

**IN THE 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'S SUR-REPLY

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 C ONTENTS

I.	INTRODUCTION	1
II.	WAIVED ARGUMENTS	1
III.	CLAIM CONSTRUCTION	2
IV.	GROUND 1: PETITIONER HAS FAILED TO ESTABLISH THAT CLAIMS 1–6 AND 9–13 ARE RENDERED OBVIOUS BY HORN IN VIEW OF BAUMGARTNER.....	2
A.	No Motivation to Combine Horn with Baumgartner	2
1.	The Two Systems Address Fundamentally Different Problems.....	2
2.	Petitioner's Arguments on Wireless LAN are Conclusory and Unsupported	3
3.	Petitioner Mischaracterizes the Horn System to Fit Its Narrative.....	4
4.	Petitioner Ignores the Security Imperatives of Horn's System.....	5
B.	The Combination of Horn and Baumgartner Fails to Disclose Limitations 1[b] and 9[a].....	6
C.	The Combination of Horn and Baumgartner Fails to Disclose Limitation 1[c] and 9[b]	8
D.	The Combination of Horn and Baumgartner Fails to Disclose Limitations 1[g] and 9[e].....	10
E.	The Combination of Horn and Baumgartner Fails to Disclose Limitations 1[m] and 9[k]	10
V.	GROUND 2: PETITIONER FAILS TO ESTABLISH THAT CLAIMS 7, 8, 14 AND 15 ARE RENDERED OBVIOUS BY HORN IN VIEW OF BAUMGARTNER AND WINTV	11
A.	Petitioner Has Not Provided Sufficient Evidence that WinTV was Publicly Accessible	11
B.	No Motivation to Combine WinTV with Horn and Baumgartner	13

VI.	GROUND 3: PETITIONER FAILS TO ESTABLISH THAT CLAIMS 1-15 ARE RENDERED OBVIOUS BY HORN IN VIEW OF BAUMGARTNER, WINTV, AND CHAO.....	15
VII.	GROUND 4: PETITIONER FAILS TO ESTABLISH THAT CLAIMS 1-15 ARE RENDERED OBVIOUS OVER KAPLAN AND BRYANT	17
A.	Petitioner Fails to Establish Obviousness for Limitations 1[b] and 9[a].....	18
B.	Petitioner Fails to Establish Obviousness for Limitations 1[c] and 9[b].....	19
C.	Petitioner Fails to Establish Obviousness for Limitations 1[g] and 9[e].....	20
D.	Petitioner Fails to Establish Obviousness for Limitations 1[l] and 9[j].....	21
E.	Petitioner Fails to Establish Obviousness for Limitations 1[m] and 9[k].....	23
VIII.	CONCLUSION.....	24

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-andwireless-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

Petitioner's reply fails to meaningfully rebut any of Patent Owner's arguments presented in its Patent Owner Response and offers no sound argument that its references invalidate U.S. Patent No. 11,017,815 under a proper reading of the claims.

II. WAIVED ARGUMENTS

Petitioner's broad waiver argument is unfounded. Patent Owner has consistently challenged the sufficiency of Petitioner's showing for each of the asserted grounds. For Ground 1 and Ground 4, Patent Owner's POR specifically identified multiple limitations—1[b]/9[a], 1[c]/9[b], 1[g]/9[e], 1[l]/9[j], and 1[m]/9[k]—for which Petitioner failed to meet its burden of proof. These are claim-critical limitations that apply equally to both independent and dependent claims; by failing to show that these limitations are met, Petitioner necessarily fails to establish unpatentability for the dependent claims (2-6 and 10-13) as well. *See* POR, 8. Patent Owner was not required to repeat its arguments for every dependent claim where the asserted combination already fails to disclose required limitations of the independent claims.

With respect to Ground 5, Petitioner's waiver argument is incorrect. Patent Owner did not waive its arguments regarding Ground 5; rather, as stated in the POR and reiterated in this Sur-reply, Patent Owner expressly argued that Ground 5 fails

for the same reasons that the Kaplan-Bryant combination in Ground 4 fails to disclose key limitations of the claims. *See* POR, 35–49. In addition, as further explained in the POR (25–30) and this Sur-reply, WinTV is not prior art to the '815 Patent, and thus cannot be relied upon to remedy the deficiencies in the Kaplan-Bryant combination.

