

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,
AMAZON.COM SERVICES LLC,
AMAZON WEB SERVICES, INC., and
TWITCH INTERACTIVE, INC.,
Petitioners,

v.

NL GIKEN INC.,
Patent Owner.

Case No. IPR2025-00050
Patent No. 10,880,592

PATENT OWNER'S PRELIMINARY RESPONSE

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I. INTRODUCTION

U.S. Patent No. 10,880,592 (“the ’592 Patent”), is directed to a receiving apparatus configured to receive the same digital moving image content independently via a first provider and second provider. In operation, for example, a user enjoying a traditionally scheduled television broadcast program of a first provider via the claimed receiving apparatus can access a complete version of the same program (provided via the second provider) to enhance remote control functionality of the scheduled broadcast. The petition grounds fail to identify a receiving apparatus that receives a program from a first provider and independently receives the same program from a second provider as claimed.

The petition grounds fail.

II. THE ’592 PATENT

FIG. 1 of the ’592 Patent, annotated and reproduced below, illustrates an exemplary embodiment of the claimed invention. The television set 2 illustrated in FIG. 1 includes a tuner 6 that receives broadcast signals from television station 5 and provides for display of a broadcast program. The user can select a desired broadcast program from a menu of scheduled programs using remote controller 18 to view the program during its scheduled broadcast. Television set 2 also includes I/O interface 16 that receives digital content from server station 9. Digital content from server

station 9 may be provided upon request (e.g., via Internet 8) and thus can be displayed and/or stored at any time.

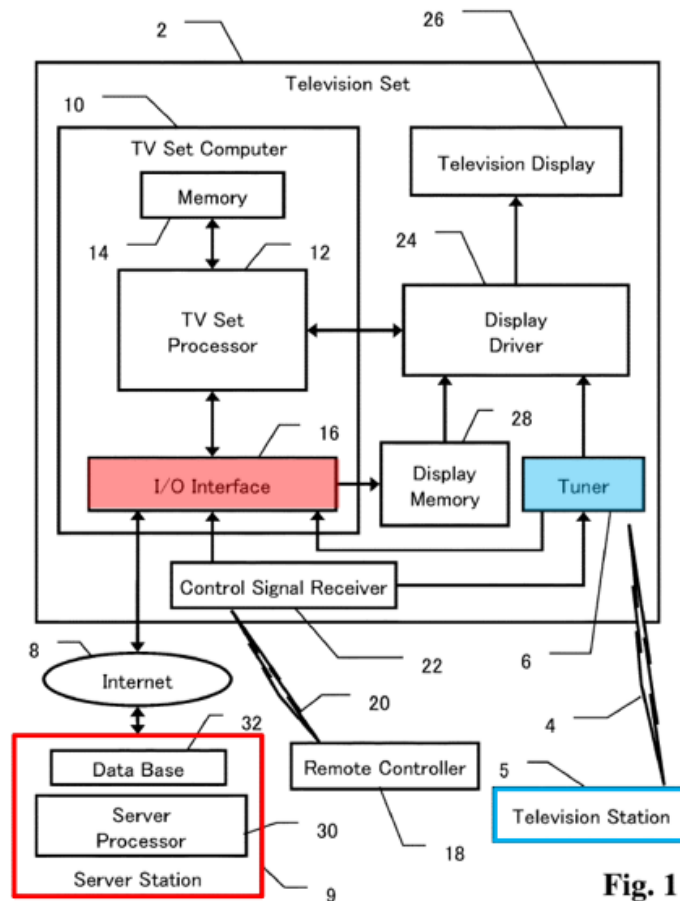


Fig. 1

The receiving apparatus enables a user to enjoy both digital broadcast content from a television station and digital content provided by a server station via the Internet. EX1001, 6:17-22. This includes ways to “combine both in advantageous manners.” EX1001, 6:22-24.

To achieve such advantages, the receiving apparatus utilizes the broadcast and Internet content in cooperation so that a user that joins a television broadcast program midstream can still “enjoy the content at any desirable position, including

the beginning, of the content.” EX1001, 11:36-42, 11:15-35. For example, when a user viewing a broadcast program from the television station indicates a desire to view the program at a different location, record the program, *etc.*, the receiving apparatus accesses the same program provided via the Internet so that the user can view the program at a desired location and/or store it in memory for viewing at any time. EX1001, 11:5-42, 12:39-51, 13:5-34.

The '592 Patent describes a receiving apparatus capable of receiving a scheduled broadcast program (*e.g.*, from a television station) and receiving the same program from a server station (*e.g.*, via the Internet) using information from the tuner receiving the scheduled broadcast program. EX1001, Abstract, 6:17-30. The receiving apparatus of claim 1 is reproduced below in relevant portion employing the same Petition labeling.

Claim 1 recites, *inter alia*:

[1.pre] A receiving apparatus configured to receive digital moving image contents from outside providers of the digital moving image contents, the outside providers including a first provider providing a digital moving image content in accordance with a program schedule table predetermined by the provider and a second provider providing the digital moving image content independently f[ro]m the program schedule table . . .

The receiving apparatus also includes an “I/O interface” that receives from the second provider the entire content of the same program received from the first provider by the tuner at the time of selection via a remote controller:

[1.c] an I/O interface that receives from the second provider the digital moving image content including entire data of the digital moving image content from the opening part to the ending part of the integral program same as the integral program received from the first provider, the I/O interface locating the integral program in accordance with information from the tuner at the time of selection by the remote controller

Thus, limitation [1.c] requires that “the digital moving image content” received by the I/O interface (1) be received from the second provider, (2) include the entirety of the same program received from the first provider (*i.e.*, by the tuner at the midstream part at the time the program is selected by the remote controller per [1.b]), and (3) be located in accordance with information from the tuner at the time the program was selected via the remote controller.

The Petition fails to demonstrate that the prior art relied on in the three grounds, Walker (EX1005) and Chang (EX1004), either alone or in combination, disclose or suggest an I/O interface that meets the requirements of limitation [1.c].

