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Paper No. 13
Date Entered: July 1, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

ROVI GUIDES, INC.,
Patent Owner.

Case IPR2019-00299
Patent 9,294,799 B2

Before: WILLIAM M. FINK, *Vice Chief Administrative Patent Judge*, and
LYNNE E. PETTIGREW and BARBARA A. PARVIS, *Administrative
Patent Judges*.

PARVIS, *Administrative Patent Judge*.

DECISION TO INSTITUTE
35 U.S.C. § 314

I. INTRODUCTION

Comcast Cable Communications, LLC, (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–28 of U.S. Patent No. 9,294,799 B2 (Ex. 1001, “the ’799 Patent”). Paper 2 (“Pet.”). Rovi Guides, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

We apply the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”¹ Upon consideration of the parties’ contentions and the evidence of record, we conclude Petitioner establishes a reasonable likelihood of prevailing in demonstrating the unpatentability of claims 8 and 10–28 of the ’799 Patent. Accordingly, we grant Petitioner’s request and institute an *inter partes* review of all challenged claims and with respect to all grounds set forth in the Petition. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); USPTO, Guidance on the Impact of SAS on AIA Trial Proceedings (April 26, 2018) (available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>) (“USPTO Guidance”) (“[I]f the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition.”).

¹ We have authority under 35 U.S.C. § 314 to determine whether to institute an *inter partes* review. *See* 37 C.F.R. § 42.4(a).

II. BACKGROUND

A. *Real Parties-in-Interest*

Petitioner identifies as the real parties-in-interest the following: Comcast Corp.; Comcast Business Communications, LLC; Comcast Cable Communications Management, LLC; Comcast Cable Communications, LLC; Comcast Financial Agency Corp.; Comcast Holdings Corp.; Comcast Shared Services, LLC; Comcast STB Software I, LLC; Comcast of Santa Maria, LLC; and Comcast of Lompoc, LLC. Pet. 1. Patent Owner names as the real parties-in-interest Rovi Guides, Inc. and Rovi Corp. Paper 4, 1.

B. *Related Matters*

As required by 37 C.F.R. § 42.8(b)(2), each party identifies a judicial matter that would affect, or be affected by, a decision in this proceeding. In particular, the parties inform us that the '799 Patent is asserted in *Rovi Guides, Inc. v. Comcast Corp.*, Case No. 2-18-cv-00253 (C.D. Cal.), filed January 10, 2018. Pet. 1; Paper 4, 1; Paper 6, 1. The parties also inform us that the '799 Patent previously was asserted, but no longer is asserted, in *Digital Video Receivers and Related Hardware and Software Components*, Inv. No. 337-TA-1103 (ITC), filed February 8, 2018 (“related ITC proceeding”). Pet. 1–2; Paper 6, 1.

Additionally, Petitioner filed five petitions, each requesting *inter partes* review of claims 1–28 of the '799 Patent, including the instant Petition. The five petitions are identified in an order issued April 15, 2019, which is discussed below in Section III.A with respect to Patent Owner’s discretionary denial contentions. Paper 9 (“Case Management Order” or “Case Mgmt. Order”).

C. The '799 Patent

The '799 Patent is directed to on-demand media delivery systems. Ex. 1001, 1:28–30. Figure 2 of the '799 Patent is reproduced below.

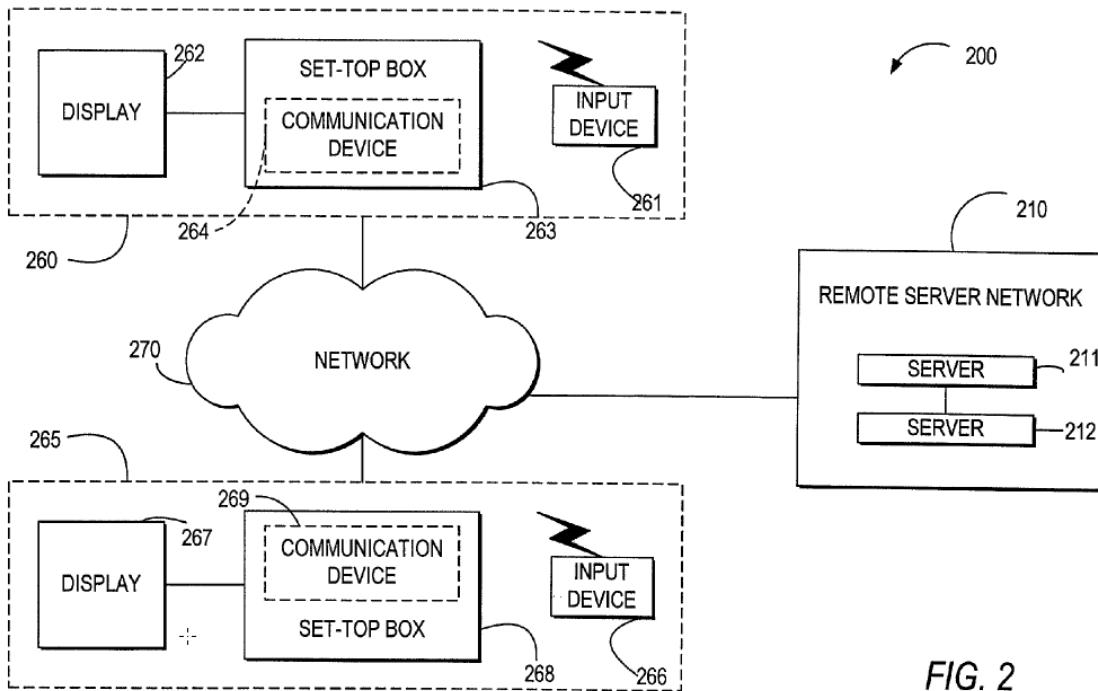


FIG. 2

Figure 2 of the '799 Patent, above, illustrates network topology 200 including user equipment 260 and 265, remote server network 210, and communications network 270. *Id.* at 6:1–6.

User equipment 260 and 265 may include input devices 261 and 266, display devices 262 and 267, set-top boxes 263 and 268, and communication devices 264 and 269 respectively. *Id.* at 6:14–17. Remote server network 210 stores on-demand media content and on-demand media data at a remote location. *Id.* at 7:8–10. Communications network 270 provides a communications hub and communications media for user equipment 260 and 265. *Id.* at 6:62–63.

D. Illustrative Claim

Petitioner challenges claims 1–28 of the '799 Patent. Pet. 1. Claims 1, 10, 19, and 28 are independent claims. Claims 2–9, 11–18, and 20–27 depend directly from claims 1, 10, and 19, respectively. Independent claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A first user equipment configured to:

receive, using control circuitry, a selection of a media asset identifier corresponding to media content, wherein the media content was previously accessed by second user equipment, wherein a request to pause access to the media content was received by the second user equipment when the media content was previously accessed by the second user equipment, and wherein a position, in the media content, that corresponds to a pause point, was stored in a data structure of a profile of a user in a storage device remote from the first user equipment when the request to pause access to the media content was received by the second user equipment;

access the data structure of the profile of the user;

access, from the data structure, the position that corresponds to the pause point;

retrieve the position that corresponds to the pause point from the data structure;

determine, based on information in the data structure, that the media content was previously accessed by the second user equipment;

based on the receiving:

cause to be simultaneously displayed a first option and a second option;

determine whether the first option or the second option is selected by the user; and

when it is determined that the first option is selected by the user:

generate a request including a position identifier that identifies the retrieved position that corresponds to the pause point,
transmit the request, and
receive, from the position that corresponds to the pause point, based on the position identifier included in the request, the media content; and
when it is determined that the second option is selected by the user:
access the media content starting from a second point in the media content which is prior to the position.

Ex. 1001, 17:55–18:27.

E. Evidence Relied Upon

Petitioner relies on the following references:

U.S. Patent No. 7,127,735 B1, filed May 19, 2000, issued October 24, 2006 (Ex. 1003, “Lee”);

U.S. Patent No. 6,501,902 B1, filed January 27, 1999, issued December 31, 2002 (Ex. 1004, “Wang”);

U.S. Patent No. 6,769,127 B1, filed June 16, 2000, issued July 27, 2004 (Ex. 1005, “Bonomi”);

U.S. Patent No. 6,622,148 B1, filed October 23, 1996, issued September 16, 2003 (Ex. 1006, “Noble”);

U.S. Patent No. 6,956,833 B1, filed April 4, 2000, issued October 18, 2005 (Ex. 1007, “Yukie”); and

U.S. Patent No. 7,036,738 B1, filed May 3, 1999, issued May 2, 2006 (Ex. 1018, “Vanzini”).

