

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

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

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2025-01277

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Exhibit No.	Description of Document
2001	Google LLC'S Second Amended Invalidity and Subject Matter Eligibility Contentions in <i>Advanced Coding Techs. LLC v. Google LLC</i> , Case No. 2:24-cv-00353-JRG (E.D. Tex.), dated April 11, 2025
2002	Advanced Coding Technologies LLC's Fourth Amended Disclosure of Asserted Claims and Infringement Contentions in <i>Advanced Coding Techs. LLC v. Google LLC</i> , Case No. 2:24-cv-00353-JRG (E.D. Tex.), dated December 20, 2024
2003	Advanced Coding Technologies LLC's Disclosure of Asserted Claims and Infringement Contentions in <i>Advanced Coding Techs. LLC v. Google LLC</i> , Case No. 2:24-cv-00353-JRG (E.D. Tex.), dated July 5, 2024
2004	Claim Construction Memorandum and Order, Dkt. 86, <i>Advanced Coding Techs. LLC v. Google LLC</i> , Case No. 2:24-cv-00353-JRG (E.D. Tex.), dated Oct. 10, 2025

I. INTRODUCTION

On July 11, 2025, Google LLC (“Petitioner” or “Google”) submitted a Petition (Paper 2, “Petition” or “Pet.”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 8,230,101 (Ex. 1001, the “101 Patent”), challenging Claims 1-12 (the “Challenged Claims”). The Petition asserts that (i) Claims 1-3, 5, and 7 are rendered obvious over WO 2001/076192 to Sloss et al. (“Ex. 1004” or Sloss”) and U.S. Patent Application Publication No. 2006/0161635 to Lamkin et al. (“Ex. 1005” or “Lamkin”); (ii) Claim 4 is rendered obvious over Sloss, Lamkin, and *Online File Storage System*, 2002 Student Conference on Research and Development Proceedings, Rou, et al. (“Ex. 1015” or “Rou”); (iii) Claims 6, 8, 9, 11, and 12 are rendered obvious over Sloss, Lamkin, and U.S. Patent Application Publication No. 2002/0026563 to Chamberlain et al. (“Ex. 1010” or “Chamberlain”); (iv) Claim 10 is rendered obvious over Sloss, Lamkin, Chamberlain, and Rou; (v) Claims 1-4 and 7 are rendered obvious over US Patent Application Publication No. 2006/0101489 to Roden et al. (“Ex. 1006” or “Roden”), U.S. Patent No. 7,895,633 to Van Hoff et al. (“Ex. 1007” or “Van Hoff”), WO 2006/073040 to Ito et al. (certified translation) (“Ex. 1008” or “Ito”), and “TiVo for Dummies,” Andy Rathbone, Wiley Publishing, Inc. (2004) (“Ex. 1009” or “Rathbone”); (vi) Claim 5 is rendered obvious over Roden, Van Hoff, Ito, Rathbone, and Lamkin; (vii) Claims 6, 8-10, and 12 are rendered obvious over Roden, Van Hoff, Ito, Rathbone, and U.S. Patent No.

5,835,698 to Harris et al. (“Ex. 1011” or “Harris”); and (viii) Claim 11 is rendered obvious over Roden, Van Hoff, Ito, and Rathbone, Harris, and Lamkin. Pet. at 1. The Board should deny the Petition for at least the reasons described briefly below.

Petitioner fails to show that each of the Petition’s Grounds discloses at least “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 the network storage device.”

First, the Petition plainly ignores that the claimed list information of Claims 1, 6, 7, and 12 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.” As a result, the Petition is silent regarding these claim limitations.

Second, the Petition is silent regarding (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*, as required by Claims 1, 6, 7, and 12. Petitioner’s broad citations to either Lamkin, Roden, or Rathbone in each of its Grounds do not relate to a tree structure of digital contents *before* those same digital contents are

transferred from an internal storage device to a network storage device.

Because the Petition plainly ignores language in the claim limitations above, the Petition is deficient on its face. The Board should deny institution of the Petition.

