

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

**MULTIMEDIA TECHNOLOGIES PTE. LTD.**  
Patent Owner

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Case No. IPR2024-00353  
U.S. Patent No. 9,055,254

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**PATENT OWNER'S PRELIMINARY RESPONSE**

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| <b>Exhibit No.</b> | <b>Petitioner's Exhibit List</b>                                                                                                                                                                                                                                                                                           |
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| Ex.1001            | U.S. Patent No. 9,510,254 to Selim et al.                                                                                                                                                                                                                                                                                  |
| Ex.1002            | Prosecution History of U.S. 9,510,254                                                                                                                                                                                                                                                                                      |
| Ex.1003            | Declaration of Dr. Andrew Lippman under 37 C.F.R. § 1.68                                                                                                                                                                                                                                                                   |
| Ex.1004            | Curriculum Vitae of Dr. Lippman                                                                                                                                                                                                                                                                                            |
| Ex.1005            | U.S. Patent Pub. No. 2012/0054794 to Kim et al. ("Kim")                                                                                                                                                                                                                                                                    |
| Ex.1006            | WD-Manual WD TV Live Hub User Manual ("WD-Manual")<br>(copy of Exhibit 1012, Exhibit B,<br><a href="https://web.archive.org/web/20101203204251/http://www.wdc.com/wdproducts/library/UM/ENG/4779-705046.pdf">https://web.archive.org/web/20101203204251/http://www.wdc.com/wdproducts/library/UM/ENG/4779-705046.pdf</a> ) |
| Ex.1007            | KR Publication No. 2010-0134423 to Geun Sang Bae ("Bae")                                                                                                                                                                                                                                                                   |
| Ex.1008            | Certified translation of KR Publication No. 2010-0134423 to Geun Sang Bae (Ex.1007)                                                                                                                                                                                                                                        |
| Ex.1009            | U.S. Patent Publication No. 2010/0079681 to Coburn et al. ("Coburn")                                                                                                                                                                                                                                                       |
| Ex.1010            | U.S. Patent 8,146,128 to Tanaka ("Tanaka")                                                                                                                                                                                                                                                                                 |
| Ex.1011            | Excerpts from Newton's Telecom Dictionary, 26th Edition                                                                                                                                                                                                                                                                    |
| Ex.1012            | Affidavit of Nathaniel E Frank-White of the Internet Archive<br>(including Exhibit A and Exhibit B, 4779-705046.pdf)                                                                                                                                                                                                       |
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| Ex.1014            | Internet Archive capture of Apple.com                                                                                                                                                                                                                                                                                      |
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| Ex.1016            | U.S. Patent Publication No. 2013/0155172 ("Mock")                                                                                                                                                                                                                                                                          |
| Ex.1017            | U.S. Patent Publication No. 2006/0192753 to Fukuhara ("Fukuhara")                                                                                                                                                                                                                                                          |

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| Ex.1018 | Excerpts from Webster’s College Dictionary                                    |
| Ex.1019 | U.S. Patent No. 9,071,418 to Rajapakse (“Rajapakse”)                          |
| Ex.1020 | WD TV Live Hub press release (copy of Ex.1012, Exhibit A, pp. 17-18)          |
| Ex.1021 | WD TV Live Hub product support page (copy of Ex.1012, Exhibit A, pp. 14-15)   |
| Ex.1022 | WD TV Live Hub documentation availability (copy of Ex.1012, Exhibit A, p. 19) |
| Ex.1023 | WD TV Live Hub product review (copy of Ex.1012, Exhibit A, pp. 5-9)           |
| Ex.1024 | WD TV Live Hub available for purchase (copy of Ex.1012, Exhibit A, pp. 11-12) |

| <b>Exhibit No.</b> | <b>Patent Owner’s Exhibits</b>                                                                                                                                                                                 |
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| 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                                                                                                                       |

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| 2004 | 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       |
| 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)                 |

## **I. INTRODUCTION**

The Board should deny the Petition for *Inter Partes* Review of U.S. Patent No. 9,055,254 (“’254 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 ’254 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 identify any reason a POSA would be motivated to combine art that contains disparate teachings—one with numerical buttons for channel input and one with an on-screen channel changer. Moreover, the WD-Manual reference does not adequately teach or enable use of generic programmable buttons to provide the specific patented functionality of the claimed inventions that would render the claims obvious. As a result, Petitioner is unable to point to any disclosed grounds that render obvious the claims of the ’254 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 ’254 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 Memorandum<sup>1</sup> (“Guidance Memo”) and *CommScope*

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<sup>1</sup> 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](https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf)

*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 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.”<sup>2</sup> *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

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<sup>2</sup> 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.

