

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CISCO SYSTEMS, INC.,  
Petitioner,

v.

CONSTELLATION TECHNOLOGIES LLC,  
Patent Owner.

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Case IPR2014-00914  
Patent 8,464,299 B1

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Before MICHAEL R. ZECHER, TREVOR M. JEFFERSON, and  
PETER P. CHEN, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

## I. INTRODUCTION

Petitioner, Cisco Systems, Inc. (“Cisco”), filed a corrected Petition (“Pet.”) requesting an *inter partes* review of claims 1–3, 6–15, and 18–22 of U.S. Patent No. 8,464,299 B1 (“the ’299 patent,” Ex. 1001). Paper 4. Patent Owner, Constellation Technologies LLC (“Constellation”), timely filed a Preliminary Response (“Prelim. Resp.”). Paper 9. We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides:

**THRESHOLD.**—The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Taking into account the arguments presented in Constellation’s Preliminary Response, we conclude that the information presented in the Petition does not establish that there is a reasonable likelihood that Cisco will prevail in challenging claims 1–3, 6–15, and 18–22 of the ’299 patent as unpatentable under 35 U.S.C. §§ 102(e) and 103(a). We, therefore, do not authorize an *inter partes* review to be instituted for the ’299 patent.

### A. *Related Matters*

The parties indicate that the ’299 patent was asserted in the following proceedings: (1) *ARRIS Group, Inc. v. Constellation Techs. LLC*, No. 1-14-cv-00114 (D. Del.); (2) *Charter Commc’ns., Inc. v. Rockstar Consortium US LP*, No. 1-14-cv-00055 (D. Del.); (3) *Constellation Techs. LLC v. Time*

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*Warner Cable Inc.*, No. 2-13-cv-01079 (E.D. Tex.); (4) *Bockstar Techs. LLC v. Cisco Systems, Inc.*, No. 1-13-cv-02020 (D. Del.); and (5) *In Re: Constellation Techs. LLC Patent Litig.*, MDL No. 2558, United States Judicial Panel On Multidistrict Litigation. Pet. 2–3; Paper 8, 2. In addition to this Petition, Cisco filed five other Petitions challenging the patentability of a certain subset of claims in the following patents owned by Constellation: (1) U.S. Patent No. 6,845,389 B1 (IPR2014-00871 and IPR2014-01085); (2) U.S. Patent No. 8,134,917 B2 (IPR2014-00911); (3) U.S. Patent No. 6,901,048 B1 (IPR2014-01179); and (4) U.S. Patent No. 7,154,879 B1 (IPR2014-01180).

#### *B. The '299 Patent*

The '299 patent generally relates to controlling delivery of television content to conserve network resources based on whether the television content is being viewed. Ex. 1001, 1:12–15. According to the '299 patent, a significant waste of network resources occurs when television content is delivered to a television that is not being viewed. *Id.* at 1:40–42. For instance, it is commonplace for subscribers to leave their televisions on for long periods of time “when no one is home or watching the television.” *Id.* at 1:42–44. Subscribers also tend to leave their set top boxes on even when the television is off. *Id.* at 1:44–45.

The '299 patent purportedly solves this problem by using a television gateway to monitor a viewer's interactions to determine whether television content is being viewed at the associated television or to detect whether the television is on or off. Ex. 1001, 1:67–2:4. Upon determining that the

viewer is not viewing the television content, various actions can be taken to conserve network resources. *Id.* at 2:4–6. These conservation actions include, for example, providing instructions to the content provider to halt delivery of all or a portion of the television content, or providing the television content at a reduced quality level so as to reduce the bandwidth required to transport the television content through the packet network. *Id.* at 2:7–11. When a conservation action is taken, an alert may be provided for display on the television before, during, or after initiating the action so as to alert the viewer of the action. *Id.* at 2:14–17.

