

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

**PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION TO
SUPPLEMENT WITH NEW EXPERT OPINIONS**

Petitioner seeks to add a new expert declaration about a claim construction that was mentioned in another IPR. Petitioner did not propose this construction and still does not assert it is correct. Nevertheless, Petitioner seeks to present additional opinions “in the alternative.” Because this is not proper supplemental information, and because Petitioner was aware of the construction at least a month before the Petition, this motion to supplement should be denied.

I. RELEVANT FACTS

On June 4, 2018, Netflix filed a Petition challenging claims 1–14 of the U.S. Patent No. 8,934,535 (“’535 patent”). IPR2018-01169 (“Netflix IPR”), Paper 4 at 1. Netflix proposed that the term “access profile” be construed as “information regarding the number or frequency of reads or writes.” *Id.* at 10.

A month later, on July 3, 2018, DISH filed this Petition challenging claims 1–6, 8–12, and 14 of the ’535 patent. IPR2018-01342, Paper 2 at 1. The Petition noted that the ’535 patent is subject to pending IPRs and referenced the Netflix IPR. *Id.* at 2. The Petition proposed that the term “access profile” be construed as “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 19–20.

On January 17, 2019, the Board issued its institution decision in the Netflix IPR. IPR2018-0116, Paper 20. The Board adopted as its preliminary construction

for “access profile” the same construction that Netflix proposed: “information regarding the number or frequency of reads or writes.” *Id.* at 11–12.

On January 31, 2019, the Board issued its institution decision in this IPR. IPR2018-01342, Paper 9. The Board noted that Petitioner proposed a construction for “access profile” but Patent Owner did not address this construction in the preliminary response. *Id.* at 10. Thus, the Board did not construe “access profile.”

II. ARGUMENT

A. Petitioner seeks to introduce new expert opinions for a construction it does not contend is correct.

Petitioner seeks to introduce the supplemental expert declaration of Dr. Acton. IPR2018-01342, Paper 13 (“Mot.”) at 6, Proposed Ex. 1029. In the declaration, Dr. Acton provides opinions “in the alternative only” (*id.*) and adds a new theory under the construction of “access profile” as ““information regarding the number or frequency of reads or writes.”” Importantly, neither Petitioner nor Dr. Acton assert that this alternative construction is correct. As Petitioner acknowledges, it “continues to assert that its previously proposed construction of the ‘access profile’ term offered with its petition is the proper BRI construction of access profile.”” *Id.*

Thus, Petitioner seeks to introduce a new theory—not the type of “supplemental information” sometimes allowed by the Board. *See Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 3 (allowing exhibits relating to public accessibility because it “does not change the grounds of

unpatentability authorized in this proceeding”). Indeed, Petitioner fails to identify any new “information” or evidence it seeks to supplement. For example, Petitioner does not seek to introduce the Board’s institution decision in the Netflix IPR. Nor does Dr. Acton mention or rely on that decision. Instead, Dr. Acton merely states he is providing alternative opinions under a different construction that “DISH’s counsel asked [him] to consider.” Proposed Ex. 1029 ¶ 224.

B. The new opinions could and should have been included with the original Petition

An IPR petition is required to include a complete statement of the petitioner’s theories and arguments. *See* 35 U.S.C. § 312(a)(3) (requiring petitions to identify “with particularity . . . the grounds on which the challenge to each claim is based”); *Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012) (prohibiting parties from submitting evidence necessary for a prima facie showing of obviousness in reply). As the Federal Circuit held: “It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify with particularity the evidence that supports the grounds for the challenge to each claim.”). *Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017); *see also Pfizer v. Chugai Pharmaceutical*, IPR2017-01357, Paper 56 at 19 (PTAB Nov. 28, 2018) (rejecting petitioner’s attempt to add a new theory because

rather than “explaining how its original theory was correct,” the new argument amounted to “a new theory . . . absent from the petition”).

Here, there is no reason Petitioner could not have included its new alternative theory with its Petition. Petitioner had full view of the intrinsic evidence of the challenged ’535 patent and could have analyzed any constructions the Board might adopt. Indeed, Petitioner asserts that its motion is justified because the Board might construe access profile “more narrowly” than its proposal. Motion at 6. But if this is so, that possibility existed at the time of the Petition.

Further, Petitioner was aware of the alternate construction at least a month before its Petition. This Petition was filed on July 4, 2018. A month earlier, on June 4, Netflix filed its petition and proposed the same construction for which Petitioner now seeks to supplement. The Petition even references the Netflix IPR. Thus, with full awareness of Netflix’s proposed construction, Petitioner decided to omit it. It should not be allowed to add an entire declaration on that construction now.

C. The Board should deny the motion to supplement.

The Board should exercise its discretion to deny Petitioner’s motion to supplement. *See Redline Detection, LLC v. Star Envirotech, Inc.*, IPR2013-00106, Paper 24 at 4 (“Nothing in [37 C.F.R. § 42.123] suggests . . . that such a motion would be granted no matter the circumstance.”). Even where the request is made within one month of institution and the supplemental information is relevant, the

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