

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SLING TV, L.L.C., et al.,
Petitioner

v.

REALTIME ADAPTIVE STREAMING LLC,
Patent Owner

Case IPR2018-01342
Patent 8,934,535

Before KEVIN W. CHERRY, GARTH D. BAER, and NABEEL U. KHAN,
Administrative Patent Judges.

**PETITIONER'S MOTION TO FILE SUPPLEMENTAL INFORMATION
PURSUANT TO 37 C.F.R. § 42.123**

EXHIBITS

DISH1029

Supplemental Declaration of Dr. Scott Acton

I. BOARD AUTHORIZATION AND LEGAL STANDARD

Pursuant to Petitioner's request under 37 C.F.R § 42.123(a), made on February 27, 2019 within a month of institution, and further pursuant to the Board's authorization granted on March 11, 2019, Petitioner moves to submit DISH1029 ("Supplemental Declaration of Dr. Scott Acton") as supplemental information. The Board recognizes that "supplemental information may prove beneficial to the Board in reaching a decision with respect to the trial." *Pacific Market Int'l v. Ignite USA, LLC*, IPR2014-00561, Paper 23 at 3 (PTAB Dec. 2, 2014). The Board may grant a motion to submit supplemental information where, as here, limited expert testimony is provided to further support an instituted ground of unpatentability. *See id.*; *see also, e.g., The Boeing Co. v. Seymour Levine*, IPR2015-01341, Paper 30 at 4 (PTAB Apr. 15, 2016) (granting motion to submit supplemental information where the supplemental information was limited in scope and did not alter the ground in the petition but merely provided additional evidence of obviousness).

The supplemental information meets all legal requirements for such material because it is timely and relevant to a claim in this trial. The supplemental information relates to instituted Ground 3 and its applicability under the Board's *preliminary* claim construction of "access profile" in the Netflix proceeding, IPR2018-01169, institution decision. *See* 37 C.F.R. 42.123(a). The material provides additional evidence, presented in the alternative, regarding the narrower,

preliminary claim construction from the Netflix IPR, and confirms the invalidity of the challenged claims under Ground 3 in this matter, even under that narrower, preliminary construction from the Netflix IPR. The supplemental information will cause no prejudice to Patent Owner or delay in the proceedings. Petitioner respectfully requests the Board grant Petitioner's request.

II. STATEMENT OF FACTS

On July 3, 2018, Petitioner sought review of claims 1–6, 8–12, and 14 (the “challenged claims”) of U.S. Pat. No. 8,934,535 B2 (DISH1001, “the ’535 Patent”). IPR2018-01342, Paper No. 9 at 1. Petitioner submitted the declaration of Dr. Scott Acton (DISH1003) in support of its Petition.

Petitioner challenges claims 1–6, 8–12, and 14 on the following grounds:

Ground	Claims	Basis for Rejection
Ground 1	1, 2, 9, 10, 14	Anticipated by Dvir ¹ , 35 U.S.C. § 102
Ground 2	1, 2, 9, 10, 14	Obvious over Dvir, 35 U.S.C. § 103
Ground 3	3-6, 8, 11, 12	Obvious over Dvir in view of Ishii ² , 35 U.S.C. § 103

IPR2018-01342, Paper No. 9 at 8. Petitioner argued that the specification-supported, broadest reasonable interpretation (“BRI”) of the claim term “access profile” is “information that enables a controller to determine a compression routine that is associated with a data type of the data to be compressed.” *Id.* at 19-21 (citing certain portions of the ’535 Patent specification).

¹ DISH1004 – Dvir, U.S. Pat. No. 6,557,001

² DISH1005 – Ishii, U.S. Pat. No. 5,675,789

On January 17, 2019, six months after Petitioner filed its petition, the Board granted a separate request for *inter partes* review of claims 1-14 of the '535 Patent submitted by Netflix, Inc. *et. al.* (“Netflix”). IPR2018-01169, Paper No. 20 at 2.

Netflix challenged claims 1-14 on the following grounds:

Ground	Claims	Basis for Rejection
Ground 1	1-14	Obvious over Imai ³ and Ishii

Id. at 8. Netflix’s Ground 1 and Petitioner’s Ground 3 rely on the Ishii reference.

On January 31, 2019, the Board instituted a trial in this proceeding, IPR2018-01342, on all challenged claims, determining that it is more likely than not that Petitioner will prevail in showing unpatentability of the challenged claims.

Id. at 2, 20-21. The Board did not construe the term “access profile” because it determined that no claim construction was necessary to institute. *Id.* at 10 (noting that the parties are still “*expected to assert all their claim construction* arguments and *evidence . . . as permitted by our rules.*” (emphasis added)).

However, in the earlier institution of the Netflix petition, the Board preliminarily construed the claim term “access profile” to mean “information regarding the number or frequency of reads or writes.” IPR2018-01169, Paper No. 20 at 12. It noted that a “final determination as to claim construction will be made at the close of the proceeding, after any hearing, based on all the evidence of record.” *Id.* at 10.

On a review of that record, the Board found that Netflix had demonstrated a

³ Imai, Japanese Patent App. Pub. No. H11331305, published Nov. 30, 1999.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.