UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FREEWHEEL MEDIA, INC.,

Petitioner,

v.

INTENT IQ, LLC,
Patent Owner.

IPR2024-00421
Patent 7,861,260 B2

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE UNDER 37 C.F.R. § 42.23

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EXHIBITS

Previously Filed:

Ex. 1001:	U.S. Pat. No. 7,861,260 ("the '260 Patent")
Ex. 1002:	Expert Declaration of Mr. David B. Lett
Ex. 1003:	Curriculum Vitae of Mr. David B. Lett
Ex. 1004:	Certified File History of U.S. Pat. No. 7,861,260
Ex. 1005:	Excerpts from Case Docket of *Meta Platforms Inc. v. AlmondNet Inc. et al.*, IPR2022-00773 (March 28, 2022)
Ex. 1006:	U.S. Pat. App. Pub. No 2007/0283384 ("Haeuser")
Ex. 1007:	Annotated Version of U.S. Pat. App. Pub. No. 2008/0113674 ("Baig")
Ex. 1008:	U.S. Prov. Pat. App. No. 60/858,204 ("Baig Provisional")
Ex. 1009:	Redline document showing differences between Baig (Ex. 1040) and Baig Provisional (Ex. 1008)
Ex. 1010:	Reserved
Ex. 1011:	U.S. Pat. App. Pub. No. 2006/0128364 ("Costa")
Ex. 1012:	Excerpts from E. D. Zwicky et al., *Building Internet Firewalls* (2d ed. 2000) ("Zwicky")
Ex. 1013:	U.S. Pat. App. Pub. No. 2004/0076180 ("Satapati")
Ex. 1014	U.S. Pat. App. Pub. No. 2006/0271690 ("Banga690")
Ex. 1015:	Independent Claim Comparison Chart for U.S. Pat. No. 7,861,260
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Ex. 1028:	U.S. Pat. App. Pub. No. 2006/0230427 ("Kunkel")
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Ex. 1032:	U.S. Pat. No. 6,282,548 ("Burner")
Ex. 1033:	U.S. Pat. No. 6,036,601 ("Heckel")
Ex. 1034:	U.S. Pat. App. Pub. No. 2005/0096978 ("Black")
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Ex. 1037:	Zeff *et al.*, *Advertising on the Internet* (2nd ed. 1999) ("Zeff")
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Ex. 1039:	Request for Comments: 793, "Transmission Control Protocol" (1981) ("RFC 793")

Ex. 1040:	U.S. Pat. App. Pub. No. 2008/0113674 ("Baig")
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Ex. 1044:	U.S. Pat. App. Pub. No. 2002/0174444 ("Gatto")
Ex. 1045:	U.S. Pat. App. Pub. No. 2002/0083445 ("Flickinger")
Ex. 1046:	U.S. Pat. App. Pub. No. 2008/0040742 ("Howcroft742")
Ex. 1047:	Jakob Nielsen, *Request Marketing* (Oct. 2000), https://www.nngroup.com/articles/request-marketing/
Ex. 1048:	Bettina Fabos, *The Commercial Search Engine Industry and Alternatives to the Oligopoly* (Mar. 2006) EastBound Journal
Ex. 1049:	Susan Young, *Getting the Message: How the Internet is Changing Advertising* (May 16, 2000), https://hbswk.hbs.edu/item/getting-the-message-how-the-internet-is-changing-advertising
Ex. 1050:	U.S. Pat. App. Pub. No. 2002/0099842 ("Jennings")
Ex. 1051:	U.S. Pat. App. Pub. No. 2002/0123928 ("Eldering928")
Ex. 1052:	Request for Comments: 2663, "IP Network Address Translator (NAT) Terminology and Considerations" (1999) ("RFC 2663")
Ex. 1053:	ANSI/IEEE Std 802.11, 1999 Edition, "Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) Specifications"
Ex. 1054:	Excerpts from Harley Hahn, *The Internet Complete Reference* (2d ed. 1996) ("Hahn")
Ex. 1055:	U.S. Pat. App. Pub. No. 2005/0108418 ("Bedi")
Ex. 1056:	U.S. Pat. App. Pub. No. 2004/0177147 ("Joshi")

