a controller configured to receive commands from a user . . .”	40
iv.	1[d][i] “at least one processor configured to (i) provide said one of said plurality of video programs in its entirety . . .”	41
v.	1[d][ii] “at least one processor configured to . . . (ii) provide said one of said plurality of video programs in its entirety . . .”	41
vi.	1[d][iii] “at least one processor configured to . . . (iii) provide only a portion of said one of said plurality of video programs . . .”	44
2.	Independent Claims 11 and 18.....	44
3.	Dependent Claims 2-10, 12-17, 19, and 20	45

IV.	THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 325(d).....	45
A.	The First Part of the Framework is Satisfied by Every Reference Asserted in the Petition.....	47
1.	<i>Dow</i>	48
2.	<i>Casagrande</i>	50
3.	<i>Russ</i>	51
4.	<i>Miller</i>	54
5.	Conclusion	54
B.	The Second Part of the Framework is Satisfied, So Institution Should Be Denied.....	54
V.	CONCLUSION.....	55

TABLE OF AUTHORITIES

Cases

<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,</i> IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020) (Precedential).....	45, 46
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG,</i> IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017) (Precedential)	46
<i>Xerox Corp., et al. v. Bytemark, Inc.,</i> IPR2022-00624, Paper 9 (P.T.A.B. Aug. 24, 2022) (Precedential).....	12, 29, 43

Statutes

35 U.S.C. § 112	7
35 U.S.C. § 325	45, 53, 54

Regulations

37 C.F.R. § 42.104	8
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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	Comparison between the specification of Ex. 1007 (" <i>Dow</i> ") and the specification of U.S. Patent No. 8,155,498 (" <i>Dow '498</i> ").
2007	Office Action Response filed during prosecution of Patent No. 8,929,710.

I. INTRODUCTION

Digital Broadcasting Solutions, LLC (“Patent Owner”) respectfully submits this Preliminary Response (the “Response”) to the Petition for *Inter Partes* Review of U.S. Patent No. 9,538,122 (IPR2023-00977, the “Petition” or “Pet.”) filed by DISH Network L.L.C. and DISH Technologies L.L.C. (collectively, “Petitioner”).

Institution should be denied because the Petition fails to demonstrate a reasonable likelihood that any challenged claim of the ’122 Patent is unpatentable. The claimed digital video recorder (DVR) places specific, time-based restrictions on when the user can skip a transmitted commercial: the DVR must preclude the user from skipping the *transmitted commercial* during a first period of time and allow the user to skip the same *transmitted commercial* during a second period of time. “By doing this, the user can avoid the secondary portions when those portions have a diminished value to the user, the content owner, the content provider, and/or the advertiser.” Ex. 1001 at Abstract. But the Petition all but ignores that limitation. Instead, the Petition relies on art where the functionality of the commercial skipping feature is not time based but predetermined (e.g., enabled or disabled by the content provider, etc.).

The Board should also exercise its discretion to institute because the Petition merely seeks another bite at the apple by repackaging *Dow*, *Casagrande*, and *Russ* as new art that was not before the Examiner. But the truth is that their disclosures

substantially overlap with the art considered by the Examiner. And the shortcomings of *Dow*, *Casagrande*, and *Russ* are the same shortcomings that the patentee overcame during prosecution.

Accordingly, Patent Owner respectfully requests that the Board deny institution.

II. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner asserts that claims 1-20 of the '122 Patent are unpatentable under the following grounds:

Petitioner requests review on the grounds that (1) claims 1-20 are obvious over <i>Casagrande</i> in view of <i>Russ</i> and <i>Miller</i> under 35 U.S.C. §103; (2) claims 1, 3-5, 7-11, 13-16, and 18-19 are anticipated by <i>Dow</i> under 35 U.S.C. §102; and (3) claims 1-20 are obvious over <i>Dow</i> in view of <i>Russ</i> and <i>Miller</i> under §103.
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Pet., p. 8.

Patent Owner requests that the Board deny institution of the Petition with respect to all challenged claims and all asserted grounds. A full statement of the reasons for the relief requested is set forth in Sections III and IV of this Response.

III. THE PETITION SHOULD BE DENIED BECAUSE IT DOES NOT ESTABLISH A REASONABLE LIKELIHOOD OF SUCCESS ON ANY CHALLENGED CLAIM.

As shown below, the Petition fails to demonstrate a reasonable likelihood that Petitioner would prevail with respect to any claim of the '122 Patent. As detailed

herein, each proposed Ground fails to disclose key limitations of each challenged claim, so trial should not be instituted.

A. The '122 Patent

The '122 Patent, which is titled “System and Method for Time Shifting At Least a Portion of a Video Program,” was filed on November 17, 2014, and issued on January 3, 2017. Ex. 1001. It is a continuation of U.S. Patent No. 8,929,710, and it claims priority to Provisional Application No. 61/408,759, which was filed on November 1, 2010. *Id.* The '122 Patent relates to “the storage and play back of time-shifted data, and more particularly to a system and method for adding auxiliary data to data that has been time-shifted.” *Id.* at 1:17-20.

As explained by patentee during prosecution of the parent case (i.e., U.S. Patent No. 8,929,710), the '122 Patent is directed to

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.). Video programs generally include multiple types of data. For example, a video program may include program data (e.g., a movie, a sitcom, etc.) and auxiliary data (e.g., a news ticker, a commercial, etc.), where the auxiliary data is either superimposed over the program data and/or placed between portions of the program data. While the program data may have a relatively long shelf life, the auxiliary data may not. For example, a news ticker or a commercial concerning the evening news may be of no (or limited) value after the evening news has been transmitted. The claimed invention addresses this issue by allowing a user to program the DVR to skip (or omit) at least a portion of the auxiliary data after its value has diminished.

The claimed invention achieves the above advantages by allowing a user of the DVR to set (or program) the DVR into one of two states. 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). In the claimed inventions, the DVR can only be programmed to skip (or omit) auxiliary data once the auxiliary data is no longer of value or is of limited value. 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). However, if the video program is being watched within a second period of time (e.g., a week after the video program has been transmitted to the DVR, etc.), then the video program will be played back in its entirety (e.g., including both program and auxiliary data, etc.) if the DVR has been programmed to operate in its first playback state, or in portions (e.g., without at least a portion of the auxiliary data, etc.) if the DVR has been programmed to operate in its second playback state. At any time during the second period of time, the user could also watch the video program with and without auxiliary data (or portions thereof) by watching the video program while the DVR is in a first playback state, and then watching the video program while the DVR is in a second playback state.

Ex. 2007, pp. 10-11.

These foregoing features are recited in the claimed inventions. For example, claim 1 provides for the reception and storage of “a plurality of video program” wherein at least one of the videos includes “at least first, second and third portions.”

Ex. 1001 at 11:60-12:8. A first command can then be used to playback the video program from memory where (i) the video program is played back during a first period of time “in its entirety . . . regardless of a playback state,” (ii) the video

program is played back during a second period of time “in its entirety . . . [if] said DVR is in said first playback state,” and (iii) the video program minus the second (e.g., commercial) portion is played back during the second period of time if “said DVR is in said second playback state,” where a “first [user-initiated] command” controls the playback state. *Id.* at 12:11-36. “By doing this, the user can avoid the secondary portions when those portions have a diminished value to the user, the content owner, the content provider and/or the advertisers.” Ex. 1001, Abstract.

It is important to note that (A) the entire video program (including first, second, and third portions) are received and stored in memory before playback is commenced and (B) it is the transmitted commercial (i.e., “second portion”) that cannot be skipped during the first period of time (regardless of playback state) and can be skipped during the second period of time only if the DVR is in a second playback state. Thus, the DVR must preclude the user from skipping the *transmitted commercial* during the first period of time and allow the user to skip the same *transmitted commercial* during the second period of time.

It is also important to note that the claimed invention provides a simple solution to recording a plurality of video programs using a single tuner. To this end, claim 1 provides for “a [single] tuner for receiving a plurality of video programs where (i) said plurality of video programs are transmitted at the same time on a single channel within said data distribution system [and] (ii) said tuner can be tuned to said

single channel to receive said plurality of video programs.” Ex. 1001, 11:63-12:1. The DVR is also configured to receive a “third command” from the user that “instructs said DVR to receive and store said plurality of video programs.” *Id.* at 12:10-17. Thus, the claimed invention uses *a single tuner* and *a single command* to *both receive and store a plurality of video programs*. The Petition does not acknowledge this feature as the prior art teaches the exact opposite, *i.e.*, recording a single program in response to a record command. For this very reason alone the Petition should be denied.

B. Level of Ordinary Skill in the Art

For the purposes of this Response only, Patent Owner does not dispute the level of skill of a person of ordinary skill in the art (“POSITA”) identified in the Petition. *See* Pet., p. 9.

C. Claim Construction – The Petition Should Be Denied for Failure to Comply With 37 C.F.R. § 42.104(b)(3).

Due to the substantial deficiencies in the Petition, Patent Owner contends that claim construction is not necessary for the Board to determine that the Petition fails to demonstrate a reasonable likelihood that any Challenged Claim of the ’122 Patent is unpatentable. Patent Owner reserves the right to address claim construction of any term in the challenged claims if the Board institutes *inter partes* proceedings.

