UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Google LLC,
Petitioner,

v.

WAG Acquisition, L.L.C.,
Patent Owner.

IPR2022-01413

U.S. Patent No. 9,762,636 B2

PETITIONER'S RESPONSE TO PATENT OWNER'S BRIEF REGARDING RELEVANCE OF DECISION ON APPEAL IN *EX PARTE WAG ACQUISITION*, APPEAL 2023-003319 (WAG '141 Patent)

In its Brief in Support of Relevance of Decision on Appeal in *Ex Parte WAG Acquisition*, Appeal 2023-003319 (Paper No. 27 ("Brief")), Patent Owner WAG Acquisition, LLC ("PO") admits that the Decision on Appeal in Appeal 2023-003319 (Exhibit 2017 ("'319 Reexam Decision")) is distinguishable because "it concerned different claim language." (Brief at 1.) This is not the only reason that the '319 Reexam Decision is not relevant or persuasive to the analysis here. As an initial matter, the '319 Reexam Decision cannot be used against Google because Google was not a party to Appeal 2023-003319 and did not have an opportunity to present evidence or argument in that appeal or the underlying proceedings. *Comair Rotron, Inc. v. Nippon Densan, Corp.*, 49 F.3d 1535, 1537 (Fed. Cir. 1995) (party asserting estoppel "must show that in the prior action the party against whom estoppel is sought had a full and fair opportunity to litigate the issue").

Most critically though, the Board's '319 Reexam Decision was narrowly focused on a specific argument that differs from the arguments regarding the Carmel prior art reference (Exhibit 1003) in this IPR. In particular, there the Board found that the quality level assessment "diamond boxes" in Figure 6B of Carmel do not meet the "providing a server programmed to receive requests from the user…". (*See* '319 Reexam Decision at 6, 8-9; Exhibit 1117 at 25-27 (summarizing the panel's understanding of the argument at issue).) The Board found that the examiner did not sufficiently "demonstrate[] that such changes in quality in **Figure 6B**" (the

"diamond boxes") "are correlated to symbols J, J+1, J+2, . . . N for bar 56," as depicted in **Figure 3C** of Carmel and as required by claim 1 of the '141 patent. ('319 Reexam Decision at 8-9 (emphasis added).) The paragraph PO cites from the '319 Reexam Decision is thus in the context of analyzing only specific portions of those figures from Carmel. (*Id.* at 9.) The '319 Reexam Decision does not include any analysis of any other figures, including Figures 6A and 3A, of Carmel. (*See generally id.*)

Here, Google's Petition (Paper No. 1 ("Petition")) focuses on different figures and different aspects of those figures. In particular, Google has presented evidence explaining why the looping nature of Figure 6A of Carmel discloses claim limitation 1[c] of the '636 patent, reciting "receiving requests at the server system via one or more data connections over the Internet, for one or more of the media data elements stored in the data structure[.]" (*See, e.g.*, Petition at 28-29 ("in both options, Carmel Figure 6A confirms this process is repeated for each slice"), 30-31, 40-43; Reply to Patent Owner's Response (Paper No. 13 ("Reply")) at 10-18.) Google has further explained how, contrary to PO's assertions, Carmel discloses a client-controlled system where "[p]referably, each segment or slice is contained in a separate, respective file," such as in Figure 3A, and slices are requested each loop in order to support requesting separate files on separate links as shown in Figure 6A. (Reply at

12-13 (quoting Carmel, 2:22-23); Petition at 12, 19-20.) Nothing in the '319 Reexam Decision contradicts or even relates to these issues.

Google does not rely on the "diamond boxes" of Figures 6B (*see* Exhibit 1117 at 25:11-24), nor has Google limited its arguments to Figures 3C and 6B, to disclose the limitations of the '636 patent in this IPR. Instead, Google has presented different arguments and different evidence that were not at issue in the '319 Reexam Decision. As such, the Board's reasoning in the '319 Reexam Decision—reviewing different figures and disclosures of Carmel against different claim language—is not relevant to the analysis here.

For at least these reasons, the Board in this IPR should give the '319 Reexam Decision little to no weight.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§42.6(e)(4)(i) et seq., a complete copy of the attached **PETITIONER'S RESPONSE TO PATENT OWNER'S BRIEF REGARDING RELEVANCE OF DECISION ON APPEAL IN *EX PARTE WAG ACQUISITION*, APPEAL 2023-003319 (WAG '141 Patent)** is being served via email on the 21st day of December 2023, upon Patent Owner's appointed attorneys of record:

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