Trials@uspto.gov
571-272-7822

Paper: 10
Entered: March 29, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLACKBERRY CORPORATION,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

Case IPR2019-00089
Patent 8,170,394 B2

Before LYNNE E. PETTIGREW, TERRENCE W. McMILLIN, and JASON W. MELVIN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

Blackberry Corporation ("Petitioner") filed a Petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 2–9 of U.S. Patent No. 8,170,394 B2 (Ex. 1001, "the '394 patent"). Maxell, Ltd. ("Patent Owner") filed a Preliminary Response (Paper 8, "Prelim. Resp.").

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows that "there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a); *see also* 37 C.F.R § 42.4(a) ("The Board institutes the trial on behalf of the Director."). For the reasons that follow, we institute an *inter partes* review as to claims 2–9 of the '394 patent on all grounds of unpatentability presented.

A. Related Matters

The parties indicate that the '394 patent has been asserted in *Maxell, Ltd. v. Blackberry Corp.*, No. 1: 17-cv-01446 (D. Del.). Pet. 2; Prelim. Resp. 1.

B. The '394 Patent

The '394 patent is titled, "Multimedia Player Displaying Operation Panel Depending on Contents." Ex. 1001, (54). The '394 patent is directed to a "digital content reproducing apparatus . . . with a plurality of user operation interfaces, e.g., a linear content operation panel and an interactive

content operation panel." *Id*. at (57) (Abstract). The apparatus "monitors information on digital contents, and upon occurrence of a change, the plurality of user operation panels are automatically and exclusively displayed in an operation panel display area." *Id*. Figures 2, 3, and 4 of the '394 patent are reproduced below.

FIG. 2

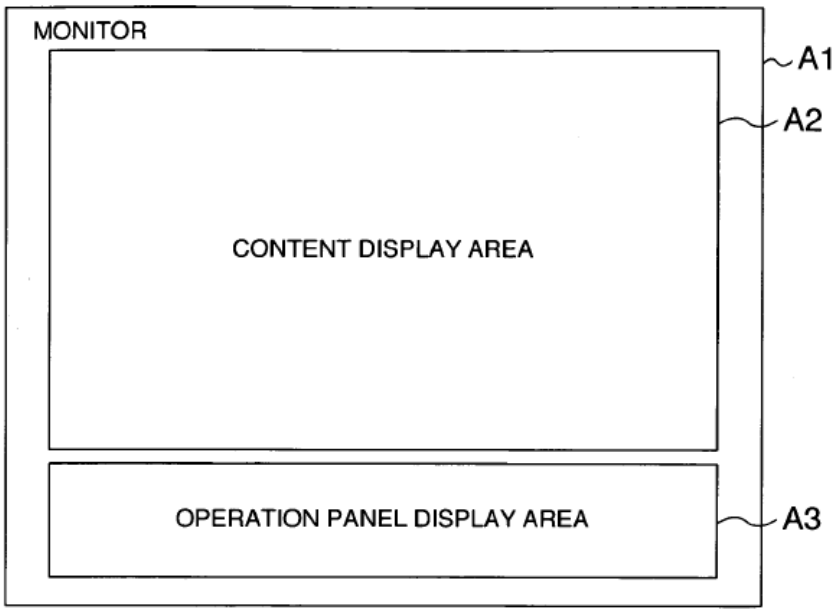


FIG. 3

FIG. 4

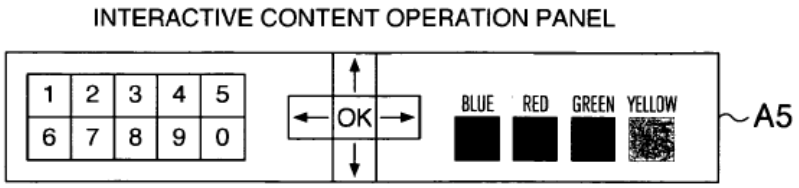


Figure 2 depicts "the layout of a screen of the apparatus;" Figure 3 depicts "a linear content operation panel of the apparatus;" and Figure 4 depicts "an interactive content operation panel of the apparatus." *Id*. at 2:45–50. As shown in Figure 2, "[a] monitor A1 has a content display area A2 and an operation panel display area A3." *Id*. at 3:44-45. "During reproduction of linear contents such as moving image contents, a linear content operation panel A4 [as shown in Figure 3] is displayed in the operation panel display area A3." *Id*. at 3:45–48. "During reproduction of interactive contents such as data broadcast contents, an interactive content operation panel A5 [as shown in Figure 4] is displayed in the operation panel display area A3." *Id*. at 3:52–54.

C. Challenged Claims

Petitioner challenges claims 2–9 of the '394 patent. Pet. 21. Independent claim 2 is illustrative of the challenged subject matter and recites:

> 2. A digital content reproducing apparatus, comprising:
>
> an input unit which inputs digital content;
>
> a reproducer which reproduces the inputted digital content;
>
> an output unit which outputs the reproduced digital content;
>
> a display which displays the outputted digital content together with an alternative display of either of a linear content operation panel allowing user-instruction regarding linear reproduction functions of the reproduced digital content or an interactive content operation panel allowing user-instruction

of interactive functions to an outside of the digital content reproducing apparatus, wherein the linear content operation panel and the interactive content operation panel are distinct panels form each other, which are not generated by a disabling of buttons; and

a controller which controls the alternative display of either of the linear content operation panel or the interactive content operation panel, wherein only one of the linear content operation panel or the interactive content operation panel is displayed exclusively at any given time, together with the outputted digital content;

wherein the outputted digital content together with either the linear content operation panel or the interactive content operation panel, are displayed concurrently in one screen.

Ex. 1001, 6:18–43.

D. Cited Art

In support of its challenges to the claims, Petitioner relies on the following references (Pet. 4–5):

U.S. Patent No. 7,293,276 B2, filed Nov. 25, 2002 (Ex. 1005, "Phillips");

U.S. Patent Application Publication No. 2005/0188408 A1, published Aug. 25, 2005 (Ex. 1006, "Wallis");

U.S. Patent No. 8,112,711 B2, filed Oct. 6, 2004 (Ex. 1007, "Ackley");

U.S. Patent No. 8,181,205 B2, filed Sep. 24, 2002 (Ex. 1008, "Russ");

U.S. Patent No. 7,073,189 B2, filed Nov. 22, 2002 (Ex. 1009, "McElhatten"); and

U.S. Patent No. 8,773,360 B2, filed Nov. 17, 2004 (Ex. 1010, "Uchida").

The earliest priority date claimed for the '394 patent is August 30, 2005, based on the filing date of a Japanese patent application. Ex. 1001, (65), 1:8–11. At least at this stage of this proceeding, Patent Owner does not challenge the prior art status of the cited references. *See generally* Prelim. Resp. For the purposes of this Decision, we determine that the cited art qualifies as prior art to the '394 patent.

E. Asserted Grounds of Unpatentability

Petitioner challenges the '394 patent on the following grounds:

claims 2, 4, 5, 7, and 8 as anticipated by Phillips;

claims 2, 4, 5, 7, and 8 as obvious in view of Phillips and Ackley;

claims 2, 4, 5, 7, and 8 as obvious in view of Phillips and Wallis;

claims 2, 3, 4, 6, 7, and 9 as obvious in view of "Phillips-based grounds" and Uchida;

claims 2, 4, 5, 7, and 8 as obvious in view of Russ and McElhatten; and

claims 2, 3, 4, 6, 7, and 9 as obvious in view of Russ, McElhatten, and Uchida. Pet. 5.

The following table summarizes Petitioner's challenges to the claims of the '394 patent.

Claims	Basis	Cited Art
2, 4, 5, 7, and 8	§ 102	Phillips
2, 4, 5, 7, and 8	§ 103	Phillips and Ackley
2, 4, 5, 7, and 8	§ 103	Phillips and Wallis
2, 3, 4, 6, 7, and 9	§ 103	"Phillips-based grounds" and Uchida
2, 4, 5, 7, and 8	§ 103	Russ and McElhatten
2, 3, 4, 6, 7, and 9	§ 103	Russ, McElhatten, and Uchida

Petitioner relies on the Declaration of Dr. Benjamin B. Bederson (Ex. 1002) to support its challenges to the claims of the '394 patent.

II. ANALYSIS

A. Claim Construction

For petitions filed before November 13, 2018,[1] we interpret the claims of an unexpired patent that will not expire before issuance of a final written decision using the broadest reasonable interpretation in light of the specification. *See* 37 C.F.R. § 42.100(b) (2016); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Consistent with the broadest

[1] The claim construction standard to be employed in an *inter partes* review recently changed. *See Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*, 83 Fed. Reg. 51,340 (October 11, 2018). At the time of the filing of the Petition in this proceeding, however, the applicable claim construction standard was set forth in 37 C.F.R. § 42.100(b), which provides that "[a] claim in an unexpired patent . . . shall be given its broadest reasonable construction in light of the specification of the patent in which it appears." 37 C.F.R. § 42.100(b) (2016).

reasonable construction standard, the challenged claims are presumed to be given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We shall construe only terms that are in controversy and then only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

linear content (operation panel)/ interactive content (operation panel)

Petitioner argues that the term "linear content" should be construed "to encompass audio or video media" and the term "interactive content" should be construed "to encompass media content where the user's selection or input drives subsequent content." Pet. 10. Patent Owner argues that the terms "linear content" and "interactive content" only appear in the challenged claims as part of the terms "linear content operation panel" and "interactive content operation panel" and that the latter terms are the proper terms to construe. Prelim. Resp. 7–11.

With regard to Petitioner's proposed constructions, we decline to construe "linear content" or "interactive content" as "to encompass media." We find no support for using the term "to encompass media" to construe the terms "linear content" or "interactive content" in the claims or Specification of the '394 patent. The Specification refers to "linear contents such as video and audio" (Ex. 1001, 1:24) and "linear contents such as moving image contents" (*id.* at 3:46–47). "Video and audio" and "moving image contents" are non-limiting examples and do not include the term "media." The Specification refers to "interactive contents such as data broadcast contents."

Id. at 3:52–53. "Data broadcast contents" is a non-limiting example and does not include the term "media." In the Petition, there is no persuasive reasoning or argument for construing these claim terms in the manner proposed. And, at least at this stage of these proceedings, we need not construe these terms in order to resolve the dispute between the parties.

With regard to that portion of Petitioner's proposed construction of "interactive content" which reads, "where the user's selection or input drives subsequent content," we also do not find any support for including this phrase in the proposed construction in the claims or the Specification of the '394 patent. In the Petition, Petitioner does not direct our attention to any intrinsic evidence that would support adding this unrecited limitation to the claims. And, we do not discern any support for doing so. Accordingly, we do not adopt Petitioner's proposed constructions of "linear content" and "interactive content."

Patent Owner proposes that we construe "linear content operation panel" as "[a] panel that provides at least functions of reproduce, stop, temporary stop, fast forward, fast backward, previous skip, next skip and similar linear reproduction functions" and "interactive content operation panel" as "[a] panel that provides at least functions of numerical keys from 0 to 9, up/down/right/left keys, a decide key, blue/red/green/yellow keys and other keys providing similar interactive functions including allowing user instructions to an outside of the apparatus with the interactive control panel." Prelim. Resp. 9–11 (citing Ex. 1001, 3:48–57, Figs. 3 and 4). However, in addition to describing the specific keys that are included in Patent Owner's proposed constructions, the Specification provides, "[t]he functions provided by the linear content operation panel A4 and interactive content operation

panel A5 are not limited to those described above, but the functions may be increased or decreased in accordance with the apparatus function." Ex. 1001, 3:60–64. As this sentence in the '394 patent explicitly provides that the operation panels are not limited to the functions or keys described or depicted in the passages and figures cited by Patent Owner, it would be improper to construe the operation panels "to provide at least" these functions or keys as proposed by Patent Owner. In addition, the phrases, "similar linear reproduction functions" and "similar interactive functions" add indefiniteness to the scope of Patent Owner's proposed constructions. And, at least at this stage of these proceedings, we need not construe these terms in order to resolve the dispute between the parties. Accordingly, we do not adopt Patent Owner's proposed constructions of "linear content operation panel" and "interactive content operation panel."

input unit/output unit

Petitioner proposes ***contingent*** constructions of "input unit" and "output unit" ***if*** the Board disagrees with the Examiner's conclusion that these terms are not means-plus-function terms. Pet. 11–12. The Petition further states, "no matter what construction of 'input unit' or 'output unit' is applied to the challenged claims, the well-known input/output structure described in the'394 patent is found in the prior art." *Id*. at 12. Patent Owner argues that these terms need not be construed, "[b]ecause these constructions are not relevant to Patent Owner's arguments." Prelim. Resp. 12–13. We need not construe these terms in order to resolve the dispute between the parties.

reproducer

The term "reproducer" appears in the limitation "a reproducer which reproduces the inputted digital content" that is recited in challenged, independent claims 2, 4, and 7. Petitioner relies on a recording or storage device as the claimed reproducer. *See* Pet. 19, 56. Patent Owner argues, "[a] 'reproducer' as claimed, however, is a device that reproduces already recorded content." Prelim. Resp. 11. Patent Owner contends that the reproducer should be limited to the combination of an input/output control unit, data extraction unit, and content decode unit as described in the Specification of the '394 patent. *Id*. at 11–12. We do not agree.

