

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
Conduct of the Proceeding
37 C.F.R. § 42.5

A conference call in *inter partes* review IPR2020-00558, involving U.S. Patent No. 10,225,588 B2 (Ex. 1001, “the ’588 Patent”), occurred on April 26, 2023. Respective counsel for Petitioner and Patent Owner, Harper Batts and Parham Hendifar, respectively, and Judges Turner, Gerstenblith, and Ahmed were in attendance. A court reporter was present on the call, provided by Patent Owner, where Patent Owner agreed to furnish a copy of the transcript of the conference call as an exhibit. The purpose of the call was to discuss briefing in response to the remand by the U.S. Court of Appeals for the Federal Circuit of this case for further proceedings. *See Netflix, Inc. v. DivX, LLC*, No. 22-1083, 2023 WL 2298768 (Fed. Cir. Mar. 1, 2023).

Our reviewing court found that “[t]he Board legally erred in its obviousness analysis,” and that “the Board committed a fundamental legal error in defining the combination it was evaluating as Lindahl with Chen’s ‘system,’ *i.e.*, with the system Chen teaches as its advance over the prior art (its inventive system).” *Id.* at 2, 8. To fulfill such considerations on remand, we request briefing specifically pointing out the issues that must be decided to reach a conclusion on the patentability of the challenged claims of the ’588 Patent, and where those issues were addressed in previous briefings by the parties. The parties elucidated the issues they intend to raise on remand during the conference call, such that each party understands the scope of those issues. Nonetheless, we also will permit responsive briefing to clarify any issues raised by opposing sides.

Each party’s initial brief is limited to twelve (12) pages and is due by May 12, 2023. Thereafter, responsive briefs from either party, if filed, will be

IPR2020-00558
Patent 10,225,588 B2

limited to five (5) pages and be due by May 26, 2023. No new evidence may be proffered in the parties' briefs, including additional references or declarations.

Accordingly, it is

ORDERED that both parties shall file briefs, limited to twelve (12) pages by May 12, 2023, as outlined above;

FURTHER ORDERED that both parties are permitted to file responsive briefs, limited to five (5) pages by May 26, 2023, as outlined above;

FURTHER ORDERED that the parties may not submit additional documentary or declaration evidence in support of the briefs and no additional briefs shall be filed without the Board's authorization; and

FURTHER ORDERED that Patent Owner will file a copy of the court reporter's transcript of the conference call once it is available.

IPR2020-00558
Patent 10,225,588 B2

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