II. CLAIM CONSTRUCTION

For the purposes of this Preliminary Response only, Patent Owner believes that “all terms should be given their ordinary and customary meaning.” Pet. at 5. However, Patent Owner notes that the Court in *Advanced Coding Techs. LLC v. Google LLC*, Case No. 2:24-cv-00353-JRG (E.D. Tex.) (the “District Court Litigation”) has already construed the following terms. 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.’”).

Claim Term	Claims	Court’s Construction
“transfer” / “transferring”	’101 Patent, Claims 1, 4, 7	“move” / “moving”

Claim Term	Claims	Court's Construction
<p>“a transfer control unit ...”</p>	<p>'101 Patent, Claim 1</p>	<p>Governed by 35 U.S.C. § 112, ¶ 6</p> <p>Function: “transfer and store part of held digital contents in the internal storage device to a network storage device”</p> <p>Structure: “transfer control means 41; and equivalents thereof”</p>
<p>“list information transmission unit ...”</p>	<p>'101 Patent, Claims 1,5</p>	<p>Governed by 35 U.S.C. § 112, ¶ 6</p> <p>Function: (Claim 1) “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 the network storage device”</p> <p>(Claim 5) “makes the list information to be transmitted to the network player include information for identifying</p>

Claim Term	Claims	Court's Construction
		<p>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: None (indefinite)</p>
<p>“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”</p>	<p>’101 Patent, Claim 1</p>	<p>Governed by 35 U.S.C. § 112, ¶ 6</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>Structure: “search means 43; and equivalents thereof”</p>
<p>“digital contents data transmission processing unit...”</p>	<p>’101 Patent, Claims 1-3</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[, and causes the network storage device to transmit the corresponding data to the server device for media, and then transmits the corresponding data received from the network storage device from the server device for</p>

Claim Term	Claims	Court's Construction
		<p>media to the network player] / [, and 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>Structure: “a processor configured to perform the algorithm set forth in the '101 Patent at 7:24–65; and equivalents thereof”</p>
<p>“a return control unit ...”</p>	<p>'101 Patent, Claim 4</p>	<p>Governed by 35 U.S.C. § 112, ¶ 6</p> <p>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”</p> <p>Structure: “a processor configured to perform the algorithm set forth in the '101 Patent at 7:66–8:24; and equivalents thereof”</p>

Ex. 2004, at 28-57.

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 the Court's ultimate construction.

III. 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 electrical engineering, computer engineering, computer science, or equivalent training, and approximately two years of experience working in the field of media device networking." Pet. at 5 (citations omitted).

IV. 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 Rsch. 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 Sloss, Lamkin, and Chamberlain¹

- 1. The Petition Does Not Show that Any Combination of Sloss, Lamkin, and Chamberlain 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 [1.3.2], [6.3.2], [7.3.2], and [12.3.2]**

Claims 1, 6, 7, and 12 of the ’101 Patent require “wherein the list information

¹ Petitioner only relies on Chamberlain with respect to Claims [6.2.3] and [12.2.3].

Pet. at 46, 47.

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.”

Petitioner’s Grounds 1-4 rely on FIG. 5 of Lamkin to disclose the claimed “list information,” including the “source/client device” where content was distributed from and where the content was “distributed to.” Pet. at 29-30. However, 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 list information indicates all content on every 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. In failing to consider the full scope of the claim limitation, the Petition is deficient on its face.

Because of these deficiencies, institution should be denied.

2. **The Petition Does Not Show that Any Combination of Sloss, Lamkin, and Chamberlain Discloses “*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 Claims [1.3.3], [6.3.3], [7.3.3], and [12.3.3]**

Claims 1, 6, 7, and 12 of the ’101 Patent require “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.”

