

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Google LLC,
Petitioner,

v.

Withrow Networks Inc.,
Patent Owner

Case No. IPR2025-00775
U.S. Patent No. 10,771,849

**PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW OF
DECISION GRANTING INSTITUTION**

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I. INTRODUCTION

Pursuant to 37 C.F.R § 42.75(a), Withrow Networks, Inc. (“Withrow” or “Patent Owner”) respectfully requests Director Review of the institution decision in IPR2025-00775 (the “Decision”) concerning U.S. Patent No. 10,771,849 (“the Patent”). Withrow requests the Director reverse the Decision and decline to institute this IPR.

Withrow and Google LLC (“Google” or “Petitioner”) have been embroiled in patent litigation since May 2024. The dispute concerns Withrow’s technology for multimedia transmission and playback on mobile clients, enabling smooth, continuous video streaming across the internet through dynamic adaptation of media quality levels and optimized decoding techniques, resulting in improved user experience even under fluctuating network conditions.

Google sought *inter partes* review of Patent claims 1-9 (“Petition”). Withrow opposed the request in its Patent Owner Preliminary Response (“POPR”) on the ground that Google’s asserted references Carmel (Ex. 1003) and Mattavelli (Ex. 1004), either alone or in combination, fail to disclose two intertwined limitations that appear in every independent claim: (1) “such that fluidity, video quality and audio quality are maintained,” and (2) “by utilizing optimized decoding processes to maintain quality playback.” Decision at 23.

The core issue in this request for Director Review is the relationship between the two aforementioned claim terms as described in Withrow’s POPR. Specifically, the independent claims recite that “fluidity, video quality and audio quality are maintained by” three operations: (1) “selecting a plurality of said multimedia objects that reflect available network bandwidth”, (2) “autonomously adjusting said selection and playback according to the multimedia object parameters and supplied host path identification” and (3) “by utilizing optimized decoding processes to maintain quality playback.” Ex. 1001, cl. 1. Thus, the claims require each of these operations to be performed in order to maintain fluidity, video quality and audio quality. Even if the Decision were correct that Carmel by itself discloses maintaining “fluidity, video quality and audio quality” and that Mattavelli separately discloses “utilizing optimized processes to maintain quality playback” (they do not), this combination still fails to disclose that “fluidity, video quality and audio quality are maintained ... **by** utilizing optimized decoding processes” as required by the claims. *Id.* (emphasis added).

As a starting point, the Decision errs because it relies exclusively on Carmel to satisfy the claim limitation “the multimedia player is configured to play multimedia objects in a sequence such that fluidity, video quality and audio quality are maintained” (Decision, 26-28), yet never explains how Carmel allegedly discloses maintaining the “fluidity” requirement. *Id.* Instead, the Decision conflates

the claim term “play[ing] multimedia objects in a sequence” with “fluidity” without identifying any basis for doing so. *Id.*, 26-27. Thus, the Decision’s analysis as to Carmel fails to address maintaining “fluidity” as required by the claims.

The Board’s analysis of Mattavelli also fails. The Petition cites Mattavelli as allegedly teaching the limitation “utilizing optimized decoding processes to maintain quality playback.” Petition, 45-50. But, to the extent Mattavelli discloses “optimized decoding processes,” those processes are optimized to “guarantee real-time performance” by *degrading* video and audio quality. Ex. 1004, 2309, 2312; Decision, 24-25. Thus, the very optimization that Mattavelli describes comes at the expense of video and audio quality. The Petition therefore relies on a reference that teaches the opposite of the claimed requirement: degradation rather than its maintenance.

Despite these deficiencies, the Board instituted review, finding that Carmel purportedly discloses maintaining “fluidity, video quality and audio quality” (Decision at 26–27) and that Mattavelli purportedly discloses “utilizing optimized decoding processes to maintain quality playback” (Decision at 22–23, 24–25). Withrow respectfully submits that the Decision misapprehends both the teachings of the applied art and the express claim language, warranting reversal by the Director.

II. GROUNDS FOR DIRECTOR REVIEW

Director Review is warranted at least because the Decision makes erroneous findings of material fact and erroneous conclusions of law. *See* www.uspto.gov/patents/ptab/decisions/director-review-process at 2.B; 37 C.F.R. §42.75. Specifically, the Decision (1) fails to appreciate that the plain language of the two disputed claim elements must be read together and (2) conflates its analysis of distinct claim terms that are missing from the prior art of record.

