

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.,**
Petitioners,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2025-01314

U.S. Patent No. 8,180,198

**PATENT OWNER PRELIMINARY RESPONSE TO PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 8,180,198**

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Patent Trial and Appeal Board
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IPR2024-00735, Paper No. 38	25
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PATENT OWNER'S EXHIBIT LIST

Description	Exhibit #
Notice Letter to Samsung (July 7, 2021)	2001
Follow-up Notice Letter to Samsung (December 29, 2021)	2002
Docket Navigator Time to Trial Statistics for the Eastern District of Texas	2003
Docket Control Order, <i>Maxell, Ltd. v. Samsung Elecs. Co., Ltd.</i> , No. 5:25-cv-00052-RWS (E.D. Tex.)	2004
Jury Trial Transcript, Vol. 4, <i>Maxell, Ltd. v. Samsung Elecs. Co., Ltd.</i> , No. 5:23-cv-00092-RWS (E.D. Tex.)	2005
Complaint, <i>Maxell, Ltd. v. Samsung Elecs. Co., Ltd.</i> , No. 5:25-cv-00052-RWS (E.D. Tex.)	2006
Follow-up Notice Letter to Samsung (April 21, 2025)	2007
Law360 Article, "Maxell Settles Patent Suit Against Apple Over Mobile Tech"	2008
Law360 Article, "Maxell Scores \$43M EDTX Jury Win In ZTE Patent Trial"	2009
Law360 Article, "Maxell, Huawei Reach Terms To End Smartphone Patent Suit"	2010
Hudson Institute Article, "Google's Loss to Sonos Settles It, Big Tech Has an IP Piracy Problem"	2011
PatentRenewal.com Article, "which-companies-hold-the-most-patents-in-the-world"	2012
Motion for Partial Summary Judgment of Validity Based on Sotera Stipulations, <i>Maxell, Ltd. v. Samsung Elecs. Co., Ltd.</i> , No. 5:23-cv-00092-RWS (E.D. Tex.)	2013
Follow-up Notice Letter to Samsung (November 28, 2024)	2014
Petitioner's Invalidity Contentions (October 28, 2025)	2015

LISTING OF CHALLENGED CLAIMS¹

Claim	Claim Text
[1pre]	A digital image recording and reproducing apparatus connectable to a display module, said apparatus comprising:
[1a]	an output module which displays a plurality of digital images and a plurality of related information concerning said digital images recorded in a recording medium on the display module, each digital image corresponding to one of said plurality of related information; and
[1b]	a control module which selects a digital image to add in a playlist, based on one of the plurality of information concerning the digital image recorded in said recording medium;
[1c.i]	wherein for a selected digital image selected by the user, said control module; retrieves other digital images whose related information is the same as the selected digital image, the other digital images being candidates for adding in said playlist,
[1c.ii]	outputs a list identifying the other digital images retrieved based on their related information to select another digital image to add in said playlist when said another digital image is selected from other digital images as the candidates by the user,
[1c.iii]	outputs said playlist including a plurality of said digital images added, wherein said plurality of digital images, said plurality of related information, said list identifying the other digital images, and said playlist are outputted in a same display, and
[1c.iv]	outputs one of the other digital images to be positioned next to another one of the other digital images in said list identifying the other digital images.
[2]	The digital image recording and reproduction apparatus according to

¹ For convenience purposes only, Patent Owner adopts for this Preliminary Response the numbering of claim elements advanced by Petitioner in the Petition (Paper 1) on page xiii-xv. Patent Owner does not concede the appropriateness of such grouping and numbering of claim elements.

	claim 1, wherein said control module rearranges the information showing said selected digital image, based on related information concerning a digital image other than the related information concerning the digital image specified by the user and adds the rearranged information to said display module for display.
[3]	The digital image recording and reproduction apparatus according to claim 2, wherein said control module displays information concerning a digital image in which information showing said selected digital image is rearranged.
[4]	The digital image recording/reproduction apparatus according to claim 1, wherein a reduced image is displayed on said display module as the information showing the digital image selected by said control module.
[5]	The digital image recording and reproducing apparatus accordingly to claim 1, wherein for a selected digital image selected by the user, said control module outputs a telop to select another digital image from a plurality of the other digital images to add in said playlist when the telop is selected.
[6pre]	A method for creating a playlist designating an reproduction order for image data reproduced from a recording medium having a plurality of image data and associated information concerning said image data that are recorded thereon, said method comprising:
[6a]	listing the associated information concerning an image data recorded on said recording medium as a program list;
[6b]	receiving, from a user, selection of a desired image data to be registered with a playlist from said program list;
[6c]	retrieving an image data associated with associated information selected, from associated information concerning said selected image data;
[6d]	retrieving other image data whose related information is the same as the desired image data selected by the user, the other digital images being candidates for adding in said playlist;
[6e]	listing information identifying said other image data to select another digital image to add in said playlist when said another digital image is selected from other digital images as the candidates by the user;
[6f]	displaying said plurality of image data, said associated information, said listed information identifying the other image data, and said

	playlist including a plurality of said digital image data added in a same display; and
[6g]	displaying one of the other digital image data to be positioned next to another one of the other digital image data in said list identifying the other digital image data.
[7]	The method for creating a playlist according to claim 6, wherein said image data is a recorded program and information identifying said image information is a program title and/or a program time zone.
[8]	The method for creating a playlist according to claim 7, wherein said selecting-menu contains a selecting-menu used for registering all image data retrieved.
[9]	The method for creating a playlist according to claim 7, wherein a retrieval condition used in retrieving said selected image data is displayed.
[10]	The method for creating a playlist according to claim 7, wherein when information identifying said retrieved image data is added to a display, the information is rearranged for display based on associated information different from a retrieval condition used for the retrieval.
[11]	The method for creating a playlist according to claim 6, wherein when information identifying said retrieved image data is added to a display, the information is rearranged for display based on associated information different from a retrieval condition used for the retrieval.
[12]	A method for creating a playlist according to claim 6, wherein for a selected digital image selected by the user, displaying a selection menu including a telop to determine whether or not to register a plurality of said other image data to add in said playlist, when the telop is selected.
[13pre]	A dubbing list-creating method for selecting an image data in dubbing from a recording medium having a plurality of image data and associated information thereof that are recorded thereon to another recording medium, said method comprising: to determine whether or not to register a plurality of said retrieved images to add in said dubbing list when the telop is selected.
[13a]	listing the associated information concerning an image data recorded on said recording medium as a program list;

[13b]	receiving, from a user, selection of desired image information to be registered with a dubbing list from said program list;
[13c]	retrieving image information associated with image information selected, from the associated information concerning the selected image data;
[13d]	retrieving other digital images whose related information is same as the one of the digital images selected from other digital images as the candidates by the user, the other digital images being candidates for adding in said playlist;
[13e]	listing information identifying the retrieved image information;
[13f]	displaying said plurality of image data said associated information, said listed information identifying said retrieved image information, and said dubbing list including a plurality of said digital image data added in a same display; and
[13g]	displaying one of the other digital image data to be positioned next to another one of the other digital image data in said list identifying the other digital image data.
[14]	The dubbing list-creating method according to claim 13, wherein said selecting menu includes a telop to determine a bit rate so as to registering all the retrieved image data.
[15]	The dubbing list-creating method according to claim 14, wherein the bit rate for said image data is determined based on a recordable capacity of said another recording medium on which dubbing is made.
[16]	A dubbing list creating method according to claim 13, wherein for a selected digital image selected by the user, displaying a selection menu including a telop to determine whether or not to register a plurality of said retrieved images to add in said dubbing list when the telop is selected.

I. INTRODUCTION

Patent Owner Maxell, Ltd. ("Patent Owner") respectfully requests that the Director deny institution of the Petition filed by Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc., (hereinafter "Petitioner") challenging the patentability of claims 1-16 ("challenged claims") of U.S. Patent No. 8,180,198 ("the '198 Patent") (EX1001).

First, Petitioner has failed to demonstrate a reasonable likelihood of success on the grounds submitted in its Petition. None of the cited references, whether taken alone or in reasonable combination, disclose or render obvious the arrangement of each limitation in the challenged claims.

Second, 37 C.F.R. § 42.104(b)(3) requires Petitioner to explain how the challenged claims are to be construed. Yet, Petitioner states it "does not contend that its proposed constructions are complete constructions of these limitations or the claims for any other purpose, including for issues that have been raised in the related litigation." A petitioner must explain why it takes different claim construction positions in the petition and in district court and asserting different claim construction positions in the two forums alone favors denial of institution.

Additionally, Petitioner relies on a declaration from its expert Dr. Bederson (EX1003). However, Dr. Bederson copies verbatim Petitioner's arguments and lacks

sufficient facts and data to support his positions, including attempting to fill in missing limitations in violation of 37 C.F.R. § 42.104(b)(4).

For at least these reasons, Petitioner has failed to meet their burden of showing a reasonable likelihood of prevailing. Accordingly, the Director should deny Petitioner's request to institute *inter partes* review.

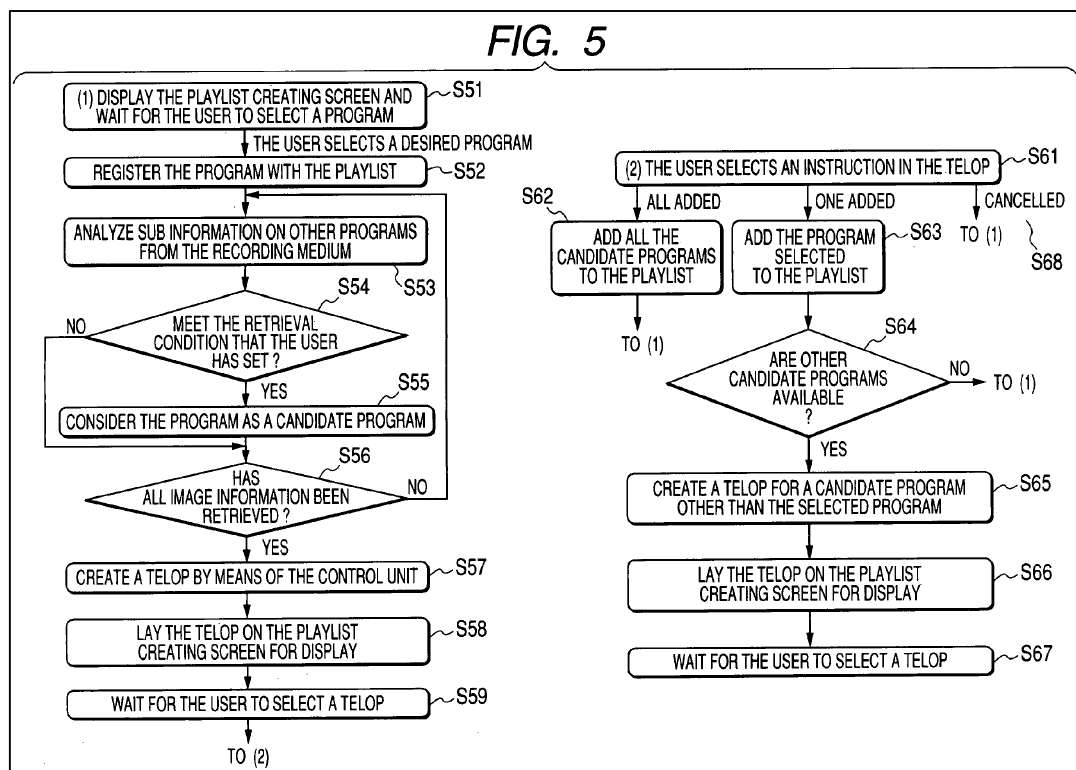
II. BACKGROUND

A. Overview of the '198 Patent

The '198 Patent, entitled "Playlist Creating Apparatus and Method, and Dubbing List Creating Apparatus and Method," is generally directed to a digital image recording and reproducing apparatus that includes an output module and control module to provide a playlist creating apparatus that "allows a user to select desired digital images from a plurality of programs and use the digital images to create a simple playlist or to select digital images to be dubbed to another recording medium." EX1001, 1:42-46.

