

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STINGRAY GROUP INC. and STINGRAY MUSIC USA, INC.
Petitioners

v.

EDWIN A. HERNANDEZ-MONDRAGON,
Patent Owner

Case IPR2025-00350
Patent No. 10,524,002

PATENT OWNER'S PRELIMINARY RESPONSE

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EX2002	<i>Edwin A. Hernandez, et al. v. Stingray Group Inc., et al.</i> , Case No. 24-cv-21266, Dkt. 190 (February 12, 2025 Order Denying Motion to Stay Pending IPRs)
EX2003	<i>Edwin A. Hernandez et al. v. Stingray Group Inc., et al.</i> , Case No. 24-cv-21266, Dkt. 154 (September 9, 2024 Order Setting Jury Trial Schedule, Requiring Mediation, and Referring Certain Matters to Magistrate Judge)
EX2004	<i>Edwin A. Hernandez et al. v. Stingray Group Inc., et al.</i> , Case No. 24-cv-21266, Dkt. 197 (March 4, 2025 Report & Recommendation regarding Motion to Dismiss)
EX2005	<i>Edwin A. Hernandez et al. v. Stingray Group Inc., et al.</i> , Case No. 24-cv-21266, Dkt. 195 (February 27, 2025 Defendants' Responsive Claim Construction Brief)
EX2006	Declaration of Edwin A. Hernandez, Ph.D. in support of Patent Owner's Preliminary Response, Case No. IPR2025-00350

I. INTRODUCTION

This petition should be denied for two independently sufficient reasons. First, the Board should exercise its discretion to deny institution because all six *Fintiv* factors overwhelmingly favor discretionary denial. The District Court has already denied Petitioners’ motion to stay the litigation, emphasizing Petitioners’ three-year delay in seeking IPR and the undue prejudice to Patent Owner. Trial is set for October 2025—a full eight months before any Final Written Decision could issue—with significant litigation milestones already completed or imminent. Petitioners have deliberately avoided any stipulation limiting their ability to pursue the same invalidity arguments in both forums, transparently seeking “two bites at the apple.” The USPTO’s February 28, 2025 rescission of the June 2022 memorandum on discretionary denials further confirms that the Board should apply the original *Fintiv* framework, under which this case presents a textbook case for discretionary denial.

Second, on the merits, Petitioners have failed to demonstrate any reasonable likelihood of success. Avellan, one of two primary references, fails to disclose the fundamental claimed architecture where a content provider (like a cable or satellite television operator) requests and receives a media stream for broadcast on a broadcast channel. Instead, Avellan discloses an entirely different system where end users request and receive internet content directly, which is not subsequently broadcast on a broadcast channel. Similarly, the second of the two primary references, Wannamaker, fails to disclose a monitoring system configured to

maintain generation of video and audio files during failures, instead teaching only conventional system restarts in the event of a failure.

Because the petition lacks merit and would waste judicial resources by duplicating the nearly completed district court proceedings, institution should be denied.

II. BACKGROUND

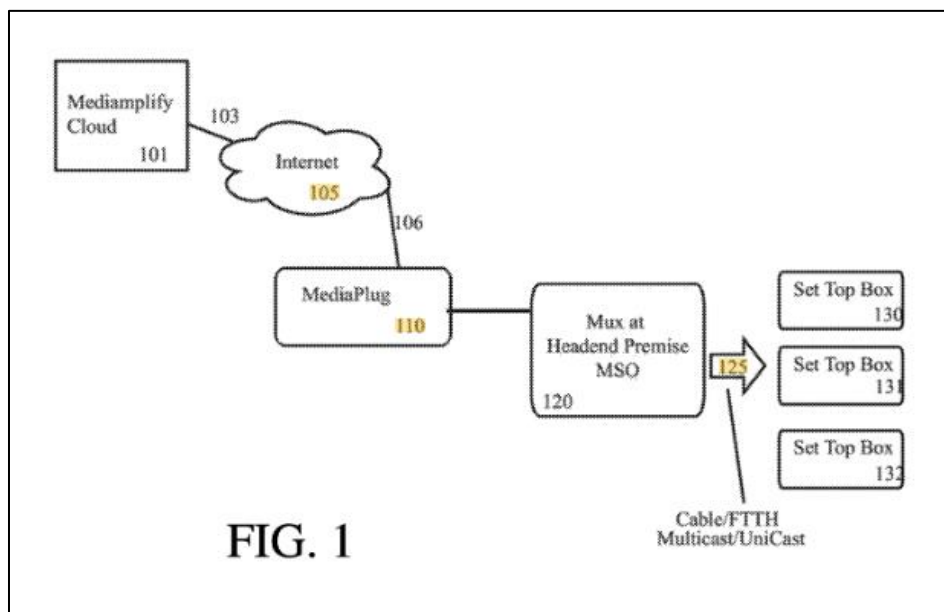
A. The ‘002 Patent

The ‘002 Patent is directed to novel systems and methods to deliver multimedia content from the cloud to cable operators. EX1001, ‘002 Patent, Abstract. Conventional systems required satellite systems “to deliver data (*e.g.* TV, radio, Video-on-Demand, multimedia streams) from a particular source (*e.g.* third-party content provider) to cable head end systems or other satellite systems.” *Id.*, 1:59-62. Recognizing these and other drawbacks, Dr. Hernandez set out to develop a system that eliminates the need for satellites while maintaining fault tolerance and reliability, among other additional advantages. *Id.*, 3:60-63; EX2006, ¶ 42.

The ‘002 Patent “describes a novel method and a system for continuous media delivery and secured synchronization of multimedia files that are broadcasted to set top boxes or subscriber units in the field that are connected to [Internet Protocol Television] IPTV or Cable Systems. The present technology...securely connect[s] to a cloud-based platform (*e.g.* OpenStack, Amazon EC2, Mediamplify Cloud, etc.), creates a set of multimedia files (*e.g.* MPEG4 movies) into a secured repository (*e.g.*

Secured File System, Linux/Windows, etc.), modifies those files according to certain rules as defined by the method herein, and reproduces those signals via a multicast video stream (*e.g.* User Datagram Protocol (UDP) multicast, etc.) encapsulated in a Transport Stream (TS) frame” that can be multiple or single transport streams. EX1001, 1:22-37; EX2006, ¶ 43.

As shown below, in FIG. 1, the disclosed technology introduces an innovative delivery mechanism for multimedia content distribution to cable and other delivery systems. EX2006, ¶ 44.



At the core of this system is a sophisticated cloud computing environment (*e.g.*, AWS) that can be implemented through various virtualized or non-virtualized server instances (shown in FIG. 1 as Mediamply Cloud). This cloud infrastructure provides secure access to archived media content and digital files. The cloud service files are accessible via internet connectivity and are stored in advanced cloud-based

or cluster file systems. These systems house multimedia files, primarily consisting of encoded video and audio files. EX1001, 3:63-4:11; EX2006, ¶ 45.

The cloud infrastructure is connected to various communication channels (*e.g.*, DSL, Cable Modem, Wireless WAN, Fiber, or Ethernet) via a computer or server (or set of computers or servers), shown in FIG. 1 as the MediaPlug. The MediaPlug computer/server resides at the Multiple System Operator (MSO) facility alongside other cable or satellite operator equipment. The MSO facility serves as the central hub where the cable operator receives, multiplexes, re-encodes, and distributes TV and Radio Programming to subscriber units with set-top boxes or modulates signals for analog TV channels. EX1001, 4:12-24; EX2006, ¶ 46.