The term "reproducer" does not appear outside the claims in the '394 patent. The term "reproduces" appears outside the claims of the '394 patent only once, in the following introductory sentence to the Specification: "The present invention relates to image rendering techniques for an apparatus which ***reproduces*** digital contents multiplexing a plurality of contents having different information, and more particularly to image rendering techniques for reproduction control of digital contents by using user operation interfaces." Ex. 1001, 1:15–20 (emphasis added). However, the terms "reproducing apparatus" and "reproduction apparatus" are used throughout the Specification including use of the term "digital content reproduction apparatus" in the description of the block diagrams depicted in Figures 1, 5–7, and 9–12. Thus, the "reproducing apparatus/reproduction apparatus" described in the '394 patent includes structures outside of the structures which Patent Owner proposes to use to construe "reproducer." Therefore, we will not limit the meaning of "reproducer" as used in the claims as argued by Patent Owner.

Summary

For purposes of this institution decision, it is unnecessary for us to explicitly construe any term in the claims to resolve the dispute between the parties.

B. Legal Standards

In order for a prior art reference to serve as an anticipatory reference, it must disclose every limitation of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Anticipation "requires that every element and limitation of the claim was previously described in a single prior art reference, either expressly or inherently, so as to place a person of ordinary skill in possession of the invention." *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1082 (Fed. Cir. 2008) (citing *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1379 (Fed. Cir. 2003); *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1267–69 (Fed. Cir. 1991)). "[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102." *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008).

A patent claim is unpatentable as obvious if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness.[2] *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

"In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable." *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify "with particularity . . . the evidence that supports the grounds for the challenge to each claim")). Petitioners cannot satisfy their burden of proving obviousness by employing "mere conclusory statements." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

C. Level of Skill in the Art

With regard to the level of ordinary skill in the art, Petitioner contends, "[a] person of ordinary skill in the field of the '394 patent would have had a Bachelor's degree in computer science, electrical engineering, or a similar discipline, and one to two years of work experience in user interface design, or a related field." Pet. 6 (citing Ex. 1002 (Bederson Decl.) ¶¶ 60–62). Patent Owner does not address this issue. *See generally* Prelim. Resp. We find, based on the current record, Petitioner's contention to be

[2] Neither party presents any objective evidence of nonobviousness or any related arguments for us to consider.

reasonable, and, for purposes of this institution decision, we adopt the level of ordinary skill in the art as proposed by Petitioner.

D. Asserted Anticipation of Claims 2, 4, 5, 7, and 8 Based on Phillips

Petitioner challenges claims 2, 4, 5, 7, and 8 as anticipated by Phillips. Pet. 5, 12–33.

1. Phillips (Ex. 1005)

Phillips is titled, "Interactive Television Program Guide for Recording Enhanced Video Content." Ex. 1005, (54). Phillips discloses interactive television applications" including "the interactive television program guide application, a home-shopping application, a home banking application, a video-on-demand application, game applications, and other applications." *Id.* at 8:45–48. Figures 14–17 of Phillips are reproduced below.

FIG. 14

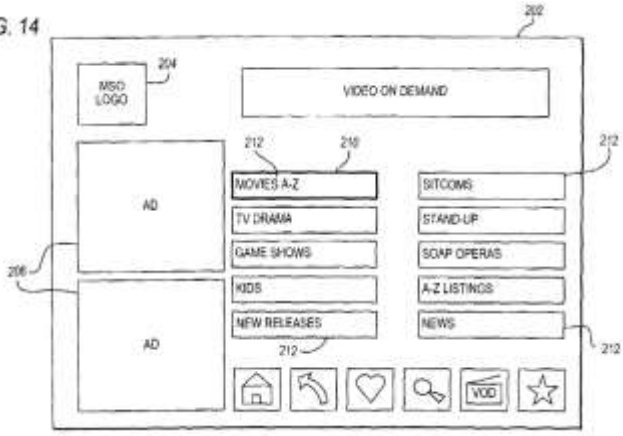


FIG. 15

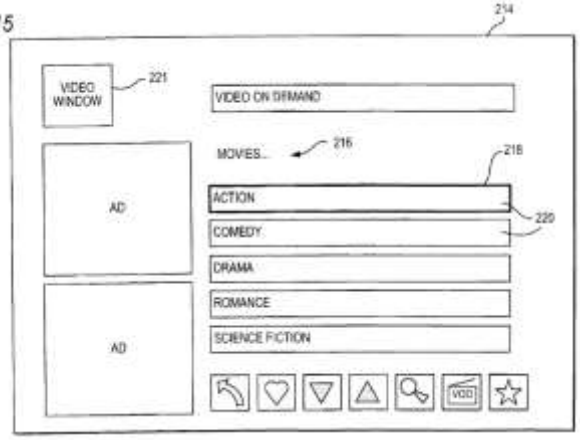


FIG. 16

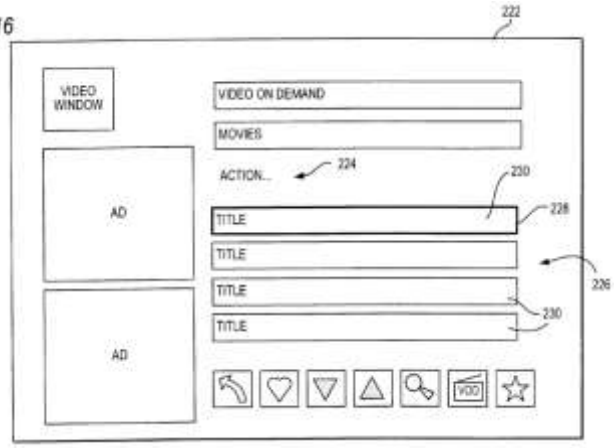


FIG. 17a

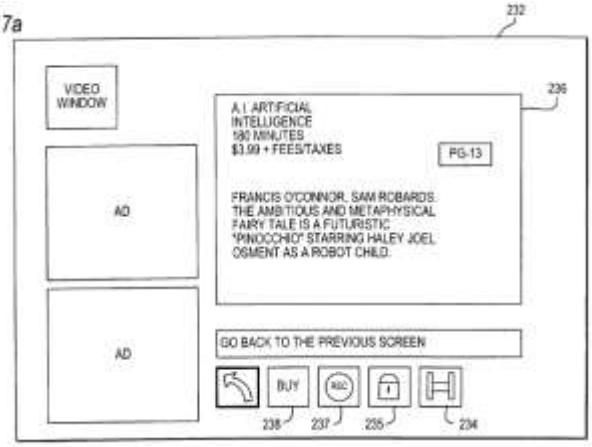
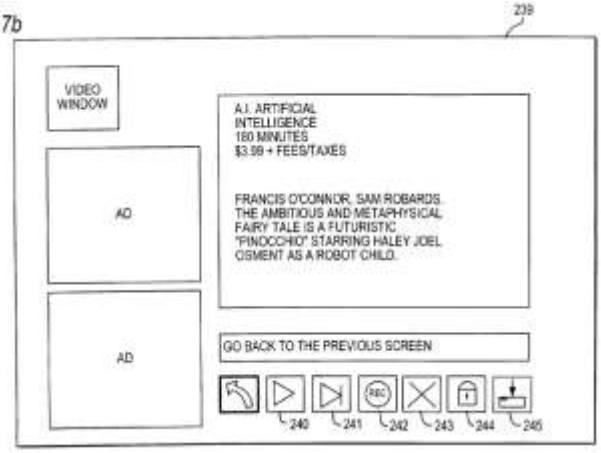


FIG. 17b



Figures 14–17 depict display screens showing interactive video-on-demand menus. *Id*. at 5:29–42. "The ordered video-on-demand content may be displayed for the user on a display screen such as video-on-demand playback screen 246 of FIG. 18." *Id*. at 20:18–20. Figure 18 of Phillips is reproduced below.

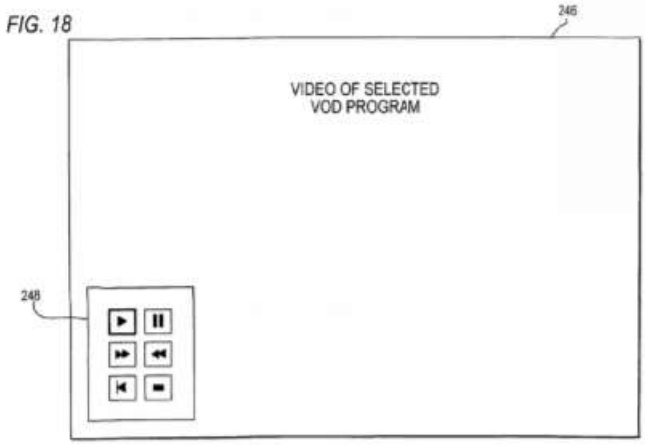


Figure 18 depicts "an illustrative display screen showing how video-on-demand playback controls may be displayed while video-on-demand content is being displayed for the user." *Id*. at 5:43–45. The description of Figure 18 states:

> As shown in the lower portion of screen 246, interactive options may be displayed in a toolbar 248 or other suitable format. The interactive options (or similar remote control buttons) may allow the user to rewind the video-on-demand content to the beginning, rewind, play, fast-forward, pause, stop delivery of the video-on-demand content, or perform other video playback options.

Id. at 20:20–27.

2. Analysis of Claims 2, 4, 5, 7, and 8

Petitioner contends that claims 2, 4, 5, 7, and 8 were anticipated by Phillips. Pet. 5, 12–33. Petitioner provides citations to the disclosure of Phillips (Ex. 1005) and the Declaration of Dr. Bederson (Ex. 1002) in support of its contention. *Id*. at 15–33.

<u>Claim 2</u>

"A digital content reproducing apparatus, comprising"

Petitioner asserts, "to the extent the preamble is limiting, Phillips discloses this limitation of claim 2."[3] Pet. 16. Figure 1 of Phillips is reproduced below.

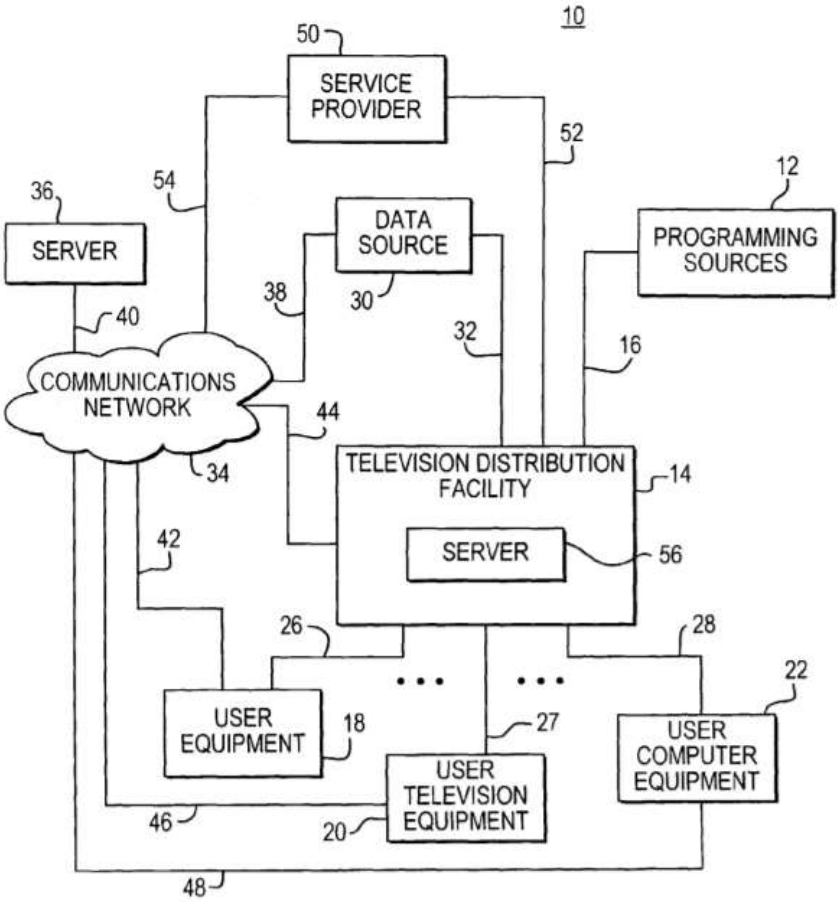


FIG. 1

[3] "[W]here a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation." *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997). The preamble of claim 2 is a statement of purpose or intended use and claim 2 otherwise appears to define a structurally complete invention. Thus, our initial determination is that the preamble of claim 2 is not limiting. However, we need not decide whether the preamble of claim 2 is limiting as we determine the Petitioner establishes the cited art teaches a digital content reproducing apparatus.

