

**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: IPR2024-00777

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

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

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37 C.F.R. § 42.104	37, 46, 62, 63

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
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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
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I. INTRODUCTION

Patent Owner Maxell, Ltd. (“Patent Owner”) respectfully requests that the Board deny institution because Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (hereinafter “Petitioner” or “Samsung”) has failed to demonstrate a reasonable likelihood of success on the grounds submitted in its Petition for challenging the patentability of claims 16-27 (“challenged claims”) of U.S. Patent No. 11,017,815 (“the ’815 Patent”) (EX1001).

First, the Board should exercise its discretion pursuant to 35 U.S.C. § 314(a) or 35 U.S.C. §325(d) and deny this petition. Application of the *Becton, Dickinson* factors weigh in favor of denying institution because most of the art relied on in the Petition was in fact considered in the ’815 Patent and related applications or is cumulative to prior art considered. Moreover, application of the *Fintiv* factors weigh in favor of denying institution. One of the purposes of IPRs is to be an “effective and efficient alternative” to litigation. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017) (precedential). Here, instituting an IPR would not be an effective or efficient alternative to litigation, particularly given the stage of the co-pending District Court case *Maxell, Ltd. v. Samsung Electronics Co. Ltd. et al.*, No. Case No. 5:23-cv-00092 (E.D. Tex.) (“District Court Litigation”) and the finite resources of the Board.

Second, Petitioner fails to show a reasonable likelihood of prevailing on any Ground because it has not shown that the cited references render obvious claims 16-27. None of the cited references alone or in combination disclose the arrangement of each element of claims 16-27.

Accordingly, the Board should decline to institute the Petition.

II. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

The Petition should be denied pursuant to the Director's discretion to deny institution of petitions. First, the Petition should be denied pursuant to 35 U.S.C. § 325(d) because the petition argues the "same or substantially the same art previously [] presented to the Office" and fails to demonstrate "that the Office erred in a manner material to the patentability of the challenged claims." *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8 (P.T.A.B. Feb. 3, 2020) (precedential); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, pp. 17-18 (PTAB Dec. 15, 2017) (Precedential). Second, the Petition should be denied pursuant to 35 U.S.C. § 314(a) and the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020). The PTAB has the authority, where warranted, to exercise discretion to deny institution in view of the *Fintiv* factors particularly where, as here, the merits of the challenge are neither compelling nor meritorious (*see infra*, Section III). *See* "Interim Procedure for Discretionary Denials in AIA Post-Grant

Proceedings With Parallel District Court Litigation,” issued June 21, 2022 (“Director’s Guidance”).

A. Application of 35 U.S.C. § 325(d) Weighs In Favor Of Denying Institution

The Petition should be denied pursuant to 35 U.S.C. § 325(d) because the petition argues the “same or substantially the same art previously [] presented to the Office” and fails to demonstrate “that the Office erred in a manner material to the patentability of the challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8 (PTAB Feb. 3, 2020) (precedential); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, pp. 17-18 (PTAB Dec. 15, 2017) (Precedential). “Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Id.* at 7-8. Further, the Board has construed “previously presented” in 35 U.S.C. § 325(d) to refer to art and arguments presented to the Office *prior to* the filing of the petition at issue. *Ironsource Ltd. v. Digital Turbine Inc.*, PGR2021- 00096, Paper 14 at 52 (PTAB Jan. 6, 2022).

Specifically, the IPR-asserted art is “substantially the same” because two of the references—Kaplan and Bryant—were previously presented to the Office in the

prosecution of the '815 Patent, along with several applications related to the '815 Patent. The remaining main reference—Horn—is cumulative of those previously presented to the Office. The remaining secondary references—Baumgartner, WinTV, Candelore, Wong, and Chao—also are cumulative. The first part of the two-part framework from *Advanced Bionics* is met here.

Under the second part, Petitioner argues that the examiner materially erred by pointing to a Board decision regarding Kaplan and Bryant on “nearly identical subject matter.” Pet. at 100. Yet, Petitioner's premise is faulty because as further set forth below, the claim at issue here is distinct from the claim at issue in that prior matter, and thus the examiner's allowance of the '815 Patent claims was not material error. *Albany Int'l Corp. v. Kimberly-Clark Worldwide, Inc.*, PGR2021-00019, Paper 22, 8-9 (P.T.A.B. June 22, 2021) (denying institution because “[i]f a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute [] review.”).

1. The Same Or Substantially The Same Art Was Previously Presented To The Office

The overlap between the IPR-asserted references and those submitted during prosecution of related applications meets the first part of the two-part *Advanced Bionics* framework, which considers the similarities and material differences

between the two sets of art, the cumulative nature of the art, and the extent of the overlap between the arguments. *Becton, Dickinson*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential).

In the instant case, the grounds presented by Petitioner are duplicative of the art and arguments applied by the Examiner during prosecution of the '815 Patent as well as the '815 Patent's parent application, U.S. Patent No. 10,679,674 (EX2006) and grandparent applications, U.S. Patent Nos. 10,199,072 (EX2007); 9,818,449 (EX2008); 9,384,783 (EX2009); 8,644,684 (EX2010); 7,613,383 (EX2011); *see also* EXS1040-1045 (file histories for related patents).

a. Kaplan and Bryant

Petitioner's main references for Grounds 9 and 10—Kaplan and Bryant—were previously presented to the Office during prosecution of the '815 Patent. EX1002 at 39, 44. The Examiner noted her consideration of each reference, including her consideration of the Final Written Decision in IPR2018-01432: "All References Considered Except Where Lined Through." *Id.* at 39, 44, 49. Indeed, after considering Kaplan and Bryant, the Examiner made the following statement:

The prior arts do not disclose or suggest continue to include the video information upon the video information is included in both the first group and the second group after the video information is deleted.

EX1002 at 12.

Grounds 9 and 10, both anchored by Kaplan and Bryant, are duplicative of the art and arguments considered during the '815 Patent's prosecution. Petitioner's admit as much. Pet. at 100. Kaplan and Bryant were also considered and are duplicative of the art and arguments applied during other related applications. EX2006-2007. *See Clim-A-Tech Ind., Inc. v. William A. Ebert*, IPR2017-01863, Paper 13, at 18-19 (PTAB Feb. 12, 2018) (denying institution even though the 'Examiner did not base a rejection' on the reference asserted in the petition); *Biocon Pharma Ltd. v. Novartis Pharm. Corp.*, IPR2020- 01263, Paper 12, 9 (PTAB Feb. 16, 2021) (holding that cited but unapplied references supported denying institution); *Sony Interactive Entm't LLC v. Terminal Reality, Inc.*, IPR2020-00711, Paper 15, at 11 (PTAB Oct. 13, 2020) (finding reference was previously considered by the PTO because it was listed in the Examiner's Notice of References Cited).

b. Horn

Grounds 6-8, all anchored by Horn (EX1005), are cumulative to at least Kaplan, Bryant, and Honkaniemi—all previously considered during prosecution of either the '815 Patent or related applications. For example, in the prosecution of the related patent 8,644,684, the Examiner—the same Examiner that examined the '815 Patent—cited U.S. Patent Application No. 2007/0022382 ("Honkaniemi") (EX2012) in a similar way as Petitioner uses Horn against claim elements 1[k]-[m]. EX1044 at 96-98. During prosecution, the Examiner pointed to Honkaniemi's disclosure of

a user interface which includes items, each item having a media file and arranged to be visible as a thumbnail to the user interface, similar to how Petitioner points to Horn's computer control software system for organization, finding, viewing and retrieval of multiple data objects. *Compare* 1044 at 96-98 with Pet. at 41-42. Further comparison between the Figures of Horn and Honkaniemi illustrate the cumulativeness of Horn:

