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Paper 52
Date: October 31, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

MAXELL LTD,
Patent Owner.

IPR2024-00777
Patent 11,017,815 B2

Before JAMESON LEE, TERRENCE W. McMILLIN, and
KEVIN C. TROCK, *Administrative Patent Judges.*

LEE, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining No Challenged Claim Unpatentable
35 U.S.C. § 318(a)
Dismissing Patent Owner's Motion to Exclude
37 C.F.R. § 42.64

I. INTRODUCTION

We instituted an *inter partes* review of claims 16–27 ("challenged claims") of U.S. Patent No. 11,017,815 B2 (Ex. 1001, "the '815 patent") owned by Maxell Ltd. ("Patent Owner"). Paper 12 ("Decision to Institute" or "Inst. Dec."). We have authority to conduct this *inter partes* review under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

Oral hearing was held on September 24, 2025, a transcript of which has been entered as Paper 48 ("Tr."). We determine that Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, "Petitioner") have not proved by a preponderance of the evidence that any of claims 16–27 of the '815 patent is unpatentable.

A. Background

Petitioner filed a Petition requesting an *inter partes* review of the challenged claims pursuant to 35 U.S.C. §§ 311–319. Paper 1. Patent Owner filed a Preliminary Response. Paper 9 ("Prelim. Resp.").

The Decision to Institute was entered on November 8, 2024. Paper 12. Thereafter, Petitioner filed a Motion to Submit Supplemental Information. Paper 16. Patent Owner opposed Petitioner's Motion to Submit Supplemental Information. Paper 17. Petitioner filed a Reply to Patent Owner's Opposition to Petitioner's Motion to Submit Supplemental Information. Paper 20. We denied Petitioner's Motion to Submit Supplemental Information. Paper 35.

Patent Owner filed a Motion to Submit Supplemental Information. Paper 39. Petitioner opposed Patent Owner's Motion to Submit Supplemental Information. Paper 42. Patent Owner filed a Reply to Petitioner's Opposition to Patent Owner's Motion to Submit Supplemental

Information. Paper 44. We denied Patent Owner's Motion to Submit Supplemental Information. Paper 50.

Patent Owner filed a Response to the Petition (Paper 21, "PO Resp."); Petitioner filed a Reply (Paper 24, "Reply"); and Patent Owner filed a Sur-reply (Paper 26, "Sur-reply").

Patent Owner filed a Motion to Exclude. Paper 29. Petitioner filed an Opposition to Patent Owner's Motion to Exclude. Paper 30. Patent Owner filed a Reply to Petitioner's Opposition to Patent Owner's Motion to Exclude. Paper 31.

B. Real Parties in Interest

Petitioner identifies itself as the real party in interest. Pet. 101. Patent Owner also identifies itself as the real party in interest. Paper 5, 1.

C. Related Matters

The parties identify the following related federal district court litigation of the '815 patent: *Maxell, Ltd. v. Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc.*, No. 5:23-cv-00092-RWS (E.D. Tex.). Pet. 101; Paper 5, 1. Also, claims 1–15 of the '815 patent are the subject of another *inter partes* review Petition filed by Petitioner in IPR2024-00735.

D. The '815 Patent

The '815 patent issued on May 25, 2021, from Application No. 16/883,124, filed May 26, 2020, and claims priority through a chain of continuation application to Application 11/203,457, filed Aug. 11, 2005, now Patent No. 7,613,383. Ex. 1001, codes (21), (22), (45), (63). The '815 patent also claims priority to the following foreign patent filings: (1) JP

2004-349264 (Dec. 2, 2004); (2) JP 2004-378767 (Dec. 28, 2004); and (3) JP 2004-378768 (Dec. 28, 2004). *Id.* at code (30).

The ’815 patent relates to a hierarchical management system for recording and reproducing device audio/video (“AV”) data. Ex. 1001, code (57). The ’815 patent describes a variety of recording and reproducing devices to which the management system relates, including a device capable of receiving and reproducing digital broadcast from an input (e.g., wave antenna, compressed AV data from another device, and analog AV), and data encryption, decryption, and processing steps prior to display on a television set screen via an output terminal. *Id.* at 4:45–55, 5:24–25, 5:28–46.

The ’815 specification describes a management system “in which the user can conduct manipulation of arbitrarily rearranging the display sequence of the play lists in the play list catalog on the user interface.” Ex. 1001, 2:36–39. The added upper management hierarchical level and unified management of play list and user-defined information allows the user to alter the display sequence of play lists. *Id.* at 2:53–55. The specification further describes that, in addition to an individual user’s ability to select and manage arbitrary play lists, a plurality of users sharing a single device can each manage favorite reproduction contents. *Id.* at 2:51, 2:63–67, 3:1.

Claim 16 is independent and reproduced below:[1]

[1] The bracketed labels correspond to those used by Petitioner to reference the claim elements. *See* Pet. vi–vii. We use the same labels here for ease of reference, understanding, and consistency.

[16pre] A method for reproducing video content associated with user profiles being implemented on an information processing apparatus, comprising:

[16a] 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;

[16b] displaying, on a display device, a first user interface for a user to select a user profile from among a plurality of user profiles including a first user profile associated with a first character and a second user profile associated with a second character,

[16c] 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;

[16d] receiving a selection of the first user profile;

[16e] displaying, in response to the selection, a second user interface for a user to select desired video information to be reproduced from among the first video information,

[16f] the second user interface being associated with the first user profile and displaying the first character, the first character associated with a first group of video information and indicating an identity of the user of the first user profile,

[16g] the second user interface further displaying thumbnails corresponding to the first group of video information;

[16h] 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,

[16i] the first group of video information and the second group of video information including one video information that is the same;

[16j] receiving a selection to remove the one video information from the first group of video information associated with the first user profile;

[16k] 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;

[16l] receiving a selection of desired video information based on a selection of a thumbnail from the first group of thumbnails, the desired video information included in the second video information;

[16m] decrypting video information corresponding to the selected thumbnail; and displaying the decrypted video information.

Pet. vi–vii.

Claim 21 also is independent and recites limitations similar to claim 16. Pet. vii–viii.

Petitioner relies on the Declaration of Benjamin B. Bederson, Ph.D. (Ex. 1003) with regard to technical substantive matters, and the Declarations of Roshan Bhattarai (Ex. 1063), Nathaniel E. Frank-White (Ex. 1008), and Ming Ching (Ex. 1073), with regard to issues relating to the publication dates of website contents. Patent Owner relies on the Declaration of Ravin Balakrishnan, Ph.D. (Ex. 2040).[2]

[2] The Declaration of Jacob Sharony, Ph.D. (Ex. 2021), submitted with Patent Owner's Preliminary Response, was not referred to in the Patent Owner Response.

E. Asserted Ground of Unpatentability

Petitioner asserts that the following grounds of unpatentability:

Claims Challenged	35 U.S.C. §[3]	Reference(s)/Basis
16–19, 21–25	103	Horn, Baumgartner, Candelore
20, 26, 27	103	Horn, Baumgartner, Candelore, WinTV
16–27	103	Horn, Baumgartner, Candelore, WinTV, Chao
16–19, 21–25	103	Kaplan, Bryant, Wong, Candelore
20, 26, 27	103	Kaplan, Bryant, Wong, Candelore, WinTV

II. ANALYSIS

A. Burden of Proof

The Petitioner has the burden of proving unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). That burden never shifts to Patent Owner except in limited circumstances not present here. *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir. 2016). "Preponderance of the evidence means the greater weight of evidence, evidence which is, more convincing than the evidence which is offered in opposition to it." *United States v. C.H. Robinson Co.*, 760 F.3d 1376, 1383 (Fed. Cir. 2014) (internal quotations omitted).

