

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,

Petitioner,

v.

ADVANCED CODING TECHNOLOGIES, LLC,

Patent Owner.

Patent No. 8,230,101

Filing Date: March 2, 2007

Issue Date: July 24, 2012

Inventors: Satoru Sekiguchi, Yoshio Sonoda, Isao Nakamura, Masamichi Furukawa, Yoshihisa Mashita, Tomoaki Yoshida, and Masahito Watanabe

Title: SERVER DEVICE FOR MEDIA, METHOD FOR CONTROLLING SERVER FOR MEDIA, AND PROGRAM

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**PATENT OWNER'S PRELIMINARY RESPONSE**

Case No. IPR2025-01103

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<b>Exhibit No.</b>	<b>Description of Document</b>
2001	Third Amended Docket Control Order, Dkt. 42, <i>Advanced Coding Techs. LLC v. Apple Inc.</i> , Case No. 2:24-cv-00572-JRG (E.D. Tex. October 29, 2024)
2002	Apple Inc.'s Second Supplementary Invalidity Contentions in <i>Advanced Coding Techs. LLC v. Apple Inc.</i> , Case No. 2:24-cv-00572-JRG (E.D. Tex.), dated July 3, 2025
2003	Advanced Coding Technologies LLC's Infringement Contentions and P.R. 3-1 and 3-2 Disclosures in <i>Advanced Coding Techs. LLC v. Apple Inc.</i> , Case No. 2:24-cv-00572-JRG (E.D. Tex.), dated September 18, 2024
2004	Joint Claim Construction and Prehearing Statement, Dkt. 72, <i>Advanced Coding Techs. LLC v. Apple Inc.</i> Case No. 2:24-cv-00572-JRG (E.D. Tex.), filed August 21, 2025

## I. INTRODUCTION

On June 4, 2025, Apple Inc. (“Petitioner” or “Apple”) submitted a Petition (Paper 2, “Petition” or “Pet.”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 8,230,101 (APPLE-1001, the “101 Patent”), challenging Claims 1-12 (the “Challenged Claims”). The Petition asserts that (i) the Challenged Claims are rendered obvious over U.S. Patent Publication No. 2006/0161635 to Lamkin et al. (“APPLE-1004” or “Lamkin”); (ii) the Challenged Claims are rendered obvious over Lamkin in view of U.S. Patent No. 7,219,123 to Fiechter et al. (“APPLE-1006” or “Fiechter”); (iii) Claims 1-5 and 7-11 are rendered obvious over Lamkin in view of International Patent Publication No. WO2006/073040 to Ito et al. with certified English translation (“APPLE-1012” or “Ito”); (iv) the Challenged Claims are rendered obvious over U.S. Patent Publication No. 2003/0195924 to Franke et al. (“APPLE-1005” or Franke”); (v) the Challenged Claims are rendered obvious over Franke in view of Fiechter; and (vi) Claims 1-5 and 7-11 are rendered obvious over Franke in view of Ito. Pet. at 6. The Board should deny the Petition for at least the reasons described briefly below.

Petitioner fails to show that any combination of Phek, YuChuan, Martins, and He discloses at least “a first resolution converter configured to work on the set of super-resolution enlarged pictures to implement a process for a first resolution conversion to create a set of super-resolution enlarged and converted pictures with a

standard resolution,” “have the set of super-resolution enlarged and converted pictures from the first resolution converter as a set of encoding target pictures, the set of decoded pictures from the first encoder as a set of first reference pictures, and the set of super-resolution enlarged and converted decoded pictures from the second resolution converter as a set of second reference pictures,” “select one of the set of first reference pictures and the set of second reference pictures to create reference picture selection information to identify the set of selected reference pictures to implement a second process for encoding to create a second sequence of encoded bits based on the set of encoding target pictures and the set of selected reference pictures,” and “wherein the set of encoding target pictures, the set of first reference pictures, and the set of second reference pictures have the same value in spatial resolution.”

