

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKAMAI TECHNOLOGIES, INC.,
Petitioner,

v.

EQUIL IP HOLDINGS LLC,
Patent Owner.

IPR2023-00330
Patent 8,495,242 B2

Before RICHARD M. LEBOVITZ, ROBERT J. WEINSCHENK, and
SHARON FENICK, Administrative Patent Judges.

FENICK, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

Akamai Technologies, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of claim 9 (“the challenged claim”) of U.S. Patent No. 8,495,242 B2 (Ex. 1001, “the ’242 patent”). Equil IP Holdings LLC (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”). After authorization (*see* Ex. 1040) to file additional briefing relating to 35 U.S.C. § 325(d) arguments and issues relating to the correction of inventorship in U.S. Patent No. 6,964,009, Petitioner filed a Preliminary Reply (Paper 12, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 13, “Prelim. Sur-reply”).

An *inter partes* review may be instituted only if “the information presented in the petition . . . and any [preliminary] response . . . shows that there is 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) (2018). For the reasons below, we decline to exercise our discretion to dismiss under 35 U.S.C. §§ 314(a) or 325(d), and determine that Petitioner has established a reasonable likelihood that it would prevail in showing the unpatentability of the challenged claim. Accordingly, we institute an *inter partes* review of the challenged claim on all grounds raised in the Petition.

B. *Real Parties in Interest*

Petitioner and Patent Owner identify only themselves as real parties in interest. Pet. 3; Paper 4 (Patent Owner’s Mandatory Notices), 1.

C. *Related Matters*

Petitioner and Patent Owner each identify as related *Equil IP Holdings LLC v. Akamai Technologies, Inc.*, Case 1-22-cv-00677 (D. Del.) and *inter partes* review petitions IPR2023-00329 and IPR2023-00332. Pet.

3–4; Paper 4, 1. Patent Owner additionally notes that the ’242 patent is related to several patent applications. Paper 4, 1–2.

D. The ’242 Patent

The ’242 patent, titled “Automated Media Delivery System,” describes an automatic graphics delivery system that operates in parallel with an existing Web site infrastructure to provide delivery of media for access by an end user. Ex. 1001, codes (54), (57), 1:18–23. “The system streamlines the post-production process by automating the production of media through content generation procedures controlled by proprietary tags placed within URLs embedded within Web documents. The system automatically processes the URL encoded tags and automatically produces derivative media for the web site from the original media.” *Id.* at 7:8–16.

When a request for the media is received, the client connection, server traffic, content generation procedures, and proprietary tags within the URL are used to generate a version of the media for the client. *Id.* at 7:17–20, 17:27–30. The generated media is cached so that further requests for the same version of the media requires less overhead. *Id.* at 7:22–24, 18:34–40.

In some embodiments, a primary content generation procedure produces a derivative image based on images from an image repository. *Id.* at 18:41–45. A dynamic image content system then may generate a subsequent derivative media from that intermediate derivative image, which may be modified for a specific user browser and then passed to the user. *Id.* at 18:45–51, 18:63–67, 19:48–53. Inputs to the dynamic image content system may be stored in a cache so the intermediate derivative image need not be regenerated. *Id.* at 18:60–63, 19:23–42, 19:66–20:3.

E. Challenged Claim

The sole challenged claim, claim 9, is reproduced below with bracketed identifiers added as used by the Petitioner.

9. A method for accessing dynamically transcoding media content, the method comprising:

[9.a] an act of receiving a request for media content to be delivered to a client presentation system for media content, wherein the requested media content has a limited number of base transcoding profiles associated therewith, each base transcoding profile corresponding to a cached version of the requested media content;

[9.b] at the time of the request, and without input by a network administrator, an act of automatically identifying transcoding parameters to be applied to the requested media content prior to delivery to the client presentation system, wherein identification of transcoding parameters is based on one or more formats of any client presentation system;

[9.c] an act of determining that the transcoding parameters to be applied to the requested media content prior to delivery to the client presentation system are the same as transcoding parameters that are being applied to the requested media content prior to delivery to another client presentation system;

[9.d] an act of transcoding the requested media content in accordance with the identified transcoding parameters, such that the identified transcoding parameters are used to perform additional incremental transcoding on top of the base transcoding profile;

[9.e] wherein the act of act of transcoding the requested media content in accordance with the identified transcoding parameters comprises:

an act of selecting a pre-existing base transcoded version of the requested media content comprising intermediate derivative media that has been transcoded in accordance with only a portion of the identified transcoding parameters; and

[9.f] an act of creating a final version by incrementally performing further transcoding of the pre-existing base transcoded version in accordance with a remaining portion of the identified transcoding parameters; and

[9.g] an act of delivering the transcoded media content to both client presentation systems concurrently.

Ex. 1001, 23:45–24:16.

F. Prior Art and Asserted Grounds

Petitioner raises the following grounds of unpatentability with respect to the challenged claims:

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
9	102	Tso ² , Huang ³
9	102	Samaniego ⁴
9	103	Samaniego
9	103	Samaniego, Tso

Pet. 6.

II. ANALYSIS

A. Legal Standards

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102, 103. Because the filing date for the ’242 patent is before the effective date of the applicable AIA amendment, we refer to the pre-AIA version of these statutes. See Ex. 1001, code (22). Our institution determination would not change under the post-AIA version of these statutes.

² Tso et al., US 6,421,733 B1 (iss. July 16, 2002) (Ex. 1004).

³ Huang et al., US 6,438,576 B1 (iss. Aug. 20, 2002) (Ex. 1005).

⁴ Samaniego et al., US 2002/0078093 A1 (pub. June 20, 2002) (Ex. 1007).

petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–1327 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review). Furthermore, Petitioner must explain with particularity how the prior art would have rendered the challenged claims unpatentable. 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.104(b)(4) (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”).

To establish anticipation, each and every element in a claim, arranged as recited in the claim, must be found in a single prior art reference. *See Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008); *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). Although the elements must be arranged or combined in the same way as in the claim, “the reference need not satisfy an *ipsissimis verbis* test,” i.e., identity of terminology is not required. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009); *accord In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

A claim is unpatentable under 35 U.S.C. § 103 if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art;

(3) the level of skill in the art; and (4) when presented, objective indicia relating to obviousness.⁵ See *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements,” but “must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

B. Level of Ordinary Skill in the Art

Petitioner argues that:

A person of ordinary skill in the art (“POSITA”) as of the ’242’s claimed priority date would have had a bachelor’s degree in computer systems, computer science, or the equivalent thereof, and at least two years of experience with networked media delivery or related technologies. More education can supplement practical experience, and vice-versa.