[3] The Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (2011) ("AIA"), amended 35 U.S.C. §§ 102 and 103. Because we determine below that the challenged claims of the '815 patent are not entitled to a priority date prior to the effective date of the applicable AIA amendments (March 16, 2013), we refer to the AIA version of 35 U.S.C. § 103. However, our findings and conclusions would still be the same under the pre-AIA version of 35 U.S.C. § 103.

B. Level of Ordinary Skill in the Art

Petitioner asserts the following with respect to the level of ordinary skill in the art:

> A person of ordinary skill in the art ("POSITA") at the time of the alleged invention of the '815 patent would have had a bachelor's degree in Computer Science, Electrical Engineering, Computer Engineering, or a related field, and two years of practical experience in digital data management.

Pet. 5.

Patent Owner proposes that a person of ordinary skill in the art "would have a Bachelor of Science degree in Electrical Engineering, Computer Engineering, Computer Science, Human Computer Interaction, or a related technical field, with at least one year of experience working in the field of user interfaces and/or content management." PO Resp. 11 (citing Ex. 2040 ¶ 53).

The Decision on Institution adopted Petitioner's proposed level of ordinary skill in the art. Inst. Dec. 10. We find Patent Owner's stated level to be less precise than that proposed by Petitioner in that the modifier "at least" used by Patent owner imposes no upper bound on the amount of experience possessed by one of ordinary skill in the art. Also, Patent Owner states: "The difference between the Board's definition and Patent Owner's (EX2040. ¶53) does not change the arguments set forth herein." PO Resp. 11. Thus, we continue to adopt Petitioner's stated level of ordinary skill in the art.[4]

[4] All of our findings and conclusions would still be the same, however, had we applied Patent Owner's articulation of the level of ordinary skill in the art.

C. Reference relied on by Petitioner and Declarations

Petitioner relies on the following references:

Name	Patent Document/Publication	Exhibit
Horn[5]	U.S. Pat. No. 7,275,063 B2	1005
Wong[6]	U.S. Pat. No. 7,650,361 B1	1007
Chao[7]	U.S. Pat. No. 7,970,240 B1	1006
Kaplan[8]	U.S. Pub. No. 2001/0056434 A1	1014
Candelore[9]	U.S. Pub. No. 2003/0174844 A1	1013
Bryant[10]	U.S. Pub. No. 2004/0201681 A1	1015
Baumgartner[11]	U.S. Pub. No. 2005/0160458 A1	1016
WinTV[12]	WinTV Installation and Reference Manual, Hauppauge.com	1010

D. Claim Construction

We use the same claim construction standard that would be used to construe a claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b) (2022). The claim construction standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc) is applicable.

Claim terms are generally given their ordinary and customary meaning as would be understood by one with ordinary skill in the art in the

[5] Issued Sept. 25, 2007. Ex. 1005, code (45).
[6] Issued Jan. 19, 2010. Ex. 1007, code (45).
[7] Issued June 28, 2011. Ex. 1006, code (45).
[8] Published Dec. 27, 2001. Ex. 1014, code (43).
[9] Published Sep. 18, 2003. Ex. 1013, code (43).
[10] Published Oct. 14, 2004. Ex. 1015, code (43).
[11] Published July 21, 2005. Ex. 1016, code (43).
[12] Petitioner alleges a publication date no later than September 14, 2003. Pet. 15.

context of the specification, the prosecution history, other claims, and extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises, although extrinsic evidence is less significant than the intrinsic record. *Phillips*, 415 F.3d at 1312–17. Usually, the specification is dispositive, and it is the single best guide to the meaning of a disputed term. *Id.* at 1315.

The specification may reveal a special definition given to a claim term by the patentee, or the specification or prosecution history may reveal an intentional disclaimer or disavowal of claim scope by the inventor. *Id.* at 1316. If an inventor acts as his or her own lexicographer, the definition must be set forth in the specification with reasonable clarity, deliberateness, and precision. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998). The disavowal, if any, can be effectuated by language in the specification or the prosecution history. *Poly-Am., L.P. v. API Indus., Inc.*, 839 F.3d 1131, 1136 (Fed. Cir. 2016).

Only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) ("The Board is required to construe 'only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.'" (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

Petitioner provides a construction for several terms and phrases including "video information," "one video information," "one video information being removed from the first group of video information, and "user profile" or "user profiles." Pet. 5–9. Patent Owner proposes a construction for three terms: (1) "user profile(s)"; (2) "in response to the

selection of the first user profile, the display displays a second user interface for a user to select desired video information to be reproduced from among the first video information"; and (3) "the processor generates a group of video information base don user preferences determined by the user selections of the video information." PO Resp. 12–19.

For purposes of this Decision, we need discuss only the construction for "user profile" or "user profiles."

1. "User Profile(s)"

With respect to "user profile" and "user profiles," Petitioner asserts:

> These limitations should be construed as requiring *data representing distinctive features and characteristics of a user*. EX1047, 3 (defining "profile" as "5. A formal summary or analysis of data, often in the form of a graph or table, representing distinctive features or characteristics"); *see also* EX1048, 3 (defining "user profile" as "A computer-based record maintained about an authorized user of a multi-user computer system. A user profile is needed for security and other reasons; it can contain information such as the person's access restrictions, mailbox location, type of terminal, and so on.").

Pet. 8–9 (emphasis added). In the Decision on Institution, we adopted Petitioner's proposed construction but changed the conjunctive "and" to the disjunctive "or." Inst. Dec. 16.

Patent Owner notes, however, that in parallel district court litigation, the district court has construed "user profile(s)" as "a collection of settings and information associated with a user," and urges our adoption of the court's interpretation. PO Resp. 12. Patent Owner explains:

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

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

FIG.6

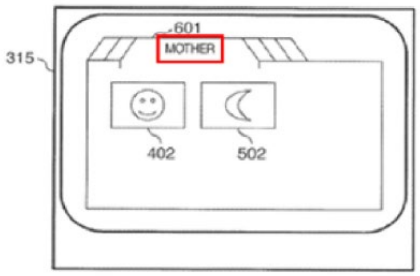
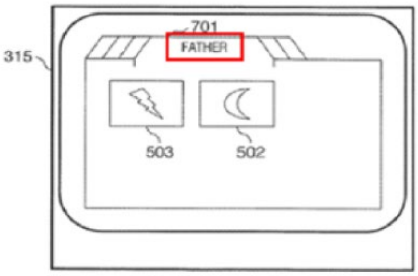


FIG.7



[Figures 6 and 7 illustrate, respectively, first and second output examples of user-defined unified information (Ex. 1001, 3:25–28) and Patent Owner has color labeled the "MOTHER" dedicated folder in Figure 6 and the "FATHER" dedicated folder in Figure 7]

Further, the '815 Patent also discloses that these user dedicated folders are possible by the use of hierarchical data directories with a "Root" directory followed by "user-defined

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

PO Resp. 12–14.