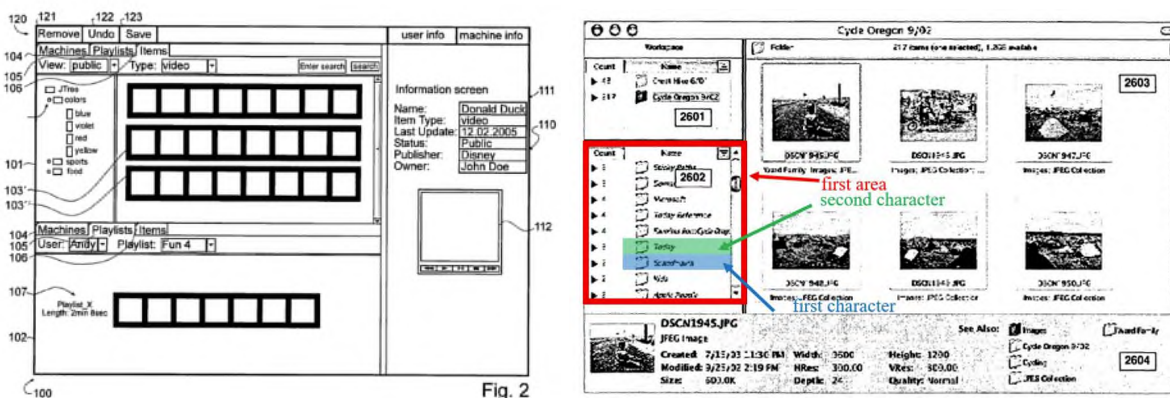
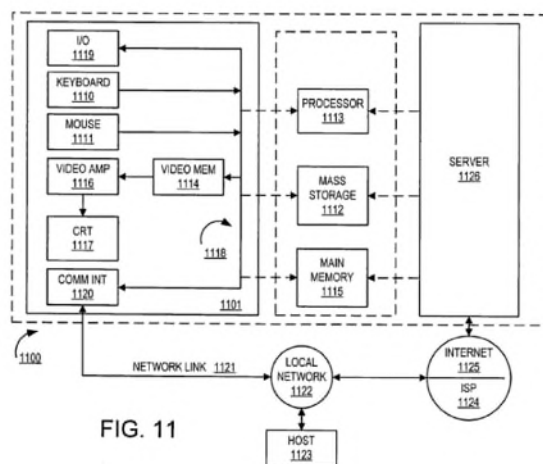
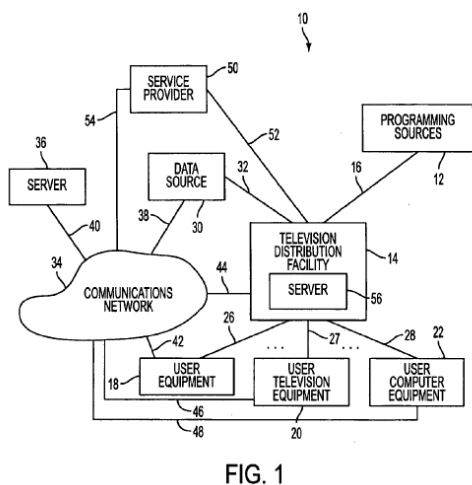


Fig. 2 (left) from Honkaniemi showing a user interface where a playlist view and an item view are illustrated, and Fig. 30 (right) from Horn showing a user interface with two areas illustrated.

c. Baumgartner

The remaining secondary references for Grounds 6-8—Baumgartner, WinTV, and Chao—are all very similar to the over one hundred references considered by the Examiner during prosecution of the '815 Patent and related applications. For example, Petitioner uses Baumgartner in Ground 1 to support claim elements 16[a]-16[e] and 21[a]-21[5]. See Pet. at 25-37 (corresponding citations to Baumgartner)

But Baumgartner is cumulative to the prior art considered during examination. For example, the Examiner considered U.S. Patent No. 7,512,622 (“Volk”) entitled “Method and Apparatus for Organizing and Playing Date.” EX2013. Volk discusses various solutions to media interfaces and navigation tools for content from a variety of sources. *Id.*, Abstract.



Compare Fig. 1 from Baumgartner with Fig. 11 from Volk.

Additionally, the Examiner considered Honkaniemi and alleged Honkaniemi disclosed elements corresponding to how Petitioner uses Baumgartner, namely, a recording medium, user profiles, a display, and a processor. See, e.g., EX1044, at 96-98.

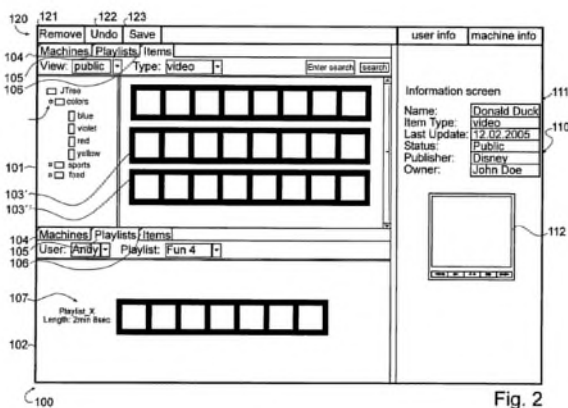


Fig. 2

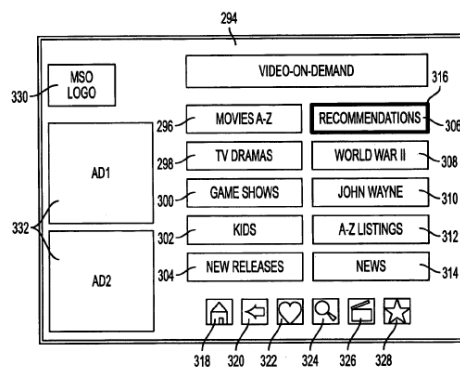


FIG. 24

Fig. 2 from Honkaniemi and Fig. 24 from Baumgartner. As such, Petitioner's use of Baumgartner is merely cumulative to what the Office considered with respect to Claims 1-15, particularly in light of the cumulativeness of Horn.

d. WinTV

Petitioner uses WinTV in Grounds 7, 8, and 10 for its alleged "television tuner card and associated software configured for installation in a personal computer." Pet. at 53-54. As further explained below in Section III.D.3, Petitioner has not met its burden of showing that WinTV was publicly accessible and is prior art. Regardless, Petitioner's use of WinTV is merely cumulative of what the Office considered with respect to Claims 16-27. For example, U.S. Patent No. 6,480,669 ("Tsumagari") (EX2014), was considered during prosecution of the '815 Patent (see EX1002 at 61) as well as during prosecution of the related '684 Patent (see EX1044 at 98). Tsumagari similarly discloses a TV tuner in its system for recording a video program or the like in real time and playing it back using an optical disk:

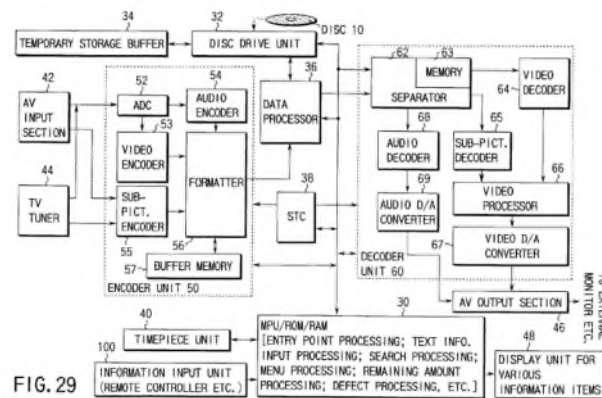


FIG. 29

EX2014, Fig. 29.

e. Chao

Petitioner uses Chao in Ground 8 for its alleged display of thumbnails. Pet. at 58-59. As with the other secondary references, Petitioner's use of Chao is merely cumulative of what the Office considered with respect to Claims 16-27, such as Honkaniemi, and how the Examiner applied such references in prosecution of related applications. *See, e.g.*, EX1044 at 95-98, 112-114, and 127. For example, Petitioner relies on Fig. 8 of Chao for disclosing thumbnails, but such a use of Chao is cumulative to Honkaniemi:

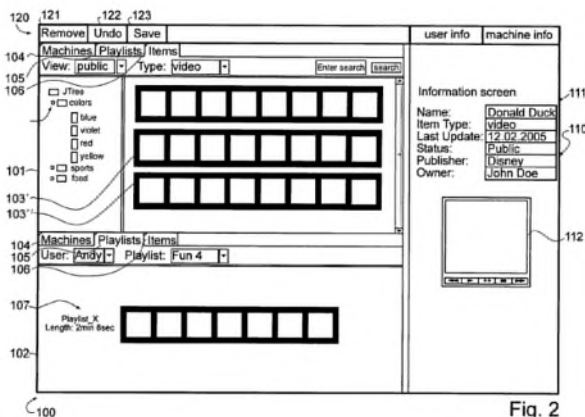


Fig. 2

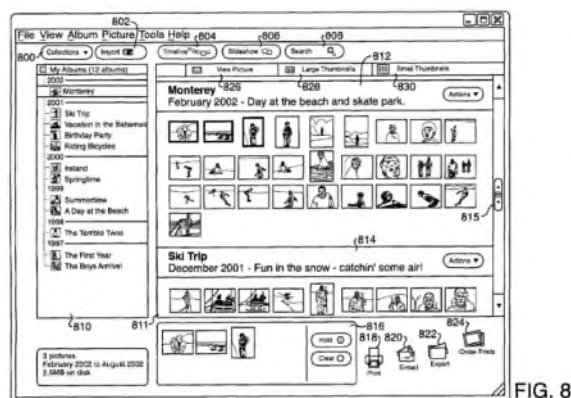


FIG. 8

EX1006 (Fig. 8); EX2012 (Fig. 2).

f. Candelore

Petitioner uses Candelore in Grounds 6-10 for its purported teaching of encrypted content. But Candelore is merely cumulative to numerous other references considered during prosecution that discuss or disclose encryption and encryption techniques. For example, U.S. Patent 7,974,511 to Mikawa discusses storage of encrypted programs and key information that is used to decrypt the program. EX2015, 14:42-50. Similarly, U.S. Patent No. 7,853,893 to Muller discusses downloaded media content that is transrypted from one encryption key to another encryption key before persistent storage. EX2016, 5:62-6:5 Muller also discusses downloaded media content that is encrypted as received at the server but is decrypted and then re-encrypted before persistent storage. *Id.*

