

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT AND TRIAL AND APPEAL BOARD**

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**COMCAST CABLE COMMUNICATIONS, LLC,**

**Petitioner**

**v.**

**WHEREVERTV, INC.**

**Patent Owner**

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**Patent No. 8,656,431**

**Filing Date: July 10, 2006**

**Issue Date: February 14, 2014**

**Title: *Global Interactive Program  
Guide Application and Device***

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***Inter Partes* Review No. IPR2019-01483**

**PATENT OWNER'S PRELIMINARY RESPONSE**

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## **I. INTRODUCTION**

Pursuant to 37 C.F.R. § 42.107, Patent Owner WhereverTV, Inc. (“Patent Owner”) submits the following Patent Owner’s Preliminary Response (“Response”) to the Petition for *Inter Partes* Review (“Petition”) filed by Petitioner Comcast Cable Communications, LLC (“Petitioner”) on August 20, 2019. Petitioner requested review of claims 1 and 3-9 (the “challenged claims”) of U.S. Patent No. 8,656,431 (the “’431 Patent”). Patent Owner respectfully requests that the Patent and Trial and Appeal Board (“PTAB”) decline to institute review of the ’431 Patent because the Petitioner has failed to meet its burden to establish a reasonable likelihood of success on any of the challenged claims.

## **II. RELATED LAWSUIT**

The ’431 Patent and the challenged claims are at issue in the parallel district court case styled *WhereverTV, Inc. v. Comcast Cable Communications, LLC*, Civil Action 2:18-cv-529-UA-CM (M.D. Fla.) (the “Related Florida Action”), in which Patent Owner alleges patent infringement against Petitioner.

## **III. SUMMARY OF ARGUMENTS FOR PATENTABILITY**

First, the Board should decline institution because Petitioner failed to submit a valid Petition that complies with 37 C.F.R. § 104(b)(3)-(4). *Hologic, Inc. v. Enzo Life Sciences, Inc.*, Case IPR2018-00019, 2018 WL 1897623, at \*3-4 (P.T.A.B. April 18, 2018). A petition for an *inter partes* review must provide a statement that: (1) sets forth the precise relief requested for each claim challenged; (2) identifies how the Petitioner believes the challenged claims should each be correctly construed; and (3) exactly how each challenged claim is unpatentable according to the construction that Petitioner believes is correct. *Id.*

In *Hologic*, the Board denied institution because the petitioner failed to analyze patentability based on the claim construction that petitioner believed to be correct; instead, the petitioner improperly analyzed whether the patented claims were valid under the claim construction that the patent owner sought in the related district court case—a claim construction that petitioner believed was erroneous. *See id.* at \*3 (“Although Petitioner disagrees with Patent Owner’s infringement position, the analyses in Grounds 1–4 addressing claims 123, 155, and 156 are based on Patent Owner’s interpretation.”); *id.* at \*4 (“The Petition identifies how Petitioner believes the challenged claims should be construed. But, the Petition does not explain how the challenged claims are unpatentable as so construed. Instead, the Petition explains how the challenged claims would be unpatentable if they are given a different construction, namely one that Petitioner considers to be erroneous.”); *id.* (“But, our interpretation of 37 C.F.R. § 42.104(b)(3) and (4) does not, in fact, force Petitioner to adopt Patent Owner’s construction as its own in order to request an *inter partes* review. Rather, under our interpretation, Petitioner was free to advocate unpatentability under a claim construction it considered to be correct. It did not do so.”).

Here, like in *Hologic*, Petitioner submitted a Petition that improperly analyzes patentability based on Patent Owner’s claim construction—a construction that Petitioner has repeatedly argued (and continues to argue) in the Related Florida Action is erroneous. The Board should deny institution in this case for the same reasons it denied institution in *Hologic*.

Second, the prior art raised by Petitioner does not disclose all of the recited elements in the claims, including limitations in Claim 1. There are numerous deficiencies. For example, Petitioner alleges that Ramraz discloses a non-MSO content source because it discloses three television channels that receive television signals over an antenna. Even if these are non-MSO

sources, Claim 1 requires that “each of the channels is selectable for receiving only . . . streaming video programming from its respective . . . non-MSO source via the communication link and the network.” “Streaming video” is a term of art that refers to a “method of transmitting video data over a computer network in a steady, continuous stream.” Ex. 2104, NEW OXFORD AMERICAN DICTIONARY at 007 (“streaming: a method of relaying data (especially video and audio material) over a computer network as a steady, continuous stream allowing playback to proceed while subsequent data is being received.”). Streaming video programming also requires a specialized server to transmit the video over the computer network. Ex. 2106, *Adobe Streaming Media Primer* at 1 (“Streaming media is transmitted by a specialized media server application. . .”).

A station tower that broadcasts television signals over-the-air to an antennae receiver is not “streaming video programming.” The video content is transmitted by a server and the video content is not transmitted over a computer network. Therefore, even assuming these antenna channels are non-MSOs, none of them is “selectable for receiving only . . . streaming video programming.” In fact, in the Related Florida Action, Petitioner construes the term “*streaming*” to mean “transmitted over the Internet (or other network implementing the Internet Protocol) and made available for viewing while the transmission is occurring.” Patent Owner disagrees with Petitioner’s proposed construction, but even under Petitioner’s proposed construction, none of these “antenna” channels are “selectable for receiving only . . . streaming video programming.”

Third, the discretionary factors weigh against institution. This Petition is the *second* petition for inter partes review that Petitioner has filed that challenges the same patented claims of the ‘431 Patent (IPR2019-01482 and IPR2019-01483). The jury trial in the Related Florida Action is scheduled to begin only *ten months from the date of this filing*. Ex. 2103, Scheduling Order at 8. The Complaint was served on Petitioner on August 21, 2018, so Petitioner



procrastinated until the final hours of the final day of its one-year window before finally submitting *its two IPR petitions*. The Related Florida Action will be over several months before the PTAB has an opportunity to conduct a trial and issue a final decision. Moreover, the application was thoroughly examined for nearly eight years before the issued claims were approved. The prosecution history includes nearly 900 pages of history and includes numerous rejections and amendments. There is no reason for the Board to commit its limited and valuable resources to institute an IPR under the circumstances, especially given that the underlying trial will likely be long over before a final decision is reached.

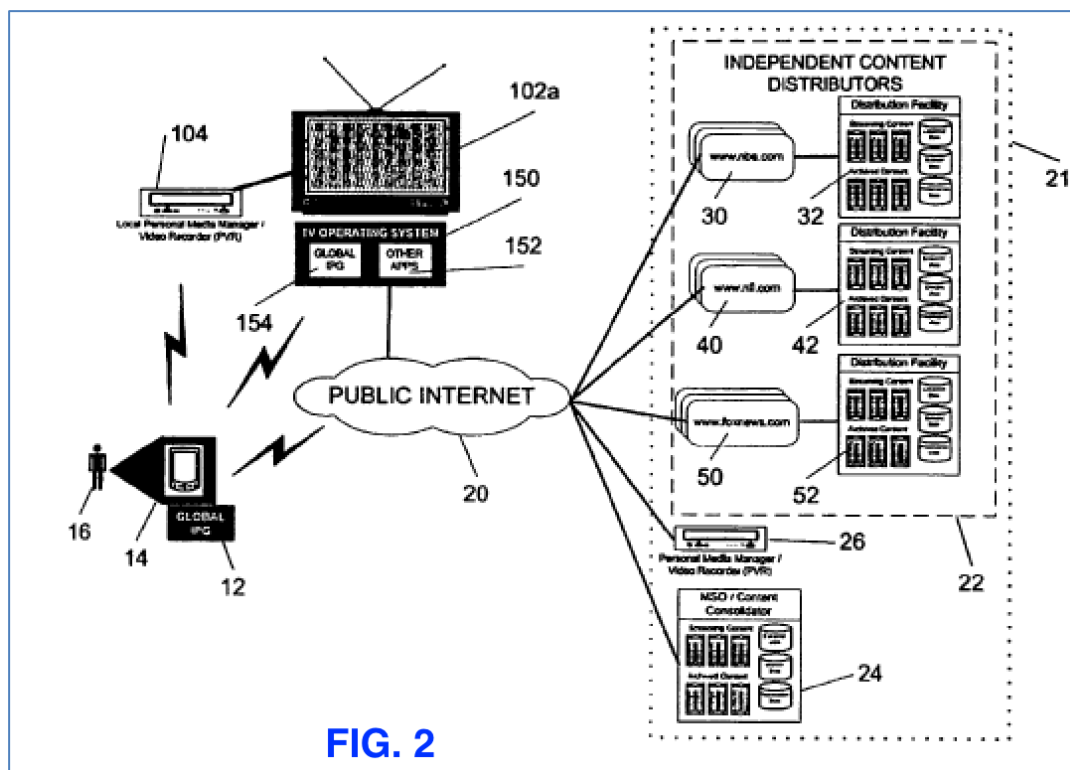
For these and others reasons discussed below, Patent Owner respectfully requests that the Board decline to institute review.

#### **IV. THE SUBJECT MATTER OF THE '431 PATENT**

The claimed invention discloses a distributed network solution for accessing, managing, and organizing television content received from disparate content sources, especially proprietary legacy television systems, known as “multiple system operators” or “MSOs,” and newer sources of television content such as, for example, online channels, podcasts, and video-on-demand websites like [www.yuks.com](http://www.yuks.com). Ex. 1101, 6:4-35; 7:45-8:35; 10:31-40. Abstract; Claim 1. The claimed invention discloses an interactive programming guide application installed on a device connected to a distributed network, as well as a separate server resident on the network. Ex. 1101, Claim 1. The server contains descriptive program data about the video television content available from the channels on the interactive programming guide. Claim 1. Ex. 1101, Claim 1. Upon the selection of a channel listed on the interactive program guide, the video programming is “streamed” *from* the MSO and non-MSO servers, rather than from the server that contains the descriptive program data about the video content. Ex. 1101, Claim 1; 9:28-10:4. This distributed

design “optimize[s] data transfer” and permits a mobile interactive programming guide that can “follow” the user from location to location, regardless of physical location. Ex. 1101, 6:33 (“optimize data transfer”); 7:16-19 (“follow me”); 6:4-9; Abstract.

The invention “consolidates content from disparate sources, manages authentication for each of the content sources, and allows for viewing from a single, customizable IPG.” Ex. 1101, 6:23-26. The interactive program guide (IPG) can be connected to “one or more sources of digital content, including, but not limited to: existing MSO subscriptions (e.g., Adelphia Santa Monica), independent content subscriptions (e.g., NFL Ticket), and personal content devices (e.g., a PVR located at the user’s home).” 7:47-52; *see also* Claim 1. The distributed design allows the IPG to “follow[] the user from one device to another, regardless of physical location or Internet service provider.” 8:16-19; Claim 1. The distributed design also allows a user to move from location to location and easily acquire, organize and view digital entertainment content from one or more independent content sources (including channel listings, programming information, and saved content) “via a follow me personalized global IPG that is available on any device that is connected” to the network. 6:33-39, Abstract; *see also* Claim 1. Figure 2a below is illustrative.



The specification teaches that integrating with an MSO was difficult because MSOs “do not allow for inter-system integration.” Ex. 1101, 3:54-56. MSOs were proprietary, closed systems that had been hardwired into the living rooms of viewers in the United States since the 1960s. Ex. 1001, 1:36-40 (“The formation of the cable television content consolidator, also known as a Multiple System Operator (MSO), in the United States during the 1960s, signaled the birth of a ‘consistent user experience’ television viewing. . .”); 3:56-65 (“The MSO’s STB (and the IPG contained therein) are typically connected via a hard wire (e.g., coaxial) to an MSO’s system.”); 14-18 (MSO technology “typically include[s]: a stationary set top box with a proprietary IPG that is typically connected to the cable provider via a hardwire connection, e.g., coaxial cable.”).

MSOs also utilize proprietary program guides and proprietary set-top boxes. Ex. 1101, 2:9-10; 3:55-65; 4:15, 4:15-21. MSOs do not support mobility because, among other reasons,

“user access” is controlled by the MSO through the proprietary set-top box, which is a stationary, immovable device. Ex. 1101, 41-46.

