

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

NL GIKEN INC.,

Plaintiff,

v.

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

Defendants.

Case No. 1:24-cv-00028-MN

DEFENDANTS' SUPPLEMENTAL INVALIDITY CONTENTIONS

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I. INTRODUCTION

Pursuant to Sections 6(d) of the Court’s Scheduling Order dated June 18, 2024 (Dkt. 32), Defendants Amazon.com, Inc., Amazon.com Services LLC, and Amazon Web Services, Inc., (collectively, “Amazon”) and Defendant Twitch Interactive, Inc. (“Twitch”) (collectively, “Defendants”) respectfully submit these supplemental invalidity contentions with respect to the claims identified by Plaintiff NL Giken Inc. (“Giken”) in its infringement contentions.

In its infringement contentions served March 31, 2025, Giken asserted claims 1-3, and 5 of U.S. Patent No. 10,880,592 (the “’592 Patent”); claims 1-2, 4, 6, and 15 of U.S. Patent No. 8,094,236 (the “’236 Patent”); claims 1, 9-10, and 12-15 of U.S. Patent No. 8,677,391 (the “’391 Patent”); and claims 1-12 of U.S. Patent No. 9,948,968 (the “’968 Patent”) (collectively, the “Asserted Claims” and “the Asserted Patents”).¹ Defendants contend that each of the Asserted Claims is invalid under at least 35 U.S.C. §§ 101, 102, 103, and/or 112. Defendants reserve the right to supplement these invalidity contentions pursuant to the Federal Rules of Civil Procedure, the Court’s Local Rules, and/or any other order or schedule entered by the Court.

II. PRELIMINARY STATEMENT AND RESERVATION OF RIGHTS

A. No Waiver.

Nothing in these invalidity contentions is intended, nor should be construed, as a waiver of any claim construction argument, noninfringement position, or argument under 35 U.S.C. § 112. Defendants’ statements herein (including the accompanying claim charts) reflect Defendants’ present understanding of the purported scope of the claims as alleged by Giken in its infringement contentions (as best those contentions can be understood in light of their present deficiencies). *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1378 (Fed. Cir.

¹ On April 9, 2025, Giken confirmed that it was no longer asserting the ’615 patent.

2001) (“it is axiomatic that that which would literally infringe if later anticipates if earlier”). For the avoidance of doubt, these contentions are not intended to present or argue in favor of any construction of the Asserted Claims, and Defendants expressly reserve the right to present constructions that differ from any construction that may be alleged to underlie these contentions. The Court established separate deadlines for the parties’ proposed claim constructions, and Defendants will disclose their proposed constructions accordingly. These invalidity contentions do not constitute an acquiescence to Giken’s interpretation of any claims to the extent they depart from the plain meaning of the Asserted Claims and from the proper scope of the claims as may be subsequently construed by the Court. Defendants disagree with Giken’s apparent positions as to the purported scope of the Asserted Claims to the extent they seek to expand the scope of the Asserted Claims beyond their proper construction and to the extent those apparent positions can be understood from Giken’s deficient infringement contentions.

The Asserted Claims have not yet been construed by the Court in this case and, thus, Defendants have not yet had the opportunity to compare the Asserted Claims of the Asserted Patents (as construed by the Court) with the prior art. Defendants reserve the right to amend, supplement, or materially modify its invalidity contentions after the claims have been construed by the Court in this case. Defendants also reserve the right to amend, supplement, or materially modify their invalidity contentions in response to any claim construction positions that Giken may take. Defendants also reserve the right to assert that a claim is indefinite, not enabled, or fails to meet the written description requirement of 35 U.S.C. § 112 based on any claim construction position Giken may take in this case or based on any claim construction the Court may adopt in this case.

B. No Admission.

Nothing disclosed herein is an admission or acknowledgement that any product accused

of infringement by Giken in its infringement contentions (the “Accused Products”), or any of Defendants’ other products or services, infringes any of the Asserted Claims.

Defendants further note that Giken appears to rely upon overly broad constructions of the Asserted Claims. At the same time, Giken’s infringement contentions are in most places too general and vague to discern Giken’s infringement theories and how exactly Giken contends each Accused Product meets or practices each element of the Asserted Claims. As a result, Defendants have been prejudiced in their ability to prepare these invalidity contentions. In addition, Giken’s infringement contentions, in many cases, fail to put Defendants on notice of Giken’s interpretation of the Asserted Claims, further prejudicing Defendants’ ability to identify relevant prior art. In addition, Giken has not properly identified any theories of infringement under the doctrine of equivalents. Defendants have relied on Giken’s apparent representation that it has no doctrine of equivalents theories in preparing these invalidity contentions, and any attempt by Giken to present an untimely doctrine of equivalents argument would be severely prejudicial to Defendants. To the extent that Giken is later permitted by the Court to amend its contentions to cure the deficiencies of its current contentions or to pursue any currently undisclosed doctrine of equivalents theories, Defendants’ expressly reserve the right to supplement or amend these invalidity contentions to account for such amendments.

To the extent that any of the prior art references disclose the same functionality or feature of any of the Accused Products, Defendants reserve the right to argue that said feature or functionality does not practice any element of any of the Asserted Claims, and to argue, in the alternative, that if said feature or functionality is found to practice any element of any of the Asserted Claims, then the prior art reference demonstrates that the element is not novel, is obvious, and/or is otherwise not patentable.

Attached are representative claim charts that identify where the elements of the Asserted Claims of the Asserted Patents may be found in the prior art and further identify why those elements are not novel or non-obvious. The references cited in the attached claim charts may disclose the limitations of the Asserted Claims expressly and/or inherently. The suggested obviousness combinations may be presented in conjunction with or in the alternative to Defendants' contentions regarding anticipation. These obviousness combinations should not be construed to suggest that any reference included in any combination is not anticipatory in its own right. Further, to the extent that Giken contends that any of the references identified do not constitute available prior art under 35 U.S.C. § 102, Defendants reserve the right to rely upon other prior art references in the same patent family with substantially identical disclosures as evidence of invalidity based on the same theories as those disclosed below.

C. Reservation of Rights.

Prior art not currently included in this disclosure may become relevant. Defendants are currently unaware of the extent, if any, to which Giken will contend that limitations of the Asserted Claims are not disclosed in the prior art identified by Defendants. Defendants reserve the right to identify other references that would have made the addition of the allegedly missing limitation to the disclosed device or method obvious or show that the allegedly missing limitation would have been known or readily apparent to one of ordinary skill in the art at the time of the invention in light of the disclosure of the prior art at issue. Defendants further reserve the right to rely on any of the references being produced herewith in order to demonstrate the state of art at the alleged times of invention and as evidence of the knowledge of one of ordinary skill in the art in support of any motivations to modify or combine the charted prior art references with other references or knowledge.

Giken has not yet produced other prior art of which it may be aware but is not yet known

to Defendants. Defendants may seek to supplement their invalidity contentions with prior art contained in such production once they have had a fair opportunity to review, analyze, and chart such prior art. Defendants reserve the right to amend their invalidity contentions with any additional potential prior art known by Giken but not yet disclosed to Defendants.

Defendants provide these invalidity contentions only for the claims asserted by Giken but reserve the right to seek invalidation of all claims in each of the Asserted Patents.

D. Ongoing Investigation.

Defendants' discovery and investigation in connection with this lawsuit are ongoing, including discovery from Giken. Thus, these invalidity contentions are based on information obtained to date. Defendants expressly reserve the right to amend their disclosures and document production to account for evidence uncovered as their investigations continue. Such amendments include identifying and relying on additional references that may result from Defendants' further searches and analysis. Defendants reserve the right to supplement these contentions in light of any additional prior art of which Giken is aware and did not disclose to Defendants in discovery, or that might be subsequently disclosed by Giken in response to Defendants' discovery requests. Defendants anticipate issuing subpoenas to third parties believed to have knowledge, documentation and/or corroborating evidence concerning some of the prior art listed herein and/or additional prior art. These third parties include, but are not limited to, the authors, employers of authors, inventors, assignees, or former or current employees of assignees, of the references identified in these invalidity contentions. For example, Defendants anticipate issuing subpoenas to potential prior artists including but not limited to individuals and entities responsible for the development of prior art systems. Defendants may also commission reverse engineering studies of certain product prior art identified herein. Discovery from these reverse engineering studies likely will reveal information that impacts the disclosures and contentions

herein. Defendants reserve the right to supplement these contentions in light of any newly discovered information produced by these third parties and reverse engineering studies from which Defendants may seek discovery.

III. ANTICIPATION AND OBVIOUSNESS (35 U.S.C. §§ 102 AND 103)

A. Legal Standard.

Under 35 U.S.C. § 102, “[a] patent is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention.” *Schering Corp. v. Geneva Pharm., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003). A prior art reference may anticipate a claim limitation even though the limitation is “not expressly found in that reference.” *MEHL/Biophile Int’l Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999); *Standard Havens Prod., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991) (“An anticipatory reference ... need not duplicate word for word what is in the claims.”). Instead, “[a]nticipation can occur when a claimed limitation is ‘inherent’ or otherwise implicit in the relevant reference.” *Standard Havens*, 953 F.2d at 1369; *see also Schering Corp. v. Geneva Pharm.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) (“[A] prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.”). In addition, the prior art document “may incorporate subject matter by reference to another document such that the incorporated material becomes part of the host document for the purposes of anticipation.” *Apple Inc. v. Int’l Trade Comm’n*, 725 F.3d 1356, 1362 (Fed. Cir. 2013).

