

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TIKTOK INC.,  
Petitioner,

v.

NTECH PROPERTIES, INC.,  
Patent Owner.

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IPR2024-01338  
Patent 8,875,185 B2

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Before KEN B. BARRETT, TERRENCE W. McMILLIN, and  
SCOTT RAEVSKY, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
*35 U.S.C. § 314*

## I. INTRODUCTION

### A. *Background and Summary*

TikTok Inc. (“Petitioner”)<sup>1</sup> filed a Petition for *inter partes* review of claims 1–20 of U.S. Patent No. 8,875,185 B2 (Ex. 1001, “the ’185 patent”). Paper 2 (“Pet.”). NTECH Properties, Inc. (“Patent Owner”)<sup>2</sup> filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314; 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”). The standard for institution is set forth in 35 U.S.C. § 314(a), which provides that *inter partes* review may not be instituted unless “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” After considering the Petition and the Preliminary Response, as well as the evidence of record, we deny institution of *inter partes* review of the ’185 patent.<sup>3</sup>

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<sup>1</sup> Petitioner identifies TikTok Inc., Bytedance Ltd., Bytedance Pte. Ltd., and TikTok Pte. Ltd. as real parties-in-interest. Pet. 2.

<sup>2</sup> Patent Owner identifies itself, NTECH Properties, Inc., as the real party-in-interest. Paper 4 (Patent Owner’s Mandatory Notices), 1.

<sup>3</sup> In addition to the Petition and Preliminary Response, Petitioner’s Preliminary Reply (Paper 7) and Patent Owner’s Preliminary Sur-reply (Paper 8) were filed. However, these papers were limited to arguments related to discretionary denial under 35 U.S.C. § 325(d). We do not reach the issue of discretionary denial in light of our decision to deny institution on the merits.

*B. Related Proceedings*

The parties identify the following district court matter related to the '185 patent: *NTECH Properties, Inc. v. ByteDance Ltd. et al.*, Case No. 2:24-cv-00130 (E.D. Tex., filed Feb. 23, 2024). Pet. 2; Paper 4, 1.

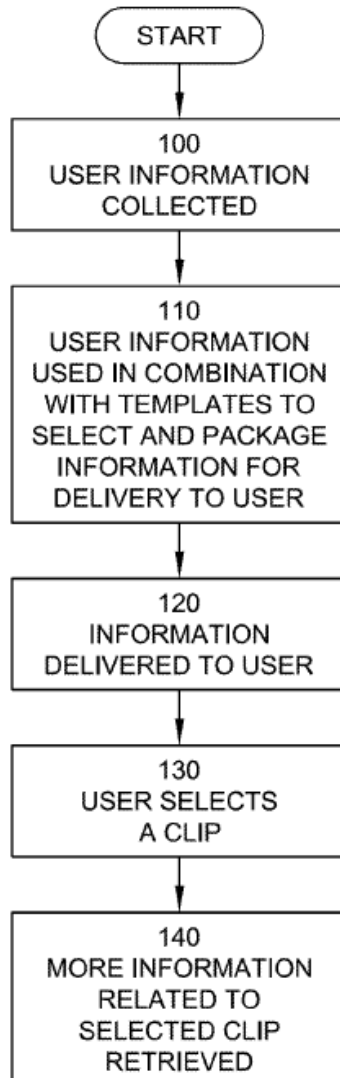
*C. The '185 patent (Ex. 1001)*

The '185 patent is titled “Method and Apparatus for Efficient, Entertaining Information Delivery.” Ex. 1001, code (54). The '185 patent “relates to the field of information delivery.” *Id.* at 1:22–24.

According to the description of the invention’s background, “[t]ypical information delivery systems (e.g., the WorldWide Web, video on demand, television, etc.) provide information to users inefficiently.” *Id.* at 1:28–30. For example, “in a [video on demand (VOD)] system, the user is able to select desired content from a list of available content” but the “user must search through and select from a list of available content.” *Id.* at 1:54–61.

“Embodiments of the present invention are directed to a method and apparatus for efficient, entertaining information delivery.” *Id.* at 2:6–8. “[I]nformation is partitioned into clips . . . selected for a user and packaged together for presentation to the user in an entertaining manner . . . accordan[t] with a template.” *Id.* at 1:6–12. “The user may select a clip to retrieve additional information related to the clip.” *Id.* at 2:21–22. “[T]he selected clip is a portion of a program (e.g., a television show, a movie, a song, an advertisement, etc.) and the additional information is a larger clip of the program and/or the entire program.” *Id.* at 2:22–26.

Figure 1, reproduced below, “is a flow diagram of the process of delivering information in accordance with one embodiment of the present invention.” *Id.* at 2:46–48.



At block 110, “the user information is used in combination with templates to select and package the information for delivery to the user,” e.g., “concatenating clips together to form a stream of data.” *Id.* at 3:28–36. At blocks 120 and 130, respectively, “the information is delivered to the user” and “the user selects a clip.” *Id.* at 3:39–40. At block 140, “more information related to the selected clip is retrieved,” e.g., “the selected clip is a portion of a media program . . . and the entire media program is retrieved.” *Id.* at 3:42–46.

*D. Challenged Claims*

Petitioner challenges claims 1–20 of the '185 patent. Pet. 3–4. Sole independent claim 1 recites (Petition's identifiers of limitations inserted in brackets):

- 1[pre] 1. A method of providing video programming to a user, comprising the steps of:
  - 1[a] searching, by one or more computing devices, one or more databases of video clips in response to a user request wherein each video clip comprises a plurality of frames;
  - 1[b] selecting, by one or more of said computing devices, a plurality of first video clips responsive to the user request, wherein each first video clip is associated with media content comprising one or more second video clips;
  - 1[c] selecting, by one or more of said computing devices, a plurality of first transitional clips for association with at least some of the selected first video clips;
  - 1[d] determining a first temporal sequence for concatenating the selected first video clips and first transitional clips;
  - 1[e] wherein said selecting, determining and concatenating is performed according to one or more first templates, to define first video programming, wherein said one or more first templates comprise a plurality of variables corresponding to (a) information about the user, (b) viewing scenarios of two or more selected video clips in a temporal relationship to each other, and (c) style requirements; and
  - 1[f] presenting said first video programming in a first area of a display associated with one of said computing devices;
  - 1[g] concurrently with said presenting said first video programming, presenting one or more frames from one or more displayed first video clips from the first video programming in a second area of said display;
  - 1[h] receiving, by one or more of said computing devices, a user selection corresponding to at least one of the frames

of at least one first video clip presented in the second area of the display;

- 1[i] selecting, by one or more of said computing devices, a second video clip based on at least one stored association between the second video clip and at least one first video clip indicated by said user selection;
- 1[j] selecting, by one or more of said computing devices, a plurality of video clips including the second video clip, and determining a second temporal sequence for concatenating the selected plurality of second video clips, wherein said selecting, determining, and concatenating is performed in accordance with one or more first or second templates, to define second video programming;
- 1[k] wherein said one or more first or second templates comprises a plurality of variables corresponding to (a) information about the user, (b) viewing scenarios of two or more selected video clips in a temporal relationship to each other, and (c) style requirements; and
- 1[l] presenting said second video programming on a display associated with one or more of said computing devices.