In its Reply, Petitioner does not assert that the district court's construction is incorrect. We agree with Patent Owner that the district court's construction is better than Petitioner's proposed construction, because for reasons indicated by Patent Owner, which are not disputed by Petitioner, settings in the computer, e.g., dedicated folders for each user are the user profiles, rather than simply data alone of any kind. Further, when asked about the appropriateness of the district court's construction, counsel for Petitioner expressed that Petitioner has no objection to the Board's adopting the district court's construction for "user profile":

> JUDGE LEE: So, you'd be fine with just going with the District Court's construction?
>
> MR. HEINTZ: Yes, Your Honor.

Tr. 15:22–24.

For the foregoing reasons, we adopt the district court's construction for "user profile," i.e., "a collection of settings and information associated with a user."

E. Alleged Obviousness of Claims 16–19 and 21–25 over Horn, Baumgartner, and Candelore

1. The Law on Obviousness

A claim is unpatentable under 35 U.S.C. § 103(a) "if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains." 35 U.S.C. § 103(a); *see KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) where in evidence, so-called secondary considerations, including commercial success, long-felt but unsolved needs, failure of others, and unexpected results. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

2. Overview of Horn (Ex. 1005)

Horn is titled, "Computer system for automatic organization, indexing and viewing of information from multiple sources." Ex. 1005, code (54). Horn discloses a computer data processing system, including a central processing unit configured with a novel integrated computer control software system, for the management of data objects. Management includes dynamic and automatic organization, linking, finding, cross-referencing, viewing, and retrieval of multiple objects regardless of nature or source. *Id.* at code (57). Horn's overall computer-control system is termed "MFS" for metadata filing system. *Id.* at 5:31–46.

3. Overview of Baumgartner (Ex. 1016)

Baumgartner is titled, "Interactive television system with custom video-on-demand menus based on personal profiles." Ex. 1016, code (54). Baumgartner discloses an "interactive television system with custom video-on-demand menus based on personal profiles." *Id.* at code (57). The video may be television programming, video on demand content, and other information. *Id.* ¶ 82.

Figure 1 of Baumgartner is reproduced below:

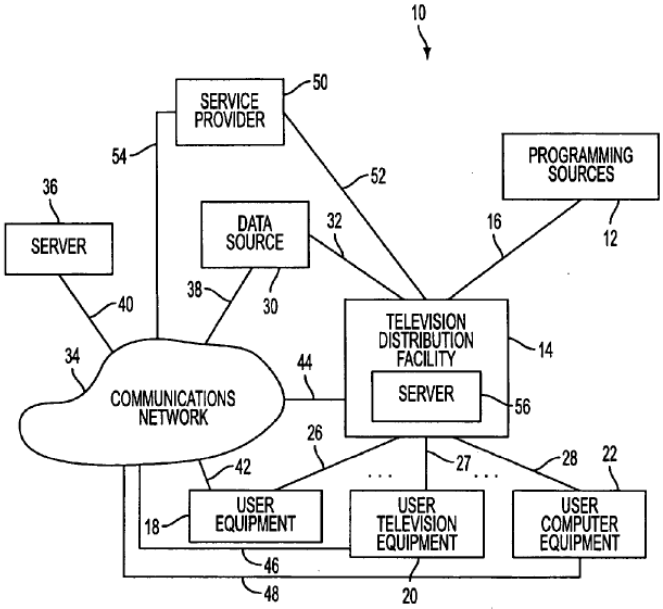


FIG. 1

Figure 1 illustrates an interactive television system in accordance with various embodiments of Baumgartner. Ex. 1016 ¶ 15.

Baumgartner describes: "Contents such as television programming and other media, such as digital music may be provided from programming sources 12 to television distribution facilities such as television distribution facility 14 using communications path 16." *Id.* ¶ 44. Baumgartner further describes:

> Television distribution facility 14 may be connected to various user equipment devices 18. Such user equipment 18 may, for example, be located in the homes of users. User equipment 18 may include user television equipment 20 or user computer equipment 22.
>
> The user equipment may receive television and music programming and other information from television distribution facility 14 over communications paths such as communications path 26, 27, and 28. . . . *Paths 26, 27, and 28 may be* cables or other wired connections, or *wireless connections* for broadcast or other satellite links.

Id. ¶¶ 47–48 (emphasis added).

Illustrative user television equipment 20 is based on a set-top box arrangement. Ex. 1016 ¶ 61. Illustrative user computer equipment is shown in Figure 5, reproduced below:

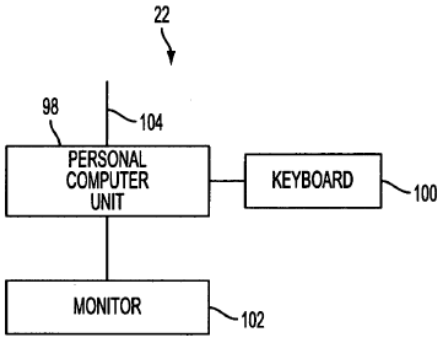


FIG. 5

Figure 5 illustrates user computer equipment according to various embodiments of Baumgartner. *Id.* ¶ 19.

Baumgartner describes:

> In the arrangement of FIG. 5, personal computer 98 may be controlled by the user using keyboard 100 or other suitable user input device, such as a trackball, mouse, touch pad, touch screen, voice recognition system, a remote control such as remote control 72 of FIG. 4, etc. Video content such as television programming and interactive television application display

> screens may be displayed on monitor 102. Television programming, video-on-demand content, video recordings played back from a network-based video recorder, and other information may be received from paths 28 and 48 (FIG. 1) using input/output 104. The user may also send commands and other information used during interactions with the interactive television application and system 10 over input/output line 104.
>
> Personal computer 98 may contain a television or video card such as television tuner card for decoding analog and digital television channels and for handling streaming video content. Multiple video cards (e.g., tuner cards) may be provided if desired.

Ex. 1016 ¶¶ 82, 83.

Baumgartner further describes that user computer equipment 22 accesses server 36 either through communication path 48 connecting to communications network 34, or through path 28, then television distribution facility 4, and then path 44 connecting to communications network 34. Ex. 1016 ¶ 54. Baumgartner describes that paths 44 and 48 can be wireless. *Id.* ¶¶ 53–54. Baumgartner also describes that communications network 34 can be the Internet. *Id.* ¶ 52. Server 36 is connected to communications network 34 through path 40 which can be a wireless path. *Id.* With regard to user computer equipment receiving video from server 36 through communications network 34, Baumgartner describes:

> If desired, an interactive television application such as a network-based video recorder or a video-on-demand application may be supported using server 56, server 36, or equipment at service provider 50. Video-on-demand content and video recorded during a network-based video recorder arrangement may be stored on server 56 or server 36 or at service provider 50 and may be provided to the user equipment when requested by users.

Ex. 1016 ¶ 57.

> Television programming, video-on-demand content, video recordings played back from a network-based video recorder, and other information may be received from paths 28 and 48 (FIG. 1) using input/output 104. The user may also send commands and other information used during interactions with the interactive television application and system 10 over input/output line 104.

Id. ¶ 82.

4. Overview of Candelore (Exhibit 1013)

Candelore relates to protecting digital content transmitted by content providers. Ex. 1013 ¶ 7. Candelore describes:

> Various embodiments of the invention relate to an apparatus, system and method for protecting the transfer of data. In one embodiment, such protection involves the descrambling or decrypting of digital content from one or more content providers in digital services. Examples of a "content provider" include, but are not limited to a terrestrial broadcaster, cable operator, direct broadcast satellite (DBS) company, a company providing content for download via the Internet, or any similar sources of content.