Under 35 U.S.C. § 103, a patent may not issue “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.” Pre-AIA 35 U.S.C. § 103(a). Thus, “[a]n invention which

has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent.” *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966). Obviousness is a question of law based on underlying factual findings concerning: “(1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness,” otherwise known as “secondary considerations.” *Miles Labs., Inc. v. Shandon, Inc.*, 997 F.2d 870, 877 (Fed. Cir. 1993); *Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1339 (Fed. Cir. 2008).

To prove that a patent is obvious, a party must demonstrate “that a skilled artisan would have had reason to combine the teaching of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success from doing so.” *Eurand, Inc. v. Mylan Pharms. Inc.*, 676 F.3d 1063, 1069 (Fed. Cir. 2012); *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”). Although an analysis of any teaching, suggestion, or motivation to combine known elements might provide “helpful insight[s],” the overall obviousness inquiry must be “expansive and flexible.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007) (rejecting “rigid and mandatory formulas” that “that deny factfinders recourse to common sense”).

A reason to combine may be found explicitly or implicitly, in one or more of the following:

1. A person of ordinary skill in the art’s knowledge or common sense;
2. The prior art references themselves;
3. The subject matter acknowledged as prior art in the asserted patent;

4. The interrelated teachings of multiple prior art references identified herein;
5. The nature of the problem to be purportedly solved by the asserted patent and the existence of similar improvements in similar applications;
6. Design incentives and other market forces, including the advantages of creating a superior and more desirable product and the effects of demands known to the design community or present in the marketplace;
7. The ability to implement the alleged invention as a predictable variation of the prior art;
8. Combining prior art elements according to known methods to yield predictable results;
9. Improvements in similar devices;
10. Applying a known technique to a known device (method or product) ready for improvement to yield predictable results;
11. Any needs or problems known in the field and purportedly addressed by the asserted patent, *i.e.*, “obvious to try”;
12. The number of identified, predictable solutions to the problem(s) purportedly addressed by the asserted patent;
13. The simple substitution of one known elements for another to obtain predictable results; and
14. Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

See KSR Int’l Co., 550 U.S. at 416-418, 421. Defendants discuss certain of these reasons more specifically below and in the attached charts. The fact that other reasons are not discussed more specifically should not be interpreted as an admission or concession that it does not apply. To the contrary, the discussion below simply provides more explanation of certain reasons.

Finally, the use of hindsight is not permitted when determining whether a claim would have been obvious to one having ordinary skill in the art. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421, (2007) (cautioning against “the distortion caused by hindsight bias” and obviousness “arguments reliant upon *ex post* reasoning”). To protect against the improper use of hindsight

when assessing obviousness, a court is required to consider secondary considerations or objective indicia of non-obviousness. *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294, 1310 (Fed. Cir. 2010). Secondary considerations of nonobviousness may include “commercial success, industry praise, unexpected results, copying, industry skepticism, licensing, and long-felt but unsolved need.” *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340, 1349 (Fed. Cir. 2012). To the extent Giken has offered in written discovery responses evidence they contend establishes non-obviousness, at a minimum, Giken has not identified nor established a nexus to the claimed systems or methods, and in particular, to the alleged inventive aspect of the asserted claims over the prior art. Discovery has just begun and Giken has not substantiated any of the alleged “evidence” identified thus far, and Defendants have not yet had the opportunity to obtain discovery on such alleged “evidence.” Defendants reserves the right to challenge the alleged “evidence” Giken has offered in its written discovery responses, and any additional “evidence” identified in the future.

B. Prior Art that Anticipates and/or Renders Obvious Each Asserted Claim of the ’592 Patent.

Defendants contend that the prior art references identified in Exhibits 592.A-G and/or described below anticipate and/or render obvious, alone or in combination, one or more of the Asserted Claims of the ’592 Patent. Each prior art reference identified below is prior art under at least 35 U.S.C. § 102(a), (b), and/or (e) (pre-AIA).

1. Prior Art Patents and Published Patent Applications

Prior Art Patents and Published Applications	Issue/Publication Date
U.S. Patent App. Pub. No. 2005/0160465 (“Walker”)	July 21, 2005
U.S. Patent App. Pub. No. 2002/0194619 (“Chang”)	December 19, 2002
U.S. Patent App. Pub. No. 2008/0086743 (“Cheng”)	April 10, 2008

Prior Art Patents and Published Applications	Issue/Publication Date
U.S. Patent App. Pub. No. 2004/0179811 (“Kikkawa”)	September 16, 2004

2. Prior Art Products and Systems

Prior Art Products/Systems	Documentation	Date of Availability
Helius System	<i>See Exhibit 592.E</i>	by 2006
2NetFX	<i>See Exhibit 592.F</i>	by 2001
TiVo	<i>See Exhibit 592.G</i>	by 2003

In addition to the products in the chart above, Defendants continues to investigate the identities of the individuals or entities involved in the first sale, offer for sale, or public use of prior art products that were made using the system recited by the asserted claims of the ’592 Patent. Defendants will produce additional documents relating to the invalidity of the asserted claims by those products as they become available.

3. Claim Charts

Defendants have attached charts identifying prior art that anticipates and/or renders obvious each of the Asserted Claims of the ’592 Patent in **Exhibits 592.A-G**, collectively referred to as the “’592 Patent Invalidity Charts.”

For each Asserted Claim that is anticipated by a reference, the corresponding claim chart includes a citation to that reference for each limitation. While Defendants have identified at least one citation per limitation present in a reference, each and every disclosure of the same limitation in the same reference is not necessarily identified. In an effort to focus the issues, Defendants cite only portions of identified references, even where a reference may contain additional support for a particular claim element. Persons of ordinary skill in the art generally read a prior art

reference as a whole and in the context of other publications and literature. Defendants reserve the right to rely on uncited portions of the prior art references and on other publications and expert testimony to provide context and as aids to understanding and interpreting the portions that are cited. To the extent any limitation is deemed not to be exactly met by an item of prior art, then any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge, skill, or creativity of those skilled in the art. Where Defendants cite to a particular figure in a prior art reference, the citation should be understood to encompass the caption and description of the figure and any text relating to the figure in addition to the figure itself. Conversely, where a cited portion of text refers to a figure, the citation should be understood to include the figure as well.

Defendants have provided exemplary combinations in Exhibits 592.A-G for specific claim limitations which identify exemplary secondary references and exemplary disclosures therefrom. Each prior art reference evidences teachings, suggestions, motivations, and/or other reasons to combine it with the other identified references in ways that render obvious all of the asserted claims of the '592 Patent. In addition to any specific combinations of prior art disclosed using claim charts, Defendants reserve the right to rely on any combination of prior art references disclosed in these contentions.

To the extent any item of prior art cited above is deemed not to disclose, explicitly or inherently, any limitation of an asserted claim of the '592 Patent, Defendants reserve the right to argue that any difference between that prior art and the corresponding patent claim would have been either inherent in the art or obvious to a person of ordinary skill in the art, even if Defendants have not specifically denoted that the art is to be combined with the knowledge of a

person of ordinary skill in the art.

4. The '592 Patent is Obvious Over the Prior Art.

In addition to the references cited on the face of the '592 Patent, the admitted prior art in the specification of the '592 Patent, and the prosecution history of the '592 Patent, the prior art references identified in Exhibits 592.A-G and listed above disclose the elements of the Asserted Claims, either explicitly, inherently, or via an obviousness combination, and may also be relied upon to show the state of the art in the relevant timeframes.

In addition to the references listed in this section, Defendants also identify all of the exemplary prior art references listed above as relevant to the knowledge, understandings, creativity, or skill of the person having ordinary skill in the art. Defendants reserve the right to supplement the invalidity contentions with additional charts for any of the references identified in Exhibits 592.A-G. Defendants further reserve the right to rely on the additional references, teachings, knowledge, or understandings identified or disclosed during fact or expert discovery in this case as evidence of the knowledge, understandings, creativity, or skill of the person having ordinary skill in the art.

Defendants further incorporate by reference the prior art references related to the '592 Patent, including those identified in any other proceeding involving the '592 Patent or related U.S. or foreign patents. Defendants additionally incorporate by reference all prior art produced by or otherwise known by Giken, the named inventors, any past or current owner of the '592 Patent, or any individual substantively involved in the prosecution of the '592 Patent.

To the extent Giken argues that any limitation of the asserted claims of the '592 Patent are not explicitly or inherently disclosed by an item of prior art identified above or in Exhibits 592.A-G, any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the

state of the art and knowledge of those skilled in the art. The item of prior art would, therefore, render the relevant claims invalid as obvious under 35 U.S.C. § 103.

5. Illustrative Obviousness Combinations and Motivations to Combine or Modify References.

Defendants have provided illustrative examples of such invalidating combinations in the attached charts. To the extent any reference disclosed does not chart every aspect of an element, the references still render the Asserted Claims obvious because one of ordinary skill in the art would find that aspect obvious without the need to combine or modify such aspect of the element with, or in light of, other references.

