

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL ELECTRONICS HOLDINGS LTD.
(f/k/a TCL MULTIMEDIA TECHNOLOGY HOLDINGS, LTD.)

Petitioner,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2025-00120

U.S. Patent No. 10,375,341

**PATENT OWNER PRELIMINARY RESPONSE TO PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 10,375,341**

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	'895 Application File History
2002	Claim Construction Order
2003	Docket Control Order
2004	First Amended Docket Control Order
2005	Invalidity Contentions
2006	Robbins (U.S. Patent Publication No. 2010/0157978)
2007	U.S. Patent No. 9,924,124

LISTING OF CHALLENGED CLAIMS¹

Claim Element	Claim Text
Claim 1 Preamble	A video display apparatus comprising:
[1A]	a display unit that displays a video content from a broadcast station or from a video content delivery source;
[1B]	a communication unit that executes two types of bi-directional wireless communication including first bi-directional wireless communication with a first wireless control device without going via a router and second bi-directional wireless communication via a router with a second wireless control device that is different from the first wireless control device;
[1C]	an infrared receiver unit that receives infrared rays from a third wireless control device; and
[1D]	a controller that controls the display unit, the communication unit and the infrared receiver unit,
[1E]	wherein, if a first command for changing a video content on the display unit from a first video content selected by the first wireless control device to a second video content is transmitted from the second wireless control device to the communication unit via the router during the first video content is displayed on the display unit, the display unit terminates displaying the first video content and starts to display the second video content and the communication unit sends first information for informing termination of the displaying of the first video content to the first wireless control device without going via a router, and
[1F]	wherein, if a second command for changing a video content on the display unit from a second video content selected by the second wireless control device to another video content is transmitted from the third wireless control device to the

¹ For convenience purposes only, Patent Owner adopts for this Preliminary Response the numbering of claim elements advanced by Petitioner in the Petition (Paper 2). Patent Owner does not concede the appropriateness of such grouping and numbering of claim elements.

Claim Element	Claim Text
	infrared receiver unit by infrared rays during the second video content is displayed on the display unit, the display unit terminates displaying the second video content and starts to display another video content and the communication unit sends second information for informing termination of the displaying of the second video content via the router to the second wireless control device.
Claim 2 Preamble	A method for changing a content on a video display apparatus comprising:
[2A]	displaying step to display a video content from a broadcast station or from a video content delivery source, on a display unit of the video display apparatus;
[2B]	first communication step to execute bi-directional wireless communication with a first wireless control device without going via a router; second communication step to execute bi-directional wireless communication via a router with a second wireless control device that is different from the first wireless control device; and
[2C]	infrared ray receiving step to receive infrared rays from a third wireless control device;
[2D]	wherein, if a first command for changing a video content on the display unit from a first video content selected by the first wireless control device to a second video content is transmitted from the second wireless control device to the video display apparatus via the router during the first video content is displayed on the display unit, the video display apparatus terminates displaying the first video content and starts to display the second video content and the video display apparatus sends first information for informing termination of the displaying of the first video content to the first wireless control device without going via a router, and
[2E]	wherein, if a second command for changing a video content on the display unit from a second video content selected by the second wireless control device to another video content is transmitted from the third wireless control device to the video display apparatus by infrared rays during the second video content is displayed on the display unit, the display unit

Claim Element	Claim Text
	terminates displaying the second video content and starts to display another video content and the video display apparatus sends second information for informing termination of the displaying of the second video content via the router to the second wireless control device.
Claim 3 Preamble	A video display apparatus comprising:
[3A]	a display unit that displays a video content from a broadcast station or from a video content delivery source;
[3B]	a communication unit that executes two types of bi-directional wireless communication including first bi-directional wireless communication with a first wireless control device without going via a router and second bi-directional wireless communication via a router with a second wireless control device that is different from the first wireless control device;
[3C]	an infrared receiver unit that receives infrared rays from a third wireless control device; and
[3D]	a controller that controls the display unit, the communication unit and the infrared receiver unit,
[3E]	wherein, if a first command for changing a video content on the display unit from a first video content selected by the first wireless control device to another video content is transmitted from the second wireless control device to the communication unit via the router during the first video content is displayed on the display unit, the display unit terminates displaying the first video content for changing a content to be displayed from the first video content to another video content and the communication unit sends first information for informing termination of the displaying of the first video content to the first wireless control device without going via a router, and
[3F]	wherein, if a second command for changing a video content on the display unit from a second video content selected by the second wireless control device to another video content is transmitted from the third wireless control device to the infrared receiver unit by infrared rays during the second video content is displayed on the display unit, the display unit terminates displaying the second video content for changing a content to be displayed from the second video content to

Claim Element	Claim Text
	another video content and the communication unit sends second information for informing termination of the displaying of the second video content via the router to the second wireless control device.
Claim 4 Preamble	A method for changing a content on a video display apparatus comprising:
[4A]	displaying step to display a video content from a broadcast station or from a video content delivery source, on a display unit of the video display apparatus;
[4B]	first communication step to execute bi-directional wireless communication with a first wireless control device without going via a router; second communication step to execute bi-directional wireless communication via a router with a second wireless control device that is different from the first wireless control device; and
[4C]	infrared ray receiving step to receive infrared rays from a third wireless control device;
[4D]	wherein, if a first command for changing a video content on the display unit from a first video content selected by the first wireless control device to another video content is transmitted from the second wireless control device to the video display apparatus via the router during the first video content is displayed on the display unit, the video display apparatus terminates displaying the first video content for changing a content to be displayed from the first video content to another video content and the video display apparatus sends first information for informing termination of the displaying of the first video content to the first wireless control device without going via a router, and
[4E]	wherein, if a second command for changing a video content on the display unit from a second video content selected by the second wireless control device to another video content is transmitted from the third wireless control device to the video display apparatus by infrared rays during the second video content is displayed on the display unit, the display unit terminates displaying the second video content for changing a content to be displayed from the second video content to

Claim Element	Claim Text
	another video content and the video display apparatus sends second information for informing termination of the displaying of the second video content via the router to the second wireless control device.

I. INTRODUCTION

Patent Owner Maxell, Ltd. (“Patent Owner”) respectfully requests that the Board deny institution because Petitioner TCL Electronics Holdings Ltd. (hereinafter “Petitioner” or “TCL”) has failed to demonstrate a reasonable likelihood of success on the grounds submitted in its Petition for challenging the patentability of claims 1-4 (the “challenged claims”) of U.S. Patent No. 10,375,341 (“the ’341 Patent”).

