

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

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

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. ARGUMENT	1
A. Waived Arguments	1
B. Claim Construction	2
C. Ground 1: Claims 1-6 and 9-13 Are Obvious Over Horn in View of Baumgartner	2
1. Motivation to Combine Horn and Baumgartner	2
a. Maxell's Different Systems Argument Fails	2
b. Maxell's Wireless LAN Cost Argument Fails	4
c. Maxell's "Horn Is limited to Server-Based Systems" Argument Fails	6
d. Maxell's Network Speed and Security Arguments Fail	10
2. The Combination of Horn and Baumgartner Discloses Limitations 1[b] and 9[a]	11
3. The Combination of Horn and Baumgartner Discloses Limitations 1[c] and 9[b]	13
4. The Combination of Horn and Baumgartner Discloses Limitations 1[g] and 9[e]	15
5. The Combination of Horn and Baumgartner Discloses Limitations 1[m] and 9[k]	15
D. Ground 2: Claims 7, 8, 14 and 15 Are Obvious Over Horn in View of Baumgartner and WinTV	16
1. WinTV Was Published	16
a. The WinTV Product Was On Sale in the U.S. in 1999	16
b. WinTV Was Published Via the Hauppauge Website	18
2. There is Ample Evidence of Motivation to Combine WinTV with Horn and Baumgartner	21

E. Ground 3: Claims 1-15 are Obvious Over Horn in View of Baumgartner, WinTV and Chao.....22

F. Ground 4: Claims 1-15 are Obvious Over Kaplan and Bryant.....23

1. Motivation to Combine 23

2. The Kaplan-Bryant Combination Discloses Limitations 1[b] and 9[a].....23

3. The Kaplan-Bryant Combination Discloses Limitations 1[c] and 9[b].....24

4. The Kaplan-Bryant Combination Discloses Limitations 1[g] and 9[e].....25

5. The Kaplan-Bryant Combination Discloses Limitations 1[l] and 9[j] 26

6. The Kaplan-Bryant Combination Discloses Limitations 1[m] and 9[k] 28

III. CONCLUSION.....29

PETITIONER'S EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,017,815
1002	File History of U.S. Pat. 11,017,815
1003	Declaration of Dr. Benjamin Bederson
1004	CV of Dr. Benjamin Bederson
1005	U.S. Patent No. 7,275,063 ("Horn")
1006	U.S. Patent No. 7,970,240 ("Chao")
1007	U.S. Patent No. 7,650,361 ("Wong")
1008	Declaration of Nathaniel E. Frank-White
1009	<i>Fandango Media, LLC v. Maxell, Ltd.</i> , IPR2018-01432, Paper 32 (PTAB Feb. 10, 2020) ("01432FWD")
1010	WinTV Installation and Reference Manual (June 30, 1999) ("WinTV")
1011	Archived Specifications - WinTV PCI boards including the WinCast/TV and WinTV-pci (November 10, 1999) (https://web.archive.org/web/19991110153658/http://hauppauge.com:80/html/wc_data.htm)
1012	Bt848/848A/849A - Single-Chip Video Capture for PCI – Datasheet ("BT848")
1013	U.S. Patent Application Publication No. 20030174844A1 ("Candelore")
1014	U.S. Patent Application Publication No. 20010056434A1 ("Kaplan")
1015	U.S. Patent Application Publication No. 20040201691 ("Bryant")
1016	U.S. Patent Application Publication No. 20050160458A1 ("Baumgartner")
1017	Appendix 5 to PO's January 11, 2024 Infringement Contentions
1018	U.S. Patent No. 6,259,418 ("Jones")
1019	U.S. Patent No. 5,911, 129 ("Towell")
1020	JP-A-2000-152180
1021	Machine Translation of JP-A-2000-152180
1022	U.S. Patent No. RE32,632 to Atkinson
1023	Brent Ethington, <i>Introducing Microsoft Windows 95</i> , Microsoft Press (1995), with authenticating declaration of Carmen Debord
1024	U.S. Patent No. 6,493,006 to Gourdol et al.
1025	Microsoft Computer Dictionary, 4th Ed., Microsoft Press (1999)

Exhibit No.	Description
1026	James Cohoon & Jack Davidson, C++ Program Design: An Introduction to Programming and Object-Oriented Design, 3rd Ed., McGraw Hill (2002)
1027	George W. Furnas and Jeff Zacks, 1994, <i>Multitrees: Enriching and Reusing Hierarchical Structure</i> , In Proceedings of the SIGCHI Conference on Human Factors in Computer Systems (CHI 1994), Beth Adelson, Susan Dumais, and Judith Olson (Eds.), ACM, New York, NY, USA, 330-336. DOI http://dx.doi.org/10.1145/191666.191778 , with authenticating declaration of Scott Delman.
1028	U.S. Patent Application Publication No. 2004/0064476 to Rounds ("Rounds")
1029	U.S. Patent Application Publication No. 2002/0082730 to Capps et al. ("Capps")
1030	U.S. Patent No. 6,166,735 to Dom et al. ("Dom")
1031	U.S. Patent No. 5,884,056 to Steele ("Steele")
1032	U.S. Patent No. 5,442,744 to Piech et al. ("Piech")
1033	U.S. Patent Application Publication No. 2006/0107289 to DeYonker et al. ("DeYonker")
1034	Benjamin B. Bederson, 2001, PhotoMesa: A Zoomable Image Browser Using Quantum Treemaps and Bubblemaps, In Proceedings of the 14th annual ACM symposium on User Interface Software and Technology (UIST 2001), ACM, New York, NY, USA, 71-80. DOI http://dx.doi.org/10.1145/502348.502359
1035	U.S. Patent No. 6,609,253 to Swix et al. ("Swix")
1036	U.S. Patent Application Publication No. 2004/0078383 to Mercer et al. ("Mercer")
1037	WIPO Patent Publication No. WO 02/32122
1038	U.S. Patent No. 5,767,897
1039	"Windows XP Media Center Exposed" (AnandTech, January 8, 2003)
1040	File History of U.S. Patent No. 10,679,674
1041	File History of U.S. Patent No. 10,199,072
1042	File History of U.S. Patent No. 9,818,449
1043	File History of U.S. Patent No. 9,384,783
1044	File History of U.S. Patent No. 8,644,684
1045	File History of U.S. Patent No. 7,613,383
1046	Ex. 2002 from IPR2018-01432

