

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: IPR2025-00135

U.S. Patent No. 10,219,020

**PATENT OWNER PRELIMINARY RESPONSE TO PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 10,219,020**

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Patent Trial and Appeal Board
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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	'938 Application File History
2002	District Court Claim Construction Order
2003	Bennett (U.S. Patent Publication No. 2007/0124772)
2004	Bennett (U.S. Patent Publication No. 2007/0124777)
2005	Bennett (U.S. Patent Publication No. 2007/0124778)
2006	Bennett (U.S. Patent Publication No. 2007/0124765)
2007	Slotznick (U.S. Patent Publication No. 2001/0055951)
2008	Docket Control Order
2009	First Amended Docket Control Order
2010	Invalidity Contentions

LISTING OF CHALLENGED CLAIMS¹

Claim Element	Claim Text
Claim 1 Preamble	A display apparatus for the display of video content acquired from a television broadcast and for the display of video content acquired via the internet, comprising:
[A]	a digital broadcast receiver configured to receive a digital broadcast signal;
[B]	a signal separator for de-multiplexing the digital broadcast signal into video data and audio data;
[C]	a video processor configured to convert the format of the video data;
[D]	an audio processor configured to convert the format of the audio data;
[E]	a network communication module configured to communicate over the internet;
[F]	a radio receiver for receiving data from an external mobile terminal;
[G]	an infra-red (IR) receiver for receiving commands from a remote controller;
[H]	a display panel; and
[I]	a system controller configured to control the display apparatus to:
[I.1]	receive a first video content via the received broadcast signal;
[I.2]	display the first video content on the display panel;
[I.3]	receive an identifier for identifying a second video content from the external mobile terminal;
[I.4]	acquire the second video content via the internet using said identifier;
[I.5]	display the second video content on the display panel;
[I.6]	terminate display of the first video content prior to display of the second video content;

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

Claim Element	Claim Text
[I.7]	execute operation instructions received from the external mobile terminal via the radio receiver while the second video content is being displayed; and
[I.8]	execute commands received from the remote controller, wherein said remote controller is a different device than the external mobile terminal.
Claim 2	The display apparatus according to claim 1, wherein the second video content comprises video content displayed on the external mobile terminal.
Claim 3	The display apparatus of claim 2, wherein the display apparatus is further configured to receive display state information for the second video content.
Claim 4	The display apparatus of claim 3, wherein the display state information comprises position information.
Claim 5	The display apparatus according to claim 2, wherein said operation instructions include move and select operations.
Claim 6	The display apparatus according to claim 5, wherein the display apparatus is not configured to transmit an identifier that identifies said first video content displayed on the display panel to the external mobile terminal.
Claim 17	The display apparatus according to claim 1, wherein the system controller is not configured to receive the identifier from the remote controller.
Claim 18	The display apparatus according to claim 1, wherein the display apparatus is not configured to transmit an identifier that identifies video content displayed on the display panel to the external mobile terminal.
Claim 19	The display apparatus according to claim 1, wherein said operation instructions include move and select operations.
Claim 20	The display apparatus according to claim 1, wherein the external mobile terminal is capable of receiving the second video content via a cellular base station.
Claim 21	The display apparatus according to claim 1, wherein the external mobile terminal comprises a smart phone.
Claim 22	The display apparatus according to claim 1, wherein the display apparatus is not configured to transmit an identifier that identifies said first video content displayed on the display panel to the external mobile terminal.

Claim Element	Claim Text
Claim 23	The display apparatus according to claim 1, wherein the identifier comprises a URL.
Claim 24	The display apparatus according to claim 1, wherein the system controller is further configured to control the network communication module to acquire the second video content without a user having to perform a log-in operation through the display apparatus.
Claim 25	The display apparatus of 1, wherein the display apparatus further includes a memory for storing a user operation history.
Claim 26	The display apparatus of claim 25, wherein the user operation history comprises a set of user selections.
Claim 27	The display apparatus of claim 1, wherein the video processor is capable of having the second video content displayed in full screen display mode and, alternatively, in a partial area of the screen.
Claim 28	The display apparatus of claim 1, wherein the display apparatus is further configured to communicate with the external mobile terminal over a wireless LAN.
Claim 29	The display apparatus of claim 1, wherein the display apparatus further comprises a DLNA communications device.
Claim 30	The display apparatus of claim 1, wherein the display apparatus further includes a memory storing an internet browser.

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 1-6, 17-30 (the “challenged claims”) of U.S. Patent No. 10,219,020 (“the ’020 Patent”).

First, the Board should exercise its discretion pursuant to any of 35 U.S.C. §§ 312(a)(3), 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. Additionally, Petitioner fails to identify, with particularity, the grounds on which the challenge to **each** claim is based and the evidence that supports the grounds for the challenge to **each** claim. Moreover, application of the *Fintiv* factors weigh in favor of denying institution and Petitioner’s stipulation is limited by timing and application 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 limitation of claims 1-6, 17-30. 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 '020 Patent

The '020 Patent, entitled "Portable Terminal, Information Processing Apparatus, Content Display System and Content Display Method," is generally directed to a display apparatus, such as a smart television, that can be controlled by an external mobile terminal, such as a smartphone, to start, control, and stop video content acquired via the internet. *See* EX1001 at Abstract. The '020 Patent specifically relates to casting content from an external mobile device to a television

and then controlling that video content based on information received from the external mobile device. *See id.* at Abstract, 3:34-53.

The '020 Patent claims are directed to controlling the display apparatus to display broadcast TV content and to terminate that display in response to information received from the external mobile terminal to display a second video content acquired via the internet. *See id.* The '020 Patent claims are also directed to executing commands from the remote controller, which is different from the external mobile terminal. *See id.*; 8:6-20.

Prior to the filing of the '020 Patent application, internet video relay systems could not be seamlessly operated by a single mobile terminal, and instead needed additional operation of the display either directly by an operation input or by the use of additional remote controls. *See* EX1001 2:23-3:17. Furthermore, operators of these prior art systems would need to first terminate viewing in the mobile terminal in order to then view it on a separate screen. *See id.* This caused interruption in viewing. *See id.* Further, “change-over operations” of internet content from the mobile terminal to another display device, caused numerous problems. *See id.* For example, one problem was that the internet video content would restart from the beginning rather than resuming from the position of a scroll bar where it was being

viewed in the mobile terminal. *See id.*

The asserted claims of the '020 Patent recite an improved information processing apparatus. *See* EX1001 at Abstract, 3:34-53. Specifically they recite an improved video relay system with specific means of controlling the display video state of a display device according to distinct action-triggering information acquired and received from a mobile terminal. *See id.* The claimed identifier and instructions sent by the mobile terminal is specific state information that triggers operation of the display in a specific manner, (e.g., by passing a URL of target video content, login authentication information, Cookie information, or the position of a scroll bar or pointer indicating a relative position of the video). *See id.* 17:19-37. This achieves an improved level of automation that provides an advancement over the prior art systems, enabling the continuous reproduction of internet video content and smooth cooperative operation when the viewing of a content that is being viewed on a portable terminal is to be relayed or passed to a separate video playback display device. *See id.*

Prior to the priority date of the '020 Patent, video relay systems that display content acquired via the internet were not controlled solely by a mobile terminal by action-triggering information. *See* EX1001 2:23-3:17. The asserted claims of the

'020 Patent brought an improved solution to these systems by the use of instructions from the mobile terminal to control the display unit to perform changeover and operation of internet video content between the devices uninterruptedly. *See id.* at Abstract, 3:34-53. This results in the smooth, uninterrupted, and seamless relay of internet video content from a mobile terminal to a separate display device. *See id.*

B. Patent Prosecution History

U.S. Patent Application No. 16/118,080—which would ultimately issue as the '020 Patent—was filed on August 30, 2018, as the eighth in a series of continuation applications: U.S. Patent Application No. 15/845,680, filed on December 18, 2017; U.S. Patent Application No. 15/402,433, filed on January 10, 2017; U.S. Patent Application No. 14/919,367, filed on October 21, 2015; U.S. Patent Application No. 14/501,621, filed on September 30, 2014; U.S. Patent Application No. 14/029,548, filed on September 17, 2013; U.S. Patent Application No. 13/489,877, filed on June 6, 2012; and U.S. Patent Application No. 12/170,938, filed on July 10, 2008. All of these applications claim priority to JP Patent Application No. 2007-248353, filed on September 26, 2007.

The Examiner who examined the original U.S. application, U.S. Patent Application No. 12/170,938 (the “'938 Application”) also examined the application

for the '020 Patent (the “’080 Application”). In the Notices of Allowance, the Examiner noted three prior art references, as well as Applicant’s remarks from the prosecution of the ’938 Application.² The Examiner further noted specific characteristics of the three prior art references:

- Slotznick U.S. Patent Publication No. 2005/0282582 discloses a telephone device that is used to establish two-way communication with remotely located entity, or to transfer content from display screen for full viewing of the content. The two-way communication is initiated by an object emitting a signal containing a telephone number to the telephone device which in turn automatically dials the telephone number.
- Walker et al. U.S. Publication No. 2004/0242304 A1 discloses a gaming system that includes a network server connected to a plurality of gaming devices that are adapted to provide a video payout on each play based on a set of payout parameters. Memory of each gaming device stores payout parameters that correspond to each possible gaming result or outcomes. When a play is initiated by a player, a gaming result is generated at a gaming device.

² There were two notices of allowance issued, but both listed similar reasons for allowance.

- Goto U.S. Publication No. 2009/0030614 A1 discloses that in an information presenting apparatus, a frequency of usage of each term contained in one text or more is calculated for each user who has implemented an operation onto the text. Based on the frequency of usage of the terms, the frequencies of usage of each term are compared between a specific user and other users to find a difference there between, and terms for which the difference is equal to or larger than a predetermined value are presented.

These references were also cited as primary and secondary references during the prosecution of the '938 Application. *See, e.g.*, EX2001 ('938 Application File History) at 284, 290, 331. The Examiner issued four office actions and the Applicant filed two requests for continued examination before Examiner allowed the '938 Application. In addition, the Applicant submitted a third request for continued examination after allowance and submitted additional references for consideration.

