

**IN UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.

Petitioners,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2024-00735

U.S. Patent No. 11,017,815

**PATENT OWNER RESPONSE
TO PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 11,017,815**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	THE SCOPE OF THE PROCEEDING.....	1
A.	U.S Patent No. 11,017,815.....	1
B.	'815 Patent Family Prosecution History	4
C.	Person Of Ordinary Skill In The Art.....	4
D.	Cited References.....	5
E.	Instituted Grounds	5
III.	CLAIM CONSTRUCTION	6
IV.	ANALYSIS OF INSTITUTED GROUNDS.....	8
A.	Ground 1.....	8
1.	No Motivation to Combine Horn with Baumgartner.....	9
2.	The Combination of Horn and Baumgartner Fails to Disclose Limitation 1[b] and 9[a].....	18
3.	The Combination of Horn and Baumgartner Fails to Disclose Limitation 1[c] and 9[b].....	21
4.	The Combination of Horn and Baumgartner Fails to Disclose Limitation 1[g] and 9[e].....	23
5.	The Combination of Horn and Baumgartner Fails to Disclose Limitation 1[m] and 9[k].....	23
B.	Ground 2.....	24
1.	Petitioner Has Not Provided Sufficient Evidence that WinTV Was Publicly Accessible	25
C.	Ground 3.....	32
D.	Grounds 4-5.....	35
1.	Petitioner Does Not Adequately Articulate a Combination of Kaplan and Bryant's Teachings.....	35
2.	The Combination of Kaplan and Bryant Fails to Disclose Limitation 1[b] and 9[a].....	43
3.	The Combination of Kaplan and Bryant Fails to Disclose Limitation 1[c] and 9[b].....	44

4.	The Combination of Kaplan and Bryant Fails to Disclose Limitation 1[g] and 9[e].....	45
5.	5.....The Combination of Kaplan and Bryant Fails to Disclose Limitation 1[l] and 9[j]	45
VI.	CONCLUSION.....	50

PATENT OWNER'S EXHIBIT LIST

Description	Exhibit #
1st Amended Docket Control Order from District Court Litigation	2001
Original Docket Control Order from District Court Litigation	2002
Maxell's Supplemental Preliminary Election of Asserted Claims	2003
Defendants' Preliminary Election of Prior Art	2004
IPR2024-00735 & IPR2024-00777 Petitions side-by-side compare	2005
U.S. Patent No. 10,679,647	2006
U.S. Patent No. 10,199,072	2007
U.S. Patent No. 9,818,449	2008
U.S. Patent No. 9,384,783	2009
U.S. Patent No. 8,644,684	2010
U.S. Patent No. 7,613,383	2011
U.S. Patent Application No. 2007/0022382	2012
U.S. Patent No. 7,512,622	2013
U.S. Patent No. 6,480,669	2014
U.S. Patent No. 7,974,511	2015
U.S. Patent No. 7,853,893	2016
Petitioner's invalidity contentions chart in District Court—Kaplan	2017
Petitioner's invalidity contentions chart in District Court—Bryant	2018
Translation of JP 4385943B2	2019
Certificate of Accuracy for Translation of JP 4385943B2	2020
Declaration of Jacob Sharony, Ph.D.	2021
Internet Archive Web Page from Hauppauge Computer Works (8/03)	2022
Internet Archive Web Page from Hauppauge Computer Works (9/03)	2023
www.bricklin.com/homenetwork.htm	2024
https://www.itprotoday.com/it-infrastructure/mixing-wired-and-wireless-networking-in-your-home	2025
The Benefits of Wireless Technologies (https://librarytechnology.org/document/9643)	2026

Internet Archive Web Page from Hauppauge Computer Works (10/03)	2027
Internet Archive Web Page from Hauppauge Computer Works (10/03)—Product Data Sheets	2028
Internet Archive Web Page from Hauppauge Computer Works (10/03)—Manuals	2029
TS 101 197 v1.2.1 (2002-02)	2030
Scrambling (Conditional Access System)	2031
Conditional Access (10/01)	2032
District Court Claim Construction Order	2033
Samsung Claim Construction Brief	2034
Lassalle, Broadcast Encryption	2035
Bederson Deposition Transcript (June 6, 2024)	2036
Bederson Claim Construction Declaration	2037
Bederson Deposition Transcript (January 17, 2024)	2038
User’s Guide for Windows NT	2039
Declaration of Ravin Balakrishnan, Ph.D.	2040

I. INTRODUCTION

Patent Owner Maxell, Ltd. ("Patent Owner") respectfully requests that the Board confirm the patentability of claims 1-15 ("challenged claims") of U.S. Patent No. 11,017,815 ("the '815 Patent") (EX1001). Samsung has failed to demonstrate that any claim is obvious in view of the asserted prior art.

Petitioner fails to show a reasonable likelihood of prevailing on any Ground because it has not shown that the cited references render obvious claims 1-15. None of the cited references alone or in combination disclose the arrangement of each element of claims 1-15.

Moreover, Grounds 2, 3, and 5 additionally fail because Petitioner has not shown by a preponderance of the evidence that WinTV was publicly accessible to a person of ordinary skill in the art prior to December 2, 2004.

Accordingly, the Board should confirm the patentability of the challenged claims.

II. THE SCOPE OF THE PROCEEDING

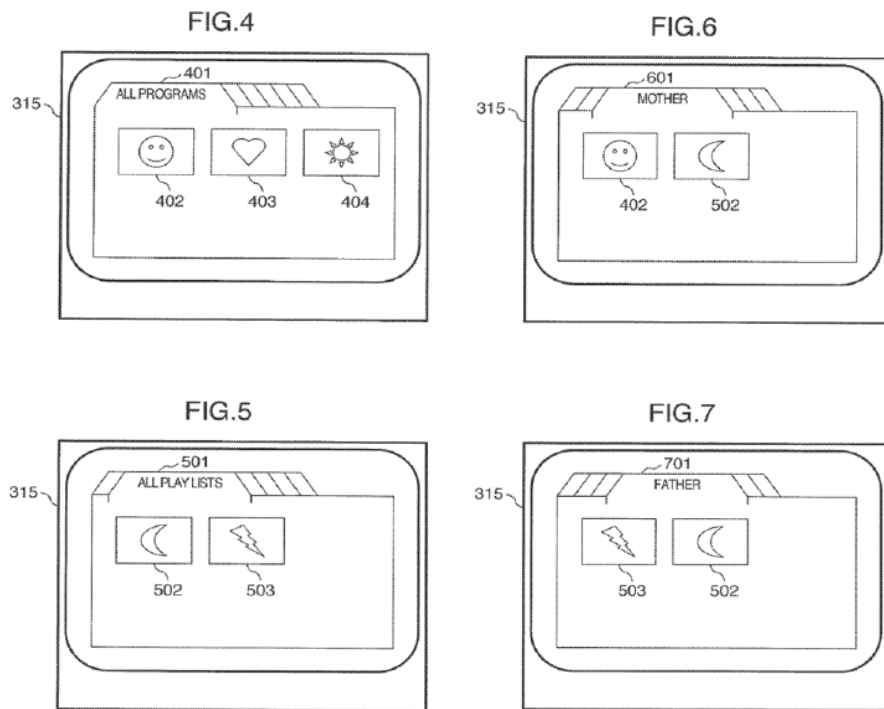
A. U.S Patent No. 11,017,815

The '815 Patent is entitled "Editing Method and Recording and Reproducing Device," and claims priority to multiple Japanese applications, the earliest of which was filed on December 2, 2004. The '815 Patent issued on May 25, 2021.

The '815 Patent is directed to an information processing apparatus, and related methods, that manages digital data and reproduces video content associated with user profiles in a specific manner that enables improved video management, storage, and the presentation of groups of video information. EX1001, at 2:63-3:6. At the time of invention, content systems allowed users to group media into “playlists,” but those playlists were not optimized for multiple users. *Id.* at 2:28-47. Different members of the same household, for instance, could not customize their views with select playlists and programs. The '815 Patent solved this problem by providing a recording and reproducing device in which the user can select and manage arbitrary playlists in a particular manner using hierarchical levels of information management.