For example, the '198 Patent discloses a digital image recording and reproducing apparatus and methods that includes an output module that displays a plurality of digital images and a plurality of related information concerning said digital images recorded in a recording medium on the display module, each digital image corresponding to one of said plurality of related information. *See id.* at 2:28-

4:42. Further, the '198 Patent discloses that the digital image recording and reproducing apparatus and methods also include techniques to provide dubbing functionality as part of playlist generation. *See id.* at 4:46-6:30. An exemplary configuration is shown below in Figure 5 of the '198 Patent:



Id. at Fig. 5.

B. Patent Prosecution History

U.S. Patent Application No. 11/054,775, which would ultimately issue as the '198 Patent, claims priority to Japanese application published on July 21, 2004.

During prosecution of the '198 Patent, the Examiner issued five office actions (three non-final office actions and two final office actions). EX1002 at 17, 37, 57,

74, 92. Throughout the course of prosecution, the claims were substantially amended, with challenged claim 1 included as illustrative:

1. A digital image recording and reproducing apparatus connectable to a display module, said apparatus comprising:

an output module which displays a digital image and information concerning said digital image recorded in a recording medium on the display module; and

a control module which selects a digital image, based on the information concerning the digital image recorded in said recording medium;

wherein said control module selects a digital image that corresponds to information concerning a digital image specified by a user, from digital images recorded in said recording medium, and adds information showing the selected digital image to said display module through said output module for display.

See id. at 103 (original claim 1).

1. (currently amended) A digital image recording and reproducing apparatus connectable to a display module, said apparatus comprising:

an output module which displays a plurality of digital image images and a plurality of related information concerning said digital images recorded in a recording medium on the display module, each digital image corresponding to one of said plurality of related information; and

a control module which selects a digital image, based on one of the plurality of information concerning the digital image recorded in said recording medium;

wherein for a selected digital image selected by the user, said control module; ~~said control module selects a digital image that corresponds to information concerning a digital image specified by a user, from digital images recorded in said recording medium, and adds information showing the selected digital image to said display module through said output module for display~~

retrieves other digital images whose related information is the same as the selected digital image,

outputs a list identifying the other digital images retrieved based on their related information, and

outputs a telop to select a plurality of the other digital images at one time when the telop is selected.

See id. at 85 (September 19, 2008 amendments to claim 1).

1. (Currently Amended) A digital image recording and reproducing apparatus connectable to a display module, said apparatus comprising:

an output module which displays a plurality of digital images and a plurality of related information concerning said digital images recorded in a recording medium on the display module, each digital image corresponding to one of said plurality of related information; and

a control module which selects a digital image to add in a playlist, based on one of the plurality of information concerning the digital image recorded in said recording medium;

wherein for a selected digital image selected by the user, said control module:

retrieves other digital images whose related information is the same as the selected digital image,

outputs a list identifying the other digital images retrieved based on their related information to select another digital image to add in said playlist when said another digital image is selected by the user, and

~~outputs a telop to select a plurality of the other digital images at one time when the telop is selected~~

outputs said playlist including a plurality of said digital images added,

wherein said plurality of digital images, said plurality of related information, said list identifying the other digital images, and said playlist are outputted in a same display.

See id. at 69 (June 26, 2009 amendments to claim 1).

1. (Currently Amended) A digital image recording and reproducing apparatus connectable to a display module, said apparatus comprising:

an output module which displays a plurality of digital images and a plurality of related information concerning said digital images recorded in a recording medium on the display module, each digital image corresponding to one of said plurality of related information; and

a control module which selects a digital image to add in a playlist, based on one of the plurality of information concerning the digital image recorded in said recording medium;

wherein for a selected digital image selected by the user, said control module:

retrieves other digital images whose related information is the same as the selected digital image,

outputs a list identifying the other digital images retrieved based on their related information to select another digital image to add in said playlist when said another digital image is selected by the user, [[and]]

outputs said playlist including a plurality of said digital images added, wherein said plurality of digital images, said plurality of related information, said list identifying the other digital images, and said playlist are outputted in a same display, and

outputs one of the other digital images to be positioned next to another one of the other digital images in said list identifying the other digital images.

See id. at 48 (February 16, 2010 amendments to claim 1).

1. (Currently Amended) A digital image recording and reproducing apparatus connectable to a display module, said apparatus comprising:

an output module which displays a plurality of digital images and a plurality of related information concerning said digital images recorded in a recording medium on the display module, each digital image corresponding to one of said plurality of related information; and

a control module which selects a digital image to add in a playlist, based on one of the plurality of information concerning the digital image recorded in said recording medium;

wherein for a selected digital image selected by the user, said control module:

retrieves other digital images whose related information is the same as the selected digital image, the other digital images being candidates for adding in said playlist,

outputs a list identifying the other digital images retrieved based on their related information to select another digital image to add in said playlist when said another digital image is selected from other digital images as the candidates by the user,

outputs said playlist including a plurality of said digital images added,

wherein said plurality of digital images, said plurality of related information, said list identifying the other digital images, and said playlist are outputted in a same display, and

outputs one of the other digital images to be positioned next to another one of the other digital images in said list identifying the other digital images.

See id. at 48 (September 30, 2011 amendments to claim 1).

The prosecution history therefore demonstrates that the USPTO recognized that the interplay between the output module, control module including the digital image retrieval, and digital image output and arrangement of the '198 Patent as patentably distinct over the relevant art. *See also* Pet. at 18-22. As shown below, Petitioner's cited references fail to disclose at least the same limitations as were discussed at length during prosecution, leading to the Notice of Allowance.

C. Summary of Petitioner's Proposed Grounds for Unpatentability

Petitioner alleges that claims 1-16 of the '198 Patent would have been obvious under post-AIA 35 U.S.C. § 103 and raises six grounds of alleged unpatentability. Pet. at 16. The alleged invalidity grounds are summarized as follows:

Ground	'198 Claims	Type of Challenge	References
1	1-4, 6, 9-11	§ 103	Nagaoka
2	5 and 12	§ 103	Nagaoka in view of Benyamin
3	7 and 13	§ 103	Nagaoka in view of Nara
4	14-15	§ 103	Nagaoka in view of Nara, Benyamin, and Imada
5	8, 16	§ 103	Nagaoka in view of Nara and Benyamin
6	1-16	§ 103	Watanabe, Looney, Platt, and Kaplan

The references relied upon by Petitioner are summarized below:

1. Nagaoka (EX1004)

Nagaoka is entitled "Method and Apparatus for Organizing Digital Media Based on Face Recognition." EX1004. Nagaoka is directed to "a computer-based method and system for organizing media, and more particularly to a computer-based system and method for organizing digital photos in accordance with objects detected and recognized in the digital photos." *See* EX1004, 2:46-49, Figs. 1-2. In one implementation, a user may "drag and drop" faces from imported digital photos,

which have not been associated with a known person's folder, from an "unknown" display window portion into a particular person's folder where face recognition analysis may determine similarities between the images. *See id.* at 5:19-29.

Patent Owner disagrees with Petitioner's conclusory statement that Nagaoka is analogous art to the '198 Patent. *See Pet.* at 36. Petitioner, who has the burden of proof on obviousness, has not shown with respect to the '198 Patent: (1) "whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *See Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 66 F.4th 1373, 1377 (Fed. Cir. 2023) (citation omitted).

2. Benjamin (EX1005)

Benjamin is entitled "Play List Manager." EX1005. Benjamin "provides for a play list manager than can be used to create and update play lists. The play lists can be used for audio information, visual information or a combination of audio and visual information. In one embodiment, a play list stores the names of tracks to be played. The user of the play list manager creates a play list and specifies certain criteria for automatically adding tracks to the play list. When a new track is added to the environment, the system tests Whether the track's properties satisfy the criteria

for the play list. If so, the new track is automatically added to the play list. In one alternative, a user can select to create or update a predefined play list whose criteria has already been created. Upon selection of the predefined play list, the play list manager accesses each track and automatically adds the track to the play list if the track's properties satisfy the criteria for the predefined playlist. In one embodiment, after a play list is created and tracks are added, the tracks on the play list are automatically played." See EX1005, 1:62-2:13.

Patent Owner disagrees with Petitioner's conclusory statement that Benjamin is analogous art to the '198 Patent. See Pet. at 37. Petitioner, who has the burden of proof on obviousness, has not shown with respect to the '198 Patent: (1) "whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." See *Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 66 F.4th 1373, 1377 (Fed. Cir. 2023) (citation omitted).

3. Nara (EX1006)

Nara is entitled "Digital Broadcast Receiver and Backup Method." EX1006. Nara provides " a digital broadcast receiver characterized by comprising: extracting means for automatically extracting a plurality of contents recorded, out of order, on

a recording medium by a first attribute of the contents; and arranging means for automatically rearranging contents extracted by the extracting means according to a second attribute of extracted contents, for recording onto a second recording medium.” EX1006, 1:44-51.

Patent Owner disagrees with Petitioner's conclusory statement that Nara is analogous art to the '198 Patent. *See* Pet. at 38. Petitioner, who has the burden of proof on obviousness, has not shown with respect to the '198 Patent: (1) “whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *See Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 66 F.4th 1373, 1377 (Fed. Cir. 2023) (citation omitted).

4. Imada (EX1007)

Imada is entitled “Recording Apparatus, Recording Program, and Recording Method.” EX1007. Imada “relates to a recording apparatus, Such as a hybrid type recorder, that performs a dual function as a DVD recorder for a DVD (Digital Versatile Disc) and an HD recorder for an HD (hard disk), as well as to a recording program and a recording method. More particularly, the present invention relates to an improvement in a technique for making a backup copy of a content recorded in

one recording medium in another recording medium.” EX1007, [0002].

Patent Owner disagrees with Petitioner's conclusory statement that Imada is analogous art to the '198 Patent. *See* Pet. at 38. Petitioner, who has the burden of proof on obviousness, has not shown with respect to the '198 Patent: (1) “whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *See Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 66 F.4th 1373, 1377 (Fed. Cir. 2023) (citation omitted).

5. Watanabe (EX1008)

Watanabe is entitled “Apparatus and Method for Managing Contents in a Computer.” EX1008. Watanabe “relates to a contents management apparatus and contents management method in a computer having a function of managing the number of duplicated contents of music, movies or the like, which can be stored in a storage medium” (*id.* at [0002]), where “an object of the present invention to provide a contents management apparatus and contents management method in a computer, which allows contents to be easily written to a storage medium and read therefrom and managements the number of duplicate contents to be recorded on the storage medium to limit the duplication of contents and thus protect the contents by

copyright.” *Id.* at [0007].

Patent Owner disagrees with Petitioner's conclusory statement that Watanabe is analogous art to the '198 Patent. *See* Pet. at 40. Petitioner, who has the burden of proof on obviousness, has not shown with respect to the '198 Patent: (1) “whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *See Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 66 F.4th 1373, 1377 (Fed. Cir. 2023) (citation omitted).