III. PERSON OF ORDINARY SKILL IN THE ART (“POSITA”)

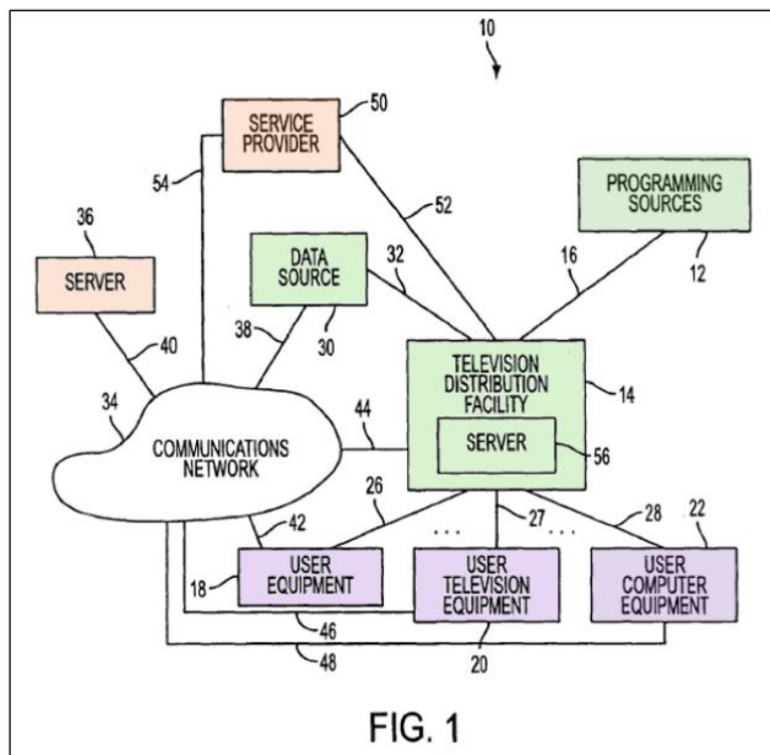
For purposes of this Preliminary Patent Owner Response only, Patent Owner does not challenge Petitioner’s POSITA definition (Petition, 3) because the Petition fails even if Petitioner’s POSITA definition is adopted.

IV. CLAIM CONSTRUCTION

Patent Owner does not challenge Petitioners' claim constructions because the Petition fails even if Petitioner's constructions are adopted. Patent Owner reserves the right to challenge these constructions as necessary should this IPR move to trial, or in different forums.

V. GROUND 1 -THE PETITION FAILS TO IDENTIFY HOW THE SAME PROGRAM IS RECEIVED FROM THE FIRST PROVIDER AND THE SECOND PROVIDER

Ground 1 relies on Walker’s interactive television system 10 illustrated in annotated FIG. 1 below (reproduced from the Petition). The Petition annotated Walker’s FIG. 1 (Petition, 10) to show how Walker’s user equipment (shaded purple) allegedly meets the limitations of the claimed “receiving apparatus.”



Petitioners allege that: (1) “*a first provider providing a digital moving image content in accordance with a program schedule table predetermined by the provider*” is met by Walker’s programming sources 12, television distribution facility 14, and data source 30 shaded in green above (Petition, 11-13), and (2) “*a second provider providing the digital moving image content independently form the program schedule table*” is met by server 36 and service provider 50 shaded orange above (Petition, 14-15).¹

As discussed *supra* §II, each of the Challenged Claims require an “I/O interface” that receives from the second provider the entirety of the same “integral program” received from the first provider “in accordance with information from the tuner at the time of selection.” Petitioners allege that this requirement is satisfied under two alternative theories: (1) when Walker’s user equipment receives both a selected broadcast program and a streaming version of the program that allows playback control of the broadcast program (Petition, 15-26); and (2) when Walker’s user equipment receives video-on-demand (VOD) content or a program previously recorded by the user (Petition, 27-28). Both theories fail.

Petitioners’ first theory fails because, unlike the representations made in the Petition, when Walker’s system provides a broadcast version and a streaming version of a scheduled program selected by the user, the user’s equipment receives

¹ Emphasis in original unless otherwise noted.

both the broadcast and streaming versions of the program from the television distribution facility 14. As the petition maps the television distribution facility 14 as the first provider, there is no explanation as to how the second provider servers identified by Petitioners meet the claimed functionality. As such, there is no “I/O interface that receives from the second provider the [entirety of the] digital moving image content [that is the] same as the integral program received from the first provider.” See *infra* §V.BC.

Likewise, Petitioners’ second theory fails because when a user selects VOD content or a recorded program for playback in Walker, nowhere does Walker disclose that the user’s equipment receives the same content that was received from the first provider, or that such is located “in accordance with information from the tuner at the time of selection” of the digital moving content of the first provider. See *infra* §V.B.1.

Thus, under either theory, the Petition fails to demonstrate that Walker discloses that the same program is received from both the first provider and the second provider, as required by claim 1.

A. Overview of Walker

Walker discloses an interactive television system 10 (see Walker’s FIG. 1 reproduced below) for providing various services to users, including distributing

broadcast programming, providing video-on-demand (VOD) content, and providing network-based recording of scheduled programming.

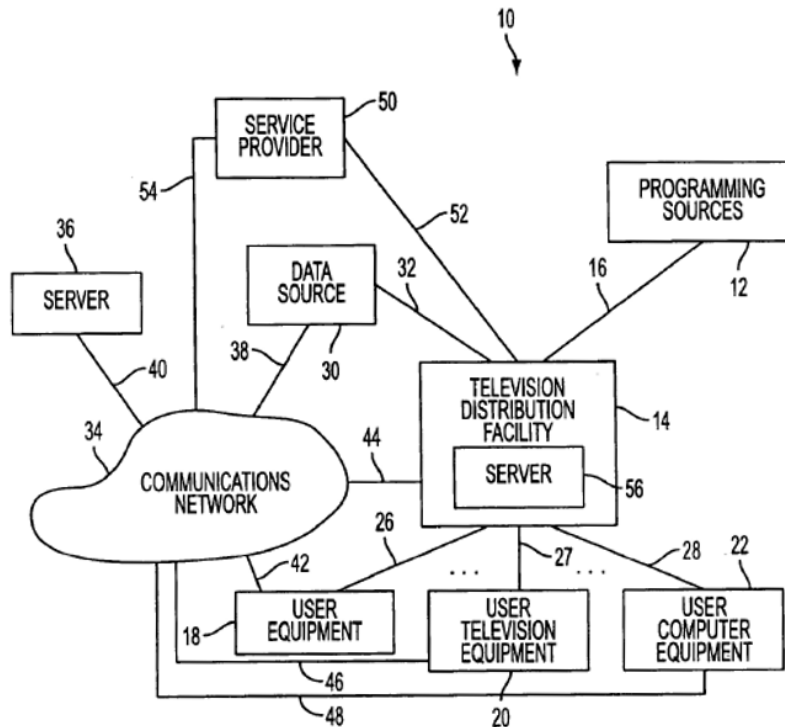


FIG. 1

Interactive television system 10 includes a television distribution facility 14 for “distributing television or music programming to users.” Walker, ¶46. Television distribution facility 14 receives television programming and other media from programming sources 12 and distributes the programming to user equipment devices 18, 20 and 22. Walker, ¶¶48-49. Data source 30 stores programming information such as “scheduled broadcast time, titles, channels, ratings information,” *etc.* (Walker, ¶50) and is configured to “provide program schedule information and other

data to television distribution facility over communications path 32 for distribution to the associated user equipment” (Walker, ¶51).

