

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

NL GIKEN INC.,

Plaintiff,

v.

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

Defendants.

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

DEFENDANTS' INITIAL INVALIDITY CONTENTIONS

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I. INTRODUCTION

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

In its infringement contentions served October 4, 2024, Giken asserted claims 1-3, 5-8, and 10-12 of U.S. Patent No. 10,880,592 (the “’592 Patent”); claims 1-2, 4, 6, and 15 of U.S. Patent No. 8,094,236 (the “’236 Patent”); claims 1, 9-10, and 12-15 of U.S. Patent No. 8,677,391 (the “’391 Patent”); claims 4-6 and 8-14 of U.S. Patent No. 9,319,615 (the “’615 Patent”); and claims 1-12 of U.S. Patent No. 9,948,968 (the “’968 Patent”) (collectively, the “Asserted Claims” and “the Asserted Patents”). Defendants contend that each of the Asserted Claims is invalid under at least 35 U.S.C. §§ 101, 102, 103, and/or 112. Defendants reserve the right to supplement these Initial Invalidity Contentions pursuant to the Federal Rules of Civil Procedure, the Court’s Local Rules, and/or any other order or schedule entered by the Court.

II. PRELIMINARY STATEMENT AND RESERVATION OF RIGHTS

A. No Waiver.

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

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

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

B. No Admission.

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

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

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

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

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

C. Reservation of Rights.

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

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

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

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

D. Ongoing Investigation.

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

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

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

A. Legal Standard.

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

Under 35 U.S.C. § 103, a patent may not issue “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” Pre-AIA 35 U.S.C. § 103(a). Thus, “[a]n invention which

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

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

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

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

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

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

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

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

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

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

1. Prior Art Patents and Published Patent Applications

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

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

2. Prior Art Products and Systems

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

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

3. Claim Charts

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

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

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

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

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

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

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

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

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

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

render the relevant claims invalid as obvious under 35 U.S.C. § 103.

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

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

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

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

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

Additional evidence that there would have been a motivation to combine or modify the prior art references listed above and identified in Exhibits 592.A-F includes the interrelated

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

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

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

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

1. Prior Art Patents and Published Patent Applications

Prior Art Patents and Published Applications	Issue/Publication Date
U.S. Patent No. 7,143,428 (“Bruck”).	Nov. 28, 2006
U.S. Patent App. Pub. No. 2004/0231003 (“Cooper”).	Nov. 18 2004
U.S. Patent No. 8,611,258 (“Croak”).	Dec. 17, 2013

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

2. Prior Art Products and Systems

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

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

3. Claim Charts

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

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

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

references disclosed in these contentions.

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

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

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

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

Defendants further incorporate by reference the prior art references related to the '236 Patent, including those identified in any other proceeding involving the '236 Patent or related U.S. or foreign patents. Defendants additionally incorporate by reference all prior art produced

by or otherwise known by Giken, the named inventors, any past or current owner of the '236 Patent, or any individual substantively involved in the prosecution of the '236 Patent.

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

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

- 1) U.S. Patent App. Pub. No. 2006/0271959 ("**Jacoby**"). *E.g.*, ¶¶ 52 ("shared viewing of content between a plurality of users, shared remote control functionality between a plurality of users, combinations thereof, shared remote and shared viewing with instant messaging between a plurality of users, etc."), 88 ("the synchronization of a given user with one or more buddies may result in the user and one or more buddies engaging in a "movie theater type viewing environment, wherein the user and one or more buddies view the same television show, movie, etc., at the same time while engaging in instant messaging or chat sessions"), Figs. 1, 5.
- 2) U.S. Patent App. Pub. No. 2006/0221173 ("**Duncan**"). *E.g.*, ¶¶ 3 ("allow the user to participate in a chat session which is related to the programme currently being viewed. Indeed, the chat room text can be displayed on the same television screen as the programme to which the chat relates"), 44 ("a user may participate in a service in which a group of users simultaneously view (or listen to) the same programmes and discuss them"), Fig. 4.
- 3) U.S. Patent App. Pub. No. 2004/0231003 ("**Cooper**"). *E.g.*, ¶¶ 55 ("Fig. 9 illustrates how a display can simultaneously present a television program and a chat room"), 56 ("when a user watching 'Gilligan's Island' selects the TV chat control, the server places the user in a 'Gilligan's Island' chat room 902 with other users viewing the show. The users can then share their comments on the show in real time by

submitting messages to the server for display in the chat room window.”), 58 (“For example, if the user tunes from ‘Love Boat’ to ‘Fantasy Island,’ the user can be moved from the Love Boat chat room to the Fantasy Island chat room.”). Figs. 8-10.

- 4) U.S. Patent No. 8,611,258 (“**Croak**”). *E.g.*, Abstract (“Specifically, a user can request the network to activate and display a video session, such as a movie. The user can invite one or more other users to participate in the video session. As other users accept to participate in the video session, the network can activate another session that enables the participants to communicate with each other via instant messages.”), 8;14-16 (“Subscribers 331 and 332 can communicate via the established IM sessions using data flows 361 and 363 while watching the same streaming video contents.”), Figs. 3-4.
- 5) U.S. Patent App. Pub. No. 2005/0262542 (“**DeWeese**”). *E.g.*, ¶¶ 93 (“Television program 202 may be displayed in region 203 of display screen 200, while a chat room region 206 may be displayed simultaneously in the lower portion of display screen 200.”), 94-96, 97 (“The divided nature of screen 200 allows users to simultaneously watch a television program and send real time communications to other users who are viewing the same program at the same time. In this way, chat room 206 is directly linked to the on-going actions in program 202 in that a user can send and receive comments about the content of the program as it unfolds on his television screen.”), 150 (“allows the user to participate in the chat group and to view the television program that is the subject of the chat simultaneously”), Figs. 9, 20-24, ¶ 139.
- 6) U.S. Patent App. Pub. No. 2007/0050822 (“**Stevens**”). *E.g.*, Abstract (“transporting signals associated with common content to a group of subscribers such that each member of the group receives the same content and establishing the shared community experience between members of the group by providing communications between on or more members of the group during playback of the content”), ¶¶ 32 (“Any number of subscribers may create their own community groups and invite any number of other subscribers to join the group”), 36, 37 (“text messages from other members of the group are displayed in a pop-up window or other feature displayed in the televisions 40-46;” “[i]dentifiers and other features may be included to identify the users in the window and the text messages associated therewith, similar to an instant messaging arrangement”), 45 (“join a ‘TV-Together’ group;” “selected participants may tune (or are automatically tuned by the group leader) to a common television channel and are connected (preferably through the set-top box) in a multi-way audio conference call.”), 46, Figs. 1-2.
- 7) U.S. Patent No. 7,143,428 (“**Bruck**”). *E.g.*, Abstract (“The system has a user-selectable chat option in which the viewer can enter text messages that will be displayed to other viewers of the video signal who have also selected the chat option.”), 7:44-46 (“Chat user interface 110 also includes a video region 118 for display of a video signal, i.e., a television program which the user was viewing prior to entry of the chat room.”), 8:4-6 (“In the interface of FIG. 8, chat region 108 is smaller and is positioned at the top of the interface, with video region 118 being located at the bottom.”), 7:17-11:14, Figs. 5-14.

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

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

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

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

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

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

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

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

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

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

1. Prior Art Patents and Published Patent Applications

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

2. Prior Art Products and Systems

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

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

3. Claim Charts

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

E. Prior Art that Anticipates and/or Renders Obvious Each Asserted Claim of the '615 Patent.

Defendants contend that the prior art references identified in Exhibits 615.A-B and/or described below anticipate and/or render obvious, alone or in combination, one or more of the Asserted Claims of the '615 Patent. Each prior art reference identified below is prior art under at least 35 U.S.C. § 102(a), (b), and/or (e) (pre-AIA).

1. Prior Art Patents and Published Patent Applications

Prior Art Patents and Published Applications	Issue/Publication Date
U.S. Patent No. 7,143,428 (“Bruck”).	Nov. 28, 2006
U.S. Patent App. Pub. No. 2004/0231003 (“Cooper”).	Nov. 18 2004
U.S. Patent No. 8,611,258 (“Croak”).	Dec. 17, 2013
U.S. Patent App. Pub. No. 2005/0262542 (“DeWeese”).	Nov. 24, 2005
U.S. Patent App. Pub. No. 2006/0221173 (“Duncan”).	Oct. 5, 2006
U.S. Provisional Patent App. Ser. No. 60/138,868 (“Herrington”).	Nov. 24, 2005
U.S. Patent App. Pub. No. 2005/0130613 (“Kutsuna”).	Jun. 16, 2005
U.S. Patent App. Pub. No. 2006/0271959 (“Jacoby”).	Nov. 30, 2006
U.S. Patent No. 4,754,268 (“Mori”).	Jun. 28, 1988
U.S. Patent App. Pub. No. 2001/0055951 (“Slotznick”).	Dec. 27, 2001
U.S. Patent App. Pub. No. 2007/0050822 (“Stevens”).	Mar. 1, 2007
U.S. Patent App. Pub. No. 2005/0160465 (“Walker”).	Jul. 21, 2005

2. Prior Art Products and Systems

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

In addition to the products in the chart above, Defendants continues to investigate the identities of the individuals or entities involved in the first sale, offer for sale, or public use of prior art products that were made using the system recited by the asserted claims of the ’615 Patent. Defendants will produce additional documents relating to the invalidity of the asserted claims by those products as they become available.

3. Claim Charts

Defendants have attached charts identifying prior art that anticipates and/or renders obvious each of the Asserted Claims of the '615 Patent in **Exhibits 615.A-B**, collectively referred to as the "'615 Patent Invalidity Charts."

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

Defendants have provided exemplary combinations in Exhibits 615.A-B for specific claim limitations which identify exemplary secondary references and exemplary disclosures therefrom. Each prior art reference evidences teachings, suggestions, motivations, and/or other

reasons to combine it with the other identified references in ways that render obvious all of the asserted claims of the '615 Patent. In addition to any specific combinations of prior art disclosed using claim charts, Defendants reserve the right to rely on any combination of prior art references disclosed in these contentions.

To the extent any item of prior art cited above is deemed not to disclose, explicitly or inherently, any limitation of an asserted claim of the '615 Patent, Defendants reserve the right to argue that any difference between that prior art and the corresponding patent claim would have been either inherent in the art or obvious to a person of ordinary skill in the art, even if Defendants have not specifically denoted that the art is to be combined with the knowledge of a person of ordinary skill in the art.

4. The '615 Patent is Obvious Over the Prior Art.

In addition to the references cited on the face of the '615 Patent, the admitted prior art in the specification of the '615 Patent, and the prosecution history of the '615 Patent, the prior art references identified in Exhibits 615.A-B and listed above disclose the elements of the Asserted Claims, either explicitly, inherently, or via an obviousness combination, and may also be relied upon to show the state of the art in the relevant timeframes.

In addition to the references listed in this section, Defendants also identify all of the exemplary prior art references listed above as relevant to the knowledge, understandings, creativity, or skill of the person having ordinary skill in the art. Defendants reserve the right to supplement the Invalidity Contentions with additional charts for any of the references identified in Exhibits 615.A-B. Defendants further reserve the right to rely on the additional references, teachings, knowledge, or understandings identified or disclosed during fact or expert discovery in this case as evidence of the knowledge, understandings, creativity, or skill of the person having ordinary skill in the art.

Defendants further incorporate by reference the prior art references related to the '615 Patent, including those identified in any other proceeding involving the '615 Patent or related U.S. or foreign patents. Defendants additionally incorporate by reference all prior art produced by or otherwise known by Giken, the named inventors, any past or current owner of the '615 Patent, or any individual substantively involved in the prosecution of the '615 Patent.

To the extent Giken argues that any limitation of the asserted claims of the '615 Patent are not explicitly or inherently disclosed by an item of prior art identified above or in Exhibits 615.A-B, any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge of those skilled in the art. The item of prior art would, therefore, render the relevant claims invalid as obvious under 35 U.S.C. § 103.

Moreover, Giken contends that one or more claims of the '615 patent read upon Amazon's "Watch Party" feature. If a fact finder were to accept this contention as true (which it is not), then the '615 patent's claims would be anticipated or rendered obvious by prior art references that disclose such functionality, including the prior art references and exemplary citations below.

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

- 3) U.S. Patent App. Pub. No. 2004/0231003 (“**Cooper**”). *E.g.*, ¶¶ 55 (“Fig. 9 illustrates how a display can simultaneously present a television program and a chat room”), 56 (“when a user watching ‘Gilligan’s Island’ selects the TV chat control, the server places the user in a ‘Gilligan’s Island’ chat room 902 with other users viewing the show. The users can then share their comments on the show in real time by submitting messages to the server for display in the chat room window.”), 58 (“For example, if the user tunes from ‘Love Boat’ to ‘Fantasy Island,’ the user can be moved from the Love Boat chat room to the Fantasy Island chat room.”). Figs. 8-10.
- 4) U.S. Patent No. 8,611,258 (“**Croak**”). *E.g.*, Abstract (“Specifically, a user can request the network to activate and display a video session, such as a movie. The user can invite one or more other users to participate in the video session. As other users accept to participate in the video session, the network can activate another session that enables the participants to communicate with each other via instant messages.”), 8;14-16 (“Subscribers 331 and 332 can communicate via the established IM sessions using data flows 361 and 363 while watching the same streaming video contents.”), Figs. 3-4.
- 5) U.S. Patent App. Pub. No. 2005/0262542 (“**DeWeese**”). *E.g.*, ¶¶ 93 (“Television program 202 may be displayed in region 203 of display screen 200, while a chat room region 206 may be displayed simultaneously in the lower portion of display screen 200.”), 94-96, 97 (“The divided nature of screen 200 allows users to simultaneously watch a television program and send real time communications to other users who are viewing the same program at the same time. In this way, chat room 206 is directly linked to the on-going actions in program 202 in that a user can send and receive comments about the content of the program as it unfolds on his television screen.”), 150 (“allows the user to participate in the chat group and to view the television program that is the subject of the chat simultaneously”), Figs. 9, 20-24, ¶ 139.
- 6) U.S. Patent App. Pub. No. 2007/0050822 (“**Stevens**”). *E.g.*, Abstract (“transporting signals associated with common content to a group of subscribers such that each member of the group receives the same content and establishing the shared community experience between members of the group by providing communications between on or more members of the group during playback of the content”), ¶¶ 32 (“Any number of subscribers may create their own community groups and invite any number of other subscribers to join the group”), 36, 37 (“text messages from other members of the group are displayed in a pop-up window or other feature displayed in the televisions 40-46;” “[i]dentifiers and other features may be included to identify the users in the window and the text messages associated therewith, similar to an instant messaging arrangement”), 45 (“join a ‘TV-Together’ group;” “selected participants may tune (or are automatically tuned by the group leader) to a common television channel and are connected (preferably through the set-top box) in a multi-way audio conference call.”), 46, Figs. 1-2.
- 7) U.S. Patent No. 7,143,428 (“**Bruck**”). *E.g.*, Abstract (“The system has a user-selectable chat option in which the viewer can enter text messages that will be

displayed to other viewers of the video signal who have also selected the chat option.”), 7:44-46 (“Chat user interface 110 also includes a video region 118 for display of a video signal, i.e., a television program which the user was viewing prior to entry of the chat room.”), 8:4-6 (“In the interface of FIG. 8, chat region 108 is smaller and is positioned at the top of the interface, with video region 118 being located at the bottom.”), 7:17-11:14, Figs. 5-14.

To the extent Giken contends otherwise, the claims of the ’615 patent recite, at most, a specific, narrow implementation of a well-known concept, which implementation is one of many possible implementations and which implementation Amazon does not practice.

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

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

Generally, motivation to combine any of the references for the ’615 Patent with other references exists within the references themselves, as well as within the knowledge of those of ordinary skill in the art at the relevant time. One of ordinary skill in the art would have understood how to combine or modify the teachings of the prior art references referred to in these Initial Invalidity Contentions and would have been motivated to pursue such combinations for numerous reasons. For example, all references identified above and in Exhibits 615.A-B are analogous art because each of them is from the same field of endeavor as the claimed inventions of the ’615 Patent. *See, e.g.*, ’615 Patent, Abstract. One of ordinary skill in the art would have combined particular features of systems, apparatuses, and methods disclosed in certain of the prior art references with other prior art references that do not expressly disclose such particular features because, *e.g.*, (i) the teachings of the references are interrelated and cite each other, (ii) it

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

Should additional evidence of motivation to combine or modify be required to render the Asserted Claims obvious, Defendants allege that there was a motivation to combine or modify one or more references listed above and identified in Exhibits 615.A-B, including the references in the '615 Patent Invalidity Charts, and, specifically, the illustrative obviousness combinations identified above. That motivation was provided in the nature of the problem allegedly solved by the '615 Patent, the teachings of the cited prior art itself, and/or the knowledge of a person of ordinary skill in the art. For example, one or more combinations of the prior art references in Exhibits 615.A-B would have been obvious because these references would have been combined or modified using: known methods to yield predictable results; common sense; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or teaching, suggestion, or motivation in the prior art generally. In addition, it would have been obvious to try combining or modifying the prior art references identified in Exhibits 615.A-B, including the references in the '615 Patent Invalidity Charts, because there were only a finite number of predictable solutions and/or because known work in one field of endeavor prompted variations based on predictable design incentives and/or market

forces either in the same field or a different one. In addition, the combination of the prior art references would have been obvious because the combination represents known potential options with a reasonable expectation of success.

Additional evidence that there would have been a motivation to combine or modify the prior art references listed above and identified in Exhibits 615.A-B includes the interrelated teachings of multiple prior art references; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the alleged invention(s); and the background knowledge, skill, or creativity that would have been possessed by a person having ordinary skill in the art.

Moreover, Exhibits 615.A-B identify limitations that were well known in the prior art, as well as limitation-specific motivation to combine or modify. Defendants may rely on uncited portions of the prior art references cited and produced, other publications and testimony, and the testimony of experts to establish that a person of ordinary skill in the art would have been motivated to modify or combine certain of the cited references so as to render the claims obvious. References identified by Defendants address the same technical issues and suggest very similar solutions to those issues discussed in the '615 Patent and generally known at the time of the alleged invention(s) claimed in the Asserted Claims.

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

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

1. Prior Art Patents and Published Patent Applications

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

2. Prior Art Products and Systems

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

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

3. Claim Charts

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

IV. INVALIDITY UNDER 35 U.S.C. § 112

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

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

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

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

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

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

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

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

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

For example:

1. The ’592 Patent

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

- “the I/O interface locating the integral program in accordance with information at the time of selection by the remote controller” (’592 patent, claims 1, 6);
- “[an/the] integral program” (’592 patent, claims 1, 2, 3, 5, 6, 7, 8, 10);
- “a television display that shows the digital moving image contents from the first provider and the second provider” (’592 patent, claim 1);
- “a TV set processor that has the television display show a past part of the integral program which has been already provided by the first provider and retrieved from the memory in the TV set computer” (’592 patent, claim 2);

- “a television display that shows the digital moving image contents provided in accordance with a program schedule table and the digital moving image content provided independently from the program schedule table;” (’592 patent, claim 6);
- “the memory in the TV set computer keeps information necessary for the TV set computer to locate the integral program same as the integral program provided in accordance with a program schedule table” (’592 patent, claim 10);
- “wherein the s remote controller selects the one of the digital moving image contents by means of selecting the sub provider;” (’592 patent, claim 11).

2. The ’236 Patent

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

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

3. The ’391 Patent

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

- “a first controller ” (’391 patent, claims 1, 10);
- “electric data” (’391 patent, claims 1, 10);
- “a second controller” (’391 patent, claims 1, 10);
- “wherein no electric payment is made to the moving image data delivery system when the advertising image data delivery system issues the electric data to the moving image viewing apparatus in exchange of viewing commercial message” (’391 patent, claims 1, 10);
- “the electric data having been issued to the moving image viewing apparatus, without intermediary of the moving image data delivery system, by the advertising image data delivery system in exchange of a commercial message view by the moving image viewing apparatus” (’391 patent, claim 1);
- “without intermediary of the moving image data delivery system” (’391 patent, claims 1, 10);
- “wherein the advertising image data delivery system is integrated into the moving image data delivery system” (’391 patent, claim 9);
- “first controller adapted to issue, without intermediary of the moving image data delivery system, to one of the moving image viewing apparatuses an electric data” (’391 patent, claim 10);
- “third controller” (’391 patent, claim 10);
- “a third controller adapted to allot the received electric payment to the moving image data delivery system” (’391 patent, claim 10);
- “fourth controller” (’391 patent, claims 12-14);
- “a fourth controller adapted to electrically provide one of the plurality of advertising image data of commercial messages to one of the plurality of moving image viewing apparatuses by request thereof.” (’391 patent, claim 12);
- “the advertising image data of commercial message being related to a television program designated by the moving image viewing apparatus” (’391 patent, claim 13);
- “wherein the advertising image data delivery system is integrated into a system of the advertiser” (’391 patent, claim 15).

4. The ’615 Patent

The asserted claims of the ’615 patent, at least under Giken’s actual and/or apparent

application of the claims, are invalid under 35 U.S.C. § 112(a) because the specification lacks an adequate written description of the alleged invention and fails to enable the full scope of the alleged invention.

- “a receiver arranged to receive, without request or acknowledgement, information of one definite broadcast program which can be displayed on the display and is identified by the program selection of the another broadcast program viewing system” (’615 patent, claim 4);
- “a manual controller having a predetermined operating portion to change the display in response to a predetermined same manual operation from own motive of a viewer of the display on the basis of the information received by the receiver,” (’615 patent, claim 4);
- “the information including information of a broadcast program which is not currently not displayed on the display” (’615 patent, claims 4, 8);
- “the information being without request or acknowledgement from the another broadcast program viewing system” (’615 patent, claim 8);
- “in response to a same manual operation from own motive of a viewer,” (’615 patent, claim 8);
- “the same manual operation being universal regardless of the information and without any program selecting operation” (’615 patent, claim 4).

5. The ’968 Patent

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

- “A receiving apparatus configured to receive digital moving image contents from a provider of the digital moving image contents, the provider being commutatively connected to the receiving apparatus,” (’968 patent, claim 1);
- “wherein the processor is configured to designate an optional part of the digital moving image contents in response to the manual operation.” (’968 patent, claims 4, 12);
- “wherein the receiving method is further configured to designate an optional part

of the digital moving image contents in response to the manual operation” (’968 patent, claim 8);

- “A receiving system configured to receive digital moving image contents from a provider of the digital moving image contents, the provider being commutatively connected to the receiving system,” (’968 patent, claim 9).

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

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

The Asserted Claims are invalid as indefinite because they fail to inform those skilled in the art about the scope of the alleged invention with reasonable certainty. These Invalidity Contentions are based on Defendants’ understanding of Giken’s interpretation of the Asserted Claims as asserted in the infringement contentions. Because the determination of whether the claims are indefinite under 35 U.S.C. § 112, second paragraph, depends on the construction of the Asserted Claims—and no claim construction positions have been exchanged, no claim construction order has been issued and no expert discovery has taken place—Defendants’ positions on indefiniteness are necessarily preliminary at this early stage of the case. Defendants

reserve their right to amend or further revise these Invalidity Contentions based on further developments, including the Court's claim construction opinion, and discovery in the case.

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

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

1. The '592 Patent

At least under Giken's actual and/or apparent application of the claims, the asserted claims of the '592 patent are invalid under 35 U.S.C. § 112(b) for indefiniteness because the specification and prosecution history of the '592 patent would not inform those skilled in the art about the scope of the alleged invention with reasonable certainty. Further, the asserted claims of the '592 patent are invalid for indefiniteness because the specification does not disclose adequate corresponding structure, material, or acts for several claim terms reciting functional language subject to 35 U.S.C. § 112(f).

- “remote controller” (’592 patent, claims 1, 6, 11);
- “the I/O interface” (’592 patent, claims 1, 6);
- “the I/O interface locating the integral program in accordance with information at the time of selection by the remote controller” (’592 patent, claims 1, 6);
- “[an/the] integral program” (’592 patent, claims 1, 2, 3, 5, 6, 7, 8, 10);
- “a TV set processor that has the television display show a past part of the integral program which has been already provided by the first provider and retrieved from the memory in the TV set computer” (’592 patent, claim 2);
- “a television display that shows the digital moving image contents provided in accordance with a program schedule table and the digital moving image content provided independently from the program schedule table;” (’592 patent, claim 6);

2. The ’236 Patent

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

- “a television function unit provided inside the television set and arranged to relate to a television function;” (’236 patent, claim 1);
- “a detector provided inside the television set and arranged to detect a cause of change in the television function;” (’236 patent, claim 1);
- “a communicator provided inside the television set and arranged to selectively communicate with one of a plurality of outside counterparts by means of designating an address of one of the outside counterparts,” (’236 patent, claim 1);
- “the plurality of outside counterparts including a first type of counterpart under free selection and a second type of counterpart which is predetermined” (’236 patent, claim 1);

- “an input provided inside the television set and arranged to newly and freely prepare first information;” (’236 patent, claim 1);
- “an automatic generator provided inside the television set and arranged to generate predetermined second information in response to the detector which detects a cause of a predetermined change in the television function” (’236 patent, claim 1);
- “a second trigger provided inside the television set and arranged to automatically send the second information to the second type of counterpart through the same communicator in response to completion of the function of the automatic generator and the second designator” (’236 patent, claim 1);
- “wherein the second information includes a channel identification of broadcast program for indication on a display of the another television set to visually inform the another television set of channel selection in the television function.” (’236 patent, claim 15).

