

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

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

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PETITIONER'S EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,017,815
1002	File History of U.S. Pat. 11,017,815
1003	Declaration of Dr. Benjamin Bederson
1004	CV of Dr. Benjamin Bederson
1005	U.S. Patent No. 7,275,063 ("Horn")
1006	U.S. Patent No. 7,970,240 ("Chao")
1007	U.S. Patent No. 7,650,361 ("Wong")
1008	Declaration of Nathaniel E. Frank-White
1009	<i>Fandango Media, LLC v. Maxell, Ltd.</i> , IPR2018-01432, Paper 32 (PTAB Feb. 10, 2020) ("01432FWD")
1010	WinTV Installation and Reference Manual (June 30, 1999) ("WinTV")
1011	Archived Specifications - WinTV PCI boards including the WinCast/TV and WinTV-pci (November 10, 1999) (https://web.archive.org/web/19991110153658/http://hauppauge.com:80/html/wc_data.htm)
1012	Bt848/848A/849A - Single-Chip Video Capture for PCI – Datasheet ("BT848")
1013	U.S. Patent Application Publication No. 20030174844A1 ("Candelore")
1014	U.S. Patent Application Publication No. 20010056434A1 ("Kaplan")
1015	U.S. Patent Application Publication No. 20040201691 ("Bryant")
1016	U.S. Patent Application Publication No. 20050160458A1 ("Baumgartner")
1017	Appendix 5 to PO's January 11, 2024 Infringement Contentions
1018	U.S. Patent No. 6,259,418 ("Jones")
1019	U.S. Patent No. 5,911, 129 ("Towell")
1020	JP-A-2000-152180
1021	Machine Translation of JP-A-2000-152180
1022	U.S. Patent No. RE32,632 to Atkinson
1023	Brent Ethington, <i>Introducing Microsoft Windows 95</i> , Microsoft Press (1995), with authenticating declaration of Carmen Debord
1024	U.S. Patent No. 6,493,006 to Gourdol et al.
1025	Microsoft Computer Dictionary, 4th Ed., Microsoft Press (1999)
1026	James Cohoon & Jack Davidson, C++ Program Design: An

Exhibit No.	Description
	Introduction to Programming and Object-Oriented Design, 3rd Ed., McGraw Hill (2002)
1027	George W. Furnas and Jeff Zacks, 1994, <i>Multitrees: Enriching and Reusing Hierarchical Structure</i> , In Proceedings of the SIGCHI Conference on Human Factors in Computer Systems (CHI 1994), Beth Adelson, Susan Dumais, and Judith Olson (Eds.), ACM, New York, NY, USA, 330-336. DOI http://dx.doi.org/10.1145/191666.191778 , with authenticating declaration of Scott Delman.
1028	U.S. Patent Application Publication No. 2004/0064476 to Rounds (“Rounds”)
1029	U.S. Patent Application Publication No. 2002/0082730 to Capps et al. (“Capps”)
1030	U.S. Patent No. 6,166,735 to Dom et al. (“Dom”)
1031	U.S. Patent No. 5,884,056 to Steele (“Steele”)
1032	U.S. Patent No. 5,442,744 to Piech et al. (“Piech”)
1033	U.S. Patent Application Publication No. 2006/0107289 to DeYonker et al. (“DeYonker”)
1034	Benjamin B. Bederson, 2001, PhotoMesa: A Zoomable Image Browser Using Quantum Treemaps and Bubblemaps, In Proceedings of the 14th annual ACM symposium on User Interface Software and Technology (UIST 2001), ACM, New York, NY, USA, 71-80. DOI http://dx.doi.org/10.1145/502348.502359
1035	U.S. Patent No. 6,609,253 to Swix et al. (“Swix”)
1036	U.S. Patent Application Publication No. 2004/0078383 to Mercer et al. (“Mercer”)
1037	WIPO Patent Publication No. WO 02/32122
1038	U.S. Patent No. 5,767,897
1039	“Windows XP Media Center Exposed” (AnandTech, January 8, 2003)
1040	File History of U.S. Patent No. 10,679,674
1041	File History of U.S. Patent No. 10,199,072
1042	File History of U.S. Patent No. 9,818,449
1043	File History of U.S. Patent No. 9,384,783
1044	File History of U.S. Patent No. 8,644,684
1045	File History of U.S. Patent No. 7,613,383
1046	Ex. 2002 from IPR2018-01432
1047	Excerpt from American Heritage Dictionary (4 th ed. 2000)

Exhibit No.	Description
1048	Excerpt from Microsoft Computer Dictionary (5 th ed. 2002)
1049	U.S. Patent No. 7,292,692 to Bonan et al. ("Bonan")
1050	Printout of https://www.atsc.org/news/security-content-protection-high-priorities-for-nextgen-tv/ (visited April 18, 2024)
1051	U.S. Patent No. 5,746,656
1052	U.S. Patent No. 5,729,741
1053	U.S. Patent Appl. Publication No. 200210077170
1054	Where to Buy WinTV. VideoTalk and VideoMagic Products
1055	Archived web page — Hauppauge (September 15, 1999)
1056	Archived web page — Hauppauge (November 17, 1999)
1057	Internet Archive Declaration
1058	11/8/24 email from Roshan Bhattarai to Patron Services Peach (Affidavits)
1059	11/12/24 email from Tanya Blue (Affidavits) to Roshan Bhattarai
1060	12/3/24 email from Roshan Bhattarai to Affidavits
1061	12/11/24 email from Roshan Bhattarai to Affidavits
1062	12/20/24 email from Patron Services Blue (Internet Archive) to Roshan Bhattarai
1063	Declaration of Roshan Bhattarai
1064	Exhibit 1064 from April 1, 2025 Balakrishnan Deposition
1065	Exhibit 1065 from April 1, 2025 Balakrishnan Deposition
1066	Exhibit 1066 from April 1, 2025 Balakrishnan Deposition
1067	Exhibit 1067 from April 1, 2025 Balakrishnan Deposition
1068	Exhibit 1068 from April 1, 2025 Balakrishnan Deposition
1069	Exhibit 1069 from April 1, 2025 Balakrishnan Deposition
1070	Email from Dr. Benjamin Bederson dated April 15, 2004
1071	Excerpts from PC World Magazine, Vol. 21, Num. 10, October 2003
1072	Deposition Transcript of Dr. Ravin Balakrishnan dated April 1, 2025
1073	Internet Archive Declaration

I. INTRODUCTION

The arguments in Maxell's Patent Owner Response ("POR") should be rejected for the reasons discussed below.