Id. ¶ 37. Candelore further describes:

> [I]n one embodiment, access requirements can provide consumers with a variety of choices for paying for the content and gaining access to the scrambled content. These choices may include pay per play (PPP), pay per view (PPV), impulse pay per view (IPPV), time based historical, pay per time (PPT), repurchase of copy never movies, personal scrambling, and regional pay per view. . . . The access requirements and entitlements can also provide consumers with different options for storing the scrambled content.

Id. ¶ 54. Candelore states: ""It is contemplated that the description below focuses on mechanisms to recover audio/visual content such as television broadcasts, purchased movies and the like. However, it is contemplated that

the invention is also applicable to the descrambling of audio content only (e.g., digitized music files). *Id.* ¶ 53.

5. Claim 16

For reasons discussed below, we find that Petitioner's accounting for limitation 16[b] is deficient.

a) Limitation 16[b]

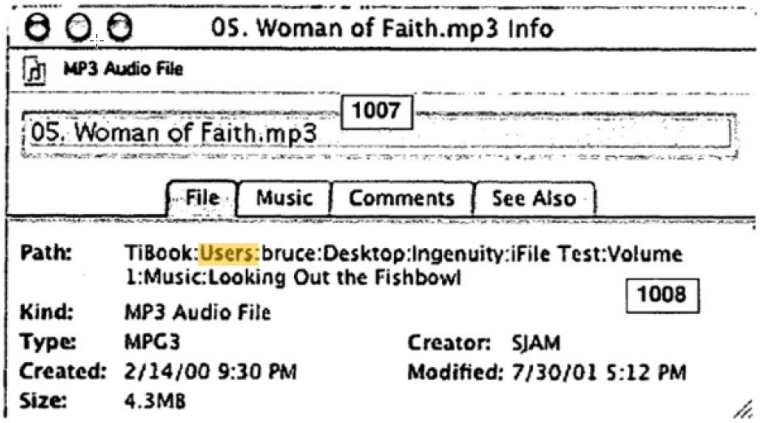
Limitation 16[b] recites: "displaying, on a display device, a first user interface for a user to select a user profile from among a plurality of user profiles including a first user profile associated with a first character and a second user profile associated with a second character." Pet. vi.

Petitioner explains:

> Horn's MFS system "comprises one or more application(s) for organizing all types of text and image information-from word processing documents to spreadsheets . . . to illustrations, images, movies, and photographs . . . or anything else that is stored and *retrieved* on a computer." EX1005, 12:8–18.

Pet. 20 (emphasis added).

> Baumgartner discloses embodiments in which a user's device is a PC like Horn's that obtains video information from a server via the Internet as in Horn. EX1016, ¶¶54-55, 82, FIGS. 1, 5. . . . Additionally, Baumgartner explicitly discloses storing video information on the computer's hard disk drive. EX1016, ¶85. EX1003, ¶133. Baumgartner also discloses multiple user profiles that are selectable by a user, and a POSITA would have recognized the desirability of providing this functionality in Horn's system because Horn teaches personalizing information organization for each individual user based on user preferences. EX1005, 6:11-39. Horn also discloses user customized collections. EX1005, 8:58–67, 9:46–52, 15:12–27, 16:5–23, 38:16–24, FIG. 10b:



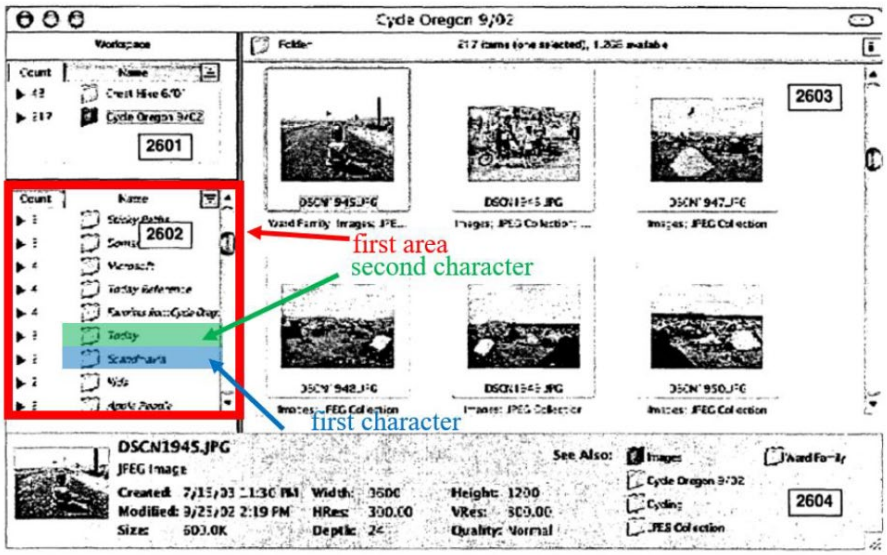
> [Figure 10b of Horn (color annotated by Petitioner to highlight "Users" in the path indicator) illustrates a display of Horn's information windows for image and music files. Ex. 1015, 10:29–30.]
>
> Thus, a POSITA would have looked at Baumgartner to improve Horn, and vice-versa.

Pet. 21–22.

Based on the foregoing, Petitioner points to Baumgartner's disclosure of user-selectable user profiles (Ex. 1016 ¶ 165) and asserts that it would have been obvious for one of ordinary skill in the art to combine Baumgartner's user-selectable user profiles with Horn's system. Pet 31. Baumgartner describes that "[i]f there are multiple users that are able to use a given user equipment, each user may have a personal profile." Ex. 1016 ¶ 165. Petitioner also notes that in one embodiment, Baumgartner discloses a user makes a selection of his or her profile "by pressing a button assigned to them." Pet. 32 (citing Ex. 1016 ¶ 165).

Petitioner further asserts:

> Baumgartner does not provide additional detail as to how to implement such user profile buttons, but a POSITA would have found it obvious to implement such buttons in a GUI screen as "soft" buttons labeled with the text of the user name associated with the user profile given Baumgartner's extensive disclosure of labeled GUI soft buttons such as the text-labeled GUI buttons 296–314, 336–350, 358–368, and 372–386 in Figs. 24–27. The text of the user name on the button for a particular user profile include at least one character associated with that user profile. EX1003, ¶288. A POSITA would have found it obvious, for example, to implement Horn's Workspace view as shown in Fig. 26 to include 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, either of which constitutes a first user interface.



> [Figure 26, annotated by Petitioner to show a first user interface in which buttons labeled with user names would be placed, shows a workspace view of Horn's display. Ex. 1005, 10:60.]

Pet. 32–33.

Patent Owner makes two arguments. First, Patent Owner asserts: "Without explicit guidance from Baumgartner, it would not have been obvious to a POSITA to implement in Horn the user profile buttons as

described in Baumgartner." PO Resp. 30. But Petitioner does rely on teachings from Baumgartner regarding a user selecting his or her own profile by pressing a button assigned to the user. Patent Owner does not contend that one of ordinary skill in the art would not have been sufficiently skilled to implement such buttons. Thus, this first argument of Patent Owner is unavailing.

Second, Patent Owner argues:

> Petitioner's reliance on modification to panes 2601 and 2602 in Horn's Workspace is misguided and lacks substantiation. The suggestion to add buttons labeled with user names for profile selection appears arbitrary and unsupported. *Id.*, ¶215. An analysis of Horn's Figure 26 (below), which illustrates the Workspace, shows no clear rationale or incentive for a POSITA to introduce additional buttons or information in these sections. Petitioner's recommendation is speculative and fails to provide a convincing basis for why such modifications would be necessary or obvious to a POSITA.