Additionally, Petitioner relies on the Declaration of Dr. Gary Tjaden. (Ex. 1002).

F. Grounds Asserted

Petitioner asserts the following grounds of unpatentability, under 35 U.S.C. § 103(a) (Pet. 8):

Claim(s) Challenged	Reference(s)
1–4 and 6	Lee and Wang
5 and 9	Lee, Wang, and Bonomi
7	Lee, Wang, and Noble
8, 10-13, 15, 17, 19–22, 24, 26, and 28	Lee, Wang, and Yukie
14, 18, 23, and 27	Lee, Wang, Yukie, and Bonomi
16 and 25	Lee, Wang, Yukie, and Noble
1–4 and 6	Lee, Wang, and Vanzini
5 and 9	Lee, Wang, Vanzini, and Bonomi
7	Lee, Wang, Vanzini, and Noble
8, 10-13, 15, 17, 19–22, 24, 26, and 28	Lee, Wang, Vanzini, and Yukie
14, 18, 23, and 27	Lee, Wang, Vanzini, Yukie, and Bonomi
16 and 25	Lee, Wang, Vanzini, Yukie, and Noble

III. DISCUSSION

A. *Discretionary Denial Arguments*

1. *Overview*

Patent Owner asserts we should exercise our discretion to deny the Petition under 35 U.S.C. § 314(a) because the factors enumerated in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. at 9–10 (PTAB Sept. 6, 2017) (Paper 19) (“*General Plastic*”) (precedential as to § II.B.4.i) should be applied to the five, concurrently filed petitions and those factors support exercising discretion to deny all five petitions. Prelim. Resp. 28–35. Patent Owner also asserts that we should exercise our discretion to deny the Petition under 35 U.S.C. § 325(d) as Lee was already considered by the Patent Office during reexamination of the ’799 Patent’s parent. *Id.* at 26–28.

2. *35 U.S.C. § 314(a)*

On April 15, 2019, we issued a Case Management Order requiring that Petitioner provide a Notice identifying a ranking of the five petitions in the order in which it wishes the panel to consider the merits, if the Board uses its discretion to institute any of the petitions, and a succinct explanation of the differences between the petitions, why the differences are material, and why the Board should exercise its discretion to consider instituting on more than one petition. Case Mgmt. Order 4. We, additionally, gave the Patent Owner an opportunity to respond.

Pursuant to our Case Management Order, Petitioner requests we consider the Petition in the instant proceeding first. Paper 11, 1. In its

response, Patent Owner does not take a position on the relative strength of the petitions. Paper 12, 5.

As Petitioner requested, we consider the Petition here first. For the reasons given herein, we conclude in the instant proceeding that Petitioner establishes a reasonable likelihood of prevailing in demonstrating the unpatentability of claims 8 and 10–28 of the '799 Patent, and we institute an *inter partes* review of claims 1–28 on the grounds set forth in the Petition. We address Petitioner's less-preferred petitions, IPR2019-00300, IPR2019-00303, IPR2019-00304, and IPR2019-00305, in a separate decision.

We find the circumstances in this case do not warrant denying the instant Petition as well, because that would deny Petitioner even one petition. Accordingly, we decline to exercise our discretion to deny institution under 35 U.S.C. § 314(a).

3. 35 U.S.C. § 325(d)

Our determination of whether to exercise our discretion is guided by 35 U.S.C. § 325(d) and involves, for example, the extent to which the asserted art was evaluated involved during examination. *See Becton, Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, slip op. at 17–18 (PTAB Dec. 15, 2017) (Paper 8) (informative). Patent Owner's contentions (Prelim. Resp. 26–28), however, pertain to *different* claims of a *different* patent, i.e., the '799 Patent's parent. *See* Ex. 1010, 39–51.

Patent Owner contends “[t]he '799 patent discloses similar limitations” as those considered by the Office during reexamination. Prelim. Resp. 26–27. Petitioner contends that the only feature that the PTO found missing in Lee is the requirement that “the playback user equipment

communicates with the pause user equipment to obtain the stored data associated with the pause point and that the pause user equipment communicates the stored data back to the playback user equipment,” which Petitioner contends was added by amendment. Pet. 6–7.

To overcome Lee during reexamination, Patent Owner amended the claims of the ’799 Patent’s parent to include recitations not in the claims before us. In particular, amendments were made to incorporate subject matter from dependent claims requiring, for example, transmitting a communication identifying the paused program from the second user equipment to the first user equipment and receiving the communication at the first user equipment device. Ex. 1010, 39, 55, 78. So far, however, Patent Owner has not directed us to similar recitations in the challenged claims.

Additionally, the Examiner rejected the independent claims as anticipated by Lee, and rejected dependent claims as obvious over Lee combined with different prior art references, not relied on by Petitioner in the instant proceeding. *See, e.g.*, Ex. 1010, 384. Petitioner asserts obviousness grounds based on Lee in combination with Wang and Yukie. Pet. 8. Neither party asserts that either Wang or Yukie was considered during reexamination of the ’799 Patent’s parent. *See generally* Pet.; Prelim. Resp. 28. For the reasons set forth below, at this preliminary stage in the proceeding, we are persuaded by Petitioner’s contentions regarding obviousness combinations involving Lee, Wang, and Yukie. Pet. 8.

At this juncture, upon consideration of the arguments and evidence submitted by the parties, we are persuaded by Petitioner’s contentions regarding the aforementioned obviousness grounds and we further are

persuaded that those grounds are not based on substantially the same prior art or arguments previously considered by the Patent Office during reexamination of the '799 Patent's parent. Accordingly, we also decline to exercise our discretion to deny institution under 35 U.S.C. § 325(d).

B. Principles of Law Relating to Obviousness

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

35 U.S.C. § 103(a). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). When evaluating a combination of teachings, we also “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006)). We analyze the grounds based on obviousness in accordance with the above-stated principles.

C. Level of Ordinary Skill

Petitioner contends, relying on the testimony of Dr. Tjaden, that a person having ordinary skill in the art would have had a bachelor's degree in electrical engineering, computer engineering, computer science, or a similar discipline, and at least two years of experience or familiarity with control of

media playback in networked media devices or would have had equivalent experience either in industry or research. Pet. 14 (citing Ex. 1002 ¶¶ 29–31). Patent Owner does not dispute Petitioner’s proposed level of ordinary skill or propose an alternative. *See, e.g.*, Prelim. Resp. 18–19. We adopt Petitioner’s proposed level for the purposes of determining whether to institute an *inter partes* review.

D. Claim Construction

1. Overview

In this *inter partes* review, we construe claim terms according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b) (2018).² Petitioner provides claim construction contentions for various terms recited in the claims including “storage device remote from the first user equipment” recited in each independent claim. Pet. 11–14. Patent Owner contends no construction of any term is required at this stage. Prelim. Resp. 11–12. We determine that, at this stage of the proceeding, to resolve the disputes between the parties, we need construe only the term “storage device remote from the first user equipment.” *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we

² The claim construction standard to be employed in an *inter partes* review changed. *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 11, 2018) (amending 37 C.F.R. § 42.100(b) effective November 13, 2018). At the time of the filing of the Petition in this proceeding, however, the applicable claim construction standard was set forth in 37 C.F.R. § 42.100(b) (2018).

need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’”) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)), *cert. denied*, 138 S. Ct. 1695 (Apr. 30, 2018).

2. “*storage device remote from the first user equipment*”

The term “storage device remote from the first user equipment” is recited in each independent claim. Petitioner contends the broadest reasonable interpretation of this term is “a storage device located outside of the first user equipment.” Pet. 11 (citing Ex. 1001, 6:40–43, 15:9–10, Fig. 13; Ex. 1002 ¶ 34). Petitioner relies on the ’799 Patent Specification’s description that “user equipment is ‘capable of retrieving and sending on-demand media content and on-demand media data to devices located outside of user equipment 260 and 265 through communication devices 264 and 269.’” *Id.* (quoting Ex. 1001, 6:40–43). At this preliminary stage in the proceeding, however, we are not persuaded that the ’799 Patent’s description suggests that the term “remote” covers all storage merely “outside of” user equipment and, indeed, this description does not include the term “remote”. Ex. 1001, 6:40–43.

In accordance with a technical dictionary, the plain and ordinary meaning of “remote” is not in the immediate vicinity and accessible through a communications link. *See, e.g.*, MICROSOFT COMPUTER DICTIONARY 448 (Microsoft Press 5th ed. 2002) (Ex. 3001). The ordinary and customary meaning of remote is consistent with the ’799 Patent Specification, which describes user equipment 160 transmitting and receiving signals from remote server network 110 through communications network 170 (Ex. 1001, 4:43–

47) and remote server network 110 including remote storage 190 (*id. at* 5:7–8). Further support is found in Figure 1 of the '799 Patent, which is reproduced below.

