

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC. and LG ELECTRONICS U.S.A., INC.
Petitioners,

v.

MULTIMEDIA TECHNOLOGIES PTE. LTD.,
Patent Owner.

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

PATENT OWNER'S SUR-REPLY

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. WD-MANUAL HAS NOT BEEN ESTABLISHED AS A PRIOR ART “PRINTED PUBLICATION”	1
A. The Petitioner Waived Any Argument that WD-Manual Was Publicly Accessible.....	1
B. There Is No Evidence that WD-Manual Was Publicly Accessible	3
1. WD-Manual on the www.wdc.com Website Was Not Publicly Accessible	3
2. The Collateral Documents Do Not Establish Public Accessibility	8
a. Purported Press Release	8
b. B&H Photo webpage	10
c. WD TV LIVE webpage	10
d. Photography Bay website.....	11
III. CLAIMS 1, 8, AND 14 ARE PATENTABLE OVER KIM, WD- MANUAL, AND BAE (GROUND 1).....	13
A. Kim, WD-Manual, and Bae Fail to Teach Limitation 1.2 for “Displaying ...an On Screen Channel Changer ... Comprising Electronic Program Guide (‘EPG’) Information and a Number Input Bar Comprising Digits”	13
1. The Petitioner Presents the References as an Improper Abstract Combination	13

2.	The Home Screen (Card Object Area) of Kim Modified by Bae’s Number Input Bar Does Not Meet Limitation 1.2	15
3.	The Petitioner’s Arguments on Motivation to Combine Are Without Merit.....	18
B.	The References Fail to Teach Limitation 1.5.2 for “An Application Center Button That, When Selected ... Provides ... Displayed Information Regarding Pre-Installed and Downloaded Software Applications”	20
1.	The Combination of WD-Manual and Kim Does Not Meet Limitation 1.5.2.....	20
2.	WD-Manual’s “Internet Services” Display Combined With Kim Does Not Meet Limitation 1.5.2.....	21
C.	Kim, WD-Manual, and Bae Fail to Teach Limitation 1.5.3 for “An Application Panel Button that, When Selected ... Displays ... An Information Panel Regarding a Selected (Pre-Installed or Previously Downloaded) Application Icon”	23
1.	The Petitioner’s Reliance on the “App Store” Display of Figure 25 and the “Application List” of Figure 16 Is Misplaced	23
2.	The Back-Up Argument Based On Access to Flickr and Facebook Is Without Merit	24
IV.	CLAIMS 6, 12, AND 19 ARE PATENTABLE OVER KIM, WD-MANUAL, BAE, AND COBURN (GROUND 2)	25
V.	CONCLUSION	27

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Acceleration Bay, LLC v. Activision Blizzard Inc.</i> , 908 F.3d 765 (Fed. Cir. 2018)	passim
<i>Blue Calypso, LLC v. Groupon, Inc.</i> , 815 F.3d 1331 (Fed. Cir. 2016)	8, 11
<i>Endo Pharm., Inc. v. Actavis LLC</i> , 922 F.3d 1365 (Fed. Cir. 2019)	19
<i>In re Bayer</i> , 568 F.2d 1357 (CCPA 1978)	12
<i>In re Cronyn</i> , 890 F.2d 1158 (Fed. Cir. 1989)	12
<i>In re Wyer</i> , 655 F.2d 221 (CCPA 1981)	1
<i>Intel. Bio-Systems, Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	2
<i>Kinetic Concepts, Inc. v. Smith & Nephew, Inc.</i> , 688 F.3d 1342 (Fed. Cir. 2012)	14
<i>NetFlix, Inc. v. DivX, LLC</i> , 984 F.4th 1374 (Fed. Cir. 2023)	2
<i>Personal Web Technologies., LLC v. Apple, Inc.</i> , 848 F.3d 987 (Fed. Cir. 2017)	14
<i>Pfizer, Inc. v. Apotex, Inc.</i> , 480 F.3d 1348 (Fed. Cir. 2007)	19
<i>Samsung Electronics Co., Ltd. v. Infobridge Pte. Ltd.</i> , 929 F.3d 1361 (Fed. Cir. 2019)	passim

<i>TQ Delta, LLC v. CISCO Systems, Inc.</i> , 942 F.3d 1352 (Fed. Cir. 2019)	18
<i>Trivascular, Inc. v. Samuels</i> , 812 F.3d 1056 (Fed. Cir. 2016)	14
<i>Voter Verified, Inc. v. Premier Election Solutions, Inc.</i> , 698 F.3d 1374 (Fed. Cir. 2012)	5
<i>Yita LLC v. MacNeil IP LLC</i> , 69 F.4th 1356 (Fed. Cir. 2023)	2

AGENCY DECISIONS

<i>First Solar, Inc. v. Sade</i> , IPR2023-00881, Paper 13 (PTAB Nov. 16, 2023), 2023 WL 7923924	5
<i>Hulu v. Sound View Innovations</i> , IPR2018-01039, Paper 29 (PTAB Dec. 10, 2019) (precedential), 2019 WL 7000067	2
<i>Microsoft Corp. v. Throughputer, Inc.</i> , IPR2022-01566, Paper 13 (PTAB May 31, 2023), 2023 WL 5167054	3
<i>Xerox Corp. v. Bytemark, Inc.</i> , IPR2022-00624, Paper 9 (PTAB Aug. 24, 2022), 2022 WL 3648989	17, 22

