

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Google LLC,
Petitioner

v.

Withrow Networks Inc.
Patent Owner

Case IPR2025-00775
Patent No. 10,771,849 B2

**AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST OF
DECISION GRANTING INSTITUTION**

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I. INTRODUCTION

The Request for Director Review of the decision granting institution of *inter partes* review of claims 1-9 of U.S. Patent No. 10,771,849 should be denied. PO deeply mischaracterizes the Board’s decision, offers no legitimate reason for revisiting the same unsupported attorney arguments that the Board considered and properly rejected, and introduces improper new arguments that still fail to provide a basis for Director Review. The Board carefully disposed of each of PO’s arguments in its Preliminary Response—i.e., that “Carmel and Mattavelli do[] not teach limitations 1[c.ii] and 1[c.iv]—‘such that fluidity, video quality and audio quality are maintained’ and ‘utilizing optimized decoding processes to maintain quality playback.’” (Decision at 24-28.) The Board concluded that “at this stage in the proceeding, we do not agree with [PO]’s arguments.” (*Id.* at 28.)

After considering the prior art, the expert analysis provided by Google, and the arguments presented by the parties, the Board “discern[ed] no deficiency in Google’s characterization of Carmel, Mattavelli, or the general background knowledge in the art” and was “persuaded by [Google’s expert] Dr. Polish’s [unrebutted] testimony concerning the relevant disclosures in Carmel and Mattavelli.” (*Id.* at 23-24, 28-29.) The Board found there was a reasonable likelihood that Google would prevail in demonstrating at least one of the claims of the ’849

patent unpatentable and granted institution. (*Id.* at 28-29.) This decision was correct, and PO's mere disagreement is not sufficient for Director Review.

II. DIRECTOR REVIEW OF INSTITUTION DECISIONS IS SPARINGLY USED FOR LIMITED PURPOSES

Neither PTAB policy nor precedent supports Director Review of this decision. Director Review of a Board's decision on institution is "limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law." (<https://www.uspto.gov/patents/ptab/decisions/director-review-process> (§2(B)).)

None of these categories apply. PO's disagreement with the Board's detailed analysis is not an abuse of discretion. PO identifies no important issues of law or policy. And PO falls woefully short of demonstrating erroneous findings of material fact or law. If every litigant could use Director Review to rehash old ground, then the PTAB would be inundated with requests by every single litigant who lost an issue, and every panel's decision would effectively be reduced to a mere advisory opinion for subsequent Director Review. Moreover, PO improperly introduces new arguments in its Request that it did not present to the Board in its Preliminary Response, in contravention of the guidelines for Director Review.

(<https://www.uspto.gov/patents/ptab/decisions/director-review-process> (“Director Review Process”), §3(E).)¹

III. THE BOARD CORRECTLY GRANTED INSTITUTION BASED ON A FULL CONSIDERATION OF THE PRELIMINARY RECORD

After fully “[t]aking into account Withrow’s Preliminary Response,” which consisted exclusively of attorney argument, the Board correctly concluded that there is a reasonable likelihood that Google would prevail in demonstrating at least one of the claims the ’849 patent is unpatentable. (Decision at 2, 28-29.)

PO raises two primary complaints in its Request: (1) that the Decision allegedly failed to appreciate that two claim elements purportedly must be read together and (2) that the Board erred in its analysis of the asserted prior art and Google’s arguments. (*See* Request at 4.) Both complaints fail. Not only are PO’s

¹ Google understands that the Director recently issued a memorandum taking over responsibility for determining whether to institute trial of IPR and PGR proceedings in the first instance, but that “all petitions referred to the PTAB for consideration of the merits and non-discretionary considerations under the Interim Processes prior to October 20, 2025 will remain with a three-member panel.” (Memorandum at 2, https://www.uspto.gov/sites/default/files/documents/open-letter-and-memo_20251017.pdf.) Here, particularly in view of its attempts to improperly inject new arguments into the record, PO’s Request should be judged (and rejected) according to the standards for Director Review—and not permitted to be an end-run around the rules that would allow for reconsidering institution in the first instance.

critiques unsupported by any evidence, they also rest on gross mischaracterizations of the preliminary record and the Board's Decision.