Pet. 10 (internal citations omitted) (citing Ex. 1003 (Declaration of Dr. Vijay K. Madiseti) ¶¶ 44, 45, 47, 48). Patent Owner applies Petitioner’s proposed level of skill for the purposes of its Preliminary Response. Prelim. Resp. 8.

For purposes of this Decision, we apply Petitioner’s definition of the level of ordinary skill in the art which is consistent with the level of skill

⁵ The record at this point contains no contentions regarding such objective indicia relating to obviousness.

reflected in the Specification and in the asserted prior art references. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

C. Claim Construction

We construe claim terms according to the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–1317 (Fed. Cir. 2005) (en banc), i.e., as construed in a civil action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b). Under *Phillips*, claim terms are afforded “their ordinary and customary meaning.” *Phillips*, 415 F.3d at 1312. “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Id.* at 1313. “Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” *Id.* An inventor may rebut that presumption by providing a definition of the term in the specification “with reasonable clarity, deliberateness, and precision.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). In the absence of such a definition, limitations are not to be read from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Neither Petitioner nor Patent Owner proposes any claim constructions, and we do not determine that any claim constructions are necessary to reach our conclusions in this Decision. Pet. 10–11; Prelim. Resp. 8; *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (requiring construction of “only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy”); *see Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (applying to *inter partes* reviews).

D. Discretion to Deny Institution Under 35 U.S.C. § 325(d)

Institution of *inter partes* review is discretionary. *See Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“the PTO is permitted, but never compelled, to institute an IPR proceeding.”); 35 U.S.C. § 314(a). Pursuant to 35 U.S.C. § 325(d), in determining whether to institute *inter partes* review, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” In evaluating arguments under § 325(d), we use

[a] two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential).

In applying the two-part framework, we consider several non-exclusive factors, including:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art or patent owner distinguishes the prior art;
- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and

(f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph).

Factors (a), (b), and (d) of the *Becton, Dickinson* factors relate to whether the art or arguments presented in the petition are the same or substantially the same as those previously presented to the Office. *Advanced Bionics*, 10. Factors (c), (e), and (f) “relate to whether the petitioner has demonstrated a material error by the Office” in its prior consideration of that art or arguments. *Id.* Only if the same or substantially the same art or arguments were previously presented to the Office do we then consider whether the petitioner has demonstrated a material error by the Office. *Id.* “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

As part of our analysis under the first prong of the *Advanced Bionics* framework, we evaluate *Becton, Dickinson* factors (a), (b), and (d) with respect to the facts of the present proceeding. *Advanced Bionics*, 9–10 n.10 (citing *Becton, Dickinson*, Paper 8 at 17–18).

Patent Owner contends that Tso was the same or substantially the same as art that was before the Examiner during the prosecution of the application that issued as the '242 patent. Prelim. Resp. 23–26; Prelim. Sur-reply 5–6. Patent Owner argues that, while Tso was not cited during prosecution, a substantially identical reference, WO 98/43177 (Ex. 2007, “Tso PCT”), was cited. Prelim. Resp. 24–25; Ex. 2007; Ex. 1002, 176 (information disclosure statement citing Tso PCT (line 58)), 780 (version

with Examiner's initials); Ex. 2008 (redline comparison of Tso and Tso PCT). Petitioner concedes that Tso PCT "has substantially the same disclosures" as Tso. Prelim. Reply 6.

Patent Owner additionally contends that, while Huang was not before the Examiner during prosecution, Huang's teachings are substantially similar to those described in U.S. Patent No. 6,483,851B1 (Ex. 2011, "Neogi"). Prelim. Resp. 26. Patent Owner argues that Neogi describes "partitioning a multimedia transcoding process into distributed intermediate stages and caching the results of each stage in a buffer pool of memory for retrieval by a subsequent processing stage." *Id.* (citing Ex. 2011, 1:14–16, 1:53–60, 2:16–26, 2:52–67, 3:2–4, 3:8–30, 3:60–65). Patent Owner asserts that these disclosures of Neogi are similar to the teachings relied upon in the Petition from Huang. *Id.* (citing Pet. 15–21); Prelim. Sur-reply 7 (equating Huang's storage of a partially rendered object in a cache to Neogi's data pools during stages of the adaptive pipelining). Petitioner contends that Huang's teachings were not considered, as Neogi does not "'further transcoding' a cached 'base transcoded version' of content," but rather teaches "transcoding content in stages" without any discussion of "caching, storing, or incrementally transcoding partially transcoded content." Prelim. Reply 6 (citing Ex. 2011, 1:56–60; 3:18–39). Petitioner argues that the "buffer pooling" described by Neogi is part of a single "adaptive pipeline" and not a cache. *Id.*

As further discussed below in Section II.E, Petitioner uses the disclosures in Huang regarding avoiding re-rendering and re-retrieving content by storing partially-rendered content in a local cache in its arguments regarding obviousness over Tso and Huang. *See* Pet. 16–17, 18–19, 33, 34–35, 37–38 (citing Ex. 1005, 2:9–13 ("any subsequent requests for

the same object . . . can be served directly from the stored copy in proxy server cache”), 6:63–67 (cache manager “maintains a local copy of the partially rendered . . . object in order to avoid repeating some object rendering operations”), 7:23–8:11; Ex. 1003 ¶¶ 67–68, 71, 89–91, 98). But Neogi does not describe caching an object in order to avoid repeating rendering operations upon subsequent requests for the same object. Rather, portions of Neogi cited by Patent Owner describe a pipeline constructed according to control parameters for the user’s request for transcoding, which may include intermediate filtering stages. Ex. 2011, 1:53–60. Neogi’s buffer pools “fulfill the memory requirements of the particular stages of the adaptive pipeline.” *Id.* at 3:2–4. We agree with Petitioner that Patent Owner’s citations to Neogi do not show the description of a cache that stores partially-rendered content in a local cache to allow subsequent requests to avoid re-rendering or re-retrieving content. *See* Prelim. Reply 6.

Thus, we determine that there were material differences between Huang and Neogi, that Huang is not cumulative of Neogi, and that there is a significant difference between Neogi and Huang, considering the manner in which Petitioner uses Huang in its unpatentability arguments. Having thus evaluated *Becton, Dickinson* factors (a), (b), and (d) with respect to the facts of the present proceeding, we determine that the same or substantially the same art or arguments were not presented to the Office previously. Thus, we do not proceed to the second prong of the *Advanced Bionics* framework, and we will not discretionarily deny the Petition under § 325(d).

For the foregoing reasons, we are not persuaded to exercise our discretion to deny institution under 35 U.S.C. § 325(d).