The Petition provides no proposed constructions for any terms, and instead relies on Patent Owner’s alleged interpretation of the claims. *See* Pet. at 9-10. But, in a clear-cut example of speaking out of both sides of one’s mouth, Patent Owner fails to mention that it asserted the opposite position in its invalidity contentions before the United States District Court for the Eastern District of Texas, Marshall Division, before the case was transferred to the District of Colorado. Petitioner asserted that a litany of claim terms are indefinite under 35 U.S.C. § 112, which would render all of the challenged claims invalid:

Claim Term	Claim(s)
“is configured to follow”	1, 11, 18
“a later time”	1

“only a portion ... said portion of said one of said plurality of video program including at least said first and third portions of said video program”	1, 11
“immediately following”	1, 11, 18
“a period of time after said first period of time”	1, 11
“at least indirectly”	2. 20
“a predetermined time”	6
“a particular channel”	16
“a particular time”	16
“indicating a desire to record a second video program”	17
“a particular frequency”	19
“individual channels associated with content owners”	20

Ex. 2001, pp. 65-66. But Petitioner did not provide any proposed constructions for those allegedly indefinite terms. *See* Pet. at 9-10.

37 C.F.R. § 42.104 enumerates required portions of a petition for *inter partes* review. Subsection (b)(3) requires that the petition identify “[h]ow the challenged claim is to be construed. 37 C.F.R. § 42.104(b)(3). But Petitioner fails to provide any constructions for the terms that it contends “fail to inform those of skill in the art of the scope of the claimed invention(s) with any reasonable certainty.” *Compare* Ex. 2001 at 65-66 *with* Pet. at 9-10. Merely arguing that “Petitioner has applied what it understands to be DBS’s interpretation of the terms” (Pet. at 9-10) does not identify how the challenged claims are to be construed, especially given Petitioner’s contention that the claims are indefinite.

Accordingly, the Petition should be denied for failure to comply with 37 C.F.R. § 42.104.

D. Ground 1 – The Combination of *Casagrande*, *Russ*, and *Miller* Does Not Render Obvious Claims 1-20 of the '122 Patent.

Petitioner contends that the combination of *Casagrande*, *Russ*, and *Miller* renders obvious claims 1-20 of the '122 Patent. Pet. at 8, 14-44. The combination of *Casagrande*, *Russ*, and *Miller* does not render obvious those claims for at least the following reasons.

Although *Casagrande* is generally directed to a set top box with digital video recorder (DVR) functionality, it is fundamentally different than the '122 Patent. *Casagrande* discloses a “receiving device” (e.g., a set-top box with DVR capabilities) that receives and stores a “first audio/visual stream” that includes “segments” and “interstitials” (e.g., commercials). See Ex. 1006, 2:33-47, Fig. 7, Fig. 8, Fig. 15. The “receiving device” generates a “second audio visual stream” by removing the “interstitials” from the “first audio/visual stream” and, in some cases, replacing the removed “interstitials” with “substitute content.” See *id.*, 8:63-9:5, 13:13-31, Fig. 4, Fig. 8. The “user may select by way of the user input 1523 whether the first A/V stream 1504 or the second A/V stream 1512 is transferred to the display device.” *Id.*, 19:63-66. But *Casagrande* fails to disclose a commercial skipping feature that is both time and state-based (i.e., is precluded during a first period of

time and allowed during a second period of time only when the DVR is in a second playback state).

Russ is also fundamentally different than the '122 Patent. *Russ* is directed to “broadband communications systems, and more particularly, to the insertion of advertisements into presentations of networked multi-room systems.” Ex. 1008, ¶[0002]. *Russ*’ “primary device” (e.g., set-top box) receives and stores a video presentation including a program and commercials. *See id.*, ¶¶[0015], [0020], [0032], Fig. 4. The “primary device” may replace the existing commercials with alternative commercials tailored to the user of the device. *See id.*, ¶¶[0030], [0032].

The commercial-related functionality in *Russ* is driven by “tags.” *Russ* uses “ad-insertion tags” to “differentiate between the program and commercials.” *See* Ex. 1008, ¶[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]. *Russ* discloses that the same tag can also specify whether the user can fast forward through a commercial (so-called “trick play” functionality). 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.* *Russ* fails to disclose a commercial skipping feature that is both

time and state-based, including transmitting a first portion and a third portion (i.e., frames) of a previously stored video program to a display device, but not transmitting a second portion (i.e., frames) of the video program to the display device, “during said second period of time and [when] said DVR is in said second playback state.” In *Russ*, the transmitted commercial can either be skipped or not. While *Russ* does provide that trick play can be precluded for a period of time, the preclusion ends when the commercial expires. Thus, there is not a period of time when the transmitted commercial can be skipped or not, depending on the state of the DVR.

1. Independent Claim 1

The combination of *Casagrande*, *Russ*, and *Miller* does not render obvious independent claim 1 because the combination does not teach or suggest the following elements of the claim.

- i. 1[a] “a tuner for receiving a plurality of video programs . . .”

Limitation 1[a] recites “a tuner for receiving a plurality of video programs” Ex. 1001 at 11:63-12:6. The “plurality of video programs are transmitted at the same time on a single channel” and “said tuner can be tuned to said single channel to receive said plurality of video programs.” *Id.* at 11:64-12:1. The Petition contends that “Casagrande renders obvious its DVR including multiple tuners, alone or in view of *Russ* and/or *Miller*” and that “*Russ* teaches known tuner features, e.g., ‘extract[ing] channels from the received downstream broadband signals’ and users

selecting a channel to display.” *See* Pet. at 20. But the Petition fails to identify in either reference any disclosure of a “tuner” that receives a “plurality of video programs” that are “transmitted at the same time”—mere generic reference to “multiple tuners” or extracting and decoding signals are not sufficient. *See id.*

The Petitioner also alleges that it would have been obvious to modify *Casagrande’s* tuner to satisfy this limitation. *See* Pet. at 20. But the Petition contains no evidence to support that contention. *See id.* It only cites to disclosures in *Miller* that allegedly disclose this limitation, with the benefit of impermissible hindsight from claim 1. *See id.* The citation to the Jeffay declaration does not cure the deficiencies in the Petition. *See* Pet. at 20 (citing Ex. 1002 ¶110). The Jeffay declaration should be afforded no weight because it does nothing more than restate Petitioner’s argument without any additional supporting evidence or reasoning. *Compare* Pet. at 20 *with* Ex. 1002 ¶110 (Jeffay declaration); *Xerox Corp., et al. v. Bytemark, Inc.*, No. IPR2022-00624, Paper 9, pp. 15-16 (P.T.A.B. Aug. 24, 2022) (Precedential) (denying IPR institution – holding 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, *Miller* discloses recording only one program, not a plurality (i.e., more than one) of video programs as is required by this limitation. *See* Ex. 1009 at Fig. 5 (the “first program” is presented

while the “second program” is recorded). Accordingly, the combination of *Casagrande*, *Russ*, and *Miller* does not teach or suggest this limitation.

- ii. 1[b] “a memory device for storing said plurality of video programs, allowing said one of said plurality of video programs to be played back at a later time”

Limitation 1[b] recites “a memory device for storing said plurality of video programs, allowing said one of said plurality of video programs to be played back at a later time.” Ex. 1001 at 12:7-9. The Petition fails to allege that it would have been obvious to modify *Casagrande* with *Miller* to render obvious this limitation, so the combination of *Casagrande*, *Russ*, and *Miller* does not teach or suggest this limitation. See Pet. at 22-23. Moreover, *Miller* discloses recording only one program, not a plurality (i.e., more than one) of video programs as is required by this limitation. See Ex. 1009 at Fig. 5 (the “first program” is presented while the “second program” is recorded). Accordingly, the combination of *Casagrande*, *Russ*, and *Miller* does not teach or suggest this limitation.

- iii. 1[c] “a controller configured to receive commands from a user of said DVR . . .”

Limitation 1[c] recites “a controller configured to receive commands from a user of said DVR, wherein a first command changes said DVR from a first playback state to a second playback state, a second command initiates playback of said one of said plurality of video programs from said memory device, and a third command instructs said DVR to receive and store said plurality of video programs.” Ex. 1001,

12:10-16 (emphasis added). The Petition contends that the claimed “first playback state” and “second playback state” correspond to whether the first A/V stream or the second A/V stream is displayed to the user:

Regarding the “first command,” Casagrande teaches that “a user may select by way of the user input 1523 whether the first A/V stream 1504 or the second A/V stream 1512 is outputted to the display device 1514,” corresponding to the claimed first and second playback states.

Pet. at 24. And it contends that the “first command” toggles between which stream is displayed. *Id.* But it is the “second command” that initiates playback of a particular program or stream. *See* Ex. 1001, 12:10-16. The claimed “first command,” which places the DVR in a “first playback state” or a “second playback state,” is associated with time-based limitations on navigation through a program, as discussed in further detail below for limitation 1[d]. *See id.*; *see also infra* Section III.D.1(iv).

