Trials@uspto.gov
571-272-7822

Paper No. 39
Entered: January 17, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SLING TV, L.L.C., SLING MEDIA, L.L.C., DISH NETWORK L.L.C., DISH TECHNOLOGIES L.L.C., and ARRIS SOLUTIONS, INC.,
Petitioner,

v.

REALTIME ADAPTIVE STREAMING, LLC,
Patent Owner.

IPR2018-01331[1]
Patent 8,867,610 B2

Before KEVIN W. CHERRY, GARTH D. BAER, and NABEEL U. KHAN, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*.

ORDER
Granting Patent Owner's Motion to Terminate
37 C.F.R. § 42.5(a)

[1] ARRIS Solutions, Inc., who filed a petition in IPR2019-00746 has been joined a petitioner in this proceeding.

On September 6, 2019, we authorized Patent Owner Realtime Adaptive Streaming, LLC ("Realtime Adaptive Streaming" or "Patent Owner") to file a motion to terminate this proceeding in view of the Precedential Opinion Panel's[2] recent decision in *GoPro, Inc. v. 360Heros, Inc.*, IPR2018-01754, Paper 38 (Aug. 23, 2019) (precedential). *See* Paper 24. Patent Owner filed its Motion to Terminate (Paper 27, "Motion" or "Mot.") on September 16, 2019. Petitioner Sling TV, Sling Media, Dish Network, Dish Technologies (collectively, "Sling") filed an opposition (Paper 28, "Sling Opposition" or "Sling Opp."). Joined party ARRIS Solutions, Inc. also filed a joint opposition to the Motion (Paper 29, "Joined Opposition" or "Joined Opp."). Patent Owner filed a reply. Paper 30 ("Reply").

For the following reasons, we grant Patent Owner's Motion and terminate this proceeding.

I. INTRODUCTION

A. BACKGROUND

On June 6, 2017, Realtime Data LLC ("Realtime Data") filed and subsequently served an amended complaint in the Eastern District of Texas naming Petitioner and alleging infringement of the '610 patent. Prelim. Resp. 2 (citing *Realtime Data LLC v. EchoStar Corp.*, No. 6:17-cv-00084-RWS-JDL). When Realtime Data filed its complaint, however, it did not own the '610 patent, because it had previously recorded an assignment to Realtime Adaptive Streaming on March 7, 2017. *See* Ex. 1023. Realtime

[2] *See* PTAB Standard Operating Procedure 2 (Revision 10) (Sept. 20, 2018) ("SOP2").

Data thus voluntarily dismissed the complaint without prejudice, and on October 10, 2017, Realtime Adaptive Streaming filed a complaint again naming Petitioner and alleging infringement of the '610 patent. Reply 2. Less than one year later, on July 3, 2018, Petitioner filed its Petition in this case. *See* Petition ("Pet.") 79.

In its Preliminary Response, Patent Owner argued that we should not institute review because the Petition was barred under 35 U.S.C. § 315(b). Paper 6. We allowed Sling to file a reply on this issue (Paper 7), and Patent Owner to file a Sur-Reply (Paper 8).

On January 31, 2019, we instituted this proceeding. *See* Paper 9 ("Decision on Institution" or "Dec. on Inst."). We determined that Sling had demonstrated a reasonable likelihood of prevailing on at least one challenged claim, and that the Petition was not barred under 35 U.S.C. § 315(b) because Realtime Data did not own the '610 patent when it served a complaint alleging infringement of the '610 patent on Sling. *See id.* at 5–13. In particular, we construed 35 U.S.C. § 315(b) based on the statute's heading—"Patent Owner's Action"—to require that the party serving the complaint had to be the owner of the patent. *See id.* at 6–7.

On February 27, 2019, ARRIS Solutions, Inc. ("ARRIS") filed a petition in IPR2019-00746 challenging the '610 patent. *See* IPR2019-00746, Paper 2 ("ARRIS Petition"). ARRIS's petition was accompanied by a motion for joinder to this proceeding. *See* IPR2019-00746, Paper 3 ("ARRIS Joinder"). Patent Owner did not file a preliminary response. On August 8, 2019, we instituted *inter partes* review and joined ARRIS as a party to this proceeding. *See* Paper 22 (IPR2019-00746 Institution Decision) ("746 Inst. Dec."). ARRIS had been sued for infringement of the '610

patent in the same June 6, 2017 case as Sling. Ex. 2001, 1, 58. ARRIS was served with a complaint on June 12, 2017. Ex. 2014.