Exhibit No.	Description
1047	Excerpt from American Heritage Dictionary (4 th ed. 2000)
1048	Excerpt from Microsoft Computer Dictionary (5 th ed. 2002)
1049	U.S. Patent No. 7,292,692 to Bonan et al. ("Bonan")
1050	Printout of https://www.atsc.org/news/security-content-protection-high-priorities-for-nextgen-tv/ (visited April 18, 2024)
1051	U.S. Patent No. 5,746,656
1052	U.S. Patent No. 5,729,741
1053	U.S. Patent Appl. Publication No. 2002/0077170
1054	Where to Buy WinTV. VideoTalk and VideoMagic Products
1055	Archived web page — Hauppauge (September 15, 1999)
1056	Archived web page — Hauppauge (November 17, 1999)
1057	Internet Archive Declaration
1058	11/8/24 email from Roshan Bhattarai to Patron Services Peach (Affidavits)
1059	11/12/24 email from Tanya Blue (Affidavits) to Roshan Bhattarai
1060	12/3/24 email from Roshan Bhattarai to Affidavits
1061	12/11/24 email from Roshan Bhattarai to Affidavits
1062	12/20/24 email from Patron Services Blue (Internet Archive) to Roshan Bhattarai
1063	Declaration of Roshan Bhattarai
1064	Exhibit 1064 from April 1, 2025 Balakrishnan Deposition
1065	Exhibit 1065 from April 1, 2025 Balakrishnan Deposition
1066	Exhibit 1066 from April 1, 2025 Balakrishnan Deposition
1067	Exhibit 1067 from April 1, 2025 Balakrishnan Deposition
1068	Exhibit 1068 from April 1, 2025 Balakrishnan Deposition
1069	Exhibit 1069 from April 1, 2025 Balakrishnan Deposition
1070	Email from Dr. Benjamin Bederson dated April 15, 2004
1071	Excerpts from PC World Magazine, Vol. 21, Num. 10, October 2003
1072	Deposition Transcript of Dr. Ravin Balakrishnan dated April 1, 2025
1073	Internet Archive Declaration

I. INTRODUCTION

The Response (Paper 20, the “POR”) filed by Maxell, Ltd. (“Maxell” or “PO”) is contrary to the ’815 patent, contrary to the references relied on in the challenges, contrary to its own expert’s deposition testimony, and contrary to plain common sense. The arguments in the POR, many of which are verbatim copies of POPR arguments that were preliminarily rejected in the Institution Decision (“ID”), should therefore be rejected, and all challenged claims should be found unpatentable.

II. ARGUMENT

A. Waived Arguments

As stated in the Board’s scheduling order, “any arguments not raised in the response may be deemed waived.” Paper 12 at 9. The POR makes no arguments for many limitations and claims. For example, the POR makes no arguments for any challenged claim limitations other than 1[b]/9[a], 1[c]/9[b], 1[g]/9[e], and 1[m]/9[k] for independent claims 1 and 9 of Ground 1 based on Horn and Baumgartner, and no arguments for dependent claims 2-6 and 10-13 of Ground 1. Similarly, Maxell makes no arguments for Ground 4 based on the combination of Kaplan and Bryant other than for limitations 1[b]/9[a], 1[c]/9[b], 1[g]/9[e], 1[l]/9[j], and 1[m]/9[k], and again makes no arguments for any dependent claim. The POR does not even address Ground 5. Maxell has waived arguments for the limitations and claims not addressed in the POR.

B. Claim Construction

Maxell requests that the Board reject its initial construction of the term “user profile” and instead adopt the district court’s construction of that term. POR, 6-8. The challenged claims are unpatentable under either construction as discussed in Sections II.C.3 and II.F.3.

C. Ground 1: Claims 1-6 and 9-13 Are Obvious Over Horn in View of Baumgartner

1. Motivation to Combine Horn and Baumgartner

Maxell argues that there is no motivation to combine Horn and Baumgartner, but the reasoning in support of its arguments is flawed and contrary to Horn and Baumgartner, and several of these same arguments - which are repeated nearly verbatim from the Maxell’s preliminary reply - were previously rejected in the ID. Paper 11 at 12.

a. Maxell’s Different Systems Argument Fails

First, Maxell repeats its POPR argument that there is no motivation to combine Horn and Baumgartner because Horn is directed toward a computer system whereas Baumgartner is directed toward a set top box. POPR at 32; POR at 9-10. This argument ignores Baumgartner’s teaching that his system may be implemented on a personal computer. EX1016, ¶[0082] and Fig. 5; Petition at 23-24 (citing same).

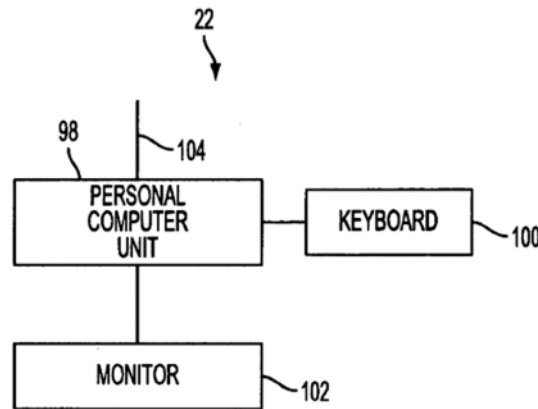


FIG. 5

Maxell also repeats the odd argument from its POPR that there is no motivation to combine because “Horn is directed to making ‘collections’ based on keywords in documents, and is not directed toward making any video-on-demand collections based on a user watch history.” POPR at 32; POR at 9-10, citing as support only the Balakrishnan Decl. (EX2040) ¶123 (which parrots this same bizarre argument without any support). Why the POR refers to keywords in **documents** is not clear, but it may be a reflection of Maxell’s flawed argument that Horn does not disclose video. Indeed, despite the clear citation to Horn’s disclosure of movies in the Petition (Petition at 23, citing Horn at 12:13), and despite the ID specifically relying on Horn’s disclosure of movies as a form of video to find motivation to combine (ID at 11), Dr. Balakrishnan’s declaration states that “Horn does not disclose ‘video information’” (EX2040, ¶¶153, 155); *see also* POR at 18 (“Horn does not even disclose receiving video”).