III. CLAIM CONSTRUCTION

Petitioner offers no arguments to rebut Patent Owner's proposed construction of the term "user profile(s)". Reply, 2. Thus, for the reasons explained in the POR, the term "user profile(s)" does not require an alternative or ambiguous interpretation different than that adopted by the District Court. POR, 6–8.

IV. GROUND 1: PETITIONER HAS FAILED TO ESTABLISH THAT CLAIMS 1–6 AND 9–13 ARE RENDERED OBVIOUS BY HORN IN VIEW OF BAUMGARTNER

A. No Motivation to Combine Horn with Baumgartner

Petitioner's reply fails to cure the evidentiary and analytical defects in its initial assertion that a POSITA would have been motivated to combine Horn and Baumgartner.

1. The Two Systems Address Fundamentally Different Problems

Petitioner attempts to downplay the substantial differences between Horn and Baumgartner by citing a single paragraph from Baumgartner (¶82) that generically states the system "may be implemented on a personal computer." Reply, 2. This

isolated statement does not overcome the fundamental distinction between the file organization and data management focus of Horn and the interactive video-on-demand set-top box environment of Baumgartner. As explained in the POR (9–10) and supported by Dr. Balakrishnan (EX2040 ¶123), the purposes and architectures of these systems diverge significantly.

Horn is explicitly directed to organizing and indexing diverse data types in a structured and efficient manner, for purposes such as faster retrieval and dynamic data linking. EX1005, 3:10–22. This point was confirmed by Dr. Balakrishnan in his deposition, where he explained that Horn describes “a server architecture doing automatic organization, indexing, and retrieval of data from multiple sources.” See EX1072 at 24:13–25:4. In contrast, Baumgartner deals with delivering user-selected video content via profiles and set-top boxes—an application-specific, media delivery solution, not a general-purpose data management platform. Petitioner's reference to multimedia in Horn (EX1005, 12:8–18) is too broad to establish a meaningful connection to Baumgartner's system, and in any event, Horn makes no mention of content delivery or user-profile-based video selection akin to Baumgartner.

2. Petitioner's Arguments on Wireless LAN are Conclusory and Unsupported

Petitioner's reply merely reiterates its original position that a POSITA would prefer wireless LANs over wired LANs due to cost and convenience, citing

anecdotal prices and general “common sense.” Reply, 4–5. But as detailed in the POR (10–13) and supported by Dr. Balakrishnan (EX2040, ¶124), this view ignores the actual technological context of Horn’s system and the state of networking technology in 2004.

While Petitioner emphasizes the cost of running wires, it fails to grapple with the clear technical drawbacks of wireless LANs at the time—lower bandwidth, higher latency, and greater security vulnerabilities. Dr. Bederson conceded that “faster communication speeds probably would help” achieve Horn’s goal of faster archiving and retrieval (EX2038, 51:22–52:8), supporting the conclusion that a wired LAN is better suited for Horn’s performance needs. Petitioner also ignores the cost data showing wireless solutions were not meaningfully cheaper than wired options at the time (EX2024–2025; EX2040 ¶124).

Nor do the Gateway advertisements (EXS1070-1071) establish that wireless LANs were viable substitutes in the high-throughput, enterprise-level computing context relevant to Horn. In particular, Petitioner’s reliance on a 2004 email from its expert, Dr. Bederson (EX1070), is both misplaced and improper. The email is hearsay, lacks any technical analysis, and offers no reliable evidence of the suitability of wireless networks for Horn’s disclosed architecture.

3. Petitioner Mischaracterizes Horn to Fit Its Narrative

Petitioner’s assertion that Horn merely runs on a laptop or general-purpose

PC (Reply, 9) ignores the broader system context that a POSITA would have appreciated. The presence of a laptop in Figure 1 does not negate the server-based design and functionality of Horn's Metadata Filing System (MFS), which is described as robust, scalable, and intended for data aggregation, indexing, and retrieval across networked environments. *See* EX1005, 3:10–17, 6:59–63.

