

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC., LG ELECTRONICS U.S.A., INC,
Petitioner,

v.

MULTIMEDIA TECHNOLOGIES PTE. LTD.
Patent Owner

Case No. IPR2024-00352
U.S. Patent No. 9,247,174

PATENT OWNER'S PRELIMINARY RESPONSE

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Exhibit No.	Petitioner's Exhibit List
Ex.1001	U.S. Patent No. 9,247,174 to Sirpal et al.
Ex.1002	Prosecution History of U.S. 9,247,174
Ex.1003	Declaration of Dr. Andrew Lippman under 37 C.F.R. § 1.68
Ex.1004	<i>Curriculum Vitae</i> of Dr. Lippman
Ex.1005	U.S. Patent Publication No. 2012/0054794 to Woods et al. ("Woods")
Ex.1006	U.S. Patent Publication No. 2002/0060750 to Istvan et al. ("Istvan")
Ex.1007	" <i>CurioView: TV Recommendations Related to Content Being Viewed</i> ," Hideki Sumiyoshi, IEEE International Symposium on Broadband Multimedia System and Broadcasting 2010 ("CurioView")
Ex.1008	U.S. Patent Publication No. 2007/0047920 to Machida et al. ("Machida")
Ex.1009	U.S. Patent Publication No. 2011/0219395 to Moshiri et al. ("Moshiri")
EX1010	WO2013133915 to Cherry et al. ("Cherry")
EX1011	U.S. Patent Publication No. 2012/0054794 to Kim et al. ("Kim")

Exhibit No.	Patent Owner's Exhibit List
2001	Third Amended Docket Control Order, <i>Multimedia Techs. Pte. Ltd. v. LG Elecs. Inc. et al.</i> , No. 2:22-cv-00494 (E.D. Tex. Jan. 3, 2024), ECF No. 54

2002	Table C-5—U.S. District Courts—Civil Statistical Tables For The Federal Judiciary (Median Time From Filing to Disposition of Civil Cases, by Action Taken—During the 12-Month Period Ending December 31, 2023)
2003	Westlaw Litigation Analytics Report for Hon. Rodney Gilstrap, for 3/27/2023 to 3/27/2024
2004	Docket Control Order, <i>Multimedia Techs. Pte. Ltd. v. Vizio, Inc.</i> , No. 2:23-cv-00124 (E.D. Tex. Aug. 4, 2023), ECF No. 46
2005	Report and Recommendation re: Motion to Dismiss , <i>Multimedia Techs. Pte. Ltd. v. LG Elecs. Inc. et al.</i> , No. 2:22-cv-00494 (E.D. Tex. Mar. 1, 2024), ECF No. 61
2006	Defendants’ Invalidity Contentions, <i>Multimedia Techs. Pte. Ltd. v. LG Elecs. Inc. et al.</i> , No. 2:22-cv-00494 (E.D. Tex.) (filed Sept. 28, 2023)
2007	Petition for Inter Partes Review Under 35 U.S.C. § 312 and 37 C.F.R. § 42.104, <i>Vizio, Inc. v. Multimedia Techs. Pte. Ltd.</i> , IPR2024-00696 (PTAB) (filed Mar. 14, 2024)
2008	Defendant’s Invalidity Contentions, <i>Multimedia Techs. Pte. Ltd. v. Vizio, Inc.</i> , No. 2:23-cv-00124 (E.D. Tex. Sept. 28, 2023)
2009	Order Adopting Report and Recommendations, <i>Multimedia Techs. Pte. Ltd. v. LG Elecs. Inc. et al.</i> , No. 2:22-cv-00494 (E.D. Tex. Mar. 28, 2024), ECF No. 65

I. INTRODUCTION

The Board should deny the Petition for *Inter Partes* Review of U.S. Patent No. 9,247,174 (“’174 Patent”) because Petitioners LG Electronics Inc., LG Electronics U.S.A., Inc. (“Petitioners”) fail to demonstrate a reasonable likelihood that any challenged claim is not patentable.

As an initial matter, the Board should exercise its discretion to deny the Petition under § 314(a). Two district court litigations involving the ’174 Patent are in their late stages and will result in jury trials long before the Board issues any Final Written Decision. Moreover, the *Fintiv* factors weigh against institution, and the Petition falls far short of presenting a “compelling unpatentability challenge” that would warrant institution despite this inefficiency.

Even if the merits are considered, the Petition still fails. At a minimum, Petitioner fails to show that its cited art has any teaching or suggestion of “a first **type** of application panel” and “a second **type** of application panel” as claimed. The cited art, however, only discloses a single type of application unlike the claims of the ’174 Patent. As a result, Petitioner is unable to point to any disclosed grounds that render obvious the claims of the ’174 Patent, and the Board should deny institution.

II. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY THIS PETITION UNDER § 314(a)

The Board should exercise its discretion to deny institution under § 314(a) because institution would be an “inefficient use of Board resources.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19-20 (PTAB Sept. 12, 2018). As explained in further detail below, two district court litigations involving the ’174 Patent are at advanced stages and will conclude long before a PTAB proceeding would.

In *NHK Spring Co.*, the Board denied institution of an *inter partes* review under § 314(a) where a parallel district court proceeding was nearing its final stages, and a PTAB proceeding would not conclude until about six months after the district court trial was scheduled. *NHK Spring Co.*, IPR2018-00752, Paper 8 at 19-21. In so reasoning, the Board set the precedent that parallel court proceedings must be considered when determining whether the institution of an *inter partes* review is consistent with the objective of the America Invents Act (“AIA”) to “provide an effective and efficient alternative to district court litigation.” *Id.*

Building on *NHK Spring Co.*, in *Apple Inc. v. Fintiv, Inc.*, the Board identified specific factors relating to “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel

proceeding.” IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential).

The *Fintiv* factors include:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Id.

The Director provided further guidance on the application of the *Fintiv* precedent in a June 21, 2022 Memorandum¹ (“Guidance Memo”) and *CommScope Technologies LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 (PTAB Feb. 27, 2023) (precedential). The Director set forth a “compelling merits test” under which

¹ Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (USPTO June 21, 2022) (“Guidance Memo”) available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

the Board—if it has found that *Fintiv* factors 1-5 favor discretionary denial—must assess whether a petition presents a “compelling unpatentability challenge” before discretionarily denying institution. *CommScope*, IPR2022-01242, Paper 23 at 3-5. As the Director explained, “the compelling merits standard is a higher standard than the standard for institution set by statute.”² *Id.* at 3. A reasonable likelihood that the petitioner would prevail with respect to at least one challenged claim does not suffice to demonstrate that a challenge is “compelling.” Rather, a “compelling” challenge is one “in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence” such that “it is **highly likely** that the petitioner would prevail with respect to at least one challenged claim.” *Id.* at 3-4 (emphasis added). This is a “high standard” (*see AviaGames, Inc. v. Skillz Platform, Inc.*, IPR2022-00530, Paper 14 at 3, 5 (PTAB Mar. 2, 2023)) and the Board must explain its reasoning in determining whether the merits are compelling. *CommScope*, IPR2022-01242, Paper 23 at 4-6.

² Institution of an IPR is authorized only when “the information presented in the petition ... and any response ... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *CommScope*, IPR2022-01242, Paper 23 at 3 n.3.

All of the Fintiv factors weigh in favor of discretionary denial, in light of the Guidance Memo. The validity of the '174 Patent is being challenged in two pending litigations:

- *Multimedia Technologies Pte. Ltd. v. LG Electronics Inc. et al.*, No. 2:22-cv-00494 (E.D. Tex.) (Filed Dec 23, 2022) (the “LG Litigation”)
- *Multimedia Technologies Pte. Ltd. v. Vizio, Inc.*, No. 2:23-cv-00124 (E.D. Tex.) (Filed Mar. 24, 2023) (the “Vizio Litigation”)

Both of these litigations have progressed significantly, and while either one would independently merit a discretionary denial, together the two parallel district court litigations tip the scales heavily in favor of it.