3. The ’391 Patent

At least under Giken’s actual and/or apparent application of the claims, the asserted claims of the ’391 patent are invalid under 35 U.S.C. § 112(b) for indefiniteness because the specification and prosecution history of the ’391 patent would not inform those skilled in the art about the scope of the alleged invention with reasonable certainty. Further, the asserted claims of the ’391 patent are invalid for indefiniteness because the specification does not disclose adequate corresponding structure, material, or acts for several claim terms reciting functional language subject to 35 U.S.C. § 112(f).

- “a first controller ” (’391 patent, claims 1, 10);
- “electric data” (’391 patent, claims 1, 10);
- “a second controller” (’391 patent, claims 1, 10);
- “wherein no electric payment is made to the moving image data delivery system when the advertising image data delivery system issues the electric data to the moving image viewing apparatus in exchange of viewing commercial message” (’391 patent, claims 1, 10);
- “the electric data having been issued to the moving image viewing apparatus, without intermediary of the moving image data delivery system, by the

advertising image data delivery system in exchange of a commercial message view by the moving image viewing apparatus” (’391 patent, claim 1);

- “a plurality of digital moving image data of television programs to be viewed by the moving image viewing apparatuses” (’391 patent, claim 1);
- “for allowing to display the television program in exchange of a presentation of an electric data denoting a right of viewing the television program” (’391 patent, claim 1);
- “without intermediary of the moving image data delivery system” (’391 patent, claims 1, 10);
- “in exchange of a commercial message view” (’391 patent, claim 1);
- “first controller adapted to issue, without intermediary of the moving image data delivery system, to one of the moving image viewing apparatuses an electric data” (’391 patent, claim 10);
- “third controller” (’391 patent, claim 10);
- “a third controller adapted to allot the received electric payment to the moving image data delivery system” (’391 patent, claim 10);
- “fourth controller” (’391 patent, claims 12-14);
- “a fourth controller adapted to electrically provide one of the plurality of advertising image data of commercial messages to one of the plurality of moving image viewing apparatuses by request thereof.” (’391 patent, claim 12);

4. The ’615 Patent

At least under Giken’s actual and/or apparent application of the claims, the asserted claims of the ’615 patent are invalid under 35 U.S.C. § 112(b) for indefiniteness because the specification and prosecution history of the ’615 patent would not inform those skilled in the art about the scope of the alleged invention with reasonable certainty. Further, the asserted claims of the ’615 patent are invalid for indefiniteness because the specification does not disclose adequate corresponding structure, material, or acts for several claim terms reciting functional language subject to 35 U.S.C. § 112(f).

- “A broadcast program viewing system for viewing a broadcast program same as that identified by a program selection of another broadcast program viewing system in another place to share same experience of viewing same broadcast program” (’615 patent, claim 4);
- “a receiver arranged to receive, without request or acknowledgement, information of one definite broadcast program which can be displayed on the display and is identified by the program selection of the another broadcast program viewing system” (’615 patent, claim 4);
- “the information including information of a broadcast program which is not currently not displayed on the display” (’615 patent, claim 4);
- “a manual controller having a predetermined operating portion to change the display in response to a predetermined same manual operation from own motive of a viewer of the display on the basis of the information received by the receiver,” (’615 patent, claim 4);
- “the same manual operation being universal regardless of the information and without any program selecting operation” (’615 patent, claims 4, 8);
- “wherein the program selection of the another broadcast program viewing system is a code setting to download the selected broadcast program” (’615 patent, claim 6);
- “In a broadcast program viewing system for viewing a broadcast program same as that identified by a program selection of another broadcast program viewing system in another place in accordance with information of one definite broadcast program which can be viewed by the broadcast program viewing system and is identified by the program selection of the another broadcast program viewing system to share same experience of viewing same broadcast program” (’615 patent, claim 8);
- “the information being without request or acknowledgement from the another broadcast program viewing system” (’615 patent, claim 8);
- “in response to a same manual operation from own motive of a viewer,” (’615 patent, claim 8);
- “wherein the manual operating portions of the manual operating part include ten key” (’615 patent, claim 11).

5. The ’968 Patent

At least under Giken’s actual and/or apparent application of the claims, the asserted claims of the ’968 patent are invalid under 35 U.S.C. § 112(b) for indefiniteness because the

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

- “A receiving apparatus configured to receive digital moving image contents from a provider of the digital moving image contents, the provider being commutatively connected to the receiving apparatus,” ('968 patent, claim 1);
- “a designation software controller configured to control the memory to keep the information in response to a termination of viewing the viewed part and control the processor to automatically designate the succeeding part of the digital moving image contents when the viewing starts again” ('968 patent, claim 1);
- “a receiver of the designated succeeding part of the digital moving image contents in response to the designation by the processor” ('968 patent, claims 1, 9);
- “wherein the processor is configured to designate an optional part of the digital moving image contents in response to the manual operation.” ('968 patent, claims 4, 12);
- “wherein the receiving method is further configured to designate an optional part of the digital moving image contents in response to the manual operation” ('968 patent, claim 8);
- “A receiving system configured to receive digital moving image contents from a provider of the digital moving image contents, the provider being commutatively connected to the receiving system,” ('968 patent, claim 9).

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

Claims directed to an abstract idea that do not add an inventive concept are ineligible for patent protection. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 69-70 (2012); *Bilski v. Kappos*, 561 U.S. 593, 601-02 (2010). Determining whether the subject matter of a claim is patent-ineligible is a two-step process. *Alice*, 134 S. Ct at 2355; *Mayo*, 566 U.S. at 69-70. First, the Court must “determine whether the claims at issue are directed to a patent-ineligible concept” such as an

abstract idea. *Alice*, 134 S. Ct. at 2355. Second, if the claims are directed to a patent-ineligible concept, the Court must “consider the elements of each claim both individually and as an ordered combination to determine whether the additional elements transform the nature of the claim into a patent eligible application.” *Id.* (internal quotations omitted).

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

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

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

Defendants incorporate here by reference their motion to dismiss the ’968 Patent as unpatentable subject matter. (D.I. 13-14). Defendants also incorporate here by reference the bases of invalidity set forth in Apple Inc.’s motions to dismiss the ’968 Patent as unpatentable

subject matter (D.I. 11, 21) in *NL Giken Inc. v. Apple Inc.*, No. 1:24-cv-00013-MN (D. Del.).

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

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

- “moving image viewing apparatuses” which Giken alleges include “laptops, phones, or other viewing devices,” (Ex. C-1 at 6);
- “moving image data delivery system” which Giken alleges includes general

purpose computers and streaming software combined with various network servers (Ex. C-1 at 8);

- “storage” which Giken alleges may be RAM (Ex. C-1 at 9);
- “first controller” which Giken alleges may be a content delivery network server (Ex. C-1 at 11);
- “second controller” which Giken alleges to be a computer processor (Ex. C-1 at 17);
- “electric data” which Giken alleges to be a tracking pixel (Ex. C-1 at 14); and
- “advertising image data delivery system” which Giken inconsistently alleges at various times to be both the Amazon Ad server, *see, e.g.*, Ex C-1 at 17 and the “Twitch System,” *see, e.g.*, Ex. C-1 at 14.

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

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

- Storing television programs for broadcast;

- Viewing television programs on, e.g., television sets;
- Advertisements playing during television viewing;
- Advertisers paying for advertisements to be played during television broadcasts;
- and
- Targeted advertising.

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

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

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

- “remote controller”;
- “tuner”;
- “television display”;
- “memory”; and
- “TVset.”

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

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

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

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

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

VI. PRIOR ART DOCUMENT PRODUCTION

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

Dated: November 15, 2024

Respectfully submitted,

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Inc.*

CERTIFICATE OF SERVICE

I, Brian A. Biggs, hereby certify that on this 15th day of November, 2024, a copy of **DEFENDANTS' INITIAL INVALIDITY CONTENTIONS** were served upon the following counsel of record via electronic mail:

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Exhibit 236.A
Invalidity of U.S. Patent No. 8,094,236 in view of Cooper¹

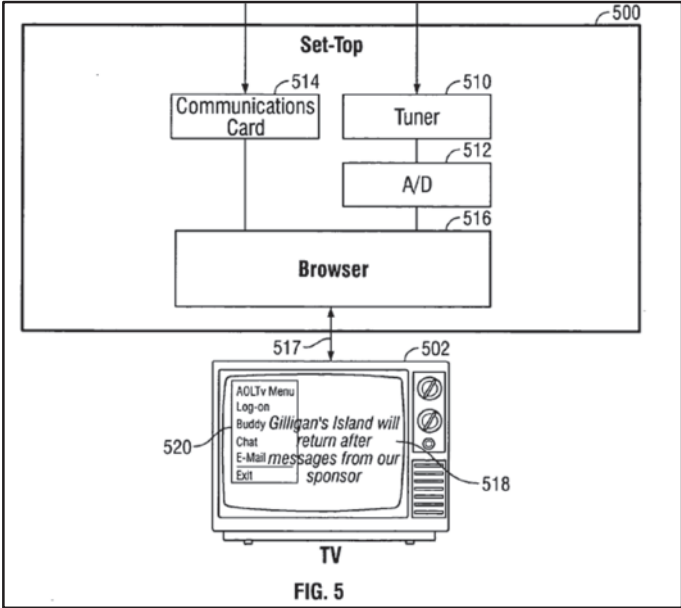
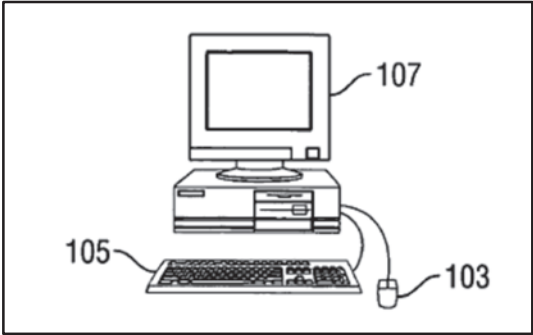
U.S. Patent App. Pub. No. 2004/0231003 (“Cooper”) is prior art to U.S. Patent No. 8,094,236 under at least 35 U.S.C. §§ 102(a), (b), and (e) (pre-AIA). Cooper was filed on December 30, 1999 and published on November 18, 2004.

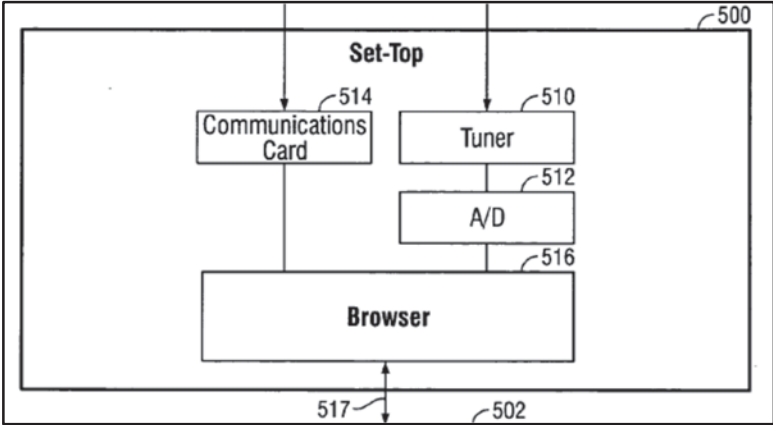
Amazon incorporates here by reference all bases of invalidity of the ’236 patent based on Cooper (alone or in combination) set forth in the *inter partes* review of that patent.

Amazon’s invalidity contentions are based in part on Giken’s infringement contentions, to the extent Amazon can understand them, because that which infringes, if later, anticipates, if earlier. Amazon offers these contentions without prejudice to any position it may later take as to any claim construction issue. To the extent these contentions reflect claim interpretations implicit in Giken’s infringement contentions, no inference is intended, nor should any be drawn, that Amazon agrees with any claim interpretation implied by Giken’s infringement contentions, and Amazon reserves the right to contest such claim interpretations. Where Amazon cites to a particular figure, the citation encompasses the description of that figure; similarly, where Amazon cites to text describing a figure, the citation encompasses that figure as well.

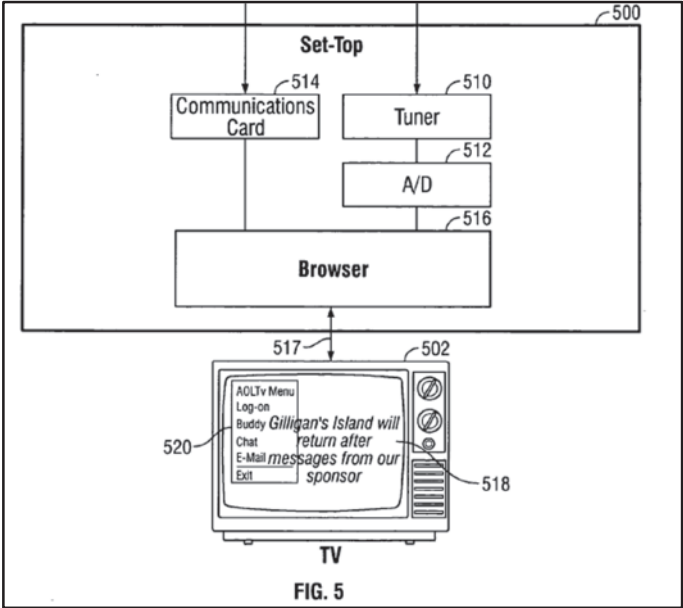
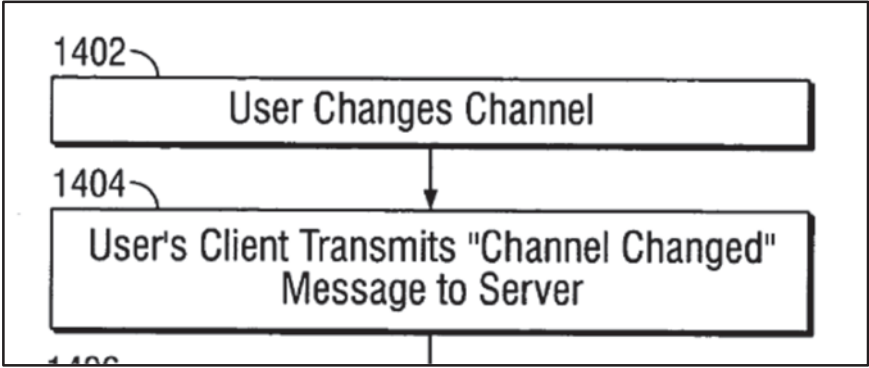
Claim Limitation	Exemplary Disclosure in the Prior Art
[1.pre] A television set comprising:	To the extent the preamble is limiting, Cooper expressly or inherently discloses “[a] television set.” For example:

¹ This chart also applies to Cooper combined with the knowledge of a POSITA, and combined with the other references cited in this chart.

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>FIG. 5</p> <p>Cooper, Fig. 5 (example television set), ¶¶ 38-40 (describing Fig. 5).</p> <p>“A set-top box essentially has the same basic components as the general purpose computer illustrated in FIG. 1, except that it also includes a TV tuner for receiving broadcast and/or cable TV signals.”</p> <p>Cooper, ¶ 11.</p> 

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Cooper, Fig. 1, ¶ 3 (describing Fig. 1).</p> <p><i>See also</i> the contentions for this preamble from the '236 patent IPR, incorporated here by reference.</p> <p>To the extent Cooper does not disclose any part of this limitation, Cooper renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Cooper combined with the knowledge of a person of ordinary skill in the art, and in light of Cooper combined with any of the other prior art references identified in the contentions for this patent, including Wick. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>[1.a] a television function unit provided inside the television set and arranged to relate to a television function;</p>	<p>Cooper expressly or inherently discloses “a television function unit provided inside the television set and arranged to relate to a television function.” For example:</p>  <p>Cooper, Fig. 5 (example television function unit), ¶¶ 38-40 (describing Fig. 5).</p> <p>“FIG. 5 shows a set- top box 500. The set-top box 500 receives TV signals from a TV source 504 such as a cable, satellite, or conventional TV provider. The box 500 includes a tuner 510 to select a TV channel for viewing. The selected TV channel may be digital in the case of a satellite TV source or analog in the</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>case of most cable TV sources. The box 500 can include an analog-to-digital converter 512 to permit digital processing of the TV images regardless of the TV source.”</p> <p>Cooper, ¶ 38.</p> <p><i>See also</i> Cooper, ¶ 11 (“a set-top box may neither be a box nor be placed on top of a display”).</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Cooper does not disclose any part of this limitation, Cooper renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Cooper combined with the knowledge of a person of ordinary skill in the art, and in light of Cooper combined with any of the other prior art references identified in the contentions for this patent, including Wick. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
[1.b] a detector provided inside the television set and arranged to detect a cause of change in the television function;	Cooper expressly or inherently discloses “a detector provided inside the television set and arranged to detect a cause of change in the television function.” For example:

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>FIG. 5</p> <p>Cooper, Fig. 5 (example television set), ¶¶ 38-40 (describing Fig. 5).</p>  <p>FIG. 14</p> <p>Cooper, Fig. 14 (example change in television function).</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>“FIG. 14 shows a process for updating the buddy list information initially transmitted. As each user changes channels 1402, the user’s set-top box transmits a message to the server describing the change 1404.”</p> <p>Cooper, ¶ 63.</p> <p><i>See also</i> Cooper, ¶ 53 (“In some embodiments, the set-top box transmits 712 a message to the server whenever a user changes channels.”)</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Cooper does not disclose any part of this limitation, Cooper renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Cooper combined with the knowledge of a person of ordinary skill in the art, and in light of Cooper combined with any of the other prior art references identified in the contentions for this patent, including Wick. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p> <p>Moreover, it also would have been obvious to a person of ordinary skill in the art to combine Cooper with the following prior art:</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p data-bbox="583 711 1575 743">TiVo Series2 Model No. TCD540080 (<i>see</i> Exhibit 968.F) (example detector).</p>  <p data-bbox="583 1365 1327 1398">TiVo Series2 Model No. TCD540080 (<i>see</i> Exhibit 968.F).</p>

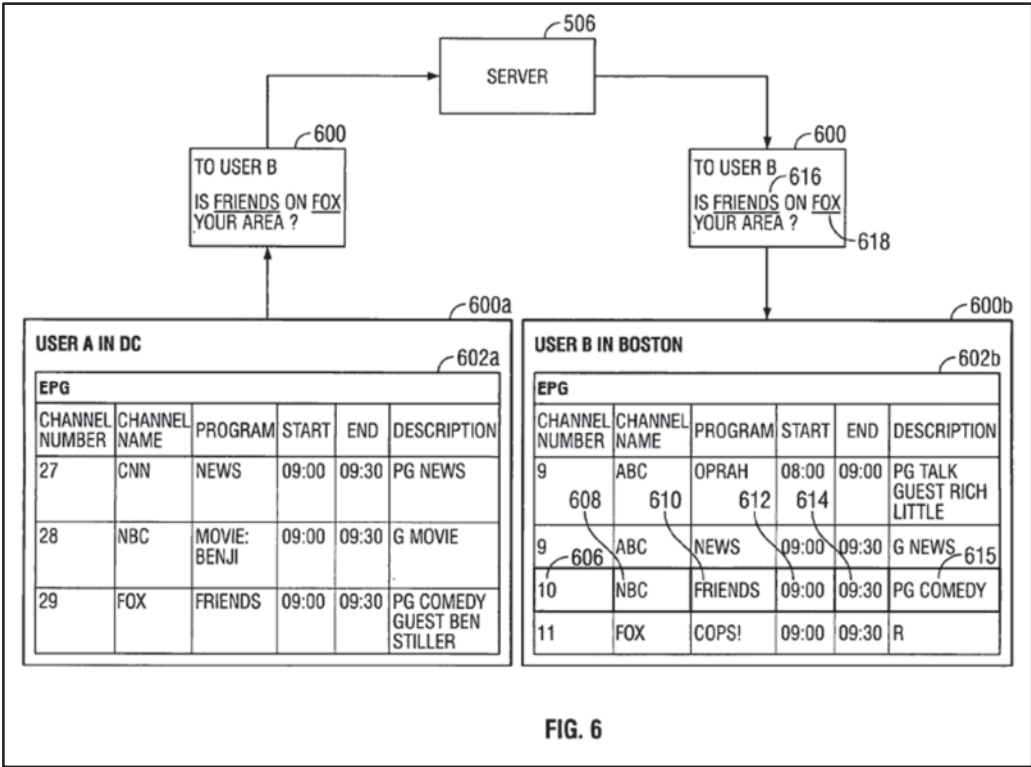
Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>TiVo Series2 Model No. TCD540080 (<i>see</i> Exhibit 968.F).</p> <p>TiVo Series2 Viewer's Guide 2003 (<i>see</i> Exhibit 968.F), pp. 6-8, 13-17, 19, 21, 25, 30-34, 37-38, 44-46 48, 50, 53, 56, 58, 62, 64, 76, 78-80, 82, 85, 88, 91, (using "SELECT" button, for example).</p> <p>TiVo Series2 Viewer's Guide 2003 (<i>see</i> Exhibit 968.F), "Remote Control Tips."</p>
[1.c] a communicator provided inside the television set and arranged to selectively	Cooper expressly or inherently discloses "a communicator provided inside the television set and arranged to selectively communicate with one of a plurality of outside counterparts by means of designating an address of

Claim Limitation	Exemplary Disclosure in the Prior Art
<p>communicate with one of a plurality of outside counterparts by means of designating an address of one of the outside counterparts, the plurality of outside counterparts including a first type of counterpart under free selection and a second type of counterpart which is predetermined;</p>	<p>one of the outside counterparts, the plurality of outside counterparts including a first type of counterpart under free selection and a second type of counterpart which is predetermined.” For example:</p> <div data-bbox="632 321 1455 971" data-label="Image"> </div> <p>FIG. 9</p> <p>Cooper, Fig. 9 (example first type of counterpart).</p> <p>“The display shown in FIG. 9 illustrates how a display can simultaneously present a television program and a chat room. The television program and chat room may be independent. That is, a user could change TV shows with changing chat rooms and vice-versa.”</p> <p>Cooper, ¶ 55.</p> <p>“In other embodiments, software may control the chat room the user is a member of so that it corresponds to the viewed television program. For example, as shown in FIG. 8, a display may include a region for displaying a received TV signal 800 (e.g., Gilligan’s Island) and a ‘TV chat’ control 802. Selecting the control automatically places a user in a chat room corresponding to the particular TV show. As shown in</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
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FIG. 9, when a user watching ‘Gilligan’s Island’ selects the TV chat control, the server places the user in a ‘Gilligan’s Island’ chat room 902 with other users viewing the show. The users can then share their comments on the show in real time by submitting messages to the server for display in the chat room window. The browser can configure the display such that the chat room text window 902 and the TV show display 900 can be viewed simultaneously.”

Cooper, ¶ 56.



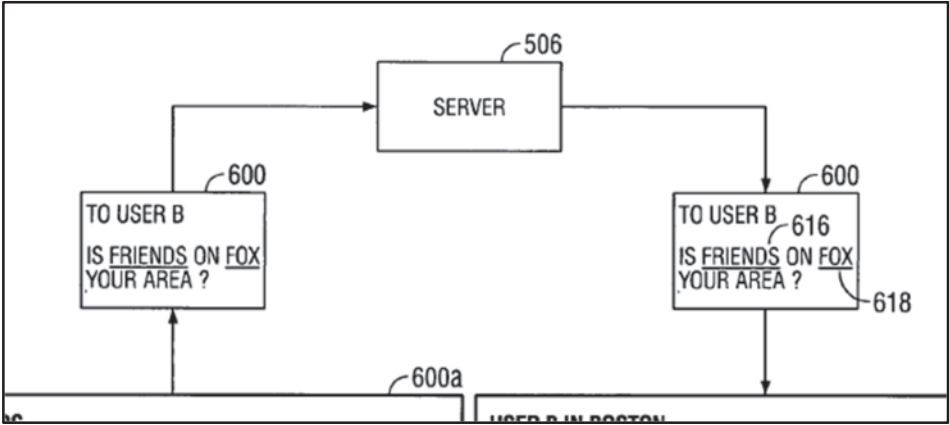
Cooper, Fig. 6 (example first type of counterpart), ¶ 42 (describing Fig. 6).