Ex. 1001, 4:53–5:36.

*E. The Asserted Grounds*

Petitioner challenges claims 1–20 of the '185 patent based on the grounds set forth in the table below.

|   | <b>Claims<br/>Challenged</b> | <b>35 U.S.C. §</b>  | <b>Reference(s)/Basis</b>                    |
|---|------------------------------|---------------------|----------------------------------------------|
| 1 | 1–20                         | 103(a) <sup>4</sup> | Marcus156 <sup>5</sup>                       |
| 2 | 1–20                         | 103(a)              | Marcus156, Rosen <sup>6</sup>                |
| 3 | 1–20                         | 103(a)              | Marcus156, Sull <sup>7</sup>                 |
| 4 | 1–20                         | 103(a)              | Marcus156, Rosen, Hosken <sup>8</sup>        |
| 5 | 1–20                         | 103(a)              | Marcus156, Sull, Hosken                      |
| 6 | 8, 16                        | 103(a)              | Marcus156, Rosen, Hosken, Byers <sup>9</sup> |
| 7 | 8, 16                        | 103(a)              | Marcus156, Sull, Hosken, Byers               |
| 8 | 1–7, 9–15,<br>17–20          | 103(a)              | Ferman <sup>10</sup>                         |
| 9 | 8, 16                        | 103(a)              | Ferman, Byers                                |

Pet. 3–4.

Petitioner supports its showing of unpatentability of the challenged claims of the '185 patent with the Declaration of Dr. Kevin Almeroth (Ex. 1002).

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<sup>4</sup> The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103, and was effective on March 16, 2013. The application for the '185 patent is a U.S. continuation application of U.S. Ser. No. 10/874,819 filed June 23, 2004 (and now abandoned). 1:6–9. Because the '359 patent claims a priority date before the effective date of the applicable AIA amendment, we assume the pre-AIA version of § 103 applies for purposes of institution.

<sup>5</sup> US 6,032,156, issued Feb. 29, 2000 (Ex. 1009).

<sup>6</sup> US 2004/0201610 A1, published Oct. 14, 2004 (Ex. 1011).

<sup>7</sup> US 2002/0069218 A2, published June 6, 2002 (Ex. 1010).

<sup>8</sup> WO 01/06398 A2, published Jan. 25, 2001 (Ex. 1013).

<sup>9</sup> US 7,334,249 B1, issued Feb. 19, 2008 (Ex. 1014).

<sup>10</sup> US 2002/0059584 A1, published May 16, 2002 (Ex. 1012).

## II. OBVIOUSNESS ANALYSIS

### A. *Principles of Law*

Under 35 U.S.C. § 103(a), “[a] patent claim is unpatentable if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (similar language). The question of obviousness involves resolving 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 ordinary skill in the art; and when presented (4) objective evidence of non-obviousness (not presented here). *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Further, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *See KSR*, 550 U.S. at 418.

### B. *Level of Ordinary Skill in the Art*

Petitioner contends:

A person of ordinary skill in the art at the time of the ’185 patent (“POSITA”) had at least a Bachelor of Science in electrical engineering, computer engineering, or similar fields and at least two years of practical experience in the field of media processing and/or transmission. More education can supplement for less practical experience, and vice versa.

Pet. 5. Patent Owner does not dispute Petitioner’s description.

Prelim. Resp. 23.

Determining the level of ordinary skill in the art involves various factors, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made;

sophistication of the technology; and educational level of active workers in the field.” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citation omitted). The prior art of record also reflects the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). For purposes of this Institution Decision, we adopt the description offered by Petitioner. It is not disputed by the Patent Owner and is consistent with the ’185 patent and the asserted prior art.

### C. Claim Construction

In *inter partes* reviews, the Board construes claims using the same claim construction standard employed in a civil action under 35 U.S.C. § 282(b). 37 C.F.R. § 42.100(b). The “words of a claim ‘are generally given their ordinary and customary meaning,’” as would have been understood by a person of ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17).

Neither Petitioner nor Patent Owner requests express claim construction. Pet. 5; Prelim. Resp. 23. And, no need exists to expressly construe any claim terms to resolve this dispute. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe 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))).

*D. Analysis of Grounds Relying on Marcus156*

In asserted grounds 1–7, Petitioner challenges all the claims of the ’185 patent as obvious based solely, or primarily, on Marcus156. Pet. 3–4, 10–48. For these grounds, Petitioner alleges that Marcus156 teaches or suggests limitations of sole independent claim 1 that we determine are not taught or suggested by Marcus156. Accordingly, we determine that there is not a reasonable likelihood that Petitioner would prevail with respect to any claim of the ’185 patent based on any of the grounds relying on Marcus156.

We start our analysis of these grounds with a description of the disclosure of Marcus156 and then consider whether Marcus156 teaches or suggests certain limitations of claim 1 of the ’185 patent.

*1. Marcus156 (Ex. 1009)*

Marcus156<sup>11</sup> is titled “System for Automated Generation of Media.” Ex. 1009, code (54). Marcus “relates to . . . creation of audiovisual programming.” *Id.* at 1:11–13.

According to the description of the invention’s background, the art already included a “capacity to design customized audio visual programs for specific purposes from a library of existing video clips and audio elements.” *Id.* at 1:16–19. However, “a human editor must make the ultimate selection

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<sup>11</sup> Marcus156 is incorporated by reference into the ’185 patent (Ex. 1001, 1:15–18) and is a reference cited in the ’185 patent (*id.*, code (56)). Both parties acknowledge that Marcus156 was considered and discussed by the Examiner during prosecution of the application for the ’185 patent and that the challenged claims of the ’185 patent were allowed over Marcus156. Pet. 6, 72–74; Prelim. Resp. 6–13.

of individual clips[,] provide the final editing decisions, [e.g.,] creation and selection of transitions so that there is a smooth visual and audio transition between adjoining clips in the program, and check[] the content of the clips to determine that there is proper coverage of the appropriate subject matter in an appropriate sequence.” *Id.* at 1:39–48.

Marcus156’s system provides, in response to a request for media programming, automated selecting of media elements and their temporal organization. *Id.* at 2:1–3. “The system selects and orders the media elements according to the data in the request[] and . . . permitted transitions[] regarding the media elements.” *Id.* at 2:6–9. “[E]ach clip . . . has associated therewith additional information often arranged in a hierarchical manner.” *Id.* at 3:1–3. “Individual items of information within [a] header[,] referred to . . . as tags[,] . . . are divided into two general categories[—]namely control tags 115 and content tags 120.” *Id.* at 3:4–7. “Content tags [] contain information identifying the content of the clip[:] . . . information communicated by the clip[;] . . . viewer profiles for viewers most likely to be receptive to the clip[;] . . . and intended use of the clip.” *Id.* at 3:7–13. “[C]ontrol tags define audio and video components of clips[;]” video control tags and audio control tags each identifying respective transition points, e.g., “an optimum transition point from the beginning of the clip.” *Id.* at 5:3–10. Additionally, optional tags can indicate a luminance range, dominant chroma value, key of music, and tempo of music for the opening and closing of a clip. *Id.* at 5:26–35.