The MediaPlug's computer/server's primary function is to deliver multimedia content to an MPEG multiplexer at the headend, which receives, processes and transmits the communication signals. This content arrives at the headend pre-formatted in MPEG Transport Streams, allowing the multiplexer (shown as Mux at Headend Premise MSO 120) to capture and reformat the content according to operator/content provider's requirements before distribution to end user/subscribers via Coaxial Cable or other multicast/unicast delivery methods. The end users receive this content through their Set Top Boxes, which are located at the end user/subscriber's home and are capable of decoding and displaying TV programming through HDMI or analog inputs. EX1001, 4:25-37; EX2006, ¶ 47.

Claim 1 of the '002 Patent recites:

1. A computer-implemented method, comprising:

receiving, from a content provider, a request for at least one media stream for playback on a broadcast media channel, wherein the at least one media stream includes a plurality of multimedia items of different types;

obtaining content corresponding to the plurality of multimedia items from at least one source offering the content in at least one first format;

rendering a web page by a browser using the content;

generating a temporal sequence of screen captures of the rendered web page, where each screen capture defines all the content of the web page at a given time, and at least two adjacent screen captures illustrate a dynamic change of at least a portion of the content over time;

assembling the at least one media stream using the temporal sequence of screen captures; and

providing the at least one media stream to the content provider for broadcast on the broadcast media channel;

wherein the at least one media stream corresponds to at least one of an HTTP live stream (HLS), an HTTP playlist, and a Real-time Streaming Transport (RTSP) stream; and

wherein the web page is rendered in parallel in multiple threads.

EX1001, 14:50-15:6; EX2006, ¶ 48. The claimed methods thus start with a content provider (*e.g.*, cable or satellite television operator) requesting a media stream to

broadcast on one of its media channels. The media stream includes different types of media such as audio and video content (*e.g.*, music and video images, respectively). To provide the requested media stream, content from a web page is obtained (via the cloud-based system) and rendered by a browser. Once the web page is rendered, a time-based sequence of screen captures is generated with at least two adjacent screen captures illustrating a change in the content over time. This sequence of screen captures is assembled into a media stream (*e.g.*, HTTP live stream, HTTP playlist, or Real-time Streaming Transport (RTSP) stream) and provided to the content provider (*e.g.*, cable operator) to broadcast over a media channel. EX2006, ¶ 49.

Claim 7 of the '002 Patent recites:

7. A system, comprising:

a multicast server configured to generate parameters relating to at least one of video content, image content and audio content, and configured to output the parameters via MPEG outputs;

a caching server communicatively coupled to the multicast server, and configured to

receive and store the parameters,

create a temporal sequence of screen captures of a rendered web page, where each said screen capture defines content of the rendered web page at a given time, and at least two adjacent screen captures in the temporal sequence illustrate a

dynamic change of at least a portion of the video content, image content or audio content over time,

assemble the temporal sequence of screen captures, and

provide at least one of the video content, image content and audio content to the multicast server for generating a multicast stream with MPEG encoded video and audio; and

a monitoring system configured to maintain generation of video and audio files, even in failure cases.

EX1001, 15:41-16:12; EX2006, ¶ 50.

B. Petitioners’ Primary Prior Art - U.S. Pat. 8,954,600 (“Avellan”)

The Petition sets forth four grounds of alleged invalidity based principally on Avellan (EX1003) and Wannamaker (EX1006) (discussed below). Pet, 3.

Avellan is entitled “System and method for zero latency browsing” and is directed to “[a] system [that] replicates Internet websites on a large number of user computers having browsers.” EX1003, Abstract. Avellan discloses that “[t]he present invention is directed to a system and method for providing high definition (HD) Internet in a near-zero latency environment. The current invention addresses latency and bandwidth efficiency by managing Internet access more efficiently and with user performance that allows viewing and interaction with web pages significantly faster than legacy systems available today over terrestrial, wireless, fiber and satellite links.” EX1003, 2:16-23; EX2006, ¶ 51.

To accomplish this goal, as shown in FIG. 1 below, Avellan discloses a system “for replicating Internet websites on a large number of user computers having browsers.” *Id.*, 2:24-26. Avellan further discloses that “the system 100 provides for user computers 104₁ – 104_n to access the Internet 150 and/or private cloud 152 through a virtual browser 106 of the gateway 130.” EX1003, 4:18-21. Avellan explains that “the browser software 106 resides at the gateway 134, and is configured to run as a virtual browser as a remote client of the gateway server 134.” *Id.*, 4:56-58. “The gateway server 134 then images those web pages (which are typically in an HTTP format) to a video or image frame format.” *Id.*, 4:65-67; EX2006, ¶ 52.

As shown below in FIG. 1, in operation, Avellan explains that “[i]f the user requests a web page, the user computer 104 checks its local storage device 110 for the desired information. If the requested information has been previously broadcast and stored in the storage device 110, that information is immediately displayed in the browser 106.” EX1003, 6:38-43. On the other hand, “[i]f the information is not stored in the cache 136, the server 134 replicates the action point to the website on the Internet cloud 120. The website response is then imaged, compressed and returned to the browser 106 using a differential burst video transmission via the satellite 102.” *Id.*, 6:49-54; EX2006, ¶ 53.

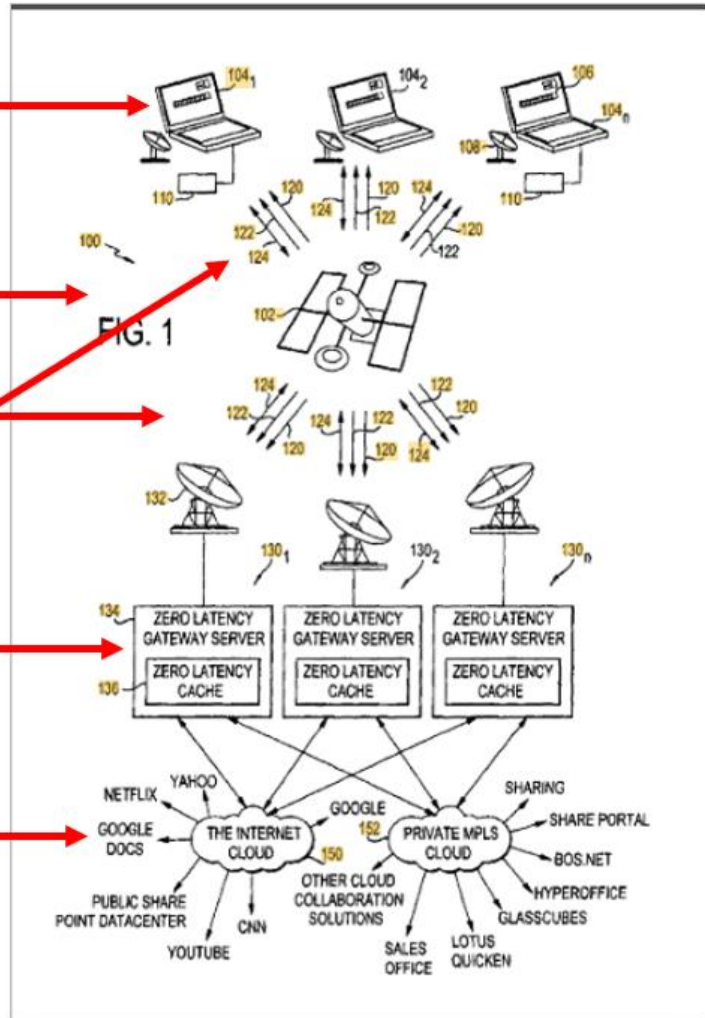
Computer users request media stream

Satellite transmits data

One way or bi-directional data links

Gateway server receives users requests, obtains web content, provides to users

Web content accessible via cloud



Avellan discloses that it has two primary modes of operation, a unicast mode and a broadcast mode. EX1003, 6:65-7:1. The “unicast mode is used to send highly customized information from a single website at network 150, 152 to a single user computer 104 in real time as it is requested by the user.” *Id.*, 7:2-5. The “broadcast mode is used to send information that is accessed by a large number of users from a single website at network 150, 152 to a large number of user computers 104.” *Id.*, 7:11-13. To reduce latency, Avellan teaches that “the broadcast mode operates proactively, before the user requests any broadcast data, so that the information is

immediately available for display in the browser 106 when the user subsequently desires to access it.” *Id.*, 9:7-10; EX2006, ¶ 54.