More specifically, the claimed inventions are directed to a hierarchical management interface with different areas and classifications associated with different user information, association, and/or behavior. For example, one of the claimed inventions contains a “first area” and a “second area.” The first area includes a “first character” associated with a “first group” of video information for a “first classification” and a “second character” that is associated with a “second group” of video information for a “second classification.” The second area displays a first or second group of thumbnails configured upon user selection of the first and second characters.

Both groups of video information are stored as part of the plurality of stored video information, and the first group of video information is configured to allow a user to edit. Finally, when one video information is deleted from the first group it continues to be included in the second group and a thumbnail corresponding to the video information is displayed as one of the second group of thumbnails. Examples of display output of an information processing apparatus that are capable of implementing the invention of the '815 Patent are shown below:



Id. at Figs. 4-7. As a result, it becomes possible for the user to select arbitrary playlists or reproduction ranges and conduct management. Even in the case where a

plurality of users share a single recording medium, therefore, each user can manage his or her favorite reproduction content, resulting in improved usage.

B. '815 Patent Family Prosecution History

U.S. Application No. 16/883,124 (the "'124 Application"), which issued as the '815 Patent, was filed on 5/26/2020. The '124 Application claimed priority to a series of continuation applications that matured into various patents. *See* EXS2006-2011; *see also* EXS1040-1045 (file histories of related patents) All the patents stemming from the Japanese priority applications were examined by the same Primary Examiner.

C. Person Of Ordinary Skill In The Art

"A person of ordinary skill in the art" in the field of the '815 Patent would have a Bachelor of Science degree in Electrical Engineering, Computer Engineering, Computer Science, Human Computer Interaction, or a related technical field, with at least one year of experience working in the field of user interfaces and/or content management. More education (e.g., a Master's degree) or work experience may compensate for a deficit in one of the relevant qualifications stated invention. EX2040, ¶53.

The Board has adopted the following definition for a person of ordinary skill in the art ("POSITA"):

“would have held a bachelor’s degree in Computer Science, Electrical Engineering, and Computer Engineering, or a related field, and two years of practical experience in digital data management.”

ID at 8. The difference between the Board’s definition and Patent Owner’s does not change the arguments set forth herein.

D. Cited References

The Petition offers six references in its challenges to the patentability of the claims of the ’815 Patent:

1. U.S. Patent No. 7,275,063 (“Horn”) (EX1005)
2. U.S. Patent Publication No. 2015/0160458 (“Baumgartner”) (EX1016)
3. WinTV Manual (“WinTV”) (EX1010)
4. U.S. Patent No. 7,970,240 (“Chao”) (EX1006)
5. 1013) U.S. Patent Application Publication No. 2001/0056434 (“Kaplan”) (EX1014)
6. U.S. Patent Application No. 2004/0201691 (“Bryant”) (EX1015).

E. Instituted Grounds

The Board instituted review on five grounds

Ground	’815 Patent Claim(s)	Type of Challenge	Primary Reference	Secondary Reference(s)
1	1-6, 9-13	§ 103	Horn	Baumgartner
2	7, 8, 14, 15	§ 103	Horn	(1)Baumgartner (2) WinTV
3	1-15	§ 103	Horn	(1)Baumgartner

				(2) WinTV (3) Chao
4	1-6, 9-13	§ 103	Kaplan	Bryant
5	7, 8, 14, 15	§ 103	Kaplan	(1) Bryant (2) WinTV

III. CLAIM CONSTRUCTION

For this proceeding, the Board has adopted the following construction:

Claim Term	Construction
“user profile(s)”	“data representing a user’s distinctive features or characteristics”

In the related District Court Litigation, the court also provided construction for the “user profile(s)” term:

Claim Term	District Court Construction
“user profile(s)”	“a collection of settings and information associated with a user”

The court specifically noted that the term “user profile” has a well-known ordinary meaning, which is further reinforced by multiple dictionary definitions. This reinforces that the concept of a “user profile” is widely understood in the field and does not require an alternative or ambiguous interpretation.

Accordingly, Patent Owner contends the court’s construction of the term “user profile” more closely aligns with the plain and ordinary meaning of the term.

EX2040, ¶¶39-40. This ensures consistency and prevents any misinterpretation of the term beyond its widely accepted meaning. Moreover, the Court’s construction of “user profile” is supported by the ’815 Patent’s specification, as well as the priority applications. Ex. 2040, ¶¶73-80. For example, while the precise term “user profile” is not used *in haec verba* in the specification, it discloses user “dedicated” folders where each user can store its playlists according to his/her preferences. EX1001, at 6:21-40 and Figs 1, 6-7 where “mother” and “father” are shown to have user dedicated folders supporting their profiles); *see also* Ex. 2019, at ¶¶[0024]-[0025] and Figs 1, 6-7; EX2040, ¶74.

FIG.6

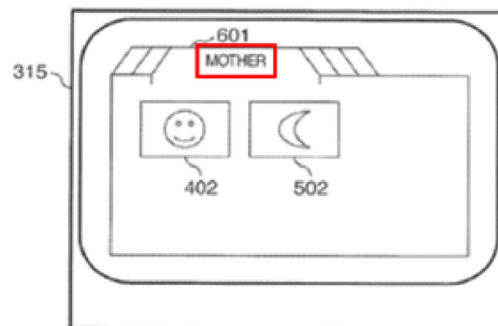
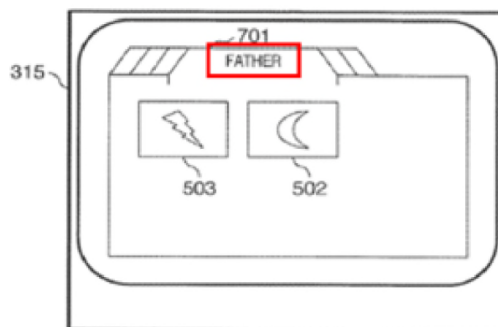


FIG.7



Further, the '815 Patent also discloses that these user dedicated folders are possible by the use of hierarchical data directories with a "Root" directory followed by "user-defined unification information" and "contents of user-defined information" grouped to "meet respective users' tastes by using one user-defined unified information [for] every user." See EX1001, 4:35-39; EX2019, at ¶[0027] . See also Figs. 8 and 9 and corresponding descriptions to show how the '815 Patent discloses the concept of a user profile consistent with the usage of root directories and folders, used for example to implement user profiles by a POSITA in Windows NT at that time. EX2039 (User's Guide for Microsoft 95 and Windows NT).

IV. ANALYSIS OF INSTITUTED GROUNDS

A. Ground 1: Petitioner Fails To Establish That Claims 1-6 and 9-13 are Rendered Obvious By Horn in View of Baumgartner

Petitioner has not shown a likelihood of prevailing with respect to Ground 1 because Horn in view of Baumgartner does not teach each and every element of Claims 1-6 and 9-13. EX2040, ¶121. Specifically, Horn in combination with Baumgartner does not teach elements 1[b], 1[c], 1[g], 1[l] (and comparable elements of claim 9: 9[a], 9[b], 9[e], 9[j]), as required for each of these claims. Additionally, because dependent claims 2-6 and 10-13 depend from claim that Petitioner has not shown to be unpatentable, Petitioner has also failed to show that claims 2-6 and 10-13 are unpatentable by Horn in view of Baumgartner. *Id.*

1. No Motivation to Combine Horn with Baumgartner

At the time of the '815 Patent, it would not have been obvious to a POSITA to combine Horn with Baumgartner. Petitioner's statement as to why Horn and Baumgartner should be combined is conclusory and unsupported by sufficient evidence and analysis. EX2040, ¶122.

A POSITA would not be motivated to combine Horn with Baumgartner because they are two different systems. The problem solved by Horn is unrelated to the technical problems addressed by Baumgartner. *Id.*, ¶123. Horn discloses a “truly open computer system having data structures, input interfaces, displays and operational systems that permits the organization of information, as data objects” and permit a “faster archiving , retrieval and viewing of the information.” EX1005, 3:10-17 (emphasis added). Moreover, Horn proposes a computer data processing system that has a “simple-to-use data structure and operating mechanism to link information together in a dynamic, memory-and- space-efficient manner.” EX1005, 3:19-22 (emphasis added). In contrast, Baumgartner discloses an “interactive television system” that uses a set-top box to access and request video-on-demand programming. EX1016, Abstract. A POSITA would not be motivated to combine the components from Baumgartner's set-top box system to Horn's simple-to-use computer file system, because Horn is directed to making “collections” based on

keywords in documents, and is not directed to making any video-on-demand collections based on a user watch history. EX2040, ¶123.