First, the Petition is deficient because Lamkin’s aggregated content view does not indicate which device (e.g., internal storage device or network storage device) contains content and the Petition plainly ignores that the claimed list information contains two specific types of information: (i) “digital contents left in the internal storage device” (after transfer); and (ii) “digital contents transferred from the internal storage device to the network storage device and stored in the network storage device.” Moreover, Petitioner’s reliance on Lamkin’s CDS list is inapposite because the CDS list relates to a user’s determination regarding contents to transfer (i.e.,

content to be transferred) rather than a post-transfer determination of where contents are stored (i.e., content has been transferred).

Second, the Petition is silent regarding whether (i) whether the tree structure is of the digital contents specifically *in the internal storage device*; and (ii) whether the tree structure is of the digital contents *before transferring the digital contents to the network storage device*. See Pet. at 23-25. Petitioner's broad citations to Lamkin do not relate to a tree structure of digital contents before those same digital contents are transferred to a network storage device but only that Lamkin's CDS "can include other data, such as metadata and other relevant data that identify the content and/or allow users to more easily locate and access the content" and that content in Lamkin's aggregated content view is "independent of the device" such that "[t]he user does not need to know which device contains the content."

Third, the Petition is deficient because Petitioner's Grounds 2A, 2B, and 2C rely on Franke's "assigned projects" to disclose the claimed "list information." However, the cited portions of Franke only disclose whether a user may access project data from a local proxy server or indirectly from a central server through the local proxy server, which has no bearing on whether there is list information, let alone the claimed list information comprising (i) "digital contents left in the internal storage device" (after transfer); and (ii) "digital contents transferred from the internal

storage device to the network storage device and stored in the network storage device.”

Fourth, Franke cannot meet the claimed “tree structure” limitation because it does not even mention the word “tree.” Even assuming that Franke’s “exemplary folder hierarchy” is a “tree structure” as Petitioner asserts, the cited portions of Franke, disclosing that media is posted to be displayed to the user independent of where the media is stored, has no relevance as to whether the digital contents in the tree structure pertains to content “before transferring” “to the network storage device,” as the claim recites.

Accordingly, the Board should deny institution of the Petition.

## II. THE ALLEGED PRIOR ART

### A. Lamkin

Lamkin “relates generally to network media service, and more particularly to managing media content over a network.” APPLE-1004, [0002].

Lamkin discloses “an aggregated content view that allows users to find content independent of the device” that the content is stored on. *Id.*, [0128], [0303]. With Lamkin’s aggregated content view, “the user does not need to know which device contains the content, but simply what content they are looking for.” *Id.*

Lamkin also discloses “determin[ing] whether the content is *to be transferred to* or can be utilized by other devices on the network . . . [and] CDS or other tracking

is updated identifying the new content, whether the new content is centralized and/or where the content is stored and/or centralized,” rather than where content *has been transferred* across all devices. *Id.*, [0077] (emphasis added).

Lamkin’s CDS may “utiliz[e] the date of the files *to form a tree structure* based on year, month, date.” *Id.*, [0264] (emphasis added). Lamkin’s CDS “can include other data, such as metadata and other relevant data that identify the content and/or allow users to more easily locate and access the content.” *Id.*, [0077].

## **B. Franke**

Franke “relates generally to data sharing systems and, more particularly, to methods and systems using a local proxy server to process media data for local area users.” APPLE-1005, [0002].

Franke discloses “assigned projects” which include “information about whether the project is completely transferred to the central server or is downloadable from the proxy server.” *Id.*, [0042], [0048]-[0049], [0053], [0070], [0112]-[0113], FIG. 11. “LAN users 130-140 can copy project data being stored on central server 110 from local proxy server 150.” *Id.*, [0042]. “Proxy server application 175 can determine the location of data files being stored in local storage [and that ] Proxy Server application 175 can also maintain a connection or session with central server 110 for LAN users 130-140.” *Id.* at [0048]-[0049]. An API may determine whether posted media data is stored on a local proxy server and access it, or, if not stored on

a local proxy server, the API may download it from the central server. *Id.* at [0070]. Franke also discloses a UI interface “allowing a user to configure settings for posting or downloading media data.” *Id.* at [0112]-[0113], FIG 11. Moreover, Franke discloses that project data requests are made of a local proxy server, and if the local server does not contain the requested project data, the local proxy server can request it from the central server without any determination of whether such data was transferred from the local proxy server. *Id.* , [0053].