According to the specification and prosecution history, not all MSOs are cable-based television systems. The specification recognizes that some “IPTV providers ... [were] essentially Internet-based MSOs acting as a content aggregation middleman between the content owner and the user, but these all follow[ed] the traditional cable-television, content aggregation model where the MSO, rather than the user, is in control of what content is available.” Ex. 1101, 2:38-44. The specification recognizes that these IPTV systems were essentially equivalent to an MSO because they “replicate[d] existing single-content-provider cable television features and functionality.” Ex. 1101, 3:18-20; Ex. 2102 at 499-500.

The prior art included inventions that had attempted to integrate MSOs with other online television content sources, but had generally failed to preserve the traditional television viewing experience. Ex. 1101, 5:56-59 (“no portable IPG allows for content to be received or orchestrated by a mobile device and then be connected to a television monitor so that a normal television viewing experience can be preserved.”).

The specification discloses that “authentication services (i.e., user name/password combinations) are managed by the IPG so a user can seamlessly browse from one content source to another in a lean-back experience without having to log-in to each system as most IPTV services require users to do today.” 6:52-56. “The user would not have to perform a manual authentication process to access each content source since the IPG would automatically authenticate the user, regardless of the server provider.” 6:57-58. “And if the user wanted to add a new channel or subscribe to a specific program, content acquisition and subscription can be completed in real-time.” 6:59-62.

The '431 Patent contains 45 claims, of which claims 1 and 3-9 are challenged.

## **V. LEVEL OF POSITA**

A POSITA would have had at least a bachelor's degree in computer science or electrical engineering, or in an equivalent field, or equivalent work experience, and, in addition, at least two years' work experience with systems involving delivery of networked video content, including streaming, and also familiarity with delivery of television media content over networks, related network protocols, electronic program guides and digital rights management. Ex. 2001 ¶ 27.<sup>1</sup>

## **VI. CLAIM CONSTRUCTION**

### **A. The legal standard for claim construction is the same as in district court**

Because the Petition was filed after November 13, 2018, the PTAB construes “claim terms according to the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc).” *Ioxus, Inc., Petitioner, v. Cap-Xx, Ltd., Patent Owner.*, No. IPR2019-01179, 2019 WL 6544742, at \*4 (P.T.A.B. Dec. 4, 2019). Under *Phillips*, claim terms are afforded “their ordinary and customary meaning.” 415 F.3d at 1312. “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Id.* at 1313. “Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” *Id.*

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<sup>1</sup> The Declaration of Michael I. Shamos, Ph.D., J.D., attached as Ex. 2101, is incorporated by reference.

**B. “multiple system operator” or “MSO”**

With respect to this claim term, the inventor acted as his own lexicographer. As used in the '431 Patent, “multiple system operator” or “MSO” means: “*A traditional cable or Internet television content consolidator that receives and rebroadcasts channels of video content.*”

Dictionaries typically defined “MSO” as a “major cable television company that franchises in multiple locations.” Ex. 2104, COMPUTER DESKTOP ENCYCLOPEDIA, at 003; Ex. 2105, *Modern Cable Television*, at 3 (defining “MSO” as “a company that owns more than one separate cable system”). The specification acknowledges the dictionary meaning. Ex. 1101, 1:36-37 (“The formation of the cable television content consolidator, also known as a Multiple System Operator (MSO), in the United States during the 1960s, signaled the birth of a consistent user experience.”).

However, neither Petitioner nor Patent Owner suggest that this term should receive its plain and ordinary meaning because both sides recognize that the intrinsic evidence shows that the inventor intended to include certain Internet-based IPTV television companies within the meaning of “MSO,” so long as they operated as a traditional MSO. Ex. 1101, 2:38-39, Ex. 2102, File Wrapper at 499-500, 617. Petitioner’s construction is too broad for numerous reasons. Ex. 2001 ¶48-52. Among other things, Petitioner ignores that the specification recognizes that only some Internet-based television providers should be deemed “Internet-based MSOs.” Ex. 1101, 2:38-39 (“There are IPTVs providers, which essentially are MSOs, acting as content aggregation middleman between the content owner and the user [because] these all follow the traditional cable-television content aggregation model where the MSO, rather than the user, is in control of what content is available.”) (emphasis added). The traditional cable-television MSO model is one that receives and rebroadcasts channels. Ex. 1101, 3:47-53 (“If an MSO chooses not to purchase

rights to broadcast a specific content provider's channel, the user cannot access or integrate that specific content provider's channel onto the STB's IPG even if a separate content access relationship has been established.”).

This meaning of MSO was discussed at length during prosecution when the examiner initially rejected the application based on a combination of art that included an IPTV system, known as JumpTV, that had adopted the traditional cable-based MSO model, namely, it received and rebroadcasted channels. The following response from the inventor-applicant is on point:

**An applicant is entitled to be his or her own lexicographer.** *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ.2d 1671, 1674 (Fed. Cir. 1994); MPEP § 2173.05(a). In the specification, the characteristics of a Multiple System Operator (MSO) are described. **An MSO is the equivalent of a cable system that receives and broadcasts channels.** An MSO controls content availability, thus if an MSO chooses not to purchase rights to broadcast a specific content provider's channel the user cannot access that specific content provider's channel even if a separate content access relationship has been established. [0005, 00010, 0019, 0028, and 0029].

**JumpTV meets the above characteristics of an MSO. JumpTV is the same as a traditional cable multi-service operators (MSO) using a different pipe—Internet vs. coaxial cable.** JumpTV's system has complete control over what content customers can or cannot access. A JumpTV customer cannot add channels for non-MSO and/or other MSO sources that are not part of the JumpTV provider's channel selections to the IPG to be viewed using the content manager. **A JumpTV customer cannot access channels that do not pass through JumpTV's headend.**

Ex. 2102, at 499-500; *see also id.* 617.

Hence, as evidenced by the specification and prosecution history, the applicant made clear that he was acting as his own lexicographer and that an “MSO is the equivalent of a cable system that receives and broadcasts channels.” Ex. 2102, File Wrapper at 499-500 & 617. The intrinsic evidence makes clear that an MSO is not defined by whether the television provider used coaxial cable or the Internet to deliver television content; rather, according to the inventor, an MSO is a “traditional cable or Internet television content consolidator that receives and

rebroadcasts channels of video content.” Id.; Ex. 11101, 1:36-37; Claim 1. An Internet-based television content provider is only an MSO if it receives and rebroadcasts channels of video content. Ex. 2102, at 499-500; *see also id.* 61.

### **C. “non-MSO”**

The term “non-MSO” is not well-known in the art and the ‘431 Patent does not specifically define it. However, the term non-MSO is used in the claims and is always juxtaposed with the term “MSO.” Ex. 1101, Claim 1. The specification and prosecution history also provide numerous examples of non-MSOs, allowing a POSITA to easily understand its meaning and scope. Ex. 1101, 2:29-35 ( “numerous Internet-only television channels and video podcasts”); 7:50 (“NFL Ticket”); 9:12-13 (“NBA.com”); 10:64 (“an Internet-based content provider, Yuks.TV, which sells monthly subscriptions to digital content accessible via the Public Internet.”); Ex. 2102, File Wrapper at 557 (“A cable company acquires rights to broadcast individual channels from the owners of those channels—i.e., Viacom, NBC Universal, News Corporation, etc. None of these companies are MSOs.”).

As demonstrated, all of these examples of non-MSOs are television content providers. None follow the traditional cable-based MSO model because none receive or rebroadcast channels. A “non-MSO” should be construed as a television content provider that does *not receive and re-broadcast channels. Contrast with* Ex. 2102, File Wrapper at 499-500 and 617.

### **D. “streaming video programming”**

Streaming is a term of art that is readily understood. Ex. 2001 ¶ 64. The inventor used the term “streaming video programming” according to its plain and ordinary meaning. “*Streaming video*” refers to a method of transmitting video over a computer network so that it appears to be received in an uninterrupted, continuous stream. Ex. 2104, NEW OXFORD AMERICAN



DICTIONARY, at 007 (“streaming: a method of relaying data (especially video and audio material) over a computer network as a steady, continuous stream allowing playback to proceed while subsequent data is being received.”); Ex. 2001 ¶ 64.

Streaming required (and still requires) a server to transmit the video over the network. Ex. 2106, *Adobe Streaming Media Primer*, at 1 (“Streaming media is transmitted by a specialized media server application. . . .”); *id.* at 6 (“True streaming requires a specialized media server”); Ex. 2001 ¶64. In streaming, discrete portions of a data stream, usually video, called “segments” are sent from a server to a receiver, where they are stored in a buffer. Ex. 2001 ¶ 64. Once the receiver’s buffer has been loaded, display of the video can commence. *Id.* As the buffer is partially emptied, subsequent segments are downloaded. *Id.* As long as the buffer never empties completely, the video as displayed to the viewer appears to be a continuous stream, hence the term “streaming.” *Id.*

The term “streaming” is used in the ‘431 Patent according to its plain and ordinary meaning. Ex. 1101, 9:41-49 (“the streaming digital content [is routed] directly from the licensed content provider 21 to the television 102”); Ex. 1101, 2:15-20 (“A fourth technology that has revolutionized the entertainment industry is the portable multimedia device. . . . These mobile devices allow users to download, stream, and access redirected video and audio files from the Internet. . . .”); 2:25 (“multimedia streaming”); 5:27 (“a media streaming engine”); 1:6-11 (“This invention relates to an interactive program guide (IPG) application and device to receive . . . digital entertainment services . . . from one or more content sources, via an internet enabled device, anywhere in the world.”); 6:4-8 (“The present invention allows a user to access and view the same content through an identical IPG anywhere in the world an Internet connection is available.”).

**E. “only or virtually entirely streaming video programming”**

This claim term is a term of degree that means “exclusively or almost exclusively streaming video programming.” Ex. 2101 ¶ 67. This claim term recognizes that a system cannot be expected to always achieve a perfectly uninterrupted, continuous video transmission over a computer network. *Id.* Brief moments of delay are permissible under this claim term, so long as the video programming is still delivered to the user in a manner that, although not perfectly “streaming,” still “preserves the normal television viewing experience” that consumers have come to expect. 5:56-59 (“normal television viewing experience”); 6:63-65 (“normal television viewing experience can be preserved”). This term does not suggest that some portion of the video programming is delivered in a form that is not consistent with “streaming video programming.” Ex. 2101 ¶68; Ex. 1101, 9:41-49.

**F. “wherein the server is distinct from at least one of the one or more MSOs and one or more non-MSOs”**

The term should be construed to mean that “the server does not stream digital television content from at least one of the MSOs and does not stream digital television content from at least one of the non-MSOs.” Petitioner wrongly construes this term to mean that “the server resident on the network,” as recited in Claim 1, is “*not controlled by* the one or more MSOs and is *not controlled by* the one or more non-MSOs.” Ex. 2001, ¶ 71. Petitioner’s definition is wrong because it redefines the words “*distinct from*” to mean “*not controlled by*.” Those words are not synonyms. There is no dictionary that defines “*distinct from*” to mean “*not controlled by*.” Nothing in the claim language, specification, or prosecution history suggests that the meaning of this term depends on the *identity* of the person or entity who “controls” the recited server. *Id.*

This claim term emphasizes a particular network design that was intended “to optimize data transfer between the internet-connected” servers and components. Ex. 1101, at 9:30-36. The

server that contains and delivers data *about* the available video programming is *distinct* from the video streaming servers used by the MSOs and non-MSOs in Claim 1 because the server containing the descriptive program data does not stream video programming. *See* '431 Patent, 9:28-10:4. The specification explains that this distributed network design is intended “to optimize data transfer between the internet-connected” components. Ex. 1101, 9:30-36.

The place to begin is the claim language. *Zamperla, Inc. v. I.E. Park SRL*, No. 6:13-CV-1807-ORL, 2015 WL 4722737, at \*1 (M.D. Fla. Aug. 7, 2015). Petitioner has mistakenly argued before the Florida District Court that Claim 1 only recites one “server,” but Petitioner overlooks that Claim 1 also recites “*streaming video programming*,” which necessarily requires a server to stream the video programming. *See supra* Section VI.D (construing “streaming video programming”).