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.

All of the *Fintiv* factors weigh in favor of discretionary denial, in light of the Guidance Memo. The validity of the '254 Patent is being challenged in a pending litigation, *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”), which weighs in favor of discretionary denial.

**A. Factor 1: Petitioner has Not Requested a Stay**

“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*, IPR2020-00019, 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.

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**

“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 some strong 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 the LG Litigation is 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 131.

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.

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 trial 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**

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 the LG Litigation, particularly when coupled with LG’s dilatory tactics in filing this Petition, strongly supports denial. 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,” Petition at 131, 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 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. 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 LG Litigation, including a substantive Report and Recommendation by Magistrate Judge Payne, (Ex. 2005), that was adopted by Judge Gilstrap (Ex. 2004), denying LG's motion to dismiss. *See Genomics*, IPR2023-01299, Paper 15 at 18 (finding that district court investment in resolving motions to dismiss the parallel litigation weighed against institution).

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 deadline—before filing its petition. 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 '254 patent is the subject of both parallel 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 131. 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 131. 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 International, 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 ’254 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 and other materials describing TV systems, which are duplicative of the system art. *Id.* at 26-27. Petitioner makes clear in its contentions that believes it can rely on “any of a number” of and any “invaliding combinations” of identified art (including system art and user guides), and notes that the sheer volume of purported invaliding 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. Com. Co.*, IPR2023-00808, Paper 9 at 25-26 (PTAB Nov. 15, 2023). Therefore, at worst, this factor is neutral.

Petitioner’s failure to provide a proper *Sotera* stipulation counsels in favor of denying Petitioner’s request.

This factor weighs against review.

**E. Factor 5: Petitioner is the Defendant in the LG Litigation**

Petitioner is the defendant in the LG Litigation, which favors denial. *Fintiv*, IPR2020-00019, Paper 11 at 13-14.

**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.<sup>3</sup> A reasonable

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<sup>3</sup> 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

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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 '254 PATENT**

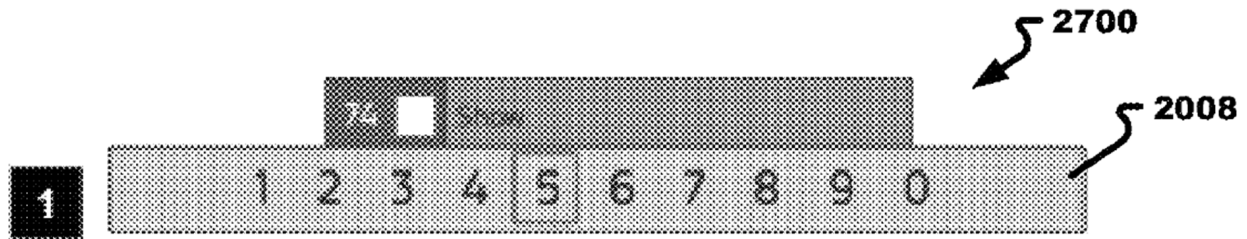
The inventions of the '254 Patent and its family members broadly relate to intelligent televisions, also known as ITV's, smart TVs and/or internet TVs. As discussed in the specification of the '254 Patent, ITVs represent the convergence of various computing and telecommunications functions and hardware 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 '254 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 1:50-54. 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 1:54-56. 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 1:57-59. Accordingly, there remained “a need for an Intelligent TV with intuitive user interfaces and with seamless user interaction capability.” *Id.* at 1:65-66.

To address this, the '254 Patent—and its family members—describes and claims inventions that provide these “intuitive” and “seamless” interfaces. Broadly speaking, the '254 Patent discloses novel remote controls and respective user interfaces that enable a user to navigate the Smart TV. Ex. 1001 at 22:57-23:7, 24:1-25:10, 32:51-33:21. Additional related patents describe and claim (1) global 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; (2) search functionality that provides the functionality to effectively search local and non-local content in the Smart TV environment; and (3) tracking and presenting content in the Smart TV environment in ways that enable users to effectively identify and access the desired content.

In particular, the '254 patent is directed to new remote control designs and interfaces to better navigate the myriad inputs and functions of Smart TVs. This includes streamlining the physical design and inputs of the remote control by utilizing a television with an “on screen channel changer”. The on screen channel

changer displays a number input bar for entering a channel. Ex.1001, 32:58-60, 33:1-8, Fig. 27.