### III. CLAIM CONSTRUCTION

Petitioner’s assertion that “no claim terms need be construed to resolve issues of controversy raised by this Petition” (Pet. at 5) contradicts its positions in *Advanced Coding Techs. LLC v. Apple, Inc.*, Case No. 2:24-cv-00572-JRG (E.D. Tex.) (the “District Court Litigation”). In the District Court Litigation, both parties agreed to the following constructions:

Claim Term	Claims	ACT’s Proposed Construction	Apple’s Proposed Construction
“transfer” / “transferring”	’101 Patent, Claims 1, 4, 7	Plain and ordinary meaning	“to move data from one place to another”
“a transfer control unit adapted to transfer and store part of held digital contents in the internal storage device to a	’101 Patent, Claim 1	Subject to 112 p. 6 Structure: Software algorithm that performs the steps of: <ul style="list-style-type: none"> <li>• Selecting the digital contents</li> </ul>	Indefinite under 35 § 112(6).  Function: transfer and store part of held digital contents

Claim Term	Claims	ACT's Proposed Construction	Apple's Proposed Construction
<p>network storage device, wherein the network storage device is connected to the network and is capable of storing data, and wherein said transfer control unit does not transfer, from the internal storage device to the network storage device, the digital contents that cannot be recovered if a network failure occurs during the transferring of the digital contents from the internal storage device to the network storage device”</p>		<p>from the held digital contents in the internal storage device according to any criteria; and</p> <ul style="list-style-type: none"> <li>• Transferring part of the held digital contents from the internal storage device to the network storage device for any reason; as set forth in 6:57-7:12, and equivalents thereof.</li> </ul> <p>Function: transfer and store part of held digital contents in the internal storage device to a network storage device, and does not transfer, from the internal storage device to the network storage device, the digital contents that cannot be recovered if a network failure occurs during the transferring of the digital contents from the internal storage device to the network storage device</p>	<p>in the internal storage device to a network storage device, wherein the network storage device is connected to the network and is capable of storing data, and wherein said transfer control unit does not transfer, from the internal storage device to the network storage device, the digital contents that cannot be recovered if a network failure occurs during the transferring of the digital contents from the internal storage device to the network storage device</p> <p>Structure: Not disclosed</p>

Claim Term	Claims	ACT's Proposed Construction	Apple's Proposed Construction
<p>“a list information transmission unit adapted to respond to a list presentation request for the held digital contents of the server device for media from the network player by transmitting list information to the network player, wherein the list information lists the digital contents left in the internal storage device and the digital contents transferred from the internal storage device to the network storage device and stored in the network storage device, and wherein the list information maintains a tree structure of the digital contents in the internal storage device before transferring the digital contents to</p>	<p>'101 Patent, Claim 1</p>	<p>Subject to 112 p. 6                      Structure: Software algorithm, program, or routine that performs the steps of:</p> <ul style="list-style-type: none"> <li>• Receive a list presentation request;</li> <li>• Transmitting list information to the network player in response to the list presentation request;</li> <li>• If the network storage device is not connected to the network, making the list information for the network player include predetermined information for allowing the network player to perform a process for expressing the non-connection</li> </ul>	<p>Indefinite under 35 § 112(6).                       Function:                      respond to a list presentation request for the held digital contents of the server device for media from the network player by transmitting list information to the network player, wherein the list information lists the digital contents left in the internal storage device and the digital contents transferred from the internal storage device to the network storage device and stored in the network storage device, and wherein the list information maintains a tree structure of the</p>

Claim Term	Claims	ACT's Proposed Construction	Apple's Proposed Construction
the network storage device”		<p>on its display list; and</p> <ul style="list-style-type: none"> <li>Excluding the digital contents that cannot be played in response to an instruction to play issued from the network player from the list information to be transmitted from the server device for media to the network player so that the digital contents are not shown on the display list of the network player; as set forth in 8:25-9:25, and equivalents thereof</li> </ul> <p>Function: respond to a list presentation request for the held digital contents of the server device for media from the network</p>	<p>digital contents in the internal storage device before transferring the digital contents to the network storage device</p> <p>Structure: Not disclosed</p>