II. ARGUMENT

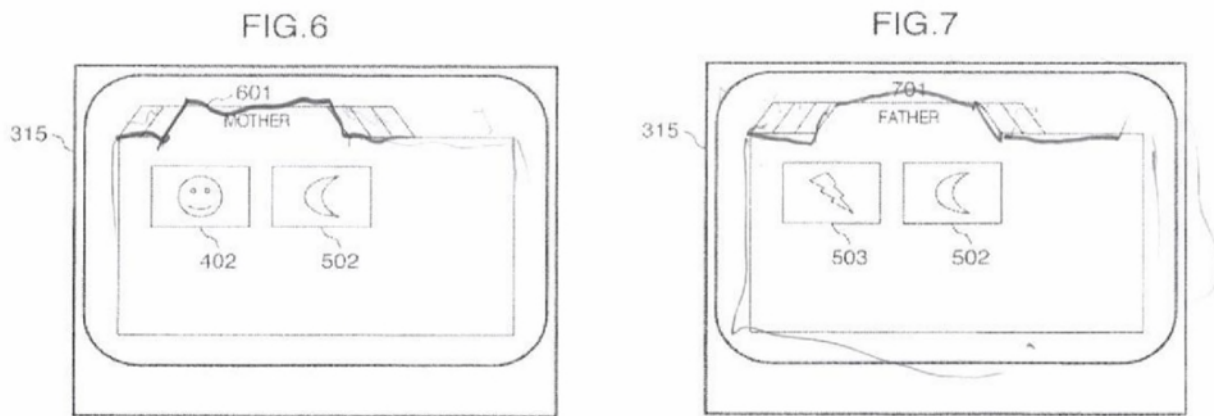
A. Claim Construction

1. "second user interface" terms (claims 16, 21)

The POR construes these terms as requiring, in response to selection of a first user profile, the display of "***a new second user dedicated screen*** for a user to select desired video information to be reproduced from among the first video information." POR, 14-17, citing Balakrishnan Declaration (EX2040), ¶¶42-43 (parroting the POR). The POR states that construction means that a POSITA would understand that this "new second user-dedicated screen" must be a "new screen" that is "separate from the first user interface" from which the user profile was selected. POR, 16, citing EX2040, ¶¶42-43 (parroting the POR). From this language, and from the POR arguments at 31-33, it appeared that Maxell was arguing that the first and second user interface screens must be entirely distinct and cannot appear on the same physical screen at the same time.

However, at his deposition, Dr. Balakrishnan renounced this understanding and clarified that both the first and second user interface screens of claims 16 and 21 may be on the same physical and logical screen at the same time. EX1071, 91:7-96:12. Particularly, the portions that are inside the lines that Dr. Balakrishnan

drew over Figures 6 and 7 in his deposition (the portion of each folder that includes the thumbnails labeled 402, 502 and 503 and the trapezoids labeled as “MOTHER” and “FATHER”) are each the claimed “second user interface,” and the parts of Figures 6 and 7 outside the hand-drawn lines (the small diamond-shape parts that represent other folders) are the claimed “first user interface.”



EX1069, 1.

This about-face makes sense when one considers (1) that there is nothing in the plain language that requires any new, “dedicated screen” (Maxell’s “construction” simply substitutes “new second user dedicated screen” for “second user interface”) and (2) that there is no support for that construction in the ’815 patent’s specification. If the entirety of Figures 6 or 7 were a second user interface, there would be no disclosure of a first user interface anywhere in the ’815 patent.

Notably, Dr. Balakrishnan was unable/unwilling to identify any such disclosure.

EX1072, 102:19-103:22.¹

B. Ground 1: Claims 16-19 and 21-25 Are Obvious Over Horn in View of Baumgartner and Candelore

1. Motivation to Combine Horn and Baumgartner

Maxell's arguments of no motivation to combine, several of which were previously rejected in the ID (Paper 11, 12-15), are flawed and contrary to Horn and Baumgartner.

a. Maxell's Different Systems Argument Fails

First, Maxell repeats its POPR argument that there is no motivation to combine Horn and Baumgartner because Horn is directed toward a computer system whereas Baumgartner is directed toward a set top box. POPR, 38-39; POR, 20-21. This ignores Baumgartner's teaching that its system may be implemented on a personal computer. EX1016, ¶[0082], Fig. 5; Petition, 28-29 (citing same).

¹ Dr. Balakrishnan also asserted that thumbnails 402, 502 and 503 could be the claimed first user interface, but that is clearly wrong because selecting those thumbnails does not cause Figures 6 or 7 to be displayed. EX1072, 98:21-102:16.

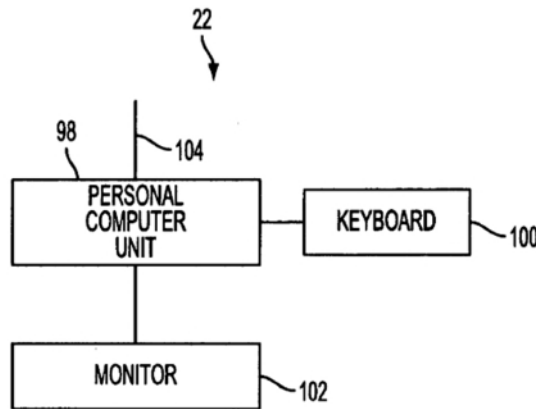


FIG. 5

Maxell also repeats its POPR argument that there is no motivation to combine because “Horn is directed to making ‘collections’ based on keywords in documents, and is not directed toward making any video-on-demand collections based on a user watch history.” POPR, 39; POR, 20-21, citing as support only the Balakrishnan Decl. (EX2040) ¶191 (parroting this same argument without support). This argument is flawed and contrary to Horn and Baumgartner. Horn is not limited to organizing documents, but instead organizes “all types of text and image information-from word processing documents and spreadsheets; to web pages and multimedia; to illustrations, images, *movies*, and photographs; to contacts, notes, and appointments; to sounds and music; *or anything else that is stored and retrieved on a computer.*” EX1005, 12:8-18 (emphasis added) (cited in Petition at 20). Baumgartner is not limited to selecting video-on-demand based on a user’s watch history but instead also discloses selecting television content and

video from a video recorder, and can organize this content based on a user profile which can include data about a user including survey responses, demographic information, interests and other information in addition to watch history. EX1016, ¶¶10, 57, 159. Thus, “Patent Owner has not supported that either reference is nonanalogous art, and therefore it is inapposite that they are different systems.” ID, 14.

b. Maxell's Wireless LAN Cost Argument Fails

Maxell repeats the POPR argument that Petitioner has “failed to provide any rationale as to why a POSITA would substitute the hardwired LAN of Horn with the wireless modem of Baumgartner.” POR, 21; POPR, 33. Maxell focuses on the cost of electronic components but, as discussed in the ID, again ignores the cost of running the wires necessary to support a wired LAN. POR, 21; POPR, 33; ID, 14. This argument is contrary to common sense. It is also contrary to Dr. Bederson's deposition testimony that the cost of running wires to support wired LANs would significantly outweigh the cost of electronic equipment needed for wireless LANs. EX2038, 44:14-48:7; 100:17-101:21. Maxell's argument fails for this reason alone. ID, 14. Moreover, in November 2003, the cost of a Gateway 802.11g wireless router was \$100 and the cost of a Gateway 802.11g wireless notebook card was \$60. EX1071, 16 (excerpted):



Dr. Bederson testified that in 2004, a device that could serve as access point and laptop card was being sold for \$85. EX2038, 45:3-20; EX1070, 1. Thus, the cost difference between wired and wireless LANs was insignificant even without consideration of the cost of running wires for a wired LAN (which makes the wired LAN significantly more expensive).