C. Summary of Petitioner's Proposed Grounds for Unpatentability

Petitioner alleges that claims 1-6, 17-30 would have been obvious under pre-AIA 35 U.S.C. § 103 and raises two grounds of alleged unpatentability. *See* Pet. at 4-5. Ground 1 includes a challenge to all challenged claims 1-6, 17-30 based on Bennett (U.S. Patent Publication No. 2007/0124792) and the knowledge of a POSITA, and Ground 2 includes a challenge to claims 1-5, 23, and 30 based on

Bennett, Nashida (U.S. Patent Pub. No. 2003/0020693) and the knowledge of a POSITA. *Id.*

The alleged invalidity grounds are summarized as follows:

Ground	'020 Patent Claims	Type of Challenge	Primary Reference	Secondary References
1	1-6, 17-30	§ 103	Bennett	Knowledge of a POSITA
2	1-5, 23, 30	§ 103	Bennett	Nashida, Knowledge of a POSITA

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 ("POSITA") in September 2007 would have been familiar with display systems (such as television systems), remote controllers, control information, and user interaction. A POSITA would have had a working knowledge of computing, networking, and data representation. A POSITA would have gained knowledge of these concepts through a mixture of education and industry experience, such as by having a Bachelor's degree in computer science, computer communications, electrical engineering, or equivalent degree, coupled with two years of experience or by obtaining a Master's degree in those fields with less experience." Pet. at 11. However, Patent Owner

reserves the right to provide its own definition of a POSITA should the Board institute review of the '020 Patent.

IV. CLAIM CONSTRUCTION

Petitioner explicitly construes the term “operation instructions” as “commands and instructions used to operate a computer.” Pet. at 11-12. Since the filing of the Petition, the District Court has issued a District Court Claim Construction Order that rejected Petitioner’s proffered construction. See EX2002 at 30 (“TCL’s argument goes too far...The Court thus agrees with this aspect of Maxell’s construction, especially in light of the rest of the limitation, which recites ‘while the second video content is being displayed.’”). The District Court instead construed “operating instructions” as “commands and instructions used to operate second video content.” *Id.* at 30. That District Court noted that evidence, “especially, in light of the rest of the limitation, which recites ‘while the second video content is being displayed’...strongly suggests the ‘operation instructions’ relate to that ‘second video content.’” See *id.*

Because the same *Philips* standard applies, the claim terms at issue should be construed in the same way. See also 83 Fed. Reg. at 51342 (“[T]he scope of an issued patent should not depend on the happenstance of which court or governmental

agency interpret it, at least as far as the objective rules go.”). The construction is clearly supported by the claim language itself which requires that “operation instructions” be executed “**while** the second video content is being displayed.” See EX2002 at 30. This indicates that “operation instructions” be related to the second video content.

The construction is also supported by the specification that repeatedly and consistently explains operation instructions through all three embodiments refers to the second video content. See, e.g., EX1001 Figs. 8A, 12; 11:24-29, 13:66-14:11, 18:44-56. For example, the specification explains that when the TV “receives the information and the signal of the operation indication such as ‘move’ or ‘select’ from the cellular phone, the TV set reflects,... the information of the indication in the screen display 406 displaying the internet and in the operation of the browser 208 (step 517).” See *id.* at 11:24-29 (emphasis added). Thus, in view of these disclosures and the claim language itself, it is clear that “operation instructions” should be construed to mean “information for changing the display of the second video content such as move or selection operations.”

Thus, should the Board decide to institute this IPR, Petitioner proposes that the Board adopt the District Court’s construction of “operation instructions.”

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. §§ 312(a)(3), 314(a), and 325(d).

A. 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 '020 Patent, making this Petition ripe for denial of institution under § 325(d).

1. Part 1: The Same or Substantially the Same Art/Arguments Were Previously Presented

a. Petitioner's Key Reference for Both Grounds (Bennett) Was Previously Presented to the Office

Bennett was “previously presented to the Office,” as shown by its explicit listing on the face of the '020 Patent and appearance as a considered reference in the file history. EX1001 at 2; EX1002 at 132 (“All references considered except where lined through.”). Part 1 is thus met here as to Bennett.

Further evidence that Bennett's disclosures have been thoroughly considered by the Office is the fact that Bennett incorporates the disclosures of multiple related applications, also relating to television remote control. *See* EX1004 ¶ [0001] (stating that the “present application is related to” applications titled “Parallel Television Remote Control,” “Control Device with Language Selectivity,” “Parallel Television Docking Adapter,” and “Universal Parallel Television Remote Control”). All of these related Bennett references (which incorporate each other) were presented to the Examiner. *See* EX1001 at 2; EX1002 at 127-128, 132. Furthermore, other additional references by the same inventor, many related to television remote

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control, are explicitly listed on the face of the '020 Patent. *See* EX1001 at 2.

(56)

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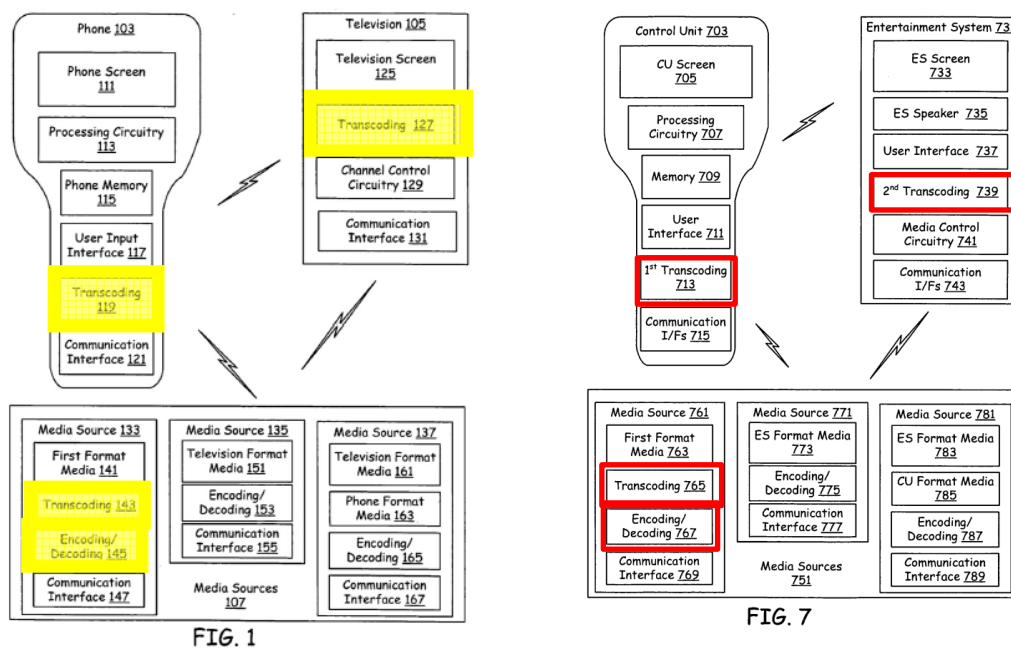
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See EX1001 at 2.

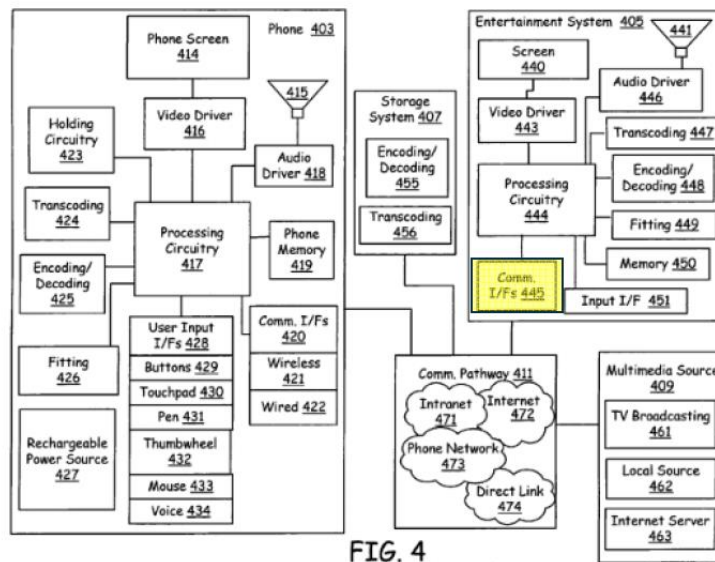
A review of these related references confirms that many of these references

all include substantially similar disclosures of Bennett that Petitioner relies upon for its arguments. For example, Petitioner relies upon Figures 1, 4, 6, and 10 of Bennett in its arguments. Substantially similar figures appear in other references previously presented to the Office, for example, in U.S. Patent Publication No. 2007/0124772 (“Bennett ’772”) (EX2003), U.S. Patent Publication No. 2007/0124777 (“Bennett ’777”) (EX2004), U.S. Patent Publication No. 2007/0124778 (“Bennett ’778”) (EX2005), and U.S. Patent Publication No. 2001/0124765 (“Bennett ’765”) (EX2006).



Compare Pet. at 24 (depicting an annotated Figure 1 of Bennett, annotations added by Petitioner to show transcoding and encoding/decoding) with EX2003 Fig. 7

(depicting substantially similar figure to Figure 1 of Bennett that shows transcoding, and encoding/decoding) and EX2004 Fig. 2 (depicting similar figure to Figure 1 of Bennett that shows transcoding, and encoding/decoding).



Pet. at 26 (depicting annotated Figure 4 of Bennett, annotations added by Petitioner

to show communication interface).

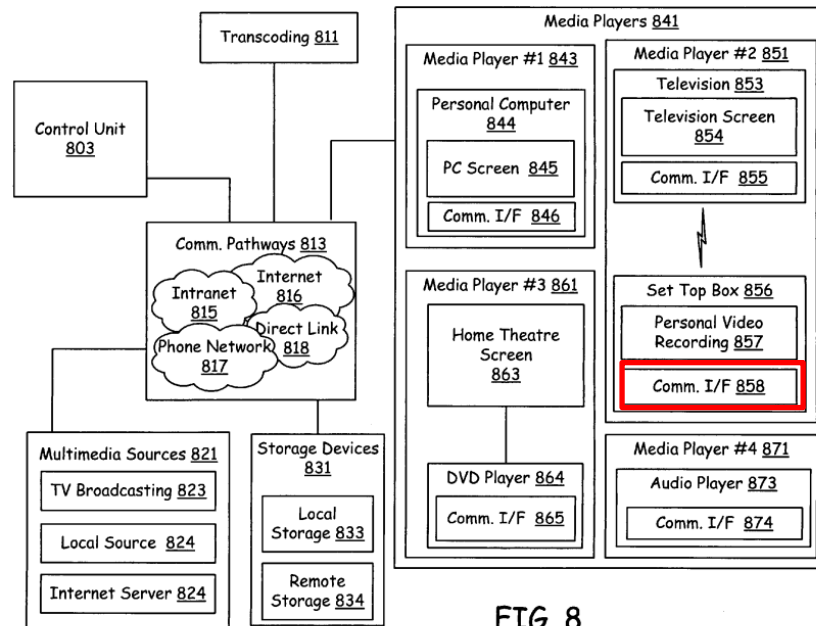


FIG. 8

Compare Pet. at 26 (depicting annotated Figure 4 of Bennett, annotations added by Petitioner to show communication interface) with EX2003 Fig. 8 (depicting substantially similar figure to annotated Figure 4 of Bennett showing communication interface).