Ex. 1057:	Excerpts from Downing *et al.*, *Dictionary of Computer and Internet Terms* (8th ed. 2003)
Ex. 1058:	Excerpts from Newton, *Newton's Telecom Dictionary* (21st ed. 2005)
Ex. 1059:	Declaration of Dr. Sylvia Hall-Ellis
Ex. 1060:	Institution Decision from *Meta Platforms, Inc. f/k/a Facebook, Inc. v. Intent IQ, LLC et al.*, IPR2023-01281, Paper 7 (February 21, 2024)
Ex. 1061:	U.S. Pat. No. 6,427,170 ("Sitaraman")

Filed Herewith:

Ex. 1062:	Transcript of March 10, 2025 Deposition of Erik de la Iglesia
Ex. 1063:	Declaration of Dr. David B. Lett in Support of Petitioner's Reply to Patent Owner Response
Ex. 1064:	U.S. Pat. No. 6,745,223 ("Nobakht")
Ex. 1065:	U.S. Pat. No. 8,640,176 ("Howcroft176")
Ex. 1066:	U.S. Pat. No. 8,619,136 ("Howarter")
Ex. 1067:	U.S. Pat. App. Pub. No. 2001/0039658 ("Walton")
Ex. 1068:	U.S. Pat. App. Pub. No. 2002/0044103 ("Paulson")
Ex. 1069:	U.S. Pat. No. 5,539,822 ("Lett822")
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Ex. 1077: U.S. Pat. App. Pub. No. 2008/0235590 ("Krantz")

I. INTRODUCTION

Between two counterpart petitions, Petitioner provided a detailed explanation of the obviousness of all 152 claims of the '260 Patent. Patent Owner's only response is an argument about motivation to combine that misconstrues the Petition and the prior art. Patent Owner essentially argues a strawman, i.e., that the prior art combination set forth in the Petition was limited to the use of a STB *in a coffee shop*, which Patent Owner argues would not have been obvious because coffee shops purportedly have no use for a STB. The Petition and prior art were not so limited, and Patent Owner's failure to address the combination actually raised in the Petition dooms its case. *See Hamilton Technologies LLC v. Fleur Tehrani*, IPR2020-01199, Paper 57, 36-37, 48-49 (PTAB Dec. 28, 2021) (finding that "Petitioner has demonstrated, by a preponderance of the evidence, the unpatentability of [the claims]" where patent owner's arguments "misstate[d] Petitioner's proposed combination."); *Apple Inc. v. Achates Reference Publishing, Inc.*, IPR2013-00080, Paper 22, 25-26 (PTAB Jun. 3, 2013); *Philip Morris Products, S.A. v. Rai Strategic Holdings, Inc.*, IPR2020-00921, Paper 9, 26-27 (PTAB Nov. 16, 2020) (finding "Patent Owner's substantive response as weak," where Patent Owner "misstates Petitioner's contention[s].").

Specifically, Patent Owner contends that it would not have been obvious (1) to include a STB, as taught by Costa, at a public hotspot system residing in a coffee

shop (an example hotspot disclosed by Baig), or (2) to use the STB and its associated display to access Baig's website, purportedly because Baig's website does not provide television service. POR, 4-6. Neither of these arguments is persuasive.

Patent Owner's first argument, involving the motivation for having a STB at a coffee shop, fails for at least two reasons. *First*, neither Baig, Costa, nor the combinations set forth in the Petition limit the public hotspot to coffee shop environments. *Second*, Patent Owner is simply wrong that there is something special about a coffee shop that would render it unobvious to have a STB in one (as opposed to any of the other types of public hotspots, such as airports, bars, hotels, barbershops, college student lounges, etc.). A POSA would have been motivated to install a STB at a public Wi-Fi hotspot, including at a coffee shop. Ex. 1063, ¶¶ 6, 12-29.