Generally, motivation to combine any of the references for the '592 Patent with other references exists within the references themselves, as well as within the knowledge of those of ordinary skill in the art at the relevant time. One of ordinary skill in the art would have understood how to combine or modify the teachings of the prior art references referred to in these invalidity contentions and would have been motivated to pursue such combinations for numerous reasons. For example, all references identified above and in Exhibits 592.A-G are analogous art because each of them is from the same field of endeavor as the claimed inventions of the '592 Patent. *See, e.g.*, '592 Patent, Abstract. One of ordinary skill in the art would have combined particular features of systems, apparatuses, and methods disclosed in certain of the prior art references with other prior art references that do not expressly disclose such particular features because, *e.g.*, (i) the teachings of the references are interrelated and cite each other, (ii) it would have been a simple substitution of particular features in one reference into the systems, methods, and/or processes of another reference, (iii) the nature of the problem alleged by the Asserted Patents made such combinations apparent and a matter of common sense, (iv) design incentives and other market forces would have made the advantages of such combinations clear,

(v) such combinations would have been predictable variations of the prior art, (vi) such combinations would have yielded predictable results, (vii) it would have been obvious to try such combinations, and (viii) such combinations would be within a finite number of identified, predictable solutions to the problem alleged by the Asserted Patents.

Should additional evidence of motivation to combine or modify be required to render the Asserted Claims obvious, Defendants allege that there was a motivation to combine or modify one or more references listed above and identified in Exhibits 592.A-G, including the references in the '592 Patent Invalidity Charts, and, specifically, the illustrative obviousness combinations identified above. That motivation was provided in the nature of the problem allegedly solved by the '592 Patent, the teachings of the cited prior art itself, and/or the knowledge of a person of ordinary skill in the art. For example, one or more combinations of the prior art references in Exhibits 592.A-G would have been obvious because these references would have been combined or modified using: known methods to yield predictable results; common sense; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or teaching, suggestion, or motivation in the prior art generally. In addition, it would have been obvious to try combining or modifying the prior art references identified in Exhibits 592.A-G, including the references in the '592 Patent Invalidity Charts, because there were only a finite number of predictable solutions and/or because known work in one field of endeavor prompted variations based on predictable design incentives and/or market forces either in the same field or a different one. In addition, the combination of the prior art references would have been obvious because the combination represents known potential options with a reasonable expectation of success.

Additional evidence that there would have been a motivation to combine or modify the

prior art references listed above and identified in Exhibits 592.A-G includes the interrelated teachings of multiple prior art references; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the alleged invention(s); and the background knowledge, skill, or creativity that would have been possessed by a person having ordinary skill in the art.

Moreover, Exhibits 592.A-G identify limitations that were well known in the prior art, as well as limitation-specific motivation to combine or modify. Defendants may rely on uncited portions of the prior art references cited and produced, other publications and testimony, and the testimony of experts to establish that a person of ordinary skill in the art would have been motivated to modify or combine certain of the cited references so as to render the claims obvious. References identified by Defendants address the same technical issues and suggest very similar solutions to those issues discussed in the '592 Patent and generally known at the time of the alleged invention(s) claimed in the Asserted Claims.

C. Prior Art that Anticipates and/or Renders Obvious Each Asserted Claim of the '236 Patent.

Defendants contend that the prior art references identified in Exhibits 236.A-B and/or described below anticipate and/or render obvious, alone or in combination, one or more of the Asserted Claims of the '236 Patent. Each prior art reference identified below is prior art under at least 35 U.S.C. § 102(a), (b), and/or (e) (pre-AIA).

1. Prior Art Patents and Published Patent Applications

Prior Art Patents and Published Applications	Issue/Publication Date
U.S. Patent No. 7,143,428 ("Bruck").	Nov. 28, 2006
U.S. Patent App. Pub. No. 2004/0231003 ("Cooper").	Nov. 18 2004

Prior Art Patents and Published Applications	Issue/Publication Date
U.S. Patent No. 8,611,258 (“Croak”).	Dec. 17, 2013
U.S. Patent App. Pub. No. 2005/0262542 (“DeWeese”).	Nov. 24, 2005
U.S. Patent App. Pub. No. 2006/0258289 (“Dua”).	Nov. 16, 2006
U.S. Patent App. Pub. No. 2006/0221173 (“Duncan”).	Oct. 5, 2006
U.S. Patent App. Pub. No. 2006/0271959 (“Jacoby”).	Nov. 30, 2006
U.S. Patent No. 4,754,268 (“Mori”).	Jun. 28, 1988
U.S. Patent App. Pub. No. 2002/0078442 (“Reyes”).	Jun. 20, 2002
U.S. Patent App. Serial No. 09/475,391 (“Silva”).	Jun. 30, 2001
WIPO Patent App. No. WO 01/50753 (“Silva II”).	Jul. 12, 2001.
U.S. Patent App. Pub. No. 2007/0050822 (“Stevens”).	Mar. 1, 2007
U.S. Patent No 7,669,213 (“Wick”).	Feb. 23, 2010

2. Prior Art Products and Systems

Prior Art Products/Systems	Documentation	Date of Availability
TiVo Series2	See Exhibit 968.G	by 2003

In addition to the products in the chart above, Defendants continues to investigate the identities of the individuals or entities involved in the first sale, offer for sale, or public use of prior art products that were made using the system recited by the asserted claims of the ’236 Patent. Defendants will produce additional documents relating to the invalidity of the asserted claims by those products as they become available.

3. Claim Charts

Defendants have attached charts identifying prior art that anticipates and/or renders obvious each of the Asserted Claims of the ’236 Patent in **Exhibits 236.A-B**, collectively

referred to as the “’236 Patent Invalidation Charts.”

For each Asserted Claim that is anticipated by a reference, the corresponding claim chart includes a citation to that reference for each limitation. While Defendants have identified at least one citation per limitation present in a reference, each and every disclosure of the same limitation in the same reference is not necessarily identified. In an effort to focus the issues, Defendants cite only portions of identified references, even where a reference may contain additional support for a particular claim element. Persons of ordinary skill in the art generally read a prior art reference as a whole and in the context of other publications and literature. Defendants reserve the right to rely on uncited portions of the prior art references and on other publications and expert testimony to provide context and as aids to understanding and interpreting the portions that are cited. To the extent any limitation is deemed not to be exactly met by an item of prior art, then any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge, skill, or creativity of those skilled in the art. Where Defendants cite to a particular figure in a prior art reference, the citation should be understood to encompass the caption and description of the figure and any text relating to the figure in addition to the figure itself. Conversely, where a cited portion of text refers to a figure, the citation should be understood to include the figure as well.

Defendants have provided exemplary combinations in Exhibits 236.A-B for specific claim limitations which identify exemplary secondary references and exemplary disclosures therefrom. Each prior art reference evidences teachings, suggestions, motivations, and/or other reasons to combine it with the other identified references in ways that render obvious all of the asserted claims of the ’236 Patent. In addition to any specific combinations of prior art disclosed

using claim charts, Defendants reserve the right to rely on any combination of prior art references disclosed in these contentions.

To the extent any item of prior art cited above is deemed not to disclose, explicitly or inherently, any limitation of an asserted claim of the '236 Patent, Defendants reserve the right to argue that any difference between that prior art and the corresponding patent claim would have been either inherent in the art or obvious to a person of ordinary skill in the art, even if Defendants have not specifically denoted that the art is to be combined with the knowledge of a person of ordinary skill in the art.

4. The '236 Patent is Obvious Over the Prior Art.

In addition to the references cited on the face of the '236 Patent, the admitted prior art in the specification of the '236 Patent, and the prosecution history of the '236 Patent, the prior art references identified in Exhibits 236.A-B and listed above disclose the elements of the Asserted Claims, either explicitly, inherently, or via an obviousness combination, and may also be relied upon to show the state of the art in the relevant timeframes.

In addition to the references listed in this section, Defendants also identify all of the exemplary prior art references listed above as relevant to the knowledge, understandings, creativity, or skill of the person having ordinary skill in the art. Defendants reserve the right to supplement the invalidity contentions with additional charts for any of the references identified in Exhibits 236.A-B. Defendants further reserve the right to rely on the additional references, teachings, knowledge, or understandings identified or disclosed during fact or expert discovery in this case as evidence of the knowledge, understandings, creativity, or skill of the person having ordinary skill in the art.

Defendants further incorporate by reference the prior art references related to the '236 Patent, including those identified in any other proceeding involving the '236 Patent or related

U.S. or foreign patents. Defendants additionally incorporate by reference all prior art produced by or otherwise known by Giken, the named inventors, any past or current owner of the '236 Patent, or any individual substantively involved in the prosecution of the '236 Patent.

To the extent Giken argues that any limitation of the asserted claims of the '236 Patent are not explicitly or inherently disclosed by an item of prior art identified above or in Exhibits 236.A-B, any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge of those skilled in the art. The item of prior art would, therefore, render the relevant claims invalid as obvious under 35 U.S.C. § 103.

Moreover, Giken contends that one or more claims of the '236 patent read upon Amazon's "Watch Party" feature. If a fact finder were to accept this contention as true (which it is not), then the '236 patent's claims would be anticipated or rendered obvious by prior art references that disclose such functionality, including the prior art references and exemplary citations below.