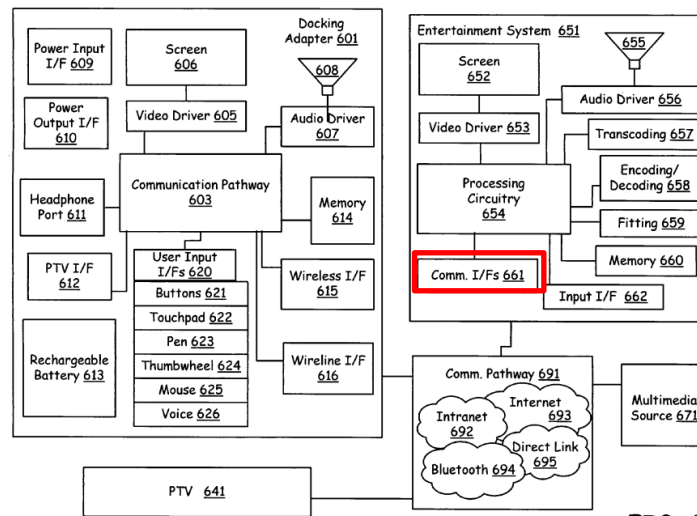


FIG. 6

Compare Pet. at 26 (depicting annotated Figure 4 of Bennett, annotations added by Petitioner to show communication interface) *with* EX2005 Fig. 6 (depicting similar figure to annotated Figure 4 of Bennett showing communication interface).

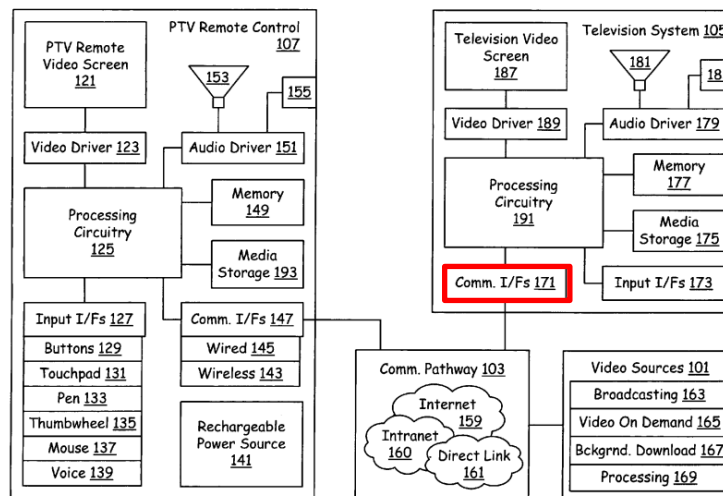


Figure 1

Compare Pet. at 26 (depicting annotated Figure 4 of Bennett, annotations added by Petitioner to show communication interface) *with* EX2006 (US 2007/0124765) Fig. 1 (depicting substantially similar figure to annotated Figure 4 of Bennett to show communication interface).

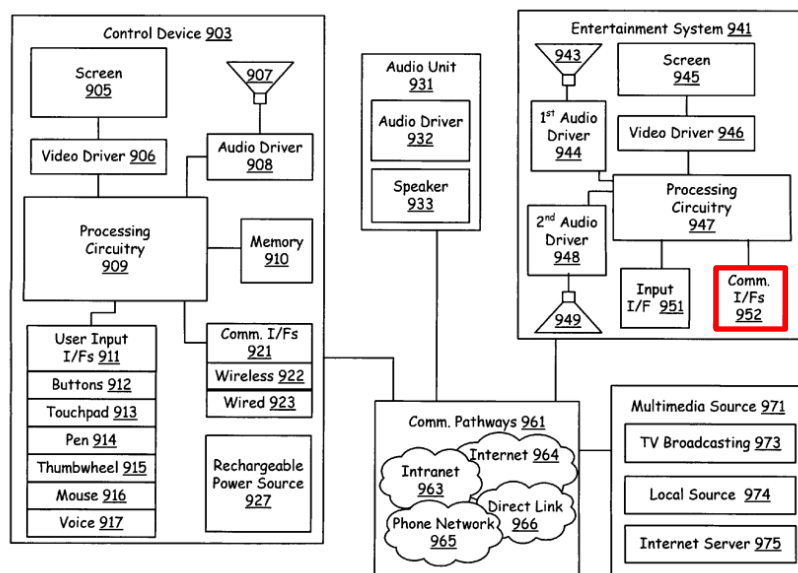
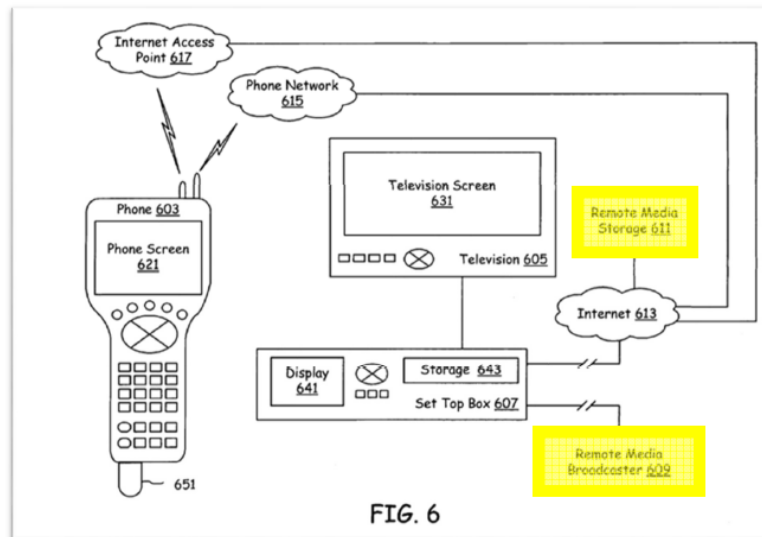
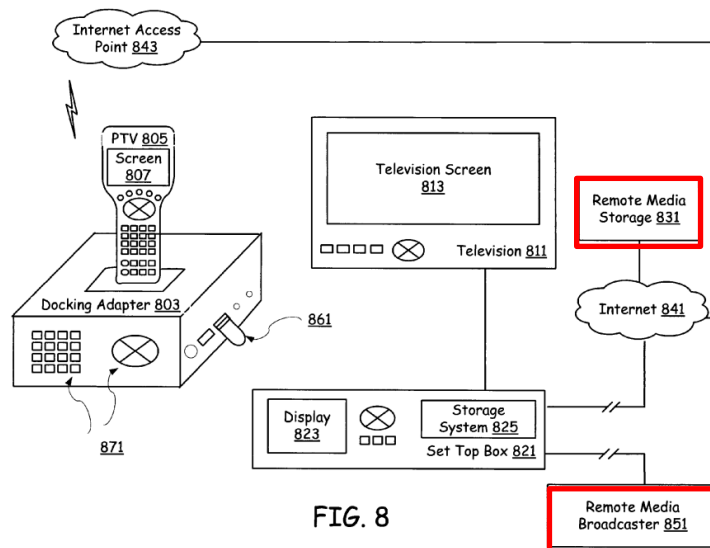


FIG. 9

Compare Pet. at 26 (depicting annotated Figure 4 of Bennett, annotations added by Petitioner to show communication interface) *with* EX2004 (2007/0124777) Fig. 9 (depicting substantially similar figure to annotated Figure 6 of Bennett showing communication interface).



Pet. at 18 (depicting annotated Figure 6 of Bennett with annotations added by Petitioner to show remote media storage and remote media broadcaster).



Compare Pet. at 18 (depicting annotated Figure 6 of Bennett with annotations added by Petitioner to show remote media storage and remote media broadcaster) with

EX2005 Fig. 8 (depicting substantially similar figure to annotated Figure 6 of Bennett that shows remote media storage and remote media broadcaster).

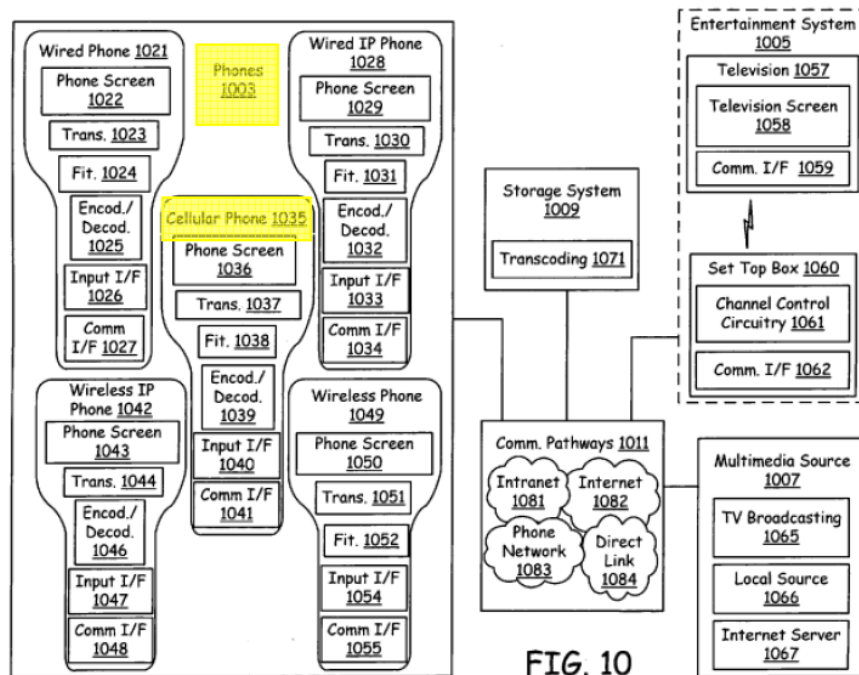


FIG. 10

Pet. at 40 (depicting annotated Figure 10 of Bennett, with annotations added by Petitioner to show multiple devices that can communicate with television).