Avellan thus teaches that users request website content using user computer 104 through a virtual browser 106. When a user wants to view a webpage, they make this request through the browser interface. EX1003, 4:19-25, 6:26-37, 6:38-43, 7:2-15; 8:23-32, 8:34-41. In broadcast mode the process flow is that the gateway server proactively identifies popular websites, proactively retrieves the website information from the internet, captures the data, compresses it, stores it, and broadcasts it to multiple users at one time, who store that data locally so it is available when the user requests it. *Id.*, 8:14-57, 9:7-10; FIG. 2. In contrast, in unicast mode the user requests a specific webpage, the browser checks if it’s stored locally, if not, the browser sends the request to the gateway server, the gateway checks its cache and, if the requested data is not found, it searches the Internet, once found it renders the web page, compresses it, then immediately transmits it to the user without delay. *Id.*, 13:21-59; FIG. 2; *see also* 7:53-58 (“Since the unicast mode is for customized information, the unicast data is sent in real time without delay, directly from the network cloud 150, 152 via the gateway platform 130 and the broadcast device 102 to user computer 104, where it may be immediately displayed (once decompressed at the computer 104).”); EX2006, ¶ 55.

C. Petitioners' Primary Prior Art - U.S. Pat. Publ. 2004/0031052 ("Wannamaker") (EX1006)

Wannamaker discloses a system is primarily designed as a broadcast-only solution, where “the information platform supports broadcast-only applications, *i.e.* applications not requiring a return path.” EX1006, [0009], [0023], Abstract. This approach allows cable television operators to leverage existing infrastructure while still providing enhanced TV services. *Id.*, [0022]. In essence, Wannamaker focuses more on enabling cable operators to offer enhanced services to TV subscribers through a middleware or information platform. EX2006, ¶ 56.

The platform employs a client/server architecture where “the information platform mediates the communication between an abundance of Web-based content and the television set.” *Id.*, [0008], [0023]. “This architecture allows a truly open cable application implemented on the server, or a client application enhanced by the capabilities of the server. For example, Web browsing is made available on the Motorola DCT 2000 set-top box by leveraging the resources of the server platform for layout and rendering of Web content.” *Id.*, [0046]. “Traditional television programming is integrated with Web content using TV-specific extensions to HTML and Java. Applications can be loaded from the network, from carousels, or from file systems, such as flash memory or EEPROM.” *Id.*, [0008]; EX2006, ¶ 57.

The information platform consists of application servers 10, having an application server processor 24 and a content processor 23, installed at the network head end 14 and hosted on a Unix platform, and the TV navigator client hosted on a set-top box 16. The application server exchanges information with a CATV system 12 and the Internet 15. The CATV system provides communications between the application server and the subscriber set-top box 16 on which a TV navigator is running 33 and to which the subscriber's television 17 is connected. These components work with the network operator's applications and equipment to deliver proprietary applications, third-party applications, and managed broadcast content to subscribers, along with broadcast television. EX1006, [0058], [0059]; EX2006, ¶ 58.

III. THE LEVEL OF ORDINARY SKILL IN THE ART

A person of ordinary skill in the art at the time of the inventions in the '002 Patent would have had a bachelor's degree in computer science or a related field, and at least two years of experience working in the field of software systems used in generating and broadcasting multimedia streams. An individual with less technical education but more experience, or vice versa, could also qualify as a person of ordinary skill in the art. EX2006, ¶ 59. Petitioners offer a similar definition, albeit with an important difference. Unlike the subject matter of the '002 Patent, their definition is not focused on software systems used in generating and broadcasting multimedia stream, but on multimedia "processing or delivery using internet

protocols.” Pet., 19. Those skilled in the art would understand that this focus is generally hardware-based whereas the subject of the patent is a software-based solution to broadcasting multimedia streams, and the skillset and expertise in hardware-based systems would not make one knowledgeable about software-based systems.¹ EX2006, ¶ 60.

IV. CLAIM CONSTRUCTION

Claims in a post-grant review are construed using the same claim construction standard as in a civil action. 37 C.F.R. § 42.100(b). Under this standard, claims terms are generally given their ordinary and customary meaning as understood by a person of ordinary skill in the art (“POSITA”) at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (en banc). The POSITA is deemed to read the claim term in the context of the entire patent, including the specification and prosecution history. *Id.* at 1313-1316. Courts depart from the plain and ordinary meaning in only two exceptions: (1) when a patentee acts as its own lexicographer, and (2) when the patentee disavows the full scope of the claim term in the specification or during prosecution. *Hill-Rom Servs. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014). Neither exception applies here.

¹ Not surprisingly, Petitioners’ expert’s experience is rooted in hardware relating to data communications over the Internet rather than software solutions as reflected in the claimed inventions.

The terms of the ‘002 Patent are used in their ordinary and customary manner. However, given Petitioners’ different interpretations “content provider” in petitions addressing this same term, Patent Owner submits the understanding of a person of ordinary skill in the art for this term in the context of the patent’s surrounding claim language and specification. Intrinsic support for this term, along with proposed construction, is set forth below. EX2006, ¶ 61.

A. The Ordinary and Customary Meaning of “content provider”

Patent Owner submits that the plain and ordinary meaning of the term “content provider” means to a POSITA *“a third party such as a cable television or satellite television operator, or any other multimedia outlet, that requests and receives multimedia content for playback on a broadcast media channel.”*² EX2006, ¶ 62.

The language of claims 1-6 and 13 recites, in pertinent portion, “receiving, from a content provider, a request for at least one media stream for playback on a broadcast media channel...” EX1001, 14:51-53. One the media stream is assembled per subsequent steps recited in the claims, the claims require “providing the at least one media stream to the content provider for broadcast on the broadcast media channel.” *Id.*, 14:66-67. Thus, the claim language plainly states that content

² Regardless of whether the Board agrees with Patent Owner’s construction, under any plausible construction or interpretation of the plain meaning of this term, Petitioners have failed to show that the claims are anticipated and/or rendered obvious on the asserted grounds.

provider (1) requests a media stream, (2) receives the requested media stream, and (3) uses the media stream for playback on a broadcast media channel. EX2006, ¶ 63.

This is the same meaning given to this term in the specification:

- “The present disclosure provides a mechanism for ***delivering multimedia content*** from a cloud-based system ***to cable or satellite content providers.***” EX1001, 1:19-21; EX2006, ¶ 64.
- “An example computer-implemented method can ***receive, from a content provider such as a cable or satellite operator, a request*** for at least one ***media stream for playback on a broadcast media channel.***” EX1001, 2:53-56; EX2006, ¶ 65.
- “The media stream can be ***provided [] to the content provider for broadcast on the broadcast media channel.***” EX1001, 8:17-19; EX2006, ¶ 66.