- 1) U.S. Patent App. Pub. No. 2006/0271959 ("**Jacoby**"). *E.g.*, ¶¶ 52 ("shared viewing of content between a plurality of users, shared remote control functionality between a plurality of users, combinations thereof, shared remote and shared viewing with instant messaging between a plurality of users, etc."), 88 ("the synchronization of a given user with one or more buddies may result in the user and one or more buddies engaging in a "movie theater type viewing environment, wherein the user and one or more buddies view the same television show, movie, etc., at the same time while engaging in instant messaging or chat sessions"), Figs. 1, 5.
- 2) U.S. Patent App. Pub. No. 2006/0221173 ("**Duncan**"). *E.g.*, ¶¶ 3 ("allow the user to participate in a chat session which is related to the programme currently being viewed. Indeed, the chat room text can be displayed on the same television screen as the programme to which the chat relates"), 44 ("a user may participate in a service in which a group of users simultaneously view (or listen to) the same programmes and discuss them"), Fig. 4.
- 3) U.S. Patent App. Pub. No. 2004/0231003 ("**Cooper**"). *E.g.*, ¶¶ 55 ("Fig. 9 illustrates how a display can simultaneously present a television program and a chat room"), 56 ("when a user watching 'Gilligan's Island' selects the TV chat control, the server

- places the user in a ‘Gilligan’s Island’ chat room 902 with other users viewing the show. The users can then share their comments on the show in real time by submitting messages to the server for display in the chat room window.”), 58 (“For example, if the user tunes from ‘Love Boat’ to ‘Fantasy Island,’ the user can be moved from the Love Boat chat room to the Fantasy Island chat room.”). Figs. 8-10.
- 4) U.S. Patent No. 8,611,258 (“**Croak**”). *E.g.*, Abstract (“Specifically, a user can request the network to activate and display a video session, such as a movie. The user can invite one or more other users to participate in the video session. As other users accept to participate in the video session, the network can activate another session that enables the participants to communicate with each other via instant messages.”), 8;14-16 (“Subscribers 331 and 332 can communicate via the established IM sessions using data flows 361 and 363 while watching the same streaming video contents.”), Figs. 3-4.
 - 5) U.S. Patent App. Pub. No. 2005/0262542 (“**DeWeese**”). *E.g.*, ¶¶ 93 (“Television program 202 may be displayed in region 203 of display screen 200, while a chat room region 206 may be displayed simultaneously in the lower portion of display screen 200.”), 94-96, 97 (“The divided nature of screen 200 allows users to simultaneously watch a television program and send real time communications to other users who are viewing the same program at the same time. In this way, chat room 206 is directly linked to the on-going actions in program 202 in that a user can send and receive comments about the content of the program as it unfolds on his television screen.”), 150 (“allows the user to participate in the chat group and to view the television program that is the subject of the chat simultaneously”), Figs. 9, 20-24, ¶ 139.
 - 6) U.S. Patent App. Pub. No. 2007/0050822 (“**Stevens**”). *E.g.*, Abstract (“transporting signals associated with common content to a group of subscribers such that each member of the group receives the same content and establishing the shared community experience between members of the group by providing communications between on or more members of the group during playback of the content”), ¶¶ 32 (“Any number of subscribers may create their own community groups and invite any number of other subscribers to join the group”), 36, 37 (“text messages from other members of the group are displayed in a pop-up window or other feature displayed in the televisions 40-46;” “[i]dentifiers and other features may be included to identify the users in the window and the text messages associated therewith, similar to an instant messaging arrangement”), 45 (“join a ‘TV-Together’ group;” “selected participants may tune (or are automatically tuned by the group leader) to a common television channel and are connected (preferably through the set-top box) in a multi-way audio conference call.”), 46, Figs. 1-2.
 - 7) U.S. Patent No. 7,143,428 (“**Bruck**”). *E.g.*, Abstract (“The system has a user-selectable chat option in which the viewer can enter text messages that will be displayed to other viewers of the video signal who have also selected the chat option.”), 7:44-46 (“Chat user interface 110 also includes a video region 118 for display of a video signal, i.e., a television program which the user was viewing prior to entry of the chat room.”), 8:4-6 (“In the interface of FIG. 8, chat region 108 is

smaller and is positioned at the top of the interface, with video region 118 being located at the bottom.”), 7:17-11:14, Figs. 5-14.

To the extent Giken contends otherwise, the claims of the ’236 patent recite, at most, a specific, narrow implementation of a well-known concept, which implementation is one of many possible implementations and which implementation Amazon does not practice.

5. Illustrative Obviousness Combinations and Motivations to Combine or Modify References

Defendants have provided illustrative examples of such invalidating combinations in the attached charts. To the extent any reference disclosed does not chart every aspect of an element, the references still render the Asserted Claims obvious because one of ordinary skill in the art would find that aspect obvious without the need to combine or modify such aspect of the element with, or in light of, other references.

Generally, motivation to combine any of the references for the ’236 Patent with other references exists within the references themselves, as well as within the knowledge of those of ordinary skill in the art at the relevant time. One of ordinary skill in the art would have understood how to combine or modify the teachings of the prior art references referred to in these invalidity contentions and would have been motivated to pursue such combinations for numerous reasons. For example, all references identified above and in Exhibits 236.A-B are analogous art because each of them is from the same field of endeavor as the claimed inventions of the ’236 Patent. *See, e.g.*, ’236 Patent, Abstract. One of ordinary skill in the art would have combined particular features of systems, apparatuses, and methods disclosed in certain of the prior art references with other prior art references that do not expressly disclose such particular features because, *e.g.*, (i) the teachings of the references are interrelated and cite each other, (ii) it would have been a simple substitution of particular features in one reference into the systems, methods, and/or processes of another reference, (iii) the nature of the problem alleged by the

Asserted Patents made such combinations apparent and a matter of common sense, (iv) design incentives and other market forces would have made the advantages of such combinations clear, (v) such combinations would have been predictable variations of the prior art, (vi) such combinations would have yielded predictable results, (vii) it would have been obvious to try such combinations, and (viii) such combinations would be within a finite number of identified, predictable solutions to the problem alleged by the Asserted Patents.

Should additional evidence of motivation to combine or modify be required to render the Asserted Claims obvious, Defendants allege that there was a motivation to combine or modify one or more references listed above and identified in Exhibits 236.A-B, including the references in the '236 Patent Invalidity Charts, and, specifically, the illustrative obviousness combinations identified above. That motivation was provided in the nature of the problem allegedly solved by the '236 Patent, the teachings of the cited prior art itself, and/or the knowledge of a person of ordinary skill in the art. For example, one or more combinations of the prior art references in Exhibits 236.A-B would have been obvious because these references would have been combined or modified using: known methods to yield predictable results; common sense; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or teaching, suggestion, or motivation in the prior art generally. In addition, it would have been obvious to try combining or modifying the prior art references identified in Exhibits 236.A-B, including the references in the '236 Patent Invalidity Charts, because there were only a finite number of predictable solutions and/or because known work in one field of endeavor prompted variations based on predictable design incentives and/or market forces either in the same field or a different one. In addition, the combination of the prior art references would have been obvious because the combination represents known potential options

with a reasonable expectation of success.

Additional evidence that there would have been a motivation to combine or modify the prior art references listed above and identified in Exhibits 236.A-B includes the interrelated teachings of multiple prior art references; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the alleged invention(s); and the background knowledge, skill, or creativity that would have been possessed by a person having ordinary skill in the art.

Moreover, Exhibits 236.A-B identify limitations that were well known in the prior art, as well as limitation-specific motivation to combine or modify. Defendants may rely on uncited portions of the prior art references cited and produced, other publications and testimony, and the testimony of experts to establish that a person of ordinary skill in the art would have been motivated to modify or combine certain of the cited references so as to render the claims obvious. References identified by Defendants address the same technical issues and suggest very similar solutions to those issues discussed in the '236 Patent and generally known at the time of the alleged invention(s) claimed in the Asserted Claims.

D. Prior Art that Anticipates and/or Renders Obvious Each Asserted Claim of the '391 Patent.

Defendants contend that the prior art references identified in Exhibits 391.A-D and/or described below anticipate and/or render obvious, alone or in combination, one or more of the Asserted Claims of the '391 Patent. Each prior art reference identified below is prior art under at least 35 U.S.C. § 102(a), (b), and/or (e) (pre-AIA).

1. Prior Art Patents and Published Patent Applications

Prior Art Patents and Published Applications	Issue/Publication Date
Japanese Patent App. Pub. No. 2003158721 (“Hisamune”)	May 30, 2003
U.S. Patent App. Pub. No. 2006/0053049 (“Nolan”)	March 9, 2006
U.S. Patent App. Pub. No. 2007/0288951 (“Ray”)	December 13, 2007

2. Prior Art Products and Systems

Prior Art Products/Systems	Documentation	Date of Availability
Massive, Inc.	<i>See Exhibit 391.D</i>	2004
Lord of the Rings: Return of the King	<i>See Exhibit 391.D</i>	2003
SWAT 4	<i>See Exhibit 391.D</i>	2005

In addition to the products in the chart above, Defendants continues to investigate the identities of the individuals or entities involved in the first sale, offer for sale, or public use of prior art products that were made using the system recited by the asserted claims of the ’391 Patent. Defendants will produce additional documents relating to the invalidity of the asserted claims by those products as they become available.