Claim Term	Claims	ACT's Proposed Construction	Apple's Proposed Construction
		player by transmitting list information to the network player	
<p>“said list information transmission unit makes the list information to be transmitted to the network player include information for identifying whether each digital content is currently stored in the internal storage device or the network storage device in the display list of the network player”</p>	<p>'101 Patent Claim 5</p>	<p>Subject to 112 p. 6                      Structure: Software algorithm, program, or routine that performs the steps of:</p> <ul style="list-style-type: none"> <li>• Receive a list presentation request;</li> <li>• Transmitting list information to the network player in response to the list presentation request;</li> <li>• if the network storage device is not connected to the network, making the list information for the network player include predetermined information for allowing the network player to perform a process for expressing the</li> </ul>	<p>Governed by 35 U.S.C. § 112, ¶ 6</p> <p>This term provides additive functionality to the functionality required by the term “a list information transmission unit adapted to respond to a list presentation request for the held digital contents of the server device for media from the network player by transmitting list information to the network player, wherein the list information lists the digital contents left in the internal storage device and the digital contents transferred from</p>

Claim Term	Claims	ACT's Proposed Construction	Apple's Proposed Construction
		<p>non-connection on its display list; and</p> <ul style="list-style-type: none"> <li>excluding the digital contents that cannot be played in response to an instruction to play issued from the network player from the list information to be transmitted from the server device for media to the network player so that the digital contents are not shown on the display list of the network player; as set forth in 8:25-9:25, and equivalents thereof</li> </ul> <p>Function: makes the list information to be transmitted to the network player include information for identifying whether each digital content is currently stored in the internal storage device</p>	<p>the internal storage device to the network storage device and stored in the network storage device, and wherein the list information maintains a tree structure of the digital contents in the internal storage device before transferring the digital contents to the network storage device” in claim 1. The corresponding structure for the additive functionality in claim 5 is not sufficient to perform the functionality from claim 1 and at most can perform the additional functionality added by claim 5. Therefore, claim 5 is</p>

Claim Term	Claims	ACT's Proposed Construction	Apple's Proposed Construction
		<p>or the network storage device in the display list of the network player</p>	<p>indefinite.</p> <p>Function: makes the list information to be transmitted to the network player include information for identifying whether each digital content is currently stored in the internal storage device or the network storage device in the display list of the network player</p> <p>Structure (if not indefinite based on lack of corresponding structure for claim 1 function): shows whether the digital contents is stored in the network storage device or internal storage device using a proper flag, different</p>

Claim Term	Claims	ACT's Proposed Construction	Apple's Proposed Construction
			colors, lighter colors, an asterisk, or an extension tag as set forth in the '101 patent at 8:35-42 and 9:4-25, and equivalents thereof
“a search unit adapted to respond to a data transmission request for the held digital contents from the network player by searching for a location where the held digital contents are currently stored”	'101 Patent, Claim 1	Subject to 112 p. 6 Structure: Software algorithm, program, or routine that performs the steps of: <ul style="list-style-type: none"> <li>• receiving a data transmission request for held digital contents from the network player;</li> <li>• responding to a data transmission request by searching for the location of requested digital contents; and</li> <li>• transmitting the result of the search to the contents data transmission processing</li> </ul>	Indefinite under 35 § 112(6).  Function: respond to a data transmission request for the held digital contents from the network player by searching for a location where the held digital contents are currently stored  Structure: Not disclosed

Claim Term	Claims	ACT's Proposed Construction	Apple's Proposed Construction
		<p>means if the result of the search shows the network storage device; as set forth in 6:41-48, and equivalents thereof</p> <p>Function: respond to a data transmission request for the held digital contents from the network player by searching for a location where the held digital contents are currently stored</p>	
<p>“a digital contents data transmission processing unit adapted to allow the corresponding data in held digital contents to be stream-delivered from the network storage device to the network player, if the result of search shows the network storage device”</p>	<p>'101 Patent, Claim 1</p>	<p>Subject to 112 p. 6</p> <p>Structure: Software algorithm, program, or routine that performs the steps of:</p> <ul style="list-style-type: none"> <li>• determining where digital contents are held;</li> <li>• determining whether digital contents should be transmitted from the network storage device to the network player</li> </ul>	<p>Indefinite under 35 § 112(6).</p> <p>Function: allow the corresponding data in held digital contents to be stream-delivered from the network storage device to the network player, if the result of search shows the network storage device</p>