Figure 1 of Phillips depicts "an interactive television system." Ex. 1005, 4:60–61. The related description of Figure 1 of Phillips states, "[c]ontent such as television programming and digital music may be provided from programming sources 12 to television distribution facilities such as television distribution facility 14 using communication path 14" (*id.* at 6:32–36) and "[t]he user equipment may receive television and music programming and other information from television distribution facility 14 over communication paths 26, 27, and 28" (*id.* at 6:56–59). Patent Owner does not argue the preamble of claim 2.

"an input unit which inputs digital data"

Petitioner relies on the apparatus shown in Figures 2 and 6 of Phillips and the related descriptions as teaching this limitation. Pet. 16–18. Figure 2 of Phillips is reproduced below.

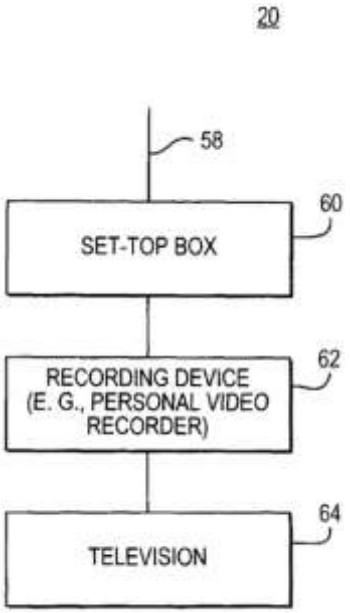


FIG. 2

Figure 2 depicts user television equipment. Ex. 1005, 4:62–63. The description of Figure 2 states, "[i]nput/output 58 may be connected to communication paths such as paths 27 and 46 [as shown in Figure 1, reproduced above]" (*id*. at 9:24–26) and "[t]elevision programming and other information may be received using input/output 58" (*id*. at 9:29–30).

Figure 6 of Phillips is reproduced below.

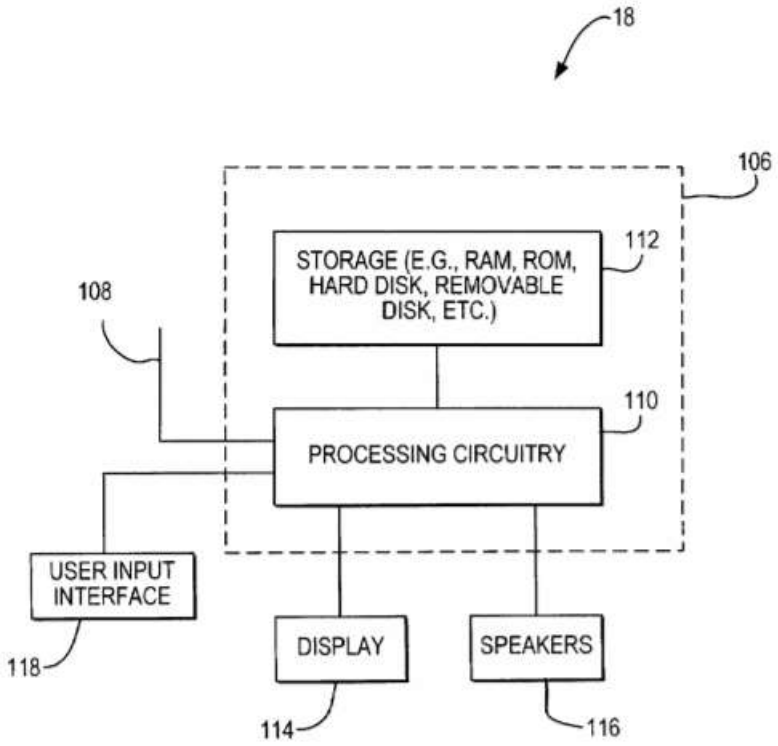


FIG. 6

Figure 6 depicts "a generalized diagram of illustrative user equipment." Ex. 1005, 5:3–4. "As shown in FIG. 6, control circuitry 106 is connected to input/output 108. Input/output 108 may be connected to one or more communication paths such as paths 26, 27, 28, 42, 46, and 48 of FIG. 1. Television and music programming may be received via input/output 108." *Id*. at 13:50–54. Patent Owner does not argue this limitation.

"a reproducer which reproduces the inputted digital content"

The Petition states, "Phillip's digital content reproducing apparatus includes a recording device to reproduce and record the inputted digital content." Prelim. Resp. 18–19. With regard to "recording device (e.g., personal video recorder) 62" shown in Figure 2, reproduced above, Phillips states:

> Recording device 62 may be used to record videos provided by set-top box 60. For example, if set-top box 60 is tuned to a given television channel, the video signal for that television channel may be passed to recording device 62 for recording on a videocassette, compact disc, digital video disk, or internal hard drive or other storage device.

Ex. 1005, 10:7–12. Phillips also states, "[t]he output of recording device 62 may be provided to television 64 for display to the user." *Id*. at 10:29–30.

Figure 3 of Phillips is reproduced below.

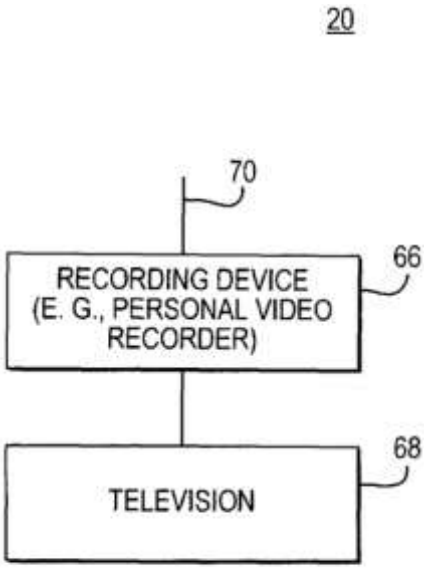


FIG. 3

Figure 3 depicts "additional illustrative user television equipment." Ex. 1005, 4:66–67. The description of Figure 3 states:

> In the example of FIG. 3, user television equipment 20 includes a recording device 66 such as a digital video recorder (e.g., a personal video recorder (PVR)) that uses a hard disk or other storage for recording video or may be a digital video disc recorder, compact disc recorder, videocassette recorder, or other suitable recording device. Equipment 20 of FIG. 3 may also include a television 68. Input/output 70 may be connected to communication paths 27 and 46 [shown in Figure 1, reproduced above].
>
> * * *
>
> Recording device 66 may also contain digital decoding circuitry for receiving digital television and music channels. . . . The hard disk and other storage in recording device 66 may be used to support databases (e.g., program guide databases or interactive television application databases). The hard disk or other storage in recording device 66 may also be used to record video such as television programs or video-on-demand content or other content provided to recording device 66 over input/output 70.

Id. at 10:41–11:5

Figure 6, reproduced above, shows "storage (e.g., RAM, ROM, hard disk, removable disk, etc.) 112" which is part of the control circuitry 106. The "storage" is connected to "processing circuitry 110" which is connected to "display 114" and "speakers 116." Ex. 1005, 13:50–14:23. The control circuitry 106 may include tuning circuitry such as digital video circuitry. *Id*. at 14:5–9. "The tuning and encoding circuitry may be used by the user equipment to receive and display or play or record a particular television or music channel or other desired audio and video content (e.g., video-on-

demand content or requested network-based or local video recorder playback)." *Id*. at 14:11–16.

Patent Owner argues that Phillips does not disclose a "reproducer" as recited in the claims of the '394 patent. Prelim. Resp. 16–17. Specifically, Patent Owner argues:

> [T]he claimed reproducer reproduces content that is already recorded. The claimed "reproducer" is not simply a recording device. As explained in the '394 Patent, the input/output control 2, data extraction unit 4, and content decode 6 all function as a reproducer for reproducing the inputted digital content. Petitioner fails to apply this construction of "reproducer" to all of its proposed grounds.

Id. This argument fails for at least two reasons. First, it is based upon Patent Owner's proposed construction of "reproducer," which we have not adopted.[4] Second, Patent Owner fails to explain why the recording devices and related equipment disclosed in Phillips are not "a reproducer which reproduces the inputted digital content" as recited in the independent claims of the '394 patent. Contrary to Patent Owner's argument, Phillips clearly and repeatedly discloses apparatuses including recording devices and other equipment that reproduces inputted digital content.

---

[4] Even if we were to adopt Patent Owner's proposed construction for this limitation, Phillips discloses an apparatus which functions to reproduce inputted digital content and is substantially the same and equivalent to the structure disclosed in the '394 patent that Patent Owner contends performs this function.

"an output unit which outputs the reproduced digital content"

The Petition states, "Phillips explains that the 'output of *recording device 62* may be provided to television 64 for display to the user [as shown in Figure 2]" and '[a]dditionally, Phillips's processing circuitry controls the output of the reproduced digital content to display 114 [as shown in Figure 6]. Pet. 19–20 (citing Ex. 1005, 10:29–39, 14:5–23). Patent Owner does not argue this limitation.

"a display which displays the outputted digital content together with an alternative display of either of a linear content operation panel allowing user-instruction regarding linear reproduction functions of the reproduced digital content or an interactive content operation panel allowing user-interaction of interactive functions to an outside of the digital content reproducing apparatus"

Petitioner relies on Figures 14–17 as disclosing a display with interactive content operation panels and Figure 18 as disclosing a display with a linear content operation panel. Pet. 21. The Petition presents Figure 17a, reproduced below, as showing an example of an interactive content operation panel. *Id*. at 22.

FIG. 17a

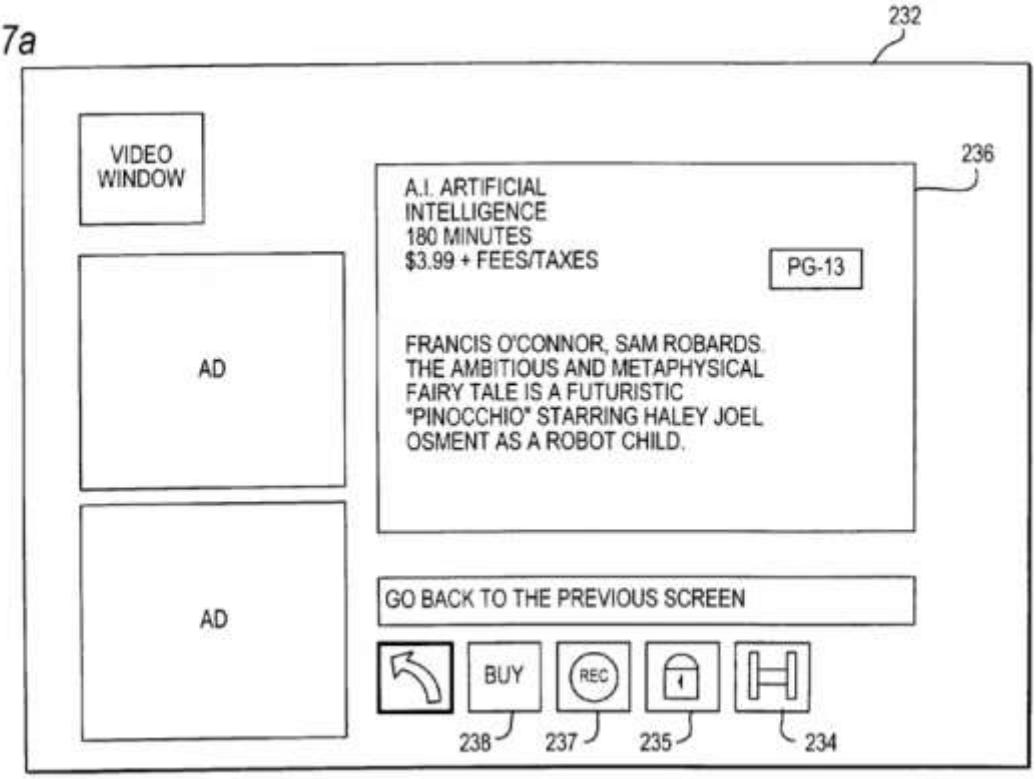


Figure 17a depicts an "illustrative video-on-demand screen[] that may be used to order and access video-on-demand content." Ex. 1005, 5:40–42. The Petition states, "in Figure 17a's interactive content screen displaying interactive VoD [video-on-demand] content, an interactive content operation panel is shown at the bottom of the screen that includes a back arrow to return to the previous screen (EX1005, 17:50-52 (describing element 174 of Figure 11)), a buy button 238, a record button 237, a parental control button 235, and a preview button 234 (EX 1005, 19:30-57.)" Pet. 21–22.

