

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRILLER, INC.
Petitioner

v.

TIKTOK PTE. LTD.
Patent Owner

Case No. IPR2022-00179
U.S. Patent No. 9,648,132
Issue Date: May 9, 2017

Title: Method Of Enabling Digital Music Content To Be Downloaded To And
Used On a Portable Wireless Computing Device

**PETITIONER'S REPLY IN FURTHER SUPPORT OF MOTION
TO SUBMIT SUPPLEMENTAL INFORMATION**

I. Patent Owner's Arguments With Respect To The Supplemental Declaration As A Whole Should Be Rejected

With respect to the declaration as a whole, Patent Owner first argues that “there is currently no paper of record that cites to Dr. Shamos’s supplemental declaration,” that “[i]t is therefore unclear how Triller plans to rely on this additional testimony,” and that this is “unduly prejudicial.” (Opp. 6, 13.) But there will *never* be a paper of record that cites to supplemental information when the Board is deciding a motion like this; that argument would preclude the filing of *any* supplemental information. In any event, it is abundantly apparent how Triller plans to rely on the declaration because it identifies the issues and then addresses them. Indeed, Patent Owner’s section-by-section responses to the declaration show that Patent Owner understands how Triller plans to rely on the declaration.

Patent Owner also argues that it is prejudiced “by the limited period of mere weeks between potential granting of Triller’s motion and Due Date 1,” stating that at least “about a week” is needed between Dr. Shamos’s deposition and Patent Owner’s Response. (Opp. 6.) But Petitioner timely asked for authorization to file this motion, Patent Owner has had Dr. Shamos’s supplemental declaration since July 1, Dr. Shamos’s deposition is currently scheduled for August 1, and Petitioner recently stipulated to extend the time for submitting Patent Owner’s Response to August 12 (Paper No. 13), so this is not a reason to deny the motion.

Patent Owner also argues that granting the motion would not lead to “a

minimum number of depositions.” (Opp. 7.) It is true that there may well be two depositions of Dr. Shamos, but the point is that there are unlikely to be *three* depositions. The observation of “a minimum number of depositions” in *Pacific Market* is applicable here for the same reasons it was applicable there because the declaration is being submitted *before* Dr. Shamos’s first deposition, not *after* it.

II. Patent Owner’s Section-by-Section Arguments Should Be Rejected

A. Paragraphs 5-11. With respect to paragraphs 5-11 of the declaration, Patent Owner argues that supplemental information is “not a mechanism to challenge the Board’s claim construction.” (Opp. 7-8.) But the case it cites in support of that argument was one in which the Board’s Institution Decision “disagreed with the expert testimony on certain claim constructions.” *Rackspace US, Inc. v. PersonalWeb Techs., LLC*, IPR2014-00057, Paper 16, at 6 (PTAB Apr. 30, 2014). In other words, the Petitioner had anticipated the issue and addressed it in the petition and accompanying expert declarations. Here, Patent Owner raised a claim construction issue in its POPR that Petitioner did not anticipate.

Patent Owner argues that Petitioner *should have* anticipated the issue and is using a “wait-and-see” approach or deliberately using “a two-stage process.” (Opp. 8-9, 3.) Incorrect. As explained in Petitioner’s motion, Petitioner did not anticipate and should not have been expected to anticipate that Patent Owner would argue that the definition for “Software Application” (capitalized) would be applied to

“software application” (lower case). (Mot. 4-5.) Patent Owner suggests that Petitioner will be able to address this claim construction issue in its Reply (Opp. 2, 4, 13) and that is true, but Patent Owner has not conceded that Petitioner will be able to make in its Reply an argument based on the contingent testimony in paragraph 11 of the declaration (i.e., that even if Patent Owner’s construction is correct, the claims are still obvious based on the statutory grounds identified in the petition). Thus, Petitioner asks to submit the contingent testimony now.

Notably, the opposition does not dispute the proposition repeatedly advanced in Petitioner’s motion that “allowing this testimony does not change the statutory grounds presented in the petition.” (Mot. 5, 7, 8.) Nor does the opposition dispute the oft-stated proposition that allowing the Supplemental Declaration now will allow Patent Owner to have “the opportunity to provide testimony from its own expert witness in response to [Dr. Shamos’s] testimony as part of its Patent Owner Response.” (Mot. 6, 7, 9, 13, 15.) Thus, it appears that Patent Owner’s reason for opposing this motion is to attempt to preclude Petitioner from *ever* making the contingent obviousness argument. The outcome of this proceeding should not turn on whether Petitioner was able to anticipate in its petition every argument Patent Owner might make. Petitioner should be able to submit the contingent testimony now in the absence of any confirmation that it will be allowed with the Reply. The Board must allow “rebuttal evidence...as may be

required for a full and true disclosure of the facts.” 5 U.S.C. § 556(d).

B. Paragraphs 12-13. With respect to paragraphs 12-13, Patent Owner argues that Petitioner “should have anticipated” that Patent Owner would argue that the claimed “software application” could not be a browser but must be a dedicated application. (Opp. 10.) But for all the reasons that argument was rejected in the Institution Decision, it should not have been anticipated. Once again, it appears that Patent Owner’s motivation is to preclude Petitioner from ever making a contingent argument (i.e., that even if the “software application” must be a dedicated application, there is still obviousness based on the statutory grounds identified in the petition). For all the reasons the contingent testimony in paragraph 11 should be allowed, the contingent testimony in paragraph 13 should be allowed.

C. Paragraphs 18-19. With respect to paragraphs 18-19, Patent Owner argues that “Triller cannot possibly show ‘why the supplemental information could not have been filed with the Petition’” because Petitioner asserted inherency in the Petition. (Opp. 12.) But the relevant inquiry is not whether the supplemental information “could not have been filed” but whether it “*reasonably* could not have been submitted” or whether Petitioner “should not have been expected to anticipate” Patent Owner’s arguments. *Med-El Elektromedizinische Gerate v. Advanced Bionics AG*, IPR2020-00190, Paper 24 at 5 (PTAB Aug. 10, 2020); *Redline*, 811 F.3d at 443. In any event, Petitioner could not have filed this

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