The proposed construction thus is consistent with the patent’s specification and makes clear the role of the content provider in requesting a media stream, receiving the requested media stream, and using the media stream for playback on a broadcast media channel. This construction is consistent with the surrounding claim language that distinguishes between the content provider, which requests and receives the multimedia stream generated from the content, and other parts of the claimed method and systems that perform the claimed functions of obtaining and rendering content, generating and assembling the multimedia stream, and providing the multimedia stream. Those skilled in the art would understand that it would be nonsensical for the content provider to request and receive something that it itself

creates and provides. Such an interpretation would render the requesting and receiving steps unnecessary and meaningless. EX2006, ¶ 67.

While Petitioners acknowledge that terms are typically given their ordinary and customary meanings, they did not offer any construction for any terms. Pet., 19. Instead, they assert that “the prior art invalidates the Challenged Claims under any plausible construction.” *Id.*, 20 Even though they offered no construction of their own in the Petition, in the parallel litigation Petitioners took exception to Patent Owner’s construction, arguing, in essence, that the “claim language does not specify nor limit the claims to a ***specific corporate configuration*** of content providers or cable/satellite operators.” EX2005, 1. Plaintiffs read too much into the proposed construction. The point is that the claims differentiate between the content providers (*e.g.*, cable television or satellite television operators) who are requesting and receiving the multimedia stream for broadcasting to their subscribers and the other entities or system components that obtain and render content, and generate, assemble, and provide the multimedia stream to such broadcasting entities. As the ‘002 Patent makes clear, this does not require a specific corporate configuration. *Compare* EX1001, 1:43-45 (describing content providers as “Cable operators, Multiple System Operators (MSO), and Digital Satellite Systems (DSS) [who] deliver media content.” to subscribers’ set top boxes) *with* 4:38-43 (describing the system components that provide the multimedia stream to the content providers as “a computer or server or set of computers of servers that can communicate with the

Cloud 101 using a standard Local Area Network (e.g. Gigabit Ethernet)...[and] can store, encode, and transmit multimedia files in the format that the cable operator at its MSO requires.”), FIG 1; EX2006, ¶ 68.

V. THE BOARD SHOULD EXERCISE DISCRETION TO DENY INSTITUTION

In the first instance, the Board should deny institution under 35 U.S.C. §314 because all six *Fintiv* factors favor discretionary denial. There is no requirement that the Board institute *Inter Partes* Review. *See, e.g., Harmonic Inc. v. Avid Tech.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). Rather, the decision to institute is delegated to the Board and is purely discretionary. Indeed, on February 28, 2025 the USPTO rescinded its June 21, 2022, guidance memorandum entitled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation.” EX2001. Among the policies set forth in the June 2022 memorandum that have been withdrawn are that (1) the PTAB will not discretionarily deny institution of an IPR or PGR in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition and (2) where the PTAB determines that the information presented at the institution stage presents a compelling unpatentability challenge, that determination alone demonstrates that the PTAB should not discretionarily deny

institution under *Fintiv*. The email rescinding the memorandum further stated, “[t]o the extent any other PTAB or Director Review decisions rely on the Memorandum, the portions of those decisions relying on the Memorandum shall not be binding or persuasive on the PTAB.” EX2001. Thus, rather than follow the June 2022 memo’s prescriptive guidance, panels will now weigh the *Fintiv* factors as they had done prior to the memo’s issuance, in view of the Board’s earlier precedent including the *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv I*”).

This petition, and the related two petitions addressing related patents, present a textbook case for discretionary denial. It is well settled that Section 314(a) gives the Board discretion to deny institution because of efficiency considerations stemming from parallel proceedings on the same patent. *See NHK Spring Co. v. Intrix-Plex, Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (“*NHK Spring*”). The PTAB considers six factors for determining whether discretionary denial due to efficiency considerations relating to parallel proceedings is appropriate (the “*Fintiv* factors”):

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;

4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner(s) and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv I, 6; *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (PTAB May 13, 2020) (order denying institution) (informative, designated July 13, 2020) (“*Fintiv II*”), 7-8.

As demonstrated below, a compelling case exists for denying IPR institution as all six *Fintiv* factors strongly favor discretionary denial:

1. **Court Stay Already Denied:** The District Court has explicitly denied Petitioners' motion to stay on February 12, 2025, citing undue prejudice to Plaintiffs, Petitioners' three-year delay in seeking IPR, and the risk to the established trial schedule in October 2025. *See* EX2002.
2. **Trial Precedes Board Decision:** The October 2025 trial date will occur approximately eight months before the earliest possible Final Written Decision deadline of June 2026, rendering IPR an inefficient parallel proceeding rather than an alternative to litigation. *See* EX2003.
3. **Significant Progress in Litigation:** Substantial work has already been, or will have been, completed in the district court before the institution decision,

including claim construction briefing, *Markman* order³, discovery exchange, and expert reports. See EX2003, EX2004.

4. **Issue Overlap:** Petitioners have deliberately avoided making any stipulation to prevent raising identical invalidity arguments in both forums, essentially seeking “two bites at the apple” on the same invalidity issues. Pet., 4.
5. **Identical Parties:** The same parties are involved in both the IPR petition and district court litigation.
6. **Uncompelling Merits:** Petitioners’ key prior art fails to anticipate or render obvious the challenged claims, and Petitioners have not demonstrated the “compelling merits” required to overcome the other factors favoring denial.

Importantly, as noted, the USPTO’s recent rescission of its 2022 guidance memorandum on discretionary denials reaffirms the Board’s authority to deny institution in cases like this where efficiency considerations strongly favor proceeding solely in the district court.

A. Factor 1 Weighs In Favor of Denial

The first *Fintiv* factor—regarding whether a stay exists or is likely to be granted if a proceeding is instituted—indisputably weighs in favor of denial. Petitioners recently sought to stay the district proceedings based on the instant

³ The district court vacated the *Markman* hearing find that “the hearing shall be re-set if necessary.” Thus, it is expected that the Court soon will construe the disputed terms based on the Parties’ completed claim construction briefing.

petition, and two others, challenging the claims of the Asserted Patents. On February 12, 2025, the District Court denied Petitioners motion to stay without leave for Petitioners to renew it should these petitions be granted. EX2002. Among the reasons given, the District Court denied the motion to stay because [1] “a stay would unduly prejudice Plaintiffs given that the PTAB will only resolve three of the nine claims that Plaintiffs have brought against Defendants”, [2] “[t]he timing of the Motion also weighs against granting a stay, given that Defendants have petitioned for inter partes review three years after receiving notice of potentially infringing activity and nine months after Plaintiffs filed their suit,” and [3] “[a] trial date has already been set, and staying the case would hinder an efficacious resolution of this matter...[because] it risks delaying the current trial date of October 2025 to an indeterminate date, given that, if the PTAB hears the case, it will have until July 2026 to issue a final decision on the validity of the at-issue patents...[a]nd if the PTAB extends its own deadline, a final decision may not arise until December 2026.” EX2002 at 1 (internal citations omitted). Where, as here, the court has denied a motion to stay pending the IPRs and has not indicated it will consider a renewed motion or reconsider a motion to stay if a PTAB trial is instituted, the Board has held this favors discretionary denial. *Fintiv*, 7-8. Thus, this factor weighs in favor of denying institution.

