

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC., AMAZON WEB SERVICES, INC., AND
AMAZON.COM SERVICES LLC,
Petitioner,

v.

B.S.D. CROWN, LTD.,
Patent Owner.

Case IPR2025-00057
U.S. Patent No. 8,934,887

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER’S EXHIBIT LIST

Exhibit No.	Description
2001	<i>B.S.D. Crown, Ltd. v. Amazon.com, Inc.</i> , Plaintiff’s Preliminary Claim Constructions, Case No. 3:24-CV-03503-JD (N.D. Cal. Jan. 10, 2025)
2002	<i>B.S.D. Crown, Ltd. v. Amazon.com, Inc.</i> , Defendants’ Preliminary Claim Constructions, Case No. 3:24-CV-03503-JD (N.D. Cal. Jan. 10, 2025)
2003	Comparison of Districts Within the Ninth Circuit — 12-Month Period Ending December 31, 2024 (available at https://www.uscourts.gov/sites/default/files/2025-02/fcms_na_distcomparison1231.2024.pdf)
2004	Patent Owner’s Power of Attorney
2005	<i>B.S.D. Crown, Ltd. v. Amazon.com, Inc.</i> , Defendants’ Invalidity Contentions, Case No. 3:24-CV-03503-JD (N.D. Cal. Dec. 9, 2024)
2006	<i>B.S.D. Crown, Ltd. v. Amazon.com, Inc.</i> , Case No. 3:24-CV-03503-JD, Scheduling Order

Pursuant to 37 C.F.R. § 42.107, Patent Owner B.S.D. Crown, Ltd. (“B.S.D. Crown” or “Patent Owner”) files this preliminary response to the Petition, setting forth reasons why the Petition for *inter partes* review (“IPR”) of claims 1-28 of U.S. Patent No. 8,934,887 (the “’887 patent”), as requested by Amazon.com, Inc., Amazon Web Services, Inc., and Amazon.com Services LLC (“Petitioner”), should be denied.¹

I. INTRODUCTION

The ’887 patent is directed to methods where a mobile device operating system (“OS”) executed at a server receives input information from one or more mobile devices, processes the information to produce a stream of user interface information, and sends the stream of user interface information to at least one mobile device. The mobile device receiving the stream of user interface information reproduces audio, display, and hardware action based on the received stream of user interface information. In some implementations of the method, the stream of user interface information may include a separate data stream for each different type of data. Also, in some implementations, the server may process input information from more than one mobile device at one instance of the mobile device OS executed at the server. Through these implementations, the ’887 patent

¹ By submitting this Preliminary Response, no waiver of any argument is intended by Patent Owner. Patent Owner will have a right to file a complete response to the Petition, should the Board institute *inter partes* review. 37 C.F.R. § 42.120(a).

discloses that the “mobile device acts as an input/output interface for a user, and actual processing, storage and network interfaces are performed by a remote server.” ’887 patent, 1:15-18.

The Petition presents eight challenges to the claims of the ’887 patent, divided generally into three groups based on Petitioner’s lead reference for each challenge. However, the Petition fails for at least two substantive reasons. First, Petitioner purports to apply plain and ordinary meaning to the claims, but incorrectly interprets the conjunctive group, “at least one of the display, the audio and the hardware (HW) action,” as a disjunctive list that only requires one of these three elements. According to Federal Circuit law, that interpretation is incorrect. A proper interpretation of this claim term requires the display, the audio, **and** the hardware action. Second, the Petition fails to identify any hardware action, such as game controller feedback or the like, in any asserted reference. As such, the Petition fails to establish this conjunctive list in any asserted reference or combination of references. Indeed, the appearance of the term “hardware action” in the Petition is substantially limited to Petitioner’s quotation of the challenged claims.

As an additional failure in the Petition, certain claims require that the stream of user interface information from the same instance of the mobile device OS comprises a plurality of different types of data, and the server sends each different

type of data to the mobile device in a separate data stream for reproduction on the mobile device of at least one of the display, audio and the HW action by the HW component. This feature is recited, for example, in claim 11. However, Petitioner's asserted art assigns data streams by application, and does not send each different type of data to the mobile device in a separate data stream. This failure applies to independent claim 11 for each asserted ground, and ensures that claim 11 has not been shown to be unpatentable.

Finally, the parallel litigation between Petitioner and Patent Owner is well-underway and scheduled to proceed to trial approximately two months *before* any final written decision would be expected to issue in this IPR. For the reasons set forth below, each *Fintiv* factor weighs in favor of the Board exercising its discretion to deny institution.

For these reasons, Petitioner's challenges fail.

II. THE '887 PATENT DISCLOSES AND CLAIMS PROCESSING AT A SERVER TO REPRODUCE, AT A MOBILE DEVICE, A DISPLAY ACTION, AN AUDIO ACTION, AND A HARDWARE (HW) ACTION

The '887 patent is entitled, "System and Method for Running Mobile Devices in the Cloud." The '887 patent discloses "decoupling mobile device HW [hardware] capabilities from actual mobile device performance and a user experience." '887 patent, 2:20-21. As introduced above, the '887 patent teaches methods where a mobile device operating system ("OS") executed at a server

receives input information from one or more mobile devices, processes the information to produce a stream of user interface information, and sends the stream of user interface information to at least one mobile device. The mobile device then reproduces audio, display, and hardware action based on the received stream of user interface information. In some implementations, the user interface information may include a separate stream for each different type of data. Additionally, the patent also describes the server may process input information from more than one mobile device at one instance of the mobile device OS executed at the server.

As such, the '887 Patent is directed to methods where a “mobile device acts as an input/output interface for a user, and actual processing, storage and network interfaces are performed by a remote server.” '887 patent, 1:15-18. This data architecture may result in some improvements, for example these methods may yield “minimal latency for all User interface related messages and DataStream encoding,” (*see* U.S. App. No. 61/653,819 at 11, Patent Disclosure dated 8 May 2012) such that a “[u]ser should not feel that its mobile device behaves differently with this solution.” U.S. App. No. 61/653,819 at 15; *see also* '887 patent, 9:47-52.