*C. Illustrative Claim*

Of the challenged claims, claims 1 and 19 are independent claims. Claims 2, 3, 6–15, and 18 directly or indirectly depend from independent claim 1. Claims 20–22 directly depend from independent claim 19. Independent claim 1 is illustrative of the challenged claims and is reproduced below:

1. A method for conserving resources associated with packet television services comprising:
  - receiving television content from a content provider over a packet network;
  - providing the television content to a television monitor for display to a viewer;
  - determining if a resource conserving process should be activated, wherein the resource conserving process determines if an action to conserve resources associated with transporting the television content over the packet network should be performed;
  - if the resource conserving process should be activated:

determining whether the viewer is watching the television monitor; and  
initiating the action to conserve resources associated with transporting the television content over the packet network upon determining that the viewer is not watching the television monitor;  
if the resource conserving process should not be activated:  
continue providing the television content.

Ex. 1001, 8:9–30.

*D. Prior Art Relied Upon*

Cisco relies upon the following prior art references:

Minnick	US 2005/0157215 A1	July 21, 2005 (filed Sept. 13, 2004)	Ex. 1002
Riley	US 2005/0188415 A1	Aug. 25, 2005 (effectively filed Jan. 24, 2005) <sup>1</sup>	Ex. 1003
Harrell	US 2003/0067872 A1	Apr. 10, 2003	Ex. 1004

*E. Asserted Grounds of Unpatentability*

Cisco challenges claims 1–3, 6–15, and 18–22 of the '299 patent based on the asserted grounds of unpatentability set forth in the table below.  
Pet. 4, 21–60.

<b>Reference(s)</b>	<b>Basis</b>	<b>Challenged Claims</b>
Minnick	§ 102(e)	1–3, 6–9, 11, 15, and 19–22
Riley and Minnick	§ 103(a)	1–3, 6–11, 14, 15, and 18–22
Riley, Minnick, and Harrell	§ 103(a)	12 and 13

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<sup>1</sup> We provide a more detailed discussion of Riley's earliest effectively filing date below. *See infra* Section II (D)(1).

## II. ANALYSIS

### A. Claim Construction

In an *inter partes* review, we construe claims by applying the broadest reasonable interpretation in light of the specification. 37 C.F.R. § 42.100(b); *see* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Under the broadest reasonable interpretation standard, and absent any special definitions, claims terms are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

#### 1. “transporting the television content over the packet network” (Claims 1 and 19)

Cisco contends that the broadest reasonable interpretation of the claim phrase “transporting the television content over the packet network” is “conveying television content from one place to another over the packet network.” Pet. 12 (citing Declaration of Frank Koperda, Ex. 1008 ¶¶ 26–29). To support its proposed claim construction, Cisco argues that the specification of the ’299 patent does not define explicitly the aforementioned claim phrase. *Id.* at 11–12 (citing Ex. 1001, 2:10–11, 2:66–67, 7:66–8:3). Cisco then asserts that, at the time the ’299 patent was filed, the term “transport” was defined as “to convey from one place to another.” *Id.* (quoting WEBSTER’S II NEW COLLEGE DICTIONARY 1172 (1999)). Cisco implies that its proposed claim construction is consistent with the ordinary

and customary meaning of “transport” as would be understood by one with ordinary skill in the art in light of the ’299 patent. *Id.*

In response, Constellation divides the claim phrase “transporting the television content over the packet network” into two claim phrases—namely, “transporting . . . content over the packet network” and “television content”—and argues that a proper claim construction should be accorded to each claim phrase. Prelim. Resp. 4. Constellation argues that the claim phrase “transporting . . . content over the packet network” should be construed as “transferring content from one node to another on a packet network, and not merely within local equipment or a single node without consuming packet network resources.” *Id.* at 5. Constellation also argues that the claim phrase “television content” should be construed as “television programming such as movies or television shows, and not other types of data such as program guides, control messages or software.” *Id.* at 5–6. To support its proposed claim constructions, Constellation directs us to various disclosures in the specification of the ’299 patent. *Id.* at 6–10 (citing Ex. 1001, 1:48–55, 2:4–14, 2:61–3:3, 3:18–31, 4:60–65, 5:7–11, 5:33–36).