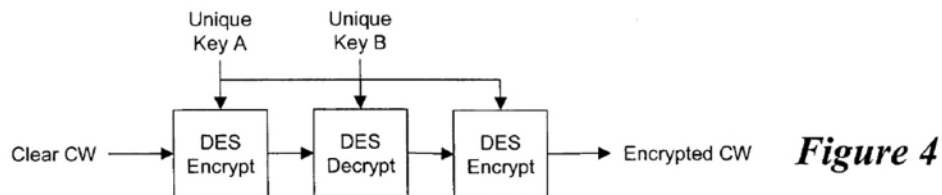


Figure 4

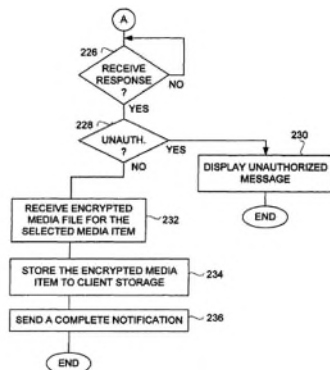
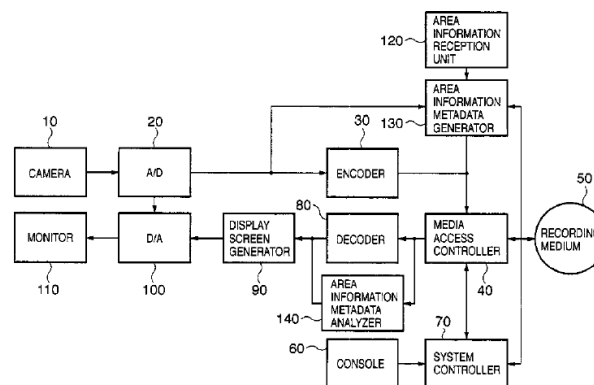


FIG. 2B



EX1013 (Fig. 4); EX2015 (Fig. 1); EX2016 (Fig. 2B).

g. Wong

Petitioner uses Wong for Grounds 9 and 10. Wong, as admitted by Petitioner, may not be prior art. Pet. at 9. As explained below in Section III.C., Wong is not prior art. Regardless, Wong is cumulative to at least Kaplan, Bryant, and Honkaniemi.

All told, Petitioner's main references for Grounds 9 and 10, Kaplan and Bryant, were previously considered by the Office. The main reference for Grounds 6-8, Horn, is cumulative to at least Kaplan, Bryant, and Honkaniemi. The secondary references, Baumgartner, WinTV, Candelore, Wong, and Chao, are also cumulative to various references previously considered by the Office, as explained above. As such, the first part of the *Advanced Bionics* test is met.

2. Petitioner Fails To Demonstrate A Material Error By The Office

Regarding part two, Petitioner's attempt to detail material error by the Office utilizes sleight of hand and is cursory. Petitioner relies solely on the Board's prior analysis of Bryant and Kaplan in IPR2018-01432 (EX1009 at 31-36) applied to a different claim (Claim 2) of a different patent (U.S. Patent No. 9,384,783). Pet. at 100. In doing so, however, Petitioner unnaturally parses the claim elements of Claims 16 and 21 to "match" the Petition's element 16[j], 16[k], 21[j], and 21[k] to the language of the '783 Patent at issue in IPR2018-01432 and concludes "the Board has found that nearly identical subject matter is rendered obvious by the combination of Bryant and Kaplan." *Id.* This broad statement with respect to *one element* of Claims 16 and 21 is as far as Petitioner goes in demonstrating material error of allowance of Claims 16-27. In so doing Petitioner ignores the remainder of the claim language of claim 16 and 21. With respect to the entirety of the claim language allowed by the Examiner during prosecution of the '815 Patent, it is worth repeating that the Examiner found:

The prior arts do not disclose or suggest continue to include the video information upon the video information is included in both the first group and the second group after the video information is deleted.

EX1002 at 12. The Examiner not only considered Kaplan and Bryant, but also considered the Final Written Decision in IPR2018-01432.

In hanging its hat regarding material error entirely on the Board's prior analysis of *one* similar claim element, Petitioner completely ignores the several differences between the remainder of the claim language. Even a cursory comparison of the Claims illustrate the differences and why there was no material error by the Examiner in allowing the '815 Patent claims over Bryant and Kaplan. *Compare* EX1001 at 8:49-11:57 *with* EX2009 at 8:23-10:27. Petitioner makes no effort to demonstrate any material error beyond this one element of Claims 16 and 21.

B. Application of 35 U.S.C. § 314(a) Weighs in Favor of Denying Institution

The Petition should be denied pursuant to 35 U.S.C. § 314(a) because, as set forth below, not only are there significant flaws in Petitioner's analysis that fail the "compelling merits" standard, but the circumstances of the parallel District Court Litigation necessitate denial of the Petition under the Board's precedent. In the Petition, Petitioner does not argue that any *Fintiv* factor, other than factor 6, supports institution. Nor has Petitioner made a *Sotera* stipulation. Every factor considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential).

The Petition should be denied because the invalidity arguments Petitioner raises here will be resolved in a co-pending District Court action long before this proceeding will conclude. Specifically, the '815 Patent is asserted in the co-pending

District Court Litigation. While Petitioner acknowledges the District Court Litigation in the Petition, it failed to inform the Board that the District Court Litigation will be complete long before any final decision would issue in this proceeding. Nor did Petitioner inform the Board that Maxell identified Petitioner's infringement of the claims at issue in the '815 Patent in 2001, years prior to Petitioner filing its Petition, and that the trial date of May 2025 for the District Court Litigation was scheduled back in January 2024. EX2002. The jury trial adjudicating the validity of the '815 Patent will conclude six months before any Final Written Decision issues in this proceeding.

Not only will the District Court Litigation conclude long before this proceeding, but it will also resolve the invalidity arguments that Petitioner raises in the instant Petition. The prior art references relied on in this proceeding are the same, or substantially the same, as those at issue in the District Court Litigation. Additionally, the challenged claims are substantially the same as those asserted in the District Court Litigation.

Thus, any questions of whether the grounds of invalidity raised in Petitioner's Petition invalidate the asserted claims of the '815 Patent will be decided in the District Court Litigation at least six months prior to when the Board would issue a Final Written Decision in this proceeding.

Accordingly, the Board should exercise its discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

1. No Stay Of The Parallel District Court Litigation

There is no stay of the parallel District Court Litigation. Even if the Petition were instituted and Petitioner filed a motion to stay the District Court Litigation, prejudice, tactical disadvantage to Maxell, the late stage of the litigation, and the lack of potential simplification would weigh strongly against such a motion. See *Lennon Image Techs., LLC v. Macy's Retail Holdings, Inc.*, 2:13-CV-00235-JRG, 2014 WL 4652117, at *1 (E.D.T.X. Sept. 18, 2014). The statutory deadline for institution is not until after fact discovery closes. EX2001; see *Intell. Ventures II v. FedEx Corp.*, No. 2:16-cv-00980-JRG, Dkt. 141 at 5 (E.D.T.X. Oct. 24, 2017) (“The Court agrees that the Parties have already invested substantial effort and resources during discovery and in preparing claim construction briefing...These circumstances weigh against staying this case.”)

2. Proximity Of The District Court's Trial Date

The proximity of the District Court Litigation's trial date to the Board's projected statutory deadline for a Final Written Decision strongly weighs in favor of discretionary denial. The parties' trial is scheduled for May 19, 2025. EX2002. Petitioner knew of this trial date four months prior to filing their Petition. *Id.* Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final Written Decision of this Petition is November 12, 2025. As the District Court's trial will be almost six months before the projected statutory deadline, this factor weighs strongly in favor of denying institution. *See Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude "several months," before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 ("Because the trial date is substantially earlier than the projected statutory deadline for the Board's final decision, this factor weighs in favor of discretionary denial.").

The proximity of the trial favors denial of institution.

3. Significant Investment In The Parallel Proceeding

The parties' investment in the parallel proceeding weighs in favor of discretionary denial. In the District Court Litigation, the Court has already entered a Docket Control Order (Dkt. 45), Discovery Order (Dkt. 46), and Protective Order (Dkt. 47). The Court has also conducted a *Markman* Hearing (Dkt. 84). Discovery is also well under way, and fact discovery including depositions of numerous foreign inventors and foreign engineers will be complete on October 29, 2024, about two weeks before the Institution Decision in this proceeding.

The parties have already exchanged infringement contentions pursuant to P.R. 3-1, and invalidity contentions pursuant to P.R. 3-3, completed claim construction briefing and a trial date is set for May 19, 2025, which is only six months after a decision on Institution. EX2001. Thus, the parties' and Court's substantial investment in this proceeding weighs in favor of denial of institution under this factor. *10X Genomics, Inc. v. President and Fellows of Harvard College*, IPR2023-01299, Paper 15, at 17-18 (P.T.A.B. March 7, 2024) (finding, under similar facts, that the parties have made a substantial investment in the parallel proceeding as of the time of the Institution Decision).