Consistent with the '887 patent's disclosure, independent claim 1 recites:

1. A method ... comprising:

receiving, by the server, input information from at least one mobile device, wherein the input information has not been processed ***to produce a display, audio and a hardware (HW) action*** by a HW component of the mobile device;

processing, by a mobile device operating system (OS) executed at the server, the input information to produce a stream of user interface information for use in reproducing at the mobile device ***at least one of the display, the audio and the hardware (HW) action*** by the HW component of the mobile device based on a same instance of the mobile device operating system; and

sending, by the server, the stream of user interface information to the mobile device to reproduce at the mobile device ***at least one of the display, the audio and the HW action*** by the HW component of the mobile device.

'887 patent, Claim 1 (emphasis added).

Claim 11 recites:

11. A method ... comprising:

receiving, by the server, input information from at least one mobile device;

processing, by a mobile device operating system (OS) executed at the server, the input information to produce a stream of user interface information for use in reproducing at the mobile device ***at least one of a display, audio and a hardware (HW) action*** by a

HW component of the mobile device based on a same instance of the mobile device OS; and

sending, by the server, the stream of user interface information to the mobile device, wherein the stream of user interface information from the same instance of the mobile device OS comprises a plurality of different types of data and the server sends *each different type of data* to the mobile device *in a separate data stream* for reproduction on the mobile device of *at least one of the display, audio and the HW action* by the HW component of the mobile device.

'887 patent, Claim 11 (emphasis added).

Claim 20 recites:

20. A method ... comprising:

receiving, by the server, input information from a plurality of different mobile devices, wherein the input information has not been processed *to produce a display, audio and a hardware (HW) action* by a corresponding HW component of the mobile devices;

processing, by a same instance of a mobile device operating system (OS) executed at the server, the input information from each of the plurality of different mobile devices to produce user interface information for use in reproducing at the different mobile devices *at least one of the display, audio and the HW action* by the HW components of the different mobile device based on the same instance of the mobile device OS; and

sending, by the server, the user interface information to at least one of the plurality of different mobile devices.

'887 patent, Claim 20 (emphasis added).

Claim 28 recites:

28. A method ... comprising:

receiving, by server, first input information from a mobile device;

processing, by a first mobile device operating system (OS) executed at the server, the first input information to produce a first stream of user interface information for use in reproducing at the mobile device *at least one of a display, audio and a hardware (HW) action* by a HW component of the mobile device; and

sending, by the server, the first stream of user interface information to the mobile device to reproduce on the mobile device *at least one of the display, audio and the HW action* by the HW component of the mobile device;

receiving, by the server, second input information from the mobile device;

processing, by a second mobile device operating system (OS) executed by the server, the second input information to produce a second stream of user interface information for reproducing *at least one of a display, audio and a HW action* by a HW component of the mobile device, wherein the second mobile device OS has at least one of a different OS type, a different OS version and a different OS instance than the first mobile device OS; and

sending, by the server, the second stream of user interface information to the mobile device to reproduce on the mobile device

at least one of the display, audio and the HW action by the HW component of the mobile device.

'887 patent, Claim 28 (emphasis added).

III. CLAIM CONSTRUCTION

Petitioner and Patent Owner have exchanged claim constructions for the term “at least one of the display, the audio, and the hardware (HW) action” in the parallel district court proceeding. Ex. 2001, Ex. 2002. Petitioner proposed a “[p]lain and ordinary meaning” construction for this term in district court (Ex. 2002, 6), and Patent Owner advocated for a conjunctive construction of the “at least one of ... and” term, proposing that this term be construed as “at least one of each of the display, the audio and the hardware (HW) action” (Ex. 2001, 16-17). Patent Owner's explicit recitation of the plain and ordinary meaning of the “at least one of ... and” construction is correct.

The plain and ordinary meaning of an “at least one of ... and” term is conjunctive, *see SuperGuide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 885-86 (Fed. Cir. 2004); *see also Medgraph, Inc. v. Medtronic, Inc.*, 843 F.3d 942, 949-50 (Fed. Cir. 2016) (applying conjunctive meaning to “and” where support “does not compel a disjunctive construction”).

Although the Petition states, “[n]o explicit construction is necessary ..., and the Petitioner applies the plain and ordinary meanings of the claim terms” (Pet., 5), the Petition has applied a disjunctive construction to the “at least one of ... and”

recitations in the independent claims. Specifically, as will be addressed below, each of Petitioner's grounds fails to establish that any reference provides the separately claimed "hardware action" aspect along with the other aspects of the claim.

The Board should apply a conjunctive construction to the "at least one of ... and" terms because the plain and ordinary meaning of the claim supports it, and rather than compelling a disjunctive construction, other claim language and the specification confirms that the conjunctive construction is correct.

Looking at the claims, they use "and" rather than "or," which indicates a conjunctive usage. Further, the antecedence for "at least one of the display, audio and the HW action" in claims 1 and 20 is "to produce a display, audio and a hardware (HW) action." In providing the antecedence, there is no "at least one of" and there is not any "or" or other disjunctive language, which confirms a conjunctive understanding of the "and" in the "at least one of ... and" term. Further support is found in claim 11, which refers to "each different type of data," which only makes sense if there is more than one type of data sent. Claim 28 applies the ordinary meaning, and there is no reason to treat this term differently in different claims.

The specification reinforces a conjunctive reading. It refers to hardware actions that are distinct from video and audio actions. *See, e.g., '887 patent,*

10:56-64 (“The mobile device 10 decodes and assembles the separate video, image and text data streams of the display data/user interface data into a display. The mobile device 10 enables different HW operations or actions according to requests from the [server] 12. For example, the mobile device 10 enables the camera and/or microphone in response to a request from the server 12. The mobile device 10 decodes the compressed audio of the user interface data and reproduces the audio at the speaker in coordination with the assembled display.”) (emphasis added); ’887 patent, 6:66-7:3 (“The mobile device 10 produces the display, speaker audio and/or a HW action of a hardware component (e.g., activates and/or controls a GPS and/or one or more sensors) based on the mirrored emulated user interface information.”) (emphasis added).

Accordingly, the terms “at least one of the display, the audio and the hardware (HW) action” should be construed as “at least one of each of the display, the audio and the hardware (HW) action,” which requires at least one display action, at least one audio action, **and** at least one hardware (HW) action consistent with the plain and ordinary meaning of its conjunctive form.

Without waiving its right to submit additional constructions in a Patent Owner Response, Patent Owner submits that the Board need not engage in any other pre-institution claim construction. For the substantive reasons presented in

Section IV below, Petitioner’s grounds include fundamental flaws and fail to establish the disclosure of every claimed element in each independent claim.