6. Looney (EX1009)

Looney is entitled “Media Organizer and Entertainment Center.” EX1009. Looney “relates to media/data (music, books, movies, etc.) organization, playback and recording systems, and more particularly to a system that enables organization, storage, playback and recording of a wide range of individual music selections/songs according to user-defined or pre-programmed list of categories.” EX1009, 1:31-36. Looney provides “a media organizer and entertainment center that enables customized playback of music or other media/data such as movies, films, books, tape, etc. having a variety of predetermined categories that are provided, typically, ahead of time by a service provider, but can also be customized and edited by a user.”

EX1009, 2:8-13.

Patent Owner disagrees with Petitioner's conclusory statement that Looney is analogous art to the '198 Patent. *See* Pet. at 40. Petitioner, who has the burden of proof on obviousness, has not shown with respect to the '198 Patent: (1) "whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *See Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 66 F.4th 1373, 1377 (Fed. Cir. 2023) (citation omitted).

7. Platt (EX1022)

Platt is entitled "Auto Playlist Generation with Multiple Seed Songs." EX1022. Platt "relates generally to systems and methodologies that facilitate generation of playlists. The invention can also facilitate organization and access to media items by identifying items similar to desirable characteristics and dissimilar to undesirable characteristics by analyzing user selectable seed items. The present invention facilitates playlist generation for a library or collection of media items by permitting a user to select a plurality of seed items." EX1022, 2:10-18.

Patent Owner disagrees with Petitioner's conclusory statement that Platt is analogous art to the '198 Patent. *See* Pet. at 41. Petitioner, who has the burden of

proof on obviousness, has not shown with respect to the '198 Patent: (1) "whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *See Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 66 F.4th 1373, 1377 (Fed. Cir. 2023) (citation omitted).

8. Kaplan (EX1016)

Kaplan is entitled "Systems, Methods and Computer Program Products for Managing Multimedia Content." EX1016. Kaplan relates to a "is a multimedia management system for storing, manipulating, and displaying multimedia content. The system comprises a user interface, a plurality of predefined functions, a multimedia acquisition interface, and system controls. The system provides users with a simple and intuitive method and computer program for reviewing multimedia content, which can include digital video, digital audio and text, still images, animation, and MIDI." EX1016, [0004].

Patent Owner disagrees with Petitioner's conclusory statement that Kaplan is analogous art to the '198 Patent. *See Pet.* at 42. Petitioner, who has the burden of proof on obviousness, has not shown with respect to the '198 Patent: (1) "whether the art is from the same field of endeavor, regardless of the problem addressed and,

(2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *See Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 66 F.4th 1373, 1377 (Fed. Cir. 2023) (citation omitted).

III. LEVEL OF ORDINARY SKILL

For purposes of this preliminary response only, Patent Owner does not raise an issue with the level of ordinary skill proposed by Petitioner. Pet. at 43. Patent Owner reserves the right to contest Petitioner's definition of a person or ordinary skill in the art ("POSITA") in the event of institution.

IV. CLAIM CONSTRUCTION

To minimize the disputes that the Board needs to address at this preliminary stage, for the purposes of this Preliminary Response only, Patent Owner simply applies Petitioner's own constructions to show how the Petitioner has not met its burden under 37 CFR § 42.104(b)(4). Patent Owner, however, reserves all rights to dispute Petitioner's proposed constructions with the support of expert testimony to the extent the Board decides to institute review of this Petition. Any statements made herein with respect to the lack of a claim element in a prior art reference are under Petitioner's proposed constructions and should not be construed as an admission on behalf of Patent Owner that such construction is proper under the *Phillips* standard.

V. LEGAL STANDARD

A claim is also not patentable if the differences between the claim and the prior art are such that the subject matter as a whole would have been obvious to a person of ordinary skill in the art at the time of the invention. 35 U.S.C. § 103(a). Obviousness requires assessing (1) the “level of ordinary skill in the pertinent art,” (2) the “scope and content of the prior art,” (3) the “differences between the prior art and the claims at issue,” and (4) “secondary considerations” of non-obviousness such as “commercial success, long felt but unsolved needs, failure of others, etc.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)).

It is a petitioner’s burden “to demonstrate both ‘that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.’” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016) (quotations and citations omitted). However, a petitioner must first show that all of the claimed elements are disclosed in the prior art. *See Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006) (considering motivation to combine and reasonable expectation of

success only “if all the elements of an invention are found in a combination of prior art references”).

VI. PETITIONER'S EXPERT DECLARATION IS ATTORNEY ARGUMENT VEILED AS EXPERT OPINION

Petitioner relies on a declaration from its expert Dr. Bederson (EX1003). However, Dr. Bederson copies verbatim Petitioner's arguments and lacks sufficient facts and data to support his positions. For example:

Petition	Dr. Bederson's Declaration (EX1003)
A POSITA would have understood that the related information is sourced from the phone's ² storage or is streamed, and each image is presented with its corresponding data on the device's display. EX1003, ¶103. (Pet. at 49)	A POSITA would have understood that the related information is sourced from the phone's storage or is streamed, and each image is presented with its corresponding data on the device's display. (EX1003, ¶103)
A POSITA would have further found it obvious to organize digital images based on underlying metadata, including the date the photo was taken. EX1003, ¶109. (Pet. at 52)	A POSITA would have further found it obvious to organize digital images based on underlying metadata, including the date the photo was taken. (EX1003, ¶109)
A POSITA would have further found it obvious to organize digital images based on underlying metadata, including the date the photo was taken. <i>See</i> Section III.D.; EX1003, ¶110. (Pet. at 52)	A POSITA would have further found it obvious to organize digital images based on underlying metadata, including the date the photo was taken. <i>See</i> Section IV.D. (EX1003, ¶110)

² Both Petitioner and Dr. Bederson (by nature of his regurgitation of Petitioner's arguments) misstate the content of Nagaoka. Namely, the word “phone” is not mentioned anywhere in Nagaoka. *See generally* EX1004.

Petition	Dr. Bederson's Declaration (EX1003)
In the alternative, a POSITA would have found it obvious to modify Nagaoka's disclosure in Fig. 6 of a display window portion 408 showing a list of digital images to a playlist. Such playlists were well known in the art. <i>See</i> Section III.D; EX1003, ¶111. (Pet. at 54-55)	In the alternative, a POSITA would have found it obvious to modify Nagaoka's disclosure in Fig. 6 of a display window portion 408 showing a list of digital images to a playlist. Such playlists were well known in the art. <i>See</i> Section IV.D. (EX1003, ¶111)

Dr. Bederson does not provide any other analysis or explanation why a POSITA would find something obvious or be motivated to modify Nagaoka other than Petitioner's own conclusory and boilerplate statements. The above citations are merely exemplary for Ground 1 (obviousness based on Nagaoka alone) but Petitioner employs the same tactics for each of the other Grounds. *See generally* Sections VIII(B)-(F) *infra*.

Such conclusory and superficial attorney argument in the guise of expert testimony cannot serve as sufficient support for Petitioner's arguments. *See, e.g., Cardiocom, LLC v. Bosch Healthcare Sys., Inc.*, IPR2013-00439, Paper 26, 15-16 (P.T.A.B. Jan. 16, 2014); *see also Kinetic Techs., Inc. v. Skyworks Solutions, Inc.*, IPR2014-00529, Paper 8, 15-16 (P.T.A.B. Sept. 23, 2014) ("Merely repeating an argument from the Petition in the declaration of a proposed expert does not give that argument enhanced probative value," and a petitioner cannot move forward to trial

based upon such “mere conclusory statements.”) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)); *TRW Auto. US LLC v. Magna Elecs., Inc.*, IPR2014- 00258, Paper 18, 10-11 (P.T.A.B. Aug. 27, 2014) (giving little to no weight to expert testimony that “did not elaborate on [Petitioner’s] position because it simply repeated [Petitioner’s] conclusory statements verbatim”); *see also InfoBionic, Inc. v. Braemar Mfg., LLC*, IPR2015-01704, Paper 11, 6 (P.T.A.B. Feb. 16, 2016) (denying institution because expert merely repeated the argument in the Petition about what a reference meant without explaining why the expert believed that meaning to be correct).

Moreover, such conclusory opinions by an expert that merely parrot Petitioner’s arguments should be accorded little weight when used to supply a missing limitation. *See Xerox Corp. et al. v. Bytemark, Inc.*, IPR2022-00624, Paper 12, 5 (P.T.A.B. Feb. 10, 2023) (Former Director Vidal noting in a Sua Sponte affirmation of the decision: “I determine that the Board was correct in giving little weight to Petitioner’s expert because the expert declaration merely offered conclusory assertions without underlying factual support and repeated, verbatim, Petitioner’s conclusory arguments.”). Former Director Vidal stated that:

The declaration does not provide any technical detail, explanation, or statements supporting why the expert determines that the feature in

question was required or would have been obvious based on the prior art disclosure. See Ex. 1003 ¶54. Instead, the declaration copies, word-for-word, Petitioner's conclusory assertions. Compare *id.*, with Pet. 28–29. The declaration sets forth Petitioner's conclusory assertions as though they are facts, rather than setting forth facts and evidence in support of Petitioner's assertions. Accordingly, I agree with the Board's explanation that “the cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight” under 37 C.F.R. § 42.65(a).

Id. As discussed *infra*, Dr. Bederson's “opinions” are copied verbatim from the Petition, including in attempting to fill in missing limitations in violation of 37 C.F.R. § 42.104(b)(4).

Therefore, little to no weight should be given to Dr. Bederson's testimony. And, absent his conclusory testimony, the Petition has no evidentiary support. Institution should be denied for this reason.

VII. THE BOARD SHOULD DENY INSTITUTION IN VIEW OF SAMSUNG ADMITTING THAT IT DID NOT PROVIDE “COMPLETE CONSTRUCTIONS” AND, THEREFORE, INTENDS TO BUILD INCONSISTENT CLAIM CONSTRUCTION RECORDS

Petitioner states: “Petitioner does not contend that its proposed constructions are complete constructions of these limitations or the claims for any other purpose, including for issues that have been raised in the related litigation.” Pet. at 42. While

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Petitioner states that the Petition does not set forth “complete constructions,” the Petition does not set forth even a **single** construction for any of the terms in the 16 claims it challenges. *Id.* Thus, conceding that it is aware of “complete constructions,” but is holding these back from the Director and Patent Owner only to spring additional disputes between the parties at a later stage.

By not providing “complete constructions” or even a single construction, Petitioner explicitly indicates that it will be taking different claim construction positions “for **any other purpose**, including for issues that have been raised in the related litigation.” *See id.* In view of Petitioners’ broad *Sotera* stipulation (EX1024), this “any other purpose” includes invalidity challenges Petitioner intends to present to the District Court based on the following system prior art:

d. '198 Patent

Prior Art Products and Systems – U.S. Patent No. 8,180,198
• ThumbsPlus • Photofinder • PhotoMesa • Picasa • iPhoto 2 • iView MediaPro • MusicMatch • Snapfish • Shutterfly • PhotoBucket • Adobe Photoshop Album • Netflix website from 2004 • ACDSee.com • Canon ZoomBrowser EX 2.2 • Flickr • Discovery is ongoing, and Defendants will identify additional products and systems as they become available.