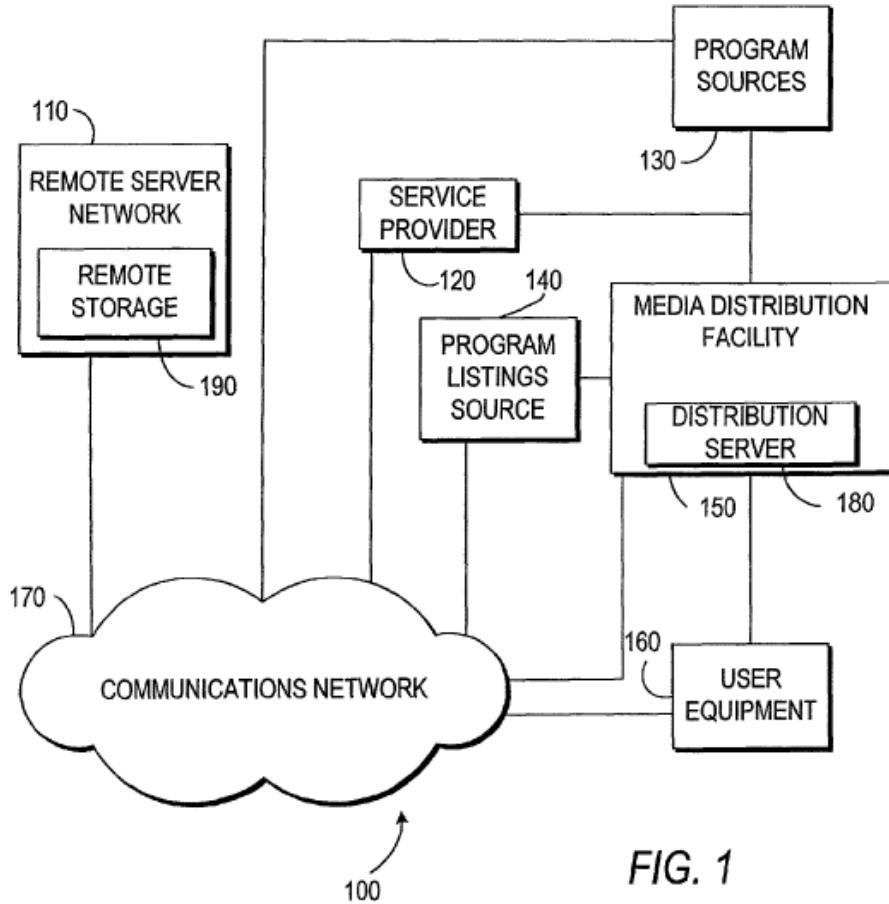


Figure 1 of the '799 Patent, above, illustrates remote server network 110 connected to user equipment 160 via communication network 170. *Id. at* 4:2–7, Fig. 1. As shown in Figure 1, remote storage device 190 is included in remote server network 110. *Id. at* Fig. 1.

Accordingly, based on the record at this preliminary stage in the proceeding, we are not persuaded that “remote from” means “located outside of” as Petitioner contends. Instead, we apply the ordinary and customary meaning, namely that “remote” means not in the immediate vicinity and

accessible through a communications network. We determine that no further express construction is needed.

E. Obviousness—Claims 1–7 and 9

Petitioner contends each of claims 1–4 and 6 of the '799 Patent is unpatentable, under 35 U.S.C. § 103(a), as obvious over (1) Lee and Wang; and (2) Lee, Wang, and Vanzini. Pet. 8. Petitioner also contends each of claims 5 and 9 of the '799 Patent is unpatentable, under 35 U.S.C. § 103(a), as obvious over (1) Lee, Wang, and Bonomi; and (2) Lee, Wang, Vanzini, and Bonomi. *Id.* Petitioner further contends that claim 7 of the '799 Patent is unpatentable, under 35 U.S.C. § 103(a), as obvious over (1) Lee, Wang, and Noble; and (2) Lee, Wang, Vanzini, and Noble. *Id.* Patent Owner opposes. *See generally* Prelim. Resp. In our discussion below, we first provide a brief overview of Lee, Wang, and Vanzini, and then we address the parties' contentions in turn.

1. Overview of Lee

Lee is directed to a user oriented video-on-demand (VOD) system that enables a user to resume viewing of a video after an interruption. Ex. 1003, 1:7–10. Lee describes an “object of the present invention” is to provide a VOD system that enables a user to resume viewing, “regardless of the video server.” *Id.* at 2:40–44. Figure 2 of Lee is reproduced below.

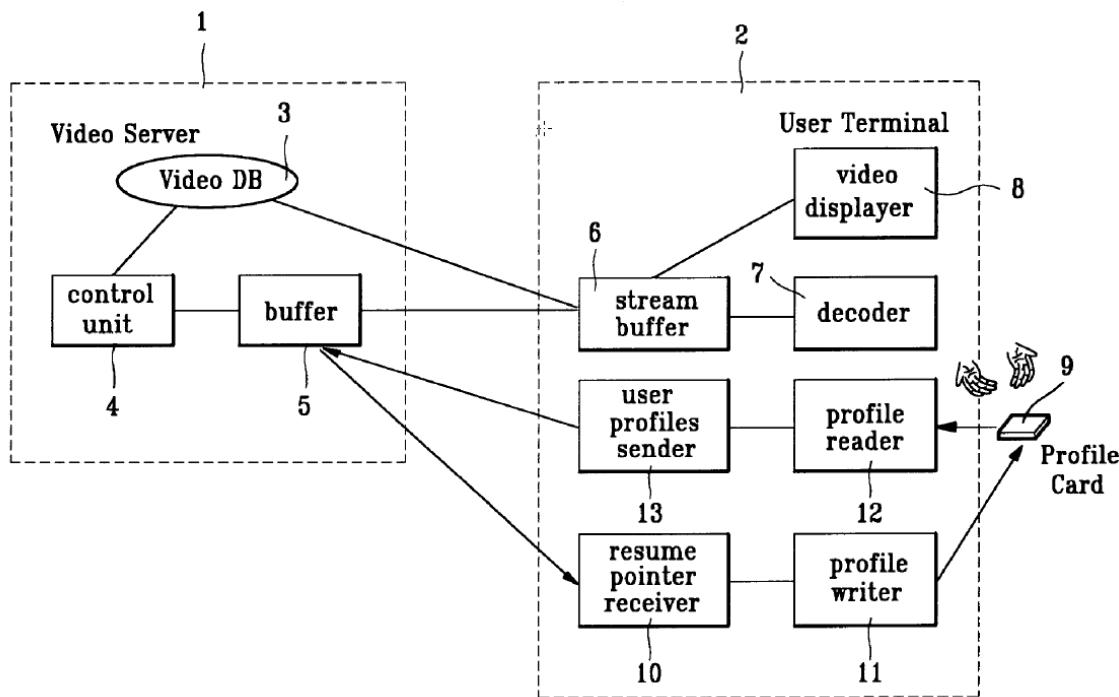


Figure 2 of Lee, above, illustrates a VOD system including video server 1 connected to user terminal 2. *Id.* at 4:6–9. Video server 1 includes video database 3, which manages the video programs, and control unit 4, which sends a video program for a user to view upon request. *Id.* 4:10–13. Video data transmitted from video server 1 to user terminal 2. *Id.* at 4:17–19. Then, in user terminal 2, the video data are stored in the stream buffer 6, decoded by decoder 7, and displayed by video display 8. *Id.* at 4:17–21.

User terminal 2 also includes profile card 9, resume pointer receiver 10, profile writer 11, profile reader 12, and user profile sender 13. *Id.* at 4:21–30. If a user interrupts viewing of the video program, control unit 4 in video server 1 transmits to user terminal 2 user profile information, including the identifier and the interrupted position of the video program. *Id.* at 4:50–53. The resume pointer receiver 10 receives and transfers to profile writer 11 the user profile information. *Id.* at 4:53–56. Then, the identifier and the interrupted position are written on profile card 9, which is

inserted in profile writer 11. *Id.* at 4:56–58. When the user wishes to resume viewing the interrupted video program, user terminal 2 reads the identifier and the interrupted position from the user profile card 9 through profile reader 12, and transmits that information to the video server 1 through the user profile sender 13. *Id.* at 5:24–29.

