

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.

IPR2023-00977

Attorney Docket No.: 081841.0149

**PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE TO
PETITION FOR *INTER PARTES* REVIEW OF**

U.S. PATENT NO. 9,538,122

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PETITIONER’S EXHIBIT LIST

Ex. No.	Description of Documents
1001	U.S. Patent No. 9,538,122 (“ 122 Patent ”)
1002	Declaration of Dr. Kevin Jeffay
1003	Prosecution File History of the ’122 Patent
1004	Complaint, <i>Digital Broadcasting Solutions, LLC v. DISH Network L.L.C.</i> , United States District Court for the Eastern District of Texas, Case No. 2:22-CV-00335, Dkt. No. 1
1005	Infringement Contentions, <i>Digital Broadcasting Solutions, LLC v. DISH Network L.L.C.</i> , United States District Court for the Eastern District of Texas, Case No. 2:22-CV-00335
1006	U.S. Patent No. 8,510,771 to Casagrande et al., entitled “Methods and apparatus for filtering content from a presentation stream using signature data” (“ Casagrande ”)
1007	U.S. Patent No. 7,251,413 to Dow et al., entitled “System and method for improved blackfield detection” (“ Dow ”)
1008	U.S. Patent App. Pub. No. 2006/0225105 by Russ, entitled “Networked multi-room system ad insertion” (“ Russ ”)
1009	U.S. Patent App. Pub. No. 2009/0165057 by Miller et al., entitled “Concurrent program content processing apparatus, systems, and methods” (“ Miller ”)
1010	Order Carrying DISH’s Motion to Change Venue, <i>Digital Broadcasting Solutions, LLC v. DISH Network L.L.C.</i> , United States District Court for the Eastern District of Texas, Case No. 2:22-CV-00335, Dkt. No. 41
1011	DISH’s Supplemental Brief in Support of its Motion to Transfer (Public Redacted Version), <i>Digital Broadcasting Solutions, LLC v. DISH Network L.L.C.</i> , United States District Court for the Eastern District of Texas, Case No. 2:22-CV-00335, Dkt. No. 44

Ex. No.	Description of Documents
1012	Docket Control Order, <i>Digital Broadcasting Solutions, LLC v. DISH Network L.L.C.</i> , United States District Court for the Eastern District of Texas, Case No. 2:22-CV-00335, Dkt. No. 28
1013	<i>Intentionally left blank</i>
1014	Declaration of Dr. Kevin Jeffay in Support of Petitioner’s Reply
1015	U.S. Patent No. 8,489,990 to Radloff et al., entitled “Playlists and bookmarks in an interactive media guidance application system”
1016	U.S. Patent No. 7,612,898 to Josephsen et al., entitled “Hard imaging systems, articles of manufacture, and hard imaging methods”
1017	U.S. Patent No. 6,448,986 to Smith, entitled “Method and system for displaying graphical objects on a display screen”
1018	U.S. Patent App. Pub. No. 2007/0136692 by Seymour et al., entitled “Enhanced visual feedback of interactions with user interface”
1019	U.S. Patent App. Pub. No. 2006/0274086 by Forstall et al., entitled “Clipview applications”
1020	Transcript of Deposition of Dr. Immanuel Freedman

I. INTRODUCTION

Patent Owner (“PO”)’s Response—Paper 11 (“POR”)—repeats nearly all the same unavailing arguments raised in its Patent Owner Preliminary Response (“POPR”). But because PO’s Response and accompanying submissions fail to rebut Petitioner’s showing that the challenged claims are invalid, there is no need for the Board to depart from its findings at the Petition stage. Accordingly, the challenged claims should be canceled.

As to the merits, the Board should determine that Dr. Immanuel Freedman’s testimony is unreliable or, at a minimum, unhelpful to the validity analysis of the ’122 Patent. Dr. Freedman’s deposition testimony and declaration are rife with contradictory statements that fail to clarify any issue presented before the Board. The Board should also reject PO’s proposed claim constructions: the Board should again find that the challenged claims do not recite a “determining” step and should reject PO’s attempt to improperly narrow the “first period of time” and “first command.” Finally, the Board should reject PO’s arguments regarding the prior art, which ignore the relevant teachings that render the claims unpatentable.

II. PATENT OWNER’S EXPERT IS UNRELIABLE

PO’s Response relies heavily on a 60-page declaration from Dr. Freedman to support its claim construction and prior art analysis. *See generally* Ex[2008]. However, Dr. Freedman’s cross-examination testimony showed a lack of understanding of the ’122 Patent and the prior art. For example, Dr. Freedman

explained in his deposition that “the first playback state is, in my opinion, a state where the DVR is not playing. And the second playback state, in my view, is a state in which the DVR is playing.” Ex[1020],57:23-58:3. However, the plain language of claim 1 makes clear that the first and second playback states have nothing to do with whether the device is playing but relate to which version of the program will be played (e.g., the entire program or the shortened version). See Ex[1001],12:12-13.

In addition to demonstrating a lack of understanding of key claim elements, Dr. Freedman repeatedly tried to import or remove express limitations from the claims. When initially asked about the commands themselves, Dr. Freedman explained that the user had nothing to do with the commands. See Ex[1020],61:2-3 (“We’re not speaking about users anywhere in this.”). Only after Petitioner’s counsel pointed him to the express language in the claims did Dr. Freedman admit that “[t]he commands are from a user.” *Id.*,61:11-12. Similarly, Dr. Freedman argued that the first and second periods of time “relate to time since the first command.” *Id.*,70:4. Nothing in the claims supports a reading that the first and second period of time are tied to when the first command is entered.