E. Claims 9 – Obviousness over Tso and Huang

Petitioner argues that claim 9 is unpatentable as obvious over a combination of Tso and Huang. Pet. 11–41. Patent Owner presents arguments relating to Petitioner’s showing with respect to claim limitations 9.b and 9.c, that Tso does not teach or suggest these limitations. Prelim. Resp. 29–30, 32–38.

1. Tso

Tso is titled “System for Dynamically Transcoding Data Transmitted Between Computers,” and describes transcoding data exchanged between two computers according to predetermined selection criteria. Ex. 1004, codes (54), (57), 2:8–17. Tso describes that a transcoder, which may be part of a server, is arranged between a network client and the Internet. *Id.* at 3:8–30. Figure 3, reproduced below, is a block diagram depicting an embodiment including network client 12 connected to Internet 18 through an interposed transcoding server 34. *Id.* at 3:21–23.

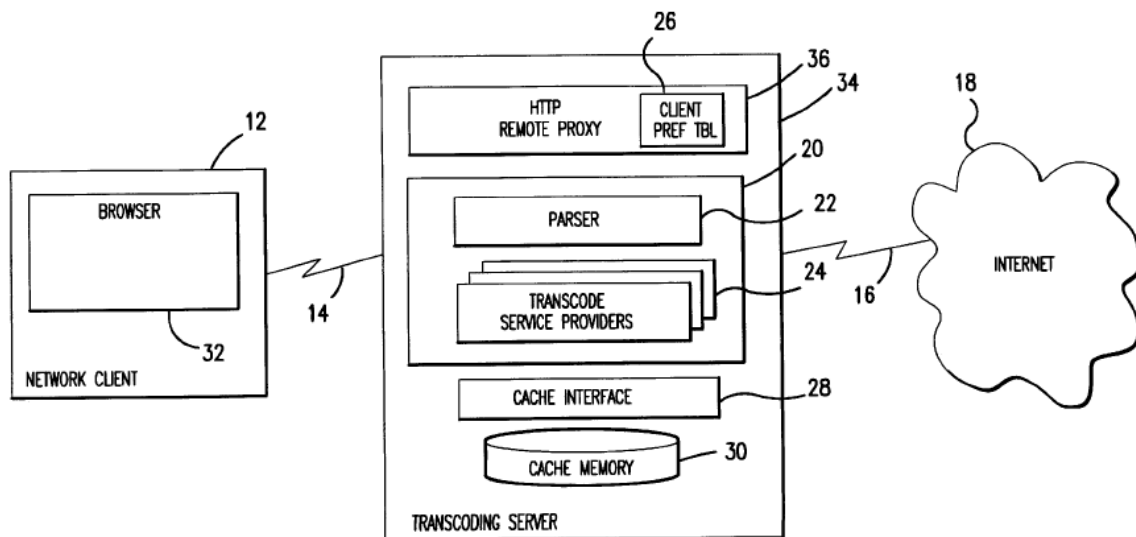


FIG.3

As seen in Figure 3, transcoding server 34 includes a remote proxy 36. *Id.* at 3:31–33. This proxy can access Internet 18 to make requests and receive

replies from external Internet resources, and also to examine and act on the requests and replies, for example by determining whether or not to transcode content. *Id.* at 3:34–40. The transcoding of content received from Internet 18 before it is returned to requesting network client 12 is done by transcoder 20, which includes parser 22 and plurality of transcode service providers 24. *Id.* at 3:8–11, 3:40–43. Parser 22 manages the transcoding of data to be transmitted from transcoding server 34 to network client 12. *Id.* at 3:45–48. Transcode service providers may provide the capability to compress or scale data content. *Id.* at 3:51–55. Server-side cache memory 30 managed by server-side cache interface 28 is provided to store original and transcoded versions of content. *Id.* at 3:66–4:5. “Server-side cache interface 28 and server-side cache memory 30 enable maintenance of multiple representations of a given cached object, with descriptive information about each representation included in server-side cache memory 30.” *Id.* at 4:62–66. These multiple representations support clients with different communications and/or presentation capabilities. *Id.* at 6:13–17. In this way, a parameter may be used to select a version of the cached object for return transmission to requesting network client 12. *Id.* at 6:17–23. Information may be stored and retrieved about cached objects, “including information maintained by transcode service provider 24 used to determine transcoding properties and transcoding status of a cached object. Transcode service provider 24 may use such information, for example, to determine current compression progress for scaled data access and staged refinements.” *Id.* at 5:35–42.

When a request is received from a client, user preferences are examined, and the cache is checked to determine whether a copy of the required version of the media already resides in cache memory. *Id.* at

14:21–30, Fig. 8. If not, it is requested from the Internet, but if so it is retrieved from the cache. *Id.* at 14:30–46, Fig. 8. The data stream received is then transcoded for the user. *Id.* at 14:47–55, Fig. 9. The transcoded object is cached. *Id.* at 14:57–59.

2. Huang

Huang relates to a “Collaborative Proxy System For Distributed Deployment Of Object Rendering” in which object requestor nodes request objects from object source nodes, with intermediate nodes performing staged object rendering. Ex. 1005, codes (54), (57), 3:19–49. Included with object requests are meta-information describing the capabilities of the object requesting node, termed receiver hint information (RHI). *Id.* at 3:52–57. During the staged object rendering a first intermediate node may perform a subset of the required rendering and pass a partially rendered object to another intermediate node to perform some or all of the remaining required rendering. *Id.* at 3:50–4:7.

Figure 4, reproduced below, is a flow chart illustrating the operations of a request object handler in an intermediate node. *Id.* at 6:52–56, 7:23–8:11.