2. Overview of Wang

Wang is directed to a method for browsing and replaying a selected picture by a multimedia player. Ex. 1004, 1:7–8. Wang describes a multimedia player having a display and a controlling interface. *Id.* at 1:63–67, Fig. 2. The user can select by the controlling interface one of the subpictures corresponding to the selected picture to be replayed, and then the selected picture will be shown on the display. *Id.* at 2:7–11.

3. Overview of Vanzini

Vanzini is directed to a profile carrier that stores and securely transports a user's profile and personal user data files from one computer to the next. Ex. 1018, 2:20–22. Figure 2 of Vanzini is reproduced below.

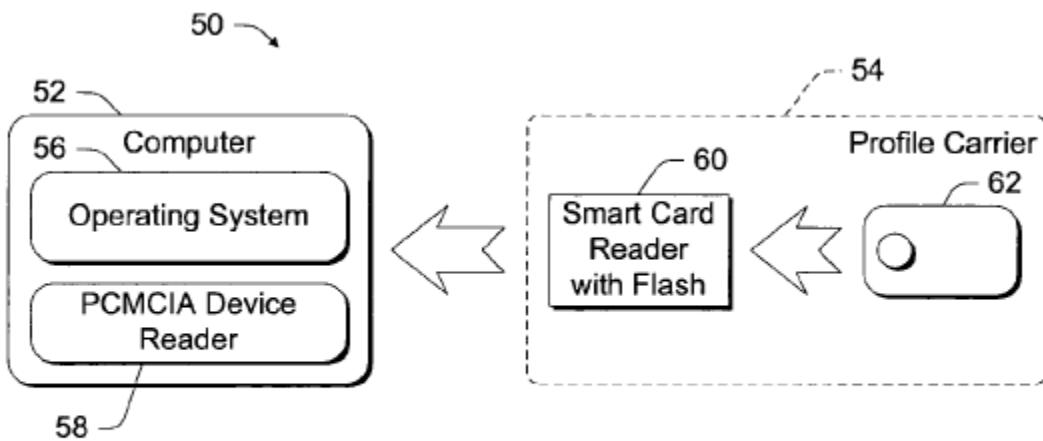


Fig. 2

Figure 2 of Vanzini, above, illustrates computer system 50 having computer 52 and portable profile carrier 54. *Id.* at 3:29–30. Computer 52 includes Personal Computer Memory Card Interface Association (PCMCIA) device reader 58. *Id.* at 3:30–34. Profile carrier 54 stores a user's profile in a secured medium that can be conveniently transported. *Id.* at 3:41–42.

4. Discussion of Claim 1

Claim 1 recites

receive, using control circuitry, a selection of a media asset identifier corresponding to media content . . . and wherein a position, in the media content, that corresponds to a pause point, was stored in a data structure of a profile of a user in a storage device remote from the first user equipment when the request to pause access to the media content was received by the second user equipment.

Ex. 1001, 17:55–67 (emphases added to a recitation that Petitioner refers to as limitation [1D] (Pet. 74)). Claim 1 further recites “based on the

receiving” (above) “cause to be simultaneously displayed a first option and a second option.” *Id.* at 18:9–11.

Petitioner asserts that Lee teaches limitation [1D] emphasized above. Pet. 27. In particular, Petitioner contends

[t]he Pause User Terminal that receives the pause request (“second user equipment”) writes the ID and the interrupted position information of the video program on a profile card 9 (described as any type of portable storage) that is a storage device *outside of* the Playback User Terminal (“first user equipment”) that plays back the video program at a later time. *Id.*, 2:45-49, 3:12-19, 3:26-37, 4:17-33, 4:48-60, 5:24-37, annotated Fig. 2 above, claim 5...

During playback of a program on the Playback User Terminal, profile card 9 is *remote* from the Pause User Terminal that paused the program. Ex. 1003, annotated Fig. 2 above.

Id. (emphases added). Petitioner relies on its proposed construction for “remote” contending that profile card 9 “is a storage device *outside of* the first user equipment and, therefore, satisfies “wherein a position . . . was stored . . . in a storage device remote from the first user equipment” recited in claim 1. *Id.* (emphasis added).

Patent Owner contends “the recited ‘data structure of the profile’ must be stored in a storage device ‘remote’ from the first user equipment.” Prelim. Resp. 11. Patent Owner further argues the combination of Lee and Wang lacks “teaching of creating and displaying multiple simultaneous options” based on receiving “*remotely-stored*” information. *Id.* at 23.

As explained above, at this preliminary stage in the proceeding, we are not persuaded that “remote from” means “located outside of” as Petitioner contends. *See supra* § III.D.2. Instead, we apply the ordinary and customary meaning, namely that “remote” means not in the immediate

vicinity and accessible through a communications network. *Id.* Accordingly, at this juncture, regarding storing “in a data structure of a profile of a user in a storage device *remote from* the first user equipment when the request to pause access to the media content was received by the second user equipment” (Ex. 1001, 17:55–67 (emphases added)), we are not persuaded by Petitioner’s pointing to “a storage device *outside of* the first user equipment, i.e., Lee’s profile card 9, because Petitioner relies on its proposed construction. Pet. 27.

Petitioner, alternatively, relies on the combination of Lee and Vanzini for teaching limitation [1D], but that alternative relates to “first” and “second” user equipment also recited in claim 1. Pet. 27–28. In particular, Petitioner asserts “[t]o the extent Patent Owner argues that Lee fails to teach *two user equipment* that can each access the same portable profile card 9” Vanzini “teaches this feature.” *Id.* at 28 (citing Ex. 1018, (57), 2:20–22, 3:14–17, 3:29–40, Fig. 2; Ex. 1002 ¶ 107). At this preliminary stage, we determine Petitioner’s alternative assertion also is based on Petitioner’s proposed construction for “remote,” which we decline to adopt for the reasons set forth in Section III.D.2.

5. *Discussion of Claims 2–7 and 9*

Each of claims 2–7 and 9 depends directly from claim 1. In its contentions for claims 2–7 and 9, Petitioner does not provide additional contentions regarding “storage device remote from the first user equipment” recited in claim 1.

6. Conclusion

On this record, at this preliminary stage, we are not persuaded by Petitioner’s showing with regard to “a storage device remote from the first user equipment,” as recited in claim 1. Nevertheless, for the reasons provided in Sections III.F–H, we are persuaded that Petitioner has shown a reasonable likelihood of prevailing on its assertion that claims 8 and 10–28 are unpatentable. Given our determination, we institute trial on all challenged claims and all grounds raised in the Petition, including grounds relating to claims 1–7 and 9. *See SAS Inst.*, 138 S. Ct. at 1359–60; USPTO Guidance.

F. Obviousness—Claims 8, 10–13, 15, 17, 19–22, 24, 26, and 28

Petitioner contends each of claims 8, 10–13, 15, 17, 19–22, 24, 26, and 28 of the ’799 Patent is unpatentable, under 35 U.S.C. § 103(a), as obvious over (1) Lee, Wang, and Yukie; and (2) Lee, Wang, Vanzini, and Yukie. Pet. 8. In our discussion below, we first provide a brief overview of Yukie, and then we address the parties’ contentions in turn.

1. Overview of Yukie

Yukie is directed to providing for remote storage and retrieval of data that otherwise would be provided locally. Ex. 1007, 2:8–11. Yukie describes addressing “limitations associated with relying on local data storage media by employing a wireless communications link to a remote data server.” *Id.* at 2:31–33. More specifically, Yukie discloses:

The data would be saved on the remote server for subsequent retrieval through, for example, the Internet or a wireless connection to the server. In addition, the user can download data from the server that did not originate from the user such as,

for example, commercially available audio files, video files, images, and the like. Data retrieval can be manual where the user specifies data to be downloaded, or can be automated through the use of a personal user profile stored on the server which defines what data will be downloaded, as well as how and when the data will be downloaded. Therefore, the invention not only provides an alternative to local data storage, but further enables the development of a myriad of consumer devices with wireless access to data.

Id. at 2:39–52.

2. *Discussion of Claim 10*

For claim 10, Petitioner contends

Claim 10 is substantially similar to independent claim 1, discussed above, and differs from claim 1 only on two points. First, claim 10 is directed to a system including the first and second user equipment of claim 1 with the nomenclature of the two user equipment being swapped, i.e., “first user equipment” in claim 1 is the “second user equipment” in claim 10, and vice versa. Ex. 1002, ¶¶ 65, 184. Second, the claimed “storage device remote from the first user equipment” in claim 10 means the storage device is remote from the pause user equipment, as opposed to the playback user equipment in claim 1.