Patent Owner's second argument, involving the motivation for having a STB in a public location access Baig's VCSP website, is likewise unavailing. At the time of the alleged invention, a POSA was well aware that televisions attached to STBs in public places presented more than just television programming. Put another way, no *skilled* artisan would have understood STBs as being limited to the provision of television programming, to the exclusion of, e.g., other web content. Ex. 1063, ¶¶ 6, 30-34.

As explained in detail below, the Petition provided clear motivations under *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) to add a STB to a public wireless hotspot and a reasoned analysis of how and why the STB would be used to visit Baig's VCSP website. Pet. 10-12, 26-28. Thus, the Board should cancel claims 1-5, 7, 11-20, 22, 26-28, 35-38, 41, 44, 54, 56-58, 61-62, 71-75, 77-80, 83-84, 86, 90-99, 101, 105-106, 116, 118-119, 125, 127-128, 137-141, 143-144, 148, and 151-152 of the '260 Patent as requested.

II. ARGUMENT

A. The Petition's Baig-Costa-Zwicky and Baig-Costa-Banga690 combinations were not limited to a coffee shop

Patent Owner's argument hinges on its flawed understanding that Petitioner's Baig-Costa-Zwicky and Baig-Costa-Banga690 combinations are limited to a coffee shop. *See* POR, 1-2, 4-5. For example, Patent Owner contends that "[a] coffee shop is the only specific example of a location to which the Petition or the corresponding expert declaration allege it would have been obvious to add a STB," and that the Petition failed to support the combination in this specific environment based on "common coffee shop behaviors." POR, 5-6, 8. This contention is parroted by Patent Owner's expert, Mr. de la Iglesia. Ex. 2001, ¶ 33 ("a coffee shop is the only example of a location that Mr. Lett provides in which it would have been allegedly obvious to provide a STB"). Indeed, Mr. de la Iglesia admitted that he analyzed the proposed combinations only within the context of a coffee shop. Ex. 1062, 13:19-23

(admitting it was his understanding "that [Mr.] Lett's only suggestion in terms of combination was a coffee shop"), 25:10-16.

The Petition, Baig, and Costa are not so limited. In its discussion of the Baig-Costa-Zwicky and Baig-Costa-Banga690 combinations, the Petition discusses public hotspots in general. Pet. 7-11. For example, the Petition explained the combined system as follows:

> Applying Costa to Baig would result in a system with a STB connected through the common hotspot AP. In the proposed combinations, the STB would have the same common IP address as the other devices 102 at that AP (claimed "common IP address"), and thus would be included in the vicinity-based group represented by list 606 of website 600 in Baig's Figure 6, as discussed below. Ex. 1002, ¶¶158, 198-199; Section V.A.1.b.ii; Ex. 1007, Fig. 6. Network traffic, e.g., from outside of the hotspot, would be routed to both the devices 102 and the STB via the common IP address of AP 106. Ex. 1002, ¶158.

Pet. 11. And the Petition's explanation of why the Baig-Costa-Zwicky and Baig-Costa-Banga690 combinations would have been obvious to a POSA similarly focused on public hotspots, not just coffee shop hotspots. Pet. 7-9, 12 ("[a] POSA would be motivated to include Costa's STB because it beneficially allows customers at a public establishment to watch television or other information on an associated display" and "Baig shares music, video games, and advertisements at hotspots, and

a POSA would have realized a STB would beneficially provide that content for display via a television or other display").

Moreover, Petitioner's expert correctly analyzed the proposed combinations within the context of public wireless hotspots – not just coffee shops. Ex. 1002, ¶¶ 157 ("modifying Baig to include Costa's set-top box would simply result in a system as described in Baig with a set-top box connected to the Internet [] through the same common access point [] as the other mobile devices [] at the hotspot"), 159 ("[m]odifying Baig's system to include a set-top box with the devices 102 would have been a natural extension of providing Internet access to other computing devices such as phones, laptops, etc., as described in Baig"), 161 ("including a set-top box would have enhanced Baig's ability to target individuals based on demographics, such as by providing vicinity-based targeted advertising based on … what television content … is being provided to individuals through the set-top box"); Ex. 1063, ¶¶ 7-8.