B. Factor 2 Weighs In Favor of Denial

The second *Fintiv* factor—the proximity of the court’s trial date to the Board’s projected statutory deadline for a Final Written Decision—also weighs in favor of denial. The Notice of Filing Date Accorded to Petition was mailed on December 20, 2024. Paper 3, 1. A Final Written Decision will therefore be due by **June 20, 2026**. *See* 35 U.S.C. §314(b); 35 U.S.C. §316(a)(11). Trial in the district court litigation is scheduled to begin on **October 6, 2025**. EX2003, 1. Thus, a final written decision will likely issue *over eight months or more after the trial* in the parallel litigation. Moreover, in its order denying Petitioners’ motion to stay pending the IPRs, this Court reaffirmed that a stay would put at risk the current trial date of October 2025. Thus, because the trial date in this matter is expected to conclude at least eight months before a final written decision is due in this IPR, under *Fintiv* factor 2, this weighs heavily in favor of discretionary denial. *See Fintiv I*, 9 (“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this factor in favor of exercising authority to deny institution under NHK.”); *Ericsson Inc. et al v. Collison Communications, Inc.*, IPR2022-01233, Paper 12 at 12-13 (PTAB Jan. 19, 2023) (holding Factor 2 “weighs in favor of denying institution, given that we would not expect to issue a final written until at least four months” after trial). Further, granting institution here would frustrate one of the primary objectives of the AIA, which is “to provide an effective and efficient alternative” to parallel litigation. *NHK Spring*, 19-20 (quoting *General Plastic*

Indus. Co., Ltd. v. Canon Kabushiki Kaisha, IPR2016-01357, Paper 19, 15-19 (PTAB Sept. 6, 2017) (precedential, designated Oct. 18, 2017)). If IPR were instituted, not only would any potential FWD issue well after trial concludes, but it would not simplify the matters before the District Court because, as the Court noted, at most the Board’s FWD will only resolve three of the nine claims that Patent Owner has brought against Petitioners. Accordingly, instituting IPR here cannot be viewed as an “alternative” to litigation. Rather, it would simply multiply the proceedings at great expense to the parties and unnecessarily waste the Board’s scarce resources.

C. Factor 3 Weighs In Favor of Denial

The third *Fintiv* factor—which relates to “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision” (*Fintiv I* at 9)—also favors denial. Significant work has been done on the case and by the time the institution decision is rendered on or about June 20, 2025, additional, substantive work will have been completed in the district court. For example, the parties already have exchanged initial disclosures, served discovery, filed claim construction briefs, and will have completed claim construction. EX2003, 2. In addition, the parties will have exchanged discovery on the merits of the claims and defenses in the case, served expert reports (due May 12, 2025), served rebuttal expert reports (due June 2, 2025), and completed all discovery (by June 23, 2025). EX2003, 2. Thus, at about the time the Board issues its

institution decision, a substantial amount of work in this case will be done and trial will be less than 4 months away.

Moreover, the District Court has invested, and will continue to invest, a significant amount of time in this case. The Court recently issued a 47-page order denying Petitioners motion to dismiss eight of the nine counts in the case. EX2004. The Court also denied Defendants’ motion to stay (EX2002) and the Court is expected to construe the disputed claim terms at or around the previously scheduled *Markman* hearing date of March 20, 2025 (EX2003, 2). Thus, significant substantive work will have already been completed in the parties and the District Court by the expected time of the institution decision, all of which weighs in favor of discretionary denial. *See Fintiv II*, 14.

Further, as the District Court recently noted, “Defendants have petitioned for inter partes review three years after receiving notice of potentially infringing activity and nine months after Plaintiffs filed their suit.” EX2002, 1. Thus, Petitioners significantly delayed filing the instant petition, resulting in the parties and District Court expending a significant amount of work in the litigation. Petitioners’ unsupported claim that the “district court case is still at an early stage” is thus belied by the record. Accordingly, factor 3 weighs in favor of the Board’s exercising its discretion to deny institution.

D. Factor 4 Weighs In Favor of Denial

The fourth *Fintiv* factor—which relates to overlap between issues raised in the petition and in the parallel proceeding—also weighs in favor of denying institution. “[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Fintiv* at 12. The invalidity arguments raised in this IPR can also be asserted in the District Court litigation because, critically, Petitioners did not stipulate that they would not raise in the District Court the same prior art invalidity defenses that it raises, or could have raised, in this Petition. Stated differently, Petitioners intentionally omitted making any stipulation that would prevent them from raising the same invalidity arguments in the District Court, *i.e.*, a *Sotera* stipulation. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential). Petitioners’ approach is designed to permit it to get two bites at the invalidity apple. That is, there is nothing preventing Petitioners from asserting in district court the same invalidity arguments are presented in the IPR petitions. Those invalidity arguments would then be raised during trial in October 2025. If Petitioners were to fail at trial, it would still have, as backup, the Final Written Decision to be issued by the Board, in June 2026 or thereafter.

Even where Petitioners offered stipulations, the Board has often denied institution in situations like the present where the other factors clearly favored non-institution. For example, in *LG Elecs., Inc. v. Ancora Techs., Inc.*, No. IPR2021-

00581, Paper 16, 9-10 (PTAB June 10, 2021), the Board denied institution despite the petitioner’s stipulation that “it will not subsequently assert invalidity in the district court on the same grounds asserted in the IPR or on the basis of the [prior art] reference, either alone or in combination with any other reference.” *Id.* Unlike Petitioners here, the petitioner in *Ancora* agreed to a blanket stipulation not to assert the primary reference under any circumstance. The Board there agreed with the patent owner that, even with the petitioner’s stipulation, “there is significant overlap between the issues raised in the Petition and in the parallel district court proceeding.” *Id.* Similarly, in *Samsung Electronics Co., LTD. v. California Institute of Technology*, IPR2023-00130, Paper 10 (PTAB May 4, 2023), the Board denied institution notwithstanding a stipulation it characterized as “broader to some degree than the stipulation discussed in *Sand Revolution*” because, as with this case, “the trial in the Underlying Litigation would commence several months before the expected date of our final written decision” and there had been significant investment in the litigation. *Id.*, *Samsung*, Case No. IPR2023-00130 at 16-20.

Accordingly, this factor favors the Board exercising its discretion to deny institution.

E. Factor 5 Weighs In Favor of Denial

The fifth *Fintiv* factor—whether the petitioners and the defendant in the parallel proceedings are the same parties—weighs in favor of discretionary denial.

The parties here are the same as the parties in the litigations.⁴ *Fintiv II*, 15 (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”).

F. Factor 6 Weighs In Favor of Denial

The sixth *Fintiv* factor—relating to other circumstances that impact the Board’s exercise of discretion, including the merits—weighs in favor of discretionary denial. As demonstrated in Section VI below, Petitioners’ key prior art fails to anticipate or render obvious the challenged claims. The claimed inventions operate in a fundamentally different way than the primary prior art, Avellan (EX1003) and Wannamaker (EX1006). Because this prior art is the only prior art offered for the claim limitations discussed below, and because they fails to disclose them, there is no reasonable likelihood of success, much less the “compelling merits” required to overcome the collective weight of the *Fintiv* factors. See *Fintiv I*, 15 (“if the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present”).

Petitioners themselves do not characterize their invalidity arguments as “compelling.” See Pet., 60. At most, Petitioners’ allegations essentially “point[] to its analysis under the lower §314 standard,” which the Board has held is insufficient to show a compelling invalidity challenge. *Commscope Technologies LLC, v. Dali*

⁴ The parallel litigation also includes Petitioners’ customers and an unrelated party.