For at least these reasons, Dr. Freedman’s testimony is unreliable and should be ignored.

III. CLAIM CONSTRUCTION

PO’s construction for the “first period of time” recited in claim element

1[d][i] and “first command” recited in claim element 1[c] offer exclusionary definitions that are not supported by the intrinsic record of the ’122 Patent and should be rejected.

A. “first period of time”

PO argues that the plain language of claim 1 requires the “first period of time” begin *after* the entire video program has been transmitted to the DVR. POR,6. This departs from the term’s plain and ordinary meaning and is inconsistent with the specification and claims.

The Federal Circuit has found it “axiomatic that [it] will not narrow a claim term beyond its plain and ordinary meaning unless there is support for the limited in the words of the claim, the specification, or the prosecution history.” *Wasica Finance GmbH v. Continental Automotive Sys., Inc.*, 853 F.3d 1272, 1281 (Fed. Cir. 2021). Where a preferred embodiment in the specification describes the invention in a particular way—even if it is the sole example—it is improper to import those limitations into the claims “absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited.” *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913, 915 (Fed. Cir. 2004).

PO’s proposed construction of “first period of time” improperly excludes embodiments listed in the ’122 Patent’s specification. PO points to portions of claims 1, 6, and 13, the specification, and the prosecution history of the parent patent—U.S. Patent No. 8,929,710 (“the ’710 Patent”)—that allegedly support its

proposed construction. POR,7-8. But PO ignores the undisputable fact that the term's only explicit requirement is that the "first period of time" must occur before the claimed second period of time. See Ex[1001],12:15-16.

PO argues that dependent claims 6 and 13 support its construction because both claims define a first period of time as some period of time that runs after "transmission" of the content. POR,7. However, the narrowed scope found in claims 6 and 13 actually supports a finding that the "first period of time," as found in independent claim 1, is not limited to occurring after the entire program has been transmitted, else these claims would be superfluous. *Phillips*, 415 F.3d at 1314-15.

Similarly, PO argues that portions of the specification and prosecution history discuss recording/storing the content and then playing it back in its entirety. POR,7-8. This construction excludes "live" content that is being buffered or delayed by the set-top box from the scope of the claims. *Id.*,7. However, the specification expressly contemplates the opposite:

It should be appreciated that the term ***"time-shifted data," as used herein is not limited to data that is recorded and watched hours or days later.*** For example, most DVRs include a buffer, which buffers data that is being viewed in real-time. The buffer is used so that ***live data can be paused*** for a predetermined period of time (determined by the size of the buffer). However, ***pausing a program and then pressing "play," results in a program that is time-shifted, if only by a couple of seconds.***

Ex[1001],5:5-17 (emphasis added). The statements PO cites do not support limiting the claims to include only one of these embodiments.

Because the claims require only that the first period of time occur before the second time, and because PO's proposed construction would exclude half of the specification's embodiments, the Board should reject PO's proposed construction. Accordingly, the Board should construe the term in accordance with its plain and ordinary meaning or, alternatively, construe the term as "a time period beginning before a second period of time."

B. "first command"

Next, PO's proposed construction of the claimed "first command" recited in claim element 1[c] is not substantively different the arguments it raised in its POPR, which the Board correctly rejected.

PO argues the claimed "first command" excludes the initiation of playback. POR,8. According to PO's Response, which relies on the testimony of Dr. Freedman, because independent claim 1 recites two commands, the second of which "initiates playback of [the] video program from [the] memory device," a person of ordinary skill in the art ("POSA") would not have interpreted the "first command" as capable of initiating playback. Ex[1001],12:17-37. But the challenged claims recite no such restriction. The "first command," as claimed, requires only that the *playback state* of the DVR be changed from a first playback state to a second playback state. *See id.*

Accordingly, the Board should reject PO's improperly narrowed construction.

IV. THE PRIOR ART RENDERS THE CHALLENGED CLAIMS INVALID.

A. Ground 1: Claims 1-20 are Obvious Over Casagrande in View of Russ and Miller.

PO concedes that both Casagrande, Russ, and Miller are directed to DVR systems having commercial skip features and “trick play” preclusion functionalities. POR,9-10,13. PO’s Response only substantively challenges independent claim elements 1[a], 1[b], 1[c], and 1[d] and claims that merely repeat the limitations recited in those elements, which are addressed below.

1. Casagrande-Russ-Miller combination teaches or renders obvious claim elements 1[a]; 11[a]; 18[pre][ii]; and 18[a].

Casagrande in view of Russ and Miller renders obvious claim element 1[a].

PO contends that “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.” POR,12 (quoting Paper 1 (“Petition”),20). But PO’s conclusory mischaracterization lacks supporting analysis. Indeed, PO’s Response does not address Casagrande’s receiving device, Russ’s set-top box, and Miller’s “receiving device **comprising a tuner**,” which disclose, or render obvious, at least one tuner consistent with the tuner recited in claim 1. Ex[1009]¶0002 (emphasis added); *see also* Ex[1008]¶¶0020,0033; Ex[1006],17:62-18:2. Further, PO’s Response incorrectly states that “Miller

discloses recording only one program, not a plurality (i.e., more than one) of the video programs as is required by this limitation.” POR,13.