IV. PETITIONER’S CHALLENGES FAIL ON THE MERITS

Petitioner asserts eight grounds in their Petition. Grounds 1A, 1C, 2A, 2C, 3A, and 3B collectively apply to independent claims 1, 11, 20, and 28 and certain dependent claims. Grounds 1B and 2B apply only to dependent claims 4, 14, and 22.

Specifically, Ground 1A contends independent claims 1, 20, and 28, as well as dependent claims 2, 3, 5, and 21, are obvious under 35 U.S.C. § 103 in view of Yoon². Ground 1C contends independent claim 11, as well as dependent claims 6-8, 12, 13, 15-17, and 23-25 are obvious under 35 U.S.C. § 103 over Yoon in view of Lubonski³ and Richardson⁴.

Ground 2A contends independent claims 1, 20, and 28, as well as dependent claims 2, 3, 5, and 21, are obvious under 35 U.S.C. § 103 in view of Overton⁵.

Ground 2C contends independent claim 11, as well as dependent claims 6-8, 12,

² Ex. 1005, KR 2012/0046807 (“Yoon”).

³ Ex. 1008, M. Lubonski, V. Gay and A. Simmonds, “An adaptation architecture to improve user-perceived QoS of multimedia services for enterprise remote desktop protocols,” Next Generation Internet Networks, 2005, Rome, Italy, 2005, pp. 149-156 (“Lubonski”).

⁴ Ex. 1009, Richardson, Iain E., The H.264 Advanced Video Compression Standard (2nd ed.), 2010, Wiley Publishing (“Richardson”).

⁵ Ex. 1006, U.S. Patent 9,424,052 (“Overton”).

13, 15-17, and 23-25 are obvious under 35 U.S.C. § 103 over Overton in view of Lubonski and Richardson.

Ground 3A contends independent claims 1 and 20, as well as dependent claims 2, 3, 5, and 21, are obvious under 35 U.S.C. § 103 in view of Lu⁶. Ground 3B contends independent claim 11, as well as dependent claims 6-8, 12, 13, 15-17, and 23-25 are obvious under 35 U.S.C. § 103 over Lu in view of Lubonski and Richardson.

For completeness, Ground 1B challenges dependent claims 4, 14, and 22 as obvious under 35 U.S.C. § 103 over Yoon and Nix⁷, and Ground 2B challenges dependent claims 4, 14, and 22 as obvious under 35 U.S.C. § 103 over Overton and Nix.

Thus, Grounds 1A, 1C, 2A, 2C, 3A, and 3B are facially deficient in establishing the unpatentability of any challenged independent claim, and Grounds 1B and 2B do not remedy the deficiencies of Grounds 1A or 2A, respectively. For the reasons discussed below, the Petition should be denied without institution.

⁶ Ex. 1007, U.S. Published Patent Application 2009/0305790 (“Lu”).

⁷ Ex. 1010, U.S. Patent Application Publication No. 2006/0098619 A1 (“Nix”).

A. All Claims: Petitioner Has Not Established the “Hardware (HW) Action” Requirements of Claims 1, 11, 20, or 28 In Grounds 1A, 1C, 2A, 2C, 3A, and 3B

Throughout the Petition, Petitioner incorrectly interprets and addresses the phrase “at least one of the display, the audio and the hardware (HW) action” in claim 1 (and similar phrases in claims 11, 20, and 28) in the disjunctive, interpreting “at least one of ... and” as an “or” to merely require a display action, an audio action, *or* a hardware action. For example, in the Petition at page 3, Petitioner asserts “the Applicant amended independent claims 20, 30, and 47 (issued as claims 1, 11, and 20, respectively) to recite that the server produces ‘a stream of user interface information’ for use in reproducing *a display, audio, or HW action* ‘at the mobile device,’” citing pages 182-190 of Ex. 1002. But those pages of the ’887 patent’s file history merely show marked-up claim language and do not indicate a disjunctive “or” for the claim language—that is indicative of Petitioner’s mistaken interpretation.

In fact, in each of the Grounds, Petitioner skips over the “hardware (HW) action” aspect of the claims and only attempts to address whether the reference has audio or video actions. For example, in Ground 1A based on Yoon for the element 1[c], which recites “at least one of the display, the audio and the HW action,” Petitioner contends “Yoon discloses that the virtualization server transmits ... the stream of *video and sound* ... to the terminal The terminal then *displays*

images and plays sounds received from the virtualization server” Pet., 11-12 (emphasis added). The only mention of “the HW action” to be found in Petitioner’s analysis of element 1[c] is in Petitioner’s quotation of the claim language. Pet., 12 (citing Martin, ¶86). Petitioner’s expert similarly fails to address “the HW action” as a conjunctive aspect of element 1[c]. Ex. 1003, ¶86 (“displays images and plays sounds received from the virtualization server”).

Even more troubling, for element 1[b], which recites “at least one of the display, the audio and the hardware (HW) action,” Petitioner ignores the requirement for “the hardware (HW) action” entirely—the Petition does not even quote the claim language. Pet., 9-11. Similarly for element 1[c], only an “image” and a “sound” are mentioned in the analysis for element 1[b]. Pet., 10 (“the virtualization server 110 generates an execution screen *image* of the running mobile OS and/or application’ as well as ‘a *sound* generated by the running mobile OS and/or application,’ and both are transmitted in a stream to the terminal” (emphasis added) (citing Yoon, 14-15).

Thus, the Petitioner’s analysis does not even mention any “hardware (HW) action” for elements 1[b] and 1[c] in Ground 1A, despite this feature being required by claim 1. Ground 1A therefore fails against claim 1.

Ground 1A also relies on its deficient analysis of the conjunctive elements found in elements 1[b] and 1[c] for elements 20[b], 28[b], 28[c], 28[e], and 28[f].

See Pet. 15 [element 20[b]] (citing “Section VII.A.2.c”); Pet. 16 [element 28[b]] (citing “Section VII.A.2.c”); Pet. 17 [element 28[c]] (citing “Section VII.A.2.d”); Pet. 19 [element 28[e]] (citing “Section VII.A.2.c”); Pet. 19 [element 28[f]] (citing “Section VII.A.2.d”). Thus, Ground 1A fails in its challenge against claims 20 and 28 as well. Petitioner has therefore failed to establish that claims 1, 20, and 28, and all the claims that depend therefrom, are unpatentable in Ground 1A. Ground 1B also fails for this same reason.