Claim Term	Claims	ACT's Proposed Construction	Apple's Proposed Construction
		<p>directly or indirectly; and</p> <ul style="list-style-type: none"> <li>transmitting digital contents to the network player according to the determination of direct or indirect transmission; as set forth in 7:24-65, and equivalents thereof</li> </ul> <p>Function: allow the corresponding data in held digital contents to be stream-delivered from the network storage device to the network player, if the result of search shows the network storage device</p>	<p>Structure: Not disclosed</p>
<p>“said digital contents data transmission processing unit causes the network storage device to transmit the corresponding data to the server device for media, and then transmits the corresponding</p>	<p>'101 Patent, Claim 2</p>	<p>Subject to 112 p. 6</p> <p>Structure: Software algorithm, program, or routine that performs the steps of:</p> <ul style="list-style-type: none"> <li>determining where digital contents are held;</li> </ul>	<p>Indefinite under 35 § 112(6).</p> <p>Function: causes the network storage device to transmit the corresponding data to the server device for media, and then transmits the</p>

Claim Term	Claims	ACT's Proposed Construction	Apple's Proposed Construction
<p>data received from the network storage device from the server device for media to the network player”</p>		<ul style="list-style-type: none"> <li>• determining whether digital contents should be transmitted from the network storage device to the network player directly or indirectly; and</li> <li>• transmitting digital contents to the network player according to the determination of direct or indirect transmission, as set forth in 7:24-65, and equivalents thereof.</li> </ul> <p>Function: allow the corresponding data in held digital contents to be stream-delivered from the network storage device to the network player, if the result of search shows the network storage device; and causes the network storage device to transmit the corresponding data to the server device for</p>	<p>corresponding data received from the network storage device from the server device for media to the network player</p> <p>Structure: Not disclosed</p>

Claim Term	Claims	ACT's Proposed Construction	Apple's Proposed Construction
		media, and then transmits the corresponding data received from the network storage device from the server device for media to the network player	
“said digital contents data transmission processing unit transmits the corresponding data and information for identifying the network storage device to the network player, and causes the network storage device to directly transmit the corresponding data to the network player.”	'101 Patent, Claim 3	Subject to 112 p. 6 Structure: Software algorithm, program, or routine that performs the steps of: <ul style="list-style-type: none"> <li>• determining where digital contents are held;</li> <li>• determining whether digital contents should be transmitted from the network storage device to the network player directly or indirectly; and</li> <li>• transmitting digital contents to the network player according to the determination of direct or indirect</li> </ul>	Indefinite under 35 § 112(6).  Function: transmits the corresponding data and information for identifying the network storage device to the network player, and causes the network storage device to directly transmit the corresponding data to the network player  Structure: Not disclosed

Claim Term	Claims	ACT's Proposed Construction	Apple's Proposed Construction
		<p>transmission, as set forth in 7:24-65, and equivalents thereof</p> <p>Function: allow the corresponding data in held digital contents to be stream-delivered from the network storage device to the network player, if the result of search shows the network storage device; transmits the corresponding data and information for identifying the network storage device to the network player, and causes the network storage device to directly transmit the corresponding data to the network player</p>	
<p>“a return control unit adapted to cause the digital contents corresponding to a predetermined condition among the digital contents which have been transferred to the</p>	<p>'101 Patent, Claim 4</p>	<p>Subject to 112 p. 6</p> <p>Structure: Software algorithm, program, or routine that performs the steps of:</p> <ul style="list-style-type: none"> <li>(i) determining a predetermined condition whether digital</li> </ul>	<p>Indefinite under 35 § 112(6).</p> <p>Function: cause the digital contents corresponding to a predetermined condition among the digital</p>