Nor does Baig or Costa limit their teachings to coffee shops. Ex. 1063, ¶¶ 9-11. In fact, Dr. de la Iglesia recognized in deposition that the Wi-Fi hotspots in Baig "are described generally." Ex. 1062, 17:13-21. Baig states that its "vicinity-based communities" can be implemented using Wi-Fi hotspots in a variety of public places, including airports (Ex. 1007, ¶¶ [0078], [0126]) and libraries (Ex. 1007, ¶¶ [0052], [0057]). *See also*, Ex. 1007, ¶¶ [0037] ("Public deployment of WiFi networks have

skyrocketed in parks, cafes, bookstores, airports and college campuses."), [0058] ("in a five-block radius in a particular metropolitan city, there may be a dozen hotspots that are available for users to access the Internet"); Ex. 1063, ¶¶ 9-10. Patent Owner simply ignores these other examples of public Wi-Fi hotspots expressly taught by Baig. Costa is also clear that examples of its network, which allows set-top boxes to exchange data with other devices in local environments, "include[] automobiles, airplanes, boats, public wireless hotspots, etc." Ex. 1011, ¶ [0036]; Ex. 1063, ¶¶ 9-10.

Because Patent Owner limits its arguments to the inclusion of a STB in a coffee shop, Petitioner's broader position that it would have been obvious to a POSA to include a STB in a public Wi-Fi hotspot anywhere else remains undisputed. In deposition, Patent Owner tried to fix this problem by questioning its own expert about other hotspots (*see* Ex. 1062, 26:5-22), but the Patent Owner's Response and associated expert declaration speak for themselves in this regard—they rely on purported "common coffee shop behaviors" that cannot simply be extrapolated to behaviors at all other public Wi-Fi hotspots. POR, 8; Ex. 2001, ¶ 38; Ex. 1063, ¶ 11. Indeed, Patent Owner's expert conceded that his newly-formed opinions regarding other public hotspot environments were still based on his coffee shop-specific concerns. Ex. 1062, 26:14-21 (admitting that if "adding a set-top box to a public hotspot at a different location such as an airport," his conclusions "would be

the same, *because it goes to the addition of a set-top box to a space based on the example of the coffee shop used by [Mr.] Lett*") (emphasis added); Ex. 1063, ¶ 11.

B. The Petition sufficiently demonstrated the obviousness of adding a STB at a coffee shop (among other places)

Patent Owner is wrong when it argues against a motivation to place a STB at a coffee house (even assuming counterfactually that the Petition were so limited). Ex. 1063, ¶¶ 12-29. As explained below, Petitioner clearly demonstrated that it would have been obvious to add a set-top box to a public hotspot, including one residing in a coffee shop. Patent Owner's arguments to the contrary are based on little other than the unsupported *ipse dixit* of its expert, coupled with a clear misunderstanding of the law of obviousness.

1. The Petition and Mr. Lett's Declaration explained why a POSA would have been motivated to make the Baig-Costa-Zwicky and Baig-Costa-Banga690 combinations

Patent Owner complains that the Petition did not identify who would make the modification and what their motivation would be. POR, 6-7, 10. Patent Owner misunderstands obviousness. Section 103 forbids issuance of a patent when "the subject matter as a whole would have been obvious at the time the invention was made *to a person having ordinary skill in the art to which said subject matter pertains*." 35 U.S.C. § 103 (emphasis added). Thus, the relevant inquiry is simply whether "a person having ordinary skill in the art" (POSA) would have found the combination obvious. Ex. 1063, ¶¶ 14-16. The Petition presented detailed

explanations of the proposed Baig-Costa-Zwicky and Baig-Costa-Banga690 combinations and why such combinations would have been obvious to a POSA. Pet. 10-12; Ex. 1063, ¶¶ 12-29.