(EX2015 at 175-176)

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This “any other purpose” also includes invalidity arguments under §112 for the following eleven terms disclosed by Petitioner in District Court proceeding:

d. '198 Patent

'198 Patent			
No.	Term	Claims	Reason
1	“an output module”	1	Lack of written description
2	“a control module”	1	Lack of written description
3	“other digital images whose related information is the same as the selected digital image”	1	Lack of written description
4	“a control module which selects a digital image to add in a playlist, based on one of the plurality of information”	1	Lack of written description
5	“the plurality of information concerning the digital image”	1	Lack of written description
6	“outputs a list identifying the other digital images retrieved based on their related information”	1	Lack of written description
7	“a plurality of said digital images added”	1	Lack of written description
8	“said plurality of related information, said list identifying the other digital images, and said playlist are outputted in a same display”	1	Lack of written description
9	“retrieves other digital images whose related information is the same as the selected digital image”	1	Lack of written description
10	“outputs a list identifying the other digital images retrieved based on their related information”	1	Lack of written description

'198 Patent			
11	“a reduced image is displayed on said display module as the information showing the digital image selected by said control module.”	4	Lack of written description

(EX2015 at 175-176)

Based on its disclosures in District Court litigation and concession that it is holding back “complete constructions” from the Board and Director, Petitioner is indicating that it wants to have the flexibility to take different claim construction positions “for any other purpose” including even for additional invalidity arguments. Such reservation of rights does not comply with the requirements of 37 C.F.R. § 42.104(b)(3) and this Board’s prior decisions and will result in development of

inconsistent records by Petitioner across multiple forums.

Specifically, under 37 C.F.R. § 42.104(b)(3), petitioners must clearly articulate **in the petition** “[h]ow the challenged claim is to be construed.” According to Petitioner, its claim construction positions in this Petition are not “complete constructions” and they do **not** limit its ability to assert a claim construction position for “any other purpose.” Petitioner leaves it to the Board to interpret such limitations to assess Petitioner’s invalidity challenges, which fails to ensure that the District Court litigation record (and/or the PTAB record) results in a consistent record when considering the validity of the patent for numerous prior art systems and eleven different §112 challenges. Petitioner is silent and provides no explanation for its basis for being non-committal in its claim construction positions to obtain an institution decision in this forum, only to turn around and reserve the ability to seek different claim construction of any claim term “for any other purpose” in, for example, the pending District Court litigation or in another potential IPR petition.

Indeed, Petitioner has done just that in prior IPRs where it argued for a plain and ordinary meaning of “character” in IPR2024-00735 and IPR2024-00777, but argued for a narrower construction of the same term in a jury trial to argue for non-infringement. *See e.g.*, IPR2024-00735, Paper No. 38 at 9-10; *see also* IPR2024-000828, Paper No. 39 at 6-10 (contending in the IPR that “mode” should be given

its plain and ordinary meaning but arguing in front of the jury that two modes require the implementation of two algorithms).

But a petitioner must explain why it takes different claim construction positions in the petition and in district court and asserting different claim construction positions in the two forums alone favors denial of institution. *See Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 20 (P.T.A.B. November 3, 2025) (Dir. Squires, precedential); *American Airlines, Inc. et al v. Intellectual Ventures I LLC*, IPR2025-01055, Paper 11 (P.T.A.B. November 21, 2025) (denying institution when Petitioner was construing terms as plain and ordinary in the Petition, yet arguing for §112 challenges in a different forum).

Instead of agreeing to be bound by the claim construction positions or lack thereof set forth in this Petition, Petitioner hedges and “does not contend that its proposed constructions are complete constructions of these limitations or the claims for any other purpose, including for issues that have been raised in the related litigation.” The Board or Patent Owner should not be burdened with such an unbounded position on claim construction when defending its patent rights. Indeed, this is the precise reason why 37 C.F.R. § 42.104(b)(3) requires Petitioner to explain how the challenged claims are to be construed. Petitioner cannot have it both ways.

Accordingly, for this reason alone the Board should deny institution of this petition.

VIII. THE PETITION DOES NOT SHOW A LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY CHALLENGED CLAIM

A. Ground 1: Petitioner Fails to Establish That Claims 1-4, 6, and 9-11 Would Have Been Obvious Based on Nagaoka.

1. Petitioner Fails to Establish that a POSITA Would Be Motivated to Modify Nagaoka.

Petitioner's motivation to modify rationale is based on boilerplate statements, represent pure hindsight, and are a verbatim parroting of its expert's, Dr. Bederson, opinions. Thus, for the same reasons set forth in Section VI, which are incorporated by reference herein, a POSITA would not be motivated to combine or modify Nagaoka in the manner suggested by Petitioner and Ground 1 should fail for this reason alone.

2. Petitioner Fails to Establish That Claim 1 Would Have Been Rendered Obvious In View of Nagaoka.

a. Petitioner Fails to Establish That Claim Limitation [1b] Would Have Been Rendered Obvious In View of Nagaoka.

Claim limitation [1b] recites "a control module which selects a digital image to add in a playlist, based on one of the plurality of information concerning the digital image recorded in said recording medium." Petitioner fails to establish that claim limitation [1b] would be rendered obvious by Nagaoka. Pet. at 52-55.

Petitioner's discussion is flawed because it misstates the disclosure of Nagaoka. Namely, there is no explanation provided how Nagaoka's "drag and drop" function, done by the user, corresponds to "select[ing] a digital image to add in a playlist" done by the control module. *See* Pet. at 53. Petitioner then provides a conclusory assertion regarding the primary citation to Nagaoka—EX1004, 5:22-29 relating to the facial recognition software—without explaining how it meets the "selects" element.

Recognizing the weakness of its argument, Petitioner claims that a "POSITA would have further found it obvious to organize digital images based on underlying metadata, including the date the photo was taken." *See* Pet. at 53. But that conclusory assertion does not remedy the gap regarding the "selects a digital image to add in a playlist" element that still exists.

For at least the foregoing reasons, Petitioner fails to show a reasonable likelihood of success in establishing that claim limitation [1b] would have been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

b. Petitioner Fails to Establish That Claim Limitation [1c.i] Would Have Been Rendered Obvious In View of Nagaoka.

Claim limitation [1c.i] recites "wherein for a selected digital image selected by the user, said control module; retrieves other digital images whose related

information is the same as the selected digital image, the other digital images being candidates for adding in said playlist.” Petitioner fails to establish that claim limitation [1c.i] would be rendered obvious by Nagaoka. Pet. at 55-57.

Petitioner's discussion is flawed because it misstates the disclosure of Nagaoka. Namely, after a user completes Nagaoka's “drag and drop” action, neither the media organizing control unit 38 nor Nagaoka's facial recognition software discloses “retrieve[ing] other digital images whose related information is the same as the selected digital image, the other digital images being candidates for adding in said playlist” element. *See* Pet. at 56-57. Indeed, Petitioner does not clearly state which of the two named components—the media organizing control unit 38 and/or the facial recognition software—perform the “retrieves” element or how such retrieval occurs. In sum, Petitioner expansively reads portions of column 5 of Nagaoka to support its contention that this limitation is met when the language of Nagaoka does not comprise such disclosure, nor does the Petitioner support its argument with evidence beyond conclusory assertions.

Recognizing the weakness of its argument, and the lack of disclosure of this claim element in Nagaoka, Petitioner resorts to conclusory language relating to purported modifications by a POSITA in an attempt to fill the gap. Specifically, Petitioner claims:

Additionally, a POSITA would have found it obvious to modify Nagaoka to retrieve images based on other related information such as dates, events, places, people, and facial recognition data. This would provide more of the same advantages that Nagaoka already provides – suggesting related images that a user might want to add to a playlist. This would be a straight forward modification since it could use the same mechanisms and user interface, merely changing which related information to use to form the suggestions. Thus, Nagaoka discloses this limitation. EX1003, ¶114.

See Pet. at 57.

Petitioner's statement, which merely restates a portion of the "retrieve images" claim language, is pure hindsight that is supported by no independent facts or analysis and does nothing to remedy the gap regarding the "retrieves other digital images" element that still exists. Further, Dr. Bederson's opinion, which is cited in this passage (EX1003, ¶114), is a verbatim copy and paste from the Petition and should be given no weight for the same reasons in Section VI.

For at least the foregoing reasons, Petitioner fails to show a reasonable likelihood of success in establishing that claim limitation [1c.i] would have been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

c. Petitioner Fails to Establish That Claim Limitation [1c.ii] Would Have Been Rendered Obvious In View of Nagaoka.

Petitioner fails to establish that claim limitation [1c.ii] would be rendered obvious by Nagaoka. Pet. at 57-60. For at least the foregoing reasons set forth in Sections VIII(A)(2)(a)-(b) (claim limitations [1b] and [1c.i]) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim limitation [1c.ii] would have been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

d. Petitioner Fails to Establish That Claim Limitation [1c.iii] Would Have Been Rendered Obvious In View of Nagaoka.

Petitioner fails to establish that claim limitation [1c.iii] would be rendered obvious by Nagaoka. Pet. at 60-61. For at least the foregoing reasons set forth in Sections VIII(A)(2)(a)-(b) (claim limitations [1b] and [1c.i]) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim limitation [1c.iii] would have been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

e. Petitioner Fails to Establish That Claim Limitation [1c.iv] Would Have Been Rendered Obvious In View of Nagaoka.

Petitioner fails to establish that claim limitation [1c.iv] would be rendered

obvious by Nagaoka. Pet. at 61. For at least the foregoing reasons set forth in Sections VIII(A)(2)(a)-(b) (claim limitations [1b] and [1c.i]) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim limitation [1c.iv] would have been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

f. Petitioner Fails to Establish That Claim 2 Would Have Been Rendered Obvious In View of Nagaoka.

Claim 2 recites “The digital image recording and reproduction apparatus according to claim 1, wherein said control module rearranges the information showing said selected digital image, based on related information concerning a digital image other than the related information concerning the digital image specified by the user and adds the rearranged information to said display module for display.” Petitioner fails to establish that claim 2 would be rendered obvious by Nagaoka. Pet. at 62-63.

Recognizing the weakness of its argument, and the lack of disclosure of this claim element in Nagaoka, Petitioner resorts to conclusory language relating to a POSITA's purported interpretation and/or modification of Nagaoka in an attempt to fill the gap. Specifically, Petitioner claims:

A POSITA would have understood that a user can rearrange the information showing said selected digital images based on related

information concerning a digital image other than the related information concerning the digital image specified by the user because the user can open the folder path by clicking on the plus symbol or collapse an opened path by clicking on the minus symbol.

See Pet. at 62-63 (citing to EX1003, ¶120).

Petitioner's statement, which merely restates a portion of the "retrieve images" claim language, is pure hindsight that is supported by no independent facts or analysis and does nothing to remedy the gap regarding that still exists for this element. Further, Dr. Bederson's opinion, which is cited in this passage (*see id*), is a verbatim copy and paste from the Petition and should be given no weight for the same reasons in Section VI.

For at least the foregoing reasons, as well as those set forth in Sections VIII(A)(2)(a)-(b) (claim limitations [1b] and [1c.i]) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim 2 would have been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

g. Petitioner Fails to Establish That Claim 3 Would Have Been Rendered Obvious In View of Nagaoka.

Petitioner fails to establish that claim 3 would be rendered obvious by Nagaoka. Pet. at 63-64. Claim 3 depends on claim 2, which depends on claim 1.

Thus, for at least the foregoing reasons in Claim 2, as well as those set forth in Sections VIII(A)(2)(a)-(b) (claim limitations [1b] and [1c.i]) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim 3 would have been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

h. Petitioner Fails to Establish That Claim 4 Would Have Been Rendered Obvious In View of Nagaoka.