Claim Term	Claims	ACT's Proposed Construction	Apple's Proposed Construction
<p>network storage device to be returned from the network storage device to the internal storage device”</p>		<p>contents have recently been subjected to self-playback among the digital contents which have been transferred to the network storage device; or (ii) determining a predetermined condition whether the digital contents have recently been played, whether by self-playback or network-playback; and</p> <ul style="list-style-type: none"> <li>• returning digital contents from the network storage device to the internal storage device based on the determined predetermined condition; as set forth in 7:66-8:24, and equivalents thereof</li> </ul>	<p>contents which have been transferred to the network storage device to be returned from the network storage device to the internal storage device</p> <p>Structure: Not disclosed</p>

Claim Term	Claims	ACT's Proposed Construction	Apple's Proposed Construction
		Function: cause the digital contents corresponding to a predetermined condition among the digital contents which have been transferred to the network storage device to be returned from the network storage device to the internal storage device	

Ex. 2004, at 5-14. The Petition's analysis of the claim limitations containing these terms against the cited references does not indicate that those references disclose the aforementioned claim terms under Petitioner's proposed constructions in the District Court Litigation.

If Petitioner believed that any claim terms required construction or that any of the claim terms were indefinite, it had a duty to identify “[h]ow the challenged claim is to be construed” in its Petition. 37 C.F.R. § 42.104(3); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide, November 2019, at 48 (“The Board, in its claim construction determinations, will consider statements regarding claim construction made by patent owners and by a petitioner filed in other proceedings, if the statements are timely made of record.”) (citations omitted). Instead, Petitioner chose to apply the plain and ordinary meaning in this proceeding,

while agreeing to construe multiple terms under §112(6) in the District Court Litigation. Therefore, the parties' understanding of the aforementioned terms under §112(6) in the District Court Litigation should be applied in this proceeding.

For the purposes of this Preliminary Response, Patent Owner notes that since both Patent Owner and Petitioner agreed to constructions of the above terms under §112(6) in the District Court Litigation, it is highly likely that the District Court will enter constructions under §112(6). Patent Trial and Appeal Board Consolidated Trial Practice Guide, at 47 (citations omitted) (“Parties should submit a prior claim construction determination by a federal court or the ITC in an AIA proceeding as soon as that determination becomes available. Preferably, the prior claim construction determination should be submitted with the petition, preliminary response, or response, along with explanations. Submission of a prior claim construction determination is mandatory under 37 C.F.R. § 42.51(b), if it is ‘relevant information that is inconsistent with a position advanced by the party during the proceeding.’”).

#### **IV. LEVEL OF ORDINARY SKILL IN THE ART**

For the purposes of this Preliminary Response only, Patent Owner utilizes Petitioner's proposed level of skill in the art: “a bachelor's degree in computer engineering or a comparable field and about 2-3 years of professional experience working with networking and data storage architectures. Additional years of

experience could substitute for an advanced-level degree (and vice versa).” Pet. at 5 (citations omitted).

**V. PETITIONER HAS NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF SUCCESS FOR THE GROUNDS ADVANCED IN THE PETITION, AND THE PETITION SHOULD BE DENIED**

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) so-called secondary considerations where in evidence. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983).

The Board has held that a failure to identify the differences between the claimed subject matter and the prior art is fatal to an obviousness challenge. *See, Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00355, Decision Denying Institution of *Inter Partes* Review, Paper 9 at 9-10 (P.T.A.B. June 26, 2015) (denying institution for failure to identify the differences between the claimed subject matter and the prior art).

In arriving at an obviousness determination, the Board must sufficiently explain and support the conclusions that the prior art references disclose all the elements recited in the Challenged Claims and a relevant, skilled artisan not only could have made, but would have been motivated to combine all the prior art references in the way the patent claims and reasonably expected success. *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017). That is, even if all the claim elements are found across a number of references, an obviousness determination must consider whether a person of ordinary skill in the art would have the motivation to combine those references. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *Los Angeles Biomedical Resch. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.*, 849 F.3d 1049, 1067 (Fed. Cir. 2017) (vacating and remanding an obviousness determination, in part, because the Board did not make factual finding as to whether there was an apparent reason to combine all three prior art references to achieve the claimed invention and whether a person of skill in the art would have had a reasonable expectation of success from such a combination). This combinability determination, as supported by an articulated motivation to combine, requires a plausible rationale as to why those prior art references would have worked together. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013). Absent some articulated rationale, a “common sense” finding is no different than the conclusory statement “would have been

obvious.” *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017). Of additional importance, “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references . . . .” *Innogenetics, N.V. v. Abbott Lab’ys.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008).

