UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY COMPUTER ENTERTAINMENT AMERICA LLC
Petitioner,

v.

ROTHSCHILD DIGITAL MEDIA INNOVATIONS, LLC
Patent Owner.

Case No. IPR2015-01364
Patent 6,101,534

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

PURSUANT TO 37 C.F.R. § 42.120

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I. INTRODUCTION

This proceeding hinges on the claim construction of the "access" concept in the Challenged Claims, and Patent Owner ("PO") concedes the claims should be broadly construed to include a remote server directing a local processor to access data. That is the heart of the case, and once the claims are properly construed, application of the prior art and a determination of obviousness are both straightforward propositions. PO cannot reasonably challenge any of this, so PO instead deploys some familiar countermeasures along with some unusual ones. In one remarkable inconsistency, PO criticizes new evidence because it has never been presented before, but then asserts that the Board should be bound by an earlier reexamination conclusion because there is nothing new here. All of this should be taken for what it is—chaff intended to distract from a strong showing of unpatentability.

For instance, PO presents a lengthy criticism of the adjectives used in the Institution Decision to describe one claim construction issue. The Decision points out that the agreed construction includes "indirect access," and PO would prefer that the Board describe the construction some other way. PO is not challenging the construction itself, which includes a path through a local processor. Instead, PO is just challenging the nomenclature used to describe the construction. None of this matters to any substantive issue in this proceeding. All that matters is what the

construction actually covers, and there is agreement between PO and Petitioner on this point, as the Institution Decision recognized. *See*, *e.g.*, **Paper 8**, *Institution Decision* at 9.

PO then reaches for the more familiar touchstones of obviousness oppositions by asserting that prior art is non-analogous and that there is no motivation to combine. But here these assertions are belied by the record. On analogous art, PO insists that no PHOSITA would ever look to broadcast television. And yet the inventor of the '534 Patent described and claimed broadcast technology as within the scope of his invention. On motivation to combine, PO speculates that any combination with Batchelor would fundamentally change the transmitted data operation of Mages. And yet Batchelor expressly describes using packetized data with a personal computer—the same data transmitting concept described in Mages. This combination just improves Mages by including command and address information into the transmitted data.

Finally, PO emphasizes a negative limitation that was added to Claims 23 and 24, and attempts to salvage patentability by implying that Petitioner must prove that the prior art cannot operate in some other way. PO's argument is legally flawed. Claims 23 and 24 recite accessibility "only while the local processor assembly is interactively online …." Because this limitation defines what prior art or accused systems cannot do (i.e., systems cannot access auxiliary site addresses

while offline), rather than affirmatively stating what they must do, this is a negative limitation. To prove invalidity of a negative limitation, it is Petitioner's burden to demonstrate that prior art discloses what the claims affirmatively require. *See*, *e.g.*, *Upsher-Smith Labs., Inc. v. Pamlab, LLC*, 412 F.3d 1319, 1322-23 (Fed. Cir. 2005). Petitioner has done so here by showing that Mages allows accessibility while the local processor is interactively online. *See id.* It is not Petitioner's burden, nor should it be, to prove the negative—that is, to prove that Mages cannot operate any other way. *See id.* Instead, it is PO's burden of production to identify rebuttal evidence. *See id.* Here, PO provided nothing more than speculation that Mages might operate in some way different from what it disclosed. Neither PO nor its expert have identified any evidence in Mages that shows accessing auxiliary site addresses while offline, and the actual Mages disclosure is contrary to PO's position. Petitioner bears the burden of proof, and that burden does not shift. But where, as here, Petitioner has presented evidence satisfying its burden, PO cannot defeat obviousness with speculation about how prior art might or might not operate in a way not disclosed by the prior art itself.

II. CLAIM CONSTRUCTION

PO's characterizations and criticisms of the Board's claim construction analysis are meritless and should be rejected. The Board performed the claim construction analysis correctly in the Institution Decision, and should maintain the

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