A. Factor 1: Petitioner has Not Requested a Stay, and would have No Authority to Request a Stay in the Vizio Litigation

“A district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts,” and thus “weigh[s] against exercising the authority to deny institution under *NHK*.” *Fintiv*, IPR2020-0019, Paper 11 at 6. Petitioner has not filed any motion to stay the parallel district court proceeding in view of the Petition, has provided no indication that they intend to do so, and has presented no evidence suggesting a stay is likely if they did (particularly in light of the pending trial date). Judge Gilstrap of the United States District Court for the Eastern District of Texas—before whom the LG Litigation is

pending—has identified criteria he examines before granting a stay motion pending *inter partes* review, and a final written decision must not be “expected in the ordinary course before trial in [the] case would otherwise take place,” *Village Green Techs., LLC v. Samsung Elecs., Co.*, No. 2:22-CV-00099-JRG, 2023 WL 416419 at * 3 (E.D. Tex. Jan. 25, 2023). Judge Gilstrap further identified as relevant to this consideration whether, as here, petitioner was dilatory in seeking review and whether, as here, the review would not cover all contested patents in the litigation. *Id.* Here, the pending LG Litigation covers *seven* patents for which Petitioner has chosen not to seek review (and for which Petitioner has now exceeded the one-year deadline for challenging). Moreover, as will be discussed in greater length below, Petitioner’s final decision would not only come months after both trials have concluded, but this delay is the direct result of Petitioner’s delay in filing until almost a year after the LG Litigation began.

Moreover even if Petitioner were to request (and be granted) a stay, this would have no impact on the parallel Vizio Litigation.

This factor weighs strongly in favor of denying institution.

B. Factor 2: The Board’s Final Written Decision Deadline Would Likely be After a Trial in the LG Litigation and/or Vizio Litigation

“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny

institution under *NHK*.” *Fintiv*, IPR2020-00019, Paper 11 at 9. In addition to whether a trial date has been set by the court, the Guidance Memo instructs the Board to look to “the most recent statistics on median time-to-trial for civil actions in the district court in which the parallel litigation resides” as well as statistical information for the specific judge involved in the litigation. Guidance Memo at 8-9. While such evidence is probative, the Board “generally take[s] courts’ trial schedules at face value absent sufficient evidence to the contrary.” *Samsung Elecs. Co. v. Cardware Inc.*, IPR2023-00314, Paper 11 at 11 (PTAB July 18, 2023) (internal quotes omitted). Here, whatever metric is chosen, it is clear that both the LG Litigation and Vizio Litigation are expected to proceed to trial long before the Board will issue its ruling were it to initiate review. Petitioner does not dispute this fact. Pet. at 98-99.

The LG Litigation has already been set for trial in November, 2024—with Jury Selection set to begin at 9:00 a.m. on November 18. Ex. 2001 at 1. Moreover, the most recent statistics for the Eastern District of Texas provide a median time-to-trial of 20.7 months, which, given the LG matter’s filing date of December 23, 2022, would yield an expected trial even earlier – in mid-September 2024. Ex. 2002 at 2. Likewise, individual statistics over the past 12 months for Judge Gilstrap show a median time-to-verdict of 639 days, which would yield a trial date of September 2024. Ex. 2003 at 1.

The Vizio Matter was commenced on March 24, 2023, and is also pending before Judge Gilstrap. It has been set for trial in early January of 2024, with Jury Selection set to begin on January 6th. Ex. 2004 at 1. Time to trial statistics (whether measured by the average time-to-trial statistics for the Eastern District of Texas, or those for Judge Gilstrap individually) yield an even earlier expected trial in December of 2024. (Ex. 2002, 2003.)

As a result, whether the Board considers “the scheduled trial date or the trial date expected based on time-to-trial statistics,” it is clear that the trials for *both* parallel litigations will almost certainly “commence several months before the expected date of [the Board’s] final written decision.” *Samsung Elecs. Co. v. Cal. Inst. of Tech.*, IPR2023-00130, Paper 10 at 16 (PTAB May 4, 2023); *see also*, *10X Genomics v. President and Fellows of Harvard Coll.*, IPR2023-01299, Paper 15 at 17 (PTAB Mar. 7, 2024).

This factor weighs strongly in favor of denying institution.

C. Factor 3: There Has Been Substantial Investment by the Parties and District Court in the LG Litigation and the Vizio Litigation

In considering whether or not to institute review, the Board weighs “the amount and type of work already completed in the parallel litigation[s] by the court and the parties at the time of the institution decision.” *Fintiv*, IPR2020-00019, Paper 11 at 9. In determining how much weight to give these investments, the Board also

considers whether “the petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted,” or whether they instead waited “until the district court trial has progressed significantly before filing a petition at the Office.” *Id.* at 11. Where a Petitioner has chosen to sit on their hands the Board has recognized that “notwithstanding that a defendant has one year to file a petition” initiating review risks “impos[ing] unfair costs to [the] patent owner.” *Id.*

The substantial investment in time and resources by the parties and district court in both the LG Litigation and the Vizio Litigation, particularly when coupled with LG’s dilatory tactics in filing this Petition, strongly supports denial.³ *See, e.g., Mylan Labs. Ltd. v. Janssen Pharm. NV*, IPR2020-00440, Paper 17 at 17-19 (PTAB Sept. 16, 2020).

The parties in the LG Litigation have already exchanged extensive discovery—including document and source-code discovery. Indeed, contrary to Petitioner’s assertion that “the co-pending litigations are in relatively early stages,” Pet. at 98, the deadline for substantial completion of all document discovery was on March 26, 2024, (Ex. 2001 at 4), the parties have already submitted joint filings, and

³ Vizio also filed a copycat petition for *inter partes* review of the ’174 Patent as time ran out on its March 27, 2024 statutory deadline. *See* Ex. 2007, IPR2024-00696 (filed March 14, 2024).

Multimedia has filed its opening brief for the upcoming *Markman* hearing on May 10, 2024, and the case will continue to progress before the Board is expected make an institution decision.⁴ Ex. 2001 at 4. *See Samsung Elecs. Co. v. Mojo Mobility Inc.*, IPR2023-01098, Paper 11 at 9 (PTAB Feb. 9, 2024) (noting that significant investments in fact discovery weigh against institution). Moreover, the court has also already invested considerable resources into the Litigation, including a substantive Report and Recommendation by Magistrate Judge Payne, (Ex. 2005), that was adopted by Judge Gilstrap (Ex. 2009). *See Genomics*, IPR2023-01299, Paper 15 at 18 (finding that district court investment in resolving motions to dismiss the parallel litigation weighed against institution). Likewise, the parties in the Vizio Litigation have exchanged extensive discovery, including extensive document and source-code discovery, and are beginning *Markman* exchanges.

These expenditures of resources are even more significant in light of LG's decision, despite being served with notice of this complaint on December 23, 2022, to wait until December 20, 2023—just before the expiration of the statutory

⁴ On the March 25, 2024 call addressing Vizio's improper pre-institution motion for joinder of IPR2024-00696 and the instant Petition, *see VIZIO Inc. v. Multimedia Technologies Pte. Ltd.*, IPR2024-00696, Paper 3, the Board indicated an institution decision regarding this Petition was unlikely to be reached before June.

deadline—before filing its petition.⁵ LG has provided no justification for this decision to wait out the entire statutory period before seeking review, while actively causing the litigants in the parallel litigations to accrue needless expenses in time and effort. The Board has repeatedly recognized that waiting until the cusp of the one-year deadline wastes the time and resources of parties and the courts, and held that such gamesmanship weighs strongly against institution. *See, e.g., Genomics*, IPR2023-01299, Paper 15 at 19; *Ericsson Inc. and Nokia of Am. Corp. v. Collision Commc'ns, Inc.*, IPR2022-01233, Paper 12 at 15 (PTAB Jan 19, 2023).