With regard to Phillips disclosing "an interactive content operation panel allowing user-instruction of interactive functions ***to an outside*** of the digital content reproducing apparatus," the Petition states, "for example, informing server 36 or 56 that the user wishes to buy the video (button 238) or wishes to view a clip of the video (button 234)." Pet. 22. Phillips states:

> Selectable options, such as options 234, 235, 237, and 238 may be provided as part of screen 232 to provide access to various interactive television application features. For example, option 238 may be selected to access options for ordering the selected video-on-demand content. Option 237 may be used to access options for recording the selected content, and option 235 may be used to access options for setting parental controls for the selected content. If the user selects option 234, the interactive television application may display a video clip containing information on the video-on-demand content of interest (e.g., a promotional video such as a preview, a trailer, a review, etc.). The video clip may be delivered to the user equipment 18 from a server such as server 36 or server 56 of FIG. 1 or from equipment at a service provider such [as] a server provider 50. The interactive television application may also provide the user with additional information on the video-on-demand content in response to the user selecting option 234. Other suitable selectable options may also be provided on screen 232 (e.g, a program package information and purchase option, options for searching program listings for related content, etc.)
>
> * * *
>
> In response to a user ordering selected content (e.g., by selecting an on-screen order option such as option 238 of FIG. 17*a*, or by using remote control 72 or any other suitable device input device 118 to order content, etc.), the interactive television application may deliver the ordered video-on-demand content to the user equipment from server such as service provider 50. The communication paths and communications network 34 of FIG. 1 may be used in delivering the requested content.

Ex. 1005, 1:37–20:17.

With regard to displaying "a linear content operation panel allowing user-instruction regarding linear reproduction functions of the reproduced

digital content," Petitioner relies on Figure 18, reproduced below, and the related disclosure. Pet. 23–24.

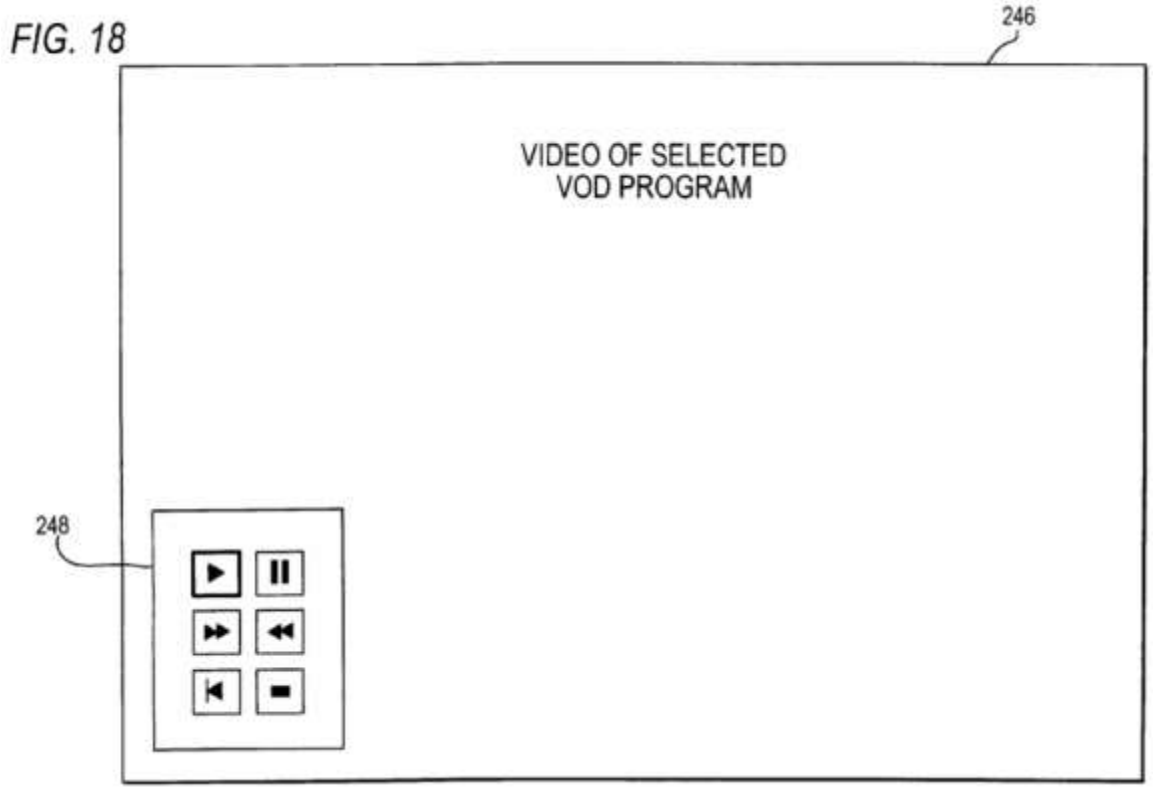


Figure 18 depicts "an illustrative display screen showing how video-on-demand playback controls may be displayed while video-on-demand content is being displayed for the user." Ex. 1005, 5:43–45. The Petition states:

> Once the user makes a selection, the selected VoD content is displayed to the user, as shown in Figure 18, with a linear content operation panel allowing "the user to rewind the video-on-demand content to the beginning, rewind, play, fast-forward, pause, stop delivery of the video-on-demand content, or perform other video playback options." (EX1005, 20:18-30; *see also* Figure 21 (22:59-23:9), Figure 27 (26:45-63).)

Pet. 23.

Patent Owner argues that Phillips fails to disclose this limitation. Prelim. Resp. 18–19. However, Patent Owner's argument rests entirely on

its constructions of "linear content operation panel" and "interactive content operation panel," which we have not adopted. *Id*. at 18 ("Because Petitioner did not properly construe the claims, Petitioner did not correctly ascertain the claims. And without ascertaining the scope of the claims, Petitioner could not have properly compared the prior art to the claims.").

"wherein the linear content operation panel and the interactive content operation panel are distinct panels from each other, which are not generated by a disabling of buttons"

Petitioner contends, "[a]s shown by comparing Phillips's Figures 17a and 18, for example, both the linear content operation panel and the interactive content operation panel are distinct operation panels, with distinct buttons and functionality, which are not generated by the disabling of buttons." Pet. 24. Patent Owner does not argue the elements of this "wherein" clause.

"a controller which controls the alternative display of either of the linear content operation panel or the interactive content operation panel, wherein only one of the linear content operation panel or the interactive content operation panel is displayed exclusively at any given time, together with the outputted digital content"

Petitioner relies on Figure 6 of Phillips, reproduced below, and the related description for disclosing this limitation. Pet. 25–26.

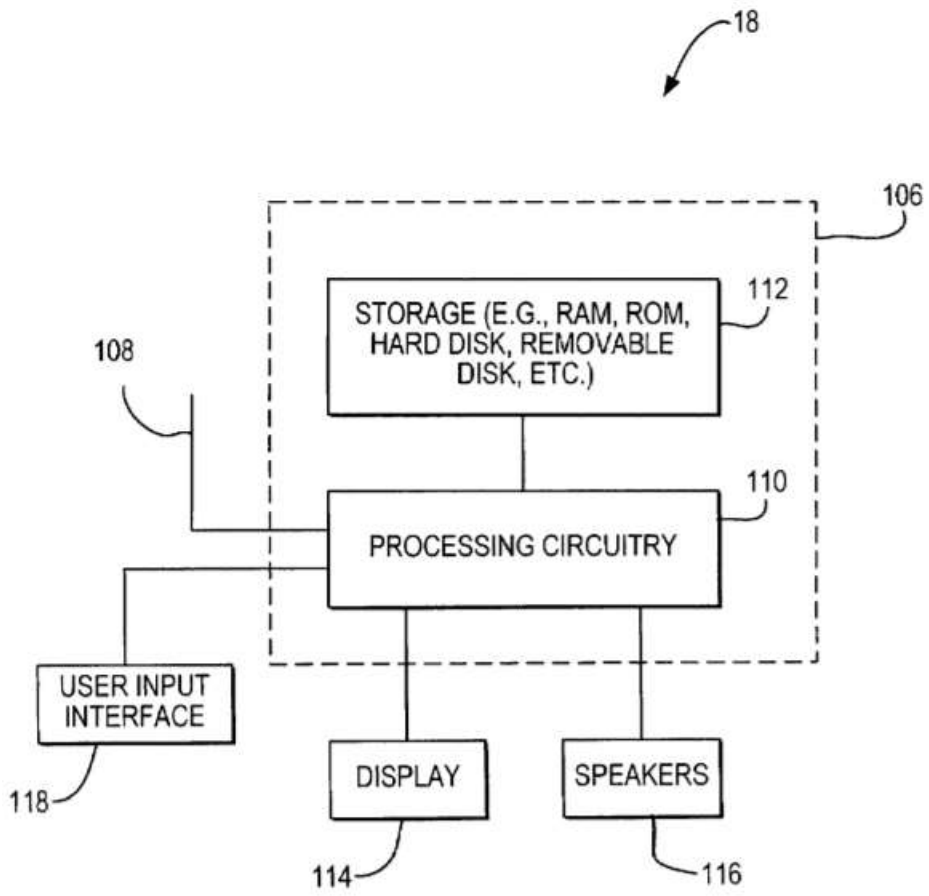


FIG. 6

Figure 6 depicts "control circuitry 106." Ex. 1005, 13:50. The related disclosure states, "[c]ontrol circuitry 106 may be based on any suitable processing circuitry 110 such as processing circuitry based on one or more microprocessors, microcontrollers, digital signal processors, programmable logic devices, etc." Ex. 1005, 13:65–14:1. As shown above, Figures 17a and 18 are examples of the alternative display of either the linear content operation panel or the interactive content operation panel which are displayed exclusively at any given time, together with outputted digital content.

"wherein the outputted digital content together with either the linear content operation panel or the interactive content operation panel, are displayed concurrently in one screen"

Petitioner again relies on Figures 17a and 18 and the related descriptions as disclosing this limitation. Pet. 27–28. The Petition states, "[f]or example, Figure 17a illustrates an interactive content screen displaying interactive VoD content (*i.e.*, outputted digital content), concurrently with an interactive content operation panel displayed along the bottom of the screen" (*id.* at 27–28) and "[a]s another example, Figure 18 illustrates a linear content screen displaying a selected VoD program—i.e., the outputted digital content—currently with a linear content operation panel in the bottom left corner of the screen" (*id.* at 28).

Patent Owner argues, "the challenged independent claims require the same digital content to be displayed with alternative, distinct operation panels. Petitioner misinterprets the claims and thus fails to demonstrate that the prior art discloses [the last 3 limitations of claim 2]." Prelim. Resp. 19. In support of this argument, Patent Owner cites the following language from claim 2: "a display which displays the outputted digital content together with an alternative of either of a linear content operation panel . . . or an interactive content operation panel," "wherein only one of the linear content operation panel or the interactive operation panel is displayed exclusively at any given time, together with the outputted digital content," and "the outputted digital content together with either the linear content operation panel or the interactive operation panel, are displayed concurrently in one screen." *See id.* at 19. These recitations from claim 2 do not support Patent

Owner's argument and are contrary to the broadest reasonable interpretation of "outputted digital content" and claim 2. Patent Owner does not cite any language from the Specification of the '394 patent in support of its argument and we discern none. To the contrary, the '394 patent discloses that the digital content can change and that the type of digital content results in different operation panels being displayed. For example, the Abstract of the '394 patent states:

> A digital content reproducing apparatus is provided with a plurality of user operation interfaces, e.g., a linear content operation panel and an interactive operation panel, a data monitor unit monitors information on digital contents, and upon occurrence of a change, the plurality of user operation panels are automatically and exclusively displayed in an operation display area.

Ex. 1001, (57). Thus, we do not find Patent Owner's argument persuasive.

Claim 4

Independent claim 4 is reproduced below with emphasis added to indicate the differences between claim 2 and claim 4. Claim 4 recites:

> 4. A digital content reproducing apparatus, comprising:
>
> an input unit which inputs digital content;
>
> a reproducer which reproduces the inputted digital content;
>
> an output unit which outputs the reproduced digital content;
>
> a display which displays the outputted digital content together with an alternative display of either of a linear content operation panel allowing user-instruction regarding linear reproduction functions of the reproduced digital content or an

> interactive content operation panel allowing user-instruction of interactive functions to an outside of the digital content reproducing apparatus, ***wherein buttons of the linear content operation panel are mutually different from buttons of the interactive content operation panel***; and
>
> a controller which controls the alternative display of either of the linear content operation panel or the interactive content operation panel, wherein only one of the linear content operation panel or the interactive content operation panel is displayed exclusively at any given time, together with the outputted digital content;
>
> wherein the outputted digital content together with either the linear content operation panel or the interactive content operation panel, are displayed concurrently in one screen.

Ex. 1001, 6:49–7:6 (emphasis added). Petitioner relies on its showing with regard to claim 2 for the limitations in claim 4 that are identical to those of claim 2. Pet. 28–30. With regard to "wherein buttons of the linear content operation panel are mutually different from buttons of the interactive content operation panel," the Petition states, "Phillips's linear content operation panel and interactive content operation panel are distinct operation panels, with mutually different buttons and functionality." *Id*. at 29. Petitioner again relies on Figures 17a and 18 and the related descriptions with regard to this limitation. *Id*. at 29–30. The Petition further states:

> For example, Figure 17a depicts an interactive content operation panel with buttons 234, 235, 237 and 238. Button 234 enables the display of a video clip containing information on the VoD content. (EX1005, 19:45-48.) Button 235 accesses options for parental controls. (EX1005, 19:43-44.) Button 237 accesses options for recording the selected content. (EX1005, 19:41-43.) Button 238 accesses options for ordering the selected VoD content. (EX1005, 19:40-41.) In contrast, the buttons of

> Phillips's linear content operation panels are mutually different from that of Phillips's interactive content operation panels, as well as individually distinctive in functionality. For example, Figure 18's linear content operation panel 248 provides the following functions: play, rewind, fast-forward, pause, stop, and rewind to the beginning. (EX1005, 20:20-30.) (EX1002, ¶¶135-140.)

