

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.
Petitioner.

v.

ATI TECHNOLOGIES ULC.
Patent Owner.

Case IPR2015-00321
Patent 7,095,945 B1

PATENT OWNER RESPONSE

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I. INTRODUCTION 1

 A. Statement of Relief Requested 1

 B. Summary of Patent Owner’s Argument 1

II. BACKGROUND 7

 A. ’945 Patent Overview 7

 B. Claim 18 9

III. A PERSON OF ORDINARY SKILL IN THE ART (“POSA”)..... 11

IV. CLAIM CONSTRUCTION. 11

V. ANALYSIS OF GROUNDS 16

 A. Hatanaka does not render obvious claim 18 of the ’945 patent 17

 1. Overview of Hatanaka 17

 2. Hatanaka’s system will not simultaneous record and playback
 the same program, as required by claim 18. 26

 3. Hatanaka does not disclose the claimed first demultiplexer. 31

 4. Significant modifications to Hatanaka’s system would have be
 needed to cure all of Hatanaka’s deficiencies with respect to
 claim 18. 41

 B. LG fails to establish that Hatanaka in view of O’Connor renders
 obvious claim 18. 47

 1. O’Connor does not remedy the deficiencies of Hatanaka with
 respect to the first demultiplexer. 47

 2. The combination of Hatanaka and O’Connor would not have
 functioned to perform claim 18’s third mode of operation
 without extensive modification and undue experimentation. 50

VI. DR. SCHONFELD’S DECLARATION SHOULD BE AFFORDED
LITTLE WEIGHT53

A. Dr. Schonfeld’s deposition testimony highlights the absence of
underlying facts or data to support his conclusions.54

VII. CONCLUSION56

TABLE OF AUTHORITIES

Cases

<i>Application of McLaughlin</i> , 443 F.2d 1392 (C.C.P.A 1971)	41
<i>Grain Processing Corp. v. Am. MaizeProds. Co.</i> , 840 F.2d 902 (Fed. Cir. 1988)	45
<i>Hewlett-Packard Co. v. MCM Portfolio, LLC</i> , IPR2013-00217, Institution Decision, Paper No. 10 (P.T.A.B. Sept. 10, 2013).....	56
<i>In re Dembiczak</i> , 175 F.3d 994 (Fed. Cir. 1999)	46
<i>In re Fine</i> , 837 F.2d 1071 (Fed. Cir. 1988)	55
<i>In re Fritch</i> , 972 F.2d 1260 (Fed. Cir. 1992)	55
<i>In re Kahn</i> , 441 F.3d 977 (Fed. Cir. 2006)	7
<i>In re NTP, Inc.</i> , 654 F.3d 1279 (Fed. Cir. 2011)	12
<i>In re Skvorecz</i> , 580 F.3d 1262 (Fed. Cir. 2009)	12
<i>In re Wands</i> , 858 F.2d 731 (Fed. Cir. 1988).....	51
<i>Kinetic Techs., Inc. v. Skyworks Solutions, Inc.</i> , IPR2014-00529, Institution Decision, Paper No. 8 (P.T.A.B. Sept. 23, 2014).....	53, 56

KSR Int’l Co. v. Teleflex Inc.,
550 U.S. 398 (2007)..... 7, 41, 50

Microsoft Corp. v. Proxyconn, Inc.,
789 F.3d 1292 (Fed. Cir. 2015)12

NewRiver, Inc. v. Mobular Tech., Inc.,
478 F. Supp. 2d 158 (D. Mass. 2007).....15

Phonometrics, Inc. v. N. Telecom, Inc.,
133F.3d 1459 (Fed. Cir. 1998)31

Vitronics Corp. v. Conceptronc, Inc.,
90 F.3d 1576 (Fed. Cir. 1996)13

Statutes

35 U.S.C. § 316.....1

35 U.S.C. §§ 311–319.....1

Rules

37 C.F.R. § 42.100(b)12

37 C.F.R. § 42.120.....1

37 C.F.R. § 42.6556

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.