This factor weighs strongly against review.

D. Factor 4: Petitioner's Claims Directly Overlap with both Parallel Litigations, Despite Petitioner's Efforts to Obscure this with an Ineffective Stipulation

Where a “petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding” thus creating “concerns of inefficiency and the possibility of conflicting decisions” this provides a strong reason for not granting review. *Fintiv*, IPR2020-00019, Paper 11 at 11-12. Petitioners do not challenge that the '174 patent is the subject of both parallel

⁵ As discussed above, Vizio also waited until nearly reaching its statutory deadline (March 27, 2024) to file a verbatim copy of the instant Petition. *See* IPR2024-00696 (filed March 14, 2024).

litigations, nor that their arguments in this Petition are substantially the same as those being litigated (as discussed at length above). Instead, Petitioners argue that the stipulation they have provided adequately addresses any concerns of reduplication. Pet. at 98. This claim however, misconstrues the authority on which it purports to rely.

In *Sotera Wireless, Inc. v. Masimo Corp.*, the Board recognized that a Petitioner can “mitigate[] any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions” by filing a binding stipulation in the parallel district court proceeding that ensures that the two proceedings will not deal with the same grounds. IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020). In *Sotera*, the Petitioner filed a stipulation with the district court not to subsequently raise in litigation any ground “that was raised or could have been reasonably raised in an IPR.” *Id.* at 18. Finding that this stipulation was not “unclear” and was sufficiently potent to “ensure[] that an *inter partes* review is a ‘true alternative’ to the district court proceeding” the *Sotera* court declined to deny institution. *Id.* at 20-21.

The Guidance Memo accepted the reasoning of *Sotera*, and indicated that, where a Petitioner has submitted a valid stipulation which “mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB,” by ensuring that “the grounds the PTAB resolves will differ from

those present in the parallel district court litigation,” this suffices to minimize concerns of inefficiency (and will generally be grounds for not discretionarily denying review). Guidance Memo at 7; *but see*, *NXP USA, Inc. v. IMPINJ, Inc.*, IPR2021-01556, Paper 13 at 4 (PTAB, Sept. 7, 2022) (noting that a purported *Sotera* stipulation which in actuality serves to “frustrate[] these goals” and to “open the door to gamesmanship” will not receive deference under the Guidance Memo).

Claiming to rely on this authority, Petitioner asserts that, if the Board institutes review, they will not pursue “the specific grounds asserted here, or on any other ground that was raised or could have been reasonably raised in this IPR” as part of the LG Litigation. Pet. at 98. Petitioner has failed however to file a proper *Sotera* stipulation. While Petitioner’s stipulation uses similar wording to the one approved by the Director, it fundamentally departs from the Director’s guidance (and the Board’s holding in *Sotera*) in two key respects.

First, unlike the stipulation which the Board and Director approved of in *Sotera*, Petitioner has not actually filed this stipulation in the District Court in the parallel proceedings. *Sotera*’s emphasis on such a filing is not a mere formality—by filing in District Court, the Petitioner in *Sotera* provided the court with an opportunity to review the stipulation, and ensure that those grounds which “could reasonably be raised” in an *inter partes* review were sufficiently clear and distinct to be later judicially enforceable. This concern is particularly acute in cases where,

as here, a petitioner indicates it will rely upon published descriptions of system art such as product manuals and user guides in challenging validity at the District Court, *see Wasica Finance GmbH v. Schrader Int'l, Inc.*, 432 F. Supp. 3d 448, 454 n.6 (D. Del. 2020) (surveying entrenched disagreements at the district court level regarding the proper method for categorizing such manuals as system vs. paper art), or, as here, intends to rely on unspecified combinations of paper and system art in the underlying litigation, *see Wirtgen America, Inc. v. Caterpillar, Inc.*, No. 1:17-CV-00770-JDW-MPT, 2024 WL 51010 at *9 (D. Del. Jan. 4. 2024) (noting unresolved, and frequently litigated ambiguity regarding which combinations constitute a “ground that the petitioner raised or reasonably could have raised during the *inter partes* review.”).

Here, Petitioner’s invalidity contentions for the ’174 Patent rely heavily on “thousands of [purportedly] invalidating combinations,” (Ex. 2006 at 39), of prior art, including paper art, systems art, and “Non-Patent Prior Art Publications” such as users guides and users manuals. *Id.* at 14-15. Petitioner makes clear in its contentions that believes it can rely on “any of a number” of and any “invalidating combinations” of identified art (including system art and user guides), and notes that the sheer volume of purported invalidating combinations are so numerous—“thousands” by Petitioner’s own estimation—as to be “unduly burdensome” for Petitioner to identify in its contentions. *Id.* at 39-40. Were the Board to institute

review without clarity as to which (if any) of these combinations and publications are covered by Petitioner's stipulation, the all-but-certain result would be the duplicate litigation of nearly all of Petitioner's claims at the District Court level via attempts to exclude certain art and combinations from the bounds of Petitioner's stipulation.

This is not a challenge to the proper role of *Sotera* stipulations in making institution decision. But here, Petitioner attempts to circumvent the process *Sotera* laid out for providing the requisite clarity to all parties and institutions involved. By declining to follow the procedure endorsed by *Sotera* and Director Vidal—*i.e.*, requesting the District Court accept the stipulation in the first instance—and declining to identify the art it believes it can and cannot rely on in the District Court, Petitioner has feinted at an agreement not to raise certain anticipation and/or obviousness challenges in the parallel litigation, but left the contours of that stipulation so vague as to be meaningless.

Where a Petitioner has offered a stipulation that does not meaningfully prevent them from later efforts to relitigate the subject matter of the *inter partes* review, the Board has been consistent in finding that such stipulation is at most “marginally” relevant in determining whether to grant review, *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR 2019-01393, Paper 24 at 12 (PTAB June 16, 2020), and that it does not receive deference under the

Guidance Memo. *See BOE Tech. Grp. Co. v. Element Cap. Co.*, IPR2023-00808, Paper 9 at 25-26 (PTAB Nov. 15, 2023). Therefore, at worst, this factor is neutral.

In addition to failing to bind Petitioner, Petitioner’s stipulation also elides the existence of the parallel Vizio Litigation, which would be unaffected by Petitioner’s stipulation. The Board has made clear in multiple decisions, including *Mylan* and *Fintiv*, that the existence of such parallel litigation covering issues “the same as, or substantially similar to” those presented for IPR is an independent basis for discretionary denial of review—even where concerns of reduplication within the parallel litigation to which the Petitioner is party are minimal. *Fintiv*, IPR2020-00019, Paper 11 at 14; *Mylan*, IPR2020-00440, Paper 17 at 22-23. Such third-party based denials are obviously not reparable by means of a stipulation signed by the Petitioner alone, which does nothing to “mitigate[] concerns of potentially conflicting decisions and duplicative efforts between the district court” in the Vizio Litigation and the PTAB. Guidance Memo at 7. Rather, the third-party itself must consent to a *Sotera* stipulation to avoid a *Mylan*-based denial.