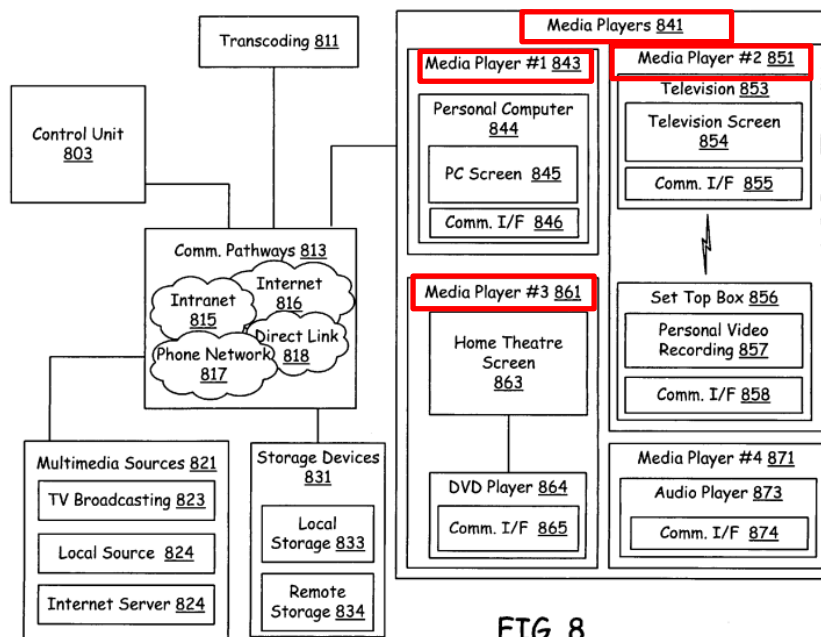


FIG. 8

EX2003 (depicting similar figure to Figure 10 of Bennett that shows multiple devices that can communicate with television (set top box 856)).

The fact that not one, but several references disclosed the same or substantially the same diagrams that Petitioner relies upon further shows that the Office thoroughly evaluated the disclosures of the Bennett reference that are cited in the Petition.

Furthermore, Bennett is substantially the same as art or arguments evaluated by the Examiner during prosecution of the '020 Patent, as well as in related applications. For example, in the Notice of Allowance, the Examiner specifically

identified and characterized three prior art references: Slotznick U.S. Publication No. 2005/0282582, Walker (U.S. Patent Publication No. 2004/024230), and Goto (U.S. Patent Publication No. 2009/0030914).

Slotznick discloses substantially similar disclosures to the sections of Bennett (and arguments related to the knowledge of a POSITA) cited in the Petition. For example, Slotznick, like Bennett, is a method of using a phone as a remote for a television. EX2007 (Slotznick) ¶ [0004]. (“An appliance acts as a wireless phone, a TV remote, and an automatic dialer of phone numbers (or web sites) displayed on the TV.”).

Furthermore, Slotznick was the primary reference asserted by the Examiner in relation to a parent application of the '020 Patent. *See, e.g.*, EX2001 at 284. This parent application was examined by the same Examiner (Arvin Eskandarnia) who allowed the '020 Patent. *See* EX1001 at 1; EX2001 at 86. Furthermore, the Examiner specifically noted in the Notice of Allowance of the '020 Patent that “Applicant’s remarks filed 12/8/11 are deemed persuasive over the prior art of record” in relation to remarks filed with respect to the parent application. Moreover, the '020 Patent is a continuation of the parent patent application, which led to the '459 Patent. *See supra* Section II.B; EX1001 at 1-2. And not only are the specification and drawings

of the '459 Patent and the '020 Patent materially identical, as further shown below, they share similar claim limitations in their independent claims. *See supra* Section VI.A.1.c-VI.A.1.d. Thus, the prosecution history of the '459 Patent is to be considered “with equal force” as the prosecution history of the '020 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).

Bennett discloses a system that is substantially the same as Slotznick’s. For

example, in relation to the Preamble, Petitioner relies on Figure 6 of Bennett, but it discloses the same type of diagram as Slotznick.

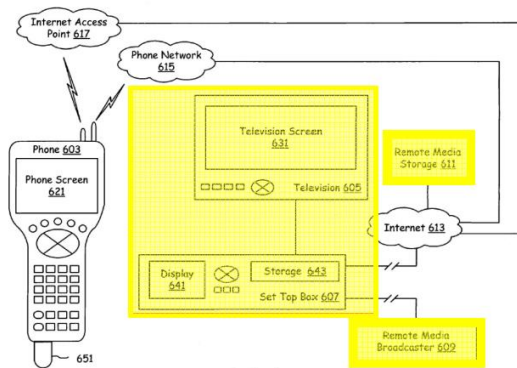


FIG. 6

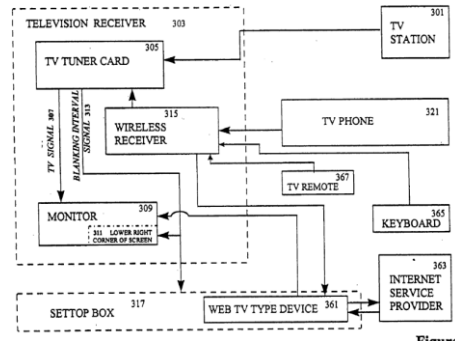


Figure 7

Pet. at 16. EX2007 Figure 6.

As seen above, relied-upon portions of Bennett, which include “a phone coupled with a set top box and a remote media broadcaster” are cumulative of disclosures of the “TV phone,” “settop box and television receiver” and “TV station/web tv type device” of Slotznick previously presented to the Office.

b. Petitioner's Additional Reference (Nashida) Is the Same or Substantially the Same as Those Previously Presented to and Considered by the Office

Petitioner relies on Nashida in Ground 2 in combination with the previously considered reference, Bennett. Nashida, similar to Bennett, also discloses a system of remote control “comprising a remote controller and an image display apparatus (television). EX1005. Indeed, Petitioner alleges that Bennett and Nashida are

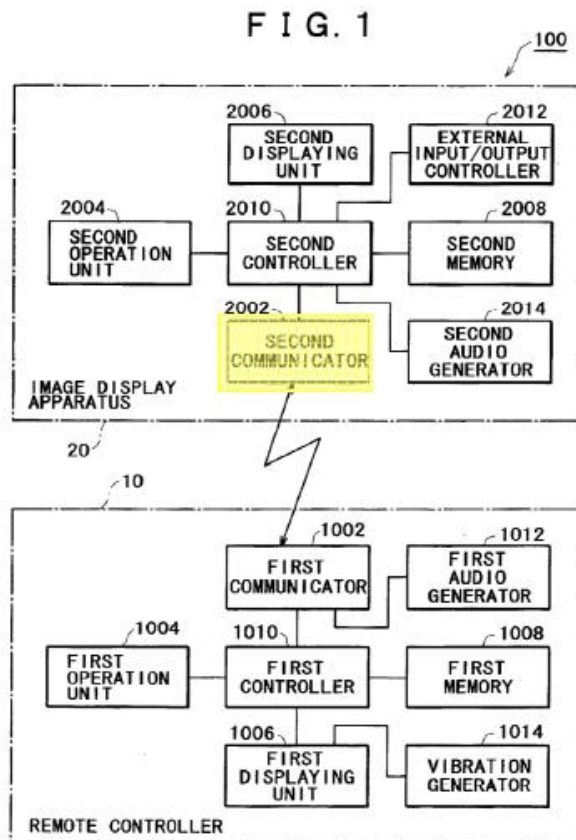
directed to the same field of endeavor. Pet. at 67. Along with Bennett and its related applications, many other references related to remote control systems were considered during prosecution of the '020 Patent.

OTHER PUBLICATIONS

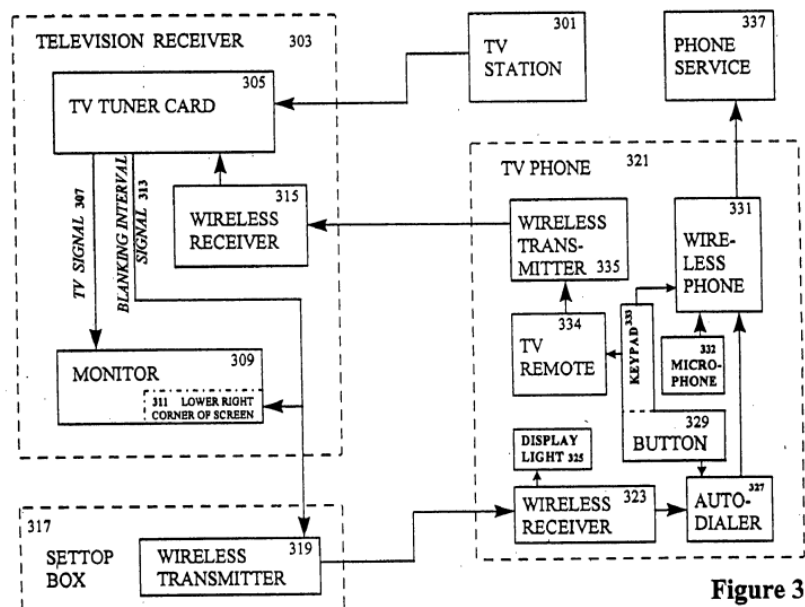
Touchpad remote control | product lineup | The personal computer television—Internet AQUOS: A sharp and Internet Archive, Mar. 20, 2007 URL: <http://web.archive.org/web/20070320153603/http://www.sharp.co.jp/i-aquos/products/ax120s/remocon.html> w/English language translation.

Shih-Hsiang Lo, Controlling Digital TV Set-Top Box with Mobile Device via an IP Network, May 20, 2006, IEEE fellow, pp. 935-942.
Takuji Imai, "SONY demonstrated a new feature of DLNA 1.5, in which images are thrown and caught on PSP and liquid crystal TV," issued on Jan. 12, 2006, Nikkei Electronics, w/ English translation.

Nashida also discloses a system discussing communication between a remote controller and an image display apparatus:



This is substantially the same as Bennett's and Slotznick's disclosures, which were previously presented to the Office. As shown in Figure 3 of Slotznick, Slotznick shows similar disclosure of wireless connectivity between phone and television/settop box by use of *wireless transmitters and wireless receivers*. See EX2007 Fig. 3.



Therefore, Nashida is cumulative to art and arguments previously presented to the Office, particularly Slotznick and Bennett.

c. Petitioner's Ground 1 Art and Arguments Are the Same or Substantially the Same as Art or Arguments Previously Presented to the Office

Furthermore, Petitioner's arguments (based on Bennett and the knowledge of a POSITA) are the same or substantially similar to Slotznick or arguments presented in relation to Slotznick for all limitations of independent claim 1 (the only independent claim asserted in the Petition).