Specifically, Claim 1 recites “*streaming video programming from its respective MSO or non-MSO source*.” Therefore, the plain language of Claim 1 requires that the *actual* video content—as opposed to the descriptive program data *about* the video content—must be streamed from the respective MSO or non-MSO content source. Ex. 1101, Claim 1. Claim 1 is provided below, in relevant part:

1. A content manager device comprising:

A **server resident on a network containing descriptive program data about video content** available from one or more multiple cable system operators (MSOs) and one or more non-MSOs;

A **device** capable of establishing and maintaining a connection with the network via a communications link; and

An **interactive program guide application installed on the device that provides** user-configurable interactive program guide (IPG) listing

at least one channel of video content available from each of the one or more MSOs and each of the one or more non-MSOs and

**descriptive program data from the server** for the video content available on each of the channels,

wherein **each of the channels is selectable for receiving** only or virtually **entirely streaming video programming from its respective MSO or non-MSO source** via the communications link and the network;

wherein the **server is distinct from** at least one of the one or more **MSOs and one or more non-MSOs** and . . . .

Ex. 1101, Claim 1.

Hence, Claim 1's server containing the descriptive program data is distinct from the MSO servers and non-MSO servers used to stream the video content. The specification further supports Patent Owner's construction. *See e.g.*, Ex. 1101, 9:36-45 (contrasting the embodiment in Figure 2 from the embodiment in Figure 1, stating that: "Instead of digital content streaming through the MMED 14 as disclosed and set forth in FIG. 1, the MMED 14 and global IPG 12 are used to obtain and present data about available content to the user 16 on the television 102a. Once the user 16 selects a specific program to the MMED 14, the global IPG 12 communicates with the global IPG code segment on the television operating system 154 in such a way to route the streaming digital content directly from the licensed content provider 21 to the television 102.") (emphasis added). The specification provides that this design was intended to "optimize data transfer" between the various network-connected components, including between the television and the licensed content providers. Ex. 1101, 9:30-45. An annotated diagram that combines Figure 2a with an excerpt from the specification is provided below:



permits the multiple sources of content to be merged and presented in a user interface. Ex. 1110, 1:37-41.

**B. U.S. Patent No. 7,373,651 (“Bayrakeri”) (Ex. 1111).**

Bayrakeri discloses “techniques for searching a program guide database.” Ex. 1111, Abstract. “In accordance with a method, one or more search criteria (e.g., keywords) are received and a request for a search is then sent, along with the search criteria, to a head end of an information distribution system.” *Id.* “In response, one or more search results are received from the head end.” Bayrakeri also discloses a flow diagram for creating or customizing an interactive program guide.” Ex. 1111, 24:58-60.

**VIII. LEGAL STANDARD FOR INTER PARTES REVIEW**

An *inter partes* review may be instituted only if “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). The petitioner always bears the burden of proof to “demonstrate that there is a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable.” 37 C.F.R. § 42.108(c).

**IX. THE BOARD SHOULD DENY INSTITUTION BECAUSE THE PETITION DOES NOT COMPLY WITH §42.104(B)(3)-(4).**

The Board should decline institution because Petitioner failed to submit a valid Petition that complies with 37 C.F.R. § 104(b)(3)-(4). *See Hologic*, 2018 WL 1897623, at \*3-4. In *Hologic*, the Board denied institution because the petitioner failed to analyze patentability based on the claim construction that the *petitioner believed was correct*. Although the petitioner in *Hologic* submitted a claim construction that it believed was correct, it erred by analyzing

unpatentability based on the patent owner's claim construction—a claim construction that petitioner believed was erroneous. *Id.* The Board stated that:

The Petition identifies how Petitioner believes the challenged claims should be construed.. But, the Petition does not explain how the challenged claims are unpatentable as so construed. Instead, the Petition explains how the challenged claims would be unpatentable if they are given a different construction, namely one that Petitioner considers to be erroneous. . . .

\* \* \*

Our rules, however, require a petition to identify, not only how the challenged claim is to be construed, but also how the construed claim is unpatentable. Although the Petition identifies what Petitioner considers to be the correct claim construction, Petitioner admittedly does not identify how the challenged claims are unpatentable under that construction.

*Id.*

As in *Hologic*, Petitioner in this case violated Rule 104(b)(3)-(4) by failing to submit the claim construction that it believes is correct *and because* it did not analyze whether the challenged claims are patentable under the claim construction that it believes is correct. Petitioner has been arguing for months in the Related Florida Action that Patent Owner's proposed constructions are erroneous—the same claim constructions that Petitioner now relies on in its Petition. In fact, Petitioner attached *Plaintiff's Proposed Interpretations of the Disputed Claim Terms* as an exhibit to its Petitioner. This document was served by Patent Owner on Petitioner in the Related Florida Action, and, as the title suggests, all of the claim terms in the document are disputed. Petitioner has represented (and continues to represent) in the district court that the claim constructions in *Plaintiff's Proposed Interpretations of the Disputed Claim Terms* are erroneous. Petitioner has not apprised the Board of the claim constructions that it has argued in the Related Florida Action should apply in this case. Those claim constructions are included as Exhibit 2107.

Moreover, because the legal standard for claim construction is now the same for both a district court and the PTAB, there is no good reason to allow Petitioner to argue two completely inconsistent positions simultaneously in two judicial proceedings, especially one that Petitioner believes to be erroneous. *See AFN, Inc. v. Schlott, Inc.*, 798 F. Supp. 219, 223 (D.N.J. 1992) (“Judicial estoppel, sometimes referred to as ‘preclusion by inconsistent positions,’ is an equitable doctrine which precludes a party from asserting a position in a legal proceeding that contradicts or is inconsistent with a previously asserted position.”); *id.* (“The doctrine applies to assertions of both factual and legal positions.”). Allowing Petitioner to do so would be prejudicial and unfair to the rights of Patent Owner.

Here, Petitioner submitted a Petition that includes constructions that Petitioner is simultaneously arguing in the Related Florida Action are erroneous for many of the claim terms. For example, in the Related Florida Action, Petitioner construes Claim 1’s limitation “adding or deleting channels from any of the one or more MSOs or the one or more non-MSOs” to mean “adding channels to the IPG that, absent such adding, are not otherwise displayed in the IPG, or deleting channels from the IPG such that, after deleting, the channel is no longer displayed in the IPG.” Ex. 2107. Yet, here, Petitioner bases its argument for instituting review on a completely different claim construction.

Similarly, Petitioner contends in the Related Florida Action that Claim 1’s limitation, “wherein each of the channels is selectable for receiving only or virtually entirely streaming video” should be construed as “*wherein each of the channels is configured such that, in immediate response to selection of its assigned channel number, and without further searching, video programming is only or virtually entirely transmitted over the Internet (or other network implementing the Internet Protocol) and made available while the transmission is occurring.*”



Ex. 2107. And again, here, Petitioner bases its argument for instituting review on a completely different claim construction. Because Petitioner fails to analyze patentability under the claim constructions that it elsewhere contends should apply, the petition is fatally flawed.

Rather than applying the claim constructions that Petitioner has argued for months to a federal district court should apply, Petitioner analyzes whether the challenged claims are patentable according to Patent Owner's proposed claim construction, which Petitioner has told the district court are erroneous. The following offers a few examples:

- Claim 8: "Patent Owner contends 'relay module' simply means "communications software and hardware components. If this construction is correct, then Ramraz discloses claim 8. Petition as 52 (internal citations omitted).
- Claim 3: "Specifically, Patent Owner contends that 'digital rights management module' is to be construed as 'software and hardware that determines whether a user has the right to access a specific program or channel. If Patent Owner's construction is correct, then Furlong discloses claim 3's additional limitations." Petition at 55.
- Claim 4: "In the Florida action, Patent Owner construes 'filtering module' as 'software that blocks access to content based on geographical location.' If Patent Owner's construction is correct, then Bednarek discloses claim 4's additional limitations." Petition at 59.
- Claim 6: "In the Florida action, Patent Owner construes 'voice recognition module that accepts verbal commands and converts them to digital form as carrying its plain and ordinary meaning. If Patent Owner's construction is correct, then Calderone discloses claim 6's additional limitations.. . . Thus, the analog-to-digital converter and speech recognition processor comprise a voice recognition module under Patent Owner's construction of claim 6." Petition at 64.

None of these claim constructions is offered in the alternative. These are only a few examples. Petitioner was required to submit a Petition that discloses the claim construction *that it believes is correct and then analyze patentability based on that claim constructions*. Because Petitioner failed to do so, the Board should decline institution, as in *Hologic*.

**X. GROUND “A”: RAMRAZ IN VIEW OF BAYRAKERI DOES NOT RENDER CLAIMS 1, 5, 7-9 OBVIOUS.**

**A. Petitioner has not shown that Ramraz in view of Bayrakeri renders Claim 1 obvious.**

**1. The preamble is not limiting.**

Petitioner questions whether the “*content manager device*” named in the preamble of Claim 1 could be the antecedent basis for the “device” recited in the claim body. It is not. In fact, Petitioner and Patent Owner agree that the preamble for Claim 1 is *not* limiting. Petition at 23 (“the preamble is non-limiting”). Because the preamble is not limiting, it is irrelevant to the construction of any claim. *IMS Tech.*, 206 F.3d 1422, 1434 (“If the preamble adds no limitations to those in the body of the claim, *the preamble is not itself a claim limitation and is irrelevant to proper construction of the claim.*”) (emphasis added); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999) (a preamble that is not limiting “is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.”).

**2. Contrary to Petitioner’s assertions, Ramraz’s “camcorder, VCR, and camera” are not “non-MSO” content sources and, thus, they are irrelevant to the limitations in Claim 1.**

Claim 1 includes several limitations that require video and/or data from one or more non-MSO content sources. Petitioner alleges that Ramraz’s “*camcorder, VCR, and camera*” are non-MSO content sources. None of these personal video devices is a non-MSO content source.

As previously discussed, a non-MSO is a television content provider that does not receive or broadcast channels. *See supra* Section VI.C (construing “non-MSO”). None of these content sources is a television content provider. This is even more clear based on the written