Interactive television system 10 also includes servers 36 and 56 connected to communications network 34 for supporting various interactive television services. Walker, ¶¶53-58. For example, “network-based video recording functions” may be provided by “storing copies of television programs and other video content on a remote server (e.g., server 56 or 36)” (Walker, ¶87) or servers 56 or 36 may store video-on-demand content available to users for download. Walker, ¶¶87-88, 120-126, 140-143.

1. Walker’s Broadcast Program Playback Control Feature

Walker describes a technique for addressing drawbacks of viewing broadcast programming. Walker, ¶¶5-15. As shown in the channel listing in FIG. 8 of Walker, reproduced below, different programs are scheduled for broadcast on different channels at prescribed times. Walker, ¶¶97-98. The user can choose to view a program currently being broadcast by selecting the current time slot on the corresponding channel. Walker, ¶¶100, 109.

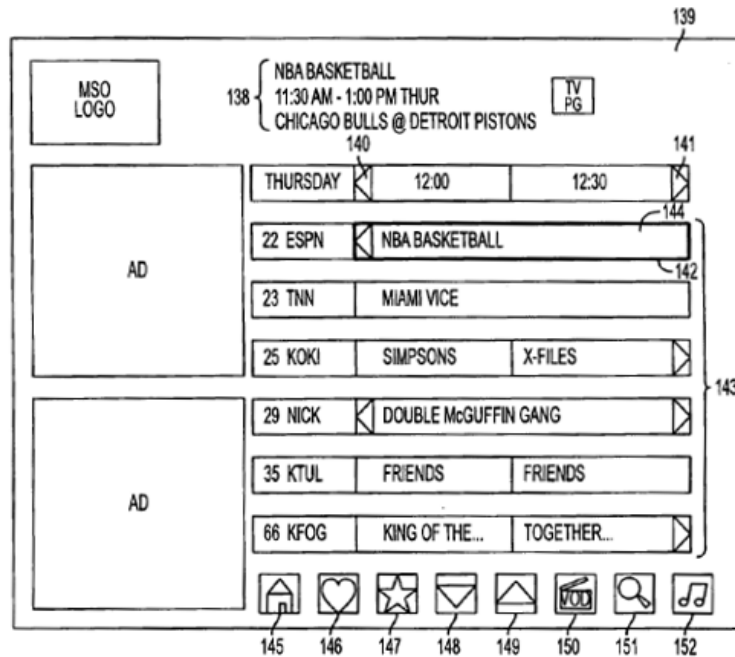


FIG. 8

Since the channel programming is broadcast only at the scheduled times, conventional broadcast programs are “non-interactive” (Walker, ¶5)—*i.e.*, the user cannot control the playback of the program during the broadcast unless the user has recording equipment that caches the program as the program is being broadcast. Walker, ¶¶5-6. Any program content broadcast before the user tunes into the channel cannot be viewed. *Id.*

Walker describes a technique that allows a user to request playback control functions while viewing a broadcast program. Walker, ¶10. To achieve this functionality, “a streaming version of the broadcast program is provided to a television distribution facility in advance of the broadcast.” Walker, ¶10. When a user requests a playback control function (*e.g.*, pause, rewind, fast-forward, *etc.*)

while viewing the broadcast program, the television distribution facility provides the streaming version of the program to the user for display in place of the broadcast version so the user can perform playback control functions on the program. Walker, ¶¶10-15 (see also ¶¶164-165, 183-186, FIG. 27).

B. Petitioners' Allegation that Walker's VOD and Video Recording Features Meet Limitation [1.c] Fails

Petitioners allege that Walker's video-on-demand (VOD) and video recordings satisfy limitation [1.c]. Petition, 27. This mapping fails because Walker does not disclose receiving a broadcast program from a television distribution facility and receiving VOD content or a video recording of that same program to enhance interactivity with the broadcast. That is, the VOD arrangement does not locate the same content "in accordance with information from the tuner at the time of selection" of the digital moving content of the first provider.

1. The Petition Fails to Demonstrate that Received VOD or Video Recording is the Same as Selected Broadcast Program Received from the Television Distribution Facility

Petitioners allege that VOD and video recordings "received from server 36 or service provider 50 includes the *entire data of the digital moving image content from the opening part to the ending part of the integral program same as the integral program received from the first provider.*" Petition, 27 (string citing EX1005, Figs. 14-15, ¶¶50-59, 120, 130 and 140).

Petitioners make no attempt to explain how Walker discloses that any received VOD content or video recordings are the “*same as the integral program received from the first provider.*” Instead, the Petition explains where VOD content and video recordings can be stored and that a user can download and view them: “Walker also discloses that VOD content and video recorded using a network-based video recorder are stored at service provider 50” and that a “user selects the VOD or recorded video for playback, utilize playback controls, and even download a full network recorded program to the set top box for later viewing.” Petition, 27.

The Petition’s allegation fails on its face. To meet each of the requirements of limitation [1.c], the Petition needed to demonstrate that VOD and video recordings allegedly “received from server 36 or service provider 50” are the same as the selected broadcast program received from the television distribution facility 14 that the Petition asserts is “*the integral program received from the first provider.*” See Petition, 16-17 (limitation [1.a]), 18-19 (limitation [1.b]); *infra* §V.C.

The Petition alleges no connection whatsoever between selected VOD content or video recordings and the selected broadcast program. The Petition’s mapping thus fails.

a. Walker Discloses Independent Selection and Delivery of VOD Content, Video Recordings and Broadcast Programs

In Walker's interactive television system 10 (see *supra* §V.A), services are provided by an interactive television application implemented locally on user equipment device or distributed in a client-server architecture. Walker, ¶61. The interactive television application provides access to services via a menu of options (see annotated FIG. 7 of Walker reproduced below) displayed on the user's television that the user can navigate via the remote controller 74 (see FIG. 4).