Pet. 58. Petitioner contends that all other recitations of claim 10 correspond to limitations in claim 1 and Petitioner, therefore, relies on and refers to its contentions for claim 1. *Id.* at 58–59 (citing § VII.A of the Petition pertaining to claim 1 for all limitations in claim 10, except “limitation [10B]”)).

Upon review of the evidence in the current record and the parties’ contentions at this preliminary stage in the proceeding, for the reasons given below, we determine that Petitioner has shown sufficiently for purposes of this Decision how the combination Lee, Wang, and Yukie teaches each

recitation in independent claim 10. We also are persuaded that Petitioner has offered articulated reasoning with a rational underpinning as to why one of ordinary skill in the art would have modified and combined the teachings of the asserted art in the manner proposed by Petitioner. Because Petitioner relies on its contentions for claim 1 for most recitations in claim 10, in our discussion below of claim 10 we discuss and cite to Petitioner’s contentions for claim 1.

We start with the limitation

a first user equipment configured to:

receive a request to pause access to a media content;
cause to be stored, in a data structure of a profile of a user in
a storage device *remote* from the first user equipment,
when the request to pause access to the media content is
received, a position, in the media content, that
corresponds to a pause point;

(Ex. 1001, 19:10–16 (emphasis added)), which Petitioner refers to as limitation [10B]. Pet. 76. Regarding “remote” emphasized above, Petitioner points to Yukie’s description of providing for remote storage and retrieval of data and relies on the testimony of Dr. Tjaden regarding reasoning to combine Yukie with Lee and Wang. *Id.* at 60–61 (citing, *e.g.*, Ex. 1007, 2:7–10; Ex. 1002 ¶¶ 185–188).³ Regarding “a request to pause access” and storing “a position, in the media content, that corresponds to a pause point,” these recitations are similar to recitations in claim 1, and Petitioner

³ Regarding the preamble, *i.e.*, “[a] system comprising” referred to by Petitioner as limitation [10A] (*id.* at 76), we need not determine whether the preamble is limiting for purposes of this Decision because we determine Petitioner’s showing is sufficient at this juncture for the reasons given herein.

references its contentions for limitation [1B] pointing to Lee's description of a viewer interrupting a video program and profile writer 11 writing user profile information on profile card 9. *Id.* at 26, 58–60 (citing, *e.g.*, Ex. 1003, 2:40–44, 3:12–25, 4:17–33, 4:48–53, 5:24–37, 7:1–11, 8:1–50, Fig. 2). Dr. Tjaden testifies it would have been obvious to a person having ordinary skill in the art to allow users to access a user interface via different devices based upon a remotely stored user profile. Ex. 1002 ¶ 188. Dr. Tjaden testifies a person having ordinary skill in the art would have made the proposed combination because “[t]he user experience is thus improved with user profile data of a pause point of a program being accessible through a network by different devices.” *Id.* Dr. Tjaden further testifies that Petitioner's proposed combination “would provide enhanced security” when a profile card is lost. *Id.*

Lee describes if a user interrupts viewing of the video program, control unit 4 in video server 1 transmits to user terminal 2 an identifier and the interrupted position of the video program, which is written on profile card 9 inserted in profile writer 11. Ex. 1003, 4:50–58. Lee describes profile card 9 as “portable storage” (*id.* at 4:59) that is “insert[ed] . . . in a *second* user terminal” (*id.* at 8:41–42 (emphasis added)).⁴ Yukie describes “[d]ata can also be supplied to data server 16 by a first user device 10 to be

⁴ Patent Owner contends that claim 5 of Lee, which contains the portion cited by Petitioner (Ex. 1003, 8:41–42), does not predate the '799 Patent. Prelim. Resp. 5. During the reexamination of the '799 Patent's parent, the Examiner found that claim 5 of Lee is supported by the original disclosure of Lee. *See, e.g.*, Ex. 1010, 123. Although the Examiner's finding was discussed during an interview, “[n]o agreement was reached” (*id.* at 28) and the claims were amended to overcome Lee. *Id.* at 10.

accessed by a *second* user device (not shown).” Ex. 1007, 18:5–7 (emphasis added).

As discussed above in Section III.E.4, Patent Owner contends “the recited ‘data structure of the profile’ must be stored in a storage device ‘remote’ from the first user equipment.” Prelim. Resp. 11. Patent Owner further argues the combination of Lee and Wang lacks “teaching of creating and displaying multiple simultaneous options” based on receiving “*remotely-stored*” information. *Id.* at 23. Unlike claim 1, however, for claim 10 Petitioner relies on the combination of Lee, Wang, and Yukie. *See, e.g.*, Pet. 60–61 (citing, *e.g.*, Ex. 1007, 2:7–10; Ex. 1002 ¶¶ 185–188). Patent Owner’s contention does not take into account Yukie’s teaching of “remote storage and retrieval of data that otherwise would be stored locally.” Ex. 1007, 2:7–10.

Upon consideration of the parties’ contentions and the evidence of record, we determine Petitioner shows sufficiently, at this stage in the proceeding that the combination of Lee, Wang, and Yukie teaches limitation [10B] and Petitioner has articulated reasoning with a rational underpinning as to why one of ordinary skill in the art would have modified and combined the teachings of the asserted art in the manner proposed.

Turning next to

a second user equipment configured to:

access the data structure of the profile of the user;

access, from the data structure, the position that corresponds to the pause point;

retrieve the position that corresponds to the pause point from the data structure;

receive a selection of a media asset identifier corresponding to the media content;

determine, based on information in the data structure, that the media content was previously accessed by the first user equipment;

(Ex. 1001, 19:17–27), which Petitioner refers to as limitations [10C]–[10G]

(Pet. 76–77), Petitioner points to Lee’s description of a user resuming viewing of an interrupted video program. *See, e.g.*, Pet. 29–30, 58–59 (citing, *e.g.*, Ex. 1003, 3:26–37, 4:17–33, 4:56–58, 5:24–37, 8:1–50, Figs. 2, 3A, 3B).⁵ Lee describes that the second user terminal reads the identifier and the interrupted position information of the video program from the user profile card 9 through the profile reader 12 and then transmits the information to video server 1 through user profile sender 13. Ex. 1003, 5:24–29, 8:1–50. Control unit 4 in video server 1 identifies the corresponding video program using the identifier and position information in the user profile and video server 1 transmits to the second user terminal the corresponding video program from the interrupted position of the video program. *Id.* at 5:29–37, 8:1–50. Upon consideration of the parties’ contentions and the evidence of record, we determine Petitioner shows sufficiently, at this stage in the proceeding, that the combination of Lee, Wang, and Yukie teaches limitations [10C]–[10G].

Finally, turning to

based on the receiving of the selection of the media asset identifier corresponding to the media content:

⁵ Because Petitioner relies on its contentions for claim 1 for the remaining recitations in claim 10 (*id.* at 58–59), our discussion and citation are to Petitioner’s contentions for claim 1.

cause to be simultaneously displayed at the second user equipment a first option and a second option;
determine whether the first option or the second option is selected by the user; and
when it is determined that the first option is selected by the user:
generate a request including a position identifier that identifies the position that corresponds to the pause point,
transmit the request, and
receive, from the position that corresponds to the pause point, based on the position identifier included in the request, the media content; and
when it is determined that the second option is selected by the user:
access the media content starting from a second point in the media content which is prior to the position.

(Ex. 1001, 19:28–47 (emphases added)), which Petitioner refers to as limitations [10H]–[10L] (Pet. 77), Petitioner references its contentions for claim 1 (*id.* at 58–59) and relies on the previously discussed teachings of Lee and Yukie combined with Wang’s teachings of multiple bookmarks, as well as the testimony of Dr. Tjaden. *Id.* at 31–41 (citing, *e.g.*, Ex. 1004, (57), 2:7–15, 4:1–5, 4:32–35, 4:40–45, 4:49–58, 5:6–9, Figs. 1, 3; Ex. 1002 ¶¶ 120–142).

Wang describes that a user can select by the controlling interface one of multiple subpictures corresponding to the selected picture to be replayed, and then the selected picture will be shown on the display. Ex. 1004, 2:7–11. Figure 3 of Wang is reproduced below.