Moreover, the Petition alleges that the “third command” is disclosed in *Casagrande* by receiving and storing a single A/V stream (AV/stream 1504):

Regarding the claimed “third command,” *Casagrande*’s discloses “user input 1523 directing the operation of the receiving device 1510” (Ex[1006], 18:54-60; Ex[1002] ¶126) the operations including “receiving device 1510, by way of the control logic 1520, [] configured to receive the first A/V stream 1504...and store the A/V stream 1504 in the storage unit 1516.” Ex[1006], 18:64-67; Ex[1002] ¶126.

See Pet. at 25. But the claimed “third command instructs said DVR to receive and store said plurality of video programs,” not only a single program. And the Petition does not content that it would have been obvious to modify *Casagrande* to meet this limitation. *See id.* at 23-25. Even if Petitioner had argued that it would have been obvious to modify *Casagrande* in view of *Miller*, *Miller* actually teaches away from this feature by recording only one program in response to a record command, not a plurality (i.e., more than one) of video programs as is required by this limitation. *See* Ex. 1009 at Fig. 5 (the “first program” is presented while the “second program” is recorded). Accordingly, the combination of *Casagrande*, *Russ*, and *Miller* does not teach or suggest claim limitation 1[c].

iv. 1[d] “at least one processor configured to . . .”

Limitation 1[d] recites “at least one processor configured to” provide different portions of “one of said plurality of video programs” based on the “playback state” of the DVR and when playback is taking place (i.e., whether playback is taking place during the claimed “first period of time” or “second period of time”). Ex. 1001 at

12:17-36. The claim recites three scenarios that define the required configuration of the “at least one processor.” *Id.*

First, the “at least one processor” must

“(i) provide said one of said plurality of video programs in its entirety to a display device in response to receiving said second command during a first period of time”

See id. at 12:17-20. The claimed “one of said plurality of video programs” contains at least three portions. *See id.* at 12:1-3. As a result, under the first scenario, the “at least one processor” must be configured to provide the first, second, and third portions. *See id.* at 12:1-3, 17-20.

Second, the “at least one processor” must

“(ii) provide said one of said plurality of video programs in its entirety to said display device in response to receiving said second command during a second period of time if said DVR is in said first playback state”

See id. at 12:20-24. This scenario occurs when (1) “said DVR is in said first playback state” and (2) “in response to receiving said second command during a second period of time.” *See id.* Here again, the “one of said plurality of video programs” contains at least three portions, so under the second scenario, the “at least one processor” must be configured to provide the first, second, and third portions. *See id.*

Third, the “at least one processor” must

“(iii) provide only a portion of said one of said plurality of video programs to said display device in response to receiving said second command during said second period of time if said DVR is in said second playback state, said portion of said one of said plurality of video programs including at least said first and third portions of said one of said plurality of video programs, wherein said third portion is provided to said display device immediately following said first portion if said second command is received during said second period of time and said DVR is in said second playback state”

See id. at 12:25-36. This scenario occurs when (1) “said DVR is in said second playback state” and (2) “receiving said second command during said second period of time.” *See id.* Under the third scenario, the “at least one processor” provides only a portion of the “one of said plurality of video programs,” not the entirety of the video program as under the first and second scenarios. *Compare id.* at 12:25-36 with *id.* at 12:17-20 (first scenario), 12:20-25 (second scenario). Specifically, the “at least one processor” will provide “at least said first and third portions of said plurality of video programs,” but not the second portion, and “said third portion is provided to said display device immediately following said first portion.” *See id.* at 12:25-36.

In summary, the “at least one processor” is configured such that the user of the DVR cannot skip the “second portion” of the “one of said plurality of video programs” during the “first time period” (i.e., the first scenario). *See id.* at 12:17-

20. Subsequently, during the “second time period,”¹ the “at least one processor” is configured such that the user of the DVR can choose whether to skip the “second portion” of the “one of said plurality of video programs” based on selecting the “first playback state” or the “second playback state” (i.e., the second and third scenarios). *See id.* at 12:18-36. As a result, the user cannot skip the “second portion,” which can be a commercial more proximate to when the “video program” was received, whereas the skip functionality becomes available at a later point in time. *See id.*

The combination of *Casagrande*, *Russ*, and *Miller* as pled in the Petition, does not disclose the first scenario (i.e., limitation 1[d][i]). *See Pet.* at 25-27. The Petition cites to only *Casagrande* for alleged disclosure of the first scenario (i.e., limitation 1[d][i]). *See id.* The cited portions of *Casagrande* show that the first A/V stream may be shown in its entirety even if the user desires to see the second A/V stream “by way of additional information delivered to the receiving device” by the “content provider.” *See Ex. 1006* at 19:66-20:2; *see also id.* at 5:66-6:3. But that limitation by the “content provider” remains the same—there is no determination as to the state of the DVR during this first period of time. The Petition does not argue that it would have been obvious to modify *Casagrande* to satisfy this claim limitation, alone or in

¹ Claim 1 of the ’122 Patent recites that “said second period of time is a period of time after said first period of time.” *Ex. 1001* at 12:37-38.

combination with *Russ* or *Miller*, so the combination of *Casagrande* and *Russ* does not disclose the first scenario (i.e., limitation 1[d][i]).

The combination of *Casagrande*, *Russ*, and *Miller* as pled in the Petition, does not disclose the second scenario (i.e., limitation 1[d][ii]). *See* Pet. at 27-30. *Casagrande* does not disclose the second scenario for the similar reason that the limitation by the “content provider” remains the same—there is no determination based on “receiving said second command during a second period of time” as is required by the claim. *See* Ex. 1006 at 19:66-20:2; *see also id.* at 5:66-6:3. In other words, it is the “content provider” that determines whether a commercial can be skipped—not the time period as claimed.

Nor is the second scenario disclosed by *Russ*. The commercial-related functionality in *Russ* is driven by “tags.” *Russ* uses “ad-insertion tags” to “differentiate between the program and commercials.” *See* Ex. 1008, ¶[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]. *Russ* discloses that the same tag can also specify whether the user can fast forward through a commercial (so-called “trick play” functionality). 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.* Accordingly, *Russ* does not disclose providing “said one of said plurality of video programs in its entirety . . . during a second 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.*

The combination of *Casagrande*, *Russ*, and *Miller*, as pled in the Petition, does not disclose the third scenario (i.e., limitation 1[d][iii]). *See* Pet. at 30-32. Claim 1 requires that the “second portion” of “said one of said plurality of video programs” (e.g., the transmitted commercial) is played back during the first period of time” regardless of the playback state of said DVR. Ex. 1001 at 12:18-21. It is not until the second period of time that the “second portion” (e.g., the transmitted commercial) can be played back or not, depending on the playback state, as selected by the user. *See id.* at 12:21-36. It is this feature—where the transmitted commercial *cannot* be played back *during the first period of time* but *can* be played back *during the second period of time*—that is not disclosed in either *Casagrande*, *Russ*, or *Miller*.

Casagrande discloses that it is the “content provider” that determines whether the transmitted commercial can be skipped “by way of additional information delivered to the receiving device.” *See* Ex. 1006 at 19:66-20:2; *see also id.* at 5:66-6:3. But that limitation by the “content provider” remains the same during the first and second periods of time—there is no determination based on “receiving said second command during a second period of time” as is required by the claim. *See id.*

The same is true for *Russ*. In *Russ*, it is the “tag” that determines whether a commercial can be skipped. *See* Ex. 1008, ¶[0035] (e.g., so-called “trick play” functionality). This is the same tag that specifies an expiration date for the commercial. *Id.* 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.

While *Russ* provides that the “tag” can “preclude trick play for only a specified length of time, such as two weeks,” it goes on to provide that this is because “a commercial could expire after a period of time after which the tag would become inactive or replaceable.” *Id.* Thus, the preclusion of trick play in *Russ* is commercial-dependent, not time-dependent. 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.

Accordingly, the combination of *Casagrande*, *Russ*, and *Miller* does not disclose the third scenario (i.e., limitation 1[d][iii]).

Petitioner's alleged motivations to combine fare no better. *See* Pet. at 33-36. Petitioner argues that because *Casagrande* and *Russ* discuss the general concept of restricting the ability to skip commercials, it would have been obvious to combine the references to arrive at the claimed invention. *See* Pet. at 27-30. Beyond that general, and unsupported, assertion that a person of ordinary skill in the art would find it obvious to combine any references that discuss restricting the ability to skip commercials, the Petition does not identify any specific reasoning to combine or modify the references according to the claimed invention. *See id.* The only support is from the declaration of Dr. Jeffay. *See* Pet. at 27-30 (citing Ex. 1002, ¶¶136-138). But his declaration should be afforded no weight because it does nothing more than restate Petitioner's argument without any additional supporting evidence or reasoning. *Compare* Pet. at 27-30 with Ex. 1002 ¶¶136-138 (Jeffay declaration); *Xerox Corp., et al. v. Bytemark, Inc.*, No. IPR2022-00624, Paper 9, pp. 15-16 (P.T.A.B. Aug. 24, 2022) (Precedential) (denying IPR institution – holding declaration is entitled to little weight when it contains an exact restatement of the petition's arguments without any additional supporting evidence or reasoning).