The system includes an “editor program” that produces an edit decision list (EDL) based on a topic and demographics for user/s of media programming. *Id.* at 6:65–7:3. Generally, to create a program, the editor

program selects clips, revises their order, determines transitions between clips, and inserts the transitions. *Id.* at 7:4–9. The editor program thus “makes transition selections at the beginning and end of the audio and video portions of each clip.” *Id.* at 8:32–35. And, if there is an incompatibility, the editor discards an element and replaces it with a substitute element.” *Id.* at 8:36–38.

In one embodiment, a user of the system creates queries, the different items therein are weighted, and the editor program identifies suitable templates and sequences for clips based on the items as weighted. *Id.* at 9:9–15. As part thereof, the editor program selects templates each identifying demographic characteristics, information to be conveyed, and sequential requirements required for a program. *Id.* at 8:14–19. “Truth tables” of the editor program select and order one or more suitable modules and floater sequences. *Id.* at 8:23–24; *see also id.* at 4:28–31 (floaters are elements “free to float temporally in order to accomplish certain transitions”). The truth tables also “determine whether a direct transition between any two clips meets aesthetic requirements,” e.g., “if the keys of the music in two adjacent clips are incompatible,” and, “[i]f not, [the system may] identify a suitable type of transition for both clips, add a bridge between the clips, or determine that one of the clips must be discarded.” *Id.* at 8:48–55.

## 2. *Limitations 1[j], 1[k], and 1[l]*

Petitioner relies on Marcus<sup>156</sup> as allegedly teaching or suggesting limitations 1[j], 1[k], and 1[l] of the challenged claims of the ’185 patent.<sup>12</sup>

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<sup>12</sup> Claim 1 is the sole independent claim of the ’185 patent. Ex. 1001, 4:53–6:52. Claims 2–20 depend, directly or indirectly, on claim 1. *Id.* at 5:37–

Pet. 26–27. Patent Owner argues that Petitioner has failed to establish that Marcus156 teaches or suggests these limitations. Prelim. Resp. 27–31.

Limitations 1[j], 1[k], and 1[l] recite:

1[j] *selecting, by one or more of said computing devices, a plurality of video clips including the second video clip, and determining a second temporal sequence for concatenating the selected plurality of second video clips, wherein said selecting, determining, and concatenating is performed in accordance with one or more first or second templates, to define **second video programming**;*

1[k] *wherein said one or more first or second templates comprises a plurality of variables corresponding to (a) information about the user, (b) viewing scenarios of two or more selected video clips in a temporal relationship to each other, and (c) style requirements; and*

1[l] *presenting said **second video programming** on a display associated with one or more of said computing devices.*

Ex. 1001, 5:23–36 (emphasis added). These limitations relate to “*selecting, determining, and concatenating*” “*a plurality of video clips*” “*to define second video programming*” and “*presenting said second video programming.*”

Patent Owner argues that, “[u]ser interactions with Marcus156’s video programming can add new clips to existing programming, but Marcus156 does not contemplate, teach, or suggest defining second programming.” Prelim. Resp. 2; *see also id.* at 7 (“Marcus156 does not disclose the claim features of ‘defin[ing] [a] second video programming,’ different from the first video programming that forms the basis for selecting the second video

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6:52. By virtue of their dependency on claim 1, claims 2–20 incorporate limitations 1[j], 1[k], and 1[l]. Accordingly, all the challenged claims include limitations 1[j], 1[k], and 1[l].

programming, and which selection adheres with ‘first or second templates’ comprising user information, viewing scenarios, and style requirements.”). Patent Owner contends that “Marcus156’s interactive system only presents a customized first video programming in which additional video clips are incorporated into that same programming upon viewer selection.” *Id.* at 7; *see also id.* at 26 (“[R]ather than generating second video programming based on [user] interaction, Marcus156 discloses adding new clips to the same video programming.”). For the reasons given below, we believe that this criticism of Petitioner’s showing as to these limitations is valid in view of Marcus156.

With regard to limitation 1[j], the Petition provides:

***Selecting, sequencing, and concatenating second video clips using templates:*** The same systems, data (in particular, templates), and algorithms that Marcus156’s system used to select a plurality of first video clips, determine a temporal sequence for them, and concatenate them are used in the second search to perform the same actions on a plurality of second video clips. The material in 1[b], 1[d], 1[e], and 1[i] applies here too. Almeroth ¶227.

Pet. 26–27. This passage does not address all the elements of the claimed invention recited in limitation 1[j]. For example, limitation 1[j] recites taking steps “*to define second video programming*,” but this passage does not even use the term “*second video programming*” or any like or equivalent term. We find this passage in the Petition provides an inadequate explanation as to how the system in Marcus156 “*define[s] the second video programming*” as recited in this limitation.<sup>13</sup>

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<sup>13</sup> At the end of this passage, Petitioner cites to paragraph 227 of the Almeroth Declaration (Ex. 1002) which provides:

Petitioner does not explain how the same systems, data, templates, and algorithms used in Marcus156 to select the first video clips to define the first video programming (*see* limitation 1[e] (Ex. 1001, 5:1–8)) are used on the plurality of second video clips. And, this passage in the Petition does not explain how or why “[t]he material in 1[b], 1[d], 1[e], and 1[i] applies here too.”<sup>14</sup> These contentions are conclusory and unsupported.

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***Selecting, by one or more of said computing devices, a plurality of video clips including the second video clip, and determining a second temporal sequence for concatenating the selected plurality of second video clips, wherein said selecting, determining, and concatenating is performed in accordance with one or more first or second templates, to define second video programming:*** The same systems, data, templates, and algorithms that Marcus156’s system used to select a plurality of first video clips, determine a temporal sequence for them, and concatenate them are used in the second search. Therefore, in my opinion, all of the evidence and analysis reviewed above in the context of elements 1[b], 1[d], 1[e], and 1[i] applies to this element as well.

Ex. 1002 ¶ 227. Uncited paragraph 226 of the Almeroth Declaration states with regard to limitation 1[j]:, “[i]m my opinion, Marcus156 discloses this element.” There is no explanation or supporting evidence or reasoning for this conclusion. The Almeroth Declaration does not disclose the underlying facts or data on which the testimony on this limitation is based and is conclusory. We accord this testimony little or no weight. *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”). Regardless, Petitioner’s failure to cite paragraph 226 of the Almeroth Declaration further undermines Petitioner’s case.