Regarding [A], Petitioner maps "a digital broadcast receiver configured to receive a digital broadcast signal" to the HDTV capability of Bennett and that a

POSITA would know that HDTV capability was synonymous with including a digital broadcast receiver to receive a digital broadcast signal. Pet. at 17. This is substantially similar to Slotnick's disclosure. *See* EX2007 ¶ [0158] ("HDTV"). In addition, the Examiner previously considered the limitation of "a broadcast receiving unit which receives broadcast data" as disclosed by a television receiver in Slotnick. EX2001 at 337. Therefore, Petitioner's art and arguments for [A] comprises substantially the same art or arguments already presented to the Office.

Regarding [B], Petitioner states that "a signal separator for de-multiplexing the digital broadcast signal into video data and audio data" would be obvious to a POSITA in light of digital television technology (HDTV technology). *See* Pet. at 20. Petitioner relies on the same portion of Bennett for [B] as [A], which was previously discussed to be substantially the same disclosure as Slotnick. Therefore, Petitioner's art and arguments for [B] comprises substantially the same art or arguments already presented to the Office.

Regarding [C], Petitioner stated that "a video processor configured to convert the format of the video data" is disclosed by "transcoding, encoding and decoding" features of Bennett. Pet. at 23-24. The cited portion of Bennett's disclosure is substantially similar to Slotnick's disclosure. *See* EX2007 ¶ [0015] ("In some

embodiments, the TV Phone acts as a ‘picture phone,’ transmitting **video** along with the audio.” (emphasis added)), ¶ [0089] (“The local control device may require the use of a **decoder** to **convert** the **signal received from the telephone device** [which can include video] into a format for viewing by the nearby display screen.”). Therefore, Petitioner’s art and arguments for [C] comprises substantially the same art or arguments already presented to the Office.

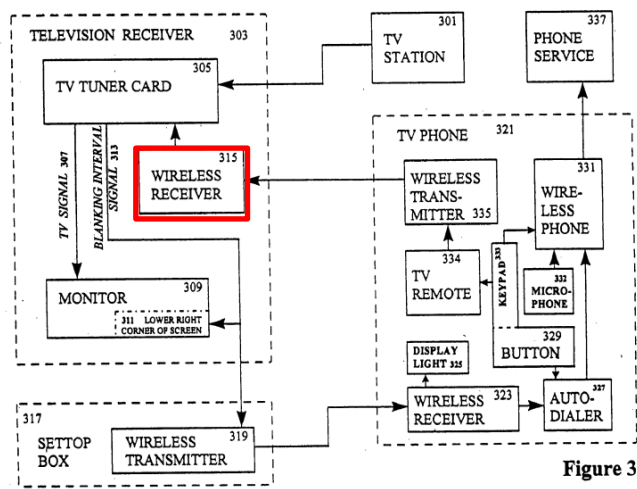
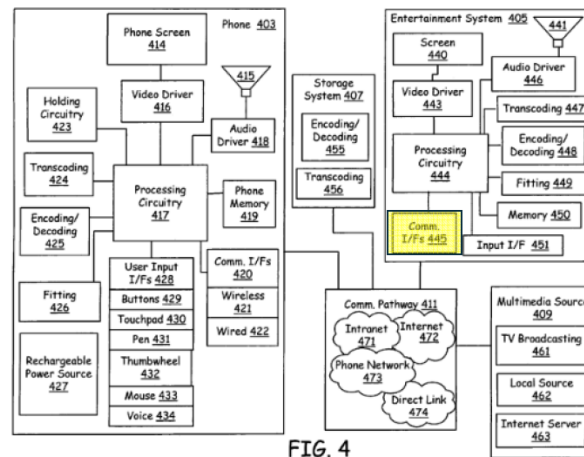
Regarding [D], Petitioner states that “an audio processor configured to convert the format of the audio data” is disclosed by “transcoding, encoding and decoding” features of Bennett. Pet. at 24-25. The cited portion of Bennett’s disclosure is substantially similar to Slotznick’s disclosure. See EX2007 ¶ [0015] (“In some embodiments, the TV Phone acts as a ‘picture phone,’ transmitting video along with the **audio**.” (emphasis added)), ¶ [0089] (“The local control device may require the use of a **decoder** to **convert the signal received from the telephone device** [which can include audio] into a format for viewing by the nearby display screen.”). Therefore, Petitioner’s art and arguments for [D] comprises substantially the same art or arguments already presented to the Office.

Regarding [E], Petitioner states that “a network communication module configured to communicate over the internet” can be disclosed based on a Bennett’s

“communication interface” and the disclosure that content can be retrieved from an Internet server. Pet. at 25-26. This is substantially similar to Slotznick’s disclosure. Slotznick ¶ [0014] (discussing that TV channels can be “TV style, or Internet style” and further discussing a wireless receiver). In the prosecution of the “’938 Application,” the Examiner also explicitly mapped Slotznick’s “wireless receiver” to a “network communication unit.” See EX2001 at 337. Therefore, Petitioner’s art and arguments for [E] comprises substantially the same art or arguments already presented to the Office.

Regarding [F], Petitioner states that “a radio receiver for receiving data from an external mobile terminal” can be disclosed in relation to Bennett’s disclosure that “[t]he phone 103 is communicatively coupled to the television 105 ... over ... wireless links.” See Pet. at 26-27. The cited portion of Bennett’s disclosure is substantially similar to Slotznick’s disclosure, and the Examiner explicitly noted this part of Slotznick’s disclosure in the prosecution of the ’938 Application. EX2001 at 337 (stating that “a communication unit which conducts communication with a portable terminal” is disclosed by Figure 3 of Slotznick which shows the “set-top box [] performing communication with the TV phone”). Further, Figure 3 of Slotznick is substantially similar to Bennett’s Figure 4 of wireless transmission from

phone to television/settop box by use of wireless transmitters and wireless receivers.



Compare Pet. at 26 (showing Figure 4 of Bennett) with EX2007 Fig. 3. Therefore, Petitioner's art and arguments for [F] comprises substantially the same art or arguments already presented to the Office.

Regarding [G], Petitioner states that "an infra-red (IR) receiver for receiving

commands from a remote controller” is disclosed by Bennett’s mention of using an infrared link to control an entertainment system with a phone. Bennett’s disclosure in this regard is substantially the same disclosure as Slotznick’s. See EX2007 ¶ [0021] (“When the viewer...clicks on a button on the TV Phone....this sends a wireless signal to the set-top box. The wireless signal may be an ***infrared signal***.” (emphasis added)). The Examiner cited this same paragraph of Slotznick in disclosing language related to an “infrared-ray communication unit.” EX2001 at 340. Therefore, Petitioner’s art and arguments for [G] comprises substantially the same art or arguments already presented to the Office.

Regarding [H], Petitioner states that “a display panel” is disclosed via a “television screen 125” or “screen 440” of Bennett. Bennett’s disclosure in this regard is substantially the same as Slotznick’s disclosure. See EX2007 Fig. 3 (showing monitor/television screen). The Examiner explicitly cited Figure 3 of Slotznick to disclose a “display unit.” EX2001 at 340. Therefore, Petitioner’s art and arguments for [H] comprises substantially the same art or arguments already presented to the Office.

Regarding [I], Petitioner states that “a system controller configured to control the display apparatus to” is disclosed through “processing circuitry” in the set-top

box” that acts to control what is displayed on the display screens. Pet. at 30-31. The cited portion of Bennett’s disclosure is substantially similar to Slotznick’s disclosure. *See* EX2007 ¶ [0147] (“The data is processed by electronics associated with this wireless receiver (not shown separately) and then displayed on the television monitor 309.”). Therefore, Petitioner’s art and arguments for [I] comprises substantially the same art or arguments already presented to the Office in view of Slotznick.

Regarding [I.1] and [I.2], Petitioner states these limitations are satisfied by Bennett’s set-top box that receives a first television channel from a media source and forwards the video portion of the first television channel to the television screen. Pet. at 31-32. The cited portions of Bennett include substantially the same disclosures as Slotznick. *See* EX2007 Fig. 3 (showing TV tuner card to receive information from TV station and monitor to display content), ¶ [0145] (“changing the channels via the built in TV remote 334 tells the wireless data receiver 409 which network or local channel is active, and which phone numbers to use”). Therefore, Petitioner’s art and arguments for [I.1] and [I.2] comprise substantially the same art or arguments already presented to the Office.

Regarding [I.3], Petitioner states this limitation is satisfied based on Bennett’s

“cellphone communicating to display multimedia elements on the display device.” Pet. at 32. This portion of Bennett’s disclosure is substantially similar to Slotznick’s disclosure. EX2007 at Abstract (“A telephone device is used to establish two-way communication with a remotely located entity, or to transfer content from a display screen of the telephone device to a nearby display screen for full viewing of the content.”). Petitioner also states that this is alternatively taught by the use of a “media guide” for the user to select video content in Bennett. However, Bennett’s disclosure of media guide is substantially similar to disclosures of Slotznick. Slotznick discusses “online or broadcast program guides (including ***interactive program guides***)” and states that the phone can be used as a remote to select options (such as options in an interactive program guide) and forward commands to the TV regarding the selection of an option. EX2007 ¶ [0130] (“The TV phone 321 also can be used as a remote control for the Television Receiver 303.... The wireless receiver 315 receives data for changing a channel, increasing or decreasing volume of audio, powering the system on or off, or the like, in the same manner it receives data from a standard TV remote control device, and then forwards the commands to the TV tuner card 305, which executes the desired operation.”). Therefore, Petitioner’s art and arguments for [I.3] comprises substantially the same art or arguments already

presented to the Office.

Regarding [I.4], Petitioner states this limitation is satisfied by Bennett's disclosure that "video content can be acquired 'via the internet' using 'said identifier.'" Pet. at 34. However, the cited portion of Bennett's disclosure is substantially the same as Slotznick's disclosure. EX2007 ¶ [0133] ("When the WebTV device 361 receives data from the Internet Service Provider 363, the data is displayed on the TV monitor 309."), ¶ [0133] ("The user can input information to the WebTV device (e.g., by clicking on hyperlinks or by typing e-mail) using the keyboard 365 or the TV remote 367."). Therefore, Petitioner's art and arguments for [I.4] comprises substantially the same art or arguments already presented to the Office.