Ground 1C challenges independent claim 11, but Petitioner again relies on its deficient analysis of the conjunctive elements found in elements 1[b] and 1[c] for elements 11[b] and 11[c]. Pet., 34 (citing “Section VII.A.2.c” and “Section VII.A.2.d”). Because Ground 1A fails against claim 1, Ground 1C also fails against claim 11 for at least the same reasons.

Ground 2A based on Overton presents a similar deficiency. For elements 1[b] and 1[c], Petitioner and its expert again focus on audio and video disclosures in Overton, without addressing the element’s conjunctive hardware action requirement. Pet. 42 (“The client device then *renders the video* on display 139 ... and *plays the audio*”) (emphasis added); Ex. 1003, ¶160 (same); Pet., 44 (“The client device receives the media stream and renders *video and audio* from the stream on the device”) (emphasis added); Ex. 1003, ¶162 (same). Once again, the Petitioner’s analysis does not even mention any “hardware (HW) action” for

elements 1[b] and 1[c], despite this feature being required by claim 1. Ground 2A therefore fails against claim 1.

Ground 2A also relies on its deficient analysis of the conjunctive elements found in elements 1[b] and 1[c] when addressing elements 20[b], 28[b], 28[c], 28[e], and 28[f]. *See* Pet. 47 [element 20[b]] (citing “Section VII.D.2.c”); Pet. 48 [element 28[b]] (citing “Section VII.D.2.c”); Pet. 51 [element 28[c]] (citing “Section VII.D.2.d”); Pet. 52 [element 28[e]] (citing “Section VII.D.2.c”); Pet. 52 [element 28[f]] (citing “Section VII.D.2.d”). Thus, Ground 2A fails in its challenge against claims 20 and 28 as well. Petitioner has therefore failed to establish that claims 1, 20, and 28, and all the claims that depend therefrom, are unpatentable in Ground 2A. Ground 2B also fails for this same reason.

Ground 2C challenges independent claim 11, but Petitioner again relies on its deficient analysis of the conjunctive elements found in elements 1[b] and 1[c] for elements 11[b] and 11[c]. Pet., 64 (citing “Section VII.D.2.c” and “Section VII.D.2.d”). Thus, Ground 2C completely fails for at least this same reason.

Finally, Ground 3A based on Lu also fails to address the conjunctive hardware aspects of elements 1[b] and 1[c]. Petitioner’s conclusory analysis begins with merely mentioning a “media stream” without any mention of audio or hardware actions. Pet., 70 (alleging that Lu will “... ‘display the frames on an attached display device.’” Lu, ¶61. Lu thus discloses the media stream is used in

[claim 1]”); Ex. 1003, ¶230 (same). Then, Petitioner asserts an obviousness-based analysis to include audio actions in Lu’s system Pet., 71-72 (“a POSITA would have understood (or at least found it obvious) Lu also renders audio associated with game play and to include that audio in the media stream from the game appliance apparatus to the client system” or “a POSITA would have been motivated to configure Lu to perform audio processing”). Nowhere in Petitioner’s theory is the conjunctive hardware action aspect of the claim element 1[b] addressed. Ground 3A’s analysis of element 1[c] contains even less detail, quoting only Lu’s video display action. Pet., 72-73 (“display[s] the frames on an attached display device”).

Ground 3A relies on its deficient analysis of the conjunctive elements found in elements 1[b] and 1[c] for element 20[b]. *See* Pet. 75 [element 20[b]] (citing “Section VII.G.2.c”). Thus, Ground 3A completely fails in its challenge of independent claims 1 and 20, and all the claims that depend therefrom.

Ground 3B challenges independent claim 11, but Petitioner again relies on its deficient analysis of the conjunctive elements found in elements 1[b] and 1[c] for elements 11[b] and 11[c]. Pet., 81 (citing “Section VII.G.2.c” and “Section VII.G.2.d”). Thus, Ground 3B completely fails for at least the same reasons.

As all Grounds presented in the Petition fail, no inter partes review should be conducted. Petitioner simply did not meet its burden of proof.

B. Claim 11: Petitioner Has Not Established That It Would Have Been Obvious to Modify the Primary References to Provide a Server That “Sends Each Different Type of [User Interface] Data to the Mobile Device in a Separate Data Stream” “From the Same Instance of the Mobile Device OS”

Compounding the deficiencies noted above, Grounds 1C, 3C, and 3B have additional shortcomings. In Grounds 1C, 2C, and 3B, Petitioner proposes to modify each of its primary references to Yoon, Overton, and Lu, respectively, based on the teachings of Lubonski and Richardson. Like the primary references, neither Lubonski nor Richardson discloses sending, from the same instance of a mobile device OS, each different type of data to the mobile device in a separate data stream, as claimed.

The logic of Petitioner’s theory for each of Grounds 1C, 2C, and 3B is that a POSITA would have added Lubonski’s user-perceived Quality of Service (QoS) (or Quality of Experience (QoE)) “server extension” in conjunction with each primary reference’s transmission of a media stream to a mobile terminal, and would have looked to Richardson to know that a video stream, such as H.264, could transmit video and audio using Real Time Protocol (RTP). *See, e.g.,* Pet., 30 (“A POSITA would have therefore been motivated to use RTP (as taught by Richardson) as the protocol for H.264 multimedia transport between Yoon’s virtualization server—with Lubonski’s extension for improving user-perceived QoS—and Yoon’s terminals.”); Pet., 60 (“A POSITA would have thus been

motivated to use RTP, as suggested by Overton and taught by Richardson, as the protocol for multimedia transport between Overton's computing device 103, with Lubonski's component for improving user user-perceived QoS, and Overton's client device(s)."); Pet., 76 ("A POSITA would have been motivated to improve user-perceived QoS for media transmitted from Lu's game appliance apparatus within the game appliance system (*the server*) to client systems by implementing the teachings of Lubonski's server extension and Richardson's use of RTP for transmitting H.264 data.").