Id.

Claim 5

Claim 5 depends from claim 4. Claim 5 recites, "all the buttons are mutually different from each other." Ex. 1001, 7:7–9. The Petition states, "[a]s explained above . . . the linear content operation panel and the interactive content operation panel depicted in Figures 17a and 18, for example, are distinct operation panels, with buttons that are all mutually different from each other. (EX1002, ¶¶135-140.) Phillips thus discloses each and every limitation of claim 5 and anticipates the same." Pet. 31.

Claim 7

Independent claim 7 is reproduced below with emphasis added to indicate the differences between claim 2 and claim 7. Claim 7 recites:

7. A digital content reproducing apparatus, comprising:

an input unit which inputs digital content;

a reproducer which reproduces the inputted digital content;

an output unit which outputs the reproduced digital content;

> a display which displays the outputted digital content together with an alternative display of either of a linear content operation panel allowing user-instruction regarding linear reproduction functions of the reproduced digital content or an interactive content operation panel allowing user-instruction of interactive functions to an outside of the digital content reproducing apparatus, ***wherein buttons of the linear content operation panel producing mutually differing functions from functions of buttons of the interactive content operation panel***; and
>
> a controller which controls the alternative display of either of the linear content operation panel or the interactive content operation panel, wherein only one of the linear content operation panel or the interactive content operation panel is displayed exclusively at any given time, together with the outputted digital content;
>
> wherein the outputted digital content together with either the linear content operation panel or the interactive content operation panel, are displayed concurrently in one screen.

Ex. 1001, 7:15–8:14 (emphasis added). Petitioner relies on its showing with regard to claim 2 for the limitations in claim 7 that are identical to those of claim 2. Pet. 31–32. With regard to "wherein buttons of the linear content operation panel producing mutually differing functions from functions of buttons of the interactive content operation panel," the Petition states, "[a]s shown by comparing Phillips's Figures 17a and 18, for example, both the linear content operation panel and the interactive content operation panel are composed of distinctive buttons which perform distinctive functions, none of which are the same." *Id*. at 32.

Claim 8

Claim 8 depends from claim 7. Claim 8 recites, "all the buttons of the linear content operation panel and the interactive operation panel, provide mutually differing functions from each other." Ex. 1001, 8:15–18. With regard to claim 8, the Petition states, "[a]s explained above . . . all of the buttons of Phillips's linear content operation panel and its interactive content operation panel provide mutually differing functions from each other. (EX1002, ¶¶135-140.) Phillips thus discloses each and every limitation of claim 8 and anticipates the same." Pet. 33.

Summary

After consideration of the arguments and evidence presented by the parties, we determine Petitioner is reasonably likely to show that Phillips discloses all the limitations of claims 2, 4, 5, 7, and 8, and that these claims were anticipated by Phillips.

E. Asserted Obviousness of Claims 2, 4, 5, 7, and 8 over Phillips and Ackley

Petitioner contends that claims 2, 4, 5, 7, and 8 would have been obvious in view of Phillips and Ackley. Pet. 5, 33–38. An overview of Phillips was provided above. An overview of Ackley is provided below.

1. *Ackley (Ex. 1007)*

Ackley is titled, "System and Method of Playback and Feature Control for Video Players." Ex. 1007, (54). "A media player . . . receives streams of video from different media [sources] and displays its content.

Simultaneously, and without interrupting the video playback, a user interface is overlaid on the video image." *Id*. at (57) (Abstract). Figure 1 of Ackley is reproduced below.

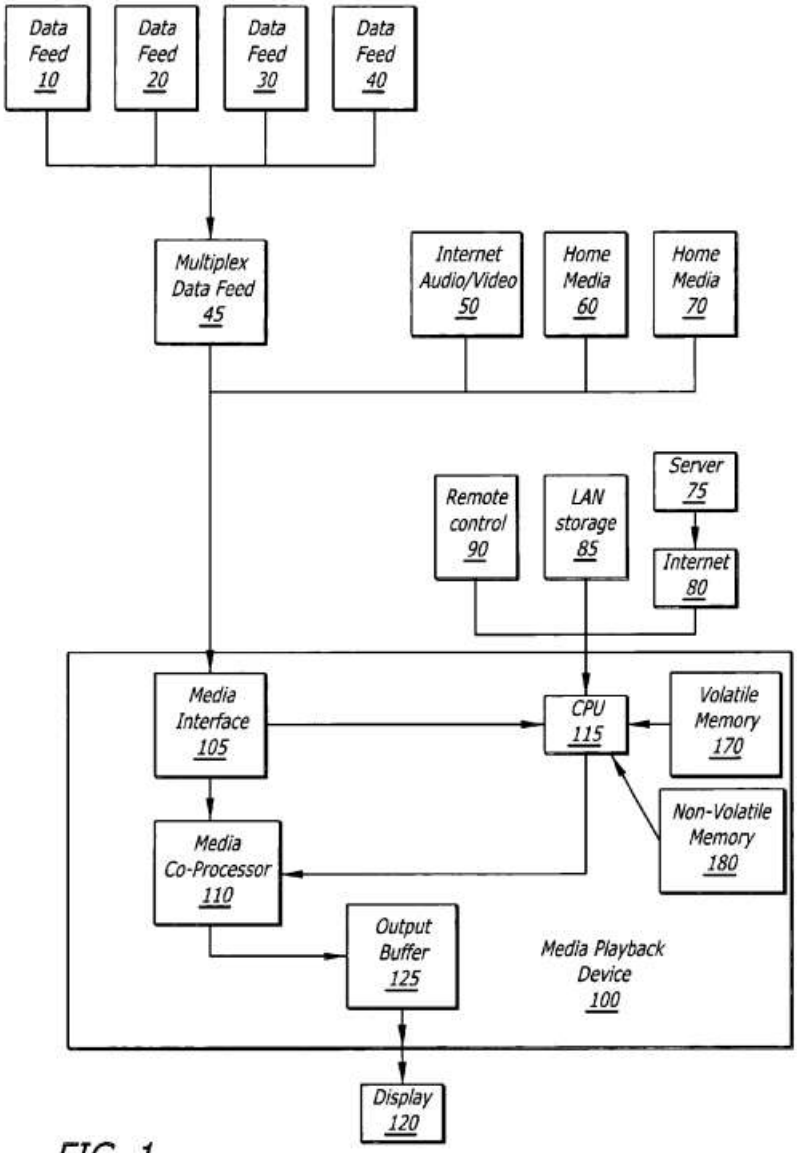


FIG. 1

Figure 1 of Ackley depicts various content sources (data feed 10, data feed 20, data feed 30, data feed 40, multiplex data feed 45, internet audio/video 50, home media 60, home media 70), media playback device 100, and display 120. "In one embodiment, the media player contains a CPU 115 and

embedded software to simultaneously display menu options and stream video to a display." *Id*. at 3:57–60. Figure 2 of Ackley is reproduced below.

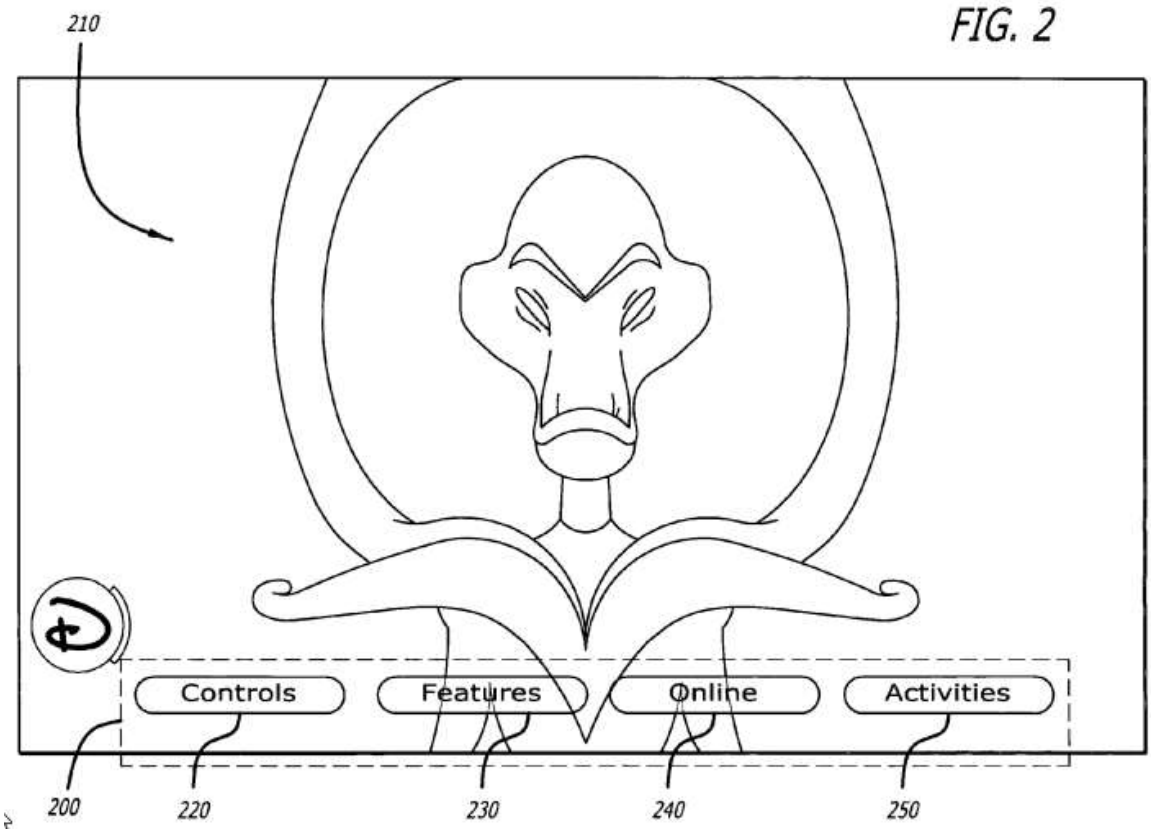


Figure 2 depicts "an exemplary screen shot illustrating the ability to operate an on-screen main menu and simultaneously view a video stream." *Id*. at 2:39–41. Figure 3 of Ackley is reproduced below.

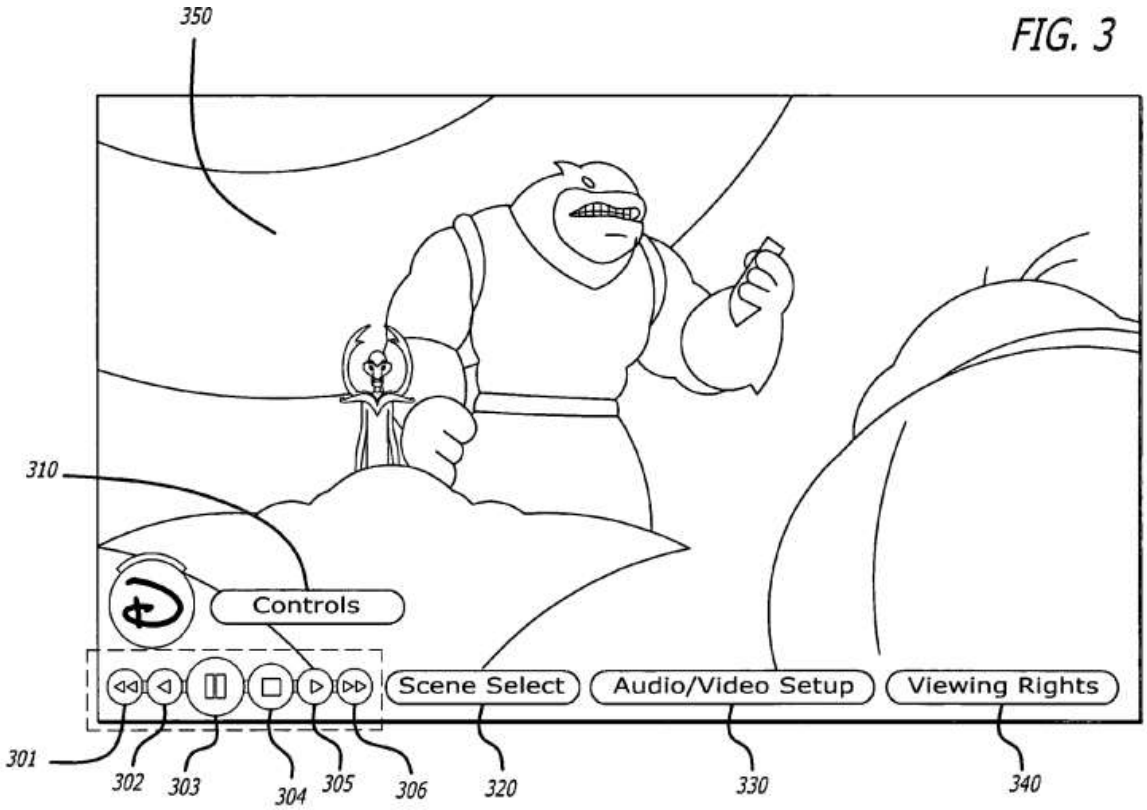


Figure 3 depicts "an exemplary screen shot illustrating the ability to operate an on-screen playback control menu and simultaneously view a video stream." *Id*. at 2:43–45.