Claim 4 recites “The digital image recording/reproduction apparatus according to claim 1, wherein a reduced image is displayed on said display module as the information showing the digital image selected by said control module.” Petitioner fails to establish that claim 4 would be rendered obvious by Nagaoka. Pet. at 64.

Recognizing the weakness of its argument, Petitioner resorts to conclusory language relating to a POSITA purported understanding of the art in an attempt to fill the gap: “a POSITA would have understood that the images in Nagaoka could be displayed at a reduced size because displaying reduced images was well known in the art. *See* Pet. at 64 (citing to EX1013 (US 2006/0026636A) (“Stark”), [0051], [062]). However, Petitioner forwards a single-reference obviousness argument based only on Nagaoka so Stark’s alleged teachings are irrelevant and Petitioner has forwarded no motivation to combine Nagaoka with Stark. Regardless, Stark

discloses a fundamentally different system and a POSITA would not look to it to fill in the gaps present in Nagaoka.

Moreover, Petitioner's statement, which merely restates a portion of the "reduced image" claim language, is pure hindsight that is supported by no independent facts or analysis and does nothing to remedy the gap regarding that still exists for this element. Further, Dr. Bederson's opinion, which is not explicitly cited in this passage (but exists in his declaration), is a verbatim copy and paste from the Petition and should be given no weight for the same reasons in Section VI. *See* EX1003, ¶122.

For at least the foregoing reasons, as well as those set forth in Sections VIII(A)(2)(a)-(b) (claim limitations [1b] and [1c.i]) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim 4 would have been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

i. Petitioner Fails to Establish That Claim Limitation [6b] Would Have Been Rendered Obvious In View of Nagaoka.

Petitioner fails to establish that claim limitation [6b] would be rendered obvious by Nagaoka. Pet. at 65. Petitioner does not cite to any additional arguments or evidence for claim limitation [6b] other than referring back to claim limitation

[1b] and Dr. Bederson's verbatim declaration. *See* Pet. at 65 ("Nagaoka discloses this limitation. EX1003, ¶125. *See* Limitation [1b].").

Thus, for at least the foregoing reasons set forth in Section VIII(A)(2)(a) (claim limitation [1b]) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim limitation [6b] would have been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

j. Petitioner Fails to Establish That Claim Limitations [6c] and [6d] Would Have Been Rendered Obvious In View of Nagaoka.

Petitioner fails to establish that claim limitations [6c] and [6d] would be rendered obvious by Nagaoka. Pet. at 65. Petitioner does not cite to any additional arguments or evidence for claim limitations [6c] and [6d] other than referring back to claim limitation [1c.i] and Dr. Bederson's verbatim declaration. *See* Pet. at 65 ("Nagaoka discloses this limitation. EX1003, ¶126. *See* Limitation [1c.i].") and "Nagaoka discloses this limitation. EX1003, ¶127. *See* Limitation [1c.i].").

Thus, for at least the foregoing reasons set forth in Section VIII(A)(2)(b) (claim limitation [1c.i])) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim limitations [6c] and [6d] would have been rendered obvious based on Nagaoka. Accordingly, the

Petition should be denied.

k. Petitioner Fails to Establish That Claim Limitations [6e] Would Have Been Rendered Obvious In View of Nagaoka.

Petitioner fails to establish that claim limitation [6e] would be rendered obvious by Nagaoka. Pet. at 65. Petitioner does not cite to any additional arguments or evidence for claim limitation [6e] other than referring back to claim limitation [1c.ii] and Dr. Bederson's verbatim declaration. See Pet. at 65 ("Nagaoka discloses this limitation. EX1003, ¶128. See Limitation [1c.ii].").

Thus, for at least the foregoing reasons set forth in Section VIII(A)(2)(c) (claim limitation [1c.ii]) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim limitation [6e] would have been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

l. Petitioner Fails to Establish That Claim Limitations [6f] Would Have Been Rendered Obvious In View of Nagaoka.

Petitioner fails to establish that claim limitation [6f] would be rendered obvious by Nagaoka. Pet. at 65. Petitioner does not cite to any additional arguments or evidence for claim limitation [6f] other than referring back to claim limitation [1c.iii] and Dr. Bederson's verbatim declaration. See Pet. at 65 ("Nagaoka discloses

this limitation. EX1003, ¶129. *See* Limitation [1c.iii].”).

Thus, for at least the foregoing reasons set forth in Section VIII(A)(2)(d) (claim limitation [1c.iii]) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim limitation [6f] would have been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

m. Petitioner Fails to Establish That Claim Limitations [6g] Would Have Been Rendered Obvious In View of Nagaoka.

Petitioner fails to establish that claim limitation [6g] would be rendered obvious by Nagaoka. Pet. at 66. Petitioner does not cite to any additional arguments or evidence for claim limitation [6g] other than referring back to claim limitation [1c.iv] and Dr. Bederson's verbatim declaration. *See* Pet. at 66 (“Nagaoka discloses this limitation. EX1003, ¶130. *See* Limitation [1c.iv].”).

Thus, for at least the foregoing reasons set forth in Section VIII(A)(2)(e) (claim limitation [1c.iv]) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim limitation [6g] would have been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

n. Petitioner Fails to Establish That Claim 9 Would Have Been Rendered Obvious In View of Nagaoka.

Petitioner fails to establish that claim 9 would be rendered obvious by Nagaoka. Pet. at 66. Claim 9 ultimately depends on claim 6. Thus, for at least the foregoing reasons set forth in Sections VIII(A)(2)(a)-(b) (claim limitations [1b] and [1c.i]) and VIII(A)(2)(i)-(m) (claim 6 limitations) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim 9 would have been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

o. Petitioner Fails to Establish That Claim 10 Would Have Been Rendered Obvious In View of Nagaoka.

Petitioner fails to establish that claim 10 would be rendered obvious by Nagaoka. Pet. at 66. Claim 10 ultimately depends on claim 6. However, Petitioner does not cite to any additional arguments or evidence for claim 10 other than referring back to claim 2 and Dr. Bederson's verbatim declaration. *See* Pet. at 66 ("Nagaoka discloses this limitation. EX1003, ¶132. *See* Claim 2.").

Thus, for at least the foregoing reasons set forth in Sections VIII(A)(2)(a)-(b) (claim limitations [1b] and [1c.i]), VIII(A)(2)(f) (claim 2), and VIII(A)(2)(i)-(m) (claim 6 limitations) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim 10 would have

been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

p. Petitioner Fails to Establish That Claim 11 Would Have Been Rendered Obvious In View of Nagaoka.

Petitioner fails to establish that claim 11 would be rendered obvious by Nagaoka. Pet. at 66. Claim 11 depends on claim 6. However, Petitioner does not cite to any additional arguments or evidence for claim 11 other than referring back to claim 2 and Dr. Bederson's verbatim declaration. See Pet. at 66 ("Nagaoka discloses this limitation. EX1003, ¶133. See Claim 2.").

Thus, for at least the foregoing reasons set forth in Sections VIII(A)(2)(a)-(b) (claim limitations [1b] and [1c.i]), VIII(A)(2)(f) (claim 2), and VIII(A)(2)(i)-(m) (claim 6 limitations) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim 11 would have been rendered obvious based on Nagaoka. Accordingly, the Petition should be denied.

B. Ground 2: Petitioner Fails to Establish That Claims 5 and 12 Would Have Been Obvious Based on Nagaoka in View of Benjamin.

Ground 2 depends on Nagaoka in combination with Benjamin. Pet. at 16.

Claim 5 depends from claim 1, and claim 12 depends on claim 6. Therefore, for at least the reasons provided above in relation to claims 1 and 6 in Ground 1,

which are incorporated herein by reference, Petitioner fails to establish that claims 5 and 12 would have been rendered obvious based on Nagaoka and Benyamin.

Because Ground 2 is only asserted against dependent claims, Ground 2 inherently relies on Ground 1. Because Ground 1 fails, Ground 2 similarly fails for the reasons provided above in relation to Ground 1. Patent Owner provides additional reasoning why Ground 2 fails as follows.

1. Petitioner Fails to Establish Any Motivation for a POSITA to Combine Nagaoka with Benyamin.

Nagaoka and Benyamin are directed to two fundamentally different systems and a POSITA would not be motivated to combine the two references in the manner suggested by Petitioner.

First, as discussed below, Petitioner's combination relies on a mischaracterization of Benyamin's disclosure—it does not disclose a “telop” as required by claims 5 and 12. Thus, a POSITA would not be motivated to combine Benyamin with Nagaoka to fill in Nagaoka's lack of a “telop” disclosure because Benyamin does not itself include such a disclosure.

Second, Nagaoka relates to organizing digital images using face recognition. *See* Pet. at 67. Benyamin relates to playlists, specifically discussing in detail the creation of playlists with respect to digital music (audio) information such as tracks while also mentioning “audio/visual” handfuls of times. *See generally* EX1005.

Benyamin does not relate to or mention facial recognition for organizing digital information at all.

In an attempt to avoid these fundamental differences, Petitioner again relies on conclusory opinions from its expert Dr. Bederson. *See* Pet. at 67-68. However, Dr. Bederson copies verbatim Petitioner's boilerplate motivation to combine statements and fails to provide sufficient facts and/or data to support his positions. *Compare* Pet. at 66-68 with EX1003, ¶¶134-138. Dr. Bederson does not provide any factual basis—apart from copying Petitioner's arguments—regarding how a POSITA would modify Nagaoka's system to incorporate the technology in Benyamin.

For example, the Petitioner (and Dr. Bederson) assert that “Selecting menus and telops to add digital images to a playlist were well known in the art to a POSITA in this timeframe, and a POSITA would naturally wish to be able to display a selecting menu or telop in any visual display when selecting options on a display. Section III.D; EX1003, ¶136.” Pet. at 67. This statement is pure hindsight. Indeed, neither the Petitioner nor Dr. Bederson explain why or provide any underlying factual support for this statement, nor is there any such support found in the cited-to Section III.D of the Petition (which he copies verbatim in Section IV.D of his

declaration). *Compare* Pet. at 22-36 with EX1003, ¶¶53-62.³

Thus, for the same reasons as set for in Section VI, Dr. Bederson's testimony should be given little to no weight. And, absent his conclusory testimony, the Ground 2 has no evidentiary support. Institution on Ground 2 should be denied for this reason.