First, the Board should exercise its discretion pursuant to any of 35 U.S.C. §§ 314(a) and 325(d) and deny the Petition. Denial under 35 U.S.C. § 325(d) is appropriate because the Petition argues the same or substantially the same art and arguments previously presented and considered by the U.S. Patent & Trademark Office (“Office”), and fails to demonstrate that the Office erred in a manner material to the patentability of the challenged claims. Moreover, application of the *Fintiv* factors weigh in favor of denying institution and Petitioner’s stipulation is limited by timing and application such that it does not overcome the strong evidence that institution should be discretionarily denied under *Fintiv*.

Second, none of the cited references alone or in combination disclose or suggest the arrangement of each element of claims 1-4. Moreover, the Petition is filled with conclusory statements that fail to demonstrate a reasonable likelihood of success on any ground and are neither bolstered nor supported by Dr. Andrew

Wolfe's declaration, which simply parrots Petitioner's conclusions without additional analysis or evidence. *See* 37 C.F.R. §42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.").

For at least these reasons, Petitioner has failed to meet its burden of showing a reasonable likelihood of prevailing. Accordingly, the Board should deny Petitioner's request to institute *inter partes* review.

II. BACKGROUND

A. Overview of the '341 Patent

The '341 Patent, entitled "Video Display Apparatus and Terminal Apparatus," is generally directed to video display apparatuses and methods of changing the displayed content where casting of such content utilizes two different types of bi-directional wireless communications. '341 Patent at Abstract.

Prior to the priority date of the '341 Patent, viewing of content from different wireless devices was not possible using casting using a seamless and user-friendly video display apparatus. *See, e.g.*, EX1001 1:20-26, 2: 19-23. The '341 Patent solved this problem by including specific means of operation and communication between two different wireless devices. *See* 2:31-3:7.

More specifically, the '341 Patent is directed to casting to a TV from two different wireless devices; one via a router and one without going via a router. *See*

id. 2:31-3:7, 4:56-5:3. For example, the claims of the '341 Patent recite devices and methods that execute two types of bi-directional wireless communication—first bi-directional wireless communication with a first wireless control device without going via a router and second bi-directional wireless communication via a router with a second wireless control device that is different from the first. *See id.* If a first command for changing a video content on the display from a first video content is selected by the first wireless control device to a second video content is transmitted from the second wireless control device via the router during displaying the first video content, the display unit terminates displaying the first video content and starts to display the second video content and sends first information for informing termination of the displaying of the first video content to the first wireless control device without going via a router. *See, e.g., id.* 10:31-54. If a second command for changing a video content on the display from a second video content selected by the second wireless control device to another video content is transmitted from the third wireless control device, the display terminates displaying the second video content and starts to display another video content and sends second information for informing termination of the displaying of the second video content via the router to the second wireless control device. *See, e.g., id.*

B. Patent Prosecution History

U.S. Patent Application No. 15/889,735—which would ultimately issue as the

'341 Patent—was filed on February 6, 2018, as a continuation of U.S. Patent Application No. 14/649,895 (“the '895 Application”), which is a National Stage Entry of PCT/JP2013/079953, filed on November 6, 2013. The '895 Application issued as U.S. Patent No. 9,924,124. *See* EX2001 at 1.

C. Summary of Petitioner’s Proposed Ground for Unpatentability

Petitioner alleges that claims 1-4 would have been obvious under pre-AIA 35 U.S.C. § 103 and raises one ground of alleged unpatentability based on one prior art reference, Acharya (U.S. Patent Pub. No. 2005/0036509) in view of the knowledge of a POSITA:

Ground	'341 Patent Claims	Type of Challenge	Primary Reference	Secondary References
1	1-4	§ 103	Acharya	Knowledge of a POSITA

D. The Relied-Upon Reference

The reference relied upon by Petitioner to challenge the patentability of claims 1-4 of the '341 Patent is summarized as follows:

1. Acharya (EX1004)

U.S. Patent Pub. No. 2005/0036509 (“Acharya”) is entitled “Wireless presentation system.” Acharya was filed on June 2, 2004, and was published on February 17, 2005. Acharya claims priority to U.S. Provisional Application No. 60/475,751, filed on June 3, 2003.

Acharya is directed to a shareable display system that allows a single device

to control the shareable display system, and arbitration/mitigation methods to determine which device to grant control to among a plurality of devices requesting control. EX1004 ¶ [0012]. To make this selection, Acharya recites different modes, security features, and settings to help determine which device to grant control to, such as a “self-service multiple-user mode,” a “roundtable multiple-user mode,” and a “moderated multiple-user mode.” EX1004 ¶¶ [0056], [0058]-[0059] [0063]. Based on the mode and settings, the shareable display system will consider different conditions before granting control to a device, particularly when a previous device has already been granted control of the shareable display system. *Id.*

For example, roundtable multiple-user mode is designed to “force any other users to obtain the permission of the current user (the user currently with control and use of the display device) before the other users may use the display device.” *Id.* ¶ [0086]. In self-service multiple-user mode, instead of requiring permission from the current user already in control of the shareable display system, additional users may instead receive a dialog box asking for confirmation on whether the additional users want to disconnect the current user, therefore circumventing permission needed from the current user. *Id.* ¶ [0090]

III. LEVEL OF ORDINARY SKILL

For purposes of this preliminary response, Patent Owner adopts the Petitioner’s proposal “that a person of ordinary skill in the art at the time of the

alleged invention (‘POSITA’) would have had an educational background, such as a Bachelor of Science degree, in Electrical Engineering or Computer Engineering as well as some understanding of Wireless Communications. Additionally, a POSITA would have two years of practical experience in television or video display system development. Additional practical or work experience could result in a lower level of education being necessary, and vice versa. Pet. at 12. However, Patent Owner reserves the right to provide its own definition of a POSITA should the Board institute review of the ’341 Patent.

IV. CLAIM CONSTRUCTION

Petitioner states that they have asserted the construction of “communication unit” asserted by Patent Owner for the purposes of this Petition. Pet. at 13-14.²

Since then, the Court has issued a Claim Construction Order that states that (a) “communication unit” is a means-plus-function limitation; (b) the function is “executes two types of bi-directional wireless communication including first bi-directional wireless communication with a first wireless control device without going via a router and second bi-directional wireless communication via a router

² Patent Owner disagrees that Petitioner properly applied Patent Owner’s construction of “communication unit.” However, in light of the Court’s Claim Construction Order, Patent Owner does not address Petitioner’s construction further for the purposes of this Petition.

with a second wireless control device that is different from the first wireless control device;” and (c) the structure to be a “‘wireless transceiver that can communicate with wireless control devices either directly or indirectly’ and equivalents thereof” EX2002 at 12-17.