The Petition explained that Baig teaches different types of user devices accessing its public hotspot, that Costa teaches hotspot-connected STBs/TVs, that it "would have been obvious to include a STB at Baig's hotspot," and that "[a] POSA would have had the skills and motivation to incorporate a STB into Baig's vicinity-based community service provider (VCSP) system." Pet. 10-11. The Petition then explained why a POSA would have found the combination to be obvious and why a POSA would have been motivated to make the combination, explaining that "it was well-known to provide web-pages (including advertisements) on a STB," "[a] POSA would be motivated to include Costa's STB because it beneficially allows customers at a public establishment to watch television or other information on an associated display," and "Baig shares music, video games, and advertisements at hotspots, and a POSA would have realized a STB would beneficially provide that content for display via a television or other display." Pet. 10-12; Ex. 1063, ¶¶ 14-19.

Mr. Lett, himself a person of ordinary skill in the art, substantiated Petitioner's analysis, including by explaining that "it would have been obvious to and a POSA would have been motivated to include a set-top box at Baig's access point 106 so that individuals at the hotspot 110 containing access point 106 would have access to

services such as televised content available via the set-top box." Ex. 1002, ¶ 196. Mr. Lett explained that "as Costa teaches, wireless hotspot systems operating in public environments (which Baig also describes with respect to a coffee shop) included consumer electronic devices such as set-top boxes and televisions as part of a hotspot network." Ex. 1002, ¶ 197 (citing Ex. 1007, Abstract, ¶¶ [0006], [0039], [0101]; Ex. 1011, ¶¶ [0007], [0035]-[0037], [0042]); Ex. 1063, ¶¶ 14-19. Mr. Lett detailed how the system would be combined ("in the combined system, like each of the other devices 102, the set-top box would have an IP address corresponding to the IP address of the wireless access point 106") and that such a combination "would have been a natural extension of providing Internet access to other computing devices such as phones, laptops, etc., as described in Baig." Ex. 1002, ¶¶ 158-159, 196, 198; Ex. 1063, ¶ 15.

Finally, Mr. Lett established that a POSA would have found it obvious to combine the system as proposed in the Petition. Ex. 1002, ¶¶ 157-165; Ex. 1063, ¶¶ 16-19. Mr. Lett explained motivations for making the combination within the contexts of both public Wi-Fi hotspots in general ("the combination provides the additional benefit of having a wider range of device types available at a particular access point") and a public Wi-Fi hotspot in a coffee shop ("including a set-top box would have enhanced Baig's ability to target individuals based on demographics, such as by providing vicinity-based targeted advertising based on, for example, what

television content (e.g., content displayed on the television including webpages and television programming) is being provided to individuals through the set-top box"). Ex. 1002, ¶¶ 160-161; Ex. 1063, ¶¶ 16-19. Mr. Lett noted that in both instances, "[a] POSA would have recognized that entertainment in a public venue such as a retail business is often beneficial to engage the user's interest and maintain their presence at that location." Ex. 1002, ¶ 160; Ex. 1063, ¶ 16. And finally, Mr. Lett explained why a POSA would have had reasonable expectation of success when making the proposed combination. Ex. 1002, ¶¶ 164-165; Ex. 1063, ¶¶ 14-19.

Importantly, all of Petitioner's motivations, supported by Mr. Lett's declaration, are grounded in *KSR* rationales. Ex. 1002, ¶¶ 159-161 (providing motivations in the prior art that would have led a person of ordinary skill in the art to combine multiple prior art teachings to arrive at the claimed invention), 163 (explaining how the combination merely uses a known technique to improve similar devices in the same way). For example, Mr. Lett explained how "the combination merely combines known prior art elements according to known methods to yield predictable results," citing *KSR* rationale (A). *Id.*, ¶ 162; Ex. 1063, ¶¶ 17-18. In response, Patent Owner's argument to the contrary relies on an explanation by Mr. de la Iglesia that he (incorrectly) "[does] not understand this to be a rationale for obviousness." Ex. 2001, ¶ 42 (quote in reference to Mr. Lett's rationale in Ex. 1002, ¶ 162); POR, 10-11 (citing Ex. 2001, ¶¶ 42-43).