Ex. 1001, Fig. 27 (excerpt).

As the user selects the digits using non-numerical keys—e.g., a directional pad—and the on screen channel changer updates to include an electronic program guide (“EPG”). Ex.1001, 36:32-33, 36:38-39, 36:50-52. The remote control has been simplified through removal of the numerical buttons. See, e.g., Ex. 1001, Fig. 7. But user’s inputs can still cause the television to display the selected channel. Ex.1001, 36:61-64. This redesign of the remote control, in turn, frees up more space for the addition of the advanced-control buttons and functionalities discussed below.

For example, the remote control of the ’254 patent includes a “media center button 736..., an application center button 740..., a global panel button 744, [and] an application panel button 748.” Ex.1001, 23:3-8. Pressing the “media center button” causes the television to display “information regarding music, videos, photographs, collections or groupings of music, videos, and/or photographs, and internal and external computational devices.” Ex.1001, 24:5-16. Pressing the

“application center button” causes the television to display “information regarding pre-installed and downloaded applications.” Ex.1001, 24:17-26. Pressing the “application panel button” causes the television to display “an information panel regarding a selected (pre-installed or previously downloaded) application icon.” Ex.1001, 24:56-25:10. Pressing the “global panel button” causes the television to display “panels” that provide access to “silos, notifications, a web browser, system settings, and/or information associated therewith.” Ex.1001, 24:27-31.

This redesign of the remote control, as exemplified in Figure 7, and the updated user interface on the Smart TV, as exemplified in Figures 14-24 and 27, enabled a new user interface experience that allowed a user to more readily access the advanced functions and features of the Smart TV.

Claim 1 (and analogous Claims 8 and 14) of the '254 Patent recite:

1. A method, comprising:  
receiving, wirelessly by at least one of an infrared and radio frequency module of a television and from a remote control, a request to change a programming channel;  
displaying, by a microprocessor executable application framework and on a television screen, an on screen channel changer, the displayed on screen channel changer comprising electronic program guide (“EPG”) information and a number input bar comprising digits, wherein the digits range from 0 to 9;

receiving, by the application framework and from the remote control, a channel selection based on digits selected by a user using the remote control and the number input bar of the on screen channel changer, wherein the user selects the digits using non-numeric keys of the remote control; and

changing, by the application framework, to the selected channel, wherein the remote control comprises:

a media center button that, when selected, provides, by the television screen, displayed information regarding one or more of groupings of music, groupings of videos, groupings of photographs, and internal and external computational devices, the computational devices comprising one or more of personal computers, laptops, tablet computers, wireless phones, and removable computer readable media;

an application center button that, when selected, provides, by the television screen, displayed information regarding pre-installed and downloaded software applications, wherein the downloaded software applications comprise one or more of a web browser, settings control, and content search algorithms;

an application panel button that, when selected, displays, by the television screen, an application panel, wherein the application panel comprises an information panel

regarding a selected (pre-installed or previously downloaded) application icon; and  
a global panel button that, when selected, provides the user, via one or more panels or windows displayed by the television screen, with access to one or more of silos, notifications, a web browser system settings, and information associated therewith.

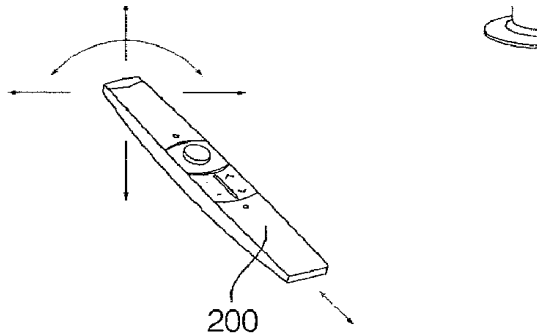
Ex. 1001 at Claim 1.

#### **IV. SUMMARY OF THE REFERENCES ASSERTED IN THE PETITION**

##### **A. Kim**

Kim describes a “multifunctional display device” consisting of a number of “card object” panels displayed in different portions of the display, along with “a method of controlling” the same. Ex. 1005 at Abstract. Kim describes this display as a “home screen” for smart television content. *Id.* at [0094], [0192]. This home screen is designed to enable quick access to all programs and applications on the television through a central, scrollable menu consisting of numerous “card objects.” *Id.* at [0195]-[0212]. These cards can be quickly navigated and scrolled in order to access the desired content. *See, e.g., id.* at [0196]; Claims 1, 7, 19.