**A. Claims 1, 6, 7, and 12 Are Not Obvious Over Any Combination of Lamkin, Fiechter, and Ito or Any Combination of Franke, Fiechter, and Ito<sup>1</sup>**

**1. The Petition Does Not Show that Any Combination of Lamkin, Fiechter, and Ito or Franke, Fiechter, and Ito Discloses “*wherein the list information lists the digital contents left in the internal storage device and the digital contents transferred from the internal storage device to the network storage device and stored in the network storage device,*” as Required by Claims [1c-ii], [6c-ii], [7c], and [12c]**

Claims 1, 6, 7, and 12 of the ’101 Patent requires “wherein the list information lists the digital contents left in the internal storage device and the digital contents transferred from the internal storage device to the network storage device and stored in the network storage device.”

First, Petitioner’s Grounds 1A, 1B, and 1C rely on Lamkin’s “CDS list” to disclose the claimed “list information” which purportedly includes “an aggregated content view that allows users to find content independent of the device.” Pet. at 22

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<sup>1</sup> Petitioner only relies on Fiechter with respect to Claims [1b-iii], [6b-iii], [7b] and [12b]. Pet. at 42, 83. Petitioner only relies on Ito with respect to Claim [1b-iii] and [7b]. *Id.* at 49, 89.

(citing APPLE-1004, [0303]). However, the Petition is deficient because the following sentence of the same cited paragraph of Lamkin describes that, with Lamkin’s aggregated content view, “the user does not need to know which device contains the content, but simply what content they are looking for.” APPLE-1004, [0303]. Setting aside that Lamkin’s aggregated content view does not indicate which device (e.g., internal storage device or network storage device) contains the content, the Petition plainly ignores that the list information contains two specific types of information: (i) “digital contents left in the internal storage device” (after transfer); and (ii) “digital contents transferred from the internal storage device to the network storage device and stored in the network storage device.” At best, Lamkin’s aggregated content view would indicate all content on a network storage device (regardless of what has been transferred) rather than specifically the “digital contents transferred from the internal storage device to the network storage device,” as claimed.

Moreover, Petitioner’s reliance on Lamkin’s CDS list are inapposite because they relate to a user’s determination regarding contents to transfer rather than a post-transfer determination of where contents are stored. For example, Petitioner’s citations (Pet. at 22-23) explicitly describe “determin[ing] whether the content is *to be transferred to* or can be utilized by other devices on the network . . . CDS or other tracking is updated identifying the new content, whether the new content is

centralized and/or where the content is stored and/or centralized,” rather than where content *has been transferred* across all devices. APPLE-1004, [0077] (emphasis added).

Second, Petitioner’s Grounds 2A, 2B, and 2C rely on Franke’s “assigned projects” to disclose the claimed “list information” which purportedly includes “information about whether the project is completely transferred to the central server or is downloadable from the proxy server.” Pet. at 66-67 (citing APPLE-1005, [0042], [0048]-[0049], [0053], [0070], [0112]-[0113], FIG. 11). However, Petitioner’s citations do not support the Petition’s conclusory statement because the citations do not relate to “list information” with two specific types of information: (i) “digital contents left in the internal storage device” (after transfer); and (ii) “digital contents transferred from the internal storage device to the network storage device and stored in the network storage device.” APPLE-1005, [0042] (describing that “LAN users 130-140 can copy project data being stored on central server 110 from local proxy server 150”), [0048]-[0049] (describing that “Proxy server application 175 can determine the location of data files being stored in local storage [and that ] Proxy server application 175 can also maintain a connection or session with central server 110 for LAN users 130-140.”), [0070] (describing that an API may determine whether posted media data is stored on a local proxy server and access it, or, if not stored on a local proxy server, the API may download it from the

central server), [0112]-[0113], FIG 11 (describing a UI interface “allowing a user to configure settings for posting or downloading media data.”). In fact, for one cited portion of Franke, Petitioner admits that project data requests are made of a local proxy server (which Petitioner argues is the claimed internal storage device) without any list information, and if the local server does not contain the requested project data, the local proxy server can request it from the central server (which Petitioner argues is the claimed network storage device), without any determination of whether such data was transferred from the local proxy server (i.e., without specifically including a fulsome list of transferred digital content from internal to network storage device as well as all content on the internal storage device). Pet. at 67 (citing APPLE-1005, [0053]). Whether a user may access project data from a local proxy server or indirectly from a central server through the local proxy server has no bearing on whether there is list information, let alone the claimed list information comprising (i) “digital contents left in the internal storage device” (after transfer); and (ii) “digital contents transferred from the internal storage device to the network storage device and stored in the network storage device.”