Petitioner’s Grounds 1-4 rely on FIG. 6 of Lamkin to disclose “a tree structure of [] digital contents.” Pet. at 30-32. Specifically, Petitioner notes that “Lamkin’s ‘media in-box user interface depicting a simplified example which identifies content and presents ‘the content according to an **organized structure, similar to a file structure.**’ The file structure appears as a hierarchical tree.” Pet. at 30 (citing Ex. 1005, ¶ 95). However, even taking this as true, the Petition is deficient because it fails to address any remaining limitations. For example, the Petition is silent regarding (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 30-32. Petitioner merely addresses the existence of tree structures in the prior art:

Lamkin’s Figure 6 tree structure would have been recognized as common to many file systems. For example, a POSITA would have recognized that both Windows and Unix-based operating systems stored files in a hierarchical file system, in which directories/folders and files were represented by a tree structure. Confirmed by Lamkin’s presentation of such a file system (e.g., a Windows file system), therefore, a POSITA would have recognized that Lamkin’s devices would have “maintain[ed] a tree structure of the digital contents in the internal storage device” present at all times, including “before transferring the digital contents to the network storage device” as recited. Ex.1003, ¶¶102-104; see also Ex.1005, ¶264 (teaching a tree structure).

Pet. at 31-32 (citing Ex. 1005, ¶ 264).

It does not logically follow that because “Lamkin[] present[s] such a file system (e.g., a Windows file system),” “a POSITA would have recognized that Lamkin’s devices would have ‘*maintain[ed] a tree structure . . .*’” present at all times, including ‘before transferring’” Petitioner’s expert, cited in the portion of the Petition, does nothing more than parrot the same statement without any clarification or explanation:

103. The tree structure depicted in Figure 6 would have been recognized by a POSITA as common to many file systems at the time of the '101 patent. For example, a POSITA would have recognized that both Windows and Unix-based operating systems stored files in a hierarchical file system, in which directories/folders and files were represented by a tree structure, tracing all the way back to the first instance in the 1960s. *See* Ex.1018 (File Structures), p. 22 (“The UNIX filesystem is a tree-structured organization...”); Ex.1017 [Microsoft Computer Dictionary], pp. 457 (“root directory *n.* The point of entry into the directory tree in a disk-based hierarchical directory structure.”), 529 (“tree view *n.* A hierarchical representation of the folders, files, disk drives, and other resources connected to a computer or network. For example, Windows Explorer uses a tree view to display the resources that are attached to a computer or a network.”). Confirmed by Lamkin’s presentation of such a tree-structured file system (e.g., a Windows file system), therefore, a POSITA would have recognized that Lamkin’s devices would have “*maintain[ed] a tree structure of the digital contents in the internal storage device*” at all times, including “*before transferring the digital contents to the network storage device*” as recited. *See also* Ex.1005 [Lamkin], ¶¶264, 296-297 (teaching a tree structure).

Ex. 1003, ¶ 103.

Moreover, Petitioner’s statement ignores the claim limitation in context. The transfer of digital contents from internal to network storage device has taken place

in Claims [1.2.1]-[1.2.3], [6.2.1]-[6.2.3], [7.2.1]-[7.2.3], and [12.2.1]-[12.2.3] (“transfer[ring] and stor[e]/[ing] part of held digital contents in the internal storage device to a network storage device”). In this claim limitation, the ’101 Patent claims recite “list information [that] maintains a tree structure of the digital contents in the internal storage device before [they were] transferr[ed] to the network storage device.” In other words, under the plain language of the claim, there is no temporal limitation on the tree structure or on all of the digital contents currently stored in the internal storage device, as the Petition improperly suggests, but rather on digital contents that *were* once stored on the internal storage device (*i.e.*, the digital contents that were stored in the internal storage device before they were transferred should be maintained in a tree structure as part of the list information.).²

Moreover, neither the Petition nor Petitioner’s expert declaration addresses the location of the list information maintained as a tree structure as per the claim limitation (*i.e.*, internal storage device vs. network storage device). Therefore, the

² This is particularly important because the Court in the District Court Litigation construed “transfer” as “move,” precluding “copying.” Because the digital contents are not copied, they are no longer stored in the internal storage device after transfer. The claim limitation requires listing those digital contents that were transferred from the internal storage any way despite not being in the internal storage anymore.