A. PO fails to show any error in how the Board interpreted and presented its analysis of the disputed claim elements

PO first takes issue with a trivial organizational point. (*See* Request at 4-8.)

PO argues that the way the Petition grouped and presented certain claim elements was somehow improper and that the Board purportedly erred by “adopt[ing] Google’s erroneous grouping by using ‘the bracketed annotations provided by Google in the Petition.’” (*Id.* at 6-7.) The Director should reject this frivolous argument because it is (i) new, (ii) unsupported, and (iii) false. Indeed, it is directly contradicted by what PO previously acknowledged in its Preliminary Response.

First, PO never argued in its Preliminary Response that there was any problem with how Google grouped or organized the claim elements in the Petition or with the bracketed element identifiers that Google used as matter of convenience when presenting its analysis of claim 1. (*See* POPR, Paper 7, at 1-12, 17-24.) While the Preliminary Response asserted that “[t]he ‘playing back’ limitation requires a multimedia player that maintains fluidity, video quality and audio quality by performing three operations—‘selecting...,’ ‘autonomously adjusting...,’ and ‘utilizing optimized decoding processes’” (*id.* at 11), it never alleged that Google’s analysis of these limitations in the Petition was purportedly faulty or problematic

due to how the Petition organized or grouped these claim elements. To the contrary, PO devoted the bulk of its arguments for Ground 1 in its Preliminary Response to its assertions that Mattavelli allegedly failed to meet the “and by utilizing optimized decoding processes to maintain quality playback” limitation of claim 1 (element 1[iv]). (*Id.* at 18-23.) PO then *separately* argued that Mattavelli allegedly also failed to meet the maintain “fluidity, video quality and audio quality” limitation (element 1[ii]), purportedly for the same reasons. (*Id.* at 23-24.) If anything, the POPR thus indicated there was no issue with Google’s chosen grouping/identification of claim elements. The Board cannot be faulted for not responding to an argument (i.e., that Google’s grouping of the claim elements in the Petition was somehow problematic) that PO never made. The Director should not consider this new argument. (*See* Director Review Process, §3(E).)

Second, in addition to being improperly raised for the first time in its Request, PO’s argument that Google’s grouping of the claim 1 elements in the Petition was somehow problematic rests on an unsupported interpretation/construction of claim 1. (*See* Request at 4-6.) PO presented no evidence to support its attorney argument that a person of ordinary skill in the art would have necessarily understood claim 1 in the manner PO proposes, where claim element 1[c.iv], which separately recites “utilizing optimized decoding processes to maintain quality playback” also modifies

the “fluidity, video quality, and audio quality are maintained” portion of claim element 1[c.ii].

Third, and most importantly, even if PO’s argument was not new and these claim elements should be interpreted and organized as PO proposes, PO still fails to show error. This is so because the Board recognized that the Petition explained how Mattavelli not only satisfied the “maintain quality feedback” portion of element 1[c.iv] but also satisfied the maintain “fluidity, video quality and audio quality” portion of element 1[c.ii]. For example, the Board recognized how Google argued that Mattavelli teaches or suggests employing both video and audio optimization “because Mattavelli discusses its *goal is to respect the real-time constraints with the lowest degradation in the video/audio content.*” (Decision at 22 (citing Pet. at 48-49).)² The Board further recognized that “Google argue[d] that Mattavelli teaches CGD methods that output degraded video quality to ensure that *fluidity or real-time continuity* of playback is maintained[.]” (Decision at 22 (citing Pet. at 46, Ex. 1004, 2309, 2312).) In short, neither the Board nor the Petition committed the alleged error that PO falsely asserts. (See, e.g., Decision at 22 (citing Pet. at 48 (“Mattavelli thus teaches and renders obvious: (i) *maintaining the quality and fluidity of playback* ... via (ii) utilizing optimized decoding processes[.]”).)

² All emphasis had been added unless otherwise indicated.