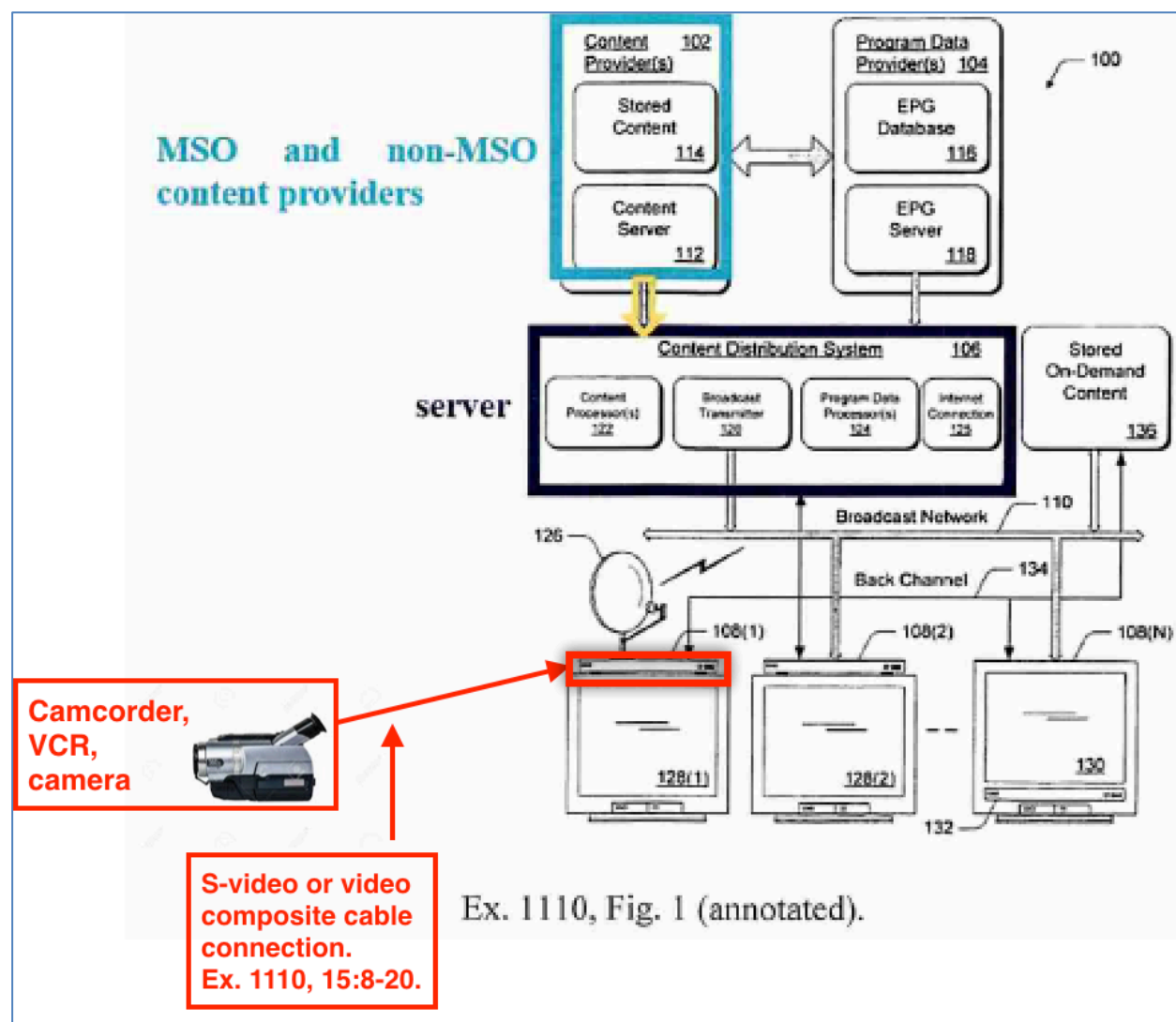
specification for Ramraz. Ramraz discloses that a subscriber may connect one or more of these personal video devices (camcorder, VCR, or camera) directly to the subscriber's "tuner," which is part of the subscriber's personal client device 108. Ex. 1110, 15:8-15, Fig. 3 (showing tuner to be part of client device 108).

Ramraz further discloses that these personal devices are connected to client device 108 using an S-Video cable or a composite video cable. Ex. 1110, 15:8-20 (The "additional sources can comprise one or more generic video sources such as a camcorder, digital camera, closed circuit camera, a VCR, and the like. The generic video source can be connected, for example, to the S-Video input or to the composite video input.") (emphasis added). Clearly, a locally connected camcorder, VCR, or camera that contains personal videos or photographs is not a television content provider and not a non-MSO.

Tellingly, Petitioner does not set forth a statement construing the meaning of non-MSO, as it was required to do under 37 C.F.R. §42.104(b)(3)-(4). In fact, Petitioner does not construe "non-MSO" even though it is not a term of art and is not expressly defined in the '431 Patent.

In any event, Petitioner contends that all video content from the MSO and non-MSO content sources disclosed in Ramraz is received from content provider(s) 102. Petition at 27 ("Ramraz teaches that video content distributed by content distribution system 106 is provided by multiple content providers 102, depicted in the blue box below.") (emphasis added). Indeed, the following annotated diagram of Ramraz, Figure 1, was submitted by Petitioner on page 44 of the Petition. The purpose of the diagram was to identify the alleged MSO and non-MSO content sources disclosed in Ramraz. The **blue** annotations were created by Petitioner, while the **red** annotations are provided now by Patent Owner. As demonstrated in the diagram, none of the

video content from Ramraz's camcorder, VCR, or camera is provided by content provider(s) 102.



Because Ramraz's camcorder, VCR, and camera are personal devices that Ramraz discloses may only be connected to client device 108 via local S-Video cable or video composite cable—they are not part of content provider(s) 102. Ex. 1110., 15:8-20 (connected to “tuner”); Fig. 3 (showing tuner as part of client device 108).

Thus, in addition to the fact that none of these video devices are television content providers (thus, not non-MSOs), they are also not even physically located in a position that

would make them relevant to Petitioner’s unpatentability analysis. The video content from these devices is not provided by any of the content provider(s) 102. Ramraz’s “camcorder, VCR, or camera” are simply not non-MSOs and they are no relevant to any of the “non-MSO” limitations in Claim 1.

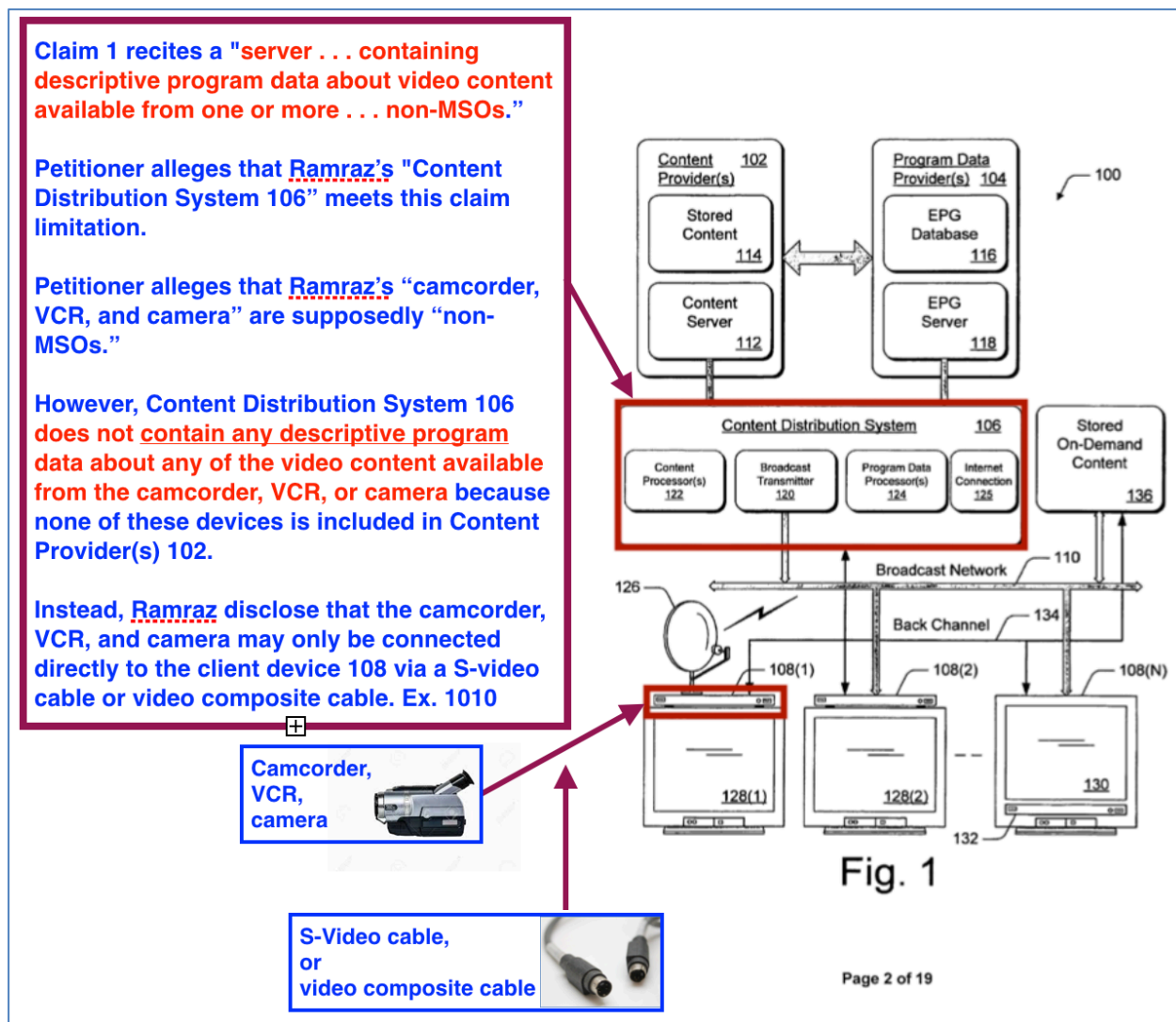
**3. Even if the “camcorder, VCR, and camera” are non-MSO content sources, Ramraz does not disclose a “server” that contains any descriptive program data about the video content available from” any of these alleged non-MSO sources.**

As previously explained, the “camcorder, VCR, and camera” are not non-MSO content sources. But even if they were non-MSO content sources, Ramraz does not disclose a “server . . . containing descriptive program data about video available from” any of these alleged non-MSOs sources.

Specifically, Claim 1 recites a “server resident on a network containing descriptive program data about video content available from . . . one or more non-MSOs.” Ex. 1101, Claim 1 (emphasis added). Petitioner alleges that Ramraz’s “*content distribution system 106*,” as shown in Figure 1, meets the limitations for the recited “server.” Petition at 26. Thus, Petitioner must prove that Ramraz’s content distribution system 106 contains “descriptive program data about video content available from . . . one or more non-MSOs.” Ex. 1101, Claim 1 (emphasis added).

However, Ramraz’s content distribution system 106 does not contain any descriptive program data about the video content available from any these personal video devices. As previously discussed, Ramraz only discloses that a subscriber may connect one or more of these personal video devices (camcorder, VCR, or camera) directly to the “tuner,” which is part of the subscriber’s personal *client device 108*. Ex. 1110, 15:8-15, Fig. 3 (showing tuner to be part of client device 108). The connection is made using a S-Video cable or composite video cable. Ex. 1110, 15:8-20. Hence, contrary to Petitioner’s contentions, Ramraz’s content distribution system

106 does not contain any “descriptive program data about video content” available from the camcorder, VCR, or camera. The following annotated version of Ramraz’s Figure 1 shows the deficiencies in Petitioner’s theory.



As demonstrated above, even if any of these personal video devices could be deemed a non-MSO content source (which they cannot because none is a television content provider), it would make no difference because none of the video and data from any of these personal video devices is received or stored in content distribution system 106. Petitioner alleges that content distribution system 106 is the “server . . . containing descriptive program data about video

content available from . . . one or more non-MSOs.” Ex. 1101, Claim 1. Yet, as shown in the figure above, content distribution system 106 does **not** contain any descriptive program data about the video content that is available from any of these personal video devices.

Petitioner, however, may allege that Ramraz’s Figure 12 discloses an electronic program guide that includes two channels associated with these personal video devices (camcorder, VCR, or camera), as a way of implying that the content distribution system 106 captures descriptive program data from these devices. Petitioner is mistaken. Ramraz’s Figure 12 is included below:

Channel	12:00	12:30	1:00
2 NBC (Ant)			
2 NBC (Sat)			
3 ABC (Ant)			
3 ABC (Sat)			

⋮

Video 1			
Video 2			

**Fig. 12**

Ramraz makes clear that his invention does not capture any “descriptive program data” from any of these personal video devices. Regarding the above Figure 12, Ramraz explains that:

In this embodiment, the additional sources can comprise one or more generic video sources such as a camcorder, digital camera, closed circuit camera, a VCR, and the like. . . As an example, consider Figure 12, which shows as exemplary program guide at 1200. There, the last two lines of the guide are dedicated to the generic video sources that can be connected with the tuner(s). Here, the “call

letters” for the sources are simply “Video 1” and “Video 2. **In addition, there is no EPG information that is inserted into the various cells of each line.**

Ex. 1110, 15:21-25 (emphasis added); Ex. 2101, ¶86.

Hence, Ramraz clearly states that his electronic programming guide does not capture any descriptive program data about the video content available from the camcorder, VCR, or camera. *Id.* (“there is no EPG information that is inserted into the various cells of each line.”). Of course, this is necessarily true because, given the design of Ramraz’s system, the content distribution system 106 has no way to know anything about the data or the video stored on any of these personal video devices because they are physically connected directly to client device 108, *bypassing content distribution system 106*. See above annotated version of Figure 1.

Accordingly, Petitioner cannot rely on any data or video from the camcorder, VCR, or camera to satisfy any limitations in Claim 1 relating to a “non-MSO,” including, without limitation, the “server” recited in Claim 1.