4. There Is Significant Overlap Between Issues Raised In The Petition And In The District Court Litigation

The issues in this proceeding are substantially the same as in the District Court Litigation.¹ Here, Petitioner asserts that Claims 16-27 of the '815 Patent are unpatentable. Petition at 1. These claims cover the asserted claims against Petitioner in the District Court Litigation. EX2003. The prior art that Petitioner relies on in supporting its Petition is the same or substantially the same as the prior art at issue in the District Court Litigation. EX2004. In light of the Director's Guidance, Petitioner's failure to make a *Sotera* stipulation weighs against institution. "When a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition *or any grounds that could have reasonably been raised in the petition*, it mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB. *See Sotera*, Paper 12 at 18- 19." Director's Guidance at 7 (emphasis added). Contrary to making a *Sotera* stipulation, Petitioner has indicated that it will be pursuing the same invalidity defenses using the same prior art in this proceeding and the District Court Litigation. EX2004 at 3.

¹ As noted in Patent Owner's Response to Notice Ranking, filed contemporaneously herewith, Petitioner has filed an additional Petition against the '815 Patent focusing on Claims 1-15. This Petition should be denied for the additional reasons expressed in Patent Owner's Response to Notice Ranking.

Given that the Petition is directed toward the same claims, same grounds, same arguments, and significantly overlapping evidence at issue in the parallel District Court proceeding, and since Petitioner has not sought to mitigate any of these concerns, this factor favors denial of institution.

5. The District Court Litigation And The Petition Involve The Same Parties

As noted in Patent Owner's Mandatory Notice, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the '815 Patent). See Paper 5. Petitioners are parties to the District Court Litigation. Accordingly, this factor weighs in favor of discretionary denial.

6. Other Factors Favor Discretionary Denial

Petitioner does not present a strong case on the merits, let alone a "compelling meritorious challenge," further supporting denial of institution. See *infra* Section III. Petitioner also does not identify any other factors which weigh against discretionary denial. Pet. at 100.

Thus, when viewing the factors together, the Petition should be denied in the Director's discretion under 35 U.S.C. §314(a).

C. The Board Should Reject Any Late *Sotera* Stipulation

Petitioner has not made a *Sotera*-style stipulation that "if IPR is instituted, [Petitioner] will not pursue in the District Court Litigation any ground raised or that could have been reasonably raised in an IPR" in its Petition, which weighs further

in favor of discretionarily denying institution. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 13-14 (P.T.A.B. Dec. 1, 2020) (designated Dec. 17, 2020). The Board should not accept any late *Sotera* stipulation after this Patent Owner Preliminary Response. Petitioner has known about the related District Court Litigation since Patent Owner filed a Complaint asserting infringement of the '815 Patent on September 7, 2023, over seven months before this Petition. Petitioner has continued to assert the same set of prior art across both proceedings requiring duplicative efforts. The Court set the trial date seven months ago. EX2002. Any withholding of the *Sotera* stipulation in its Petition is gamesmanship and prejudicial to Patent Owner in this proceeding, and is inconsistent with 37 C.F.R. § 42.1(b)'s mandate to "secure the just, speedy, and inexpensive resolution of every proceeding." Indeed, Petitioner's gamesmanship in this regard prejudices Maxell because Maxell is forced to prepare a validity defense in the District Court Litigation throughout the pendency of this Petition.

Both the Board and the Director are clear that petitioners cannot wait until after the Board renders its Institution Decision to address the issue of *Fintiv* and to submit a *Sotera* stipulation. *NXP USA, Inc. v Impinj, Inc.*, IPR2021-01556, Paper 12, 5-6 (P.T.A.B. Aug. 25, 2022); *see also id.*, IPR2021-01556, Paper 13, 3-4 (P.T.A.B. Sept. 7, 2022) (the Director finding "[p]ermitting a petitioner to wait and see if the Board denies institution under *Fintiv*, and then offer such a stipulation for

the first time on rehearing, frustrates these goals [of avoiding conflicting decisions] and would open the door to gamesmanship;”). Petitioner’s failure to provide a *Sotera* stipulation along with its Petition has prejudiced and continues to prejudice Maxell.

III. THE PETITION DOES NOT SHOW A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY CHALLENGED CLAIM

While application of the *Fintiv* factors and *Becton, Dickinson* factors weigh in favor of denial of institution, institution should also be denied because the petition fails to show a reasonable likelihood of prevailing with respect to any challenged claim.

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

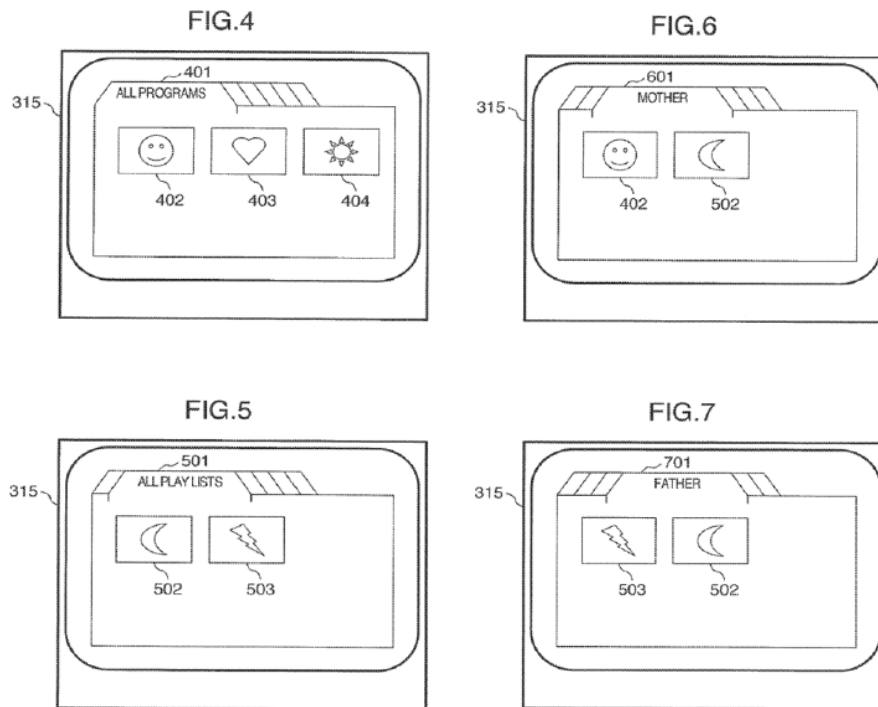
The ’815 Patent is entitled “Editing Method and Recording and Reproducing Device,” and claims priority to multiple Japanese applications, the earliest of which was filed on December 2, 2004. The ’815 Patent issued on May 25, 2021.

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 EXS2006-20011; EXS1040-1045 (file histories of related patents) All the patents stemming from the Japanese priority applications were examined by the same Primary Examiner.

C. The '815 Patent's Priority Date

To support its use of Wong for Grounds 9 and 10, Petitioner contends that none of the applications to which the '815 Patent claims priority that were filed prior to 11/9/2017 “satisfy the requirements of 35 U.S.C. §112 for at least the following terms found in each independent claims of the Challenged Claims”. Petitioner then characterizes the terms as Terms 1-3, respectively. Pet. at 10. However, each of Terms 1-3 has written support in several applications prior to 11/9/2017. EX2021, ¶36. In fact, each term has support in the priority application JP2004-378767. *See* EX2019 (Translation of JP2004-378767); EX2020 (certification of accuracy); EX2021, ¶41.

With respect to Term 1, the “encryption” limitation is disclosed in the priority application at least in the following:

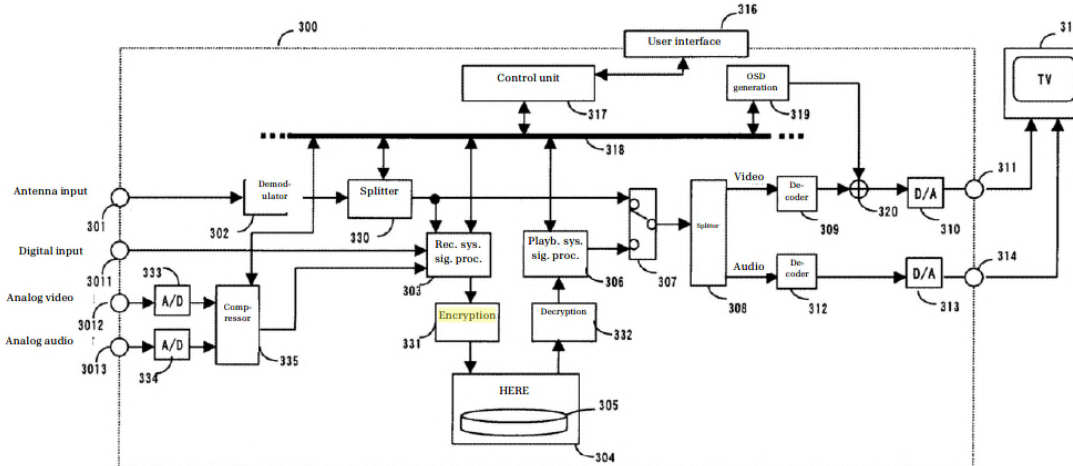
331 is an encryption circuit for encrypting recorded data, 304 is a recording and playback system including drive functionality for the recording medium, 305 is a recording medium, 332 is a decryption circuit for decrypting data which has been encrypted and recorded on the recording medium, 306 is a playback system signal processing circuit....