Regarding [I.5], Petitioner states this limitation is disclosed by Bennett's display of a received media element on the television. Bennett's disclosure is substantially similar to Slotznick's disclosure. See EX2007 ¶ [0133] ("When the WebTV device 361 receives data from the Internet Service Provider 363, the data is displayed on the TV monitor 309."). Therefore, Petitioner's argument for [I.5] comprises substantially the same art or argument already presented to the Office.

Regarding [I.6]. Petitioner states that this limitation is satisfied by Bennett's

media swapping, where the entertainment system terminates display of a first media element and commences display of a second multimedia element. Pet. at 37. The “media swapping” disclosure of Bennett is substantially similar to Slotznick’s disclosures. EX2007 ¶ [0031] (“In other applications, input from the phone may cause a change in the video and audio displayed on the TV, e.g., cause transmission of pay per view movie, cause a signal that enables the set-top box to descramble a pay per view movie or channel (while charging the user's account or credit card), cause the TV to display an Internet web page, etc.”). Therefore, Petitioner’s argument for [I.6] comprises substantially the same art or argument already presented to the Office.

Regarding [I.7], Petitioner states that this limitation is satisfied by disclosures of Bennett’s radio receiver, processing circuitry that can “execute operation instructions,” and media swapping. The disclosure of Bennett in relation to this limitation is substantially similar to Slotznick’s disclosure. See EX2007 ¶ [0130] (“The TV phone 321 also can be used as a remote control for the Television Receiver 303.... The wireless receiver 315 receives data for changing a channel, increasing or decreasing volume of audio, powering the system on or off, or the like, in the same manner it receives data from a standard TV remote control device, and then

forwards the commands to the TV tuner card 305, which executes the desired operation.”), ¶ [0031] (“In other applications, input from the phone may cause a change in the video and audio displayed on the TV.”). Therefore, Petitioner’s art and arguments for [I.7] comprises substantially the same art or arguments already presented to the Office.

Regarding [I.8], Petitioner states that this limitation is met by Bennett’s infrared receiver for receiving commands from a remote controller. The cited disclosure of Bennett’s is substantially similar to Slotznick’s disclosure. EX2007 ¶ [0021] (“Like *other remote controls*, this sends a wireless signal to the set-top box. The wireless signal may be an *infrared signal*.” (emphasis added)), ¶ [0124] (discussing use of “hand-held remote control 239” to control television). Therefore, Petitioner’s argument for [I.8] comprises substantially the same art or argument already presented to the Office.

As shown above, Petitioner’s art and arguments for Ground 1 comprises substantially the same art or argument already presented to the Office.

d. Petitioner’s Ground 2 Art and Arguments Are the Same or Substantially the Same as Art and Arguments Previously Presented to the Office

Furthermore, Petitioner’s Ground 2 art and arguments (based on Bennett,

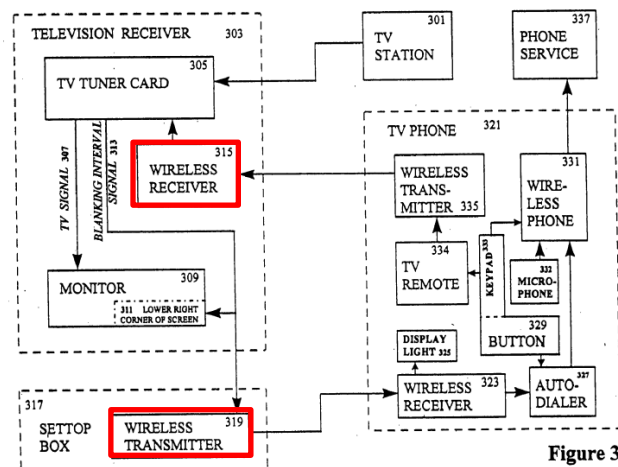
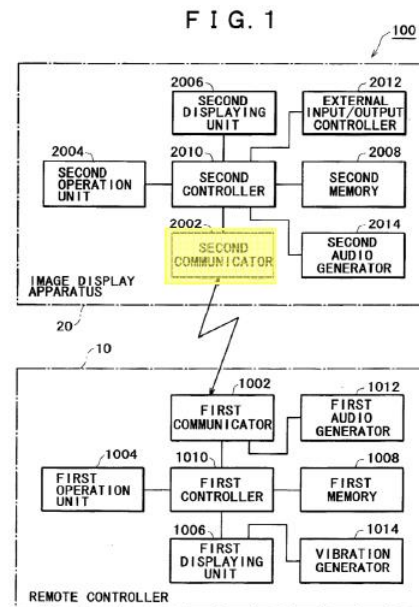
Nashida, and the knowledge of a POSITA) were all previously presented (and considered) in view of Slotznick in relation to all of the limitations of independent claim 1 (the only independent claim asserted in the Petition):

Regarding [A], Petitioner argues that Nashida's external input/output controller 2012 is configured to receive an image signal and an audio signal of a television broadcast. Pet. at 69. Nashida's cited disclosure is substantially the same as Slotznick's. See EX2007 ¶ [0069] ("The object may be a set-top box of a TV system. If so, then the set-top box receives the telephone number from broadcast signals sent over the TV system."). Additionally, the Examiner previously considered the limitation of "a broadcast receiving unit which receives broadcast data" as disclosed by a television receiver in Slotznick. EX2001 at 337. Therefore, Petitioner's argument for [A] comprises substantially the same art or argument already presented to (and considered by) the Office.

Regarding [B]-[E], the Petition provides no argument for how a combination of Bennett, Nashida, and the knowledge of a POSITA render these limitation obvious. See Pet. 70-72 (failing to provide any rationale regarding limitations [B]-[E] between sections relation to limitation [A] and [F]). To the extent the Board assumes (it should not) that Petitioner is actually asserting arguments from Ground

1 here, Petitioner's arguments for [B]-[E] comprises substantially the same art or argument already presented to the Office for the same reasons presented above with Ground 1. *See supra* Section VI.A.1.c.

Regarding [F], Petitioner argues that Nashida's disclosure of a second communication in the image display apparatus for wireless communication with a first communicator satisfies this limitation (in combination with Bennett). *See Pet.* at 72. As described above in relation to Ground 1 and Bennett, the Examiner already considered Slotznick's discussion of a phone that can wirelessly send information to a television. EX2001 at 337 (stating that "a communication unit which conducts communication with a portable terminal" is disclosed by Figure 3 of Slotznick which shows the "set-top box [] performing communication with the TV phone"). Nashida's cited disclosure is substantially similar to Slotznick's disclosure. *Compare Pet.* at 72 (showing annotated Figure 1 of Nashida) *with* EX2007 Fig. 3.



Therefore, Petitioner's argument for [F] comprises substantially the same art or argument already presented to (and considered by) the Office.

Regarding [G], Petitioner argues that "an infra-red (IR) receiver for receiving commands from a remote controller" is disclosed by Nashida's mention of using an

infrared-ray receiving/emitting device for communicating between the image display apparatus and the remote control. This cited disclosure of Nashida's is substantially similar to Slotznick's disclosure. EX2007 ¶ [0021] ("When the viewer...clicks on a button on the TV Phone....this sends a wireless signal to the set-top box. The wireless signal may be an ***infrared signal***." (emphasis added)). The Examiner cited this same paragraph of Slotznick in disclosing language related to an "infrared-ray communication unit." EX2001 at 340. Therefore, Petitioner's argument for [G] comprises substantially the same art or argument already presented to (and considered by) the Office.

Regarding [H]-[I.2], Petition provides no argument or evidence for how a combination of Bennett, Nashida, and the knowledge of a POSITA render these limitations obvious. See Pet. at 73 (failing to provide any rationale regarding limitations [H]-[I.2] between sections relation to limitation [G] and [I.3]). To the extent the Board assumes (it should not) that Petitioner is actually asserting arguments from Ground 1, Petitioner's arguments for [H]-[I.2] comprises substantially the same art or argument already presented to the Office for the same reasons presented above with Ground 1. See *supra* Section VI.A.1.c.

Regarding [I.3]-[I.4], Petitioner argues these limitations are satisfied based

on Nashida's disclosure that "controller 1010 transmits a command of requesting a transmission of a URL." Pet. at 73-74. Petitioner specifically accuses the remote controller of Nashida to transmit a URL to the television to disclose this limitation. *See id.* However, while Petitioner attempts to portray this Nashida disclosure as a transmission of a URL information **from a remote controller** to a display apparatus (e.g., a television), Nashida **actually** discloses that the URL is sent **from the television** to the remote controller. EX1005 ¶ [0121]. *See infra* Section VII.B.1.

Because Nashida fails to disclose or render obvious what Petitioner is asserting, these disclosures of Nashida should not be relevant in discussion of previously presented art or arguments. However, for the sake of comprehensiveness, the Petitioner's cited portions Nashida's include substantially the same disclosures as Slotznick's. *See* EX2007 ¶¶ [0073]-[0074], [0079] ("The electronic address may be a web site address of the remotely located entity.").

Regarding [I.5]-[I.8], Petition provides no argument or evidence for how a combination of Bennett, Nashida, and the knowledge of a POSITA render these limitation obvious. *See* Pet. at 74-75 (failing to provide any rationale regarding limitations [I.5]-[I.8] between sections relation to limitation [I.4] and Claim 2). To the extent the Board assumes (it should not) that Petitioner is actually asserting

arguments from Ground 1, Petitioner's arguments for [I.5]-[I.8] comprises substantially the same art or argument already presented to the Office for the same reasons presented above with Ground 1. *See supra* Section VI.A.1.c.

2. Part 2: Petitioner Has Not Demonstrated Material Error in Allowance of the '020 Claims

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*, IPR2019-01469 at Paper 8. 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."). Notably, Petitioner appears to recognize that Bennett was cited in an IDS (which satisfies Part 1) but fails to even address Part 2 with respect to the Office's prior consideration of such references or similar obviousness arguments. *See* Pet. at 5.

Petitioner completely fails to address why either the prior consideration of

Bennett, or the combination of Slotznick, Walker, and Goto, is material error. The fact that the Examiner explicitly acknowledged remarks made in relation to the parent application, further supports a conclusion that the Examiner thoroughly considered the prosecution history of the '020 Patent and carefully evaluated the Slotznick, Walker, and Goto references.

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 makes only a conclusory remark that "Bennett and Nashida were not addressed by the Examiner during prosecution of the '020 Patent" and that the "Examiner did not have access to the expert testimony of Dr. Wolfe." 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*, IPR2019-01469, Paper 6, 8; *Albany Int’l Corp.*, PGR2021-00019, Paper 22, 10-11.