Indeed, the majority of his opinions cite no supporting evidence. *See* Ex. 1002 ¶¶136-138. Accordingly, Petitioner's remaining obviousness rationale lacks support.

In sum, Petitioner's obviousness rationale for this limitation is driven by hindsight, without any evidence that the claimed invention would have been obvious to a person of ordinary skill in the art.

2. Independent Claims 11 and 18

The Petition does not provide independent analysis for independent claims 11 or 18. *See* Pet. at 14-33. Instead, it contends that the same disclosures in *Dow*, *Russ*, and *Miller* are relevant to each of the independent claims. *See id.* As a result, the Petition fails to show that the combination of *Dow*, *Russ*, and *Miller* renders obvious claims 11 and 18 for the same reasons as claim 1. *See supra* Section III.D.1.

3. Dependent Claims 2-10, 12-17, 19, and 20

Dependent claims 2-10 depend from and add limitations to independent claim 1. Dependent claims 12-17 depend from and add limitations to independent claim 11. Dependent claims 19 and 20 depend from and add limitations to independent claim 18. The combination of *Casagrande*, *Russ*, and *Miller* fails to render obvious independent claims 1, 11, and 18, therefore, that combination fails to render obvious dependent claims 2-10, 12-17, 19, and 20 for at least the same reasons.

E. Ground 2 – *Dow* Does Not Anticipate Claims 1, 3-5, 7-11, 18, and 19 of the '122 Patent.

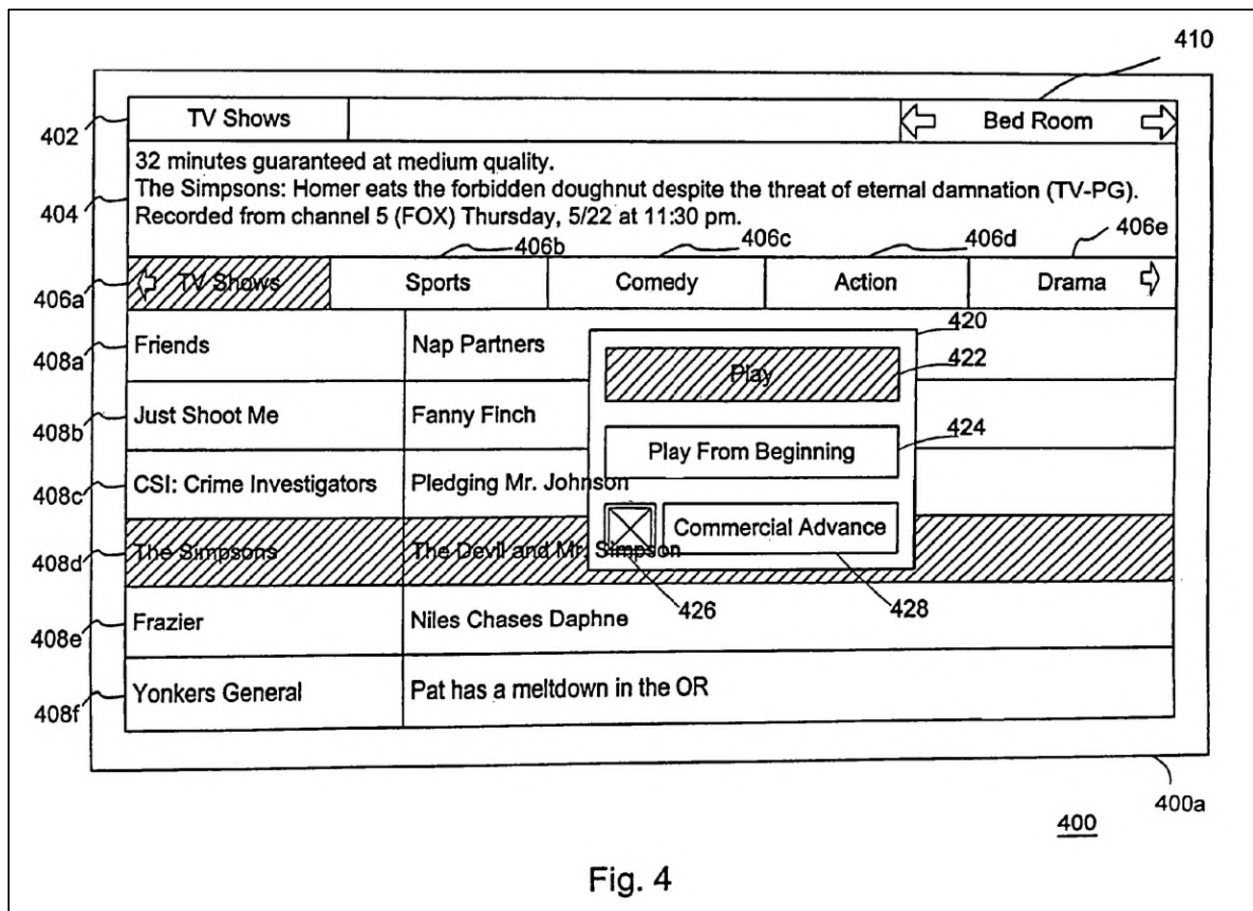
Petitioner contends that *Dow* anticipates claims 1, 3-5, 7-11, 13-16, 18, and 19 of the '122 Patent. Pet. at 8, 44-57. *Dow* does not anticipate those claims for at least the following reasons.

Dow is fundamentally different than the claimed inventions of the '122 Patent. *Dow* was filed on April 26, 2002. Ex. 1007. The context from that filing date is important—*Dow* was filed when DVRs were starting to replace VCRs in the marketplace. One of the first DVR prototypes was made at Stanford University in the fall of 1998. See Ex. 2002; see also Ex. 2003. The first consumer DVRs were demonstrated by Replay Network and TiVo at the 1999 Consumer Electronics Show (CES). See Ex. 2004. *Dow* acknowledges that as of its filing date the transition from VCRs to DVRs was “revolutionizing the way broadcast video content is stored, managed, and viewed.” See Ex. 1007 at 2:61-62.

Dow recognizes that predecessor VCRs included commercial-skipping functionality. See *id.* at 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.* at 3:14-48. *Dow* purports

to “provide improved detection of events in a video signal or data stream” by “calculating the luminance of at least a portion of a video frame, and comparing the luminance against a threshold value.” *See id.* at 3:53-57. The specification focuses on the details of how to implement *Dow’s* purported improvements to event detection. *See generally* Ex. 1007.

With respect to navigation through those events (e.g., skipping commercials), *Dow* discloses a simple toggle for whether the “Commercial Advance” (426 in Fig. 4) feature is enabled:



Ex. 1007, Fig. 4. “The commercial skip toggle 426 indicates whether the commercial skip feature is enabled or not.” *Id.* at 11:57-58. When the feature is enabled, “commercials will be skipped regardless of the play mode selected.” *Id.* at 11:59-61 (emphasis added). *Dow* does not, however, disclose the time-based limitations on navigation through a program claimed in the ’122 Patent that were recognized by the inventor of the ’122 Patent as DVR technology matured.

Nor does *Dow* disclose a “tuner” that receives a “plurality of video programs” that are “transmitted at the same time,” so *Dow*’s DVR cannot store the claimed “plurality of video programs” in response to “a [single] third command.” In fact, the Petition concedes that the tuner in *Dow* is capable of receiving only one video program at a time, which is why recording more than one program using the DVR of *Dow* necessarily requires more than one tuner:

The DVR user “select[s] one *or more* of the programs for recording,” which necessarily includes multiple tuners. Ex[1007], 6:14-15; Ex[1002] ¶308. The AV input module, which contains the DVR’s tuner, may be scaled to enable the simultaneous processing of video programs. Ex[1002] ¶308.

Pet. at 52 (emphasis added).

1. Independent Claim 1

Dow does not anticipate independent claim 1 because it does not disclose the following elements of the claim.

- i. 1[a] “a tuner for receiving a plurality of video programs
...”

Limitation 1[a] recites “a tuner for receiving a plurality of video programs” Ex. 1001 at 11:63-12:6. The “plurality of video programs are transmitted at the same time on a single channel” and “said tuner can be tuned to said single channel to receive said plurality of video programs.” *Id.* at 11:64-12:1. But the Petition ignores those requirements. *See* Pet. at 45. The Petition cites to column 12, lines 21-32 of *Dow* as allegedly disclosing this claim limitation. *See id.* (citing Ex. 1002, 12:21-23, 12:31-32, 12:33-34). That portion of *Dow* is reproduced below in its entirety:

The AV input module **510** receives an external signal, such as a broadcast signal, signal from another playback device, or packetized communication signal. The AV input module **510** directs content data corresponding to the content of the received signal to the data storage **550**. The AV input module **510** may provide conversion, indexing, event detection, and compression based upon the received content data. In the embodiment shown, the AV input module includes a tuner **512**, an A/D converter **514**, indexing logic **516**, an event detector **518**, and a compression encoder **520**.

The tuner **512** is a conventional tuner for selecting a signal or channel from a spectrum of available signals or channels. A tuner may be unnecessary where the data carrier consists of a single signal or channel.