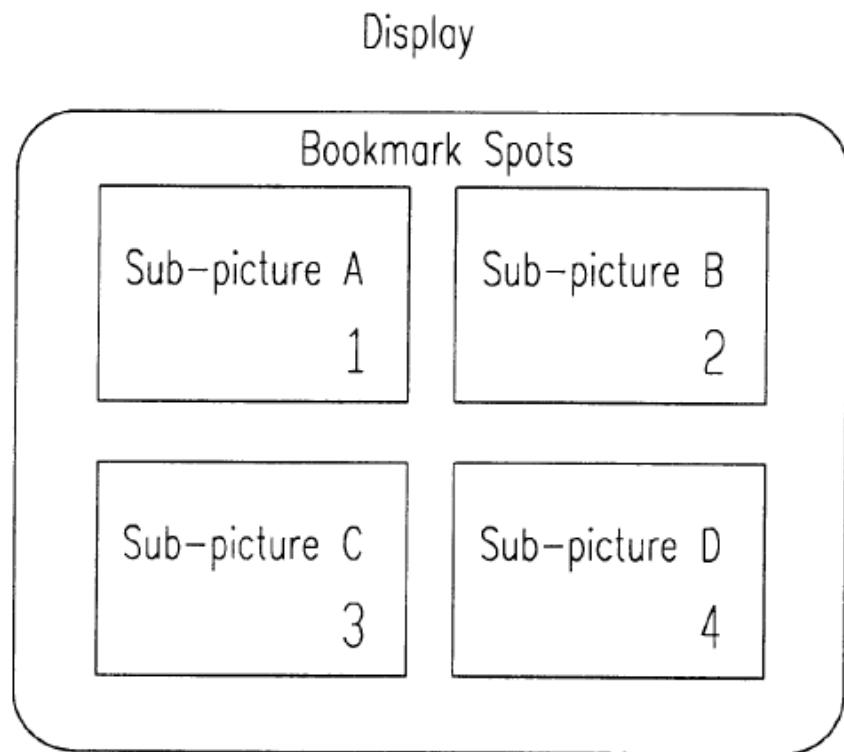


Figure 3 of Wang, above, illustrates a page on a display with four subpictures A, B, C, and D corresponding to four different bookmark spots. *Id.* at 4:46–52. Wang teaches that the subpictures are small pictures corresponding to full-scale pictures, “so it is very convenient for a user to select a picture to be replayed by the [video compact disc] (VCD) player.” *Id.* at 4:52–55.

Dr. Tjaden testifies a person having ordinary skill in the art would have known that a user interface “providing multiple options at one time was commonly known and practiced in the art to allow for a better user experience in selecting programs and content to watch” and Wang describes such a user interface. Ex. 1002 ¶ 121. Dr. Tjaden also testifies that a person having ordinary skill in the art would have understood Wang’s

“simultaneous display of multiple selectable bookmarks (illustrated in Figs. 1 and 3 of Wang above) to disclose simultaneous display of a first option and a second option” (*id.* ¶ 124) and would have understood Wang’s “bookmark to equate to a pause position or an interrupt point” (*id.* ¶ 130). Dr. Tjaden further testifies a person having ordinary skill in the art would have combined Lee’s system with Wang’s display of multiple bookmarks on a page “to provide enhanced functionality with respect to choice” (*id.* ¶ 125) and such an enhancement would “allow the user to quickly determine which of a plurality of positions the user wants to resume playback” (*id.* ¶ 130).

Patent Owner contends “[n]either Lee nor Wang discloses simultaneous displaying options” because “Wang’s bookmarks are not ‘resume’ options for paused media content.” Prelim. Resp. 21–22. Contrary to Patent Owner’s contention, however, Wang describes that “[w]hen a user is watching a program, he can *randomly* set a bookmark spot as *a starting point* for being browsed or *replayed*.” Ex. 1004, 1:19–20 (emphases added). Wang also describes that selection of a bookmark is “to *replay* or *browse*.” *Id.* at 4:1–5 (emphasis added). Based on the record before us at this preliminary stage, we are persuaded that Wang’s bookmarks teach options for a user to resume playing media content. Even if we were to accept that a bookmark in Wang differs from a pause point in the ’799 Patent, however, we are persuaded by Dr. Tjaden’s testimony that a person having ordinary skill in the art would have known that a user interface “providing multiple options at one time was commonly known and practiced in the art to allow for a better user experience in selecting programs and content to watch” and Wang describes such a user interface. Ex. 1002 ¶ 121.

Patent Owner further contends Wang’s bookmarks are distinguishable from the claimed options on the basis that Wang’s bookmarks are manually created by a user in advance and outside of play mode and stored locally on the VCD machine. Prelim. Resp. 22–23. That Wang’s bookmarks are manually created by a user in advance does not necessarily distinguish them from requests to pause access to media content. Indeed, claim 10 recites that “a request to pause access” is received by first user equipment (Ex. 1001, 19:10–11) and the ’799 Patent describes that “pause” is an option that may be selected by the user manually (*id.* at 9:64–65). Regarding Patent Owner’s contentions that Wang’s bookmarks are created outside of “play mode” and stored locally, Dr. Tjaden does not suggest bodily incorporation of Wang’s entire system into Lee’s, but instead testifies that one having ordinary skill in the art would have enhanced Lee’s user interface to display multiple resume options, as taught by Wang. *See, e.g.*, Ex. 1002 ¶¶ 124–125, 142.

Patent Owner also contends that the simultaneous display in Petitioner’s proposed combination is not “*based on receiving* information remotely stored in a user profile.” Prelim. Resp. 24. As discussed above with respect to limitations [10A]–[10G], Lee describes that when a user resumes viewing of an interrupted video program, user profile information is transmitted to video server 1. Ex. 1003, 5:24–29, 8:1–50. Petitioner relies on Yukie’s teaching of providing for “remote storage and retrieval of data that would otherwise be provided locally” for storing the user profile “in a storage device remote from the first user equipment” recited in claim 10. *See, e.g.*, Pet. 60 (citing, *e.g.*, Ex. 1007, 2:7–10, 18:5–7). As also discussed above with respect to limitations [10A]–[10G], Lee teaches that *video server 1* uses the identifier and position information in the user profile to resume

transmission of the video program. *Id.* at 5:29–37, 8:1–50. Patent Owner’s contention (Prelim. Resp. 24) is not persuasive because it is based on each of Lee and Wang considered alone, rather than considering the combined teachings of Lee, Wang, and Yukie. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981) (“[O]ne cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references.”)

Patent Owner further contends that a “person of ordinary skill in the art would not have combined the bookmarks of Wang with the pause feature of Lee” because Wang’s bookmark mode is too cumbersome to be an improvement to Lee. Prelim. Resp. 18–19 (citing Ex. 1004, 1:15–43). At this preliminary stage in the proceeding, we are persuaded by Dr. Tjaden’s testimony that one having ordinary skill in the art would have understood the proposed combination to be an enhancement. Ex. 1002 ¶¶ 120–142.

Upon consideration of the parties’ contentions and the evidence of record, we determine Petitioner shows sufficiently, at this stage in the proceeding, that the combination of Lee, Wang, and Yukie teaches limitation limitations [10H]–[10L] and Petitioner has articulated reasoning with a rational underpinning as to why one of ordinary skill in the art would have modified and combined the teachings of the asserted art in the manner proposed.

In summary, based on the record at this preliminary stage, we are persuaded by Petitioner’s showing for all recitations in claim 10. Also, we are persuaded that Petitioner has offered articulated reasoning with a rational underpinning as to why one of ordinary skill in the art would have modified and combined the teachings of the asserted art in the manner proposed by

Petitioner. Accordingly, for the reasons given and on the record before us at this juncture, we determine that Petitioner has shown a reasonable likelihood that it would prevail in establishing that claim 10 would have been obvious over Lee, Wang, and Yukie.

We note that Petitioner provides alternative contentions adding Vanzini to the combination of Lee, Wang, and Yukie. At this juncture, we are not persuaded that Petitioner’s reliance on Vanzini for teaching limitations related to “first” and “second” user equipment provides further support that claim 10 is unpatentable because Lee teaches inserting a portable user profile card into a second terminal and Yukie teaches that data supplied to the data server by a first user device may be accessed by a second user device. Patent Owner contends that the Petition has a fatal procedural defect because “Petitioner presents its positions in a multitude of ‘alternatives.’” Prelim. Resp. 13. Petitioner, however, presents alternatives based on its claim constructions positions. Although we decline to adopt Petitioner’s proposed broadest reasonable interpretation at this preliminary stage for the reasons given in Section III.D.2, we are not persuaded that Petitioner’s presentation of alternative grounds based on this interpretation constitutes a procedural defect in the Petition. Given our determination regarding the combination of Lee, Wang, and Yukie, therefore, we institute trial on all grounds raised in the Petition, including grounds relating to Vanzini. *See SAS Inst.*, 138 S. Ct. at 1359–60; USPTO Guidance. Petitioner’s reliance on Vanzini is the same for other independent claims, so we do not repeat our analysis below and, instead, limit our discussion to Lee, Wang, and Yukie.