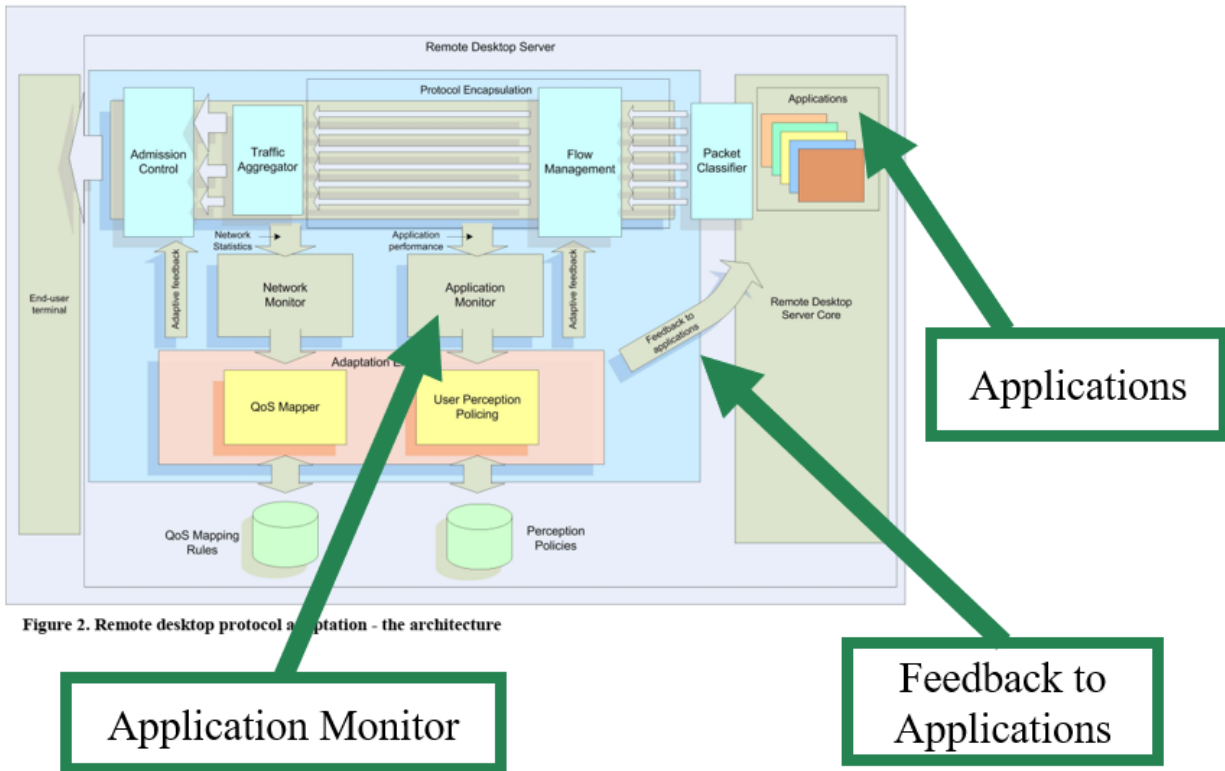
Addressing Yoon first, the Petition notes that Yoon encodes a "plurality of virtual environment images into a specific video format such as H.264 and may transmit the same to the terminal 150 in real time" and a "plurality of time-based sounds into a specific video format such as H.264 and may transmit the same to the terminal 150 in real time." Pet., 28 (citing Yoon, 15). The Petition asserts that a POSITA would look to Lubonski to improve user-perceived QoS in Yoon. Pet., 28. The Petition then asserts that "[t]o implement Lubonski's extension in Yoon's server, a POSITA would also have needed to understand how multimedia data is transported so that Lubonski's Packet Classifier could correctly distinguish between media types." Pet., 29. The Petition relies on Richardson to disclose "H.264 transmitted with RTP," where "each data packet includes a type identifier." Pet., 29. With that background, the Petition asserts a "POSITA would have

understood Lubonski's Packet Classifier would use this type identifier to distinguish between, e.g., video and audio flows." Pet., 29-30.⁸

The flaw in Petitioner's logic in each Ground is that Lubonski's Packet Classifier does not provide separate data streams for each different type of user interface data sent to a mobile device. Instead, Lubonski's Packet Classifier provides data flows based on *application type*, and *not* by the type of user interface data. In other words, like H.264 transmitted with RTP, an RTP stream originating from an application in Lubonski may have video and audio data within the RTP stream, and Lubonski would classify that RTP stream as a *single data flow* originating from the source application.

Lubonski repeatedly explains how its "server extension" is based on application-based performance and application-based data flows. For example, Figure 2 of Lubonski provides "the architecture" of its "[r]emote desktop protocol adaptation." As annotated below, the application-based focus of Lubonski is evident from Figure 2:

⁸ Petitioner's treatment of Overton and Lu follow similar logic as Petitioner employs with regard to Yoon. *See, e.g.*, Pet. 59-60 (Overton); Pet., 77-78 (Lu).



As explained in Lubonski, “[t]he architectural elements can be categorized into two main groups depending on the scope of the adaptation mechanisms they implement (see Figure 2)” and one of those groups is “[p]er application flow adaptation.” Lubonski, 154, col. 2 (emphasis added). The QoS mapping rules database, one of the two main databases in Lubonski, stores “mapping rules between network QoS parameters and *application level QoS*.” Lubonski, 155, col. 1 (emphasis added). Consistent with these disclosures, Lubonski’s data flows are provided per application. Lubonski explains, “[t]o perform per-flow operations there has to be means to distinguish between flows. In one of the possible implementations the traffic shaping mechanism could use information provided by

Packet Classifier – responsible for the classification and *marking of each application data flow* - to reflect its traffic characteristics and user-perceived QoS requirements.” Lubonski, 155, col. 2.

Moreover, Lubonski's abstract explains “[t]he set of perception rules defined *for each application* and type of user triggers the adaptation mechanisms to change the transmission parameters in order to meet end user expectations” Lubonski, 149 (Abstract) (emphasis added). And Lubonski says, “[i]n our approach, the data flows of different characteristics - corresponding to *different types of applications or services* - within one client connection are being dynamically shaped to the current network conditions and user-perceived performance of remote *applications and services*.” Lubonski, 150, col. 1 (emphasis added). Similarly, “we design our component in such a way that it is able to manage *multiple flows* with different requirements *depending on the type of application/group of applications* they are associated with.” Lubonski, 153, col. 1 (emphasis added). Lubonski even notes how the application-based user model is a core of its approach. Lubonski, 153, col. 2 (“The user model for *each application* is a core element of our approach.”) (emphasis added); *see also* Lubonski, 153, col. 2 (“User model is expressed terms of a mapping between *application-level* and network QoS parameters.”) (emphasis added). Lubonski touts that “[t]he strength of our approach lies in the mapping between the

application-level (e.g.: video frame rate, frames dropped, etc.) and the network-level QoS parameters (e.g.: jitter, delay, packet loss, etc.).” Lubonski, 155, col. 2 (emphasis added).