Additionally, Petitioner fails to provide any rationale as to why a POSITA would substitute the hardwired LAN of Horn with the wireless modem of Baumgartner. *Id.*, ¶124. Petitioner simply provides a conclusory statement that “a POSITA would have found it obvious to implement Horn’s LAN with a wireless LAN because they were often cheaper and easier to install than a wired LAN due to elimination of the need to run wires to all of the endpoint computers in the network.” Pet. at 28. Petitioner’s conclusory statements are insufficient and provide no factual support. *See In re Nuvasive, Inc.*, 842 F.3d 1376, 1383 (Fed. Cir. 2016) (conclusory statements are “insufficient articulations of motivation to combine” references). In fact, Petitioner’s assertion that wireless LAN was cheaper at the time of the ’815 Patent’s invention is also unsupported. EX2040, ¶124. For example, publicly available information shows that at the time of the ’815 Patent’s invention the price of wireless PC card and wireless access point was more than \$300, as compared to the wired LAN card that cost on average less than \$50. Petitioner’s assertion regarding the costs involved might be true today but not around the early 2000’s. Today of course a wireless solution may be more cost effective, but not at the time of the ’815 invention (Dec. 2004). *Id.*; *see also* EXS.2024-2025.

Petitioner states that a POSITA would have considered obvious to include the wireless communication from Baumgartner in Horn. Pet. at 23-24. This is incorrect. EX2040, ¶125.

Specifically, Petitioner's analysis of the Horn system is fundamentally flawed because it fails to evaluate the system within the proper context of the prior art. Specifically, the Horn system is a specialized, server-based computer running the Metadata Filing System (MFS), not just a general-purpose or personal computer. *Id.*, ¶126. Rather than assessing the technology in light of its intended enterprise environment, Petitioner applies its analysis to a general-purpose or personal computer and assumes that a wireless LAN would be beneficial. This mischaracterization leads to incorrect conclusions that are not supported by the Horn's disclosure. EX2040, ¶126.

For example, Horn's MFS is designed for high-performance, data-intensive computing, a characteristic that distinguishes it from general-purpose computers, which are optimized for single-user, lower-complexity tasks. *Id.*, ¶127. Horn's system's architecture and functionality indicate that it is a robust, server-based solution that is intended to handle large volumes of data. EX1005, 6:59-63. A POSITA evaluating the Horn disclosure would immediately recognize that the system is a server-based solution designed for large-scale data processing and

management. *Id.* This conclusion is evident from several key factors in the system's disclosure.

First, the Horn system is not a simple general-purpose computer but a dedicated server architecture specifically designed for automatic organization, indexing, and retrieval of data from multiple sources. EX1005, 3:10-17. The emphasis on handling vast amounts of structured data further supports the conclusion that the system is a server-based architecture rather than a consumer-grade or personal-use system. EX2040, ¶128.

Second, the system's capabilities align with enterprise-level data management, including aggregating data from multiple inputs, performing complex indexing operations, and providing structured data views. *Id.*, ¶129. These are defining characteristics of server-based computing environments—features that are neither typical nor necessary for general-purpose personal computers, which primarily function for localized, single-user tasks. EX2040, ¶129.

Furthermore, the architectural framework described in the Horn disclosure supports high availability, scalability, and efficient handling of extensive data volumes. Such design considerations are commonly associated with enterprise data centers, further reinforcing that the Horn system is a server-based computing environment requiring a high-performance infrastructure. *Id.*, ¶130.

Petitioner's assumption that a wireless LAN is a suitable alternative to a wired connection is inconsistent with the Horn system's technical and operational requirements. The system requires advanced reliability, stability, and security, all of which are best provided by a wired LAN. *Id.*, ¶131. A POSITA would understand that from performance standpoint, wired networks provide a more stable and reliable connection with lower packet loss and reduced latency, which is critical for high-throughput enterprise computing. *Id.*, ¶132. In contrast, wireless networks are inherently vulnerable to interference, congestion, and signal degradation, making them highly unreliable for large-scale, high-performance data environments like the Horn system. *Id.*

Moreover, Horn's real-time indexing and retrieval of high data volumes necessitate low-latency, high-speed communication. Wired networks are specifically designed to minimize latency, ensuring efficient and predictable data transmission. EX2040, ¶133. Wireless networks, on the other hand, introduce variable latency and bandwidth limitations, which would severely impact system performance and render wireless connectivity unsuitable for Horn's operational needs. *Id.*

On cross-examination, Dr. Bederson admitted that if a system's goal (like Horn's—EX1005 at3:10-17) is to permit faster archiving, retrieval and viewing

information then it is better to transfer data at higher speeds:

Q: If you had a computer system whose goal is to permit faster archiving, retrieval and viewing of information, would it be better to have the data transferred at higher speeds or lower speeds?

A: If your goal was faster communication, then I would think **faster communication speeds probably would help you address that goal more readily.**

EX2038, at 51:22-52:8 (emphasis added).

A POSITA would have understood that at the time of the '815 Patent (December 2004) the speed and bandwidth of wireless communication was much slower than that of the cable LAN, and hence Baumgartner's wireless communication would not be appropriate for Horn's distributed computer system that requires higher speed and bandwidth to "faster" retrieve and view information on a communication network. EX2040, ¶134. In particular, at the time of the '815 Patent, the wireless communication protocols (802.11b/g) offered communication speeds much slower than that of wired ethernet:

Patent No. 11,017,815

Patent Owner Response

The current standard: 802.11b

Standards insure that wireless networks that consist of components from several different vendors will work properly. Theoretically, cards manufactured by one company will work with an access point from another company. The current standard for wireless networks is known as 802.11b. This standard is in the same family as Ethernet, generally known by the designation 802.3.

Equipment that follows 802.11b standard will be capable of a theoretical data throughput rate of 11 mb/sec. This level of bandwidth is quite respectable, given that many wired networks continue to operate at 10mb/sec. The actual usable bandwidth averages about half the theoretical, though.

The previous generation of wireless networks operated at 2-3 mb/sec. Not surprisingly, wireless networks did not become popular until the emergence of the 802.11b standard that increased the data flow to 11 mb/sec. The emerging 802.11a standard, expected to find more common use in the next 1-2 years, will deliver data at 54MB/sec.

Still a Niche product

Despite the steadily increasing speed of wireless technology, wired networks will always outperform them by long strides. Today 100mb/sec Ethernet cards prevail in most business LANs, with Gigabit Ethernet (1024 mb/sec) finding common use as network backbones and for connecting high-performance servers. 10 GB/sec Ethernet for fibre-based networks is already on the horizon.

EX2026; EX2040, ¶134.

Security is another critical concern that Petitioner's analysis fails to address adequately. *Id.*, ¶135. The Horn system is explicitly designed for data aggregation and management, making data integrity and security paramount. EX1005, 19:25-60, 5:47-60. A POSITA would have understood that network security is important to Horn's system as it stores user data and could host websites. EX1005, 19:25-60, 5:47-60. In particular, Dr. Bederson agreed on cross-examination that one of ordinary skill in the art would be aware of the importance of data security for Horn's system:

Q: In Horn's system, Exhibit 1005, does Horn store user data?

A: Yes, I believe it does.

Q: Does Horn's system host websites?

A: I don't recall if it does.

Q: Just take a look at column 5, line 47, and the subsequent

sentences.

A: Okay, I see that, and I do see that Horn discloses hosting internet pages.

Q: So in 2024, in a system such as Horn's, would data security be important to one of skill in the art?

A: Well, I think in 2004, data security was certainly less important, less top of mind than it is today. But I think a person of skill in the art would at least have some awareness of data security.

EX2038, at 52:9-53:4.

Wired LANs offer a superior security framework by eliminating risks associated with wireless transmissions, such as hacking, data interception, and unauthorized access. EX2040, ¶136. Wireless LANs, especially those in 2004, were significantly more vulnerable to security breaches, further supporting the conclusion that Horn's intended infrastructure is wired, not wireless.