EXHIBIT LIST (PATENT OWNER)	
Ex. 2001	Third Amended Docket Control Order, Multimedia Techs. Pte. Ltd. v. LG Elecs. Inc. et al., No. 2:22-cv-00494 (E.D. Tex. Jan. 3, 2024), ECF No. 54
Ex. 2002	Petition for Inter Partes Review Under 35 U.S.C. § 312 and 37 C.F.R. § 42.104, Vizio, Inc. v. Multimedia Techs. Pte. Ltd., IPR2024-00696 (PTAB) (filed Mar. 14, 2024)
Ex. 2003	Westlaw Litigation Analytics Report for Hon. Rodney Gilstrap, for 3/27/2023 to 3/27/2024
Ex. 2004	Docket Control Order, Multimedia Techs. Pte. Ltd. v. Vizio, Inc., No. 2:23-cv-00124 (E.D. Tex. Aug. 4, 2023), ECF No. 46
Ex. 2005	Report and Recommendation re: Motion to Dismiss, Multimedia Techs. Pte. Ltd. v. LG Elecs. Inc. et al., No. 2:22-cv-00494 (E.D. Tex. Mar. 1, 2024), ECF No. 61
Ex. 2006	Defendants' Invalidity Contentions, Multimedia Techs. Pte. Ltd. v. LG Elecs. Inc. et al., No. 2:22-cv-00494 (E.D. Tex.) (filed Sept. 28, 2023)
Ex. 2007	Petition for Inter Partes Review Under 35 U.S.C. § 312 and 37 C.F.R. § 42.104, Vizio, Inc. v. Multimedia Techs. Pte. Ltd., IPR2024-00694 (PTAB) (filed Mar. 14, 2024)
Ex. 2008	Defendant's Invalidity Contentions, Multimedia Techs. Pte. Ltd. v. Vizio, Inc., No. 2:23-cv-00124 (E.D. Tex. Sept. 28, 2023)
Ex. 2009	Order Adopting Report and Recommendations, Multimedia Techs. Pte. Ltd. v. LG Elecs. Inc. et al., No. 2:22-cv-00494 (E.D. Tex. Mar. 28, 2024), ECF No. 65

Ex. 2010	Challenged claims of '040 Patent from Petition
Ex. 2011	Declaration of Rajeev Surati
Ex. 2012	C.V. of Rajeev Surati
Ex. 2013	U.S Pat. No. 8,863,219 (Brown)
Ex. 2014	U.S. Pat. Pub. 2011-0320476 (McRae)
Ex. 2015	Deposition of Dr. Andrew Lippman in IPR2024-00351 7/15/2024
Ex. 2016	Provisional App. No. 61/583,609 filed 1/6/2012 (Kim Provisional)

I. INTRODUCTION

As explained below, the Petitioner’s Reply fails to rehabilitate the defective arguments in the Petition. Accordingly, each of the Challenged Claims of the ’254 Patent should be confirmed as patentable.

II. WD-MANUAL HAS NOT BEEN ESTABLISHED AS A PRIOR ART “PRINTED PUBLICATION”

A. The Petitioner Waived Any Argument that WD-Manual Was Publicly Accessible

A reference is publicly accessible only if it was [1] sufficiently disseminated or [2] otherwise available as being “searchable or indexed in a meaningful way” such that “persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate [the reference]” as of the relevant priority date. *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 772-73 (Fed. Cir. 2018) (brackets added) (citing *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981)).

The entirety of the Petition’s argument for WD-Manual’s availability as prior art consists of four conclusory sentences. Pet., 13-14. Petitioner’s Reply does not dispute that the Petition failed to assert that WD-Manual was publicly accessible through either (1) actual dissemination or (2) that it was at a location that was “*meaningfully* indexed,” searchable, or otherwise organized so that an interested artisan could locate WD-Manual exercising reasonable diligence. *Samsung*

Electronics Co., Ltd. v. Infobridge Pte. Ltd., 929 F.3d 1361, 1369 (Fed. Cir. 2019) (citing *Acceleration Bay*) (org. italics). Reply, 8-11.

At most, the Petition asserted that (a) WD-Manual was technically accessible, and (b) the WD product was on-sale. Pet., 13-14. An allegation of mere technical accessibility is insufficient. The alleged on-sale status of the product does not establish public accessibility of WD-Manual.

The Petition was thus facially deficient, and the Petitioner waived any argument that WD-Manual was publicly accessible by virtue of dissemination or that it was reasonably locatable by interested artisans. *Intel. Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) “**the initial petition** [must] identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’”) (emph added). See *NetFlix, Inc. v. DivX, LLC*, 984 F.4th 1374, 1378-79 (Fed. Cir. 2023)) (all theories not presented in the initial petition are waived); *Yita LLC v. MacNeil IP LLC*, 69 F.4th 1356, 1366–67 (Fed. Cir. 2023) (argument not raised in initial petition declined “because it was presented too late ... in [the] reply brief”); *Hulu v. Sound View Innovations*, IPR2018-01039, Paper 29 (PTAB Dec. 10, 2019) (precedential), 2019 WL 7000067, at *5 (addressing public accessibility: “[T]he statute requires that the **petition** identify *with particularity* the grounds for institution and evidence supporting such grounds”).