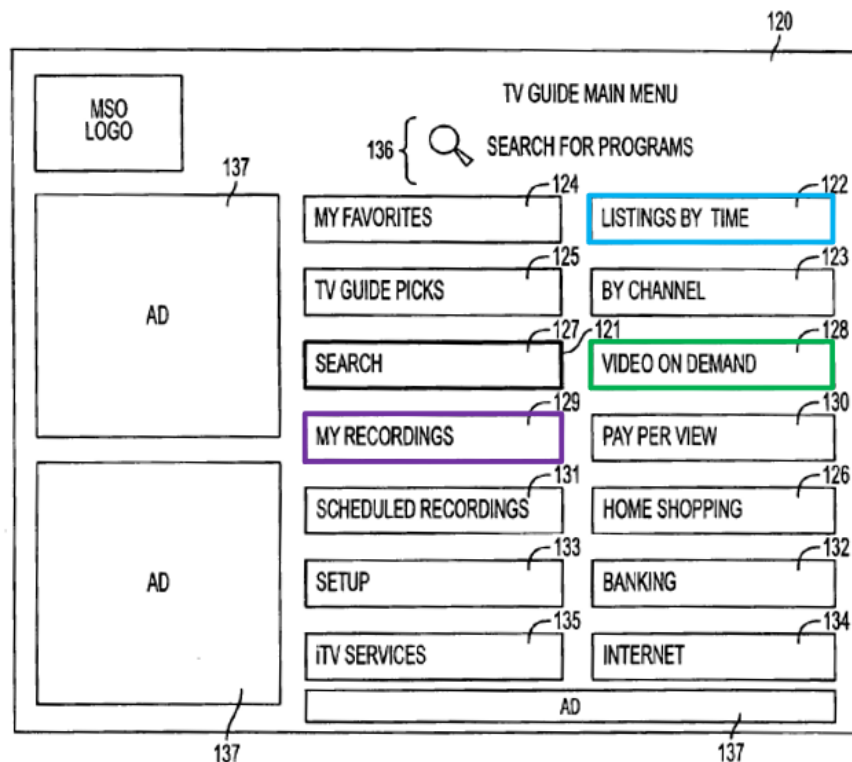


FIG. 7

By selecting menu option 122 ("LISTINGS BY TIME," boxed in blue below) from main menu 120, the interactive television application displays a listing of

scheduled programs on each channel and the times at which those programs are scheduled to be broadcast, as shown in Walker's FIG. 8 (annotated and reproduced below). Walker, ¶¶97-98. The user can then choose to view a program currently being broadcast by selecting the current time slot on the corresponding channel. Walker, ¶¶100, 109. The selected program broadcast from television distribution facility 14 to the user is what the Petition asserts meets "*the integral program received from the first provider.*" Petition, 16-19.

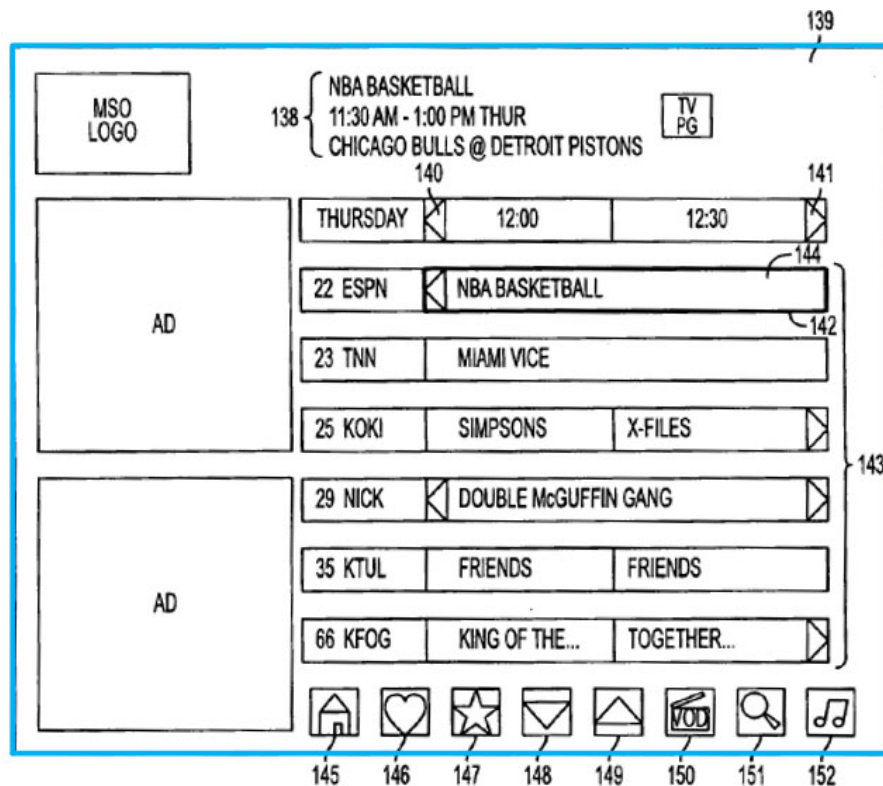


FIG. 8

But if a user wants to view available VOD content, the user selects option 128 ("VIDEO ON DEMAND," boxed in green in FIG. 7 annotated and reproduced above) to display video-on-demand menu 202 (see FIG. 14 annotated and

reproduced below) to navigate the system's on-demand inventory. Walker, ¶¶119-123. The user can select desired VOD content for ordering, and the interactive television application delivers the ordered VOD content to the user equipment. Walker, ¶125.