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

Maxell argues that "Petitioner's analysis of the Horn system is fundamentally flawed because it fails to evaluate the system within the proper context of the prior art." POR, 22. To support this argument, PO makes the following mis-characterizations of Horn's system, none of which appear in Horn's specification:

- "a *specialized, server-based computer* running the Metadata Filing System (MFS), not *just a general-purpose or personal computer*"
- "*designed for high-performance, data-intensive computing*"

- “a ***robust, server-based solution*** that is intended to handle ***large volumes of data***”
- “a server-based solution designed for ***large-scale data processing***,” emphasizes “handling ***vast*** amounts of structured data,”
- “align[s] with ***enterprise-level data management***, including aggregating data from multiple inputs, performing complex indexing operations, and providing structured data views”
- “supports ***high availability, scalability, and efficient handling of extensive data volumes*** . . . commonly associated with ***enterprise data centers***.”

POR, 22-24.

Notably, Maxell relies almost exclusively on its expert's declaration as support for all of these buzz-word filled “context”-based characterizations of Horn. But that declaration mostly parrots the words of the POR without any evidentiary citations or further explanation. EX2040, ¶¶193-199. In fact, the POR and Maxell's expert cite only two portions of Horn as support for these allegations: EX1005, 6:59-63 and 3:10-17; EX2040, ¶¶195-196. Neither of these passages support Maxell's “context”-based arguments that improperly attempt to limit Horn. The first passage at 6:59-63 states:

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

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

The second passage at 3:10-17 states:

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

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

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

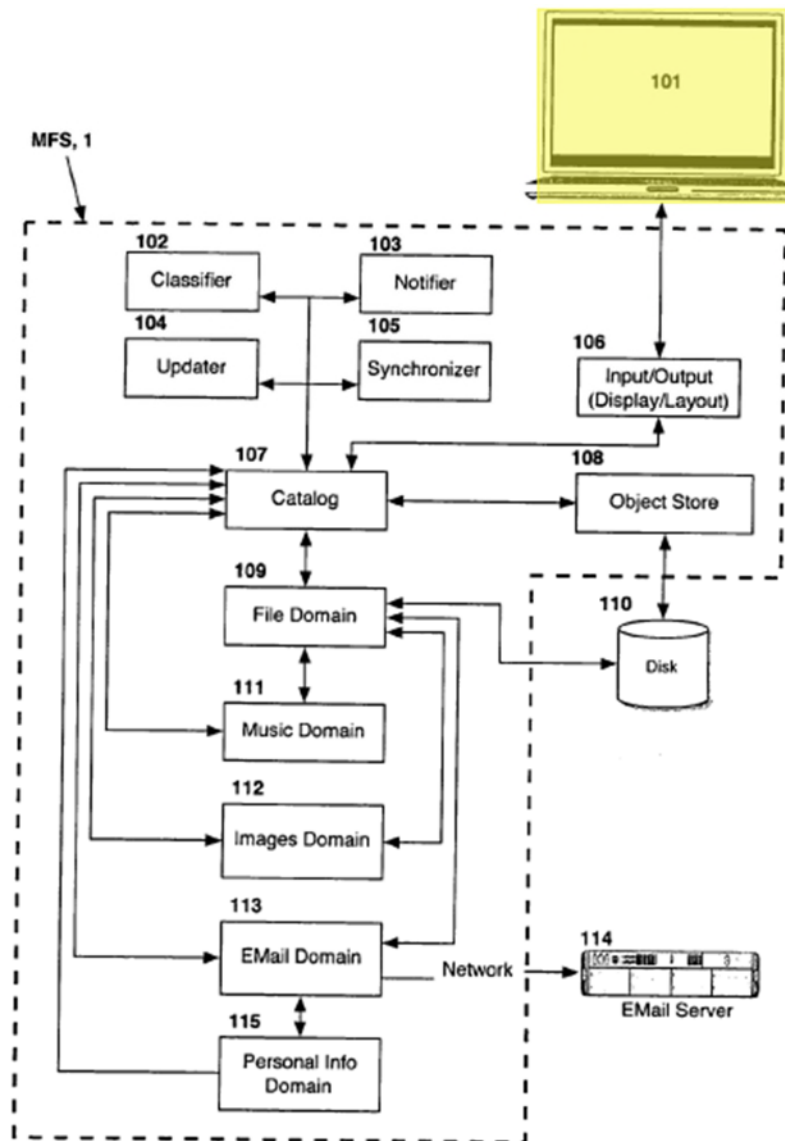


Figure 1

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

The inventive system is remarkably robust, yet is a relatively small application program that can function with any type of Operating System: Microsoft Windows, Windows NT, Windows 2000, and Windows XP; Apple Macintosh OS 9 and OSX; BSD Unix, HP-UX, Sun Solaris, Linux, and the like. Currently the

inventive technology is preferably implemented in its current best mode in a form that is executable on the Apple Macintosh OS9 and OSX operating systems.

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

d. Maxell's Network Speed and Security Arguments Fail

Maxell argues that Horn's system requires "low-latency, high-speed communication" and "data integrity and security are paramount," which purportedly make wireless LANs unsuitable for Horn's system. POR, 24 and 26. However, these assertions are all premised on Maxell's assertion that Horn is limited to enterprise-level server-based systems. That assertion is false for the reasons discussed above, and Maxell's arguments based on this false assertion all fail.

* * *

For all of the reasons discussed above, Maxell has failed to demonstrate any flaw the Board's preliminary determination that the "Petitioner has identified sufficient reason that skilled artisans would have made the [Horn-Baumgartner] combination. ID, 14. Maxell makes no arguments regarding motivation to add Candelore to Horn-Baumgartner, so that argument is waived.

2. The Combination of Horn, Baumgartner and Candelore Discloses Limitations 16[a] and 21[a]

PO largely repeats its POPR argument that the combination of Horn and Baumgartner fails to disclose a recording medium on which a plurality of video information including first video information is stored wirelessly as recited in limitations 16[a] and 21[a]. POPR, 44-45; POR, 28-29. This argument fails for the same reasons stated in the ID at 15-16.

First, Maxell's arguments address Horn and Baumgartner individually rather than addressing their combination. This is improper. *In re Merck & Co., 800 F.2d 1091, 1097* (Fed. Cir. 1986) ("Nonobviousness cannot be established by attacking the references individually where the rejection is based upon the teachings of a combination of references"); ID, 15.

Second, the POR argues that Horn does not disclose receiving videos, which according to Maxell "take[s] up too much storage." POR, 28. This argument ignores Horn's disclosure of movies (at 12:13).