**4. Petitioner has not shown that Ramraz discloses “*wherein each of the channels is selectable for receiving only . . . streaming video programming*” recited in Claim 1.**

Petitioner has presented no evidence that Ramraz in view of Bayrakeri teaches or suggests “*wherein each of the channels is selectable for receiving only . . . streaming video programming*,” as recited in Claim 1. Ex. 1101, Claim 1 (emphasis added).<sup>2</sup>

*First*, as previously discussed, Petitioner was required to disclose in its Petition the claim construction that it believes is correct for this limitation and also analyze patentability based on the claim construction that Petitioner believes is correct for this limitation. *Hologic*, 2018 WL 1897623, at \*3-4 (April 18, 2018). The Petition wholly fails to comply with respect to this limitation. In the Related Florida Action, Petitioner contends that this limitation should be

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<sup>2</sup> Although the claim limitation permits “only or virtually entirely streaming video programming, Petitioner only contends that Ramraz discloses “*streaming video programming*.” Petition at 41, fn. 7.



construed to mean “*wherein each of the channels is configured such that, in immediate response to selection of its assigned channel number, and without further searching, video programming is only or virtually entirely transmitted over the Internet (or other network implementing the Internet Protocol) and made available for viewing while the transmission is occurring.*” Ex. 2107; Ex. 2101, ¶82. Patent Owner disagrees with Petitioner’s claim construction, but Petitioner was still required to prove how Ramraz teaches or discloses the limitations according to the claim construction that Petitioner believes is correct. *Hologic*, 2018 WL 1897623, at \*3-4. Petitioner was also required to specifically identify within Ramraz where these limitations (as construed by Petitioner) are allegedly disclosed. Petitioner did not do so because the prior art does not disclose Petitioner’s esoteric claims limitations. The Board should decline to institute, as it did in *Hologic*.

Second, even overlooking the material deficiencies in the Petition, Ramraz only discloses that its channels may be selected for receiving video. Ramraz does not disclose that any of its channels are selectable for receiving “streaming video programming.”<sup>3</sup>

“Streaming video” refers to a method of delivering digital video data over a computer network, so that the video appears to be received in a continuous, steady stream. Ex. 2104, NEW OXFORD AMERICAN DICTIONARY at 007 (“streaming: a method of relaying data (especially video and audio material) over a computer network as a steady, continuous stream allowing playback to proceed while subsequent data is being received.”); Ex. 2001 ¶64; *see also supra* Section VI.D (construing “streaming video programming”).

A “streaming” transmission of video is accomplished by the delivery of a rapid sequence of individual, separate packets of data. Ex. 2101, ¶64. The packets are stored (buffered) by the

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<sup>3</sup> The claim term actually allows “only or virtually entirely streaming video programming,” but Petitioner admits that the prior art only discloses “entirely streaming video programming.” Petition at 41, fn. 7.

receiver. *Id.* When the buffer has stored a sufficient number of packets, the content begins to play. *Id.* As the buffer empties, it is refilled by more incoming packets. *Id.* While the actual transmission is not continuous, the playback is continuous. *Id.*

Ramraz never uses the word “streaming” when discussing the transmission of video from the content provider(s) 102. Ramraz only uses a form of the word “streaming” on two occasions, but always in a different context. Ex. 2101, ¶¶91-92. Tellingly, Petitioner does not rely on either of those two irrelevant references.

At the time of the invention, “streaming video” was “an *emerging* technology.” See Ex. 2106, Adobe Streaming Primer at 3 (“Streaming is an emerging technology.”). If Ramraz had intended to disclose streaming video programming, Ramraz would have done so..

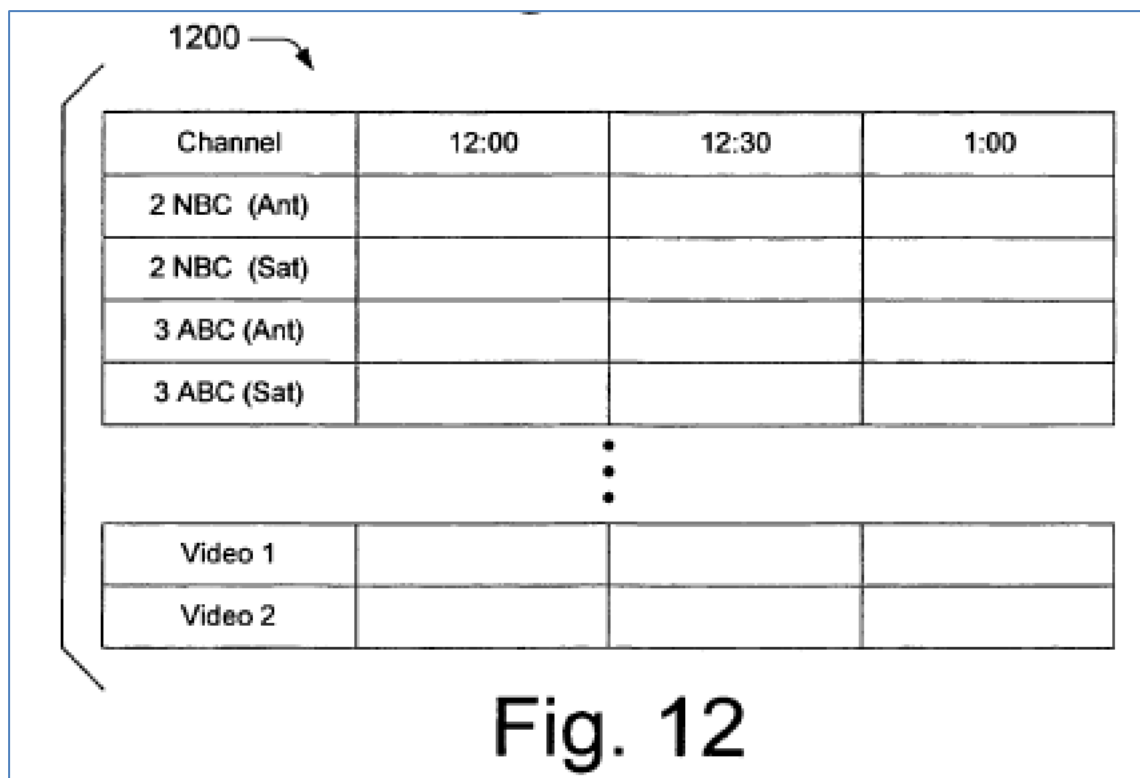
Recognizing this omission in Ramraz, Petitioner struggles to argue that the limitation is at least implicitly disclosed, but this argument fails. Petitioner wrongly argues in conclusory fashion that because Ramraz discloses that the video for some of its channels could be transmitted over the Internet “in data packets,” Ramraz discloses “streaming video programming.” Petition at 42. All data transmitted over the Internet is necessarily transmitted in packets, but that does not mean the data is streamed. For example, video transmitted over the Internet via the ubiquitous User Datagram Protocol (UDP) protocol is not “streaming video programming.” Ex. 2101 ¶¶93. “Streaming video” requires more than data packets delivered over the Internet. Streaming requires a client to buffer incoming video data received from the server in such a way as to avoid delays caused by, for example, slow network speeds. Ex. 2101, ¶¶64. Ramraz does not disclose this technology.

Streaming video programming was also not suitable for most network connections at the time of the invention because, among other things, streaming video required a high-bandwidth

network connection and the majority of consumers at that time did not have high-bandwidth network connections. Ex. 2106, Adobe Streaming Media Primer at 5 (“Quality concerns will continue to challenge media streamed over the public Internet until broadband is ubiquitous”); *id.* (“as of this writing, most Internet users are still connecting at speeds of 56Kps or lower”); *id.* at 7 (“Streaming is bandwidth-dependent”) (emphasis in original).

“Streaming video” also requires a different network architecture than downloading video files. Adobe Streaming Media Primer at 6 (“Streaming media requires a different architecture from that used for downloadable media—an architecture that supports a higher level interactivity of the Web, and offers a wealth of additional advantages.”). Ramraz does not disclose any special architecture for streaming video programming.

As a fallback to its fallback argument, Petitioner next suggests that Ramraz may impliedly disclose “streaming video programming” because Ramraz “teaches that the content from content providers 102 is live broadcast television airing at specific time slots as shown in the program guide in Figure 12.” Petition at 42. Petitioner relies solely on Figure 12 as its purported evidence. As demonstrated below, Figure 12 from Ramraz does not disclose “streaming video programming.”



Ramraz discloses live television, but not live streaming. Ex. 2101 ¶105. Even assuming a television program in Figure 12 is scheduled to broadcast live at a specific time slot, that does *not* mean the video content will be “streamed” upon selection of the channel. Ramraz does not disclose how the live television is received. However, two of the four channels listed in Figure 12 are “antenna” channels, indicating that the video signals associated with those channels are broadcasted over-the-air in analog form from station towers to antennas, which has been done since the 1940s. This is not streaming. Ex. 2101, ¶81. As previously discussed, streaming video programming refers to data transmitted over a computer network. *See supra* Section VI.D. (construing “streaming video programming”); Ex. 2106, *Adobe Streaming Media Primer* at 1 (“Streaming media is transmitted by a specialized media server application”); *id.* at 6 (“True streaming requires a specialized media server”).

Additionally, the last two rows in Figure 12, namely “Video 1 and Video 2” are generic names for the auxiliary devices, namely, the camcorder, VCR, or camera. Ex. 1110, 15:21-25. As previously discussed, these personal video devices are connected to client device 108 via an S-Video cable or composite cable. Data transmitted by an S-Video cable and/or composite cable is not streamed over a packet-based computer network. Ex. 2101 ¶ 97.

Additionally, as previously shown, none of the video from any of these personal video devices (camcorder, VCR, or camera) is delivered from content provider(s) 102, which Petitioner alleges is the source of all of the MSO and non-MSO content. As a result, none of the video from these devices is passed to content distribution systems 106. Thus, the video from these personal video devices is irrelevant to the limitation of Claim 1. *See supra* X.A.2.

Because Ramraz in view of Bayrakeri does not disclose “streaming video programming,” Petitioner cannot make out a prima facie case for obviousness.

**5. Petitioner has failed to show that Ramraz discloses “*wherein each of the channels is selectable for receiving only . . . streaming video programming from its respective . . . non-MSO source.*”**

Even if Ramraz is deemed to disclose that each of the MSO channels is selectable for receiving “only . . . streaming video programming,” Ramraz does not disclose that any of the alleged non-MSO channels is “selectable for receiving only . . . streaming video programming.”

Claim 1 expressly requires “wherein each of the channels is selectable for receiving only . . . streaming video programming from its respective . . . non-MSO source.” Ex. 1101, Claim 1.

Petitioner alleges that Ramraz only discloses *two* categories of non-MSOs channels. The first category includes three “*antenna*” channels. Specifically, Petitioner alleges that Ramraz discloses three antenna channels, namely, 2 (NBC), 3 (ABC), and 4 (KRON). Petition at 33; Ex. 1110, 2:56-60 (“Sources can include, without limitation, analog cable, digital cable, satellite, antenna, camcorders, VCRs, digital camera, and the like.”); (emphasis); 5:61 (“Client device

108 receives one or more broadcast signals 210 from one or more broadcast sources, **such as from a** satellite, **antenna**, or from a broadcast network, such as broadcast network 110 (Fig. 1).”) (emphasis).

Even assuming, without admitting, that these antenna channels are “non-MSO” content sources, Ramraz discloses that these channels are **received via antenna**, meaning their video signals are transmitted from their respective non-MSO content sources as radio waves over-the-air. Radio waves are fundamentally analog. Television signals transmitted via radio waves over-the-air are broadcasted by station towers and do not transmit over a computer network. *Id.* This method for delivering video is *not* streaming (no server, no computer, no packets, no buffering, etc.). Ex. 2101 ¶81; Ex. 2106.

As previously discussed, “streaming video” requires transmitting *video data over a computer network*. Ex. 2106, *Adobe Streaming Media Primer* at 1 and 6; Ex. 2104. NEW OXFORD AMERICAN DICTIONARY at 007 (“streaming video: a method of relaying data (especially video and audio material) **over a computer network** as a steady continuous stream, allowing playback to proceed while subsequent data is being received.”) (emphasis added); COMPUTER DESKTOP ENCYCLOPEDIA at 6 (defining “steaming video” as “video transmission over a data network” in which “both the client and server software cooperate for uninterrupted motion.”) (emphasis added).