The WD-Manual should be disqualified as a reference.

B. There Is No Evidence that WD-Manual Was Publicly Accessible

In its Reply, Petitioner once again has failed to marshal evidence that WD-Manual was publicly accessible as disseminated or “made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” *Acceleration Bay*, 908 F.3d at 772.

1. WD-Manual on the www.wdc.com Website Was Not Publicly Accessible

The Petition’s argument is that WD-Manual was publicly accessible because it was allegedly posted on the Internet at the following obscure URL:

www.wdc.com/wdproducts/library/UM/ENG/4779-705046.pdf

in a *fifth-level subdirectory* (/wdproducts/library/UM/ENG/4779-705046) in the root website, www.wdc.com. POR, 19 (citing Pet., 14). See Reply, 10 (“the evidence shows that WD-Manual was available and accessible via the www.wdc.com website.”).

It is well established that the “mere technical accessibility” of a document on the Internet does not establish public accessibility. *Infobridge*, 929 F.3d at 1369; *Acceleration Bay*, 908 F.3d at 773. Numerous decisions from the Board confirm this principle. See, e.g., *Microsoft Corp. v. Throughputer, Inc.*, IPR2022-01566, Paper 13 (PTAB May 31, 2023), 2023 WL 5167054 (Zeher, R., et al.) at *4 (“public

accessibility requires more than technical accessibility”).

To establish that WD-Manual was publicly accessible “via the www.wdc.com website,” as asserted (Reply, 10), Petitioner must establish: (1) evidence showing that a person interested in the art knew of the www.wdc.com website or could have reasonably found it; and (2) evidence that the www.wdc.com website was meaningfully indexed or catalogued or otherwise organized such that a person interested in the field of the ’254 Patent could have found WD-Manual on that website exercising reasonable diligence. *Infobridge*, 929 F.3d at 1369 (citing *Acceleration Bay*). *Infobridge* holds that this evidence is “critical.” *Id.* The Petitioner has failed to establish this critical evidence.

The declaration from a Records Request Processor of the Internet Archive, Nathaniel Frank-White, is, at best, evidence of technical accessibility. Ex. 1012 (“Internet Archive Decl.”), 2. See Reply, 8-9. Mr. Frank-White provides no evidence that a person interested in the ’254 Patent’s field (user interfaces with EPGs) would have known of the www.wdc.com website, or that such a person could have located

the www.wdc.com website exercising reasonable diligence.¹ *Id.*, 1-2. *Infobridge*, 929 F.3d at 1369. *See Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374, 1380 (Fed. Cir. 2012). Petitioner’s Reply (at 8-9) does not dispute that Mr. Frank-White is unqualified to give evidence (which he does not) on whether an interested artisan would have known of the www.wdc.com website or could have reasonably located it. See POR, 19-20; Reply, 8-10.

Mr. Frank-White’s declaration also does not provide any evidence on the second prong of the *Infobridge*, which is whether the www.wdc.com website was “meaningfully indexed” or otherwise organized, as of the priority date (August 2012), such that an interested person, once at the website, could locate the WD-Manual document exercising reasonable diligence. *Infobridge*, 929 F.3d at 1369. The Internet Archive declaration provides no information on whether the www.wdc.com site was indexed or searchable, let alone that an interested person could locate WD-Manual on it. Internet Archives Decl., 1-2, Part B. Mr. Frank-White could not give such evidence (and did not) because he is not qualified to speak

¹ The Board has held that a declaration from the Internet Archive is insufficient to establish public accessibility. *First Solar, Inc. v. Sade*, IPR2023-00881, Paper 13 (PTAB Nov. 16, 2023), 2023 WL 7923924 at *7.

as an expert in the field of the '254 Patent. Petitioner's Reply (at 8-9) does not dispute any of these points.

The Petition and the Reply provide *no evidence* on whether the www.wdc.com website was meaningfully indexed, searchable, or otherwise organized such that a person interested in the art could locate WD-Manual. Reply, 8-11; Pet., 13-14. The bald assertion that “[a]ny person interested in learning more about the WD TV Live Hub would have been able to browse the www.wdc.com website” to find WD-Manual is pure made-up attorney argument without citation to evidence. Reply, 10. Further, the test is not whether the relevant artisan, pre-informed of the website, would have been able to “browse” the site to locate the reference. The test is whether the www.wdc.com website was meaningfully indexed, catalogued, or otherwise organized such that an interested artisan could locate WD-Manual exercising reasonable diligence—even assuming (without evidence) that such a person would have found the www.wdc.com website to begin with. *Infobridge*, 929 F.3d at 1369. Ultimately, the Petitioner provides no evidence on the structure and layout of the website, let alone evidence that it was “*meaningfully indexed*” or otherwise organized such that WD-Manual could be located with reasonable diligence. *Infobridge*, 929 F.3d at 1369 (orig. italics). For example, there is no evidence that there were five sub-levels of available menus at all, much less five levels of meaningfully organized menus that would have led an interested

artisan from www.wdc.com to www.wdc.com/wdproducts/library/UM/ENG/4779-705046.pdf.