In fact, in its Preliminary Response, PO explicitly recognized that the Petition contended that Mattavelli satisfied **both** the maintain “fluidity, video quality and audio quality” portion of element 1[c.ii] and the “maintain quality playback” portion of element 1[c.iv]. (See POPR, Paper 7, at 18-19 (discussing claim element 1[c.iv] and stating: “According to Petitioner, ‘Carmel in view of Mattavelli teaches and renders obvious configuring [] Carmel’s multimedia player to utilize optimized decoding processes to play multimedia objects in a sequence ***such that fluidity and video and audio quality playback are maintained.***” (quoting Pet. at 45)); see also Pet. at 33-55 (grouping all the “playback” limitations under the same sub-heading, 1[c.#]); 39 n.7 (also acknowledging, e.g., a relationship between elements 1[c.ii] and 1[c.iii]).) PO’s current argument that the Petition via its grouping of claim elements somehow failed to recognize a connection between the “utilizing optimized decoding processes” portion of element 1[c.iv] and the maintain “fluidity, video quality and audio quality” portion of element 1[c.ii] is directly contradicted by PO’s prior, express recognition of the opposite. The Director should reject PO’s disingenuous attempt to manufacture a non-existent error here by playing shell games with the “bracketed annotations provided by Google in the Petition.” (See Request at 6-8.)

B. PO's substantive critiques rest on mischaracterizations of the challenged patent, the prior art, the Petition, and the Board's Decision

PO's substantive critiques of the Board's Decision fare no better. They too are unsupported attorney argument that rest on gross mischaracterizations of the challenged patent, the asserted prior art, the Petition, and the Board's Decision.

1. The Board correctly found that the Petition demonstrated how Mattavelli taught "optimized decoding processes" that contributed to maintaining "fluidity, video quality and audio quality"

First, PO wrongly asserts that "[t]he Decision at no point explains how Mattavelli contributes to maintaining the separate media stream requirements of 'fluidity, video quality and audio quality.'" (Request at 9.) This is false.

As discussed in the previous section, PO ignores the Board's analysis on page 22 of its Decision that shows how the Petition made a connection between "to maintain quality playback" and the "fluidity, video quality and audio quality are maintained" terms and how Mattavelli teaches "optimized decoding processes" that satisfy *both* of these related claim elements. (Decision at 22 (citing Pet. at 46, 48, ("Mattavelli thus teaches and renders obvious: (i) maintaining the quality and fluidity of playback ... via (ii) utilizing optimized decoding processes[.]"), 49 (how Mattavelli's teachings are applicable to maintaining audio quality) and Ex. 1004 at 2309, 2311-12); *see also* Pet. at 45 ("Carmel in view of Mattavelli teaches and

renders obvious configuring a Carmel's multimedia player to utilize optimized decoding processes to play multimedia objects in a sequence such that fluidity and video and audio quality playback are maintained.”.) The Decision also recognizes that “Google contends that Carmel and Mattavelli are both directed to processing multimedia data playback ‘for the appreciation of a user,’ while providing the highest perceived audio and video output quality possible in view of system constraints to ensure playback continuity.” (Decision at 22 (citing Pet. at 50-51).) And, the Board “discern[ed] no deficiency in Google’s characterizations of Carmel, Mattavelli, or the general background knowledge in the art” and was persuaded by the testimony of Google’s expert “concerning the relevant disclosures in Carmel and Mattavelli.” (Decision at 23-24.)

Next, PO restates its unsupported attorney argument from its Preliminary Response that Mattavelli purportedly does not teach “maintaining” video or audio quality because it teaches methods that (potentially, temporarily) degrade video quality when necessary to maintain fluidity/real-time playback. (*See* Request at 10-11.) The Board considered and rightly rejected this argument, recognizing Google’s position that fluidity, video quality and audio quality all contribute to playback quality and that Mattavelli teaches techniques for “ensur[ing] that real-time continuity of playback is maintained, which means a viewer can enjoy watching the

multimedia stream without the stream stopping repeatedly.” (Decision at 24-25 (citing Pet. at 46 and Ex. 1004 at 2309, 2312); *see also* Pet. at 45, 48-51.) The Board properly concluded “[o]n this preliminary record, Mattavelli appears to teach or fairly suggest the notion of maintaining quality playback.” (Decision at 25.) PO’s mere disagreement with this conclusion does not warrant Director Review.