Although Petitioner is silent in this proceeding regarding its proposed construction of “streaming video programming,” in the Related Florida Action, Petitioner contends that “streaming video programming” requires video to be “transmitted over the Internet (or other network implementing the Internet protocol).” Ex. 2107. An antenna that receives over-the-air television signals is not equivalent to video “transmitted over the Internet (or other network

implementing the Internet protocol). Although Patent Owner does not agree with Petitioner’s proposed construction, neither Patent Owner nor Petitioner has ever alleged that “streaming video programming” could be implemented over-the-air using radio waves broadcasted to an antenna, as disclosed by Ramraz. This is not streaming video programming by any definition.

The “Adobe Streaming Media Primer”—a document that Comcast introduced in the underlying district court case and relies on to support its proposed definition of “streaming” in that case—confirms that “streaming video” refers to digital video data and requires a server to transmit the video data over a computer network. Ex. 2106, *Adobe Streaming Media Primer* at 1 (“Streaming media is transmitted by a specialized media server application. . . .”); *id.* at 6 (“True streaming requires a specialized media server”). The following excerpt from the Adobe Streaming Media Primer shows that a server is necessary to “stream video programming.”

### **Gotta have a streaming media server... or two... or three...**

The term “server” can either be used to refer to server software, or to computer hardware dedicated to serving processes. When we say that you need a specialized server to stream media, we are primarily referring to the server software. **You’ll recall from our definition of streaming, that *true* streaming requires a specialized streaming server.** Although files formatted for streaming *can* be served from a Web server, files cannot truly be streamed. In the next section, and later in this Primer, you’ll learn more about why this is so.

The following excerpt from the Adobe Streaming Media Primer shows that specialized client-software is necessary to receive the “streaming video programming.”

### **And a streaming media player... or two... or three...**

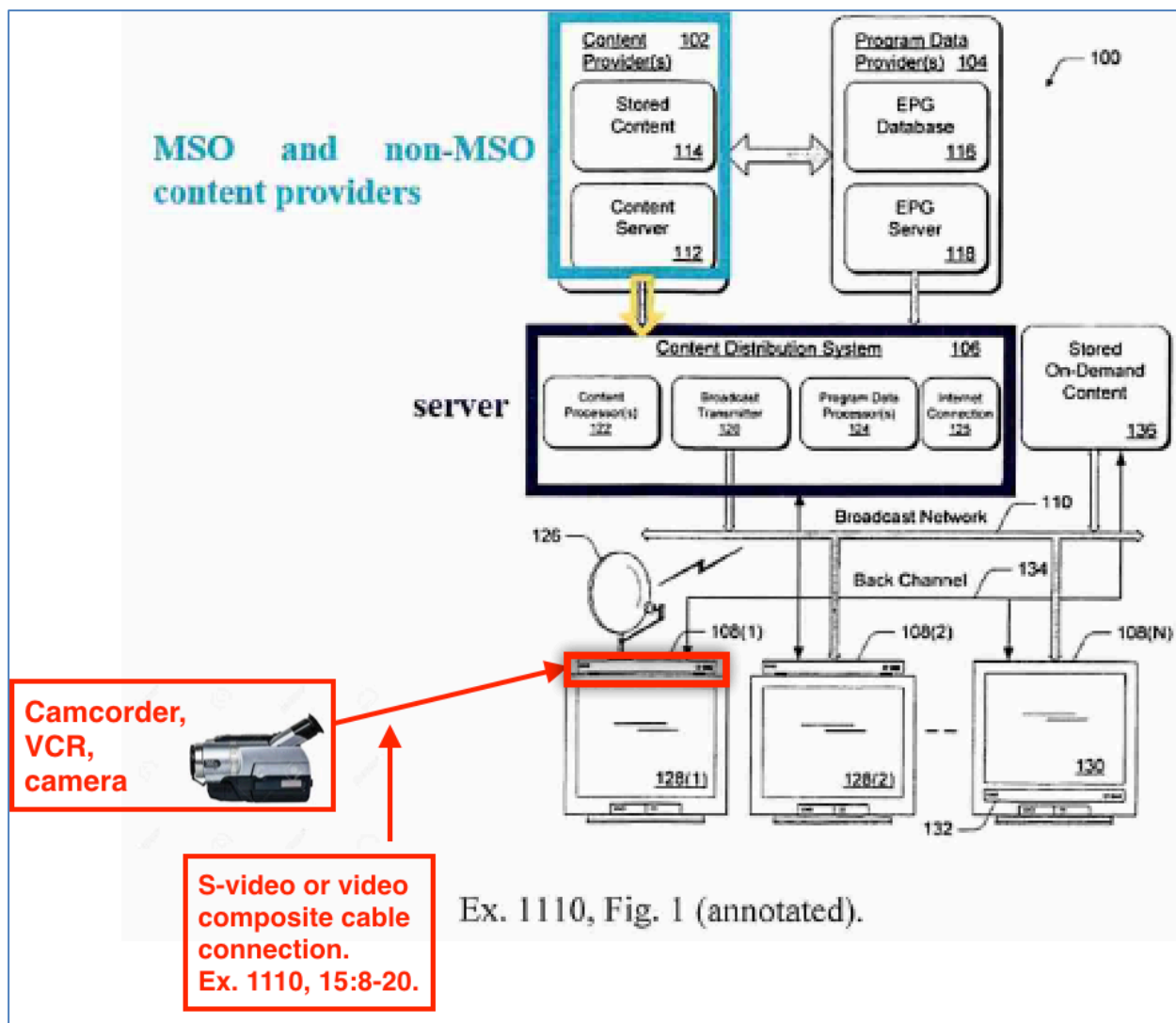
**Streaming media requires client software on the receiving end—in other words, each of the end-users in your audience needs a player to see and hear your streaming media content.** These players stream pre-recorded and live media over the Internet, and can play back media that has been saved to disk in various formats.

Based on Petitioner’s evidence, none of Ramraz’s three antenna channels—the alleged non-MSO sources—are “selectable for receiving . . . *streaming video programming*,” as required by Claim 1. Each of these antennae channels is only selectable for receiving radio waves broadcasted analog information over-the-air from station towers Ex. 1117 (Wikipedia page showing that channel 4 (KRON) was an over-the-air television station, where the station tower transmitted only analog information; and further disclosing that channel 4 (KRON) was not converted from analog to digital until long *after* Ramraz’s patent application was filed and long after the priority date of the ’431 Patent.).

Because Ramraz does not disclose that any of these alleged non-MSO channels is selectable for receiving streaming video programming, Ramraz does not disclose Claim 1’s limitation “**wherein each of the channels is selectable for receiving . . . *streaming video programming from its respective . . . non-MSO source***,” as recited in Claim 1.

As previously discussed, Petitioner alternatively alleges, that the “camcorder, VCR, and camera” are non-MSO sources. As previously discussed, none of these personal devices is a “non-MSO” and, in any event, none of them are physically located in a position to make them relevant to the limitations in Claim 1. See *supra* Sections X.A.2 and 3. None of these personal video devices is included in content provider(s) 102, which Petitioner alleges to be the source for all MSO and non-MSO “streaming video programming.” *Id.* The previous annotated diagram of Ramraz Figure 1 is provided again here for convenience:



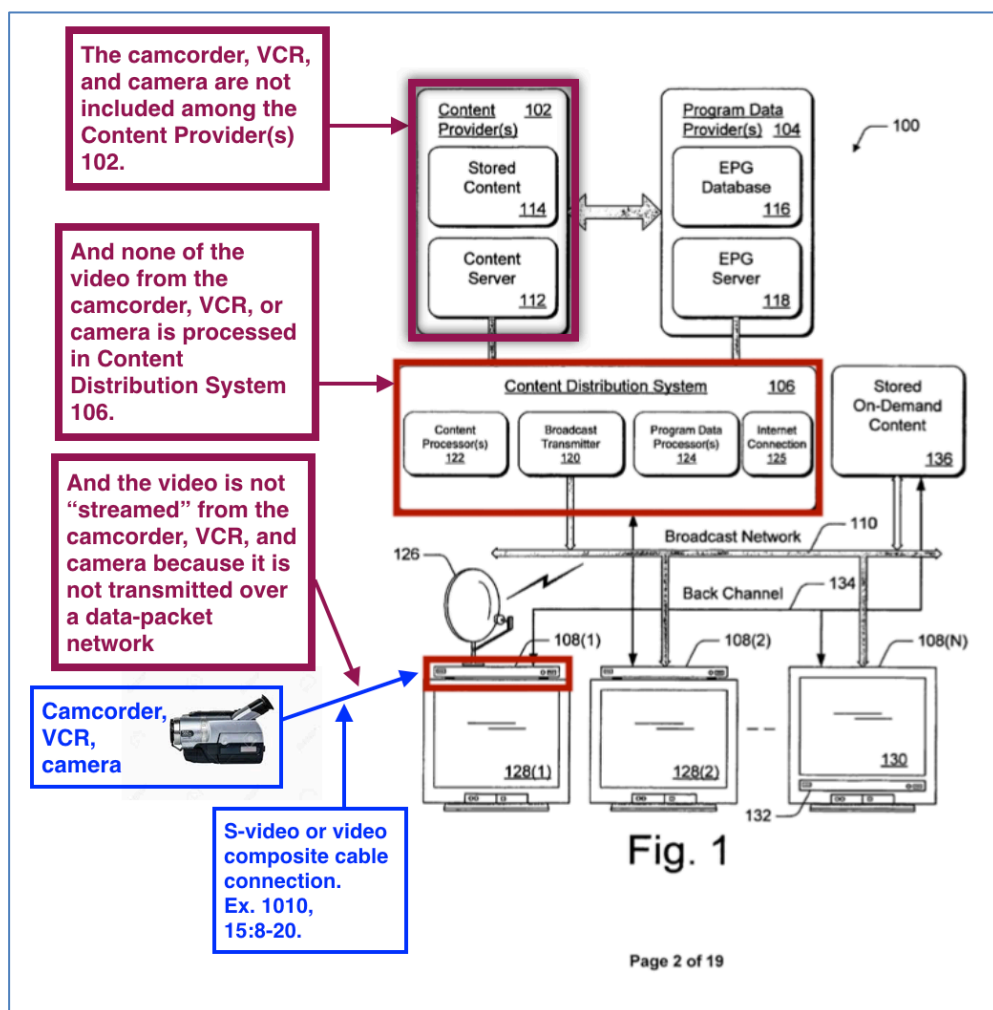


Thus, Ramraz makes clear that the video content from camcorder, VCR, and camera does not pass through content provider(s) 102. Ex. 1110, 15:21-25 (discussing Figure 12 and stating that “there is no EPG information that is inserted into the various cells of each line,” meaning there is no descriptive program data captured from the camcorder, VCR, or camera).

Additionally, Ramraz discloses that the subscriber can connect these personal video devices to subscriber’s personal client device 108 via an S-Video cable or a video composite cable. Ex. 1110, 15:8-20. An S-Video cable or video composite cable does not stream video programming. Ex. 2101, ¶ 97. Moreover, as previously discussed, Petitioner contends in the

Related Florida Action, that “streaming video programming” requires the video to be “transmitted over the Internet (or other network implementing the Internet protocol).” Ex. 21008. None of the personal video devices in Ramraz transmits video over the Internet because, as shown in the above annotated figure, none are connected to broadcast network 110. Patent Owner disagrees with Petitioner’s requirement that streaming requires the Internet Protocol, but either way, there is no evidence that these devices “stream video programming.”

The following annotated figure (from Ramraz Figure 1) highlights the material fallacies in Petitioner’s analysis regarding the “camcorder, VCR, and camera,” as purported non-MSO source.



For all the reasons discussed, Ramraz in view Bayrakeri fails to teach or suggest a *non-MSO channel* that is “selectable for receiving . . . streaming video programming from its respective. . . non-MSO source” as recited by Claim 1. Petitioner has failed to make out a prima facie case for obviousness.