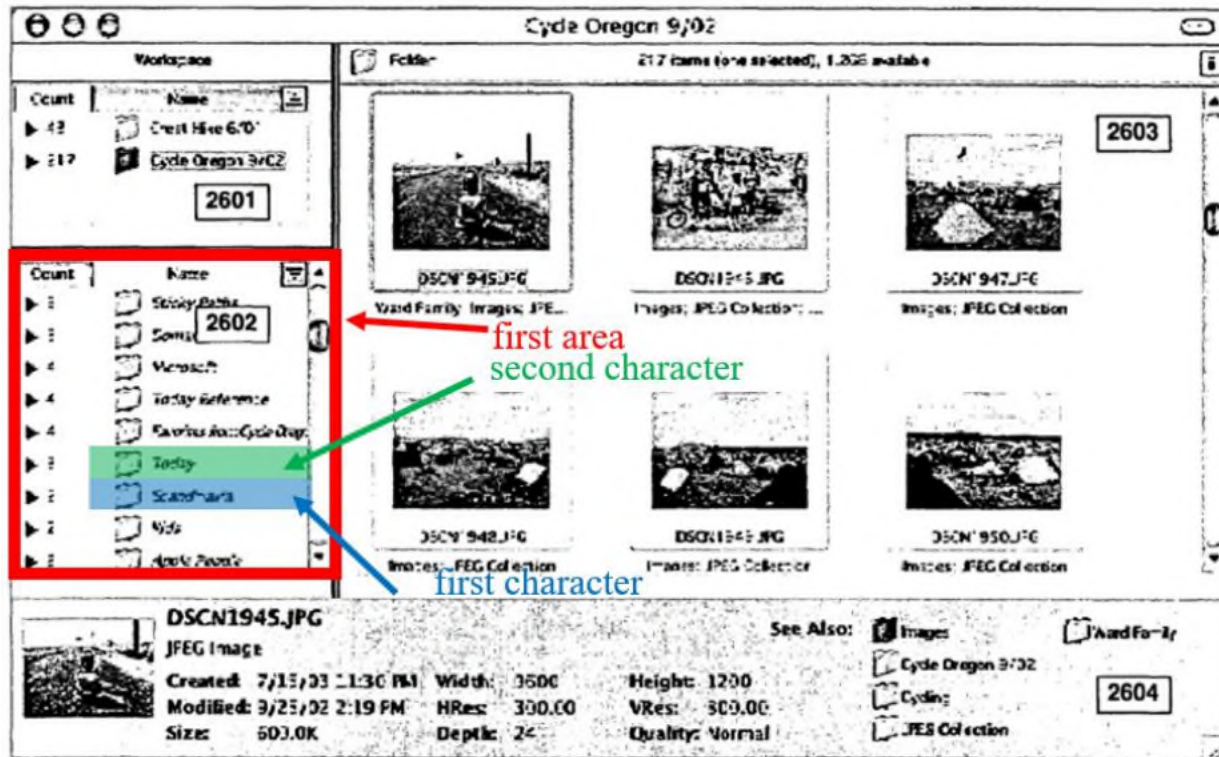
Third, Maxell argues that a POSITA would not be motivated to combine Baumgartner's disclosure of a wireless LAN with Horn, again relying on its cost argument. This argument fails for the reasons discussed above.

3. The Combination of Horn, Baumgartner and Candelore Discloses Limitations 16[b] and 21[b]

As discussed in the Petition at 24, Horn discloses that its system “provide[s] information management tools that facilitate communication to generate, transmit and receive, archive, search, order, retrieve and render objects, *including information organization personalized for each individual user based on preferences selected by the user.*” EX1005, 6:11-22 (emphasis added in Petition). The Petition further cites Horn at 8:58-67, which provides that “[u]sers can select predetermined collections provided in a basic menu such as Family, Friends, Work, To Do, Activities and Vacation when running the MFS program for the first time.” Petition, 24. These citations indicate that Horn's MFS system collections and other settings are particular to users. This is further indicated by Horn's disclosure that its MFS provides PIM (Personal Information Management) domain functionality “that provides a new feature: the ability to organize information object *by person* and by project.” EX1005, 37:66-38:3 (emphasis added). The settings that allow such individual user personalization are clearly a user profile under the Board's construction of that term as “data representing a user's distinctive features or characteristics” because collections of content corresponding

to a user's " Family, Friends, Work, To Do, Activities and Vacation" is data representing a user's distinctive features or characteristics (e.g., one user's To Do list will be different from another user's). These settings also qualify as a user profile under Maxell's proposed construction of " a collection of settings and information associated with a user."

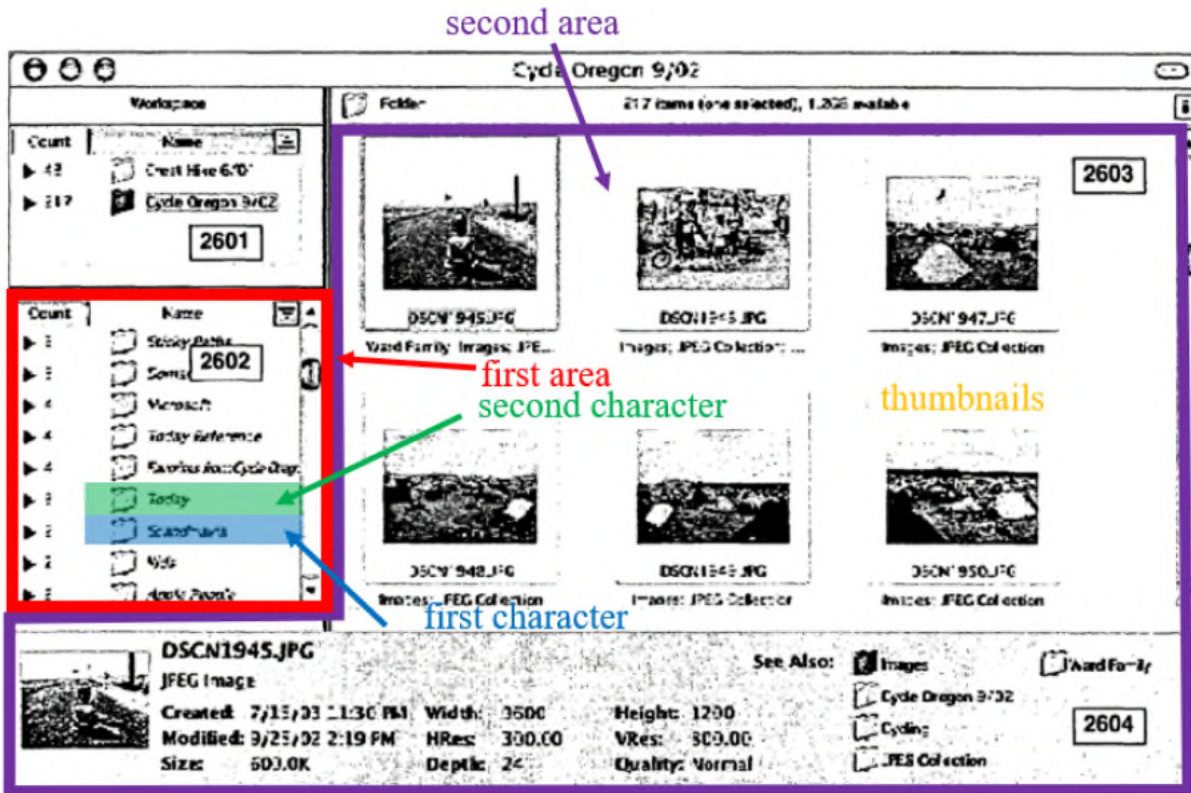
Even if the above disclosures of Horn were insufficient for this limitation, the Petition also relied on disclosures in Baumgartner in which a user selects his/her profile from among a plurality of user profiles "by pressing a button assigned to them" and explains that it would have been obvious to a POSITA to implement these buttons as soft buttons labeled with user names for selecting user profiles in the collections pane 2602 annotated in the red box labeled first area and/or the folder pane 2601 as shown below. Petition 34, citing EX1016, ¶¶165, ¶172.