V. LEGAL STANDARD

Under 35 U.S.C. § 102(a) (pre-AIA), an issued patent is invalid if “the invention [therein] was . . . described in a printed publication . . . before the invention thereof by the applicant.” This statute “embodies the concept of novelty—if a device or process has been previously invented (and disclosed to the public), then it is not new, and therefore the claimed invention is ‘anticipated’ by the prior invention.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). To anticipate, “the prior art reference . . . must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *Id.* (citing *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)).

A claim is also not patentable if the differences between the claim and the prior art are such that the subject matter as a whole would have been obvious to a person of ordinary skill in the art at the time of the invention. 35 U.S.C. § 103(a) (pre-AIA). Obviousness requires assessing (1) the “level of ordinary skill in the pertinent art,” (2) the “scope and content of the prior art,” (3) the “differences

between the prior art and the claims at issue,” and (4) “secondary considerations” of non-obviousness such as “commercial success, long felt but unsolved needs, failure of others, etc.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)).

It is the petitioner’s burden to prove unpatentability, *E.I DuPont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996, 1007 (Fed. Cir. 2018), and “to demonstrate both ‘that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.’” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016) (quotations and citations omitted). However, a petitioner must first show that all of the claimed elements are disclosed in the prior art. *See Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006) (considering motivation to combine and reasonable expectation of success only “if all the elements of an invention are found in a combination of prior art references”).

VI. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

The Petition should be denied pursuant to any of 35 U.S.C. §§ 314(a) or 325(d).

A. 35 U.S.C. § 314(a) Weighs in Favor of Denying Institution

The Petition should be denied pursuant to 35 U.S.C. § 314(a) because, as set forth below, not only are there significant flaws in Petitioner’s analysis that fail the “compelling merits” standard, but the circumstances of the parallel District Court Litigation necessitate denial of the Petition under the Board’s precedent. In the Petition, Petitioner does not argue that any *Fintiv* factor supports institution. Every factor considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (precedential).

Accordingly, the Board should exercise its discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court litigation.” *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

1. The Board Should Use Its Discretion To Deny Institution Even In Light Of Petitioner’s *Sotera* Stipulation

Petitioners’ *Sotera* stipulation does not change that the Board should deny institution under *Fintiv*. The former Director recently clarified in district court filings that the Board retains discretion to deny institution even when petitioner files a so-called *Sotera* stipulation; otherwise, the Director’s factors would violate statute and

be unconstitutional. Particularly, the Director’s district court brief in *Apple Inc. v. Vidal* stated that “[i]n June 2022, the Director issued a guidance memorandum revising the Fintiv analysis.... In this Memorandum, the Director ... directed that ... the Board *should not* discretionarily deny institution under Fintiv when a petitioner stipulates not to pursue, in a parallel district court proceeding, the same grounds as in the petition or any grounds that could reasonably have been raised in the petition.” USPTO Director’s Brief in *Apple Inc. v. Vidal* at 6, No. 5:20-cv-06128- EJD (N.D. Cal. Sept. 21, 2023) (emphasis added). The Director further clarified that “[T]he Fintiv factors are only a ‘general statement of agency policy’ that binds neither the Board nor actors beyond the agency ...” *Id.* at 8.

Relying on the Director’s statements, the district court held that because the Board always retains discretion to deny institution (even when, for example, petitioner files a *Sotera* stipulation) the Director’s *Fintiv* guidance does not violate the Administrative Procedure Act: Plaintiffs ... alleg[e] three violations of the Administrative Procedure Act (“APA”), 5 U.S.C. § 701 et seq. ... Based on the parties’ written and oral arguments, the Court finds that the NHK-Fintiv standard was not a substantive rule requiring notice-and-comment rulemaking. *Apple Inc. v. Vidal*, No. 5:20-cv-06128-EJD, Order Denying Plaintiffs’ Renewed Motion for Summary Judgment; Granting Defendant’s Motion for Summary Judgment (N.D. Cal. Mar. 31, 2024)).

Accordingly, even when petitioner files a purported “Sotera” stipulation, it is not dispositive of whether the Board should deny institution under *Fintiv*. Rather, the Director and district court have clarified that the Board should consider any such stipulation as just one non-dispositive factor in connection with all other circumstances of the case, just like the Board has done previously. *See e.g., Cisco Systems, Inc. v. Estech Systems, Inc.*, IPR2021-00333, Paper No. 12 at 12-13 (P.T.A.B. July 7, 2021) (denying institution under *Fintiv* based on holistic analysis of all factors even when petitioner filed a Sotera stipulation because the Board was “not persuaded ... the stipulations proffered here are sufficient when weighed against the other factors”).

2. Petitioner’s Stipulation Is Insufficient In View of Other Factors That Weigh Heavily Against Institution

Here, any stipulation does not overcome the strong evidence that institution should be denied under *Fintiv*, or the Director’s inherent discretion, as addressed above. Additionally, Petitioner’s *Sotera* stipulation is insufficient because it does not purport to bind the real parties-in-interest (the remaining defendants in the district court litigation). Pet. at 68.

a. No Stay Of The Parallel District Court Litigation

There is no stay of the parallel District Court Litigation. Even if the Petition were instituted and Petitioner filed a motion to stay the District Court Litigation,

prejudice, tactical disadvantage to Maxell, the late stage of the litigation, and the lack of potential simplification would weigh strongly against such a motion. *See Lennon Image Techs., LLC v. Macy's Retail Holdings, Inc.*, 2:13-CV-00235-JRG, 2014 WL 4652117, at *1 (E.D.Tex. Sept. 18, 2014). The statutory deadline for institution is not until after fact and expert discovery closes and the Court has already conducted a *Markman* hearing and issued a claim construction order. EX2003; EX2004. Such facts make it unlikely that the District Court Litigation will be stayed. *See Intell. Ventures II v. FedEx Corp.*, No. 2:16-cv-00980-JRG, Dkt. 141 at 5 (E.D.Tex. Oct. 24, 2017).

b. Proximity Of The District Court's Trial Date

The proximity of the District Court Litigation's trial date to the Board's projected statutory deadline for a Final Written Decision strongly weighs in favor of discretionary denial. The parties' trial is scheduled for September 22, 2025, less than four months after the deadline for institution. EX2004. Petitioner knew of this trial date seven months prior to filing the Petition. EX2003. Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a final written decision of this Petition is May 26, 2026. 35 U.S.C. § 314(b)(1). As the District Court's trial will be almost eight months before the projected statutory deadline for a final written decision, this factor weighs strongly in favor of denying institution. *See Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7 at 7-10 (P.T.A.B. Jan.