<sup>14</sup> This sentence is ambiguous. Although the Petition does not explain this sentence to mean that the evidence and analysis in the Petition presented with regard to limitations 1[b], 1[d], 1[e], and 1[i] is what “applies here too,” this is how we are interpreting this sentence in light of paragraph 227 of the Almeroth Declaration. Alternatively, this sentence could possibly mean that

These contentions are also contradicted by Marcus156. In Marcus156, the user views a video (the “*first video programming*” in Petitioner’s mapping) (for example, a “tour of a three-dimensional model of the heart” (Ex. 1009, 14:45–46)) and clicks on the screen to get more information (*id.* at 46–52) (“When the user moves a pointer or mouse to a particular portion of the screen, and clicks on the screen, the system may select, for example, assets incorporating more detailed information on certain portions of the heart corresponding to material on the portion of the screen where the mouse was located when clicked.”). Then, the system adds these “assets” to the programming. *See id.* at 14:43–45 (“The system will then generate suitable transitions and add those assets to the programming.”), 14:52–55 (“The system applies suitable transitions to the assets and incorporates these assets into the programming interactively in response to mouse clicks or other suitable input from the viewer.”). Petitioner does not explain, and we do not discern, why it would be necessary or appropriate in the method of Marcus156 to use the same systems, data, templates, and algorithms used in Marcus156 to select the first video clips to define the first video programming to define video programming that only relates to addition of these “assets” to the first video programming. And, Petitioner does not direct our attention to any disclosure in Marcus156 of using the same systems, data, templates, and algorithms used to select the first video clips to define the first video programming to define second video programming.

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the material recited in limitations 1[b], 1[d], 1[e], and 1[i] applies to this limitation too, but this is not how we are interpreting this sentence.

Patent Owner contends that “Petitioner essentially ignores the ‘define a second video programming’ language in its analysis of this limitation, which is sufficient for the Board to find Grounds 1-7 meritless.” Prelim.

Resp. 27. More specifically, Patent Owner argues:

The closest Petitioner comes to addressing this limitation is its unexplained [assertion] that Marcus156 discloses “the generation of a new stream of video programming.” Pet. at 25 (citing Marcus156 at 14:40-45, 14:46-55, 7:11-15<sup>[15]</sup>). However, the first two (unexplained) citations confirm that if and when Marcus156’s interactive system performs “additional interactive searches” (in Petitioner’s parlance) no “new stream of video programming” is generated. *Id.* (citing Marcus156 at 14:40-55). Instead, when appropriate assets are identified, they are added to the existing video programming:

At this point, the system may select assets that are appropriate to the particular information that the viewer appears to be seeking based on the information on the screen at the time. The system will then generate suitable transitions and **add those assets to the programming**. For example, the program may be a tour of a three-dimensional model of the heart. When the user moves a pointer or mouse to a particular portion of the screen, and clicks on the screen, the system may select, for example, assets incorporating more detailed information on certain portions of the heart corresponding to material on the portion of the screen where the mouse was located when clicked. The system applies suitable transitions to the assets and **incorporates these assets into the programming interactively** in response to mouse

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<sup>15</sup> Patent Owner correctly asserts that this citation to Marcus 156, 7:11–15, relates to the List Editor/Previewer described in Marcus156 that is utilized by the production editor of a video program and does not relate to “a user selection corresponding to at least one of the frames of at least one video clip” as recited in limitation 1[h]. Prelim. Resp. 28–29.

clicks or other suitable input from the viewer.  
Marcus156 at 14:40-55 (emphasis added). This passage explicitly contradicts Petitioner’s claim that Marcus156 discloses generating a “new stream of video programming” based on interactive searches and video selections. Pet. at 25.

*Id.* at 27–28. We agree with Patent Owner that the Petition fails to provide support for its assertion that limitation 1[j] is taught or suggested by Marcus156.

With regard to limitation 1[k], the Petition provides:

***Templates:*** The templates used in follow-up searches in Marcus156’s system can be the same as or different from the initial search (discussed in 1[e]). While searching, the system “selects and orders one or more suitable templates” first. Marcus156, 8:13-15. The interactive searches at 14:35-67 use templates, just as any initial search does. As in 1[e], those templates contain the required (a), (b), and (c) information. Almeroth ¶229.<sup>16</sup>

Pet. 27. This passage cites Marcus156, 14:35–67, relating to interactive searches by the user, but fails to explain, and we do not discern from reviewing Marcus156, how this citation supports the assertion that “[t]he interactive searches at 14:35–67 use templates, just as any initial search does.” This passage fails to provide adequate explanation or reasoning and fails to cite supporting evidence that Marcus156 teaches or suggests limitation 1[k].

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<sup>16</sup> Here again, we find that the cited paragraph in the Almeroth Declaration (¶ 229) does no more than recite the limitation and repeat, almost verbatim, the language in the Petition without any further explanation or supporting reasoning or evidence. We give this testimony little or no weight.

Patent Owner contends that Petitioner fails to establish that Marcus156 discloses limitation 1[k]. Prelim. Resp. 29–30. More specifically, Patent Owner argues:

Aside from the fact that Marcus156 discloses incorporating new assets into the same program rather than defining a second video programming, the new clips are selected in accordance with the information on the screen, ***not template rules***. Tellingly, where Petitioner mentions templates, it provides only conclusory statements that the same actions performed on the “initial search” are also performed on “follow-up searches,” *i.e.* a viewer’s interactive searches. Pet. at 27 (“templates used in follow-up searches in Marcus156’s system can be the same as or different from the initial search”). No disclosure in Marcus156 substantiates this claim, and Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

In any event, Marcus156 contradicts Petitioner’s conclusory statements. Rather than “selecting, determining, and concatenating” the plurality of second video clips in accordance with one or more templates, Marcus156 “select[s] assets that are appropriate to the particular information that the viewer appears to be seeking based on the information on the screen at the time.” *See* Marcus156 at 14:40-43. Accordingly, Marcus156 does not disclose selecting “a plurality of video clips including the second video clip” in accordance with template rules. ’185 Patent at Claim 1. This makes sense because if the user seeks out “more detailed information” about material on a certain part of the screen, Marcus156 will add the requested information regardless of the template rules used to select, determine, and concatenate the clips chosen for the original video programming. Marcus156 at 14:46-52.

*Id.* Patent Owner’s criticism of the showing in the Petition as to limitation 1[k] has merit and is better supported by the disclosure of Marcus156.

With regard to limitation 1[l], the Petition provides:

***Presenting second video programming:*** After performing a follow-up search and defining second video programming, the programming is displayed on the computing device's display, just like the first video programming. Marcus156, 14:52-55; 14:61-67; Almeroth ¶231. Additional detail is in 1[f].

Pet. 27. Patent Owner argues that, “[f]or the reasons discussed above, Petitioner also fails to demonstrate that Marcus156 provides for the presentation of a second video programming following the ‘follow-up search.’ Again, this search simply results in the presentation of the that same video program, just with additional clips incorporated therein.” Prelim. Resp. 31. Patent Owner’s argument has merit. Petitioner fails to explain how the cited evidence supports a finding that Marcus156 teaches or suggests “presenting said second video programming” as recited in claim 1.

Patent Owner’s arguments<sup>17</sup> with regard to limitations 1[j], 1[k], and 1[l] are valid in view of the disclosure of Marcus156 and the inadequate analysis of limitations 1[j], 1[k], and 1[l] in the Petition. We determine that Petitioner has failed to establish a reasonable likelihood of showing Marcus156 teaches or suggests limitations 1[j], 1[k], and 1[l].