Here, although Vizio has purported to enter a similar stipulation in their (identical to LG’s) petition for *inter partes* review, (Ex. 2007 at 98), it is not linked to the institution of Petitioner’s requested review, and Vizio remains free to withdraw their petition. Moreover, it suffers from all of the same defects as LG’s

stipulation, described above, including ambiguity as to the art Vizio believes it can raise in District Court. *See* Ex. 2008 at 12-14, 32 (identifying “thousands of [purportedly] invalidating combinations” of prior art that can be combined in “any combination,” which are so numerous that Vizio itself finds identifying them “unduly burdensome,” including paper art, systems art, and “Non-Patent Prior Art Publications” such as users guides and users manuals).

Petitioner’s failure to provide a proper *Sotera* stipulation, the fact that Petitioner’s stipulation will have no effect on the parallel Vizio litigation, and the strong overlap between Petitioner’s grounds here and those asserted in the Vizio litigation collectively counsel in favor of denying Petitioner’s request.

This factor weighs against review.

E. Factor 5: Petitioner is the Defendant in the LG Litigation, and the Vizio Litigation Involves Substantially Similar Issues

Petitioner is the defendant in the LG Litigation, which favors denial. *Fintiv*, IPR2020-00019, Paper 11 at 13-14. Petitioner is not a party to the Vizio Litigation. Nonetheless, “the issues [in the Petition] are the same as, or substantially similar to, those already or about to be litigated,” so this factor favors denial even with respect to the Vizio Litigation. *Id.*; *Mylan*, IPR2020-00440, Paper 17 at 22-23 (noting that denial of review on the basis of an additional litigation to which petitioner is not a member does not constitute prejudice, since they will in any event have the

opportunity “to fully litigate the invalidity of the [challenged] patent” in the litigation they are defending).

F. Factor 6: Petitioner Has Not Established Grounds for Review under The Statutory Standard, Let Alone the Far Stricter “Compelling Merits” Standard

The “factors considered in the exercise of discretion are part of a balanced assessment of all the relevant circumstances in the case, including the merits.” *Fintiv*, IPR2020-00019, Paper 11 at 14. The Director has provided further guidance on the proper role of consideration of the merits in weighing a discretionary denial, both in the Guidance Memo, as well as in her precedential decision in *CommScope Technologies LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 (PTAB Feb. 27, 2023). The Director set forth a “compelling merits test” under which the Board—if it has found that *Fintiv* factors 1-5 favor discretionary denial—must assess whether a petition presents a “compelling unpatentability challenge” before discretionarily denying institution. *CommScope*, IPR2022-01242, Paper 23 at 3-5.

As the Director explained, “the compelling merits standard is a higher standard than the standard for institution set by statute.” *Id.* at 3.⁶ A reasonable

⁶ Institution of an IPR is authorized only when “the information presented in the petition ... and any response ... shows that there is a reasonable likelihood that the

likelihood that the petitioner would prevail with respect to at least one challenged claim does not suffice to demonstrate that a challenge is “compelling.” Rather, a “compelling” challenge is one “in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence” such that “it is *highly likely* that the petitioner would prevail with respect to at least one challenged claim.” *Id.* at 3-4 (emphasis added). This is a “high standard” (see *AviaGames, Inc. v. Skillz Platform, Inc.*, IPR2022-00530, Paper 14 at 3, 5 (PTAB Mar. 2, 2023)) and the Board must explain its reasoning in determining whether the merits are compelling. *CommScope*, IPR2022-01242, Paper 23 at 4-6.

Here, the *Fintiv* factors weigh strongly in favor of discretionary denial. Moreover, as discussed in the merits section below, Petitioner’s challenge does not meet even the statutory standard, let alone the higher “compelling merits” standard. Accordingly, there is no basis for ignoring the other factors and granting review.

This factor weighs strongly in favor of denying review.

Because institution of any ground raised in the Petition would be an inefficient use of the Board’s resources—as evidenced by all six *Fintiv* factors—and the

petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *CommScope*, IPR2022-01242, Paper 23 at 3 n.3.

Petition does not satisfy the “compelling merits test,” the Board should exercise its discretion under § 314(a) to deny institution.

III. OVERVIEW OF THE '174 PATENT

The inventions of the '174 Patent and its family members broadly relate to intelligent televisions, also known as ITV's, smart TVs and/or internet TVs. As discussed in the specification of the '174 Patent, ITVs represent the convergence of various computing and telecommunications functions and hardware into a single package, enabling TVs that can also connect to the internet, function as a smart hub for connected homes, interface with social media, and perform myriad other functions. More specifically, they claim systems and methods for ITVs that, for example, employ novel user interfaces to harmonize and enable the various functions, sources and inputs necessary to perform all of the converged technologies.

The claims of the '174 Patent cover specific improvements in the field of televisions and television user interfaces that go beyond what was well-understood, routine, and conventional to solve then-existing problems in the field, particularly with respect to “Smart TVs”. Generally, a Smart TV is “a device that integrates access to the Internet and Web 2.0 features into television sets” and “represent[ed] the trend of technological convergence between computers and television sets.” *See, e.g.,* Ex. 1001 at 1:56-59. Smart TVs allow for access to “online interactive media, Internet TV, on-demand streaming media” and do not generally “focus on traditional

broadcast media” although they typically provide access to same. *Id.* at 1:60-62. Prior art Smart TV systems failed to, inter alia, “provide seamless and intuitive user interfaces for navigating and/or executing the various features of the Smart TV.” *Id.* at 1:63-65. Accordingly, there remained “a need for an Intelligent TV with intuitive user interfaces and with seamless user interaction capability.” *Id.* at 2:3-4.

To address this, the ’174 Patent—and its family members—describes and claims inventions that provide these “intuitive” and “seamless” interfaces. Broadly speaking, the ’174 Patent discloses panels that enable users to navigate Smart TV offerings and associated panels employed and oriented in novel ways to facilitate navigation of the Smart TV. Ex. 1001 at 29:62-37:54. Additional related patents describe and claim (1) search functionality that provides the functionality to effectively search local and non-local content in the Smart TV environment; (2) remote controls that enable a user to navigate the Smart TV; and (3) tracking and presenting content in the Smart TV environment in ways that enable users to effectively identify and access the desired content.

The claimed panel-based approach is a core aspect of providing this intuitive and seamless user experience for Smart (or intelligent) TVs which, by definition, are aggregating different types of inputs and media. By mediating access to screen portions through panels—which can be tailored toward specific inputs or

functionality—the TV can present a coherent, unified presentation to the user despite the myriad and different inputs and functionalities underlying that presentation.

In particular, the '174 Patent is directed to an “intelligent television and methods for displaying content.” Ex. 1001 at Abstract. The '174 Patent describes an “application panel interface” that includes a “first content panel [that] is a first type of application panel” to display a first type of information. In response to directional inputs from a user, the “application panel interface” displays a “second content panel [that] is a second type of application panel” that displays a different type of information about the content. *See* Ex. 1001 at Claim 1. The '174 Patent provides the following guidance regarding types of application panels (with reference to Figure 14):

The application panel **1412** may be the same or similar to application panel **544**. The application panel **1412** may provide access to contextually relevant functionality based on the currently viewing/recently viewed material. Similar to the global panel **1404**, the application panel **1412** may provide such access without disrupting the content view area **1408**. That is, the application panel **1412** may be displayed in such a manner as to provide a user the ability to view content displayed in content view area **1408**. For example, the application panel **1412** may be translucent in nature such that the content displayed in the content view

area **1408** is displayed (i.e., still viewable to a user), behind the application panel **1412**. The application panel **1412** may provide quick access to core functionality of the Intelligent TV **100** such that the active content in the content view area **1408** is always in view. Moreover, the application panel **1412** may provide a consistent user experience across all applications and may include focused contextual content.

Ex. 1001 at 30:39-57; *see also* Ex. 1001 at Fig. 14, 16.