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>“FIG. 6 shows a set- top box 600 <i>a</i> in Washington, D.C. sending a message 600 to a set-top box 600 <i>b</i> in Boston via the server 506. The message 600 could be part of an e-mail message, a chat room entry, an instant message, etc.”</p> <p>Cooper, ¶ 42, Fig. 6.</p> <div data-bbox="632 448 1402 967" data-label="Diagram"> </div> <p>FIG. 11</p> <p>Cooper, Fig. 11 (example first type of counterpart, example second type of counterpart), <i>see also</i> Cooper, Figs. 12A-B.</p> <p>“FIG. 11 shows a set-top box display that includes a TV program 1102 and a TV-enhanced buddy list 1110. Like conventional buddy lists, a user can define a list of server system user names.”</p> <p>Cooper, ¶ 60.</p> <p>“A user creates a buddy list by entering the names of other server system users (e.g., friends, family, or co-workers).”</p> <p>Cooper, ¶ 10.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>“After a user logs-on, the set-top box software transmits the user’s buddy list 1300 to the server.” Cooper, ¶ 62.</p> <p>“FIGS. 12A and 12B shows server data 1204 used to provide the enhanced buddy list functions. The data 1204 includes a list 1206 of logged-in users and the TV show and/or network that each user is currently watching. The server also stores a buddy list 1208 for each user. The buddy list 1208 may be permanently stored on the server 1204 or transmitted to the server 1204 by a set-top box when a user logs-on.” Cooper, ¶ 61; <i>see also</i> Cooper, ¶ 63.</p> <div data-bbox="632 574 1199 1125" data-label="Diagram"> <pre> graph TD Internet((Internet)) <--> Server[Server] STB[Set-top box] --> Server </pre> <p>The diagram shows a cloud labeled 'Internet' with reference numeral 508. Below it is a rectangular box labeled 'Server' with reference numeral 506. A double-headed vertical arrow connects the Internet cloud to the Server box. To the right of the Server box, there is a horizontal line representing a set-top box, with an arrow pointing from it to the right side of the Server box.</p> </div> <p>Cooper, Fig. 5 (example second type of counterpart), ¶¶ 38-40 (describing Fig. 5). <i>See also</i> Cooper, Figs. 6, 12A-B (showing server), ¶ 42 (describing Fig. 6), ¶ 61 (describing Figs. 12A-B).</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<div data-bbox="630 211 1398 633" data-label="Diagram"> <pre> graph TD In[] --> 500 subgraph 500 [Set-Top] 514[Communications Card] 510[Tuner] 512[A/D] 516[Browser] 514 --> 516 510 -- 512 --> 516 end 516 <--> 517 517 --> 502 502 --> 506[Network Server] </pre> </div> <p>Cooper, Fig. 5 (example communicator), ¶¶ 38-40 (describing Fig. 5).</p> <p>“The box 500 includes a network communication card 514 to communicate with a network server 506 such as an ISP (Internet Service Provider). The box 500 also includes browser client software 516 for communicating with the server, for example, by sending and receiving HTTP (HyperText Transfer Protocol) messages. Additionally, the box 500 includes communication protocol software (e.g., TCP/IP) and an operating system.”</p> <p>Cooper, ¶ 39 (example communicator).</p> <p><i>See also</i> Cooper, ¶¶ 9, 55-56 (user’s chat messages are communicated to the chat room members).</p> <p>“As shown in FIG. 12A, when a user changes channels, set-top box software transmits a message to the server including the name of the show and/or the network the user is presently viewing.”</p> <p>Cooper, ¶ 61, Fig. 12A.</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Cooper does not disclose any part of this limitation, Cooper renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Cooper combined with the knowledge of a person of ordinary skill in the art, and in light of Cooper combined with</p>

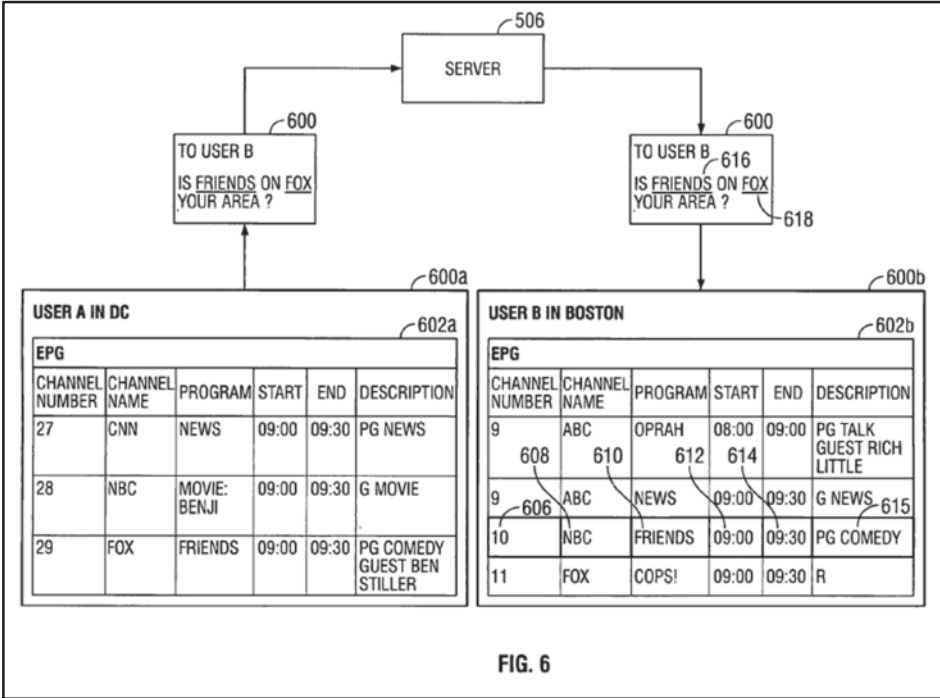
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>any of the other prior art references identified in the contentions for this patent, including Wick. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>[1.d] an input provided inside the television set and arranged to newly and freely prepare first information;</p>	<p>Cooper expressly or inherently discloses “an input provided inside the television set and arranged to newly and freely prepare first information.” For example:</p> <div data-bbox="632 496 1467 1159" data-label="Image"> <p>The diagram shows a rectangular frame representing a television screen. It is divided into two horizontal rectangular areas. The upper area is labeled '900' on its right side and contains the text 'Images from Gilligan's Island'. The lower area is labeled '902' on its right side and contains a chat room interface. The chat room text reads: 'Welcome to the Gilligan's Island chat-room', 'Al: <u>Gilligan's Island</u> stinks. I'm going to switch to <u>MTV</u>.', and 'Bob: Are you kidding??? This is the episode where they have to eat the skipper to stay alive'. At the bottom right of the chat room area is a small rectangular button labeled 'SEND'.</p> </div> <p>FIG. 9</p> <p>Cooper, Fig. 9 (example input and first information), ¶¶ 55-56 (describing Fig. 9).</p> <p>“As shown in FIG. 9, when a user watching ‘Gilligan’s Island’ selects the TV chat control, the server places the user in a ‘Gilligan’s Island’ chat room 902 with other users viewing the show. The users can then share their comments on the show in real time by submitting messages to the server for display in the</p>

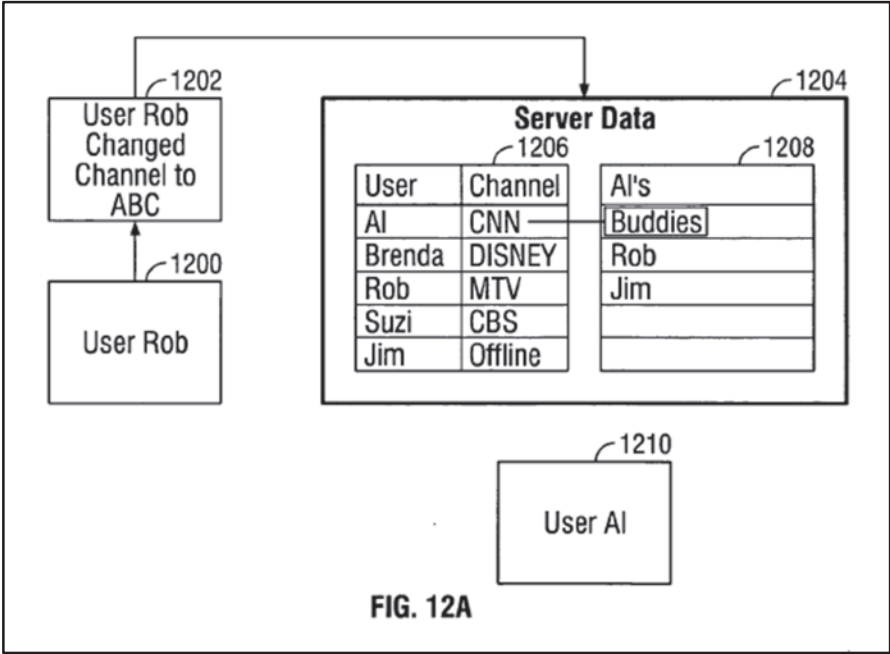
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>chat room window. The browser can configure the display such that the chat room text window 902 and the TV show display 900 can be viewed simultaneously.”</p> <p>Cooper, ¶ 56; <i>see also</i> Cooper, ¶¶ 54-58 (describing chat room).</p>  <p>Cooper, Fig. 6 (example input and first information), ¶ 42 (describing Fig. 6)</p> <p>“FIG. 6 shows a set- top box 600 <i>a</i> in Washington, D.C. sending a message 600 to a set-top box 600 <i>b</i> in Boston via the server 506. The message 600 could be part of an e-mail message, a chat room entry, an instant message, etc.”</p> <p>Cooper, ¶ 42.</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Cooper does not disclose any part of this limitation, Cooper renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Cooper combined with the knowledge of a person of ordinary skill in the art, and in light of Cooper combined with any of the other prior art references identified in the contentions for this patent, including Wick. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
<p>[1.e] a first designator provided inside the television set and arranged to freely designate a desired address of the first type of outside counterpart to which the first information is sent;</p>	<p>Cooper expressly or inherently discloses “a first designator provided inside the television set and arranged to freely designate a desired address of the first type of outside counterpart to which the first information is sent.” For example:</p> <p><i>See limitation 1.d (preparing first information).</i></p> <div data-bbox="630 431 1467 1092" data-label="Image"> </div> <p>Cooper, Fig. 9 (example addressing first type of counterpart), ¶¶ 55-56 (describing Fig. 9).</p>

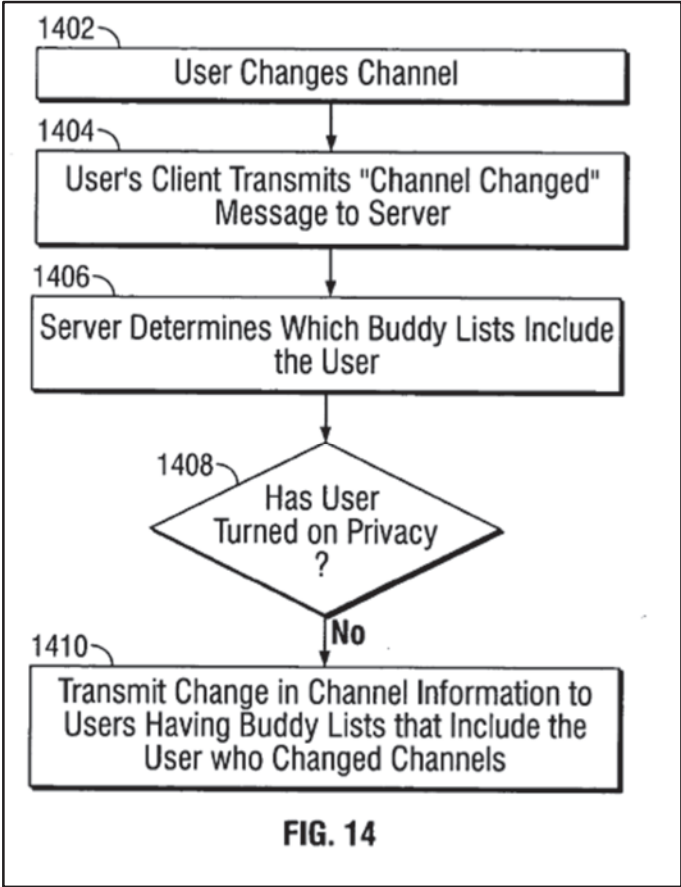
Claim Limitation	Exemplary Disclosure in the Prior Art
	<div data-bbox="632 212 1614 943"> <p style="text-align: center;">FIG. 6</p> </div> <p>Cooper, Fig. 6 (example addressing first type of counterpart), ¶ 42 (describing Fig. 6).</p> <p>“FIG. 6 shows a set- top box 600 <i>a</i> in Washington, D.C. sending a message 600 to a set-top box 600 <i>b</i> in Boston via the server 506. The message 600 could be part of an e-mail message”</p> <p>Cooper, ¶ 42.</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Cooper does not disclose any part of this limitation, Cooper renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Cooper combined with the knowledge of a person of ordinary skill in the art, and in light of Cooper combined with any of the other prior art references identified in the contentions for this patent, including Wick. The manner</p>

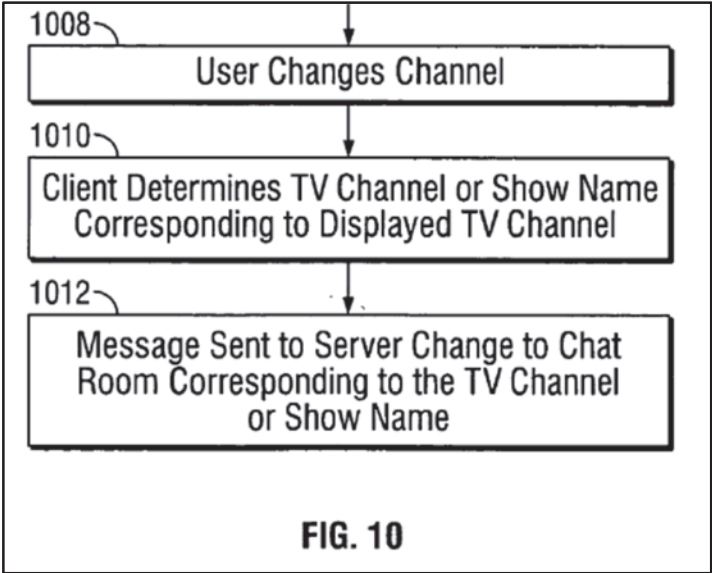
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>[1.f] a first trigger provided inside the television set and arranged to send the first information to the first type of counterpart through the communicator when the first trigger is manually operated;</p>	<p>Cooper expressly or inherently discloses “a first trigger provided inside the television set and arranged to send the first information to the first type of counterpart through the communicator when the first trigger is manually operated.” For example:</p> <p><i>See limitation 1.c (the communicator).</i></p> <div data-bbox="632 570 1467 1230" data-label="Image"> </div> <p>FIG. 9</p> <p>Cooper, Fig. 9 (example first trigger), ¶¶ 55-56 (describing Fig. 9).</p> <p>Cooper, ¶ 39.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p data-bbox="1123 857 1178 881">FIG. 6</p> <p data-bbox="583 927 1381 959">Cooper, Fig. 6 (example first trigger), ¶ 42 (describing Fig. 6).</p> <p data-bbox="632 1000 1965 1068">“FIG. 6 shows a set-top box 600 <i>a</i> in Washington, D.C. sending a message 600 to a set-top box 600 <i>b</i> in Boston via the server 506. The message 600 could be part of an e-mail message”</p> <p data-bbox="583 1089 758 1122">Cooper, ¶ 42.</p> <p data-bbox="632 1162 1959 1341">“The box 500 includes a network communication card 514 to communicate with a network server 506 such as an ISP (Internet Service Provider). The box 500 also includes browser client software 516 for communicating with the server, for example, by sending and receiving HTTP (HyperText Transfer Protocol) messages. Additionally, the box 500 includes communication protocol software (e.g., TCP/IP) and an operating system.”</p> <p data-bbox="583 1362 1430 1395">Cooper, ¶ 39 (information sent through the communicator), Fig. 5.</p>

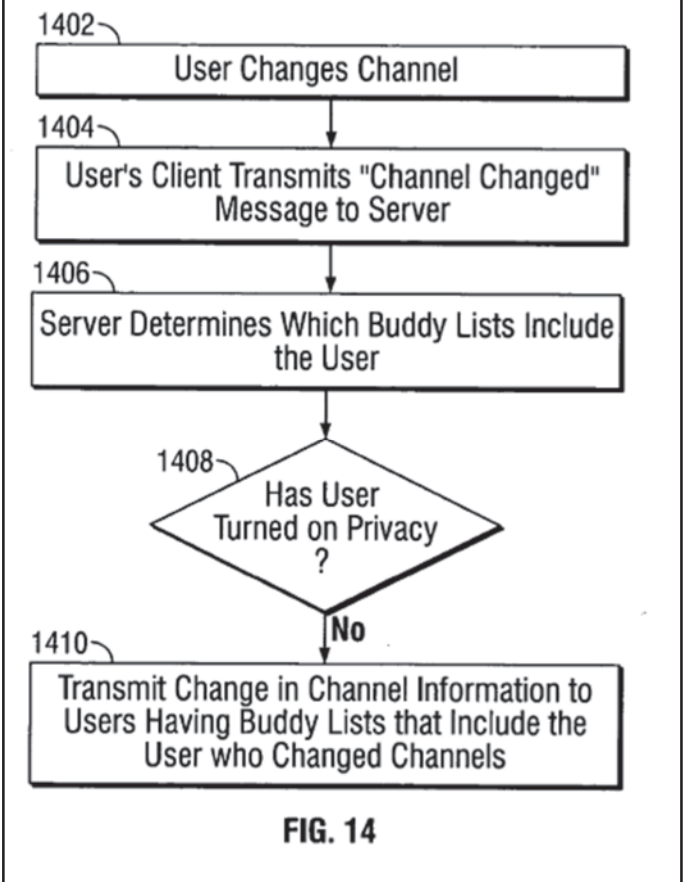
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p><i>See also</i> the contentions for this limitation from the '236 patent IPR, incorporated here by reference.</p> <p>To the extent Cooper does not disclose any part of this limitation, Cooper renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Cooper combined with the knowledge of a person of ordinary skill in the art, and in light of Cooper combined with any of the other prior art references identified in the contentions for this patent, including Wick. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>[1.g] an automatic generator provided inside the television set and arranged to generate predetermined second information in response to the detector which detects a cause of a predetermined change in the television function;</p>	<p>Cooper expressly or inherently discloses “an automatic generator provided inside the television set and arranged to generate predetermined second information in response to the detector which detects a cause of a predetermined change in the television function.” For example:</p>  <p>FIG. 12A</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Cooper, Fig. 12A (example automatic generator and second information), ¶ 61 (describing Fig. 21A).</p> <p>“As shown in FIG. 12A, when a user changes channels, set-top box software transmits a message to the server including the name of the show and/or the network the user is presently viewing. As shown in FIG. 12B, the server 1204 updates the user list 1206 to reflect the new viewing information. The server also transmits a message 1212 to each logged-in user that included the channel-changing user in his or her list.”</p> <p>Cooper, ¶ 61, Figs. 12A-B.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <pre> graph TD 1402[1402 User Changes Channel] --> 1404[1404 User's Client Transmits "Channel Changed" Message to Server] 1404 --> 1406[1406 Server Determines Which Buddy Lists Include the User] 1406 --> 1408{1408 Has User Turned on Privacy?} 1408 -- No --> 1410[1410 Transmit Change in Channel Information to Users Having Buddy Lists that Include the User who Changed Channels] </pre> <p style="text-align: center;">FIG. 14</p> <p>Cooper, Fig. 14 (example automatic generator and second information), ¶ 63 (describing Fig. 14).</p> <p>“FIG. 14 shows a process for updating the buddy list information initially transmitted. As each user changes channels 1402, the user’s set-top box transmits a message to the server describing the change 1404. The server uses these messages to update its user list 1406. After updating 1404, the server broadcasts 1410 the change to each logged-on user who included the channel changing user in their buddy list. Viewers can turn off this feature if they do not want others to see the name of the TV show they are watching.”</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Cooper, ¶ 63, Fig. 14.</p>  <pre> graph TD 1008[1008 User Changes Channel] --> 1010[1010 Client Determines TV Channel or Show Name Corresponding to Displayed TV Channel] 1010 --> 1012[1012 Message Sent to Server Change to Chat Room Corresponding to the TV Channel or Show Name] </pre> <p>FIG. 10</p> <p>Cooper, Fig. 10 (example automatic generator and second information), ¶ 58 (describing Fig. 10).</p> <p>“As described, each time the user changes channels 1008, the set-top box can transmit a message to the server 1010, 1012 indicating the new channel the viewer is watching.”</p> <p>Cooper, ¶ 58, Fig. 10.</p> <p><i>See also</i> Cooper, ¶ 53 (“the set-top box transmits 712 a message to the server whenever a user changes channels”).</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Cooper does not disclose any part of this limitation, Cooper renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Cooper combined with the knowledge of a person of ordinary skill in the art, and in light of Cooper combined with</p>

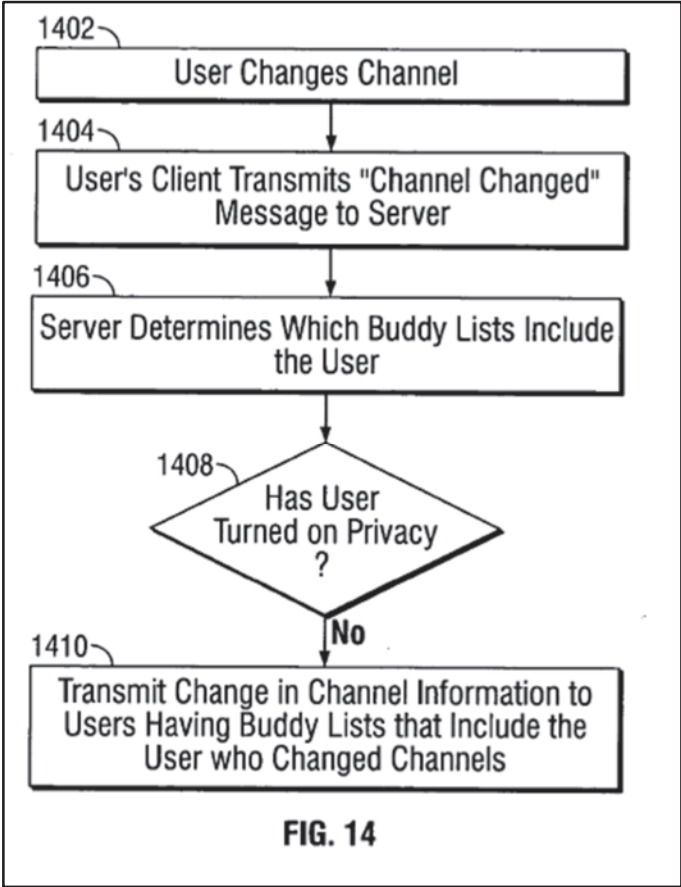
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>any of the other prior art references identified in the contentions for this patent, including Wick. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>[1.h] a second designator provided inside the television set and arranged to automatically designate a predetermined address of the second type of outside counterpart to which the second information is sent; and</p>	<p>Cooper expressly or inherently discloses “a second designator provided inside the television set and arranged to automatically designate a predetermined address of the second type of outside counterpart to which the second information is sent.” For example:</p> <p><i>See</i> limitation 1.g (the second information).</p> <div data-bbox="632 607 1516 1256" data-label="Diagram"> <p>FIG. 12A</p> </div> <p>Cooper, Fig. 12A (example predetermined address designation by second designator), ¶ 61 (describing Fig. 21A).</p>