Security problems remain

Organizations that implement wireless networks have to consider the security implications. Wireless networks suffer from the same basic weakness as wired networks, where some unknown party might be listening in on the network conversation. Any information transported across a network must be encrypted to ensure that it remains private. The problem is amplified in wireless networks since anyone with the right equipment in physical proximity might be able to capture your network traffic, gain unprotected passwords, and launch an attack on your computers.

The 802.11b standard includes provision for protecting data transmissions through the use of encryption. The standard includes a security layer called Wired Equivalency Privacy (WEP) that uses a private key in its encryption. Many wireless networks have been installed without implementing this security feature. The security available on encrypted wireless LANs should be considered as weak, since it has recently been demonstrated that any third party capturing network packets off an access point can fairly easily determine the keys needed to decrypt network traffic.

The basic lesson for wireless networks is to avoid their use by computers with highly confidential or proprietary information. Assume that an unknown third party can intercept any information that isn't separately protected with strong encryption. As with wired network, never transmit a password that provides root or administrative access unless it is protected through strong encryption.

EX2026.

In addition, Petitioner's argument for wireless LAN based on mobility (*See* EX2038, Bederson Dep. Tr. at 102:7-20) is entirely misplaced and not supported by the Horn disclosure. EX2040, ¶137. The Horn system is a mainframe server running the MFS—it is not a mobile system nor does the patent suggest any mobility requirements. EX1005, 6:59-63; EX2040, ¶137. A POSITA reviewing the Horn disclosure would find no indication that mobility is a relevant factor in the system's design. EX2040, ¶137. The enterprise-level nature of the system, its focus on large-scale data management, and its reliance on stable, high-throughput processing all point toward a fixed, stationary computing environment. EX1005, 7:7-10. As such, there is no justification or motivation for implementing wireless networking, reinforcing that a wired infrastructure is both the intended and optimal choice. EX2040, ¶137.

Given its specific design, integrating wireless LAN would introduce unnecessary performance bottlenecks, security vulnerabilities, and operational inefficiencies, making it an impractical and unjustifiable choice for such an infrastructure. *Id.*, ¶138. Even today's distributed computer systems, which are similar to Horn's system, prefer wired network connectivity at least at the backend for higher speeds, bandwidth, and network security. *Id.*, ¶139. In sum, a POSITA would readily conclude that the Horn system is a wired, server-based architecture,

designed for high-performance data management and optimized for security, stability, and scalability—all of which necessitate wired network infrastructure. Wireless LAN such as that disclosed in Baumgartner is not a viable option, and Petitioner’s analysis fails to consider these fundamental technical realities. *Id.* Therefore, a POSITA would not have considered it obvious to combine Baumgartner with Horn. *Id.*, ¶140.

2. The Combination of Horn and Baumgartner Fails to Disclose Limitation 1[b] and 9[a]

Petitioner fails to show that Horn in combination with Baumgartner discloses claim elements 1[b] and 9[a]: a recording medium on which is stored a plurality of video information including first video information received wirelessly by the network interface. EX2040, ¶141.

Specifically, Petitioner admits that “Horn does not expressly disclose that the digital video information is received by the network interface wirelessly.” Pet. at 29. In fact, Horn does not even disclose receiving video, let alone receiving it wirelessly. Horn discloses receiving files, music and images: “[t]he e-mail domain is linked through a network for the communication of files, music and images to and from a network.” EX1005, 12:5-7. This is because Horn is interested in providing a “space-saving” file system, and not a system like videos that would use up too much storage. EX2040, ¶142.

Petitioner tries to plug this deficiency by simply pointing to Horn's LAN:

A POSITA would have understood that a LAN is often implemented as a wireless LAN, and a POSITA would have found it obvious to implement Horn's LAN with a wireless LAN because they were often cheaper and easier to install than a wired LAN due to elimination of the need to run wires to all of the endpoint computers in the network. Additionally, wireless LANs can be more convenient for users.

Pet. at 29; EX1003, ¶14. Specifically, Petitioner attempts to use Baumgartner to fill this gap in the teachings of Horn. However, a POSITA wouldn't be motivated to combine Baumgartner with Horn. As discussed above, at the time of the '815 Patent, it would not have been obvious to a POSITA to combine Baumgartner with Horn because they are solving different problems and hence directed to different solutions, and the wireless LAN is not necessarily cheaper (e.g., a wireless LAN card is more expensive than a wired LAN card at the time of the patent) as Petitioner claims. EX2040, ¶143.

In addition, Horn fails to show that "[a]n information processing apparatus ... [having a] recording medium such that first video information is received first video information received wirelessly by the network interface over a network *from another information processing apparatus*," as required by claim 1[b] and 9[a] of the '815 Patent. EX2040, ¶144. Here, the "information processing apparatus" means

the same thing in the claim. *See Frank's Casing Crew & Rental Tools, Inc. v. Weatherford Intern., Inc.*, 389 F.3d 1370, 1377 (Fed. Cir. 2004) (“the same terms appearing in different portions of the claims should be given the same meaning unless it is clear from the specification and prosecution history that the terms have different meanings at different portions of the claims”). Petitioner points to “PC” as the information processing apparatus in both Horn and Baumgartner, but fails to show “another PC,” as required by claim element 1[b] and 9[a], from which video information is received wirelessly by the network interface. EX2040, ¶144. In particular, Petitioner admits that “Horn does not expressly disclose that the digital video information is received by the network interface wirelessly.” Pet. at 29.

Baumgartner also doesn’t meet this limitation either because it discloses a PC receiving video on demand from a “television distribution facility 14.” EX2040, ¶145. Petitioner has not provided any explanation if the Baumgartner’s “PC” corresponds to the claimed “information processing apparatus.” Specifically, Baumgartner’s “television distribution facility 14” cannot correspond to “another information processing apparatus,” as the claims require communication between two information processing apparatuses, and not communication between in any category of devices.

Therefore, because Petitioner has not shown Horn in view of Baumgartner discloses claim elements 1[b] and 9[a], Petitioner failed to show unpatentability by a preponderance of the evidence for any claim in Ground 1.

3. The Combination of Horn and Baumgartner Fails to Disclose Limitation 1[c] and 9[b]

Petitioner fails to show that Horn in combination with Baumgartner discloses “at least some of the plurality of **video information** is associated with a **user profile**” as required by claim elements 1[c] and 9[b]. EX2040, ¶147. As discussed above, “user profile” term should be construed to mean “a collection of settings and information associated with a user.”

Petitioner and Dr. Bederson erroneously rely on Horn’s disclosure regarding “collections” to argue that the user profile limitation is met. EX1003, ¶146. However, this interpretation is fundamentally flawed, as collections, as disclosed by Horn, are not equivalent to user profiles. EX2040, ¶148. Horn explicitly defines a collection as:

Collection: means a grouping of objects based on a metadata specification describing properties that all objects in the group have in common, or objects that were grouped together specifically by the user as having some shared meaning or logical grouping.

EX1005 at 4:1-5.

This definition clearly distinguishes collections from user profiles. EX2040, ¶149. Collections, as described in Horn, are metadata-driven groupings or manually curated sets of objects. *Id.* They do not represent specific settings and information associated with a user, which is the core requirement of a user profile. *Id.* Moreover, Horn discloses a system-centric approach rather than a user-centric system. The MFS system in Horn is designed for generalized data management, ensuring broad applicability across various data types and sources, rather than enabling customization for individual users. EX2040, ¶150. Critically, Horn does not disclose any personalization features such as saved user settings or user-based configurations, which are essential components of a user profile per court’s construction. *Id.*

Recognizing this gap in Horn, Petitioner attempts to bridge the deficiency by relying on Baumgartner. Pet. at 34. However, as previously established, a POSITA would not be motivated to combine Baumgartner with Horn. EX2040, ¶151. Petitioner’s attempt to extend Horn’s disclosure beyond its intended scope is unsupported by the evidence and inconsistent with the system’s actual functionality. *Id.*

Thus, Horn’s disclosure of “collections” does not meet the user profile limitation, and Petitioner’s reliance on this argument is both incorrect and misleading. EX2040, ¶152.