III. ANALYSIS

A. The Claims Require Maintaining Fluidity, Video Quality and Audio Quality Through Three Distinct Operations

Withrow's request for Director Review centers on the plain language of the "playing back" limitation present in all the independent claims (1, 6, and 7), of which Claim 1 is illustrative. Claim 1 (using Google's bracketed annotations) reads:

1[preamble] A method comprising:

1[a.i] receiving audio and video segments encoded in a digital encoding format and with an encoding rate; wherein, said audio and video segments are associated with object parameters and supplied host path identification to form multimedia objects;

1[b.i] requesting by a multimedia player, transmission of said multimedia objects; wherein said multimedia objects are located using http and received by said multimedia player from servers using a wireless connection;

1[c.i] playing back received multimedia objects by the multimedia player,¹ 1[c.ii] wherein the multimedia player is configured to play multimedia objects in a sequence such that fluidity, video quality and audio quality are maintained **by**

selecting a plurality of said multimedia objects that reflect available network bandwidth,

1[c.iii] autonomously adjusting said selection and playback according to the multimedia object parameters and supplied host path identification, **and by**

1[c.iv] utilizing optimized decoding processes to maintain quality playback.

Ex. 1001, cl. 1 (bracket material added in Decision, 5, reflecting the Petition's annotations; emphasis added by Withrow).

The structure of the claim demonstrates that “playing back” multimedia objects “requires a multimedia player that maintains fluidity, video quality and audio quality by performing three operations: ‘selecting...,’ ‘autonomously adjusting...,’ and ‘utilizing optimized decoding processes....’” POPR at 11. In short, “maintaining fluidity, video quality and audio quality” results from (and requires) these three

¹ The Decision uses a semicolon here, but the Patent uses a comma. Decision at 5; Ex. 1001, cl. 1.

conjunctive operations [limitations c.ii (as to “selecting”), c.iii. and c.iv, respectively].²

The above understanding of the playback limitation’s structural relationship between different elements is required by the claim’s *express* language. The claim states that “the multimedia player is configured to play multimedia objects ... such that fluidity, video quality and audio quality are maintained **by** selecting ..., autonomously adjusting ..., **and by** utilizing optimized decoding processes to maintain quality playback.” Thus, the conjunctive “*and by*” reinforces that all three limitations are independent operations modifying the same *maintaining* function.

B. The Board Adopted Google’s Improper Interpretation

The Petition departed from the plain claim language, grouping the claimed “selecting” operation together with the “wherein” clause in limitation 1[c.ii] and separately addressing the “autonomously adjusting” and “utilizing” limitations of the “wherein” clause as independent elements 1[c.iii] and 1[c.iv], respectively. Ex. 1057, 1. This incorrect grouping suggested to the Board that maintaining fluidity and

² While the Decision addresses the clause “maintain quality playback” at the end of 1[c.iv] (Decision, 24-26), this request need not reach that analysis, as the arguments herein, alone, warrant reversal and denial of institution.

quality of video and audio only requires the “selecting” operation and not the “autonomously adjusting” (1[c.iii]) and “optimized decoding processes” (1[c.iv]):

“wherein the multimedia player is configured to play multimedia objects in a sequence such that fluidity, video quality and audio quality are maintained by selecting a plurality of said multimedia objects that reflect available network bandwidth,” (claim 1[c.ii])

Petition at 35. The Decision adopted Google’s erroneous grouping by using “the bracketed annotations provided by Google in the Petition.” *Compare* Decision at 5 (grouping the “selecting” limitation as part of 1[c.ii] *with* POPR at 10-11 (asserting that “fluidity, video quality and audio quality are maintained by” is accomplished by all three processes). In doing so, the Board erred.

Withrow’s POPR addressed the Petition’s error, repeatedly arguing that these three processes contribute to the maintaining element:

[T]he ’849 Patent ... employ[s] a novel multimedia player that maintains fluidity and quality by selecting multimedia objects that reflect available network bandwidth, autonomously adjusting selection and playback according to multimedia object parameters and supplied path identification, and using optimized decoding processes to maintain quality playback. ... These operations are performed together, and all are performed at the mobile client itself[.]