Although Lubonski is replete with explanations of how its flows are classified per application, Petitioner and its expert only glancingly mention “application data flows” in Lubonski, and without ever fully recognizing that Lubonski uses its packet classifier on a per application basis. For example, Petitioner admits “Lubonski teaches a ‘Packet Classifier – responsible for the classification and marking of each application data flow – to reflect its traffic characteristics and user-perceived QoS requirements,’” Pet., 26 (quoting Lubonski, 155), and leaps from that disclosure to the inference that “a POSITA would also have needed to understand how multimedia data is transported so that Lubonski’s Packet Classifier could correctly distinguish between media types.” Pet., 29. But Lubonski does not have flows distinguished between media types, it has flows distinguished by application. And Lubonski expressly tells a POSITA that, in its system, it needs “to be aware” of “application level information,” not the internal makeup of an application’s data flow. Lubonski, 153, col. 2 (“To do so it has to be aware of the application level information such as user session, user type if there is user service differentiation”). Thus, whether a single flow from an application

consists of different media types within that flow does not mean Lubonski provides separate data flows for each different media type.

As another oversight, Petitioner admits that “Lubonski’s server extension comprises a Packet Classifier that classifies and marks each application data flow” (Pet., 78 (citing Lubonski, 155, Fig. 2)), but then jumps to the conclusion that “[b]ecause Lu discloses sending the media stream to the client system via RTP (which includes a type identifier with each packet), Lubonski’s Packet Classifier would classify video and audio packets differently and separate them into different data flows so that user-perceived QoS of each data flow could be adjusted separately” Pet., 78 (citing Martin, ¶253). Petitioner’s expert at ¶253 does not provide any additional analysis, rather he merely parrots the Petition. What is missing from this analysis is a link between classifying an application’s single data flow according to Lubonski and providing separate data flows for each type of user interface data, as required by the claims. In other words, even assuming a POSITA would look to Lubonski and Richardson as contemplated in the Petition, the end result would be RTP packet identifiers that identify a single data flow corresponding to an application, but not identify a type of user interface data or sending “each different type of data to the mobile device in a separate data stream” as required by claim 11. The proposed combination of references also fails to

disclose the corresponding features of dependent claims 6-8, 12, 13, 15-17, and 23-25.

Accordingly, Grounds 1C, 2C, and 3B fail to demonstrate the unpatentability of independent claim 11 of the '887 patent, as well as dependent claims 6-8, 12, 13, and 15-17, and 23-25.

C. Claim 14: Petitioner Challenges Dependent Claim 14 Without Asserting a Corresponding Challenge Against Independent Claim 11

Dependent claim 14 depends from independent claim 11. Petitioner challenges claim 14 in Ground 1B, which proposes to combine Yoon and Nix. However, Petition does not present any challenge against independent claim 11 based on Yoon alone in Ground 1A, or Yoon in combination with Nix in Ground 1B. Similarly, Petitioner challenges claim 14 in Ground 2B, which proposes to combine Overton and Nix. However, Petition does not present any challenge against independent claim 11 based on Overton alone in Ground 2A, or Overton in combination with Nix in Ground 2B. Petitioner's challenge of claim 14 is facially deficient for this reason as well, along with claim 14 being patentable over these challenges in view of its dependence on claim 11 for the reasons stated in Section IV.A.

V. The Board Should Deny Institution Under *Fintiv*

Notwithstanding the substantive defects of the Petition, the Board can and should deny the Petition by exercising its discretion under 35 U.S.C. § 314(a) because the correct balance of relative factors weighs in favor of denial.

When evaluating whether to deny a petition under Board discretion, the Board balances six factors:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the Petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020).

“These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* In evaluating these factors, the Board takes “a holistic

view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*⁹

A proper balance of the *Fintiv* factors warrants denial of institution.

A. Factor 1 Favors Denial (Likelihood of Stay)

Factor 1—which considers whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted—favors denial of institution.

Petitioner has not moved for a stay of the district court litigation, and in the months after its Petition was filed, Petitioner has not requested a stay or that the trial date be adjusted, despite its “intent” to do so. Pet., 82. Under these circumstances, Factor 1 favors denial of institution or remains neutral.

B. Factor 2 Favors Denial (Timing of Trial)

Fintiv factor 2 weighs in favor of denying institution because the district court is set to commence trial on April 6, 2026, two months before the Board’s final decision would be expected to be due, on or about June 10, 2026. *See* Ex. 2006, 2 (District Court Scheduling Order). “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor

⁹ On February 28, 2025, the USPTO rescinded the “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (“Interim *Fintiv* Procedure”) dated June 21, 2022. The Interim *Fintiv* Procedure no longer applies to the *Fintiv* analysis.

of exercising authority to deny institution under *NHK*.” *Fintiv*, IPR2020-00019, Paper 11 at 9.

This timeline undisputedly favors denial. Indeed, the Board has previously held that a trial date which precedes a final written decision deadline by months favors discretionary denial. *See, e.g., Samsung Elecs. Co., Ltd. v. Mojo Mobility Inc.*, IPR2023-01092, Paper 11 at 11 (PTAB Jan 8, 2024) (denying institution, finding that a trial date “about five months before the projected statutory deadline” favored discretion to deny); *Bentley Motors Ltd., Jaguar Land Rover Ltd.*, IPR2019-01539, Paper 9 at 14 (PTAB Mar. 10, 2020) (denying institution where trial was set to occur five months before final written decision); *Immersion Sys. LLC v. Midas Green Techs., LLC*, PGR2021-00104, Paper 15 at 11 (PTAB Jan. 31, 2022) (jury trial starting four months ahead of final written decision favored discretionary denial); *see also NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18 at 8-9 (PTAB May 2, 2022) (two-month period between trial date and deadline for final decision weighed in favor of discretionary denial); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 at 6-9 (PTAB May 15, 2019) (one-month period between trial date and deadline for final written decision weighed in favor of discretionary denial); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12-13 (PTAB May 13, 2020) (second factor favors denial when “the currently scheduled District Court trial is scheduled to begin two months before our deadline

to reach a final decision”); *eClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (favoring denial where beginning of jury trial was “roughly one to two months” before final decision was due).