Upon reviewing the specification of the ’299 patent, we agree with Cisco that it does not define explicitly the claim phrase “transporting the television content over the packet network,” much less provide separate definitions for the claim phrases “transporting . . . content over the packet network” and “television content.” Because there is no special definition in the specification for the claim phrase “transporting the television content over the packet network,” we refer to its ordinary and customary meaning as

would be understood by one of ordinary skill in the art in the context of the entire disclosure. *Translogic*, 504 F.3d at 1257. We note, however, that if a feature is not necessary to give meaning to what the inventor means by a claim term, it would be “extraneous” and should not be read into the claim. *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998); *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir. 1988).

If we were to adopt Constellation’s approach and divide the claim phrase “transporting the television content over the packet network” into two claim phrases—namely, “transporting . . . content over the packet network” and “television content”—we are not persuaded that either construction offered by Constellation constitutes the broadest reasonable interpretation. With respect to the claim phrase “transporting . . . content over the packet network,” we decline to adopt Constellation’s claim construction as the broadest reasonable interpretation because it would import extraneous limitations into the claims. Constellation’s attempt to describe the claim phrase “transporting . . . content over the packet network” by what it does not encompass is not necessary to give meaning to this claim phrase, and should not be read into the claims that recite this feature.

With respect the claim phrase “television content,” Constellation’s overly narrow claim construction is unwarranted because the specification of the ’299 patent does not preclude a broader construction. Contrary to Constellation’s assertion (Prelim. Resp. 9–10), the specification does not differentiate clearly between movies or television shows on the one hand,

and program guide control messages or software on the other. *See, e.g.*, Ex. 1001, 3:18–31.

Instead, we agree with Cisco that its proposed claim construction for the claim phrase “transporting the television content over the packet network” constitutes the broadest reasonable interpretation. As Cisco implied in its Petition, its proposed claim construction is consistent with the ordinary and customary meaning of “transport” as would be understood by one with ordinary skill in the art in light of the specification of the ’299 patent. Pet. 12 (quoting a dictionary definition for “transport”). Therefore, for purposes of this decision, we adopt Cisco’s claim construction of the claim phrase “transporting the television content over the packet network” as “conveying television content from one place to another over the packet network.”

2. “*resource conserving process*” (Claims 1 and 19)

In its Petition, Cisco does not offer a construction for the claim phrase “resource conserving process.” In its Preliminary Response, Constellation contends that the claim phrase “resource conserving process” should be construed as “a process that determines whether to undertake an action to conserve resources.” Prelim. Resp. 12. To support its claim construction, Constellation refers to how this claim phrase is used in the context of independent claims 1 and 19, and directs us to two disclosures in the specification of the ’299 patent. *Id.* at 13 (citing Ex. 1001, 3:67–4:2, 4:20–23).

Upon reviewing the specification of the '299 patent, we do not find an explicit definition for the claim phrase “resource conserving process.” We, therefore, refer to its ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *Translogic*, 504 F.3d at 1257. For purposes of this decision, we adopt Constellation’s claim construction because it is consistent with its ordinary and customary meaning as would be understood by one with ordinary skill in the art in light of the specification of the '299 patent.

*B. Priority Date for the Challenged Claims of the '299 Patent*

The '299 patent issued from U.S. Patent Application No. 11/280,615 (“the '615 application”), filed on November 16, 2005. Ex. 1001, at [21], [22]. The '615 application claims the benefit of the following two provisional applications: (1) U.S. Provisional Application No. 60/628,577 (Ex. 1006, “the '577 provisional application”), filed on November 17, 2004; and (2) U.S. Provisional Application No. 60/628,625 (Ex. 1007, “the '625 provisional application), also filed on November 17, 2004. Ex. 1001 at [60].

Cisco contends that the '577 provisional application and the '625 provisional application do not provide sufficient written description support for the challenged claims of the '299 patent. Pet. 9–10. In particular, Cisco argues that neither the '577 provisional application nor the '625 provisional application disclose the step of “determining if a resource conserving process should be activated, prior to monitoring actions of the viewer,” as recited in independent claims 1 and 19. *Id.* at 10. (citing Ex. 1006, 6; Ex. 1007, 9). Cisco asserts that, because these provisional applications do

not disclose the aforementioned limitation, the '299 patent is entitled only to a priority date of November 16, 2005—the filing date of the '615 application that led to the '299 patent. *Id.* at 10–11.