Patent Owner ignores the explicit disclosures of Miller as cited in the Petition. For example, the Petition explains that “Miller [provides] ‘various techniques to facilitate the concurrent utilization of program content communicated via a single carrier signal’ such as “receiving via a single content stream selector a multiplexed signal containing multiple distinct programs.’” Petition,18 (quoting Ex[1009]¶0032 and citing Ex[1002]¶104). Indeed, when pointed to this same paragraph of Miller in his deposition, Dr. Freedman, PO’s expert, confirmed that it covered the claimed tuner:

Q: Is that the type of tuner that you think is within the scope of the claims of the ’122 patent?

A. In my view, that would be how a [POSA] would read it.

Ex[1020],85:15-20.

Thus, Casagrande in view of Miller and Russ renders obvious claim element 1[a].

Regarding element 1[b], PO asserts that Petitioner fails to show it would have been obvious to modify Casagrande with Miller to arrive at this element’s “memory device.” POR,14. But the petition establishes that Casagrande alone teaches element 1[b] through Casagrande’s storage unit 1516 storing multiple video programs for playback. Pet., 22-23.

2. Casagrande-Russ-Miller combination teaches or renders obvious claim elements 1[c]; 11[b]; 11[d]; 11[e]; and 18[c].¹

Casagrande renders obvious claim element 1[c].

PO's proposed construction of a "first command" should be rejected. *See supra* §III.B. Nonetheless, Casagrande discloses the limitations of claim element 1[c] regardless of whether the Board adopts PO's narrow construction of a "first command." Casagrande expressly discloses user-transmitted commands that (1) change the DVR's playback state, (2) initiate playback of videos, and (3) receive and store the plurality of video programs. PO's Response—relying on Dr. Freedman's unreliable declaration—argues that Casagrande lacks "any additional step the user must take to initiate playback after selecting 'the first A/V stream 1504 or the second A/V stream 1514.'" POR,12.

Even if the claimed "first command" must not initiate playback, Casagrande teaches changing the DVR's playback state to a second playback state because it teaches that the user "may select...whether the first A/V stream...or the second A/V stream...is outputted to the display device." Ex[1006], 19:63-66. Notably, this selection may be overwritten by the system, so this user selection does not guarantee that playback of the requested stream is initiated. *Id.*,19:64-10:2; 19:15-19. PO fails

¹ As set forth in the Petition, Miller's teachings are particularly relevant to the "tuner" limitations recited in elements 1[a], 11[a], 18[a] and dependent claims 3, 7, 8, 15-17, and 20.

to explain how either of these user inputs would automatically initiate playback. Indeed, the user interface is described as allowing the user to make multiple designations of segments before playback begins, suggesting there is a separate command used to indicate that selections are complete and playback should begin. *Id.*

Regarding the claimed “second command,” Casagrande explains: “the receiving device ***responsively outputs*** the selected segments.” Ex[1006],4:4-8 (emphasis added); Ex[1002]¶106. Thus, Casagrande satisfies even Dr. Freedman’s narrow interpretation of the claims. Ex[1020],63:8-16. Further, under PO’s narrow view of the claims, the user interaction described in Casagrande renders obvious the claims because it would be obvious to allow the user to first designate a desired program, or program variant to watch (i.e. to select whether a complete first stream, or a shortened second stream is desired, corresponding to the first command) followed by a second command to indicate that selection is complete and playback should begin. Ex[1014]¶9. Such an approach to a user interface (i.e. permitting user selections, followed by a second interaction to show that selection is complete and processing of the selections by the system should begin) was well-known, often described as a “confirmation dialog” or “confirmation prompt” and provides a way to ensure user selection was intentional, not erroneous, and complete. *Id.*; see also Exs[1016]-[1019].

3. Casagrande-Russ-Miller combination teaches or renders obvious claim elements 1[d]; 11[f]; 11[g]; and 18[d].

PO's Response next argues that the combination of Casagrande, Russ, and Miller fails to disclose the three claimed scenarios of playing back the video program.² PO attempts to distinguish the type of commercial skipping in Casagrande from the "time shifting of a video program" in the '122 Patent, arguing that Casagrande only skips commercials based on the commercials' time indices, not based on time since transmission. *See, e.g.*, Ex[1001],11:60-61. However, the '122 Patent does not draw this distinction between commercial-based and time-based skipping. Rather, the '122 Patent is directed toward "time shifting at least a portion of a transmitted video program" and provides three time-based situations for viewing or skipping commercial segments. *Id.* Casagrande, Russ, and Miller render obvious all three scenarios.

- a. Casagrande-Russ-Miller combination teaches providing a video program in its entirety during a first period of time.

Casagrande and Russ disclose, or render obvious this first scenario. Ex[1002]¶¶128-131.

Casagrande specifically teaches that "commercials within a television program may be associated with restrictions against fast forwarding or skipping, and

² PO's Response does not contest Petitioner's showing that Casagrande teaches all structural elements of claim element 1[d]. *See, e.g.*, Petition at 25-32; Ex[1002]¶¶108-111.

a recording device may automatically present the commercial segments regardless of the receipt of user input requesting non-presentation of the segments.” Ex[1006],4:29-32. As Casagrande explains: “a content provider of the first A/V stream 1504 *may prevent the user from maintaining such control.*” *Id.*,19:66-20:2; 5:66-6:3; Ex[1002]¶110. Thus, Casagrande teaches playback of the entire first A/V stream during a first time period (i.e., while restrictions are active), “regardless of” whether the first or second playback state had been requested by the user. Ex[1002]¶111. Moreover, the Petition explains that Russ’s limits on trick-play based on time periods was applicable to the restrictions discussed in Casagrande. Petition,21.