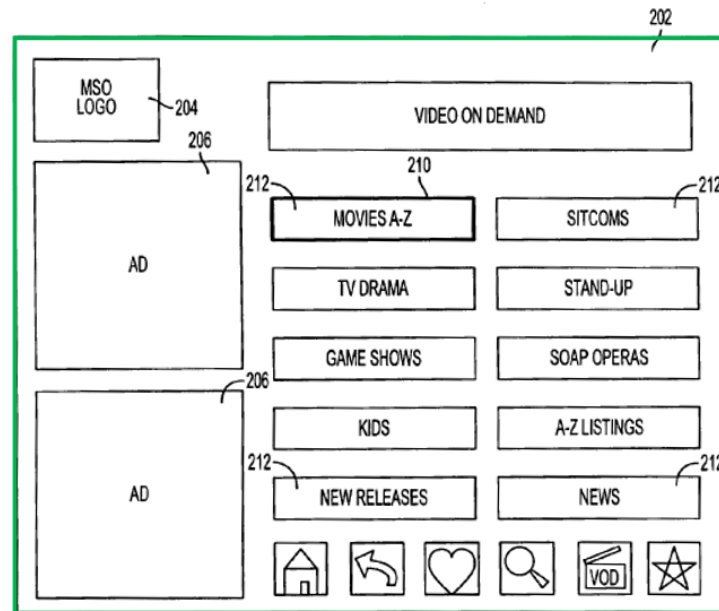


FIG. 14

If a user wants to view programs that the user previously recorded, the user can selected option 129 (“MY RECORDINGS,” boxed in purple in FIG. 7 annotated and reproduced above) to display the user’s list of recorded programs. Walker, ¶¶140-142. From the user’s list of recorded programs, the user can select a desired program for playback (see FIG. 20a annotated and reproduced below). Walker, ¶143.

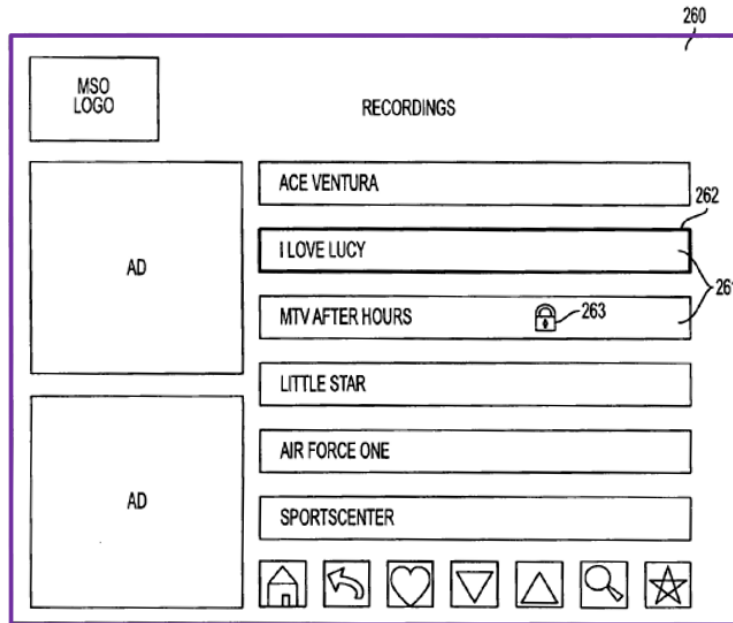


FIG. 20a

Thus, Walker describes selecting and receiving VOD content or recorded video and selecting and viewing scheduled programs currently being broadcast as separate processes. Nowhere does Walker disclose selecting and receiving a broadcast program and receiving VOD content or a video recording of the same program received from the television distribution facility 14 via broadcast.

2. Walker Does Not Disclose Locating VOD Content or Video Recordings Using Information From the Tuner

Petitioners allege that Walker discloses that an I/O interface “*locating the integral program in accordance with information from the tuner at the time of selection by the remote controller.*” Petition, 27. The Petition argues that “[a]s

discussed above², a POSITA would have known that the tuner would receive information at the time of selection including the title of the program and other identifying information, that would allow the I/O interface to locate the VOD or video recording utilizing the title or other information.” Petition, 27-28.

That is not remotely how Walker discloses locating VOD content or video recordings, even if Walker’s “tuner” does receive title and other identifying information (see footnote below). Walker’s *interactive application* locates VOD content or a video recording when the user *navigates* to the desired content and selects it. Walker, ¶¶119-126 (VOD), 140-144 (recorded video). This bears no relation to locating an integral program with information from the tuner at the time of selection of content of a first provider (claim element 1a), nor does the Petition explain how any such tuner information “extracted” from broadcast signals is used to locate VOD content or video recording (Petition, 24-25). At the risk of belaboring point, the interactive application provides title and identifying information on available VOD content and video recording and displays that information such that

² What the Petition “discussed above” was the tuner provides “channel information” because “the tuning circuitry defines what channel is being viewed and extracts the signal corresponding to that channel from the incoming television signal.” Petition, 24-25.

the user can select it (*see e.g.*, FIGS. 17a, 17b, 20a, 20b). Walker, ¶¶119-126, 140-144.

Thus, the Petition also fails to demonstrate that Walker discloses locating, by the I/O interface or otherwise, VOD content or recorded video “*in accordance with information from the tuner at the time of selection by the remote controller.*”

C. The Petition Fails to Demonstrate that Walker Discloses an I/O Interface that Receives From a Second Provider the Same Program Received From a First Provider

As discussed above, the Petition alleges that television distribution facility 14 (and the other components colored green in annotated FIG. 1 below reproduced from the Petition) collectively meet the “*first provider*” and server 36 and service provider 50 (colored orange in FIG. 1 below) collectively meet the “*second provider.*” Petition, 11-15.

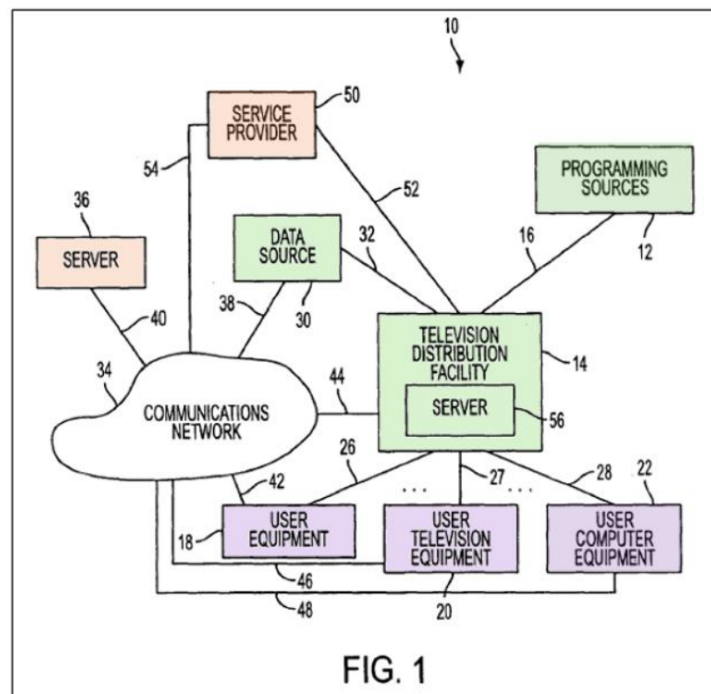


FIG. 1

As discussed *supra* §II, each of the Challenged Claims require an I/O interface that receives from the second provider the entirety of the same integral program received from the first provider—i.e., “*entire data of the digital moving image content from the opening part to the ending part of the integral program same as the integral program received from the first provider*” (limitation [1.c]).