4. The Combination of Horn and Baumgartner Fails to Disclose Limitation 1[g] and 9[e]

Petitioner fails to show that Horn in combination with Baumgartner discloses claim elements 1[g] and 9[e]: “at least the first group of **video information** being configured to allow a user to edit.” EX2040, ¶153. Petitioner contends that the Horn-Baumgartner combination renders this limitation obvious. Pet. at 38-39. In support, the petition cites only to Horn at 20:16-46, and 17:18-45 as well as Figures 21-22 and 30. As set forth above, Horn does not disclose “video information,” and a POSITA would not be motivated to combine Horn and Baumgartner to include first video information received wirelessly by the network interface, as discussed above. EX2040, ¶153. The Petition’s deficiency in regard to element 1[g] can be seen by Petitioner’s elimination of any contention that Horn discloses the “first group of **video** information”: “Horn discloses the first group of information, *i.e.*, a collection, is configured to allow a user to edit membership in the collection....” Pet. at 38.

Therefore, Petitioner failed to show unpatentability by a preponderance of the evidence for any claim in Ground 1.

5. The Combination of Horn and Baumgartner Fails to Disclose Limitation 1[m] and 9[k]

Petitioner fails to show that Horn in combination with Baumgartner discloses claim element 1[m]: “the processor controls the display to display a thumbnail corresponding to the one video information as one of the second group of thumbnails

when the second character is selected” and 9[k]: “displaying a thumbnail corresponding to the one video information as one of the second group of thumbnails when the second character is selected.” EX2040, ¶154.

As set forth above, Horn does not disclose “video information,” and a POSITA would not be motivated to combine Horn and Baumgartner to include video information received wirelessly by the network interface. EX2040, ¶155. The Petition’s deficiency in regard to elements 1[m] and 9[k] can be seen by Petitioner’s elimination of any contention that Horn discloses the “thumbnail corresponding to the one video information”: “a POSITA would have understood that selection of the second collection (e.g., the Today collection) in the collection pane 2602 would result in the display of thumbnails for all objects in the second collection ...” Pet. at 42-43. EX2040, ¶155.

Therefore, Petitioner failed to show unpatentability by a preponderance of the evidence for any claim in Ground 1.

B. Ground 2: Petitioner Fails To Establish That Claims 7, 8, 14, and 15 are Rendered Obvious By Horn in View of Baumgartner and WinTV

Claims 7 and 8 depends from claim 1, and claims 14 and 15 depends from claim 9. As set forth above, the combination of Horn, Baumgartner fails to teach all of the limitations of claims 1 and 9. *See also* EX2040, ¶157. Additionally, as further

set forth below, Petitioner has not provided sufficient evidence to show that WinTV was publicly accessible. Thus, WinTV is not prior art. For these reasons, Ground 2 fails to show unpatentability of claims 7-8, and 14-15 by a preponderance of the evidence.

1. Petitioner Has Not Provided Sufficient Evidence that WinTV Was Publicly Accessible

Petitioner contends that WinTV was “published no later than September 14, 2003 on the Hauppauge.com website.” Pet. at 15. Petitioner further contends that “[a] POSITA would have been familiar with Hauppauge WinTV products...[and] would therefore have known to look on the Hauppauge website for relevant information.” *Id.* at 15-16. However, even assuming, *arguendo*, a POSITA would have been familiar with Hauppauge, Petitioner has not shown that the link provided to the manual was publicly accessible to POSITA before the critical date. EX2040, ¶98.

“[T]he burden is on the petitioner to identify with particularity evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent, and therefore that there is a reasonable likelihood that it qualifies as a printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 16 (PTAB Dec. 20, 2019) (precedential). The determination of whether a document was publicly

accessible “involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.” *Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018). What constitutes a printed publication “must be determined in light of the technology employed.” *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1369 (Fed. Cir. 2019) (citing *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981)). “[E]lectronic documents may be publicly accessible if they were indexed or catalogued, or if there were other tools for customary and meaningful research. See *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1196 (Fed. Cir. 2008) (quoting *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006)). Public accessibility requires more than technical accessibility. *Id.* (citing *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 773 (Fed. Cir. 2018)). “[A] work is not publicly accessible if the only people who know how to find it are the ones who created it.” *Id.* at 1372. Here, there are critical gaps in Petitioner’s evidence attempting to show WinTV is prior art.

First, Petitioner fails to provide sufficient evidence that WinTV was actually offered for sale/sold in the U.S. EX1011, upon which Petitioner relies, is an unauthenticated Internet Archive web page accessed on March 28, 2024 purporting to show a screen capture from the Hauppauge web site from, according to Petitioner, November 10, 1999. Pet. at 6. Yet, Petitioner provides no Internet Archive affidavit

to support this exhibit. Moreover, even taking the exhibit at face value, it provides no evidence that WinTV was offered for sale in the US by November 10, 1999.

Second, Petitioner has not provided sufficient evidence that the WinTV Installation and Reference Manual (EX1010) was publicly accessible to a POSITA prior the critical date. EX2040, ¶98.

It is undisputed that the link provided by Petitioner takes a user in 2024/2025 to the manual Petitioner uses as Exhibit 1010. However, Petitioner has provided no evidence to support its statement that “[a] POSITA would have been familiar with Hauppauge WinTV products...[and] would therefore have known to look on the Hauppauge website for relevant information.” *Id.* at 6-7.

In fact, the evidence suggests the opposite and that EX1010 would have only been accessible by the ones who created it, and was not indexed in a customary or meaningful way. For example, Dr. Balakrishnan navigated within the Internet Archive to the Hauppauge web site around the time Petitioner contends the WinTV manual was available (in August or September 2003) (*see, e.g.*, EXS2022-2023). EX2040, ¶99. He explored some links present at the time within those web pages, for example:

Exhibit	Link
2027	https://web.archive.org/web/20031001191953/http://www.hauppauge.com

	com:80/html/tech.htm
2028	https://web.archive.org/web/20031001185005/http://www.hauppauge.com:80/html/specs.htm
2029	https://web.archive.org/web/20031011045622/http://www.hauppauge.com:80/manuals/

With respect to the link at Exhibit 2029, Dr. Balakrishnan found that:

it is the next higher level directory where one would expect the manuals to be accessible. However, as can be seen from Exhibit 2029, that access was denied:



This leads me to conclude that the general public, or a POSITA at the time, did not have access to the various WinTV manuals, at least through the Hauppauge web site at the time. I could find no link to current or archived manuals. Even further exploring some of the links on the home page failed to provide accessibility to product manuals.

EX2040, ¶¶100-101.

In an attempt to gloss over this deficiency in the evidence, Petitioner cites to various patents (*e.g.*, EX1037-1038) and states “[t]hese products were also

mentioned in patents that would have come to the attention of a POSITA looking for information on such products.” Pet. at 7. However, these patents are not evidence of the public accessibility of the WinTV Manual Petitioner uses in the Petition. EX2040, ¶102. The Petition never explains how the vague references to “WinTV” in these documents provides any evidence of the public accessibility of the manual. No connection is made between these documents and their relevance to the WinTV Manual—the reference—rather than simply vaguely referenced “WinTV products.”

Whether a POSITA was looking for information on unnamed WinTV products is irrelevant to whether the WinTV Manual—as used in the Petition—was publicly accessible prior to December 2, 2004. EX2040, ¶103. Indeed, the Board has rejected similar efforts to establish public accessibility of a reference based on publication of another document. *See, e.g., Monolithic Power Sys., Inc. v. Volterra Semiconductor LLC*, IPR2020-01351, Paper 20 at 6-11 (PTAB March 4, 2021) (finding Petitioner had not established public accessibility of a reference based on publication of another document because the record lacked evidence “that would tend to indicate that the release of the Handbook submitted as Exhibit 1017 is the particular release to which Philips refers.”)

There is no evidence that the WinTV manual (EX1010) was indexed or catalogued such that a POSITA would have had access to it in 2003. Rather, it

appears that only Hauppauge employees would know where to access the manuals in 2003. EX2040, ¶104. Petitioner has failed to show by a preponderance of the evidence that the WinTV manual (EX1010) was publicly accessible prior to the critical date. “[A] work is not publicly accessible if the only people who know how to find it are the ones who created it.” *Samsung Elecs. Co.*, 929 F.3d at 1372.

2. No Motivation to Combine WinTV with Horn and Baumgartner

For Ground 2, Petitioner attempts to use the WinTV reference to fill in the various gaps of the teachings of Horn with regard to the dependent claims of the ’815 Patent. *See generally* Pet. at 54-60. As set forth above in the preceding section, Petitioner has not met its burden in showing that WinTV was publicly accessible and thus has not met its burden of showing WinTV is prior art. For this reason Ground 2 fails to show unpatentability by a preponderance of the evidence.