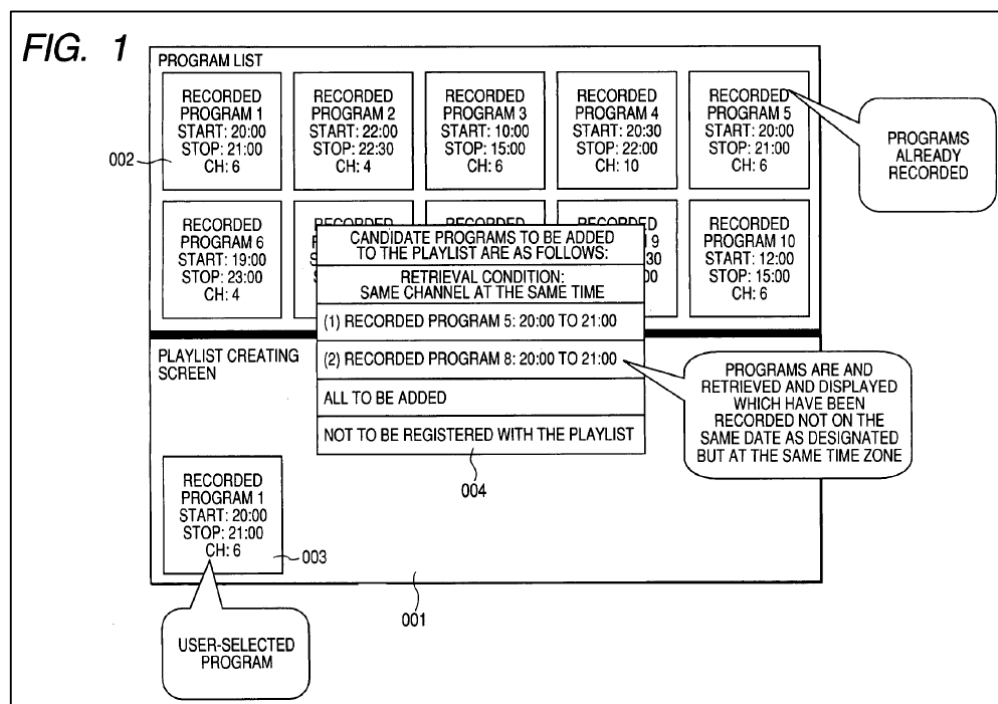
2. Petitioner Fails to Establish That Claims 5 and 12 Would Have Been Rendered Obvious in View of Nagaoka and Benjamin.

Regarding claim 5, which depends on claim 1, Petitioner (and Dr. Bederson) claim that "A POSITA would have found it obvious to use a telop, such as the one disclosed in Benjamin, to register images" and that "[i]n one embodiment, Benjamin discloses that 'the software provides a window indicating to the user that the track meets the criteria for a play list and requests that the user confirm that the track should be added to the play list.' EX1005, 15:57-60." Pet. at 68-69; *see also* EX1003, ¶139 (same verbatim). Patent Owner disagrees that Benjamin discloses

³ Dr. Bederson's verbatim recitation of Petitioner's positions also includes Petitioner's typographical errors. Petitioner refers to the "Sharpe" patent (U.S. Patent 7,461,099) as EX1022. *See* Pet. at 34. But Petitioner submitted listed EX1022 as "U.S. Patent No. 6,987,221 ("Platt")." *See* Pet. at xii. Dr. Bederson copied Petitioner's error regarding its citation to Sharpe/EX1022. *See* EX1003, ¶61.

any telop and that Benjamin's reference to a "window" is the claimed telop.

For example, the '198 Patent discusses a telop in the context of Figure 1 where "Reference numeral 004 denotes a telop displayed on a display screen (i.e. a small frame displayed on a display screen in piles)." EX1001, 2:45-47. Figure 1 is reproduced below:



Id., Fig. 1; *see also id.* at 2:53-62, 5:1-8, 6:20-30, Figs. 2, 8, 9. Petitioner does not provide any evidence that the "window" in Benjamin is a telop. Thus, Petitioner's conclusory assertion that "A POSITA would have been motivated because Benjamin demonstrates that such telops were well known in the art" is not supported by any facts or evidence. *See* Pet. at 69; *see also* EX1003, ¶139 (same verbatim).

Further, Petitioner's additional assertion that "the telop to register all photos at once to the playlist furthers Nagaoka's goal 'to organize even hundreds of photos in a short time based on the people appearing therein'" is equally devoid of facts or supporting evidence and should be given no weight. *See* Pet. at 69.

Thus, for at least the foregoing reasons and those set forth in Sections VIII(A)(2)(a)-(b) (claim limitations [1b] and [1c.i]) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim 5 would have been rendered obvious based on Nagaoka in view of Benjamin. Accordingly, the Petition should be denied.

Regarding claim 12, which depends on claim 6, Petitioner does not cite to any additional arguments or evidence for claim 12 other than referring back to claim 5 and Dr. Bederson's verbatim declaration. *See* Pet. at 66 ("Nagaoka in view of Benjamin discloses this claim. EX1003, ¶140. *See* Claim 5.").

Thus, for at least the foregoing reasons set forth in Sections VIII(A)(2)(a)-(b) (claim limitations [1b] and [1c.i]) and VIII(A)(2)(i)-(m) (claim 6 limitations) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim 12 would have been rendered obvious based on Nagaoka in view of Benjamin. Accordingly, the Petition should be denied.

C. Ground 3: Petitioner Fails to Establish That Claims 7 and 13 Would Have Been Obvious Based on Nagaoka in View of Nara.

Ground 3 depends on Nagaoka in combination with Nara. Pet. at 16.

Claim 7 depends from claim 6, and claim 13 is an independent claim where Petitioner largely points to its arguments for Ground 1 (*i.e.*, for claims 1 and 6). *See* Pet. at 72-75. Therefore, for at least the reasons provided above in relation to claims 1 and 6 in Ground 1, which are incorporated herein by reference, Petitioner fails to establish that claims 7 and 13 would have been rendered obvious based on Nagaoka and Nara.

Because Ground 1 fails, Ground 3 similarly fails for the reasons provided above in relation to Ground 1. Patent Owner provides additional reasoning why Ground 3 fails as follows.

1. Petitioner Fails to Establish Any Motivation for a POSITA to Combine Nagaoka with Nara.

Nagaoka and Nara are directed to two fundamentally different systems and a POSITA would not be motivated to combine the two references in the manner suggested by Petitioner.

Nagaoka relates to organizing digital images using face recognition. *See* Pet. at 67. Nara relates to “a digital broadcast receiver capable of reducing time and labor to back-up contents recorded on one recording medium to another recording

medium.” *See* EX1006, Abstract. Nara does not relate to or mention facial recognition for organizing digital information at all.

In an attempt to avoid these fundamental differences, Petitioner again relies on conclusory opinions from its expert Dr. Bederson. *See* Pet. at 69-71. However, Dr. Bederson copies verbatim Petitioner's boilerplate motivation to combine statements and fails to provide sufficient facts and/or data to support his positions. *Compare* Pet. at 69-71 with EX1003, ¶¶141-145. Dr. Bederson does not provide any factual basis—apart from copying Petitioner's arguments—regarding how a POSITA would modify Nagaoka's system to incorporate the technology in Nara.

For example, Petitioner asserts that a POSITA would combine Nagaoka, which does not disclose dubbing, with Nara that purportedly does. *See* Pet. at 69, 72-73. Petitioner claims that “a POSITA would have been motivated to combine Nagaoka with Nara because Nara discloses various benefits to recording the content list on another medium, including creating backups of the digital images, related information, and playlists.” *See* Pet. at 73; *see also* EX1003, ¶48 (same verbatim). But Petitioner's (and Dr. Bederson) reasoning is pure hindsight. None of Nara's alleged benefits raised by Petitioner relate to or solve any problem identified in Nagaoka so a POSITA would not have any motivation to look to Nara to combine with Nagaoka.

Thus, for the same reasons as set for in Section VI, Dr. Bederson's testimony should be given little to no weight. And, absent his conclusory testimony, the Ground 3 has no evidentiary support. Institution on Ground 3 should be denied for this reason.

2. Petitioner Fails to Establish That Claims 7 and 13 Would Have Been Rendered Obvious in View of Nagaoka and Nara.

Regarding claim 7, which depends on claim 6, Nagaoka does not teach "said image information is a program title and/or a program time zone." Pet. at 71-72.

Recognizing Nagaoka's lack of disclosure, Petitioner asserts that "a POSITA would have found it obvious to implement Nagaoka's facial recognition techniques with video programs, such as in video program thumbnails and to use a title or time zone as related information metadata." *See id.* Patent Owner disagrees that Nagaoka discloses any program title or time zone or that a POSITA would find it obvious to modify Nagaoka in this manner.

Moreover, Petitioner's statement, which merely restates a portion of the "program title and/or a program time zone" claim language, is pure hindsight that is supported by no independent facts or analysis and does nothing to remedy the gap regarding that still exists for this element. Petitioner's "motivation"—that both references "disclose solutions to organizing digital media"—does not reconcile that these references use fundamentally different methods to do so nor does Petitioner or

Dr. Bederson explain how such modifications would occur. *See id.* at 72. Further, Dr. Bederson's opinion (*see id.* (citing EX1003, ¶146)), is a verbatim copy and paste from the Petition and should be given no weight for the same reasons in Section VI.

Thus, for at least the foregoing reasons, as well as those set forth in Sections VIII(A)(2)(a)-(b) (claim limitations [1b] and [1c.i]) and VIII(A)(2)(i)-(m) (claim 6 limitations) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim 7 would have been rendered obvious based on Nagaoka in view of Nara. Accordingly, the Petition should be denied.

Regarding claim limitation [13pre], Petitioner's first argument—*i.e.*, that simply equates “dubbing” with “play” in the context of a list incorrectly reads “dubbing” out of the claim. *See Pet.* at 72-73. When the Patent Owner wanted to claim dubbing functionality as opposed to not, it knew how to do so and, thus, Petitioner's first argument should be rejected.

As to Petitioner's second argument, that Nara discloses “dubbing” and that a POSITA would be motivated to combine Nagaoka with Nara, Petitioner's argument is pure hindsight. *See Pet.* at 73. None of Nara's alleged benefits raised by Petitioner relate to or solve any problem identified in Nagaoka so a POSITA would not have any motivation to look to Nara to combine with Nagaoka. And, for the same reasons

as set for in Section VI, Dr. Bederson's testimony should be given little to no weight.

Thus, for at least the foregoing reasons, as well as those set forth in Sections VIII(A)(2)(a)-(b) (claim limitations [1b] and [1c.i]) and VIII(A)(2)(i)-(m) (claim 6 limitations) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim limitation [13pre] would have been rendered obvious based on Nagaoka in view of Nara. Accordingly, the Petition should be denied.

Regarding claim limitations [13a] – [13g], Petitioner does not cite to any additional arguments or evidence for these limitations other than referring back to claim limitations [1a] – [1c.iv] and [6a] – [6g] and Dr. Bederson's verbatim declaration. *See* Pet. at 74-75 (“Nagaoka in view of Nara discloses this claim. EX1003, [¶¶149-155]. *See* Limitations [[1a] – [1c.iv] and [6a] – [6g]].”).

Thus, for at least the foregoing reasons set forth in Sections VIII(A)(2)(a)-(b) (claim limitations [1b] and [1c.i]) and VIII(A)(2)(i)-(m) (claim 6 limitations) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim limitations [13a] – [13g] would have been rendered obvious based on Nagaoka in view of Nara. Accordingly, the Petition should be denied.

D. Ground 4: Petitioner Fails to Establish That Claims 14-15 Would Have Been Obvious Based on Nagaoka in View of Nara, Benjamin, and Imada.

Ground 4 depends on Nagaoka in combination with Nara, Benjamin, and Imada. Pet. at 16.

Claims 14 and 15 depend from claim 13, which is an independent claim where Petitioner largely points to its arguments for Ground 1 (*i.e.*, for claims 1 and 6). *See* Pet. at 72-75. Therefore, for at least the reasons provided above in relation to claims 1 and 6 in Ground 1, which are incorporated herein by reference, Petitioner fails to establish that claims 14-15 would have been rendered obvious based on Nagaoka, Nara, Benjamin, and Imada.

Because Ground 1 fails, Ground 4 similarly fails for the reasons provided above in relation to Ground 1. Patent Owner provides additional reasoning why Ground 4 fails as follows.