Petitioner's Reply also does not dispute that Petitioner's own technical expert, who was allegedly a POSITA at the time of the invention, testified in deposition that he had not heard of the www.wdc.com website or WD-Manual prior to this IPR. See Reply, 8-10. Petitioner's technical expert never accessed that website and never did any research to determine whether WD-Manual was publicly accessible on the Internet. For example, he conceded "I did not look for the WD Manual on the internet. ... I did not search for the WD Manual." Ex. 2010 (Dep. Trans. Lippman), 72:2-73:9. He conceded that he did nothing to confirm WD-Manual was available on the Internet in the 2012 period. *Id.*, 158:24-159:3. He had never even seen WD-Manual before this IPR. *Id.*, 71:20-22. He further admitted "I was not familiar with [the product]" prior to the IPR. *Id.*, 159:5-11.

Indeed, this testimony of the Petitioner's expert—a self-described POSITA as of the priority date of August 2012 (see Ex. 1003, ¶ 20)—is affirmative evidence that an interested person **would not** have known of the www.wdc.com website. If Petitioner's declarant is a POSITA (and even an alleged expert) in the field, the fact he had never accessed the www.wdc.com website and did not know of the WD-Manual or product confirms that a person interested in the field would not have known of the www.wdc.com website and had no reason to look for WD-Manual.

The Petitioner had the option to submit supplemental evidence on this point from its technical expert in reply to Patent Owner's Response raising this issue, but was unable to do so. See Reply, 8-11. That says something.

In the final analysis, the Petitioner provides no evidence that an interested artisan could have located WD-Manual exercising reasonable diligence. Under these circumstances, the WD-Manual reference should be disqualified as a printed publication.

2. The Collateral Documents Do Not Establish Public Accessibility

Because it cannot find an expert to give evidence on public accessibility, the Petitioner is forced to rely on a handful of collateral hearsay documents. Reply, 9-11.

a. Purported Press Release

Petitioner's Reply refers to the October 2010 press release, but it is only evidence that a product named the "WD TV Live Hub media center" was allegedly available for purchase. Ex. 1020, 1. This press release does not reference WD-Manual. Thus, the press release does not disclose WD-Manual or provide a roadmap for an interested person to locate it.

Moreover, an article cannot provide a roadmap to the reference if the article itself was not publicly accessible. *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d

1331, 1350 (Fed. Cir. 2016). There is no evidence provided to establish that the press release itself was publicly accessible. Pet., 14. Petitioner’s Reply (at 9) cites the Internet Archives declaration, but Mr. Frank-White’s evidence only establishes technical accessibility, not public accessibility. *Acceleration Bay*, 908 F.3d at 772. The Reply argues that the press release is publicly disseminated “by its nature.” Reply, 9.² No case law is cited for that proposition. On this record, there is no evidence that the press release was actually disseminated to persons of interest or that it could have been located by persons of interest exercising reasonable diligence.

Petitioner’s Reply misleadingly asserts that the October 2010 press release provides a hyperlink to the “product page” at www.wdc.com. Reply, 9. That is incorrect. First, the Reply does not assert (because it cannot) that the hyperlink is to the WD-Manual reference. Second, the press release does *not* reference a product page at www.wdc.com. Instead, the press release only refers to these other websites: www.westerndigital.com (for investors), wdstore.com (for sales), and

² The argument that the October 2010 press release was publicly accessible because it was allegedly disseminated is newly presented on reply. *Compare* Pet., 14. This foreseeable argument should be deemed waived. See Pet., 14. CTG (Nov. 2019). Also, there is no evidence to support it.

support.wdc.com/warranty (for warranty issues). Ex. 1020, 2. The press release (1) is not shown to be publicly accessible, (2) does not reference WD-Manual, and (3) does not provide a roadmap to WD-Manual.

b. B&H Photo webpage

The Petitioner asserts that a webpage from the B&H Photo website (Ex. 1024) shows a product “was available for purchase.” Reply, 9. But the alleged on-sale status of a product does not establish the public accessibility of WD-Manual. The Petitioner does not dispute that the B&H Photo webpage fails to reference WD-Manual. POR, 21. Reply, 9. And there is no evidence that the B&H Photo webpage was itself publicly accessible. Reply, 9. Pet., 14. Furthermore, the Petitioner does not establish that even a single product was sold or that WD-Manual was provided with any potentially sold product. On the contrary, Ex. 1023 indicates “there’s no manual in the box.” Ex. 1023, 3.

c. WD TV LIVE webpage

There is no showing that the WD TV LIVE Hub page of Ex. 1022 was publicly accessible to a person of interest in this field. There is no showing that an interested artisan would have known of the www.wdc.com root website, or that an interested artisan could have located that website exercising reasonable diligence. Once again, there is no evidence that the www.wdc.com website was meaningfully indexed or organized such that an interested artisan could locate WD-Manual on it. See Reply

9-10. POR, 22.

