UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

I.M.L. SLU
Petitioner

v.

WAG ACQUISITION, LLC
Patent Owner

U.S. Patent No. 8,122,141

Inter Partes Review Case No. IPR2016-01656

PATENT OWNER PRELIMINARY RESPONSE

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Patent Owner WAG Acquisition, L.L.C. ("Patent Owner" or "WAG") respectfully submits this Preliminary Response in accordance with 35 U.S.C. § 313 and 37 C.F.R. § 42.107, responding to the Petition for *inter partes* review (the "Petition") filed by I.M.L. SLU ("Petitioner") regarding the claims of U.S. Patent No. 8,122,141 (the "'141 Patent"). While Patent Owner is not required to file a Preliminary Response (37 C.F.R. § 42.107(a)), WAG takes this limited opportunity to point out the shortcomings of the Petition and the reasons why the Board should not institute trial.

By statute, the Board must decide whether to institute a trial based on "the information presented in the petition" while also determining whether to "reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. §§ 314(a), 325(d).

I. DUPLICATION

The Petitioner acknowledges that there is an issue of duplication under 35 U.S.C. § 325(d). (*See* Petition at 7-8.) A side-by-side comparison of the instant Petition with the Petition filed in IPR2016-01238 (the "2016 '1238 Petition") should make clear that the anticipation arguments in this case are at least substantially similar to those in the 2016 '1238 Petition and are based upon identical art – *e.g.* U.S. Patent No. 5,822,524 to Chen ("Chen"); U.S. Patent No. 6,389,473 to Carmel et al. ("Carmel"); "Bamba – Audio and Video Streaming

Over the Internet," published by Willebeek-LeMair, *et al.* ("Willebeek"). (*Compare* Petition at ii *with* 2016 '1238 Petition at iii.) In a few instances, Petitioner seeks to present a different spin on these previously-asserted grounds by pressing tenuous alternative claim interpretations, but in the main, the Board will recognize the arguments as substantial repeats of those in the 2016 '1238 Petition.

Petitioner states that Grounds 2-5 rely "upon the combination of Chen with different prior art than used in the prior pending IPR" and argues the instant Petition should be instituted on this basis. (Petition at 7.) But Petitioner offers no explanation as to how this different prior art offers any new facts that cure deficiencies in Chen or in the art cited in the earlier 2016 '1238 Petition. *See Medtronic, Inc. v. Nuvasive, Inc.*, Case IPR2014-00487, slip op. at 6-7 (PTAB September 11, 2014) (Paper 8) (denying petition despite grounds "based on different prior art references and different arguments") (internal quotations omitted).

Petitioner even seeks to use its own last-minute filing of the present IPR as a "reason" to consider this Petition. (*See* Petition at 8.) Petitioner argues that "[t]he present petition is Petitioner's only option for relief at the PTAB." (*Id.*) In fact, Petitioner's option to file an IPR expired more than a year before it filed the instant

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