In any event, this argument is flawed and contrary to Horn and Baumgartner. Horn is not limited to organizing just documents, but instead organizes “all types of text and image information—from word processing documents and spreadsheets; to web pages and multimedia; to illustrations, images, *movies*, and photographs; to contacts, notes, and appointments; to sounds and music; *or anything else that is stored and retrieved on a computer.*” EX1005, 12:8-18 (emphasis added) (cited in Petition at 23). Baumgartner is not limited to selecting video-on-demand based on a user's watch history but instead also discloses selecting television content and video from a video recorder, and can organize this content based on a user profile, which can include data about a user including survey responses, demographic information, interests, and other information in addition to watch history. EX1016, ¶¶10, 57, 159. Thus, as discussed in the ID at 12, “Patent Owner has not supported that either reference is nonanalogous art, and therefore it is inapposite that they are different systems.”

b. Maxell's Wireless LAN Cost Argument Fails

Maxell next repeats its POPR argument that Petitioner has “failed to provide any rationale as to why a POSITA would substitute the hardwired LAN of Horn with the wireless modem of Baumgartner.” POR at 10; POPR at 33. In making this argument, Maxell focuses on the cost of electronic components but, as discussed in the ID, again wholly ignores the cost of running the wires necessary to support a

wired LAN. POR at 10; POPR at 33; ID (Paper 11) at 12. This argument is contrary to common sense. It is also contrary to the deposition testimony of Dr. Bederson, who testified that the cost of running wires to support wired LANs in environments such as homes would significantly outweigh the cost of electronic equipment needed for wireless LANs. EX2038, 44:14-48:7; 100:17-101:21.

Maxell's cost argument fails for this reason alone.

Maxell's cost argument is flawed for additional reasons. First, for the cost of the wireless LAN, Maxell includes the cost of a PC card *and* an access point (a.k.a., a wireless router), which allows multiple devices to connect to the network; but for the cost of a wired LAN, Maxell only includes the cost of a PC wired LAN card without any consideration of a device such as a switch that is necessary for multiple connections to the LAN and that according to Maxell costs "less than \$200." EX2025, 4. Second, the \$300 cost for the wireless LAN components, which is based on a January 2001 document EX2024 at 5, is too high. In November 2003, the cost of a Gateway 802.11g wireless router was \$100 and the cost of a Gateway 802.11g wireless notebook card was \$60. EX1071, 16 (excerpted):



In 2004, Dr. Bederson testified that he investigated a wireless network for a friend and found that a device that could serve as access point and laptop card was being sold for \$85. EX2038, 45:3-20; EX1070, 1. Thus, the cost differential between wired and wireless LANs was insignificant even without consideration of the cost of running wires for a wired LAN, which made the wireless LAN far less expensive.

c. Maxell's "Horn Is limited to Server-Based Systems" Argument Fails

Maxell then argues that "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." POR, 11. When a PO starts an argument by making assertions about "context," it is typically an indication that what follows is an attempt to improperly narrow an asserted patent or reference. Maxell's argument is no exception.

PO makes the following characterizations of Horn's system, none of which appear in Horn's specification:

- “a ***specialized, server-based computer*** running the Metadata Filing System (MFS), not ***just a general-purpose or personal computer***”
- “***designed for high-performance, data-intensive computing***”
- “a ***robust, server-based solution*** that is intended to handle ***large volumes of data***”
- “a server-based solution designed for ***large-scale data processing***,” emphasizes “handling ***vast*** amounts of structured data,”
- “align[s] with ***enterprise-level data management***, including aggregating data from multiple inputs, performing complex indexing operations, and providing structured data views”
- “supports ***high availability, scalability, and efficient handling of extensive data volumes . . .*** commonly associated with ***enterprise data centers***.”

POR, 11-12.

Notably, Maxell relies almost exclusively on its expert's declaration as support for all of these buzz-word filled “context”-based characterizations of Horn. But that declaration mostly just parrots the words of the POR without any citations to evidence or further explanation. EX2040, ¶¶126-131. In fact, the POR and

Maxell's expert cite only two portions of Horn as support for these allegations:

EX1005 at 6:59-63 and 3:10-17; EX2040, ¶¶127-128. Neither of these two passages provide support Maxell's "context"-based arguments that improperly attempt to limit Horn. The first passage at 6:59-63 states:

A network interface is coupled to the bus to provide an interface to the data communication network (LAN, WAN, and/or Internet) for exchange of data among the various local network users, site computers, routers, and other computing devices.

EX1001, 6:59-63. This passage says nothing about Horn's system being a "robust, server-based solution that is intended to handle large volumes of data" as alleged in the POR at 11. Indeed, at deposition, Maxell's expert Dr. Balakrishnan admitted that this description also applies to the laptop in Fig. 1 of Horn. EX1072, 9:8-24:4.

The second passage at 3:10-17 states:

Accordingly, there is a long felt need in the art to provide a truly open computer system having data structures, input interfaces, displays and operational systems that permits the organization of information, as data objects, in a wide variety of files and databases, which computer system is independent of the source of the information objects, is dynamic and automatic, permitting faster archiving, retrieval and viewing of the information and providing more meaningful and useful links for better organization and indexing of the information.

This passage again does not say that Horn's system cannot be "a simple general-purpose computer but a dedicated server architecture" as alleged in the POR at 12.

Maxell's "context"-based arguments are also flatly contrary to Horn. Horn's Fig. 1 illustrates a laptop computer on which the MFS/Metadata Filing System runs:

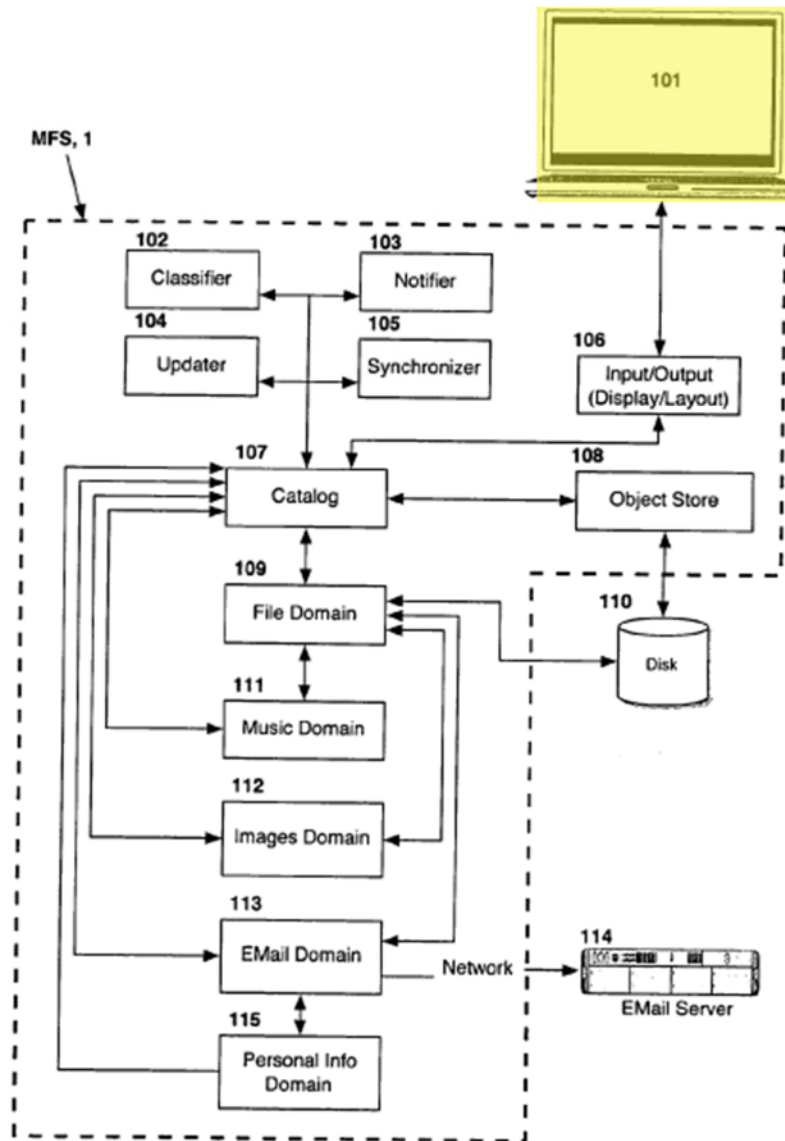


Figure 1

EX1005, Fig. 1; *see also* EX1072, 32:4-34:4. Consistent with Fig. 1's illustration of a laptop personal computer running the MFS, Horn further discloses:

The inventive system is remarkably robust, yet is a relatively small application program that can function with any type of Operating System: Microsoft Windows, Windows NT, Windows 2000, and Windows XP; Apple Macintosh OS 9 and OSX; BSD Unix, HP-UX, Sun Solaris, Linux, and the like. Currently the inventive technology is preferably implemented in its current best mode in a form that is executable on the Apple Macintosh OS9 and OSX operating systems.

EX1005, 37:27-35; *see also* EX1072 at 26:11-29:7 (admitting that the Apple Macintosh that ran OS9 was a personal computer). Thus, while Horn did include embodiments that ran on servers (EX1005, 5:51-60), it was not so limited, and the preferred embodiment ran on a personal computer such as the laptop shown in Fig. 1. Accordingly, Maxell's argument that there is no motivation to combine Horn with Baumgartner because Horn is limited to an enterprise level server-based system (POR at 11-12) fails. Maxell's attempt to discredit Petitioner's argument that a POSITA would have been motivated to modify Horn's system to use a wireless LAN to increase a user's mobility because Horn is server-based (POR, 17) also fails for the same reason.

d. Maxell's Network Speed and Security Arguments Fail

Maxell argues that Horn's system requires "low-latency, high-speed communication" and "data integrity and security are paramount," which purportedly make wireless LANs unsuitable for Horn's system. POR, 13 and 15.

However, these assertions are all premised on Maxell's assertion that Horn is limited to enterprise-level server-based systems. That assertion is false for the reasons discussed above, and therefore Maxell's arguments that are based on this assertion all fail.

* * *

For all of the reasons discussed above, Maxell has failed to demonstrate any flaw the Board's preliminary determination that the "Petitioner has identified sufficient reason that skilled artisans would have made the [Horn-Baumgartner] combination. ID, 12-13.

2. The Combination of Horn and Baumgartner Discloses Limitations 1[b] and 9[a]

PO largely repeats its POPR argument that the combination of Horn and Baumgartner fails to disclose a recording medium on which a plurality of video information including first video information is stored wirelessly as recited in limitations 1[b] and 9[a]. POPR at 37-40; POR at 18-21. This argument fails for the same reasons stated in the ID at 13-14.

First, Maxell's arguments address Horn and Baumgartner individually rather than addressing their combination. This is improper. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) ("Nonobviousness cannot be established by attacking the references individually where the rejection is based upon the teachings of a

combination of references.”); *see also In re Keller*, 642 F.2d 413, 425 (CCPA 1981); ID, 13.

Second, the POR argues that Horn does not disclose receiving videos, which according to Maxell “take up too much storage.” POR, 18. This argument again ignores Horn’s disclosure at Horn at 12:13 of movies, as discussed above.

Third, Maxell again argues that a POSITA would not be motivated to combine Baumgartner’s disclosure of a wireless LAN with Horn, again relying on its cost argument. This argument fails for all of the reasons discussed above.

Fourth, Maxell argues that “another information processing apparatus” in limitations 1[b] and 9[c] must be limited to “another PC.” POR at 19-20. This argument represents a fundamental misunderstanding of claim construction law. More particularly, Maxell argues that “another information processing apparatus” must be limited to a PC because Petitioner mapped “the information processing apparatus” recited in the preambles of claims 1 and 9 to the PC of the Horn-Baumgartner combination, and because the same claim terms should be given the same meaning in different portions of the claims.

The flaw in Maxell’s argument is obvious: the plain language of “the information processing apparatus” and “another information processing apparatus” are both broad terms that do mean the same thing (an apparatus that processes information), but nothing in the claim or the specification requires the “another

information processing apparatus” to be the same as “the information processing apparatus.” For example, nothing in the specification discloses or suggests that the “another information processing apparatus” of claim 1 must correspond to the device of Fig. 3 when that device is the claimed “information processing apparatus,” and it is highly unlikely that this would be the case given the structure of the device of Fig. 3. The fact that Petitioners have mapped a particular species (i.e., a PC) to the generic “the information processing apparatus” of claims 1 and 9 does not alter the broad scope of this generic limitation. The Petition’s mapping of Horn’s “site computer” (i.e., a server) (Pet. at 32) as the claimed “another information processing apparatus,” is consistent with this broad plain meaning, as is the mapping to Baumgartner’s television distribution facility 14 which includes a server 56 that is also “another information processing apparatus.”