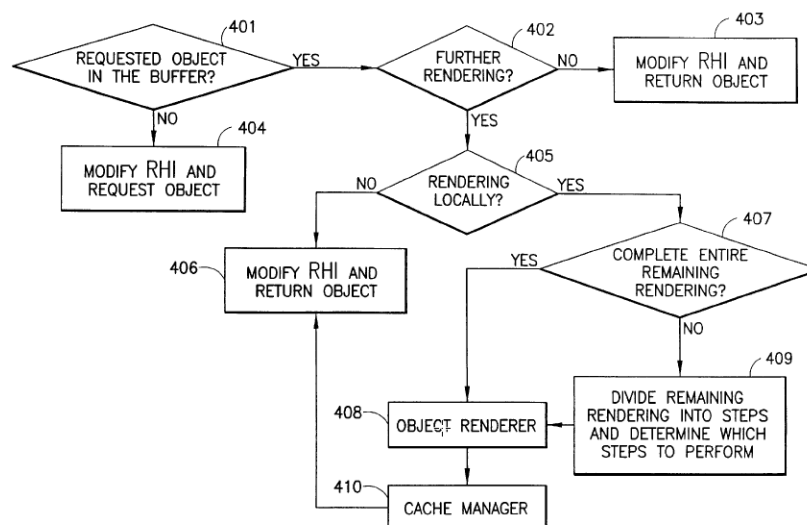


FIG. 4

Figure 4 describes a process for handling a request for an object, including (decision diamond 401) determining whether a useful version of the requested object is in a buffer or must be requested and (decision diamond 402 and “YES” branch) performing further rendering on the object if necessary. *Id.* at 7:23–8:11. As described in Figure 4, if a version of the object satisfying certain requirements is available in the cache, it is retrieved from the cache, but if not a request for the object is sent out to a content server or another proxy server. *Id.* at 7:23–42, Fig. 4 (elements 401, 404). If the requested object is found in the cache, the RHI is checked to determine whether further rendering is necessary, if not the RHI is modified and the object returned. *Id.* at 7:43–53, Fig. 4 (elements 402, 403). If additional rendering is necessary, complete or partial additional rendering may be performed locally. *Id.* at 7:61–8:5, Fig. 4 (elements 405, 407–409). After local rendering, the cache manager then determines whether to store a local copy of the completely or partially rendered object. *Id.* at 8:5–7, Fig. 4 (element 410). The object (whether or not local rendering has been performed) is returned along with modified RHI reflecting the condition of the object. *Id.* at 7:57–61, 8:7–11, Fig. 4 (element 406).

3. *Combination of Tso and Huang*

Petitioner argues that Tso and Huang are analogous prior art to the ’242 patent, as each is directed to networked media delivery, and pertinent to the problems identified in the ’242 patent. Pet. 17 (citing, *inter alia*, Ex. 1001, 1:20–23; Ex. 1004, 1:10–31; Ex. 1005, 1:20–26; Ex. 1003 ¶ 70).

Petitioner argues that Tso discloses receiving partially-transcoded content from a cache, and that one of ordinary skill in the art would have modified these teachings by implementing Huang’s “detailed teachings” regarding retrieving and further processing cached partially transcoded

content, and tracking cached versions available via Huang's RHI information. *Id.* at 18 (citing Ex. 1004, 5:39–41, 14:64–15:6; Ex. 1005, 6:9–23, 6:23–67; Ex. 1003 ¶ 71). Petitioner argues that the mechanisms in the two references are complementary and that Huang teaches “how to further improve speed and efficiency” in staged transcoding by utilizing local cached content to avoid repeating operations and to track transcoding status of content. *Id.* at 18–31 (citing *inter alia* Ex. 1003 ¶¶ 72–73). Petitioner asserts that one of ordinary skill in the art would have had a reasonable expectation of success, as a straightforward application of the teachings of Huang in Tso's similar staged transcoding system. *Id.* at 21 (citing, *inter alia*, Ex. 1003 ¶ 74).

At this time, Patent Owner does not comment on Petitioner's proposed reasons for combining Tso and Huang.

With respect to the Petitioner's proposed combination of Tso and Huang by one of ordinary skill in the art, we find Petitioner has sufficiently shown, on the present record and for the purposes of institution, that a person of ordinary skill in the art would have had reason to combine the teachings of Tso and Huang.

4. Claim 9

a) Preamble and Limitation 9.a

Without asserting a position regarding whether the preamble is limiting, Petitioner argues that Tso discloses a method for dynamically transcoding media content, for example in its description of a client computer receiving dynamically transcoded information from a network server computer. Pet. 21–22 (citing, *inter alia*, Ex. 1004, 2:44–49, 3:45–54; Ex. 1003 ¶¶ 75–77).

Limitation 9.a recites “an act of receiving a request for media content to be delivered to a client presentation system for media content, wherein the requested media content has a limited number of base transcoding profiles associated therewith, each base transcoding profile corresponding to a cached version of the requested media content.” For the first portion of this limitation (“an act of receiving a request for media content to be delivered to a client presentation system for media content”), Petitioner cites Tso’s receipt of requests from a network client by a network server for media content. *Id.* at 22–26 (citing Ex. 1004, 2:56–65, Fig. 5; Ex. 1003 ¶¶ 78–80). For the second portion, requiring that the “requested media content has a limited number of base transcoding profiles associated therewith, each base transcoding profile corresponding to a cached version of the requested media content,” Petitioner argues this is taught by Tso’s storage of requested contented items in a cache storing “multiple representations of a given cache object” and “descriptive information” regarding “transcoding properties and . . . status” of cached versions of content. *Id.* at 22–25 (citing Ex. 1004, 4:1–5, 4:62–5:7, 5:35–42, 6:17–23; Ex. 1003 ¶¶ 78–80). Petitioner additionally cites the portion of Tso that describes a network proxy “determin[ing] whether a non-transcoded version of the requested hypertext object” is present in the cache memory, and retrieves information regarding the transcoding properties and status of the cached object. *Id.* at 26 (citing Ex. 1004, 14:21–55) (emphasis omitted).

At this time, Patent Owner does not present any arguments or comments regarding these assertions.

We determine, on the present record and for the purposes of institution, that Petitioner sufficiently shows that Tso teaches or suggests the preamble of claim 9⁶ and limitation 9.a.

b) Limitation 9.b

Limitation 9.b recites that the method of claim 9 comprises “at the time of the request, and without input by a network administrator, an act of automatically identifying transcoding parameters to be applied to the requested media content prior to delivery to the client presentation system, wherein identification of transcoding parameters is based on one or more formats of any client presentation system.”

Petitioner argues that this limitation is taught or suggested in Tso’s parser, which manages the transcoding of data to be transmitted by invoking transcode service providers based on predetermined selection criterion including characteristics of the Tso network client. *Id.* at 26–27. Petitioner cites Tso’s disclosure that, upon receipt of a request, the parser selectively invokes transcode service providers 24 based on the selection criteria. *Id.* at 28–29 (citing Ex. 1004, 6:64–7:14). Petitioner additionally cites Tso’s teaching that the predetermined selection criterion may relate to the condition of the transcoding device or connection, or information regarding the network client. *Id.* at 27, 28–29 (citing Ex. 1004, 6:64–7:29; Ex. 1003 ¶ 83).