Petition fails to address the full claim limitation and is deficient on its face.

Because of these deficiencies, institution should be denied.

B. Claims 1, 6, 7, and 12 Are Not Obvious Over Any Combination of Roden, Van Hoff, Ito, Rathbone, and Harris³

- 1. The Petition Does Not Show that Any Combination of Roden, Van Hoff, Ito, Rathbone, and Harris 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 [1.3.2], [6.3.2], [7.3.2], and [12.3.2]**

Claims 1, 6, 7, and 12 of the ’101 Patent require “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.”

Petitioner’s Grounds 5-8 rely on Roden’s “user interface [that] may present a list of all content in the user’s library on a display screen of the content device” to disclose the claimed “list information.” Pet. at 62 (citing Ex. 1006, ¶ 22). However, 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);

³ Petitioner only relies on Harris with respect to Claims [6.2.3] and [12.2.3]. Pet. at 77, 78.

and (ii) “digital contents transferred from the internal storage device to the network storage device and stored in the network storage device.” At best, Roden’s user interface 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. Petitioner’s cited portion of Roden is completely agnostic as to any transfer. As such, the Petition fails to address the entire claim limitation and is deficient on its face.

Because of these deficiencies, institution should be denied.

2. The Petition Does Not Show that Any Combination of Roden, Van Hoff, Ito, Rathbone, and Harris 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 Claims [1.3.3], [6.3.3], [7.3.3], and [12.3.3]

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.”

Petitioner’s Grounds 5-8 rely on both Roden and Rathbone to disclose this claim limitation. As a preliminary matter, Petitioner admits that Roden does not disclose “a tree structure.” Pet. at 62. Petitioner then relies on Rathbone to disclose “a tree structure” and Petitioner’s expert relies on additional evidence for purportedly showing that “a tree structure” “would have been obvious.” Pet. at 63-

64 (citing Ex. 1003, ¶¶ 214-215).

However, it does not logically follow that the Roden-Rathbone combination discloses this claim limitation, even if “Roden’s listing includes ‘*the digital contents in the internal storage device,*’ whether ‘*before transferring the digital contents to the network storage device*’ or after.” Pet. at 64, n.6. Petitioner ignores the claim limitation in context. The transfer of digital contents from internal to network storage device has taken place in Claims [1.2.1]-[1.2.3], [6.2.1]-[6.2.3], [7.2.1]-[7.2.3], and [12.2.1]-[12.2.3] (“transfer[ring] and stor[e]/[ing] part of held digital contents in the internal storage device to a network storage device”). In this claim limitation, the ’101 Patent claims recite “list information [that] maintains a tree structure of the digital contents in the internal storage device before [they were] transferr[ed] to the network storage device.” In other words, under the plain language of the claim, there is no temporal limitation on the tree structure or on all of the digital contents currently stored in the internal storage device, as the Petition improperly suggests, but rather on digital contents that *were* once stored on the internal storage device (*i.e.*, the digital contents that were stored in the internal storage device before they were transferred should be maintained in a tree structure as part of the list information.).⁴

⁴ This is particularly important because the Court in the District Court Litigation

Moreover, neither the Petition nor Petitioner's expert declaration addresses the location of the list information maintained as a tree structure as per the claim limitation (*i.e.*, internal storage device vs. network storage device). Therefore, the Petition fails to address the full claim limitation and is deficient on its face.

Because of these deficiencies, institution should be denied.

C. Claims 2-5 and 8-11 Are Not Obvious Over Any of Petitioner's Grounds

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.

V. CONCLUSION

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

construed "transfer" as "move," precluding "copying." Because the digital contents are not copied, they are no longer stored in the internal storage device after transfer. The claim limitation requires listing those digital contents that were transferred from the internal storage despite not being in the internal storage anymore.

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 3,424 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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CERTIFICATE OF SERVICE

A copy of the foregoing Patent Owner's Preliminary Response and Exhibit
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