Additionally, even were WinTV considered to be prior art, Petitioner has not shown how a POSITA would have combined the teachings of WinTV with at least the teachings of Horn in addition to Baumgartner with any expectation of success. EX2040, ¶159. A POSITA wouldn’t be motivated to combine Horn with WinTV because they are two different systems. *Id.* The problem solved by Horn is unrelated to the technical solutions addressed by WinTV. Horn discloses a “truly **open computer system** having data structures, input interfaces, displays and operational

systems that permits the organization of information, as data objects” and permit a “**faster archiving** , retrieval and viewing of the information.” EX1005, 3:10-17 (emphasis added). Moreover, Horn proposes a computer data processing system that has a “**simple-to-use** data structure and operating mechanism to link information together in a dynamic, memory-and- space-efficient manner.” EX1005, 3:19-22 (emphasis added). In contrast, WinTV discloses a “Plug and Play” device installed to receipt, playback and record video. EX1010, 3-4, 4-1. A POSITA would not be motivated to combine the TV tuner card from WinTV to Horn’s simple-to-use computer file system, because Horn is directed to making “collections” based on keywords in documents, and is not directed to receiving, playing and recording of video. EX2040, ¶159.

Additionally, the Petitioner states that Baumgartner suggests including a television tuner card for decoding tv channels. Pet. at 54. However, Horn does not suggest or teach to incorporate a tv tuner card in its system. EX2040, ¶160. In particular, a POSITA maybe motivated in modifying a set-top box system of Baumgartner with a TV tuner card, however, a POSITA would not be motivated to include a TV tuner card in a “truly open system” with an MFS system as disclosed in Horn that is directed to collection of various documents. *Id.*

Therefore, Petitioner fails to establish by a preponderance of the evidence that any claim in Ground 2 is unpatentable.

C. Ground 3: Petitioner Fails To Establish That Claims 1-15 are Rendered Obvious By Horn in View of Baumgartner, WinTV, and Chao

Petitioner has not shown how a POSITA would have combined the teachings of Horn with at least the teachings of Baumgartner in addition to WinTV and Chao with any expectation of success. Again, Petitioner has not shown that WinTV was publicly accessible and thus has not shown WinTV is prior art. Ground 3 fails for this reason alone. EX2040, ¶162.

Additionally, Petitioner has provided only conclusory statements regarding the combination of these references and have failed to identify how each claim element will be mapped against these **four** references. *Id.*¶, 163; *see KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (Obviousness showing requires “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” and “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.”).

Moreover, Petitioner fails to state why a POSITA would be motivated to modify Horn to add thumbnails for folders of content data as disclosed in Chao.

Horn discloses a **simple-to-use** data structure system that provides interfaces for organization of data objects in a memory-and-space-efficient manner. *See* EX1005, 3:10-22. Horn teaches away from adding further complexity to its system, because its goal is to organize and display data in a space efficient manner. EX2040, ¶164. Additionally, Petitioner fails to state what thumbnails would be used from Chao to modify the folders in Horn. *See In re Hedges*, 783 F.2d 1038, 1041 (Fed. Cir. 1986) (“[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.”).

In particular, Petitioner fails to disclose why a POSITA would be motivated to modify the operating system (OS) code of Horn computer to include the thumbnails features from Chao. EX2040, ¶165. Horn’s system is already optimized for efficient data organization and display. Simply identifying that thumbnails exist in Chao is not sufficient motivation to modify Horn. Without a clear rationale for the combination, the Petitioner’s argument relies on impermissible hindsight reconstruction. *Id.*

Horn explicitly teaches away from additional complexity. EX2040, ¶166. A POSITA would recognize that modifying Horn to include Chao’s thumbnails would

undermine its core functionality by introducing processing overhead that conflicts with its space-efficient design. In particular, the modifications which contradict the intended function of the prior art (Horn) cannot be considered obvious. *Id.*

Petitioner does not explain how a POSITA would access or modify Horn's OS code to integrate Chao's thumbnails. Chao provides no guidance on which specific lines of Horn's OS code would require modification, leaving a POSITA to engage in an uncertain and speculative process. *Id.*, ¶167. Specifically, obviousness requires a reasonable expectation of success, which Petitioner has failed to establish.

Furthermore, Petitioner ignores the fact that Horn's OS architecture is not compatible with Chao's thumbnail-based system. A POSITA would not simply extract Chao's thumbnail implementation and insert it into Horn without overcoming significant hardware and software integration challenges. EX2040, ¶168. Petitioner fails to address these challenges, making the proposed modification impractical and non-obvious.

Therefore, Petitioner failed to show unpatentability by a preponderance of the evidence for any claim in Ground 3.

D. Grounds 4-5 Fail Because Kaplan and Bryant Do Not Disclose Elements 1[b], 1[c], 1[g], 1[l], 1[m], 9[a], 9[b], 9[e], 9[j], and 9[k] Either Alone Or In Combination

As with prior grounds, Petitioner relies on cursory analysis in an attempt to utilize Kaplan and Bryant to show Claims 1-15 are unpatentable. However, Petitioner fails to show Kaplan and Bryant, either alone or together, render the claims unpatentable.

1. Petitioner Does Not Adequately Articulate a Combination of Kaplan and Bryant's Teachings

"It is Petitioner's burden to explain specifically how the references would be combined to produce the claimed invention." *Lowe's Home Centers, LLC v. Epistar Corp.*, IPR2018-00932, Paper 7 at 19 (PTAB Nov. 1, 2018) (citing *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016)). Indeed, this requirement is set out in the statutory text of 35 U.S.C. § 312(a)(3)—"the petition identifies, in writing and **with particularity**, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim." For each of the individual reasons herein, the Petition lacks this explanation and therefore Grounds 4 and 5 fail.

First, the Petition repeatedly recites what Kaplan and Bryant purportedly teach *individually* (e.g., Pet. at 73 ("The Kaplan-Bryant combination renders this limitation obvious. Kaplan's computer includes...Bryant's computer also...Kaplan

further discloses...as does Bryant...”) but fails to assert “what the combined teachings of those references would have suggested to those of ordinary skill in the art.” *Willis Elec. Co., Ltd. v. Polygroup Macau Ltd.*, 777 Fed. Appx. 495, 501 (Fed. Cir. 2019) (citing *In re. Keller*, 642 F.2d 413, 425 (CCPA 1981)). But “the Board tends to reject a ‘pick-and-choose’ approach to the presentation of evidence.” *Trend Micro Inc. v. Open Text Inc.*, IPR2023-00692, Paper 8 at 28 (PTAB Nov. 6, 2023) (denying institution where “Petitioner’s case is lacking a clear roadmap of which reference it relies on to disclose which limitation”). Such approach is “challenging to follow and makes it difficult to piece together in order to understand Petitioner’s proposed combination or modification.” *Lyft, Inc. v. Quartz Auto Techs., LLC*, IPR2020-01450, Paper 7 at 17-20 (PTAB Mar. 4, 2021) (denying institution where petitioner “does not articulate adequately how it proposes to modify one of the references or to combine the two references’ teachings”).

While the features of a secondary reference need not be bodily incorporated into the structure of the primary reference, a “clear, evidence-supported account of the contemplated workings of the combination is a prerequisite to adequately explaining and supporting a conclusion that a relevant skilled artisan would have been motivated to make the combination and reasonably expect success in doing so” is required. *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir.

2017). Accordingly, Petitioner's non-specific approach to the Kaplan-Bryant combination cannot meet its burden to establish a reasonable likelihood of success.

The Petition is organized such that Petitioner attempts to address the combination of Kaplan and Bryant and alleged motivation to combine up front, Pet. at 66-70, and then the Petition makes fleeting references of the purported combination within individual limitations. *See, e.g.*, Pet. at 83-87 (limitation 1[l]), 87 (limitation 1[m]). But neither the generic motivation to combine section nor the cursory mentions of a combination in a few limitations meets Petitioner's burden to explain what the combined teachings of Kaplan and Bryant would have suggested to a POSITA. EX2040, ¶171.