The POR argues that Baumgartner does not explain how to implement these buttons (POR, 30), but ignores Baumgartner's disclosure of text-labeled GUI buttons 296-314, 336-350, 358-368, and 372-386 in Figs. 24-27 and does nothing to establish that implementing these buttons is beyond the skill of a POSITA. The POR also argues that doing so is "arbitrary and unsupported," but ignores the Petition's citations to Horn for user profile personalization as discussed above.

4. The Combination of Horn, Baumgartner and Candalore Discloses Limitations 16[e]-[h] and 21[e]-[h]

The Petition identifies the area of the Workspace View (Fig. 26) bounded by the purple lines as the second user interface. Petition, 36-37.



The POR argues that “Horn’s Workspace view cannot be the second user interface as the Petitioner already selected it as a first user interface. In particular, ’815 Patent discloses the first and second user interfaces as two separate display screens.” POR, 31-33. This argument depends on the construction of the “second user interface” that is wrong and has been disclaimed by Maxell’s expert, *see* above §II.A.1 (“second user interface” construction), and fails for that reason.

Maxell further argues that limitations 16[e] and 21[e] are not met because pane 2603 would not display anything upon a user selecting a user profile using the above-discussed soft buttons in pane 2602/2601 as discussed above in §II.B.4 until a user selected a folder in panes 2602/2601. POR, 33-34. This is wrong because the

Petition and Dr. Bederson established that it would have been obvious to include soft buttons for selecting user profiles in Horn's Workspace view's panes 2602/2601 (Petition, 32; EX1003, ¶288), that content associated with the user profiles included videos or collections (Petition, 33-36; EX1003, ¶¶290-295), and that selection of the soft button caused the display of content associated with the selected user profile (i.e., video/collections) in panes 2603/2604 as taught by Horn. Petition, 36-37; EX1003, ¶297. This is entirely consistent with Horn's disclosure that panes 2603/2604 display the content associated with an item in panes 2602 or 2601 when that item is selected. EX1005, 19:48-54.

Maxell also argues that the showing in the Petition at 37-38 that it would have been obvious to include the username in metadata pane 2604 of Horn's Fig. 26 is incorrect because it "undermines the teachings of the invention claimed in the '815 patent" and "contradicts the fundamental design and intended functionality of the '815 patent." POR, 35. This hyperbole fails because this "fundamental design" is neither claimed nor disclosed in the '815 patent's specification as discussed above.

5. The Combination of Horn, Baumgartner and Candelore Discloses Limitations 16[i]-[I] and 21[i]-[I]

The Petition establishes that the same information (i.e., video or anything else) can be part of different collections. Petition, 33 (citing EX1005, 9:1-16; Abstract, 8:59-67, 23:57-24:12). The Petition also established that it would have

been obvious for different collections to be associated with different users having different profiles. Petition, 36-37 (“A POSITA would have found it obvious . . . to configure Horn’s system to display to a user a second user interface such as Horn’s Workspace view as shown in the annotated version of Fig. 26 shown below, with user-selectable content corresponding to the user profile that was selected by the user being displayed in the content pane 2603 and the metadata pane 2604 (the areas surrounded by the purple boxes, together the claimed second user interface).”). Thus, the Petition establishes that when different users are selected, different content panes 2603 associated with those users will be displayed, and that the same information may be in these different content panes/second user interfaces. The POR’s argument to the contrary at 36-37 therefore fails.

The POR argues that Horn and Baumgartner do not disclose that removing a video from one group/collection associated with one user’s profile will result in the video remaining in another group/collection associated with another user’s profile. POR, 37. But the Petition establishes that Horn discloses at 20:16-46:

...items may belong to more than one collection at a time. ...
[I]tems may be removed from a collection by choosing the
Remove command, which removes the items from the collection
but does not otherwise delete the items from the source (e.g. the
file system) or any other collections.

6. The Combination of Horn, Baumgartner and Candelore Discloses Limitations 16[m], 21[l] and 21[m]

The POR's argument that the combination of Horn, Baumgartner and Candelore do not disclose these decryption limitations is based on a bodily incorporation argument that is improper. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) ("Nonobviousness cannot be established by attacking the references individually where the rejection is based upon the teachings of a combination of references.").

7. The Combination of Horn, Baumgartner and Candelore Discloses Claims 18 and 24

PO's argument fails because it is premised on the incorrect claim construction that claims 18 and 24 are limited to a "recommendations list." POR, 41. To be clear, these claims are written broadly enough to include such lists, but they are not limited to such lists. Indeed, there is no disclosure of such "recommendations lists" anywhere in the '815 patent. Further, this assertion is contrary to Maxell's construction, which can include only videos that are selected by a user (i.e., category i of Maxell's construction in the POR at 17) and thus are not a "recommendations list." The Petition's identification of Horn's disclosures of "information personalized for each individual user based on preferences selected by the user" and "user-defined collections" satisfies these claims. Petition, 43.

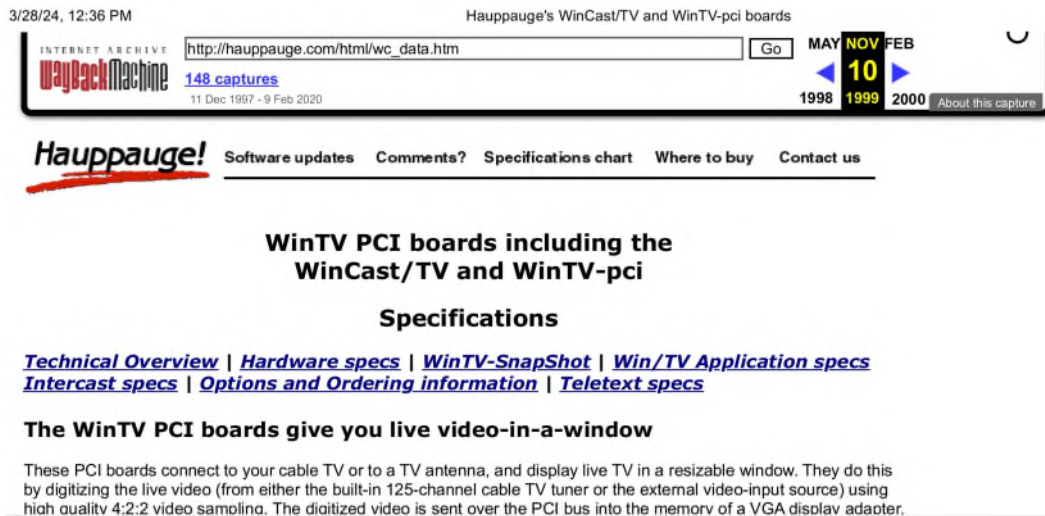
C. Ground 7: Claims 20, 26 and 27 Are Obvious Over Horn in View of Baumgartner, Candelore and WinTV

1. WinTV Was Published

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

Maxell asserts that the WinTV reference – EX1010, the WinTV Installation and Reference Manual dated June 30, 1999 – was not prior art because (1) there is insufficient evidence to establish that WinTV products with which the WinTV reference was distributed were on sale in the United States, and (2) WinTV was not publicly accessible because Maxell's expert was not able to navigate to the WinTV manual from the hauppauge.com home page, and thus the WinTV manual was only accessible by the Hauppauge employees who created it. POR, 43-48. Both assertions are flawed.

