

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC. and HULU, LLC,
Petitioner,

v.

DIVX, LLC,
Patent Owner.

IPR2020-00558
Patent 10,225,588 B2

Before KEVIN F. TURNER, BART A. GERSTENBLITH, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

ORDER

Revising Due Dates 3 and 5–7
Granting the Parties' Requests to File Supplemental Information

A conference call in IPR2020-00558 occurred on April 15, 2021. Respective counsel for Petitioner and Patent Owner and Judges Turner, Gerstenblith, and Ahmed were in attendance. Petitioner arranged for a court reporter to be on the conference call and agreed to provide a transcript of the call once it is reviewed. Petitioner requested the conference call, seeking authorization to file supplemental information pursuant to 37 C.F.R. § 42.123, namely a deposition transcript, already of record in IPR2020-00646. Petitioner asserts that the transcript contains testimony that contradicts positions that Patent Owner has taken in this proceeding, which Patent Owner denies.

On the conference call, Petitioner argued that positions taken by Patent Owner's declarant in IPR2020-00646, Dr. Chandrajit Bajaj, during his deposition (Ex. 1022) as a part of that proceeding, contradicted positions taken by Patent Owner in the instant proceeding, where the patents in each proceeding are commonly owned. Petitioner explained that the deposition occurred after Petitioner filed its Reply (Paper 29) in this proceeding and, thus, Petitioner could not have filed the transcript with its Reply. Patent Owner argued that its positions were not contradictory, and that allowing Petitioner to file the deposition transcript would prejudice Patent Owner by requiring it to argue additional issues at oral hearing or in its motion to exclude. In the event we allow the filing of the deposition transcript in this proceeding, Patent Owner requested that Dr. Bajaj's declaration (Ex. 2005) from the IPR2020-00646 proceeding also be made of record in this proceeding to provide context.

The panel conferred and determined that the information could not have been submitted by Petitioner previously and consideration of the

supplemental information would be in the interests-of-justice. The panel agreed to authorize the filing of supplemental information in this proceeding, namely Exhibits 1022 and 2005 from IPR2020-00646, where those documents may be filed in this proceeding by Petitioner and Patent Owner, respectively. No additional documents or arguments are to be presented with the supplemental information. Further, the panel agreed to extend the remaining Due Dates in this proceeding, with the exception of Due Date 8, by two days to allow the parties to address the supplemental information, should they choose to address it.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file Exhibit 1022 of IPR2020-00646 in the instant proceeding under 37 C.F.R. § 42.123; no additional documents or arguments are permitted;

FURTHER ORDERED that Patent Owner is authorized to file Exhibit 2005 of IPR2020-00646 in the instant proceeding under 37 C.F.R. § 42.123; no additional documents or arguments are permitted; and

FURTHER ORDERED that the accompanying Due Date Appendix alters Due Dates 3 and 5–7 in the instant proceeding.

A. DUE DATE APPENDIX

DUE DATE 3 April 21, 2021
Patent owner's sur-reply to reply

DUE DATE 5 April 23, 2021
Motion to exclude evidence

DUE DATE 6 April 30, 2021
Opposition to motion to exclude

DUE DATE 7 May 7, 2021
Reply to opposition to motion to exclude
Request for prehearing conference

DUE DATE 8 May 25, 2021
Oral argument (if requested)

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