PO argues that Casagrande does not disclose this first scenario because lacks a “determination on whether ‘said second command is received during a first period of time.’” POR,16. Yet, as the Board noted in its institution decision, “there is no ‘determining step of the state of the DVR recited in the claims.’” Paper 8,18. Even if there were, PO’s argument fails for two reasons. First, Casagrande expressly states that its receiving device “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.” Ex[1006],24:53-56 (emphasis added). Dr. Jeffay points out that “even if the user selects a shortened version [of the video program] (e.g., the second A/V stream),” the “additional information delivered to the receiving

device” restricting the user from time-shifting the video program “would be processed using the same control logic.” Ex[1002]¶110-111. Accordingly, the processor in Casagrande’s DVR would similarly be required to “determine,” pursuant to the additional information prohibiting time-shifting of the video program, whether the user-input to fast-forward or skip commercials occurred during a first period of time. *See id.*

Second, 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.” Ex[1008]¶0035.

- b. Casagrande-Russ-Miller combination teaches providing a video program in its entirety during a second period of time.

Casagrande and Russ discloses, or otherwise render obvious, the second scenario. *See* Ex[1002]¶¶132-143.

Casagrande and Russ both disclose precluding “trick play ***for only a specified length of time***, such as two weeks.” Ex[1008]¶0034-35 (emphasis added); Ex[1006],5:67-6:1; Ex[1002]¶135. Once the first period of time ends, either through the expiration of a tag or additional information, Casagrande and Russ teach a second period of time when a user may elect to skip the commercial segments (or not). Ex[1002]¶136.

PO argues that Casagrande does not connect the selection of segments from the menu of available segments to a second command initiating playback of the

video program. But Casagrande expressly discloses menu selection by which a user “may select one or more of the available segments **for presentation.**” Ex[1006],4:1-8. *See supra* at §IV.A.2. Moreover, Casagrande permits the user to select the full length first A/V stream, which in the combination with Russ would be available during the second time period. Ex[1006],19:63-65, 13:5-12.

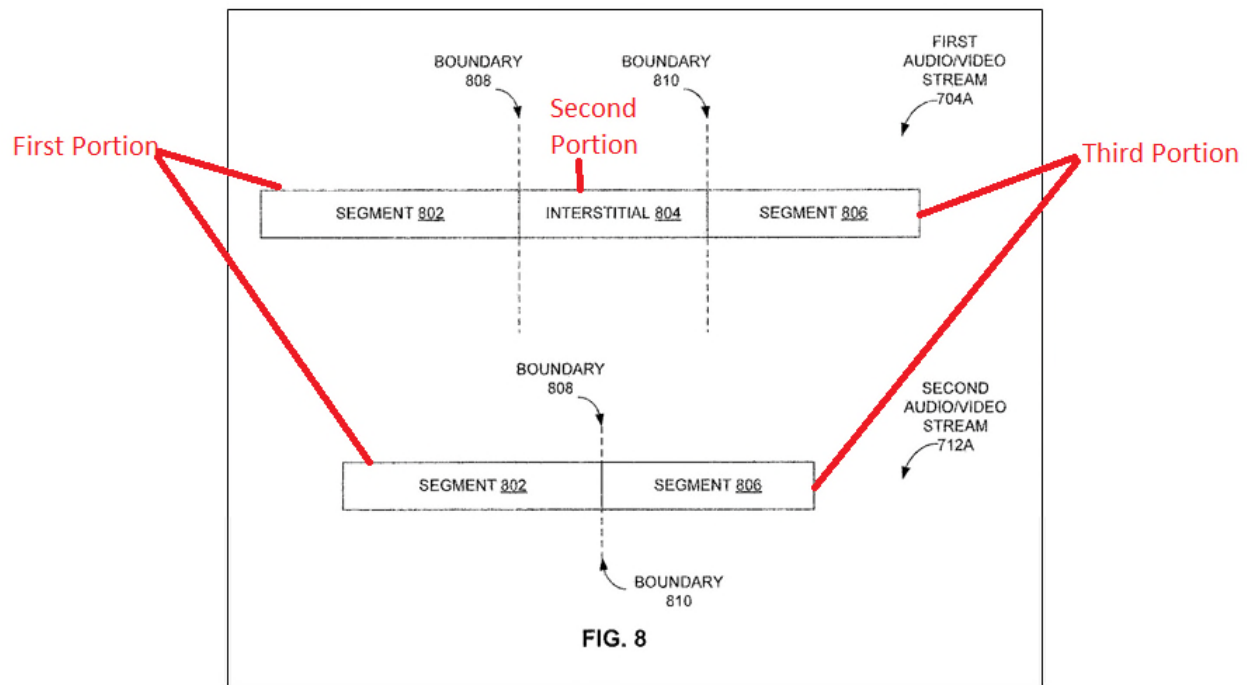
Russ similarly discloses viewing a program in its entirety even though the viewer has the option of utilizing trick play functionalities like fast-forwarding or skipping. According to Russ, “a tag corresponding with a commercial **could** expire after a period of time, after which the tag would become inactive **or replaceable.**” Ex[1008]¶0035 (emphases added). Notably, nothing in Russ prohibits viewing commercials once the tag expires, and, regardless, a POSA would not implement the combination this way because Casagrande states that users may prefer to watch commercials in certain instances. Ex[1006],14:49-51; Ex[1015]¶¶10-11.