Ex. 1007 at 12:21-34. *Dow* contains no disclosure of a “plurality of video programs [that] are transmitted at the same time on a single channel.” *See id.* And it contains no disclosure that “said tuner can be tuned to said single channel to receive said plurality of video programs.” *See id.* In fact, later the Petition concedes that the tuner in *Dow* is capable of receiving only one video program at a time, which is why recording more than one program using the DVR of *Dow* necessarily requires more than one tuner:

The DVR user “select[s] one *or more* of the programs for recording,” which necessarily includes multiple tuners. Ex[1007], 6:14-15; Ex[1002] ¶308. The AV input module, which contains the DVR’s tuner, may be scaled to enable the simultaneous processing of video programs. Ex[1002] ¶308.

Pet. at 52 (emphasis added).

The Petition also argues that “*Dow* also recognizes the use of a tuner to access multiple programs on a single channel by explaining that a tuner is optional ‘where the data carrier consists of a single channel or channel.’” Pet. at 45 (citing Ex. 1007 at 12:33-34). But again, that section of *Dow* is silent about the channel containing a “plurality of video programs [that] are transmitted at the same time on a single channel.” *See* Ex. 1007 at 12:33-34. Moreover, that section of *Dow* is not relevant because it describes receiving a program without a tuner, whereas the claim requires a tuner. *Compare id. with* Ex. 1001 at 11:63-12:6.

The citation to paragraph 282 of the Jeffay declaration does not cure the deficiencies in the Petition. *See* Pet. at 45 (citing Ex. 1002 at ¶ 282). The Jeffay declaration should be afforded no weight because it does nothing more than restate Petitioner’s argument without any additional supporting evidence or reasoning. *Compare* Pet. at 45 *with* Ex. 1002 ¶ 282 (Jeffay declaration); *Xerox Corp., et al. v. Bytemark, Inc.*, No. IPR2022-00624, Paper 9, pp. 15-16 (P.T.A.B. Aug. 24, 2022) (Precedential) (denying IPR institution – holding declaration is entitled to little weight when it contains an exact restatement of the petition’s arguments without any additional supporting evidence or reasoning).

Accordingly, *Dow* does not anticipate limitation 1[a].

- ii. 1[b] “a memory device for storing said plurality of video programs, allowing said one of said plurality of video programs to be played back at a later time”

Limitation 1[b] recites “a memory device for storing said plurality of video programs, allowing said one of said plurality of video programs to be played back at a later time.” Ex. 1001, 12:7-9. Because *Dow* fails to anticipate limitation 1[a], it also fails to anticipate storing “said plurality of video programs” that are received via the “tuner” in limitation 1[a]. Accordingly, *Dow* does not anticipate limitation 1[b].

- iii. 1[c] “a controller configured to receive commands from a user of said DVR . . .”

Limitation 1[c] recites “a controller configured to receive commands from a user of said DVR, wherein a first command changes said DVR from a first playback state to a second playback state, a second command initiates playback of said one of said plurality of video programs from said memory device, and a third command instructs said DVR to receive and store said plurality of video programs.” Ex. 1001, 12:10-16 (emphasis added). The Petition contends that the claimed “first playback state” and “second playback state” correspond to whether the commercial-skipping functionality in Dow is active or inactive:

Dow’s control interface module “define[s] one or more control signals for toggling the commercial skip function between active and inactive modes, such as a button on (and corresponding control signal from) a remote control.” Ex[1007], 24:29-32. Thus, Dow’s command for toggling the commercial skip function corresponds to the claimed “first command” wherein the toggling changes the DVR between the claimed “first playback state” and “second playback state.”

Pet. at 48. And it contends that the “first command” toggles whether that functionality is active or inactive. *Id.* But the “first playback state” and “second playback state” correspond to more than simply whether commercial-skipping functionality in is active or inactive. *See* Ex. 1001, 12:17-36. They also place time-based limitations on navigation through a program, as discussed in further detail below for limitation 1[d]. *See id.*; *see also infra* Section III.E.1(iv).

In addition, limitation 1[c] requires “a third command instructs said DVR to receive and store said plurality of video programs.” *See* Ex. 1001, 12:15-16. *Dow* does not disclose that limitation because for the same reasons that it does not disclose limitation 1[a]. *See supra* Section III.E.1(i).

Accordingly, *Dow* does not anticipate claim limitation 1[c].

iv. 1[d] “at least one processor configured to . . .”

Limitation 1[d] recites “at least one processor configured to” provide different portions of “one of said plurality of video programs” based on the “playback state” of the DVR and when playback is taking place (i.e., whether playback is taking place during the claimed “first period of time” or “second period of time”). Ex. 1001 at 12:17-36. The claim recites three scenarios that define the required configuration of the “at least one processor.” *Id.*

First, the “at least one processor” must

“(i) provide said one of said plurality of video programs in its entirety to a display device in response to receiving said second command during a first period of time”

See id. at 12:17-20. The claimed “one of said plurality of video programs” contains at least three portions. *See id.* at 12:1-3. As a result, under the first scenario, the “at least one processor” must be configured to provide the first, second, and third portions. *See id.* at 12:1-3, 17-20.

Second, the “at least one processor” must

“(ii) provide said one of said plurality of video programs in its entirety to said display device in response to receiving said second command during a second period of time if said DVR is in said first playback state”

See id. at 12:20-24. This scenario occurs when (1) “said DVR is in said first playback state” and (2) “in response to receiving said second command during a second period of time.” *See id.* Here again, the “one of said plurality of video programs” contains at least three portions, so under the second scenario, the “at least one processor” must be configured to provide the first, second, and third portions.

See id.

Third, the “at least one processor” must

“(iii) provide only a portion of said one of said plurality of video programs to said display device in response to receiving said second command during said second period of time if said DVR is in said second playback state, said portion of said one of said plurality of video programs including at least said first and third portions of said one of said plurality of video programs, wherein said third portion is provided to said display device immediately following said first portion if said second command is received during said second period of time and said DVR is in said second playback state”

See id. at 12:25-36. This scenario occurs when (1) “said DVR is in said second playback state” and (2) “receiving said second command during said second period of time.” *See id.* Under the third scenario, the “at least one processor” provides only a portion of the “one of said plurality of video programs,” not the entirety of the

video program as under the first and second scenarios. *Compare id.* at 12:25-36 with *id.* at 12:17-20 (first scenario), 12:20-25 (second scenario). Specifically, the “at least one processor” will provide “at least said first and third portions of said plurality of video programs,” but not the second portion, and “said third portion is provided to said display device immediately following said first portion.” *See id.* at 12:25-36.

In summary, the “at least one processor” is configured such that the user of the DVR cannot skip the “second portion” of the “one of said plurality of video programs” during the “first time period” (i.e., the first scenario). *See id.* at 12:17-20. Subsequently, during the “second time period,”² the “at least one processor” is configured such that the user of the DVR can choose whether to skip the “second portion” of the “one of said plurality of video programs” based on selecting the “first playback state” or the “second playback state” (i.e., the second and third scenarios). *See id.* at 12:18-36. As a result, the user cannot skip the “second portion,” which can be a commercial more proximate to when the “video program” was received, whereas the skip functionality becomes available at a later point in time. *See id.*

Dow does not disclose any of the three scenarios recited in limitation 1[d]. For the first scenario, the Petition alleges that this limitation is met because “Dow’s

² Claim 1 of the ’122 Patent recites that “said second period of time is a period of time after said first period of time.” Ex. 1001 at 12:37-38.

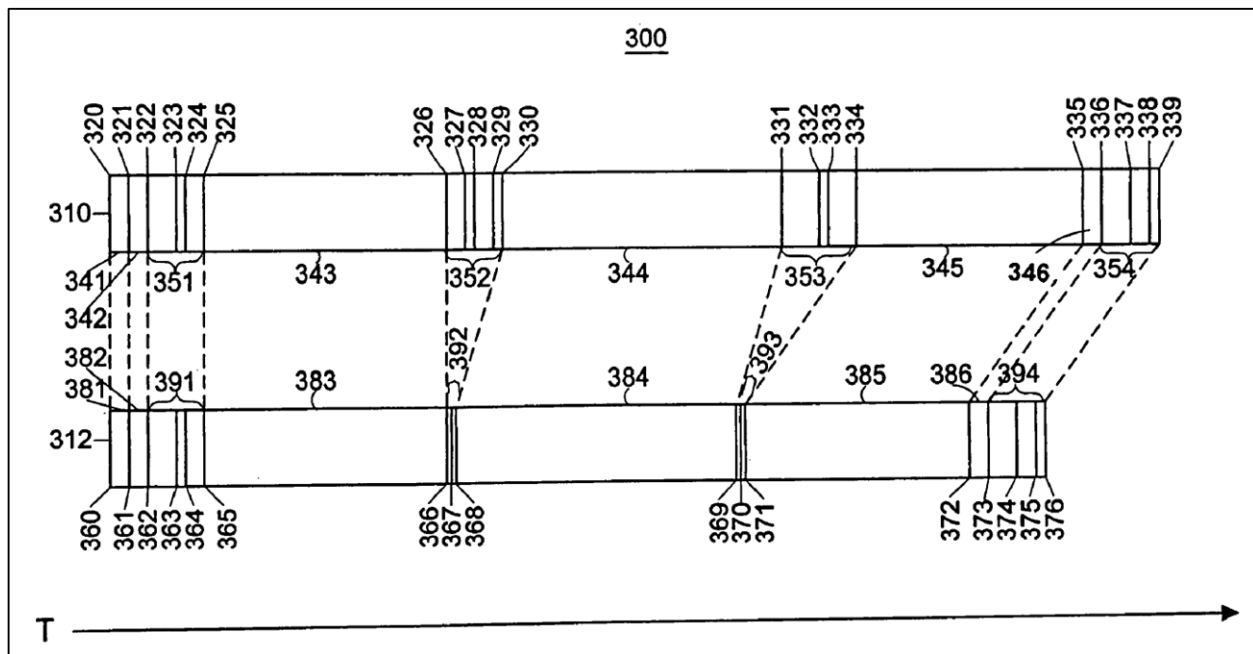
processor will provide the entire program to the display during a first time period, for example, the 2-minute period needed for program buffering and processing—even when the DVR receives the command for skipping commercials (claimed ‘second command’).” Pet. at 49. The Petition identifies the content portions of a program as the claimed “first portion” and “third portion,” whereas the commercials between those portions are identified as the claimed “second portion.” See Pet., pp. 50-51. *Dow’s* DVR cannot “provide said video in its entirety” in its “delayed video mode . . . where there is insufficient time to buffer and process events for identifying commercial groups (e.g., a time delay of less than two minutes)” because the “second portion” has not been fully received and the third portion has not yet been received, let alone stored in a memory device (the claimed invention requires playback from the memory device). See Ex. 1007 at 24:43-48. Accordingly, *Dow* does not disclose the “at least one processor” configured to “(i) provide said one of said plurality of video programs in its entirety to a display device in response to receiving said second command during a first period of time.”