d. Photography Bay website

The Photography Bay webpage (Ex. 1023) does not establish the public accessibility of WD-Manual at the location:

www.wdc.com/wdproducts/library/UM/ENG/4779-705046.pdf

See Reply, 10. There is no evidence that the Photography Bay webpage of Ex. 1023 was publicly accessible, as required to show it could reasonably lead interested artisans to information referenced therein. *Blue Calypso*, 815 F.3d at 1350. The Internet Archive declaration at most establishes technical accessibility, not public accessibility, of the Photography Bay webpage. See Ex. 1012. There is no evidence that the Photography Bay webpage was known to the relevant persons of interest. Having failed the *Blue Calypso* test, the Photography Bay webpage of Ex. 1023 is unavailing to establish a roadmap to any URL it allegedly references.³

Petitioner asserts Patent Owner's expert testified the Photography

³ Petitioner provides no evidence that the tags (e.g., "storage," "Photos," "WD Photo," etc.) allegedly associated with the product review would enable an interested person to locate the Photography Bay webpage, let alone the WD-Manual itself. See Reply, 10.

Bay website is a well-known provider of video hardware products. See Reply, 10, citing Ex. 1026, 22:7-10. Petitioner's assertion is utterly false. Patent Owner's expert was referring to **Ex. 1024**, the B&H Photo website, not Ex. 1023, the Photography Bay website. Ex. 1026, 22:1-10. The Petitioner provides no evidence that the Photography Bay webpage was known to relevant interested artisans or that they could reasonably locate it. Indeed, there's no evidence that a person of skill in the '254 Patent's field of user interfaces with EPGs would be interested in a website for photography hobbyists.

Petitioner's Reply suggests that the Photography Bay reviewer, Eric Reagan (Ex. 1023, 1), was somehow "representative" of the class of skilled artisans interested in the field. Reply, 10. However, there is no evidence Mr. Reagan was an interested artisan in the '254 Patent's field (user interfaces with EPGs), much less "representative" of such artisans. Reply, 10. There is also no evidence of how Mr. Reagan came to possess the obscure URL allegedly referenced in his review. For example, there is no evidence that he located it by searching or browsing. Regardless of how Mr. Reagan came into possession of WD-Manual, the fact that a single person had a copy of WD-Manual is not evidence of public accessibility. Reply, 10. *See, e.g., In re Cronyn*, 890 F.2d 1158, 1159-60 (Fed. Cir. 1989) (copy available to four persons is insufficient); *In re Bayer*, 568 F.2d 1357, 1360, 1361 (CCPA 1978) (copy available to three persons is insufficient).

Considered individually and as a whole, the collateral documents do not remotely establish that (1) an interested person would know of the www.wdc.com website or could reasonably locate it, or that (2) the www.wdc.com website was meaningfully indexed, searchable, or otherwise organized such that an interested person, once at that site, could locate the WD-Manual reference at the fifth level subdirectory at www.wdc.com/wdproducts/library/UM/ENG/4779-705046.pdf location exercising reasonable diligence. *Infobridge*, 929 F.3d at 1369. The WD-Manual should be disqualified as eligible art, and the Challenged Claims should be confirmed as patentable.

III. CLAIMS 1, 8, AND 14 ARE PATENTABLE OVER KIM, WD-MANUAL, AND BAE (GROUND 1)

A. Kim, WD-Manual, and Bae Fail to Teach Limitation 1.2 for “Displaying ...an On Screen Channel Changer ... Comprising Electronic Program Guide (‘EPG’) Information and a Number Input Bar Comprising Digits”

1. The Petitioner Presents the References as an Improper Abstract Combination

The Petitioner proposes an abstract combination of Kim and Bae. The Petition failed to provide an explanation of how the elements from Kim and Bae are combined and how that combination works to meet the claimed invention. POR, 32-39. The Reply again fails to do so. See Reply, 11-15. The Patent Owner cited cases from the Federal Circuit and the Board holding that the burden is on the challenger

to explain how the references are combined and how the resulting combination works. POR, 34-36 (citing *Trivascular*, *Kinetic Concepts*, *Power One*, *Provisur*, *Metalcraft*, *Innogenics*, *Personal Web Technologies*, *Ex Parte King*, etc.). The Reply does not address any of these cases.

As explained further in the next section, the Petitioner has made the combination of references in the abstract, instead of combining their teachings into an operable embodiment. But the Petitioner must demonstrate an operable embodiment by explaining how the elements from the prior art are combined and how that combination works. *See, e.g., Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016); *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1368 (Fed. Cir. 2012). As the Federal Circuit stated in *Personal Web Technologies, LLC v. Apple, Inc.*, 848 F.3d 987, 993-994 (Fed. Cir. 2017), the Petitioner must provide “clearly explained ... evidence showing, how the combination of references was supposed to work.”

The Reply fails to provide that explanation and evidence supporting it. Further, the detailed testimony of the Patent Owner’s expert on this deficiency is un rebutted. Surati Decl., ¶¶ 152-160.