PO Resp. 30–31 (Figure 26 omitted). In its Reply, Petitioner still does not provide an articulated reason for placing user profile selection buttons, labeled with user names, within Horn's panes 2601 or 2602. Reply 12–14. Although Horn does describe personalized profile, Petitioner points to no disclosure of Horn as to how a user would have selected his or her own profile from among a plurality of user profiles.

Petitioner presents no reason for placing these user profile selection buttons, labeled with user names, gleaned from or suggested by Baumgartner, within either pane 2601 or pane 2602 in Horn's workspace view. Further, pane 2602 contains "a list of all collections defined by MFS and the user," and pane 2601 lists the source examined by the user to create his or her collections. Ex. 1005, 19:41–46. That disclosure suggests the contents of panes 2601 and 2602 are tied to one particular user. No rational

basis is articulated by Petitioner to place user profile selection buttons within these panes which appear to be in the profile space of one user.

For the foregoing reasons, Petitioner has not adequately accounted for limitation 16[b].

b) Conclusion

Because Petitioner has not adequately account for limitation 16[b], Petitioner has not proved by a preponderance of the evidence that claim 16 would have been obvious over Horn, Baumgartner, and Candelore.

6. Claim 21

Claim 21 is substantially similar to claim 16. The above-discussed deficiency of Petitioner's accounting for limitation 16[b] equally applies to limitation 21[b].[13] Petitioner has not proved by a preponderance of the evidence that claim 21 would have been obvious over Horn, Baumgartner, and Candelore.

7. Claims 17–19 and 22–25

Claims 17–19 each depend from claim 16 and claims 22–25 each depend from claim 21. The deficiency of Petitioner's accounting for claim 16 equally applies to claims 17–19. The deficiency of Petitioner's accounting for claim 21 equally applies to claims 22–25. Petitioner has not proved by a preponderance of the evidence that claims 17–19 and 22–25 would have been obvious over Horn, Baumgartner, and Candelore.

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[13] Limitation 21[b] reads: "a display displaying a first user interface for a user to select a user profile from among a plurality of user profiles including a first user profile associated with a first character and a second user profile associated with a second character." Pet. vii.

F. Alleged Obviousness of Claims 20, 26, and 27 over Horn, Baumgartner, Candelore, and WinTV

Claim 20 depends from claim 16. Claims 26 and 27 each depend from claim 21. The deficiency of Petitioner's accounting for claim 16 equally applies to claim 20. The deficiency of Petitioner's accounting for claim 21 equally applies to claims 26 and 27. Petitioner's addition of WinTV does not cure the discussed deficiency.

Petitioner has not proved by a preponderance of the evidence that claims 20, 26, and 27 would have been obvious over Horn, Baumgartner, Candelore, and WinTV.

G. Alleged Obviousness of Claims 16–27 over Horn, Baumgartner, Candelore, WinTV, and Chao

Petitioner's addition of WinTV and Chao does not cure the above-discussed deficiency of Petitioner's accounting of claims 16–19 and 21–25 as obvious over Horn, Baumgartner, and Candelore. Petitioner's addition of Chao does not cure the above-discussed deficiency of Petitioner's accounting of claims 20, 26, and 27 as obvious over Horn, Baumgartner, Candelore, and WinTV. Petitioner has not proved by a preponderance of the evidence that claims 16–27 would have been obvious over Horn, Baumgartner, Candelore, WinTV, and Chao.

H. Alleged Obviousness of Claims 16–19 and 21–25 over Kaplan, Bryant, Wong, and Candelore

1. Overview of Kaplan (Ex. 1014)

Kaplan is directed to "a multimedia management system for storing, manipulating, and displaying multimedia content." Ex. 1014 ¶ 4. To facilitate the storage and subsequent retrieval of multimedia data files, the system includes a user interface with a plurality of predefined functions to

uniquely index multimedia files, create an index database file, and create visual representations of the files for later retrieval. *Id.* ¶ 44. The indexed file stores a pointer in a management system database to a physical file location, while providing a thumbnail image that can be used to represent the file in the user interface. *Id.* Multiple pointers in the database may be related to a single physical file stored on computer media, so there is no need to store multiple physical files of the same multimedia data. *Id.* Kaplan's Figure 4 is reproduced below:

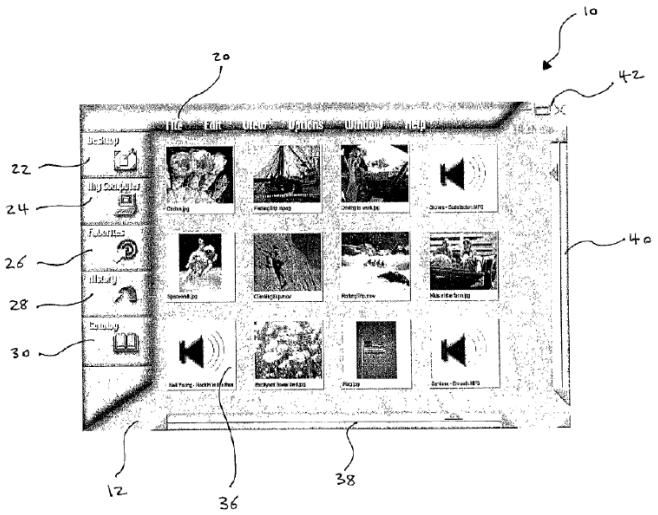

FIG-4

Figure 4 is a graphical representation of control options available to a user via interface 12 that can be displayed on a "monitor or TV." *Id.* ¶¶ 14, 39. Functions associated with user interface 12 may be carried out via control buttons for various primary options in user interface 12, including Desktop 22, My Computer 24, Favorites 26, History 28, and Catalog 30. *Id.* ¶¶ 39–40. For example, users may store their favorite multimedia content by way of the Favorites 26 primary option. *Id.* ¶ 42. All information and multimedia content is displayed through thumbnails 36, which are small

image representations of larger images. *Id.* ¶ 40. A user may click on thumbnails to view and/or listen to multimedia content. *Id.* ¶ 50.

Playback may occur within the thumbnail itself, in a partial screen mode, or in a full screen mode. *Id.* ¶ 51.

2. Overview of Bryant (Ex. 1015)

Bryant is directed to "grouping and classifying digital still images and digital motion images captured using a handheld digital camera." Ex. 1015, ¶ 29. Grouping and classification data are stored in a database on a host computer. *Id.* The classification provides "affective information," which is information that relates to the feelings or emotions of a person toward images. *Id.* ¶ 30. An example of affective information is the level of importance a user associates with an image, such as whether the image is a "favorite." *Id.*

Bryant discloses that its database includes "favlevel" metadata, which indicates whether the user has selected the image as a favorite, and "thmnail" metadata in row 692, which holds a copy of the compressed thumbnail image as stored by the digital camera. *Id.* ¶¶ 84, 85, 87.