B. 35 U.S.C § 312(a)(3) Weighs in Favor of Denying Institution

“It is Petitioner’s burden to explain specifically how the references would be combined to produce the claimed invention.” *Lowe’s Home Centers, LLC v. Epistar Corp.*, IPR2018-00932, Paper 7, at 19 (P.T.A.B. Nov. 1, 2018) (citing *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016)). Indeed, this requirement is set out in the statutory text of 35 U.S.C. § 312(a)(3)—“the petition identifies, in writing and ***with particularity, each claim challenged, the grounds on which the***

challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” For each of the individual reasons herein, the Petition lacks this explanation and therefore Ground 2 fails and should not be instituted.

Petitioner fails to recite any evidence or argument for (or even address at all) claim limitations [B]-[E], [H]-[I.2], and [I.5]-[I.8] with respect to Ground 2. *See* Pet. 70-72. There is no way to discern Petitioner’s arguments and evidence if they are not asserted. Further, “[i]t 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,” but that is what the Petitioner asks the Board and Patent Owner to do here. *Microsoft Corp. v. FG SRC, LLC*, 860 Fed. Appx. 708, 713 (Fed. Cir. 2021). The absence of any discussion with regard to limitations [B]-[E], [H]-[I.2], and [I.5]-[I.8] asks the Board and Patent Owner to interpret which limitations from each reference 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. Due to the complete absence of any discussion regarding limitations [B]-[E], [H]-[I.2], and [I.5]-[I.8], Petitioner fails to provide any specific motivations to combine in relation to [B]-[E], [H]-[I.2], and

[I.5]-[I.8]. Petitioner only provide general motivation-to-combine discussions up front in relation to Ground 2.

However, Petitioner’s general motivation-to-combine statements are not sufficient. While the features of a secondary reference need not be bodily incorporated into the structure of the primary reference, a “clear, evidence-supported account of the contemplated workings of the combination is a prerequisite to adequately explaining and supporting a conclusion that a relevant skilled artisan would have been motivated to make the combination and reasonably expect success in doing so” is required. *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017). Petitioner’s failure to address motivation to combine in relation to specific claim limitations cannot meet its burden to establish a reasonable likelihood of success. *ADT LLC v. Vivint, Inc.*, IPR2022-00642, Paper 7, at 13-14 (P.T.A.B. Oct. 4, 2022) (denying institution where the petition mapped each limitation to both reference but “without any discussion of the interplay between these two references”).

C. 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 83.

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. EX2009. 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. EX2009 at 2. Petitioner knew of this trial date seven months prior to filing the Petition. *See* EX2008 at 2. 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. Fact discovery closes March 3, 2025 and expert discovery closes May 5, 2025. The Court has also conducted a *Markman* Hearing (Dkt. 117) and issued a claim construction order.

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, e.g.*, EX2008; EX2009. 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. March 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 1-6, 17-30 of the '020 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 Bennett and Nashida references in its contentions five months before filing its Petition. EX2010 at 11.

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 83.

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).

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 any of the challenged claims 1-6, 17-30 are rendered obvious by Bennett and the knowledge of a POSITA or that claims 1-5, 23, and 30 are rendered obvious by Bennett, Nashida, and the knowledge of a POSITA.

A. Petitioner Fails to Establish that Ground 1 Would Have Been Obvious Based on Bennett and the Knowledge of a POSITA

As explained below, Petitioner has not shown a likelihood of prevailing with respect to Ground 1. Bennett in view of the knowledge of a POSITA fails to disclose at least claim limitations [I.3], [I.4] and [I.7].

1. Petitioner Fails to Establish that Claim Limitation [I.3] Would Have Been Obvious in View of Bennett and Further in View of the Knowledge of a POSITA

Petitioner fails to disclose that Bennett and the knowledge of a POSITA, whether taken alone or in reasonable combination, would disclose or suggest limitation [I.3]: receive an identifier for identifying a second video content from the external mobile terminal.

Petitioner cites Bennett's "control signal" to disclose the "identifier" of [I.3]. Pet. at 32-33. However, Petitioner fails to establish any sort of "identifier" in the control signal of Bennett that can be used to identify the second video content. Bennett only states that the "control signal" "triggers the TV to implement the changes" but fails to disclose any sort of identifier or other information that is transmitted within the control signal itself to trigger those changes in the TV. See EX1004 ¶ [0008]. Additional deficiencies of Petitioner's mapping will be shown with respect to limitation [I.4], which further clarifies how the identifier is used.

Therefore, Bennett and the knowledge of a POSITA fail to disclose or suggest claim limitation [I.3]. Because the remaining challenged claims all depend from independent claim 1, Petitioner has failed to demonstrate that **any** challenged claim is rendered obvious based on Bennett and the knowledge of a POSITA.

2. Petitioner Fails to Establish that Claim Limitation [I.4] Would Have Been Obvious in View of Bennett and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Bennett in view of the knowledge of a POSITA discloses or suggests claim limitation [I.4]: “acquire the second video content via the internet using said identifier.”

For example, Petitioner fails to provide any evidence or even argument that the second video content is acquired *via the internet using said identifier*. Petitioner has already mapped “identifier” to Bennett’s control signal, and must now show this control signal is used to acquire the second video content via the internet. *See* Pet. at 34-36. Petitioner fails, however, to present any evidence or argument that the control signal, received from Bennett’s phone, is used to acquire video content via the Internet. This is true for both arguments posited by Petitioner: whether Petitioner maps “said identifier” to: (a) the control signal, or (b) a URL. *See* Pet. at 34-35.

Starting with the first argument, Petitioner asserts that the control signal sent from a phone to Bennett’s television system is the “said identifier” of limitation [I.4]. Petitioner then discusses that Figure 6 discloses that Bennett’s set-top box is capable of “retriev[ing] the video content from ‘Internet 613’ using the ‘control signal.’” Pet. at 34. Petitioner’s annotated Figure 6 of Bennett is reproduced here as well for

reference:

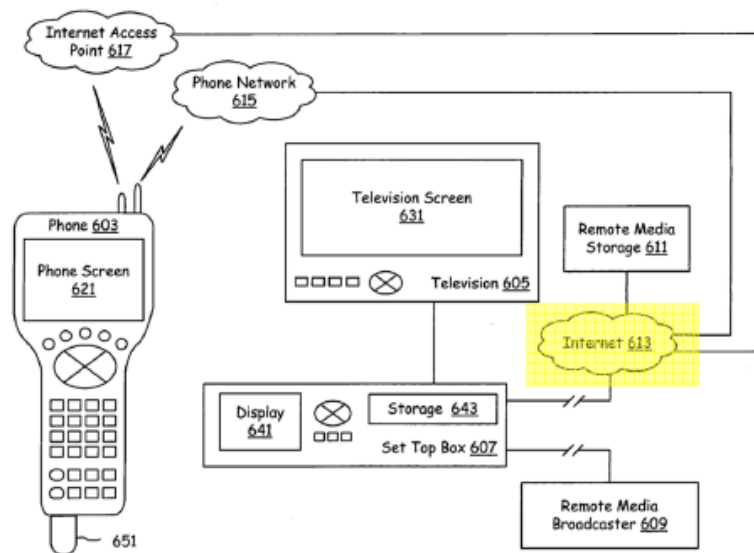


FIG. 6

Pet. at 35. The glaring gap in Petitioner’s analysis is that there is no disclosure in Figure 6 of Bennett of actually using the control signal received from the phone to obtain content from the Internet. All of Petitioner’s evidence indicates that the control signal is sent from the phone, to the television, and not further used. See EX1004 Fig. 6; Pet. at 35.

Additionally, Figure 6 of Bennett is simply a “schematic block diagram” illustrating an embodiment of the phone and also showing that the set top box has “three communication interfaces...one to communication over the Internet 613.” The mere fact that Bennett’s set top box is *capable* of communicating with the

Internet fails to disclose or suggest any specific signals, data, identifiers, or anything else that are actually used to “acquire” specific video content via the Internet.

Instead, Bennett only establishes that a control signal can be sent from the phone, fails to establish a process in which the control signal is further used, and only implies that some arbitrary process occurs to obtain content via the Internet. That is, Petitioner fails to establish that any “identifier” at all is being used to obtain content via the Internet, much less the specific identifier received from the phone. Petitioner’s expert declaration fails to fill the evident hole in Petitioner’s analysis, and merely parrots back the same conclusory allegation with no proof supported by either Bennett or external sources. *Compare* EX1002 ¶ 86 *with* Pet. at 34.

Petitioner’s second argument demonstrates this point further. In this argument, Petitioner asserts that “it would have been obvious to a POSITA to use an identifier such as URL in Bennett’s system to retrieve video content from the Internet.” Petitioner argues that a POSITA would know that a URL can be used to access content from an internet server. Pet. at 36. But now, while asserting a possible identifier that can be used to retrieve content from the Internet, Petitioner exposes another gap—Petitioner fails to show that the URL is an identifier being received from the phone in Bennett’s system.

In other words, Petitioner **only** argues that a URL would be an obvious identifier for “retrieving specific content from an internet server.” Petitioner’s arguments focus on justifying an example of **what** an identifier could be, and fails to address a scenario that would justify the receipt of a URL from a phone/remote. In other words, Petitioner fails to provide any evidence or argument that a URL would be **received** from Bennett’s phone as required by limitation [I.3], and then that URL is used to access content from an internet server.

Instead, Petitioner’s arguments actually demonstrate a different method of operation: a “control signal” is sent from the phone to the set top box, and a distinct identifier, such as a URL, is used to retrieve specific content from an internet server. Furthering this idea is Bennett’s disclosure, that discloses the use of a phone as a remote, and that “[a] Remote is used to change TV (‘Television’) channels, change audio and video settings of the TV and control power supply to the TV by selecting one or more of the buttons.” EX1004 ¶ [0008]. Petitioner presents no evidence that the remote can be used to send such “identifiers” such as “URLs” that can be used to pull content via the Internet rather than just control signals. Petitioner fails to provide any evidence of such a linkage.

Petitioner fails to explain how or why the URL would be received from a

phone/remote, rather than already stored by Bennett's TV or obtained by other means. Bennett only discusses selecting media element and a control signal that triggers the TV to implement changes. *See* EX1004 ¶ [0008]. Petitioner fails to demonstrate any capabilities of the phone/remote to determine URL information and transmit URL information when selecting a media element, which is necessary for Petitioner's mapping.