7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, -00962, Paper 10 at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude “several months,” before a final decision would be due).

The proximity of the trial favors denial of institution.

c. Significant Investment In The Parallel Proceeding

The parties’ investment in the parallel proceeding weighs in favor of discretionary denial. In the District Court Litigation, by the time the Board renders an institution decision, the parties will have already completed most of the work getting prepared for trial, such as fact and expert discovery and dispositive motion briefing. *See* EX2003; EX2004. Fact discovery closes March 3, 2025 and expert discovery closes May 5, 2025. *See* EX2003; EX2004. The Court has also conducted a *Markman* Hearing (Dkt. 117) and issued a claim construction order. *See* EX2003; EX2004.

The parties have already exchanged infringement contentions pursuant to P.R. 3-1, and invalidity contentions pursuant to P.R. 3-3, completed claim construction briefing and a trial date is set for September 22, 2025, which is only four months after a decision on Institution. *See* EX2003; EX2004. Thus, the parties’ and Court’s substantial investment in this proceeding weighs in favor of denial of institution

under this factor. *10X Genomics, Inc. v. President and Fellows of Harvard College*, IPR2023-01299, Paper 15 at 17-18 (P.T.A.B. Mar. 7, 2024) (finding, under similar facts, that the parties have made a substantial investment in the parallel proceeding as of the time of the Institution Decision).

d. There Is Significant Overlap Between Issues Raised In The Petition And In The District Court Litigation

The issues in this proceeding are substantially the same as in the District Court Litigation. Here, Petitioner asserts that Claims 1-4 of the '341 Patent are unpatentable. Pet. at 1. These claims include the asserted claims against Petitioner in the District Court Litigation. Not only will the District Court Litigation conclude long before this proceeding, but it will also resolve the invalidity arguments that Petitioner raises in the instant Petition. The prior art references relied on in this proceeding are the same, or substantially the same, as those at issue in the District Court Litigation. Indeed, Petitioner disclosed the Acharya references in its contentions five months before filing its Petition. EX2005 at 9.

Given that the Petition is directed toward substantially the same grounds, arguments, and significantly overlapping evidence at issue in the parallel District Court Litigation, this factor favors denial of institution.

**e. The Parallel District Court Litigation And The
Petition Involve The Same Parties**

Petitioners are parties to the District Court Litigation. This factor weighs in favor of discretionary denial.

f. Other Factors Favor Discretionary Denial

The Petition does not present a strong case on the merits, let alone a “compelling meritorious challenge,” further supporting denial of institution. *See infra* Section VII. Petitioner also does not identify any other factors which weigh against discretionary denial. Pet. at 68.

Though Petitioners make a *Sotera* stipulation, its effect is substantially muted because, in addition to not binding all real parties-in-interest, by the time the Board renders a decision on institution, the parties will have already prepared expert reports and completed expert discovery. As a result, it would be much more efficient for the parties to address the validity issues in the district court rather than in this forum. *Inter partes* review was created as “a quick, inexpensive, and reliable alternative to district court litigation.” S. Rep. No. 110-259, at 20 (2008). None of these goals are achieved if Maxell is forced to prepare its validity case in the district court litigation—including engaging experts and going through expert discovery—all prior to the Board’s institution decision as a result of Petitioner’s filing of the petition at almost a year after the litigation was commenced.

Thus, when viewing the factors together, the Petition should be denied in the Director's discretion under 35 U.S.C. § 314(a).

B. 35 U.S.C § 325(d) Weighs in Favor of Denying Institution

Employing a framework that “reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown,” the Director will discretionarily deny institution when: (1) “the same or substantially the same art previously was presented to the Office” *or* “the same or substantially the same arguments previously were presented to the Office”; and (2) the petitioner does not “demonstrate[] that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential) (“*Advanced Bionics*”).

Within this two-part framework, the Board considers a number of non-exclusive factors in evaluating whether to exercise its discretion under § 325(d). *See Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017) (precedential as to § III.C.5, first para.) (“*Becton, Dickinson*”); *see also Advanced Bionics* at 9–11. The factors set forth in *Becton, Dickinson* are as follows:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;

- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art;
- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson at 17–18.

For Part 1 of the *Advanced Bionics* framework, the Board first evaluates *Becton, Dickinson* factors (a), (b), and (d). *Advanced Bionics* at 10. If it is determined that the same or substantially the same art or arguments were previously presented to the USPTO, then under Part 2 Board considers factors (c), (e), and (f) to assess “whether the petitioner has demonstrated a material error by the Office” in its prior consideration of that art or arguments. *Id.* Notably, previously presented does not mean the Examiner must have “meaningfully addressed” or based a rejection on a particular reference. *Biocon Pharma Ltd. v. Novartis Pharm. Corp.*, IPR2020-01263, Paper 12 at 9 (P.T.A.B. Feb. 16, 2021) (holding that cited but unapplied references supported denying institution); *Sony Interactive Entm’t LLC v. Terminal Reality, Inc.*, IPR2020-00711, Paper 15 at 11 (P.T.A.B. Oct. 13, 2020) (finding

reference was previously considered by the PTO because it was listed in the Examiner's Notice of References Cited).

Simply put, the Petition is a rehash of the art, rejections, arguments, and reasons for allowance already considered during the prosecution of the '341 Patent, making this Petition ripe for denial of institution under § 325(d).

1. Part 1: The Same or Substantially the Same Art Were Previously Considered

The overlap between the IPR-asserted references and those submitted during prosecution meets the first part of the two-part *Advanced Bionics* framework, which considers the similarities and material differences between the two sets of art, the cumulative nature of the art, and the extent of the overlap between the arguments. *Becton, Dickinson & Co. v. B. Braun Melsungen AAG*, IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (factors (a), (b), and (d)).

Petitioner relies on Acharya as a primary reference for the only ground asserted in the Petition. However, Acharya is substantially the same as art previously presented to the Office.

For example, Acharya is substantially the same as Robbins (U.S. Patent Publication No. 2010/0157978) (EX2006), art that was previously presented to the Office. See EX1001 at 2 (listed as a cited reference on the '341 Patent).