2. *Analysis*

Petitioner contends, "[a]ll the limitations of claims 2, 4, 5, 7, and 8 are disclosed by Phillips." Pet. 33. Petitioner relies on Ackley because Patent Owner "***may argue*** for a more narrow interpretation of its claims, such that the claimed 'controller which controls the alternative display of either of the linear content operation panel or the interactive content operation panel' requires a 'dynamic' alteration of the displayed operation panel based on an assessment of the displayed data." *Id*. at 34 (emphasis added). Patent Owner does not make this argument for a more narrow interpretation of the

claims. To the contrary, Patent Owner argues that such an interpretation would be improper. Prelim. Resp. 23–24. Patent Owner does not present any additional arguments specifically related to this combination of references. *See generally* Prelim. Resp.

In view of our decision to institute on the challenge to these same claims as anticipated by Phillips, we institute *inter partes* review of claims 2, 4, 5, 7, and 8 in view of the combination of Phillips and Ackley. *See SAS Inst. Inc. v. Iancu*, 138 S.Ct. 1348, 1358 (2018) ("The statute [35 U.S.C. § 318(a)] . . . requires the Board's final written decision to address every claim the petitioner presents for review."); *see also USPTO Guidance on the Impact of SAS on AIA Trial Proceedings* (April 26, 2018) ("[I]f the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition.") ("USPTO *SAS* Guidance").

F. Asserted Obviousness of Claims 2, 4, 5, 7, and 8 over Phillips and Wallis

Petitioner contends that claims 2, 4, 5, 7, and 8 would have been obvious in view of Phillips and Wallis. Pet. 5, 38–43. An overview of Phillips was provided above. An overview of Wallis is provided below.

1. *Wallis (Ex. 1006)*

Wallis is titled, "Non-Linear Interactive Video Navigation." Ex. 1006, (54). Wallis teaches "[a] system and method for delivering interactive video and audio content items." *Id.* at (57) (Abstract). Figure 2 of Wallis is reproduced below.

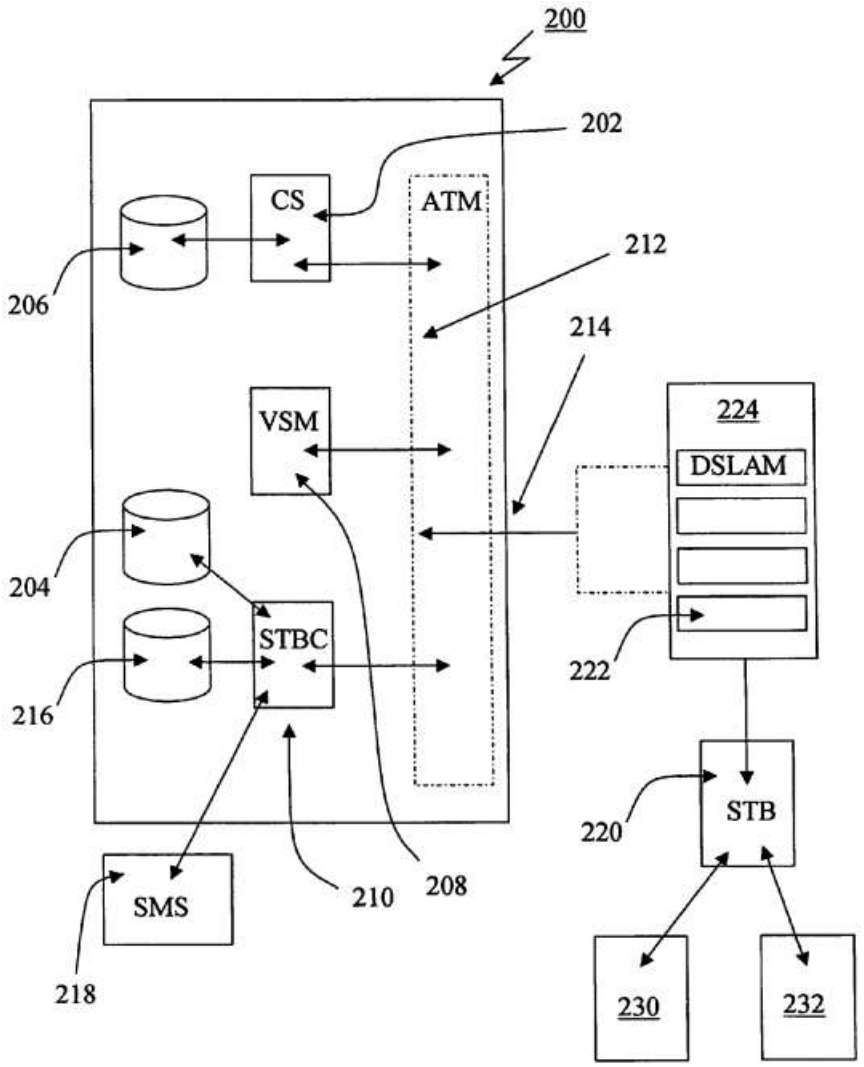


Fig 2

Figure 2 depicts "a schematic diagram of a video content delivery system." *Id.* ¶ 25. "In this figure, the STBs [set top boxes] 220 communicate with a remote video server 200." *Id.* ¶ 35. Figure 4 of Willis is reproduced below.

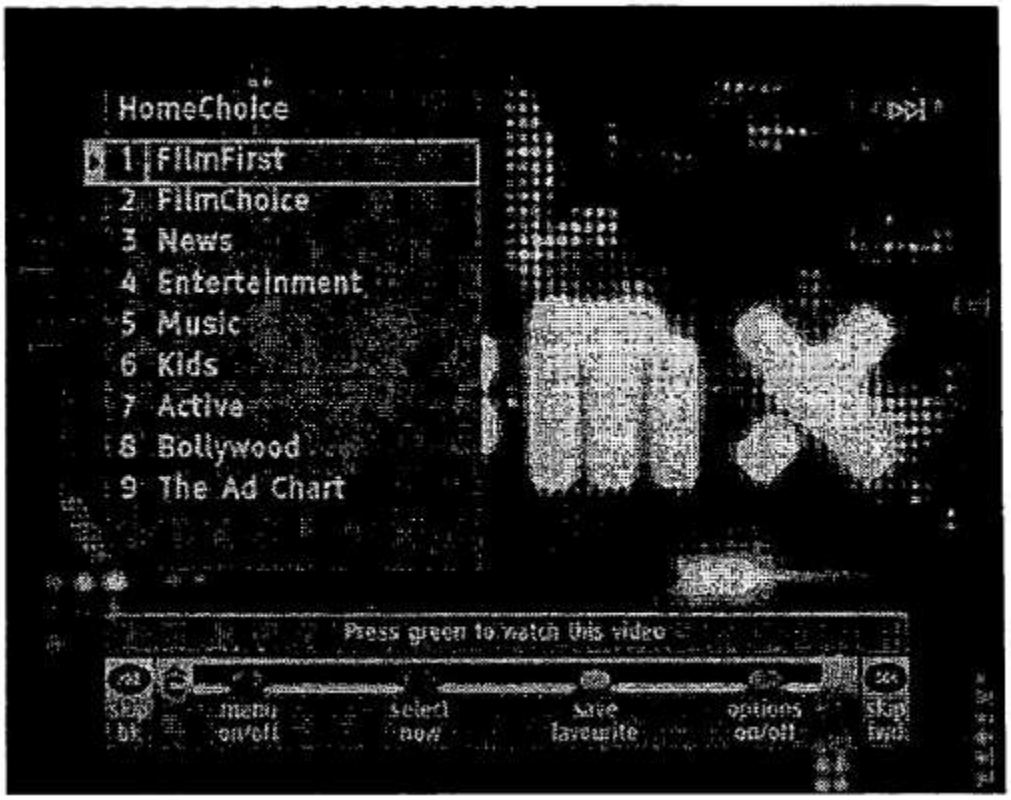


Figure 4 depicts "a snapshot of a TV display." *Id.* ¶ 27. "In FIG. 4, a screen, or graphical user interface (GUI) for interactive promotions is displayed." *Id.* ¶86.

2. *Analysis*

Petitioner's challenge to claims 2, 4, 5, 7, and 8 based on Phillips and Wallis is based on a construction of the "controller" limitation that we have not adopted. As with the previous challenge, Petitioner contends, "Phillips discloses each and every element of claims 2, 4, 5, 7, and 8 (as explained above in Ground 1)." Pet. 42–43. Petitioner relies on Wallis:

> To the extent there is a more narrow interpretation of the claim language "a controller which controls the alternative display of either of the linear content operation panel or the interactive content operation panel…," such that this limitation

> requires an assessment of the content's metadata to determine if it is linear or interactive content and then, based on that determination, display an appropriate operation panel, the combination of Phillips and Wallis renders this limitation obvious.

Id. at 38. Patent Owner does not make an argument for this more narrow interpretation of this claim language. To the contrary, Patent Owner argues such an interpretation would be improper. Prelim. Resp. 23–24. Patent Owner does not present any additional arguments specifically related to this combination of references. *See generally* Prelim. Resp.

In view of our decision to institute on the challenge to these same claims as anticipated by Phillips, we institute *inter partes* review of claims 2, 4, 5, 7, and 8 in view of the combination of Phillips and Wallis. *See SAS*, 138 S.Ct. at 1358; *see also* USPTO *SAS* Guidance.

G. Asserted Obviousness of Claims 2, 3, 4, 6, 7, and 9 over the Phillips Grounds and Uchida

Petitioner contends that claims 2, 3, 4, 6, 7, and 9 would have been obvious in view of Phillips (as well Phillips/Ackley or Phillips/Wallis) and Uchida. Pet. 5, 45–49.

1. *Uchida (Ex. 1010)*

Uchida is titled, "Display Device, Two-Way Communication System and Display Information Using Method." Ex. 1010, (54). Figure 2 of Uchida is reproduced below.

FIG. 2

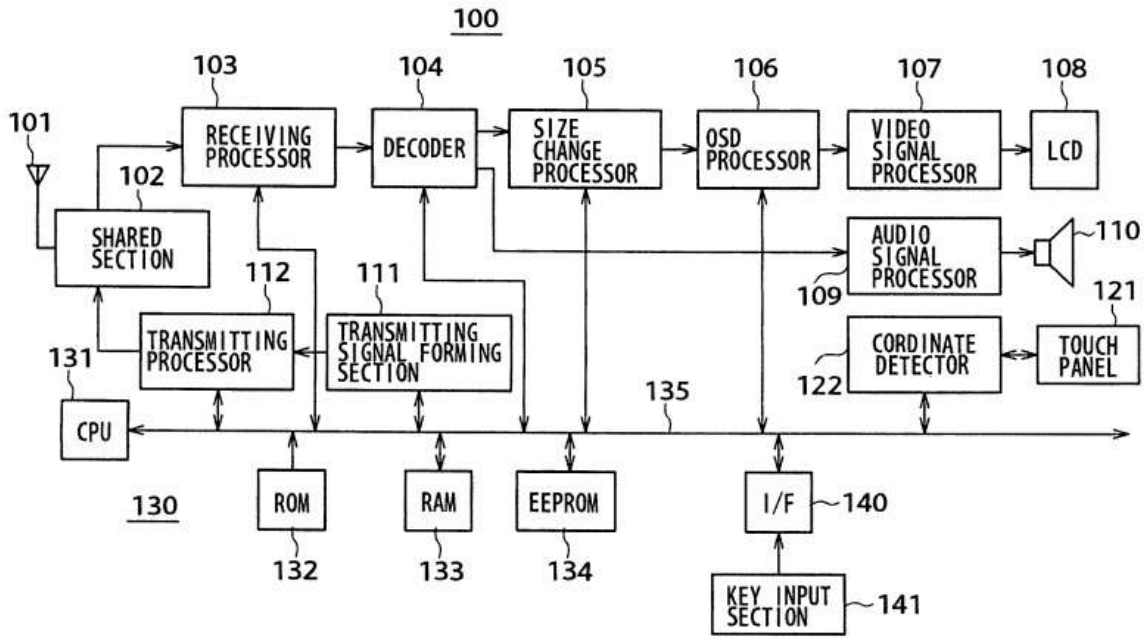


Figure 2 depicts a block diagram for a display device. *Id*. at 3:54–55.