Dr. Balakrishnan's characterization of Horn as a server-based system is rooted in this disclosure and reflects the realities of high-performance data management in the early 2000s. *See* EX2040 ¶127. Petitioner criticizes the use of terms like “enterprise-level” and “scalable” (Reply, 7), but fails to address the actual technical limitations of wireless LANs in server environments, including the risk of packet loss, interference, and unstable throughput—all of which would undermine Horn's goals of fast and secure data access.

The fact that MFS could run on multiple operating systems, including those used on personal computers, does not mean the intended use case was a low-complexity, single-user environment. *See* EX2040 ¶127. The ability to run on diverse platforms reflects software portability—not suitability for replacing wired, high-performance networks with wireless alternatives. *See id.*

4. Petitioner Ignores the Security Imperatives of Horn's System

Petitioner's reply entirely fails to rebut the security-based motivation against adopting wireless LANs in Horn's system. As discussed in the POR (at 15–16), Horn

explicitly discloses that its system stores user data and hosts internet pages (EX1005, 5:47–60), raising critical concerns about data integrity and unauthorized access. Even Dr. Bederson acknowledged that a POSITA in 2004 would be aware of such security risks (EX2038, 52:9–53:4). Petitioner does not point to any disclosures in Horn or Baumgartner suggesting that wireless networks, which were widely recognized as less secure in that era, would be appropriate for this type of system.

Petitioner's reply fails to offer a credible, technically grounded reason why a POSITA would have been motivated to combine Horn and Baumgartner. The two systems solve different problems using different architectures, and the proposed combination would have introduced performance, security, and design drawbacks that a POSITA would have recognized and avoided.

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

Petitioner acknowledges that Horn does not expressly disclose receiving video wirelessly (Reply, 12)—indeed, it does not disclose receiving video at all. EX2040 ¶142. Horn's system focuses on organizing files, music, and images (EX1005, 12:5–7), not on handling streaming or downloaded video content. While Petitioner now points to a generic mention of “movies” in Horn (EX1005, 12:13), this isolated term does not equate to a disclosure of receiving encrypted video content wirelessly from an external device, as the claims require. Petitioner offers no evidence that Horn

handles such transmissions—wireless or otherwise—and the reference's consistent emphasis on space-efficient data organization undermines any suggestion that high-bandwidth video data was contemplated. *See* EX2040 ¶142.

Petitioner's reliance on *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) is misplaced. Reply, 11. The principle that references should be considered in combination does not absolve a Petitioner from articulating a specific reasoned rationale for why a POSITA would have made the claimed combination with a reasonable expectation of success. Here, Petitioner fails to establish a credible reason why a POSITA would integrate Baumgartner's wireless video delivery system into Horn's file-based organizational framework—a framework not even configured for video transmission. The conclusory assertion that combining the two would be “obvious” because of general LAN substitutability ignores the technical, functional, and architectural incompatibilities between the systems. *See* EX2040 ¶¶123-124, 141-143.

Moreover, Petitioner's reply again leans on the wireless LAN cost argument, which fails for the reasons already addressed above. *See* Reply, 12. Petitioner does not meaningfully contest that in the early 2000s, wireless networking equipment was more expensive and less secure, with substantially lower throughput compared to wired LANs (EX2024–2026; EX2040 ¶134). Petitioner's citation to consumer hardware pricing does not demonstrate that a POSITA designing a secure, high-

performance enterprise system would have adopted wireless communication—let alone for encrypted video transmission from an external device.

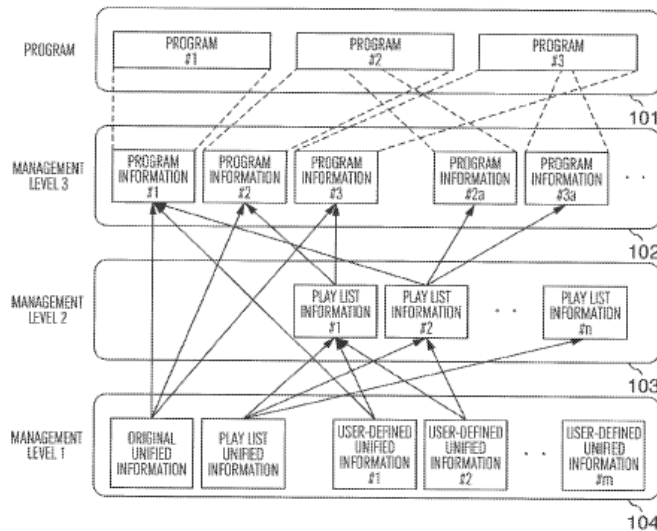
Thus, Petitioner has not shown, by a preponderance of the evidence, that the asserted combination discloses limitations 1[b] and 9[a].