Patent No. 10,375,341
Patent Owner Preliminary Response

2010/0157978	A1	6/2010	Robbins et al.
2010/0235862	A1	9/2010	Adachi
2010/0254670	A1*	10/2010	Amsterdam H04N 5/44543 386/248

Furthermore, Robbins was the primary reference asserted by the Examiner in relation to a parent application of the '341 Patent (the '895 Application). *See, e.g.*, EX2001 at 347. This parent application was examined by the same Examiner (Mustafizur Rahman) who allowed the '341 Patent. *See, e.g.*, EX1001 at 1; EX2001 at 344. And not only are the specification and drawings of the '124 Patent and the '341 Patent materially identical, they share similar claim limitations in their independent claims. *Compare* EX1001 *with* EX2007. Thus, the prosecution history of the '895 Application is to be considered “with equal force” as the prosecution history of the '341 Patent itself. *See Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 980 (Fed. Cir. 1999) (“When multiple patents derive from the same initial application, the prosecution history regarding a claim limitation in any patent that has issued applies with equal force to subsequently issued patents that contain the same claim limitation.”); *Nokia of America Corp. v. Alexander Soto and Walter Soto*, IPR2023-00681, Paper 10, at 20 (P.T.A.B. Nov. 3, 2023) (finding the parent prosecution history to apply in equal force to evaluate part 1); *II-VI, Inc. v. Alexander Soto*, IPR2021-01359, Paper 10, at 19–20 (P.T.A.B. Feb. 15, 2022) (evaluating Patent Owner’s comparison of claim 1 of the '723 patent with claim 1 of the '795

patent and finding that “it supports Patent Owner’s position that the prosecution history of the [’795] patent is appropriately considered in evaluating whether to exercise discretion to deny the Petition”); *Cultec, Inc. v. StormTech LLC*, IPR2017-00777, Paper 7, at 9, 11 (P.T.A.B. Aug. 22, 2017).

Acharya is substantially the same as Robbins. For example, the abstract of Robbins states:

A system that incorporates teachings of the present disclosure may include, for example, a communication device having a controller to detect a media device operating externally to the communication device actively engaged in presenting media content, detect an incoming communication session initiated by another communication device, present a notice identifying the media device and the media content being presented by the media device, detect a directive to modify an operation of the media device to mitigate interrupting a communication session with the other communication device, and instruct the media device to modify its operation according to the directive.

EX2006 at Abstract.

This is substantially similar to Petitioner’s contentions regarding Acharya. For example, Petitioner contends Acharya discloses a “multiple-user display system” which is substantially similar to Robbins’s disclosures. *Compare* Pet. at 23 (“multiple-user display system”) with EX2006 at Abstract (“engaged in the presenting media content”). Further, Petitioner’s characterization of Acharya as

implementing arbitration mitigation methods is substantially similar to Robbins's disclosure. *Compare* Pet. at 39 ("arbitrate access"), 42 *with* EX2006 at Abstract ("modify an operation of the media device to mitigate interrupting a communication session with the other communication device"). Also, Petitioner's contentions regarding Acharya's dialog boxes are substantially similar to Robbins's disclosures. *Compare* Pet. at 42 (discussing dialog box "informing Bob that 'Projector ABC is in Use by Jane," and that Jane will be disconnected if Bob elects to connect nonetheless) *with* EX2006 at Abstract (disclosing "detect an incoming communication session initiated by another communication device, present a notice identifying the media device and the media content being presented by the media device, detect a directive to modify an operation of the media device to mitigate interrupting a communication session with the other communication device").

For at least these reasons, Acharya is cumulative to art presented to the Office during prosecution of the '341 Patent. Thus, Part 1 is met because the same or substantially the same art were previously presented to the Office.

2. Petitioner Fails to Demonstrate Material Error by the Office

Because Part 1 is met, Petitioner must demonstrate material error under Part 2. However, the Petition is silent on this point and thus fails to demonstrate "that the Office erred in a manner material to the patentability of the challenged claims," as required under Part 2. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte*

GMBH, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential). In fact, the Petition makes no mention of §325(d) at all. Petitioner’s failure to address Part 2 validates denial under § 325(d). *Albany Int’l Corp. v. Kimberly-Clark Worldwide, Inc.*, PGR2021-00019, Paper 22 at 8-9 (P.T.A.B. June 22, 2021) (denying institution because “[i]f a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute [] review.”).

Petitioner completely fails to address why the prosecution of the ’341 Patent included material error. Petitioner’s lack of analysis is insufficient to meet the second part of the *Advanced Bionics* test, and denial under §325(d) is appropriate. Petitioner only makes conclusory remarks that “Acharya is not included amongst the references listed on the face of the ’341 Patent,” and that “the Examiner did not have access to the expert testimony of Dr. Andrew Wolfe describing the disclosure of Acharya and the compelling motivations to combine various embodiments of Acharya.” Pet. at 5. But the mere presence of a declaration “alone does not overcome the circumstances presented here.” *Cloud9 Techs. LLC v. IPC Systems, Inc.*, IPR2017-0615, Paper 8 at 11 (P.T.A.B. Jan. 10, 2018); *Telebrands Corp. v. Tinnus Enterprises, LLC*, PGR2017-00040, Paper 10 at 14-15 (P.T.A.B. Feb. 7, 2018) (denying institution based on 325(d) discretionary factors and finding that expert testimony did not meaningfully distinguish the record that was before the Examiner);

see also 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”).

Indeed, Petitioner does not meet its burden. To evaluate material error, the Board weighs *Becton, Dickinson* factors c, e and f. The Petition does not reference any of these factors, let alone analyze them. *Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper 7 at 20 (P.T.A.B. July 11, 2023) (“[W]hile there are no ‘magic words’ necessary to address material error, Petitioner’s alleged grounds of unpatentability cannot establish material error *per se* under our binding precedent. . . . Otherwise, the reasonable likelihood standard of § 314(a) and the second part of the *Advanced Bionics* framework (‘material error’) would collapse into one.”).

Accordingly, the *Advanced Bionics* framework is satisfied and the Director should exercise its discretion to deny institution. *See Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential); *Albany Int’l Corp. v. Kimberly-Clark Worldwide, Inc.*, PGR2021-00019, Paper 22 at 8-9 (P.T.A.B. June 22, 2021).

VII. THE PETITION DOES NOT SHOW A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY CHALLENGED CLAIM

The Petition should be denied because it does not establish a reasonable likelihood of prevailing on any of the asserted grounds against any of the challenged

claims. Petitioner fails to establish that claims 1-4 are rendered obvious by Acharya.