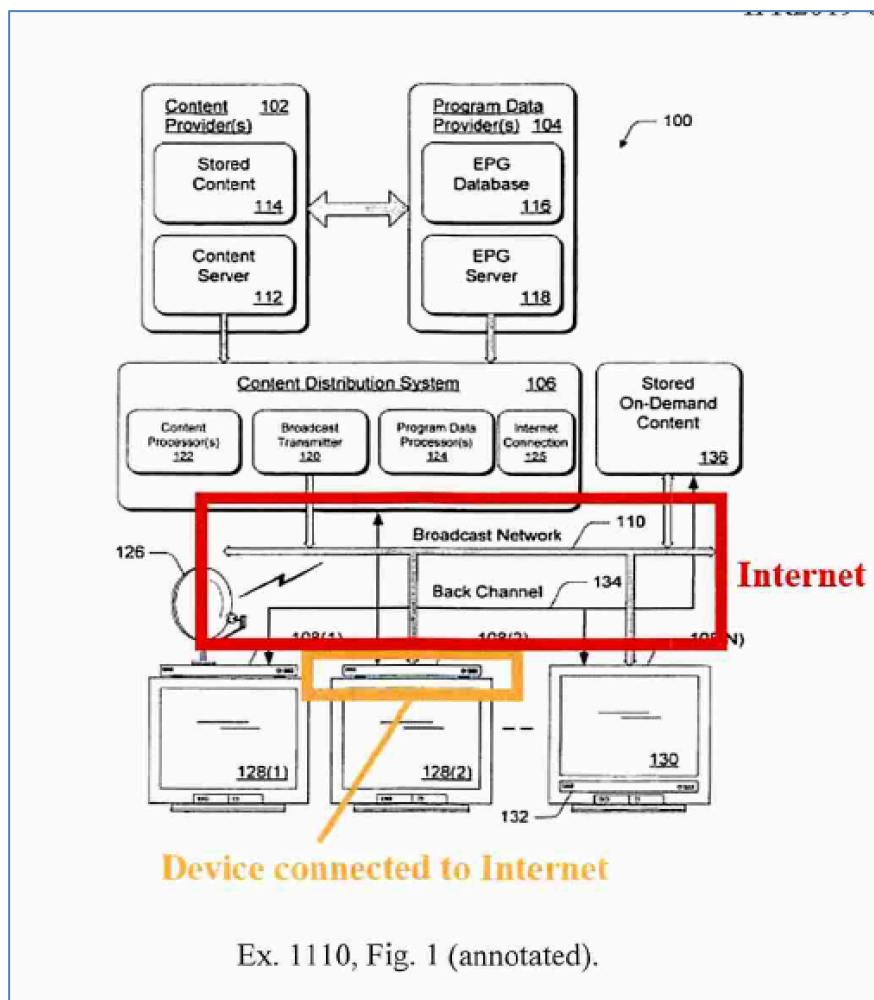
**6. Petitioner has failed to show that Ramraz discloses “*wherein each of the channels is selectable for receiving only . . . streaming video programming from its respective MSO or non-MSO source via the communications link and the network.*”**

Ramraz does not disclose Claim 1’s limitation relating to the “communications link and the network.” Specifically, Claim 1 recites “*wherein each of the channels is selectable for receiving only . . . streaming video programming from its respective MSO or non-MSO source via the communications link and the network.*” Ex. 1101, Claim 1.

Petitioner contends that “the network” recited in Claim 1 is disclosed by Ramraz’s broadcast network 110. In the Related Florida Action, Petitioner takes the position that “streaming video programming” necessarily requires the video to be “transmitted over the Internet (or other network implementing the Internet protocol).” Ex. 21008. Therefore, here, Petitioner contends that Ramraz meets this limitation because Ramraz discloses that broadcast network 110 may be the Internet. Petition at 36-37.

Patent Owner disagrees with Petitioner’s claim construction, but for purpose of responding to Petitioner’s arguments, Petitioner has not demonstrated that any non-MSO channel is “selectable for receiving only . . . streaming video programming” over the Internet.

The following figure was included by Petitioner in its Petition.



Petitioner also confusingly provide a preemptive argument in its Petition stating that:

Patent Owner may try to argue that the video content from the various sources is not necessarily sent over the same network because other embodiments in Ramraz (e.g., *id.* at 8:34-38) involve having multiple tuners or separate inputs for the various sources. But Ramraz specifically discloses the use of broadcast network 110, which may be the Internet.

Petition at 43.

While it is true that Ramraz discloses in boilerplate fashion that “broadcast network 110 can include a cable television network, RF, microwave, satellite, **and/or data network such as the Internet**, . . . ,” Ramraz never discloses that the MSO and non-MSO channels in its programming guide are both selectable for receiving streaming video programming over the network that Petitioner has identified, namely, the Internet. *Abiomed, Inc. v. Maquet*

*Cardiovascular, LLC*, No. IPR2017-01025, 2017 WL 4317629, at \*4 (P.T.A.B. Sept. 26, 2017) (“[T]he Petition is deficient . . . [W]e are left unpersuaded that the features of Aboul-Hosn's various embodiments are interchangeable or that one skilled in the art would have combined those features in the manner proposed by Petitioner.”). By defining the “network” to be the “Internet,” Petitioner is wrongly mixing elements of different embodiments that are not disclosed as interchangeable. *Id.* For example, Petitioner alleges that the MSO content sources in Ramraz are Comcast and DirecTV. Petition at 35. Comcast is disclosed in Ramraz as a cable television source, while DirecTV is disclosed as a satellite television source. Ramraz does not disclose how the television content from these MSO content providers is available over the Internet. Petitioner was required to articulate facts explaining how the components from different embodiments in Ramraz can be treated as if they are interchangeable. Petitioner has not done so because Ramraz does not disclose them to be interchangeable.

Another fatal problem with Petitioner’s theory is that Petitioner has not identified (and cannot identify) a non-MSO channel in Ramraz that is “selectable for receiving only streaming video programming” via Petitioner’s alleged “network,” which Petitioner identifies as the Internet. Petitioner alleges that Ramraz discloses two categories of non-MSO channels, namely the “antenna” channels and the “camcorder, VCR, or camera.” Petitioner has not demonstrated that any of these channels are selectable for “receiving only . . . streaming video programming from its respective . . . non-MSO source via the communications link and the network.”

As previously discussed, the video content associated with the “antennae” channels consists of analog information transmitted in analog form through radio waves. More pointedly, an over-the-air, radio-wave “network” is not “the Internet.”

Similarly, the camcorder, VCR, and camera are connected to client device 108 via a direct connection using an S-Video cable or video composite cable, which, again, is not “the network” that Petitioner has identified for purpose of meeting this limitation. Ex. 1110, 15:8-20. Even under Petitioner’s own claim construction, Petitioner has not demonstrated that any non-MSO channel is selectable for receiving streaming video programming over the Internet.

**7. Petitioner fails to show that Ramraz discloses “*wherein the server is distinct from at least one of the one or more MSOs and one or more non-MSOs.*”**

Even assuming, without agreeing, that Ramraz discloses that one or more content provider(s) “stream[] video programming,” Ramraz still does not meet the limitations of Claim 1.

Specifically, Claim 1 further recites “*wherein the server is distinct from at least one of the one or more MSOs and one or more non-MSOs.*” Ex. 11101, Claim 1. As previously discussed, this limitation refers to a distributed network design where the server containing the descriptive program data about the video content is distinct from the video streaming servers used to deliver the content because, unlike those video streaming servers, the server containing the descriptive program data does *not stream video programming*. See supra VI.D (construing “*wherein the server is distinct from at least one of the one or more MSOs and one or more non-MSOs.*”).

Ramraz in view of Bayrakeri does not disclose this limitation. In fact, Petitioner admits that “the software and hardware [in content distribution system 106] are for receiving and processing EPG data from program data provider 104, as well as video content, and transmitting it on broadcast network 110.” Petition at 25 (emphasis added).

Petitioner does not attempt to construe the meaning of this claim term and barely offers any analysis regarding how the prior art allegedly meets this limitation. In the Related Florida

Action, however, Petitioner alleges that this limitation should mean “wherein the server *is not controlled by* the one or more MSOs and is not controlled by the one or more non-MSOs.” Ex. 21007. Patent Owner disagrees with Petitioner’s claim construction. Nonetheless, even under Petitioner’s erroneous claim construction, Petitioner cannot carry its burden.

Petitioner alleges, without evidence, that the “server” disclosed in Ramraz meets this limitation because, according to Petitioner, Ramraz’s server is “*not controlled by the MSOs or the non-MSOs*” and is purportedly “*controlled by an entity, such as a network operator, that is separate from the content providers.*” Petition at 45. The word “distinct” does not mean “not controlled by” and Petitioner offers any theory that would justify redefining the words of the claim.

In any event, there is no way to know from Ramraz who controls or owns any of the servers (or groups of servers) or other components disclosed in Ramraz. Petitioner’s citation to Ramraz is irrelevant to the “control” issue. Ramraz simply never discusses *who* may control its components, nor would one expect Ramraz to limit its invention based on the identity of the person or company who may “control” or “own” the components.

In any event, Petitioner’s claim construction for this claim term is erroneous. Claims 1 in the ’431 Patent is not limited by *who controls* or *owns* the recited “server.” The ’431 Patent is defined by the structure and arrangement of its physical components, not by the identity of who may control those components. A proposed construction based on the identity of the person who controls a component-subpart of a patented invention makes no sense because there is no straightforward way to discern who at any given time controls a particular subcomponent. Moreover, the person who controls a computer or server today may decide to lease or outsource

control tomorrow. Simply put, the identity of the person or entity who controls the server recited in Claim 1 is irrelevant to the construction of the claim term.

Petitioner also alleges that Figure 1 in Ramraz shows that the server containing the descriptive program data is distinct because “the content distribution system is physically separated by a transmission line (the arrow) between it and the content providers.” Petition at 44-45. Petitioner misreads the meaning of this claim term. As previously discussed, this claim term refers to a particular distributed network design where the server [containing the descriptive program data about the available video content from the one or more MSOs and non-MSOs] is not used to stream video programming. Ex. 1101, 9:28-10:4. The specification for the ‘431 Patent teaches that this particular distributed design is intended to “optimize data transfer.” Ex. 1101, 9:34. Ramraz in view of Bayrakeri does not meet this limitation.

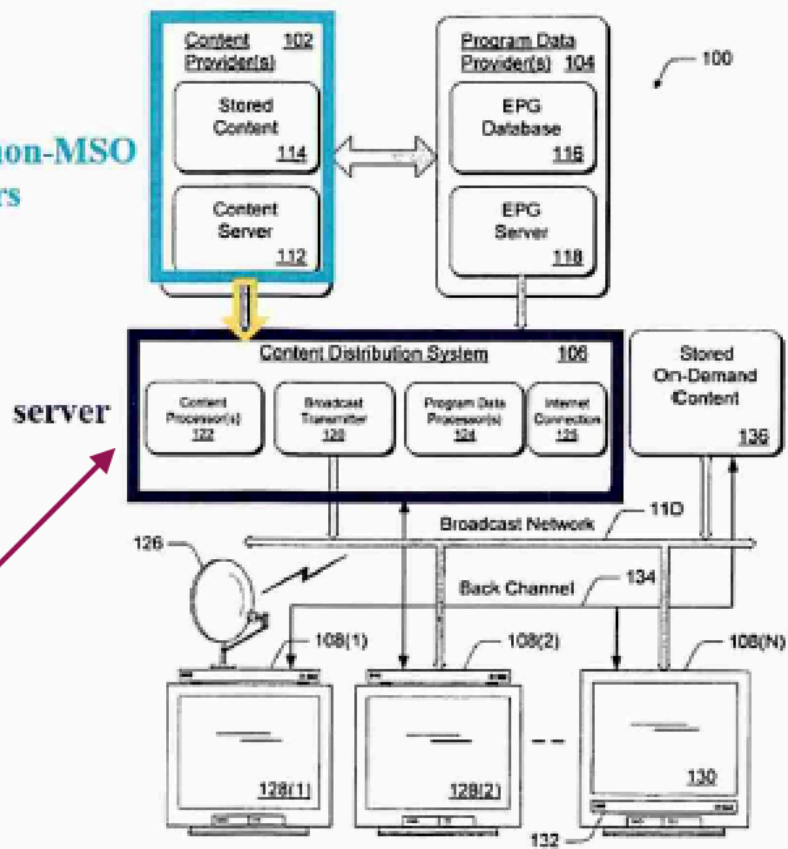
Ramraz’s content distribution system 106 is not distinct from content provider(s) 102 because it performs the same streaming function as the video servers in content provider(s) 102. The following is an annotated version of Petitioner’s annotated figure (found on page 44 of the Petition).