POPR at 8. This issue was again raised in discussing the claims, prosecution history, and Mattavelli. *See*, POPR at 10-11 (Claims); POPR 11-12 (Prosecution History, (citing Ex. 1008 at 589) (“the ‘multimedia player’ ... ‘is configured to play multimedia objects in a sequence such that fluidity, video quality and audio quality

are maintained’ by ‘selecting...,’ ‘autonomously adjusting...,’ and ‘utilizing optimized decoding processes to maintain quality playback’); and POPR at 23 (explaining that Mattavelli does not teach or suggest maintaining “video quality”).

Nonetheless, the Decision failed to recognize that the limitation “video quality and audio quality are maintained by” not only applies to the selecting term (1[c.ii]), but also to autonomously adjusting, and optimized decoding. Decision at 21 (discussing 1[c.iii] without referencing the limitation “fluidity, video quality and audio quality are maintained by”); Decision at 22-23 (discussing 1[c.iv] without reference to the limitation “fluidity, video quality and audio quality are maintained by”). In other words, the Decision treated both clauses in isolation and failed to recognize that none of the prior art teaches utilizing optimized decoding processes to maintain fluidity, video quality and audio quality as required by the claims. In doing so the Board erred, and the error resulted in the incorrect institution of this IPR.

C. Even Under the Most Generous Reading of the Decision, Carmel and Mattavelli Fail to Teach or Suggest the “video quality and audio quality are maintained ... by utilizing optimized decoding processes” Limitation

The Petition incorrectly proposed a compartmentalized interpretation of the claim language, where “fluidity, video quality and audio quality are maintained” was purportedly taught by Carmel (which Withrow believes is erroneous), and “utilizing optimized decoding processes to maintain quality playback” was purportedly

separately taught by Mattavelli. *Compare* Pet., 35-40 *with* Petition, 45-50. Google’s interpretation (adopted by the Board at Institution) distorts the plain language of Claim 1 because it breaks the claimed relationship between maintaining media fluidity and quality, and the processes used to accomplish it. POPR, 18-24.

The Decision at no point explains how Mattavelli contributes to maintaining the separate media stream requirements of “fluidity, video quality and audio quality.” *Compare* POPR 23-24 (describing Google’s deficient analysis as to this point) *with* Decision 24-28 (focusing exclusively on the “maintaining quality playback” clause 1[c.iv], without addressing the more fundamental “fluidity, video quality and audio quality are maintained by” language of 1[c.ii]). This is fatal to the Petition as Petitioner has the burden to demonstrate unpatentability. Decision 23; *see Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (“the burden of persuasion is on petitioner to prove unpatentability by a preponderance of the evidence.”) (internal citation omitted).

Furthermore, even generously applying the Decision’s analysis of the distinct “to maintain quality playback” clause (1[c.iv]) to the maintenance of fluidity and quality in 1[c.ii], the result is the same: Mattavelli fails. For example, the Decision accepts Google’s argument that Mattavelli’s video degradation teaches that “fluidity

or real-time continuity of playback is maintained.” Decision at 24.³ Even assuming the Decision’s analysis were correct (which it is not), Mattavelli could only potentially describe decoding processes that impact maintaining fluidity. That finding, however, comes up short in meeting the separate and required “video

³ The Decision should also be rejected because the claims are neither taught nor suggested by the prior art. For example, in finding that Mattavelli teaches or suggests “utilizing optimized decoding processes to maintain quality playback,” the Decision cites “Petition at 46 (*citing* Ex. 1004, 2309, 2312).” Decision, 24-25. Those passages from Mattavelli (Ex. 1004) state “The main rationale ... is to provide results of poorer quality when the results of the desirable quality cannot be obtained in real time” (Ex. 2309) and, “Obviously, the implementation of CGD features are not proposed to be used at their maximum degradation rate but as [a] tool able to guarantee real-time performance in [the] presence of peaks of decoding complexity or as a way to ease the scheduling problems given by temporary fluctuations of the available processing power” (Ex. 2312). Neither excerpt mentions, nor suggests, the claim concept of “fluidity.” The cited statements address quality trade-offs and processor scheduling, not fluid playback. As such, this Ground must be rejected. 37 C.F.R. § 42.104(b)(4) (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon”).

quality” and “audio quality” claim terms. In fact, the Decision concedes that Mattavelli describes the opposite of maintaining video quality by teaching its degradation in favor of real-time services. Decision at 24 (“Mattavelli teaches CGD methods that output degraded video quality”).