3. Claim Charts

Defendants have attached charts identifying prior art that anticipates and/or renders obvious each of the Asserted Claims of the ’391 Patent in **Exhibits 391.A-D**, collectively referred to as the “’391 Patent Invalidation Charts.”

For each Asserted Claim that is anticipated by a reference, the corresponding claim chart includes a citation to that reference for each limitation. While Defendants have identified at least one citation per limitation present in a reference, each and every disclosure of the same limitation

in the same reference is not necessarily identified. In an effort to focus the issues, Defendants cite only portions of identified references, even where a reference may contain additional support for a particular claim element. Persons of ordinary skill in the art generally read a prior art reference as a whole and in the context of other publications and literature. Defendants reserve the right to rely on uncited portions of the prior art references and on other publications and expert testimony to provide context and as aids to understanding and interpreting the portions that are cited. To the extent any limitation is deemed not to be exactly met by an item of prior art, then any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge, skill, or creativity of those skilled in the art. Where Defendants cite to a particular figure in a prior art reference, the citation should be understood to encompass the caption and description of the figure and any text relating to the figure in addition to the figure itself. Conversely, where a cited portion of text refers to a figure, the citation should be understood to include the figure as well.

Defendants have provided exemplary combinations in Exhibits 391.A-D for specific claim limitations which identify exemplary secondary references and exemplary disclosures therefrom. Each prior art reference evidences teachings, suggestions, motivations, and/or other reasons to combine it with the other identified references in ways that render obvious all of the asserted claims of the '391 Patent. In addition to any specific combinations of prior art disclosed using claim charts, Defendants reserve the right to rely on any combination of prior art references disclosed in these contentions.

To the extent any item of prior art cited above is deemed not to disclose, explicitly or inherently, any limitation of an asserted claim of the '391 Patent, Defendants reserve the right to

argue that any difference between that prior art and the corresponding patent claim would have been either inherent in the art or obvious to a person of ordinary skill in the art, even if Defendants have not specifically denoted that the art is to be combined with the knowledge of a person of ordinary skill in the art.

4. The '391 Patent is Obvious Over the Prior Art.

In addition to the references cited on the face of the '391 Patent, the admitted prior art in the specification of the '391 Patent, and the prosecution history of the '391 Patent, the prior art references identified in Exhibits 391.A-D and listed above disclose the elements of the Asserted Claims, either explicitly, inherently, or via an obviousness combination, and may also be relied upon to show the state of the art in the relevant timeframes.

In addition to the references listed in this section, Defendants also identify all of the exemplary prior art references listed above as relevant to the knowledge, understandings, creativity, or skill of the person having ordinary skill in the art. Defendants reserve the right to supplement the invalidity contentions with additional charts for any of the references identified in Exhibits 391.A-D. Defendants further reserve the right to rely on the additional references, teachings, knowledge, or understandings identified or disclosed during fact or expert discovery in this case as evidence of the knowledge, understandings, creativity, or skill of the person having ordinary skill in the art.

Defendants further incorporate by reference the prior art references related to the '391 Patent, including those identified in any other proceeding involving the '391 Patent or related U.S. or foreign patents. Defendants additionally incorporate by reference all prior art produced by or otherwise known by Giken, the named inventors, any past or current owner of the '391 Patent, or any individual substantively involved in the prosecution of the '391 Patent.

To the extent Giken argues that any limitation of the asserted claims of the '391 Patent

are not explicitly or inherently disclosed by an item of prior art identified above or in Exhibits 391.A-D, any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge of those skilled in the art. The item of prior art would, therefore, render the relevant claims invalid as obvious under 35 U.S.C. § 103.

5. Illustrative Obviousness Combinations and Motivations to Combine or Modify References.

Defendants have provided illustrative examples of such invalidating combinations in the attached charts. To the extent any reference disclosed does not chart every aspect of an element, the references still render the Asserted Claims obvious because one of ordinary skill in the art would find that aspect obvious without the need to combine or modify such aspect of the element with, or in light of, other references.

Generally, motivation to combine any of the references for the '391 Patent with other references exists within the references themselves, as well as within the knowledge of those of ordinary skill in the art at the relevant time. One of ordinary skill in the art would have understood how to combine or modify the teachings of the prior art references referred to in these invalidity contentions and would have been motivated to pursue such combinations for numerous reasons. For example, all references identified above and in Exhibits 391.A-D are analogous art because each of them is from the same field of endeavor as the claimed inventions of the '391 Patent. *See, e.g.*, '391 Patent, Abstract. One of ordinary skill in the art would have combined particular features of systems, apparatuses, and methods disclosed in certain of the prior art references with other prior art references that do not expressly disclose such particular features because, *e.g.*, (i) the teachings of the references are interrelated and cite each other, (ii) it would have been a simple substitution of particular features in one reference into the systems,

methods, and/or processes of another reference, (iii) the nature of the problem alleged by the Asserted Patents made such combinations apparent and a matter of common sense, (iv) design incentives and other market forces would have made the advantages of such combinations clear, (v) such combinations would have been predictable variations of the prior art, (vi) such combinations would have yielded predictable results, (vii) it would have been obvious to try such combinations, and (viii) such combinations would be within a finite number of identified, predictable solutions to the problem alleged by the Asserted Patents.

Should additional evidence of motivation to combine or modify be required to render the Asserted Claims obvious, Defendants allege that there was a motivation to combine or modify one or more references listed above and identified in Exhibits 391.A-D, including the references in the '391 Patent Invalidity Charts, and, specifically, the illustrative obviousness combinations identified above. That motivation was provided in the nature of the problem allegedly solved by the '391 Patent, the teachings of the cited prior art itself, and/or the knowledge of a person of ordinary skill in the art. For example, one or more combinations of the prior art references in Exhibits 391.A-D would have been obvious because these references would have been combined or modified using: known methods to yield predictable results; common sense; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or teaching, suggestion, or motivation in the prior art generally. In addition, it would have been obvious to try combining or modifying the prior art references identified in Exhibits 391.A-D, including the references in the '391 Patent Invalidity Charts, because there were only a finite number of predictable solutions and/or because known work in one field of endeavor prompted variations based on predictable design incentives and/or market forces either in the same field or a different one. In addition, the combination of the prior art

references would have been obvious because the combination represents known potential options with a reasonable expectation of success.

Additional evidence that there would have been a motivation to combine or modify the prior art references listed above and identified in Exhibits 391.A-D includes the interrelated teachings of multiple prior art references; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the alleged invention(s); and the background knowledge, skill, or creativity that would have been possessed by a person having ordinary skill in the art.

Moreover, Exhibits 391.A-D identify limitations that were well known in the prior art, as well as limitation-specific motivation to combine or modify. Defendants may rely on uncited portions of the prior art references cited and produced, other publications and testimony, and the testimony of experts to establish that a person of ordinary skill in the art would have been motivated to modify or combine certain of the cited references so as to render the claims obvious. References identified by Defendants address the same technical issues and suggest very similar solutions to those issues discussed in the '391 Patent and generally known at the time of the alleged invention(s) claimed in the Asserted Claims.

E. Prior Art that Anticipates and/or Renders Obvious Each Asserted Claim of the '968 Patent.

Defendants contend that the prior art references identified in Exhibits 968.A-G and/or described below anticipate and/or render obvious, alone or in combination, one or more of the Asserted Claims of the '968 Patent. Each prior art reference identified below is prior art under at least 35 U.S.C. § 102(a), (b), and/or (e) (pre-AIA).

1. Prior Art Patents and Published Patent Applications

Prior Art Patents and Published Applications	Issue/Publication Date
U.S. Patent App. Pub. No. 2007/0157249 (“Cordray”).	Jul. 5, 2007
U.S. Patent App. Pub. No. 2008/0155615 (“Craner”).	Jun. 26, 2008
U.S. Patent No. 7,929,551 (“Dietrich”).	Apr. 19, 2011
U.S. Patent No. 8,365,235 (“Hunt”).	Jan. 29, 2013
U.S. Patent App. Pub. No. 2008/0025693 (“Lee”).	Jan. 31, 2008
U.S. Patent App. Pub. No. 2005/0097623 (“Tecot”).	May 5, 2005
U.S. Pat. App. Pub. No. 2005/0160465 (“Walker”).	Jul. 21, 2005

2. Prior Art Products and Systems

Prior Art Products/Systems	Documentation	Date of Availability
Apple iPod	<i>See Exhibit 968.F</i>	by 2003
TiVo Series2	<i>See Exhibit 968.G</i>	by 2007

In addition to the products in the chart above, Defendants continues to investigate the identities of the individuals or entities involved in the first sale, offer for sale, or public use of prior art products that were made using the system recited by the asserted claims of the '968 Patent. Defendants will produce additional documents relating to the invalidity of the asserted claims by those products as they become available.

3. Claim Charts

Defendants have attached charts identifying prior art that anticipates and/or renders obvious each of the Asserted Claims of the '968 Patent in **Exhibits 968.A-G**, collectively referred to as the “'968 Patent Invalidity Charts.”