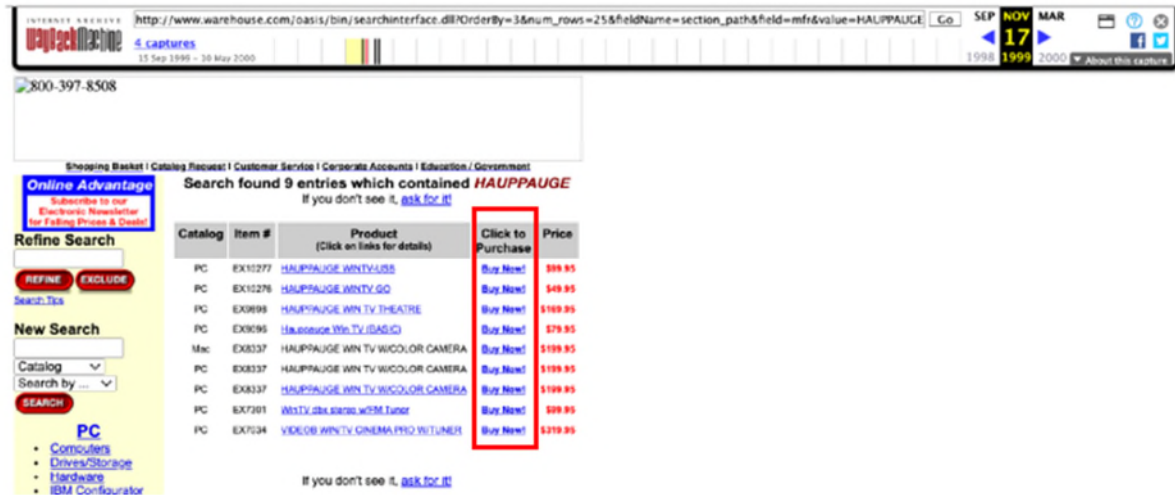
Product manuals for products such as the WinTV manual for the WinTV products that were on sale qualify as publications. *Weber, Inc. v. Provisur Techs., Inc.*, 92 F.4th 1059, 1068-69 (Fed. Cir. 2024). The POPR argued that EX1011 was insufficient to demonstrate that the WinTV products with which the WinTV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



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

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

Moreover, pursuant to the suggestion in the ID at 20, Petitioner filed a Motion to Submit Supplemental Information (Paper 15) including an authenticated version of EX1011 (EX1057, 1-7) as well as additional Internet Archive web pages such as the one excerpted below that further demonstrate that the Win TV-PCI product corresponding to the WinTV manual was on sale in the U.S. as of 1999:



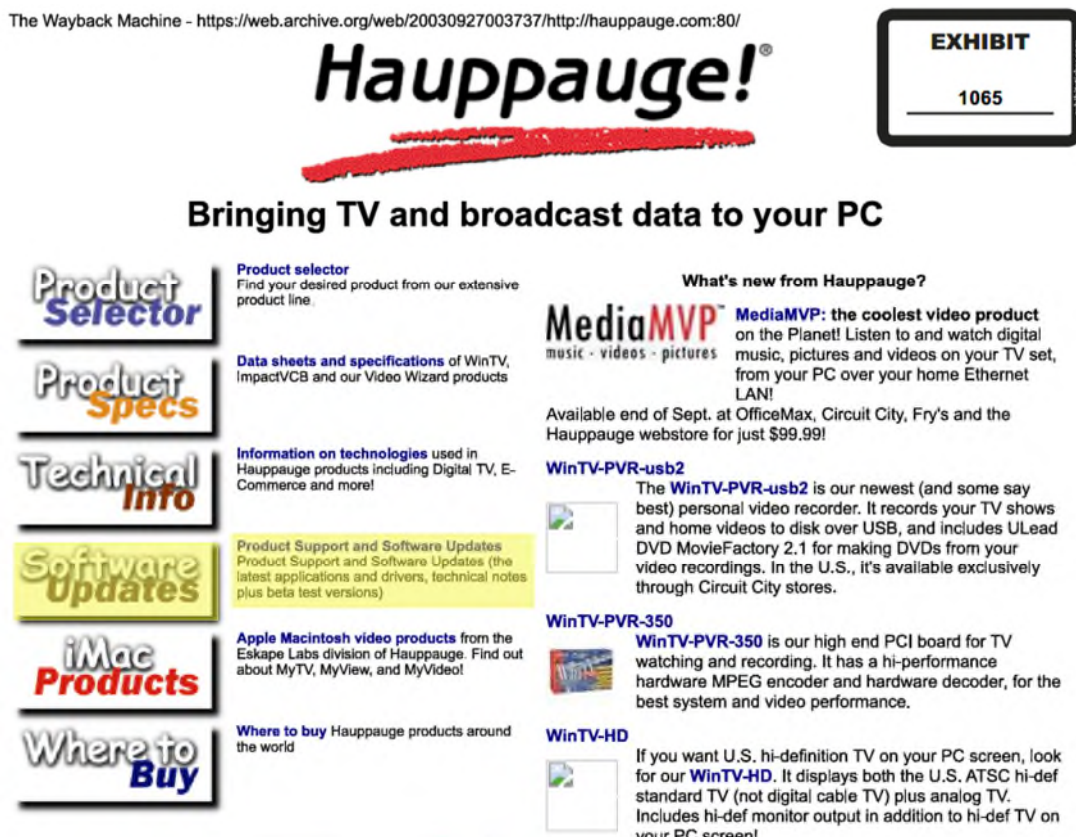
EX1057, 11. Thus, the WinTV manual was published via distribution with the WinTV products that were on sale in 1999. *Weber*, 92 F.4th at 1068-69.

b. WinTV Was Published Via the Hauppauge Website

As established in the Petition at 15-18 and further supported by references to the WinTV products in various U.S. patent documents including EX1037, 2:6-8; EX1038, 3:51-55, EX1051, 5:31-32; 11:28-31, EX1052, 7:56-59 and EX1053, ¶96, a POSITA would have been aware of the WinTV products and would have known to look to the hauppauge.com website for information regarding those products. Maxell's assertion that WinTV was not accessible to the public via that website because it was not possible to navigate to from the hauppauge.com home page to the page from which the WinTV manual could be downloaded was proven false by Maxell's expert during deposition. In fact, Dr. Balakrishnan was able to navigate from the archived version of that home page to the page from which the

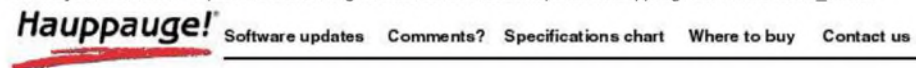
WinTV manual could be downloaded *in just 3 clicks*, then downloaded what he confirmed was an identical copy of the WinTV manual. EX1072, 48:5-65:7.