Further, to the extent that PO was or is suggesting that “maintain[ing]” fluidity and video or audio quality, as recited in the challenged claims, cannot include or encompass *any* reduction in *any* of these qualities—regardless of for how long, for what reason (such as fluctuations in available network bandwidth or decoding resources), or for what purpose (such as preserving fluidity of the playback at the expense of other aspect(s) of playback quality)—such a position is inconsistent with the ordinary meaning of this term in view of the specification. The ’849 specification provides, for example:

In a third aspect, the invention provides **novel optimizations for digital video decoding**. Some of these optimizations can then be used by an expert assessment process, whereby, the decoder maintains a state information list of **short-cuts**, related to perceived frame rate in a sorted list starting with those that will decrease output quality the least, **to those that will decrease output quality the most but have the most impact on decoding speed**. The *client player-decoder dynamically adjusts* how many shortcuts must be taken. These short-cuts are

specifically designed to drastically reduce the number of computations necessary at certain critical steps in the video decoding process *at the cost video output quality*. This allows the video decoder to scale in complexity based on the processing power of the device being used. It also allows users to experience multimedia playback despite the limitations of the device they may be using.

(EX1001, 4:7-23.) Indeed, prior to the district court case being stayed, PO identified this passage from the specification as supporting its plain and ordinary meaning proposed construction of the “***maintain*** quality playback” term in the litigation. (EX1070 at p.010.) PO’s critique of the Petition is thus inconsistent with the ’849 specification and PO’s claim construction position in the district court.³

The Board thus did not err in rejecting PO’s unsupported, incorrect claim construction-based argument and finding that “[o]n this preliminary record, Mattavelli appears to teach or fairly suggest the notion of maintaining quality playback,” which includes maintaining fluidity, video quality, and audio quality. (See Decision at 25, 22, 23 (“Google argues that a PHOSITA would have been motivated to combine the complementary teachings in Carmel and Mattavelli to

³ Google previously raised this point in rebuttal to a similar argument made in PO’s Request for Discretionary Denial. (See Paper 6 at 15 (PO Request for DD); Paper 8 at 28-29 (Google Opposition); Paper 10 (Director’s denial of PO’s DD request).)

create a more robust streaming system that addresses both bandwidth constraints and client processing limits to provide a best possible playback experience.” (citing Pet. at 52, 53-54 (Mattavelli’s techniques facilitate use of more efficient compression techniques, thereby enabling and maintaining *higher* quality playback) & Ex. 1002 (Google expert’s declaration), ¶¶ 212-215)); *see also* Pet. at 45-46, 48-50, 50-51.)

2. The Board correctly found that the Petition demonstrated how Carmel taught techniques for maintaining “fluidity, video quality and audio quality”

Second, PO also mischaracterizes the Board’s Decision when asserting that it identifies support from Carmel only for the “sequence” portion and not for the “fluidity” portion of the claim term that provides: “the multimedia player is configured to play multimedia objects in a **sequence** such that **fluidity**, video quality and audio quality **are maintained**.” (Request at 11-14 (emphasis in original).) This too is false. The Decision identifies multiple instances where the Petition describes how Carmel satisfies not only the “sequence” limitation but also the “fluidity” limitation as well (among the other limitations of the challenged claims).

As an initial matter, PO never argued in its Preliminary Response that the Petition purportedly failed to show that Carmel satisfied the “fluidity” limitation. Rather, PO’s argument against the Carmel-Mattavelli combination proposed in Ground 1 was limited to the alleged deficiencies of *Mattavelli* with respect to the “maintain quality playback” and “fluidity, video quality and audio quality are

maintained” terms (which are/were wrong for the reasons discussed in the section above). (See POPR, Paper 7, at 18-24.) Again, the Board cannot be faulted for failing to address and respond to an argument PO never made, and the Director should dismiss this new argument raised for the first time in PO’s Request. (Director Review Process, §3(E).)