For the second scenario, the Petition cites to *Dow’s* disclosure of “toggling the commercial skip function between active and inactive modes.” See Pet. at 50 (citing Ex. 1007 at 24:29-32). But again, *Dow* does not disclose that function being available or not available based on time. See Ex. 1007 at 24:29-32. Accordingly, *Dow* does not disclose the “at least one processor” configured to “(ii) provide said

one of said plurality of video programs in its entirety to said display device in response to receiving said second command during a second period of time if said DVR is in said first playback state.”

For the third scenario, the Petition cites to Figure 3 in *Dow*, which depicts how a program will be displayed to the user when commercial-skip function is inactive and active. *See* Pet. at 50-51 (citing Ex. 1007 at Fig. 3, 9:40-45, 10:43-47).

Figure 3 is reproduced below:



Ex. 1007 at Fig. 3. The Petition identifies the content portions (343 & 344) of a program as the claimed “first portion” and “third portion,” whereas the commercials between those portions (352) are identified as the claimed “second portion.” *See* Pet. at 50-51 (citing Ex. 1007 at Fig. 3). Timeline 310 depicts the program as originally presented, whereas timeline 312 depicts how the program will be

displayed with the commercial-skip feature active. *See* Ex. 1007 at 9:37-47. Figure 3 and the related written disclosures are silent about the commercial-skip feature becoming available during “a second period of time” when it was not available during “a first period of time.” Accordingly, *Dow* does not disclose the “at least one processor” configured to “(iii) provide only a portion of said one of said plurality of video programs to said display device in response to receiving said second command during said second period of time if said DVR is in said second playback state, said portion of said one of said plurality of video programs including at least said first and third portions of said one of said plurality of video programs, wherein said third portion is provided to said display device immediately following said first portion if said second command is received during said second period of time and said DVR is in said second playback state.”

Again, while *Dow* may provide that “commercial skip is always inactive in live view mode or in delayed view mode,” this feature is mode-based, not time-based as claimed. *See* Ex. 1007 at 24:43-48. It is also before the first, second, and third portions have been received and stored on a memory device, from which playback is initiated. Thus, by definition, this “inactivation” of “commercial skip” cannot be during “said second period of time . . . wherein said second period of time is a period of time after said first period of time.” Ex. 1001 at 11:62-12:16. In other words, inactivating commercial skip before the commercials have been received (or before

the programming after the commercial has been received) is completely different from the claimed invention, where skipping is allowed after the video program (first, second, and third portions) has been received and stored in memory. *Dow* is merely addressing fact that it is impossible to skip a commercial during live or delayed view mode—not prohibiting commercial skip until the commercials “have a diminished value to the user, the content owner, the content provider and/or advertisers.” Ex. 1001, Abstract.

4. Independent Claims 11 and 18

The Petition does not provide independent analysis for independent claims 11 and 18. *See* Pet. at 44-52. Instead, it contends that the same disclosure in *Dow* is relevant to each of the independent claims. *See id.* As a result, the Petition fails to show that *Dow* anticipates claims 11 and 18 for the same reasons as claim 1. *See supra* Section III.E.1.

5. Dependent Claims 3-5, 7-10, 13-16, and 19

Dependent claims 3-5 and 7-10 depend from and add limitations to independent claim 1. Dependent claims 13-16 depend from and add limitations to independent claim 11. Dependent claim 19 depends from and adds limitations to independent claim 18. *Dow* fails to anticipate independent claims 1, 11, and 18, therefore, *Dow* fails to anticipate dependent claims 3-5, 7-10, 13-16, and 19 for at least the same reasons.

F. Ground 3 – The Combination of *Dow*, *Russ*, and *Miller* Does Not Render Obvious Claims 1-20 of the '122 Patent

Petitioner contends that the combination of *Dow*, *Russ*, and *Miller* renders obvious claims 1-20 of the '122 Patent. Pet. at 8, 58-69. The combination of *Dow*, *Russ*, and *Miller* does not render obvious those claims for at least the following reasons.

1. Independent Claim 1

The combination of *Dow*, *Russ*, and *Miller* does not render obvious independent claim 1 because the combination does not teach or suggest the following elements of the claim. As described above in Sections III.D and E, neither *Russ* nor *Dow* discloses the time-based limitations recited in the claims. The same is true for *Miller*. Not only does *Miller* not make up for the deficiencies of *Dow* or *Russ*, but it fails to disclose the features for which it is recited, *i.e.*, using *a single tuner* and *a single record command* to both *receive and record a plurality of video programs*. Accordingly, Petitioner's argument that the combination of *Dow*, *Russ*, and *Miller* is driven by impermissible hindsight rather than evidence of what would have been obvious to a person of ordinary skill in the art at the time of the invention.

- i. 1[a][ii] “said tuner can be tuned to said single channel to receive said plurality of video programs”

Limitation 1[a] recites “a tuner for receiving a plurality of video programs, wherein . . . (ii) said tuner can be tuned to said single channel to receive said plurality

of video programs. . . .” Ex. 1001, 11:63-12:1. The Petition alleges that it would have been obvious to modify *Dow* with *Miller* to satisfy this limitation. *See* Pet. at 58-60. But the Petition contains no evidence to support that contention. *See id.* It only cites to disclosures in *Miller* that allegedly disclose this limitation, with the benefit of impermissible hindsight from claim 1. *See id.* First, as discussed in Section III.D.1(i), *Miller* does not disclose this feature. Second, the citations to the Jeffay declaration do not cure the deficiencies in the Petition. *See* Pet. at 58-60. The Jeffay declaration should be afforded no weight because it does nothing more than restate Petitioner’s argument without any additional supporting evidence or reasoning. *Compare* Pet. at 58-60 with Ex. 1002 ¶¶ 396-399 (Jeffay declaration); *Xerox Corp., et al. v. Bytemark, Inc.*, No. IPR2022-00624, Paper 9, pp. 15-16 (P.T.A.B. Aug. 24, 2022) (Precedential) (denying IPR institution – holding declaration is entitled to little weight when it contains an exact restatement of the petition’s arguments without any additional supporting evidence or reasoning). Accordingly, the combination of *Dow*, *Russ*, and *Miller* does not teach or suggest this limitation.

- ii. 1[b] “a memory device for storing said plurality of video programs, allowing said one of said plurality of video programs to be played back at a later time”

Limitation 1[b] recites “a memory device for storing said plurality of video programs, allowing said one of said plurality of video programs to be played back at

a later time.” Ex. 1001 at 12:7-9. The Petition fails to allege that it would have been obvious to modify *Dow* to render obvious this limitation, so the combination of *Dow*, *Russ*, and *Miller* does not teach or suggest this limitation for at least the same reasons that *Dow* fails to anticipate this limitation. See Pet. at 58-60. Moreover, as discussed in Section III.D.1(ii), *Miller* discloses recording only one program, not a plurality (i.e., more than one) of video programs as is required by this limitation. See Ex. 1009 at Fig. 5 (the “first program” is presented while the “second program” is recorded). Accordingly, the combination of *Dow*, *Russ*, and *Miller* does not teach or suggest this limitation.

- iii. 1[c] “a controller configured to receive commands from a user . . .”