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



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

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



Product Support and Software Updates

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

See below for a list of software updates for Hauppauge Products

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

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

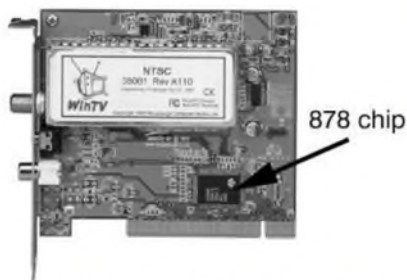
From that page, Dr. Balakrishnan clicked on the highlighted link for the first product in the WinTV-PCI boards cell of the product selector table (second click), which brought him to the “WinTV PCI boards” product selector page excerpted below (EX1067, yellow highlighting added):

WinTV PCI boards

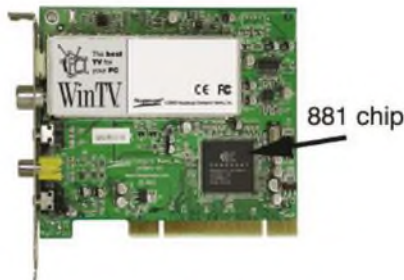
Software Update product selector page

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

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



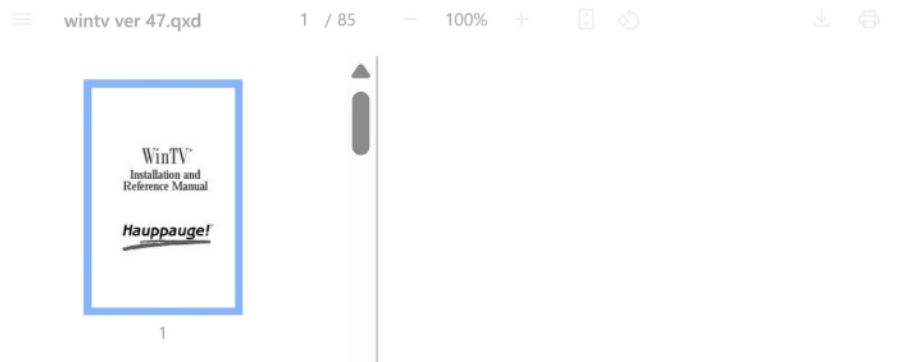
WinTV 878 or 848 based PCI boards or Impact VCB's
[Software updates and utilities page](#)
[Frequently asked questions](#)
[Installation manual \(PDF\)](#)



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

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

The Wayback Machine - <https://web.archive.org/web/20030914203323/http://www.hauppauge.com:80/manuals/...>



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

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

Horn's disclosure of videos in the form of movies and Baumgartner's teaching of the desirability of including a TV tuner card such as the WinTV PCI product in its PC embodiments (EX1016, ¶83) provide strong motivation to combine WinTV with Horn and Baumgartner. See Petition at 54-55. Maxell's arguments to the contrary are based on (1) the false assertion that WinTV was not publicly accessible, (2) that Horn and WinTV are different systems and the false

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

D. Ground 8: Claims 16-27 Are Obvious Over Horn in View of Baumgartner, Candelore, WinTV and Chao

The Petition asserts that a POSITA would have found it obvious to modify the Horn-Baumgartner-WinTV combination by adding thumbnails to represent folders of content data (as opposed to individual items in a folder) as taught by Chao given that Horn already discloses the use of thumbnails for individual items in a folder. Indeed, doing so improves the user interface by allowing easy navigation between folders and involves no more than applying a known technique to a known device that is ready for improvement to yield predictable results. Petition, 55-60. This rationale belies Maxell's POR argument at 50 that the Petition fails to explain motivation. Maxell's POR arguments about (1) Horn teaching away from further complexity, (2) the “failure” to explain how to “access or modify” Horn's OS to use thumbnails, and (3) the alleged incompatibility between the Horn “OS architecture” and the Chao “thumbnail-based system” are likewise belied by the fact that Horn already uses thumbnails for individual items as discussed in the Petition at 60 (citing EX1003, ¶354), and are improper “bodily incorporation” arguments that the Board preliminarily rejected. ID, 23.

E. Ground 9-10: Claims 16-27 Are Obvious Over Kaplan, Bryant, Wong and Candelore

1. The Petition Establishes Motivation to Combine Kaplan, Bryant, Wong and Candelore

The POR repeats nearly verbatim the arguments from the POPR regarding motivation to combine Kaplan and Bryant. POR, 52-60; POPR, 52-61. These arguments fail for the reasons articulated in the ID at 29-30 (citing Petition, 61-66).

2. The Combination of Kaplan, Bryant, Wong and Candelore Discloses Limitations 16[a] and 21[a]

The POR repeats verbatim the arguments from the POPR on limitations 16[a] and 21[a]. POR, 60-61; POPR, 61-62. The ID rejected those arguments, noting that Maxell did not address the Petition's assertion that "common knowledge beyond Kaplan and Bryant additionally informed skilled artisans such that using a wireless rather than wired network would have been obvious" and "Patent Owner does not explain why Petitioner is wrong in that regard." ID, 32. By again failing to address that argument in the POR, Maxell has waived any argument to the contrary regarding limitations 16[a] and 21[a].

3. The Combination of Kaplan, Bryant, Wong and Candelore Discloses Limitations 16[b] and 21[b]

The POR's argument for these limitations is based on the assertion that Wong is not prior art. POR, 62. Wong is prior art because, as established in the Petition at 9-14, there is no written support in any of the applications filed prior to 11/19/2017 to which the '815 patent claims priority for either (i) the "first video

information being received including second video information that is encrypted” requirement in limitations 16[a] and 21[a] (“Term 1”), or (ii) the “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” requirement in limitations 16[k] and 21[k] (“Term 2”).

a. Term 1

As an initial matter, while the POR discusses the district’s court’s construction of several terms of the ’815 patent, it ignores Term 1. POR, 12-19. This is likely because the district court held that Term 1 requires the second video information to be in encrypted form at the time it is received by the information processing apparatus of claims 16 and 21. EX2033, 31. The Court reasoned:

For one, the structure of the claim as a whole supports Samsung’s construction. The more natural reading of the claim language is “that is encrypted” describes a present characteristic of the “second video information.” In fact, the limitation more precisely relates to receiving “the first video information” at the time it is received. If the claim were to cover first receiving and then later encrypting the second video information, a skilled

artisan would have expected the “receiving” and “encrypting” to be recited as separate “steps.”

Id., 12. The Court rejected Maxell’s assertion that Term 1 was broad enough to include encrypting video information at a time after it was received and Maxell’s assertion that Fig. 3 supported that construction. *Id.* The district court’s construction is correct and should be adopted here in view of the POR’s waiver on this issue by failing to offer an alternative construction.