For all of the reasons discussed above, the combination of Horn and Baumgartner discloses limitations 1[b] and 9[c], and Maxell has failed to demonstrate any error in the ID’s preliminary conclusion.

3. The Combination of Horn and Baumgartner Discloses Limitations 1[c] and 9[b]

As discussed in the Petition at 33, Horn discloses that its system “provide[s] information management tools that facilitate communication to generate, transmit and receive, archive, search, order, retrieve and render objects, *including information organization personalized for each individual user based on*

preferences selected by the user.” EX1005, 6:11-22 (emphasis added in Petition).

The Petition further cites Horn at 8:58-67, which provides that “[u]sers can select predetermined collections provided in a basic menu such as Family, Friends, Work, To Do, Activities and Vacation when running the MFS program for the first time.” Petition, 33. These citations clearly indicate that Horn’s MFS system collections and other settings are particular to users. This is further indicated by Horn’s disclosure that its MFS provides PIM (Personal Information Management) domain functionality “that provides a new feature: the ability to organize information object *by person* and by project.” EX1005 at 37:66-38:3 (emphasis added). The settings that allow such individual user personalization are clearly a user profile under the Board’s construction of that term as “data representing a user’s distinctive features or characteristics” because collections of content corresponding to a user’s “ Family, Friends, Work, To Do, Activities and Vacation” is data representing a user’s distinctive features or characteristics (e.g., one user’s To Do list will be different from another user’s). These settings also qualify as a user profile under Maxell’s proposed construction of “ a collection of settings and information associated with a user.”

Even if the above disclosures of Horn were insufficient for this limitation, the Petition also relied on disclosures in Baumgartner (Petition at 34). The POR does not address these disclosures other than to assert that a POSITA would not be

motivated to combine Baumgartner with Horn (POR, 22), which is incorrect for the reasons discussed above. Maxell has therefore waived any argument that the combination of Horn and Baumgartner discloses limitations 1[c] and 9[b].

4. The Combination of Horn and Baumgartner Discloses Limitations 1[g] and 9[e]

Maxell's argument for this limitation rests on two flawed assertions that "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." POR, 23. The first assertion is false because Horn discloses "movies," which are a form of video. Petition at 23, citing Horn at 12:13; *see also* ID at 11. The second assertion is wrong for the reasons discussed above in Section II.C.2.

5. The Combination of Horn and Baumgartner Discloses Limitations 1[m] and 9[k]

Maxell's arguments regarding these limitations again rest on the two false assertions that "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." POR, 24. Both are wrong for the reasons discussed in the preceding Section II.C.4.

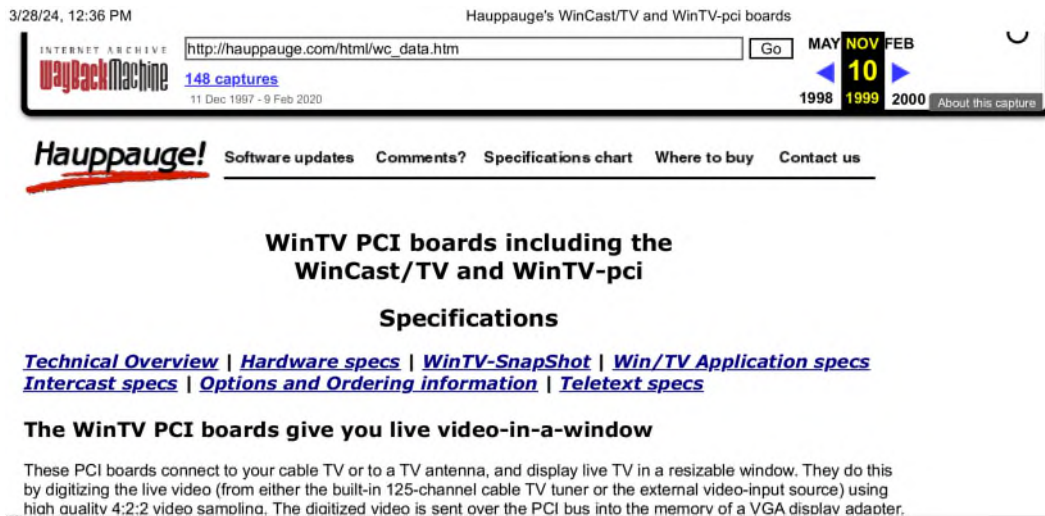
**D. Ground 2: Claims 7, 8, 14 and 15 Are Obvious Over
Horn in View of Baumgartner and WinTV**

1. WinTV Was Published

a. The WinTV Product Was On Sale in the U.S. in 1999

Maxell asserts that the WinTV reference – EX1010, the WinTV Installation and Reference Manual dated June 30, 1999 – was not prior art because (1) there is insufficient evidence to establish that WinTV products with which the WinTV reference was distributed were on sale in the United States, and (2) WinTV was not publicly accessible because Maxell's expert was not able to navigate to the WinTV manual from the hauppauge.com home page, and thus the WinTV manual was only accessible by the Hauppauge employees who created it. POR, 26-30. Both assertions are flawed.

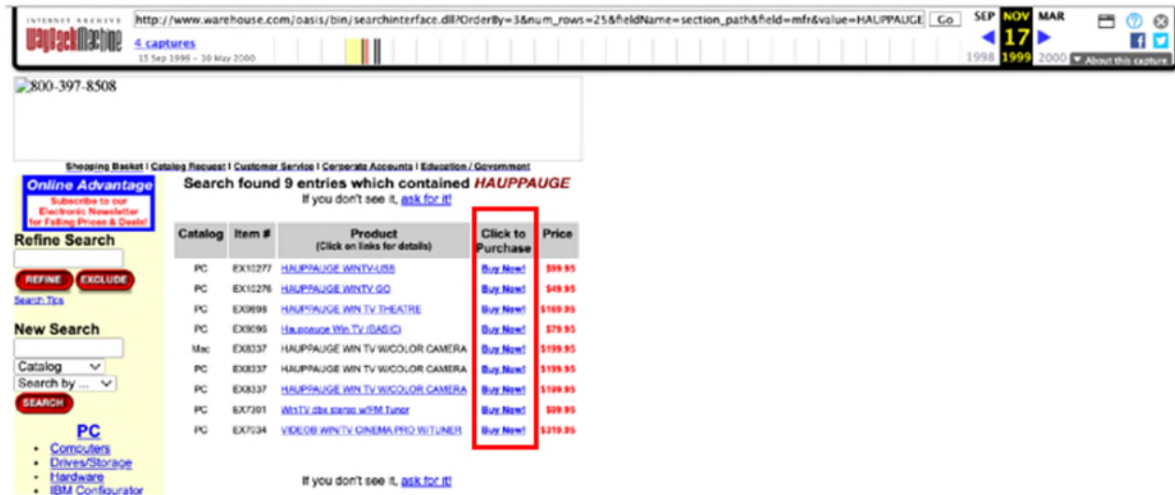
Product manuals for products such as the WinTV manual for the WinTV products that were on sale qualify as publications. *Weber, Inc. v. Provisur Techs., Inc.*, 92 F.4th 1059, 1068-69 (Fed. Cir. 2024). The POPR argued that EX1011 was insufficient to demonstrate that the WinTV products with which the WinTV manual was distributed were on sale in the U.S. in 1999 because EX1011 was unauthenticated. As shown in the excerpt below EX1011 is an archived web page from the Internet Archive's Wayback Machine dated November 10, 1999 showing the WinTV-PCI product corresponding to the WinTV manual (EX1011, 1):