## MSO and non-MSO content providers

As demonstrated from Petitioner's own annotated figure, all of the video content disclosed in Ramraz is routed from the content server 112 in the content provider 102 to content distribution system 106, before finally being routed to client device 108.

Content distribution 106 is *not* distinct because it is performing the same function as content server 112 (i.e., transmitting the video content).



Ex. 1110, Fig. 1 (annotated).

As show above, all of the video content and descriptive program data is streamed through content distribution system 106. Ramraz's design does not meet this limitation because unlike the invention recited in Claim 1, all of the descriptive program data and video content is always routed through Ramraz's content distribution system 106.

8. **Petitioner fails to show that Ramraz in view of Bayrakeri discloses “wherein the application allows for the IPG to be configured by a user with respect to adding . . . channels from any of the one or more MSOs or the one or more non-MSOs.”**

Petitioner admits that Ramraz does not disclose “adding” channels. Petition at 45. Petitioner, therefore, alleges that because Bayrakeri discloses an interface from which a user can select a desired channel to add to Bayrakeri’s electronic programming guide, a POSITA would have been modified Ramraz’s electronic programming guide to include Bayrakeri’s “channel adding” feature.

Bayrakeri discloses a traditional MSO, namely Comcast, but Bayrakeri does not disclose any non-MSO content sources. Ex. 2101, ¶101-104. Because Bayrakeri does not disclose any non-MSO content sources, Bayrakeri does not disclose adding or deleting any channels associated with any non-MSOs. *Id.* Tellingly, Petitioner does not identify any non-MSO content sources or channels in Bayrakeri. It is Petitioner’s burden to precisely identify where in the prior art the required element or limitation can be found. Petitioner has not carried its burden regarding this limitation. This alone is enough to deny institution.

Moreover, Bayrakeri specifically makes clear that its “adding channel” feature only applies to MSO channels.

The local IPG center 1302 generates guide page user interface (UI) screens and periodically sends the UI screens to an IPG server 1312 at the head end 1304. **MSO/third party IPG add-on content** 1314 may be provided to the IPG server 1312 from **MSO equipment** within the head end 1304. For example, the add-on content may include real-time advertisement video or HTML pages for electronic commerce. The IPG server 1312 composes (C), encodes (E), processes (P), multiplexes (M), and modulates (QAM) the IPG content (guide plus add-on content) and transmits it to a combiner 1316. The combiner 1316 combines the IPG content with broadcast TV, premium content (e.g., HBO), pay-per-view (PPV), and **other content from a multiple service operator (MSO) content delivery system 1318**. The combined content is then broadcast to the STT's 1308 via an in-band distribution network 1320.

Ex. 1111, 18:48-63.

Because Bayrakeri does not disclose adding or deleting any channels associated with any non-MSOs, Petitioner's proposed modification of Ramraz will not yield the claimed invention. Even if a POSITA was motivated to make the proposed modification, it would not result in allowing Ramraz to add any non-MSO channels, meaning that Ramraz in view of Bayrakeri does not meet the limitations of Claim 1.

**9. Ramraz in view of Bayrakeri also does not render dependent claims 5, 7, 8, or 9 obvious.**

Dependent claims 5, 7, 8, and 9 each depends on Claim 1. For all the reasons previously discussed, Petitioner has failed to show that Ramraz in view of Bayrakeri renders Claim 1 obvious, so Petitioner has also failed to show that Claims 5, 7, 8, or 9 are obvious. *Additionally*, the Board should decline institution under *Hologic* because Petitioner has failed to submit a Petition that complies with 37 C.F.R. §42.104 (b)(3)-(4), regarding claims 1, 5, 7, 8, or 9. *See e.g.*, Petition as 52 (regarding Claim 8, stating that: "Patent Owner contends 'relay module' simply means "communications software and hardware components. If this construction is correct, then Ramraz discloses claim 8.") (internal citations omitted); *see also* Ex. 2107.

**XI. GROUND "B": RAMIREZ IN VIEW OF BAYRAKERI, IN FURTHER VIEW OF FURLONG DOES NOT RENDER CLAIM 3 OBVIOUS.**

Claim 3 depends on Claim 1, but further comprises a digital rights management module that obtains viewing rights for at least one of the channels." Ex. 1101, Claim 3.

*First*, because Claim 1 is not obvious, neither is Claim 3.

*Second*, the Board should also decline institution because Petitioner has failed to submit a Petition that complies with 37 C.F.R. §42.104(b)(3)-(4), regarding this claim. *Hologic, Inc.* 2018 WL 1897623, at \*3-4. Petitioner has not disclosed how it believes the term "digital rights management module" should be construed and Petitioner has not analyzed how the claim is allegedly unpatentable under the claim construction that Petitioner believes is correct. Ex. 2107.

Petitioner has been arguing for months (and continues to argue) in the Related Florida Action that “digital rights management module” is a means-plus function claim term governed by 35 U.S.C. § 112, part 6.” The Petition, however, fails to comply with 37 C.F.R. 42.104(b)(3) because it fails to analyze structure, material, or acts corresponding to the claimed function.

Petitioner may say that it could not analyze the corresponding structure in the specification because it believes the claim is indefinite. The same argument was made and rejected in *Hologenic*. See fn. 7 (reminding petitioner that the Board cannot institute an IPR based on indefiniteness). Plus, this claim is not indefinite even if the claim term is deemed to be a mean-plus function. Ex. 11101 8:44-52; 14:42-45. Petitioner could have analyzed the corresponding structure in the specification, as required under the rules. Petitioner simply did not perform the analysis.

The Board should decline institution for the same reasons as in *Hologic*. See *Hologic*. See *Hologic, Inc.*, 2018 WL 1897623, at \*4 (“If Patent Owner’s construction in a related lawsuit is erroneous, Petitioner should respond accordingly there, not here. At the Patent Trial and Appeal Board, petitioners should bring petitions for *inter partes* review asserting unpatentability based on constructions that their petitions seek.”).

**XII. GROUND “C”: RAMIREZ IN VIEW OF BAYRAKERI, IN FURTHER VIEW OF BEDNAREK DOES NOT RENDER CLAIM 4 OBVIOUS.**

Claim 4 depends on Claim 1, but further comprises “a GPS receiver and a filtering module that blocks content according to a jurisdiction.” Ex. 1101, Claim 4.

First, because Claim 1 is not obvious, neither is Claim 4.

Second, the Board should also decline institution because Petitioner has failed to submit a Petition that complies with 37 C.F.R. §42.104(b)(3)-(4), regarding this claim. *Hologic, Inc.* 2018 WL 1897623, at \*3-4. Although Patent Owner disagrees, Petitioner argues in the Related Florida

Action, that this claim term should be construed as a means-plus function that is governed by 35 U.S.C. § 112, part 6. Ex. 2107. Petitioner has not analyzed patentability under the claim construction that it believes is correct. *C.f.* Ex. 2107 with Petition at 59 (“In the Florida action, Patent Owner construes ‘filtering module’ as ‘software that blocks access to content based on geographical location.’ If Patent Owner’s construction is correct, then Bednarek discloses claim 4’s additional limitations.”) (internal quotes omitted). Like in *Hologic*, the Board should decline institution. See *Hologic, Inc.*, 2018 WL 1897623, at \*4”

**XIII. GROUND “D”: RAMIREZ IN VIEW OF BAYRAKERI, IN FURTHER VIEW OF CALDERONE DOES NOT RENDER CLAIM 6 OBVIOUS.**

Claim 6 depends on Claim 1, but further comprises “voice recognition module.” Ex. 1101, Claim 3.

First, because Claim 1 is not obvious, neither is Claim 6.

Second, the Board should also decline institution because Petitioner has failed to submit a Petition that complies with 37 C.F.R. §42.104(b)(3)-(4), regarding this claim. *Hologic, Inc.* 2018 WL 1897623, at \*3-4. Although Patent Owner disagrees, Petitioner argues in the Related Florida Action that “filtering module” should be construed as a means-plus function that is governed by 35 U.S.C. § 112, part 6. Petitioner has failed to analyze patentability under the claim construction that it believes is correct. *C.f.* Ex. 2107 with Petitioner at 64 (“In the Florida action, Patent Owner construes ‘voice recognition module that accepts verbal commands and converts them to digital form as carrying its plain and ordinary meaning. If Patent Owner’s construction is correct, then Calderone discloses claim 6’s additional limitations.. . . Thus, the analog-to-digital converter and speech recognition processor comprise a voice recognition module under Patent Owner’s construction of claim 6.”) (internal quotes omitted). Like in *Hologic*, the Board should decline institution. See *Hologic, Inc.*, 2018 WL 1897623, at \*4”

#### **XIV. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DECLINE INSTITUTION.**

The Board should exercise discretion and decline institution under Section 314 and 325(d).

First, the Related Florida Action is in an advanced stage. The jury trial is set to begin in October 5, 2020—less than ten months from the filing date of *this* Response brief. Ex. 2103 at 8. In fact, by the time a decision is made whether to institute IPR, the jury trial will likely be scheduled to begin in only seven more months. Moreover, Petitioner is already arguing invalidity based on Ramraz and Bayrakeri in the Related Florida Action. Thus, Petitioner's invalidity defenses based on those prior art references will be resolved months before the final decision is reached on an IPR. The district court has already denied Petitioner's motion to stay the litigation pending resolution of its two pending IPR petitions.

Second, the district court in the Related Florida Action will apply the same legal standard for claim construction as the PTAB. All of the claim construction briefing has long been completed in the district court and the claim construction order from the Court will likely be issued before any decision is made regarding institution.

Third, Petitioner should have filed its two IPR petitions (IPR2019-01482 and IPR2019-01483) much earlier. Petitioner knew about Ramraz and Bayrakeri long before it filed the two pending IPR petitions. In fact, Petitioner waited until the final hours of the final day of its one-year window before seeking IPR. The Petition at issue in this proceeding was the second IPR petition filed by Petitioner challenging the same patented claims (although they were both filed the same day).

Fourth, the prosecution of the application that eventually issued into the challenged claims was deliberate, careful, time consuming, and expensive. In fact, the prosecution history

for this application lasted almost *eight years*. The record is 875 pages. Ex. 2102 (pages 1 through 875). There were several applicant interviews and numerous office actions. *See e.g.*, Ex. 2102 at 180 (office action), 325 (office action), 371 (office action), 455 (office action), 511 (office action), 569 (office action), 684 (office action), 738 (office action). The examiner considered several different video delivery systems and many electronic programming guides as prior art and issued several initial and final rejections, leading to several claim amendments and countless response briefs. The prior art raised in the Petition is cumulative and the arguments are substantially the same.

*Fifth*, denying institution also makes sense in view of *Hologic* and because Petitioner has not submitted a petition that complies with 37 C.F.R. § 42.104(3) and (4), as previously discussed.

## **XV. CONCLUSION**

Because the Petition has not demonstrated a reasonable likelihood that at least one of the challenged claims is unpatentable, Patent Owner respectfully requests the Board not institute.

Dated: December 11, 2019

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**CERTIFICATE OF COMPLIANCE**

This document complies with the type-volume limitation of 37 C.F.R. § 42.24(a)(1)(i). This Preliminary Response contains 13,709 words, excluding the parts of the document exempted by 37 C.F.R. § 42.24(a)(1).

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**CERTIFICATE OF SERVICE UNDER C.F.R. §42.6(e)4)**

Pursuant to 37 C.F.R. § 42.6, I hereby certify that a true copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR INTER PARTES REVIEW was served via Electronic Mail this 11<sup>th</sup> day of December 2019 in its entirety on the following lead and backup counsel for Petitioner.

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