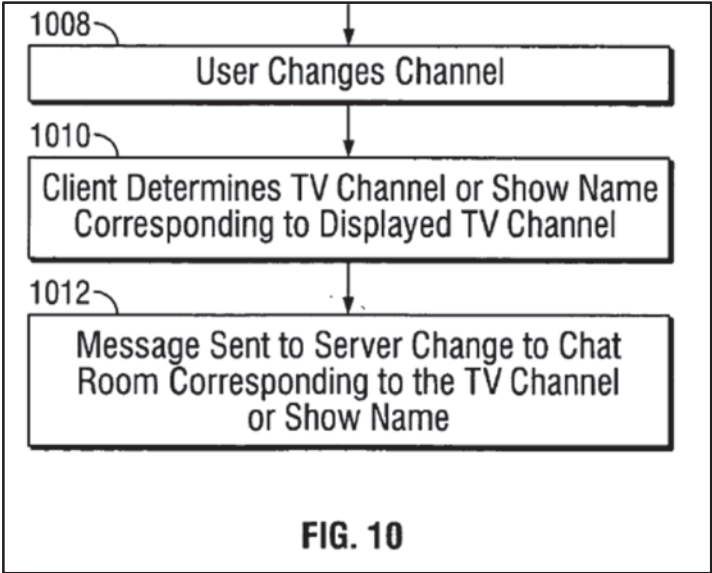
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>“As shown in FIG. 12A, when a user changes channels, set-top box software transmits a message to the server including the name of the show and/or the network the user is presently viewing. As shown in FIG. 12B, the server 1204 updates the user list 1206 to reflect the new viewing information. The server also transmits a message 1212 to each logged-in user that included the channel-changing user in his or her list.”</p> <p>Cooper, ¶ 61, Figs. 12A-B.</p>  <pre> graph TD 1402[1402 User Changes Channel] --> 1404[1404 User's Client Transmits "Channel Changed" Message to Server] 1404 --> 1406[1406 Server Determines Which Buddy Lists Include the User] 1406 --> 1408{1408 Has User Turned on Privacy ?} 1408 -- No --> 1410[1410 Transmit Change in Channel Information to Users Having Buddy Lists that Include the User who Changed Channels] </pre> <p>FIG. 14</p> <p>Cooper, Fig. 14 (example predetermined address designation by second designator), ¶ 63 (describing Fig. 14).</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>“FIG. 14 shows a process for updating the buddy list information initially transmitted. As each user changes channels 1402, the user’s set-top box transmits a message to the server describing the change 1404. The server uses these messages to update its user list 1406. After updating 1404, the server broadcasts 1410 the change to each logged-on user who included the channel changing user in their buddy list. Viewers can turn off this feature if they do not want others to see the name of the TV show they are watching.”</p> <p>Cooper, ¶ 63, Fig. 14.</p> <div data-bbox="627 555 1339 1127" data-label="Diagram"> <pre> graph TD 1008[1008 User Changes Channel] --> 1010[1010 Client Determines TV Channel or Show Name Corresponding to Displayed TV Channel] 1010 --> 1012[1012 Message Sent to Server Change to Chat Room Corresponding to the TV Channel or Show Name] </pre> <p style="text-align: center;">FIG. 10</p> </div> <p>Cooper, Fig. 10 (example predetermined address designation by second designator), ¶ 58 (describing Fig. 10).</p> <p>“As described, each time the user changes channels 1008, the set-top box can transmit a message to the server 1010, 1012 indicating the new channel the viewer is watching.”</p> <p>Cooper, ¶ 58, Fig. 10.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p><i>See also</i> Cooper, ¶ 53 (“the set-top box transmits 712 a message to the server whenever a user changes channels”).</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Cooper does not disclose any part of this limitation, Cooper renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Cooper combined with the knowledge of a person of ordinary skill in the art, and in light of Cooper combined with any of the other prior art references identified in the contentions for this patent, including Wick. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>[1.i] a second trigger provided inside the television set and arranged to automatically send the second information to the second type of counterpart through the same communicator in response to completion of the function of the automatic generator and the second designator.</p>	<p>Cooper expressly or inherently discloses “a second trigger provided inside the television set and arranged to automatically send the second information to the second type of counterpart through the same communicator in response to completion of the function of the automatic generator and the second designator.” For example:</p> <p><i>See</i> limitation 1.c (the communicator, second type of counterpart).</p> <p><i>See</i> limitation 1.g (the second information).</p>

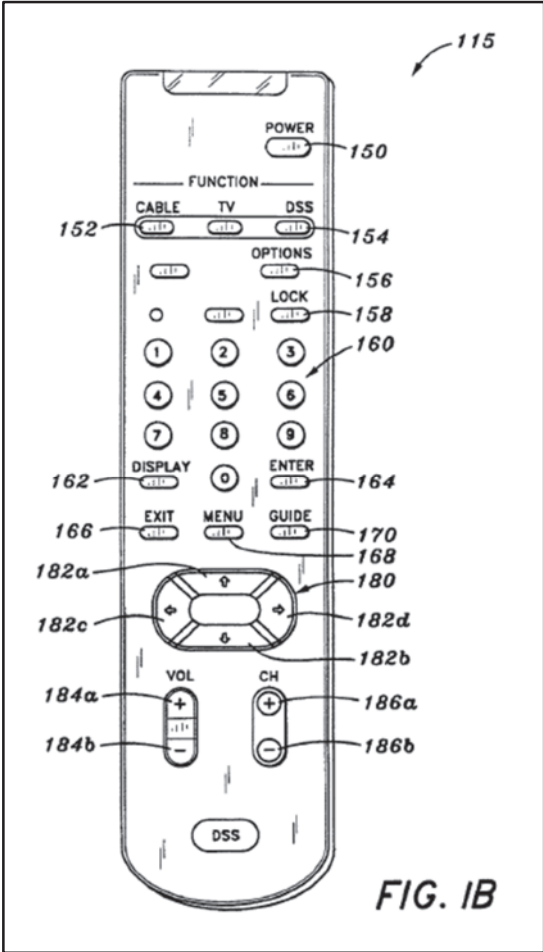
Claim Limitation	Exemplary Disclosure in the Prior Art
	<div data-bbox="632 212 1516 862" data-label="Diagram"> <p style="text-align: center;">FIG. 12A</p> </div> <p data-bbox="583 883 1497 915">Cooper, Fig. 12A (example second trigger), ¶ 61 (describing Fig. 21A).</p> <p data-bbox="627 956 1982 1135">“As shown in FIG. 12A, when a user changes channels, set-top box software transmits a message to the server including the name of the show and/or the network the user is presently viewing. As shown in FIG. 12B, the server 1204 updates the user list 1206 to reflect the new viewing information. The server also transmits a message 1212 to each logged-in user that included the channel-changing user in his or her list.”</p> <p data-bbox="583 1156 932 1188">Cooper, ¶ 61, Figs. 12A-B.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <pre> graph TD 1402[1402 User Changes Channel] --> 1404[1404 User's Client Transmits "Channel Changed" Message to Server] 1404 --> 1406[1406 Server Determines Which Buddy Lists Include the User] 1406 --> 1408{1408 Has User Turned on Privacy?} 1408 -- No --> 1410[1410 Transmit Change in Channel Information to Users Having Buddy Lists that Include the User who Changed Channels] </pre> <p style="text-align: center;">FIG. 14</p> <p>Cooper, Fig. 14 (example second trigger), ¶ 63 (describing Fig. 14).</p> <p>“FIG. 14 shows a process for updating the buddy list information initially transmitted. As each user changes channels 1402, the user’s set-top box transmits a message to the server describing the change 1404. The server uses these messages to update its user list 1406. After updating 1404, the server broadcasts 1410 the change to each logged-on user who included the channel changing user in their buddy list. Viewers can turn off this feature if they do not want others to see the name of the TV show they are watching.”</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Cooper, ¶ 63, Fig. 14.</p>  <pre> graph TD 1008[1008 User Changes Channel] --> 1010[1010 Client Determines TV Channel or Show Name Corresponding to Displayed TV Channel] 1010 --> 1012[1012 Message Sent to Server Change to Chat Room Corresponding to the TV Channel or Show Name] </pre> <p>FIG. 10</p> <p>Cooper, Fig. 10 (example second trigger), ¶ 58 (describing Fig. 10).</p> <p>“As described, each time the user changes channels 1008, the set-top box can transmit a message to the server 1010, 1012 indicating the new channel the viewer is watching.”</p> <p>Cooper, ¶ 58, Fig. 10.</p> <p><i>See also</i> Cooper, ¶ 53 (“the set-top box transmits 712 a message to the server whenever a user changes channels”).</p> <p>“The box 500 includes a network communication card 514 to communicate with a network server 506 such as an ISP (Internet Service Provider). The box 500 also includes browser client software 516 for communicating with the server, for example, by sending and receiving HTTP (HyperText Transfer Protocol) messages. Additionally, the box 500 includes communication protocol software (e.g., TCP/IP) and an operating system.”</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Cooper, ¶ 39 (information sent through the communicator), Fig. 5.</p> <p><i>See also</i> the contentions for this limitation from the '236 patent IPR, incorporated here by reference.</p> <p>To the extent Cooper does not disclose any part of this limitation, Cooper renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Cooper combined with the knowledge of a person of ordinary skill in the art, and in light of Cooper combined with any of the other prior art references identified in the contentions for this patent, including Wick. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>2. The television set according to claim 1, wherein the detector includes a receiver arranged to receive a signal from a remote controller.</p>	<p>Cooper expressly or inherently discloses “[t]he television set according to claim 1, wherein the detector includes a receiver arranged to receive a signal from a remote controller.” For example:</p> <p><i>See</i> limitation 1.b (the detector).</p> <div data-bbox="630 823 1159 1157" data-label="Image"> </div> <p>Cooper, Fig. 1 (example remote controller), ¶ 3 (describing Fig. 1).</p> <p>“A set-top box essentially has the same basic components as the general purpose computer illustrated in FIG. 1, except that it also includes a TV tuner for receiving broadcast and/or cable TV signals. Users of such ‘web TV’ systems can make dual usage of their TV sets—that is, either to watch TV or to view web pages and otherwise ‘surf’ the Internet.”</p>

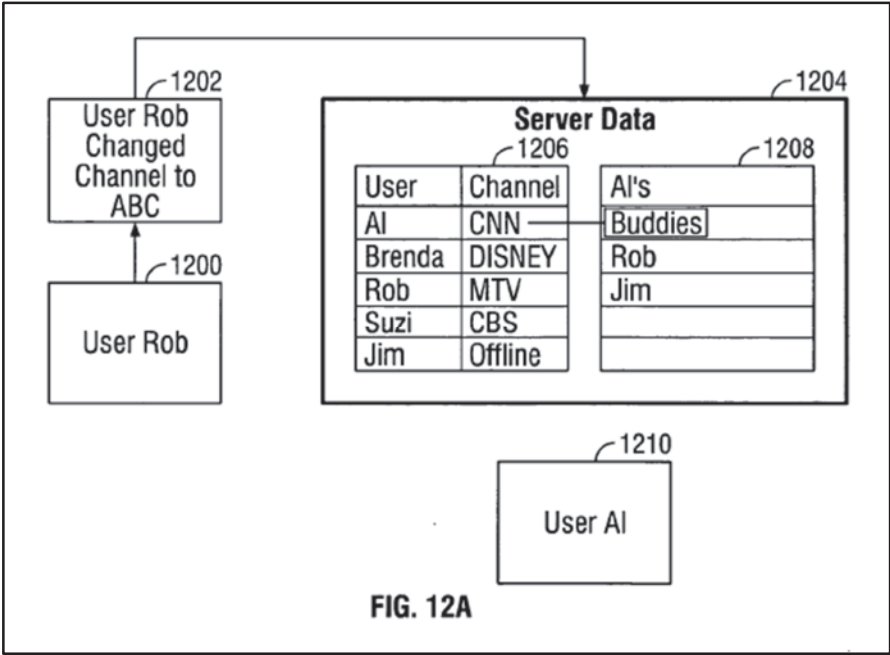
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Cooper, ¶ 11.</p> <p>“The box 500 constructs a display that can include information received from the server 506 and/or from the TV source 504. The box 500 sends the constructed display to a TV 502 or monitor via an output port 517. In one embodiment, the browser 516 (e.g., Liberate’s TV Navigator) integrates server and TV information by processing an HTML-like (HyperText Manipulation Language) tag (e.g.) that instructs the browser 516 to place incoming TV images on the screen at specified coordinates. By modifying a received web-page to include this tag, the browser 516 can display the TV data received from the TV source 504 in conjunction with information provided by the server 506. Alterations to the screen, such as adding user interface controls or moving and/or resizing the TV image also can be performed by altering instructions of a web-page displayed by the browser. The box 500 may store a default web-page that makes the received TV signal a full-screen background image 518 with overlaid user interface controls 520. The controls 520 can correspond to functions such as initiating a session with the server 506.”</p> <p>Cooper, ¶ 40.</p> <p><i>See also</i> Cooper, ¶¶ 60-63 (chat functionality with TV viewing).</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Cooper does not disclose any part of this limitation, Cooper renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Cooper combined with the knowledge of a person of ordinary skill in the art, and in light of Cooper combined with any of the other prior art references identified in the contentions for this patent, including Wick. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p> <p>Moreover, it also would have been obvious to a person of ordinary skill in the art to combine Cooper with the following prior art:</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>U.S. Pat. App. Pub. No. 2002/0078442 (“Reyes”), Fig. 1B.</p> <p>“The remote control 115 comprises a power key 150 for activating the IRD 110 via a communication link, a cable key 152 which facilitates selection of cable channels, a DSS key 154 which facilitates selection of satellite-based channels, an OPTIONS key 156 for facilitating selection of desired channels; a LOCK key 158 for facilitating locking and unlocking of the control functions of the remote control 115, a numerical</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>keypad 160, a DISPLAY key 162, an ENTER key 164, an EXIT key 166, a MENU key 168, and a GUIDE key 170.”</p> <p>Reyes, ¶ 24.</p>  <p>TiVo Series2 (<i>see</i> Exhibit 968.F).</p> <p><i>See also</i> TiVo Series2 Viewer’s Guide 2003 (<i>see</i> Exhibit 968.F).</p>
<p>4. The television set according to claim 1, wherein the automatic generator is arranged to generate the second information in</p>	<p>Cooper expressly or inherently discloses “[t]he television set according to claim 1, wherein the automatic generator is arranged to generate the second information in accordance with a predetermined format.” For example:</p> <p><i>See</i> limitation 1.g (generate the second information).</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
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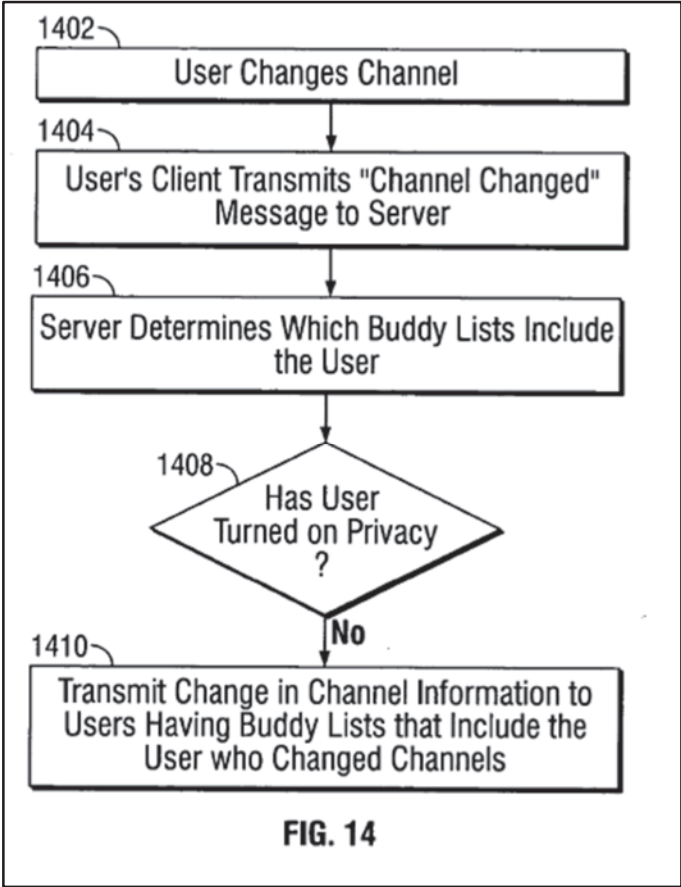
accordance with a predetermined format.



Cooper, Fig. 12A (example generation of second information in predetermined format), ¶ 61 (describing Fig. 21A).

“As shown in FIG. 12A, when a user changes channels, set-top box software transmits a message to the server including the name of the show and/or the network the user is presently viewing. As shown in FIG. 12B, the server 1204 updates the user list 1206 to reflect the new viewing information. The server also transmits a message 1212 to each logged-in user that included the channel-changing user in his or her list.”

Cooper, ¶ 61, Figs. 12A-B.

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <pre> graph TD 1402[1402 User Changes Channel] --> 1404[1404 User's Client Transmits "Channel Changed" Message to Server] 1404 --> 1406[1406 Server Determines Which Buddy Lists Include the User] 1406 --> 1408{1408 Has User Turned on Privacy?} 1408 -- No --> 1410[1410 Transmit Change in Channel Information to Users Having Buddy Lists that Include the User who Changed Channels] </pre> <p style="text-align: center;">FIG. 14</p> <p>Cooper, Fig. 14 (example generation of second information in predetermined format), ¶ 63 (describing Fig. 14).</p> <p>“FIG. 14 shows a process for updating the buddy list information initially transmitted. As each user changes channels 1402, the user’s set-top box transmits a message to the server describing the change 1404. The server uses these messages to update its user list 1406. After updating 1404, the server broadcasts 1410 the change to each logged-on user who included the channel changing user in their buddy</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>list. Viewers can turn off this feature if they do not want others to see the name of the TV show they are watching.”</p> <p>Cooper, ¶ 63, Fig. 14.</p> <div data-bbox="632 375 1339 943"> <pre> graph TD 1008[1008 User Changes Channel] --> 1010[1010 Client Determines TV Channel or Show Name Corresponding to Displayed TV Channel] 1010 --> 1012[1012 Message Sent to Server Change to Chat Room Corresponding to the TV Channel or Show Name] </pre> <p>FIG. 10</p> </div> <p>Cooper, Fig. 10 (example generation of second information in predetermined format), ¶ 58 (describing Fig. 10).</p> <p>“As described, each time the user changes channels 1008, the set-top box can transmit a message to the server 1010, 1012 indicating the new channel the viewer is watching.”</p> <p>Cooper, ¶ 58, Fig. 10.</p> <p><i>See also</i> Cooper, ¶ 53 (“the set-top box transmits 712 a message to the server whenever a user changes channels”).</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>To the extent Cooper does not disclose any part of this limitation, Cooper renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Cooper combined with the knowledge of a person of ordinary skill in the art, and in light of Cooper combined with any of the other prior art references identified in the contentions for this patent, including Wick. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>6. The television set according to claim 1, wherein the second designator is arranged to designate an address of another television set located in another place.</p>	<p>Cooper expressly or inherently discloses “[t]he television set according to claim 1, wherein the second designator is arranged to designate an address of another television set located in another place.” For example:</p> <p><i>See limitation 1.h (second designator).</i></p> <div data-bbox="632 716 1402 1235"> <p>FIG. 11 is a schematic diagram of a television set-top box display. The display is represented by a large rectangle with a double border, labeled 1102. Inside the display, there is a smaller rectangle labeled 1110, which contains a list of names and their corresponding TV channels or status. The names are Al, Bob, Carol, Rob, and Sam. The channels/status are CNN, FOX, CBS, (Private), and (Offline). To the left of the list, there are labels 1108, 1106, and 1104 pointing to the list area. Below the list, there are labels 1106 and 1104 pointing to the 'Private' and 'TV Chat' options. The label 'Exit' is at the bottom of the list. The text 'TV Images' is to the right of the list. The label 'FIG. 11' is centered below the display.</p> </div> <p>Cooper, Fig. 11 (example address of another television set), <i>see also</i> Cooper, Figs. 12A-B.</p> <p>“FIG. 11 shows a set-top box display that includes a TV program 1102 and a TV-enhanced buddy list 1110. Like conventional buddy lists, a user can define a list of server system user names.”</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Cooper, ¶ 60.</p> <p><i>See also</i> Cooper, ¶¶ 10, 61-62 (describing buddy list), ¶ 63 (notifying buddy list of changes).</p> <p><i>See also</i> the contentions for this limitation from the '236 patent IPR, incorporated here by reference.</p> <p>To the extent Cooper does not disclose any part of this limitation, Cooper renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Cooper combined with the knowledge of a person of ordinary skill in the art, and in light of Cooper combined with any of the other prior art references identified in the contentions for this patent, including Wick. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p> <p>Moreover, it also would have been obvious to a person of ordinary skill in the art to combine Cooper with the following prior art:</p>

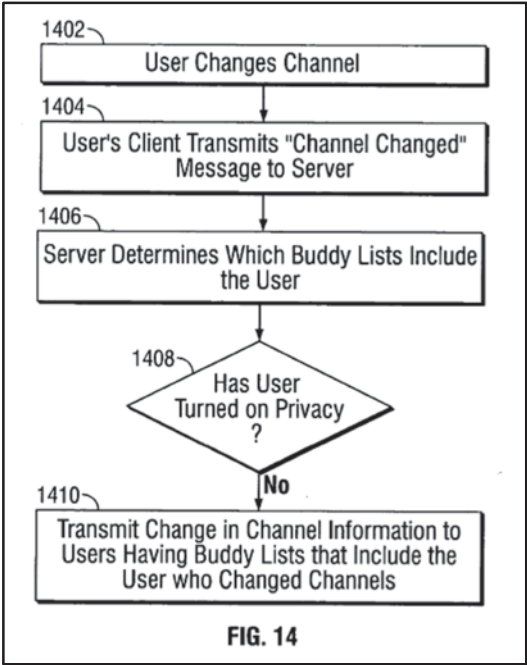
Claim Limitation	Exemplary Disclosure in the Prior Art
	<div data-bbox="632 212 1740 1032" data-label="Diagram"> <p style="text-align: center;">FIG. 10</p> </div> <p data-bbox="583 1052 1308 1088">U.S. Pat. App. Pub. No. 2006/0258289 (“Dua”), Fig. 10.</p> <p data-bbox="627 1127 1961 1230">“The method includes, selecting a media source, selecting specific media assets, selecting an address for the target device, resolving the address to an Internet routable address, and establishing a peer-to-peer communication session with the target device over the Internet.”</p> <p data-bbox="583 1252 716 1287">Dua, ¶ 21.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p data-bbox="627 215 1976 321">“In one embodiment, media player 100 functions as a wireless terminal that has one or more E.164 phone numbers, Uniform Resource Identifiers (URIs), or other types of unique addresses that can be resolved over the Internet associated with it.”</p> <p data-bbox="583 341 716 375">Dua, ¶ 67.</p> <p data-bbox="627 414 1976 630">“Upon selecting specific media assets from the media source categories in step 570 the user is prompted (in step 573) to select the addresses of one or more remote recipients to which the media assets should be transmitted. The user may be presented on Screen with a contact list or ‘buddy list’ from which to select one or more recipients of the media assets. In a preferred embodiment, the contact list or ‘buddy list’ profiles contain unique addresses for target devices which can be resolved via the Internet, for routing over the global network.”</p> <p data-bbox="583 649 730 683">Dua, ¶ 178.</p> <p data-bbox="627 722 1955 792">“A transceiver and tuner in the media player 100 allows the unit to receive local television channels and other content from local devices in the vicinity via these frequency bands.”</p> <p data-bbox="583 812 730 846">Dua, ¶ 169.</p> <p data-bbox="627 885 1923 954">“Upon connecting with the target device, a secure, peer-to-peer communication session is established between the media player 100 and the target device.”</p> <p data-bbox="583 974 730 1008">Dua, ¶ 183.</p> <p data-bbox="627 1047 1892 1117">“In step 575, after peer-to-peer connectivity is established between media player 100 and the target device, the selected media assets are transmitted to the target device from the media player 100.”</p> <p data-bbox="583 1136 730 1170">Dua, ¶ 187.</p> <p data-bbox="627 1209 1934 1312">“Mapped to User B’s name could be an E.164 number, URI, SIP address, or other Internet-routable address which corresponds to User B’s wireless media player 100B. All of these address types can be resolved via the Internet to target the delivery of the live video feed to User B’s media player 100B.”</p> <p data-bbox="583 1331 730 1365">Dua, ¶ 192.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p data-bbox="627 215 1934 284">“The IP address is further used to establish a SIP peer-to-peer session over the Internet between media player 100A and 100B as earlier described.”</p> <p data-bbox="583 305 730 337">Dua, ¶ 193.</p> <p data-bbox="627 378 1927 479">“Assuming the connection attempt is accepted by user B, a SIP peer-to-peer connection is established between the two devices. Media player 100A begins transmitting the video content to media player 100B.”</p> <p data-bbox="583 505 730 537">Dua, ¶ 194.</p> <p data-bbox="627 578 1976 1047">“As described up until now, the media player 100 has the ability to receive media content from a wide array of devices either in local proximity or over a wide area network. The media player 100 also has a built-in transceiver for transmitting/receiving content via broadcast frequency bands such as UHF, VHF, AM, and FM. In accordance with the invention, the media player 100 may have the ability to receive, for example, television and radio content over these broadcast frequency bands and convert the content to a digital format that can be stored in the media players hard drive 112 and later accessed by the user via the media manager application operating on media player 100. According to one embodiment of the invention, the media manager application enables the media player 100 to function as a digital video recorder (DVR). The digital video recording functionality can be enabled at the user's option. When enabled, the media player 100 digitally encodes all incoming broadcast signals being viewed by the user, and a saves them to the media players hard drive, allowing the user to pause, play, rewind, watch video in slow motion, and perform other operations with live programming similar to digital video recording devices such as TiVo or ReplayTV.”</p> <p data-bbox="583 1068 730 1101">Dua, ¶ 205.</p> <p data-bbox="627 1141 1976 1356">“While this invention has been described in terms of several preferred embodiments, there are alterations, per mutations, and equivalents, which fall within the scope of this invention. For example, although the invention has been described in terms of a wireless media player 100, it should be appreciated that certain features of the invention may also be applied to other types of electronic devices (e.g., cameras, music players, video players, PDAs, cellular phones, game players, portable storage devices, headphones, televisions,”</p> <p data-bbox="583 1377 730 1409">Dua, ¶ 230.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
<p>15. The television set according to claim 6, wherein the second information includes a channel identification of broadcast program for indication on a display of the another television set to visually inform the another television set of channel selection in the television function.</p>	<p>Cooper expressly or inherently discloses “[t]he television set according to claim 6, wherein the second information includes a channel identification of broadcast program for indication on a display of the another television set to visually inform the another television set of channel selection in the television function.” For example:</p> <p>See limitation 1.g (the second information).</p> <p>See claim 6 (other television sets).</p> <div data-bbox="630 539 1520 1192" data-label="Diagram"> <p>FIG. 12A</p> </div> <p>Cooper, Fig. 12A.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art																				
	<div data-bbox="632 212 1509 889" data-label="Diagram"> <p>FIG. 12B</p> <table border="1" data-bbox="661 305 1192 613"> <thead> <tr> <th colspan="2">Server Data</th> </tr> </thead> <tbody> <tr> <td>User</td><td>Channel</td> </tr> <tr> <td>Al</td><td>CNN</td> </tr> <tr> <td>Brenda</td><td>DISNEY</td> </tr> <tr> <td>Rob</td><td>ABC</td> </tr> <tr> <td>Suzi</td><td>CBS</td> </tr> <tr> <td>Jim</td><td>Offline</td> </tr> </tbody> </table> <table border="1" data-bbox="945 370 1161 586"> <thead> <tr> <th>Al's</th><th>Buddies</th> </tr> </thead> <tbody> <tr> <td></td><td>Rob</td> </tr> <tr> <td></td><td>Jim</td> </tr> </tbody> </table> </div> <p>Cooper, Fig. 12B (second information with channel identification), ¶¶ 60-61 (describing buddy list and Figs. 12A-B).</p> <p>“FIGS. 12A and 12B shows server data 1204 used to provide the enhanced buddy list functions. The data 1204 includes a list 1206 of logged-in users and the TV show and/or network that each user is currently watching. The server also stores a buddy list 1208 for each user. The buddy list 1208 may be permanently stored on the server 1204 or transmitted to the server 1204 by a set-top box when a user logs-on. As shown in FIG. 12A, when a user changes channels, set-top box software transmits a message to the server including the name of the show and/or the network the user is presently viewing. As shown in FIG. 12B, the server 1204 updates the user list 1206 to reflect the new viewing information. The server also transmits a message 1212 to each logged-in user that included the channel-changing user in his or her list.”</p> <p>Cooper, ¶ 61, Figs. 12A-B.</p>	Server Data		User	Channel	Al	CNN	Brenda	DISNEY	Rob	ABC	Suzi	CBS	Jim	Offline	Al's	Buddies		Rob		Jim
Server Data																					
User	Channel																				
Al	CNN																				
Brenda	DISNEY																				
Rob	ABC																				
Suzi	CBS																				
Jim	Offline																				
Al's	Buddies																				
	Rob																				
	Jim																				