Additionally, Petitioner submitted what it contended were the “latest” Federal Court Management Statistics based on the now-rescinded June 21, 2022, USPTO Interim *Fintiv* Procedure. Ex. 1014. Petitioner’s Ex. 1014 should not be used to question the district court’s assessment of the trial date for this matter, not only because the USPTO has since rescinded the Interim *Fintiv* Procedure, but also because Ex. 1014 does not reflect the latest statistics. Federal Court Management Statistics are issued quarterly, and Petitioner’s submission included statistics until only June 2024 (which showed a time from filing to trial of 48.9 months for that period). The December 2024 statistics (Ex. 2003) show a median time-to-trial period of 34.5 months for the Northern District of California, placing the date much closer to the date set by the district court. As the evidence shows a downward trend in the time-to-trial dates from the older statistics cited by Petitioner and the more recent statistics, a reasonable inference would be that the district court judge accounted for that trend in setting the trial date of April 6, 2026.

Accordingly, *Fintiv* Factor 2 weighs significantly in favor of denial.

C. Factor 3 Favors Denial (Investment in Parallel Proceedings)

Factor 3 also weighs in favor of denial because the district court and both Patent Owner and Petitioner will have expended considerable resources in the parallel litigation by the time the Board issues an institution decision, expected by June 10, 2025. For factor 3, the Board considers “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, IPR2020-00019, Paper 11 at 9. “This investment factor is related to the trial date factor, in that more work completed by the parties and the court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Id.*, 10.

Here, the current and projected investment is significant.

The parallel district court contention period has *already* closed. *See Sand Revolution II, LLC v. Cont'l Intermodal Grp.*, IPR2019-01393, Paper 24 at 10 (PTAB June 16, 2020) (considering the parties' investment in contentions for this factor). For example, Patent Owner served infringement contentions on Petitioner on October 15, 2024. Petitioner served invalidity contentions on December 9, 2024. Moreover, Patent Owner served damages contentions on Petitioner on January 21, 2025, and Petitioner responded on February 18, 2025. Thus, the issues of infringement, validity, and damages have been distilled for trial.

Extensive work pertaining to claim construction, too, will have been completed before a decision on whether to institute this IPR. The parties have already exchanged preliminary claim constructions (January 10, 2025), and filed with the district court a Joint Claim Construction Statement (January 29, 2025). Claim construction discovery closes on March 17, 2025. Claim construction briefing opens on April 4, 2025, followed by in-person technical tutorials on May 22, 2025. These activities all culminate in the claim construction hearing on May 29, 2025.

Even fact discovery will be completed (June 20, 2025) around the time the Board is expected to reach an institution decision in this IPR. This effort includes laborious document collection and review, extensive interrogatory practice, fact witness depositions that involve persons located in the middle east, and wide-ranging third-party activities (e.g., document and testimonial subpoenas).

It is also noteworthy that Petitioner raises validity challenges in the district court based not only on prior art, but also on patent ineligibility, lack of enablement, lack of written description, and indefiniteness. *See* Ex. 2005, 23-30 (patent ineligibility), 30-31 (enablement), 31-32 (written description), 33-34 (§112 ¶2). Thus, the district court will be in the best position to resolve all of the validity issues relating to the '887 patent. Considering the timing of the litigation and the

relative status of this IPR, efficiency is favored in the forum that can address all of the validity issues at the same time.

Finally, as noted in factor 2, the Court's Scheduling Order requires dispositive motions on issues such as (in)validity to be filed by November 13, 2025. *See* Ex. 2006 (setting the deadline for dispositive motions). Should the Board institute, the Parties will effectively duplicate the efforts expended in the District Court to address the validity of the '887 Patent.

These investments by the district court and the parties in the district court proceeding favor denial.

D. Factor 4 Favors Denial (Overlap of Issues)

Factor 4 also weighs in favor of discretionary denial because there is substantial overlap between the claims, arguments, and evidence raised in the Petition and in Petitioner's invalidity contentions in the parallel district court proceeding.

For example, in this proceeding, Petitioner's Ground 1 challenges are based on Yoon alone or in view of Nix, Lubonski, and Richardson (Pet., 2) whereas, in district court, Petitioner included a claim chart for "Yun,"¹⁰ alone or in combination

¹⁰ The Petition refers to the inventor of KR 2012/0046807 as "Yoon" (Pet., 1) and the invalidity contentions refer to the inventor of KR 2012/0046807 as "Yun" (Ex. 2005, 5).

with Richardson, Lubonski, Rinne, and/or the knowledge of a person or ordinary skill in the art.” Ex. 2005, 23. Similarly, Petitioner’s Ground 2 challenges are based on Overton alone or in view of Nix, Lubonski, and Richardson (Pet., 2) whereas, in district court, Petitioner included a claim chart for “Overton, alone or in combination with Richardson, Lubonski, Rinne, and/or the knowledge of a person or ordinary skill in the art.” Ex. 2005, 22. Petitioner’s Grounds 1B and 1C rely on Nix as a secondary reference, and Petitioner’s invalidity contentions also identify Nix as a prior art reference. Ex. 2005, 5. Additionally, Petitioner’s Ground 3 challenges are based on Lu alone or in view of Lubonski and Richardson (Pet., 2) whereas, in district court, Petitioner included a claim chart for “Lu, alone or in combination with Richardson, Lubonski, Rinne, and/or the knowledge of a person or ordinary skill in the art.” Ex. 2005, 23.

Therefore, Petitioner’s common prior art challenges to the claims renders the “overlap in issues between the two proceedings [] substantial.” *Code200, UAB v. Luminate Networks, Ltd.*, IPR2020-01506, Paper 10 at 11-12 (PTAB Feb. 16, 2021).

Moreover, Petitioner has not offered a *Sotera* stipulation. *Inter Partes* Review is intended to be a “quick and cost effective alternative[] to litigation,” not an avenue for Petitioner to argue invalidity a second time in a second venue. *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1317 (Fed. Cir.

2018) (quoting H. Rep. No. 112-98, at 40, 48 (2011)). Indeed, Petitioner's failure to offer a *Sotera* stipulation, despite the substantial overlap between the proceedings, only highlights the concerns of duplicative efforts and conflicting outcomes raised by *Fintiv*.