According to the Petition’s mapping “*the integral program received from the first provider*” is met by the broadcast program received from television distribution facility 14 when the user selects a channel for viewing. Petition, 16-17 (asserting that “*an integral program*” is selected from Walker’s program guide using remote controller 72 to meet limitation [1.a]), 18-19 (asserting that “*the integral program*” is received from television distribution facility 14 at the time of selection by the remote controller to meet limitation [1.b]).

As to limitation [1.c], the Petition never explains where Walker allegedly discloses an I/O interface that receives from server 36 or service provider 50 (Petition identified *second provider*) the same program received from television distribution facility 14. Instead, the Petition presents a series of disconnected cites that allegedly disclose the separate elements of limitation [1.c] with no explanation as to how the cited paragraphs of Walker disclose what the Petition alleges and without ever identifying disclosure in Walker that meets each of the requirements of limitation [1.c] or explaining how Walker allegedly does so.

First, the Petition alleges that “Walker discloses *an I/O interface* (user television equipment 18, 20, and 22 via each of input/output 58, 104, and 108 connected to communication paths 26, 27, 28, 46, 48) *that receives from the second provider* (remote server 36, service provider 50) *the digital moving image content.*”

Petition, 19-20. The Petition’s entire support for this assertion follows:

EX1005, ¶91 (user equipment includes “input/output 108” connected to communication paths 42 and 46, and “input/output 108” **receive programming from “server 36”**), ¶¶83-84, §IV(B)(1) (claim 1, preamble) (the *digital moving image content* is streamed from remote server 36 or service provider 50).

Petition, 20. (emphasis in bold added)

In relying on server 36 as the second provider, the Petition does not point to any particular “programming” received at the I/O interface from server 36, nor any particular digital content allegedly streamed from server 36 (or service provider 50), let alone establish that the I/O interface receives from server 36 or service provider 50 the same “*integral program received from the first provider*, as required by limitation [1.c]—i.e., the same program being broadcast from television distribution facility 14 and received by the tuner. Petition, 16-19 (mapping Walker to limitations [1.a] and [1.b]).

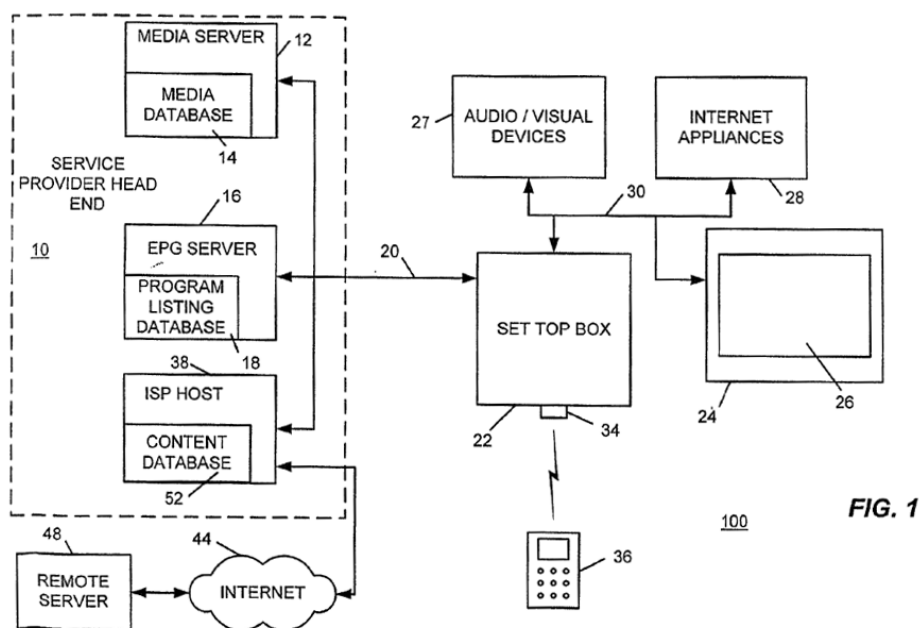
The Petition *never* provides an explanation of how Walker allegedly discloses that the streamed version of the broadcast program is received by user equipment

devices from server 36 (or service provider 50), let alone the required “detailed explanation.” (37 C.F.R. § 42.22(a)(2)).

VI. GROUND 2 (OBVIOUSNESS BASED ON CHANG) FAILS

A. Overview of Chang

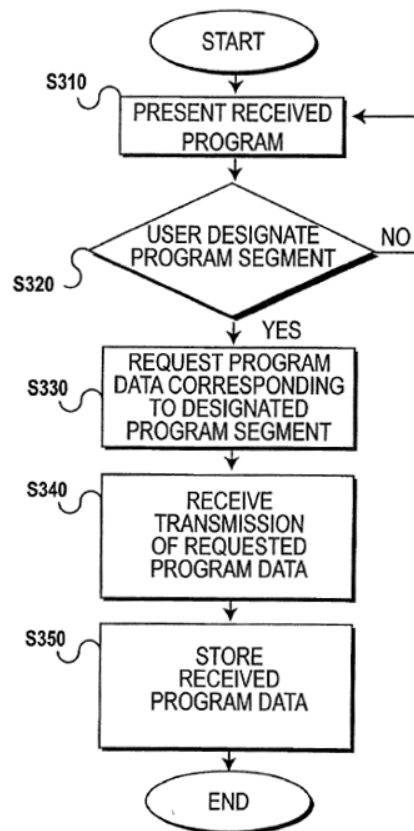
Chang is directed to an interactive television system 100 (see Chang’s FIG. 1 reproduced below) that allows a user who is watching a program broadcast by service provider (head end (“HE”) 10) to download a clip of the broadcast program to the user’s set top box (“STB”) 22. Chang, ¶¶37-41.