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <pre> graph TD 1402[1402 User Changes Channel] --> 1404[1404 User's Client Transmits "Channel Changed" Message to Server] 1404 --> 1406[1406 Server Determines Which Buddy Lists Include the User] 1406 --> 1408{1408 Has User Turned on Privacy?} 1408 -- No --> 1410[1410 Transmit Change in Channel Information to Users Having Buddy Lists that Include the User who Changed Channels] </pre> <p>FIG. 14</p> <p>Cooper, Fig. 14, ¶ 63 (describing Fig. 14).</p> <p>“[T]he server broadcasts 1410 the change to each logged-in user who included the channel changing user in their buddy list.”</p> <p>Cooper, ¶ 63, Fig. 14.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<div data-bbox="632 212 1339 781" data-label="Diagram"> <pre> graph TD 1008[1008 User Changes Channel] --> 1010[1010 Client Determines TV Channel or Show Name Corresponding to Displayed TV Channel] 1010 --> 1012[1012 Message Sent to Server Change to Chat Room Corresponding to the TV Channel or Show Name] </pre> <p style="text-align: center;">FIG. 10</p> </div> <p data-bbox="583 805 1953 873">Cooper, Fig. 10 (example generation of second information in predetermined format), ¶ 58 (describing Fig. 10).</p> <p data-bbox="627 914 1948 982">“As described, each time the user changes channels 1008, the set-top box can transmit a message to the server 1010, 1012 indicating the new channel the viewer is watching.”</p> <p data-bbox="583 1003 863 1036">Cooper, ¶ 58, Fig. 10.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<div data-bbox="632 212 1402 732"> <p style="text-align: center;">FIG. 11</p> </div> <p>Cooper, Fig. 11 (visually inform other television set of channel selection).</p> <p><i>See also</i> the contentions for this limitation from the '236 patent IPR, incorporated here by reference.</p> <p>To the extent Cooper does not disclose any part of this limitation, Cooper renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Cooper combined with the knowledge of a person of ordinary skill in the art, and in light of Cooper combined with any of the other prior art references identified in the contentions for this patent, including Wick. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>

Exhibit 236.B
Invalidity of U.S. Patent No. 8,094,236 in view of Wick¹

U.S. Patent No 7,669,213 (“Wick”) is prior art to U.S. Patent No. 8,094,236 under at least 35 U.S.C. §§ 102(e) (pre-AIA). Wick was filed on October 28, 2004.

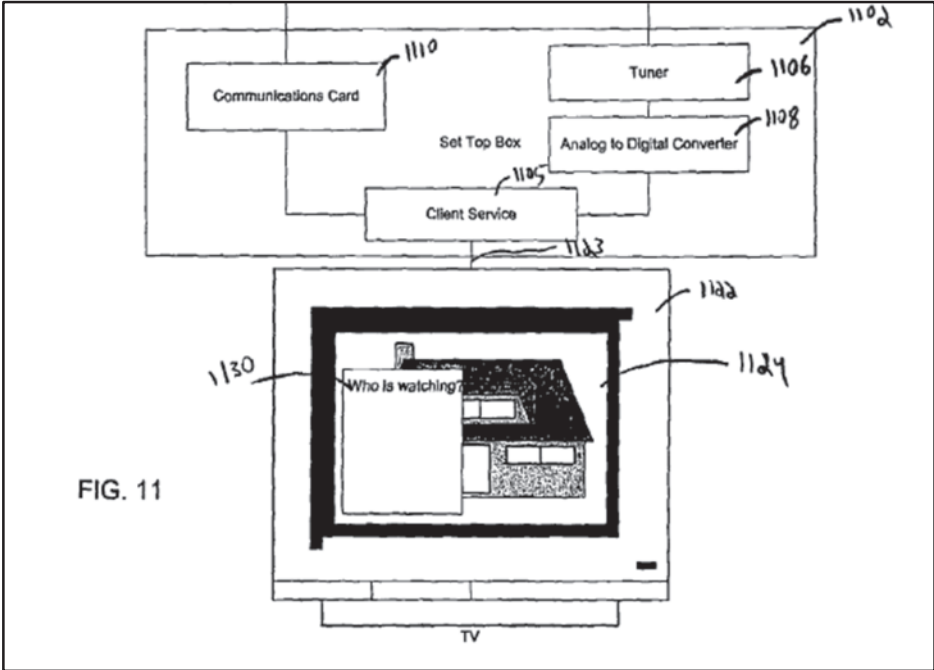
Amazon incorporates here by reference all bases of invalidity of the ’236 patent based on Wick (alone or in combination) set forth in the *inter partes* review of that patent.

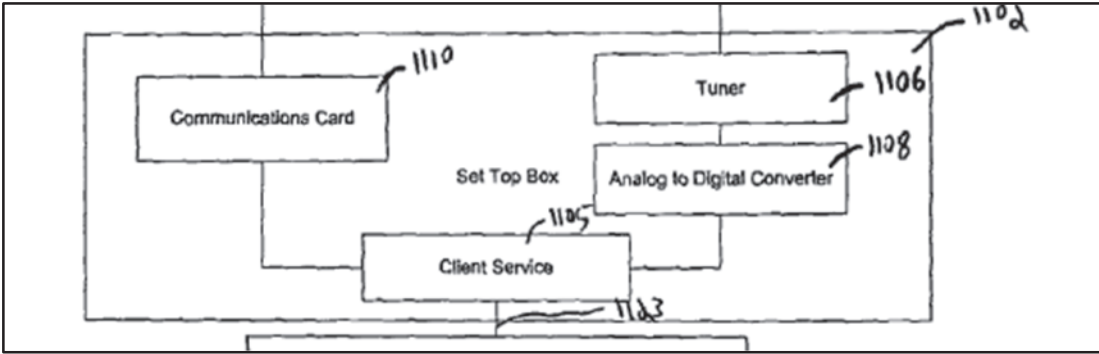
Wick’s disclosure includes the entirety of U.S. Patent Application Serial No. 09/475,391 (“Silva”), the entirety of which Wick incorporates by reference at 20:25-29.

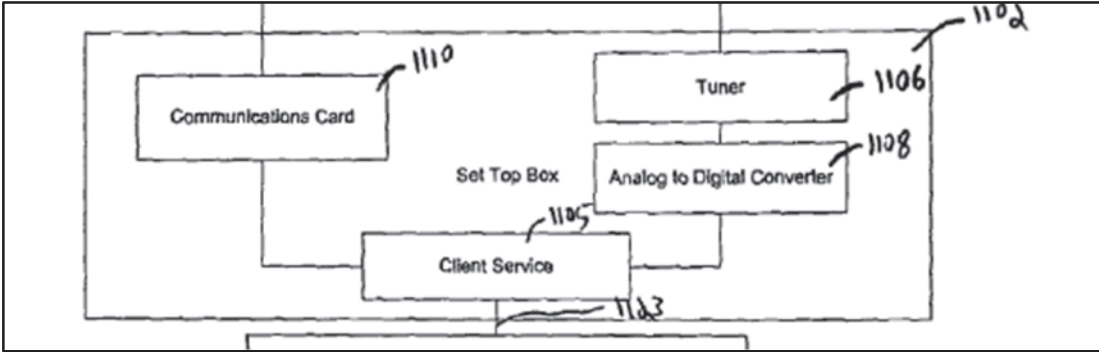
Amazon’s invalidity contentions are based in part on Giken’s infringement contentions, to the extent Amazon can understand them, because that which infringes, if later, anticipates, if earlier. Amazon offers these contentions without prejudice to any position it may later take as to any claim construction issue. To the extent these contentions reflect claim interpretations implicit in Giken’s infringement contentions, no inference is intended, nor should any be drawn, that Amazon agrees with any claim interpretation implied by Giken’s infringement contentions, and Amazon reserves the right to contest such claim interpretations. Where Amazon cites to a particular figure, the citation encompasses the description of that figure; similarly, where Amazon cites to text describing a figure, the citation encompasses that figure as well.

Claim Limitation	Exemplary Disclosure in the Prior Art
[1.pre] A television set comprising:	To the extent the preamble is limiting, Wick expressly or inherently discloses “[a] television set.” For example:

¹ This chart also applies to Wick combined with the knowledge of a POSITA, and combined with the other references cited in this chart.

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>FIG. 11</p> <p>Wick, Fig. 11 (example television set), ¶¶ 18:28-19:34 (describing Fig. 11).</p> <p>“[S]ome or all of the functionality of the set-top box 1102 may be performed by the television ... 1122.” Wick, 21:16-19.</p> <p><i>See also</i> the contentions for this preamble from the '236 patent IPR, incorporated here by reference.</p> <p>To the extent Wick does not disclose any part of this limitation, Wick renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Wick combined with the knowledge of a person of ordinary skill in the art, and in light of Wick combined with any of the other prior art references identified in the contentions for this patent, including Cooper. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
<p>[1.a] a television function unit provided inside the television set and arranged to relate to a television function;</p>	<p>Wick expressly or inherently discloses “a television function unit provided inside the television set and arranged to relate to a television function.” For example:</p>  <p>Wick, Fig. 11 (example television function unit), ¶¶ 18:28-19:34 (describing Fig. 11).</p> <p>“[S]ome or all of the functionality of the set-top box 1102 may be performed by the television ... 1122.” Wick, 21:16-19.</p> <p>“The system 1100 includes a set-top box 1102 that receives television signals from a television source 1104. The set-top box 1102 includes a tuner 1106 used to select a television channel for viewing. The selected television channel may be received as an unencoded or encoded digital or analog signal. For example, satellite television channels are typically received as a digital signal while most cable television channels are received as analog signals. The analog signals may be scrambled, and the digital signals may be encrypted and/or compressed (e.g., using MPEG-2 format). The set-top box 1102 includes an analog-to-digital converter 1108 (A/D converter) that permits digital processing of the television images regardless of the television source 1104. The A/D converter 1108 may also be configured to decode and uncompress a scrambled or encrypted signal.”</p> <p>Wick, 18:31-45.</p>

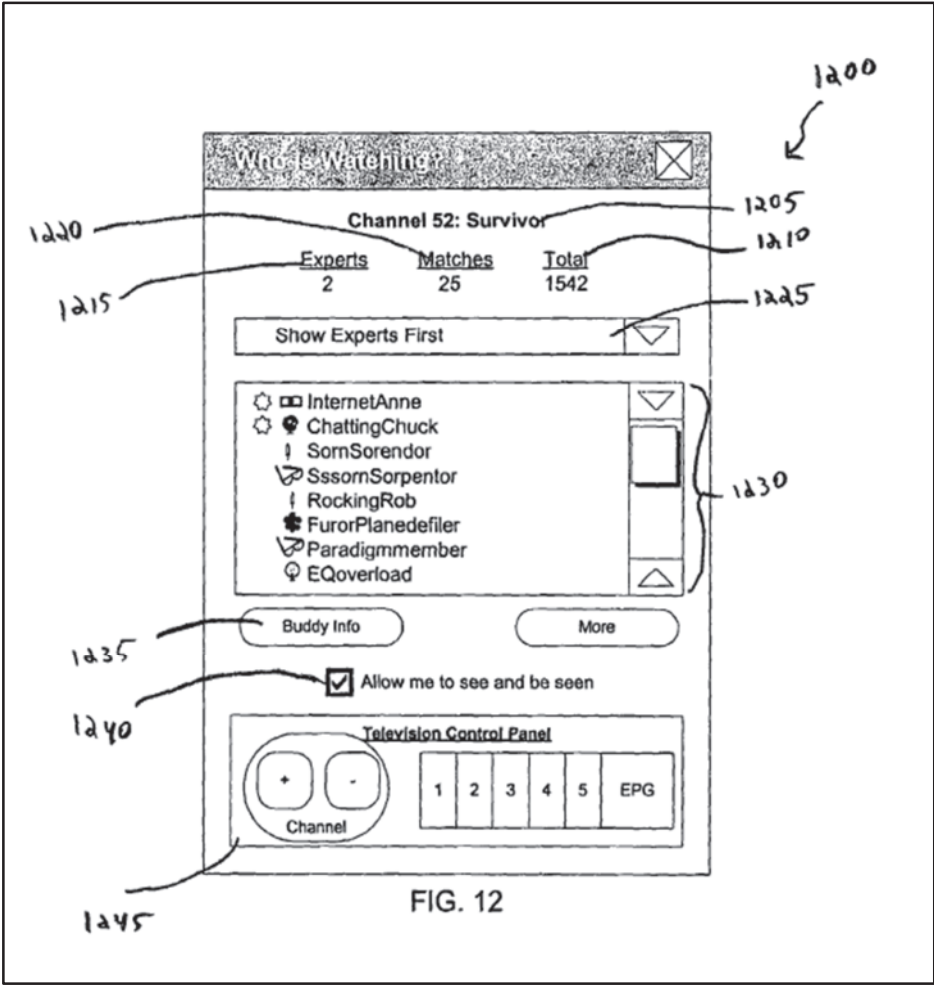
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>“The set-top box 1102 also includes a client service 1105 for communicating with the user identification system 1120 (the channel between the client service 1105 and the user identification system 1120 is not shown) and constructing a display on a television or monitor 1122.”</p> <p>Wick, 18:54-58.</p> <p><i>See also</i> the contentions for this limitation from the '236 patent IPR, incorporated here by reference.</p> <p>To the extent Wick does not disclose any part of this limitation, Wick renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Wick combined with the knowledge of a person of ordinary skill in the art, and in light of Wick combined with any of the other prior art references identified in the contentions for this patent, including Cooper. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>[1.b] a detector provided inside the television set and arranged to detect a cause of change in the television function;</p>	<p>Wick expressly or inherently discloses “a detector provided inside the television set and arranged to detect a cause of change in the television function.” For example:</p>  <p>Wick, Fig. 11 (example detector), 18:28-19:34 (describing Fig. 11).</p> <p>“The set-top box 1102 also includes a client service 1105 for communicating with the user identification system 1120 (the channel between the client service 1105 and the user identification system 1120 is not</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>shown) and constructing a display on a television or monitor 1122. The client service 1105 may be, for example, a browser client software configured to communicate with the network server 1112 by sending HTTP (HyperText Transfer Protocol) messages.”</p> <p>Wick, 18:54-61.</p> <p>“The client service 1105 is also configured to send channel selection data to the user identification system 1120 via the network server 1112.”</p> <p>Wick, 19:12-15.</p> <p>“The window 1200 indicates a program (or channel or television network) 1205 to which the television or monitor 1122 is current tuned (e.g., ‘Channel 52: Survivor’).”</p> <p>Wick, 19:42-44.</p> <p>“The WhoisWatching window 1200 also may include a television control panel 1245 that enables the user to select a program, channel, or television network to view. The television control panel 1245 may include buttons 1250 that may be selected to progress sequentially to the next or previous channel, program, or television network. The television control panel 1245 also may include one or more buttons 1255 that may be selected to automatically tune into a predetermined program, channel, or television network.”</p> <p>Wick, 20:10-18.</p> <p>“When the viewer selects one of the buttons 1250 or 1255, or otherwise interacts with the television 1122 and/or set-top box 1102 in a manner that changes the channel, program, or television network, the client service 1105 is configured to send a TV select signal to the dynamic user identification system 1120.”</p> <p>Wick, 20:35-40.</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Wick does not disclose any part of this limitation, Wick renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Wick combined with the knowledge of a person of ordinary skill in the art, and in light of Wick combined with any of the other prior art references identified in the contentions for this patent, including Cooper. The manner in</p>

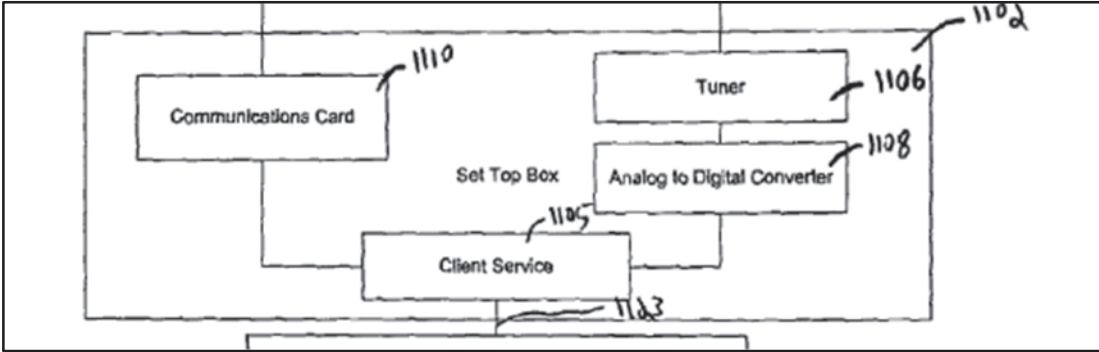
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p> <p>Moreover, it also would have been obvious to a person of ordinary skill in the art to combine Wick with the following prior art:</p> <div data-bbox="632 469 1715 946" data-label="Image"> </div> <p>TiVo Series2 Model No. TCD540080 (<i>see</i> Exhibit 968.F) (example detector).</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p data-bbox="583 792 1329 829">TiVo Series2 Model No. TCD540080 (<i>see</i> Exhibit 968.F).</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>TiVo Series2 Model No. TCD540080 (<i>see</i> Exhibit 968.F).</p> <p>TiVo Series2 Viewer's Guide 2003 (<i>see</i> Exhibit 968.F), pp. 6-8, 13-17, 19, 21, 25, 30-34, 37-38, 44-46 48, 50, 53, 56, 58, 62, 64, 76, 78-80, 82, 85, 88, 91, (using "SELECT" button, for example).</p> <p>TiVo Series2 Viewer's Guide 2003 (<i>see</i> Exhibit 968.F), "Remote Control Tips."</p>
[1.c] a communicator provided inside the television set and arranged to selectively communicate with one of a	<p>Wick expressly or inherently discloses "a communicator provided inside the television set and arranged to selectively communicate with one of a plurality of outside counterparts by means of designating an address of one of the outside counterparts, the plurality of outside counterparts including a first type of counterpart under free selection and a second type of counterpart which is predetermined." For example:</p>

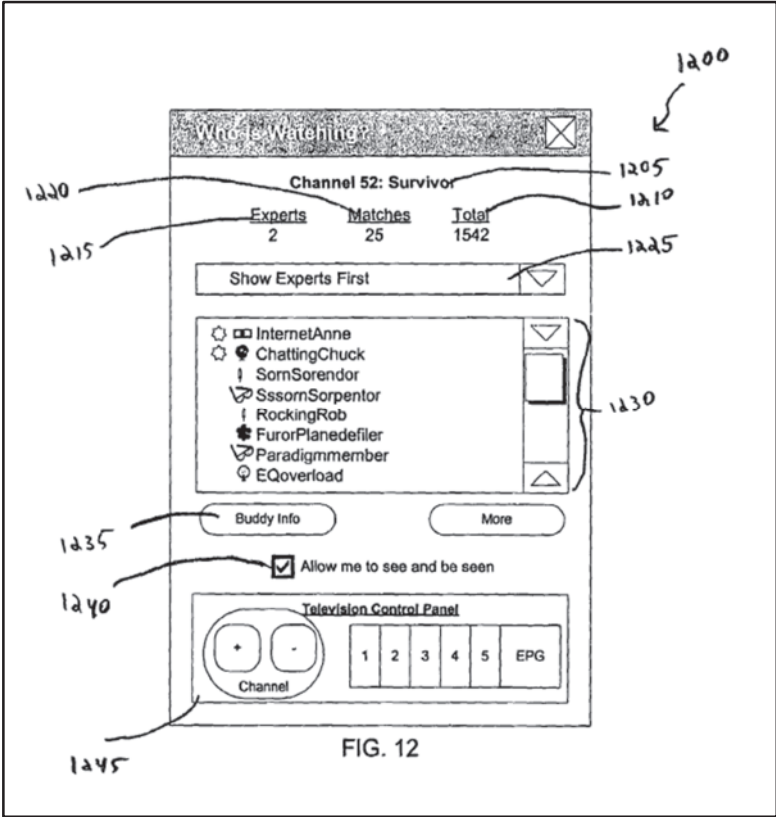
Claim Limitation	Exemplary Disclosure in the Prior Art
<p>plurality of outside counterparts by means of designating an address of one of the outside counterparts, the plurality of outside counterparts including a first type of counterpart under free selection and a second type of counterpart which is predetermined;</p>	 <p>FIG. 12</p> <p>Wick, Fig. 12 (example first type of counterpart), 19:35-20:46 (describing Fig. 12). <i>See also</i> Wick, Fig. 3 (“Other Individuals”).</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>“The client service 305 also may include a Web browser, an email client, a synchronization client (e.g., a calendar synchronization client, or a task list synchronization client), an instant messaging (IM) client ...” Wick, 7:18-21.</p> <p>“The WhoIsHere window 600 may enable the user 105 to open an IM or email to an other individual who is displayed by clicking on the displayed identifier of that other individual. For example, the user 105 may initiate an IM to SurfingSally by clicking on that individuals online identifier.” Wick, 16:13-15.</p> <p>“The WhoIsWatching window 1200 may enable the viewer to open an IM or email that may be sent to another viewer by, for example, selecting the displayed identifier of that other viewer.” Wick, 19:66-20:2.</p> <p>“The user interface may be manipulated by the viewer to invoke an instant message or send an e-mail to at least one other viewer in the subset of other viewers.” Wick, 2:62-64.</p> <div data-bbox="632 899 1663 1282"> <p>The diagram shows a central cloud labeled 'Network' with the reference numeral 1117. To the left of the network is a rectangular box labeled 'Server' with reference numeral 1112. To the right of the network is another rectangular box labeled 'TV Source' with reference numeral 1104. Above the network is a rectangular box labeled 'Dynamic User Identification System' with reference numeral 1120. Lines connect the Server to the Network, the Network to the TV Source, and the Dynamic User Identification System to the Network. A large reference numeral 1100 is positioned to the right of the TV Source, with a bracket indicating it encompasses the TV Source and the Dynamic User Identification System.</p> </div> <p>Wick, Fig. 11 (example second type of counterpart), 18:28-19:34 (describing Fig. 11). <i>See also</i> Wick, Fig. 3 (“Dynamic User Identification System” 320).</p>