In response, Constellation contends that Cisco's argument in this regard is mistaken because independent claims 1 and 19 do not recite “*prior to monitoring actions of the viewer.*” Prelim. Resp. 30. Instead, Constellation argues that the relevant portions of independent claims 1 and 19 recite “if the resource conserving process should be activated: determining whether the viewer is watching the television monitor.” *Id.* at 30–31 (quoting Ex. 1001, 8:22–24, 10:10–12). Notwithstanding this argument, Constellation provides a table that includes all the limitations of independent claim 1 and the corresponding written description support for these limitations in the '577 provisional application. *Id.* at 37–39. For the sake of completeness, Constellation also provides exemplary citations to the '577 provisional application and the '625 provisional application that purportedly provide written description support for the other features of the challenged claims. *Id.* at 40–41.

Claims are entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides sufficient written description support for those claims, as required by 35 U.S.C. § 112. *In re Chu*, 66 F.3d 292, 297 (Fed. Cir. 1995). To satisfy the written description requirement, the prior application must convey with reasonable clarity to those skilled in the art that, as of the earlier filing date,

the inventor was in possession of the invention. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991).

We are not persuaded by Cisco’s argument that the ’577 provisional application and the ’625 provisional application do not provide sufficient written description support for the purported step of “determining if a resource conserving process should be activated, prior to monitoring actions of the viewer.” Cisco’s argument in this regard is not commensurate in scope with the limitations recited in independent claims 1 and 19. These independent claims do not require determining if a resource conserving process should be activated “prior to monitoring actions of the viewer.” Instead, both independent claims simply recite “if the resource conserving process should be activated: determining whether the viewer is watching the television monitor.” Ex. 1001, 8:22–24, 10:10–12. Cisco does not offer an adequate explanation as to how, or why, the step of “determining whether the viewer is watching the television monitor” is essentially the same as monitoring actions of the viewer.

In any event, we are satisfied that Constellation has made a sufficient showing that the ’577 provisional application and the ’625 provisional application provide written description support for all the challenged claims. *See* Prelim. Resp. 37–41. For instance, with respect to the step of “determining if a resource conserving process should be activated” as recited in independent claims 1 and 19, Constellation directs us to the following disclosures in the ’577 provisional application: (1) checking a timer against a user’s preference (Ex. 1006, 6); (2) an action algorithm showing

bandwidth saving actions taken after determining a resource conserving processing should be activated (*id.* at 7); and (3) automatically disabling a specific feature based on certain types of actions (*id.* at 9). Prelim. Resp. 37–38. In our view, these disclosures in the ’577 provisional application convey sufficient detail such that one of ordinary skill in the art would have appreciated that the inventors of the ’299 patent possessed the idea of “determining if a resource conserving process should be activated” as of the filing date of the ’577 provisional application.

For purposes of this decision, Constellation has made a sufficient showing that all the challenged claims of the ’299 patent are entitled to claim the benefit of the filing date of the ’577 provisional application and the ’625 provisional application—namely, November 17, 2004.

### *C. Anticipation by Minnick*

Cisco contends that claims 1–3, 6–9, 11, 15, and 19–22 are anticipated under 35 U.S.C. § 102(e) by Minnick. Pet. 21–40. Cisco uses claim charts to explain how Minnick describes the claimed subject matter and relies upon the Declaration of Mr. Koperda (Ex. 1008 ¶¶ 37–56) to support its positions. *Id.* We have considered Cisco’s explanations and supporting evidence, but we are not persuaded that Minnick expressly or inherently describes “an action to conserve resources associated with transporting the television content over the packet network,” as recited in independent claims 1 and 19.