Claim 1 (and analogous Claim 10) of the '174 Patent recite:

1. A method for displaying content on a television, comprising:
receiving a first input via an input device associated with the television;
in response to the first input, displaying, via the television, an application panel interface;
determining content currently being shown on the television;
identifying at least one of a content source and content information associated with the content currently being displayed via the television;
based on the content and the at least one of the content source and the content information, providing a first content panel in the application panel interface, *wherein the first content panel is a first type of application panel*;

receiving a first directional input via the input device associated with the television;
determining, based on a first direction associated with the first directional input, a second content panel to display via the television in the application panel interface, *wherein the second content panel is a second type of application panel*;
retrieving, from memory, a second content information based on the second type of content panel; and
displaying, via the television, the second content information in the second content panel.

Ex. 1001 at Claim 1 (emphasis added). Notably, the independent claims recite two *types* of application panels.

IV. SUMMARY OF THE REFERENCES ASSERTED IN THE PETITION

A. Woods

Woods describes a method “for navigating a media guidance application with multiple perspective views” involving arrays of “media guidance objects” presented in both “a first perspective view that appears flat on the screen” and “a second perspective view that appears to be going into the screen.” Ex. 1005 at Abstract. Users may manipulate these media guidance objects in a variety of fashions, such as sliding and jumping, in order to better traverse the array. *Id.* at [0100, 0106]. Woods describes a variety of “media guidance applications” relating to this method, which

aid users to “efficiently navigate media selections and easily identify media that they may desire.” *Id.* at [0033]. Woods does not, however, describe different *types* of application panels, but rather a single panel that shows different information depending on the selected tab. That is, the disclosure of Woods is a single application and single type of panel.

In fact, Woods describes several menus and menu bars that relate to the process described in its specification. *See, e.g., id.* at Figs. 1-2. One example of such a menu is a television program guide arranged in multiple perspectives. *Id.* at Fig. 9. This program guide includes a column for information “that allows the user to associate the program Source information with the program Source of the programs,” *Id.* at [0153], from which an application panel can launch. *Id.* at Fig. 9.

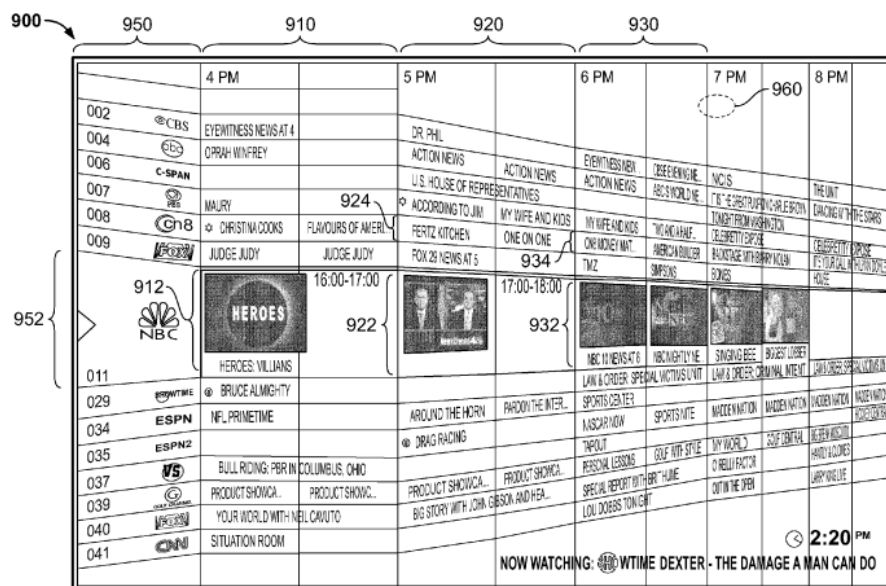


FIG. 9

Upon selecting a television program from this program guide, users are provided with “an illustrative display screen of functions corresponding to” that program, which enable the user to explore program-specific information. *Id.* at [0170]. This panel—what Petitioner alleges is an application panel—includes a “functions menu bar” which Woods provides “may display of [sic] list of indicators of functions associated with the media asset corresponding to the program listing selected,” *id.* at [0171]. In addition, the display screen includes a customizable “media region,” airing content relating to the selected program, advertisements, or the tv program that had previously been running, *id.* at [0174], and a function options region providing further sub-options for each listed function, *id.* at [0175].

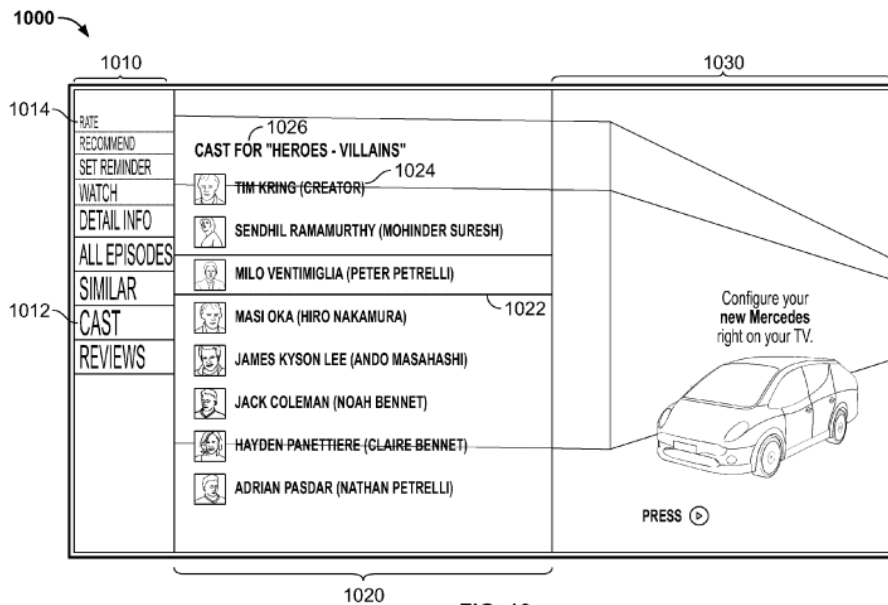


FIG. 10

Id. at *Fig. 10*. The display screen described by Woods aims at “allow[ing] the user to seamlessly browse for information associated with a selected media asset,” *id.* at [0179]. The functions it provides are all directly related to the particular media asset selected (e.g. rating information, reminder setting, detailed program information, and program cast). *Id.* at [0171]. Accordingly, a user may navigate from tab to tab (e.g., “CAST” to “DETAIL INFO”) in the “menu bar” to obtain additional information about the program. *Id.* at [0183]-[0190]. No directional navigation disclosed in Woods renders a second type of application panel.