D. Carmel Cannot Satisfy the Limitation that “fluidity [is] maintained” as the Decision Improperly Conflates the Distinct Terms “Sequence” and “Fluidity”

The Decision’s reliance on Carmel (Ex. 1003) to satisfy the “fluidity” requirement (Decision, 26-28) is erroneous. The disputed limitation is part of a larger clause that reads, “the multimedia player is configured to play multimedia objects in a **sequence** such that **fluidity**, video quality and audio quality **are maintained**.” Ex. 1001, cl. 1[c.ii] (emphasis added). This language imposes two distinct and independent conditions: (1) playback in “a sequence,” and (2) maintenance of “fluidity” along with video and audio quality.

The Decision, however, identifies support only for the first requirement, “sequence.” Specifically, it adopts the Petition’s reliance on Carmel’s alleged disclosure of a “sequence.” Decision 26-27⁴ (*citing* Petition 37-38, Ex. 1003, 10:48-

⁴ The Decision also references Ex. 1003, 13:29-35, but that evidence is far afield and does not even explicitly or implicitly reference a sequence: “Although details of these steps have been described primarily with reference to the uploading process of

54 (“[t]ime stamps in the data stream are used to synchronize the data, so that the multimedia **sequence** is played back just as it was input at the computer”); 12:6-12 (“The shorter files 46, 48, etc., that result from the change in slice duration are more likely to reach server 36 in the proper **sequence**, without being held up by extended bottlenecks.”) (emphasis added)).

Despite relying solely on Carmel’s discussion of “sequence,” the Decision then extends that concept to meet the distinct “fluidity” limitation, asserting that “Google’s reliance on Carmel’s disclosure of playing back the multimedia data in ‘proper sequence’ appears to teach or fairly suggest the limitation ‘such that fluidity ... are maintained.’” Decision 26-27 (*citing* Petition 37-38). This conflation is legal error. *Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381-82 (Fed. Cir. 2008) (“different claim terms are presumed to have different meanings”). The claim terms “sequence” and “fluidity,” thus, are presumed to have different meanings, and the Decision offers no basis for finding otherwise.

To potentially patch the hole in the “fluidity” analysis, the Decision cites to the Petition’s discussion of Withrow’s district court complaint and its accompanying

FIG. 5, it will be understood that similar methods are applicable, *mutatis mutandis*, to the method of downloading the files from server 36 to clients 30, as shown in FIG. 6A.” Decision 28.

claim chart. Decision, 27 *citing* Petition, 39, Ex. 1055, 50-52 [Withrow’s claim chart] and Ex. 1002 [Polish Decl.], ¶181. The Decision argues that the claim chart provides “some insight into what it means to maintain ‘fluidity, video quality and audio quality,’ in the context of YouTube’s selection of different quality levels. *Id.* That analogy, however, proves nothing. The Petition merely states that “[i]n its infringement allegations in the related litigation, PO alleges that this same type of functionality satisfies this claim element.” Petition, 39.

In support, the Petition relies on unsubstantiated opinion testimony from its expert whose totality of analysis is a single paragraph that merely restates the “playing back” element:

Carmel thus teaches and render obvious “playing back received multimedia objects by the multimedia player ... such that fluidity, video quality and audio quality are maintained by selecting a plurality of said multimedia objects that reflect available network bandwidth” via these multi-level streaming teachings, in which multiple versions of a multimedia data stream (comprising slices at multiple quality levels) are provided and selected by a client (controlled by a multimedia player) based on the client’s assessment of network bandwidth availability.

Ex. 1002, ¶181. That language is then followed by a single sentence, “Patent Owner has signaled (via its infringement allegations made in its complaint) its position that such a configuration or functionality satisfies this claim element” (*id.*) pointing the reader to pages 26-28 of Withrow’s complaint chart. *Id.* (citing Ex. 1055 at Ex. 2, 26-28). Google’s expert provided no other annotations, commentary, or analysis. As

such, Google’s expert’s testimony should be given no weight. *See TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1362–63 (Fed. Cir. 2019) (reversing Board’s finding of unpatentability that was based on conclusory expert testimony.)

Thus, while Carmel’s description of data playback in “proper sequence” may relate, at most, to the claim’s “play multimedia objects in a sequence” requirement, the Decision provides no rational to then equate “sequence” with the separate claim term of “fluidity.”

IV. CONCLUSION

For the foregoing reasons, Withrow respectfully requests the Director reverse the Board’s Decision to institute IPR2025-00775.

Dated: October 10, 2025

Respectfully submitted,

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Dated: October 10, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following document was served on the Petitioner by electronic service, as authorized in Petitioner's mandatory notices, on the date below:

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