Patent Owner argues that Petitioner’s argument is flawed because it “maps Tso’s transcode service providers 24 to the claimed ‘transcoding parameters’” but “Tso discloses that the transcode service providers 24 are

⁶ Because we determine that Petitioner shows that Tso teaches or suggests the preamble of claim 9, we do not make a determination regarding whether it is limiting.

software modules within the transcoding server 34 that perform various functions or operations; they are not ‘parameters.’” Prelim. Resp. 33–35. However, we do not understand the Petition to be mapping the transcode service providers to the claimed “transcoding parameters.” Rather, we understand the Petition to be arguing that Tso’s teaching of predetermined selection criteria teaches the identified transcoding parameters, and that these are applied by the operation of the parser and its invoking of transcode service providers. Pet. 26–29. Thus, on the present record and for the purposes of institution, we find Patent Owner’s argument to be inapposite as not addressing the contentions in the Petition.

For these reasons, we determine, on the present record and for the purposes of institution, that Petitioner sufficiently shows that Tso teaches or suggests limitation 9.b of claim 9.

c) Limitation 9.c

Petitioner asserts that limitation 9.c, “an act of determining that the transcoding parameters to be applied to the requested media content prior to delivery to the client presentation system are the same as transcoding parameters that are being applied to the requested media content prior to delivery to another client presentation system,” as taught in Tso’s disclosure that, when a request is made for a content item, it determines whether a copy of the required version is available, and generates the required version using the selection criteria in the request, and in its teaching regarding multiple-thread processing, and retrieving content from the Internet once with multiple versions transmitted to network clients concurrently, if the two clients are requesting the same content. Pet. 29–31 (citing Ex. 1004, 6:51–63, 10:22–27; Ex. 1003 ¶¶ 84–86).

Patent Owner argues that Petitioner does not show that “two similar client systems” would receive the same version of the object, because Tso describes many types of information that might dictate which of the transcode service providers are invoked. Prelim. Resp. 37 (citing Ex. 1004, 7:15–8:9). However, we understand Tso to teach that caching of different content versions, including transcoded versions of content, occurs, so that they may be served to a network client without repeating retrieval or transcoding operations. Ex. 1004, 4:1–5 (cited at Pet. 14–15, 23, 25). On the present record, we do not agree that Petitioner’s showing does not account for two client systems receiving the same transcoded version of content. Patent Owner additionally argues that, even if two similar client systems were to receive the same version, this does not teach a determination as recited in 9.c. Prelim. Resp. 37–38. This argument does not address Petitioner’s contention that the determination taught or suggested in Tso’s determination that multiple network clients have requested the same hypertext object as a cached copy of the required version is available. See Pet. 29–30. On the present record, and for the purposes of institution, Petitioner has adequately shown that the recited determination is taught or suggested in the Tso determination that a copy of the required version is available in a cache. *Id.* Patent Owner’s last argument relates to its arguments with respect to limitation 9.b, which we have already addressed. Prelim. Resp. 38.

For these reasons, we determine, on the present record and for the purposes of institution, that Petitioner sufficiently shows that Tso teaches or suggests limitation 9.c of claim 9.

d) *Limitations 9.d, 9.e, 9.f, and 9.g*

Petitioner argues that limitation 9.d, reciting that the method of claim 9 comprises “an act of transcoding the requested media content in accordance with the identified transcoding parameters, such that the identified transcoding parameters are used to perform additional incremental transcoding on top of the base transcoding profile” is taught or suggested by the combination of Tso and Huang. Pet. 31–36.

For the “act of transcoding the requested media content in accordance with the identified transcoding parameters,” Petitioner argues that Tso discloses obtaining a version of the content from the cache, determining its properties, and performing transcoding on it according to transcoding parameters (“selection criterion” in Tso). *Id.* at 31–33 (citing *inter alia* Ex. 1004, 5:36–42, 6:9–4, 7:15–29, 14:47–55, 15:66–16:42; Ex. 1003 ¶¶ 87, 88, 90). With respect to using the identified transcoding parameters “to perform additional incremental transcoding on top of the base transcoding profile,” Petitioner argues that Huang teaches this in its discussion of incremental transcoding on top of a base transcoding profile. *Id.* at 33–36 (citing, *inter alia*, Ex. 1005, 4:8–15, 6:9–23, 7:43–64; Ex. 1003 ¶¶ 89–91).

With respect to limitations 9.e and 9.f, providing that the transcoding of limitation 9.d further comprises “selecting a pre-existing base transcoded version of the requested media content comprising intermediate derivative media that has been transcoded in accordance with only a portion of the identified transcoding parameters” (9.e) and “creating a final version by incrementally performing further transcoding of the pre-existing base transcoded version in accordance with a remaining portion of the identified transcoding parameters” (9.f), Petitioner argues that these are similarly taught by Tso and Huang, referring to similar teachings with respect to the

incremental transcoding applied to pre-existing transcoded versions. *Id.* at 36–39 (citing, *inter alia*, Ex. 1004, 5:36–42, 6:9–4, 7:15–29; Ex. 1005, 4:8–15, 6:9–23, 7:43–64; Ex. 1003 ¶¶ 93, 94, 96). With respect to the final version created by incremental transcoding Petitioner argues that this is taught by Tso and Huang, including in Huang’s disclosure that further rendering is performed after which a completely rendered object is returned to a requesting client device. *Id.* at 39–41 (citing, *inter alia*, Ex. 1005, 7:43–57, 8:1–11, 9:4–14, 10:46–56; Ex. 1003 ¶¶ 99–101).

Lastly, with respect to limitation 9.g’s step of delivering transcoded media content to both client presentation systems, Petitioner argues that Tso’s delivery of an appropriate version for two clients may be transmitted to multiple clients concurrently teaches or suggest this limitation. *Id.* at 41 (citing, *inter alia*, Ex. 1004, 6:51–63; Ex. 1003 ¶¶ 103–105).

At this time, Patent Owner does not present any arguments or comments regarding these assertions.

We determine, on the present record and for the purposes of institution, that Petitioner sufficiently shows that the combination of Tso and Huang teaches or suggests and limitations 9.d, 9.e, 9.f, and 9.g of claim 9.

e) Conclusion: Obvious of Claim 9 over Tso and Huang

On the present record, and for purposes of institution, Petitioner has established a reasonable likelihood that it would prevail in showing the unpatentability claim 9 as obvious over Tso and Huang.

F. Grounds Including Samaniego

Petitioner argues that claim 9 is anticipated by Samaniego, or is obvious in view of Samaniego or a combination of Samaniego and Tso. Pet. 41–56. Patent Owner contends that Samaniego is not prior art to the ’242 patent. Prelim. Resp. 8–17.

