UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

I.M.L. SLU,

Petitioner,

v.

WAG ACQUISITION, LLC,

Patent Owner.

Case IPR2016-01656
Patent 8,122,141

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE TO PETITION

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I. INTRODUCTION

Patent Owner's assertion that claims 19-23 of the '141 Patent are patentable fails in multiple respects since it is built on (i) an unsupported claim construction and (ii) faulty characterizations of the prior art. Patent Owner rests its patentability arguments on unsupported assertions that the claims should be construed to require "a 'pull' mechanism" for streaming media "in response to repeated requests by the client. . ." "by breaking the streaming media into serially identified elements. . ." which elements are not "too small. . ." to work with the pull mechanism and which will "achieve uninterrupted playback." Patent Owner Response ("POR"), Paper No. 20 at 2, 7, 8, 10 (emphasis added). None of the underlined terms are found in the claims at issue and there is no support for them in the patent specification (except for the term "uninterrupted playback" which is expressly included in claims not at issue, *e.g.*, claim 1, and excluded from claims 19-23). Nor does Patent Owner rationally explain why any of these terms should be imported into the claims even if they could draw support from the specification.

The error of Patent Owner's overreaching claim construction is compounded by its mischaracterization of the primary prior art reference, Chen. Contrary to Patent Owner's assertions, even if the challenged claims could be construed to expressly require a "pull mechanism," Chen discloses one.

II. DISCUSSION

A. Patent Owner's Proposed Claim Construction Is Untenable

Patent Owner seeks to have the claim phrase "in a format capable of being served to users by said server" to mean "a format whose characteristics make it possible to serve the multimedia program comprised of those elements via the recited 'pull' mechanism in order to achieve uninterrupted playback." POR, Paper No. 20, at 7. The Patent Owner fails to provide any, much less adequate, support in the evidentiary record for this construction.

The Board already considered and rejected the exact construction Patent Owner proposes for a second time in the Patent Owner Response. Institution Decision, Paper No. 11 at 9-10. Patent Owner does not adequately address any of the points made by the Board when it rejected the proposed construction for the first time in its Institution Decision. If not completely determinative, this weighs heavily against Patent Owner's proposition.

A proposed construction of a claim term must be supported by some evidence, not just attorney argument. *See United States v. Adams*, 383 U.S. 39, 49 (1966) ("it is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention."); *Icon Health & Fitness, Inc. v. Strava, Inc*., 849 F.3d 1034, 1046 (Fed. Cir. 2017) ("Attorney argument is not evidence or explanation in support of a conclusion.").

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