Limitation 1[c] recites “a controller configured to receive commands from a user of said DVR, wherein a first command changes said DVR from a first playback state to a second playback state, a second command initiates playback of said one of said plurality of video programs from said memory device, and a third command instructs said DVR to receive and store said plurality of video programs.” Ex. 1001, 12:10-16. Petitioner does not contend that it would have been obvious to combine *Dow*, *Russ*, and *Miller* to address *Dow*’s failure to disclose limitation 1[c]. See Pet. at 58-62. Accordingly, the combination of *Dow*, *Russ*, and *Miller* does not teach or suggestion limitation 1[c] for the same reasons provided in Section III.E.1(iii).

Moreover, as discussed in Section III.D.1(iii), *Miller* discloses recording only one program, not a plurality (i.e., more than one) of video programs as is required by this limitation. *See* Ex. 1009 at Fig. 5 (the “first program” is presented while the “second program” is recorded). Accordingly, the combination of *Dow*, *Russ*, and *Miller* does not teach or suggest “a third command [that] instructs said DVR to receive and store said plurality of video programs.”

- iv. 1[d][i] “at least one processor configured to (i) provide said one of said plurality of video programs in its entirety . . .”

Limitation 1[d][i] recites “at least one processor configured to (i) provide said one of said plurality of video programs in its entirety to a display device in response to receiving said second command during a first period of time.” Ex. 1001, 12:17-20. Petitioner does not contend that it would have been obvious to combine *Dow*, *Russ*, and *Miller* to address *Dow*’s failure to disclose limitation 1[d][i]. *See* Pet. at 58-62. Accordingly, the combination of *Dow* and *Russ* does not teach or suggestion limitation 1[d][i] for the same reasons provided in Section III.E.1(iv).

- v. 1[d][ii] “at least one processor configured to . . . (ii) provide said one of said plurality of video programs in its entirety . . .”

Limitation 1[d][ii] recites “at least one processor configured to . . . (ii) provide said one of said plurality of video programs in its entirety to said display device in response to receiving said second command during a second period of time if said

DVR is in said first playback state.” Ex. 1001, 12:20-25. For this limitation, Petitioner contends that it would have been obvious to combine *Dow* with *Russ* to overcome the shortcomings in *Dow* because “Russ discloses the desirability of having a second time period (i.e., once the restriction expires) in which the user may elect to skip the commercials or not.” See Pet. at 60-61. But *Russ* does not disclose “providing said video program in its entirety” (i.e., including commercials under Petitioner’s argument) “during a second period of time.”

The commercial-related functionality in *Russ* is driven by “tags.” *Russ* uses “ad-insertion tags” to “differentiate between the program and commercials.” See Ex. 1008, ¶[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]. *Russ* discloses that the same tag can also specify whether the user can fast forward through a commercial (so-called “trick play” functionality). 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.* Accordingly, *Russ* does not disclose providing “said video program in its entirety” because the commercial would either be non-viewable or replaced by a new commercial. See *id.* And Petitioner’s rationale that “Russ

discloses the desirability of having a second time period (i.e., once the restriction expires) in which the user may elect to skip the commercials or not” is not supported by the reference. *See* Pet. at 61. As discussed above, when the restriction expires, so too does the commercial (or its tag), and a new, different commercial is provided.

Petitioner’s remaining obviousness rationale is supported by only the declaration of Dr. Jeffay. *See* Pet. at 60-61 (citing Ex. 1002, ¶¶417-419).³ But his declaration should be afforded no weight because it does nothing more than restate Petitioner’s argument without any additional supporting evidence or reasoning. *Compare* Pet. at 60-61 *with* Ex. 1002, ¶¶417-419 (Jeffay declaration); *Xerox Corp., et al. v. Bytemark, Inc.*, No. IPR2022-00624, Paper 9, pp. 15-16 (P.T.A.B. Aug. 24, 2022) (Precedential) (denying IPR institution – holding declaration is entitled to little weight when it contains an exact restatement of the petition’s arguments without any additional supporting evidence or reasoning). Accordingly, Petitioner’s remaining obviousness rationale lacks support.

In sum, Petitioner’s obviousness rationale for this limitation is driven by hindsight, without any evidence that the claimed invention would have been obvious to a person of ordinary skill in the art.

³ The Petition also cites paragraph 343 of the Jeffay declaration, but that paragraph does not contain any rationale regarding obviousness.

- vi. 1[d][iii] “at least one processor configured to . . . (iii) provide only a portion of said one of said plurality of video programs . . .”

Limitation 1[d][iii] recites “at least one processor configured to . . . (iii) provide only a portion of said one of said plurality of video programs . . .” Ex. 1001, 12:25-38. In arguing that this feature is obvious, Petitioner merely restates its anticipation arguments for *Dow*, and its previous arguments for *Russ* (where trick play is precluded). *See id.* at 62. However, as discussed above, this feature is not disclosed in either *Dow* or *Russ*. In *Dow*, there are no time-based restrictions on commercial skipping after the video program has been received and stored on a memory device—only while the program is being received (as one cannot skip while viewing program live or with a slight (e.g., two minute) delay). *See supra* Section III.E.1(iv). In *Russ*, the commercial skipping restrictions are commercial based, not time-based. The transmitted commercial can either be skipped or it cannot (based on its “tag”). *See supra* Section III.D.1(iv). It does not switch from non-skippable (during a first period of time) to skippable (during a second period of time). Accordingly, *Russ* cannot make up for this deficiency in *Dow*.

2. Independent Claims 11 and 18

The Petition does not provide independent analysis for independent claims 11 or 18. *See* Pet. at 58-62. Instead, it contends that the same disclosures in *Dow*, *Russ*, and *Miller* are relevant to each of the independent claims. *See id.* Moreover, the

Petition fails to even identify what, if any, in elements in claim 11 it would have allegedly been obvious to modify in view of *Miller*. *See id.* at 58-60. As a result, the Petition fails to show that the combination of *Dow*, *Russ*, and *Miller* renders obvious claims 11 and 18 for the same reasons as claim 1. *See supra* Section III.F.1.

3. Dependent Claims 2-10, 12-17, 19, and 20

Dependent claims 2-10 depend from and add limitations to independent claim 1. Dependent claims 12-17 depend from and add limitations to independent claim 11. Dependent claims 19 and 20 depend from and add limitations to independent claim 18. The combination of *Dow*, *Russ*, and *Miller* fails to render obvious independent claims 1, 11, and 18, therefore, that combination fails to render obvious dependent claims 2-10, 12-17, 19, and 20 for at least the same reasons.

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

The Patent Office evaluates Section 325(d) using a “two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8-9 (P.T.A.B. Feb. 13, 2020) (Precedential).

The question of whether proffered art or arguments are “the same or substantially the same” as art or arguments previously presented to the Office is a highly factual inquiry, which may be resolved by reference to the factors set forth in *Becton*. See *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“we have weighed some common non-exclusive factors, such as: (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.”). If, after review of factors (a), (b), and (d), it is determined that the same or substantially the same art or arguments previously were presented to the Patent Office (i.e., first part of the framework is satisfied), then factors (c), (e), and (f) relate to whether the Petitioner has demonstrated a material error by the Office (i.e., second part of the framework). See *Advanced Bionics*, Paper 6 at 10.

A. The First Part of the Framework is Satisfied by Every Reference Asserted in the Petition.

U.S. Patent Publication No. 2009/0238536 (“*Gratton*”) is cited on the face of the ’122 Patent. Ex. 1001, p. 2. Further, during prosecution, the Examiner stated that *Gratton* is “[t]he closest prior art” to the claimed invention. Ex. 1003, p. 99. *Gratton* is directed towards a system and method “for replacing audio data within a recorded audio/video stream is presented.” Ex. 2005, Abstract. *Gratton* discloses a “receiving device” (e.g., set-top box with DVR capabilities) that receives and stores a “first audio/visual stream” and an “audio data segment.” *See id.*, ¶¶[0001], [0031], [0032], Fig. 5. A user may request playback of the “first audio/visual stream” at some point (e.g., “several days, or even weeks”) after the stream was stored in the “receiving device.” *See id.*, ¶¶[0002], [0037]. In response to the user playback request, the “receiving device” may generate a “second audio/visual stream” by replacing a portion of audio in the “first audio/visual stream” with the received “audio data segment,” and then output the “second audio/visual stream” to a “display device.” *See id.*, ¶¶[0010], [0037], Fig. 1, Fig. 3. Alternatively, in response to the user playback request, the “receiving device” may output the “first audio/visual stream” to the “display device.” *See id.*, ¶[0040]. Specifically, the “user may select by way of the user input 523 whether the first audio/video stream 504 or the second audio/video stream 512 is transferred to the display device.” *Id.*

But *Gratton* fails to disclose transmitting the entire video portion during a first time period “regardless of a playback state,” as the independent claims require. Further, *Gratton* fails to disclose transmitting a first portion and a third portion (i.e., frames) of a previously stored video program to a display device, but not transmitting a second portion (i.e, frames) of the video program to the display device, such that the third portion plays on the display device immediately after the first portion. This too is a requirement of the independent claims. Further still, *Gratton* fails to disclose (1) a plurality of programs all transmitted at the same time on a single channel, and (2) a single command that causes a single tuner to tune to the single channel and store the plurality of programs all transmitted at the same time on the single channel, as the independent claims require.