*E. Analysis of Grounds Relying on Ferman*

In asserted grounds 8 and 9, Petitioner challenges all the claims of the ’185 patent as obvious based solely, or primarily, on Ferman. Pet. 3–4, 48–71. For these grounds, Petitioner alleges that Ferman teaches or suggests

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<sup>17</sup> Patent Owner presents additional arguments challenging the Petition that appear to have merit. However, because we determine that Petitioner has failed to establish the unpatentability of the challenged claims based on our analysis of the limitations discussed in this decision, we need not reach these additional arguments.

limitations of sole independent claim 1 that we determine are not taught or suggested by Ferman. Accordingly, we determine that there is not a reasonable likelihood that Petitioner would prevail with respect to any claim of the '185 patent based on the grounds relying on Ferman.

We start our analysis of these grounds with a description of the disclosure of Ferman and then consider whether Ferman teaches or suggests certain limitations of claim 1 of the '185 patent.

*1. Ferman (Ex. 1012)*

Ferman is titled “Audiovisual Management System.” Ex. 1009, code (54). According to the description of the invention’s background, prior systems require a “linear” search of items selected for viewing. *Id.* ¶¶ 2–3. For example, a viewer may program a video cassette recorder (VCR) based on a television guide, but “the viewer scans through the entire video tape to select relevant portions of the program for viewing using . . . fast forward and fast reverse.” *Id.* ¶ 2. “Hard disk” systems (e.g., TiVo) record and play television broadcasts in a manner similar to a VCR, but “viewing the recorded programs occurs in a linear manner and may require substantial time.” *Id.* ¶ 3. “[T]he user should be able to access only that portion of all of the available information that the user is interested in, while skipping the remainder of the information.” *Id.* ¶ 90.

In Ferman’s system, “[a] program description scheme 18 related to the video, still image, and/or audio information 10 preferably includes two sets of information[—]namely, program views and program profiles.” *Id.* ¶ 94. “[T]he program views may contain a set of fields that contain data for the identification of key frames, segment definitions between shots, highlight definitions, video summary definitions, different lengths of highlights,

thumbnail set of frames, individual shots or scenes, representative frame of the video, grouping of different events, and a close-up view[,] . . . so that users can filter and search not only at the program level but also within a particular program.” *Id.* “The program profiles define distinctive characteristics of the content of the program, [e.g.,] actors, stars, rating, director, release date, time stamps, keyword identification, trigger profile, still profile, event profile, character profile, object profile, color profile, texture profile, shape profile, motion profile, and categories[,] . . . [so] to facilitate filtering and searching of the audio and video information.” *Id.*

“[A] user description scheme 20 preferably includes the user's personal preferences, and information regarding the user's viewing history such as for example browsing history, filtering history, searching history, and device setting history.” *Id.* ¶ 97. “The user's personal preferences includes information regarding particular programs and categorizations of programs that the user prefers to view.” *Id.* “The user description scheme may also include personal information about the particular user, such as demographic and geographic information, e.g. zip code and age.” *Id.* “The user description scheme is generated by direct user input, and by using a software that watches the user to determine his/her usage pattern and usage history.” *Id.* ¶ 112. “A well-defined and structured description scheme design allows different devices to interoperate with each other.” *Id.* “The proposed user description scheme includes three major sections for describing a user[: (1)] . . . identifies the described user[: (2)] . . . records a number of settings which may be preferred by the user[: and (3)] . . . records some statistics which may reflect certain usage patterns of the user.” *Id.* ¶ 196.

“[A] system description scheme 22 preferably manages the individual programs and other data” by “maintaining lists of programs, categories, channels, users, videos, audio, and images.” *Id.* ¶ 98. “The management may include the capabilities of a device for providing the audio, video, and/or images.” *Id.*

“The descriptors of the program description scheme and the user description scheme should overlap, at least partially, so that potential desirability of the program can be determined by comparing descriptors representative of the same information,” e.g., such that “the program and user description scheme may include the same set of categories and actors.” *Id.* ¶ 99. “The program description scheme and the system description scheme should include at least partially overlapping fields,” such that “the system description scheme will be capable of storing the information contained within the program description scheme[ and] the information is properly indexed.” *Id.* ¶ 101.

“[A] search engine uses the information contained in the program description scheme to retrieve programs on the basis of their content.” *Id.* ¶ 117. “The user description scheme can be used in prioritizing the results of the user query during presentation.” *Id.* “The program description scheme can also be used in navigating through the contents of the database or the query results.” *Id.* For example, “[w]hen each ‘individual preference’ is evaluated against the corresponding information from the program descriptions a score is calculated for that individual preference.” *Id.* ¶ 410. “[a] composite score from the aggregation of individual scores . . . is then compared against other composite scores for other program descriptions to determine a relative ranking.” *Id.*

“[T]he user can view a thumbnail view of different categories of programs stored in the system.” *Id.* ¶ 114. “The user then may choose frame view, shot view, key frame view, or highlight view, depending on their availability and user's preference.” *Id.* “Selecting a particular category, such as news, provides a set of thumbnail views of different programs that are currently available for viewing[;] . . . [t]he thumbnail views are short video segments that provide an indication of the content of the respective actual program that it corresponds with.” *Id.* ¶ 124.

2. *Limitations 1[c], 1[d], 1[f], 1[g], 1[h], 1[i], and 1[j]*

Petitioner relies on Ferman as allegedly teaching or suggesting limitations 1[c], 1[d], 1[f], 1[g], 1[h], 1[i], and 1[j] of the challenged claims of the '185 patent. Pet. 52–62. Patent Owner argues that Petitioner has failed to establish that Ferman teaches or suggests these limitations. Prelim. Resp. 37–43.

Limitations 1[c], 1[d], 1[f], 1[g], 1[h], 1[i], and 1[j] recite:

- 1[c] *selecting, by one or more of said computing devices, a plurality of first transitional clips for association with at least some of the selected first video clips;*
- 1[d] *determining a first temporal sequence for concatenating the selected first video clips and first transitional clips;*
- 1[f] *presenting said first video programming in a first area of a display associated with one of said computing devices;*
- 1[g] *concurrently with said presenting said first video programming, presenting one or more frames from one or more displayed first video clips from the first video programming in a second area of said display;*
- 1[h] *receiving, by one or more of said computing devices, a user selection corresponding to at least one of the frames of at least one first video clip presented in the second area of the display;*

- 1[i] *selecting, by one or more of said computing devices, a second video clip based on at least one stored association between the second video clip and at least one first video clip indicated by said user selection; and*
- 1[j] *selecting, by one or more of said computing devices, a plurality of video clips including the second video clip, and determining a second temporal sequence for concatenating the selected plurality of second video clips, wherein said selecting, determining, and concatenating is performed in accordance with one or more first or second templates, to define second video programming.*

Ex. 1001, 4:63–5:29.