Moreover, Petitioner's assertion in district court of *additional* prior art and *additional* combinations of art than those asserted here (Ex. 2005, 4-23) does nothing to alter the degree of overlap between the Petition and its invalidity contentions. *See, e.g., Fintiv*, IPR2020-00019, Paper 15 at 15 (finding Petitioner's assertion of additional invalidity contentions "not relevant to the question of the degree of overlap for this factor").

In any event, even when there is not a perfect alignment between the claims in IPR and litigation, the Board has repeatedly ruled that the assertion of additional claims does nothing to mitigate "substantial" overlap in issues between the two proceedings where common prior art is presented and common independent claims are challenged. *See, e.g., Code200, UAB*, IPR2020-01506, Paper 10 at 11-12 ("In light of the common prior art asserted here and in the [] district court case, as well as the common challenge to the sole independent claim and all but two of the dependent claims of the ['384] patent, we agree with the Patent Owner that the overlap in issues between the two proceedings is substantial."); *see also Teso LT UAB v. Luminati Networks Ltd.*, IPR2021-00122, Paper 12 at 10 (PTAB Apr. 20,

2021) (denial of institution favored where Petition’s prior art references were all identified in the district court invalidity contentions, the same independent claims were challenged in both proceedings, and “the *additional* claims challenged in the Petition are all dependent claims”).

Therefore, with this substantial overlap between the Petition and the parallel proceeding, there are particularly strong “concerns of inefficiency and the possibility of conflicting decisions” if the IPR is instituted. *See, e.g., Fintiv*, IPR2020-00019, Paper 11 at 12 (finding “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong” where there is substantial overlap).

Accordingly, factor 4 weighs strongly in favor of denial of institution. *See Teso LT UAB*, IPR2021-00122, Paper 12 at 10 (finding “the overlap in issues between the two proceedings is substantial” where common art and common challenges to the independent claim were presented in both proceedings); *see also eClinicalWorks*, IPR2022-00229, Paper 10 at 12 (finding factor 4 weighed in favor of denial where Preliminary Invalidity Contentions showed overlap of asserted claims, art and arguments asserted in the Petition); *U.S. Venture, Inc. v. Sunoco Partners Mktg. & Terminals L.P.*, IPR2020-00728, Paper 10 at 12-14 (PTAB Oct. 1, 2020) (finding overlap between primary references asserted in Petition and litigation weighed in favor of denial).

For each of these reasons, factor 4 strongly favors discretionary denial.

E. Factor 5 Favors Denial (Overlapping Parties)

Patent Owner is the plaintiff and Petitioner is involved in the parallel litigation, and “because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Samsung Elecs. Co. v. Clear Imaging Research, LLC*, IPR2020-01401, Paper 12 at 21-22 (PTAB Feb. 17, 2021) (quoting *Fintiv*, IPR2020-00019, Paper 15 at 15). Petitioner incorrectly contends that Factor 5 favors institution, mistakenly asserting the “FWD is expected before trial, such that estoppel will apply under 35 U.S.C. 315(e).” Putting aside Petitioner’s novel position concerning how estoppel would relate to this factor, the Final Written Decision in this case would be expected after the district court trial. The district court trial is scheduled to begin on April 29, 2026, prior to the expected date of June 10, 2026 for any Final Written Decision. Factor 5 weighs strongly in favor of denial.

F. Factor 6 Favors Denial (Other Factors)

Additional factors weigh in favor of denial.

The district court can resolve more disputed issues than the limited nature of IPR proceedings, which can only address a limited set of validity challenges. While IPR proceedings were once thought to be vehicles to settle validity questions concerning a patent, history has informed that IPR proceedings often

only address some validity issues, leaving others for the district courts to deal with. When a patent survives an IPR, it adds complexity to the proceeding as the district court must then weigh questions of the scope of IPR estoppel. *See, e.g., EIS Inc. v. IntiHealth Ger GmbH*, 2023 WL 6797905, 19-1227-GBW (D. Del. Aug. 30, 2023) (addressing scope of IPR estoppel). And for other validity issues beyond the reach of IPRs, like the 35 U.S.C. § 101 and § 112 issues referenced in Petitioner's district court invalidity contentions (Ex. 2005, 23-34), the IPR proceeding will be of limited use.

Moreover, the merits of this Petition are weak as explained in Section IV. Far from presenting "a compelling unpatentability challenge," *see Fintiv*, IPR2020-00019, Paper 11 at 13-14, the flaws in Petition are numerous. *See CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 24 (PTAB Mar. 17, 2023) ("to find compelling merits, the Board must provide reasoning to explain and support its determination as to compelling merits sufficient to allow the parties to challenge that finding and sufficient to allow for review of that decision.").

In such circumstances, the Board has found that it "need not decide whether the merits of Petitioner's asserted grounds are particularly strong because it would not impact [the] ultimate determination under Section 314(a)" and "the merits do not outweigh the other *Fintiv* factors." *NXP USA*, PGR2022-00005, Paper 18 at 12-13 (finding that where factor 1 was neutral and factors 2-5 favored or slightly

avored denial, factor 6 was neutral because it “would not impact [the] ultimate determination”); *Samsung Elecs.*, IPR2020-01401, Paper 12 at 23-25 (finding that where factors 1 and 4 slightly favored denial, factors 2 and 3 strongly favored denial, and factor 5 weighed in favor of denial, those factors outweighed any merits of the case considered in factor 6); *Apcon, Inc. v. Gigamon Inc.*, IPR2020-01579, Paper 9 at 26 (PTAB Mar. 16, 2021) (finding that the merits of the petitioner’s grounds do not outweigh the other factors in light of the strength of factors 2); *see also Fintiv*, IPR2020-00019, Paper 11 at 15 (“if the merits of the grounds raised in the petition are a close[] call, then that fact has favored denying institution when other factors favoring denial are present”).

Accordingly, for the reasons stated above, including Factor 6 and each of the remaining *Fintiv* factors, these factors weigh in favor of the Board exercising its discretion to deny institution.

VI. CONCLUSION

For the reasons presented above, the Petition should be denied, and no *inter partes* review should be instituted.

IPR2025-00057 Patent Owner's Preliminary Response

Dated: March 10, 2025

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CERTIFICATE OF WORD COUNT

The undersigned certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE complies with the type-volume limitation in 37 C.F.R. § 42.24(b)(1). According to the word-processing system's word count, the brief contains 8,509 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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CERTIFICATE OF SERVICE

Petitioner has consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on March 10, 2025, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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