During recording, a signal transmitted by digital broadcast, for example, and received is demodulated using a predetermined method in the demodulation circuit 302 and then subjected to any requisite signal processing such as modulation or addition of data for timing

adjustment in the recording system signal processing circuit 303 before being encrypted in the encryption circuit 331 and recorded on the recording medium 305 by the recording and playback system 304. The digital signal input by the digital input terminal 3011 is subjected to any requisite signal processing such as modulation and addition of data for timing adjustment in the recording system signal processing circuit 303 before being encrypted in the encryption circuit 331 and recorded to the recording medium 305 by the recording and playback system 304. The analog video signal input by the analog video input terminal 3012 and the analog audio signal input by the analog audio input terminal 3013 are compressed in the compression circuit 335, pass through the recording system signal processing circuit 303, and are encrypted by the encryption circuit 331 before being recorded on the recording medium 305 by the recording and playback system 304.

During playback, encrypted digital data read via the recording and playback system 304 from the recording medium 305 in response to a user command is decrypted by the decryption circuit 332, subjected to any requisite signal processing for playback such as demodulation in a manner consistent with a predetermined modulation method in the playback system signal processing circuit 103 and sent to the splitter circuit 308 via the switching circuit 307.

FIG. 3



EX2019, ¶¶[0017]-[0019]; Fig. 3; EX2021, ¶¶37-38.

Regarding Term 2, the “upon the one video being removed” is disclosed in the priority application at least in the following:

402 and 502 are the thumbnails showing program information #1 and playlist information #1, as can be seen from FIG. 1. "Mom" can freely register and delete data to be played back, using the mom menu display tag 601 as her own folder.

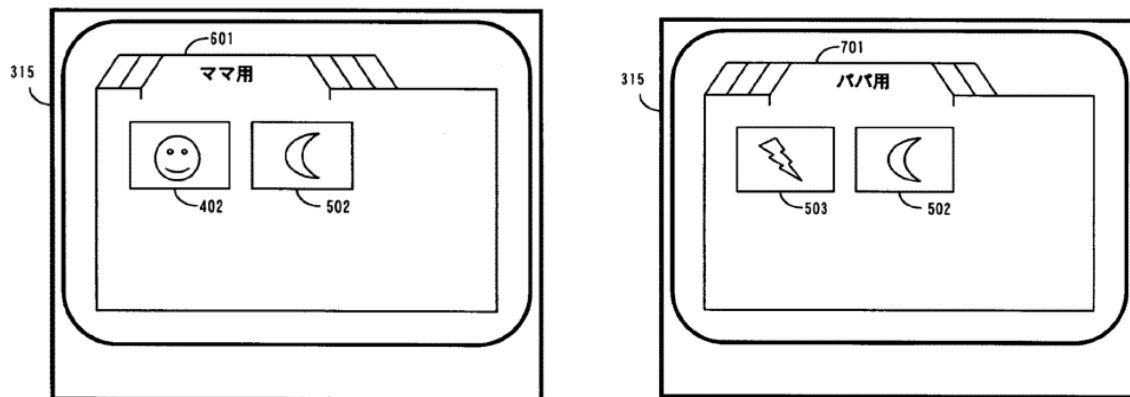
503 and 502 are the thumbnails for playlist information #2 and playlist information #1, as can be seen from FIG. 1. In this case, "dad" has selected two playlists and can change the playback order. As with "mom" above, "dad" can freely register and delete data to be played back, using the dad menu display tag 701 as his own folder.

EX2019, at ¶¶[0024]-[0025]; EX2021, ¶39.

Regarding Term 3, the “user profile” limitation is disclosed in the priority application:

Next, FIG. 6 is an example of a menu display using integrated user defined information #1 in FIG. 1. 601 is a user #1 (here being "mom") menu display tag, and 402 and 502 are the thumbnails showing program information #1 and playlist information #1, as can be seen from FIG. 1. "Mom" can freely register and delete data to be played back, using the mom menu display tag 601 as her own folder.

Similarly, FIG. 7 is an example of a menu display using integrated user defined information #2 in FIG. 1. 701 is a user #2 (here being "dad") menu display tag, and 503 and 502 are the thumbnails for playlist information #2 and playlist information #1, as can be seen from FIG. 1. In this case, "dad" has selected two playlists and can change the playback order. As with "mom" above, "dad" can freely register and delete data to be played back, using the dad menu display tag 701 as his own folder.



EX2019, at ¶¶[0024]-[0025]; Figs. 6-7; EX2021, ¶40.

As can be seen from the foregoing, Terms 1-3 are well supported in the priority application, and certainly by December 2, 2004. EX2021, ¶41.

D. Person Of Ordinary Skill In The Art

At the time of the '815 Patent, a POSITA would have a Bachelor of Science degree in Electrical Engineering, Computer Engineering, Computer Science, Human Control Interface, or a related technical field, with at least one year of experience working in the field of user interfaces and/or content management. EX2021, ¶42. More education (*e.g.*, a Master's degree) or work experience may compensate for a deficit in one of the relevant qualifications stated above. *Id.* While this definition differs from the definition of POSITA offered by Petitioner, for purposes of this Preliminary Response, there is no practical difference between the two definitions.

E. Summary Of Petitioner's Proposed Grounds Of Unpatentability And The References Cited

The Petition raises five grounds of alleged obviousness based on the following six references:

Ground	'815 Patent Claim(s)	Type of Challenge	Primary Reference	Secondary Reference(s)
6	16-19, 21-25	§ 103	Horn	(1) Baumgartner (2) Candelore
7	20, 26, 27	§ 103	Horn	(1) Baumgartner (2) Candelore (3) WinTV
8	16-27	§ 103	Horn	(1) Baumgartner (2) Candelore (3) WinTV (4) Chao
9	16-19, 21-25	§ 103	Kaplan	(1) Bryant (2) Wong (3) Candelore

10	20, 26, 27	§ 103	Kaplan	(1) Bryant (2) Wong (3) Candelore (4) WinTV
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1. Horn (EX1005)

Horn, titled “Computer System for Automatic Organization Indexing and Viewing of Information from Multiple Sources,” was filed on July 16, 2003 and issued on September 25, 2007.

Horn discloses a computer data processing system including a central processing unit configured with an integrated computer control software system for the management of data objects including dynamic and automatic organization, linking, finding, cross-referencing, viewing and retrieval of multiple objects regardless of nature or source. EX1005, Abstract

2. Baumgartner (EX1016)

Baumgartner, titled “Interactive Television System with Custom Video-On - Demand Menus Based on Personal Profiles,” was filed on January 21, 2004 and published on July 21, 2005.

Baumgartner discloses an interactive television system in which a user can use an interactive television application to access and request media-on-demand programming. The interactive television application may display customized interface display screens that include video-on-demand programs and categories that may be of particular interest to the user. These programs and categories of interest

may be based on the user's personal profile. Once a list of programs and categories based on a user's personal profile is generated, one or more of these programs may be incorporated in a menu interface template to generate a video-on-demand menu customized for the user. EX1016, Abstract.

3. WinTV (EX1010)

WinTV purports to be an "Installation and Reference Manual" for the WinTV product. Petitioner contends that WinTV "was a product offered for sale/sold in the U.S. by Hauppauge Computer Works, Inc. at least by 11/10/1999." As evidence of this, Petitioner includes Exhibit 1011. As set forth further below, Petitioner has not provided sufficient evidence to show that WinTV was publicly accessible. For this reason, Grounds 7, 8, and 10 fail to show with a reasonable likelihood of success of prevailing.

a. 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. Maxell reserves the right to challenge this evidence in the event this proceeding is instituted. 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.

“[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 United States. EX1011, upon which Petitioner relies, is an unauthenticated Internet Archive web page apparently accessed by Petitioner 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. It is undisputed that the link <https://web.archive.org/web/20030914203323/http://www.hauppauge.com:80/manuals/wintvpci.pdf> takes a user in 2024 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. EX2021, ¶57. For example, if one navigates 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), there is no discernable link to current or archived manuals. EX2021, ¶56. Even further exploring some of the links on the home page fail to provide accessibility to product manuals. *Id.* The inability to access the manual through the archived web page during the 2003 timeframe suggests 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. *Id.* Petitioner has failed to provide sufficient evidence that the WinTV manual was publicly accessible prior to the critical date. Rather, it appears that only Hauppauge employees would know where to access the manuals in 2003. EX2021, ¶57. “[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. Petitioner has not shown how the WinTV was publicly accessible on the Hauppauge web page in a manner that was accessible to POSITA or persons other than the ones who created the manual.