For each Asserted Claim that is anticipated by a reference, the corresponding claim chart

includes a citation to that reference for each limitation. While Defendants have identified at least one citation per limitation present in a reference, each and every disclosure of the same limitation in the same reference is not necessarily identified. In an effort to focus the issues, Defendants cite only portions of identified references, even where a reference may contain additional support for a particular claim element. Persons of ordinary skill in the art generally read a prior art reference as a whole and in the context of other publications and literature. Defendants reserve the right to rely on uncited portions of the prior art references and on other publications and expert testimony to provide context and as aids to understanding and interpreting the portions that are cited. To the extent any limitation is deemed not to be exactly met by an item of prior art, then any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge, skill, or creativity of those skilled in the art. Where Defendants cite to a particular figure in a prior art reference, the citation should be understood to encompass the caption and description of the figure and any text relating to the figure in addition to the figure itself. Conversely, where a cited portion of text refers to a figure, the citation should be understood to include the figure as well.

Defendants have provided exemplary combinations in Exhibits 968.A-G for specific claim limitations which identify exemplary secondary references and exemplary disclosures therefrom. Each prior art reference evidences teachings, suggestions, motivations, and/or other reasons to combine it with the other identified references in ways that render obvious all of the asserted claims of the '968 Patent. In addition to any specific combinations of prior art disclosed using claim charts, Defendants reserve the right to rely on any combination of prior art references disclosed in these contentions.

To the extent any item of prior art cited above is deemed not to disclose, explicitly or inherently, any limitation of an asserted claim of the '968 Patent, Defendants reserve the right to argue that any difference between that prior art and the corresponding patent claim would have been either inherent in the art or obvious to a person of ordinary skill in the art, even if Defendants have not specifically denoted that the art is to be combined with the knowledge of a person of ordinary skill in the art.

4. The '968 Patent is Obvious Over the Prior Art.

In addition to the references cited on the face of the '968 Patent, the admitted prior art in the specification of the '968 Patent, and the prosecution history of the '968 Patent, the prior art references identified in Exhibits 968.A-G and listed above disclose the elements of the Asserted Claims, either explicitly, inherently, or via an obviousness combination, and may also be relied upon to show the state of the art in the relevant timeframes.

In addition to the references listed in this section, Defendants also identify all of the exemplary prior art references listed above as relevant to the knowledge, understandings, creativity, or skill of the person having ordinary skill in the art. Defendants reserve the right to supplement the invalidity contentions with additional charts for any of the references identified in Exhibits 968.A-G. Defendants further reserve the right to rely on the additional references, teachings, knowledge, or understandings identified or disclosed during fact or expert discovery in this case as evidence of the knowledge, understandings, creativity, or skill of the person having ordinary skill in the art.

Defendants further incorporate by reference the prior art references related to the '968 Patent, including those identified in any other proceeding involving the '968 Patent or related U.S. or foreign patents. Defendants additionally incorporate by reference all prior art produced by or otherwise known by Giken, the named inventors, any past or current owner of the '968

Patent, or any individual substantively involved in the prosecution of the '968 Patent.

To the extent Giken argues that any limitation of the asserted claims of the '968 Patent are not explicitly or inherently disclosed by an item of prior art identified above or in Exhibits 968.A-G, any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge of those skilled in the art. The item of prior art would, therefore, render the relevant claims invalid as obvious under 35 U.S.C. § 103.

5. Illustrative Obviousness Combinations and Motivations to Combine or Modify References.

Defendants have provided illustrative examples of such invalidating combinations in the attached charts. To the extent any reference disclosed does not chart every aspect of an element, the references still render the Asserted Claims obvious because one of ordinary skill in the art would find that aspect obvious without the need to combine or modify such aspect of the element with, or in light of, other references.

Generally, motivation to combine any of the references for the '968 Patent with other references exists within the references themselves, as well as within the knowledge of those of ordinary skill in the art at the relevant time. One of ordinary skill in the art would have understood how to combine or modify the teachings of the prior art references referred to in these invalidity contentions and would have been motivated to pursue such combinations for numerous reasons. For example, all references identified above and in Exhibits 968.A-G are analogous art because each of them is from the same field of endeavor as the claimed inventions of the '968 Patent. *See, e.g., '968 Patent, Abstract.* One of ordinary skill in the art would have combined particular features of systems, apparatuses, and methods disclosed in certain of the prior art references with other prior art references that do not expressly disclose such particular

features because, *e.g.*, (i) the teachings of the references are interrelated and cite each other, (ii) it would have been a simple substitution of particular features in one reference into the systems, methods, and/or processes of another reference, (iii) the nature of the problem alleged by the Asserted Patents made such combinations apparent and a matter of common sense, (iv) design incentives and other market forces would have made the advantages of such combinations clear, (v) such combinations would have been predictable variations of the prior art, (vi) such combinations would have yielded predictable results, (vii) it would have been obvious to try such combinations, and (viii) such combinations would be within a finite number of identified, predictable solutions to the problem alleged by the Asserted Patents.

Should additional evidence of motivation to combine or modify be required to render the Asserted Claims obvious, Defendants allege that there was a motivation to combine or modify one or more references listed above and identified in Exhibits 968.A-G, including the references in the '968 Patent Invalidity Charts, and, specifically, the illustrative obviousness combinations identified above. That motivation was provided in the nature of the problem allegedly solved by the '968 Patent, the teachings of the cited prior art itself, and/or the knowledge of a person of ordinary skill in the art. For example, one or more combinations of the prior art references in Exhibits 968.A-G would have been obvious because these references would have been combined or modified using: known methods to yield predictable results; common sense; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or teaching, suggestion, or motivation in the prior art generally. In addition, it would have been obvious to try combining or modifying the prior art references identified in Exhibits 968.A-G, including the references in the '968 Patent Invalidity Charts, because there were only a finite number of predictable solutions and/or because known work in

one field of endeavor prompted variations based on predictable design incentives and/or market forces either in the same field or a different one. In addition, the combination of the prior art references would have been obvious because the combination represents known potential options with a reasonable expectation of success.

Additional evidence that there would have been a motivation to combine or modify the prior art references listed above and identified in Exhibits 968.A-G includes the interrelated teachings of multiple prior art references; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the alleged invention(s); and the background knowledge, skill, or creativity that would have been possessed by a person having ordinary skill in the art.

Moreover, Exhibits 968.A-G identify limitations that were well known in the prior art, as well as limitation-specific motivation to combine or modify. Defendants may rely on uncited portions of the prior art references cited and produced, other publications and testimony, and the testimony of experts to establish that a person of ordinary skill in the art would have been motivated to modify or combine certain of the cited references so as to render the claims obvious. References identified by Defendants address the same technical issues and suggest very similar solutions to those issues discussed in the '968 Patent and generally known at the time of the alleged invention(s) claimed in the Asserted Claims.

IV. INVALIDITY UNDER 35 U.S.C. § 112

A. Lack of Written Description and Enablement Under 35 U.S.C. § 112(a).

Section 112 requires that a patent “contain a written description of ... the manner and process of making and using [the invention] in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly

connected, to make and use the same.” 35 U.S.C. § 112(a). A patent is invalid if the written description does not “describe the invention sufficiently to convey to a person of skill in the art that the patentee had possession of the claimed invention at the time of the application, *i.e.*, that the patentee invented what is claimed.” *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005); *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (same). “[T]he test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). “Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” *Id.* The specification provides inadequate support where it “fail[s] to demonstrate that the patentee possessed the *full scope* of the invention recited in [the claim]” *LizardTech*, 424 F.3d at 1345 (emphasis added). “The level of detail required to satisfy the written description requirement depends, in large part, on the nature of the claims and the complexity of the technology. *Streck, Inc. v. Research & Diagnostic Sys., Inc.*, 665 F.3d 1269, 1285 (Fed. Cir. 2012). But a “mere wish or plan” for obtaining the alleged invention does not satisfy the written description requirement. *Novozymes A/S v. DuPont Nutrition Biosciences APS*, 723 F.3d 1336, 1344 (Fed. Cir. 2013). Put another way, “a description that merely renders the invention obvious does not satisfy the requirement.” *Ariad*, 598 F.3d at 1351. Instead, “all the limitations must appear in the specification.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). Defendants contend that, at least under Giken’s actual and/or apparent application of the claims, the specifications of at least one or more of the Asserted Patents do not include a sufficient written description supporting the claims.

Section 112 likewise requires that the specification “enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the” alleged invention. 35 U.S.C. § 112(a). A claim is not enabled if, “at the effective filing date of the patent, one of ordinary skill in the art could not practice their full scope without undue experimentation.” *Wyeth and Cordis Corp. v. Abbott Labs.*, 720 F.3d 1380, 1384 (Fed. Cir. 2013). “This important doctrine prevents both inadequate disclosure of an invention and overbroad claiming that might otherwise attempt to cover more than was actually invented.” *MagSil Corp. v. Hitachi Global Storage Techs., Inc.*, 687 F.3d 1377, 1381 (Fed. Cir. 2012).

“Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations.” *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). These factors may include: “(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.” *Id.* Although “a specification need not disclose what is well known in the art,” “[t]ossing out the mere germ of an idea does not constitute enabling disclosure.” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1366 (Fed. Cir. 1997). A patent “cannot simply rely on the knowledge of a person of ordinary skill to serve as a substitute for the missing information in the specification.” *ALZA Corp. v. Andrx Pharms., LLC*, 603 F.3d 935, 941 (Fed. Cir. 2010).