The '242 patent claims priority to a chain of continuation and divisional applications, including Application No. 09/929,904 (“the '904 application”), filed on August 14, 2001. Ex. 1001, code (60). The '904 application subsequently issued as U.S. Patent 6,964,009 (“the '009 patent”). The '904 application was published on June 20, 2002 as U.S. Pub. No. 2002/0078093 A1 (“Samaniego”). Ex. 1007, code (10). In these grounds, Samaniego is cited by Petitioner as § 102(b) prior art to the '242 patent. Pet. 2–3, 41–56.

In the Petition, Petitioner argues that claim 9 of the '242 patent is not entitled to the priority date of the '904 application because none of the '242 patent's named inventors are “name[d] ... in the previously filed application[s],” a requirement of 35 U.S.C. § 120 to claim benefit of the filing date of an earlier filed application. *Id.* at 41–42. Based on this reasoning, Petitioner asserts that the earliest filing date that the '242 patent can be accorded is November 7, 2005 when continuation Application No. 11/269,916,⁷ which shares common inventors with the '242 patent, was filed. *Id.* at 2. Samaniego was published June 20, 2002, more than two years before that November 7, 2005 filing date and therefore, according to Petitioner, is 35 U.S.C. § 102(b) prior art to the '242 patent. *Id.* at 41. Consequently, Petitioner challenges the patentability of claim 9 as anticipated or obvious in view of Samaniego and as obvious in view of Samaniego and Tso.

Petitioner asserts that Patent Owner cannot dispute that Samaniego discloses the subject matter of challenged claim 9 because the specifications

⁷ Application No. 11/269,916 is listed as a “continuation-in-part” of the '904 application. Ex. 1001, code (60).

of the '242 patent and Samaniego are substantively identical. *Id.* at 42 (citing Ex. 1013 (Petitioner's redline comparison between the specifications of the '242 patent and Samaniego, showing substantial identity)). Patent Owner acknowledges that the specifications of the '242 patent and Samaniego are substantively identical and admits there is written description support in Samaniego for the '242 patent claims. Prelim. Resp. 9.

Patent Owner responds in the Preliminary Response that Petitioner's argument that Samaniego is prior art is moot because a petition was filed under 37 C.F.R. § 1.324 to correct the inventorship of the '009 patent by adding Sean Barger as a co-inventor. *Id.* at 10–11 (citing Ex. 2003). Mr. Barger is also listed as a co-inventor of the '242 patent and, therefore, Patent Owner asserts that all the requirements under 35 U.S.C. § 120 for getting the benefit of an earlier filing date are met. *Id.* at 11. Patent Owner thus asserts that the inventorship correction to the '009 patent cures the 35 U.S.C. § 120 defect in the '242 patent's priority claim. *Id.* Petitioner, however, disputes the propriety and effect on the '242 patent of the inventorship correction. Prelim. Reply 1. We thus first turn to 35 U.S.C. § 256, which authorizes correction of the named inventor(s) of an issued patent.

Under section 256(a), “[w]hen through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent, the Director may . . . issue a certificate correcting such error.” The requirements to correct inventorship under 35 U.S.C. § 256(a) are listed in 37 C.F.R. § 1.324. Patent Owner filed a petition pursuant to section 1.324(b) to correct the inventorship of the '009 patent by adding Sean Barger as a named inventor. Ex. 2003. The section 1.324(b) petition was granted (Ex. 2012) and a Certificate of Correction correcting inventorship was approved (Ex. 2013) and subsequently entered in the '009

patent on June 13, 2023, adding the name of Sean Barger as a co-inventor of the '009 patent. Ex. 2014. This petition was filed on April 3, 2023, approximately three months after the filing date of this Petition. Ex. 2003.

Petitioner argues in the Preliminary Reply Brief that section 256 “limits its effects to only inventorship errors in the patent being corrected.” Prelim. Reply 1. Petitioner, in support of this argument, asserts that Section 256 is “a savings provision” to avoid invalidity under section 102(f) of the patent in which correction is sought. *Id.* at 2 (citing *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1350 (Fed. Cir. 1998)). Petitioner further asserts that any retroactive effect of a Certificate of Correction under section 256 must be authorized by Congress. *Id.* Petitioner contends that a Certification of Correction, as expressly stated in sections 254 and 255, has only a prospective effect on “the trial of actions for causes thereafter arising” after the Certificate of Correction has issued. *Id.* at 2–3. In addition, Petitioner argues that section 256(b) expressly refers to correcting an inventorship in the patent “in which such error occurred” and therefore restricts the correction to “only to errors of inventorship implicating §102(f)” in the patent in which the inventorship error occurred. *Id.* at 3. Thus, Petitioner’s principal argument is that the inventorship correction to the '009 patent cannot be applied retroactively in this proceeding to cure the section 120 defect in the '242 patent’s priority claim to the filing date of the '009 patent.

Patent Owner argues that “[n]othing in the statute indicates that the effect of [inventorship] corrections are limited solely to the patent being corrected.” Prelim. Sur-reply 1–2. Patent Owner asserts that Petitioner is reading a “prospective” requirement into section 256 that is not there. *Id.* at 2. To support this position, Patent Owner cites *Viskase Corp. v. American Nat’l Can Co.*, 261 F.3d 1316, 1329 (Fed. Cir. 2001) which held “[a]bsent

fraud or deceptive intent, the correction of inventorship does not affect the validity or enforceability of the patent for the period before the correction.”

Id. at 3. Thus, Patent Owner argues that retroactive effect is given to a Certificate of Correction correcting inventorship under section 256. *Id.*

To begin, the language of section 256 indicates that a certificate of correction issued pursuant to the statute is applied retroactively to the patent in which the correction is made. *See Roche Palo Alto LLC v. Ranbaxy Labs. Ltd.*, 551 F. Supp. 2d 349, 358 (D.N.J. 2008).⁸ Section 256(b) expressly states that “[t]he error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section.” This statutory language has been interpreted to mean that, despite an initial error being made in the naming of the inventor(s), once this error has been corrected, it is as if the patent was valid from the beginning and the defect in inventorship had never happened. *See Viskase*, 261 F.3d at 1329; *see also Emerson Electronic Co. v. Sipco LLC*, IPR2016-00984, Paper 52 at 11–21 (PTAB January 24, 2020) (Decision on Remand) (distinguishing the retroactive effect of section 256 from sections 254 and 255, which are prospective).

Next, we must consider whether the correction to the inventorship of the ’009 patent can retroactively correct the ’242 patent’s priority claim to the ’009 patent under 35 U.S.C. § 120. If so, Samaniego would no longer be available as prior art because the ’242 patent would then have an inventor in common with the ’009 patent and the ’904 application from which it issued and upon which Samaniego is based.