B. Istvan

Istvan describes a “method of displaying multimedia content on a display area.” Ex. 1006 at Abstract. This method provides for the activation of a user interface (“UI”) providing a variety of menu options relating to the on-screen content. *Id.* at [0041]-[0043]. This UI includes a “logo area” including branding information associated with the service provider, and certain, limited context-sensitive optionality (such as channel numbers and network call letters where a television program is running). *Id.* at [0043]-[0045]. Istvan also instructs that the UI may include multiple “primary controls” – which are menu options relating to system-level functionalities, such as “Username,” “TV,” “Mail,” “Browser” and “Help” – which in turn are generally associated with a further sub-menu relating to that selection. *Id.* at *Fig. 3*; *see also id.* at [0042], [0046]-[0071]. Consistent with the

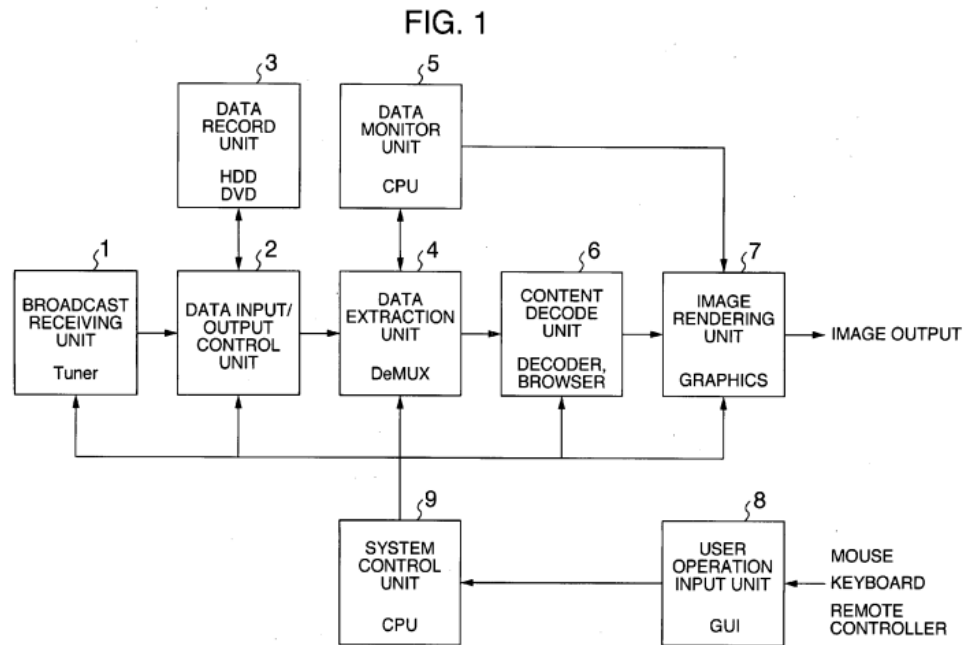
UI serving as a system-level menu, the TV submenu includes a number of system-level TV options, including searching for television content, reviewing recently-watched programming, and providing a list of designated favorite channels. *Id.* at [0057]-[0059].

C. Machida

Machida describes a “digital content reproducing apparatus” which possesses “a plurality of user operation interfaces,” as well as a “data monitor unit” which “monitors information on digital contents” of the television and automatically activates a particular apparatus based on the television content. Ex. 1008 at Abstract. In particular, Machida provides for the activation of a “linear content operation panel” when the television is reproducing “linear contents such as moving image contents,” allowing for relevant functionality such as “stop” and “fast forward,” and for a, different, “interactive content operation panel” when the television is reproducing “interactive contents such as data broadcast contents” which allows for user functionality such as “numerical keys from 0 to 9” and “up/down/right/left keys.” *Id.* at [0031]-[0032].

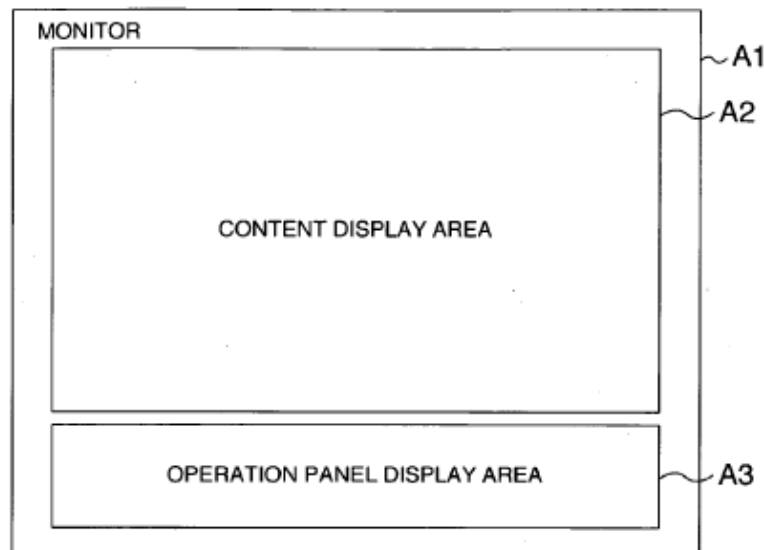
Machida instructs that the selection of these panels is performed automatically by the data monitoring unit, which “instructs the image rendering unit to perform rendering of an user operation interface” without direct user participation. *Id.* at [0029]. Panel selection is not the direct result of a user selection, and Machida does

not provide for the television to switch between the two types of panels, i.e., the interactive content operation panel and linear content panel, based on a directional input from the user. *Id.*; *see also, id.* at Fig. 1:



Moreover, the Operation Panel Display Area is exclusively dedicated to that use on the monitor and does not appear to be able to be used for display of content:

FIG. 2



V. LEVEL OF ORDINARY SKILL IN THE ART

Patent Owner adopts Petitioner's definition of a person of ordinary skill in the art ("POSITA") for the purposes of this Preliminary Response. *See* Pet. at 10. Patent Owner reserves the right to present arguments on the definition should the Petition be instituted.

VI. CLAIM CONSTRUCTION

Patent Owner does not dispute Petitioner's statement on claim construction for the purposes of this Preliminary Response. *See* Pet. at 10. Patent Owner reserves the right to present arguments on appropriate claim construction should the Petition be instituted.

VII. PETITIONER FAILS TO SHOW A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CHALLENGED CLAIM

To the extent the Board considers the merits of the Petition, the Petition does not demonstrate that Woods or the combination of Woods with Istvan and/or Machida renders obvious any of the challenged claims.

A. Ground 1: Woods Does Not Render Obvious Claims 1-14 of the '174 Patent

Petitioner's primary art, Woods, does not disclose or render obvious a key limitation of the '174 Patent's independent Claims 1 and 10—"a second **type** of application panel." Petitioner's "alternative" read of Woods fares no better, and fails to disclose the use of a "directional input" as claimed by the '174 Patent. As such, Woods does not render obvious Claims 1-14 of the '174 Patent.

1. Woods Does Not Disclose a "Second Type of Application Panel"

Petitioner elides over key language in independent Claims 1 and 10—"a first **type** of application panel" and "a second **type** of application panel" and in so doing manufactures an unavailing invalidity argument. The disclosures of Woods—both the reference as a whole and the portions identified by Petitioner—relate to a single application panel (and a single ***type*** of panel) that shows different information depending on which tab a user selects. For example, Woods describes an input—*e.g.*, selecting "HEROES" from a program guide— from a user:

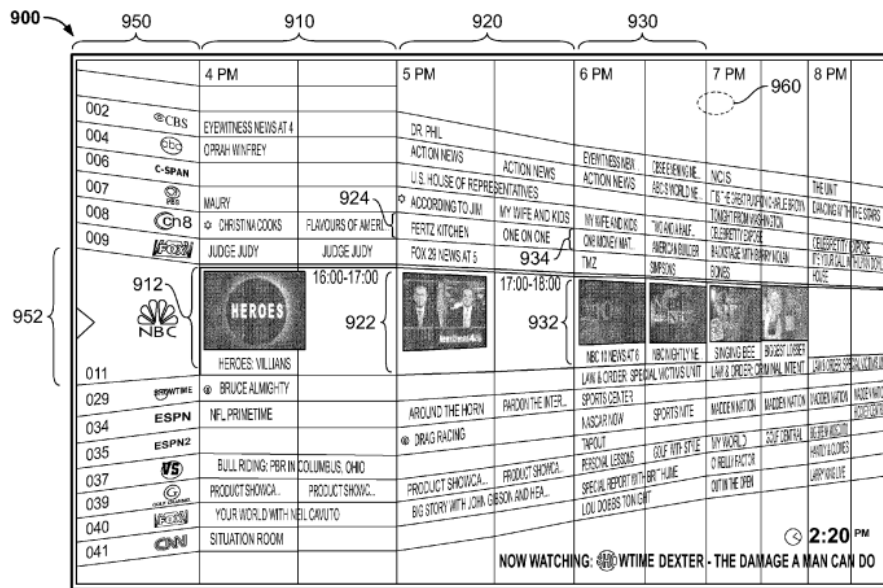


FIG. 9

This input launches a functions bar that Petitioner points to as an applications panel—a *first* type of application panel. This panel provides users with “an illustrative display screen of functions corresponding to” that program, which enable the user to explore program-specific information. *Id.* at [0170]. Its layout is illustrated in Figure 10:

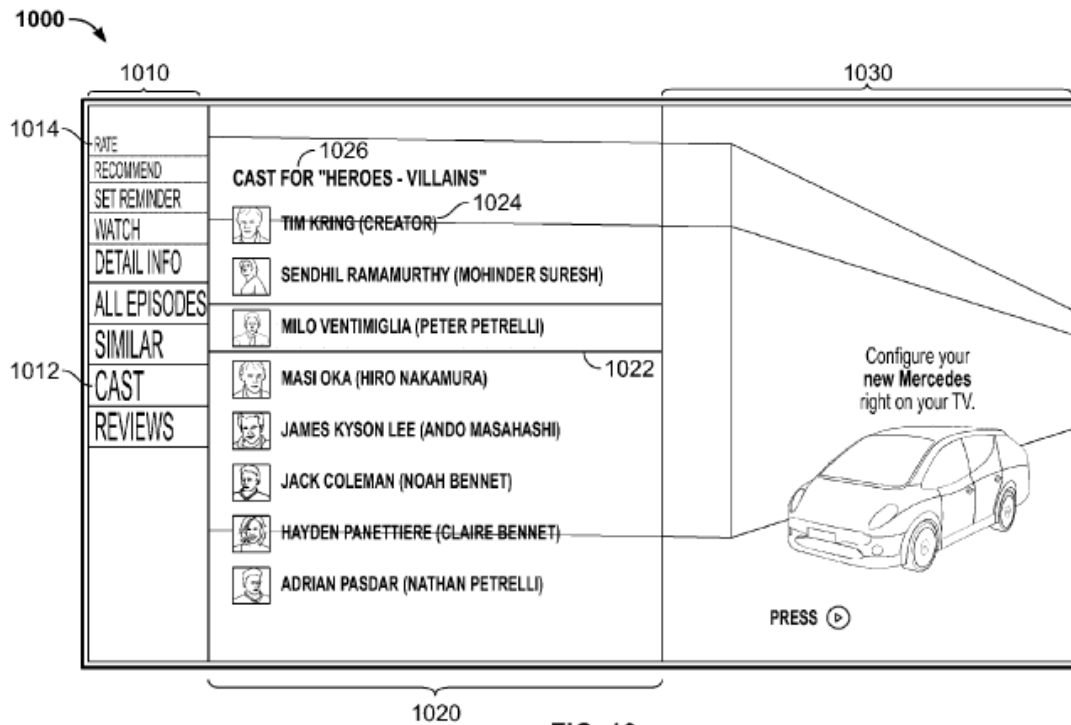
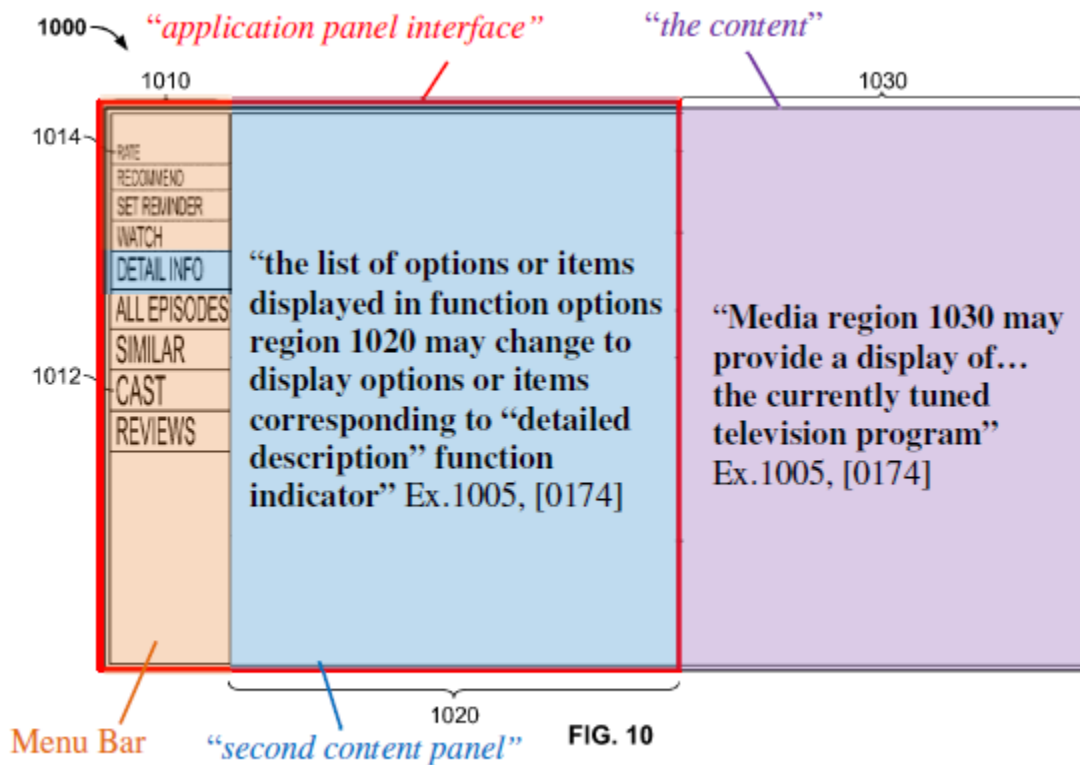


FIG. 10

Petitioner is unable to identify a second type of applications panel as recited by Claims 1 and 10 of the '174 Patent. Instead, Petitioner points to the functionality of the “functions menu bar” and a user’s ability to scroll between options on the left of the screen. In particular, Petitioner asserts Woods discloses that scrolling from “CAST” to “DETAIL INFO” would result in the rendering of a “second content panel”:



Ex.1005, Fig. 10 (modified/annotated); Ex.1003, ¶156.

Pet. at 59. By Petitioner’s own admission, the “second content panel” it identifies is simply a “second list of options displayed within [the application panel],” not a second type of application panel. Pet. at 49. While this disclosure may describe a second content panel in the abstract, it does not account for the full limitation of claims 1 and 10 of the ’174 Patent, which recites:

. . . determining, based on a first direction associated with the first directional input, a second content panel to display via the television in the application panel interface, **wherein the second content panel is a second type of application panel** . . .

Thus, at most, Woods teaches a series of content panels, all of which are the same type of application panel contrary to Claims 1 and 10 of the '174 Patent.

There is no suggestion in Woods that a different type of application panel (as the second content panel) would be appropriate for use in place of the expressly taught series of identical types of application panels. This fails to carry Petitioner's burden of pointing to "where each element of the claim is found" in Woods, *see* 37 C.F.R. § 42.104(b)(4), and Woods does not render obvious Claims 1-14 of the '174 Patent.

