UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC., AMAZON WEB SERVICES, INC.,
AND AMAZON.COM SERVICES LLC,
Petitioners

v.

WAG ACQUISITION, LLC
Patent Owner

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

Inter Partes Review Case No. IPR2022-01433

PATENT OWNER PRELIMINARY RESPONSE

TABLE OF CONTENTS

I. INTRODUCTION

Petitioners have 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 Petitioners 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. 1005 ("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.[1] The Petition fails to provide any reference or combination of

[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).

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. 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

To set the stage for the argument that follows, Patent Owner submits, in summary, first, that neither Carmel nor Ex. 1031 (“Feig”) discloses limitation [h] (“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”).

Carmel certainly does not disclose limitation [h], 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.

Even if the Board were to find even a provisional basis to accept that Feig might be shown to disclose limitation [h] and thereby overcome the deficiency of Carmel in this regard (although Patent Owner would submit that the disclosure of Feig does not meet this threshold), the Petition also fails to provide a sufficient rationale for combining Feig with Carmel as to limitation [h] (and as next addressed, limitation [k] as well).

To the extent Petitioners would rely on Carmel alone for obviousness of modifying its teachings with respect to limitation [h], the proposed modification to Carmel would require additional changes to Carmel, which the Petition fails to address.

Second, Carmel, relying upon a "push" streaming methodology (as will be addressed herein), does not disclose limitation [k] ("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"). To the extent Petitioners rely on Feig to overcome this shortcoming of Carmel, they likewise fail to provide a suitable rationale to combine, insofar as the Petition merely repeats the same inadequate rationale it provided for limitation [h].

For these and the other reasons set forth herein, Patent Owner respectfully submits that the Petition is inadequate to trigger institution.

II. LEGAL STANDARDS FOR INSTITUTION

Institution requires "a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). In the first instance, this showing must be made *in the Petition*. *See* 35 U.S.C. § 312(a) ("A petition filed under section 311 may be considered only if … (3) *the petition* identifies, in writing and with particularity … the grounds on which

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.