4. Chao (EX1006)

Chao, titled “Method and Apparatus for Archiving and Visualizing Digital Images,” was filed on December 17, 2002 and issued on June 28, 2011. Chao discloses a computer-based, digital image management system that visually presents

an entire archive in a manner that facilitates easy, non-textual, searching for specific images. EX1006, Abstract.

5. Kaplan (EX1014)

U.S. Patent App. Pub. No. 2001/0056434 titled "Systems, Methods, and Computer Program Products for Managing Multimedia Content" by Jon Kaplan et al. ("Kaplan") was filed on March 29, 2001 and was published on December 27, 2001.

Kaplan discloses a multimedia management system for storing, manipulating, and displaying multimedia content. EX1014 at Abstract, ("The present invention is a multimedia management system for storing, manipulating, and displaying multimedia content. The system comprises a user interface, a plurality of predefined functions, a multimedia acquisition interface, and system controls. The system provides users with a simple and intuitive method and computer program for reviewing multimedia content, which can include digital video, digital audio and text, still images, animation, and MIDI.").

6. Bryant (EX1015)

U.S. Patent App. Pub. No. 2004/0201691 titled "Method for Producing Electronic Job Pages" by Steven Bryant et al. ("Bryant") was filed on April 11, 2003 and was published on October 14, 2004.

Bryant discloses a method for producing a plurality of electronic job pages using a digital camera and a computer. EX1015, Abstract, (“A method for producing a plurality of electronic job pages using a digital camera and a computer comprises the steps of capturing and storing a first group of digital images using the digital camera; designating, in response to a user input, that subsequent captured digital images are to form a second group of digital images; and capturing and storing a second group of digital images using the digital camera.”)

7. Candelore (EX1013)

U.S. Patent Application Publication No. 2003/0174844 to Candelore describes a method for scrambling and descrambling program data comprising the receipt of a mating key generator message including a manufacturer identifier. The mating key generator message is transmitted to a first remote source identified by the manufacturer identifier. In response, a mating key is received from the first remote source. Then, the mating key is supplied to a second remote source, the mating key being subsequently used to encrypt a service key used for scrambling program data. EX1013, Abstract.

8. Wong (EX1007)

U.S. Patent No. 7,650,361 to Wong titled “Media content modification and access system for interactive access of media content across disparate network platforms” was filed July 21, 2005 and issued on January 19, 2010. As set forth

above in Section III.C, all limitations of Claims 16-27 are fully supported prior to the filing of Wong. As such, Wong is not prior art.

F. Claim Construction

It is Petitioner's burden to propose a construction and then explain how the construed claim is unpatentable under that proposed construction. See 37 C.F.R. § 42.104(b)(4). As Patent Owner explains herein, the Petition fails to meet this burden. Given the multiple reasons why the Petition should not be instituted, including 35 U.S.C. § 325(d) and 35 U.S.C. § 314, and to minimize the disputes that the Board needs to address at this preliminary stage, for the purposes of this Preliminary Response only, Patent Owner simply applies Petitioner's own constructions to show how the Petitioner has not met its burden under 37 CFR § 42.104(b)(4).

Patent Owner, however, reserves all rights to dispute Petitioner's proposed construction with the support of expert testimony to the extent the Board decides to institute review of this Petition. Any statements made herein with respect to the lack of a claim element in a prior art reference are under Petitioner's proposed constructions and should not be construed as an admission on behalf of Patent Owner that such construction is proper under the *Phillips* standard.

G. Ground 6: Petitioner Fails To Establish That Claims 16-19 and 21-25 are Rendered Obvious By Horn in View of Baumgartner and Candelore

Petitioner has not shown a likelihood of prevailing with respect to Ground 6

because Horn in view of Baumgartner does not teach each and every element of Claims 16-19 and 21-25. Specifically, Horn in combination with Baumgartner and Candelore does not teach elements 16[a], 16[c], 16[h] (and comparable elements of claim 21: 21[a], 21[c], 21[h]), as required for each of these claims. Additionally, because dependent claims 17-19 and 22-25 depend from claim that Petitioner has not shown to be unpatentable, Petitioner has also failed to show that claims 17-19 and 22-25 are unpatentable by Horn in view of Baumgartner and Candelore.

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. EX2021, ¶61. Petitioner's statement as to why Horn and Baumgartner should be combined is conclusory and unsupported by sufficient evidence and analysis.

First, a POSITA would not be motivated to combine Horn with Baumgartner because they are two different systems. EX2021, ¶65. The problem solved by Horn is unrelated to the technical problems addressed by Baumgartner. 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); EX2021, ¶65. 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; EX2021, ¶67. 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. EX2021, ¶68.

Second, the Petitioner fails to provide any rationale as to why a POSITA would substitute the hardwired LAN of Horn with the wireless modem of Baumgartner. EX2021, ¶69. 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 ’815 Patent’s invention is also incorrect. EX2021, ¶70. 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. EX2021, ¶70.

Third, and more importantly, a POSITA would not be motivated to combine components from Baumgartner to Horn because that would defeat Horn's intended use. EX2021, ¶71. Petitioner states that a POSITA would have considered obvious to include the wireless communication from Baumgartner in Horn. Pet. at 21-22. This is incorrect. EX2021, ¶71. As discussed above, Horn discloses a distributed computer system having data structures that permits **faster** archiving, retrieval and viewing information. Horn further discloses "[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." EX1005, 6:59-63. In addition, Horn further explains that "[i]n a net-worked environment, the program modules may be distributed among several computing devices coupled to the network, and used as needed." EX1005, 7:7-10.

A POSITA would have understood that at the time of '815 Patent 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. EX2021,

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¶74. In particular, at the time of '815 Patent, the wireless communication protocols (802.11b/g) offered communication speed much slower than that of wired ethernet:

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; EX2021, ¶74. At the time of the '815 Patent, 100 Mbps LAN was widespread in homes and businesses. For WLAN (Wi-Fi), 802.11b offered up to 11 Mbps, 802.11g up to 54 Mbps, and 802.11a up to 54 Mbps but less common than 802.11g due to higher cost and shorter range. Further, the actual usable wireless rates are lower than the radio bitrate due to high overhead (up to 50%). EX2021, ¶74, n.3

In addition, by reviewing Horn, 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. Therefore, a POSITA would not have been motivated to include Baumgartner's wireless communication in Horn, as wireless communication has additional security vulnerabilities than a wired network:

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 (annotated); EX2021, ¶75.

At the time of the claimed invention, the reliability of wired LAN was greater than wireless LAN (WLAN) that could suffer from coverage holes and/or dropped connections. EX2021, ¶76. In sum, Petitioner's statements are conclusory and are unsupported by sufficient evidence and analysis to why Baumgartner and Horn should be combined. *Id.* Moreover, when evaluating claims for obviousness, "the prior art as a whole must be considered. The teachings are to be viewed as they would have been viewed by one of ordinary skill." *In re Hedges*, 783 F.2d 1038, 1041 (Fed. Cir. 1986). Accordingly, "[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." *Id.* (quoting *In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965)).

Therefore, a POSITA would not have been motivated to combine Baumgartner with Horn.

1. Dr. Bederson's Opinions Regarding the Combination Of Horn and Baumgartner Should Be Disregarded

"*Daubert* and Rule 702 are safeguards against unreliable or irrelevant opinions," such as those offered by Dr. Bederson. *I4i Ltd. P'ship v. Microsoft Corp.*, 598 F.3d 831, 854 (Fed. Cir. 2010). Dr. Bederson's qualifications and background

make clear that his expertise lie in the fields of computer science and user interfaces, not wireless communication or networking. Yet Dr. Bederson offers opinions pertaining to a POSITA's understanding of implementing wireless communications without having any relevant experience. Accordingly, his opinions should be afforded no weight.

Dr. Bederson summarizes his experience in user interfaces, but notably excludes any skills, knowledge, education, experience, or training regarding wireless communications. Specifically, Dr. Bederson holds a B.S., M.S., and Ph.D. in Computer Science and currently teaches Computer Science with a focus on human-computer interaction ("HCI"). EX1003, ¶¶7-8. He describes his own experiences as focusing on "the design and implementation of *software* applications" for interactive computing systems. EX1003, ¶9 (emphasis added). He then describes his various projects in software platforms, user interface designs, websites, and robotics developments. EX1003, ¶¶11-13.

However, Dr. Bederson does not describe any relevant experience in wireless communications. Dr. Bederson is not qualified to offer the conclusory opinion that a "POSITA would have been motivated to use a wireless modem to implement a wireless connection" and other similar opinions throughout his declaration. EX1003, ¶366; *see also* EX1003, ¶¶283, 330, 367, 414. These conclusory statements demonstrate a lack of understanding of wireless networks and its state at the relevant

time period. EX2021, ¶69. Accordingly, the Board should afford such opinions no weight.