2. Petitioner's Alternative Read Does Not Employ a Directional Input

Petitioner also suggests an "alternative" read based on Woods' disclosure of a series of inputs to navigate from the interface of Figure 10 to the display of information about cast members shown in Figure 11. Pet. at 51-52. This contorts the language of the '174 Patent's claims, and requires that the "directional input" of the Claim comprise selecting the enter button, not the directional keys themselves: "after 'pressing up/down arrow keys,' *the 'user may press an 'enter' or 'confirm' key to receive a display of information* about the selected cast member." Pet. at 51-52 (quoting Ex. 1003 at ¶¶ 133-36) (emphasis added). Petitioner offers no support

for a read of “directional input” that encompasses pressing an “enter” button, and Patent Owner is not aware of any.

In view of this, Woods does not render obvious the claims of the ’174 Patent, and the Board should deny institution.

B. Ground 2: Woods in view of Istvan Does Not Render Obvious Claims 6, 8, and 14 of the ’174 Patent

Petitioner’s Ground 2 fails for at least the same reasons as Ground 1. Ground 2 purports to demonstrate the obviousness of certain limitations found in dependent claims 6, 8, and 14 of the ’174 Patent. Petitioner does not assert—and Istvan in fact does not—that Istvan discloses the missing limitations identified above in response to Ground 1, but rather that Istvan allegedly “confirms the obviousness” of the limitations in dependent claims 6, 8, and 14. Pet. at 83. Accordingly, Woods in view of Istvan does not render obvious Claims 6, 8, and 14 of the ’174 Patent at least for the same reasons Woods alone does not render obvious those claims.

C. Ground 3: Woods in view of Machida Does Not Render Obvious Claims 1-14 of the ’174 Patent

Petitioner’s Ground 3 fails for at least the same reasons as Ground 1. Petitioner asserts that the disclosure of Machida (1) would have been combined with Woods and (2) in combination with Woods, renders obvious the claims of the ’174 Patent. Petitioner is wrong on both counts. A POSA would not have been motivated to combine Woods and Machida or had a reasonable expectation of success in so doing.

And even if a POSA had done so, the combination of Woods and Machida would not render obvious Claims 1-14 of the '174 Patent.

1. Petitioner Has Failed to Establish Motivation to Combine Woods and Machida

As an initial matter, the disclosure of Machida relates not to a television, but to a “digital content reproduction apparatus” that may comprise tools generally not found with the televisions disclosed in Woods, such as a mouse and keyboard. Ex. 1008 at [0029]. Petitioner has not explained why a POSA would consult such art in developing Intelligent TV displays let alone articulated a motivation to combine with a reasonable expectation of success. *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.”).

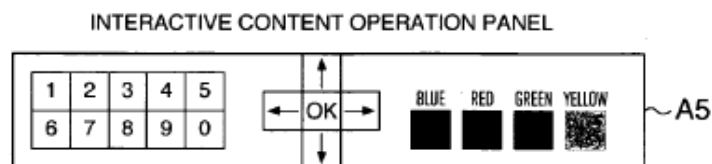
Even if the art were analogous, the disclosure of Machida—particularly as articulated by Petitioner—would not lead a POSA to combine it with Woods. In particular, Machida teaches, according to Petitioner, two types of control panels—“linear content operation panel” and an “interactive content operation panel.” Pet. at 91-92 (quoting Ex. 1008 at [0033], Fig. 3-4). These panels may be displayed in the same space on the television screen, but may only be displayed one at a time. *Id.* Petitioner asserts that this teaches, and a POSA would be motivated to combine these

teaching with Woods, that “it was known in the art to use the same panel area to change between two different types of panels with predefined functions.” *Id.* at 92. In contrast to Woods, however, these panels are “operation panels” that function to enable a user to perform basic television functions, like enter numbers, fast forward, or select icons:

FIG. 3



FIG. 4



Ex. 1008 at Fig. 3, 4.

These panels were operable with a mouse, and importantly, designed to be in the particular location and with the described characteristics in order to function properly with a mouse:

[T]he linear content operation panel and interactive content operation panel are provided, information on digital contents is monitored, and upon occurrence of a change in the information, the panels are automatically and exclusively displayed in the operation panel display

area A3 of the same panel rendering area size. Accordingly, only usable operation keys can be displayed, a user operation learning time can be shortened, **since the panel rendering area is made small, a mouse motion distance can be shortened, and an easy to use performance can be improved.**

Id. at [0037]. A POSA would not understand the operation panels of Machida to be relevant to a television environment, such that the disclosure of Woods could be combined with Machida to teach dynamically changing panels within a space on a television.

Additionally, Machida instructs that the selection of these panels is performed automatically by the data monitoring unit, which “instructs the image rendering unit to perform rendering of an user operation interface” without direct user participation.

Id. at [0029]. Panel selection is not the direct result of a user selection, and Machida does not provide for the device to switch between the interactive content operation panel and linear content panel based on a directional input from the user. *Id.* This disclosure teaches away from combining Machida with Woods, particularly with respect to the panels described in Woods.

2. Machida Does Not Remedy the Deficiencies of Woods With Respect to the “second type of application panel” Limitation

Even if a POSA were to combine the disparate teachings of Woods and Machida, the disclosure would not render obvious the “second type of application panel” limitation of the ’174 Patent. As discussed, Machida discloses a “linear content operation panel” when the device is reproducing “linear contents such as moving image contents,” allowing for relevant functionality such as “stop” and “fast forward,” and for a, different, “interactive content operation panel” when the device is reproducing “interactive contents such as data broadcast contents” which allows for user functionality such as “numerical keys from 0 to 9” and “up/down/right/left keys.” *Id.* at [0031]-[0032]. A user may not intentionally switch between the two under the teaches of either Woods or the ’174 Patent, the control space is dedicated exclusively to these panels as shown in Machida at Fig. 2, and the Machida teaching contemplates in its design the use of a mouse. *Id.* at [0037]. Moreover, the niche nature of the panels—limited to very narrow functionality—suggest not a concept with broad applicability to be incorporated into the teachings of Woods, but a narrow use case for the mouse-based “reproduction apparatus” addressed by Machida.

A POSA would not employ these teachings with Woods, and even if they did, a combination of Woods and Machida does not render obvious the claims of the ’174 Patent.

D. Ground 4: Woods in view of Machida and Istvan Does Not Render Obvious Claims 6, 8, and 14 of the '174 Patent

Ground 4 purports to demonstrate the obviousness of certain limitations found in dependent claims 6, 8, and 14 of the '174 Patent. Petitioner does not assert that Istvan discloses—and Istvan in fact does not disclose—the missing limitations identified above in response to Ground 3, but rather that Istvan allegedly “confirms the obviousness” of the limitations in dependent claims 6, 8, and 14. Pet. at 83. Accordingly, Woods in view of Machida and Istvan does not render obvious Claims 6, 8, and 14 of the '174 Patent at least for the same reasons Woods in view of Machida alone does not render obvious those claims.

VIII. CONCLUSION

Petitioner fails to show that institution is warranted. As explained above, institution would require an inefficient use of the Board’s resources, and the Petition falls far short of presenting a “compelling unpatentability challenge” that would warrant proceeding.

Even if the Board reaches the merits under the lower “reasonable likelihood” standard, denial is still warranted. Petitioner fails to demonstrate that the asserted prior art teaches every limitation of the challenged claims. For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution.

Dated: March 28, 2024

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that this brief complies with the type-volume limitations of 37 CFR § 42.24(a)(1)(i). This brief contains 8,368 words as calculated by the “Word Count” feature of Microsoft Word, the word processing program used to create it. The undersigned further certifies that this brief complies with the typeface requirements of 37 CFR § 42.6(a)(2)(ii) and typestyle requirements of 37 CFR § 42.6(a)(2)(iii). This brief has been prepared in a proportionally spaced typeface using Microsoft Word in Times New Roman 14 point font.

Dated: March 28, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Preliminary Response, was served on March 28, 2024 *via* email directed to counsel of record for the Petitioner at the following address of record as listed on PTACTS:

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