We begin our analysis with the principles of law that generally apply to a ground of unpatentability based on anticipation, followed by a general discussion of Minnick, and then we turn to the parties’ contentions with

respect to whether Minnick expressly or inherently describes “an action to conserve resources associated with transporting the television content over the packet network,” as recited in independent claims 1 and 19.

### *1. Principles of Law*

To establish anticipation under § 102(e), “all of the elements and limitations of the claim must be shown in a single prior reference, arranged as in the claim.” *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted). We analyze this ground of unpatentability based on anticipation by Minnick with the principles stated above in mind.

### *2. Minnick*

Minnick relates to television converters for receiving and delivering channels of television programming and, in particular, to determining when a channel selecting resource in a television converter is inactive. Ex. 1002 ¶ 1. Minnick discloses that, in order to maintain the efficient operation of a modern set top box, various “housekeeping” functions should be performed from time to time. *Id.* ¶ 3. These “housekeeping” functions include activities such as defragmentation of hard drives, disk scanning for errors,

memory testing, downloading software updates, spinning down hard drives when not in use, etc. *Id.* According to Minnick, a set top box typically does not perform housekeeping functions that require a channel selecting resource while the set top box is on because doing so would run the risk of interfering with a user viewing a television program. *Id.* Minnick purportedly solves this problem by first determining when the channel selecting resource in the set top box is inactive, and then using the inactive channel selecting resource as necessary for housekeeping and maintenance functions. Ex. 1002 ¶ 4.

Figure 5 of Minnick, reproduced below, illustrates method 500 for determining an inactive channel selecting resource. Ex. 1002 ¶¶ 9, 46.

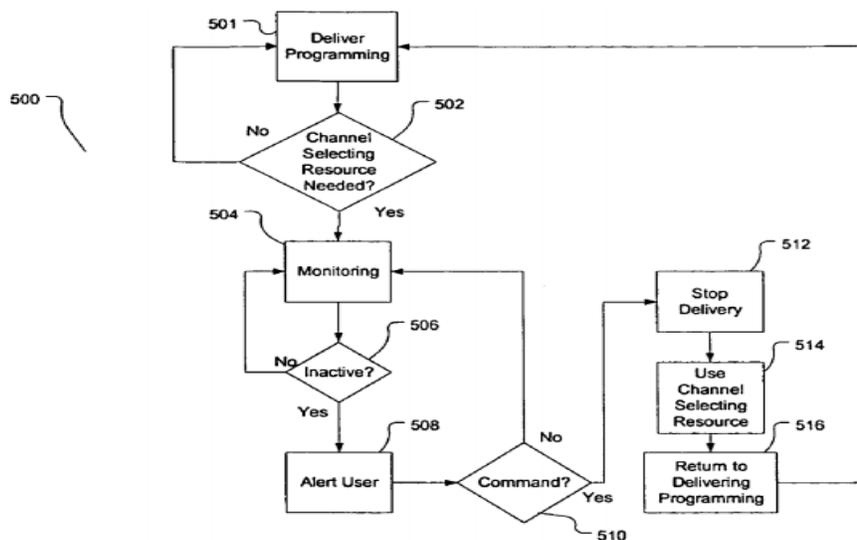


FIG. 5

As shown in Figure 5 of Minnick, delivering operation 501 delivers television programming to a set top box via a channel selecting resource. Ex. 1002 ¶ 46. First determination operation 502 identifies when the

channel selecting resource is needed by the set top box for purposes not related directly to user commands, which includes, but is not limited to, housekeeping and maintenance duties, receiving forced downloads, or remotely executing set recording timers. *Id.* This is accomplished by allowing the set top box to monitor one or more parameters during monitoring operation 504. *Id.* ¶ 47. For example, the set top box may monitor parameters such as the time since a last command was issued from the remote controller. *Id.* Determining operation 506 proceeds to analyze one or more monitored parameters, and determines whether the channel selecting resource is inactive or otherwise available for allocation by the set top box. *Id.* ¶ 49.