2. The Combination of Horn, Baumgartner, and Candelore Fails to Disclose Limitation 16[a] and 21[a]

Petitioner fails to show that Horn in combination with Baumgartner and Candelore discloses claim elements 16[a] and 21[a]: receiving, via a network, first video information wirelessly from a device external to the information processing apparatus, the first video information being received including second video information that is encrypted.

Specifically, Petitioner admits that “Horn does not expressly disclose receiving digital video information wirelessly.” Pet. at 27. 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.

Petitioner tries to plug this deficiency by simply pointing to Horn's LAN. 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. EX2021, ¶¶65-76. 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 directed to different solution, the wireless card is not cheaper to replace a wired card as Petitioner claims, and Horn will stop performing its intended use by replacing its wired communication with wireless communication. *Id.*

Therefore, because Petitioner has not shown Horn in view of Baumgartner and Candelore discloses claim elements 16[a] and 21[a], there is no reasonable likelihood of success of any claim challenged in Ground 6.

3. The Combination of Horn, Baumgartner, and Candelore Fails to Disclose Limitation 16[c] and 21[c]

Petitioner fails to show that Horn in combination with Baumgartner and Candelore discloses “the plurality of **user profiles** being associated with **video information** and the first user interface including an option for a user to select the first user profile from the plurality of user profiles by selecting the first character” as required by claim elements 16[c] and 21[c]. Petitioner proposes that the “user profile” term “should be construed as requiring data representing **distinctive features** and **characteristics** of a user.” Pet. at 8 (emphasis added).

However, the petition never addresses or applies its proposed construction of “user profile” while analyzing Horn, Baumgartner, or any other references. Specifically, Petitioner fails to meet its burden to explain how the prior art meets

its proposed construction. *See* 37 CFR § 42.104(b)(4) (“It is Petitioner’s burden to propose a construction and then explain how the construed claim is unpatentable.”).

Petitioner points to some disclosures in Horn and Baumgartner in an attempt to show that a plurality of video information is associated with a user profile. *See, e.g.,* Pet. at 33-34. However, Petitioner provides no reasoning or explanation as to how or why the disclosures in Horn and Baumgartner teach or suggest the claimed “user profile” as construed by Petitioner itself to include two requirements, such as “representing **distinctive features** and **characteristics** of a user.” Petitioner fails to describe these two features in Horn and Baumgartner and has left it for the Board to plug the gap. “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). It is Petitioner’s burden to propose a construction and then explain how the construed claim is unpatentable. *See* 37 CFR § 42.104(b)(4). The Petition fails to do so. Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

Petitioner has failed to identify with particularity evidence showing how the cited art teaches or suggests its own offered “user profile” construction. Thus,

Petitioner has not established that the cited art teaches or suggests “wherein at least some of the plurality of video information is associated with a user profile.”

In addition, 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 via a network interface, as discussed above. The Petition's deficiency in regard to element 16[c] can be seen by Petitioner's elimination of any contention that Horn discloses the “video information”: “Horn also discloses that ‘[u]ser-defined categorization is enabled by a user directly specifying that a given object belongs to a given collection.’” Petition at 34.

Therefore, Petitioner failed to establish a reasonable likelihood of success of any claim challenged in Ground 6.

4. The Combination of Horn, Baumgartner, and Candelore Fails to Disclose Limitation 16[h] and 21[h]

Petitioner fails to show that Horn in combination with Baumgartner discloses claim element 16[h] and 21[h]: “displaying the second character and a second group of thumbnails corresponding to a second group of video information associated with the second user profile when the second character is selected.”

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. The Petition's deficiency in regard to element 16[h]/21[h] 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 found it obvious to display a second group of thumbnails representing content corresponding to a second user profile when the second profile is selected." Pet. at 39.

Therefore, Petitioner failed to establish a reasonable likelihood of success of any claim challenged in Ground 6.

H. Ground 7: Petitioner Fails To Establish That Claims 20, 26, and 27 are Rendered Obvious By Horn in View of Baumgartner, Candelore, and WinTV

For Ground 7, 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 48-55. As set forth above in Section II.E.3, 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. Ground 7 fails for this reason alone.

Additionally, 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. A POSITA wouldn't be motivated to combine Horn with WinTV because they are two different systems. EX2021, ¶78.

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). EX2021, ¶78. 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. EX2021, ¶79.

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. 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. EX2021, ¶80.

Therefore, Petitioner failed to establish a reasonable likelihood of success of any claim in Ground 7 and institution should be denied.

I. Ground 8: Petitioner Fails To Establish That Claims 16-27 are Rendered Obvious By Horn in View of Baumgartner, Candelore, 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 Candelore, WinTV, and Chao with any expectation of success. Again, 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. Ground 8 fails for this reason alone.

Additionally, Petitioner has provided only conclusory statements regarding the combination of these references and has failed to identify how each claim element will be mapped against these **five** references. *See KSR*, 550 U.S. at 417 (Obviousness showing requires “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”); *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) (“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. 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. EX2021, ¶82. Additionally, the Petition does not provide any information regarding how a POSITA would get access to OS code running on the Horn computer, and even if access to the code was possible, Chao does not provide the guidance regarding which lines of code, among thousands of lines of code, in Horn's OS code need to be modified to implement the changes. Petitioner has simply provided conclusory statements without any factual support for combining these references. *See In re Nuvasive, Inc.*, 842 F.3d 1376, 1383 (Fed. Cir. 2016) (conclusory statements “insufficient articulations of motivation to combine” references).

Therefore, Petitioner failed to establish a reasonable likelihood of success of any claim in Ground 8 and institution should be denied.

J. Grounds 9-10 Fail Because Kaplan, Bryant, Wong, and Candelore Do Not Disclose Elements 16[a], 16[c], 16[h], 21[a], 21[c], and 21[h] Either Alone Or In Combination

As with prior grounds, Petitioner relies on cursory analysis in an attempt to utilize Kaplan, Bryant, Wong, and Candelore to show Claims 16-27 are unpatentable. However, Petitioner fails to show Kaplan and Bryant, either alone or together, render the claims unpatentable. Additionally, Grounds 9 and 10 fail because Wong is not prior art, and Petitioner relies on Wong for all claims of Grounds 9 and 10. Finally, because Claims 20, 26, and 27 all depend on Petitioner's faulty analysis with respect to Claims 16 and 21, Ground 10 fails for this additional reason.

1. Petitioner Does Not Adequately Articulate a Combination of Kaplan's, Bryant's, Wong's, and Candelore'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 9 and 10 fail and should not be instituted.

First, the Petition consistently recites what Kaplan, Bryant, Wong, and Candelore purportedly teach *individually* (e.g., Pet. at 67-68 (“The Kaplan-Bryant-Wong-Candelore combination renders this limitation obvious. Bryant discloses....Kaplan discloses...Moreover, Candelore renders obvious”)) 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-Wong-Candelore combination cannot meet its burden to establish a reasonable likelihood of success. *ADT LLC v. Vivint, Inc.*, IPR2022-00642, Paper 7 at 13-14 (PTAB Oct. 4, 2022) (denying institution where the petition mapped each limitation to both reference but “without any discussion of the interplay between these two references”).

The Petition is organized such that Petitioner attempts to address the combination of Kaplan, Bryant, Wong, and Candelore and alleged motivation to combine up front, Petition at 61-66, and then the Petition makes fleeting references of the purported combination within individual limitations. *See, e.g.*, Pet. at 76-79 (limitation 16[f]), 81-83 (limitation 16[h]). 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, Bryant, Wong, and Candelore would have suggested to a POSITA.

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 62. However, these vague suggestions merely parrot portions of Kaplan and Bryant. 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 62-63. Such "conclusory statements alone" are "insufficient articulations of motivation to combine." *In re Nuvasive, Inc.*, 842 F.3d 1376, 1383 (Fed. Cir. 2016). Petitioner's motivations for adding Wong to the Kaplan-Bryant combination (Pet. at 63-65 discussing "multiple user profiles") and Candelore with Kaplan-Bryant-Wong (Pet. at 66 discussing "encrypted content") fair no better.

Further, Petitioner's limitation-specific analysis of the independent claim merely discusses the teachings of Kaplan, Bryant, Wong, and Candelore 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 16, Petitioner's discussion of each reference and the purported combination²:

² The argument applies equally to Petitioner's analysis of Claim 21 because it simply refers back to the Claim 16 analysis.

