UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE WALT DISNEY COMPANY, DISNEY STREAMING SERVICES LLC, HULU LLC, AND NETFLIX INC.,

Petitioners

v.

WAG ACQUISITION, LLC

Patent Owner

U.S. Pat. No. 9,762,636

Inter Partes Review Case No. IPR2022-01227

PATENT OWNER'S SUR-REPLY

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LIST OF PATENT OWNER'S EXHIBITS

Exhibit	Description
2001	*WAG Acquisition, LLC v. WebPower, Inc.*, 781 F. App'x 1007 (Fed. Cir. 2019)
2002	IETF RFC 1945
2003	Declaration of Henry Houh, Ph.D. Regarding Claims 1-17 of U.S. Patent No. 9,729,594, IPR2022-01346, Exhibit 1002
2004	IETF RFC 2068
2005	April 10, 2023, Remote Deposition of Henry Houh, IPR2022-01227-28
2006	Declaration of W. Leo Hoarty
2007	IETF RFC 1738
2008	Redline comparison of claims of '824 and '636 patents
2009	April 10, 2023, (First) Remote Deposition of Henry Houh, IPR2022—01227-28
2010	August 21, 2023, (Second) Remote Deposition of Henry Houh, IPR2022—1227-28

I. INTRODUCTION

As noted in the POR, Petitioner has not shown where Carmel (EX1004), on which it principally relies, discloses a client that makes successive individual requests to the server for each of the media data elements that comprise a program stream. Nor does the Reply point to any such identified evidence it claims the POR overlooked. In short, the record herein points to no express disclosure in Carmel of any such individual requests.

In instituting review, the Board cited the fact that Petitioner's expert said that such individual requests were "inherent when using the HTTP protocol to download each of the slice files," noting that "[a]t this stage of the proceeding, Patent Owner does not introduce rebuttal testimony." Inst. Dec. at 44.

That situation has now changed. Patent Owner's expert has appeared and rebutted the assertion of inherency.

The Reply (*e.g.*, Reply-1:16-18) refers over and over again to what it asserts is "Carmel's repeated disclosure of the client requesting each slice by identifier," yet never cites anything in Carmel that says this. The most Petitioner ever does is merely to characterize what is shown in Figs. 6A and 6B of Carmel and then, as illustrated on page 19 of the Reply, segue into referring to this as "express disclosure." It is a piecewise bootstrap argument, which leaps from an insufficient

disclosure to a characterization, which then labels the characterization as "express disclosure" for the remainder of the submission.

Nowhere in Carmel, from beginning to end, is there express disclosure of individual element requests that Petitioner has attributed to it. Rather, the case here rests entirely on alleged inherent disclosure.

Inherency fails as well because inherency implies necessity. *Persion Pharmaceuticals v. Alvogen Malta Oper.*, 945 F.3d 1184, 1191 (Fed. Cir. 2019). Under the evidence of record, Petitioner fails to make a showing, as to any embodiment disclosed in Carmel, that Carmel must, as a matter of technical necessity, implement streaming by means of successive individual requests for each of the stream elements.

The above-noted lack of individual element requests in Carmel is an overarching shortcoming of the Petition. Numerous other shortcomings of Carmel will be addressed herein as well.

Reply-1:19-20 asserts that, as to the secondary reference, Shteyn, PO argues contrary to Shteyn's "express disclosure." However, all the Petition seeks to rely on Shteyn for is the server's selection of elements to send, allegedly without depending on its own record of what it has previously sent. Petitioner claims there is express disclosure for this, but as discussed below, has failed to substantiate any such disclosure.

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