Minnick further discloses that, after determining whether the channel selecting resource is inactive, the set top box may attempt to verify this inactivity by displaying a message to a user alerting him/her 508 that the set top box may cease delivering television content. Ex. 1002 ¶ 52. If no such input from the user is detected within a specified time period, third determination step 510 may confirm that the channel selecting resource is inactive. *Id.* ¶ 53. Stop delivery operation 512 then may stop delivery of the television programming from the set top box to the television. *Id.* Once delivery of the television programming has stopped, background use operation 514 may allocate the channel selecting resource for a necessary purpose, such as to receive a forced download of content or computer control instructions, to perform housekeeping functions, or to perform other maintenance type duties. *Id.*

### 3. Claims 1 and 19

Independent claims 1 and 19 recite, in relevant part, “determining if a resource conserving process should be activated, wherein the resource conserving process determines if an action to conserve resources associated with transporting the television content over the packet network should be performed.” Ex. 1001, 8:17–21, 10:5–9.

Cisco contends that Minnick’s system may need to conserve resources associated with transporting television content over the packet network. Pet. 22–23. According to Cisco, Minnick accomplishes this by identifying when the channel selecting resource is needed by the set top box for purposes not related directly to user commands, such as receiving a forced download. *Id.* at 23, 27 (citing Ex. 1002 ¶ 46; *see also id.* ¶¶ 37–39 (disclosing a process that uses an inactivity detector to monitor the channel selecting resource to determine when it may be reallocated for housekeeping functions)). Cisco asserts that, at the very least, reallocating the channel selecting resource to receive a forced download is a conservation of a resource associated with transporting television content over the packet network. *Id.* at 23. To support this assertion, Cisco directs us to the testimony of its expert witness, Mr. Koperda. Ex. 1008 ¶¶ 40–45.

In response, Constellation contends that Minnick does not disclose “an action to conserve resources associated with transporting the television content over the packet network,” as recited in independent claims 1 and 19. Prelim. Resp. 16–25. In particular, Constellation argues that, according to Figure 5 of Minnick, when first determination operation 501 identifies that

the channel selecting resource is needed by the set top box for purposes not related directly to user commands, stop delivery operation 512 stops the delivery of the television content from the set top box to the television. *Id.* at 18 (citing Ex. 1002 ¶¶ 46, 53, Fig. 5). Constellation asserts that Minnick's disclosure focuses on output of the television content from the set top box to the television and, therefore, does not describe a resource conserving process associated with transporting the television content over the packet network, as claimed. *Id.* at 18–20. Constellation also asserts that Cisco has not pointed to a single disclosure in Minnick that expressly describes stopping the transmission of the television content from the content server(s) to the set top box over the packet network. *Id.* at 20.

We are not persuaded that Cisco has presented sufficient evidence to support a finding that Minnick expressly or inherently describes “an action to conserve resources associated with transporting the television content over the packet network,” as recited in independent claims 1 and 19. Cisco's position with respect to this limitation is predicated on the notion that Minnick's reallocation of the channel selecting resource to receive a forced download somehow stops or minimizes the transmission of television content from the content server(s) to the set top box over the packet network. Cisco does not direct us to, nor can we find, an express disclosure in Minnick that contemplates this type of conservation action. Instead, Minnick discloses stopping the transmission of the television content from the set top box to the television, thereby freeing the channel selecting resource to receive a forced download, presumably from the content

server(s). *See* Ex. 1002 ¶¶ 53, 54, Fig. 5 (stop delivery operation 512, background use operation 514). In other words, there is no indication in *Minnick* that, while the channel selecting resource is inactive and, as a result, capable of receiving a forced download from the content server(s), transmission of television content from the content server(s) to the set top box over the packet network is either stopped or minimized.