The specifications of the Asserted Patents fail to satisfy the written description requirement for the Asserted Claims because the alleged inventions claimed therein are not sufficiently described in the specifications of the Asserted Patents. Specifically, the Asserted Patents fail to satisfy the written description requirement for at least the terms identified below

because, based on those terms, the respective specifications of the Asserted Patents do not adequately convey to those skilled in the art that the inventors had possession of the claimed subject matter as of the respective filing dates. Moreover, each Asserted Claim fails to satisfy the written description requirement because the Asserted Patents' specifications do not set forth a single embodiment that includes all limitations of any Asserted Claim. These invalidity contentions are based on Defendants' understanding of Giken's interpretation of the Asserted Claims as asserted in the infringement contentions. Because compliance with the written description requirement of 35 U.S.C. § 112, first paragraph, depends on the construction of the Asserted Claims—and no claim construction positions have been exchanged, no claim construction order has issued and no expert discovery has taken place—Defendants' positions on written description are necessarily preliminary at this early stage of the case. Defendants reserve their right to amend or further revise these invalidity contentions based on further developments, including the Court's claim construction opinion, and discovery in the case. When a phrase is recited in multiple claims, the first instance of that phrase being recited is indicated below; invalidity under § 112, first paragraph, for lack of written description applies to any, all, and each of the claims where the phrase is recited, however.

The Asserted Patents also fail to satisfy the enablement requirement because the specifications of the Asserted Patents do not describe the manner and process of making and using the alleged inventions in the Asserted Claims so as to enable a person of skill in the art to make and use the full scope of the alleged inventions without undue experimentation. Specifically, the specifications of the Asserted Patents fail to meet the enablement requirement for at least the terms identified below because, based on those terms, the respective specifications of the Asserted Patents do not describe the manner and process of making and using the alleged

inventions in the Asserted Claims. These invalidity contentions are based on Defendants' understanding of Giken's interpretation of the Asserted Claims as asserted in the infringement contentions. Because compliance with the enablement requirement of 35 U.S.C. §112, first paragraph, depends on the construction of the Asserted Claims—and no claim construction positions have been exchanged, no claim construction order has been issued and no expert discovery has taken place—Defendants' positions on enablement are necessarily preliminary at this early stage of the case. Defendants reserve their right to amend or further revise these invalidity contentions based on further developments, including the Court's claim construction opinion, and discovery in the case. When a phrase is recited in multiple claims, the first instance of that phrase being recited is indicated below; invalidity under § 112, first paragraph for lack of enablement applies to any, all, and each of the claims where the phrase is recited, however.

For example:

1. The '592 Patent

The asserted claims of the '592 Patent, at least under Giken's actual and/or apparent application of the claims, are invalid under 35 U.S.C. § 112(a) because the specification lacks an adequate written description of the alleged invention and fails to enable the full scope of the alleged invention.

- “the I/O interface locating the integral program in accordance with information at the time of selection by the remote controller” ('592 patent, claim 1);
- “[an/the] integral program” ('592 patent, claims 1-3, 5);
- “a television display that shows the digital moving image contents from the first provider and the second provider” ('592 patent, claim 1);
- “a TV set processor that has the television display show a past part of the integral program which has been already provided by the first provider and retrieved from the memory in the TV set computer” ('592 patent, claim 2);

2. The '236 Patent

The asserted claims of the '236 patent, at least under Giken's actual and/or apparent application of the claims, are invalid under 35 U.S.C. § 112(a) because the specification lacks an adequate written description of the alleged invention and fails to enable the full scope of the alleged invention.

- “the plurality of outside counterparts including a first type of counterpart under free selection and a second type of counterpart which is predetermined” ('236 patent, claim 1);
- “an input provided inside the television set and arranged to newly and freely prepare first information;” ('236 patent, claim 1);
- “an automatic generator provided inside the television set and arranged to generate predetermined second information in response to the detector which detects a cause of a predetermined change in the television function” ('236 patent, claim 1);
- “a second trigger provided inside the television set and arranged to automatically send the second information to the second type of counterpart through the same communicator in response to completion of the function of the automatic generator and the second designator” ('236 patent, claim 1).

3. The '391 Patent

The asserted claims of the '391 patent, at least under Giken's actual and/or apparent application of the claims, are invalid under 35 U.S.C. § 112(a) because the specification lacks an adequate written description of the alleged invention and fails to enable the full scope of the alleged invention.

- “a first controller ” ('391 patent, claims 1, 10);
- “electric data” ('391 patent, claims 1, 10);
- “a second controller” ('391 patent, claims 1, 10);
- “wherein no electric payment is made to the moving image data delivery system when the advertising image data delivery system issues the electric data to the moving image viewing apparatus in exchange of viewing commercial message” ('391 patent, claims 1, 10);

- “the electric data having been issued to the moving image viewing apparatus, without intermediary of the moving image data delivery system, by the advertising image data delivery system in exchange of a commercial message view by the moving image viewing apparatus” (’391 patent, claim 1);
- “without intermediary of the moving image data delivery system” (’391 patent, claims 1, 10);
- “wherein the advertising image data delivery system is integrated into the moving image data delivery system” (’391 patent, claim 9);
- “first controller adapted to issue, without intermediary of the moving image data delivery system, to one of the moving image viewing apparatuses an electric data” (’391 patent, claim 10);
- “third controller” (’391 patent, claim 10);
- “a third controller adapted to allot the received electric payment to the moving image data delivery system” (’391 patent, claim 10);
- “fourth controller” (’391 patent, claims 12-14);
- “a fourth controller adapted to electrically provide one of the plurality of advertising image data of commercial messages to one of the plurality of moving image viewing apparatuses by request thereof.” (’391 patent, claim 12);
- “the advertising image data of commercial message being related to a television program designated by the moving image viewing apparatus” (’391 patent, claim 13);
- “wherein the advertising image data delivery system is integrated into a system of the advertiser” (’391 patent, claim 15).

4. The ’968 Patent

The asserted claims of the ’968 patent, at least under Giken’s actual and/or apparent application of the claims, are invalid under 35 U.S.C. § 112(a) because the specification lacks an adequate written description of the alleged invention and fails to enable the full scope of the alleged invention.

- “A receiving apparatus configured to receive digital moving image contents from a provider of the digital moving image contents, the provider being commutatively connected to the receiving apparatus,” (’968 patent, claim 1);

- “wherein the processor is configured to designate an optional part of the digital moving image contents in response to the manual operation.” (’968 patent, claims 4, 12);
- “wherein the receiving method is further configured to designate an optional part of the digital moving image contents in response to the manual operation” (’968 patent, claim 8);
- “A receiving system configured to receive digital moving image contents from a provider of the digital moving image contents, the provider being commutatively connected to the receiving system,” (’968 patent, claim 9).

B. Indefiniteness Under 35 U.S.C. § 112(b) and/or (f).

Under 35 U.S.C. § 112, a “patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014). “The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, *e.g.*, competitors of the patent owner, can determine whether or not they infringe.” *All Dental Prodx, LLC v. Advantage Dental Prods., Inc.*, 309 F.3d 774, 779-80 (Fed. Cir. 2002) (citing *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 28-29 (1997)). Put another way, “[a] patent holder should know what he owns, and the public should know what he does not.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002).

The Asserted Claims are invalid as indefinite because they fail to inform those skilled in the art about the scope of the alleged invention with reasonable certainty. These invalidity contentions are based on Defendants’ understanding of Giken’s interpretation of the Asserted Claims as asserted in the infringement contentions. Because the determination of whether the claims are indefinite under 35 U.S.C. § 112, second paragraph, depends on the construction of the Asserted Claims—and no claim construction positions have been exchanged, no claim

construction order has been issued and no expert discovery has taken place—Defendants’ positions on indefiniteness are necessarily preliminary at this early stage of the case. Defendants reserve their right to amend or further revise these invalidity contentions based on further developments, including the Court’s claim construction opinion, and discovery in the case.

The Asserted Claims are also indefinite because the specifications of the Asserted Patents fail to disclose a specific structure for performing the functions recited in the Asserted Claims. These invalidity contentions are based on the Defendants’ understanding of Giken’s interpretation of the Asserted Claims as asserted in Giken’s infringement contentions. Because the determination of whether the claims are indefinite under 35 U.S.C. §§ 112, sixth paragraph and second paragraph, depends on the construction of the Asserted Claims—and no claim construction positions have been exchanged, no claim construction order has issued, and no expert discovery has taken place—Defendants’ positions on indefiniteness are necessarily preliminary at this early stage of the case. Defendants reserve their right to amend or further revise these invalidity contentions based on further developments, including the Court’s claim construction opinion, and discovery in the case.

When a phrase is recited in multiple claims, the first instance of that phrase being recited is indicated below; invalidity under § 112, second and sixth paragraphs, for indefiniteness applies to any, all, and each of claims where the phrase is recited, however.

1. The ’236 Patent

At least under Giken’s actual and/or apparent application of the claims, the asserted claims of the ’236 patent are invalid under 35 U.S.C. § 112(b) for indefiniteness because the specification and prosecution history of the ’236 patent would not inform those skilled in the art about the scope of the alleged invention with reasonable certainty. Further, the asserted claims of the ’236 patent are invalid for indefiniteness because the specification does not disclose adequate

corresponding structure, material, or acts for several claim terms reciting functional language subject to 35 U.S.C. § 112(f).