Chang’s FIG. 3 (reproduced below) shows the process by which a user can designate a “program segment” or “clip” from the broadcast program the user is viewing to be downloaded. Chang, ¶¶37-42. In step 310, “STB 22 is tuned to a programming channel broadcast from HE 10, say a video music channel, on transmission medium 20 for receiving a program data signal and presenting the

program on TV 24.” Chang, ¶37. Chang discloses that “the presented program may include a number of segments with corresponding identifiable clips (e.g., music video clips)” stored at media server 12 (e.g., each segment of a program may be identified with a PID). *Id.*

FIG. 3

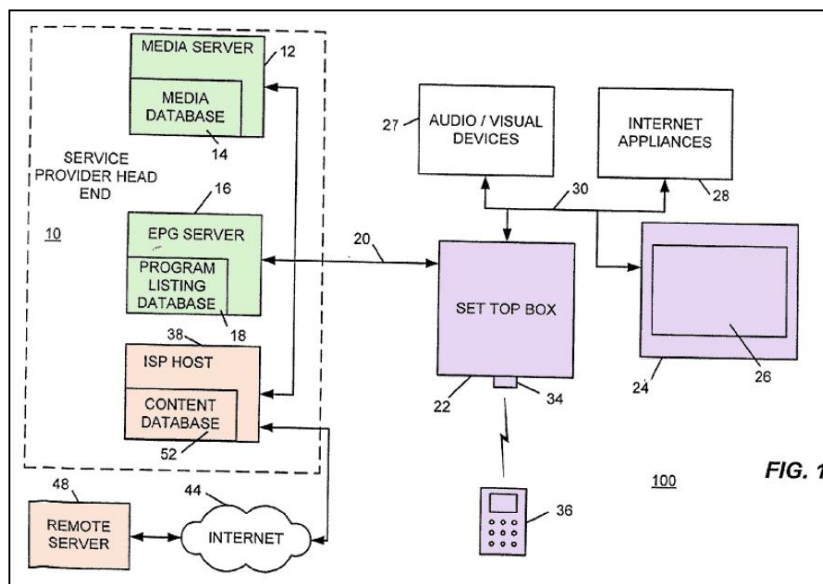


As the user views the broadcast program, the user can select or “designate” a segment (or a portion thereof) of the broadcast program currently being presented to the user to request download of the corresponding video clip (steps 310-330). Chang, ¶¶38-40. Specifically, in response to the user selecting the portion of the program

currently being presented, a request is sent to HE 10 to retrieve the video clip corresponding to the segment of the program the user designated. Chang, ¶¶38-41.

B. The Petition Fails to Establish that Chang Meets the Requirements of Limitation [1.c]

The Petition alleges that claim 1’s “*receiving apparatus*” is met collectively by set top box (“STB”) 22, television 24, and remote controller 36 that the Petition colored purple in Chang’s FIG. 1 (reproduced below from the Petition). Petition, 45-46.



The Petition further alleges that (1) Chang’s EPG server 16, program listing database 18, media server 12, and media database 14 (colored in green above) collectively meet the claimed “*first service provider*” that broadcasts channel programming to the STB 22, and (2) Chang’s ISP host 32 content database 52 and remote server 48 (colored in orange above) collectively meet the claimed “*second*

service provider” from which segments of a broadcast program requested by the user when viewing the program are allegedly received. Petition, 46-55.

The Petition’s arguments fail for at least two reasons. First, Chang does not disclose that designated program segments are received from any component asserted to be the “*second provider*.” Second, Chang’s program segments are not the “*entire data*” of “*the integral program received from the first provider*.” Thus, the Petition fails to establish that Chang meets limitation [1.c] for at least these two independent reasons.

1. Chang Does Not Disclose Its Selected Program Segments Being Received from ISP Host 38 as Alleged

The Petition alleges Chang’s ISP host 38 is the “*second provider*” and that Chang’s I/O interface 146 receives the program segments designated by the user from ISP host 38. Petition, 52-53. Chang discloses no such thing.

Chang specifies that its program segments are stored on media server 12. Chang, ¶37. Chang discloses that requests for selected program segments are sent from STB 22 to HE 10 and that requested program segments are then transmitted from HE 10 to STB 22 in response. Chang, ¶40. Nowhere does Chang disclose that ISP host 38 is involved in obtaining a program segment of the broadcast program the user designated.

As clear from Chang itself, when HE 10 transmits requested program segments to STB 22, the program segments are provided from their storage location

in media server 12 (which the Petition alleges is the “*first provider*”) where they are stored as “identifiable clips” (Chang, ¶37) and from where Petitioners acknowledge the program segments are also provided via a selected program broadcast. Petition, 46-47. Chang does *not* disclose that requested program segments are received from ISP host 38 (which the Petition alleges is the “second provider”), nor that ISP host 38 is involved in the process.

2. A POSITA Would Have Had No Reason to Store Chang’s Program Segments of the Broadcast Program on the ISP Host’s Database

The Petition alternatively alleges that it would have been obvious to “have ISP host 38 provide the designated program segment from its ‘content database 52’” and that a “POSITA could have done so by, for example, storing the program segments in content database 52 just as Chang discloses ‘content database 52’ stores ‘video clips.’” Petition, 48-49 (citing Chang, ¶50). The Petition alleges that motivation “arises from that disclosure, and from a desire to implement Chang’s disclosure of providing designated program segments to the user ‘via Internet 44’ (and ISP host 38) in a logical manner.” Petition, 49 (citing ¶¶20, 50, 33 and 52). However, that disclosure, relates to a process that only occurs post-identification and the previous downloading of the clip from the Media Server 12. As such, no such desire is expressed by Chang.

To reiterate, Chang does not disclose providing “designated program segments” (i.e., program segments selected by the user for download while viewing a broadcast program) to the user “‘via Internet 44’ (and ISP host 38)” as Petitioners allege. Chang discusses using the ISP for retrieving “additional information.” Chang, ¶¶ 47-51. Specifically, Chang discloses that STB 22 may search for additional information in order to identify program data corresponding to the designation such as “concert dates, news regarding the artist and other similar artists, new releases by the artist and similar artists, other video clips from the same or other artists” and “that STB 22 may search content database 52, Internet 44, remote server 48, and/or media server 12 for such additional information.” Chang, ¶50.

Once the STB has identified program data corresponding to the designation, the STB requests download of the program data—*i.e.*, STB 22 transmits a request for the program data to HE 10 and HE 10 transmits the requested program data to STB 22 in response. Chang, ¶51. The Petition offers no motivation for storing the requested program data at ISP host 38, let alone the “designated program segments” requested, in contradiction to Chang’s explicit teaching. Chang also discloses that downloaded program data of a user can be stored off site at a remote storage device accessible via the Internet. Chang, ¶51-52. Indeed, Petitioner’s further citation to ¶52 plainly relates to user storage of downloaded program data, not first provider storage options.