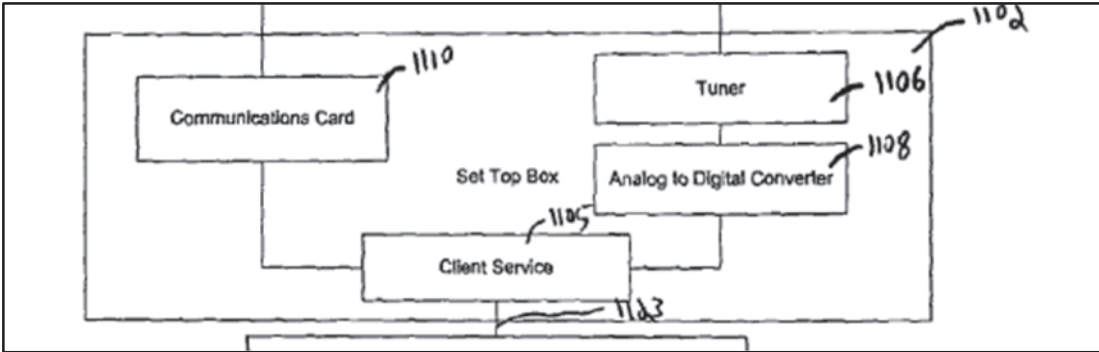
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>“The set-top box 1102 also includes a client service 1105 for communicating with the user identification system 1120”</p> <p>Wick, 18:54-55.</p> <p>“The client service 1105 is also configured to send channel selection data to the user identification system 1120 via the network server 1112.”</p> <p>Wick, 19:12-15.</p> <p>“When the viewer selects one of the buttons 1250 or 1255, or otherwise interacts with the television 1122 and/or set-top box 1102 in a manner that changes the channel, program, or television network, the client service 1105 is configured to send a TV select signal to the dynamic user identification system 1120.”</p> <p>Wick, 20:35-40.</p>  <p>Wick, Fig. 11 (example communicator), 18:28-19:34 (describing Fig. 11); <i>see also</i> Wick, Fig. 3 (client service 305).</p> <p>“[T]he client service 1105, the network 1117 and the dynamic user identification system 1120 typically have attributes comparable to and may illustrate one possible implementation of the client service 305, the large scale network 317, and the dynamic user identification systems 120, 320, 420, and 520, respectively.”</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Wick, 18:66-19:2.</p> <p>“For example, the client service 305 may include a device such as a notebook computer, a telephone, a pen-enabled computer, a personal digital assistant (PDA) or mobile telephone, and/or a desktop computer.”</p> <p>Wick, 7:14-18.</p> <p>“[T]he large scale network 317 also may allow direct or indirect communication between the client service 305 [and] the other individuals 110.”</p> <p>Wick, 7:47-49.</p> <p>“The client service 1105 is also configured to send channel selection data to the user identification system 1120 via the network server 1112.”</p> <p>Wick, 19:12-15.</p> <p>“The set-top box 1102 includes a network communication card 1110 configured to enable the set-top box to communicate with a network server 1112. The network server 1112 is configured to provide the set-top box 1102 with access to a network 1117.”</p> <p>Wick, 18:46-50.</p> <p>“The WhoIsWatching window 1200 may enable the viewer to open an IM or e-mail to an other viewer by, for example, selecting the displayed identifier of that other viewer.”</p> <p>Wick, 19:66-20:2.</p> <p>“Additional information, such as, for example, trait and/or contact information of the other individual is accessed from an additional information source (e.g., a user profile database) based on the identification information (step 720). The additional information may include, for example, client addressing information, email information, interest information, age or other demographic information, and/or a WholsHere preference such as a participation status.”</p> <p>Wick, 16:38-45.</p>

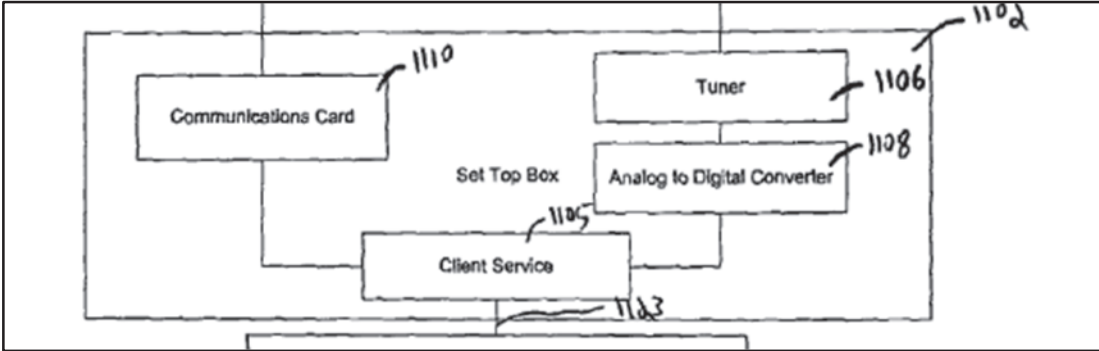
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p data-bbox="627 250 1955 321">“The viewer also may select the displayed identifier and then select the Buddy Info button 1235 to view buddy information of the other viewer corresponding to the displayed identifier.”</p> <p data-bbox="583 339 762 370">Wick, 20:2-5.</p> <p data-bbox="583 412 1860 443"><i>See also</i> the contentions for this limitation from the '236 patent IPR, incorporated here by reference.</p> <p data-bbox="583 487 1976 735">To the extent Wick does not disclose any part of this limitation, Wick renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Wick combined with the knowledge of a person of ordinary skill in the art, and in light of Wick combined with any of the other prior art references identified in the contentions for this patent, including Cooper. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
[1.d] an input provided inside the television set and arranged to newly and freely prepare first information;	Wick expressly or inherently discloses “an input provided inside the television set and arranged to newly and freely prepare first information.” For example:

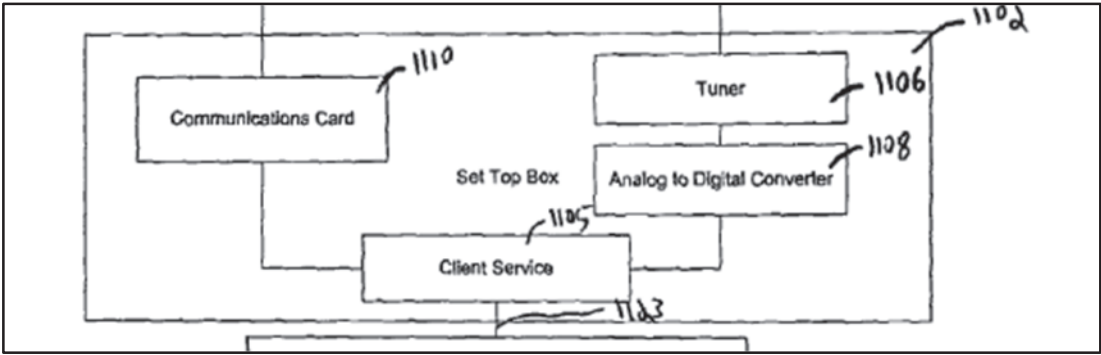
Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>FIG. 12</p> <p>Wick, Fig. 12, 19:35-20:46 (describing Fig. 12).</p> <p>“The WhoIsWatching window 1200 may enable the viewer to open an IM or e-mail that may be sent to an other viewer by, for example, selecting the displayed identifier of that other viewer.”</p> <p>Wick, 19:66-20:2 (example input).</p> <p>“[T]he dynamic user identification system 320 may enable the user 105 to interact online with one or more of the other individuals 110 within the online context 315, for example, ... by using instant messaging or email.”</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Wick, 9:5-9 (example input).</p> <p>“The client service 305 also may include a Web browser, an email client,”</p> <p>Wick, 7:18-19.</p> <p>“[S]ome or all of the functionality of the set-top box 1102 may be performed by the television or monitor 1122.”</p> <p>Wick, 21:17-19.</p> <p>“[T]he client service 1105, the network 1117 and the dynamic user identification system 1120 typically have attributes comparable to and may illustrate one possible implementation of the client service 305, the large scale network 317, and the dynamic user identification systems 120, 320, 420, and 520, respectively.”</p> <p>Wick, 18:66-19:2.</p> <p><i>See also</i> Wick, 16:13-15 (“The WholsHere window 600 may enable the user 105 to open an IM or email to another individual who is displayed by clicking on the displayed identifier of that other individual.”), Fig. 6, 9:25-29 (any form of “electronic messaging”).</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Wick does not disclose any part of this limitation, Wick renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Wick combined with the knowledge of a person of ordinary skill in the art, and in light of Wick combined with any of the other prior art references identified in the contentions for this patent, including Cooper. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
[1.e] a first designator provided inside the television set and arranged to freely designate a	<p>Wick expressly or inherently discloses “a first designator provided inside the television set and arranged to freely designate a desired address of the first type of outside counterpart to which the first information is sent.” For example:</p>

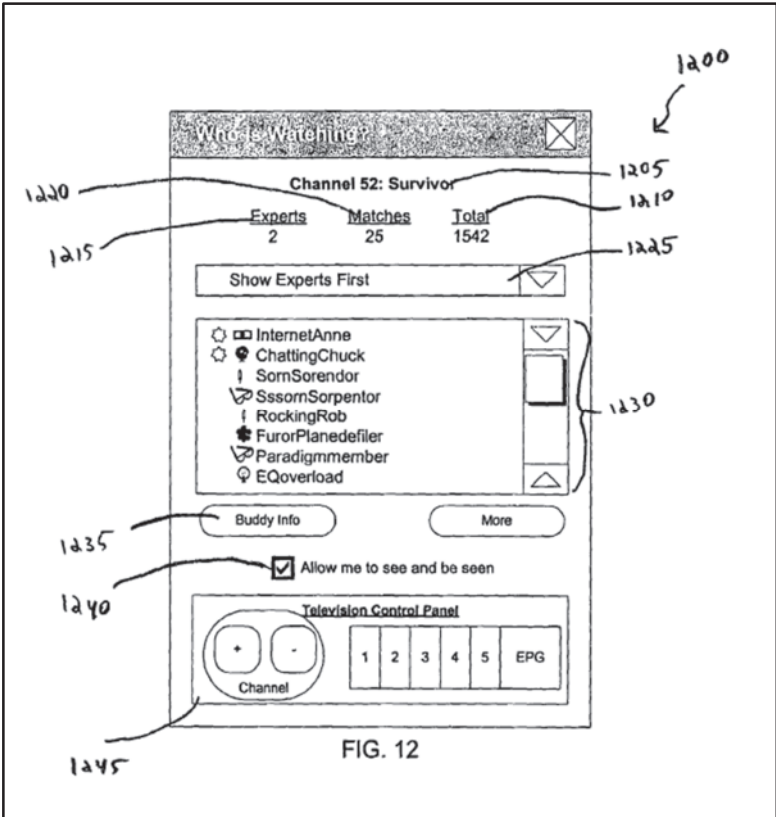
Claim Limitation	Exemplary Disclosure in the Prior Art
<p>desired address of the first type of outside counterpart to which the first information is sent;</p>	<p>See limitation 1.d (preparing first information).</p>  <p>Wick, Fig. 11 (example first designator), 18:28-19:34 (describing Fig. 11); <i>see also</i> Wick, Fig. 3 (client service 305).</p> <p>“[T]he client service 1105, the network 1117 and the dynamic user identification system 1120 typically have attributes comparable to and may illustrate one possible implementation of the client service 305, the large scale network 317, and the dynamic user identification systems 120, 320, 420, and 520, respectively.”</p> <p>Wick, 18:66-19:2.</p> <p>“The client service 305 also may include a Web browser, an email client,”</p> <p>Wick, 7:18-19.</p> <p>“The WhoIsWatching window 1200 may enable the viewer to open an IM or e-mail that may be sent to an other viewer by, for example, selecting the displayed identifier of that other viewer.”</p> <p>Wick, 19:66-20:2.</p> <p>“Additional information, such as, for example, trait and/or contact information of the other individual is accessed from an additional information source (e.g., a user profile database) based on the identification</p>

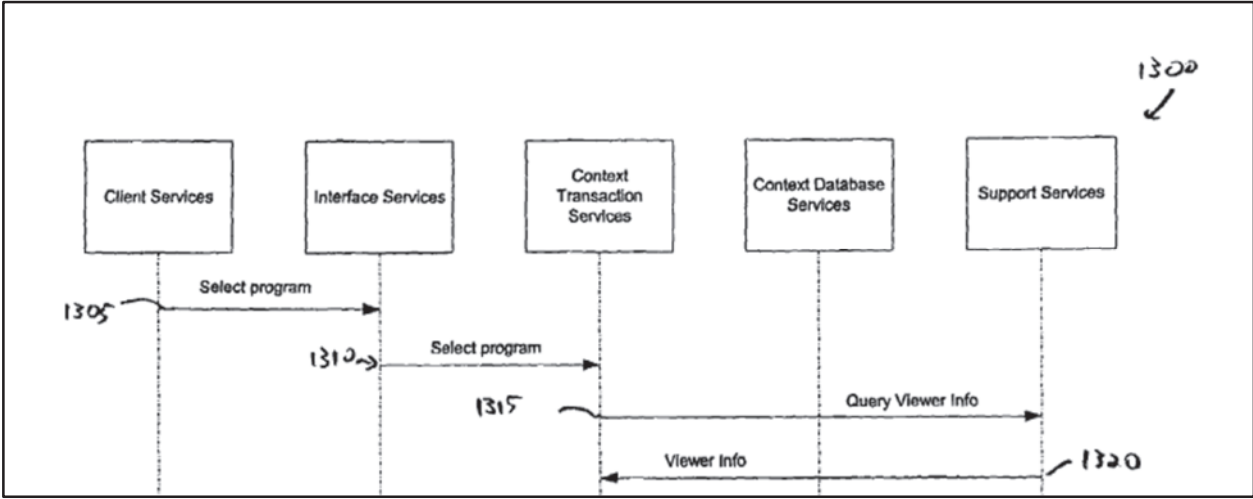
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>information (step 720). The additional information may include, for example, client addressing information, email information,”</p> <p>Wick, 16:38-45.</p> <p>“[S]ome or all of the functionality of the set-top box 1102 may be performed by the television or monitor 1122.”</p> <p>Wick, 21:17-19.</p> <p><i>See also</i> Wick, 9:5-9 (emailing other user), 8:39-42 (“the dynamic user identification system 320 also may be configured to show online identifiers (e.g., screen names) of other individuals 110 within the context 315”).</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Wick does not disclose any part of this limitation, Wick renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Wick combined with the knowledge of a person of ordinary skill in the art, and in light of Wick combined with any of the other prior art references identified in the contentions for this patent, including Cooper. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>[1.f] a first trigger provided inside the television set and arranged to send the first information to the first type of counterpart through the communicator when the first trigger is manually operated;</p>	<p>Wick expressly or inherently discloses “a first trigger provided inside the television set and arranged to send the first information to the first type of counterpart through the communicator when the first trigger is manually operated.” For example:</p> <p><i>See</i> limitation 1.c (the communicator).</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>Wick, Fig. 11 (example first trigger), 18:28-19:34 (describing Fig. 11); <i>see also</i> Wick, Fig. 3 (client service 305).</p> <p>“[T]he client service 1105, the network 1117 and the dynamic user identification system 1120 typically have attributes comparable to and may illustrate one possible implementation of the client service 305, the large scale network 317, and the dynamic user identification systems 120, 320, 420, and 520, respectively.”</p> <p>Wick, 18:66-19:2.</p> <p>“The client service 305 also may include a Web browser, an email client,”</p> <p>Wick, 7:18-19.</p> <p>“The WhoIsWatching window 1200 may enable the viewer to open an IM or e-mail that may be sent to an other viewer by, for example, selecting the displayed identifier of that other viewer.”</p> <p>Wick, 19:66-20:2.</p> <p>“[S]ome or all of the functionality of the set-top box 1102 may be performed by the television or monitor 1122.”</p> <p>Wick, 21:17-19.</p> <p><i>See also</i> Wick, 9:5-9 (emailing other user),</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>“The set-top box 1102 includes a network communication card 1110 configured to enable the set-top box to communicate with a network server 1112. The network server 1112 is configured to provide the set-top box 1102 with access to a network 1117.”</p> <p>Wick, 18:46-50 (email sent through the communicator).</p> <p><i>See also</i> the contentions for this limitation from the '236 patent IPR, incorporated here by reference.</p> <p>To the extent Wick does not disclose any part of this limitation, Wick renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Wick combined with the knowledge of a person of ordinary skill in the art, and in light of Wick combined with any of the other prior art references identified in the contentions for this patent, including Cooper. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>[1.g] an automatic generator provided inside the television set and arranged to generate predetermined second information in response to the detector which detects a cause of a predetermined change in the television function;</p>	<p>Wick expressly or inherently discloses “an automatic generator provided inside the television set and arranged to generate predetermined second information in response to the detector which detects a cause of a predetermined change in the television function.” For example:</p>  <pre> graph TD subgraph 1102 [Set Top Box] 1110[Communications Card] 1106[Tuner] 1108[Analog to Digital Converter] 1105[Client Service] 1105 --- 1106 1105 --- 1108 end 1110 --- 1117[Network 1117] 1105 --- 1117 1106 --- 1117 1108 --- 1117 </pre>

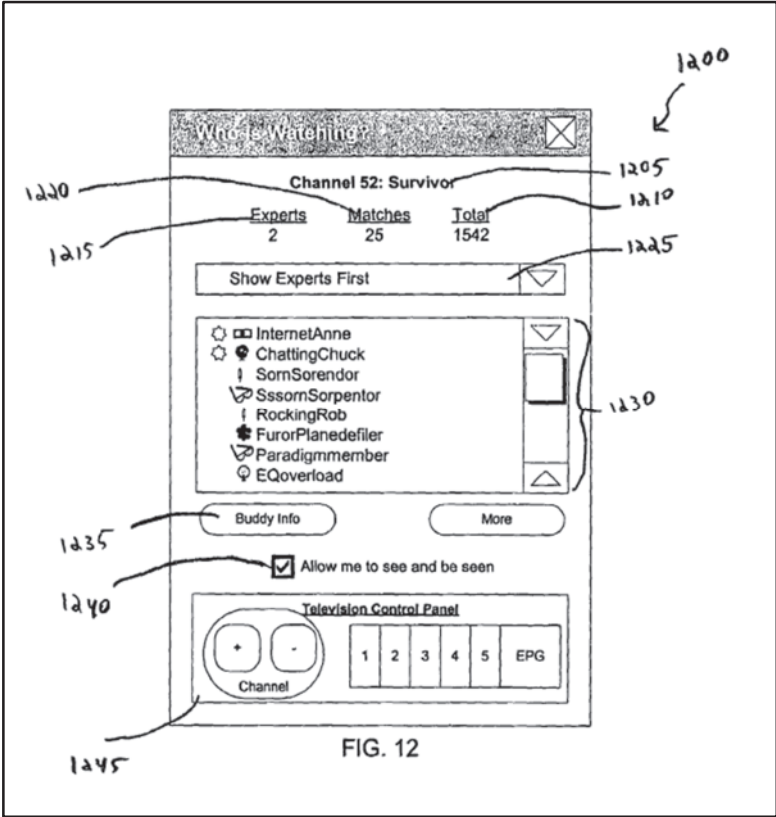
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Wick, Fig. 11 (example automatic generator), 18:28-19:34 (describing Fig. 11); <i>see also</i> Wick, Fig. 3 (client service 305).</p> <p>“[S]ome or all of the functionality of the set-top box 1102 may be performed by the television or monitor 1122.”</p> <p>Wick, 21:17-19.</p> <p>“[T]he client service 1105, the network 1117 and the dynamic user identification system 1120 typically have attributes comparable to and may illustrate one possible implementation of the client service 305, the large scale network 317, and the dynamic user identification systems 120, 320, 420, and 520, respectively.”</p> <p>Wick, 18:66-19:2.</p> <p>“The WholsWatching window 1200 also may include a television control panel 1245 that enables the user to select a program, channel, or television network to view. The television control panel 1245 may include buttons 1250 that may be selected to progress sequentially to the next or previous channel, program, or television network. The television control panel 1245 also may include one or more buttons 1255 that may be selected to automatically tune into a predetermined program, channel, or television network.”</p> <p>Wick, 20:10-18.</p> <p>“The viewer may select the buttons 1250, 1255, and 1260 which represent links that may be processed to change the channel of the set-top box 1102.”</p> <p>Wick, 20:29-31.</p> <p>“The set-top box 1102 also includes a client service 1105 for communicating with the user identification system 1120.”</p> <p>Wick, 18:54-55.</p> <p>“The client service 1105 is also configured to send channel selection data to the user identification system 1120 via the network server 1112.”</p>

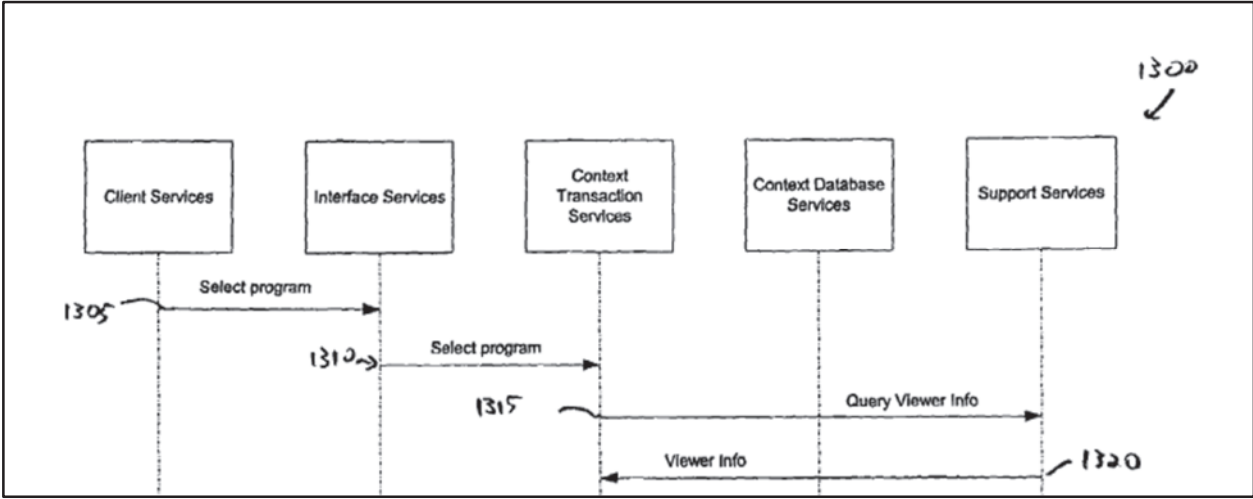
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Wick, 19:12-15.</p> <p>“When the viewer selects one of the buttons 1250 or 1255, or otherwise interacts with the television 1122 and/or set-top box 1102 in a manner that changes the channel, program, or television network, the client service 1105 is configured to send a TV select signal to the dynamic user identification system 1120.”</p> <p>Wick, 20:35-40.</p>  <p>FIG. 12</p> <p>Wick, Fig. 12, 19:35-20:46 (describing Fig. 12).</p>

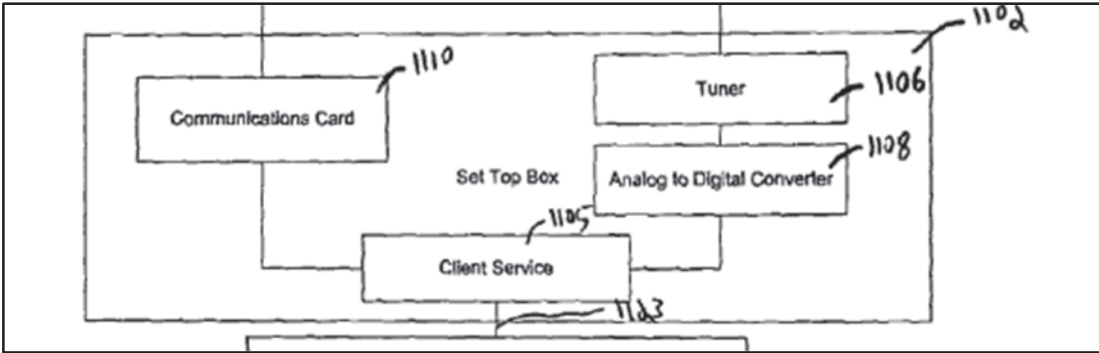
Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>Wick, Fig. 13 (example automatic generator).</p> <p>“FIG. 13 illustrates a process 1300 that may be used to implement the system of FIG. 11 when the viewer tunes to a specific channel, program, or television network. Upon tuning to a particular channel, program, or television network, the client services 1105 sends a ‘select program’ message to the interface services (step 1305). The interface services communicates the ‘select program’ message to the context transaction services (step 1310).”</p> <p>Wick, 20:47-54.</p> <p>“An online service provider may display dynamically and in real time information of other users presently viewing the television program (or channel) as being viewed by the user. For instance, the user may perceive when buddy list members view a television program concurrently with the user,”</p> <p>Wick, 4:37-42.</p> <p>See also Wick, Fig. 6 (displaying other users viewing the program), 4:50-61 (displaying other users viewing the program).</p> <p>See also the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>To the extent Wick does not disclose any part of this limitation, Wick renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Wick combined with the knowledge of a person of ordinary skill in the art, and in light of Wick combined with any of the other prior art references identified in the contentions for this patent, including Cooper. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>[1.h] a second designator provided inside the television set and arranged to automatically designate a predetermined address of the second type of outside counterpart to which the second information is sent; and</p>	<p>Wick expressly or inherently discloses “a second designator provided inside the television set and arranged to automatically designate a predetermined address of the second type of outside counterpart to which the second information is sent.” For example:</p> <p>See limitation 1.g (the second information).</p> <p>Wick, Fig. 11 (example second designator), 18:28-19:34 (describing Fig. 11); <i>see also</i> Wick, Fig. 3 (client service 305).</p> <p>“[S]ome or all of the functionality of the set-top box 1102 may be performed by the television or monitor 1122.”</p> <p>Wick, 21:17-19.</p>