The Board may take judicial notice of Internet Archive-captured web pages.

Valve Corp. v. Ironburg Inventions Ltd., 8 F.4th 1364, 1374 (Fed. Cir. 2021). Thus, EX1011 alone is sufficient to establish that the WinTV-PCI product was on sale in the U.S. in 1999, and thus the WinTV manual was published in 1999.

Moreover, pursuant to the suggestion in the ID at 17, Petitioner filed a Motion to Submit Supplemental Information (Paper 15) including an authenticated version of EX1011 (EX1057, 1-7) as well as additional Internet Archive web pages such as the one excerpted below that further demonstrate that the Win TV-PCI product corresponding to the WinTV manual was on sale in the U.S. as of 1999:



EX1057, 11. Thus, the WinTV manual was published via distribution with the WinTV products that were on sale in 1999. *Weber*, 92 F.4th at 1068-69.

b. WinTV Was Published Via the Hauppauge Website

As established in the Petition at 6-7 and further supported by references to the WinTV products in various U.S. patent documents including EX1037, 2:6-8; EX1038, 3:51-55, EX1051, 5:31-32; 11:28-31, EX1052, 7:56-59 and EX1053, ¶96, a POSITA would have been aware of the WinTV products and would have known to look to the hauppauge.com website for information regarding those products. Maxell's assertion that WinTV was not accessible to the public via that website because it was not possible to navigate from the hauppauge.com home page to the page from which the WinTV manual could be downloaded was proven false by Maxell's expert during deposition. In fact, Dr. Balakrishnan was able to navigate from the archived version of that home page to the page from which the

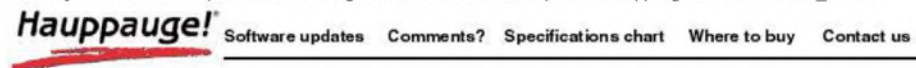
WinTV manual could be downloaded *in just 3 clicks*, then downloaded what he confirmed was an identical copy of the WinTV manual. EX1072, 48:5-65:7.

Dr. Balakrishnan started at the archived hauppauge.com home page excerpted below (EX1065, yellow highlighting added). That page indicates that technical notes on the Hauppauge products were available by clicking on the Product Support and Software Updates button.



Clicking on the Software Update button (first click) took Dr. Balakrishnan to the Product Support and Software Updated page shown below (EX1066, annotations added):

The Wayback Machine - https://web.archive.org/web/20030801080926/http://www.hauppauge.com:80/html/free_sw.htm



Product Support and Software Updates

Click [here](#) for the **Product Support site**
(maintained by Hauppauge's technical support department)

See below for a list of software updates for Hauppauge Products

WinTV-PCI boards including the WinTV-GO, Theater, and DBX Product selector for software updates and utilities	WinTV-USB Software updates and utilities Frequently asked questions QuickInstall manual (PDF) WinTV-USB manual v4.8(PDF)	WinTV-HD High Definition TV receiver software updates QuickInstall manual (PDF)
WinTV-PVR Products Software Updates product selector WinTV-PVR Manual in PDF form		
WinTV-CinemaPro software updates	WinTV-D Installation software for Windows 98, NT, ME, 2000 and XP	VTplus Teletext Software

[Home](#) [Back to Home Page](#)

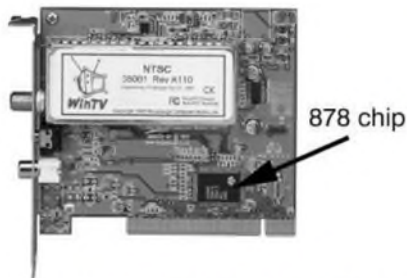
From that page, Dr. Balakrishnan clicked on the highlighted link in the WinTV-PCI boards cell of the product selector table (second click), which brought him to the “WinTV PCI boards” product selector page excerpted below (EX1067, yellow highlighting added):

WinTV PCI boards

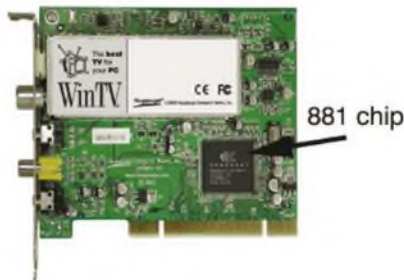
Software Update product selector page

Note: It is important that you chose the right WinTV pci board before you download and install a driver update.

Chose your WinTV PCI board, and you will be taken to the page which has software updates. Click [here](#) to download [ProdInfo](#). When you run ProdInfo, the first line will tell you which WinTV pci Model number you have.