Petitioner's general motivation-to-combine discussion makes only conclusory statements that a POSITA would have modified the teachings in Kaplan based on Bryant's digital camera and "usable-customizable metadata." Pet. at 67. However, these vague suggestions merely parrot portions of Kaplan and Bryant. EX2040, ¶172. For example, Petitioner alleges "a POSITA would have known how to modify any data structures and user interfaces to include additional metadata because modifying data structures and user interfaces was well within their skill, and they had already created those data structures and user interfaces to create the system of Kaplan in the first place." Pet. at 69-70. Such "conclusory statements alone" are

“insufficient articulations of motivation to combine.” *In re Nuvasive, Inc.*, 842 F.3d 1376, 1383 (Fed. Cir. 2016).

Further, Petitioner’s limitation-specific analysis of the independent claim merely discusses the teaches of Kaplan and Bryant individually and does not provide an “account of the contemplated workings of the combination.” *Personal Web Techs.*, 848 F.3d at 994. The table below includes, for each limitation in claim 1, Petitioner’s discussion of each reference and the purported combination:¹

Claim Limitation	Petitioner’s Asserted Reference Discussion
[1pre]	“To the extent the preamble is limiting, Kaplan discloses it.” Pet. at 70.
[1a]	“This limitation is obvious over Bryant.” Pet. at 71 (no mention of Kaplan)
[1b]	“The Kaplan-Bryant combination renders this limitation obvious.” Pet. at 73 (discussing Kaplan and Bryant individually without discussing the combination)
[1c]	“Bryant discloses this limitation.” Pet. at 74 (no mention of Kaplan)

¹ The argument applies equally to Petitioner’s analysis of Claim 9 because it simply refers back to the Claim 1 analysis.

[1d]	“The Kaplan-Bryant combination discloses and renders obvious this limitation.” Pet. at 74-75 (discussing Kaplan and Bryant individually without discussing the combination)
[1e]	“The Kaplan-Bryant combination discloses and renders obvious this limitation.” Pet. at 75 (discussing Bryant and no mention of Kaplan)
[1f]	“The Kaplan-Bryant combination renders this limitation obvious.” Pet. at 76-77 (discussing Kaplan and no mention of Bryant)
[1g]	“The Kaplan-Bryant combination renders this limitation obvious.” Pet. at 77 (discussing Kaplan and no mention of Bryant)
[1h]	“The Kaplan-Bryant combination renders this limitation obvious.” Pet. at 77 (discussing Kaplan and no mention of Bryant)
[1i]	“The Kaplan-Bryant combination renders this limitation obvious.” Pet. at 77-78 (discussing Kaplan and no mention of Bryant)
[1j]	“Bryant and Kaplan each disclose and/or render obvious this limitation, and their combination renders it obvious.” <i>But see</i> Pet. at 78-79 (discussing Kaplan and no mention of Bryant)
[1k]	Pet. at 79-80 (discussing Kaplan and no mention of Bryant)

[1l]	“To the extent that this limitation is not disclosed or obvious over Kaplan, it is disclosed or at least obvious over Bryant.” Pet. at 83 ²
[1m]	“...taught by both Kaplan and Bryant” Pet. at 87

The Petition never stays true to one primary reference and one secondary reference in this combination. Rather, the Petition simply ignores one reference in favor of the other in some limitations (*e.g.*, limitations 1[pre], 1[a], 1[c]) and oftentimes alleges to discuss the “Kaplan-Bryant combination” while only relying on a single reference (*e.g.*, limitations 1[e]-1[k]). Such approaches are insufficient to establish obviousness under Section 103. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“A patent composed of several elements is not proved obvious by merely demonstrating that each of its elements was, independently, known in the prior art.”).

In some instances, Petitioner cites lengthy portions of a reference as support without any explanation as to what in those citations supports Petitioner’s obviousness combination. As one example, for limitation 1[l], Petitioner cites paragraphs 89-106 (over three columns), and figures 9A-9C of Kaplan without

² See *infra* for further explanation as to why this language has been rejected by the PTAB.

explanation. Pet. at 85. “It is not the Board’s job to cobble together assertions from different sections of a petition or citations of various exhibits in order to infer every possible permutation of a petitioner’s arguments,” but that is what the Petitioner asks the Board and Patent Owner to do here. *Microsoft Corp. v. FG SRC, LLC*, 860 Fed. Appx. 708, 713 (Fed. Cir. 2021). The result of Petitioner’s mix-and-match approach to combining Kaplan and Bryant along with the overly broad citations asks the Board and Patent Owner to interpret which elements from each reference a POSITA would choose to combine, which portions of each reference should be considered, and what the combined teachings might suggest to a POSITA.

Petitioner’s choice to discuss the teachings of Kaplan and Bryant separately rather than to discuss “the contemplated workings of the combination” cannot establish a reasonable likelihood of success. *Personal Web Techs.*, 848 F.3d at 994; *Trend Micro Inc.*, IPR2023-00692, Paper 8 at 28.

Second, the defective combination of Kaplan and Bryant is further exacerbated by Petitioner’s inclusion of a third reference, Baumgartner. For limitation 1[a], the Petition contends that “this limitation is obvious over Bryant.” Pet. at 71. But then, without providing any motivation to combine references, the Petition bring in the teachings of Baumgartner to show forming a wireless connection between a computer and the Internet. Pet. at 72. Such omission of a

motivation to combine Baumgartner with Kaplan and Bryant is fatal to this combination. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 449 (Fed. Cir. 2015) (“When asserting that a claimed invention would have been obvious, that party must demonstrate that a skilled artisan would have had reason to combine the teaching of the prior art references to achieve the claimed invention....”) (internal quotes omitted).

Third, Petitioner avails that for limitation 1[l], “the Kaplan-Bryant combination renders this limitation obvious as each of Kaplan and Bryan [sic] disclose or render obvious this limitation.” Pet. at 80. After contending that Kaplan alone discloses this limitation, Pet. at 81-83, the Petition then states that “**to the extent that** this limitation [1l] is not disclosed or obvious over Kaplan, it is disclosed or at least obvious over Bryant.” Pet. at 83. However, the Petition is silent as to what circumstances Kaplan would not disclose this element. There is, therefore, no indication in the Petition that [Kaplan] has any deficiencies related to this element. It is thus, unclear why a person of ordinary skill would turn to Bryant for the teaching of an element that, according to Petitioner, is already taught by Kaplan. For this additional reason, the Kaplan-Bryant combination fails.

Therefore, Petitioner failed to establish by a preponderance of the evidence the unpatentability of any claim in Grounds 4-5 based on its failure to adequately

articulate a combination of Kaplan and Bryant's teachings.

2. The Combination of Kaplan and Bryant Fails to Disclose Limitation 1[b] and 9[a]

Petitioner argues that that Bryant discloses “a recording medium on which is stored a plurality of video information including first **video information received wirelessly by the network interface** over a network from another information processing apparatus, wherein at least some of the plurality of video information is associated with a user profile,” as required by claim element 1[b] and 9[a] of the '815 Patent.

Bryant cites the hard drive 20 of the home computer 10 in the Figure 1 as the claimed recording medium. However, there is no description about the “first video information received wirelessly by the network interface over a network from another information processing apparatus.” EX2040, ¶175. Although the home computer 10 includes a modem 22, Bryant does not disclose that the home computer 10 wirelessly receives video information by the network interface over a network from another information processing apparatus. *Id.*

Additionally, Kaplan also fails to disclose that it receives video information wirelessly, as required by claim 1 of the '815 Patent. EX2040, ¶176. The Petitioner recognizes this deficiency in Kaplan-Bryant combination when it states that

“receiving this information wireless via a wireless modem at the Kaplan-Bryant PC would have been obvious to a POSITA.” Pet. at 73.

Therefore, Petitioner failed to show unpatentability by a preponderance of the evidence for any claim in Grounds 4-5.

3. The Combination of Kaplan and Bryant Fails to Disclose Limitation 1[c] and 9[b]

Petitioner fails to show that Kaplan in combination with Bryant discloses “at least some of the plurality of **video information** is associated with a **user profile**” as required by claim elements 1[c] and 9[b]. As discussed above, “user profile” should be construed to mean “a collection of settings and information associated with a user. See EX2040, ¶178.