Wireless, Inc., IPR2022-01242, Paper 23, 5 (precedential) (“Merely pointing to [] analysis under the lower institution standard is insufficient to demonstrate that the Petition presents a compelling unpatentability challenge.”); *see also OpenSky* at 49 (“a compelling-merits challenge is a higher standard than the reasonable likelihood required for the institution of an IPR under 35 U.S.C. § 314(a).”). Thus, this factor favors discretionary denial.

Even before the recent rescission of the June 2022 *Fintiv* memo, as summarized below the PTAB has found it appropriate to exercise its discretion to deny institution when the *Fintiv* factors were less favorable to the patent owner than are the circumstances presented here:

Factor	Instant Petition, Case No. IPR2025-00349	<i>Samsung Electronics Co. Ltd. v. Mojo Mobility Inc.</i>, Case No. IPR2023-01094	<i>AT&T Services Inc., et. al. v. Asus Technology Licensing Inc.</i>, Case No. IPR2024-01121
1	District court denied stay; reiterated October 2025 trial date	No stay sought; PO relied on 15% win rate on stay motions post-institution	Motion to stay pending
2	FWD 8 months or more after trial	FWD 6 months or more after trial	FWD 5-6 months or more after trial
3	By institution decision date, exchanged initial discovery, initial disclosures, claim construction briefing, will be complete, and <i>Markman</i> order, fact and expert discovery will be completed by	By institution decision date, opening claim construction briefs completed; <i>Markman</i> to held near institution decision date	By institution decision date, will have exchanged infringement and invalidity contentions, presented initial disclosures, engaged in fact discovery, <i>Markman</i> hearing

Factor	Instant Petition, Case No. IPR2025-00349	<i>Samsung Electronics Co. Ltd. v. Mojo Mobility Inc.</i>, Case No. IPR2023-01094	<i>AT&T Services Inc., et. al. v. Asus Technology Licensing Inc.</i>, Case No. IPR2024-01121
	institution decision date		expected to be complete
4	Petitioner did not provide any stipulation	Stipulation that Petitioner will not pursue this IPR's Grounds in the district court litigation	Stipulation that Petitioner will not pursue this IPR's Grounds in the district court litigation
5	Same parties in both proceedings	Same parties in both proceedings	Same parties in both proceedings
6	Petitioner did not argue merits were compelling; weak invalidity merits	Petitioner did not show a compelling challenge	Petitioner did not show a compelling challenge

The current case also presents a stronger argument for discretionary denial than the precedential *Fintiv* case. While there was no stay in place in *Fintiv*, here the District Court has forcefully rejected Petitioners' stay motion, explicitly condemning their three-year delay in seeking IPR and highlighting the significant prejudice to Plaintiffs. The trial timeline discrepancy is similarly pronounced—this case's eight-month gap between trial and Final Written Decision deadline exceeds *Fintiv*'s six-month gap (*Fintiv*, 4), making parallel proceedings even more wasteful of judicial resources. By the institution decision, here, the investment in district court proceedings will have reached advanced stages with comprehensive claim construction and fact and expert discovery imminently done, and a trial only four months away. In *Fintiv*, only the claim construction hearing had been completed

(*Fintiv*, 4). Most egregiously, Petitioners here have deliberately avoided any stipulation to prevent duplicative invalidity arguments, transparently seeking “two bites at the apple” in direct opposition to PTAB efficiency principles. Similarly, in *Fintiv* substantially identical prior art arguments were presented in both forums (*Fintiv*, 4). In both cases, the parties are identical across forums, eliminating any justification for parallel proceedings. Finally, as explained below, Petitioners’ invalidity case rests on prior art that demonstrably fails to anticipate or render obvious the challenged claims—Petitioners themselves don’t even claim their arguments are “compelling.” This case represents not just a routine application of *Fintiv*, but a quintessential example demanding discretionary denial to prevent abuse of the IPR process.

Accordingly, in this case, because all six *Fintiv* factors weigh in favor of discretionary denial, the Board should use its discretion to deny institution of this IPR.

VI. THE CHALLENGED CLAIMS ARE NOT ANTICIPATED BY AVELLAN OR OBVIOUS IN VIEW OF AVELLAN AND WANNAMAKER

As the Board is well aware, the petitioner in an IPR bears the burden of proving by a preponderance of evidence that each challenged claim is unpatentable. 35 U.S.C. § 316(e). Petitioner has failed to meet this burden.⁵

⁵ The deficiencies identified below are not intended to be a complete and exhaustive list of ways that the cited prior art fails to anticipate and/or render obvious the

A. Avellan Does Not Anticipate or Render Obvious The Claimed Inventions

For the claim limitation discussed below (elements 1a, 4a and 13a), Petitioners identify only Avellan as purportedly disclosing this limitation. Because Avellan does not disclose this claimed feature, Petitioners have failed to demonstrate that claims 1-6 and 13 are unpatentable.

1. The Method of Claims 1-6 and 13 Requires a Content Provider That Requests a Media Stream, Receives the Requested Media Stream, and Uses the Media Stream for Broadcast on the Broadcast Media Channel

Claims 1-6 and 13 of the '002 Patent requires, with only slight variations in the language, that a ***content provider*** (1) requests a media stream, (2) receives the requested media stream, and (3) uses the media stream for broadcast on the broadcast media channel. EX1001, 14:51-53 (“***receiving, from a content provider, a request*** for at least one media stream for playback on a broadcast media channel, wherein the at least one media stream includes a plurality of multimedia items of different types”);⁶ *id.*, 14:66-67 (“***providing*** the at least one media stream ***to the content provider for broadcast on the broadcast media channel.***”).⁷ Avellan, on the other

claimed inventions. Patent Owner identifies key differences between the claimed inventions and the cited prior art that are, by themselves, sufficient to show that there is no reasonable likelihood that Petitioners would prevail with respect to at least one of the claims challenged in the petition based on the asserted invalidity grounds, let alone that the merits of their challenge are compelling.

⁶ This limitation corresponds to Elements 1a, 4a, and 13a in the Petition.

⁷ This limitation corresponds to Elements 1f, 4f, and 13f in the Petition.

hand, is concerned with providing the end users with the requested website content with reduced latency. As such, the request for the content comes from the computer users themselves who are requesting information from the Internet for their own use as opposed to content providers (*e.g.*, cable and satellite TV operators) who are requesting information to broadcast to their subscribers. EX2006, ¶ 69.

2. Avellan's Users Request the Media

Avellan discloses that the users (*e.g.*, user computers 104) request the Internet content. Avellan discloses that “[t]he system 100 preferably has two primary modes of operation, a unicast mode to communicate unicast data using differential burst video transmission, and a broadcast mode to communicate broadcast data. Both modes are implemented at the browser 106 and/or the gateway platform 130. The unicast mode is used to send highly customized information from a single website at network 150, 152 to a single user computer 104 in real time ***as it is requested by the user.***” EX1003, 6:65-7:5; *see also id.*, 6:37-40 (“If the ***user requests a web page,*** the user computer 104 checks its local storage device 110 for the desired information.”); 6:19-25 (“The browser 106 also generates and sends commands and a tag file to the gateway server 134 so that the gateway server 134 retrieves ***the information desired by the user.***”); 9:7-10 (“Accordingly, the broadcast mode operates proactively, ***before the user requests any broadcast data,*** so that the information is immediately available for display in the browser 106 ***when the user subsequently desires to access it.***”); *see also id.*, 9:66-7:2; 10:5-13 (“By

broadcasting the broadcast data to a large number of user computers 104, the system 100 avoids having to bog down the satellite 102 (as well as the gateway server 134) with repeated *individual requests from a large number of user computers 104* for those frequently-viewed sites. Instead, those *individual requests are handled immediately at the user computer 104* itself and the requested data is retrieved from the user storage device 110.”); 13:20-23 (“FIG. 2 illustrates exemplary method steps performed by the system 100 of the present invention. First, in step 200, the system recognizes that a *web page option has been selected by a user* at the browser 106.”); EX2006, ¶ 70.