Further, PO’s argument is wrong on the merits. PO simply ignores the multiple places in the Decision where the Board identifies how Carmel satisfies the maintaining “fluidity” limitation (in addition to the “sequence” and other limitations of challenged claim 1). The Board, for example, recognized that Carmel teaches the use of time stamps “to ensure proper synchronization and proper playback” where the multimedia data is output “for the appreciation of a user so that the multimedia sequence is played back just as it was input in the computer in a proper sequence.” (Decision at 19 (citing Pet. at 35-37 and Ex. 1003, 2:1-21, 7:4-8, 7:18-31, 10:48-54, 12:6-12).) The Board further recognized that Carmel teaches making multimedia data available at multiple quality levels such that a client player can select a quality level appropriate for the available bandwidth, with lower quality slices having a smaller data volume, thus being appropriate for transmission “over a lower bandwidth data link, *while maintaining the required slice timing indicated by time stamps.*” (Decision at 20 (citing Pet. 37-40 and Ex. 1003, 7:35–41 (“[C]lients 30

similarly monitor the time codes as the file is received, *in order to ensure that the transmission or reception is ‘keeping up’ with the input of the data to the computer*. In the event that a lag is detected, steps are taken to increase the data transmission or reception rate[.]”), 8:42–9:9, 10:64–11:9, Fig. 3D); *see also* Decision at 27 (discussing Carmel’s time stamp teachings); Pet. at 39-40 (Carmel “repeatedly emphasizes seeking to match the bitrate/data rate of the multimedia slices with the available network bandwidth for download (and upload) *so as to avoid lag and maintain fluidity of the multimedia playback at the best possible/practicable quality.*”).) PO takes a shorthand reference (“proper sequence”) used by the Board and divorces it from this context to falsely suggest that the Board’s findings and the Petition’s arguments concerning Carmel were limited just to the “sequence” portion and not the “fluidity” portion of claim element 1[c.ii]. The Director should not entertain such a misrepresentation of the facts.

Indeed, the Board also credited Google’s argument that PO alleged in the related district court litigation that the same type of functionality taught by Carmel (i.e., selecting an initial quality level for audio and video based on multiple versions of each stream that fit available bandwidth) “satisfies the limitation ‘*fluidity*, video quality and audio quality are maintained by selecting a plurality of objects that reflect available network bandwidth,’” and the Board associated this argument with its

“proper sequence” shorthand. (Decision at 20 & 27-28 (citing Ex. 1055, at pp. 050-52 (PO allegation that: “YouTube playback fluidity, video quality, and audio quality are maintained based on multiple versions of each stream that fit available bandwidth[.]”) and Ex. 1002, ¶ 181).) The Board’s assessment of this evidence was (more than) reasonable. That PO disagrees with how the Board evaluated this evidence (*see* Request at 12-14) does not establish that it was erroneous.

Moreover, PO’s assertion that Google’s expert’s treatment of this evidence was conclusory (*see id.*) is ironic, given that PO failed to present any competing expert testimony in the preliminary record and *all* of its allegations and analysis in its Preliminary Response and in PO’s present Request are unsupported attorney argument. *Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017) (“Attorney argument is not evidence.”); *Permian Glob. Inc. v. Fuel Automation Station, LLC*, IPR2023-01238, Paper 11 at 17 (PTAB Feb. 28, 2024) (instituting IPR where dispute that petition’s “conclusory” statement did not include “much analysis” but was “supported by unrebutted testimony” was “best resolved after further development of the record”).

IV. CONCLUSION

For the foregoing reasons, PO’s Request for Director Review should be denied.

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U.S. Patent No. 10,771,849

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. § 42.6 that a true and correct copy of **AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST OF DECISION GRANTING INSTITUTION** is being served electronically on October 23, 2025 to the e-mail addresses shown below:

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