With regard to limitation 1[c], the Petition provides:

***Selecting transitional clips:*** Ferman’s system filters and segments a video program “into story units, scenes, and shots.” Ferman [0252]. The set of segments includes multiple major events in the video clip, including events which transition between other clips. *Id.* [0094]; [0252] (syntactic structure description scheme segments clips via a “segment tree [which] may be used to define[] a temporal structure of a video program”); [255] (semantic description scheme segments clips into events, reflected in an event description scheme). In particular, the set of sub-segments for given preferred program are related to each other as a sequence of events that pertain to the same overall program. *Id.* [0094] (“grouping of different events”). Based on the user’s viewing preferences, a set of initial preferred programs can be supplemented by sub-segments from those programs that are automatically selected. A POSITA would consider these video segments, which are thematically and structurally related to other surrounding video clips, to be “transitional clips.” Almeroth ¶343.

To the extent PO contends that these clips do not qualify as “transitional clips,” it would have been obvious for a POSITA to modify Ferman’s system to more explicitly select clips for inclusion in the final video programming based on their ability to transition between other events. A POSITA would have been motivated to do so by at least Ferman’s expressed desire to “include content suited to [the user’s]

particular viewing preferences.” Ferman [0089]. Moreover, doing so would provide more compelling and cohesive video programming. A POSITA would have had a reasonable expectation of success in making any necessary changes to Ferman’s system to more explicitly include transitions, including because Ferman already categorizes sub-sections of a video program by their contextual relationship to other sections. *Id.* [0094]; Almeroth ¶344.<sup>18</sup>

Pet. 52–53. We have reviewed each of the cited paragraphs in Ferman referred to by Petitioner in this passage and we can find no disclosure of transitional clips or any comparable or related concept. Moreover, limitation 1[c] recites, “*selecting, by one or more of said computing devices, a plurality of first transitional clips for association with at least some of the selected first video clips.*” We can find no teaching or suggestion in the cited paragraphs of Ferman (or elsewhere in Ferman) that supports finding that Ferman teaches or suggests selecting clips that transition between the selected first video clips. There is no support for this contention in the cited paragraphs (and none that we can otherwise discern in Ferman).

With regard to Petitioner’s contention that “it would have been obvious for a POSITA to modify Ferman’s system to more explicitly select clips for inclusion in the final video programming based on their ability to transition between other events,” we determine that this contention is not adequately supported by articulated reasoning. *See* Pet. 52–53. Petitioner asserts that, “[a] POSITA would have been motivated to do so by at least Ferman’s expressed desire to ‘include content suited to [the user’s]

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<sup>18</sup> We have considered the cited paragraphs in the Almeroth Declaration (Ex. 1002 ¶¶ 343, 344) and find that the testimony is conclusory and includes no supporting reasoning or evidence. We give this testimony little or no weight.

particular viewing preferences.” *Id.* (citing Ex. 1002 ¶89). There is no articulated reasoning (and we can discern none) as to how or why including content suited to a user’s preferences would have motivated a skilled artisan to modify Ferman to select transitional clips. Petitioner also asserts, “doing so would provide more compelling and cohesive video programming.” *Id.* at 53. There is no articulated reasoning or explanation for this assertion and we find this statement to be too general and unsupported. We determine that Petitioner has not established that a skilled artisan would be motivated to modify Ferman’s system as proposed in the Petition.

Patent Owner argues that “Petitioner fails to demonstrate that Ferman discloses ‘selecting . . . a plurality of first transitional clips.’” Prelim. Resp. 41. We agree with Patent Owner that the Petition fails to provide adequate support for its assertion that limitation 1[c] is taught or suggested by Ferman.

With regard to limitation 1[d], the Petition provides:

***Temporal sequence:*** The selection of video clips and transitional clips in turn determines a temporal sequence for the concatenated video programming. Ferman [0252] (“Such a segment tree may be used to define[] a temporal structure of a video program.”). Additionally, the video programming is sequenced based on information in the program description scheme and/or event description scheme. *Id.* [0095] (sequencing program views using the program description scheme); [0255] (“The event description scheme 480 may be used to form relationships between different events of the video normally consisting of multiple frames of the video.”); Almeroth ¶348.

***Concatenating:*** The responsive video clip and transitions are concatenated and presented as a stream of video programming to the user. Ferman [0607] (“PlayStream Play content from input stream”); [0107] (“summarization functionality of the system...prepare[s] a summary”); [0111];

[0114] (“The user at any time can start viewing the program either in parts, or in its entirety.”). The system can generate a highlight video of a given length that consists of multiple subsidiary highlight or event clips concatenated and presented together. *Id.* [0267] (15-minute highlight); Fig. 10; [0107] (5-minute highlight). The act of generating a single video highlight from multiple previously separate clips qualifies as “concatenating.” Almeroth ¶349.

To the extent that PO may argue that concatenation of the video clips is not explicitly described in Ferman, it would have been obvious for a POSITA to modify Ferman’s system to record and allow viewing of archival copies of the sequence of programming viewed by a user, which would be a concatenated video stream. A POSITA would have been motivated to make the modification because it would allow its system to achieve better VCR-like functionality. Moreover, concatenating clips would lead to a more coherent viewing experience corresponding, for example, to a single highlight video rather than disparate clips. A POSITA would also have had a reasonable expectation of success in making the modification, because Ferman’s system already has video recording capability. Ferman [0107]; Almeroth ¶350.

Pet. 53–55. With regard to the first sentence of this passage, Ferman does not “*determin[e] a first temporal sequence for concatenating the selected first video clips and first **transitional clips**,*” as recited in limitation 1[d], because, as discussed immediately above with regard to limitation 1[c], Ferman does not disclose “*selecting . . . first **transitional clips**.*” None of the cited paragraphs in Ferman make any reference to transitional clips or any comparable or related concept. Moreover, the selected video clips are sequenced based on their existing order or temporal sequence. The system in Ferman has not been shown to determine the temporal sequence. In this regard, Petitioner is correct that, “[t]he selection of video clips . . . in turn determines a temporal sequence for the concatenated video programming.”

Pet. 53. The “*selecting . . . first video clips*” as recited in limitation 1[b] is a distinct limitation and step in the method of claim 1 of the ’185 patent that, once performed in the Ferman system, would make unnecessary the limitation and step of “determining a first temporal sequence” as recited in limitation 1[d]. We determine that Petitioner has not shown that Ferman teaches or suggests determining the temporal sequence.

With regard to concatenating the video clips and transitional clips, here again, none of the cited passages in Ferman make any reference to transitional clips or any comparable or related concept. Accordingly, Petitioner has not shown that Ferman teaches or suggests “*concatenating the selected first video clips and first **transitional clips***” as recited in limitation 1[d].

And, with regard to concatenating the video clips, Patent Owner argues:

There is no concatenating of Ferman’s video segments because they are part of the video clip itself (e.g., the basketball game) and are used for filtering the video clip (for example, searching for dunk events in the basketball game). *See* Ferman at ¶ [0094] (disclosing that the identification of highlights and events can be filtered and searched for), ¶ [0255] (disclosing that the program contains video segments (clips) segmented into events such as dunks), ¶ [0252] (segmenting the video program into “story units, scenes, and shots”).