While Kim instructs that its method may include a remote control, *id.* at [0172]-[0180], it provides minimal details regarding this remote control's functionality, and the remote which appears in the attached images contains only rudimentary directional and navigational controls. *See, e.g., id.* at Fig. 13 (excerpt):



Kim fails to describe the possibility of accessing the specific cards and/or applications arrayed in its card menu via programmed shortcuts on the remote control. This absence aligns with the purpose of the card menu being to provide an efficient method of accessing this content without needing additional shortcuts or remote control button.

While Kim mentions the possibility that the remote control may contain unspecified keys, *id.* at [0175], the only example it provides is a “home” button calling up Kim’s home screen when it is inactive, *id.* at [0094], [0192]. Once the home screen has been called up, the functions which the remote is described as performing are limited to classic remote control functions such as turning the television on and off, changing the channel/volume, scrolling through displayed

items, and accessing system settings, *see, id.* at [0086], [0174], [0196], [0230], [0251], [0281] as well as traditional virtual-pointer based manipulation and selection of items already displayed on the television screen. *See, e.g., id.* at [0097], [0167]-[0171], [0185]-[0186], [0198], [0223], [0257]. Kim additionally suggests that alphanumeric inputs transmitted with this remote control is provided via “character keys” enabling users to input alphanumeric characters. *Id.* at [0189], [0267].

## **B. WD-Manual**

WD-Manual provides “step-by-step instructions for installing and using” a “media center” capable of storing and displaying a variety of media types. Ex. 1006 at 9. One feature which is described as accompanying this media center is a remote control containing four shortcut buttons. *Id.* at 15. By default, these buttons direct the user to the “sort and filter menu,” the “select content source menu,” the “change view” menu, and the “dashboard menu.” *Id.* at 30. WD-Manual permits, however, the reassignment of these shortcut keys to other media functions. *Id.* While WD-Manual provides minimal description of this process, it does provide a list of permissible modified shortcuts, including “display mode, filter menu, Music, Video, Services, Setup” and other unidentified functions. *Id.* at 142. The media center described by WD-Manual is, as its name implies, limited to media sources, which, while including certain internet-based sources, does not include broader services such as a web-browser. *See id.* at 80-130.

The remote control described by WD-Manual relies upon alphanumeric keys for selecting and changing channels. *See id.* at 15, No. 9:

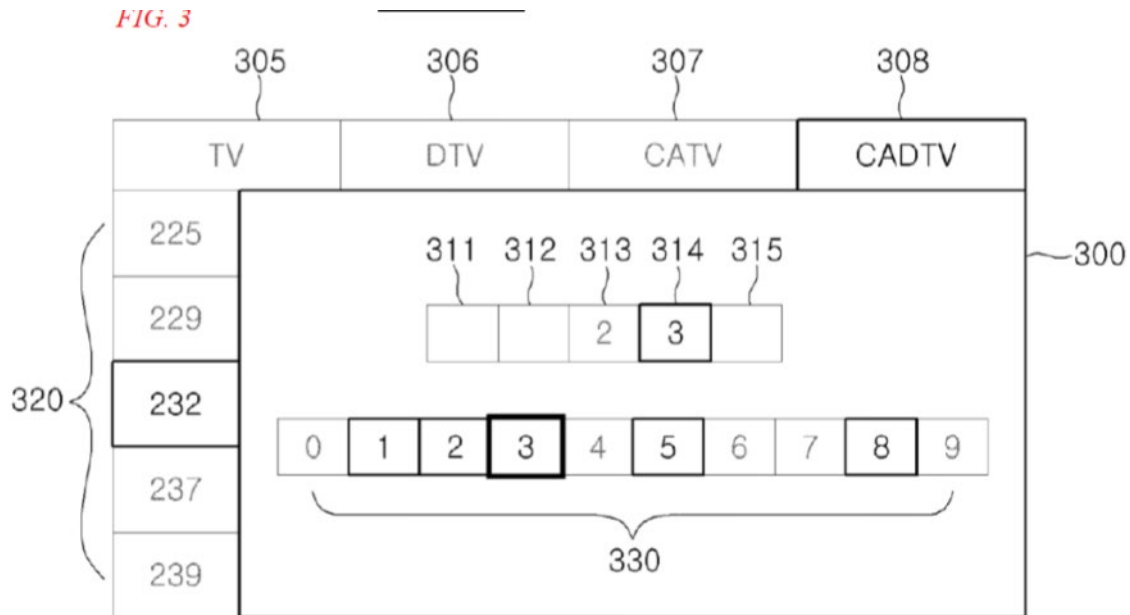


Petitioner has not shown that the WD-Manual describes an alternate method of inputting alphanumeric information using the remote to change the channel, and in particular does not describe any method for inputting numerical information using the remote's directional keys to change the channel. There is no indication of any insufficiency or unmet need from the use of the numerical keypad.