Claim Limitation	Petitioner's Asserted Reference
[16pre]	"To the extent the preamble is limiting, Kaplan discloses it." Pet. at 66.
[16a]	"This Kaplan-Bryant-Wong-Candelore combination renders this limitation obvious." Pet. at 67 (discussing Kaplan, Bryant, and Candelore individually without discussing the combination or Wong)
[16b]	"Kaplan-Bryant in combination with Wong renders obvious this limitation." Pet. at 69 (discussing Bryant and Wong individually without discussing the combination, Kaplan, or Candelore) "To the extent not disclosed by Kaplan-Bryant, Wong discloses..." Pet. at 70 ³
[16c]	"Kaplan-Bryant in combination with Wong renders this limitation obvious." Pet. at 73 (no mention of Kaplan, Bryant, or Candelore)
[16d]	"Kaplan-Bryant in combination with Wong renders this limitation obvious." Pet. at 73 (no mention of Kaplan, Bryant, or Candelore)
[16e]	"Kaplan-Bryant in combination with Wong renders this limitation obvious." Pet. at 74 (discussing Wong and Kaplan

³ See *infra* for further explanation as to why this language has been rejected by the PTAB.

	individually without discussing the combination, Bryant, or Candelore)
[16f]	“Kaplan-Bryant in combination with Wong renders this limitation obvious.” Pet. at 76 (discussing Wong and Kaplan individually without discussing the combination, Bryant, or Candelore)
[16g]	“Kaplan-Bryant renders this limitation obvious.” Pet. at 79 (discussing Kaplan and Wong individually without discussing the combination, Bryant, or Candelore)
[16h]	“Kaplan-Bryant renders this limitation obvious.” Pet. at 81 (discussing Kaplan and Wong individually without discussing the combination, Bryant, or Candelore)
[16i]	“Kaplan renders this limitation obvious.” Pet. at 84 (discussing Kaplan and no mention of the combination, Bryant, Wong, or Candelore)
[16j] and [16k]	“Kaplan and Bryant disclose and/or render obvious these limitations obvious.” Pet. at 84 (no discussion of the combination, Wong, or Candelore) “To the extent that these limitations are not disclosed or obvious over Kaplan, they are disclosed or at least obvious over Bryant.” Pet. at 87
[16l]	“Kaplan-Bryant renders this limitation obvious.” Pet. at 90 (discussing Kaplan and no mention of the combination, Bryant, Wong, or Candelore)

[16m]	"Kaplan-Bryant-Wong in combination with Candelore renders this limitation obvious" Pet. at 92 (providing pincites without any analysis)
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The Petition never stays true to one primary reference and secondary references in this combination. Rather, the Petition simply ignores one or more references in favor of others in some limitations and oftentimes alleges to discuss the "Kaplan-Bryant combination" or the "Kaplan-Bryant-Wong combination" while only relying on a single reference. 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 limitations 16[j] and 16[k], Petitioner cites paragraphs 89-106 (over three columns), and figures 9A-9C of Kaplan without explanation. Pet. at 89. "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, Bryant, Wong, and Candelore 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 when, and what the combined teachings might suggest to a POSITA.⁴

Moreover, instituting an IPR on such a Petition would prejudice Patent Owner. Because Patent Owner is unable to discern the manner in which Petitioner suggests Kaplan, Bryant, Wong, and Candelore should be combined, Patent Owner is limited in its ability to address some unspecified combination of disclosures from the Petition. *T-Mobile US, Inc. v. TracBeam LLC*, IPR2015-01687, Paper 10 at 20 (PTAB Feb. 12, 2016) (“We will not...improperly shift the burden of deciphering the arguments onto the Patent Owner”). Indeed, institution would enable Petitioner to develop arguments not initially presented in the Petition. This is also improper. *ADT*, IPR2022-00642, Paper 7 at 13-14.

Petitioner's choice to discuss the teachings of Kaplan, Bryant, Wong, and Candelore separately rather than to discuss “the contemplated workings of the

⁴ As set forth below, Maxell is not collaterally estopped from arguing that Petitioner failed to meet its burden with respect to claim element 16[j]/16[k].

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, Bryant, Wong, and Candelore is further exacerbated by Petitioner's inclusion of a third reference, Horn. For limitation 16[h], the Petition contends that “Kaplan-Bryant renders this limitation obvious.” Pet. at 81. But then, without providing any motivation to combine references, the Petition bring in the teachings of Horn to replace text with graphical thumbnails. Pet. at 83. Such omission of a motivation to combine Horn with Kaplan and Bryant (let alone the combination of Kaplan, Bryant, Wong, and Candelore) 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, after contending that Kaplan and/or Bryant alone discloses limitations 16[b], 16[j], 16[k], Pet. at 69, 85, the Petition then states that “**to the extent that** these limitations are not disclosed or obvious over Kaplan, they are disclosed or at least obvious over Bryant.” Pet. at 87; *see also* Pet. at 69 (similar language in 16[b]). However, the Petition is silent as to what circumstances Kaplan would not disclose these limitations. “There is, therefore, no indication in the Petition that [Kaplan] has

any deficiencies related to th[ese] element[s]. 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].” See *LG Elecs., Inc. v. Cellular Comm’ns Equip. LLC*, IPR2016-00197, Paper 7 at 8 (PTAB Apr. 29, 2016) (denying institution where the Petition uses “to the extent that” language in an alleged obviousness combination). For this additional reason, the Kaplan-Bryant-Wong-Candelore combination fails.

Therefore, Petitioner failed to establish a reasonable likelihood of success of any claim in Grounds 9-10 and institution should be denied for this reason alone.

2. The Combination of Kaplan, Bryant, Wong, and Candelore Fails to Disclose Limitation 16[a] and 21[a]

Petitioner argues that that Bryant discloses “ **receiving, via a network, first video information wirelessly** from a device external to the information processing apparatus, the first video information being received including second video information that is encrypted,” as required by claim element 16[a] and 21[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 “ **receiving, via a network, first video information wirelessly**” from an external device. 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 an external device. The Petitioner recognizes this deficiency in Kaplan-Bryant combination when it states that “[r]eceiving this video information wireless via a wireless modem at the Kaplan-Bryant PC would have been obvious to a POSITA for the reasons discussed above.” Pet. at 68.

Therefore, Petitioner failed to establish a reasonable likelihood of success of any claim in Grounds 9-10 and institution should be denied.

3. The Combination of Kaplan, Bryant, Wong, and Candalore Fails to Disclose Limitation 16[c] and 21[c]

Petitioner fails to show that Kaplan in combination with Bryant, Wong, and Candalore discloses claim elements 16[c] and 21[c]: the plurality of **user profiles** being associated with **video information** and the first user interface including an option for a user to select the first user profile from the plurality of user profiles by selecting the first character.” The Petitioner proposes that the “user profile” term “should be construed as requiring data representing **distinctive features** and **characteristics** of a user.” Pet. at 8 (emphasis added). However, the petition does not address its proposed construction of the “user profile” term while analyzing Kaplan or other references. Specifically, the Petitioner fails to meet its burden to explain how the prior art meets its proposed construction. See 37 CFR § 42.104(b)(4) (“It is Petitioner’s burden to propose a construction and then explain how the

construed claim is unpatentable.”).

Petitioner points to some disclosures of Wong in attempting to show that plurality of video information is associated with a user profile. Pet. at 73. However, Petitioner provides no reasoning or explanation as to how or why the disclosures in Wong teach or suggest the claimed “user profile” as construed by Petitioner itself to include two requirements, such as “representing **distinctive features** and **characteristics** of a user.” Petitioner fails to point out these two requirements in Bryant’s disclosures and has left it for the Board to plug the gap. The Petition fails to do so. Thus, the Petition does not comply with the requirements set forth in 37 CFR § 42.104, and for this reason alone, the Petition should not be instituted.

Therefore, Petitioner failed to establish a reasonable likelihood of success of any claim challenged in Grounds 9-10.

4. The Combination of Kaplan, Bryant, Wong, and Candelore Fails to Disclose Limitation 16[j]/[k] and 21[k]

Petitioner has failed to show that the combination of Kaplan and Bryant discloses “removing the one video information from the first group of video information, wherein, upon the one video information being removed from the first group of video information, the one video information continues to be included in the second group of video information for the second user profile and the second group of thumbnails continues to display a thumbnail corresponding to the one video

information when the second character is selected” as required by claim elements 16[k] and 21[k] of the '815 Patent.⁵

For limitations 16[j], 16[k], and 21[k] Petitioner cites paragraphs 89-106 (over three columns), and figures 9A-9C of Kaplan without explanation. Pet. at 89. “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, Bryant, Wong, and Candelore 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 when, and what the combined teachings might suggest to a POSITA. See Section III.J.1, *supra*.

Additionally, Maxell 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 16[k]. Pet. at 84.

⁵ Petitioner provides absolutely no analysis for Claim element 21[j]. See Pet. at 96.

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.” EX1009 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 ignores the claim as a whole. For example, the language of claim elements 16[l] and 16[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 EX1001, Claim 16.

As such, Maxell is not estopped from arguing that Petitioner has failed to meet its burden of showing Bryant and Kaplan render claim 16 unpatentable with respect to claim element 16[k]/21[k].

IV. CONCLUSION

For at least the foregoing reasons, the Board should deny institution of the Petition.

Dated: August 12, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 12th day of August, 2024, a copy of the attached PATENT OWNER PRELIMINARY 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:

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Respectfully submitted,

Date: August 12, 2024

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 Preliminary Response 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 Preliminary Response indicates that the Preliminary Response contains 13,975 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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