Because of these deficiencies, institution should be denied.

**2. The Petition Does Not Show that Any Combination of Lamkin, Fiechter, and Ito or Franke, Fiechter, and Ito Discloses “and wherein the list information maintains a tree structure of the digital contents in the internal storage device before transferring the digital contents to the network storage device,” as Required by Claim Elements [1c-iii], [6c-iii], [7c], and [12c]**

Claims 1, 6, 7, and 12 of the '101 Patent require “and wherein the list information maintains a tree structure of the digital contents in the internal storage device before transferring the digital contents to the network storage device.”

First, Petitioner’s Grounds 1A, 1B, and 1C rely on “Lamkin’s CDS with hierarchical directory” (Pet. at 23-25) as disclosing the claimed “list information maintain[ing] a tree structure of the digital contents.” Specifically, Petitioner notes that Lamkin’s CDS may “utilize[e] the date of the files **to form a tree structure** based on year, month, date.” Pet. at 23 (citing APPLE-1004, [0264]). However, the Petition is deficient because it fails to address any remaining limitations. For example, the Petition is silent regarding whether (i) whether the tree structure is of the digital contents specifically *in the internal storage device*; and (ii) whether the tree structure is of the digital contents *before transferring the digital contents to the network storage device*. See Pet. at 23-25. Petitioner merely points to two broad citations, both of which are irrelevant to the aforementioned limitations. Pet. at 25. APPLE-1004, [0077] does not relate to a tree structure of digital contents before those same digital contents are transferred to a network storage device but only that

Lamkin’s CDS “can include other data, such as metadata and other relevant data that identify the content and/or allow users to more easily locate and access the content.” Similarly, APPLE-1004, [0128]<sup>2</sup> describes an aggregated content view but any such content is “independent of the device” such that “[t]he user does not need to know which device contains the content” instead of a tree structure listing digital content currently on the internal storage device to be transferred to the network storage device.

Second, Petitioner’s Grounds 2A, 2B, and 2C are also deficient. Notably, Franke does not even mention the word “tree.” Even assuming that Franke’s “exemplary folder hierarchy” is a “tree structure” as Petitioner asserts, the Petition is silent regarding a tree structure of digital contents “in the internal storage device before transferring the digital contents to the network storage device.” The Petition actually admits that, at best, Franke’s folder hierarchy is organized “when media is posted to the server to be displayed to the user *regardless of where the media is located in the system,*” instead of the claimed “digital contents *in the internal storage device.*” Similarly, that such media is posted to be displayed to the user independent of where the media is stored has no relevance as to whether the digital contents in the tree structure pertains to content “before transferring” “to the network

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<sup>2</sup> Petitioner mistakenly cites to APPLE-1004, [0124] but its cited quote is not from [0124] but rather [0128]. Pet. at 25.

storage device,” as the claim recites.

Because of these deficiencies, institution should be denied.

**B. Claims 2-5 and 8-11 Are Not Obvious Over Any Combination of Lamkin, Fiechter, and Ito or Franke, Fiechter, and Ito**

Claims 2-5 depend upon Claim 1, and for at least the same reasons as Claim 1, Petitioner’s Grounds fail to render obvious Claim 2-5. ’101 Patent, Claims 2-5.

Claims 8-11 depend upon Claim 6, and for at least the same reasons as Claim 6, Petitioner’s Grounds fail to render obvious Claim 8-11. ’101 Patent, Claims 8-11.

**VI. CONCLUSION**

For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition in its entirety.

Respectfully submitted,

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**CERTIFICATE OF WORD COUNT**

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE specified in 37 C.F.R. § 42.24 has 5,928 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

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