### C. Bae

Bae describes "a device and method for channel search in a video display device" in which users can select channel numbers sequentially from a "channel number selection window." Ex. 1008 at Abstract. Bae's selection window does not

provide any information, dynamically updated or otherwise, about the content of the channels selected by means of its method. *See, id.* at Fig. 3.



#### D. Coburn

Coburn describes a system and method for “graphically controlling numeric, alphanumeric or other symbol-based features” on a television by receiving a “two dimensional input” which “indicates one of the key images” on a “keypad image” and updating the “imagery on the display” of the keypad image accordingly. Ex. 1009 at Abstract. While allowing for various modes of presentation, Coburn repeatedly instructs that the interface used for such selection is structured as a “keypad,” *id.* at [0041]-[0043], [0054]. While Coburn instructs that the data inputted through its method “can be processed in a predictive manner” to provide channel options which “correspond to the initially-entered data,” this is done by providing

dynamically updated options in a separate window, not by dynamically updating the keypad itself. *Id.* at [0046]-[0047], *see also id.* at Fig. 3.

**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 10-11. 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 11. 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 the combinations of Kim, Bae, and WD-Manual or Kim, Bae, and WD-Manual further in view of Coburn render obvious any of the challenged claims.

**A. Ground 1: Kim, Bae, and WD-Manual Does Not Render Obvious Claims 1-4, 8-10, and 13-17 of the '254 Patent**

Petitioner's primary combination, Kim, Bae, and WD-Manual, does not render obvious any claim of the '254 Patent at least because (1) Petitioner has not identified any reason a POSA would be motivated to combine art that contains disparate teachings—one with numerical buttons for channel input and one with an on-screen channel changer; and (2) the WD-Manual does not adequately teach or enable use of generic programmable buttons to provide the specific patented functionality of the claimed inventions that would render the claims obvious. Accordingly, Petitioner does not identify any disclosure in Kim, Bae, and WD-Manual—individually or collectively—that renders obvious any claim of the '254 Patent, and those references do not, in fact, do so. Accordingly, the Board should decline to institute review.

**1. Petitioner Has Not Identified Any Motivation to Combine Any On-Screen “Number Selection Window” of Bae with the Remote Control of WD-Manual**

Petitioner identifies three pieces of art—Kim, Bae, and WD-Manual—that each purport to disclose individual claimed elements of the invention of the '254 Patent. Petitioner claims these individual—and contradictory—disclosures render obvious claims 1-4, 8-10, and 13-17 of the '254 Patent. *See* Pet. at 14-119. But “[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.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015). Indeed, “the mere fact that these possible arrangements existed in the prior art does not provide a reason that a skilled artisan would have substituted [the teaching in one reference] with the [teaching of another].” *Virtek Vision Int’l ULC v. Assembly Guidance Sys., Inc.*, No. 2022-1998, 2024 WL 1292734, at \*3 (Fed. Cir. Mar. 27, 2024). The Petition does not set forth a reason to combine Kim, Bae, and WD-Manual nor a reason to combine certain elements of one piece of art with contradictory disclosures of another—such as numerical keypads of some references with directional inputs of others.

Here, Bae and WD-Manual provide antithetical teachings, and Petitioner does not identify a motivation for a POSA to substitute one for the other or combine the two. According to Petitioner, Bae teaches an on-screen “channel number selection window” in which “the user can input the corresponding number using left and right arrow keys.” Pet. at 34; Ex. 1008 at [0023]. In contrast, petitioner has not shown that the remote control of WD-Manual, which expressly features numerical input keys for channel changing and provides no indication of an on-screen channel changing function:



Ex. 1006 at 15. These two prominent disclosures of Bae and WD-Manual teach away from each other—each provides the same numerical channel changing outcome, but they do so in diametrically opposed ways. And none of the references on which Petitioner relies indicate any shortcoming of the WD-Manual approach or its reliance on a numerical pad for channel selection, or any motivation or reason to modify that approach.

