

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SLING TV, L.L.C., SLING MEDIA, L.L.C.,
DISH NETWORK L.L.C., DISH TECHNOLOGIES L.L.C.,
GOOGLE LLC, and COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

REALTIME ADAPTIVE STREAMING, LLC,
Patent Owner.

IPR2018-01342¹
Patent 8,934,535 B2

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

CHERRY, *Administrative Patent Judge*.

ORDER

*Granting-in-Part and Denying-in-Part Patent Owner's Motion to Terminate
37 C.F.R. § 42.5(a)*

¹ GOOGLE LLC, who filed a petition in IPR2019-00748, and COMCAST CABLE COMMUNICATIONS, LLC, who filed a petition in IPR2019-00760, have been joined as petitioners in this proceeding.

On September 6, 2019, we authorized Patent Owner Realtime Adaptive Streaming, LLC (“Realtime Adaptive Streaming” or “Patent Owner”) to file a motion to terminate this proceeding in view of the Precedential Opinion Panel’s² recent decision in *GoPro, Inc. v. 360Heros, Inc.*, IPR2018-01754, Paper 38 (Aug. 23, 2019) (precedential). *See* Paper 27. Patent Owner filed its Motion to Terminate (Paper 30, “Motion” or “Mot.”) on September 16, 2019. Petitioner Sling TV, Sling Media, Dish Network, Dish Technologies (collectively, “Sling”) filed an opposition (Paper 31, “Sling Opposition” or “Sling Opp.”). Joined parties Google LLC and Comcast Communications LLC also filed a joint opposition to the Motion (Paper 32, “Joined Opposition” or “Joined Opp.”). Patent Owner filed a reply. Paper 33 (“Reply”).

For the following reasons, we grant-in-part and deny-in-part Patent Owner’s Motion. For the reasons explained below, Sling is terminated as a petitioner, but the motion is otherwise denied.

I. INTRODUCTION

A. BACKGROUND

On June 6, 2017, Realtime Data LLC (“Realtime Data”) filed and subsequently served an amended complaint in the Eastern District of Texas, *Realtime Data LLC v. EchoStar Corp.*, No. 6:17-cv-00084-RWS-JDL naming Sling as a defendant and alleging infringement of U.S. Patent No. 8,934,535 B2 (Ex. 1001, “the ’535 Patent”). *See* Ex. 2001. When Realtime Data filed its complaint, however, it did not own the ’535 Patent, because it

² *See* PTAB Standard Operating Procedure 2 (Revision 10) (Sept. 20, 2018) (“SOP2”). We shall refer to the Precedential Opinion Panel as “POP.”

had previously recorded an assignment to Realtime Adaptive Streaming on March 7, 2017. *See* Ex. 1026. Realtime Data thus voluntarily dismissed the complaint without prejudice, and on October 10, 2017, Realtime Adaptive Streaming filed a complaint again naming Sling as a defendant and alleging infringement of the '535 Patent. Paper 7, 2. Less than one year later, on July 3, 2018 Sling filed its Petition in this case. *See* Paper 2, 66.

In its Preliminary Response, Patent Owner argued that we should not institute review because the Petition was barred under 35 U.S.C. § 315(b). Paper 6. We allowed Sling to file a reply on this issue (Paper 7), and Patent Owner to file a Sur-Reply (Paper 8).

On January 31, 2019, we instituted this proceeding. *See* Paper 9 (“Decision on Institution” or “Dec. on Inst.”). We determined that Sling had demonstrated a reasonable likelihood of prevailing on at least one challenged claim, and that the Petition was not barred under 35 U.S.C. § 315(b) because Realtime Data did not own the '535 Patent when it served a complaint alleging infringement of the '535 Patent on Sling. *See id.* at 11–14. In particular, we construed 35 U.S.C. § 315(b) based on the statute’s heading—“Patent Owner’s Action”—to require that the party serving the complaint had to be the owner of the patent. *See id.*

On February 27, 2019, Google LLC (“Google”) filed a petition in IPR2019-00748 challenging the '535 Patent. *See* IPR2019-00748, Paper 1 (“Google Petition”). Google’s petition was accompanied by a motion for joinder to this proceeding. *See* IPR2019-00748, Paper 3 (“Google Joinder”). Patent Owner did not file a preliminary response. On August 13, 2019, we instituted *inter partes* review and joined Google as a party to this

proceeding. *See* Paper 26 (IPR2019-00748 Institution Decision) (“748 Inst. Dec.”).

On February 28, 2019, Comcast Cable Communications, LLC (“Comcast”) filed a petition in IPR2019-00760 challenging the ’535 Patent. *See* IPR2019-00760, Paper 1 (“Comcast Petition”). Comcast’s petition was accompanied by a motion for joinder to this proceeding. *See* IPR2019-00760, Paper 3 (“Comcast Joinder”). Patent Owner did not file a preliminary response. On August 13, 2019, we instituted *inter partes* review and joined Comcast as a party to this proceeding. *See* Paper 25 (IPR2019-00760 Institution Decision) (“760 Inst. Dec.”).

Google and Comcast were also both sued for infringement of the ’535 Patent. Google was sued for infringement of the ’535 Patent in *Realtime Adaptive Streaming, LLC v. Google LLC & YouTube*, Case No. 2:18-cv-03629 FMO (JCx) (C.D. Cal.) (“Google Action”). Ex. 1101, 1. Google was served with the complaint in the Google Action on May 4, 2018. *Id.* at 2. Comcast was sued for infringement of the ’535 Patent in *Realtime Adaptive Streaming, LLC v. Comcast Cable Communications, LLC & Comcast Corp.*, Case No. 1:18-CV-01446-PAB-STV (D. Colo.) (“Comcast Action”). *See* Ex. 1103. Comcast was served with the complaint in the Comcast Action on July 20, 2018. *See id.*

B. LEGAL STANDARD

Section 315(b) provides that “an *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b) (2018). The Federal Circuit recently held that

“[35 U.S.C.] § 315(b)’s time bar is implicated once a party receives notice through official delivery of a complaint in a civil action, irrespective of subsequent events.” *Click-to-Call Techs. v. Ingenio, Inc.*, 899 F.3d 1321, 1330 (Fed. Cir. 2018) (“*Click-to-Call*”). According to the Federal Circuit, “the plain meaning of the phrase ‘served with a complaint’ is ‘presented with a complaint’ or ‘delivered a complaint’ in a manner prescribed by law.” *Click-to-Call*, 899 F.3d at 1330. Moreover, “Congress chose the date of service, as opposed to some other event, as the trigger for § 315(b)’s time bar because service of a complaint is the seminal notice-conferring event in a district court action.” *Id.* at 1332.

The Precedential Opinion Panel has determined that “[t]he service of a pleading asserting a claim alleging infringement, including where the serving party lacks standing to sue or the pleading is otherwise deficient, triggers the one-year time period for a petitioner to file a petition under 35 U.S.C. § 315(b).” *GoPro*, Paper 38, at 24.

II. ANALYSIS

A. SLING

Patent Owner submits that it is undisputed that Sling was served with a complaint more than one year before the filing date of the Petition. Mot. 1. Patent Owner further submits that, even though Realtime Data did not own the ’535 Patent, *GoPro* holds that § 315(b) still bars the Petition and this proceeding should be dismissed. *Id.* at 1–6.

Sling raises several arguments why the case should not be terminated with respect to them. Sling Opp. 2–5. Sling argues that SOP2 “commands that precedential Board decisions are ‘binding Board authority in *subsequent matters* involving similar facts or issues.’” *Id.* at 2. Because *GoPro* issued

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