- “a first designator provided inside the television set and arranged to freely designate a desired address of the first type of outside counterpart to which the first information is sent” (’236 patent, claim 1);
- “a second designator provided inside the television set and arranged to automatically designate a predetermined address of the second type of outside counterpart to which the second information is sent” (’236 patent, claim 1).

2. The ’968 Patent

At least under Giken’s actual and/or apparent application of the claims, the asserted claims of the ’968 patent are invalid under 35 U.S.C. § 112(b) for indefiniteness because the specification and prosecution history of the ’968 patent would not inform those skilled in the art about the scope of the alleged invention with reasonable certainty. Further, the asserted claims of the ’968 patent are invalid for indefiniteness because the specification does not disclose adequate corresponding structure, material, or acts for several claim terms reciting functional language subject to 35 U.S.C. § 112(f).

- “commutatively connected,” (’968 patent, claims 1, 9);
- “a designation software controller configured to control the memory to keep the information in response to a termination of viewing the viewed part and control the processor to automatically designate the succeeding part of the digital moving image contents when the viewing starts again” (’968 patent, claim 1);
- “a step of controlling the keeping step to keep the information in response to a termination of viewing the viewed part and control the executing step to automatically designate the succeeding part of the digital moving image contents when the viewing starts again” (’968 patent, claim 5).

V. PATENT ELIGIBILITY (35 U.S.C. § 101)

Claims directed to an abstract idea that do not add an inventive concept are ineligible for patent protection. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 69-70 (2012); *Bilski v. Kappos*, 561

U.S. 593, 601-02 (2010). Determining whether the subject matter of a claim is patent-ineligible is a two-step process. *Alice*, 134 S. Ct at 2355; *Mayo*, 566 U.S. at 69-70. First, the Court must “determine whether the claims at issue are directed to a patent-ineligible concept” such as an abstract idea. *Alice*, 134 S. Ct. at 2355. Second, if the claims are directed to a patent-ineligible concept, the Court must “consider the elements of each claim both individually and as an ordered combination to determine whether the additional elements transform the nature of the claim into a patent eligible application.” *Id.* (internal quotations omitted).

Several principles help guide the analysis of whether the claims are directed to an abstract idea. First, “the abstract idea exception does not turn solely on whether the claimed invention comprises physical versus mental steps.” *In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157, 1161 (Fed. Cir. 2018). “It is well-settled that mere recitation of concrete, tangible components is insufficient to confer patent eligibility to an otherwise abstract idea.” *In re TLI Commc’ns LLC Pat. Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016). Second, implementation of an abstract concept using conventional generic computer components is insufficient to transform an abstract idea into a patent-eligible invention. *Prism Techs. LLC v. T-Mobile USA, Inc.*, 696 F. App’x 1014, 1016 (Fed. Cir. 2017).

Defendants’ contention that the Asserted Claims are invalid under 35 U.S.C. § 101 are made in the alternative, and do not constitute, and should not be interpreted as, admissions that any of the asserted claims are not anticipated or rendered obvious by any prior art.

The Asserted Claims, including as they appear to be construed by Giken, are invalid because they do not constitute patentable subject matter under 35 U.S.C. § 101. See, e.g., *Alice*, 134 S.Ct. 2347; *Bilski*, 130 S. Ct. 3218; *Diamond v. Diehr*, 450 U.S. 17 (1981); *Gottschalk v. Benson*, 409 U.S. 63 (1972); *In re Nuijten*, 500 F.3d 1346 (Fed. Cir. 2007).

Defendants incorporate here by reference their motion to dismiss the '968 Patent as unpatentable subject matter. (D.I. 13-14). Defendants also incorporate here by reference the bases of invalidity set forth in Apple Inc.'s motions to dismiss the '968 Patent as unpatentable subject matter (D.I. 11, 21) in *NL Giken Inc. v. Apple Inc.*, No. 1:24-cv-00013-MN (D. Del.).

The asserted claims of the '391 patent are invalid because they do not constitute patentable subject matter under 35 U.S.C. § 101. The asserted claims of the '391 patent are directed to an abstract idea—a system for offering video content in exchange for watching an advertisement and receiving payment from the sponsor of the advertisement. This abstract idea is similar to many found unpatentable by the Federal Circuit. *See, .e.g., Ultramercial Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (“The process of receiving copyrighted media, selecting an ad, offering the media in exchange for watching the selected ad, displaying the ad, allowing the consumer access to the media, and receiving payment from the sponsor of the ad all describe an abstract idea, devoid of a concrete or tangible application.”); *Smartflash LLC v. Apple Inc.*, 680 F. App'x 977, 984 (Fed. Cir. 2017) (holding ineligible “the abstract idea of conditioning and controlling access to data based on payment”).

That the claims are directed to systems comprised of various electronic components is not sufficient to confer eligibility. Indeed, the Federal Circuit has made clear that “after Alice, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (internal quotations and citations omitted). At least the following claim elements of the asserted claims of the '391 patent are merely directed to generic computer or similar electronic components (as shown in Defendants' invalidity contentions involving anticipation and/or obviousness in this case):

- “moving image viewing apparatuses” which Giken alleges include “laptops, phones, or other viewing devices,” (Ex. C-1 at 6);
- “moving image data delivery system” which Giken alleges includes general purpose computers and streaming software combined with various network servers (Ex. C-1 at 8);
- “storage” which Giken alleges may be RAM (Ex. C-1 at 9);
- “first controller” which Giken alleges may be a content delivery network server (Ex. C-1 at 11);
- “second controller” which Giken alleges to be a computer processor (Ex. C-1 at 17);
- “electric data” which Giken alleges to be a tracking pixel (Ex. C-1 at 14); and
- “advertising image data delivery system” which Giken inconsistently alleges at various times to be both the Amazon Ad server, *see, e.g.*, Ex C-1 at 17 and the “Twitch System,” *see, e.g.*, Ex. C-1 at 14.

This high-level, abstract idea of a system for offering video content in exchange for watching an advertisement and receiving payment from the sponsor of the advertisement fails to recite a non-abstract concept to confer eligibility.

Furthermore, under Alice Step 2 the asserted claims of the ’391 patent do not contain an inventive concept. The asserted claims employ well-understood, routine, and conventional concepts (as shown in Defendants’ invalidity contentions involving anticipation and/or obviousness in this case), which is not enough to impart patent eligibility of an abstract idea and as below. *See, e.g., Alice*, 134 S. Ct. at 2359 (holding that limitations describing “‘well-understood, routine, conventional activit[ies]’ previously known to the industry” were insufficient to supply an inventive concept (quoting *Mayo*, 132 S. Ct. at 1294)). At least the following claim elements are directed to well-understood, routine, and/or conventional concepts:

- Storing television programs for broadcast;
- Viewing television programs on, e.g., television sets;

- Advertisements playing during television viewing;
- Advertisers paying for advertisements to be played during television broadcasts; and
- Targeted advertising.

And as an ordered combination, nothing within the asserted claims of the '391 patent confer eligibility.

The asserted claims of the '592 patent are invalid because they do not constitute patentable subject matter under 35 U.S.C. § 101. The asserted claims of the '592 patent are directed to an abstract idea—receiving media content via two content providers via two separate communication mediums. This abstract idea is similar to many found unpatentable by the Federal Circuit. *See, .e.g., Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1337 (Fed. Cir. 2017) (“The claim requires the functional results of ‘converting,’ ‘routing,’ ‘controlling,’ ‘monitoring,’ and ‘accumulating records,’ but does not sufficiently describe how to achieve these results in a non-abstract way.”).

That the claims are directed to systems comprised of various electronic components is not sufficient to confer eligibility. Indeed, the Federal Circuit has made clear that “after Alice, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (internal quotations and citations omitted). At least the following claim elements of the asserted claims of the '592 patent are merely directed to generic computer or similar electronic components (as shown in Defendants' invalidity contentions involving anticipation and/or obviousness in this case):

- “remote controller;”
- “tuner;”

- “television display;”
- “memory;” and
- “TV set.”

This high-level, abstract idea of receiving media content via two content providers via two separate communication mediums fails to recite a non-abstract concept to confer eligibility.

Furthermore, under Alice Step 2 the asserted claims of the ’592 patent do not contain an inventive concept. The asserted claims employ well-understood, routine, and conventional concepts (as shown in Defendants’ invalidity contentions involving anticipation and/or obviousness in this case), which is not enough to impart patent eligibility of an abstract idea and as below. *See, e.g., Alice*, 134 S. Ct. at 2359 (holding that limitations describing “‘well-understood, routine, conventional activit[ies]’ previously known to the industry” were insufficient to supply an inventive concept (quoting *Mayo*, 132 S. Ct. at 1294)). At least the following claim elements are directed to well-understood, routine, and/or conventional concepts:

- Selecting a television channel;
- Over-the-air television program broadcasts;
- A television display that shows the content; and
- Memory that stores downloaded content.

And as an ordered combination, nothing within the asserted claims of the ’592 patent confer eligibility.

Defendants reserve the right to supplement these disclosures based on further investigation and discovery.

VI. PRIOR ART DOCUMENT PRODUCTION

Pursuant to Paragraph 6(d) of the Scheduling Order (Dkt. 32), Defendants have produced or made available for inspection known invalidating prior art references.

Dated: April 9, 2025

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CERTIFICATE OF SERVICE

I, Jeff Castellano, certify that on April 9, 2025, a copy of the foregoing document was served upon the following counsel of record via email.

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