Thus, the Petition and Mr. Lett's Declaration sufficiently explained why a POSA would have been motivated to make the Baig-Costa-Zwicky and Baig-Costa-Banga690 combinations.

2. Patent Owner's arguments related to the undesirability of a STB/TV in a coffee shop in particular are unpersuasive

Patent Owner contends that a POSA would have avoided adding a STB to a coffee shop's wireless hotspot because "adding a STB to a coffee shop is costly," "patrons do not go to coffee shops to watch a television screen," and "[patrons watching the TV] may actually harm the coffee shop because they may stay at their seats / tables longer, thus providing less seating for customers who have just arrived at the coffee shop and who want a place to sit after getting their order." POR, 8-9.[1] These arguments are unavailing. Ex. 1063, ¶¶ 20-29.

For instance, even if adding a TV would be costly, "[a] given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine." *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157,

[1] Patent Owner's support for this surmise about coffee shop patrons is limited to the statements of its expert. Yet there is no evidence that Mr. de Iglesia has any expertise in coffee shops, the economics of placing set-top boxes at a public hotspot, or whether patrons desire to avoid screens.

1165 (Fed. Cir. 2006) (citation omitted). And "a generalized statement discussing tradeoffs in design," as is the case here, "does not rise to the level of discouraging the combination." *Valencell, Inc. v. Fitbit, Inc*., 786 F. App'x 247, 250 (Fed. Cir. 2019). As Petitioner explained, the addition of a STB (and television) within a public venue would have several advantages, including maintaining users' presence at the venue by engaging the users' interests, and having a wider range of device types available at the public venue. Pet. 11-12; Ex. 1002, ¶¶ 159-160. And Patent Owner's argument that coffee shops do not want their patrons staying in their seats for a long period is severely undermined both by Patent Owner's own argument that people would go to the coffee shop to "talk with friends or read a book" (POR, 8), activities that could lead to people staying in their seats for a long time, and the fact that coffee shops *choose* to provide public Wi-Fi hotspots for their patrons in the first place. Ex. 1063, ¶¶ 20-26.

Moreover, the mere fact that an owner of a coffee shop might not have made a combination for economic reasons does not mean that a POSA would not have made the combination and found it obvious to do so. *Grit Energy Sols., LLC v. Oren Techs*., *LLC*, 957 F.3d 1309, 1323-1324 (Fed. Cir. 2020) ("[E]ven if we accept the Board's factual determination that swapping Eng Soon's components would result in a more expensive system, that determination, standing alone, is insufficient to reject each of [Petitioner's] arguments as to why a skilled artisan would have been

motivated to make the proposed swap."); *In re Farrenkopf*, 713 F.2d 714, 718 (Fed. Cir. 1983) ("That a given combination would not be made by businessmen for economic reasons does not mean that persons skilled in the art would not make the combination because of some technological incompatibility. Only the latter fact would be relevant.").

Patent Owner contends that the Petition "does not provide any plausible motivation to adding a STB to a public hotspot" because "Costa at most teaches that a public wireless hotspot could potentially include a STB, but does not actually disclose a public wireless hotspot including an STB." POR, 9 (emphasis removed). Costa provides:

> The UPnP network 104 (or similar networking technology) allows devices to exchange data in a local environment 110. The local environment 110 typically includes a home or office, although it will be appreciated that other environments may provide UPnP connectivity, including automobiles, airplanes, boats, public wireless hotspots, etc. The UPnP network 104 may couple consumer electronics devices 112, including televisions 114, audio systems 116, computers 118, telephones 120 (e.g., analog phones, digital phones, cordless phones, SIP phones), digital media centers 122 (e.g., set-top boxes, MP3 jukeboxes, personal Video recorders, media hubs),

> printers 124, cameras 126, and other devices, represented by generic UPnP device 128.