1. *Dow*

As acknowledged by Petitioner, *Dow* is virtually identical to U.S. Patent No. 8,155,498 (“*Dow* ’498”). *See* Pet., p. 70 (*Dow* ’498 “has a similar specification to the Dow reference discussed herein.”). A comparison between the specification of *Dow* and the specification of *Dow* ’498 is attached as Ex. 2006, which shows that the two specifications are nearly identical. As also acknowledged by Petitioner, *Dow* ’498 is cited on the face of the ’122 Patent. *See* Pet., p. 70. Thus, the disclosure *Dow* was considered by Examiner during prosecution of the ’122 Patent. Under

factors (a) and (b) set forth in *Becton*, cited reference *Dow* is substantially the same as art previously presented to the Patent Office.

Dow is also similar to *Gratton*, which the Examiner considered to be the “closest prior art.” Ex. 1003, p. 99. Both references are directed to a receiving device (e.g., DVR) that receives and stores a first audio/video stream. Compare Ex. 1007, 7:40-54, 9:37-47, 10:6-30, Fig. 3, with *Gratton*, ¶¶[0001], [0031], [0032], Fig. 5. In both references, the receiving device generates a second audio/video stream by removing a portion of the first audio video/ stream. Compare Ex. 1007, 10:6-50, 24:29-33, Fig. 3, with *Gratton*, ¶¶[0010], [0037], Fig. 1, Fig. 3. Both references enable the user to select between playback of the first or second audio/visual stream. Compare Ex. 1007, 11:57-12:4, 24:29-32, Fig. 4, with *Gratton*, ¶[0040]. Like *Gratton*, *Dow* also fails to disclose transmitting the entire video program during a first time period “regardless of a playback state of said DVR,” as the independent claims require. Further, like *Gratton*, *Dow* also fails to disclose (1) a plurality of programs all transmitted at the same time on a single channel, and (2) a single command that causes a single tuner to tune to the single channel and store the plurality of programs all transmitted at the same time on the single channel, as the independent claims require. Accordingly, *Dow* is in fact cumulative with respect to *Gratton* and discloses information already considered by the USPTO. Thus, under

factors (a) and (b) set forth in *Becton*, cited reference *Dow* is substantially the same as art previously presented to the Patent Office.

Further, Ground 2 of the Petition relies solely on *Dow*, which is nearly identical to *Dow* '498, to disclose all the limitations of the independent claims. Pet., p. 44. Ground 3 modifies *Dow* in view of an alleged teaching in *Miller* related to a single channel and multiplexing. See Pet., pp. 58-60. *Miller* is only used for one limitation. See *id.* Thus, even if Ground 3 were considered new by the Board due to the inclusion of *Miller*, the Board would still need to fully reconsider *Dow* in relation to Ground 2 and substantially reconsider *Dow* in relation to Ground 3. This would not be an efficient use of the Office's resources and defeat the goal set forth in *Advanced Bionics* to defer to previous Office determinations. *Advanced Bionics* at 10. ("At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.").

2. *Casagrande*

Casagrande is similar to *Gratton*, which the Examiner considered to be the "closest prior art." Ex. 1003, p. 99. Both references are directed to a receiving device (e.g., DVR) that receives and stores a first audio/video stream. Compare Ex. 1006, 2:33-47, Fig. 7, Fig. 8, Fig. 15, with *Gratton*, ¶¶[0001], [0031], [0032], Fig. 5. In both references, the receiving device generates a second audio/video stream by removing a portion of the first audio video/ stream. Compare Ex. 1006, 8:63-9:5,

13:13-31, Fig. 4, Fig. 8, *with Gratton*, ¶¶[0010], [0037], Fig. 1, Fig. 3. Both references enable the user to select between playback of the first or second audio/visual stream. *Compare* Ex. 1006, 19:63-66, *with Gratton*, ¶[0040]. Like *Gratton*, *Casagrande* fails to disclose transmitting the entire video program during a first time period “regardless of a playback state of said DVR,” as independent claim 1 requires. Further, like *Gratton*, *Casagrande* fails to disclose (1) a plurality of programs all transmitted at the same time on a single channel, and (2) a single command that causes a single tuner to tune to the single channel and store the plurality of programs all transmitted at the same time on the single channel, as the independent claims require. Accordingly, *Casagrande* is in fact cumulative with respect to *Gratton* and discloses information already considered by the Patent Office. Thus, under factors (a) and (b) set forth in *Becton*, cited reference *Casagrande* is substantially the same as art previously presented to the USPTO.

3. *Russ*

Russ, cited in the Petition, is similar to *Gratton*, which the Examiner considered to be the closest prior art. Ex. 1003, p. 99. Both references are directed to a receiving device (e.g., DVR) that receives and stores a first audio/video stream. *Compare* Ex. 1008, ¶¶[0015], [0020], [0032], Fig. 4, *with Gratton*, ¶¶[0001], [0031], [0032], Fig. 5. In both references, the receiving device generates a second audio/video stream by removing a portion of the first audio video/stream. *Compare*

Ex. 1008, ¶¶[0030], [0032], *with Gratton*, ¶¶[0010], [0037], Fig. 1, Fig. 3. Both references enable the user to manipulate playback of an audio/visual stream. *Compare* Ex. 1008, ¶¶ [0034], [0035], *with Gratton*, ¶[0040]. Like *Gratton*, *Russ* fails to disclose ignoring a user's request (via the selected playback state) to not transmit a portion (i.e., frames) of a previously stored video program to the display device if a separate user playback request is received during a first time period, as the independent claims require. Further, like *Gratton*, *Russ* fails to disclose transmitting a first portion and a third portion (i.e., frames) of a previously stored video program to a display device, but not transmitting a second portion (i.e., frames) of the video program to the display device, such that the third portion plays on the display device immediately after the first portion. This too is a requirement of the independent claims. Further still, like *Gratton*, fails to disclose (1) a plurality of programs all transmitted at the same time on a single channel, and (2) a single command that causes a single tuner to tune to the single channel and store the plurality of programs all transmitted at the same time on the single channel, as the independent claims require. Accordingly, *Russ* is in fact cumulative with respect to *Gratton* and discloses information already considered by the Patent Office. Thus, under factors (a) and (b) set forth in *Becton*, cited reference *Russ* is substantially the same as art previously presented to the Patent Office.

4. *Miller*

Miller is directed to “apparatus, systems and methods for concurrently presenting and recording program content received via a single carrier signal.” Ex. 1008, ¶[0001]. But similar to *Gratton*, *Miller* fails to disclose providing the entire video program during a first time period regardless of the playback state, as the independent claims require. Further, like *Gratton*, *Miller* fails to disclose transmitting a first portion and a third portion (i.e., frames) of a previously stored video program to a display device, but not transmitting a second portion (i.e., frames) of the video program to the display device, such that the third portion plays on the display device immediately after the first portion. This too is a requirement of the independent claims. Further still, like *Gratton*, *Miller* fails to disclose (1) a plurality of programs all transmitted at the same time on a single channel, and (2) a single command that causes a single tuner to tune to the single channel and store the plurality of programs all transmitted at the same time on the single channel, as the independent claims require. Accordingly, *Miller* is in fact cumulative with respect to *Gratton* and discloses information already considered by the Patent Office. Thus, under factors (a) and (b) set forth in *Becton*, cited reference *Miller* is substantially the same as art previously presented to the Patent Office.

5. Conclusion

The first part of the § 325(d) framework is satisfied for every reference cited in the Petition.

B. The Second Part of the Framework is Satisfied, So Institution Should Be Denied.

As discussed above, during prosecution, the Examiner stated that *Gratton* is the “closest prior art.” Ex. 1003, pp. 99. Petitioner has not pointed out how the Examiner erred in its evaluation of *Gratton*, which is substantially the same as at least primary references *Dow* and *Casagrande*. See Pet., pp. 69-70. The Declaration of Dr. Jeffay provided by Petitioner also does not point out sufficiently how the Examiner erred in its evaluation of *Gratton*. See Ex. 1002. At most, Petitioner states that “the combinations presented in the Petition are not redundant to any combination of references considered during prosecution.” Pet., p. 70. That implies that Petitioner agrees with the Examiner and the Office did not err. Accordingly, the second part of the framework is also satisfied, and institution should be denied under 35 U.S.C. § 325(d).

As also discussed above, *Dow* '498 is cited on the face of the '122 Patent, and *Dow* '498 is virtually identical to *Dow*. While Petitioner may have attempted to demonstrate that *Dow* (and thus *Dow* '498) discloses every limitation of the independent claims in the '122 Patent, upon closer inspection, *Dow* does not (discussed above). Petitioner has not shown how the Office erred with respect to

Dow. Accordingly, the second part of the framework is also satisfied, and institution should be denied under 35 U.S.C. § 325(d).

V. CONCLUSION

The Petition should be denied. Petitioner has not established that the cited references render unpatentable any challenged claim of the '122 Patent. Alternatively, the Board should exercise its discretion to deny institution under 35 U.S.C. § 325(d).

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), I hereby certify that the foregoing Patent Owner's Preliminary Response contains 12,537 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: September 18, 2023

Respectfully submitted,

By: /Todd E. Landis/
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on September 18, 2023, 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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