Petitioner makes no attempt to reconcile these teachings. Petitioner nominally titles a sub-section in its motivation to combine analysis “Kim and/or Kim-WD-Manual with Bae”, (Pet. at 21), but in this section only attempts to justify a motivation to combine Kim with Bae—it fails to address a motivation or reason to

combine any of the references with WD-Manual. In effect, Petitioner instead purports to identify a motivation to combine (1) Bae with Kim, (Pet. at 21-25), or (2) Kim with WD-Manual, (Pet. at 18-21),<sup>4</sup> without ever accounting for the disparate teachings of Bae and WD-Manual—or ever mentioning a reason to combine Bae and WD-Manual—as part of the three reference Kim, Bae, and WD-Manual combination.

Doing so was necessary, and Petitioner’s failure to do so means it cannot carry its burden. Petitioner relies on the remote control of WD-Manual to disclose “remote control features,” (Pet. at 21), that are recited by the claim and not taught by Kim or Bae. *See* Pet. at 40-45 (relying on WD-Manual to “teach[] remote control buttons that, when selected, cause specific content and information to be displayed,” *i.e.*, the

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<sup>4</sup> These two individual motivations to combine are also deficient. For each, Petitioner relies largely on a generic statement in Kim that its disclosed remote control could “include various input tools other than those set forth herein, such a scroll key, a jog wheel, or other appropriate user input device.” Pet. at 20 (quoting Ex. 1005 at [0175]). This does not provide motivation to incorporate specific features—and exclude others, such as a numeric keypad—of Bae or WD-Manual into the disclosure of Kim, but rather provides a general statement that an improvement may be possible.

recited “media center button,” “application center button,” “application panel button,” and “global panel button”); *see also* Pet. at 42-104 (addressing each of the recited buttons). This reliance indicates a need to identify the reasons a POSA would have been motivated to combine WD-Manual’s remote control with that of Bae. In failing to do so, Petitioner identified a combination with prominent disclosures that teach away from each other—Bae’s on-screen channel changer and WD-Manual’s numeric keys both serve to change the channel numerically—without explanation of how the combination would occur or why the WD-Manual numerical-pad approach would have been abandoned by a person of skill in the art when considering the combination.

Accordingly, Petitioner has failed to identify a motivation to combine Kim, Bae, and WD-Manual, and such combination does not render obvious Claims 1, 10, and 17 of the ’254 Patent, and the Board should deny institution.

## **2. WD-Manual Does Not Enable the Allegedly Disclosed Features**

Petitioner relies on WD-Manual for the proposition that the limitations in the independent claims reciting a “media center button” and an “application center button” would be obvious to a POSA. Pet. at 49-71. But WD-Manual’s scant disclosure does not support a finding that the prior art “enable a person of ordinary skill to make and use the invention.” *In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir.

2005). Here, WD-Manual discloses a remote control containing four shortcut buttons which, by default, direct the user to the “sort and filter menu,” the “select content source menu,” the “change view” menu, and the “dashboard menu.” Ex. 1006 at 15, 30. Although WD-Manual discloses that the reassignment of these shortcut keys to other media functions, such as “display mode, filter menu, Music, Video, Services, Setup” and other unidentified functions, is possible, it provides minimal detail as to how such a change is accomplished. *Id.* at 142. A POSA would not understand this minimalist disclosure to enable the reassignment of these shortcut keys such that the relevant limitations of the ‘254 Patent are rendered obvious.

**B. Ground 2: Kim, Bae, and WD-Manual, further in view of Coburn Does Not Render Obvious Claims 6, 12, and 19 of the ‘254 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, 12, and 19 of the ‘254 Patent, and does not address the deficiencies in the independent claims as addressed in Ground 1. Pet. at 119-130. Accordingly, Kim, Bae, and WD-Manual, further in view of Coburn does not render obvious claims 6, 12, and 19 of the ‘254 Patent at least for the same reasons Kim, Bae, and WD-Manual alone does not render obvious those claims, and the Board should deny institution.

### **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: April 12, 2024

Respectfully submitted,

/Ryan J. Singer/

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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 7,138 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: April 12, 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 April 12, 2024 *via* email directed to counsel of record for the Petitioner at the following address of record as listed on PTACTS:

| <b>Lead Counsel</b>                                                                                                                                                                                 | <b>Backup counsel</b>                                                                                                                                                                                                                                                                                                                                                                          |
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