PO’s expert argues that “the preclusion of trick play in *Russ* is commercial-dependent, not time-dependent” and, thus, different than the commercial skipping claimed in the ’122 Patent. Ex[2008]¶0079. This argument assumes commercial tags expire after a specified time, after which commercials are never shown. POR at 10. But this interpretation of Russ is inconsistent with Russ’s actual disclosures. Russ teaches using a multipurpose tag to command a primary device to “preclude trick play for only a specified length of time, such as two weeks,” after which, a user

may utilize trick play functionality. Ex[1008]¶¶0034-0035. Regardless, the combination of Casagrande and Russ articulated in the petition expressly includes the ability to watch commercials, even after the first period of time. Petition,35-36.

- c. Casagrande-Russ-Miller combination teaches providing an abbreviated portion of a video program during a second period of time.

Lastly, Casagrande’s “second A/V stream” effectively includes a subset of segments in the original temporal order of the first A/V stream such that the third scenario is rendered obvious. Ex[1002]¶¶144-152. Casagrande discloses a DVR that plays back a recorded program with the ability to perform traditional time-shifting functions such as skipping commercial breaks and other unwanted commercial portions. Ex[1006],1:22-26. Casagrande teaches that, even though a user may desire to view a program without the commercial breaks, “a user may be restricted from temporally moving through particular identified segments.” *Id.*,4:20-22. In other words, during a first time period, Casagrande’s DVR will “automatically output particular segments of a presentation stream without skipping over or otherwise fast forwarding through the segments, regardless of whether a user provides input” requesting skipping or fast forwarding. *Id.*,4:23-26. Thus, time-based commercial skipping is expressly disclosed in Casagrande. *See Id.*,24:23-26; Ex[1002]¶145. This is shown in Casagrande’s Figure 8, annotated below. *Id.*,13:5-8, Fig. 8; Ex[1002]¶145.



“As a result of the filtering...the second segment 806 [third portion] is outputted immediately following the first segment 802 [first segment].” Ex[1006],13:29-31; Ex[1002]¶146.

Moreover, this feature is present when combined with Russ. Russ teaches commanding a primary device to “preclude trick play for only a specified **length of time**, such as two weeks,” after which, a user **may** utilize trick play functionality to achieve the features of the ’122 Patent. Ex[1008]¶¶0034-0035 (emphases added).

Lastly, as with the first scenario, PO’s Response recognizes that “the claims do not expressly recite [a determining step],” but nonetheless contends that the third scenario requires a “determining” step. POR,25. But, as with the first scenario, the Board need not depart from its conclusion that there is no “determining step” in the

claims. See Paper 8,32. Even if the Board were to import PO's "determining" step into the challenged claims, Casagrande alone would still render the "determining" step obvious. Casagrande's DVR expressly "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," which would include Russ's time-based restrictions. Ex[1006],24:53-56 (emphasis added).

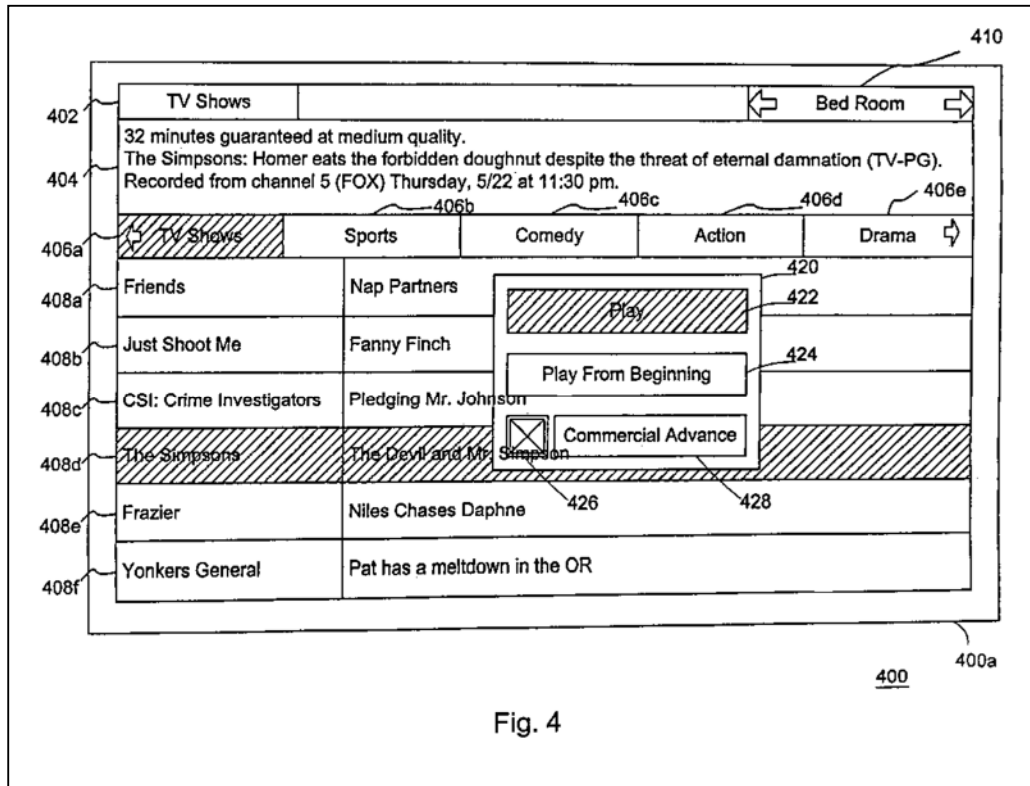
4. Claims depending from Claims 1, 11, and 18

As shown in the Petition and Dr. Jeffay's declaration, Casagrande, Russ, and Miller disclose or render obvious the limitations of the remaining claims. PO asserts that the remaining claims "depend from and add limitations" to the independent claims. POR,29. But PO's Response provides no support from the '122 Patent for this proposition and fails to explain any deficiencies in Petitioner's or Dr. Jeffay's analyses of the remaining challenged claims. Accordingly, PO's arguments should be rejected, and the Board should accept Petitioner's showing that the claims are obvious.