A. Petitioner Fails to Establish that Claim Element [1E] Would Have Been Obvious to a POSITA in View of Acharya and Further in View of the Knowledge of a POSITA

Petitioner fails to demonstrate that Acharya in view of the knowledge of a POSITA discloses or suggests “wherein, if a first command for changing a video content on the display unit from a first video content selected by the first wireless control device to a second video content is transmitted from the second wireless control device to the communication unit via the router during the first video content is displayed on the display unit, the display unit terminates displaying the first video content and starts to display the second video content and the communication unit sends first information for informing termination of the displaying of the first video content to the first wireless control device without going via a router,” as required by element [1E].

1. Acharya’s Dialog Boxes

Petitioner specifically alleges that “[t]he termination message of Acharya’s FIG. 18 correlates to the feature “the communication unit sends first information for informing termination of the displaying of the first video content to the first wireless control device.” Pet. at 45.

However, Acharya’s termination message displayed on Jane’s device (the alleged “first wireless control device”) fails to disclose or suggest [1E] for several

reasons: (a) there is no disclosure of the **projector actually sending information to Jane's device** for informing termination of the displaying of the first video content; and (b) there is no disclosure of the projector sending information **for informing termination of the displaying of the first video content**.

First, Petitioner fails to introduce any evidence, through its citations to Acharya or its expert declaration, that Acharya's alleged communication unit "**sends first information** for informing termination of the displaying of the first video content **to the first wireless control device** without going via a router," as required by element [1E]. Pet. at 45; EX1003 ¶¶106-108.

Petitioner exclusively relies on dialog boxes displayed on devices that are **not** the alleged "video display apparatus" (Acharya's projector) to disclose this limitation. See Pet. at 45. For example, Petitioner relies on Acharya's disclosure that Jane's computing device displays a dialog box that informs the user of "loss of control" to the projector (the alleged "video display apparatus"). See *id.* However, Acharya fails to disclose any actions **by the projector** that causes other devices, such as Jane's computing device, to perform certain actions. See EX1003 ¶¶106-108. As a result, Petitioner fails to cite to any portion of Acharya that supports the projector sending information, because Acharya only discloses an exemplary dialog box that might be displayed on Jane's computing device.

While Petitioner does not assert a combination with what a POSITA would

know for this particular sub-element, Petitioner's expert declaration is similarly lacking. *See* Pet. at 45. Petitioner and expert, without any further rationale or reasoning, made conclusory assumptions that Acharya's projector sends "first information informing termination" without articulating any rationale for how Acharya explicitly or inherently discloses that the dialog box was displayed based on information sent from the projector, or how a POSITA would understand that Acharya discloses that the dialog box was displayed based on information sent from the projector.

Instead, Petitioner fixates on justifying a conclusion that this termination message was sent ***without going via a router***, without supporting that the termination message was sent ***from*** the projector in the first place. *See* Pet. at 45-47. For example, Petitioner cites district court claim construction deposition testimony by Dr. Saber that clarifies that a POSITA would understand transmission would occur a specific way (via a router or not via a router) in the context where there already is an established transmission. *See* EX1005 71:25-72:17. Dr. Saber's testimony specifically related to the disclosure of the '341 Patent, which clearly discloses that the communication device sends information to notify a particular wireless communication device of the termination of the displaying of the second video content. '341 Patent at 7:66-8:5 ("[W]hen channel switching by the terminal apparatus 1b other than the terminal apparatus 1a...has occurred, ***the video display***

apparatus 3 transmits the channel switching notification as status information ***to the terminal apparatus 1a.***” (emphasis added)). There is no similar statement in Acharya. Dr. Saber’s testimony does not shift Petitioner’s burden to first establish transmission of information informing of termination of video content. Ironically, Petitioner’s characterization that the ’341 Patent lacks “disclosure for any methods and/or mechanisms of sending back termination information” applies clearly to Acharya, because while the ’341 Patent explicitly dictates a notification being **sent**, Acharya is silent regarding any transmission of information to cause the dialog box to populate. Pet. at 50.

Second, the communication from the projector to Jane’s device must pertain to “termination of the displaying of the first video content.” Because Petitioner fails to demonstrate that the projector sends first information in the first place, Petitioner fails to address whether the first information relates to the “termination of the displaying of the first video content.”

Petitioner has the burden to link the lack of control message of Acharya to actual “termination of the displaying of the first video content.” Petitioner takes for granted that a sample dialog box displayed on ***Jane’s device*** that is ***not the projector*** discloses or suggests all parts of the limitation without providing any explanation for how actions on one device discloses or suggests actions on another device. Petitioner also fails to address that a POSITA would link these limitations or any

arguments/evidence addressing this gap. Therefore, Petitioner fails to show that Acharya discloses or suggests element [1E].

Third, Acharya never discloses that the projector “terminates displaying the first video content” or “starts to display the second video content,” as required by claim element [1E]. While Petitioner relies on dialog boxes shown on Jane’s device, changes on the display of Jane’s device fails to disclose or suggest changes on the display **of the projector**, such as changing from displaying a first video content to a second video content.

Additionally, Acharya’s definition of “control” explicitly distinguishes obtaining control of the projector from displaying video or changing the display of the projector. See EX1003 ¶ [0094] (discussing option to give or remove “privileges for presenting video on the display device” when user obtains control the display device); [0095] (discussing option to “partially modify a presentation being controlled by another user”). For example, Acharya discloses that when Bob obtains “control” of the projector, this would not terminate any first video content being displayed on the projector. See EX1003 ¶¶ [0094]-[0095]. Acharya also discloses that, in some cases, “obtaining control” merely gives Bob the ability to control first video content already displayed by another user. See *id.*

2. Paragraph 13 of Acharya

To the extent that the Board considers that Petitioner’s discussion of

paragraph 13 may disclose this limitation, several points are of note. **First**, Petitioner specifically recites paragraph 13 in relation to the “starts to display the second video content” and fails to articulate how paragraph 13 discloses “a first command.” Pet. at 44 (“*[S]pecific to the requirement of ‘starts to display the second video content’ of [1E], Acharya discloses in ¶13 that in a self-serve mode, users send video data to the shareable display system and the shareable display system updates the display with the most recently received video data received.*”). Therefore, application of paragraph 13 should be limited to this specific portion of the limitation.

Petitioner asserts that “A POSITA reading ¶ 13 in view of ¶ 90 of Acharya would understand that as Bob took over the control of the projector from Jane, Jane’s video content is terminated and Bob’s video content will be displayed.” Pet. at 44. There appear to be two different ways to interpret paragraph 13 in view of paragraph 90: (1) paragraph 90 expounds upon a high-level description of paragraph 13; or (2) paragraph 90 and paragraph 13 disclose different embodiments. Regarding the first interpretation, if paragraph 90 expounds on paragraph 13, paragraph 90 fails to disclose the claim limitation for the reasons stated above. Additionally, there is no detail that describes a technical implementation of paragraph 13 that cures the deficiencies of paragraph 90.

