

UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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GOOGLE LLC,  
Petitioner

v.

WAG ACQUISITION, LLC  
Patent Owner

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

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*Inter Partes* Review Case No. IPR2022-01413

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**PATENT OWNER PRELIMINARY RESPONSE**

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## I. INTRODUCTION

Petitioner has challenged the validity of U.S. Patent No. 9,762,636 (the “’636 patent”). Patent Owner WAG Acquisition, L.L.C. (“Patent Owner”) opposes institution.

Any case for invalidity must be made, in the first instance, in the Petition. If the Petition does not show a reasonable likelihood that the Petitioner would prevail as to at least one of the claims challenged, institution should be denied.

The Petition heavily relies on a reference, Carmel *et al.*, U.S. Patent No. 6,389,473, Ex. 1003 (“Carmel”), which was the focal point of prior IPR proceedings with regard to other family patents owned by Patent Owner. Carmel, and the prior Board institution decision in IPR2016-01238 (on U.S. Patent Nos. 8,122,141 (the “’141 patent”)) based on Carmel, were before the Examiner, as reflected on the front page of the ’636 patent. However, the claims to which Carmel was applied against the ’141 patent in the prior IPR proceedings lacked a number of explicit limitations incorporated in the claims of the ’636 patent addressed herein.<sup>1</sup> The Petition fails to provide any reference or combination of

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<sup>1</sup> 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).

references that disclose all of those further limitations introduced in the '636 claims. It fails as well to provide a sufficient rationale for combining Carmel with the other cited references (Grounds 2-4). These failures cannot be corrected by anything that might reasonably be expected to develop as a result of institution.

### **Summary of Patent Owner's argument<sup>2</sup>**

To set the stage for the argument that follows, Patent Owner submits, in summary, first, that Carmel fails to disclose limitation 1[d(i)] (“the data connection between the server system and each requesting user system has a data rate more rapid than the playback rate of the one or more media data elements sent via that connection”). Further, and as set forth in more detail below, since Carmel relies upon a “push” methodology, Carmel fails to disclose the combination of limitations 1[c] (“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

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<sup>2</sup> Each of the referenced limitations exist in independent claim 1 (method claim) as well as in claims 5 (system claim) and 9 (computer-recorded medium claim).

Unless otherwise stated, the arguments herein, expressly referring to claim 1, are intended to apply in all three contexts. The deficiencies in the Petition thus noted with respect to the independent claims apply with respect to the dependent claims as well.

the data structure”), 1[c(i)] (“each received request specifying one or more serial identifiers of the requested one or more media data elements”), 1[c(ii)] (“each received request originating from a requesting user system of a plurality of user systems”), 1[d] (“responsive to the requests, sending, by the server system, the one or more media data elements having the one or more specified serial identifiers, to the requesting user systems corresponding to the requests”), 1[d(iii)] (“the one or more media data elements sent are selected without depending on the server system maintaining a record of the last media data element sent to the requesting user systems”), and 1[d(iv)] (“all of the media data elements that are sent by the server system to the plurality of user systems are sent in response to the requests”).

Carmel certainly does not disclose limitation 1[d(i)], as Carmel contemplates, and the entire Carmel system is designed to account for, situations in which the data connection has a data rate *slower* than the playback rate.

Additionally, the plain language of limitations 1[c]-1[c(ii)], 1[d], 1[d(iii)], and 1[d(iv)] collectively make clear that the independent claims are directed to a server that transmits an entire stream via serial requests, in which the server receives a plurality of requests for media data elements from the client, each media data element being specified by a serial identifier, and the server responds by sending the corresponding media data elements, in which all such media data elements sent to the client are sent in response to such requests, and the server has

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