For at least the foregoing reasons, Petitioner fails to demonstrate that Bennett and the knowledge of a POSITA render limitation [I.4] obvious. Because the remaining challenged claims all depend from independent claim 1, Petitioner has failed to demonstrate that **any** challenged claim is rendered obvious based on Bennett and the knowledge of a POSITA.

3. Petitioner Fails to Establish that Claim Limitation [I.7] Would Have Been Obvious in View of Bennett and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Bennett in view of the knowledge of a POSITA discloses or suggests claim limitation [I.7]: "execute operation instructions received from the external mobile terminal via the radio receiver while the second video content is being displayed."

Petitioner argues that this limitation is satisfied by Bennett's disclosure that a

phone delivers a “control signal” that allows for “media swapping”—directing display of a new multimedia element. Pet. at 38; EX1004 ¶ [0051]. Here, Petitioner maps Bennett’s control signal for media swapping to the “operation instructions” of the claim limitation. Pet. at 38.

However, Petitioner adopted a claim construction for “operation instructions” that was ultimately rejected by the District Court, which construed “operation instructions” as “commands and instructions used to operate second video content.” *See supra* Section IV. Media swapping plainly falls outside this construction because signals to direct display of a new multimedia element is **not** a command or instruction used to operate a second video content (the second video content being currently displayed). Instead, media swapping is, at most, directed to displaying a **new** supposed “video content” and unrelated to commands or instructions to operate the second video content.

Therefore, Bennett and the knowledge of a POSITA fail to disclose or suggest claim limitation [I.7]. Because the remaining challenged claims all depend from independent claim 1, Petitioner has failed to demonstrate that **any** challenged claim is rendered obvious based on Bennett and the knowledge of a POSITA.

B. Petitioner Fails to Establish that Ground 2 Would Have Been Obvious Based on Bennett, Nashida, and the Knowledge of a POSITA

As explained below, Petitioner has not shown a likelihood of prevailing with respect to Ground 2. The combination of Bennett, Nashida, and the knowledge of a POSITA fails to disclose at least claim limitations [I.3], [I.4], and [I.7].

1. Petitioner Fails to Establish that Claim Limitation [I.3] Would Have Been Obvious in View of Bennett, Nashida, and Further in View of the Knowledge of a POSITA

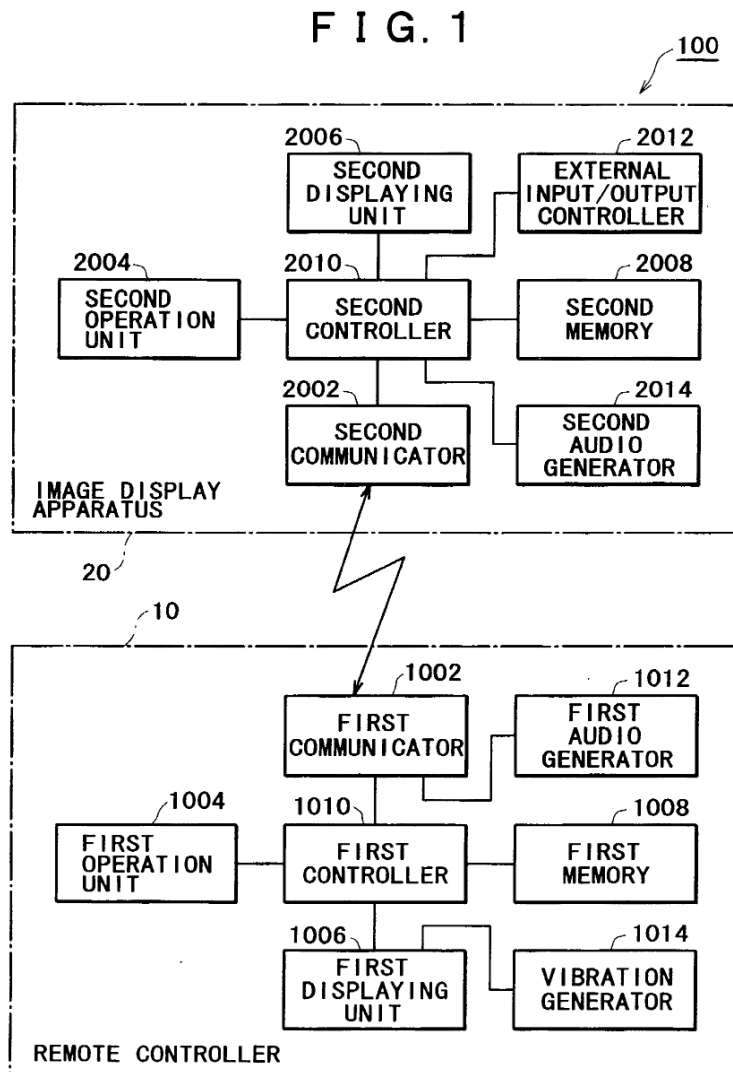
Petitioner fails to disclose that Bennett, Nashida, and the knowledge of a POSITA, whether taken alone or in reasonable combination, would disclose or suggest limitation [I.3]: receive an identifier for identifying a second video content from the external mobile terminal.

For example, Petitioner uses Nashida's disclosure that the "controller 1010 transmits a command of requesting a transmission of a URL." Because Petitioner asserts that "[i]ncorporating a URL or similar identifier into Bennett's "*control signal*" as a combination—it is clear that Petitioner is attempting to use this disclosure of Nashida to assert that a remote controller of Bennett is transmitting a URL.

However, Petitioner's selective quoting of Nashida misrepresents Nashida's teachings. While Nashida discloses that "the first controller 1010 transmits a

command of **requesting** a transmission of a URL (Uniform Resource Locator) information, from the first communicator 1002 to the second communicator 2002,” this needs to be read in light of the very next paragraph. See EX1005 ¶ [0120]; see also Pet. at 73.

The next paragraph of Nashida discloses that once the command is received by the second communicator 2002, it is a component of the **image display apparatus** that controls a controller to “**transmit[] the URL information...from the second communicator 2002** to the first communicator.” See EX1005 ¶ [0120]. Fig. 1 of Nashida shows that the second communicator is a component of the image display apparatus and that the first communicator is a component of the remote controller. It is therefore the image display apparatus (the alleged “display apparatus”) that sends the URL to the remote controller (which includes the first communicator), and not the other way around, as claimed by Petitioner.



See EX1005 Fig. 1.

The image shown in Petitioner's citation of Figure 17 A corresponds to this process. See Pet. at 74. Once the URL is received from the image display apparatus, the remote controller can then display the URL on a display unit of the remote controller. See EX1005 ¶ [0121] ("Accordingly, as shown in FIG. 9(B-1), the remote

controller 10 displays the URL information **received by** the first communicator 1002.”) That is, paragraph 121 of Nashida makes clear that the URL displayed on the remote controller is received **from** the image display apparatus (the alleged “display apparatus”), instead of reflecting URL information sent **to** the image display apparatus. There is no disclosure in Nashida of the URL information itself being transmitted from the remote controller to the image display apparatus, and only the other way around.

Furthermore, the disclosure of Nashida discloses that the image display apparatus is **already in possession** of the URL information, and therefore this information is **not received** from the remote controller.

Therefore, Bennett, Nashida, and the knowledge of a POSITA fail to disclose or suggest claim limitation [I.3]. Because the remaining challenged claims all depend from independent claim 1, Petitioner has failed to demonstrate that **any** challenged claim is rendered obvious based on Bennett, Nashida, and the knowledge of a POSITA.

2. Petitioner Fails to Establish that Claim Limitation [I.4] Would Have Been Obvious in View of Bennett, Nashida, and Further in View of the Knowledge of a POSITA

Petitioner fails to disclose that Bennett, Nashida, and the knowledge of a

POSITA, whether taken alone or in reasonable combination, would disclose or suggest limitation [I.4]: “acquire the second video content via the internet using said identifier.”

For example, Petitioner fails to provide any evidence or even argument that the second video content is acquired **via the internet using said identifier**. At most, Petitioner **only** presents evidence and arguments regarding the use of **a control signal and an identifier**: a control signal received from a phone/remote controller and an identifier (different from the control signal) that is used to acquire content via the internet. See Pet. at 74-75.

As set forth above in relation to Section VII.B.1, Nashida (and Bennett) fail to disclose a system in which the URL information itself is transmitted **from the remote controller** to the image display apparatus. Instead, Nashida discloses a system in which the URL information is transmitted from the image display apparatus **to the remote controller**, and **then** displayed on a display of the remote controller. See *supra* Section VII.B.1; see EX1005 ¶ [0121] (“Accordingly, as shown in FIG. 9(B-1), the remote controller 10 displays the URL information **received by** the first communicator 1002.”). Petitioner provides no evidence that the URL information is transmitted back from the remote controller to the image display

apparatus.

Petitioner then specifically asserts an argument that “[c]ombining these teachings, it would have been obvious that the display apparatus acquires second video content from the internet after receiving the identifier.” Pet. at 74. As described, Petitioner cannot prove that the display apparatus receiv[es] the identifier (URL information) from the remote controller. *See supra* Section VII.B.1. Other commands, such as the command to launch a browser, do **not** identify a second video content, and thus cannot qualify as the identifier. Nashida merely discloses that a **command**, not an identifier, is sent to the television and therefore cannot be used to modify Bennett to render obvious an identifier.

Therefore, Bennett, Nashida, and the knowledge of a POSITA fail to disclose or suggest claim limitation [I.4]. Because the remaining challenged claims all depend from independent claim 1, Petitioner has failed to demonstrate that **any** challenged claim is rendered obvious based on Bennett, Nashida, and the knowledge of a POSITA.

3. Petitioner Fails to Establish that Claim Limitation [I.7] Would Have Been Obvious in View of Bennett, Nashida, and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Bennett, in view of Nashida, and further in

view of the knowledge of a POSITA discloses or suggests claim limitation [I.7]:
“execute operation instructions received from the external mobile terminal via the radio receiver while the second video content is being displayed.”

Petitioner fails to address this limitation at all in relation to Ground 2. Therefore, the combination of Bennett, Nashida, and the knowledge of POSITA fail to disclose or suggest claim limitation [I.7] at least for the same reasons presented above with respect to Ground 1. *See supra* Section VII.A.3.

Therefore, Bennett, Nashida, and the knowledge of a POSITA fail to disclose or suggest claim limitation [I.7]. Because the remaining challenged claims all depend from independent claim 1, Petitioner has failed to demonstrate that **any** challenged claim is rendered obvious based on Bennett and the knowledge of a POSITA.

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 12,594 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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