Figure 9A of Bryant is reproduced below:

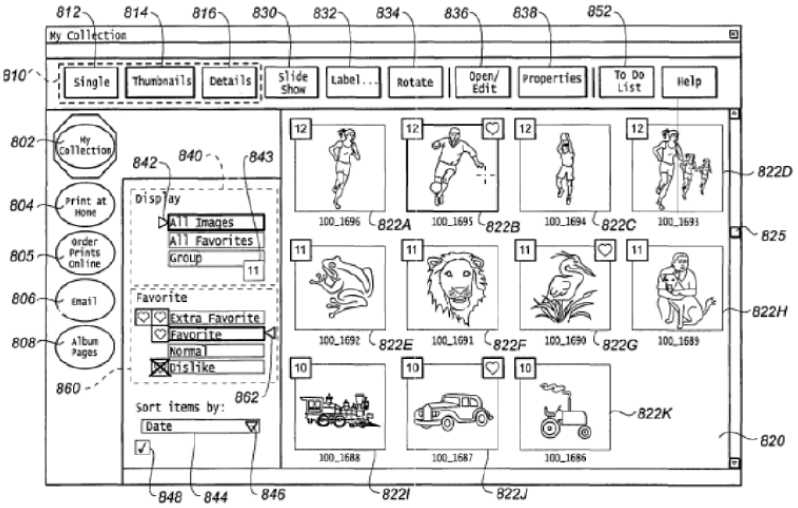

FIG. 9A

Figure 9A depicts an example of a computer user interface screen for displaying all of the transferred images. *Id.* ¶ 89. The user interface screen includes area 820 for displaying the thumbnail images provided using "thmnail" metadata 692 of each object from general assets table 600. *Id.* By moving selector 842 within display selection area 840, the user can select among the display of "All Images," "All Favorites," or "Group" based on group number/name box 843. *Id.* The user also can change the level of a selected image to be an "Extra Favorite," a "Favorite," a "Normal," or a "Dislike" image using selector 862 in favorites level selection area 860. *Id.* ¶ 96.

3. Motivation to Combine

Over eight pages in the Patent Owner Response, Patent Owner asserts and explains its contention that the Petition lacks a sufficiently clearly stated motivation to combine the teachings of Kaplan, Bryant, Candelore, and Wong, using independent claim 16 as a specific example. P.O. Resp. 53–60. Patent Owner asserts that the Petition "consistently recites what Kaplan, Wong, and Candelore purportedly teach individually (e.g., Pet. at 67-68) but fails to assert 'what the combined teachings of those references would have suggested to those of ordinary skill in the art.'" PO Resp. 53. Patent Owner asserts that "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.'" *Id.* at 55. According to Patent Owner, this amounts to an inappropriate "pick and choose" approach to presentation of evidence. *Id.* at 53.

Patent Owner under-appreciates the motivation to combine analysis provided on pages 61–66 of the Petition prior to Petitioner's specific

accounting of each claim limitation. Patent Owner refers to this analysis as vague and conclusory. PO Resp. 55. But when considered together with Petitioner's subsequent limitation by limitation analysis, the presentation is reasonably clear as to what teaching from which reference is applied in the proposed combination to meet which limitation. If either the general discussion or the specific analysis is viewed individually, we agree the accounting by Petitioner is less than reasonably clear. But the two must be read together. Therefore, Patent Owner's argument that the Petition lacks a sufficiently clearly stated motivation to combine the teachings of Kaplan, Bryant, Candelore, and Wong, is unavailing.

4. Priority Date of Challenged Claims

Whether Wong constitutes applicable prior art turns on the priority date of the challenged claims. The '815 patent issued from Application 16/883,124, filed on May 26, 2020, and claims priority through a chain of ancestral applications to JP 2004-378767 (Dec. 28, 2004), JP 2004-378768 (Dec. 28, 2004), and JP 2004-349264 (Dec, 2, 2004). Ex. 1001, codes (21), (22), (30), (63).[14] Wong was issued on Jan. 19, 2010, from Application 11/186,175 which was filed on June 21, 2005. Ex. 1007, codes (21), (22), (45). Petitioner asserts that none of the challenged claims is entitled to a priority date earlier than November 9, 2017. Pet. 9. Petitioner explains:

> This is because none of the applications to which the '815 patent claims priority that were filed prior to 11/9/2017 (i.e., 11/203,457; 12/56,898; 14/141,417; and 15/176,535 – see

[14] The chain of ancestral U.S. Patent Applications are: Application No. 16/221,908, filed Dec. 17, 2018, Application No. 15/808,175, filed Nov. 9, 2017, Application 15/176,435, filed June 8, 2016, Application 14/141,417, filed Dec. 26, 2013, Application 12/567,898, filed Sep. 28, 2009, and Application No. 11/203,457, filed Aug. 11, 2005. Pet. 10 (citing Ex. 1003 ¶ 86.

> EX1001, front cover) (collectively, the "Pre-2017 Applications") satisfy the requirements of 35 U.S.C. § 112 for at least the following terms found in each independent claim of the Challenged Claims:
>
> - "receiving . . . 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" ("Term 1")
> - "upon the one video 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" ("Term 2")
> - "user profile" or "user profiles" ("Term 3")

Pet. 9–10.

For Term 1, Petitioner asserts that there is no disclosure anywhere in the Pre-2017 Applications of receiving video that is encrypted, i.e., is received in encrypted form. Petitioner explains, in part:

> The only disclosure of any kind regarding encryption in the specifications of these four Pre-2017 Applications, which are identical to the '815 patent, is that video information is received at the information processing apparatus 300 of Fig. 3 via terminals 301, 3011 or 3012 and then – only after it has been received – it is encrypted by the encryption circuit 331 and stored on a medium 305 in a recording and reproducing unit 304 (which is not itself an information processing apparatus and which is not disclosed as being wirelessly connected to encryption circuit 331). EX1001, 4:43-5:25 and Fig. 3. This description does not disclose, either expressly or by implication, the wireless receipt of video information that is in encrypted form when received ass required by Term 1. EX1003, ¶¶86–92. . . . Encryption is also not inherent in any of the Pre-2017 Applications because video

> received at any of terminals 301, 3011 or 3012 need not be encrypted and often were not.

Pet. 11–12.

In response, Patent Owner asserts: "However, each of Terms 1-3 has written support in several applications prior to 11/9/2017. EX2040, ¶64. In fact, each term has support in the priority application JP2004-378767. *See* EX2019 (Translation of JP2004-378767)." PO Resp. 4. Patent Owner then attempts to show support for the contested terms in the disclosure of JP 2004-378767, dated Dec. 28, 2004, by reference to an English translation thereof (Ex. 2019). *Id.* Exhibit 2019, however, appears to be an English translation of a different Japanese priority application, i.e., JP 2004-378768, to which the '815 patent also claims priority.

As we noted above, the '815 patent claims priority to JP 2004-378767 and JP-378768 through a chain of ancestral applications. Ex. 1001, codes (30), (63). Patent Owner does not represent that the disclosure of all the ancestral applications which were filed prior to November 9, 2017, are the same as that in JP 2004-378768 discussed by Patent Owner, and we cannot assume that they are. It is well established, however, that "if the later filed application claims priority through the heredity of a chain of applications, each application in the chain must satisfy 112." *See In re NTP*, 654 F.3d 1268, 1277 (Fed. Cir. 2011). For this reason alone, Patent Owner's rebuttal is insufficient and the '815 patent is not entitled to a priority date prior to November 9, 2017.

In any event, Patent Owner's showing with respect to the disclosure of JP 2004-378768, incorrectly referenced by Patent Owner as JP 2004-378767, and issued Dec. 28, 2004, is nonetheless insufficient for the '815

patent to be entitled to a priority date prior to November 9, 2017, because at least Term 1 is not supported by that disclosure.