B. LEGAL STANDARD

Section 315(b) provides that "an inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest or privy of the petitioner is served with a complaint alleging infringement of the patent." 35 U.S.C. § 315(b) (2018). The Federal Circuit recently held that "[35 U.S.C.] § 315(b)'s time bar is implicated once a party receives notice through official delivery of a complaint in a civil action, irrespective of subsequent events." *Click-to-Call Techs. v. Ingenio, Inc.*, 899 F.3d 1321, 1330 (Fed. Cir. 2018) ("*Click-to-Call*"). According to the Federal Circuit, "the plain meaning of the phrase 'served with a complaint' is 'presented with a complaint' or 'delivered a complaint' in a manner prescribed by law." *Click-to-Call*, 899 F.3d at 1330. Moreover, "Congress chose the date of service, as opposed to some other event, as the trigger for § 315(b)'s time bar because service of a complaint is the seminal notice-conferring event in a district court action." *Id.* at 1332.

The Precedential Opinion Panel has determined that "[t]he service of a pleading asserting a claim alleging infringement, including where the serving party lacks standing to sue or the pleading is otherwise deficient, triggers the one-year time period for a petitioner to file a petition under 35 U.S.C. § 315(b)." *GoPro*, Paper 38, at 24.

II. ANALYSIS

A. SLING

Patent Owner submits that it is undisputed that Sling was served with a complaint more than one year before the filing date of the Petition. Mot. 1. Patent Owner further submits that, even though Realtime Data did not own the '610 patent, *GoPro* holds that § 315(b) still bars the Petition and this proceeding should be dismissed. *Id.* at 1–6.

Sling raises several arguments why the case should not be terminated with respect to them. Sling Opp. 2–5. Sling argues that SOP2 "commands that precedential Board decisions are 'binding Board authority in ***subsequent matters*** involving similar facts or issues.'" *Id.* at 2. Because *GoPro* issued after this proceeding was instituted, Sling argues that *GoPro* is not binding under SOP2. *Id.*

We disagree with Sling. This Motion to Terminate is just such a "subsequent matter," even if the original Petition is not. But we need not resolve the exact contours of SOP2 because we have "inherent authority to reconsider [our] decisions," regardless of whether Patent Owner filed a request for rehearing. *Medtronic, Inc. v. Robert Bosch Healthcare Sys., Inc.*, 839 F.3d 1382, 1386 (Fed. Cir. 2016). Here, although we disagree with Sling's contention that *GoPro* is not binding, we find *GoPro's* reasoning persuasive, regardless of whether *GoPro* is binding in this case under SOP2, and apply it to reconsider our Decision to Institute. As *GoPro* explained, *Click-to-Call* held that § 315(b) is unambiguous, and, given that the statute is unambiguous, our resort, in our Decision to Institute, to the statute's heading—"Patent Owner's Action"—to interpret the statute was a clear legal error. *See GoPro*, Paper 38, at 10. For the reasons explained in detail in

GoPro, we agree with Patent Owner that our construction of § 315(b) to require that the complaint be served by the owner of the patent was incorrect. *See id.* at 9–24.

Sling further argues that the law-of-the-case doctrine bars our reconsideration. Sling Opp. 5. The law-of-the-case doctrine does not apply if "one of three 'exceptional circumstances' exists: 'the evidence on a subsequent trial was substantially different, controlling authority has since made a contrary decision of the law applicable to such issues, or the decision was clearly erroneous and would work a manifest injustice.'" *Smith Int'l, Inc. v. Hughes Tool Co.*, 759 F.2d 1572, 1576 (Fed. Cir. 1985). In addition to being subject to a later contrary decision of the law by a controlling authority, we determine that, as explained in *GoPro*, our reliance on the statute's heading was a clear error in view of *Click-to-Call's* determination that the statute was unambiguous. Moreover, we determine that allowing Sling to remain in this proceeding despite the statutory bar would be unjust. Thus, even if *GoPro* were not binding authority, given our decision was clearly erroneous and would work a manifest injustice, we disagree with Sling that the law-of-the-case doctrine bars reconsidering our Decision to Institute.