1. Petitioner Fails to Establish Any Motivation for a POSITA to Combine Nagaoka With Nara, Benjamin, and Imada.

First, for the same reasons set forth in Sections VIII(B)(1) and VIII(C)(1), which are incorporated herein by reference, Petitioner have failed to establish any motivation to combine (1) Nagaoka with Benjamin or (2) Nagaoka with Nara. In addition, Petitioner has not forwarded a sufficient motivation to combine Nagaoka with Imada let alone a motivation to combine Nagaoka with Nara, Benjamin, and

Imada as set forth in Ground 4.

Second, Nagaoka and Imada are directed to two fundamentally different systems and a POSITA would not be motivated to combine the two references in the manner suggested by Petitioner.

Nagaoka relates to organizing digital images using face recognition. *See* Pet. at 67. Imada relates to a recording apparatus for recording a plurality of audio-visual contents stored in a HD to a writable DVD. *See* EX1007, Abstract. Imada does not relate to or mention facial recognition for organizing digital information at all.

In an attempt to avoid these fundamental differences, Petitioner again relies on conclusory opinions from its expert Dr. Bederson. *See* Pet. at 75-76. However, Dr. Bederson copies verbatim Petitioner's boilerplate motivation to combine statements and fails to provide sufficient facts and/or data to support his positions. *Compare* Pet. at 75-76 with EX1003, ¶¶156-159. Dr. Bederson does not provide any factual basis—apart from copying Petitioner's arguments—regarding how a POSITA would modify Nagaoka's system to incorporate the technology in Imada alone or Imada in combination with Nara and Benyamin (*i.e.*, the four-reference combination set forth in Ground 4).

For example, Petitioner (and Dr. Bederson) asserts that "it was well known in the art to utilize bit rate to determine recording capacity." *See* Pet. at 76; EX1003,

¶157 (same verbatim). But neither Petitioner nor Dr. Bederson provide any evidence or facts to support this statement.

Thus, for the same reasons as set for in Section VI, Dr. Bederson's testimony should be given little to no weight. And, absent his conclusory testimony, the Ground 4 has no evidentiary support. Institution on Ground 4 should be denied for this reason.

2. Petitioner Fails to Establish That Claims 14 and 15 Would Have Been Rendered Obvious in View of Nagaoka and Nara, Benjamin, and Imada.

Regarding claim 14, Petitioner (and Dr. Bederson) first state that "As discussed, Benjamin discloses the telop used to register all the retrieved images." Pet. at 77; EX1003, ¶160 (same verbatim). For the same reasons set forth in Ground 2 (Section VIII(B)), which are incorporated by reference herein, Patent Owner disagrees that Benjamin discloses a telop at all let alone to "register all the retrieved images" as Petitioner contends.

Petitioner asserts that Imada "determines a bit rate to record programs." *See* Pet. at 77 (citing EX1007 at [0008] ("A bit rate to be allocated to the remaining content upon re-encoding is determined")). But Imada does not disclose a telop (to make up for Benjamin's deficiencies). And Imada's passing reference to a "bit rate" does not disclose claim 14 which recites "wherein said selecting menu includes a

telop to determine a bit rate so as to registering all the retrieved image data.”
EX1001, 8:47-49. Namely, Imada is silent on a bit rate being used to register all the retrieved image data.

Accordingly, Ground 4 with respect to claim 14 fails.

Regarding claim 15, claim 15 fails for the same reasons as claim 14.

E. Ground 5: Petitioner Fails to Establish That Claims 8 and 16 Would Have Been Obvious Based on Nagaoka in View of Nara and Benjamin.

Ground 5 depends on Nagaoka in combination with Nara and Benjamin. Pet. at 16.

Claim 8 depends from claim 6, and claim 16 depends from claim 13, which is an independent claim where Petitioner largely points to its arguments for Ground 2 (*i.e.*, for claim 5, the combination of Nagaoka and Benjamin). *See* Pet. at 77-78. Therefore, for at least the reasons provided above in relation to claim 5 in Ground 2, claims 1 and 6 regarding Ground 1, and claim 13 in Ground 3, all of which are incorporated herein by reference, Petitioner fails to establish that claims 8 and 16 would have been rendered obvious based on Nagaoka, Nara, and Benjamin.

Because Ground 5 is only asserted against dependent claims, Ground 5 inherently relies on Grounds 1, 2, and 3. Because Grounds 1-3 fail, Ground 5 similarly fails for the reasons provided above in relation to Grounds 1-3.

1. Petitioner Fails to Establish Any Motivation for a POSITA to Combine Nagaoka with Nara and Benjamin.

For Ground 5, Petitioner's motivation to combine Nagaoka with Nara and Benjamin merely incorporate its arguments from other Grounds as follows: "It would have been obvious to combine Nagaoka, Nara, and Benjamin. A POSITA would have been motivated and expected success for the reasons described above with respect to Grounds 2 (Nagaoka and Benjamin), Ground 3 (Nagaoka and Nara), and Ground 4 (Nagaoka, Nara, Benjamin, and Imada). EX1003, ¶163." Pet at 77-78. Despite claims 8 and 16 comprise different limitations/claim scope than that referenced in Grounds 2-4, Petitioner did not include any additional evidence or arguments explaining why a POSITA would be motivated to combine Nagaoka with Nara and Benjamin in a three-reference combination. For example, claim 16 depends on claim 13 which includes the "dubbing" requirement not present in claim 5 or claim 1 which claim 5 depends on. EX1001, 8:54-58. Thus, Petitioners mere reliance on claim 5—where it forwards the combination of Nagaoka and Benjamin, both of which are silent as to "dubbing"—is wholly insufficient to demonstrate that claim 16 is rendered obvious.

Thus, for the same reasons as set forth in Grounds 2-4, which are incorporated herein by reference, Petitioner has not established a motivation to combine Nagaoka with Nara and Benjamin.

2. Petitioner Fails to Establish That Claims 8 and 16 Would Have Been Rendered Obvious in View of Nagaoka, Nara, and Benjamin.

Regarding claim 8, which ultimately depends on claim 6, both Petitioner and Dr. Bederson state the same: “Nagaoka in view of Nara and Benjamin discloses this claim” and to “See claim 5.” *See* Pet. at 78; EX1003, ¶164. Petitioner did not include any additional evidence or arguments explaining how the Nagaoka-Nara-Benjamin combination renders obvious claim 8.

Thus, for the same reasons that Ground 1 (covering claims 1-4, 6, 9-11) and Ground 2 (covering claims 5 and 12) fail, which are incorporated by reference herein, Ground 5 with respect to claim 8 equally fails.

Regarding claim 16, which depends on claim 13, both Petitioner and Dr. Bederson state the same: “Nagaoka in view of Nara and Benjamin disclose this claim” and to “See claim 5.” *See* Pet. at 78; EX1003, ¶165. Petitioner did not include any additional evidence or arguments explaining how the Nagaoka-Nara-Benjamin combination renders obvious claim 16.

Thus, for the same reasons that Ground 1 (covering claims 1-4, 6, 9-11) and Ground 3 (covering claims 7 and 13) fail, which are incorporated by reference herein, Ground 5 with respect to claim 16 equally fails.

F. Ground 6: Petitioner Fails to Establish That Claims 1-16 Would Have Been Obvious Based on Watanabe in view of Looney, Platt, and Kaplan.

1. Petitioner Fails to Establish that a POSITA Would Combine Watanabe, Looney, Platt, and Kaplan.

Petitioner's motivation to combine rationale is based on boilerplate statements, represent pure hindsight, and are a verbatim parroting of its expert's, Dr. Bederson, opinions. Thus, for the same reasons set forth in Section VI, which are incorporated by reference herein, a POSITA would not be motivated to combine Watanabe, Looney, Platt, and Kaplan as suggested by Petitioner and Ground 6 should fail for this reason alone.

Watanabe, Looney, Platt, and Kaplan are directed to four fundamentally different systems—not simply “organizing digital images into lists and managing the content”—and a POSITA would not be motivated to combine the four references in the manner suggested by Petitioner. *See* Pet. at 78-81.

As discussed below with respect to claim 1, Petitioner's combination relies on a mischaracterization of the Watanabe disclosure—Watanabe does not disclose digital images as required by claims 1-16. Petitioner's citation to the Abstract of Watanabe, Looney, and Platt, and paragraph 1 of Kaplan illustrates the superficial and cursory nature of Petitioner's purported motivation to combine these disparate references. Petitioner also incorrectly states that “Moreover, the use of telops was

well known in the art, as discussed above with respect to the disclosure of Benjamin. EX1005.” *See id.* at 80. As explained in Section VIII(B)(1)-(2) (Ground 2), which is incorporated by reference herein, Petitioner’s mischaracterize Benjamin as it does not disclose telops.

In an attempt to avoid these fundamental differences between its four-reference obviousness combination, Petitioner again relies on conclusory opinions from its expert Dr. Bederson. *See Pet.* at 78-81. However, Dr. Bederson copies verbatim Petitioner’s boilerplate motivation to combine statements and fails to provide sufficient facts and/or data to support his positions. *Compare Pet.* at 78-81 with EX1003, ¶¶166-169.⁴ Dr. Bederson does not provide any factual basis—apart from copying Petitioner’s arguments—regarding how a POSITA would modify Watanabe’s system to incorporate the technology in Looney, Platt, and Kaplan.

For example, the Petitioner (and Dr. Bederson) assert that:

⁴ Similar to Ground 2, Dr. Bederson’s verbatim recitation of Petitioner’s positions also includes Petitioner’s typographical errors. Petitioner states that “it would have been obvious to a POSITA to combine such embodiments into a single system for providing the ability to share and watch another user’s broadcast program.” *Pet.* at 80. Petitioner confuses its boilerplate rationale for likely a different patent with its conclusory statement here as the word “broadcast” is nowhere in claims 1-16 of the ’198 Patent. Dr. Bederson copied Petitioner’s error verbatim. *See EX1003, ¶169.*

[S]uch a combination involves a combination of prior art elements according to known methods to yield predictable results. Therefore, a POSITA would have been motivated to make this combination. EX1003, ¶167. For the same reasons, a POSITA would have had a reasonable expectation of success in making the proposed combination. Such a combination would have required minimal modifications. The proposed combination would not have required undue experimentation and would have yielded the predictable result. EX1003, ¶168.

Pet. at 80; EX1003, ¶¶167-168 (same verbatim). These statements are pure hindsight. Indeed, neither the Petitioner nor Dr. Bederson explain why or provide any underlying factual support for these statements.

Thus, for the same reasons as set for in Section VI, Dr. Bederson's testimony should be given little to no weight. And, absent his conclusory testimony, the Ground 6 has no evidentiary support. Institution on Ground 6 should be denied for this reason.

- 2. Petitioner Fails to Establish that Claims 1-16 Would Have Been Rendered Obvious By Watanabe in view of Looney, Platt, and Kaplan.**
 - a. Petitioner Fails to Establish That Claim 1 Would Have Been Rendered Obvious In View of Watanabe, Looney, Platt, and Kaplan.**

Petitioner fails to establish that claim 1 would be rendered obvious by Watanabe, Looney, Platt, and Kaplan. Pet. at 81-87. Claim limitations [1pre] –

[1c.iv] each recite, in some fashion, “digital images.” *See id.* For example, these claim limitations require an output module for “display[ing] a plurality of digital images,” they also require recording of “a plurality of related information concerning said digital images” and each digital image to “correspond[] to one of said plurality of related information.” *See* claim 1. Further, claim 1 requires a control module that “selects a digital image to add in a playlist, based on one of the plurality of information concerning the digital image” and “retriev[ing] other digital images whose related information is the same as the selected digital image.” *Id.* Claim 1 also requires outputting “a list identifying the other digital images retrieved based on their related information to select another digital image to add in said playlist,” “output[ing] said playlist including a plurality of said digital images added,” and “output[ing] one of the other digital images to be positioned next to another one of the other digital images.” *Id.* Critically, however, Watanabe does not disclose digital images and this lack of disclosure is fatal to Petitioner’s arguments for Ground 6.