Prelim. Resp. 42. This argument has merit. The video clips that are selected by Ferman’s system are already concatenated in temporal sequence as they are part of the video program that is recorded. *See* Ex. 1012 ¶ 107 (“The system, in an autonomous manner, periodically obtains and records the audiovisual information that may be of interest to the user during the past week based on the three description schemes. . . On the display, the user is

presented with a list of recorded sporting events including Basketball and Soccer.”).

The Petition fails to provide adequate support for its assertion that limitation 1[d] is taught or suggested by Ferman.

With regard to limitation 1[f], the Petition provides:

***Presenting first video programming:*** In Ferman’s system, a playing video may be presented next to multiple frame images from the program, for example when a user desires to see the highlight view or event view associated with a program. Ferman [0250]. For example, **playing video** in the “Highlight View” screen is shown next to **frames from that video**:

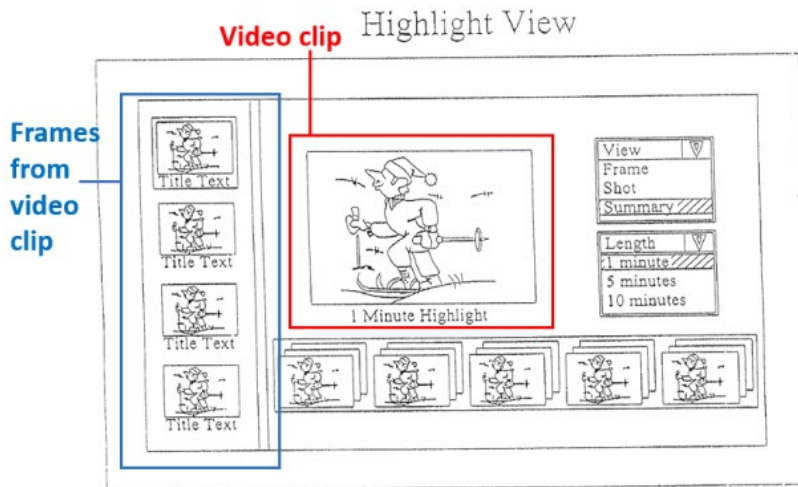


FIG. 10

*Id.* at Fig. 10 (annotated); [0124] (“The thumbnail views are **short video segments** that provide an indication of the content of the respective actual program that it corresponds with.... [A] **frame view of particular programs may be displayed**, if desired.”); *id.* (“**a set of representative frames of different programs in the left hand column**”); [0119]. The event view has similar functionality. *Id.* at Fig. 11; [0124]; Almeroth ¶361.

Moreover, to the extent PO argues there is any ambiguity in the Ferman’s disclosure, it would have been obvious to implement the UI shown in Ferman’s Fig. 10 to concurrently play the selected highlight video in the main UI element and display frames from the highlight videos to allow the user to

play other versions of that highlight video. Ferman [0124]. Ferman discloses playing highlight videos and displaying frames corresponding to the videos, as well as a UI (Fig. 10) that includes areas for both of those UI elements. Almeroth ¶362.

A POSITA would have been motivated to make the change because it would facilitate efficient browsing of highlight videos, since a user would be able to watch an initial version of the highlight video and then select frames to play other highlight videos of the same program that might focus on different aspects of the program. For example, in Ferman's example of highlight videos of a basketball game (*id.* [0107]), the user might initially watch a highlight video of the most exciting scoring events and be presented with frames from that video corresponding to different types of scoring events for play, e.g., a highlight video of dunks vs. a highlight video of 3-point shots. This would increase the interactivity and pertinence of the videos generated by Ferman's system. Almeroth ¶363.

Pet. 57–59.

With regard to limitation 1[g], the Petition provides:

***Concurrent frame display:*** As discussed immediately above, Ferman's system displays running video alongside frames from the video, in distinct areas of the display, in at least the highlight view and event view.

Pet. 60. These passages are inaccurate. Ferman does not display running video alongside frames from that video as contended by Petitioner and does not depict playing video in the “Highlight View” next to frames from that video as shown in the annotated version of Figure 10 of Ferman in the Petition.

A more accurate description and depiction of Figure 10 of Ferman is provided in Patent Owner's Preliminary Response. *See* Prelim. Resp. 31–

34. Patent Owner provides an annotated version of Figure 10, reproduced below.

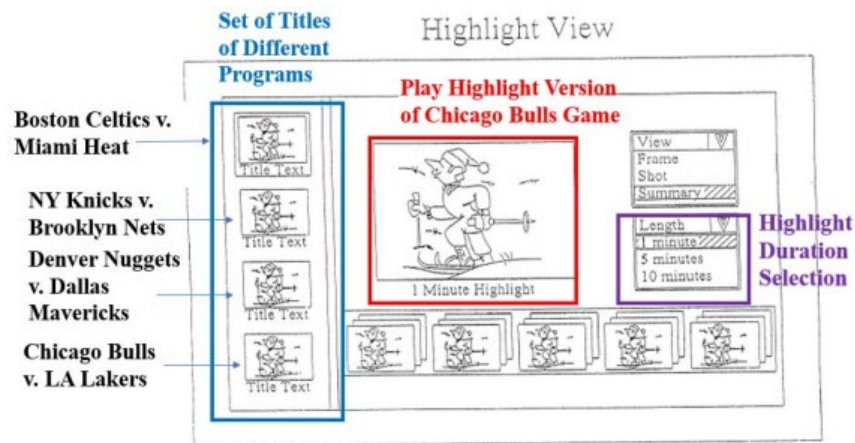


FIG. 10

Prelim. Resp. 33–34. This more accurately annotated version of Figure 10 depicts title frames of different programs (blue) from the video clip being played (red) near the center of the screen. Patent Owner’s more accurate description of the teachings of Ferman states:

Ferman discloses an audiovisual system that receives several audiovisual programs from a source, such as broadcast television. Ferman at ¶ [0119] (“In particular, the description scheme will enable audiovisual browsing and searching of programs and enable **filtering within a particular program** by supporting **multiple program views** such as the highlight view.”) (emphasis added). The system analyzes the programs and presents the viewer with several viewing options. *Id.* at ¶¶ [0092], [0102], [0105]–[0107], [0114]. For example, the system can receive several previously-recorded programs (e.g., basketball games) and present “title frames . . . that capture[] an important moment of each game.” *Id.* at ¶ [0107].

Accordingly, Ferman’s “Highlight View” interface displays a set of different programs to a user and enables the user to select and watch highlight/summary videos of each program within the set. *Id.* at ¶ [0114] (disclosing that the viewer is able to select the highlight view/summary). . . .

[T]hese title frames are not “frames from one or more displayed first video clips from the first video programming,” they depict “an important moment of each game,” and each game is a different video program. *Id.* at ¶ [0107]; ’185 Patent at Claim 1 (Element 1[g]).

A viewer who is interested in watching basketball games is provided with a “set of title frames [of different games] . . . on the display” and can “select[] the Chicago Bulls game and indicate[] a desire to view a 5 minute highlight of the game.” Ferman at ¶ [107]. At this point, the viewer is presented with the five-minute highlight video . . . *Id.* at Fig. 10 (annotated); *see also id.* at ¶ [0107]. More or less of the same game (e.g., one-minute and 10-minute highlights) may be played by selecting the appropriate “Length,” not from a viewer selecting frames displayed concurrently with the playing the initial highlights of a program.