⁸ “[T]here are many federal cases that have given retrospective effect to a Certificate of Correction when it regards correction of inventorship, albeit all of these cases involve petitions under Section 256.”

We begin with 35 U.S.C. § 256. According to *Merry Mfg. Co. v. Burns Tool Co.*, 206 F. Supp. 53, 58 (N.D. Ga 1962), *aff'd.*, 335 F.2d 239 (5th Cir. 1964), “Section 256 of Title 35 of the United States Code is a codification of the law as it was established by the Court of Appeals for the District of Columbia [in] *In re Roberts*, 49 App.D.C. 250, 263 F. 646.”

In re Roberts, 263 F. 646 (D.C. Cir. 1920) was an appeal from a decision of the Patent Office “refusing to treat” an application by sole inventor Roberts “as a continuation of a joint application embracing the same subject-matter, theretofore filed by appellant [Roberts] and another [Roberts’ son] under a mistake of fact.” *Roberts*, 263 F. at 646.⁹ In an interference between the application of Bruckman and the joint application of Roberts and his son, it was discovered that Roberts’ son was not an inventor of the joint application and priority was awarded to Bruckman. *Id.* at 646–47. “[T]he Patent Office declined to consider the present application [by Roberts alone] as a continuation of the former joint application, the result being that the Bruckman patent, having issued more than two years prior to the filing of the present application, became a statutory bar to its allowance.” *Id.* at 647. The question framed by the D.C. Court of Appeals was “whether, in a case like the present, where it appears that a joint application has been filed through mistake or inadvertence and without fraudulent intent, the sole inventor, one of the joint applicants, is estopped from taking any advantage of that application.” *Id.* On this question, the court held:

All that was sought in the new application [by Roberts alone] was the elimination of one of the joint applicants, to whom

⁹ We recognize that the statutes in place when *Roberts* was decided are not the same as they were when the ’009 and ’242 patents were filed.

credit mistakenly had been given for the particular invention involved. There was identity of subject-matter, and it is difficult to perceive any reason for not permitting the rectification of such a mistake by an amendment eliminating the superfluous applicant.

Id. at 648.

The court therefore concluded that the “second application” by Roberts as sole inventor was “filed merely to correct a formal error” in the first application, and thus properly could be given benefit of the first application. *Id.* at 648–49. The court further explained:

To prevent a possible failure of justice, the present application should have been considered as a continuation of the abortive application. As already suggested, we perceive no reason why the mistake could not have been rectified by a simple amendment, but in any event the sole inventor should not be deprived of his day in court by the raising of artificial barriers against him. He claimed his invention, and, through mistake, gave his son credit where no credit was due. The elimination of the son ought not to deprive the father, the sole inventor, of the benefit of his original application; and we so rule.

Id. at 649.

In re Schmidt, 293 F.2d 274 (CCPA 1961) involved the impact of an inventorship correction in an earlier-filed application, pursuant to 35 U.S.C. § 116, had on a later-filed continuation application that sought benefit under 35 U.S.C. § 120¹⁰ to the filing date of the earlier, corrected application. *Schmidt* considered sections 116 and 256 parallel for inventorship correction purposes and held that “the same inventor” as used in section 120 “embraces

¹⁰ *Schmidt* involved an interpretation of the statutory language of 35 U.S.C. § 120 requiring that the continuing application for which benefit of the earlier application is sought must be filed by “the same inventor.” *In re Schmidt*, 293 F.2d at 277. Section 120 has since been amended and no longer contains this language.

the possibility permitted by sections 116 and 256 that the earlier application may be corrected thereunder by changes in the name or names of the applicants under the conditions stated in section 116.” *In re Schmidt*, 293 F.2d at 279. A patent was removed as prior art when *Schmidt* held “that appellant was entitled under section 116 to correct the errors in the intermediate application filed in the names of joint inventors and under section 120 was entitled as ‘the same inventor’ to the benefits of the filing dates of the earlier co-pending applications.” *Id.* *Schmidt* cited *Roberts* as approving this practice. *Id.*; see also *Weil v. Fritz*, 572 F.2d 856, 863 (CCPA 1978) (stating that *Schmidt* was correctly decided).

While the statutes at the time *Schmidt* and *Roberts* were decided are different from those in place when the ’242 and ’009 patents were filed, the legal principles reflected in these cases suggest that the inventorship correction to the ’009 patent can be applied retroactively to cure the defect in the ’242 patent’s section 120 priority claim. For example, in *Roberts*, the subsequently-filed patent application by Roberts alone was given benefit of the previously-filed first patent application to Roberts and son, despite the error in naming the son as a co-inventor in the first application. Similarly, the Patent Owner of the ’242 patent seeks the benefit of the earlier-filed ’009 patent, despite the initial error in naming the inventors of the ’009 patent. This error otherwise forecloses the inventors of the ’242 patent from claiming priority to the ’009 patent. As explained in *Roberts*, to deny the second application the benefit of priority of the first application would deprive an inventor of their invention because of a mistake that could be corrected. *Schmidt* further approved the practice of curing a defect in a claim to priority under section 120 by making an inventorship correction in an earlier-filed application. See also *Winbond Elecs. Corp. v. Int’l Trade*

Comm’n, 262 F.3d 1363, 1371 (Fed. Cir. 2001) (“‘Incorrect inventorship is a technical defect in a patent that may be easily curable.’ . . . Rule 324 permits such an easy cure.” (quoting *Canon Comput. Sys., Inc. v. Nu-Kote Int’l, Inc.*, 134 F.3d 1085, 1089 (Fed. Cir. 1998))) (opinion corrected, 275 F.3d 1344 (Fed. Cir. 2001)); see also *Stark v. Advanced Magnetics, Inc.*, 119 F.3d 1551, 1554 (Fed. Cir. 1997) (discussing “the availability of section 256 to the policy of rewarding the actual inventor”).

We are not persuaded by Petitioner’s argument that inventorship correction under section 256 limits a Certificate of Correction to the patent “in which such error occurred” and “has only a confined effect that does not retroactively impact the ’242 [patent].” Prelim. Reply 3 (quoting from section 256(b)). Section 256(b) states: “The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section.” This statement indicates that a defect in naming the inventors does not invalidate the patent—the purpose for which section 256 was enacted. Petitioner argues that because the statute refers to correcting an inventorship error in the patent, it cannot be used to correct an error in any other patent, such as a descendant of the corrected patent. However, the only patent expressly mentioned in section 256 is the patent in which the error occurred. Unlike sections 254 and 255, which expressly state that the change “shall have the same effect and operation in law” for “causes . . . arising” after a certificate of correction has been issued, no such constraint appears in section 256.