2. The Home Screen (Card Object Area) of Kim Modified by Bae's Number Input Bar Does Not Meet Limitation 1.2

The Reply goes back and forth on whether its argument is that (1) the Channel Browser and TV Guide card objects are the claimed “*on screen channel changer(s)*,” or (2) it is Kim’s card object area/home screen *containing* the Channel Browser and TV Guide card objects that is the “*on screen channel changer*.” Reply, 11-12, 15-16.⁴ It does not matter. What matters is that the Petitioner and its expert are unequivocal that the channel changer functionality is provided by the Channel Browser and TV Guide card objects because they provide thumbnails and program listings that can be selected to change the channel. Ex. 1003 (Lippman Decl.), ¶ 104. Pet, 30-31.

The Reply argues the number input bar (330) from Bae would be applied to the alleged “*on screen channel changer*” of Kim to meet limitation 1.2. Reply, 12, 15 (“the Petition contemplates modifying” Kim’s home screen/card area). The Reply

⁴ The Reply concedes that Petitioner’s position is that “Kim’s individual channel-changing card objects [are] the CHANNEL BROWSER and TV GUIDE card objects ...” Reply, 20.

vaguely explains that Bae's number input bar would be "added" so that it is "within" Kim's home screen/card object area.⁵ Reply, 12-13, 15.

The modified user interface does not work.⁶ For one thing, Bae's on screen channel changer requires a channel number display window (310) in addition to the number input bar. The channel number display window is needed to show the user what numbers have been input by the user so far. Bae, Abstract, [0024]. For example, as the user enters 2, 3, and 2, the user can see that he/she has entered 2, 23, and 232 in the channel display window. Bae, [0025]-[0026]. Surati Decl., ¶¶ 119-122.

But the Petitioner only proposes adding Bae's number input bar to Kim's home screen/card area. Reply, 13, 15. There is no proposal to include Bae's channel number display window. As for Kim, it has no channel number display window. See Kim, Figs. 19, 22. Accordingly, adding Bae's number input bar to Kim's home

⁵ The Petitioner refers to the "card object area" of Kim. The card object area is the home screen of Kim. Kim, Fig. 19, [0193] ("card object area" "defined in a home screen 1300").

⁶ This is not an improper bodily incorporation argument. It is the Petitioner that asserts that Kim's card object area/home screen is modified to include the number input bar from Bae. See Reply, 12-13, 15; Lippman Decl., ¶¶ 83, 123.

screen does not provide an operable embodiment to meet limitation 1.2. Certainly, a POSITA would not have reason to make the combination as proposed. Surati Decl., ¶¶ 161-162.

The Petitioner’s expert testimony on this point is conclusory, and it never explains what the combination is and how it works. Ex. 1003 (Lippman Decl.”), ¶¶ 99-104. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (PTAB Aug. 24, 2022), 2022 WL 3648989, at *6 (precedential) (disregarding conclusory expert testimony lacking “technical reasoning”). On the other hand, the Patent Owner’s expert explains in detail why the combination would not work. Ex. 2008 (Surati Decl.”), ¶¶ 159-164.

The Reply does not dispute that in deposition, its expert, Dr. Lippman, was repeatedly asked how the Kim/Bae combination would work, and he was unable to provide a meaningful answer. See Surati Decl. ¶¶ 164-169 (citing Ex. 2010, Dep. Trans. Lippman, at 130:21-131:25, 132:2-12, 152:21-154:2). For example, Petitioner’s expert Dr. Lippman explained the combination as follows: “You would choose to display EPG information either the way Kim does or an altered way that Kim does using the teachings of Kim so that you would end up with an artful and usable user interface with Bae added to it.” Ex. 2010, 152:21-153:3. That does not make sense. Ultimately, Dr. Lippman settled on this answer: The combination would be an “admixture” of Kim and Bae. Ex. 2010 (Dep. Trans. Lippman), 152:21-154:2,

something he repeated. *Id.*, 155:9-12. It is unclear what this “admixture” is. Whatever it is, he and the Petitioner have not demonstrated it to be an operable embodiment that meets limitation 1.2. *TQ Delta, LLC v. CISCO Systems, Inc.*, 942 F.3d 1352, 1360 (Fed. Cir. 2019) (cite omitted) (“the expert failed to explain how specific references could be combined ... or how any specific combination would operate”).

3. The Petitioner’s Arguments on Motivation to Combine Are Without Merit

The Petitioner attempts to reframe its argument regarding Kim’s remote control without a keypad. Reply, 18-19. In Kim, a remote control without a keypad is used to change channels by selecting icons in Kim’s card objects (e.g., Channel Browser, TV Guide objects). Kim, Figs. 19, 22, [0167]-[0171]. The disclosure in Kim of a remote control without a keypad does not provide a motivation to refer to Bae’s number input bar. POR, 47-48; Surati Decl., ¶¶ 181-182.

Indeed, the design concept of Kim is to provide a user interface allowing the user to select graphical objects *without having to select channel numbers* using the remote control or the user interface on the television. See Kim, Fig. 13 (remote control without number buttons to select graphical objects on display 180), Fig. 19 (home screen with card objects on display 180), Fig. 22 (same), [0167]-[0171], [0187], [0192]-[0212], [0229]. The proposed modification to have the user select

channel numbers is directly counter to the principle of operation of Kim. A POSITA would not modify Kim's home screen to incorporate the channel number input bar of Bae. Surati Decl., ¶¶ 161-162.