Alternatively, if paragraph 13 and paragraph 90 are considered to disclose **different** embodiments, Petitioner fails to assert rationale for the combination of the

two different embodiments, or even a working combination of the two embodiments, and merely states that “reading ¶ 13 in view of ¶ 90” would render obvious the limitation. Because Petitioner fails to assert a combination rationale, Petitioner fails to prove that a combination of paragraphs 13 and 90 renders obvious this limitation.

B. Petitioner Fails to Establish that Claim Element [1F] Would Have Been Obvious to a POSITA in View of Acharya and Further in View of the Knowledge of a POSITA

Petitioner fails to demonstrate Acharya and the knowledge of a POSITA disclose or render obvious limitation [1F]: “wherein, if a second command for changing a video content on the display unit from a second video content selected by the second wireless control device to another video content is transmitted from the third wireless control device to the infrared receiver unit by infrared rays during the second video content is displayed on the display unit, the display unit terminates displaying the second video content and starts to display another video content and the communication unit sends second information for informing termination of the displaying of the second video content via the router to the second wireless control device.”

First, Petitioner fails to follow the mapping asserted in [1E], where Bob has obtained control of the projector. Pet. at 44. Petitioner now alleges that in [1F], Bob obtains control of the projector *from* Jane, even though Petitioner previously alleged that Bob had already obtained control from Jane in [1E]. Petitioner fails to address

this gap between [1E] and [1F] at all and combines different embodiments with no combination rationale.

The result of Petitioner’s approach to failing to propagate mappings asks the Board and Patent Owner to interpret which elements from each exhibit a POSITA would choose to combine, which portions of each reference should be considered when, and what the combined teachings might suggest to a POSITA. This is improper. *See Microsoft Corp. v. FG SRC, LLC*, 860 Fed. Appx. 708, 713 (Fed. Cir. 2021) (“It is not the Board’s job to cobble together assertions from different sections of a petition or citations of various exhibits in order to infer every possible permutation of a petitioner’s arguments.”). Instituting an IPR on such a Petition would prejudice Patent Owner, because Patent Owner is unable to discern the manner in which Petitioner suggests different embodiments of Acharya and a knowledge of a POSITA should be combined, and is therefore limited in its ability to address some unspecified combination of disclosures from the Petition. *T-Mobile US, Inc. v. TracBeam LLC*, IPR2015-01687, Paper 10 at 20 (P.T.A.B. Feb. 12, 2016) (“We will not...improperly shift the burden of deciphering the arguments onto the Patent Owner”). Indeed, institution would enable Petitioner to develop arguments not initially presented in the Petition. This is improper. *ADT LLC v. Vivint Inc.*, IPR2022-00642, Paper 7 at 13-14 (P.T.A.B. Oct. 4, 2022).

Next, Petitioner asserts the same arguments for [1F] as [1E]—e.g., relying on

examples of dialog boxes that can be displayed on user devices other than the shared projector. Therefore, for at least the reasons set forth in relation to [1E] in Section VII.A, Petitioner fails to establish that element [1F] would have been obvious to a POSITA in view of Acharya and further in view of the knowledge of a POSITA. The dialog boxes reflect sample user interface elements on devices other than the projector, and therefore do not disclose or suggest changes on the display of the projector from second video content to third video content.

Petitioner provides additional arguments related to “a command transmitted to the infrared receiver unit.” Petitioner asserts that Bob’s third wireless control device directly connects to projector 110 through infra-red connection, and then asserts that the same scenario occurs. Pet. at 48. Petitioner further asserts that “[B]efore being terminated, Jane was displaying her content (which correlates to ‘second video content’ of [1F] on projector 110. The content requested by Bob correlates to ‘another video content’ of [1F].”

There are several issues with Petitioner’s argument. First, Petitioner asserts that there is “content requested by Bob.” Pet. at 48-49. But this is a conclusory remark without any support from Acharya. Petitioner fails to point to a section in Acharya that demonstrates that Bob requests content. *See id.* Acharya only discloses or suggests that Bob requests control of the projector without any indication of specific content. EX1004 ¶ 90. Petitioner’s expert declaration further fails to posit

what comprises “content” or Bob’s request for specific content besides a conclusory remark that Bob requests specific content.

Petitioner also asserts that paragraph 13 which discloses that in “self-serve mode, users send video data to the shareable display system, and the shareable display system updates the display with the most recently received video data received.” Pet. at 49. As described above in relation to Section VII.A, this is a high level overview that discloses *no* details, such as details of how requests are sent, of details of timing of updating the display upon request. There is no further detail in Acharya on how video data is received and processed by the projector.

Alternatively, if paragraph 13 and paragraph 90 are considered to disclose *different* embodiments, Petitioner fails to assert rationale for the combination of the two different embodiments, or even a working combination of the two embodiments, and merely states that “reading ¶ 13 in view of ¶ 90” would render obvious the limitation. Because Petitioner fails to assert a combination rationale, Petitioner fails to prove that a combination of paragraphs 13 and 90 renders obvious this limitation.

C. Petitioner Fails to Establish that Claim 2 Would Have Been Obvious to a POSITA in View of Acharya and Further in View of the Knowledge of a POSITA

1. Petitioner Fails to Establish that Limitation [2D] Is Rendered Obvious by Acharya and the Knowledge of a POSITA.

In relation to limitation [2D], Petitioner relies on the same rationale for Claim

2 as Claim 1. See Pet. at 56 (“Element [2D] is substantially the same as [1E]. The arguments and analyses for [1E], as explained in § XI.2.a.vi apply to [2D].”). Therefore, for at least the same reasons asserted above in relation to limitation [1E], Petitioner fails to demonstrate that claim 2 would be obvious to a POSITA based on Acharya and the knowledge of a POSITA.

Petitioner **only** applies new rationale regarding the use of “a video display apparatus” rather than a communication unit. Because this is irrelevant to the analysis asserted in relation to limitation [1E], Petitioner’s additional rationale fails to cure the deficiencies stated above in relation to limitation [1E].