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

Petitioner's argument hinges on the assertion that Horn's disclosure of "personalized collections" qualifies as a user profile under the Board's construction.

Horn does not disclose a user-selectable interface for choosing among multiple user profiles, each associated with a distinct character or identity. While Horn references collections such as "Family, Friends, Work, To Do" (EX1005, 8:58–67), these categories are not selectable profiles, but rather pre-defined organizational groupings. Petitioner's reliance on general statements about "personalization" and "organizing by person" (EX1005, 6:11–22, 37:66–38:3) is misplaced. These disclosures pertain to how data may be organized within a user's workspace, not how a user selects between multiple user profiles at an interface. This is in stark contrast to the claims and specification of the '815 Patent. For example, in Fig. 1 the claimed GUI feature relating to the user profile is based on that "User Defined Unified Information" is assigned to the dedicated management layer, *e.g.*,
LEVEL 1:

FIG.1



The record lacks any evidence that Horn provides a GUI with buttons, avatars, or identifiers enabling such profile selection.

Petitioner attempts to remedy the deficiencies in Horn by relying on disclosures from Baumgartner (Reply, 14–15). But as explained above, Petitioner fails to demonstrate that a POSITA would have been motivated to combine Baumgartner with Horn.

In short, Petitioner's arguments reflect impermissible hindsight—relying on knowledge of the claims to retrofit unrelated features from disparate systems. The proposed combination lacks both disclosure and motivation, and Petitioner's reply fails to meaningfully address these fatal gaps.

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

Petitioner's Reply (Reply, 15) sidesteps the core deficiency. The claims require that the video information that is configured to allow editing is received wirelessly via the network interface. *See* POR, 23; EX2040, ¶153. Petitioner points to Horn's disclosure of "movies," but Horn neither teaches that these movies were received wirelessly nor that they are subject to editing, as required by limitations 1[g] and 9[e]. *Id.* Petitioner's argument that a POSITA would have been motivated to combine Horn with Baumgartner fails for the reasons already explained, and does not cure this fundamental gap.

Thus, Petitioner has not shown, by a preponderance of the evidence, that the asserted combination discloses limitations 1[g] and 9[e].

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

Petitioner's Reply again fails to overcome the key deficiencies. First, the claims require that **the video information**, which is displayed as a thumbnail, is received wirelessly via the network interface. EX2040, ¶155. Petitioner simply cites Horn's reference to "movies" without demonstrating that Horn discloses any such wirelessly received video information, or that this information meets the claim requirements. *See* POR, 24; EX2040, ¶155.

Second, Petitioner offers **no reply at all** to Patent Owner's argument that the Petition fails to disclose **"a thumbnail corresponding to the one video information."** Instead, the Petition cites display of thumbnails for a collection of objects (Pet. at 42–43)—which does not satisfy limitations 1[m] and 9[k]. Petitioner's silence on this point is a tacit concession of the deficiency.

Petitioner has thus failed to carry its burden to show that the combination of Horn and Baumgartner discloses these limitations.

V. GROUND 2: PETITIONER FAILS TO ESTABLISH THAT CLAIMS 7, 8, 14 AND 15 ARE RENDERED OBVIOUS BY HORN IN VIEW OF BAUMGARTNER AND WINTV

A. Petitioner Has Not Provided Sufficient Evidence that WinTV was Publicly Accessible

Petitioner's reply does not cure the evidentiary deficiencies identified in the POR and fails to demonstrate that the WinTV Installation and Reference Manual (EX1010) qualifies as a printed publication under prevailing Federal Circuit and PTAB precedent. The record lacks sufficient evidence that the manual was accessible to a POSITA as of the critical date.