Petitioner erroneously relies on Bryant’s disclosure regarding “affective information” about images to argue that the user profile limitation is met. EX1003, ¶226; EX2040, ¶179. However, Petitioner, agrees that Bryant discloses “information that relates to the feelings or emotions of a person towards images.” EX1015, ¶30. Notably, the feelings and emotions information is not a “collection of settings and information associated with a user.” But Bryant’s disclosure of “affective information” about images does not meet the user profile limitation, and Petitioner’s reliance on this argument is both incorrect and misleading. EX2040, ¶180.

For all the foregoing reasons, Petitioner fails to show unpatentability by a preponderance of the evidence for any claim in Grounds 4-5.

4. The Combination of Kaplan and Bryant Fails to Disclose Limitation 1[g] and 9[e]

Petitioner has failed to provide any evidence that Bryant-Kaplan combination discloses “the first group of video information being configured to allow a user to edit” as required by claim elements 1[g] and 9[e] of the ’815 Patent. EX20204, ¶182.

Specifically, Petitioner simply points to Kaplan paragraph 44 to show that the buttons 26, 28 represent “containers that are configured to allow a user to edit, such as by adding a video to a container using standard operation system window functions 20, such as FILE which can include marking a vide as a favorite.” Pet. at 77. Petitioner is mischaracterizing Kaplan’s disclosure. Paragraph 44 of Kaplan doesn’t refer to button 28. Additionally, the disclosure provides no evidence that a user can edit “video information.” EX20204, ¶183.

Therefore, Petitioner failed to show unpatentability by a preponderance of the evidence for any claim in Grounds 4-5.

5. The Combination of Kaplan and Bryant Fails to Disclose Limitation 1[l] and 9[j]

Petitioner has failed to show that the combination of Kaplan and Bryant discloses “wherein, upon one video information stored on the recording medium included in both the first group of video information and the second group of video

information being deleted from the first group of video information, the one video information continues to be included in the second group of video information and the processor controls the display to display a thumbnail corresponding to the one video information as one of the second group of thumbnails when the second character is selected” as required by claim elements 1[l] and 9[j] of the ’815 Patent. EX2040, ¶185. After contending that Kaplan alone discloses this limitation, Pet. at 81-83, the Petition then states that “*to the extent that* this limitation [1l] is not disclosed or obvious over Kaplan, it is disclosed or at least obvious over Bryant.” Pet. at 83. However, the Petition is silent as to what circumstances Kaplan would not disclose this element or what Bryant might specifically provide to remedy Kaplan’s deficiency. EX2040, ¶185. For this additional reason, the Kaplan-Bryant combination fails. See Section IV.I.1, *supra*.

Additionally, Patent Owner is not estopped from arguing Petitioner’s failure with respect to this element, as set forth below.

a. Collateral Estoppel Does Not Apply

Petitioner argues that collateral estoppel applies to limitation 1[l]:

the doctrines of issue preclusion and collateral estoppel preclude Maxell from contesting that Bryan does not disclose, and the combination of Kaplan and Bryan do not render obvious [sic]. This is because the language of this limitation is nearly identical, and is

substantively identical, to limitation 2.9 of the '783 patent, which was held by the Board in the 01432FWD to be taught by Bryant alone and by the combination of Kaplan and Bryant.

Pet. at 80-81. A party seeking to invoke collateral estoppel must show:

(1) the issue is identical to one decided in the first action; (2) the issue was actually litigated in the first action; (3) resolution of the issue was essential to a final judgment in the final action; and (4) [the party against whom collateral estoppel is being asserted] had a full and fair opportunity to litigate the issue in the first action.

In re Freeman, 30 F.3d 1459, 1465 (Fed. Cir. 1994). Here, collateral estoppel does not apply at least because the issue was not actually litigated. In the FWD on which Petitioner bases this argument, the Board noted that “[b]ecause this *inter partes* review is based on a petition filed before November 13, 2018, we construe the claims by applying the broadest reasonable interpretation in light of the specification.” Ex. 1009 at 9-10. In the FWD, the Board construed usage of the singular “one” in “one video information,” which was part of limitation 2.9, and disagreed with Patent Owner’s interpretation of that term under a broadest reasonable interpretation standard. *Id.* at 11-12. But in this proceeding, the standard of claim interpretation is different—it is the standard that is used in federal courts. 37 C.F.R. § 42.100(b).

The different claim construction standards applied by the Board in the FWD and the standard to be applied in this proceeding prevent any expansion of the

collateral estoppel doctrine here because the claim construction issues have not actually been litigated. *Cf. Skyhawk Techs., LLC v. Deca Int’l Corp.*, 828 F.3d 1373, 1376 (Fed. Cir. 2016) (“Because the Board applies the broadest reasonable construction of the claims while the district courts apply a different standard of claim construction as explored in *Phillips*..., the issue of claim construction under *Phillips* to be determined by the district court has not been actually litigated.”). As such, the Board should reject Petitioner’s collateral estoppel argument.

Additionally, the issues of patentability between the two proceedings are not identical. In attempting to show identical issues of patentability, Petitioner unnaturally parses out elements 1[l] and 1[m], where the claim language is clearly one element in the ’815 Patent, and Petitioner’s element 1[m] is not included in the ’783 Patent. While there is some language in the respective claims that is similar, a comparison of the claim language between the two patents show that, when considered as a whole, the issues of patentability are not identical when considering the claim language as a whole. *Compare* EX2009, Claim 2 *with* Ex. 1001, at Claim 1.

As such, Maxell is not estopped from arguing that Petitioner has failed to meet its burden of showing Bryant and Kaplan render claim 1 unpatentable with respect to claim element 1[l].

6. Kaplan and Bryant Fail to Disclose Claim Elements 1[m] and 9[k]

Petitioner appears to acknowledge that Kaplan-Bryant combination does not disclose that “the processor controls the display to display a thumbnail corresponding to the one video information as one of the second group of thumbnails when the second character is selected,” as required by claim 1 of the ’815 Patent, because it only argues in, in a cursory fashion, that “a POSITA would have understood that selection of a second collection (e.g., the History or All Images collection) would result in the display of thumbnails for all objects in the second collection even if one of those objects had been removed from a favorites collection.” Pet. at 87. However, Kaplan discloses folder icons and does not show the thumbnails corresponding to the video information. EX2040, ¶187. For example, Figure 8 of Kaplan shows that selection of History button results in displaying of objects that include a film icon on folder 56 instead of the video information thumbnail. Ex. 1014, Fig. 8.; EX2040, ¶187.

For the reasons expressed above, the Petitioner has failed to show that any of Grounds 1-5 render claims 1-15 unpatentable by a preponderance of the evidence.

VI. CONCLUSION

For at least the foregoing reasons, the Board should confirm the patentability of the challenged claims 1-15.

Dated: January 31, 2025

Respectfully submitted,

/Robert G Pluta Reg No 50970 /
Robert G. Pluta (Reg. No. 50,970)
MAYER BROWN LLP
71 S. Wacker Drive
Chicago, IL 60606
Telephone: (312) 701-8641
Fax: (312) 706-8144

Saqib J. Siddiqui (Reg. No. 68,626)
MAYER BROWN LLP
1999 K Street NW
Washington DC, 20006
ssiddiqui@mayerbrown.com

Counsel for Maxell, Ltd.

CERTIFICATE OF SERVICE

I hereby certify that on this 31st day of January, 2025, a copy of the attached PATENT OWNER RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 11,017,815, together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

James Heintz
Jim.Heintz@us.dlapiper.com

Gianni Minutoli
Gianni.Minutoli@us.dlapiper.com

With a courtesy copy by electronic mail to:
dla-samsung-maxell@us.dlapiper.com

Respectfully submitted,

Date: January 31, 2025

By: /Robert G Pluta Reg No 50970/
Robert G. Pluta (Reg. No. 50,970)

Counsel for Maxell, Ltd.

CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Patent Owner's Response complies with the type-volume limitation of 37 CFR §42.24(a). The word count application of the word processing program used to prepare this Patent Owner's Response indicates that the Response contains 9,851 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

Respectfully submitted,

/Robert G Pluta Reg No 50970/

Robert G. Pluta (Reg. No. 50,970)
Mayer Brown, LLP
71 S. Wacker Drive
Chicago, IL 60606
Telephone: (312) 701-8641
Fax: (312) 706-8144
rpluta@mayerbrown.com