3. *Discussion of Independent Claims 19 and 28*

Independent claims 19 and 28 of the '799 Patent are similar to independent claims 1 and 10. For each of claims 19 and 28, Petitioner relies on its contentions for claims 1 and 10. Pet. 62–64, 66–67 (citing, *e.g.*, Ex. 1002 ¶¶ 65–67, 194–201, 207–211). Petitioner accounts sufficiently for all differences in the claims. For instance, regarding “*a server* configured to” perform functions similar to those recited in claim 10, *i.e.*, “determine . . . that the media content was previously accessed” and “cause to be simultaneously displayed . . . a first option and a second option,”⁶ Petitioner relies on the testimony of Dr. Tjaden regarding the server in the preamble of claim 19 and the contentions discussed in Section III.F.2 relating to Lee’s teaching of video *server* 1 using the identifier and position information in the user profile to resume transmission of the video program, as well as Wang’s teaching of simultaneous display of multiple options for a user to resume playing media content and Yukie’s teaching of storing user information remotely. *Id.* at 62–64 (citing, *e.g.*, Ex. 1002 ¶ 65–67, 194–201). Dr. Tjaden testifies “Lee’s video *server* 1 is configured to operate in the same manner as described” in claim 19. Ex. 1002 ¶ 201 (emphasis added). Claim 28 recites a method with steps corresponding to functions performed in claim 10, and Petitioner provides contentions showing a mapping of the steps in claim 28 with the contentions we found persuasive as discussed in Section III.F.2 with respect to claim 10. Pet. 66–67.

⁶ Petitioner refers to these recitations as limitations [19A], [19C], and [19D], respectively. Pet. 78–79. According to Petitioner, limitations [19A], [19C], and [19D] correspond to limitations [1A], [1H], [1I], [10A], [10G], and [10H]. *Id.* at 58–59, 63.

For independent claims 19 and 28, Patent Owner relies on the same arguments discussed above in Sections III.E.4 and III.F.2 with respect to claims 1 and 10. *See generally* Prelim. Resp. For the reasons discussed above in this Section and in Section III.F.2 with respect to claim 10, based on the record at this preliminary stage, we are persuaded by Petitioner’s showing that the combination of Lee, Wang, and Yukie teaches each element of claims 19 and 28. Also, we are persuaded that Petitioner has offered articulated reasoning with a rational underpinning as to why one of ordinary skill in the art would have modified and combined the teachings of the asserted art in the manner proposed by Petitioner.

Accordingly, for the reasons given and on the record before us at this juncture, we determine that Petitioner has shown a reasonable likelihood that it would prevail in establishing that each of claims 19 and 28 of the ’799 Patent would have been obvious over Lee, Wang, and Yukie.

4. *Discussion of Claims 8, 17, and 26*

Claim 8 recites “wherein receiving the selection of the media asset identifier corresponding to media content” requires “receiving user input that identifies the user” and “in response to receiving the user input, *automatically* configuring the first user equipment to generate for display the first option and the second option.” Ex. 1001, 18:65–67 (emphasis added). Claims 17 and 26 recite similar recitations. *Id.* at 20:18–24, 21:36–41.

Petitioner contends

Yukie describes a system for remotely storing data on a server that would otherwise be provided locally on a consumer device. Ex. 1007, 2:7–10; Ex. 1002, ¶180. A user profile stored on a data server allows a user to configure specific media content (the claimed “option[s]”) to be automatically

transmitted from a remote server to a user device. Ex. 1007, Abstract, 2:44–52, 17:31–16:7; Ex. 1002, ¶180. The user profile defines how and when the data will be downloaded. Ex. 1007, 2:44–52. The retrieved media content may then be automatically displayed on the user device. Ex. 1007, 20:19–65. Such data retrieval has multiple benefits, including allowing end user equipment to be automatically configured to generate data from a networked user profile in response to receiving user input. Ex. 1002, ¶181.

Pet. 56.

Claim 8 depends directly from claim 1. Regarding storing “in a data structure of a profile of a user in a storage device *remote from* the first user equipment when the request to pause access to the media content was received by the second user equipment” recited in claim 1 (Ex. 1001, 17:55–67 (emphases added)), as we discussed in Section III.E.4, we are not persuaded by Petitioner’s contentions relying on its proposed construction at this preliminary stage for the reasons given in Section III.D.2. As set forth above, for claim 8, however, Petitioner points to the same teachings in Yukie relied upon for claim 10. Pet. 56 (citing, *e.g.*, Ex. 1007, (57), 2:44–52, 17:31–18:7, 20:19–65; Ex. 1002, ¶180). Yukie teaches “remote storage” (Ex. 1007, 2:9) and data server 16 transmitting data to user device 10 “according to the user profile.” *Id.* at 17:46–47. For the reasons discussed in Section III.F.2 with respect to claim 10 and further because for claim 8, Petitioner has articulated reasoning with a rational underpinning as to why one of ordinary skill in the art would have modified and combined the teachings of the asserted art in the manner proposed, we are persuaded by Petitioner’s showing relying on the combined teachings of Lee, Wang, and Yukie for the aforementioned recitation in claim 1, as well as the further

recitation in claim 8. We also are persuaded by Petitioner’s showing for the further recitations in claims 17 and 26.

Patent Owner does not argue separately Petitioner’s contentions for claims 8, 17, and 26. Accordingly, for the reasons given and on the record before us at this juncture, we determine that Petitioner has shown a reasonable likelihood that it would prevail in establishing that each of claims 8, 17, and 26 of the ’799 Patent would have been obvious over Lee, Wang, and Yukie.

5. *Discussion of Claims 11–13, 15, 20–22, and 24*

Claims 11 and 12 depend directly from claim 10 and further recite “wherein the second user equipment is further configured to generate an instruction to display the media content at the second user equipment from [the first point (claim 11)/the second point (claim 12)] in the media content when it is determined that the first option was selected.” Ex. 1001, 19:48–57. Claims 20 and 21 depend directly from claim 19 and include recitations that are substantially the same as claims 11 and 12, respectively, except claims 20 and 21 each require that the server is further configured to generate the instruction. *Id.* at 20:65–21:7. Petitioner relies on Lee’s description that the second user terminal (the playback terminal) generates an instruction to display the program from the selected pause point, which combined with Wang’s displaying of multiple bookmarks for user selection teaches the further recitations in dependent claims 11, 12, 20, and 21. Pet. 41–42, 62, 65 (citing, *e.g.*, Ex. 1003, 2:41–49, 3:4–11, 3:37–45, 4:17–33, 5:24–29, 5:32–37, 5:51–65, 6:26–33, 7:1–5, 8:1–50; Ex. 1004, (57); Ex. 1002 ¶¶ 143–147).

Claims 13 and 22 depend directly from claims 10 and 19, respectively, and each further recites “wherein the second point is selected by the user using the second equipment.” Ex. 1001, 19:59–58, 21:8–9. Claims 15 and 24 depend directly from claims 10 and 19, respectively, and each of claims 15 and 24 further recites “wherein [the second user equipment/server] is further configured [to display/to generate for display, on the second user equipment,] a third option that causes, responsive to user selection, the second user equipment to display the media content from a point in the media content that is after the position.” Ex. 1001, 20:6–10, 21:23–27. Petitioner points to the same teachings identified with respect to dependent claims 11, 12, 20, and 21, and also points to further detailed teachings in Wang relating to the display of multiple bookmarks as well as Dr. Tjaden’s testimony that one having ordinary skill in the art would have understood that Wang teaches bookmarks that allow resuming replaying at different points, one point being before another point. Pet. 43–46 (citing, *e.g.*, Ex. 1004, (57), 1:65–66, 2:7–15, 4:32–35, 4:40–45, 4:59–60, 5:6–9; Ex. 1002 ¶¶ 149–159).

Patent Owner does not argue separately Petitioner’s contentions for claims 11–13, 15, 20–22, and 24. Accordingly, for the reasons given and on the record before us at this juncture, we determine that Petitioner has shown a reasonable likelihood that it would prevail in establishing that each of claims 11–13, 15, 20–22, and 24 of the ’799 Patent would have been obvious over Lee, Wang, and Yukie.

G. Obviousness—Dependent Claims 14, 18, 23, and 27

Petitioner contends each of claims 14, 18, 23, and 27 of the '799 Patent is unpatentable, under 35 U.S.C. § 103(a), as obvious over (1) Lee, Wang, Yukie, and Bonomi; and (2) Lee, Wang, Yukie, Vanzini, and Bonomi. Pet. 8. Regarding Petitioner's alternative contentions relying on the combination with Vanzini, as discussed above in Section III.F.2, we are not persuaded that these contentions provide further support that the independent claims are unpatentable. We address the parties' contentions regarding Lee, Wang, Yukie, and Bonomi below.