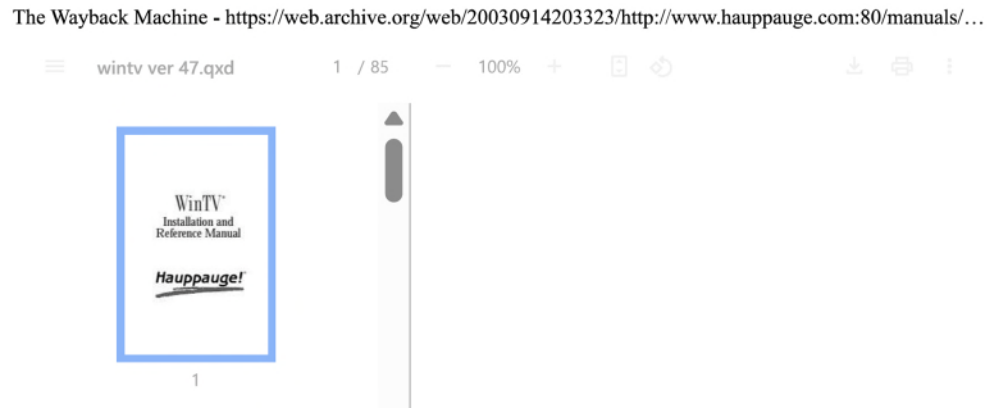


WinTV 878 or 848 based PCI boards or Impact VCB's
[Software updates and utilities page](#)
[Frequently asked questions](#)
[Installation manual \(PDF\)](#)



WinTV 881 based PCI boards
[Software updates and utilities page](#)
[QuickInstall manual \(PDF\)](#)

From that page, Dr. Balakrishnan clicked on the highlighted link for the Installation manual for the first product shown on the left (third click), which took him to the page from which WinTV could be viewed and downloaded (EX 1068) as shown below:



Dr. Balakrishnan then downloaded this manual and confirmed it was identical to EX1010. EX1072, 67:16-68:10. Authenticated copies of these pages are submitted herewith as EX1073. WinTV was therefore published via the hauppauge.com website as of September 2003.

2. There is Ample Evidence of Motivation to Combine WinTV with Horn and Baumgartner

As discussed in the Petition at 54-55, Horn's disclosure of videos in the form of movies and Baumgartner's teaching of the desirability of including a TV tuner card such as the WinTV PCI product in its PC embodiments (EX1016, ¶83) provide strong motivation to combine WinTV with Horn and Baumgartner. Maxell's arguments to the contrary are based on (1) the false assertion that WinTV was not

publicly accessible, (2) that Horn and WinTV are different systems and the false assertion that Horn is “directed toward making ‘collections’ based on keywords in documents, and is not directed to receiving, playing and recording video,” and (3) improperly attacking Horn and Baumgartner individually. POR, 30-31.

E. Ground 3: Claims 1-15 are Obvious Over Horn in View of Baumgartner, WinTV and Chao

The Petition asserts that a POSITA would have found it obvious to modify the Horn-Baumgartner-WinTV combination by adding thumbnails to represent folders of content data (as opposed to individual items in a folder) as taught by Chao given that Horn already discloses the use of thumbnails for individual items in a folder. Indeed, doing so improves the user interface by allowing easy navigation between folders, and involves no more than applying a known technique to a known device that is ready for improvement to yield predictable results. Pet. 60-65. This rationale belies Maxell's argument that the Petition fails to explain motivation. Maxell's POR arguments about (1) Horn teaching away from further complexity, (2) the “failure” to explain how to “access or modify” Horn's OS to use thumbnails, and (3) the alleged incompatibility between the Horn “OS architecture” and the Chao “thumbnail-based system” are likewise belied by the fact that Horn already uses thumbnails for individual items as discussed in the Petition at 61 (citing EX1003, ¶210), and are improper “bodily incorporation” arguments.

F. Ground 4: Claims 1-15 are Obvious Over Kaplan and Bryant

1. Motivation to Combine

The POR repeats nearly verbatim the arguments from the POPR on motivation to combine. POR, 35-43; POPR, 48-56. The ID rejected those arguments, determining that the Petition's showing of a motivation to combine at 66-68 was sufficient. "We view the combination as adequately stated, and determine at this stage that the reasons justify the combination." ID at 26. The ID further noted that "[s]hould Patent Owner believe that Petitioner has not justified an aspect of the combination asserted against a particular limitation, we will address such arguments made during trial." *Id.* Given that the POR merely repeats the same POPR arguments that were previously rejected rather than raising any new issues, Maxell has waived any argument concerning motivation for the Kaplan-Bryant combination.

2. The Kaplan-Bryant Combination Discloses Limitations 1[b] and 9[a]

The POR repeats verbatim the arguments from the POPR on limitations 1[b] and 9[a]. POR, 43-44; POPR, 56-57. The ID rejected those arguments, noting that Maxell did not address the Petition's assertion that "common knowledge beyond Kaplan and Bryant additionally informed skilled artisans such that using a wireless rather than wired network would have been obvious." ID, 27. By again failing to

address that argument in the POR, Maxell has waived any argument to the contrary regarding limitations 1[b] and 9[a].

3. The Kaplan-Bryant Combination Discloses Limitations 1[c] and 9[b]

These limitations require that “at least some of the plurality of video information is associated with a user profile.” As explained in the Petition at 74, “Bryant discloses associating ‘affective information’ with digital motion images, which is ‘information that relates to the feelings or emotions of a person toward images.’ EX1015, ¶30.” Bryant further discloses:

Different users can have different emotional reactions to the same image. Therefore, to be most useful, ***affective information relating to images should be associated with a particular user***, if the images are to be shared with various users. In some embodiments, ***this is accomplished by associating a user identifier with the affective information***. The user identifier can be any type of information that helps enable a particular user to be identified. For example, the user identifier can be a personal identification code such as a globally unique ID (GUID), a user number, a Social Security number, a camera serial number, or the like. The user identifier can also be a complete legal name, a nick name, a computer user name, or the like.

Petition at 74, citing EX1015, ¶32 (emphasis added). In the face of this explicit disclosure, Maxell argues that “feelings and emotions information is not a ‘collection of settings and information associated with a user’” and “Bryant’s

disclosure of 'affective information' about images does not meet the user profile limitation." POR, 44. However, Maxell does not explain these statements, nor shows why feelings and emotions information are not a "collection of settings and information associated with a user" as required under Maxell's construction, or "data representing a user's distinctive features or characteristics" as required under the Board's construction. Without such an explanation, this argument fails.

4. The Kaplan-Bryant Combination Discloses Limitations 1[g] and 9[e]

The POR repeats nearly verbatim the arguments from the POPR on limitations 1[g] and 9[e], including the argument that "paragraph 44 of Kaplan doesn't refer to button 28." POR, 45; POPR, 58-59. The ID rejected all of Maxell's POPR arguments. ID, 28-29

With respect to the argument that paragraph 44 of Kaplan doesn't refer to button 28," the Petition referred to both buttons 26 and 28 as corresponding to containers that are both configured to allow a user to edit, and then went on to give as an example a "FILE function which can include marking a video as a favorite" and cited EX1014, ¶44 in support. Petition, 77. ¶44 of EX1014 does in fact discuss "copy a multimedia file into one of the Favorites 26 containers 48." And the ID specifically noted that "Kaplan discloses that History 28 is a primary option button." ID, 28 (citing EX1014, ¶46).