The argument that Bae is needed to enable Kim's user to "directly change to a specific channel" is without merit. Reply, 13. The Reply does not dispute that Kim's device is a set-top box and that it was well understood that set-top boxes allowed a user to directly input a channel number to change the channel. POR, 46-47. POR, 45 (citing Ex. 2011, 2012, 2013, 2015, 2018, 2019). There is no reason for a POSITA to refer to Bae to allow a user to directly input channel numbers. Surati Decl., ¶¶ 175-180.

Additionally, the proposed combination would not have a reasonable expectation of success. The demonstration of a reasonable expectation of success is not a formality—it is a fundamental requirement of the obviousness case. *Endo Pharm., Inc. v. Actavis LLC*, 922 F.3d 1365, 1373 (Fed. Cir. 2019); *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1361 (Fed. Cir. 2007). The Petitioner's expert's analysis for reasonable expectation of success is a one-sentence conclusory assertion. Lippman Decl., ¶ 83. The Patent Owner's expert, on the other hand, provides a detailed analysis with citation to evidence explaining why the combination would not work for its intended purpose. Surati Decl., ¶¶ 160-164.

B. The References Fail to Teach Limitation 1.5.2 for “*An Application Center Button That, When Selected ... Provides ... Displayed Information Regarding Pre-Installed and Downloaded Software Applications*”

1. The Combination of WD-Manual and Kim Does Not Meet Limitation 1.5.2

For the “*displayed information regarding pre-installed and downloaded software applications*” of limitation 1.5.2, the Petitioner relies on Kim. The Petitioner references a hodgepodge of passages relating to different embodiments in Kim. Reply, 22-23. Kim’s paragraph [0099] refers to the display of a “list of applications that are available in the image display apparatus or downloadable from an external network.” That does not teach the display of “*pre-installed*” software applications that are (1) pre-installed, (2) not removable, and (3) not manually updatable. The Reply (at 22-23) tries to couple paragraph [0099] from Figure 6 (system diagram) with paragraph [0158] from Figures 11-12 (software architecture diagrams). Reply, 22. Paragraph [0158] indicates that the application layer in Figures 11-12 may include “user-undeletable applications.” But those passages do not teach the *display* of user-undeletable applications to the user. Also, the Petitioner makes no argument that Kim’s display of a list of applications per [0099] (Fig. 6) would be modified to include user-undeletable applications per [0157]-[0158] (Figs. 11-12). Reply, 22-23.

Even if the Petitioner proposed combining those teachings (which it did not), the result still fails to teach a **pre-installed application**, meaning one that was installed before the user obtained the device. It also does not teach a pre-installed application that cannot be manually updated. Kim is completely silent on both points. POR, 53, 55-57; Surati Decl., ¶¶ 198, 204-208.

The Petitioner also refers to the “application list view menu” of Figure 16 and the “application menu” of Figure 34 of Kim. Reply, 28. The Reply does not seriously dispute the Patent Owner’s point that neither example provides a display of “*pre-installed ... applications*,” as defined in the specification of the ’254 Patent. Reply, 28-29. The Petitioner again refers to the software stack for the application layer in Figures 11 and 12. Reply, 28-29. These describe software applications on the device, not the *display* of applications to the user. Moreover, nowhere does Kim teach or suggest that user-undeletable apps are displayed to the user.

2. WD-Manual’s “Internet Services” Display Combined With Kim Does Not Meet Limitation 1.5.2

The Petitioner concedes that the Internet Services display of WD-Manual does not teach “*pre-installed and downloaded software applications*.” Reply, 25 (“Petition does not rely on WD-Manual for teaching services that are either pre-installed or downloaded software applications.”).

Having said that, Petitioner proceeds to present a new theory of obviousness that the display of pre-installed/downloaded applications is met by the Internet Services display of WD-Manual. Reply, 25. This improper new theory was never presented in the Petition (as the Petitioner admits), and it should be disregarded.

The new argument fails on the merits. The Internet Services menu shows services “fully integrated with their web-based counterparts.” WD-Manual, 76. In other words, the device is configured so the browser can use the URL to connect to a website (e.g., www.youtube.com). Surati Decl., ¶¶ 188-192. Indeed, WD-Manual describes the Internet Services menu as presenting a “list of Internet services,” and makes no reference to the menu as displaying downloaded software applications or pre-installed software applications. WD-Manual, 77. Surati Decl., ¶ 191.

The Petitioner’s expert asserts that “[a] POSITA would recognize that ‘Services’ (e.g., Netflix, Facebook, Flickr, Pandora) are software applications.” Lippman Decl., ¶ 194. No reasoning is provided, no evidence is provided, and thus that testimony should be given no weight. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (PTAB Aug. 24, 2022), 2022 WL 3648989, at *6 (precedential). The Patent Owner’s expert, Dr. Surati, provides reasoning to the contrary that is amply supported by evidence. Surati Decl., ¶¶ 193-194, 196.

The Reply has no answer to the Patent Owner’s point that if services such as YouTube and Facebook were downloaded software applications, then the index of

WD-Manual surely would have information on downloading or updating those applications. But it does not. See Surati Decl., ¶¶ 194, 196 (citing to WD-Manual, 160-164, also referring to WD-Manual’s Chapter 13 for “Setup and Advanced Features”). The Patent Owner’s expert’s detailed explanation coupled to evidence should be credited over the Petitioner’s expert’s conclusory assertion.