3. Avellan’s Users Receive the Requested Media

Similarly, Allevan discloses that the requested content is provided to the requesting user. EX1003, 2:8-15 (“It is a further object of the invention to broadcast information from a web server over a broadcast device *to a multitude of user computers* without loss of functionality....It is still another object of the invention to provide dedicated channels in a broadcast system, *for sending specific information to a single user computer.*”); *id.*, 7:2-5 (“The unicast mode is used to send highly customized information from a single website at network 150, 152 *to a single user computer 104* in real time as it is requested by the user.”); *id.*, 7:9-13 (“In contrast, the broadcast mode is used to send information that is accessed by a large number of users from a single website at network 150, 152 *to a large number of user computers 104.*”); *id.*, 8:14-15 (same); *id.*, 11:10-16 (“the Differential

Burst Video Communication Channel 122 is similar to the Broadcast Communication Channel 120, except that the DBVcc 122 is used *to send video data to a single user computer 104 in the unicast operational mode*, and the Bcc 120 is used *to send video data to multiple user computers 104 in the broadcast operational mode.*”); EX2006, ¶ 71.

4. Avellan’s Gateway Platform is Not a Content Provider

Petitioners assert that the claimed content provider requesting and receiving the media stream is Avellan’s gateway platform 130. Pet., 22 (“*a request* for at least one media steam *is received from a content provider, the gateway platform 130.*”), *id.*, 29 (“*the media stream is provided to* the content provider (*gateway platform 130*)...”). This interpretation is unsupported and contrary to Avellan’s teachings. EX2006, ¶ 72.

First, as demonstrated above, those skilled in the art would have understood that, in Avellan’s system, the gateway platform 130 is not requesting a media stream or receiving it for broadcast on the broadcast media stream. Indeed, it is the entity receiving the requests and providing the requested web pages to the requesting user computers. As demonstrated above, the *user computers 104 request* the Internet content and receive it. EX1003, 6:65-7:5; 6:37-40 (“If the *user requests a web page*, the user computer 104 checks its local storage device 110 for the desired information.”); 6:19-25; 9:7-10; 9:66-7:2; 10:5-13; 13:20-23 (“FIG. 2 illustrates exemplary method steps performed by the system 100 of the present invention. First,

in step 200, the system recognizes that a ***web page option has been selected by a user*** at the browser 106.”); EX1003, 2:8-15 (“It is a further object of the invention to broadcast information from a web server over a broadcast device ***to a multitude of user computers*** without loss of functionality....It is still another object of the invention to provide dedicated channels in a broadcast system, ***for sending specific information to a single user computer.***”); *id.*, 7:2-5; 7:9-13; 8:14-15; 11:10-16 (“the Differential Burst Video Communication Channel 122 is similar to the Broadcast Communication Channel 120, except that the DBVcc 122 is used ***to send video data to a single user computer 104 in the unicast operational mode***, and the Bcc 120 is used ***to send video data to multiple user computers 104 in the broadcast operational mode.***”); EX2006, ¶ 73.

Second, in contrast, those skilled in the art would have understood that that Avellan’s gateway platform (consisting of gateway server 134 and gateway cache 136) receives the request from the user computer 104, retrieves the requested content from the Internet or private cloud, captures, compresses, stores it, and provides it back to the personal computer 104. *See e.g.*, EX1003, 5:12-15 (“[o]nce the page is imaged (including any audio on the web page), the ***gateway server 134 compresses*** the image or video frame format and ***sends it to the browser 106*** via the satellite 102.”); 8:42-46 (“In the broadcast mode, ***the gateway server 134 retrieves the desired data*** from the networks 150, 152, ***captures the data*** (including audio) to a video (or image) frame format, ***compresses that video data*** and ***stores the***

compressed video data to the gateway 130 at the cache 136.”). In other words, the gateway platform is the part of Avellan’s system that, in response to a request from a user computer, obtains and creates the requested media, and provides it to the requesting users. It would be nonsensical to interpret the gateway platform as receiving a request for media content from itself, obtaining and creating the requested content, and providing it to itself. Essentially, this would render the requesting and receiving steps unnecessary and meaningless in the claimed systems and methods. EX2006, ¶ 74.

Third, in a related petition (IPR2025-00349) addressing the same limitation in related U.S. Patent No. 10,123,074, Petitioners assert that the content provider requesting the media stream is Avellan’s **broadcast device 102**: “gateway platform 130 **receives requests from broadcast device 102** for playback of at least one media stream on a broadcast channel.” IPR2025-00349, Pet., 18. Petitioners confirm their interpretation that the content provider allegedly is broadcast device 102 when, with respect to claim 9 of the ‘074 Patent (reciting “the content provider is a cable television operator or a satellite television operator”), they argue that allegedly is met because Avellan’s “broadcast device 102 can be a satellite 102.” *Id.*, 30-31. Not only does Petitioners’ own analysis undermine its current interpretation, but, as explained below, those skilled in the art also would not have understood Avellan’s broadcast device 102 to be the claimed “content provider” of the challenged claims or the claimed “satellite television operator” of claim 9. EX2006, ¶ 75.

Because the argument that the broadcast device 102 allegedly is a content provider was not made in this IPR petition even though it was made in the -349 IPR, it cannot serve as a basis for instituting this IPR. *See Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (the Board must reject any “entirely new theory of *prima facie* obviousness absent from the petition”). None the less, Patent Owner briefly addresses it here in an abundance of caution. This argument fails for the same reasons above that the identification of the gateway platform as the content provider fails, namely, broadcast device 102 is only a data transmission device that “can be any suitable broadcast medium, such as a repeater, and a satellite need not be used.” EX1003, 4:36-43, 49-52 (“the user computer 104 can be in communication with the gateway platform 130 through a repeater, which in turn communicates with a plurality of user computers 104, and a satellite 102 need not be used.”). There is no disclosure in Avellan of the broadcast device 102 or a satellite 102 requesting or receiving the multimedia stream. Even Petitioners’ own citation to Avellan makes clear that the broadcast device 102 is merely for data transmission and not a content provider broadcasting media streams to set top boxes such as cable or satellite television operators. Pet., 24 (“[o]nce the page is imaged (including an audio on the web page), the gateway server 134 compresses the image or video frame format and **sends it to the browser 106 via the satellite 102.**”). EX2006, ¶ 76.

The ‘002 Patent distinguishes between content providers and broadcast devices such as repeaters and satellites that are used only to deliver data such as Avellan’s satellite. For example, the specification explains that “[s]atellite systems are used to deliver data (e.g. TV, radio, Video-on-Demand, multimedia streams) **from a particular source (e.g. third-party content provider)** to cable head end systems or other satellite systems.” EX1001, 1:56-59. Thus, those skilled in the art would have understood that the content providers (e.g., **cable or satellite television operators**) request and receive the multimedia stream in order to broadcast to their subscribers. The requested multimedia stream is transmitted to them via satellite or other means such as repeaters, “Radio Frequency (RF) and Integrated Receiver and Decoder (IRD) technologies.” *Id.*, 1:40-45; EX2006, ¶ 77.