Petitioner now attempts to rehabilitate its faulty petition and relies on the deposition testimony of Dr. Balakrishnan, claiming that he was able to navigate to the WinTV manual from an archived version of the Hauppauge website "in just three clicks." However, Petitioner overlooks the fact that this navigation was conducted in 2025 using the Internet Archive, not in real-time from the actual live website as it

existed in 2003. The reconstruction of a path using modern archival tools does not equate to public accessibility at the time. *See Samsung Elecs. v. Infobridge*, 929 F.3d 1363, 1370–72 (Fed. Cir. 2019).

More importantly, the links and exhibits cited during Dr. Balakrishnan's deposition differ from the evidence presented in the Petition.¹ Even considering the "supplemental information" Petitioner seeks to introduce, Petitioner still fails to show WinTV was publicly accessible at the relevant time. As set forth in his declaration, Dr. Balakrishnan attempted to access the WinTV Manual (Ex1010) via the information *provided in the Petition*. EX2040, ¶¶96-104. He was unable to do so. Not until Dr. Balakrishnan's deposition, utilizing Petitioner's curated "bookmarks" provided on counsel's laptop, was Dr. Balakrishnan able to navigate through allegedly archived Hauppauge web pages. EX1072, 53:18-68:3. Yet, even then when asked to read the URL into the record, Dr. Balakrishnan found a difference between the evidence in the Petition and the newly-navigated web page. *Id.*, 67:3-15. Notably, Dr. Balakrishnan's testimony regarding his inability to access WinTV based on the evidence *presented in the Petition* remains unrebutted.

¹ Petitioner moved to include supplemental information relating to WinTV (Paper 16) and Patent Owner opposed (Paper 17). The Board has not yet ruled on the motion.

It is Petitioner's burden to clearly and consistently present its evidence in the Petition. The Board should disregard these new materials, which are improper and untimely. Public accessibility is evaluated based on whether a POSITA could have located the document using tools available and customary at the time, not via hindsight navigation. *See Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018). As Dr. Balakrishnan explained in his declaration (EX2040 ¶¶99–101), he explored the archived Hauppauge site as it existed in August–September 2003 using the links *provided in the Petition* and could not locate any functional links to the manual.

B. No Motivation to Combine WinTV with Horn and Baumgartner

Petitioner's reply does not overcome the fundamental deficiencies identified in the POR. The combination proposed in Ground 2—Horn, Baumgartner, and WinTV—remains unsupported by the record. Petitioner has failed to establish (1) that WinTV is prior art, (2) that a POSITA would be motivated to combine these three disparate systems, and (3) that there would be a reasonable expectation of success in doing so.

As detailed in the POR (at 25–30) and reiterated above, Petitioner has not met its burden to prove that the WinTV manual (EX1010) was publicly accessible prior to the critical date. Without that showing, all dependent claim arguments relying on WinTV fail. *See Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper

29 at 16 (PTAB Dec. 20, 2019) (precedential); *Samsung Elecs.*, 929 F.3d at 1370–72.

Petitioner's assertion that Horn supports video playback and therefore naturally integrates with WinTV is factually incorrect and unsupported by the record. Horn's references to "movies" are in the context of file types that may be stored and indexed (EX1005, 12:13), not content the system is configured to receive, decode, or render from external sources like a TV tuner.

Horn's architecture is centered around metadata-based document organization, optimized for efficient indexing, search, and retrieval in an "open computer system." See EX1005, 3:10–22; EX2040 ¶159. A POSITA would recognize that Horn's data structure is designed to manage digital files already present within the system—not to interface with hardware such as TV tuner cards for real-time broadcast reception or analog video decoding. See EX2040 ¶159.

Unlike Baumgartner's set-top box, Horn does not contemplate real-time video input, analog signal decoding, or broadcast channel management—all central to WinTV. Petitioner fails to explain how or why a POSITA would retrofit Horn's metadata architecture to accommodate hardware-based media decoding. See EX2040 ¶159.

Even if a POSITA were motivated to combine these systems, Petitioner offers no analysis supporting a reasonable expectation of success. The references offer no

disclosure—nor does Petitioner supply any evidence—of how to integrate the WinTV PCI hardware (requiring driver-level integration and video pipelines) into Horn's file-based operating mechanism. *See* EX2040 ¶159.

Petitioner's reply instead falls back on generalizations about video playback and personalization, which are insufficient under Federal Circuit law. *See In re NuVasive*, 842 F.3d 1376, 1383 (Fed. Cir. 2016) ("conclusory statements alone are insufficient to demonstrate a motivation to combine").