The test for sufficiency of a written description under 35 U.S.C. § 112 is whether the earlier application's disclosure "reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The specification must "clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed." *Id.* The Court of Appeals for the Federal Circuit has explained:

> One shows that one is "in possession" of *the invention* by describing *the invention,* with all its claimed limitations, not that which makes it obvious. *Id.* ("[T]he applicant must also convey to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention.* The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed.*") (emphasis in original). One does that by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention. Although the exact terms need not be used *in haec verba, see Eiselstein v. Frank,* 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed.Cir.1995) ("[T]he prior application need not describe the claimed subject matter in exactly the same terms as used in the claims. . . ."), the specification must contain an equivalent description of the claimed subject matter. A description which renders obvious the invention for which an earlier filing date is sought is not sufficient.

Lockwood v. American Airlines, Inc., 107 F.3d 1565 (Fed. Cir. 1997).

Patent Owner's arguments at most shows only that the limitation of Term 1 would have been obvious to one of ordinary skill in the art, not described. For instance, Patent Owner asserts:

> Specifically, a POSITA would know about encrypted video information that is wirelessly received by a device and would also know that *the circuits* (for example, input and decryption) described above *could be used to receive the digital broadcast signal (encrypted video information)*, decrypt it, and produce it for viewing, all satisfy the written description requirement because the essence of the original disclosure conveys the necessary information. For example, a POSITA, at the time of '815 Patent invention in 2004 would know through the technical documents and specifications *that the digital broadcast is generally encrypted*, ...

PO Resp. 6 (emphasis added).

> Indeed, Dr. Bederson has previously testified that digital broadcast *is typically encrypted*:

Q. I'm saying like the data you mentioned which typically should be encrypted, does that include the broadcast -- digital broadcast data, also?
A. Yes, it does.

> EX2036, at 30:3–7.

Id. at 8–9 (emphasis added).[15]

Patent Owner further asserts that in parallel district court litigation Dr. Bederson confirmed that encryption is typically applied to data before transmission. PO Resp. 9 (citing Ex. 2037 ¶ 37).

Showing that one of ordinary skill in the art would have known what could have been done and what was typical falls short of establishing the specification reasonably conveys actual possession of the subject matter by

[15] Petitioner notes, however, that Dr. Bederson's testimony was only directed to "pay television digital broadcasts (not digital broadcasts generally)." Reply 29 (citing Ex. 2036, 31:15–20 (Dr. Bederson referring to "paid television content or content that is not free")).

the inventor and thus includes adequate written description support under 35 U.S.C. § 112. Petitioner has the better side of this argument.

Thus, the challenged claims are entitled to a priority date no earlier than November 9, 2017, and Wong constitutes applicable prior art.

5. Overview of Wong (Ex. 1007)

Wong is titled "Media content modification and access system for interactive access of media content across disparate network platforms." Ex. 1007, code (54). Wong discloses a media content playlist generation and access system for a video entertainment network. *Id.* at code (57). Wong discloses that a plurality of media content from various networks may be conglomerated into a customized list, which may contain stored media content. *Id.* The system also provides manipulation of the playlist from various device displays that are interconnected to the Internet, for further user customization of the playlist. *Id.* Multiple user accounts are provided, which may also be configured for corresponding multiple individualized playlists, each customized to the user's tastes. *Id.*

Wong discloses an interface allowing a user to select a user profile from among a plurality of user profiles. *Id.* at code (57), 3:13–27, 4:1–5, Fig. 3. Wong's Figure 3 is reproduced below:

FIG. 3

Figure 3 is a screenshot depicting the log-in procedure for Wong's system. Ex. 1017, 4:53–55. As shown, several active usernames may be displayed in the username window 40, and one username may be highlighted by pressing the "up", or "down" button on remote-control device 20. *Id.* at 8:14–40. An authentication scheme is provided for user account access security purposes, including viewing and/or modifying playlists. *Id.*

6. Petitioner's Stated Motivation to Use Wong's Teachings

Petitioner explains:

> A POSITA would have found it obvious to incorporate multiple user profiles, as taught by Wong, in the Kaplan-Bryant computer system and a POSITA would have been capable of and motivated to do so. EX1003, ¶357.
>
> A POSITA would have been motivated to add multiple user profiles to Kaplan-Bryant's system because Bryant discloses that "[d]ifferent users can have different emotional reactions to the same image. Therefore, to be most useful, affected information relating to images should be associated with a particular user." EX1015, ¶32. Bryant also discloses user identifiers and thus already teaches personalizing information organization for each individual user. *Id.*; EX1003, ¶358.

Pet. 63.

> A POSITA would have recognized the benefit to having multiple different users use Kaplan-Bryant with unique user profiles as disclosed by Wong to provide customized user collections for multiple users on a single PC. EX1003, ¶361. This obvious application of Kaplan-Bryant's functionality would have motivated a POSITA to make the combination. EX1003, ¶361.

Id. at 64–65.

7. Claim 16

For reasons discussed below, we find that Petitioner's accounting for limitation 16[i] is deficient.

Limitation 16[i] recites: "the first group of video information and the second group of video information including one video information that is the same." Pet. vi. Petitioner asserts: "Kaplan renders this limitation obvious. The objects in the Favorites and History groups are the same and are part of the information stored in Kaplan's system, such as the hard drive. EX1044, ¶44; EX1003, ¶387." *Id.* at 84. The cited testimony of Dr. Bederson states the same, also citing to paragraph 44 of Kaplan. Ex. 1003 ¶ 387.

We have reviewed paragraph 44 of Kaplan, and find that it does not support Petitioner's assertion and Dr. Bederson's testimony. We find nothing in paragraph 44 which indicates that the object contents of Favorites group and History Group are the same. Petitioner's assertion and Dr. Bederson's testimony are conclusory and unexplained. Additionally, Petitioner's accounting for limitation 16[f] appears to contradict the assertion that the first group of video information from "Favorites" and the second group of video information from "History" are the same.

When accounting for limitation 16[f], Petitioner refers to Kaplan's Figure 4, reproduced below:

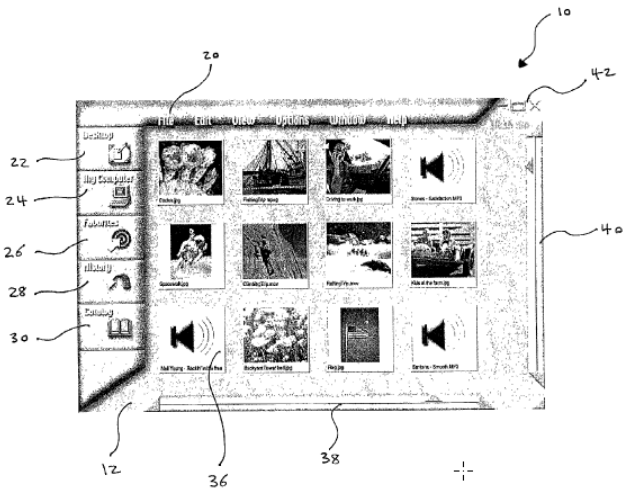

FIG.-4

Figure 4 illustrates the control options available to Kaplan's user via an interface. Ex. 1014 ¶ 14. Petitioner asserts:

> The first area includes a first character in the form of Favorites button 26 that includes the characters in the word "Favorites" and a bullseye icon. EX1014, ¶40; EX1009, 27-28; EX1003, ¶380. *Favorites is a classification for a first group of objects* such as videos that are represented by thumbnails because they were marked as a favorite of the user. EX1014, ¶42; EX1009, 27-28; EX1003, ¶380. The first area in blue in FIG. 4 also includes a second character in the form of History button 28 that includes the characters in the word "History" and a different icon. EX1014, ¶40; EX1009, 27-28; EX1003, ¶380. *History is a classification for a second group of objects such as videos (again represented by thumbnails) that different from the first group*, based on access of those objects by the user. EX1014, ¶¶42, 45; EX1009, 27-28; EX1003, ¶380.