Ex. 1011, ¶ [0036] (emphasis added). Thus, as admitted by Patent Owner's expert, Costa expressly teaches a UPnP network that allows devices such as set-top boxes to exchange data in a public wireless hotspot environment. Ex. 1011, ¶ [0036]; Ex. 1062, 21:6-12 (admitting that "Costa cites a set-top box as an example of a digital media center that could be deployed in a universal plug and play network"), 22:3-10 (admitting that public wireless hotspots "are environments that provide plug and play connectivity"), 23:15-23 (admitting "that what Costa says directly is that it may utilize any combination of wired and wireless networking technologies, … [including] 802.11 Wi-Fi"); Ex. 1063, ¶ 29.

Finally, Patent Owner contends that adding a STB to a public wireless hotspot as provided in Petitioner's combinations is not "combining prior art elements according to known methods to yield predictable results" because "a POSA would not have had a reason to add a STB to Baig's coffee shop in the manner the Petition proposes." POR, 10 (emphasis removed). But Petitioner provided multiple reasons why a POSA would add a STB/TV to Baig's public venues – "reach[ing] a larger audience that might not have their own devices (or might not be viewing their own device) when an advertisement is to be displayed," "beneficially allow[ing] customers at a public establishment to watch television or other information on an

associated display," and "beneficially provid[ing] [Baig's] content for display via a television or other display." Ex. 1002, ¶ 163; Pet. 11-12; Ex. 1063, ¶¶ 27-28. And Patent Owner's putative reasons for why a POSA would not be motivated to make such a combination (cost, distraction, etc.) are, at best, conclusory design tradeoffs that do not obviate Petitioner's combination. Ex. 1063, ¶¶ 20-26.

Thus, Patent Owner's arguments related to the undesirability of a STB/TV in a coffee shop are unsupported and unpersuasive. *Id.*, ¶¶ 12-29.

C. The Petition sufficiently demonstrates the obviousness and motivation for a television to display web content

Patent Owner also contends that a STB would not be used to "navigate to Baig's VCSP website which does not provide television service or streaming service." POR, 11 (emphasis removed). Specifically, Patent Owner assumes that any television installed in a public hotspot environment would be used only to provide "television service" to users. *Id*. With this assumption, Patent Owner concludes that such a television being used to display Baig's website would be "a very strange decision" and that the Petition fails to provide analysis of whether it would have been beneficial "in the context of an STB at a coffee shop." *Id*. Patent Owner is wrong. Ex. 1063, ¶¶ 30-34.

Patent Owner's position that any television in a public hotspot environment would be used only for "television service" fails to account for the creativity and knowledge of the ordinarily-skilled artisan. Ex. 1063, ¶¶ 30-34. At the time of the

invention, it was common to use televisions (displays) for more than just "television service." Ex. 1063, ¶ 31; *see also* Exs. 1064-1068. The Petition specifically addressed the obviousness of displaying Baig's website advertisements on a television, explaining that "Baig's advertisements would obviously have been displayed on any suitable access device" and "[a]n advertiser would wish to direct a hotspot-targeted advertisement to devices which would reach the widest possible audience at the hotspot, such as Costa's STB with an associated television display." Pet. 27-28. The Petition further explained that "[b]y providing Baig's advertisements to a STB for presentation on a television, such advertisements constitute 'television advertisements' as defined by the '260 Patent." Pet. 27 (citations omitted); Ex. 1001, 6:37-40. Thus, the Petition did indeed establish the obviousness of displaying Baig's website on the STB/television.