Prelim. Resp. 31–34 (footnotes and annotated Figure 10, reproduced above, omitted).

Patent Owner’s annotations to Figure 10 and its description of the disclosure of Ferman is supported by the cited paragraphs of Ferman and is accurate. In addition, Patent Owner argues:

Petitioner does not accurately describe this aspect of Ferman, which discloses presenting a set of “title frames” that represent different programs than the one that is concurrently playing. Ferman at ¶ [0107] (“The user is interested in basketball games and indicates a desire to view games. *A set of title frames is presented on the display* that captures an important moment *of each game*. The user selects the Chicago Bulls game and indicates a desire to view a 5 minute highlight of the game.” (emphasis added)). . . .

When a viewer wishes to play more or less of the same program, the viewer selects a length option from the “Length” menu. *See* Ferman at Fig. 10 (depicting a “Length” menu listing other highlight durations), ¶¶ [0107], [0204] (“The descriptor <HighlightLength> specifies which version of the

highlight should be shown . . .”). There is, therefore, no concurrent display of the initial “playing video” and “frames from that video” in a different area to thereby “allow the user to play other versions of that highlight video,” as Petitioner suggests. Pet. at 58-59.

*Id.* at 37–38. We agree with Patent Owner and determine that Ferman does not disclose limitations 1[f] and 1[g].

Petitioner also makes an obviousness argument related to these limitations. *See* Pet. 58–60 (quoted above). In this regard, the Petition states:

Moreover, to the extent P[atent] O[wner] argues there is any ambiguity in the Ferman’s disclosure, it would have been obvious to implement the UI shown in Ferman’s Fig. 10 to concurrently play the selected highlight video in the main UI element and display frames from the highlight videos to allow the user to play other versions of that highlight video.

*Id.* at 58–59. First, Patent Owner does not argue that there is any ambiguity in Ferman’s disclosure related to these limitations. As shown above, Patent Owner argues that Petitioner’s contentions are clearly contrary to Ferman’s disclosure. *See* Prelim. Resp. 37–38.

Petitioner makes the following argument regarding motivation to modify Ferman so that it discloses these limitations:

A POSITA would have been motivated to make the change because it would facilitate efficient browsing of highlight videos, since a user would be able to watch an initial version of the highlight video and then select frames to play other highlight videos of the same program that might focus on different aspects of the program. For example, in Ferman’s example of highlight videos of a basketball game (*id.* [0107]), the user might initially watch a highlight video of the most exciting scoring events and be presented with frames from that video corresponding to different types of scoring events for

play, e.g., a highlight video of dunks vs. a highlight video of 3-point shots. This would increase the interactivity and pertinence of the videos generated by Ferman's system. Almeroth ¶363.

Pet. 59. However, the modification Petitioner proposes would limit the displayed videos to a single program ("a basketball game") and would be contrary to the user's selections and interests as stated in the cited paragraph of Ferman (Ex. 1012 ¶ 107). Paragraph 107 of Ferman states: "The user is interested in basketball games and indicates a desire to view games. A set of title frames is presented on the display that captures an important moment of **each game**" (emphasis added). We determine that a skilled artisan would not have been motivated to modify Ferman as proposed by Petitioner.

The Petition fails to provide adequate support for its assertion that limitations 1[f] and 1[g] are taught or suggested by Ferman.

With regard to limitations 1[h], 1[i], and 1[j], Patent Owner argues that Petitioner's showing is deficient because it depends on Petitioner's proposed modification of Ferman. *See* Prelim. Resp. 40–41. Patent Owner argues:

Ferman's Highlight view does not present frames of clips from a first video programming in its Highlight interface, it presents a set of title frames, each of which is associated with a different program. . . . Because it would not have been obvious to modify Ferman to present first video programming concurrently with frames from clips of the first video programming, it follows that Ferman cannot disclose a user selecting such a frame as the basis for selecting a plurality of second video clips to define a second video programming. *See* '185 Patent at Claim 1. Indeed, Petitioner acknowledges that its argument for these limitations depend on its argument that it would be obvious to modify Ferman to reach the concurrent presentation limitations regarding element 1[f].

*Id.* at 40. Patent Owner’s argument has merit. Limitation 1[h] recites, “receiving . . . a user selection corresponding to at least one of the frames of at least one **first video clip presented in the second area of the display.**” In Petitioner’s mapping of the claims to Ferman (*see* Pet. 57–60; *see also* discussion above relating to limitations 1[f] and 1[g]), the first video clip is presented in the first area of the display; not in the second area of the display. In Petitioner’s mapping, the first video clip is presented in the area near the center of the display (the area in the red box in Figure 10 as annotated by Petitioner (Pet. 58)) and the frames from the video clip are presented in the left-hand column of the display (the area in the blue box in Figure 10 as annotated by Petitioner (*id.*)). As Patent Owner argues (Prelim. Resp. 40), in Petitioner’s mapping, Ferman cannot disclose a user selecting a frame from a first video clip presented in the second area of the display, because the first video clip is not presented in the second area of the display. Accordingly, Ferman does not teach or suggest limitation 1[h].

Limitations 1[i] and 1[j] recite further method steps that are based on the user selection made in the step recited in limitation 1[h] that cannot be made in Petitioner’s mapping. Limitation 1[i] recites, “*selecting, by one or more of said computing devices, a second video clip based on at least one stored association between the second video clip and at least one first video clip indicated by **said user selection***”; and limitation 1[j] recites, “*selecting, by one or more of said computing devices, a plurality of video clips including the second video clip, and determining a second temporal sequence for concatenating the **selected plurality of second video clips**, wherein said selecting, determining, and concatenating is performed in accordance with one or more first or second templates, to define second*

*video programming*” (emphasis added). In Petitioner’s mapping, these limitations cannot be met and are not disclosed by Ferman.

Patent Owner’s arguments with regard to limitations 1[c], 1[d], 1[f], 1[g], 1[h], 1[i], and 1[j] are valid in view of the disclosure of Ferman and the inadequate analysis of limitations 1[c], 1[d], 1[f], 1[g], 1[h], 1[i], and 1[j] in the Petition. We determine that Petitioner has failed to establish a reasonable likelihood of showing Ferman teaches or suggests limitations 1[c], 1[d], 1[f], 1[g], 1[h], 1[i], and 1[j].

### III. CONCLUSION

We have weighed the evidence presented by Petitioner and considered its arguments. We determine that Petitioner fails to establish a reasonable likelihood that it would prevail with respect to at least 1 of the claims challenged in the Petition. For each challenged claim in each asserted ground of unpatentability, Petitioner fails to establish that the asserted art teaches or suggests multiple recited limitations. Accordingly, we determine that trial should not be instituted on claims 1–20 of the ’185 patent.

### IV. ORDER

Upon consideration of the record before us, it is:

ORDERED that the Petition is *denied* as to all challenged claims, and no trial is instituted.

IPR2024-01338  
Patent 8,875,185 B2

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