Petitioner has failed to show that WinTV is prior art, has not provided a credible motivation for combining it with Horn and Baumgartner, and has not demonstrated a reasonable expectation of success in doing so. The three systems operate with different purposes, architectures, and technical assumptions. Petitioner's attempt to integrate them relies on hindsight and speculation, not evidence. Accordingly, Ground 2 fails.

VI. GROUND 3: PETITIONER FAILS TO ESTABLISH THAT CLAIMS 1-15 ARE RENDERED OBVIOUS BY HORN IN VIEW OF BAUMGARTNER, WINTV, AND CHAO

Petitioner's reply does not cure the fundamental deficiencies of Ground 3. The proposed combination of Horn, Baumgartner, WinTV, and Chao lacks both evidentiary and technical foundation. Petitioner improperly strings together disparate references without articulating a coherent rationale or addressing the practical and architectural incompatibilities among them. The Board should reject

Ground 3 for at least the following reasons.

As discussed in the POR (at 25–30) and reaffirmed above, Petitioner has not met its burden to show that the WinTV Manual (EX1010) was publicly accessible prior to the critical date. Accordingly, any claim relying on WinTV—including every claim challenged in Ground 3—fails as a matter of law. *See Hulu*, IPR2018-01039, Paper 29 at 16.

Petitioner offers a broad assertion that a POSITA would have found it obvious to use thumbnails for folders, as taught by Chao, because Horn uses thumbnails for individual items. Petitioner's argument is nothing more than a generic assertion of UI improvement and does not address the specific motivations or technical feasibility of modifying Horn's architecture to integrate Chao's teachings.

Critically, Horn teaches away from additional complexity by emphasizing memory and space efficiency as a core design principle. EX1005, 3:10–22; EX2040 ¶166. Adding additional thumbnail layers, particularly ones linked to folders and involving separate image generation and rendering logic as in Chao, would introduce processing and memory overhead that undermines Horn's intended architecture.

In particular, Petitioner cites no portion of Horn suggesting extensibility or UI modularity allowing for thumbnail overlays on folders. Chao provides no roadmap for integration with Horn's memory-managed data structure. Petitioner does not address hardware/software integration challenges, such as differences in how

metadata is generated and rendered in Horn versus Chao.

Petitioner attempts to dismiss Patent Owner's structural objections as "bodily incorporation" arguments. Reply, 22. This mischaracterizes the POR. The issue is not whether one could imagine combining four references, but whether there is a teaching, motivation, or expectation of success in doing so—none of which Petitioner establishes with respect to Chao's integration into Horn's MFS-based framework. The Petition does not even attempt to explain how Chao's folder-thumbnails would be generated, stored, and displayed within Horn's architecture.

Petitioner's reply on Ground 3 relies on improper hindsight, fails to articulate a plausible integration of Chao's thumbnail system into Horn's architecture, and disregards the incompatibility between the systems. Without a specific, reasoned motivation and a reasonable expectation of success, the proposed four-reference combination is not obvious under §103. Accordingly, Petitioner has not met its burden to show unpatentability of claims 1-15 by a preponderance of the evidence.

VII. GROUND 4: PETITIONER FAILS TO ESTABLISH THAT CLAIMS 1-15 ARE RENDERED OBVIOUS OVER KAPLAN AND BRYANT

Petitioner's reply does not cure its failure to explain how the teachings of Kaplan and Bryant would actually be combined. As set forth in the POR (at 35–43), Petitioner merely recites teachings from each reference in isolation and offers high-level motivations unsupported by specific technical reasoning or mapping. This

“pick-and-choose” approach falls short 35 U.S.C. §312(a)(3).

Petitioner's reply fails to remedy the deficiencies identified in the POR. The proposed combination lacks a clear rationale, improperly relies on hindsight, and fails to disclose or support several key limitations. Petitioner has not met its burden to show unpatentability of Claims 1-15 by a preponderance of the evidence.