B. Ground 2: Claims 1, 3-5, 7-11, 13-16, and 18-19 Are Anticipated by Dow.

Dow teaches skipping commercial segments of a video program via a control interface module. Ex[1007],24:16-20, 24:55-56. The control interface module, "define[s] one or more control signals for toggling the commercial skip function

between active and inactive modes.” *Id.*,24:29-31. Figure 4, reproduced below, illustrates an example graphical interface with the described control signals:



Dow’s “commercial skip toggle 426 indicates whether the commercial skip features is enabled or not. For example, if the commercial skip toggle 426 is marked (as shown), the commercials will be skipped when the program is played, regardless of the play mode selected.” *Id.*,11:57-61. A user-provided “control signal, such as from the select button, will toggle the toggle 426 between on and off.” Thus, Dow teaches that a user may transmit a first command to set the playback state.

Therefore, Dow is not fundamentally different than the ’122 Patent as PO’s Response argues. Rather, Dow discloses all the limitations of claims 1, 3-5, 7-11, 13-16, and 18-19. Accordingly, Dow anticipates those claims of the ’122 Patent.

PO's Response challenges Petitioner's arguments only as to claim elements 1[a]-1[d] (and the other claim elements reciting the same limitations). As such, the Board should accept Petitioner's unrebutted showing that Dow anticipates the other elements.

1. Dow anticipates elements 1[a]-1[b]; 11[a]; 18[pre][ii]; 18[a]-18[b].

Dow anticipates these element. PO's Response argues that Dow fails to teach a single tuner that receives “plurality of video programs [that] are transmitted at the same time on a single channel.” POR,33 (quoting Ex[1007],12:21-34). But Dow clearly contradicts PO's argument.

As Dr. Jeffay notes, Dow's “AV input module, which “includes a tuner,” “receives an external signal, such as a broadcast signal...of packetized communication signal.” Ex[1007], 12:21-23; Ex[1002] ¶282. Further, Dow teaches that its tuner “may be unnecessary where the data consists of a single signal or channel.” Ex[1002]¶282; Ex[1007],12:33-34. Thus, because data transmitted to Dow's DVR will include more than one program, signal, or channel, a POSA would have understood Dow's tuner is equipped to receive a plurality of programs, signals, or channels at the same time. Ex[1002]¶282.

PO additionally argues that Dr. Jeffay's analysis should be given no weight because Petitioner's analysis aligns with Dr. Jeffay's. POR,34 (citing *Xerox Corp. et al. v. Bytemark, Inc.*, IPR 2022-00624, Paper 9, 15-16 (P.T.A.B. Aug. 24, 2022))

(precedential)). But unlike the *Xerox* case—in which Petitioner’s expert’s declaration “repeated, *verbatim*, the conclusory assertion for which it [was] offered for support”—Dr. Jeffay’s declaration provides specific analysis of the ’122 Patent and Dow to support his positions. *Xerox*, Paper 9, 6. *Cf. Netflix, Inc. v. GoTV Streaming, LLC*, IPR 2023-00757, Paper 11, 67. Petitioner bases its arguments upon Dr. Jeffay’s thorough analysis, not the other way around. *See Netflix*, Paper 11,67. Thus, Dr. Jeffay’s analysis should be fully credited.

PO’s Response argues that Dow fails to anticipate claim limitation 1[b] for the same reason as claim element 1[a]. While Dow anticipates element 1[a], Dow also discloses a “data storage 110 [that] includes ***at least one content file 160***” and the user’s selection of “***one or more programs for recording.***” Ex[1007],6:45-48; 6:14-17 (emphasis added). Thus, Dow anticipates elements 1[a] and 1[b].

2. Dow anticipates elements 1[c]; 11[b], 11[d], 11[e], and 18[c]

Dow anticipates element 1[c]. As stated above, PO’s proposed construction of a “first command” should be rejected. *See supra* §III.B. Nonetheless, Dow expressly discloses user-transmitted commands to the DVR system that (1) change the DVR’s playback state, and (2) initiate playback of the video program. PO construes Petitioner’s proof of these commands too narrowly and ignores Dow’s express disclosure of the functionality of these commands. *See* POR,35.

As noted above, Dow teaches a control interface module that prompts control signals through a user interface.” Ex[1007],24:16-20, 24:55-56. Dow’s control

interface enables a user of Dow's DVR to view videos according to one of two playback states: a first state, where commercial skipping is inactive; and a second state, where commercial skipping is active.

Dow also teaches the second command: "when the play button is pressed."
Id.,24:37-40.

And Dow teaches a third command by teaching the selection of "one or more of the programs for recording" and a "menu overlay 420 [that] displays one or more ways of viewing the previously recorded programs, including using the commercial skipping feature. *Id.*,6:14-15, 11:42-46; Ex[1002]¶¶297-298. Thus, Dow teaches the claimed "third command," and Dow anticipates element 1[c].