Sling also argues that, to the extent its decisions are binding, the Precedential Opinion Panel violates the Administrative Procedures Act. Sling Opp. 6–7. Although we disagree, we need not reach the question[3],

[3] As Sling acknowledges, the issue of whether the Precedential Opinion Panel violates the Administrative Procedures Act is currently pending before the Federal Circuit in *Facebook, Inc., v. Windy City Innovs., LLC*, No. 18-1400 (Fed. Cir. Aug. 7, 2019). *See* Sling Opp. 6–7. As such, we do not analyze the issue in detail.

because, as we explained above, regardless of whether *GoPro* is binding in this particular case, we find its reasoning persuasive that we committed legal error in our construction of § 315(b) in light of the Federal Circuit's decision in *Click-to-Call* that § 315(b)'s time bar is implicated once a party receives notice through official delivery of a complaint in a civil action, irrespective of subsequent events. *See Click-to-Call*, 899 F.3d at 1330. Thus, Sling's arguments that the Precedential Opinion Panel violates the APA are irrelevant in this case.[4]

Finally, Sling argues that it would be unfair to apply *GoPro* to Sling in this case. Sling Opp. 7–8.[5] We disagree. As we explained, § 315(b) bars Sling from seeking *inter partes* review. We have no discretion to maintain Sling as a Petitioner in this proceeding given the clear statutory command. Thus, the question of fairness does not persuade us otherwise.

Having determined that, under the proper construction of the statute, the service of a pleading alleging infringement, even where the serving party lacks standing to sue or the pleading is otherwise deficient, triggers the one-year time period for a petitioner to file a petition under 35 U.S.C. § 315(b), and having determined that Sling did not file a petition during this one year period, we grant Patent Owner's motion to terminate with respect to Sling.

B. ARRIS

Patent Owner also seeks to terminate this proceeding with respect to joined Petitioner ARRIS. Mot. 8–10; Reply 6–9. Patent Owner asserts that

[4] Sling also argues that the Precedential Opinion Panel violates its due process rights under the Fifth Amendment to the U.S. Constitution. *See* Sling Opp. 7. However, this argument is not developed in any way, so we do not find it persuasive.

[5] The Sling petitioners refer to themselves collectively as "DISH."

if we vacate our earlier institution decision and terminate the IPR with respect to Sling, we should also terminate the proceeding with respect to ARRIS because "ARRIS was accused of infringing the '610 patent in the same complaint as the Sling petitioners," and "ARRIS should not be permitted to circumvent its time-bar by way of joinder, transmuting two time-barred petitions into one timely petition." Mot. 8, 10.

We agree with Patent Owner. ARRIS's petition was time barred, both at the time of Sling's petition and at the time of its own joinder petition. *See* Ex. 2014 (showing ARRIS was served with a complaint asserting infringement on June 12, 2017); Pet. 79 (Sling's Petition dated July 3, 2018), IPR2019-00746, Papers 2, 3 (ARRIS's petition and motion for joinder both dated February 27, 2019). We decline to permit ARRIS to circumvent the time bar by way of joinder. Although, as Petitioner ARRIS notes, the 1 year time bar under 35 U.S.C. § 315(b) does not apply to a request for joinder, under the proper construction of § 315(b), Sling's petition was time barred. We decline to excuse ARRIS's late Petition because had we denied Sling's Petition as time barred under 315(b)—as we should have under the reasoning in *GoPro*—there would have been no instituted proceeding to join.[6]

In addition to the arguments above, ARRIS asserts that Patent Owner waived its objection by failing to contest joinder. Joined Opp. 2–4. We

[6] In IPR2018-01342, we permitted a proceeding to continue with joined Petitioners Google and Comcast after terminating original petitioner Sling. *See* IPR2018-01342, Paper 45, 12. We did so because Google and Comcast had filed their petitions before the one-year deadline. *See id*. That is not the case here for ARRIS, which filed its petition after the one-year deadline for doing so.

decline, however, to fault Patent Owner for not raising the same time bar argument—this time opposing joinder—that we had just addressed and rejected in instituting Sling's Petition in this case. In addition, as Patent Owner notes, it "expressly reserved all rights concerning the time-bar issue, as stated in ARRIS's joinder motion itself." Reply 7 (citing IPR2019-00746 Paper 3, 9). Under these circumstances, we decline to hold that Patent Owner waived any objection to proceeding with *inter partes* review based on ARRIS's Petition.

III. CONCLUSION

In conclusion, we agree with Patent Owner that this proceeding should be terminated based on *GoPro, Inc. v. 360Heros, Inc.*, IPR2018-01754, Paper 38 (Aug. 23, 2019) (precedential).

IV. ORDER

It is ORDERED that Patent Owner's Motion to Terminate is *granted.*

For PETITIONER:

Ruffin Cordell
Adam Schartzer
Brian Livedalen
FISH & RICHARDSON P.C.
cordell@fr.com
shartzer@fr.com
bvl@fr.com

For PATENT OWNER:

Philip Wang
Kent Shum
Neil Rubin
Reza Mirzaie
C. Jay Chung
RUSS AUGUST & KABAT
pwang@raklaw.com
kshum@raklaw.com
nrubin@raklaw.com
rmirzaie@raklaw.com
jchung@raklaw.com