

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LG ELECTRONICS, INC.,  
Petitioner

v.

ATI TECHNOLOGIES ULC,  
Patent Owner

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Case IPR2015-00321  
Patent 7,095,945

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**PATENT OWNER'S MOTION FOR OBSERVATION  
ON CROSS EXAMINATION OF PETITIONER'S REPLY  
WITNESS DR. DANIEL SCHONFELD**

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Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**EXHIBIT LIST**

<b>Exhibit Number</b>	<b>Document Description</b>
2001	Affidavit of Aaron R. Fahrenkrog, dated January 15, 2015, filed and served concurrently herewith Patent Owner's Motion for <i>Pro Hac Vice</i> Admission of Aaron R. Fahrenkrog Under 37 C.F.R. § 42.10(c)
2002	Affidavit of William H. Manning, dated January 15, 2015, filed and served concurrently herewith Patent Owner's Motion for <i>Pro Hac Vice</i> Admission of William H. Manning Under 37 C.F.R. § 42.10(c)
2003	Declaration of Dr. William Mangione-Smith
2004	"A consumer digital VCR for digital broadcasting" by Hatanaka et al. (1998)
2005	"A consumer digital VCR for advanced television" by Okamoto et al. (1993)
2006	"A consumer digital VCR for digital broadcasting" by Okamoto et al. (1995)
2007	Webster's Dictionary Definition for "portion"
2008	Deposition Transcript of Daniel Schonfeld, Ph.D.
2009	Exhibit 5 from Deposition of Daniel Schonfeld, Ph.D.
2010	"Digital video recorder," from Wikipedia, obtained on September 28 <sup>th</sup> , 2015; <a href="https://en.wikipedia.org/wiki/Digital_video_recorder">https://en.wikipedia.org/wiki/Digital_video_recorder</a>
2011	Intentionally Left Blank
2012	Intentionally Left Blank
2013	Transcript of Daniel Schonfeld, Ph.D dated February 12, 2016

Patent owner ATI Technologies ULC respectfully asks the Board to consider this Motion for Observation on Cross-Examination of petitioner LG's reply witness Dr. Daniel Schonfeld. Dr. Schonfeld's reply declaration is Exhibit 1012, and the transcript of the cross-examination deposition is presented in its entirety as Exhibit 2013. The observations are set forth below.

**Observation 1: Dr. Schonfeld testified that switch 8 of Hatanaka does not need to be toggled for simultaneous storing and decoding of different portions of the same program.**

Dr. Schonfeld testified that Hatanaka's "switch 8 is independent of switch 25" and that in order to meet claim 18's simultaneous requirement, "there is no need for ... switch 8 to do any type of toggling." (Ex. 2013, 53:2:5, 53:18-22.) This is relevant to Petitioner's theory that Hatanaka could perform simultaneous storing and decoding of different portions of the same program. Dr. Schonfeld testimony is relevant, because it is unsupported by Hatanaka. Hatanaka's system plays a live program when switch 8 is set to contact "a" and in order to record (i.e. store) the live program, Hatanaka's switch 8 needs to be set to position "a" in order to receive the proper decoder clock 45 signal so that data packets can be stored with the correct timing information. (Hatanaka, 3:42-63 4:38-50, 3:16-32.) But Hatanaka's switch 8 must be set to position "b" to play back (i.e., decoding) programming that was previously recorded (Hatanaka, 4:27-30) — a requirement that precludes simultaneous storing and decoding of different portions of the same

program, because switch 8 is unable to be in two different positions at the same time.

**Observation 2: Dr. Schonfeld testified, without any supporting evidence, that Hatanaka's switches could be toggled at double the processing rate in order to simultaneously store and decode different portions of the same program.**

Dr. Schonfeld testified on cross-examination, without any supporting evidence, that Hatanaka's switches could alternate positions at double the processing rate in order to perform simultaneous storing and decoding of different portions of the same program. (Ex. 2013, 6:22-7:11.) This is relevant to petitioner's theory that Hatanaka could perform claim 18's third mode of operation. (Petitioner's Reply, p. 16). Dr. Schonfeld's testimony is relevant for three reasons. *First*, Dr. Schonfeld and petitioner, for the first time, try to explain how Hatanaka's switches could be toggled at double the processing rate to perform simultaneous storing and decoding of different portions of the same program – an explanation that is conclusory and not supported by any intrinsic or extrinsic evidence in the record. *Second*, Dr. Schonfeld does not cite to Hatanaka, O'Connor, or any other reference to support his opinion that toggling switches at double the processing rate would allow Hatanaka's VCR to perform claim 18's third mode of operation. *Third*, when asked repeatedly to give an example of a processing rate, Dr. Schonfeld was unable or unwilling to do so. (See Ex. 2013, 9:12 – 14:23.)

**Observation 3: Dr. Schonfeld testified that Hatanaka’s VCR did not need significant modifications to simultaneous store and decode different portions of the same program, but then lists significant modifications that would be needed.**

When asked how Hatanaka would perform simultaneous storing and decoding, Dr. Schonfeld speculated, without any support, about the different combination of modifications needed to Hatanaka’s system:

- “the switches could alternate position at double the rate required for processing by either storage or playback.” (Ex. 1012, ¶18);
- “using multiple heads in a VCR recording function over multiple tracks ... [using] multiple VCRs ... [using] a different storage device” (Ex. 2013, 66:18-24);
- having “data clock 45 and fixed clock 46 made available directly to packet control[ler] 18” (Ex. 2013, 54:22-25);
- inserting a phase lock loop into Hatanaka’s circuit and allowing the clock generator to send its clocks to the phase lock loop instead (Ex. 2013, 64:2-7); and
- having “clock generator ... [perform synchronization] with the data recovered from the program clock reference in the clock recovery circuit” (Ex. 2013, 64:23-65:1)

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