1. Overview of Bonomi

Bonomi describes centrally managed storage for paused or recorded media. Ex. 1005, 2:44–46. The media delivery system may be restricted differently for different users of a common subscriber account. *Id.* at 5:57–61. Vault module 718 provides personal storage for subscribers for content recorded or paused either by the owner of the account or other designated subscribers. *Id.* at 21:34–37. Authentication is checked based on username and password. *Id.* at 22:42–44.

2. Claims 14, 18, 23, and 27

Claims 14, 18, 23, and 27 of the '799 Patent depend directly from claims 10 and 19, respectively. Each of claims 14 and 23 recites

wherein the [second user equipment/server] is further configured, when accessing the data structure of the profile of the user, to:

generate a login option to be displayed to the user [at/using] the second user equipment;

receive a communication including login identification and associated password information from the user;
generate a request for authorization;
transmit the request for authorization; and
receive, based on a determination that the login identification and associated password information are valid, authorization to access the data structure of the profile of the user.

Ex. 1001, 19:60–20:5, 21:9–22. Each of claims 18 and 27 recites “wherein the position is associated with an account associated with the user of the first user equipment, the first user equipment, or user-specific data.” *Id.* at 20:25–27, 22:1–3.

For the further recitations of claims 14, 18, 23, and 27, Petitioner points to Bonomi’s centrally managed storage for paused or recorded media that controls access to accounts by checking authentication using a username and password. Pet. 46–52, 67–69 (citing, *e.g.*, Ex. 1005, (57), 21:52–22:11, 22:35–46, 33:1–29, Figs. 7C, 15A). Regarding reasoning to combine, Petitioner relies on the testimony of Dr. Tjaden that a person having ordinary skill in the art would have used Bonomi’s passwords to protect the user profile from unauthorized access. *Id.* (citing Ex. 1002 ¶¶ 161–170, 212–218).

Patent Owner does not argue separately Petitioner’s contentions for claims 14, 18, 23, and 27. Based on the record at this preliminary stage, we are persuaded by Petitioner’s showing that the further recitations in claims 14, 18, 23, and 27 are taught by the asserted art. Also, we are persuaded that Petitioner has offered articulated reasoning with a rational underpinning as to why one of ordinary skill in the art would have modified and combined the teachings of the asserted art in the manner proposed by Petitioner.

In summary, for the reasons given and on the record before us at this juncture, we determine that Petitioner has shown a reasonable likelihood that it would prevail in establishing that dependent claims 14, 18, 23, and 27 of the '799 Patent are unpatentable, under 35 U.S.C. § 103(a), as obvious over Lee, Wang, Yukie, and Bonomi.

H. Obviousness—Dependent Claims 16 and 25

Petitioner contends that claims 16 and 25 of the '799 Patent are unpatentable, under 35 U.S.C. § 103(a), as obvious over (1) Lee, Wang, Yukie, and Noble; and (2) Lee, Wang, Yukie, Vanzini, and Noble. Pet. 8. Regarding Petitioner's alternative contentions relying on the combination with Vanzini, as discussed above in Section III.F.2, we are not persuaded that these contentions provide further support that the independent claims are unpatentable. We address the parties' contentions regarding Lee, Wang, Yukie, and Noble below.

1. Overview of Noble

Noble is directed to a system and method for issuing search commands so a user can interactively choose a selection from a media database. Ex. 1006, (57). Noble describes movie finder service 313, which is a text-driven search scheme. *Id.* at 5:51–53. Figure 7 is reproduced below.

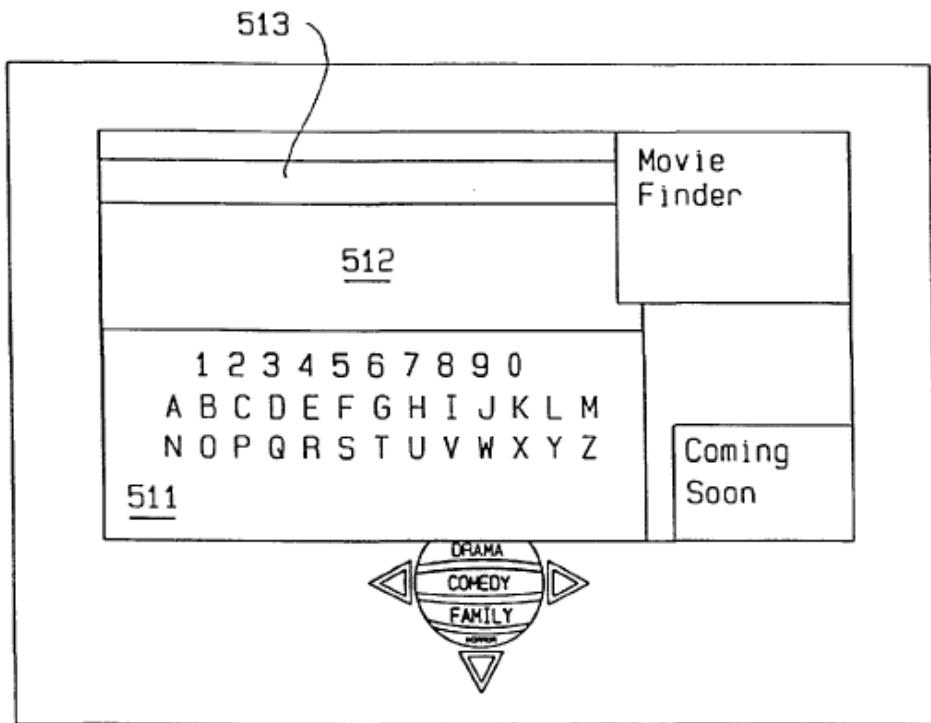


FIG. 7

Figure 7 illustrates a display on a user's television when movie finder service 313 is selected, which includes virtual keyboard 511, title entry window 513, and title display window 512. *Id.* at 5:54–57. The user highlights letters on virtual keyboard 511 for entry in title entry window 513. *Id.* at 5:58–60. After an initial letter is entered, a partial listing of movies starting with that letter is displayed in title display window 512. *Id.* at 5:63–65.

2. *Claims 16 and 25*

Claims 16 and 25 depend directly from claims 10 and 19, and each of claims 16 and 25 recites

wherein the [second user equipment/server] is further configured to:
receive[, at the second user equipment,] either (1) an indication of program type, or (2) a text string; and
in response to the receiving of either the indication of program type or the text string, receive [at the second user equipment,] search results including the previously accessed media content.

Ex. 1001, 20:11–17, 21:27–35. Petitioner points to Noble’s text-search of movie titles or genre. Pet. 52–55, 69–70 (citing, *e.g.*, Ex. 1006, 5:51–6:8, Figs. 8A, 8B). Regarding reasoning to combine, Petitioner relies on the testimony of Dr. Tjaden that one having ordinary skill in the art would have improved Lee, Wang, and Yukie’s system with Noble’s searching functionality to allow the user to quickly select a program to view. *Id.* (citing, *e.g.*, Ex. 1002 ¶¶ 171–178, 219–222).

Patent Owner does not argue separately Petitioner’s contentions for claims 16 and 25. Based on the record at this preliminary stage, we are persuaded by Petitioner’s showing that the further recitations in claims 16 and 25 are taught by the asserted art. Also, we are persuaded that Petitioner has offered articulated reasoning with a rational underpinning as to why one of ordinary skill in the art would have modified and combined the teachings of the asserted art in the manner proposed by Petitioner.

In summary, for the reasons given and on the record before us at this juncture, we determine that Petitioner has shown a reasonable likelihood that it would prevail in establishing that dependent claims 16 and 25 of the ’799 Patent are unpatentable, under 35 U.S.C. § 103(a), as obvious over Lee, Wang, Yukie, and Noble.

IV. CONCLUSION

Upon consideration of the parties' contentions and the evidence of record, we determine that Petitioner has shown a reasonable likelihood that it would prevail in establishing the unpatentability of at least claims 8 and 10–28 of the '799 Patent on all grounds presented in the Petition. Given our determination, we institute trial on all challenged claims and all grounds raised in the Petition. *See SAS Inst.*, 138 S. Ct. at 1359–60; USPTO Guidance.

At this preliminary stage, no final determination has yet been made with regard to the patentability of any challenged claim or any underlying factual or legal issues. The final determination will be based on the record as developed during the *inter partes* review.

V. ORDER

In consideration of the foregoing, it is hereby
ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–28 of the '799 Patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '799 Patent shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

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