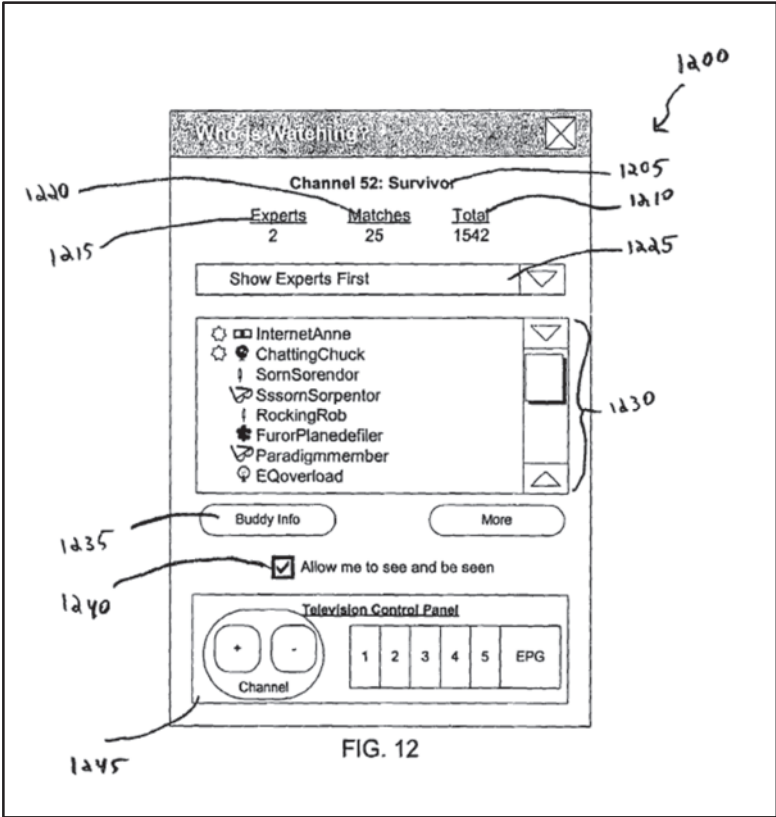
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>“[T]he client service 1105, the network 1117 and the dynamic user identification system 1120 typically have attributes comparable to and may illustrate one possible implementation of the client service 305, the large scale network 317, and the dynamic user identification systems 120, 320, 420, and 520, respectively.”</p> <p>Wick, 18:66-19:2.</p> <p>“The WholsWatching window 1200 also may include a television control panel 1245 that enables the user to select a program, channel, or television network to view. The television control panel 1245 may include buttons 1250 that may be selected to progress sequentially to the next or previous channel, program, or television network. The television control panel 1245 also may include one or more buttons 1255 that may be selected to automatically tune into a predetermined program, channel, or television network.”</p> <p>Wick, 20:10-18.</p> <p>“The viewer may select the buttons 1250, 1255, and 1260 which represent links that may be processed to change the channel of the set-top box 1102.”</p> <p>Wick, 20:29-31.</p> <p>“The set-top box 1102 also includes a client service 1105 for communicating with the user identification system 1120.”</p> <p>Wick, 18:54-55.</p> <p>“The client service 1105 is also configured to send channel selection data to the user identification system 1120 via the network server 1112.”</p> <p>Wick, 19:12-15.</p> <p>“When the viewer selects one of the buttons 1250 or 1255, or otherwise interacts with the television 1122 and/or set-top box 1102 in a manner that changes the channel, program, or television network, the client service 1105 is configured to send a TV select signal to the dynamic user identification system 1120.”</p> <p>Wick, 20:35-40.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>FIG. 12</p> <p>Wick, Fig. 12, 19:35-20:46 (describing Fig. 12).</p>

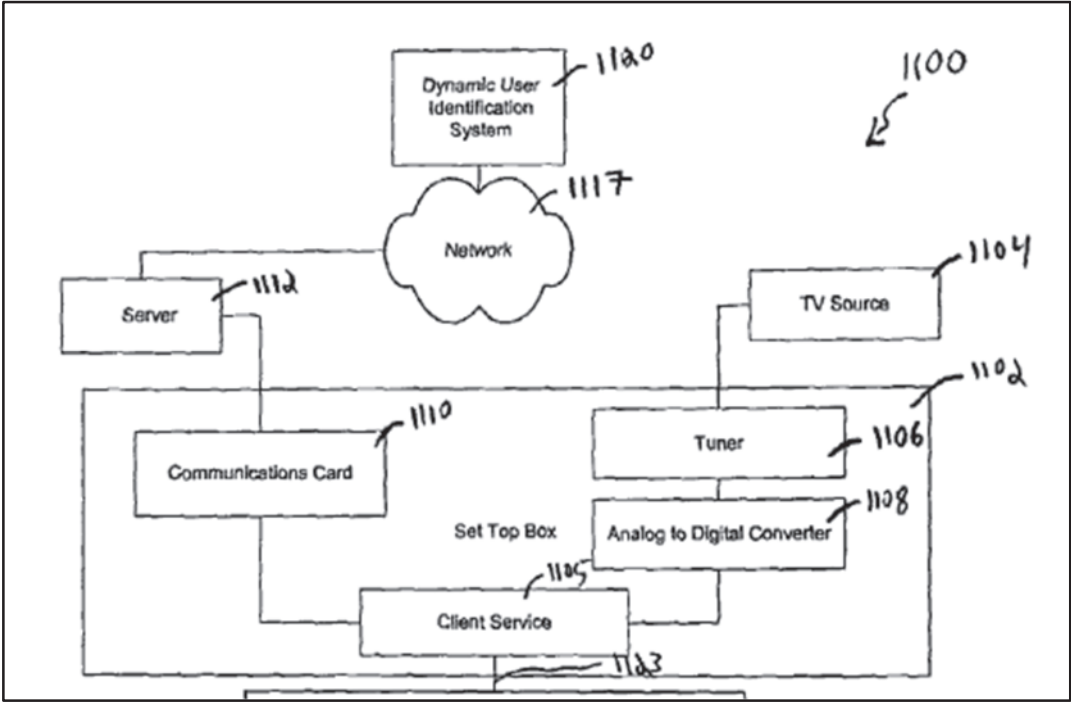
Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>Wick, Fig. 13 (example second designator).</p> <p>“FIG. 13 illustrates a process 1300 that may be used to implement the system of FIG. 11 when the viewer tunes to a specific channel, program, or television network. Upon tuning to a particular channel, program, or television network, the client services 1105 sends a ‘select program’ message to the interface services (step 1305). The interface services communicates the ‘select program’ message to the context transaction services (step 1310).”</p> <p>Wick, 20:47-54.</p> <p>“An online service provider may display dynamically and in real time information of other users presently viewing the television program (or channel) as being viewed by the user. For instance, the user may perceive when buddy list members view a television program concurrently with the user,”</p> <p>Wick, 4:37-42.</p> <p><i>See also</i> Wick, Fig. 6 (displaying other users viewing the program), 4:50-61 (displaying other users viewing the program).</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p>

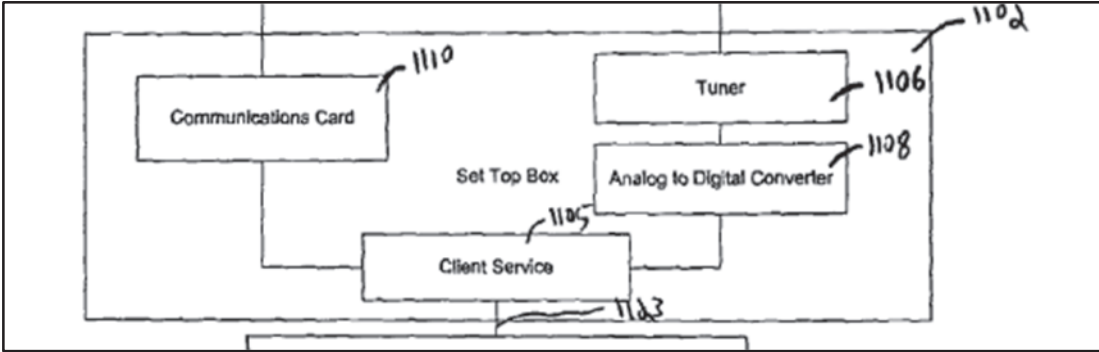
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>To the extent Wick does not disclose any part of this limitation, Wick renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Wick combined with the knowledge of a person of ordinary skill in the art, and in light of Wick combined with any of the other prior art references identified in the contentions for this patent, including Cooper. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>[1.i] a second trigger provided inside the television set and arranged to automatically send the second information to the second type of counterpart through the same communicator in response to completion of the function of the automatic generator and the second designator.</p>	<p>Wick expressly or inherently discloses “a second trigger provided inside the television set and arranged to automatically send the second information to the second type of counterpart through the same communicator in response to completion of the function of the automatic generator and the second designator.” For example:</p> <p><i>See</i> limitation 1.c (the communicator, second type of counterpart).</p> <p><i>See</i> limitation 1.g (the second information).</p>  <p>Wick, Fig. 11 (example second trigger), 18:28-19:34 (describing Fig. 11); <i>see also</i> Wick, Fig. 3 (client service 305).</p> <p>“[S]ome or all of the functionality of the set-top box 1102 may be performed by the television or monitor 1122.”</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Wick, 21:17-19.</p> <p>“[T]he client service 1105, the network 1117 and the dynamic user identification system 1120 typically have attributes comparable to and may illustrate one possible implementation of the client service 305, the large scale network 317, and the dynamic user identification systems 120, 320, 420, and 520, respectively.”</p> <p>Wick, 18:66-19:2.</p> <p>“The WholsWatching window 1200 also may include a television control panel 1245 that enables the user to select a program, channel, or television network to view. The television control panel 1245 may include buttons 1250 that may be selected to progress sequentially to the next or previous channel, program, or television network. The television control panel 1245 also may include one or more buttons 1255 that may be selected to automatically tune into a predetermined program, channel, or television network.”</p> <p>Wick, 20:10-18.</p> <p>“The viewer may select the buttons 1250, 1255, and 1260 which represent links that may be processed to change the channel of the set-top box 1102.”</p> <p>Wick, 20:29-31.</p> <p>“The set-top box 1102 also includes a client service 1105 for communicating with the user identification system 1120.”</p> <p>Wick, 18:54-55.</p> <p>“The client service 1105 is also configured to send channel selection data to the user identification system 1120 via the network server 1112.”</p> <p>Wick, 19:12-15.</p> <p>“When the viewer selects one of the buttons 1250 or 1255, or otherwise interacts with the television 1122 and/or set-top box 1102 in a manner that changes the channel, program, or television network, the client service 1105 is configured to send a TV select signal to the dynamic user identification system 1120.”</p>

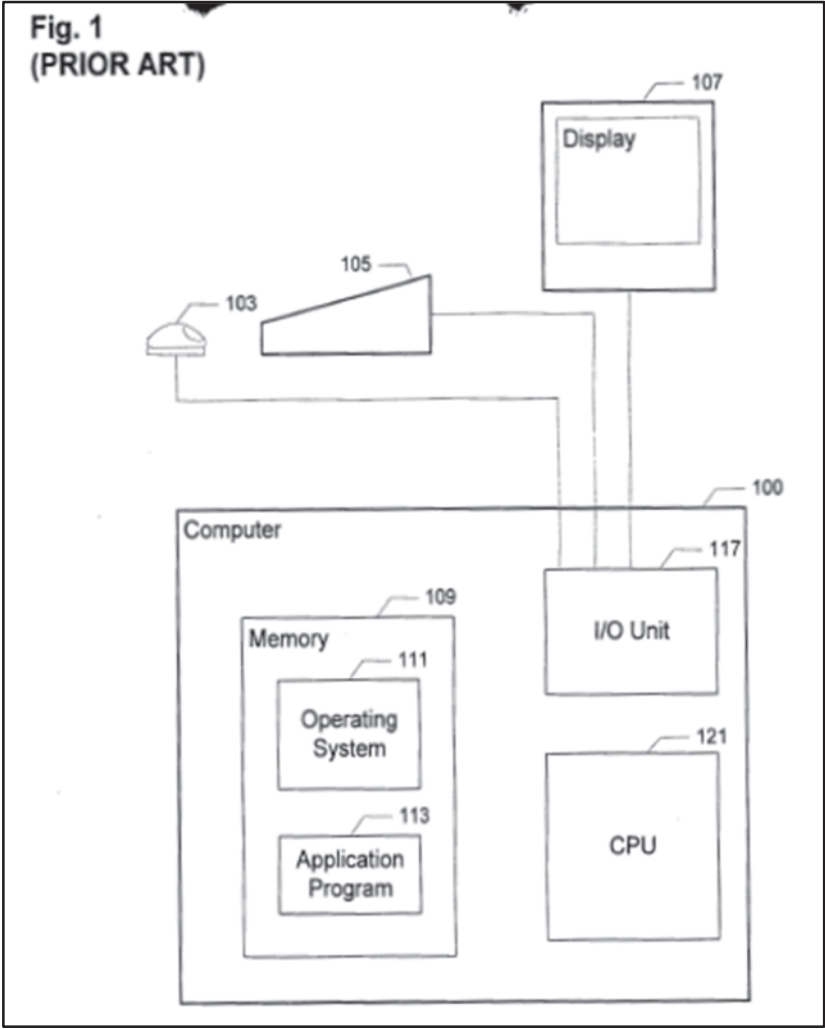
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Wick, 20:35-40.</p>  <p>FIG. 12</p> <p>Wick, Fig. 12, 19:35-20:46 (describing Fig. 12).</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<div data-bbox="632 212 1877 708" data-label="Diagram"> <pre> sequenceDiagram participant CS as Client Services participant IS as Interface Services participant CTS as Context Transaction Services participant CDS as Context Database Services participant SS as Support Services Note over 1300 CS->>IS: Select program Note over 1310 IS->>CTS: Select program Note over 1315 CTS->>SS: Query Viewer Info Note over 1320 SS-->>CTS: Viewer Info </pre> </div> <p data-bbox="583 727 1142 760">Wick, Fig. 13 (example second designator).</p> <p data-bbox="627 802 1976 980">“FIG. 13 illustrates a process 1300 that may be used to implement the system of FIG. 11 when the viewer tunes to a specific channel, program, or television network. Upon tuning to a particular channel, program, or television network, the client services 1105 sends a ‘select program’ message to the interface services (step 1305). The interface services communicates the ‘select program’ message to the context transaction services (step 1310).”</p> <p data-bbox="583 1000 793 1032">Wick, 20:47-54.</p>

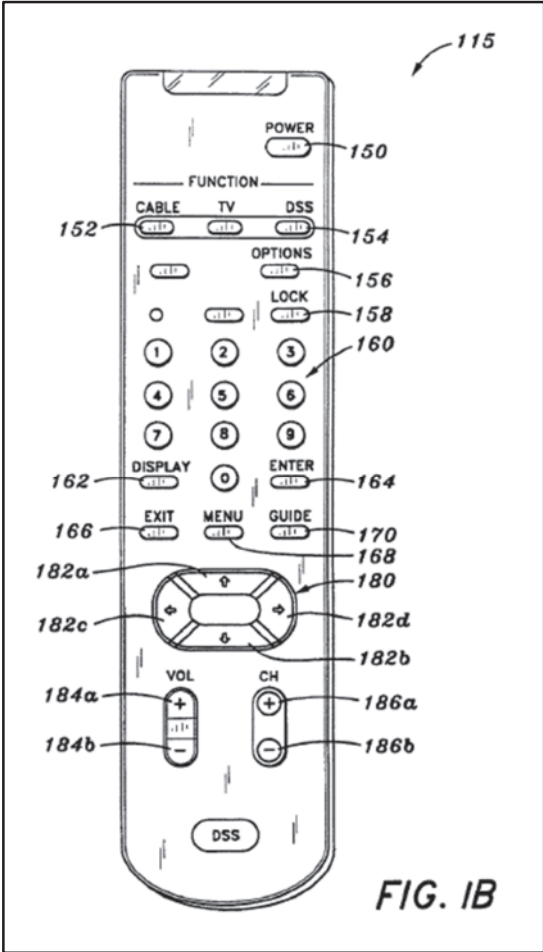
Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>Wick, Fig. 11 (example communicator communicating with second type of counterpart), 18:28-19:34 (describing Fig. 11); <i>see also</i> Wick, Fig. 3 (client service 305).</p> <p>“The set-top box 1102 includes a network communication card 1110 configured to enable the set-top box to communicate with a network server 1112. The network server 1112 is configured to provide the set-top box 1102 with access to a network 1117.”</p> <p>Wick, 18:46-50.</p> <p>“An online service provider may display dynamically and in real time information of other users presently viewing the television program (or channel) as being viewed by the user. For instance, the user may perceive when buddy list members view a television program concurrently with the user,”</p> <p>Wick, 4:37-42.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p><i>See also</i> Wick, Fig. 6 (displaying other users viewing the program), 4:50-61 (displaying other users viewing the program).</p> <p><i>See also</i> the contentions for this limitation from the '236 patent IPR, incorporated here by reference.</p> <p>To the extent Wick does not disclose any part of this limitation, Wick renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Wick combined with the knowledge of a person of ordinary skill in the art, and in light of Wick combined with any of the other prior art references identified in the contentions for this patent, including Cooper. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>2. The television set according to claim 1, wherein the detector includes a receiver arranged to receive a signal from a remote controller.</p>	<p>Wick expressly or inherently discloses “[t]he television set according to claim 1, wherein the detector includes a receiver arranged to receive a signal from a remote controller.” For example:</p> <p><i>See</i> limitation 1.b (the detector).</p>  <p>Wick, Fig. 11 (example receiver), 18:28-19:34 (describing Fig. 11); <i>see also</i> Wick, Fig. 3 (client service 305).</p> <p>“The elements of system 100 (the system elements) may include additional mechanisms for delivering or processing data. The mechanisms may include, for example, any applications, protocols, devices, or</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>networks used to facilitate communication or processing of electronic data. The system elements also may include or be included in a general-purpose or a special-purpose computer, a database, a local area network (LAN), and/or a wide area network (WAN). The response to and execution of instructions received by the system elements may be controlled by, for example, a program, a piece of code, an instruction, a device, a computer system, or a combination thereof, for independently or collectively instructing the system elements to interact and operate as described.”</p> <p>Wick, 6:20-35.</p> <p>“The WhoIsHere window 600 may enable the user 105 to open an IM or email to an other individual who is displayed by clicking on the displayed identifier of that other individual. For example, the user 105 may initiate an IM to SurfingSally by clicking on that individuals online identifier. Alternatively, the user 105 may select SurfingSally and may click on the Buddy Info button 635 to view buddy information related to SurfingSally.”</p> <p>Wick, 16:13-20.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p data-bbox="659 224 840 293">Fig. 1 (PRIOR ART)</p>  <p data-bbox="583 1252 1115 1289">Silva, Fig. 1 (example remote controller).</p> <p data-bbox="632 1328 1955 1398">“.... U.S. patent application Ser. No. 09/475,391, titled Television Chat Rooms, hereby incorporated by reference in its entirety.”</p>

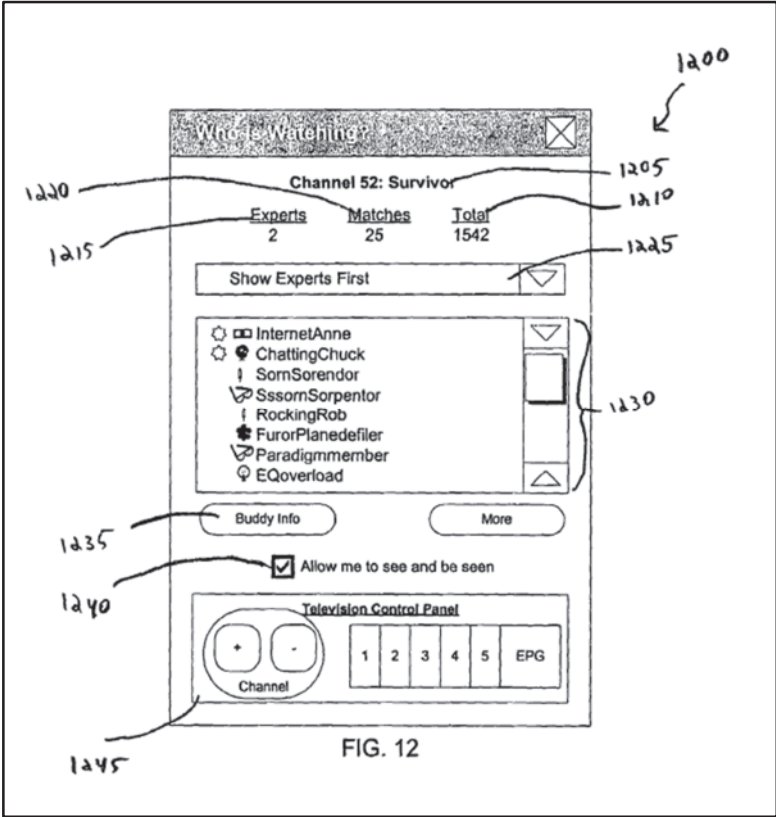
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Wick, 20:25-29.</p> <p>“The computer system illustrated in Fig. 1 represents a typical hardware setup for executing software that allows a user to perform tasks such as communicating with other computer users, accessing various computer resources, and viewing, creating, or otherwise manipulating electronic content -- that is, any combination of text, images, movies, music or other sounds, animations, 3D virtual worlds, and links to other objects. The system includes various input/output (I/O) devices (mouse 103, keyboard 105, display 107) and a general purpose computer 100 having a central processor unit (CPU) 121, an I/O unit 117 and a memory 109 that stores data and various programs such as an operating system 111, and one or more application programs 113.”</p> <p>Silva, 1:8-20.</p> <p><i>See also</i> WIPO Patent App. Pub. No. WO 01/50753 (“Silva II”), Fig. 1, 1:10-18 (disclosing same).</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Wick does not disclose any part of this limitation, Wick renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Wick combined with the knowledge of a person of ordinary skill in the art, and in light of Wick combined with any of the other prior art references identified in the contentions for this patent, including Cooper. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p> <p>Moreover, it also would have been obvious to a person of ordinary skill in the art to combine Wick with the following prior art:</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>U.S. Pat. App. Pub. No. 2002/0078442 (“Reyes”), Fig. 1B.</p> <p>“The remote control 115 comprises a power key 150 for activating the IRD 110 via a communication link, a cable key 152 which facilitates selection of cable channels, a DSS key 154 which facilitates selection of satellite-based channels, an OPTIONS key 156 for facilitating selection of desired channels; a LOCK key 158 for facilitating locking and unlocking of the control functions of the remote control 115, a numerical</p>