We also are not persuaded by Mr. Koperda's application of the doctrine of inherency. Mr. Koperda testifies that "[r]eallocating the 'channel selecting resource' by stopping delivery of the television content in order to receive a 'forced download' necessarily conserves resources associated with transporting the television content over the packet network." Ex. 1008 ¶ 40 (emphasis added). Mr. Koperda further testifies that:

The bandwidth typically required for delivering television content over a packet network is around 3.3 megabits per second (or approximately 0.4 megabytes per second). Thus, for a minute of television content delivery, approximately 25 megabytes of data is transferred to the STB [set top box] and as much as 750 megabytes for a thirty minute television program. On the other hand, typical downloads that tend to be "forced" upon a STB like in *Minnick* are usually 10 to 20 megabytes of computer program data, which is much less than the amount of television data delivered to the STB for a single television program. Therefore, when the channel selecting resource stops television content delivery, and instead receives a forced download, *Minnick* has conserved resources associated with transporting the television content over the packet network by reducing the amount of network bandwidth used.

*Id.* ¶ 44.

This testimony from Mr. Koperda only indicates that “typical downloads that tend to be ‘forced’ upon a [set top box],” such as the forced downloads disclosed in Minnick, consume less bandwidth on a packet network than the transmission of television content to the set top box over the packet network. *Id.* It leaves open the possibility that a forced download may consume the same or more bandwidth on a packet network than the transmission of television content over the packet network. The aforementioned testimony from Mr. Koperda does not cure the deficiency in Minnick identified above. Although Minnick’s disclosure of delivering a forced download to the set top box over a packet network may require less bandwidth than delivering television content to the set top box over the packet network, mere probabilities and possibilities fall short of demonstrating that Minnick necessarily describes “an action to conserve resources associated with transporting the television content over the packet network,” as required for anticipation. *See Robertson*, 169 F.3d at 745.

Based on the record before us, Cisco has not demonstrated a reasonable likelihood that it will prevail on its assertion that independent claims 1 and 19 are anticipated by Minnick

*4. Claims 2, 3, 6–9, 11, 15, and 20–22*

As we explained previously, claims 2, 3, 6–9, 11, 15, and 20–22 directly or indirectly depend from independent claims 1 and 19, respectively. By virtue of their dependency, each of claims 2, 3, 6–9, 11, 15, and 20–22 incorporate the same limitations as their underlying base claim. For the same reasons discussed above with respect to independent claims 1 and 19,

Cisco has not demonstrated a reasonable likelihood that it will prevail on its assertion that dependent claims 2, 3, 6–9, 11, 15, and 20–22 are anticipated by Minnick.

*D. Obviousness Based, in Part, on Riley*

Cisco contends that: (1) claims 1–3, 6–11, 14, 15, and 18–22 are unpatentable under 35 U.S.C. § 103(a) over the combination of Riley and Minnick; and (2) claims 12 and 13 are unpatentable under 35 U.S.C. § 103(a) over the combination of Riley, Minnick, and Harrell. Pet. 40–59. Cisco uses claim charts to explain how the prior art references teach the claimed subject matter and relies upon the Declaration of Mr. Koperda (Ex. 1008 ¶¶ 57–85) to support its positions. *Id.* We have considered Cisco’s explanations and supporting evidence, but we are not persuaded that Cisco has made a sufficient showing that Riley qualifies as prior art to the ’299 patent under 35 U.S.C. § 102(e).

*1. Riley*

Riley issued from U.S. Patent Application No. 11/041,779 (“the ’779 application”), filed on January 24, 2005. Ex. 1003, at [21], [22]. The ’779 application claims the benefit of the following two provisional applications: (1) U.S. Provisional Application No. 60/538,802 (Ex. 1012, “the ’802 provisional application”), filed on January 23, 2004; and (2) U.S. Provisional Application No. 60/538,803 (Ex. 1011, “the ’803 provisional application”), also filed on January 23, 2004. Ex. 1003, at [60].