The combination of Kim with WD-Manual and Bae does not meet limitation 1.5.2.

C. Kim, WD-Manual, and Bae Fail to Teach Limitation 1.5.3 for “*An Application Panel Button that, When Selected ... Displays ... An Information Panel Regarding a Selected (Pre-Installed or Previously Downloaded) Application Icon*”

1. The Petitioner’s Reliance on the “App Store” Display of Figure 25 and the “Application List” of Figure 16 Is Misplaced

The Petitioner relies on the App Store menu of Figure 25 of Kim. Reply, 31. The App Store presents applications stored on a third party website available for purchase and download, not applications stored on the user’s image display apparatus, as Petitioner’s theory requires. Surati Decl., ¶¶ 229-234. See Kim, [0202] (App Store displays “applications available on a server” “for download or purchase *from* the image display apparatus”), [0234] (App Store presents “application market screens”), [0238] (App Store is an “application market”)

The Petitioner makes an improper new argument based on Figure 25's display of "newly added applications." Reply, 32 (citing Kim, [0236]). That argument and evidence was not presented in the Petition or the expert declaration of Dr. Lippman and should be deemed waived. Even so, the argument fails on the merits. A POSITA would understand that the "newly added applications" tab on the App Store refers to applications that are newly available from the App Store, not new applications stored on a user's image display device.

The Petitioner also refers to Figure 16, which depicts an "application list view menu" of a "list of applications [] stored in the image display apparatus." Kim, [0184]. Reply, 36-37 (citing Kim, [0184]-[0185]). The application list "may include both applications available over the network as well as applications available locally." Kim, [0185]. This does not remotely teach the display of information about a "*pre-installed ... application*" per 1.5.3.

2. The Back-Up Argument Based On Access to Flickr and Facebook Is Without Merit

The Reply argues that selecting the Options button when in the Flickr menu renders a display that "identifies the selected application." Reply, 33-34. WD-Manual states that selecting the Options button causes the device to display "Flickr home page options." WD-Manual, 86. The options are "Last 7 Days Interesting," "Most recent uploads," "Hot Tags," "My Contacts," and "My Tags." WD-Manual,

91. These refer to *photo files*, not software “*application[s]*” per limitation 1.5.3. Surati Decl., ¶¶ 192-196, 222.

Thus, the Petitioner’s assertion that “WD-Manual teaches an Options button that, when selected displays an application panel with an information panel regarding a *selected service*” (Reply, 34) does not meet the requirement that selecting an application icon causes the display of information about a *software application* per limitation 1.5.3.

The Reply also makes an argument based on the disclosure that a user can mark Facebook as a favorite. Reply, 34-36. The Reply also refers to accessing information about a photo file, beachsunset.jpg. Reply, 35-36. These examples are impertinent because the Options button is being used to designate a service or a file as a favorite, not to display information about a selected *application icon* per 1.5.3.

IV. CLAIMS 6, 12, AND 19 ARE PATENTABLE OVER KIM, WD-MANUAL, BAE, AND COBURN (GROUND 2)

For Claim 6, the Petitioner bases its argument on the Search Window of Figure 38 in Kim. Reply, 38. But Petitioner’s theory for Claim 1 is based on the home screen/card object area of Kim, as depicted in Figures 19 and 22, as discussed above in Section III.A. See Pet, 23, (Fig. 22), 91-92 (Fig. 19). The Petitioner’s shifting theory of obviousness fails to establish Claim 6 is unpatentable. See POR, 72. Surati Decl., ¶ 237.

Claim 6 provides for “*updat[ing] the EPG information*” “*as the user selects each digit.*” The Petition does not explain how the thumbnails in the Channel Browser or the program listings in the TV Guide object (allegedly, the “*EPG information*”) would be updated based on a user entering digits. POR, 70. Instead, the Petitioner refers to the updating of a channel indicator window in Coburn. Reply, 40. See POR, 71. Surati Decl., ¶¶ 241. The Petitioner’s theory does not meet limitation 6.1.

The Reply’s argument about bodily incorporation (Reply, 41) is misplaced. It is the Petitioner that repeatedly asserts that the claimed “*EPG information*” refers to the thumbnails in the Channel Browser and the program listings in the TV Guide. See Pet., 37; Reply, 12. The Petitioner and its expert make no showing as to how (or even whether) the thumbnails or program listings would be updated in the modified home screen as the user enters each digit to meet limitation 6.1.

Accordingly, Claim 6 is patentable over the four-part combination of Kim, WD-Manual, Bae, and Coburn.

V. CONCLUSION

For the foregoing reasons, the Challenged Claims should be confirmed as patentable.

Respectfully submitted,

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Date: January 30, 2025

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Sur-Reply consists of 5,566 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The Sur-Reply complies with the type-volume limitation of 5,600 words as mandated in 37 C.F.R. § 42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

Respectfully submitted,

/Stephen T. Schreiner/

Date: January 30, 2025

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following document was served by electronic service, by agreement between the parties, on the date below:

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