The argument in the POR at 4-6 that Fig. 3 provides support for Term 1 fails because it is premised on Maxell’s incorrect construction. The second argument in the POR at 6-7 is that a POSITA would “know about” video information that is received in encrypted form and would know that the circuits of Fig. 3 “could be used to receive the digital broadcast signal (encrypted video information), decrypt it, and produce it for viewing.” This argument also fails because it is nothing more than an argument that receiving encrypted video information would have been obvious. A specification that makes a limitation obvious does not satisfy the written description requirement. *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571–72 (Fed. Cir. 1997).

The relevant inquiry is whether the specifications of the priority applications convey with reasonable clarity to a POSITA that, as of the filing date sought, the inventor was in possession of the invention. There is nothing in the specification

that discusses any video being received in encrypted form as required by the properly-construed claim. Maxell points to DVB specifications for encryption of broadcast pay television signals, but that is not referenced by the specification. Moreover, Maxell ignores Dr. Bederson's showing that conventional ATSC-1 broadcast digital television signals were not encrypted during the relevant time period. EX1003, ¶93 (citing EX1050, 2-3).

Maxell also mischaracterizes Dr. Bederson's deposition testimony as stating that "digital broadcast is typically encrypted." POR, 8-9 (citing EX2036, 30:3-7, which is actually 32:3-7). But that excerpt must be understood in view of what Dr. Bederson said immediately prior to that testimony, i.e., only that pay television digital broadcasts (not digital broadcasts generally), were typically encrypted. EX2036, 31:15–20.

Simply put, pointing to what a POSITA might find obvious in view of references not cited in the specification does not establish compliance with the written description requirement for Term 1.

b. Term 2

The POR fails to show any support in the specification for Term 2. The citations to the specification's descriptions of Figures 6 and 7 (POR, 9) are silent about what happens when an item is deleted from one folder, and certainly do not state that such a deleted item remains in the other folder. The POR does not even

attempt to explain how these passages provide support for Term 2. Moreover, Maxell does not address the Petition's showing that Maxell's own expert asserted in IPR2018-01432 for a parent of the '815 patent that a POSITA would have considered it more common to delete the underlying video information when a user deletes a pointer to it. Petition, 13, citing EX1009, 36 (citing Ex. 2002, ¶65 in IPR2018-01432 (EX1046, ¶65)); see also EX1003, EX1003, ¶¶95-96. Maxell has failed to establish entitlement to priority to any pre-2017 application for Term 2.

4. The Combination of Kaplan, Bryant, Wong and Candelore Discloses Limitations 16[e]-[h] and 21[e]-[h]

The POR's first argument (POR, 62-63) is based on a construction of the "second user interface" that is wrong and has been disclaimed by Maxell's expert as discussed above in §II.A.1 ("second user interface" construction) and fails for that reason.

The POR's second argument (POR, 63-65) fails because (i) Wong is prior art, and (ii) the POR makes no coherent argument that the usernames in Wong's Fig. 3 (Petition at 71, reproduced below) are associated with user names that indicate a user's identity as discussed in the Petition at 70-72, 73-75.

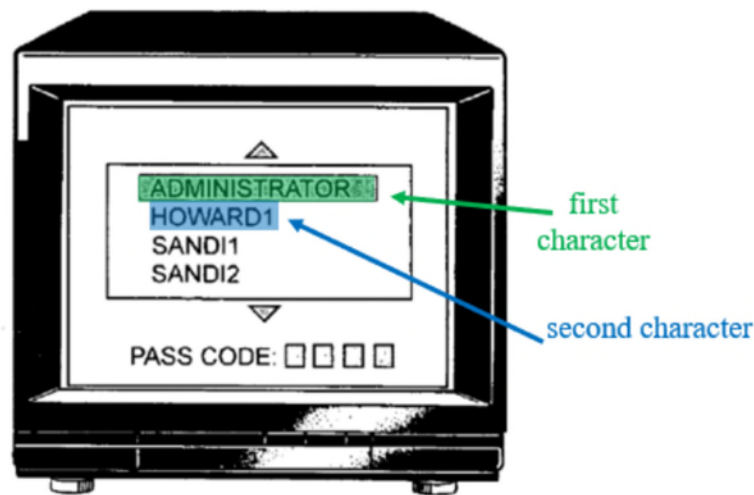


FIG. 3

5. The Combination of Kaplan, Bryant, Wong and Candelore Discloses Limitations 16[i]-[l] and 21[i]-[l]

Collateral estoppel precludes Maxell's arguments on these limitations. The POR's argument on the collateral estoppel issue (POR, 67-69) is nearly identical to its POPR arguments (POPR, 60-62). Maxell's principal argument is that the prior IPR was decided under a BRI construction whereas this IPR applies the federal court claim construction standard, and "[a]s such, the Board should reject Petitioner's collateral estoppel argument." POR, 67-68. However, as noted in the ID, "[t]hat may be so, but Patent Owner has not raised a claim-construction issue here regarding limitation 1[l]." ID, 34. The quotation from the *Skyhawke* case upon which Maxell relies (POR, 48) is clearly distinguishable because that dispute centered on the correct claim construction, whereas here the disputed issue is whether or not Bryant and Kaplan disclose or render obvious limitations 16[k] and

21[k]. Maxell has failed to demonstrate that the construction of these limitations is different under the different standards. By failing to demonstrate such a difference, Maxell has failed to show that the relevant issue has not actually been litigated. It has, and collateral estoppel therefore precludes Maxell's arguments on these limitations.

6. The Combination of Kaplan, Bryant, Wong and Candelore Discloses Limitations 16[m], 21[l] and 21[m]

The POR's argument that this combination does not disclose these decryption limitations fails because it is based on an improper bodily incorporation argument.

III. CONCLUSION

Challenged claims 16-27 should be found unpatentable for the reasons discussed above and in the Petition.

Date: April 25, 2025

Respectfully submitted,

/s/ James M. Heintz

Reg. No. 41828

DLA Piper LLP

One Fountain Square

11911 Freedom Drive, Suite 300

Reston, VA 20190-5602

Phone: + 1 703 773 4000

Fax: + 1 703 773 5000

Jim.heintz@us.dlapiper.com

Attorney for Petitioners

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(c) and (d), Petitioner certifies that the word count of Petitioner's Reply to Patent Owner's Response to Petition for *Inter Partes* Review of U.S. Patent No. 11,017,815 (exclusive of any table of contents, table of authorities, certificates of service and word count, and list of exhibits or claim listing) as measured by Microsoft Word is 5,580 words, which is less than the 5,600 allowed under 37 C.F.R. § 42.24.

Date: April 25, 2025

s/ James M. Heintz
James M. Heintz
Reg. No. 41,828
DLA Piper LLP
One Fountain Square
11911 Freedom Drive, Suite 300
Reston, VA 20190-5602
Phone: + 1 703 773 4000
Fax: + 1 703 773 5000
jim.heintz@us.dlapiper.com

Attorney for Petitioners

CERTIFICATE OF SERVICE

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

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

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

Respectfully submitted,

/s/ James M. Heintz