3. Dow anticipates elements 1[d]; 11[f]; 11[g]; and 18[d].

PO's Response contends that the commercial skipping modes disclosed in Dow are not affected by time. *See, e.g.*, POR,40, 41, 42. But PO's Response hinges on its proposed construction of a "first period of time," which the Board should reject. *See supra* §III.A. As discussed in further detail below, Dow expressly teaches each scenario, and, as a result, Dow anticipates claim element 1[d].³

a. Dow teaches providing a video program in its entirety during a first period of time.

Dow expressly discloses the first scenario of "provid[ing] the video program

³ As with Ground 1, PO's Response does not contest Petitioner's showing that structural components of the claims are sufficient.

in its entirety” in response to receiving a second command to initiate playback during a first period of time. PO’s Response entirely relies upon its preferred construction of “a first period of time” to assert that Dow’s “live view” or “delayed view” modes cannot anticipate element 1[d][i] because the video program has not yet been fully transmitted to the DVR.

As stated above, PO’s proposed construction of a “first period of time” improperly excludes express features in the ’122 Patent’s specification, such as live viewing. *See supra* §III.A. However, even if the Board were to adopt PO’s proposed construction for the “first period of time,” Dow’s “delayed view” mode is merely a non-limiting example of presenting a video in its entirety during a first period of time. Indeed, Dow specifically teaches that the same DVR components that render commercial skipping “always inactive” during “delayed view” mode are “compatib[le] with other navigation features...activated in the same mode as the navigation function, such as instant replay, slow motion, fast-forward, skip forward, and reverse during playback mode.” Ex[1007],24:49-52. Thus, Dow teaches that “[o]ther relationships to operation mode and control signals may be defined for other navigation functions.” *Id.*,24:52-54. As such, Dow does not limit displaying the entire video program to only its disclosed “live view” or “delayed view” modes. Therefore, Dow teaches the first scenario and anticipates element 1[d][i].

- b. Dow teaches providing a video program in its entirety during a second period of time.

As to the second scenario, Dow teaches providing a video program in its entirety to a display device in response to receiving a second command if the second command is received during a second period of time and the DVR is in a first playback state.

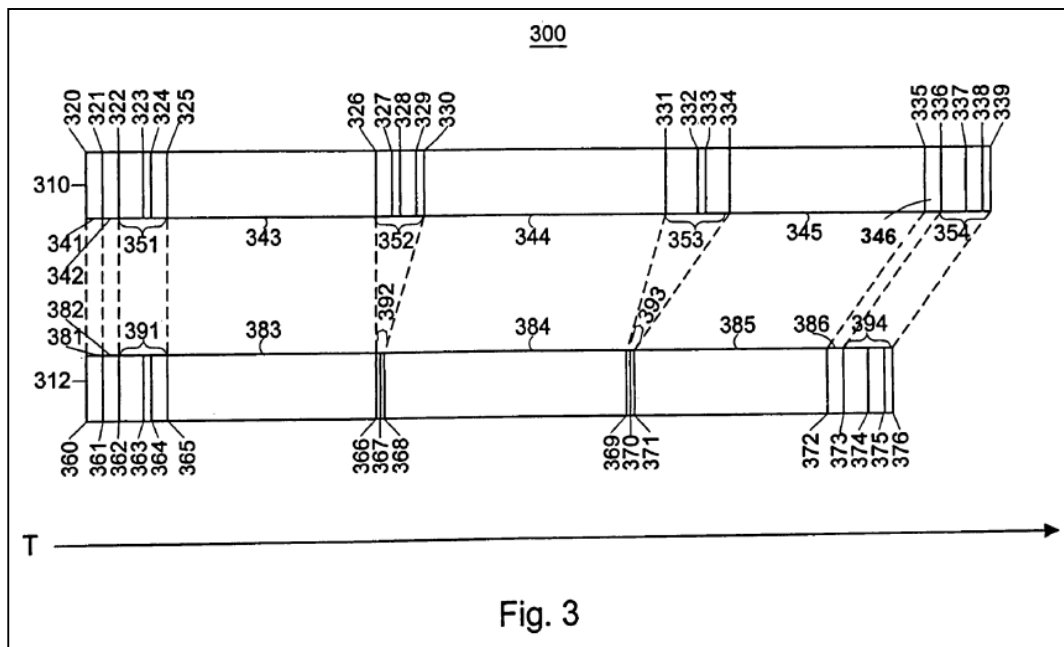
As stated above, PO's construction excluding live content from the "first period of time" should be rejected. *See supra* §III.A. When a video is being presented in "live view" or "delayed view" modes, Dow's commercial skip feature can be defined as always inactive. *See* Ex[1007],24:36-39. Afterwards, Dow teaches that this feature can be toggled to "indicate[] whether the commercial skip features is enabled or not. For example, if the commercial skip toggle 426 is marked (as shown), the commercials will be skipped when the program is played, regardless of the play mode selected." *Id.*,11:57-61. Further, a user-provided "control signal, such as from the select button, will toggle the toggle 426 between on and off." Accordingly, a user may transmit a first command to set the playback state of the DVR before transmitting a second command initiating playback of the video program. Thus, a user of Dow's DVR may disable the commercial skip feature during a second time period and view the video in its entirety.

- c. Dow teaches providing an abbreviated portion of a video program during a second period of time.