Pet. 77–78 (emphasis added). This explanation contradicts the assertion in the context of limitation 16[i] that the first group of video information and the second group of video information are the same.

Patent Owner asserts that, as explicitly required by claim 1, the first group of video information is associated with the first user profile and the second group of video information is associated with the second user profile, citing claim limitations 16[f] and 16[h]. PO Resp. 64. We have reviewed claim 16, in particular limitations 16[b], 16[f], and 16[h], and find that, indeed, the first group of video information is associated with the first user profile and the second video information is associated with a second user profile. Thus, the first video information and the second video information are not within the same user profile. Further, in light of Petitioner's accounting for limitations 16[b] and 16[d], based on the teachings from Wong for the reasons to combine Wong's teachings as discussed by Petitioner, the first and second user profiles as applied by Petitioner are

associated with different users. Yet, the Favorites group and the History group relied on by Petitioner here appear to be within the same user profile, thus not satisfying limitation 16[i]. Pet. 77–78.

Petitioner asserts that collateral estoppel precludes Patent Owner from making arguments on limitations 16[i] through 16[l]. Reply 31. However, Petitioner only asserts that the language of limitations 16[j] and 16[k] is nearly identical, and is substantively identical, to limitation 2.9 of Patent 9,384,783, which was held by the Board in IPR2018-01432 "to be taught by Bryant alone and by the combination of Kaplan and Bryant." Pet. 84 (citing Ex. 1009, 31–36).

The deficiency of Petitioner's accounting here pertains to limitation 16[i] and limitations 16[b], 16[f], and 16[h], as explained above, with the focus on sharing video information between different user profiles. Limitation 2.9 in Patent 9,384,783, reproduced below, does not include any language in that regard, and Petitioner has not alleged that it does:

> wherein, even if one video information recorded on the recording medium included in both the first group of video information and the second group of video information is deleted from the first group of video information, the one video information continues to be included in the second group of video information.

IPR2018-01432, Paper 1, 41.

Because Petitioner has not shown that any issue adjudicated by the Board in IPR2018-01432 with regard to limitation 2.9 is the same or substantially the same as the matter here with respect to limitation 16[i], Petitioner's issue preclusion and estoppel argument is without merit for limitation 16[i].

For the foregoing reasons, Petitioner has not adequately accounted for limitation 16[i]. Petitioner has not proved by a preponderance of the

evidence that claim 16 would have been obvious of Kaplan, Bryant, Wong, and Candelore.

8. Claim 21

Claim 21 is substantially similar to claim 16. The above-discussed deficiency of Petitioner's accounting for limitation 16[i] equally applies to limitation 21[i].[16] Because Petitioner has not adequately accounted for limitation 21[i], Petitioner has not proved by a preponderance of the evidence that claim 21 would have been obvious over Kaplan, Bryant, Wong, and Candelore.

9. Claims 17–19 and 22–25

Claims 17–19 each depend from claim 16. Claims 22–25 each depend from claim 21. The deficiency of Petitioner's accounting for claim 16 equally applies to claims 17–19. The deficiency of Petitioner's accounting for claim 21 equally applies to claims 22–25. Petitioner has not proved by a preponderance of the evidence that any of claims 17–19 and 22–25 would have been obvious over Kaplan, Bryant, Wong, and Candelore.

I. Alleged Obviousness of Claims 20, 26, and 27 over Kaplan, Bryant, Wong, Candelore, and WinTV

Claim 20 depends from claim 16. Claims 26 and 27 each depend from claim 21. The deficiency of Petitioner's accounting of claim 16, discussed above, equally applies to claim 20. The deficiency of Petitioner's accounting of claim 21, discussed above, equally applies to claims 26 and 27. Petitioner's addition of WinTV does not cure the above-discussed deficiency of Petitioner's accounting of claims 16 and 21 as obvious over

[16] Limitation 21[i] reads: "the first group of video information and the second group of video information including one video information that is the same." Pet. viii.

Kaplan, Bryant, Wong, and Candelore. Accordingly, Petitioner has not proved by a preponderance of the evidence that claims 20, 26, and 27 would have been obvious over Kaplan, Bryant, Wong, Candelore, and WinTV.

J. Patent Owner's Motion to Exclude Evidence

Patent Owner's Motion to Exclude seeks to exclude Exhibit 1007 (Wong), WinTV (Ex. 1010), Exhibit 1008, Exhibit 1011, Exhibits 1051–1057, Exhibits 1065–1068, paragraphs 101–104, 194, 196–199, 200–204, 209, 270, 335, 337, 339, 341–344 and 419 of Ex. 1003, Exhibit 1070, Exhibit 1073, and a portion of Dr. Balakrishnan's deposition testimony (Ex. 1072, 52:9–68:12). Paper 29.

Exhibit 1007 is the prior art reference Wong. Patent Owner seeks to exclude it because according to Patent Owner it is not prior art. Paper 29, 10. However, we determined above that Wong is prior art to the challenged claims. And we also determined that Petitioner has not proved that any challenged claim is unpatentable.

Exhibits 1051–1057 were the subject of Petitioner's Motion to Submit Supplemental Information. Paper 16. We denied Petitioner's Motion to Submit Supplemental Information. Paper 35. Thus, these exhibits are not before us to consider exclusion.

With respect to Exhibit 1070, the Motion to Exclude does not explain why it should be excluded, and we have made no finding or conclusion adverse to Patent Owner on the basis of Exhibit 1070.

Exhibit 1010 is WinTV the prior art reference. All of the other evidence sought to be excluded by Patent Owner relate to Petitioner's efforts to show WinTV is a printed publication with a publication date prior to the effective filing date of the challenged claims.

We have concluded, without excluding any evidence, that Petitioner has not proved by a preponderance of the evidence that any challenged claim is unpatentable. Thus, the request to exclude WinTV and evidence relating to the publication date of WinTV is moot.

Patent Owner's Motion to Exclude Evidence is *dismissed* as moot.

III. CONCLUSION

We determine that Petitioner has not proved by a preponderance of the evidence that any of claims 16–27 of the '815 patent is unpatentable.

In summary:

Claims	35 U.S.C. §	References/Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
16–19, 21–25	103	Horn, Baumgartner, Candelore		16–19, 21–25
20, 26, 27	103	Horn, Baumgartner, Candelore, WinTV		20, 26, 27
16–27	103	Horn, Baumgartner, Candelore, WinTV, Chao		16–27
16–19, 21–25	103	Kaplan, Bryant, Wong, Candelore		16–19, 21–25
20, 26, 27	103	Kaplan, Bryant, Wong, Candelore, WinTV		20, 26, 27
Overall Outcome				16–27

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that claims 16–27 of the ’815 patent have not been proved unpatentable by a preponderance of the evidence;

FURTHER ORDERED that Patent Owner’s Motion to Exclude is *dismissed* as moot; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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