UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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NETAPP, INC.,
Petitioner

v.

REALTIME DATA LLC,
Patent Owner

Patent No. 7,161,506

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Inter Partes Review No. IPR2017-01660

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PETITIONER'S SUPPLEMENTAL BRIEF REGARDING *GENERAL PLASTIC* FACTORS

Petitioner's Exhibit List for *Inter Partes* Review of U.S. Patent No. 7,161,506

Exhibit Description	Exhibit #
U.S. Patent No. 7,161,506 (the "'506 patent"), including Reexamination Certificate No. 7,161,506 C1 and Reexamination Certificate No. 7,161,506 C2	1001
Hsu and Zwarico, "Automatic Synthesis of Compression Techniques for Heterogeneous Files," *Software-Practice and Experience*, Vol. 25(10), 1097-1116 (October 1995) ("Hsu")	1002
U.S. Patent No. 5,870,036 ("Franaszek")	1003
U.S. Patent No. 6,195,024 (the "'491 application")	1004
Declaration of Dr. Daniel Hirschberg ("Hirschberg Decl.")	1005
July 5, 2006 Notice of Allowability, Application No. 10/668,768	1006
December 15, 2009 Non-Final Office Action, Reexamination No. 95/000,479	1007
January 18, 2012 Decision on Appeal, Reexamination No. 95/000,479	1008
April 25, 2012 *Inter Partes* Reexamination Petition, Reexamination No. 95/001,926	1009
August 16, 2013 Right of Appeal Notice, Reexamination No. 95/001,928	1010
Memorandum Opinion and Order ("Claim Construction Order")	1011
U.S. Patent No. 6,253,264 ("Sebastian")	1012
U.S. Patent No. 5,467,087 ("Chu")	1013

Exhibit Description	Exhibit #
Declaration of Dr. Scott Bennett ("Bennett Decl.")	1014
D.A. Lelewer and D.S. Hirschberg, "Data compression," *Computing Surveys* 19:3 (1987) 261-297	1015
International Patent Application Publication No. WO 2001/063772	1016
International Patent Application Publication No. WO 2001/050325	1017
Listing of Realtime's cases asserting the '506 patent	1018
Order Denying Stay, Case 6:16-CV-00961, Docket No. 151 (E.D. Tex April 24, 2017)	1019

*Petitioner's Exhibits 1001 - 1017 were previously filed and are listed again here

based on 37 C.F.R. § 42.63.

**Petitioner's Exhibits 1018-1019 are newly filed.

Pursuant to the Board's email of November 20, 2017, Petitioner NetApp submits that the *General Plastic* factors should not apply to petitioners that have not previously filed a petition. A first time petitioner should have an opportunity to challenge a patent without being required to join an earlier, significantly different petition.

Even if the *General Plastic* factors were applied to this case, they favor institution. NetApp's Petition's timing is justified and there is no reason why the Board could not issue a final written decision within the statutory time period.

I. *GENERAL PLASTIC* FACTORS FAVOR INSTITUTION

A. Factor 1 – "whether the same petitioner previously filed a petition directed to the same claims of the same patent"

NetApp has not filed a previous petition against the '506 patent and thus this factor weighs in favor of instituting the Petition. Additionally, NetApp's Petition does not include the ground that was instituted in the earlier IPRs.[1] Instead, the Petition includes four unique grounds, each of which is different from the grounds presented in the earlier petitions. While some of the prior art is overlapping, the actual grounds rely on different portions of the prior art references, different combinations of the prior art references, different motivations to combine the prior art references, and different expert testimony. Realtime's argument that NetApp's Petition is the same as the earlier petitions ignores all of these significant

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[1] IPR2017-00176 and IPR2017-00806.

differences. *See* Patent Owner Preliminary Response at 6-7. NetApp submits that these facts should be dispositive, and that the rest of the *General Plastic* factors should not outweigh this factor to deny institution of a first petition filed by a party. To find otherwise would enable patent owners to file multiple serial actions, as Realtime has done here, in an effort to limit later defendants from filing IPR petitions.[2]

In another proceeding for a related patent, the Board noted that there is no precedent for this factor to be dispositive. *NetApp, Inc. v. Realtime Data LLC*, Case IPR2017-01354, slip op. 10-11 (PTAB November 14, 2017) (Paper 16). NetApp submits, however, that (1) before the Board decided NetApp's IPR petitions the Board had never applied these factors to a petitioner's first IPR petition and (2) that the Board has previously recognized a party's right to pursue an IPR even when the prior art is the same or similar to art present in an earlier petition. *See, e.g.*, *SAP America Inc. v. Clouding IP, LLC*, Case IPR2014-00306, slip op. 13 (PTAB May 19, 2014) (Paper 12) ("We consider each petition by a different petitioner on its own merits, in part, because a second petitioner has no control over the decision to see a review through a determination on the merits if the second petitioner is not a party in that matter. Therefore, we decline to deny

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[2] Realtime has asserted the '506 patent against over 60 defendants starting in 2008. Exhibit 1018.

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