A. Petitioner Fails to Establish Obviousness for Limitations 1[b] and 9[a]

Petitioner's waiver argument is unfounded. Patent Owner has consistently argued—and continues to argue—that neither Bryant nor Kaplan discloses or renders obvious “first **video information received wirelessly by the network interface** over a network from another information processing apparatus,” as required by limitations 1[b] and 9[a]. See POR, 43–44; EX2040, ¶¶175–176.

Petitioner now seeks to rely on an unsupported assertion of “**common knowledge**” to fill this critical gap. But as the Board is well aware, **generic appeals to “common knowledge”** cannot substitute for specific evidence or articulated reasoning in an IPR proceeding. See, e.g., *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1361 (Fed. Cir. 2016) (“common sense” and “common knowledge” must be supported and cannot replace reasoned analysis or evidence). Here, Petitioner points to no disclosure in Bryant, Kaplan, or elsewhere that teaches or suggests the claimed wireless receipt of video information via a network interface. See POR, 43–44;

EX2040, ¶¶175–176.

Accordingly, Petitioner has failed to show unpatentability by a preponderance of the evidence with respect to limitations 1[b] and 9[a].

B. Petitioner Fails to Establish Obviousness for Limitations 1[c] and 9[b]

Petitioner's Reply does not overcome the clear deficiency in its showing. The claims require that “at least some of the plurality of video information is associated with a user profile,” where a user profile is construed to mean a collection of settings and information associated with a user. *See* POR, 44; EX2040, ¶178.

Petitioner continues to rely on Bryant's disclosure of affective information about images—that is, information reflecting feelings or emotions toward images—as allegedly meeting this limitation. EX1003, ¶226; EX2040, ¶179. But, such affective information is not a collection of settings and information about the user, nor is it data representing the user's distinctive features or characteristics. *See* EX2040, ¶179–180. The fact that Bryant associates a user identifier with affective information about an image does not convert that affective information into a user profile under the claim construction. *Id.* The user identifier merely labels which user entered an emotion about an image; it does not create a collection of settings or information about that user—which is what the claim requires. *Id.*

Petitioner's Reply provides no evidence that Bryant discloses or suggests associating video information with an actual user profile as properly construed. Reply, 24–25. Its argument continues to conflate affective metadata about images with profile information about a user—two distinct concepts. *See* EX2040, ¶179–180.

Accordingly, Petitioner has failed to show unpatentability by a preponderance of the evidence with respect to limitations 1[c] and 9[b].

C. Petitioner Fails to Establish Obviousness for Limitations 1[g] and 9[e]

Petitioner's Reply again fails to demonstrate that the Bryant-Kaplan combination discloses “the first group of video information being configured to allow a user to edit,” as required by limitations 1[g] and 9[e].

First, Petitioner continues to mischaracterize Kaplan. Paragraph 44 of Kaplan does not refer to button 28, nor does it describe editing video information as required by the claims. *See* EX1014, ¶44; EX2040, ¶¶182–183. The fact that a user may copy a file into a Favorites container (EX1014, ¶44) or that History 28 is described as a “primary option button” (EX1014, ¶46) does not establish that a user is editing video information—that is, audio-visual data or playlists—as required under Petitioner's own proposed construction. *See* POR, 45; EX2040, ¶¶182–183. Simply moving or copying files or recording “History” of usage does not equate to editing video

information or playlists as required under Petitioner's own proposed construction.
Id.

Second, Petitioner's claim of waiver is unfounded. Reply, 26. Specifically, Petitioner has failed to provide evidence that Kaplan's Favorites and History containers satisfy the claim limitations—because Petitioner has not shown that these containers are themselves configured to allow a user to edit video information, as opposed to performing simple file management or recording user history. *See* POR, 45; EX2040, ¶¶182–183.

Accordingly, Petitioner has failed to show unpatentability by a preponderance of the evidence with respect to limitations 1[g] and 9[e].

D. Petitioner Fails to Establish Obviousness for Limitations 1[l] and 9[j]

Petitioner's Reply fails to cure the deficiency in its showing regarding limitations 1[l] and 9[j]. The claims require that when one video information is deleted from the first group, it remains included in the second group of video information, and a thumbnail corresponding to that video information continues to be displayed. EX2040, ¶185. Petitioner has failed to demonstrate that the Kaplan-Bryant combination satisfies this requirement.