Uchida states:

> As shown in FIG. 2, the display device 100 includes a transmitting and receiving antenna 101, an antenna shared section 102, a receiving processor 103, a decoder 104, a size change processor 105, an audio signal processor 109, a speaker 110, a transmitting signal forming section 111, a transmitting processor 112, a touch panel 121, and a coordinate detector 122.
>
> The respective sections of the display device 110 according to this embodiment are controlled by a controller 130. The controller 130 is a microcomputer having a CPU (central processing unit) 131, a ROM (read only memory) 132, a RAM (random access memory) 133, and an EEPROM (electronically erasable programmable ROM) 134 connected to each other through a CPU bus 135, as shown in FIG. 2.

Id. at 7:32–45. Figures 10A, 10B, and 10C of Uchida are reproduced below.

FIG. 10A

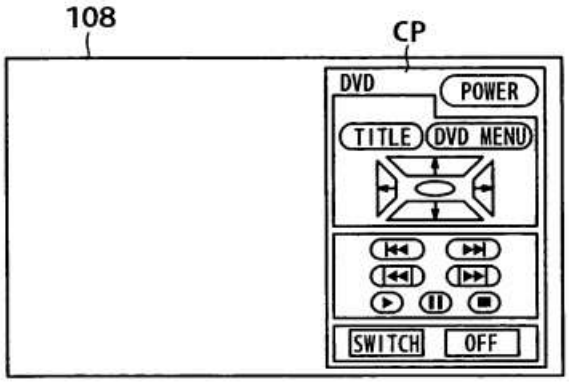


FIG. 10B

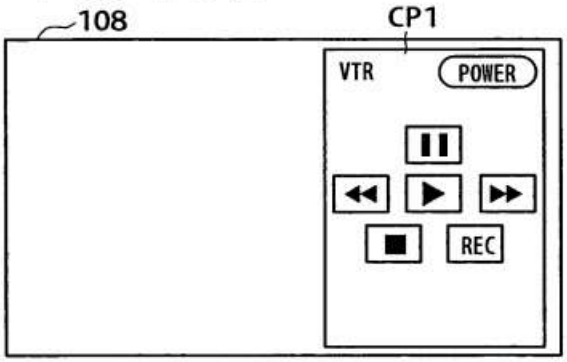
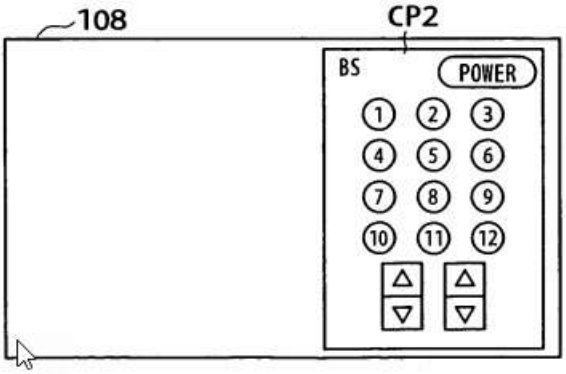


FIG. 10C



Figures 10A, 10B, and 10C depict control elements on a display. *Id*. at 4:1–3. The description of Figures 10A, 10B, and 10C provides:

> FIG. 10A is a control panel CP for the DVD device 300 which includes various operation keys such as an on/off key of a power supply, arrow keys and a decision key as described above.

> FIG. 10B is a control panel CP1 for the VTR, which has a pause key, a fast-forward key, a rewind key, a reproduction[,] key, a stop key, and a record key in correspondence with the on/off key of a power supply and the operation keys of the VTR. Also, FIG. 10C is a control panel CP2 for the BS digital tuner, which provides an on/off key of a power supply and numerical keys for channel selection.

Id. at 21:57–67. Figure 12B of Uchida is reproduced below.

FIG. 12B

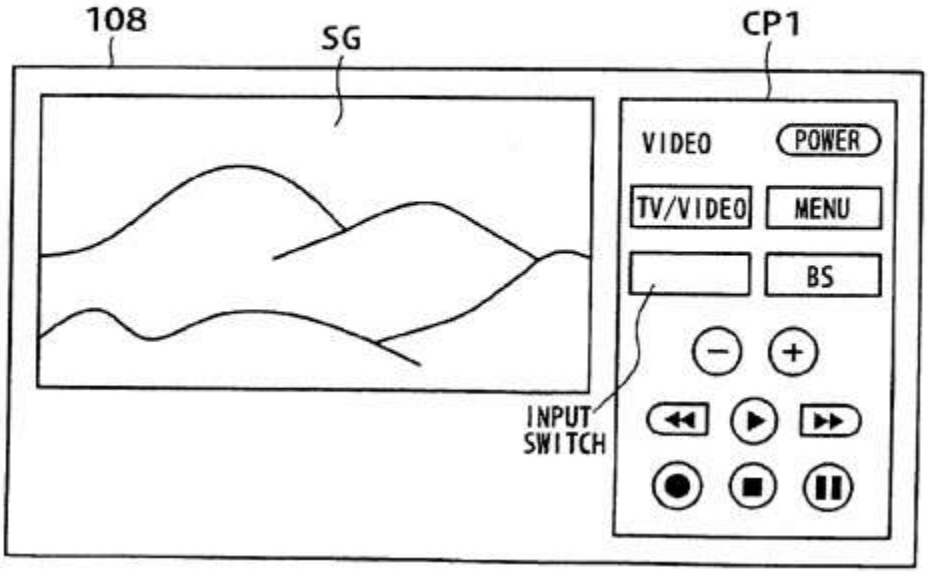


Figure 12B depicts "the display of the size-reduced main display information and the control panel." *Id*. at 4:10–11. With regard to Figure 12B, Uchida states:

> [W]hen the control panel for the VTR or the DVD device is going to be displayed, the reproduced image which is the main display information is reduced in size and displayed, and the control panel CP1 for the VTR and the DVD device is displayed for conducting operation such as reproduction stop, pause, fast forwarding, or fast rewind, as shown in FIG. 12B.

Id. at 23:24–30.

2. *Analysis*

Petitioner's showing focuses on the limitations recited in dependent claims 3, 6, and 9. Pet. 45–49. Claims 3, 6, and 9 recite, "[T]he linear content operation panel and the interactive content operation panel are common in size, and are alternatively switched between each other in a same panel rendering area of the screen as alternative operation panels." Ex. 1001, 6:44–48, 7:10–14, 8:19–23. The disclosures of Figures 10A, 10B, and 10C, and the related description (Ex. 1010, 21:54–22:23) teach switching between alternative operation panels that are common in size and are displayed in a same panel rendering area of the screen. With regard to the motivation to combine the teachings of the cited references, the Petition states:

> One of ordinary skill in the art would have been motivated to incorporate Uchida's split display with Phillips (as well as the Phillips/Ackley or Phillips/Wallis combined systems)[] to achieve the specific benefits described by Uchida—namely, ensuring that the displayed content (which may be linear or interactive content as taught by Phillips, Ackley, and Wallis) is not obstructed by an operation panel displayed on the screen. In fact, Phillips even explains that rather than overlaying its operation panels on the displayed content, "the video for the current channel may be reduced in size and the flip information … may be displayed at a location on the periphery of the reduced-sized video (e.g., at the bottom, side, or top of the reduced-sized video)." (EX1005, 16:45-50.) Thus, not only is a split screen display (and the benefits thereof) expressly disclosed by Uchida, but Phillips already contemplated and disclosed the exact implementation proposed by Petitioner's Uchida combination. (EX1002, ¶¶175-177.)

Pet. 47–48. Patent Owner does not specifically discuss this challenge to claims 2, 3, 4, 6, 7, and 9. *See generally* Prelim. Resp.

Based on the present record and in view of our determination on claims 2, 4, and 7 as anticipated by Phillips, we determine that Petitioner has shown a reasonable likelihood of establishing that the cited references teach or suggest all limitations of claims 2, 3, 4, 6, 7, and 9 and has sufficiently articulated a reason to combine, supported by a rational underpinning, the relevant teachings of the cited references. Accordingly, we institute *inter partes* review of claims 2, 3, 4, 6, 7, and 9 as obvious in view of the cited references.

H. Asserted Obviousness of Claims 2, 4, 5, 7, and 8 over Russ and McElhatten

Petitioner contends that claims 2, 4, 5, 7, and 8 would have been obvious in view of Russ and McElhatten. Pet. 5, 50–75.

1. Russ (Ex. 1008)

Russ is titled, "PVR Channel and PVR IPG Information." Ex. 1008, (54). The invention relates to personal video recording (PVR) and interactive program guides (IPG). *Id*. at 1:15–17. Figure 3A of Russ is reproduced below.

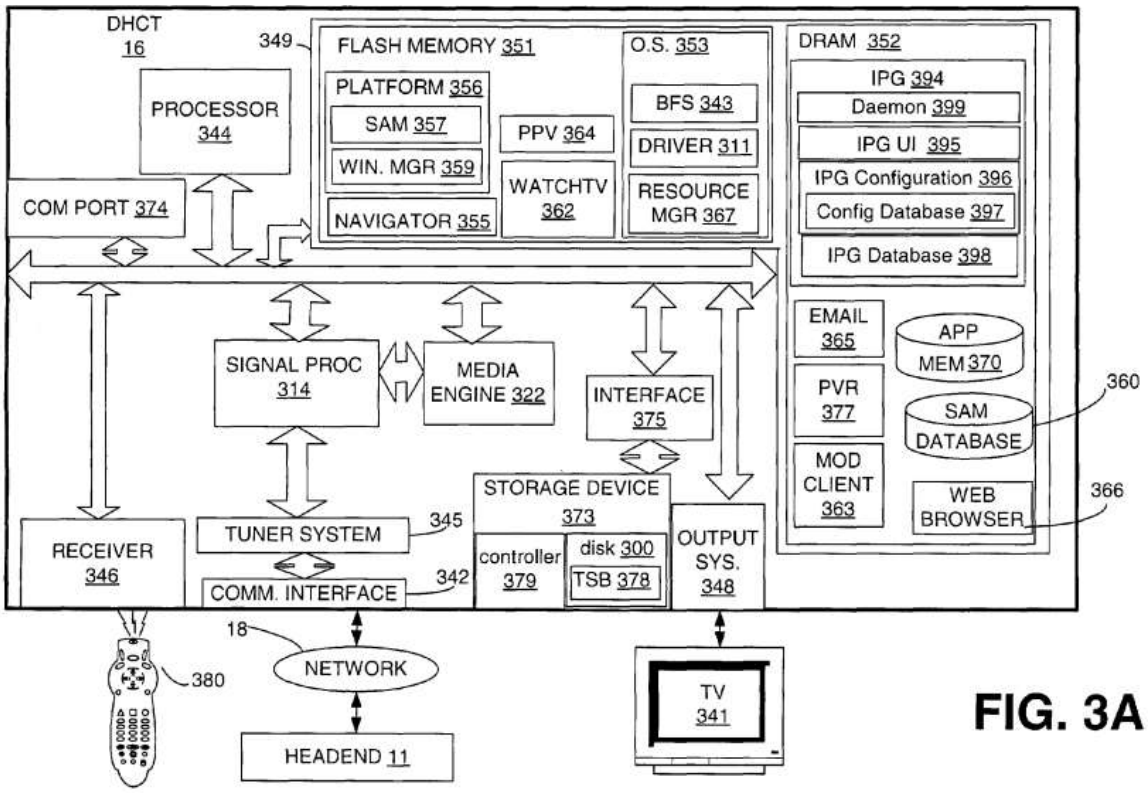


FIG. 3A

Figure 3A depicts a DHCT (digital home communication terminal device) or set-top box. *Id*. at 2:13–15. "The DHCT 16 processes analog and/or digital transmission signals for storage in the storage device 373, and/or for display to the television 341." *Id*. at 7:61–63. "The DHCT 16 preferably includes one or more processors, such as processor 344, for controlling operations of the DHCT 16, an output system 348 for driving the television display 341, and at least one tuner system 345 for tuning into a particular television channel or frequency to display media content and for sending and receiving various types of data or media content to and from the headend 11." *Id*. at 7:42–48.

Figure 7 of Russ is reproduced below.