Cisco contends that Riley claims priority to the ’802 provisional application and the ’803 provisional application, both filed on January 23,

2004, and, therefore, qualifies as prior art to the '299 patent under 35 U.S.C. § 102(e). Pet. 4, 17. Cisco asserts that, because the features of Riley it relies upon in the asserted grounds of unpatentability based, in part, on Riley are supported by the '802 provisional application and the '803 provisional application, Riley should be granted the benefit of the earlier filing date of these provisional applications. *Id.* at 17. To support this assertion, Cisco relies upon the testimony of Mr. Koperda. Ex. 1008 ¶ 57. Mr. Koperda testifies that “[he has] reviewed both provisional applications[,] as well as the Appendix referenced by and submitted with [the '803 provisional application], and it is [his] opinion that the features of *Riley* discussed below are supported by the two provisional applications . . . to which it claims priority.” *Id.*

In response, Constellation contends that, in the asserted grounds of unpatentability based, in part, on Riley, Cisco solely relies on paragraph 58 of Riley to teach “an action to conserve resources associated with transporting the television content over the packet network,” as recited in independent claims 1 and 19. Prelim. Resp. 42–43 (citing Pet. 42). Constellation argues that neither Cisco, nor its expert witness, Mr. Koperda, attempts to justify their assertions that Riley is supported by the '802 provisional application and the '803 provisional application by pointing to a specific disclosure in these provisional applications that provides sufficient written description support for paragraph 58 of Riley. *Id.* at 44. Constellation briefly summarizes the '802 provisional application and the '803 provisional, and then asserts that each provisional application does not

disclose paragraph 58 of Riley verbatim, much less disclose activities, such as monitoring or determining viewing indicia, or releasing reserved resources. *Id.* at 44–47.

Title 35, United States Code, section 311(b), limits the scope of an *inter partes* review to “only . . . a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.” A petitioner has the burden of proof to establish that a reference that serves as the basis of a ground of unpatentability asserted in an *inter partes* review qualifies as prior art. *See* 37 C.F.R. § 42.20(c) (“The moving party has the burden of proof to establish that it is entitled to the requested relief.”)

We are not persuaded that Cisco has made a sufficient showing that Riley qualifies as prior art to the ’299 patent under 35 U.S.C. § 102(e). Notably absent from the Petition and the supporting Declaration of Mr. Koperda is a sufficient or credible explanation as to how the disclosures in the ’802 provisional application and the ’803 provisional application provide sufficient written description support for the features in Riley relied upon by Cisco, particularly paragraph 58 of Riley. We do not credit Mr. Koperda’s testimony that he has reviewed these provisional applications and that, in his opinion, they provide sufficient written description support for the features in Riley relied upon by Cisco. Ex. 1008 ¶ 57. This testimony is conclusory in nature and entitled to little, if any, weight. *See* 37 C.F.R. § 42.65 (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”).

Based on the evidence presented and developed in the Petition, as well as the corresponding testimony of Mr. Koperda, we conclude that Cisco has not made a sufficient showing that Riley is entitled to claim the benefit of the filing date of the '802 provisional application and the '803 provisional application. As a result, the earliest effective filing date that should be accorded to Riley is the filing date of the '779 application—namely, January 24, 2005. As we explained previously, Constellation has made a sufficient showing that all the challenged claims of the '299 patent are entitled to claim the benefit of the filing date of the '577 provisional application and the '625 provisional application—namely, November 17, 2004. Because Constellation has made a sufficient showing that the '299 patent is entitled to an effective filing date of November 17, 2004, and Cisco has shown only that Riley is entitled to a filing date of January 24, 2005, Cisco has not demonstrated a reasonable likelihood that it will prevail on its assertion that Riley qualifies as prior art to the '299 patent under 35 U.S.C. § 102(e).

We do not reach whether the grounds of unpatentability based, in part, on Riley renders obvious claims 1–3, 6–15, and 18–22 of the '299 patent because, as discussed above, Cisco has not demonstrated a reasonable likelihood that it will prevail on its assertion that Riley qualifies as prior art to the '299 patent under 35 U.S.C. § 102(e).

### III. CONCLUSION

Taking into account the arguments presented in Constellation's Preliminary Response, we conclude that the information presented in the

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Petition does not demonstrate that there is a reasonable likelihood that Cisco will prevail in challenging claims 1–3, 6–15, and 18–22 of the '299 patent as unpatentable under 35 U.S.C. §§ 102(e) and 103(a).

#### IV. ORDER

In consideration of the foregoing, it is ORDERED that the Petition is DENIED and no trial is instituted.

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