Finally, the petition at page 49 argues that “[m]ore motivation arises from a desire to cache content closer to the ISP host than the remote server 48.” To the extent this position is even understood, it is based on the false the premise that there is a motivation to move program clips from the dedicated Media Server to an Internet accessible server in the first instance (demonstrated as baseless above). But even that failed premise aside, Petitioners own expert demonstrates the illogic of such a modification to Chang. The Petitioners’ expert testifies that (EX1002 ¶146) there is a desire to cache content “closer to the ISP for performance reasons.” This testimony demonstrates the only “obvious” implementation is to do exactly as Chang does, utilize Media Server 12 and its dedicated access given its superior performance benefits.

3. The Petition Fails to Explain How Chang’s Program “Segments” Are “Entire Data” in the Context of Chang

To meet limitation [1.c]’s requirement that “*entire data*” of “*the integral program received from the first provider*,” Petitioners allege that a program segment can include an entire program. Petitioners cite to Chang’s statement that “a music video program segment may include one or more music videos where each music video may form a portion of the program segment” Petition, 50 (quoting Chang,

¶38).³ From this, Petitioners allege that a “POSITA therefore would have understood that a Chang ‘program segment’ is disclosed as optionally including an entire program. Petition, 50 (discussing the “*integral program*” selected by the remote controller of [1.a])). But whether a segment might be considered to be a one-unit program in the abstract, bears no relation to Chang’s teachings. Chang nowhere teaches that its program segment is synonymous with an entire program, indeed it consistently uses “segment” and “program” to convey different meanings.

Chang’s disclosure immediately preceding and following the Petition’s quote from Chang’s ¶38 (which is part of the description of the process illustrated in FIG. 3 in which a user is viewing a program on the user’s television as it is being broadcast from HE 10—see Chang, ¶37) makes clear that a program includes multiple program segments that the user can designate when a desired segment of the program is currently being displayed on the television. Chang’s ¶38 reads:

[0038] *As the program is being presented*, control passes to step S 320, where it is determined whether a user designates a program segment or a portion of a program segment being presented. For example, a music video program segment may include one or more music videos where each music video may form a portion of the program segment (i.e., a user may designate any one of the individual videos in a segment). A

³ Chang’s ¶44 discloses that “a ‘music video’ can be a ‘portion’ of a program segment.”

user's designation may be received from input device 36...at any time during the presentation of the program segment (or a portion thereof).

That is, as the broadcast program is being displayed to the user on the television from beginning to end, the user can select a segment currently being presented—*i.e.*, because as STB 22 “continue[s] presenting the program,” the user can only designate segments currently being displayed. Chang, ¶39. As such, there is no way to designate “entire data” of Chang’s program. Chang’s principle of operation is to allow the user to select segments of interest to obtain video clips of a larger program. Chang, ¶¶39-43.

Petitioners’ contention that a program segment can include the entire program from which the segment can be selected derives from the allegation that a music video is a program “because it is a complete unit of programming.” (Petition, 50). Because a program segment can include one or more music videos and a music video is allegedly a program, Petitioners conclude “a Chang ‘program segment’ is disclosed as optionally including an entire program.” Petition, 50. But if a music video is a program and a program segment can include one or more music videos, a program segment can also include *multiple* entire programs. Chang does not use “segment” and “program” interchangeably. As such, Petitioners untethered semantical musings find no basis in the record. Chang, ¶37, 38-41.

VII. GROUND 3 (OBVIOUS BASED ON WALKER AND CHANG)

Ground 3 proposes modifying Walker to include Chang’s segment identifiers in Walker’s broadcast programs. Even if Walker had some need to identify segments in the broadcast programs and that could somehow assist in locating streaming versions of the broadcast program, the combination of Walker and Chang does not cure any of the deficiencies identified for Ground 1 or 2.

VIII. STATUTORY DISCLAIMER UNDER 37 C.F.R. § 1.321(A)

On February 27, 2025, Patent Owner filed a statutory disclaimer, disclaiming claims 6-13 of the ’592 Patent under 35 U.S.C. § 253(a) and in compliance with 37 C.F.R. § 1.321(a), using the form approved for such submissions by the Office and accompanied by the appropriate fee. EX2001. Because “no *inter partes* review will be instituted based on disclaimed claims” (37 C.F.R. § 42.107(e)), Patent Owner respectfully submits that institution of a trial here would be improper with respect to disclaimed claims 6-13. *See Unified Patents Inc. v. Sound View Innovations, LLC.*, IPR2019-01113, Paper No. 8, 7-8 (PTAB November 22, 2019) (denying institution and holding that “[b]ecause [some of the challenged] claims . . . have been disclaimed under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a), we cannot institute a trial on these claims”); *SFC Co., Ltd. v. LG Chem, Ltd.*, IPR2020-00178, Paper No. 16, 7-8 (PTAB May 29, 2020) (similar); *Delta Electronics, Inc. v. Vicor Corporation*, IPR2024-00134, Paper No. 8, 11-12 (PTAB May 17, 2024)

(similar); *see also Tandus Flooring, Inc. v. Interface, Inc.*, IPR2013-00526, Paper No. 7 (PTAB, February 14, 2014) (denying institution of trial because patent owner had disclaimed all of the challenged claims); *Inguran, LLC d/b/a Sexing Technologies v. Premium Genetics (UK) Ltd.*, IPR2016-00756, Paper No. 9 (PTAB, August 31, 2016)(same).

IX. CONCLUSION

Petitioners fail to meet their burden to demonstrate a likelihood of showing that any Challenged Claim is unpatentable. The Board should deny institution.

Respectfully submitted,
NL Giken Inc.

Date: February 28, 2025

/Scott A. McKeown /

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24, the undersigned certifies that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** contains 5,479 words excluding; a table of contents, a table of authorities, a certificate of service or word count, or appendix of exhibits or claim listing. Patent Owner has relied on the word count feature of the word processing system used to create this paper in making this certification.

Date: February 28, 2025

/MacAulay Rush/
MacAulay Rush
Paralegal
WOLF, GREENFIELD & SACKS, P.C.

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

I certify that on February 28, 2025, I will cause a copy of the foregoing document, including any exhibits filed therewith, to be served via electronic mail, as previously consented to by Petitioner, upon the following:

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