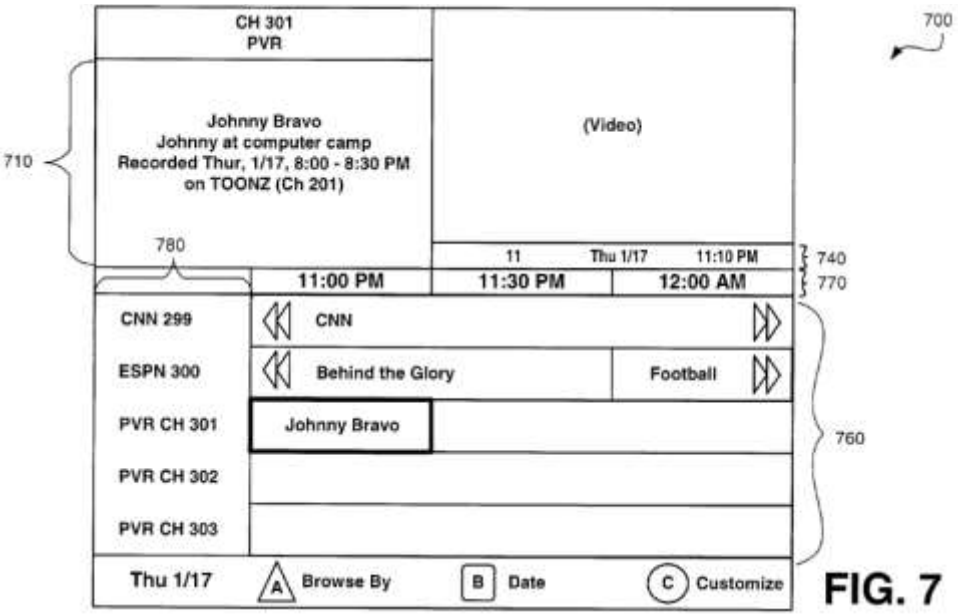


FIG. 7

Figure 7 depicts "an example IPG screen, prompted by the user after the scheduled recording of the Johnny Bravo episode, the title of which is displayed in a Personal Video Recording (PVR) channel." *Id*. at 2:33–36.

Figure 8 of Russ is reproduced below.

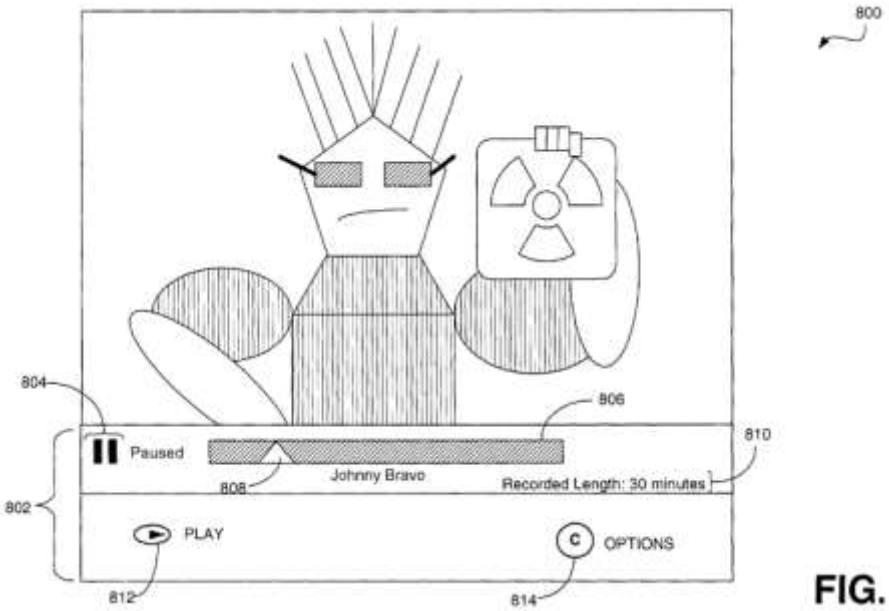


FIG. 8

Figure 8 depicts "an example screen display of the presentation of Johnny Bravo, prompted by the user selecting the Johnny Bravo episode in the IPG of FIG. 7, with a pause banner and playback bar overlaid on the display of Johnny Bravo." *Id*. at 2:38–42.

2. *McElhatten (Ex. 1009)*

McElhatten is titled, "Program Guide and Reservations System for Network Based Digital Information and Entertainment Storage and Delivery System." Ex. 1009, (54). "In a broadband communications system, e.g., a cable system, programming content can be readily reserved and accessed for viewing using interactive program guides." *Id*. at (57) (Abstract). Figure 1 of McElhatten is reproduced below.

FIG. 1

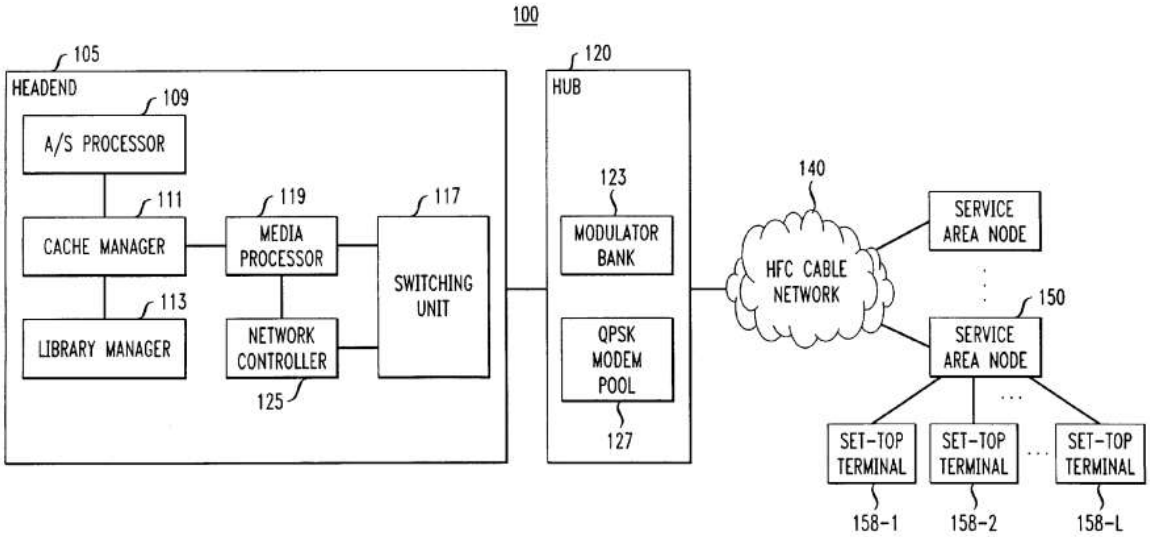


Figure 1 depicts "a block diagram of a broadband communications system." *Id*. at 3:61–62. Figure 12 of McElhatten is reproduced below.

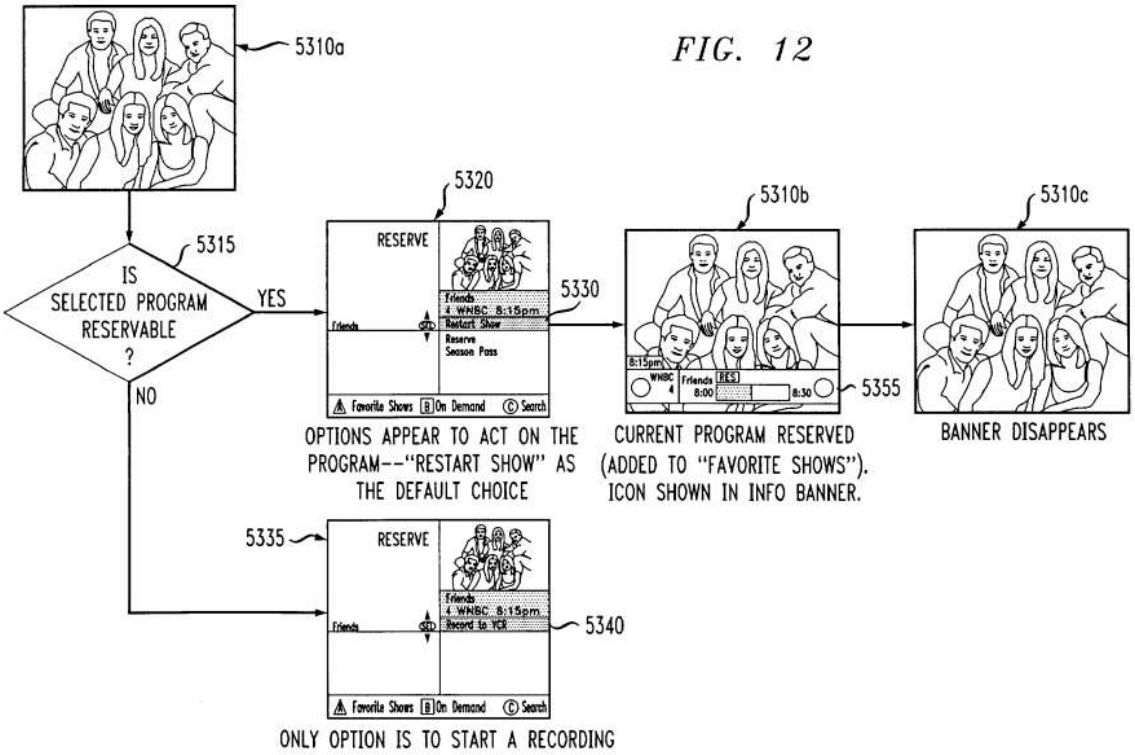


Figure 12 depicts "screen displays in reserving a current show." *Id*. at 4:21–22. McElhatten states:

> Referring to FIG. 12, if a user is watching a program that is currently being broadcast on a first channel GUI 5310*a*, the user may issue a reserve command by pressing record key 910 of remote control 900. When media processor 119 receives a command to reserve a selected program, processor 119 determines whether the selected program is reservable (5315). Reservable programs are those that have been recorded and stored at headend 105 for future access[i]bility. Such programs may then be reserved after they have been broadcast. These programs may also be manipulated by the user by issuing PVR-like commands, such as rewind, fast-forward, pause, skip commercials and restart. Programs that are not predesignated for reservation are referred to as non-reservable programs.

Id. at 15:59–16:5.

3. Analysis

According to Petitioner, all the limitations of claims 2, 4, 5, 7, and 8 are disclosed in Russ. *See* Pet. 50–75. Petitioner relies on McElhatten only "to the extent that there is a more narrow interpretation of the claim language 'a controller which controls the alternative display of either of the linear content operation panel or the interactive content operation panel . . . ,' such that this limitation requires an assessment of the content's metadata to determine if it is linear or interactive content and then, based on that determination, display an appropriate operation panel." Pet. 65. Neither party argues for this more narrow construction of the "controller" limitation, which we have not adopted.

Patent Owner argues that "Petitioner fails to establish that Russ discloses "interactive functions **to an outside of the digital content reproduction apparatus**.'" Prelim. Resp. 22. Specifically, Patent Owner argues that Petitioner "simply ignores" this portion of the limitation. *Id*. at 23. On the record before us, we agree. Petitioner makes no showing that Russ teaches or suggests "an interactive content operation panel allowing user-instruction of interactive functions to an outside of the digital content reproducing apparatus" as recited in independent claims 2, 4, and 7. *See id*. at 58–62, 72, 74. Petitioner has not relied on McElhatten to remedy the deficiencies in Russ. *Id*.

In view of our decision to institute on the challenge to these same claims as anticipated by Phillips, we institute *inter partes* review of claims 2, 4, 5, 7, and 8 in view of the combination of Russ and McElhatten. *See SAS*, 138 S.Ct. at 1358; *see also* USPTO *SAS* Guidance.

I. Asserted Obviousness of Claims 2, 3, 4, 6, 7, and 9 over Russ, McElhatten, and Uchida

Petitioner contends that claims 2, 3, 4, 6, 7, and 9 would have been obvious in view of Russ, McElhatten, and Uchida. Pet. 5, 75–76. Petitioner relies on Uchida as teaching or suggesting the additional limitations in dependent claims 3, 6, and 9. *Id*. at 75–76. Petitioner does not further address independent claims 2, 4, and 7. *Id*. Patent Owner does not specifically discuss this challenge to claims 2, 3, 4, 6, 7, and 9. *See generally* Prelim. Resp In view of our decision to institute on the challenge to these same claims as obvious in view of Phillips and Uchida, we institute *inter partes* review of claims 2, 3, 4, 6, 7, and 9 in view of the combination of Russ, McElhatten, and Uchida. *See SAS*, 138 S.Ct. at 1358; *see also* USPTO *SAS* Guidance.

III. CONCLUSION

For the foregoing reasons, we conclude that Petitioner has shown a reasonable likelihood of establishing that at least one claim of the '394 patent is unpatentable.

Our discussion of facts in this Decision is only for the purpose of determining whether or not *inter partes* review should be initiated and is not dispositive of any issue. At this preliminary stage, the Board has not made a final determination with respect to the patentability of any of the challenged claims or any underlying factual and legal issues. The Board's final determination will be based on the record as developed during the trial.

IV. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted as to claims 2–9 of U.S. Patent No. 8,170,394 B2 based on the challenges in the Petition (Pet. 5).

Pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, which commences on the entry date of this Decision.

PETITIONER:

Todd Baker
cpdocketbaker@oblon.com

Christopher Ricciuti
cpdocketricciuti@oblon.com

Marc Weinstein
cpdocketweinstein@oblon.com

Ali Allawi
cpdocketallawi@oblon.com

Michael West
cpdocketwest@oblon.com

PATENT OWNER:

Robert Pluta
rpluta@mayerbrown.com

Michael Word
mword@mayerbrown.com

Amanda Bonner
astreff@mayerbrown.com

Luiz Miranda
lmiranda@mayerbrown.com

Saqib Siddiqui
ssiddiqui@mayerbrown.com