UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE WALT DISNEY COMPANY, DISNEY STREAMING SERVICES LLC,
and HULU LLC,
Petitioners

v.

WAG ACQUISITION, LLC
Patent Owner

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

Inter Partes Review Case No. IPR2022-01227

PATENT OWNER PRELIMINARY RESPONSE

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I. INTRODUCTION

Patent Owner takes the opportunity of this Preliminary Response to point out why the Petition fails to provide a sufficient basis under which the Board could find any claim of U.S Patent No. 9,762,636 (the "'636 patent") to be unpatentable.

Any case for invalidity must be made, in the first instance, in the Petition. Applicable law specifies that it is Petitioners who must specify "[h]ow the challenged claim is to be construed" and "[h]ow the construed claim is unpatentable," including "specify[ing] where each element of the claim is found in the prior art patents or printed publications relied upon." 35 U.S.C. § 312(a)(3); 37 CFR § 42.104(b)(3)-(4). "[I]t is Petitioner's burden to establish, in the Petition, a reasonable likelihood of success, which includes, inter alia, explaining how a challenged claim is construed and how the prior art teaches that claim." *World Bottling Cap, LLC v. Crown Packaging Tech., Inc.*, Case IPR2015-00296, Paper 8 at 5 (P.T.A.B. May 27, 2015) (denying rehearing). *See also Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify "with particularity … the evidence that supports the grounds for the challenge to each claim")).

Fundamentally, the Petition heavily relies on a reference, Carmel *et al.*, U.S. Patent No. 6,389,473, Ex. 1004 ("Carmel"), which was the focal point of prior IPR proceedings with regard to other patents owned by Patent Owner. Carmel, and the

prior Board institution decision based on Carmel (on U.S. Patent Nos. 8,122,141 (the "'141 patent")), were before the Examiner, as reflected on the front page of the '636 patent. However, the claims to which Carmel was applied in the prior IPR proceedings lacked a number of explicit limitations incorporated in the claims addressed herein.[1] The Petition seeks to gloss over the additional limitations that are incorporated in the present claims, failing to provide any reference or combination of references that address all of those limitations. It fails as well to provide a sufficient basis on which the Board could find the additional claim features obvious, based on the foundation of the present Petition, whether now or as a result of anything that might reasonably be expected to develop as a result of institution.

This submission addresses only the issue of institution of trial. Should a trial be instituted, Patent Owner reserves any and all arguments not expressly addressed herein.

[1] The patents challenged in the current round of IPRs all issued in 2017, well after the filing of the prior round of IPRs (which (other than joinder petitions) was in 2015 and 2016).

Context of this Petition

In this and two other now-pending IPRs, the present Petitioners challenge three patents that have been asserted against them in parallel litigation: (i) the '636 patent (Ex. 1001), (ii) U.S. Patent No. 9,742,824 (the "'824 patent") (*see* IPR2022-01228), and (iii) U.S. Patent No. 9,729,594 (the "'594 patent") (*see* IPR2022-01346).

All three of these patents address a particular embodiment disclosed in the common specification underlying the three patents. That disclosure is of an internet streaming media mechanism – wherein (among other required specified aspects and limitations) the stream consists of serialized, time-sequenced elements of an audio or video program, and the elements are served to one or more clients over the internet, in each case responsive to specific requests for the elements that originate from the respective client devices. The express claim limitations, taken together, recite a transmission of the respective elements comprising the stream that is driven, from beginning to end, by client requests for specified elements, and thus the claimed streaming process may be thought of as a "pull." These requests, each made by the client, are timed as the client determines to be necessary in order to keep its incoming media buffer at a sufficient level of fill to sustain continuous playback, despite variations in connection quality over the course of the transmission.

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