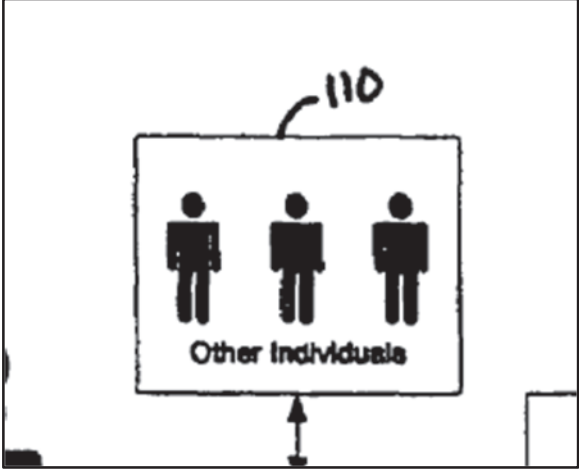
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>keypad 160, a DISPLAY key 162, an ENTER key 164, an EXIT key 166, a MENU key 168, and a GUIDE key 170.”</p> <p>Reyes, ¶ 24.</p>  <p>TiVo Series2 (<i>see</i> Exhibit 968.F).</p> <p><i>See also</i> TiVo Series2 Viewer’s Guide 2003 (<i>see</i> Exhibit 968.F).</p>
<p>4. The television set according to claim 1, wherein the automatic generator is arranged to generate the second information in</p>	<p>Wick expressly or inherently discloses “[t]he television set according to claim 1, wherein the automatic generator is arranged to generate the second information in accordance with a predetermined format.” For example:</p> <p><i>See</i> limitation 1.g (generate the second information).</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
<p>accordance with a predetermined format.</p>	<div data-bbox="632 321 1724 672" data-label="Diagram"> </div> <p>Wick, Fig. 11 (example automatic generator), 18:28-19:34 (describing Fig. 11); <i>see also</i> Wick, Fig. 3 (client service 305).</p> <p>“[S]ome or all of the functionality of the set-top box 1102 may be performed by the television or monitor 1122.”</p> <p>Wick, 21:17-19.</p> <p>“[T]he client service 1105, the network 1117 and the dynamic user identification system 1120 typically have attributes comparable to and may illustrate one possible implementation of the client service 305, the large scale network 317, and the dynamic user identification systems 120, 320, 420, and 520, respectively.”</p> <p>Wick, 18:66-19:2.</p> <p>“The WholsWatching window 1200 also may include a television control panel 1245 that enables the user to select a program, channel, or television network to view. The television control panel 1245 may include buttons 1250 that may be selected to progress sequentially to the next or previous channel, program, or television network. The television control panel 1245 also may include one or more buttons 1255 that may be selected to automatically tune into a predetermined program, channel, or television network.”</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>Wick, 20:10-18.</p> <p>“The viewer may select the buttons 1250, 1255, and 1260 which represent links that may be processed to change the channel of the set-top box 1102.”</p> <p>Wick, 20:29-31.</p> <p>“The set-top box 1102 also includes a client service 1105 for communicating with the user identification system 1120.”</p> <p>Wick, 18:54-55.</p> <p>“The client service 1105 is also configured to send channel selection data to the user identification system 1120 via the network server 1112.”</p> <p>Wick, 19:12-15.</p> <p>“When the viewer selects one of the buttons 1250 or 1255, or otherwise interacts with the television 1122 and/or set-top box 1102 in a manner that changes the channel, program, or television network, the client service 1105 is configured to send a TV select signal to the dynamic user identification system 1120.”</p> <p>Wick, 20:35-40.</p>

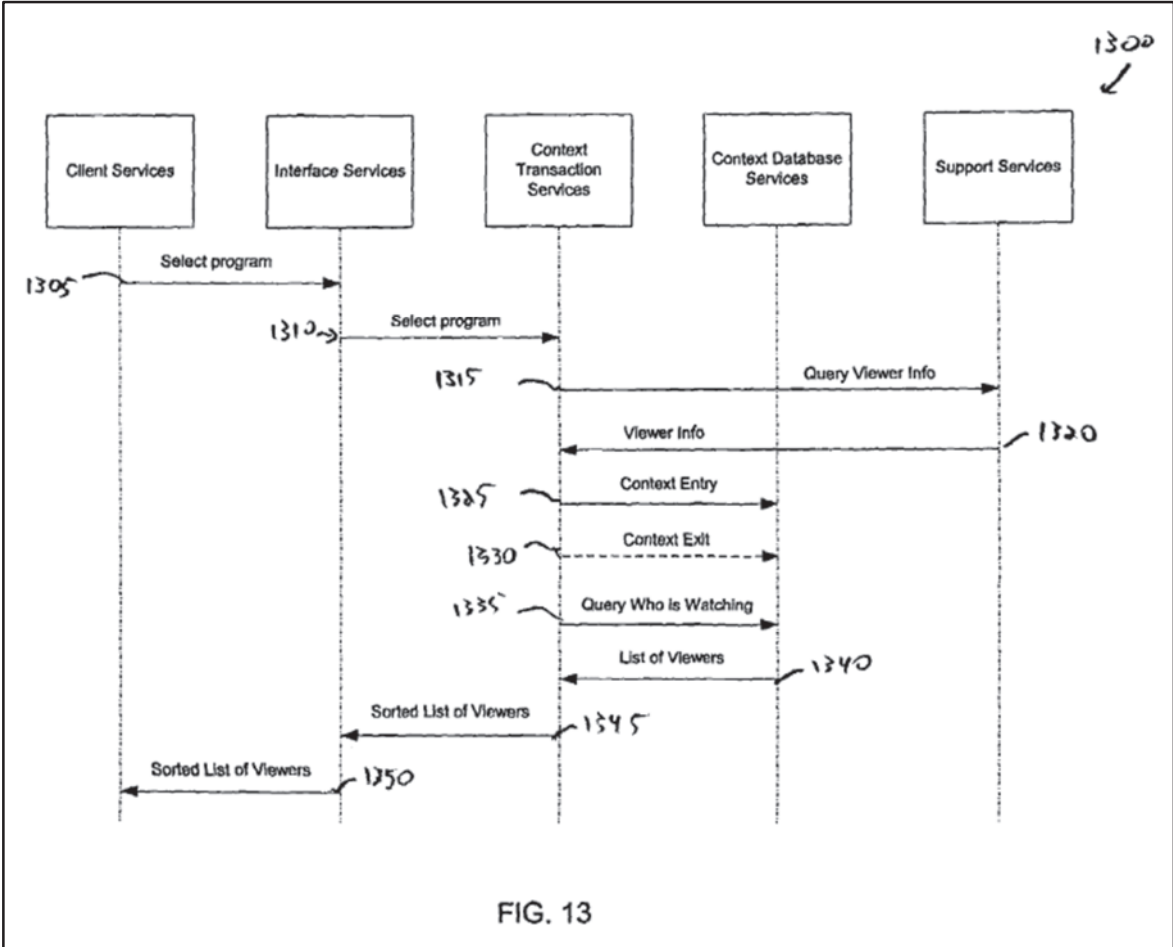
Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>FIG. 12</p>
	<p>Wick, Fig. 12, 19:35-20:46 (describing Fig. 12).</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<div data-bbox="632 212 1877 708" data-label="Diagram"> <pre> sequenceDiagram participant CS as Client Services participant IS as Interface Services participant CTS as Context Transaction Services participant CDS as Context Database Services participant SS as Support Services Note over 1300 CS->>IS: Select program Note over 1310 IS->>CTS: Select program Note over 1315 CTS->>SS: Query Viewer Info Note over 1320 SS-->>CTS: Viewer Info </pre> </div> <p>Wick, Fig. 13 (example second information in predetermined format).</p> <p>“FIG. 13 illustrates a process 1300 that may be used to implement the system of FIG. 11 when the viewer tunes to a specific channel, program, or television network. Upon tuning to a particular channel, program, or television network, the client services 1105 sends a ‘select program’ message to the interface services (step 1305). The interface services communicates the ‘select program’ message to the context transaction services (step 1310).”</p> <p>Wick, 20:47-54.</p> <p>“An online service provider may display dynamically and in real time information of other users presently viewing the television program (or channel) as being viewed by the user. For instance, the user may perceive when buddy list members view a television program concurrently with the user,”</p> <p>Wick, 4:37-42.</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Wick does not disclose any part of this limitation, Wick renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Wick</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>combined with the knowledge of a person of ordinary skill in the art, and in light of Wick combined with any of the other prior art references identified in the contentions for this patent, including Cooper. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>
<p>6. The television set according to claim 1, wherein the second designator is arranged to designate an address of another television set located in another place.</p>	<p>Wick expressly or inherently discloses “[t]he television set according to claim 1, wherein the second designator is arranged to designate an address of another television set located in another place.” For example:</p> <p><i>See limitation 1.h (second designator).</i></p>  <p>The diagram shows a rectangular television set labeled '110' at the top. Inside the screen, there are three black stick figures standing side-by-side. Below the figures, the text 'Other Individuals' is written. An upward-pointing arrow is located below the screen, and a small square is visible in the bottom right corner of the television's frame.</p> <p>Wick, Fig. 1 (other television sets in other places), 4:62-6:33 (describing Fig. 1), Fig. 3 (same).</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<div data-bbox="630 211 1402 1024"> <p style="text-align: center;">FIG. 12</p> </div> <p>Wick, Fig. 12, 19:35-20:46 (describing Fig. 12).</p> <p>“The WholsWatching window 1200 also may include a television control panel 1245 that enables the user to select a program, channel, or television network to view. The television control panel 1245 may include buttons 1250 that may be selected to progress sequentially to the next or previous channel, program, or television network. The television control panel 1245 also may include one or more buttons 1255 that may be selected to automatically tune into a predetermined program, channel, or television network.”</p> <p>Wick, 20:10-18.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p data-bbox="625 215 1976 285">“The viewer may select the buttons 1250, 1255, and 1260 which represent links that may be processed to change the channel of the set-top box 1102.”</p> <p data-bbox="583 305 793 337">Wick, 20:29-31.</p> <p data-bbox="625 378 1965 448">“The set-top box 1102 also includes a client service 1105 for communicating with the user identification system 1120.”</p> <p data-bbox="583 467 793 500">Wick, 18:54-55.</p> <p data-bbox="625 540 1982 610">“The client service 1105 is also configured to send channel selection data to the user identification system 1120 via the network server 1112.”</p> <p data-bbox="583 630 793 662">Wick, 19:12-15.</p> <p data-bbox="625 703 1976 808">“When the viewer selects one of the buttons 1250 or 1255, or otherwise interacts with the television 1122 and/or set-top box 1102 in a manner that changes the channel, program, or television network, the client service 1105 is configured to send a TV select signal to the dynamic user identification system 1120.”</p> <p data-bbox="583 828 793 860">Wick, 20:35-40.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>FIG. 13</p> <pre> sequenceDiagram participant CS as Client Services participant IS as Interface Services participant CTS as Context Transaction Services participant CDS as Context Database Services participant SS as Support Services Note over CS: 1305 CS->>IS: Select program Note over IS: 1310 IS->>CTS: Select program Note over CTS: 1315 CTS->>SS: Query Viewer Info Note over SS: 1320 SS->>CTS: Viewer Info Note over CTS: 1325 CTS->>CDS: Context Entry Note over CTS: 1330 CTS->>CDS: Context Exit Note over CTS: 1335 CTS->>CDS: Query Who is Watching Note over CDS: 1340 CDS->>CTS: List of Viewers Note over CTS: 1345 CTS->>IS: Sorted List of Viewers Note over IS: 1350 IS->>CS: Sorted List of Viewers </pre> <p>The diagram illustrates a process 1300 involving five service components: Client Services, Interface Services, Context Transaction Services, Context Database Services, and Support Services. The process begins with Client Services (labeled 1305) sending a 'Select program' message to Interface Services (labeled 1310). Interface Services then sends a 'Select program' message to Context Transaction Services (labeled 1315). Context Transaction Services sends a 'Query Viewer Info' message to Support Services (labeled 1320). Support Services returns 'Viewer Info' to Context Transaction Services (labeled 1325). Context Transaction Services then sends 'Context Entry' (labeled 1330) and 'Context Exit' (labeled 1335) messages to Context Database Services. Context Transaction Services also sends a 'Query Who is Watching' message to Context Database Services (labeled 1335). Context Database Services returns a 'List of Viewers' to Context Transaction Services (labeled 1340). Context Transaction Services then sends a 'Sorted List of Viewers' to Interface Services (labeled 1345). Finally, Interface Services sends a 'Sorted List of Viewers' back to Client Services (labeled 1350).</p>

Wick, Fig. 13, 20:47-21:15 (describing Fig. 13).

“FIG. 13 illustrates a process 1300 that may be used to implement the system of FIG. 11 when the viewer tunes to a specific channel, program, or television network. Upon tuning to a particular channel, program, or television network, the client services 1105 sends a ‘select program’ message to the interface services

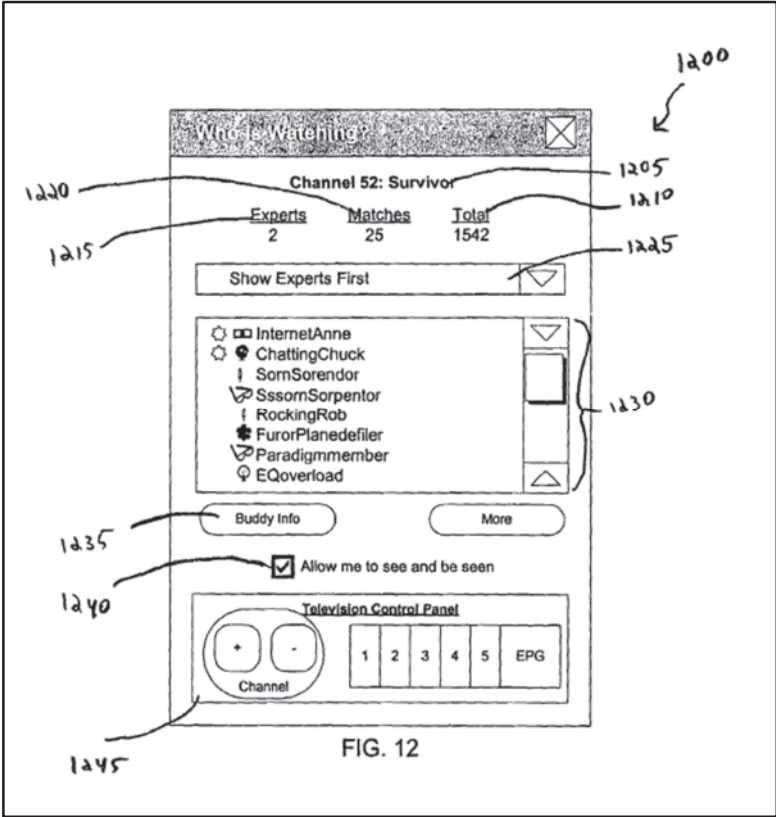
Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>(step 1305). The interface services communicates the ‘select program’ message to the context transaction services (step 1310).”</p> <p>Wick, 20:47-54.</p> <p>“The context transaction services also communicates a ‘query who is watching’ message to the context database services (step 1335). The context database services generate a ‘list of viewers’ message identifying individuals that are tuned to the selected channel, program, or television network (step 1340). The context transaction services generate a ‘sorted list of viewers’ message based on the “list of viewers’ message and preferences of the user and communicates the ‘sorted list of viewers’ message to the interface services (step 1345). The interface services communicate the ‘sorted list of users’ message to the client for presentation to the user (step 1350).”</p> <p>Wick, 21:4-15.</p> <p>“An online service provider may display dynamically and in real time information of other users presently viewing the television program (or channel) as being viewed by the user. For instance, the user may perceive when buddy list members view a television program concurrently with the user,”</p> <p>Wick, 4:37-42.</p> <p><i>See also</i> Wick, Fig. 6 (displaying other users viewing the program), 4:50-61 (displaying other users viewing the program).</p> <p><i>See also</i> Wick, Figs. 8-10 (implementing user identification system), 17:8-18:27 (describing Figs. 8-10).</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Wick does not disclose any part of this limitation, Wick renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Wick combined with the knowledge of a person of ordinary skill in the art, and in light of Wick combined with any of the other prior art references identified in the contentions for this patent, including Cooper. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p> <p>Moreover, it also would have been obvious to a person of ordinary skill in the art to combine Wick with the following prior art:</p> <div data-bbox="632 431 1740 1252"> <p>The diagram, labeled FIG. 10, illustrates a network architecture connecting two domains. On the left, 'USER A - DOMAIN 710' is shown, containing a 'CITY 711' with a video camera '712' and a 'WIRELESS MEDIA PLAYER 100A'. 'USER A' is depicted interacting with the media player. This domain connects to 'MOBILE OPERATOR A NETWORK 720', which includes a 'RADIO ACCESS NETWORK 721' and a 'CORE NETWORK 722'. On the right, 'USER B - DOMAIN 750' contains a 'WIRELESS MEDIA PLAYER 100B' and a 'TELEVISION 751', with 'USER B' interacting with the media player. This domain connects to 'MOBILE OPERATOR B NETWORK 740', which includes a 'CORE NETWORK 741' and a 'RADIO ACCESS NETWORK 742'. Both mobile operator networks connect to a central 'INTERNET 730' cloud, which is labeled with reference numeral '700'.</p> </div> <p>U.S. Pat. App. Pub. No. 2006/0258289 (“Dua”), Fig. 10.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p data-bbox="627 215 1961 321">“The method includes, selecting a media source, selecting specific media assets, selecting an address for the target device, resolving the address to an Internet routable address, and establishing a peer-to-peer communication session with the target device over the Internet.”</p> <p data-bbox="583 341 716 375">Dua, ¶ 21.</p> <p data-bbox="627 415 1976 521">“In one embodiment, media player 100 functions as a wireless terminal that has one or more E.164 phone numbers, Uniform Resource Identifiers (URIs), or other types of unique addresses that can be resolved over the Internet associated with it.”</p> <p data-bbox="583 540 716 574">Dua, ¶ 67.</p> <p data-bbox="627 615 1976 829">“Upon selecting specific media assets from the media source categories in step 570 the user is prompted (in step 573) to select the addresses of one or more remote recipients to which the media assets should be transmitted. The user may be presented on Screen with a contact list or ‘buddy list’ from which to select one or more recipients of the media assets. In a preferred embodiment, the contact list or ‘buddy list’ profiles contain unique addresses for target devices which can be resolved via the Internet, for routing over the global network.”</p> <p data-bbox="583 849 730 883">Dua, ¶ 178.</p> <p data-bbox="627 924 1955 992">“A transceiver and tuner in the media player 100 allows the unit to receive local television channels and other content from local devices in the vicinity via these frequency bands.”</p> <p data-bbox="583 1011 730 1045">Dua, ¶ 169.</p> <p data-bbox="627 1086 1923 1154">“Upon connecting with the target device, a secure, peer-to-peer communication session is established between the media player 100 and the target device.”</p> <p data-bbox="583 1174 730 1208">Dua, ¶ 183.</p> <p data-bbox="627 1248 1892 1317">“In step 575, after peer-to-peer connectivity is established between media player 100 and the target device, the selected media assets are transmitted to the target device from the media player 100.”</p> <p data-bbox="583 1336 730 1370">Dua, ¶ 187.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p data-bbox="627 215 1934 321">“Mapped to User B’s name could be an E.164 number, URI, SIP address, or other Internet-routable address which corresponds to User B’s wireless media player 100B. All of these address types can be resolved via the Internet to target the delivery of the live video feed to User B’s media player 100B.”</p> <p data-bbox="583 341 732 370">Dua, ¶ 192.</p> <p data-bbox="627 414 1934 483">“The IP address is further used to establish a SIP peer-to-peer session over the Internet between media player 100A and 100B as earlier described.”</p> <p data-bbox="583 503 732 532">Dua, ¶ 193.</p> <p data-bbox="627 576 1927 678">“Assuming the connection attempt is accepted by user B, a SIP peer-to-peer connection is established between the two devices. Media player 100A begins transmitting the video content to media player 100B.”</p> <p data-bbox="583 698 732 727">Dua, ¶ 194.</p> <p data-bbox="627 771 1976 1247">“As described up until now, the media player 100 has the ability to receive media content from a wide array of devices either in local proximity or over a wide area network. The media player 100 also has a built-in transceiver for transmitting/receiving content via broadcast frequency bands such as UHF, VHF, AM, and FM. In accordance with the invention, the media player 100 may have the ability to receive, for example, television and radio content over these broadcast frequency bands and convert the content to a digital format that can be stored in the media players hard drive 112 and later accessed by the user via the media manager application operating on media player 100. According to one embodiment of the invention, the media manager application enables the media player 100 to function as a digital video recorder (DVR). The digital video recording functionality can be enabled at the user's option. When enabled, the media player 100 digitally encodes all incoming broadcast signals being viewed by the user, and a saves them to the media players hard drive, allowing the user to pause, play, rewind, watch video in slow motion, and perform other operations with live programming similar to digital video recording devices such as TiVo or ReplayTV.”</p> <p data-bbox="583 1266 732 1295">Dua, ¶ 205.</p> <p data-bbox="627 1339 1976 1409">“While this invention has been described in terms of several preferred embodiments, there are alterations, per mutations, and equivalents, which fall within the scope of this invention. For example, although the</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>invention has been described in terms of a wireless media player 100, it should be appreciated that certain features of the invention may also be applied to other types of electronic devices (e.g., cameras, music players, video players, PDAs, cellular phones, game players, portable storage devices, headphones, televisions,”</p> <p>Dua, ¶ 230.</p>
<p>15. The television set according to claim 6, wherein the second information includes a channel identification of broadcast program for indication on a display of the another television set to visually inform the another television set of channel selection in the television function.</p>	<p>Wick expressly or inherently discloses “[t]he television set according to claim 6, wherein the second information includes a channel identification of broadcast program for indication on a display of the another television set to visually inform the another television set of channel selection in the television function.” For example:</p> <p><i>See</i> limitation 1.g (the second information).</p> <p><i>See</i> claim 6 (other television sets).</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	 <p>FIG. 12</p> <p>Wick, Fig. 12, 19:35-20:46 (describing Fig. 12).</p> <p>“The window 1200 indicates a program (or channel or television network) 1205 to which the television or monitor 1122 is currently tuned (e.g., ‘Channel 52: Survivor’). The window 1200 provides a total count 1210 of the other viewers that are tuned to the program 1205 (e.g., ‘1542’). The window 1200 also indicates the number 1215 of other viewers tuned to the program 1205 that are considered experts with respect to the program (e.g., ‘2’) and the number 1220 of other viewers tuned to the program 1205 whose interests match a specified interest of the viewer (e.g., ‘25’).”</p> <p>Wick, 19:42-51.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>“When the viewer selects one of the buttons 1250 or 1255, or otherwise interacts with the television 1122 and/or set-top box 1102 in a manner that changes the channel, program, or television network, the client service 1105 is configured to send a TV select signal to the dynamic user identification system 1120. The TV select signal enables the dynamic user identification system 1120 to update the context database services to reflect the new context corresponding to the channel, program, or television network and to return a sorted list of users to the client services 1105. The client services 1105 updates the WholsWatching window 1200 accordingly to reflect the new channel, program, or television network.”</p> <p>Wick, 20:35-46.</p> <p>“The context database services generate a ‘list of viewers’ message identifying individuals that are tuned to the selected channel, program, or television network (step 1340).”</p> <p>Wick, 21:6-9.</p> <p>“The set-top box 1102 also includes a client service 1105 for communicating with the user identification system 1120.”</p> <p>Wick, 18:54-55.</p> <p>“The client service 1105 is also configured to send channel selection data to the user identification system 1120 via the network server 1112.”</p> <p>Wick, 19:12-15.</p> <p>Wick, Fig. 13, 20:47-21:15 (describing Fig. 13).</p> <p>“FIG. 13 illustrates a process 1300 that may be used to implement the system of FIG. 11 when the viewer tunes to a specific channel, program, or television network. Upon tuning to a particular channel, program, or television network, the client services 1105 sends a ‘select program’ message to the interface services (step 1305). The interface services communicates the ‘select program’ message to the context transaction services (step 1310).”</p> <p>Wick, 20:47-54.</p>

Claim Limitation	Exemplary Disclosure in the Prior Art
	<p>“The context transaction services also communicates a ‘query who is watching’ message to the context database services (step 1335). The context database services generate a ‘list of viewers’ message identifying individuals that are tuned to the selected channel, program, or television network (step 1340). The context transaction services generate a ‘sorted list of viewers’ message based on the ‘list of viewers’ message and preferences of the user and communicates the ‘sorted list of viewers’ message to the interface services (step 1345). The interface services communicate the ‘sorted list of users’ message to the client for presentation to the user (step 1350).”</p> <p>Wick, 21:4-15.</p> <p>“An online service provider may display dynamically and in real time information of other users presently viewing the television program (or channel) as being viewed by the user. For instance, the user may perceive when buddy list members view a television program concurrently with the user,”</p> <p>Wick, 4:37-42.</p> <p><i>See also</i> Wick, 21:27-38.</p> <p><i>See also</i> Wick, Figs. 8-10 (implementing user identification system), 17:8-18:27 (describing Figs. 8-10).</p> <p><i>See also</i> the contentions for this limitation from the ’236 patent IPR, incorporated here by reference.</p> <p>To the extent Wick does not disclose any part of this limitation, Wick renders this limitation obvious. It would have been obvious to a person of ordinary skill in the art to practice this limitation in light of Wick combined with the knowledge of a person of ordinary skill in the art, and in light of Wick combined with any of the other prior art references identified in the contentions for this patent, including Cooper. The manner in which each of these references discloses and/or renders obvious this limitation is set forth in these contentions. All of these disclosures also would have been within the knowledge of a person of ordinary skill in the art.</p>