2. Petitioner Fails to Establish that Limitation [2E] Is Rendered Obvious by Acharya and the Knowledge of a POSITA.

In relation to limitation [2E], Petitioner relies on the same rationale for Claim 2 as Claim 1. See Pet. at 57 (“Element [2E] is substantially the same as [1F]. The arguments and analyses for [1F], as explained in § XI.2.a.vii apply to [2E].”). Therefore, for at least the same reasons asserted above in relation to limitation [1F], Petitioner fails to demonstrate that claim 2 would be obvious to a POSITA based on Acharya and the knowledge of a POSITA.

Petitioner **only** applies new rationale regarding the use of “a video display apparatus” rather than an infrared receiver unit and communication unit. Because this is irrelevant to the analysis asserted in relation to limitation [1F], Petitioner’s

additional rationale fails to cure the deficiencies stated above in relation to limitation [1F].

D. Petitioner Fails to Establish that Claim 3 Would Have Been Obvious to a POSITA in View of Acharya and Further in View of the Knowledge of a POSITA

1. Petitioner Fails to Establish that Limitation [3E] Is Rendered Obvious by Acharya and the Knowledge of a POSITA.

In relation to limitation [3E], Petitioner relies on the same rationale for Claim 3 as Claim 1. See Pet. at 61 (“Element [3E] is substantially the same as [1E]....Thus, the arguments and analyses for [1E], as explained in § XI.2.a.vi[] show Acharya discloses [3E], or at least renders it obvious.”). Therefore, for at least the same reasons asserted above in relation to limitation [1E], Petitioner fails to demonstrate that claim 3 would be obvious to a POSITA based on Acharya and the knowledge of a POSITA.

Petitioner **only** applies new rationale regarding that “the display unit terminates displaying the first video content for changing a content to be displayed from the first video content to another.” Petitioner states that paragraph 13 of Acharya discloses this limitation. However, analysis in relation to limitation [1E] already address these arguments.

That is, there appear to be two different ways to interpret paragraph 13 in view of paragraph 90: (1) paragraph 90 expounds upon a high-level description of

paragraph 13; or (2) paragraph 90 and paragraph 13 disclose different embodiments. Regarding the first interpretation, if paragraph 90 expounds on paragraph 13, paragraph 90 fails to disclose the claim limitation for the reasons stated above. Additionally, there is no detail that describes a technical implementation of paragraph 13 that cures the deficiencies of paragraph 90.

Alternatively, if paragraph 13 and paragraph 90 are considered to disclose *different* embodiments, Petitioner fails to assert rationale for the combination of the two different embodiments, or even a working combination of the two embodiments, and merely states that “reading ¶ 13 in view of ¶ 90” would render obvious the limitation. Because Petitioner fails to assert a combination rationale, Petitioner fails to prove that a combination of paragraphs 13 and 90 renders obvious this limitation.

2. Petitioner Fails to Establish that Limitation [3F] Is Rendered Obvious by Acharya and the Knowledge of a POSITA.

In relation to limitation [3F], Petitioner relies on the same rationale for Claim 3 as Claim 1. *See* Pet. at 62 (“Element [3F] is substantially the same as [1F].... The arguments and analyses for [1F], as explained in § XI.2.a.vii[] show Acharya discloses [3F], or at least renders it obvious.”). Therefore, for at least the same reasons asserted above in relation to limitation [1F], Petitioner fails to demonstrate that claim 3 would be obvious to a POSITA based on Acharya and the knowledge of a POSITA.

Petitioner **only** applies new rationale regarding that “the display unit terminates displaying the second video content for changing a content to be displayed from the second video content to another video content.” This time, Petitioner states that paragraph 13 of Acharya discloses this limitation. However, analysis in relation to limitation [1E] already address these arguments.

That is there appear to be two different ways to interpret paragraph 13 in view of paragraph 90: (1) paragraph 90 expounds upon a high-level description of paragraph 13; or (2) paragraph 90 and paragraph 13 disclose different embodiments. Regarding the first interpretation, if paragraph 90 expounds on paragraph 13, paragraph 90 fails to disclose the claim limitation for the reasons stated above. Additionally, there is no detail that describes a technical implementation of paragraph 13 that cures the deficiencies of paragraph 90.

Alternatively, if paragraph 13 and paragraph 90 are considered to disclose **different** embodiments, Petitioner fails to assert rationale for the combination of the two different embodiments, or even a working combination of the two embodiments, and merely states that “reading ¶ 13 in view of ¶ 90” would render obvious the limitation. Because Petitioner fails to assert a combination rationale, Petitioner fails to prove that a combination of paragraphs 13 and 90 renders obvious this limitation.

E. Petitioner Fails to Establish that Claim 4 Would Have Been Obvious to a POSITA in View of Acharya and Further in View of the Knowledge of a POSITA

1. Petitioner Fails to Establish that Limitation [4D] Is Rendered Obvious by Acharya and the Knowledge of a POSITA.

In relation to limitation [4D], Petitioner relies on the same rationale for Claim 4 as Claim 2. *See* Pet. at 65 (“Element [4D] is substantially the same as [2D]... Thus, the arguments and analyses regarding [2D] in § XI.2.b.v[] show Acharya discloses [4D], or at least renders it obvious.”). Therefore, for at least the same reasons asserted above in relation to limitation [2D], Petitioner fails to demonstrate that claim 4 would be obvious to a POSITA based on Acharya and the knowledge of a POSITA.

Petitioner additional rationale regarding use of paragraph 13 is further addressed in limitation [2D].

2. Petitioner Fails to Establish that Limitation [4E] Is Rendered Obvious by Acharya and the Knowledge of a POSITA.

In relation to limitation [4E], Petitioner relies on the same rationale for Claim 4 as Claim 2. *See* Pet. at 66 (“Element [4E] is substantially the same as [2E]....Thus, the arguments and analyses regarding [2E] in § XI.2.b.vi[] show Acharya discloses [4E], or at least renders it obvious.”).

Therefore, for at least the same reasons asserted above in relation to limitation [2E], Petitioner fails to demonstrate that claim [4E] would be obvious to a POSITA

based on Acharya and the knowledge of a POSITA.

Petitioner additional rationale regarding use of paragraph 13 is further addressed in limitation [2E].

VIII. CONCLUSION

For at least the foregoing reasons, the Board should deny institution of the Petition.

Dated: February 26, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on this 26th day of February, 2025, a copy of the attached **PATENT OWNER'S PRELIMINARY RESPONSE** was served by electronic mail to the attorneys of record, at the following addresses:

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CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Preliminary Response complies with the type-volume limitation of 37 CFR §42.24(a). The word count application of the word processing program used to prepare this Preliminary Response indicates that the Preliminary Response contains 8,751 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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