For claim limitations [1pre], [1a], [1b], [1c.ii], [1c.iii], and [1c.iv], Petitioner states that “Watanabe in view of Looney discloses this limitation,” but Petitioner merely provides some additional citations to Watanabe. Petitioner does not, however, provide any evidence or argument that Looney discloses digital images to remedy the core deficiency of Watanabe. *See id.* Petitioner claims that the “library

list display section 87” demonstrates the presence of digital images but there is no such disclosure in Watanabe or Figure 13—*e.g.*, there are no thumbnails or pictures of individuals or places. *See id.* at 81-86. As excerpted below, the SD library manager of Watanabe does not disclose any “digital images”:

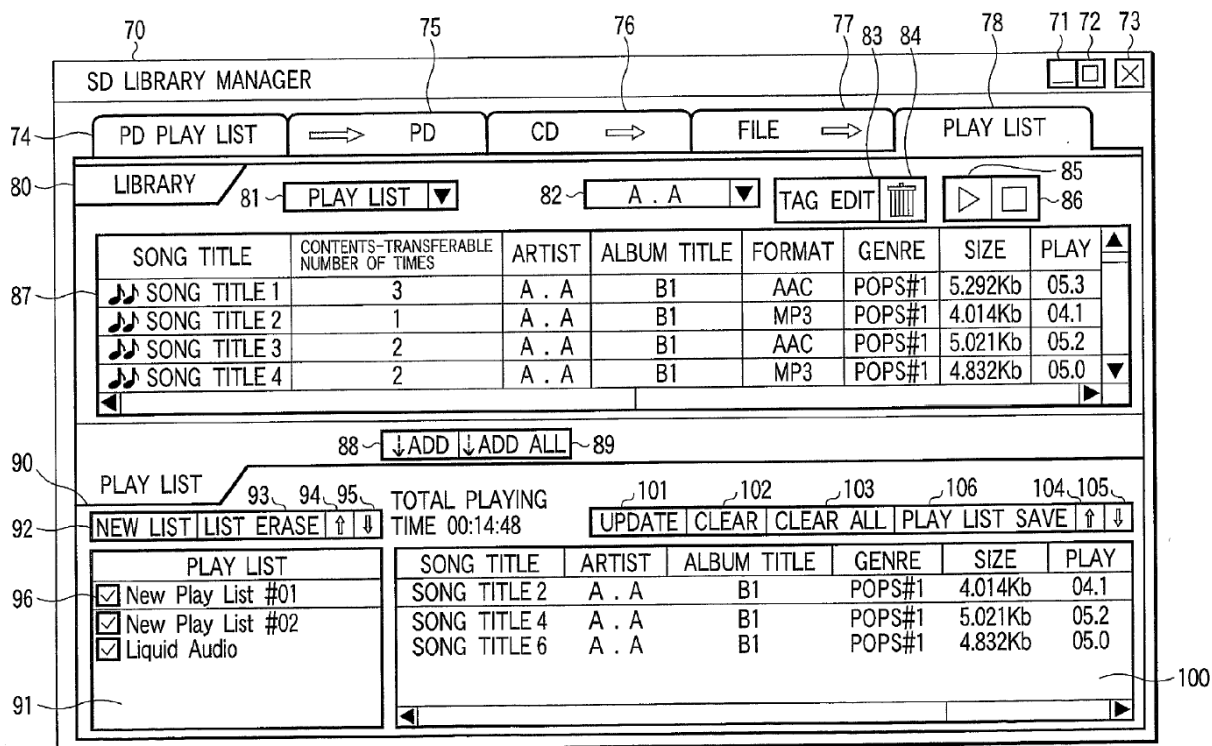


FIG. 13

EX1008 at FIG. 13; *see also id.* at Watanabe Figs. 14-17.

Further, Watanabe’s passing reference to “icon”—mentioned only once in the entire patent publication—does not disclose the claimed digital image as Watanabe does not explain what an icon represents. Rather, Watanabe discloses a music icon (♪) which is not a digital image. And Petitioner does not provide any

evidence or argument regarding how Watanabe's library list display section 87 or SB library manager discloses an output module for "display[ing] a plurality of digital images," a recording medium for recording related information "concerning said digital images," a control module that "selects a digital image to add in a playlist," "retriev[ing] other digital images whose related information is the same as the selected digital image," outputting "a list identifying the other digital images retrieved based on their related information to select another digital image to add in said playlist," "output[ing] said playlist including a plurality of said digital images added," and "output[ing] one of the other digital images to be positioned next to another one of the other digital images," when the entirety of Watanabe is silent as to any disclosure of "digital image" or "picture," let alone disclosing components that can record, display, select, and/or manipulate "digital images" in other ways as claimed. *See* EX1008 (generally); Pet. at 81-82.

For claim limitation [1c.i], Petitioner states that "Watanabe in view of Looney and Platt discloses this limitation," but does not provide any citation to Looney to fill the deficiencies of Watanabe. *See id.* at 83-84. Indeed, Petitioner states that "the selected contents" are added to a playlist, not digital images. *See id.* at 83. Platt "describes using a feature vector to generate a playlist using seed items" and comparing the similarity of two seed items. *Id.* at 84. However, Petitioner does not

explain how Platt's disclosure fills the gap in Watanabe's for claim limitation [1c.i] for which it is mentioned, or how Platt fills the gaps Watanabe's disclosure for claim limitations [1pre], [1a], [1b], [1c.ii], [1c.iii], and [1c.iv].

Nor does Petitioner provide any motivation to combine Platt with Watanabe (or Watanabe and Looney) for claim limitation [1c.i]. *See id.* at 83-84. To the extent Petitioner is relying on the motivation to combine all four references together, such arguments are pure hindsight and fail for at least the reasons set forth in Section VIII(F)(1). None of Platt's alleged benefits raised by Petitioner relate to or solve any problem identified in Watanabe—a fundamentally different system—so a POSITA would not have any motivation to look to Platt to combine with Watanabe (let alone Watanabe and Looney). And, for the same reasons as set for in Section VI, Dr. Bederson's testimony should be given little to no weight.

Thus, for at least the foregoing reasons that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim 1 would have been rendered obvious based on Watanabe, Looney, Platt, and Kaplan. Accordingly, the Petition should be denied.

b. Petitioner Fails to Establish That Claims 2, 3, 5-16 Would Have Been Rendered Obvious In View of Watanabe, Looney, Platt, and Kaplan.

Petitioner fails to establish that claims 2, 3, 5-16, would be rendered obvious

by Watanabe, Looney, Platt, and Kaplan. Pet. at 87-99. As discussed with respect to claim 1, Watanabe does not disclose digital images. For claims 2-3, 7, 9-12, and 15-16, Petitioner states that “Watanabe in view of Looney discloses this limitation,” but Petitioner merely provides some additional citations to Watanabe. Petitioner does not, however, provide any evidence or argument that Looney discloses digital images to remedy the core deficiency of Watanabe. *See id.* For example, for claim 7, Petitioner's citation to Watanabe's disclosure regarding a music song title is not the claimed program title. *See id.* at 92-93.

In addition, for each of the sub-limitations of claim 6, Petitioner claims that “Watanabe in view of Looney discloses this limitation,” but merely cites back to similar limitations for the sub-parts of claim 1 without providing any additional evidence or arguments, including any evidence or argument that Looney discloses digital images to remedy the core deficiency of Watanabe. *See id.* at 91-92.

Similarly, for claim 13, for claim limitations [13a] – [13g], Petitioner claims that “Watanabe in view of Looney discloses this limitation,” but merely cites back to similar limitations for the sub-parts of claims 1 and 6 without providing any additional evidence or arguments. *See id.* at 96-97. For claim limitation [13pre], Petitioner provides a citation to Looney purportedly disclosing the “dubbing list” element of the preamble. *See id.* at 95-96. Patent Owner disagrees—Petitioner's

citation to Looney does not establish the “dubbing list” nor does it demonstrate that Looney discloses digital images to remedy the core deficiency of Watanabe.

For claims 5, 8, and 14, Petitioner provides a citation to Looney for the “telop” and “selecting menu” elements, but does not provide any evidence or argument that Looney discloses digital images to remedy the core deficiency of Watanabe. *See id.* at 89-90, 93-94, 97-98.

Thus, for at least the foregoing reasons set forth in Section VIII(F)(2)(a) (claim 1) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claims 2, 3, 5-16 would have been rendered obvious based on Watanabe, Looney, Platt, and Kaplan. Accordingly, the Petition should be denied.

c. Petitioner Fails to Establish That Claim 4 Would Have Been Rendered Obvious In View of Watanabe, Looney, Platt, and Kaplan.

Petitioner fails to establish that claim 4 would be rendered obvious by Watanabe, Looney, Platt, and Kaplan. Pet. at 88-89. As discussed with respect to claim 1, Watanabe does not disclose digital images.

Petitioner states that “Watanabe in view of Looney and Kaplan discloses this limitation” but does not provide any citation to Looney to fill the deficiencies of Watanabe. While Kaplan discloses digital images (*e.g.*, thumbnails), Petitioner

concedes—consistent with Patent Owner's arguments for claim 1 in Section VIII(F)(2)(a)—that “Watanabe does not describe a user interface for images.” *See id.* at 89. However, in the same sentence, Petitioner purportedly claims that, despite Watanabe's core deficiencies, a “POSITA would be motivated to look to Kaplan for details about what a user interface for filtering based on user images would look like.” *See Pet.* at 89. But Petitioner's (and Dr. Bederson) reasoning is pure hindsight. None of Kaplan's alleged benefits raised by Petitioner relate to or solve any problem identified in Watanabe—a fundamentally different system—so a POSITA would not have any motivation to look to Kaplan to combine with Watanabe (let alone Watanabe, Looney, and Platt). And, for the same reasons as set for in Section VI, Dr. Bederson's testimony should be given little to no weight.

Thus, for at least the foregoing reasons and those set forth in Section VIII(F)(2)(a) (claim 1) that are incorporated by reference herein, Petitioner fails to show a reasonable likelihood of success in establishing that claim 4 would have been rendered obvious based on Watanabe, Looney, Platt, and Kaplan. Accordingly, the Petition should be denied.

IX. CONCLUSION

For at least the foregoing reasons, the Director should deny institution of the Petition.

Case IPR2025-01314
Patent No. 8,180,198
Patent Owner's Preliminary Response

Dated: December 5, 2025

Respectfully submitted,

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Case IPR2025-01314
Patent No. 8,180,198
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CERTIFICATE OF SERVICE

I hereby certify that on this 5th day of December, 2025, a copy of the attached
PATENT OWNER'S PRELIMINARY RESPONSE was served by electronic
mail to the attorneys of record, at the following addresses:

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Case IPR2025-01314
Patent No. 8,180,198
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CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Preliminary Response and complies with the type-volume limitation of 37 CFR § 42.24(a). The word count application of the word processing program used to prepare this Patent Owner's Preliminary Response indicates that the Preliminary Response contains 12,987 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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