With respect to the argument that “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], the ID noted that:

Patent Owner does not elaborate, and does not take issue with Petitioner's proposed construction for “video information,” which allows for “audio-visual data (e.g., a video such as a recording of a TV program) or information referring to a storage location of such audio-visual data (e.g., a pointer to the audio-visual data), as well as information constituting or specifying a group of audio-visual data (e.g., a playlist).” Pet. 18–19 (citing Ex. 1001, 1:63–2:27, 3:55–4:13). Without explanation, ***we do not understand and cannot address*** Patent Owner's asserted dispute.

ID, 28-29 (emphasis added). By failing to explain its argument in the POR as to why Kaplan's Favorites and History containers are not video information in the form of playlists that satisfy these limitations, Maxell has waived this argument for limitations 1[g] and 9[e].

5. The Kaplan-Bryant Combination Discloses Limitations 1[l] and 9[j]

The POR repeats nearly verbatim the substantive arguments from the POPR on limitations 1[l] and 9[j]. POR, 45-46; POPR, 59-60. The ID rejected those arguments, finding that the disclosures of both Kaplan and Bryant identified in the Petition at 81-82 (citing EX1014 ¶44) and 83-86 (citing EX1015, ¶¶82–87, 89–106

and Figs. 9A-9C) disclose this limitation. ID, 30. By again failing to address that argument in the POR, Maxell has waived any substantive argument to the contrary regarding limitations 1[l] and 9[j].

The POR also disputes the application of collateral estoppel to these limitations. POR, 46-48. As discussed in the Petition at 80-81, a prior Board final written decision in *Fandango Media, LLC v. Maxell, Ltd.*, IPR2018-01432, Paper 32 (PTAB Feb. 10, 2020) held that a substantively identical limitation was taught by Bryant alone and by the combination of Kaplan and Bryant. EX1009, 31-36. The POR's argument on the collateral estoppel issue is nearly identical to its POPR arguments (POPR, 60-62). The principal argument raised by Maxell is that the prior IPR was decided under a BRI construction whereas this IPR applies the federal court claim construction standard, and "[a]s such, the Board should reject Petitioner's collateral estoppel argument." POR, 47-48. However, as noted in the ID, "[t]hat may be so, but Patent Owner has not raised a claim-construction issue here regarding limitation 1[l]." ID, 30. The quotation from the *Skyhawk* case upon which Maxell relies (POR, 48) is *dicta* and is clearly distinguishable because the dispute in that case centered on the correct claim construction, whereas here the disputed issue is whether or not Bryant and Kaplan disclose or render obvious limitations 1[l] and 9[j]. Maxell has failed to show how the claim construction resulting from the application of these different standards would have any impact

on this disputed issue. In particular, Maxell has failed to demonstrate that the construction of limitations 1[l] and 9[j] are different under the different claim construction standards. By failing to demonstrate such a difference, Maxell has failed to show that the relevant issue – whether or not Bryant and Kaplan disclose or render obvious limitations 1[l] and 9[j] – has not actually been litigated. It has.

Maxell makes a last-gasp attempt to avoid the application of estoppel by pointing to additional limitations and arguing that “when considered as a whole, the issue of patentability are not identical when considering the claim language as a whole.” POR, 48. This attempt fails because Maxell does not explain how the claim language “as a whole” has any impact on the issue of whether Bryant and Kaplan disclose or render obvious limitations 1[l] and 9[j], which again are substantively identical to the limitations that the Board has already determined are rendered obvious by Kaplan and Bryant. Collateral estoppel thus applies and Maxell's arguments regarding limitations 1[l] and 9[j] fail.

6. The Kaplan-Bryant Combination Discloses Limitations 1[m] and 9[k]

The POR repeats verbatim the arguments from the POPR on limitations 1[m] and 9[k]. POR, 49; POPR, 62-63. The ID rejected those arguments, noting that Maxell did not address the Petition's assertion that “common knowledge beyond Kaplan and Bryant additionally informed skilled artisans such that using a wireless rather than wired network would have been obvious.” ID, 27. By again

failing to address that argument in the POR, Maxell has waived any argument to the contrary regarding limitations 1[m] and 9[k].

III. CONCLUSION

Claims 1-16 are unpatentable for all of the reasons discussed above and in the Petition.

Date: April 25, 2025

Respectfully submitted,

/s/ James M. Heintz

Reg. No. 41828

DLA Piper LLP

One Fountain Square

11911 Freedom Drive, Suite 300

Reston, VA 20190-5602

Phone: + 1 703 773 4000

Fax: + 1 703 773 5000

Jim.heintz@us.dlapiper.com

Attorney for Petitioners

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(c) and (d), Petitioner certifies that the word count of Petitioner's Reply to Patent Owner's Response to Petition for *Inter Partes* Review of U.S. Patent No. 11,017,815 (exclusive of any table of contents, table of authorities, certificates of service and word count, and list of exhibits or claim listing) as measured by Microsoft Word is 5,390 words, which is less than the 5,600 allowed under 37 C.F.R. § 42.24.

Date: April 25, 2025

/s/ James M. Heintz

James M. Heintz

Reg. No. 41,828

DLA Piper LLP

One Fountain Square

11911 Freedom Drive, Suite 300

Reston, VA 20190-5602

Phone: + 1 703 773 4000

Fax: + 1 703 773 5000

jim.heintz@us.dlapiper.com

Attorney for Petitioners

CERTIFICATE OF SERVICE

The undersigned certifies service pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b) on the Patent Owner by Electronic Mail of this Petitioner's Reply to Patent Owner's Response to Petition for *Inter Partes* Review of U.S. Patent No. 11,017,815.

Robert G. Pluta
(PTO Reg. 50,970)
MAYER BROWN, LLP
71 S. Wacker Drive
Chicago, IL 60606
Telephone: (312) 701-8641
Fax: (312) 706-8144
rpluta@mayerbrown.com

Saqib J. Siddiqui
(PTO Reg. 68,626)
MAYER BROWN LLP
1999 K Street NW
Washington DC, 20006
ssiddiqui@mayerbrown.com

Respectfully submitted,

/s/ James M. Heintz