This rationale applies across different types of public hotspots, including coffee shops, libraries, airports, and the like. §II.B; Ex. 1063, ¶¶ 31, 33-34. Patent Owner contends that because only one patron could control the television at a time, this would be "undesirable" in terms of privacy concerns. POR, 12. First, the number of patrons that are able to concurrently control the television is divorced from any potential "privacy concerns." Ex. 1063, ¶ 32. Second, Baig teaches that its user profile does not include personally-identifiable information, thereby alleviating "privacy concerns." Pet. 37-38; Ex. 1002, ¶¶ 264-265; Ex. 1063, ¶ 32.

Thus, the STB would be used to access Baig's VCSP website via the public Wi-Fi hotspot and Patent Owner's arguments to the contrary are unpersuasive. Ex. 1063, ¶¶ 30-34.

D. Patent Owner's unsupported expert testimony is entitled to little weight

Patent Owner provides no evidence to corroborate multiple arguments in its POR other than the declaration of its expert who repeats the statements nearly verbatim, also without support. POR, 8-9, 11-12; Ex. 2001, ¶¶ 38 (no evidence supporting testimony that TV is distracting to people in a coffee shop), (no evidence supporting testimony that people prefer to talk with friends or read a book when visiting a coffee shop), (no support for testimony that adding a STB to a coffee shop is "costly"), 39 (no supporting evidence), 40 (no evidence supporting testimony that maintaining a user's presence at a coffee shop for a long period of time would generally not be advantageous commercially for a coffee shop), 45 (no evidence supporting testimony that the purported purpose of installing a television would exclusively be to provide television service to visitors to the coffee shop), 46 (same), 47 (no evidence supporting testimony that most sensible purpose of adding the STB would be to provide television service rather than to browse to a VCSP website). These conclusory and unsubstantiated opinions, therefore, are entitled to little weight. *Upjohn Co. v. Mova Pharm. Corp.*, 225 F.3d 1306, 1311 (Fed. Cir. 2000) ("Lack of factual support for expert opinion going to factual determinations,

however, may render the testimony of little probative value in a validity determination.") (citation omitted); *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15 (PTAB Aug. 24, 2022) ("the cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight"); 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.").

E. Patent Owner's challenge is limited to the combination of Baig and Costa

Outside of challenging the motivation to combine Baig's hotspot with Costa's STB, Patent Owner does not independently dispute the remaining arguments of Grounds A-B (Baig-Costa-Zwicky and Baig-Costa-Banga690). *See generally* POR. Further, Patent Owner does not independently dispute any argument in Grounds C-K. *Id*. If the Board finds that it would have been obvious to combine Baig's hotspot with Costa's STB, then the Board should find that Grounds A-K render claims 1-5, 7, 11-20, 22, 26-28, 35-38, 41, 44, 54, 56-58, 61-62, 71-75, 77-80, 83-84, 86, 90-99, 101, 105-106, 116, 118-119, 125, 127-128, 137-141, 143-144, 148, and 151-152 of the '260 Patent obvious. Pet. 4.

III. CONCLUSION

For the reasons set forth above, in the Petition, and the associated declarations and exhibits, claims 1-5, 7, 11-20, 22, 26-28, 35-38, 41, 44, 54, 56-58, 61-62, 71-75, 77-80, 83-84, 86, 90-99, 101, 105-106, 116, 118-119, 125, 127-128, 137-141, 143-144, 148, and 151-152 of the ’260 Patent are obvious and should be canceled.

Respectfully submitted

Dated: May 1, 2025

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

Under the provisions of 37 CFR § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Petitioner's Reply totals 4,375, which is less than the 5,600 allowed under 37 CFR § 42.24(c)(1), as counted by the Word Count feature of Microsoft Word.

Pursuant to 37 C.F.R. § 42.24(a)(1), this count does not include the table of contents, the table of authorities, mandatory notices under § 42.8, the certificate of service, this certification of word count, the claims listing appendix, or appendix of exhibits.

Dated: May 1, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.105, I hereby certify that I caused a true and correct copy of this **PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE UNDER 37 C.F.R. § 42.23** in connection with IPR2024-00421 to be served via e-mail on May 1, 2025, in its entirety on the following counsel of record for Patent Owner:

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