Our reviewing court has “interpreted § 256 broadly as a ‘savings provision’ to prevent patent rights from being extinguished simply because the inventors are not correctly listed.” *Chou v. University of Chicago*, 254

F.3d 1347, 1358 (Fed. Cir. 2001) (citing *Pannu*, 155 F.3d at 1349).

Petitioner has not supplied an adequate reason to limit the effect of the certificate of correction to the ancestor patent of the '242 patent. *In re Schmidt*, in particular, appears to be consistent with the result that an inventorship correction to an intermediate or ancestor patent can be used to correct a defect in a section 120 priority claim in a later filed patent.

Petitioner contends that Patent Owner failed to raise the inventorship defect timely. Prelim. Reply 3. Citing *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 1296 (Fed. Cir. 2000), Petitioner argues “requiring a patentee to ‘check a patent when it is issued’ is not ‘asking too much.’” *Id.* Petitioner asserts that Patent Owner knew of the inventorship issue “since at least 2008—before the '242 was filed—when it filed a related application removing Samaniego’s inventors and replacing them with an entirely new set of inventors.” *Id.* (citing Ex. 1026, 79–89). Despite this alleged knowledge, Petitioner contends that Patent Owner did nothing to correct the inventorship during the life of the '242 patent. *Id.* Petitioner argues that “the public has been on notice that the '242 was invalid over Samaniego given the discontinuity in inventorship.” *Id.* Petitioner asserts that it “relied on this discontinuity and filed a petition seeking to invalidate claim 9 based on this deficiency.” *Id.*

In response, Patent Owner argues “there is no concern that the public was not aware of the priority claim” because the '242 patent “claims priority to the '009 patent on its face.” Prelim. Sur-reply 3 (emphasis omitted); see Ex. 1001, code (60). Patent Owner contends that the requirements of Section 120 are met for the claim of priority to the '009 patent. Prelim. Sur-reply 4. Patent Owner asserts that the inventorship correction under section

256 is an administrative correction and formality to list the proper inventors on the '009 patent. *Id.*

We agree with Patent Owner. Despite Petitioner's arguments about untimeliness¹¹ and lack of notice, the USPTO granted Patent Owner's request under 37 C.F.R. § 1.324 to correct inventorship of the '009 patent. Ex. 2012 (Decision Granting Inventorship Petition). A Certificate of Correction, signed by the Director of the USPTO, was subsequently entered in the '009 patent. Ex. 2013 (Decision Approving Request for Certificate of Correction); Ex. 2014 (Certificate of Correction correcting inventorship). Regarding Petitioner's allegations that, due to the conduct of Patent Owner, "[t]he Board . . . should not permit [Patent Owner] to change the inventorship of Samaniego" (Pet. 43–44 & n.5), Petitioner has not described under what principle or caselaw the Board should act. *See* Prelim. Reply 1 n.1.

For the foregoing reasons, we decide that Samaniego is not prior art to the '242 patent. Following correction of the inventorship of the '009 patent, and with no dispute by Petitioner that all other requirements under section 120 necessary for the '242 patent to claim the benefit of the filing date of the

¹¹ Petitioner has not established that the asserted "delay" in filing the certification of correction is a factor that should have been considered in determining whether to enter a certificate of correction of inventorship should be entered. Petitioner has not identified any statutory language in Section 256 that makes "timeliness" a factor to consider when correcting inventorship of a patent. In this regard, we point out that "diligence is not a requirement to correct inventorship under section 256." *Stark*, 119 F.3d at 1551; *see also Advanced Cardiovascular Systems, Inc. v. SciMed Life Systems, Inc.*, 988 F.2d 1157, 1162 (Fed. Cir. 1993) ("Since the defense of patent invalidity based on incorrect inventorship can be raised at any time, correction of inventorship should be similarly available at any time.").

'009 patent are met (*see* Prelim. Resp. 9–11), Samaniego is excluded as prior art. Accordingly, Petitioner has not demonstrated a reasonable likelihood that it would prevail in proving the unpatentability of claims 1 on grounds including Samaniego.

G. § 314(a) *Discretionary Denial – Chevron and Deeper*

Patent Owner argues, should we determine that Samaniego is not prior art to the '242 patent, that we should discretionarily deny the petition under 35 U.S.C. § 314(a), as only one of the four asserted grounds is not based on Samaniego. Prelim. Resp. 1, 18, 19–21. Patent Owner contends, referencing the PTAB's *Chevron* and *Deeper* decisions, each designated as informative, that instituting on only the one remaining ground (of obviousness over a combination of Tso and Huang) would not be an efficient use of Board resources because an institution would require review of all grounds. *Id.* (citing *Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper 9, 10–11 (PTAB Nov. 7, 2018) (informative); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7, 41–43 (PTAB Jan. 24, 2019) (informative)). Patent Owner additionally argues that, in this case, the arguments made with respect Huang and Tso and 35 U.S.C. § 325(d) discretion strengthen the case for discretion.

However, we note that in *Chevron* the petitioner had demonstrated a reasonable likelihood of prevailing with respect to only two dependent claims out of twenty challenged claims. *Chevron*, 10–11. And in *Deeper*, the petitioner had only demonstrated a reasonable likelihood of prevailing with respect to two of twenty-three challenged claims. *Deeper*, 1, 42–43. In some cases “the ‘effect . . . on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings,’ 35 U.S.C. § 316(b), favors denying

a petition even though some claims meet the threshold standards for institution under 35 U.S.C. §§ 314(a), and 324(a).” Patent Trial and Appeal Board Consolidated Trial Practice Guide 58 (November 2019), 58 (alteration in original). While institution in an *inter partes* proceeding is necessarily on all claims and all grounds, we do not, in this case, determine that concerns regarding efficiency lead us to the conclusion that we should discretionarily deny in this situation, (a) where only one claim has been challenged, (b) where we have found Petitioner has demonstrated a reasonable likelihood of success with respect to showing that claim to be unpatentable, and (c) where, while additional arguments may be made after institution regarding the other asserted grounds, a single issue (the prior art status of Samaniego) may quickly resolve each of those grounds. For these reasons, we decline to exercise discretion to deny institution under § 314(a).

III. CONCLUSION

We determine that Petitioner establishes a reasonable likelihood that it would prevail in showing that claim 9 of the ’242 patent is unpatentable. We further determine not to discretionarily deny the Petition. Accordingly, we institute an *inter partes* review of all challenged claims on all grounds asserted against those claims in the Petition.

IV. ORDER

It is

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claim 9 of the '242 patent is instituted commencing on the entry date of this Decision; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of trial.

IPR2023-00330
Patent 8,495,242 B2

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