Dow discloses the third scenario. Dow provides for the presentation of an

abbreviated portion of the video program in response to a command to skip certain detected portions of the video program. *E.g.*, Ex[1007],11:58-61. Dow explains that its commercial skipping is time-based and that it is made possible by a commercial indexer and an already-known companion index file containing the time index of the video file. *Id.*,6:61-64. (“The data stored regarding the identified transitions in content may then be used by the program navigator 150 to **provide enhanced playback options, such as commercial skipping.**”).

This is also shown in Figure 3:



Dow explains that “[t]he first timeline 310 is the program 300 as it may be viewed in correspondence with how it was originally presented and stored on DVR 100. The second timeline 312 is the program 300 viewed with one embodiment of an automated commercial skipping feature enabled.” *Id.*,9:40-45. In the second

timeline 312, Figure 3 illustrates commercial-skip-indicators 392, 393. Dow teaches that those indicators are optional such that “[p]rogram segments 383, 384, and 385 would be presented sequentially without any interruption or other indication that commercials had been skipped.” *Id.*,10:45-47. Thus, Dow discloses the third scenario and all limitations of claim element 1[d].

In sum, Dow anticipates claims 1, 11, and 18.

4. Claims depending from Claims 1, 11, and 18

While PO attempts to rebut Petitioner’s showing that Dow anticipates all challenged claims, PO admits that its grounds for most of the remaining dependent claims repeat those made for the claims discussed above. PO’s Response separately discusses claims 10 and 14 because PO argues they recite additional limitations not discussed in claims 1, 11, and 18. As discussed above, PO’s arguments are unavailing, and these claims too should be canceled.

a. Claim 10

PO argues that Dow does not disclose displaying all the primary content and only a portion of the secondary commercial content because Petitioner maps the “portion” of the video program recited in claim 10 to “commercials.” POR,44. But PO’s reading of the Petition is incorrect.

The “portion of said video program” referenced in claim 10 first arises in the third scenario, where the processor “provide[s] **only a portion of**” one of the plurality of video programs to the display device. Ex[1001],12:25-26. When explaining the

third scenario, Dr. Jeffay and the Petition both highlight that, when Dow's commercial skip is enabled, "[p]rogram sequences 383, 384, and 385 would be presented sequentially without interruption," creating a "shortened total running time for the presentation." Ex[1002]¶302; Petition,50-51. When commercial skipping is not enabled during the second period of time (by toggling the feature "off"), the program is retrieved and shown in its entirety. *E.g.*,Petition,50; Ex[1002]¶¶339-340. So, the limitations of claim 10 are anticipated by Dow.

Even if "portion" corresponded to "commercials," Dow still anticipates claim 10. As Dr. Jeffay explains, "Dow also teaches a commercial skip feature, which is utilized to filter commercials or certain chapters from a video program." Ex[1002]¶250. In a first time period, "where there is insufficient time to buffer and process events for identifying commercial groups," the commercial skip feature "is always inactive." Ex[1007],24:44-47; Ex[1002]¶250. During a second time period, when the commercial skip feature is enabled, Dow explains that users may utilize the DVR's "enhanced navigation features to view recorded content with substantially reduced commercials." Ex[1007],9:37-39; Ex[1002]¶250. And, Dow's "**content navigation module 540 may play a small portion of one or more commercials** in a skipped commercial group." Ex[1007],16:5-9 (emphasis added); Ex[1002]¶250.

Thus, Dow teaches the limitations of claim 10.

b. Claim 14

PO's Response fails to recite what "add[itional] limitations" are present in claim 14 that are not present in claim 11, so PO's resulting conclusion that "Dow fails to anticipate dependent claim 14" should be rejected. POR,44-45. Thus, because claims 1 and 11 are anticipated by Dow, claim 14 is also anticipated.

Because Dow anticipates claims 1, 10, and 14, and because PO agrees that the analysis for the remaining claims is not materially different than for claims 1, 10, and 14, Dow anticipates claims 1, 3-5, 7-11, 13-16, and 18-19. Ex[1002]¶¶388-89.

C. Ground 3: Claims 1-20 Are Obvious Over Dow In View of Russ and Miller.

PO rehashes similar arguments as those it makes in Grounds 1 and 2, which the Board should reject for the reasons stated above. PO also contests whether it would have been obvious to combine Dow, Miller and Russ to render obvious the challenged claims. See POR,50-54. Petitioner establishes that Dow alone or in combination with Miller, Russ, or both discloses or renders obvious all the limitations of the challenged claims. But PO's Response also fails because it ignores detailed analysis from Petition and Dr. Jeffay that a POSA would have been motivated to combine Dow with Russ and/or Miller. *E.g.*, Ex[1002]¶¶397-398, 418, 434, 448, 453.

Thus, claims 1-20 are obvious in view of Dow alone or in combination with Russ and Miller.

V. CONCLUSION

Petitioner respectfully requests that claims 1-20 of the '122 Patent be cancelled as unpatentable pursuant to 35 U.S.C. §318(b).

Respectfully Submitted,

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. §§42.6(e) and 42.105, the undersigned certifies that on June 4, 2024, a complete and entire copy of the **PETITIONER’S REPLY TO PATENT OWNER’S RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,538,122 UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. §§ 42.100 *ET SEQ.***, including exhibits and testimony relied upon were was provided via email to the Patent Owner by serving the correspondence email addresses of record as follows:

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CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

Pursuant to 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count under §42.24(a)(1) for the foregoing Petition for *Inter Partes* Review totals 5,581 words, within the 5,600 word limit allowed under § 42.24(c)(1).

Date: June 4, 2024

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