First, the Petition itself acknowledges that Kaplan alone may not disclose this limitation, and offers no concrete explanation of what specific disclosure in Bryant allegedly remedies this gap. Pet. at 83. The Petition simply states that Bryant would

make this limitation “at least obvious” (Pet. at 83), but fails to identify any particular teaching or mechanism in Bryant that would ensure continued inclusion and display of the video information as the claims require. EX2040, ¶185. This deficiency remains unaddressed in the Reply. Reply, 26–27.

Second, Petitioner's assertion of waiver is unfounded. Reply, 27. Patent Owner has consistently argued that Petitioner fails to show how the Kaplan-Bryant combination satisfies the precise claim requirement concerning the behavior of video information upon deletion and the continued display of corresponding thumbnails. EX2040, ¶185.

Petitioner's attempt to distinguish *Skyhawke Techs., LLC v. Deca Int'l Corp.*, 828 F.3d 1373 (Fed. Cir. 2016) is unavailing. Contrary to Petitioner's assertion, the applicability of collateral estoppel turns not merely on whether the same claim construction issue was explicitly raised by the parties, but on whether the underlying legal standard used to construe the claims materially differed. In *Skyhawke*, the Federal Circuit rejected collateral estoppel where the prior proceeding applied the BRI standard and the later one applied Phillips, because the two standards can produce different outcomes—even where the specific claim construction was not affirmatively disputed in the later case. That is precisely the situation here. The prior IPR applied BRI, while this proceeding applies Phillips, and Petitioner fails to show that limitations 1[l] and 9[j] would necessarily be construed the same way under both

standards. As such, the claim construction issue has not been “actually litigated” and collateral estoppel does not apply.

Moreover, the challenged claim here (claim 1) includes element (*e.g.*, 1[m]) absent from the '783 patent, meaning the patentability issues are not identical. Thus, estoppel is inapplicable. *See In re Freeman*, 30 F.3d at 1465.

E. Petitioner Fails to Establish Obviousness for Limitations 1[m] and 9[k]

Petitioner continues to conflate the display of folder icons with the claim requirement of displaying a thumbnail corresponding to video information—a fundamental distinction it has not addressed. EX2040, ¶187. The claims require 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.” Petitioner’s Reply does not demonstrate that this limitation is met. *Id.*

Petitioner repeats the conclusory assertion that a POSITA would have understood that selection of a second collection would result in displaying thumbnails for all objects in that collection. Pet. at 87. But, as Patent Owner has shown, Kaplan discloses folder icons—not thumbnails corresponding to video information—when the second character is selected. *See* Kaplan Fig. 8; EX2040, ¶187. The presence of a generic folder icon with a film symbol is not a thumbnail corresponding to the

claimed “one video information,” as required by the claims. *Id.* Petitioner's Reply identifies no disclosure in Kaplan or Bryant that teaches this required behavior. *See* Reply, 28–29.

Further, Petitioner's assertion of waiver is misplaced. Patent Owner's argument has consistently focused on the lack of disclosure of thumbnails corresponding to video information—not on any issue regarding wired versus wireless networks. EX2040, ¶187. Petitioner's reference to “common knowledge” (Reply, 28) about networks is irrelevant to this specific limitation and cannot substitute for actual evidence or reasoned analysis. *See Arendi*, 832 F.3d at 1361.

VIII. CONCLUSION

For at least the foregoing reasons, the Board should confirm the patentability of Claims 1–15.

Dated: June 6, 2025

Respectfully submitted,

/Robert G. Pluta/

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

Saqib J. Siddiqui (Reg. No. 68,626)

MAYER BROWN LLP

1999 K Street NW

Patent No. 11,017,815
Patent Owner's Sur-Reply

Washington, D.C., 20006
ssiddiqui@mayerbrown.com

Counsel for Maxell, Ltd.

Patent No. 11,017,815
Patent Owner's Sur-Reply

CERTIFICATE OF SERVICE

I hereby certify that on this 6th day of June, 2025, a copy of the attached
PATENT OWNER SUR-REPLY, 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-Patent Owner@us.dlapiper.com

Respectfully submitted,

Date: June 6, 2025

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

Counsel for Patent Owner, Ltd.

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

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Sur-reply and 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 Sur-reply indicates that the Sur-reply contains 4,940 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)