Petitioners’ internal contradictions stems from their tortured interpretations of Avellan to identify the claimed content provider. But because Avellan operates in a fundamentally different way and for a different purpose than the claimed inventions, it does not have the claimed content provider that (1) requests a media stream, (2) receives the requested media stream, and (3) uses the media stream for broadcast on a broadcast media channel. As such, Avellan neither anticipates nor renders obvious the challenged claims. EX2006, ¶ 78.

For at least these reasons, the Petitioners have failed to demonstrate that Avellan discloses the claimed content provider. Because these limitations are recited in claims 1-6, 13 of the challenged claims of the ‘002 patent, and because Avellan is

the only prior art identified for these claim limitations, Petitioners have not demonstrated a reasonable likelihood that they would prevail with respect to at least these claims as challenged in the petition. 35 U.S.C. § 314(a).

Accordingly, institution should be denied.

B. Wannamaker Does Not Anticipate or Render Obvious The Claimed Inventions

For the claim limitation discussed below (element 7g), Petitioners identify only Wannamaker as purportedly disclosing this limitation. Because Wannamaker does not disclose this claimed feature, Petitioners have failed to demonstrate that claims 7-12 are unpatentable.

1. The System of Claims 7-12 Requires a Monitoring System Configured to Maintain Generation of Video and Audio Files, Even in Failure Cases

Claims 7-12 recite, among other things, “a monitoring system configured to maintain generation of the video and audio files, even in failure cases.” EX1001, 16:10-11 [element 7g]. Those skilled in the art would understand that the claimed monitoring system monitors the operation of the system, *i.e.*, the ability to provide “at least one of the video content, image content and audio content to the multicast server for generating a multicast stream with MPEG encoded video and audio,” and ensures that these operations continue in the event of a failure. EX1001, 16:6-9 [element 7f]; EX2006, ¶ 79.

The specification explains how the monitoring system is able to maintain generation of the video and audio files, even in the event of a failure. In particular, with respect to FIG. 7, the specification discloses that “Monit 750 corresponds to a monitoring block that can ensure that the process running the ‘Media Parallel encoder’ keeps running at all times and does not stop upon failure.” EX1001, 8:63-66; FIG. 7. In other words, the “Mediamplify Parallel Encoder” keeps broadcasting and delivering multimedia to the content provider without disruption, even if one of the units is turned off, or there is no internet. The specification further discloses that “the multicast-01 and multicast-02 blocks contain a **‘Recording’ function 790, which is in charge or [sic of] recording the multicasting streams and recording for later use in case of failure on the system.** This operates by listening into the UDP (User Datagram Protocol) multicast address of each individual channels being broadcasted, and recording the output into a file. This file is then stored and made accessible for future use.” *Id.*, 9:55-61. With respect to FIG. 8, the specification explains that “the streamer [module] can perform functions that include...determine if unit is working in fault-tolerant mode; **playback pre-recorded audio if a failure is detected....**” *Id.*, 9:66-10:4. FIG. 8 shows that, if a backup unit detects a “multicast” as in 850, the other unit is working, and that unit will wait <Timer> time. However, if there is no multicast detected 850, the unit will checks if the caching system is alive 815, and, if not, then the system invokes other steps, including playing a pre-recorded stream; *see also id.* 10:42-45 (“In the case that there

are no ping responses, ***a timeout will trigger a failure and a pre-recorded content 820 will be played*** or sent to the multicast address and port of record.”). This monitoring system ensures that, if the process of providing video content, image content and audio content to the multicast server for generating a multicast stream with MPEG encoded video and audio is interrupted, the generation of video and audio files can continue uninterrupted, by playing, for example, pre-recorded content. FIG. 2 shows multicast-01 and multicast-02, as one being main or backup without any particular distinction, as the failure handling steps apply to both systems equally. EX2006, ¶ 80.

2. Wannamaker Does Not Disclose the Claimed Monitoring System

Petitioners fail to show that Wannamaker anticipates this limitation. *Net MoneyIN, Inc.*, 545 F.3d at 1371 (anticipation requires showing that a single reference “expressly or inherently disclose[s] each claim limitation.”). Petitioners do not argue inherency, nor could they as Wannamaker repeatedly discloses that its “fault tolerant” system operates by “restarting” the system, which the claim invention expressly avoids by claiming continuous generation of video and audio files.

Wannamaker’s system monitoring and fault tolerance addresses only general system-level detection and recovery mechanisms, not the specific operational continuity claimed in the patent. While Wannamaker does mention that its system

can “detect fatal faults” (¶ [0320]) and that the “application server monitors each software component and recovers from failure” (¶ [0103]), these passages merely describe conventional failure detection. *See e.g. See e.g. Pet.*, 63 (citing Wannamaker’s generic reference to “rerouting transactions,” “failover support,” and “redundant network components”). Critically, however, Wannamaker discloses that when addressing such failures, the disclosed solution is to telnet and manually fix the problem or restart the failed components or system. EX1006, [0103] (“The entire hardware platform can be protected by an uninterruptable power supply and surge protection. Should a power outage occur, however, ***the system is configured to restart*** at power up.”); *id.* (“The application server monitors each software component and recovers from failure according to a specified configuration. This could include ***restarting the failed component***, or ***restarting the entire system*** as necessary.”); *id.*, [0320] (“Typically, problems are detected by monitoring the OMI for server log messages. The ***operator can then telnet into the system and fix the problem, or restart the system*** through the OMI. The system is also capable of detecting fatal faults and ***restarting itself without human intervention.***”). Those skilled in the art would have understood that a manual fix or restart will not maintain the generation of video and audio files during failures. Instead, both of these will result in the interruption of the service while the component or system is being manually repaired or restarted. Because Claim 7 requires a monitoring system that specifically ensures the continuity of video and audio file generation during system

failures—not merely automatically restarting after failures occur, this distinct operational continuity focus is entirely absent from Wannamaker and fatal to Petitioners’ anticipation argument. EX2006, ¶ 81.

Accordingly, for this reason, Petitioners have failed to show that claims 7-12 are anticipated by Wannamaker.⁸

VII. CONCLUSION

For the reasons stated herein, Patent Owner respectfully requests that the Board deny institution.

Dated: March 20, 2025

Respectfully submitted,

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⁸ Petitioners’ reliance on its expert is of no help. Pet., 62-63. The cited expert declaration merely repeats, verbatim, the same arguments in the petition. EX1007, ¶ 183. The declaration then concludes, with no further explanation or evidence demonstrating how Wannamaker discloses the claimed operational continuity, that “Wannamaker teach[es] the claimed monitoring system configured to maintain generation of video and audio files, even in failure cases.” *Id.*, ¶ 184. This is precisely the type of unsupported, *ipse dixit* from an expert that has been found insufficient to establish obviousness. *TQ DELTA, LLC v. Cisco Systems, Inc.*, 942 F. 3d 1352, 1362 (Fed. Cir. 2019).

CERTIFICATE OF WORD COUNT

The undersigned certifies pursuant to 37 C.F.R. §42.24(d) that the foregoing Patent Owner's Preliminary Response to Petition for *Inter Partes* Review of U.S. Patent No. 10,524,002, excluding any table of contents, table of authorities, grounds for standing under §42.104, §42.204, or §42.304, mandatory notices under §42.8, certificates of service or word count, or appendix of exhibits of claim listings, contains 10,079 words according to the word-processing program used to prepare this paper (Microsoft Word).

Dated: March 20, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was served electronically via electronic mail on March 20, 2025 on the following counsel of record for Petitioners:

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